

# DOMAIN NAME JURISPRUDENCE

(A Handbook on  
ICANN'S UDRP)

by

Gerald M. Levine

Admitted: State and Federal Courts  
New York

Copyright © Gerald M. Levine 2009-2010

# TABLE OF CONTENTS

-----

## INTRODUCTION

### Chapter One: Overview of the Administrative Procedure.

- A. Foundation of the Uniform Domain Name Resolution Policy.
  - 1. Responding to the Proliferation of Cybersquatting.
  - 2. Disjunction Between Two Different Systems.
  - 3. The UDRP Forum.
  - 4. Domain Names as Intangible Property.
- B. Legislating Deceptive Practices.
  - 1. Defining Abusive Registration.
  - 2. Varieties of Predators and Parasites.
  - 3. Innocent and Good Faith Registration.
- C. The Architecture of the UDRP: A Quick Primer.
  - 1. Complainant's Burden to Prove Its Case.
  - 2. Respondent's Burden to Rebut Complainant's Prima Facie Case.
  - 3. Complainant's Burden to Prove Bad Faith in the Conjunctive.
- D. Jurisprudence of the UDRP.
  - 1. New Law Created from Legal and Cultural Resources.
    - a) Sources of UDRP Law.
    - b) Incrementally Broadening Jurisdiction.
  - 2. Construing Basic Principles.
  - 3. The Role of Local Law.
    - a. Creating a Supra-National Jurisprudence.
    - b. Freedom to Criticize.
    - c. Favoring Local Law vs. Conflict of Laws.
- E. Predictability and Consistency in Application of the Law.
  - 1. Fair Verdicts Based on Evidence and the Law.
  - 2. Inconsistency in Applying the Law:
    - Same Complainant, Different Cases and Panels.

### Chapter Two: Contract Obligations.

- A. Contractual Basis for the UDRP.
  - 1. Condition for Registering Domain Name.
  - 2. What "Mandatory" Means.
- B. Registrant's Responsibility for Determining  
Whether a Domain Name Infringes a Third Party's Rights.
  - 1. Representation and Warranty.
  - 2. Willful Blindness Standard.

- C. [Sunrise Rights and Remedies.](#)
- D. [Use and Abuse of Proxy and Privacy Services.](#)
- E. [The Whois Database.](#)

### Chapter Three: The Scope of the UDRP.

- A. [The UDRP is Not a Trademark Court.](#)
  
- B. [Disputes Outside the Scope of the Policy.](#)
  - 1. [The Limited Jurisdiction of the UDRP.](#)
    - a) [Policy Not Applicable to Disputes Between Parties with Competing Rights Acting in Good Faith.](#)
    - b) [Factual Circumstances Outside the Scope of the Policy.](#)
  
- C. [Disputes Within the Scope of the Policy](#)
  - 1. [Willingness to Consider Ancillary Principles and Issues.](#)
  - 2. [Complexity Not Reason for Abdicating Making a Decision Under the UDRP.](#)
  - 3. [Disputes between Contractually Related Parties.](#)
    - a. [Business Disputes.](#)
    - b. [Employer/Employee Disputes.](#)
    - c. [Agency and Consultant Disputes.](#)
  
- D. [Right of a Trademark Owner to Recapture Domain Name After Inadvertent Lapse of Registration.](#)
  - 1. [Recapturing Domain Name.](#)
  - 2. [Uncertainty of Recapturing Lapsed Domain Name.](#)

### Chapter Four: Complainant's Burden of Proof.

- A. [Subject Matter Jurisdiction and Standing](#) – Paragraph 4(a)(i) of the Policy
  - 1. [Threshold for Jurisdiction.](#)
    - a) [Qualification for Invoking Policy Remedies.](#)
      - i. [Existing Trademark Rights.](#)
      - ii. [Potential Trademark Rights.](#)
    - b) [Comparing Domain Name and Trademark Side by Side.](#)
      - i. [Identical and Confusing Similarity.](#)
      - ii. [Test for Confusing Similarity.](#)
      - iii. [Similar, But Not Confusingly Similar.](#)
    - c) [A Trademark "In Which the Complainant Has Rights."](#)
      - i. [Trademark Registered in Any Country.](#)
      - ii. [Principal Register: Presumption of Validity.](#)
      - iii. [Family of Marks.](#)

