

A Study by the Max-Planck-Institute for Foreign and International Patent, Copyright and Competition Law,
Munich

in Cooperation with

Institute for Intellectual Property Law and Market Law, University of Stockholm

Institute for Information Law, Technical University of Karlsruhe

written by Dr. Annette KUR, Max-Planck-Institute, Munich

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I. [Introduction](#)

1. [Initial Remarks](#)

The UDRP (Uniform Dispute Resolution Policy) was accepted and introduced by ICANN in November 1999 in order to provide for a fast and efficient procedure for the settlement of conflicts between domain name registrants under the Top Level Domains (TLDs) .com, .org and .net and the holders of trade mark rights. The administrative framework for the procedure is provided by Dispute Resolution Service Providers accredited by ICANN, of which there are four at the moment: WIPO, NAF, eResolutions and CPR.

The statistical data available from ICANN and other sources show that the UDRP is used very frequently in practice. Since the first decision handed down by a WIPO Panel in December 1999, more than 4000 cases involving over 7000 domain names have been handled, and there is no sign of major decline. To the contrary, it is expected that the figures will rise again in proportion to further ccTLDs joining the system and, even more important, in connection with the roll-out of new generic TLDs like .biz, .info etc.

Although the introduction of the UDRP has been a success story at least in regard of the number of conflicts which have been submitted for decision by UDRP Panels, the Policy was and remains the subject of concern and controversy. It was feared that the system might be misused by rightholders, in particular big companies, in order to obstruct the selection and use of domain names by small business and private parties, that the Policy was not formulated clearly enough, and that it did not furnish a sufficient "legal" basis for the settlement of conflicts. On the other hand, it was argued that the policy had too many loopholes to function properly from the point of view of rightholders. It was *inter alia* for the last-mentioned reason that WIPO initiated its second domain name process, in the course of which the possibility was investigated to amend the policy, e.g. by including more rights than just (registered) trade marks, etc.

This study evaluates the functioning of the UDRP as at early 2001, without taking into account possible changes and extensions brought about by the inclusion of more TLDs and in consequence of the WIPO second (and third) domain name process. The issues to be explored comprise *inter alia* whether and to what extent the UDRP functions in practice in accordance with its original objective, namely to grant quick and efficient relief against cybersquatting, or whether and to what extent it goes beyond that aim; furthermore, whether the decisions reveal some amount of inconsistency and if so, which aspects are primarily concerned, and what – if anything – could be done about it; next, whether there are indications of misuse of the policy, in particular signs of reverse domain hijacking and how Panels react to that, etc[1].

2. [Historical Background – How the UDRP was Developed](#)

The UDRP was introduced in the framework of transferring Internet governance structures from the public to the private sector, a process which was initiated by the National Telecommunications and Information Agency (NTIA) in the US Department of Commerce (DoC) in early 1998. The process involved *inter alia* the founding of ICANN as well as the termination of the previous monopoly held by Network Solutions, Inc. (NSI) as registrar for the so-called generic, open TLDs .com, .org and .net (+ the restricted TLDs .gov, .mil and .edu). As a further step in the process, WIPO was given the mandate to investigate possible means and procedures to be implemented in, or in connection with, the registration procedure, in order to prevent or at least to reduce the negative impact of

cybersquatting.

The phenomenon which has become known by the term "cybersquatting" emerged around the mid-nineties, after the Internet – or more specifically: the world wide web – had gone commercial. Before that, when the Internet was mainly used for scientific purposes or for communication between individuals, domain names hardly posed any problems. The Domain Name System (DNS) had been invented at a rather early stage of the Internet age as a user-friendly complement to the Internet address system consisting of digital numbers. Coordination and control of the Internet address system as well as the DNS were originally performed by IANA (Internet Assigned Numbers Authority), a branch of the Information Sciences Institute (ISI) at the University of California. Network Solution Inc. (NSI), a private enterprise, was endowed with the task of registering domain names on the basis of a contract with the National Science Foundation (NSF). In 1995, NSI obtained the permission to charge a registration fee.

Registrations of domain names under .com, .org and .net were – and still are – taken out on the basis of the first come, first served principle. As a reaction to growing concerns about cybersquatting – persons registering (sometimes large quantities of) trade marks or trade names belonging to major companies with the intent to sell them back for a high amount of money – NSI developed a so-called Dispute Settlement Policy, which was implemented for the first time in November 1996, and which was amended and changed several times during the following years. Notwithstanding changes in respect of the details, it was generally foreseen in NSI's Policy that if someone could establish that he or she was the owner of a right which was identical or quasi-identical with the second level domain registered under .org, .com or .net, the domain name was put "on hold", i.e. it could not be used by either party, as long as the conflict was not settled, be it by court decision or by way of a voluntary agreement.

NSI's Dispute Settlement Policy attracted much criticism. In particular, the fact that identity or quasi-identity of the domain name and the sign was sufficient to put the domain name on hold, even if the sign was protected for different goods or services than those in connection of which the domain name was used, was held to constitute a major flaw. Several registrants successfully sued NSI after their domain names had been put on hold on the basis of complaints raised by holders of marks which were used and protected only in respect of non-competing goods or services.

Another serious drawback of NSI's Policy concerned the fact that while the conflict was pending, none of the interested parties was in a position to make use of the domain name. As it usually took a long time before a court decision could be obtained, in particular in a situation when the parties were resident in different countries, there was frequently no other choice for the party who most needed to use the domain name, than to offer a considerable sum of money to the other side in order to end the deadlock. Thus, NSI's Dispute Settlement Policy could be used by both parties involved – the person first registering the domain name as well as the person challenging the registration - as an instrument for harassing and money-making. It was this situation which gave rise to the phenomenon which became known as "reverse domain hijacking".

The problems arising under .net, .org and particularly under .com, and the dissatisfactory response offered by NSI's Policy, lay behind the initiative launched by several Internet-related associations and international organisations supported by IANA, the so called Internet Ad Hoc Committee (IAHC), to establish a new system

for the registration of domain names under a couple of new generic TLDs, based on the so-called gTLD Memorandum of Understanding (gTLD-MoU). As one of its essential features, the gTLD-MoU obliged any person registering a domain name under a gTLD adhering to the system to submit, upon request of a person claiming to be the holder of an intellectual property right infringed by the domain name, to a mediation procedure in the framework of the WIPO Arbitration and Mediation Center, or to an administrative panel procedure to be established with a special view towards domain name conflicts (Administrative Domain Name Challenge panels - ACPs), which was also intended to operate within the administrative framework of the WIPO Center.

Although the gTLD-MoU system became operational in 1998, it never gained much impact in practice. Instead, it was superseded by the process launched by NTIA, to which reference was made at the beginning of this chapter. Anyway, when WIPO, upon request by NTIA and on the basis of a mandate of its Member States, initiated the investigation of possibilities to prevent or reduce cybersquatting in respect of domain names under gTLDs administered by ICANN, it used the legal mechanisms discussed in connection with the gTLD-MoU as a model of reference.

The efforts undertaken by WIPO in the context have become widely known as the ²first domain name process². They comprised extensive consultations with Member States and interested circles, both conducted on-line and during regional conferences held over all continents. The work resulted in a final report which was published in 1999[2] and which embraced, inter alia, the proposal to establish the UDRP as administrative dispute resolution proceedings to which any domain name registrant under the system has to submit, and which are administered by several independent Dispute Resolution Service providers accredited by ICANN.

In the course of the first domain name process, WIPO further considered a number of alternative mechanisms by which to reduce the risk of cybersquatting. Even though they have not been implemented, they may be of interest as a background for the evaluation of the UDRP. They are therefore briefly outlined below:

- *Obligatory pre-screening*: This proposal was based on the idea that every new domain name registration should be subject to an automatic, computer-based pre-screening for prior trademark rights. For this purpose, it was suggested that a world-wide data base comprising all trademark registrations should be set up and administered by an international agency, preferably by WIPO. If a conflict was found to exist between a registered mark and a designation to be registered as second level domain, the parties could be notified of the conflict and the registration be postponed until the conflict was settled between them or in court. The proposal was rejected inter alia because of the technical and financial difficulties which the establishment of the envisaged database would entail. Furthermore, it was found that the somewhat cumbersome process of pre-screening, to which according to the proposal all applications for domain name registration would be subject, might be regarded as being out of proportion in view of the relatively small number of domain name conflicts as compared to the number of domain name registrations at large.
- *Obligatory waiting period*: Another proposal discussed during the first domain name process concerned the obligation of every domain name registrant to observe a waiting period – six or four weeks – before commencing active use. During that time, the name would be posted, together with the contact information for the registrant and the purpose for which the domain name was intended to be used, on a special, fully searchable website, giving rightholders the opportunity to take protective measures against threatening infringements at an early stage. However, also in respect of this proposal it was found that it would be overly restrictive if it were imposed as a mandatory rule to be followed by all registrars and their clients; however, it was maintained as one possibility to be implemented on a voluntary basis.

- *Exclusionary process:* An alternative to obligatory pre-screening on a general basis could be provided by a pro-active system which permits rightholders, possibly under certain conditions, to volunteer for a list of protected designations which are per se excluded from registration by others. In the WIPO final report, the option was discussed and proposed as a special tool for protection of famous marks. The idea was that owners of marks which they considered to be famous should be given the opportunity to apply for famous mark status, with the consequence that applications for domain name registrations including the same mark would be excluded from all or some gTLDs. The proposal was however not readily accepted by ICANN, but it was referred to the Domain Name Supporting Organisation of ICANN (DNSO) for further discussion, and was finally rejected. It was found that there was little to no chance to arrive at a general agreement in respect of the criteria by which a famous mark in the meaning of the Policy should be defined. Furthermore, the registrars objected to any regulation which would put them under an obligation to perform a kind of pre-screening, not least in view of the possible liability for negligence this might entail.

- *Restricted Top Level Domains:* As a radical step towards prevention of domain conflicts, a system could be envisaged which reserves the right to register a second level domain to persons who are in a position to show that they have a right in the name at stake – be it a trademark, tradename or personal name. Such systems have been established on the national level (e.g. in France), and are generally considered to be very effective. On the other hand, they exclude any possibility to register fantasy names or generic/descriptive names and thereby further reduce the number of available second level domains. Whereas this approach may not be unduly burdensome in respect of a (small) ccTLD, it is unsuitable for large gTLDs intended to encompass registrations from many countries. Besides, a system like that cannot be installed retroactively with respect to previously open gTLDs such as .com, .org and .net, but it could only function for newly established gTLDs. In fact, the “sunrise period“ which is a feature frequently discussed in the context of the introduction of new gTLDs, and which has been observed e.g. by .info, consists of a combination of a restricted approach – only right holders are allowed to register during the initial roll-out phase (“sunrise“) – whereas the gTLD becomes “open“ after that period.

3 About the UDRP

3.1 Basic Facts & Statistical Data

As was mentioned previously, four Dispute Resolution Service Providers (“Providers“) had been accredited by ICANN by July 2001: WIPO (1.Dec.1999), NAF (23 Dec,1999), eResolutions (1 Jan, 2000) and CPR (22 May, 2000). Each Provider is bound to observe the "Rules of Procedure" which have been accepted by ICANN together with the UDRP. The general framework as regards the formal requirements for complaint and response as well as other communications during the procedure, the appointment of the Panel, languages, default, etc. are therefore the same for all Providers.

In addition to that, supplemental rules have been promulgated by each Provider. Among others, these rules typically contain the fee structure applied by the Provider. When last visited (15 Sept. 2001), the structures were as follows (all fees in US\$):

Provider	Number of domain names	Single Panelist	Three-Person-Panel
CPR	1-2	2000	4500
	3-5	2500	6000
	more than 6	To be determined	To be determined
eResolution	1-2	1250	2900
	3-6	1800	3250
	7-10	1850	3900
	11-15	2300	4600
	more than 15	To be determined	To be determined
NAF	1	950	2500
	2	1100	2500
	3	1250	2500
	4-5	1400	2500
	6-10	1750	3500
	11-15	2000	4000
	more than 15	To be determined	To be determined
WIPO	1-5	1500	3000
	6-10	2000	4000
	more than 10	To be determined	To be determined

It follows that CPR is most expensive, while NAF has the most differentiated and, in most cases, the most favourable fee structure.

Previous studies, in particular the "Rough Justice" analysis by Dr. Milton Mueller, have undertaken further comparative analyses of the services rendered by each Provider, e.g. as regards the decision time^[3]. No effort has been undertaken in this study to complete or update these findings. Likewise, no specific investigation has been made in respect of the country of origin of the parties involved. Insofar as NAF and eResolution are concerned, it is submitted that the statistical data in the "Rough Justice" still convey a realistic picture of the present situation. This means that US-based complainants are involved in the large majority of cases before NAF, whereas eResolutions attracts a relatively high number of complainants from Canada and also from the US^[4]. According to statistics from WIPO as at 3 August 2001, parties originating from the US have been involved in roughly 50 % of the decisions handed down in 2000, both as complainants (897 out of 1841) and as respondents (943). For 2001, the corresponding data are not yet available.

As regards the outcome of decisions in general, the ICANN homepage shows that out of 3316 decisions^[5] (30 July 2001), 2616 have ordered transfer of the domain name (WIPO, same date: 1502 of 1815^[6]). In 650 cases, the decision was for defendant (WIPO: 346); in 21 cases comprising 496 domain names, the decision was split (the WIPO statistics do not mention split decisions).

3.2 [The Legal Nature of UDRP Decisions](#)

The legal nature of UDRP proceedings is not easy to define. In fact, it is not far from the truth to say that it is without precedent. It has been emphasized several times that the UDRP differs from arbitration in the usual meaning. In contrast to arbitration, it does not have binding effect other than on the registrar (subject to certain conditions), and it does not foreclose the possibility to submit the case to national courts in a competent jurisdiction. Furthermore, the UDRP is not "law" in the sense that the substantive rules applied in the assessment are derived from any specific national codification or case law, or that they are founded on an international agreement in the meaning of public international law.

The legal basis for the application of the UDRP is set up in the contract between the registrar and the domain name registrant. In that contract, the registrant expressly submits to the Policy and the Procedural Rules by which it is implemented. In other words, the Policy and the Rules themselves are to be legally qualified as specific contract terms which have been promulgated autonomously by the entity rendering the service, i.e. (finally) by ICANN.

Admittedly, this picture amounts to an over-simplification of the much more complicated structure of DNS administration and domain name registration. In particular, there is obviously more than one level of contractual relationship involved. Nevertheless, it is basically correct. Keeping this in mind may help to shed light on some of the questions which are sometimes raised in respect of the legal quality of UDRP decisions.

If it is understood that the UDRP rules are merely contract terms, in contrast to rules of law which have been rendered binding vis-à-vis everyone by an Act of State, it should be possible to ease the concerns sometimes expressed in respect of the lacking foundation of the Policy in any specific, identifiable legal codification. It also explains the reason why aspects of the UDRP do not comply with certain rules of procedure anchored in national law, e.g. the seventh amendment in the US constitution^[7].

Furthermore, if it is accepted that the UDRP is based on rules which are meant to be operative only in the framework of a contractual system, it becomes clearer why the Panel decisions do not prejudice the outcome of subsequent court proceedings in any manner. It also takes the sting out of questions pertaining to conflict of laws: as a matter of principle, Panels are not supposed to apply any particular national law at all, but to interpret the Policy as it is, i.e. as a body of rules which have been developed autonomously for the purposes of dispute settlement in respect of domain name conflicts.

However, this does not exclude rules developed in certain national legislations being applied to the extent the Panel might find them useful and appropriate for the interpretation of the Policy. This concerns most of all issues which have not been regulated in a conclusive manner in the UDRP itself, like the question under which circumstances (unregistered) trademark rights may provide a sufficient basis for a complaint.

While the fact that the UDRP is a system based on a hierarchy of contracts therefore does help to disperse some of the concerns which are sometimes raised in respect of its allegedly lacking legal foundation, it raises a different kind of legal issue. If the whole system is based on contract, the stability of its structure depends on the validity of the individual agreements under which it is constructed. It adds to the complexity of this aspect that the laws governing the assessment of the validity of the contracts involved may be many – how many and which is an issue to be decided pursuant to the rules of private international law – and that they may hold specific safeguard mechanisms in respect of the evaluation of the validity of contract clauses which, such as the submission to the UDRP, which are pre-formulated by the contractor and cannot be negotiated or abrogated.

The study does not attempt to deal with this question in more detail, although it strongly recommends this issue for further in-depth analysis. Notwithstanding the results of further studies, it is submitted here that the contractual system on which the UDRP is based will pass the test for validity of adhesive contracts as long as it embraces a fair and equitable balance of interests, so that its foundation on a "pseudo-voluntary" consent by registrants does not clash with fundamental legal principles.

4. [The UDRP in the Literature – an Overview](#)

In the relatively short time since the introduction of the UDRP, it has been the object of much discussion in the literature. An illustrative list of publications in English, both published on-line and in printed form, is attached to this study. In addition to that, several publications in German and in Swedish have been taken into account. It is however understood that these listings do not cover the whole range of publications available on the subject.

As regards the contents of available publications, the following trends can be discerned. Most of the (shorter) articles are of an informative nature, frequently with a supportive undertone. In the early phase, the emphasis lay on information about the legislative history of the UDRP and the description of its individual features; later, the focus shifted to observations concerning the current practice, e.g. by reviewing decisions. A lesser number of the publications goes beyond pure information and embarks on a deeper analysis of the UDRP; often, though not necessarily, with a critical view. The critical remarks sometimes target the complex of the DNS management as a whole, i.e. the role and structure of ICANN, and its interaction with other institutions involved, i.e. the DoC or WIPO. This sort of fundamental criticism, although interesting as such, is beyond the topic of this study. Other publications aim at pointing out certain flaws in respect of the procedural framework and/or in respect of the way in which the ²substantive law² aspects of the Policy are applied by Panels.

The points raised in the last-mentioned kind of articles have been of special interest for this study. However, the fact that these critical remarks have received special attention does not mean that they are considered as being more valuable, and given preference over, other, more supportive interventions. It should be duly noted that the bulk of published comments on the UDRP – inasfar as they have been revised in the preparation of this study – are generally positive in their attitude. This even holds true for many of the articles containing critical comments: The authors often state that they are supportive of the system in general, and only want to improve its efficiency and/or aspects contributing to more fairness and balance.

II [The Study](#)

1. [Method](#)

1.1 [Warming Up: The Pre-Study](#)

Before the commencement of the statistical evaluation, a pre-study was carried out in the framework of the master's course on European Intellectual Property Law at the University of Stockholm, under the supervision of Prof. Marianne Levin and Dr. Annette Kur. The course consisted of 29 students who were given, in groups consisting of two people each, the task to review and evaluate UDRP decisions which were pre-selected according to certain criteria. The results of the review were summarized in a written abstract, and they were presented and discussed in a seminar held in Stockholm at the end of February 2001.

The decisions to be considered by the individual groups were selected and distributed among them according to the following criteria:

- **geographical names, personal names (1 person; all cases)**
- **Generic (descriptive) designations (4 groups)**
- **prefixes and suffixes (5 groups)**
- **cases including more than 5 domain name registrations (mass cases) (1 group)**
- **cases where the complaint was rejected (3 groups)**

1.2 [Statistical Evaluation of UDRP Decisions](#)

The second phase consisted of a statistical evaluation of 700 individual UDRP decisions. The evaluation was carried out by a group of students (10 persons) and post-graduates (4 persons) simultaneously in Munich and in Karlsruhe, during March/April 2001. The technical support, in particular the digitization of the questionnaire and the establishment of the database, were furnished by staff members of the Institute for Information Law at the Technical University of Karlsruhe (chaired by Prof. Thomas Dreier).

