

The iPhone case [2]

- June 29, 2007 : iPhone launching in the USA
- July 24, 2007 :
 - 21.822 names use the chain of characters "iphone"
 - *iphoneanywhere.com*
 - *360iphone.com...*
 - 476 are a typo of "iphone"
 - *i-phone.com*
 - *iph0ne.com...*

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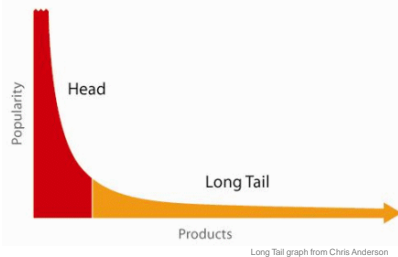
The iPhone case [3]

- Majority of names : typosquatting
 - *iohone.com*
- Some names are not used
- Other are used for:
 - Fans sites: *everythingiphone.com*
 - News sites: *i-phone.com*, *iphonematters.com*
 - 'Technique' sites: *iphonehacks.com*
 - Parking sites: *iohone.com*
 - Frauds: *freeappleiphonesnow.com*
 - Mushroom sites: *iphone + nano*



Domain names economy

- An illustration of the 'long tail economy'



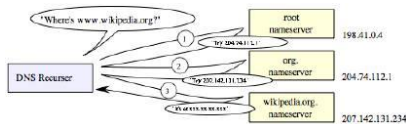
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Domain names and International IP law

1. Historical & technical background
2. U.D.R.P. principles
3. Practice of the U.D.R.P.

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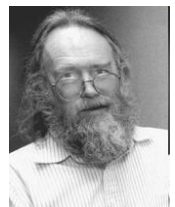
1. Historical & technical background



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1.1. Electronic address structures

- From the *Internet Protocol...*
 - Example: <http://128.214.104.36>
- ... to the *domain name*
 - <http://www.hanken.fi/>



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Electronic address structures

- Each address is made up of at least
 - one **Top Level Domain (TLD)**
 - gTLD
 - or ccTLD
 - a Second Level Domain (SLD)

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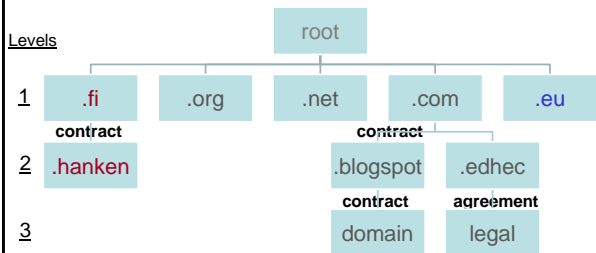
Electronic address structures

- The SLD can:
 - have up to 62-64 **characters**
 - be written with figures: 2600.com
 - be **multilingual**. Examples: 三共.com



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The hierarchical organization of domains



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An authority manages every namespace

- TLDs** are managed by **registries**
- Private authorities for gTLDs ~~NATIONAL BOARD OF PATENTS AND REGISTRATION OF FINLAND~~
 - (almost) no registration rules
- (Almost) private authorities for ccTLDs
 - in **each country**, an authority received a delegation for its own ccTLD [Ficora in Finland]
 - This authority create its own **rules** for registering
 - > [Directory](#) of authorities

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generic Top Level Domains

TLD	Year	Authority
.aero	2001	Société Internationale de Télécommunications Aéronautiques SC
.asia	2008	DotAsia
.biz	2001	NeuLevel
.cat	2005	Fundació puntCAT
.com	1995	VeriSign, Inc.
.coop	2001	DotCooperation, LLC
.edu	1995	EDUCAUSE
.gov	1995	US General Services Administration
.info	2001	Afilias Limited
.int	1998	Internet Assigned Numbers Authority
.jobs	2005	Employ Media LLC
.mil	1995	US DoD Network Information Center
.museum	2001	Museum Domain Management Association, (MuseDoma)
.name	2001	Global Name Registry, LTD
.net	1995	VeriSign, Inc.
.org	1995	Public Interest Registry
.pro	2002	RegistryPro, LTD
.travel	2005	Tralliance Corporation

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测试	IANA test	إختبار	IANA test
परीक्षा	IANA test	.台灣	Taiwan, Province of China / Taiwan Network Information Center (TWNIC)
ИСПЫТАНИЕ	IANA test	.台灣	Taiwan, Province of China / Taiwan Network Information Center (TWNIC)
Испытание	IANA test	امارات	United Arab Emirates / Telecommunications Regulatory Authority (TRA)
испытание	IANA test	الأردن	Jordan / National Information Technology Center (NITC)
中国	China / China Internet Network Information Center	السعودية	Saudi Arabia / Communications and Information Technology Commission
中國	China / China Internet Network Information Center	ไทย	Thailand / Thai Network Information Center Foundation
ශ්‍රී ලංකා	Sri Lanka / LK Domain Registry	рф	Russian Federation / Coordination Center for TLD RU
测试	IANA test	تونس	Tunisia / Agence Tunisienne d'Internet
آزمایشی	IANA test	مصر	Egypt / National Telecommunication Regulatory Authority – NTRA
பிரிட் டைம்	IANA test	இலங்கை	Sri Lanka / LK Domain Registry
香港	Hong Kong / Hong Kong Internet Registration Corporation Ltd.	فلسطين	Palestinian Territory, Occupied / Ministry of Telecom (MTIT)
δοκιμή	IANA test	.テスト	IANA test

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.XXX New generation

- eco, .gay, .music, .free, .sport, ...
- .paris, .berlin, .nyc, .sfo, .riga...
- .irish, .zulu, .bzh, .scot, .africa...
- .**canon** (and... ?)

Trademark holders concerns:

- Register, or not?
- Specific dispute resolution?

