

UNITED NATIONS CONFERENCE ON TRADE AND DEVELOPMENT

Dispute Settlement

World Intellectual Property Organization

4.2 Domain Name Dispute Resolution



NOTE

The Course on Dispute Settlement in International Trade, Investment and Intellectual Property consists of forty modules.

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WHAT YOU WILL LEARN

The WIPO Arbitration and Mediation Center (the WIPO Center) is the leading dispute resolution service provider in relation to the alleged abusive registration and use of domain names. From December 1999 through April 2003, the WIPO Center handled over 20,000 domain name cases covering some 25,000 domain names, with new cases being received each day. Approximately 5,000 of these cases were governed by the Uniform Domain Name Dispute Resolution Policy (UDRP), which is the principal policy for addressing this type of dispute on an international level.

This module gives an overview of the procedural rules and the substantive criteria of this dispute settlement procedure.

Section 1 introduces the policy and technical background that produced the UDRP. It also explains how the domain name system works and how domain names are registered.

Sections 2 and *3* describe the history and the objectives of the UDRP and the role of the World Intellectual Property Organization (WIPO) leading to the adoption of the UDRP.

Section 4 highlights the principal characteristics and the scope of the UDRP and outlines its principal advantages in comparison to conventional litigation in national courts.

Section 5 presents the various stages in the UDRP procedure and the timeframe of a case.

Section 6 outlines basic procedural issues for parties to a UDRP proceeding.

Sections 7 and *8* contain details concerning the legal aspects of filing or defending a domain name case under the UDRP.

Section 9 provides information on fees for the UDRP procedure.

Section 10 describes the role of the dispute resolution service provider.

Section 11 examines the appointment procedure and role of the Administrative Panels that decide disputes under the UDRP.

Section 12 describes the remedies that are available under the UDRP and the timeframe for the decision-making process. It also explains how the Administrative Panel decision is implemented.

Section 13 discusses the effect of court proceedings relating to the domain name disputed in the UDRP procedure, and what happens if a party files a

lawsuit after a UDRP Panel decision has been rendered.

Section 14 gives an insight into how the UDRP decision criteria have been interpreted by Panels.

Section 15 describes recent developments in the area of domain names and domain name dispute resolution, including “internationalized” domain names, registry-specific dispute resolution policies for new generic top-level domains (gTLDs) and the Second WIPO Internet Domain Name Process.

Section 16 comprises a series of self-assessment questions to reinforce the reader’s comprehension of the module.

Section 17 contains a selection of filing resources and further readings on the UDRP.

Annexes provide the Model Complaint and the Index of WIPO UDRP Panel Decisions made available by the WIPO Center as part of its case facilities.

OBJECTIVES

On completion of this module, the reader will be able:

- **to appreciate why there was a need for an alternative dispute resolution procedure to combat the abusive registration of trademarks as domain names by third parties;**
- **to recognize the specific characteristics of the UDRP;**
- **to file a Complaint or a Response under the UDRP;**
- **to appreciate how Administrative Panels appointed by the WIPO Center have applied the UDRP.**

1. DOMAIN NAMES AND THE DOMAIN NAME SYSTEM

1.1 The development of the domain name system

The rapid increase in the number of globally active Internet users makes the Internet an ideal marketplace and advertising location. More than traditional mass communication media, the Internet offers users the opportunity to actively seek the desired information for themselves. Persons or entities planning to use the Internet as a global marketplace or communication platform must enable potentially interested parties to locate them in cyberspace. To facilitate such communication, each computer connected to the Internet is identified by a unique numerical Internet Protocol (IP) address, such as the number 193.5.93.80.

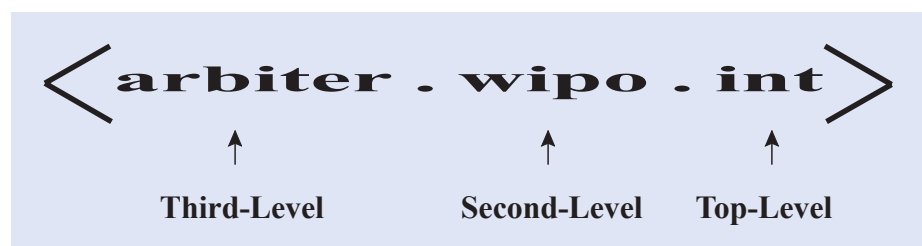
1.2 How does the domain name system work?

It rapidly became evident that, while the use of numerical addresses is an appropriate means of identification between computers, people prefer names to numbers. Thus, an addressing system, the domain name system, was designed to enable users to locate computers through the use of names rather than numbers. A domain name such as <wipo.int> acts as a unique alias for an IP address (a number), to locate a computer site connected to the Internet, in this case the WIPO web site at the IP address 193.5.93.80. The domain name system is essentially a global addressing system. It is the way in which domain names are located and translated into numerical IP addresses, and vice versa, to facilitate identification of a specific web site on the Internet.

1.3 The structure of a domain name

The domain name system is hierarchical, featuring multiple levels. Reading from the right to left, each level in a domain name is separated by a dot starting on the right with top-level domains and moving on to second-level and third-level domains.

For example, in the domain name <arbiter.wipo.int>, which is the location of the WIPO Center's web site, "int" is the top-level domain, "wipo" is the second-level domain and "arbiter" is the third-level domain.



1.4 Generic top-level domains (gTLDs)

Until November 2000, there were seven generic top-level domains (gTLDs). Three of these are open, in the sense that there are no restrictions on the persons or entities that may register names in them. These three open gTLDs are:

- .com (primarily intended for commercial purposes);
- .net (primarily intended for computers or network providers); and
- .org (primarily intended for miscellaneous organizations).

The other four gTLDs are restricted, in the sense that only certain entities meeting specific criteria may register names in them. They are:

- .edu (for educational institutions in the United States of America);
- .gov (for agencies of the Federal Government of the United States of America);
- .int (for certain intergovernmental organizations); and
- .mil (for military agencies of the United States of America).

1.5 New gTLDs

On November 16, 2000, the Internet Corporation for Assigned Names and Numbers (ICANN) approved the introduction of the following seven new gTLDs:

- .aero (for the aviation community);
- .biz (for business purposes);
- .coop (for cooperatives);
- .info (unrestricted);
- .museum (for museums);
- .name (for personal names); and
- .pro (for professionals).

Some of these new gTLDs are open for registration by the general public (“unsponsored gTLDs”), while others are aimed at registration and use by specific user communities (“sponsored gTLDs”). The unsponsored gTLDs are .biz, .info, .name and .pro, whereas .aero, .coop and .museum are sponsored.

The least restricted of the new gTLDs is .info, where anyone can register any name. Slightly less open is .biz, which is intended for registrations stated to be “used or intended to be used primarily for bona fide business or commercial purposes”. The .name gTLD is reserved for personal names of individuals (for commercial, as well as non-commercial purposes). The .pro gTLD is conceived for professionals, and is so far limited to accountants, lawyers and physicians. The .aero gTLD is restricted to members of the aviation community worldwide, .coop to cooperatives and .museum to museums. ICANN plans to further enlarge the number of gTLDs.

1.6 Country code top-level domains (ccTLDs)

In addition to the above gTLDs, there are 243 country code top-level domains (ccTLDs), based on the two-letter ISO-Norm 3166 (for example, .br for Brazil, .fr for France, .mx for Mexico), which are administered by nationally designated registration authorities. Some of these domains are open, in the sense that there are no restrictions on the persons or entities who may register names. Others are restricted, in that only persons or entities satisfying certain criteria (for example, domiciled within the territory) may register names in them.

Functionally, there is no distinction between the gTLDs and the ccTLDs. A domain name registered in a ccTLD provides the same connectivity as a domain name registered in a gTLD. As noted above, there are open gTLDs and ccTLDs, which contain no restrictions on use, and restricted gTLDs and ccTLDs, which restrict use to persons or entities meeting certain criteria.

The WIPO Center offers a ccTLD database portal on its web site,¹ facilitating online searches for registration and dispute resolution information related to each ccTLD.

1.7 Second-level domains

Under a gTLD, second-level domains are registered by the applicant (for example <wipo.int> by WIPO or <microsoft.com> by Microsoft Corporation) with the respective registration authority responsible for the administration of the gTLD. Administrators of ccTLDs often create mandatory second-level domains. For example, in the United Kingdom, the national registration authority Nominet U.K. introduced various second-level domains under the top-level domain .uk, for example .co.uk for commercial enterprises; .ltd.uk for limited companies; .sch.uk for schools or .gov.uk for government bodies. In such cases, it is the third-level domain that may be registered by competent parties.

Domain names are registered on a first-come, first-served basis and the open gTLDs and ccTLDs normally do not apply an examination procedure. As a domain name functions as an address, no two entities can have the same domain name under the same top-level domain. It is, however, possible for the same name to be registered by separate entities in different top-level domains. Thus, technically speaking, it is possible for one party to register a term in one top-level domain, and other parties to register the same term in different top-level domains.

1.8 Third and fourth-level domains

Third and fourth-level domains are usually chosen by the registrant of the second-level domain name but, as seen above, certain registration authorities

¹ Available at <http://arbiter.wipo.int/domains/cctld/>.

limit the second and third-level domains to designate, for example, the purpose or locality of the domain.

1.9 The growth in domain name registrations

The number of domain names has in recent years undergone spectacular growth. Whereas at the beginning of the 1990s there were only a few hundred domain names registered, by the end of 2002 some 28 million domain names had been registered.

2. NEED FOR AN ALTERNATIVE DISPUTE RESOLUTION PROCEDURE

2.1 The conflict between domain names and intellectual property rights in signs

Originally designed to enable users to locate computers in an easy manner, domain names have gone on to acquire further significance as business identifiers. As a result, domain names have come into conflict with the system of intellectual property rights.

