

The UDRP and Non Commercial Cyber-Squatting, Free Speech and the 'Sucks.Com" Cases

Michael D Pendleton

Professor, Chinese University of Hong Kong
Emeritus Professor, Murdoch University, Perth,
Australia

Cyber-squatting, Free Speech and the Sucks.Com Cases

The Uniform Domain Name Dispute Resolution Policy (UDRP)

- **4. Mandatory Administrative Proceeding.**
- **a. Applicable disputes.** You are required to submit to a mandatory administrative proceeding in the event that a third party (a "complainant") asserts to the applicable Provider, in compliance with the Rules of Procedure, that
 - (i) your domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and

- 4. a (ii) you have no rights or legitimate interests in respect of the domain name; and
- (iii) your domain name has been registered and is being used in bad faith.
- In the administrative proceeding, the complainant must prove that each of these three elements are present.

- **4. b. Evidence of Registration and Use in Bad Faith.** For the purposes of Paragraph 4(a)(iii), the following circumstances..... shall be evidence of the registration and use of a domain name in bad faith:
 - (i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

- 4. b (ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or
- (iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.

- **4. c. How to Demonstrate Your Rights to and Legitimate Interests in the Domain Name in Responding to a Complaint.**

Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of Paragraph 4(a)(ii):

- (i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or



- 4. c (ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Panel Decisions

- WalmartSucks.com D2000-0477

The Panel Decisions (cont)

- Estelauder.com D2000-0869

The Panel Decisions (cont)

- Asdasucks.net D2002-0857

The Panel Decisions (cont)

- Lockheedsucks.com D2000-1015

The Panel Decisions (cont)

- SDA v Klassen D2006-0255

UDRP and New Non Roman Domain Names

- The coming flood of cyber squatting disputes?
- A corresponding flood of legitimate non commercial critique websites?
- Traditional & simplified Chinese character DMs - identical or confusingly similar?

Disclaimers on the Website Not in the Domain Name

- If the disputed domain name is identical to the Complainant's name, should it always be disallowed?
- In any event domain names found by search engines which have a prominent disclaimer such as 'sucks' or 'not' or on the website are distinguishable.

UDRP Para. 4(a) i

- Confusing Similarity and Trademark Holders – the Comparison under UDRP 4(a) i
- Not Only No Similar Goods and Services But No Goods or Services at all - Just Criticism

UDRP Para. 4(a) i (cont)

- Trademark owners care little for consumer confusion. They object to misappropriation by competitors. Confusion as a test is historically problematic in IP law.
- Trademark are national rights except for the very fluid 'well known' trademark and always a matter for national law.