WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0")
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 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

### 1.1.2 Relevant decisions

- **F. Hoffmann-La Roche AG v. Relish Enterprises**, WIPO Case No. D2007-1629, <xenicalla.com>, Transfer
- **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 Nhat**, 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
- **Assurances Premium SARL v. Whois Privacy Shield Services / Daisuke Yamaguchi**, WIPO Case No. D2016-1425, <mascotte-assurances.com>, Transfer

### 1.1.3 Relevant decisions

- **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. D2008-0840, <coverkids.com>, 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
- **Greenvelope, LLC v. Virtual Services Corporation**, WIPO Case No. D2017-0006, <greenvelope.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
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

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
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, <celikmotofilo.com> [xn--elikmotofilo-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, <libertyenergtrust.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
1.4 Does a trademark owner’s affiliate or licensee have standing to file a UDRP complaint?

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 RamÃ­rez, WIPO Case No. D2002-0309, <telcelbellsouth.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


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, <boschappliancipro.info> et al., Transfer


Taylor Wimpey Holdings Limited and Taylor Wimpey PLC v. Annette Johnson, Tangerineuk, WIPO Case No. D2016-2116, <taylorwimpey.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


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
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


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

Virgin Enterprises Limited v. Laranjo 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
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**

- *Covance, Inc. and Covance Laboratories Ltd. v. The Covance Campaign*, WIPO Case No. D2004-0206, <covancecampaign.com>, Denied
- *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
- *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
- *Mejeriforeningen Danish Dairy Board v. Cykon Technology Limited*, WIPO Case No. D2010-0776, <lurpa.com>, Transfer
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


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


Hoffmann-La Roche Inc. v. Wei-Chun Hsia, WIPO Case No. D2008-0923, <youtamiflushop.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, <unlimitedwidowdownloads.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

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. ShaheenYounas, WIPO Case No. D2012-1365, <youubeurdu.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
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 interspersion 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
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

Meat and Livestock Commission v. David Pearce aka OTC / The Recipe for BSE, WIPO Case No. D2003-0645, <britishmeat.com> et al., Denied
Asset Loan Co. Pty Ltd v. Gregory Rogers, WIPO Case No. D2006-0300, <assetloanco.net>, 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


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, Automobil 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
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

*WeWork Companies, Inc. v. Michael Chiriac, Various Concepts Inc.*,,
WIPO Case No. D2016-1817, <joinwe.work> et al., Transfer

*Swarovski Aktiengesellschaft v. Aprensa UG haftungsbeschraenkt, Mike Koefler*,
WIPO Verfahren Nr. D2016-2036, <swarovski>, 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, <yahoobeay.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, <dellorossosucks.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, <boehringerelhimsucks.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

The Coca-Cola Company v. Keren, Chen, WIPO Case No. D2008-1852, <קוקהquent.com>, Transfer
EPSON Europe BV v. cinin mehvar, Ali Yousofnia, WIPO Case No. D2010-2037, <دوسپي.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, <ilpiccoloprinipe.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, <mailsong.info>, Transfer
Yahoo! Inc. v. Mr. Omid Pournazar, WIPO Case No. D2012-1612, <فیای.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, <pmcanabis.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

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
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, <my cvs.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


Harpo, Inc. and Oprah’s Farm, LLC v. Robert McDaniel, WIPO Case No. D2013-0585, <oprahsfarm.com> et al., Transfer


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

- **Sanofi-aventis, Aventis Inc. v. Allegra Bonner/Domains By Proxy, Inc.**, WIPO Case No. D2007-1618, <allegrashock.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
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
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, <boschappliancespro.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) Pty 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, <boersen.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

- **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, <maracutiasnapetrobras.com>, Denied
- **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. D2016-1688, <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
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, <oprahsfarm.com> and <oprahsfarm.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, <puravankaraparjects.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


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 (Qld) Pty 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


Estate of Francis Newton Souza v. ZWYX.org Ltd., WIPO Case No. D2007-0221, <fnsouza.com>, Denied


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


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


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, <bmwentiugastclub.com> et al., Transfer
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 Tsyplin,
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

2.8.2 Relevant decisions

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


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, <discountvibramfivelings.com>, Transfer

