

Evicting Cybersquatters: A Practical Guide to the Uniform Domain Name Dispute Resolution Policy

Rebekah Gay and David Stone, solicitors, Freehills.¹

INTRODUCTION

Internet domain names were originally designed to allow internet users to locate a web site using a people-friendly and easy to remember address.² However, with the explosion of commercial internet activity the structural limits of cyberspace domain names have become important and valuable³ business and personal identifiers.

One of the results⁴ has been "cybersquatting", the practice of registering as a domain name, a trade mark or name belonging to another entity, often in the hope of later "selling" the domain name registration to the trade mark or name owner at a profit.⁵

Many people now consider domain names to be important "intellectual property rights". However, whilst rights in contract arise on registration, there is no legislative regime in Australia which specifically establishes rights in domain names. Any rights with respect to a domain name must be cobbled together from traditional intellectual property rights, particularly those under the *Trade Marks Act 1995* (Cth), the *Trade Practices Act 1974* (Cth) and the law of passing off. Registration of a domain name results in a worldwide cyber presence: this has caused difficulties for trade mark owners, whose rights have limited geographic application, but whose concerns are international.

What, then, is the problem? The answer⁶ runs something like this: consumers seeking a telephone number for a business will look it up in a telephone book. There is no "phone book" for the internet, so web surfers will often begin by hazarding a guess at the domain name. It is here that cybersquatting leads internet surfers into error: "companyname.com" or "trademark.com" will display the site of the first person to register that domain

name, not necessarily the company or the trade mark owner.⁷ That error may lead a customer to a competitor, may cost the trade mark owner business or may create income for wholly unrelated profiteers.⁸

On 24 October 1999, with a view to addressing the difficulties associated with the global protection of trade marks (and particularly in response to the ease of registration of top-level domain names), the Internet Corporation for Assigned Names and Numbers (ICANN)⁹ adopted the Uniform Domain Name Dispute Resolution Policy (UDRP). Given the difficulties and costs of evicting cybersquatters through the courts,¹⁰ the UDRP is a significant boon for trade mark holders around the world.

Previous articles in this journal have discussed the development of the internet¹¹ and the ICANN UDRP.¹² This paper attempts to provide a practical guide to use of the UDRP procedure.

UDRP JURISDICTION

All registrars of the .com, .net, and .org top-level domain names¹³ have adopted the UDRP.¹⁴ When a person registers a top-level domain name, the UDRP is incorporated into the contract between the domain name holder and the registrar. The domain name holder agrees to submit to a mandatory administrative proceeding if a complaint is made of abusive domain name registration.¹⁵ If the domain name holder refuses to submit to the procedure, the UDRP proceeding will still take its course, a determination will be made, and orders may be issued to the domain name requiring transfer or cancellation of

the domain name.

The UDRP applies to all .com, .org and .net domain names and to a small number of country code domain names: .ac (Ascension Island), .ag (Antigua and Barbuda), .as (American Samoa), .cy (Cyprus), .gt (Guatemala), .na (Namibia), .nu (Niue), .ph (Philippines), .sh (St Helena), .tv (Tuvalu), and .ws (Western Samoa).

There are separate dispute resolution policies for a number of country codes.

Australia has not to date ascribed to the UDRP¹⁶. Some argue that the Australian practice of requiring registrants to prove they own a business or company name from which the domain name is derived has prevented many of the difficulties of top-level domain name cybersquatting. However, the domain name registration requirement may not be as effective as initially thought because business name registrations are easily purchased: the practice has been a cash bonus for the Australian government, which has benefited from the fees of increased business name registrations.

Recent industry calls for competition in the domain name registration industry in Australia may indicate strict registration practices are unlikely to survive much longer.¹⁷ Reform will be needed: the lack of an appropriate .com.au dispute resolution procedure at present is a significant failing of the Australian system.

For domain names other than the three registrable top-level domain names,¹⁸ trade mark owners should check with the country code or other registrar to determine if any form of administrative or arbitral procedure applies. A list of country codes, hypertext-linking to country code registrars, is at <www.iana.org/cctld/cctld-whois.htm>.

UDRP ADMINISTRATIVE PROCEEDINGS

The UDRP provides that a domain name holder must submit to mandatory administrative proceedings if a third party lodges a complaint which alleges that:

- 1) the domain name is identical or confusingly similar to a trade mark or service mark in which the complainant has rights; *and*
- 2) the domain name holder has no rights or legitimate interests in respect of the domain name; *and*
- 3) the domain name has been registered and is being used in bad faith.

