

**Theft Of Domain Names:
How Do You Get Your Stolen Doman Name Back?**
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- I. What is a domain name and what can a domain name be used for?
- A. Web site
1. Informational Web sites (sometimes called static web sites).
www.BrownWelsh.com
 2. eCommerce Web sites (you can make money from the web).
www.Amazon.com
- B. eMail (you need email to be taken seriously in today's business). How do you feel about doing business with someone whose email address is SweetCakes@aol.com?
- C. eCommerce portal
- D. There are lots of gTLDs (global top level domain names), such as (this list was pulled from <http://www.norid.no/domreg.html>):
1. .com – commercial
 2. .net – networks
 3. .org – organizations
 4. .aero – aviation
 5. .biz – business organizations
 6. .cat – Catalan language and culture
 7. .coop – co-operative organizations
 8. .edu – educational
 9. .gov – United States government (federal and state)
 10. .info – information
 11. .int – international organizations
 12. .jobs – jobs
 13. .mil – United States Department of Defense
 14. .mobi – mobile devices
 15. .museum – museums
 16. .name – personal

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17. .travel – traveling

E. The top twenty domains registered are (according to <http://domainworldwide.com>) as of February 7, 2008 (you should note these numbers have not changed since at least September 15, 2006, which makes their validity suspicious):

Rank	Domain	Registered	Percentage	Designation
1	.COM	21,336,063	49.76%	Commercial
2	.DE	5,459,604	12.73%	Germany
3	.NET	3,631,270	8.47%	Network
4	.CO.UK	3,080,659	7.18%	UK Commercial
5	.ORG	2,333,855	5.44%	Organization
6	.INFO	828,223	1.93%	Information
7	.IT	681,779	1.59%	Italy
8	.BIZ	666,399	1.55%	Business
9	.NL	617,045	1.44%	Netherlands
10	.CC	581,147	1.36%	Cocos Islands
11	.TV	473,168	1.10%	Tuvalu
12	.COM.AR	463,571	1.08%	Argentina
13	.CH	442,512	1.03%	Switzerland
14	.BR	406,355	0.95%	Brazil
15	.CO.KR	403,556	0.94%	South Korea
16	.DK	378,996	0.88%	Denmark
17	.US	315,215	0.74%	United States
18	.CA	272,071	0.63%	Canada
19	.COM.AU	254,168	0.59%	Australia Commercial
20	.WS	253,029	0.59%	Samoa
Total		42,878,685	100.00%	

F. Each country has its own domain name (ccTLDs – country code top level domains) and may have sub-domain names, such as www.royal.gov.uk or www.ryderamies.co.uk.

- G. The fifteen top countries registering domain names as of February 7, 2008 are (according to <http://www.webhosting.info/domains/>):

1	United States	61,813,579
2	Germany	5,223,639
3	United Kingdom	3,451,458
4	Canada	3,038,485
5	China	2,757,231
6	France	2,102,844
7	Australia	1,998,481
8	HongKong S.A.R	1,763,767
9	Japan	1,201,459
10	Spain	1,096,384
11	Bahrain	1,045,987
12	Italy	866,156
14	Korea	859,648
15	The Netherlands	839,045
	Total	88,058,163

As of August 28, 2006, there were only 65,639,159 registered domain names. This is an increase of 22,419,004 domains in 528 days, or 23.6% growth in a year. With the exception of Bahrain joining the list (and Panama dropping from the list) and Spain dropping from 8 to 10, the order of the list has not changed in the 18 months or so.

- H. All together, there are about 250 top level domain names.

II. How many domain names do I need?

- A. It depends on your goals and strategies. There are 61,813,579 registered domain names in the United States as of February 7, 2008 according to <http://www.webhosting.info/domains>. This means most businesses have more than one domain name.
- B. Each top level domain is regulated separately and has its own restrictions, depending on who sponsors the top level domain.
1. You may be able to only get one domain name.
 2. You may be required to have an office or do business “in country.”
- C. Brown & Welsh, P.C. (a local law firm) has eight domain names, despite its small size in comparison to other United States businesses.

1. BrownWelsh.com is our major web site.
2. ACPIL.net goes to our private international law web page on BrownWelsh.com (sometimes called “deep drilling” to a “non-splash” page on a web site) (on a legal topic).
3. CTevictions.com goes to our evictions web page on BrownWelsh.com (deep drilling on a legal topic).
4. CTUCC9.com goes directly to our Uniform Commercial Code Article 9 web page on BrownWelsh.com (deep drilling on a legal topic).
5. UCC9.INFO goes directly to our Uniform Commercial Code Article 9 web page on BrownWelsh.com (deep drilling on a legal topic).
6. YBRA.us goes directly to our web page on BrownWelsh.com that deals with this series of cases (deep drilling on cases for a particular client).
7. TJWelsh.com goes directly to Thomas J. Welsh’s web page on BrownWelsh.com (deep drilling on a person in the firm).
8. HPLowry.com goes directly to Houston Putnam Lowry’s web page on BrownWelsh.com (deep drilling on a person in the firm).

