

# **WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Overview 3.0”)**

**(including additional filing resources)**

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## INTRODUCTION

***Resulting from WIPO's care for effective remedies under a sustainable UDRP, this WIPO Jurisprudential Overview reflects, and assists the predictability of, UDRP decisions by panels appointed in WIPO cases.***

The World Wide Web in 2014 celebrated its **25th anniversary**. Its ubiquity both as a commercial medium – facilitating trillions of dollars in trade annually – and as a means of disseminating information globally is self-evident. Sometimes heralded as one of mankind's greatest innovations, for all of its positive attributes, even looking back to its early days the Internet has also provided a platform for a range of bad-faith practices across territorial borders including Intellectual Property infringement.

To help maintain the overall integrity of the Internet's Domain Name System (DNS), at the **request of the United States Government** supported by all Member States, in 1999 following **an extensive process of international consultations**, the World Intellectual Property Organization (WIPO) created the Uniform Domain Name Dispute Resolution Policy (UDRP) to address cross-border trademark-abusive domain name registrations, a practice widely known as cybersquatting. Adopted by ICANN as a much needed standardized alternative to multi-jurisdictional court litigation, the UDRP provides an efficient remedy for brand owners and predictability for domainers, fosters consumer protection for end users, and acts as a safe harbor for DNS registration authorities. As a globally recognized best-practice, it is also the basis for a significant number of country code top-level domain (ccTLD) dispute resolution policies.

Since creating the **blueprint for the UDRP**, WIPO as of early 2017 has processed over 37,000 UDRP-based cases decided by nearly 500 experts covering some 65 nationalities and 21 languages, and involving parties from over 175 countries.

As the DNS expands, including as an engine for economic growth, and further to ICANN's approval of scores of new Top Level Domains, the potential for cybersquatting and resulting consumer harm persists – making WIPO's not-for-profit institutional investment in continued UDRP predictability, for all DNS stakeholders, all the more important.

In furtherance of transparency and accessibility, this WIPO investment includes a keyword-searchable Legal Index of WIPO UDRP Panel Decisions, a full-text search facility on all posted decisions, real-time WIPO case statistics, UDRP training Workshops, WIPO Panelists Meetings, and this WIPO Jurisprudential Overview. Beyond these resources, WIPO has successfully initiated paperless e-filing, case language, and settlement practices.

Understanding the relationship between UDRP operations and policy, WIPO notes that the fabric of UDRP jurisprudence, carefully woven over many years, can easily be torn apart. It is hoped that as ICANN embarks on a review of the UDRP, resources such as this WIPO Jurisprudential Overview 3.0 assist responsible decision-making that works for all DNS stakeholders.

Under the UDRP, decision-making authority rests exclusively with the appointed external panels, based on the facts and circumstances of each case. While the UDRP does not operate on a strict doctrine of binding precedent, it is important for the overall credibility of the UDRP system that filing parties can reasonably anticipate the result of their case. Often noting the existence of similar facts and circumstances or identifying distinguishing factors, WIPO panels strive for consistency with prior decisions. In so doing, WIPO panels seek to ensure that the UDRP operates in a fair and predictable manner for all stakeholders while also retaining sufficient flexibility to address evolving Internet and domain name practices.

With this collective aim, the WIPO Arbitration and Mediation Center has produced the present WIPO Jurisprudential Overview version 3.0, to summarize consensus panel views on a range of common and important substantive and procedural issues. Following a review of thousands of WIPO panel decisions issued since WIPO Overview 2.0, this edition has been updated to now include express references to over 800 representative decisions (formerly 380) from over 250 (formerly 180) WIPO panelists. The number of cases managed by the WIPO Center has nearly doubled since its publication of WIPO Overview 2.0; as a result, the number of issues covered in this WIPO Jurisprudential Overview 3.0 has significantly increased to reflect a range of incremental DNS and UDRP case evolutions.

While the overall purpose of the WIPO Jurisprudential Overview is to assist in predictability, it is important to point out that – as with any legal system – differences of opinion may exist on some specific issues and in certain outlier cases; all the more so as the UDRP operates across fact patterns and jurisdictions. Furthermore, neither this WIPO Jurisprudential Overview nor prior UDRP decisions are strictly binding on panelists, who will consider the particular facts and circumstances of each individual proceeding in a manner they consider fair. At the same time, panel findings tend to fall within the views summarized in this WIPO Jurisprudential Overview 3.0. Finally, parties should note that the WIPO Jurisprudential Overview cannot serve as a substitution for each party’s obligation to argue and establish their particular case under the UDRP, and it remains the responsibility of each party to make its own independent assessment of prior decisions relevant to its case.

The consensus views laid out in this WIPO Jurisprudential Overview 3.0 have been welcomed by UDRP Panelists inter alia at WIPO’s Panelists Meetings convened in Geneva through 2016. The contents reflect the Meetings’ constructive dialogue, as well as substantial contribution and informal review from a number of the most experienced WIPO panelists. As WIPO UDRP jurisprudence matures, the WIPO Center, in consultation with its panelists, will on appropriate occasions consider undertaking further updates in whole or in part to this WIPO Jurisprudential Overview 3.0. (The [original edition](#) and [WIPO Overview 2.0](#) will continue to be accessible on the WIPO Center’s website for reference.)

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## FIRST UDRP ELEMENT

### 1.1 What type of trademark rights are encompassed by the expression “trademark or service mark in which the complainant has rights” in UDRP paragraph 4(a)(i)?

1.1.1 The term “trademark or service mark” as used in UDRP paragraph 4(a)(i) encompasses both registered and unregistered (sometimes referred to as common law) marks.

1.1.2 Noting in particular the global nature of the Internet and Domain Name System, the jurisdiction(s) where the trademark is valid is not considered relevant to panel assessment under the first element.

Also, the goods and/or services for which the mark is registered or used in commerce, the filing/priority date, date of registration, and date of claimed first use, are not considered relevant to the first element test. These factors may however bear on a panel’s further substantive determination under the second and third elements.

1.1.3 While the UDRP makes no specific reference to the date on which the holder of the trademark or service mark acquired its rights, such rights must be in existence at the time the complaint is filed.

The fact that a domain name may have been registered before a complainant has acquired trademark rights does not by itself preclude a complainant’s standing to file a UDRP case, nor a panel’s finding of identity or confusing similarity under the first element.

Where a domain name has been registered before a complainant has acquired trademark rights, only in exceptional cases would a complainant be able to prove a respondent’s bad faith.

1.1.4 A pending trademark application would not by itself establish trademark rights within the meaning of UDRP paragraph 4(a)(i).

[See sections 3.1, 3.2.1, and 3.8 generally.]

#### 1.1.1 Relevant decisions

*Uniroyal Engineered Products, Inc. v. Nauga Network Services*,  
WIPO Case No. **D2000-0503**, <nauga.net> et al., Transfer

*Thaigem Global Marketing Limited v. Sanchai Aree*,  
WIPO Case No. **D2002-0358**, <thaigem.net>, Transfer

*Fine Tubes Limited v. Tobias Kirch, J. & J. Ethen, Ethen Rohre GmbH*,  
WIPO Case No. **D2012-2211**, <fine-tubes.com>, Denied

*Tesar Industrial Contractors, Inc. v. Boris Santana*,  
WIPO Case No. **D2014-0960**, <tesarindustrial.com>, Transfer

*Generate4 Schools, LLC v. Privacyguardian.org / MiCamp Merchant Services*,  
WIPO Case No. **D2014-1009**, <generate4u.org>, Transfer

*Money Tree Software, Ltd. v. Javier Martinez, Money Tree Software, LLC*,  
WIPO Case No. **D2014-1078**, <moneytreesoftware.com>, Transfer

*Lindeva Living Trust, Kim W. Lu Trustee v. Domain Privacy Service FBO Registrant / 510 Pacific Ave, Pacific Venice*, WIPO Case No. **D2015-1105**, <510pacificave.com>, Denied

### 1.1.2 Relevant decisions

*F. Hoffmann-La Roche AG v. Relish Enterprises*,  
WIPO Case No. **D2007-1629**, <xenicalla.com>, Transfer

*Drugstore.com, Inc. v. Nurhul Chee / Robert Murry*,  
WIPO Case No. **D2008-0230**, <drugstoretm.com>, Denied with Dissenting Opinion

*Office Holdings Limited v. Hocu To d.o.o. and Office Shoes d.o.o.*,  
WIPO Case No. **D2009-1277**, <officeshoesonline.com>, Denied

*RapidShare AG and Christian Schmid v. majeed randi*,  
WIPO Case No. **D2010-1089**, <rapidpiracy.com>, Transfer

*Reckon Limited v. Multitech s.r.l.*,  
WIPO Case No. **D2013-1017**, <reckon.com>, Denied

*CeltonManx Limited v. Pham Dinh Nhut*,  
WIPO Case No. **D2014-0109**, <sbobet.net>, Transfer

*Etechaces Marketing and Consulting Private Limited v. Bhargav Chokshi / IR Financial Services Pvt. Ltd.*, WIPO Case No. **D2015-0563**, <onlinepolicybazaar.com>, Transfer

*Tozzini, Freire, Teixeira e Silva Advogados v. Ernesto Siempro*,  
WIPO Case No. **D2015-1002**, <tozzini-freire.com>, Transfer

*Guinness World Records Limited v. Solution Studio*,  
WIPO Case No. **D2016-0186**, <guinnessworldrecords.xyz>, Transfer

*Assurances Premium SARL v. Whois Privacy Shield Services / Daisuke Yamaguchi*,  
WIPO Case No. **D2016-1425**, <mascotte-assurances.com>, Transfer

### 1.1.3 Relevant decisions

*Digital Vision, Ltd. v. Advanced Chemill Systems*,  
WIPO Case No. **D2001-0827**, <digitalvision.com>, Denied

*Madrid 2012, S.A. v. Scott Martin-MadridMan Websites*,  
WIPO Case No. **D2003-0598**, <2m12.com> et al., Transfer

*Stoneygate 48 Limited and Wayne Mark Rooney v. Huw Marshall*,  
WIPO Case No. **D2006-0916**, <waynerooney.com>, Transfer

*Esquire Innovations, Inc. v. Iscrub.com c/o Whois Identity Shield; and Vertical Axis, Inc, Domain Administrator*, WIPO Case No. **D2007-0856**, <iscrub.com>, Transfer

*The State of Tennessee, USA v. (DOMAIN NAME 4 SALE) DOMAIN-NAME-4-SALE eMAIL baricci@attglobal.net*, WIPO Case No. **D2008-0640**, <coverkids.com>, Denied

*Reckitt Benckiser Plc v. Eunsook Wi*, WIPO Case No. **D2009-0239**, <rb.net>, Denied

*QIQ Communications Pty Ltd v. Netico, Inc.*, WIPO Case No. **D2014-1024**, <qiq.com>, Denied

*Naviswiss AG v. inLink GmbH*,  
WIPO Case No. **D2016-2339**, <naviswiss.com>, Denied

*Bayer AG v. Whois Agent, Whois Privacy Protection Service, Inc. / Syed Hussain, IBN7 Media Group*, WIPO Case No. **D2016-2354**, <bayermonsanto.com>, Transfer

*MAS S.A.S. v. Joseph Kattampally*,  
WIPO Case No. **D2016-2408**, <maaji.com>, Denied

*Greenvelope, LLC v. Virtual Services Corporation*,  
WIPO Case No. **D2017-0006**, <greenenvelope.com>, Denied

### 1.1.4 Relevant decisions

*Lion Country Supply, Inc. v. J. Katz*,  
WIPO Case No. **D2003-0106**, <lioncountrysupply.com>, Transfer

*PC Mall, Inc. v. Pygmy Computer Systems, Inc.*,  
WIPO Case No. **D2004-0437**, <mobile-mall.com> et al., Denied

*Displays Depot, Inc. v. GNO, Inc.*,  
WIPO Case No. **D2006-0445**, <displaydepot.com>, Denied

*Advance News Service Inc. v. Vertical Axis, Inc. / Religionnewsservice.com*,  
WIPO Case No. **D2008-1475**, <religionnewsservice.com>, Denied

*Mario Rodriguez BBS Technologies, Inc. v. Guangzhou Tianji Technology Co. Ltd Pengfei Zhang*, WIPO Case No. **D2009-0477**, <shadygrovefertilitycenter.com> et al., Denied

*537397 Ontario Inc. operating as Tech Sales Co. v. EXAIR Corporation*,  
WIPO Case No. **D2009-0567**, <nexflow.com> et al., Transfer

*No Zebra Network Ltda v. Baixaki.com, Inc.*,  
WIPO Case No. **D2009-1071**, <baixaki.com>, Transfer

*Prom Night Events v. YourFormal Pty Ltd / Your Formal Australia Pty Ltd, Samir Kapoor*,  
WIPO Case No. **D2011-1707**, <adelaidepromnight.com> et al., Denied

*Kemosabe Entertainment, LLC v. Mike Nazzaro*,  
WIPO Case No. **D2012-1893**, <kemosaberecords.com>, Denied

*Mark C. Spicher v. Froggi Design, s.r.o. / The Artwork Factory, s.r.o.*,  
WIPO Case No. **D2015-0606**, <the-artwork-factory.com>, Denied

*Intellect Design Arena Limited v. Moniker Privacy Services / David Wieland, iEstates.com, LLC*, WIPO Case No. **D2016-1349**, <unmail.com>, Denied

## 1.2 Do registered trademarks automatically confer standing to file a UDRP case?

- 1.2.1 Where the complainant holds a nationally or regionally registered trademark or service mark, this prima facie satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case.
- 1.2.2 Complainants relying on trademark registrations listed solely on the USPTO Supplemental Register are expected to show secondary meaning in order to establish trademark rights under the Policy because under US law a supplemental registration does not by itself provide evidence of distinctiveness to support trademark rights. Even where such standing is established, panels may scrutinize the degree of deference owed to such marks in assessing the second and third elements.

When considering UDRP standing, panels tend to carefully review certain types of automatic/unexamined registered trademarks such as US state registrations (as opposed to US federal registrations); these are not accorded the same deference and may not on their own satisfy the UDRP’s “rights in a mark” standing test.

- 1.2.3 Subject to considerations addressed in section 1.10 below, trademark registrations with design elements or disclaimed terms typically would not affect panel assessment of standing or identity/confusing similarity under the UDRP, but may be relevant to panel assessment of the second and third elements. However, if the similar elements of the domain name are made up exclusively of disclaimed terms, trademark rights under the Policy may not be found unless the complainant can show sufficient secondary meaning in the disclaimed terms.

[See also section 1.10.]

### 1.2.1 Relevant decisions

*Integrated Print Solutions, Inc. v. Kelly Davidson and Integrated Print Solutions*,  
WIPO Case No. **D2013-0219**, <integratedprintsolutions.com>, Denied

*Scentco, Inc., Christopher Cote v. Domain Discreet Privacy Service / Vincent Poloma Pet Nutritional Research*, WIPO Case No. **D2014-0401**, <smanimals.com>, Denied

*Advance Magazine Publishers Inc., Les Publications Conde Nast S.A. v. Voguechen*,  
WIPO Case No. **D2014-0657**, <voguepromdresses.com>, Transfer  
*Horten Advokatpartnerselskab v. Domain ID Shield Service CO., Limited / Krutikov Valeriy  
Nikolaevich*, WIPO Case No. **D2016-0205**, <horten-canada.com>, Transfer  
*Starpixel Marketing LLC dba Vape Magazine v. Geoffrey Stonham*,  
WIPO Case No. **D2016-0773**, <vapemagazine.com>, Denied  
*Tinynova LLC v. Chris Edwards, Orion Interactive*,  
WIPO Case No. **D2016-0804**, <backit.com>, Denied  
*VKR Holding A/S v. Li Pinglong*,  
WIPO Case No. **D2016-2269**, <wxvelux.com>, Transfer

### 1.2.2 Relevant decisions

*Teresa Christie, d/b/a The Mackinac Island Florist v. James Porcaro, d/b/a Weber's Mackinac  
Island Florist*, WIPO Case No. **D2001-0653**, <mackinacislandflorist.com> et al., Transfer  
*The New England Vein & Laser Center, P.C. v. Vein Centers for Excellence, Inc.*,  
WIPO Case No. **D2005-1318**, <newenglandveincenter.com>, Transfer  
*Paul McMann v. J McEachern*,  
WIPO Case No. **D2007-1597**, <paulmcmann.com>, and <paulmcmannsucks.com>, Denied  
*Bouncing Bear Botanicals, Inc. v. International Domain Name and Protection, LLC.*,  
WIPO Case No. **D2011-1243**, <k2incenseblend.com> et al., Denied  
*Tarheel Take-Out, LLC v. Versimedia, Inc.*,  
WIPO Case No. **D2012-1668**, <takeout.com>, Denied  
*South Fork Hardware, Inc., DBA TireChain.com v. Vulcan Sales, Inc., DBA Vulcan Tire Sales*,  
WIPO Case No. **D2013-0199**, <tirechian.com> and <tirechians.com>, Denied  
*Win Kelly Chevrolet L.L.C. v. PrivacyProtect.org / Tech Domain Services Private Limited*,  
WIPO Case No. **D2013-2018**, <winnkelly.com>, Transfer  
*Jewelry Candles, LLC v. Micah Buse of WebsiteVM - Domain Management, Louisville  
Marketing, Inc., d/b/a Jewelry In Candles, LLC*,  
WIPO Case No. **D2014-2203**, <jewelryincandles.com>, Denied  
*Mark C. Spicher v. Frogi Design, s.r.o. / The Artwork Factory, s.r.o.*,  
WIPO Case No. **D2015-0606**, <the-artwork-factory.com>, Denied

### 1.2.3 Relevant decisions

*Jobs on the Net Limited, Andrew Middleton v. International New Media Limited*,  
WIPO Case No. **D2011-1531**, <nannyjob.com>, Denied with Dissenting Opinion  
*Marco Aurich v. Johannes Kuehrer, World4You Webservice*,  
WIPO Case No. **D2012-1147**, <domainhoster.info>, Denied  
*Çelik Motor Ticaret A.S. v. ONUNO L.L.C.*,  
WIPO Case No. **D2015-0369**, <çelikmotorfilo.com> [xn--elikmotorfilo-hgb.com>], Transfer  
*Major Wire Industries Limited v. DigitalOne AG*,  
WIPO Case No. **D2015-0284**, <major.com>, Denied  
*Career Group, Inc. v. The Career Group Ltd / Deborah Simonds*,  
WIPO Case No. **D2014-1296**, <careergroup.com>, Denied  
*Liberty Utilities (America) Co. v. Christopher Ohrstrom*,  
WIPO Case No. **D2016-2062**, <libertyenergytrust.com>, Denied  
*Das Telefonbuch Zeichen-GbR v. Yajun Zhang*,  
WIPO Case No. **D2016-2228**, <dastelefonbuch.top>, Transfer

### 1.3 What does a complainant need to show to successfully assert unregistered or common law trademark rights?

To establish unregistered or common law trademark rights for purposes of the UDRP, the complainant must show that its mark has become a distinctive identifier which consumers associate with the complainant's goods and/or services.

Relevant evidence demonstrating such acquired distinctiveness (also referred to as secondary meaning) includes a range of factors such as (i) the duration and nature of use of the mark, (ii) the amount of sales under the mark, (iii) the nature and extent of advertising using the mark, (iv) the degree of actual public (e.g., consumer, industry, media) recognition, and (v) consumer surveys.

(Particularly with regard to brands acquiring relatively rapid recognition due to a significant Internet presence, panels have also been considering factors such as the type and scope of market activities and the nature of the complainant's goods and/or services.)

Specific evidence supporting assertions of acquired distinctiveness should be included in the complaint; conclusory allegations of unregistered or common law rights, even if undisputed in the particular UDRP case, would not normally suffice to show secondary meaning. In cases involving unregistered or common law marks that are comprised solely of descriptive terms which are not inherently distinctive, there is a greater onus on the complainant to present evidence of acquired distinctiveness/secondary meaning.

As noted in section 1.1.2, for a number of reasons, including the global nature of the Internet and Domain Name System, the fact that secondary meaning may only exist in a particular geographical area or market niche does not preclude the complainant from establishing trademark rights (and as a result, standing) under the UDRP.

Also noting the availability of trademark-like protection under certain national legal doctrines (e.g., unfair competition or passing-off) and considerations of parity, where acquired distinctiveness/secondary meaning is demonstrated in a particular UDRP case, unregistered rights have been found to support standing to proceed with a UDRP case including where the complainant is based in a civil law jurisdiction.

The fact that a respondent is shown to have been targeting the complainant's mark (e.g., based on the manner in which the related website is used) may support the complainant's assertion that its mark has achieved significance as a source identifier.

Even where a panel finds that a complainant has UDRP standing based on unregistered or common law trademark rights, the strength of the complainant's mark may be considered relevant in evaluating the second and third elements.

[See also sections 3.2 and 3.8 generally.]

#### Relevant decisions

*Uitgeverij Crux v. W. Frederic Isler*,  
WIPO Case No. **D2000-0575**, <crux.net>, Transfer

*Skattedirektoratet v. Eivind Nag*,  
WIPO Case No. **D2000-1314**, <skatteetaten.com>, Transfer

*Amsec Enterprises, L.C. v. Sharon McCall*,  
WIPO Case No. **D2001-0083**, <backgroundfacts.com>, Denied

*Australian Trade Commission v. Matthew Reader*,  
WIPO Case No. [D2002-0786](#), <austrade.com>, Transfer

*Imperial College v. Christophe Dessimoz*,  
WIPO Case No. [D2004-0322](#), <idealeague.com> et al., Transfer

*Julie & Jason, Inc. d/b/a The Mah Jongg Maven v. Faye Scher d/b/a Where the Winds Blow*,  
WIPO Case No. [D2005-0073](#), <themahjonggmaven.com>, Transfer

*Alpine Entertainment Group, Inc. v. Walter Alvarez*,  
WIPO Case No. [D2006-1392](#), <realspanking.com>, Denied

*Fairview Commercial Lending, Inc. v. Aleksandra Pesalj*,  
WIPO Case No. [D2007-0123](#), <fairviewlending.org>, Transfer

*The Carphone Warehouse Limited and The Phone House B.V. v. Navigation Catalyst Systems, Inc.*, WIPO Case No. [D2008-0483](#), <thecarephonewarehouse.com> et al., Transfer, Denied in Part

*Continental Casualty Company v. Andrew Krause / Domains by Proxy, Inc.*,  
WIPO Case No. [D2008-0672](#), <continentalcasualty.com>, Denied

*Thomas Pick aka Pick Inc. v. EUROPREMIUM LTD, Elaine Maria Gross*,  
WIPO Case No. [D2008-1010](#), <bs.com>, Denied

*Mancini's Sleepworld v. LAKSH INTERNET SOLUTIONS PRIVATE LIMITED*,  
WIPO Case No. [D2008-1036](#), <mancinissleepworld.com>, Denied

*La Mafafa, Inc. dba Cultura Profética v. Domains Real Estate*,  
WIPO Case No. [D2009-0534](#), <culturaprofetica.com>, Transfer

*S.N.C. Jesta Fontainebleau v. Po Ser*,  
WIPO Case No. [D2009-1394](#), <palaisstephany.com>, Transfer

*Board of Supervisors of Louisiana State University and Agricultural and Mechanical College v. FinanceMalta v. Adriano Cefaj*, WIPO Case No. [D2011-1246](#), <financemalta.com>, Transfer

*Michael Sweep v. Douglas Berry*,  
WIPO Case No. [D2012-0651](#), <brisbaneglass.com>, Denied

*Robin Hanger v. RPM Truck & Trailer Sales - Samantha Holcomb*,  
WIPO Case No. [D2013-1092](#), <bestpricedtrailer.com>, Denied

*Roper Industries, Inc. v. VistaPrint Technologies Ltd.*,  
WIPO Case No. [D2014-1828](#), <ropenind.com>, Transfer

*Liviu Tudor v. Andra Matei*,  
WIPO Case No. [D2014-1903](#), <liviu-tudor.com>, Denied

*Roadcam, Inc. v. Jon Smejkal*,  
WIPO Case No. [D2014-1980](#), <dashcamlab.com> et al., Denied

*K-Tek Computers, Inc., d/b/a Computer Refurb v. Domains By Proxy, LLC / mail: and Fred Serhal*, WIPO Case No. [D2015-0225](#), <computerrefurb.com>, Denied

*Intellect Design Arena Limited v. Moniker Privacy Services / David Wieland, iEstates.com, LLC*, WIPO Case No. [D2016-1349](#), <unmail.com>, Denied

*Together Networks Holdings Limited v. Admin Admin / MyPengo Mobile B.V.*,  
WIPO Case No. [D2016-1350](#), <cheekydevil.com>, Denied

## **1.4 Does a trademark owner's affiliate or licensee have standing to file a UDRP complaint?**

- 1.4.1 A trademark owner's affiliate such as a subsidiary of a parent or of a holding company, or an exclusive trademark licensee, is considered to have rights in a trademark under the UDRP for purposes of standing to file a complaint.

While panels have been prepared to infer the existence of authorization to file a UDRP case based on the facts and circumstances described in the complaint, they may expect parties to provide relevant evidence of authorization to file a UDRP complaint.

In this respect, absent clear authorization from the trademark owner, a non-exclusive trademark licensee would typically not have standing to file a UDRP complaint.

- 1.4.2 Where multiple related parties have rights in the relevant mark on which a UDRP complaint is based, a UDRP complaint may be brought by any one party, on behalf of the other interested parties; in such case, the complainant(s) may wish to specify to which of such named interested parties any transfer decision should be directed.

[See also section 4.11.1.]

#### 1.4.1 Relevant decisions

*Telcel, C.A. v. Jerm and Jhonattan RamÁrez*,  
WIPO Case No. [D2002-0309](#), <telcelbellsouth.com>, Transfer

*Toyota Motor Sales U.S.A. Inc. v. J. Alexis Productions*,  
WIPO Case No. [D2003-0624](#), <lexusmichaels.com>, Denied

*Grupo Televisa, S.A., Televisa, S.A. de C.V., Estrategia Televisa, S.A. de C.V., Videoserpel, Ltd. v. Party Night Inc., a/k/a Peter Carrington*,  
WIPO Case No. [D2003-0796](#), <televisadeporte.com>, Transfer

*Spherion Corporation v. Peter Carrington, d/b/a Party Night Inc.*,  
WIPO Case No. [D2003-1027](#), <shperion.com>, Transfer

*Teva Pharmaceutical USA, Inc. v. US Online Pharmacies*,  
WIPO Case No. [D2007-0368](#), <adipex-p.com>, Transfer

*Komatsu Deutschland GmbH v. Ali Osman / ANS*,  
WIPO Case No. [D2009-0107](#), <komatsugermany.com> et al., Transfer

*Allianz Sigorta A.S v. Efe Sancak*,  
WIPO Case No. [D2011-0111](#), <allianzemeklilik.com> and <allianzsigorta.com>, Transfer

*RGM Trading, LLC v. rgm-trading.com, RGM-Trading / Ronald Perry, rgmthk.com, RGM-Trading / Bushan Shimpi*, WIPO Case No. [D2012-1049](#), <rgm-trading.com> and <rgmthk.com>, Transfer

*Volkswagen Group of America, Inc. v. Kim Hyeonsuk a.k.a. Kim H. Suk, Domain Bar, Young N. and Kang M.N.*, WIPO Case No. [D2014-1596](#), <audiplus.com> et al., Transfer

*NA PALI SAS v. BWI Domains, Domain Manager*,  
WIPO Case No. [D2008-1859](#), <quiksilverstore.com>, Denied

*BSH Home Appliances Corporation v. Michael Stanley / Michael Sipo*,  
WIPO Case No. [D2014-1433](#), <boschappliancepro.info> et al., Transfer

*Mahendra Singh Dhoni and Rhiti Sports Management Private Limited v. David Hanley*,  
WIPO Case No. [D2016-1692](#), <msdhoni.com>, Transfer

*Taylor Wimpey Holdings Limited and Taylor Wimpey PLC v. Annette Johnson, Tangerineuk*,  
WIPO Case No. [D2016-2116](#), <tay1orwimpey.com>, Transfer

#### 1.4.2 Relevant decisions

*National Dial A Word Registry Pty Ltd and others v. 1300 Directory Pty Ltd*,  
WIPO Case No. [DAU2008-0021](#), <13cars.com.au> et al., Denied

*Fulham Football Club (1987) Limited, Tottenham Hotspur Public Limited, West Ham United Football Club PLC, Manchester United Limited, The Liverpool Football Club And Athletic Grounds Limited v. Domains by Proxy, Inc./ Official Tickets Ltd*,  
WIPO Case No. [D2009-0331](#) <official-fulham-tickets.com> et al., Transfer

*Boot Royalty Company, L.P., Justin Brands, Inc. v. Dauben, Inc. d/b/a Texas International Property Associates - NA NA*, WIPO Case No. [D2010-1090](#), <justinshoes.com>, Transfer

*Cantor Fitzgerald Securities, Cantor Index Limited v. Mark Mark, Chen Xian Sheng/Whois Protect*, WIPO Case No. [D2014-0125](#), <cantorforex.com> and <cantorindexforex.com>, Transfer

*“Dr. Martens” International Trading GmbH, “Dr. Maertens” Marketing GmbH v. Posers/Philip Cox*, WIPO Case No. [D2011-1142](#), <drmartens-losangeles.com> et al., Transfer

*Expedia Inc. and Hotels.com L.P. v. Arabia Horizons Tours LLC*, WIPO Case No. [DAE2014-0005](#), <expedia.co.ae> and <hotels.co.ae>, Transfer

*Mr. Itay Hasid and Mr. Daniel Assis v. Asha Hussein*, WIPO Case No. [D2015-1026](#), <mobeego.com>, Transfer

*Chicago Mercantile Exchange Inc. and CME Group Inc. v. Johnson Atru*, WIPO Case No. [D2015-1941](#), <cme clearing-eu.com>, Transfer

## **1.5 Can a complainant show UDRP-relevant rights in a personal name?**

1.5.1 Personal names that have been registered as trademarks would provide standing for a complainant to file a UDRP case.

1.5.2 The UDRP does not explicitly provide standing for personal names which are not registered or otherwise protected as trademarks. In situations however where a personal name is being used as a trademark-like identifier in trade or commerce, the complainant may be able to establish unregistered or common law rights in that name for purposes of standing to file a UDRP case where the name in question is used in commerce as a distinctive identifier of the complainant’s goods or services.

Merely having a famous name (such as a businessperson or cultural leader who has not demonstrated use of their personal name in a trademark/source-identifying sense), or making broad unsupported assertions regarding the use of such name in trade or commerce, would not likely demonstrate unregistered or common law rights for purposes of standing to file a UDRP complaint.

[See also section [1.3](#).]

### **1.5.1 Relevant decisions**

*Madonna Ciccone, p/k/a Madonna v. Dan Parisi and “Madonna.com”*, WIPO Case No. [D2000-0847](#), <madonna.com>, Transfer

*Beyoncé Knowles v. Sonny Ahuja*, WIPO Case No. [D2010-1431](#), <beyoncefragrance.com>, Transfer

*Virgin Enterprises Limited v. Larino Enterprises*, WIPO Case No. [D2013-0791](#), <richardbransoninvestment.com>, Transfer

*Khloe Kardashian, Whalerock Celebrity Subscription, LLC, Khlomoney, Inc. v. Private Registrations Aktien Gesellschaft / Privacy Protection Service Inc. d/b/a Privacyprotect.Org*, WIPO Case No. [D2015-1113](#), <khloekardashian.com>, Transfer

*Halle Berry and Bellah Brands Incorporated v. Alberta Hot Rods*, WIPO Case No. [D2016-0256](#), <halleberry.com>, Transfer

*Victoria Beckham v. David James*, WIPO Case No. [D2017-0035](#), <victoriabeckham.info>, Transfer

### **1.5.2 Relevant decisions**

*Julia Fiona Roberts v. Russell Boyd*, WIPO Case No. [D2000-0210](#), <juliaroberts.com>, Transfer

*Dr. Michael Crichton v. In Stealth Mode*,  
WIPO Case No. **D2002-0874**, <michael-crichton.com>, Transfer

*Tom Cruise v. Network Operations Center / Alberta Hot Rods*,  
WIPO Case No. **D2006-0560**, <tomcruise.com>, Transfer

*Fields for Senate v. Toddles Inc.*,  
WIPO Case No. **D2006-1510**, <virginiafields.com>, et al., Denied

*Jacques Chardeau, et al. v. MindViews, LLC*,  
WIPO Case No. **D2008-0778**, <caillebotte.com>, Denied

*Margaret C. Whitman v. Domains For Sale*,  
WIPO Case No. **D2008-1534**, <megwhitmanforgovernor.com> et al., Denied

*Jim Carrey v. BWI Domains*,  
WIPO Case No. **D2009-0563**, <jimcarrey.com>, Transfer

*Jay Leno v. Garrison Hintz*,  
WIPO Case No. **D2009-0569**, <weeknightswithjayleno.com>, Transfer

*Vanisha Mittal v. info@setrillonario.com*,  
WIPO Case No. **D2010-0810**, <vanishamittal.com>, Denied

*Ananyashree Birla v. Ali Madencioglu*,  
WIPO Case No. **D2013-1123**, <ananyashreebirla.com>, Denied

*Tracy Morgan v. Fundacion Private Whois / PPA Media Services, Ryan G Foo*,  
WIPO Case No. **D2013-0078**, <tracymorgan.com>, Transfer

*Ananyashree Birla v. Ali Madencioglu*,  
WIPO Case No. **D2013-1123**, <ananyashreebirla.com>, Denied

*Philippe Pierre Dauman v. Dinner Business*,  
WIPO Case No. **D2013-1255**, <philippepierredauman.com>, Denied

*Adam Anshel v. Domains By Proxy, LLC / Tzvi Milshtein*,  
WIPO Case No. **D2015-1570**, <adamanschel.com> et al., Transfer

*Victor Topa v. Whoisguard Protected / "Victor Topa"*,  
WIPO Case No. **D2015-2209**, <victortopa.com> and <victortopa.md>, Denied

*David Michael Bautista, Jr. v. Quantec LLC / Whois Privacy Services Pty Ltd / Lisa Katz, Domain Protection LLC*, WIPO Case No. **D2016-0397**, <davebautista.com>, Transfer

## 1.6 Can a complainant's rights in a geographical term provide standing to file a UDRP complaint?

Geographical terms used only in their ordinary geographical sense, except where registered as a trademark, would not as such provide standing to file a UDRP case.

Geographical terms which are not used solely in a geographically descriptive sense (e.g., "Nantucket Nectars" for beverages) and which are registered as a trademark, would provide standing to file a UDRP case.

Panels have exceptionally found that geographical terms which are not registered as trademarks may support standing to file a UDRP complaint if the complainant is able to show that it has rights in the term sufficient to demonstrate consumer recognition of the mark in relation to the complainant's goods or services (often referred to as secondary meaning).

Under the UDRP however, it has generally proven difficult for an entity affiliated with or responsible for a geographical area (which has not otherwise obtained a relevant trademark registration) to show unregistered trademark rights in that geographical term on the basis of secondary meaning.

[See also section 1.3.]

It is further noted that the Report of the Second WIPO Internet Domain Name Process ultimately declined to recommend specifically extending protection to geographical terms as such under the UDRP.

### Relevant decisions

*Kur- und Verkehrsverein St. Moritz v. StMoritz.com*,  
WIPO Case No. **D2000-0617**, <stmoritz.com>, Denied

*Skipton Building Society v. Peter Colman*,  
WIPO Case No. **D2000-1217**, <skipton.com>, Transfer

*Brisbane City Council v. Joyce Russ Advertising Pty Limited*,  
WIPO Case No. **D2001-0069**, <brisbane.com>, Denied

*BAA plc, Aberdeen Airport Limited v. Mr. H. Hashimi*,  
WIPO Case No. **D2004-0717**, <aberdeenairport.com>, Transfer

*Province of Brabant Wallon v. Domain Purchase, NOLDC, Inc.*,  
WIPO Case No. **D2006-0778**, <brabant-wallon.org>, Denied

*Commune of Zermatt and Zermatt Tourismus v. Activelifestyle Travel Network*,  
WIPO Case No. **D2007-1318**, <zermatt.com>, Denied

*Jumeirah International LLC, Jumeirah Beach Resort LLC v. Vertical Axis, Inc, Domain Administrator / Jumeira.com*, WIPO Case No. **D2009-0203**, <jumeira.com>, Denied

*Instra Corporation Pty Ltd v. Domain Management SPM*,  
WIPO Case No. **D2009-1097**, <asiaegistry.com> et al., Transfer

*Sentosa Development Corporation v. Jang Shih Chieh*,  
WIPO Case No. **D2010-1082**, <sentosa.com>, Transfer

*Thompson Island Outward Bound Education Center v. Larrie Noble/ Dirty Mackn Entertainment Corp*, WIPO Case No. **D2013-1144**, <thompsonisland.org>, Transfer

*Gold Coast Tourism Corporation Ltd. v. Digimedia.com L.P.*,  
WIPO Case No. **D2013-1733**, <goldcoast.com>, Denied

*Ministre des Relations internationales, de la Francophonie et du Commerce extérieur (Minister of International Relations, La Francophonie and External Trade), acting in this proceeding for and on behalf of the Government of Québec v. Anything.com, Ltd.*,  
WIPO Case No. **D2013-2181**, <quebec.com>, Denied

*Gstaad Saanenland Tourismus v. Connecting Concepts BV*,  
WIPO Case No. **D2014-1666**, <gstaadvalley.com>, Denied

*Intermountain Health Care, Inc., IHC Health Services, Inc. v. Randy Delcore*,  
WIPO Case No. **D2017-0265**, <cedarcityhospital.co> et al., Transfer

### 1.7 What is the test for identity or confusing similarity under the first element?

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the complainant's trademark and the disputed domain name.

This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name. (This may also include recognizability by technological means such as search engine algorithms.) In some cases, such assessment may also entail a more holistic aural or phonetic comparison of the complainant's trademark and the disputed domain name to ascertain confusing similarity.

While each case is judged on its own merits, in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing.

In specific limited instances, while not a replacement as such for the typical side-by-side comparison, where a panel would benefit from affirmation as to confusingly similarity with the complainant's mark, the broader case context such as website content trading off the complainant's reputation, or a pattern of multiple respondent domain names targeting the complainant's mark within the same proceeding, may support a finding of confusing similarity. On the other hand, if such website content does not obviously trade off the complainant's reputation, panels may find this relevant to an overall assessment of the case merits, especially under the second and third elements (with such panels sometimes finding it unnecessary to make a finding under the first element).

Issues such as the strength of the complainant's mark or the respondent's intent to provide its own legitimate offering of goods or services without trading off the complainant's reputation, are decided under the second and third elements. Panels view the first element as a threshold test concerning a trademark owner's standing to file a UDRP complaint, i.e., to ascertain whether there is a sufficient nexus to assess the principles captured in the second and third elements.

In this context, panels have also found that the overall facts and circumstances of a case (including relevant website content) may support a finding of confusing similarity, particularly where it appears that the respondent registered the domain name precisely because it believed that the domain name was confusingly similar to a mark held by the complainant.

[See also section [1.15](#).]

### Relevant decisions

*Fondation Le Corbusier v. Monsieur Bernard Weber, Madame Heidi Weber*,  
WIPO Case No. [D2003-0251](#), <artlecorbusier.com> et al., Denied, Transfer in Part

*Covance, Inc. and Covance Laboratories Ltd. v. The Covance Campaign*,  
WIPO Case No. [D2004-0206](#), <covancecampaign.com>, Denied

*V&S Vin & Sprit AB v. Ooar Supplies*,  
WIPO Case No. [D2004-0962](#), <absolutxxx.com>, Transfer

*Ice House America, LLC v. Ice Igloo, Inc.*,  
WIPO Case No. [D2005-0649](#), <icehouseamerica.com> et al., Transfer

*SoftCom Technology Consulting Inc. v. Olariu Romeo/Orv Fin Group S.L.*,  
WIPO Case No. [D2008-0792](#), <myhostingfree.com>, Transfer

*Harry Winston Inc. and Harry Winston S.A. v. Jennifer Katherman*,  
WIPO Case No. [D2008-1267](#), <hairywinston.com>, Denied

*project.me GmbH v. Alan Lin*,  
WIPO Case No. [DME2009-0008](#), <project.me>, Denied

*Research in Motion Limited v. One Star Global LLC*,  
WIPO Case No. [D2009-0227](#), <unofficialblackberrystore.com>, Transfer

*F. Hoffmann-La Roche AG v. P Martin*,  
WIPO Case No. [D2009-0323](#), <alli-xenical.com>, Transfer

*Hertz System, Inc. v. Kwan-ming Lee*,  
WIPO Case No. [D2009-1165](#), <hzcar.com>, Denied

*Mejeriforeningen Danish Dairy Board v. Cykon Technology Limited*,  
WIPO Case No. [D2010-0776](#), <lurpa.com>, Transfer

*RapidShare AG, Christian Schmid v. Protected Domain Services/Dmytro Gerasymenko*,  
WIPO Case No. **D2010-1071**, <rapidpedia.com>, Transfer

*Mile, Inc. v. Michael Burg*,  
WIPO Case No. **D2010-2011**, <lionsden.com>, Denied

*Rockwool International A/S v. usrockwool.com / US Rockwool LLC, formerly US Fireproofing LLC*,  
WIPO Case No. **D2013-1022**, <usrockwool.com>, Transfer

*Philip Morris USA Inc. v. Steven Scully, J&S Auto Repair*,  
WIPO Case No. **D2015-1001**, <pmcannabis.com>, Transfer

*Supercell Oy v. WhoisProxy.com Ltd / Jordan Rash, Application Automation LLC*,  
WIPO Case No. **D2015-1445**, <clashbot.org>, Transfer

*The Canadian Hockey Association and The Canadian Olympic Committee v. Lin Lin*,  
WIPO Case No. **D2016-0322**, <canadaolympichockey.com> and <canadaolympicstore.com>,  
Transfer

*Vivid Seats LLC v. Peter Smith / Domain Administrator, Domains by Proxy, LLC*,  
WIPO Case No. **D2016-1784**, <viividseats.com> et al., Transfer, Denied in Part

*VF Corporation v. Vogt Debra*,  
WIPO Case No. **D2016-2650**, <bagpakonline.com> and <eastpake.com>, Transfer

*Rae Jansen, EZ UPC v. James Johnson, EASYUPC / Whoisguard Protected, Whoisguard, Inc.*,  
WIPO Case No. **D2016-2293**, <easyupc.com>, Transfer

*Florida National University, Inc. v. Registration Private, Domains By Proxy, LLC / Toby Schwarzkopf*,  
WIPO Case No. **D2017-0138**, <floridanationaluniversityloanforgiveness.com>,  
Transfer

*Bayerische Motoren Werke AG (“BMW”) v. Registration Private, Domains By Proxy, LLC / Armands Piebalgs*,  
WIPO Case No. **D2017-0156**, <bmdecoder.com> and <bmwdecoder.com>, Transfer

*Alfred Dunhill, Inc. v. Registration Private, Domains By Proxy, LLC / Abdullah Altubayieb*,  
WIPO Case No. **D2017-0209**, <richarddunhill.com>, Transfer

## **1.8 Is a domain name consisting of a trademark and a descriptive or geographical term confusingly similar to a complainant’s trademark?**

Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. The nature of such additional term(s) may however bear on assessment of the second and third elements.

[See also section 2.5.]

### **Relevant decisions**

*Ansell Healthcare Products Inc. v. Australian Therapeutics Supplies Pty, Ltd.*,  
WIPO Case No. **D2001-0110**, <ansellcondoms.com>, Transfer

*Hachette Filipacchi Presse v. Vanilla Limited/Vanilla Inc/Domain Finance Ltd.*,  
WIPO Case No. **D2005-0587**, <naturelle.com> et al., Cancellation, Denied in Part

*eBay Inc. v. ebayMoving / Izik Apo*,  
WIPO Case No. **D2006-1307**, <ebaymoving.com>, Transfer

*Playboy Enterprises International, Inc. v. Zeynel Demirtas*,  
WIPO Case No. **D2007-0768**, <playboyturkey.com>, Transfer

*Hoffmann-La Roche Inc. v. Wei-Chun Hsia*,  
WIPO Case No. **D2008-0923**, <yourtamiflushop.com>, Transfer

*BHP Billiton Innovation Pty Ltd, BMA Alliance Coal Operations Pty Ltd v. Cameron Jackson*,  
WIPO Case No. **D2008-1338**, <auriasdiamonds.info> et al., Transfer

*TPI Holdings, Inc. v. Carmen Armengol*,  
WIPO Case No. **D2009-0361**, <autotradertransactions.com>, Transfer

*Nintendo of America Inc. v. Fernando Sascha Gutierrez*,  
WIPO Case No. **D2009-0434**, <unlimitedwiidownloads.com>, Transfer

*Sensis Pty Ltd., Telstra Corporation Limited v. Yellow Page, Yellow Page Marketing B.V.*,  
WIPO Case No. **D2010-0817**, <yellowpage-adelaide.com> et al., Denied

*Advance Magazine Publishers Inc. v. Arena International Inc.*,  
WIPO Case No. **D2011-0203**, <buyvogue.com>, Transfer

*LEGO Juris A/S v. DBA David Inc/ DomainsByProxy.com*,  
WIPO Case No. **D2011-1290**, <legoninjagokai.com>, Transfer

*Schering Corporation, a subsidiary of Merck & Co., Inc. v. Private Whois claritingeneric.com*,  
WIPO Case No. **D2012-0027**, <claritingeneric.com>, Transfer

*Google Inc. v. Shaheen Younas*,  
WIPO Case No. **D2012-1365**, <youtubeurdu.com>, Transfer

*M/s Daiwik Hotels Pvt. Ltd v. Senthil Kumaran S, Daiwik Resorts*,  
WIPO Case No. **D2015-1384**, <daiwikresorts.com>, Transfer

*F. Hoffmann-La Roche AG v. Domain Admin, Privacy Protection Service INC d/b/a PrivacyProtect.org / Conan Corrigan*,  
WIPO Case No. **D2015-2316**, <valiumuk10.com>, Transfer

*Valero Energy Corporation and Valero Marketing and Supply Company v. Valero Energy*,  
WIPO Case No. **D2017-0075**, <valeropetroleum.org>, Transfer

*BHP Billiton Innovation Pty Ltd v. Oloyi*,  
WIPO Case No. **D2017-0284**, <bhpbillitonusa.com>, Transfer

*Allianz SE v. IP Legal, Allianz Bank Limited*,  
WIPO Case No. **D2017-0287**, <allianzkenya.com>, Transfer

*The American Automobile Association, Inc. v. Cameron Jackson / PrivacyDotLink Customer 2440314*, WIPO Case No. **D2016-1671**, <aaaclub.xyz> and <theamericanautomobileassociation.xyz>, Transfer

### **1.9 Is a domain name consisting of a misspelling of the complainant's trademark (i.e., typosquatting) confusingly similar to the complainant's mark?**

A domain name which consists of a common, obvious, or intentional misspelling of a trademark is considered by panels to be confusingly similar to the relevant mark for purposes of the first element.

