

24 The WIPO Domain Name Dispute Resolution System

The World Intellectual Property Organization (WIPO) has already been considered in relation to arbitration and mediation in earlier chapters of the Manual. Here, a closer look is taken at WIPO and its specialist system relating to domain names.

1) Introduction

WIPO is an international organisation *“dedicated to promoting the use and protection of works of the human spirit. These works – intellectual property – are expanding the bounds of science and technology and enriching the world of the arts. Through its work, WIPO plays an important role in enhancing the quality and enjoyment of life, as well as creating real wealth for nations.”*

WIPO, which has its headquarters in Geneva, Switzerland, is one of the 16 specialised agencies of the United Nations. It administers 23 international treaties dealing with different aspects of intellectual property protection and has 180 nations – over 90 per cent of the world’s countries – as member States.

There are more than 900 WIPO staff, who are drawn from around the world. The tasks carried out by WIPO in relation to the protection of intellectual property rights include *“administering international treaties, assisting governments, organizations and the private sector, monitoring developments in the field and harmonizing and simplifying relevant rules and practices. In all that it does, the key words are relevance, efficiency, communication and international cooperation.”*

In the view of WIPO, there is a vital need for

“... quick and inexpensive ways of settling commercial disputes involving intellectual property rights, and providing private parties with an alternative to often lengthy and costly court proceedings. This need has increased in recent years with the growing importance of international trade. WIPO’s Arbitration and Mediation Center helps to meet those needs for companies and individuals anywhere in the world. The Center maintains an extensive list of specialized mediators or arbitrators from over 100 countries, who conduct dispute resolution procedures according to rules made available by WIPO. The procedures may take place in any country, in any language, and under any law, allowing a great deal of flexibility. Indeed, because they are cost-effective, the WIPO procedures are particularly interesting for companies that are unable or unwilling to enter into expensive or protracted litigation, especially at the international level. The subject matter of disputes resolved by means of WIPO procedures has included both contractual (e.g. patent and software licenses, trademark coexistence agreements, distribution agreements for pharmaceutical products and research and development agreements) and non-contractual disputes (e.g. patent infringement).”

Turning to the specific problem of 'cybersquatting', WIPO states that the Center "*is the leading dispute resolution service provider for challenges related to abusive registration and use of Internet domain names, commonly known as 'cybersquatting'. In 2003, the Center received 5,722 cases under the Uniform Domain Name Dispute Resolution Policy (UDRP) and similar procedures, involving parties from 116 countries. In addition, some 15,510 domain name cases were decided under special procedures. The Center provides this service both for the generic top-level domains, such as .com, .net, .org, .info, and for certain country-code domains. Trademark owners can file complaints using model documents made available on the Center's website. The entire procedure is conducted on-line, resulting in enforceable decisions within two months.*"

The Center's IT case facilities allow the parties involved "*to communicate via the Internet without being physically present in the same place, greatly reducing the time and cost of reaching a settlement. Using such expertise, the Center also assists in the design of tailor-made dispute avoidance and resolution procedures upon demand, for example in the area of information technology.*"

In addition to dealing with the abusive use of trademark rights in domain names, WIPO also deals with other types of cybersquatting, including the use of personal names, international non-proprietary names for pharmaceutical substances and the names of intergovernmental organisations.

Full details of WIPO's services are available on its website.¹¹⁶

2) The Policy and Rules

There are three matters to be considered when looking at the Domain Name Dispute Resolution system operated by WIPO:

- i) the Internet Corporation for Assigned Names and Numbers (ICANN) Uniform Domain Name Dispute Resolution Policy (UDRP); the ICANN Policy;*
- ii) the ICANN Rules for UDRP; and*
- iii) the WIPO Supplemental Rules for UDRP.*

Before looking at the Policy and the two sets of Rules, however, it may be useful to describe briefly how the WIPO system works.

The process is aimed at the problem of 'cybersquatting': the registration of a domain name similar to an established corporation's well-known trademark, often with the intention of either selling the domain name to the corporation at an excessive price or of disrupting that corporation's business. One of the great benefits of the scheme is that the system of registering domain names incorporates within itself a dispute resolution procedure.