2. No Rights Accrue on Application for Trademark.
  3. Common Law Marks, Recognition in the Marketplace and Proof of Secondary Meaning.
    - a) Common Law Rights Protected.
    - b) Proving Common Law Trademark Rights.
      - i. Common Law Right Not Presumed.
      - ii. Common Law Right Disproved by Admission.
      - iii. Supplemental Register.
  4. Acronyms, Initials and Abbreviations.
    - a) Associated with Multiple Complainants.
    - b) Disfavoring the Complainant.
    - c) Offers of Proof.
  5. Design-Plus-Word Trademarks.
  6. A Question of Standing.
    - a) Personal Names as Domain Names.
      - i. Not Source Indicators.
      - ii. Source Indicators.
        - A. The General Rule: Common Law Right.
        - B. Expanding the General Rule.
    - b) Geographic Indicators as Domain Names.
      - i. Purely Descriptive of Location.
      - ii. Geography as Source.
    - c) Trade Names as Domain Names.
  7. Timing of Trademark Acquisition Not a Factor in Determining Standing.
    - a) Complainant's Acquisition of Trademark Right.
    - b) Maturation of Trademark Right Over Time.
- B. Respondent's Lack of Rights or Legitimate Interests –  
Paragraph 4(a)(ii) of the Policy
1. Prima Facie Proof.
  2. Domain Names Antedating Trademark Acquisition.
  3. Lawful Business, Mala Fides Use of Domain Name.
- C. Has Been Registered and Is Using the Domain Name in Bad Faith –  
Paragraph 4(a)(iii) of the Policy
1. Bad Faith in the Conjunctive.
    - a) Construed Temporally.
    - b) Bad Faith Use Measured by Content.

- c) Subsequent Bad Faith Use.
    - i. Good Faith Not Vitiating by Change of Use.
    - ii. Retroactive Bad Faith.
    - iii. The Unified Concept of Bad Faith.
  - d) Concealment and Falsification
2. Knowledge and Targeting are Prerequisite to Finding Bad Faith Registration.
- 
- a) Knowledge, Awareness and Implausible Denial.
    - i. Actual Knowledge Inferred from the Record..
    - ii. Examples of Awareness.
    - iii. No Constructive Notice.
  - b) Geographic Remoteness and Nearness in Proving Knowledge.
- 
- c) Targeting: Appropriating for Trademark Value
3. Renewal of Registration vs Registration by Transfer.
- a) Renewal: Not Equivalent to New Registration.
  - b) Transfer=Registration.
    - i. Second and Subsequent Generations of Transferees.
    - ii. Examining Conduct: Retrospective.
    - iii. Examining The Record: Prospective.
    - iv. Transfer Between Commonly Controlled Persons.

Chapter Five: Respondent Has Registered and is Using Domain Name in Bad Faith – Paragraphs 4(b)(i-iv).

- A. Tortious Conduct that Supports Bad Faith
  - 1. Circumstances of Bad Faith.
    - a) Examples of Proscribed Conduct.
      - i. Defining the Burden.
      - ii. Identifying the Right Theory of Predation.
    - b) Other Acts of Bad Faith and ACPA List of Examples.
    - c). Parking for Revenue.
  - 2. Interfering With the Proceedings.
  - 3. Registering Domain Names Opportunistically.
    - a) Opportunistic “Bad Faith.”
      - i. No Connection with Complainant.
      - ii. Acting on Media Coverage.
    - b) Pretending to Be the Complainant.
      - i. Faux Registrant.
      - ii. Fraudulent Transfer (Hijacking) of Domain Names.
      - iii. Phishing.
      - iv. Redacting Victims’ Names.

4. Initial Interest Confusion and Nominative Fair Use.
  - a) Initial Interest Confusion.
  - b) Nominative Fair Use.
  - c) Disclaimer in Website.
5. Retaining Domain Name After Termination of Contract.
6. Mixing Innocent and Infringing Elements.

B. Selling, Renting or Otherwise Transferring –  
Paragraph 4(b)(i) of the Policy

1. The “Primary Purpose” Test: Not All Offers to Sell Violate the Policy.

---

  - a) Violating the “Primary Purpose” Test.
  - b) Not All Offers to Sell Violate the Policy.

C. Pattern of Conduct – Paragraph 4(b)(ii) of the Policy

1. Acts Construed as a “Pattern of Conduct”.
2. Enhanced Investigatory Responsibilities for High Volume Registrants.

---

  - a) Construing a Different Standard for High Volume Registrants.
  - b) Discomfort in Construing a Higher Standard.