2.2 The phenomenon of cybersquatting

Domain name disputes arise largely from the practice of “cybersquatting”, that is, the pre-emptive bad faith registration of trademarks by third parties as domain names. Cybersquatters exploit the first-come, first-served nature of the domain name registration system by registering names corresponding to trademarks with which they are not connected. As registration of a domain name is a relatively simple procedure, cybersquatters can register numerous variations of such names as domain names. As the holders of these registrations, cybersquatters often put the domain names up for auction, or offer them for sale directly to the company or person connected with the names, at prices far exceeding the cost of registration. Alternatively, they keep the registration and use the name of the person or business associated with that domain name to attract business to their own sites.

2.3 Limitations of court litigation in combating cybersquatting

Despite the rapid growth of the Internet over the last decade as a place to do business, there was, until recently, no globally uniform procedure for resolving disputes arising out of domain name registrations. Prior to the establishment of the UDRP, trademark owners had to resort to litigation before the courts to reclaim domain names that had fallen victim to cybersquatting. In view of the complex questions of jurisdiction, applicable law and enforcement that arise when resorting to national judicial systems to resolve disputes arising in the global context of the domain name system, and the resulting delays and costs, traditional court litigation was considered an unsatisfactory solution to the problem. Arguments were presented in support of a reform of the domain name system to include a mechanism for allowing intellectual property owners to rectify abuses of rights in domain name registration in a more efficient manner.

3. CREATION OF THE UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY (UDRP)

3.1 Origins

In response to the growing concerns relating to intellectual property issues associated with domain names and the increasing number of abusive domain name registrations, a White Paper was produced by the United States Department of Commerce,² which called on WIPO to conduct a study and make recommendations for a uniform approach to resolving trademark/domain name disputes involving cybersquatting (as opposed to conflicts between trademark holders with legitimate competing rights).

In addition, the Internet Corporation for Assigned Names and Numbers, a non-profit California-based corporation was formed in 1998 for the purpose of, among other things, addressing the management of the domain name system.³

3.2 Final Report of the WIPO Internet Domain Name Process

Negotiating a new international treaty was considered too involved a process, and relying on the development of national laws was seen as unlikely to result in an effective mechanism suited to the international nature of these disputes. To resolve domain name disputes, an internationally uniform and mandatory procedure to deal with what frequently developed into cross-border disputes in an efficient manner was needed.

With the support of its Member States, WIPO, which is mandated to promote the protection of intellectual property worldwide, conducted extensive international consultations, resulting in the publication of a Report which addressed domain name issues and made recommendations for their resolution.⁴

The Final Report of the WIPO Internet Domain Name Process (First WIPO Report) recommended the creation of an online administrative dispute resolution procedure, which would have universal application for all .com, .net and .org registrations. The procedure would therefore apply to any name registered in those gTLDs, irrespective of the registrar through which the registration was made and irrespective of the date of registration. WIPO made the following recommendations:

² *Management of Internet Names and Addresses*, 63 FED. REG. 31,741 (June 10, 1998), available at http://www.ntia.doc.gov/ntiahome/domainname/6_5_98dns.htm.

³ *Documentation concerning ICANN can be found at ICANN's web site, at <http://www.icann.org>.*

⁴ *The Management of Internet Domain Names and Addresses: Intellectual Property Issues, Final Report of the WIPO Internet Domain Name Process*, April 30, 1999; the Report is available at WIPO's web site at <http://wipo2.wipo.int/process1/report/finalreport.html>.

- (a) Third parties should be able to challenge domain name registrations and the dispute should be decided by a panel of independent expert decision-makers.
- (b) The scope of the procedure should be limited to the abusive registration of trademarks as domain names.
- (c) The legal basis for the procedure should be the domain name registration agreement through which the registrant agrees to submit to the procedure.
- (d) The procedure should be administered by independent dispute resolution institutions, which would be responsible for the appointment of the panel of decision-makers and for the administration of the procedure.
- (e) The principal remedies available under the procedure should be limited to the transfer or cancellation of the domain name registration (no monetary damages).
- (f) Registration authorities should be obliged to implement decisions made under the procedure ordering the transfer or cancellation of a domain name, without the need for a court to review or confirm such decisions.
- (g) The availability and conduct of the administrative procedure should not deny the parties to the dispute access to national court proceedings, either before, during or after the procedure.
- (h) The procedure should be quick, efficient, cost-effective and conducted to a large extent online.

3.3 Adoption of the UDRP

After consideration and approval by the WIPO Member States, the First WIPO Report was submitted to ICANN for its review. In August 1999, ICANN resolved to adopt the Uniform Domain Name Dispute Resolution Policy,⁵ which, essentially, implements the above WIPO recommendations.

ICANN also appointed dispute resolution service providers to administer disputes that are brought under the UDRP, the WIPO Arbitration and Mediation Center being the first such dispute resolution service provider.

3.4 Entry into effect of the UDRP

The UDRP came into effect on December 1, 1999. Since its entry into force, the UDRP has been widely used as a tool to combat the abusive registration of domain names by cybersquatters, with some 7,000 gTLD cases filed under the procedure by the end of 2002.

⁵ *Uniform Domain Name Dispute Resolution Policy, adopted on August 26, 1999, available at <http://www.icann.org/udrp/udrp-policy-24oct99.htm>.*

3.5 Experience of the WIPO Center

The WIPO Center was the first domain name dispute resolution service provider to be accredited by ICANN. Since commencing its domain name dispute resolution service in December 1999, through April 2003, the WIPO Center has processed well over 20,000 domain name cases, some 5,000 of which were under the UDRP. These WIPO UDRP cases cover approximately 9,000 domain names and involve parties from over 100 countries. The WIPO Center has a list of some 400 Panelists from over 50 countries, who together have rendered some 4,000 decisions, excluding those cases that were terminated for settlement.

The WIPO Center has extensive legal, administrative and information technology resources that provide a solid infrastructure. The Center has administered cases in a number of languages, primarily in English but also in Chinese, French, German, Japanese, Korean, Norwegian, Portuguese, Russian and Spanish, with the possibility to add further languages as required.

4. PRINCIPAL CHARACTERISTICS AND SCOPE OF THE UDRP

4.1 Which disputes are covered?

As recommended in the First WIPO Report, ICANN places two major restrictions on the UDRP.

First, the dispute resolution procedure is limited solely to cases of deliberate, bad-faith, abusive registrations (cybersquatting) and leaves the resolution of other trademark disputes to the courts.⁶

The UDRP therefore offers relief to trademark owners who have fallen victim to cybersquatting practices, provided they can demonstrate that (UDRP, Paragraph 4(a)):

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

Second, the UDRP only applies to abusive registrations of trademarks and service marks as domain names. The WIPO recommendations concluded that registrations which violate trade names, geographical indications or personality rights should not per se fall within the definition of abusive registration for the purposes of the UDRP procedure, as intellectual property rights in these categories were less harmonized throughout the world.

4.2 Which top-level domains are governed?

The UDRP applies directly to the open gTLDs .com, .net and .org as well as to the new gTLDs, presently .aero, .biz, .coop, .info, .museum, .name and .pro.

The management of ccTLDs is delegated to national registration authorities that operate the ccTLDs according to local policies. The UDRP does not apply per se to all ccTLDs, but only to those where the national ccTLD registration authority decides to adopt the UDRP on a voluntary basis.

By the end of 2002 over 30 ccTLDs had adopted the UDRP or variations thereof and designated the WIPO Center to provide domain name dispute

⁶ ICANN, *Second Staff Report on Implementation Documents for the Uniform Dispute Resolution Policy* (October 24, 1999), at <http://www.icann.org/udrp/udrp-second-staff-report-24oct99.htm>.

resolution services under such Policy. The list of these ccTLDs is available at the WIPO Center's web site at <http://arbiter.wipo.int/domains/cctld/>.

WIPO also regularly provides, as part of its WIPO ccTLD Program, advice to ccTLD registration authorities for the purpose of managing intellectual property in their domains. As part of this activity, WIPO published the WIPO ccTLD Best Practices for the Prevention and Resolution of Intellectual Property Disputes, which is a set of guidelines for the development of practices and policies for preventing and resolving abusive registrations of protected names.

4.3 What are the major advantages?

Compared with conventional court litigation the UDRP has two major advantages.

The main advantage of the UDRP procedure is that it typically provides a faster and cheaper way of resolving a dispute regarding the registration and use of an Internet domain name. The procedure is considerably more informal than litigation and the decision-makers are experts in such areas as trademark law, domain name issues, electronic commerce, the Internet and dispute resolution. Practice shows that in the absence of exceptional circumstances it takes on average no more than two months to resolve a UDRP dispute.

Another advantage of the UDRP is that, in contrast to national court decisions, which require time-consuming enforcement procedures, a UDRP decision merely needs to be notified to the registrar, which is then required to implement the Administrative Panel finding.

4.4 How does the UDRP become binding on the domain name registrant?

The UDRP derives its application from ICANN's authority over the domain name system. ICANN requires all gTLD registrars to incorporate the UDRP into their domain name registration agreements as a condition of ICANN's registrar accreditation. Accordingly, all gTLD registrants, through their domain name registration agreement, agree to submit to the UDRP procedure. For example, a dispute clause could read as follows:

"The Registrant agrees to be bound by ICANN's Uniform Domain Name Dispute Resolution Policy ("UDRP"). Any disputes regarding the right to use your Domain Name will be subject to the UDRP. We may modify the Dispute Policy in our sole discretion at any time in accordance with the ICANN Agreement or any ICANN/Registry Policy. Your continued use of our registration services after modification to the UDRP becomes effective constitutes your acceptance of those modifications. If you do not agree to such a modification, you may request that your SLD [second-level domain] name be cancelled or transferred to another registrar."

