Cybersquatting and domain name disputes

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1. Introduction

Domain names are valuable property, being unique identifiers for establishing one's internet presence. As the generic Top-Level Domains ('gTLD') .com, .net and .org were allocated on a first-come, first-in basis, they were susceptible to abusive practices. These include cybersquatting, where people register domain names to sell at exorbitant prices; and reverse domain name hijacking, where entities attempt to unfairly acquire domain names from legitimate holders by financial and legal pressure.

This paper discusses the issue of cybersquatting and briefly outlines the procedures of the Uniform Domain Name Dispute Resolution Policy ('UDRP'), which was established by the Internet Corporation for Assigned Names and Numbers ('ICANN') to deal with this problem. It also provides a thorough assessment of the effectiveness and fairness of the UDRP process as well as suggesting a number of solutions to tackle some of the deficiencies identified.

2. Uniform domain name dispute resolution policy (UDRP)

To deal with cybersquatting, ICANN introduced the UDRP in 1999 as an efficient, cost-effective process for domain name disputes that could be applied globally.[1] The UDRP applies to all gTLD registrars (making up 65% of domain names)[2] and several country top-level domains.[3]

Under the UDRP, domain name registrants contractually agree to participate in a mandatory administrative proceeding with an approved dispute resolution service provider ('DSP') where a complainant alleges three elements:

1. that the domain name is identical or confusingly similar to a trade or service mark in which the complainant has rights (so the complainant must be a trademark owner);
2. that the registrant does not have any rights or legitimate interests in respect of the domain name; and
3. that the domain name was registered and is being used in bad faith.[4]

Prior to 28 February 2002 and the approval of the Asian Domain Name Dispute Resolution Centre, the existing DSPs were the World Intellectual Property Organisation Mediation and Arbitration Centre ('WIPO'), The National Arbitration Forum ('NAF'), the CPR Institute for Dispute Resolution and eResolution.[5]

3. Assessment of the UDRP

The UDRP appears to be successful as a dispute resolution alternative to costly and lengthy litigation. Several Australian organisations have used the UDRP to gain transfer of domain names including telstra.org, westfieldshopping.com and the wiggles.com.[6]

However, the UDRP is a policy trade-off between trademark owners (simplifying the process to contest domain names to eradicate abusive registrants) and registrants (lowering the threshold to contest domain names makes it easier for reverse domain name hijackers to make challenges against legitimate holders).[7]

This has had several consequences in relation to the effectiveness of the UDRP process, the fairness of its rules, the quality of decisions and equality on the internet.

4. Effectiveness of process

The UDRP is effective as it is simple and easily accessible. The process is conducted entirely online with a single electronic and hard copy document submission of facts and legal arguments. Service of process can be achieved by email to the address shown in the registrar's record.[8]

The UDRP has been efficient, providing a response in approximately 45 days[9] from the initial complaint. The process is cost-effective with low filing fees, starting with a cost of $US1500 for one panellist for a complaint involving one to five domain names (WIPO), which is less than usual court litigation costs.[10] It is also effective in overcoming jurisdictional barriers for enforcement as it applies to all registrars irrespective of where they are located.

As at 14 February of this year, 4314 proceedings affecting 7507 domain names have been conducted under UDRP, with over 75% of proceedings decided in favour of the complainants.[11] Hence, overall UDRP has been effective in addressing the latent demand for administrative proceedings against cybersquatters in different situations.

4.1 Fact-finding Inadequacy

Despite the apparent success of the UDRP, the lack of oral testimony and rules of evidence in these paper proceedings limit the ability to evaluate disputed facts and assess credibility of evidence. Panels can only judge on what is presented to them, so they may have to regard submissions as reliable where there is no refuting documentary evidence.[12] This is particularly relevant to submissions of legitimate interest.[13] Different conclusions may result in a court where the evidence is better able to be scrutinised for its credibility.[14] Thus the UDRP process is less effective than a court in cases involving disputed facts.