Under that procedure a Complainant must show:

- 1 that the domain name registered is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;

- 2 that the Respondent who registered the domain name has no rights or legitimate interest in that name; and
- 3 that the name was registered and is being used in bad faith.

Where a complaint made under the WIPO system is upheld, the WIPO Panel may either order the cancellation of the domain name or order the transfer of that domain name to the Complainant.

i) The ICANN UDRP Policy

The UDRP Policy sets out the legal framework for the resolution of disputes between a domain name registrant and a third party in relation to the abusive registration and use of an Internet domain name. At its meetings in August 1999 in Santiago, Chile, the ICANN Board of Directors adopted the UDRP Policy, based largely on the recommendations of a WIPO Report. All ICANN-accredited registrars who are authorised to register names in the .com, .net, .org, .biz, .info and .name generic top level domains (gTLDs) have adopted the UDRP Policy and have agreed to abide by it. Any person or entity wishing to register a domain name in the gTLDs and country code top level domains (ccTLDs) is required to consent to the terms and conditions of the UDRP Policy, which contains a dispute resolution procedure and the machinery to enforce its decisions.

The Notes to the Policy state that it is between the registrar and its customer (the domain-name holder or registrant) and therefore the policy uses 'we' and 'our' to refer to the registrar and 'you' and 'your' to refer to the domain-name holder.

Paragraph 1

Paragraph 1 of the Policy states that the Policy is incorporated by reference:

"into your Registration Agreement, and sets forth the terms and conditions in connection with a dispute between you and any party other than us (the registrar) over the registration and use of an Internet domain name registered by you. Proceedings under Paragraph 4 of this Policy will be conducted according to the Rules for Uniform Domain Name Dispute Resolution Policy (the 'Rules of Procedure')... and the selected administrative-dispute-resolution service provider's supplemental rules."

Paragraph 2

Paragraph 2 deals with representations. By applying to register a domain name, the applicant represents that:

- (a) the statements that you made in your Registration Agreement are complete and accurate;*
- (b) to your knowledge, the registration of the domain name will not infringe upon or otherwise violate the rights of any third party;*
- (c) you are not registering the domain name for an unlawful purpose; and*
- (d) you will not knowingly use the domain name in violation of any applicable laws or regulations. It is your responsibility to determine whether your domain name registration infringes or violates someone else's rights."*

Paragraph 3

The circumstances in which cancellations, transfers and changes will be made are set out in Paragraph 3 and include:

- "b. our receipt of an order from a court or arbitral tribunal, in each case of competent jurisdiction, requiring such action; and/or*
- c. our receipt of a decision of an Administrative Panel requiring such action in any administrative proceeding to which you were a party and which was conducted under this Policy or a later version of this Policy adopted by ICANN."*

Paragraph 4

Paragraph 4 is at the heart of the Domain Name Dispute Resolution process. It deals with the three elements mentioned above that are essential in a cybersquatting case and contains the remedies.

Paragraph 4 (a) sets out the type of disputes in relation to which the domain name holder is required to submit to a *"mandatory administrative proceeding"* before one of the *"administrative-dispute-resolution service providers"*:

- "a. Applicable Disputes. You are required to submit to a mandatory administrative proceeding in the event that a third party (a 'complainant') asserts to the applicable Provider, in compliance with the Rules of Procedure, that*
 - (i) your domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and*
 - (ii) you have no rights or legitimate interests in respect of the domain name; and*
 - (iii) your domain name has been registered and is being used in bad faith.*
- In the administrative proceeding, the complainant must prove that each of these three elements are present."*

The burden of proving each of the three elements is therefore on the Complainant.

Evidence of the 'registration and use in bad faith' element of Paragraph 4 (a) (iii) is indicated in Paragraph 4 (b):

"For the purposes of Paragraph 4 (a) (iii) the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- (i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or*
- (ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or*
- (iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or*

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location."

Paragraph 4 (c) sets out how the domain-name holder can demonstrate the Paragraph 4 (a) (ii) element of rights or legitimate interests:

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

- (i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or*
- (ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or*
- (iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue."*

Paragraph 4 (d) deals with selection of a Provider and 4 (e) with the initiation of proceedings: *"The Rules of Procedure state the process for initiating and conducting a proceeding and for appointing the panel that will decide the dispute (the 'Administrative Panel')."*

Paragraph 4 (f) contains provisions dealing with consolidation.