4.5 What remedies are available?

The remedies available under the UDRP consist of the cancellation or transfer of the domain name in dispute. Parties may seek independent recourse in a court of competent jurisdiction before, during, or after a UDRP proceeding. No monetary remedies are available.

5. OVERVIEW OF THE UDRP PROCEDURE

5.1 Legal framework

The UDRP sets out a legal framework for the resolution of disputes between a domain name registrant and a third party over the abusive registration and use of a domain name in a gTLD and those ccTLDs that have adopted the UDRP on a voluntary basis.

Proceedings under the UDRP are conducted according to the Rules for Uniform Domain Name Dispute Resolution Policy (the Rules),⁷ which set out the procedures and other requirements for each stage of a UDRP case.

In addition to the UDRP and Rules, each ICANN-accredited dispute resolution service provider has adopted supplemental rules⁸ which complement the UDRP and Rules on certain issues, such as applicable fees.

5.2 Stages in the procedure

The basic stages in a UDRP procedure are:

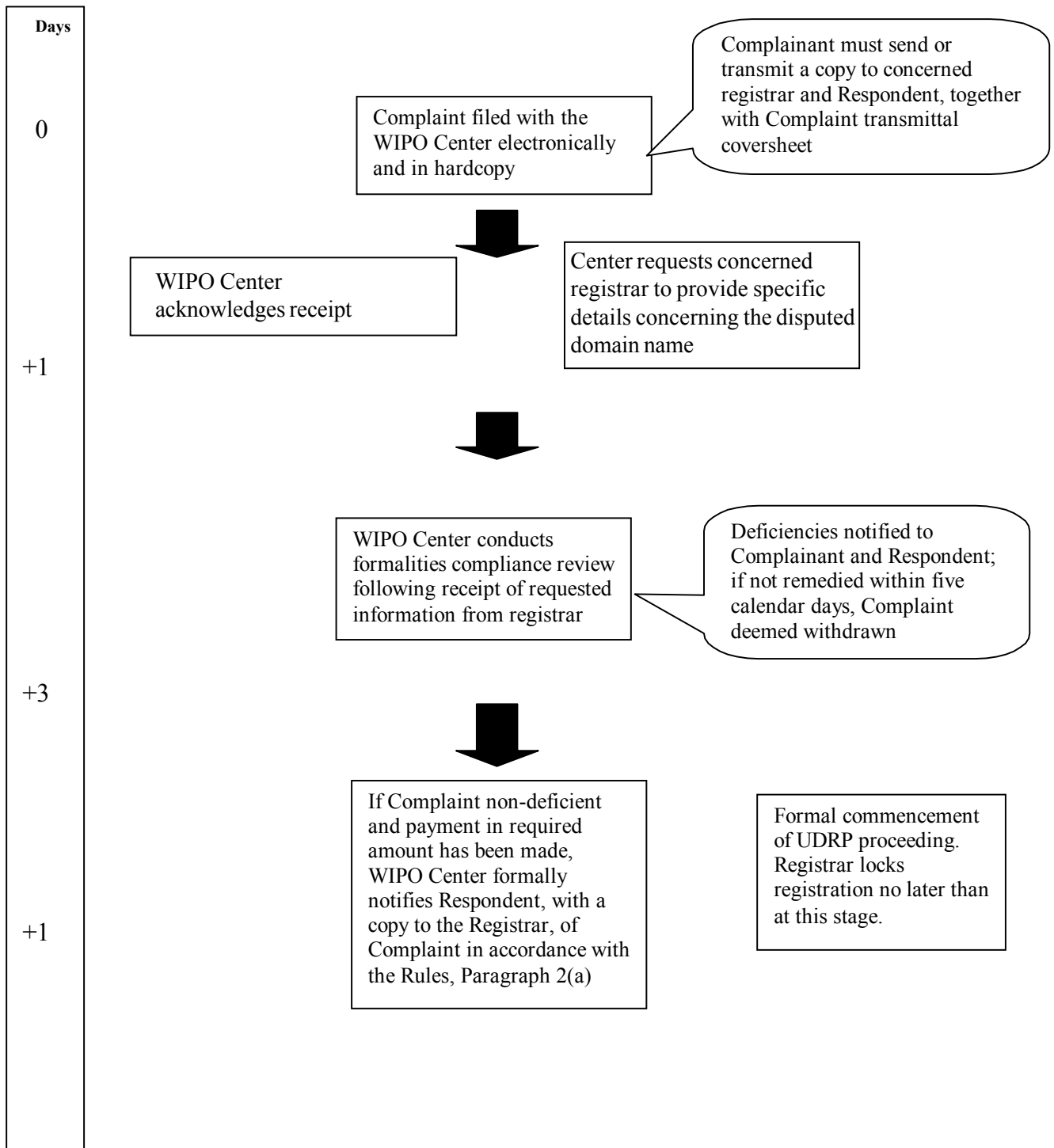
- (a) Filing of a Complaint with an ICANN-accredited dispute resolution service provider of the Complainant's choice, such as the WIPO Center;
- (b) Filing of a Response by the person or entity against whom the Complaint was made;
- (c) Appointment by the chosen dispute resolution service provider of an Administrative Panel comprising one or three persons who will decide the dispute;
- (d) Issuance of the Administrative Panel decision and the notification thereof to all relevant parties; and
- (e) Implementation of the Administrative Panel decision by the registrar concerned, should there be a decision that the domain name in question be cancelled or transferred.

The following flowchart prepared by the WIPO Center gives a more detailed description of the UDRP procedure.

⁷ Rules for Uniform Domain Name Dispute Resolution Policy, approved by ICANN on October 24, 1999, available at <http://www.icann.org/udrp/udrp-rules-24oct99.htm>.

⁸ See for example, World Intellectual Property Organization Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (in effect as of December 1, 1999), available at <http://arbiter.wipo.int/domains/rules/supplemental/>.

5.3 UDRP procedural flowchart



+20

+5 to +15

+14

+3

+10

Response due within 20 calendar days of formal commencement of the administrative proceeding

Default notification sent if Response not filed by deadline; Panel has discretion whether to consider late-filed Response



WIPO Center acknowledges receipt or sends default notification



Regardless of whether Respondent defaults or not, WIPO Center proceeds to appoint Administrative Panel of one or three members

If both Complainant and Respondent designate a single-member Panel, the WIPO Center will make an appointment from its published list. If either the Complainant or Respondent designates a three-member Panel, the WIPO Center will appoint a three-member Panel from its list. In so doing, the WIPO Center will attempt to appoint one of three candidates nominated by the Complainant and one of three nominated by the Respondent. The Presiding Panelist in a three-member Panel is appointed taking into consideration the parties' preferences, concerning five candidates proposed by the WIPO Center.

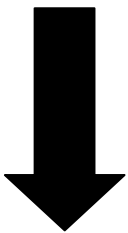


Panel is required to forward its decision to the WIPO Center within 14 days of its appointment



Center formats and notifies decision to parties, concerned registrar and ICANN within 3 days after receipt

Pursuant to Policy, Paragraph 4(k), the registrar implements a decision in favor of the Complainant after ten business days of receipt, unless it receives official documentation from the Respondent that the Respondent has commenced a lawsuit against the Complainant in a mutual jurisdiction to which the Complainant has submitted for this purpose.



Decision implemented by registrar

6. PROCEDURAL ISSUES

6.1 Does a party's submission have to be prepared and submitted by a lawyer?

No. While the assistance of a lawyer may be helpful, there is no requirement that the Complaint or the Response be prepared or submitted by a lawyer. Accordingly, there is no requirement that the Complaint be certified or notarized, although the original hardcopy of the Complaint must be signed by the Complainant or the Complainant's authorized representative, as the case may be.

6.2 Which party carries the burden of proof and what is the standard of proof?

The UDRP places the burden of proof for the case on the Complainant. In order to meet its burden of proof, it is not sufficient for a Complainant to make bald assertions of fact. The Complainant is required to substantiate its claims beyond mere allegations. In general, the standard imposed by Panels is proof on the preponderance of evidence, that is, a fact is considered established when it is more likely than not that the fact is true. Account is taken of possible default and of reasonable limitations for the parties in proving facts that are known only to the other party.

6.3 Are in-person hearings provided for?

Paragraph 13 of the Rules makes it clear that there shall be no in-person hearings (including hearings by teleconference, videoconference and web conference), unless the Administrative Panel determines, only as an exceptional matter, that such a hearing is necessary in order for it to make its decision. No in-person hearing has been held in any WIPO proceeding to date.

6.4 Is the UDRP proceeding confidential?

Following the formal commencement of a UDRP proceeding, the provider publishes the following case-related information on its web site: the domain name(s) in issue, the date of formal commencement of the proceeding and the case number assigned by that provider.

Unless the Panel has decided to redact certain portions of its findings, the WIPO Center publishes in full on its web site all decisions rendered under the UDRP.

7. UDRP COMPLAINT

7.1 Where can a Complaint be submitted?

The Complaint may be submitted to any accredited dispute resolution service provider. For gTLDs these providers are accredited by ICANN. For ccTLDs which have adopted the UDRP, the providers are accredited by the registration authorities of the ccTLD in question. Once a Complainant selects the dispute resolution service provider, it must ensure that the Complaint conforms not only to the requirements specified in the Rules, but also to those requirements specified in the chosen provider's supplemental rules.

7.2 Is there a standard format in which a Complaint should be submitted?

While there is no standard format of Complaint prescribed by ICANN, the WIPO Center has prepared a model Complaint together with filing guidelines which parties may wish to use when filing a UDRP Complaint with the WIPO Center. The use of the model as a basis for the preparation of a party's Complaint does not preclude the possibility of that Complaint being found deficient following the WIPO Center's formalities compliance review, nor does reliance on the model guarantee a Complainant's success on the merits. The majority of WIPO Complainants use the WIPO model Complaint.

