The Law That It Deems Applicable: ICANN, Dispute Resolution, and the Problem of Cybersquatting

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by

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Introduction

Cybersquatting has become a major issue for trademark holders and domain name holders alike. There are currently no requirements that a domain name applicant complete a search of the trademark records to determine whether the second level domain name is a registered trademark. This is the cause of many of the domain name disputes. Many domain name holders argue that the domain name is merely an address that has no legal significance or true property rights attached to it. In other words, whoever 'settled' it first has rights to use it until he or she moves on, thus letting that domain name go. In addition, domain name holders often argue that the trademark holders should have registered early on. Merely because they 'slept' through the first few years of domain name registrations they do not have the right to take away domain names properly registered by individuals who had the forethought to use the Internet. This type of activity is often seen as commercial 'bullying' by large businesses against smaller businesses or individuals.

Trademark owners, on the other hand, argue that the domain name is still a brand indicator. The name 'belongs' to them as a part of their rights granted under the trademark laws of whatever country they registered in. The use of famous marks, in particular, has caused significant problems worldwide. Often, an individual will register a famous mark for the sole purpose of selling it back to the trademark owner at an inflated price; to provide it to a competitor with the intent of harming the trademark owner; or to hold it purely to keep the trademark owner from being able to show its presence on the web with a mark with which it has been traditionally identified. This type of activity is referred to as "cybersquatting."

Various countries have re-written or created laws to protect trademark owners from "cybersquatters." Numerous court cases have tried to deal with the issues using current law. Many
commentators, however, have complained of a lack of consistency in policy for domain name holders. The end result, some claim, is the use of the courts by big businesses to bankrupt or ‘bully’ smaller businesses, which may have legitimate rights to use their domain names, out of those names (reverse cybersquatting), and registrars who transfer names without any hearing as long as evidence of a valid trademark is shown.

The Internet Corporation for Assigned Names and Numbers (ICANN) has implemented a policy by which domain name and trademark holders may dispute the other’s right to use a domain name. The Policy, thus far, is implemented by three different ICANN approved Dispute Resolution Providers. Since the first complaint filed on December 9, 1999, the three ICANN Dispute Resolution Providers have seen more than 600 cases filed. There is obviously a need for such a dispute resolution forum; the question, however, is whether the ICANN forum provides an objective inquiry into the facts for both the trademark holders, as well as the domain name registrants.


4. See ICANN, Approved Providers for Uniform Domain Name Dispute Resolution Policy (last modified Oct. 17, 2000) <http://www.icann.org/udrp/approved-providers.htm>. Please note: ICANN approved a fourth Dispute Resolution Provider after this Article had been written; for more information please see the discussion, infra, section VIII.


6. This number was correct as of May 6, 2000. See List of Proceedings Under Uniform Domain Name Dispute Resolution Policy, ICANN (last modified Nov. 21, 2000) <http://www.icann.org/udrp/proceedings-list.htm>.
This Article will try to examine some of the cases to date7 in an effort to determine whether the ICANN Policy and Rules are being used in the way, and for the purpose, they were intended to be used. Part I of this Article is a brief examination of what exactly a domain name is. Part II examines the history of the Internet and how the decision to privatize the administration of domain names was made. The recommendations made by the World Intellectual Property Organization ("WIPO") concerning the best way of handling domain name disputes is examined briefly in Part III. Part IV of the Article examines the creation of ICANN and the implementation of its Dispute Resolution process. Part V examines some of the cases that have been decided to date by the first three Providers and whether or not they have resulted in a fair hearing for both parties. Part VI examines a recent change to one of the Dispute Resolution Provider’s Supplemental Rules, which make the process much more complainant-oriented. Finally, this article will argue that while ICANN has made a formidable effort to provide fair hearings for both parties, much work remains to be done to ensure objectivity and fairness.

I

What is a Domain Name?

The Internet is a worldwide network of computers linked together for communications. It is easy to turn on one’s computer, establish a link to the Internet, and instantly be transported through the World Wide Web to sites around the globe. One can shop for goods, access businesses, retrieve newspaper articles, do research or ‘chat’ with someone next door, in France, Malaysia, South Africa, or Chile in a matter of minutes.

In order for these networks to communicate with one another, every computer linked to another has a numeric address assigned to it. This number is similar to a telephone number, and other computers use this number to route messages to it. The number, for example 123.456.789.23, is called an Internet Protocol, or IP address. These IP addresses are, due to their length, often hard to remember,

7. This Article examines the first 600 plus cases decided by the first three Dispute Resolution Providers, National Arbitration Forum, eResolution, and the World Intellectual Property Organization, from January 14, 2000 through the end of May 2000. The fourth Dispute Resolution Provider, CPR Institute for Dispute Resolution (“CPR”), did not become an ICANN-approved dispute resolution provider until after this Article had been written. For more information on CPR, as well as an update on the other three providers, please see the Author’s Note at the end of this article, infra, section VIII.
particularly as the Internet has grown and the number of computers and commercial sites linked to the Internet have also expanded.

To remedy this problem, names are assigned to the IP addresses. These addresses are called Uniform Resource Locators (URLs). The URLs are broken into several parts. For instance, if the URL is http://www.tissuefishie.com, the ‘http’ is the protocol, or the technical convention the operation of the World Wide Web is based on. ‘WWW’ indicates that the site you want to go to is on the World Wide Web.

The ‘.com’ is the top level domain, or TLD. The top level domain helps identify what the site may represent. Top level domains are currently broken up by generic top level domains (gTLD) and country code top level domains (ccTLD). The gTLDs, on the other hand, are currently administered through the Internet Corporation for Assigned Names and Numbers (ICANN). A ccTLD is administered by the individual country that sponsors it. There are currently seven gTLDs: .com (commercial); .edu (educational); .gov (US Government); .int (international organizations); .mil (military); .net (Internet service/network); and .org (nonprofit organization). Four of these gTLDs, .mil, .gov, .edu, and .int, are restricted to organizations that meet certain standards. Thus, URLs usually indicate the site is .com, .org, or .net.

The final part of the address is the second level domain. This is the part that is chosen by the user and which causes domain name disputes. A user can go to an ICANN approved registrar, type in the second level and top level domain combination she would like to register and, if it has not yet been registered, she may do so. The second level domain name can be almost anything an applicant would like, as long as it is not already in use.

The URL is sent to a Domain Name Server (DNS). DNS computers maintain tables of information linking the URL with the IP address. When the URL is accepted by the DNS, it automatically finds the IP address and sends the individual to that site. This is one of the main reasons the URL must be unique with respect to the second and top level domain combinations.

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8. For an examination of the Internet Corporation for Assigned Names and Numbers, see infra section V.

9. To see the individual regulations for each country code, a good site to visit, listing all the country codes and links to their websites, is UniNett, <http://www.uninett.no/navn/donreg.html>. The .no in this URL designates that the site is registered off of the Norway ccTLD.
II
The Road to ICANN

The Internet's origins go back to the Cold War. In 1957 the U.S.S.R. launched Sputnik. The United States responded to this in 1958 by forming an agency within the purview of the Department of Defense called the Defense Advanced Research Projects Agency (DARPA). This agency was given the task of ensuring the United States' superiority in the fields of science and technology as they applied to the military. It was DARPA that, through its computer research program, created the first computer network in 1969, giving rise to the Internet.

While DARPA is an agency within the Department of Defense, mostly academics and the RAND group created and used these early networks. The technology stayed within these circles until the late 1970s, when the commercial sector started to gain an interest in the Internet. Because of the Internet's origins, the academic traditions of open publication and ideas were integrated into the early Internet community, allowing it to become open and transparent.

Originally, to use the network, hosts were identified through the use of their numeric addresses (for example, 123.456.789.23). As the Internet began to flourish in the 1980's, hosts began to be assigned names, making it easier for people to remember and access them. However, as the networks themselves expanded, it became necessary to create a central system for identifying numeric addresses and their associated host names. This need led to the creation of the Domain Name System (DNS), which would take an entered domain name, such as www.plants.com, and match it with its corresponding numeric address, such as 123.456.789.23.

The Internet Assigned Numbers Authority (IANA), headed by

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13. See id.
Jon Postel, did much of the original management of domain names and the DNS itself. Postel created standards that one had to abide by to link to the DNS. He enforced these standards using the threat of incompatibility. However, as more and more businesses and individuals started to use the Internet it became harder to maintain the DNS and the allocation of domain names.

In 1992, the United States government granted Network Solutions, Inc. (NSI) the right to register three of the gTLDs: .com, .net, and .org. NSI registered domain names on a ‘first come, first serve’ basis. In addition, it placed no restrictions on the use of any given domain name in a class. Trademark holders, in reaction to this, began to sue NSI. NSI, in response, started suspending domain names upon proof by a trademark holder of a valid trademark. NSI did not provide a hearing of any kind.

The Internet community found itself split. Many thought NSI’s suspension of domain names went beyond its boundaries. Others thought NSI was finally correcting a fatal flaw in the domain name registration process. Jon Postel organized a group called the Internet Ad Hoc Committee (IAHC) which sought to organize the Internet through formal efforts. The IAHC, however, did not get support from big business or the National Science Foundation. This led to the ultimate defeat of many of IAHC’s proposals, such as the creation of new gTLDs.

As this expansion continued and as the growth increased in the commercial sector, concern also began to arise regarding what standards needed to be implemented. More and more domain name lawsuits were appearing in the courts. The United States Department of Commerce finally stepped in, in an attempt to halt the confusion that was growing over the use of domain names.

In January 1998, the National Telecommunications and Information Administration (NTIA), an agency of the Department of Commerce, issued a draft discussion paper entitled, A Proposal to Improve Technical Management of Internet Names and Addresses. The United States government, recognizing the increasing role of the
private sector, wanted to transfer its administrative oversight of the Internet to a new, not-for-profit corporation. On February 20, 1998, the proposed rulemaking, also known as the “Green Paper,” was published in the *Federal Register*, requesting public comment on its content.\(^6\) The Green Paper’s stated goals were to “privatize, increase competition in, and promote international participation in the domain name system.”\(^7\) However many of the comments submitted complained that the Green Paper was too focused on U.S. interests.\(^8\)

The Department of Commerce recognized the concerns of individuals, companies, and organizations that its efforts be more global in nature. In response to the public comments it received, the NTIA published its final report, *Management of Internet Names and Addresses*, or the “White Paper.”\(^9\) The White Paper addressed many of the concerns voiced by the public, particularly as they related to trademarks and domain names. A main concern was that the United States was trying to enforce U.S. trademark law on the Internet.


\(^7\) Id. at 8826.

\(^8\) See America Online, Inc., *Re: Improvement of Technical Management of Internet Names and Addresses, Proposed Rule*, Docket No. 980212036-8036-01 (Mar. 23, 1998) (visited March 9, 2000) <http://ntia.doc.gov/ntiahome/domainname/130dftmail/scanned/AOL.htm> (“In AOL’s view, it is of the utmost importance that whatever system is adopted reflect not only the intense and vested interests of the United States in the Internet, but also the important and vested interests of foreign governments, businesses, consumers, users, and others in the growth and stability of this global medium. . . . . AOL does not believe that the U.S. proposal adequately reflects the legitimate need and desire for the larger international community, including stakeholders in Europe, Asia, Africa and Latin America, to be directly involved in decisions regarding the future administration of the DNS and management of the coordinated functions of the Internet.”). See also, e.g., California SunCare, Inc., *Re: Comments on the U.S. Green Paper on Improvement of Technical Management of Internet Names and Addresses; Proposed Rule* (Mar. 23, 1998) (visited Mar. 9, 2000) <http://www.ntia.doc.gov/ntiahome/domainname/130dftmail/scanned/SunCare.htm>. (“Notwithstanding its laudatory goals, the GP’s proposal reflect (sic) a U.S.-centric and monopolistic slant. This bias is apparent in claims such as ‘the Internet is rapidly becoming an international medium for commerce, education and communication.’ The truth is the Internet is already such a medium. Until the U.S. Government and the GP recognize the worldwide character of the Internet and Internet-based commerce, they will be injuring the ability of both the U.S. and international companies to compete in the global marketplace.”); see also Paul Stanyer, *Untitled* (Mar. 15, 1998) <http://www.ntia.doc.gov/ntiahome/domainname/130dftmail/scanned/Stanyer.htm> (“I’m relaxed about the US government taking a lead on internet naming structures, but I reckon it ought to understand why we in the European Union are nervous. . . . . Until the Dept [sic] of Commerce understands the multi-cultural dimension that is growing so fast, there is a risk that the net might be divided into old-net that caters for one-language English speaking countries like the USA, and new-net that caters for the rest of us.”).

through its suggestions for the resolution of domain name disputes.\textsuperscript{20} In response, the White Paper suggested the following:

