



INTERNATIONAL  
INTELLECTUAL  
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INSTITUTE

**The UDRP: A Guide for SMEs and Consumers on  
Domain Names and Domain Name Disputes**



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## **Disclaimer**

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<b><u>1.0</u></b>	<b><u>DOMAIN NAMES, THE INTERNET, AND TRADEMARKS</u></b>	<b><u>6</u></b>
<b>1.1</b>	<b>THE INTERNET – A SHORT EXPLANATION</b>	<b>7</b>
<b>1.2</b>	<b>DISSECTING A DOMAIN NAME</b>	<b>8</b>
<b>1.3</b>	<b>THE DOMAIN NAME SYSTEM</b>	<b>9</b>
<b>1.4</b>	<b>TRADEMARKS</b>	<b>11</b>
<b>1.5</b>	<b>TRADEMARKS AND DOMAIN NAMES</b>	<b>13</b>
<b><u>2.0</u></b>	<b><u>HISTORY OF DISPUTES AND THE DOMAIN NAME SYSTEM</u></b>	<b><u>13</u></b>
<b>2.1</b>	<b>THE EVOLUTION OF DISPUTE RESOLUTION</b>	<b>13</b>
<b>2.2</b>	<b>THE BIRTH OF ICANN</b>	<b>14</b>
<b>2.3</b>	<b>APPROVAL OF THE UDRP</b>	<b>14</b>
<b><u>3.0</u></b>	<b><u>THE UDRP</u></b>	<b><u>15</u></b>
<b>3.1</b>	<b>INTRODUCTION</b>	<b>15</b>
<b>3.2</b>	<b>WHAT RULES APPLY</b>	<b>16</b>
<b>3.3</b>	<b>WHO USES THE UDRP</b>	<b>16</b>
<b>3.4</b>	<b>WHO DECIDES THE DISPUTES?</b>	<b>17</b>
<b>3.5</b>	<b>POWERS AND OBLIGATIONS OF THE PANEL</b>	<b>19</b>
<b>3.6</b>	<b>REMEDIES OF THE UDRP</b>	<b>19</b>
<b>3.7</b>	<b>LANGUAGE OF THE PROCEEDING</b>	<b>20</b>
<b>3.8</b>	<b>TIMELINE OF A UDRP DISPUTE</b>	<b>23</b>
<b><u>4.0</u></b>	<b><u>SUBSTANTIVE LAW OF THE UDRP</u></b>	<b><u>23</u></b>
<b>4.1</b>	<b>WHAT LAW DO THEY USE?</b>	<b>23</b>
<b>4.2</b>	<b>WHAT THE COMPLAINANT MUST PROVE</b>	<b>24</b>
<b>4.2.1</b>	<b>ELEMENT 1: THE DOMAIN NAME IS IDENTICAL OR CONFUSINGLY SIMILAR TO A TRADEMARK OR SERVICE MARK IN WHICH THE COMPLAINANT HAS RIGHTS;</b>	<b>25</b>
<b>4.2.2</b>	<b>ELEMENT 2: THE RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DOMAIN NAME</b>	<b>26</b>
<b>4.2.3</b>	<b>ELEMENT 3: THE DOMAIN NAME HAS BEEN REGISTERED AND IS BEING USED IN BAD FAITH</b>	<b>27</b>
<b>4.3</b>	<b>RESPONSE TO THE COMPLAINT</b>	<b>28</b>
<b>4.4</b>	<b>REVERSE DOMAIN NAME HIJACKING</b>	<b>29</b>
<b>4.5</b>	<b>ENFORCEMENT</b>	<b>30</b>
<b><u>5.0</u></b>	<b><u>WHOIS</u></b>	<b><u>31</u></b>

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<b>5.1</b>	<b>WHAT IS WHOIS</b>	<b>31</b>
<b>5.2</b>	<b>WHOIS AND PRIVACY</b>	<b>32</b>
<b>6.0</b>	<b><u>RELATIONSHIP TO NATIONAL LAW</u></b>	<b><u>33</u></b>
<b>6.1</b>	<b>THE UDRP AND NATIONAL COURTS</b>	<b>33</b>
<b>6.2</b>	<b>THE ACPA</b>	<b>34</b>
<b>6.3</b>	<b>BRINGING THE DISPUTE TO A NATIONAL COURT</b>	<b>34</b>
<b>7.0</b>	<b><u>CRITICISMS OF THE UDRP</u></b>	<b><u>35</u></b>
<b>7.1</b>	<b>PRIVACY, WHOIS, AND NOTIFYING THE RESPONDENT</b>	<b>35</b>
<b>7.2</b>	<b>THE PANEL DECISION IS NOT FINAL</b>	<b>35</b>
<b>7.3</b>	<b>TRADEMARK OWNER BIAS</b>	<b>36</b>
<b>7.4</b>	<b>NO SANCTIONS FOR REVERSE DOMAIN NAME HIJACKING</b>	<b>36</b>
<b>7.5</b>	<b>HARMFUL TO FREE SPEECH</b>	<b>36</b>
<b>8.0</b>	<b><u>APPENDIX</u></b>	<b><u>38</u></b>
<b>8.1</b>	<b>GLOSSARY OF TERMS</b>	<b>38</b>
<b>8.2</b>	<b>LINKS</b>	<b>38</b>
<b>8.3</b>	<b>LAW REVIEW, BOOKS, AND TREATISES</b>	<b>40</b>
 <b><u>ILLUSTRATIONS AND EXAMPLES USED IN THIS GUIDE</u></b>		
	<b>FIGURE 1. AN EXAMPLE DOMAIN NAME</b>	<b>8</b>
	<b>FIGURE 2. THE DOMAIN NAME SYSTEM</b>	<b>10</b>
	<b>FIGURE 3. USE OF UDRP BY CCTLDS</b>	<b>17</b>
	<b>FIGURE 4. UDRP TIMELINE</b>	<b>22</b>
	<b>FIGURE 5. ENFORCEMENT</b>	<b>31</b>

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## Introduction to this guide

This guide has been produced in order to give consumers and small and medium-sized enterprises, particularly those in developing countries, an introduction to disputes over domain names on the Internet. Domain names are the exclusive addresses used on the Internet to host services such as email and websites such as *example.com*. As businesses and consumers move online in greater numbers, they have a need to be informed of their rights and responsibilities in this new space in plain language.

The Uniform Dispute Resolution Policy, or UDRP, is a policy that has been developed with input from governments, international institutions, businesses, and consumers to address the conflict between one kind of intellectual property right – trademarks – and domain names (example.com). The UDRP is a unique answer to a unique problem: While the UDRP shares many similarities with traditional legal disputes, it also has many novel features that are important to fully grasp if you are moving your business online or creating your own website.

This guide starts by introducing the technical issues involved in domain names and explaining the purposes of trademark law as well as the history of the UDRP. This guide then dissects the UDRP and explains in a user-friendly way what the policy is, how disputes get decided, and how decisions are enforced. Next, the guide discusses WHOIS, which is a listing of the contact details of people and organizations who register domain names and is one of the methods for contacting domain name registrants for disputes under the policy. The following section evaluates the relationship between the UDRP and disputes in national court systems. Finally, in order to give a full picture of this policy, we conclude by listing some of its criticisms. A resource appendix follows at the end of this guide to assist you in finding out more about the UDRP and its role.

This guide is meant to be useful in primarily three ways:

- To help you evaluate the capabilities of a legal professional should you need to hire one in relation to a domain name dispute;
- So that you can better understand advice from a suitably-qualified legal professional in relation to disputes over domain names; and
- To provide a comprehensive guide and set of resources for independent study into domain name disputes and the UDRP.

Becoming informed about the UDRP is increasingly important for a number of reasons. It is often the first step in any dispute over a domain name. Use of the UDRP has been expanding through requirements in free trade agreements that use the UDRP as a model for individual countries' domain names, such as “.gt” for Guatemala. Internet access, particularly broadband access, continues to increase throughout the world and brings with it more and more businesses and users online every day. This guide is meant to be a first step in gaining some understanding about the policy and its implications for your activities on the Internet, and it is with this purpose that we hope you find it useful.

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## 1.0 Domain names, the Internet, and trademarks

This section gives an overview of how the Internet works and the role of domain names in the process. These concepts may be familiar to some readers, and this guide is designed so that readers may skip ahead if desired. However, the information in this section helps explain the origins of the UDRP and the enforcement process, and so it may be useful to review the concepts discussed here. After the discussion of the technical aspects, this section introduces trademarks and reviews the goals of protecting these intellectual property rights on the Internet. Finally, we will discuss the relationship between trademarks and domain names and why this caused so many problems during the first years of the Internet.

### 1.1 *The Internet – a short explanation*

The Internet is more than just a home computer connected to another far-away computer with some files to browse or pictures to download. At its roots, the Internet is a collection of globally connected networks joined by common protocols and policies. Communication over the Internet works by breaking down large chunks of information into very small “packets” of information. These packets are then delivered individually from one point on the network to another until they reach their final destination. Once the complete series of packets arrive at the destination computer, this computer reassembles them into a file, photograph, or other useful bit of information. During this process, each packet carries an Internet Protocol (IP) address identifying a specific destination on the Internet so that it can arrive at the correct location. The process is known as TCP/IP.

An example IP address: 208.77.188.166<sup>1</sup>

Because these IP addresses look like long phone numbers, they have also been given a user-friendly version called a domain name, which can be written with letters, numbers, and symbols in order to have greater meaning: the familiar “google.com” or “myspace.com”. Domain names must however be translated from the written address into the numerical IP addresses so that they can work – the computers that make up the Internet use the IP address to know where to retrieve the information from and deliver it to.

An example domain name: example.com

We could enter IP addresses directly into our browser windows (such as Internet Explorer or Firefox) instead of domain names, but it is more useful to have names that we can remember rather than long strings of numbers. The example IP address above could lead you to the same webpage as entering <http://www.example.com> directly into your web browser.

208.77.188.166 = <http://www.example.com><sup>2</sup>

As Mueller, author of *Ruling the Root* explains:

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<sup>1</sup> This is an IPv4 address: a new version of IP addresses known as IPv6 is in the process of being implemented.

<sup>2</sup> For simplicity and convenience, this Guide will often refer to full URLs rather than solely the second and top level domains.

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We tend to speak of the Internet as if it were a *thing*, but in reality the Internet is entirely virtual; it consists of nothing but a software protocol suite known as TCP/IP. The software enables any computer in the world to exchange information with any other computer, regardless of the particular physical networks to which they are attached or the hardware they use. It does this largely by giving computers addresses and names, and providing instructions about how to use them.<sup>3</sup>

The location of a destination on the Internet, whether it is an IP address or the more readable domain name, must be unique to work within this framework. The control over the rights to manage these unique identifiers is understandably a critical issue in the way that the Internet is governed. This control, along with other issues of administration is discussed further in Section 2, *History of disputes and the domain name system*.

There are several legal and policy issues that arise when discussing the administration of these unique identifiers, but because this guide focuses on domain names, it concentrates on trademarks and their relationship to domain names.

## 1.2 Dissecting a domain name

Let us look at some domain names, including the domain name we encountered earlier:

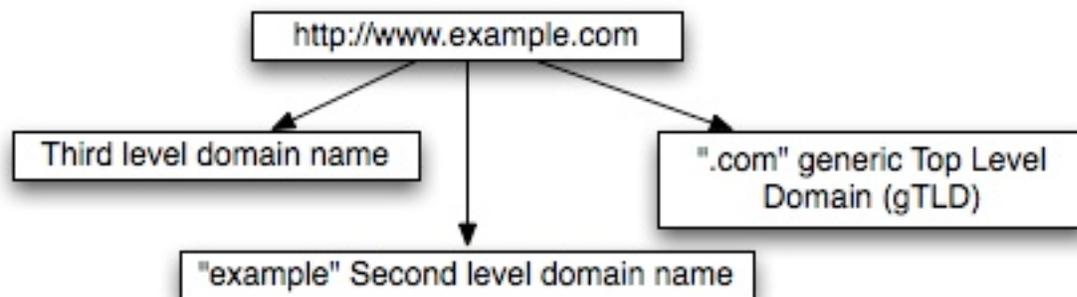


Figure 1. An example domain name

The rightmost portion is called the Top Level Domain (TLD) or First level domain – domain names are read by computers from right to left. This is the familiar “.com”, “.net,” or “.uk”. The part immediately to the left of the TLD is known as the second level domain; the part immediately after that is the third level domain, and so on.

Broadly speaking, there are two kinds of TLDs: generic TLDs (gTLDs) and country-code TLDs (ccTLDs). The gTLDs are a specific set of domain names, including: “.com”, “.net”, and “.org” as well as others such as “.museum”, “.info” and “.gov”.<sup>4</sup> The second grouping, ccTLDs, are top level

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<sup>3</sup> Milton L. Mueller, *Ruling the Root: Internet Governance and the Taming of Cyberspace*, p6 (MIT Press 2002) [hereinafter Mueller, *Ruling the Root*].

<sup>4</sup> See Internet Assigned Numbers Authority [hereinafter IANA], *Generic Top Level Domains*, <http://www.iana.org/gtld/gtld.htm> (a full list of generic TLDs). Note all web references were last visited on 26 July 2007.