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country code Top Level Domains

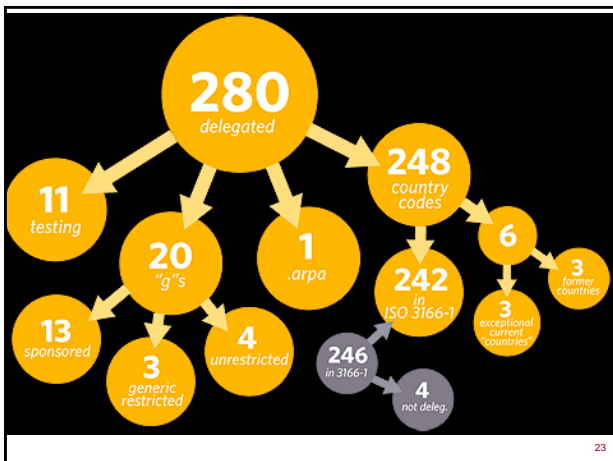
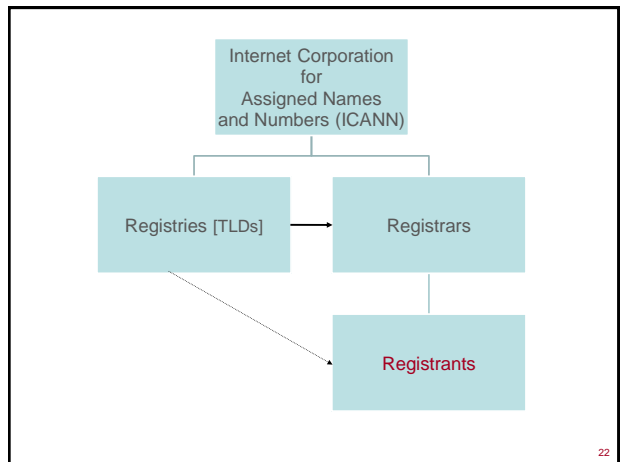
.de Germany	.ec Ecuador	.fi Finland	.ga Gabon
.eg Egypt	.ee Estonia	.fj Fiji	.gb United Kingdom
.dk Denmark	.eg Egypt	.fk Falkland Islands	.gd Grenada
.dm Dominican	.eh Western Sahara	.fm Micronesia	.ge Georgia
.do Dominican Republic	.et Eritrea	.fo Faroe Islands	.gf French Guiana
.dz Algeria	.es Spain	.fr France	.gg Guernsey
	.eu European Union		.gh Ghana
			.gi Gibraltar
			.gl Greenland
			.gm Gambia
			.gn Guinea
			.gq Guadeloupe
			.gr Greece
			.gs South Georgia and the South Sandwich Islands
			.gt Guatemala
			.gu Guam
			.gw Guinea-Bissau
			.gy Guyana
.hk Hong Kong	.id Indonesia	.je Jersey	.jm Jamaica
.hm Heard and McDonald Islands	.il Israel	.kn Saint Kitts and Nevis	.kg Kyrgyzstan
.hn Honduras	.in India	.kr Korea, Democratic People's Republic of	.kh Cambodia
.hr Croatia	.io British Indian Ocean Territory	.kp Korea, Republic of	.ki Kiribati
.ht Haiti		.kw Kuwait	.km Comoros
.hu Hungary		.kz Kazakhstan	

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Private namespace / Sovereign States

<p>Domain: tv Sponsoring Organization: Ministry of Finance and Tourism 2 Vaiaku Rd Funafuti Tuvalu</p>	<p>Domain: ax Sponsoring Organization: Ålands landskapsregering Strandgatan Mariehamn 22100 Åland Islands, Finland</p>
<p>Domain: su Sponsoring Organization: Russian Institute for Development of Public Networks (ROSNIIROS) Kurchatov Sq., Moscow 123182 Russian Federation</p>	<p>Domain: ps Sponsoring Organization: Ministry of Telecommunications & Information Technology, Government Computer Center Al-Irsal Street. City: Ramallah 674 Palestine Palestinian Territory, Occupied</p>

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1.2. Historical background

- IANA (Internet Assigned Number Authority)
 - NSI (Networks Solutions Inc.)
 - VeriSign
 - Internic I.C.A.N.N. (and VeriSign)

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Historical background

- How 'cybersquatting' was invented
 - The Wired / mcdonalds.com story (oct. 94)



- Why it has never stopped since then

First come, first served

+

Low registering costs

+

High procedural costs

=

TM infringement

International remedy: The **U.D.R.P.**

2. The birth of UDRP

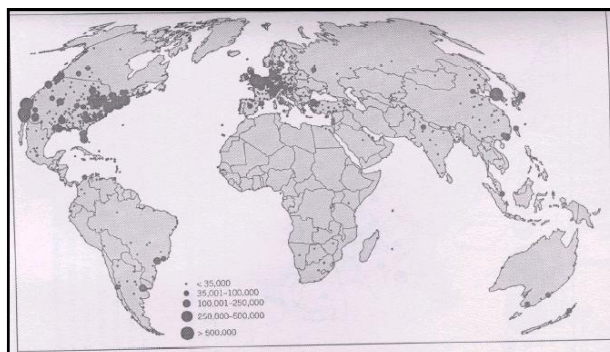


Fig. 8.3 : Nombre total de noms de domaines .com, .org, .net et codes pays d'Internet par ville dans le monde, juillet 2000. Source : Zook (2001a).

Domain names registrations by country (July 2000)
(source : Manuel Castells, *The Internet Galaxy*, 2002)

2.1. How to get back a stolen domain name in an international context?

- How can you know if your TM is used?
- Who is the cybersquatter?
- Where is the cybersquatter?

