

www.cybersquatting101.com

***Strategies, Trends & Tips in
Uniform Domain Name Dispute
Resolution Policy (“UDRP”)
Proceedings***

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What's In A Name?

Domain Name

ICANN
WIPO

UDRP
ACPA

gTLDs
ccTLDs

Registrant
Registrar





UDRP is ...

“The UDRP is an administrative alternative dispute resolution policy which creates a procedure specifically designed to provide a fast and cheap means for resolving domain name disputes. On average, it takes no more than two months to resolve a domain name dispute under the UDRP.”

-- *American Girl, LLC v. Nameview, Inc.*, 381 F. Supp. 2d 876 (E.D. Wis. 2005) (internal citations omitted).



Cybersquatting Is ...

- Registering, trafficking in, or using a domain name (a) that is confusingly similar or identical to and (b) with bad faith intent to profit from the goodwill of, a trademark belonging to someone else.

-- Anticybersquatting Consumer Protection Act,
Section 43 of the Lanham Act, 15 U.S.C. §1125



Cybersquatting Is ...

(i) the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights;

(ii) the squatter has no rights or legitimate interests in respect of the domain name; and

(iii) the domain name has been registered and is being used in bad faith.

-- Paragraph 4, Uniform Domain Name Dispute Resolution Policy ("UDRP") as adopted by the Internet Corporation for Assigned Names and Numbers ("ICANN")



Why Are Domain Names / Cybersquatting So Overwhelming?