The complainant must prove that all of the three requisite elements are present.¹⁹

In all other circumstances, the UDRP provides that a domain-name dispute must be resolved through court action, arbitration or other proceedings.²⁰

Some comments on each of the requirements are made below.

(1) IDENTICAL OR CONFUSINGLY SIMILAR

The requirement for a domain name to be "identical or confusingly similar" to the complainant's mark has not been a big issue in proceedings decided to date - the impugned domain name is unlikely to attract the trade mark owner's attention unless it is identical or confusingly similar.

A registered trade mark does not have to be registered in the jurisdiction of the respondent/domain name registrant: the internet's reach is global.²¹

It is worth noting that unregistered marks such as a person's name may also give the owner rights under the UDRP. Actors Julia Roberts and Isabelle Adjani, author Jeanette Winterson and performer Madonna have all succeeded in ICANN proceedings.²²

As *The Times of India*, for which the

well known but unregistered marks have also been successfully protected, such trade mark registration in India had lapsed.²³

(2) NO RIGHTS OR LEGITIMATE INTERESTS

Whether or not the domain name holder has "rights or legitimate interests in respect of the domain name" will often be a matter, at least initially, of some conjecture.

The UDRP provides a non-exhaustive list of factors which "shall demonstrate the registrant's rights or legitimate interests to the domain name". These are:

- 1) before any notice to the registrant of the dispute, the registrant used or was demonstrably preparing to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or Services; *or*
- 2) the registrant (as an individual, business, or other organisation) has been commonly known by the domain name, even if the registrant has acquired no trade mark or service mark rights; *or*
- 3) the registrant is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain misleadingly to divert consumers or to tarnish the trade mark or service mark at issue.²⁴

Some examples, such as the first case decided under the UDRP, *worldwrestlingfederation.com*²⁵ will be obvious: the mark could not readily or obviously belong to anyone else.²⁶

In other cases, it will be necessary to investigate any website which appears at the domain name and perhaps any physical business or organisation it refers to. Domain names holders which appear to be illegitimate may, in fact, have legitimate interests in their domain name. Penguin Books lost its application

in relation to *penguin.org*, because the domain name holder brought evidence that he was known by the nickname "Penguin" and his wife as "Mrs Penguin". The UDRP panel ruled he had a legitimate interest in the domain name.²⁷

Legitimate rights or interests may also be established by registration of a trade mark from which the domain name is derived, although not if the registration is merely to protect the interests in the domain name.²⁸

Change of name by deed poll will also not assist a domain name registrant to resist a complaint: Mr Oxford University failed because that wasn't his name at the time of registration.²⁹

Whilst the UDRP and the reported cases do not put it in these terms, we have the impression that once the complainant has established its rights in a trade or service mark, the onus is on the defendant to prove it *does* have a legitimate interest rather than the complainant having to prove the registrant *does not* have legitimate rights.³⁰ Many respondents to UDRP complaints never respond, and so, in the absence of any evidence, fail to establish a legitimate interest.

(3) USE IN BAD FAITH

Where factual evidence may be hardest to compile is in relation to the requirement that the domain name has been registered and is being used in bad faith.

A decision under the UDRP has found that registration alone, without any further use (such as setting up a webpage at the address) can constitute "registration and use in bad faith".³¹

The UDRP provides certain circumstances which are taken to be evidence of registration and use of a domain name in bad faith:

- (a) circumstances indicating that the domain name has been registered or acquired primarily for the purpose of selling, renting or otherwise transferring it to the complainant (who is the owner

of the trade mark or service mark) or a competitor of the complainant for valuable consideration in excess of the documented out-of-pocket expenses for registering of the domain name;

- (b) the domain name has been registered to prevent the owner of the trade mark or service mark from reflecting the mark in a corresponding domain name, provided that the domain name holder has engaged in a pattern of such conduct;
- (c) the domain name has been registered primarily for the purpose of disrupting the business of a competitor; or
- (d) by using the domain name, the domain name holder has intentionally attempted to attract internet users for commercial gain by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation or endorsement of the website or of a product or service on the website.

Each is discussed below.