2.2. UDRP, the first **transnational** electronic procedure

- **Uniform Domain Name *Dispute Resolution Policy***
- Private rules
- Pyramidal implementation:
 - **defined** by the I.C.A.N.N.
 - **adopted** by the registrars
 - **accepted** by the purchasers
 - anyone who registers a (gTLD) domain name is bound by UDRP rules & accepts the principle of electronic proceedings

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UDRP, an example of a widely used ODR system

- Only for disputes between **trademark** holders and **domain names** holders
- Inspired more than 50 similar procedures

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Why such an ODR system?

- Abusive registrations of domain names
- Diversity of judicial responses
 - **Length** of proceedings
 - **Competency**
 - **Enforcement**
- Effects of legislative initiatives, if any
- Prevention tools hard to put in place

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A now **10 years old** ODR system

- International and uniform procedure to address *cybersquatting* disputes
- Mandatory
- Does not prevent parties to go before a national court

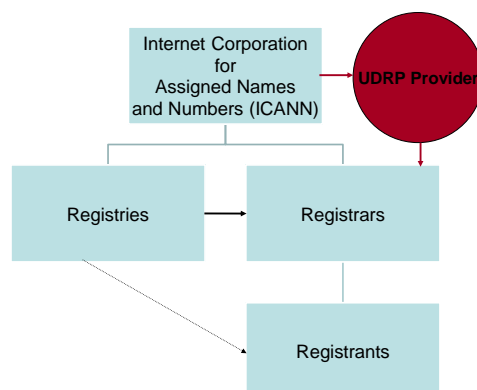
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5 ICANN-approved UDRP providers

- WIPO Arbitration & Mediation [Center](#)
- National Arbitration [Forum](#)
- CPR [Institute](#) for Dispute Resolution
- Asian Domain Name Dispute Resolution [Center](#)
- Arbitration Center for EU Disputes

[† eResolution stopped Nov. 30, 2001]

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Upsides & downsides

Strengths:

- Domain 'on hold' (article 8)
- Rapidity
- Costs
- Enforcement (3.c)

Drawbacks:

- Language
- Publicity
- Only for trademarks
- Only against frauds
- No punitive damages
- Written & abstract communications, 5,000 words limit
- Not for all the TLDs
 - But inspired 50 similar procedures

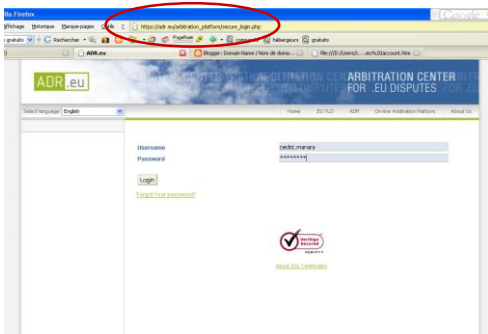
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Fees

.com, .org, .net, .info, .biz	WIPO	1500 \$ / 4000 \$
.com, .org, .net, .info, .biz	NAF	1300 \$ / 2600 \$
.com, .org, .net, .info, .biz	CAC (Arbitration Center for Internet Disputes)	1300 € / 3100 €

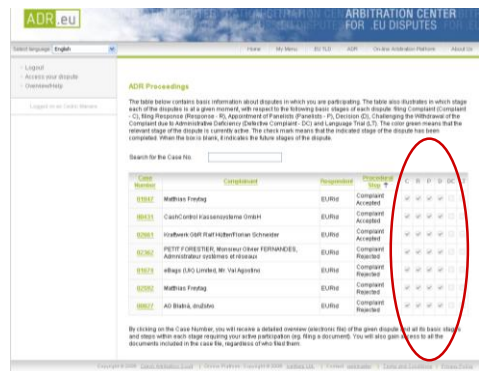
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(Quick) visit of an ADR platform



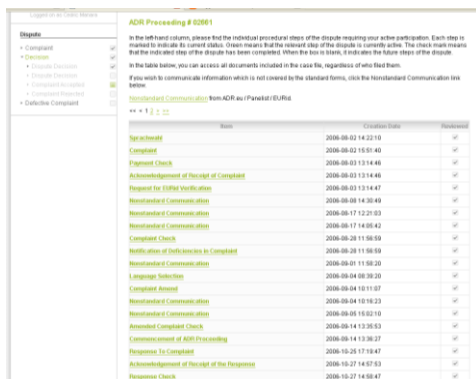
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Access to files



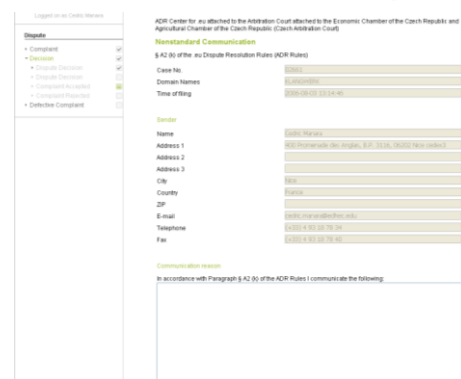
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Access to a case in particular

