



The Uniform Domain Name Dispute Resolution Policy: A Practical Guide

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I. INTRODUCTION

Disputes involving alleged bad faith registration and use of certain Internet domain names may be arbitrated pursuant to the *Uniform Domain Name Dispute Resolution Policy* (the *Policy*)¹ mandated by the Internet Corporation for Assigned Names and Numbers ("ICANN").²

The *Policy* is the first attempt to establish a global set of substantive rules regarding certain kinds of Internet-related trademark disputes, and a single, international system for the arbitration of those disputes. In many respects, the *Policy* has fulfilled its objective of providing an efficient and cost effective means of resolving certain domain name disputes. In other respects, however, the experience with the *Policy* has been less than satisfactory, and has demonstrated significant deficiencies in the *Policy*.

This paper provides an overview of the *Policy*, and discusses the manner in which the *Policy* has been interpreted and applied. It is not possible for a paper of this kind to review or discuss all of the decisions issued under the *Policy*. There have been far too many in the short period of time since the *Policy* was established.³

Internet law is developing rapidly, and must be considered in the circumstances of each individual case or issue. If legal or other expert advice or assistance is required regarding a domain name dispute, the services of a competent lawyer should be sought.

II. APPLICATION OF THE *POLICY*

On October 24, 1999, ICANN resolved that all registrars of the top level domains (TLDs) - *.com*, *.net* and *.org* - would be required to adopt the *Policy* and incorporate it by reference into their domain name registration agreements.⁴ Currently, the *Policy* applies to disputes regarding all domain names in the *.com*, *.net*, *.org*, *.biz* and *.info* TLDs, including the multi-lingual domain names.⁵

The *Policy* has also been voluntarily adopted by the administrators of certain country code TLDs, including *.ag* (Antigua and Barbuda), *.as* (American Samoa), *.bs* (Bahamas), *.cy* (Cyprus), *.gt* (Guatemala), *.lv* (Latvia), *.mx* (Mexico), *.na* (Namibia), *.nu* (Nuie), *.ph* (Philippines), *.pn* (Pitcairn Islands), *.ro* (Romania), *.sh* (St. Helena), *.tt* (Trinidad and Tobago), *.tv* (Tuvalu), *.ve* (Venezuela), and *.ws* (Western Samoa).⁶

A similar dispute resolution process domain names in the *.ca* domain is presently being considered by the Canadian Internet Registration Authority ("CIRA") and is expected to come into force in early

2002.⁷ The current draft CIRA Policy is substantially similar to the *Policy*, although terms such as "confusing", "rights", "bad faith" and "legitimate interest" are defined in considerably more detail. Further, the draft CIRA Policy provides that panels will be composed of three arbitrators, and complainants will only be required to show that the domain name was registered in bad faith (not registered and used in bad faith). The draft CIRA Policy may undergo further changes before it is implemented.

The *Policy* is binding on domain name registrants because it is incorporated by reference into domain name registration agreements. By virtue of those agreements, domain name registrants are contractually bound to the *Policy's* mandatory administrative dispute resolution processes.⁸

It is important to note that the *Policy* may only be invoked by a complainant, and not a domain name registrant. Further, a party disputing the registration and use of a domain name need not initiate proceedings pursuant to the *Policy*, but may instead commence judicial proceedings in a competent national court.⁹ Decisions pursuant to the *Policy*, whether in favour of the complainant or the registrant, are not determinative of trademark disputes that may be the subject of litigation in national courts.¹⁰

III. SCOPE OF THE *POLICY*

The *Policy* is narrow in scope. It applies only to disputes involving clear cases of bad faith registration and use of domain names - conduct commonly known as "cybersquatting" or "cyberpiracy".¹¹ The *Policy* does not apply to other kinds of disputes between trademark owners and domain name registrants.¹² In particular, it is not designed to resolve legitimate disputes between two parties with conflicting legitimate trademark rights.¹³ It is also not designed to remedy every domain name use that might constitute bad faith in the ordinary sense of the term.¹⁴ The jurisdiction of arbitral panels appointed pursuant to the *Policy* is derived from the *Policy* and the applicable rules, and accordingly is restricted to the limited kind of disputes covered by the *Policy* between parties that have agreed to arbitrate those disputes pursuant to the *Policy*.¹⁵

The summary nature of proceedings under the *Policy* also imposes practical limits on the disputes that may be fairly resolved. In particular, a number of panels have dismissed complaints because they were not able to resolve conflicting evidence and make required findings of fact due to the truncated nature of the proceedings and the lack of live testimony. Those panels have observed that disputes involving credibility issues or other complicated questions of fact are better resolved through conventional litigation in a court.¹⁶

Other panels have observed, however, that a panel's role is to make findings of fact to the extent possible based upon the evidence presented, and that the mere existence of a genuine dispute of material fact should not preclude a panel from weighing the evidence and reaching a decision.¹⁷ Further, at least one panel has commented on the international nature of the *Policy* and the need to recognize the validity and effectiveness of other kinds of judicial procedures:

The Panel is an international body, not an American centric one. Civil law jurisdictions, which are predominant internationally, do not provide for American type discovery, yet those systems function quite well. In civil law jurisdictions, documentary evidence is given great weight, while oral testimony is given relatively little. The practice of the Panels, then, is much closer to civil law, than to common law.¹⁸

The narrow scope of the *Policy* reflects its origins as a novel form of Internet dispute resolution

designed to balance a wide range of perspectives regarding the regulation of Internet conduct. The ICANN *Second Staff Report on Implementation Documents for the Uniform Dispute Resolution Policy*, October 24, 1999, paragraph 4.1(c) states as follows:

The Recommended Policy is Minimalist in its Resort to Mandatory Resolution. In contrast to the *Policy* currently followed by NSI, the *Policy* adopted by the Board in Santiago, as set forth in the final WIPO report and recommended by the DNSO and registrar group, calls for administrative resolution for only a small, special class of disputes. Except in cases involving "abusive registrations" made with bad-faith intent to profit commercially from others' trademarks (e.g. cybersquatting and cyberpiracy), the adopted policy leaves the resolution of disputes to the courts (or arbitrators where agreed by the parties) and calls for registrars not to disturb a registration until those courts decide. The adopted policy establishes a streamlined, inexpensive administrative dispute-resolution procedure intended only for the relatively narrow class of cases of "abusive registrations". Thus, the fact that the policy's administrative dispute-resolution procedure does not extend to cases where a registered domain name is subject to a legitimate dispute (and may ultimately be found to violate the challenger's trademark) is a feature of the *Policy*, not a flaw. The *Policy* relegates all "legitimate" disputes - such as those where both disputants had longstanding trademark rights in the name when it was registered as a domain name - to the courts; only cases of abusive registrations are intended to be subject to the streamlined administrative dispute-resolution procedure.¹⁹

IV. THE PROCESS

• Providers

The *Policy* provides that disputes are to be determined by a panel established by an approved administrative-dispute-resolution service provider, and in accordance with ICANN's *Rules for the Uniform Domain Name Dispute Resolution Policy*.²⁰ Service providers may also establish their own supplemental rules. Currently there are four accredited administrative-dispute-resolution service providers: World Intellectual Property Organization, National Arbitration Forum, eResolution, and the CPR Institute for Dispute Resolution.²¹ The complainant selects the administrative-dispute-resolution service provider.²²

• Submissions and Evidence

A *Policy* proceeding is initiated by the complainant's on-line submission of a written complaint and supporting evidence.²³ The complaint is then forwarded to the registrant, who has 20 days within which to file a written response and supporting evidence.²⁴

Rules paragraph 12 provides that a panel may request further statements or documents from the parties. However, in the absence of such a request, the parties do not have a right to file supplementary arguments and evidence.²⁵ Panels are increasingly disregarding supplementary arguments and evidence submitted, unrequested, by the parties.²⁶

Evidence is primarily adduced by the parties through documentary exhibits. *Rules* paragraph 13 provides that there shall be no in-person hearings (including hearings by teleconference) unless the panel determines, in its sole discretion and as an exceptional matter, that such a hearing is necessary for deciding the complaint. An oral hearing was held in *Biofield Corp. v. Joahyun Kwon*,²⁷ where the panel apprehended that the registrant, whose primary language was Korean, may have been at a disadvantage unless an oral hearing was conducted with the assistance of an interpreter. A

request for an oral hearing was refused in *Millennium Broadcasting Corporation v. Publication France Monde*,²⁸ on the basis that an oral hearing was not necessary for the fair disposition of the complaint.

Several panels have confirmed that they may independently review the Internet during their deliberations.²⁹ Some panels have conducted independent WHOIS searches to determine whether the registrant has engaged in a pattern of registering domain names that are confusingly similar to trademarks in which other persons have rights.³⁰

- Panels

The complainant or the registrant may require that the administrative panel be comprised of three members. If no such election is made, then the panel will be comprised of a single panelist appointed by the provider.³¹

If the complainant or the registrant elects to have the dispute decided by a three-member panel, the parties must each provide a list of three potential panelists selected from the provider's panelist roster. The provider will then attempt to appoint a panelist from each party's list, and will appoint the third panelist from a list of five candidates submitted by the provider to the parties for their comment.³²

After a panel is appointed, it generally has fourteen days within which to render its decision.³³

- Remedies

A panel may order a domain name registration to be cancelled or transferred to the complainant. A panel may not grant additional remedies, such as shutting down a Web site or awarding damages and costs.³⁴ It is not clear when it would be appropriate for a panel to order the cancellation of a domain name as opposed to a transfer of the domain name to the complainant. As observed by at least one panel, although there may be other legitimate users of the domain name that might seek registration subsequent to a cancellation, the complainant's request for a transfer may reasonably take precedence under the general first-in-time principle applicable to legitimate domain name registration requests. Further, a panel's transfer order does not prejudice the position of a third party seeking to challenge a domain name registration obtained by way of a panel's order of transfer.³⁵

- Applicable Law

The *Policy* does not direct panels to consider or apply any particular national trademark law. *Rules* paragraph 15(a) simply provides that a panel is to decide the dispute according to "rules and principles of law that [it] deems applicable". The *Final Report of the WIPO Internet Domain Name Process* indicated that if the parties are resident in one country, the domain was registered through a registrar in that country, and the evidence of bad faith registration and use arises from activities in that country, it is appropriate to refer to that country's trademark laws.³⁶ A number of panels have taken that approach.³⁷

Where the parties are located in different countries, some panels have held that only the *Policy* and the *Rules* should be applied,³⁸ other panels have selected the law applicable to the jurisdiction in which the registrant is located,³⁹ and still other panels have applied law from multiple jurisdictions.⁴⁰

- Delay

The Policy does not prescribe a limitation period within which a complaint must be brought after the complainant discovers that the registrant has registered the disputed domain name. In *Mario Lemieux v. Creato*,⁴¹ the panel held that a three-year delay was not unreasonable, and in the circumstances did not constitute consent to the use of the domain name. The panel noted that the Policy was not in force during most of the delay period. The panel also noted that a longer period of time in other circumstances might produce a different result.⁴²

V. THE ELEMENTS REQUIRED BY THE POLICY

The Policy provides trademark owners with a significant new procedural and substantive rights. The Policy enables trademark owners to require registrants to abide by the on-line arbitration process established by the Policy and to assert rights beyond the territorial jurisdictions in which they have trademark rights.⁴³

As a counter-balance to these procedural and substantive rights, the application of the Policy is limited to situations in which a complainant asserts and proves the following: (i) the registered domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; (ii) the registrant has no rights or legitimate interests in respect of the domain name; and (iii) the domain name has been registered and is being used in bad faith.⁴⁴ A complainant must prove all three elements in order to be entitled to relief under the Policy.⁴⁵

In interpreting and applying the Policy, panels tend to look to prior decisions to offer guidance.⁴⁶ Nevertheless, as will be seen, there are often significant differences in the way in which the Policy is interpreted and applied.

(i) Conflicting Mark and Domain Name

The complainant must prove that it has rights in a trademark or service mark with which the registered domain name is identical or confusingly similar.

(a) Trademark Rights

The Policy does not require a complainant to rely on a registered trademark.⁴⁷ It is sufficient that a complainant have rights in a common law, unregistered trademark.⁴⁸ A number of disputes have involved unregistered trademarks used on the Internet. Panels have held that trademark rights may accrue quickly on the Internet due to the accelerated speed at which it allows information to be distributed.⁴⁹

The Policy requires that the complainant have rights in a trademark, but does not indicate whether ownership rights are required, or whether more limited licensed rights are sufficient to satisfy the Policy and establish standing to bring a proceeding.⁵⁰ This issue was considered in *NBA Properties Inc. v. Adirondack Software Corp.*,⁵¹ where the panel held that NBA Properties Inc., which operated the official NBA Web sites, did not have status to bring the complaint because Madison Square Garden LP held the rights to the NEW YORK KNICKS trademark, NBA Properties claimed to be the "exclusive licensee" of the trademark, but did not provide any details regarding its licensed rights. The panel reasoned "the rights of a licensee are contract rights with respect to, not *in*, the licensed

marks". The panel recognized that some exclusive licensee contracts might vest in the licensee substantially all the powers of the trademark owner; however that was not established by the complainant. The panel reasoned that the purpose of the *Policy* is to transfer a disputed domain name to a complainant "as a route to unification of control over the uses of the domain name and the trademark", and that result would not occur if the complainant was not the trademark owner or did not have the trademark owner's consent to bring the proceeding.⁵²

The *Policy* does not require that a complainant's trademark rights arise in the same jurisdiction in which the registrant carries on business. That a complainant and registrant carry on business in different jurisdictions may be relevant to the other two requirements of the *Policy* - the registrant's rights and legitimate interests in the domain name and the registrant's bad faith registration and use of the domain name - but it is not relevant to the first element of the *Policy*.⁵³

- Personal Names

Several administrative panels have applied the *Policy* to famous personal names.⁵⁴ For the *Policy* to apply, the famous name must have acquired trademark status as opposed to being merely well known or famous.⁵⁵ For example, in *Sumner p/k/a Sting v. Urvan*,⁵⁶ a dispute over the *sting.com* domain name, the panel expressed doubts whether the *Policy* applied because the complainant's stage name "Sting", although famous, was a common English word that was not distinctive of the complainant and therefore did not have trademark or service mark status. The panel reasoned that the *Policy* was intended to protect only trademark rights, and not trade names or personality rights. In support of this view, the panel referred to the *Final Report of the WIPO Internet Domain Name Process*, upon which ICANN based the *Policy*, which recommended that the *Policy* initially be restricted to the protection of trademarks and service marks, and not extend to trade names, geographic indications or personality rights.⁵⁷ Other panels have been less rigorous regarding the distinction between personal names and trademarks.⁵⁸

WIPO is currently considering whether the *Policy* should be extended to include disputes over domain names that conflict with personal names. The September 2001 *Report of the Second WIPO Internet Domain Name Process*⁵⁹ recommended that the *Policy* not be changed to refer expressly to personal names, with the consequence that only personal names that function as trademarks are protected under the *Policy*. In October 2001, the WIPO Member States referred the *Report* to two special sessions of WIPO's Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications, to be held in late 2001.

The status of personal names will further change when the new *.name* gTLD comes into operation in 2002. The *.name* gTLD will be available only for the registration of personal names, and fictional names in which trademark rights have accrued.

- Geographic Place-Names

Several cases have involved complaints by governments or government agencies regarding domain names comprised of geographic place-names. In cases where the geographic place-name has been a registered trademark, the *Policy* has been applied.⁶⁰ In cases where the geographic place-name has not functioned as a trademark, the *Policy* has not been applied, and panels have noted that the legal authority of a geographic area does not necessarily have an exclusive right to use the name of that area as a domain name.⁶¹ Accordingly, in order to be protected by the *Policy*, a geographic place-name must perform the function of a trademark - distinguishing the goods or services of the complainant in trade from the goods or services of other traders.

WIPO is currently considering whether to extend the scope of the *Policy* should be extended to

include disputes over domain names that conflict with geographic place names. The September 2001 *Report of the Second WIPO Internet Domain Name Process* recommended that: (a) the *Policy* not be modified at this stage to permit complaints based on breaches of the prohibition against false indications of source or the rules relating to the protection of geographical indications; (b) further consideration of any measures to protect the names of places should be restricted, at this stage, to the names of countries and administratively recognized regions and municipalities within countries; and (c) those discussions should ideally occur between governments at the international level, not in the context of an amendment of the *Policy*. As noted, the *Report* is to be reviewed by WIPO's Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications.