(a) Intention to profit

Usually a complainant trade mark owner will have clear evidence of an intention to transfer the domain name at a profit only if the domain name holder has offered to sell the domain name. Trade mark owners and their advisers seeking to elicit such an offer from a domain name holder should exercise caution. An offer from the *trade mark owner* to purchase the domain name for a figure will not necessarily constitute evidence of the *domain name holder's* purpose.³²

We are unaware of any decision which has expressly balanced the primary purpose of the domain name holder against any other purpose. The primary purpose appears to be reasonably readily inferred.

Dollar values need not be significant. The amount involved in the *worldwrestlingfederation.com* case involved an asking price of US\$1000.³³

A demand for cash is also not essential, with UDRP panellists holding that requests for free university tuition³⁴ or shares³⁵ established registration and use in bad faith.

In *The Wiggles Touring Pty Ltd v Thompson Media Pty Limited*,³⁶ <www.wiggles.com> was offered for sale for "a quarter of the value of a small Australian car". The UDRP panellist also appeared to be influenced by the respondent's registration of 37 other domain names, including tooheys.com, kimbeazley.com and dairyfarmers.com. He ordered the domain name be transferred to the Wiggles.

(b) Preventative registration

This type of bad faith was designed to catch cybersquatters who register domain names but do not make an offer to sell them and do not use them in any other way.

For an example see *Adobe Systems Incorporated v Domain Oz*,³⁷ where 256 domain names had been registered, many including famous marks.

The requirement for a "pattern of such conduct" is also a matter on which a complainant can accumulate evidence. Domain name registrar Network Solutions Inc provides a search function³⁸ which enables users to identify the holder of any .com, .org or .net domain name. The search function can also locate all other domain names registered by that person. If the person has registered a number of well-known trade marks as domain names, a pattern of conduct will be established.³⁹

(c) Disruptive registration

The reported UDRP decisions suggest that, by and large, major corporations are not engaging in cybersquatting to disrupt their competitors' businesses. Some smaller entities have. Because of the enhanced capacity for confusion, and the commercial benefits that flow from it, where appropriate, this "head" of bad faith will be readily made out.⁴⁰

In *The Chancellor, Masters and Scholars of the University of Oxford v DR Seagle*,⁴¹ the panellist found against Mr Seagle, although there was

no evidence Mr Seagle was a competitor of the University. The panel ordered that *oxford-university.com* be transferred to the University.

(d) Intention to attract internet users by causing confusion

Many of the cases which have been decided under this example of bad faith involve misspellings of domain names (*microsof.com*,⁴² *guinnes.com*⁴³).

In *Encyclopedia Britannica Inv. v John Zuccarini and the Cupcake Patrol*,⁴⁴ Mr Zuccarini had registered 1,300 misspelled domain names, including *opharahwinfrey.com* and *jeneferlopez.com*, and relevantly, a misspelled version of the famous reference work. He was allegedly "earning" US\$1 million a year from advertising revenue of 25¢ per hit on each site.

(e) Other

The four examples of "bad faith" set out in the policy are not exclusive. UDRP panellists have, in the absence of all four, still found bad faith and transferred the impugned domain name. Further examples of "bad faith" include where the domain name links to a pornographic site,⁴⁵ where registration was by former employees, contractors and distributors⁴⁶ and where the registrant failed to provide true name and contact details in the registration.⁴⁷

DISPUTE RESOLUTION SERVICE PROVIDERS

The Rules for UDRP provide that a complainant can initiate proceedings by submitting a complaint to any dispute resolution service provider approved by ICANN (**Provider**).⁴⁸ To date, ICANN has approved four Providers:

1. CPR Institute for Dispute Resolution (CPR), New York;⁴⁹
2. Disputes.org/eResolution Consortium (DeC), Montreal;⁵⁰
3. The National Arbitration Forum (NAF), Minneapolis;⁵¹ and
4. World Intellectual Property Organisation (WIPO), Geneva.⁵²

Each Provider must comply with the Rules for UDRP. Each Provider also has its own

supplemental rules that govern, in greater detail, the conduct of administrative proceedings.⁵³

Because complaints are dealt with almost entirely in “cyberspace” (face to face “hearings” are rare), it is not necessary to choose a Provider with local links. However, several providers have panellists resident in Australia,⁵⁴ which complainants may find useful in some circumstances (such as where reference will be made to reputation in Australia or to Australian law). Alternatively, the complainant may wish to choose a three member panel and nominate an Australian.