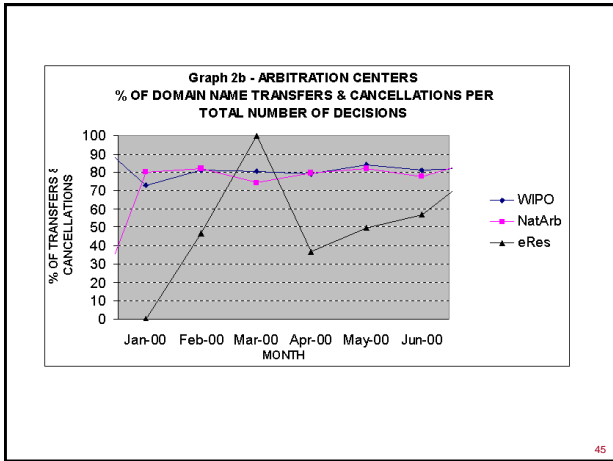
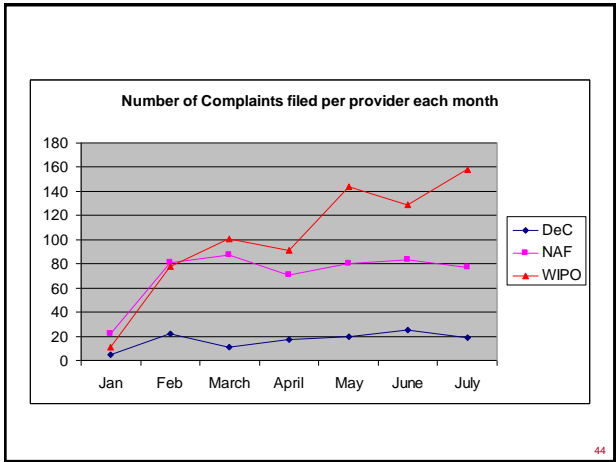
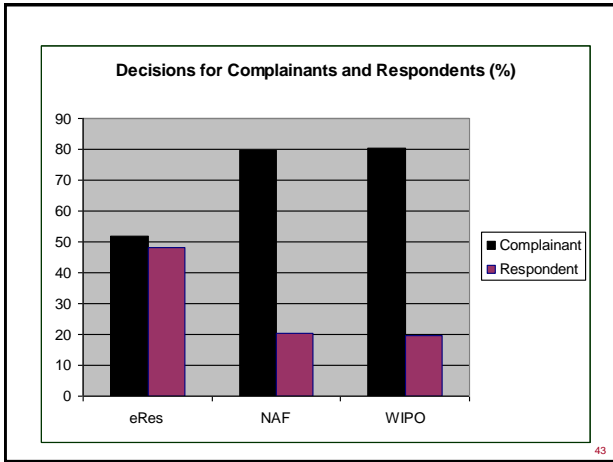


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Communication with the parties



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Comparison of provider market shares against average time to resolve disputes

Provider	Average Time to resolve a dispute (days)	Market Share
WIPO	45	59.06%
NAF	37	35.90%
eResolution	55	<8% (at time of bankruptcy)
ADNDRC / CPR	unknown	<1%

- « Clients do not pay their attorneys to obtain "justice". Clients pay attorneys to win. The last thing the [attorney] wants in an arbitrator is someone who is going to think. The [attorney] wants someone who is going to listen to be persuaded to find in the client's favour. (...) A practical attorney would not ... pick an arbitration provider wherein at least one of the members is known to have some kind of association with material critical of the interests of trademark holders with regard to the UDRP. Especially not, ... to save \$250 »
- John Berryhill, 'The UDRP Provides Disputable Resolution Incentives' (2000)

E-Resolution's changing Panelist composition

Date	Academic Panelists	% Academic Panelists	Practitioner Panelists	% Practitioner Panelists	Total Panelists
7/4/2000	25	51%	23	47%	49
26/9/2001	24	24%	76	76%	100

Press Release 435
Geneva, January 25, 2006

WIPO RESPONDS TO SIGNIFICANT CYBERSQUATTING ACTIVITY IN 2005

The World Intellectual Property Organization (WIPO) saw a 20% increase in the number of cybersquatting (abusive registration of trademarks as domain names) cases filed in 2005 as compared to 2004. In 2005, a total of 1,450 cybersquatting cases were filed with WIPO's Arbitration and Mediation Center. This increase represents the highest number of cybersquatting cases handled by the WIPO Center since 2001.

WIPO's Arbitration and Mediation Center has handled a total of over 8,350 disputes, involving parties from 127 countries and covering some 18,000 domain names since the Uniform Domain Name Dispute Resolution Policy (UDRP) – a quick and cost-effective dispute resolution procedure – went into effect in December 1999. In another development in 2005, the Internet Corporation for Assigned Names and Numbers (ICANN) approved the creation of new generic top-level domains (gTLDs), such as .travel and .jobs, with a number of further domains awaiting introduction in 2006.

"Understanding the unique effectiveness of the UDRP as a global remedy against cybersquatting, the fact that WIPO's caseload in 2005 was the highest in four years and that many of these cases concern recently registered domain names, creates the need for coordinated vigilance by intellectual property owners," said Mr. Francis Suter, Deputy Director General of WIPO who oversees the work of the Center. He further noted that, while WIPO's experience shows that UDRP disputes are heavily concentrated in the .com domain, attention must also be paid to the establishment of robust preventive mechanisms against abusive registration in new gTLDs. "If domain names are randomly attributed to new domains, intellectual property owners will be forced to compete with cybersquatters for their own trademarks – unless additional preventive safeguards are introduced," he added.

The UDRP's popularity stems from its cost effectiveness, the predictability of the process and swift enforcement of the results. Frequent users of the UDRP include the entertainment industry, pharmaceutical companies, IT firms and a significant number of small to medium-sized businesses who favor the UDRP over traditional litigation, because they consider it to be a far quicker and cheaper way of protecting their trademark rights against cybersquatting. Many UDRP decisions involve high-value brands that fall prey to cybersquatters, cases handled by the WIPO Center have involved most of the 100 largest international brands by value. Numerous well-known individuals, including Madonna, Julia Roberts, Eminem, Pamela Anderson, J. K. Rowling, Morgan Freeman, Ronaldirino and Lance Armstrong have also used the Center's services.

The Center's online facilities and its ability to handle cases in different languages have allowed parties from all parts of the world to protect their rights under the UDRP. While most cases are filed by parties based in the United States of America or Europe (including, increasingly, in Eastern European countries), cases have also been filed in 2005 by parties from Argentina and Barbados, Argentina, Bahamas, Barbados, Brazil, China, Honduras, Israel, Japan, Mexico, Morocco, Qatar, Senegal, South Africa, Tanzania, United Arab Emirates and Venezuela.

