

**Domain Names Management and Dispute Resolutions
- A Comparative Legal Study in the UK, US and China**

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Abstract

In the new information technology era, companies widely use the Internet to develop their preserve in the global marketplace and to build up their business images. Registering a domain name is a necessary step in an ever-changing information-driven society. Domain names relate to trademarks for the products or services, as well as a way of setting up companies' goodwill or reputation. Following three case studies, this article examines the registration, usage and protection of domain names in the UK, US and China and provides a comparative table on domain name dispute resolution policies and techniques in these countries.

Keywords: Domain names management; Registration; Trademarks; Infringement; Cybersquatting; Bad faith; In rem jurisdiction; Dispute resolutions.

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1. Introduction

Companies widely utilize the Internet technologies and resources exploring their global marketplace and building up their business images. For a company doing business on the Internet, a domain name is a vital tool for reaching and maintaining communication with customers. Because there is no effective alternative method of finding a company's Internet location, having a domain name that corresponds to a well-known trade mark may be a prerequisite for a company that wants to establish an Internet presence.¹

According to the case results statistics updated on 25 March 2007, **UDRP** (the Uniform Domain Name Dispute Resolution Policy) has received an amount of 10642 cases since its launch in 1999. The gTLD (Genetic Top-level Domains) case results rate of transferred domain names was 65%,

¹ Wang (2006), 116.

while the withdrawn/terminated rate was 22%. Similarly, the ccTLD (Country-Code Top-level Domains) case results rate of transferred domain name was 63%, while the withdrawn/terminated rate was 24%.² In the UK, **Nominet** has received a total of 5545 new cases for the Dispute Resolution Service (DRS) since its re-launch on 24 September 2001. The average response rate to valid dispute over the last 12 months was 45%, while the average settlement rate was 53% and the average complainant success rate was 79%.³ On 23 January, 2007, **China Internet Network Information Center** (CNNIC) published "19th Statistical Survey Report on Internet Development in China"⁴. The report shows that by the end of 2006, the number of the Internet users in China reached 137 million, accounting for 10.5% of China's population.⁵ Compared to the same period last year, China's Internet users increased by 26 million.⁶ China has approximately 4,109,020 domain names, including names registered in .CN and gTLDs.⁷ Among them, 1,939,343 names were registered in .COM, which account for 47.2% of the total; 1,803,393 (43.9%) names were registered in .CN.⁸

The demand for domain names grew as commercial activity on the Internet developed and as businesses wanted potential customers to have an easy way to find them.⁹ In response to the rapid development of domain names, at the international level, the Internet Corporation for Assigned Names and Numbers (ICANN) was formed in 1998 to take over responsibility for the governance of the domain name system (DNS). With advice from the World Intellectual Property Organization (WIPO), ICANN developed a Uniform Domain Name Dispute Resolution Policy (UDRP). This policy finally adopted in October 1999, provides a mandatory administrative procedure for the resolution of disputes between trade mark owners and domain name holders in cases where the domain name has been registered and is being used in "bad faith".¹⁰ National approaches have kept up with the international development. In 1999, US Congress passed legislation designed to curb cybersquatters, such as the Anticybersquatting Consumer Protection Act (ACPA) went into effect on 29 November 1999, amending Section 43 of the Lanham/Trademark Act. In addition, on 21 February 2002, the U.S Department of Commerce approved the usTLD Dispute Resolution Policy (USDRP) for .us domain names. On 30 September 2002, the China Internet Information Center (CNNIC) approved and implemented the CNNIC Domain Name Dispute Resolution Policy (CNDRP). The new amended CNDRP comes into force as from 17 March 2006. In September 2004, Nominet.UK released the second version of Dispute Resolution Service Policy (DRS Policy), which applies to all disputes filed on or after 25 October 2004. It could be regarded as an appendix to the Trade Marks Act 1994 governing domain names.

This paper illustrates the potential conflicts between domain names and trade marks, analyses three recent cases, discusses different legal policies in the UK, US and China, and proposes a recommendation to improve domain names legal protection on a global level.

2. Domain Names Management

2.1 Domain Names & Domain Names System

² UDRP Case Filing and Decisions, reported on 25 March 2007, available at <http://www.wipo.int/amc/en/domains/statistics/cumulative/results.html> (last visited on 25 March 2007).

³ Nominet DRS Statistics, Reported on 1 March 2007, available at <http://www.nominet.org.uk/intelligence/statistics/drs/> (last visited on 22 March 2007).

⁴ Statistical Survey Report on Internet Development in China (Jan. 2007), China Internet Network Information Center (CNNIC), available at <http://www.cnnic.net.cn/uploadfiles/pdf/2007/2/14/200607.pdf> (last visited 27 March 2007), thereafter called "Statistical Survey Report China 2007".

⁵ CNNIC Released the 19th Statistical Survey Report on Internet Development in China, available at <http://www.cnnic.net.cn/html/Dir/2007/02/05/4432.htm> (last visited on 27 March 2007), thereafter called "CNNIC the 19th Survey Report".

⁶ CNNIC the 19th Survey Report.

⁷ Statistical Survey Report China 2007.

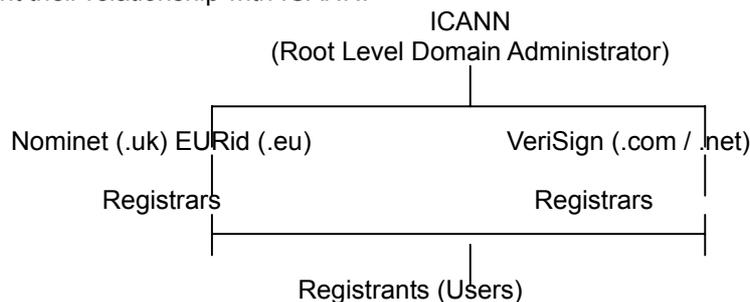
⁸ Statistical Survey Report China 2007.

⁹ Katsh (2006), 5.

¹⁰ Clark (2000).