FILING A COMPLAINT

A complaint must be filed with a Provider in both hard copy and electronic form. The complaint must, amongst other things:

1. specify the domain name(s) the subject of the complaint;
2. identify the respondent (the domain name holder) and provide contact details for the respondent;⁵⁵
3. identify the registrar with whom the domain name is registered;⁵⁶
4. specify the trade mark or service mark on which the complaint is based and describe the goods or services to which each mark relates;
5. describe the grounds on which the complaint is made including:
 - a. the manner in which the domain name is identical or confusingly similar to the complainant’s mark;
 - b. why the respondent should be considered as having no legitimate interest in the domain name; and
 - c. why the domain name should be considered as being registered in bad faith;

6. designate whether the complainant elects to have the dispute decided by a single-member or three-member administrative panel;
7. specify the remedies sought; and
8. annex any documentary or other evidence on which the complainant relies.

In addition, the rules of each Provider contain further requirements in relation to the form and contents of complaints. Helpfully, model complaints are available at each Provider’s website.

Each Provider charges a fee for a complaint. The fees vary according to whether a single-member panel or three-member panel is to determine the dispute and according to the number of domain names in dispute. Fees range from US\$750 to US\$6,000. Generally the fee is payable by the complainant. Where the respondent requests the matter be determined by a three-member panel, the fees are shared equally by the parties.

Importantly, once a complaint is filed, the domain name cannot be transferred to another owner.⁵⁷

THE PROCESS FOR DETERMINING A COMPLAINT

Once a complaint is filed, the Provider must send a copy of the complaint to the domain name holder. The domain name holder has 20 days from the date of the complaint within which to respond. The Rules for UDRP and the supplementary rules of each Provider set out what information must be included in the response. The complainant does not have an automatic right of reply to the domain nameholder’s response: all information, and evidentiary exhibits, should therefore be included in the initial complaint.⁵⁸ One of the providers now provides an express right of reply in its supplementary rules. This divergence in practice between providers is unfortunate.⁵⁹

Once a response has been filed, the Provider will appoint a panel. The panel, except in extraordinary circumstances, has 14 days in which to reach its decision. Unless the panel determines otherwise, there are no in-person hearings and the matter is determined on the basis of the written evidence submitted by the parties.

AVAILABLE REMEDIES

The UDRP aims to provide a decision within 45 days of the complaint being filed. If the panel decides in favour of the complainant, the panel can order:

1. that registration of the domain name be cancelled; or
2. the domain name registration be transferred to the complainant.

The UDRP provides no power to award damages or costs.

The panel’s decision is enforced by the relevant registrar, which is notified of the decision by the Provider. The Provider notifies the domain name holder of the decision 10 days prior to notifying the registrar, in order to give the domain name holder sufficient time to commence legal proceedings against the complainant, should it wish to do so. If legal proceedings are commenced, the decision of the UDRP panel is stayed pending resolution of the proceedings.

DECISIONS UNDER THE UDRP

As at 20 October 2000, 2082 domain name dispute proceedings had been filed under the UDRP relating to 3771 domain names. Of those proceedings, 1327 had been determined, with 1037 decisions (78%) being in favour of the complainant. In the proceedings decided in favour of the complainant, the relevant domain names were transferred (99%) or cancelled (1%).⁶⁰

Sufficient determinations have been made under the UDRP for a jurisprudence to begin to emerge. This provides a fruitful, if still somewhat informal, source of precedent.⁶¹

The developing body of case law has clarified a number of issues, but also raised a series of further questions. Some of these are discussed below.

(1) WHAT LAW APPLIES?

Panellists from many different jurisdictions are appointed to determine disputes, often between parties in different jurisdictions. Most of the decisions panellists make are determination of questions of fact: in such cases, there is no need for the panel to involve local law. But where the panel seeks the assistance of local law, which law applies? Different panels have adopted different approaches.

In *Madonna Ciccone p/k/a Madonna v Dan Parisi and "Madonna.com"*,⁶² decided by a three person panel on 12 October 2000, the panel discussed the appropriate standard for fact finding in UDRP proceedings. The panel applied the United States civil standard of "a preponderance of the evidence" (similar to the Australia civil standard of "on the balance of probabilities") as opposed to the higher standards of "clear and convincing evidence" or "evidence beyond a reasonable doubt" (the Australian criminal standard). The panel stated:

"We recognize that other standards may be employed in other jurisdictions. However, the standard of proof employed in the United States seems appropriate for these proceedings generally, and in particular for this proceeding which involves citizens of the United States, actions occurring in the United States and a domain name registered in the United States." (emphasis supplied)

The three panellists are all United States based lawyers, which, perhaps, explains their attitude. We do not argue against the standard of proof which the panellists applied: the civil standard seems to us appropriate for civil proceedings of this nature. But we suggest that better reasons should have been given for its application than simply that it is United States law: we query the stated application of United States law

to all UDRP proceedings, some of which will have no connection at all with the United States.