Following instructions concerning the objectives and structure of the UDRP as well as the aim of the study, each

participant was given the task to evaluate 50 decisions on the basis of a scheme set out in a questionnaire which is published in the annex to this study. In contrast to the method employed in the Stockholm group, the participants in the Munich/Karlsruhe project were not allowed to pre-select the cases they evaluated^[8], but they were told to take up for evaluation 50 subsequent cases. In order to avoid overlap, each participant was attributed a certain Provider as well as the number of the case they should start with.

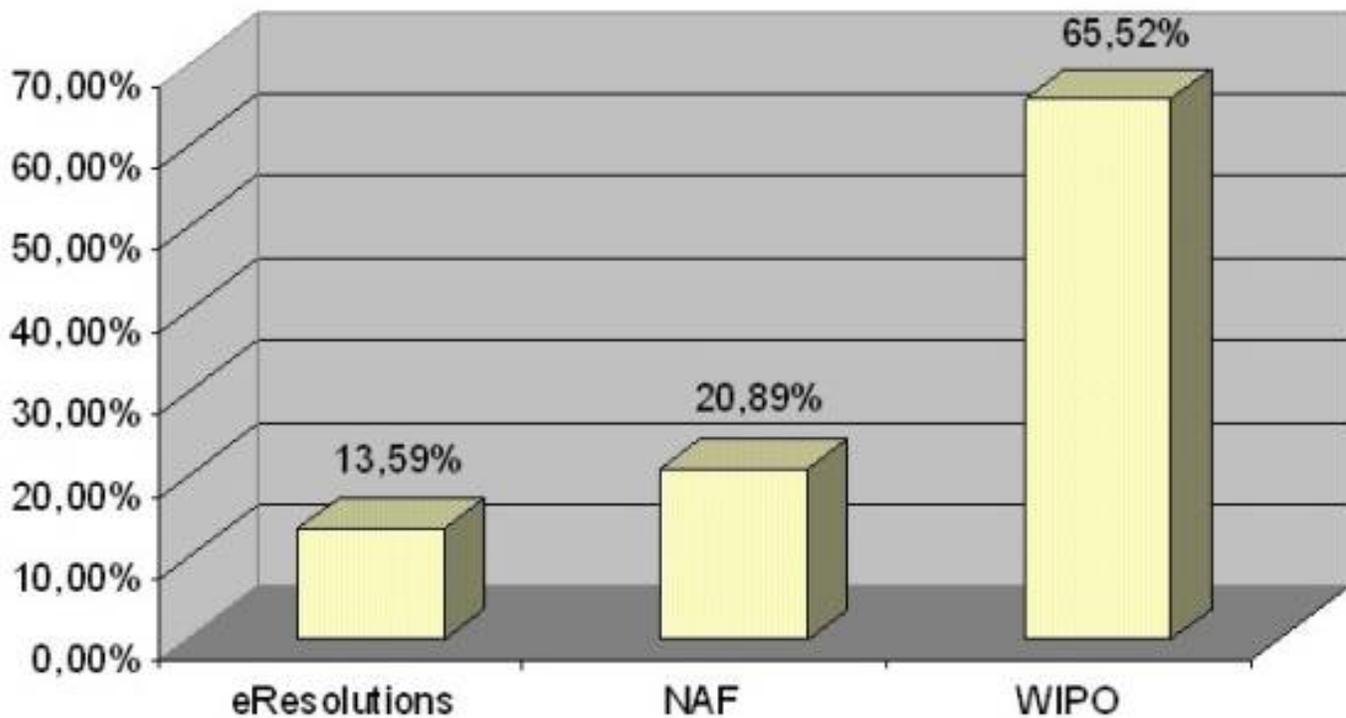
The query was conducted on-line, i.e. the results of the evaluation were entered directly into the questionnaire which was posted and secured by password on the homepage of the Technical University of Karlsruhe. After the evaluation phase was completed, a final round of discussions was held in May 2001 with each group in order to capture their personal impression and opinions in addition to the computed results.

2. [Results](#)

2.1 [Number of Cases Appraised; Distribution Among Providers](#)

The evaluation comprises 700 cases, i.e roughly a fourth of the decisions handed down by April 2001. Of the four ICANN-accredited Providers, only the three major ones, namely eResolutions, NAF and WIPO have been included in the survey. Of the total number of decisions appraised, 95 (13.95 %) were from eResolutions, 146 (20.89 %) were from NAF, and 458 (65.52 %) were from WIPO.

Appraised results (in percent)



This means that the study does not represent a statistically correct picture in respect of the distribution of cases between the three Providers, as the percentages for both eResolutions and WIPO exceed their actual "market share" [\[9\]](#). The background for this is that the aim of this study was not so much to investigate general developments in respect of the use being made of the UDRP, which would have

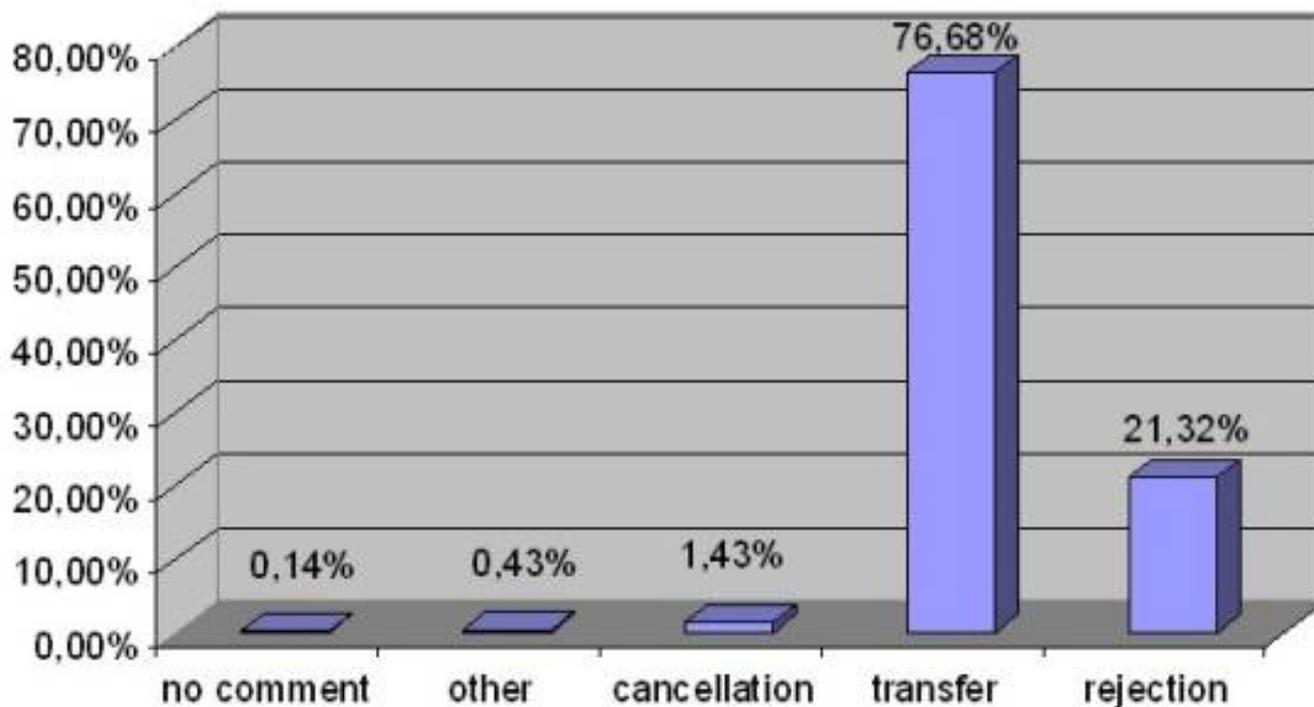
included the aspect of "market share", but rather to find out more about the substantive aspects of the decisions – whether the system was functioning in a fair and satisfactory manner. Before this background, and with special regard to information concerning the statistically significant differences in the outcome of decisions handed down by eResolutions on one hand and WIPO and NAF on the other, it seemed more important to include a major number of cases (approx. hundred) from eResolutions than to limit them in accordance with their actual percentage. That instead of dividing the remaining roughly 600 cases in the correct proportion between WIPO and NAF, the WIPO decisions were given a much broader covering, is due to the consideration that the WIPO material assumingly offers a wider variety of nationalities involved on both sides of the conflict as well as acting as Panels, and therefore might furnish a more

representative picture when it comes to evaluating the functioning of UDRP for the US as well as for the non-American part of the world.

2.2 [The Outcome \(General\)](#)

Of all the decisions included in the evaluation, transfer of the domain name was ordered in 76.68 % of all decisions, whereas cancellation was claimed and granted in 1.43 %. In 21.32 %, the claim was rejected in the decision[10].

All results (digit 7 of survey)

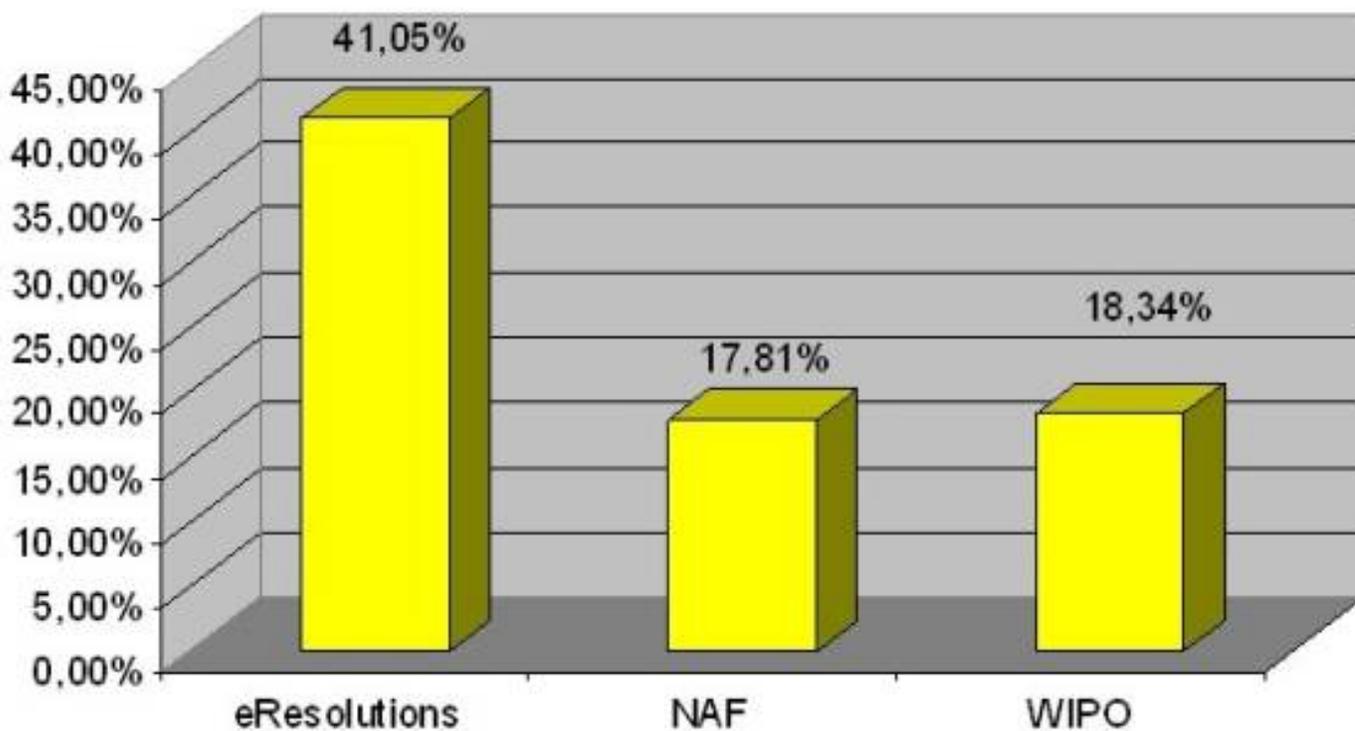


These figures – in particular the relatively high percentage of transfers – may appear astonishing, not least in view of the fact that e.g. according to the WIPO statistics, transfer was (only) ordered in 64.4 % of the cases, and that

the corresponding figure can be expected to be even lower for eResolutions. The explanation for this is that the study in contrast to the WIPO statistics does not take into account those cases which were withdrawn before a decision was made – only decisions were included in the questionnaire. On the same computing basis, the percentage of decisions where transfer was ordered would be some 80 % for WIPO, and approximately 77 % in the overall statistics of ICANN. This shows that the results found in the study are in principal compliance with the statistical material compiled by the relevant institutions themselves.

The same applies when the total of decisions rendered in favour of the respondent are broken down per Provider. Very similar percentages are shown for WIPO and NAF – 18.34 % and 17.81 % respectively – while eResolutions figures with a significantly higher percentage of decisions in favor of the respondent, namely 41.05 %. Again, due to the fact that withdrawals were not counted, the figures are higher than those indicated in the official statistics e.g. by WIPO (14.8%). Apart from this, the figures confirm what has been pointed out in previous studies, namely that the relation between decisions in favor of complainant and decisions rejecting those claims this more or less the same for WIPO and NAF – with more than two thirds of decisions in favor of complainant – whereas the balance is significantly more favorable for the respondent in respect of eResolutions.

Rejections per provider



Another aspect of a more general nature investigated in the course of the study concerned the number of decisions handed down by a sole Panel in comparison to a full panel. It is no surprise that the large majority of cases (81.97 %) were decided by a sole Panel, whereas a full panel answers for the decision in 17.17 %.

As it can be expected that the more cumbersome and costly procedure of trial by a full panel is mostly invoked in cases which are not very clear and therefore more often than usual might fall out of the scope of decisions to be made in the framework of the UDRP, it was also of interest to find out whether complainant's claim was rejected more often by a full panel than by a sole Panel. The survey shows that there is in fact a difference, although not as significant as one might have expected: Full panels were responsible for 22.82 % of the decisions finding in favor of the respondent, which clearly but somewhat modestly surpasses their share of 17.17 % in decision-making at large.

2.3 [Specific Results](#)

2.3.1 [Issues Concerning Art. 4 a \(i\)](#)

2.3.1.1 [Complainant's Right](#)

In order to challenge the registration of a domain name under the UDRP, the complainant must have rights in a "trademark or service mark". Whereas this formulation doubtlessly pertains to marks which have been registered as such, it is less clear whether it is also meant to comprise other kinds of designations which in practice fulfill the function of identifying and distinguishing the (commercial) origin of goods or services. These doubts are supported to some extent by the legislative history of the UDRP. Whereas it was recommended in the WIPO Interim Report of February 1999 that the Administrative Dispute Resolution should comprise all kinds of rights, its scope was deliberately narrowed down in the Final Report to trademarks only, with a view to the fact that the Policy should only become operative in clear piracy cases where the factual and legal situation did not pose any problems.

However, the Policy does not expressly exclude the possibility that complaints are based on rights which have not been registered, as long as it is possible to claim legal protection under the title of trademark rights. Complaints founded on unregistered rights have been accepted without much discussion in two rather early decisions, AF-0096 (tourplan.com) and in FA 93633 (BuyPC.com). The issue was considered in detail – with the same result – e.g. in AF-0250 (jobpostings.com). Protection for personal names, which are not registered as marks, was first claimed in D2000-0235 (jeannettewinterson.com), and shortly thereafter in D2000-0210 – (juliaroberts.com). The Panel in the first case applied British law in order to assess whether the complainant did have trade mark rights in her name, and the result was positive. Further decisions have taken the same approach, mostly without expressly discussing the law to be applied in the assessment.

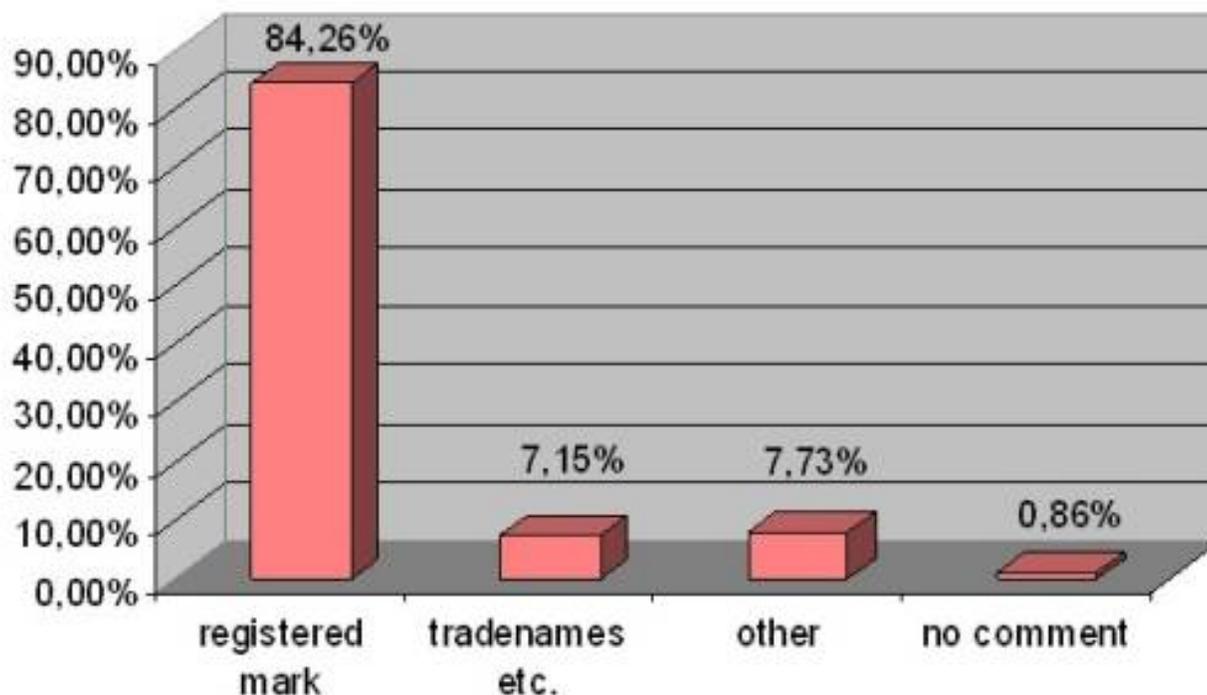
The only major exemption from this scheme appears to be the decision D 2000-0596 (sting.com), where the complaint was denied mostly because the word "sting", in addition to denoting the well-known artist, also is a generic term in the English language and is used in a number of different occasions in the Internet. Similar argumentation was invoked by the Respondent in D2000-0847 – madonna.com, however without winning the acceptance of the panel.

Also geographical names have been invoked as the basis for protection under the Policy, e.g. in D2000-050 (barcelona.com). This issue is however more controversial than the case of personal names and other unregistered rights. The conditions under which such complaints can be granted under the present Policy[11] are somewhat unclear[12].

The study attempts to quantify the relation between cases where a registered mark has formed the basis for the complaint, and where other types of rights have been involved (Q 1[13]). In this respect, one problem was posed by the fact that the concept of a "common law trademark" is unknown in the German legal system and had to be transposed into terms which are more suitable for German terminology. The questionnaire (in the original German form) thus makes reference to "geschäftliche Bezeichnungen", which comprises all kinds of distinctive signs – in particular tradenames etc. – which are protected (in Germany) under trademark law, and to "other rights", a category which was meant to comprise personal names and geographical indications.

