

UDRP and ACPA: Weapons of War

All businesses, whether dealing in goods or services, should have an Internet presence. However, it is no longer sufficient to have just a single domain name related to such a business. Today the typical business has multiple domain names that divert Internet traffic among the network of the company's domain names. This feeding frenzy allows a consumer to purchase the offered goods or services quickly, and almost thoughtlessly, as a way of enhancing the quality of the consumer's life. However, businesses that are gobbling up domain names should beware! Selection of the wrong domain name could be costly and disruptive to even the best business plan.



Unfortunately, it is the owners of domain names who operate in bad faith who have forced lexicographers to develop terms such as "cybersquatters" and "typosquatters." It is these ill-intentioned, evil creatures who abuse domain names and generate profit by selling the domain names at exorbitant prices, setting up pay-per-click advertisements on their Web sites, or unlawfully obtaining and using private information in scams. Many consumers of goods or services who have experienced the sting of identity theft or the frustration of Web site diversions when earnestly attempting to make a purchase via the Internet wrongfully blame the brand owner for such annoying results. As a result, the owner of the trademark(s) associated with such goods or services frequently lose a customer.



The good news for the trademark owners is that they have numerous swords with which to inflict fatal blows on those who abuse domain names. Independent of good old-fashioned litigation, a trademark owner may initiate a Uniform Dispute Resolution Policy (UDRP) proceeding by filing a complaint with dispute resolution provider who has been approved by the Internet Corporation for Assigned Names and Numbers. Typically, the result of such a proceeding flows from the consideration of the complaint and the response from the registrant of the domain name, if any. The remedies of the UDRP proceeding may include cancellation of the domain name

or transfer of the domain name to the complainant.

Briefly, in order for a complainant to prevail, UDRP rules permit the cancellation or transfer of a domain name that is the subject of the complaint if (1) the domain name is identical or confusingly similar to the complainant's mark, (2) the owner of the domain name has no rights or no legitimate interest in the domain name, and (3) the domain name was registered and is being used in bad faith. An example of a situation giving rise to the cancellation or transfer of a domain name includes a circumstance showing that the domain name was registered primarily to be sold to the complainant, or to a competitor of the complainant, for an amount of money in excess of the cost required for registering the domain name. Other obvious examples include circumstances showing that the domain name was registered to prevent the owner of the mark from using it in a corresponding domain name when the registrant has engaged in a pattern of such conduct or that the registrant has intentionally used the domain name to attract Internet traffic for commercial gain, such traffic being driven by the creation of a likelihood of confusion with the complainant's mark. A UDRP proceeding is a powerful weapon for a trademark owner to use to force the transfer of a domain name from a person who has been using the name to divert business away from the trademark owner, to dilute the owner's mark, or to tarnish the mark.

An additional sword at the disposal of the trademark owner is the Anti-Cybersquatting Consumer Protection Act (ACPA), which prohibits the use of a confusingly similar mark in a way that is likely to cause confusion regarding the source or sponsorship of the goods or services with which the mark is used. Under the ACPA, a person is liable to the trademark owner if the person has a bad faith intent to profit from the mark and registers, traffics in, or uses a domain name that is either identical or confusingly similar to a distinctive mark or is identical, confusingly similar, or dilutive of a famous mark. In determining whether a person has a bad faith intent, a court may consider a host of factors, such as the person's use of the domain name in connection with the bona fide offering of any goods or services, or lack thereof, or the existence of a person's portfolio of multiple domain names that the person knows are identical or confusingly similar to marks of others at the time of registration of those domain names.

Obviously, as with any litigation, the process in-

volved in such cases is fact-driven. However, a current advantage for the trademark owner is that obtaining such facts is now easier than ever before as a result of Internet “sleuthing” tools, such as Domain Tools, which provides reports related to the portfolio of domain names that may be owned by a person. Such tools may not offer the best solution, however, because the use of privacy or proxy registration services may shield the identity of a more sophisticated registrant.

The swords discussed above are sharpened for use against those who abuse domain names, but regis-

trants of legitimate domain names should become familiar with these weapons so that they don’t inadvertently receive the painful blow they are designed to inflict. **TFL**

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as well as the use of technology to ensure the continuance of participatory governance.

Legislative Issues To Be Monitored

- Support the federal judiciary consistent with and in implementation of resolutions previously adopted by the Federal Bar Association, including support for:
 - Adequate funding for the general and continuing operations of the federal courts, including an equitable level of rent and facilities expense consistent with actual costs, budgetary constraints, staffing needs and security considerations, to permit the courts to fulfill their constitutional and statutory responsibilities;
 - Development of strategies to reduce the time required to fill federal judicial vacancies; and
 - Expansion of and enhanced federal funding for continuing legal education and training programs for the federal judiciary.
- Advocate strict scrutiny of legislation proposing to grant original jurisdiction to federal authorities over crimes traditionally reserved to state and local prosecution.
- Oppose the division of the Ninth Circuit Court of Appeals, consistent with its capacity to effectively

and efficiently render justice.

- Encourage and contribute to a discussion of the competing considerations vis-à-vis proposed legislation which would authorize federal judges, in their discretion, to permit photographing, electronic recording, broadcasting, and televising of federal court proceedings in appropriate circumstances.
- Address proposals to amend the Uniform Code of Military Justice and to make changes to the military justice system.
- Oppose proposed “user fees” in Social Security and SSI cases, consistent with and in implementation of resolutions previously adopted by the FBA.
- Support efforts to assure the continued use and independence of administrative law judges in the adjudication of Medicare benefit appeals.
- Support the aims of the Indian Child Welfare Act to protect American Indian and Alaska Native families by recognizing the importance of tribal authority, culture and tradition in decision-making for children subject to the Act. **TFL**

Bruce Moyer is government relations counsel for the FBA. An “Issues Agenda Spotlight” will be included in future issues and will feature updates and new items.

Eighth Annual Washington, D.C./Baltimore Public Service Career Fair **Presented by the Federal Bar Association**

It is with great pleasure that we invite you to participate in the eighth annual Washington, D.C./Baltimore Public Service Career Fair!

Last year’s event brought more than 75 employers and 400 students together through interviews, table talk sessions, and résumé collections to meet and discuss public interest and government opportunities in the Washington, D.C., area.

There are six participating law schools with more than 5,000 J.D. students, many of whom are interested in working in federal careers!

Registration for employers will begin October 15 online at <https://law-dcpscf-csm.symplicity.com/employers>. For questions or to be added to a mailing list for additional information and/or registration reminders, please e-mail Laurie Neff at lneff@gmu.edu.

Friday, January 29, 2010

9:30 a.m.–4:30 p.m.

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