A domain name is simply a number string, which corresponds to the numerical Internet Protocol address (IP address) of the computer on the Internet, while the Domain Name System (DNS) is established to translate a domain name into an IP address. So instead of typing 152.78.128.78¹¹, you can type www.soton.ac.uk. There are two types of domains: one is country code top-level domains (ccTLDs), such as .uk, .us and .cn, the other is generic top-level domains (gTLDs), such as .com, .edu and .net.

ICANN is primarily responsible for ensuring that IP addresses correspond with the correct domain name and for gTLD and ccTLD domain names management. There are currently over 150 ICANN-accredited registrars. Since 2000, ICANN has also worked with managers of ccTLDs to document their relationship with ICANN.¹²



Generally, domain name management will involve: consolidating domains into one portfolio, tracking the lifecycle of existing domains, ensuring domain name details are up to date and managing the DNS records and registration of new domain names.¹³ When a domain name is registered, the details of the registrant are stored in a central database, known as the WHOIS database. Domain name management providers have consolidated these databases and developed mechanisms to search the registrant information and exact all the domains registered by a particular company.¹⁴ Furthermore, the database of the WHOIS directory performs the “firework” function. That is to say, not only the WHOIS directory is to be used by the would-be registrants to check the availability of a particular domain name and select an unregistered domain name, but also it could be used to update the registrants by setting an alarm of expiration after a certain period, however, after the due date, the registrants still could renew it. This method would offer a chance to re-evaluate whether the original registrants are still capable and legible of holding the domain names.

2.2 Connection between Domain Names & Trade Marks

The growth in the use of domain names appears to have increased the number of bad faith registrations and further raised concerns that trade mark owners’ rights are increasingly infringed or diluted by the use of trade marks in domain names.¹⁵ That is, domain names have come into conflict with trade marks. The main reason for such conflict can be attributed to the lack of connection between the system of registering trade marks and the registration of domain names. The former is a system granting territorial rights enforceable only within the designated territory, the latter is a system of granting rights that can be enforced globally.¹⁶ Because trade mark law is territorial, a mark may be protected only in the geographic location where it distinguishes its goods or services. Thus, trade mark law can tolerate identical or similar marks in different territories even

¹¹ The IP number of the University of Southampton Website.

¹² Available at <http://www.icann.org/cctlds/> (last visited on 27 March 2007).

¹³ Wang (2006), 119.

¹⁴ Robinson (2005).

¹⁵ A Review of the Relationship between Trade Marks and Business Names, Company Names and Domain Names (March 2006), Australian Government, Advisory Council on Intellectual Property, p.5, available at <http://www.acip.gov.au/library/TM,%20business,company,domain%20names-%20Final%20Report.pdf> (last visited on 17 March 2007), thereafter called “Australian DR Review”.

¹⁶ Tunkel & York (2000).

within the same classes of goods and services. Domain Names, by contrast, are both unique and global in nature. Only one entity in the world can own the right to use a specific domain name that can be accessed globally.¹⁷ Moreover, there is an opposition procedure for trade marks registration, while there is no notice period for the domain names registration.

3. Dispute Resolutions

3.1 Three Cases

3.1.1 UK case

The case *Phones4U Ltd (1) and Cauldwell Holdings Ltd (2) v. Phone4u.co.uk Ltd (1), A Heykali (2) and New World Communication (Southern Division) Ltd (3)*¹⁸ went to the High Court in March 2005. Since 1995, the first claimant operated a chain of shops called “Phones4U” with its parent company, the second claimant, who registered a trademark, the Phones4U logo in the colors red, white and blue. In August 1999, the second defendant registered the domain name “phone4u.co.uk”, setting up an internet-based business selling mobile phones, and subsequently purchased the domain name “phone4u.com”, while the first defendant company was incorporated into the second defendant’s business. The first claimant commenced proceedings for passing off arising out of the “phone4u” web sites operated by the second defendant and for infringement of the second claimant’s registered trademark. The High Court finally made a decision that the first and second claimant failed their trademark and passing off claim against the defendants, because the court was not satisfied that the claimants had in fact discharged its burden to show that it had acquired sufficient good will and reputation prior to the defendant’s acquisition and use of its phone4u.co.uk website. The court was not satisfied that the claimant could rely on the brand name alone and so the passing off element of the claim was dismissed. Furthermore, the court ruled that the claimant could make out a claim for trademark infringement based on the limitation placed on the trademark application, which is limited to the colors red, white and blue.¹⁹

On appeal in May 2006, four arguments raised²⁰: (1) the judge used the wrong test in deciding whether or not a the key date Caudwell had goodwill protectable by passing off; (2) that the domain name was an instrument of fraud as set out in *One in Million*²¹; (3) the judge wrongly characterized several cases of ‘deception’ as ‘mere confusion’; (4) the judge made a mistake in placing significance on the co-existence of the marks. However, the Court of Appeal concluded that passing off was established, but the Court dismissed trade mark infringement. The Court of Appeal raised four arguments in allowing the passing off claim: First, there is a Goodwill established in Phones4u since 1999. Second, the Court decided that the defendant used Phone4u website as an instrument of fraud. Third, the Court ruled that it constituted “deception” rather than “mere confusion”. Furthermore, the defendant was not able to show that it had been trading side by side without significant confusion or deception.

3.1.2 US case

In the case of *Her, Inc. v. Re/Max First Choice, LLC*²², plaintiffs provided real estate services using the registered trademarks HER, REAL LIVING, and RELAX WITH REAL LIVING, and operated a website at “realliving.com.” Defendant Barlow formerly worked as a real estate agent for plaintiffs and later went to work for defendant Re/Max, a direct competitor of plaintiffs. The Plaintiff seeks a preliminary injunction to prevent Defendants RE/MAX from using Internet domain names incorporating Plaintiffs’ personal names and registered marks.”

¹⁷ Efroni (2002), 343.

¹⁸ [2005] EWHC 334 (CH); [2005] ALL ER (D) 143 (approved judgment).

¹⁹ [2005] EWHC 334 (CH); [2005] ALL ER (D) 143 (approved judgment).