4.2 Precedents

Panels can refer to any rules or principles of law it deems appropriate.[15] Currently, about 32% of

UDRP decisions cite prior decisions.[16] This trend to refer to past decisions as precedents is facilitated by all UDRP decisions being published on the ICANN website and by lawyers representing the parties who are trained to use favourable prior decisions to enunciate general propositions.[17]

While this improves consistency between UDRP decisions, the use of 'precedents', which requires lengthy research for 'rules of law' (similar to the complex court system), diminishes the effectiveness of UDRP as a simple, cost-efficient process. Further, the relevance of 'precedents' may be limited where prior decisions were decided in accordance with foreign laws and are written in foreign languages.[18]

The use of precedents highlights another limitation on the effectiveness of UDRP because of the lack of an appellate system or guidance to panels to reconcile two or more inconsistent UDRP decisions.[19]

4.3 Limited scope and remedies

The effectiveness of the UDRP is also limited to its purpose of dealing only with cybersquatting cases so it can only order the transfer or cancellation of domain names.

If the complainant has concerns other than gaining ownership of the domain name, such as trademark infringement, false advertising, unfair competition or wishes to seek relief such as injunctions (to prevent posting of certain content), damages and costs, the UDRP is not the appropriate forum.[20] Rather a court action would be more suitable.

5. Fairness of Rules

5.1 Burden of Proof

The burden of proof in UDRP proceedings lies upon the complainant to prove a prima facie case with all of the three elements discussed above.[21] This requirement is fair and consistent with due process.

Two views exist as to how the burden of proof should be applied where the registrant does not reply to the complaint. One view is that the burden of proof remains on the complainant, as the panel should not make inferences of intent from allegations rather than from facts or evidence (literal approach).[22]

However, another broader view shifts the burden of proof since it is difficult for the complainant to prove the registrant had no legitimate interest where only the registrant knows this and adopting the literal approach would give the registrants a 'tactical advantage' by not responding to complaints.[23]

This consequence is relevant as registrants default in over 50% of cases of which 90% are won by complainants.[24] Although the broader approach is efficient, according to fairness principles, it clearly favours the complainant's (trademark owners) rights over the registrant's rights.

5.2 Appealing the UDRP decision

If a complainant loses the arbitration, he/she can, subject to statute of limitations restrictions, bring a court action against the registrant. This appears fair with the courts as a control mechanism on wrong UDRP decisions.[25] However, an unfair consequence under the UDRP rules arises when registrants lose the arbitration.

When the registrant loses, court action within 10 days must be taken to stay the adverse UDRP decision in a jurisdiction where the registrar or registrant is located.[26] If the registrant is located in a jurisdiction that is not conducive to domain name litigation, the registrant may be disadvantaged, as he/she may be forced into litigation in an unfamiliar jurisdiction almost immediately and has to quickly obtain legal representation.[27] Again, it seems that the UDRP favours the rights of the trademark owners over the registrants.

5.3 Trade Names

Another limitation of the UDRP is that it only applies to trade and service mark owners, but not trade names.[28] However, celebrity personal names have been found to be 'trademarks' at common law.[29]

This means the UDRP is unfair in distinguishing people on status: an ordinary person cannot use the UDRP to restrict the use of their personal name, as it would not satisfy the 'trademark' requirement. In comparison, the United States (US) *Anti-cybersquatting Consumer Protection Act* ('ACPA') protects all personal names.[30]

5.4 Choice of Arbitrator

Participants are able to select the arbitrators (from the DSP's list) for the proceedings.[31] While this appears to be fair to the participants as it allows them to choose arbitrators who are familiar with their jurisdiction, this has resulted in certain unfair outcomes ultimately affecting the quality of decisions (discussed further below).