The result shows a clear preponderance of cases where the complaint was based on a registered trademark right (84.26 %)[14]. This leaves 15 % for decisions where the complaint did not have such a clear and secure basis, divided equally between "geschäftliche Bezeichnungen" (trade names etc.) and others, e.g. personal names and geographical indications. This means that although these cases are by far outnumbered by cases involving registered marks, the number of decisions involving other rights at least is no *quantité négligable*.

complainant's right



A

more detailed analysis of the decisions where the complainant was not able to base its request on a registered trademark right shows that unregistered marks were involved in 19 cases; in one case, the right invoked was the name of a religious non-profit corporation (AF-0188 - christusrex.com). Personal names were invoked in 11 cases.

These were the following: AF-030a, b (Anne Mclellan), D 2000-1256 (Bernardo Neustadt), D 2000-0210 (Julia Roberts), D 2000-0235 (Jeannette Winterson), D 2000-0402 (Steven Rattner), D-0658 (Nik Carter), D 2000-0661 (Philip Berber), D 2000-1415 (Nicole Kidman), D 2000-1459 (David Gilmour), D 2000-1221 (Cliff Greenhouse, Keith Greenhouse – only part of the complaint was based on name rights)[15]. In one case, D2000-1234 (icet.com), the domain name was held to correspond to the name "Ice-T" under which the artist Tracy Marrow had become popular. In all of these decisions, transfer was granted. Geographical names (one in combination with a collective mark[16]) formed the basis of the complaint in five cases. In three of these – AF 0267, a,b (Bamberg.com, Bamberg.net); AF 0202 (huangshan.com) and FA 96347 – (berkeleysprings.org etc.), the complaint was denied because the complainants were not able to assert rights in the name at stake. In another decision, D2000-1435 (capeharbour.com), the Panel did not challenge the assertion that the complainant company owned common law trade mark rights in the designation, but the use made of the domain name by the respondent was not found to be illegitimate[17]. Further decisions had to deal with the question of whether registration of a domain name gives rise to demonstrable rights under the Policy; this was denied in AF-0273 myespace.com).

In D2000-0261 (frankwagnerandson.com, etc.) the Panel rejected the complaint with expressions of regret, because the complainant did not *"allege evidence sufficient to show that it owns a trade or service mark similar or confusingly similar to the Domain Names. It has alleged a trade name, a logo and a slogan, but it has not provided any evidence that any of these phrases are being used as a trade or service mark, that is, as a name of a particular product or service."* As the Panel felt itself bound to the narrow and specific wording of Paragraph 4 a (i) of the Policy, it could not order transfer of the domain names at stake, although it held that the registration had been taken out in bad faith.

Further cases in which the complaint was denied because the complainant could not establish a valid right in the name included the following: AF-0162 (2ecorp.com), AF-0169 (qtrade.com), AF-0190 (oscarnet.com), D2000-1205 (usatodaysports.com, usatodayweather.com), D2000-1601 (goldfm.com), FA 96271 (supportsock.com); see also D2000-1014 (tuxedo4u.com).

2.3.1.2 [Degree of Similarity](#)

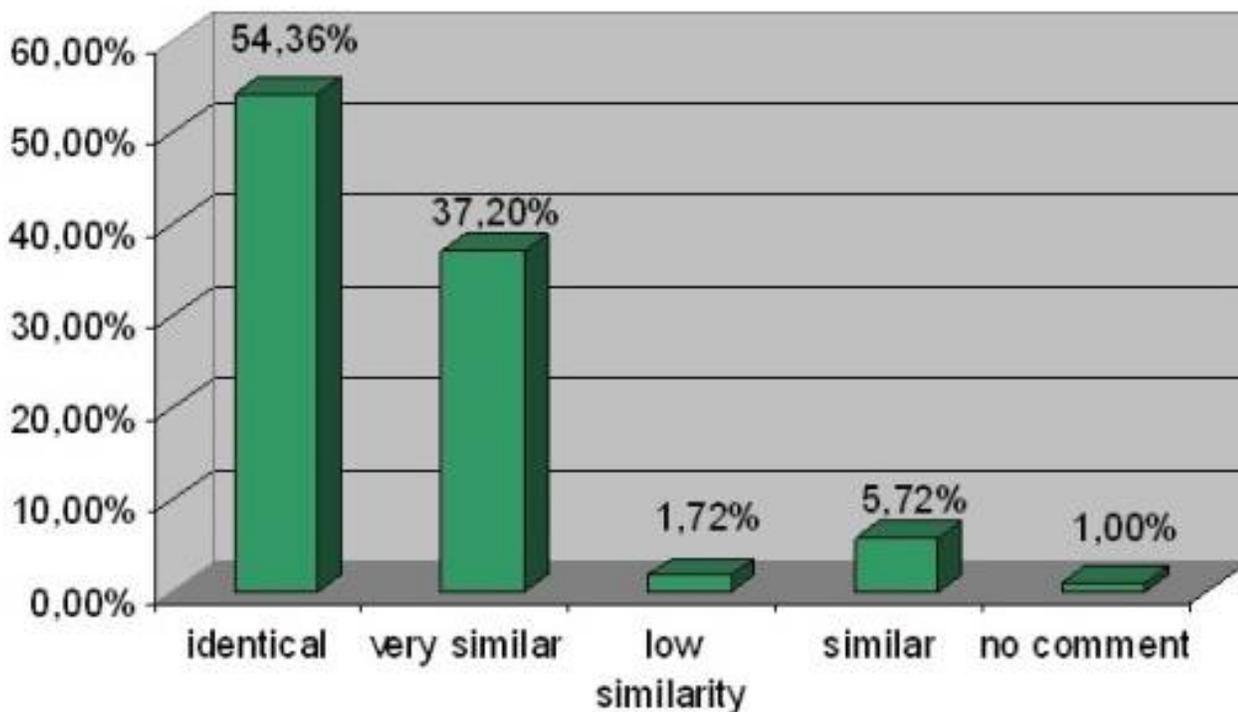
In order to present a case under the UDRP, the challenged domain name must be identical or confusingly similar with the rightholder's mark. In traditional trademark law, the idea underlying the concept of confusing similarity is that customers should not be exposed to the risk that they walk out of the shop with product X although what they wanted to buy was in reality product Y. That kind of risk very seldom occurs in cyberspace. When someone reaches a "wrong" homepage, this is typically realized immediately, and if the person does not want to stay on for specific reasons, the site is left with one click (unless the "back"-button has been deactivated, which seems to happen ever more frequently). In any case, the initial error will hardly persist until someone actually makes a purchase.

On the basis of this consideration, it could be argued that domain names never give rise to a risk of confusion in the meaning of trademark law. This argument was indeed frequently used in the early times of domain name conflicts, and it could still be encountered in some of the cases under consideration here. There is however general

agreement, supported by abundant case law from a large number of countries in the world, that this argument is not a viable excuse. Instead, it is widely accepted that a domain name is confusingly similar in the meaning of trademark law when the impression is created that it resolves to a website operated or sponsored by the rightholder, before and without taking into account the actual content of the site[18]. Therefore, even if disclaimers are included on the website which direct visitors to the true site of the trademark owner, this will typically not be taken into account when assessing confusing similarity in the meaning of the Policy[19]. But although the legal basis as such is uncontroversial, it may still be difficult to draw the exact borderlines of the concept, i.e. to find out under which circumstances confusing similarity will be denied.

In the survey, an attempt was made to qualify the degree of similarity between mark and domain name according to four given categories: Identity, high similarity, (middle) similarity and low similarity. The assessment should reflect the view of the Panel, if expressly stated. Otherwise, the participants should state their own view.

degree of similarity



In the majority of decisions, the complainant's sign and the domain name were held to be identical (54.36 %). In accordance with the practice commonly applied in the UDRP, this means that the second level domain was totally congruent with the trademark or sign on which the complaint was based, without taking into account the TLD which is regularly added to the name[20]. The next category, high similarity, was meant to cover those cases where only minor deviations existed between the mark and the second level domain, as in D2000-0430 (luisvuitton.com), whereas cases where e.g. the addition of longer suffixes made the domain name clearly distinguishable from the mark, as in D2001-0026 (concerning the mark Guinness in several variations and combinations), or abbreviations which, in combination with additional letters, at least at first glance create an impression which is different from the trademark as such (as e.g. in nynbc.com) were meant to be marked as "similar". However, a closer review of the cases which have been entered in those categories reveals that the

participants have obviously found it difficult to separate the two categories from each other, and that in case of doubt, they have preferred the first category. For instance, a good part of the notorious cases where mass registrations have been taken out – e.g. the Harry Potter cases, D2000-1245 – were entered into the "very similar" category, although they typically also comprise variations of the protected mark which are clearly distinguishable[21]. The relevance of the figures indicated for each category – 37.20 % for "very similar" and 5.72 % for "similar" – should therefore not be overestimated. However, it remains obvious that in the large majority of cases, the challenged domain name bears a clear, unmistakable resemblance to the protected sign.

The last category, "low similarity", was only chosen in 1.72 % of the decisions, corresponding to an absolute figure of 12[22]. Upon closer review of those cases, it shows that if the Panels have denied confusing similarity between the domain name and the sign, this was due in the majority of cases to other factors than the actual differences between the designations in question. In four cases, the finding was motivated by the fact that the complainant did not have a demonstrable right in the sign. This concerned the decisions AF-0169 (qtrade.com), AF-0190 (oscarnet.com), AF-0202 (huangshan.com) and D2000-1601 (goldfm.com)[23]. In four cases, respondent's use of the domain name was justified for other grounds, or it was found that the conflict resulted from internal problems between the parties which could not be resolved in the framework of the UDRP; see D2000-058 (ahmanson.org), AF-0249 (sampati.com), FA 94943 (go-to-sandals.com, sandals-all-inclusive.com) and AF-0162 (2ecorp.com). The similarity between a mark and a domain name adding the suffix –sucks to it was discussed and denied D2000-1015 (lockheedsucks.com)[24]. In another case, D2000-0417 (copart.net), similarity existed rather between that domain name and the domain name having been registered by the complainant (copart.com) than between the domain name and the trademark used by complainant (CI Copart Inc. Salvage Auto Auctions), and therefore the complaint was denied. Only one case, D2000-0264 (eresmas.com, .org and .net), dealt with similarity in the usual manner of "real world" trademark law, i.e. comparing the likeness in spelling as well as in meaning[25] of the two designations (esmas/eresmas), and denying confusing similarity.

Other cases were not included in the category of "low similarity", although the Panels wholly or partly denied confusing similarity in their findings. One concerned the domain names maclaneneast.com and maclaneneastsucks.com (D2000-1455). The Panel, citing US case law[26], argued in the same vein as the Lockheed decision mentioned above, namely that no-one would assume that a "-sucks" site is operated by the holder of the mark in question[27]. In respect of the other domain name, the Panel found that the complainant had failed to sufficiently establish its rights to the designation in question, and that it was therefore not possible to come to a positive conclusion as regards its identity or confusing similarity with the domain name. Confusing similarity was further denied in AF-0107 b between the complainant's mark "Kittinger" and the domain name "kittingercollector.com".[28]

Another case concerned the registration of a substantial number of variations of the National Collegiate Athletic Association's trademark (ncaamensbasketball.com etc.). Only some of the domain names registered were ordered to be transferred to the complainant. The claim was denied in respect of 11 domain names on the ground that they referred, in one way or other, to betting and gambling. The Panel held that *given the NCAA's strong opposition to gambling, it is less likely that these names could lead to any confusion. Instead these names appear to be a descriptive use of the NCAA mark to indicate sites that provide access to information on gambling on NCAA games. Thus the NCAA has not met its burden of proving that names 21-32 listed below are identical or confusingly similar to the NCAA trademark?*

Finally, in FA 94964 (quirkchevrolet.com etc.), the Panel found that although the domain names registered by complainant, while identical to the trademark since they all contained the "Quirk" mark, were not confusingly similar ²since a reasonable person viewing the Respondents website would conclude that it was a consumers affairs website and not offering goods and services for sale².

Notwithstanding the pre-cited decisions, it seems to be a rare exemption that a complaint is rejected for non-compliance with the similarity criterion in 4 a (i) of the Policy. This does however not mean that Panels do not take the issue into account in their decisions – to the contrary, it is often discussed at some length, but the outcome is practically always positive. Another telling example for this approach can be found in the decision D2000-0404 Institute Straumann AG v. Core-Vent Corporation, concerning the domain name "straumann-clone.com". The respondent in this case was, in the words of the complainant, "a competitor in the field of dental and maxillo-cranio-facial implantology", and asserted that he had chosen the domain name because "clone" indicates "the sale of similar, compatible or outright copies of another product". After citing inter alia section 1207 of the USPTO Manual of Trademark Examining Procedures as well as Kerly's Law of Trade Marks and Trade Names (12th ed.) at pp. 445, the Panel concluded that it was "satisfied that the principal and dominant element of the said domain name viz the word <straumann> is identical to the Complainant's trademarks and that overall the said domain name is confusingly similar to the Complainant's trademarks".

When reviewing the published decisions, there is indeed little doubt that the domain names in question regularly are, at least in their non-descriptive or -generic part, congruent with or very similar to the right claimed by the complainant. In that respect, the findings in the survey are supported by appearance. In many of these cases, the variations added simply indicate a geographic area or make reference to the articles usually sold under the mark, which might intensify the misleading effect instead of dispelling it. Others consist of variations corresponding to typical typing mistakes (e.g. D2000-0554: hotmaill.com, otmal.com, homail.com, hotmai.com) which can be taken as indicating that the registration was taken out with the intent to profit from errors made by the person entering the name in the browser^[29]. That confusing similarity is found in those cases, which account for the large majority of decisions, can therefore hardly be regarded as problematic.

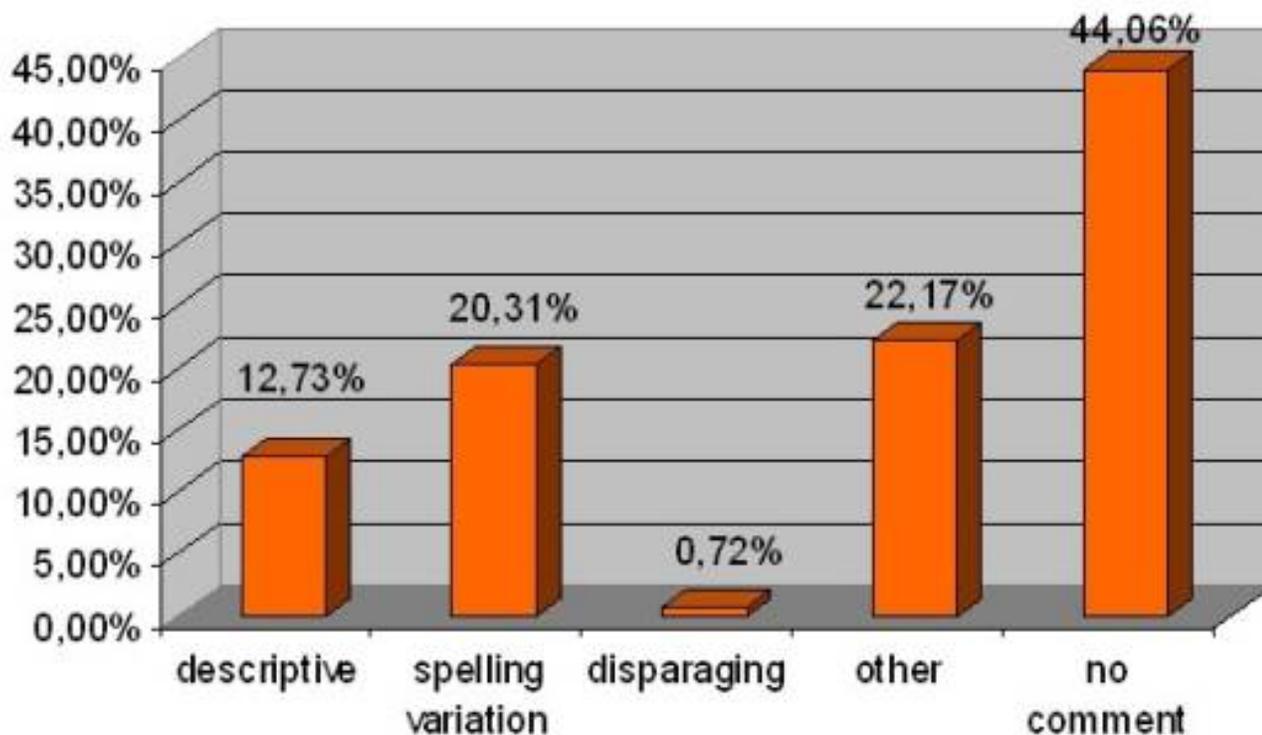
Nevertheless, there are certain inconsistencies in the assessment of the similarity issue where the Policy might need some clarification. One obvious example are the "-sucks" cases, which have been qualified as not giving rise to actual confusion by courts as well as by some Panels, whereas in most other cases, they have been deemed as falling under Art. 4 (a) (i). Similar questions have arisen in the NCAA case, which was cited above. The problem is further illustrated by the ²sandals² cases, a number of which were included in the survey: whereas in the decision cited above (FA 94943), confusing similarity was denied on the ground that the mark was used in combination with distinguishing suffixes, other, parallel decisions concerning the same mark have submitted that the mark and the domain names were confusingly similar as a matter of principle – the case then turning on the question whether the registrant could be regarded as being entitled to make use of the mark in the relevant manner. We shall come back to these issues at the end of this paper.

2.3.1.3 [Kind of Similarity](#)

As was pointed out in the previous paragraph, it occurs quite frequently that domainnames are construed in a manner which paraphrases a – typically well-known – mark by adding descriptive or other suffixes or prefixes. Q

2 b) in the questionnaire tries to find out how frequently these cases occur in comparison to likeness caused by spelling variations without specific meaning. Furthermore, if the case concerned a mark plus suffix or prefix, the participants were asked to state whether the part added was (geographically or otherwise) descriptive, disparaging, or of a still different kind ("other").

kind of similarity



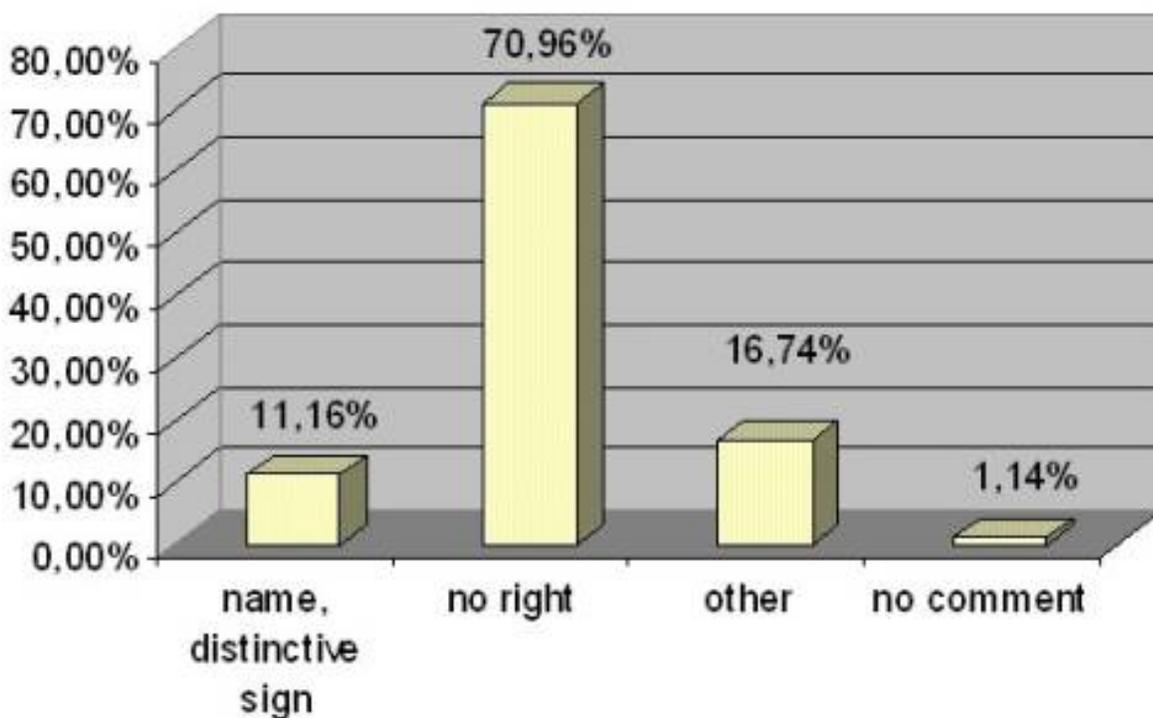
In this respect, the participants were expected to make an independent assessment of the issue, all the more because this is a question which is seldom expressly addressed by the Panel in the decision. The results can be taken as an indication that the participants themselves found it rather difficult to find a clear answer to the question. The percentage of non-answers ("no comment") is extraordinarily high in comparison to the other questions (44.06 %) [30]. Also in respect of the prefix-suffix cases, the highest percentage of answers can be found in the unspecified category ("other"; 22.17 %). Still, to some extent the answers can be taken as a confirmation of the expectation that domain name conflicts more often involve variations of trademarks by addition of suffixes and prefixes than by mere differences in spelling. The relevant figures are 20.31 % (spelling variations) compared to 35.62 % for cases involving prefixes and suffixes.