Under the Rules, Complaints must be submitted in hardcopy and in electronic format. In order to facilitate electronic filing, the WIPO Center offers the option either to download and complete the WIPO model Complaint as a word document and submit it to the WIPO Center as an e-mail attachment or, to submit the Complaint directly online using the WIPO online filing facility.

Hardcopies (original and four copies) of the Complaint including all annexes (for example, documentary or other evidence) should be sent by postal or courier service to the dispute resolution service provider. The original hardcopy must be signed by the Complainant or the Complainant's authorized representative. At the same time as the Complaint is submitted to the dispute resolution service provider, a copy of the Complaint should also be sent to the Respondent and, under the WIPO Supplemental Rules, to the concerned Registrar.

7.3 In what language should the Complaint be submitted?

Unless the Complainant and the Respondent agree otherwise or unless specified otherwise in the domain name registration agreement, the Complaint must be submitted in the same language as the domain name registration agreement. Attachments to the Complaint may be in their original language, subject to the

authority of the Panel to order any such attachment to be translated in full or in part. The final authority to determine the language of the proceeding lies with the Administrative Panel.

7.4 What information should be included in the Complaint?

The information that must be included in the Complaint is described in Paragraph 3 of the Rules. It is also itemized in the WIPO model Complaint. The formal requirements consist of procedural information, a description of the facts, and legal reasoning on the basis of the substantive decision criteria. As to these criteria, Paragraph 3 provides, *inter alia*, that the Complainant shall describe, in accordance with the UDRP, the grounds on which the Complaint is made including, in particular:

- (a) the manner in which the domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (b) why the Respondent (domain-name holder) should be considered as having no rights to, or legitimate interests in respect of the domain name that is the subject of the Complaint; and
- (c) why the domain name should be considered as having been registered and being used in bad faith. The UDRP contains non-exhaustive examples of scenarios which are normally considered to constitute such bad faith.

Other information to be provided includes indications as to whether the Complainant elects to have the dispute decided by a single-member or a three-member Panel and, in the event that the Complainant elects a three-member Panel, the names of three candidates to serve as one of the Panelists (these candidates may be drawn from any ICANN-accredited provider's list of Panelists).

The WIPO Center also makes available on its web site an online legal Index of WIPO decisions rendered under the UDRP in order to assist parties in preparing their submissions.

7.5 Can a Complaint include more than one domain name?

Under Paragraph 3(c) of the Rules, the Complaint may relate to more than one domain name, so long as the person or entity that is the registrant of the domain names specified in the Complaint is effectively the same.

7.6 Where can one access information on the registrant of a domain name?

Certain registration information can be obtained for domain names registered in .com, .net, .org, .biz, .info and .name by conducting a “WHOIS” search at <http://www.internic.net/whois.html>. For other domain names, or for additional information, the concerned registrar’s WHOIS service may be used.

8. UDRP RESPONSE

8.1 Is there a standard format in which a Response should be submitted?

The information that must be included in the Response is described in Paragraph 5 of the Rules. In addition, the WIPO Center has prepared a model Response and response filing guidelines which parties may wish to use. The use of the model Response as a basis for the preparation of a party's Response is not required and does not guarantee a Respondent's success on the merits.

8.2 What information should be included in the Response?

The information that must be included in the Response is described in Paragraph 5 of the Rules. This provision states, inter alia, that the Respondent shall respond specifically to the statements and allegations contained in the Complaint and include any and all bases for the Respondent to retain registration and use of the disputed domain name, in other words, to convince the Administrative Panel that the Complainant has not established the three cumulative criteria described in paragraph 7.4 above.

8.3 How many days does a Respondent have to file a Response?

According to Paragraph 5(a) of the Rules, the Respondent must file its Response within 20 days of the commencement of the UDRP proceeding. A UDRP proceeding is deemed to have commenced once the dispute resolution service provider has formally notified the Complaint in accordance with Paragraphs 2(a) and 4 of the Rules.

8.4 How can a Respondent demonstrate rights to or legitimate interests in the domain name that is the subject of the Complaint?

Paragraph 4(c) of the UDRP states that any of the following circumstances, in particular but without limitation, if found by the Administrative Panel to be proved based on its evaluation of all evidence presented, shall demonstrate the domain name registrant's rights or legitimate interests in the domain name for the purposes of the UDRP:

- (i) before any notice to the domain name registrant of the dispute, the registrant's use of, or demonstrable preparations 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

- (ii) the domain name registrant (as an individual, business, or other organization) has been commonly known by the domain name, even if the registrant has acquired no trademark or service mark rights; or
- (iii) the domain name registrant is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Paragraph 14.4 provides further information on how the above examples have been interpreted by Administrative Panels.

8.5 What happens if the Respondent fails to submit a Response or submits its Response after the deadline?

If the Respondent does not file its Response by the deadline specified by the dispute resolution service provider, the Respondent will be considered in default. Regardless of the Respondent's default, the dispute resolution service provider will proceed to appoint the Administrative Panel. The Panel will be informed of the Respondent's default. The Panel will then decide the dispute based on the information available to it and may draw such inferences as it deems appropriate from the Respondent's failure to submit a Response, for example as to the existence of facts asserted by the Complainant and the validity of the Complainant's conclusions therefrom. In any event, the Administrative Panel will normally assert its independent responsibility to make its determination on the case. If the Response is filed after the deadline, the Panel will decide whether to admit and consider the late-filed Response.

9. UDRP FEES

9.1 How are the dispute resolution service provider's fees for a domain name dispute calculated?

The amount of the lump sum fee depends on two criteria: the number of disputed domain names and the number of Panelists (one or three). The fee consists of an amount to be retained by the provider as an administration fee and an amount to be paid to the Panelist(s).

In terms of who pays: in the case of a single-member Panel, the full fee is paid by the Complainant. If it is a three-member Panel, requested by the Complainant, the full fee is due from the Complainant. Where it is the Respondent who requests a three-member Panel, the fee is split equally between the Complainant and the Respondent.

The full schedule of the fees charged by the WIPO Center is available at: <http://arbiter.wipo.int/domains/fees/>.

10. ROLE OF THE UDRP DISPUTE RESOLUTION SERVICE PROVIDER

10.1 Procedural involvement

The dispute resolution service provider's role is to administer the proceedings, which includes verifying that the Complaint satisfies the formal requirements of the UDRP, the Rules and the concerned provider's supplemental rules, coordinating with the concerned registrar to verify that the named Respondent is the actual registrant of the domain name in issue, notifying the Complaint to the Respondent, sending out case-related communications, appointing the Administrative Panel and otherwise ensuring that the UDRP proceeding runs smoothly and expeditiously.

10.2 Impartiality

The dispute resolution service provider is independent and impartial. It does not decide the dispute between the parties. As an administrative body, it can provide guidance on the procedural aspects of the UDRP, the Rules and the provider's supplemental rules, but cannot give any views about the strengths and weaknesses of a party's case.

11. ROLE OF THE UDRP ADMINISTRATIVE PANEL

11.1 What is an Administrative Panel?

An Administrative Panel is composed of one or three independent and impartial persons appointed by the dispute resolution service provider to decide the dispute in accordance with the UDRP and the Rules. The Administrative Panel is independent of the dispute resolution service provider, the parties, the registrar concerned and ICANN.

11.2 Who are the Panelists?

The persons appearing on the WIPO Center's list of Panelists have been selected on the basis of their well-established reputation for impartiality, sound judgement and experience as decision-makers, as well as their substantial experience in the areas of trademark law, electronic commerce and Internet-related issues.

In order to ensure transparency and to make available full information for the parties, the WIPO Center not only provides the names of its Panelists but also their full biographical details, which the WIPO Center publishes at <http://arbitrator.wipo.int/domains/panel/>. The WIPO Center's list is truly international, consisting of some 400 Panelists from over 50 countries.

11.3 When is the Administrative Panel appointed?

The Administrative Panel is appointed after the filing of the Response, or following the due date on which the Response should have been filed.

11.4 How is the Administrative Panel appointed?

The Administrative Panel is appointed by the dispute resolution service provider in the following manner:

- (a) If both the Complainant and Respondent indicate that they would like the dispute to be decided by a single-member Panel, the provider will appoint the Panelist from its list of domain name Panelists.
- (b) If the Complainant designates a three-member Panel and the Respondent designates a single-member Panel, or vice versa, then the dispute resolution service provider will appoint a three-member Panel. In so doing, the dispute resolution service provider will try to appoint one of the candidates nominated by the Complainant and one of the candidates nominated by the Respondent. If it is unable to do so, for example because of Panelist unavailability,

the provider will make an appropriate appointment from its list of Panelists. The third Panelist, or presiding Panelist, will be appointed on the basis of preferences indicated by the parties from among a list of five candidates that will have been provided to them by the dispute resolution service provider.

- (c) If the Respondent fails to file a Response, then the dispute resolution service provider will appoint the Administrative Panel in accordance with the number of Panelists designated by the Complainant. If the Complainant designated a three-member Panel, the dispute resolution service provider will try to appoint one of the candidates nominated by the Complainant, failing which it will make the appointment from its published list. It will make the appointment of the other two Panelists from its list of Panelists.

11.5 Appointment considerations

In appointing a Panel for the resolution of a UDRP proceeding, the WIPO Center takes into account a number of considerations, including the nationality of the parties, the language of the proceeding, the experience of the Panel, the geographical location of the Panelist, and prior case involvement by the Panelist with the parties. The WIPO Center also requires the Panelist to confirm his or her independence of each of the parties and disclose any and all facts that should be considered prior to such appointment.