This stems from the fact that the domain name contains sufficiently recognizable aspects of the relevant mark. Under the second and third elements, panels will normally find that employing a misspelling in this way signals an intention on the part of the respondent (typically corroborated by infringing website content) to confuse users seeking or expecting the complainant.

Examples of such typos include (i) adjacent keyboard letters, (ii) substitution of similar-appearing characters (e.g., upper vs lower-case letters or numbers used to look like letters), (iii) the use of different letters that appear similar in different fonts, (iv) the use of non-Latin internationalized or accented characters, (v) the inversion of letters and numbers, or (vi) the addition or interspersing of other terms or numbers.

#### **Relevant decisions**

*Wachovia Corporation v. Peter Carrington*,  
WIPO Case No. **D2002-0775**, <wochovia.com> et al., Transfer

*Fuji Photo Film U.S.A., Inc. v. LaPorte Holdings*,  
WIPO Case No. **D2004-0971**, <fujifilm.com>, Transfer

*Humana Inc. v. Cayman Trademark Trust*,  
WIPO Case No. **D2006-0073**, <humanna.com>, Transfer

*Edmunds.com, Inc. v. Digi Real Estate Foundation*,  
WIPO Case No. **D2006-1043**, <edmundss.com>, Transfer

*Express Scripts, Inc. v. Whois Privacy Protection Service, Inc. / Domaindeals, Domain Administrator*,  
WIPO Case No. **D2008-1302**, <expressscripts.com>, Transfer

*Sanofi v. Domains By Proxy, LLC / domain admin*,  
WIPO Case No. **D2013-0368**, <sanofi.com>, Transfer

*SIEMENS AG v. Omur Topkan*,  
WIPO Case No. **D2013-1318**, <siemens.com> [xn--semens-p9a.com], Transfer

*Twitter, Inc. v. Ahmet Ozkan*,  
WIPO Case No. **D2014-0469**, <twitter.com> [xn--twitter-q9a.com], Transfer

*Comerica Bank v. Online Management / Registration Private, Domains By Proxy, LLC*,  
WIPO Case No. **D2014-1018**, <c0merica.com>, Transfer

*LinkedIn Corporation v. Daphne Reynolds*,  
WIPO Case No. **D2015-1679**, <linkedlnjobs.com>, Transfer

*Schneider Electric S.A. v. Domain Whois Protect Service / Cyber Domain Services Pvt. Ltd.*,  
WIPO Case No. **D2015-2333**, <schnieder-electric.com>, Transfer

*Sanofi, Genzyme Corporation v. Domain Privacy*,  
WIPO Case No. **D2016-1193**, <genzyme.com>, Cancellation

### **1.10 How are trademark registrations with design elements or disclaimed text treated in assessing identity or confusing similarity?**

Panel assessment of identity or confusing similarity involves comparing the (alpha-numeric) domain name and the textual components of the relevant mark. To the extent that design (or figurative/stylized) elements would be incapable of representation in domain names, these elements are largely disregarded for purposes of assessing identity or confusing similarity under the first element. Such design elements may be taken into account in limited circumstances e.g., when the domain name comprises a spelled-out form of the relevant design element.

On this basis, trademark registrations with design elements would prima facie satisfy the requirement that the complainant show “rights in a mark” for further assessment as to confusing similarity.

However where design elements comprise the dominant portion of the relevant mark such that they effectively overtake the textual elements in prominence, or where the trademark registration entirely disclaims the textual elements (i.e., the scope of protection afforded to the mark is effectively limited to its stylized elements), panels may find that the complainant’s trademark registration is insufficient by itself to support standing under the UDRP. [See in particular section **1.2.3.**]

To the extent the complainant could nevertheless establish UDRP standing on the basis of a mark with design elements, the existence of such elements (or a disclaimer) would be relevant to the panel’s assessment of the second and third elements, e.g., in considering possible legitimate trademark co-existence or scenarios where the textual elements correspond to a dictionary term.

## Relevant decisions

- Sweeps Vacuum & Repair Center, Inc. v. Nett Corp.*,  
WIPO Case No. **D2001-0031**, <sweeps.com>, Denied
- Meat and Livestock Commission v. David Pearce aka OTC / The Recipe for BSE*,  
WIPO Case No. **D2003-0645**, <britishmeat.com> et al., Denied
- J2 Global Communications, Inc. v. Ideas Plus, Inc.*,  
WIPO Case No. **D2005-0792**, <e-fax.com>, Denied
- Asset Loan Co. Pty Ltd v. Gregory Rogers*,  
WIPO Case No. **D2006-0300**, <assetloanco.net>, Transfer
- Dreamstar Cash S.L. v. Brad Klarkson*,  
WIPO Case No. **D2007-1943**, <gals4free.com>, Transfer
- Hero v. The Heroic Sandwich*,  
WIPO Case No. **D2008-0779**, <hero.com>, Denied
- Consejo Regulador del Cava v. Adrian Lucas*,  
WIPO Case No. **D2008-1939**, <cava.com>, Denied
- Ideation Unlimited, Inc. v. Dan Myers*,  
WIPO Case No. **D2008-1441**, <prescriptioncosmetics.com>, Denied
- Which? Limited v. Whichcar.com c/o Whois Identity Shield / Vertical Axis, Inc.*,  
WIPO Case No. **D2008-1637**, <whichcar.com>, Transfer
- Casa Editorial El Tiempo, S.A. v. Montanya Ltd*,  
WIPO Case No. **D2009-0103**, <clubdesuscriptoreseltiempo.com>, Transfer
- RUGGEDCOM, Inc. v. James Krachenfels*,  
WIPO Case No. **D2009-0130**, <ruggedrouter.com>, Transfer with Dissenting Opinion
- Ville de Paris v. Salient Properties LLC*,  
WIPO Case No. **D2009-1279**, <wifiparis.com>, Denied
- Espire Infolabs Pvt. Ltd. v. TW Telecom*,  
WIPO Case No. **D2010-1092**, <espire.com>, Denied
- Islamic Bank of Britain Plc v. Ifena Consulting, Charles Shrimpton*,  
WIPO Case No. **D2010-0509**, <islamic-bank.com>, Transfer
- Limited Liability Company Infomedia v. c/o Office-Mail processing center / Whois privacy services, provided by DomainProtect LLC / 1) Eurofirm Ltd. 2) Ethno Share PO, Domain Manager*, WIPO Case No. **D2010-1239**, <ethno.com>, Denied
- Comservice SA v. Mdnh Inc., Brendhan Height*,  
WIPO Case No. **D2010-1591**, <comservice.com>, Denied
- Graça Artes Gráficas E Editora Ltda. v. Domain Amin*,  
WIPO Case No. **D2011-0734**, <shoppingdopovo.com>, Denied
- bambu, LLC v. Domains by Proxy, LLC/ Jamil Bouchareb*,  
WIPO Case No. **D2012-0902**, <bambushop.com>, Transfer
- Marco Aurich v. Johannes Kuehrer, World4You Webservice*,  
WIPO Case No. **D2012-1147**, <domainhoster.info>, Denied
- Mr. Ralph Anderl v. Yang Min*,  
WIPO Case No. **D2013-1226**, <ic-berlinshop.com>, Transfer
- The Coca-Cola Company v. Whois Privacy Protection Service, Inc. / Thien Le Trieu, Le Trieu Thien*, WIPO Case No. **D2015-2078**, <xomtu.com>, Transfer
- At World Properties, LLC v. Whois Agent, WHOIS PRIVACY PROTECTION SERVICES, INC. / Whois Agent, PROFILE GROUP*,  
WIPO Case No. **D2016-0440**, <at.properties>, Denied
- American Public University System, Inc. v. Toby Schwarzkopf / Kyle Kupher / Domains by Proxy, LLC / DreamHost, LLC*,  
WIPO Case No. **D2017-0070**, <americanpublicuniversityloanforgiveness.com> and <americanpublicuniversitysystemloanforgiveness.com>, Transfer

## 1.11 Is the Top Level Domain relevant in determining identity or confusing similarity?

1.11.1 The applicable Top Level Domain (“TLD”) in a domain name (e.g., “.com”, “.club”, “.nyc”) is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test.

1.11.2 The practice of disregarding the TLD in determining identity or confusing similarity is applied irrespective of the particular TLD (including with regard to “new gTLDs”); the ordinary meaning ascribed to a particular TLD would not necessarily impact assessment of the first element. The meaning of such TLD may however be relevant to panel assessment of the second and third elements. [See in particular sections 2.14 and 3.2.1.]

For example, in cases where the combination of the mark and the TLD signals potential legitimate co-existence or fair use, and where the related website content supports such inference, panels would tend to focus their inquiry on the second element. On the other hand, in cases where the TLD corresponds to the complainant’s area of trade so as to signal an abusive intent to confuse Internet users, panels have found this relevant to assessment under the third element.

1.11.3 Where the applicable TLD and the second-level portion of the domain name in combination contain the relevant trademark, panels may consider the domain name in its entirety for purposes of assessing confusing similarity (e.g., for a hypothetical TLD “.mark” and a mark “TRADEMARK”, the domain name <trade.mark> would be confusingly similar for UDRP standing purposes).

### 1.11.1 Relevant decisions

*CANAL + FRANCE v. Franck Letourneau*,  
WIPO Case No. [DTV2010-0012](#), <canalsat.tv>, Transfer  
*Bentley Motors Limited v. Domain Admin / Kyle Rocheleau, Privacy Hero Inc.*,  
WIPO Case No. [D2014-1919](#), <bentleymotorcars.com>, Transfer  
*SAP SE v. Mohammed Aziz Sheikh, Sapteq Global Consulting Services*,  
WIPO Case No. [D2015-0565](#), <sapteq.com>, Transfer  
*Bank Nagelmackers N.V. v. WhoisGuard, Inc / Paulo Giardini*,  
WIPO Case No. [D2016-0819](#), <nagelmackers.mobi>, Transfer  
*G4S Plc v. Noman Burki*,  
WIPO Case No. [D2016-1383](#), <g4splc.com>, Transfer  
*Groupon, Inc. v. Whoisguard Protected, Whoisguard, Inc. / Vashti Scalise*,  
WIPO Case No. [D2016-2087](#), <grouponers.xyz>, Transfer  
*Rexel Developpements SAS v. Zhan Yequn*,  
WIPO Case No. [D2017-0275](#), <rexel.red>, Transfer

### 1.11.2 Relevant decisions

*Statoil ASA v. Daniel MacIntyre, Ethical Island*,  
WIPO Case No. [D2014-0369](#), <statoil.holdings> et al., Transfer  
*Slide Mountain Acquisition Company LLC v. Simon Nissim, lipstick boutique*,  
WIPO Case No. [D2014-0393](#), <loehmanns.clothing>, Transfer  
*Hultafors Group AB v. my domain limited*,  
WIPO Case No. [D2014-0597](#), <snickers.clothing>, Transfer  
*Sanofi v. Farris Nawas*,  
WIPO Case No. [D2014-0705](#), <sanofi.careers>, Transfer

*Sheppard Industries Limited v. Tiagra Investments, Christopher Murphy / Whois Agent / Whois Privacy Protection Service, Inc.*, WIPO Case No. **D2014-1248** <avanti.bike>, Transfer  
*Starwood Hotels & Resorts Worldwide, Inc. and Westin Hotel Management, L.P. v. Hyper.Directory Inc.*, WIPO Case No. **D2014-1315**, <westin.berlin>, Transfer  
*HUGO BOSS Trade Mark Management GmbH & Co. KG, HUGO BOSS AG v. Max Brauer, CloudStudio*, WIPO Case No. **D2014-2029**, <hugoboss.moda>, Transfer  
*Audi AG, Automobili Lamborghini Holding S.p.A., Skoda Auto a.s., Volkswagen AG v. JUS TIN Pty Ltd.*, WIPO Case No. **D2015-0827**, <audi.social> et al., Transfer  
*Virgin Enterprises Limited v. Cesar Alvarez*, WIPO Case No. **D2016-2140**, <virginmedia.shop>, Transfer  
*De Beers Intangibles Limited v. Domain Admin, Whois Privacy Corp.*, WIPO Case No. **D2016-1465**, <debeers.feedback>, Transfer

### 1.11.3 Relevant decisions

*project.me GmbH v. Alan Lin*, WIPO Case No. **DME2009-0008**, <project.me>, Denied  
*Banco Bradesco S/A v. Paulo Araujo*, WIPO Case No. **DCO2010-0049**, <brades.co>, Transfer  
*Tesco Stores Limited v. Mat Feakins*, WIPO Case No. **DCO2013-0017**, <tes.co>, Transfer  
*Zions Bancorporation v. Mohammed Akik Miah*, WIPO Case No. **D2014-0269**, <zionsbank.holdings>, Transfer  
*Fifth Street Capital LLC v. Fluder (aka Pierre Olivier Fluder)*, WIPO Case No. **D2014-1747**, <fifthstreet.finance>, Transfer  
*Bayerische Motoren Werke AG v. Masakazu/Living By Blue Co., Ltd.*, WIPO Case No. **DMW2015-0001**, <b.mw>, Transfer  
*Totaljobs Group Limited v. Faisal Khan, CreativeMode Ltd*, WIPO Case No. **D2017-0295**, <total.jobs>, Transfer  
*At World Properties, LLC v. Whois Agent, WHOIS PRIVACY PROTECTION SERVICES, INC. / Whois Agent, PROFILE GROUP*, WIPO Case No. **D2016-0440**, <at.properties>, Denied  
*WeWork Companies, Inc. v. Michael Chiriack, Various Concepts Inc.*, WIPO Case No. **D2016-1817**, <joinwe.work> et al., Transfer  
*Swarovski Aktiengesellschaft v. Aprensa UG haftungsbeschraenkt, Mike Koefer*, WIPO Verfahren Nr. **D2016-2036**, <swarov.ski>, Transfer  
*Compagnie Générale des Etablissements Michelin v. Pacharapatr W.*, WIPO Case No. **D2016-2465**, <tyre.plus>, Transfer

## 1.12 Is a domain name consisting of the complainant's mark plus a third-party trademark confusingly similar to the complainant's trademark?

Where the complainant's trademark is recognizable within the disputed domain name, the addition of other third-party marks (i.e., <mark1+mark2.tld>), is insufficient in itself to avoid a finding of confusing similarity to the complainant's mark under the first element.

The complaint may include evidence of the third-party mark holder's consent to file the case, and request that any transfer order be issued in favor of the filing complainant only. Absent such consent (and, where this was considered appropriate, having failed to reach the concerned third party by Procedural Order via the complainant), some panels have ordered transfer of the domain name without prejudice to the concerned third-party's rights. In certain highly exceptional circumstances, panels have ordered the cancellation of the disputed domain name.

[See also sections 4.11.1 and 4.13.]

### Relevant decisions

*Chevron Corporation v. Young Wook Kim*,  
WIPO Case No. [D2001-1142](#), <chevron-texaco.com>, Transfer  
*Yahoo! Inc. v. CPIC NET and Syed Hussain*,  
WIPO Case No. [D2001-0195](#), <yahooebay.org>, et al., Transfer  
*Bayerische Motoren Werke AG v. Gary Portillo*,  
WIPO Case No. [D2012-1937](#), <rockvilleaudibmw.com> et al., Cancellation  
*Guccio Gucci S.p.A. v. Brenda Hawkins*,  
WIPO Case No. [D2013-0603](#), <gucciipadcase.net>, et al., Transfer  
*Decathlon SAS v. Nadia Michalski*,  
WIPO Case No. [D2014-1996](#), <decathlon-nike.com>, Transfer  
*Go Sport v. Clara Toussaint*,  
WIPO Case No. [D2015-0389](#), <gosport-nike.com>, Transfer  
*Cummins Inc. v. Dennis Goebel*,  
WIPO Case No. [D2015-1064](#), <fordcummins.com>, Transfer  
*Philip Morris USA Inc. v. Whoisguard Protected, Whoisguard, Inc. / MARK JAYSON DAVID*,  
WIPO Case No. [D2016-2194](#), <pallmall-marlboro.com>, Transfer  
*Aldi GmbH & Co. KG, Aldi Stores Limited v. Ronan Barrett*,  
WIPO Case No. [D2016-2219](#), <aldiorlidl.com> and <lidloraldi.com>, Transfer

### 1.13 Is a domain name consisting of a trademark and a negative term (“sucks cases”) confusingly similar to a complainant’s trademark?

A domain name consisting of a trademark and a negative or pejorative term (such as <[trademark]sucks.com>, <[trademark]구려.com>, <[trademark]吸.com>, or even <trademark.sucks>) is considered confusingly similar to the complainant’s trademark for the purpose of satisfying standing under the first element. The merits of such cases, in particular as to any potential fair use, are typically decided under the second and third elements.

[See also section 2.6 and sections 3.1 and 3.2.1 generally.]

Panels have thereby observed that permitting such standing avoids gaming scenarios whereby appending a “sucks variation” would potentially see such cases fall outside the reach of the UDRP.

### Relevant decisions

*Wal-Mart Stores, Inc. v. Richard MacLeod d/b/a For Sale*,  
WIPO Case No. [D2000-0662](#), <wal-martsucks.com>, Transfer  
*A & F Trademark, Inc. and Abercrombie & Fitch Stores, Inc. v. Justin Jorgensen*,  
WIPO Case No. [D2001-0900](#), <abercrombieandfilth.com>, Transfer  
*Asda Group Limited v. Mr. Paul Kilgour*,  
WIPO Case No. [D2002-0857](#), <asdasucks.net>, Denied  
*Joseph Dello Russo M.D. v. Michelle Guillaumin*,  
WIPO Case No. [D2006-1627](#), <dellorussosucks.com> et al., Transfer, Denied in part  
*Bakers Delight Holdings Ltd v. Andrew Austin*,  
WIPO Case No. [D2008-0006](#), <bakersdelightlies.com>, Denied

*Red Bull GmbH v. Carl Gamel*,  
WIPO Case No. **D2008-0253**, <redbullsucks.com>, Transfer

*Southern California Regional Rail Authority v. Robert Arkow*,  
WIPO Case No. **D2008-0430**, <metrolinksucks.com>, et al., Denied

*Sermo, Inc. v. CatalystMD, LLC*,  
WIPO Case No. **D2008-0647**, <sermosucks.com>, Denied

*Vanguard Trademark Holdings USA, LLC v. European Travel Network*,  
WIPO Case No. **D2008-1325**, <alamo-sucks.com>, Transfer

*Air Austral v. Tian Yi Tong Investment Ltd.*,  
WIPO Case No. **D2009-0020**, <airaustralsucks.com>, Transfer

*Streamtel Corporation SRL v. Ton Kamminga*,  
WIPO Case No. **D2010-0423**, <streamtel-is-fraud.com>, Transfer

*HBT Investments, LLC d/b/a Valley Goldmine v. Christopher D. Bussing*,  
WIPO Case No. **D2010-1326**, <valleygoldminesucks.com>, Transfer

*HM Publishers Holdings Ltd v. Marcus Costa Camargo Peres*,  
WIPO Case No. **D2013-1597**, <fuckmacmillan.info>, Transfer

*Swarovski Aktiengesellschaft v. Zengwei*,  
WIPO Case No. **D2014-0243**, <swarovskideschmuck.com>, Transfer

*Philip Morris USA Inc. v. Johnny Angelone, Aware Marketing*,  
WIPO Case No. **D2015-0380**, <philipmorrisusasucks.com>, Transfer

*Ironfx Global Limited v. MR Qaisar Saeed Butt / Moniker Privacy Services*,  
WIPO Case No. **D2015-1221**, <ironfxscam.com>, Denied

*Boehringer Ingelheim Pharma GmbH & Co. KG. v. Whoisguard Protected, Whoisguard, Inc. / J Gates, My Domain Estates*,  
WIPO Case No. **D2015-1542**, <boehringeringelheimsucks.com>, Transfer

*RoboForex (CY) Ltd v. Ekaterina Zhiltsova*,  
WIPO Case No. **D2016-0902**, <anti-roboforex.com>, Transfer

*Royal Institution of Chartered Surveyors v. Martin Rushton*,  
WIPO Case No. **D2016-0951**, <rics-corruption.com> and <ricsfrance.com>, Transfer, Denied in Part

#### **1.14 Is a domain name that consists or is comprised of a translation or transliteration of a trademark identical or confusingly similar to a complainant's trademark?**

A domain name that consists or is comprised of a translation or transliteration of a trademark will normally be found to be identical or confusingly similar to such trademark for purposes of standing under the Policy, where the trademark – or its variant – is incorporated into or otherwise recognizable, through such translation/transliteration, in the domain name.

##### **Relevant decisions**

*Compagnie Générale Des Etablissements Michelin – Michelin & Cie v. Graeme Foster*,  
WIPO Case No. **D2004-0279**, <le-guide-rouge-recipes.com>, <redbook-recipes.com> et al., Transfer

*Société pour l'Oeuvre et la Mémoire d'Antoine de Saint Exupéry – Succession Saint Exupéry – D'Agay v. Perlegos Properties*,  
WIPO Case No. **D2005-1085**, <thelittleprince.com>, Transfer

*The Coca-Cola Company v. Keren, Chen*,  
WIPO Case No. **D2008-1852**, <קוקהקולה.com>, Transfer

*EPSON Europe BV v. cimin mehvar, Ali Yousofnia*,  
WIPO Case No. **D2010-2037**, <اپسون.com>, Transfer

*Société pour l’Oeuvre et la Mémoire d’Antoine de Saint Exupéry, Succession Saint Exupéry-d’Agay v. il piccolo principe di laurora rossella Ditta Individuale*,  
WIPO Case No. **D2011-1497**, <ilpiccoloprincipe.com>, Transfer

*E. Remy Martin & Co v. xiangwu meng*,  
WIPO Case No. **D2012-0069**, <rentouma.net>, Transfer

*La Roche-Posay Laboratoire Pharmaceutique v. Domain Whois Protection Service / sdfdsdf*,  
WIPO Case No. **D2012-1606**, <li-fu-quan.com>, Transfer

*McDonald’s Corporation v. Fundacion Private Whois*,  
WIPO Case No. **D2012-1435**, <mailesong.info>, Transfer

*Yahoo! Inc. v. Mr. Omid Pournazar*,  
WIPO Case No. **D2012-1612**, <پناهو.com> [<xn--mgb8dd93c.com>], Transfer

*Happy Pancake AB v. Registration Private, Domains By Proxy, LLC / Fredrik Johansson*,  
WIPO Case No. **D2014-0870**, <gladapannkakan.com>, Transfer

*OSRAM GmbH v. mingshu li, limingshu*,  
WIPO Case No. **D2015-0030**, <aosilang.com>, Transfer

*Swarovski Aktiengesellschaft v. Wang Jihui Wang Jihui*,  
WIPO Case No. **D2015-0587**, <施华洛世奇.手机>, Transfer

*Crédit industriel et commercial S.A. v. Registration Private, Domains By Proxy, LLC*,  
WIPO Case No. **D2016-2447**, <bank-cic.net>, Transfer

### **1.15 Is the content of the website associated with a domain name relevant in determining identity or confusing similarity?**

The content of the website associated with the domain name is usually disregarded by panels when assessing confusing similarity under the first element.

In some instances, panels have however taken note of the content of the website associated with a domain name to confirm confusing similarity whereby it appears prima facie that the respondent seeks to target a trademark through the disputed domain name.

Such content will often also bear on assessment of the second and third elements, namely whether there may be legitimate co-existence or fair use, or an intent to create user confusion.

#### **Relevant decisions**

*Fondation Le Corbusier v. Monsieur Bernard Weber, Madame Heidi Weber*,  
WIPO Case No. **D2003-0251**, <artlecorbusier.com> et al., Denied, Transfer in Part

*Harry Winston Inc. and Harry Winston S.A. v. Jennifer Katherman*,  
WIPO Case No. **D2008-1267**, <hairywinston.com>, Denied

*Schering-Plough Corporation, Schering Corporation v. Dan Myers*,  
WIPO Case No. **D2008-1641**, <clarinx.com> and <clartin.com>, Transfer

*Philip Morris USA Inc. v. Steven Scully, J&S Auto Repair*,  
WIPO Case No. **D2015-1001**, <pmcannabis.com>, Transfer

*The Canadian Hockey Association and The Canadian Olympic Committee v. Lin Lin*,  
WIPO Case No. **D2016-0322**, <canadaolympichockey.com> and <canadaolympicstore.com>, Transfer

*Bayer Healthcare LLC v. Admin, Domain*,  
WIPO Case No. **D2016-2342**, <scholls.com>, Transfer

*VF Corporation v. Vogt Debra*,  
WIPO Case No. **D2016-2650**, <bagpakonline.com> and <eastpake.com>, Transfer

*Bayerische Motoren Werke AG (“BMW”) v. Registration Private, Domains By Proxy, LLC / Armands Piebalgs*, WIPO Case No. **D2017-0156**, <bmdecoder.com> and <bmwdecoder.com>, Transfer





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## SECOND UDRP ELEMENT

### 2.1 How do panels assess whether a respondent lacks rights or legitimate interests in a domain name?

The UDRP Rules in principle provide only for a single round of pleadings, and do not contemplate discovery as such. Accordingly, a panel's assessment will normally be made on the basis of the evidence presented in the complaint and any filed response. The panel may draw inferences from the absence of a response as it considers appropriate, but will weigh all available evidence irrespective of whether a response is filed. [See also in this regard sections 4.7 and 4.8.]

While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

To demonstrate rights or legitimate interests in a domain name, non-exclusive respondent defenses under UDRP paragraph 4(c) include the following:

- (i) before any notice of the dispute, the respondent's 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) the respondent (as an individual, business, or other organization) has been commonly known by the domain name, even if the respondent has acquired no trademark or service mark rights; or
- (iii) the respondent is 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.

[See respectively sections 2.2, 2.3, 2.4, and 2.5.]

Over the course of many UDRP cases, panels have acknowledged further grounds which, while not codified in the UDRP as such, would establish respondent rights or legitimate interests in a domain name. For example, generally speaking, panels have accepted that aggregating and holding domain names (usually for resale) consisting of acronyms, dictionary words, or common phrases can be bona fide and is not per se illegitimate under the UDRP. [See in particular section 2.10.]

#### Relevant decisions

*Belupo d.d. v. WACHEM d.o.o.*,  
WIPO Case No. D2004-0110, <belupo.com>, Transfer

*Banco Itau S.A. v. Laercio Teixeira*,  
WIPO Case No. [D2007-0912](#), <itaushopping.com>, Transfer  
*Malayan Banking Berhad v. Beauty, Success & Truth International*,  
WIPO Case No. [D2008-1393](#), <maybank.com>, Transfer  
*Accor v. Eren Atesmen*,  
WIPO Case No. [D2009-0701](#), <accorreviews.com>, Transfer  
*Wal-Mart Stores, Inc. v. WalMart Careers, Inc.*,  
WIPO Case No. [D2012-0285](#), <walmartcareers.com>, Transfer  
*B-Boy TV Ltd v. bboytv.com c/o Whois Privacy Service / Chief Rocka LTD, formerly named BreakStation LTD.*, WIPO Case No. [D2012-2006](#), <bboytv.com>, Denied  
*OSRAM GmbH. v. Mohammed Rafi/Domain Admin, Privacy Protection Service INC d/b/a PrivacyProtect.org*, WIPO Case No. [D2015-1149](#), <ojram.com>, Transfer

## **2.2 What qualifies as prior use, or demonstrable preparations to use the domain name, in connection with a bona fide offering of goods or services?**

As expressed in UDRP decisions, non-exhaustive examples of prior use, or demonstrable preparations to use the domain name, in connection with a bona fide offering of goods or services may include: (i) evidence of business formation-related due diligence/legal advice/correspondence, (ii) evidence of credible investment in website development or promotional materials such as advertising, letterhead, or business cards (iii) proof of a genuine (i.e., not pretextual) business plan utilizing the domain name, and credible signs of pursuit of the business plan, (iv) bona fide registration and use of related domain names, and (v) other evidence generally pointing to a lack of indicia of cybersquatting intent. While such indicia are assessed pragmatically in light of the case circumstances, clear contemporaneous evidence of bona fide pre-complaint preparations is required.

Acknowledging that business plans and operations can take time to develop, panels have not necessarily required evidence of such use or intended use to be available immediately after registration of a domain name, but the passage of time may be relevant in assessing whether purported demonstrable preparations are bona fide or pretextual.

If not independently verifiable by the panel, claimed examples of use or demonstrable preparations to use the domain name in connection with a bona fide offering of goods or services cannot be merely self-serving but should be inherently credible and supported by relevant pre-complaint evidence.

### **Relevant decisions**

*CVS Pharmacy, Inc. v. Top Investments, LLLP*,  
WIPO Case No. [D2011-0379](#), <mycvs.com>, Transfer with Dissenting Opinion  
*Asbach GmbH v. Econsult Ltd., d.b.a. Asbach Communities and Whois-Privacy Services*,  
WIPO Case No. [D2012-1225](#), <asbach.com>, Denied  
*Publicare Marketing Communications GmbH v. G.E.D. Faber / GAOS BV*,  
WIPO Case No. [D2012-1580](#), <publicare.com>, Denied  
*Puravankara Projects Limited v. Shiva Malhotra*,  
WIPO Case No. [D2013-0260](#), <purva.com>, Denied  
*Harpo, Inc. and Oprah's Farm, LLC v. Robert McDaniel*,  
WIPO Case No. [D2013-0585](#), <oprahfarm.com> et al., Transfer  
*Etro S.p.A. v. Hernan Villalobos*,  
WIPO Case No. [D2014-0264](#), <etrolounge.com>, Denied

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*Pro Quidity B.V. v. Domains By Proxy LLC / Nicholas Hall, Hall Attorneys, P.C.*,  
WIPO Case No. **D2014-0765**, <proquidity.com>, Denied  
*Fotocom Société Anonyme v. PrivateName Services Inc. / Werner A. Krachtus, motiondrive  
AG*, WIPO Case No. **D2014-1769**, <photo.com>, Denied  
*Philip Morris USA Inc. v. Borut Bezjak, A Domains Limited*,  
WIPO Case No. **D2015-1128**, <marlboro.party>, Denied  
*Autodesk, Inc. v. Brian Byrne, meshIP, LLC*,  
WIPO Case No. **D2017-0191**, <autocadcloud.com> and <hostedautocad.com>, Transfer

### **2.3 How would a respondent show that it is commonly known by the domain name or a name corresponding to the domain name?**

Panels have addressed a range of cases involving claims that the domain name corresponds to the respondent's actual given name (including in combination with initials), stage name, nickname, or other observed moniker.

For a respondent to demonstrate that it (as an individual, business, or other organization) has been commonly known by the domain name or a name corresponding to the domain name, it is not necessary for the respondent to have acquired corresponding trademark or service mark rights.

The respondent must however be "commonly known" (as opposed to merely incidentally being known) by the relevant moniker (e.g., a personal name, nickname, corporate identifier), apart from the domain name. Such rights, where legitimately held/obtained, would prima facie support a finding of rights or legitimate interests under the UDRP.

Insofar as a respondent's being commonly known by a domain name would give rise to a legitimate interest under the Policy, panels will carefully consider whether a respondent's claim to be commonly known by the domain name – independent of the domain name – is legitimate. Mere assertions that a respondent is commonly known by the domain name will not suffice; respondents are expected to produce concrete credible evidence.

Absent genuine trademark or service mark rights, evidence showing that a respondent is commonly known by the domain name may include: a birth certificate, driver's license, or other government-issued ID; independent and sustained examples of secondary material such as websites or blogs, news articles, correspondence with independent third parties; sports or hobby club publications referring to the respondent being commonly known by the relevant name; bills/invoices; or articles of incorporation. Panels will additionally typically assess whether there is a general lack of other indicia of cybersquatting. In appropriate cases panels may refer to the respondent's domain name-related track record more generally.

#### **Relevant decisions**

*Red Bull GmbH v. Harold Gutch*,  
WIPO Case No. **D2000-0766**, <redbull.org>, Transfer  
*G. A. Modefine S.A. v. A.R. Mani*,  
WIPO Case No. **D2001-0537**, <armani.com>, Denied  
*Banco Espirito Santo S.A. v. Bancovic*,  
WIPO Case No. **D2004-0890**, <bancoespiritosanto.com>, Transfer  
*Julie & Jason, Inc. d/b/a The Mah Jongg Maven v. Faye Scher d/b/a Where the Winds Blow*,  
WIPO Case No. **D2005-0073**, <themahjonggmaven.com>, Transfer

*Sanofi-aventis, Aventis Inc. v. Allegra Bonner/Domains By Proxy, Inc.*,  
WIPO Case No. **D2007-1618**, <allegrashock.com>, Denied  
*Sony Kabushiki Kaisha aka Sony Corporation v. Sony Holland*,  
WIPO Case No. **D2008-1025**, <sonyholland.com>, Denied  
*Compagnie Gervais Danone v. Duxpoint and Alejandro Gomez*,  
WIPO Case No. **D2008-1799**, <danonino.org>, Transfer  
*Grundfos Holding A/S v. PrivacyProtect.org / Incredible SEO Mehul (Sailesh Patel / Ajay Soni)*,  
WIPO Case No. **D2011-1355**, <groundforcepumps.com>, Denied  
*Alessandro International GmbH v. Alessandro Gualandi*,  
WIPO Case No. **D2014-2111**, <alessandro.com>, Denied  
*Argenta Spaarbank NV v. Barbara Lesimple / Argenthal Private Capital Limited*,  
WIPO Case No. **D2015-0467**, <argenthal.com>, Denied  
*CKL Holdings N.V. v. Paul Flammea*,  
WIPO Case No. **D2016-1340**, <flammea.com>, Denied

## 2.4 How does the UDRP account for legitimate fair use of domain names?

As is evident in the [Report of the First WIPO Internet Domain Name Process](#), fairness – both in procedural and in substantive terms – is a lynchpin of a credible dispute resolution system. A number of UDRP cases decided in a defaulting respondent’s favor bear strong witness to this.

The UDRP codifies this foundational principle in many ways. For example, the UDRP stipulates that certain notification obligations should be met so that a respondent is aware of and given an opportunity to present its case. As a more substantive example, UDRP paragraph 4(c)(iii) provides that a respondent may demonstrate rights or legitimate interests in a domain name by providing evidence of “legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the [complainant’s] trademark or service mark.”

At the same time, in assessing allegations of bad faith, consideration factors provided under the third UDRP element address a range of unfair practices.

### Relevant decisions

*Human Resource Certification Institute v. Tridibesh Satpathy, Edusys*,  
WIPO Case No. **D2010-0291**, <hrcistudy.com>, Denied  
*Intuit, Inc. v. Privacyprotect.org / Niveditha.G, Cosmic IT Services Pvt. Ltd.*,  
WIPO Case No. **D2011-1714**, <quickbooksindia.com>, Denied  
*Amylin Pharmaceuticals, Inc. v. Watts Guerra Craft LLP*,  
WIPO Case No. **D2012-0486**, <byettacancer.com>, Denied  
*DOTMED.COM, INC. v. Hexap and Promopixel SARL*,  
WIPO Case No. **D2012-1117**, <aboutdotmed.org> et al., Denied  
*CFA Properties, Inc. v. Domains By Proxy, LLC and John Selvig*,  
WIPO Case No. **D2012-1618**, <chickfilafoundation.com>, Denied  
*Global Personals, LLC v. Domains By Proxy, LLC / Thomas Kupracz*,  
WIPO Case No. **D2013-0528**, <best-fling-sites.com>, Denied  
*BSH Home Appliances Corporation v. Michael Stanley / Michael Sipo*,  
WIPO Case No. **D2014-1433**, <boschappliancepro.info> et al., Transfer  
*Adam Anschel v. Domains By Proxy, LLC / Tzvi Milshtein*,  
WIPO Case No. **D2015-1570**, <adamanschel.com>, Transfer

*Ironfx Global Limited v. MR Qaisar Saeed Butt / Moniker Privacy Services*,  
WIPO Case No. **D2015-1221**, <ironfxscam.com>, Denied

*Titan Enterprises (Qid) Ply Ltd v. Dale Cross / Contact Privacy Inc*,  
WIPO Case No. **D2015-2062**, <bewareoftitangarages.com>, Denied

*Dagbladet Børsen A/S v. Laurent Mermet*,  
WIPO Case No. **D2016-1814**, <børsen.com>, Denied

## **2.5 What are some core factors UDRP panels look at in assessing fair use?**

Fundamentally, a respondent's use of a domain name will not be considered "fair" if it falsely suggests affiliation with the trademark owner; the correlation between a domain name and the complainant's mark is often central to this inquiry.

### **2.5.1 The nature of the domain name**

Generally speaking, UDRP panels have found that domain names identical to a complainant's trademark carry a high risk of implied affiliation.

Even where a domain name consists of a trademark plus an additional term (at the second- or top-level), UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner.

As described in more detail below and in sections 2.6 through section 2.8, UDRP panels have articulated a broad continuum of factors useful in assessing possible implied sponsorship or endorsement.

At one end, certain geographic terms (e.g., <trademark-usa.com>, or <trademark.nyc>), or terms with an "inherent Internet connotation" (e.g., <e-trademark.com>, <buy-trademark.com>, or <trademark.online>) are seen as tending to suggest sponsorship or endorsement by the trademark owner.

At the other extreme, certain critical terms (e.g., <trademarksucks.com>) tend to communicate, prima facie at least, that there is no such affiliation.

In between, certain additional terms within the trademark owner's field of commerce or indicating services related to the brand, or which are not obviously critical (e.g., <okidataparts.com>, <nascartours.com>, <covancecampaign.com>, or <meissencollector.com>), may or may not by themselves trigger an inference of affiliation, and would normally require a further examination by the panel of the broader facts and circumstances of the case – particularly including the associated website content – to assess potential respondent rights or legitimate interests.

### **2.5.2 Circumstances beyond the domain name itself**

Beyond looking at the domain name and the nature of any additional terms appended to it (whether descriptive, laudatory, derogatory, etc.), panels assess whether the overall facts and circumstances of the case support a claimed fair use.

To facilitate this assessment, panels have found the following factors illustrative: (i) whether the domain name has been registered and is being used for legitimate purposes and not as a pretext for commercial gain or other such purposes inhering to the respondent's benefit, (ii) whether the respondent reasonably believes its use (whether referential, or for praise or

criticism) to be truthful and well-founded, (iii) whether it is clear to Internet users visiting the respondent's website that it is not operated by the complainant, (iv) whether the respondent has refrained from engaging in a pattern of registering domain names corresponding to marks held by the complainant or third parties, (v) where appropriate, whether a prominent link (including with explanatory text) is provided to the relevant trademark owner's website, (vi) whether senders of email intended for the complainant but (because of user confusion) directed to the respondent are alerted that their message has been misdirected, (vii) whether there is an actual connection between the complainant's trademark in the disputed domain name and the corresponding website content, and not to a competitor, or an entire industry, group, or individual, and (viii) whether the domain name registration and use by the respondent is consistent with a pattern of bona fide activity (whether online or offline).

### 2.5.3 Commercial activity

In the broadest terms, while panels will weigh a range of case-specific factors such as those listed above in section 2.5.2, judging whether a respondent's use of a domain name constitutes a legitimate fair use will often hinge on whether the corresponding website content prima facie supports the claimed purpose (e.g., for referential use, commentary, criticism, praise, or parody), is not misleading as to source or sponsorship, and is not a pretext for tarnishment or commercial gain.

Notably in this regard, commercial gain may include the respondent gaining or seeking reputational and/or bargaining advantage, even where such advantage may not be readily quantified. [See further section 3.1.4.]

Similarly, a respondent's use of a complainant's mark to redirect users (e.g., to a competing site) would not support a claim to rights or legitimate interests.

While specific case factors have led panels to find that fair use need not always be categorically noncommercial in nature, unambiguous evidence that the site is not primarily intended for commercial gain, e.g., the absence of commercial or pay-per-click (PPC) links or references to a respondent's business, would tend to indicate a lack of intent to unfairly profit from the complainant's reputation.

Panels also tend to look at whether a response is filed (and the credibility thereof), whether the respondent provides false contact information or engages in cyberflight, and whether the respondent has engaged in a pattern of trademark-abusive domain name registrations.

The above-described broad concept of fair use is explored below in the more specific contexts of (i) criticism sites, (ii) fan sites, and (iii) nominative use.

#### 2.5.1 Relevant decisions

*Fulham Football Club (1987) Limited, Tottenham Hotspur Public Limited, West Ham United Football Club PLC, Manchester United Limited, The Liverpool Football Club And Athletic Grounds Limited v. Domains by Proxy, Inc./ Official Tickets Ltd*,  
WIPO Case No. **D2009-0331**, <official-fulham-tickets.com> et al., Transfer

*Wal-Mart Stores, Inc. v. Domains by Proxy, LLC / UFCW International Union*,  
WIPO Case No. **D2013-1304**, <reallywalmart.com> et al., Transfer

*Petroleo Brasileiro S.A. - Petrobras v. Ivo Lucio Santana Marcelino Da Silva*,  
WIPO Case No. **D2014-1331**, <maracutaiasnapetrobras.com>, Denied

*201 Folsom Option JV, L.P. and 201 Folsom Acquisition, L.P. v. John Kirkpatrick*,  
WIPO Case No. **D2014-1359**, <luminacondo.com>, Transfer

*Iflscience Limited v. Domains By Proxy LLC / Dr Chauncey Siemens*,  
WIPO Case No. **D2016-0909**, <iflscience.org>, Transfer

*Eli Lilly and Company and Novartis Tiergesundheit AG v. Manny Ghumman / Mr. NYOB / Jesse Padilla*, WIPO Case No. **D2016-1698**, <buycomfortis.com> et al., Transfer

*The Procter & Gamble Company v. Whoisguard, Inc. / Enzo Gucci, Xtremcare, Tony Mancini, USDIET, USDIET Ltd*, WIPO Case No. **D2016-1881**, <achetercrest.com>, Transfer

*The Royal Edinburgh Military Tattoo Limited v. Identity Protection Service, Identity Protect Limited / Martin Clegg, WM Holdings*, WIPO Case No. **D2016-2290**, <edinburghmilitarytattootickets.com>, Transfer

### 2.5.2 Relevant decisions

*Suncor Energy Inc. v. Whois Privacy Protection Service, Inc. / andre bechamp*,  
WIPO Case No. **D2012-2123**, <suncorcalgary.com> et al., Transfer

*Veritas Investments, Inc. v. Private Registrant / Jamie Campbell*,  
WIPO Case No. **D2014-0010**, <veritasinvestments.net>, Denied

*Angelica Fuentes Téllez v. Domains by Proxy, LLC / Angela Brink*,  
WIPO Case No. **D2014-1860**, <angelissima.com>, Denied

*Alessandro International GmbH v. Alessandro Gualandi*,  
WIPO Case No. **D2014-2111**, <alessandro.com>, Denied

*Philip Morris USA Inc. v. Borut Bezjak, A Domains Limited*,  
WIPO Case No. **D2015-1128**, <marlboro.party>, Denied

*Azimo Ltd. v. Vladimir Zubkov*,  
WIPO Case No. **D2016-2608**, <azimoreview.com>, Denied

### 2.5.3 Relevant decisions

*Harpo, Inc. and Oprah's Farm, LLC v. Robert McDaniel*,  
WIPO Case No. **D2013-0585**, <oprahfarm.com> and <oprahfarm.net>, Transfer

*Richemont International SA v. Turvill Consultants*,  
WIPO Case No. **D2014-0862**, <piagetwatch.com> and <piagetwatches.com>, Transfer

*Carlos Alberto Vives Restrepo v. WSJ Trade / Wilman Villegas*,  
WIPO Case No. **D2015-0919**, <cumbiahouse.com>, Transfer

*Pfizer Inc. v. Ubrokerage inc*,  
WIPO Case No. **D2015-1927**, <sayanapress.com>, Transfer

*Segway Inc. v. Domains By Proxy, LLC / Arthur Andreasyan, NIM*,  
WIPO Case No. **D2016-0725**, <segawayboard.com> and <segawayhoverboard.com>, Transfer

*Valentino S.p.A. v. Qiu Yufeng, Li Lianye*,  
WIPO Case No. **D2016-1747**, <byvalentino.com> et al., Transfer

## 2.6 Does a criticism site support respondent rights or legitimate interests?

As noted above, UDRP jurisprudence recognizes that the use of a domain name for fair use such as noncommercial free speech, would in principle support a respondent's claim to a legitimate interest under the Policy.

