

Collection of WIPO Domain Name Panel Decisions



WIPO Arbitration and Mediation Center
(Eun-Joo Min and Mathias Lilleengen, eds)

KLUWER LAW INTERNATIONAL

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1. Introduction

This publication contains a selection of decisions rendered by panels appointed by the World Intellectual Property Organization (WIPO) Arbitration and Mediation Center (WIPO Center) in Internet domain name disputes subject to the Uniform Domain Name Dispute Resolution Policy (UDRP). It offers insight into the procedural mechanics of the UDRP and illustrates how WIPO panels have answered the main legal questions that have emerged in UDRP cases.

The WIPO Center offers services for the resolution of commercial disputes between private parties involving intellectual property through procedures other than court litigation. Based in Geneva, Switzerland, the WIPO Center advises on, and administers, procedures conducted under the WIPO Arbitration, Expedited Arbitration and Mediation Rules. WIPO dispute clauses typically are found in patent, trademark, and software licensing agreements, as well as in research and development contracts and pharmaceutical and other distribution agreements.

In addition to administering arbitration and mediation cases under the WIPO Rules, the WIPO Center is involved in the design and implementation of dispute resolution procedures for specific types of intellectual property disputes. The most prominent example, and the basis for the present publication, is the UDRP, which is based on recommendations made by WIPO to address certain abusive practices in the domain name system. Since commencing its domain name dispute resolution service in December 1999, the WIPO Center has processed over 5,000 UDRP cases.

Established as a time- and cost-effective alternative to court litigation, the UDRP provides holders of trademark rights with an administrative mechanism for the resolution of disputes arising out of bad-faith registration and use of domain names corresponding to those trademark rights. The UDRP forms a mandatory part of the registration conditions for generic top-level domains, such as .com, .net, .org, .biz and .info, and it is also adopted by the registration authorities of a growing number of country code top-level domains.

Trademark owners seeking the transfer of a domain name may file a complaint with the WIPO Center, or another accredited UDRP dispute-resolution service provider, in which they must establish the following (UDRP, Paragraph 4(a)):

- (i) the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and

- (ii) the domain name registrant has no rights or legitimate interests in respect of the domain name in question; and
- (iii) the domain name has been registered and is being used in bad faith.

Decisions on the complaints are rendered by independent panelists selected by the WIPO Center on the basis of their impartiality and sound judgment as well as their experience and expertise in trademark law, electronic commerce and Internet-related issues.

Together, WIPO panelists have already issued over 4,000 UDRP decisions. The present publication contains 45 examples of these decisions. They have been selected to provide a broad overview of the mechanics of the UDRP, the principal legal issues that have arisen, and how WIPO panels have tended to resolve such issues. As such, this compilation is not intended as an endorsement of these particular decisions, but rather to illustrate broad decision trends, while also including issues on which views diverge.

The decisions are set out in the order of the cases, as listed in the chronological index. In addition, this publication contains a legal index outlining the issues which the respective decisions illustrate in particular. Certain formal issues are set out first, followed by substantive criteria in the order in which these criteria are stated in the UDRP. Many of the included decisions are relevant to more than one of the indexed issues.

The decisions may be read in conjunction with the Annexes to this publication, which include the UDRP Policy and Rules and the WIPO Model Complaint and Response. The decisions have been subject to minor clerical editing, to ensure consistent use of terminology or protection of certain contact data. The original version of all decisions is available on the Center's web site at <http://arbiter.wipo.int/domains/decisions/>.

For those interested in a more comprehensive overview, in more particular legal or factual issues, or in an update on newly issued decisions, the WIPO Center makes available on its web site an extensive legal Index of WIPO UDRP Decisions (<http://arbiter.wipo.int/cgi-bin/domains/search/legalindex>). Created to facilitate the consistency of decisions and the transparency of the process, the WIPO Index is used by parties to assist them in formulating complaints and responses, by panelists for drafting reasoned decisions, and by the general public to attain easy access to WIPO UDRP jurisprudence. An off-print of the home page of the WIPO Index is included in the Annexes to the present publication.