The UDRP, which was proposed by WIPO and has become accepted as an international standard for resolving domain name disputes, is designed specifically to discourage and resolve the abusive registration of trademarks as domain names. Under the UDRP, a complainant must demonstrate that the disputed domain is identical or confusingly similar to its trademark, that the respondent does not have a right or legitimate interest in the domain name and that the respondent registered and used the domain name in bad faith.

Disputes are decided by independent panels drawn from the Center's list of 400 trademark specialists from over 100 countries. The domain name in question is frozen (suspended) during the proceedings. After carefully reviewing each case, panelsists submit their decisions within a period of about 14 days. If a panelist's decision to transfer a domain name is not challenged in court within a period of ten days, the registrar is legally bound to implement the panelist's order.

All panel decisions are posted on the Center's web site. To facilitate access to the decisions, the Center also makes available an online legal index, which is unique in the world and continues to rank among the most-viewed WIPO web pages. WIPO panelists and panelsists use this index for their detailed jurisprudential research. To also offer them an overview of broad decision trends, the Center in 2005 created the new WIPO Overview of WIPO Panel Views on Selected UDRP Questions. The result of a review of the thousands of UDRP cases submitted to the Center, the Overview is an important instrument to help maintain the consistency of WIPO UDRP jurisprudence. It identifies common and important substantive and procedural questions and the views expressed in WIPO panel decisions on those questions, with reference to decisions that may be considered representative of those views.

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Right to go before a national court

- Article 4.K
 - These mandatory administrative proceeding requirements do not prevent parties 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
- UDRP decision is implemented within 10 days unless the arbitration center is notified that a complaint has been submitted to a court
 - Defendant only keeps during a brief period the right to go before a court
 - Effect: limitation of the right to appeal?

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Other remarks

- Selection of the Provider (4.d) but not the [panelist](#)
- Paragraph 15(a) of the supplemental Rules addresses the principles to be used in rendering a decision:
 - "A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."
 - Cultural and legal influences

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Estimated number of cases: +33,000 [yesterday]

UDRP Cases

Displaying results 1 - 10 of 33127 matches Show 98 | 25 | 50 | 100 results per page

Case Number	Domain(s)	Complainant	Respondent	Status
1348797	wynnencoremacao.com	Wynn Resorts Holdings, LLC	Oleksiy Oleksiy	TRANSFERRED 02-Nov-2010
03-Nov-2010 12:55pm	0 Comments	Follow case		
1348353	churchilcarinsurance.org	Churchill Insurance Co. Ltd	Coolidge road productions	TRANSFERRED 03-Nov-2010
03-Nov-2010 12:54pm	0 Comments	Follow case		
1348312	victorias-secret-giftcards.com	Victoria's Secret Stores Brand Management, Inc.	Quest cio Martin Wong	TRANSFERRED 03-Nov-2010
03-Nov-2010 12:54pm	0 Comments	Follow case		
1347807	wellsfargo.com wellsfargo.com	Wells Fargo & Company	Purple Bucquet	TRANSFERRED 03-Nov-2010
03-Nov-2010 12:54pm	0 Comments	Follow case		
1347369	laneybrant.com	Charming Shoppes, Inc.	Kiansu Thoi	TRANSFERRED 02-Nov-2010
03-Nov-2010 12:54pm	0 Comments	Follow case		
1347297	enterprise.com	Enterprise Holdings, Inc.	Domain Admin / Privacy Protect	TRANSFERRED 03-Nov-2010
03-Nov-2010 12:53pm	0 Comments	Follow case		
1346744	natwestcards.com	National Westminster Bank plc	Legateeb UK Ltd / James Booker	TRANSFERRED 03-Nov-2010

When is the U.D.R.P. applicable?

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

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

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3. Practice of the U.D.R.P.

3.1. "Your domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights"

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"trademark or service mark"

- Is Cho Yong Pil a trademark?



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- "It is not disputed that the Complainant's name Cho Yong Pil is essentially the same as the Respondent's domain name <CHOYONGPIL.COM>. However, it should be reviewed whether the name Cho Yong Pil functions as the Complainant's mark. It is noted that the Complainant has no trademark or service mark registration of the name and that the ICANN Policy and Rules do not require that the Complainant's mark be registered with a government authority or agency for such right to exist" (D2000-[0754](#))

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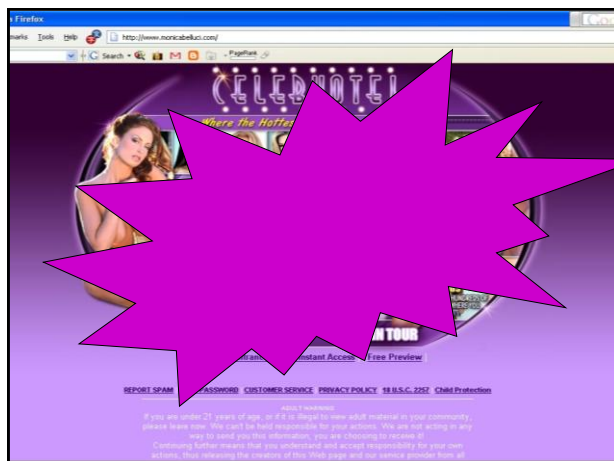
- Here, the passing off is likely given Cho Yong Pil's fame, especially in Korea and Asia. Accordingly, the Panel determines that the Complainant has shown that the fame in his name Cho Yong Pil is sufficient to give the Complainant trademark or service mark rights for the purpose of the Rules. The Panel thus concludes that the domain name <CHOYONGPIL.COM> is identical or confusingly similar to the Complainant's mark, Cho Yong Pil.