D. Disrupting Business of Competitor –  
Paragraph 4(b)(iii) of the Policy

1. Competition in the Marketplace.

E. Intentionally Attempting to Attract for Commercial Gain – Paragraph 4(b)(iv) of the Policy

1. Violating Complainant’s Right by Intentionally Attempting to Attract Internet Users for Commercial Gain.

---

  - a) Conduct that Violates the Policy.
  - b) Intentional Act.
2. Forming a Domain Name by Incorporating Complainant’s Trademark Plus an Additional Term.

---
3. Diverting or Redirecting Internet Users to Another Website.
  - a) Commercial Gain from Diverting or Redirecting.
  - b) Commercial Gain from Tarnishment.
4. Word Order and Reorder.
  - a) Typosquatting.
  - b) Contractions and Abbreviations.
5. Populating Web Pages; the “Not Me” Defense.

Chapter Six: Proving Rights or Legitimate Interests in the  
Dispute Domain Name.

A. Safe Harbor, Paragraph 4(c) of the Policy

1. Distinguishing Rights and Legitimate Interests.
  - a) Rights As a Legally Enforceable Interest.
    - i. Rival Trademarks in Foreign Jurisdictions.
    - ii. Concurrent Use of Common Lexical Arrangements.
  - b) Legitimate Interests.
2. Rights and Legitimate Interests are Dictated by Conduct
  - a) Active Website.
  - b) Inactive and Passive Use.
3. Legitimate Interest Permissibly or Without Authorization.
  - a) Permissive Use of Trademark.
  - b) Legitimate Use Without Authorization.
4. Registering Common Words and Descriptive Phrases to Attract Internet Traffic.
  - a) Dictionary Words and Common Combinations.
    - i. Crossing the Boundary Separating Denotation and Connotation.
    - ii. Common Words; Uncommon in Combination.
    - iii. Common Words; Common Phrases.
  - b) Descriptive Terms and Expressions Common in Everyday Life or in Industry and the Professions.
5. Race to the Registry: “First Come First Served” Doctrine.
  - a) Parties with Equal Rights.
  - b) Pre-Registered Domain Names; Post-Registered Trademarks.

B. Prior Use and Demonstrable Use Before Notice –  
Paragraph 4(c)(i) of the Policy

1. Construing “Before Any Notice of the Dispute”.
2. Construing Bona Fide Use.
3. Cease and Desist Letters.
4. Construing “Demonstrable Preparations.”
5. Sleeping on One’s Rights.
6. Legitimate Activities.
  - a) Business Models.
  - b) Personalized (Vanity) E-Mail Service.
  - c) Domain Names for Sale.
  - d) Advertising.

- C. Commonly Known by the Domain Name,  
Paragraph 4(c)(ii) of the Policy
  - 1. What It Means to be “Commonly Known By.”
    - a) Business Names.
    - b) Personal Names.
    - c) Nicknames and False names.
  
- D. Noncommercial or Fair Use, Without Intent  
Paragraph 4(c)(iii) of the Policy
  - 1. Appropriating Target’s Trademark for Noncommercial Fair Use and Free Speech.
    - a) Structure of the Defense.
    - b) Ambivalence in Application.
      - i. View 1 – Limitations on Critical Speech.
      - ii. View 2 – Critical Speech without Limitations.
      - iii. Mediating Views 1 and 2.
    - c) Political Speech: Parody and Satire.
    - d) Famous Names and Fan Sites.
      - i. View 1.
      - ii. View 2.
  - 2. Adding Terms of Opposition or Pejorative Affixes/Suffixes to Trademarks.
    - a. “Sucks” Cases.
    - b. Other Pejorative Affixes/Suffixes.
  - 3. Intent to Tarnish.
  - 4. Extreme Expression.
  - 5. Affiliate Programs.

Chapter Seven: Selected Rules of the Policy.

- A. Rule 3 of the Rules of the Policy – Concerning Complainant
  - 1. Proper Party Complainant(s).
    - a) Single or Multiple Related Complainants.
      - i. Trademark Holders.
      - ii. Licensees.
    - b) Multiple Domain Names – Aliases for Controlling Domain Name Holder.
      - i. Multiple Registrants in One Dispute.
      - ii. Multiple Disputes Consolidated.
    - c) Multiple Unrelated Complainants in Consolidated Proceeding.