5.5 Reverse Domain Name Hijacking

As mentioned above, the UDRP makes reverse domain name hijacking easier for trademark owners. Although reverse domain name hijacking declarations have been made against excessively aggressive complainants,[32] such a determination currently does not incur any penalties.[33] This appears to be unfair to legitimate registrants who have expended time and expense to defend their registrations.

6. Quality of decisions

UDRP arbitrators range from intellectual property experts to retired judges from around the world. This wide jurisdictional spread of possible arbitrators, results in the main deficiency of UDRP decisions, namely the inconsistent decisions due to different interpretation and application of the UDRP.

6.1 Arbitrators

This inconsistency can most clearly be seen in the cases involving Quirk, a car dealer and a customer who registered several domain names including quirkautos.com,[34] quirknissan.com[35] and quirkmazda.com,[36] using the websites to provide warning information about car dealers. The domain names were

split into 3 cases with 3 different arbitrators.

In the latter two cases, the names were transferred to the complainant as the registrant had demonstrated bad faith by diverting the complainant's business customers. However, in the first case, the arbitrator held that the domain names were being used for legitimate criticism as protected under the first amendment to the US constitution.[37]

This demonstrates that even in cases with the same facts, different outcomes can result from different arbitrators. This highlights the weakness of the UDRP process, as decisions are highly dependent on the selection of the arbitrators, their language, culture and jurisdictional backgrounds and on guidance from ICANN.[38]

6.2 Examples of Inconsistency

In determining whether a trademark is 'confusingly similar' with a domain name, interpretation has ranged from only comparing the trademark with the domain name[39] to a consideration of the entire circumstances relating to the domain name's registration and use.[40]

Courts have also varied as to whether registering a generic term with the intention of selling it constitute bad faith.[41] Some cases have held generic terms give registrants a legitimate interest and so the complainant fails,[42] while other cases hold there is no legitimate interest.[43] The latter cases have been criticised as unjustly giving trademark owners more rights than permitted under trademark law which only gives companies exclusive naming rights in that particular industry and locality and certainly not on a general basis (such as generic terms).

Another example of inconsistent interpretation of the rules was in *guerlain.net*,[44] where the registration of 14 other recognisable trademark domain names established a pattern of bad faith. Yet in *cignadirect.com*,[45] bad faith could not be implied from the registrant having registered 50 other domain names, as the panel did not know why those names were registered.

6.3 Dispute Resolution Service Providers (DSP)

According to a study conducted in November 2000,[46] at WIPO, 67% of proceedings are won by the complainant,[47] at NAF, 72% win and at eResolutions, only 44% win.

This was found to be due to WIPO and NAF panellists adopting a broader interpretation of the URDP rules, to give trademark holders stronger rights, than that given at eResolutions.[48]

As WIPO and NAF attract the largest number of complaints (61% and 31%, respectively) and eResolutions only 7%,[49] it would seem this bias in favour of trademark holders applies to a significant proportion of cases.

As complainants can choose which DSP to use, they can undertake 'DSP-shopping' to select the DSP that is most likely to rule in their favour. This creates a bias against domain registrants and benefits trademark owners or repeat players who have the financial resources and experience to know and select the DSP that is to their advantage.[50]

Hence, although decisions are made after careful consideration, the quality of the decisions is limited by the inconsistency in interpretation of the UDRP resulting in inequality and unfairness to participants.

6.4 Free expression

The UDRP has also been condemned for overemphasis on trademark owners' rights over general rights of free expression, hindering the internet as a medium for information exchange.[51]

However, this assertion is unfounded. Admittedly, most cases have held domain names e.g. NAMEsucks.com to be 'confusingly similar' to trademarks e.g. 'NAME', especially in cases where the Internet user may not be English.[52] However, the domain names were transferred where the registrant demonstrated bad faith, for example, by a pattern of registering other NAMEsucks.com domain names to embarrass the owners and there being no evidence to show the domain names were being used for criticism or free expression (a legitimate interest).[53]

Indeed several cases have upheld criticism and commentary as a legitimate interest,[54] even if the domain name was confusingly similar with a trademark. Thus free expression is protected under the UDRP rules as the panels recognise criticism as a legitimate use.