The U.S. Government will seek international support to call upon the World Intellectual Property Organization (WIPO) to initiate a balanced and transparent process, which includes the participation of trademark holders and members of the Internet community who are not trademark holders, to (1) develop recommendations for a uniform approach to resolving trademark/domain name disputes involving cyberpiracy (as opposed to conflicts between trademark holders with legitimate competing rights), (2) recommend a process for protecting famous trademarks in the generic top level domains, and (3) evaluate the effects, based on studies conducted by independent organizations, such as the National Research Council of the National Academy of Sciences, of adding new gTLDs and related dispute resolution procedures on trademark and intellectual property holders. These findings and recommendations could be submitted to the board of the new corporation for its consideration in conjunction with its development of registry and registrar policy and the creation and introduction of new gTLDs.\textsuperscript{21}

The White Paper was careful to add, however, that whatever dispute resolution mechanism is put in place by the new corporation, that mechanism should be directed toward disputes about cybersquatting and cyberpiracy and not to settling the disputes between two parties with legitimate competing interests in a particular mark. Where legitimate competing rights are concerned, disputes are rightly settled in an appropriate court.\textsuperscript{22}

Thus, the new policy statement provided for the U.S. government to enter into an agreement with a new, not-for-profit corporation, formed by the private sector, to administer policy for the Internet name and address system. The United States government would then seek international support for, and coordinate the transfer of, the DNS system and administration of gTLDs to this corporation.\textsuperscript{23} In addition, the White Paper asked the WIPO to “convene an international process including individuals from the private sector and government to develop a set of recommendations for trademark/domain name dispute resolutions and other issues to be presented to the Interim Board for its consideration” during the transition.\textsuperscript{24}

\begin{itemize}
\item \textsuperscript{20} See id. at 31,746-747.
\item \textsuperscript{21} Id. at 31,747.
\item \textsuperscript{22} Id.
\item \textsuperscript{23} See id. at 31,749.
\item \textsuperscript{24} Id. at 31,751.
\end{itemize}
III
WIPO

The World Intellectual Property Organization responded to the United States' request and published its first Request for Comments (RFC-1) on July 8, 1998.25 RFC-1 posed several questions regarding what should be included in WIPO's suggestions to the new corporation overseeing gTLDs. These included available recommendations concerning a uniform approach to resolving domain name disputes, the process of protecting famous marks in gTLDs, and whether new gTLDs should be implemented.26 While many of the initial comments submitted applauded WIPO's attempts at tackling the domain name problem, many were concerned that the interests of big business and clashes between national laws would overcome the openness of the Internet.27


26. See id.

27. See WIPO RFC 1: Comments of Dr. Milton Mueller, WIPO RFC-1 <http://wipo2.wipo.int/dnscomments/0057.html> (accessed Aug. 24, 1998) (expressing concern that uniform approach would be antithetical to Internet culture). Dr. Mueller reflected many of the concerns found in the comments submitted by writing:

A uniform approach is advocated by large corporations with significant brand and trademark holdings because it reduces the cost of challenging domain names . . . . Such uniformity and speed might be desirable if the entire world had already agreed upon a single set of criteria for resolving domain name-trademark interactions. It has not come to such an agreement, however. This fact is incontrovertible. Some systems of law privilege freedom of expression over commercial intellectual property while others do not even recognize a right to free expression. Some jurisdictions may recognize common law rights to domain name use while others have no common law tradition at all. If WIPO wants uniformity, it must begin with the harmonization of law across nations, and work from there to link administrative processes such as domain name registration to the accepted law. The process cannot move in the opposite direction. . . . In the absence of any real uniformity in the legal principles used to resolve disputes, the only accomplishment of mandating uniformity at the registry level will be to make it exceptionally easy for trademark holders to challenge domain names. And this is precisely what many Internet users fear about a centralized, uniform process: trademark holders will use it to assert property rights in character strings that resemble or conform to their trademarks, regardless of whether any actual infringement is taking place. It sets up a process that is intrinsically biased toward parties with a trademark. . . . This is unacceptable to any advocate of a broad, open Internet.

Id. See also, e.g., Comments of Erik Nilsson, WIPO RFC-1 (Aug. 24, 1998) <http://wipo2.wipo.int/dns_comments/0054.html> (“Creating this role for domain names turns the domain-name dispute mechanism into an odd kind of world judiciary with no
WIPO addressed these concerns in its next two Requests for Comments (RFC-2\textsuperscript{28} and RFC-3\textsuperscript{29}). In RFC-2, WIPO formed many of the concerns voiced in the first comment period into policy questions and invited the public to comment on them again. In RFC-3, WIPO forwarded a much more complete, lengthy document outlining the process and the desired goals it would recommend in its Final Report. Again, numerous comments were submitted to WIPO regarding these RFCs. This time, however, many of the comments were more positive toward the findings as a whole.\textsuperscript{30} On April 30, 1999, WIPO released the final report of the WIPO Internet Domain Name Process (“Final Report”).\textsuperscript{31}

The Final Report is fairly straightforward, although lengthy in its recommendations. First, the recommendations state that the process cannot deny parties access to court litigation.\textsuperscript{32} It is interesting to note that “virtually all commentators” supported this recommendation.\textsuperscript{33} Next, the Final Report recommends that a domain name applicant should submit to the jurisdiction of both the country of domicile of the domain name applicant, as well as the country where the registrar is located, in the case of non-dispute resolution proceedings.\textsuperscript{34}

The Report then goes on to discuss alternative dispute resolution procedures that should be adopted for all open gTLDs. There are several guiding principles that are identified in the report. First, the judicial principles other than the sanctity of intellectual property.”); Comments on Behalf of Federation Internationale Des Conseils en Propriete Industrielle Regarding WIPO RFC-1, WIPO RFC-1 (Aug. 24, 1998) <http://wipo2.wipo.int/dns_comments/0059.html> and <http://wipo2.wipo.int/dns_attachments/attach904059308.doc> (“[T]here should be some balance between allowing a person with a bona fide right to challenge a name to do so, and allowing a registrant to feel secure once their name is registered.”).

30. See, e.g., Joint Reply of the European Community and Its Member States to the Request for Comments on Issues Addressed in the WIPO Internet Domain Name Process, WIPO RFC-2 (Nov. 3, 1998) <http://wipo2.wipo.int/dns_comments/rfc2/0018.html> (“The European Community and its Member States believe it to be desirable to develop approaches, other than court litigation, for the resolution of domain name disputes involving intellectual property rights. Such approaches should include various forms of administrative procedures, mediation and arbitration. Of course, the establishment of such mechanisms does not foreclose the recourse to traditional litigation procedures and should be conceived as alternatives to them.”).
32. See id. at ¶ 140.
33. Id. at ¶ 139.
34. See id. at ¶ 147.
procedure should be quick and cost little compared to formal legal action. It should allow both sides to be heard and should ensure procedural fairness, and it should be uniform and consistent for all gTLDs, lest one particular gTLD becomes a "haven for abusive registrations." The procedures should not have the same weight that traditional binding precedence has had, but rather the individual panel should decide how much credence to give previous decisions.

The remedies in these cases should be restricted to the status of the domain name itself, rather than awarding monetary damages or rulings concerning the trademarks themselves. In addition, the registrars should enforce these determinations in an expeditious manner, though the registrars should not be involved in the administrative decision making process itself. Finally, however, these administrative decisions are secondary to decisions from any court of competent jurisdiction "in a country that is party to the Paris Convention for the Protection of Industrial Property or bound by the Agreement on Trade-Related Aspects of Intellectual Property Rights . . . ."

As for the question of when these procedures take place, the Final Report suggests that a policy making a uniform administrative dispute resolution procedure should be adopted for all gTLDs, and that domain name applicants should be required to submit to these procedures upon registration. The scope of these procedures, however, should be limited to abusive registrations. The report states that:

35. See id. at ¶ 150(i).
36. See id. at ¶ 150(ii).
37. Id. at ¶ 150 (iii).
38. See id. at ¶ 150(v).
39. See id. at ¶ 150(vi).
40. See id. at ¶ 150(vii).
41. See id. at ¶ 150(viii).
42. Id. at ¶ 150(ix) (emphasis added).
43. See Final Report, supra note 31, ¶¶ 154-162.
44. See id. at ¶ 169. "Abusive registrations" are defined as:

(1) The registration of a domain name shall be considered to be abusive when all of the following conditions are met:
   (i) the domain name is identical or misleadingly similar to a trade or service mark in which the complainant has rights; and
   (ii) the holder of the domain name has no rights or legitimate interests in respect of the domain name; and
   (iii) the domain name has been registered and is used in bad faith.

(2) For the purposes of paragraph (1)(iii), the following, in particular, shall be evidence of the registration and use of a domain name in bad faith:
In applying the definition of abusive registration given above in the administrative procedure, the panel of decision-makers appointed in the procedure shall, to the extent necessary, make reference to the law or rules of law that it determines to be applicable in view of the circumstances of the case. Thus, for example, if the parties were resident in one country, the domain name was registered through a registrar in that country and the evidence of the bad faith registration and use of the domain name related to activity in the same country, it would be appropriate for the decision-maker to refer to the law of the country concerned in applying the definition.\footnote{Id. at ¶ 176.}

The Final Report recommends that this policy be incorporated into the final dispute resolution policy adopted by the corporation that will have oversight of these proceedings. Finally, the Final Report recommends that the available remedies be limited to the cancellation or transfer of the domain name and allocation of responsibility for payment of the proceedings.\footnote{See id. at ¶ 187.}

To ensure that the proceedings are fair and expeditious for both parties, the panel appointed should combine all claims by a party that relate to the same domain name holder. In addition, the Final Report recommends that determinations should be made within 45 days after an action is brought, but that claims should not be subject to a time bar.\footnote{See id. at ¶ 197-203.} The Final Report also contains recommendations as to the number of panelists to be appointed, 3,\footnote{See id. at ¶ 207.} the use of electronic filing,\footnote{See id. at ¶ 214.} coordination with registrars,\footnote{See id. at ¶ 220.} costs,\footnote{See id. at ¶ 214.} and the availability of voluntary

\begin{itemize}
\item[(a)] an offer to sell, rent or otherwise transfer the domain name to the owner of the trade or service mark, or to a competitor of the owner of the trade or service mark, for valuable consideration; or
\item[(b)] an attempt to attract, for financial gain, Internet users to the domain name holder's website or other on-line location, by creating confusion with the trade or service mark of the complainant; or
\item[(c)] the registration of the domain name in order to prevent the owner of the trade or service mark from reflecting the mark in a corresponding domain name, provided that a pattern of such conduct has been established on the part of the domain name holder; or
\item[(d)] the registration of the domain name in order to disrupt the business of a competitor.
\end{itemize}
mediation.\textsuperscript{52} Finally, the Final Report recommends against establishing a centralized appellate system.\textsuperscript{53}

IV

ICANN

On November 25, 1998, the Department of Commerce entered into an agreement with a not-for-profit corporation, the Internet Corporation for Assigned Names and Numbers (ICANN), for the management of domain names.\textsuperscript{54} This agreement outlines the basic responsibilities and requirements of both ICANN and the Department of Commerce during and after the transition of the DNS. One of ICANN’s responsibilities is collaboration on a process that may lead to the expansion of gTLDs, including the development of a dispute resolution policy.\textsuperscript{55} This policy is to take into account the recommendations made by the World Intellectual Property Organization, as well as the White Paper.\textsuperscript{56}

In addition, ICANN’s membership structure must provide for openness and diversity.\textsuperscript{57} ICANN is comprised of four organizational units. Three of the units are “Supporting Organizations,” designed to provide mechanisms that allow businesses to participate in the development of ICANN’s policies.\textsuperscript{58} The fourth unit is an at-large membership made up of individuals from around the world,\textsuperscript{59} with a minimum size of five thousand.\textsuperscript{60} This at-large membership will select

\begin{itemize}
\item \textsuperscript{51} See id. at ¶ 227.
\item \textsuperscript{52} See id. at ¶¶ 229-243.
\item \textsuperscript{53} See id. at ¶¶ 221-222.
\item \textsuperscript{54} See Memorandum of Understanding Between the U.S. Department of Commerce and Internet Corporation for Assigned Names and Numbers, ICANN <http://www.ntia.doc.gov/ntiahome/domainname/icann-memorandum.htm>. (accessed Nov. 25, 1998)
\item \textsuperscript{55} See id. at V(C)(9)(d).
\item \textsuperscript{56} See id.
\item \textsuperscript{57} See id. at V(C)(8).
\item \textsuperscript{58} See Frequently Asked Questions, ICANN (posted Sept. 13, 1999) <http://www.icann.org/general/faq1.htm>.
\item \textsuperscript{59} See id. The only requirements are that the individual fill out an application form, have a valid e-mail account, and provide a single physical residence accessible by a postal mail address.
\item \textsuperscript{60} See id.
\end{itemize}
an "At Large Council" composed of up to eighteen members. Ten of these members will be selected from the five geographic regions into which ICANN is divided, no two of whom can come from the same country.\textsuperscript{61} The Council will then select nine individuals to become "At Large Directors" of ICANN. There are no geographic restrictions placed on these Directors. All of ICANN’s meetings and policies are required to be public and transparent.

