

Legal Issues in 'UDRP'

Issue: Is a Website's Content Relevant in Determining Identity or Confusing Similarity of a Domain Name?

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Introduction

❖ Rouge Websites

- Flagrantly Infringing Online Locations (“FIOLs“) or Rogue Websites are those websites which primarily and predominantly share infringing/pirated content or illegal work. The registrant details of these websites are unknown and any or all contact information is masked/blocked.

❖ Cybersquatting

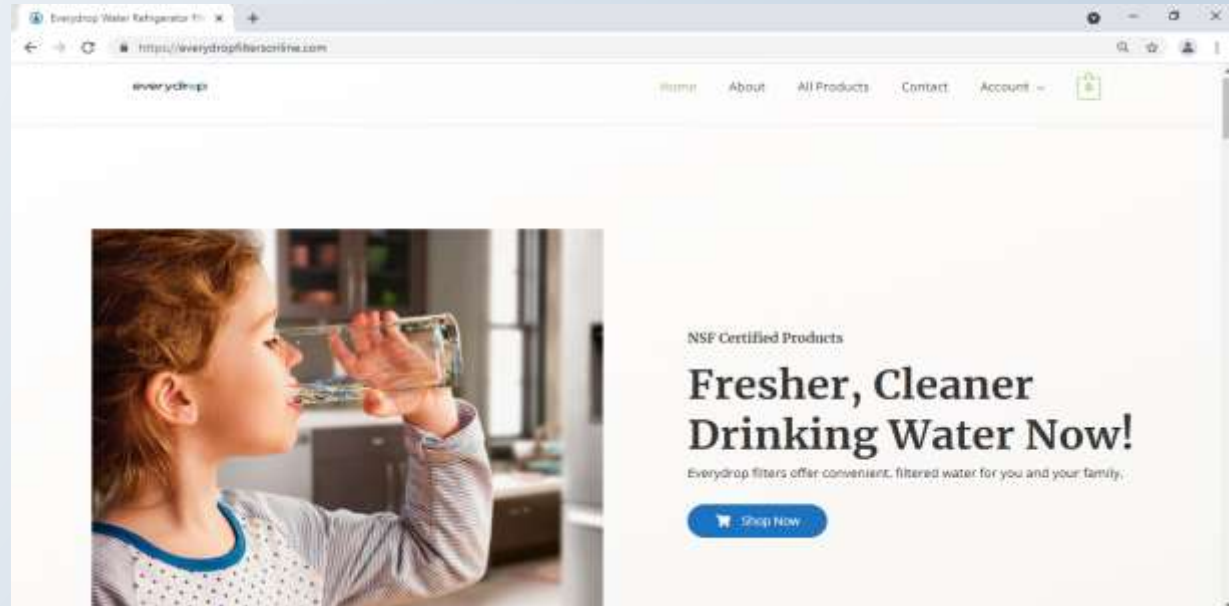
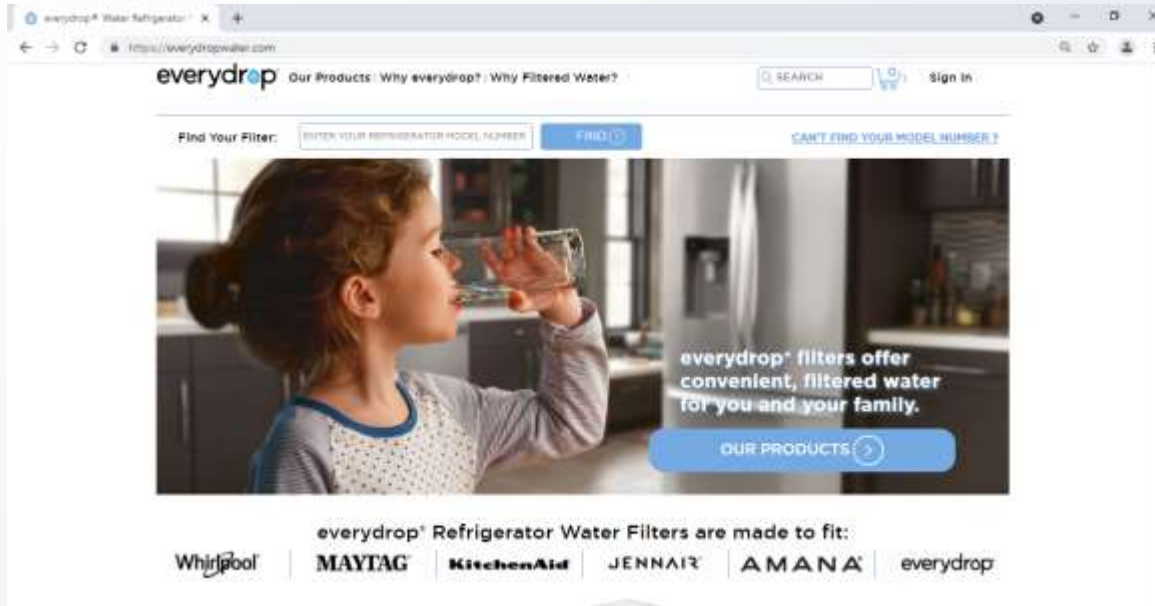
- The term cybersquatting refers to the unauthorized registration and use of Internet domain names that are identical or similar to trademarks, service marks, company names, or personal names. is buying domain names of popular business names so that they can resell it in the future at a cost. Cybersquatting involves registering website URLs of already established businesses that do not have a related website. Cybersquatting registrants obtain and use the domain name with the bad faith intent to profit from the goodwill of the actual trademark owner.