7. The UDRP – Court relationship

7.1 Laws of different jurisdictions

Under the rules, panellists are able to make their decisions on the basis of whichever law (including cases[55] or legislation) they deem as appropriate.[56] This is fair as only relevant legislation is applied to the participants. For example, in *westfieldshopping.com*[57] as the parties were related to Australia, the *Trade Marks Act 1995* (Cth) was applied.

7.2 Simultaneous Court Proceedings

The effect of simultaneous legal proceedings on a current UDRP proceeding depends on the discretion of the panel, [58] although most panels have rejected requests for a stay of proceedings.[59]

However in *innersense.com*,[60] as the complainant obtained an injunction to prohibit the transfer of the domain name registration pending a court order, proceedings were stayed to avoid delivering a decision inconsistent with the court order. This shows how court decisions take priority over UDRP proceedings.

7.3 Lack of Finality

As the filing of a court action in a jurisdiction where the registrar or registrant is located can stay UDRP decisions, the resulting lack of finality can also limit the effectiveness of the UDRP process.[61] Moreover, a US federal court has found that UDRP decisions are not legally binding and can be challenged in a court.[62]

Also, in January 2001, a Wisconsin federal district court reversed a UDRP decision without any reference or consideration to the arbitrator's

decision.[63] This implies UDRP decisions have no analytical value in court actions.

7.4 Right of review under UDRP

Although the UDRP makes provisions for court appeal, it has been asserted that this right of review is 'illusory',[64] as the UDRP decision does not automatically give a right to court appellate review of the panel's decision in the mutual jurisdiction.[65] The mutual jurisdiction is generally either the jurisdiction in which the registrar is located or the registrant's address as stated in the registrar's database at the time the complaint is submitted.[66]

The registrant cannot sue in contract against the arbitration service provider, domain-name registrar or ICANN for improperly applying the UDRP policy as the registrant agreed in the registration contract not to sue them in relation to UDRP proceedings. [67]

Given that over half of the 80 accredited ICANN registrars are based in the US,[68] consideration of US appellate avenues of law would be most relevant at this point.[69]

UDRP decisions are not binding in US courts,[70] so registrants cannot bring actions under the *Federal Arbitration Act*.[71]

The only remaining action would be to apply for declaratory judgment or for relief under the domain name review provisions of §32(2)(D)(v) of the US *Lanham Act*. However such court review is only available if there is an actionable case, that is, if there is an assertion of infringement of rights under the US ACPA or trademark law. For example, in *corinthians.com*,[72] the US court held it did not have jurisdiction to review the UDRP decision as no breach of US rights or law was claimed. In the UDRP proceedings the registrants only asserted their Brazilian rights, which were not actionable under US law.

So, registrants may be bound by an adverse UDRP finding, which lacks judicial authority (as the courts do not place any value on UDRP decisions), yet find themselves without the ability to seek appellate review. This is particularly unfair for registrants and demonstrates another serious weakness of the UDRP.

8. Solutions

8.1 Advisory opinions

As already discussed, one of the main problems of the UDRP decisions is the lack of consistency of interpretation of the UDRP Policy resulting in unfairness.

One solution would be to establish an advisory board of impartial arbitrators to review all UDRP decisions and then issue advisory opinions, which would be the sole authorised precedents that can be used in UDRP proceedings. This will alleviate the bias, inconsistency and interpretation problems.[73]

8.2 Courts

To address the weakness of the UDRP process due to the panel's inability to fairly assess the credibility of evidence, the UDRP should maintain its limited focus, only ruling in cases of clear abusive behaviour. In cases where there is uncertainty, the panels should not 'guess' but leave such cases to the courts. This would avoid the problem of the reversal of the burden of proof and lack of sufficient appeal avenues.