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Names of celebrities

- [juliaroberts.com](#) (D2000-[0210](#))
- [isabelleadjani.net](#) (D2000-[0867](#))
- [nicolekidmannude.com](#) (D2000-[1415](#))
- [venusandserenawilliams.com](#) (D2000-[1673](#))
- [madonna.com](#) (D2000-[0847](#))
- [sting.com](#) (D2000-[0596](#))
- [brucesteen.com](#) (D2000-[1532](#))
- [amymiller.com](#) (D2001-[1071](#))

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"identical or confusingly similar"

- Adjunction of
 - TLD (.com, .net) or www: D2002-[0425](#)
 - figure (2, 3): D2002-[0267](#), [D2002-1048](#)
 - hyphen: D2002-[0037](#)
 - 'e-': D2001-[0039](#)
 - 'group': D2002-[1166](#)
 - descriptive term to a famous TM: D2004-[0043](#) (sofitelcancun.com) or name of a product: D2000-[0306](#) (armani-sunglasses.com)

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"identical or confusingly similar"

The Respondent contends that he has rights and legitimate interests in the domain name on the basis of the fact that he has registered 三共.com for the official and non-commercial website of an organization named "Sankyo Art Salon", which the Respondent participated in founding. Especially, the Respondent points out that 三共 comprises two Japanese kanji, 三 (meaning "three") and 共 (meaning "together") and, thus, that the term 三共 is descriptive in Japanese. 三共 in Chinese has the same meaning. The Respondent contends that "Sankyo Art Salon," for which the Respondent contends to have registered the disputed domain name, is designed for an art presentation mode that combines three artistic forms of literature, music and painting together. Since MDN cannot function properly to this day, the Respondent has registered a domain name san-gong.com (san-gong is the pronunciation of 三共 in Chinese) and is constructing a website under this domain name. See <http://www.san-gong.com>. Accordingly, the Respondent contends that, just as many other Japanese firms use the name 三共 in their business, the Respondent has the equal rights to use this name as the domain name for a non-commercial website.

Are disparaging names confusingly similar to TM?

- [wallmartcanadasucks.com](#) (D2000-[1104](#))
 - "I do not see how a domain name including "sucks" ever can be confusingly similar to a trademark to which "sucks" is appended"
- [fucknetscape.com](#) (D2001-[0918](#)):
 - "The Panel regards it as inconceivable that anyone looking at this Domain Name will believe that it has anything to do with a company of such high repute as the Complainant. It is manifestly, on its face, a name, which can have nothing whatever to do with the Complainant. It is a name, which, by its very nature, declares that it is hostile to Netscape"
- [guinness-beer-really-really-sucks.com](#) (D2000-[0996](#))
- [accorsucks.com](#) (D2001-[0007](#))

- (...) In the absence of any Response from the Respondent, this Administrative Panel accepts that in the present state of development of the jurisprudence in this area, in cases where the administrative panel is being guided by the principles developing in the laws of the USA, the appropriate test to apply is the multi-factor test set forth in the decision of the United States Court of Appeals for the Ninth Circuit in *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341 (9th Cir. 1979). In doing so, this Administrative Panel is conscious that this test may not be entirely suited to the determination of these issues as can be seen from the difficulties experienced by this Administrative Panel in its application (*infra*). Nonetheless it is the test that has been applied in a number of cases where there has been a "-sucks" element. Furthermore, in the present case the Complainant has submitted that this is the appropriate test to apply and the Respondent has made no submissions on the point. In the circumstances, this Administrative Panel with some reservations, accepts that this is the appropriate test to apply. (...)

- (...) As to similarity of the marks: In comparing the marks for similarity, this Administrative Panel has used the *formula* suggested by the Complainant, and compared each in their entirety, as to appearance, sound, connotation and commercial impression. In the absence of any submissions by the Respondent, this Administrative Panel accepts that this is the appropriate approach to take. In applying this *formula*, this Administrative Panel has compared each of the said domain names with each of the Complainant's trademarks and accepts that insofar as each of them include the word "guinness" as the only or first word in the sequence of words, there is certainly a degree of similarity in each case. (...)

- (...) "it is likely (given the relative ease by which websites can be entered) that such users will choose to visit the sites, if only to satisfy their curiosity. Respondent will have accomplished his objective of diverting potential customers of Complainant to his websites by the use of domain names that are similar to Complainant's trademark."
- As the Internet extends far beyond the Anglophone world, a more difficult question arises as to whether non-English speaking users of the Internet would be confused into believing that such a site is owned and/or controlled by the Complainant. Because the word "-sucks" is a slang word with which all English speakers may not be familiar, this Administrative Panel concludes that there may well be circumstances where Internet users are not aware of the abusive connotations of the word and consequently associate the domain name with the owner of the trademark. (...)

Complaints can be denied

- [asdasucks.net](#) (D2002-[0857](#))

What are 'rights' or 'legitimate interests'?

- highclass.com (D2000-[0100](#))
- americanhomeproducts.com (D2000-[1239](#))
- technicard.com (NAF [94308](#))
- lovelygirls.com (D2000-[1270](#))
- elephantsanctuary.org (D2000-[1190](#))
- yourenergysource.com (NAF [96364](#))
- dw.com (D2000-[1202](#))
- scorpions.com (D2001-[0787](#))
- [chantellebra.com](#) (D2001-[1181](#))

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3.3. "Your domain name has been registered **and** is being used in bad faith"

- [justdoit.net](#) (D2002-[0544](#))
 - "the Complainant must show that the domain name **both** has been registered **and** is being used in bad faith.
 - Presumably, as there is no proof to the contrary, Respondent's purpose in obtaining the <justdoit.net> in 1997 was to use it as its main web page. As the only proof of the content of this "main web page" is Respondent's assertion that it highlighted its "funding, consulting and media offered services," there is insufficient proof of a "bad faith" registration."