- 2.6.1 To support fair use under UDRP paragraph 4(c)(iii), the respondent's criticism must be genuine and noncommercial; in a number of UDRP decisions where a respondent argues that its domain name is being used for free speech purposes the panel has

found this to be primarily a pretext for cybersquatting, commercial activity, or tarnishment.

- 2.6.2 Panels find that even a general right to legitimate criticism does not necessarily extend to registering or using a domain name identical to a trademark (i.e., <trademark.tld> (including typos)); even where such a domain name is used in relation to genuine noncommercial free speech, panels tend to find that this creates an impermissible risk of user confusion through impersonation. In certain cases involving parties exclusively from the United States, some panels applying US First Amendment principles have found that even a domain name identical to a trademark used for a bona fide noncommercial criticism site may support a legitimate interest.
- 2.6.3 Where the domain name is not identical to the complainant's trademark, but it comprises the mark plus a derogatory term (e.g., <trademarksucks.tld>), panels tend to find that the respondent has a legitimate interest in using the trademark as part of the domain name of a criticism site if such use is prima facie noncommercial, genuinely fair, and not misleading or false. Some panels have found in such cases that a limited degree of incidental commercial activity may be permissible in certain circumstances (e.g., as "fundraising" to offset registration or hosting costs associated with the domain name and website).

[See also sections 1.8 and 1.13 with respect to the first UDRP element.]

[See also sections 2.5 and 2.7.]

### 2.6.1 Relevant decisions

*Wal-Mart Stores, Inc. v. Richard MacLeod d/b/a For Sale*,  
WIPO Case No. D2000-0662, <wal-martsucks.com>, Transfer

*Sermo, Inc. v. CatalystMD, LLC*,  
WIPO Case No. D2008-0647, <sermosucks.com>, Denied

*Amylin Pharmaceuticals, Inc. v. Watts Guerra Craft LLP*,  
WIPO Case No. D2012-0486, <byettacancer.com>, Denied

*Towers on the Park Condominium v. Paul Adao*,  
WIPO Case No. D2012-1054, <towersonthepark.com>, Denied

*Mr. Willem Vedovi, Galerie Vedovi S.A. v. Domains By Proxy, LLC / Jane Kelly*,  
WIPO Case No. D2014-0780, <vedovi-gallery.com> et al., Transfer, Denied in Part

*MUFG Union Bank, N.A. v. William Bookout*,  
WIPO Case No. D2014-1821, <mufgunionbankna.com> et al., Denied

*Northwestel Inc. v. John Steins*,  
WIPO Case No. D2015-0447, <northwestel.com>, Transfer

*De Beers Intangibles Limited v. Domain Admin, Whois Privacy Corp.*,  
WIPO Case No. D2016-1465, <debeers.feedback>, Transfer

*Azimo Ltd. v. Vladimir Zubkov*,  
WIPO Case No. D2016-2608, <azimoreview.com>, Denied

*Bernardelli Cesarina v. Paola Ferrario, Ferrario Photography*,  
WIPO Case No. D2017-0091, <farmaciabernardellicaione.com> et al., Transfer

## 2.6.2 Relevant decisions

*Joseph Dello Russo M.D. v. Michelle Guillaumin*,  
WIPO Case No. [D2006-1627](#), <dellorusso.info> and <dellorussosucks.com>, Transfer, Denied in Part

*Sermo, Inc. v. CatalystMD, LLC*,  
WIPO Case No. [D2008-0647](#), <sermosucks.com>, Denied

*The First Baptist Church of Glenarden v. Melvin Jones*,  
WIPO Case No. [D2009-0022](#), <fbcglenarden.com>, Transfer

*Mr. Willem Vedovi, Galerie Vedovi S.A. v. Domains By Proxy, LLC / Jane Kelly*,  
WIPO Case No. [D2014-0780](#), <vedovi-gallery.com> et al., Transfer, Denied in Part

*Puravankara Projects Limited v. Saurabh Singh*,  
WIPO Case No. [D2014-2054](#), <puravankaraprojects.com>, Transfer

## 2.6.3 Relevant decisions

*Amylin Pharmaceuticals, Inc. v. Watts Guerra Craft LLP*,  
WIPO Case No. [D2012-0486](#), <byettacancer.com>, Denied

*Mr. Willem Vedovi, Galerie Vedovi S.A. v. Domains By Proxy, LLC / Jane Kelly*,  
WIPO Case No. [D2014-0780](#), <vedovi-gallery.com> et al., Transfer, Denied in Part

*Petroleo Brasileiro S.A. - Petrobras v. Ivo Lucio Santana Marcelino Da Silva*,  
WIPO Case No. [D2014-1331](#), <maracutaiasnapetrobras.com>, Denied

*Nix Solutions Ltd. Limited Liability Company v. WhoisGuard Protected / Shaun Ferguson*,  
WIPO Case No. [D2014-1475](#), <nixsolutions-sucks.com> and <nixsolutionssucks.com>, Denied

*Moog Inc. v. Andrew Botte, Sayfa Workwear Limited*,  
WIPO Case No. [D2014-1484](#), <moogagm.com> et al., Denied

*Mobile Mini, Inc. v. Derek Carmichael*,  
WIPO Case No. [D2015-0350](#), <mobileminisucks.com>, Transfer

*Titan Enterprises (Qid) Ply Ltd v. Dale Cross / Contact Privacy Inc.*,  
WIPO Case No. [D2015-2062](#), <bewareoftitangarages.com>, Denied

*Royal Institution of Chartered Surveyors v. Martin Rushton*,  
WIPO Case No. [D2016-0951](#), <rics-corruption.com> and <ricsfrance.com>, Transfer, Denied in Part

## 2.7 Does a fan site support respondent rights or legitimate interests in a domain name?

Many of the considerations applied in relation to criticism sites, as discussed above in section [2.6](#), also are considered by panels as relevant in relation to fan sites.

2.7.1 As with criticism sites discussed above, for purposes of assessing fair use under UDRP paragraph 4(c)(iii), a respondent's fan site must be active, genuinely noncommercial, and clearly distinct from any official complainant site. Again, similar to claimed criticism sites, there are a number of UDRP cases in which the respondent claims to have a true fan site but the panel finds that it is primarily a pretext for cybersquatting or commercial activity.

2.7.2 Where a domain name which is identical to a trademark (i.e., <trademark.tld>) is being used in relation to a genuine noncommercial fan site, panels have tended to find that a general right to operate a fan site (even one that is supportive of the mark owner) does not necessarily extend to registering or using a domain name that is identical to the

complainant's trademark, particularly as the domain name may be misunderstood by Internet users as being somehow sponsored or endorsed by the trademark owner. (See discussion of inter alia misrepresentation at section 2.5 above.) In such cases, where the domain name is identical to the trademark, panels have also noted that this prevents the trademark holder from exercising its rights to the mark and so managing its presence on the Internet, including through a corresponding email address. However, as with criticism sites, in certain cases involving parties exclusively from the United States, some panels applying US First Amendment principles have found that even a domain name identical to a trademark used for a bona fide noncommercial fan site may support a legitimate interest.

- 2.7.3 Where the domain name is not identical to the complainant's trademark, i.e., it comprises the mark plus an additional, typically descriptive or laudatory term (e.g., <celebrity-fan.tld>), noting the factors listed above at section 2.5.2, panels tend to find that the respondent has a legitimate interest in using the mark as part of the domain name for a fan site if such use is considered to be fair in all of the circumstances of the case. Where such a site is noncommercial in nature, this would tend to support a finding that the use is a fair one. Some panels have found in such cases that a limited degree of incidental commercial activity may be permissible in certain circumstances (e.g., to offset registration or hosting costs associated with the domain name and website).

[See also generally section 1.8, and sections 2.5, and 2.6.]

#### 2.7.1 Relevant decisions

*Stoneygate 48 Limited and Wayne Mark Rooney v. Huw Marshall*,  
WIPO Case No. [D2006-0916](#), <waynerooney.com>, Transfer  
*Estate of Francis Newton Souza v. ZWYX.org Ltd.*,  
WIPO Case No. [D2007-0221](#), <fnsouza.com>, Denied  
*Ain-Jeem, Inc. v. Barto Enterprises, Inc., Philip Barto*,  
WIPO Case No. [D2007-1841](#), <kareemabuljabbar.com>, Transfer  
*Burberry Limited v. Carlos Lim*,  
WIPO Case No. [D2011-0344](#), <burberryworld.com>, Transfer  
*Miranda Kerr v. orangesarecool.com*,  
WIPO Case No. [D2013-0553](#), <kerr-miranda.com> et al., Transfer  
*Sofia Vergara v. Domain Administrator, Fundacion Private Whois / Domain Admin, Whois Privacy Corp. / Guy Bouchard*,  
WIPO Case No. [D2014-2008](#), <sofiavergara.org>, Transfer  
*Comcast Corporation v. Tonic Marketing Ltd.*,  
WIPO Case No. [D2015-1617](#), <thexfinitycenter.com> and <xfinitytheatre.net>, Transfer  
*Volkswagen AG v. Thijs van der Tuin*,  
WIPO Case No. [D2015-2106](#), <volkswagen-formula1.com> et al., Cancellation

#### 2.7.2 Relevant decisions

*Monty and Pat Roberts, Inc. v. Bill Keith*,  
WIPO Case No. [D2000-0299](#), <montyroberts.net>, Transfer  
*Nintendo of America Inc. v. Alex Jones*,  
WIPO Case No. [D2000-0998](#), <legendofzelda.com>, Denied  
*David Gilmour, David Gilmour Music Limited and David Gilmour Music Overseas Limited v. Ermanno Cenicolla*,  
WIPO Case No. [D2000-1459](#), <davidgilmour.com>, Transfer

*Russell Peters v. George Koshy and Navigation Catalyst Systems, Inc.*,  
WIPO Case No. [D2009-0173](#), <russelpeters.com>, Transfer

*The Jennifer Lopez Foundation v. Jeremiah Tieman, Jennifer Lopez Net, Jennifer Lopez, Vaca Systems LLC*,  
WIPO Case No. [D2009-0057](#), <jenniferlopez.net> and <jenniferlopez.org>, Transfer

### 2.7.3 Relevant decisions

*Samsung Electronics Co., Ltd. v. Kunal Gangar*,  
WIPO Case No. [D2013-0578](#), <samsunghub.com>, Denied

*Staatliche Porzellan-Manufaktur Meissen GmbH v. Peter Hillbricht*,  
WIPO Case No. [D2014-0095](#), <meissencollector.com>, Denied

*Bayerische Motoren Werke Aktiengesellschaft, Rolls-Royce Motor Cars Limited v. Mr David Redshaw, Auto Crowd, Auto Crowd Group / MEDIAGROUP24/ WhoisGuard Protected / WhoisGuard, Inc.*, WIPO Case No. [D2015-0589](#), <bmwenthusiastsclub.com> et al., Transfer

*Volkswagen AG v. Constantin Amann*,  
WIPO Case No. [D2015-2011](#), <volkswagen.rocks>, Transfer

*Etihad Airways v. Whoisguard Protected, Whoisguard, Inc / Hamza Ali*,  
WIPO Case No. [D2016-0615](#), <vetihad.com>, Denied

## 2.8 How do panels assess claims of nominative (fair) use by resellers or distributors?

While the following section primarily concerns cases involving “bait and switch” or other related unfair trade practices, many of the principles outlined above, especially at section [2.5](#) with respect to fair use, underpin the following section.

2.8.1 Panels have recognized that resellers, distributors, or service providers using a domain name containing the complainant’s trademark to undertake sales or repairs related to the complainant’s goods or services may be making a bona fide offering of goods and services and thus have a legitimate interest in such domain name. Outlined in the “Oki Data test”, the following cumulative requirements will be applied in the specific conditions of a UDRP case:

- (i) the respondent must actually be offering the goods or services at issue;
- (ii) the respondent must use the site to sell only the trademarked goods or services;
- (iii) the site must accurately and prominently disclose the registrant’s relationship with the trademark holder; and
- (iv) the respondent must not try to “corner the market” in domain names that reflect the trademark.

The Oki Data test does not apply where any prior agreement, express or otherwise, between the parties expressly prohibits (or allows) the registration or use of domain names incorporating the complainant’s trademark.

2.8.2 Cases applying the Oki Data test usually involve a domain name comprising a trademark plus a descriptive term (e.g., “parts”, “repairs”, or “location”), whether at the second-level or the top-level. At the same time, the risk of misrepresentation has led panels to find that a respondent lacks rights or legitimate interests in cases involving a domain name identical to the complainant’s trademark. [See section [2.5.1](#) above.]

Panels have found that PPC websites do not normally meet the Oki Data requirements as they do not themselves directly offer the goods or services at issue.

### 2.8.1 Relevant decisions

*Oki Data Americas, Inc. v. ASD, Inc.*,  
WIPO Case No. **D2001-0903**, <okidataparts.com>, Denied

*Experian Information Solutions, Inc. v. Credit Research, Inc.*,  
WIPO Case No. **D2002-0095**, <experiancredit.com> et al., Transfer

*Philip Morris Incorporated v. Alex Tsykin*,  
WIPO Case No. **D2002-0946**, <discount-marlboro-cigarettes.com>, Transfer

*Dr. Ing. h.c. F. Porsche AG v. Del Fabbro Laurent*,  
WIPO Case No. **D2004-0481**, <porsche-buy.com> et al., Denied

*National Association for Stock Car Auto Racing, Inc. v. Racing Connection / The Racin' Connection, Inc.*, WIPO Case No. **D2007-1524**, <nascartours.com>, Denied

*ITT Manufacturing Enterprises, Inc., ITT Corporation v. Douglas Nicoll, Differential Pressure Instruments, Inc.*, WIPO Case No. **D2008-0936**, <ittbarton.com> et al., Denied

*MasterCard International Incorporated v. Global Access*,  
WIPO Case No. **D2008-1940**, <mastercards.com>, Transfer

*Research in Motion Limited v. One Star Global LLC*,  
WIPO Case No. **D2009-0227**, <unofficialblackberrystore.com>, Transfer

*Intex Recreation Corp. v. RBT, Inc., Ira Weinstein*,  
WIPO Case No. **D2010-0119**, <intexpool.com>, Transfer

*Starwood Hotels & Resorts Worldwide Inc., The Sheraton LLC, Sheraton International Inc., Societe des Hotels Meridien, Westin Hotel Management L.P. v. Media Insight a/k/a Media Insights*, WIPO Case No. **D2010-0211**, <sheratonnassaubeachresort.com>, Transfer

*National Association of Realtors v. John Fothergill*,  
WIPO Case No. **D2010-1284**, <listonrealtor.com>, Transfer

*General Motors LLC v. Flashcraft, Inc DBA Cad Company*,  
WIPO Case No. **D2011-2117**, <cadillacperformance.com>, Denied

*Furla S.P.A. v. Cai Jin Yong*,  
WIPO Case No. **DCO2012-0011**, <furla.com.co>, Transfer

*Hermes International v. Brian E. Nielsen*,  
WIPO Case No. **D2013-1407**, <hermesbyhabitjp.org> et al., Transfer

*Aktiebolaget Electrolux v. Nguyen Van Dien*,  
WIPO Case No. **D2014-0490**, <baohanhelectrolux.net>, Transfer

*BSH Home Appliances Corporation v. Michael Stanley / Michael Sipo*,  
WIPO Case No. **D2014-1433**, <boschappliancepro.info> et al., Transfer

*Iveco S.p.A. v. Cong ty TNHH san xuat va TM Khang Thinh, NA*,  
WIPO Case No. **D2015-2249**, <ivecovn.com>, Transfer

*Autodesk, Inc. v. Brian Byrne, meshIP, LLC*,  
WIPO Case No. **D2017-0191**, <autocadcloud.com> and <hostedautocad.com>, Transfer

### 2.8.2 Relevant decisions

*Motorola, Inc. v. NewGate Internet, Inc.*,  
WIPO Case No. **D2000-0079**, <talkabout.com>, Transfer with Dissenting Opinion

*General Electric Company v. Japan, Inc.*,  
WIPO Case No. **D2001-0410**, <japan-ge.com>, Transfer

*Rada Mfg. Co. v. J. Mark Press a/k/a J. Mark Cutlery*,  
WIPO Case No. **D2004-1060**, <radacutlerysales.com>, Transfer

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*F. Hoffmann-La Roche AG v. Canadian Pharmacy Network Online*,  
WIPO Case No. **D2005-1203**, <canadian-pharmacy-xeloda.com>, Transfer

*X-ONE B.V. v. Robert Modic*,  
WIPO Case No. **D2010-0207**, <gaastrashop.com>, Transfer

*Vibram S.p.A. v. Chen yanbing*,  
WIPO Case No. **D2010-0981**, <discountvibramfivefingers.com>, Transfer

*Beyoncé Knowles v. Sonny Ahuja*,  
WIPO Case No. **D2010-1431**, <beyoncefragrance.com>, Transfer

*Johnson & Johnson v. Ebubekir Ozdogan*,  
WIPO Case No. **D2015-1031**, <desitin-pisik-kremi.com> and <listerineturkiye.com>, Transfer,  
Terminated in Part

*Eli Lilly and Company and Novartis Tiergesundheit AG v. Manny Ghumman / Mr. NYOB /  
Jesse Padilla*, WIPO Case No. **D2016-1698**, <buycomfortis.com> et al., Transfer

*Rakuten Kobo Inc. v. World Public Library*,  
WIPO Case No. **D2016-1708**, <kobolibrary.com> and <kobolibrary.org>, Transfer

## **2.9 Do “parked” pages comprising pay-per-click links support respondent rights or legitimate interests?**

Applying UDRP paragraph 4(c), panels have found that the use of a domain name to host a parked page comprising PPC links does not represent a bona fide offering where such links compete with or capitalize on the reputation and goodwill of the complainant’s mark or otherwise mislead Internet users.

Panels have additionally noted that respondent efforts to suppress PPC advertising related to the complainant’s trademark (e.g., through so-called “negative keywords”) can mitigate against an inference of targeting the complainant.

Panels have recognized that the use of a domain name to host a page comprising PPC links would be permissible – and therefore consistent with respondent rights or legitimate interests under the UDRP – where the domain name consists of an actual dictionary word(s) or phrase and is used to host PPC links genuinely related to the dictionary meaning of the word(s) or phrase comprising the domain name, and not to trade off the complainant’s (or its competitor’s) trademark.

In cases involving a website that is not predominantly a “typical” parked or PPC site (e.g., a blog, forum, or other informational page), where other clear, non-pretextual indicia of respondent rights or legitimate interests are present, some panels have been prepared to accept the incidental limited presence of PPC links as not inconsistent with respondent rights or legitimate interests.

[See also section 3.5.]

### **Relevant decisions**

*Express Scripts, Inc. v. Windgather Investments Ltd. / Mr. Cartwright*,  
WIPO Case No. **D2007-0267**, <express-scrips.com>, Transfer

*Asian World of Martial Arts Inc. v. Texas International Property Associates*,  
WIPO Case No. **D2007-1415**, <proforcekarate.com> et al., Transfer

*Gold Medal Travel Group plc v. Damir Kruzicevic*,  
WIPO Case No. **D2007-1902**, <goldmedal.com>, Denied

*Legacy Health System v. Nijat Hassanov*,  
WIPO Case No. **D2008-1708**, <legacyhealthsystem.com>, Transfer

*Mpire Corporation v. Michael Frey*,  
WIPO Case No. **D2009-0258**, <widgebucks.com>, Transfer

*Intel Corporation v. The Pentium Group*,  
WIPO Case No. **D2009-0273**, <pentiumgroup.net>, Transfer

*Compart AG v. Compart.com / Vertical Axis, Inc.*,  
WIPO Case No. **D2009-0462**, <compart.com>, Transfer

*Donald J. Trump v. Mediaking LLC d/b/a Mediaking Corporation and Aaftek Domain Corp.*,  
WIPO Case No. **D2010-1404**, <trumpllasvegas.com>, Transfer

*Paris Hilton v. Deepak Kumar*,  
WIPO Case No. **D2010-1364**, <parishiltonheiress.com>, Transfer

*Lardi Ltd v. Belize Domain WHOIS Service Lt*,  
WIPO Case No. **D2010-1437**, <larditrans.com>, Transfer

*Havanna S.A. v. Brendan Hight, Mdnh Inc*,  
WIPO Case No., **D2010-1652**, <havanna.com>, Denied

*Enrique Salinas Pérez v. Buydomains.com, Inventory Management*,  
WIPO Case No. **D2011-1950**, <solanum.com>, Denied

*King.com Limited and Midasplayer.com Ltd. v. Robertson J M Price, Domains By Proxy, LLC, Robertson Price, Scrapple Labs*, WIPO Case No. **D2014-1081**, <candycrush-cheats.com> et al., Transfer, Denied in Part

*Bally Gaming, Inc. d/b/a bally technologies v. Dreamhost, LLC / Aaron Stein*,  
WIPO Case No. **D2015-0757**, <caribbean-stud-poker-online.com> et al., Transfer

*E-Renter USA Ltd. v. Domain Hostmaster, Customer ID: 55391430909834, Whols Privacy Services Pty. Ltd. / Domain Administrator, Vertical Axis Inc*,  
WIPO Case No. **D2015-0784**, <erenter.com>, Denied

*Philip Morris USA Inc. v. Borut Bezjak, A Domains Limited*,  
WIPO Case No. **D2015-1128**, <marlboro.party>, Denied

*Fontem Holdings 4, B.V. v. J- B-, Limestar Inc.*,  
WIPO Case No. **D2016-0344**, <blucigarettes.org>, Transfer

*Candi Controls, Inc. v. Whois Privacy Protection Service Inc. / Domain Vault LLC*,  
WIPO Case No. **D2016-0818**, <candi.com>, Denied

*Billy Bob's Texas IP Holding LLC v. Domain Administrator, Name Administration Inc. (BVI)*,  
WIPO Case No. **D2016-1221**, <billybobs.com>, Denied

*Virgin Enterprises Limited v. LINYANXIAO aka lin yanxiao*,  
WIPO Case No. **D2016-2302**, <virginemdia.com> et al., Transfer

*Merck Sharp & Dohme Corp. v. Domain Administrator, PrivacyGuardian.org / George Ring, DN Capital Inc.*, WIPO Case No. **D2017-0302**, <gardasilvaccine.com>, Transfer

*Archer-Daniels-Midland Company v. Wang De Bing*,  
WIPO Case No. **D2017-0363**, <adm.website>, Transfer

## **2.10 Does a respondent have rights or legitimate interests in a domain name comprised of a dictionary word/phrase or acronym?**

The fact that a particular term has a dictionary meaning is sometimes confused with the notion of a “generic” term. When used in a non-dictionary distinctive sense (i.e., in a manner that bears no relation to the goods or services being sold), such dictionary terms can function as “arbitrary” trademarks. (See the “orange” example below.)

2.10.1 Panels have recognized that merely registering a domain name comprised of a dictionary word or phrase does not by itself automatically confer rights or legitimate interests on the respondent;

panels have held that mere arguments that a domain name corresponds to a dictionary term/phrase will not necessarily suffice. In order to find rights or legitimate interests in a domain name based on its dictionary meaning, the domain name should be genuinely used, or at least demonstrably intended for such use, in connection with the relied-upon dictionary meaning and not to trade off third-party trademark rights.

For example, a hypothetical respondent may well have a legitimate interest in the domain name <orange.com> if it uses the domain name for a website providing information about the fruit or the color orange. The same respondent would not however have a legitimate interest in the domain name if the corresponding website is aimed at goods or services that target a third-party trademark (in this example: *Orange*, well-known inter alia for telecommunications and Internet services) which uses the same term as a trademark in a non-dictionary sense.

Panels have assessed cases involving common phrases (whether spelled out or numerical) corresponding in whole or in part to numbers (e.g., 24/7 or 365) in a similar manner as dictionary terms.

Panels also tend to look at factors such as the status and fame of the relevant mark and whether the respondent has registered and legitimately used other domain names containing dictionary words or phrases in connection with the respective dictionary meaning.

[See generally section 3.2.1.]

- 2.10.2 For a respondent to have rights or legitimate interests in a domain name comprising an acronym, the respondent's evidence supporting its explanation for its registration (and any use) of the domain name should indicate a credible and legitimate intent which does not capitalize on the reputation and goodwill inherent in the complainant's mark.

### 2.10.1 Relevant decisions

*Allocation Network GmbH v. Steve Gregory*,  
WIPO Case No. **D2000-0016**, <allocation.com> et al., Denied

*Asphalt Research Technology, Inc. v. National Press & Publishing, Inc.*,  
WIPO Case No. **D2000-1005**, <ezstreet.net>, Denied

*402 Shoes, Inc. dba Trashy Lingerie v. Jack Weinstock and Whispers Lingerie*,  
WIPO Case No. **D2000-1223**, <trashylingerie.com>, Transfer with Concurring Opinion

*Porto Chico Stores, Inc. v. Otavio Zambon*,  
WIPO Case No. **D2000-1270**, <lovelygirls.com>, Denied

*Sweeps Vacuum & Repair Center, Inc. v. Nett Corp.*,  
WIPO Case No. **D2001-0031**, <sweeps.com>, Denied

*Classmates Online, Inc. v. John Zuccarini, individually and dba RaveClub Berlin*,  
WIPO Case No. **D2002-0635**, <classmat.com> et al., Transfer

*Gorstew Limited v. Worldwidewebsales.com*,  
WIPO Case No. **D2002-0744**, <anguillabeaches.com> et al., Denied

*Emmanuel Vincent Seal trading as Complete Sports Betting v. Ron Basset*,  
WIPO Case No. **D2002-1058**, <completesportsbetting.com>, Transfer

*Owens Corning Fiberglas Technology, Inc v. Hammerstone*,  
WIPO Case No. **D2003-0903**, <cultured-stone.com>, Transfer

*Mobile Communication Service Inc. v. WebReg, RN*,  
WIPO Case No. **D2005-1304**, <mobilcom.com>, Transfer

*Media General Communications, Inc. v. Rarenames, WebReg*,  
WIPO Case No. **D2006-0964**, <wcmh.com>, Transfer

*Commune of Zermatt and Zermatt Tourismus v. Activelifestyle Travel Network*,  
<zermatt.com>, WIPO Case No. **D2007-1318**, Denied

*Terroni Inc. v. Gioacchino Zerbo*,  
WIPO Case No. **D2008-0666**, <terroni.com>, Transfer

*Société Nationale des Chemins de Fer Français v. RareNames, Inc., RareNames WebReg and RN WebReg*, WIPO Case No. **D2008-1849**, <tgvcinema.com> et al., Transfer

*St Andrews Links Ltd v. Refresh Design*,  
WIPO Case No. **D2009-0601**, <theoldcourse.com>, Transfer

*Gibson, LLC v. Jeanette Valencia*,  
WIPO Case No. **D2010-0490**, <moderncowgirls.com>, Transfer

*B-Boy TV Ltd v. bboytv.com c/o Whois Privacy Service / Chief Rocka LTD, formerly named BreakStation LTD.*, WIPO Case No. **D2012-2006**, <bboytv.com>, Denied

*Kariyer.net Elektronik Yayıncılık ve İletişim Hizmetleri A.S v. Yenibiris İnsan Kaynakları Hizmetleri Danışmanlık ve Yayıncılık A.S*, WIPO Case No. **D2012-2151**, <kariyer.com>, Denied

*Dollar Bank, Federal Savings Bank v. Host Master / Jason Duke*,  
WIPO Case No. **D2016-0701**, <dollarbankaccount.com>, Denied

*24 Seven, Inc. v. IT Freelance / 24x7freelancer*,  
WIPO Case No. **D2016-0936**, <24x7freelancer.com>, Denied

*Javier Narvaez Segura, Grupo Loading Systems S.L. v. Domain Admin, Mrs. Jello, LLC*,  
WIPO Case No. **D2016-1199**, <loading.com>, Denied

## 2.10.2 Relevant decisions

*Belupo d.d. v. WACHEM d.o.o.*,  
WIPO Case No. **D2004-0110**, <belupo.com>, Transfer

*Archer-Daniels-Midland Company v. Shawn Downey*,  
WIPO Case No. **D2015-0415**, <adm.international>, Transfer

*Audi AG v. Mohamed Maan*,  
WIPO Case No. **D2015-0756**, <audi.press> Transfer

*The Procter & Gamble Company v. OHMY! Consult Ltd, Pezhman Ahmadi*,  
WIPO Case No. **D2015-1143**, <cresteuropa.com> Transfer

*Viacom International Inc. v. Mary Rachel Kostreva*,  
WIPO Case No. **D2016-0200**, <mtvglobal.club>, Transfer

*ETH Zürich (Eidgenössische Technische Hochschule Zürich) v. Andre Luiz Silva Rocha, Construtora Norberto Odebrecht S/A*,  
WIPO Case No. **D2016-0444**, <eth.com>, Denied

*American Franchise Marketing Limited v. Host Master, Qualcomm Inc.*,  
WIPO Case No. **D2016-1327**, <imod.com>, Denied

*Statoil ASA (Statoil) v. Domains by Proxy LLC, Domainsbyproxy.com / Frederic Bavastro*,  
WIPO Case No. **D2016-1824**, <statoilvr.com>, Transfer

*Welcomemat Services, Inc. v. Michael Plummer Jr., MLP Enterprises Inc.*,  
WIPO Case No. **D2017-0481**, <welcomemat.com> and <welcomematfranchise.com>, Transfer

## 2.11 At what point in time of respondent conduct do panels assess claimed rights or legitimate interests?

Panels tend to assess claimed respondent rights or legitimate interests in the present, i.e., with a view to the circumstances prevailing at the time of the filing of the complaint.

Without prejudice to the complainant's duty to establish that a domain name has been registered and used in bad faith, a respondent claiming a right or legitimate interest in a domain

name for example based on a prior agreement or relationship between the parties or based on past good-faith use (thus demonstrating merely a past right or legitimate interest) would not necessarily have rights or legitimate interests in the domain name, at the time a decision is rendered.

Panels will often also consider any evidence of previous legitimate use under the third UDRP element. [See also in this regard, sections 3.2.1 and 3.8 generally.]

### Relevant decisions

*Fuji Heavy Industries Ltd. (Fuji Jukogyo Kabushiki Kaisha) v. Radacini Autotrading SRL*,  
WIPO Case No. [DRO2007-0009](#), <subaru.ro>, Denied

*K & K Promotions Inc. v. Route 44 Leathers*,  
WIPO Case No. [D2011-0088](#), <eveloneclothing.com> et al., Denied

*Etro S.p.A. v. Hernan Villalobos*,  
WIPO Case No. [D2014-0264](#), <etrolounge.com>, Denied

*Pro Quidity B.V. v. Domains By Proxy LLC / Nicholas Hall, Hall Attorneys, P.C.*,  
WIPO Case No. [D2014-0765](#), <proquidity.com>, Denied

*Moomin Characters Oy Ltd v. Tapani Vuori*,  
WIPO Case No. [D2014-2062](#), <moominshop.com>, Denied

*Alessandro International GmbH v. Alessandro Gualandi*,  
WIPO Case No. [D2014-2111](#), <alessandro.com>, Denied

*MAGIX Software GmbH v. The Music Connection*,  
WIPO Case No. [D2015-1216](#), <musicmaker.com>, Denied

*The Chancellor, Masters and Scholars of the University of Cambridge v. Kirkland Holdings LLC*,  
WIPO Case No. [D2015-1278](#), <cambridge.com>, Denied

*Fanuc Corporation v. SC Metalkid 2008 SRL and Alunăriței Liliana*,  
WIPO Case No. [DRO2016-0005](#), <fanucdrill.ro> et al., Transfer

*Bruyerre S.A. v. Online Systems*,  
WIPO Case No. [D2016-1686](#), <bruyerre.com>, Transfer

*California Milk Processor Board v. Domain Admin, RegistrarAds, Inc.*,  
WIPO Case No. [D2017-0337](#), <gotpuremilk.com>, Transfer

## 2.12 Does a respondent trademark corresponding to a domain name automatically generate rights or legitimate interests?

2.12.1 Panels have recognized that a respondent's prior registration of a trademark which corresponds to a domain name will ordinarily support a finding of rights or legitimate interests in that domain name for purposes of the second element.

2.12.2 The existence of a respondent trademark does not however *automatically* confer rights or legitimate interests on the respondent. For example, panels have generally declined to find respondent rights or legitimate interests in a domain name on the basis of a corresponding trademark registration where the overall circumstances demonstrate that such trademark was obtained primarily to circumvent the application of the UDRP or otherwise prevent the complainant's exercise of its rights (even if only in a particular jurisdiction). Absent evidence of such circumstances indicating pretext however, panels have been reluctant to reject a respondent trademark registration out of hand.

### 2.12.1 Relevant decisions

*British Sky Broadcasting Group Plc. and British Sky Broadcasting Limited v. Global Access*,  
WIPO Case No. [D2009-0817](#), <skytravel.com>, Denied

*Office Holdings Limited v. Hocu To d.o.o. and Office Shoes d.o.o.*,  
WIPO Case No. [D2009-1277](#), <officeshoesonline.com>, Denied

*Air Products and Chemicals, Inc. v. Chongqing Acme Tech. Corp., Ltd.*,  
WIPO Case No. [D2011-0842](#), <surfadol.com>, Denied

*Canon U.S.A., Inc. v. Client Domain Administrator and www.eos1.net*,  
WIPO Case No. [D2012-0703](#), <canoncard.com> et al., Transfer

*Al Arabiya News Channel FZ - LLC v. ALCLICK*,  
WIPO Case No. [D2013-0079](#), <alarabiya.com>, Denied

*Mubadala Trade Marks Holding Company, LLC, Al Yah Satellite Communications Company PrJSC, and Al Maisan Satellite Communications Company, LLC v. Emedia Development Ltd. and Whois Privacy Services Pty Ltd.*,  
WIPO Case No. [D2013-0570](#), <yahclick.com> and <yahlive.com>, Denied

### 2.12.2 Relevant decisions

*Madonna Ciccone, p/k/a Madonna v. Dan Parisi and “Madonna.com”*,  
WIPO Case No. [D2000-0847](#), <madonna.com>, Transfer

*Chemical Works of Gedeon Richter Plc v. Covex Farma S.L.*,  
WIPO Case No. [D2008-1379](#), <cavinton.com> et al., Transfer, Cancellation in Part

*Air Products and Chemicals, Inc. v. Chongqing Acme Tech. Corp., Ltd.*,  
WIPO Case No. [D2011-0842](#), <surfadol.com>, Denied

*Wall-Street.com, LLC v. Marcus Kocak / Internet Opportunity Entertainment (Sports) Limited, Sportingbet PLC*, WIPO Case No. [D2012-1193](#), <wallstreet.com>, Denied

*Aukro Ukraine LLC v. PrivacyYes.com, Igor Spodin*,  
WIPO Case No. [D2013-1568](#), <vcene.com>, Transfer

*Privacy Services Pty Ltd.*,  
WIPO Case No. [D2013-0570](#), <yahclick.com> and <yahlive.net>, Denied

*Aukro Ukraine LLC v. PrivacyYes.com, Igor Spodin*,  
WIPO Case No. [D2013-1568](#), <vcene.com>, Transfer

## 2.13 How do panels treat complainant claims of illegal (e.g., counterfeit) activity in relation to potential respondent rights or legitimate interests?

2.13.1 Panels have categorically held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent. Particularly in the case of counterfeits and pharmaceuticals, this is true irrespective of any disclosure on the related website that such infringing goods are “replicas” or “reproductions” or indeed the use of such term in the domain name itself.

[See sections [3.1.4](#) and [4.2](#).]

2.13.2 Panels are generally not prepared however to accept merely conclusory or wholly unsupported allegations of illegal activity, including counterfeiting, even when the respondent is in default. On the other hand, panels have found that circumstantial evidence can support a complainant’s otherwise credible claim of illegal respondent

activity. Evidence that the goods are offered disproportionately below market value, that the goods are only sold under license or through a prescription (especially with pharmaceutical products), that the images of the goods prima facie suggest (e.g., where the relevant logo is distorted) that they are not genuine, that the respondent has misappropriated copyrighted images from the complainant's website, that the goods are extremely rare, that the goods have prompted consumer complaints, or that a respondent has improperly masked its identity to avoid being contactable, have each been found relevant in this regard. Where relevant, panels have found evidence of so-called "trap purchases" to be of additional assistance.

### 2.13.1 Relevant decisions

*Prada S.A. v. Domains For Life*,  
WIPO Case No. **D2004-1019**, <wwwprada.com>, Transfer

*Advance Magazine Publishers Inc. v. Arena International Inc.*,  
WIPO Case No. **D2011-0203**, <buyvogue.com>, Transfer

*Pierre Fabre Dermo-Cosmetique v. Simon Chen/personal/jinpingguo*,  
WIPO Case No. **D2011-0769**, <avenechina.com> et al., Transfer

*Karen Millen Fashions Limited v. Danny Cullen*,  
WIPO Case No. **D2011-1134**, <karenmillenoutletonline.com>, Denied

*Advance Magazine Publishers Inc., Les Publications Conde Nast S.A. v. Chunhai Zhang*,  
WIPO Case No. **D2012-0136**, <voguecatch.com>, Transfer

*Karen Millen Fashions Limited v. Belle Kerry*,  
WIPO Case No. **D2012-0436**, <karenmillenonline-australia.com>, Transfer

*Richemont International SA v. brandon gill*,  
WIPO Case No. **D2013-0037**, <iwcreplicawatches.com>, Transfer

*Twitter, Inc. v. Moniker Privacy Services/ accueil des solutions inc*,  
WIPO Case No. **D2013-0062**, <twitter.org>, Transfer

*PJS International SA v. Carl Johansson*,  
WIPO Case No. **D2013-0807**, <parajumpers-outlet.com>, Denied

*Philipp Plein v. Privacy Protection Service INC d/b/a PrivacyProtect.org / Norma Brandon, cheapphilippplein*, WIPO Case No. **D2015-1050**, <cheapphilippplein.com>, Transfer

*Euroview Enterprises LLC v. Jinsu Kim*,  
WIPO Case No. **D2016-1124**, <euroview.com>, Transfer

*Wikimedia Foundation, Inc. v. Walter Gerbert*,  
WIPO Case No. **D2016-1346**, <nlwikipedia.org>, Transfer

### 2.13.2 Relevant decisions

*Chopard International S.A. v. Vladimit Kozlov*,  
WIPO Case No. **D2007-1544**, <chopardreplicawatch.com>, Transfer

*Fabergé Ltd. v. Management Services*,  
WIPO Case No. **D2009-0425**, <faberge-elegance.com>, Transfer

*Moncler S.r.l. v. Sandra Brown*,  
WIPO Case No. **D2010-1674**, <ukmoncler.com>, Transfer

*Hermes International, SCA v. cui zhenhua*,  
WIPO Case No. **D2010-1743**, <hermes-handbag.com>, Transfer

*Karen Millen Fashions Limited v. Lily Rose*,  
WIPO Case No. **D2012-0428**, <karenmillen-ireland.com>, Transfer

*Belstaff S.R.L. v. jiangzheng ying*,  
WIPO Case No. **D2012-0793**, <belstaffgermany.com> et al., Transfer

*Guccio Gucci S.p.A. v. Zhiyuan Zou, Zouzhi Zhou, Fujian Anfu*,  
WIPO Case No. **D2012-0888**, <cheapguccionsale.com> et al., Transfer  
*Oakley, Inc. v. Victoriaclassic.Inc.*,  
WIPO Case No. **D2012-1968**, <oakleyglassescool.com> et al., Transfer  
*David Yurman IP LLC v. Guangsheng Zhang*,  
WIPO Case No. **D2014-1119**, <davidyurmanoutlet.net>, Transfer  
*F. Hoffmann-La Roche AG v. Shop User*,  
WIPO Case No. **D2014-1560**, <buygenericvaliumonline.com>, Transfer  
*Moncler S.p.A. v. Yao Tom, Lee Fei, Geryi Wang*,  
WIPO Case No. **D2015-2244**, <monclersaleie.com> et al., Transfer  
*Jazz Basketball Investors, Inc. v. Whoisguard Protected, Whoisguard, Inc. / Big Shen, Joan Bristol*, WIPO Case No. **D2017-0031**, <jazzbasketballteamshop.com>, Transfer  
*Céline v. Peujun Chen, Jason Zhao*,  
WIPO Case No. **D2017-0078**, <celine.online> and <celine-online.com>, Transfer  
*Alfred Dunhill, Inc. v. Registration Private, Domains By Proxy, LLC / Abdullah Altubayieb*,  
WIPO Case No. **D2017-0209**, <richarddunhill.com>, Transfer

## **2.14 Is the TLD under which a domain name is registered relevant in assessing respondent rights or legitimate interests?**

- 2.14.1 Particularly when the TLD is descriptive of or relates to goods or services (including their natural zone of expansion), a geographic region, or other term associated with the complainant, the respondent's selection of such TLD would tend to support a finding that the respondent obtained the domain name to take advantage of the complainant's mark and as such that the respondent lacks rights or legitimate interests in the domain name.
- 2.14.2 If on the other hand the meaning of the TLD appears to corroborate the respondent's bona fide use or demonstrable preparations to use the domain name (e.g., the respondent has a legitimately obtained and used trademark covering goods or services connected to the meaning of the relevant TLD), the selection of the TLD may support respondent rights or legitimate interests in the domain name.

[See generally section 1.11 and section 3.2.1.]

### **2.14.1 Relevant decisions**

*Statoil ASA v. Daniel MacIntyre, Ethical Island*,  
WIPO Case No. **D2014-0369**, <statoil.holdings> and <statoil.ventures>, Transfer  
*Fifth Street Capital LLC v. Fluder (aka Pierre Olivier Fluder)*,  
WIPO Case No. **D2014-1747**, <fifthstreet.finance>, Transfer  
*HUGO BOSS Trade Mark Management GmbH & Co. KG, HUGO BOSS AG v. Whois Agent, Whois Privacy Protection Service, Inc. / Tiagra Investments, Christopher Murphy*,  
WIPO Case No. **D2014-2022**, <hugoboss.clothing>, Transfer  
*Societe du Figaro S.A. v. Cognac Inc., Juan Hervada*,  
WIPO Case No. **D2014-2159**, <figaro.club>, Denied  
*Le Cordon Bleu International B. V. v. Keith Myers*,  
WIPO Case No. **D2015-0115**, <cordobleu.education>, Transfer  
*Accor v. WHOISt trustee.com Limited / Domain Administrator, Beyond the Dot LTD*,  
WIPO Case No. **D2015-0279**, <novotelqueenstown.kiwi>, Cancellation

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*Lloyds Bank Plc v. Marc Wiese*,  
WIPO Case No. [D2015-0914](#), <lloydsbank.brussels>, Transfer  
*Bialetti Industrie S.p.A. v. Onno Brantjes, Stichting Taxaceae*,  
WIPO Case No. [D2016-1450](#), <bialetti.coffee> et al., Transfer  
*Volkswagen AG v. Milena Milovanov*,  
WIPO Case No. [D2016-2117](#), <volkswagen.engineer>, Cancellation

#### 2.14.2 Relevant decisions

*Red Bull GmbH v. Yung Jake*,  
WIPO Case No. [D2014-2035](#), <redbull.vodka>, Transfer  
*Tractor Supply Co. of Texas, LP, Tractor Supply Company v. Itai Dor-On / Domains By Proxy, LLC*, WIPO Case No. [D2015-0026](#), <traveller.tools>, Denied  
*Audi AG, Automobili Lamborghini Holding S.p.A., Skoda Auto a.s., Volkswagen AG v. JUS TIN Pty Ltd.*, WIPO Case No. [D2015-0827](#), <audi.social> et al., Transfer  
*Philip Morris USA Inc. v. Borut Bezjak, A Domains Limited*,  
WIPO Case No. [D2015-1128](#), <marlboro.party>, Denied

#### 2.15 What is the relation between the 2nd and 3rd UDRP elements?

Apart from the circumstances surrounding their registration, to support a claim to rights or legitimate interests under the UDRP, the use of a disputed domain name must in any event not be abusive of third-party trademark rights.

In some cases therefore, panels assess the second and third UDRP elements together, for example where clear indicia of bad faith suggest there cannot be any respondent rights or legitimate interests. In such cases, panels have found that the facts and circumstances of the case would benefit from a joint discussion of the policy elements.

[See in particular in this regard, sections [3.2.1](#) (including “NB”) and [3.8](#).]