- Trade Names

The *Policy* does not apply to trade names that are not trademarks.⁶² For example, *Canadian Tire Corporation Limited v. McFadden*,⁶³ involved a dispute over the *crappytire.com* domain name. The complainant claimed that it was frequently referred to colloquially, or known as, "Crappy Tire" by the Canadian public, and claimed that the impugned domain name was being used by the registrant in bad faith for a criticism Web site. The panel held that the *Policy* did not apply because the complainant had failed to prove that it had used the slang expression "Crappy Tire" as a trademark.

The September 2001 *Report of the Second WIPO Internet Domain Name Process* recommends against amending the *Policy* to include disputes arising from domain names corresponding to trade names, noting the variety of ways trade names are addressed by national legal systems. As noted, the *Report* is to be reviewed by WIPO's Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications.

(b) Identical or Confusingly Similar

- The Appropriate Test

The *Policy* and the *Rules* do not provide any guidance with respect to the test to be applied regarding the confusingly similar criterion of the *Policy*. Panels have applied different tests. Some panels have undertaken a literal comparison of the domain name and the trademark, and have not considered whether there is any source confusion.⁶⁴ Other panels have undertaken a likelihood of confusion or source confusion analysis as required by conventional American and Canadian trademark law, which involves a consideration of all of the circumstances including the strength of the complainant's mark, the sophistication of likely consumers, and the nature of the wares and services with which the domain name and conflicting mark are used.⁶⁵

A number of considerations support the view that the appropriate test for confusing similarity under the *Policy* is a literal comparison of the challenged domain name and conflicting mark:

- The language of *Policy* paragraph 4(a) should be interpreted in a purposive manner consistent with the *Policy's* remedial nature and objective - to prevent the extortionate behaviour known as "cybersquatting".
- The language of *Policy* paragraph 4(a) does not invoke a likelihood of confusion test, as contrasted with *Policy* paragraph 4(b)(iv) which expressly refers to a "likelihood of confusion with the complainant's 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" as an indication of bad faith domain name use.
- The *Policy* is international and, in the absence of express language, it is inappropriate to import into *Policy* paragraph 4(a) a test that may not exist under all national trademark laws.
- The procedure contemplated by the *Policy* is not well-suited to the kinds of difficult factual issues presented by a conventional likelihood of confusion analysis. In particular, the *Policy* is

intended to be a relatively quick and inexpensive process, panels must make factual determinations based upon written submissions and documentary evidence, complainants have no right of reply without the panel's permission, and parties are often not represented by counsel.⁶⁶

It has also been noted that the threshold inquiry of trademark and domain name similarity is not an assessment of the propriety of the registrant's conduct. Accordingly, the registrant's intentions in registering and using the domain name are irrelevant at this point in the analysis.⁶⁷

- Prefixes, Suffixes, and Other Domain Name Elements, and Misspellings

Most panels have held that when comparing a challenged domain name and a trademark, the addition of the TLD suffix is irrelevant for the purpose of determining whether the domain name it is identical or confusingly similar to the trademark. Rather, one looks to the second level domain for such a determination, since the TLD suffix is merely descriptive of the registry services.⁶⁸

Similarly, panels have also held that the omission of punctuation marks or spaces between components of a trademark when used in a domain name, which is a function of the technological limitations of the Internet domain name system, should be disregarded when determining whether the domain name is identical or confusingly similar to a mark.⁶⁹ Further, because design elements cannot be captured in a domain name, panels have held that the logo portion of a complainant's trademark is irrelevant for the purpose of determining whether a domain name and trademark are identical or confusingly similar.⁷⁰

Whether the addition of other terms to the complainant's mark is sufficient to avoid a finding of confusing similarity depends on the circumstances.⁷¹ For example, in *Ticketmaster Corp. v. Brown*⁷², the panel held that the addition of a non-distinctive prefix ("urn2") to a well known trademark did not prevent a finding of confusing similarity. Similar results were reached in *Dr. Ing. h.c.F. Porsche AG v. Macros-Telecom Corp.*⁷³, involving *porsche-usa.com*, and *Victoria's Secret v. Victoria's Cyber Secret*,⁷⁴ involving various domain name variations on the VICTORIA'S SECRET trademark, such as *victoriassexyssecret.com*.

Common misspellings of well-known trademarks have been held to be confusingly similar to the trademark.⁷⁵

- Critical Domain Names

Several panels have considered disputes involving domain names comprised of the complainant's trademark (or a variation of it) followed by the word "sucks" or similar terms. Panels are divided regarding the application of the *Policy* to those critical domain names.

Some panels have found confusing similarity between the "sucks" domain name and the complainant's trademark.⁷⁶ For example, in *Wal-Mart Stores Inc. v. Richard MacLeod d/b/a For Sale*⁷⁷ the panel accepted the registrant's argument that a domain name that combines a famous mark with a term casting opprobrium on the mark would likely not cause confusion as to the sponsorship or association of the Web site associated with the critical domain name. Nevertheless, the panel held that the *Policy* section 4(a)(1) "identical or confusingly similar" requirement ought to be broadly interpreted in a manner consistent with the *Policy's* objective of preventing "extortionate registration" of domain names incorporating other persons' trademarks. The panel concluded that a domain name is "identical or confusingly similar" with a trademark within the meaning of the *Policy* if the domain name includes the trademark or a confusingly similar approximation of the mark,

regardless of the other terms in the domain name. The panel reasoned that this approach would not adversely affect good faith criticism Web sites because of the requirement that complainants prove that registrants have no legitimate interest in the domain name and that they registered and used the domain name in bad faith.

Similarly, in *Vivendi Universal v. Jay David Sallen*,⁷⁸ a majority of the panel held that *vivendiuniversalsucks.com* domain name was confusingly similar to the VIVENDIUNIVERSAL trademark. The panel majority held that there is no per se rule that the addition of the word "sucks" to a well known trademark makes the domain name not confusingly similar to the trademark. The panel noted that not all Internet users speak English as their mother tongue or are aware of the disparaging meaning of the word "sucks" when added to a well known trademark.

Other panels have held that "sucks" and similar critical domain names are not confusingly similar to the trademark. For example, in *Lockheed Martin Corporation v. Dan Parisi*,⁷⁹ the majority of the panel stated:

Both common sense and a reading of the plain language of the *Policy* support the view that a domain name combining a trademark with the word "sucks" or other language clearly indicating that the domain name is not affiliated with the trademark owner cannot be considered confusingly similar to the trademark.⁸⁰

Similarly, in *American Online Inc. v. Johuathan Investments Inc.*,⁸¹ which involved the domain name *fucknetscape.com*, the panel stated as follows:

The Panel regards it as inconceivable that anyone looking at this Domain Name will believe that it has anything to do with a company of such high repute as the Complainant. It is manifestly, on its face, a name, which can have nothing whatever to do with the Complainant. It is a name, which, by its very nature, declares that it is hostile to Netscape.

(ii) Rights and Legitimate Interests

The complainant must prove that the registrant does not have rights or legitimate interests in respect of the domain name.

(a) General

Policy paragraph 4(c) stipulates that the following circumstances, if proved, demonstrate the registrant's rights or legitimate interests in a domain name:

- i. the registrant used or demonstrably prepared to use the domain name or a corresponding name in connection with a *bona fide* offering of goods or services prior to notice of the dispute;
- ii. the registrant (as an individual, business, or other organization) has been commonly known by the domain name, even if it has not acquired trademark rights; or
- iii. the registrant is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the complainant's mark.

In interpreting this required element, panels have held as follows:

- The registration and use of a domain name is not illegitimate merely because the domain

- name is not derived from the registrant's trademark or trade name.[82](#)
- The registration of a domain name is not, by itself, sufficient to establish rights or legitimate interests in the domain name.[83](#)
- The mere registration of a trademark does not necessarily create a legitimate interest under the *Policy*.[84](#)
- Mere assertions of intent to use a domain name for legitimate noncommercial or fair uses are not sufficient to show a legitimate interest.[85](#)
- A registrant may have difficulty establishing rights or legitimate interests in a domain name where no product or service has been marketed using the domain name,[86](#) or it is not used for an active Web site.[87](#) However, in certain circumstances non-use may be entirely legitimate.[88](#)
- In some circumstances, a registrant may be considered to have no rights or legitimate interests in a domain name if the use of the domain name would infringe the trademark rights of the complainant.[89](#)
- Only uses before the registrant receives notice of the complainant's objections may be considered when determining whether the registrant has legitimate rights and interests in the domain name.[90](#)
- A domain name registrant is entitled to claim legitimate rights and interests in a generic mark, even where the mark is registered as a trademark by another person.[91](#)
- An individual has a legitimate interest in a domain name that corresponds to their name. [92](#)
- Factors relating to bad faith registration and use, such as the registration of multiple domain names, should not generally form part of the analysis of whether the registrant has legitimate rights and interests in a domain name.[93](#)
- Collecting domain names is not a legitimate right or interest.[94](#)
- Using a domain name as an email address may give rise to a legitimate right and interest in the domain name.[95](#)
- The bad faith registration and use of a domain name within the meaning of the *Policy* is not sufficient to establish the requisite rights or legitimate interests in the domain name.[96](#)
- The knowing use of a domain name that infringes trademark rights is unlikely to be *bona fide*, and is therefore incapable of giving rise to a legitimate right or interest.[97](#)

(b) Criticism and Commentary Uses

There is a difference of opinion regarding whether a registrant has a right or legitimate interest in a domain name that consists solely of a trademark and is used for a Web site that comments on the owner of the mark or its wares or services. A number of panels have held that such use neither gives rise to a right or legitimate interest in the domain name, nor qualifies as a "legitimate non-commercial or fair use" of the domain name within the meaning of *Policy* paragraph 4(c) (iii).[98](#) For example, in *Monty and Pat Roberts Inc. v. Keith*[99](#) the panel held that the use of the *montyroberts.net* domain name for a Web site that was critical of the famous horse trainer did not constitute a right or legitimate interest in the domain name. The panel reasoned:

...the right to express one's views is not the same as the right to use another's name to identify one's self as the source of those views. One may be perfectly free to express his or her views about the quality or characteristics of the reporting of the *New York Times* or *Time Magazine*. That does not, however, translate into a right to identify one's self as the *New York Times* or *Time Magazine*.[100](#)

Similarly, in *Compagnie de Saint Gobain v. Com-Union Corp.*[101](#) the panel held that the registrant's use of a domain name that consisted solely of the complainant's trademark was not legitimate,

reasoning that the registrant could have chosen a domain name reflecting both the "object and independent nature" of its criticism Web site. The panel stated that the dispute did not involve issues of free speech and expression rights, but rather the choice of a domain name used to exercise those rights.

In *Nintendo of America Inc. v. Alex Jones*,¹⁰² which involved the *legendofzelda.com* domain name, the panel stated as follows:

A Complainant has the right to decide how its mark will be used in the context of the product or products associated with the mark. A fan-club does not exist in a vacuum; it promotes the product for which it is named. It may, and in this case does, lead people to commercial outlets for the product. Insofar as a domain name which is identical to a name or mark is used solely in the context of the product of the owner of the name or mark and the owner objects to the use, it is not legitimate. The Complainant has the right to decide how its mark will be used in the promotion of its product. Although the Respondent may have a genuine desire to support the Complainant's products, he does not have a legitimate interest in the subject domain name which is identical to the Complainant's mark.

Different considerations may arise in circumstances where the domain name is similar, but not identical or where the use of identical words is coupled with the identification of a fan club. Neither these issues nor the question whether considerations of free speech intervene in circumstances where the use is for critical purposes are matters resolved by this Administrative Panel.

Other panels have held that the use of a trademark as the domain name for a critical or laudatory Web site does give rise to a legitimate interest in the domain name.¹⁰³ For example, in *Bridgestone Firestone Inc. v. Meyers*,¹⁰⁴ which involved the *bridgestone-firestone.net* domain name, the panel held that it is not necessary for critical Web sites to use "circumlocutions" like *[trademark]sucks.com*. The panel emphasized that the "fair use doctrine applies in cyberspace as it does in the real world", and reasoned that "the Internet is above all a framework for global communication, and the right to free speech should be one of the foundations of Internet law".¹⁰⁵ Similarly, in *The Sam Francis Estate v. Magidson Fine Art Inc.*,¹⁰⁶ a majority of the panel held that an art gallery's use of a domain name comprised solely of a famous artist's name for a commercial Web site may be a permissible "fair use" or "nominative use".¹⁰⁷

In *A & F Trademark Inc. v. Justin Jorgensen*,¹⁰⁸ which involved the *abercrombieandfilth.com* domain name, the panel held that in some circumstances a parodic use of a trademark in a domain name might give the registrant a legitimate interest in the domain name. The panel held that to constitute a parody, the use must "convey two simultaneous - and contradictory - messages: that it is the original, but also that it is not the original and is instead a parody". The panel established a two-step test for determining whether a domain name is a defensible parody: (a) the domain name itself, without reference to Web site content, must be capable of constituting a parody; and (b) the registrant's use of the domain name, for a Web site or otherwise, must be consistent with that parody. The panel held that the *abercrombieandfilth.com* domain name was capable of being a parody, but its use for a commercial Web site, which promoted gay-oriented pornographic goods and services and did not in any way poke fun at Abercrombie & Fitch, was inconsistent with that claim. Accordingly, the panel held that the registrant did not have any rights or legitimate interests in the domain name.

Underlying the different views regarding fan site domain names is a fundamental disagreement regarding the nature and function of domain names. Some panels view domain names as indicating the source of the Web site. In *DaimlerChrysler Corporation v. Bargman*,¹⁰⁹ involving a dispute over the *dodgeviper.com* domain name, the panel stated as follows:

Because Respondent uses the Domain Name for a fan website, there is a potential issue of nominative fair use. It is unquestionable, however, that Internet users frequently associate a domain name comprised of a trademark with the particular company that produces or offers goods and/or services under that mark. This is particularly true where as here the Domain Name consists of two different trademarks that together form the brand name for a well-known product. Respondent's recent addition of a disclaimer does not counter that expectation. Disclaimers are not always read or understood, and potential customers may not notice or appreciate Respondent's disclaimer. More fundamentally, Respondent's disclaimer, "Fan Appreciation Page" will not prevent a likelihood of confusion because it is not part of the Domain Name itself. Had Respondent registered and used a "dodgeviper"-formative domain name that on its face clearly indicated the fan appreciation nature of the site, the result might be different.

This view is consistent with the approach taken by other panels and numerous courts.¹¹⁰

At least one other panel has disagreed with this view, and held that domain names do not necessarily indicate the source or affiliation of the corresponding Web site. In *Springsteen v. Burgar*,¹¹¹ the majority of the panel stated as follows:

... it is relatively unlikely that any user would seek to go straight to the internet and open the site <*brucespringsteen.com*> in the optimistic hope of reaching the official Bruce Springsteen website. If anyone sufficiently sophisticated in the use of the internet were to do that, they would very soon realise that the site they reached was not the official site, and consequently would move on, probably to conduct a fuller search. ...

[T]he users of the internet do not expect all sites bearing the name of celebrities or famous historical figures or politicians, to be authorised or in some way connected with the figure themselves. The internet is an instrument for purveying information, comment, and opinion on a wide range of issues and topics. It is a valuable source of information in many fields, and any attempt to curtail its use should be strongly discouraged. Users fully expect domain names incorporating the names of well known figures in any walk of life to exist independently of any connection with the figure themselves, but having been placed there by admirers or critics as the case may be.