D. You can have a domain name for:

1. A company (such as www.BrownWelsh.com).
2. A product line (such as www.Chevrolet.com).
3. A single product or service (such as www.Pkzip.com).

III. Purchasing a domain name.

A. Domain names can be purchased online.

1. When you purchase a domain name, you agree to the top level domain name’s dispute resolution procedures.

B. Domain names must be purchased from an accredited registrar. There are hundreds of accredited registrars, such as GoDaddy.com. According to

www.webhosting.info/registrars, the top thirty registrars as of February 7, 2008 are:

	Name	Country	Percentage	# domains
1	GO DADDY	United States	32.74%	22,126,336
2	ENOM	United States	12.16%	8,216,447
3	NETWORK SOLUTIONS	United States	7.72%	6,674,556
4	TUCOWS	Canada	9.02%	6,093,320
5	MELBOURNE IT	Australia	7.22%	4,881,028
6	SCHLUND+PARTNER	Germany	3.84%	3,987,035
7	WILD WEST DOMAINS	United States	4.09%	2,762,952
8	MONIKER	United States	3.86%	2,608,570
9	REGISTER.COM	United States	3.77%	2,548,981
10	PUBLIC DOMAIN REGISTRY	United States	2.60%	1,757,583
11	KEY-SYSTEMS	Germany	2.03%	1,369,815
12	DIRECTNIC	United States	1.77%	1,195,071
13	DOTSTER	India	1.72%	1,164,193
14	FABULOUS.COM	Australia	1.66%	1,119,124
15	35.COM	China	1.60%	1,084,743
	Totals		95.79%	67,589,754

- C. Domain names are fairly cheap – they can usually be purchased for less than \$10 per year. Even if you pay \$35 per year for your domain name, it is still cheaper than almost any other single purchase you make over the year.
- D. Domain names are titled, or registered, to a particular person. This information can be found at a variety of sources, such as www.betterwhois.com and www.whois.net.
 - 1. The ownership information is called the “whois” information.
 - 2. The owner of a domain can sell it, or transfer title, to another person.
 - 3. Like any other business asset, it is important for the business to own it.

IV. Internet Corporation For Assigned Names and Numbers’ (ICANN) Uniform Dispute Resolution Policy (UDRP) which governs .com, .net and .org.

- A. ICANN itself does not decide disputes. It merely developed the rules and accredits the organizations that administer the dispute resolution process. The rules became effective for all registrars on December 1, 1999.

- B. Each registrar has supplemental rules to implement the UDRP.
- C. Each person who buys the most common gTLDs (.com, .org and .net) must agree to this dispute resolution procedure (commonly called UDRP) developed by ICANN. Other procedures govern other gTLDs and ccTLDs.
- D. The first and foremost factor to remember is there is no hearing, which means this is a DOCUMENTS ONLY proceeding.
 - 1. Documents are filed in both paper format and electronic format.
 - 2. Certain things **MUST** be in the complaint or it will not be deemed to be administratively compliant (and ultimately rejected if not corrected):
 - a. Request that the complaint be submitted for decision in accordance with the UDRP and the rules.
 - b. Provide the name, postal and e-mail addresses, and the telephone and fax numbers of the Complainant and of any representative authorized to act for the Complainant in the administrative proceeding.
 - c. Specify a preferred method for communications directed to the Complainant in the administrative proceeding (including person to be contacted, medium, and address information) for each of (A) electronic-only material and (B) material including hard copy.
 - d. Designate whether Complainant elects to have the dispute decided by a single-member or a three-member Panel and, in the event Complainant elects a three-member Panel, provide the names and contact details of three candidates to serve as one of the Panelists (these candidates may be drawn from any ICANN-approved Provider's list of panelists).
 - e. Provide the name of the Respondent (domain-name holder) and all information (including any postal and e-mail addresses and telephone and fax numbers) known to Complainant regarding how to contact Respondent or any representative of Respondent, including contact information based on pre-complaint dealings, in sufficient detail to allow the Provider to send the complaint.
 - f. Specify the domain name(s) that is/are the subject of the complaint.

- g. Identify the Registrar(s) with whom the domain name(s) is/are registered at the time the complaint is filed.
- h. Specify the trademark(s) or service mark(s) on which the complaint is based and, for each mark, describe the goods or services, if any, with which the mark is used (Complainant may also separately describe other goods and services with which it intends, at the time the complaint is submitted, to use the mark in the future).
- i. Describe, in accordance with the Policy, the grounds on which the complaint is made.
- j. Specify, in accordance with the Policy, the remedies sought.
- k. Identify any other legal proceedings that have been commenced or terminated in connection with or relating to any of the domain name(s) that are the subject of the complaint.
- l. State that a copy of the complaint, together with the cover sheet as prescribed by the Provider's Supplemental Rules, has been sent or transmitted to the Respondent (domain-name holder).
- m. State that Complainant will submit, with respect to any challenges to a decision in the administrative proceeding canceling or transferring the domain name, to the jurisdiction of the courts in at least one specified Mutual Jurisdiction.
- n. Verify the Complaint in accordance with the specific language required (meaning the complaint is essentially under oath).
- o. Annex any documentary or other evidence, including a copy of the Policy applicable to the domain name(s) in dispute and any trademark or service mark registration upon which the complaint relies, together with a schedule indexing such evidence.