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

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, <trumplasvegas.com>, Transfer
Paris Hilton v. Deepak Kumar,
WIPO Case No. D2010-1364, <parishiltonheiress.com>, Transfer
Lardi Ltd v. Belize Domain WHOIS Service Ltd,
WIPO Case No. D2010-1437, <larditrans.com>, Transfer
Havanna S.A. v. Brendan High, 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

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


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 yanjiao, 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

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
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, <mobilicom.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, <thefieldcourse.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 Yayincilik ve Iletisim Hizmetleri A.S v. Yenibiris Insan Kaynaklari Hizmetleri Danismanlik ve Yayincilik A.S, WIPO Case No. D2012-2151, <kariyer.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, <cresteurope.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
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


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


Wall-Street.com, LLC v. Marcus Kocak / Internet Opportunity Entertainment (Sports) Limited, 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


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,
cheapphilippiplein, WIPO Case No. D2015-1050, <cheapphilippiplein.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, <richardddunhill.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


*Accor v. WHOIStreasure.com Limited / Domain Administrator, Beyond the Dot LTD*, WIPO Case No. D2015-0279, <novotelqueenstown.kiwi>, Cancellation

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

*Bialetti Industrie S.p.A. v. Onno Brantjes, Stichting Taxacea*, 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


*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 <buyaccutanewithnoprescription.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

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 Altywaijri,*
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 Alkurd,*
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, <رویای.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, <isuteamshop.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, <parsu.com>, Transfer

SODEXO v. Nihat Bahçe, FN Market / Nihat BAHCE, Inmarket,
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, <illusion.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, <yahoo3.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, <oculs Rift.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, <-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, <wikipeadia.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-roycetrade> 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
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


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
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.]

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 the 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
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 Gunn, 
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, <arcelormittal.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, <porsche.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, <americanfunds.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<br>
<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 Chimanz,*
WIPO Case No. D2014-2256, <asda.club>, Transfer

*Volkswagen AG v. Jan-Iver Levsen,*
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*TTT Moneycorp Limited v. Privacy Gods / Privacy Gods Limited,*
WIPO Case No. D2016-1973, <wwwmoneycorp.com>, Transfer
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- **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
- **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, <flextouch.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, <nbcmnews.org>, Transfer
- **ID Group v. Nomi Nee / Aerol Ltd, No Lo / Aerol Ltd**, WIPO Case No. D2012-2469, <jaccadi.com>, 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. Paytotake 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

- **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, <ladbrokespoker.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
- **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, <divx.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, <bhpbillion-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

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**

- *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
- *ALROSA v. Domain Privacy LTD, DNS Admin / The Tidewinds Group, Inc. and Elisa Marina Mendoza Rosa / Whos Privacy Services Pty Ltd, Domain Hostmaster*, WIPO Case No. D2013-0256, <alrosa.com>, Denied
- *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, <www.wired.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, <www.etvnet.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, <d.rmartinshoes.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, <omya.uk.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
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

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
*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
*Pinterest, Inc. v. Pinterest.com c/o Whois Privacy Services Pty Ltd / Ian Townsend*, WIPO Case No. D2015-1873, <pinterest.com>, Transfer
*Dreamlines GmbH v. Darshini 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
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
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
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, Khломoney, 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, <dogruterch.com> and <dogruterch.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 Models [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. WhoIsGuard Protected, Inc./Tom Howe, WIPO Case No. D2014-0159, <y8.net>, Transfer
Angelica Fuentes Téllez v. Domains by Proxy, LLC / Angela Brink, WIPO Case No. D2014-1860, <angelissima.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 Mudjackers and Garwood S. Wilson, Sr.,
WIPO Case No. D2000-1525, <magnumpiering.com> et al., Transfer

Advance Magazine Publishers Inc. v. Marcello Russo,
WIPO Case No. D2001-1049, <vogueaustralia.com>, Transfer

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
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, <franchise.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
Havanna S.A. v. Brendan Hight, Mdnh Inc, WIPO Case No. D2010-1652, <havanna.com>, Denied
Attachmate Corporation v. Domain Administrator / Development Services, MindViews LLC, WIPO Case No. D2013-1622, <filexpress.com>, Transfer
LRG 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.