²⁰ Available at <http://www.nominet.org.uk/disputes/caselaw/index/phone4u/> (last visited 27 March 2007).

²¹ *British Telecommunications Plc v. One in a Million Ltd* [1998] FSR 265.

²² *Her, Inc. v. Re/Max First Choice, LLC*, — F. Supp. 2d —, 2007 WL 43747 (S.D. Ohio Jan. 5. 2007).

The case arises as a result of circumstances which took place in late April and early May 2006, when agents of HER received an e-mail from “Herbie”, using the e-mail address herbie@insiderealliving.com. The e-mail, entitled “Inside Real Living” and “the Truth shall set you free”, purported to be an insider’s look into the dealings of HER and its leadership.

The Court granted the plaintiffs’ request for preliminary because of the defendant’s violation of the ACPA, according to four factors. The first factor is likelihood of Success on the Merits. In order to successfully establish a claim for likelihood, the Plaintiffs must show:

First, a valid trademark entitled to protection. The Plaintiffs’ initials “HER” was registered as a trademark in 1977, alongside with the other registered trademarks include: “Real Living”, “Relax with Real Living”, and “It is got to be real”. The evidence demonstrates that the names of the individual Plaintiffs have been regularly and frequently used in extensive marketing of HER and Real Living and the names have acquired secondary meaning. The Court concluded that HER, Real Living, and the Plaintiffs’ personal names are worthy of trademark protection. (Secondary Meaning: a long association of the personal name with the business makes the name and the business become synonymous in the public mind.)

Second, the mark is distinctive or famous. The HER mark and the REAL LIVING mark, which are registered, are clearly distinctive. In addition, the Plaintiffs’ personal names are distinctive by virtue of the secondary meaning they have acquired.

Third, the Defendant’s domain name is identical or confusingly similar to, or in the case of famous mark, dilutive of, the owner’s mark. The Defendants’ domain names identified in the Complaint are www.insiderealliving.com and the other domain names with Plaintiffs’ personal names. Defendants’ use of the Plaintiffs’ personal names as well as the Real Living mark is clearly confusing as it creates the appearance that Plaintiffs have permitted the use of the trademarks and names by the defendants. The use also dilutes the Plaintiffs’ mark.

Forth, the Defendants used, registered and trafficked in the forgoing domain names. Fifth, the Defendants’ use was done with a bad faith intent to profit, for the reasons that the Defendants have no intellectual property right in the domain names. The domain names consist of the Plaintiffs’ business or personal names. The Defendants had no prior use of the domain names for a bona fide offering of goods or services. The Defendants harmed the goodwill of Plaintiffs’ marks by routing users to either the RE/MAX site or the “insiderealliving” site. Users intending to view the Plaintiffs’ websites could be, and in some instances were, unknowingly diverted to Defendant’s website. In the Court’s view, the Defendants was simply displeased with the detrimental, economic effect on him and RE/MAX of no having their homes for sale listed on the HER website. The Defendants’ site was designed with a long-term commercial gain motive.

The second factor to prove the violation of the ACPA is whether Plaintiffs would suffer irreparable harm if an injunction did not issue. As discussed before, the Court finds a likelihood of confusion as a result of the Defendants’ use of the domain names. Thus, the Court concludes that Plaintiffs will suffer irreparable harm if the Court does not enjoin the Defendants’ operation of the domain names and linked sites.

The third factor is whether the issuance of an injunction would cause substantial harm to others. The Court finds that Defendant’s misleading use of Plaintiffs’ marks causes substantially more harm to Plaintiffs, if not enjoined, than any harm which would befall the Defendant if an injunction is issued.

The fourth factor is public interest. There is a public interest in preventing consumer confusion and deception in the marketplace and protecting the trademark holder’s property interest in the mark. The Defendants’ use of the Plaintiffs’ personal and professional names is misleading and against public interest.

Plaintiffs claimed that visitors to these sites were diverted to Re/Max's website; defendants argued that the websites were "intended to link to the 'insiderealliving' website" and this diversion to Re/Max's site was unintentional. Plaintiffs sued for cybersquatting, unfair competition, infringement, and dilution, and moved for a preliminary injunction.²³

3.1.3 Chinese Case

The case *Educational Testing Service v. toefl.cn & toefl.net.cn*²⁴, was filed at the Hong Kong International Arbitration Centre (HKIAC) on 16 March 2006. The complainant was a non-profit and well-known educational testing organization, which was established 1947 in the United States. TOEFL is called "Test of English as a Foreign Language". It established a test for English language ability for university entrance or scholarship application. The complainant had registered "TOEFL" as a trademark in 78 countries. The Claimant asserted that the respondent's use of domain names "toefl.cn", registered on 17 March 2003 and "toefl.net.cn", registered on 29 March 2000, which are connected to an irrelevant website <http://m.com.tv/default.shtml>, would confuse the claimant's existing and future customers of the Claimant, and thus constitute registration and use of the domain names in bad faith.

3.2 Time Limit for Initiating Complaints

Effective in 17 March 2006, the CNNIC has issued an amended Domain Name Dispute Resolution Policy (CNDRP) with new measures for resolving domain name registration disputes. There are two new rules: first is time limit for the complaint²⁵ and the other is the evidence of the rights to and legitimate interests in domain name²⁶.

Subject to Article 2 of CNDRP, the disputed names shall "within the range of .CN domain names and Chinese domain names that were under the administration of CNNIC. However, the Dispute Resolution Service Providers do not accept the Complaint regarding domain names with registration term of over (including) two years." This is so-called "Two-Year Rule". Complainants are now required to file a complaint within two years of the commencement of use of a domain name by the respondent – i.e. there is a two-year limitation period on complaints. However, this will not prevent the complainant from filing a claim against the respondent via the courts.²⁷

In the UK, Article 3(c) of the Nominet DRP is more precise to the time limit, providing that "there shall be a presumption of Abusive Registration if the Complainant proves that Respondent has been found to have made an Abusive Registration in three or more Dispute Resolution Service cases in the two years before the Complaint was filed."

