The New Singapore Domain Name Dispute Resolution Policy: The Context of the Common Law and ICANN's UDRP

Richard Wu†

Introduction

Domain name disputes are a by-product of the growth of the Internet and electronic commerce. Although domain name registration began in the United States in the early 1980s, few disputes ensued then as use of the Internet remained largely in the realm of academic circles. When the Internet and electronic commerce became popular in the mid-1990s, many commercial companies came to realize the marketing and sales potential of domain names. They flocked to register domain names and the demand for domain names spawned astronomically. As the registered number of domain names grows, domain name disputes occur much more frequently.

On November 6, 2001, the Singapore Network Information Centre (SGNIC) adopted the Singapore Domain Name Dispute Policy (the Policy).[1] This represents the efforts of Singapore to strengthen its management of domain name disputes, particularly for cybersquatting cases. The Policy, however, is only concerned with disputes over registration and use of *.sg* Internet domain names registered with the SGNIC Private Limited. The administrative proceedings under the Policy are conducted according to the Rules for the Singapore Domain Name Dispute and Policy[2] and the Supplemental Rules for the Singapore Domain Name Disputes Resolution Policy[3] issued jointly by the Singapore Mediation Centre and the Singapore International Arbitration Centre.

In this article, I will analyse the salient features of the Policy and evaluate the extent to which they match international practice. I will focus, in particular, upon the Uniform Domain Name Dispute Resolution Policy (UDRP)[4] and the rules made under the UDRP.[5] The Internet Corporation for Assigned Names and Numbers (ICANN),[6] the international body responsible for domain name management, adopted both in 1999. As the nature of domain name disputes and dispute resolution rules are very similar in different countries, domain name disputes are becoming a global phenomenon, leading to the development of a kind of "Internet common law".[7] I will, therefore, discuss new developments in other common law countries such as the United Kingdom (U.K.) and United States (U.S.), as they will invariably influence Singapore in its interpretation of the Policy. I will also evaluate both the merits and demerits of the Policy. In conclusion, I will analyze the significance of the Policy for Singapore.

Salient Features of the Policy

Grounds for complaint

Under the Policy, a complainant can commence mandatory administrative proceedings against the registrant of an *.sg* Internet domain name registered with SGNIC if the complainant satisfies three criteria. First, the registrant's domain name must be identical or confusingly similar to a name, trademark or service mark in Singapore in which the registrant has rights. Second, the registrant must have no rights or legitimate interests in respect of the domain name. Third, the registrant's domain name must have been registered and used in bad faith.[8] The Policy, therefore, contains what I will call "the trilogy of cybersquatting", namely, the domain name is identical or confusingly similar to an existing trademark or service mark; the domain name registrant has no legitimate interests in the domain name; and the domain name registrant registers and uses the domain name in bad faith. In fact, these three elements also appear in the UDRP.[9]

Rights of complainants

If a complainant registers in Singapore a trademark or service mark identical or similar to the domain name in dispute, there should be no difficulty in proving the first criterion required under the Policy, namely, the complainant's rights. The position is less clear, however, if the complainant has *not* registered any trademark or service in Singapore. In fact, *unregistered* trademark

†Associate Dean, Faculty of Law, University of Hong Kong. LLB, PCLL (HKU), BSc, LLM (London), MBA (Warwick), LLB, LLM (Peking). Solicitor (Hong Kong, England and Wales, Australia (ACT and NSW) and Singapore.

rights emerged as an issue in many decisions made under the UDRP. In the case of *Jeannette Winterson v. Mark Hogarth*,[10] the complainant, Jeannette Winterson, was a famous U.K. writer. The respondent registered the domain names *jeannettewinterson.com*, *jeannettewinterson.net* and *jeannettewinterson.org*. The panel ruled that as long as the complainant had legal right to a trademark, the UDRP did not require the complainant's trademark to be registered by a government authority or agency. The panel relied on the previous UDRP decision of *Cedar Trade Associates Inc. v. Greg Ricks*.[11] It further held that trademarks, where used in the UDRP, are "not to be construed by reference to the criteria of registrability under English law, but more broadly in terms of the distinctive features of a person's activities".[12]

In another UDRP case, *Gordon Sumner, aka Sting v. Urvan*,[13] however, the panel came to a different ruling. The complainant was the famous singer Sting, while the respondent, Michael Urvan, was an amateur gamer. Urvan registered the domain name *www.sting.com* for sending e-mails and global Internet gaming services. The panel ruled against the complainant and held that personality right was not intended to be made subject to the UDRP.[14] The panel also distinguished this case from the *Winterson* case in that the word "sting" is a common English word with a number of different meanings.[15] In other words, the *Sting* case favoured a restrictive interpretation of complainant's rights under the UDRP.