As regards the cases where the suffix/prefix was of a disparaging character (the "sucks"-cases), it has been pointed out already above that this has played a role only in very few cases, namely, D2000-0636 (natwestsucks.com), D2000-1015 (lockheedsucks.com, lockheedmartinsucks.com), and D2000-1455 (*inter alia*: mclaneneastestsucks.com). It was also pointed out already that the outcome has been different: the claim for transfer of the domain name was granted in the first-mentioned case [31], whereas the Panels in two other decisions dismissed the complaint for lack of confusing similarity.

2.3.2 [Issues Concerning Paragraph 4 a \(ii\), 4 c](#)2.3.2.1 [Respondent's Rights and Legitimate Interests](#)2.3.2.1.1 [General Remarks](#)

Even if a domain name is identical or confusingly similar with a trademark held by the complainant, the complaint will be denied if the respondent can rely on a right of his/her own or on a legitimate interest to use the sign, as is set out in more detail in Paragraph 4 c. In the survey, an attempt was made to quantify the cases in which the respondent did invoke own property rights in the sign in question, and to measure the success of such allegations.

respondent's right

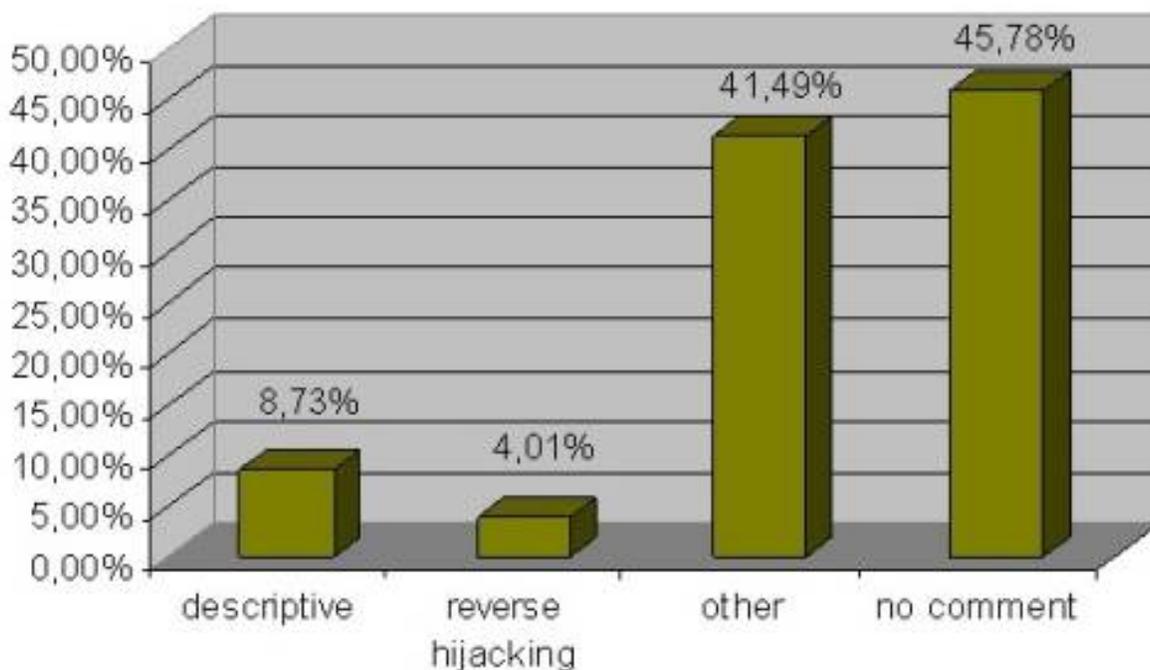


The answers given to the question regarding the right (possibly) claimed by the respondent (Q 3) show that in the large majority of cases, no such claims were made (70.96 %) [32]. Of the remaining 27.9 %, rights in personal names or distinctive signs were claimed by respondents in 11.16 % of the decisions, while the larger half (16.74 %) concerned unspecified rights and legitimate interests. When broken down according to the final result, it shows that in 56.41 % of all cases where the respondent has invoked a right and/or another legitimate interest to use the domain name, the complaint was still successful, i.e. transfer or cancellation of the domain name were ordered.

The figure varies when the two categories "own right"/"other legal interests" are considered separately: when property rights are invoked by the respondent, the complaint is denied in the majority of cases (56 %), whereas only 38.46 % of complaints are rejected in the second category. This difference appears quite significant. Another difference exists in respect of cases decided by WIPO Panels and by Panels operating under other Providers: the percentage of rejections is considerably lower in the WIPO panels (40.63 %) than for NAF (54.29 %) and eResolutions (63.64 %).

Another question (Q 6) attempted to investigate which defenses were invoked by respondents other than to claim a right of their own. In particular, the question sought to identify cases where the respondent made use of the argument that the mark was at the same time a descriptive term (possibly in another language) and should be free for use in that capacity. Furthermore, the participants were requested to indicate the cases where the respondent had raised the issue of reverse domain hijacking.

defenses



Again, the answers to this question resolve to relatively high figures in the unspecified categories, i.e. "other" (41.49 %) and "no comment" (45.78 %). Of the rather small percentage (12.74 %) of specified answers, a clear majority (8.73 %) relates to the allegedly descriptive character of the domain name, whereas it was indicated in 4.01% of the decisions that the issue of reverse domain hijacking had been raised (for a detailed analysis of these cases see *infra*, 2.3.2.2).

When broken down into results per Provider, it shows that WIPO Panels are more likely to grant complaints in cases where the respondent has alleged descriptiveness of the mark. The figures according to the evaluation are as

follows: WIPO: complaint granted in 30 of 47 cases; NAF: complaint granted in 4 of 10 cases; eResolutions: complaint granted in 3 of 5 cases. However, as the total figures are so small, and as the evaluation also in this respect may not be free from mistakes, the relevance of these figures must be viewed with some caution.

It is submitted that a considerable percentage of the unspecified answers relates to cases where the respondent did not make any allegations at all, i.e. where the respondent was in default. A separate analysis was undertaken in order to investigate the issue, which had not been the object of a specific question[33]. The results of that analysis will be presented below.

A closer examination of the answers given to the specified answers show that the distinction between "own right" and "other" (including other legitimate interests) has not been observed very strictly. Furthermore, there is a certain overlap between answers given to Q 3 and Q 6, as in a number of cases the answers have been cumulated (e.g. "other" in Q 3 and "descriptive" in Q 6). The same also concerns the cases where reverse hijacking has been averted. In most of these cases, the answers "own right" or "other" in Q 3 have been combined with "descriptive" and/or "reverse hijacking" in Q 6. Instead of considering separately the different categories of answers specified in the catalogue, the following review will therefore undertake a more general analysis, departing from the illustrative catalogue set out in Paragraph 4 c of the Policy. It is noted beforehand that the assessment of the respondent making legitimate use of the domain name is very closely intertwined with the issue of bad faith, which will however be treated in a separate paragraph.

2.3.2.1.2 Respondent is the Owner of an Independent Right

As the Policy was enacted with the purpose to grant relief against abusive registration, it is clearly not meant to resolve cases where different persons or entities can claim bona fide rights to the same name or abbreviation (acronym). Decisions where the complaint was rejected on that ground include inter alia: D2000-0046 (avnet.net; the respondent doing business under the name Aviation Network Inc.), D2000-1257 (cellcontrol.org and -net, the name having been used previously for software developed by respondent); AF-0121 (launchpad.com, the name having been respondent's long-standing business name); AF-0205 (whiskeyagogo.com; the name corresponding to a trademark owned by respondent in Canada), AF-0213 (canbest.com; the respondent doing business as Canada's Best in a totally different field of business from the complainant); FA 94947 (parachute.com; the respondent operating under the company name of Parachute Computer Services), D2000-0008 (sixnet.com; the respondent having been doing business under @sixnet); see also D2000-1014 (rockbottom.com), where the respondent relied on the name which had been acquired by his predecessor[34]. Another case to be mentioned in this context is D2000-0410 (scientologie.org), where the respondent was able to rely on the right to publish a book under the title. Prior bona fide use of the domain name was further successfully contended in e.g. D2000-1052 (usavideo.com), D2000-0047 (eautolamps.com) and D2000-0100 (highclass.com)[35].

If the Panel comes however to the conclusion that the name under which the respondent has been doing business before registering the domain name or before having been notified of the conflict was chosen, or that the mark was acquired, with full knowledge of the complainant's rights, in order to furnish a formal basis for registration of the corresponding domain name, the respondent normally loses. See e.g. AF-0160 (computerfutures.com), FA 96333 (koalawebdesign.com), D2000-631 (sunfest.com), D2000-810 (topicq.com, ticq.com), D2000-423 (telstrashop.com) and two cases involving the mark yahoo!, D2000-428 (yahoocommerce.net, yahoofree.net, -com,

yahoochat.net) and D2001-0051 (yahooasian.com, -.net, yahoo-asian.com, -.net), where the respondent also contended inter alia that yahoo was a descriptive term, and that there was no confusing similarity, because the respondent had not used the characteristic "!" in its registration.

It is not unusual that in a case when the respondent contends that the right to use the domain name is based on a right of his own, the underlying facts are highly disputed between the parties. In that situation, it is frequently pointed out in the decisions that the conflict cannot be resolved and should not be brought before a Panel under the Policy, especially if it involves complex issues, typically concerning the previous relationship between the parties, which should rather be litigated in court. This principle was expressed very clearly in e.g. AF-0209 a, b (quarterview.com; chatpop.com) and D2000-0638 (manchesterairport.com), see also D2000-0040 (phonenphone.com) and AF-0162 (2corp.com)[\[36\]](#).

If the situation has already been under review by a court, the outcome must be respected also in the framework of the UDRP. For instance, in D2000-0230 (euro2000.com), the Panel noted that according to a prior court decision, respondent's use of the name in question could not be objected at least insofar as Europe was concerned, and consequently, the complaint was rejected.

2.3.2.1.3 [Respondent is Authorised by or Has Other Links With the Right Holder](#)

If the respondent is an authorised dealer or otherwise has established links with the complainant, this may be regarded as constituting a right or legitimate interest under the Policy, see e.g. AF 02000 (resqdisc.com); D2000-0268 (cellulone.net); D2000-0005 (telaxis.com); D2000-0006 (militec.com); D2000-0017 (drawtite.com); FA 94960 (grobert.com); FA 96318 (turbonetics.com), see also FA 94944 (sandalsbest.com, sandalsoutlet.com, sandalsoutletstore.com, sandalshoneymoon.com, sandalsweddings.com, 2sandals.com, sandalsjamaica.net, sandals.org, sandalsresorts.net). Again, if in these cases the parties quarrel about the validity and/or scope of the authorisation, this is usually not considered to be an issue which can be resolved in the framework of the UDRP. Exempted from this rule are cases where it is undisputed or otherwise obvious that the respondent did not act on the basis of a valid authorisation or other kind of contractual relationship, such as e.g. in D2000-1079 (imperialcollege.com); see also FA 96376 (alennutrition.com, alenfood.com, alenusa.com, alenusa.net), where the agreement between the parties had been terminated, and the Panel held that the respondent had no rights *to solicit orders for complainant's products he has no rights to sell*².

That the right to sell a product may furnish a sufficient ground for use of the mark in a domain name was held in D2000-0819 (usacanon.com, astrocanon.com, canonastro.com, canoncopymachines.com). The Panel ordered in respect of the first three domain names that they be transferred to the complainants, Canon U.S.A. Inc., Astro Business Solutions, Inc. and Canon Information Systems, Inc. However, a different conclusion was reached with respect to the domain name *2*canoncopymachines.com², which was the only one being in active use. The Panel concluded that *2*Respondent's use of the 'Canon' mark falls within paragraph 4(c)(iii) of the Policy. Respondent has the right, at least under U.S. trademark law, to refer to the marks of others as a means to identify the types of products it services or sells².

Similarly, in AF-0107 a,b and AF-0108 a,b the respondent, who had been in the business of selling used Kittinger

furniture for some time and had become known under the name Kittinger Collector, was found to have a legitimate interest not only in registering and using but also in keeping the domain names ²kittingercollector.com² (which was found to be not even confusingly similar to complainant's Kittinger mark), kittinger.com, kittenger.com and kittengerfurniture.com.

2.3.2.1.4 [Authorisation From Third Parties](#)

In another group of cases, respondents have tried to argue that their rights or legitimate interests in the domain name are derived from persons actually bearing the name. In most cases, this attempt has been unsuccessful^[37]; see e.g. D2000-1235 (hammondsuddards.com), D 2000-402 (stevenrattner.com) – the registration said to have been taken out for a friend bearing that name –, D 2000-436 (jimthompsonhouse.com) – the respondent declaring that Jim Thompson had been a friend of the family, and D2000-0827 (betwilliamhill.com) – the respondent allegedly owning a license from a client acting under that name. Transfer was also ordered in D 2000-0853 (saradar.com), where the facts suggested that respondents had "hired" the person bearing the name only for the purpose to grant them a license to register.

2.3.2.1.5 [Business Plans](#)

Another argument to establish legitimate interests in case that the respondent cannot rely on a right of his or her own concerns the development of a plausible, bona fide business plan involving the domain name. It is obvious that the success of the argumentation essentially depends on the credibility of the explanation given by the respondent, i.e. whether plausible reasons existed to choose the name – which normally requires that the name is descriptive of some sort, and that it is not clearly associated with a famous mark or company name – and that the respondent has engaged in preparation for the implementation of its plan, or that it can give credulous explanations for the delay. Decisions where the issue was considered with a positive outcome for respondent include the following: D2000-0223 (countryhome.com), D2000-0806 (eplan.com, e-plan.com), D2000-1001 (pi.com), D2000-1403 (financialreview.com), FA 94976 (Golfsociety.com), FA 93553 (usource.net); AF-0186 (dinabase.com), AF-0104 (thyme.com). These cases all involved a plan to establish a network of sites featuring information on specific topics. A legitimate interest of the respondent to acquire domain names for that purpose was acknowledged *inter alia* in D2001-0001 and D2001-0002 (portofhelsinki.com and portofhamina.com, said to have been acquired for the purpose to establish www.portof.com, an information network on harbours); see further D2000-0617 (stmoritz.com), D2000-0407.com (cityutilities.com), D2001-607 (vat.com), AF-0249 (sampati.com). Other respondents employing the same or a similar argumentation were however less successful. In D2000-1224 (sydneyoperahouse), the domain name was transferred to the complainant Sydney Opera House Trust in spite of respondent's argument that the building to which the name relates formed part of the global cultural heritage, and that it should be used for building a 'global community network' with other 'generic people's icons'.

The argument that the choice of a domain name featuring a famous trademark was legitimate in view of networking purposes was further denied in D2000-0413 (chanelstore.com, chanel-fashion.com). The respondent had argued that the names were needed to create an Internet directory of authorized designer fashion stores. The Panel held however that it was not ²fair use for Respondent to use Complainant's famous trademark in order to attract the public to the web site². Instead, the respondent should rather use the database it had established at

²DesignerGlobe.com² in order to provide relevant information about the product.

In many other cases, the explanation given by the respondent about the bona fide use it intended to make of the site to be reached under the domain name was not found to be credulous by the Panel, e.g. in D2000-0225 (nandos.com, nandoschicken.com), D2000-648 (pivotalsoftware.com), FA 96300 (b3.org); D2000-1030 (mensa.com), D2000-1054 (the-body-shop-digital.com, bodyshop-digital.com), D2000-1206 (buyasyouview.com)), D2000-0634 (tryg.com), D2000-0645 (tryg-baltica.com), D2000-0405 (lemeridien.com), D2000-1234 (icet.com). In D2000-0461 (corinthians.com), the respondents, at some time which could not be exactly determined, started to post text from the biblical Books (Letters to the Christian Corinthians by Paul) on their website, thereby trying to demonstrate fair use. The Panel found however that the posting did not occur prior to the time when the respondents became aware of the conflict with the Brazilian Football (Soccer) Club which is known under the name, and therefore ordered transfer of the name.

To register and store domain names in order to sell them to the highest bidder or otherwise exploit them commercially is not held to be illegitimate in principle according to the Policy. On the other hand, while being regarded as a generally admissible business practice, it does not give rise to a legitimate interest in the name in the meaning of Art. 4 c. The case therefore turns on the question whether the registration has been taken out in bad faith (for further on that point, see below).

2.3.2.1.6 [Nicknames, Pet Names](#)

In one case included in the survey, the respondent successfully contended that the second level domain in question – Penguin – corresponded to the nickname under which he had been known for many years (D2000-204, penguin.org). In two other cases, it was successfully argued that the name was a dog's name (D 2000-0067, miguard.com; AF-0131, fido.com). In the last-mentioned case, the respondent further pointed out that the name also had a descriptive connotation in the Internet world (fido=find it directly online), and there was no indication of bad faith. The first case, miguard.com, was more critical, and the Panelist admitted that in light of all the circumstances, the case appeared as somewhat suspicious. However, he also noted that suspicion was not enough to justify a finding of transfer under the Policy. Other attempts to motivate the choice of domain names by making reference to pet names have however not been approved by Panels, see e.g. D 2000-0098 (babydior.com. -net), where the respondent declared that *"the proper pronunciation of our domain is "babydyor" for baby dinosaur"*; D2000-0817 (xanax.net) – Xanax allegedly being the name of respondent's "beloved cat", and D2000-0091 (finter.com, -.org) – allegedly referring to a dog named "Ruby der Finter"[\[38\]](#).