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domain names divided up by country, using a standard list.<sup>5</sup> The domain name for the University of Edinburgh, <http://www.ed.ac.uk>, is in the ccTLD “.uk” for the United Kingdom. There are currently 20 gTLDs and 244 ccTLDs.<sup>6</sup>

Some TLDs, like “.com” allow anyone to register a name within that domain, and others restrict Registrants to those of a certain group. The gTLD “.gov” for example, is for the exclusive use of the government of the United States. “Credentialed professionals” such as doctors, accountants, and lawyers can obtain registrations in “.pro”. Some ccTLDs restrict their Registrants to those with some association to their country, and others operate on varying degrees of openness.

As mentioned, at each step in reading the domain name, from the TLD to the second level domain, to the third (and so on from right to left) must be unique. This means that there can be a google.com and a google.net, as well as a google.org and google.de (.de is the ccTLD for Germany), but there can only be one of each.

### ***1.3 The Domain Name System***

As mentioned, domain names need to correspond to IP addresses in order to function. At the beginning of the Internet, a small central authority simply accepted applications for domain names (of any type) and verified that they were unique and then put out a simple text file, *hosts.txt*, with the names and their corresponding IP addresses. With the growth of the Internet, this system reached its limits (it grew too large too fast) and the modern Domain Name System (DNS) was created, with the structure of separating names out with TLDs and so on that has already been discussed. It is important to understand the modern workings of this structure in order to grasp how the UDRP came into existence and how it is enforced.

It might help to think of each level of the DNS as a tree. To the right of every TLD is what is known as the *root* – you could think of every address as being the equivalent of google.com.root. Like a living tree, out of this root spreads all of the different TLDs. Out of these TLDs spreads all of the second level domain names, and then the third level names, and so on and so forth. Here is an example:

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<sup>5</sup> IANA, *Root-Zone Whois Index by TLD Code*, <http://www.iana.org/root-whois/index.html> (a full list of ccTLDs and their administrators).

<sup>6</sup> 244 ccTLDs are in use, though more have been assigned but not used, such as .bv for Bouvet Island.

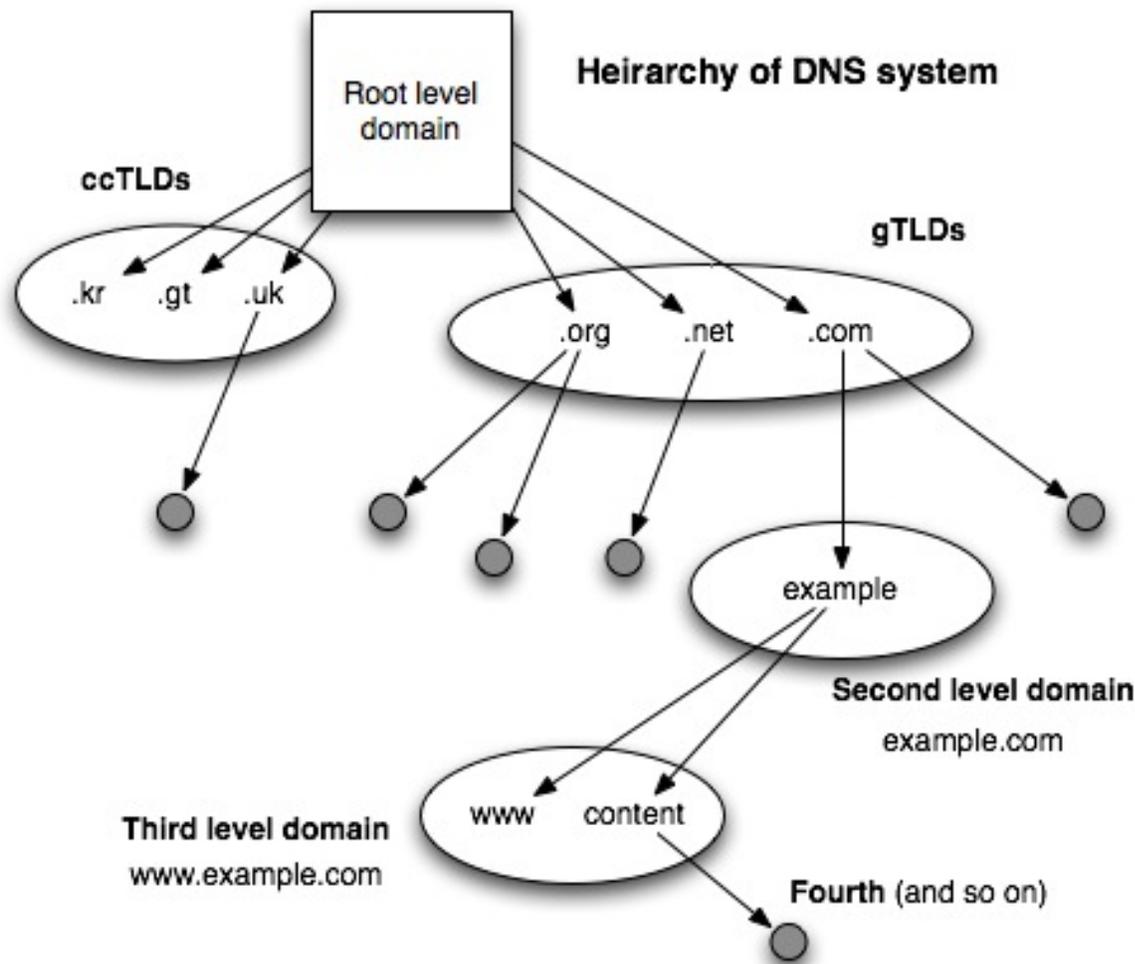


Figure 2. The Domain Name System

At each level is a set of information on where to find the materials requested or where to find the next element needed to resolve the request. So the root says where to find the TLD requested, the TLD then states where to find the second level domain name requested, and then that domain provides the information on where to find the next level. Remember that computers read domain names from right to left, so for `www.example.com` or `www.content.example.com` they look to the root, which tells them where to find `.com`. The `.com` part of the DNS then says where to find “example”, and finally `example.com` gives the location of “www” or “content” (such as “`content.example.com`”). These could be further divided into a fourth level, and so on.

This system, however, depends on everyone looking at the same place – the root – for their information about the first level of domain names: the TLDs. There are 12 root operators that run 13 addresses whereby computers can locate the root DNS information, and these addresses are known by their assigned letters, A-M. All thirteen addresses were formerly servers located in 13 locations in the United States and Europe, but now six of the thirteen have distributed the location of their servers throughout the world.<sup>7</sup>

<sup>7</sup> See Root Server Technical Operations Assn, *root-servers.org*, <http://www.root-servers.org/> (The servers are C, F, I, J, K and M).

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The information contained in these root servers determines what TLDs will be available when people look to these servers for that level of domain name information. All of the root servers look to only one location to get the definitive file for the root. The organization that controls the contents of the root file is ICANN, the Internet Corporation for Assigned Names and Numbers. How ICANN came to control this file will be covered in greater detail in the next section, but the fact that they exercise control over what domain names people can access by controlling the root is very important.

#### 1.4 Trademarks

The move from IP addresses to more easily remembered domain names may have made navigation of the Internet easier, but with this added meaning came added difficulties. As we have seen, for domain names to work they must be unique. Because this uniqueness means that the use of a word or phrase can only be given to one person or entity in the entire world, this has caused conflict, particularly with trademark law.

Trademarks have been defined as:

Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark. Such signs, in particular words including personal names, letters, numerals, figurative elements and combinations of colors as well as any combination of such signs, shall be eligible for registration as trademarks.<sup>8</sup>

Trademarks can be combinations of letters and numerals, as well as designs, and colors. Smells, sounds, and even taste can be trademarks in some legal systems. For the purposes of domain names however, the DNS was originally designed for only combinations of the Roman alphabet letters a through z, numbers 0-9 and the plus, period, and hyphen characters.<sup>9</sup> As a result, this guide concentrates on discussing marks made up of these symbols, rather than designs, sounds, smells, or colors.

#### Internationalized Domain Names

The DNS system works only with domain names that contain a limited character set based on the Latin alphabet known as ASCII: primarily A-Z and 0-9. This limitation is generally unnoticed by English-speaking communities and ASCII was subsequently extended to cover languages that use the basic Latin alphabet plus diacritical marks such as the German ü or Spanish í. Because of this limited character set, languages that use a non-Latin alphabet such as Cyrillic, Arabic, or Japanese present a unique problem for domain names – they must use a Latin-alphabet equivalent. To counter this problem, ICANN has introduced **Internationalized Domain Names**. An Internationalized Domain Name (or IDN) is a domain name that is available to an Internet user in a non-ASCII character set. A user types a URL in their local language, which is then converted into an equivalent string of characters in the ASCII set.<sup>10</sup>

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<sup>8</sup> *Trade Related Aspects of Intellectual Property Rights (TRIPS)* art. 15.1 [http://www.wto.org/english/docs\\_e/legal\\_e/legal\\_e.htm#TRIPS](http://www.wto.org/english/docs_e/legal_e/legal_e.htm#TRIPS).

<sup>9</sup> See RFC 1738 *Uniform Resource Locators (URL)*, <http://www.faqs.org/rfcs/rfc1738.html> (The Request For Comments, RFCs, are an influential series of documents created by the Internet community to develop standards for how the Internet functions).

<sup>10</sup> For an example of characters and how they are converted to a non Latin-alphabet language, see IANA, *.JP Japanese Character Table*, <http://www.iana.org/assignments/idn/jp-japanese.html>. Relevant RFCs for IDNs are: RFC 3490, RFC 3491, and RFC 3492. See Internet FAQ Archives, *Internet RFC/STD/FYI/BCP Archives* <http://www.faqs.org/rfcs/>. See also resources collected at ICANN, *Internationalized Domain Names* <http://www.icann.org/topics/idn.html>.

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Trademarks must be distinctive in order to be protected. Words that are *generic* for that product or service – words that simply describe what a product is – will not be protected by trademark law. Words that are *descriptive* of a product can become trademarks if they acquire distinctiveness through use of the mark. In other words, if the use of a descriptive term on a product over a period of time has created a close association with those words and that particular manufacturer, then they may become a trademark.

Trademarks have several different functions, including:

- Identifying that the goods or services come from a single source, and helping to distinguish those goods or services from others;
- Indicating that all goods or services associated with the mark are of a uniform quality;
- Allowing for advertising or branding campaigns based around the mark; and
- Creating associations of sponsorship or endorsement when used with other goods or services.

Trademark, like many other areas of intellectual property (such as copyright or patents), has an international framework. This framework relies on two major principles:

1. **National treatment** – trademark treaty members give the citizens of other treaty members the same rights as their own citizens.
2. **Minimum standards** – treaty members must comply with a minimum set of standards, but are free to implement higher protection if they wish.<sup>11</sup>

Though there is an international framework, trademarks are generally granted on a nation-by-nation basis, and there is no single international trademark covering all countries of the world. Thus, the rights to use a specific symbol for a good or service could be held by different producers in different countries.<sup>12</sup> There are, just to note, several international systems for coordinating trademark registration, such as the Community Trade Mark for the European Community and the Benelux system.<sup>13</sup> These and treaties such as the Madrid Protocol can be used to obtain trademark rights in multiple countries at the same time.

Trademarks are also limited to a certain class of goods or services, even within a legal system. Thus trademark law would generally allow for there to be both a car manufacturer and a plumbing supply company with the mark TULIP, because it is unlikely that consumers would confuse the two. Trademark law therefore allows for overlapping use in the two following situations:

1. Use of the same mark for the *same* goods or services, but in *different* geographic locations; and
2. Use of the same mark for *different* goods or services in the *same* geographic location.

As noted, when looked at globally, trademark law allows many different parties to use the same mark, even for the same goods and services. But the Internet only provides a limited number of possibilities for domain names and requires that each name be unique. Different producers of goods and services from all over the world, that previously had nothing to do with one another, were all of a sudden

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<sup>11</sup> See e.g. TRIPS art. 1.1 (minimum standards) and art. 1.3 (national treatment) [http://www.wto.org/english/docs\\_e/legal\\_e/legal\\_e.htm#TRIPs](http://www.wto.org/english/docs_e/legal_e/legal_e.htm#TRIPs).

<sup>12</sup> For an example of a nation-by-nation dispute in trademark and geographical indications, see the dispute over BUDWEISER for beer. Robert C. Bird, *This Bud's For You: Understanding International Intellectual Property Law Through the Ongoing Dispute over the Budweiser Trademark*, 23 J. Legal Stud. Educ. 53 (2006).

<sup>13</sup> The Benelux countries are Belgium, the Netherlands, and Luxembourg. The Benelux Office of Intellectual Property is at <http://www.boip.int/>.

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competing for the use of the same word or phrase in a domain name.