3.3 Bad Faith

At the international level, the ICANN UDRP procedure is designed for domain name disputes that meet the following cumulative criteria²⁸:

²³ Case Summary.

²⁴ *Educational Testing Service v. toefl.cn & toefl.net.cn*, DCN-0600061, Administrative Panel Decision, Hong Kong International Arbitration Centre, available at <http://www.adndrc.org/cn/image/DCN-0600061.pdf> (last visited 27 March 2007).

²⁵ CNNIC Domain Name Dispute Resolution Policy (March 17, 2006), Article 2, available at <http://www.cnnic.net.cn/html/Dir/2006/03/15/3655.htm> (last visited 27 March 2007).

²⁶ CNNIC Domain Name Dispute Resolution Policy (March 17, 2006), Article 10, available at <http://www.cnnic.net.cn/html/Dir/2006/03/15/3655.htm> (last visited 27 March 2007).

²⁷ *China Update 2006*, Squire, Sanders & Dempsey L.L.P. (April 2006), p.5, available at http://www.ssd.com/files/tbl_s29Publications%5CFileUpload5689%5C9574%5CChinaUpdate.pdf (last visited 27 March 2007), thereafter called "China Update 2006".

²⁸ ICANN the Uniform Domain Name Dispute Resolution Policy (24 October 1999), Article 4(a), available at <http://www.icann.org/dndr/udrp/policy.htm> (last visited 27 March 2007).

- (i) that the domain name registered by the respondent is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
- (ii) that the respondent has no legitimate interests in respect of the domain name; and
- (iii) that the domain name has been registered and used in bad faith.

In the US, although the ACPA does not offer a definition of the term “bad faith”, it provides nine factors for courts to consider when determining whether a person acted in bad faith (ACPA Sec 2002 (B)). The ICANN UDRP list of bad faith factors is strikingly similar to that of the ACPA. Evidence of bad faith includes circumstances indicating that (a) whether the registrant obtained the domain name to **prevent** the trademark owner from using its mark in a domain name and has a pattern of such conduct; (b) whether the registrant obtained the domain name primarily to **sell, rent, or otherwise transfer** it to the trademark owner or the trademark owner’s competitor; (c) whether the registrant obtained the domain name primarily to **disrupt** the business of a competitor; or (d) whether the registrant uses the domain name to intentionally attract Internet users for **commercial gain** by creating a **likelihood of confusion** with the complainant’s mark (Article 4(b) of UDRP).

Compared with Article 4(b) of UDRP, CNDRP “bad faith” provision²⁹ is less specific and precise. However, the CNDRP gives a broader recognition of “bad faith” by providing “other circumstances which may prove the bad faith”³⁰. For example, in the case of *Educational Testing Service v. toefl.cn & toefl.net.cn*³¹, according to Article 9(a) (b) (c) of CNDRP, the Panel ruled that the respondent’s domain names are identical or confusingly similar to the claimant’s trade mark. The respondent had no rights or legitimate interests in “toefl.cn” and “toefl.net.cn” since toefl is not a descriptive word. Thus, these two domain names had been registered and used in bad faith. In addition, the respondent linked its domain names to another website, which is completely irrelevant to the claimant’s services or products, should apply to Article 9(d) of CNDRP “other circumstances which may prove the bad faith”.

In China, if disputed domain names are gTLDs, they will be filed with the Asian Domain Name Dispute Resolution Center (ADNDRC) instead of Hong Kong International Arbitration Centre. For example, the case *AVON Products, INC. v. Ni Ping*³² was filed with ADNDRC on 27 April. The complainant was one of the world’s most well known direct sellers of cosmetic products. Since 1886, the claimant claims that it built up distribution networks covering 145 countries, 8 million customers and 4.8 million independent sales representatives. The claimant has expended extensive amounts of fiscal and temporal capital in preserving the value of its AVON and “Ya Fang” trademarks in Roman and Chinese characters, including registration of these trademarks throughout the world, including the PRC, Hongkong, Taiwan and Singapore. It entered into the PRC market in 1990 and now has 77 branches in China, over 6,000 specialty shops. Sales between 2000 and 2004 of products marked with “Ya Fang” in Chinese characters (or derivative marks) totaled over US\$681 million, thereby providing substantial evidence of a global association of the Complainant’s “Ya Fang” marks with its cosmetic products. The Claimant asserted that the respondent’s use of domain name “yafang.net”, which was registered on 12 August 2003 in Beijing, would confuse existing and future customers of Claimant, and constitute use and registration in bad faith. When visitors type in www.yafang.net, it will directly connect to www.x-y-f.com. The respondent Ni Ping also registered “avon.cn”, “yafang.cn” and “niping.cn” on 17 March 2003, and sold cosmetic products online. Ni Ping transferred the link of “yafang.net” to “avon.cn”, “yafang.cn” and “niping.cn” after the complaint was filed. The Panel ordered that the domain name

²⁹ CNNIC Domain Name Dispute Resolution Policy (March 17, 2006), Article 9, available at <http://www.cnnic.net.cn/html/Dir/2006/03/15/3655.htm> (last visited 27 March 2007).

³⁰ CNNIC Domain Name Dispute Resolution Policy (March 17, 2006), Article 9(d), available at <http://www.cnnic.net.cn/html/Dir/2006/03/15/3655.htm> (last visited 27 March 2007).

³¹ *Educational Testing Service v. toefl.cn & toefl.net.cn*, DCN-0600061, Administrative Panel Decision, Hong Kong International Arbitration Centre, available at <http://www.adndrc.org/cn/image/DCN-0600061.pdf> (last visited 27 March 2007).

³² *Avon Products, INC. v. Ni Ping*, CN-0600087, available at http://www.adndrc.org/adndrc/bj_statostocs.html (last visited 27 March 2007).

“yafang.net” be transferred to the Complainant, pursuant to Article 4(a) of the UDRP.

