

## Legal Issues in UDRP

### Issue: Can a Single UDRP Complaint be Filed Against Multiple Unknown Parties?

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## Relevant Provisions

❖ **Paragraph 4(f), Uniform Domain Name Dispute Resolution Policy –**

*“Consolidation. In the event of multiple disputes between you and a complainant, either you or the complainant may petition to consolidate the disputes before a single Administrative Panel. This petition shall be made to the first Administrative Panel appointed to hear a pending dispute between the parties. This Administrative Panel may consolidate before it any or all such disputes in its sole discretion, provided that the disputes being consolidated are governed by this Policy or a later version of this Policy adopted by ICANN.”* [Emphasis supplied]

❖ **Paragraph 3(c), Rules for Uniform Domain Name Dispute Resolution Policy –**

*“The complaint may relate to more than one domain name, provided that the domain names are registered by the same domain-name holder.”* [Emphasis supplied]

❖ **Paragraph 10 (e), Rules for Uniform Domain Name Dispute Resolution Policy –**

*“A Panel shall decide a request by a Party to consolidate multiple domain name disputes in accordance with the Policy and these Rules.”*

## WIPO Overview of WIPO Panel Views on Selected UDRP Questions

### ❖ How is respondent identity assessed in a case involving privacy or proxy registration service?

*“the WIPO Center will (a) **provide any disclosed underlying registrant information** to the complainant, and (b) invite the complainant to **amend the complaint** to reflect such information.”*

*“...where underlying registrant information is disclosed/provided to the complainant, the complainant **chooses not to amend** its complaint, and instead to retain the WhoIs-listed registrant as the named respondent, the WIPO Center would **not normally treat this as a complaint deficiency**.”*

*“a complainant may **either add** the disclosed underlying registrant as a co-respondent, **or replace** the originally named privacy or proxy service with the disclosed underlying registrant...”*

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*“...**appointed panel retains discretion** to determine the respondent against which the case should proceed...” [Emphasis supplied]*

(Link: <https://www.wipo.int/amc/en/domains/search/overview3.0/#item44>)

# WIPO Overview of WIPO Panel Views on Selected UDRP Questions (Contd.)

## ❖ Examples of Proxy Details

**Domain Name:** The domain name  
**Registry Data:** The [registry](#) for the domain  
**Updated Date:** The date the domain was last updated  
**Creation Date:** The date the domain was originally registered  
**Expiration Date:** The expiration date for the domain  
**Registrar Data:** The [registrar](#) where the domain was registered  
**Registrant Name:** Registration Private  
**Registrant Organization:** Domains By Proxy, LLC  
**Registrant Street:** 2155 E GoDaddy Way  
**Registrant City:** Tempe  
**Registrant State/Province:** Arizona  
**Registrant Postal Code:** 85284  
**Registrant Country:** US  
**Registrant Phone:** +1.4806242599  
**Registrant Fax:** +1.4806242598  
**Registrant Email:** *the domain name@domainsbyproxy.com*

(Source: <https://in.godaddy.com/help/what-shows-in-the-whois-directory-330>)

### BEFORE WHOIS PRIVACY

Springfield Power Plant  
 Homer J. Simpson  
 742 Evergreen Terrace  
 Springfield, ST 55555  
 US  
 +1 999 555-1212  
 homer@simpsons.com

### AFTER WHOIS PRIVACY

See PrivacyGuardian.org  
 Domain Administrator  
 1928 E. Highland Ave. Ste F104  
 PMB# 255  
 Phoenix, AZ 85012  
 US  
 +1 347 871-7726  
 pw0e843e899@privacyguardian.org

(Source: <https://www.namesilo.com/support/v2/articles/domain-manager/whois-privacy>)

## WIPO Overview of WIPO Panel Views on Selected UDRP Questions (Contd.)

### ❖ How do panels address consolidation scenarios?

*“The WIPO Center may accept, on a preliminary basis, a consolidated complaint...criteria described below are **prima facie met**...Any final determination on consolidation would be made by the **appointed panel**, which may apply its discretion in certain circumstances to order the separation of a filed complaint. In all cases, the **burden falls to the party seeking consolidation** to provide evidence in support of its request.”* [Emphasis supplied]

### ❖ 4.11.2 Complaint consolidated against multiple respondents

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*“...panels look at whether (i) the domain names or corresponding websites are subject to **common control**, and (ii) the consolidation would be **fair and equitable** to all parties...”* [Emphasis supplied]