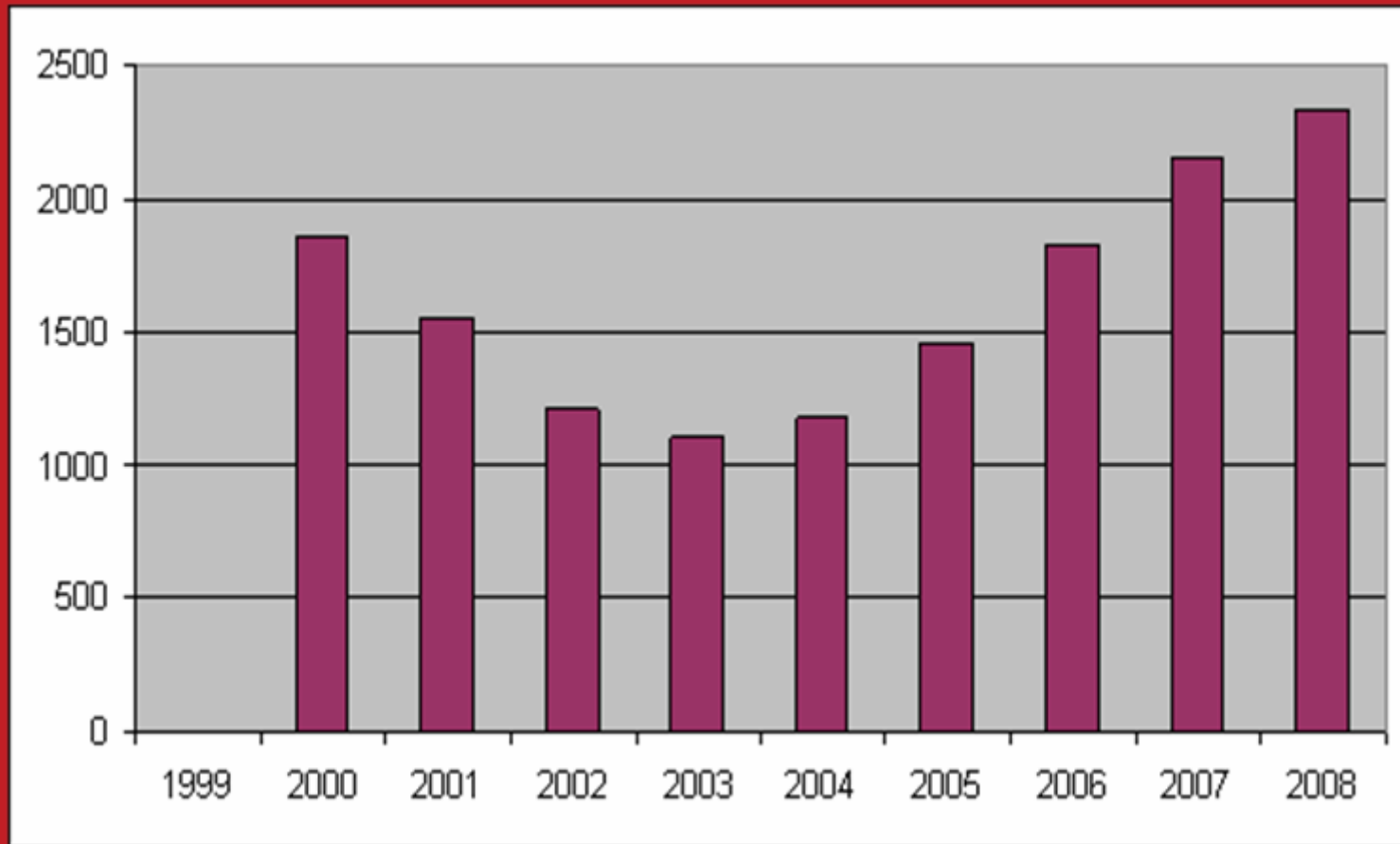
The Universe Of Domain Names

- Over 1.5 billion Internet users
- Over 174 million registered domain names worldwide





Total Number of WIPO Domain Name Cases By Year





WIPO Complainant Country Filing (Top 15 Ranking 1999-2008)

<u>Country</u>	<u>Number of Cases</u>	<u>Percentage of Cases</u>
United States of America	6,452	43.81%
France	1,575	10.69%
United Kingdom	1,110	7.54%
Germany	840	5.70%
Switzerland	744	5.05%
Spain	678	4.60%
Italy	467	3.17%
Canada	289	1.96%
Australia	270	1.83%
Netherlands	265	1.80%
Sweden	212	1.44%
Japan	174	1.18%
India	143	0.97%
Brazil	126	0.86%
Denmark	124	0.84