The important provisions relating to remedies are contained in Paragraph 4 (i): *"the remedies available to a complainant pursuant to any proceeding before an Administrative Panel shall be limited to requiring the cancellation of your domain name or the transfer of your domain name registration to the complainant."*

Paragraphs 5 and 6

Paragraph 5 deals with other disputes and litigation concerning the domain name that do not involve the registrar, and Paragraph 6 states that the registrar will not participate in any dispute between the domain name holder and any other party.

Paragraphs 7 and 8

Paragraphs 7 and 8 deal with the status of the domain name. The registrar will not cancel, transfer, activate, deactivate or otherwise change the status of any domain name registration save in accordance with the Paragraph 3 provisions dealing with cancellations and transfers (Paragraph 7). Paragraph 8 covers the transfer of a domain name to another holder or to another registrar during a dispute.

Paragraph 9

Paragraph 9 deals with modifications to the Policy: the registrar may modify the Policy at any time, but only with the permission of ICANN.

ii) *The ICANN Rules*

In October 1999 the ICANN Board adopted a set of Rules for UDRP. These Rules set out the procedures and other requirements for each stage of the dispute resolution administrative procedure. The procedure is administered by dispute resolution service providers accredited by ICANN, one of which is the WIPO Arbitration and Mediation Center.

Rule 1

Rule 1 sets out a series of definitions, which include:

- *Complainant*: the party initiating a complaint concerning a domain-name registration.
- *Respondent*: the holder of a domain-name registration against which the complaint is initiated.
- *Panel*: an administrative panel appointed by a Provider.
- *Provider*: a dispute-resolution service provider, approved by ICANN.
- *Registrar*: the entity with which the Respondent registered the domain name that is the subject of a complaint.
- *Registration Agreement*: the agreement between a Registrar and a domain-name holder (which agreement will incorporate by reference the UDRP Policy).
- *Reverse Domain Name Hijacking*: means "using the Policy in bad faith to attempt to deprive a registered domain-name holder of a domain name".
- *Mutual Jurisdiction*: means " a court jurisdiction at the location of either (a) the principal office of the Registrar... or (b) the domain-name holder's address as shown for the registration of the domain name in Registrar's Whois¹¹⁷ database at the time the complaint is submitted to the Provider."

Rule 2

This Rule deals with Communications.

Rules 3 and 4

Rules 3 and 4 concern the Complaint, which initiates the proceedings. Rule 3 states that it is to be submitted in hardcopy and in electronic form. The Complaint is to:

- state whether the Complainant elects to have the dispute decided by a single-member or a three-member Panel (and if three, providing three names that may be drawn from an ICANN-approved Providers' list);
- specify the domain name in question;

¹¹⁷ Whois (or WHOIS) is an Internet utility through which information can be obtained about the ownership of domain names.

- specify the trademark or service mark on which the complaint is based;
- describe the grounds in the Policy that are relied on: i.e. the three elements of Paragraph 4 (a) of the Policy (identical or confusingly similar / no rights or legitimate interests / bad faith);
- specify the remedies sought;
- annex any documentary or other evidence, including a copy of the Policy applicable to the domain name(s) in dispute and any trademark or service mark registration on which the complaint relies.

Notification of the Complaint by the Provider to the Respondent is dealt with in Rule 4.

Rule 5

Rule 5 deals with the Response form. The Response is to:

- respond specifically to the Complaint;
- deal with the constitution of the panel;
- annex any documentary or other evidence.

Rule 6

This Rule deals with the appointment of the panel. There will be a single Panellist unless the Complainant or the Respondent has elected for a three-member panel.

Rule 7

Impartiality and independence is dealt with in Rule 7: *“A Panelist shall be impartial and independent and shall have, before accepting appointment, disclosed to the Provider any circumstances giving rise to justifiable doubt as to the Panelist’s impartiality or independence. If, at any stage during the administrative proceeding, new circumstances arise that could give rise to justifiable doubt as to the impartiality or independence of the Panelist, that Panelist shall promptly disclose such circumstances to the Provider. In such event, the Provider shall have the discretion to appoint a substitute Panelist.”*

Rules 8 and 9

Rules 8 and 9 deal with communications between the parties and the Panel and the transmission of the file to the Panel.