2.3.2.1.7 [\(Other Cases of\) Fair Use, Free Speech](#)

If the site to be reached under the domain name is used for noncommercial purposes only[\[39\]](#), the complaint will be regularly denied if it is not apparent from other circumstances that the respondent acted in bad faith. One example for fair, non commercial use can be found in D2000-0097 (avnet.org), where the name had been registered and was used for non-commercial purposes by an organisation referred to as AVNetwork Inc. Non-commercial use plus absence of any indication of bad faith also motivated the finding in D2000-0068

(myinfospace.com). Another interesting case is D2001-0003 (icqplus.org). The respondent contended that he had developed a software product intended for interaction with icq, which was freely available on his website, which also provided for a link to the official icq homepage. He had chosen the name ICQ plus in order to indicate the purpose. He had been advertising the service for more than one year on other websites, like xoom.com, but established his own website under the name in question in consequence of the limitations in rules of such sites, and in aiming to give to consumers more qualitative support. The Panel found in this case that the complainant had failed to establish the requirement that the respondent did not have legitimate rights or interest in the use of the domain name.

In D2000-0034 (2002worldcup.net, 2002worldcup.org, 2006worldcup.org, wc02.com, wc2002.com, worldcup02.net, worldcup02.org, worldcup10.com, worldcup2002.com, worldcup2002.net, worldcup2002.org, worldcup2006, worldcup2010.com, worldcup2010.net, worldcup2010.org), the panel noted that although the use made by respondent of the three first domain names may have been non-commercial, it still failed to be legitimate use, as the contents amounted more or less to a slavish copy of the complainant's (FIFA's) websites.

The question whether and in what manner a company's name or mark may be used in order to establish a complaint site has been the object of several decisions, the results of which appear as somewhat inconsistent. In FA 94964 (quirkchevrolet.com, quirkautos.com, quirkmotors.com, quirkoldsmobile.com, quirkkia.com), registration and use of the names were held to be legitimate, ²since a reasonable person viewing the Respondents website would conclude that it was a consumers affairs website and not offering goods and services for sale", and because its content "consists of constitutionally protected non-commercial materials used in the exercise of Respondent's fundamental rights under the First Amendment of the US Constitution". Also in D2000-0585 (ahmanson.org) and D2000-0859 (ahmansonranch.com, ahmanson-ranch.com) it was held to be fair use to offer a platform for critical comments of the complainant's land development activities under the domain names [40]. Furthermore, in the two "-sucks" cases cited above (lockheedsucks.com, maclanenortheastedsucks.com) where the complaint was rejected, recognition of the right to make critical comments about products or companies played a prominent role, and it supported the finding that the domain names were not confusingly similar with the protected marks in question. Further to be mentioned here is FA 96375 (roboenterprises-litigation.com), where it was found legitimate to use the domain for publication of critical comments on the firm's business conduct towards investors. Given the suffix "-litigation", the Panel might even have come to the conclusion that this was one of the rare cases where in fact the mark and the domain name were not "confusingly similar" in the meaning of the Policy.

Other decisions have however held that the purpose to criticize did not justify the registration and use of a domain name corresponding to the sign in which the complainant holds rights. This was pointed out in D2000-0020 (saint-gobain.net), where the Panel declared inter alia:

²It goes without saying that shareholders or other interested parties have the right to voice opinions, concerns and criticism with respect to a listed company and that the Internet constitutes an ideal vehicle for such activities. The issue at hand is however not as Respondent seems to contend, the freedom of speech and expression but the mere choice of the domain name used to exercise this inalienable freedom of speech and expression... Respondent could have chosen a domain name adequately reflecting both the object and independent nature of its site, as evidenced today in thousands of domain names².

Transfer of the name was further ordered in D2000-0801 (bartlesandjames.com, -net). In that case, the complaint

site under the name was established by a lawfirm which allegedly engaged in a pattern to establish such sites when engaging in a lawsuit against the firm or person in question. The same result was found in D2000-0856 (newyorkpresbyterianhospital.org), where the Panel, in order to motivate its findings, made reference to the two pre-cited decisions[41].

That the purpose to criticise does not justify the registration and use of third parties' marks as a domain name is held to apply all the more in cases when the aims pursued by the respondent are mainly or at least partly of a commercial nature, see e.g. D2000-0071 (csa-canada.com, csa-international.com), where the respondent used the names in order to criticize the complainant, Canadian Standard Authorization, for not certifying an ozone generator developed by him, and to direct viewers to its commercial homepage. In D2000-0636 (natwestsucks.com), the respondent contended that its aim had not been to criticize, but instead to "protect" the complainant against such attempts from other parties, and that it did not have the intention to transfer the name to anyone other than the complainant. However, the Panel concluded that the respondent did not act out of "altruistic motives" (which would have been questionable anyway, because if the allegations had been true, this might have amounted to an attempt to disrupt free speech), but solely in order to sell the name to the complainant, and that it had engaged in a pattern of such conduct. Finally, in D2000-1406 (dixons-online), respondent's allegations that it wanted to establish a consumer's complaint site under the name was not given credit by the Panel, as the respondent did not procure any concrete evidence for its plans.

When a trademark is used in order to establish a fansite, this is usually not held to constitute a legitimate interest in the meaning of Paragraph 4 a ii, see D2000-0222 (dodgeviper.com)[42], D2000-0233 (jordanf1.com), D2000-1459 (davidgilmour.com). While this policy is understandable as a matter of principle, it may raise questions if long-standing, non-commercial use has been made of the site, which had not been opposed by the right holder previously (on this issue see also below, in the context of "bad faith").

An unusual set of circumstances had to be considered by the Panel in D2000-0625 (cultureclub.com). The complainant used the name for a chain of nightclubs, whereas the respondent had registered the name in order to install a website referring to the music group (obviously without being authorised by them). The Panel found that the respondent did not have rights or legitimate interests in the name, but that there was no bad faith with respect to complainant's mark. Consequently, the claim was dismissed.

2.3.1.8 *[Descriptiveness as a General Excuse](#)*

The argument most frequently used by respondents, with or without additional allegations such as being in possession of own rights etc., avers to the descriptive or generic character of the sign in question. As was pointed out before, this argument may support the finding that the respondent had a plausible motivation to use the name for its own – present or future – business, that a right in the name cannot be asserted by the rightholder other than in the area in which he himself is doing business, that there was no reason for the respondent to assume that the name was protected and that he therefore did not act in bad faith, etc. In these cases, the decision very often depends on the assessment of subjective factors – what did the respondent actually know, what were its true motives? – which is made even more complicated by the fact that the possible meanings of a term in different languages have to be taken into account, and that the extent to which an originally generic or descriptive term has acquired secondary meaning, can vary considerably between different countries.

As these issues are typically inseparable also from the assessment of bad faith, which comes under Paragraph 4 a) iii, 4 b) of the Policy, the following account is limited to a simple enumeration, as usual without any claim as to completeness, of decisions where the complaint was denied/granted essentially or at least partly with a view to/in spite of the respondent having alleged the generic or descriptive character of the word. Transfer was ordered e.g. in AF-0218 (peepingmoes.com), AF-0235 (chemco.com), AF-0263 (hotlinecommunications.com), AF-0268 (web2you.com), AF-0275 (globalprintexchange.com), D 2000-0024 (easyjet.net) D2000-0245 (journalnacional.com, globoesporte.com), D2000-0812 (maxnewyorklife.com, newyorklifeindia.com), D2000-1034 (ibopecom; "ibopec" being a Brazilian slang word for fame/successful condition), D2000-0429 (rollerblade.net), homeinteriors.net, homeinteriorsandgifts.net), D2000-0019 (goodfoodguide.net), D2000-0032 (wheatthin.com, wheatsworth.com, bettercheddars.com, harvestcrisps.com, milk-bone.com), D2000-0225 (nandos.com, nandoschicken.com; nandos meaning "we, us" in India), D2000-0416 (fieldofdreams.com), D2000-0431 (bandondunes.com; the word being understood, according to a survey allegedly undertaken by respondent, as "band on dunes"), D2000-0432 (gaygames.com), D2000-0435 (usaolympiconlinestore), D2000-1209 (Kalanjali.com etc.; kalanjali meaning "offering of art"), D2000-0835 (satyam.net, -.org; satyam meaning "truth" in the Sanskrit language).

The complaint was rejected e.g. in FA 96196 (filmnet.com), FA 96271 (supportsock.com[43]), AF 0107aFA 96301 (lifewatch.com), AF-0122 (shopzone.com), AF-0232 (sugoi.com; sugoi being Japanese slang for "awesome"), AF-0212 (tiba.com; being the historic name of the town in which respondent lives); D2000-0426 (tchin-tchin.com), D2000-0078 (m-power.net), D2000-1037 (mymaruti.com; Maruti being the name of a Hindu god[44]), D2000-0844 (worldemergency.com), D2000-1070 (notar.com, -org, being the German word for notary public), D2000-1046 (tuxedo4u[45]), D2000-0629 (parmaham.com), D2001-0050 (mensfitnessespagnol.com), AF-0284 (thelowestfare.com), AF-0262 (travelmichigan.com), FA 96195 (lawcheck.com), FA 93682 (cartoys.net), FA 93547 (concierge.com), D2000-1267 (legeforeningen.com, meaning association of medical doctors in Danish and Norwegian), D2000-655 (countybookshops.com), D2000-0624 (pollyester.com, pollyesters.com[46]). See also AF-0104 (thyme.com), where the Panel noted *inter alia* that "where the domain name and trademark in question are generic – and in particular where they comprise no more than a single, short word, the rights/interests inquiry is more likely to favor the domain name registrant".

2.3.2.2 Reverse Hijacking

In Paragraph 15 of the UDRP Rules, it is stated in the second sentence that "if after considering the submissions the Panel finds that the complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking or was brought primarily to harass the domain-name holder, the Panel shall declare in its decision that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding." The survey attempted to identify the number and outcome of cases in which the issue was raised.

A first overview shows that reverse hijacking was expressly claimed by the respondent only in relatively few cases. As regards the distribution per provider, the absolute numbers are 3 (eResolutions) / 5 (NAF) / 18 (WIPO). Put in relation to the absolute number of cases evaluated per provider, however, the figures are quite close to each other: eResolutions 3.15 % / NAF 3.42 % and WIPO 3.39 %.

In eight of the cases where the complainant had been accused of reverse hijacking by the respondent, the domain names were still ordered to be transferred. This includes e.g. AF-0229a,b (thingsengraved.com, things-engraved.com), where the respondent had argued that the complainant was engaging in reverse hijacking vis-à-vis other registered right holders. Other cases are D2000-263 (trident.com), D2000-075 (catmachines.com), D2000-0631 (sunfest.com), D2000-0835 (saradar.com), D2000-0860 (hispaniconline.com, -.net), D2000-1223 (trashylingerie.com), D2000-1224 (sydneyoperahouse). Claims were rejected without a positive finding on reverse hijacking in AF-0104 (thyme.com), AF-050 (jobpostings.com), AF-0122 (shopzone.com), D2000-1257 (cellcontrol.com, -.org, -.net), D2000-0807 (findus.com), D2000-0449 (eurotrash.com), D2000-0422 (athome.com, atwork.com), D2000-0410 (scientologie.org), D2000-0272 (domina.net), D2000-0460 (Bankinternet.com, Bankinternet.org, Bankinternet.net) and D20001037 (mymaruti.com), FA 93681 (dogs.com), FA 94906 (rockcity.com) and FA 94907 (rock-city.com). In one of these cases, AF 0170 a-c (presidentchoice.com, -.org. and -.net), the Panelist declared that she found *"the Complainant's apparent failure to investigate whether the Respondent had rights or legitimate interests in the presidentchoice.com domain name troubling... In a case where the trademark, although a well-known supermarket brand, is a common English phrase used as a mark by other businesses, the failure to conduct a cursory investigation seems especially unreasonable. Nonetheless, because the UDRP is new, and the Complainant was proceeding on an incorrect but common misapprehension as to its scope, I am reluctant to find that it filed the complaint in bad faith."*

In AF-0169 (qtrade.com), the Panel concluded that the Complainant had engaged in reverse domain hijacking. Although he had not been able to prove that he was the owner of trademark rights to "QTRADE" in either the United States or Canada, he had made several unsuccessful attempts to persuade the respondent to sell the name, and had made an exaggerated representation of the status of his mark. Other findings of reverse hijacking concerned D2000-0622 (K2r.com) D2000-1202 (dw.com). The complainant in the first case, K2r Produkte AG, is a Swiss firm which owning trademark rights in "K2r"; the domain name in question was used for a store trading as "Keith and Rosie Rich". In the second case Deutsche Welle, a German Broadcasting Station, tried to assert its rights against the American firm Diamond Ware Ltd. In both cases, the finding on reverse hijacking was adopted by majority, with one Panel dissenting. The majority was of the view that the complainant could and should have been aware of the fact that the respondent was carrying on a bona fide business under the name. In D2000-1202, it was stated in the majority vote that *"the Complainant has not produced one shred of evidence to suggest why the Respondent, a company in the United States, should have been aware of the existence of the Complainant, a German broadcasting service, back in 1994 when it registered the Domain Name. When the Complainant visited the Respondent's website (its letter of July 13, 2000 makes it clear that it was aware of the website) any doubts it may have had were removed. The Domain Name connects to an active website through which the Respondent conducts a bona fide business and in relation to which the acronym "DW" is apt. In such circumstances, the price the Respondent put on the Domain Name in the year 2000 was completely irrelevant to its motives when registering the Domain Name in 1994. None of this is addressed in the Complainant's response. ...the Complainant's behaviour, which has wrongfully resulted in the Respondent having to incur what must be substantial legal fees, should be condemned as an abuse of the administrative procedure"*[\[47\]](#).

The last case to be reported here is D2000-1005 (ezstreet.com). The complainant had rights in a registered trademark for asphalt products. The respondent, who had not been contacted by the complainant prior to initiating the proceedings, had used the domain name for a site resolving to another website. He did not respond to the claim filed to him, i.e. he was in default. The Panel noted that the complainant had alleged, and the respondent had failed to deny, that Respondent has no legitimate interests in respect of the domain name at issue. However, it also noted that *the second-level domain name at issue is a variation of and phonographic for a common English*

phrase which means 'a situation with no worries', and that "Common words and descriptive terms are legitimately subject to registration as domain names on a 'first come, first served' basis". Finally, it concluded that because "the Complainant produced no evidence that it had attempted to contact the Respondent and negotiate a resolution of the matter prior to initiating the panel proceeding, and where the domain name at issue consists of a well known common, descriptive English phrase, and where the Complainant knew that Respondent had registered for sale other domain names all of which consist of common and/or descriptive words and phrases together with the generic Top Level Domain names, the Panel is of the opinion that this proceeding was brought in bad faith and constitutes an attempt at Reverse Domain Name Hijacking."

2.3.2.3 Default

It has been remarked previously that the relatively high number of unspecified answers in Q 3 and Q 6 might be due at least partly to the fact that in many cases, the respondent does not respond to the claim at all. It is submitted that this is an element which is of some relevance to the outcome of the cases treated under the UDRP. According to Paragraph 14 b) of the UDRP Rules, the Panel is free in case of default "to draw such inferences therefrom as it considers appropriate". While this does not automatically lead to a finding in favour of the complainant, it still might have a noticeable effect on the outcome in the sense that the complaint is granted more frequently than when the respondent answers the claim and explains its position.

As the questionnaire did not expressly ask for default cases, an attempt was made to identify them by way of retrospective analysis. It can be assumed with some certainty that respondents have been in default when the answer "none" or "no response" was given under Q 6 – the question relating to the defenses brought forward by the respondent – in the unspecified category "other". Furthermore, there is at least a reasonable probability that the same applies if "no right" was answered under Q 3 – the question relating to respondent's rights – and "no comment" was chosen under Q 6. The analysis undertaken from this starting point arrives at the following conclusions: Out of 290 cases where participants have chosen the answer "other" under Q 6, 152 can be identified with reasonable certainty as default cases. Of these, transfer of the domain name was ordered in 141 cases, cancellation was ordered in three cases, and the complaint was rejected only in eight cases. The number of cases where the answer was "no right" under Q 3, and "no comment" was answered under Q 6 amounts to a total of 246 cases. Of these, transfer of the domain name was ordered in 228 cases, cancellation was ordered in 4 cases, and the claim was rejected in 13 cases.

Further detailed examinations of some of these cases have however shown that the figures resulting from the second mode of analysis must be viewed with some caution. Nevertheless, the result establishes a reasonable basis for the assumption that well over 300 cases – roughly one half of all decisions included in the survey – have been handed down without the respondent actively participating in the proceedings. The result also shows that the percentage of decisions in favour of the complainant clearly surmounts the general average^[48].

That said, a brief presentation shall be undertaken of decisions which have *rejected* the complaint in spite of the respondent being in default. Among these is D2000-1005 (ezstreet.com), where the Panel not only rejected the complaint but held the complainant liable for reverse domain hijacking (see *supra*). In D2000-1211 (knicks.com) and D2000-1205 (usatodayssports.com), the claim was denied because the complainant was unable to establish valid rights in the mark at issue. The complaint was denied for the same reason in D2000-1044 (fiducial.net,

fiducial.org). In this case, the respondent was not really in default, but had expressly consented to the transfer, which the Panel denied in spite of respondent's consent.

In most of the decisions rejecting the complaint when the respondent is in default, the finding is motivated by the fact that the complainant has not met its (initial) burden of establishing the requirements in Paragraph 4 a) (ii) and (iii), i.e. lack of rights or legitimate interests on part of the respondent as well as registration and use in bad faith. For instance, in DN2000-419 (armaniexchange.net), the Panel noted that it found *no support whatsoever in the Complaint for the Complainant's allegations that the Respondent did not have rights or legitimate interests in respect of the domain name but the unsubstantiated statement that 'Respondent certainly knew'*. Furthermore, it was held that *the Panel cannot assume that Complainant's trademarks are indeed renown solely upon the Complainant's word since it is necessary that the Complainant proffer evidence in such a sense (see Case D 2000-0532, Unione Calcio Sampdoria SpA v. Titan Hancocks) and therefore the Panel cannot base its finding on such a self-serving statement, even because the Complainant failed to offer any evidence that its trademarks are indeed registered in Australia, the place where the Respondent is*, and the Panel concluded that *in the present case, where no facts and no evidence have been submitted, the Panel finds it impossible to draw any inference from the Respondent's default*"[\[49\]](#).

See also AF-0188 (christusrex.com), where the Panel held that *this Panel's ability to make an order in favour of a Complainant is limited by the words of Paragraph 4a. of the ICANN POLICY which requires that a Complainant prove three specific factual elements. The restrictive nature of the Uniform Dispute Resolution Process and the heavy burden imposed of complainants encourages parties to attempt to reach a settlement of their own in a dispute. The Complainant in this case has led limited evidence with respect to its own rights to the words Christusrex. Furthermore, the Complainant has failed to demonstrate any bad faith registration and use of the Domain Name by the Respondent. On this basis, the Complainant's request for a transfer must be denied.* "

For similar reasons, claims were rejected in AF-0164 (presidentchoicesocks.com), AF-0156 (arcturus.com; the respondent had failed to meet the time limit for its response and was therefore held to be in default), AF-0257 (irenegari.com), AF-0176 (spincycle.com), AF-0241 (canhost.com), D2000-1239 (americanhomeproducts.com), D2000-0608 (azzaro.com), D2000-0232 (al-anon-alateen.org), D2000-0096 (eautoparts.com) and D2000-1467 (intocast.com).