(c) Speculation in Generic Domain Names

There is disagreement whether speculation in generic domain names is a legitimate interest within the meaning of the *Policy*. Some panels have held that registering generic words as domain names for resale establishes a legitimate interest in the domain names, provided there is no intent to profit from other's trademark rights.¹¹² Other panels have held that there must be something more, such as demonstrable preparations to use the generic domain name in good faith, before the registrant can assert rights or legitimate interests in the domain name within the meaning of the *Policy*.¹¹³

(iii) Bad Faith Registration and Use

A complainant must prove that the domain name was registered and is being used in bad faith. The language of *Policy* paragraph 4(b)(iii) is conjunctive, and requires that both bad faith registration and bad faith use be proved.¹¹⁴

Policy paragraph 4(b) identifies the following circumstances as evidence of bad faith domain name registration and use:

- i. the registrant registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring it to the complainant owner of the mark or its competitor for valuable consideration in excess of the registrant's documented out-of-pocket costs directly related to the domain name; [115](#)
- ii. the registrant registered the domain name to prevent the complainant owner of the mark from using it in a corresponding domain name, provided the registrant has engaged in a pattern of such conduct; [116](#)
- iii. the registrant registered the domain name primarily to disrupt the business of a competitor; [117](#) or
- iv. the registrant used the domain name to intentionally attempt to attract, for commercial gain, users to its Web site by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Web site or a product or service on the Web site. [118](#)

The *Policy* expressly states that these circumstances are non-exclusive. [119](#)

In interpreting this required element, panels have held as follows:

- "Bad faith" within the meaning of the *Policy* is a term of art, and is not intended to apply to distasteful conduct that might constitute bad faith in the ordinary sense of the term. [120](#)
- The registrant's intention may be determined by common sense inferences from circumstantial evidence. [121](#)
- The acquisition of a pre-registered domain name is the equivalent of initial registration for the purpose of the bad faith requirement. [122](#)
- The use contemplated by the *Policy* does not have the narrow, technical meaning given to it by national trademark laws, but rather includes any kind of activity through which the registrant derives or attempts to derive economic benefit. [123](#)
- Bad faith use is established if the domain name is used in bad faith at any time after its registration. [124](#)
- Mere passive holding of a domain name (where there is no active Web site, no offer to sell, and no positive action by the registrant) can, in certain circumstances, constitute use in bad faith. [125](#)
- Bad faith use may be found where a registrant fails to make good faith inquiries as to whether its use of the domain name will infringe the rights of a trademark owner. [126](#)
- The *Policy* does not require a person registering a domain name to conduct a prior trademark search in every country of the world for conflicting trademark rights. [127](#)
- A registrant's mistaken belief that a mark was generic and not entitled to trademark protection is not a defence to a claim of bad faith registration and use. [128](#)
- A registrant's mistaken belief that one is entitled to register an unregistered trademark as a domain name does not preclude a finding of bad faith - "ignorance of the *Policy*" is not an excuse. [129](#)
- Bad faith may be inferred where a registrant has engaged in a pattern of registering domain names that are identical to popular Web site domain names except for slight differences that may occur as a result of common keyboarding or spelling errors in order to generate traffic to the mis-labeled Web site (a practice known as "typosquatting"). [130](#)
- Bad faith registration and use may be established where the registrant violates the terms of a license agreement. [131](#)
- Bad faith registration and use may be established where the registrant provided misleading

- contact information in its registration documents. [132](#)
- The registration of a domain name replicating an existing trademark is not conclusive evidence of bad faith. [133](#)
- Nominative use of a trademark in connection with the sale of goods or services that are properly identified by the trademark does not constitute bad faith. [134](#)
- Temporary bad faith use is sufficient to satisfy the *Policy*. [135](#)
- Registering additional domain names in retaliation for the filing of a complaint pursuant to the *Policy* constitutes bad faith. [136](#)
- Negotiations between the parties regarding the sale of the domain name do not necessarily constitute evidence of bad faith use by the registrant. [137](#)
- Bad faith registration and use may be demonstrated by an offer to sell the domain name in an online auction, even though no price is stipulated. [138](#)
- A mere offer to sell a domain name for a large sum of money is not conclusive evidence of bad faith. In some circumstances, demanding a large sum of money for a domain name may be entirely appropriate. Further, an offer to sell a domain name must be such as to indicate that selling the domain name for an excessive sum was the "primary purpose" in registering the domain name. [139](#)
- Refusing to sell a domain name is not evidence of bad faith. [140](#)
- Offering to transfer a domain name if the complainant makes a charitable donation is evidence of bad faith. [141](#)

There is disagreement regarding the interpretation of *Policy* paragraph 4(b) (ii), which refers to the registration of a domain name "to prevent the complainant owner of the mark from using it in a corresponding domain name". In *Springsteen v. Burgar* [142](#) the majority of the panel held that paragraph 4(b) (ii) should be read as referring to "any corresponding domain name" rather than "a particular corresponding domain name". The majority concluded that paragraph 4(b) (ii) was not implicated because the registrant's registration of *brucespringsteen.com* and *brucespringsteen.org* did not prevent the complainant from registering *brucespringsteen.net*. That interpretation was expressly disagreed with by the panel in *Julie Brown v. Julie Brown Club* [143](#) and *Celine Dion v. Burgar*, [144](#) on the basis that the registration of a trademark as a domain name in the *.com* gTLD prevented the trademark owners from securing "the straightforward *.com* registration" for their trademarks, which is "a corresponding domain name". The panel reasoned that if the *springsteen.com* panel's interpretation were correct, then paragraph 4(b) (ii) would rarely be met because a domain name corresponding to the trademark would almost always be available in one of the hundreds of country code TLDs.

There is also disagreement regarding the application of the *Policy* to generic domain name speculation. A number of panels have held that speculation in generic or descriptive domain names does not constitute bad faith. [145](#) Other panels have held otherwise, especially where the registrant had constructive or actual knowledge of the conflicting trademark. [146](#)

There is disagreement regarding whether a Web site that is critical or laudatory of a trademark owner is a bad faith use of the Web site domain name. Some panels have held that critical Web site content is not a bad faith use. [147](#) Other panels have held that using a domain name for a Web site that attacks the owner of the trademark reflected in the domain name is a bad faith use. [148](#) Some panels have held that a domain name used for a good faith fan club site is nevertheless used in bad faith if the domain name is identical to the complainant's trademark, while other panels have taken the opposite view. [149](#)

There is disagreement regarding whether the requisite bad faith must have existed at the time of initial registration or acquisition of the domain name, or if the renewal of a domain name registration

in bad faith is sufficient.[150](#)

There are even differing views regarding the meaning of "competitors" in *Policy* paragraph 4(b) (iii). Panels have broadly interpreted that provision, and held that parties are competitors if the registrant operates a Web site that is critical of the complainant.[151](#) At least two other panels have adopted a literal interpretation, and held that to be competitors the parties must sell competing goods or services.[152](#)

VI. MISCELLANEOUS ISSUES

(a) Burden of Proof

The burden is on the complainant to prove each of the three requirements elements set forth in *Policy* paragraph 4(a). It is not sufficient for the Complainant to make assertions without providing proof.[153](#) In the absence of evidence sufficient to prove the three elements required by *Policy* paragraph 4(a), the complaint ought to be dismissed.[154](#) A number of panels have emphasized the importance of filing appropriately detailed evidence (including statutory declarations and corroborative documentary evidence).[155](#)

The second element required by *Policy* paragraph 4(a) - the registrant has no legitimate right or interest in the domain name - requires the complainant to prove a negative proposition, which can be particularly difficult.[156](#) A number of panels have held that the burden on the complainant regarding the second element is necessarily light, because the nature of the registrant's rights or interests, if any, in the domain name lies most directly within the registrant's knowledge.[157](#) Other panels have held that once the complainant makes a *prima facie* showing that the registrant does not have rights or legitimate interest in the domain name, the evidentiary burden shifts to the registrant to rebut the showing by providing evidence of its rights or interests in the domain name.[158](#) At least one panel has held that a failure to deny the complainant's allegations of bad faith registration and use may be construed as an "admission by silence".[159](#)

Panels have also held, however, that a complainant must provide reasonably available evidence in support of its assertion that the registrant does not have any rights or interests in the domain name, such as trademark searches, telephone directory searches, company and business name searches, and Internet searches.[160](#)

(b) Default Proceedings

A registrant's failure to respond to a complaint does not automatically result in a decision in favour of the complainant. The complainant must still prove each of the three elements required by *Policy* paragraph 4(a).[161](#) However, *Rules* paragraph 14(b) provides that a panel may draw such inferences as are appropriate from a party's failure to comply with the *Rules*, including the failure to reply to a complaint.[162](#)

(c) Without Prejudice Negotiations

Rules paragraph 10(d) provides that the panel "shall determine the admissibility of evidence". There is disagreement regarding the admissibility of evidence of without prejudice negotiations regarding the possible sale of a domain name. Some panels have held that it is not appropriate for a panel to consider evidence of *bona fide* without prejudice negotiations.[163](#) They consider such evidence to

be inadmissible for the same reasons such evidence is excluded under the evidence laws of the United States, Canada and similar countries: parties may offer to settle a claim for many legitimate reasons unconnected with the merits of the dispute; and the public policy favouring settlements may be undermined if evidence of settlement negotiations is admitted into evidence.

A contrary view has been expressed by at least one panel, which held that evidence of without prejudice settlement negotiations between the parties' solicitors before the commencement of proceedings was admissible evidence of the registrant's bad faith under *Policy* paragraph

4(b)(i).¹⁶⁴ The panel reasoned that evidence of the communications should be admitted because "it would be too simple to disguise the sale of a domain name for a sum in excess of out of pocket expenses as an agreement to settle thus avoiding a finding of bad faith pursuant to paragraph 4(b)(i) ..." and "it makes no sense to discard what would otherwise be valid evidence of bad faith merely because the parties had conducted their dealings through an intermediary who is also a solicitor". In that case, however, the panel noted that neither party had objected to the admissibility of the evidence.

(d) Reverse Domain Name Hijacking

Rules paragraph 15(e) provides that if a complaint is brought in bad faith, for example in an attempt at "reverse domain name hijacking" or to harass the registrant, the panel shall declare in its decision that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding.¹⁶⁵ The apparent intent of this declaratory sanction is to deter abuse of the *Policy*. However, there are no penalties associated with a finding of reverse domain name hijacking.

Panels have held that filing a complaint that is not supported by any evidence of the registrant's bad faith registration or use of the domain name, or failing to investigate properly or at all the possibility that the registrant may have legitimate rights or interests in the domain name, indicates that the complaint has been brought in bad faith.¹⁶⁶ Where a mark is likely to have several legitimate non-conflicting uses, complainants must take special care to ensure that there is a reasonable argument to be made with respect to each element of the *Policy*, and that their claims are not over-stated.¹⁶⁷ Complainants should also avoid providing a misleading history of the parties' dealings.¹⁶⁸

(e) Res Judicata in Policy Proceedings

The *Policy* and *Rules* are silent regarding the applicability of *res judicata* principles to *Policy* proceedings, and whether an unsuccessful complainant may subsequently bring another complaint regarding the same domain name. Several panels have considered this issues.¹⁶⁹ Those panels have held that *res judicata* principles should apply to *Policy* proceedings, and re-filed complaints should be permitted only in limited circumstances, as follows:

- i. A re-filed complaint that concerns acts that were the basis of a previous complaint should only be permitted where the panel is satisfied that a miscarriage of justice occurred in the original proceeding. For example, there was serious misconduct on the part of the panel, party or legal representative; perjured or fraudulent evidence was submitted; there has been a discovery of credible and material evidence that could not have been reasonably foreseeable or known at the time of the original proceeding; or there was a breach of natural justice in the original proceeding.
- ii. A re-filed complaint that concerns acts that have occurred subsequent to the decision on the original complaint is not subject to restrictions based upon *res judicata* principles. Because the complaint concerns acts that occurred after the original decision, it is not a dispute regarding which a final adjudication has taken place, and is truly a new proceeding under the *Policy*. Accordingly, this type of re-filed complaint should be determined *de novo* on the merits as any new complaint under the *Policy*, and the panel hearing the second complaint may not rely upon the findings of fact and conclusions reached by the panel in the first

proceeding.

A slightly different but related issue is the practice of some panels to dismiss complaints "without prejudice". As of November 12, 2001, 356 of 4,739 proceedings had been dismissed "without prejudice".¹⁷⁰ It has been observed that such a practice is generally inappropriate because it provides no finality to the dispute and no certainty to the successful registrant. If the panel considers that the complainant has not met the required elements of the *Policy*, but could do so upon the submission of further arguments or evidence, the better approach is to request further submissions and evidence from the parties. If, after being given that opportunity, the complainant is still unable to satisfy the *Policy* requirements, then the complaint ought to be dismissed "with prejudice" to the re-filing of the complaint.¹⁷¹ However, other panels have reasoned that in some circumstances (for example where there is a technical failure of proof) a without prejudice dismissal may be an appropriate means of ensuring that substantial justice is done.¹⁷²

(f) Judicial Proceedings

The *Policy* expressly provides that domain name registrants and complainants may submit their disputes to courts of competent jurisdiction for independent resolution at any time.¹⁷³ The *Policy* also provides that a panel decision that a domain name should be cancelled or transferred will not be implemented if a party initiates court proceedings within 10 days of the date of the decision.¹⁷⁴

Unfortunately, the *Policy* fails to fully explain the intended interaction between administrative panel decisions and concurrent court proceedings.¹⁷⁵ The *Rules* simply provide that if a legal proceeding is initiated prior to or during a *Policy* proceeding, the panel has the discretion to suspend or terminate the proceeding, or proceed to a decision.¹⁷⁶

In *Broadbridge Media L.L.C. v. Hypercd.com*,¹⁷⁷ a U.S. court held that a party does not waive its right to proceed with a court action (there, seeking in rem relief under the U.S. *Anticybersquatting Consumer Protection Act*) simply by initiating a proceeding under the *Policy*.

In *Weber-Stephen Products Co. v. Armitage Hardware*,¹⁷⁸ a majority of the administrative panel held that a decision should be issued under the *Policy* even though there were pending court proceedings in which the U.S. *Anticybersquatting Protection Act* was engaged. The dissenting panelist would have stayed the *Policy* arbitration in favour of the court proceedings, where the same relief was being sought and which would resolve larger issues between the parties that the panel could not decide. Judicial economy, in that panelist's view, dictated that a multiplicity of proceedings should be avoided.¹⁷⁹ In the corresponding court proceeding,¹⁸⁰ the Court stayed the lawsuit pending the outcome of the *Policy* arbitration. The Court held, however, that it was not bound by the outcome of the arbitration, and declined to determine in advance the precise standard by which it would review the administrative panel's decision or the degree of deference, if any, that would be extended to the decision.

In contrast, *Policy* proceedings were suspended by the panel in *Innersense International Inc. v. Manegre*¹⁸¹ where, the complainant had previously commenced a court proceeding and obtained an injunction restraining the registrant and others from selling or transferring the domain name until further order of the court. The panel found that it had jurisdiction to proceed to a decision, but exercised its discretion to decline to do so. In its reasons, the panel found that the apparent purpose of the injunction was to maintain the *status quo* until the court could determine the issues in the action, and that an order by the panel that the domain name be transferred to the complainant would undermine that purpose. In the circumstances, the panel held that due respect must be shown to the court and its order, and the proceedings were suspended unless and until the injunction order was set aside or varied to permit the transfer of the domain name pursuant to a decision of an

arbitrator under the *Policy*.

Innersense was distinguished in *IPF Online Ltd. v. John Hitfield*¹⁸² on the basis that, in that case, the parties to the court action were different from the parties to the *Policy* proceedings, even though the same domain name was at issue in both. The panel proceeded to render an award even though a Bangalore court had issued an order expressly enjoining the transfer of the domain name.

The *Rules* require complainants to agree to submit to the jurisdiction of the courts located in either the jurisdiction of the domain name registrar or the jurisdiction of the domain name registrant with respect to any challenges to a panel's decision canceling or transferring the domain name.¹⁸³ At least one U.S. court has held that this submission applies only to judicial challenges to decisions made under the *Policy*, and does not act as a general attornment for other civil claims.¹⁸⁴ Nevertheless, this required submission may present a significant risk for trademark owners who bring *Policy* proceedings against foreign domain name registrants or with respect to domain names registered by foreign registrars, particularly if the foreign court is in a country where the complainant does not have trademark rights or the law is less favourable than the law of countries whose courts might otherwise have jurisdiction over the registrant and the dispute.¹⁸⁵

Neither the *Policy* nor the *Rules* provide any guidance regarding the nature of a judicial "challenge" to a decision issued under the *Policy*, and in particular whether subsequent judicial proceedings are in the nature of a judicial review, an appeal, or a hearing *de novo*. That question was considered in *Parisi v. Netlearning Inc.*, which involved a dispute over the *netlearning.com* domain name.¹⁸⁶ Netlearning commenced *Policy* proceedings against Parisi, and obtained a 2-1 split decision in its favour.¹⁸⁷ Parisi then commenced a lawsuit pursuant to the U.S. trademark laws seeking declarations that he lawfully registered and used the domain name. Netlearning applied to dismiss the lawsuit on the basis that Parisi failed to comply with the procedural and substantive requirements of the U.S. *Federal Arbitration Act*, which provides only a limited basis for judicial review of an arbitration award. The Court rejected Netlearning's argument, holding that a decision pursuant to the *Policy* is not an arbitral award subject to the limited judicial review mandated by the *Federal Arbitration Act*. The Court based its decision on the following considerations: (a) The *Policy* expressly contemplates judicial proceedings; (b) participation in *Policy* proceedings are not required before either party commences judicial proceedings; (c) the narrow and specific *Policy* remedies do not justify a limited judicial review, and ICANN intended to provide parity of appeal ensuring a clear mechanism for seeking judicial review of a decision pursuant to the *Policy*; and (d) The *Policy* itself contemplates comprehensive, *de novo* adjudication of the parties' rights, including a judicial "resolution of the parties' overarching trademark, contract and other claims and defences". The Court concluded that a party to a *Policy* decision was entitled to a *de novo* review of a dispute that has been the subject of administrative proceedings pursuant to the *Policy*.