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Registration and use in **bad faith**

- [nikepark.com](#), [nikepark.net](#), [nikemen.com](#), [nikegolf.net](#), [nikeshops.com](#) (D2002-[0352](#))
 - "In the Complainant's submission number 2 as set out in para. 5.4 above it asserts that "Respondent's use and registration of these domain names has prevented Complainant from using its own world-famous trademark in these domain names. This conduct constitutes bad faith registration and use of the domain names under controlling law and precedent." But, what was this use? There must be something beyond mere registration and it should be a use at the time of the commencement of the UDRP proceedings. It is the opinion of this Panel that mere continuous ownership is not sufficient."

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Registration and use in **bad faith**

- [armani.com](#) (D2001-[0537](#))



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3.4. UDRP proceedings in practice

- From the point of view of:
 - the **complainant** [3.4.1]
 - the **respondent** [3.4.2]

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3.4.1. From the **complainant's** point of view

- **Strategic reasons:**
 - Locate and notify the respondent
 - Domain name « on hold »
 - Speed
 - e-filing (transmission of documentation: 3 days)
 - response: 20 days
 - decision: 14 days
 - Enforcement

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Other upsides

- Possibility to **refile** (*≠ non bis in idem*)
- **Abuse** of procedure cannot be sanctioned

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Possible drawbacks

- Publicity
- **Language** of the proceedings
- Obligation to accept the competence of the jurisdiction where the registrar is based or the defendant has domicile
- Only **written** and abstract communications
- Limitation of the number of words
- Obligation to accept a non liability clause of the centre
- **Culture** of the expert...

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Powers of the panel

- Article 10:
 - (a) The Panel shall conduct the administrative proceeding in such manner as it considers appropriate in accordance with the Policy and these Rules. ...
 - (d) The Panel shall determine the admissibility, relevance, materiality and weight of the evidence.

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Panel decisions

- Article 15 (a)
 - A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and **any rules and principles of law that it deems applicable**

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No damages

- Article 4.(i):
 - The remedies available to a complainant pursuant to any proceeding before an Administrative Panel shall be limited to requiring the cancellation of your domain name or the transfer of your domain name registration to the complainant
- No (punitive) damages
- *Nota:* article 10.k of « .be » names registration rules
 - The dispute resolution fee is payable by the Complainant. However, if the Third-party Decider concludes that the domain name registration needs to be struck out or transferred, DNS BE shall repay the total of these costs to the Complainant and reclaim the thus repaid costs from the domain name holder. Upon DNS BE's first request, the domain name holder shall reimburse the repaid amounts. The domain name holder shall not have a right of recourse against DNS BE, the Dispute Resolution Entity, the Third-party Decider or the Complainant for the thus suffered financial loss. The potential financial loss for the domain name holder is the risk that the latter took for the speculative registration of domain names on which third parties have rights.

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3.4.2. From the respondent's point of view

- No damages
- Evidence tricks
 - **bruce springsteen.com** (2001 - D2000-1532)

– Nov. 2000 ↔ Feb. 2001

Currently Running Polls

- Eminem
- Justin Timberlake
- Jay-Z
- Kanye West
- Bruce Springsteen

The AUTHORIZED BRUCE SPRINGSTEEN.COM Web Site

Bruce Springsteen

NAME: []
 PASSWORD: []
 E-MAIL: []
 REGISTER

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Drawbacks

- No **anonymity**
- No **transparency** of panel selection
- No possible **challenge** of the panel
 - Article 7
 - A Panelist shall be impartial and independent and shall have, before accepting appointment, disclosed to the Provider any circumstances giving rise to justifiable doubt as to the Panelist's impartiality or independence. If, at any stage during the administrative proceeding, new circumstances arise that could give rise to justifiable doubt as to the impartiality or independence of the Panelist, that Panelist shall promptly disclose such circumstances to the Provider. In such event, the Provider shall have the discretion to appoint a substitute Panelist

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Right to a fair trial?

- UDRP designed for **quick** resolution of disputes
- Convention for the Protection of Human Rights and Fundamental Freedoms, Article 6.1
 - everyone is entitled to a fair and public hearing within a reasonable time by an independent and impartial tribunal established by law

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The World Intellectual Property Organization (WIPO) saw a 20% increase in the number of cybersquatting (abuse of registration of trademarks as domain names) cases filed in 2005 as compared to 2004. In 2005, a total of 1,456 cybersquatting cases were filed with WIPO's Arbitration and Mediation Center. This increase represents the highest number of cybersquatting cases handled by the WIPO Center since 2001.

WIPO's Arbitration and Mediation Center has handled a total of over 1,300 disputes, involving parties from 127 countries and covering some 18,000 domain names since the Uniform Domain Name Dispute Resolution Policy (UDRP) – a quick and cost effective dispute resolution procedure – went into effect in December 1999. In another development in 2005, the Internet Corporation for Assigned Names and Numbers (ICANN) approved the creation of new generic top-level domains (gTLDs), such as: travel and jobs, with a number of further domains pending introduction in 2006.

"Notwithstanding the unique effectiveness of the UDRP as a global remedy against cybersquatting, the fact that WIPO's caseload in 2005 was the highest in four years and that many of these cases concern newly registered domain names, underlines the need for continued vigilance by intellectual property owners," said Mr. Francis Gurn, Deputy Director General of WIPO who oversees the work of the Center. He further noted that, while WIPO's experience shows that UDRP disputes are heavily concentrated in the .com domain, attention must also be paid to the establishment of robust preventive mechanisms against abusive registration in new gTLDs. "If domain names are randomly attributed in new domains, intellectual property owners will be forced to compete with cybersquatters for their own trademarks – unless additional preventive safeguards are introduced," he added.