2.3.3 [Issues Concerning Art. 4 \(iii\), a b](#)

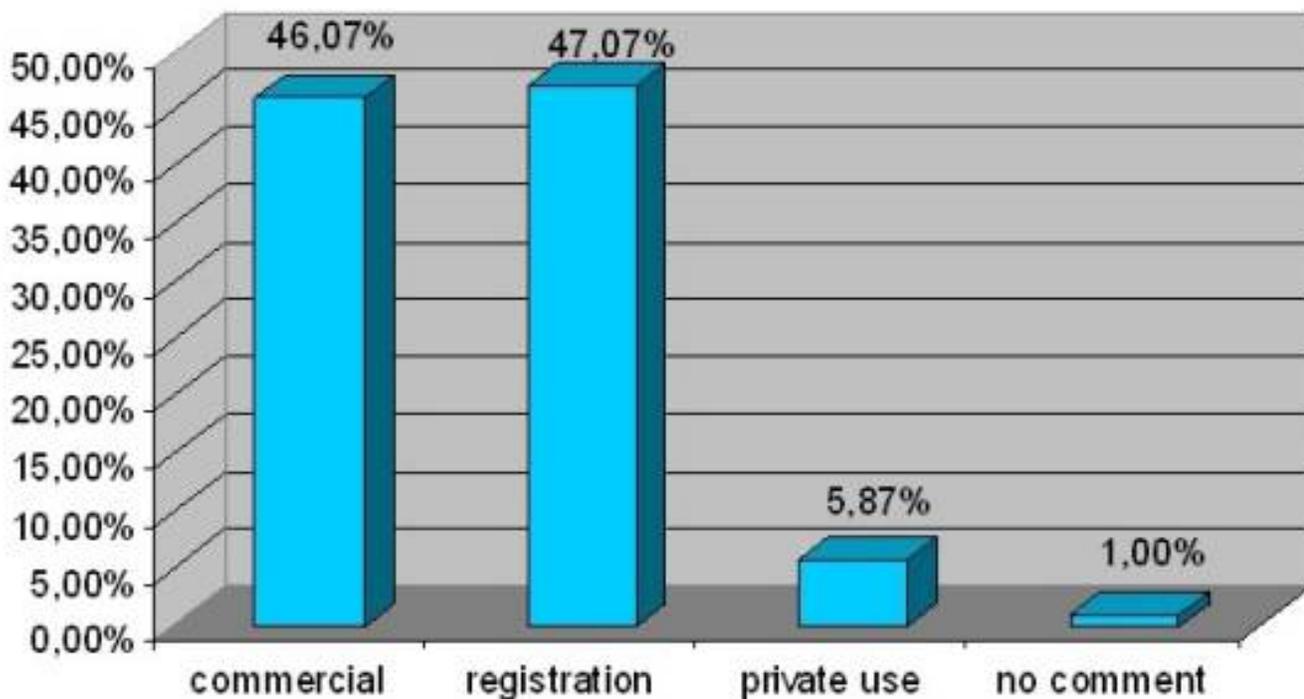
2.3.3.1 [Mode of Use](#)

One of the features in the UDRP which has been under debate ever since the beginning concerns the fact that Sec. 4 a iii stipulates a cumulative requirement in respect of registration *and* use of the domain name (in bad faith). It has been pointed out frequently that if this should mean that the complainant cannot challenge a domain name as soon as it is registered, but has to show that it is already used – in particular if use in that meaning could only be found in use in commerce in the usual sense, i.e. use in connection with the offering of goods or services over the net – this would bar any possibility for a timely reaction by rightholders to the threat of detriment caused by cybersquatting.

Already in the very first decision handed down in the framework of the UDRP however, the misgivings were eased to some extent by the fact that in accordance with (not only!) US law, use in the meaning of the Policy was found in the fact that the respondent had tried to sell the name to the complainant, thus using it as a trading object^[50]. This line of argument has been employed in many other decisions^[51].

Still, the fact that at least some kind of use (in bad faith) has to be established in order to successfully initiate UDRP proceedings is felt by many to constitute an unnecessary impediment for quick and efficient proceedings. With a view to that discussion, the study seeks to quantify the cases when the domain name was used on a regular, active website in comparison to those where the name was not actively used (other than offering it for sale etc.). Furthermore, it was asked whether in case of active use, the respective website was used for private or commercial purposes.

Use (digit 4 of survey)



The result demonstrates that in nearly one half of the decisions (47 %), there was no active use of the domain name other than the effort to commercialize the domain name itself. Active commercial use accounted for 46.07 % of the cases, while private use figures with only 5.87 %.

No further analysis was undertaken of the figures. It seems however worth noticing that the fact that the cases where the domain name is actually used for an active website only account for roughly one half of the decisions

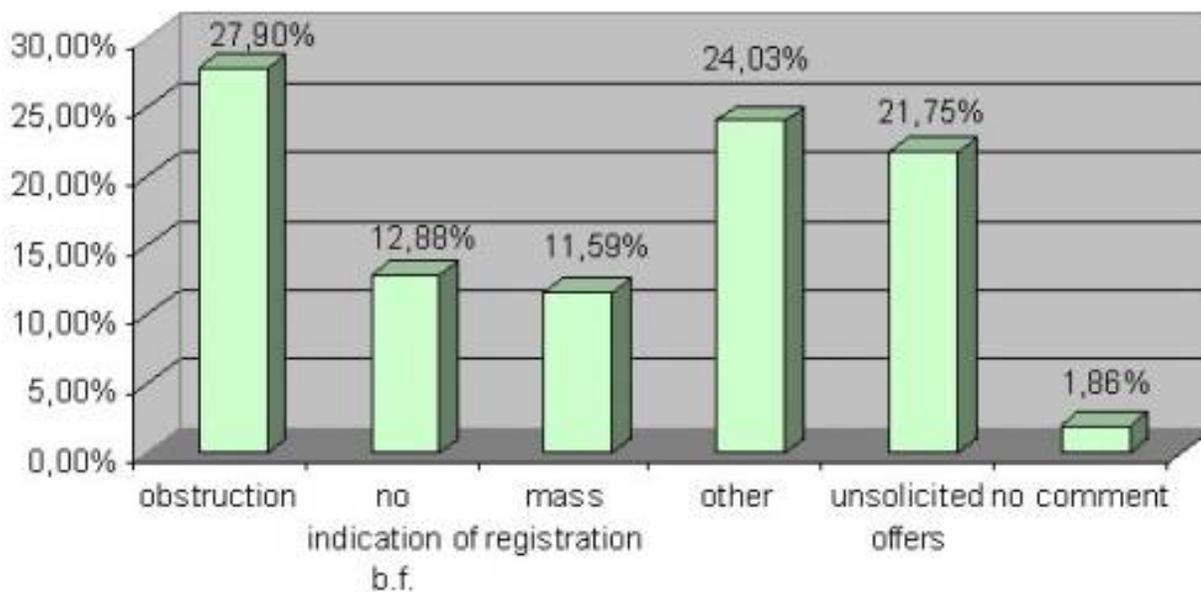
underlines the necessity of finding clear and adequate rules in order to take care of the problem.

2.3.3.2 [Factors Indicating Bad Faith](#)

2.3.3.2.1 [General Remarks](#)

The last item in the survey to be presented here concerns the conduct of the respondent which was considered in the decision to furnish an indication of bad faith in the meaning of sec 4 b UDRP (Q 5). The pre-formulated categories of answers in the questionnaire were meant to reflect the practically most relevant types of indications for bad faith. For technical reasons, only one alternative could be selected as an answer.

bad faith



The largest figure among the answers given relates to obstruction, which includes registration and use for misleading purposes (27.90 %). Examples of actual intent to mislead, or to use the mark in order to sell the respondent's competing products can be found e.g. in D2000-0019 (goodfoodguide.net) and in FA 96374 (clbooks.com).

Unsolicited offers were mentioned in 21.75 % of the answers, while mass registration follows with 11.59 %. This shows that the actual conduct of persons engaging in cybersquatting has moved away to some extent from the classical pattern which is reflected in the wording of Art. 4 b. Only in a minority of cases does the alleged pirate

approach the trademark holder with an offer to sell the name back. Rather, the domain name is stored and offers are made only made when negotiations are initiated by the rightholder, or the registrant uses the name for its own purposes, e.g. in order to attract traffic to a website resolving to another site with a less attractive name.

Quite remarkable is also the fact that mass registrations have only been mentioned in little more than 10% of the cases as furnishing an indication of bad faith. Even if this is partly due to the fact that only one alternative could be chosen in the responses to the questionnaire, meaning that the actual figures are somewhat higher, it still shows that a majority of respondents are not engaging in a pattern of mass registrations. Another reason might be that Panels treat the issue with some caution, as it is generally understood that dealing in domain names, and therefore also registration of large quantities of such names cannot be viewed as an indication of bad faith *per se*.

In 12.88 % of the cases, no indication of bad faith on part of the respondent was found. This figure falls clearly below the percentage of decisions found in favour of the respondent (21.32 %), meaning that in approximately 10 % of the decisions, the complaint was rejected without the Panel making an express finding on the bad faith issue. Different reasons may account for this. In some cases, the complainants may have even failed to establish a right of their own, or – more seldom – the Panel may have denied confusing similarity. Also when the respondent could rely on a property right of his/her own, Panels may have found it superfluous to comment expressly on bad faith, with an exemption in respect of those cases where the Panel had reason to assume that the right had been acquired with the intention of enabling the respondent to engage in cybersquatting.

Unspecified answers ("other") were given in 24.03 % of the cases [\[52\]](#). This mainly concerns decisions where the Panels have stated that the conduct by the respondent did not fit neatly into one of the examples listed in 4 b, but that they were either applicable cumulatively, or that the finding was motivated on other grounds. As the list is only of an illustrative character, there is no doubt that it is in full compliance with the Policy to revert to other factors for the motivation of the finding on bad faith.

The aspects and nuances which are addressed in the decisions in regard to bad faith are so numerous and complex that no attempt is undertaken in the following to categorize them in a comprehensive manner. Instead, only examples are given of the issues involved.

2.3.3.2.2 [Respondent's Awareness of the Conflicting Sign](#)

One essential aspect in the assessment of bad faith concerns the question whether the respondent has been aware of the conflicting sign at the time of registration (and subsequent use [\[53\]](#)). As this is a subjective factor, it can hardly be proven by direct evidence. This as well as most other elements to be taken into account in the assessment of bad faith are therefore typically only susceptible to indirect means of proof, e.g. by showing that in view of the famousness of the mark, it is quite unlikely that the respondent was unaware of its existence when registering the domain name. It remains however unclear how much evidence the complainant must bring forward in order to establish a *prima facie* case in his favour. For instance, in D2000-0419 (armaniexchange.net), a default case, the Panel found that the mere statement by the complainant that his mark was widely known was not sufficient to support a positive finding, while contrary to that, the Panel was obviously satisfied with the same sort of "self serving statement" in D2000-1424 (armaniboutique.com).

Apart from the degree of renown of the complainant's mark, the Panels have also considered other elements as being indicative of respondent's awareness of the conflicting sign. For instance, knowledge of complainant's mark and, consequently, bad faith was assumed in cases when the respondent had been a former employee of the complainant, see e.g. AF-0096 (tourplan.com)[54] or when there was a clear coincidence between a press announcement of the product to be sold under the mark and the date of registration of the domain name (D2001-0024 - contrarotator.com, -.org, -.net). Also the fact that the respondent is active in the same business sector as the complainant may furnish a basis for the assumption that the domain name was registered with knowledge of the sign, see e.g. D2000-0835 (satyam.net, -.org). In D2000-1416 (emailco.com), the Panel contended itself with the statement that *"the business of the Complainant is similar to the alleged business of Icodos SA (closely related to the Respondent), and the Respondent seems to have had knowledge of the e-mail service market..."*

In D2000-0422 (athome.com, atwork.com), the respondent had delivered an affidavit stating that he did not know about the conflicting mark "Athome" when registering the domain names. The Panel discussed and accepted the document as evidence of good faith, all the more because the mark was of a descriptive character, and the respondent himself was the owner of a trademark right (@home) which also corresponded to the domain name.

When doubts concerning the respondent's knowledge cannot be resolved either way, it is regularly decisive whether the respondent can provide a good and plausible explanation for choosing the name in question. As was already pointed out above, the prospects of this exercise depend inter alia on the degree of descriptiveness of the mark. The more descriptive a designation is, the easier will it be for the respondent to motivate his choice. Examples of cases involving allegedly descriptive domain names, comprising decisions both in favour and against the complainant, have been mentioned already above[55]. The decision can be very difficult; much depends in these cases on the subjective evaluation by the Panel. It is inevitable that this represents a source for uncertainty and for inconsistencies. For instance, it is not easy to understand why the Panel did not accept the explanation given by the respondent in D2000-1234 (icet.com), where the respondent, an Icelandic citizen, had explained that he had chosen the name as an abbreviation for Iceland Travel, whereas in D2000-0203 (oilily.com), the Panel accepted the explanation that the name was derived from the words 'oi' (meaning cucumber in Korean) and 'lily', and was intended to be used for a business selling fresh flowers and vegetables through the Internet.

2.3.3.2.3 [Diversity of Business Sectors](#)

When the domain name is used within a different field of business than that for which complainant's mark has obtained protection, it should at least in theory be irrelevant whether the respondent had knowledge about complainant's mark, as according to general trademark law principles, the term may be used freely outside of the scope of protection, which is confined by the range of products or services for which the mark is registered and used. In decisions denying bad faith, the aspect of diversity of the fields of business in which the respective Parties are active is indeed frequently emphasized by the Panels, see e.g. FA 93553 (usource.net), D2000-0100 (highclass.com), D2000-0223 (countryhome.com), FA 96301 (lifewatch.com). Typically however, such observations are made in cases where the protected mark has a very low degree of distinctiveness, and where no direct evidence exists that the respondent did have positive knowledge of complainant's mark, so that the diversity of the field of business is just another, and not the only and decisive, factor on which the decision on (lack of) bad

faith is based.

2.3.3.2.4 [Relevance of Use vs. Non-Use](#)

Another element in the assessment of bad faith which is often emphasized concerns the kind of use which is made of the domain name. While some decisions tend to hold that mere storing of a domain name, instead of using it for an active website, supports a finding of bad faith, e.g. in D2000-0003 (telstra.org), D2000-1223 (trashylingerie.com), AF-0092 (beveragesandmore.com) and FA 96300 (b3.org)^[56], some Panels have taken the opposite position, like e.g. AF 0162 (2ecorp.com), AF-0156 (arcturus.com), FA 94 946 (avenger.com), D2000-1467 (intocast.com), D2000-0624 (pollyester.com). Upon closer examination, it shows however that use or non-use are hardly ever considered independently as constituting elements of bad faith, but only in connection with the other circumstances of the case. Thus, if there is no clear evidence of the respondent having been aware of the sign, and if the explanation given for the choice of the name and for the intended future use sound plausible, it does not harm if the website to be reached under the name has remained dormant for a while. On the other hand, if the explanations given by the respondent have little credibility, the fact that the domain name has not been used for some time may count as an element supporting the overall impression that the registration has been taken out in bad faith.

2.3.3.2.5 [Dealing in Domain Names](#)

It has been said before that dealing in domain names as such is not regarded as illegitimate under the Policy. To register as many attractive names as possible and to sell them for the highest achievable price is not an offence; nothing in the Policy would prevent the person having registered e.g. "business.com" or "sex.com" from cashing the hundreds of thousands of dollars the names might be worth on the free market. A different assessment only applies if the domain name is in conflict with a prior mark, and the domain name dealer intends to derive profit from that.

While the general principle is clear and uncontroversial, it may create problems in a situation when a (descriptive) domain name corresponding to an existing sign has been acquired by a professional domain name dealer, who contends in a *prima facie* plausible manner that at the time of acquisition, he did not know about the conflict. If a restrictive interpretation of the Policy is followed, the complaint would have to be dismissed in the absence of further evidence of bad faith. However, it seems that in the balancing of interest which is regularly undertaken in these cases, the interests of the rightholder tend to prevail. This is expressed in a clear and rather far-reaching fashion in AF-0222 (efads.com), where the Panel undertakes a comparison between the position of both parties:

“Complainant offers job opportunities in 54 stores, presumably pay taxes (sic) and is an element of circulation of wealth in the places where it operates. Respondent does nothing of the kind, she simply registers fancy names and in order to auction them on the highest bidder...(People like the Respondent) are not doing an illegitimate business, but a very risky one, as they might be infringing other people’s rights, even without knowing it. Therefore, those who register a domain name for sale, as the Respondent, must bear the burden of losing the registrations, as in this case, or else the transaction costs for companies which have already developed a goodwill upon a certain trademark...would sky-rocket, and this would be an extremely inefficient system for the economy as a whole.”

While this reasoning is understandable from a general point of view, it creates a risk that considerations are included in the Policy which are no longer consistent with the restricted purpose for which it was originally created.

2.3.3.2.5 [Subsequent Bad Faith](#)

Another point of concern regards those cases where the respondent did not register the domain name in bad faith, but subsequently uses it in a manner which falls under the criteria listed in 4 b, e.g. by making unsolicited offers. Some decisions have expressly made the point that such conduct is not within the scope of the UDRP, see e.g. D2000-0026 (4tel.com), where the Panel denied the claim, stating that a conscious decision had been made that UDRP proceedings should be limited to abusive registrations[57].

2.3.3.2.7 [Absence of Bad Faith When Respondent was Aware of the Conflicting Sign](#)

It has been said before that bad faith is regularly denied by the Panels when they find that the respondent was not aware of the conflicting sign when registering (and using) the domain name, or when it is at least not possible to establish knowledge with the necessary degree of probability. If it is undisputed that the respondent did know about the mark, or if it is highly improbable that he was not aware of it, registration and use in bad faith can still be denied under certain circumstances. Obviously, the aspect of knowledge becomes totally irrelevant when the respondent is in a position to rely on a right of his own, which gives him equal entitlement to the domain name at stake. The same applies at least in principle if the respondent is authorized to use the name on the basis of a contractual relationship with the right owner. It is however not quite certain whether and to what extent mere dealership can be regarded as furnishing an authorisation in that meaning; see on this point above, 2.3.2.1.3.

As was pointed out above, the respondent does however not have a valid excuse if the right was acquired – possibly in a different country than that where the complainant is mainly active – with a view to derive profit out of the business value connected with the name. Several examples of these practices have been given above. Another case illustrating the problem is AF-0160 (computerfutures.com). Although in that case, the US-based respondent had actually started to do business on the Internet under the contested name, the Panel came to the conclusion that the purpose of this exercise had been either to attract and mislead customers of the much bigger complainant, who, although based in England and Wales, was operating internationally, or in order to sell or rent the name to the complainant or a competitor.

A further group of cases where bad faith can be denied in spite of the respondent being fully aware of the mark being the property right of another regards the issue of free (critical) speech. As was shown above, there is much inconsistency in these decisions, with a tendency towards a rather restrictive approach.

It has been pointed out above that a positive attitude towards the rightholder, in particular the intention to establish a fansite, is not considered to constitute a legitimate interest in the domain name in the meaning of Art. 4 c.