Parisi was followed in *Strick Corporation v. Strickland*, where the Court held that decision in a previous *Policy* proceeding was not binding on the court, which has *de novo* review of the matter.¹⁸⁸

(g) The Risk of Systemic Bias

- *Rough Justice* - Dr. Milton Mueller

In November 2000, Dr. Milton Mueller issued a report entitled *Rough Justice: An Analysis of ICANN's Dispute Resolution Policy*,¹⁸⁹ which provided a statistical analysis and critique of the operation of the *Policy* in its first ten months. The *Report* found that arbitration service providers have statistically significant different records when it comes to resolving disputes, and that the differences result from substantially different approaches to the interpretation of the *Policy*. The *Report* also found that complainants appeared to consider those differences when selecting an arbitration service provider.

The *Report* indicated that the service providers most likely to be chosen by complainants - the World Intellectual Property Organization (61%) and the National Arbitration Forum (31%) - were also the most likely to find in favour of complainants (approximately 80%). Conversely, eResolution, chosen only 7% of the time, was the least likely to find in favour of complainants (approximately 60%).

The *Report* attributed the differences in result to the tendency of eResolution panelists to adopt a stricter and more literal interpretation of the *Policy*, whereas World Intellectual Property Organization and National Arbitration Forum panelists tend to adopt a more expansive, results-oriented interpretation of the *Policy* that gives trademark holders stronger rights. The *Report* concludes that the *Policy* favours trademark holders because they are entitled to select the arbitration service provider.

The *Report* considers two solutions to the problem of systemic bias resulting from forum-shopping: (a) arbitration service providers could be assigned at random or in some other arbitrary fashion that prevented claimants from forum shopping; and (b) an appellate body could be constituted to oversee the quality of decision-making under the *Policy* and narrow the differences among service providers.

- *Fair.com?* - Michael Geist

In August 2001, Professor Michael Geist issued a report entitled *Fair.com?: An Examination of Allegations of Systemic Unfairness in the ICANN UDRP*.¹⁹⁰ *Fair.com?* confirms and extends many of Dr. Mueller's observations.

Geist notes earlier concerns that the *Policy* is systematically biased in favour of trademark owners, and points to evidence gathered by Dr. Mueller and others indicating that the two providers most likely to release decisions ordering transfers of domain names (WIPO and NAF) were also the most likely to be chosen by complainants. In comparison, the provider least likely to release decisions in favour of complainants (eResolution) was the least likely to be chosen by complainants.

Dismissing factors such as variations in fees, panelist roster compositions, applicable supplemental rules, and marketing practices, Geist concludes that influence over panel composition is likely the most important controlling factor in determining case outcomes. Complainants' greater success before single-member panels is ultimately attributable, argues Geist, to the tendency of NAF and WIPO to routinely assign the bulk of their claims to a limited number of complainant-friendly panelists.

Geist concludes with a series of recommendations designed to alleviate the perceived problem of provider bias in selecting panelists: (a) all contested *Policy* proceedings should be heard by three-member panels; (b) minimum and maximum individual panelist caseloads should be established; (c) there should be annual public reviews of each provider's roster of panelists, with unsatisfactory panelists being removed from service; and (d) *Policy* decisions should be reported in a standard, readily-available format, in order to increase the general transparency of *Policy* proceedings.

Geist's conclusions have been criticized. For example, the disproportionate degree of success enjoyed by complainants before single-member panels might be attributable to the high rate of default by respondents. Conversely, three-member panel proceedings are likely to be more vigorously contested, with a concomitantly higher likelihood that the respondents will prevail.¹⁹¹

VII. CONCLUSION

The *Policy* grants to trademark owners certain rights against persons who register and use in bad faith domain names in which they have no legitimate right or interest and which conflict with the trademark owner's mark. The *Policy* also provides a relatively quick, inexpensive and informal

procedure for arbitrating disputes regarding such domain names.

The *Policy* is a positive first step in establishing a global set of rules for the resolution of certain kinds of Internet-related trademark disputes. Nevertheless, the *Policy* has significant deficiencies:

- a. The *Policy's* written process makes it difficult for arbitrators to resolve issues of credibility and motive, or to resolve conflicting evidence.
- b. The parties' limited right to make reply submissions may in some circumstances result in procedural unfairness.
- c. The *Policy* fails to provide guidance regarding the application of potentially conflicting national trademark laws.
- d. There is no appellate body to provide guidance regarding the interpretation of the *Policy*,¹⁹² or to provide a quick and inexpensive means of correcting patently incorrect decisions.¹⁹³
- e. The *Policy* fails to indicate the intended interaction between *Policy* proceedings and concurrent court proceedings, and the nature of judicial challenges decisions made under the *Policy*.
- f. The *Policy* permits complainants to forum shop and facilitates systemic bias.

Certain of these problems may be addressed by amendments to the *Policy*. The September 2001 *Report of the Second WIPO Internet Domain Name Process* assessed the progress of the *Policy*, but made generally conservative recommendations regarding amendments to the *Policy*.

Other deficiencies may simply reflect the challenges inherent in on-line, transnational, arbitration. The *Policy* strives to accommodate legal perspectives and rules from all jurisdictions, and provide a relatively quick, inexpensive and informal procedure. The lack of a discovery process, no opportunity to challenge adverse evidence through cross-examination or otherwise, limited submissions, and uncertainty regarding applicable legal principles may simply be the inevitable trade-offs disputants must accept in order to participate in cost effective, on-line arbitration.

Future refinements of the *Policy* and the development of other online arbitration regimes must ensure that basic principles of fairness and rationality are not sacrificed in favour of the desire for speed, reduced costs, and simplicity that motivated the creation of the *Policy* in the first place.

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¹ [Back](#) The text of the *Policy* may be found at www.icann.org/udrp/udrp-policy-24oct99.htm. For a general description of the development of the *Policy*, see C.J. Schulte, "The New Anticybersquatting Law and Uniform Dispute Resolution Policy for Domain Names", (2000), 36(1) *Tort & Ins. L.J.* 101; P.L. Jones, "Protecting Your *SportEvent.com*": *Athletic Organizations and the Uniform Domain Name Dispute Resolution Policy* (2001), 5 *W.Va. J.L.&Tech.* 2; and S.H. King, "The 'Law That It Deems Applicable': ICANN, Dispute Resolution and the Problem of Cybersquatting" (2000) 27 *Hastings*

Comm. & Ent. L.J. 453.

² [Back](#) In late 1998, ICANN was established to administer the gTLD system and other Internet related matters. ICANN removed Network Solutions Inc.'s monopoly over the administration and registration of gTLDs, and established a Shared Registration System to administer the gTLDs through quasi-private sector initiatives and competition among registrars. The .com, .net and .org gTLDs are currently administered by VeriSign Inc. This monopoly is subject to several restrictions, and will eventually conclude between 2002 and 2007, as set forth in an agreement among the U.S. Department of Commerce, Verisign Inc. and ICANN on May 18, 2001. Other gTLDs, such as .info, .biz, .name, .pro, .museum, .aero and .coop are operated by other private sector registrars through agreements with ICANN.

³ [Back](#) This paper is generally current to November 15, 2001. As of that date, there had been 4,756 proceedings involving 8,167 domain names and resulting in 3,881 decisions. Current statistics regarding the *Policy* may be found at www.icann.org/udrp/proceedings-stat.htm. A list of all current ICANN *Policy* disputes and decisions may be found at www.icann.org.

⁴ [Back](#) A timeline for the formulation and implementation of the *Policy* may be found at www.icann.org/udrp/udrp-schedule.htm0.

⁵ [Back](#) *Sankyo Co. Ltd. v. Zhu Jiajun*, Case No. D2000-1791 (March 23, 2001): "Multilingual domain names also function as a source identifier and affect Internet traffic in exactly the same way as other English-language domain names do. Accordingly, it is natural in view of their function and clear from the Agreement that the *Policy* applies to multilingual as well as English-language domain names". See also *The Dow Chemical Company Inc. v. Iryu Keiei Kenkyusho Ltd.*, Case No. AF-0747 (May 17, 2001).

⁶ [Back](#) One of the first decisions regarding a ccTLD was *Toronto Star Newspaper Ltd. v. Elad Cohen*, Case No. DTV2000-0006 (January 22, 2001), regarding the *tstv.tv* domain name.

⁷ [Back](#) See www.cira.ca/adr.html. Because CIRA has not yet implemented a dispute-resolution process, parties are compelled to institute formal court proceedings if a dispute regarding a .ca domain name cannot be resolved informally: see *Itravel2000.com Inc. v. Fagan*, [2001] O.J. No. 943 (Sup.Ct.).

⁸ [Back](#) For example, the VeriSign Services Agreement provides, in relevant part, as follows: "Dispute *Policy*. If you registered a domain name through us, you agree to be bound by our current domain name dispute policy that is incorporated herein and made a part of this Agreement by reference. The current version of the domain name dispute policy may be found at our Web site: http://www.netsol.com/en_US/legal/dispute-policy.jhtml." See also *Policy*, paragraph 1.

⁹ [Back](#) *Parisi v. Netlearning Inc.*, 2001 WL 503004 (E.D. Vir. 2001).

¹⁰ [Back](#) *America Online Inc. v. Frank Albanese*, Case No. D2000-1604 (January 25, 2001); *e-Duction Inc. v. Zuccarini*, Case No. D2000-1369 (February 5, 2001); *Inter-Continental Hotels Corporation v. Khaled Ali Soussi*, Case No. D2000-0252 (July 5, 2000).

¹¹ [Back](#) *Quarterview v. Quarterview Co. Ltd.*, Case No. AF-0209(a-b) (July 6, 2000); *Libro AG v. NA Global Link Limited*, Case No. D 2000-0186 (May 16, 2000); *Toronto Star Newspapers Limited v. Virtual Dates Inc.*, Case No. D2000-1612 (February 6, 2001). *Two Systems Enterprises Co. Ltd. v. Sonie's Creations*, Case No. AF-0911 (September 7, 2001).

- ¹² [Back](#) The *Policy* does not apply to disputes regarding meta-tags: *Reg Vardy Plc v. David Wilkinson*, Case No. D2001-0593 (July 3, 2001).
- ¹³ [Back](#) *Educational Testing Service v. TOEFL*, Case No. D2000-0044 (March 16, 2000); *FLOS Spa. v. Victory Interactive Media S.A.*, Case No. D2000-0771 (December 15, 2000); *Re. Infolink v. Nathan Frey*, Case No. D2000-1687 (March 26, 2001); *Tribeca Film Center Inc. v. Lorenzo Brusasco-Mackenzie*, Case No. D2000-1772 (April 10, 2001); *Deutsche Welle v. DiamondWare Limited*, Case No. D2000-1202 (January 2, 2001); *Nintendo of America Inc. v. Alex Jones*, Case No. D2000-0998 (November 17, 2000); *Cellular One Group v. Applied Communications Inc.*, Case No. D20001-1520 (February 6, 2001); *Rogers Cable Inc. v. Arran Lai*, Case No. D2001-0201 (March 30, 2001).
- ¹⁴ [Back](#) *Wal-Mart Stores Inc. v. walmartcanadasucks.com*, Case No. D2000-1104 (November 23, 2000); *Jules I. Kendall v. Mayer*, Case No. D2000-0868 (October 26, 2000); *CMG Worldwide Inc. v. Bonnie Masterson*, Case No. FA104000097061 (June 13, 2001).
- ¹⁵ [Back](#) *Quartermview v. Quartermview Co. Ltd.*, Case No. AF-0209 (July 6, 2000); *Adaptive Molecular Technologies Inc. v. Priscilla Woodward and others*, Case No. D2000-0006 (February 28, 2000); *Avnet Inc. v. Aviation Network Inc.*, Case No. D2000-0046 (March 24, 2000); *Plaza Operating Partners Ltd. v. Pop Data Technologies Inc. v. Pillus*, Case No. D2000-0166 (June 1, 2000).
- ¹⁶ [Back](#) *Tribeca Film Center Inc. v. Lorenzo Brusasco-Mackenzie*, Case No. D2000-1772 (April 10, 2001); *Lopez v. Irish Realty Corp.*, Case No. FA0005000094906 (August 8, 2000); *Quartermview v. Quartermview Co. Ltd.*, Case No. AF-0209(a-b) (July 6, 2000); *America Online Inc. v. John Deep Buddy U.S.A. Inc.*, Case No. FA01030000096795 (May 14, 2001), dissenting panelist; *J. Crew International Inc. v. crew.com*, Case No. D2000-0054 (February 16, 2000), dissenting panelist; *Re. Infolink v. Nathan Frey*, Case No. D2000-1687 (March 26, 2001); *FLOS Spa. v. Victory Interactive Media S.A.*, Case No. D2000-0771 (December 15, 2000); *Robert Alan Thomas v. Customer Card Services*, Case No. D2000-0872 (October 2, 2000); *United States Postal Service v. Postoffice.com Inc.*, Case No. FA0012000096313 (March 19, 2001).
- ¹⁷ [Back](#) *Madonna Ciccone p/k/a/ Madonna v. Parisi*, Case No. D2000-0847 (October 12, 2000); *Pacific Fence & Wire Co. v. Pacific Fence and Jim Paradise*, Case No. D2001-0237 (June 11, 2001); *Magnum Piering, Inc. v. The Mudjackers and Garwood S. Wilson, Sr.*, Case No. D2000-1525 (January 29, 2001); *Anheuser-Busch Incorporated v. Fernand Dumas*, Case No. D2001-0651 (July 20, 2001).
- ¹⁸ [Back](#) *Ty Inc. v. Parvin*, Case No. D2000-0688 (November 9, 2000).
- ¹⁹ [Back](#) The Report may be found at www.icann.org/udrp/udrp-second-staff-report-24oct99.htm.
- ²⁰ [Back](#) The *Rules* may be found at www.icann.org.
- ²¹ [Back](#) Information regarding the providers may be found at www.icann.org/udrp/approved-providers.htm.
- ²² [Back](#) *Policy*, paragraph 4(d).
- ²³ [Back](#) *Rules*, paragraph 3.
- ²⁴ [Back](#) *Rules*, paragraph 5.

²⁵ [Back](#) *Brisbane City Council v. Warren Bolton Consulting Pty Ltd.*, Case No. D2001-0047 (May 7, 2001); *Document Technologies, Inc. v. International Electronic Communications Inc.*, Case No. D2000-0270 (June 6, 2000); *Universal City Studios Inc. v. G.A.B. Enterprises*, Case No. D2000-0416 (June 29, 2000); *Sumner p/k/a Sting v. Urvan*, Case No. D2000-0596 (July 20, 2000); *Plaza Operating Partners Ltd. v. Pop Data Technologies Inc. v. Pillus*, Case No. D2000-0166 (June 1, 2000); *Pacific Fence & Wire Co. v. Pacific Fence and Jim Paradise*, Case No. D2001-0237 (June 11, 2001).

²⁶ [Back](#) See, for example, *American Eyewear Inc. v. Thralow Inc.*, Case No. D2001-0991 (October 24, 2001); *CRS Technology Corp. v. CondeNet Inc.*, Case No. FA0002000093547 (March 27, 2000); *Plaza Operating Partners Ltd. v. Pop Data Technologies Inc. v. Pillus*, Case No. D2000-0166 (June 1, 2000); *University City Studios Inc. v. G.A.B. Enterprises*, Case No. D2000-0416 (June 29, 2000); *The Toronto-Dominion Bank v. Boris Kapachev*, Case No. D2000-1571 (January 15, 2001). See contra *Minnesota Mining and Manufacturing Company v. Mark Overbey*, Case No. D2001-0727 (October 15, 2001).

²⁷ [Back](#) Case No. AF-0102 (March 23, 2000).

²⁸ [Back](#) Case No. FA0010000095752 (November 22, 2000).

²⁹ [Back](#) *Corinthians Licenciamentos LTDA v. Sallen*, Case No. D2000-0461 (July 17, 2000); *Commonwealth Hotels Inc. v. CCD Internet*, Case No. AF-00771 (May 17, 2001); *Link Clicks Inc. v. John Zuccarini*, Case No. D2000-1547 (January 12, 2001); *Two Systems Enterprises Co. Ltd. v. Sonie's Creations*, Case No. AF-0911 (September 7, 2001).

³⁰ [Back](#) *Newman/Haas Racing v. Virtual Agents Inc.*, Case No. D2000-1688 (March 29, 2001); *Rogers Cable Inc. v. Arran Lai*, Case No. D2001-0201 (March 30, 2001).