12. ADMINISTRATIVE PANEL DECISION

12.1 What decisions can the Administrative Panel take?

Only three types of decisions can be made by the Administrative Panel:

- a) (i) decide in favor of the Complainant and order that the disputed domain name be transferred to Complainant;
- (ii) decide in favor of the Complainant and order that the disputed domain name be cancelled;
- b) decide in favor of the domain name registrant (i.e. deny the remedy requested by the Complainant).

The Administrative Panel cannot make monetary awards, including awards for lawyers' costs.

12.2 What is a finding of "reverse domain name hijacking"?

As domain name applicants are required to submit to a mandatory dispute resolution procedure in respect of any trademark dispute arising out of their domain name registration, there exists a risk of abuse of the UDRP by Complainants seeking to acquire a domain name that they know or should have known was being used by a legitimate registrant in good faith ("reverse domain name hijacking").

Therefore, if after considering the submissions, the Panel finds that the Complaint was brought in bad faith, or was brought primarily to harass the domain name holder, the Panel has the power to declare in its decision that the Complaint was brought in bad faith and constitutes an abuse of the proceeding.

12.3 How long does it take to get the Administrative Panel decision?

In the absence of exceptional circumstances, the Administrative Panel decision will be notified to all relevant parties within three weeks of the appointment of the Panel.

12.4 How is the Administrative Panel decision implemented?

An Administrative Panel decision is implemented by the registrar with which the contested domain name is registered, subject to the right of a domain name registrant that lost in the UDRP proceeding to file court proceedings and thereby cause the implementation of the UDRP decision to be suspended

in accordance with Paragraph 4(k) of the UDRP, as further described in paragraph 13.2 below.

12.5 Is the Administrative Panel decision subject to appeal?

The UDRP decision does not prejudice parties' rights to submit their domain name dispute to a court. Considering this, the UDRP, as a streamlined procedure, does not provide for appeals to Panel decisions within the UDRP system.

12.6 Are Administrative Panel decisions available to the public?

According to Paragraph 16(b) of the Rules, except where an Administrative Panel in exceptional circumstances decides to redact portions of its decision, a dispute resolution service provider is required to publish all UDRP decisions in full on the Internet.

WIPO decisions may be searched by full text, domain name or parties' names. In addition, the WIPO Center's online Index categorizes WIPO UDRP decisions by type of domain name and procedural or substantive legal issue. Statistics relating to case filings and decisions are also available on the WIPO Center's web site and are updated daily. Interested parties can also subscribe to daily email updates of new WIPO UDRP decisions.

ICANN publishes the UDRP gTLD decisions of all its accredited providers.

12.7 Consistency of decisions

In order to ensure consistency and predictability in decisions, Panels will normally take notice of previous Administrative Panel decisions and provide reasoned conclusions. Even if Panels are not formally bound by precedent, Panel decisions rendered so far show that Panels as well as parties frequently cite previous decisions to support their arguments, or to distinguish the case at issue from prior decisions.

13. RELATIONSHIP BETWEEN THE UDRP AND COURT PROCEEDINGS

13.1 What happens if a national court case is initiated during the UDRP proceeding?

In the event of any legal proceedings being initiated prior to or during a UDRP proceeding in respect of the domain name that is the subject of the proceeding, the Panel shall have the discretion to decide whether to suspend or terminate the case, or to proceed to a decision.

In the event that a party initiates any legal proceedings during the pendency of a UDRP proceeding in respect of a domain name that is the subject of the Complaint, the Rules require the party to promptly notify the Panel and the provider.

13.2 What happens if a losing domain name registrant files a lawsuit after the Administrative Panel decision has been rendered?

Paragraph 4(k) of the UDRP allows a domain name registrant who loses in the UDRP proceeding to challenge the result of an Administrative Panel decision by filing a lawsuit in an appropriate court.

The concerned registrar will implement the Panel decision ten business days after it receives notification of the decision from the dispute resolution service provider, unless it receives from the domain name registrant during that ten-day period official documentation (such as a copy of a complaint, file-stamped by the clerk of the court) that the registrant has commenced a lawsuit against the Complainant in a jurisdiction to which the Complainant has submitted under Paragraph 3(b)(xiii) of the Rules, i.e., a “mutual jurisdiction”.

The concerned registrar will then take no further action until it receives:

- (i) satisfactory evidence of a resolution of the dispute between the parties; or
- (ii) satisfactory evidence that the domain name registrant’s lawsuit has been dismissed or withdrawn; or
- (iii) a copy of an order from the court dismissing the lawsuit or ordering that the domain name registrant has no right to continue to use the domain name.

13.3 What is meant by “mutual jurisdiction”?

The Complainant is required under the Rules to agree to submit, with respect to any challenges to a decision in the administrative proceeding canceling or transferring the domain name, to the jurisdiction of the courts in at least one specified mutual jurisdiction.

Mutual jurisdiction is defined as a court jurisdiction at the 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 on the concerned registrar’s WHOIS database at the time the Complaint is submitted to a dispute resolution service provider.

Experience shows that only in very few UDRP cases a losing registrant proceeds to file a court case.

14. UDRP DECISION CRITERIA AND APPLICATION BY ADMINISTRATIVE PANELS

14.1 What must the Complainant prove under Paragraph 4(a) of the UDRP?

The UDRP represents an effort to address clear cases of domain name abuse – cases involving the bad faith registration and use of domain names which are confusingly similar or identical to trademarks in which the Complainant has rights. This is evident from Paragraph 4(a) which is the central element of the UDRP. It requires proof of each of the following:

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

14.2 Complainant has rights in a trademark or service mark (UDRP, Paragraph 4(a)(i))

The first element that a Complainant has the burden of proving is whether the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights. Complainants frequently attach to their Complaints copies of registration certificates from trademark registration authorities demonstrating their rights in a given mark.

Administrative Panels have consistently held that the UDRP does not require the Complainant to have a registered trademark or service mark. It is sufficient for the Complainant to satisfy the Administrative Panel that it has unregistered rights in a trademark arising out of use in commerce (common law rights).

In addition to commercial entities, well-known individuals, such as Julia Roberts, have been successful in their respective UDRP cases by asserting common law rights in their personal names.⁹

Many cases involve domain names corresponding to famous marks, but others relate to marks that are only used nationally or even locally.

⁹ *Julia Fiona Roberts v. Russell Boyd*, WIPO Case No. D2000-0210 (March 29, 2001).

14.3 Domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights (UDRP, Paragraph 4(a)(i))

To establish that a domain name and a registered trademark are identical for the purposes of the UDRP, a mere comparison suffices. Domain names have been found to be identical to names that enjoy trademark protection regardless of whether the domain name is expressed as one word or separated by a hyphen (for example <jethrotull.com> and <jethro-tull.com>).¹⁰ In analyzing the identity between a trademark and a domain name, the top-level part of the domain name (for example “.com”) is not taken into consideration. In addition, design elements which cannot be reproduced in a domain name have been held not to have distinguishing capacity and should therefore be ignored when assessing identity.¹¹

Determining whether a domain name and a service or trademark are confusingly similar can be a more complicated inquiry. The UDRP does not specify what is meant by “confusingly similar” in Paragraph 4(a)(i). However, in light of the specific nature of domain names, it has been frequently held that the question in assessing confusing similarity between the Complainant’s trademark and the domain name is not whether the domain name causes confusion as to source, but whether the mark and domain name when directly compared appear to be confusingly similar. Thus, in contrast to trademark law, the products and services covered by the Complainant’s trademark are of no relevance as regards the question of whether the Complainant’s trademark and the domain name are confusingly similar. Paragraph 4(a)(i) merely requires that there is a confusing similarity between the domain name and the trademark irrespective of the similarities in products and services.

14.4 Domain name registrant has no rights or legitimate interests in the domain name (UDRP, Paragraph 4(a)(ii))

Paragraph 4(a)(ii) requires that the Complainant prove that the Respondent has “no rights or legitimate interests in respect of the domain name”. The interpretation and application of this provision is made significantly easier by Paragraph 4(c) of the UDRP which sets out, without limitation, the following examples of circumstances that may be considered when addressing the question of whether the Respondent has any rights or legitimate interests in the domain name for the purposes of Paragraph 4(a)(ii) of the UDRP. These conditions can provide the grounds for a successful defense by the Respondent of a domain name dispute. Paragraph 4(c) provides as follows:

¹⁰ *The Ian Anderson Group of Companies Ltd v. Denny Hammerton & I Schembs, WIPO Case No. D2000-0475 (July 12, 2000).*

¹¹ *Credit Libanais SAL v. Charbel Hajj, WIPO Case No. D2002-0792 (November 3, 2002).*

- (i) before any notice to the Respondent of the dispute, the Respondent's use of, or demonstrable preparations 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
- (ii) the Respondent (as an individual, business, or other organization) has been commonly known by the domain name, even if the Respondent has acquired no trademark or service mark rights; or
- (iii) the Respondent is making 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 at issue.

The above criteria are largely self-explanatory. However, they require careful interpretation in specific circumstances, for example, where a distributor or licensee of the trademark holder is using a domain name identical to the trademark of the licensor for a bona fide offering of the trademarked goods,¹² or where the Respondent is operating a criticism or commentary web site under a company's trade mark and the site is not intended for commercial gain and contains adequate disclaimers. In the latter category of cases, the majority of WIPO Panels have found that the right to express one's views does not translate into a right to use another's trademark as a domain name.¹³

14.5 Domain name has been registered and is being used in bad faith (UDRP, Paragraph 4(a)(iii))

What circumstances constitute evidence that a domain name has been registered and is being used in bad faith? Paragraph 4(b) of the UDRP sets out the following examples of circumstances that will be considered by an Administrative Panel to be evidence of bad faith registration and use of a domain name:

- (i) circumstances indicating that the domain name was registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of the domain name registrant's out-of-pocket costs directly related to the domain name; or
- (ii) the domain name was registered in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the domain name registrant has engaged in a pattern of such conduct; or

¹² *Motorola, Inc. v. NewGate Internet, Inc.*, WIPO Case No. D2000-0079 (April 20, 2000); *Stanley Works and Stanley Logistics, Inc. v. Camp Creek*, WIPO Case No. D2000-0113 (April 13, 2000).