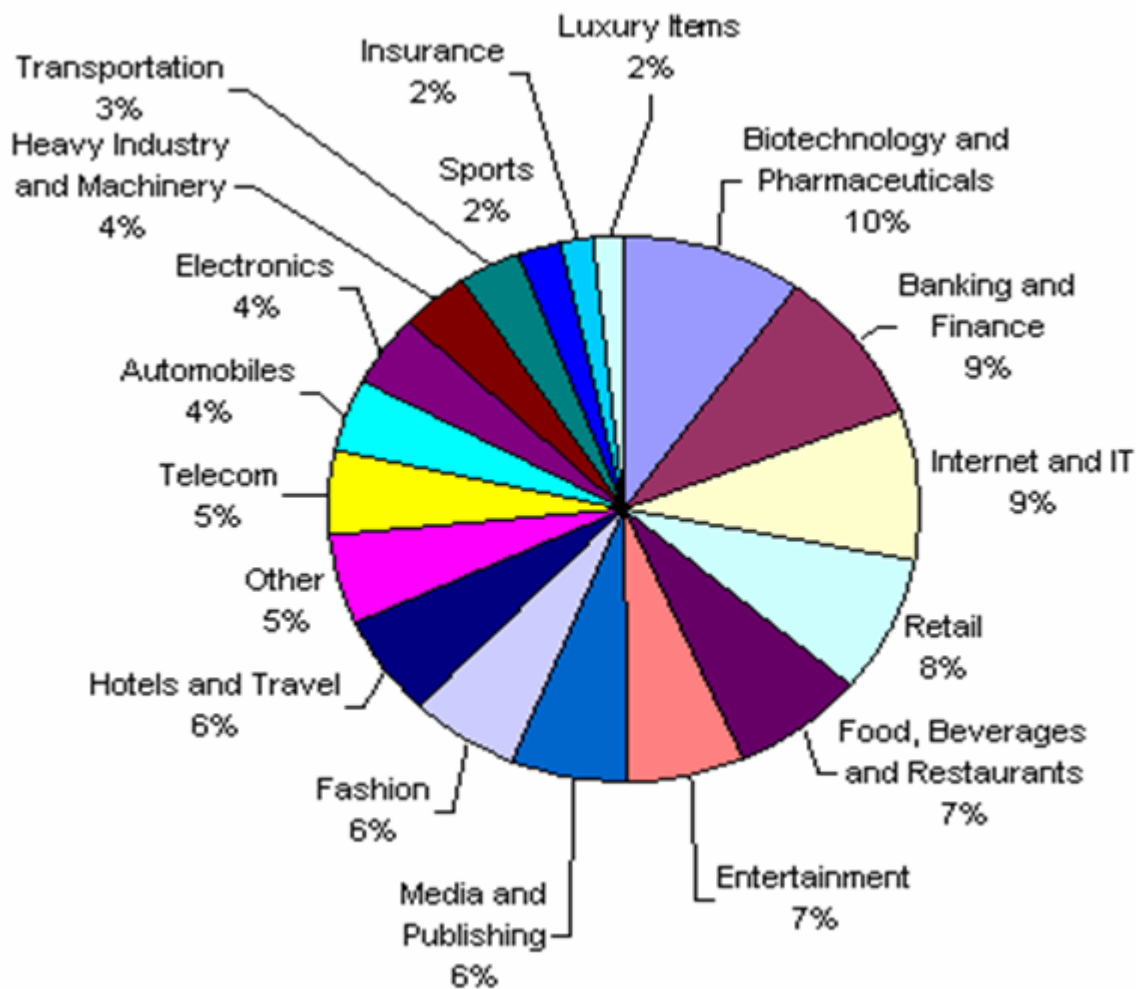


WIPO Respondent Country Filing (Top 15 Ranking 1999-2008)

<u>Country</u>	<u>Number of Cases</u>	<u>Percentage of Cases</u>
United States of America	5,822	39.53%
United Kingdom	1,243	8.44%
China	735	4.99%
Canada	701	4.76%
Spain	677	4.60%
Republic of Korea	596	4.05%
France	466	3.16%
Australia	356	2.42%
Italy	222	1.51%
Netherlands	219	1.49%
India	216	1.47%
Germany	213	1.45%
Russian Federation	207	1.41%
Switzerland	204	1.39%
Bahamas	165	1.12%