In the UK, Nominet DRS does not use the terminology “bad faith”. It uses the term “Abusive Registration”³³ instead. As decided in the *Phones4U* case, Lord Justice Jacob firstly noted that since it had been shown that there was a Phones4U shop in most towns, it could not really be said that the brand was not “an attractive force which brings in custom” protected by law. Secondly, according to Mr Heykali’s conduct in offering to sell after being aware of Phones4U was not materially different from that of the defendants in *One in Million*³⁴, which is deemed to be “Cybersquatting”. Thirdly, Jacob judged it as “deception” rather than “mere confusion” for the reasons that emails had now been provided and these revealed a mass of evidence of people mailing <phone4u.co.uk> while attempting to reach <phones4u.co.uk>, who appeared to believe that they were in communication with Caudwell’s shops. Some of these emails got a standard reply distancing <phone4u.co.uk> from Phone 4u, but also advertising Phone4u. Finally, there wasn’t co-existence of the marks, because Mr Heykali’s trade did not really exist.³⁵ As to the argument of trademark infringement, Jacob decided that the color limitation was valid, so the mark did not protect the words alone and there was no registered trade mark infringement.³⁶

3.4 Rights or Legitimate Interests

Parallel to Article 4(c) of UDRP, Article 10 of CNDRP provides that “before receiving the complaint, any of the following circumstances may be evidence of the rights to and legitimate interests in the domain names: (1) your use of the domain name or a name corresponding to the domain name in connection with a **bona fide** offering of goods or services; (2) you have been **commonly known** by the domain name, even if you have acquired no trademark or service mark rights; (3) you are making a **legitimate noncommercial** or **fair use** of the domain name, without intent of or commercial gain to misleadingly divert consumers.”

This is a general equivalence to Article 4(a)(i)&(ii) of the UK Nominet Dispute Resolution Service Policy (Nominet DRS), which states five factors of non-abusive registration as follows:

- i. Before being aware of the Complainant’s cause for complaint, the Respondent has (A) used or made demonstrable preparations to use the Domain Name or a Domain Name which is similar to the Domain Name in connection with a **genuine offering of goods or services**; (B) been **commonly known** by the name or **legitimately connected** with a mark which is identical or similar to the Domain Name; (C) made legitimate **non-commercial** or **fair use** of the Domain Name; or
- ii. The Domain Name is **generic** or **descriptive** and the Respondent is making fair use of it.

In addition, compared with CNDRP and UDRP, Article 4(a)(iii)&(iv) of Nominet DRS have two more conditions regarded as non-abusive registration that “the Domain Name is consistent with an express term of a written agreement entered into by the Parties”³⁷ or “the Domain Name is of a significantly different type or character to the other domain names registered by the Respondent”³⁸.

3.5 Cybersquatting

³³ UK Nominet Dispute Resolution Service Policy (25 October, 2004), Article 3, available at <http://www.nominet.org.uk/disputes/drs> (last visited 27 March 2007).

³⁴ *British Telecommunications Plc v. One in a Million Ltd* [1998] FSR 265.

³⁵ Available at <http://www.nominet.org.uk/disputes/caselaw/index/phone4u/> (last visited 27 March 2007).

³⁶ Available at <http://www.nominet.org.uk/disputes/caselaw/index/phone4u/> (last visited 27 March 2007).

³⁷ UK Nominet Dispute Resolution Service Policy (25 October, 2004), Article 4(a)(iii), available at <http://www.nominet.org.uk/disputes/drs> (last visited 27 March 2007).

³⁸ UK Nominet Dispute Resolution Service Policy (25 October, 2004), Article 4(a)(iv), available at <http://www.nominet.org.uk/disputes/drs> (last visited 27 March 2007).

“In 2006, a total of 1,823 (gTLDs and country code Top Level Domains (ccTLDs)) complaints alleging cybersquatting – the abusive registration as domain names of trademarks – were filed with WIPO’s Arbitration and Mediation Center, representing the highest number of cybersquatting cases handled by WIPO since 2000.”³⁹

In the Internet market, there have been a number of attempts to gain commercial benefits in domain names. Cybersquatting remains on the high rise. World Intellectual Property Organization (WIPO) statistics showed that the number of cybersquatting disputes filed with WIPO in 2006 increased by 25% as compared to 2005.⁴⁰

Cybersquatting involves the pre-emptive, bad faith registration of trademarks as domain names by third parties who do not possess rights in such names.⁴¹ A cybersquatter is one who knowingly registers with a network information center (NIC) a domain name consisting of the mark or name of a company for the purpose of relinquishing the right to that domain name back to the legitimate owner for a price.⁴² The intention of cybersquatting is to sell the domain name back to the trademark owner or to attract web traffic to unrelated commercial offers.⁴³ This gives rise to disputes between trademark owners and domain name registrants.

In practice, cybersquatting is deemed to be a threat of trade mark infringement and passing off. The leading case in cybersquatting in the UK is *British Telecommunications plc v. One in a Million Ltd*⁴⁴, One in a Million traded in domain name registrations and had registered names and trade marks of well-known companies. The Intention was to sell them back to the owners. Amongst the names registered were “marksandspencer.com” and “marksandspencer.co.uk”, “virgin.org”, “bt.org” and “sainsbury.com”. The Courts decided that the defendant failed the case for the reason that, by registering them it blocked the registration of such names by the respective plaintiffs. It was quite clear that the defendant’s intention was to offer to sell the names back to the respective plaintiffs.