¹³ See *Bridgestone Firestone, Inc., Bridgestone/Firestone Research, Inc., and Bridgestone Corporation v. Jack Myers*, WIPO Case No. D2000-0190 (July 6, 2000); *Monty and Pat Roberts, Inc. v. Bill Keith*, WIPO Case No. D2000-0299 (June 9, 2000).

- (iii) the domain name was registered primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, the domain name registrant intentionally attempted to attract for financial gain, Internet users to the registrant's web site or other online location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the registrant's web site or location or of a product or service on the registrant's web site or location.

The above examples are not exclusive and other circumstances may exist that demonstrate the registration and use of a domain name in bad faith.

15. NEW DEVELOPMENTS

15.1 “Internationalized” domain names

The registration of “internationalized” domain names, in non-ASCII scripts such as Arabic, Chinese, Cyrillic or Korean, has become possible. The WIPO Center also offers dispute resolution services for such domain names.

15.2 Dispute resolution in the new gTLDs

Most new gTLD registry operators have adopted specific dispute resolution policies applicable during a start-up or “sunrise” phase. The .info Sunrise Registration Challenge Policy and the .biz Start-Up Opposition Policy are examples of such procedures. The WIPO Center has issued reports on its very extensive experience with these introductory procedures. Furthermore, registries of domains that are restricted to certain purposes provide special procedures to resolve disputes concerning compliance with their respective registration conditions.

15.3 Second WIPO Internet Domain Name Process

After the First WIPO Report made recommendations for the protection of trademark rights in the domain name system, the Second WIPO Internet Domain Name Process considered the relationship between the domain name system and other types of identifiers, namely:

- International nonproprietary names for pharmaceutical substances (INNs)
- Names and acronyms of international intergovernmental organizations
- Personal names
- Geographical identifiers
- Trade names

Based on WIPO’s Report on this Second Process,¹⁴ WIPO Member States decided to recommend that names and acronyms of international intergovernmental organizations and country names be protected against abusive registration as domain names. These recommendations are at the time of publication being considered by ICANN.

¹⁴ “The Recognition of Rights and the Use of Names in the Internet Domain Name System”, Report of the Second WIPO Internet Domain Name Process, available at <http://wipo2.wipo.int/process2/report/html/report.html>.

16. TEST YOUR UNDERSTANDING

After having studied this module, you should be able to answer the following questions. Most answers go beyond a simple yes/no alternative and will require a brief explanation:

1. How does the domain name system work?
2. What is a gTLD?
3. What is a ccTLD?
4. What is the origin and main purpose of the UDRP?
5. Which gTLDs are covered by the UDRP?
6. How does the UDRP become binding on the domain name registrant?
7. What are the major advantages of the UDRP?
8. Which party bears the burden of proof for the elements in Paragraph 4(a) of the UDRP?
9. Can UDRP decisions be challenged by a losing Party?
10. Can a defaulting Respondent be found to have legitimate rights to or interests in the domain name?
11. What happens if a Respondent fails to submit a Response?
12. Are unregistered (common law) trademarks protected under the UDRP?
13. Are celebrity names protected under the UDRP?
14. Describe some of the elements of confusing similarity as developed by Panelists.
15. The following is a theoretical situation not based on any actual facts.

The Complainant is PAPELA AG, a corporation organized under the laws of Austria, having its principal place of business in Austria. The Respondent is World Internet Limited, a company incorporated in Japan having its place of business in Los Angeles, California. The Complainant has provided evidence of its ownership of the marks:

- PAPELA, registered with the Austrian Patent and Trademark Office for “printed matter, books and calendars” in class 16 on the basis of a proof of secondary meaning; and
- PAPELA, registered in the Benelux countries, Croatia, the Czech Republic, France, Germany, Hungary, Italy, Liechtenstein, Poland, Slovakia, Slovenia and Switzerland in class 16 for printed matter, books and calendars.

The Respondent has registered the domain name <papela.com>. The Complainant alleges that “PAPELA” is “famous in its market” and “has acquired strong secondary meaning because of heavy advertising and exclusive use of the mark in association with books, music, paper supplies and other products in Austria.

The Complainant asserts that:

- (1) the domain name <papela.com> is confusingly similar to the trademark “PAPELA” in accordance with Paragraph 4(a)(i) of the UDRP;
- (2) pursuant to Paragraph 4(a)(ii) the Respondent has no rights or legitimate interest in respect of the domain name <papela.com> and has not established any such rights in the manner set out in Paragraph 4(c) of the UDRP;
- (3) the domain name <papela.com> was registered and used in bad faith as provided in Paragraph 4(a)(iii) and in reference to Paragraph 4(b) of the UDRP.

The Respondent disputes the Complainant’s argument that it registered and used the domain name in bad faith and alleges that the Complainant’s trademark “PAPELA” is from the common word for “paper” in the Spanish language “papel” and is used extensively by third parties. It contends that no one has the exclusive right over the use of this word or variations thereof on the Internet.

Describe some of the considerations that could go into a Panel decision.

17. RESOURCES

17.1 WIPO Center's web site and publications

The WIPO Center's domain name web site, available in English, French, Spanish, Japanese, Korean and Portuguese, regularly receives over one million hits per month. The site contains updated information on the WIPO Center's domain name dispute resolution service under the UDRP and other policies, including:

- Dispute resolution policies, rules and related WIPO supplemental rules
- Guide to the UDRP and other domain name dispute resolution policies
- Model Complaint, model Response, and online filing forms
- List of WIPO domain name panelists and their professional profiles
- Listing of all WIPO domain name cases with full text of decisions
- Searchable legal Index of WIPO UDRP Decisions
- Bibliography of selected articles on domain name dispute resolution
- WIPO case statistics
- Selection of UDRP-related court cases
- WIPO Trademark Database Portal
- WIPO ccTLD Database

Interested parties can also use the web site to subscribe to the Center's e-mail updates of new WIPO UDRP decisions. The Center's domain name site can be accessed at <http://arbiter.wipo.int/domains/>.

The Center can be contacted at:

WIPO Arbitration and Mediation Center
World Intellectual Property Organization
34, chemin des Colombettes
1211 Geneva 20
Switzerland

Telephone: +41 22 338 8247
Facsimile: +41 22 740 3700
E-mail: arbiter.mail@wipo.int

In addition, there are a number of published brochures that provide information on the WIPO Center's activities, including the Guide to WIPO Domain Name Dispute Resolution. These are listed at <http://arbiter.wipo.int/center/publications/>.

18. ANNEXES

Annex A: WIPO Model Complaint

(<http://arbiter.wipo.int/domains/filing/udrp/complaint.doc>)

COMPLAINT TRANSMITTAL COVERSHEET

Attached is a Complaint that has been filed against you with the World Intellectual Property Organization (**WIPO**) Arbitration and Mediation Center (the **Center**) pursuant to the Uniform Domain Name Dispute Resolution Policy (the **Policy**) approved by the Internet Corporation for Assigned Names and Numbers (**ICANN**) on October 24, 1999, the Rules for Uniform Domain Name Dispute Resolution Policy (the **Rules**), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the **Supplemental Rules**).

The Policy is incorporated by reference into your Registration Agreement with the Registrar(s) of your domain name(s), in accordance with which you are required to submit to a mandatory administrative proceeding in the event that a third party (a **Complainant**) submits a complaint to a dispute resolution service provider, such as the Center, concerning a domain name that you have registered. You will find the name and contact details of the Complainant, as well as the domain name(s) that is/are the subject of the Complaint in the document that accompanies this Coversheet.

You have no duty to act at this time. Once the Center has checked the Complaint to determine that it satisfies the formal requirements of the Policy, the Rules and the Supplemental Rules, it will forward an official copy of the Complaint to you. You will then have 20 calendar days within which to submit a Response to the Complaint in accordance with the Rules and Supplemental Rules to the Center and the Complainant. You may represent yourself or seek the assistance of legal counsel to represent you in the administrative proceeding.

- The **Policy** can be found at <http://www.icann.org/udrp/udrp-policy-24oct99.htm>.
- The **Rules** can be found at <http://www.icann.org/udrp/udrp-rules-24oct99.htm>.
- The **Supplemental Rules**, as well as other information concerning the resolution of domain name disputes can be found at <http://arbiter.wipo.int/domains>.
- A **model Response** can be found at <http://arbiter.wipo.int/domains/filing/udrp/>.

Alternatively, you may contact the Center to obtain any of the above documents. The Center can be contacted in Geneva, Switzerland by telephone at +41 22 338 8247, by fax at +41 22 740 3700 or by e-mail at domain.disputes@wipo.int.

You are kindly requested to contact the Center to provide the contact details to which you would like (a) the official version of the Complaint and (b) other communications in the administrative proceeding to be sent.

A copy of this Complaint has also been sent to the Registrar(s) with which the domain name(s) that is/are the subject of the Complaint is/are registered.

By submitting this Complaint to the Center the Complainant hereby agrees to abide and be bound by the provisions of the Policy, Rules and Supplemental Rules.