The UDRP's popularity stems from its cost effectiveness, the predictability of the process and swift enforcement of the results. Frequent users of the UDRP include the entertainment industry, pharmaceutical companies, IT firms and a significant number of small to medium-sized businesses who favor the UDRP over traditional litigation, because they consider it to be a far quicker and cheaper way of protecting their trademark rights against cybersquatting. Many UDRP decisions involve high-value brands that fall prey to cybersquatters; cases handled by the WIPO Center have involved most of the 100 largest international brands by value. Numerous well-known individuals, including Madonna, Julia Roberts, Eminem, Pamela Anderson, J. K. Rowling, Maggie Freeman, Ronalddora and Lance Armstrong have also used the Center's services.

The Center's online facilities and its ability to handle cases in different languages have allowed parties from all parts of the world to protect their rights under the UDRP. While most cases are filed by parties based in the United States of America or Europe (including, increasingly, in Eastern European countries), cases have also been filed in 2005 by parties from Antigua and Barbuda, Argentina, Bahamas, Barbados, Brazil, Canada, China, Honduras, Israel, Japan, Mexico, Morocco, Qatar, Senegal, South Africa, Tanzania, United Arab Emirates and Venezuela.

The UDRP, which was proposed by WIPO and has become accepted as an international standard for resolving domain name disputes, is designed specifically to discourage and resolve the abusive registration of trademarks as domain names. Under the UDRP, a complainant must demonstrate that the disputed domain is identical or confusingly similar to its trademark, that the respondent does not have a right or legitimate interest in the domain name and that the respondent registered and used the domain name in bad faith.

Cases are decided by independent panelists drawn from the Center's list of 400 trademark specialists from over 50 countries. The domain name in question is frozen (suspended) during the proceedings. After carefully reviewing each case, panelists submit their decisions within a period of about 14 days. If a panelist's decision to transfer a domain name is not challenged in court within a period of ten days, the registrar is legally bound to implement the panelist's order.

All panel decisions are posted on the Center's web site. To facilitate access to the decisions, the Center also makes available an online legal index, which is unique in the world and available to help visitors the most common WIPO-UDRP cases. WIPO's website also provides a free legal index for the most common cybersquatting cases. To learn more about the Center's services, please visit the WIPO website.

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Unequal treatment

- No **precedential** authority
- Burden of **evidence**:
 - on the complainant
 - but silence kept by the respondent often plays against it

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Reasoning

- Low cost procedure ⇔ Quality of reasoning (?)
 - e-auto-parts.com (2000 - D2000-0120):
 - *It is possible that Respondent does have some legitimate interest in respect of this name. For example, it is possible that this is one in a series of domain names registered by Respondent that contain descriptive terms that Respondent has registered for purposes of resale. (...) But it also is possible that Respondent registered this name knowing of Complainant's rights and hoping to force Complainant to purchase the name at a premium*

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Lawfulness?

- Is this system **legal**?
- **Opinion** dismissing claims against U.S. Department of Commerce in *Bord v. Banco de Chile* (205 F. Supp. 2d 521)

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The future of UDRP

- Technological sophistication
- Example: 100% electronic proceedings
 - « When a Party is obligated to submit a hardcopy to the Provider, this obligation can also be satisfied when the Party uses advanced electronic signatures based on a qualified certificate and created by a secure-signature-creation device, for the purposes of signing and filing the respective documents via the on-line platform of the Provider. » [ADR.eu Supplemental Rules, Paragraph A5]

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The future of ODR

- A legal trend encouraging ODR development in the EU
 - 2007: Regulation
 - 2008: Directive project
 - 2009: Case law

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Regulation on small claims procedure

- EC Regulation 861/2007 [July 11, 2007]
- Article 8
 - The court or tribunal may hold an oral hearing through video conference or other communication technology if the technical means are available

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Mediation in civil and commercial matters

- On April 23, 2008, the European Parliament formally approved the Council's common position on Mediation
 - The purpose of the Directive is to facilitate access to dispute resolution and to promote the amicable settlement of disputes by encouraging the use of mediation and by ensuring a sound relationship between mediation and judicial proceedings
 - The Directive applies to processes where two or more parties to a cross-border dispute of a civil or commercial nature attempt by themselves, on a voluntary basis, to reach an amicable settlement to their dispute with the assistance of a mediator
 - The Directive only applies to cross-border disputes, although it does not prevent Member States from applying the provisions of the Directive to internal mediation processes.

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ECJ ruling, 2009

- Joined Cases C-317/08 to C-320/08, *Rosalba Alassini and Others*
- Opinion of Advocate General [Nov. 19, 2009]
 - A mandatory dispute resolution procedure without which judicial proceedings may not be brought does not constitute a disproportionate infringement upon the right to effective judicial protection

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ADR.eu

The ADR .eu initiative [1]

- A multilingual ODR platform for consumer disputes
 - You are a consumer from Salerno, and bought a product online from a Swedish provider. You are not satisfied with the product
 - You file a complaint on-line in Italian; the Swedish online seller would be able to read this complaint in Swedish and communicate with the you in Swedish. You would communicate back in Italian
 - A decision will be provided in Italian, Swedish and English and will be implemented by the online provider without delay, otherwise the online provider will lose the right to use the system (and consumers will shop elsewhere)

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ADR.eu

The ADR .eu initiative [2]

- This initiative would create:
 - a multilingual ODR solution
 - more trust, and thus encourage e-commerce development
- *Financing:*
 - small regular contributions from online providers who subscribe to the system for the resolution of their consumer disputes
 - In return, they can use a trust mark
 - consumers will pay a nominal fee if they proceed to mediation/arbitration.
- Has support from the European Commission and European Parliament
- The project should have been launched on January 1, 2010

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The word "Tack !" is written in a large, colorful, serif font. The letters are multi-colored: 'T' is green, 'a' is yellow, 'c' is green, 'k' is blue, and '!' is red. The text is centered on a light green rectangular background.

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