In the recent Hong Kong case of *Outblaze Limited v. Wah Cheung Leatherware Company Limited*,[16] decided under the Hong Kong Domain Name Registration Company Limited (HKDNR) Domain Name Dispute Resolution Policy,[17] the Hong Kong arbitrator decided that it was *not* necessary for the relevant trademark rights to be registered before the complainant could lay claim and establish rights to a mark.[18] In the decision, the arbitrator held that:

> … there is a *sufficient level of reputation* in the trade and industry in Hong Kong and the region in the unregistered "OUTBLAZE" mark belonging to the Complainant as to give the Complainant a claim of passing off, and hence sufficient to constitute the Complainant's trademark rights for the purpose of paragraph 4(a) of the Policy.[19]

The Hong Kong arbitrator in the *Outblaze* case therefore interpreted "complainant's rights" to include *unregistered* rights. He also developed a "reputation test" to deal with complainant's rights. It remains to be seen whether the panels in Singapore will adopt similar interpretations of complainant's rights under the Policy in future.

Confusingly similar

On the criterion of "confusingly similar" required under the Policy, some case law decisions in other common law jurisdictions are relevant to Singapore. In the United Kingdom, a similar issue arose in the recent case of *Avnet Inc. v. Isoact Ltd.*[20] In the *Avnet* case, the plaintiff was a distributor of electronic components and computer software and registered a trademark "Avnet". The defendant, on the other hand, was an Internet Service Provider that used the domain name *avnet.co.uk*. The plaintiff commenced proceedings against the defendant, arguing that there would be confusion over the word "avnet" on the Internet with "search engines and the like producing the wrong Avnet. A person looking for them might either give up or somehow get into some other sort of muddle".[21] Jacob J., however, disagreed with the plaintiff. He took the view that a customer "could see immediately that he is not getting an advertisement for semiconductor chips and the like, but things to do with aviation instead". Jacob J. also noted:

> It is a general problem of the Internet that it works on words alone and not words relating to goods or services. So, whenever anyone searches for a word even if a searcher is looking for the word in one context, he will, or may find, Web pages or data in a wholly different context. This may be an important matter for the courts to take into account in considering trademark and like problems.[22]

By contrast, the U.S. adopted a more straightforward interpretation of the term "confusingly similar". In the U.S. case of *Northern Light Technology, Inc. v. Northern Lights Club*,[23] Woodcock J. briefly discussed the legislative history of the U.S. *Anticybersquatting Consumer Protection Act* (ACPA).[24] He held that the term "confusingly similar" in the ACPA merely required the court to compare directly the domain name and the alleged offensive trademark,[25] not the traditional and more comprehensive trademark infringement test of "likelihood of confusion".[26]

It remains to be seen whether the panels in Singapore will favour the U.K. or U.S. approach. As a matter of practicality, it is submitted that the U.S. approach is preferable because it enables the arbitrators to determine domain name disputes in a speedy manner, which is compatible with the expedient resolution goal of the Policy.

Using the domain name

In the Policy, the complainant needs to prove that the holder registers and *uses* the domain name in bad faith. However, it may not be easy to prove that the domain name is "used". In other common law jurisdictions, there is a growing body of case law on the meaning of the term "use". For example, in the famous English case of *Marks & Spencer Plc v. One in a Million Ltd. & Others*,[27] the defendant registered many names of famous companies as domain names, such as *Ladbrokes.com*, *sainsbury.com*, *sainsburys.com*, *marksandspencer.com*, *markspencer.co.uk*, *cellnet.net*, *bt.org*, *virgin.org*, *britishtelecom.co.uk*, *britishtelecom.net*, *britishtelecom.org* and *britishtelecom.com*. The defendant sought to sell them to such companies as Marks & Spencer Plc., J. Sainsbury Plc., Virgin Enterprises Ltd., British Telecommunications Plc. and Ladbroke Plc. The defendant argued that it had never "used" the domain names. However, the English Court of Appeal rejected

this argument. In the Court of Appeal judgment, Aldous L.J. held that:

> I am not satisfied that section 10(3) does require the use to be trade mark as use or confusing use, but I am prepared to assume it does. Upon that basis I am of the view that threats to infringe have been established. The appellants seek to sell the domain names which are confusingly similar to registered trademarks. The trademarks indicate origin. That is the purpose for which they were registered. Further, they will be used in relation to the services provided by the registrant who trades in domain names.[28]

Similarly, in the U.S. case of *Panavision International, L.P. v. Dennis Toeppen*,[29] the defendant registered the domain name Panavision.com and attempted to resell it to the plaintiff. In the Court of Appeal judgment, Thomas Circuit J. held that the defendant's commercial use was his attempt to sell the trademark itself.[30]

The issue of "use" was also raised in many UDRP decisions. In the case of *World Wrestling Entertainment Inc. v. Bosman*,[31] the respondent, Bosman, registered the domain name *worldwrestling.com* and then offered to sell the domain name to the World Wrestling Federation (WWF). The WWF commenced proceedings on the basis that Bosman had registered a domain name identical to its trademark and used the domain name without having any legitimate interest in it. Eventually, the panel ruled that Bosman's offer of the domain name to the WWF revealed that his "primary purpose in registering the domain name was to sell, rent, or otherwise transfer it to the complainant for a valuable consideration in excess of [his] out of pocket expenses".[32] On that basis, and on the authority of such U.S. decisions as *Panavision International, L.P. v. Dennis Toeppen*[33] and *Intermactic Inc. v. Toeppen*,[34] the panel held that Bosman had "used" the domain name in bad faith and ordered the transfer of the domain name *worldwrestling.com* to the WWF.

In *Telstra Corp Ltd v. Nuclear Marshmallows*,[35] the panel further clarified the meaning of the term "use" under the UDRP. The complainant in this case (Telstra) was the largest telecommunications company in Australia and operated a Web site with the domain name *telstra.com*. The respondent, Nuclear Marshmallows (NM), registered the domain name *Telstra.org*. Unlike the *Bosman* case, NM did not offer to sell the domain name after registering the domain name. Eventually, the panel held that:

> The relevant issue is not whether the respondent is undertaking a positive action in bad faith in relation to the acting in bad faith but whether, in all circumstances of the case, it can be said that the respondent is acting in bad faith. The distinction between undertaking a positive action in bad faith and acting in bad faith may seem a rather fine distinction, but it is an important one. The significance of the distinction is that *the concept of a domain name being used in bad faith is not limited to positive action, inaction is within the concept*. In other words, *it is possible, in certain circumstances, for inactivity by the respondent to amount to the domain name being used in bad faith*.[36]

The approach adopted in the *Telstra* case was also endorsed in the above-mentioned Hong Kong case of *Outblaze*.[37]

Evidence of registration and use in Bad Faith

Another difficult legal issue under the Policy is establishment of evidence of registration and use *in bad faith*. The Policy set out four circumstances as evidence of the registration and use in bad faith. First, the registrant has registered or acquired the domain name primarily for the purpose of selling, renting or otherwise transferring the domain name registration to the complainant, who bears the name or is the owner of the trademark or service mark, or to a competitor of that complainant, for valuable consideration in excess of the registrant's documented out-of-pocket costs directly related to the domain name. Second, the registrant has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the registrant has engaged in a pattern of such conduct. Third, the registrant has registered the domain name primarily for the purpose of disrupting the business of a competitor. Fourth, the registrant, by using the domain name, has intentionally attempted to attract, for commercial gain, Internet users to its Web site by creating a likelihood of confusion with the complainant's name or mark as to the source, sponsorship, affiliation, or endorsement of the registrant's Web site or location or of a product or service on the registrant's Web site or location.[38] This definition of bad faith is very similar to its counterpart in the UDRP.[39]