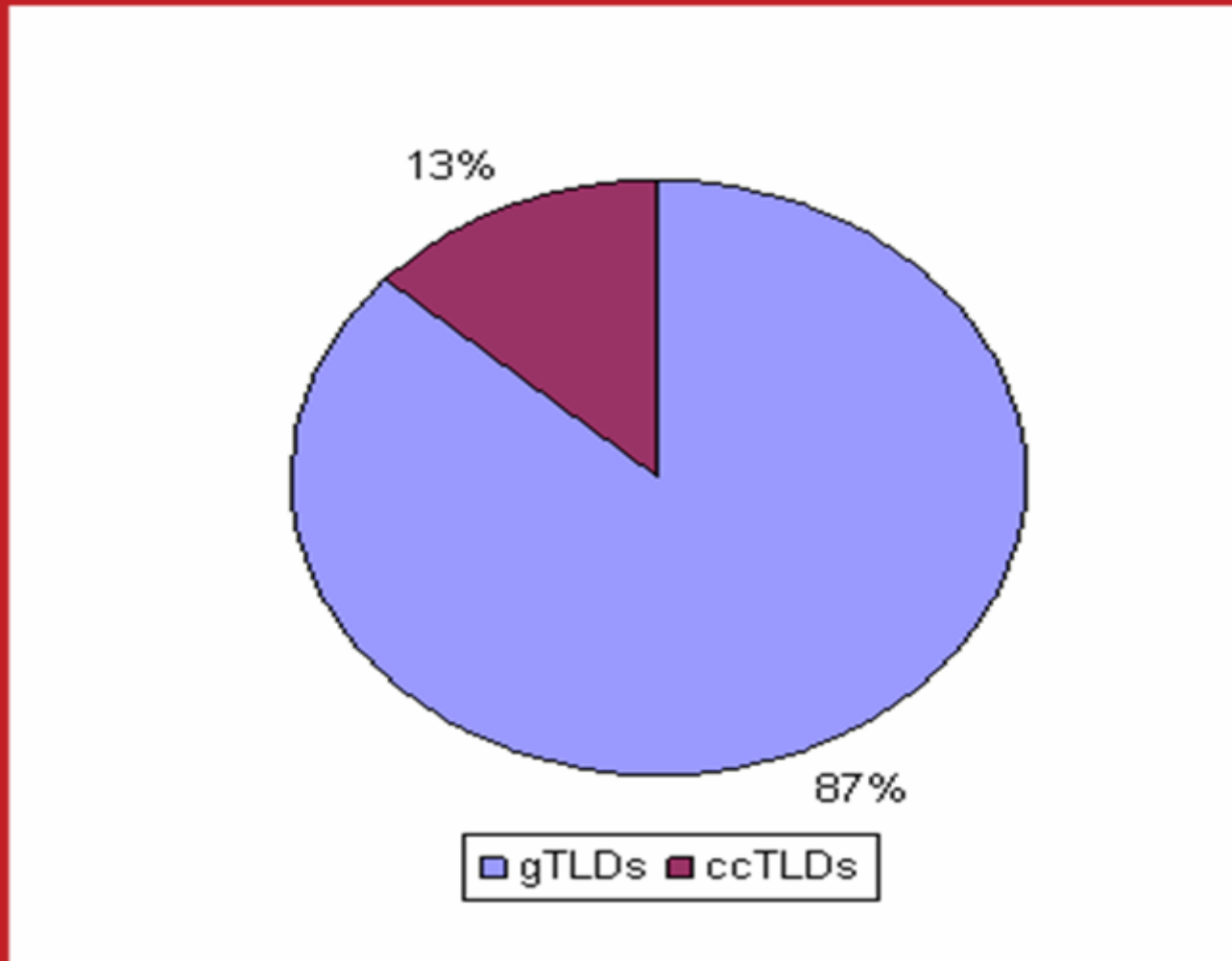


Which Industry Is Impacted The Most?





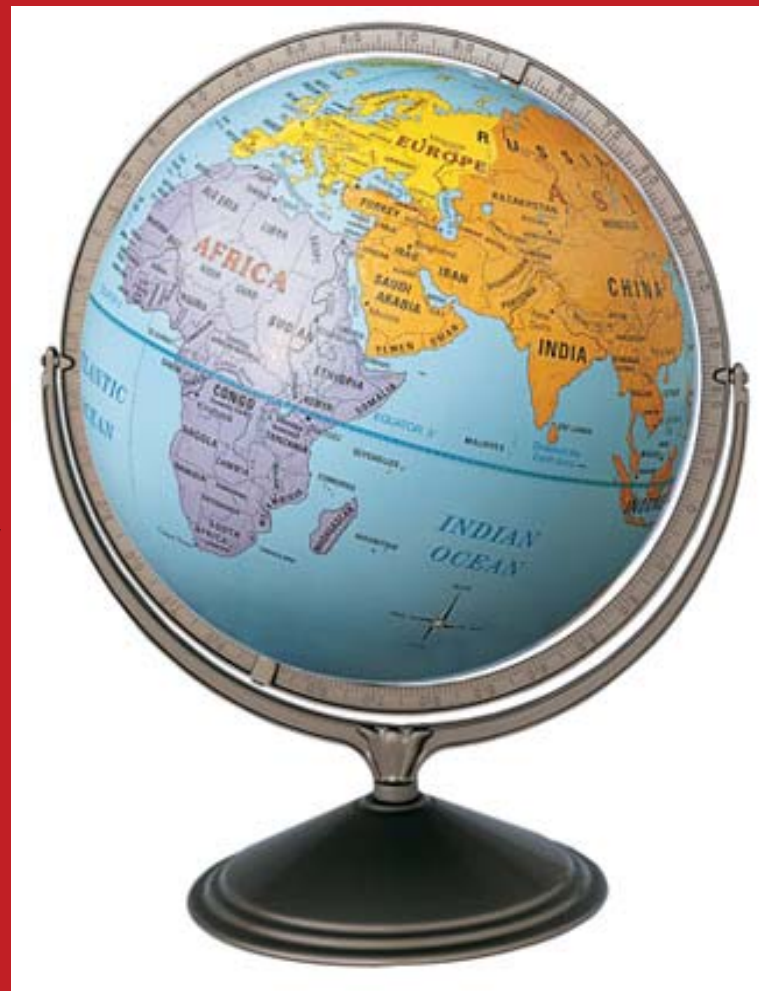
WIPO Cases gTLDs v. ccTLDs (2008)





The Universe Of gTLDs, SLDs, ccTLDs, etc., etc., etc., etc., etc., etc.