³¹ [Back](#) *Rules*, paragraph 6(b). The propriety of *Policy* panelists acting as counsel regarding a *Policy* proceeding was considered and confirmed by at least one panel. In *Newman/Haas Racing v. Virtual Agents Inc.*, Case No. D2000-1688 (March 29, 2001), the registrant objected to the complainant's counsel on the basis that he was also a WIPO panelist and the dispute was being heard by a WIPO-appointed panel. The panel dismissed the objection on the basis that there was nothing improper or unusual about *Policy* panelists acting as counsel. The panel reasoned that in many jurisdictions practicing counsel from time to time sit as deputy judges, and that panelists are often qualified by virtue of their experience acting for parties to *Policy* disputes. The panel held that so long as the members of the panel are truly independent of the parties to the dispute, neither party is disadvantaged.

³² [Back](#) *Rules*, paragraphs 6(c).

³³ [Back](#) *Rules*, paragraph 15(b).

³⁴ [Back](#) Nor may a panel issue an extraordinary order even in cases of blatant, serial cybersquatting: *NCRAS Management LP v. Cupcake City and John Zuccarini*, Case No. D2000-1803 (February 26, 2001).

³⁵ [Back](#) *ISL Marketing AG v. Chung*, Case No. 2000-0034 (April 3, 2000). See also *Kelson Physician Partners, Inc. v. Mason*, Case No. CPR003.

³⁶ [Back](#) The Report is available at www.icann.org.

³⁷ [Back](#) *Sporting Goods Manufacturers Association v. InterAD Group Inc.*, Case No. D2000-0202 (May 22, 2000); *Robert Ellerbogen v. Mike Pearson*, Case No. D2000-0001 (January 10, 2000); *Exario Network Inc. v. The Domain Name You Have Entered is for Sale*, Case No. AF-0536 (December 11, 2000); *Packaging World Inc. v. Zynpak Packaging Products Inc.*, Case No. AF-0233 (July 28, 2000); *The Chicago Tribune Company v. Varkey*, Case No. D2000-0133 (May 9, 2000); *Nintendo of America Inc. v. Holland*, Case No. D2000-1483 (January 11, 2001); *Two Systems Enterprises Co. Ltd. v. Sonie's Creations*, Case No. AF-0911 (September 7, 2001).

³⁸ [Back](#) *SGS Societe Generale de Surveillance S.A. v. Inspectorate*, Case No. D2000-0025 (February 9, 2000).

³⁹ [Back](#) *Capcom Co. Ltd. and Capcom U.S.A. Inc. v. Dan Walker*, Case No. D2000-0200 (March 27, 2000); *Empresa Brasileira de Telecomunicacoes S.A. - Embratel v. Kevin McCarthy*, Case No. D2000-0164 (March 22, 2000).

⁴⁰ [Back](#) *Singapore Airlines Limited v. Robert Nielson (trading as Pacific International Distributors)*, Case No. D2000-0644 (July 6, 2000); *Global Print Exchange Pte. Ltd. v. Robert Paul Soden*, Case No. AF-0275 (July 13, 2000).

⁴¹ [Back](#) Case No. AF-07591 (May 24, 2001).

⁴² [Back](#) See also *4You A/S v. 4You oNet Services*, Case No. FA0010000095647 (November 30, 2000) and *New York Times Company v. New York Times Internet Services*, Case No. D2000-1072 (December 5, 2000).

⁴³ [Back](#) Under the laws of most countries, including Canada and the United States, trademark rights are limited to the territorial jurisdictions in which the mark is registered or the geographic areas in which the mark has goodwill and reputation. This limitation presents significant challenges to trademark owners given that there is a single, global Internet domain name system. The *Policy* overcomes this limitation by simply ignoring it. The rights afforded by the *Policy* to trademark owners are not limited by geographic or territorial considerations.

⁴⁴ [Back](#) *Policy* paragraph 4(a).

⁴⁵ [Back](#) *Edward Van Halen v. Morgan*, Case No. D2000-1313 (December 20, 2000).

⁴⁶ [Back](#) "In this process, we should look to prior panel decisions to offer guidance, and, to the extent reasonable, we should attempt to harmonize our decisions with those of prior panels. The decision we reach should naturally flow from that process.": *Ty Inc. v. Parvin*, Case No. D2000-0688 (November 9, 2000).

⁴⁷ [Back](#) Conversely, the existence of a registered trademark is not necessarily dispositive, although a governmental body's decision to permit the trademark to be registered will be accorded a very high degree of deference: *America Online Inc. v. John Deep Buddy U.S.A. Inc.*, Case No. FA01030000096795 (May 14, 2001); *Eauto L.L.C. v. Triple S. Auto Parts d/b/a Kung Fu Yea Enterprises Inc.*, Case No. D2000-0047 (March 24, 2000); *The Chancellor, Masters and Scholars of the University of Oxford v. DR Seagle t/a Mr. Oxford-University*, Case No. D2001-0746 (August 14, 2001). Still, the administrative panel may determine that it must come to its own decision on the point.

⁴⁸ [Back](#) *Julia Fiona Roberts v. Russell Boyd*, Case No. D2000-0210 (May 29, 2000); *Exario Network Inc. v. The Domain Name You Have Entered is for Sale*, Case No. AF-0536 (December 11, 2000); *GroupHug Productions Inc. v. Overstreet Health Center*, Case No. FA0012000096271 (February 21, 2001); *SeekAmerica Inc. v. Tariq Masood and Solo Signs*, Case No. D2000-0131 (April 13, 2000); *Packaging World Inc. v. Zynpak Packaging Products Inc.*, Case No. AF-0233 (July 28, 2000); *MathForum.com LLC v. Weiguang Huang*, Case No. D2000-0743 (August 23, 2000); *Gallerina v. Mark Wilmhurst*, Case No. D2000-0730 (July 18, 2000); *Winterson v. Hogarth*, Case No. D2000-0235; *Gateway Inc. v. Cadieux*, Case No. D2000-0198; *Potomac Mills Limited Partnership v. Gambit Capital Management*, Case No. D2000-0062.

⁴⁹ [Back](#) *Web2You Inc. v. Mydotcom*, Case No. AF-0268 (August 7, 2000); *Creo Products Inc. v. Website in Development*, Case No. D2000-0160 (May 1, 2000). See also *Classified Ventures L.L.C. v. Softcell Marketing Inc.*, 109 F.Supp. 2d 898 (N.D.Ill. 2000), in which the Court held that *cars.com* was a famous trademark.

⁵⁰ [Back](#) In contrast, the draft CIRA *Policy* provides that a complainant licensee may have sufficient "rights" in a trademark to bring a proceeding: see draft CIRA *Policy*, s. 3.3.

⁵¹ [Back](#) Case No. D2000-1211 (December 12, 2000).

⁵² [Back](#) See also *Backstreet Boys Productions Inc. v. John Zuccarini*, Case No. D2000-1619 (March 27, 2001) and *Limco Inc. and Too Inc. v. Pat Mintash, d/b/a Mintash Enterprises*, Case No. D2001-0175 (March 4, 2001). See contra *Mitsubishi motors Corporation v. sDns.com*, Case No. D2001-1031 (October 22, 2001). See, however, *Gruner + Jahr Printing and Publishing Co. v. Savior Baby*, Case No. D2000-1741 (February 21, 2001), where at the request of the complainant trademark owners the domain name was transferred to their licensee, and *The Nasdaq Stock Market Inc. v. Green Angel*, Case No. D2001-1010 (September 30, 2001).

⁵³ [Back](#) *Two Systems Enterprises Co., Ltd. v. Sonie's Creations*, Case No. AF-0911 (September 7, 2001).

⁵⁴ [Back](#) *Jeannette Winterson v. Mark Hogarth*, Case No. D2000-0235 (May 22, 2000); *Julia Fiona Roberts v. Russell Boyd*, Case No. D2000-0210 (May 29, 2000); *Steven Rattner v. BuyThisDomain*, Case No. D2000-0402 (May 25, 2000); *Emeril Lagasse v. Vpop Technologies*, Case No. FA0003000094373 (May 8, 2000); *Anne McLellan v. Smartcanuk.com*, Case No. AF-0303(a-b) (September 25, 2000); *Daniel C. Marino, Jr. v. Video Images Productions*, Case No. D2000-0598 (August 2, 2000); *Nicole Kidman v. John Zuccarini, d.b.a Cupcake Party*, Case No. D2000-1415 (January 23, 2001); *Celine Dion v. Jeff Burgar*, Case No. D2000-1838 (February 13, 2001); *Serena Williams and Venus Williams v. Eileen White Byrne and Allgolfconsultancy*, Case No. D2000-1673 (January 30, 2001); *Mario Lemieux v. Createo*, Case No. AF-0791 (May 24, 2001); *Playboy Enterprises International Inc. v. Good Samaritan Program*, Case No. D2001-0241 (May 17, 2001); *Mick Jagger v. Hammerton*, Case No. FA0007000095261 (September 11, 2000); *Cho Yong Pil v. Imageland Inc.*, Case No. D2000-0235 (May 10, 2000); *Harrod's Limited v. Boyd*, Case No. D2000-0060 (March 16, 2000); *Madonna Ciccone p/k/a/ Madonna v. Parisi*, Case No. D2000-0847 (October 12, 2000); *Isabelle Adjani v. Second Orbit Communications Inc.*, Case No. D2000-0867 (October 4, 2000); *Pierre van Hooijdonk v. S.B. Tait*, Case No. D2000-1068 (November 4, 2000); *Helen Folsade Adu v. Quantum Computer Services Inc.*, Case No. D2000-0794 (September 26, 2000); *Rickey Skaggs v. Vincente*, Case No. D2000-1134 (December 18, 2000); *David Gilmore v. Cenicolla*, Case No. D2000-1459 (December 15, 2000); *Garth Brooks v. Shunit Sarid Commbine.com*, Case No. FA0011000096097 (January 12, 2001); *Julie Brown v. Julie Brown Club*, Case No. D2000-1628 (February 13, 2001); *Elmore "Rip" Torn v. Riptorn.com*, Case No. D2001-0850 (October 9, 2001).

⁵⁵ [Back](#) *Judy Larson v. Judy Larson Fan Club*, Case No. FA0101000096488 (March 13, 2001); *Sun*

International Resorts Inc. v. Adrian Najar, Case No. D2000-1349 (February 13, 2001); *CMG Worldwide Inc. v. Page*, Case No. FA0009000095641 (November 8, 2000); *Jules I. Kendall v. Mayer*, Case No. D2000-0868 (October 26, 2000); *Springsteen v. Bugar*, Case No. D2000-1532 (January 25, 2001).

⁵⁶ [Back](#) Case No. D2000-0596 (July 20, 2000).

⁵⁷ [Back](#) Paras. 164-169. The Report may be found at <http://ecommerce.wipo.int/domains>.

⁵⁸ [Back](#) *Anne McLellan v. Smartcanuk.com*, Case No. AF-0303(a-b) (September 25, 2000).

⁵⁹ [Back](#) The Report may be found at <http://wipo.net>.

⁶⁰ [Back](#) *Excelentismo Ayuntamiento de Barcelona v. Barcelona.com Inc.*, Case No. D2000-0505 (August 4, 2000) (barcelona.com); *Kur-und Verkehrsverein St. Moritz v. StMoritz.com*, Case No. D2000-0616 (August 17, 2000) (stmoritz.com).

⁶¹ [Back](#) *Port of Helsinki v. Paragon International Projects Ltd.*, Case No. D2001-0002 (February 12, 2001) (portofhamina.com); *City of Hamina v. Paragon International Projects Ltd.*, Case No. D2001-0001 (March 12, 2001) (portofhamina.com); *Brisbane City Council v. Warren Bolton Consulting Pty Ltd.*, Case No. D2001-0047 (May 7, 2001) (brisbanecity.com).

⁶² [Back](#) Re. *Infolink v. Nathan Frey*, Case No. D2000-1687 (March 26, 2001); *Chiswick Inc. v. S. Walter Packaging Corporation*, Case No. FA0107000098410 (October 9, 2001); *Cream Holdings Limited v. National Internet Source Inc.*, Case No. D2001-0964 (September 28, 2001).

⁶³ [Back](#) Case No. D2001-0383 (May 24, 2001).

⁶⁴ [Back](#) *Smoky Mountain Knife Works v. Deon Carpenter*, Case No. AF-230 (July 3, 2000); *Newport News Inc. v. VCV Internet*, Case No. AF-0238 (July 18, 2000); *Wal-Mart Stores Inc. v. Walsucks and Walmarket Puerto Rico*, Case No. D2000-0477 (July 20, 2000); *Wal-Mart Stores Inc. v. Richard MacLeod d/b/a For Sale*, Case No. D2000-0662 (September 19, 2000); *Nicole Kidman v. John Zuccarini, d/b/a Cupcake Party*, Case No. D2000-1415 (January 23, 2001); *Slep-Tone Entertainment Corporation v. Sound Choice Disc Jockeys Inc.*, Case No. FA20002000093636 (March 13, 2000); *VeriSign Inc. v. Michael Brook*, Case No. D2000-1139 (March 7, 2001); *Tourism and Corporate Automation Ltd. v. TSI Ltd.*, Case No. AF-0096 (March 16, 2000); *The Toronto-Dominion Bank v. Boris Kapachev*, Case No. D2000-1571 (January 15, 2001). This is the same interpretation given to a similar requirement in the U.S. *Anticybersquatting Consumer Protection Act*: see *Sporty's Farm v. Sportsman's Market Inc.*, 2000 U.S. App. LEXIS 1246 (2nd Cir. 2000), cert. denied, 2000 U.S. LEXIS 4367 (U.S.S.C. 2000); *Northern Light Technology Inc. v. Northern Lights Club*, 97 F. Supp. 2d 96 (D. Mass. 2000); aff'd, 236 F.3d 57 (1st Cir. 2001); *Spear, Leeds & Kellogg v. Rodando* 2000 U.S. Dist. LEXIS 3732 (S.D.N.Y.); *A & F Trademark Inc. v. Justin Jorgensen*, Case No. D2001-0900 (September 19, 2001); *Cream Holdings Limited v. National Internet Source Inc.*, Case No. D2001-0964 (September 28, 2001); *Vivendi Universal v. Jay David Sallen*, Case No. D2001-1121 (November 7, 2001).

⁶⁵ [Back](#) *Aurora Foods Inc. v. David Paul Jaros*, Case No. D2000-0274 (June 7, 2000); *Robert Chestnutt v. Jennifer Tumminelli*, Case No. D2000-1758 (February 2, 2001); *Jordan Grand Prix Limited v. Gerry Sweeney*, Case No. D2000-0233 (May 11, 2000); *Automatic Data Processing Inc. v. Access Electronics*, Case No. FA0101000096483 (February 20, 2001); *Motorola Inc. v. Newgate Internet Inc.*, Case No. D2000-0079 (April 14, 2000); *America Online Inc. v. Frank Albanese*, Case

No. D2000-1604 (January 25, 2001). See also *Trademarks Act*, R.S.C. 1985, c. T-13, s. 6.

⁶⁶ [Back](#) *Commonwealth Hotels Inc. v. CCD Internet*, Case No. AF-00771 (May 17, 2001).

⁶⁷ [Back](#) *Celine Dion v. Jeff Burgar*, Case No. D2000-1838 (February 13, 2001); *The Toronto-Dominion Bank v. Boris Kapachev*, Case No. D2000-1571 (January 15, 2001).

⁶⁸ [Back](#) *Experience Hendrix L.L.C. v. Denny Hammerton and The Jimi Hendrix Fan Club*, Case No. D2000-0364 (August 15, 2000); *VAT holding AG v. Vat.com*, Case No. D2000-0607 (August 22, 2000); *Northwest Airlines Inc. v. Kim Jong Sub*, Case No. FA01010000096377 (February 19, 2001); *Rollerblade Inc. v. Chris McGrady*, Case No. D2000-0429 (June 25, 2000); *Nintendo of America Inc. v. Alex Jones*, Case No. D2000-0998 (November 17, 2000); *AltaVista Co. v. Stonybrook Investments*, Case No. D2000-0886 (October 26, 2000); *Wal-Mart Stores Inc. v. Walsucks and Walmarket Puerto Rico*, Case No. D2000-0477 (July 20, 2000); *The Toronto-Dominion Bank v. Boris Kapachev*, Case No. D2000-1571 (January 15, 2001); *Ticketmaster Corp. v. Brown*, Case No. D2001-0716 (July 18, 2001). In contrast, see *Pueblo International Inc. v. Pueblo On-Line*, Case No. FA00070000095250, in which the panel held that the domain names *pueblo.org*, *pueblo.com*, and *pueblo.net* were not identical. Pueblo has been distinguished by at least one other panel: *North American Wilderness Recovery Inc. v. Citizens with Common Sense*, Case No. FA01040000097058 (July 1, 2001).