As judged in the US case, *Her, Inc. v. Re/Max First Choice, LLC*⁴⁵, the court granted plaintiffs’ motion, finding that they established a likelihood of success on their cybersquatting and infringement claims. Regarding cybersquatting, according to the ACPA the court held first that plaintiffs had valid marks, including REAL LIVING, and that the personal names of plaintiffs’ executives had acquired secondary meaning due to their long association with the business such that their names and the real estate business had “become synonymous in the public mind.” Secondly, the court held that the plaintiffs’ marks were distinctive or famous when the domain names were registered. Third, the court held that the defendants’ domain names were confusingly similar to and dilutive of the plaintiffs’ marks. The court rejected the defendants’ argument that adding the word “inside” to “realliving” in the domain name eliminated confusion, noting that there was evidence of actual consumer confusion surrounding the “insiderealliving.com” site. Fourth, the court held that defendants used, registered, and trafficked in the domain names. Lastly, the court held that defendants had a bad-faith intent to profit from the plaintiffs’ marks, finding that (a) the defendants had no intellectual property rights in the domain names, (b) the domain names consisted entirely of the plaintiffs’ business and personal names, (c) the defendants had never used the domain names previously in a bona fide offering of goods or

³⁹ WIPO Press Room, [Cybersquatting Remains on the Rise with further Risk to Trademarks from New Registration Practices](http://www.wipo.int/pressroom/en/articles/2007/article_0014.html), Geneva, March 12, 2007, WIPO/PR/2007/479, available at http://www.wipo.int/pressroom/en/articles/2007/article_0014.html (last visited 27 March 2007), thereafter “WIPO Press Room Cybersquatting”.

⁴⁰ WIPO Press Room Cybersquatting.

⁴¹ [Guide to WIPO Domain Name Dispute Resolution \(Publication No. 892\)](http://www.wipo.int/freepublications/en/arbitration/892/wipo_pub_892.pdf), WIPO Arbitration and Mediation Center, available at http://www.wipo.int/freepublications/en/arbitration/892/wipo_pub_892.pdf (last visited 27 March 2007), thereafter called “WIPO 892”.

⁴² *K.C.P.L., Inc. v. Nash*, 49 U.S.P.Q. 2d 1584 (S.D.N.Y.1988).

⁴³ WIPO 892.

⁴⁴ [1998] FSR 265.

⁴⁵ *Her, Inc. v. Re/Max First Choice, LLC*, — F. Supp. 2d —, 2007 WL 43747 (S.D. Ohio Jan. 5. 2007).

services, (d) although the defendants had a bona fide First Amendment right to criticize the plaintiffs, the defendants could not claim a “legitimate, noncommercial purpose” for its domain names because the defendants competed directly with the plaintiffs, (e) the defendant’s diversion of Internet users away from plaintiffs’ website harmed the goodwill of plaintiffs’ marks, regardless of whether users were routed to the Re/Max site or the “insiderealliving.com” site, and this diversion “was designed with a long-term financial motive in mind” (i.e., to have defendants’ homes for sale listed on plaintiffs’ website), and (f) the plaintiffs’ marks were clearly distinctive or famous. In short, defendants use of plaintiffs’ marks was commercially misleading. The court also held that the plaintiffs established a likelihood of success on their infringement claims based on a similar analysis. The court did not issue an injunction against the domain names containing the telephone numbers and addresses of plaintiffs’ executives. Although these domain names did not appear to have any “legitimate purpose,” there was no evidence showing that these telephone numbers or addresses were worthy of trademark protection.”⁴⁶

In order to prevent cybersquatting, the ACPA has additionally set up rules in five ways: (1) stripping away shields and filling in loopholes in traditional trade marks analysis which previously allowed cybersquatters to escape liability; (2) providing a specific cause of action for individuals whose names have been pirated; (3) preventing cybersquatters from “hiding” from liability by allowing in the actions against the domain names themselves; (4) making cybersquatting a much riskier practice by allowing statutory damages of \$1000 per domain name; and (5) facilitating the compliance and cooperation of registrars by limiting registrars’ liability and encouraging them to establish their own policies to stop cybersquatting.⁴⁷

Another important element of ACPA for cybersquatting was the establishment of *in rem* jurisdiction. This rule is for the mark holders who would like to bring civil action against the domain name itself in the US district court. *In rem* action can apply to the case when the mark owner can’t establish *in personam* jurisdiction, or is not able to find the registrant’s physical location through due diligence.⁴⁸ Take *Barcelona.com, Inc. v. Excelentísimo Ayuntamiento de Barcelona*⁴⁹ for example, it shows how a foreign losing registrant can obtain standing as plaintiff in a federal court. Barcelona.com was registered by a Spanish couple, providing tourist information about Barcelona, e-mail services, a chat room, advertising and links to other Web sites. The Complainant was the City Council of Barcelona, having approximately one thousand registrations of the mark “Barcelona”. The City Council filed a complaint and won the UDRP proceeding. The domain name was ordered transferred to the City Council. Before the execution of the transfer, Barcelona.com, Inc. commenced a lawsuit in the District Court for the Eastern District of Virginia, seeking a declaratory judgment and asserting that the registration of the domain name was not unlawful.⁵⁰ The Court found that, firstly Barcelona.com, Inc. was registered with the US registrar, NSI; secondly, it had a mailing address in New York but had no office space, no telephone number and no employees. This action meets the ACPA criteria for an *in rem* action. So the domain name “barcelona.com” has been named as a complainant in the lawsuit in the US. The Court’s decision validated the transfer according to the ACPA through the *in rem* jurisdiction.

In rem jurisdiction also applied to another case between the US and China, *Cable News Network L.P., L.L.L.P. v. CNNEWS.COM*⁵¹. The plaintiff alleged that cnnews.com violated his rights because cnnews.com is similar to his registered marks “CNN” in the US. As Ellis, a district judge noted, “this is an *in rem* ACPA suit brought by an American company against ‘cnnews.com’ a domain name used by a Chinese company in connection with a website that focused chiefly on China and Chinese speakers by providing online services in Chinese language.” This case maintains an *in rem* action because (i) the action was brought in the jurisdiction where the registrar

⁴⁶ Case Summary.

⁴⁷ Kaplan (Fall, 2000), 43.

⁴⁸ 15 U.S.C Section 1125 (d)(2)(A).

⁴⁹ 189 F. Supp.2d 367 (E. D. Va. 2002), rev’d and vacated, 330 F. 3d 617 (4th Cir. 2003).

⁵⁰ 189 F. Supp. 2d at 369.