8.3 Self-regulation

The success of the internet depends on the confidence consumers and businesses have in its efficient operation. This confidence is secured by allowing the internet to be administered by contracts and self-regulation, which, unlike legislation that can take significant time to develop, can easily accommodate the internet's rapid technological changes. In particular, the longer the dispute resolution process, the greater the loss of opportunity for companies who lose that time to be able to market their goods and services using their domain names.

So the advantage of self-regulation is that it allows immediate adoption of industry standards for example via arbitrators in deliberation who can take account of technological changes or new abusive behaviours.

8.4 Success of the powerful

Having said that, self-regulation tends to result in the success of the powerful to the detriment of consumers.

In pursuit of self-regulation, governed by market principles of cost and efficiency, judicial safety measures to address power imbalances can often be eroded, resulting in a decrease in procedural fairness (limited appeal avenues) and due process (short notice, no discovery, written submissions and no in-person hearings or collective action).

Bias against consumers is also demonstrated by the unfair consequences to a registrant who has lost the UDRP proceeding and now bears the burden of proof in court proceedings.

There is also a lack of consideration of the public interest. The UDRP rules were developed by ICANN, a private body with input from powerful industry interest groups (like the WIPO, who have a vested interest in the protection of trademarks since they provide services to trademark owners). Thus the existing rules reflect the interests of those who contributed to their drafting: the trademark owners, copyright owners and corporate repeat players, resulting in the success of the powerful.

Moreover, generally only repeated players or those with financial resources can gain advantageous knowledge (such as which DSP to use to their benefit). Consumers, who are unlikely to have such information, are again at a disadvantage in this form of self-regulation.[74]

So although self-regulation achieves efficiency, it tends towards an environment manipulated by corporate players to maximise their interests. Thus it is important to be aware of the situations of market failure to protect consumers.

8.5 Market Failure

Where market failure does occur such that consumers suffer a detriment (e.g. reversed onus of proof, lack of appeal

choices) there is a need for court or government intervention to ensure there is a fair, equitable balance between market and public interests.

Here, this can be achieved by limiting self-regulation, or more specifically, the UDRP, to areas where efficiency is most important (such as cybersquatting cases), although where cases involve due process and policy concerns (for example cases concerning disputed facts), these should be left for the courts and legislature to resolve (e.g. the US ACPA).

9. Conclusion

The UDRP has been quite successful in addressing a very large number of cases since its inception with a steady average of 270 cases a month.[75] Even with legislation such as the US ACPA, the UDRP has continued its popularity nonetheless as the participants are generally more concerned in gaining the domain name in a simple, cost-effective way than receiving damages.[76] So demand for the UDRP is still strong and will only grow with the introduction of the new gTLDs.[77] Even Australia is planning to adopt a modified form of UDRP.[78]

Overall, the UDRP is quite an effective self-regulatory alternative for domain name disputes as long as it addresses its limitations such as issuing guidelines to the panels and referring decisions to the courts in cases where it is clear the UDRP is an inappropriate forum. By overcoming its problems, the UDRP will be an even more useful domain dispute forum in the future to come.

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1 <http://www.icann.org >.

2 As at Nov 2000, Mueller, M., *"Rough Justice: An Analysis of ICANN's Uniform Dispute Resolution Policy*, v2.1", November 2000, Sycacuse University Convergence Center, <http://dcc.syr.edu/roughjustice.htm>, accessed 18 February 2002.

3 The country top level domains include .ag, .as, .bs, .cy, .fj, .gt, .na, .nu, .pa, .ph, .pn, .ro, .tt, .tv, .ve and .ws <http://arbiter.wipo.int/domains/cctld/index.html>.

4 Uniform Domain Name Dispute Resolution Policy (UDRP) para 4a.

5 <http://www.icann.org/udrp/approved-providers.htm>, accessed 18 February 2002.

6 <http://www.icann.org/udrp/proceedings-list-name.htm>, accessed 18 February 2002.

