



ICANN CAN!

By: James B. Astrachan

Yes! I just filed my first Complaint under the new Uniform Domain Name Dispute Resolution Policy. According to the policy sponsor, the Internet Corporation for Assigned Names and Numbers ("ICANN"), the process should take about sixty days from start to finish. It's a little like ordering a new car and savoring the expectation of delivery.

The old domain name dispute resolution policy was a lot like eating Chinese food. A short time after the process starts, the results are not satisfying. District Court litigation is certainly an option, but its expensive and time consuming.

ICANN's new policy looks like a real winner where the infringement is clear, but it is not so certain to be effective where the infringement is questionable. In our case, our client is a manufacturer of motor yachts and its registered trademark, in use since 1964, was registered as a ".org" domain name by someone whom our investigation reveals appears to have no valid claims to the mark.

We wrote to the registrant of our client's mark and told him we believed he was an infringer and asked that he voluntarily transfer the domain name to our client. We figured that at this stage, if a valid use existed, the registrant would indignantly tell us. This response was indignant, but there was no justification for his use. So the Complaint was filed.

The ICANN Policy is supported by rules. ICANN has appointed a number of Providers to actually resolve these disputes, and each Provider has created its own supplemental rules which are generally procedural.

The Providers have no power to award monetary damages, but they can order a domain name registrar, such as Internic, to cancel, transfer or change a domain name registration. In our case, we asked that the Provider order Internic to transfer the offending domain name to our client should the Complaint be decided in our favor.

Registrants of domain names have generally agreed to adhere to the Policy as a condition of registration, and the Policy requires registrants to submit to a mandatory administrative proceeding.

The ball is kicked-off with the filing of a Complaint and service of a copy on the Registrant and the Provider. A fee of \$750 for a one-person panel is paid, but a Complainant can elect a three person panel, likely a wise decision where the infringement is less clear.

To be successful, the Complainant must prove that its domain name is identical (ours is) or confusingly similar to the Complainant's mark; that the Respondent has no rights or legitimate interests in the domain name and that the domain name has been registered and used in bad faith.

The Policy also provides a non-inclusive list of circumstances that will evidence a Respondent's bad faith. They are: circumstances that tend to show that the domain name was registered so it could later be sold to the rightful owner of the mark or a competitor; engagement in a pattern of behavior that would indicate that the Respondent is attempting to deny the owner of a trademark use of the mark in a domain name to disrupt the owner's business; registration of the domain name to disrupt the submission of a competitor; or use of the domain name to lure Internet

users to the Respondent's website by creating a likelihood of confusion as to source or sponsorship.

The Policy also provides for a non-inclusive list of circumstances that would represent a defense to a Complainant's charges. They are: a pre-notice of the dispute use of the domain name in connection with a bona fide offering of goods or services; that Respondent is commonly known by the domain name; or that the domain name is being used non-commercially or as a fair use without intent to profit or misleadingly divert consumers or tarnish the trademark.

And unlike the earlier dispute resolution policy, no cancellation or transfer of the domain name can be ordered until a decision is rendered by the Provider. And to avoid a razzle-dazzle play while the Provider reaches its decision, the Respondent is not permitted to change Registrants or transfer the domain name, nor can the Respondent do so in the fifteen days following conclusion of the proceeding. The Policy also prohibits transfer during a pending court proceeding.

A person who believes that a domain name registration violates its rights and falls within the reach of the policy can file a Complaint with a Provider selected from a list published by ICANN. The selected Provider will then forward the Complaint to the Respondent within three days following receipt of the filing fee. The Provider is required to immediately notify the Complainant, the Respondent, the Registrar and ICANN of the commencement of the proceedings.

The Respondent has twenty days to file its response to the Complaint. If the Complainant has elected the more expensive three person panel to decide the matter, the Respondent is required to pay one-half the fee with the submission of its response. This requirement may eliminate a spurious response and cause the Complainant to

proceed more quickly. Failure to submit a response will result in a decision based solely on the Complaint.

There are no in-person or telephonic hearings permitted. The matter will be declined on the written submissions of the parties. Fourteen days following the Provider's appointment to the Panel, a decision must be made. The parties have the right to appeal the decision to a court, generally located in the jurisdiction of the principal office of the Registrant.

No doubt there will be some bumps along the road with this new dispute resolution policy. But it does appear to go along way towards meeting the need for a practical solution to the domain name provision. I remain hopeful.

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