Also among ICANN’s responsibilities is the development and implementation of a dispute resolution forum to address the issue of "cybersquatting." On August 24, 1999, ICANN adopted a draft of implementation language to address, among other issues, "cybersquatting" and "reverse domain name hijacking." ICANN developed several drafts of a Policy and Rules, using the White Paper and WIPO’s Final Report as guidelines.\textsuperscript{62} Finally, on October 24, 1999, ICANN adopted the Policy and the Rules.

The \textit{Rules for Uniform Domain Name Dispute Resolution Policy} ("Rules")\textsuperscript{63} govern the administrative proceedings for the resolution of disputes carried out under the \textit{Uniform Domain Name Dispute Resolution Policy} ("Policy").\textsuperscript{64} In addition to these Rules, each Dispute Resolution Provider, approved by ICANN, may add Supplemental Rules that participants and panel members must abide by. The ICANN Rules provide: definitions of the most commonly used terms;\textsuperscript{65} instructions on how the Panels, Providers, and parties should communicate with each other; what needs to be included in the Complaint; how notification will be delivered to the Respondent and what should be included in the Response; how a Panel is appointed and the time-frame in which it must be selected; a list of instructions for the Panel, including the need for impartiality; a fee policy; and a section absolving ICANN, the Providers, and the

\begin{footnotes}
\item[61.] See id.
\item[64.] Uniform Domain Name Dispute Resolution Policy, ICANN (Oct. 24, 1999) <http://www.icann.org/udrp/udrp-policy-24oct99.htm> (also commonly known as the ‘UDRP’).
\item[65.] See Rules, supra note 63, at § 1 (defining Complainant; ICANN; Mutual Jurisdiction; Panel; Panelist; Party; Policy; Provider; Registrar; Registration Agreement; Respondent; Reverse Domain Name Hijacking; Supplemental Rules).
\end{footnotes}
Panelists from liability.

The Administrative Proceedings called for under ICANN's Policy are mainly for abusive registrations, such as cybersquatting. The Uniform Domain Name Dispute Resolution Policy sets forth the types of disputes for which a Respondent is required to submit to a 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

(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 is present.66

The Policy provides some guidelines as to what “use in bad faith” may mean:

b. Evidence of Registration and Use in Bad Faith. For the purposes of Paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, 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

(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.67

66. Policy, supra note 64, at ¶ 4(a) (emphasis added).
67. Id. at ¶ 4(b).
If a party believes it can prove that each of the three elements listed above is present, the first step is to file a complaint. Any person or entity may initiate an administrative proceeding by filing a complaint with an approved ICANN Dispute Resolution Service Provider. The complaint must be submitted in hard copy and electronic form and:

(i) Request that the complaint be submitted for decision in accordance with the Policy and these Rules;

(ii) Provide the name, postal and e-mail addresses, and the telephone and telefax numbers of the Complainant and of any representative authorized to act for the Complainant in the administrative proceeding;

(iii) Specify a preferred method for communications directed to the Complainant in the administrative proceeding (including person to be contacted, medium, and address information) for each of (A) electronic-only material and (B) material including hard copy;

(iv) Designate whether Complainant elects to have the dispute decided by a single-member or a three-member Panel and, in the event Complainant elects a three-member Panel, provide the names and contact details of three candidates to serve as one of the Panelists (these candidates may be drawn from any ICANN-approved Provider's list of panelists);

(v) Provide the name of the Respondent (domain-name holder) and all information (including any postal and e-mail addresses and telephone and telefax numbers) known to Complainant regarding how to contact Respondent or any representative of Respondent, including contact information based on pre-complaint dealings, in sufficient detail to allow the Provider to send the complaint as described in Paragraph 2(a);

(vi) Specify the domain name(s) that is/are the subject of the complaint;

(vii) Identify the Registrar(s) with whom the domain name(s) is/are registered at the time the complaint is filed;

(viii) Specify the trademark(s) or service mark(s) on which the complaint is based and, for each mark, describe the goods or services, if any, with which the mark is used (Complainant may also separately describe other goods and services with which it intends, at the time the complaint is submitted, to use the mark in the future.);

(ix) Describe, in accordance with the Policy, the grounds on which the complaint is made including, in particular,

(1) the manner in which the domain name(s) is/are identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

(2) why the Respondent (domain-name holder) should be considered as having no rights or legitimate interests in respect of the domain name(s) that is/are the subject of the complaint; and

(3) why the domain name(s) should be considered as having
been registered and being used in bad faith (The description should, for elements (2) and (3), discuss any aspects of Paragraphs 4(b) and 4(c) of the Policy that are applicable. The description shall comply with any word or page limit set forth in the Provider’s Supplemental Rules.);

(x) Specify, in accordance with the Policy, the remedies sought;

(xi) Identify any other legal proceedings that have been commenced or terminated in connection with or relating to any of the domain name(s) that are the subject of the complaint;

(xii) State that a copy of the complaint, together with the cover sheet as prescribed by the Provider's Supplemental Rules, has been sent or transmitted to the Respondent (domain-name holder), in accordance with Paragraph 2(b);

(xiii) State that Complainant will submit, with respect to any challenges to a decision in the administrative proceeding canceling or transferring the domain name, to the jurisdiction of the courts in at least one specified Mutual Jurisdiction;

(xiv) Conclude with the following statement followed by the signature of the Complainant or its authorized representative:

“Complainant agrees that its claims and remedies concerning the registration of the domain name, the dispute, or the dispute’s resolution shall be solely against the domain-name holder and waives all such claims and remedies against (a) the dispute-resolution provider and panelists, except in the case of deliberate wrongdoing, (b) the registrar, (c) the registry administrator, and (d) the Internet Corporation for Assigned Names and Numbers, as well as their directors, officers, employees, and agents.”

“Complainant certifies that the information contained in this Complaint is to the best of Complainant’s knowledge complete and accurate, that this Complaint is not being presented for any improper purpose, such as to harass, and that the assertions in this Complaint are warranted under these Rules and under applicable law, as it now exists or as it may be extended by a good-faith and reasonable argument.”; and

(xv) Annex any documentary or other evidence, including a copy of the Policy applicable to the domain name(s) in dispute and any trademark or service mark registration upon which the complaint relies, together with a schedule indexing such evidence.

Upon filing the complaint, the Provider will review the complaint for compliance with the Policy and Rules and will forward the complaint to the respondent within three days following receipt of the fees to be paid by the complainant. If the complaint does not comply, the Provider will notify both the complainant and the respondent as to the nature of the deficiencies. The complainant will

68. Rules, supra note 63, at ¶ 3(b).
69. See id. at ¶ 4(a).
have five days to repair the deficiencies, or the administrative proceeding is withdrawn without prejudice.\textsuperscript{70} The administrative proceeding commences from the date the Provider sends the complaint by post to all addresses shown in the domain name’s registration data for the registered domain name holder; by sending the complaint in electronic form by e-mail to the registered domain name holder; and by sending the complaint to any address the respondent has notified the Provider it prefers.

The respondent has twenty days from the date of commencement of the administrative proceeding to file a response to the complaint.\textsuperscript{71} Again, the response must be submitted in hard copy and electronic form, and must set forth the following:

(i) Respond specifically to the statements and allegations contained in the complaint and include any and all bases for the Respondent (domain-name holder) to retain registration and use of the disputed domain name (This portion of the response shall comply with any word or page limit set forth in the Provider’s Supplemental Rules.);

(ii) Provide the name, postal and e-mail addresses, and the telephone and telefax numbers of the Respondent (domain-name holder) and of any representative authorized to act for the Respondent in the administrative proceeding;

(iii) Specify a preferred method for communications directed to the Respondent in the administrative proceeding (including person to be contacted, medium, and address information) for each of (A) electronic-only material and (B) material including hard copy;

(iv) If Complainant has elected a single-member panel in the Complaint (see Paragraph 3(b)(iv)), state whether Respondent elects instead to have the dispute decided by a three-member panel;

(v) If either Complainant or Respondent elects a three-member Panel, provide the names and contact details of three candidates to serve as one of the Panelists (these candidates may be drawn from any ICANN-approved Provider’s list of panelists);

(vi) Identify any other legal proceedings that have been commenced or terminated in connection with or relating to any of the domain name(s) that are the subject of the complaint;

(vii) State that a copy of the response has been sent or transmitted to the Complainant, in accordance with Paragraph 2(b); and

(viii) Conclude with the following statement followed by the signature of the Respondent or its authorized representative:

"Respondent certifies that the information contained in this Response is to the best of Respondent’s knowledge complete and accurate, that this Response is not being presented for any

\textsuperscript{70} See id. at ¶ 4(b).

\textsuperscript{71} See id. at ¶ 5(a).
improper purpose, such as to harass, and that the assertions in this Response are warranted under these Rules and under applicable law, as it now exists or as it may be extended by a good-faith and reasonable argument."; and

(ix) Annex any documentary or other evidence upon which the Respondent relies, together with a schedule indexing such documents.\textsuperscript{32}

If the respondent does not submit a response, the Panel will decide the dispute based solely upon the complaint.

In responding to the complaint, respondent can rebut the complainant's allegations by convincing the Panel that he or she has a right or legitimate interest to the domain name. The respondent can demonstrate this by showing:

(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

(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.\textsuperscript{73}

It is important to remember, however, that the burden is on the Complainant to show first that the Respondent has no right or legitimate interest in the domain name.\textsuperscript{74} Only after Complainant has proven this must a Respondent resort to showing the above.

Once the complaint and Response have been submitted, a Panel is appointed to hear the dispute. If neither Complainant nor Respondent has elected a three-member Panel, the Provider has five days from receipt of the response (or the lapse of the time period for submitting a Response) to appoint a single Panelist.\textsuperscript{75} The fees for the Panelist are to be paid by the Complainant. Where a three-member Panel has been requested, the Provider will appoint the Panelists. The Complainant will pay the fees for the three-member Panel, unless the Respondent elected the three-member Panel, in which case both parties will share the fees.\textsuperscript{76} Once the Panel is appointed, the parties are notified by the Provider who was appointed, and of the date by

\textsuperscript{72} Id. at ¶ 5(b).
\textsuperscript{73} Policy, supra note 64, at ¶ 4(c).
\textsuperscript{74} See id. at ¶ 4(a)(ii).
\textsuperscript{75} See Rules, supra note 64, at ¶ 6(b).
\textsuperscript{76} See id. at ¶ 6(c).
which the Panel will forward its decision on the complaint to the Provider.

The Panel has the following general powers in weighing the evidence submitted by the parties:

(a) The Panel shall conduct the administrative proceeding in such manner as it considers appropriate in accordance with the Policy and these Rules.

(b) In all cases, the Panel shall ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case.

(c) The Panel shall ensure that the administrative proceeding takes place with due expedition. It may, at the request of a Party or on its own motion, extend, in exceptional cases, a period of time fixed by these Rules or by the Panel.

(d) The Panel shall determine the admissibility, relevance, materiality and weight of the evidence.

(e) A Panel shall decide a request by a Party to consolidate multiple domain name disputes in accordance with the Policy and these Rules.\(^7\)

The Panel must be impartial and independent and will have disclosed to the Provider anything that will give rise to doubt as to the impartiality of a member before accepting the appointment.\(^7^6\)

The Panel may request further statements or documents from the parties. There is to be no in-person hearing, however, unless the Panel determines that such a hearing is absolutely necessary for deciding the complaint.\(^7^9\) The Panel’s decision must be based on the “statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.”\(^8^0\)

If the Panel has three members, a majority will determine the decision. The Panel will forward its decision, in writing, to the Provider within fourteen days of its appointment (barring exceptional circumstances).\(^8^1\) The final decision must provide the reasons on which it is based and include the names of the Panelists. Dissenting opinions, if there are any, will accompany majority decisions.

The Provider must forward the full text of the decision to each party, the concerned Registrar, and ICANN within three days after receiving it from the Panel. The Registrar must immediately inform

77. Id. at ¶ 10.
78. See id. at ¶ 7.
79. See id. at ¶ 11(b).
80. Id. at ¶ 15(a) (emphasis added).
81. See id. at ¶ 15(b).
each party, the provider, and ICANN of the date for implementation of the decision. 82

Either party may submit the dispute to a court in the relevant jurisdiction for independent resolution before or after the mandatory administrative proceeding is commenced or concluded. If the proceeding has concluded and a decision has been reached, ICANN waits ten business days after being informed of the decision by the applicable Provider before implementing the decision. 83 If, within the ten days, ICANN has received documentation ("such as a copy of a complaint, file-stamped by the clerk of the court") 84 that a lawsuit has been commenced, it will not implement the Administrative Panel's decision and will take no action until ICANN receives:

(i) evidence satisfactory to us of a resolution between the parties;
(ii) evidence satisfactory to us that your lawsuit has been dismissed or withdrawn; or
(iii) a copy of an order from such court dismissing your lawsuit or ordering that you do not have the right to continue to use your domain name. 85

If it receives no documentation within the specified time period, ICANN will implement the Panel's decision.