⁵¹ No. 00-2022-A, E.D. Virginia (Dec 21, 2001).

or registry of the infringing domain name was located; and (ii) *in personam* jurisdiction over the registrant did not exist⁵². Under the ACPA, a trade mark owner can petition a US court to transfer a foreign national's domain name to the trade mark owner despite the fact that the foreign national domain name has never transacted business in any forum within the US to the trade mark owner.⁵³

By contrast, a domain name registrant whose domain name has been suspended, disabled, or transferred under a reasonable policy may, upon notice to the mark owner, file a civil action to prove that such registrant is not unlawful. The court may grant injunctive relief to the domain name registrant, including the reactivation of domain name or transfer of the domain name to the domain name registrant.⁵⁴ This action, protecting registrants unjustified cybersquatting claims is called domain name hijacking.

Cybersquatting by defining it as the practice of registering a domain name for the purpose of selling or transferring it to the rightful owners or their competitors. Therefore, cybersquatting is not committed if a respondent sells or transfers a domain name to a third party other than the rightful owner or the rightful owner's competitor.⁵⁵

3.6 Summary

Through the analysis of the above three cases and the relevant policies, it is notably apparent that firstly, an advantage of the ICANN's UDRP is that it is intended to be fast and relatively inexpensive. Secondly, the remedies provided under the UDRP are limited in comparison to ACPA. Simply stated, the UDRP allows either the transfer or cancellation of the domain name, but, unlike ACPA, does not allow recovery of statutory damages. Thirdly, the UDRP does not provide the finality that a trial decision under the ACPA would provide. Fourthly, the UDRP protects famous names, while the ACPA protects any living individual whose name has been registered.⁵⁶

In the UK, the new Nominet's Domain Resolution Service Policy (DRS Policy) aims at resolving disputes over abusive registrations only and, interestingly, Nominet has chosen not to adopt the UDRP despite the success of such a system. The UDRP does not provide any mediation service. There is inconsistency in published decisions of arbitrators under the UDRP, and Nominet perceives the UDRP to favour trade mark holders whereas Nominet claims to operate a principle of "neutrality and equality".⁵⁷

The structure and principles of the CNDRP model is close to that of the UDRP of the ICANN. As with the UDRP, one of the main objectives of the CNDRP is to reduce the cost of resolving disputes concerning the most egregious types of cybersquatting, leaving other disputes to the court system. The CNDRP is designed to provide a cheap and quick way to resolve the earliest cases, rather than to replace the court as an ultimate resolution system for name rights disputes on the Internet.⁵⁸

Furthermore, both the international approaches and national approaches regulate the principles of "Confusingly similar", "Bad faith intent to profit", "Damages and remedies" except for the ACPA, which also sets up the jurisdiction provision. Three separate causes of action are established by the ACPA, which are protection for living individuals, liability of registrars and courses of action for legitimate domain name holders.

4. Recommendation & Conclusion

⁵² 15 U.S.C. Section 1125 (d)(2)(A).

⁵³ Nguyen (Jan 2003), 486.

⁵⁴ 15 U.S.C Section 1114 (2)(D)(v).

⁵⁵ China Update 2006.

⁵⁶ *Roberts v. Boyd* (WIPO No. D2000-0210, May 29, 2000).

⁵⁷ Simmons & Simmons (2001), p.77.

⁵⁸ Soo (Sep. 2004).

The UDRP, Nominet DRS, and CNDRP serve importance functions to resolve domain name disputes in an out-of-court proceeding that can be implemented on an international basis. The question is whether the process is as fair and effective as it should be. Listed below are recommendations:

1. Design a set of objective criteria to analyze the fairness and efficacy of the UDRP and its implementation by the respective providers.⁵⁹
2. Recommend a choice of law provision to guide disputes among complainants and respondents of diverse jurisdictions.⁶⁰
3. Design a set of precise criteria to determine fair use and rights and legitimate interests of domain names, because use of the domain names can be very localized, and it is questionable whether these can be accessed properly for disputes in gTLDs on a global medium.⁶¹
4. Establish an assessment system, for example, domain name applications should be checked by the registry/registrars to ensure that a domain name is not similar to an existing domain name,⁶² or whether a domain name conflicts with a registered trade mark or enterprise name, or whether a third party's rights are infringed.
5. Explore the practical implications for the developments in the Domain Name Registration System using automated registration processes, and accommodate changing circumstances and new developments of domain name system. For example, "The combined effect of developments such as: the use of 'Whois' privacy services for registrations; the growth in the number of professional domain name dealers and the volume of their activity; the use of computer software to automatically register expired domain names and their 'parking' on pay-per-click portal sites; the option to register names for free for a five-day 'tasting' period; the growth in the number of accredited registrars; and the establishment of new gTLDs, is to create great opportunities for mass registration of domain names."⁶³ With regard to bulk buyers of domain names using automated registration processes, a WIPO panel decision found that failure to conduct prior checks for third-party rights in certain circumstances would represent "willful blindness", representing bad faith under the UDRP.⁶⁴
6. Employ and enhance Sunrise Period. In my perspectives, if the domain names regulations or rules could be developed to keep pace with these new technology changes and protect the rights between domain names registrars and trade marks owners, the increase of gTLD's would seem to open opportunities to trademark owners who desire an online presence more than it will expose them to the risk of cybersquatting. For example, the new ".eu" top level. In order to prevent new gTLDs from turning into cybersquatting havens, the preventive IP protection mechanisms are needed. They are supposed to be effective and in a way that minimizes the potential for abuse.⁶⁵ Sunrise mechanisms are designed to offer a means to protect the interests of IP owners. That is, prior to commencing .eu registration on a first-come-first-served basis and in accordance with EU Regulation 733/2002⁶⁶ and EC Regulation 874/2004⁶⁷, there will be a 4-month sunrise

⁵⁹ Kornfeld, D. (2000).

⁶⁰ Kornfeld, D. (2000).

⁶¹ Second WIPO Internet Domain Name Process, The Recognition of Rights and the Use of Names in the Internet Domain Name System, Final Report, 3 September 2001, available at <http://www.wipo.int/export/sites/www/amc/en/docs/report-final2.pdf> (last visited 27 March 2007).