Rule 10

The general powers of the Panel are set out in Rule 10. The Panel is to conduct the administrative proceedings in such manner as it considers appropriate, but in accordance with the Policy and Rules. The Panel is to ensure that *“the Parties are treated with equality and that each Party is given a fair opportunity to present its case”*. The administrative proceeding is to take place with due expedition. It is for the Panel to determine the admissibility, relevance, materiality and weight of the evidence. The Panel has the power to consolidate multiple domain name disputes.

Rule 11

Rule 11 states that the language of the administrative proceeding is the language of the Registration Agreement, but with power given to the Panel to determine otherwise.

Rule 12

Under Rule 12, the Panel may request further statements or documents from the parties.

Rule 13

Rule 13 contains provisions that are essential to the speed and cost-effectiveness of online dispute resolution:

“There shall be no in-person hearings (including hearings by teleconference, videoconference, and web conference), unless the Panel determines, in its sole discretion and as an exceptional matter, that such a hearing is necessary for deciding the complaint.”

Rules 14 and 15

Default provisions are set out in Rule 14. The Panel is to decide a complaint on the basis of *“the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable”*.

The decision of the panel is to be forwarded to the Provider within 14 days of the appointment of the Panel. The decision is to be in writing and to set out the reasons on which is based. In the case of a three-member panel the decision is by majority. Dissenting opinions are to accompany the majority decision. If 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”* (Rule 15).

Rules 16 and 17

Rule 16 deals with the communication of the decision and Rule 17 with settlement or other grounds for termination. Where legal proceedings are initiated prior to or during an administrative proceeding, the Panel has a discretion whether to suspend or terminate the administrative proceeding or to proceed to a decision.

Rules 19, 20 and 21

These Rules deal with fees, exclusion of liability and amendments to the Rules.

iii) The WIPO Supplemental Rules [level 3]

There are 12 WIPO Supplemental Rules containing the machinery for dealing with a WIPO domain name dispute complaint. Rule 1 states that the Supplemental Rules are to be read in conjunction with the ICANN Rules and Rule 2 provides that terms used in the Supplemental Rules have the same meaning as in the ICANN Rules.

Communications are dealt with in Rule 3 and the submission of a Complaint in Rule 4. Rule 5 deals with Formalities Compliance Review. The WIPO Center is to review the Complaint for compliance with the formal requirements of the Policy, the ICANN Rules and the WIPO Supplemental Rules.

A Case Administrator is to be appointed – a member of the Center’s staff who will deal with administrative matters (Rule 6). The procedure for the appointment of panellists, and the Presiding Panellist where a three-member panel is requested is set out in Rule 7. Candidates appointed are required to submit a declaration of independence and impartiality (Rule 8)

Rule 9 deals with fees and Rule 10 with word limits: 5,000 words for the Complaint and the Response but no limit for the Panel decision.

Rules 11 and 12 deal with amendments and exclusion of liability.

3) WIPO Decisions

The WIPO Domain Name Dispute Resolution service has operated with considerable success. Since the UDRP went into effect in December 1999, WIPO’s Arbitration and Mediation Center has handled over 8,350 disputes, involving parties from 127 countries and covering some 16,000 domain names.¹¹⁸

A total of 1,456 cybersquatting cases were filed with the WIPO Center in 2005, a 20 per cent increase as compared to 2004. This increase represents the highest number of cybersquatting cases handled by the Center since 2001.

The pattern of many of the cases involves the abusive registration of a domain name with the intention of benefiting financially, usually by offering to sell a domain name that is identical to or similar to a well-known trademark or service mark. Alternatively, the abusive registration may be aimed at the disruption of a well-established corporation or other business organisation.

One example of a WIPO Decision relates to an oil company: *Statoil ASA v Magne Espelund*, where the domain names statoil-gas.com and statoilgas.com were in dispute (see Box 11).