In the above-mentioned case of *Telstra*, the panel pointed out that the circumstances set out for bad faith in the UDRP did not constitute an exhaustive list.[40] In that case, the panel held that the respondent's passive holding of the domain name amounted to "in bad faith", based on a set of unique circumstances. These included the good reputation and publicity generated by the complainant's trademark; no actual or contemplated good faith use by the respondent of the domain name; and the concealment of the respondent's true identity by giving false details when registering the domain name.[41]

The *Telstra* case, therefore, confirms that the circumstances of bad faith stated in the UDRP Rules are not exhaustive. Such view was also adopted in the above-mentioned Hong Kong case of *Outblaze*.[42] In the latter case, the arbitrator also considered the repeated failure of the respondent to reply to the complainant and related correspondence from the Hong Kong International Arbitration Centre as evidence of bad faith.[43]

Legitimate interests of domain name holders

In order to defend under the Policy, the registrant can argue that it has legitimate interests in the disputed domain name. The Policy sets out the following three circumstances as evidence of "legitimate interests" of the registrant. First, the registrant has used, or has demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services. Second, the registrant (as an individual, business, or other organization) has been commonly known by the domain name, even if the registrant has acquired no trademark or service mark rights. Third, the registrant is making a legitimate non-commercial or fair user of the domain name, without intent for commercial gain to misleadingly divert customers or to tarnish the trademark or service mark at issue.[44]

In the above-mentioned Hong Kong case of *Outblaze*, the arbitrator held that "outblaze" was not "a word which Hong Kong traders in the Internet community could legitimately choose unless they were intending to create a false association with the complainant".[45] This, coupled with the domain name holder's failure to reply to the complaint, led the arbitrator to infer that the domain name holder had no legitimate interest in the domain name outblaze.com.hk. This decision reflected a liberal approach adopted by Hong Kong arbitrators in determining the issue of "domain name holder's legitimate interest".

Merits and demerits of the Policy

The Policy is beneficial to Singapore for several reasons. First, it promotes development of electronic commerce in Singapore. In recent years, Singapore has been keen on developing the country into a regional centre of electronic commerce. The presence of cybersquatters will affect consumer confidence to conduct online business, as consumers will not be able to know for certain whether the Web sites that they are accessing belong to the parties with which they want to do business. Moreover, if companies in Singapore need to pay huge sums of money to cybersquatters for their favourite domain names, they may pass the costs of obtaining the domain names to their online customers when they price their products and services. Finally, if a large number of domain names are held hostage by cybersquatters, many companies in Singapore may not be able to find suitable domain names for their online business. All these affect the future development and growth of electronic commerce in Singapore. Adoption of the Policy should curb the proliferation of cybersquatters in Singapore, thereby reducing the entry barriers and transaction costs of electronic commerce. The deterrent effect of similar anti-cybersquatting policy is confirmed by UDRP case statistics. In fact, the number of proceedings under the UDRP peaked at 343 in August 2000 and has since declined to 250.[46]

Second, the Policy provides an effective means of resolving domain name disputes in Singapore. As a form of alternative dispute resolution procedure, the Policy is more flexible than proceedings under the *Trademarks Act*.[47] The parties can dispense with many of the formal court processes and court documents that are required in court proceedings. They therefore represent a new approach to resolve disputes arising from the Internet that "corresponds with the communication speed and economic efficiency of the Internet itself".[48]

Third, the costs of proceedings under the Policy are relatively low compared with proceedings under the *Trademarks Act*. In the case of domain name court litigation, smaller companies are usually in a disadvantaged position because they lack the financial means to contest court proceedings against large companies, even if they enjoy lawful rights to a domain name.[49] At present, the minimum costs of proceedings under the Policy for a single-member panel is S$2,750,[50] which is lower than the costs of court litigation in Singapore. Thus, the Policy benefits small businesses in Singapore by providing an alternative procedure to assert their domain name rights at a lower cost.

Moreover, many cybersquatters offer to sell registered domain names to their rightful owners at a "nuisance value", namely, the price offered by the cybersquatters is lower than the legal costs of fighting a cybersquatting lawsuit in court but at the same time, is much higher than the costs of registering the domain name. In the past, the rightful owners were inclined to pay the cybersquatters for the domain name based on a simple cost-benefit analysis.[51] As the legal costs involved in claiming a domain name are reduced substantially, the Policy gives economic incentives to the rightful owners to commence proceedings to reclaim domain names.