.aero the air transport industry **.arpa** reserved exclusively to support operationally-critical infrastructural identifier spaces as advised by the Internet Architecture Board **.biz** business use **.cat** Catalan **.com** commercial organizations **.coop** cooperatives **.edu** post-secondary educational establishments **.gov** government entities within the U.S. **.info** informational sites **.int** international organizations established by treaty **.jobs** employment-related sites **.mil** the U.S. military **.mobi** sites catering to mobile devices **.museum** museums **.name** families and individuals **.net** originally for network infrastructures **.org** originally for organizations **.pro** certain professions **.tel** telephone network services **.travel** travel agents, airlines, hoteliers, tourism bureaus, etc. **.asia** companies, organizations and individuals in the Asia-Pacific region **.uk** United Kingdom **.be** Belgium **.in** India





The Universe Of gTLDs, SLDs, ccTLDs, etc., etc., etc., etc., etc., etc.

Additional gTLDs Are Around The Corner





Sophistication Of Cybersquatters Cyber-Terminology

- Cybersquatting
- Typosquatting
- Domain Tasting
- Domain Parking
- Name Jacking
- Renewal Snatching / Alert Angling / Extension Exaggeration
- Cyberflying
- Serial Cybersquatter



Portal Websites Or Click-Through Advertising / Presumption Of Bad Faith

- “A website owner is paid click-through advertising revenues from having visitors to a web site subsequently click on a link or banner advertisement which leads the visitor to a second web site This sort of arrangement illustrates a reason why a website owner might want a well known mark included in its domain name.” *Nintendo of Am., Inc. v. Pokemonplanet.net et al.*, Case No. D2001-1020, at n.2 (WIPO Sept. 25, 2001) (transferring name, and characterizing the respondent’s use of the Complainant’s POKEMON mark as “another improper use of the Complainant’s mark for commercial purposes”);
- *Bang & Olufsen v. Unasi Inc.*, Case No. D2005-0728, at § C (WIPO Sept. 7, 2005) (finding bad faith as, *inter alia*, Respondent was using the disputed domain name as a “web portal with links to different products ... competing with those of Complainant’s” knowing “that Internet users recognize Complainant’s [] mark as identifying Complainant’s business”);
- *Microsoft Corp. v. Gioacchino Zerbo*, Case No. D2005-0644, at § C (WIPO Aug. 9, 2005) (“It may be inferred that the Respondent did register the domain name in dispute on purpose, to disrupt the Complainant’s business, as it used the domain name [in dispute] with sponsored links to competitors.”)



So How Do You Find A Cybersquatter?

WHOIS Search

Reverse WHOIS Search

The screenshot shows a Microsoft Internet Explorer browser window with the Google homepage. A search results box is displayed, listing various search terms and their corresponding result counts. The browser's address bar shows 'http://www.google.com/'. The Windows taskbar at the bottom indicates the system time as 3:45 PM.

Search Term	Results
whois search	
whois search domain	452,000 results
whois searches	298,000 results
whois search by registrant	669,000 results
whois search by owner	264,000 results
whois search by ip	686,000 results
whois search by email	1,160,000 results
whois search engine	2,900,000 results
whois search ip address	386,000 results
whois search uk	360,000 results
whois search by contact	668,000 results

[Advanced Search](#)
[Preferences](#)
[Language Tools](#)



Go To The Registrar's WHOIS Search Database

- www.networksolutions.com
- www.godaddy.com
- www.moniker.com
- Full list of ICANN-approved Registrars are publicly available at
www.icann.org/en/registrars/accredited-list.html