118 The WIPO Center’s online index of WIPO UDRP Decisions (<http://arbiter.wipo.int/cgi-bin/domains/search/legalindex>) allows for an extensive search on legal and procedural issues under the UDRP.

Box 11: Administrative Panel Decision in *Statoil ASA v Magne Espelund*

1. The Parties

The Complainant was Statoil ASA of Sweden, represented by Cogent IPC AB of Sweden. The Respondent was Magne Espelund of Norway.

2. The Domain Names and Registrar

The disputed domain names were statoil-gas.com and statoilgas.com. The domain names at issue were registered with Capital Networks Pty Ltd dba.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center on 10 February 2003. On 12 February 2003, the Center emailed a request to Capital Networks Pty Ltd dba TotalNIC.net for registrar verification in connection with the domain names at issue. On date of registrar verification, Capital Networks Pty Ltd. dba TotalNIC.net emailed its verification response confirming that the Respondent was listed as the registrant and providing the contact details for the administrative, billing and technical contact. The Center verified that the Complaint satisfied the formal requirements of the UDRP, the ICANN Rules and the WIPO Supplemental Rules.

The Center formally notified the Respondent of the Complaint and the proceedings commenced on 4 March 2003. In accordance with the Rules, the due date for Response was 24 March 2003. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on 25 March 2003.

The Center appointed Peter G Nitter as the Sole Panellist on 4 April 2003.

4. Factual background

The Complainant is an oil and gas company founded in 1972, with thousands of employees in 25 countries, and is among the leading suppliers of gas to the European market. Statoil complained that the domain names were virtually identical to its trademark 'STATOIL'. The addition of the suffix 'gas' strengthened the impression that the domain names belonged to the Complainant and were therefore confusingly similar. The Respondent did not reply to Statoil's contentions.

5. Decision

The Panel found (i) that the Respondent had no rights or legitimate interest in the contested domain names; (ii) that the domain name were confusingly similar; and (iii) that there was evidence that there had been offers to sell the domain names to the Complainant for an amount considerably in excess of the Respondent's out-of-pocket costs. This indicated bad faith. The Panel ordered that the domain names be transferred to the Complainant.

Source: The WIPO Internet report of the case (No. D2003-0097);
<http://arbitr.wipo.int/domains/decisions/html/2003/d2003-0097.html>

Another example, the case of *PepsiCo, Inc. v Henry Chan*, shows the potential dangers of cybersquatting to long-established businesses and their trademarks (see Box 12). The case also shows that cybersquatting is itself a large-scale business.

In all a total of 10 domain names were registered by the Respondent. The Complainant was the owner of the 'PEPSI' and 'MOUNTAIN DEW' trademarks marks and other trademarks and domain names incorporating those two marks. The Claimant contended that the Respondent had registered some 25,000 domain names.

Box 12: Administrative Panel Decision in *PepsiCo, Inc. v Henry Chan*

1. The Parties

The Complainant was PepsiCo, Inc., New York, USA. The Respondent was Henry Chan of Nassau, Bahamas.

2. The Domain Names and Registrar

The Domain Names in dispute were set out in the Complaint of 15 January 2004. At that stage these comprised the following: thepepsichart.com, pepsimusic.com, pepsiearena.com, pepsisweep.com, pepsinfl.com, pepsicoliseum.com and montaindew.com. All the domain names were registered with iHoldings.comInc.d/b/a dotregistrar.com.

A further disputed domain name was added by amendment to the Amended Complaint of 5 February 2004, namely pepsicollection.com. That domain name was registered with the same registrar. Two further disputed domain names were added by re-amendment to the Re-Amended Complaint dated 25 March 2004, namely pepsicareer.com and pepsidownloads.com. Again, those domain names were registered with the same registrar.

3. Procedural History

The Complaint and annexes were filed with the Center on 16 January 2004. On 19 March 2004, the Center appointed Anthony R Connerty as Sole Panellist. No Response was filed by the Respondent.

4. Factual Background

The Complainant is the owner of the PEPSI and MOUNTAIN DEW marks and other trademarks and domain name incorporating those two marks. The Complainant said that for more than a century the PEPSI-COLA name and mark (and its shortened version, PEPSI) have been continuously used. The Complainant's brands of soft drinks are currently sold in most countries of the world, including the Bahamas.

