



## ***ICANN Uniform Domain-Name Dispute-Resolution Policy***

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Athar A. Khan

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# Agenda

- Definitions & Terminology
- ICANN
- UDRP

- Anatomy of a Domain Name

Protocol	Server (subdomain)	Domain Name	TLD	Root
http://	www	mcandrews-ip	com	.

- DNS Lookup
- Registrant / WHOIS
- Registrar

# WHOIS Record for McAndrews-IP.com



Current Registrar: NETWORK SOLUTIONS, LLC.

IP Address: 82.165.179.227 (ARIN & RIPE IP search)

Record Type: Domain Name

Server Type: Apache 1

Lock Status: clientTransferProhibited

WebSite Status: Active

Registrant: McAndrews, Held & Malloy, Ltd., 500 W. Madison Street Suite 3400, Chicago, IL 60661, US

Domain Name: MCANDREWS-IP.COM

**Administrative Contact/Technical Contact:**

**jboettger@mcandrews-ip.com,**

**McAndrews, Held & Malloy, Ltd., 500 W. Madison Street Suite 3400, Chicago, IL 60661, US**

**Phone: 312-775-8000**

**Fax: 312-775-8100**

Record expires on 01-Mar-2015

Record created on 01-Mar-2007

Database last updated on 13-May-2009

Domain servers in listed order:

NS1.MHMLAW.COM 65.42.220.61

NS2.MHMLAW.COM 38.115.129.43

- Internet Corporation for Assigned Names and Numbers
- Formed in 1998
- Not-for-profit corporation with participants all over the world
- Coordinates Internet naming system
- Does not control content or traffic on the Internet

# Typical Scenario

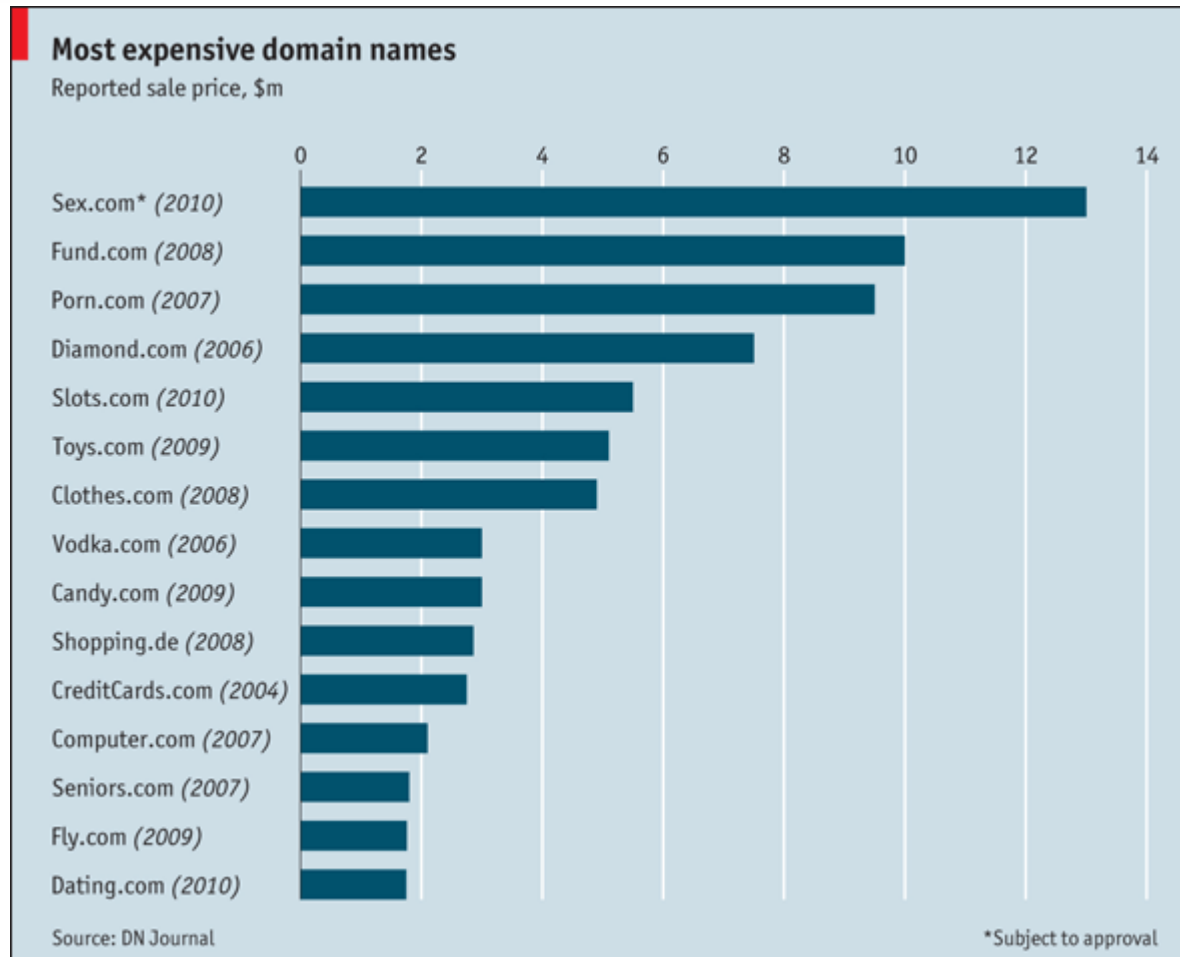
- You
  - Have a well established brand
  - Start a new company
- Someone attempts to profit off your reputation
  - “Abusive registration”
    - Cybersquatting
    - Typosquatting