The web site of the WIPO Center contains extensive information about WIPO arbitration, mediation, and domain name dispute resolution. The WIPO Center may be contacted as follows:

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2. Administrative Panel Decisions 2000

2.1 Administrative Panel Decision of 18 February 2000 in Case No. D2000-0003

Parties:

Complainant Telstra Corporation Limited
Respondent Nuclear Marshmallows

Panel:

Andrew F. Christie (Sole Panelist)

Published in:

<http://arbiter.wipo.int/domains/decisions/html/2000/d2000-0003.html>

Subject matters:

- The Complainant must prove both that the domain name was registered in bad faith and that it is being used in bad faith.
- Inaction or passive holding of the domain name can, in certain circumstances, constitute a domain name being used in bad faith. Supporting circumstances may include evidence that: (i) the Complainant's mark has a strong reputation and is widely known; (ii) the Respondent has provided no evidence of actual or contemplated good faith use of the domain name; (iii) the Respondent has taken active steps to conceal its true identity; (iv) the Respondent has provided false contact details; and (v) any legitimate actual or contemplated use of the domain name by the Respondent would be inconceivable.

1. THE PARTIES

1.1 The Complainant is Telstra Corporation Limited, a company incorporated in Australia, with its registered office in Melbourne, Australia. The Respondent is Nuclear Marshmallows. Nuclear Marshmallows is an unregistered business name of an unidentifiable business entity. The address of the Respondent as contained in the domain name registration is a post office box in Gosford, NSW, Australia. The administrative and billing Contact provided for the domain name registered by the Respondent is a Michael Jenkins.

2. THE DOMAIN NAME AND REGISTRAR

2.1 The domain name that is the subject of this Complaint is <telstra.org>. The Registrar of this domain name is Network Solutions, Inc. of Herndon, Virginia, USA.

3. PROCEDURAL HISTORY

ISSUANCE OF COMPLAINT

3.1 A Complaint made pursuant to the Uniform Domain Name Dispute Resolution Policy implemented by the Internet Corporation for Assigned Names and Numbers (“ICANN”) on 24 October, 1999 (the “Policy”), and under the Rules for Uniform Domain Name Dispute Resolution Policy implemented by ICANN on the same date (the “Rules”), was submitted electronically to the World Intellectual Property Organization Arbitration and Mediation Center (the “Center”) on 4 January, 2000. A paper original of the Complaint together with annexures and the required fees were forwarded by courier under cover of a letter of the same date, and received by the Center on 10 January, 2000. An Acknowledgment of Receipt was sent by the Center to the Complainant, by facsimile and email dated 10 January, 2000.

3.2 A copy of the Complaint was dispatched by courier to the Registrar on 5 January, 2000, and delivered to the Registrar on 7 January, 2000. By email to the Center on 7 January, 2000, the Registrar confirmed that it is the Registrar of the domain name <telstra.org>; confirmed that the current registrant of that domain name is the Respondent, Nuclear Marshmallows; informed that the administrative, technical, zone and billing Contact for the Respondent is Michael Jenkins; and provided a postal and an email address, and a telephone and a facsimile number, for the Contact. The Registrar also supplied the terms of the domain name service agreement between it and the Respondent. Amongst other things, that agreement provides that the Respondent agrees to be bound by the domain name dispute policy incorporated therein. The policy incorporated into the agreement is the Policy.

NOTIFICATION TO RESPONDENT

3.3 Having verified that the Complaint satisfied the formal requirements of the Policy and the Rules, the Center issued to the Respondent on 12 January, 2000, a Notification of Complaint and Commencement of Administrative Proceeding (including a copy of the filed Complaint), to both the postal and email addresses of the Respondent, and to the facsimile of the Respondent’s Contact, as provided by the Registrar. Copies of this Notification of Complaint were sent to the Complainant, the Registrar and ICANN on the same date.

3.4 On 14 January, 2000, an email was received by the Center from the email address of Nuclear Marshmallows’ Contact, saying in full “cannot read attachment”. On that day, the Center replied to the Contact by email, attaching the Notification of Complaint in four different formats in four separate transmissions, and inviting the Contact to specify any other format required. No response to these emails was received. Moreover, no response to the postal dispatches of the Notification of Complaint to the Respondent was received. Furthermore, all attempts to transmit the Notification of Complaint to the

Respondent by facsimile failed. Having reviewed the communications records in the case file, the Administrative Panel finds that the Center has discharged its responsibility under paragraph 2(a) of the Rules “to employ reasonably available means calculated to achieve actual notice to Respondent”.

