

DOMAIN
NAME
DISPUTES

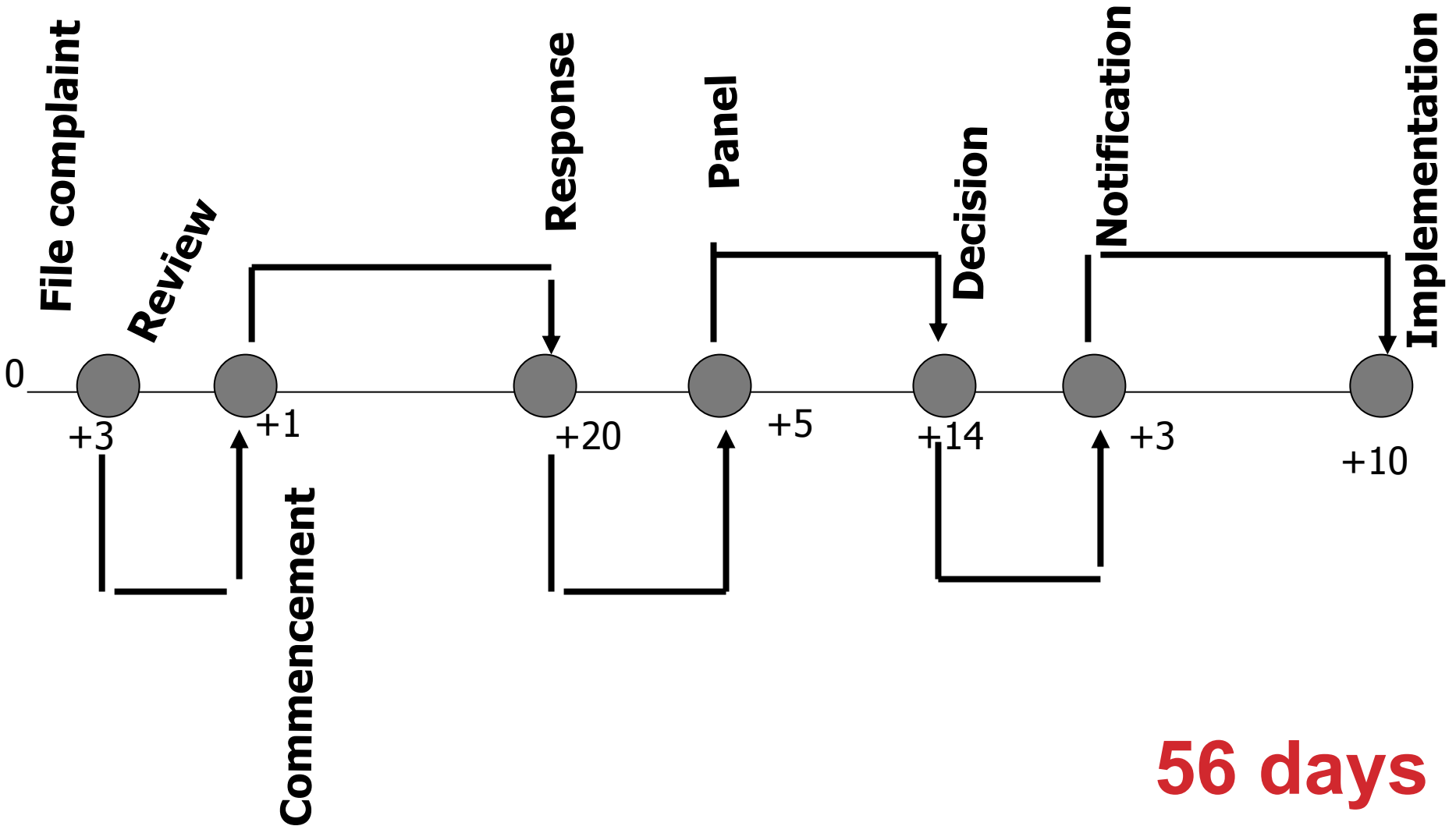
PROCEDURAL ELEMENTS

JUDR. PAVEL LOUČEK, PH.D., BA (HONS)

MAIN PRINCIPLE

- **First comes – first served**
- **The domain name is immediately registered**
- **What if the holder of domain name is not the one who should own it?**
- **Cybersquatting, typosquatting, etc.**

UDRP



UDRP PROCESS



Criticism

- Froomkin says, that such a short terms are in contradiction with public order
- On the other hand some of the terms can be **prolonged**