### **1.5 Trademarks and domain names**

At the dawn of the commercial use of the Internet, many people recognized the value in owning a domain name for an established mark. This value can be especially high because some people type names of goods or services directly into their web browser as a means of finding websites (versus using a search engine such as Google). Domain names have generally been given on a first-come first-served basis. If a trademark holder was slow to register a domain name for one of their word marks, a third party could come along and get the registration and thus the domain name. The Registrant could either have a valid reason, such as selling its own goods or services that legitimately contain the mark. However, the Registrant could be merely trying to exploit someone else's trademark. Because registering a domain name is relatively cheap, some attempted to register domain names for marks that they did not own specifically in order to sell the domain name back to the legal owner of the mark for large sums of money. This process became known as *cybersquatting*. "Squatting" is a term used for unlawfully occupying land or a building. In this case, cybersquatters identified popular trademarks or variations of trademarks that were available, and subsequently registered the name (occupying it) in the hopes of selling or otherwise exploiting the domain name for large amounts of money.

Cybersquatting instantly became a big problem on the Internet because trademark owners felt that they should have the rights over their name on the Internet and that the use by cybersquatters was driving away customers and otherwise hurting their mark's reputation. Because domain name registrations were inexpensive and easy to obtain, cybersquatters often registered many variations on a trademark in the most popular top level domains such as ".com", ".net", and ".org".

Existing legal causes of action could be very difficult for trademark owners to enforce their rights in this new arena. Court cases are long and expensive and sometimes judges encountered great difficulty in applying traditional requirements of certain causes of action to domain names. In addition, because the users of domain names came from all over the world, the different legal systems and burden of international litigation added a further layer of complexity – domain name Registrants and trademark holders could be on completely different sides of the world. It quickly emerged that another procedure to resolve disputes over trademarks and domain names other than litigation in national courts was needed. The solution, the Uniform Domain Name Dispute Resolution Policy (UDRP), was introduced and came into effect in 1999.

## **2.0 History of disputes and the domain name system**

Cybersquatting, the DNS, and the evolution of Internet governance are all parts of the deep and rich history of the Internet. This section conveys only a very general overview of this history in order to place the discussion of the UDRP and how it works in greater context. If interested, readers should consult the Appendix for sources that discuss this history in more detail.

### **2.1 The evolution of dispute resolution**

Before 1995, there was no formal dispute resolution policy for disputes over trademarks and domain names. In July of 1995, Network Solutions Incorporated (NSI), a private company that had managerial responsibility over the domain name system (DNS), put in place a procedure where registered trademark holders could present proof that their mark was identical to a domain name. If the Registrant

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could not provide their own proof of trademark registration for the domain, then NSI would compel a transfer after 90 days or place a hold on the domain name so that neither party could use it.<sup>14</sup> This policy was subsequently amended in 1996 in order to address shortcomings with the policy, and in 1998 the process started for a new policy.<sup>15</sup>

During this same time period from 1995 to 1998, the Internet itself was growing, more disputes were being brought under NSI's policy, and trademark holders and registrants were growing dissatisfied with the results.<sup>16</sup> In February of 1998, an agency of the United States Department of Commerce released a draft discussion paper called the "Green Paper" which proposed greater international participation (the US government played a primary role with the internet at this time), privatization of the DNS, and increased competition in registry services.<sup>17</sup> After a consultation period, a "White Paper" was produced in June of 1998 that called for an international initiative led by the World Intellectual Property Organization (WIPO) to come up with a dispute resolution procedure dealing with cybersquatting while leaving legitimate trademark infringement disputes to national courts.<sup>18</sup>

## 2.2 *The birth of ICANN*

In the 1980's the Internet was a mostly a self-governing community, and people that played a key role in shaping the Internet, such as Jon Postel, could readily coordinate what was a fairly close group.<sup>19</sup> But as the Internet grew in the 1990's it was quickly realized that a more formal structure was needed. The Green Paper and the later White Paper (mentioned above) were both intended to address the issue of the Internet's structure as well as the problems of dispute resolution. These two documents were part of a large and controversial debate over how core aspects of the Internet were to be governed. Was it to be by a new international body? By part of the United Nations? Were governments to be directly involved? Out of the process that followed the release of these two papers, ICANN, the Internet Corporation for Assigned Names and Numbers, was created as the solution for a governing institution for the internet and specifically for matters related to the DNS (as was proposed in the White Paper). The United States Department of Commerce officially recognized ICANN on February 26, 1999, and as a result it became the governing institution for dispute resolution issues related to domain names.<sup>20</sup>

## 2.3 *Approval of the UDRP*

From July of 1998 to April of 1999, WIPO held its consultative process on domain name disputes (as called for in the White Paper) and delivered a report to the newly formed ICANN that outlined a dispute resolution process that dealt with cybersquatting. After going through some internal processes at ICANN, including a public comment period, the final aspects of the Uniform Domain Name Dispute Resolution Policy (UDRP) was approved on October 24<sup>th</sup>, 1999. On November 29<sup>th</sup>, WIPO was

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<sup>14</sup> Michael A. Geist, *Fair.com?: An Examination of the Allegations of Systemic Unfairness in the ICANN UDRP*, 27 Brook. J. Int'l L. 903, 914-15 (August 2001). (also available at SSRN: <http://ssrn.com/abstract=280630>).

<sup>15</sup> *Id.* at 915-918.

<sup>16</sup> *Id.*

<sup>17</sup> *A Proposal to Improve Technical Management of Internet Names and Addresses*, 63 Fed. Reg. 8825 (1998) (the "Green Paper") <http://www.ntia.doc.gov/ntiahome/domainname/022098fedreg.htm>.

<sup>18</sup> *Management of Internet Names and Addresses*, 63 Fed. Reg. 31,741 (1998). (the "White Paper") [http://www.ntia.doc.gov/ntiahome/domainname/6\\_5\\_98dns.htm](http://www.ntia.doc.gov/ntiahome/domainname/6_5_98dns.htm).

<sup>19</sup> Mueller, *Ruling the Root*, at 164-5.

<sup>20</sup> For more of this history, see Mueller *Ruling the Root*, Chapter 8.

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approved as a dispute resolution provider under the policy and December 1<sup>st</sup> was the first date that complaints under the policy could be submitted.<sup>21</sup> On December 9<sup>th</sup>, 1999, the first proceeding, *World Wrestling Federation Entertainment, Inc. v. Michael Bosman* was heard by WIPO.<sup>22</sup> A new way of handling domain name disputes was born.

### 3.0 The UDRP

#### 3.1 Introduction

The introduction of the UDRP was innovative in primarily two areas. First, except in extremely rare circumstances there is no live hearing – no teleconferences, webconferences, or in-person arguments by either side. Second, the communications and filings involved in a dispute occur primarily online: via email. In the previous two sections, we have seen the technical restrictions that set up the problem of disputes over trademarks in domain names, and the history of how ICANN came to deal with this problem. The UDRP was their response, and in this section we will go through the basics of the policy. In the next section, 4.0, we will discuss the more substantive aspects of the law behind the UDRP.

At this point it should be noted that there are other dispute policies besides the UDRP that are in place and that deal with the problems of domain names and trademarks. Some ccTLDs have come up with their own dispute policies, such as the European Union’s “.eu” domain and its policy.<sup>23</sup> In addition, ICANN has other dispute policies that it applies in some gTLDs, such as the “Qualification Challenge Policy” for registrants in .pro. This policy allows for challenging whether Respondents are licensed professionals, which is, as mentioned, a requirement for a .pro registration.

We focus in on the UDRP for several reasons. It covers the majority of gTLDs, including the very popular .com and .net domains. Approximately 7 million out of 11.7 million new registrations in the first quarter of 2007 were in .com and .net. On the whole, there are approximately 128 million TLD registrations, with 69 million of those being .com and .net, reflecting 54% of all registrations.<sup>24</sup> In addition, the UDRP is also followed by several ccTLDs as their dispute policy, which we examine further in section 3.3.

The following definitions might be helpful when reading the remaining sections of this guide:

**Complainant** – The party filing a complaint against a Respondent of a domain name.

**Registrant** – Someone who has registered a domain name and agreed to the UDRP in the registration agreement.

**Respondent** – Another term used for a Registrant, and is used for a Respondent that is expected to respond to a complaint made via the UDRP framework.

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<sup>21</sup> ICANN, *Timeline for the Formulation and Implementation of the Uniform Domain-Name Dispute-Resolution Policy*, <http://www.icann.org/udrp/udrp-schedule.htm>.

<sup>22</sup> See *World Wrestling Federation Entertainment, Inc. v. Michael Bosman*, WIPO/D99-0001, Transfer <http://www.wipo.int/amc/en/domains/decisions/html/1999/d1999-0001.html>.

<sup>23</sup> For more information on the .eu policy, see Arbitration Center for .EU disputes, *ADR.eu*, <http://www.adr.eu/>.

<sup>24</sup> Verisign, *Verisign Domain Name Industry Brief*, Vol. 4(3), June 2007. <http://www.verisign.com/static/042161.pdf>.

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### 3.2 What rules apply

There are three primary sets of rules that govern a domain name dispute.<sup>25</sup> They are:

1. **The Uniform Domain Name Dispute Resolution Policy (UDRP).** These rules are available at: <http://www.icann.org/udrp/udrp-policy-24oct99.htm>
2. **The Rules for the UDRP (“The Rules” or “Uniform Rules”).** All dispute resolution providers follow these (mostly procedural) rules set out by ICANN. They are available at: <http://www.icann.org/dndr/udrp/uniform-rules.htm>
3. **Supplemental rules set down by the individual dispute resolution provider.** Each provider has a set of supplemental rules that also apply for the cases they handle. A list of current providers and their supplemental rules is available at: <http://www.icann.org/dndr/udrp/approved-providers.htm>

Registrant’s agree to the above rules when they enter into their contract for registration with the Registrar for their domain name. The first set of rules, the policy itself, states under what circumstances a dispute can be issued and how the dispute is decided. The Uniform Rules for the UDRP and each provider’s supplemental rules deal with procedural issues, including such criteria as how word limits on written submissions and specifying due dates for responses. We will primarily be discussing the UDRP and the Uniform Rules, though it is important to remember that the supplemental rules will also apply, and will be different depending on who is selected for the dispute.

### 3.3 Who uses the UDRP

The UDRP is used by all ICANN-accredited registrars for the gTLDs. This includes:

- .aero – Reserved for members of the air-transportation industry;
- .asia – Reserved for legal entities in the Pan-Asia and Asia-Pacific region;
- .biz – Reserved for businesses;
- .cat – Reserved for members of the Catalan community;
- **.com – Open to any Respondent;**
- .coop – Reserved for cooperatives;
- .info – Open to any Respondent;
- .jobs – Reserved for the human resources industry;
- .mobi – Reserved for mobile services consumers and providers;
- .museum – Reserved for museums;
- .name – Reserved for individuals;
- **.net – Open to any Respondent;**
- **.org – Open to any Respondent;**
- .pro – Reserved for professionals;
- .tel – Reserved for publications of contact data;
- .travel – Reserved for the travel industry.<sup>26</sup>

The UDRP has also been adopted by several ccTLDs as the dispute policy for their domain. According to information collected by WIPO, 54 ccTLDs either have adopted the UDRP in whole or have adopted a version of the UDRP. Of these, 33 ccTLDs use the UDRP and an additional 21 use a variant of the

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<sup>25</sup> ICANN, *Uniform Domain Name Dispute Resolution Policy*, §1. Purpose <http://www.icann.org/udrp/udrp-policy-24oct99.htm> [hereinafter UDRP].

<sup>26</sup> IANA, *Generic Top Level Domains*, <http://www.iana.org/gtld/gtld.htm> (emphasis added).

UDRP. 41 ccTLDs use another alternative dispute resolution (ADR) procedure such as mediation, arbitration, or a non-UDRP administrative hearing. The remaining 149 ccTLDs do not report an ADR procedure.<sup>27</sup>

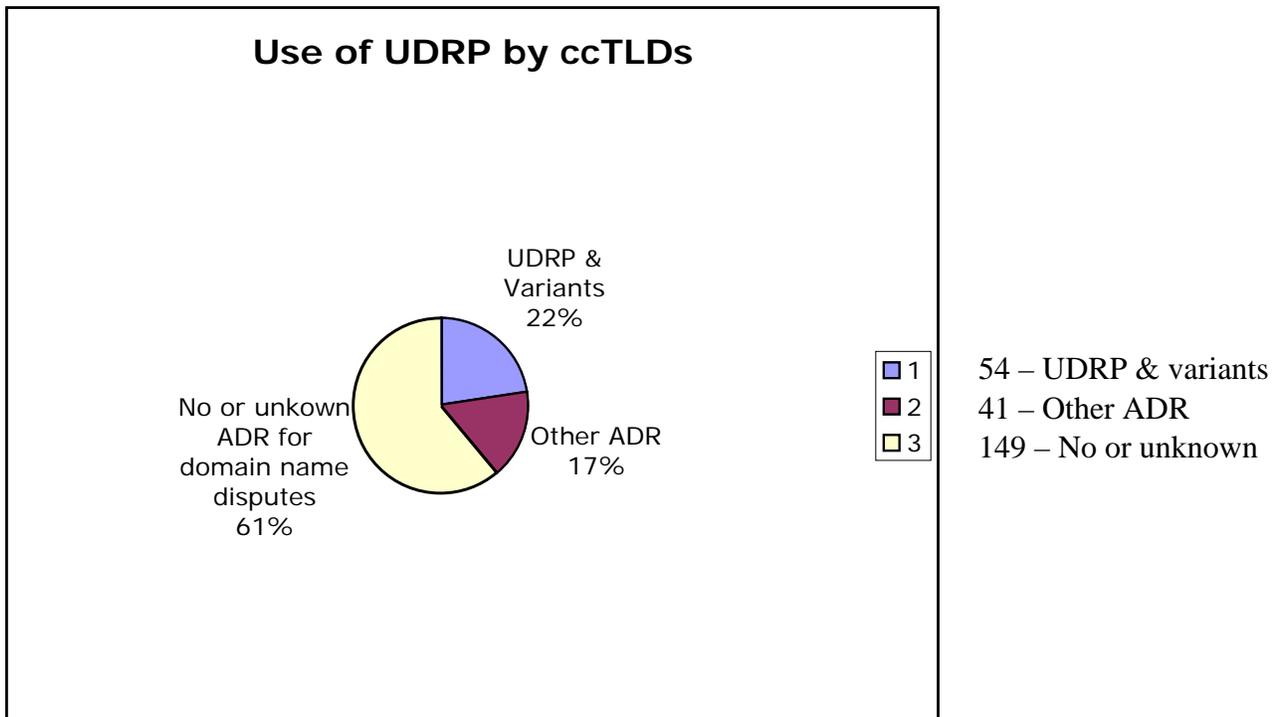


Figure 3. Use of UDRP by ccTLDs

Source: WIPO, *Arbitration and Mediation Center ccTLD Database*, [http://www.wipo.int/amc/en/domains/cctld\\_db/output.html](http://www.wipo.int/amc/en/domains/cctld_db/output.html)