7 Mueller, see note 2 above.

8 Rules for Uniform Domain Name Dispute Resolution Policy, adopted on August 26, 1999. <http://www.icann.org/udrp/udrp-rules-24oct99.htm>, accessed 18 February 2002.

9 Dinstein, O., & Cappunyns, E., "Pitfalls in ICANN's Domain Name Dispute Policy", 19 Sept 2000, *New York Law Journal*.

10 <http://arbiter.wipo.int/domains/fees/>, accessed 18 February 2002.

11 <http://www.icann.org/udrp/proceedings-stat.htm>.

12 Rules for UDRP para 13; Edelman, S., "Cybersquatting claims take center stage", January 2001, 18(1) *Computer and Internet Lawyer*.

13 Willoughby, T., "An analysis of the ICANN dispute resolution policy: part 2" February 2001, 3(2) *E-Commerce Law and Policy* <http://www.e-comlaw.com>; see *Penguin Books Limited v. The Katz family and Anthony Katz*, WIPO D2000 – 0204 (28 March 2000).

14 As noted by the panellist in *Infospace.com Inc. v. Infospace Technology Co. Ltd.*, WIPO D2000-0074 (18 Feb 2000).

15 Rules for UDRP para 15(a).

16 Levy, J., "Precedent and other problems with ICANN's UDRP Process", April 2001 *Domain Name Law Reports*, <http://dnlr.com/reporter/levyicann.shtml>; *Loblaws, Inc. v. Presidentchoice.Inc/ Presidentchoice.com*, AF-0170 (3 Apr 2000) (which cited six different UDRP decisions).

17 *Ibid.*

18 *Ibid.*

19 *Ibid.*

20 Osborne, D., "In a dispute – ICANN arbitration or court?" November 2000 2(11) *E-Commerce Law and Policy*.

21 *Universal City Studios, Inc. v. G.A.B. Enterprises*, Case No. D2000-0416 (WIPO, June 29, 2000).

22 *Raj Vasant Pandit v. Vishal Bhuta*, DeC, No. AF-0224, (July 10, 2000); *Cyro Indus. v. Contemporary Design*, WIPO, No. D2000-0336, (June 19, 2000); *Softquad Software Inc. v. Eleven-Eleven Ltd.*, DeC, No. AF-0143, (June 1, 2000) noted in White, J., "ICANN's Uniform Domain Name Dispute Resolution Policy in Action", 2001, 16 *Berkley Technology Law Journal* 229.

23 *Loblaws, Inc. v. Charlo Barbosa*, DeC, No. AF-0163 (June 23, 2000); *Wine.com, Inc. v. Zvieli Fisher*, WIPO, No. D2000-0614, at (Sept. 11, 2000) in White, J., "ICANN's Uniform Domain Name Dispute Resolution Policy in Action", 2001, 16 *Berkley Technology Law Journal* 229.

24 *Ibid.*

25 Although this appellate avenue is limited which is detailed later in "The UDRP – Court Relationship".

26 UDRP para 4k.

27 Froomkin, M., "Wrong turn in cyberspace: using ICANN to route around the APA and the Constitution" Oct 2000, 50(1) *Duke Law Journal* 17.

28 *Manchester Airport PLC and Club Limited*, WIPO D2000-0638 (4 July 2000); UDRP para 4(a)(i).

29 *Julia Fiona Roberts v. Russell Boyd* WIPO D2000-0210(29 Mar 2000); *Jeanette Winterson v. Mark Hogarth* WIPO D2000-0235 (10 Apr 2000); *Isabelle Adjani .v. Second Orbit Communications, Inc*, WIPO D2000-0867 (16 Aug 2000).

30 Dixon, R., "Common names and Common sense: Why celebrity names should not be subject to the UDRP", 26 October 2000, *Domain Notes* <http://www.domainnotes.com/news/article/0,,4651_495871,00.html>, accessed 18 February 2002.

