

**LINDQVIST**

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# **Domain Names & Trademarks: UDRP Fundamentals in the Context of Real-World Cases**

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# Internet Structure Basics

- ICANN - Internet Corporation for Assigned Names and Numbers.
- Domain Name System (DNS)
  - Links web site addresses ([www.lindquist.com](http://www.lindquist.com)) to internet protocol locations (105.22.55.209).
- Domain Names: [www.lindquist.com](http://www.lindquist.com)
  - Top Level Domain: “.com”
  - Second-Level Domain: “lindquist”
- Over 153 million registered domain names.
- Over 33 million registered in 2007.
- ICANN created and controls the UDRP.



# UDRP: The Uniform Domain-Name Dispute-Resolution Policy

- Established by ICANN in 1999.
- **Purpose:** Provides rules and procedures for trademark owners to resolve infringement in domain names.
- Applies to all .com, .biz, .info, .name, .net, and .org top-level domains, and some country code top-level domains.
- Binds all internet registrars and all domain name “owners” within these top-level domains.
- **Remedy:** Transfer ownership of domain name.

## Practical Applications of the UDRP

- Used to stop trademark infringement occurring within a domain name space.
  - Stop customer confusion.
  - Stop customers from being diverted to competitors.
  - Obtain a valuable web address.
  - Increase web site traffic.
  - Can result in the elimination of traditional trademark infringement on the associated website.
- Common targets of UDRP actions:
  - Competitors seeking market advantage.
  - Cybersquatters seeking to sell domain name.
  - Typosquatters obtaining advertising revenue.
  - Junior trademark owners unaware of a senior trademark owner.

# UDRP Arbitrations

- ICANN approved provides for arbitration process:
  - World Intellectual Property Organization (WIPO).
  - National Arbitration Forum (NAF).
  - The Czech Arbitration Court Arbitration Center for Internet Disputes.
  - Asian Domain Name Dispute Resolution Centre.
- Three Set of Rules:
  - The UDRP.
  - The UDRP Rules.
  - Each arbitration provider's Supplemental Rules.
- Highly developed body of UDRP opinions at WIPO and NAF.



# UDRP Arbitration Procedure

- **Proceeding on the Papers:** UDRP provides for a mandatory arbitration proceeding on written filings only, without a discovery period and without a hearing.
- **Supplemental Rules:** Each arbitration provider issues Supplemental Rules controlling the procedure for the arbitration proceeding.
- **Panel:** Panel of one or three arbitrators, at either parties' election.
- **Fees:** Filing fee from \$1300 to \$2600 for single domain, depending upon panel size. Additional fee for supplemental statements.
- **Parties:** Parties are "Complainant "and "Respondent."
- **Filings:** Complaint and Response with supporting affidavits and exhibits. Supplemental responsive statements can be provided.
- **Court Action Available:** At the election of either party, the Policy allows for submitting the dispute to a court either before an arbitration is commenced or after it has concluded.

# UDRP Arbitration Timeline

- **Timing:** WIPO and NAF proceedings usually completed within 60 days of filing.
  - **Day 1:** Case filing.
  - **Day 3:** Within three days, Arbitration provider sends copy of Complaint to registrar and respondent commencing action.
  - **Day 23:** Respondent must file Answer.
  - **Day 28:** Provider has five days from receipt of response or the deadline to respond to appoint a panel.
  - **Day 42:** Panel must provide decision within 14 days of appointment.
  - **Day 45:** Panel has three days to notify parties of decision.
  - **10 Business Days Later:** The registrar will implement the decision of the panel canceling or transferring the domain name, unless the adversely affected domain registration owner has filed suit in a court of mutual jurisdiction by this date.

# Identifying Domain Owner

- **Identify Owner:** Before filing a complaint, contact information for the owner of subject domain must first be identified.
- **WHOIS Searches:** Searchable databases of domain registration owners.
  - Search domain name in a general WHOIS database .
    - e.g., Google.com, Internic.com, Who.is.
  - Identify the relevant domain registrar and its website.
  - Search domain name in the registrar's WHOIS database to find the domain registrant's contact information.
- **Privacy Services:** Many registrar's provide domain privacy services that hide the contact information of domain registration owners for a fee.
  - Registrar's must provide the name and contact information to the arbitration provider when a UDRP complaint is filed.