This number is expected to grow, as requirements to implement the UDRP for a country’s ccTLD have been increasingly used in various Regional Trade Agreements (RTAs), including the Dominican Republic–Central American Free Trade Agreement (DR-CAFTA) and the Korea–United States Free Trade Agreement (KORUS).<sup>28</sup> In addition, the use of the UDRP is suggested by WIPO in its document *ccTLD Best Practices for the Prevention and Resolution of Intellectual Property Disputes*.<sup>29</sup> As a result, the UDRP is in use all over the world and applies to a wide variety of domains. Understanding the basics of the UDRP is a crucial step in protecting your rights online – either as a consumer asked to respond to one of these proceedings or as a mark holder needing to enforce their rights on the Internet.

### 3.4 Who decides the disputes?

There are currently three approved providers for the UDRP, and only approved providers may be used

<sup>27</sup> WIPO, *Arbitration and Mediation Center ccTLD Database*, [http://www.wipo.int/amc/en/domains/cctld\\_db/output.html](http://www.wipo.int/amc/en/domains/cctld_db/output.html).

<sup>28</sup> DR-CAFTA art. 15.4.1 and KORUS art. 18.3.1 (both available on the USTR website, [http://www.ustr.gov/Trade\\_Agreements/Bilateral/Section\\_Index.html](http://www.ustr.gov/Trade_Agreements/Bilateral/Section_Index.html)). See also Abbe E.L. Brown, Andres L. Guadamuz, and Jordan S. Hatcher, *The Impact of Free Trade Agreements on Information Technology Based Business* (2007) <http://ssrn.com/abstract=984864>.

<sup>29</sup> WIPO, *ccTLD Best Practices for the Prevention and Resolution of Intellectual Property Disputes*, <http://www.wipo.int/amc/en/domains/bestpractices/bestpractices.html>.

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for disputes under the policy.<sup>30</sup> They are:<sup>31</sup>

- **The World Intellectual Property Organization** – WIPO is an international agency of the United Nations that was established in 1967 to promote and develop international aspects of intellectual property law and policy. WIPO has an *Arbitration and Mediation Center* that was established in 1994 to offer services for the resolution of disputes. WIPO's Arbitration and Mediation Center has been a provider for UDRP disputes since December 1<sup>st</sup>, 1999.<sup>32</sup>
- **The National Arbitration Forum** – NAF is a provider of neutral administration services for alternative dispute resolution from 1986. Though NAF is located in the United States, it serves in disputes from throughout the world and has an international roster of panelists for UDRP disputes. NAF has been a provider under the UDRP from December 23<sup>rd</sup>, 1999.<sup>33</sup>
- **Asian Domain Name Dispute Resolution Centre** – The ADNDRC is a group of three different organizations – the China International Economic and Trade Arbitration Commission (CIETAC), the Hong Kong International Arbitration Centre (HKIAC) and the Korean Internet Address Dispute Resolution Committee (KIDRC). It has three different offices based on the locations of these organizations, and has a set of supplemental rules for the UDRP that governs each office. The offices are in Beijing, Hong Kong, and Seoul. ADNDRC has provided services for UDRP disputes from February 28<sup>th</sup>, 2002.<sup>34</sup>

There are two former dispute providers, CPR: International Institute for Conflict Prevention and Resolution and eResolution, but neither one currently accepts UDRP disputes.<sup>35</sup>

UDRP disputes are decided by either one or three panelists. The Complainant mark holder decides in their complaint whether they would like one or three panelists. If the Complainant selected the use of only one panelist, the Respondent domain name holder can, in their response to the complaint, request three panelists. WIPO, for example, maintains a list of approved panelists along with a brief biography of each at its website.<sup>36</sup> WIPO describes their list of panelists as follows:

The persons appearing on the WIPO Center's list of Domain Name Panelists have been selected on the basis of their well-established reputations for their impartiality, sound judgment and experience as decision-makers, as well as their substantive experience in the areas of international trademark law, electronic commerce and Internet-related issues. The WIPO Center's list is truly international, consisting of more than 250 Panelists from 42 countries, many of whom are multi-lingual.<sup>37</sup>

It has been commented that some panelists receive more disputes than others. In a study in 2001, with

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<sup>30</sup> UDRP §4 *Mandatory Administrative Proceeding*.

<sup>31</sup> ICANN, *Approved Providers for Uniform Domain-Name Dispute-Resolution Policy* <http://www.icann.org/dndr/udrp/approved-providers.htm>.

<sup>32</sup> WIPO, *Homepage*, <http://wipo.int/>. WIPO, *Arbitration and Mediation Center*, <http://www.wipo.int/amc/en/index.html>.

<sup>33</sup> NAF, *Homepage*, <http://www.arb-forum.com/>. See also their alternative site for UDRP disputes: *Domain-Disputes.com, Homepage*, <http://www.domain-disputes.com/>. NAF, *Panelist search*, <http://domains.adrforum.com/panel.aspx>.

<sup>34</sup> ADNDRC, *Homepage*, <http://www.adndrc.org/adndrc/index.html>.

<sup>35</sup> Former provider eResolution closed, and CPR stopped doing UDRP disputes. See ICANN, *Former Providers for Uniform Domain-Name Dispute-Resolution Policy*, <http://www.icann.org/dndr/udrp/former-providers.htm>.

<sup>36</sup> WIPO, *Domain Name Panelists*, <http://www.wipo.int/amc/en/domains/panel/panelists.html>.

<sup>37</sup> WIPO, *WIPO Guide to the Uniform Domain Name Dispute Resolution Policy (UDRP)*, <http://www.wipo.int/amc/en/domains/guide/index.html>.

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an update in 2002, of the 4,333 decisions that were examined, the top five panelists participated in 788 decisions – or approximately 18% of all decisions issued.<sup>38</sup> The top five panelists at this time all came from the United States and included four current or retired judges at the trial court level and two professional mediators. The top two panelists alone represented a combined 9.4% of all UDRP decisions.<sup>39</sup>

### 3.5 Powers and obligations of the Panel

UDRP Rule 10 lays out the powers of the panelists in a UDRP dispute:

#### 10. General Powers of the Panel

- (a) The Panel shall conduct the administrative proceeding in such manner as it considers appropriate in accordance with the Policy and these Rules.
- (b) In all cases, the Panel shall ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case.
- (c) The Panel shall ensure that the administrative proceeding takes place with due expedition. It may, at the request of a Party or on its own motion, extend, in exceptional cases, a period of time fixed by these Rules or by the Panel.
- (d) The Panel shall determine the admissibility, relevance, materiality and weight of the evidence.
- (e) A Panel shall decide a request by a Party to consolidate multiple domain name disputes in accordance with the Policy and these Rules.

Though they are characterized as “powers”, rules 10(b) and the first sentence of 10(c) are really obligations on the panelists to be fair and impartial with each dispute and to resolve each dispute quickly – much like a judge in a case before a court. The rest provide the panel with the power to decide what documents that they will consider [10(d)], to extend deadlines [10(c)], hear more than one dispute over multiple domain names at the same time [10(e)] and generally do what is needed to resolve a case quickly and fairly [10(a)].

### 3.6 Remedies of the UDRP

There are only two remedies that Complainants can ask for:

1. **Cancellation of the registration.** This means that the person who originally registered the domain name has lost that domain name and it is now available for registration. Normally Complainants wishing to prevent the use of a domain name by anyone other than themselves would not seek this remedy, as the name can be registered on a first-come, first-served basis by anyone after the cancellation.
2. **Transfer of the registration to the Complainant.** The registration of the domain name is transferred to the Complainant, who must then pay the registration fee and now owns the domain name.

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<sup>38</sup> The actual number may be somewhat lower due to these members serving on three arbiter panels together. However, given the low proportion of three panel decisions this difference is minimal. All statistics from UDRPinfo.com, *Homepage*, <http://www.udrpinfo.com>. This site is based off of statistics collected by Michael Geist in 2001-02. For up-to-date statistics from WIPO disputes only, see WIPO, *WIPO Domain Name Dispute Resolution Statistics*, <http://www.wipo.int/amc/en/domains/statistics/>.

<sup>39</sup> *Id.*

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Notably, panelists under the UDRP cannot award *damages* to the Complainant (paid by the Respondent), issue *sanctions* against the Complainant for bringing a frivolous claim (also known as “Reverse Domain Name Hijacking”), or order the Respondent to refrain from certain activities, such as registering more domain names related to the mark at issue (an injunction or interdict). If a party wishes to seek any of these remedies, the party will need to go to a national court.

### Practice tip – Choosing 1 or 3 panelists

A study in 2001 and updated in 2002 argued that 3 member panel decisions favor the Respondent over single member panels for decisions where the Respondent has filed a response.<sup>40</sup> However, since the majority of the decisions in this study are Respondent-default (no response), this may simply indicate that Respondents are likely to default when the case is weak, and request 3 panelists when the case is stronger. Because default may be more likely, Complainants often can conserve costs by requesting a single member panel. Respondents should consider requesting a three-member panel in order to offset any bias by the single-member process, though this request will result in a fee for the additional panelists being paid by the Respondent.<sup>41</sup>

So for example a dispute involving a single domain name under the WIPO rules would result in the following fees:

<i>Single Panelist</i>	\$1,500 USD payable by Complainant
<i>Three Panelists</i> , requested by Complainant	\$4,000 USD payable by Complainant
<i>Three Panelists</i> , requested by Respondent	\$2,000 USD payable by Respondent
	\$2,000 USD payable by Complainant <sup>42</sup>
	(Consult the WIPO site for more details)

### 3.7 Language of the proceeding

The Internet is a global place, and, particularly with .com, domains are registered to people and organizations all throughout the world. This means that the language of the Complainant or the Respondent may differ. Because of this, disputes under the UDRP must be conducted in the language of the registration agreement – the agreement signed by the person registering a domain name and the registrar – unless otherwise agreed by the parties or allowed for in the registration agreement itself.<sup>43</sup> Panelists can order the translation of documents sent in another language.<sup>44</sup>

Registrants should take care when registering a domain name to use a registrar who provides an agreement in a language they feel comfortable with the possibility of a UDRP proceeding being conducted in. When selecting panelists, there are panelists available who speak languages such as

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<sup>40</sup> See Geist, *Fair.com* supra; Michael Geist, *Fundamentally Fair.com? An Update on Bias Allegations and the ICANN UDRP*, <http://aix1.uottawa.ca/~geist/fairupdate.pdf>; UDRPinfo.com, *UDRP Decisions*, <http://www.udrpinfo.com/dcsn.php#data>.

<sup>41</sup> M. Scott Donahey, *Internet Law and Practice* 16:13 (West 2006) [hereinafter Donahey, *Internet Law and Practice*].

<sup>42</sup> See WIPO, *Schedule of Fees under the UDRP (valid as of December 1, 2002)*, <http://www.wipo.int/amc/en/domains/fees/index.html>.

<sup>43</sup> Donahey, *Internet Law and Practice*, 16:16. See also *WIPO Overview* §4.3.

<sup>44</sup> Donahey, *Internet Law and Practice*, 16:16.

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Spanish, Korean, Dutch, French, and German.<sup>45</sup> Most disputes however, are conducted in English and it might be beneficial to retain a legal expert with a working knowledge of English and/or request a bilingual panelist in order to take full advantage of the wealth of published disputes available in English.<sup>46</sup>

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<sup>45</sup> WIPO, *WIPO Domain Name Panelists*, <http://www.wipo.int/amc/en/domains/panel/panelists.html>. See WIPO, *All case languages (ranking): all years*, [http://www.wipo.int/amc/en/domains/statistics/languages\\_yr.jsp?year=](http://www.wipo.int/amc/en/domains/statistics/languages_yr.jsp?year=) (statistics on case languages).