Fourth, proceedings under the Policy save time compared with proceedings under the *Trademarks Act*. The time factor is very important in domain name disputes. Once a domain name similar or identical to a trademark is registered and used by a cybersquatter, the lawful trademark owner will start to suffer losses, in terms of potential customers and business opportunities. The longer the domain disputes last, the larger the losses the trademark owner will suffer. Instead of entering into online contracts with the trademark holders, customers may end up contracting with the cybersquatters. The lawful trademark holders may also suffer loss of business goodwill as customers will attribute any unprofessional services or substandard products ordered through the wrong Web site to the lawful trademark owners. Thus, the longer the domain name battles ensue, the more pressure is exerted on the trademark owners to concede

to the requests of the cybersquatters, however unreasonable they may be. Expediency may force the lawful trademark holders to purchase the domain names at an unreasonably high price.[52]

However, the Policy is not without its limitations and problems. First, it is confined to dealing with bad faith registration and use of domain names and *not* to other types of domain name disputes. Thus, it does not apply to domain name disputes between two legitimate trademark owners competing for the same domain name. For example, in the English case of *Pitman Training Limited et al. v. Nominet UK*,[53] both parties lawfully used the trading name Pitman and competed to use the domain name *pitman.co.uk*. If similar disputes arise in Singapore, the parties cannot use the Policy to resolve which company can own and use the domain name. The scope of the Policy is therefore largely restricted to one kind of domain name dispute, namely, cybersquatting cases.

Second, the Policy does not adequately deal with "reverse domain name hijacking" — an action by a company or an individual, usually well established and with substantial financial means, attempting to take away a domain name from another company or individual by threatening to begin legal proceedings against the latter. The concept of "reverse domain name hijacking" is exemplified by some recent UDRP decisions. In the case of *Goldline International, Inc. v. Gold Line*,[54] the complainant was the owner of the trademark "Goldline", dealing in precious metals and coins with a service mark as well as providing information on the price and market value of precious metals and coins. The respondent was an individual operating a business under the business name Gold Line Internet with a registered domain name *goldline.com*. In the *Goldline* case, the respondent claimed that the complainant attempted "reverse domain name hijacking". The panel ruled that the complainant should have known that the respondent's registration of the domain name *goldline.com* could not have constituted bad faith under the UDRP. The panel also ruled that the respondent notified the complainant of the relevant facts prior to the UDRP proceedings. On such basis, the panel held that the complainant engaged in "reverse domain name hijacking".

In another case, *Deutsche Welle v. DiamondWare Limited*,[55] the complainant was a German-based television and radio broadcasting company operating under the acronym DW and owning various trademarks comprising or including, as part of a device, the letters DW. The respondent was a U.S.-based software development company operating under the acronym DW and operating an active Web site with a domain name *dw.com*. In the *DiamondWare* case, the panel ruled against the complainant for two reasons. First, because the respondent registered the domain name *dw.com* prior to the complainant registering its trademarks, they held that the complainant, upon discovery of that registration, should have known that the registration of the domain name was unlikely to have been undertaken primarily for any bad faith purpose directed at the complainant. Secondly, it ruled in favor of the respondent because the domain name was used in relation to an active Web site and the *bona fide* business of the respondent. The panel ruled by a majority decision that the complainant attempted "reverse domain name hijacking" under the UDRP.

Under the Policy, the panel can only declare that a complainant abuses the administrative proceedings if he attempts "reverse domain name hijacking".[56] This is modeled on the UDRP.[57] In the United States, many academics like Osborn[58] and Walker,[59] have criticized the UDRP for failing to deal with the issue of "reverse domain name hijacking" adequately. They have called for expansion of the scope of the UDRP to address the issue of "reverse domain name hijacking" with more remedies for domain name owners.