❖ Typosquatting

- Typosquatting is the practice of registering new domain names which are similar to those of well-known brands, but which contain common typing or spelling errors. Once the domain is claimed, typosquatters then have a number of strategies to profit from the domain, including those listed previously. Eg: linkdin.com instead of linkedin.com and facebook.com instead of facebook.com.

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Example of Content Similarity



Relevant Provisions

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

“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...” [Emphasis supplied]

❖ Paragraph 2, Uniform Domain Name Dispute Resolution Policy –

*“Your Representations. By applying to register a domain name, or by asking us to maintain or renew a domain name registration, you hereby represent and warrant to us 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.”* [Emphasis supplied]

WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Jurisprudential Overview 3.0”)

- ❖ The content of the website associated with the domain name is usually disregarded by panels when assessing confusing similarity under the first element.
- ❖ In some instances, panels have however taken note of the content of the website associated with a domain name to confirm confusing similarity whereby it appears prima facie that the respondent seeks to target a trademark through the disputed domain name.
- ❖ Such content will often also bear on assessment of the second and third elements, namely whether there may be legitimate co-existence or fair use, or an intent to create user confusion.

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Source: <https://www.wipo.int/amc/en/domains/search/overview3.0/#item115>

Relevant UDRP Decisions

- ❖ ***Harry Winston Inc. and Harry Winston S.A. v. Jennifer Katherman* [Case No. D2008-1267]**
 - “***The content of a website*** (whether it is similar or different to the business of a trademark owner) is ***irrelevant*** in the finding of confusing similarity. This is because trademark holders often suffer from “initial interest confusion”, where a potential visitor does not immediately reach their site after typing in a confusingly similar domain name, and is then exposed to offensive or commercial content. ***The test for confusing similarity should be a comparison between the trademark and the domain name to determine the likelihood of confusion.***” [Emphasis supplied]
 - “Accordingly, while the Panel accepts that anyone aware of the existence of the Complainants and noticing the one letter difference in the names is unlikely to be confused, the Panel believes it quite likely that people (not merely morons in a hurry) glancing at the Domain Name may well not notice the difference and believe that they are looking at ‘harrywinston’.”

Relevant UDRP Decisions (Contd.)