The issue has more frequently arisen (and a different approach has been adopted) in relation to determining whether a complainant has rights in a trade or service mark.

In the *Julia Roberts* case⁶³ (29 May 2000), both Ms Roberts and the domain name registrant were based in the United States. The UDRP panellists (again, three United States lawyers) found Ms Roberts had rights to her name under United States law (Lanham Act 15 USC section 105(d)), and granted her application. In the *Jeanette Winterson* case⁶⁴ (22 May 2000), both Ms Winterson and the domain name registrant were based in England: the panellist, a London lawyer, looked to English law and granted Ms Winterson's application.

The *Isabelle Adjani* case⁶⁵ (4 October 2000) was somewhat different: Ms Adjani was based in Switzerland, and the domain name registrant was based in the United States. The UDRP panellist, the same London lawyer who decided Ms Winterson's case found Ms Adjani had rights in her name under *both* Swiss law (Arts 28 and 29 of the Civil Code) and United States law (citing the *Julia Roberts* decision).

Madonna has United States trade mark registrations, so the issue did not arise in her proceedings.⁶⁶

It will be interesting to see the approach taken when the complainant has rights under her/or his home law, but not under the respondent's home law.

In our view, the appropriate approach is to develop an ICANN jurisprudence that does not rely on the local law of any jurisdiction. As questions arise, panellists will "borrow" from their legal experience in a local law jurisdiction. But over time, to preserve the truly international quality of the UDRP, the best solution should be found, and applied by UDRP panellists. The best solution may not always be United States law!

(2) ONUS OF PROOF

As noted earlier, many respondents to UDRP proceedings (the registrants of impugned domain names) do not respond to complaints filed against them. Under the UDRP,⁶⁷ where no response is filed, the panel decides the proceeding on the basis of the complaint. The panel is also entitled to draw factual conclusions from the complainant's undisputed representations.⁶⁸ Indeed, failure to file a response has itself been held to be evidence of bad faith.⁶⁹

In effect, this often means that the complainant's allegations are accepted as true,⁷⁰ although some decisions note that the panel is not required to accept all the complainant says, but may apply its own knowledge and understanding.

Even in cases where a response is filed by the domain name holder, the cases suggest that the onus rests with the respondent to prove its legitimate right or interest in the domain name: where no plausible explanation is provided for adopting a domain name, the UDRP will be violated.⁷¹

(3) CONFIDENTIALITY

UDRP proceedings are not confidential. Most panels publish their reasons on the internet (usually in English).

Panellists have refused applications by complainants for, in effect, suppression orders,⁷² although some care will be taken not to disclose unnecessary confidential information in the published reasons.⁷³

(4) COURT PROCEEDINGS

The circumstances in which administrative proceedings under the UDRP are available are limited.⁷⁴ There are likely to be many cases in which a complainant will not be able to satisfy each of the elements that must be established in order fall within the scope of the UDRP.

While countries such as the United States have passed specific legislation designed at addressing cybersquatting,⁷⁵ there are currently no such laws in Australia. Accordingly, trade mark law, the common law of passing off and statutory misleading and deceptive conduct provisions must

be called upon to resolve domain name disputes.

The UDRP anticipates the availability of court proceedings, before, during or after a determination. If a court's jurisdiction is involved during UDRP proceedings, the panel may, in its discretion, stay its determination.⁷⁶ Alternatively, the court where the claim is made may stay its proceedings until the UDRP decision is available.⁷⁷

Damages will only be available if court proceedings are commenced. In some circumstances, it may therefore be appropriate to commence both UDRP and court proceedings. If there is a risk the domain name will be transferred out of the court's jurisdiction, the UDRP proceedings will be an inexpensive way of obtaining, in effect, an urgent interlocutory injunction to prevent transfer.⁷⁸ Difficulties will arise if the UDRP panel and the court reach different decisions.

In cases where the UDRP is not available (such as .com.au domain names), court proceedings may be the only realistically available option.