Recognition of the significance of the PEPSI mark was indicated by two earlier WIPO cases that were relied on in this respect by the Complainant: *PepsiCo, Inc., v Diabetes Home Care, Inc*, WIPO Case No. D 2001 -0174 ("one of the world's most famous" marks) and *PepsiCo, Inc. v "null" aka Alexander Zavoronkov*, WIPO Case No.D 2002 -0562 (a "universally recognised" mark).

The PEPSI mark was first used in North Carolina in 1898. The PEPSI brand has been valued at over US\$11 billion. The Complainant owns over 100 registrations in the

USA of the PEPSI mark and variants and has at least a dozen PEPSI-variant marks registered in the Bahamas. The Complainants' expenditure on global advertising since 1991 on the PEPSI mark has exceeded US\$200 million a year.

The MOUNTAIN DEW name was first registered by the Hartman Beverage Company of Knoxville, Tennessee and was subsequently acquired by PepsiCo, Inc. in 1964. It has since been marketed continuously for almost 40 years. By the mid-1980s, the sale of Mountain Dew products in countries outside the United States exceeded 9,450 million cases. One valuation puts Mountain Dew as the fourth most valuable brand in the United States.

Numerous Internet domain names for active websites based on the PEPSI and MOUNTAIN DEW marks have been continuously owned and used by the Complainant.

Confusingly Similar

The Complainant submitted that the disputed domain names were nearly identical or confusingly similar to the PEPSI mark, and the addition of common terms such as 'chart', 'collection', 'career' and 'download' was of no relevance.

The Complainant relied on a number of previous WIPO decisions in support of its contention:

- *Sony Kabushiki Kaisha v Kil Inja*, WIPO Case No. D 2000-1409 (addition of descriptive word to a world-famous mark does not detract from the overall impression of the famous mark),
- *America Online, Inc v Chris Hoffman*, WIPO Case No. D 2001-1184 (use of short phrases with a well-known mark is still confusingly similar),
- *Chernow Communications, Inc. v Jonathan D Kimball*, WIPO Case No. D 2001-0119 ("... the use or absence of punctuation marks, such as hyphens, does not alter the fact that a name is identical to a mark").

In relation to the use of misspelled variations of the PEPSI and MOUNTAIN DEW marks, the Complainant relied on one of the 'typo-squatting' or 'typo-piracy' cases: *Ultimate Electronics, Inc v Phayze, Inc*, WIPO Case No. D 2002-085.

Further, the Complainant argued that the unique character of the Pepsi and Mountain Dew marks would lead consumers to readily believe that the Domain Names were related to the Complainant.

Registered and Used in Bad Faith

The Complainant contended that the Respondent's bad faith registration and use was established by the fact that the Respondent was using the domain names to divert web traffic to search engines and linking portals that provided links to websites used for gambling, music and movie downloads and tickets for sporting events, none of which were related to the Complainant. These offered a revenue programme that paid domain name owners for diverted traffic 50 per cent of all revenues generated from searches, pop-ups, exit pop-ups and the like.

In addition, the Complainant relied on the Respondent's "pattern of registering domain names containing the trademark and names of third parties and then using those domain names to direct web traffic to websites from which he derives financial benefit".

The Complainant stated that the Respondent had been found to have registered and used domain names in bad faith by at least five administrative panels. The Complainant referred to a number of WIPO and National Arbitration Forum (NAF) cases in which the Respondent had registered domain names (including 'typo' domain names) so as to direct web traffic to websites from which he derived a financial benefit.

Next, the Complainant relied on the fact that the Respondent owned in excess of 25,000 domain names, many of which were based on third party names and marks, including a number of 'typo' domain names. Examples included newharrypotter.com, disneycredit.com, citibankdirect.com and saksfifthavenue.com.

Bad faith was also demonstrated, the Complainant said, by the Respondent's pattern of using multiple addresses for his domain name registrations, including addresses in Hong Kong and the Bahamas.

5. Decision

The Panel ordered that the 10 domain names be transferred to PepsiCo.

Source: The WIPO Internet report of the case (No. D2004-0033):
<http://arbitrator.wipo.int/domains/decisions/html/2004/d2004-0033.html>.