# Typical Scenario

- You
  - Contact Registrant to obtain Domain Name
- Registrant
  - Will not transfer domain name
  - Wants unreasonably high amount



# Most Expensive Domain Names



- Economist, October 2010



# Options when confronted with a Registrant

- Pay
- Register a different name
- Litigate
- UDRP

# Uniform Domain Name Dispute Resolution Policy (UDRP)

Legal framework for resolving disputes between a domain name registrant and a third party that deals with:

- Abusive Registration
- Domain names in Generic Top Level Domains
  - Incorporated by Reference into Registration Agreement
  - gTLDs e.g. .com, .biz, .info, .net, .org, etc.
- Country Code Top Level Domains (ccTLDs)
  - That have adopted UDRP on voluntary basis
- Adopted on October 24, 1999

# Three Requirements of UDRP Paragraph 4(a)

- **Domain Name Identical or Confusingly Similar**
  - the domain name registered by the domain name registrant is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
- **Registrant has No Rights or Legitimate Interest**
  - the domain name registrant has no rights or legitimate interests in the domain name in question; and
- **Bad Faith**
  - the domain name has been registered and is being used in bad faith

- Select an Approved Dispute-Resolution Provider
  - WIPO
    - Disputes: 1 (1999) → 2696 (2010)
    - Domains: 1 (1999) → 4367 (2010)
  - National Arbitration Forum
  - Asian Domain Name Dispute Resolution Centre
  - The Czech Arbitration Court Arbitration Center for Internet Disputes
- Each provider has supplemental rules

# Overview of UDRP Administrative Procedure

- Complaint filed with ICANN-accredited dispute resolution service provider (e.g. WIPO)
- Response by person or entity against whom the Complaint was made;
- Administrative Panel (1 or 3 persons) appointed
- Administrative Panel issues decision
- Registrar implements Administrative Panel's decision to cancel or transfer domain name
- Total Process Takes ~ 60 Days
- See Handout for Flowchart



# Dispute Resolution Costs

	1-5 Domains	6-10 Domains
1 Panelist	\$1500	\$4000
3 Panelists	\$4000	\$5000

- Parties decide whether to select 1 or 3 Panelists
- Complainant responsible for total fees
- Respondent must share fee if respondent chooses 3 panelists and the Complainant had chosen a single panelist
- Details: [www.wipo.int/amc/en/domains/fees](http://www.wipo.int/amc/en/domains/fees)

# Three Types of Decisions

- Decide in Favor of Complainant
  - 1. Transfer Domain Name to Complainant, or
  - 2. Cancel Domain Name
  
- Decide in Favor of Domain Name Registrant
  - 3. Deny the requested remedy
  - If Panel concludes that the dispute is not within the scope of Paragraph 4(a) of the UDRP Policy, it must specify this in its decision
  - If Panel finds that Complaint was brought in bad faith, the Panel is required to declare in its decision that the Complaint was brought in bad faith and constitutes an abuse of the administrative proceeding

# Challenging an Administrative Panel Decision

- Under Paragraph 4(k), domain name registrant may challenge decision by filing suit
- Registrar will implement decision within 10 days unless complaint filed in a “Mutual Jurisdiction”
- Registrar will then take no further action until it receives:
  - (i) Evidence that the **dispute has been resolved**
  - (ii) Evidence that the **lawsuit has been dismissed or withdrawn**
  - (iii) A copy of a **court order dismissing the lawsuit** or ordering that the **domain name registrant has no right to continue** to use the domain name



## Location of **either**

- **(a) the principal office of the registrar** (provided that the domain name registrant has submitted in the Registration Agreement to that jurisdiction for court adjudication of disputes concerning or arising from the use of the domain name) **or**
- **(b) the domain name registrant's address** as shown for the registration of the domain name in the concerned registrar's WHOIS database at the time the Complaint is submitted to a dispute resolution service provider.