[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. pxchk1@gmail.com,
WIPO Case No. D2006-1373, <1888vsupremo.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, Inmarket,
WIPO Case No. DCC2015-0002, <sodexo.cc>, Transfer
Titan Enterprises (Odd) Pty Ltd v. Dale Cross / Contact Privacy Inc,
WIPO Case No. D2015-2062, <bewareoftitangarages.com>, Denied
PROCEDURAL SECTION

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, <xenia.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 Dayanıklı 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, <sofitelemail>, 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


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.rarGmbH 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
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, <vanguard.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, <qlilive.net>, Transfer
Lonsdale Sports Limited v. Holger Doelle, WIPO Case No. D2016-1140, <lonsdale.world>, 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:

“All 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 WhoIs-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, <wwwired.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. D2007-0393, <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

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
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 / Comsys 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

- **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 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. Telstra.com /Telecomunicaciones Serafin Rodriguez y Asociados, WIPO Case No. D2003-0247, <telsra.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, <shuuemura.com>, Transfer

Deutsche Messe AG v. Kim Hyungho,
WIPO Case No. D2003-0679, <cebital.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, <mypsace.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. Slikewang, 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**

Delikomat Betriebsverpflegung Gesellschaft m.b.H. v. Alexander Lehner, WIPO Case No. D2001-1447, <delikomat.com>, Transfer

AutoNation Holding Corp. v. Rabea Alawneh, WIPO Case No. D2002-0058, <autoway.com>, Denied


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


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 Alsaidi, WIPO Case No. D2016-0013, <desertforce.com>, Denied

Green Bay Packers v. Moniker etc, WIPO Case No. D2016-1455, <totalpackers.com>, Denied


Sarten Ambalaj San. ve Tic. A.Ş. v. Stanley Pace, WIPO Case No. D2015-1790, <sarten.com>, Denied


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

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
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
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) 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
- 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
- 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
- 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 LeTrieu, Le Trieu Thien, WIPO Case No. D2015-2078, <xomtu.com>, 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
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

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
**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
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, <jacquelinériu.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, <aaaaarbitrations.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. D2016-2526, <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. WhoIs 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, <apple.com> et al., Transfer
Valerie Pharmaceuticals International, Inc. / iNova Pharmaceuticals (Australia) Pty Limited v. Luca Radu / Fundacion Private Whols / 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, <giuseppezanottioutlet.com> et al., Transfer, Dismissed in Part
Wikiimedia Foundation, Inc. v. Domain Administrator, Whois Privacy Services Pty Ltd / Yeongju Hong and Mike Kerry, Dzone Inc., WIPO Case No. D2015-1148, <wikimedia.com> et al., Transfer in Part, Terminated in Part
Mou Limited v. Zeng Xiang / Debra Nelis / Privacy Protection Service Inc. d/b/a PrivacyProtect.org, WIPO Case No. D2016-0759, <moubots-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, <kiehls.cn> 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 WhoIs-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, <myflorrida.com>, Transfer

Société Air France v. Kristin Hirsch, Hirsch Company,
WIPO Case No. D2008-1213, <airfrancesite.info>, Transfer

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
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, <graфф-perfume.com> and <graфф-perfume.net>, 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+thirdpartymark>) 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 throughout.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
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
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
Aussie Car Loans Pty Ltd v. Wilson Accountants Pty Ltd, (formerly Wilson and Wilson Accountants), WIPO Case No. D2009-1477, <aussieautoloans.net> et al., Terminated
Masco Corporation v. Giovanni Laporta, WIPO Case No. D2015-0468, <masco.email>, 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
Saia, Inc. v. Whois Privacy Services Pty Ltd / Damon Nelson – Manager, Quantec, LLC / Novo Point, LLC, WIPO Case No. D2014-1158, <saiamotorfrieght.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（文現）, 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, <allemerivyille.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

- **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 refiling, (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**


Goway Travel Limited v. Tourism Australia, WIPO Case No. D2006-0344, <downunder.travel>, Denied


M. Corentin 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
Obero Inc. v. Domain Manager, eWeb Development Inc., WIPO Case No. D2016-2591, <obero.com>, Denied
Patricks Universal Export Pty Ltd. v. David Greenblatt, WIPO Case No. D2016-0653, <patricks.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. Compania 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
- Tax Analysts v. eCorp, WIPO Case No. D2007-0040, <taxanalyst.com>, Denied
- 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 refilled complaint may be justified. The extent to which any such conditions have been met would bear on determining whether a refilled 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


*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


*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, <gegeneralelectric.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


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
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
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), 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

### 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