<sup>46</sup> See WIPO, *All Case Languages (Ranking): All Years*, [http://www.wipo.int/amc/en/domains/statistics/languages\\_yr.jsp?year=](http://www.wipo.int/amc/en/domains/statistics/languages_yr.jsp?year=)

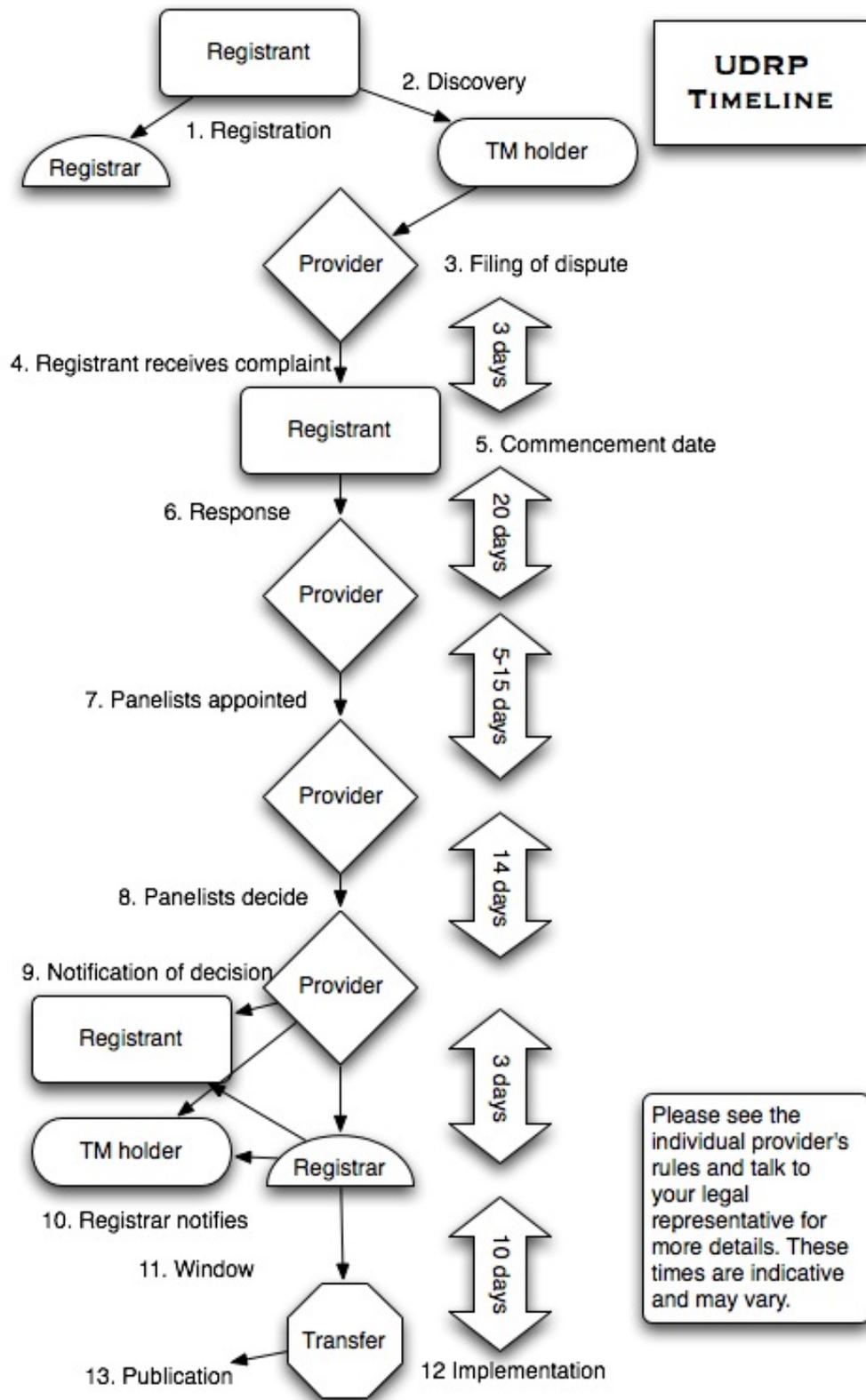


Figure 4. UDRP Timeline

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### **3.8 *Timeline of a UDRP dispute***

Here is a timeline of a dispute based on the Uniform Rules and the WIPO supplemental rules:

1. Registration of potentially infringing domain name with an ICANN-approved registrar in a UDRP-governed gTLD. Respondent consents in the registration agreement to the use of the UDRP for disputes over the domain name.
2. Trademark holder discovers the use of their mark in a domain name and believes it to be infringing.
3. TM holder prepares and submits complaint to an ICANN approved dispute resolution provider.
4. Within 3 days of receiving the complaint, provider forwards on the complaint to the Respondent.
5. Commencement date of the dispute begins once the provider forwards on the complaint.
6. The Respondent has 20 days to file a response. If they do not, the dispute is heard on the complaint alone.
7. Once provider receives a response, or the date when a response should have been received has passed, the panelists are appointed. In one-panelist disputes this happens within 5 days, in three-panelist disputes, this can take up to 15 days.
8. Panelists will usually decide the dispute within 14 days, though in the case of three panelists this is often extended because of scheduling. The decision is then sent to the dispute resolution provider.
9. The provider has 3 days to send the decision on to the parties, including the registrar.
10. “Immediately” the registrar must communicate to the parties the date of the implementation of that decision if the domain name is to be transferred or the registration cancelled.
11. There is a 10-business day window to file a claim to a national court system before the registrar implements the decision.
12. Implementation of the decision by the registrar or appeal to the courts. If appealed to the courts, then the UDRP expresses a policy of maintaining the status quo while the dispute takes place.
13. Decision is published on the provider’s website.

### **4.0 *Substantive law of the UDRP***

The previous section covered the three sets of rules that come into play in a dispute, who decides the disputes and their powers, and went through the timeline of a UDRP dispute. This section explores the substantive rules used by panelists to decide disputes. We will start out by looking at what the Complainant must prove, and then what the Respondent must prove.

#### **4.1 *What law do they use?***

15(a) of the Uniform Rules governs the rules and law that a panel can use:

- (a) A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the [UDRP] Policy, these Rules and any rules and principles of law that

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it deems applicable.

The panelists thus must use the UDRP and the Uniform rules (and applicable supplemental rules), but can choose any other rules of law or sources that it “deems applicable”, including the law of a specific legal jurisdiction. As mentioned in the beginning, trademark law is more national than international, and different legal systems may handle the same legal issues surrounding trademarks differently. Unlike in a case before a court, there are no “choice of law” rules that the panel must follow – no laws about what law to apply in a dispute. In general, it has been observed that when the parties to a dispute are from different jurisdictions, panelists tend to rely solely on the UDRP and Uniform Rules. When the parties are both in the same jurisdiction, then panels may tend to use the law of that jurisdiction.<sup>47</sup>

Unlike judges in many legal systems, the panelists have no obligation to follow the past decisions of other panels – there is no rule of *precedent* within the UDRP system. Each panel can decide the situation as if it were the first one to consider the issue. However, many decisions, if not all of the ones now decided, cite other UDRP decisions or otherwise follow the reasoning of other decisions. Past decisions are published and available via the Internet from each provider. WIPO, for example, maintains web pages with the 25 most cited decisions in the complaint and 25 most cited in the response.<sup>48</sup> Finally, WIPO has created a *WIPO Overview of WIPO Panel Views on Selected UDRP Questions* [“WIPO Overview”],<sup>49</sup> which has been cited by some panelists as to “be regarded as a studied and considered summary of consensus positions and as such ought to be considered in a Panel’s deliberations.”<sup>50</sup>

#### 4.2 What the Complainant must prove

The UDRP lays out the three elements that the Complainant must prove in order to be successful in a dispute under the policy in 4(a):

- (i) [the] domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) [the Respondent has] no rights or legitimate interests in respect of the domain name; and
- (iii) [the] domain name has been registered and is being used [by the Respondent] in bad faith.

Complainant must satisfy *all three elements* to be successful. These elements should be addressed directly in the complaint because there are (except in unusual circumstances) no further documents submitted by the mark holder other than the complaint. All three elements should also be addressed fully and directly because if there is no response from the Registrant, the dispute will be decided solely

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<sup>47</sup> Donahey, *Internet Law and Practice*, 16:6. For an example of this line of reasoning, see *The Chamberlain Group, Inc. v. Martial Maitam*, WIPO/D2002-0338, Transfer <http://www.wipo.int/amc/en/domains/decisions/html/2002/d2002-0338.html> (“Since both the Complainant and Respondent are domiciled in the United States, since both registrars have their principal places of business in the United States, and since United States’ courts have recent experience with similar disputes, to the extent that it would assist the Panel in determining whether the Complainant has met its burden as established by Paragraph 4(a) of the Policy, the Panel shall look to rules and principles of law set out in decisions of the courts of the United States.”)

<sup>48</sup> WIPO, *25 most cited decisions*, [http://www.wipo.int/amc/en/domains/statistics/cases\\_cited.jsp?party=C](http://www.wipo.int/amc/en/domains/statistics/cases_cited.jsp?party=C) (Complaints) [http://www.wipo.int/amc/en/domains/statistics/cases\\_cited.jsp?party=R](http://www.wipo.int/amc/en/domains/statistics/cases_cited.jsp?party=R) (Response).

<sup>49</sup> [hereinafter *WIPO Overview*] Available at <http://www.wipo.int/amc/en/domains/search/overview/index.html>.

<sup>50</sup> See *Advance Magazine Publishers Inc. v. Vanilla Limited/ Domain Finance Ltd./ Minakumari Periasany* WIPO/D2004-1068, Transfer <http://www.wipo.int/amc/en/domains/decisions/html/2004/d2004-1068.html>; *Fresh Intellectual Properties, Inc. v. 800Network.com*, WIPO/D2005-0061, Transfer <http://www.wipo.int/amc/en/domains/decisions/html/2005/d2005-0061.html>

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on the basis of the complaint. Because of this reason, a UDRP complaint has been described as “a hybrid of a court complaint and summary judgment brief”.<sup>51</sup> All three providers offer model complaints (and responses) on their websites.<sup>52</sup> When drafting a complaint, mark holders should make sure that they address all three of the required elements in a way that gives a panel enough information to decide in their favor without any additional material.

### UDRP stories – Croatia Airlines

Croatia Airlines is Croatia’s national airline. The domain name [www.croatiaairlines.com](http://www.croatiaairlines.com), however, was being used by a resident of China to sell airline tickets and other goods and services. Croatia Airlines filed a UDRP complaint with WIPO in an effort to protect its mark and to transfer the domain name to the airline. The Registrant did not respond, and the panel found that the domain name was identical, that the Registrant had no rights or legitimate interest in the domain name, and that it was registered and being used in bad faith. Accordingly, Croatia Airlines was able to successfully acquire the domain name [www.croatiaairlines.com](http://www.croatiaairlines.com), and the site is used for their business to this day.

#### 4.2.1 Element 1: The domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;

This element requires that the Complainant prove two facts – that the domain name or names at issue are identical or confusingly similar to a trademark, and that the Complainant has rights to that mark.

Ownership of the mark or marks in question is usually established by providing proof of registration and other materials from the relevant trademark offices. Marks or words that are not registered, such as common law marks, trade names, geographical names, as well as celebrity and personal names have had mixed success under the UDRP. The key element is usually providing some proof that the mark is used commercially and that there is an association with that use to the Complainant.<sup>53</sup> The consensus view, taken from the *WIPO Overview* states:

The Complainant must show that the name has become a distinctive identifier associated with the Complainant or its goods and services. Relevant evidence of such “secondary meaning” includes length and amount of sales under the mark, the nature and extent of advertising, consumer surveys and media recognition. The fact that the secondary meaning may only exist in a small geographic area does not limit Complainant’s rights in a common law trademark. Unregistered rights can arise even when the Complainant is based in a civil law jurisdiction [Ed note – civil law systems generally require registration in order to have a trademark].<sup>54</sup>

In addition, Complainants must prove the domain name is “identical or confusingly similar” to their mark. Deleting spaces, deleting or adding punctuation or adding a TLD such as .com have all been found not to prevent a panelist from finding the domain name to be identical to the Complainant’s

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<sup>51</sup> Barbara Solomon, *Two New Tools to Combat Cyberpiracy – A Comparison*, 90 Trademark Rep. 679, 682 (2000) [hereinafter Solomon, *Two New Tools to Combat Cyberpiracy*].

<sup>52</sup> See e.g. WIPO, *Model Complaint and Filing Guidelines*, <http://www.wipo.int/amc/en/domains/complainant/index.html>.

<sup>53</sup> *WIPO Overview*, §1.7 <http://www.wipo.int/amc/en/domains/search/overview/index.html>.