⁶⁹ [Back](#) *The Pep Boys Manny, Moe and Jack of California v. E-Commerce Today, Ltd.*, Case No. AF-0145 (May 3, 2000); *V Secret Catalogue, Inc. v. Artco, Inc.*, Case No. FA0094342 (May 9, 2000); *V Secret Catalogue, Inc. v. victoriassecret.org*, Case No. FA0094349 (May 14, 2000); *Hunton & Williams v. American Distribution Systems Inc.*, Case No. D2000-0501 (August 1, 2000); *Micron Electronics Inc. v. Frank Holden*, Case No. FA01030000096797 (April 4, 2001); *Blue Cross and Blue Shield Association and Trigon Insurance Company Inc. d/b/a Blue Cross Blue Shield v. InterActive Communications Inc.*, Case No. D2000-0788 (August 28, 2000); *Gruner + Jahr Printing and Publishing Co. v. Savior Baby*, Case No. D2000-1741 (February 21, 2001); *The Chancellor, Masters and Scholars of the University of Oxford v. DR Seagle t/a Mr. Oxford-University*, Case No. D2001-0746 (August 14, 2001); *Commonwealth Hotels Inc. v. CCD Internet*, Case No. AF-00771 (May 17, 2001).

⁷⁰ [Back](#) *Football Club des Girondins de Bordeaux v. Arr*, Case No. D2000-0149 (May 19, 2000); *General Machine Products Company Inc. v. Prime Domains*, Case No. NAF FA00010000092531 (January 26, 2000); *Packaging World Inc. v. Zynpak Packaging Products Inc.*, Case No. AF-0233 (July 28, 2000); *Commonwealth Hotels Inc. v. CCD Internet*, Case No. AF-00771 (May 17, 2001). See contra, *Cream Holdings Limited v. National Internet Source Inc.*, Case No. D2001-0964 (September 28, 2001).

⁷¹ [Back](#) *America Online Inc. v. John Deep Buddy U.S.A. Inc.*, Case No. FA01030000096795 (May 14, 2001); *General Electric Company v. Pars International Computer Inc.*, Case No. D2000-0368 (July 25, 2000); *Inter-IKEA Systems Inc. v. Technology Education Center*, Case No. D2000-0522 (August 7, 2000); *Ty Inc. v. Parvin*, Case No. D2000-0688 (November 9, 2000); *America Online Inc. v. Anson Chan*, Case No. D2001-0004 (February 22, 2001); *America Online Inc. v. Vadim Eremeev*, Case No. D2001-0003 (February 15, 2001); *Digital City v. Smalldomain*, Case No. D2000-1283 (November 6, 2000); *eBay Inc. v. G.L. Liadis Computing Ltd.*, Case No. D2000-1463 (January 10, 2001); *Bloomberg L.P. v. Electronic Media Services*, Case No. FA96438 (February 19, 2001); *America Online Inc. v. Frank Albanese*, Case No. D2000-1604 (January 25, 2001); *Wal-Mart Stores Inc. v. Walsucks and Walmarket Puerto Rico*, Case No. D2000-0477 (July 20, 2000); *CSA International v. Shannon*, Case No. D2000-0071 (March 24, 2000); *Minnesota Mining and Manufacturing Company v. Mark Overbey*, Case No. D2001-0727 (October 15, 2001); *Cellular One Group v. Applied Communications Inc.*, Case No. D20001-1520 (February 6, 2001); *Pacific Fence & Wire Co. v. Pacific Fence and Jim Paradise*, Case No. D2001-0237 (June 11, 2001); *The Nasdaq Stock Market Inc. v. Green Angel*, Case No. D2001-1010 (September 30, 2001); *America Online Inc. v. Miao-qua Wang*, Case No. D2001-0115 (March 4, 2001); *Union des Associations Européennes de*

Football (UEFA) v. Chris Hallam, Case No. D2001-0717 (July 10, 2001).

⁷² [Back](#) *Ticketmaster Corp. v. Brown*, Case No. D2001-0716 (July 18, 2001).

⁷³ [Back](#) *Dr. Ing. h.c.F. Porsche AG v. Macros-Telecom Corp.*, Case No. D2001-0993 (October 16, 2001).

⁷⁴ [Back](#) *Victoria's Secret v. Victoria's Cyber Secret*, Case No. FA0101000096536 (March 9, 2001).

⁷⁵ [Back](#) *Doctor Ing. h.c. F. Porsche AG v. Stonybrook Investments Limited*, Case No. D2001-1095 (October 26, 2001); *The Toronto-Dominion Bank v. Boris Kapachev*, Case No. D2000-1571 (January 15, 2001); *Gruner + Jahr Printing and Publishing Co. v. Savior Baby*, Case No. D2000-1741 (February 21, 2001); *Ingram Micro Inc. v. Noton Inc.*, Case No. D2001-0124 (March 6, 2001); *Anheuser-Busch Incorporated v. Fernand Dumas*, Case No. D2001-0651 (July 20, 2001).

⁷⁶ [Back](#) *National Westminster Bank PLC v. Purge I.T. Ltd.*, Case No. D2000-0636 (August 13, 2000); *Wal-Mart Stores Inc. v. Walsucks*, Case No. D2000-0477 (July 20, 2000); *Diageo PLC v. Zuccarini*, Case No. D2000-0996 (October 22, 2000); *Cabela's Inc. v. Cupcake Patrol*, Case No. FA95080 (August 29, 2000); *Direct Line Group Ltd. v. Purge I.T.*, Case No. D2000-0583 (August 13, 2000); *Dixons Group PLC v. Purge I.T.*, Case No. D2000-0584 (August 13, 2000); *Freeserve PLC v. Purge I.T.*, Case No. D2000-0585 (August 13, 2000); *Standard Chartered PLC v. Purge I.T.*, Case No. D2000-0681 (August 13, 2000); *Burlington Coat Factory Warehouse Corporation v. Smartsoft L.L.C.*, Case No. D2000-1792 (March 1, 2001); *Nicole Kidman v. John Zuccarini, d/b/a Cupcake Party*, Case No. D2000-1415 (January 23, 2001); *A & F Trademark Inc. v. Justin Jorgensen*, Case No. D2001-0900 (September 19, 2001).

⁷⁷ [Back](#) Case No. D2000-0662 (September 19, 2000).

⁷⁸ [Back](#) Case No. D2001-1121 (November 7, 2001).

⁷⁹ [Back](#) Case No. D2000-1015 (January 26, 2001).

⁸⁰ [Back](#) See also *Wal-Mart Stores Inc. v. wallmartcanadasucks.com*, Case No. D2000-1104 (November 23, 2000). Similarly, confusing similarity was not found where the word "lovers" was added to the complainant's trademark: *E.I. du Pont de Nemours and Company v. ITC*, Case No. FA0012000096219 (February 20, 2001).

⁸¹ [Back](#) Case No. D2001-0918 (September 14, 2001).

⁸² [Back](#) *CRS Technology Corporation v. Condenet Inc.*, Case No.

FA0002000093547 (March 28, 2000); *Commonwealth Hotels Inc. v. CCD Internet*, Case No. AF-00771 (May 17, 2001).

⁸³ [Back](#) *Emeril Lagasse v. VPOP Technologies*, Case No. FA0003000094373 (May 8, 2000); *Barney's Inc. v. BNY Bulletin Board*, Case No. D2000-0059 (February 16, 2000); *Drew Kaplan Agency v. DAK.Com*, Case No. FA0003000094328 (May 16, 2000); *Commonwealth Hotels Inc. v. CCD Internet*, Case No. AF-00771 (May 17, 2001).

- 84 [Back](#) *Madonna Ciccone p/k/a/ Madonna v. Parisi*, Case No. D2000-0847 (October 12, 2000) (trademark registered in Tunisia).
- 85 [Back](#) *Tribeca Film Center Inc. v. Lorenzo Brusasco-Mackenzie*, Case No. D2000-1772 (April 10, 2001).
- 86 [Back](#) *Compagnie de Saint Gobain v. Com-Union corp.* Case No. D2000-0020 (February 4, 2000).
- 87 [Back](#) *Ziegenfelder Co. v. VMH Enterprises Inc.*, Case No. D2000-0039 (March 14, 2000).
- 88 [Back](#) *Radio Globo S.A. v. Diogo Pimentel*, Case No. D2000-1705 (January 31, 2001).
- 89 [Back](#) *Packaging World Inc. v. Zynpak Packaging Products Inc.*, Case No. AF-0233 (July 28, 2000); *Slep-Tone Entertainment Corporation v. Sound Choice Disc Jockeys Inc.*, Case No. FA20002000093636 (March 13, 2000); *Quixtar Investments Inc. v. Dennis Hoffman*, Case No. D2000-0253 (April 20, 2000); *Motorola Inc. v. Newgate Internet Inc.*, Case No. D2000-0079 (April 14, 2000); *America Online Inc. v. John Deep Buddy U.S.A. Inc.*, Case No. FA01030000096795 (May 14, 2001); *America Online, Inc. v. Xianfeng Fu*, Case No. D2000-1374 (December 11, 2000).
- 90 [Back](#) *Corinthians Licenciamentos LTDA v. Sallen*, Case No. D2000-0461 (July 17, 2000); *e-Duction Inc. v. Zuccarini*, Case No. D2000-1369 (February 5, 2001); *Vivendi Universal v. Jay David Sallen*, Case No. D2001-1121 (November 7, 2001).
- 91 [Back](#) *Zero International Holding GmbH & Co. v. Beyonet Services*, Case No. D2000-0161 (March 28, 2000); *Lifeplan v. Life Plan*, Case No. FA0000500094826 (July 13, 2000).
- 92 [Back](#) *Société des Produits Nestlé SA v. Pro Fiducia Treuhand AG*, Case No. D2001-0916 (October 12, 2001); *G.A. Modefine S.A. v. A.R. Mani*, Case No. D2001-0537 (July 20, 2001).
- 93 [Back](#) *Sankyo Co. Ltd. v. Zhu Jiajun*, Case No. D2000-1791 (March 23, 2001).
- 94 [Back](#) *Mario Lemieux v. Creato*, Case No. AF-0791 (May 24, 2001).
- 95 [Back](#) *Aspen Grove Inc. v. Aspen Grove*, Case No. D2001-0798 (October 5, 2001).
- 96 [Back](#) *National Football League Properties Inc. v. One Sex Entertainment Co.*, Case No. D2000-0118; *The Hamlet Group Inc. v. Lansford*, Case No. D2000-0073; *Packaging World Inc. v. Zynpak Packaging Products Inc.*, Case No. AF-0233 (July 28, 2000); *AltaVista Co. v. Stonybrook Investments*, Case No. D2000-0886 (October 26, 2000); *Two Systems Enterprises Co. Ltd. v. Sonie's Creations*, Case No. AF-0911 (September 7, 2001); *Pacific Fence & Wire Co. v. Pacific Fence and Jim Paradise*, Case No. D2001-0237 (June 11, 2001); *The Nasdaq Stock Market Inc. v. Green Angel*, Case No. D2001-1010 (September 30, 2001); *American Eyewear Inc. v. Thralow Inc.*, Case No. D2001-0991 (October 24, 2001); *A & F Trademark Inc. v. Justin Jorgensen*, Case No. D2001-0900 (September 19, 2001).
- 97 [Back](#) *Madonna Ciccone p/k/a/ Madonna v. Dan Parisi*, Case No. D2000-0847 (October 12, 2000); *The Nasdaq Stock Market Inc. v. Green Angel*, Case No. D2001-1010 (September 30, 2001); *Packaging World Inc. v. Zynpak Packaging Products Inc.*, Case No. AF-0233 (July 28, 2000); *Slep-Tone Entertainment Corporation v. Sound Choice Disc Jockeys Inc.*, Case No. FA20002000093636 (March 13, 2000); *Quixtar Investments Inc. v. Dennis Hoffman*, Case No. D2000-0253 (April 20,

2000); *Motorola Inc. v. Newgate Internet Inc.*, Case No. D2000-0079 (April 14, 2000); *America Online Inc. v. John Deep Buddy U.S.A. Inc.*, Case No. FA01030000096795 (May 14, 2001); *Two Systems Enterprises Co. Ltd. v. Sonie's Creations*, Case No. AF-0911 (September 7, 2001); *Pacific Fence & Wire Co. v. Pacific Fence and Jim Paradise*, Case No. D2001-0237 (June 11, 2001).

⁹⁸ [Back](#) *Nik Carter v. The Afternoon Fiasco*, Case No. D2000-0658 (October 17, 2000); *Quirk Works Inc. v. Maccini*, Case No. FA0006000094963 (July 13, 2000); *CSA International v. Shannon*, Case No. D2000-0071 (March 24, 2000); *DFO Inc. v. Williams*, Case No. D2000-0181 (May 14, 2000); *Louis Vuitton Malletier v. Villa*, Case No. D2000-0721 (October 13, 2000); *David Gilmore v. Cenicolla*, Case No. D2000-1459 (December 15, 2000); *E. & H. Gallo Winery v. Hanna Law Firm*, Case No. D2000-0615; *Reg Vardy Plc v. David Wilkinson*, Case No. D2001-0593 (July 3, 2001).

⁹⁹ [Back](#) Case No. D2000-0299 (June 9, 2000). See also *Monty and Pat Roberts Inc. v. Bartell*, Case No. D2000-0300 (June 13, 2000).

¹⁰⁰ [Back](#) See also *Chicago-Tribune Company v. Varkey*, Case No. D2000-0133 (May 9, 2000); *Gruner + Jahr Printing and Publishing Co. v. Savior Baby*, Case No. D2000-1741 (February 21, 2001); *Ourisman Dodge Inc. v. Ourisman "Okie Doke" Dodge Dot Com*, Case No. D2001-0108 (March 22, 2001); *The Toronto-Dominion Bank v. Boris Kapachev*, Case No. D2000-1571 (January 15, 2001); *New York Times Company v. New York Times Internet Services*, Case No. D2000-1072 (December 5, 2000); *Vivendi Universal v. Jay David Sallen*, Case No. D2001-1121 (November 7, 2001).

¹⁰¹ [Back](#) Case No. D2000-0020 (March 14, 2000).

¹⁰² [Back](#) Case No. D2000-0998 (November 17, 2000).

¹⁰³ [Back](#) *Quirk Works Inc. v. Maccini*, Case No. FA0006000094964 (July 11, 2000); *Ahmanson Land Company v. Save Open Space*, Case No. D2000-0858 (December 4, 2000); *Ahmanson Land Company v. Vince Curtis*, Case No. D2000-0859 (December 4, 2000); *Edward Van Halen v. Morgan*, Case No. D2000-1313 (December 20, 2000); *The Estate of Tupak Shakur v. Barranco*, Case No. AF-0384 (October 23, 2000); *Bloomberg L.P. v. Secaucus Group*, Case No. FA0104000097077 (June 3, 2001); *Union des Associations Européennes de Football (UEFA) v. Chris Hallam*, Case No. D2001-0717 (July 10, 2001).

¹⁰⁴ [Back](#) Case No. D2000-0109 (July 6, 2000).

¹⁰⁵ [Back](#) A legitimate interest in the use of a domain name for critical purposes may be even more readily recognized where the target is a governmental entity: *Dorset Police v. Coulter*, Case No. AF-0924(a-b) (October 20, 2001).

¹⁰⁶ [Back](#) Case No. D2000-0673 (September 27, 2000).

¹⁰⁷ [Back](#) See also *Springsteen v. Burgar*, Case No. D2000-1532 (January 25, 2001).

¹⁰⁸ [Back](#) Case No. D2001-0900 (September 19, 2001).

¹⁰⁹ [Back](#) Case No. D2000-0022 (May 29, 2000).