# Three Requirements of UDRP Paragraph 4(a)

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  - the domain name registered by the domain name registrant is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
- **Registrant has No Rights or Legitimate Interest**
  - the domain name registrant has no rights or legitimate interests in respect of the domain name in question; and
- **Bad Faith**
  - the domain name has been registered and is being used in bad faith

# Element 1: Identical / Confusingly Similar

- Threshold Test: Compare Mark to Domain Name
  - Mark must be recognizable within domain name
  - Visual or Aural comparison
    - Mike Rowe
  - Mark may not be subsumed within common word
    - “HEAT” within domain name “theatre.com”
  - Some panelists have required risk that Internet users may actually believe a real connection between domain name and complainant

# Element 1: Some Examples of Transfers

## ■ Transfer

- **Guinness.com** - Arthur Guinness Son & Co. (Dublin) Limited v. Dejan Macesic:
- **AbsolutXXX.com** - V&S Vin & Sprit AB v. Ooar Supplies
- **Alli-Xenical.com** - F. Hoffmann-La Roche AG v. P Martin
- **UnofficialBlackberryStore.com** - Research in Motion Limited v. One Star Global LLC

# Element 1: A Denial (HairyWinston.com)

- Harry Winston Inc. and Harry Winston S.A. v. Jennifer Katherman
- The Panel is much taken by three quotations from US authorities cited by the Respondent, namely:
  - “A parody must convey two simultaneous – and contradictory – messages: that it is the original, but also that it is not the original and is instead a parody.” [People for the Ethical Treatment of Animals –v- Doughney 263 F.3d (4<sup>th</sup> Cir. 2001)]
  - “Thus a parody relies upon a difference from the original mark, presumably a humorous difference, in order to produce its desired effect.” [Jordache Enterprises, Inc. v Hogg Wyld, Ltd 828 F.2d (10<sup>th</sup> Cir. 1987)]
  - “It is a matter of common sense that the strength of a famous mark allows consumers immediately to perceive the target of the parody, while simultaneously allowing them to recognize the changes to the mark that make the parody funny or biting.” [Tommy Hilfiger Licensing, Inc. v Nature Labs, LLC [221 F.Supp.2d (S.D.N.Y. 2002)]

# Element 1: “Sucks” Websites

- Domain Name and Negative/Pejorative Term considered confusingly similar for purposes of satisfying first element of UDRP
- Merits decided under subsequent elements
- Paragraph 4(c)(iii):
  - A legitimate **noncommercial** or **fair use** of the domain name, **without intent for commercial gain** to misleadingly divert consumers or to tarnish the trademark or service mark can establish legitimate rights and interests in a domain name.

## Element 2: No Rights or Legitimate Interest

- Complainant required to make out a prima facie case that respondent lacks rights or legitimate interests
- Burden shifts to respondent to demonstrate rights or legitimate interests

## Element 2: Criticism Websites

- Criticism Websites
  - Genuine, non-commercial criticism acceptable
  - Panel often finds free speech pretext for commercial advantage
- View 1
  - Right to criticize does not extend to registering and using an identical or confusingly similar domain name
- View 2 (Where both Parties are in US)
  - Irrespective of whether domain name connotes criticism, Respondent has legitimate interest in using trademark as part of domain name of a criticism site if such use is fair and non-commercial



## Element 2: Additional Considerations

### Whether

- Domain name registered and used genuinely for criticizing mark owner
- Registrant believes criticism to be well-founded and lacks intent for commercial gain
- It is immediately apparent to Internet users visiting the website at the domain name that it is not operated by the owner of the mark
- Respondent has refrained from registering all or most of the obvious domain names reasonably suitable for the owner of the mark
- Where appropriate, a prominent and appropriate link is provided to the relevant trademark owner's website
- Where there is a likelihood that email intended for the complainant will use the domain name in issue, senders are alerted in an appropriate way that their emails have been misaddressed

## Element 3: Bad Faith

- Paragraph 4(b)
  - Primarily to sell to complainant (trademark owner) or complainant's competition at a markup
  - To prevent mark owner from reflecting mark in domain name
  - Primarily to disrupt the business of a competitor
  - Intentionally creating likelihood of confusion for profit
- No Bad Faith
  - Domain name registered before trademark rights established (registration or common law)
  - No Bad faith because registrant could not have contemplated then non-existent right