Before the:

**WORLD INTELLECTUAL PROPERTY ORGANIZATION
ARBITRATION AND MEDIATION CENTER**

***[NAME AND ADDRESS OF
COMPLAINANT]***

(Complainant)

-v-

***[NAME AND ADDRESS OF
RESPONDENT]***

(Respondent)

Disputed Domain Name/s/:

[<the contested domain name(s)>]

COMPLAINT

(RULES, PARA. 3(B))

I. Introduction

[1.] This Complaint is hereby submitted for decision in accordance with the Uniform Domain Name Dispute Resolution Policy (the **Policy**), approved by the Internet Corporation for Assigned Names and Numbers (**ICANN**) on October 24, 1999, the Rules for Uniform Domain Name Dispute Resolution Policy (the **Rules**), approved by ICANN on October 24, 1999 and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the **Supplemental Rules**).

II. The Parties

A. The Complainant
(Rules, para. 3(b)(ii) and (iii))

[2.] The Complainant in this administrative proceeding is *[provide full name and, if relevant, legal status, place of incorporation and principal place of business]*.

[3.] The Complainant's contact details are:

Address: *[Specify mailing address]*
Telephone: *[Specify telephone number]*
Fax: *[Specify fax number]*
E-mail: *[Specify e-mail address]*

[If there is more than one Complainant, provide the above information for each, describe the relationship between the Complainants and why each Complainant has a sufficient common interest in the domain name(s) in issue for a joinder to be permissible.]

[4.] The Complainant's authorized representative in this administrative proceeding is:

[If relevant, identify authorized representative and provide all contact details, including postal address, telephone number, fax number, e-mail address; if there is more than one authorized representative, provide contact details for each.]

[5.] The Complainant's preferred method of communications directed to the Complainant in this administrative proceeding is:

Electronic-only material

Method: e-mail
Address: *[Specify one e-mail address]*
Contact: *[Identify name of one contact person]*

Material including hardcopy

Method: *[Specify one: fax, post/courier]*
Address: *[Specify one address, if applicable]*
Fax: *[Specify one fax number]*
Contact: *[Identify name of one contact person]*

B. The Respondent
(Rules, para. 3(b)(v))

[6.] According to *[indicate why the person/entity identified in the Complaint has been identified as the Respondent, e.g., the concerned registrar's Whois database. (Information about the concerned registrar can be found on the Internic database at <http://www.internic.net/whois.html>)]*, the Respondent in this administrative proceeding is *[identify Respondent (the domain name holder), including full name, and if relevant, legal status, place of incorporation and principal place of business, or residence)]*. Copies of the printout of the database search^[es] conducted on *[date]* are provided as Annex *[Annex number]*.

[7.] All information known to the Complainant regarding how to contact the Respondent is as follows:

[Provide all contact details (postal address, telephone number, fax number, email addresses) for the Respondent, including those that may have been used successfully in the course of pre-complaint dealings and those available from any Whois look-up service.]

[If there is more than one Respondent, provide the contact details for each Respondent and describe the relationship between them, which justifies them being named in a common complaint.]

III. The Domain Name/s/ and Registrar/s/
(Rules, para. 3(b)(vi) and (vii))

[8.] This dispute concerns the domain name^[s] identified below:

[Identify precisely the domain name(s) in issue.]

[9.] The registrar^[s] with which the domain name^[s] *[is/are]* registered *[is/are]*:

[Provide the name and full contact details of the registrar(s) with which the domain name(s) (is/are) registered.]

IV. Jurisdictional Basis for the Administrative Proceeding
(Rules, paras. 3(a), 3(b)(xv))

[10.] This dispute is properly within the scope of the Policy and the Administrative Panel has jurisdiction to decide the dispute. The registration agreement, pursuant to which the domain name[s] that [is/are] the subject of this Complaint [is/are] registered, incorporates the Policy. *[If relevant, indicate when the domain name(s) (was/were) registered and specify the provision of the registration agreement that makes the Policy applicable to the domain names(s).]* A true and correct copy of the domain name dispute policy that applies to the domain name[s] in question is provided as Annex [Annex number] to this Complaint.

V. Factual and Legal Grounds
(Policy, paras. 4(a), (b), (c); Rules, para. 3)

[In completing this Section V., do not exceed the 5000 word limit: Supplemental Rules, para. 10(a). Relevant documentation in support of the Complaint should be submitted as Annexes, with a schedule indexing such Annexes. Copies of case precedents or commentaries that are referred to for support should be referred to with complete citations and, if not voluminous, submitted as Annexes.]

[11.] This Complaint is based on the following grounds:

A. The domain name[s] [is/are] identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
(Policy, para. 4(a)(i), Rules, paras. 3(b)(viii), (b)(ix)(1))

[In accordance with Rules, para. 3(b)(viii), specify the trademark(s) or service mark(s) on which the Complaint is based and, for each mark, describe the goods or services, if any, in connection with which the mark is used. A separate description may also be given of the goods or services with which the Complainant intends to use the mark in the future. If applicable, attach copies of the registration certificates for the relevant marks.]

[In accordance with Rules, para. 3(b)(ix)(1), describe the manner in which the domain name(s) (is/are) identical or confusingly similar to a trademark or service mark in which the Complainant has rights.]

B. The Respondent has no rights or legitimate interests in respect of the domain name/s/:

(Policy, para. 4(a)(ii), Rules, para. 3(b)(ix)(2))

[In accordance with Rules, para. 3(b)(ix)(2), describe why the Respondent should be considered as having no rights or legitimate interests in respect of the domain name(s) that (is/are) the subject of the Complaint. Attention should be paid to any relevant aspects of the Policy, para. 4(c), including:

- *Whether before any notice to the Respondent of the dispute, there is any evidence of the Respondent's use of, or demonstrable preparations to use, the domain name(s) or a name corresponding to the domain name(s) in connection with a bona fide offering of goods or services;*
- *Whether the Respondent (as an individual, business, or other organization) has been commonly known by the domain name, even if the Respondent has acquired no trademark or service mark rights;*
- *Whether the Respondent is making a legitimate non-commercial or fair use of the domain name(s), without intent for commercial gain misleadingly to divert consumers or to tarnish the trademark or service mark at issue.]*

C. The domain name/s/ [was/were] registered and [is/are] being used in bad faith.

(Policy, paras. 4(a)(iii), 4(b); Rules, para. 3(b)(ix)(3))

[In accordance with Rules, para. 3(b)(ix)(3), describe why the domain name(s) should be considered as having been registered and used in bad faith by the Respondent. Attention should be paid to any relevant aspects of the Policy, para. 4(b), including:

- *Circumstances indicating that the domain name(s) (was/were) registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the domain name registration(s) to the owner of the trademark or service mark (normally the Complainant) or to a competitor of that Complainant, for valuable consideration in excess of the Respondent's out-of-pocket costs directly related to the domain name(s); or*
- *Whether the domain name(s) (was/were) registered in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the Respondent has engaged in a pattern of such conduct; or*

- *Whether by using the domain name(s), the Respondent intentionally attempted to attract for commercial gain, Internet users to the Respondent's web site or other on-line location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's web site or location or of a product or service on the Respondent's web site or location.]*

VI. Remedies Requested

(Rules, para. 3(b)(x))

- [12.] In accordance with Paragraph 4(i) of the Policy, for the reasons described in Section V above, the Complainant requests the Administrative Panel appointed in this administrative proceeding [*choose **one** per domain name: "issue a decision that <the contested domain name(s)> be transferred to the Complainant" / "be cancelled".*]

VII. Administrative Panel

(Rules, para. 3(b)(iv))

- [13.] The Complainant elects to have the dispute decided by a [*choose **one**: "single-member Administrative Panel" / "three-member Administrative Panel"*].

[] [*If a three-member Administrative Panel is designated, the names of three persons must be provided, one of whom the Center shall attempt to appoint to the Administrative Panel in accordance with Para. 6 of the Rules and Para. 7 of the Supplemental Rules. The names of the nominees may be taken from the Center's published list of panelists at <http://arbiter.wipo.int/domains/panel/panelists.html>, or that of any other ICANN-accredited dispute resolution service provider.*]

VIII. Mutual Jurisdiction

(Rules, para. 3(b)(xiii))

- [14.] In accordance with Paragraph 3(b)(xiii) of the Rules, the Complainant will submit, with respect to any challenges that may be made by the Respondent to a decision by the Administrative Panel to transfer or cancel the domain name[s] that [*is/are*] the subject of this Complaint, to the jurisdiction of the courts at [*choose **one** of the following:*

- (a) *“the location of the principal office of the concerned registrar.” (or)*
- (b) *“the location of the domain name holder’s address, as shown for the registration of the domain name(s) in the concerned registrar’s Whois database at the time of the submission of the Complaint to the Center.” (or)*
- (c) *“the location of the principal office of the concerned registrar AND the domain name holder’s address, as shown for the registration of the domain name(s) in the concerned registrar’s Whois database at the time of the submission of the Complaint to the Center.”*

A Mutual Jurisdiction election must be made for each domain name that is the subject of the Complaint.]

IX. Other Legal Proceedings

(Rules, para. 3(b)(xi))

[15.] *[If any, identify other legal proceedings that have been commenced or terminated in connection with or relating to the domain name(s) that (is/are) the subject of the Complaint and summarize the issues that are the subject of (that/those) proceeding(s).]*

X. Communications

(Rules, paras. 2(b), 3(b)(xii); Supplemental Rules, paras. 3, 4)

[16.] A copy of this Complaint, together with the cover sheet as prescribed by the Supplemental Rules, has been sent or transmitted to the Respondent on *[date]* by *[indicate method(s) of communication and contact details used, with reference to Rules, para. 2(b)]*.

[17.] A copy of this Complaint, has been sent or transmitted to the concerned registrar[s] on *[date]* by *[indicate method(s) of communication and contact details used]*.