UDRP PROCESS



Advantages:

- Fast – the case can be decided within 2 months
- Inexpensive
- Co - existing with local legal systems
- Global solution
- Law accessible – decisions are freely available
- Price: <http://www.wipo.int/amc/en/domains/fees/>

UDRP PROCESS



Disadvantages:

- Hard to control (are we getting good decisions?)
- Transparency of panellists
- Inconsistent decisions
- Only transfer (cancellation) of the domain name is decided (not damages)

UDRP SHIELDED BY COURT



Storey v. Cello Holdings LLC (american court decision)

- The agreement with UDRP is implemented by chains of contracts and it is involuntary
- ICANN as the only regulator does not offer any other solution
- The decision is contractually binding just between the parties (*no rei iudicata*)
- The parties cannot be prevented from submitting their dispute to the court

UDRP CASE STUDY IN GENERAL



Classmates Online, Inc. v. John Zuccarini

- Possibility to file additional information (an exception)
- *„To avoid any misunderstanding that the decision establishes a precedent, we call for caution and recommend to submit complete documentation of the case when filing a complaint.“*

UDRP PROCES - CONS



Problems:

Forum shopping:

- Complainant win percentages:
 - WIPO – 82%
 - NAF – 83%
 - eResolution – 63% (not working any more)

2011

- WIPO – 19.123 cases
- NAF – 16.134 cases
- eResolution – 277 cases

UDRP PROCES - CONS



Problems

Case allocation bias:

- One panelist (83% probability to transfer domain name)
- vs
- Three member – panels (60% probability to transfer domain name)

!! 3 member panel is more expansive and there is lower probability to win the case !! (however it can be part of the tactics !!)

3 member panel decides only 10% of cases

UDRP PROCES - CONS

Also choosing one or three member panel is problem:

- **One panelist – decided by ODR provider**
- **Three members**
 - each party proposes three members from defined list of panelists; provider chooses one from each list
 - Third panelist is chosen from 5 panelists list where each party crosses out 2 panelists (the last one remains)

The parties thus cannot influence who will be member of one member panel

UDRP contain rules how to exlude panelist...

HOWEVER – usualy the panelists are lawyers who are specialists in trademarks, thus they prefer trademark protection

UDRP PROCES - CONS



Flexibility of the rules

- It is OK that the rules are not covering only trademarks
- The problem is with spreading it wider – e.g. in geographical indications
- **.zulu (new gTLD) is considered as geographical indication (but it is language)**

Really bad decisions:

- Domain name **bodacious-tats.com** was found as confusingly similar to trademark „Tata & Sons“

SOME PROCEDURAL ISSUES



**There is not only UDRP itself
There are also Rules for UDRP**

<https://www.icann.org/resources/pages/udrp-rules-2015-03-11-en>

**UDRP - substantive rules (mainly)
Rules for UDRP – procedural rules**

SOME PROCEDURAL ISSUES



**Do you need a lawyer?
(And who is the lawyer?)**

SOME PROCEDURAL ISSUES



- **No..**
- **There is not such a demand**
- **However it could be helpful..**

SOME PROCEDURAL ISSUES



Who carries a burden of proof?

SOME PROCEDURAL ISSUES



- the Complainant..
- the Complainant is required to substantiate its claims beyond mere allegations
- a fact is considered established when it is more likely than not that the fact is true
- *Neusiedler Aktiengesellschaft v. Kulkarni*, WIPO Case No. D2000-1769;
- *Dow Jones & Company and Dow Jones LP v. The Hephzibah Intro-Net Project Limited*, WIPO Case No. D2000-0704.

SOME PROCEDURAL ISSUES



Are there in-person hearings?

SOME PROCEDURAL ISSUES



- **Paragraph 13 of the Rules - there shall be no in-person hearings (including hearings by teleconference, videoconference and web conference)**
- **...unless the Administrative Panel determines, only as an exceptional matter, that such a hearing is necessary**
- **no in-person hearing has been held in any WIPO proceeding to date!**

SOME PROCEDURAL ISSUES



- **Is UDRP confidential?**

SOME PROCEDURAL ISSUES



- **Paragraph 16 of the Rules**
- **The provider publishes the following case-related information on its web site:**
 - the domain name(s) in issue,
 - the date of formal commencement of the proceeding,
 - the case number assigned by that provider.
- **Unless the Panel has decided to hide certain portions of its findings, it publishes in full on its web site all decisions rendered under the UDRP.**

SOME PROCEDURAL ISSUES



What language of the Complaint?