#### Relevant decisions

*Roche Products Limited v. Private Person, Livas V Kusheykas*,  
WIPO Case No. [D2011-0754](#), <accutanesale.com> and  
<buyacutanewithnoprescription.com>, Transfer  
*Total Temperature Instrumentation, Inc. DBA “Instrumart” v. Domains By Proxy, LLC / Name Redacted*,  
WIPO Case No. [D2014-0648](#), <instrumartinc.com>, Transfer  
*RESINAS OLOT, S.L. c. Francisco José López de Vega*,  
WIPO Caso No. [D2017-0050](#), <indecasa.com>, Transfer  
*Welcomemat Services, Inc. v. Michael Plummer Jr., MLP Enterprises Inc.*,  
WIPO Case No. [D2017-0481](#), <welcomemat.com> and <welcomematfranchise.com>,  
Transfer



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## THIRD UDRP ELEMENT

### 3.1 How does a complainant prove a respondent's bad faith?

**Policy criteria:** bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark. To facilitate assessment of whether this has occurred, and bearing in mind that the burden of proof rests with the complainant, UDRP paragraph 4(b) provides that any one of the following non-exclusive scenarios constitutes evidence of a respondent's bad faith:

- (i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name 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 the respondent's documented out-of-pocket costs directly related to the domain name; or
- (ii) the respondent has 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 the respondent has engaged in a pattern of such conduct; or
- (iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website 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 the respondent's website or location or of a product or service on the respondent's website or location.

**General evidentiary framework:** complaints alleging the types of conduct described in UDRP paragraph 4(b) should be supported by arguments and available evidence such as dated screenshots of the website to which the disputed domain name resolves or correspondence between the parties. Even in cases of respondent default, panels have held that wholly unsupported conclusory allegations may not be sufficient to support a complainant's case.

Panels have been prepared in appropriate cases to draw inferences concerning a respondent's (bad faith) intent from the relevant facts and circumstances.

[See section 4.2 in relation to the complainant's burden of proof.]

Given that the scenarios described in UDRP paragraph 4(b) are non-exclusive and merely illustrative, even where a complainant may not be able to demonstrate the literal or verbatim application of one of the above scenarios, evidence demonstrating that a respondent seeks to take unfair advantage of, abuse, or otherwise engage in behavior detrimental to the complainant's trademark would also satisfy the complainant's burden.

Noting that the UDRP normally provides for a single round of pleadings without opportunity for discovery, panels have expressed an expectation that a complainant should anticipate and address likely plausible respondent defenses with supporting arguments and evidence in its complaint. To the extent a response raises defenses that could not reasonably have been

anticipated, a complainant may request that the panel provide an opportunity to address such unanticipated defenses in a supplemental filing, which may also include a rebuttal opportunity for the respondent.

[See also sections 4.6, 4.7, and 4.8.]

For discussion of specific application by panels of the policy criteria see the discussion below at sections 3.1.1 through 3.1.4.

### Relevant decisions

*BlankPage AG v. Waleed Altywajiri*,

WIPO Case No. D2012-2189, <keetab.com>, Denied

*Atos IT Services UK Limited v. Above.com Domain Privacy / Nish Patel*,

WIPO Case No. D2013-0655, <redspottedhankie.com>, Transfer

*Michael Patrick Lynch v. Steve Nicol (Stephen Joel Nicol)*,

WIPO Case No. D2015-0933, <portatreat.com>, Transfer

*Arla Foods Amba and Mejeriforeningen Danish Dairy Board v. Mohammad Alkurdi*,

WIPO Case No. D2017-0391, <arlacheese.com> et al., Transfer

#### 3.1.1 How does a complainant prove that a respondent has registered or acquired a domain name primarily to sell the domain name to the complainant (or its competitor) for valuable consideration in excess of the respondent's costs related to the domain name?

Generally speaking, panels have found that the practice as such of registering a domain name for subsequent resale (including for a profit) would not by itself support a claim that the respondent registered the domain name in bad faith with the primary purpose of selling it to a trademark owner (or its competitor).

Circumstances indicating that a domain name was registered for the bad-faith purpose of selling it to a trademark owner can be highly fact-specific; the nature of the domain name (e.g., whether a typo of a famous mark, a domain name wholly incorporating the relevant mark plus a geographic term or one related to the complainant's area of commercial activity, or a pure dictionary term) and the distinctiveness of trademark at issue, among other factors, are relevant to this inquiry.

The use to which the domain name is put, particularly the absence of circumstances indicating that the respondent's aim in registering the disputed domain name was to profit from or exploit the complainant's trademark, can inform a panel's assessment of the respondent's intent. Such circumstances notably include credible pre-complaint website content corresponding to a dictionary meaning of the term comprising the domain name, as opposed to targeting the trademark owner or its competitor. Panels have also viewed a respondent's use of "negative keywords" or similar means to avoid links/content impermissibly capitalizing on a trademark as relevant in assessing a respondent's overall intent.

If on the other hand circumstances indicate that the respondent's intent in registering the disputed domain name was in fact to profit in some fashion from or otherwise exploit the complainant's trademark, panels will find bad faith on the part of the respondent. While panel assessment remains fact-specific, generally speaking such circumstances, alone or together, include: (i) the respondent's likely knowledge of the complainant's rights, (ii) the distinctiveness of the complainant's mark, (iii) a pattern of abusive

registrations by the respondent, (iv) website content targeting the complainant's trademark, e.g., through links to the complainant's competitors, (v) threats to point or actually pointing the domain name to trademark-abusive content, (vi) threats to "sell to the highest bidder" or otherwise transfer the domain name to a third party, (vii) failure of a respondent to present a credible evidence-backed rationale for registering the domain name, (viii) a respondent's request for goods or services in exchange for the domain name, (ix) a respondent's attempt to force the complainant into an unwanted business arrangement, (x) a respondent's past conduct or business dealings, or (xi) a respondent's registration of additional domain names corresponding to the complainant's mark subsequent to being put on notice of its potentially abusive activity.

Particularly where the domain name at issue is identical or confusingly similar to a highly distinctive or famous mark, panels have tended to view with a degree of skepticism a respondent defense that the domain name was merely registered for legitimate speculation (based for example on any claimed dictionary meaning) as opposed to targeting a specific brand owner.

**Offers to sell:** Taking the above scenarios into account, panels have generally found that where a registrant has an independent right to or legitimate interest in a domain name, an offer to sell that domain name would not be evidence of bad faith for purposes of the UDRP, irrespective of which party solicits the prospective sale. This also includes "generalized" offers to sell, including those on a third-party platform.

### 3.1.1 Relevant decisions

*Viceroy Cayman Ltd. v. Anthony Syrowatka*,  
WIPO Case No. **D2011-2118**, <viceroybeijing.com> et al., Transfer

*OVH SAS v. EE, Emre Erim*,  
WIPO Case No. **D2012-0330**, <ovhturk.com>, Transfer

*Yahoo! Inc. v. Mr. Omid Pournazar*,  
WIPO Case No. **D2012-1612**, <ياهو.com>, Transfer

*Adams County Society for the Prevention of Cruelty to Animals a/k/a The Rick & Sally Meyers Animal Shelter v. James Houseman*, WIPO Case No. **D2013-1447**, <meyersshelter.net>, Transfer

*OSRAM GmbH v. Joaquin Barbera (LED SMC España S.L.)*,  
WIPO Case No. **D2013-1455**, <ledosram.net>, Transfer

*Bottega Veneta SA v. ZhaoJiafei*,  
WIPO Case No. **D2013-1556**, <bottega-veneta.info>, Transfer

*Board of Supervisors of Louisiana State University and Agricultural and Mechanical College v. Registration Private, Domains by Proxy, LLC / Chad Hartvigson*,  
WIPO Case No. **D2013-1693**, <lsuteamshop.com>, Transfer

*RE/MAX, LLC v. Privacy--Protect.org / Isaac Goldstein / Hulmiho Ukolen, Shlomo Icik*,  
WIPO Case No. **D2013-2036**, <remaxdenver.com> et al., Transfer

*Avid Dating Life Inc. v. Zhu Xumei*,  
WIPO Case No. **DCO2014-0006**, <ashleymadison.com.co>, Transfer

*Cocolabel AB v. Roche Gerard*,  
WIPO Case No. **D2014-0611**, <newbody.com>, Denied

*Aygaz Anonim Şirketi v. Arthur Cain*,  
WIPO Case No. **D2014-1206**, <pursu.com>, Transfer

*SODEXO v. Nihat Bahçe, FN Market / Nihat BAHCE, fnmarket*,  
WIPO Case No. **DCC2015-0002**, <sodexo.cc>, Transfer

*Volkswagen AG v. Jan-Iver Levsen*,  
WIPO Case No. **D2015-0069**, <volkswagen.limo>, Cancellation

*Diltex, S.A. de C.V. v. Domain Administration, Web Development Group Ltd / Privacydotlink Customer 269486*, WIPO Case No. **D2015-0082**, <ilusion.com>, Denied

*Major Wire Industries Limited v. DigitalOne AG*,  
WIPO Case No. **D2015-0284**, <major.com>, Denied

*Revevol SARL v. Whoisguard Inc. / Australian Online Solutions, Domain Support*,  
WIPO Case No. **D2015-0379**, <revevol.com>, Transfer

*Bharti Airtel Limited v. Oleg Mandrik*,  
WIPO Case No. **D2015-1815**, <airtelbank.com>, Transfer

*Statoil ASA (“Statoil”) v. Cameron Jackson*,  
WIPO Case No. **D2015-2226**, <statoil.site> and <statoil.xyz>, Transfer

*Comerica Bank v. Eli Tomlinson, Eli’s Software Encyclopedia*,  
WIPO Case No. **D2016-0044**, <comerica.mortgage>, Transfer

*ZB, N.A., dba Zions First National Bank and ZB, N.A., dba Amegy Bank v. Cameron David Jackson*, WIPO Case No. **D2016-1452**, <amegybanknationalassociation.xyz> et al., Transfer

*Audi AG v. Claus Linder*,  
WIPO Case No. **D2016-1579**, <audibank.online> and <audizentrum.online>, Transfer

*BERNINA International AG v. Domain Administrator, Name Administration Inc. (BVI)*,  
WIPO Case No. **D2016-1811**, <bernette.com>, Denied (RDNH found)

*Serverscheck BVBA v. Michael Starr, DCC Corporate*,  
WIPO Case No. **D2016-1958**, <servercheck.com>, Denied

*Albemarle Corporation v. Marino Specogna*,  
WIPO Case No. **D2016-1960**, <albemarlelithium.com>, Transfer

*Autodesk, Inc. v. Bayram Fatih Aksoy*,  
WIPO Case No. **D2016-2000**, <autocadmep.com>, Transfer

*Insight Energy Ventures LLC v. Alois Muehlberger, L.M.Berger Co.Ltd.*,  
WIPO Case No. **D2016-2010**, <powerly.com>, Denied (RDNH found)

*Mou Limited v. IT Manager, Jack Zhang*,  
WIPO Case No. **D2016-2130**, <mouboots.com>, Transfer

*Bayer AG v. Whois Agent, Whois Privacy Protection Service, Inc. / Syed Hussain, IBN7 Media Group*, WIPO Case No. **D2016-2354**, <bayermonsanto.com>, Transfer

*Compagnie Générale des Etablissements Michelin v. Cameron Jackson*,  
WIPO Case No. **D2016-2392**, <michelinfrance.online> et al., Transfer

#### **Relevant decisions: Offers to sell**

*Pepperdine University v. BDC Partners, Inc.*,  
WIPO Case No. **D2006-1003**, <pepperdineuniversitywaves.com> and <pepperdineuniversitywaves.net>, Transfer

*Yahoo! Inc. v. Mr. Omid Pournazar*,  
WIPO Case No. **D2012-1612**, <ياهو.com>, Transfer

*Cofra Holding AG v. Mr Obada Alzatari*,  
WIPO Case No. **D2014-1709**, <c-a.com>, Transfer

*Cash Converters Pty Ltd. v. Cameron David Jackson*,  
WIPO Case No. **D2014-2265**, <cashconverterbabes.com> et al., Transfer

*OLX, B.V. v. Abdul Ahad / Domains By Proxy, LLC*,  
WIPO Case No. **D2015-0271**, <olx.global>, Transfer

*Oculus VR, LLC v. Sean Lin*,  
WIPO Case No. **DCO2016-0034**, <oculusrift.co>, Transfer

*Billy Bob’s Texas IP Holding LLC v. Domain Administrator, Name Administration Inc. (BVI)*,  
WIPO Case No. **D2016-1221**, <billybobs.com>, Denied

*Bayerische Motoren Werke AG v. James Vergis, Stressfree Driving School Pty Ltd*,  
WIPO Case No. **D2017-0071**, <bmwdriveschool.com>, Transfer

*Arla Foods Amba and Mejeriforeningen Danish Dairy Board v. Mohammad Alkurdi*,  
WIPO Case No. **D2017-0391**, <arlacheese.com> et al., Transfer

### **3.1.2 What constitutes a pattern of conduct of preventing a trademark holder from reflecting its mark in a domain name?**

UDRP panels have held that establishing a pattern of bad faith conduct requires more than one, but as few as two instances of abusive domain name registration.

This may include a scenario where a respondent, on separate occasions, has registered trademark-abusive domain names, even where directed at the same brand owner.

A pattern of abuse has also been found where the respondent registers, simultaneously or otherwise, multiple trademark-abusive domain names corresponding to the distinct marks of individual brand owners.

Panels have however been reluctant to find a pattern of abuse where a single UDRP case merely contains two domain names registered simultaneously by the same respondent directed at a single complainant mark.

#### **Relevant decisions**

*Home Interiors & Gifts, Inc. v. Home Interiors*,  
WIPO Case No. **D2000-0010**, <homeinteriors.net> et al., Transfer

*Telstra Corporation Limited v. Ozurls*,  
WIPO Case No. **D2001-0046**, <i-telstra.com> et al., Transfer

*Investone Retirement Specialists, Inc. v. Motohisa Ohno*,  
WIPO Case No. **D2005-0643**, <investone.com>, Denied

*Playboy Enterprises International, Inc. v. Tom Baert*,  
WIPO Case No. **D2007-0968**, <playboys.mobi>, Transfer

*AMPO, S. COOP v. Contactprivacy.com, Taeho Kim, Philippine*,  
WIPO Case No. **D2009-0177**, <ampo.com>, Transfer

*Wikimedia Foundation Inc. v. Kevo Ouz a/k/a Online Marketing Realty*,  
WIPO Case No. **D2009-0798**, <wikipedia.com>, Transfer

*Bestway Holdings Ltd v. Bkarato, AK Bkarato*  
WIPO Case No. **D2012-2485**, <bestwaygroup.com>, Transfer

*Helmut Lang New York, LLC v. Kailong Wen*,  
WIPO Case No. **D2013-0147**, <helmutlangshop.com>, Transfer

*Salvatore Ferragamo S.p.A v. Ying Cho*,  
WIPO Case No. **D2013-2034**, <ferragamojapanhot.com> et al., Transfer

*Canon U.S.A., Inc. v. Miniatures Town*,  
WIPO Case No. **D2014-0948**, <canonmug.com>, Transfer

*AKPA Dayanikli Tüketim LPG Ve Akaryakit Ürünleri Pazarlama A.S. v. Mehmet Kahveci / Domains By Proxy, LLC*, WIPO Case No. **D2014-1202**, <akpa.com>, Transfer

*Rolls-Royce PLC v. Ragnar Kallaste*,  
WIPO Case No. **D2014-2218**, <rolls-royce.trade> and <rollsroyce.trade>, Transfer

*Verizon Trademark Services LLC v. Osman Khan, NutriGold Inc*,  
WIPO Case No. **D2015-1651**, <verizonphone.best>, Transfer

*Autodesk, Inc. v. Bayram Fatih Aksoy*,  
WIPO Case No. **D2016-2000**, <autocadmep.com>, Transfer

*Halle Berry and Bellah Brands Incorporated v. Alberta Hot Rods*,  
WIPO Case No. **D2016-0256**, <halleberry.com>, Transfer

*Arla Foods Amba and Mejeriforeningen Danish Dairy Board v. Mohammad Alkurdi*,  
WIPO Case No. **D2017-0391**, <arlacheese.com> et al., Transfer

### **3.1.3 How have panels viewed the concept of registering a domain name primarily to disrupt the business of a competitor?**

Noting that the scenarios enumerated in UDRP paragraph 4(b) are non-exhaustive, panels have applied the notion of a “competitor” beyond the concept of an ordinary commercial or business competitor to also include the concept of “a person who acts in opposition to another” for some means of commercial gain, direct or otherwise.

While this may include prior customers or business partners of the complainant, it would not encompass legitimate noncommercial criticism.

#### **Relevant decisions**

*Mission KwaSizabantu v. Benjamin Rost*,  
WIPO Case No. **D2000-0279**, <kwasizabantu.com> et al., Transfer

*Twiflex Limited v. Industrial Clutch Parts Ltd*,  
WIPO Case No. **D2000-1006**, <twiflex.com>, Transfer

*Tuyap Tum Fuarcilik Yapim Anonim Sirketi (Tuyap Fairs and Exhibitions Organization Inc.) v. Tuyap /Kurumsal.net/Koznet Kurumsal Internet Hizmetleri*,  
WIPO Case No. **D2003-0442**, <tuyap.com>, Transfer

*Champion Innovations, Ltd. v. Udo Dussling (45FHH)*,  
WIPO Case No. **D2005-1094**, <championinnovation.com>, Transfer

*Travellers Exchange Corporation Limited v. Travelex Forex Money Changer*,  
WIPO Case No. **D2011-1364**, <travelexforex.com>, Transfer

*Culligan International Company v. Kqwssa LLC / Domains By Proxy, LLC*,  
WIPO Case No. **D2012-2409**, <culligansanantonio.com>, Transfer

*Bremner Capital LLP v. Ahsan Manzoor*,  
WIPO Case No. **D2014-1977**, <bremnercapitalllp.com>, Transfer

*Revevol SARL v. Whoisguard Inc. / Australian Online Solutions, Domain Support*,  
WIPO Case No. **D2015-0379**, <revevol.com>, Transfer

*Virgin Enterprises Limited v. Jay Cannon*,  
WIPO Case No. **D2016-0452**, <vgfwealthmanagement.com>, Transfer

*Welcomemat Services, Inc. v. Michael Plummer Jr., MLP Enterprises Inc.*,  
WIPO Case No. **D2017-0481**, <welcomemat.com> and <welcomematfranchise.com>, Transfer

### **3.1.4 How does a complainant prove that a respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the complainant’s mark?**

Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith.

Panels have moreover found the following types of evidence to support a finding that a respondent has registered a domain name to attract, for commercial gain, Internet users to its

website by creating a likelihood of confusion with the complainant's mark: (i) actual confusion, (ii) seeking to cause confusion (including by technical means beyond the domain name itself) for the respondent's commercial benefit, even if unsuccessful, (iii) the lack of a respondent's own rights to or legitimate interests in a domain name, (iv) redirecting the domain name to a different respondent-owned website, even where such website contains a disclaimer, (v) redirecting the domain name to the complainant's (or a competitor's) website, and (vi) absence of any conceivable good faith use. [See also generally section 2.5.3.]

As noted in section 2.13.1, given that the use of a domain name for per se illegitimate activity such as the sale of counterfeit goods or phishing can never confer rights or legitimate interests on a respondent, such behavior is manifestly considered evidence of bad faith. Similarly, panels have found that a respondent redirecting a domain name to the complainant's website can establish bad faith insofar as the respondent retains control over the redirection thus creating a real or implied ongoing threat to the complainant.

### Relevant decisions

*Veuve Clicquot Ponsardin, Maison Fondée en 1772 v. The Polygenix Group Co.*,  
WIPO Case No. **D2000-0163**, <veuveclicquot.org>, Transfer

*Park Place Entertainment Corporation v. Anything.com Ltd.*,  
WIPO Case No. **D2002-0530**, <flamingo.com>, Transfer with Dissenting Opinion

*Xbridge Limited v. Marchex Sales, Inc.*,  
WIPO Case No. **D2010-2069**, <simplybusiness.com>, Denied with Dissenting Opinion

*Revlon Consumer Products Corporation v. Moniker Privacy Services / Janice Liburd*,  
WIPO Case No. **D2011-0315**, <revlonwalk.org>, Transfer

*Georgia-Pacific Corporation v. Charlie Kalopungi*,  
WIPO Case No. **D2011-0634**, <georgiapacificjobs.com>, Transfer

*Barclays Bank PLC v. PrivacyProtect.org / Sylvia Paras*,  
WIPO Case No. **D2011-2011**, <barclayspremiercapitalinc.com>, Transfer

*Omnia Italian Design, Inc. v. Andrew Greatrex*,  
WIPO Case No. **D2013-0392**, <omnialeatherfurniture.com>, Denied

*First ScotRail Limited v. Mark Thomson*,  
WIPO Case No. **D2013-1623**, <scotrail.com>, Transfer

*Randstad Holding nv v. Pinaki Kar*,  
WIPO Case No. **D2013-1796**, <ranstadjobs.org>, Transfer

*Shawn Dohmen v. Web Sales Promotion Group, aka Confluence Consulting Group*,  
WIPO Case No. **D2014-0150**, <islediscount.com>, Transfer

*NVIDIA Corporation v. Brent Angie/Domain Admin, Privacy Protection Service INC d/b/a PrivacyProtection.org*,  
WIPO Case No. **D2014-1171**, <geforce.graphics>, Transfer

*Swarovski Aktiengesellschaft v. WhoisGuard Protected / Peter D. Person*,  
WIPO Case No. **D2014-1447**, <swarovskimarket.net>, Transfer

*Haas Food Equipment GmbH v. Usman ABD, Usmandel*,  
WIPO Case No. **D2015-0285**, <haas-mond0mix.com>, Transfer

*Pixers Ltd. v. Whois Privacy Corp.*,  
WIPO Case No. **D2015-1171**, <pixers.com>, Denied

*Labrador II, Inc. v. Viva La Pets Inc.*,  
WIPO Case No. **D2016-0010**, <onlinepetdepot.com>, Transfer

*Oculus VR, LLC v. Sean Lin*,  
WIPO Case No. **DCO2016-0034**, <oculusrift.co>, Transfer

*Friedman and Soliman Enterprises, LLC v. Gary Selesko, M&B Relocation and Referral, LLC*,  
WIPO Case No. **D2016-0800**, <junkusa.com> Transfer

*Ifscience Limited v. Domains By Proxy LLC / Dr Chauncey Siemens*,  
WIPO Case No. **D2016-0909**, <ifscience.org>, Transfer

*Walgreen Co. v. Muhammad Azeem / Wang Zheng, Nicenic International Group Co., Limited*,  
WIPO Case No. **D2016-1607**, <walgreenonlinepharmacy.com>, Transfer

*Ebel International Limited v. Alan Brashear*,  
WIPO Case No. **D2017-0001**, <cyzoneperu.com> and <esikaperu.com>, Transfer

*Booking.com BV v. Chen Guo Long*,  
WIPO Case No. **D2017-0311**, <bookingcom.xyz>, Transfer

### **3.2 What circumstances further inform panel consideration of registration in bad faith?**

In addition to the above-described application of the specific Policy criteria, panels have applied a range of considerations in assessing bad faith.

#### **3.2.1 Additional bad faith consideration factors**

Particular circumstances panels may take into account in assessing whether the respondent's registration of a domain name is in bad faith include: (i) the nature of the domain name (e.g., a typo of a widely-known mark, or a domain name incorporating the complainant's mark plus an additional term such as a descriptive or geographic term, or one that corresponds to the complainant's area of activity or natural zone of expansion), (ii) the chosen top-level domain (e.g., particularly where corresponding to the complainant's area of business activity or natural zone of expansion), (iii) the content of any website to which the domain name directs, including any changes in such content and the timing thereof, (iv) the timing and circumstances of the registration (particularly following a product launch, or the complainant's failure to renew its domain name registration), (v) any respondent pattern of targeting marks along a range of factors, such as a common area of commerce, intended consumers, or geographic location, (vi) a clear absence of rights or legitimate interests coupled with no credible explanation for the respondent's choice of the domain name, or (viii) other indicia generally suggesting that the respondent had somehow targeted the complainant.

Application of UDRP paragraph 4(b)(iv): in some cases, e.g., where it is unclear why a domain name was initially registered and the domain name is subsequently used to attract Internet users by creating a likelihood of confusion with a complainant's mark, panels have found that UDRP paragraph 4(b)(iv), read in light of paragraph 4(a)(ii), can support an inference of bad faith registration for the respondent to rebut. Such inference would be supported by a clear absence of the respondent's own rights or legitimate interests, the nature of the domain name itself (i.e., the manner in which the domain name incorporates the complainant's mark), the content of any website to which the domain name points – including any changes and the timing thereof, the registrant's prior conduct generally and in UDRP cases in particular, the reputation of the complainant's mark, the use of (false) contact details or a privacy shield to hide the registrant's identity, the failure to submit a response, the plausibility of any response, or other indicia that generally cast doubt on the registrant's bona fides.

NB, a number of cases in 2009 and 2010 (including **Mummygold**, **Octogen**, **Parvi**, and **Jappy**) explored application of registrant representations in UDRP paragraph 2 in finding so-called "retroactive" bad faith registration; while this particular concept has not been followed in subsequent cases, UDRP paragraph 2 may be relevant on its own terms. [See in particular section 3.8 below.]

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In addition to the above-described scenarios, sections 3.2.2 and 3.2.3 explore certain legal principles applied by panels in assessing respondent knowledge.

### 3.2.2 “Knew or should have known”

Noting the near instantaneous and global reach of the Internet and search engines, and particularly in circumstances where the complainant’s mark is widely known (including in its sector) or highly specific and a respondent cannot credibly claim to have been unaware of the mark (particularly in the case of domainers), panels have been prepared to infer that the respondent knew, or have found that the respondent should have known, that its registration would be identical or confusingly similar to a complainant’s mark. Further factors including the nature of the domain name, the chosen top-level domain, any use of the domain name, or any respondent pattern, may obviate a respondent’s claim not to have been aware of the complainant’s mark.

On the other hand, where the complainant’s mark is not inherently distinctive and it also corresponds to a dictionary term or is otherwise inherently attractive as a domain name (e.g., it is a short combination of letters), if a respondent can credibly show that the complainant’s mark has a limited reputation and is not known or accessible in the respondent’s location, panels may be reluctant to infer that a respondent knew or should have known that its registration would be identical or confusingly similar to the complainant’s mark. Particularly noting the Internet’s borderless nature, a sweeping respondent disclaimer of knowledge based as such on its (deemed) presence in a particular location different from the location(s) in which the complainant’s goods or services are accessible may be seen by panels as lacking in credibility or relevance. In this respect, it is noted that the business of cybersquatting often seeks to exploit the global reach of the Internet, and may in fact purposefully target a location other than that in which the respondent may be “present”.

In limited circumstances – notably where the parties are both located in the United States and the complainant has obtained a federal trademark registration pre-dating the relevant domain name registration – panels have been prepared to apply the concept of constructive notice. Application of this concept may depend in part on the complainant’s reputation and the strength or distinctiveness of its mark, or facts that corroborate an awareness of the complainant’s mark.

### 3.2.3 Willful blindness and the duty to search for and avoid trademark-abusive registrations

Panels have held that especially domainers undertaking bulk purchases or automated registrations have an affirmative obligation to avoid the registration of trademark-abusive domain names. Panelists will look to the facts of the case to determine whether such respondent has undertaken good faith efforts to screen such registrations against readily-available online databases to avoid the registration of trademark-abusive domain names.

Noting the possibility of co-existence of trademarks across jurisdictions and classes of goods and services, and the fact that trademarks which may be inherently descriptive in one context may be generic in another, the mere fact of certain domain names proving identical or confusingly similar to third-party trademarks pursuant to a search does not however mean that such registrations cannot as such be undertaken or would automatically be considered to be in bad faith.

Noting registrant obligations under UDRP paragraph 2, panels have however found that respondents who (deliberately) fail to search and/or screen registrations against available online databases would be responsible for any resulting abusive registrations under the concept of willful blindness; depending on the facts and circumstances of a case, this concept has been applied irrespective of whether the registrant is a professional domainer.

Panels have conversely found that where a respondent provides evidence that it has undertaken additional measures to avoid abusive use of any registered domain names, e.g., through methods such as applying negative keywords, such undertakings will corroborate the respondent's claim to good faith.

### 3.2.1 Relevant decisions

*Park Place Entertainment Corporation v. Anything.com Ltd.*,  
WIPO Case No. **D2002-0530**, <flamingo.com>, Transfer with Dissenting Opinion

*Collective Media, Inc. v. CKV / COLLECTIVEMEDIA.COM*,  
WIPO Case No. **D2008-0641**, <collectivemedia.com>, Denied

*Revlon Consumer Products Corporation v. Terry Baumer*,  
WIPO Case No. **D2011-1051**, <Revlon-foundations.com>, Transfer

*LEGO Juris A/S v. Domains by Proxy, Inc., DomainsByProxy.com / DBA David Inc.*,  
WIPO Case No. **D2011-1839**, <legoninjagospinjitzu.com> and <legoninjagozane.com>, Transfer

*Lloyds Bank Plc v. Marc Wiese*,  
WIPO Case No. **D2015-0914**, <lloydsbank.brussels>, Transfer

*Michael Jastremski v. Jaisen Mathai*,  
WIPO Case No. **DME2014-0006**, <openphoto.me>, Denied

*Georgia-Pacific Consumer Products LP v. Whois Privacy Services Pty Ltd. / Conquistador Sat*,  
WIPO Case No. **D2013-1458**, <brawnypapertowels.com>, Transfer

*Tudor Games, Inc. v. Domain Hostmaster, Customer ID No. 09382953107339 dba Whois Privacy Services Pty Ltd / Domain Administrator, Vertical Axis Inc.*,  
WIPO Case No. **D2014-1754**, <electricfootball.com>, Transfer

*Limited Stores, LLC v. DTAC Group / Registration Private Domains By Proxy LLC*,  
WIPO Case No. **D2014-1757**, <thelimitedscandalcollection.com>, Transfer

*Rolls-Royce PLC v. Ragnar Kallaste*,  
WIPO Case No. **D2014-2218**, <rolls-royce.trade> and <rollsroyce.trade>, Transfer

*Pixers Ltd. v. Whois Privacy Corp.*,  
WIPO Case No. **D2015-1171**, <pixers.com>, Denied

*Intesa Sanpaolo S.p.A. v. Domains Admin, New Media Nexus*,  
WIPO Case No. **D2015-1606**, <eurizon.capital>, Transfer

*Accenture Global Services Limited v. VistaPrint Technologies Ltd*,  
WIPO Case No. **D2015-1922**, <accenture.net>, Transfer

*Progeo Monitoring GmbH v. Clark Guinness*,  
WIPO Case No. **D2015-2163**, <progeogroup.com> et al., Transfer

*Aveva Group Plc. v. Edward Kim*,  
WIPO Case No. **D2015-2349**, <avevaengage.com>, Transfer

*Wendy Sue Ansel, Owner- Rocks and Runes v. Jerome Lacharite*,  
WIPO Case No. **D2015-2362**, <rocksandrunes.com>, Transfer

*Comerica Bank v. Eli Tomlinson, Eli's Software Encyclopedia*,  
WIPO Case No. **D2016-0044**, <comerica.mortgage>, Transfer

*Coolside Limited v. Get On The Web Limited*,  
WIPO Case No. **D2016-0335**, <trtl.com>, Denied

*SRAM, LLC v. Li Qing*,  
WIPO Case No. **D2016-1172**, <sram.red>, Transfer

*Carlos Andrea González, Ramón Guiral Broto, José les Viamonte v. Contact Privacy Inc. Customer 011235504 / Hubert Seiwert*,  
WIPO Case No. **D2016-1468**, <cafedelmar.com>, Transfer

*Centroamerica Comercial, Sociedad Anonima de Capital Variable (CAMCO) v. Michael Mann*,  
WIPO Case No. **D2016-1709**, <dollarcity.com>, Denied

*Arcelormittal S.A. v. Cees Willemsen*,  
WIPO Case No. **D2016-1853**, <arclormittal.com> and <arelormittal.com>, Transfer

*Virgin Enterprises Limited v. Cesar Alvarez*,  
WIPO Case No. **D2016-2140**, <virginmedia.shop>, Transfer

*IDR Solutions Ltd. v. Whois Privacy Corp*,  
WIPO Case No. **D2016-2156**, <jpedal.org>, Transfer

*Ebel International Limited v. Alan Brashear*,  
WIPO Case No. **D2017-0001**, <cyzoneperu.com> and <esikaperu.com>, Transfer

*Dr. Ing. h.c. F. Porsche AG v. Registration Private, Domains By Proxy, LLC / Jaya Yella*,  
WIPO Case No. **D2017-0044**, <p0rsche.com>, Transfer

*Tyson Foods, Inc. v. R3D HACKCID*,  
WIPO Case No. **D2017-0182**, <tysonfoodsincorp.com>, Transfer

*Arla Foods Amba and Mejeriforeningen Danish Dairy Board v. Mohammad Alkurdi*,  
WIPO Case No. **D2017-0391**, <arlacheese.com> et al., Transfer

*Awesome Events Limited v. Ben Loyd Holmes*,  
WIPO Case No. **D2017-0517**, <awesome-events.com>, Transfer

### 3.2.2 Relevant Decisions

*SembCorp Industries Limited v. Hu Huan Xin*,  
WIPO Case No. **D2001-1092**, <sembcorp.com>, Transfer

*Maori Television Service v. Damien Sampat*,  
WIPO Case No. **D2005-0524**, <maoritv.com>, Transfer

*Champion Broadcasting System, Inc. v. Nokta Internet Technologies*,  
WIPO Case No. **D2006-0128**, <wunr.com>, Transfer

*uwe GmbH v. Telepathy, Inc.*,  
WIPO Case No. **D2007-0261**, <uwe.com>, Denied

*Salt River Community Gaming Enterprises (d/b/a Casino Arizona) v. Fort McDowell Casino*,  
WIPO Case No. **D2007-0416**, <casinoarizona.com>, Transfer

*PC Mall, Inc v. NWPCMALL LLC*,  
WIPO Case No. **D2007-0420**, <nwpcmall.com>, Denied

*American Funds Distributors, Inc. v. Domain Administration Limited*,  
WIPO Case No. **D2007-0950**, <amercanfunds.com>, Transfer

*F. Hoffmann-La Roche AG v. Transure Enterprise Ltd.*,  
WIPO Case No. **D2008-0422**, <wwwroche.com>, Transfer

*Hero v. The Heroic Sandwich*,  
WIPO Case No. **D2008-0779**, <hero.com>, Denied

*The Fragrance Foundation Inc. v. Texas International Property Associates*,  
WIPO Case No. **D2008-0982**, <fragrancefoundation.com>, Transfer

*Kellwood Company v. Onesies Corporation*,  
WIPO Case No. **D2008-1172**, <onesies.net>, Denied

*Research In Motion Limited v. Privacy Locked LLC/Nat Collicot*,  
WIPO Case No. **D2009-0320**, <backberry.com>, Transfer

*Dansko, LLC v. Wenhong Chen*,  
WIPO Case No. **D2012-0583**, <danskooutletonline.com>, Transfer

*Comerica Incorporated v. Comerica Merchant Services*,  
WIPO Case No. **D2012-1678**, <comericapayments.com> and  
<comericabankmerchantservices.com>, Transfer

*Limited Stores, LLC v. Infinite Wireless*,  
WIPO Case No. **D2013-1269**, <limitedcoupon.com>, Denied

*Board of Supervisors of Louisiana State University and Agricultural and Mechanical College v. Registration Private, Domains by Proxy, LLC / Chad Hartvigson*,  
WIPO Case No. **D2013-1693**, <lsuteamshop.com>, Transfer

*Zions Bancorporation v. Jim Pearl*,  
WIPO Case No. **D2014-0007**, <zionsbusinessbanking.com>, Transfer

*Leite's Culinaria, Inc. v. Gary Cieara*,  
WIPO Case No. **D2014-0041**, Transfer

*MD On-line, Inc. v. Yenta Marketing, Inc.*,  
WIPO Case No. **D2014-1468**, <mdonline.com>, Denied

*eBay Inc. v. Renbu Bai*,  
WIPO Case No. **D2014-1693**, <ebayjordans.com>, Transfer

*Asda Stores, Ltd., Wal-Mart Stores, Inc. v. HC a/k/a Henry Chimanzi*,  
WIPO Case No. **D2014-2256**, <asda.club>, Transfer

*Volkswagen AG v. Jan-Iver Levsen*,  
WIPO Case No. **D2015-0069**, <volkswagen.limo>, Cancellation

*Nutricia International BV v. Eric Starling*,  
WIPO Case No. **D2015-0773**, <aptamilk.com>, Cancellation

*TTT Moneycorp Limited v. Privacy Gods / Privacy Gods Limited*,  
WIPO Case No. **D2016-1973**, <www.moneycorp.com>, Transfer

### **3.2.3 Relevant decisions**

*Mobile Communication Service Inc. v. WebReg, RN*,  
WIPO Case No. **D2005-1304**, <mobilcom.com>, Transfer

*Media General Communications, Inc. v. RareNames, WebReg*,  
WIPO Case No. **D2006-0964**, <wcmh.com>, Transfer

*HSBC Finance Corporation v. Clear Blue Sky Inc. and Domain Manager*,  
WIPO Case No. **D2007-0062**, <creditkeeper.com>, Transfer

*mVisible Technologies, Inc. v. Navigation Catalyst Systems, Inc.*,  
WIPO Case No. **D2007-1141**, <imyxr.com> et al., Transfer

*Grundfos A/S v. Texas International Property Associates*,  
WIPO Case No. **D2007-1448**, <groundfos.com>, Transfer

*General Electric Company v. Marketing Total S.A*,  
WIPO Case No. **D2007-1834**, <gegeneralelectric.com> et al., Transfer

*5B Investments, Inc. v. RareNames, WebReg*,  
WIPO Case No. **D2008-0146**, <storageplus.com>, Denied

*Terroni Inc. v. Gioacchino Zerbo*,  
WIPO Case No. **D2008-0666**, <terroni.com>, Transfer

*Compart AG v. Compart.com / Vertical Axis, Inc.*,  
WIPO Case No. **D2009-0462**, <compart.com>, Transfer

*Aspen Holdings Inc. v. Rick Natsch, Potrero Media Corporation*,  
WIPO Case No. **D2009-0776**, <firstquote.org>, Transfer

*Novo Nordisk A/S v. Andrew Melcher*,  
WIPO Case No. **D2010-0095**, <flectouch.com>, Denied

*Mile, Inc. v. Michael Burg*,  
WIPO Case No. **D2010-2011**, <lionsden.com>, Denied

*Barclays Bank PLC v. Andrew Barnes*,  
WIPO Case No. **D2011-0874**, <barclayslimited.com>, Transfer

*CouponCabin LLC v. Transure Enterprise Ltd, Host Master/ Above.com Domain Privacy*,  
WIPO Case No. **D2011-1571**, <mycouponcabin.com>, Transfer

*NBC Universal Media, LLC v. Flying Stingrays Ltd, Jim Macallum*,  
WIPO Case No. **D2012-1568**, <nbcnews.org>, Transfer

*İD Group v. Nomi Nee / Aero1 Ltd, No Lo / Aerol Ltd*,  
WIPO Case No. **D2012-2469**, <jaccadi.com>, Transfer

*E. Remy Martin & C° v. J Pepin - Emedia Development Ltd*,  
WIPO Case No. **D2013-1751**, <louisxiicasino.com> et al., Transfer

*Merck Sharp & Dohme Corp., MSD Consumer Care, Inc. v. Michael Johnson, THIS DOMAIN NAME IS FOR SALE*,  
WIPO Case No. **D2014-0172**, <mexana.com>, Transfer

*Philip Morris USA Inc. v. Borut Bezjak, A Domains Limited*,  
WIPO Case No. **D2015-1128**, <marlboro.party>, Denied

*Yumiko, LLC v. Domain Hostmaster, Customer ID: 44519875664713, Whois Privacy Services Pty Ltd / Stanley Pace*, WIPO Case No. **D2015-1669**, <yumiko.com>, Transfer

*Intocable, Ltd. v. Payotake LLC*,  
WIPO Case No. **D2016-1048**, <intocable.com>, Denied

### **3.3 Can the “passive holding” or non-use of a domain name support a finding of bad faith?**

From the inception of the UDRP, panelists have found that the non-use of a domain name (including a blank or “coming soon” page) would not prevent a finding of bad faith under the doctrine of passive holding.

While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant’s mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent’s concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put.

[See also section 3.4.]

#### **Relevant decisions**

*Telstra Corporation Limited v. Nuclear Marshmallows*,  
WIPO Case No. **D2000-0003**, <telstra.org>, Transfer

*Jupiters Limited v. Aaron Hall*,  
WIPO Case No. **D2000-0574**, <jupiterscasino.com> et al., Transfer

*Ladbroke Group Plc v. Sonoma International LDC*,  
WIPO Case No. **D2002-0131**, <ladbrokepoker.com> et al., Transfer

*Westdev Limited v. Private Data*,  
WIPO Case No. **D2007-1903**, <numberone.com>, Transfer

*Malayan Banking Berhad v. Beauty, Success & Truth International*,  
WIPO Case No. **D2008-1393**, <maybank.com>, Transfer

*537397 Ontario Inc. operating as Tech Sales Co. v. EXAIR Corporation*,  
WIPO Case No. **D2009-0567**, <nexflow.com> et al., Transfer

*Stertil B.V. v. Nergis*,  
WIPO Case No. **D2013-2081**, <stertil.com>, Transfer

*Bruichladdich Distillery Company Limited v. Johannes Iga Schneemann*,  
WIPO Case No. **D2014-0168**, <octomore.net>, Transfer

*Revevol SARL v. Whoisguard Inc. / Australian Online Solutions, Domain Support*,  
WIPO Case No. **D2015-0379**, <revevol.com>, Transfer

*Missoni S.p.A. v. 米索尼股份有限公司 / Missoni Limited*,  
WIPO Case No. **D2015-0843**, <missoni.网址>, Transfer

*Virgin Enterprises Limited v. Cesar Alvarez*,  
WIPO Case No. **D2016-2140**, <virginmedia.shop>, Transfer

*“Dr. Martens” International Trading GmbH and “Dr. Maertens” Marketing GmbH v. Godaddy.com, Inc.*, WIPO Case No. **D2017-0246**, <docmartens.xyz>, Transfer

### **3.4 Can the use of a domain name for purposes other than hosting trademark-abusive content constitute bad faith?**

Panels have held that the use of a domain name for purposes other than to host a website may constitute bad faith. Such purposes include sending email, phishing, identity theft, or malware distribution. (In some such cases, the respondent may host a copycat version of the complainant’s website.) Many such cases involve the respondent’s use of the domain name to send deceptive emails, e.g., to obtain sensitive or confidential personal information from prospective job applicants, or to solicit payment of fraudulent invoices by the complainant’s actual or prospective customers.

[See also section **2.13**.]

#### **Relevant decisions**

*Spoke Media Holdings, Inc. v. Andrey Volkov*,  
WIPO Case No. **D2010-1303**, <c3metrics.net>, Transfer

*DivX, LLC v. PrivacyProtect.org / Gerente de Dominia, CSRUS Enterprises*,  
WIPO Case No. **D2011-0600**, <dvix.com>, Transfer

*Publix Asset Management Company v. WhoisGuard, Inc. / Entrep, David Levey / Mr. Dunaway*,  
WIPO Case No. **D2013-1349**, <publixical.com>, Transfer

*Accor v. SANGHO HEO / Contact Privacy Inc.*,  
WIPO Case No. **D2014-1471**, <accorhotels-booking.com>, Transfer

*Haas Food Equipment GmbH v. Usman ABD, Usmandel*,  
WIPO Case No. **D2015-0285**, <haas-mond0mix.com>, Transfer

*Sydbank A/S v. Syd Bank*,  
WIPO Case No. **D2015-0324**, <dk-sydbank.com>, Transfer

*BHP Billiton Innovation Pty Ltd v. Domains By Proxy LLC / Douglass Johnson*,  
WIPO Case No. **D2016-0364**, <bhpbilliton-hr.com>, Transfer

*Accenture Global Services Limited v. Patel Holdings*,  
WIPO Case No. **D2016-0367**, <accenturejobs.com>, Transfer

*Magna International Inc. v. Mustafa Mashari*,  
WIPO Case No. **D2015-0645**, <magnahr.info>, Transfer

*Twitter, Inc. v. Whois Agent, Whois Privacy Protection Service, Inc. / Domain Support*,  
WIPO Case No. **D2015-1488**, <twittertour.com>, Transfer

*BJ's Wholesale Club v. Lisa Katz, Domain Protection LLC / Domain Hostmaster, Customer ID: 64382986619850 Whois Privacy Services Pty,*

WIPO Case No. **D2015-1601**, <wwwbjswholesaleclub.com>, Transfer

*Tetra Laval Holdings & Finance S.A. v. Named Redacted,*

WIPO Case No. **D2015-2034**, <tetrapak-uk.com>, Transfer

*Accenture Global Services Limited v. Patel Holdings,*

WIPO Case No. **D2016-0367**, <accenturejobs.com>, Transfer

*Minerva S.A. v. TT Host,*

WIPO Case No. **D2016-0384**, <minerva-food.com>, Transfer

*Minerva S.A. v. Whoisguard Protected, Whoisguard, Inc., / GREYHAT SERVICES,*

WIPO Case No. **D2016-0385**, <minevafoods.com>, Transfer

*Yahoo! Inc. v. Aman Anand, Ravi Singh, Sunil Singh, Whois Privacy Corp., Domains By Proxy, LLC,*

WIPO Case No. **D2016-0461**, <helplineyahoo.com> et al., Transfer

*Arla Foods Amba v. Michael Guthrie, M. Guthrie Building Solutions,*

WIPO Case No. **D2016-2213**, <arlarfoods.com>, Transfer

### **3.5 Can third-party generated material “automatically” appearing on the website associated with a domain name form a basis for finding bad faith?**

Particularly with respect to “automatically” generated pay-per-click links, panels have held that a respondent cannot disclaim responsibility for content appearing on the website associated with its domain name (nor would such links ipso facto vest the respondent with rights or legitimate interests).