(5) APPEALS FROM ICANN

Other than approaching a court, there is, at present, no avenue for "appeal" from a decision of an ICANN panel. This creates two disadvantages:

- (a) dissatisfied parties may have to litigate rather than pursue further arbitration proceedings; and
- (b) there is no method of encouraging consistency between panellist and their approaches to some of the issues raised above. Many panellists are now citing earlier UDRP decisions to support their reasoning. No clear precedence is being given to three member panels (we say appropriately), and no clear statements are being made by panellists to the effect that they are "bound by an earlier decision". Many cite their own earlier decisions, with approval.

We hope that these issues might be shortly resolved with, perhaps, five member panels being constituted to decide some of the issues arising and to set guiding precedent on matters such as burden of proof and when there will be "rights or legitimate interests". Alternatively, similar ends could be achieved by administrative changes to the rules.

CONCLUSIONS

The ICANN UDRP can, in many respects, be hailed as a great success. Whilst some issues remain to be resolved, by and large the proceedings are swift, cost-effective and accurately reflect both local law and people's expectations with respect to cybersquatting.

Will the UDRP bring an end to cybersquatting? We doubt it. There are still many registered domain names that have no affiliation with the name or trade mark they contain. And, whilst cyber real estate at the .com, .org and .net domain names may be nearly sold out, with new second-level domain names available, and many country codes not signed up to the UDRP or a similar dispute resolution policy, there remains a financial incentive for this behaviour.

- ¹ The opinions expressed are the authors' own.
- ² WIPO, *The Management of Internet Names and Addresses: Intellectual Property Issues - Final Report of the WIPO Internet Domain Name Process* (30 April 1999), <www.wipo2.wipo.int>.
- ³ For a registration fee of approximately UD\$70, business.com sold for US\$7.5 million: "What's in a name? Top price for right address", *Sydney Morning Herald*, 23 August 2000.
- ⁴ It is the very profitability of the internet industry and the high price of cyber real estate that has led to cybersquatting: see Chad de Souza, "Specific remedies for cybersquatting" (2000) 3 *Internet*

Law Bulletin 49 at 50.

- ⁵ References to "cybersquatting" often, inaccurately, include two different concepts. For the purposes of this paper, "cybersquatting" is used to refer to the "practice of registering famous brand names as Internet domain names...in the hope of later selling them to the appropriate owner at a profit": www.dictionary.com. We use the expressions "domain name speculation" and "cyberinvesting" to describe registration of generic domain names (for example, sex.com, business.com, buy.com) for the purposes of trade where no other entity can legitimately claim exclusive trade mark or other rights in the generic expression.
- ⁶ See *Playboy Enters v Universal Tel-a-Talk Inc* No 96-6961, 1998 WL 767440.
- ⁷ See *Brookfield Communications Inc v West Coast Entertainment Corporation* (2000) 46 IPR 259 at 265 (United States Court of Appeal for the Ninth Circuit).
- ⁸ John Zuccarini made an estimated US\$1 million from advertising on websites at domain names of misspelled popular trade marks: *Encyclopaedia Britannica Inc v John Zuccarini and the Cupcake Patrol* (7 June 2000) WIPO D2000-0330. WIPO decisions cited in this article are available at <www.icann.com/udrp/proceedings-list-name.htm>.
- ⁹ ICANN was created in 1998 by a coalition of internet users, businesses and academics to coordinate the assignment of domain names.
- ¹⁰ For a discussion of the trade mark and other issues of pursuing a cybersquatter through the Australian courts, see Patrick Gunning, "Trade Marks and Domain Names" [2000] *CyberLRes*1.
- ¹¹ See, for example, Andrew McRobert and Michael Pendleton, "Browsing, Caching, Downloading and Linking Websites: Copyright and Multi-jurisdictional Dimensions" (2000) 41