[18.] This Complaint is submitted to the Center in electronic form (except to the extent not available for annexes), and in four (4) sets together with the original.

XI. Payment

(Rules, para. 19; Supplemental Rules, Annex D)

[19.] As required by the Rules and Supplemental Rules, payment in the amount of USD *[amount]* has been made by *[method]*.

XII. Certification

(Rules, para. 3(b)(xiv))

[20.] The Complainant agrees that its claims and remedies concerning the registration of the domain name*[s]*, the dispute, or the dispute's resolution shall be solely against the domain name holder and waives all such claims and remedies against (a) the WIPO Arbitration and Mediation Center and Panelists, except in the case of deliberate wrongdoing, (b) the concerned registrar*[s]*, (c) the registry administrator, (d) the Internet Corporation for Assigned Names and Numbers, as well as their directors, officers, employees, and agents.

[21.] The Complainant certifies that the information contained in this Complaint is to the best of the Complainant's knowledge complete and accurate, that this Complaint is not being presented for any improper purpose, such as to harass, and that the assertions in this Complaint are warranted under the Rules and under applicable law, as it now exists or as it may be extended by a good-faith and reasonable argument.

Respectfully submitted,

[Name/Signature]

Date: _____

Annex B: Index of WIPO UDRP Panel Decisions

(<http://arbiter.wipo.int/domains/search/legalindex>)

This Index covers all WIPO UDRP decisions. New decisions are being added continuously.

 Search tips

Any time you select more than one category, the search result will yield ONLY those decisions that are indexed in ALL of the categories so selected.

Decided WIPO cases by domain name categories I. Associations and Institutions II. Geographical Identifiers III. Individuals IV. Industry and Commerce V. Non-ASCII Script Registrations VI. Professional Firms VII. Education VIII. Public Sector (Governments)	Legal index to WIPO panel decisions I. General II. Substance III. Procedure IV. National Court Proceedings Relating to UDRP
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Decided WIPO cases by domain name categories

- I. Associations and Institutions**
 - A. Religious**
 - B. Sports**
 - C. Others**

- II. Geographical Identifiers**

- III. Individuals**
 - A. Authors**
 - B. Business**
 - C. Entertainment (Music and Film)**
 - D. Media**
 - E. Political**
 - F. Sports**

- IV. Industry and Commerce**
 - A. Automobiles**
 - B. Banking and Finance**
 - C. Biotechnology and Pharmaceuticals**
 - D. Electronic**
 - E. Entertainment**
 - F. Fashion**
 - G. Food, Beverages and Restaurants**
 - H. Heavy Industry and Machinery**

- I. Hotels and Travel**
- J. Insurance**
- K. Internet and IT**
- L. Luxury Items**
- M. Media and Publishing**
- N. Retail**
- O. Sports**
- P. Telecom**
- Q. Transportation**

- V. Non-ASCII Script Registrations**
 - A. Chinese**
 - B. Danish**
 - C. French**
 - D. German**
 - E. Japanese**
 - F. Korean**
 - G. Norwegian**
 - H. Spanish**
 - I. Swedish**

- VI. Professional Firms**

- VII. Education**

- VIII. Public Sector (Governments)**
 - A. States and State Agencies**
 - B. Intergovernmental Organizations**

Legal index to WIPO panel decisions

- I. General**
 - A. Competence**
 - B. Mandatory Proceeding**

- II. Substance**
 - A. Identical or Confusingly Similar to a Trademark or a Service Mark in which the Complainant has Rights (Policy, Para. 4(a)(i))**
 - 1. Trademark / Service Mark**
 - a. General**
 - b. Goods or services associated with mark**
 - c. Distinctiveness**
 - (i) General**

- (ii)** Generic / Descriptive
 - (iii)** Suggestive
 - (iv)** Arbitrary; Fanciful
 - d.** Mark validity in question
 - e.** Device mark
 - f.** Registered mark
 - g.** Unregistered mark
 - h.** Well-known mark
 - i.** Personal names
 - (i)** Registered
 - (ii)** Unregistered
 - j.** Trade names
 - (i)** Registered
 - (ii)** Unregistered
 - k.** Geographical identifiers
 - (i)** Indications of source and geographical indications
 - (ii)** Geographical terms
- 2.** Rights in Mark
 - a.** General
 - b.** Territorial effect
 - c.** Licensee
 - 3.** Identical or Confusingly Similar
 - a.** General
 - b.** Absence of actual confusion
 - c.** Misspelling ("Typosquatting")
 - d.** Phonetical similarity
 - e.** Translation/Transliteration
 - f.** Overall impression
 - g.** Prefix + mark
 - h.** Mark with geographical term
 - i.** Mark with generic word
 - j.** Mark with "sucks" or with other pejorative term
 - k.** Abbreviation of mark
 - l.** Mark + Mark
 - m.** Symbols
- B.** Rights or Legitimate Interests (Policy, Para. 4(a)(ii))
 - 1.** General
 - 2.** Bona Fide Use (Policy, Para. 4(c)(i))
 - a.** General
 - b.** "before notice"
 - c.** "demonstrable preparations to use"
 - (i)** Finding for respondent
 - (ii)** Finding against respondent

- d. "bona fide offering"**
- e. Concurrent use**
 - (i) Finding for respondent**
 - (ii) Finding against respondent**
- f. Distributorship and Agency, Collateral use**
 - (i) Finding for respondent**
 - (ii) Finding against respondent**
- 3. "Commonly known by" (Policy, Para. 4(c)(ii))**
- 4. Legitimate Noncommercial, Fair Use (Policy, Para. 4(c)(iii))**
 - a. General**
 - b. Fair Use and Free Speech**
 - (i) Criticism & Commentary**
 - (ii) Parody Sites**
 - (iii) Fan Sites**
- 5. Mark Rights of Respondent**
- C. Registration and Use in Bad Faith (Policy, Para. 4(a)(iii))**
 - 1. General**
 - 2. Conjunctive Requirement**
 - a. General**
 - b. Registration in good faith, usage in bad faith**
 - c. Registration in bad faith, usage in good faith**
 - 3. Registration in Bad Faith**
 - a. General**
 - b. Acquisition of domain name from third party**
 - c. Registration of domain name prior to mark registration**
 - d. Renewals**
 - 4. Use in Bad Faith**
 - a. General**
 - b. Non-web site use**
 - c. Inaction / Passive holding**
 - 5. Evidence of Registration and Use in Bad Faith (Policy, Para. 4(b))**
 - a. General**
 - b. Offer to sell / rent or license (Policy, Para. 4(b)(i))**
 - (i) Offer to Complainant**
 - (1) General**
 - (2) Solicited**
 - (3) Unsolicited**
 - (ii) Offer to general public**
 - (1) General**
 - (2) Auction web site**
 - (3) Listing in Whols directory**
 - (iii) "out-of-pocket costs"**
 - (1) General**

- (2) Monetary demands**
 - (3) Other demands**
 - (iv) Offer - Bad faith not found**
 - c. Pattern of conduct (Policy, Para. 4(b)(ii))**
 - (i) Found**
 - (ii) Not Found**
 - d. Disrupt competitor (Policy, Para. 4(b)(iii))**
 - (i) General**
 - (ii) "competitor"**
 - e. Attract Internet users (Policy, Para. 4(b)(iv))**
 - (i) General**
 - (ii) Automatic hyperlinking**
 - (1) Pornographic sites**
 - (2) Competitor's sites**
 - (3) Other sites**
 - (iii) Mousetrapping**
 - f. Other considerations**
 - (i) General**
 - (ii) False contact information**
 - (iii) Speculation in domain names**
 - (iv) Inconceivable legitimate use**
 - (v) Inactive web sites**
 - (vi) Prior knowledge/notice of mark**
 - (vii) Infringement of complainant's IP rights**
 - (viii) Disclaimer**
 - (ix) Prior relationship between parties**
 - (x) Acquiescence of mark owner**
 - (xi) Cease and desist letter**
-
- III. Procedure**
 - A. Parties**
 - 1. Complainant**
 - a. General**
 - b. Multiple Complainants**
 - 2. Respondent**
 - a. General**
 - b. Multiple Respondents**
 - c. Beneficial holder of domain name**
 - d. Cyberflight**
 - B. Domain name**
 - 1. General**
 - 2. Registered before Dec. 1999**
 - 3. Multiple domain names**

- 4. "Internationalized" domain names
- C. Filings**
 - 1. General
 - 2. Complaint
 - 3. Response
 - a. General
 - b. Extension
 - (i) By Provider discretion
 - (ii) By Party agreement
 - c. Late response
 - d. Deficient response
 - e. Default
 - 4. Supplemental Filings
 - a. General
 - b. Requested by panel
 - c. Unsolicited
 - (i) Considered
 - (ii) Not considered
 - 5. Language
 - 6. Consolidation
 - 7. Refiling
- D. Provider's Role**
 - 1. General
 - 2. Notifications
- E. Administrative Panel**
 - 1. General
 - 2. General Powers
 - 3. Impartiality and Independence
- F. Decision**
 - 1. Basis of Decision
 - a. General
 - b. Applicable law
 - c. Judicial decisions
 - d. Evidence
 - (i) General
 - (ii) Burden / Standard of proof
 - (iii) Conflicting evidence
 - (iv) "without prejudice" materials
 - (1) Considered
 - (2) Not considered
 - e. Party settlement
 - 2. Remedies
 - a. General

- b.** Requested remedies other than transfer or cancellation
 - 3.** Reverse Domain Name Hijacking
 - a.** Found
 - b.** Not Found
 - 4.** Precedent value of panel decisions
-
- IV. National Court Proceedings Relating to UDRP**
 - A.** General
 - B.** Challenges to UDRP Decisions
 - C.** Concurrent Court Proceedings