

Global IT Law
Domain Names
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ICANN' s Uniform Dispute Resolution Policy (UDRP)

- Domain name disputes are frequently cross-border
- Need for speed, accessibility, global scope
- ICANN UDRP
 - External providers - WIPO, NAF, ADNDRC, etc.
 - Bad Faith Domain Name Registrations
 - 3 Months and \$1 - 3,000

ICANN' s Uniform Dispute Resolution Policy (UDRP)

Complainant must prove...

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

ICANN' s Uniform Dispute Resolution Policy (UDRP)

Bad Faith includes...

- Attempt to sell, lease, etc. the domain
- Prevent registration if there is a pattern of such behaviour
- Disrupt competitor' s business
- Attract, for commercial gain, visitors to your site via confusion

ICANN' s Uniform Dispute Resolution Policy (UDRP)

Legitimate interest includes...

- Bona fide offering of goods or services
- Commonly known as domain
- Legitimate non-commercial use provided no attempt to obtain commercial gain via confusion

ICANN' s Uniform Dispute Resolution Policy (UDRP)

- Step-by-step process
- Complainant launches claim with arb. provider
- Registrant opportunity to respond and decide whether one or three member panel
- Arbitration provider assigns panelist(s)
- Panelist(s) render decision based on evidence submitted

The Development of the CDRP Influences

- ICANN UDRP
- Canadian court experience
- Desire for a Canadian-specific approach (language, CPR)
- ccTLD considerations

Key CDRP Provisions

Launching a Claim

- Complainant (who meets CIRA Canadian Presence Requirements) required to prove:
 - Registrant's .ca domain name is Confusingly Similar to a Mark in which the Complainant has Rights
 - Registrant has no legitimate interest in the domain
 - Registrant has registered or using the domain name in bad faith

Key CDRP Provisions

Confusing Similarity Prong

- Confusingly similar if resembles mark in appearance, sound, or ideas such that likely to be mistaken for mark
- Mark based largely on *Trademark Act* definition
 - Can be registered or unregistered
- Rights requires use in Canada

Key CDRP Provisions

Bad Faith Prong

- Bad faith indicia:
 - Registered or acquired domain primarily for purpose of resale, lease, etc. to Complainant or Complainant's competitor
 - Registered or acquired domain primarily to prevent Complainant from registering and engaged in pattern of such activity
 - Registered or acquired domain primarily to disrupt Complainant's business and Registrant & Complainant are competitors
 - Registered to intentionally attempted to attract, for commercial gain, Internet users to the Registrant's website 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 Registrant's website or location or of a product or service on the Registrant's website or location

Key CDRP Provisions

Legitimate Interest Prong

Complainant must also affirmatively show that the registrant has no legitimate interest

Key CDRP Provisions

Legitimate Interest Prong

If Confusion, Bad Faith and No Legitimate Interest are proven, onus falls to Registrant to prove legitimate interest :

- Registrant has rights in the Mark
- Good faith commercial use - domain descriptive or generic
- Good faith non-commercial use including news reporting and criticism
- Legal name of registrant
- Geographical location of Registrant' s non-commercial activity or place of business

Key CDRP Provisions

Canadian Issues

- CDRP only open to those who meet Canadian Presence Requirements
- Canadian law governs all disputes
- Actions brought in either English or French

Key CDRP Provisions Of Note...

- Reverse Hijacking clause -- up to \$5000 in damages
- Domains can be transferred or cancelled
 - Typically transferred, rarely cancelled
- 60 days to implement
- Three member panels for all contested cases
- Two dispute resolution providers - BCIAC and Resolution Canada

Dot-IL DRP

Claims for:

- 3.1. the Domain Name is the same or confusingly similar to a trademark, trade name, registered company name or legal entity registration ("Name") of the complainant; and
- 3.2. the Complainant has rights in the Name; and
- 3.3. the Holder has no rights in the Name; and
- 3.4. the application for allocation of the Domain Name was made or the Domain Name was used in bad faith.

Dot-IL DRP

Evidence of bad faith use or registration:

- the Holder continues to hold the domain name during or after termination of employment or work for hire contract where the domain name allegedly should have been allocated to the employing/contracting party; or
- the Holder has requested allocation of the domain name primarily for the purpose of disrupting the business of a competitor; or
- circumstances indicating that the Holder has requested allocation or holds the Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Domain Name allocation 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 documented out-of-pocket costs directly related to the domain name; or
- the Holder has requested allocation of the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that there is evidence of having engaged in a pattern of such conduct; or
- by using the domain name, the Holder has intentionally attempted to attract, for commercial gain, Internet users to its web site or other on-line location, by creating a likelihood of confusion with the Complainant's Name as to the source, sponsorship, affiliation, or endorsement of its web site or location or of a product or service on its web site or location.

Dot-IL DRP

- Documents in either Hebrew or English
- Decisions typically in English
- 65 cases to date
 - Spotify
 - Facebook
 - Skype
 - Google
 - Wikipedia

The Problem with Domain Name Dispute Resolution

Bodacious-Tatas.com

- Complainant - Tata & Sons (India)
- Respondent - D & V Enterprises (USA)
- ADR Provider - WIPO (Switzerland)
- Arbitrator - Michael Ophir (Israel)
- Precedent - Nokiagirls.com case (Japan with a Belgian arbitrator)

The Good

- **Fast** - Complaint launched May 23, 2000; decision August 18, 2000
- **Inexpensive** - one panelist
- **Co-exists with local legal systems** - injunction obtained in India but tough to enforce
- **Global** - international composition of the case
- **Law Accessible** - decision freely available; relies on precedent

The Bad

- **Substantive Questions** -- Are we getting “good” decisions?
- **Inconsistent Decisions**
 - Geographic Names (Barcelona.com vs. StMoritz.com)
 - Generic Names (Crew.com vs. Jobpostings.com)
 - Definition of Bad Faith Use (buyguerlain.com vs. buyvuarnetsunglasses.com)

The Ugly

Forum Shopping

- Complainant win percentages:
 - WIPO - 82%
 - NAF - 83%
 - eResolution - 63%
- 93% of the cases to the two complainant-friendly providers (WIPO & NAF)
- eResolution -- 3 cases in February 2001 (183 WIPO, 96 NAF); Folds December 2001

The Ugly

- **Case Allocation Bias**
- One Panelist (83%) vs. Three-Member Panels (60%)
- Case Allocation --
 - NAF -- 53% of cases to six panelists (complainant win percentage in those cases -- 94%)
 - WIPO - 104 of 105 panelists (with five or more cases) rule in favour of complaints over 50% of the time

Noteworthy Cases

- Telstra - no use can constitute bad faith
- WalmartCanadasucks.com - no transfer of sucks site
- Annemclennan.com - trademark rights in personal name?
- Newzealand.com - no rights in country name