A. Dispute Resolution Service Providers

ICANN must approve all dispute resolution service providers. To be selected as a dispute resolution service provider, one must become familiar with the Policy and the Rules, and submit an application. The application should include: any information concerning applicant's background and experience in providing alternative dispute resolution services, including descriptions of clerical aspects of expediting proceedings; a list of qualified panelists the applicant will include, as well as a description of its screening requirements; description of training and educational requirements that will be employed as they relate to the Policy and Rules; a promise not to interfere with a panelist's decision to serve on a panel with another provider; a copy of the proposed supplemental rules; internal operating procedures; a proposed implementation schedule; a statement of any limitations on the number of cases the applicant

82. See id. at ¶ 16(a).
83. See Policy, supra note 64 at ¶ 4(k).
84. Id.
85. Id.
will handle; a description of how the proceedings will be administered; and a description of how the cases will be published.\textsuperscript{86} ICANN will then examine the application, looking for evidence that the applicant has demonstrated its ability to hear cases in a fair, global, orderly, and expeditious manner. In particular, ICANN is seeking a “track record in competently handling the clerical aspects of ADR proceedings;”\textsuperscript{87} a list of “highly qualified neutrals who have agreed to serve as panelists;”\textsuperscript{88} and evidence that the applicant’s “supplemental rules and internal procedures demonstrate that applicant understands the workings of the policy and uniform rules.”\textsuperscript{89} To date, ICANN has approved four different dispute resolution providers: the World Intellectual Property Organization Arbitration and Mediation Center (WIPO/AMC); the Disputes.org/eResolution Consortium; and the National Arbitration Forum (NAF). The CPR Institute for Dispute Resolution was added to the list in May 2000.

1. \textit{WIPO}

a. Supplemental Rules

The WIPO/AMC Supplemental Rules include very few changes to ICANN’s Rules.\textsuperscript{90} First, the Supplemental Rules adopt all definitions set forth in the Rules. The Supplemental Rules do, however, provide for cases to be filed through the Center’s “Internet-

\begin{footnotesize}
\begin{enumerate}
\item \textsuperscript{86} See \textit{Information Concerning Approval Process for Dispute-Resolution Service Providers}, ICANN (last modified May 6, 2000) \texttt{<http://www.icann.org/udrp/udrp-provider-approval-process.htm>}.\textsuperscript{86}
\item \textsuperscript{87} \textit{Id.}\textsuperscript{87}
\item ICANN considers proper review of pleadings for administrative compliance and reliable and well-documented distribution of documents to the parties and panels to be essential capabilities for providers. In the absence of a well-established track record in handling the clerical function, a detailed plan for providing those abilities ordinarily must be submitted.\textsuperscript{87}
\item \textsuperscript{88} \textit{Id.}\textsuperscript{88}
\item [An] Applicant’s list should include at least twenty persons. Applicants are expected thoroughly to train the listed neutrals concerning the policy, the uniform rules, the technology of domain names, and the basic legal principles applicable to domain-name disputes. Accordingly, excessively long lists of neutrals are discouraged. The applicant should either present a list of panelists from multiple countries or, if the applicant initially presents a single-country list, propose a plan to expand its list to become multinational.\textsuperscript{88}
\item \textsuperscript{89} \textit{Id.}\textsuperscript{89}
\item \textsuperscript{90} See \textit{World Intellectual Property Organization Supplemental Rules for Uniform Domain Name Dispute Resolution Policy}, WIPO/AMC (Dec. 1, 1999) (available at \texttt{<http://arbiter.wipo.int/domains/rules/supplemental.html>}).\textsuperscript{90}
\end{enumerate}
\end{footnotesize}
based case filing and administration system." Both the Complainant and the Respondent are subject to a word limit. In addition, if a complaint is rejected for lack of compliance, and the Complainant was unable to conform the complaint within five days, the Center will refund the fee paid by the Complainant unless he/she indicates that the complaint will be re-submitted to the Center.

In addition, the Center provides the Parties with the name and contact information of a member of its staff who will act as the Case Administrator. This person has no authority to decide substantive matters, but will be responsible for administrative matters relating to the dispute and communications with the Panel. As for the Panel, the Supplemental Rules provide that the Presiding Panelist, when a three-Panel group is requested, will be the panelist chosen by the Center, or the third Panelist. Finally, each Panelist will be required to submit a "Declaration of Independence and Impartiality" to the Center prior to appointment.

b. Panelists

WIPO/AMC currently claims ninety-five panelists. These Panelists have varying backgrounds. However, most tend to be law professors and attorneys. The Center, out of the three providers, is by far the most global in nature. By way of example, in March of 2000 the panelists' geographical diversity broke down as follows: North America (33); South America (8); Central America (0); Europe (40); Middle East (5); Africa (2); Asia (8); and Australia/New Zealand (7). The biographies of the panelists are available on WIPO/AMC's website.

c. Fees

The Center sets forth fees based on the type of Panel (single Panelist v. three Panelists), and the number of domain names.

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91. Id. at ¶ 3(iii).
92. See id. at ¶ 10(a), (b).
93. See id. at ¶ 5(c).
94. See id. at ¶ 6(a),(b).
95. See id. at ¶ 7(b).
96. See id. at ¶ 8.
97. See WIPO Domain Name Panelists, WIPO/AMC (Mar. 28, 2000) <http://arbiter.wipo.int/domains/panel/panelists.html>. Note that the composition of the panel changes continuously.
98. See id.
included in the complaint. The fees are broken down, in U.S. dollars, as follows:

One to five domain names
  Single Panelist: $1000 [Panelist: $750; Center: $250]
  Three Panelists: $2500 [Presiding panelist: $800; Co-Panelist: $650; Center $400]

Six to ten domain names
  Single Panelist: $1500 [Panelist: $1250; Center: $250]
  Three Panelists: $3500 [Presiding panelist: $1200; Co-Panelist: $950; Center $400]

More than ten
  Single Panelist: To be decided in consultation with the WIPO/AMC
  Three Panelists: To be decided in consultation with the WIPO/AMC

The WIPO/AMC accepted its first filing on December 9, 1999.100 The Center was the first approved Dispute-Resolution Service Provider and has been accepting and hearing cases longer than either of the other providers. As of September 2000, more than 1200 cases had been filed with WIPO/AMC, and almost 600 have been decided.101

2. eResolution

a. Supplemental Rules

   eResolution's Supplemental Rules include twenty-one definitions.102 These include the definitions set out in the Rules, as well as adding a number of additional definitions. None of the definitions, however, significantly changes the process or procedures. They simply act to clarify certain terms. As with WIPO/AMC, if the complaint does not conform to the Rules, and Complainant does not

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correct the complaint in the proper time limit, the fee is returned, minus the administration fee and a "conformity evaluation fee." 103

When either party requests that the case be heard by three panelists, the presiding panelist will be determined by the Clerk's office. 104 The "President of the Panel" can, however, be any of the three panelists, including the one selected by Complainant or Respondent. The Panelist does not need to provide a written statement of impartiality, but does need to inform the Clerk's office of any circumstances or facts that may impair the Panelist's ability to hear the case. 105 In addition, the Supplemental Rules provide guidance for panelists who need to be replaced 106 or recuse themselves. 107

Finally, the Supplemental Rules provide a list of powers of the Panel. These are:

1. The Panel may rule on any question raised by a Party, including the interpretation of the Regulation.
2. An objection must be raised as early as possible and, at the latest, at the time the Response to the Complaint is filed.
3. The Panel may rule on any objection as a preliminary issue, or it may decide to continue the arbitration and rule on such an objection in its final decision. 108

The Supplemental Rules also set forth what to do if a Party attempts to influence a decision. 109 The Party will be deemed to have abandoned the proceeding and forfeited his fee (if Complainant), and to have accepted unconditionally the remedies sought by Complainant (if Respondent). He or she will be barred from introducing another complaint concerning the domain name in question, and the Panel will publish its finding that one of the Parties has tried to influence the outcome. 110

b. Panelists

eResolution currently claims more than eighty panelists. Like WIPO's Panelists, they range in their backgrounds, but most are law professors or attorneys. 111 The Center, not quite as global in its

103. See id. at ¶ 6(d)(i)(2)(c).
104. See id. at ¶ 13.
105. See id. at ¶ 9.
106. See id. at ¶ 11.
107. See id. at ¶ 10.
109. See id. at ¶ 18.
110. See id.
111. See List of Arbitrators (as of Mar. 28, 2000) <http://www.eresolution.ca/services/
representation as WIPO/AMC, does have a selection of Panelists from several geographic regions. In March 2000, for example, the Panelists’ geographical diversity broke down as follows: North America (37); South America (0); Central America (0); Europe (9); Middle East (1); Africa (0); Asia (1); and Australia/New Zealand (0). The biographies of some of the panelists are available on eResolution’s website.

c. Fees

eResolution sets forth fees based on the type of Panel (single Panelist v. three Panelists), and the number of domain names included in the Complaint. The fees are broken down, in U.S. dollars, as follows:

One to two domain names
- Single Panelist: $750 [Panelist: $525; Center: $225]
- Three Panelists: $2200 [Panelists: $1850; Center $350]

Three to five domain names
- Single Panelist: $900 [Panelist: $675; Center: $225]
- Three Panelists: $2300 [Panelists: $1950; Center $350]

Six to Nine domain names
- Single Panelist: $1300 [Panelist: $1075; Center $225]
- Three Panelists: $3200 [Panelists: $2850; Center $350]

Ten to twelve domain names
- Single Panelist: $1500 [Panelist: $1275; Center $225]
- Three Panelists: $3500 [Panelists: $3100; Center $400]

Thirteen domain names or more
- Single Panelist: To be discussed with the Clerk’s office
- Three Panelists: To be discussed with the Clerk’s office.

In addition, eResolution charges fees for communications preferences: for e-mail and eResolution’s secure site there is no fee; for e-mail, eResolution’s secure site, and regular postal service, the fee is $75; for e-mail, eResolution secure’s site, facsimile/fax, the fee is $100; and for e-mail, eResolution’s secure site and courier service, the fee is $250.

112. See id.
113. See id.
115. See id.
d. Pending Decisions

eResolution accepted its first filing on January 21, 2000.\textsuperscript{116} Between January 21, 2000 and the middle of May 2000, 58 cases were filed with eResolution.\textsuperscript{117} Of this number, one was terminated; none were suspended; forty-seven are pending decision; one was settled; and nine were decided.

3. National Arbitration Forum

a. Supplemental Rules

Like the WIPO/AMC, the National Arbitration Forum (NAF) has adopted the definitions set forth in the Rules without supplementing them. The Supplemental Rules do mandate that all communications must be directed to the NAF itself, and not the individual panelists.\textsuperscript{118} The Supplemental Rules do set forth page limits for both Complainant\textsuperscript{119} and Respondent,\textsuperscript{120} but not for the Panelists.\textsuperscript{121}

The Panelists must take an oath to be neutral and independent. In addition, the Supplemental Rules set forth circumstances under which a Panelist may be disqualified.\textsuperscript{122} Finally, a case coordinator is assigned to the parties. All communications between the Parties and Panelists must go through the case coordinator rather than directly between Panelists and parties.\textsuperscript{123}

b. Panelists

NAF has a total of sixty-one panelists.\textsuperscript{124} The Center, out of the three providers, is by far the least global in nature. All of the panelists are from the United States.\textsuperscript{125} The biographies of the panelists are available on NAF's website.

\textsuperscript{116} See Domain Name Arbitration Decisions, Case No. AF-0076a, eResolution Panel Decision (Pending) \textlangle\textit{http://www.eresolution.ca/services/dnd/decisions.htm}\textrangle.

\textsuperscript{117} See id.

\textsuperscript{118} See The Forum’s Supplemental Rules to ICANN’s Uniform Domain Name Dispute Resolution Policy, ¶ 3 (Apr. 27, 2000) \textlangle\textit{http://www.arbforum.com/domains/domain-rules.html}\textrangle.

\textsuperscript{119} See id. at ¶ 4(a).

\textsuperscript{120} See id. at ¶ 5(a).

\textsuperscript{121} See id. at ¶ 9.

\textsuperscript{122} See id. at ¶ 7(b).

\textsuperscript{123} See id. at ¶ 8.


\textsuperscript{125} See id.
c. Fees

The Center sets forth fees based on the type of Panel (single Panelist v. three Panelists), and the number of domain names included in the complaint. The fees are broken down, in U.S. dollars, as follows:

One domain name
- Single Panelist: $750
- Three Panelists: $2250

Two domain names
- Single Panelist: $1000
- Three Panelists: $3000

Three or more domain names
- Single Panelist: $1250
- Three Panelists: $3750

126.

d. Pending Decisions

The NAF accepted its first filing on January 11, 2000. Since then, 225 cases have been filed with NAF. Of these, fourteen have been withdrawn without prejudice; two have been withdrawals of complaints; none have been suspended; eighty-five are pending decision; and 138 have been decided.