Neither the fact that such links are generated by a third party such as a registrar or auction platform (or their affiliate), nor the fact that the respondent itself may not have directly profited, would by itself prevent a finding of bad faith.

While a respondent cannot disclaim responsibility for links appearing on the website associated with its domain name, panels have found positive efforts by the respondent to avoid links which target the complainant’s mark (e.g., through “negative keywords”) to be a mitigating factor in assessing bad faith.

[See also section 2.9.]

#### **Relevant decisions**

*Shangri-La International Hotel Management Limited v. NetIncome Ventures Inc.,*

WIPO Case No. **D2006-1315**, <shangrila.com>, Transfer

*Owens Corning v. NA,*

WIPO Case No. **D2007-1143**, <pinkbatts.com>, Transfer

*McDonald's Corporation v. ZusCom,*

WIPO Case No. **D2007-1353**, <ronaldmcdonaldhouse.info>, Transfer

*Villeroy & Boch AG v. Mario Pingerna,*

WIPO Case No. **D2007-1912**, <villeroy-boch.mobi>, Transfer

*Rolex Watch U.S.A., Inc. v. Vadim Krivitsky,*

WIPO Case No. **D2008-0396**, <rolexdealer.com>, Transfer

*The Jennifer Lopez Foundation v. Jeremiah Tieman, Jennifer Lopez Net, Jennifer Lopez, Vaca Systems LLC,*

WIPO Case No. **D2009-0057**, <jenniferlopez.net> et al., Transfer

*ALROSA v. Domain Privacy LTD, DNS Admin / The Tidewinds Group, Inc. and Elisa Marina Mendoza Rosa / Whois Privacy Services Pty Ltd, Domain Hostmaster,*  
WIPO Case No. [D2013-0256](#), <alrosa.com>, Denied

*FIL Limited v. Elliott Evans,*  
WIPO Case No. [D2014-0259](#), <fundnetwork.org>, Transfer

*MD On-line, Inc. v. Yenta Marketing, Inc.,*  
WIPO Case No. [D2014-1468](#), <mdonline.com>, Denied

*Volkswagen Aktiengesellschaft v. Robert Brodi,*  
WIPO Case No. [D2015-0299](#), <volkswagen.guru>, Cancellation

*Fédération Française de Tennis (FFT) v. Daniel Hall, dotCHAT, Inc.,*  
WIPO Case No. [D2016-1941](#), <frenchopen.chat>, Transfer

*SAP SE v. Domains by Proxy, LLC / Kamal Karmakar,*  
WIPO Case No. [D2016-2497](#), <sapbusinessonecloud.com>, Transfer

### **3.6 How does a registrant's use of a privacy or proxy service impact a panel's assessment of bad faith?**

There are recognized legitimate uses of privacy and proxy registration services; the circumstances in which such services are used, including whether the respondent is operating a commercial and trademark-abusive website, can however impact a panel's assessment of bad faith.

In terms of underlying respondent identity, panels treat privacy and proxy services as practical equivalents for purposes of the UDRP, and the fact that such services may be employed to prevent the complainant and panel from knowing the identity of the actual underlying registrant of a domain name does not prevent panel assessment of the UDRP elements.

Where it appears that a respondent employs a privacy or proxy service merely to avoid being notified of a UDRP proceeding filed against it, panels tend to find that this supports an inference of bad faith; a respondent filing a response may refute such inference.

Panels additionally view the provision of false contact information (or an additional privacy or proxy service) underlying a privacy or proxy service as an indication of bad faith.

In some cases, particularly where the respondent does not avail itself of the opportunity to respond to claims based on the timing of the registration of the disputed domain name (such as a materially relevant change in underlying registrant), panels have been prepared to infer that the use of a privacy or proxy service may seek to mask the timing of the respondent's acquisition of the domain name.

Panels have also viewed a respondent's use of a privacy or proxy service which is known to block or intentionally delay disclosure of the identity of the actual underlying registrant as an indication of bad faith.

[See also section [4.4](#).]

#### **Relevant decisions**

*Gaylord Entertainment Company v. Nevis Domains LLC,*  
WIPO Case No. [D2006-0523](#), <rymanauditorium.com>, Transfer

*Fifth Third Bancorp v. Secure Whois Information Service,*  
WIPO Case No. [D2006-0696](#), <fifththirdreward.com>, Transfer

*WWF-World Wide Fund for Nature aka WWF International v. Moniker Online Services LLC and Gregory Ricks*,  
WIPO Case No. **D2006-0975**, <wwf.com>, Denied

*HSBC Finance Corporation v. Clear Blue Sky Inc. and Domain Manager*,  
WIPO Case No. **D2007-0062**, <creditkeeper.com>, Transfer

*The iFranchise Group v. Jay Bean / MDNH, Inc. / Moniker Privacy Services [23658]*,  
WIPO Case No. **D2007-1438**, <ifranchise.com>, Denied

*Advance Magazine Publishers Inc. d/b/a Condé Nast Publications v. MSA, Inc. and Moniker Privacy Services*,  
WIPO Case No. **D2007-1743**, <wwwwired.com>, Transfer

*Ustream.TV, Inc. v. Vertical Axis, Inc.*,  
WIPO Case No. **D2008-0598**, <ustream.com>, Transfer

*FOSS A/S, FOSS NIRSystems INC v. fossnirsystems.com c/o Whois IDentity Shield /Admin, Domain*, WIPO Case No. **D2008-1256**, <fossnirsystems.com>, Transfer

*Matvil Corporation v. Private Registration / PrivacyProtect.org*,  
WIPO Case No. **D2011-0841**, <wwwetvnet.com>, Transfer

*CouponCabin LLC v. Transure Enterprise Ltd, Host Master/ Above.com Domain Privacy*,  
WIPO Case No. **D2011-1571**, <mycouponcabin.com>, Transfer

*Dr. Martens International Trading GmbH, Dr. Maertens Marketing GmbH v. Private Whois Service*,  
WIPO Case No. **D2011-1753**, <drmartinshoes.net>, Transfer

*LEGO Juris A/S v. Whois Privacy Protection Service, Inc. / Domains Secured, LLC*,  
WIPO Case No. **D2011-1857**, <mycitylego.com>, Transfer

*Omya AG and Omya UK Limited v. DomainProtect LLC*,  
WIPO Case No. **D2012-0164**, <omyauk.com>, Transfer

*The Uder Company Pty Ltd and Stay In Bed Milk & Bread Pty Ltd (trading as Aussie Farmers Direct) v. PrivacyProtect.org, Domain Admin, ID # 10760*,  
WIPO Case No. **D2012-0924**, <aussiefarmersdirect.com>, Transfer

*Ferm Living ApS v. PrivacyProtect.org / Domain Admin, Private Registrations AG*,  
WIPO Case No. **D2013-0093**, <fermliving.com>, Transfer

*E. Remy Martin & C° v. J Pepin - Emedia Development Ltd*,  
WIPO Case No. **D2013-1751**, <louisxiicasino.com> et al., Transfer

*The Teaching Company, LLC, d/b/a The Great Courses v. Privacy Protection Service INC d/b/a PrivacyProtect.org / Domain Admin, Private Registrations Aktien Gesellschaft*,  
WIPO Case No. **D2014-0456**, <thegreatcourse.com>, Transfer

*IL Makiage Cosmetics (2013) Ltd. v. Mark Rumpler / Mordechai Rumpler / Domains By Proxy, LLC*, WIPO Case No. **D2015-2311**, <il-makiage.com> and <ilmakiage.com>, Denied

*Solvay SA v. Domain Privacy Service Fbo Registrant / Mary Koehler*,  
WIPO Case No. **D2016-1357**, <solvaycom.com>, Transfer

*WhatsApp, Inc. v. Whois Agent, Whois Privacy Protection Service, Inc. / Mohammed Alkalbani, Ops Alkalbani, M. Rashid Alkalbani*,  
WIPO Case No. **D2016-2299**, <download-whatsapp-plus.net> et al., Transfer

*Fédération Internationale de Football Association ("FIFA") v. Whois Privacy Shield Services / Winsum Wong*, WIPO Case No. **D2016-2310**, <fifa.net>, Transfer

*GVC Holdings plc / ElectraWorks Limited v. Registration Private, Domains By Proxy, LLC / Adnan Atakan Alta*, WIPO Case No. **D2016-2563**, <betbwin1.com> et al., Transfer

*Compagnie Générale des Etablissements Michelin v. Privacy Protection Service INC d/b/a PrivacyProtect.org / Domain Admin, Private Registrations Aktien Gesellschaft*,  
WIPO Case No. **D2017-0096**, <michelinrebates.com>, Transfer

*Weber-Stephen Products LLC v. WhoisGuard Protected, WhoisGuard, Inc. / Daniela Gebauer, Kitchenhelpers GmbH*, WIPO Case No. **D2017-0118**, <weber-grills.net>, Transfer

*Compagnie Générale des Etablissements Michelin v. Balticsea LLC*,  
WIPO Case No. **D2017-0308**, <michlintires.com>, Transfer

*H & M Hennes & Mauritz AB v. Domain Admin, Private Registrations Aktien Gesellschaft / Domain Admin, C/O ID#10760, Privacy Protection Service INC d/b/a PrivacyProtect.org*,  
WIPO Case No. **D2017-0491**, <costores.com>, Transfer

### **3.7 How does a disclaimer on the webpage to which a disputed domain name resolves impact a panel's assessment of bad faith?**

In cases where the respondent appears to otherwise have a right or legitimate interest in a disputed domain name, a clear and sufficiently prominent disclaimer would lend support to circumstances suggesting its good faith. For example, where a respondent is legitimately providing goods or services related to the complainant's mark only (see *Oki Data* and its progeny discussed at 2.8), the presence of a clear and sufficiently prominent disclaimer can support a finding that the respondent has undertaken reasonable steps to avoid unfairly passing itself off as related to the complainant, or to otherwise confuse users.

On the other hand, where the overall circumstances of a case point to the respondent's bad faith, the mere existence of a disclaimer cannot cure such bad faith. In such cases, panels may consider the respondent's use of a disclaimer as an admission by the respondent that users may be confused.

[See generally section 3.2.]

#### **Relevant decisions**

*Estée Lauder Inc. v. estelauder.com, estelauder.net and Jeff Hanna*,  
WIPO Case No. **D2000-0869**, <estelauder.com> et al., Transfer

*Arthur Guinness Son & Co. (Dublin) Limited v. Dejan Macesic*,  
WIPO Case No. **D2000-1698**, <guinness.com>, Transfer

*Besiktas Jimnastik Kulubu Dernegi v. Mehmet Tolga Avcioglu*,  
WIPO Case No. **D2003-0035**, <besiktas.com>, Denied

*Pliva, Inc. v. Eric Kaiser*,  
WIPO Case No. **D2003-0316**, <antabuse.net>, Transfer

*AARC Inc. v. Jayashankar Balaraman*,  
WIPO Case No. **D2007-0578**, <advanceamericacash.net>, Transfer

*McMullen Argus Publishing Inc. v. Bret S. Chrismer*,  
WIPO Case No. **D2007-0703**, <streetrodder.com> and <streetrodder.net>, Denied

*Wink NYC, Inc. v. Wink New York, Inc.*,  
WIPO Case No. **D2008-1257**, <winknewyork.com> and <winkny.com>, Denied

*Broan-Nutone, LLC v. Ready Set Sales*,  
WIPO Case No. **D2010-0920**, <broanreplacementparts.com> et al., Transfer

*Beachbody, LLC v. Gregg Gillies*,  
WIPO Case No. **D2011-0358**, <p90xworkoutschedule.com>, Denied

*Educational Testing Service v. Prinn Sukriket*,  
WIPO Case No. **D2011-0439**, <toeflthai.com>, Transfer

*General Motors LLC v. Flashcraft, Inc DBA Cad Company*,  
WIPO Case No. **D2011-2117**, <cadillacperformance.com>, Denied

*Costco Wholesale Corporation, Costco Wholesale Membership, Inc. v. Gerardo Suarez, Medicina Mexico, S.A. De C.V.*, WIPO Case No. **D2013-1811**, <costcomeds.com>, Transfer

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*IKEA Systems B.V. v. James Acosta*,  
WIPO Case No. **D2013-2245**, <ikeacouponsprintable.com>, Transfer  
*Dr. Ing. h.c. F. Porsche AG v. Gaurav Khanna, Carnity*,  
WIPO Case No. **D2014-1618**, <porschedxb.com>, Transfer  
*LEGO Juris A/S v. Andrew Orr*,  
WIPO Case No. **D2015-1311**, <legominifigs.info>, Transfer  
*Carrefour v. Whois Agent, Whois Privacy Protection Service Inc. / Andres Saavedra*,  
WIPO Case No. **D2016-0608**, <viajescarrefour.net>, Transfer  
*Thirty & Co. v. Jake Marcum, Marcum Creative, LLC*,  
WIPO Case No. **D2016-1212**, <whole30.org>, Transfer

### **3.8 Can bad faith be found where a domain name was registered before the complainant acquired trademark rights?**

#### **3.8.1 Domain names registered before a complainant accrues trademark rights**

Subject to scenarios described in 3.8.2 below, where a respondent registers a domain name before the complainant's trademark rights accrue, panels will not normally find bad faith on the part of the respondent. (This would not however impact a panel's assessment of a complainant's standing under the first UDRP element.)

[See also section **1.1.3**.]

Merely because a domain name is initially created by a registrant other than the respondent before a complainant's trademark rights accrue does not however mean that a UDRP respondent cannot be found to have registered the domain name in bad faith. Irrespective of the original creation date, if a respondent acquires a domain name after the complainant's trademark rights accrue, the panel will look to the circumstances at the date the UDRP respondent itself acquired the domain name.

[See also sections **3.2**, **3.6**, and **3.1.4**.]

#### **3.8.2 Domain names registered in anticipation of trademark rights**

As an exception to the general proposition described above in **3.8.1**, in certain limited circumstances where the facts of the case establish that the respondent's intent in registering the domain name was to unfairly capitalize on the complainant's nascent (typically as yet unregistered) trademark rights, panels have been prepared to find that the respondent has acted in bad faith.

Such scenarios include registration of a domain name: (i) shortly before or after announcement of a corporate merger, (ii) further to the respondent's insider knowledge (e.g., a former employee), (iii) further to significant media attention (e.g., in connection with a product launch or prominent event), or (iv) following the complainant's filing of a trademark application.

[See also section **3.9**.]

### 3.8.1 Relevant decisions

*Mile, Inc. v. Michael Burg*,  
WIPO Case No. **D2010-2011**, <lionsden.com>, Denied

*Xbridge Limited v. Marchex Sales, Inc.*,  
WIPO Case No. **D2010-2069**, <simplybusiness.com>, Denied

*Side by Side, Inc. /dba/ Sidetrack v. Alexander Lerman*,  
WIPO Case No. **D2012-0771**, <sidetrack.com>, Denied

*Extreme Networks Limited, Extreme Drinks Limited v. Ex Drinks, LLC*,  
WIPO Case No. **D2013-0197**, <exdrinks.com>, Denied

*Forsythe Cosmetic Group, Ltd. v. R.E. Schoonover*,  
WIPO Case No. **D2014-0605**, <colorclub.com>, Transfer

*Compositech, Inc. and SRAM, LLC. v. Joseph Muino, Ciclismo UK*,  
WIPO Case No. **D2014-1343**, <zippwheels.com>, Denied

*MD On-line, Inc. v. Yenta Marketing, Inc.*,  
WIPO Case No. **D2014-1468**, <mdonline.com>, Denied

*Donald J. Trump v. SD Dillon*,  
WIPO Case No. **D2015-0077**, <trumpcard.com>, Transfer

*Wirecard AG v. Telepathy Inc., Development Services*,  
WIPO Case No. **D2015-0703**, <boon.com>, Denied

*New Forests Asset Management Pty Limited v. Kerry Schorsch, Global Advertizing, LLC*,  
WIPO Case No. **D2015-1415**, <newforests.com>, Denied

*Edatanetworks Inc. v. Joe Racek, Network of Giving*,  
WIPO Case No. **D2015-1608**, <networkofgiving.com> and <networkofgiving.org>, Denied

*Pinterest, Inc. v. Pinerest.com c/o Whois Privacy Services Pty Ltd / Ian Townsend*,  
WIPO Case No. **D2015-1873**, <pinterest.com>, Transfer

*Dreamlines GmbH v. Darshinee Naidu / World News Inc*,  
WIPO Case No. **D2016-0111**, <dreamlines.com>, Denied

*Heraeus Kulzer GmbH v. Whois Privacy Services Pty Ltd / Stanley Pace*,  
WIPO Case No. **D2016-0245**, <kulzer.com>, Transfer

*Coolside Limited v. Get On The Web Limited*,  
WIPO Case No. **D2016-0335**, <trl.com>, Denied

*TOBAM v. M. Thestrup / Best Identity*,  
WIPO Case No. **D2016-1990**, <tobam.com>, Denied

*Insight Energy Ventures LLC v. Alois Muehlberger, L.M.Berger Co.Ltd.*,  
WIPO Case No. **D2016-2010**, <powerly.com>, Denied

*Trumi International LLC contre Jean-Denis Reis*,  
WIPO Case No. **D2016-2466**, <nudagio.com>, Denied

*KION Material Handling GmbH v. Kion Printing Inc.*,  
WIPO Case No. **D2017-0025**, <kion.com>, Denied

### 3.8.2 Relevant decisions

*ExecuJet Holdings Ltd. v. Air Alpha America, Inc.*,  
WIPO Case No. **D2002-0669**, <execujet.com>, Denied

*Kangwon Land, Inc. v. Bong Woo Chun (K.W.L. Inc)*,  
WIPO Case No. **D2003-0320**, <kangwonland.com>, Transfer

*Madrid 2012, S.A. v. Scott Martin-MadridMan Websites*,  
WIPO Case No. **D2003-0598**, <2m12.com> et al., Transfer

*General Growth Properties, Inc., Provo Mall L.L.C. v. Steven Rasmussen/Provo Towne Centre Online*, WIPO Case No. **D2003-0845**, <provotownecentre.com> et al., Transfer

*Geopack v. Name Administration Inc. (BVI)*,  
WIPO Case No. **D2006-1590**, <geopack.com>, Denied

*537397 Ontario Inc. operating as Tech Sales Co. v. EXAIR Corporation*,  
WIPO Case No. **D2009-0567**, <nexflow.com> et al., Transfer

*Stoneygate 48 Limited and Wayne Mark Rooney v. Huw Marshall*,  
WIPO Case No. **D2006-0916**, <waynerooney.com>, Transfer

*San Diego Hydroponics & Organics v. Innovative Growing Solutions, Inc.*,  
WIPO Case No. **D2009-1545**, <sandiegohydro.com>, Denied

*Cosmetic Research Group v. John Miller*,  
WIPO Case No. **D2012-0014**, <institutsoskin.com>, Denied

*upjers GmbH und Co. KG v. Aşkın Ceyhan*,  
WIPO Case No. **D2012-0823**, <upjers.net>, Denied

*SIEMENS Product Lifecycle Management Software Inc. v. SOLID Applications Ltd*,  
WIPO Case No. **D2012-0882**, <solidedgeuk.com>, Denied

*Cocolabel AB v. Roche Gerard*,  
WIPO Case No. **D2014-0611**, <newbody.com>, Denied

*QIQ Communications Pty Ltd v. Netico, Inc.*,  
WIPO Case No. **D2014-1024**, <qiq.com>, Denied

*Compositech, Inc. and SRAM, LLC. v. Joseph Muino, Ciclismo UK*,  
WIPO Case No. **D2014-1343**, <zippwheels.com>, Denied

*Khloe Kardashian, Whalerock Celebrity Subscription, LLC, Khlomoney, Inc. v. Private Registrations Aktien Gesellschaft / Privacy Protection Service Inc. d/b/a Privacyprotect.Org*,  
WIPO Case No. **D2015-1113**, <khloekardashian.com>, Transfer

*BML Group Limited v. Rikard Beach, Proxy My Whois AB*,  
WIPO Case No. **D2015-1897**, <betsaf.com>, Transfer

*Aveva Group Plc. v. Edward Kim*,  
WIPO Case No. **D2015-2349**, <avevaengage.com>, Transfer

*Istanbul Kültür Üniversitesi Türkiye Cumhuriyeti v. Burak Kilanc, Kilanc Family*,  
WIPO Case No. **D2016-0391**, <dogrutercih.com> and <dogrutercih.org>, Transfer

*The Dow Chemical Company and E. I. du Pont de Nemours and Company v. Mario Rojas Serra*,  
WIPO Case No. **D2016-0595**, <dowdupontchemicals.com>, Transfer

*Groupe BMTC Inc. v. Domain Admin, Whois Privacy Corp. / Star Access, Inc.*,  
WIPO Case No. **D2016-2610**, <economax.com>, Denied

*INTERTEX, Inc. v. Shant Moughalian, Contess, Inc.*,  
WIPO Case No. **D2017-0480**, <bluedri.com> et al., Transfer

### **3.9 Can the respondent's renewal of its domain name registration support a finding of (registration in) bad faith?**

Where the respondent provides satisfactory evidence of an unbroken chain of possession, panels typically would not treat merely “formal” changes or updates to registrant contact information as a new registration.

Also, irrespective of registrant representations undertaken further to UDRP paragraph 2, panels have found that the mere renewal of a domain name registration by the same registrant is insufficient to support a finding of registration in bad faith.

On the other hand, the transfer of a domain name registration from a third party to the respondent is not a renewal and the date on which the current registrant acquired the domain name is the date a panel will consider in assessing bad faith. This holds true for single domain name acquisitions as well as for portfolio acquisitions.

In cases where the domain name registration is masked by a privacy or proxy service and the complainant credibly alleges that a relevant change in registration has occurred, it would be incumbent on the respondent to provide satisfactory evidence of an unbroken chain of registration; respondent failure to do so has led panels to infer an attempt to conceal the true underlying registrant following a change in the relevant registration. Such an attempt may in certain cases form part of a broader scenario whereby application of UDRP paragraph 4(b)(iv), read in light of paragraph 4(a)(ii), can support an inference of bad faith registration for the respondent to rebut.

[See in particular section 3.2.1.]

Facts or circumstances supporting an inference that a change in registrant has occurred may typically include a change in the content of the website to which a domain name directs to take advantage of the complainant's mark or unsolicited attempts to sell the domain name to the complainant only following such asserted change in registrant.

### Relevant decisions

*Substance Abuse Management, Inc. v. Screen Actors Modesl [sic] International, Inc. (SAMI)*,  
WIPO Case No. [D2001-0782](#), <sami.com>, Denied

*PAA Laboratories GmbH v. Printing Arts America*,  
WIPO Case No. [D2004-0338](#), <paa.com>, Denied

*Ticketmaster Corporation v. Global Access*,  
WIPO Case No. [D2007-1921](#), <ticketmast.com>, Transfer

*BMEzine.com, LLC v. Gregory Ricks / Gee Whiz Domains Privacy Service*,  
WIPO Case No. [D2008-0882](#), <bme.com>, Transfer

*Intellogy Solutions, LLC v. Craig Schmidt and IntelliGolf, Inc.*,  
WIPO Case No. [D2009-1244](#), <intellogy.com>, Denied

*Web Entertainment, LLC v. Wholsguard Protected, Inc./Tom Howe*,  
WIPO Case No. [D2014-0159](#), <y8.net>, Transfer

*Vita-Cos-Med Klett-Loch GmbH v. Perfect Privacy, LLC / MVB & Associates, Inc. and Theresa Wainright*,  
WIPO Case No. [D2014-0978](#), <phytoskin.com> et al., Transfer

*Mirza Juddani v. CDN Properties Incorporated CDN Properties Incorporated*,  
WIPO Case No. [D2014-1354](#), <skiddoo.com>, Denied

*Angelica Fuentes Téllez v. Domains by Proxy, LLC / Angela Brink*,  
WIPO Case No. [D2014-1860](#), <angelissima.com>, Denied

*Pixers Ltd. v. Whois Privacy Corp.*,  
WIPO Case No. [D2015-1171](#), <pixers.com>, Denied

*Capitalmatch Pty Ltd v. Registrar Technician, BestRegistrar.Com*,  
WIPO Case No. [D2015-2165](#), <capitalmatch.com>, Transfer

*BD Hotels, LLC v. POD Hotels Ltd*,  
WIPO Case No. [D2016-0997](#), <podhotels.com>, Denied

*Cantarella Bros Pty Limited v. Petar Karanovic, Syrah Corporation*,  
WIPO Case No. [D2016-2552](#), <gelatoria.com>, Transfer

*Charter Communications, Inc., Charter Communications Holding Company, LLC and Charter Communications Operating LLC v. Perfect Privacy, LLC / Sheri K Corwin*,  
WIPO Case No. [D2017-0040](#), <myspectrumnews.com>, Denied

### 3.10 Will panels consider statements made in settlement discussions?

The UDRP framework, and WIPO's specific panel-fee-refund practice, encourages settlement between parties.

[See generally section 4.9.]

In the UDRP context, panels tend to view settlement discussions between the parties as "admissible", particularly insofar as such discussions may be relevant to assessing the parties' respective motivations.

If, for example, negotiations between UDRP parties confirm that the respondent's intent was merely to capitalize on the complainant's rights (as opposed to using the domain name for prima facie legitimate purposes, possibly including resale), this would be material to a panel's assessment of bad faith.

However, panels are mindful that negotiations between domain name registrants and trademark owners (whether regarding a purchase or trademark-abusive content) can serve a legitimate useful purpose, and are not necessarily indicative of bad faith.

Whether settlement discussions occur before or after the filing of a UDRP proceeding is not necessarily relevant by itself to panel assessment of the case merits.

[See generally section 3.1.1.]

#### Relevant decisions

- CBS Broadcasting, Inc. v. Gaddoor Saidi*,  
WIPO Case No. [D2000-0243](#), <cbs.org>, Transfer
- Magnum Piering, Inc. v. The Mudjacks and Garwood S. Wilson, Sr.*,  
WIPO Case No. [D2000-1525](#), <magnumpiering.com> et al., Transfer
- Advance Magazine Publishers Inc. v. Marcellod Russo*,  
WIPO Case No. [D2001-1049](#), <vogueaustralia.com>, Transfer
- McMullan Bros., Limited, Maxol Limited, Maxol Direct Limited Maxol Lubricants Limited, Maxol Oil Limited Maxol Direct (NI) Limited v. Web Names Ltd*,  
WIPO Case No. [D2004-0078](#), <maxol.com>, Transfer
- NB Trademarks, Inc. v. Domain Privacy LTD and Abadaba S.A.*,  
WIPO Case No. [D2008-1984](#), <aliensport.com>, Transfer
- The South African Football Association (SAFA) v. Fairfield Tours (Pty) Ltd*,  
WIPO Case No. [D2009-0998](#), <bafanabafana.com>, Transfer
- Panino Giusto S.r.l. v. Toscana Enterprises Corporation*,  
WIPO Case No. [D2012-0574](#), <paninogiusto.com> et al., Transfer
- Cash Converters Pty Ltd v. Whios Agent / Profile Group*,  
WIPO Case No. [D2013-0689](#), <cashconverters.org>, Transfer
- Board of Supervisors of Louisiana State University and Agricultural and Mechanical College v. Registration Private, Domains by Proxy, LLC / Chad Hartvigson*,  
WIPO Case No. [D2013-1693](#), <lsuteamshop.com>, Transfer
- Lost Dog Café Corporation v. Brooks Roberts / Lost Dog Pizza Company*,  
WIPO Case No. [D2013-2012](#), <lostdogpizza.com>, Transfer
- Giorgio Armani S.p.A. v. Yitao/ Apex Laboratories Limited*,  
WIPO Case No. [D2013-2060](#), <armanijeans.org>, Transfer

*SAP SE v. Domains by Proxy, LLC / Kamal Karmakar*,  
WIPO Case No. **D2016-2497**, <sapbusinessonecloud.com>, Transfer

### **3.11 Can the use of “robots.txt” or similar mechanisms to prevent website content being accessed in an online archive impact a panel’s assessment of bad faith?**

Panels have tended to view the use of “robots.txt” (or other similar tool) as prima facie neutral. Panels moreover have been prepared to consider the use of “robots.txt” as legitimate, for example where used consistently from the inception of the respondent’s hosting website content to prevent clickfraud.

However, the use of “robots.txt” (or other similar tool) to prevent access to evidence of historical website content (e.g., on the Internet Archive at <archive.org>), particularly where employed only after notice of potential trademark abuse, may support an inference that a respondent has sought to prevent access to trademark-abusive or otherwise incriminating content. It is incumbent however on the party advancing arguments based on “robots.txt” to demonstrate their relevance to the case.

#### **Relevant decisions**

*The iFranchise Group v. Jay Bean / MDNH, Inc. / Moniker Privacy Services [23658]*,  
WIPO Case No. **D2007-1438**, <ifranchise.com>, Denied

*Bacchus Gate Corporation d/b/a International Wine Accessories v. CKV and Port Media, Inc.*,  
WIPO Case No. **D2008-0321**, <internationalwineaccessories.com>, Denied with Dissenting Opinion

*Balglow Finance S.A., Fortuna Comércio e Franquias Ltda. v. Name Administration Inc. (BVI)*,  
WIPO Case No. **D2008-1216**, <chillibeans.com>, Transfer

*Rba Edipresse, S.L. v. Brendhan Hight / MDNH Inc.*,  
WIPO Case No. **D2009-1580**, <clara.com>, Denied

*Havanna S.A. v. Brendan Hight, Mdnh Inc.*,  
WIPO Case No. **D2010-1652**, <havanna.com>, Denied

*Starwood Hotels & Resorts Worldwide, Inc., The Sheraton LLC, and Sheraton International, Inc. v. Mike James*, WIPO Case No. **D2013-1483**, <sheratonsuiteskeywest.com>. Transfer

*Attachmate Corporation v. Domain Administrator / Development Services, MindViews LLC*,  
WIPO Case No. **D2013-1622**, <filexpress.com>, Transfer

*LRC Products Limited v. Domain Admin, Privacy Protection INC d/b/a PrivacyProtect.org / Tamerlan*, WIPO Case No. **D2014-0254**, <durex.info>, Transfer

*Stena Line Travel Group AB v. Domain Vault*,  
WIPO Case No. **D2015-1207**, <sembo.com>, Transfer

*University of Stellenbosch / Stellenbosch University v. Privacydotlink Customer 336335 / Privacy Protection*, WIPO Case No. **D2015-2086**, <universityofstellenbosch.com>, Transfer

*The American Automobile Association, Inc. v. Bao Shui Chen, Poste restante*,  
WIPO Case No. **D2016-0229**, <ouraaa.com>, Transfer

### **3.12 Can tarnishment form a basis for finding bad faith?**

Noting that noncommercial fair use without intent to tarnish a complainant’s mark is a defense under the second element, using a domain name to tarnish a complainant’s mark (e.g., by posting false or defamatory content, including for commercial purposes) may constitute evidence of a respondent’s bad faith.

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[See also sections 2.4, 2.5, and 2.6.]

### Relevant decisions

*Britannia Building Society v. Britannia Fraud Prevention*,  
WIPO Case No. **D2001-0505**, <britanniabuildingsociety.org>, Denied

*Covance, Inc. and Covance Laboratories Ltd. v. The Covance Campaign*,  
WIPO Case No. **D2004-0206**, <covancecampaign.com>, Denied

*V&V Supremo Foods, Inc. v. pxlchk1@gmail.com*,  
WIPO Case No. **D2006-1373**, <1888vvsupremo.com>, Transfer

*CHRISTIAN DIOR COUTURE v. Paul Farley*,  
WIPO Case No. **D2008-0008**, <annadior.com>, Transfer

*Susan Scheff v. Psyborgue*,  
WIPO Case No. **D2008-1177**, <sueschefftruth.com>, Denied

*Sermo, Inc. v. CatalystMD, LLC*,  
WIPO Case No. **D2008-0647**, <sermosucks.com>, Denied

*Newell Operating Company v. HostMonster.Com and Andrew Shalaby*,  
WIPO Case No. **D2008-1805**, <bernzomaticinjuries.com>, Denied

*Guccio Gucci S.p.A. v. Lin Shi Jiang*,  
WIPO Case No. **D2013-2164**, <allguccisalejapan.com> et al., Transfer

*1Verge Internet Technology (Beijing) Co., Ltd. v. MARY HANSEN/ WholsGuard, Inc.*,  
WIPO Case No. **D2013-2207**, <fuckyouku.com>, Transfer

*Christian Dior Couture v. Identity Protection Service / Tom Birkett*,  
WIPO Case No. **D2014-1053**, <diorlondonescorts.com>, Transfer

*SODEXO v. Nihat Bahçe, FN Market / Nihat BAHCE, fnmarket*,  
WIPO Case No. **DCC2015-0002**, <sodexo.cc>, Transfer

*Titan Enterprises (Qid) Ply Ltd v. Dale Cross / Contact Privacy Inc*,  
WIPO Case No. **D2015-2062**, <bewareoftitangarages.com>, Denied



## PROCEDURAL QUESTIONS

### 4.1 What deference is owed to past UDRP decisions dealing with similar factual matters or legal issues?

While the UDRP does not operate on a strict doctrine of binding precedent, it is considered important for the overall credibility of the UDRP system that parties can reasonably anticipate the result of their case. Often noting the existence of similar facts and circumstances or identifying distinguishing factors, panels strive for consistency with prior decisions. In so doing, panels seek to ensure that the UDRP operates in a fair and predictable manner for all stakeholders while also retaining sufficient flexibility to address evolving Internet and domain name practices.

[See also section 4.14.]

#### Relevant decisions

*Geobra Brandstätter GmbH & Co KG v. Only Kids Inc*,  
WIPO Case No. **D2001-0841**, <playmobil.net> et al., Transfer

*Howard Jarvis Taxpayers Association v. Paul McCauley*,  
WIPO Case No. **D2004-0014**, <hjta.com>, Denied *PAA Laboratories GmbH v. Printing Arts America*,  
WIPO Case No. **D2004-0338**, <paa.com>, Denied

*Fresh Intellectual Properties, Inc. v. 800Network.com, Inc.*,  
WIPO Case No. **D2005-0061**, <800-flowers.com>, Transfer

*F. Hoffmann-La Roche AG v. Relish Enterprises*,  
WIPO Case No. **D2007-1629**, <xenicalla.com>, Transfer

*Mile, Inc. v. Michael Burg*,  
WIPO Case No. **D2010-2011**, <lionsden.com>, Denied

*Extreme Networks Limited, Extreme Drinks Limited v. Ex Drinks, LLC*,  
WIPO Case No. **D2013-0197**, <exdrinks.com>, Denied

*S.P.C.M. SA v. Whois Privacy Services Pty Ltd / Vertical Axis Inc., Domain Administrator*,  
WIPO Case No. **D2014-0327**, <snf.com>, Denied

*AKPA Dayanikli Tüketim LPG Ve Akaryakit Ürünleri Pazarlama A.S. v. Mehmet Kahveci / Domains By Proxy, LLC*, WIPO Case No. **D2014-1202**, <akpa.com>, Transfer

*LinkedIn Corporation v. Linda Audsley, The Training Company (Glos) / Domain Manager, The Training Company (Glos)*, WIPO Case No. **D2016-1757**, <linkedinlearning.com>, Transfer

*Wikimedia Foundation, Inc. v. Sarbajit Roy*,  
WIPO Case No. **D2014-2261**, <wikimedia.xyz>, Transfer

*Cameron Thomaz p/k/a Wiz Khalifa, Wiz Khalifa Trademark, LLC v. Taylor Gang Enterprises Limited Liability Corporation, Ken Warner*,  
WIPO Case No. **D2015-0473**, <taylorgang.com>, Transfer

*Accor, SoLuxury HMC v. Giovanni Laporta, Yoyo.Email*,  
WIPO Case No. **D2014-1650**, <sofitel.email>, Transfer

*Zions First National Bank v. Xu Shuaiwei / Domain Administrator, See PrivacyGuardian.org*,  
WIPO Case No. **D2015-1177**, <zonsbank.com>, Transfer

*CP Masters B.V. v. RareNames, WebReg*,  
WIPO Case No. **D2009-1673**, <imagem.com>, Denied

## 4.2 What is the applicable standard of proof in UDRP cases?

The applicable standard of proof in UDRP cases is the “balance of probabilities” or “preponderance of the evidence”; some panels have also expressed this as an “on balance” standard. Under this standard, a party should demonstrate to a panel’s satisfaction that it is more likely than not that a claimed fact is true.

While conclusory statements unsupported by evidence will normally be insufficient to prove a party’s case, panels have been prepared to draw certain inferences in light of the particular facts and circumstances of the case e.g., where a particular conclusion is prima facie obvious, where an explanation by the respondent is called for but is not forthcoming, or where no other plausible conclusion is apparent.

Noting that a complainant must prevail on all three elements to succeed, in appropriate cases where a panel finds that one of the elements is clearly not met, the panel may consider it unnecessary to address the other elements.

[See also sections 2.1, 3.1 and 3.2, and 4.3.]

### Relevant decisions

*Madonna Ciccone, p/k/a Madonna v. Dan Parisi and “Madonna.com”*,  
WIPO Case No. **D2000-0847**, <madonna.com>, Transfer

*Tribeca Film Center, Inc. v. Lorenzo Brusasco-Mackenzie*,  
WIPO Case No. **D2000-1772**, <tribecafilmcenter.com>, Denied

*Bootie Brewing Company v. Deanna D. Ward and Grabebootie Inc.*,  
WIPO Case No. **D2003-0185**, <bootiebar.com>, Denied

*William S. Russell v. Mr. John Paul Batrice d/b/a the Clock Doc*,  
WIPO Case No. **D2004-0906**, <clockdoc.com>, Denied

*Check Into Cash, Inc. v. Peter Wolfe, Microtel Ltd.*,  
WIPO Case No. **D2008-0745**, <checkintocash.info>, Transfer

*Nintendo of America Inc. v. Fernando Sascha Gutierrez*,  
WIPO Case No. **D2009-0434**, <unlimitedwiidownloads.com>, Transfer

*Comservice SA v. Mdnh Inc., Brendhan Height*,  
WIPO Case No. **D2010-1591**, <comservice.com>, Denied

*Cash Converters Pty Ltd v. John Cox*,  
WIPO Case No. **D2013-0721**, <propertycashconverters.com>, Transfer

*Montage Hotels & Resorts, LLC v. Robert McDaniel*,  
WIPO Case No. **D2013-1366**, <montagekapaluabay.com> et al., Transfer

*Veikkaus Oy v. David Webb*,  
WIPO Case No. **D2016-0373**, <veikkaus.com>, Transfer

*HUGO BOSS Trade Mark Management GmbH & Co. KG and HUGO BOSS AG v. houjianyong*,  
WIPO Case No. **D2015-2018**, <houshiboss.com>, Cancellation

*win.rar GmbH v. Win Road Assistance Repairs Pvt. Ltd.*,  
WIPO Case No. **D2015-0398**, <winrar.com>, Transfer

*Veikkaus Oy v. David Webb*,  
WIPO Case No. **D2016-0373**, <veikkaus.com>, Transfer

*Wingstop Restaurants Inc. v. Domains By Proxy, LLC / Johnson Millner / Matthew Alvarez*,  
WIPO Case No. **D2016-1004**, <wingstopmail.com> and <wingstoponline.com>, Transfer

*Dama S.p.A. v. Registration Private, Domains By Proxy, LLC / Alexandr Tymoshenko, DomainInvestGroup / Atlanta Capital Inc*,  
WIPO Case No. **D2016-0915**, <paul-shark.boutique> and <paulshark.boutique>, Transfer

*Hallmark Licensing, LLC v. EWebMall, Inc.*,  
WIPO Case No. **D2015-2202**, <hallmarkgift.com> and <hallmarkhome.com>, Denied.  
*Bayer AG v. Cagri Savan*,  
WIPO Case No. **D2015-1573**, <bayer.global>, Transfer

#### **4.3 Does a respondent's default/failure to respond to the complainant's contentions automatically result in the complaint succeeding?**

Noting the burden of proof on the complainant, a respondent's default (i.e., failure to submit a formal response) would not by itself mean that the complainant is deemed to have prevailed; a respondent's default is not necessarily an admission that the complainant's claims are true.

In cases involving wholly unsupported and conclusory allegations advanced by the complainant, or where a good faith defense is apparent (e.g., from the content of the website to which a disputed domain name resolves), panels may find that – despite a respondent's default – a complainant has failed to prove its case.

Further to paragraph 14(b) of the UDRP Rules however, panels have been prepared to draw certain inferences in light of the particular facts and circumstances of the case e.g., where a particular conclusion is prima facie obvious, where an explanation by the respondent is called for but is not forthcoming, or where no other plausible conclusion is apparent.

Panels have typically treated a respondent's submission of a so-called "informal response" (merely making unsupported conclusory statements and/or failing to specifically address the case merits as they relate to the three UDRP elements, e.g., simply asserting that the case "has no merit" and demanding that it be dismissed) in a similar manner as a respondent default.

[See also sections **2.1**, **3.1** and **3.2**, and **4.2**.]

#### **Relevant decisions**

*The Vanguard Group, Inc. v. Lorna Kang*,  
WIPO Case No. **D2002-1064**, <vanguar.com>, Transfer  
*Berlitz Investment Corp. v. Stefan Tinculescu*,  
WIPO Case No. **D2003-0465**, <berlitzsucks.com>, Transfer  
*Brooke Bollea, a.k.a Brooke Hogan v. Robert McGowan*,  
WIPO Case No. **D2004-0383**, <brookehogan.com>, Denied  
*Mancini's Sleepworld v. LAKSH INTERNET SOLUTIONS PRIVATE LIMITED*,  
WIPO Case No. **D2008-1036**, <mancinissleepworld.com>, Denied  
*Allianz, Compañía de Seguros y Reaseguros S.A. v. John Michael*,  
WIPO Case No. **D2009-0942**, <allianz-es.com>, Transfer  
*M. Corentin Benoit Thiercelin v. CyberDeal, Inc.*,  
WIPO Case No. **D2010-0941**, <virtualexpo.com>, Denied  
*Tradewind Media, LLC d/b/a Intopic Media v. Jayson Hahn*,  
WIPO Case No. **D2010-1413**, <intopicmedia.org>, Denied  
*PJS International SA v. Carl Johansson*,  
WIPO Case No. **D2013-0807**, <parajumpersoutlet.com>, Denied  
*Groupe Auchan v. Roberto La Palombara*,  
WIPO Case No. **D2014-0660**, <qilive.net>, Transfer  
*Lonsdale Sports Limited v. Holger Doelle*,  
WIPO Case No. **D2016-1140**, <lonsdale.world>, Transfer

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*Sportsdirect.com Retail Limited v. WhoisGuard Protected, WhoisGuard, Inc. / Anwar Rehman*,  
WIPO Case No. D2016-0926, <sports-direct.online> et al., Transfer

#### 4.4 How is respondent identity assessed in a case involving a privacy or proxy registration service?

Paragraph 1 of the UDRP Rules defines the respondent as “the holder of a domain name registration against which a complaint is initiated.” In many cases however, the named respondent listed in the Whois register is not a person or corporation, but a “privacy” or “proxy” registration service. Regarding the latter, paragraph 4(b) of the UDRP Rules provides that:

“Any updates to the Respondent’s data, such as through the result of a request by a privacy or proxy provider to reveal the underlying customer data, must be made before the two (2) business day period concludes or before the Registrar verifies the information requested and confirms the Lock to the UDRP Provider, whichever occurs first. Any modification(s) of the Respondent’s data following the two (2) business day period may be addressed by the Panel in its decision.”

##### 4.4.1 WIPO Center practice

As a matter of panel-endorsed practice, in cases involving a privacy or proxy registration service initially named as the respondent, on timely receipt from the registrar (or privacy or proxy service) of information relating to an underlying or beneficial registrant, further to its compliance review and case notification responsibilities, the WIPO Center will (a) provide any disclosed underlying registrant information to the complainant, and (b) invite the complainant to amend the complaint to reflect such information.

Noting the definition of “respondent” in the UDRP Rules, where underlying registrant information is disclosed/provided to the complainant, the complainant chooses not to amend its complaint, and instead to retain the Whois-listed registrant as the named respondent, the WIPO Center would not normally treat this as a complaint deficiency. Complainants do however tend to amend their complaints in such scenarios to reflect any disclosed underlying registrant information, in particular to avoid raising possible decision enforcement questions by the registrar.