(Link: <https://www.wipo.int/amc/en/domains/search/overview3.0/#item411>)

## Factors Used to Determine Whether the Consolidation is Appropriate

- ❖ The **registrants' identity(ies)** including pseudonyms.
- ❖ The registrants' **contact information** including email address(es), postal address(es), or phone number(s), including any pattern of irregularities.
- ❖ **Relevant IP addresses**, name servers, or webhost(s).
- ❖ The **content or layout of websites** corresponding to the disputed domain names.
- ❖ The **nature of the marks** at issue (e.g., where a registrant targets a specific sector).
- ❖ Any **naming patterns** in the disputed domain names (e.g., <mark-country> or <mark-goods>).
- ❖ The **relevant language/scripts** of the disputed domain names particularly where they are the same as the mark(s) at issue.
- ❖ Any **changes by the respondent relating to any of the above items following communications** regarding the disputed domain name(s),
- ❖ Any evidence of **respondent affiliation with respect to the ability to control** the disputed domain name(s),
- ❖ Any **(prior) pattern of similar respondent behavior**, or
- ❖ Other arguments made by the complainant and/or disclosures by the respondent(s). [Emphasis supplied]

(Link: <https://www.wipo.int/amc/en/domains/search/overview3.0/#item411>)

## Relevant UDRP Decisions

- ❖ *Valeant Pharmaceuticals International, Inc. / iNova Pharmaceuticals (Australia) Pty Limited v. Luca Radu / Fundacion Private WhoIs / Maxim Conovalov / Vasju Pere* [Case No. D2013-1918]

**Trademark:** DUROMINE ; **Disputed Domain Names:** <duromineau.com>, <durominehome.com>, <durominephentermine.net> and <durominesale.com>

- “...In order to accept such Complaint and proceed to notify it on the basis of more than a single domain name holder, the **Center would typically need to be satisfied that there is at least a prima facie case for consolidation warranting consideration by a Panel.** This would typically involve the Complainant putting on at least some argument and supporting material indicating a connection or relationship between the domain names and their listed domain name holders. Even if provided, **any final determination would need to be made by the appointed Panel,** who may still order the severance of one or more of the named Respondents... This is **without prejudice to the right of the Complainants to seek to refile the remaining three Complaints**” ” [Emphasis supplied]

## Relevant UDRP Decisions (Contd.)

- ❖ *Western Union Holdings, Inc. v. Private Whois Escrow Domains Private Limited* [Case No. D2008-1675]

**Trademark:** WESTERN UNION ; **Disputed Domain Names:** <westenunionmoneytransfer.com>, <westernunioninsurance.com>, <westernunionmastercards.com>, and <westernuniopn.com>

- “...a potential complainant believes that multiple abusive domain names have been registered with a single service, it cannot from the WhoIs record tell in advance how many entities are behind these domain names and therefore the number of complaints it may need to file. **A complainant cannot be criticised in such a case for filing a single set of proceedings with the Center against the WhoIs privacy service.** Indeed, it may in practice have little choice but to do so in order to facilitate access to the identity of any “true” underlying registrant. But then **what should the Center, panel, and complainant do where, as here, the registrar in response to the Center's verification request reveals different registrant details for different names?.**” [Emphasis supplied]

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## Relevant UDRP Decisions (Contd.)

- ❖ *Western Union Holdings, Inc. v. Private Whois Escrow Domains Private Limited* [Case No. D2008-1675] (Contd.)
  - “if the Complainant chose to proceed with a single Complaint and the as yet unappointed Panel held that there was no connection between the registrants, the **Panel might elect to proceed in respect of one domain name only**. It therefore invited the Complainant “to file an amendment to the Complaint or, if no common link between the four entities is found, amend this Complaint and **file separate Complaints** as determined to be appropriate [by the Complainant]”.
  - “it is also **unfair to genuinely unrelated “true” registrants to require them to participate as co-respondents** in a single consolidated proceeding, or to expect a panel to have to decide in single case what are essentially multiple proceedings.”
  - 9 • “Perhaps in such a case the complainant **may not necessarily be required to commence fresh proceedings**, and the Panel could **direct that upon the payment of appropriate additional fees, the matter could be subdivided into “split” proceedings** with each referred to a different panelist or panelists. This approach might have the advantage of allowing the matter to proceed relatively rapidly. It would allow for **continuity of “pending” proceedings** under paragraph 8(a) of the Policy..**might not be the need for the parties to file fresh submissions.**” [Emphasis supplied]