- ❖ ***Schering-Plough Corporation, Schering Corporation v. Dan Myers [Case No. D2008-1641]***
 - *“The aural and visual comparison of the domain names with a complainant's trademark is an important part of the issue of confusing similarity. In addition, **the content of a website may provide indication as to a respondent's targeting of a specific trademark through the domain name chosen.** Accordingly, **the context in which the domain names are being used may be helpful to assess confusing similarity.** Here, the disputed domain names direct to webpages displaying commercial links reproducing Complainants' trademarks. The Panel thus considers that Respondent has sought to take advantage of Internet users typing an incorrect address when seeking to access the Complainants' websites, a practice known as “typosquatting”” [Emphasis supplied]*

- ❖ ***The Canadian Hockey Association and The Canadian Olympic Committee v. Lin Lin [Case No. D2016-0322]***
 - *“...it is usual to disregard the content of the website to which the disputed domain name resolves, in this case that content is - in the Panel's view - **highly relevant to assessment of the intent to create confusion under the subsequent requirements of paragraphs 4(a)(ii) and (iii) of the Policy.**” [Emphasis supplied]*

Relevant UDRP Decisions (Contd.)

❖ *Bayer Healthcare LLC v. Admin, Domain [Case No. D2016-2342]*

- *“The disputed domain name incorporates the principal element ("SCHOLLS") of Complainant's trademark, leaving out the prefatory abbreviated professional identifier "DR."¹ Complainant's trademark is well-known in the United States in connection with foot care products. From the perspective of visual impression, sound and meaning, the disputed domain name is substantially similar to Complainant's trademark. An Internet user viewing the disputed domain name alone would likely confuse it with Complainant's trademark. Moreover, Respondent used the disputed domain name specifically to direct Internet users to a webpage referring to Complainant's full trademark, suggesting that Respondent relied on Internet user confusion to direct Internet users to its website. This evidence of intent to confuse on the part of Respondent reinforces the conclusion that the disputed domain name is confusingly similar to Complainant's trademark.⁸ The Panel determines that the disputed domain name is confusingly similar to Complainant's trademark.”*
[Emphasis supplied]

Relevant UDRP Decisions (Contd.)

❖ *VF Corporation v. Vogt Debra* [Case No. D2016-2650]

- “While the Complainant's **EASTPAK** mark is not as easily recognized in the disputed domain name <**bagpakonline.com**>, the PAK element of the Complainant's mark is recognizable, and is combined with the descriptive terms "bag" and "online". In addition, both of the disputed domain names resolved to an identical website displaying the Complainant's **EASTPAK** logo and products bearing the **EASTPAK** mark. Under this broader context and on balance, the Panel concludes that this disputed domain name also is confusingly similar to the Complainant's mark for purposes of the first element of the Policy.”
[Emphasis supplied]
- “...the Panel finds the Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy.”

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Relevant UDRP Decisions (Contd.)

- ❖ *Bayerische Motoren Werke AG (“BMW”) v. Registration Private, Domains By Proxy, LLC / Armands Piebalgs [Case No. D2017-0156]*
 - *“The Disputed Domain Names, as registered by the Respondents, incorporate either the BMW trademark or a contraction of the BMW trademark omitting the third letter. Previous UDRP panels have consistently held that domain names are identical or confusingly similar to a trademark for purposes of the Policy, “when the domain name includes the trademark, or a confusingly similar approximation, regardless of the other terms in the domain name...The only difference in the present case is the addition in both Disputed Domain Names of the generic word “decoder”, which is apt to describe a website providing what purports to be technical information about a specific car. This addition does not in the opinion of the Panel suffice to negate the similarity between the Disputed Domain Names and the Complainant’s BMW trademark having regard to the established principles set out below. Moreover, whereas in the case of the latter Disputed Domain Names the mark is not present in its entirety, **the content at the corresponding website serves to affirm a finding of confusing similarity.**” [Emphasis supplied]*

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THANK YOU!
Questions?

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