Third, the Policy is likely to be biased toward trademark owners in its implementation. In the United States, Halpern and Mehrotra[60] made similar criticism of the UDRP, on which the Policy is modeled. As of February 6, 2002, 4,273 cases were decided under the UDRP. Of these, 3,426 cases were decided in favour of the complainant, i.e., the trademark owners, and the domain names registered in these cases were ordered to be transferred to the complainants or cancelled, while only 820 decisions were decided in favour of the respondents, i.e., domain name holders. In other words, trademark owners won 80.2% of the cases while domain name owners won only 19.2% of the cases.[61] Mueller[62] even found that some panels interpreted the UDRP in ways that favour trademark owners, rather than by adhering to the strict language of the UDRP.

Fourth, the remedies available to trademark owners under the Policy are limited. Under the Policy, the complainant can only ask for either cancellation or transfer of registration of the domain name.[63] In other words, a trademark owner cannot apply for compensation under the Policy. However, if the trademark owner commences proceedings under the *Trademarks Act*, he can apply for a wide range of relief, including an injunction, damages and accounts for profits.[64] He may also apply for orders for erasure, delivery up and disposal of the infringing goods, materials and articles.[65] Thus, if a trademark owner wants to apply for legal remedies other than cancellation and transfer of registration of the domain name, he may prefer to commence proceedings under the *Trademarks Act*, rather than under the Policy.

One interesting issue here is whether trademark owners in Singapore can commence proceedings under the *Trademarks Act* and the Policy *concurrently*. In the U.S. case of *Broadbridge Media, L.L.C., v. HyperCD.com*,[66] the court ruled that a trademark owner may concurrently commence arbitration proceeding under the UDRP and litigation proceedings under U.S.

trademark law. The advantages of such concurrent proceedings are obvious. Trademark owners can therefore employ the UDRP to reclaim the domain name in a speedy manner while claiming for compensation and other remedies under traditional trademark laws. It appears, however, that the trademark owners in Singapore cannot do so under the Policy as both the complainant and registrant cannot commence proceedings in respect of a domain name while a proceeding in respect of the domain name under the Policy is pending.[67]

Finally, if a domain name holder is dissatisfied with a decision made by a panel under the Policy, he may commence proceedings in Singapore courts to review the decision. Thus, the complainant may opt for proceedings under the *Trademarks Act* if it is likely that the domain name holder will review any unfavourable decision made against him under the Policy.

Conclusion

As electronic commerce continues to develop in Singapore, domain names will increasingly be an important asset of companies, both local and overseas, as they conduct online business. It is, therefore, essential for Singapore to develop a dispute resolution procedure to resolve domain name disputes that may arise from the competing interests of domain name owners and trademark owners. Adoption of the Policy is a step in the right direction.

More importantly, adoption of the Policy demonstrates the determination and efforts of Singapore to observe international standards and practice in its information technology laws. In fact, more than 10 jurisdictions have adopted a UDRP-like dispute resolution procedure.[68] China adopted a UDRP-like dispute resolution procedure in 2000.[69] Viewed from this perspective, adoption of the Policy represents an important step in the development of Singapore into an international centre of electronic commerce.

Notes:

[1] Online: Singapore Domain Name Resolution Service, <http://www.disputemanager.com.sg/Policy.htm> (last accessed 07/23/02) [hereinafter the Policy].

[2] Online: Singapore Domain Name Resolution Service <http://www.disputemanager.com.sg/Rules.htm> (last accessed 07/23/02).

[3] Online: Singapore Domain Name Resolution Service <http://www.disputemanager.com.sg/SupRules.htm> (last accessed 07/23/02).

[4] *Uniform Domain Name Dispute Resolution Policy*, see online: ICANN <http://www.icann.org/dndr/udrp/policy.htm> (last accessed 07/23/02) [hereinafter UDRP].

[5] For a full version of the UDRP Rules, see online: ICANN: <http://www.icann.org/udrp/udrp-rules-24oct99.htm> (last accessed 07/23/02) [hereinafter UDRP Rules].

[6] The ICANN was a non-profit body formed in 1998 to assume responsibility for domain name management system. For more information of the ICANN, see online: ICANN <http://www.icann.org./general/abouticann.htm> (last accessed 07/23/02).

[7] Marcelo Halpern and Ajay K. Mehrotra, "From international treaties to Internet norms: the evolution of international trade marks disputes in the Internet age", University of Pennsylvania Journal of International Economic Law 523, at 524 [hereinafter Halpern and Mehrotra].