Contacting Registrar or Maybe The Registrant

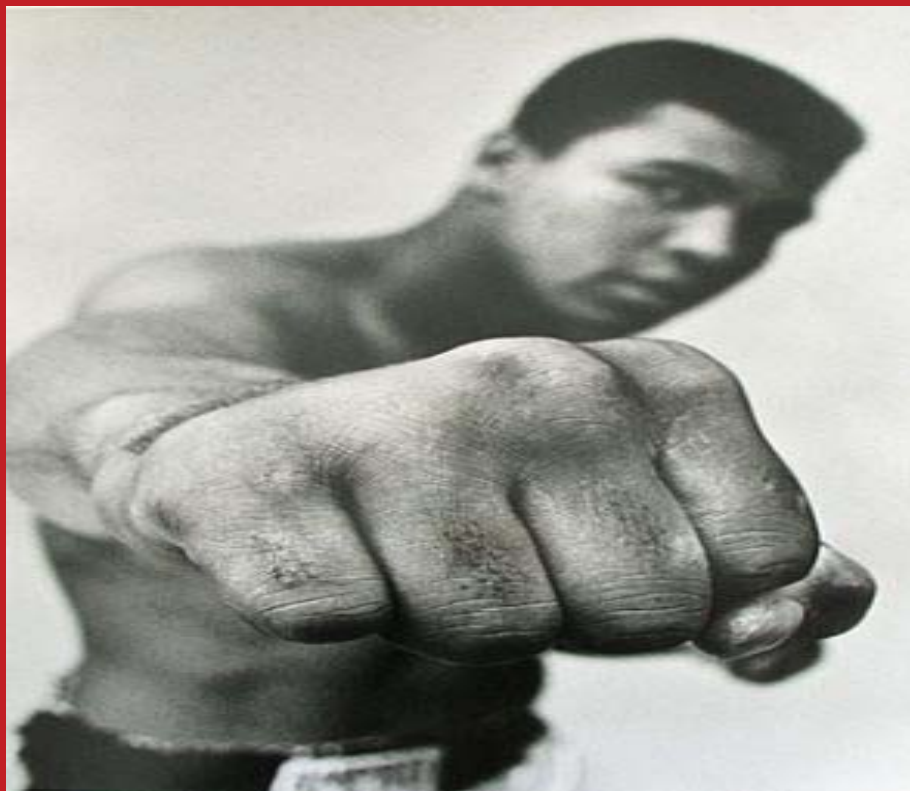
- Sometimes the Registrant is anonymous or private;
- Send Cease / Desist Letter?
 - Transfer Agreement w/o \$\$\$
 - Transfer Agreement w/ \$\$\$
 - Cyberflying Games Begin
 - Ignore You
 - Jurisdiction





How Do You Know Which Ones To Go After?

- Likelihood of Confusion Test (similarities or source affiliation)
- Dilution Test (blurring or tarnishment)
- Advertising Traffic To Your Advantage?
- DMCA Claim?





Why Not Sue The Registrar?



- In Rem Domain Name Action Under ACPA
- Recent Trend, Although Success Rate Is Not High
- Disfavored by ICANN (Sort Of)



Jurisdiction In Suing Registrant

- (www.kevinspacey.com)
- Lost in federal district court
Spacey v. Burgar, 207 F. Supp. 2d 1037
2001 WL 1869857 (C.D. Cal. 2001)
- Won In UDRP Proceeding
Kevin Spacey v. Alberta Hot Rods
D2000-1532, Claim No. FA0205000114437
Nat'l Arbitration Forum (Aug. 1, 2002)





ACPA

vs.

UDRP

- Imposes liability upon mere *registration* in bad faith.
- Damages may include actual or statutory damages.
- Discovery.
- Potentially high costs.
- Months/years.

- Requires that respondent *use* the domain name.
- Remedy limited to cancellation or transfer of the domain name.
- One pleading.
- Relatively inexpensive.
- 90 days.
- Potential for appeal to federal court.



Other Considerations

- WIPO vs. NAF vs. other forum
- Single person panel vs. 3-person panel
- Submitting to jurisdiction in ...
- Filing requirements (eUDRP initiative)
- Supplemental filings



4 Current ICANN-Approved UDRP Service Providers

- World Intellectual Property Organization ("WIPO")
- The National Arbitration Forum ("NAF")
- Asian Domain Name Dispute Resolution Centre ("ADNDRC")
- The Czech Arbitration Court ("CAC")



Common UDRP Issues

1. **Non-commercial / Fair Use**
 - Complaint forums
2. **Bad Faith Intent to Profit**
 - Cost-per-click linking portals
 - “This domain for sale”
 - Pornography
3. **The Gray Zone**
 - Resellers
 - “Tribute” pages
 - Acronyms
 - Disclaimers



One End Of The Spectrum: Complaint Forum

GMSucks.net - Microsoft Internet Explorer provided by Kilpatrick Stockton LLP

File Edit View Favorites Tools Help

Back Forward Stop Home Search Favorites Refresh Mail Print TV

Address <http://www.pontiacsucks.com/> Go Links >>

In my humble opinion, I think GM sucks...


GM SUCKS!

UPDATE!!!

LOWER INTAKE MANIFOLD GASKET LEAKING AT 40,000 MILES.