The victims of cybersquatting are not only international commercial corporations. Individuals have also been the targets. One example is the film actress Julia Roberts. In the case of *Julia Fiona Roberts v Russell Boyd*, the Respondent put the domain name in question up for auction on the commercial website eBay. This case is an example of a three-member WIPO Administrative Panel (see Box 13).

Box 13: Administrative Panel Decision in *Julia Fiona Roberts v Russell Boyd*

1. The Parties

The Claimant was Julia Fiona Roberts, a United States citizen. The Respondent was Russell Boyd, a United States citizen.

2. The Domain Name and Registrar

The domain name at issue was juliaroberts.com. The registrar was Network Solutions, Inc. (the 'Registrar'), USA.

3. Procedural History

The Center received the Complaint on 25 March 2000. Having verified that the Complaint satisfied the formal requirements of the Policy, the Rules and the

Supplemental Rules, the Center on 29 March 2000 sent the Respondent a notification of the administrative proceeding together with copies of the Complaint.

In correspondence with the Center, the Respondent requested and was granted an extension of time to file his Response. On 8 May 2000, the Center received the Response. On 18 May 2000 the Center notified the parties of the appointment of a three-member Administrative Panel consisting of Mr Richard W Page as the Presiding Panellist, Ms Sally M Abel as Complainant's party-appointed panellist and Mr James Bridgeman as Respondent's party-appointed panellist.

On 8 and 9 May 2000, Complainant tendered a Reply by fax and email. The acceptance of a Reply is subject to the discretion of the Panel. The Panel met by telephone conference call on 25 May 2000 and decided not to accept or consider Complainant's Reply.

4. Factual Background

The Complainant, Julia Fiona Roberts, is a famous motion picture actress. She has appeared in numerous movies including *Erin Brockovich*, *Notting Hill*, *Runaway Bride*, *My Best Friend's Wedding*, *Everyone Says I Love You*, *The Pelican Brief*, *The Player*, *Hook*, *Sleeping With the Enemy*, *Flatliners* and *Pretty Woman*. She has earned two Academy Award nominations.

Respondent registered the subject domain name on 9 November 1998. As of 24 March 2000, the website www.juliaroberts.com featured a photograph of a woman named 'Sari Locker'. The Respondent had placed the domain name up for auction on the commercial auction website, eBay, specifically at <http://cgi.ebay.com/aw-cgi/eBayISAPI.dll?ViewItem&item=285891617>.

The Respondent had also registered over 50 other domain names, including some incorporating other movie stars names, for example, madeleineinestowe.com and alpacino.com, and a famous Russian gymnast's name: elenaprodunova.com. Respondent listed his email address as mickjagger@home.com. Respondent was offered US\$2,550 in the eBay auction for the domain name registration.

Bad Faith

Paragraph 4 of the Policy provides that evidence of bad faith registration and use includes circumstances showing:

(ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct.

The Respondent admitted that he had registered other domain names including several famous movie and sports stars. Such actions necessarily prevented Complainant from using the disputed domain name and demonstrated a pattern of such conduct. Therefore, the Panel found that Respondent had registered and used the domain name juliaroberts.com in bad faith and that the requirement of the Policy paragraph 4 (a) (iii) was satisfied.

In addition, the Respondent had placed the domain name up for auction on the commercial website eBay. When considered in conjunction with the pattern of

registrations described above, the Panel found that such action constituted additional evidence of bad faith.

5. Decision

The Administrative Panel's decision was (a) that the domain name juliaroberts.com was identical to Complainant's common law trademark in her name 'Julia Roberts,' (b) that Respondent had no rights or legitimate interest in the domain name and (c) that Respondent registered and used the domain name in bad faith. Therefore the Panel ordered that the domain name juliaroberts.com be transferred to Complainant Julia Fiona Roberts.

Source: The WIPO Internet report of the case (No. D2000-0210):
<http://arbiter.wipo.int/domains/decisions/html/2000/d2000-0210.html>.

This brief look at some of the Decisions illustrates the nature of the WIPO process. The number of such Decisions since the start of the Scheme shows the very considerable success of the WIPO Domain Name system.