[8] UDRP, *supra* note 4 at para. 4a.

[9] Under the UDRP, a complainant can file a claim if there is "abusive registration" of domain names, and "abusive registration" occurs when the following three criteria are fulfilled. First, the domain name is identical or confusingly similar to a trademark in which the complainant has right. Second, the domain name holder has "no rights or legitimate interests in respect of the domain name". Third, the domain name has been registered and used in bad faith. See *ibid.*

[10] Case No. D2000-0235. Available online: WIPO Arbitration and Mediation Centre <http://arbiter.wipo.int/domains/decisions/html/2000/d2000-0235.html> (last accessed 07/23/02).

[11] File no. 0002 000093633. In that decision, the panel held that the complainant had common law trademark rights in a trading name that it used for four years and invested considerable time and effort in establishing the trading name.

[12] *Supra* note 10 at para 6.12 [emphasis mine].

[13] Case No. D2000-0596. Online: Worlds Intellectual Property Organization (WIPO) Web site <http://arbiter.wipo.int/domains/decisions/html/2000/d2000-0596.html> (date accessed: June 29, 2002).

[14] *Ibid.* at paras. 6.1-6.4.

[15] *Ibid.* at para. 6.5.

[16] Case No. 0106-0001. Available online: Hong Kong International Arbitration Centre <http://dn.hkiac.org/outblaze> (last accessed 07/23/02) [hereinafter *Outblaze*].

[17] The HKDNR Domain Name Dispute Resolution Policy was adopted by Hong Kong on 24th April 2001. Its contents are substantially the same as the UDRP. For a full version of the Hong Kong Domain Name Dispute Resolution Policy, see online: Hong Kong International Arbitration Centre <http://dn.hkiac.org/policy_print.html> (last accessed 07/23/02).

[18] *Outblaze*, *supra* note 16 at para. 5A.

[19] *Ibid.* [emphasis mine].

[20] FSR 16 (Ch.D.).

[21] *Ibid.* at 18.

[22] *Ibid.*

[23] 97 F. Supp. 2d 96.

[24] Pub. L. No. 106-113 (1999). The *Anti-cybersquatting Consumer Protection Act* was a statute passed by the United States in 1999 to deal with cybersquatting specifically.

[25] 97 F. Supp. 2d 96 at 117.

[26] In the *Northern Light* case, Woodcock J. also considered the alternative test of "likelihood of confusion", and laid down eight assessment criteria for the term. Namely, similarity of marks, similarity of goods (or services), relationship between the parties advertising, classes of prospective purchasers, evidence of actual confusion, defendant's intent in adopting the mark, and strength of the mark. See *ibid.* at 109.

[27] F.S.R. 1.

[28] *Ibid.* at 25.

[29] 141 F3d 1316.

[30] *Ibid.* at 1325.

[31] Case No. D99-0001. Available online: World Intellectual Property Organization (WIPO) Arbitration and Mediation Centre <http://arbiter.wipo.int/domains/decisions/html/1999/d1999-0001.html> (last accessed 07/23/02). For a discussion of the case, see Rachel Montagnon, "Computers — WIPO resolves dispute over 'Worldwrestlingfederation.dom' domain name — the first case to be decided under the new ICANN uniform domain name dispute policy". *European Intellectual Property Review* 2000 22(3), at N37-38.

[32] UDRP, *supra* note 4 at para. 4b.

[33] *Supra* note 29.

[34] 947 F. Supp. 1227 (N.D. 111.1996).

[35] Case No. D2000-0003. Available online: World Intellectual Property Organization (WIPO) Arbitration and Mediation Centre <http://arbiter.wipo.int/domains/decisions/html/2000/d2000-0003.html> (last accessed 07/23/02). For a discussion of the case, see D Kovacs, "WIPO: Computers & Databases — Domain Names — Bad Faith" *European Intellectual Property Review* 2000, Vol. 22 (6) at N89–90.

[36] *Ibid.* at para. 7.9 [emphasis mine].

[37] *Supra* note 16.

[38] UDRP Rules, *supra* note 5 at para. 4b.