V

Cases

ICANN has estimated that, between the three providers, a total of 668 proceedings have been instituted. Of the cases decided, 9 domain names have been cancelled, 64 decisions were for the respondent, 2 were split decisions, and 234 resulted in names being transferred. In other words, 80% of the domain names in questions are transferred or cancelled, while only 20% of Respondents are allowed to retain their rights in their registration.

These kinds of numbers raise many questions. First, can these numbers be explained away by determining that those who are resorting to this forum are, for the most part, truly being hounded by

127. See Pearson v. Byers Choice, Case No. FA-92015, NAF Panel Decision (Mar. 9, 2000) (finding respondent was not a cybersquatter).
128. See id.
130. See id.
people who are trying to profit off others’ hard work? Or is it that the Panelists are simply providing additional, easier protections for trademark holders and big businesses at the expense of individuals or small businesses? Are the rules that the Panelists follow skewed in some way, or are they simple enough that they get to the heart of the problem and truly weed out the cybersquatter from the legitimate registrant?

There has been much conjecture regarding the inherent fairness of these dispute resolution providers. Many, however, have waited to see what the first series of proceedings and results would look like. Many of the cases are decided on one single factor – whatever factor is most outrageous, on either side, to the Panelist(s). An analysis of the cases to date\textsuperscript{131} is set forth below, separating issues and discrepancies that have arisen in these cases by topic.

A. Administrative/Interpretive Problems

There have been relatively few problems directly related to the filing of the Complaints and Responses themselves. Approximately half of Respondents do not file a Response to a Complaint.\textsuperscript{132} In several decisions, it was hard to determine whether a complaint had even been filed.\textsuperscript{133} In others, it was a question of whether

\textsuperscript{131} As of May 9, 2000.


\textsuperscript{133} See, e.g., PlanetRx.com, Inc. v. Intertainment, Inc., Case No. FA-92973, NAF Panel Decision (Mar. 7 2000). The entire decision reads as follows:

The Complainant is a California-based company that sells over the Internet prescription drugs, over-the-counter remedies, and health and beauty aids, a [sic] well as providing on-line medical information. It has registered the domain name PLANETRX.COM. The Complainant has applied to the register the marks PLANETRX and PLANETRX.com.

The Respondent is a London-based competitor that has registered the domain name PLANETRX.COM. That domain name bears no relationship to the Respondent’s trade name, World Express Rx. When a consumer types the name PLANETRX.COM, they are taken to the home page of the Respondent.
It is apparent that the Respondent has registered PLANETHXX.COM to disrupt the Complainant's business. The Respondent has acted in bad faith. The Respondent's domain name PLANETHXX.COM is cancelled.

Id. See also Allergan, Inc. v. Ostad, Case No. FA-92974, NAF Panel Decision, (Mar. 8, 2000) (finding respondent acted in bad faith).

134. See eAuto, Inc. v. Available-Domain-Names.com, Case No. D2000-0120, WIPO Panel Decision, (Apr. 13, 2000) ("[T]he Panel must consider whether to accept the two amendments filed by Complainant. Because the first amendment was filed at the same time as the commencement of the proceeding, because it promptly reported a new development since the filing of the Complaint, and because Respondent had a fair opportunity to respond to the amendment, the Panel elects to accept and consider this submission."); eAuto, Inc. v. E Auto Parts, Inc., Case No. 2000-0121, WIPO Panel Decision, (Apr. 13, 2000) (Because the amendment was filed at the same time as the commencement of this proceeding, and because Respondent had a fair opportunity to respond to the amendment, the Panel elects to accept and consider this submission."); Cordstrap B.V. v. Aliphas, Case No. FA-94110, NAF Panel Decision, (Apr. 5, 2000) ("The Complaint, the Response, Complainant's Rebuttal to Respondent's Reply to Complaint, and the Objection of Respondent to Consideration by the Panel of the Rebuttal were docketed and forwarded to each of the [panelists]." (But note, allowing the Complainant's Rebuttal to Respondent's Reply to Complaint without discussing Respondent's objections."); America Online, Inc. v. Tencent Communications Corp., Case No. FA-93668, NAF Panel Decision, (Mar. 21, 2000) ("Upon the submitted record including the Complaint, the Response to the Complaint, the Complainant's Rebuttal to Respondent's Reply to Complaint and the Response of Respondent to the Rebuttal[."]); Aero Turbine, Inc. v. McAym Ltd., Case No. FA-93675, NAF Panel Decision, (Feb. 28, 2000) NAF (2000) ("A Response was filed by [Respondent]. In additions, Complainant filed a Rebuttal to Respondent's Response. Upon the written submitted record, the following decision is made.")

135. See J.P. Morgan v. Resource Marketing, Case No. D2000-0035, WIPO Panel Decision, (Mar. 23, 2000) ("[T]he Panel is persuaded that documents, whether designated "replies" or "rebuttals," are not called for in the Rules. Paragraph 12 of the Rules provides for additional submissions only at the Panel's request, in its sole discretion."); Easyjet Airline Company Ltd. v. Steggles, Case No. D00-0024, WIPO Panel Decision (Mar. 17, 2000) ("The first question to be dealt with is whether or not further submissions like the ones which were filed after the initial Complaint and Response can be allowed if such submissions are not made on the request of the Center or the Panel. The Rules provide for the filing of a Complaint (art. 3), the notification of the Complaint and the fixation of the commencement of the administrative proceeding (art. 4), the filing of the Response (art. 5) and the appointment of the Panel and timing of the Decision (art. 6). The Rules do not provide for the possibility of filing further submissions with the exception of article 12 where it is said that the Panel may, in its sole discretion, request further statements or documents form [sic] the Parties. The further submissions in this case which were not requested by the Panel will therefore not be taken into account.").

supplemental documents from both Complainants and Respondents would be allowed. Usually, supplemental/amended documents are allowed by the Panels, though this is not always the case. Some panels deny the consideration of supplemental materials, others simply skip any consideration of the issue whatsoever. There is no majority rule in these cases. Thus, a party considering whether or not to provide a supplemental response or amendment should probably submit it. The Panel may say no, but there is an equal chance the
Panel will accept the documents.

One of the more important questions, however, deals with what the Panel can use as principles of law when it examines these cases. In *World Wide Wrestling Federation Entertainment, Inc. v. Bosman* the Panel states:

> [s]ince both the complainant and respondent are domiciled in the United States, and since United States’ courts have recent experience with similar disputes, to the extent that it would assist the Panel in determining whether the complainant has met its burden as established by Paragraph 4(a) of the Policy, the Panel shall look to rules and principles of law set out in decisions of the courts of the United States.

The panel then examines what constitutes “use” in U.S. case law regarding trademark owners contesting domain names. The Panelist does state, however, that he is examining U.S. law because both the Complainant and Respondent are domiciled in the United States.

Other cases do this as well. In fact, over forty-three of the cases examined used precedent and law outside of the ICANN Rules, Policy, and provider cases. The use of outside precedent is based on

137. Id. at 4 (emphasis added).
138. See id. at 5.
Paragraph 15(a) of the Rules.\textsuperscript{140} Although there is not much legislative history available through ICANN concerning the meaning of this rule, it was addressed in the WIPO Final Report.\textsuperscript{141}

The Final Report gave an example of what it meant by laws "applicable in view of the circumstances of the case."\textsuperscript{142} The example said that if both parties were residents of one country, the domain name was registered in that country, and the evidence of bad faith registration and use occurred in that country, then it would be appropriate for a panelist to refer to that country's laws.\textsuperscript{143} Where this becomes problematic is when a Panelist refers to the laws of a country, because all the elements stated above apply, and a Panelist in another case uses the former case as precedent on that same issue, but where the Parties are resident in other countries.\textsuperscript{144} This may subject Parties to the laws of countries that they have no ties to, or knowledge of.

B. Identical or Confusingly Similar\textsuperscript{145}

Of the three factors the complainant must prove, this is the least controversial and the easiest to apply. In fact, only a handful of cases have actually done any real analysis of "identical or confusingly similar." This is because most of the domain names at issue are letter for letter the same as the mark in question.

The panelists have overwhelmingly agreed on several issues related to determinations of similarity. First, the Panels have agreed that where the addition of a TLD is the only difference between the domain name and the trademark, this is sufficient to meet the test.\textsuperscript{146} Second, if a trademark employs the use of symbols or punctuation

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\item \textsuperscript{140} See Rules, supra note 63, at ¶ 15(a) ("A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.").
\item \textsuperscript{141} See Final Report, supra note 45, and accompanying text.
\item \textsuperscript{142} Final Report, supra note 43, ¶ 176.
\item \textsuperscript{143} See id.
\item \textsuperscript{144} See, e.g., Telstra Corporation Ltd. v. Nuclear Marshmallows, Case No. D2000-0003, WIPO Administrative Panel Decision, (Feb. 18, 2000) (referring to Case No. D99-0001, applying US law on same point, as precedent in case where parties are both Australian).
\item \textsuperscript{145} "Your domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights." Policy, supra note 64, at ¶ 4(a)(i).
\item \textsuperscript{146} See, e.g., Shirmax Retail Ltd. v. CES Marketing Group Inc., Case No. AF-0104, eResolution Panel Decision, (Mar. 20, 2000) ("However, where the addition of a TLD is only difference, such virtual identiciality seems sufficient to satisfy the [identical test].").
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that cannot be used in domain names, the lack of such symbols or punctuation are not sufficient to overcome the test.\textsuperscript{147} In addition, the Panels have not required parties to show actual consumer confusion to prove that a domain name is confusingly similar.\textsuperscript{148}

There has been some question, however as to whether a generic term can be considered identical or confusingly similar at all. The Panels either address this issue by stating that generic terms cannot fall within this provision,\textsuperscript{149} or they bypass the discussion altogether and analyze the trademark in relation to the domain name.\textsuperscript{150} This issue may need to be further addressed by ICANN in the future.

\textsuperscript{147} See, e.g., Beverages and More, Inc. v. Glenn Sobel Mgmt., Case No. AF-0092, eResolution Panel Decision, (Mar. 9, 2000) (finding ampersands, commas, and exclamation marks are not sufficient to bar similarity).


While it is possible that the Complainant could have made a stronger case for his claim of confusion between the use of the trademark and the domain name by showing that consumers or others utilizing the Complainant’s services were actually confused between the two or that the Complainant had lost business because of this confusion, we find that the level of proof that is required to meet the burden by the Complainant does not require the presentation of such additional tangible evidence.

\textit{Id.}

\textsuperscript{149} See, e.g., Shirmax Retail Ltd. v. CES Marketing Group Inc., Case No. AF-0104, eResolution Panel Decision, (Mar. 20, 2000) (“Where [a term] is generic, it is more likely to favor the domain name owner. . . . The ICANN Policy [does not cover] every dispute that might arise over a domain name. It only covers clear cases of “cybersquatting” and “cyberpiracy.”); Western Hay Co. v. Forester, Case No. NAF-93466, NAF Panel Decision, (Mar. 3, 2000) (finding “westernhay” to be generic and thus not be a violation under the UDRP).

\textsuperscript{150} See, e.g., Hearst Communications, Inc. v. Spencer, Case No. NAF-93763, NAF Panel Decision (Apr. 13, 2000) (“It is the opinion of the majority of the Panel that Spencer’s actions constitute the very thing the Policies are designed to prevent. It was and is his intent to take advantage of the benefit of these established trademarks. Contrary to the Respondent’s claim, the majority does not agree that esquire is a generic term or that the Complainant’s trademark is so weak it should not be protected.”).
C. No Legitimate Interest and the Defenses

Complainant must prove that Respondent has no legitimate right or interest in the domain name. Respondent may rebut this presumption by showing that he or she does have such a right. The Policy seems to suggest that Respondent only needs to present this defense if Complainant is able to show no right to the domain name in the first place. However, this is not always how it is played out in the cases themselves.

Paragraph 4(a) of the Policy provides that Complainant's duty in relation to these administrative proceedings is to prove that each of the three elements is present. The burden, in other words is on Complainant to show that each of the three elements outlined in Paragraph 4(a) is present in this particular case. The question, then, is to what standard of proof do the Panels hold Complainants in proving these factors?

This question is hard to answer. Many of the Panels simply fail to address who has what burden. A large percentage of the cases simply list the accusations presented by Complainant, state that Respondent has not presented evidence sufficient to rebut them, and leave it at that. Very few cases have actually acknowledged that Complainant must first present evidence of Respondent's lack of a legitimate interest, or right, in the domain name before Respondent must prove otherwise. Often, in fact, the opposite is true; i.e., the Panel looks to

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151. "You have no rights or legitimate interests in respect of the domain name." Policy, supra note 64, at ¶ 4(a)(ii).