2. [No Record, No Case.](#)
3. [Refiling a Complaint: New Facts or New Registrant.](#)
  - a) [Dismissal on the Merits.](#)
  - b) [Dismissal as Outside the Scope of the Policy.](#)
  - c) [Complaint Dismissed without Prejudice.](#)

B. [Rule 5 of the Rules of the Policy](#) – Concerning Respondent

1. [Proper Party Respondent.](#)
2. [Rule of Timely Submission or Lose Right to Defend.](#)
  - a) [Timely Submission.](#)
  - b) [Extension of Time to Submit.](#)
3. [A Respondent Is Not Required to Respond to a Complaint.](#)
  - a) [Mandatory Procedure.](#)
  - b) [Consequences of Default.](#)

C. [“Supplemental Rules”](#) – Rules Adopted by Provider

1. [Supplementing the Record](#)
  - a) [WIPO Practice.](#)
  - b) [Nat. Arb. Forum Practice.](#)

D. [Rule 10\(d\) of the Rules of the Policy](#) –  
Admissibility, Relevance, Materiality and  
Weight of the evidence.

1. [Prosecuting a UDRP Complaint and Defending Rights or Legitimate Interests in Disputed Domain Name.](#)
  - a) [Preponderance of the Evidence.](#)
  - b) [Variety of Evidence.](#)
    - i. [Declaration or Affidavit.](#)
    - ii. [Historical Snapshots: The Wayback Machine.](#)
  - c) [Evidence Controlled by Party.](#)
2. [No Record, No Case.](#)
3. [The Role of Credibility in a UDRP Proceeding.](#)
4. [Admissibility of Communications Relating to Settlement.](#)

- E. Rule 11(a) of the Rules of the Policy –  
Language of the Proceedings
  - 1. Language of the Proceedings.
  
- F. Rules 12 and 10(a) of the Rules of the Policy – Panel’s Authority
  - 1. Respecting the Record –  
What Panels Can and Cannot Do.
    - a) Procedural Orders.
    - b) Researching on the Internet.
  
- G. Rule 14 of the Rules of the Policy – Inferences
  - 1. Drawing Inferences.
  
- H. Rule 15(a) of the Rules of the Policy – Rules and Principles of Law.
  - 1. Marshaling Rebuttal Proof to Complainant’s  
Prima Facie Case
  - 2. Factual Circumstances Favoring Respondents.
  
- I. Rule 15(e) of the Rules of the Policy –  
Complaint filed in Bad Faith
  - 1. Declaring the Complainant Culpable For Abusing the  
Administrative Proceeding (Reverse Domain Name Hijacking).
    - a) Complaints Without Merit.
    - b) Denying RDNH.
    - c) Different Standards, Appearing by Counsel and Pro Se.
  
- J. Rule 17(a) of the Rules of the Policy – Consent to Transfer
  - 1. Mutual or Unilateral Consent to Transfer; Respondent’s Motivation.

Chapter Eight: Terminating or Suspending UDRP Proceedings.

A. Paragraph 4(k) of the Policy

1. Submitting Dispute to a Court of Competent Jurisdiction.
2. Plenary Adjudication after An Adverse Decision.

B. Rule 18 of the Rules of the Policy

1. Suspending or Terminating a Proceeding.

-----  
APPENDIX

Hyperlinks to Basic Documents on the Internet.

## INTRODUCTION

The Uniform Domain Name Resolution Policy, UDRP or the Policy for short, establishes an alternative forum for trademark holders (owners, co-owners and licensees) to challenge registrations of domain names that allegedly violate their legal rights. It is a niche forum implemented in 1999 by the Internet Corporation of Assigned Names and Numbers following an in-depth study and publication of recommendations by the World Intellectual Property Organization earlier that year. These two organizations are commonly referred by their acronyms, ICANN and WIPO. The UDRP forum is available to trademark holders without regard to the national source of their rights or the respondent's business or residential location. The procedure is authorized by interlinked contracts by and between, on the one hand, ICANN and Registrars and, on the other, Registrars and Registrants. On payment of a modest fee, an impartial and independent ICANN certified Provider will assign an arbitrator (or a three member panel if requested) to examine the facts and rule on the parties' respective rights to the disputed domain name.

The process for adjudicating UDRP claims is both vastly accelerated and significantly different from experience in a national court of law. It is different most conspicuously in that the claims are resolved solely on papers by applying a jurisprudence especially adapted to the issues the Policy is designed to resolve. The complainant in these proceedings is entitled to invoke the Policy and present its claim if it has a *present* trademark right. A present right includes unregistered trademarks. A prospective right, an application pending for example, does

not support an actionable claim unless there is affirmative proof of unregistered use of the trademark sufficient in length and market penetration to be recognized by the public as a source of goods or services.