<sup>54</sup> *Id.*

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mark.<sup>55</sup> Adding words to a mark or reversing the order of words in a mark have both been found to meet the “confusingly similar” element.<sup>56</sup> Decisions have been split as to whether adding a negative term at the end of a mark is “confusingly similar” under this part of the policy. This is the “sucks” line of decisions – domain names consisting of the “mark-sucks.TLD” format such as “wal-martsucks.com”. One view is that the use of the mark plus “sucks” leads to confusing similarity based on the use of the mark in the domain name,<sup>57</sup> and the other view is that most users are not likely to confuse a domain name with negative connotations with the mark owner.<sup>58</sup>

### Practice tip – Trade names

A trade name is the name that a business uses for commercial purposes, and it may be different from its legal name. This name is not automatically protected as a trademark, and if the name is not registered, dispute panels under the UDRP treat these as if they would common law or other unregistered marks. If the trade name does not meet the requirements for a mark, then a panel will not find that the Complainant has met the first element 4(a)(i) of the UDRP. For example, an Australian company named Sealite Pty Limited manufactured marine LED lights using its trade name. Because “lite” is a common alternative spelling of “light”, and “sea” is simply descriptive of the kind of lights manufactured, the panel found that the company failed to establish rights to the name required under the UDRP in a dispute over “sealite.com”, and thus the Complainant lost its UDRP dispute.<sup>59</sup>

## 4.2.2 Element 2: The Respondent has no rights or legitimate interests in respect of the domain name

Because it is difficult for a Complainant to prove a negative – especially because proof of a right or legitimate interest would be in the possession of the Respondent – several panel decisions have stated that the burden on the Complainant for this element is relatively light.<sup>60</sup> Panels often look at whether or not the Complainant has authorized or licensed the use of the mark to the Respondent and if they have had any kind of past relationship.<sup>61</sup> Conducting a trademark search by the Complainant for registrations by the Respondent for marks related to the domain name can help prove this element, but

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<sup>55</sup> See: Deletion of .com and spaces *Ann Coulter v. Mark Vadnais*, NAF/FA137221, Transfer <http://www.arbforum.com/domains/decisions/137221.htm>; Deleting punctuation: *Chi-Chi's, Inc. v. Restaurant Commentary (Restaurant Commentary)*, WIPO/D2000-0321, Transfer <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0321.html>; Adding punctuation: *France Telecom SA v. France Telecom Users Group*, WIPO/D2002-0144, Transfer <http://www.wipo.int/amc/en/domains/decisions/html/2002/d2002-0144.html>.

<sup>56</sup> Reversing order *Cook Motorcars, Ltd. v. Patricia Soto* NAF/FA94992, Transfer <http://www.arbforum.com/domains/decisions/94992.htm>; Adding words *The Black & Decker Corp. v. Eric Savelle dba Tools Plus, Inc.* NAF/FA96700, Transfer <http://www.arbforum.com/domains/decisions/96700.htm>.

<sup>57</sup> See e.g. *Wal-Mart Stores, Inc. v. Richard MacLeod d/b/a For Sale*, WIPO/D2000-0662, Transfer <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0662.html>.

<sup>58</sup> See e.g. *Wal-Mart Stores, Inc. v. wallmartcanadasucks.com and Kenneth J. Harvey*, WIPO/D2000-1104, Denied <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-1104.html>

<sup>59</sup> *Sealite Pty Limited v. Carmanah Technologies, Inc.* WIPO/D2003-0277 Denied <http://www.wipo.int/amc/en/domains/decisions/html/2003/d2003-0277.html>.

<sup>60</sup> See *De Agostini S.p.A. v. Marco Cialone* WIPO/DTV2002-0005 Transfer <http://www.wipo.int/amc/en/domains/decisions/html/2002/dtv2002-0005.html>, *Pivotal Corporation v. Discovery Street Trading Co. Ltd.* WIPO/D2000-0648 Transfer, <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0648.html>, *Arroyo Craftsman Lighting, Inc. v. Golden Realty* WIPO/D2002-0503, Transfer <http://www.wipo.int/amc/en/domains/decisions/html/2002/d2002-0503.html>.

<sup>61</sup> See e.g. *WIPO Belupo d.d. v. WACHEM d.o.o.* WIPO/D2004-0110, *Yell Limited v. Ultimate Search* WIPO/D2005-0091 Transfer, denied in part <http://www.wipo.int/amc/en/domains/decisions/html/2005/d2005-0091.html> *Croatia Airlines d.d. v. Modern Empire Internet Ltd.* WIPO/D2003-0455 <http://www.wipo.int/amc/en/domains/decisions/html/2003/d2003-0455.html>.

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is not necessary.<sup>62</sup>

Once the Complainant has met their burden, however light it may be, the Respondent then has the obligation to prove legitimate interest in the domain name. In 4(c), the UDRP gives three examples of *legitimate* interests that the Respondent may use to meet this burden, and we will discuss these three elements in Section 4.3 describing the response by the Respondent.

### UDRP Stories – AXA Management Consulting

AXA Management Consulting offers business consulting in the Republic of Moldova, and in 2004 it was challenged in a UDRP proceeding by the French insurance company AXA for using [www.axamc.com](http://www.axamc.com). AXA Management Consulting was using the website as the home page for offering its business consulting services in Moldova and neighboring countries. AXA Insurance requested transfer of the domain name under the UDRP because of its similarity to their trademark rights in AXA. The Moldavian company responded that AXA was chosen because “axa” means a “straight line” or “an axis” in Romanian and “mc” were added as short for “Management Consulting”. The panelist considered this use, together with the website, and found for Respondent AXA Management Consulting, stating that the use of a related and generic word together with the descriptive initials of the business established legitimate use of the domain name.<sup>63</sup> A much smaller company was able to defend its rights against an international corporation quickly and relatively inexpensively.

#### 4.2.3 Element 3: The domain name has been registered and is being used in bad faith

The UDRP itself outlines four different situations when panelists will consider the registration and use of a domain name to be in bad faith. They are:

1. Evidence that the Respondent acquired the domain name with the primary purpose of selling the domain to the owner of the trademark (or a competitor) for a profit. 4(b)(i);
2. “Engaging in a pattern” of registering a domain name in order to prevent the owner of the mark from procuring a domain name with the mark included in it. 4(b)(ii);
3. Evidence that the registration of the domain name was for the primary purpose of “disrupting the business of a competitor”. 4(b)(iii); or
4. Evidence of using the domain name to attract users to the site by creating a “likelihood of confusion” on the part of users as to the relationship of the site with the Complainant’s mark. 4(b)(iv).

Evidence of bad faith has been found, for example, where the Registrant:

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<sup>62</sup> See *Ronson Plc v. Unimetal Sanayi ve Tic.A.S.* WIPO/D2000-0011 Transfer <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0011.html> and *Educational Testing Service v. Netkorea Co.* WIPO/D2000-0087 Transfer <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0087.html>.

<sup>63</sup> See *FINAXA Société Anonyme v. Vitalie Popa* WIPO/D2004-0873 Denied <http://www.wipo.int/amc/en/domains/decisions/html/2004/d2004-0873.html>.

- Offered to sell the domain to the mark holder within three days of registration.<sup>64</sup>
- Registered a misspelling of Complainant’s mark – a practice known as “typosquatting”.<sup>65</sup>
- Offered to sell the domain to the mark holder for an amount in excess of out-of-pocket costs.<sup>66</sup>
- Registered the exact same domain name in another TLD after Complainant registered a domain name in another TLD for its famous mark (registering a .net after mark holder registered the .com).<sup>67</sup>
- Failed to put up a website on a domain name reflecting a well-known mark, combined with providing false or misleading contact details.<sup>68</sup>

“Bad faith” is not limited to the four scenarios outlined above, and panelists are free to find bad faith on other facts.<sup>69</sup> With thousands of decided cases, it would be very difficult to describe all the situations in which panelists have found bad faith. In order to assess whether a particular situation might be bad faith, the resources provided at the end of this guide can be reviewed or appropriate legal aid can be consulted.

### UDRP Stories – Kwandwe Private Game Reserve

Kwandwe Private Game Reserve is a private reserve in South Africa’s eastern cape region that provides safari tours and ecotourism services. From the beginning, they invested heavily in the KWANDWE mark to promote their services. In order to advertise on the Internet, they registered www.kwandwe.com and related domain names in the South Africa ccTLD (.za) and used these domain names to host information about their services. In 2003, the registration for www.kwandwe.com mistakenly lapsed and was subsequently registered by a Russian resident, who linked the domain to a site featuring sexually explicit material. This site also used a number of techniques that made it difficult for users who inadvertently visited the site to navigate away from the site without being further exposed to sexually explicit material (often called “mousetrapping”).

Kwandwe Private Game Reserve brought a dispute under the UDRP to WIPO in an effort to recover www.kwandwe.com. The Registrant did not respond, and the sole panelist found for Kwandwe, who then were able to safely and inexpensively recover www.kwandwe.com and resume their website.

### 4.3 Response to the complaint

In 4(c), the UDRP does outline three examples of *legitimate* interests that the Respondent can

<sup>64</sup> See *World Wrestling Federation Entertainment, Inc. v. Michael Bosman* WIPO/D1999-0001 supra.

<sup>65</sup> See *Dow Jones & Company, Inc. and Dow Jones LP v. John Zuccarini, d/b/a Cupcake Patrol* WIPO/D2001-0302 Transfer <http://www.wipo.int/amc/en/domains/decisions/html/2001/d2001-0302.html>.

<sup>66</sup> See *Time Warner Inc. and EMI Group plc v. CPIC Net* WIPO/D2000-0433 Transfer <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0433.html>.

<sup>67</sup> See *Technology Properties, Inc v. Ralph Burris* NAF/FA94424 Transfer <http://www.arb-forum.com/domains/decisions/94424.htm> (Registering radioshack.net after famous consumer electronics retailer and mark owner registered radioshack.com).

<sup>68</sup> See e.g. *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO/D2000-0003 Transfer <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0003.html>.

<sup>69</sup> See e.g. *TV Globo Ltda. v. Radio Morena*, WIPO/D2000-0245 Transfer <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0245.html>.

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demonstrate to show their rights to the domain name:

1. Before the Respondent knew about the dispute, the use, or preparations for use, of the domain name or a name corresponding to the name with the offering of goods and services by the Respondent. UDRP 4(c)(i);
2. Even if they have not acquired trademark rights, if they have been commonly known by the domain name. UDRP 4(c)(ii); or
3. Using the domain name for a “legitimate noncommercial or fair use”, and this use is “without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark”. 4(c)(iii).

Legitimate use by Respondents has been found in situations where:

- Use by a business of the name before receiving notice of dispute.<sup>70</sup>
- Use of a trade name by each of the parties in different countries (in parallel) for a number of years.<sup>71</sup>
- They run a non-commercial fan site.<sup>72</sup>
- They are a reseller of the goods or services of the Complainant/mark holder.<sup>73</sup>

Apart from the three situations outlined in 4(c), dispute panelists are free to find other examples of legitimate interest of the Respondent – the list is not exhaustive. Past decisions have included situations where:

- The domain name at issue is also a *generic* term.<sup>74</sup>
- The domain name at issue is also a *descriptive* term.<sup>75</sup>
- A disclaimer was included on the site that it was not run by the Complainant.<sup>76</sup>

In addition to showing a legitimate interest in the domain name, Respondents should argue against the other two elements that the Complainant must prove in a UDRP dispute. This may include arguing that the Complainant does not have trademark rights to the name or that the registration and use were not done in bad faith.

#### **4.4 Reverse Domain Name Hijacking**

The UDRP Rules provide for panelists to find that the complaint is a case of Reverse Domain Name Hijacking (RDNH). RDNH is an attempt in bad faith to use the UDRP to acquire a domain name from a legitimate user and not for a supportable complaint of cybersquatting, UDRP Rule 15(e) allows for

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<sup>70</sup> See e.g. *EAuto, Inc. v. E Auto Parts, Inc.* WIPO/D2000-0121 Denied <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0121.html>.

<sup>71</sup> See e.g. *Shri Ram Chandra Mission v. Shri Ram Chandra Mission*, NAF/FA94237 Denied <http://www.arb-forum.com/domains/decisions/94237.htm>.

<sup>72</sup> See e.g. *2001 White Castle Way, Inc. v. Glyn O. Jacobs*, WIPO/D2004-0001 Denied <http://www.wipo.int/amc/en/domains/decisions/html/2004/d2004-0001.html>.

<sup>73</sup> See e.g. *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO/D2001-0903 Denied <http://www.wipo.int/amc/en/domains/decisions/html/2001/d2001-0903.html>.

<sup>74</sup> See e.g. *Zero International Holding GmbH & Co. Kommanditgesellschaft v. Beyonet Services and Stephen Ulrich*, WIPO/D2000-0161 Denied <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0161.html>.

<sup>75</sup> See e.g. *Car Toys, Inc. v. Informa Unlimited, Inc.*, NAF/FA93682 Denied <http://www.arbforum.com/domains/decisions/93682.htm>.

<sup>76</sup> See e.g. *Besiktas Jimnastik Kulubu Dernegi v. Mehmet Tolga Avcioğlu* WIPO/D2003-0035 Denied <http://www.wipo.int/amc/en/domains/decisions/html/2003/d2003-0035.html>.

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panels to find RDNH and states:

If after considering the submissions the Panel finds that the complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking or was brought primarily to harass the domain-name holder, the Panel shall declare in its decision that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding.

Respondent can allege Reverse Domain Name Hijacking – that the Complainant brought the complaint in bad faith – in their response, and if a panel finds RDNH they will rule in Respondent’s favor and make a finding of RDNH. However, while there may be other benefits to this finding, there are no monetary or other sanctions that can be brought against Complainant for engaging in RDNH.

