

Domain names

JOHN D. GOODHUE

McKEE, VOORHEES & SEASE

I. INTRODUCTION

A. DEFINITION AND DESCRIPTION OF A DOMAIN NAME

A domain name is an identifier that corresponds to a numeric routing address called an Internet Protocol (IP) address. Computers use ip addresses to find each other and route information to each other. For example, *www.ipmvs.com* corresponds to the ip address of 216.81.229.217. A domain name is easier for a person to remember and to use than an ip addresses. Additionally, a domain name can express a name, a description, or other helpful identifying information.

1. Top level domains

A domain name can be broken down into multiple pieces. These include the Top Level Domain (TLD) and a second level domain. See e.g. *Sallen v. Corinthians Licenciamentos Ltda*, 273 F.3d 14 (1st Cir. 2001). The TLD is the rightmost portion of a domain name. For example, *.com* is the TLD domain in *ipmvs.com*. *.com* is also an example of a generic Top Level Domain (gTLD). Other examples of gTLDs include *.org*, *.net*, *.info.*, *.biz*, *.aero*, *.coop*, *.museum*, and *.pro*. There are also country code TLDS (ccTLDS). These include *.ca* (Canada), *.jp* (Japan), *.de* (Germany) and numerous others.

2. Second level domain

In addition to the TLD, there is at least a second level domain. In *www.ipmvs.com*, the “*ipmvs*” is the second level domain.

B. CHARACTERISTICS OF DOMAIN NAMES

Defining some of the general characteristics of domain names is helpful as it provides additional insight into the problems that domain names create.

1. Easy to get

Domain names are easy to obtain, provided no one else already has the domain you want. In fact, a domain name can be obtained in seconds. Further, domain names are very inexpensive to obtain and are registered privately in generally a first-come, first-served manner.

2. Ownership and use of a domain name is very visible

Registration information for a domain name is easily obtainable to anyone with Internet access. Further, anyone with Internet access can tell that a domain name is being used, at least for a web site. When there is a web site associated with a domain name, the contents of that web site can have a wide audience.

3. Only one of each domain name

Domain names serve as unique identifiers, therefore there can only be one of each domain name.

C. COMMON DOMAIN NAME PROBLEMS

The characteristics of domain names have created a number of problems. Primarily these problems have related to trademark rights, although other rights/and claims can come into play. It makes perfect sense that the owner of a mark would want to have a domain name (and corresponding web site) that corresponds to their mark. However, such a domain name may already have been registered by someone else.

1. Cybersquatting

One scenario that arose early and often is that individuals would register domain names corresponding to someone else's trademark speculating that the domain name would be valuable to the trademark owner and the trademark owner would be willing to buy the domain name. See e.g. *Panavision Int'l, L.P. v. Toeppen*, 141 F.3d 1316 (9th Cir. 1998).

2. Multiple trademark owners, but only one domain name

Another scenario that continues to arise is that domain names must be unique within a particular TLD while trademarks are generally not so unique. Thus, multiple parties can have trademark rights in the same mark, where each uses the mark to identify different

goods and services. For example, DELTA is associated with particular air travel services as well as with particular water fixtures.

3. Domain name is associated with a trademark, but also has other significance

A word or phrase in a domain name will likely have significance other than as an indicator of source and outside of the trademark sense. Thus both owners of a trademark and those who use the same word or phrase for other legitimate reasons may desire the same domain name. See e.g. *Avery Dennison Corp. v. Sumpton*, 189 F.3d 868, 51 U.S.P.Q.2d 1801 (9th Cir. 1999).

4. Domain name includes a trademark but no confusion as to source of origin

Other problems relate to situations where the domain name includes a trademark but is being used by someone else in a legitimate matter. See e.g. *Bally Total Fitness Holding Corp. v. Faber*, 29 F.Supp.2d 1161 (C.D.Cal.1998) (no Lanham Act violation for registering "Ballysucks.com").

II. ANTI CYBERSQUATTING PROTECTION ACT

A. OVERVIEW OF LAW - 15 U.S.C. § 1125(D) OR LANHAM ACT § 43(D)

The Act provides a cause of action against anyone who (1) has a bad faith intent to profit from the mark (including a protected personal name) and (2) registers, traffics in, or uses a domain name that is identical to, or confusingly similar to a distinctive mark, or dilutive of a famous mark, without regard to the goods or services of the parties.