¹¹⁰ [Back](#) "A domain name is more than a mere internet address. It also identifies the internet site to

those who reach it, much like a person's name identifies a particular person, or, more relevant to trademark disputes, a company's name identifies a specific company.": *Cardservice International Inc. v. Webster R. McGee*, 950 F.Supp. 737 (E.D. Va. 1997); aff'd 129 F.3d 1258 (4th Cir. 1997). See also *Green Products Co. v. Independence Corn By-Products Co.*, 992 F.Supp. 1070 (N.D. Iowa 1995); *Brookfield Communications Inc. v. West Coast Entertainment Corp.*, 174 F.3d 1036 (9th Cir. 1999); *British Telecommunications plc v. One In A Million Ltd.*, [1997] E.W.J. No. 1599 (H.C.), aff'd, [1998] 4 All E.R. 476 (C.A.); *TCPIP Holding Company Inc. v. Haar Communications Inc.* 244 F. 3d 88 (2nd Cir. 2001); and *Ford Motor Company v. Ford Financial Solutions Inc.* 103 F. Supp. 2d 1126 (N.D. Iowa 2000). As the Court noted in *PACCAR Inc. v. Telescan Technologies L.L.C.*, 2000 U.S. Dist. LEXIS 12857 (E.D.Mich. 2000), Words in domain names, however, do communicate information as to the nature of the entity sponsoring the web site. ... Using the name Peterbilt or Kenworth in a domain name sends a message to Internet users that the Web site is associated with, or sponsored by the company owning the trademarks Peterbilt and Kenworth. See also *New York Times Company v. New York Times Internet Services*, Case No. D2000-1072 (December 5, 2000); *E. & H. Gallo Winery v. Hanna Law Firm*, Case No. D2000-0615; *DaimlerChrysler Corporation v. Bargman* Case No. D2000-0022 (May 29, 2000); *Two Systems Enterprises Co. Ltd. v. Sonie's Creations*, Case No. AF-0911 (September 7, 2001).

¹¹¹ [Back](#) *Springsteen v. Bugar*, Case No. D2000-1532 (January 25, 2001). Other panels have expressly disagreed with the reasoning of the majority in *Springsteen* on this point: see, for example, *Starkey v. LOVEARTH.net*, Case No. FA0104000097089 (June 4, 2001).

¹¹² [Back](#) *Cream Holdings Limited v. National Internet Source Inc.*, Case No. D2001-0964 (September 28, 2001); *Newstoday Printers and Publishers (P) Ltd. v. InetU Inc.*, Case No. D2001-0085 (May 23, 2001); *Audiopoint Inc. v. eCorp.*, Case No. D2001-0509 (June 14, 2001); *Allocation Network GmbH v. Gregory*, Case No. D2000-0016 (March 24, 2000).

¹¹³ [Back](#) *Libro AG v. NA Global Link Limited*, Case No. D 2000-0186 (May 16, 2000); *VZ VermogensZentrum AG v. Anything.com*, Case No. D2000-0527 (August 22, 2000); *Commonwealth Hotels Inc. v. CCD Internet*, Case No. AF-00771 (May 17, 2001).

¹¹⁴ [Back](#) *e-Duction Inc. v. Zuccarini*, Case No. D2000-1369 (February 5, 2001); *World Wrestling Entertainment v. Michael Bosman*, Case No. D99-0001 (January 14, 2000); *Sporoptic Pouilloux S.A. v. William H. Wilson*, Case No. D2000-0265 (June 16, 2000); *Audiopoint Inc. v. eCorp.*, Case No. D2001-0509 (June 14, 2001); *A Prompt Corporation v. Aprompt Computers Inc.*, Case No. AF-00816 (June 18, 2001); *A & F Trademark Inc. v. Justin Jorgensen*, Case No. D2001-0900 (September 19, 2001).

¹¹⁵ [Back](#) Under this illustrative example of bad faith, an intent to sell the domain name for profit must be the primary purpose for obtaining the domain name. See *Ticketmaster Corp. v. Brown*, Case No. D2001-0716 (July 18, 2001).

¹¹⁶ [Back](#) *General Media Communications Inc. v. Vine Ent.*, Case No. FA0101000096554 (March 26, 2001).

¹¹⁷ [Back](#) *Packaging World Inc. v. Zynpak Packaging Products Inc.*, Case No. AF-0233 (July 28, 2000); *Mission KwaSizabantu v. Post*, Case No. D2000-0279; *NetGrocer Inc. v. Tahiliani*, Case No. FA0002000093768; *SGS Société Générale de Surveillance S.A. v. Inspectorate*, Case No. D2000-0025

¹¹⁸ [Back](#) *Packaging World Inc. v. Zynpak Packaging Products Inc.*, Case No. AF-0233 (July 28, 2000); *Monty and Pat Roberts Inc. v. Keith*, Case No. D2000-0299 (June 9, 2000).

¹¹⁹ [Back](#) *Telstra Corporation Limited v. Nuclear Marshmallows*, Case No. D2000-003 (February 18, 2000); *The Chancellor, Masters and Scholars of the University of Oxford v. DR Seagle t/a Mr. Oxford-University*, Case No. D2001-0746 (August 14, 2001); *The Bruce Trail Association v. Andrew Camp and Bruce Trail Employees*, Case No. D2001-1021 (October 12, 2001); *A & F Trademark Inc. v. Justin Jorgensen*, Case No. D2001-0900 (September 19, 2001); *Vivendi Universal v. Jay David Sallen*, Case No. D2001-1121 (November 7, 2001).

¹²⁰ [Back](#) *Wal-Mart Stores Inc. v. walmartcanadasucks.com*, Case No. D2000-1104 (November 23, 2000).

¹²¹ [Back](#) *Tourism and Corporate Automation Ltd. v. TSI Ltd.*, Case No. AF-0096 (March 16, 2000); *Educational Testing Service v. Netkorea Co.*, Case No. D2000-0087; *Telstra Corporation Limited v. Nuclear Marshmallows*, Case No. D2000-003 (February 18, 2000); *Bloomberg L.P. v. David Cohen*, Case No. FA01020000096600 (February 19, 2001); *New York Times Company v. New York Times Internet Services*, Case No. D2000-1072 (December 5, 2000); *Two Systems Enterprises Co. Ltd. v. Sonie's Creations*, Case No. AF-0911 (September 7, 2001).

¹²² [Back](#) *Madonna Ciccone p/k/a/ Madonna v. Parisi*, Case No. D2000-0847 (October 12, 2000) (trademark registered in Tunisia); *Plaza Operating Partners Ltd. v. Pop Data Technologies Inc. v. Pillus*, Case No. D2000-0166 (June 1, 2000).

¹²³ [Back](#) *Educational Testing Service v. TOEFL*, Case No. D2000-0044 (March 16, 2000); *America Online Inc. v. QTR Corporation*, Case No. FA0001000092016 (February 10, 2000).

¹²⁴ [Back](#) *Ingersoll-Rand Co. v. Frank Gully (d.b.a. Advcomren)*, Case No. D2000-0021 (March 9, 2000).

¹²⁵ [Back](#) In *Telstra Corporation Limited v. Nuclear Marshmallows*, Case No. D2000-003 (February 18, 2000), the administrative panel held that the registrant's passive holding of the domain name constituted bad faith use because: (a) the complainant's trademark was strong and widely known; (b) the registrant provided no evidence of actual or contemplated good faith use of the domain name; (c) the registrant actively concealed its true identity; (d) the registrant provided false contact details in breach of its registration agreement; and (e) any plausible active use of the domain name by the registrant would be illegitimate, i.e. a trademark infringement or passing-off. See also *Ingersoll-Rand Co. v. Frank Gully (d.b.a. Advcomren)*, Case No. D2000-0021 (March 9, 2000).; *Educational Testing Service v. TOEFL*, Case No. D2000-0044 (March 16, 2000).; *Telstra Corporation Limited v. Nuclear Marshmallows*, Case No. D2000-003 (February 18, 2000).; *Mary-Lynn Mondich and others v. Shane Brown*, Case No. D2000-0004 (February 16, 2000); *Leland Stanford Junior University v. Zedlar Transcription & Translation*, Case No. FA0006000094970 (July 11, 2000); *Automatic Data Processing Inc. v. Access Electronics*, Case No. FA0101000096483 (February 20, 2001).; *Minnesota Monthly Publications Inc. v. Key Enterprises, d.b.a. MSP Communications*, Case No. FA0101000096381 (February 14, 2001); *The State-Record Co. v. Godpilot*, Case No. FA0102000096686 (April 4, 2001); *Cruzeiro Licenciamentos Ltda v. Sallen & Sallen Enterprises*, Case No. D2000-0715 (September 6, 2000); *Grundfos A/S v. Lokale*, Case No. D2000-1347 (November 27, 2000); *Pennsylvania State University v. Joel Gehman*, Case No. FA01030000964842 (April 2, 2001); *Victoria's Secret at al. v. Sherry Hardin*, Case No. FA0102000096694 (March 31, 2001); *Minnesota State Lottery v. Bryan Mendes*, Case No. FA0102000096701 (April 2, 2001); *Mario Lemieux v. C reato*, Case No. AF-0791 (May 24, 2001).; *The Estate of Tupac Shakur v. Andronian*, Case No. AF0349 (October 3, 2000); *Cho Yong Pil v. Dooseok*, Case No. D2000-0754 (August 28, 2000); *CMG Worldwide Inc. v. Page*, Case No. FA0009000095641 (November 8, 2000); *Cho Yong Pil v. Dooseok*, Case No. D2000-0754 (August 28, 2000); *Isabelle Adjani v. Second Orbit Communications Inc.*, Case No. D2000-0867 (October 4, 2000); *Nintendo of America Inc. v. Holland*, Case No. D2000-1483, (January 11, 2001); *Credit Suisse Group v. Milanes-Espinach, Fernando and Milanes-Espinach, SA*, Case No. D2000-1376 (March 20, 2001); *Do The Hustle, LLC v. Tropica Web*, Case No. D2000-0624 (August 21, 2000); *Ticketmaster Corp. v. Brown*, Case No. D2001-0716 (July

18, 2001); *Elmore "Rip" Torn v. Riptorn.com*, Case No. D2001-0850 (October 9, 2001); *Vivendi Universal v. Jay David Sallen*, Case No. D2001-1121 (November 7, 2001).

¹²⁶ [Back](#) *Slep-Tone Entertainment Corporation v. Sound Choice Disc Jockeys Inc.*, Case No. FA20002000093636 (March 13, 2000); *August Storck KG v. Tony Mohamed*, Case No. D2000-0196 (May 3, 2000). In some cases, the registrant has been fixed with constructive knowledge of the complainant's trademark, particularly where the trademark is famous or was registered prior to the registrant's registration of the domain name: *Cellular One Group v. Brien*, Case No. D2000-0028 (February 8, 2000); *Finter Bank Zurich v. Gianluca Olivier*, Case No. D2000-0091 (February 28, 2000); *J. Crew International Inc. v. crew.com*, Case No. D2000-0054 (February 16, 2000); *Victoria's Secret v. Brown*, Case No. FA0101000096561 (March 19, 2001).

¹²⁷ [Back](#) *Toronto Star Newspapers Limited v. Virtual Dates Inc.*, Case No. D2000-1612 (February 6, 2001); *Toronto Star Newspapers Limited v. Elad Cohen*, Case No. D2000-0006 (January 22, 2001); *Allocation Network GmbH v. Gregory*, Case No. D2000-0016 (March 24, 2000); *Commonwealth Hotels Inc. v. CCD Internet*, Case No. AF-00771 (May 17, 2001).

¹²⁸ [Back](#) *Sony Corporation v. Times Vision Ltd.*, Case No. FA0009000095686 (March 9, 2001); *Sydney Opera House Trust v. Trilynx Pty. Ltd.*, Case No. D2000-1224 (October 31, 2000).

¹²⁹ [Back](#) *Serena Williams and Venus Williams v. Eileen White Byrne and Allgolfconsultancy*, Case No. D2000-1673 (January 30, 2001).

¹³⁰ [Back](#) *General Electric Company v. Fisher Zvieli*, Case No. D2000-0377 (July 15, 2000); *Ingram Micro Inc. v. Noton Inc.*, Case No. D2001-0124 (March 6, 2001); *Playboy Enterprises International Inc. v. SAND WebNames - For Sale*, Case No. D2001-0094 (April 3, 2001); *Pig Improvement Company, Inc. v. Platinum Net, Inc.*, Case No. D2000-1594 (January 19, 2001); *News Group Newspapers Limited v. Momm Amed*, Case No. D2000-1623 (January 18, 2001); *Microsoft Corp. v. Global Net 2000, Inc.*, Case No. D2000-0554 (July 25, 2000); *Reuters Limited v. Global Net 2000, Inc.*, Case No. D2000-0441 (July 13, 2000); *Accu Weather, Inc. v. Global Net 2000, Inc.*, Case No. FA0004000094645 (June 1, 2000); *Yahoo! Inc. and GeoCities v. Data Art Corp., DataArt Enterprises, Inc., Stonybrook Investments, Global Net 2000, Inc., Powerclick, Inc. and Yahoo Search, Inc.*, Case No. D2000-0587 (August 10, 2000); *Dow Jones & Company Inc. v. Zuccarini*, Case No. D2000-0578 (August 28, 2000); *Doctor.Ing.h.c. F. Porsche AG v. Stonybrook Investments Limited*, Case No. D2001-1095 (October 26, 2001); *Telstra Corporation Ltd v. Warren Bolton Consulting Pty Ltd.*, D2000-1293 (November 21, 2000); *The Toronto-Dominion Bank v. Boris Kapachev*, Case No. D2000-1571 (January 15, 2001); *Anheuser-Busch Incorporated v. Fernand Dumas*, Case No. D2001-0651 (July 20, 2001); *AltaVista Co. v. Stonybrook Investments*, Case No. D2000-0886 (October 26, 2000); *Dow Jones & Co. v. Dow Jones L.P.*, Case No. D2000-1259 (December 1, 2000); *Bloomberg L.P. v. Baltic Consultants Ltd.*, Case No. FA0010000095834 (November 20, 2000); and *Nicole Kidman v. John Zuccarini, d/b/a Cupcake Party*, Case No. D2000-1415 (January 23, 2001).

¹³¹ [Back](#) *Heel Quik! Inc. v. Goldman*, Case No. AF-92527 (March 1, 2000).

¹³² [Back](#) *Morrison & Foerster L.L.P. v. Brian Wick and American Distributions System Inc.*, Case No. FA0003000094301 (April 17, 2000); *N.C.P. Marketing Group v. Entredomains*, Case No. D2000-0387 (July 5, 2000); *Onu S.R.L. v. Online Sales*, Case No. AF-0672 (February 16, 2001); *Aspen Grove Inc. v. Aspen Grove*, Case No. D2001-0798 (October 5, 2001).

¹³³ [Back](#) *Drew Kaplan Agency v. DAK.Com*, Case No. FA0003000094328 (May 16, 2000).

¹³⁴ [Back](#) *Minnesota Mining and Manufacturing Company v. Mark Overbey*, Case No. D2001-0727 (October 15, 2001).

- 135 [Back](#) *Packaging World Inc. v. Zynpak Packaging Products Inc.*, Case No. AF-0233 (July 28, 2000); *Ingersoll-Rand Co. v. Frank Gully (d.b.a. Advcomren)*, Case No. D2000-0021 (March 9, 2000).
- 136 [Back](#) *Teleplace Inc. v. Eileen De Oliveira*, Case No. FA0010000095835 (December 4, 2000).
- 137 [Back](#) *Zero International Holding GmbH & Co. v. Beyonet Services*, Case No. D2000-0161 (March 28, 2000); *Lifepan v. Life Plan*, Case No. FA0000500094826 (July 13, 2000); *Dorset Police v. Coulter*, Case No. AF-0924(a-b) (October 20, 2001); *Cream Holdings Limited v. National Internet Source Inc.*, Case No. D2001-0964 (September 28, 2001).
- 138 [Back](#) *Workplace Safety and Insurance Board v. Kleiman*, Case No. FA0102000096611 (March 13, 2001); *N.C.P. Marketing Group Inc. v. Entredomains*, Case No. D2000-0387; *Robert Ellenbogen v. Mike Pearson*, Case No. D2000-0001; *Harrod's Limited v. Boyd*, Case No. D2000-0060 (March 16, 2000); *Unibanco - Uniao de Bancos Brasileiros S.A. v. Vendo Domain Sale*, Case No. D2000-0671; *American Golf Corporation v. The Perfect Web Corporation*, Case No. D2000-0908.
- 139 [Back](#) *Deutsche Welle v. DiamondWare Limited*, Case No. D2000-1202 (January 2, 2001); *Creo Products Inc. v. Website In Development*, Case No. D2000-1490 (January 19, 2001); *Do The Hustler LLC v. Monkey Media LLC*, Case No. D2000-0625 (September 5, 2000); *Aspen Grove Inc. v. Aspen Grove*, Case No. D2001-0798 (October 5, 2001); *G.A. Modefine S.A. v. A.R. Mani*, Case No. D2001-0537 (July 20, 2001).
- 140 [Back](#) *Microcell Solutions Inc. v. B-Seen Design Group Inc.*, Case No. AF-0131 (May 2, 2000). In *Sud-Chemie AG v. tonsil.com*, Case No. D2000-0376, the panel held that a registrant's failure to respond to the complainant's offer to purchase a domain name indicated the registrant's bad faith intent to sell the domain name for more than out-of-pocket costs. See also *Minnesota Mining and Manufacturing Company v. Mark Overbey*, Case No. D2001-0727 (October 15, 2001).
- 141 [Back](#) *Exario Network Inc. v. The Domain Name You Have Entered is for Sale*, Case No. AF-0536 (December 11, 2000); *IPF Online Ltd. v. John Hitfield*, Case No. AF-0291 (November 13, 2000).
- 142 [Back](#) *Springsteen v. Burgar*, Case No. D2000-1532 (January 25, 2001).
- 143 [Back](#) *Julie Brown v. Julie Brown Club*, Case No. D2000-1628 (February 13, 2001).
- 144 [Back](#) *Celine Dion v. Jeff Burgar*, Case No. D2000-1838 (February 13, 2001).
- 145 [Back](#) *Libro AG v. NA Global Link Limited*, Case No. D 2000-0186 (May 16, 2000); *VZ VermogensZentrum AG v. Anything.com*, Case No. D2000-0527 (August 22, 2000); *Toronto Star Newspapers Limited v. Virtual Dates Inc.*, Case No. D2000-1612 (February 6, 2001); *Radio Globo SA v. Diogo Pimentel*, Case No. D2000-1705 (January 31, 2001); *Microcell Solutions Inc. v. B-Seen Design Group Inc.*, Case No. AF-0131 (May 2, 2000); *General Machine Products Company Inc. v. Prime Domains (a/k/a/ Telepathy Inc.)*; Case No. FA0001000092531; *Commonwealth Hotels Inc. v. CCD Internet*, Case No. AF-00771 (May 17, 2001).
- 146 [Back](#) *J. Crew International Inc. v. crew.com*, Case No. D2000-0054 (February 16, 2000); *Electronic Commerce Media Inc. v. Taos Mountain*, Case No. FA0008000095344 (October 11, 2000); *Sony Corporation v. Times Vision Ltd.*, Case No. FA0009000095686 (March 9, 2001).