Furthermore, it is regularly assumed that the requirement of bad faith is fulfilled, even if the site – at least initially – has not been used commercially; see e.g. D2000-0222 (dodgeviper.com)[58], D2000-0233 (jordanf1.com). A similar situation had to be considered by the Panel in D2000-1212 (christianiabank.com). The respondents did not contest the fact that they targeted the complainant's mark when registering the domain name. However, they argued that they did this out of admiration for the complainant and in order to get in business contact with him and "be friends". The Panel said it believed "*the Respondents had good intentions but those alone do not justify intentionally registering a domain name identical or confusingly similar to an name and trademark in which the Complainant has rights*".[59]

3. [Evaluation and conclusions](#)

3.1 [General Observations](#)

The answer to be given to the question posed as the general theme for the present study – whether the UDRP is functioning satisfactorily – is slightly ambiguous. Generally speaking, the survey shows that fears concerning the risk that the Policy might be misused by large companies in order to freeze competition and free speech are largely unfounded. In the vast majority of cases considered, the domain name at stake was identical with, or incorporated, or otherwise clearly resembled the trademark belonging to someone else, and whenever the respondent could make out a plausible case of *bona fide* business interests or fair use, chances were good that the complaint would be rejected. Only a rather small amount of cases could be identified where issues such as reverse hijacking or critical comments on the rightowner's product or business conduct etc. were involved. On the other hand, a more detailed analysis of individual cases or groups of cases reveals that several issues still need further clarification. In other words: although the UDRP is functioning well as a matter of principle, there are certain points where the picture becomes somewhat unclear.

This result was reflected also in the final round of discussions held with those who participated in the evaluation. All groups involved, i.e. the students taking part in the

Stockholm master course as well as in the final evaluation work, were positive as a matter of principle about the functioning of the UDRP. This impression was particularly pronounced among those who had been involved in the statistical evaluation, i.e. those who had been told to read and evaluate 50 cases *en bloc*, without any pre-selection. They answered practically unanimously that there were hardly any cases where they had disagreed with the Panel, or where they saw the need for a general change in the Policy as presently applied. Compared to that, the Stockholm group tended to be more critical. As they had been told to pre-select cases in a manner which would lead them to possibly interesting issues, they were more prone to come up with the problems they had identified.

Before embarking on further discussion of these issues, the following statement shall be made. Given the fact that the UDRP is so new and does not have a legal basis in any specific legislation, that the number of decisions is so high and, most of all, that they have been handed down by Panelists coming from different countries and having been brought up in different legal systems, it is a wonder anyhow that the discrepancies in the practical application of the Policy are not more profound. Even trained judges operating at different courts in the same jurisdiction may come to different conclusions in respect of one and the same case, and all the more so if the assessment is partly a

matter of subjective evaluation. To achieve full consistency or even uniformity in the decision practice of UDRP proceedings is therefore hardly a realistic option. However, this does not mean that any effort to strive for more transparency and legal security would be in vain. The following considerations should be understood against this background.

3.2 [Specific Issues](#)

3.2.1 [\(Identity or\) Confusing Similarity](#)

It has been pointed out above (2.3.1.2) that the first prong in Art. 4 a) of the Policy only very seldom constitutes an obstacle to the grant of a claim for transfer or cancellation. This concerns in particular the criterion of (identity or) confusing similarity between the mark and the domain name, which was denied only in a few exceptional cases. One obvious reason for this is that complainants do not make use of the Policy unless the domain name does in fact incorporate the trademark or otherwise bear a clear resemblance to it (see on this point also above, 2.3.1.2). This is however not the sole explanation. In particular, it does not explain sufficiently why Panels have held that confusing similarity even exists in cases when the domain name clearly distances itself from the mark, such as in the notorious "-sucks" cases^[60].

One possible argument to overcome these difficulties is that suffixes or prefixes consisting of generic or descriptive words should be ignored when assessing confusing similarity, no matter whether they are of a geographic character, indicate the nature or other specifics of the goods or services offered, or are of a critical or disparaging character. If this line is followed, the decisions denying confusing similarity in the "-sucks" and other, similar cases have come to the wrong conclusion, and the whole criterion, at least the part of it which refers to confusion, would largely become superfluous.

It might indeed be a matter for consideration whether Art. 4 a) (i) of the Policy should be re-formulated or commentary added in a manner which makes clear that a finding of confusing similarity does *not* require the showing of an actual risk of confusion to the public. In order to better reflect the reality of the proceedings, it might also be pointed out in the commentary that confusing similarity should not be assessed in an isolated manner, but that it should be evaluated in the light of the case as a whole, as it seems that this is what happens in practice. If in view of all the circumstances of the case, the Panel is of the opinion that the registrant has clearly acted in bad faith and without being able to rely on legitimate interests of his or her own, it is very unlikely that the case will be dismissed for lack of confusing similarity –even if it is obvious that a reasonably well informed and circumspect consumer would hardly expect the site to be operated or sponsored by the right holder. On the other hand, the claim may well be denied for that very reason, if the Panel holds that there is no bad faith involved.

This effect can be studied *inter alia* in the cases concerning mass registrations of domain names. For instance, had the domain name "yayou.com" been registered individually by a person who had not been engaged previously in a

pattern of registering domain names containing the distinctive signs of third parties for commercial purposes, chances are good that it might have been found not confusingly similar with the <yahoo!> mark. As things were, the domain name was only one in a range of 38 domain names reflecting the same mark. In that situation, the Panel decided that all the names included in the registration were confusingly similar with the mark in question, and that they were registered in bad faith (D2000-0273). Obviously, similar considerations might also account for the different result in the "-sucks" cases, to which reference has been made above.

Instead of making clear in the Policy or in the commentary that an actual risk of confusion is not required - which would largely leave the current practice unchanged -, there is also a different option to be considered. Panels could be instructed to give more weight to the first prong in the Policy, and to restrict positive findings under the UDRP to cases where an actual, serious risk of (at least initial) confusion can be established. Such an approach would most likely lead to a considerable reduction of decisions in favour of the complainant. Transfers would in principle only be ordered when the domain name is in fact identical or quasi-identical with the mark, or where additional elements like prefixes or suffixes are of a geographical nature or relate to the business the complainant carries out or the products it sells, whereas the question whether other kinds of variations amount to trademark infringement would be left for the courts to decide[\[61\]](#).

It is at least not totally wrong to argue that such a restrictive approach would be more in line with the original aims of the Policy, than the more generous practice applied by the majority of UDRP Panels. Indeed, if the effect of the registration is not clearly obstructive in the sense that the domain name holder is prevented from using his or her mark as a domain name, and if it is clearly visible to the public that the domain name consists of the mark "plus something", which has nothing to do with the geographical origin or the nature of the goods or services, the situation is not comparable with that of a trademark holder whose mark has actually been stolen by a pirate. To recommend a more restrictive attitude therefore appears in principle as a tenable option.

Before such a step is taken, its possible impacts should however be investigated under all relevant aspects. Would it really help competition, in particular small businesses, and/or the general public if variations of a mark were excluded from the Policy, as long as they are not clearly misleading? Perhaps the only group which would profit from such a strategy – or at least the group profiting most from it – would be the professional domain name dealers, the usefulness of whose services for society at large remains somewhat dubious?[\[62\]](#) Furthermore, it is less clear than it might seem at first glance, whether the efficiency and transparency of UDRP decisions would really profit if Panelists had to put more emphasis on their decisions in relation to the first prong. To reach a conclusive decision on the question as to whether use of a domain name is actually misleading, might create new, additional difficulties – e.g. in respect of the weight which has to be attributed to the contents of the respondent's website[\[63\]](#).

Without giving preference to either of the two possible attitudes depicted above, it is recommended that the issue should be discussed further, and that the Policy should be reformulated or commentary should be added in one direction or the other, in order to add clarity to the grounds on which the decision practice is founded.

3.2.2 [Legitimate Use & Bad Faith](#)

3.2.2.1 [The General Structure](#)

The two other elements mentioned in the Policy under 4 a ii/iii and 4b/4c respectively are of considerably higher importance in the present Panel decision practice than the first prong. Although both elements are formally and logically separated, they are so closely intertwined in the assessment that it seems appropriate to treat them together in this concluding analysis.

When summarizing the argumentation in respect of both legitimate interests and bad faith, the following structure can be discerned. The most essential aspect is one which is not even mentioned expressly in the Policy – namely, whether respondent was aware or had reason to be aware of the conflicting sign. If knowledge can be established with a reasonable degree of probability, this will in most cases be sufficient to establish bad faith. If the domain name is used for an active website, the argument would be that the purpose is to attract traffic and thus to obstruct the trademark holder and/or mislead the public. If the domain name is inactive, the argument would be that this implies an offer to sell it to the trademark holder or a competitor.

For the respondent, this basically leaves two ways to escape a finding against her. She may argue that contrary to the complainant's allegations, she did not know about the conflicting sign or at least did not think about it when registering the domain name, but that the domain name was chosen for independent reasons – typically because it is descriptive of some sort, and because it has a useful connotation in respect of the business which she actually undertakes or intends to engage in. This form of argument can be found in the majority of cases, where the respondent makes an attempt to defend herself. The other defence is to establish that she had a positive right to register and use the domain name, so that the issue of actual or potential knowledge becomes irrelevant. This argument is without problems if the respondent is the owner of a property right in the sign, which was been acquired by *bona fide* registration or use. Absent such rights however, the respondent's position is rather precarious. Even if it is possible at least in theory that the proposed use of someone else's mark as a domain name is held to be admissible for reasons of free speech (commercial or private), the extent to which the respondent may rely on such principles is not at all clear.

Departing from these observations, it might be asked whether it would serve the understandability and transparency of the Policy, if the structure depicted above were reflected more clearly in the text, e.g. by making express reference to the paramount importance of the respondent's actual or potential awareness of the conflict. However, it is submitted that major changes in the wording and structure of the present formulation of the Policy are neither necessary nor recommendable. All in all, there is no major sign that the objectives of the UDRP have been misunderstood by the Panels or by a substantial number of complainants^[64].

To point out the general structure underlying the findings on legitimate use and bad faith is however considered to constitute a useful exercise insofar as it helps to summarize and identify those issues which are of major importance in the context, and where further investigation is needed. These are on one hand the question of how the interests of free speech can constitute a viable excuse for the proposed use of another person's trademark, and second, questions concerning the standards and burden of proof.

3.2.3.1 [Issues to Be Investigated](#)

3.2.3.1.1 [How to Safeguard the Interests of Free Speech](#)

It was pointed out before that the issue of free speech was expressly addressed only in relatively few decisions included in the survey. Nevertheless, the importance of the issue should not be underestimated. It is a very sensitive point, and it is highly controversial. This is underlined not least by the fact that the most blatant inconsistencies between Panels can be found in decisions where the issue has been of major importance. While some Panels have found that use of the mark as domain name (or as part thereof) is legitimate if it resolves to a website containing critical comments in respect of the firm or product concerned[65], and also to sites legitimately offering the products for sale[66], others have strongly rejected that view, holding that interests of free speech on the Internet should be safeguarded by other means than using someone else's trademark[67].

The issue is in fact a very complex one and merits thorough consideration. It is generally accepted that as a matter of principle, in private and also commercial communication, use of trademarks by others in a nominative manner is legitimate in order to make critical or other statements about them, such as announcing them for sale etc. The rightholder cannot oppose the use *per se*, but only if the statements made are incorrect or disparaging etc. Although it may appear as desirable to transpose such principles to the field of domain names and the UDRP, this raises considerable difficulties. In view of their specific purpose, domain names have to be relatively short. It is therefore hardly possible that they embrace complex statements, the legitimacy of which could be assessed according to the same standards as apply in normal (commercial) communication. Accordingly, when making reference to a trademark in a domain name for the purpose of establishing a website containing (critical) comments, a person must either use the mark as such or clarify his intentions by using crude and possibly disparaging denominations like "-sucks", "-reallysucks", etc. Both solutions run counter not only to the interests of the trademark holder but also to the interests of the general public who would be rendered a rather poor service. If the mark is used as such, they might be subject to initial confusion about the sponsor of the website. If, on the other hand, a custom would be developed that critical comments may be published on websites identified by ²<trademark>sucks.com (-.org, -.net, -.biz, .info etc.) ², this creates new risks, as it would allow the monopolisation and also manipulation of sites where such information may be found[68].

The topic is too complex and important to be considered solely in the context of a study on the UDRP, or even on domain names as a whole. It concerns the question of how information involving other people's property rights can be transmitted and, even more important, how it can be traced and found on the Internet. A thorough analysis of the topic would have to involve also other means of use of marks which are of relevance in the context, e.g. as metatags, keywords etc., and the efficiency/legitimacy of such measures as compared to use as domain names.

Without such an analysis, it will hardly be possible to arrive at a clear and commonly acceptable conclusion as regards the treatment of the issue by UDRP Panels.

2.3.3.2.2 [Burden and Standards of Proof](#)

The factor which is presumably the most influential in respect of the outcome in an individual case is the manner in which the parties' contentions and eventually also the evidence proffered by them is evaluated by the Panel. Who has to prove with what degree of certainty or probability whether the mark is used and registered in bad faith, or whether the use is legitimate for certain grounds?[69]

In the Policy, it is set out as a matter of principle that the complainant bears the burden in respect of all three elements mentioned in 4 a. On the other hand, it follows from Art. 4 c that the respondent bears the burden in respect of the legitimate interests invoked by him. As has been pointed out in the literature[70], the best way to interpret this somewhat confusing regulation seems to be that the complainant has to prove the elements in Art. 4 (i) and (iii) and has to establish a *prima facie* case in respect of (ii), whereafter the burden of proof in respect of the absence of legitimate interests is shifted to the respondent.

This leaves the question as to how much is needed from the complainant's side in order to overcome the initial burden. This question is regularly decisive in a situation when the respondent is in default, and the complainant has little to no information about respondent's actual business activities and potential interests in the domain name. Is it sufficient in that situation if the complainant simply states that to her knowledge, there is nothing which is apparent which favours the respondent, or is it necessary to undertake and present more thorough investigations? It seems that the attitudes towards the issue vary amongst Panels: while some have been quite stern in this respect, and have rejected complaints where the complainant in their view did not undertake sufficient efforts to meet his burden[71], others are less demanding[72]. With a certain *caveat* – because a detailed analysis has not been undertaken concerning this point – it might be argued that the number of decisions in favour of the complainant in default cases would hardly be as clearly surpassing the general average, if all Panels generally applied the same, strict standards.

Another point where the relevance of the standards applied when assessing whether the respective parties have met their burden of proof becomes particularly obvious is the evaluation of contentions by the respondent, stating that the choice of the domain name had nothing to do with complainant's mark (which the respondent claims he did not even know of), but that it was chosen because of its descriptive/allusive character matching the private or business purposes which are intended to be carried out on the website. What degree of plausibility or probability is required to support the explanation? If it is accepted as a starting point that the burden is shifted to the respondent after the complainant has established a *prima facie* case (see above), it still remains unclear whether this means that the respondent necessarily loses in case of remaining doubts – in other words, that he has to bear the ultimate burden of persuasion -, or whether the burden is shifted back to the complainant as soon as the allegations of the respondent at least appear plausible.

As there are no fixed rules on these matters, each Panel has to cope with them individually. This can, and indeed does, lead to a certain inconsistency in the decisions. With all necessary caution, the findings of this study may be taken as an indication that this aspect accounts for the differences in the overall results in cases decided by eResolution Panels as opposed to WIPO (and NAF) Panels: as the proportion of rejections is considerably higher in decisions by eResolution Panels when the respondent has invoked a right of his own, or has referred to the descriptiveness of the mark in question, than in decisions by WIPO Panelists[73], this may suggest that eResolution Panelists in general take a stricter attitude towards the complainant's burden of proof and the

standards required in the context.

It has been suggested that because of the fact that the complainant chooses the Dispute Service Provider, there is a direct relation between the readiness with which Panels accept that a domain name should be transferred to the complainant, and the Provider's market share, and that in order to achieve a narrow and consistent application of the Policy, the choice between Dispute Service Providers should rather be made by the registrar^[74]. While this is a proposal worth discussing, the analysis on which it is based is not totally conclusive. While the Providers may be striving to increase their market share, the decisions themselves are made by the independent Panelists. At least according to the general concept, which according to the information available to this author is observed also in practice, the Providers do not attempt to influence the outcome of decisions – with the possible exemption of cases when it becomes obvious that the Panelist has totally misunderstood the Policy.

Nevertheless, the argument that decisions in favour of the complainant at least indirectly tend to increase one's own "market share" might also be valid with regard to the individual Panelists. On the other hand, given the structure of UDRP fees to which reference has been made above (I 3.1), to increase one's occupation as a UDRP Panelist hardly constitutes a very tempting option for the very specialised persons involved. There remains however a certain risk that Panelists, by handing down decisions which are markedly in favour of right holders might seek to increase their popularity in the trademark community at large, and to profit from this effect for their regular work, in particular as a lawyer or trademark attorney.

Whatever the reasons may be – the statistically significant difference in the outcome of decisions handed down by different Providers' Panels remains remarkable or even troubling, and it calls for further consideration. As was stated initially in this chapter, burden and standards of proof seem to constitute a key issue in the context. This is underlined by the fact that these issues are closely connected with another, more fundamental question, namely how the Panelists view the aim and function of the UDRP and their own role therein. If it is strictly observed as a general principle that the UDRP only serves the purpose of granting relief in clear piracy cases, the complaint must be rejected whenever any of the three elements mentioned in Art. 4 a cannot be established by clear and convincing proof, no matter where the burden of producing evidence lies at the time when the decision is made. However, if the idea prevails that the UDRP should function like some sort of "normal" summary proceeding in court, it would be more logical to decide in favour of the complainant if the respondent, after the burden was shifted to him, cannot establish his case at least with a reasonable preponderance of the evidence.

It goes beyond the purpose of this study to decide which of these two attitudes is correct, or is preferable vis-à-vis the other. Again, it shall only be pointed out that in the interest of transparency and legal security, the issue should be addressed and discussed openly.

2.3.3.2.3 [Default](#)

Another question to be considered in the context concerns default cases. Panelists may have problems dealing with such cases simply because in absence of any response, it can be even more difficult than otherwise to evaluate the credibility of complainant's contentions, and to decide on complex issues like absence of rights and legitimate interests or on bad faith. To decide the case without sufficient information as regards the position of

one of the parties involved may leave the Panel with feelings of uneasiness. Furthermore, as the approach regarding the burden and standards of proof is subject to uncertainties, this is another source for inconsistency.

The problems might be eased considerably if it were established as a general rule that if a respondent does not answer the claim within the appropriate time, the registration can be considered as forfeited, leading to cancellation and possibly also to transfer of the domain name to the complainant.

The Panel would thus be spared the trouble of making a decision on the merits. Consequently, if such a rule were adopted, it might even lead to a reduction of fees, as the workload for the Panel is obviously much lower if it is sufficient for the decision to refer to the fact that the respondent is in default, instead of having to motivate the finding in respect of all three elements contained in the Policy. This would be another advantage for the complainant, who of course also profits from the fact that the complaint is automatically granted – a result which, on the other hand, to a large extent complies with the outcome to be found under the current practice. Even for the respondent, the solution might have some advantages, as he is spared the verdict of having acted in bad faith. Cancellation (or transfer) of the domain name would simply be regarded as constituting a reaction to respondent's inactivity, and not as a sanction for reprehensible conduct.

Nevertheless, the proposal is not without its problems and risks. Introducing cancellation (and/or transfer) of the domain name as an automatic consequence of inaction would only be feasible under the condition that it can be guaranteed that the respondent receives sufficient time and opportunity to answer the claim. Already under the present conditions, when a Panel is obliged to make a decision on the merits even in case of default, it has been claimed repeatedly that the UDRP is not fairly balanced insofar as the position of the respondent is concerned, as it does not provide for sufficient time to prepare and file an answer, whereas there are in principle no time constraints as regards the deliberation and preparation of the complaint, before it is actually filed. If the consequences would be more severe than they are to-date, this argument would of course gain in importance.