152. Respondent, to rebut an inference that he/she has no legitimate interest to a domain name for purposes of paragraph 4(a)(ii), should present evidence that:
   1) 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
   2) 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
   3) 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.

Policy, supra note 64, at ¶ 4(c).

153. Id. ¶(a).

154. First, Complainant must show that the domain name is "identical or confusingly similar to a trademark or service mark in which the complainant has rights;" second, that Respondent has "no rights or legitimate interests in respect of the domain name;" and third, the "domain name has been registered and is being used in bad faith." Id.


156. See, e.g., General Machine Products Co. v. Prime Domains, Case No. NAF-92531,
see whether Respondent has provided proof of a legitimate right to the name and, if none is presented, uses this in concluding that paragraph 4(a)(ii) has been sufficiently proven.¹⁵⁷

The Policy states that Complainant must prove each of the three elements (identical or confusingly similar; no legitimate rights or interest; and bad faith) to have the Panel find in his favor.¹⁵⁸ Respondent only needs to respond if Complainant has provided evidence of these elements.¹⁵⁹ This discrepancy in the application of the Rules by the Panels needs to be addressed.

In addition, there is some question as to what is in fact, a legitimate interest. Can a legitimate interest be shown through common law rights?²⁰ At what point do preparations to use a site

NAF Panel Decision (2000).  
[Complainant] has not proven, however, that [Respondent] has no legitimate interests in respect of the domain name. [Complainant's] trademark is not fanciful or arbitrary, and [Complainant] has submitted no evidence to establish either fame or strong secondary meaning in its mark such that consumers are likely to associate [the domain name] only with [Complainant. As Respondent] has rebutted [Complainant's] arguments and has proven that it is in the business of selling generic and descriptive domain names. As a result, [Respondent] does have a legitimate interest in the domain name. That respondent has offered to sell this descriptive, non-source identifying domain name does not make its interest illegitimate.

Id.

¹⁵⁷. See, e.g., Sandy Frank Entertainment, Inc. v. Law Street Inc., Case No. NAF-93669, NAF Panel Decision, (Apr. 1, 2000) (“The second element is arguably present since the Respondent makes merely a naked allegation that the website is being developed without showing a use, or the existence of demonstrable preparations to use the site.”).
¹⁵⁸. See Policy, supra note 64, at ¶ 4(a).
¹⁵⁹. See id., at ¶ 4(c).

In lack of further information [concerning registration], the Panel takes it for granted that Respondent did not register that name as its trademark in the United States Patent and Trademark Office or in other federal or state registers. However, it is a well-established principle in trademark law – also in U.S. state laws and under federal law – that trademark rights can be protected, and even enforced, in the absence of such registration. Clearly, one of the shortcomings of having an unregistered common law trademark is its more limited geographical scope. But in relation to the use of trademarks on the Internet in general, and in this matter in particular, it is the opinion of the Panel that this limitation should not be given weight. The domain name in question is registered under a generic top level domain which by its nature is global, and both companies are obviously conducting their business on a scale which can not be regarded as local. Therefore, when considering the right of a party to obtain domain name registration for a business name or unregistered trademark, the fact that the said party has actually used the mark for its products or services gives that party a legitimate interest in using a similar Internet domain name. This principle also corresponds with the generally agreed “first filed, first served” - rule of domain
under a specific domain name become enough to ensure that the use is legitimate? The Rules also allow for fair use defenses. What exactly constitutes fair use? There have not been enough cases addressing this question to make any kind of determination as to what qualifies as fair use in the context of domain names.

The Panels do, however, tend to focus on the amount of time a Respondent has taken in setting up a website. Overall, the Panels seem to lean towards the principle that if action is not taken within a

name registration.

Based on the information in the case provided by the Respondent, the Panel finds it plausible that Respondent by its very use of the domain name has acquired a common law trademark right to use the domain name for products and services, and that this right also gives Respondent a legitimate interest in the continued use of the domain name for its business as Respondent has registered as its domain name long before Complainant made attempts to register her registered trademark as a domain name.

Id. (emphasis added).

161. See Rules, supra note 63, at ¶ 4(c)(iii).


Whether the Respondent has 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 requires a careful consideration of the facts. The disputed domain name was placed on hold before the Respondent has an opportunity to place content on a web page associated with the domain name. Therefore, all that the record contains is Respondent’s statements as to Respondent’s intended uses. Respondent states in correspondence between the parties and in its response that its intent is to establish a historical and biographical site dedicated to Kokichi Mikimoto. As stated, this would be a noncommercial or fair use of the domain name.

However, this is not the complete record, in addition to creating a “noncommercial” biographical web site, Respondent intends to link from the disputed domain name to Respondent’s business. Respondent avers in his response that it did not intend to link from the “noncommercial” mikimoto.com page to asanti.com page. Notwithstanding this statement, Respondent stated that its online biography would result in “heightened awareness and credibility for Asanti” and a projected increase of 5% per year across the board in cultured pearl sales. I find Respondent’s claim that it would not link mikimoto.com to asanti.com not entirely credible. . . . I find it particularly telling that Respondent did not offer to take reasonable measures, for example disclaimers of association with Complainant or warnings in meta tags, to help consumer confusion.

Id.

163. Id. at ¶ 5(2)(c). See also Adaptive Molecular Technologies, Inc. v. Woodward, Case No. D00-0006, WIPO Panel Decision (Feb. 28, 2000).

While Respondent does not own MILITEC as a trademark, questions remain as to whether Complainant legally acquiesced in Respondent’s registration and use of the domain, at least initially, or whether Respondent’s use is a nominative fair use. Acquiescence and fair use are principles of trademark law, each requiring full analysis of the underlying facts. These are issues for the courts.

Id. at ¶ 5.2.
reasonable period of time, Respondent has not shown a legitimate interest in the domain name. 164


[A]lthough the Respondent claims that there was an intent to use the domain name in furtherance of his partner’s business activities, he does not show that any such activities were actually carried out. Indeed, he admits that he was not actually using the domain name and that it had been ‘warehoused.’ Under such circumstances, we can only come to the conclusion that the Respondent had not acquired any such other interest or rights in the domain name and his claim, therefore, is invalid.


One could argue that, from June 1996 until notice of the dispute in early 2000, the preparation time to actually use the domain name and the corresponding business name is rather long. However, that fact in itself is not sufficient to defeat [Respondent]’s rights or legitimate interests in the domain name. . . . [A]lthough paragraph 4(c) of the ICANN rules provides the Respondent with instances demonstrating his rights to and legitimate interests in the domain name in issue, and therefore provides examples of conclusive defenses to the complaint, the burden of proof still rests on the Complainant’s shoulders to prove that the Respondent has no rights or legitimate interests.

Id. See also Tourism and Corp. Automation Ltd. v. TSI Ltd., Case No. AF-0096, eResolution Panel Decision, (Mar. 16, 2000) (determining respondents lack of using website for business purposes as of date is sufficient to find bad faith); Beverages and More, Inc. v. Glenn Sobel Mgmt., Case No. AF-0092, eResolution Panel Decision, (Mar. 9, 2000) (finding no legitimate use as website is not active).
D. Bad Faith

The vast majority of these cases are decided upon the question of "bad faith." This is the very crux of the matter when one is dealing with the issue of cybersquatting: Did the domain name registrant register the name for the purpose of selling it back to a rightful trademark holder at an enormous profit; register it to confuse the public and profit off of the trademark's goodwill; or register it with the intent of disrupting the trademark holder's business, or to provide a competitor with an edge?

The very first decision handed down under ICANN's rules, *World Wrestling Federation Entertainment, Inc. v. Bosman*, provided the first real guidance on how the rules regarding bad faith needed to be applied. The Panel found that, for a domain name to fall positively within this category, "the name must not only be registered in bad faith, but it must also be used in bad faith." The Panel examined the ICANN's legislative history to determine that Complainant must establish not only bad faith registration, but also use in bad faith. The Panel then went on to state that the activities identified in paragraph 4(b)(i) are evidence of registration and use in bad faith.

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165. For reference, this section deals with paragraph 4(a)(iii) of the Policy, which states, "your domain name has been registered and is being used in bad faith." *Policy*, supra note 41 at ¶ 4(a)(iii). Paragraph 4(b) reads:

Evidence of Registration and Use in Bad Faith. For the purposes of Paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, 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

(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.


167. *Id.* at 5.

168. *See id.*
This was expanded upon in *Shirmax Retail Ltd. v. CES Marketing Group Inc.*[^169] Here, the Panelist states, "[r]egistration in bad faith is insufficient if the respondent does not use the domain in bad faith, and conversely, use in bad faith is insufficient if the respondent originally registered the domain name for a permissible purpose."[^170] The Panelist goes on to examine what this means in the context of applying paragraph 4(b) of the Policy:

The first three examples in paragraph 4(b) all refer to registration for various illegitimate purposes as evidence of registration and use in bad faith; but in each instance bad faith use may well be implicit in the act of registering a domain name, since all of the improper purposes mentioned can be accomplished merely by passively holding a domain name.

The fourth example (paragraph 4(b)(iv)), however, refers only to improper use, and does not appear to require that the domain name also have been registered in bad faith. This example thus appears to conflict with the rule set forth in paragraph 4(a)(iii). The language of paragraph 4(a)(iii) is clear, and the only reasonable interpretations are to regard the fourth example as a narrow exception to the preceding subparagraph's conjunctive rule, or to apply the conjunctive rule as it is written and disregard the example entirely.[^171]

This confusion over the exact interpretation of use is reiterated in different forms throughout the cases.

The most common of the four types of bad faith found by the Panels are the first and last examples. The first, commonly known as "cybersquatting," occurs when someone acquires a domain name for the sole purpose of selling it back to the "rightful" owner. The question the panels seem to be struggling with in these cases is exactly how much money is considered an exorbitant amount? There seems to be a consensus that the registrant may legitimately request the costs actually expended. After that point, the question is interpreted on a case-by-case basis. Some of the Panels have found that any amount over the actual costs is evidence of bad faith.[^172] Others have required that the domain name simply be for sale, or that more than one be registered at a time,[^173] or for others, that the domain name not

[^169]: Case No. AF-0104, eResolution Panel Decision (Mar. 20, 2000).
[^170]: Id. at 3.
[^171]: Id.
[^172]: See, e.g., Biofield Corp. v. Kwon, Case No. AF-0102, eResolution Panel Decision, (Mar. 23, 2000) (offering to sell domain name registered for a non-profit for $1000 is bad faith).
[^173]: See, e.g., Royal Bank of Can. v. D3M Domain Sales, Case No. AF-0147, eResolution Panel Decision, (May 1, 2000) ("Absent evidence of any other purpose for registering the three domain names in question . . ., I conclude they were registered and
for sale. One panel even suggested that Respondent’s request for actual costs and a public apology from the Complainant was evidence of bad faith.

The second and third examples of bad faith are not as commonly used by the Panels. Often, when these are used, there is little or no explanation of how the Panel reached its decision. The final example, however, is used quite frequently.

used primarily for sale to the Complainant or a competitor. Further evidence of this purpose is found in the [Respondent’s] registration of other domain names closely resembling financial industry and charitable trademarks and names.”; Mikimoto (America) Comp. v. Asanti Fine Jewellers, Ltd., Case No. AF-0126, eResolution Panel Decision, (Apr. 8, 2000) (determining a single prior instance of registering a domain name to keep the holder of a trademark from using it is sufficient to find bad faith in current case); Beverages and More, Inc. v. Glenn Sobel Mgmt., Case No. AF-0092, eResolution Panel Decision, (Mar. 9, 2000) (finding respondent’s business of selling domain names is sufficient to prove bad faith); America Online, Inc. v. QTR Corp., Case No. NAF-92016, NAF Panel Decision, (Feb. 10, 2000) (“Respondent has made no legitimate use of the domain name and it seeks to profit from its registration of said domain name by trading upon the goodwill associated with the ICQ Marks. Respondent’s profit motive is evidenced by its offer to sell said domain name by listing in the WHOIS directory ‘...This domain name is for sale...’ ”).

See, e.g., Fishtech, Inc. v. Rossiter, Case No. NAF-92976, NAF Panel Decision, (Mar. 10, 2000) (“...Respondent... did not respond to telephone calls, e-mail messages, or letters. This continuing refusal to communicate is evidence of continuing bad faith.”).

See Hewlett Packard Co. v. Burgar, Case No. NAF-93564, NAF Panel Decision, (Apr. 10, 2000) (“[T]he respondent has stated that he would transfer the name if he were paid his costs associated with registration and received a public apology from the complainant. This demonstrates to the Panel that he has no legitimate right or interest in the domain name.”).