147 [Back](#) *Bridgestone Firestone Inc. v. Meyers*, Case No. D2000-0109 (July 6, 2000); *Jules I. Kendall v. Mayer*, Case No. D2000-0868 (October 26, 2000); *Ahmanson Land Company v. Save Open Space*, Case No. D2000-0858 (December 4, 2000); *Ahmanson Land Company v. Vince Curtis*, Case No. D2000-0859 (December 4, 2000).

148 [Back](#) *CSA International v. Shannon*, Case No. D2000-0071 (March 24, 2000); *DFO Inc. v. Williams*, Case No. D2000-0181 (May 14, 2000); *Reg Vardy Plc v. David Wilkinson*, Case No. D2001-0593 (July 3, 2001); *Home Properties v. SMS Online*, Case No. FA0009000095639 (November 2, 2000).

149 [Back](#) *Hero Honda Motors Limited v. Tella*, Case No. D2000-0365 (July 16, 2000); *Nintendo of America Inc. v. Alex Jones*, Case No. D2000-0998 (November 17, 2000); *The Estate of Tupak Shakur v. Barranco*, Case No. AF-0384 (October 23, 2000); *Edward Van Halen v. Morgan*, Case No. D2000-1313 (December 20, 2000). See contra, *Union des Associations Européennes de Football (UEFA) v. Chris Hallam*, Case No. D2001-0717 (July 10, 2001).

150 [Back](#) *NetLearning Inc. v. Parisi*, Case No. FA0008000095471 (October 16, 2000); *Artnews L.L.C. v. Ecorp.com*, Case No. FA95231 (August 22, 2000); *Spirit Airlines Inc. v. Spirit Airlines Pty. Ltd.*, Case No. D2001-0748 (July 25, 2001).

151 [Back](#) *Mission KwaSizabantu v. Rost*, Case No. D2000-0279 (June 7, 2000); *The Toronto-Dominion Bank v. Boris Kapachev*, Case No. D2000-1571 (January 15, 2001).

152 [Back](#) *Tribeca Film Center Inc. v. Lorenzo Brusasco-Mackenzie*, Case No. D2000-1772 (April 10, 2001); *Compusa Management Co. v. Customized Computer Training*, Case No. FA0006000095082 (August 27, 2000). See also *Minnesota Mining and Manufacturing Company v. Mark Overbey*, Case No. D2001-0727 (October 15, 2001).

153 [Back](#) *Radio Globo SA v. Diogo Pimentel*, Case No. D2000-1705 (January 31, 2001); *Two Systems Enterprises Co. Ltd. v. Sonie's Creations*, Case No. AF-0911 (September 7, 2001); *Link Clicks Inc. v. John Zuccarini*, Case No. D2000-1547 (January 12, 2001).

154 [Back](#) *Radio Globo SA v. Diogo Pimentel*, Case No. D2000-1705 (January 31, 2001).

155 [Back](#) *Sumner p/k/a Sting v. Urvan*, Case No. D2000-0596 (July 20, 2000); *Do The Hustle, LLC v. Tropica Web*, Case No. D2000-0624 (August 21, 2000); *Aspen Grove Inc. v. Aspen Grove*, Case No. D2001-0798 (October 5, 2001).

156 [Back](#) *Radio Globo S.A. v. Diogo Pimentel*, Case No. D2000-1705 (January 31, 2001).

157 [Back](#) *Packaging World Inc. v. Zynpak Packaging Products Inc.*, Case No. AF-0233 (July 28, 2000); *Educational Testing Service v. TOEFL*, Case No. D2000-0044 (March 16, 2000); *Grove Broadcasting Co. Ltd. v. Telesystems Communications Limited*, Case No. D2000-0158 (May 9, 2000); *Nicole Kidman v. John Zuccarini, d/b/a Cupcake Party*, Case No. D2000-1415 (January 23, 2001); *Commonwealth Hotels Inc. v. CCD Internet*, Case No. AF-00771 (May 17, 2001).

158 [Back](#) *Nicole Kidman v. John Zuccarini, d/b/a Cupcake Party*, Case No. D2000-1415 (January 23, 2001); *Inter-Continental Hotels Corporation v. Khaled Ali Soussi*, Case No. D2000-0252 (July 5, 2000); *Electronic Commerce Media Inc. v. Taos Mountain*, Case No. FA0008000095344 (October 11, 2000); *Universal City Studios Inc. v. G.A.B. Enterprises*, Case No. D2000-0416 (June 29, 2000); *Springsteen v. Burgar*, Case No. D2000-1532 (January 25, 2001); *Credit Suisse Group v. Milanes-*

Espinach, Fernando and Milanese-Espinach, SA, Case No. D2000-1376 (March 20, 2001); See also *Ingram Micro Inc. v. Noton Inc.*, Case No. D2001-0124 (March 6, 2001); *Do The Hustle, LLC v. Tropical Web*, Case No. D2000-0624 (August 21, 2000).

¹⁵⁹ [Back](#) *Cigna Corporation v. JIT Consulting*, Case No. AF-00174 (June 6, 2000).

¹⁶⁰ [Back](#) *Radio Globo SA v. Diogo Pimentel*, Case No. D2000-1705 (Jan. 31, 2001).

¹⁶¹ [Back](#) *Packaging World Inc. v. Zynpak Packaging Products Inc.*, Case No. AF-0233 (July 28, 2000); *Cortefiel S.A. v. Quintas*, Case No. D2000-0140; *Shore Media Ventures Inc. v. Both Worlds Inc.*, Case No. AF-0228; *Softquad Software Inc. v. Eleven-Eleven Ltd.*, Case No. AF-0143; *The Estate of Tupac Shakur v. Andronian*, Case No. AF0349 (October 3, 2000); *Cho Yong Pil v. Dooseok*, Case No. D2000-0754 (August 28, 2000); *Rickey Skaggs v. Vincente*, Case No. D2000-1134 (December 18, 2000); *Ingram Micro Inc. v. Noton Inc.*, Case No. D2001-0124 (March, 2001); *Link Clicks Inc. v. John Zuccarini*, Case No. D2000-1547 (January 12, 2001).

¹⁶² [Back](#) *Packaging World Inc. v. Zynpak Packaging Products Inc.*, Case No. AF-0233 (July 28, 2000); *MatchNet plc v. MAC Trading*, Case No. D2000-0205; *SeekAmerica Networks Inc. v. Masood*, Case No. D2000-0131; *The Pep Boys Manny, Moe and Jack of California v. E-Commerce Today, Ltd.*, Case No. AF-0145 (May 3, 2000); *Bloomberg L.P. v. Baltic Consultants Ltd.*, Case No. FA0010000095834 (November 20, 2000); *Isabelle Adjani v. Second Orbit Communications Inc.*, Case No. D2000-0867 (October 4, 2000); *Sony Corporation v. Inja*, Case No. D2000-1409 (December 9, 2000); *Doctor.Ing.h.c. F. Porsche AG v. Stonybrook Investments Limited*, Case No. D2001-1095 (October 26, 2001); *Credit Suisse Group v. Milanese-Espinach, Fernando and Milanese-Espinach, SA*, Case No. D2000-1376 (March 20, 2001); *Ingram Micro Inc. v. Noton Inc.*, Case No. D2001-0124 (March 6, 2001); *American Online Inc. v. Johuathan Investments Inc.*, Case No. D2001-0918 (September 14, 2001); *Ticketmaster Corp. v. Brown*, Case No. D2001-0716 (July 18, 2001).

¹⁶³ [Back](#) *Zero International Holding GmbH & Co. v. Beyonet Services*, Case No. D2000-0161 (March 28, 2000); *CRS Technology Corporation v. Condenet Inc.*, Case No. FA0002000093547 (March 28, 2000); *LifePlan v. LifePlan*, Case No. FA0005000094826 (July 13, 2000); *Motorola Inc. v. Newgate Internet Inc.*, Case No. D2000-0079 (April 14, 2000), dissenting panelist.

¹⁶⁴ [Back](#) *Film Council v. Boolean Consulting Limited*, Case No. AF-0503 (November 27, 2000).

¹⁶⁵ [Back](#) *Loblaws Inc. v. Guita Azimi*, Case No. AF-0170 (June 7, 2000).

¹⁶⁶ [Back](#) *Shirmax Retail Ltd. v. CES Marketing Group Inc.*, Case No. AF-0104 (March 20, 2000); *Breakthrough Software Inc. v. Hendrick Huigen*, Case No. AF-0122 (April 13, 2000); *Interep National Radio Sales Inc. v. Internet Domain Names Inc.*, Case No. D2000-0174 (May 26, 2000); *Loblaws Inc. v. Presidentchoice.Inc./Presidentchoice.com*, Case No. AF-0170 (June 7, 2000); *Deutsche Welle v. DiamondWare Limited*, Case No. D2000-1202 (January 2, 2001).

¹⁶⁷ [Back](#) *Goldline International Inc. v. Gold Line*, Case No. D2000-1151 (January 4, 2001); *Qtrade Canada Inc. v. Bank of Hydro*, Case No. AF-0169 (June 19, 2000); *Passion Group Inc. v. Usearch Inc.*, Case No. AF-0250 (August 10, 2000); *Aspen Grove Inc. v. Aspen Grove*, Case No. D2001-0798 (October 5, 2001); *Cream Holdings Limited v. National Internet Source Inc.*, Case No. D2001-0964 (September 28, 2001). In *Rogers Cable Inc. v. Arran Lai*, Case No. D2001-0201 (March 30, 2001), the panel, although apparently not asked to make a finding that the claim was brought in bad faith, commented that "attempting to characterize the Respondent as a cybersquatter, and the making of unsubstantiated allegations in order to attract the operation of the *Policy*, is an entirely inappropriate solution, and the panel would wish to dissuade other potential complainants from seeking to utilise the *Policy* to resolve disputes for which it is entirely ill-equipped or intended".

¹⁶⁸ [Back](#) *Société des Produits Nestlé SA v. Pro Fiducia Treuhand AG*, Case No. D2001-0916 (October 12, 2001); *G.A. Modefine S.A. v. A.R. Mani*, Case No. D2001-0537 (July 20, 2001).

¹⁶⁹ [Back](#) *Grove Broadcasting Co. Ltd. v. Telesystems Communications Ltd.*, Case No. D2000-0703 (November 10, 2000); *Creo Products Inc. v. Website In Development*, Case No. D2000-1490 (January 19, 2001); *Backstreet Boys Productions Inc. v. John Zuccarini*, Case No. D2000-1619 (March 27, 2001).

¹⁷⁰ [Back](#) Current statistics regarding the *Policy* may be found at www.icann.org/udrp/proceedings-stat.htm. See *Cluett, Peabody & Co. Inc. v. Sanford Business Writing Service*, Case No. FA0010000095842 (December 12, 2000); *Cellular One Group v. Applied Communications Inc.*, Case No. D20001-1520 (February 6, 2001).

¹⁷¹ [Back](#) *Creo Products Inc. v. Website In Development*, Case No. D2000-1490 (January 19, 2001); *Credit Suisse Group v. Milanes-Espinach, Fernando and Milanes-Espinach, SA*, Case No. D2000-1376 (March 20, 2001).

¹⁷² [Back](#) *Backstreet Boys Productions Inc. v. John Zuccarini*, Case No. D2000-1619 (March 27, 2001). See also *Cellular One Group v. Applied Communications Inc.*, Case No. D20001-1520 (February 6, 2001).

¹⁷³ [Back](#) *Policy*, paragraph 4(k).

¹⁷⁴ [Back](#) *Policy*, paragraph 4(k).

¹⁷⁵ [Back](#) One commentator has suggested that complainants may properly launch court claims and initiate *Policy* proceedings at the same time - the *Policy* proceeding to obtain a transfer of the domain name, and the court action to recover damages: J. Osborn, "Effective and Complementary Solutions to Domain Name Disputes: ICANN's *Uniform Domain Name Dispute Resolution Policy* and the Federal *Anticybersquatting Consumer Protection Act of 1999 (2000)*", 76 *Notre Dame L. Rev.* 209.

¹⁷⁶ [Back](#) *Rules*, paragraph 18(a).

¹⁷⁷ [Back](#) 2000 U.S. Dist. LEXIS 9516 (S.D.N.Y. 2000).

¹⁷⁸ [Back](#) Case No. D2000-0187 (May 11, 2000). See also *Zero International Holding GmbH & Co. v. Beyonet Services*, Case No. D2000-0161 (March 28, 2000).

¹⁷⁹ [Back](#) See also *Computer Futures Recruitment Consultants v. Keith Phillips and Computerfutures Ltd.*, Case No. AF-0106 (March 29, 2000); *World Publications, Inc. v. World Pen*, WIPO D2000-0736 (September 14, 2000); *ISL Marketing AG v. The European Unique Resources Organisation 2000 BV*, Case No. D2000-0230 (July 5, 2000).

¹⁸⁰ [Back](#) *Weber-Stephen Products Co. v. Armitage Hardware*, 2000 U.S. Dist. LEXIS 6335 (N.D.Ill. 2000).

¹⁸¹ [Back](#) Case No. AF-0278 (September 21, 2000).

- 182 [Back](#) *IPF Online Ltd. v. John Hitfield*, Case No. AF-0291 (November 13, 2000).
- 183 [Back](#) *Rules*, paragraphs 1 and 3(b)(xiii).
- 184 [Back](#) *Virtuality L.L.C. v. Bata Limited*, Civ. No. H-00-3054 (April 3, 2001, D.Md.).
- 185 [Back](#) Proceedings in foreign courts may also result in substantial legal costs.
- 186 [Back](#) *Parsi v. Netlearning Inc.*, 2001 WL 503004 (E.D. Vir. 2001).
- 187 [Back](#) Case No. FA0008000095471 (October 16, 2000).
- 188 [Back](#) *Strick Corporation v. Strickland*, Civ. Act. No. 00-3343 (E.D.Pa., August 27, 2001). See also *Referee Enterprises Inc. v. Planet Ref Inc.*, No. 00-C-1391 (E.D.Wisc., January 24, 2001).
- 189 [Back](#) The *Report* is available at www.dcc.syr.edu/roughjustice.htm.
- 190 [Back](#) The report is available at www.udrpinfo.com.
- 191 [Back](#) See, for example, the *Comments on the CIRA Dispute Resolution Policy and Rules*, submitted to CIRA by Macera & Jarzyna LLP, dated October 12, 2001.
- 192 [Back](#) See *Quirk Works Inc. v. Maccini*, Case No. FA0006000094963 (July 13, 2000) and *Quirk Works Inc. v. Maccini*, Case No. FA0006000094964 (July 11, 2000).
- 193 [Back](#) See *Tata Sons Limited v. D & V Enterprises*, Case No. D2000-0479 (August 18, 2000). See also M. Scott Donahey, "Adding Appeals Procedure to Dispute Resolution Might Satisfy ICANN's Critics" (2001) 6(2) *Electronic Commerce & Law* 33.