B. NONEXCLUSIVE FACTORS TO DETERMINE BAD FAITH

The Act specifically provides for factors that can be considered (without limitation) to determine the presence or absence of bad faith. These factors include:

1. “the trademark or other intellectual property rights of the person, if any, in the domain name” 15 U.S.C. § 1125(D)(1)(B)(i)(I)
2. “the extent to which the domain name consists of the legal name of the person or a name that is otherwise commonly used to identify that person” 15 U.S.C. § 1125(D)(1)(B)(i)(II)

3. “the person’s prior use, if any, of the domain name in connection with the bona fide offering of any goods or services” 15 U.S.C. § 1125(D)(1)(B)(i)(III)
4. “the person’s bona fide noncommercial or fair use of the mark in a site accessible under the domain name” 15 U.S.C. § 1125(D)(1)(B)(i)(IV)
5. “the person’s intent to divert consumers from the mark owner’s online location to a site accessible under the domain name that could harm the goodwill represented by the mark, either for commercial gain or with the intent to tarnish or disparage the mark, by creating a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the site” 15 U.S.C. § 1125(D)(1)(B)(i)(V)
6. “the person’s offer to transfer, sell, or otherwise assign the domain name to the mark owner or any third party for financial gain without having used, or having an intent to use, the domain name in the bona fide offering of any goods or services, or the person’s prior conduct indicating a pattern of such conduct” 15 U.S.C. § 1125(D)(1)(B)(i)(VI)
7. “the person’s provision of material and misleading false contact information when applying for the registration of the domain name, the person’s intentional failure to maintain accurate contact information, or the person’s prior conduct indicating a pattern of such conduct” 15 U.S.C. § 1125(D)(1)(B)(i)(VII)
8. “the person’s registration or acquisition of multiple domain names which the person knows are identical or confusingly similar to marks of others that are distinctive at the time of registration of such domain names, or dilutive of famous marks of others that are famous at the time of registration of such domain names, without regard to the goods or services of the parties” 15 U.S.C. § 1125(D)(1)(B)(i)(VIII)
9. “the extent to which the mark incorporated in the person’s domain name registration is or is not distinctive and famous” 15 U.S.C. § 1125(D)(1)(B)(i)(IX)

C. REMEDIES

The ACPA provides for various remedies. These remedies include injunctive relief, actual damages, recovery of profits, and statutory damages from \$1000 to \$100,000. Money damages can only be recovered for activities that occurred after the enactment date of the Act of *November 29, 1999*.

D. JURISDICTION

1. In rem jurisdiction

a. In rem

There is a provision if a party is unable to find the alleged squatter after due diligence is used to find the squatter, the party may sue the domain name itself in an in rem action.

b. The in rem action should be brought where the registry is located.

2. Jurisdiction to review UDRP

In *Sallen v. Corinthians Licenciamentos LTDA*, 273 F.3d 14 (1st Cir. 2001), Sallen a Massachusetts resident had lost a UDRP action to a Brazilian corporation for the domain name corinthians.com. He then brought an action seeking a declaration that he was not a cybersquatter under the ACPA and that he was not required to transfer the domain name. The First Circuit held that there was jurisdiction to address such a claim.

III. OTHER CAUSES OF ACTION

A. TRADEMARK INFRINGEMENT

Another potential remedy is trademark infringement. However, trademark infringement analysis should take into account how the domain name is used. See *Entrepreneur Media, Inc. v. Smith*, No. 00-56559 (9th Cir. 2002) (No infringement of ENTREPRENEUR trademark by use of EntrepreneurPR.com domain name in connection with offering of public relations services for entrepreneurs).

B. CONVERSION

In some situations, a claim of conversion may be appropriate. For example where an employee or former employee registers a domain name corresponding to the mark of the employer. See e.g. *Gaede v. Sk Investments, Inc.*, 38 S.W.3d 753 (Tex.App. 2001).

IV. FACT INVESTIGATION

A. WHOIS

Once a domain has been identified, information concerning the registrant (owner) of the domain can be determined by querying a whois database. The whois database provides details concerning who registered a domain, which registrar was used to register the domain, when it was registered and other information that proves useful.

1. WHOIS databases available

www.allwhois.com

www.networksolutions.com

B. USE OF DOMAIN NAME

Visiting the domain provides additional facts as to how the domain is being used. The domain should be fully explored, including examining the source of each web page. The source itself may provide additional information concerning the web site.

V. UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY

In the process of registration of a domain name, a domain name registrant agrees to be subject to the Uniform Domain Name Dispute Resolution Policy (UDRP). This policy sets forth procedures for UDRP proceedings that provide for transfer or cancellation of domain names.

A. NOTICE

Paragraph 2(a) of the Uniform Rules requires that the complainant and arbiter "to employ reasonably available means calculated to achieve actual notice to Respondent." Actual notice that may be effected through electronic mail, postal mail, facsimile, or other means.

1. Contacting the registrant via email

- a. Verifies the validity of the email address given to the registrar
This is useful because if the email address is not valid, this may be in violation of the registrar's service agreement and this fact may show bad faith.

- b. Provides the registrant an opportunity to provide a response.
 - i. The response itself may be indicative of bad faith.