3.5 Having received no response from the Respondent within the specified time in the Notification of Complaint, on 3 February, 2000, the Center issued to both parties a Notification of Respondent Default. On 4 February, 2000, the Center issued to both parties a Notification of Appointment of Administrative Panel and Projected Decision Date. This Notification informed the parties that the Administrative Panel would be comprised of a single Panelist, Dr Andrew Christie.

4. FACTUAL BACKGROUND

4.1 The Complaint asserted, and provided evidence in support of, and the Administrative Panel finds established, the following facts.

COMPLAINANT'S ACTIVITIES

4.2 The Complainant is the largest company listed on the Australian stock exchange, having a market capitalisation of approximately \$A62 billion. It is the largest provider of telecommunications and information services in Australia, with financial year 1998–99 revenue exceeding \$A16 billion. The Complainant’s main activities, each of which is carried out under or by reference to the TELSTRA mark, are the provision of a fixed telephony network to residences and businesses across Australia; the provision of local, long distance domestic and international telephone call services to over 7 million residential and business customers in Australia; the provision of 78,000 public pay-phones in Australia; the operation of mobile telecommunications services to 3.4 million customers; the provision of a range of data, Internet and on-line services (including the largest Internet Service Provider in Australia); the provision of wholesale services to other telecommunications carriers and service providers; the provision of directory information and connection services to over 520 million calls per annum; the publication and distribution of white pages and yellow pages directories in hard-copy, CD-ROM and on-line formats; and the operation of over 80 retail outlets throughout Australia.

COMPLAINANT'S TRADING NAME AND TRADEMARKS

4.3 The predecessor in title to the Complainant’s business can be traced back to 1901. In April 1993 the Complainant changed its legal name to Telstra Corporation Limited. It has traded under the name “Telstra” outside Australia since that date, and within Australia since July 1995. The Complainant is the proprietor of more than 50 registrations in Australia of trademarks consisting of or containing the word “TELSTRA” (details of which are contained in Annexure 3 to the Complaint), including a number of registrations

in class 38 in respect of telecommunications services. The various trademark registrations and applications cover an extensive range of goods and services, and span 17 of the 42 trademark classes. As well, the Complainant has registered, or applied for registration of, a range of trademarks consisting of or containing the word “TELSTRA”, in a large number of countries, such as Brunei, Cambodia, France, Germany, Hong Kong, Indonesia, Ireland, Japan, Kazakhstan, Kiribati, Korea, Laos, Malaysia, Mauritius, New Zealand, Papua New Guinea, People’s Republic of China, South Africa, Russian Federation, Saudi Arabia, Singapore, Taiwan, The Philippines, Tonga, United Kingdom, United States of America, Vanuatu, Vietnam and Western Samoa. In addition, the Complainant has obtained a registered Community Trade Mark for a trademark including the word “TELSTRA”. Details of the trademark registrations in countries outside Australia are set out in Annexure 4 to the Complaint.

COMPLAINANT’S DOMAIN NAMES AND WEB SITES

4.4 The Complainant is the registrant of the following domain names containing the word “TELSTRA”:

- <telstra.com>
- <telstra.net>
- <telstra.com.au>
- <telstra-inc.com>
- <telstrainc.com>

4.5 The Complainant operates its principal web site at <telstra.com>. The site includes electronic customer services for its fixed-line and mobile-phone customers, news and entertainment services, and White Pages and Yellow Pages directories.

RESPONDENT’S IDENTITY AND ACTIVITIES

4.6 The Respondent is the registrant of the domain name <telstra.org>, the Registrar of which is Network Solutions, Inc. This domain name does not resolve to a web site or other on-line presence.

4.7 The postal address of the Respondent and its Contact, as contained in the Registrar’s registry, is a post office box in a town in the State of New South Wales, Australia. The registers of company names and business names in Australia do not disclose a registration of a company name or business name for the Respondent’s name, Nuclear Marshmallows. Accordingly, it is not possible to identify the legal entity conducting business in Australia under the Respondent’s name.

4.8 Prior to the issuing of the Complaint, the Complainant made substantial efforts to identify and contact the Respondent, using the details then current on the Registrar’s registry. During the course of these attempts, some of the contact details of the Respondent