##### 4.4.2 Adding or replacing the respondent

When provided with underlying registrant information which differs from the respondent named in the complaint, a complainant may either *add* the disclosed underlying registrant as a co-respondent, or *replace* the originally named privacy or proxy service with the disclosed underlying registrant. In either event, complainants may also amend or supplement certain substantive aspects of the complaint (notably the second and third elements) in function of any such disclosure. [See also section 4.11.2.]

##### 4.4.3 Mutual jurisdiction

Noting the possibility for a respondent to commence a legal proceeding in one of two complainant-elected “mutual jurisdictions” (the location of the registrar’s principal office, or the registrant’s address shown in the Whois database at the time the complaint is submitted), when amending a complaint pursuant to disclosure of an underlying

registrant, complainants will sometimes amend the mutual jurisdiction section of their complaint.

#### 4.4.4 Complaint notification

Irrespective of the entity or entities ultimately recorded by the panel as the respondent(s) in a particular case, in satisfying its notification obligations, the WIPO Center practice provides notice of the complaint to all available registrant contacts including the privacy or proxy service and any underlying registrant.

#### 4.4.5 Panel discretion

In all cases involving a privacy or proxy service and irrespective of the disclosure of any underlying registrant, the appointed panel retains discretion to determine the respondent against which the case should proceed.

Depending on the facts and circumstances of a particular case, e.g., where a timely disclosure is made, and there is no indication of a relationship beyond the provision of privacy or proxy registration services, a panel may find it appropriate to apply its discretion to record only the underlying registrant as the named respondent. On the other hand, e.g., where there is no clear disclosure, or there is some indication that the privacy or proxy provider is somehow related to the underlying registrant or use of the particular domain name, a panel may find it appropriate to record both the privacy or proxy service and any nominally underlying registrant as the named respondent.

#### 4.4.6 Undisclosed/uncertain underlying beneficial registrant

Particularly noting UDRP paragraph 8(a), panels have found that where a “disclosed” registrant is in turn what appears to be yet another privacy or proxy service (sometimes referred to as a “Russian doll” scenario) or prima facie appears to be a false identity, such multi-layered obfuscation or possible cyberflight may support an inference of a respondent’s bad faith, e.g., in an attempt to shield illegitimate conduct from a UDRP proceeding.

A number of panels have also made reference to paragraph 3.7.7.3 of the ICANN Registrar Accreditation Agreement which states that a Whols-listed registrant (referred to as the “Registered Name Holder”) accepts liability for any use of the relevant domain name unless it timely discloses the contact information of any underlying beneficial registrant. [See generally section 3.6.]

#### 4.4.1 Relevant decisions

*Advance Magazine Publishers Inc. d/b/a Condé Nast Publications v. MSA, Inc. and Moniker Privacy Services*, WIPO Case No. **D2007-1743**, <wwwwired.com>, Transfer

*F. Hoffmann-La Roche AG v. PrivacyProtect.org, Domain Admin and Mark Sergijenko*, WIPO Case No. **D2007-1854**, <xenicalbuy.com>, Transfer

*Elvstrom Sails A/S v. Moniker Privacy Services*, WIPO Case No. **D2008-0393**, <elvstromsails.com>, Denied

*Association Robert Mazars v. Private Whois Service, c/o mazarsrevenge.com*, WIPO Case No. **D2009-0183**, <mazarsrevenge.com>, Transfer

*Research In Motion Limited v. PrivacyProtect.org / Pluto Domain Services Private Limited*, WIPO Case No. **D2009-0324**, <blackberru.com> et al., Transfer

*Hertz System, Inc. v. Domainproxyagent.com / Compsys Domain Solutions Private Limited*,  
WIPO Case No. **D2009-0615**, <www2hertz.com>, Transfer

*LEGO Juris A/S v. Domains By Proxy, LLC / Netzero Tools - Jason Kaylor*,  
WIPO Case No. **D2012-2141**, <legoreview.org>, Transfer

#### **4.4.2 Relevant decisions**

*Mrs. Eva Padberg v. Eurobox Ltd.*,  
WIPO Case No. **D2007-1886**, <eva-padberg.com>, Transfer

*Research In Motion Limited v. Privacy Locked LLC/Nat Collicot*,  
WIPO Case No. **D2009-0320**, <backberry.com>, Transfer

*Research In Motion Limited v. PrivacyProtect.org / Pluto Domain Services Private Limited*,  
WIPO Case No. **D2009-0324**, <blackberru.com> et al., Transfer

*RapidShare AG, Christian Schmid v. PrivacyAnywhere Software, LLC, Mikhail Berdnikov (Protected Domain Services Customer ID: DSR-2262893, Protected Domain Services Customer ID: DSR-2092987) and RapidShare AG, Christian Schmid v. Winsoul, Inc., Aleksey Atushev; (Protected Domain Services Customer ID: DSR-2239262)*,  
WIPO Case No. **D2010-0894**, <rapidsharefilesdownload.com> et al., Transfer

*Western Woods Distributing, Inc. v. Domains By Proxy, LLC, DomainsByProxy.com / Mike Mallon*, WIPO Case No. **D2015-1400**, <westernwoods.com>, Transfer

#### **4.4.3 Relevant decisions**

*Research In Motion Limited v. Privacy Locked LLC/Nat Collicot*,  
WIPO Case No. **D2009-0320**, <backberry.com>, Transfer

*Research In Motion Limited v. PrivacyProtect.org / Pluto Domain Services Private Limited*,  
WIPO Case No. **D2009-0324**, <blackberru.com> et al., Transfer

*Hertz System, Inc. v. Domainproxyagent.com / Compsys Domain Solutions Private Limited*,  
WIPO Case No. **D2009-0615**, <www2hertz.com>, Transfer

#### **4.4.4 Relevant decisions**

*Advance Magazine Publishers Inc. d/b/a Condé Nast Publications v. MSA, Inc. and Moniker Privacy Services*, WIPO Case No. **D2007-1743**, <wwwwired.com>, Transfer

*F. Hoffmann-La Roche AG v. PrivacyProtect.org, Domain Admin and Mark Sergijenko*,  
WIPO Case No. **D2007-1854**, <xenicalbuy.com>, Transfer

*Elvstrom Sails A/S v. Moniker Privacy Services*,  
WIPO Case No. **D2008-0393**, <elvstromsails.com>, Denied

*Viacom International Inc. v. Pablo, Palermao / Moniker Privacy Services*,  
WIPO Case No. **D2008-1179**, <teenick.com>, Transfer

*Association Robert Mazars v. Private Whois Service, c/o mazarsrevenge.com*,  
WIPO Case No. **D2009-0183**, <mazarsrevenge.com>, Transfer

#### **4.4.5 Relevant decisions**

*Xtraplus Corporation v. Flawless Computers*,  
WIPO Case No. **D2007-0070**, <zipzoomflysucks.com>, Denied

*Advance Magazine Publishers Inc. d/b/a Condé Nast Publications v. MSA, Inc. and Moniker Privacy Services*, WIPO Case No. **D2007-1743**, <wwwwired.com>, Transfer

*F. Hoffmann-La Roche AG v. PrivacyProtect.org, Domain Admin and Mark Sergijenko*,  
WIPO Case No. **D2007-1854**, <xenicalbuy.com>, Transfer

*The Jennifer Lopez Foundation v. Jeremiah Tieman, Jennifer Lopez Net, Jennifer Lopez, Vaca Systems LLC*, WIPO Case No. **D2009-0057**, <jenniferlopez.net> et al., Transfer

#### 4.4.6 Relevant decisions

*TDS Telecommunications Corporation v. Registrant [20758] Nevis Domains and Registrant [117460] Moniker Privacy Services,*

WIPO Case No. [D2006-1620](#), <tdstelecom.net>, Transfer

*HSBC Finance Corporation v. Clear Blue Sky Inc. and Domain Manager,*

WIPO Case No. [D2007-0062](#), <creditkeeper.com>, Transfer

*CanWest Mediaworks Publications Inc. v. Laksh Internet Solutions Private Limited / SA c/o FP,* WIPO Case No. [D2008-0687](#), <theedmontonjournal.com>, Transfer

*Viacom International Inc. v. Pablo, Palermao / Moniker Privacy Services,*

WIPO Case No. [D2008-1179](#), <teenick.com>, Transfer

*The Jennifer Lopez Foundation v. Jeremiah Tieman, Jennifer Lopez Net, Jennifer Lopez, Vaca Systems LLC,* WIPO Case No. [D2009-0057](#), <jenniferlopez.net> et al., Transfer

*Jay Leno v. St. Kitts Registry, Domain Names Administration,*

WIPO Case No. [D2009-0571](#), <jaylenoshow.com>, Transfer

*RapidShare AG, Christian Schmid v. Protected Domain Services/Dmytro Gerasymenko,*

WIPO Case No. [D2010-1071](#), <rapidpedia.com>, Transfer

*The Royal Bank of Scotland Group plc v. Reserved Bench of Strategic Geographers / Domain ID Shield Service,* WIPO Case No. [D2012-1733](#), <rbsgrps.com>, Transfer

*LEGO Juris A/S v. Domains By Proxy, LLC / Netzero Tools - Jason Kaylor,*

WIPO Case No. [D2012-2141](#), <legoreview.org>, Transfer

*Revevol SARL v. Whoisguard Inc. / Australian Online Solutions, Domain Support,*

WIPO Case No. [D2015-0379](#), <revevol.com>, Transfer

#### 4.5 How is the (working) language of a UDRP proceeding determined?

##### 4.5.1 Language of Proceeding

Pursuant to paragraph 11 of the UDRP Rules, unless otherwise agreed by the parties, the default language of the proceeding is the language of the registration agreement, subject to the authority of the panel to determine otherwise.

Noting the aim of conducting the proceedings with due expedition, paragraph 10 of the UDRP Rules vests a panel with authority to conduct the proceedings in a manner it considers appropriate while also ensuring both that the parties are treated with equality, and that each party is given a fair opportunity to present its case.

Against this background, panels have found that certain scenarios may warrant proceeding in a language other than that of the registration agreement. Such scenarios include (i) evidence showing that the respondent can understand the language of the complaint, (ii) the language/script of the domain name particularly where the same as that of the complainant's mark, (iii) any content on the webpage under the disputed domain name, (iv) prior cases involving the respondent in a particular language, (v) prior correspondence between the parties, (vi) potential unfairness or unwarranted delay in ordering the complainant to translate the complaint, (vii) evidence of other respondent-controlled domain names registered, used, or corresponding to a particular language, (viii) in cases involving multiple domain names, the use of a particular language agreement for some (but not all) of the disputed domain names, (ix) currencies accepted on the webpage under the disputed domain name, or (x) other indicia tending to show that it would not be unfair to proceed in a language other than that of the registration agreement.

The credibility of any submissions by the parties and in particular those of the respondent (or lack of reaction after having been given a fair chance to comment) are particularly relevant.

Where it appears the parties reasonably understand the nature of the proceedings, panels have also determined the language of the proceeding/decision taking account of the panel's ability to understand the language of both the complaint and the response such that each party may submit pleadings in a language with which it is familiar.

#### **4.5.2 Party requests concerning the Language of Proceeding (WIPO Center practice)**

Panels have recognized that a preliminary determination by the WIPO Center may be necessary where a party (typically the complainant) requests for the proceeding to be administered in a language other than that of the registration agreement.

Following the registrar's confirmation as to the language of the registration agreement, and in order to preserve the panel's discretion under paragraph 11 of the UDRP Rules to determine the appropriate language of proceedings, where a complaint has been submitted in a language other than that of the registration agreement, the WIPO Center will notify both parties (in all relevant languages where possible) of the discrepancy between the language of the registration agreement and the complaint.

In such cases, the complainant is invited to either translate the complaint or, if not already included in the original complaint, to formally submit a motivated request that the proceedings be conducted in the language of the complaint. Such requests often take account of the factors listed above in section 4.5.1. The respondent is given a subsequent opportunity to comment on or to oppose (if it wishes, in the language of the Registration Agreement) the complainant's arguments.

In the interest of fairness and to preserve continuity in the case, prior to panel appointment and determination of the language of the proceedings, where possible, the WIPO Center seeks to send "dual language" case-related communications to the parties (i.e., in both the language of the registration agreement, and the language of the complaint).

On panel appointment, both parties' arguments are provided to the panel for its determination as to the language of proceeding. This may include accepting the complaint as filed, and a response in the language of the registration agreement, thereby seeking to give both parties a fair opportunity to present their case. In certain cases however, owing to due process concerns, a panel may order that the complaint be translated into the language of the registration agreement.

#### **4.5.1 Relevant decisions**

*Telstra Corporation Limited v. Telsra com /Telecomunicaciones Serafin Rodriguez y Asociados*, WIPO Case No. **D2003-0247**, <telsra.com>, Transfer

*Fondation Le Corbusier v. Monsieur Bernard Weber, Madame Heidi Weber*, WIPO Case No. **D2003-0251**, <artlecorbusier.com> et al., Denied, Transfer in Part

*Advanced Magazine Publishers Inc. v. Computer Dazhong*, WIPO Case No. **D2003-0668**, <voguedress.com>, Transfer

*Volkswagen AG v. Nowack Auto und Sport - Oliver Nowack*, WIPO Case No. **D2015-0070**, <volkswagenmotorsport.com>, Transfer

*Groupe Auchan v. Yang Yi*,  
WIPO Case No. [D2014-2094](#), <auchan.xyz>, Transfer  
*Orlane S.A. v. Yu Zhou He / He Yu Zhou*,  
WIPO Case No. [D2016-1763](#), <orlane.vip>, Transfer

#### 4.5.2 Relevant decisions

*L'Oreal S.A. v. MUNHYUNJA*,  
WIPO Case No. [D2003-0585](#), <shuueamura.com>, Transfer  
*Deutsche Messe AG v. Kim Hyungho*,  
WIPO Case No. [D2003-0679](#), <cebit.com>, Transfer  
*SWX Swiss Exchange v. SWX Financial LTD*,  
WIPO Case No. [D2008-0400](#), <swxtrader.com>, Transfer  
*MySpace Inc. v. Will Eom*,  
WIPO Case No. [D2008-0448](#), <myspace.com>, Transfer  
*Fissler GmbH v. Chin Jang Ho*,  
WIPO Case No. [D2008-1002](#), <fissler.com>, Transfer  
*Zappos.com, Inc. v. Zufu aka Huahaotrade*,  
WIPO Case No. [D2008-1191](#), <shopzappos.com>, Transfer  
*Biotechnology and Biological Sciences Research Council v. Kim Jung Hak*,  
WIPO Case No. [D2009-1583](#), <bbsrc.com>, Transfer  
*Paul's Boutique Limited v. Fulongyang, longyang fu, Fundacion Private Whois, fu longyang, Zhang Qianqian, Cheng Mingsheng*,  
WIPO Case No. [D2013-0029](#), <paulsboutiquebag.com> et al., Transfer  
*Laverana GmbH & Co. KG v. Silkewang, Jiangsu Yun Lin Culture Communication Co., Ltd. / xia men yi ming wang luo you xian gong si*,  
WIPO Case No. [D2016-0721](#), <lavera.wang>, Transfer  
*eBay Inc. v. NicSoft, Antonio Francesco Tedesco*,  
WIPO Case No. [D2014-0812](#), <ebaybiologic.com>, Transfer  
*F.lli De Cecco S.p.A. v. Xiamen Privacy Protection Service Co. Ltd. / CAIHEQIONG, AGRINOON (FUJIAN) ECOLOGICAL AGRICULTURE CO.,LTD. / Cai Heqiong*,  
WIPO Case No. [D2016-1273](#), <dececco.com>, Transfer

#### 4.6 In what circumstances would a panel accept a party's unsolicited supplemental filing?

NB, at least at the WIPO Center, parties' unsolicited supplemental filings are not subject to party payment of additional administrative fees. (While other providers may charge a fee for processing such filings, a panel is under no obligation to accept it as part of the case file. On this subject see inter alia *Parfums Christian Dior S.A. v. Jadore*, WIPO Case No. [D2000-0938](#).)

Paragraph 10 of the UDRP Rules vests the panel with the authority to determine the admissibility, relevance, materiality and weight of the evidence, and also to conduct the proceedings with due expedition.

Paragraph 12 of the UDRP Rules expressly provides that it is for the panel to request, in its sole discretion, any further statements or documents from the parties it may deem necessary to decide the case.

Unsolicited supplemental filings are generally discouraged, unless specifically requested by the panel.

On receipt of a request to submit an unsolicited supplemental filing or the actual receipt of such filing, the WIPO Center will confirm receipt of the request or filing to the parties, and forward such request or filing to the panel for its consideration as to admissibility.

In all such cases, panels have repeatedly affirmed that the party submitting or requesting to submit an unsolicited supplemental filing should clearly show its relevance to the case and why it was unable to provide the information contained therein in its complaint or response (e.g., owing to some “exceptional” circumstance).

Depending on the content of any admitted supplemental filing, the panel may issue further instructions to the parties, including a rebuttal/reply opportunity to the non-initiating party.

[See also section 4.7.]

### Relevant decisions

*Delikommat Betriebsverpflegung Gesellschaft m.b.H. v. Alexander Lehner*,  
WIPO Case No. **D2001-1447**, <delikommat.com>, Transfer

*AutoNation Holding Corp. v. Rabea Alawneh*,  
WIPO Case No. **D2002-0058**, <autoway.com>, Denied

*De Dietrich Process Systems v. Kemtron Ireland Ltd.*,  
WIPO Case No. **D2003-0484**, <dedietrich-process-systems.com>, Transfer

*Auto-C, LLC v. MustNeed.com*,  
WIPO Case No. **D2004-0025**, <autochlor.com>, Transfer

*Wal-Mart Stores, Inc. v. Larus H. List*,  
WIPO Case No. **D2008-0193**, <wa1mart.com>, Transfer

*NB Trademarks, Inc. v. Domain Privacy LTD and Abadaba S.A.*,  
WIPO Case No. **D2008-1984**, <aliensport.com>, Transfer

*Mejeriforeningen Danish Dairy Board v. Cykon Technology Limited*,  
WIPO Case No. **D2010-0776**, <lurpa.com>, Transfer

*Softronic AB v. Privacy Protect / Frank Lancaster / Isaac Goldstein*,  
WIPO Case No. **D2013-0637**, <softronic.com>, Transfer

*X for convening and Managing Athletic Events v. Registration Private, Domains By Proxy, LLC, DomainsByProxy.com/Ebrahim Alsaïdi*,  
WIPO Case No. **D2016-0013**, <desertforce.com>, Denied

*Green Bay Packers v. Moniker etc*,  
WIPO Case No. **D2016-1455**, <totalpackers.com>, Denied

*Nancy L. Lanard, Lanard and Associates, P.C. v. Whols Agent, Whols Privacy Protection Service, Inc. / Josh Lignana, Spadea Lignana LLC*,  
WIPO Case No. **D2016-1706**, <lanardlaw.com>, Denied

*Sarten Ambalaj San. ve Tic. A.Ş. v. Stanley Pace*,  
WIPO Case No. **D2015-1790**, <sarten.com>, Denied

*Starwood Hotels & Resorts Worldwide, Inc., The Sheraton LLC, Sheraton International IP, LLC, Preferred Guest, Inc., Société des Hôtels Méridien, Worldwide Franchise Systems, Inc., Westin Hotel Management, L.P. v. Lei Qi*,  
WIPO Case No. **D2015-1539**, <aloft.pub> et al., Transfer

*Pro Natura Gesellschaft für Gesunde Ernährung mbH v. Mike Pollard*,  
WIPO Case No. **D2016-2531**, <fructaid.com> et al., Denied

*Fashion Design Council of India v. Ashish Pawaskar, Internet Wizards*,  
WIPO Case No. **D2015-2296**, <indiafashionweek.com>, Transfer

*Welcomemat Services, Inc. v. Michael Plummer Jr., MLP Enterprises Inc.*,  
WIPO Case No. **D2017-0481**, <welcomemat.com> and <welcomematfranchise.com>, Transfer

#### 4.7 Under what circumstances would a UDRP panel issue a Procedural Order?

As noted above in respect of supplemental filings, paragraph 12 of the UDRP Rules makes clear that it is for the panel to request, in its sole discretion, any further statements or documents from the parties that it deems necessary.

Paragraph 10 of the UDRP Rules similarly vests the panel with the authority to determine the admissibility, relevance, materiality and weight of the evidence, and also to conduct the proceedings with due expedition.

While relatively infrequent, where a panel believes it would benefit from additional information or arguments from the parties concerning contentions made in the pleadings or otherwise, it may issue a procedural order to the parties requesting such information or arguments.

Merely by way of example, scenarios in which a panel has issued a procedural order include (i) where a party makes a prima facie credible assertion the confirmation of which would benefit from additional supporting evidence (and irrespective of whether such assertion is disputed by the other party), (ii) where a party has failed to address a relevant claim made by the opposing party, (iii) where fairness calls for an opportunity for a party to respond to certain (unforeseeable) allegations or submissions by the other party.

##### Relevant decisions

*Lazzoni Mobilya Ins.Tur. San.Ve Tlc.Ltd. Şti. v. Privacy--Protect.org / Marco Gaetano Lazzoni*,  
WIPO Case No. [D2012-0240](#), <lazzoni.com>, Transfer

*Joan Collins v. Stephen Gregory*,  
WIPO Case No. [D2013-0290](#), <joancollins.com>, Denied

*Omnia Italian Design, Inc. v. Andrew Greatrex*,  
WIPO Case No. [D2013-0392](#), <omnialeatherfurniture.com>, Denied

*5 PRE VIE W AB v. Diego Manfreda*,  
WIPO Case No. [D2013-1946](#), <5preview.com>, Denied

*HUGO BOSS Trade Mark Management GmbH & Co. KG, HUGO BOSS AG v. I Market and Design LLC*,  
WIPO Case No. [D2014-2064](#), <boss.black>, Transfer

*Kabbage, Inc. v. Robert Hanssen, Ridiculous File Sharing, et al.*,  
WIPO Case No. [D2015-0842](#), <kabbageinc.com>, Transfer

*MAGIX Software GmbH v. The Music Connection*,  
WIPO Case No. [D2015-1216](#), <musicmaker.com>, Denied

*Heraeus Kulzer GmbH v. Whois Privacy Services Pty Ltd / Stanley Pace*,  
WIPO Case No. [D2016-0245](#), <kulzer.com>, Transfer

*Singapore Pools (Private) Limited v. Vietnam Domain Privacy Services / To Thi Thanh Tam*,  
WIPO Case No. [D2016-0292](#), <sgpools.com>, Transfer

*Filinvest Land, Inc. v. Filinvest.com, Inc.*,  
WIPO Case No. [D2016-0668](#), <filinvest.com>, Transfer

*ROAR, LLC v. Jonathan Shalit, ROAR Global Limited*,  
WIPO Case No. [D2016-1574](#), Denied

*Bigfoot Ventures LLC v. Shaun Driessen*,  
WIPO Case No. [D2016-1330](#), <bubblingbeats.com>, Denied

*Wipro Enterprises Private Limited ("WIPRO") v. Domain Privacy Service fbo Registrant / Ankur Aggarwal, Piron*,  
WIPO Case No. [D2017-0181](#), <wiprofurniture.com>, Transfer

#### 4.8 May a panel perform independent research in assessing the case merits?

Noting in particular the general powers of a panel articulated inter alia in paragraphs 10 and 12 of the UDRP Rules, it has been accepted that a panel may undertake limited factual research into matters of public record if it would consider such information useful to assessing the case merits and reaching a decision.

This may include visiting the website linked to the disputed domain name in order to obtain more information about the respondent or its use of the domain name, consulting historical resources such as the Internet Archive ([www.archive.org](http://www.archive.org)) in order to obtain an indication of how a domain name may have been used in the relevant past, reviewing dictionaries or encyclopedias (e.g., Wikipedia), or accessing trademark registration databases.

In some circumstances, a panel may also rely on personal knowledge (e.g., to take “judicial notice” of the reputation of a well-known mark, or a corporate affiliation/structure).

Where a panel intends to rely on information outside the pleadings, in certain limited scenarios, e.g., where such information may not be general public knowledge or at least readily accessible, it may consider issuing a procedural order to give the parties an opportunity to comment on such information as it relates to the proceedings.

[See generally section 4.2.]

##### Relevant decisions

*Société des Produits Nestlé SA v. Telmex Management Services*,  
WIPO Case No. **D2002-0070**, <nestlefoods.com>, Transfer

*Hesco Bastion Limited v. The Trading Force Limited*,  
WIPO Case No. **D2002-1038**, <hescobastion.com>, Transfer

*Howard Jarvis Taxpayers Association v. Paul McCauley*,  
WIPO Case No. **D2004-0014**, <hjta.com>, Denied

*National Football League v. Thomas Trainer*,  
WIPO Case No. **D2006-1440**, <nflnetwork.com>, Transfer

*La Francaise des Jeux v. Domain Drop S.A.*,  
WIPO Case No. **D2007-1157**, <coteetmatch.com>, Transfer

*Descente, Ltd. and Arena Distribution, S.A. v. Portsportals Enterprises Limited.*,  
WIPO Case No. **D2008-1768**, <arena.com>, Denied

*Latchways PLC v. Martin Peoples*,  
WIPO Case No. **D2010-1255**, <mansafe.com>, Transfer

*Sensis Pty Ltd., Telstra Corporation Limited v. Yellow Page Marketing B.V.*,  
WIPO Case No. **D2011-0057**, <yellowpage-adelaide.com> et al., Transfer

*Imagine Solutions, Inc. v. Encapture.com, Privacy Services / Ravindra Kumar Lahoti*,  
WIPO Case No. **D2013-0268**, <encapture.com>, Transfer

*Red Diamond Holding Sàrl v. Guava Softs Pvt Ltd*,  
WIPO Case No. **D2013-0537**, <leecooper.biz>, Transfer

*MAGIX Software GmbH v. The Music Connection*,  
WIPO Case No. **D2015-1216**, <musicmaker.com>, Denied

*FANUC Corporation, FANUC UK Limited v. Whois Agent Your Jungle Privacy Protection Service / John Ginley / Neil Ginley; Pennine Automation Spares*,  
WIPO Case No. **D2015-1387**, <fanuc-repairs.repair> et al., Transfer

*The Coca-Cola Company v. Whois Privacy Protection Service, Inc. / Thien Le Trieu, Le Trieu Thien*, WIPO Case No. **D2015-2078**, <xomtu.com>, Transfer

*Wild PCS, Inc. and Tom Yang v. Perfect Privacy, LLC / Choi Lam*,  
WIPO Case No. [D2016-0017](#), <wildpcs.com>, Transfer

*Singapore Pools (Private) Limited v. Vietnam Domain Privacy Services / To Thi Thanh Tam*,  
WIPO Case No. [D2016-0292](#), <sgpools.com>, Transfer

*Mark Overbye v. Maurice Blank, Gekko.com B.V.*,  
WIPO Case No. [D2016-0362](#), <gekko.com>, Denied

*Humble Bundle, Inc. v. Domain Admin, Whois Privacy Corp.*,  
WIPO Case No. [D2016-0914](#), <humble-bundle.net>, Transfer

*IDR Solutions Ltd. v. Whois Privacy Corp*,  
WIPO Case No. [D2016-2156](#), <jpedal.org>, Transfer

#### 4.9 Can UDRP proceedings be suspended for purposes of settlement?

Paragraph 17 of the UDRP Rules makes clear that a proceeding may be suspended to facilitate settlement negotiations, or to implement a settlement agreement between the parties.

**Prior to panel appointment:** where, before appointment of the administrative panel, the complainant (or both parties jointly) submits a suspension request to the WIPO Center, the proceedings will be suspended to allow the parties to explore settlement options.

Given the expedited nature of UDRP proceedings such suspensions are typically for 30 days, with an additional 30 days normally available on request where necessary to give effect to the parties' settlement effort. When notifying the parties of the suspension, the WIPO Center will provide the parties with a **Standard Settlement Form** merely to facilitate the implementation of any agreed transfer (and not to record any settlement particulars).

If the parties agree to settle their dispute, they should return the completed **Standard Settlement Form** to the WIPO Center.

Upon receipt of the completed **Standard Settlement Form**, the WIPO Center will direct the registrar to "unlock" the disputed domain name, ordinarily to allow it to be transferred to the complainant's control (or canceled).

Once the complainant confirms implementation of the settlement agreement (ordinarily that it has control of the disputed domain name), the WIPO Center will dismiss the proceedings and refund the panel portion of the complainant's **filing fee**. NB, other UDRP providers may not issue such a refund.

**Following panel appointment:** a request from the parties to suspend the proceedings to explore settlement options after panel appointment is subject to the discretion of the panel. In the event of a settlement, the panel would normally terminate the proceedings in accordance with paragraph 17 of the UDRP Rules. In such a post-panel-appointment scenario however, no fee refund would be available.

##### Relevant decisions

*AT&T Corp. v. Ondonk Partners*,  
WIPO Case No. [D2000-1723](#), <attplaza.com>, Transfer

*Mori Seiki Co. Ltd. v. Texas International Property Associates*,  
WIPO Case No. [D2007-1795](#), <mori-seiki.com> et al., Transfer

*MasterCard International v. Bankrate*,  
WIPO Case No. [D2008-0704](#), <mastercreditcard.com>, Transfer

*F. Hoffmann-La Roche AG v. Texas International Property Associates – NA NA*,  
WIPO Case No. [D2008-0752](#), <hoffman-laroche.com>, Transfer

*ANOVO v. Moniker Privacy Services / Alexander Lerman*,  
WIPO Case No. [D2008-1049](#), <anovo.com>, Transfer

*Grundfos A/S v. Luca Mueller*,  
WIPO Case No. [D2009-0091](#), <grundfosinsite.com>, Transfer

*F. Hoffmann-La Roche AG v. P Martin*,  
WIPO Case No. [D2009-0323](#), <alli-xenical.com>, Transfer

*Banco Bradesco S/A v. Belcanto Investment Group*,  
WIPO Case No. [D2013-1279](#), <bradescofinaciamento.com>, Transfer

*LRC Products Limited v. Domain Admin, Privacy Protection INC d/b/a PrivacyProtect.org / Tamerlan*, WIPO Case No. [D2014-0254](#), <durex.info>, Transfer

*Statoil ASA v. gaelle etienne / WhoisGuard Protected*,  
WIPO Case No. [D2015-1812](#), <statoil.space>, Transfer

*General Electric Company v. Islam Gamal and Begad Negad, YourServ.CoM*,  
WIPO Case No. [D2016-0553](#), <geegypt.com> et al., Transfer

*Ladurée International SA v. Andrew White*,  
WIPO Case No. [D2016-1054](#), <ladureeaustralia.com> et al., Transfer

*Société du Figaro v. Guolong Wang*,  
WIPO Case No. [D2016-2107](#), <figaro.live> and <madamefigaro.online>, Transfer

#### **4.10 How do panels handle cases involving a respondent’s informal or unilateral consent for the transfer of the domain name to the complainant outside the “standard settlement process” described above?**

Where parties to a UDRP proceeding have not been able to settle their dispute prior to the issuance of a panel decision using the “standard settlement process” described above, but where the respondent has nevertheless given its consent on the record to the transfer (or cancellation) remedy sought by the complainant, many panels will order the requested remedy solely on the basis of such consent. In such cases, the panel gives effect to an understood party agreement as to the disposition of their case (whether by virtue of deemed admission, or on a no-fault basis).

In some cases, despite such respondent consent, a panel may in its discretion still find it appropriate to proceed to a substantive decision on the merits. Scenarios in which a panel may find it appropriate to do so include (i) where the panel finds a broader interest in recording a substantive decision on the merits – notably recalling UDRP paragraph 4(b)(ii) discussing a pattern of bad faith conduct, (ii) where while consenting to the requested remedy the respondent has expressly disclaimed any bad faith, (iii) where the complainant has not agreed to accept such consent and has expressed a preference for a recorded decision, (iv) where there is ambiguity as to the scope of the respondent’s consent, or (v) where the panel wishes to be certain that the complainant has shown that it possesses relevant trademark rights.

##### **Relevant decisions**

*Sassybax, L.L.C. v. Texas International Property Associates*,  
WIPO Case No. [D2007-1190](#), <sassybac.com>, Transfer

*Brownells, Inc. v. Texas International Property Associates*,  
WIPO Case No. [D2007-1211](#), <brwonells.com>, Transfer

*Ticketmaster Corporation v. Global Access*,  
WIPO Case No. [D2007-1921](#), <ticketmast.com>, Transfer

*Infonxx.Inc v. Lou Kerner, WildSites.com*,  
WIPO Case No. [D2008-0434](#), <inonxxx.com>, Transfer

*President and Fellows of Harvard College v. Texas International Property Associates – NA NA*, WIPO Case No. [D2008-0597](#), <harvarduniversitypress.com>, Transfer

*John Bowers QC v. Tom Keogan*,  
WIPO Case No. [D2008-1720](#), <johnbowersqc.com>, Transfer

*Malley's Candies Inc. v. Texas International Property Associates – NA NA*,  
WIPO Case No. [D2008-1803](#), <malleychocolates.com> et al., Transfer

*Research In Motion Limited v. Privacy Locked LLC/Nat Collicot*,  
WIPO Case No. [D2009-0320](#), <backberry.com>, Transfer

*A.S. Roma S.p.A. v. Whois Privacy Services Pty Ltd / Vertical Axis Inc., Domain Administrator*,  
WIPO Case No. [D2011-2054](#), <asroma.com>, Transfer

*Rockwool International A/S v. Lin Chengxiong*,  
WIPO Case No. [D2012-0472](#), <rockwool.net>, Transfer

*Arnold Clark Automobiles Limited v. DOMAIN MAY BE FOR SALE, CHECK AFTERNIC.COM Domain Admin, Domain Registries Foundation*,  
WIPO Case No. [D2016-2035](#), <arnoldclarkpreview.com>, Transfer

*Jet2.com Limited v. Contact Privacy Inc. Customer 0130301837 / Jonathan Whittle*,  
WIPO Case No. [D2016-0812](#), <jet2holidayvillas.com> and <jet2villas.com>, Transfer

*Société du Figaro v. Guolong Wang*,  
WIPO Case No. [D2016-2107](#), <figaro.live> and <madamefigaro.online>, Transfer

*Leica Microsystems IR GmbH v. Tong Chuang*,  
WIPO Case No. [D2016-2316](#), <leica.store>, Transfer

*Patriot Supply Store, Inc., d/b/a My Patriot Supply v. Domain May be for Sale, Check Afternic.Com Domain Admin, Domain Registries Foundation*,  
WIPO Case No. [D2016-1573](#), <mypatriotssuppl.com>, Transfer

*Pierre Balmain S.A. v. Domains By Proxy, LLC / Daniel Phillips*,  
WIPO Case No. [D2015-0189](#), <balmainarmy.com>, Transfer

#### **4.11 How do panels address consolidation scenarios?**

The WIPO Center may accept, on a preliminary basis, a consolidated complaint where the criteria described below are prima facie met. Any final determination on consolidation would be made by the appointed panel, which may apply its discretion in certain circumstances to order the separation of a filed complaint. In all cases, the burden falls to the party seeking consolidation to provide evidence in support of its request.

##### **4.11.1 Multiple complainants filing against a single respondent**

Paragraph 10(e) of the UDRP Rules grants a panel the power to consolidate multiple domain name disputes. At the same time, paragraph 3(c) of the UDRP Rules provides that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain-name holder.

In assessing whether a complaint filed by multiple complainants may be brought against a single respondent, panels look at whether (i) the complainants have a specific common grievance against the respondent, or the respondent has engaged in common conduct that has affected the complainants in a similar fashion, and (ii) it would be equitable and procedurally efficient to permit the consolidation.

[See also section [1.4](#).]

#### 4.11.2 Complaint consolidated against multiple respondents

Where a complaint is filed against multiple respondents, panels look at whether (i) the domain names or corresponding websites are subject to common control, and (ii) the consolidation would be fair and equitable to all parties. Procedural efficiency would also underpin panel consideration of such a consolidation scenario.

Panels have considered a range of factors, typically present in some combination, as useful to determining whether such consolidation is appropriate, such as similarities in or relevant aspects of (i) the registrants' identity(ies) including pseudonyms, (ii) the registrants' contact information including email address(es), postal address(es), or phone number(s), including any pattern of irregularities, (iii) relevant IP addresses, name servers, or webhost(s), (iv) the content or layout of websites corresponding to the disputed domain names, (v) the nature of the marks at issue (e.g., where a registrant targets a specific sector), (vi) any naming patterns in the disputed domain names (e.g., <mark-country> or <mark-goods>), (vii) the relevant language/scripts of the disputed domain names particularly where they are the same as the mark(s) at issue, (viii) any changes by the respondent relating to any of the above items following communications regarding the disputed domain name(s), (ix) any evidence of respondent affiliation with respect to the ability to control the disputed domain name(s), (x) any (prior) pattern of similar respondent behavior, or (xi) other arguments made by the complainant and/or disclosures by the respondent(s).

[See also section 4.4.]

#### 4.11.1 Relevant decisions

*NFL Properties, Inc. et al. v. Rusty Rahe*,  
WIPO Case No. [D2000-0128](#), <arizonacardinals.com> et al., Transfer

*Fulham Football Club (1987) Limited, et.al v. Domains by Proxy, Inc./ Official Tickets Ltd*,  
WIPO Case No. [D2009-0331](#), <official-fulham-tickets.com> et al., Transfer

*MLB Advanced Media, The Phillies, Padres LP v. OreNet Inc.*,  
WIPO Case No. [D2009-0985](#), <padresbaseball.com> et al., Transfer

*Inter-Continental Hotels Corporation, Six Continents Hotels, Inc. v. Daniel Kirchhof*,  
WIPO Case No. [D2009-1661](#), <amstel-intercontinental.com> et al., Transfer in Part, Denied in Part

*Jacqueline Riu and Société Riu Aublet et Compagnie v. Olivia Marimelado*,  
WIPO Case No. [D2010-0170](#), <jacquelinერიu.com>, Transfer

*London Court of International Arbitration (LCIA), International Chamber of Commerce (ICC), Singapore International Arbitration Centre (SIAC), Arbitration Institute of the Stockholm Chamber of Commerce (SCC), American Arbitration Association/International Center for Dispute Resolution (AAA/ICDR) v. ICSID Lawyers, LLC*,  
WIPO Case No. [D2013-0685](#), <aaaarbitrations.com> et al., Transfer in Part, Denied in Part

*Statoil ASA and Statoil Fuel & Retail Aviation AS v. NA - Claudio Russo*,  
WIPO Case No. [D2013-0963](#), <statoilaviation.net>, Transfer

*Vectra Bank Colorado, Zions First National Bank and Amegy Bank National Association v. Fluder*, WIPO Case No. [D2015-2046](#), <amegybank.online> et al., Transfer

*Halle Berry and Bellah Brands Incorporated v. Alberta Hot Rods*,  
WIPO Case No. [D2016-0256](#), <halleberry.com>, Transfer

*N. M. Rothschild & Sons Limited and Banque Martin Maurel v. Xiamen PrivacyProtection Service Co. Ltd. / Yang hongjuan*,  
WIPO Case No. [D2016-2508](#), <rothschildmartinmaurel.com>, Transfer

#### 4.11.2 Relevant decisions

*Speedo Holdings B.V. v. Programmer, Miss Kathy Beckerson, John Smitt, Matthew Simmons*,  
WIPO Case No. [D2010-0281](#), <aussiespeedoguy.com> et al., Transfer

*Apple, Inc. v. Whols Privacy Services Pty Ltd. / Stanley Pace / Shahamat / Kent Mansley / Phoebe Aoe / Tammy Caffey / Staci Michele / Layne Fletcher / Hiroko Tadano / Keith Besterson / Andrew Devon,*

WIPO Case No. **D2013-1312**, <appeloffre.com> et al., Transfer in Part, Dismissed in Part

*Apple Inc. v. Stanley Pace (a.k.a. Jordan Smith, Chris Carter, sunhei.org, Keith Besterson, Shahamat, Staci Michele and Courtney Culbertson) and Fundacion Private Whois,*

WIPO Case No. **D2013-1313**, <apole.com> et al., Transfer

*Valeant Pharmaceuticals International, Inc. / iNova Pharmaceuticals (Australia) Pty Limited v. Luca Radu / Fundacion Private Whois / Maxim Conovalov / Vasju Pere,*

WIPO Case No. **D2013-1918**, <duromineau.com> et al., Transfer in Part, Denied in Part

*VICINI S.P.A. v. runs yao / delao dkeo,*

WIPO Case No. **D2014-1000**, <giuseppezanottoutlet.com> et al., Transfer, Dismissed in Part

*Wikimedia Foundation, Inc. v. Domain Administrator, Whois Privacy Services Pty Ltd / Yeongju Hong and Mike Kerry, Dzone Inc.,*

WIPO Case No. **D2015-1148**, <wikipedia.com> et al., Transfer in Part, Terminated in Part

*Yahoo! Inc. v. Aman Anand, Ravi Singh, Sunil Singh, Whois Privacy Corp., Domains By Proxy, LLC,* WIPO Case No. **D2016-0461**, <helplineyahoo.com> et al., Transfer

*F. Hoffmann-La Roche AG v. Binero AB, Netfirms AB / Igor Ivanov, Binero AB, Netfirms AB / Tigran Mosisyan, Private Person, Kseniya S Dzhabbarova, Kseniya Dzhabbarova, Wuxi Yilian LLC / Alexis Uvarovis, Flee Ventures 4, Vladimir Kiskov, Konayem Temirtassova, Kravtsov Alexander, Alexander Kravtsov, Domain Admin, Privacy Protection Service INC d/b/a PrivacyProtect.org / Danilo Krasko,* WIPO Case No. **D2016-0517**, <accutane-online.nu> et al., Cancellation, Transfer in Part

*Mou Limited v. Zeng Xiang / Debra Nelis / Privacy Protection Service Inc. d/b/a*

*PrivacyProtect.org,* WIPO Case No. **D2016-0759**, <mouboots-sale.com> et al., Transfer in Part, Dismissed in Part

*Ecom Holdings Pty Ltd v. Innovation Consulting LTD / Veelin Admin, Veelin International Inc / WhoisGuard Protected, WhoisGuard, Inc.,* WIPO Case No. **D2016-1583**, <brazilcupid.date> et al., Transfer

*Lancôme Parfums Beauté et compagnie and L'Oréal v. Din Mont and Yunleng Mercyk,* WIPO Case No. **D2016-1721**, <kiehlscn.com> and <lancame.com>, Transfer

*BMW v. Mike Lee et al.,*

WIPO Case No. **D2016-2268**, <bmw-icom.com> et al., Transfer

*Virgin Enterprises Limited v. LINYANXIAO aka lin yanxiao,*

WIPO Case No. **D2016-2302**, <virginemdia.com> et al., Transfer

#### **4.12 Under what circumstances may additional domain names be added to a filed complaint/ongoing proceeding?**

Whether a request to add domain names to a filed complaint will be accepted may depend on whether the request is received prior, or subsequent to, complaint notification.

As the WIPO Center's UDRP fees apply on a staggered sliding scale, the addition of domain names may necessitate the payment of additional fees.

##### **4.12.1 Addition of domain names prior to complaint notification**

As a general rule, domain names held by the same registrant(s) may be added to a complaint before notification to the respondent(s)/formal commencement of the relevant proceeding.

Particularly where the Whols-listed registrant is a privacy or proxy service, on receipt of confirmation of the underlying registrant identity from the registrar relayed by the WIPO Center to the complainant, a complainant may wish to add other relevant domain names held by the same registrant to its complaint.

In the event proposed additional domain names involve marks not invoked in the original complaint, the complainant would be required to show relevant trademark rights corresponding to the new domain names. At the same time, the second and third UDRP elements may be updated where appropriate or applicable.

[See also sections 4.4 and 4.11.]

#### 4.12.2 Addition of domain names following complaint notification

Requests for addition of domain names to a complaint after it has been notified to the respondent and the proceedings have formally commenced would be addressed by the panel on appointment.

Except in limited cases where there is clear evidence of respondent gaming/attempts to frustrate the proceedings (e.g., by the respondent's registration of additional domain names subsequent to complaint notification), panels are generally reluctant to accept such requests because the addition of further domain names would delay the proceedings (which are expected to take place with due expedition). Moreover, a panel declining such request would not prevent the filing of a separate complaint where such additional domain names may be addressed.

In those cases where panels would grant such a request, the complainant would need to hold relevant trademark rights and the proposed additional domain names would need to be prima facie registered by the same or related respondent. Moreover, in the event a panel would grant such a request, it may also order partial or full re-notification of the proceeding (which may impact case timelines).