Acquiring domain names as assets – for selling, financing monetizing, trading and warehousing – has been part of the culture of the Internet from the beginning. It is not condemned by the Policy unless the purpose of the registration is to take advantage of the trademark holder. Merchants in the domain business simply pitched their stalls in the new souk alongside the more traditional sellers of goods and services. Commencement of a proceeding to challenge the registration of the disputed domain name puts in issue the respondent's choice. Although a domain name identical or confusingly similar to a trademark calls for an explanation, fortuity cannot be ruled out.

Just as trademark law recognizes that two parties can co-exist as concurrent users of the same lexical elements without interfering with the legal rights of the other, so too does the jurisprudence of the UDRP. So, for example, generic words and descriptive phrases are protected only to the extent of their public recognition as sources of a complainant's goods or services. Trademarks that over time have achieved a market reputation may or may not have a right superior to the respondent if they had no reputation at the time the disputed domain name was registered. Lacking proof that a respondent registered the domain name with the intention of taking advantage of the trademark common lexical and numerical elements are available to the first to register.

The jurisdiction of the Policy is limited to adjudicating conduct defined as “abusive registration” *as that term has come to be construed*. I italicize to make a point. A case can be made that domain name jurisprudence has broadened beyond the scope of the Policy as it was originally conceived to subsume into abusive registration acts of abusive conduct and practice. Even so, the jurisdiction of the UDRP is limited to domain names.

The UDRP proceeding is not a substitute for a trademark court – it was not created to adjudicate issues of trademark infringement, *as such*. This does not mean to say that trademark issues are absent in adjudicating domain name rights, but the focus is different. The UDRP’s mission is to determine whether the registrant has a right or legitimate interest in the disputed domain name or has registered it to take advantage of the complainant’s trademark. “Taking advantage” includes a variety of culpable acts within the pallet of bad faith. Where the complainant satisfies its burden of proof the Policy offers relief similar to that which it would receive in a court of law, namely control of the domain name, but not damages. Its great benefit is that the proceeding is over and done with in a fraction of the time and cost of a plenary action in a court of law.

Registrants (respondents in a UDRP proceeding) are involuntary participants to the proceedings. Even though their Registration Agreement makes the proceeding mandatory in the sense of having to answer for their choices of domain names, they are not compelled to appear and answer the complaint. However, default in answering a complaint has consequences, and although failure to submit exculpatory evidence is as much a part of the record as that which is offered, silence is not an admission of abusive registration. A complainant is not entitled to

relief simply because it has a trademark and a respondent does not suffer forfeiture of the domain name because it defaults. It is not bad faith to speculatively register domain names for presumed future value. A holder of a future acquired trademark, for example, has no legal right to an earlier registered corresponding domain name. Nor is it cybersquatting to register a domain name found to be identical or confusingly similar to a complainant's trademark, as long as the domain name is not acquired to take economic advantage of an *existing* trademark.

The beneficiary of the Policy, though, and the reason for its existence is the trademark holder. It does not have to jump through hoops for redress. The Policy is not territorially restricted and service of process does not involve process servers. Any trademark holder complaining of abusive registration may initiate a proceeding against any respondent residing anywhere in the World. Assigned panelists are required to deliver decisions within two months of the initiation of proceedings. The Policy is a powerful tool for trademark holders, but it can also be a drawback in that there is no internal appeal from inadequately reasoned decisions. Recourse is to a national court, which in the United States would be a claim in district court under the Anticybersquatting Consumer Protection Act (ACPA). This deficiency of appeal not only affects respondents who lose out. Unfortunately, parties with small means are discouraged by the expense of a plenary action to mount a *de novo* challenge to a UDRP decision.

*Commentaries on the Uniform Domain Name Resolution Policy* serves several ends. It is an instructional manual for parties and attorneys engaged in the UDRP process. Parties should know what to expect and what is expected of them in arbitrating a domain name claim. It may come as a surprise to some, but much is expected of parties in a UDRP proceeding. Many – and

this includes counsel – fail to understand what is required in prosecuting and defending a proceeding solely on papers initiated under the Policy and its Rules. This failure includes a lack of appreciation for the jurisprudence applied to the facts in a case. While the jurisprudence is narrow, it is not static. *Commentaries* gives an account of its development and identifies the direction the law is taking with respect to certain issues and the disagreements among panelists as to constructions that are said to violate the intentions of the framers of the Policy.

The proceeding may be “adjudication lite” as one appellate panel has said, but it is not “law lite” and the requirements should be taken seriously. Guidance on the subject of expectations and domain name jurisprudence is warranted because many parties undertake the proceedings and they and their counsel are dismayed to learn that it is governed by a body of law and rules of evidence of which before hand they paid little or no attention and after hand wished they had.

New York, 2010