31 Rules for UDRP para 6.

32 *Deutsche Welle v. DiamondWare Ltd.* WIPO D2000-1202 (Jan. 2, 2001) and *Goldline International Inc. v. Gold Line* WIPO D2000-1151 (Jan. 4, 2001); Rules for UDRP para 15(e).

33 Willoughby, T., "An analysis of the ICANN dispute resolution policy: part 3" March 2001, 3(3) *E-Commerce Law and Policy* 1 <http://www.e-comlaw.com>.

34 *Daniel J. Quirk, Inc., East Braintree, MA, USA v Michael J. Maccini, Randolph, MA, USA* NAF FA0094964 (6 June 2000).

35 *Quirk Nissan Inc v Michael J. Maccini, Randolph, MA, USA* NAF FA0094959 (6 June 2000).

36 *Quirk Works Inc v Michael J. Maccini, Randolph, MA, USA* NAF FA0094963 (6 June 2000).

37 Mueller, note 2.

38 *Ibid.*

39 *InfoSpace.com, Inc. v. Delighters, Inc.*, D2000-0068 (May 1, 2000).

40 *AT&T v. Tala Alamuddin*, D2000-0249 (May 18, 2000).

41 UDRP para 4b(i).

42 *General Machine Products Co., Inc. v. Prime Domains, FA0092531, and Allocation Network GbmH v. Steve Gregory*, D2000-0016 (March 24, 2000).

43 *Hearst Communications, Inc. et al. v. David Spencer et al.*, FA0093763 (April 13, 2000), *J. Crew International, Inc. v. crew.com* WIPO D2000-0054 (16 Feb 2000).

44 *Guerlain S.A. v. Peikang* WIPO D2000-0055 (16 Feb 2000).

45 *Cigna Corporation v Jit Consulting* DeC AF-0174 (11 Apr 2000).

46 Mueller, note 2. Note only WIPO, NAF and eResolutions were analysed in the study as CPR had only just been approved by ICANN at the time.

47 *Ibid;* <http://www.wipo.org>.

48 *Ibid.*

49 *Ibid.*

50 *Ibid.*

51 Dixon, R., "The Arbitral Forum: Why ICANN's Uniform Dispute Resolution Process Must Undergo Reform". 9 October 2000, *Domain Notes* <http://www.domainnotes.com/news/article/0,,4651_480291,00.html>.

52 *ADT Services AG v. ADT Sucks.com*, note 52.

53 *ADT Services AG v. ADT Sucks.com*, WIPO D2001-0213 (26 Feb 2001); *Dixons Group PLC v Purge IT and Purge IT Limited*, Case No D 2000-0584 (28 June 2000); *Diageo plc v John Zuccarini t/a Cupcake Patrol*, WIPO Case No D2000-0996 25 Aug 2000); *Wal-Mart Stores, Inc. v. Richard MacLeod*

d/b/a For Sale WIPO D2000-0662 (14 Jul 2000).

54 *McLane Company, Inc. v. Fred Craig* WIPO D2000-1455 (16 Nov 2000); *Bridgestone Firestone, Inc., Bridgestone/Firestone Research, Inc., and Bridgestone Corporation v. Jack Myers* WIPO D2000-0190 (28 Mar 2000).

55 *Lockheed Martin Corp. v. Parisi*, D2000-1015 (Jan. 26, 2001). (The Panel relied on two US court cases for its decision.)

56 Rules for UDRP para 15a.

57 *Westfield Corporation, Inc and Westfield Limited v. Graeme Michael Hobbs (Dynamic Marketing Consultants)* WIPO D2000-0227 (7 Apr 2000).

58 Rules for UDRP para 18.

59 *Computer Futures Recruitment Consultants v. Keith Phillips and Computerfutures Ltd.*, Dec. AF-106 (16 Feb 2000); and *Weber-Stephen Products Co. v. Armitage Hardware*, Case No. D2000-0187 (22 Mar 2000).