## Elements of a UDRP Claim

1. Domain name is identical or confusingly similar to a trademark in which the complainant had rights.
  2. Domain owner has no rights or legitimate interests in the domain name.
  3. Domain name has been registered and is being used in bad faith.
- All three elements must be established to prevail.

# Element 1: Confusing Similarity

- **Requires complainant to have trademark rights.**
  - Federal trademark registration not mandatory, but helpful.
  - Trademark registration or use should pre-date domain name registration.
- **Panel compares trademark to domain name.**
  - Generic components (.com or generic terms) generally not considered.
  - Design elements generally not considered.

## Element 2: No Rights or Legitimate Interests

Can be established by showing . . .

- Domain is not used with bona fide offering of goods and services.
- Domain owner is not commonly known by domain name.
- If use is noncommercial, it is intended to misleadingly divert consumers or tarnish a complainant's trademark.

## Element 3: Bad Faith Registration *and* Use

Can be established by showing . . .

- Domain was registered to be later sold or rented to trademark owner.
- Pattern of registering domains to prevent trademark owners from registering.
- Domain was registered for the purpose of disrupting business of competitor.
- Domain was registered to confuse and divert internet traffic from trademark owner's web site for commercial gain.

Both bad faith registration and bad faith use must be established.

# Practice Considerations

- **Always First Determine the Registration Dates.**
  - Determine the date of the trademark registration and the date of the domain registration.
- **Avoid a Barebones Complaint or Answer.**
  - The pleading may be the only chance you have to explain facts and cite to relevant prior decisions.
- **Failing to File Answer is Dangerous.**
  - All assertions in a complaint are generally taken as true where a respondent does not answer.
- **Provide Relevant and Ample Documentary Evidence.**
  - Providing an affidavit with supporting facts and documents is generally advisable.

## Example: Sportsmanswarehouse.com



# Sportsmanswarehouse.com Website

Welcome to **sportsmanswarehouse.com**

Sponsored listings for Sportsmans Warehouse:

## Gander Mountain-Official

Gear Up for Fields & Streams. Reliable Outdoor Gear Since 1960.  
[GanderMountain.com](http://GanderMountain.com)

## Dick's Sporting Goods

Find Top Quality Sporting Goods. Save 20% Off The Outlet.  
[www.DicksSportingGoods.com](http://www.DicksSportingGoods.com)

## Sports Equipment Big 5 Sporting Goods

Search Local Listings between 1 and 50 Miles of Your Area.  
[Local.com](http://Local.com)

## Sportsman's Warehouse Application

Every Job. Everywhere.  
[www.JobsOnline.net](http://www.JobsOnline.net)

## Sports Authority®

Shop Top Quality Sporting Goods. Free Shipping Offers - Official Site.  
[www.SportsAuthority.com](http://www.SportsAuthority.com)

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This domain may be for sale. Buy this Domain

# Why Was Complaint Successful?

- ✓ Trademark ownership predated domain name ownership.
- ✓ Domain parking is generally non-legitimate use.
- ✓ Typosquatting generally indicates bad faith.
- Result: Domain name transferred.

# Example: [grouphealth.com](http://grouphealth.com)



# Grouphealth.com Website

**GroupHealth.com** October 09, 2008

Search:

**gohealth**  
Finding Health Insurance Just Got Easier

Compare Plans Online  
Enter Zip

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## Why Was Defense Successful?

- ✓ Domain name registration predated trademark registrations by 10 years.
- ✓ “Group Health” is generic term in insurance industry.
  - Domain parking is generally legitimate where domain name is generic term.
- ✓ No evidence of bad faith registration.
- Result: Complaint denied.

## Key Elements for a Winning UDRP Case

- Rights in a strong trademark.
- Trademark nearly identical to target domain name.
- Trademark rights predate domain name registration.
- Lack of legitimate domain name use.
- Evidence of bad faith use and registration.

# UDRP Statistics

- Over 20,000 UDRP complaints filed since 1999.
- Top five business sectors in which complaints were filed in 2007: biotechnology and pharmaceuticals, banking and finance, information technology, retail, and entertainment.
- Large percentage of defaults.
- On average, less than 15% of decisions favor domain owners.

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