A. Offer to sell domain.

"if your client wants the name then your client needs to make an offer for it". *CCA Industries, Inc. v. Bobby R. Dailey*, WIPO Case No. D2000-0148, (April 26, 2000).

- 2. Contacting the registrant by postal address
 - a. Verifies the validity of the postal address given to the registrar.

B. PROVIDERS

- 1. World Intellectual Property Organization (WIPO)
 - a. Case statistics

Case statistics are available at the WIPO web site at arbitrator.wipo.int/domains/statistics/results.html. As of September 2000, 591 decisions were rendered. In 467 of these cases, the domain was transferred to the complainant, in 6 cases, the domain was cancelled, and in 118 cases, the complaints were denied.
- 2. The National Arbitration Forum
- 3. CPR Institute for Dispute Resolution
- 4. Asian Domain Name Dispute Resolution Centre

C. ELEMENTS REQUIRED FOR RELIEF

To obtain relief under the ICANN Uniform Domain Name Dispute Resolution Policy, Paragraph 4(a) of the Policy requires the complainant to prove that (1) the domain name registered by the respondent is identical or confusingly similar to a trademark or service mark in which the complainant has rights; (2) the respondent has no rights or legitimate interest in the domain name; and (3) the domain name has been registered and used in bad faith.

- 1. Identical or confusingly similar
 - a. www before Complainant's mark and "s" after

"The addition of www before Complainant's mark and the addition of "s" after the mark are not sufficient to avoid confusion. Indeed, they appear to be additions designed to

take advantage of mistakes that consumers are likely to make when intending to enter Complaint's web site address." *InfoSpace.com, Inc. v. Registrar Administrator Lew Blanck*, ICAAN Case No. D2000-0069 (April 3, 2000).

b. Use of a hyphen

"The domain name <info-space.com> is identical to Complainant's INFOSPACE trademark. The addition of a hyphen and .com are not distinguishing features." *InfoSpace.com, Inc. v. Tenenbaum Ofer*, WIPO Case No. D2000-0075 (April 27, 2000).

2. Respondent's legitimate rights or interests in the domain name

Under Paragraph 4(c) of the ICANN Uniform Domain Name Dispute Resolution Policy, evidence of a registrant's rights to and legitimate interest in the domain name includes: (1) demonstrable preparations to use the domain name in connection with a bona fide offering of goods or services prior to the dispute; (2) an indication that the registrant has been commonly known by the domain name even if it has acquired no trademark rights; or (3) legitimate noncommercial or fair use of the domain name without intent to divert consumers or to tarnish the trademark.

a. Facts showing no legitimate rights

i. Respondent is not known by name

ii. Respondent has not made noncommercial or fair use of domain name

b. Facts showing legitimate rights

i. Name is descriptive

ii. Domain name includes respondent's personal name

3. Bad faith

Under Paragraph 4(b) of the ICANN Uniform Domain Name Dispute Resolution Policy, evidence of bad faith registration and use includes: (1) circumstances indicating the domain name was registered for the purpose of resale to the trademark owner or competitor for profit; (2) a pattern of conduct showing an attempt to prevent others from obtaining a domain name corresponding to their trademarks; (3) registration of the domain name for the purpose of disrupting the business of competitor; or (4) using the domain name to attempt to attract, for commercial gain, Internet users to the web site by creating a likelihood of confusion with the

complainant's mark; or (5) any other circumstance evidencing bad faith.

a. Typographical pirates

i. www before Complainant's mark and "s" after

"The addition of 'www' and 's' to Complainant's mark is best explained as a deliberate attempt to exploit user's typographical mistakes when seeking Complainant's web site" thus satisfying the bad faith requirement. *InfoSpace.com, Inc. v. Registrar Administrator Lew Blanck*, ICAAN Case No. D2000-0069 (April 3, 2000).

ii. Pornography

"Finally the Complainant has placed substantial emphasis on the damage that it will suffer as a result of the linkage of its own trade mark BIKINI ZONE and its domain name registration to a pornographic web site and indeed continues to do so despite having been requested otherwise by the Complainant. I am satisfied that this association with a pornographic web site can itself constitute a bad faith." *CCA Industries, Inc. v. Bobby R. Dailey*, ICAAN Case No. D2000-0148, (April 26, 2000).

VI. "NEW" DOMAIN NAMES AND TRADEMARKS

There is an ever increasing number of new TLDs that have been approved by the Internet Corporation of Assigned Names and Numbers (ICANN). Such TLDs include .aero, .biz, .coop, .info, .museum, .name, and .pro. Most of these newer domain names have had "sunrise" periods to give trademark owners the first opportunity to either provide notice of their rights (through the IP claim procedure of .BIZ) or to be given the first opportunity to secure the domain name (such as the .INFO sunrise registration period).