60 *Innersense International Inc. v. Keith Manegre*, DeC AF-0278 (20 Jul 2000).

61 UDRP para 4(k).

62 *Weber-Stephen Products Co., v. Armitage Hardware and Building Supply, Inc.*, 54 U.S.P.Q.2d 1766, 2000 WL 562470 at 2 (N.D. Ill. May 3, 2000).

63 *Referee Enterprises Inc v Planet Ref Inc.*, No.00-C-1391 (E.D. Wisc. Jan 24, 2001).

64 Steward, D., & James, A., " 'Right of review' under UDRP may be illusory" 30 April 2001, *National Law Journal* pC23.

65 *Ibid.*

66 Rules for UDRP para 1

67 *Ibid.*

68 <http://www.icann.org/registrars/accredited-list.html>.

69 Court of 'Mutual jurisdiction' includes where the registrar is located: UDRP para 4(k).

70 *Weber-Stephen Products Co. v. Armitage Hardware and Building Supply Inc.*, 54 U.S.P.Q.2d 1766, 2000 WL 562470, at 2 (N.D. Ill. May 3, 2000).

71 Similarly in Australia, under the *International Arbitration Act 1974* (Cth) s8(5)(f) courts can refuse to enforce non-binding arbitration agreements on the parties.

72 *Corinthians Licenciamentos LTDA v. David Allen*, WIPO Case No. D2000-0461 (30 May 2000).
Sallen v. Corinthians Licenciamentos LTDA, No. 00-11555, 2000 U.S. Dist. Lexis 19976 (D. Mass. 2000).

73 Levy, note 16

74 Thornburg, E., "Going Private: Technology, Due Process and Internet Dispute Resolution", (Fall 2000) 34 U.C. *Davis L. Rev* 151.

75 Mueller, note 2; <http://www.icann.org/udrp/proceedings-stat.htm>.

76 Elder, J., "Naming Rights", May 2001, Issue 2 *elawpractice.com.au* at p20.

77 Such as .biz, .aero, .name, .coop, .pro, .info and .museum.

78 See: <http://www.auda.org.au/policy/wg-dr-2001/>, accessed 13 March 2002.

Domain name dispute – Germany

Intellectual Property News, Linklaters and Alliance

Germany: "For the first time, the Federal Supreme Court held that there was no remedy of transfer of disputed domain name to the claimant."

On 11 November 2001, in a precedent-setting decision, the Federal Supreme Court ruled on the prohibitory action taken by Deutsche Shell GmbH regarding the domain "shell.de". The court ruled against the defendant, Andreas Shell, who owned the domain "shell.de". Andreas Shell had acquired the domain name from a domain-broker and had originally been using it for promoting translation and press services. Subsequently he only used it for private purposes.

The Federal Supreme Court confirmed the first and second instance judgments of the Regional Court and the Higher Regional Court of Munich. Its decision is primarily based on the fame of the name and trade mark "Shell" and the outstanding level of awareness of the mark. The Court ruled that the claimant had interests worthy of protection in that potential clients should not be led to the website of the defendant, and that the public had an interest in not being misled. Further, the court held that it could reasonably be expected of Mr. Shell that he differentiate himself from the claimant, rather than vice versa. The Federal Supreme Court confirmed the general principle of priority with regard to time and did not recognise any general priority of commercial over private interests, but held that this case was an exception for reasons of respect and practicability. People wishing to contact Andreas Shell could more easily be informed about an alternative domain name than people interested in the website of Deutsche Shell GmbH.

For the first time, the Federal Supreme Court held that there was no remedy of transfer of the disputed domain name to the claimant. In this respect, it found for the defendant. Third parties could have the same or even a better right. In practice, an automatic transfer can usually be achieved by filing a "dispute" application with the DENIC (the central registry for domain names under the top level domain ".de"). In this case, a domain name cancelled with DENIC will be automatically transferred to the person who filed the "dispute".

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