

The Domain of Trademarks

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Road Map of Issues

- Uniform Domain Name Dispute Resolution Policy (“UDRP”)
- Process and Procedure
- Bad Faith
- Dilution Claims

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UDRP

- The UDRP (Uniform Domain Name Dispute Resolution Policy) was adopted in late 1999 by ICANN (the private authority responsible for the administration of certain Internet technical parameters) to offer an alternative to litigation in local courts to settle complaints by trademark owners about cybersquatting.

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UDRP

- The UDRP created its own definition of "bad faith registration and use" of domain names, and identified some situations that would be considered defenses to a trademark complaint (rights and legitimate interests). UDRP proceedings are binding on all domain name holders in .com, .org, .net, .info and .biz as well as [ccTLDs] and can result in the cancellation or transfer of the domain registration to the trademark owner.

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UDRP

- Procedure
 - Cases are decided by individual Panelists who serve one of four resolution service Providers .
 - No single entity to which these conflicts can be appealed.

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UDRP Process

- Key Elements
 - 45 days for adjudication
 - Less expensive, as little as \$750
 - Uniform guidelines
 - Streamlined filing procedures
 - Can be done pro se

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UDRP Process

- Day 1
 - The complainant files a complaint with the provider of his choice and sends a copy to the respondent (holder of the domain name) at the address shown on the registrar's Whois database.
 - After review of complaint by Provider, if deficient, 5 days to amend.

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UDRP Process

- Day 3
 - Provider must send a copy of the complaint to the registrar of the domain name in question and a copy to the respondent.

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UDRP Process

- Day 20
 - the respondent must respond specifically to the allegations in the complaint and offer any bases for the retention of the domain name.
 - Default if no response is filed within this 20-day window

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UDRP Process

- Day 28
 - After the receipt of the respondent's response to the complaint, the provider has 5 days to appoint a panel.

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UDRP Process

- Day 42
 - A decision will be rendered within 14 days of the panel's appointment.
- Day 45
 - The panel has 3 days to notify the parties of the decision.

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UDRP Process

- Within 10 days after the decision:
- Unless the adversely affected domain name holder has filed suit in a court of mutual jurisdiction by this date, the registrar will implement the decision of the panel, canceling or transferring the domain name according to the remedy sought in the complaint

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UDRP Process

- Mutual Jurisdiction
 - means a court jurisdiction at the location of either (a) the principal office of the Registrar (provided the domain-name holder has submitted in its Registration Agreement to that jurisdiction for court adjudication of disputes concerning or arising from the use of the domain name) or (b) the domain-name holder's address as shown for the registration of the domain name in Registrar's Whois database at the time the complaint is submitted to the Provider.

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UDRP "Bad Faith"

- To prevail in a domain name dispute under the UDRP, the complainant must prove that the disputed domain name "has been registered *and is being used* in bad faith."

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UDRP "Bad Faith"

- (i) the domain was registered primarily for the purpose of selling it to the complainant or a competitor for more than the documented out-of-pocket expenses related to the name

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UDRP “Bad Faith”

- (ii) the domain was registered in order to prevent the mark owner from using it, provided that the registrant has engaged in a pattern of such registration

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UDRP “Bad Faith”

- (iii) the domain was registered primarily to disrupt the business of a competitor
- (iv) by using the domain, the registrant has intentionally attempted to attract users for commercial gain by creating a likelihood of confusion as to source or affiliation .

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UDRP “Bad Faith”

- Burden of Proof
 - The requirement that Complainant prove bad faith does not relieve Complainant of its burden of proving confusing similarity and the lack of legitimate rights or interest in the domain name.
 - Despite the use of the conjunction “AND” in the Policy, some panels have only required that Complainant show that Respondent either registered the domain name in bad faith OR is using the domain name in bad faith.

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UDRP “Bad Faith”

- In addition, some Panels, beginning with [WIPO/D2000-0003](#) (telstra.org) have determined that, under certain circumstances, non-use or passive use of a domain may be evidence of bad faith. Thus, some panels have, in effect, determined that bad faith registration alone is sufficient. In Telstra, the panelist could not conceive of any possible legitimate right or interest that the domain holder could make of a famous, coined Australian mark.

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UDRP “Bad Faith”

- In [jackspade.com](#), [WIPO/D2001-1384](#), the panelist held that when a mark is proven, the burden then shifts to the domain holder to prove a right or legitimate interest and non-use for three years supported a finding of a lack of right or legitimate interest.

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UDRP “Bad Faith”

- However, other panels require proof of both registration and use base their reasoning on statutory interpretation and general concepts of trademark law.
- Trademark law itself does not ordinarily find infringement in the absence of active commercial use

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UDRP "Bad Faith"

- Trademark law does not grant a mark owner worldwide exclusive rights in a name nor should the UDRP.
- The UDRP should only be invoked when there is a specific intent to harm the mark owner.
- Mere registration of a single domain name simply does not prove any of these elements.

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UDRP "Bad Faith"

- Telstra is distinguished on the grounds that famous marks have always enjoyed special protection against new uses (even new non-competing uses), however such rights are unique to famous marks and should not be applied to non-famous.

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Dilution Claims

- Mosley v. V Secret Catalogue, Inc. 537 U.S. 418 (2003)
- "Victor's Secret" name of independent shop
- Victoria's Secret, famous mark
- Claim "the dilution of famous marks" under the Federal Trademark Dilution Act (FTDA).

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Dilution Claims

- The name of the store was similar, but not identical, to the trademark owners' mark.
- In the dilution claim, the trademark owners alleged that the store owners' conduct was likely to blur and erode the distinctiveness and tarnish the reputation of their trademark.

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Dilution Claims

- The store owners did not challenge the claim that the trademark owners' mark was famous.
- The Court determined that the trademark owners were required to show actual dilution, rather than a likelihood of dilution.

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Dilution Claims

- There was a complete absence of evidence of any lessening of the capacity of the trademark owners' mark to identify and distinguish goods or services sold in the trademark owners' stores or advertised in their catalogs.

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Dilution Claims

- In addition, difficulties in obtaining proof of actual dilution were not an acceptable reason for dispensing with proof of an essential element of a statutory violation.
- The evidence in the record was not sufficient to support the summary judgment on the dilution count.

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