See, e.g., PlanetRX.com, Inc. v. Intertainment, Inc., Case No. FA-92973, NAF Panel Decision (Mar. 7, 2000). The entire decision reads:
The Complainant is a California-based company that sells over the Internet prescription drugs, over-the-counter remedies, and health and beauty aids, as well as providing on-line medical information. It has registered the domain name PLANETRX.COM. The Complainant has applied to register the marks PLANETRX and PLANETRX.COM.
The Respondent is a London-based competitor that has registered the domain name PLANETRXX.COM. The domain name bears no relationship to the Respondent’s trade name, World Express Rx. When a consumer types the name PLANETRXX.COM, they are taken to the home page of the Respondent.
It is apparent that the Respondent has registered PLANETRXX.COM to disrupt the Complainant’s business. The Respondent has acted in bad faith.
The Respondent’s domain name PLANETRXX.COM is cancelled.

Id. See also FaceTime Communications, Inc. v. Live Person, Inc., Case No. FA-92048, NAF Panel Decision (Feb. 18, 2000) (finding bad faith of disrupting Complainant’s business); SGS Societe Generale de Surveillance S.A. v. Inspectorate, Case No. D00-0025, WIPO Panel Decision (Mar. 17, 2000).

Passing off or confusion caused by Inspectorate between Supreme Global Service (SGS) and SGS Societe Generale de Surveillance S.A. is not the only way to disturb or hinder a competitor’s operation. A certainly more subtle way does exist, and that is diverting prospective customers to an Internet “cul-de-sac”
Here, Complainant must show that Respondent was trying to gain commercially through consumer confusion as to the source of the site. This bad faith example, however, seems to be used when a Complainant or Panel is at a loss to explain the bad faith in any other way. While a Panel does not have to fit the bad faith explanation within one of the four examples given, Complainant usually produces evidence that relates to one of the four. If the evidence does not show what Complainant says that it shows, but the Panels think there is evident bad faith, the fourth reason in paragraph 4(b) is usually cited. In this situation, however, the Panel usually does not explain consisting in presenting a tombstone supposedly not related to Claimant. The Panel cannot ascertain whether this scheme is or has been successful in achieving that hindering goal. However the Panel cannot overlook that this mechanism is an evidence of bad faith as described in the Policy. The fact of having set up such scheme is certainly a “pattern of such conduct” by Respondent, and does not require any effective success in unfairly disturbing competition.

Id. 6.3.1.

177. See, e.g., Faithnet, Inc. v. Believers Fellowship of Lakeland, Case No. NAF-93666, NAF Panel Decision, (Mar. 20, 2000) (“The Respondent has made no legitimate use of the domain name, and by attempting to maintain the right to the use of the domain name after notification of the prior trademark rights and domain name rights of the Complainant, there was an inference that Respondent’s intent was to create a likelihood of confusion with the Complainant’s mark and domain name, or to profit from the sale of the domain name.”); Fire-Trol Holdings, LLC v. Fire Foam Products Development, Case No. NAF-93709, NAF Panel Decision, (Mar. 20, 2000) (“Adopting a designation with knowledge of its trademark status permits a presumption of intent to deceive. In turn, intent to deceive is strong evidence of a likelihood of confusion. Here it is concluded that far beyond the presumptions, Respondent acted in bad faith and with the intent to deceive.”);


Respondent has been incorporated and has been doing business in Canada under the name ‘Fiber Shield (Toronto) LTD.’ ... Respondent claims that it was unaware of the business activity of complainant under the name ‘Fiber Shield Industries, Inc.’, or any variation thereof, until it attempted to register its own domain name as ‘fiber-shield.com’. Upon being advised of the unavailability of such name due to complainant’s prior registration, respondent proceeded to register the domain ‘fibershield.net.’ It appears clear that Registrant registered fibershield.net with actual awareness of a confusingly similar prior registration in favor of complainant.

Id.

178. See, e.g., Which? Ltd. v. Halliday, Case No. WIPO D00-0019, WIPO Panel Decision, (Mar. 27, 2000) (“The sheer number of hits on the Complainant’s website (which gives access to its publication “The Good Food Guide”) demonstrates the wide public knowledge of the Complainant’s publication,” as evidence of confusion); Ingersoll-Rand Co. v. Gully, Case No. WIPO D00-0021, WIPO Panel Decision, (Mar. 9, 2000) (“It is Complainant’s burden to establish bad faith registration and bad faith use. The Panel believes that, while in some instances the question is a close one, Complainant has failed to meet its burden as to any of the four particular set of circumstances set out in Paragraph 4.b. The Panel is not persuaded that the registration of three very similar or identical domain names arises to the “pattern of conduct” required by 4.b(ii), and although
Respondent appears to have realized commercial gain by intentionally attracting Internet users searching for the website of Ingersoll-Rand Co. and by offering links to pornographic websites where services were available for fees, it is highly unlikely that such Internet users, who were seeking the website of a long-standing United States corporation, were likely to be confused that Complainant would deign to sponsor such links as "tasteless.net" or "rascals.net," or endorse the products or services offered there. However, under the proper facts and circumstances even inaction can constitute "bad faith" use, and the Panel finds that Respondent has registered and is using the DN at issue in bad faith. Respondent has failed to respond to the offer by the trademark holder to purchase the domain name at Respondent's out of pocket costs. Respondent has failed to respond to the allegations of the Complainant, and the Panel is permitted to draw such inferences therefrom as it considers appropriate.


Lacking any response from the holder of royalbankonline.com to the Complainant's evidence that the domain name was used in e-mail in which it appeared as the identity of an endorser or sponsor of instalotto.net, I must infer that such use occurred with the Respondent's knowledge and consent. That, in my judgment, constituted an attempt to attract the Internet users for commercial gain by creating a likelihood of confusion with the Complainant's trademark.

Id. Baker Hughes Inc. v. Petroil, C.A., Case No. FA-93557, NAF Panel Decision (Mar. 14, 2000) ("Respondent registered and acquired the domain name "Vybar.com" for the sole purpose of creating confusion and an unfair competitive advantage with Complainant to Complainant's detriment. Respondent registered and used the domain name in bad faith."); Fiber-Shield Industries, Inc. v. Fiber Shield Ltd., Case No. FA-92054, NAF Panel Decision (Feb. 29, 2000)

Respondent has been incorporated and has been doing business in Canada under the name "Fiber Shield (Toronto) LTD." Respondent claims that it was unaware of the business activity of Complainant under the name "Fiber Shield Industries, Inc.", or any variation thereof, until it attempted to register its own domain name as "fiber-shield.com". Upon being advised of the unavailability of such name due to Complainant's prior registration, Respondent proceeded to register the domain "fibershield.net". It appears clear that Respondent registered fibershield.net with actual awareness of a confusingly similar prior registration in favor of Complainant.

Id. Alcoholics Anonymous World Services, Inc. v. Raymond, Case No. D00-0007, WIPO Panel Decision (Mar. 6, 2000) (in finding for Complainant that domain name was registered with an intent to gain through confusion, Panel states, "It is a general principle of United States law that the failure of a party to submit evidence on facts in its control may permit the court to draw an adverse inference regarding those facts.").
E. Remedies

A Panel has several options at the conclusion of the case. It may find in favor of Complainant and either transfer or cancel the domain name registration; or it may find for Respondent and do nothing to the registration and, if it so finds, charge Complainant with reverse domain name hijacking. Of the cases included in this article, forty-six were dismissed because the Complainant did not prove that the Respondent either acted in bad faith or had no legitimate interest in the domain name. Only seven cases resulted in cancellation. The rest of the domain names were transferred to the trademark holder.

VI

Update on the National Arbitration Forum

It is interesting to note that, on the final day of drafting this Article, the National Arbitration Forum released amended Supplemental Rules. The amendments were drafted in response to

180. “The remedies available to a complainant pursuant to any proceeding before an Administrative Panel shall be limited to requiring the cancellation of your domain name or the transfer of your domain name registration to the complainant.” Policy, supra note 64, at ¶ 4(i).

If after considering the submissions the Panel finds that the complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking or was brought primarily to harass the domain-name holder, the Panel shall declare in its decision that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding. Rules, supra note 63, at ¶ 15(e).

181. See Shirmax Retail Ltd. v. CES Marketing Group, Inc., Case No. AF-0104, eResolution Panel Decision (Mar. 20, 2000). Stating:
Although the applicable policy and rules are quite vague on what constitutes bad faith in bringing a complaint, it seems logical that bad faith should be found if the complaint has an obvious interest in obtaining the respondent’s domain name for its own use, yet lacks even a plausible argument on each of the elements set forth in paragraph 4(a) of the ICANN policy.
Id. at 4. See also Breakthrough Software, Inc. v. Hendrick Huigen Doing Business as Gordon-Huigen Enterprises, Case No. AF-0122, eResolution Panel Decision (Apr. 13, 2000) (“[T]he ICANN Rules having been adopted quite recently, that is only a few months before Breakthrough filed the present complaint, it would be appropriate, in this very particular instance, to give Breakthrough the benefit of the doubt.”); Dog.com,. Inc. v. Pets.com, Inc., Case No. FA-93681, NAF Panel Decision (Mar. 31, 2000) (“Respondent further requests that the Arbitrators make an express finding of fact that the Complainant has brought this Complaint in bad faith and has attempted to engage in reverse domain name hijacking. The Arbitrators decline to make a finding of bad faith or reverse domain name hijacking against the Complainant.”)
182. See id.
183. See id.
a survey of attorneys who have represented parties in arbitration claims concerning cybersquatting. As the sub-heading of a press-release written by the National Arbitration Forum explains, “Findings Generate Amendments to Forum’s Supplemental Rules for ICANN UDRP Program.” According to the press release, “[n]inety-five percent of those who have filed a domain name claim with the Forum say they would use the Forum again to resolve a ‘cybersquatting’ dispute.” In addition, 91% of attorneys for claimants and respondents found NAF provided excellent or good service, and 96% said the website presented helpful information.

Why then, with such a high approval rating and success would NAF change anything? Again, the press release helps us in answering this question.

The Forum has used the findings to update its Supplemental Rules, effective May 10. The Supplemental Rules, approved by ICANN, address case management issues. Changes address several issues:

- A preferred-communication option;
- A mechanism for informed time extensions;
- Provisions to allow parties to address facts stated in the response;
- Protections against procedural errors; and
- A fee reduction for some uncontested cases.

The “preferred-communication option” is not the issue. The others are more worrisome from a fairness perspective.

The changes made to the Supplemental Rules, which were approved by ICANN, are extremely biased toward Complainants. The new Supplemental Rules set forth specific steps a Respondent must go through to get an extension for filing a response. Before, a Respondent merely had to submit his request to the provider, now there are very specific steps that must be met, and fees that must be paid before an extension will even be considered.

(a) . . . Any request by the Respondent for an extension or any joint request by the parties for an extension shall:

(i) be submitted after the parties have first conferred with each other to see if they could reach an agreement concerning the requested extension;

186. Id. (emphasis added).
187. See id.
188. Id.
(ii) be submitted in writing to The Forum and the parties within the time for the Response to be submitted;

(iii) state the exceptional circumstances warranting the request for an extension;

(iv) state the length of the extension being requested (no more than twenty (20) additional days); and

(v) be accompanied by an extension fee of $100.

(b) The Forum may exercise its discretion in determining whether exceptional circumstances exist warranting an extension and if so, the length of the extension. No request for an extension shall be approved if any of the conditions set forth in Paragraph 6(a) has not been performed.\(^{189}\)

The bonuses provided to the Complainant do not end there, however. A party may submit additional written statements and documents to The Forum and the opposing party(s) not later than five (5) calendar days after the date the Response is submitted or the last date the Response was due to be submitted to the Forum, whichever occurs first. A fee of $150 and proof of service of these submissions upon the opposing party(s) shall accompany each such submission. No such submission shall be considered by the panel if not timely submitted, or if the required fee is not paid and the proof or [sic] service does not accompany the submission. The parties may not amend the Complaint or the Response.\(^{190}\)

NAF clarifies this somewhat in its press release by stating that it is a provision "to allow parties to address facts stated in the response."\(^{191}\)

The Supplemental Rules do add a provision for reconsideration of a decision prior to action on the decision by a Registrar. This reconsideration may occur if: "(i) [t]he Decision is ambiguous or contains evident material mistakes, (ii) [a] party was not served with the complaint in accordance with the Rules, (iii) [t]he Panel did not decide a required issue, or (iv) [a]ll the parties agree."\(^{192}\) While (ii) is definitely in the Respondent's favor, the other provisions are equally beneficial for both. While this may be some consolation for a Respondent, nevertheless, additional benefits are provided for Complainants.

Complainants are given further incentives to use NAF through its amended rules concerning the selection of panels.