In the opinion of this author, it would however not be a viable argument to hold that the rule proposed for consideration in the previous paragraph would not be compatible with established principles of fair trial. As was pointed out initially (under I 3.2), the UDRP is not law in the usual meaning, and Panels are not judges. The rules applying in the framework of the UDRP are part of the contract concluded between the domain name registrant and the registrar, who, in his turn, has accepted to be bound by the rules by virtue of its contract with ICANN. This leads to the following observations:

- a) As a matter of principle, the decisive question would be whether the inclusion of a clause stipulating that failure to react, within a given time, to a complaint filed with a UDRP Panel, leads to cancellation (or transfer) of the name would clash with principles of *contractual* law, in particular the legal rules of national law applying to contracts on standard terms. Again, notwithstanding further investigations in the matter, there seems to be a good chance that such a clause – which would amount to a contractual obligation to respond to a complaint filed, with the consequence of dissolution of the contract in case of non-compliance – could be regarded as legally valid. This applies however only under the condition pointed out above, namely that the interests of the respondent to be granted sufficient time and opportunity to respond are safeguarded to the best possible degree.
- b) The considerations under a) are however only applicable with respect to contracts which are concluded *after* the introduction of such a rule. As this would amount to a substantial change in the Policy, with possibly detrimental effects to the respondent, it would hardly be possible to incorporate it retroactively into contracts

which have already been concluded. This assessment is made irrespective of the fact that the contract may contain a clause by which the registrant agrees to be bound by future changes of the UDRP rules, as the extent to which the registrars and others may rely on such a clause is in itself subject to control under the rules of national law applying to contracts on standard terms.

3.3 *[Should There Be a Possibility for Appeal?](#)*

In the context of the present study, the question necessarily arises whether the system should be complemented by establishing an appeal instance, in order to take care of the inconsistencies. One possible answer to this is that such an option is unnecessary, simply because the possibility always exist to take the case to court.

Indeed, to review the functioning of the UDRP remains incomplete without addressing and possibly also examining the interaction between the administrative system provided by the UDRP rules and the ordinary courts operating under national jurisdiction(s). In the beginning, it had been intended to include a chapter on this matter in the study, but it turned out that for the time being, it is not possible to obtain sufficient material on the issue, to furnish a solid basis for the analysis.

Anyhow, inasfar as references to court proceedings following UDRP decisions have been published, they tend to confirm the general expectation that the decisions are rather seldom challenged in court^[75]. Different reasons may account for this. In some or even many cases, the losing party may be aware of the fact that the result would not be different if the matter were considered by a national court. This may even be true in respect of cases where the complaint should not have been granted, if the Panel had departed from a narrow, restrictive application of the Policy^[76]. In some cases however, the reluctance of losing parties to initiate subsequent court proceedings may simply be due to the fact that they shun the trouble (and expense) of going to court even if they feel that the decision was blatantly wrong. To install a possibility for appeal within the system would help to clarify this point.

Several aspects must however be taken into account when embarking on a discussion concerning the introduction of an option for appeal. One of them is the fact that the whole UDRP system is contract-based, without having a specific legal basis in any national law or international agreement (see supra, I 3.2). Accordingly, any substantial enlargement of the Policy and its procedural framework will only be legally valid if it complies with requirements of balance and equity which are set out in most countries' legislations with respect to such contracts. It would be premature to speculate at this stage about the consequences this might have for the question at stake.

Second, if the primary task of an appeal body should be to provide for clear and unequivocal guidelines and precedents that help to reduce inconsistencies, it should preferably be construed as an independent institution, not being linked to any of the present Providers, and possibly limited to a certain number of members sitting in permanence. Otherwise, the perplexities created by the sheer number and various legal backgrounds of UDRP Panelists might simply be transposed to a higher level, and nothing would be gained. It is obvious however that to implement such a model would create not least financial problems, the dimensions of which have to be explored thoroughly.

III [Summary and Proposals](#)

1. As a matter of principle, the UDRP is functioning satisfactorily. No major flaws have been identified in the course of the evaluation.
2. It was however confirmed that considerable differences exist with respect to the outcome of decisions handed down by eResolution Panels on one hand and NAF and WIPO Panels on the other.
3. Furthermore, several issues have been identified where the application of the Policy is unclear and needs further consideration. This concerns in particular:
 - a) the conditions under which a domain name is found to be "confusingly similar" with a mark,
 - b) measures to be taken in order to safeguard the interests of free speech,
 - c) rules concerning the burden of proof and the standards to be applied in the assessment of the parties' contentions.
4. In order to overcome the present inconsistencies, an effort should be made to arrive at an even better understanding of the aims and the scope of the Policy between all Providers and Panelists. This calls *inter alia* for a conscious decision to be made in respect of the approach to be taken in the future, i.e. whether the UDRP should be broadened in order to encompass more than just the very clear cases of domain name piracy, or whether it should remain restricted to its original aims.
5. In particular with respect to default cases, it should be considered whether and under what safeguards a rule might be introduced for the future, stipulating that in case of default, the respondent forfeits its right to the domain name, without the Panel having to make a decision on the merits of the case.
6. It should be investigated whether and in what form the possibility to lodge an appeal against UDRP decisions should be installed in the framework of the UDRP system.

[Annex 1](#)

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Questionnaire (translation from the German original)

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1. Complainant's right
 - registered trademark

- tradename or other business identifier
 - other (please indicate)
2. Identity/similarity between distinctive sign and domain name
- a) degree of similarity
 - identical
 - very similar
 - similar
 - low degree of similarity
 - b) type of similarity
 - variation without specific meaning
 - prefix or suffix
 - disparaging (-sucks etc.)
 - descriptive (geographical etc.)
 - other (please indicate)
3. Respondent's right
- respondent does not claim a right of his own
 - respondent claims a name or distinctive sign of his own
 - other (please indicate)
4. Use made of the domain name
- registration only
 - commercial use
 - private use
5. Indication of bad faith
- mass registration of domain names
 - unsolicited offers to right holder or third parties
 - misleading or obstructive use of domain name
 - no indication of bad faith
 - other (please indicate)
6. Respondent's defenses (other than 3)
- domain name is descriptive

- complainant engages in reverse hijacking
 - other (please indicate)
7. Result
- Transfer
 - Cancellation
 - Rejection of claim
8. Type of Panel
- sole Panelist
 - full Panel

[Annex 2](#)

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compiled by Petra Sund-Norrgård

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[2] Available at the WIPO website, under <http://wipo2.wipo.int/process1/report/index.html>

[3] Rough Justice, p. 19.

[4] Rough Justice, p. 18.

[5] Withdrawals etc. are not counted

[6] See the previous footnote. Of the total comprising 2333 completed cases, 472 have been withdrawn/terminated and are therefore not included in the above figure of 1815 decisions.

[7] Concerns in that respect have been expressed e.g. in the article by Daid G. Post, *Juries and the UDRP*, posted on the Internet on 06 Sept. 2000, at http://www.icannwatch.org/archive/juries_and_the_udrp.htm

[8] They were however allowed to skip cases for language reasons – e.g. when decisions were written in Spanish, which most of the participants did not master.

[9] According to the “Rough Justice“ study which is based on an evaluation of the first 621 cases decided between December 1999 and June 2000, the distribution of cases between all four Providers (CPR having only been admitted in May 2000) was as follows: WIPO: 61 %, NAF 31 %, eResolutions 7 % and CPR 1 %.

[10] The decision was split in its results in (at least) two cases, D2000-819 (usacanon.com etc.) and D2000-836 (ncaamensbasketball.com etc.), where transfer was ordered only in respect of some of the registered names.

[11] The issue of protection for personal names as well as for geographical designations has been under consideration in the second WIPO domain name process, the results of which have been submitted to ICANN in August 2001.

[12] See e.g. D2000-1769 (neusiedler.com), where the complaint was rejected on the ground that the use of the geographical designations (“Neusiedler See“ is the name of a lake in the border region between Austria and Hungary) should be kept free.

[13] The figures refer to the range of questions in the questionnaire.

[14] In the detailed analysis, it was found that this number is even higher, because the participants sometimes chose the answer "other right" or "trade name" in situations when the complainant did in fact own a registered trademark right corresponding in the domain name and merely invoked other, non registered rights in addition to that.

[15] Also D2000-0847 (madonna.com) was among the cases included in the survey, but as the artist could rely on a registered trademark, it was not counted as a decision founded (solely) on name rights.

[16] AF-0252 (granapadano.com) in that case, the complaint was granted in contrast to decision D2000-0629 (parmaham.com).

[17] In D2000-0617 (StMoritz.com), which was also included in the survey, the complainant association (Kur- und Verkehrsverein St. Moritz) could rely on a registered trademark in the name, so that this case was not counted among the cases where the decision was (solely) based on a geographical designation. Also in that case, the complaint was denied. The same applies to D2001-0001 and D2001-20002 (portofhamina.com, portofhelsinki.com). The outcome was different in D2000-1224 (sydneyoperahouse.net), where the complaint for transfer by the Sydney Opera House Trust was granted. See also D2000-1217 (skipton.com), where the town name corresponded to the registered mark of complainant's company.

[18] One example for an exemption from this rule can be found in FA 94964 (quirkchevrolet.com etc.)

[19] This is stated many times in the decisions, see e.g. FA 96374 (clbooks.com); D2000-0416 (fieldofdreams.com); D2000-0222 (dodgevip.com); D2000-1072 (newyorktimes.com). However, depending on

the circumstances, the presence of disclaimers may be an additional element supporting the conclusion that the domain name registrant is not acting in bad faith; see e.g. FA 93631 (soundchoice.net); D200-0232 (al-anon-alateen.org).

[20] In one of the cases included in the survey (AF-0216 a-c), it was however held that because of the addition of the TLD, there was no identity but only confusing similarity between the domain name and the sign

[21] This applies also to cases like D2000-1409 (variations of the Sony name) or D2000-0836 (ncaamansbasketball.com, etc.).

[22] In one of these cases, D2000-1246 (dcpglobal.com etc.). The Panel had found the domain name being confusingly similar from the protected sign, DCP standing (for Digital Channel Partners Ltd.). It is not clear why the person evaluating this case departed from this assessment.

[23] See already supra. In the same vein: D2000-1417 (a1tv.com), where according to Panel the complainant failed to establish that the right it owned in the registered device mark containing both “a” “1” and “tv” actually covered the combination of letters and numerals appearing in the domain name. In the evaluation, mark and domain name were classified as “similar”.

[24] In contrast to that, the domain name “natwestsucks”, was classified by the Panel as well as in the evaluation as “very similar”. On D2000-1455, which includes inter alia the domain name “maclanenortheastssucks.com”, see *infra*.

[25] Esmas meaning "is more" and eresmas meaning "you are more" in Spanish.

[26] Lucent Technologies Inc. v. Lucentssucks.com, 95 F. Supp. 2d 528, 535 [E.D. Va., May 3, 2000].

[27] In FA 96219 (lycra-lovers), the respondent argued in vain that the same assessment as for “-sucks” should also apply for names containing “-lovers”, i.e. that confusing similarity should generally be excluded.

[28] The complaint was also denied in respect of the other domain names involved in parallel cases, AF-0107 a (kittinger.com) and AF-0108 a, b (kittenger.com, kittengerfurniture.com), because the respondent had a long-standing business of selling used kittinger furniture. See also D2000-0819 (usacanon.com etc.).

[29] Other examples for this strategy can be found e.g. in D2000-1004 (abercrombie.com etc) and in D2000-0848 (actavista.com etc.).

[30] One explanation lies probably in the fact that many decisions comprise more than one domain name, including different kinds of variations.

[31] As far as can be seen, the results were the same in other “-sucks” cases, which were not included in the survey, see e.g. Diageo PLC v. John Zuccarini, D2000-0996 (guinness-really-sucks.com etc). The argument was that -sucks is not known as being a slang word in the English language to foreigners, and that they might therefore be misled into believing that the abuse sites were sponsored by Guinness.

[32] The default cases are also hidden in this figure.

[33] The author regrets this omission retrospectively. However, with a more detailed enquiry into the questionnaires, it was possible to achieve an approximation to the actual figures; see *infra*, 2.3.2.3.

[34] Further cases in this category include: D2001-0035 (the-warehouse.com); D2000-1454 (liberty.com); D2000-1505 (usavideo.com); FA94946 (avengers.com); FA 94990 (osho.com); FA 94996 (Atmonline); FA 93631 (soundchoice.net); AF-0121 (launchpad.com); D2000-0074 (microinfospace). In some of these decisions, it was

considered doubtful by the Panels whether the respondent did in fact have a valid right, and/or whether it did in fact render the choice and use of the domain name legitimate; still the claims were dismissed on the ground that it is the complainant who principally bears the burden to establish the presence of all elements in the Policy.

[35] See also FA 92975 (phonesspell.com, phonespel.com, phonespell.net, phonespel.org), where the respondent had been doing business under the name which was not protected for either of the parties. See also FA 93466 (Westernhay.com).

[36] See however e.g. D2000-1038 (marutionline.com) and D2000-0434 (bungeishunju.com, bunshun.com). Both cases involved long-standing quarrels between the parties, still the Panels found the name conflict to be sufficiently clear for an order of transfer.

[37] See however AF-0149a (gassan.com), where the respondent claimed that he had been commissioned to register the name “on behalf of his clients Mr Abdoullaev and Mrs Edit Gassan“. Although the respondent did not procure the contract or any other evidence, the complaint was dismissed, as the onus to prove lack of legitimate interest lay primarily on the complainant. See also AF-0133, rbcinsurance, where the Panel accepted that the acronym related to Rahim Bismillah (Crop Insurance) rather than the complainant, the Royal Bank of Canada. This finding may have been further motivated by the fact that the respondent did make non-commercial use of the site, giving information about inter alia crop insurance.

[38] See also D2000-0428 (yahooemail.com etc.), where the respondent had argued inter alia that yahoo was common dog’s name and meant "beast" in the Spanish language.

[39] It is another question under which circumstances a site will be qualified as "noncommercial". This study does not investigate the issue any further.

[40] In addition to that it was contested – and in D2000-0858 (ahmanson.org) the Panel denied – that the complainant had valid rights in the name.

[41] See also D2000-0658 (nikcarter.com, -.org. and -.net) where the respondent used the sites for disparaging and tarnishing statements about the complainant; further: D2000-0231 (lloydstsb-visa.com).

[42] According to information available at <http://www.udrplaw.net/UDRPappeals.htm> , this decision has been appealed in court.

[43] In addition to the domain being descriptive, the complainant could not establish a right in the name.

[44] But see marutionline, where the claim for transfer was granted

[45] In connection with the argument that the respondent could not establish demonstrable rights in the name; see also AF-0076a, b, c (powrachute.com, -net, powrachutes.com, -net).

[46] The outcome was different in D2000-0627 (polyesthers.com).

[47] Tony Willoughby, one of the majority Panelists in dw.com, had been the dissenting Panelist in D2000-0622 (K2r.com). In “dw.com“, the dissenting Panel was Torsten Bettinger.

[48] If the figures mentioned above are accepted, findings in favour of the complainant would amount to nearly 95 %. For the reasons mentioned in the above text, it must however be assumed that the actual percentage is somewhat lower.

[49] The Panel came to a different conclusion in D2000-1424 (armaniboutique.com).

[50] D1999-0001 (worldwrestlingfederation.com).

[51] See e.g. D2000-0059 (barneysnewyork.com), where the respondent in vain tried to argue that inaction would save him from being held liable for (registration and) use in bad faith.

[52] In 1.86 % of the answers, the question was skipped (“no comment”)

[53] The question whether it suffices for a finding of bad faith in the meaning of the Policy if a person learns about the conflicting sign after having registering it in good faith, and then tries to derive profit from the domain name, is one of the controversial issues in the context of Art. 4 b; further on this point see below.

[54] Further: FA 96348 (stlouiscountycab.com)

[55] See further D2000-0807 (findus.com), FA 93681 (dogs.com), AF-0122 (shopzone.com), D2000-0459 (justforkids.com).

[56] See further AF 298 a-d (satellitikonos.com, spaceimagingsatellite, ikonospacephoto.com, ikonosatellitephoto.com)

[57] In the same vein: D2000-0422 (athome.com, atwork.com).

[58] According to information available at <http://udrplaw.net/UDRPAppeals.htm> , this decision is under court appeal.

[59] See further D2000-1426 (e-creditlyonnais.com), where the allegedly altruistic motives – to draw the attention of large industrial and financial groups to the problem of excluded children in Romania – were neither acknowledged as furnishing a legitimate interest nor as excluding bad faith.

[60] similarly: D2000-0838 (concerning inter alia the domain name “no-walmart.com“).

[61] It might be argued that, not least as a consequence of the currently more extended application of the Policy, the public has been influenced to believe that the use of any domain name including a trademark needs to have an authorization by the right holder, so that an actual risk to mislead always exists if that requirement is not met. Indeed, on the basis of such an argument, it might happen in the long run that the public believes that even the “-sucks“ sites may only be operated under the supervision of right holders. In this manner, the Policy would operate as a self-fulfilling prophecy. Whether this effect is desirable, remains an open question.

[62] See in this respect the Panelist’s comments in AF-0222 (efads.com).

[63] This aspect is considered by the Panels already today. However, it might gain additional weight and lead to further problems if the complaint had to be dismissed whenever an actual risk of confusion is found to be absent.

[64] There are however cases where complainants have obviously believed that the UDRP serves other purposes than what it was meant for, see e.g. AF 0170 a-c (presidentchoice.com, -org. and -.net).

[65] See FA 94964 (quirkchevrolet.com etc.) and further cases cited *supra* under 2.3.2.1.7.

[66] In D2000-0819 (usacanon.com etc.; see on this case *supra*, under 2.3.2.1.3)

[67] See in particular D2000-0020 (saint-gobain.net) further cases cited *supra* under 2.3.2.1.7.

[68] Similar considerations apply in respect of cases when a mark is used in order to indicate dealership.

[69] The importance of these issues has been emphasized in particular in the article by T. Willoughby, The

Uniform Dispute resolution Policy From the Perspective of a WIPO Panelist, Trademark World Nr. 134, p. 34 *et seq*

[70] T. Willoughby, *loc. cit.*

[71] See in particular D2000-0419 (armaniexchange.net); AF-0257 (irenegari.com); D2000-0608 (azzaro.com)

[72] For an example see D2000-1229 (tacobell.net).

[73] See on this point under 2.3.2.1.1.

[74] See the “Rough Justice“ Study by Dr. Milton Mueller, 4.5

[75] See the information available at <http://www.udrplaw.net/UDRPappeals.htm> . According to that list, five of the decisions included in this survey have been appealed to court, namely D2000-0222 (dodgeviper.com), D2000-0210 (juliaroberts.com), D2000-0715 (corinthians.com) and D2000-1038 (marutionline.com) and D2000-0836 (ncaamensbasketball.com etc.).

[76] Under national law, the legal possibilities for courts to enjoin further use of a domain name which is in conflict with another person’s distinctive sign may be significantly more extensive than under a strict application of the UDRP. For instance, pursuant to the US ACPA, bad faith registration or use of a domain name are not only prohibited if it is confusingly similar with a mark, but also if it results in blurring or tarnishment of a mark (provided that it is famous). Therefore, even if the assessment of “confusing similarity“ in a case decided under the UDRP in practice may have been broadened so as to include even cases of blurring and tarnishment, it still makes little sense for the respondent to take the matter to a national (US) court, where high fees would be incurred without a realistic chance of obtaining a more favourable decision.