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- ¹² Simon Pollard and Tim Gole, "The WIPO Proposed Internet Domain Name Process" (1999) 39 *Computers and Law Journal* 1.
- ¹³ ICANN recently received proposals from 45 consortia seeking additional new top-level domain names including .kids, .biz, .tel, .xxx, .health, .museum, .coop and .co-op, .web, .info and .site. ICANN intends to select a small number of these in November 2000 for operation early in 2001: Aaron Pressman, "ICANN asked to connect the dots", *The Industry Standard*, 4 October 2000.
- ¹⁴ ICANN UDRP, <www.icann.org/udrp/udrp-policy-24oct99.htm>.
- ¹⁵ *Educational Testing Service v TOEFL* (16 March 2000) WIPO D2000-0044.
- ¹⁶ See comments of Professor Andrew Christie in Dominique Jackson, "Local plan needed to liberate domains", *The Australian*, 1 August 2000.
- ¹⁷ See John Davidson, "Domain name reform finally under way", *The Australian Financial Review*, 16 June 2000.
- ¹⁸ In addition to .com, .org and .net, top-level domain names exist as follows: .mil (for military organisations), .edu (for educational institutions), .gov (for government bodies) and .int (for international organisations).
- ¹⁹ ICANN UDRP, paragraph 4(a).
- ²⁰ ICANN UDRP, paragraph 5.
- ²¹ *Infospace.com Incv Infospace Technology Co Limited* (28 March 2000) WIPO D2000-0074.
- ²² See *Julia Fiona Roberts v Russell Boyd* (29 May 2000) WIPO D2000-0210; *Isabelle Adjani v Second Orbit Communications Inc* (4 October 2000) WIPO D2000-0867; *Jeanette Winterson v Mark Hogarth* (22 May 2000) WIPO D2000-0235; and *Madonna Ciccone p/k/a/ Madonna v Dan Parisi and "Madonna.com"* (12 October 2000) WIPO D2000-0847. The recording artist Sting was not similarly successful, because "sting" is a common word, is not his real name, and the registrant was not seeking to trade on the good will of the performer: *Gordon Sumner p/k/a Sting v Michael Urvan* (20 July 2000) WIPO D2000-0596.
- ²³ *Bennett Coleman & Co Limited v Steven S Lalwani* (11 March 2000) WIPO D2000-0014.
- ²⁴ ICANN UDRP, paragraph 4(c).
- ²⁵ *World Wrestling Federation Entertainment Inc v Michael Bosman* (14 January 2000) WIPO D99-0001.
- ²⁶ See also *Telstra Corporation Limited v Nuclear Marshmellows* (18 February 2000) WIPO D2000-0003.
- ²⁷ *Penguin Books Ltd v The Katz Family and Anthony Katz* (20 May 2000) WIPO D2000-0204.
- ²⁸ In *Madonna Ciccone v Dan Parisi and "Madonna.com"* (12 October 2000) WIPO D2000-0847, registration of MADONNA as a trade mark in Tunisia did not assist the respondent.
- ²⁹ *The Chancellor, Masters and Scholars of the University of Oxford v DR Seagle* (30 May 2000) WIPO D2000-0308.
- ³⁰ See also *Educational Testing Service v Netkorea Co* (4 April 2000) WIPO D2000-0087, where the complainant's burden on this element was described as being "relatively light".
- ³¹ *Guerlain SA v Peikang* (21 March 2000) WIPO D2000-0055. cf *Cigna Corporation v JIT Consulting* (6 June 2000) DeC AF0174, where the mere act of registration was found not to provide evidence of use in bad faith, but the element of bad faith was established by the failure of the domain name holder to respond to a "cease and desist" letter.
- ³² *Physik Instrumente GmbH and Co v Stefan Kerner and Jeremy Kerner and Magic Moments Design Limited* (3 October 2000) WIPO D2000-1001.
- ³³ *World Wrestling Federation Entertainment Inc v Michael Bosman* (14 January 2000) WIPO D99-0001.
- ³⁴ *The University of Wyoming v David Horton* (16 June 2000) WIPO D2000-0366.
- ³⁵ *Array Printers AB v Lennart Nordell* (10 April 2000) WIPO D2000-0092.
- ³⁶ (15 April 2000) WIPO D2000-0124.
- ³⁷ (22 March 2000) WIPO D2000-0057.
- ³⁸ At <www.networksolutions.com/cgi-bin/whois/whois> although care should be taken as to its accuracy.
- ³⁹ See, for an example, *Experience Hendrix LLC v Denny Hammerton and the Jim Hendrix Fan Club* (15 August 2000) WIPO D2000-0364. Mr Hammerton had registered, among others, elvispresley.net, paulmccartney.com and mickjagger.com.
- ⁴⁰ *Northwest Plumbing Drain Station Inc v Summer Plumbing* (4 April 2000) NAF FA0094197.
- ⁴¹ (30 May 2000) WIPO D2000-0308.
- ⁴² *Microsoft Corporation v Microsoft.com aka Tarek Ahmed* (21 July 2000) WIPO D2000-0548.
- ⁴³ *Diageo plc v John Zuccarini* (22 August 2000) WIPO D2000-0541.
- ⁴⁴ (7 June 2000) WIPO D2000-0330.
- ⁴⁵ *CAA Industries Inc v Bobby R Dailey* (26 April 2000) WIPO D2000-0148.
- ⁴⁶ *Phillips India Limited v Proton Engineers* (27 January 2000) NAF FA0092529; *Heel Quik! Inc v Michael Goldman and Ors* (1 March 2000) NAF FA0092527.
- ⁴⁷ *Parfums Christian Dior v Javier Garcia Quintas and Christiandior.net* (17 May 2000) WIPO D2000-0226.
- ⁴⁸ ICANN UDRP, paragraph 4.
- ⁴⁹ <www.cpradr.org>
- ⁵⁰ <www.eresolution.ca>
- ⁵¹ <www.arbforum.com>
- ⁵² <www.arbiter.wipo.int>
- ⁵³ The rules for each Provider are set out at each Provider's website.
- ⁵⁴ See <www.wipo.int/domains/panel/panelists.html> for a list of WIPO panellists, including six arbitrators