⁶² Australian DR Review.

⁶³ WIPO Press Room Cybersquatting.

⁶⁴ *Mobile Communications Services Inc. v. WebReg RN*, WIPO Case No. D2005-1304, available at <http://www.wipo.int/amc/en/domains/decisions/html/2005/d2005-1304.html> & *Media General Communications, Inc. v. Rarenames, WebReg*, WIPO Case No. D2006-0964, available at <http://www.wipo.int/amc/en/domains/decisions/html/2006/d2006-0964.html> (last visited 28 March 2007).

⁶⁵ WIPO Report on New Generic Top-Level Domains: Intellectual Property Considerations (06 April 2005), para.118, 124, available at <http://www.icann.org/wipo/newgtld-ip-05apr06.htm> (last visited 22 March 2007).

⁶⁶ Regulation (EC) No 733/2002 of the European Parliament and of the Council of 22 April 2002 on the implementation of the .eu Top Level Domain, O. J. 2002 L 113/1.

- period to allow owners of “prior rights” (e.g. trade mark holders, public bodies) to register their names as domain names before other eligible parties. Sunrise complies with the geographical requirements applicable to all .eu domain name holders, as set out in EU regulation 733/2002⁶⁸, and protects all owners of rights in identifiers. All owners of such rights would compete during sunrise on an equal footing. Sunrise applicants will be also dealt with a validation process, that is, the domain name for sunrise applicant will become usable only after a 40-day period to allow for any errors or appeals.⁶⁹
7. Establish uniform rules of authorized UDRP providers.
 8. Recommend the time limit for initiating complaints.

In conclusion, with the booming exploration of cyberspace conducting, domain name has been one of the most popular issues among electronic commercial transactions. The legal issues on domain name have been the subjects of intensive discussions throughout the world. This paper through three typical case studies, illustrated that it is essential to reshape the Domain Name System (DNS) or to establish new management mechanisms that accommodate the growing volume of traffic on the Internet. Meanwhile, in order to keep the balance of the rights between the domain names registers and trade mark owners, the rules governing domain names should be improved or amended. According to the analysis before, it is clear that the purpose of the trade mark system is to recognize and protect rights, while the purpose of the domain name system is to award an address for operation in a telecommunications network. The trade marks system aims to prevent legal confusion, while the domain name system aims to prevent “communication” confusion. Since the systems have different purposes and methods of implementation, conflict is to be expected.⁷⁰ In my view, since the domain name issue is a cross-bordered topic, an international agreement on domain name policies may help to integrate the worldwide internet marketplace. The policies are supposed to solve the uncertainty about how traditional laws would apply to the new frontier of the Internet and what are both trade marks owners and domain name registrants’ legal rights. It is suggested that, based on national laws, agreements should be established to clarify trademark abandonment in the context of domain name by redefining the limits of “failure to police a mark.” Furthermore, it should be formed to clarify the desired result in lawsuits involving two or more parties with legitimate ownership of the same trademark. Finally, with regards to the nature of trade marks that can be confined by region, goods and services, several parties may own the same mark. The international agreement should clarify whether there should be some sort of shared system or whether it is merely a first come, first served basis amongst the trademark owners.

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⁶⁷ Commission Regulation (EC) No 874/2004 of 28 April 2004 laying down public policy rules concerning the implementation and functions of the .eu Top Level Domain and the principles governing registration, O. J. 2004 L 162/40.

⁶⁸ Article 4(2)(b) of EU Regulation 733/2002, states only the following may apply for a .eu domain name:

- i) undertaking having its registered office, central administration or principal place of business within the Community, or
- ii) organization established within the Community without prejudice to the application of national law, or
- iii) natural person resident within the Community.

⁶⁹ Information on the European Registry of Internet Domain Names (EURid), available at <http://www.eurid.eu/euDomainNames/sunrisePeriod.html> (last visited 23 March 2007).

⁷⁰ Schwimmer (1999), 387.

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Appendix: Comparative Table on Domain Name Dispute Resolution Policies and Techniques

		ICANN UDRP	ACPA	USDR P	Nominet DRS	CNDRP
Causes of Actions	Identical or confusingly similar to a mark	Yes	Yes	Yes	Yes	Yes
	Dilutive of a mark	No	Yes	No	No	No
	No rights or legitimate interests	Yes	No	Yes	No	Yes
	An abusive registration	No	No	No	Yes	No
	In bad faith	Yes	Yes	Yes	Yes	Yes
Tests for bad faith	For the purposes of selling, renting or transferring	Yes	Yes	Yes	Yes	Yes
	To prevent the trade mark owners from reflecting the mark in a corresponding domain names	Yes	No	Yes	Yes	Yes
	For the purposes of disrupting the business of a competitor	Yes	No	Yes	Yes	Yes
	Likelihood of confusion	Yes	Yes	Yes	Yes	Yes
	IP rights in the domain names	No	Yes	No	No	No
	That consists of legal personal name used to identify the person	No	Yes	No	No	No
	Prior use with the bona fide offering; Bona fide noncommercial or fair use	No	Yes	No	No	No
Rights & Legitimate Interests	The owner or beneficiary of a trade or service mark that is identical to the domain name	No	No	Yes	No	No
	A bona fide offering	Yes	No	Yes	Yes	Yes
	Commonly known	Yes	No	Yes	Yes	Yes
	Legitimate noncommercial or fair use	Yes	No	Yes	Yes	Yes
Remedies	Transfer/cancellation	Yes	Yes	Yes	Yes	Yes
	Actual or statutory damages	No	Yes	No	No	No
	Attorney's fees	Yes	Yes	Yes	Yes	Yes
	Injunctive relief	No	Yes	No	No	No
Defenses	Legitimate use or intent to use domain names	Yes	Yes	Yes	Yes	No
	Lack of fame or distinctiveness	No	Yes	No	Yes	No
	No bad faith (domain name owner's prior bona fide use)	Yes	Yes	Yes	Yes	Yes