

the GigaLaw firm

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Q&A on Domain Name Disputes

Q: What is a domain name?

A: A domain name is a part of every Internet and e-mail address. For example, “gigalawfirm.com” is the domain name used by The GigaLaw Firm. Other well-known domain names are “cnn.com”, “hotmail.com”, “amazon.com” and millions of others. Domain names are available for registration (for annual fees as little as \$8.95) on a first-come-first-served basis.

Q: What is a domain name dispute?

A: A domain name dispute describes the situation that arises when one person or company asserts rights to a domain name that has been registered by another person or company. For example, in one of the earliest reported domain name disputes, Viacom International asserted rights to the domain name “mtv.com”, which had been registered personally by one of its employees. Ultimately, Viacom obtained the rights to the domain name.

Q: What are cybersquatters and typosquatters?

A: A cybersquatter is a person who, in bad faith, registers a domain name that contains a trademark owned by someone else. A typosquatter is a person who, in bad faith, registers a domain name that contains a common typographical misspelling of a trademark owned by someone else.

Q: What rights does a trademark owner have against a cybersquatter or typosquatter?

A: Depending on the facts of the case, a trademark owner may have a claim for trademark infringement or trademark dilution against a cybersquatter or typosquatter. In addition, in response to the problem of domain name disputes, the U.S. Congress in 1998 passed a law called the Anticybersquatting Consumer Protection Act (ACPA), which allows trademark owners to obtain domain names and offers the possibility of significant damages awards; in one case, a court ordered a cybersquatter to pay Electronics Boutique \$500,000 for registering five domain names that contained the company’s trademarks.

Q: Do trademark owners have any rights without going to court?

A: Yes. Under the Uniform Domain Name Dispute Resolution Policy (UDRP), a trademark owner can file an arbitration complaint and seek the transfer of one or more domain names registered by someone else. This is a very popular approach that has been described as “the preferred option for most trademark owners” by Corporate Counsel magazine. More than 6,000 disputes have been decided under the UDRP since it was adopted in 1999.

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Q: What are the advantages of the UDRP?

A: Unlike traditional litigation, filing a complaint under the UDRP is a straightforward process that results in a quick decision without significant legal fees. The policy is very favorable to trademark owners; more than 80% of reported decisions under the UDRP have been decided in favor of the party that files the complaint.

Q: What does the UDRP require a trademark owner to prove?

A: To prevail under a UDRP complaint and obtain a transfer of a domain name, a trademark owner must prove three elements: (1) the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights, (2) the registrant of the domain name has no rights or legitimate interests in respect of the domain name, and (3) the domain name has been registered and is being used in bad faith.

Q: What does the UDRP cost?

A: A trademark owner that files a complaint under the UDRP must pay a filing fee of about US\$1,500 (depending on the case), plus legal fees. The amount of the legal fees varies depending upon a number of factors, including the trademark(s) involved, the number of domain names at issue and what use, if any, the current registrant has made of the relevant domain name(s). (A domain name registrant that wants to *defend* itself against a UDRP complaint need not pay any filing fees.)

Q: Does an attorney need to file or defend a UDRP complaint?

A: No, but there are significant reasons to consider using an attorney experienced in UDRP proceedings, because the process is unusual. **Doug Isenberg, an attorney and founder of The GigaLaw Firm, has been advising clients on domain name disputes since 1996 and has obtained numerous victories for clients under the UDRP. He has represented clients before two of the leading organizations that decide UDRP complaints, the World Intellectual Property Organization (WIPO) and the National Arbitration Forum. Isenberg also serves as a domain name panelist for WIPO, appointed to decide disputes (for non-clients) under the UDRP.** This role at WIPO has provided Isenberg with additional insight into the procedural and substantive aspects of the UDRP process, thereby enhancing his ability to represent clients involved in UDRP disputes.

To discuss a domain name dispute with Doug Isenberg at The GigaLaw Firm, call 1-404-348-0368, or e-mail disenberg@GigaLawFirm.com.