#### **4.5 Enforcement**

Enforcement of panel decisions under the UDRP is done at the technical level. The registrar changes the appropriate technical entries for the website in the DNS, and the domain name no longer refers requests to the former registrant. In the case of transfer of a registration, the Complainant owns the domain name (the root points to their computer when the domain name is entered) and is free to put up a web site at that name. When a registration is cancelled, the domain name does not point to any specific web site and is free for anyone to register.

The UDRP as a policy works through the control exercised by ICANN over the root. ICANN requires that registries in the gTLDs listed in its root file use and abide by the UDRP and its Rules. These registries in turn require their registrars – other entities selling domain name registrations – to include the UDRP and its rules in their contracts with registrants. Thus if one wants to register a domain name in a TLD that requires the UDRP, one must agree to the policy.

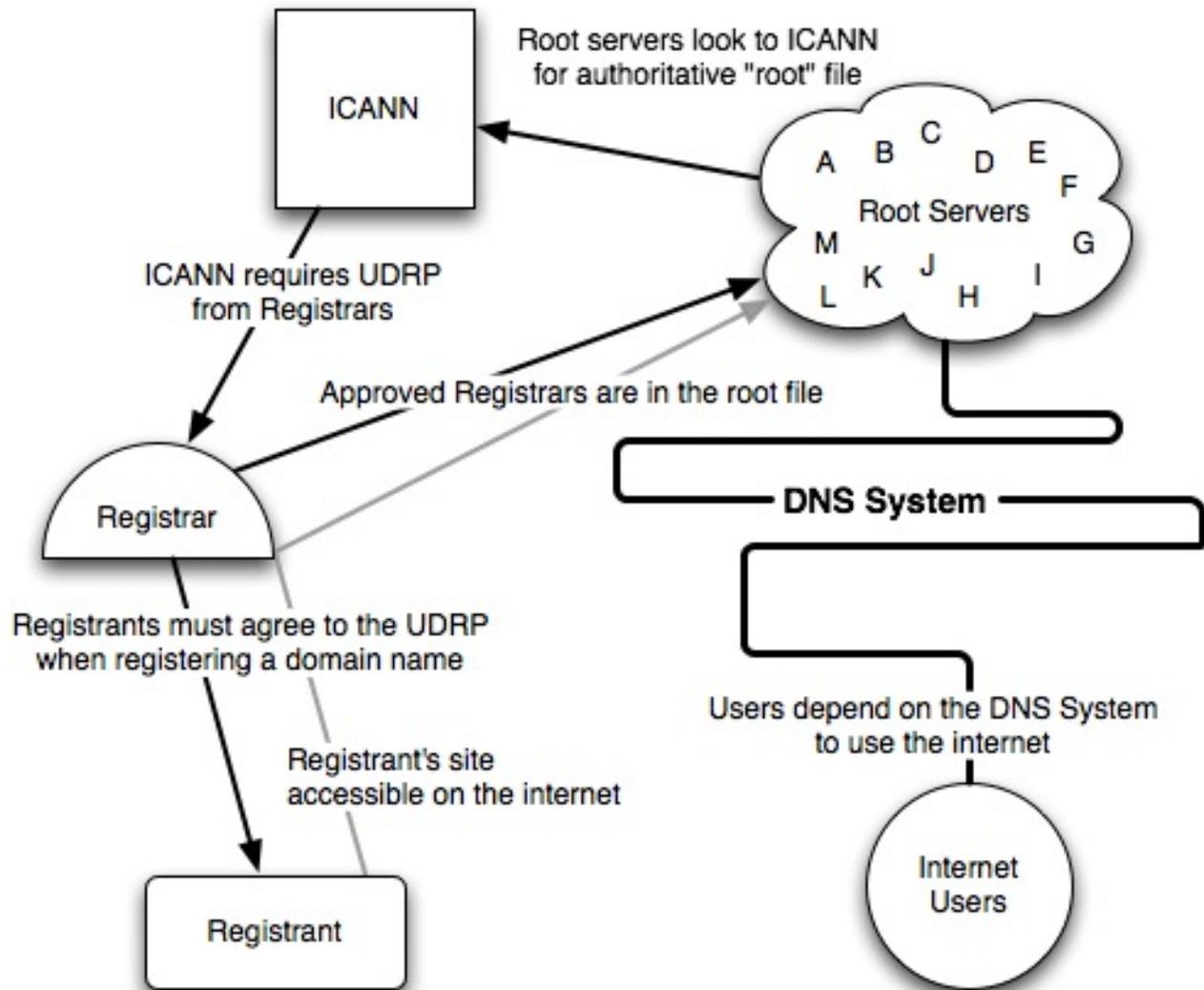


Figure 5. Enforcement

## 5.0 WHOIS

### 5.1 What is WHOIS

WHOIS service is a component of a domain name registration that identifies “who is” the point of contact for various issues related to the domain name. The information currently provided includes:

- Name;
- Email address;
- Mailing address;
- Phone number; and
- Fax number.

For the following groups of people:

- Respondent contact;

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- Administrative contact;
  - Technical contact; and
  - Billing contact.<sup>77</sup>

It is an important tool to provide a point of contact for technical problems related to a website, and is available even if the website itself has no content. As mentioned, WHOIS information is also used as the primary method for getting in touch with a Respondent in case of a dispute under the UDRP. All ICANN-approved registrars must make a WHOIS service available.

### **Practice Tip – No response from the Registrant and WHOIS**

If you own a domain name, keep in mind that part of the high default (lack of response by the Registrant) may be inaccurate or out-of-date WHOIS information on file with the domain name's registrar. Domain name owners are notified of UDRP disputes primarily through this contact information, and if it is inaccurate, a Registrant may never know of a complaint filed against them. It is a good practice to create a periodic review process to ensure that the WHOIS data is current and accurate to prevent the loss of the domain name. Failure to maintain an accurate WHOIS profile could even be used as evidence of bad faith against you in a proceeding under the UDRP.

## **5.2 WHOIS and privacy**

There is a conflict between openly providing on the web the personal details of domain name registrants, who are often private individuals rather than businesses, and the need to be able to contact the responsible parties for technical and legal issues associated with a domain, including for disputes under the UDRP. There can be a conflict between the privacy laws of a particular nation and the policies under WHOIS, especially for the gTLDs, which are available in any jurisdiction. This is particularly true in legal systems that have strong data protection or *habeas data* laws.

The privacy and WHOIS policies of the different ccTLDs vary, and so the individual ccTLD should be consulted if you are a ccTLD registrant or have a complaint against a registration in a ccTLD. WIPO has listed a set of best practices for ccTLDs and their WHOIS services in its *ccTLD Best Practices for the Prevention and Resolution of Intellectual Property Disputes*. In addition, some obligations by states to provide for WHOIS services under Regional Trade Agreements, such as the Dominican Republic–Central America Free Trade Agreement (DR-CAFTA), contain provisions that allow for some balancing of privacy interests.<sup>78</sup>

For those concerned about privacy and WHOIS, there are privacy services offered by private companies that provide their own contact information for the WHOIS service, and forward on any correspondence the Registrant. From a trademark holder perspective, these services increase the difficulty in maintaining a UDRP dispute or later national court litigation because they make it harder to identify the owner. From a consumer perspective, these services help protect private information and help require mark holders to go through traditional service of process rules, which are established rules designed to ensure proper notice of a dispute. The relationship between WHOIS, privacy, and

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<sup>77</sup> The March of 2007 GNSO report recommended a different set up for the information and groups of people. See GNSO WHOIS Task Force, *Final Task Force Report on WHOIS Services*, <http://gns0.icann.org/issues/whois-privacy/whois-services-final-tf-report-12mar07.htm> [hereinafter *Final Task Force Report on WHOIS Services*].

<sup>78</sup> DR-CAFTA 15.4.2 *supra*, and Brown, et al. *The Impact of Free Trade Agreements on Information Technology Based Business*, *supra*.

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legal disputes such as the UDRP is an ongoing debate in the Internet community. ICANN's working group on this issue issued its *Final Task Force Report on Whois Services* in March of 2007 with a number of recommendations on this issue, and the debate continues to evolve.<sup>79</sup>

## 6.0 Relationship to National Law

This section picks back up on the thread of the possibility of using national courts as opposed to the UDRP for the resolution of domain name disputes. Though there is less of a need to resort to the court system with the UDRP in place, national litigation plays an important role in the UDRP process.

### 6.1 *The UDRP and national courts*

As a review from earlier in the guide, there are only two remedies that Complainants can ask for:

1. **Cancellation of the registration; or**
2. **Transfer of the registration to the Complainant.**

This means that if any of the following remedies are sought, then the Complainant will have to go to a national court:

- **Damages** – monetary compensation paid by the Respondent for harm to the mark holder.
- **An order to refrain from certain activities** – Such an order, known as an injunction or interdict, could be used to prevent Respondents from repeatedly registering infringing domain names.

The national court system also serves as an “appellate” function, though it is not an appeal in the traditional sense but rather a completely new court proceeding. If either party loses, they have the option of filing a case in a national court. For Registrants, this means that they can file in order to prevent the transfer or cancellation of their registration. For Complainants, this means that they have a second chance to ask for the transfer or cancellation of a domain name, plus they can ask for the above-mentioned additional remedies.

The UDRP and its system of panelists is also not an appropriate place to settle legitimate trademark disputes, such as who has rights to a certain mark in a given class of goods or services. It was never meant to deal with these situations, and explicitly provides for the use court proceedings and for the compliance of the registrar to transfer a domain name if given an appropriate court order.<sup>80</sup> From 4(k) of the UDRP:

The mandatory administrative proceeding requirements ... shall not prevent either you or the Complainant from submitting the dispute to a court of competent jurisdiction for independent resolution before such mandatory administrative proceeding is commenced or after such proceeding is concluded.

Though court proceedings are available at any time, the UDRP gives 10 business days from the time of a UDRP panel decision to file a court case before implementation by the registrar (transfer or cancellation of the domain name). The registrar, in the UDRP, commits to trying to “maintain the

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<sup>79</sup> *Final Task Force Report on WHOIS Services* supra.

<sup>80</sup> UDRP §3 b.

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status quo” by not transferring the domain name unless ordered.<sup>81</sup>

## 6.2 *The ACPA*

National courts have had some difficulty with applying traditional areas of the law to the new context of the Internet. In the United States for example, trademark infringement law required a special kind of “use” by the Respondent, and there was some difficulty as to whether merely registering a domain name can under this definition. In order to clarify the rights involved with domain names and to facilitate online commerce, the US Congress passed a law dealing with domain names called the Anti-Cybersquatting Consumer Protection Act (ACPA). This act aimed to address shortcomings in US trademark law that prevented or made difficult bringing domain name disputes before US courts. The ACPA shares several similarities with the UDRP, but places these within the context of a full legal system with courts, judges, pleadings, and formal appeals.<sup>82</sup>

The ACPA contains an *in rem* provision designed to provide relief limited to cancellation or transfer of the registration. Actions *in rem* are court actions or judgments against a particular piece of property, as opposed to suits against a person or legal entity. The *in rem* provision of the ACPA allows for trademark holders to file a suit against a particular domain name “in the judicial district in which the domain name registrar, domain name registry, or other domain name authority that registered or assigned the domain name is located” under certain circumstances. These circumstances essentially amount to situations where the courts could not exercise jurisdiction over the person or legal entity who registered the name, but where the registrar with whom the name was registered is located within the United States. Thus trademark owners can get limited relief against foreign persons and legal entities that register infringing marks with US-based registrars but who are not amenable to more traditional lawsuits.

## 6.3 *Bringing the dispute to a national court*

Besides this special piece of legislation in the United States, other legal causes of action in the US and other jurisdictions throughout the world for the resolution of a domain name dispute include:

- **Trademark infringement** – a suit for infringement under a legal system’s trademark law;
- **Passing off and similar tortious offenses** – a suit for damages based on the injury from representing goods or services as coming from the trademark owner;
- **Unfair competition** – a suit for damages for acts commercial activity that deceives or confuses consumers about the origin of a good or service;
- **Dilution of a well-known trademark** – a suit for “blurring” the distinctiveness or “tarnishing” the reputation and standing of a famous mark; and
- **False advertising** – a suit for deliberately using deception or untrue statements in order to gain a commercial advantage.<sup>83</sup>

A suitably qualified legal professional in your jurisdiction can go through all of the possible claims that could be brought in your national legal system, and advise you on the advantages of filing a national claim, a UDRP dispute, or possibly both.

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<sup>81</sup> See UDRP §§ 3, 7.

<sup>82</sup> Solomon, *Two New Tools to Combat Cyberpiracy*, at 701-03 *supra*.

<sup>83</sup> Mary M. Squyres, *Trademark Practice Throughout the World*, §30:35 (West 2007).

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## 7.0 Criticisms of the UDRP

The UDRP allows for fast resolution of disputes over domain names for relatively low costs between parties from across the world, but the UDRP is not a perfect system. In the interest of quickly and inexpensively resolving disputes several areas were sacrificed. Several of its shortcomings have been mentioned throughout this guide, and these as well as others are collected here. This is not a comprehensive review, but is instead an outline of some of the debates centered on current practices to give an idea of some of the concerns over the policy.