190. Id. at ¶ 7.
191. Press Release, supra note 185. However, it is hard to imagine that Respondent would have more to say within those five days that is neither an amendment nor a response to anything supplemental Complainant may have submitted.
(c) In cases where the Complainant requested a three member panel and no Response was submitted as required by Rule 5(a), the Complainant may be given the option of converting the three member panel to a single arbitrator:

(i) after the time for the Response has expired, The Forum shall notify the Complainant that no response was submitted and that the Complainant may convert its three member panel request to a single arbitrator request;

(ii) Within five (5) calendar days of this notification, the Complainant, by e-mail to The Forum, may request that the three member panel be converted to a single arbitrator;

(iii) If a single arbitrator is requested, The Forum shall select an arbitrator from its list of arbitrators, not on the list of arbitrators submitted by the Complainant; and

(iv) If a single arbitrator conducts the administrative hearing, the Complainant shall be reimbursed $1,000 of its filing fee.\(^{193}\)

Again, to simplify the new provision, the press release calls this "a fee reduction for some uncontested cases."\(^{194}\)

The effect of these policies is yet to be seen. The Supplemental Rules went into effect on May 10, 2000. Given the tendency of NAF to provide little detail concerning Respondents’ arguments, it will be interesting to see how the Rules play out within the Panels themselves.

VII

Conclusion

ICANN and the three dispute resolution providers have made a formidable effort to provide fair hearings for both parties. However, much work needs to be done to ensure objectivity and fairness. In addition, the providers and ICANN need to work on some variety of uniformity. As it stands, there is no set of rules that either of the Parties can rely on, as they are interpreted by the Panels in many different ways.

In particular, the dispute resolution providers should be careful of advertising themselves as pro-Complainant. The National Arbitration Forum released a press release concerning its first decision, entitled, "Cybersquatter Evicted from AOL Domain Name in World’s Second Test of New ICANN Domain Dispute Policy."\(^{195}\)

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193. Id. at ¶ 9(c) (emphasis added).
194. Press Release, supra note 185, at 510.
The use of the term "evicted" sends a strong message, as does the NAF's new Supplemental Rules, to Complainants and Respondents.

In addition, the three Providers should work toward encouraging their Panelists to include more information on the evidence Complainants have introduced to prove that the Registrant is a cybersquatter, as well as the defenses the Respondents have put forth. Presently, at least two-thirds of the cases do not adequately explain how the Panelists were able to find bad faith or no legitimate interest, and on what evidence the finding was based. Instead, many of the cases look like a recitation of what the Rules require, with the Complainant or Respondent's name placed before it, and no real analysis.

The rules and policies of ICANN make it a potentially inexpensive way for trademark and domain name owners to settle their differences. However, as long as the providers are dependent on getting their fees from Complainants, and thus have an interest in keeping Complainants happy, we are in danger of having a biased system. While it would not be fair to require the respondent to pay the fees, ICANN should try to develop a system under which the Complainants are not the sole source of money for the Providers.

Finally, the Providers should remember that the ICANN rules and policies are about fairness above all, they are not intended simply to extend trademark law into the realm of domain names. As Judge Mueller stated in his dissent in Hearst Communications, Inc. v. Spencer:196

The majority panelists have decided – without any direct evidence – that [Respondent's] sole original intent was to sell the name to Esquire Magazine. When faced with the clear fact that [Respondent] sold the name to someone else, they say that this sale is invalid because of [Respondent's] imputed original intent. The argument is entirely circular, and has no validity. The UDRP is intended to prevent trademark owners from being extorted by cybersquatters, but it is also intended to protect legitimate registrations from being threatened by overreaching trademark owners. A correct application of the spirit and letter of the UDRP gives each of these concerns equal weight. The majority opinion fails to balance these concerns.197

Professor Froomkin also expresses concern:
The majority... decides that respondent's sworn affidavit is not credible on the apparent grounds that this testimony regarding his daughter from someone with 1300 domains, many of which appear to overlap trademarks, is inherently incredible. Although this

197. Id. (emphasis added).
reasoning has the attraction of rough justice, it comes dangerously close to making cybersquatting a status offense rather than one that the UDRP instructs us must be based on conduct.¹⁹⁸

These reminders and warnings should be heeded by all the Panelists, Parties, and Providers in future proceedings.

VIII
Author’s Note

Since this Article was originally written in late May 2000 many more cases have been filed and decisions have been handed down. The UDRP appears to be well used based on the numbers. To date, almost 2,300 complaints have been filed, representing nearly 4,200 disputed domain names.¹⁹⁹

Of these complaints, 1,543 have resulted in decisions by the panelists, 518 are undisposed of, and 227 were disposed of without decision (usually by dismissal without prejudice).²⁰⁰ Of the 1,543 decisions, 1201 resulted in transfers of domain names, 16 domain name cancellations, 314 decisions for respondent, and 11 split decisions.²⁰¹ These numbers reflect the same percentages of approximately 80% of cases being decided for complainants, with 20% in the respondents’ favor.

In addition, ICANN has approved an additional Dispute Resolution Provider: CPR Institute for Dispute Resolution (“CPR”). For the sake of completeness, this Article will provide a summary of each of the Dispute Resolution Providers’ numbers as of the last review of this Article before publication.

A. WIPO

Since January 14, 2000 WIPO has had 1,580 complaints filed with its Dispute Resolution Provider.²⁰² Approximately 449 of these complaints are currently pending and 394 were withdrawn or settled.²⁰³ Of the 738 decisions, 591 called for the transfer of the

²⁰⁰. See id.
²⁰¹. See id.
²⁰³. See id.
domain name(s), 6 for the cancellation of the domain name, 1 split
decision, and 140 were in favor of the respondent.\textsuperscript{204}

WIPO's panelists now number 188. The breakdown by nation is
as follows: Argentina (2); Australia (8); Austria (2); Belgium (2);
Brazil (5); Canada (12); Chile (1); China (1); Colombia (1); Czech
Republic (2); Denmark (1); Ecuador (1); Egypt (3); France (11);
Germany (6); Ghana (2); Greece (1); Hungary (1); India (3); Ireland
(1); Israel (2); Italy (7); Jamaica (2); Japan (4); Malaysia (1); Mexico
(4); Netherlands (2); New Zealand (6); Portugal (1); Republic of
Korea (3); South Africa (2); Spain (5); Sweden (4); Switzerland (9);
Uganda (1); United Kingdom (14); and United States (55).\textsuperscript{205} This is
by far the most diverse of the Providers.

As of late October 2000, approximately half (801) of the
complaints filed were by and against United States citizens.\textsuperscript{206} The
second largest number of complaints were filed by citizens of the
United Kingdom (153), followed by France (96).\textsuperscript{207} While the
Panelists are becoming more international, the process itself is still
largely used by Americans.

Finally, the fees for bringing a complaint with WIPO have
increased. Each of the fees have gone up by $500 per class.\textsuperscript{208}
Therefore, a complaint including one to five domain names before a
single panelist would cost $1500; and before three panelists $3000. A
complaint including six to ten domain names before a single panelist
costs $2000; and before three panelists $4000.

B. National Arbitration Forum

NAF has had 728 complaints filed since January 11, 2000.\textsuperscript{209} Of
these, fifty-four are currently pending.\textsuperscript{210} A total of 486 complaints
resulted in the transfer of the domain name(s), eleven resulted in
cancellation, one was a split decision, and 104 were in the

\textsuperscript{204} See id.

\textsuperscript{205} See WIPO, WIPO Domain Name Panelists (last modified Nov. 20, 2000)
<http://arbiter.wipo.int/domains/panel/panelists.html>.

\textsuperscript{206} See WIPO, Geographical Distribution of Parties (last modified Nov. 22, 2000)

\textsuperscript{207} See id.

\textsuperscript{208} See WIPO, Schedule of Fees Under the ICANN Policy (last modified Aug. 15,

\textsuperscript{209} See NAF, Pending Domain Name Dispute Proceedings and Decisions in the

\textsuperscript{210} See id.
respondents’ favor. Again, approximately three-quarters of complaints result in the transfer of domain names.

NAF is working towards making its panelist pool more international in scope. The country representation among NAF’s member panel pool includes: Argentina (1); Australia (1); Belgium (1); Brazil (3); Canada (5); Colombia (1); Denmark (1); France (2); Hungary (1); India (1); Japan (1); Korea (1); Malaysia (1); New Zealand (1); Puerto Rico (1); Switzerland (2); Uganda (1); United Kingdom (2); United States (76); Vietnam (1).

Finally, NAF’s fees have not changed.

C. eResolution

eResolution’s docket has grown significantly between May and November 2000. eResolution now has over 200 cases currently pending or decided. Of the Panelist’s decisions, eighty-five resulted in transfer, one was transferred, and fifty-four were for respondent. Finally, fourteen cases were settled before a Panel’s decision was issued, and four were abandoned by complainant.

eResolution now claims eighty-eight panelists. The pool of panelists has expanded in its international representation. The current breakdown of panelists by country is as follows: Australia (2); Belgium (1); Brazil (1); Canada (17); China (2); Colombia (1); Denmark (1); Finland (1); France (5); Germany (1); Ireland (1); Israel (1); Italy (3); Switzerland (1); Uganda (1); United Kingdom (2); United States (45).

The fees a complainant must pay have increased significantly. In addition, eResolution has changed the number of domain names that may be included in a complaint. The new fee schedule is broken down as follows:

One to two domain names:

Single Panelist: $1250 [Panelist: $1000; Center: $250]

Three Panelists: $2900 [President: $1000; Co-Panelist: $750;

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211. See id.
214. See id.
215. See id.
217. See id.
Center: $400
  Three to six domain names:
    Single Panelist: $1500 [Panelist: $1200; Center: $300]
    Three Panelists: $3250 [President: $1200; Co-Panelist: $800; Center: $450]
  Seven to ten domain names:
    Single Panelist: $1850 [Panelist: $1500; Center: $350]
    Three Panelists: $3900 [President: $1500; Co-Panelist: $950; Center: $500]
  Eleven to fifteen domain names:
    Single Panelist: $2300 [Panelist: $1800; Center: $500]
    Three Panelists: $4600 [President: $1800; Co-Panelist: $1100; Center: $600]
  More than fifteen domain names:
    Single Panelist: To be discussed with the Clerk’s office
    Three Panelists: To be discussed with the Clerk’s office. 218

D. **CPR Institute for Dispute Resolution**

1. **Supplemental Rules**

   The CPR Supplemental Rules include very few changes to ICANN’s Rules. 219 The Supplemental Rules adopt all definitions set forth in the Rules. The Supplemental Rules do, in addition, provide for several interesting new provisions to the ICANN Rules. Both the Complainant and the Respondent are subject to a ten-page limit, not including annexed materials and exhibits. 220 In addition, CPR has provided an amendment to the General Powers of the Panel section of the Rules, stating that “[t]he Panel shall have the authority to determine challenges to its jurisdiction and procedural challenges arising from the Rules or these Supplemental Rules. Challenges to the impartiality, integrity or independence of a Panelist shall be determined by an officer of CPR.” 221 Finally, CPR provides additional language to the Exclusion of Liability section of the Rules. Here, the Supplemental Rules exclude any member of a Panel and

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220. See id. at ¶¶ 4, 5.

221. Id. at ¶ 9.
CPR from liability to a party, registrar or ICANN for "any act or omission in connection with any administrative proceeding."  

2. Panelists

CPR currently claims thirty-two panelists. These Panelists have varying backgrounds. However, the vast majority (26) are attorneys. The panelists’ geographical diversity follows in the footsteps of the earlier NAF and eResolution panels and breaks down as follows: United States (28); Canada (1); China (1); Spain (1); and Australia (1). The biographies of the panelists are available on CPR’s website.

3. Fees

The Center sets forth fees based on the type of Panel (single Panelist v. three Panelists), and the number of domain names included in the complaint. The fees are broken down, in U.S. dollars, as follows:

One to two domain names:
- Single Panelist: $2000 [Panelist: $1000; Center: $1000]
- Three Panelists: $4500 [Panelist: $1500; Center $1000]

Three to five domain names:
- Single Panelist: $2500 [Panelist: $1500; Center: $1000]
- Three Panelists: $6000 [Panelist: $1500; Center $1500]

More than six:
- Single Panelist: To be decided in consultation with CPR, plus $1000 to CPR
- Three Panelists: To be decided in consultation with CPR, plus $1500 to CPR  

4. Pending Decisions

CPR accepted its first filing on June 13, 2000. CPR was limited to twenty proceedings for each of the first two months of its operation by ICANN, yet has had only sixteen complaints filed since June 13,
Of the sixteen complaints filed, seven are currently pending, six resulted in transfers in full, one was a partial transfer and partial denial of transfer, and two were for respondent in full.\textsuperscript{229}

This alternative to litigation appears to have grabbed the attention of many trademark registrants. Over the course of eleven months, the UDRP has seen 2,288 complaints filed representing 4,167 disputed domain names.

The issues raised in this Article are still relevant to the future of the UDRP. The cases seen thus far only deal with three TLDs. With the addition of seven new TLDs, the potential flood of complaints is sure to cause a re-evaluation of the policies and rules of each of the Dispute Resolution Providers. It is the author's hope that the four Providers – and any others that come along – keep in mind Judge Mueller and Professor Froomkin's reminders regarding the intent behind the Uniform Domain Name Dispute Resolution Policy.