Home
Forums
GM In The News
Disclaimer

I noticed a small wet spot under the van this morning... I opened the hood, and found the radiator fluid reservoir was low and there's orange liquid coming from the passenger front side of the lower intake and dripping to the ground. Luckily, my oil isn't a milky color so I'm hoping that my motor isn't damaged.



Done Internet

start Disc... 3 M... DOC... 2 M... Rem... GMS... Google 3:11 PM

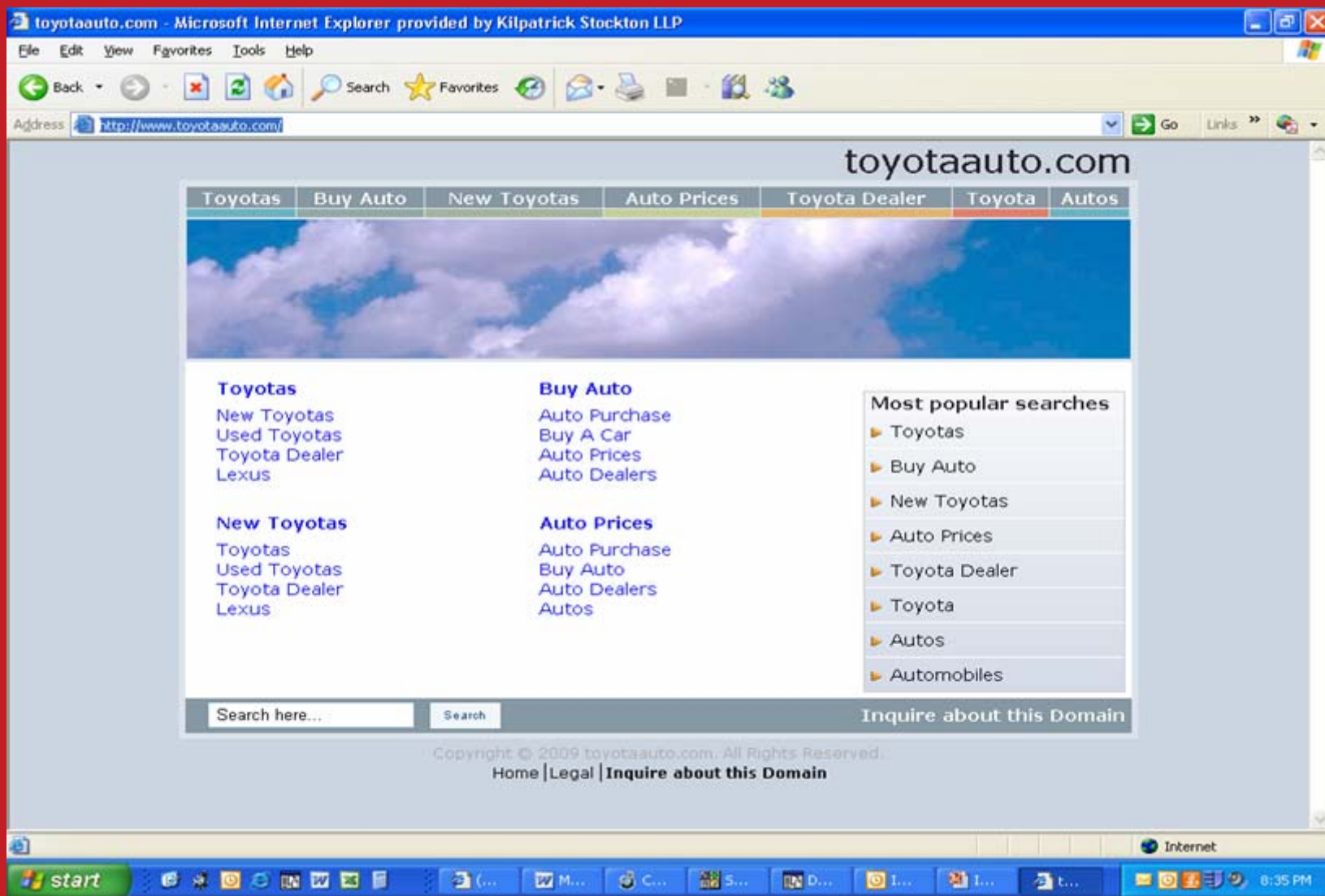


UDRP Elements

- Identical or confusingly similar
- No rights or legitimate interests
- Registered and used in bad faith



The Other End Of The Spectrum: Pay-Per Click Linking Portal





UDRP Elements

- Identical or confusingly similar
- No rights or legitimate interests
- Registered and used in bad faith



The Gray Zone

Toyota Nation - Windows Internet Explorer
http://www.toyotanation.com/

File Edit View Favorites Tools Help

Remote Ac... http://www... WIPO Over... National Ar... http://aix1... BuyaToyot... Toyota ...