### 7.1 Privacy, WHOIS, and notifying the Respondent

The UDRP does not require formal service of process, which is a notification of a dispute, against the Respondent in the same way as a court proceeding. Service in a court proceeding often involves having an officer of the court deliver notice of a complaint in a way that makes it highly likely that the person or organization knows that there is a complaint. Within the context of the UDRP, once a notice is sent based on the information in the WHOIS database, the 20-day countdown starts toward default.<sup>84</sup> If this information is incorrect, then a Respondent could lose their domain name without ever knowing that there was a dispute.

As noted, there are additional complaints about the privacy impact of current WHOIS practices. Identifying personal information in a WHOIS record has negative implications for spam policy, phishing (attempting to gain access to financial information for fraud purposes), cyber-stalking, and identity theft.<sup>85</sup> In addition, there is concern that the personally identifiable information in a WHOIS record can have a chilling effect on freedom of expression on the Internet.<sup>86</sup> As noted, ICANN's *Final Task Force Report on Whois Services* in March of 2007 is an attempt to move forward on issues surrounding WHOIS.<sup>87</sup>

### 7.2 The panel decision is not final

Should a Complainant lose a UDRP proceeding, there is no change to the status quo, and the domain name remains registered to the original party. This gives the Complainant the ability to resort to another proceeding in a national court under, for example, trademark law or specialized legislation such as the ACPA (discussed above). This can work to the disadvantage of a Registrant who won a UDRP dispute, since review in a national court is done *de novo*, and a successful UDRP defense is not generally entitled to review by the court. In addition, a losing Respondent must file an action in a national court within 10 days to prevent the domain transfer, while a losing Complainant may try again at their leisure. While the low cost of filing and quick response time are traditionally seen as advantages to the UDRP system, it can encourage "probing" litigation where a trademark holder can file a UDRP claim at low cost and with little danger prejudicing later action in a national court in order to test the Registrant.<sup>88</sup>

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<sup>84</sup> See also A. Michael Froomkin, *ICANN's "Uniform Dispute Resolution Policy" – Causes and Partial Cures*, 67 *Brook. L. Rev.* 605, 702-705 (2002) (criticizing the short time for a response) [hereinafter Froomkin, *ICANN's "Uniform Dispute Resolution Policy"*].

<sup>85</sup> See e.g. EPIC, *Comments on ICANN Whois Task Force*, <http://www.epic.org/privacy/whois/comments.html>.

<sup>86</sup> *Id.*

<sup>87</sup> *Supra.*

<sup>88</sup> Froomkin, *ICANN's "Uniform Dispute Resolution Policy"* [at 699]

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### 7.3 Trademark owner bias

UDRP panelists can take into account the law of any or none of the legal systems in the world, and are not bound by prior panel decisions under the UDRP. Because of this feature, and because there is no appellate review, there are often wildly inconsistent results between panelists, and there is no body that harmonizes decisions between providers.<sup>89</sup> This has led to allegations of forum shopping between individual panelists and between dispute resolution providers. Providers compete for Complainants (who primarily are the ones who pay fees), and providers seen as “pro-Complainant” receive more complaints. In addition, particular arbitrators have been seen as biased, especially since most arbitrators are drawn from the pool of trademark practitioners (lawyers) and would naturally be inclined to trademark arguments.

It has also been argued that the UDRP procedures favor Complainants over Respondents. This is particularly the case for losing Respondents, who have a short amount of time to file a court proceeding in order to retain the domain name, while losing Complainants can file at their leisure.<sup>90</sup> Respondents also have a limited amount of time to, if necessary, hire counsel and formulate a response, while Complainants can draft and file their complaints under any time frame.

### 7.4 No sanctions for Reverse Domain Name Hijacking

As noted above, there are no monetary or other sanctions that a panel can order against a Complainant that makes a bad faith use of the UDRP. This leaves Complainant’s with little deterrence (other than the filing costs) to file bad faith complaints in an attempt to wrest a desired domain name from a legitimate owner. Bad faith complaints also impose costs on registrants who have to respond to the claim, who potentially have to hire a legal professional and take time out to respond or face losing their domain name. It has also been remarked that panelists often won’t find RDNH even in clear cases, which helps to demonstrate a possible pro-trademark holder bias in the process.<sup>91</sup>

### 7.5 Harmful to Free Speech

The UDRP has been used to great effect against sites “mark+sucks” sites – winning transfer of the domain even though many court decisions looking at trademark have come to the opposite conclusion.<sup>92</sup> Many of these sites are used by consumers dissatisfied about products or services relating to the mark, and transfer disrupts this criticism. Transfer under the UDRP has rested on a fairly specious argument that non-native English speakers will not know what “sucks” means, and will take the presence of the trademark in the domain name to imply sponsorship.<sup>93</sup> There is a split in UDRP decisions as to whether “sucks” is a legitimate use.<sup>94</sup> As mentioned above, the data available under WHOIS can also have a chilling effect on speech as it reduces the anonymity of the site owner.

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<sup>89</sup> See *Sallen v. Corinthians Licenciamentos*, 273 F.3d 14 (1st Cir. 2001) (Holding that U.S. review of UDRP procedures under ACPA should be *de novo*).

<sup>90</sup> Froomkin, ICANN’s “Uniform Dispute Resolution Policy” at 679.

<sup>91</sup> Froomkin, ICANN’s “Uniform Dispute Resolution Policy” at 666-670 and 692-696.

<sup>92</sup> David E. Sorkin, *Judicial Review of ICANN Domain Name Dispute Decisions*, 18 Santa Clara Computer & High Tech. L.J. 35-55, 48-50 n.77 and n.78 (2001).

<sup>93</sup> Froomkin, ICANN’s “Uniform Dispute Resolution Policy” at 663-665.

<sup>94</sup> See *WIPO Overview*, §1.3.



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## 8.0 Appendix

### 8.1 Glossary of Terms

*Complainant* – The party filing a complaint against a Respondent of a domain name.

*Reverse Domain Name Hijacking* – Using the UDRP to gain the transfer of a legitimately held domain name from its registrant by filing a weak complaint.

*Kiting / Tasting* – Using the domain name registration refund period in order to reserve a name and to test its profitability. If the domain name is not desired, within 5 days the registration fees can be fully refunded.

*Mousetrapping* – A technique used to try to prevent the user from navigating away from a webpage.

*Registrant* – Someone who has registered a domain name and agreed to the UDRP in the registration agreement.

*Respondent* – Another term used for a Registrant, and is used for a Respondent that is expected to respond to a complaint made via the UDRP framework.

*Typosquatting* – Registering misspellings or common typographical errors of popular domain names as a means of diverting traffic to a site owned by the typosquatter.

### 8.2 Links

#### **The UDRP and the rules**

The Uniform Domain Name Dispute Resolution Policy (UDRP).  
<http://www.icann.org/dndr/udrp/policy.htm>

The Rules for the UDRP (“The Rules” or “Uniform Rules”).  
<http://www.icann.org/dndr/udrp/uniform-rules.htm>

List of current providers of UDRP disputes and their supplemental rules:  
<http://www.icann.org/dndr/udrp/approved-providers.htm>

#### **Provider websites**

The World Intellectual Property Organization, Arbitration and Mediation Center  
<http://www.wipo.int/amc/en/index.html>

The National Arbitration Forum (NAF)  
<http://domains.adrforum.com/>

Asian Domain Name Dispute Resolution Centre (ADNDRC)  
<http://www.adndrc.org/adndrc/index.html>

#### **Help understanding the UDRP process**

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

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

*WIPO UDRP Flowchart*

<http://www.wipo.int/export/sites/www/amc/en/docs/UDRPflowchart.doc>

*Typical Interactions Between the WIPO Center and a Registrar in the Course of an Administrative Proceeding*

<http://www.wipo.int/export/sites/www/amc/en/docs/registrarflow.doc>

*ADNDRC Flowchart*

[http://www.adndrc.org/adndrc/hk\\_flow\\_chart.html](http://www.adndrc.org/adndrc/hk_flow_chart.html)

*NAF flowchart*

A diagram of the process is available from the NAF site.

### **Model forms**

*WIPO, Case Filing under the UDRP,*

<http://www.wipo.int/amc/en/domains/filing/udrp/index.html>

*WIPO Model Complaint (DOC file)*

<http://www.wipo.int/export/sites/www/amc/en/docs/complaint-udrp.doc>

*WIPO Model Response (DOC file)*

<http://www.wipo.int/export/sites/www/amc/en/docs/response-udrp.doc>

NAF model forms are available from their website

<http://domains.adrforum.com/default.aspx>

ADNDRC also has model forms available from their website

<http://www.adndrc.org/>

### **Drafting a complaint or response**

*WIPO Overview of WIPO Panel Views on Selected UDRP Questions*

<http://www.wipo.int/amc/en/domains/search/overview/index.html>

*WIPO, 25 most cited decisions,*

[http://www.wipo.int/amc/en/domains/statistics/cases\\_cited.jsp?party=C](http://www.wipo.int/amc/en/domains/statistics/cases_cited.jsp?party=C) (Complaints)

[http://www.wipo.int/amc/en/domains/statistics/cases\\_cited.jsp?party=R](http://www.wipo.int/amc/en/domains/statistics/cases_cited.jsp?party=R) (Response)

*Index of WIPO UDRP Panel Decisions* (search cases by industry or legal component)

<http://www.wipo.int/cgi-bin/domains/search/legalindex?lang=en>

Berkman Center for Internet & Society, *UDRP Opinion Guide* (Ed note, not continuously updated)

<http://cyber.law.harvard.edu/udrp/opinion/>

### **gTLD specific resources**

IANA, *Generic Top Level Domains* (determining which domains are covered by ICANN)

<http://www.iana.org/gtld/gtld.htm>

### **ccTLD resources**

These resources may help you determine if the ccTLD operates a policy similar to the UDRP and related material in order to investigate filing a complaint.

*WIPO, Arbitration and Mediation Center ccTLD Database,*

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[http://www.wipo.int/amc/en/domains/cctld\\_db/output.html](http://www.wipo.int/amc/en/domains/cctld_db/output.html)

WIPO, *ccTLD Best Practices for the Prevention and Resolution of Intellectual Property Disputes*,

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

IANA, *Root-Zone Whois Index by TLD Code*,

<http://www.iana.org/root-whois/index.html> (a full list of ccTLDs and their administrators).

## History

ICANN, *Timeline for the Formulation and Implementation of the Uniform Domain-Name Dispute-Resolution Policy*

<http://www.icann.org/udrp/udrp-schedule.htm>.

## Statistical resources

UDRPinfo.com (This site is based off of statistics collected by Michael Geist in 2001-02).

<http://www.udrpinfo.com>

WIPO, *WIPO Domain Name Dispute Resolution Statistics* (statistics from WIPO disputes only)

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

## 8.3 Law review, books, and treatises

Selected resources related to the UDRP. See also WIPO, *Domain Name Bibliography*,

<http://www.wipo.int/amc/en/center/bibliography/udrp.html>.

M. Scott Donahey, *Internet Law and Practice* (West 2006).

Graeme B. Dinwoodie, *The Architecture of the International Intellectual Property System*, 77 Chi.-Kent L. Rev. 993. (also available at <http://www.kentlaw.edu/depts/ipp/publications/AIPPS.pdf>).

Graeme B. Dinwoodie, *(National) Trademark Laws And The (Non-National) Domain Name System*, 21 U. Pa. J. Int'l Econ. L. 495 (2000). (also available at <http://www.kentlaw.iit.edu/depts/ipp/publications/TMDNSFinal.pdf>)

Graeme B. Dinwoodie, *Trademarks and Territoriality*, (2004) 41 *Hous. L. Rev.* 885. (also available at <http://www.kentlaw.edu/depts/ipp/publications/886HoustonLR41.pdf>).

A. Michael Froomkin, *ICANN's "Uniform Dispute Resolution Policy" – Causes and Partial Cures*, 67 *Brook. L. Rev.* 605, 704-705 (2002).

Michael A. Geist, *Fair.com?: An Examination of the Allegations of Systemic Unfairness in the ICANN UDRP*, 27 *Brook. J. Int'l L.* 903, 914-15 (August 2001). (also available at SSRN: <http://ssrn.com/abstract=280630>).

Michael A. Geist, *Fundamentally Fair.com? An Update on Bias Allegations and the ICANN UDRP*, <http://aix1.uottawa.ca/~geist/fairupdate.pdf>

Laurence R. Helfer, *Whither the UDRP: Autonomous, Americanized, or Cosmopolitan?*, (2004) 12 *Cardozo J. Int'l & Comp. L.* 493.

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Laurence R. Helfer and Graeme B. Dinwoodie, *Designing Non-National Systems: The Case of the Uniform Domain Name Dispute Resolution Policy*, 43 Wm. & Mary L. Rev. 141 (2001);

Milton L. Mueller, *Ruling the Root: Internet Governance and the Taming of Cyberspace* (MIT Press 2002).

Barbara Solomon, *Two New Tools to Combat Cyberpiracy – A Comparison*, 90 Trademark Rep. 679, 682 (2000)

David E. Sorkin, *Judicial Review of ICANN Domain Name Dispute Decisions*, 18 Santa Clara Computer & High Tech. L.J. 35-55 (2001).

Mary M. Squyres, *Trademark Practice Throughout the World*, (West 2007).