## Relevant UDRP Decisions (Contd.)

❖ *President and Fellows of Harvard College v. World Capital Market, Ming Xu* [Case No. D2013-1982]

**Trademark:** HARVARD ; **Disputed Domain Names:** <harvardgi.org> and <harvardgi.com>

- *The Center therefore requested that Complainant either file a separate Complaint for one of the domain names and file a short amendment to drop the separately-filed domain name from the current Complaint, or file an amendment to the Complaint to omit or remove the additional domain name from the Complaint. The Center further noted that if Complainant chose to file a separate Complaint concerning one or the other domain name, corresponding fees would need to be submitted for such Complaint...*”  
[Emphasis supplied]

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## Relevant UDRP Decisions (Contd.)

- ❖ *Speedo Holdings B.V. v. Programmer, Miss Kathy Beckerson, John Smitt, Matthew Simmons* [WIPO Case No. D2010-0281]

**Trademark:** SPEEDO ; **Disputed Domain Names:** <speedopics.com> and <whitespeedos.com>

- “...paragraphs 3(c) and 10(e) of the Rules may seem to address different circumstances, both provisions in effect address consolidation of multiple domain name disputes with the presumed common goal of furthering the fundamental objectives of the Policy...the Panel does not believe that **paragraphs 3(c) and 10(e) are mutually exclusive**, or that the drafters of the Policy necessarily intended for paragraph 3(c) to abrogate the authority of panels to order the consolidation of multiple domain name disputes under paragraph 10(e) in all circumstances involving differently named domain name holders.”
- “...As noted above, **indicia of common control** have been found based on commonalities in registrant information, such as **shared administrative or technical contacts and shared postal or email addresses**, as well as other circumstances in the record indicating that the respondents are related or that a sufficient unity of interests otherwise exists that they may be essentially treated as a single domain name holder for purposes of paragraph 3(c) of the Rules...” [Emphasis supplied]

## Relevant UDRP Decisions (Contd.)

- ❖ *Yahoo! Inc. v. Aman Anand, Ravi Singh, Sunil Singh, Whois Privacy Corp., Domains By Proxy, LLC*  
[Case No. D2016-0461]

**Trademark:** YAHOO ; **Disputed Domain Names:** <helplineyahoo.com>, <myyahoaustralia.com>, <sbcyahoaustralia.com>, <yahoo-australia.net>, <yahoaustralia.net>, etc.

- “...The Panel notes that it is **not necessary for it to find that the disputed domain names are registered nominally to a single entity or person**. As noted above, the issue is whether the Respondents can be treated as a single domain name holder, because they are **involved in a common enterprise**, and whether it is procedurally fair and efficient to do so. The definition of the “Respondent” under paragraph 1 of the Rules does not exclude the “holder” of the domain name registrations from being a common enterprise, being carried out by multiple individuals” [Emphasis supplied]

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## Relevant UDRP Decisions (Contd.)

❖ *Wikimedia Foundation, Inc. v. Domain Administrator, Whois Privacy Services Pty Ltd / Yeongju Hong and Mike Kerry, Dzone Inc.* [Case No. D2015-1148]

- “...The Center provided the underlying registrant information disclosed by the Registrar to the Complainant and requested the Complainant either to **add the disclosed registrants as named respondents** providing arguments that they are under common control, or to **file a separate complaint for domain name(s) associated with different registrants**. The Complainant filed an amended Complaint, adding Yeongju Hong / Mike Kerry, Dzone Inc. as a named Respondent, but noted that the **registrant remained the same for <wikipedia.org> as Whois Privacy Services Pty Ltd**... While the Panel notes that the underlying registrant information for <wikipedia.org> was not publically available, this information was confirmed by the Registrar and provided to the Complainant...” [Emphasis supplied]
- “Therefore, the disputed domain name <wikipedia.org> will not be analyzed under this proceeding....Nevertheless, this Panel leaves the rights of the Complainant intact, regarding the disputed domain name <wikipedia.org>, should the Complainant decide to **file another complaint under the Policy in relation to said disputed domain name.**” [Emphasis supplied]

**THANK YOU!**  
**Questions?**

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