TOYOTANATION.COM

International Toyota Enthusiast Community

home forum gallery vehicles premium classifieds about us contact

Google Custom Search

Ads by Google Toyota Trucks Honda Car Sales Toyota Vehicle Toyota Pricing Best Used Car

TN Toyota Nation

User Name Password

[Register](#) [Home](#) [Forum](#) [Gallery](#) [Active Topics](#) [TN Arcade](#) [Block](#)

Search TN

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764-6697
www.BrandNewToyota.com

Toyota Price



UDRP Elements

- Identical or confusingly similar ?
- No rights or legitimate interests ?
- Registered and used in bad faith ?



Resellers

- **Majority View:**
 - “A reseller can be making a bona fide offering of goods and services and thus have a legitimate interest in the domain name if the use fits certain requirements. These requirements include the actual offering of goods and services at issue, the use of the site to sell only the trademarked goods and the site accurately disclosing the registrant’s relationship with the trademark owner. The respondent must also not try to corner the market in domain names that reflect the trademark.” (WIPO Panel Views)
- **Minority view:**
 - “Without the express permission of the trademark holder the right to resell the trademark holder’s products does not create a right to use the trademark as the basis for a domain name.” (WIPO Panel Views)



“Tribute” Sites

- **View 1**
 - An active and clearly non-commercial fan site may have rights and legitimate interests in the domain name that includes the complainant’s trademark. The site should be non-commercial and clearly distinctive from any official site. (WIPO Panel Views)
- **View 2:**
 - Respondent does not have rights to express its view, even if positive, on an individual or entity by using a confusingly similar domain name, as the respondent is misrepresenting itself as being that individual or entity. In particular, where the domain name is identical to the trademark, the respondent, in its actions, prevents the trademark holder from exercising the rights to its mark and managing its presence on the Internet. (WIPO) Panel Views)



Disclaimers

- ***Consensus view:*** The existence of a disclaimer cannot cure bad faith, when bad faith has been established by other factors. A disclaimer can also show that the respondent had prior knowledge of the complainant's trademark. However a disclaimer is sometimes found to support other factors indicating good faith or legitimate interest. (WIPO Panel Views)



Some Theories to Consider

- **Opportunistic Bad Faith**
 - *Veuve Cliquot Ponsardin, Maison Fondée en 1772 v. The Polygenix Group Co.*, WIPO Case D2000-0163 (bad faith is found where a domain name “is so obviously connected with such a well-known product that its very use by someone with no connection with the product suggests opportunistic bad faith”).
 - *PepsiCo, Inc. v. Zhavoronkov*, WIPO Case No. D2002-0562 (“blatant appropriation of a universally recognized trademark is of itself sufficient to constitute bad faith”).



Some Theories to Consider

- Pattern of Conduct
 - *Amazon.com, Inc. v. Michele Dinoia c/o Szk.com*, NAF Case No. 536549 (“The fact that Respondent [has a] long history of abusive cybersquatting can leave no doubt as to whether his behavior in this instance was the product of inadvertence.”)



Some Theories to Consider

- Use of Privacy Services
 - *Fifth Third Bancorp v. Secure Whois Information Service*, WIPO Case No. D2006-0696 (“The use of a proxy registration service to avoid disclosing the name and coordinates of the real party in interest is also consistent with an inference of bad faith in registering and using the Domain Name, given the other evidence in this case of evasive and irresponsible conduct.”)



Add to Favorites!

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



Enter with Caution

- **Risks:**
 - Reverse domain name hijacking
 - Appeal
 - Costs
 - Press / public relations



Preventive Measures

- Watch Notice / Policing
- Domain Name Typosquatting Search
- Register TM, Register Domain Name
- Funnel Which Ones To Enforce



Policy Group Initiatives

To Be Continued



THANK YOU!

The End

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(At Least For Today)