#### 4.12.1 Relevant decisions

*Société Air France v. Spiral Matrix,*

WIPO Case No. [D2005-1337](#), <airfrancereservation.com> et al., Transfer

*Department of Management Services, State of Florida v. Digi Real Estate Foundation,*

WIPO Case No. [D2007-0547](#), <myflorida.com>, Transfer

*Société Air France v. Kristin Hirsch, Hirsch Company,*

WIPO Case No. [D2008-1213](#), <airfrancesite.info>, Transfer

*F. Hoffmann-La Roche AG v. Konayem Temirtassova, Tigran Movsisyan, Aleksandr Bannikov,*

*Valentin Barshev, Oleg Sobin, Igor Ivanov, Sergey Timofeev, Igor Ivanov, N/A, Vladimir D*

*Kiskov, Private Person, Irina F Scherban, Private Person, Aleksandr V Sivkov, Private Person,*

*Igor Ivanov, [RU]70983550, Albert Sadykov, [RU]722410292, Tigran Mosisyan, [AM]0720347,*

*Vladimir Kiskov, [RU]4607604244, Anastasiya Yankova, [RU]4606291090, Konstantin*

*Tkachev, [RU]4507343219, Kristina Melnichenko, [RU]712403282, Igor A Ivanov, Private*

*Person, Zhuhai Yingxun Keji Limited aka Zhuhai Yingxun information technology limited,*

WIPO Case No. [D2015-0984](#), <buy-accutane.nu> et al., Transfer

*Churchill Downs Incorporated v. Leonard Manley, Jalapeno Ventures / Domain Privacy Group (aka Domain Privacy Service FBO Registrant),*

WIPO Case No. [D2015-1777](#), <kentuckyderbybetting.info> et al., Transfer

*Advance Magazine Publishers Inc. v. Perfect Privacy, LLC / Vogue UK / Above.com Domain Privacy / LD Arnott + FMS Smith*,  
 WIPO Case No. **D2016-0341**, <vogueclubuk.com> and <vogueclub.com>, Transfer  
*Tinder, Incorporated v. Super Privacy Service c/o Dynadot / WhoisGuard Protected, WhoisGuard, Inc. / Jennifer Lopez, SI Marketing LLC / David Miller*,  
 WIPO Case No. **D2016-1610**, <tinder-background.com> et al., Transfer  
*Mou Limited v. Privacy Protection Service INC d/b/a PrivacyProtect.org / Jason Cheyney / Jonathon / P de Ree*, WIPO Case No. **D2016-2071**, <botas-mou.com> et al., Transfer  
*HUGO BOSS Trade Mark Management GmbH & Co. KG and HUGO BOSS AG v. Ludwig Rhys*, WIPO Case No. **D2016-2448**, <cheaphugobossonline.com> and <hugobosssalecheaponline.com>, Transfer

#### 4.12.2 Relevant decisions

*T.R.B. International S.A. v. Kale Roben*,  
 WIPO Case No. **D2011-1307**, <vilebrequinsale.com> et al. Transfer  
*Confédération nationale du Crédit Mutuel v. iPage*,  
 WIPO Case No. **D2013-1574**, <banquecreditmutuel.com> et al., Transfer  
*Thule Sweden AB v. Cameron David Jackson*,  
 WIPO Case No. **D2016-0414**, <thulegroup.club> et al., Transfer  
*Graff Diamonds Limited v. Fariborz Saba*,  
 WIPO Case No. **D2016-1143**, <graff-perfume.com> and <graff-perfume.net>, Transfer  
*ZB, N.A., dba Zions First National Bank and ZB, N.A., dba Amegy Bank v. Cameron David Jackson*, WIPO Case No. **D2016-1452**, <amegybanknationalassociation.xyz>, Transfer  
*MBC FZ-LLC v. Hassan Latif, MBC Business Center*,  
 WIPO Case No. **D2016-1934**, <mbcbusinesscenter.com> et al., Transfer  
*De Beers Intangibles Limited v. Romano Mudano*,  
 WIPO Case No. **D2017-0323**, <adiamondisforever.cloud> and <adiamondisforever.store>, Transfer

#### 4.13 How do panels address domain names involving the mark of a third party trademark owner not joined in the complaint?

As described in [section 1.12](#) concerning the first UDRP element, the presence, in a particular disputed domain name, of the mark of a third party not joined in a particular proceeding (e.g., <**complainantmark+thirdparty**mark>) would not by itself prevent a finding of confusing similarity.

While the presence of a third party mark in a domain name would not prevent a panel from rendering a decision on the merits, a number of panels have found it appropriate to issue any transfer order without prejudice to the concerned third party's rights.

Where a panel may have concerns that the rights of the third party mark owner would potentially be unduly impacted by a transfer order, some panels have issued a Procedural Order to seek some reasonable assurance of the third party's non-objection. In certain highly exceptional circumstances (e.g., where even through a Procedural Order via the complainant the third party is unreachable), a panel may order cancellation of the disputed domain name as opposed to a requested transfer.

#### Relevant decisions

*WhatsApp Inc. v. Private Whois whatsappandroid.com, Private Whois whatsappipad.com and Private Whois whatsappiphone.com,*

WIPO Case No. [D2012-0674](#), <whatsappandroid.com> et al., Transfer

*Elmec România S.R.L. v. Georgian Munteanu,*

WIPO Case No. [D2014-0107](#), <collective-ugg-shop.com>, Transfer

*Cummins Inc. v. Dennis Goebel,*

WIPO Case No. [D2015-1064](#), <fordcummins.com>, Transfer

*Kabbage, Inc. v. Oneandone Private Registration, 1&1 Internet Inc. - www.1and1.com / Robert Hanssen, Ridiculous File Sharingm,* WIPO Case No. [D2015-1507](#), <kabbagefund.com> et al., Transfer

*Philip Morris USA Inc. v. Whoisguard Protected, Whoisguard, Inc. / MARK JAYSON DAVID,*

WIPO Case No. [D2016-2194](#), <pallmall-marlboro.com>, Transfer

*Aldi GmbH & Co. KG, Aldi Stores Limited v. Ronan Barrett,*

WIPO Case No. [D2016-2219](#), <aldiorlidl.com> and <lidloraldi.com>, Transfer

#### **4.14 What is the relationship between the UDRP and court proceedings?**

By design, the UDRP system preserves parties' court options before, during, and after a UDRP proceeding; as indicated by UDRP paragraph 4(k), the UDRP does not bar either party from seeking judicial recourse.

Paragraph 18(a) of the UDRP Rules gives the panel discretion to suspend, terminate, or continue a UDRP proceeding where the disputed domain name is also the subject of other pending legal proceedings.

##### **4.14.1 Suspension**

Appointed panels are reluctant to suspend a UDRP case due to concurrent court proceedings, most notably because of the potential for indeterminate delay; the WIPO Center would similarly be reluctant to facilitate such suspension.

##### **4.14.2 UDRP decision**

Panels generally issue a UDRP decision on the merits even in an overlapping court-UDRP proceeding scenario where, notwithstanding the fact that a UDRP decision would not be binding on the court, the relative expediency of the UDRP versus courts is seen as a benefit to the parties. Panel reluctance to terminate a UDRP case on this basis often also takes account of, and respects, the potential for a court action to address causes of action separate from that being addressed in the UDRP proceeding.

Where there are prior or pending court or administrative (e.g., trademark office) proceedings, it is within the panel's discretion to determine the relevance to ascribe to such proceeding in the UDRP context, in light of the case circumstances. [See generally section [4.21](#).]

##### **4.14.3 Impact of termination due to court proceedings on future UDRP filings**

In the somewhat exceptional event a panel would terminate a UDRP proceeding because of its overlap with a court proceeding, the panel may specifically terminate the UDRP proceeding without prejudice to the filing of a future UDRP complaint pending resolution or discontinuation of the court proceeding. [See also section [4.18](#).]

#### 4.14.4 National court competence

It is widely recognized that national courts are not bound by UDRP panel decisions. Where a domain name which has been the subject of a UDRP panel decision becomes subject to a national court proceeding (whether by a respondent pursuant to UDRP paragraph 4(k), or otherwise), such court case is generally acknowledged to represent a de novo hearing of the case under national law.

#### 4.14.5 Court orders

Noting panel discretion concerning court proceedings, in some cases involving a court order for certain injunctive relief as to the disputed domain name(s), e.g., as in receivership cases, panels would generally render a UDRP decision rather than terminate or suspend the proceedings; implementation of such UDRP decision may be deferred pending the ultimate disposition of such receivership action.

#### 4.14.6 Scope of UDRP as grounds for termination

Depending on the facts and circumstances of a particular case, and irrespective of whether the parties may also be engaged in court litigation, in some instances (e.g., complex business or contractual disputes) panels have tended to deny the case not on the UDRP merits but on the narrow grounds that the dispute between the parties exceeds the relatively limited “cybersquatting” scope of the UDRP, and would be more appropriately addressed by a court of competent jurisdiction.

##### 4.14.1 Relevant decisions

*August Storck KG v. Origan Firmware*,  
WIPO Case No. [D2000-0576](#), <nimm2.com>, Transfer

*Russell Specialties Corporation v. Media Image, Inc., Casual Day.Com, and Rodney Williams*,  
WIPO Case No. [D2002-0322](#), <casualday.com> et al., Transfer in Part, Denied in Part

*Galley, Inc. v. Pride Marketing & Procurement / Richard’s Restaurant Supply, Inc.*,  
WIPO Case No. [D2008-1285](#), <galley.com>, Denied with Dissenting Opinion

*Tiara Hotels & Resorts LLC v. John Pepin*,  
WIPO Case No. [D2009-0041](#), <essque.com>, Transfer

*DNA (Housemarks) Limited v. Tucows.com Co*,  
WIPO Case No. [D2009-0367](#), <dunlop.com>, Terminated

*Collin County Community College District d/b/a Collin College v. Off Campus Books, Howard Hutton*, WIPO Case No. [D2011-0583](#), <collincollegebooks.com>, Transfer

*Yellow Paes Group Co. / Groupe Pages Jaunes Cie. v. Thomas Moll / Yellow Page Marketing B.V.*, WIPO Case No. [D2011-1833](#), <yellowpage-alberta.com> et al., Terminated

##### 4.14.2 Relevant decisions

*August Storck KG v. Origan Firmware*,  
WIPO Case No. [D2000-0576](#), <nimm2.com>, Transfer

*Russell Specialties Corporation v. Media Image, Inc., Casual Day.Com, and Rodney Williams*,  
WIPO Case No. [D2002-0322](#), <casualday.com> et al., Transfer in Part, Denied in Part

*Aussie Car Loans Pty Ltd v. Wilson Accountants Pty Ltd, (formerly Wilson and Wilson Accountants)*, WIPO Case No. [D2008-1477](#), <aussieautoloans.net> et al., Terminated

*DNA (Housemarks) Limited v. Tucows.com Co*,  
WIPO Case No. [D2009-0367](#), <dunlop.com>, Terminated

*BD Real Hoteles, SA de C.V. v. Media Insights aka Media Insight*,  
WIPO Case No. [D2009-0958](#), <cariberealcancun.com> et al., Transfer in Part, Denied in Part  
*Masco Corporation v. Giovanni Laporta*,  
WIPO Case No. [D2015-0468](#), <masco.email>, Transfer  
*Etechaces Marketing and Consulting Private Limited v. Bhargav Chokshi / IR Financial Services Pvt. Ltd.*, WIPO Case No. [D2015-0563](#), <onlinepolicybazaar.com>, Transfer  
*W Nicholson & Co Ltd v. PRIVATE INFORMATION PROTECTION / Southern Grain Spirits NZ Ltd., Matthew Fitzpatrick, Michael Marneros, Nuweb Designs*,  
WIPO Case No. [D2016-1829](#), <jwnicholson.com> and <nicholsongin.com>, Transfer

#### 4.14.3 Relevant decisions

*Yellow Pages Group Co. / Groupe Pages Jaunes Cie. v. Thomas Moll / Yellow Page Marketing B.V.*, WIPO Case No. [D2011-1833](#), <yellowpage-alberta.com> et al., Terminated  
*SDT v. Telepathy*,  
WIPO Case No. [D2014-1870](#), <sdt.com>, Terminated with Dissenting Opinion

#### 4.14.4 Relevant decisions

*Rediff.com India Ltd. v. Contact Privacy Inc. Customer / zhijun shen*,  
WIPO Case No. [DCO2012-0016](#), <rediff.co>, Transfer  
*W Nicholson & Co Ltd v. PRIVATE INFORMATION PROTECTION / Southern Grain Spirits NZ Ltd., Matthew Fitzpatrick, Michael Marneros, Nuweb Designs*,  
WIPO Case No. [D2016-1829](#), <jwnicholson.com> and <nicholsongin.com>, Transfer

#### 4.14.5 Relevant decisions

*Judah Smith v. Whois Privacy Services Pty. Ltd. / URDMC LLC*,  
WIPO Case No. [D2011-0397](#), <judahsmith.com>, Transfer  
*Levi Strauss & Co. v. Domain Hostmaster, Customer ID: 64322845027211 Domain Admin: Damon Nelson – Manager Quantec, LLC / Novo Point, LLC*,  
WIPO Case No. [D2014-1097](#), <dockersoutlet.com>, Transfer  
*Saia, Inc. v. Whois Privacy Services Pty Ltd / Damon Nelson – Manager, Quantec, LLC / Novo Point, LLC*, WIPO Case No. [D2014-1158](#), <saiaonline.com>, Transfer  
*AXA SA v. Damon Nelson, Quantec, LLC / Novo Point LLC*,  
WIPO Case No. [D2015-0286](#), <axaonline.com>, Transfer  
*Yahoo! Inc. v. Whois Agent, Whois Privacy Protection Service, Inc. / Domain Vault, Domain Vault LLC*, WIPO Case No. [D2015-0500](#), <friendsteryahoo.com> and <newyahoomessenger.com>, Transfer  
*Yves Saint Laurent v. Xian Wen (文现)*,  
WIPO Case No. [D2016-2622](#), <yslkings.com>, Transfer

#### 4.14.6 Relevant decisions

*Jason Crouch and Virginia McNeill v. Clement Stein*,  
WIPO Case No. [D2005-1201](#), <allemeryville.net> et al., Dismissed  
*The Thread.com, LLC v. Jeffrey S. Poploff*,  
WIPO Case No. [D2000-1470](#), <thethread.com>, Denied  
*OLX, B.V. v. Abdul Ahad / Domains By Proxy, LLC*,  
WIPO Case No. [D2015-0271](#), <olx.global>, Transfer  
*Masco Corporation v. Giovanni Laporta*,  
WIPO Case No. [D2015-0468](#), <masco.email>, Transfer

*CCTV Outlet, Corp. v. Moises Faroy*,  
WIPO Case No. [D2015-0682](#), <cctvco.com> et al., Transfer, Denied in Part  
*Roger Martin v. Sandra Blevins, Social Design*,  
WIPO Case No. [D2016-0181](#), <strategicchoicearchitecture.com>, Denied

[See also WIPO [Select UDRP-related Court Cases](#).]

#### **4.15 To what extent is national law relevant to panel assessment of the second and third UDRP elements (rights or legitimate interests, and bad faith)?**

UDRP paragraph 15(a) provides that a panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the UDRP, the UDRP Rules, and any rules and principles of law that it deems applicable.

Panels have broadly noted that insofar as the UDRP system is designed to operate in a global context, while rooted in general trademark law principles, in its own terms UDRP jurisprudence generally would not require resort to particular national laws.

In some limited cases such as where the parties share a common nationality and the import of a specific national law concept is particularly germane to an issue in dispute, panels have applied national law principles in assessing the UDRP elements. In such cases, panels have often noted in the applicable UDRP decision the fact that the laws of a particular jurisdiction (possibly that elected by the complainant under UDRP paragraph 4(k)) may well govern any subsequent court case.

Particularly where national trademark office proceedings between the parties have occurred or are pending, panels will normally consider the relevance of such proceedings to assessment of the case merits (e.g., where co-existence principles or limitations to the scope of rights may be present).

[See also sections [1.1.2](#) and [4.14](#).]

##### **Relevant decisions**

*FMR Corp. v. Native American Warrior Society, Lamar Sneed, Lamar Sneed*,  
WIPO Case No. [D2004-0978](#), <fidelitybrokerageinvestmentsfraud.com> et al., Transfer,  
Denied in Part

*Fashiontv.com GmbH v. Mr. Chris Olic*,  
WIPO Case No. [D2005-0994](#), <fashiontv.com>, Denied

*1066 Housing Association Ltd. v. Mr. D. Morgan*,  
WIPO Case No. [D2007-1461](#), <1066ha.com>, Transfer

*Fundación Calvin Ayre Foundation v. Erik Deutsch*,  
WIPO Case No. [D2007-1947](#), <calvinayrefoundation.org>, Transfer

*Sermo, Inc. v. CatalystMD, LLC*,  
WIPO Case No. [D2008-0647](#), <sermosucks.com>, Denied

*St Andrews Links Ltd v. Refresh Design*,  
WIPO Case No. [D2009-0601](#), <theoldcourse.com>, Transfer

*Michael Sweep v. Douglas Berry*,  
WIPO Case No. [D2012-0651](#), <brisbaneglass.com>, Denied

*Green Bay Packers, Inc. v. Moniker Privacy Services / Montgomery McMahon*,  
WIPO Case No. [D2016-1455](#), <totalpackers.com>, Denied

#### 4.16 In what circumstances will panels issue a finding of Reverse Domain Name Hijacking (RDNH)?

Paragraph 15(e) of the UDRP Rules provides that, 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”.

RDNH is furthermore defined under the UDRP Rules as “using the UDRP in bad faith to attempt to deprive a registered domain-name holder of a domain name.” Panels have also referred to paragraphs 3(b)(xiii) and (xiv) of the UDRP Rules in addressing possible RDNH scenarios.

Panels have consistently found that the mere lack of success of a complaint is not itself sufficient for a finding of RDNH. At the same time, the mere fact of a respondent default would not by itself preclude an RDNH finding as this ultimately turns on the complainant’s conduct. In either event, following some early cases to the contrary, panels have more recently clarified that, for an RDNH finding to be made, it is not necessary for a respondent to seek an RDNH finding or prove the presence of conduct constituting RDNH.

Reasons articulated by panels for finding RDNH include: (i) facts which demonstrate that the complainant knew it could not succeed as to any of the required three elements – such as the complainant’s lack of relevant trademark rights, clear knowledge of respondent rights or legitimate interests, or clear knowledge of a lack of respondent bad faith (see generally section 3.8) such as registration of the disputed domain name well before the complainant acquired trademark rights, (ii) facts which demonstrate that the complainant clearly ought to have known it could not succeed under any fair interpretation of facts reasonably available prior to the filing of the complaint, including relevant facts on the website at the disputed domain name or readily available public sources such as the WhoIs database, (iii) unreasonably ignoring established Policy precedent notably as captured in this WIPO Overview – except in limited circumstances which prima facie justify advancing an alternative legal argument, (iv) the provision of false evidence, or otherwise attempting to mislead the panel, (v) the provision of intentionally incomplete material evidence – often clarified by the respondent, (vi) the complainant’s failure to disclose that a case is a UDRP refile, (vii) filing the complaint after an unsuccessful attempt to acquire the disputed domain name from the respondent without a plausible legal basis, (viii) basing a complaint on only the barest of allegations without any supporting evidence.

Given the undertakings in paragraphs 3(b)(xiii) and (xiv) of the UDRP Rules, some panels have held that a represented complainant should be held to a higher standard.

NB, parties may be aware that unlike in the UDRP system, certain national courts may (where invoked) impose monetary penalties (including punitive damages) where the equivalent of RDNH is found.

##### Relevant decisions: RDNH found

*carsales.com.au Limited v. Alton L. Flanders*,  
WIPO Case No. D2004-0047, <carsales.com>, Denied

*Goway Travel Limited v. Tourism Australia*,  
WIPO Case No. D2006-0344, <downunder.travel>, Denied

*Proto Software, Inc. v. Vertical Axis, Inc/PROTO.COM*,  
WIPO Case No. **D2006-0905**, <proto.com>, Denied

*Cheung Kong (Holdings) Limited and Chueng Kong Property Development Limited v. Netego DotCom*, WIPO Case No. **D2009-0540**, <長江.com>, Denied

*M. Coentlin Benoit Thiercelin v. CyberDeal, Inc.*,  
WIPO Case No. **D2010-0941**, <virtualexpo.com>, Denied

*Coöperatie Univé U.A. v. Ashantiplc Ltd / c/o Domain Name Privacy LLC*,  
WIPO Case No. **D2011-0636**, <unive.com>, Denied

*Gold Coast Tourism Corporation Ltd. v. Digimedia.com L.P.*,  
WIPO Case No. **D2013-1733**, <goldcoast.com>, Denied

*Chuan Sin Sdn. Bhd. v. Internet Admin (not for sale), Reflex Publishing Inc.*,  
WIPO Case No. **D2014-0557**, <spritzer.com>, Denied

*Obero Inc. v. Domain Manager, eWeb Development Inc.*,  
WIPO Case No. **D2016-2591**, <obero.com>, Denied

*Patrick Universal Export Pty Ltd. v. David Greenblatt*,  
WIPO Case No. **D2016-0653**, <patrick.com>, Denied

*Intellect Design Arena Limited v. Moniker Privacy Services / David Wieland, iEstates.com, LLC*, WIPO Case No. **D2016-1349**, <unmail.com>, Denied

*GWG Holdings Inc. v. Jeff Burgar, Alberta Hot Rods*  
WIPO Case No. **D2016-1420**, <gwg.com>, Denied

#### **Relevant decisions: RDNH not found**

*Rudy Rojas v. Gary Davis*,  
WIPO Case No. **D2004-1081**, <nativestyles.net> et al., Denied

*Mondial Assistance S.A.S. v. Compana LLC*,  
WIPO Case No. **D2007-0965**, <mondial.com>, Denied

*Grasso's Koninklijke Machinefabrieken N.V., currently acting as Royal GEA Grasso Holding N.V. v. Tucows.com Co*, WIPO Case No. **D2009-0115**, <grasso.com>, Denied

*Compart AG v. Compart.com / Vertical Axis, Inc.*,  
WIPO Case No. **D2009-0462**, <compart.com>, Denied

*Interbasic Holding S.A. v. Francois Carrillo*,  
WIPO Case No. **D2012-0656**, <zut.com>, Denied

*NYLSTAR S.A. v. Domain Administrator, Meryl Blog*,  
WIPO Case No. **D2016-0561**, <meryl.com>, Denied

*Billy Bob's Texas IP Holding LLC v. Domain Administrator, Name Administration Inc. (BVI)*,  
WIPO Case No. **D2016-1221**, <billybobs.com>, Denied

*Bigfoot Ventures LLC v. Shaun Driessen*,  
WIPO Case No. **D2016-1330**, <bubblingbeats.com>, Denied

#### **4.17 Does “delay” in bringing a complaint bar a complainant from filing a case under the UDRP?**

Panels have widely recognized that mere delay between the registration of a domain name and the filing of a complaint neither bars a complainant from filing such case, nor from potentially prevailing on the merits.

Panels have noted that the UDRP remedy is injunctive rather than compensatory, and that a principal concern is to halt ongoing or avoid future abuse/damage, not to provide equitable relief. Panels have furthermore noted that trademark owners cannot reasonably be expected to permanently monitor for every instance of potential trademark abuse, nor to instantaneously

enforce each such instance they may become aware of, particularly when cybersquatters face almost no (financial or practical) barriers to undertaking (multiple) domain name registrations.

Panels have therefore declined to specifically adopt concepts such as laches or its equivalent in UDRP cases.

Panels have however noted that in specific cases, certain delays in filing a UDRP complaint may make it more difficult for a complainant to establish its case on the merits, particularly where the respondent can show detrimental reliance on the delay.

### Relevant decisions

*The Hebrew University of Jerusalem v. Alberta Hot Rods*,  
WIPO Case No. **D2002-0616**, <alberteinstein.com>, Denied

*Tom Cruise v. Network Operations Center / Alberta Hot Rods*,  
WIPO Case No. **D2006-0560**, <tomcruise.com>, Transfer

*Tax Analysts v. eCorp*,  
WIPO Case No. **D2007-0040**, <taxanalyst.com>, Denied

*Francine Drescher v. Stephen Gregory*,  
WIPO Case No. **D2008-1825**, <frandrescher.com>, Transfer

*The Jennifer Lopez Foundation v. Jeremiah Tieman, Jennifer Lopez Net, Jennifer Lopez, Vaca Systems LLC*, WIPO Case No. **D2009-0057**, <jenniferlopez.net> et al., Transfer

*Board of Trustees of the University of Arkansas v. FanMail.com, LLC*,  
WIPO Case No. **D2009-1139**, <razorbacks.com>, Denied

*Mile, Inc. v. Michael Burg*,  
WIPO Case No. **D2010-2011**, <lionsden.com>, Denied

*The Restored Church of God v. Alexa Properties, LLC*,  
WIPO Case No. **D2013-0320**, <rt.org>, Transfer

*Green Bay Packers, Inc. v. Moniker Privacy Services / Montgomery McMahon*,  
WIPO Case No. **D2016-1455**, <totalpackers.com>, Denied

*Billards Toulet v. Damon Nelson - Manager, Quantec LLC/Novo Point, LLC*,  
WIPO Case No. **D2016-2502**, <billards-toulet.com>, Transfer

*NYLSTAR S.A. v. Domain Administrator, Meryl Blog*,  
WIPO Case No. **D2016-0561**, <meryl.com>, Denied

#### 4.18 Under what circumstances would a refiled case be accepted?

A refiled case is one in which a newly-filed UDRP case concerns identical domain name(s) and parties to a previously-decided UDRP case in which the prior panel denied the complaint on the merits. (The previous case may or may not be from another UDRP provider.) As the UDRP itself contains no appeal mechanism, there is no express right to refile a complaint; refiled complaints are exceptional.

Panels have accepted refiled complaints only in highly limited circumstances such as (i) when the complainant establishes that legally relevant developments have occurred since the original UDRP decision, (ii) a breach of natural justice or of due process has objectively occurred, (iii) where serious misconduct in the original case (such as perjured evidence) that influenced the outcome is subsequently identified, (iv) where new material evidence that was reasonably unavailable to the complainant during the original case is presented, or (v) where the case has previously been decided (including termination orders) expressly on a “without prejudice” basis.

In the refiling itself, a complainant must clearly indicate the grounds it believes would justify acceptance of the refiled complaint. The WIPO Center would initially assess whether grounds have been pleaded which prima facie justify accepting the refiled complaint. It remains however for any appointed panel to ultimately determine whether such preliminarily-accepted refiled complaint should proceed to a decision on the merits.

In certain highly limited circumstances (such as where a panel found the evidence in a case to be finely balanced, and opined that it may be possible for future respondent behavior to cast a different light on a panel's assessment of bad faith), a panel may record in its decision that in the event certain conditions would be met, acceptance of a refiled complaint may be justified. The extent to which any such conditions have been met would bear on determining whether a refiled complaint should be accepted prima facie by the provider, and subsequently by the panel.

[See also section 4.16.]

#### Relevant decisions

*Creo Products Inc. v. Website In Development*,  
WIPO Case No. **D2000-1490**, <creoscitex.com>, Transfer

*Maruti Udyog Ltd. v. maruti.com*,  
WIPO Case No. **D2003-0073**, <maruti.com>, Transfer

*AB Svenska Spel v. Andrey Zacharov*,  
WIPO Case No. **D2003-0527**, <svenskaspel.com>, Transfer

*Alpine Entertainment Group, Inc. v. Walter Alvarez*,  
WIPO Case No. **D2007-1082**, <realspanking.com>, Transfer

*Shaw Industries Group Inc. and Columbia Insurance Company v. Rugs of the World Inc.*,  
WIPO Case No. **D2007-1856**, <shawrugsonline.com>, Transfer

*GetMore A/S v. Sooyong Kim*,  
WIPO Case No. **D2009-0357**, <getmore.com>, Denied

*Cheung Kong (Holdings) Limited and Chueng Kong Property Development Limited v. Netego DotCom*, WIPO Case No. **D2009-0540**, <長江.com>, Denied

*Giochi Preziosi S.P.A. v. VGMD NetWeb S.L.*,  
WIPO Case No. **D2009-0542**, <gormiti.mobi>, Denied

*Sensis Pty Ltd., Telstra Corporation Limited v. Yellow Page Marketing B.V.*,  
WIPO Case No. **D2011-0057**, <yellowpage-adelaide.com> et al., Transfer

*Reliance Telecom Limited v. Domains By Proxy, LLC, Sukhraj Randhawa*,  
WIPO Case No. **D2014-0947**, <reliancegroup.com>, Denied

*Steven Samblis v. Domains By Proxy, LLC / Friends Of PNCH*,  
WIPO Case No. **D2016-0579**, <stevensamblis.com> et al., Denied

*GBI Prosperities Pty Ltd., Dr Grow It All Sales Pty Ltd. v. Private Registration / Dave Lovegrove, Real Estate Educational Programmes*,  
WIPO Case No. **D2016-0879**, <doctorgrowitall.com> and <drgrowitall.com>, Denied

#### 4.19 Can a registry or registrar be liable under the UDRP?

When acting solely in its capacity as a registry or registrar, and not also as a registrant, a registry or registrar is not subject to jurisdiction under the UDRP as a respondent.

A registry or registrar would be subject to jurisdiction under the UDRP where it has registered a domain name for itself, and not demonstrably on behalf of a specific third-party registrant

customer. Typically in such cases a registry- or registrar-affiliated entity, as opposed to the registry or registrar itself, is at least listed in the relevant WhoIs as the registrant.

[See also section 4.4.]

### Relevant decisions

*General Electric Company v. Marketing Total S.A.*,  
WIPO Case No. [D2007-1834](#), <generalelectric.com> et al., Transfer

*Pernod Ricard v. Tucows.com Co.*,  
WIPO Case No. [D2008-0789](#), <ricard.com>, Transfer

*DNA (Housemarks) Limited v. Tucows.com Co.*,  
WIPO Case No. [D2009-0367](#), <dunlop.com>, Terminated by Panel

*Key-Systems GmbH v. Joost Zuurbier, OpenTLD B.V.*,  
WIPO Case No. [DME2015-0002](#), <key-systems.cc> and <rrproxy.me>, Transfer

*NetEarth Group, Inc. v. Stichting OpenTLD WHOIS Proxy*,  
WIPO Case No. [D2015-0428](#), <netearthone.biz>, Transfer

*Serverscheck BVBA v. Michael Starr, DCC Corporate*,  
WIPO Case No. [D2016-1958](#), <servercheck.com>, Denied

## 4.20 How does the expiration or deletion of a domain name subject to a UDRP proceeding affect the proceeding?

Where a domain name which is subject to an active UDRP proceeding is scheduled to expire or is deleted during the course of the proceeding, to facilitate continuity and resolution of the dispute, ICANN has incorporated the Expired Domain Deletion Policy (or EDDP) into its Registrar Accreditation Agreement (RAA), applicable to all ICANN-accredited Registrars and all gTLD registrations. The EDDP (RAA paragraph 3.7.5.7) reads as follows:

“In the event that a domain which is the subject of a UDRP dispute is deleted or expires during the course of the dispute, the complainant in the UDRP dispute will have the option to renew or restore the name under the same commercial terms as the registrant. If the complainant renews or restores the name, the name will be placed in Registrar HOLD and Registrar LOCK status, the WHOIS contact information for the registrant will be removed, and the WHOIS entry will indicate that the name is subject to dispute. If the complaint is terminated, or the UDRP dispute finds against the complainant, the name will be deleted within 45 days. The registrant retains the right under the existing redemption grace period provisions to recover the name at any time during the Redemption Grace Period, and retains the right to renew the name before it is deleted.”

Further to the EDDP, where the expiration or deletion of a domain name subject to a UDRP proceeding comes to the WIPO Center’s attention, as a courtesy to all parties the WIPO Center will contact the parties and registrar drawing their attention to the domain name’s status (i.e., that it has expired/been deleted). The registrar is expected to confirm whether any action is required by the parties to renew/restore the disputed domain name so that it may remain under “lock” and the UDRP proceeding may continue. Any renewal/registration fee required for the registrar to maintain the domain name registration status is the responsibility of the parties. If the domain name is not renewed/restored, the case may be deemed withdrawn.

While the WIPO Center will forward any registrar reply to the parties, it is solely the parties' duty to ensure that any actions required to maintain the domain name's active/locked status, including any registrar/registration fee payment, are fulfilled.

Once the relevant domain name registration passes into "pendingDelete" status at the registry level, it may no longer be possible for the parties to renew/restore the domain name registration.

Expiration or deletion prior to complaint filing: The WIPO Center is typically unable to register a complaint if the disputed domain name is *already* expired or deleted before receipt of the UDRP complaint. In some cases however, the domain name status is only known after the complaint is filed and the registrar asked to confirm certain information. This may occur e.g., due to the automatic "renewal" of a domain name by a registrar being presumptively reflected in the Whois (e.g., as a matter of administrative courtesy), or due to a delete request received by the registrar prior to the filing of a UDRP complaint but not yet reflected in the registrar's Whois records.

### Relevant decisions

*Facebook, Inc. v. Domain Asset Holdings,*

WIPO Case No. [D2011-0516](#), <aboutfacebook.com> et al., Transfer

*TKS, S.A. v. Huang Li Technology Corp.,*

WIPO Case No. [D2012-2367](#), <ice-watches.com>, Transfer

*Valero Energy Corporation and Valero Marketing and Supply Company v. John Williams,*

WIPO Case No. [D2015-1039](#), <valeroenergy-corp.com>, Transfer

*Mr. Hans Jakob Limbach v. Matthew V. Millett, Millett International Holdings (HK) Ltd,*

WIPO Case No. [D2015-1297](#), <labor-limbach.com>, Transfer

*Think Schuhwerk GmbH v. Helmut Eder, Modern Tech Limited International,*

WIPO Case No. [D2016-2295](#), <thinkschuhe.net>, Transfer

*Instagram, LLC v. Sedat Das, Arda Arda, Domain Admin, whoisprotection biz, Domain Admin Domain Admin, whoisprotection biz,*

WIPO Case No. [D2016-2382](#), <instagla.com> et al., Transfer

#### 4.21 What is the Center's role, if any, in decision implementation?

The WIPO Center is a neutral dispute resolution provider for UDRP cases. As such, the WIPO Center's role concerns the administration of the procedure and normally ends upon notification of a panel decision to the parties and registrar (or as the case may be, upon termination/settlement).

Absent evidence that the losing respondent has commenced a lawsuit in a complainant-elected "mutual jurisdiction" further to the ICANN Registrar Accreditation Agreement (which incorporates the UDRP as an ICANN consensus Policy), a registrar is expected to implement a UDRP panel's decision.

UDRP paragraph 4(k) provides in relevant part ("you" refers to the respondent, "we"/"our" refers to the registrar):

The mandatory administrative proceeding requirements set forth in [Paragraph 4](#) shall not prevent either [party] from submitting the dispute to a court of competent jurisdiction for independent resolution before such mandatory administrative proceeding is commenced or after such proceeding is concluded. If [the UDRP] Panel decides that

your domain name registration should be canceled or transferred, we will wait ten (10) business days (as observed in the location of our principal office) after we are informed by the applicable Provider of the [UDRP] Panel's decision before implementing that decision. We will then implement the decision unless we have received from you during that ten (10) business day period official documentation (such as a copy of a complaint, file-stamped by the clerk of the court) that you have commenced a lawsuit against the complainant in a jurisdiction to which the complainant has submitted under **Paragraph 3(b)(xiii)** of the [UDRP] Rules. (In general, that jurisdiction is either the location of our principal office or of your address as shown in our Whois database. See **Paragraphs 1 and 3(b)(xiii)** of the [UDRP] Rules for details.) If we receive such documentation within the ten (10) business day period, we will not implement the [UDRP] Panel's decision, and we will take no further action, until we receive (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.

In relevant cases, in order to assist the registrar and parties, the WIPO Center would be able to clarify the mutual jurisdiction which was elected by the complainant in its filed complaint.

NB, in the event a complainant may be experiencing difficulty in the implementation of a panel decision, the matter may be referred to ICANN (e.g., at [compliance@icann.org](mailto:compliance@icann.org)), or by using the ICANN compliance complaint form available at <https://forms.icann.org/en/resources/compliance/complaints/dndr/udrp-form>.

To assist the proper functioning of the UDRP more generally, parties may also raise such implementation matters to the WIPO Center's attention.

[See section **4.14**.]

#### **Relevant decisions**

*DNA (Housemarks) Limited v. Tucows.com Co*,  
WIPO Case No. **D2009-0367**, <dunlop.com>, Terminated

*JBS S.A. and Swift Brands Company v. Domain Admin, C/O ID#10760 Privacy Protection Service INC d/b/a PrivacyProtect.org / Harshad Panchal*,  
WIPO Case No. **D2017-0464**, <jbsfoods.com>, Denied

#### **4.22 What is the relation of the UDRP to the URS?**

The URS is the ICANN-created Uniform Rapid Suspension system for new gTLDs. (At present the WIPO Center is not a provider for URS cases.)

Under the relevant ICANN provisions, a URS complaint may not be filed if there is a pending URS or UDRP proceeding involving the same domain name(s). There is no explicit prohibition however, against the filing of a UDRP proceeding during a URS case. (Paragraphs 16 and 17 of the URS rules address concurrent legal proceedings.) In such event, the filing party may wish to consider whether to withdraw any such URS case after the filing of the UDRP proceeding, to maintain the registrar "lock" on the domain name while avoiding potential questions regarding implementation of overlapping decisions.

There have also been UDRP proceedings filed where the same domain name was previously subject to a URS case. In such event, the UDRP complaint should make this clear.

UDRP panels have noted that a URS case shall not cause prejudice in a UDRP proceeding. This stems in part from the fact that, aside from not being specifically linked together by ICANN in procedural terms, the URS and UDRP are distinct dispute resolution mechanisms. While the UDRP operates on an “on balance” standard, the burden of proof on the more limited pleadings provided for under the URS requires that the complainant demonstrate by “clear and convincing evidence” that the particular case facts merit a determination in its favor. The URS only provides for a proportionally appropriate remedy, namely the temporary domain name suspension (instead of the transfer provided for under the UDRP). Importantly, URS determinations rarely provide insight into the particular legal reasoning applied. Thus, while a UDRP panel should be made aware of a URS determination, it is not bound by that determination.

NB, despite its more limited pleadings and remedy, the URS foresees a range of various appeals layers over an extended time period.

[See generally section 4.2.]

#### **Relevant decisions**

*Yves Saint Laurent v. Khita Kongsansatien*,  
WIPO Case No. **D2016-0496**, <saintlaurent.club> and <ysl.club>, Transfer

*SRAM, LLC v. Li Qing*,  
WIPO Case No. **D2016-1172**, <sram.red>, Transfer

*Virgin Enterprises Limited v. Wang Hong Wei*,  
WIPO Case No. **D2016-1860**, <virginmedia.vip>, Transfer

*ASOS plc v. Michael Getz*,  
WIPO Case No. **D2017-0052**, <asosaustralia.top>, Transfer

*Dr. Ing. H.c. F. Porsche AG*,  
WIPO Case No. **D2017-0288**, <porsche.kaufen>, Terminated



# WIPO LEGAL INDEX OF WIPO UDRP PANEL DECISIONS

WIPO

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## Legal Index of WIPO UDRP Panel Decisions

This Legal Index covers all WIPO UDRP decisions. New decisions are added as relevant. The Center also makes available a separate [WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition](#).

Any time you select more than one category, the search result will yield ONLY those decisions that are indexed in ALL of the categories so selected.

### ▼ Search tips and examples ↓

1. The principal purpose of the Index is to offer structured access to the large quantity of legal and other data contained in the WIPO Panel decisions under the Uniform Domain Name Dispute Resolution Policy ("UDRP"). In order to maintain ease of access and to avoid needless duplication, the Index does not necessarily refer to all of the many decisions that may touch upon a certain issue. Rather, it provides an informative sample of decisions with regard to specific issues of interest.
2. You may select more than one field at a time in "Decided cases by domain name categories"; likewise, you may select more than one field in "Legal index to decisions"; and you may also combine one or more fields in "Decided cases by domain name categories" with one or more fields in "Legal index to decisions". In all such cases, the resulting outcome will be limited to decisions that cover all of the combined criteria.  
e.g. A single search may combine "III.A. Authors" (under "Decided cases by domain name categories") and "II.A.1.i.(ii) Personal names / unregistered" (under "Legal index to decisions"). As a further example, a single search could combine "II.A.1.i.(ii) Personal names / unregistered" and "II.B.4.b. Fair use and Free Speech" (both under "Legal index to decisions").
3. If you select a certain field, the search results for that level will be displayed by the sub-categories in the next lower level (if any).  
e.g. If you click only on "III. Individuals" (under "Decided cases by domain name categories"), the search results will display all cases under this field sorted by the sub-categories "III.A. Authors, III.B. Business, III.C. Entertainment, III.D. Media, III.E. Political, III.F. Sports".  
If, however, you are interested in "III.A. Authors" individuals and separately in "III.F. Sports" individuals, and you do not want other categories of Individuals mentioned in your search results, do a search for "III.A. Authors" and a separate search for "III.F. Sports". If you select both categories in a single search, the search result will yield only those decisions (if any) overlapping both categories.
4. This Index is based on a review of all WIPO UDRP Panel decisions rendered to date. New decisions are being added continuously.