SOME PROCEDURAL ISSUES



- **Paragraph 11**
- **the Complaint must be submitted in the same language as the domain name registration agreement**
- **Unless agreed otherwise**
- **Attachments to the Complaint may be in their original language (could be ordered to translate it)**
- **The final authority to determine the language of the proceeding lies with the Administrative Panel.**

SOME PROCEDURAL ISSUES



- **Problem:**
- **Ets Leobert, SARL v. Jeonngon Weo**
 - Agreement in Korean language
 - Panel decided to have the proceedings in two languages (to improve comfort of the parties – it was however not agreed)
- **LEGO Juris A/S v. Linecom**
 - Agreement in Korean language
 - Complaint of LEGO in English and then whole proceedings in English (without agreement)
 - The argument of panel was, that the domain name consisted of English words (mindstormslego.com)
 - At least there could be bilingual process as it happened in previous case...

Know the

rules!

4. Mandatory Administrative Proceeding.

This Paragraph sets forth the type of disputes for which you are required to submit to a mandatory administrative proceeding. These proceedings will be conducted before one of the administrative-dispute-resolution service providers listed at www.icann.org/en/dndr/udrp/approved-providers.htm (each, a "Provider").

a. Applicable Disputes. You are required to submit to a mandatory administrative proceeding in the event that a third party (a "complainant") asserts to the applicable Provider, in compliance with the Rules of Procedure, that

- (i) your domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights, and
- (ii) you have no rights or legitimate interests in respect of the domain name, and
- (iii) your domain name has been registered and is being used in bad faith.

Cumulative condition

UDRP PROCESS



Complainant has to prove:

- Domain name is **identical or confusingly similar** to a trademark in which complainant has rights
- No rights or **legitimate interests** in respect of current domain name
- Domain name has been registered and is being used in **bad faith**

1) IDENTICAL OR CONFUSINGLY SIMILAR



The test:

- comparison between the trademark and the domain name itself to determine likelihood of Internet user confusion.
- the relevant trademark would generally need to be recognizable as such within the domain name
- the content of website is irrelevant
- E.g. guinness.com



MISPELLED IS CONFUSINGLY SIMILAR

- *Wachovia Corporation v. Peter Carrington*, WIPO Case No. D2002-0775, <wochovia.com>, Transfer
- *Fuji Photo Film U.S.A., Inc. v. LaPorte Holdings*, WIPO Case No. D2004-0971, <fuijifilm.com>, Transfer
- *Express Scripts, Inc. v. Whois Privacy Protection Service, Inc. / Domaindeals, Domain Administrator*, WIPO Case No. D2008-1302, <expressscripts.com>, Transfer

2) LEGITIMATE INTEREST



What is legitimate interest?

- Bona fide offering of goods or services
- Commonly known as domain
- **Legitimate noncommercial or fair use of the domain name**
 - without intent for commercial gain to misleadingly divert consumers
 - or to tarnish the trademark or service mark at issue.
- Article 4(c) of the rules
- See e.g. *DaimlerChrysler A.G. v. Donald Drummonds*, WIPO Case No. [D2001-0160](#), **Not transferred**

3) BAD FAITH



What is bad faith?

- Attempt to sell, lease, etc. the domain (cybersquatting)
- Disrupt competitor's business
- Attract (for commercial gain) the visitors to the site via confusion

Article 4 (b) of the rules

3) BAD FAITH

b. Evidence of Registration and Use in Bad Faith. For the purposes of [Paragraph 4\(a\)\(iii\)](#), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.

MUST READ !

**WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition
("WIPO Jurisprudential Overview 3.0")**

<http://www.wipo.int/amc/en/domains/search/overview3.0/>

WIPO Guide to the Uniform Domain Name Dispute Resolution Policy (UDRP)

<http://www.wipo.int/amc/en/domains/guide/>

FUTURE

- **1th October 2016 – expiration of the agreement between IANA and National Telecommunications and Information Administration (Part of US Ministry of Commerce)**
- **Control of ICANN completely out of US gouvernement**
- **More complicated control of the decision making authorities and possible loss of transparency and quality of the process**



THANK YOU FOR YOUR ATTENTION!

QUESTIONS?

FILE A CASE!

udrp.expert4me.com

- Instructions will be sent via email!