[39] Under the UDRP, evidence of "bad faith" includes, but is not limited to, the following four circumstances. First, the domain name was registered or acquired primarily for the purpose of selling, renting or otherwise transferring it for valuable consideration in excess of expenses for obtaining the domain name. Second, the domain name was registered to prevent the trademark owner from reflecting its mark in its domain name. Third, the domain name was registered primarily for the purpose of disrupting the business of a competitor. Fourth, the domain name was intentionally used to attempt to attract, for commercial gain, Internet users to the Web site of the domain name holder or other online location, by creating a likelihood of confusion with the complainant's mark as the source, sponsorship, affiliation, or endorsement of its Web site or location or of a product or service on its Web site or location. See UDRP, *supra* note 4 at para. 4b.

[40] *Supra* note 35 at para. 7.10.

[41] *Ibid.* at para. 7.11.

[42] *Supra* note 16 at para. 5C.

[43] *Ibid.*

[44] UDRP Rules, *supra* note 5 at Para. 4c.

[45] *Supra* note 16 at para. 5B.

[46] See Milton Mueller, "Rough Justice — An analysis of ICANN's Uniform Dispute Resolution Policy". Online: The Convergence Center at Syracuse University Website <http://dcc.syr.edu/roughjustice.htm> (last accessed 07/23/02), at 6 [hereinafter Mueller].

[47] Cap. 332.

[48] See *Halpern and Mehrotra*, *supra* note 7 at 533.

[49] Jason M. Osborn, "Effective and complementary solutions to domain name disputes: ICANN's Uniform Domain Name Dispute Resolution Policy and the Federal Anti-cyber-squatting Consumer Protection Act of 1999", 76 *Notre Dame Law Review*, 209, at 240 [hereinafter Osborn].

[50] See Schedule of Fee. Available online: Hong Kong International Arbitration Centre <http://www.disputemanager.com.sg/SupRules.htm> (last accessed 07/23/02).

[51] Luke A. Walker developed the concept of "nuisance value". See Luke A. Walker, "ICANN's Uniform Domain Name Dispute Resolution Policy", 15 *Berkeley Technology Law Journal* 289 [hereinafter Walker].

[52] *Ibid.* at 307.

[53] FSR 797 (Ch D).

[54] Case No. D2000-1151. Online: Worlds Intellectual Property Organization (WIPO) Web site <http://arbiter.wipo.int/domains/decisions/html/2000/d2000-1151.html> (last accessed 07/23/02) [hereinafter *Goldline*].

[55] Case No. D2000-1202. Online: Worlds Intellectual Property Organization (WIPO) Web site <http://arbiter.wipo.int/domains/decisions/html/2000/d2000-1202.html> (last accessed 07/23/02) [hereinafter *DiamondWare*].

[56] See UDRP Rules, *supra* note 5 Rule 15.

[57] *Ibid.*

[58] See *Osborn*, *supra* note 49.

[59] See *Walker*, *supra* note 51.

[60] See *Halpern and Mehrotra*, *supra* note 7.

[61] See ICANN, *Statistical Summary of Proceedings under Uniform Domain Name Dispute Resolution Policy on February 6, 2002*. Available online: ICANN <http://www.icann.org/udrp/proceedings-stat.htm>.

[62] See *Mueller*, *supra* note 46.

[63] UDRP Rules, *supra* note 5 para. 3.

[64] *Supra* note 47 at s. 31.

[65] *Ibid.* ss. 32–34.

[66] 106 F. Supp. 2d 505.

[67] UDRP Rules, *supra* note 5 at para. 4k.

[68] Dawn Osborne, "ICANN procedure proves a resounding success", *International Internet Law Review*, Issue 10, December 2000/January 2001 at 26.

[69] In November 2000, China adopted the Resolutions of Disputes Concerning Chinese-language Domain Names Procedures (Trial Implementations — "the Chinese procedure"), which was largely modelled on the UDRP. For an English translation of the Chinese procedure, see *China Law and Practice*, December 2000/ January 2001, Vol 14, No 10, at 19–24. For an analysis of the Chinese procedure, see R. Wu, "New Rules for Resolving Chinese Domain Names Disputes", 2001(1), *The Journal of Information, Law and Technology*. Online: The Journal of Information, Law and Technology <http://elj.warwick.ac.uk/jilt/01-1/wu.html> (last accessed 07/23/02).