<https://www.wipo.int/amc/en/domains/search/legalindex/>

### Decided WIPO cases by domain name categories

Select all Deselect all Expand all Collapse all

- I. Associations and Institutions
  - A. Religious
  - B. Sports
  - C. Others
- II. Geographical Identifiers
- III. Individuals
  - A. Authors
  - B. Business
  - C. Entertainment (Music and Film)
  - D. Media
  - E. Political
  - F. Sports
  - G. Other
- IV. Industry and Commerce
  - A. Automobiles
  - B. Banking and Finance
  - C. Biotechnology and Pharmaceuticals
  - D. Electronics
  - E. Entertainment
  - F. Fashion
  - G. Food, Beverages and Restaurants
  - H. Heavy Industry and Machinery
  - I. Hotels and Travel
  - J. Insurance
  - K. Internet and IT
  - L. Luxury Items
  - M. Media and Publishing
  - N. Retail
  - O. Sports
  - P. Telecom
  - Q. Transportation
  - R. Other
- V. Non-ASCII Script Registrations
  - A. Chinese
  - B. Danish
  - C. French
  - D. German
  - E. Japanese
  - F. Korean

### Legal Index to WIPO panel decisions

Select all Deselect all Expand all Collapse all

- I. General
  - A. Competence
  - B. Mandatory Proceeding
- II. Substance
  - A. Identical or Confusingly Similar to a Trademark or a Service Mark in which the Complainant has Rights (Policy, Para. 4(a)(i))
    - 1. Trademark / Service Mark
      - a. General
      - b. Goods or services associated with mark
    - c. Distinctiveness
      - (i). General
      - (ii). Generic / Descriptive
      - (iii). Suggestive
      - (iv). Arbitrary; Fanciful
    - d. Mark validity in question
    - e. Device mark
    - f. Registered mark
    - g. Unregistered mark / common-law mark
    - h. Well-known mark
    - i. Personal names
      - (i). Registered mark
      - (ii). Unregistered
    - j. Trade names
      - (i). Registered
      - (ii). Unregistered
    - k. Geographical identifiers
      - (i). Indications of source and geographical indications
      - (ii). Geographical terms
    - l. International Nonproprietary Names (INNs) for pharmaceutical substances
  - 2. Rights in Mark
    - a. General
    - b. Territorial effect
    - c. Timing of rights
    - d. Licensee
    - e. Disclaimed
  - 3. Identical or Confusingly Similar
    - a. General
    - b. Absence of actual confusion
    - c. Misspelling ("Typosquatting")

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- G. Norwegian
- H. Spanish
- I. Swedish
- VI. Professional Firms
- VII. Education
- VIII. Public Sector (Governments)
  - A. States and State Agencies
  - B. Intergovernmental Organizations

- d. *Phonetical similarity*
- e. *Translation/Transliteration*
- f. *Overall impression*
- g. *Prefix + mark*
- h. *Mark with geographical term*
- i. *Mark with generic word*
- j. *Mark with "sucks" or with other pejorative term*
- k. *Abbreviation of mark*
- l. *Mark + Mark*
- m. *Symbols and punctuation marks*
- n. *Internationalized Domain Names (IDNs)*
- o. *TLD*
- p. *Content of Website*
- B. *Rights or Legitimate Interests (Policy, Para. 4(a)(ii))*
  - 1. *General*
  - 2. *Bona Fide Use (Policy, Para. 4(c)(i))*
    - a. *General*
    - b. *"before notice"*
    - c. *"demonstrable preparations to use"*
      - (i). *Finding for respondent*
      - (ii). *Finding against respondent*
    - d. *"bona fide offering"*
    - e. *Use of dictionary term*
  - f. *Concurrent use*
    - (i). *Finding for respondent*
    - (ii). *Finding against respondent*
  - g. *Distributorship and Agency, Resellers, Collateral use*
    - (i). *Finding for respondent*
    - (ii). *Finding against respondent*
  - h. *Pay-per-click and other landing pages*
  - i. *Sale of Counterfeits*
  - j. *Nominative Fair Use*
- 3. *"Commonly known by" (Policy, Para. 4(c)(ii))*
- 4. *Legitimate Noncommercial, Fair Use (Policy, Para. 4(c)(iii))*
  - a. *General*
  - b. *Fair Use and Free Speech*
    - (i). *Criticism and Commentary*
    - (ii). *Parody Sites*
    - (iii). *Fan Sites*
- 5. *Mark Rights of Respondent*

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- C. Registration and Use in Bad Faith (Policy, Para. 4(a)(iii))
  - 1. General
- 2. Conjunctive Requirement
  - a. General
  - b. Registration in good faith, usage in bad faith
  - c. Registration in bad faith, usage in good faith
- 3. Registration in Bad Faith
  - a. General
  - b. Acquisition of domain name from third party
  - c. Registration of domain name prior to mark registration
  - d. Renewals
- 4. Use in Bad Faith
  - a. General
  - b. Non-web site use
  - c. Inaction / Passive holding
- 5. Evidence of Registration and Use in Bad Faith (Policy, Para. 4(b))
  - a. General
  - b. Offer to sell / rent or license (Policy, Para. 4(b)(i))
    - (i). Offer to Complainant
      - (1). General
      - (2). Solicited
      - (3). Unsolicited
    - (ii). Offer to general public
      - (1). General
      - (2). Auction web site
      - (3). Listing in Whois directory
    - (iii). "out-of-pocket costs"
      - (1). General
      - (2). Monetary demands
      - (3). Other demands
    - (iv). Offer - Bad faith not found
  - c. Pattern of conduct (Policy, Para. 4(b)(ii))
    - (i). Found
    - (ii). Not Found
  - d. Disrupt competitor (Policy, Para. 4(b)(iii))
    - (i). General
    - (ii). "competitor"
  - e. Attract Internet users (Policy, Para. 4(b)(iv))
    - (i). General
    - (ii). Automatic hyperlinking
      - (1). Pornographic sites
      - (2). Competitor's sites
      - (3). Other sites

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- (iii). Mousetrapping
- f. Prior knowledge/notice of mark
    - (i). Willful blindness
    - (ii). Constructive notice
    - (iii). Knew or should have known
    - (iv). Registrant search obligation
  - g. Other considerations
    - (i). General
    - (ii). False contact information
    - (iii). Use of privacy service
    - (iv). Speculation in domain names
    - (v). Inconceivable legitimate use
    - (vi). Inactive web sites
    - (vii). Automated registration
    - (viii). Advertising revenue arrangements
    - (ix). Infringement of complainant's IP rights
    - (x). Disclaimer
    - (xi). Prior relationship between parties
    - (xii). Acquiescence of mark owner
    - (xiii). Cease and desist letter
    - (xiv). Unauthorized acquisition of domain name
    - (xv). Parking / landing pages
    - (xvi). Tarnishment
    - (xvii). Use of robots.txt
    - (xviii). Sale of Counterfeits
- III. Procedure
  - A. Parties
    - 1. Complainant
      - a. General
      - b. Multiple Complainants

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- 2. Respondent
  - a. General
  - b. Multiple Respondents
  - c. Beneficial holder of domain name
  - d. Privacy
  - e. Cyberflight
  - f. Name redacted / identity theft
- B. Domain name
  - 1. General
  - 2. Registered before Dec. 1999
  - 3. Multiple domain names
    - a. Addition of domain names
  - 4. "Internationalized" domain names
- C. Filings
  - 1. General
  - 2. Complaint
  - 3. Response
    - a. General
    - b. Extension
      - (i). By Provider discretion
      - (ii). By Party agreement
    - c. Late response
    - d. Deficient response
    - e. Default
  - 4. Supplemental Filings
    - a. General
    - b. Requested by panel
    - c. Unsolicited
      - (i). Considered
      - (ii). Not considered
  - 5. Language

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	<input checked="" type="checkbox"/> 6. Consolidation
	<input checked="" type="checkbox"/> 7. Refiling
•	<input checked="" type="checkbox"/> D. Provider's Role
	<input checked="" type="checkbox"/> 1. General
	<input checked="" type="checkbox"/> 2. Notifications
	<input checked="" type="checkbox"/> E. Registrar Issues
•	<input checked="" type="checkbox"/> F. Administrative Panel
	<input checked="" type="checkbox"/> 1. General
	<input checked="" type="checkbox"/> 2. General Powers
	<input checked="" type="checkbox"/> 3. Impartiality and Independence
•	<input checked="" type="checkbox"/> G. Decision
•	<input checked="" type="checkbox"/> 1. Basis of Decision
	<input checked="" type="checkbox"/> a. General
	<input checked="" type="checkbox"/> b. Applicable law
	<input checked="" type="checkbox"/> c. Delay in bringing Complaint
	<input checked="" type="checkbox"/> d. Judicial decisions
•	<input checked="" type="checkbox"/> e. Evidence
	<input checked="" type="checkbox"/> (i). General
	<input checked="" type="checkbox"/> (ii). Burden / Standard of proof
	<input checked="" type="checkbox"/> (iii). Conflicting evidence
•	<input checked="" type="checkbox"/> (iv). "without prejudice" materials
	<input checked="" type="checkbox"/> (1). Considered
	<input checked="" type="checkbox"/> (2). Not considered
	<input checked="" type="checkbox"/> (v). On-line archives
	<input checked="" type="checkbox"/> f. Party settlement
	<input checked="" type="checkbox"/> g. Consent to transfer
	<input checked="" type="checkbox"/> h. Respondent default
•	<input checked="" type="checkbox"/> 2. Remedies
	<input checked="" type="checkbox"/> a. General
	<input checked="" type="checkbox"/> b. Requested remedies other than transfer or cancellation

<https://www.wipo.int/amc/en/domains/search/legalindex/>

Search    Reset

- ▾  2. Remedies
  - a. General
  - b. Requested remedies other than transfer or cancellation
- ▾  3. Reverse Domain Name Hijacking
  - a. Found
  - b. Not Found
- 4. Precedent value of panel decisions
- ▾  IV. National Court Proceedings Relating to UDRP
  - A. General
  - B. Challenges to UDRP Decisions
  - C. Concurrent Court Proceedings

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# DOMAIN NAME DISPUTE RESOLUTION SERVICE FOR COUNTRY CODE TOP LEVEL DOMAINS (“CCTLDS”)

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## Domain Name Dispute Resolution Service for Country Code Top Level Domains (ccTLDs)

Since the launch of the [WIPO ccTLD Program](#) in 2000, WIPO has provided advice to many ccTLDs with a view to establishing registration conditions and dispute resolution procedures that conform with international standards of intellectual property protection while taking into account the particular circumstances and needs of the individual ccTLD.

The WIPO Center provides domain name dispute resolution services for the ccTLDs listed in the below table. Each such ccTLD page includes links to a range of relevant resources including for case filings.


**Where a ccTLD has adopted the UDRP, those domain names may be consolidated with gTLD and other ccTLD domain names against a single registrant in a single UDRP complaint.**

ccTLDs adopting the UDRP include .ag, .ai, .as, .bm, .bs, .bz, .cc, .cd, .co, .cy, .dj, .ec, .fj, .fm, .gd, .gt, .ki, .la, .lc, .md, .me, .mw, .nr, .nu, .pa, .pk, .pn, .pr, .pw, .ro, .sa, .sc, .sl, .sn, .so, .tj, .tt, .tv, .ug, .ve, .vg, and .ws.

*(\*) Those ccTLDs which use a variation of the UDRP are marked below with an asterisk.*

### ▾ More general ccTLD information

- The [WIPO ccTLD Database](#) contains links to the websites of 252 ccTLDs allowing to determine the availability of a registration agreement, the existence of a WhoIs service and the adoption of ADR procedures.
- The [Trademark Database Portal](#) facilitates access to online trademark databases of a number of national and regional intellectual property offices, allowing any person wishing to register a domain name to perform a prior trademark search.
- The [WIPO ccTLD Best Practices for the Prevention and Resolution of Intellectual Property Disputes](#) provide an overview of practices and policies for ccTLD operations designed to curb abusive and bad faith registration of protected names, and to resolve related disputes.



**FEATURED**

Guide to WIPO's services for country code top-level domain registries

[Guide](#)

<https://www.wipo.int/amc/en/domains/cctlld/>

ccTLDs for which the WIPO Center provides dispute resolution services	
<b>A</b> .AC (Ascension Island) (*) .AE and امارات. (United Arab Emirates) (*) .AG (Antigua and Barbuda) .AI (Anguilla) .AO (Angola) (*) .AS (American Samoa) .AU (Australia) (*)	<b>B</b> .BH and البحرين. (Bahrain) (*) .BM (Bermuda) .BO (Bolivia (Plurinational State of)) (*) .BR (Brazil) (*) .BS (Bahamas) .BZ (Belize)
<b>C</b> .CC (Cocos Islands) .CD (Democratic Republic of the Congo) .CH (Switzerland) (*) .CN and .中国 (China) (*) .CO (Colombia) .CR (Costa Rica) (*) .CY (Cyprus)	<b>D</b> .DJ (Djibouti) .DO (Dominican Republic) (*)
<b>E</b> .EC (Ecuador) .ES (Spain) (*) .EU (European Union) (*)	<b>F</b> .FJ (Fiji) .FM (Micronesia (Federated States of)) .FR (France) (*)
<b>G</b> .GD (Grenada) .GE (Georgia) (*) .GT (Guatemala)	<b>H</b> .HN (Honduras) (*)
<b>I</b> .IE (Ireland) (*) .IO (British Indian Ocean Territory) (*) .IR (Islamic Republic of Iran) (*)	<b>K</b> .KI (Kiribati)
<b>L</b> .LA (Lao People's Democratic Republic) .LC (Saint Lucia) .LI (Liechtenstein) (*)	<b>M</b> .MA (Morocco) (*) .MD (Republic of Moldova) .ME (Montenegro) .MP (Commonwealth of the Northern Mariana Islands) (*) .MW (Malawi) .MX (Mexico) (*)

<p><b>N</b></p> <p>.NL (Netherlands) (*)</p> <p>.NR (Nauru)</p> <p>.NU (Niue)</p>	<p><b>P</b></p> <p>.PA (Panama)</p> <p>.PE (Peru) (*)</p> <p>.PH (Philippines) (*)</p> <p>.PK (Pakistan)</p> <p>.PL (Poland) (**) [expedited arbitration process]</p> <p>.PM (St. Pierre and Miquelon) (*)</p> <p>.PN (Pitcairn Islands)</p> <p>.PR (Puerto Rico)</p> <p>.PW (Palau)</p> <p>.PY (Paraguay) (*)</p>
<p><b>Q</b></p> <p>.QA and قطر. (Qatar) (*)</p>	<p><b>R</b></p> <p>.RE (Reunion Island) (*)</p> <p>.RO (Romania)</p>
<p><b>S</b></p> <p>.SA and السعودية. (Saudi Arabia) (*)</p> <p>.SC (Seychelles)</p> <p>.SE (Sweden) (*)</p> <p>.SH (Saint Helena) (*)</p> <p>.SL (Sierra Leone)</p> <p>.SN (Senegal)</p> <p>.SO (Somalia)</p>	<p><b>T</b></p> <p>.TF (French Southern Territories) (*)</p> <p>.TJ (Tajikistan)</p> <p>.TM (Turkmenistan) (*)</p> <p>.TT (Trinidad and Tobago)</p> <p>.TV (Tuvalu)</p> <p>.TZ (United Republic of Tanzania) (*)</p>
<p><b>U</b></p> <p>.UA (Ukraine) (*)</p> <p>.UG (Uganda)</p>	<p><b>V</b></p> <p>.VE (Venezuela (Bolivarian Republic of))</p> <p>.VG (Virgin Islands (British))</p>
<p><b>W</b></p> <p>.WF (Wallis and Futuna Islands) (*)</p> <p>.WS (Samoa)</p>	<p><b>Y</b></p> <p>.YT (Mayotte) (*)</p>

<https://www.wipo.int/amc/en/domains/cctld/>



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# UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY ("UDRP")

**Policy Adopted: August 26, 1999  
(As Approved by ICANN on October 24, 1999)**

## 1. Purpose

This Uniform Domain Name Dispute Resolution Policy (the "Policy") has been adopted by the Internet Corporation for Assigned Names and Numbers ("ICANN"), is incorporated by reference into your Registration Agreement, and sets forth the terms and conditions in connection with a dispute between you and any party other than us (the registrar) over the registration and use of an Internet domain name registered by you. Proceedings under **Paragraph 4** of this Policy will be conducted according to the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules of Procedure"), which are available at <https://www.icann.org/resources/pages/udrp-rules-2015-03-11-en>, and the selected administrative-dispute-resolution service provider's supplemental rules.

## 2. Your Representations

By applying to register a domain name, or by asking us to maintain or renew a domain name registration, you hereby represent and warrant to us that (a) the statements that you made in your Registration Agreement are complete and accurate; (b) to your knowledge, the registration of the domain name will not infringe upon or otherwise violate the rights of any third party; (c) you are not registering the domain name for an unlawful purpose; and (d) you will not knowingly use the domain name in violation of any applicable laws or regulations. It is your responsibility to determine whether your domain name registration infringes or violates someone else's rights.

## 3. Cancellations, Transfers, and Changes

We will cancel, transfer or otherwise make changes to domain name registrations under the following circumstances:

- a. subject to the provisions of Paragraph 8, our receipt of written or appropriate electronic instructions from you or your authorized agent to take such action;
- b. our receipt of an order from a court or arbitral tribunal, in each case of competent jurisdiction, requiring such action; and/or
- c. our receipt of a decision of an Administrative Panel requiring such action in any administrative proceeding to which you were a party and which was conducted under this Policy or a later version of this Policy adopted by ICANN. (See **Paragraph 4(i) and (k)** below.)

We may also cancel, transfer or otherwise make changes to a domain name registration in accordance with the terms of your Registration Agreement or other legal requirements.

#### 4. Mandatory Administrative Proceeding

This Paragraph sets forth the type of disputes for which you are required to submit to a mandatory administrative proceeding. These proceedings will be conducted before one of the administrative-dispute-resolution service providers listed at [www.icann.org/en/dndr/udrp/approved-providers.htm](http://www.icann.org/en/dndr/udrp/approved-providers.htm) (each, a “Provider”).

- 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 are present.

- 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 or of a product or service on your web site or location.

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- c. How to Demonstrate Your Rights to and Legitimate Interests in the Domain Name in Responding to a Complaint.** When you receive a complaint, you should refer to **Paragraph 5** of the Rules of Procedure in determining how your response should be prepared. Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of **Paragraph 4(a)(ii)**:
- (i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
  - (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.
- d. Selection of Provider.** The complainant shall select the Provider from among those approved by ICANN by submitting the complaint to that Provider. The selected Provider will administer the proceeding, except in cases of consolidation as described in **Paragraph 4(f)**.
- e. Initiation of Proceeding and Process and Appointment of Administrative Panel.** The Rules of Procedure state the process for initiating and conducting a proceeding and for appointing the panel that will decide the dispute (the “Administrative Panel”).
- f. Consolidation.** In the event of multiple disputes between you and a complainant, either you or the complainant may petition to consolidate the disputes before a single Administrative Panel. This petition shall be made to the first Administrative Panel appointed to hear a pending dispute between the parties. This Administrative Panel may consolidate before it any or all such disputes in its sole discretion, provided that the disputes being consolidated are governed by this Policy or a later version of this Policy adopted by ICANN.
- g. Fees.** All fees charged by a Provider in connection with any dispute before an Administrative Panel pursuant to this Policy shall be paid by the complainant, except in cases where you elect to expand the Administrative Panel from one to three panelists as provided in **Paragraph 5(b)(iv)** of the Rules of Procedure, in which case all fees will be split evenly by you and the complainant.
- h. Our Involvement in Administrative Proceedings.** We do not, and will not, participate in the administration or conduct of any proceeding before an Administrative Panel. In addition, we will not be liable as a result of any decisions rendered by the Administrative Panel.

- i. Remedies.** 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.
- j. Notification and Publication.** The Provider shall notify us of any decision made by an Administrative Panel with respect to a domain name you have registered with us. All decisions under this Policy will be published in full over the Internet, except when an Administrative Panel determines in an exceptional case to redact portions of its decision.
- k. Availability of Court Proceedings.** The mandatory administrative proceeding requirements set forth in **Paragraph 4** shall not prevent either you or the complainant from submitting the dispute to a court of competent jurisdiction for independent resolution before such mandatory administrative proceeding is commenced or after such proceeding is concluded. If an Administrative Panel decides that your domain name registration should be canceled or transferred, we will wait ten (10) business days (as observed in the location of our principal office) after we are informed by the applicable Provider of the Administrative Panel's decision before implementing that decision. We will then implement the decision unless we have received from you during that ten (10) business day period official documentation (such as a copy of a complaint, file-stamped by the clerk of the court) that you have commenced a lawsuit against the complainant in a jurisdiction to which the complainant has submitted under **Paragraph 3(b)(xiii)** of the Rules of Procedure. (In general, that jurisdiction is either the location of our principal office or of your address as shown in our Whois database. See **Paragraphs 1** and **3(b)(xiii)** of the Rules of Procedure for details.) If we receive such documentation within the ten (10) business day period, we will not implement the Administrative Panel's decision, and we will take no further action, until we receive (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.

## **5. All Other Disputes and Litigation**

All other disputes between you and any party other than us regarding your domain name registration that are not brought pursuant to the mandatory administrative proceeding provisions of **Paragraph 4** shall be resolved between you and such other party through any court, arbitration or other proceeding that may be available.

## **6. Our Involvement in Disputes**

We will not participate in any way in any dispute between you and any party other than us regarding the registration and use of your domain name. You shall not name us as a party or otherwise include us in any such proceeding. In the event that we are named as a party in any such proceeding, we reserve the right to raise any and all defenses deemed appropriate, and to take any other action necessary to defend ourselves.

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## 7. Maintaining the Status Quo

We will not cancel, transfer, activate, deactivate, or otherwise change the status of any domain name registration under this Policy except as provided in [Paragraph 3](#) above.

## 8. Transfers During a Dispute

- a. **Transfers of a Domain Name to a New Holder.** You may not transfer your domain name registration to another holder (i) during a pending administrative proceeding brought pursuant to [Paragraph 4](#) or for a period of fifteen (15) business days (as observed in the location of our principal place of business) after such proceeding is concluded; or (ii) during a pending court proceeding or arbitration commenced regarding your domain name unless the party to whom the domain name registration is being transferred agrees, in writing, to be bound by the decision of the court or arbitrator. We reserve the right to cancel any transfer of a domain name registration to another holder that is made in violation of this subparagraph.
- b. **Changing Registrars.** You may not transfer your domain name registration to another registrar during a pending administrative proceeding brought pursuant to [Paragraph 4](#) or for a period of fifteen (15) business days (as observed in the location of our principal place of business) after such proceeding is concluded. You may transfer administration of your domain name registration to another registrar during a pending court action or arbitration, provided that the domain name you have registered with us shall continue to be subject to the proceedings commenced against you in accordance with the terms of this Policy. In the event that you transfer a domain name registration to us during the pendency of a court action or arbitration, such dispute shall remain subject to the domain name dispute policy of the registrar from which the domain name registration was transferred.

## 9. Policy Modifications

We reserve the right to modify this Policy at any time with the permission of ICANN. We will post our revised Policy at <URL> at least thirty (30) calendar days before it becomes effective. Unless this Policy has already been invoked by the submission of a complaint to a Provider, in which event the version of the Policy in effect at the time it was invoked will apply to you until the dispute is over, all such changes will be binding upon you with respect to any domain name registration dispute, whether the dispute arose before, on or after the effective date of our change. In the event that you object to a change in this Policy, your sole remedy is to cancel your domain name registration with us, provided that you will not be entitled to a refund of any fees you paid to us. The revised Policy will apply to you until you cancel your domain name registration



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## RULES FOR UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY (“RULES”)

As approved by the ICANN Board of Directors on 28 September 2013.

**These Rules are in effect for all UDRP proceedings in which a complaint is submitted to a provider on or after 31 July 2015. The prior version of the Rules, applicable to all proceedings in which a complaint was submitted to a Provider on or before 30 July 2015, is at <https://www.icann.org/resources/pages/rules-be-2012-02-25-en>. UDRP Providers may elect to adopt the notice procedures set forth in these Rules prior to 31 July 2015.**

Administrative proceedings for the resolution of disputes under the Uniform Dispute Resolution Policy adopted by ICANN shall be governed by these Rules and also the Supplemental Rules of the Provider administering the proceedings, as posted on its web site. To the extent that the Supplemental Rules of any Provider conflict with these Rules, these Rules supersede.

### 1. Definitions

In these Rules:

**Complainant** means the party initiating a complaint concerning a domain-name registration.

**ICANN** refers to the Internet Corporation for Assigned Names and Numbers.

**Lock** means a set of measures that a registrar applies to a domain name, which prevents at a minimum any modification to the registrant and registrar information by the Respondent, but does not affect the resolution of the domain name or the renewal of the domain name.

**Mutual Jurisdiction** means a court jurisdiction at the location of either (a) the principal office of the Registrar (provided the domain-name holder has submitted in its Registration Agreement to that jurisdiction for court adjudication of disputes concerning or arising from the use of the domain name) or (b) the domain-name holder’s address as shown for the registration of the domain name in Registrar’s Whois database at the time the complaint is submitted to the Provider.

**Panel** means an administrative panel appointed by a Provider to decide a complaint concerning a domain-name registration.

**Panelist** means an individual appointed by a Provider to be a member of a Panel.

**Party** means a Complainant or a Respondent.

**Pendency** means the time period from the moment a UDRP complaint has been submitted by the Complainant to the UDRP Provider to the time the UDRP decision has been implemented or the UDRP complaint has been terminated.

**Policy** means the **Uniform Domain Name Dispute Resolution Policy** that is incorporated by reference and made a part of the Registration Agreement.

**Provider** means a dispute-resolution service provider approved by ICANN. A list of such Providers appears at <http://www.icann.org/en/dndr/udrp/approved-providers.htm>.

**Registrar** means the entity with which the Respondent has registered a domain name that is the subject of a complaint.

**Registration Agreement** means the agreement between a Registrar and a domain-name holder.

**Respondent** means the holder of a domain-name registration against which a complaint is initiated.

**Reverse Domain Name Hijacking** means using the Policy in bad faith to attempt to deprive a registered domain-name holder of a domain name.

**Supplemental Rules** means the rules adopted by the Provider administering a proceeding to supplement these Rules. Supplemental Rules shall not be inconsistent with the Policy or these Rules and shall cover such topics as fees, word and page limits and guidelines, file size and format modalities, the means for communicating with the Provider and the Panel, and the form of cover sheets.

**Written Notice** means hardcopy notification by the Provider to the Respondent of the commencement of an administrative proceeding under the Policy which shall inform the respondent that a complaint has been filed against it, and which shall state that the Provider has electronically transmitted the complaint including any annexes to the Respondent by the means specified herein. Written notice does not include a hardcopy of the complaint itself or of any annexes.

## 2. Communications

- (a) When forwarding a complaint, including any annexes, electronically to the Respondent, it shall be the Provider's responsibility to employ reasonably available means calculated to achieve actual notice to Respondent. Achieving actual notice, or employing the following measures to do so, shall discharge this responsibility:
- (i) sending Written Notice of the complaint to all postal-mail and facsimile addresses (A) shown in the domain name's registration data in Registrar's Whois database for the registered domain-name holder, the technical contact, and the administrative contact and (B) supplied by Registrar to the Provider for the registration's billing contact; and
  - (ii) sending the complaint, including any annexes, in electronic form by e-mail to:
    - (A) the e-mail addresses for those technical, administrative, and billing contacts;
    - (B) `postmaster@<the contested domain name>`; and
    - (C) if the domain name (or "www." followed by the domain name) resolves to an active web page (other than a generic page the Provider concludes is maintained by a registrar or ISP for parking domain-names registered by multiple domain-name holders), any e-mail address shown or e-mail links on that web page; and

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- (iii) sending the complaint, including any annexes, to any e-mail address the Respondent has notified the Provider it prefers and, to the extent practicable, to all other e-mail addresses provided to the Provider by Complainant under **Paragraph 3(b)(v)**.
  - (b) Except as provided in **Paragraph 2(a)**, any written communication to Complainant or Respondent provided for under these Rules shall be made electronically via the Internet (a record of its transmission being available), or by any reasonably requested preferred means stated by the Complainant or Respondent, respectively (see **Paragraphs 3(b)(iii)** and **5(b)(iii)**).
  - (c) Any communication to the Provider or the Panel shall be made by the means and in the manner (including, where applicable, the number of copies) stated in the Provider's Supplemental Rules.
  - (d) Communications shall be made in the language prescribed in **Paragraph 11**.
  - (e) Either Party may update its contact details by notifying the Provider and the Registrar.
  - (f) Except as otherwise provided in these Rules, or decided by a Panel, all communications provided for under these Rules shall be deemed to have been made:
    - (i) if via the Internet, on the date that the communication was transmitted, provided that the date of transmission is verifiable; or, where applicable
    - (ii) if delivered by telecopy or facsimile transmission, on the date shown on the confirmation of transmission; or:
    - (iii) if by postal or courier service, on the date marked on the receipt.
  - (g) Except as otherwise provided in these Rules, all time periods calculated under these Rules to begin when a communication is made shall begin to run on the earliest date that the communication is deemed to have been made in accordance with **Paragraph 2(f)**.
  - (h) Any communication by
    - (i) a Panel to any Party shall be copied to the Provider and to the other Party;
    - (ii) the Provider to any Party shall be copied to the other Party; and
    - (iii) a Party shall be copied to the other Party, the Panel and the Provider, as the case may be.
  - (i) It shall be the responsibility of the sender to retain records of the fact and circumstances of sending, which shall be available for inspection by affected parties and for reporting purposes. This includes the Provider in sending Written Notice to the Respondent by post and/or facsimile under **Paragraph 2(a)(i)**.
  - (j) In the event a Party sending a communication receives notification of non-delivery of the communication, the Party shall promptly notify the Panel (or, if no Panel is yet appointed, the Provider) of the circumstances of the notification. Further proceedings

concerning the communication and any response shall be as directed by the Panel (or the Provider).

### 3. The Complaint

- (a) Any person or entity may initiate an administrative proceeding by submitting a complaint in accordance with the Policy and these Rules to any Provider approved by ICANN. (Due to capacity constraints or for other reasons, a Provider's ability to accept complaints may be suspended at times. In that event, the Provider shall refuse the submission. The person or entity may submit the complaint to another Provider.)
- (b) The complaint including any annexes shall be submitted in electronic form and shall:
- (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 (where applicable);
  - (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 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;
- (xiii) Conclude with the following statement followed by the signature (in any electronic format) 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

- (xiv) 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.
- (c) The complaint may relate to more than one domain name, provided that the domain names are registered by the same domain-name holder.

#### **4. Notification of Complaint**

- (a) The Provider shall submit a verification request to the Registrar. The verification request will include a request to Lock the domain name.
- (b) Within two (2) business days of receiving the Provider's verification request, the Registrar shall provide the information requested in the verification request and confirm that a Lock of the domain name has been applied. The Registrar shall not notify the Respondent of the proceeding until the Lock status has been applied. The Lock shall remain in place through the remaining Pendency of the UDRP proceeding. Any updates to the Respondent's data, such as through the result of a request by a privacy or proxy provider to reveal the underlying customer data, must be made before the two (2) business day period concludes or before the Registrar verifies the information requested and confirms the Lock to the UDRP Provider, whichever occurs first. Any modification(s) of the Respondent's data following the two (2) business day period may be addressed by the Panel in its decision.
- (b) The Provider shall review the complaint for administrative compliance with the Policy and these Rules and, if in compliance, shall forward the complaint, including any annexes, electronically to the Respondent and Registrar and shall send Written Notice of the complaint (together with the explanatory cover sheet prescribed by the Provider's Supplemental Rules) to the Respondent, in the manner prescribed by **Paragraph 2(a)**, within three (3) calendar days following receipt of the fees to be paid by the Complainant in accordance with **Paragraph 19**.
- (d) If the Provider finds the complaint to be administratively deficient, it shall promptly notify the Complainant and the Respondent of the nature of the deficiencies identified. The Complainant shall have five (5) calendar days within which to correct any such deficiencies, after which the administrative proceeding will be deemed withdrawn without prejudice to submission of a different complaint by Complainant.
- (e) If the Provider dismisses the complaint due to an administrative deficiency, or the Complainant voluntarily withdraws its complaint, the Provider shall inform the Registrar that the proceedings have been withdrawn, and the Registrar shall release the Lock within one (1) business day of receiving the dismissal or withdrawal notice from the Provider.
- (f) The date of commencement of the administrative proceeding shall be the date on which the Provider completes its responsibilities under **Paragraph 2(a)** in connection with sending the complaint to the Respondent.
- (g) The Provider shall immediately notify the Complainant, the Respondent, the concerned Registrar(s), and ICANN of the date of commencement of the administrative proceeding. The Provider shall inform the Respondent that any corrections to the Respondent's contact information during the remaining Pendency of the UDRP proceedings shall be communicated to the Provider further to Rule 5(c)(ii) and 5(c)(iii).

## **5. The Response**

- (a) Within twenty (20) days of the date of commencement of the administrative proceeding the Respondent shall submit a response to the Provider.
- (b) The Respondent may expressly request an additional four (4) calendar days in which to respond to the complaint, and the Provider shall automatically grant the extension

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and notify the Parties thereof. This extension does not preclude any additional extensions that may be given further to 5(d) of the Rules.

- (c) The response, including any annexes, shall be submitted in electronic form and shall:
- (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 (where applicable);
  - (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 including any annexes 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 (in any electronic format) 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 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.
- (d) If Complainant has elected to have the dispute decided by a single-member Panel and Respondent elects a three-member Panel, Respondent shall be required to pay one-half of the applicable fee for a three-member Panel as set forth in the Provider's Supplemental Rules. This payment shall be made together with the submission of the

response to the Provider. In the event that the required payment is not made, the dispute shall be decided by a single-member Panel.

- (e) At the request of the Respondent, the Provider may, in exceptional cases, extend the period of time for the filing of the response. The period may also be extended by written stipulation between the Parties, provided the stipulation is approved by the Provider.
- (f) If a Respondent does not submit a response, in the absence of exceptional circumstances, the Panel shall decide the dispute based upon the complaint.

## **6. Appointment of the Panel and Timing of Decision**

- (a) Each Provider shall maintain and publish a publicly available list of panelists and their qualifications.
- (b) If neither the Complainant nor the Respondent has elected a three-member Panel (**Paragraphs 3(b)(iv)** and **5(b)(iv)**), the Provider shall appoint, within five (5) calendar days following receipt of the response by the Provider, or the lapse of the time period for the submission thereof, a single Panelist from its list of panelists. The fees for a single-member Panel shall be paid entirely by the Complainant.
- (c) If either the Complainant or the Respondent elects to have the dispute decided by a three-member Panel, the Provider shall appoint three Panelists in accordance with the procedures identified in **Paragraph 6(e)**. The fees for a three-member Panel shall be paid in their entirety by the Complainant, except where the election for a three-member Panel was made by the Respondent, in which case the applicable fees shall be shared equally between the Parties.
- (d) Unless it has already elected a three-member Panel, the Complainant shall submit to the Provider, within five (5) calendar days of communication of a response in which the Respondent elects a three-member Panel, 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.
- (e) In the event that either the Complainant or the Respondent elects a three-member Panel, the Provider shall endeavor to appoint one Panelist from the list of candidates provided by each of the Complainant and the Respondent. In the event the Provider is unable within five (5) calendar days to secure the appointment of a Panelist on its customary terms from either Party's list of candidates, the Provider shall make that appointment from its list of panelists. The third Panelist shall be appointed by the Provider from a list of five candidates submitted by the Provider to the Parties, the Provider's selection from among the five being made in a manner that reasonably balances the preferences of both Parties, as they may specify to the Provider within five (5) calendar days of the Provider's submission of the five-candidate list to the Parties.
- (f) Once the entire Panel is appointed, the Provider shall notify the Parties of the Panelists appointed and the date by which, absent exceptional circumstances, the Panel shall forward its decision on the complaint to the Provider.

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## **7. Impartiality and Independence**

A Panelist shall be impartial and independent and shall have, before accepting appointment, disclosed to the Provider any circumstances giving rise to justifiable doubt as to the Panelist's impartiality or independence. If, at any stage during the administrative proceeding, new circumstances arise that could give rise to justifiable doubt as to the impartiality or independence of the Panelist, that Panelist shall promptly disclose such circumstances to the Provider. In such event, the Provider shall have the discretion to appoint a substitute Panelist.

## **8. Communication Between Parties and the Panel**

No Party or anyone acting on its behalf may have any unilateral communication with the Panel. All communications between a Party and the Panel or the Provider shall be made to a case administrator appointed by the Provider in the manner prescribed in the Provider's Supplemental Rules.

## **9. Transmission of the File to the Panel**

The Provider shall forward the file to the Panel as soon as the Panelist is appointed in the case of a Panel consisting of a single member, or as soon as the last Panelist is appointed in the case of a three-member Panel.

## **10. General Powers of the Panel**

- (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.

## **11. Language of Proceedings**

- (a) Unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.

- (b) The Panel may order that any documents submitted in languages other than the language of the administrative proceeding be accompanied by a translation in whole or in part into the language of the administrative proceeding.

## 12. Further Statements

In addition to the complaint and the response, the Panel may request, in its sole discretion, further statements or documents from either of the Parties.

## 13. In-Person Hearings

There shall be no in-person hearings (including hearings by teleconference, videoconference, and web conference), unless the Panel determines, in its sole discretion and as an exceptional matter, that such a hearing is necessary for deciding the complaint.

## 14. Default

- (a) In the event that a Party, in the absence of exceptional circumstances, does not comply with any of the time periods established by these Rules or the Panel, the Panel shall proceed to a decision on the complaint.
- (b) If a Party, in the absence of exceptional circumstances, does not comply with any provision of, or requirement under, these Rules or any request from the Panel, the Panel shall draw such inferences therefrom as it considers appropriate.

## 15. Panel Decisions

- (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.
- (b) In the absence of exceptional circumstances, the Panel shall forward its decision on the complaint to the Provider within fourteen (14) days of its appointment pursuant to [Paragraph 6](#).
- (b) In the case of a three-member Panel, the Panel's decision shall be made by a majority.
- (c) The Panel's decision shall be in writing, provide the reasons on which it is based, indicate the date on which it was rendered and identify the name(s) of the Panelist(s).
- (d) Panel decisions and dissenting opinions shall normally comply with the guidelines as to length set forth in the Provider's Supplemental Rules. Any dissenting opinion shall accompany the majority decision. If the Panel concludes that the dispute is not within the scope of [Paragraph 4\(a\)](#) of the Policy, it shall so state. 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.

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## 16. Communication of Decision to Parties

- (a) Within three (3) business days after receiving the decision from the Panel, the Provider shall communicate the full text of the decision to each Party, the concerned Registrar(s), and ICANN. The concerned Registrar(s) shall within three (3) business days of receiving the decision from the Provider communicate to each Party, the Provider, and ICANN the date for the implementation of the decision in accordance with the Policy.
- (b) Except if the Panel determines otherwise (see [Paragraph 4\(j\)](#) of the Policy), the Provider shall publish the full decision and the date of its implementation on a publicly accessible web site. In any event, the portion of any decision determining a complaint to have been brought in bad faith (see [Paragraph 15\(e\)](#) of these Rules) shall be published.

## 17. Settlement or Other Grounds for Termination

- (a) If, before the Panel's decision, the Parties agree on a settlement, the Panel shall terminate the administrative proceeding. A settlement shall follow steps 17(a)(i) – 17(a)(vii):
  - (i) The Parties provide written notice of a request to suspend the proceedings because the parties are discussing settlement to the Provider.
  - (ii) The Provider acknowledges receipt of the request for suspension and informs the Registrar of the suspension request and the expected duration of the suspension.
  - (iii) The Parties reach a settlement and provide a standard settlement form to the Provider further to the Provider's supplemental rules and settlement form. The standard settlement form is not intended to be an agreement itself, but only to summarize the essential terms of the Parties' separate settlement agreement. The Provider shall not disclose the completed standard settlement form to any third party.
  - (iv) The Provider shall confirm to the Registrar, copying the Parties, the outcome of the settlement as it relates to actions that need to be taken by the Registrar.
  - (v) Upon receiving notice from the Provider further to 17(a)(iv), the Registrar shall remove the Lock within two (2) business days.
  - (vi) The Complainant shall confirm to the Provider that the settlement as it relates to the domain name(s) has been implemented further to the Provider's supplemental rules.
  - (vii) The Provider will dismiss the proceedings without prejudice unless otherwise stipulated in the settlement.
- (b) If, before the Panel's decision is made, it becomes unnecessary or impossible to continue the administrative proceeding for any reason, the Panel shall terminate the

administrative proceeding, unless a Party raises justifiable grounds for objection within a period of time to be determined by the Panel.

## **18. Effect of Court Proceedings**

- (a) In the event of any legal proceedings initiated prior to or during an administrative proceeding in respect of a domain-name dispute that is the subject of the complaint, the Panel shall have the discretion to decide whether to suspend or terminate the administrative proceeding, or to proceed to a decision.
- (b) In the event that a Party initiates any legal proceedings during the Pendency of an administrative proceeding in respect of a domain-name dispute that is the subject of the complaint, it shall promptly notify the Panel and the Provider. See [Paragraph 8](#) above.

## **19. Fees**

- (a) The Complainant shall pay to the Provider an initial fixed fee, in accordance with the Provider's Supplemental Rules, within the time and in the amount required. A Respondent electing under [Paragraph 5\(b\)\(iv\)](#) to have the dispute decided by a three-member Panel, rather than the single-member Panel elected by the Complainant, shall pay the Provider one-half the fixed fee for a three-member Panel. See [Paragraph 5\(c\)](#). In all other cases, the Complainant shall bear all of the Provider's fees, except as prescribed under [Paragraph 19\(d\)](#). Upon appointment of the Panel, the Provider shall refund the appropriate portion, if any, of the initial fee to the Complainant, as specified in the Provider's Supplemental Rules.
- (b) No action shall be taken by the Provider on a complaint until it has received from Complainant the initial fee in accordance with [Paragraph 19\(a\)](#).
- (c) If the Provider has not received the fee within ten (10) calendar days of receiving the complaint, the complaint shall be deemed withdrawn and the administrative proceeding terminated.
- (d) In exceptional circumstances, for example in the event an in-person hearing is held, the Provider shall request the Parties for the payment of additional fees, which shall be established in agreement with the Parties and the Panel.

## **20. Exclusion of Liability**

Except in the case of deliberate wrongdoing, neither the Provider nor a Panelist shall be liable to a Party for any act or omission in connection with any administrative proceeding under these Rules.

## **21. Amendments**

The version of these Rules in effect at the time of the submission of the complaint to the Provider shall apply to the administrative proceeding commenced thereby. These Rules may not be amended without the express written approval of ICANN.





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## WIPO SUPPLEMENTAL RULES FOR UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY (“WIPO SUPPLEMENTAL RULES”)

(The WIPO “Supplemental Rules”)  
(In effect as of July 31, 2015)

### 1. Scope

- (a) **Relationship to Rules.** These Supplemental Rules are to be read and used in connection with the **Rules for Uniform Domain Name Dispute Resolution Policy**, approved by the Internet Corporation for Assigned Names and Numbers (ICANN) on September 28, 2013 (the “Rules”).
- (b) **Version of Supplemental Rules.** The version of these Supplemental Rules as in effect on the date of the submission of the complaint shall apply to the administrative proceeding commenced thereby.

### 2. Definitions

Any term defined in the Rules shall have the same meaning in these Supplemental Rules.

### 3. Communications

- (a) **Modalities.** Subject to Paragraphs 3(b) and 5(c) of the Rules, except where otherwise agreed with the WIPO Arbitration and Mediation Center (the “Center”), any submission that may or is required to be made to the Center or to an Administrative Panel pursuant to these Rules, shall be made either:
  - (i) by electronic mail (email) using the address specified by the Center; or
  - (ii) through the Center’s Internet-based case filing and administration system.
- (b) **Archive.** The Center shall maintain an archive of all communications received or required to be made under the Rules.

### 4. Submission of Complaint and Annexes

- (a) **Complaint Including Annexes.** The complaint including any annexes shall be submitted electronically in complete form (in accordance with Paragraph 12(a) below).
- (b) **Complaint Transmittal Coversheet.** The Complainant shall be required to send or transmit its complaint under cover of the Complaint Transmittal Coversheet set out in **Annex A** hereto and posted on the Center’s website. Where available, the Complainant shall use the version that is in the same language(s) as the registration agreement(s) for the domain name(s) that is/are the subject of the complaint.

- (c) **Registrar Notification.** The Complainant shall provide a copy of the complaint to the concerned Registrar(s) at the same time as it submits its complaint to the Center.
- (d) **Complaint Notification Instructions.** In accordance with Paragraph 4(c) of the Rules, the Center shall forward the complaint electronically to the Respondent together with the instructions set out in **Annex B** hereto and posted on the Center's website. In accordance with Paragraph 2(a)(i) of the Rules the Center shall also forward Written Notice of the complaint to the Respondent.

## 5. Formalities Compliance Review

- (a) **Deficiency Notification.** The Center shall, within five (5) calendar days of receiving the complaint, review the complaint for compliance with the formal requirements of the Policy, Rules and Supplemental Rules and notify the Complainant and Respondent of any deficiencies therein.
- (b) **Withdrawal.** If the Complainant fails to remedy any deficiencies identified by the Center within the time period provided for in Paragraph 4(d) of the Rules (*i.e.*, five (5) calendar days), the Center shall notify the Complainant, the Respondent and the concerned Registrar(s) of the deemed withdrawal of the complaint.
- (c) **Fee Refunds.** Unless the Complainant confirms its intention to re-submit a complaint to the Center following a deemed withdrawal, the Center shall refund the fee paid by the Complainant pursuant to Paragraph 19 of the Rules, less a processing fee as set forth in **Annex D**.

## 6. Appointment of Case Administrator

- (a) **Notification.** The Center shall advise the Parties of the name and contact details of a member of its staff who shall be the Case Administrator and who shall be responsible for all administrative matters relating to the dispute and communications to the Administrative Panel.
- (b) **Responsibilities.** The Case Administrator may provide administrative assistance to the Administrative Panel or a Panelist, but shall have no authority to decide matters of a substantive nature concerning the dispute.

## 7. Submission of a Response

The response including any annexes shall be submitted electronically in complete form (in accordance with Paragraph 12(b) below).

## 8. Panelist Appointment Procedures

- (a) **Party Candidates**

Where a Party is required to submit the names of three (3) candidates for consideration for appointment by the Center as a Panelist (*i.e.*, in accordance with Paragraphs 3(b)(iv), 5(c)(v) and 6(d) of the Rules), that Party shall provide the names and contact details of its three candidates in the order of its

preference. In appointing a Panelist, the Center shall, subject to availability, respect the order of preference indicated by a Party.

(b) **Presiding Panelist**

- (i) The third Panelist appointed in accordance with Paragraph 6(e) of the Rules shall be the Presiding Panelist.
- (ii) Where, under Paragraph 6(e) of the Rules, a Party fails to indicate its order of preference for the Presiding Panelist to the Center, the Center shall nevertheless proceed to appoint the Presiding Panelist.
- (iii) Notwithstanding the procedure provided for in Paragraph 6(e) of the Rules, the Parties may jointly agree on the identity of the Presiding Panelist, in which case they shall notify the Center in writing of such agreement no later than five (5) calendar days after receiving the list of candidates provided for in Paragraph 6(e) of the Rules.

(c) **Respondent Default**

Where the Respondent does not submit a response or does not submit the payment provided for in Paragraph 5(d) of the Rules by the deadline specified by the Center, the Center shall proceed to appoint the Administrative Panel, as follows:

- (i) If the Complainant has designated a single member Administrative Panel, the Center shall appoint the Panelist from its published list;
- (ii) If the Complainant has designated a three member Administrative Panel, the Center shall, subject to availability, appoint one Panelist from the names submitted by the Complainant and shall appoint the second Panelist and the Presiding Panelist from its published list.

## 9. Declaration

In accordance with Paragraph 7 of the Rules, prior to appointment as a Panelist, a candidate shall be required to submit to the Center a Declaration of Independence and Impartiality using the form set out in [Annex C](#) hereto and posted on the Center's web site.

## 10. Fees

The applicable fees for the administrative procedure are specified in [Annex D](#) hereto and posted on the Center's web site.

## 11. Word Limits

- (a) The word limit under Paragraph 3(b)(ix) of the Rules shall be 5,000 words.
- (b) The word limit under Paragraph 5(c)(i) of the Rules shall be 5,000 words.
- (c) For the purposes of Paragraph 15(e) of the Rules, there shall be no word limits.

## **12. File Size and Format Modalities**

- (a) The file size and format modalities under Paragraph 3(b) of the Rules shall be as set forth in **Annex E** hereto and posted on the Center's website.
- (b) The file size and format modalities under Paragraph 5(c) of the Rules shall be set forth in **Annex E** hereto and posted on the Center's website.

## **13. Settlement**

In accordance with Paragraph 17 of the Rules, if before Panel appointment the Parties agree on a settlement, the Parties shall notify the Center, for example by submitting the Standard Settlement Form as set forth in **Annex F** hereto and posted on the Center's website. An email version of the Center's Standard Settlement Form is also available upon request by the Parties.

## **14. Amendments**

Subject to the Policy and Rules, the Center may amend these Supplemental Rules in its sole discretion.

## **15. Exclusion of Liability**

Except in respect of deliberate wrongdoing, an Administrative Panel, the World Intellectual Property Organization and the Center shall not be liable to a party, a concerned registrar or ICANN for any act or omission in connection with the administrative proceeding.



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