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- in Australia: Philip Argy, Andrew Christie, Alan Limbury, Desmond Ryan, John Terry and Ross Wilson.
- ⁵⁵ This information is obtainable by searching at <www.networksolutions.com/cgi-bin/whois/whois>, or a number of other registrars' sites.
- ⁵⁶ Id.
- ⁵⁷ ICANN UDRP, paragraph 7.
- ⁵⁸ In *Physik Instrumente GmbH v Stefan Kerner and Jeremy Kerner and Magic Moments Design Limited* (3 October 2000) WIPO D2000-1001 the panel found against Physik at least in part because it failed to disclose that it had initially asked to purchase the disputed domain name.
- ⁵⁹ David Bernstein and Sheri Raliner, "Lessons from New Dispute Resolution Procedure for Domain Name Disputes", *The New York Law Journal*, 21 August 2000.
- ⁶⁰ ICANN, Statistical Summary of Proceedings Under Uniform Domain Name Dispute Resolution Policy, <www.icann.org/udrp/proceedings-stat.htm>.
- ⁶¹ *ViewSonic Corporation v Informer Associates Inc* (6 September 2000) WIPO D2000-0852.
- ⁶² (12 October 2000) WIPO D2000-0847.
- ⁶³ *Julia Fiona Roberts v Russell Boyd* (29 May 2000) WIPO D2000-0210.
- ⁶⁴ *Jeanette Winterson v Mark Hogarth* (22 May 2000) WIPO D2000-0235.
- ⁶⁵ *Isabelle Adjani v Second Orbit Communications Inc* (4 October 2000) WIPO D2000-0867.
- ⁶⁶ *Madonna Ciccone p/k/a Madonna v Dan Parisi and "Madonna.com"* (12 October 2000) WIPO D2000-0847.
- ⁶⁷ ICANN UDRP, paragraph 14(a).
- ⁶⁸ ICANN UDRP, paragraph 15(a). See also *Sampo Insurance Company Plc and Leonia Plc v Caspar Callerstrom* (16 September 2000) WIPO D2000-0864.
- ⁶⁹ *Talk City Inc v Michael Robertson* (29 February 2000) WIPO D2000-0009. See also ICANN UDRP, paragraph 14(b).
- ⁷⁰ *CBS Broadcasting Inc v Worldwide Webs Inc* (4 September 2000) WIPO D2000-0834.
- ⁷¹ See discussion in *Madonna*, op cit, in relation to the *Julia Roberts* case, op cit, and *Helen Folsade Adu p/k/a Sade v Quantum Computer Services Inc* (26 September 2000) WIPO D2000-0794.
- ⁷² *Ronson Plc v Unimetal Sanayi ve Tic.A.S.* (11 March 2000) WIPO D2000-0011.
- ⁷³ *Lion Nathan Limited v Wallace Waugh* (3 April 2000) WIPO D2000-0030.
- ⁷⁴ *Educational Testing Service v TOEFL* (16 March 2000) WIPO D2000-0044.
- ⁷⁵ Anti-Cybersquatting Consumer Protection Act (2000).
- ⁷⁶ ICANN UDRP, paragraph 18.
- ⁷⁷ *Weber-Stephen Products Co v Armitage Hardware and Building Supply Inc and Ors* (unreported, 3 May 2000, United States District Court for the Northern District of Illinois, Aspen CJ).
- ⁷⁸ ICANN UDRP, paragraph 7.