E. There are four agencies that administer UDRP cases:

- 1. National Arbitration Forum (NAF) (more than 6,600 cases since inception and 1,369 cases in 2005).
 - a. Their forms are at:
<http://domains.adrforum.com/main.aspx?itemID=528&hideBar=Fa>

[lse&navID=233&news=26](#) The forms make sure you meet the minimum UDRP requirements for filing a proceeding.

- b. 1-3 domain names; single member panel: \$1,300.00
 - c. 1-3 domain names; three member panel: \$2,600.00
2. World Intellectual Property Organization (WIPO) (more than 8,500 cases since inception and 1,361 cases in 2005).
 - a. Their forms are at:
<http://wipo.int/amc/en/domains/complainant/index.html>
 - b. 1-5 domain names; single member panel: \$1,500.00
 - c. 1-5 domain names; three member panel: \$4,000.00
 3. CPR International Institute for Dispute Resolution (which seems to do 25 or fewer cases a year).
 - a. Their forms are at:
http://www.cpradr.org/ICANN_Filing.asp?M=7.5
 - b. 1-2 domain names; single member panel: \$2,000.00
 - c. 1-2 domain names; three member panel: \$4,500.00
 4. Asian Domain Name Dispute Resolution Centre (which seems to do less than 25 cases a year).
 - a. Their forms are at:
http://www.adndrc.org/adndrc/hk_download.html
 - b. Single domain name dispute for a single member panel: \$1,000.00
 - c. Single domain name dispute for a three member panel: \$2,500.00
- F. Each agency has their own Panel list of who will hear and decide cases. When three person panel are chosen, the parties spend a lot of time researching the past decisions of the person they nominate.
- G. What are my remedies?
1. You can have the offending registration cancelled, but why would you do that? Someone else might simply buy it up.
 2. The domain name can be transferred to you (in which case, you need to pay the renewal fees).

- H. What do I need to prove to win?
1. the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights.
 - a. You may have a registered trademark or service mark.
 - b. You may have common law rights to your mark. This is harder to prove, so you should consider registering your trademark.
 2. Respondent has no rights or legitimate interests in respect of the domain name. Respondent can demonstrate such rights by:
 - a. before any notice of the dispute, Respondent's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services.
 - b. Respondent (as an individual, business, or other organization) have been commonly known by the domain name, even if Respondent has acquired no trademark or service mark rights.
 - c. Respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.
 3. Respondent registered and uses the domain in bad faith, which can be shown by:
 - a. circumstances indicating Respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of respondent's documented out-of-pocket costs directly related to the domain name.
 - b. Respondent registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that Respondent has engaged in a pattern of such conduct.

- c. Respondent registered the domain name primarily for the purpose of disrupting the business of a competitor.
- d. by using the domain name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's web site or location or of a product or service on Respondent's web site or location.

V. War stories: How did the cases turn out?

- A. Complainants tend to win more of the uncontested cases (about 35% of the cases filed) than the contested cases.
- B. Adding geographical designations does not avoid the problem
example: HPcanada.com and SoyLifeCA.com
- C. Simply using a domain name that forwards to another web site invites a higher level of scrutiny.
example: Thriftyairportparking.com
- D. Providing false WHOIS contact information creates a presumption of bad faith.
example: Agent Host v. Host Dot Com Investments
 - 1. Failing to keep your WHOIS information does not create much sympathy, but at least it doesn't create a presumption of bad faith
example: Mattel, Inc. v. KPF, Inc.
 - 2. If you disclaim an interest in special words, that disclaimer may come back from the trademark proceeding to haunt you in the UDRP proceeding.
example: Soylifeca.com
- E. Delay in bringing a proceeding can have significant consequences.
 - 1. There are no hard and fast rules. It seems to be a question of "sleeping on your rights" based upon the totality of the circumstances (When does the Respondent gain rights to a domain name it has been using?)

Case	Docket #	Acquired	Not acquired
Opus Northwest Construction v. Opus Realty	FA0408000318960	10 years	

VideoCall Company v M Koenig c/o Tecton LLC	FA0307000167922	5.3 years	
Target Brands, Inc. v. 4160894 Canada Inc.	FA0401000227648	4 years	
Target Brands, Inc. v. ALDnet Media Group	FA0401000227647	1.75 years	
Global Informational Licensing v. Bankers Online	FA0405000267427		4 months

2. When an active domain name was deleted and the original owner took no action for more than 3 months (allowing the new owner to put up a *bona fide* web site), the new owner had acquired rights and prevented the transfer of the domain name.

Example: Yupi Internet Inc. v. Mercantil Inc.

F. Don't expect to be able to name a web site after your dead pet guinea pig, who just happens to be named after a famous trademark.
example: YUM! Brands v. Ether Graphics a/k/a Andrew Gruner

G. Is a trademark and the word "sucks" a problem?
Majority view: there is confusion.
Minority view: there is no confusion.
example: HomeDepotSucks.com (which is a minority case, but I decided it)

H. A person acquires common law rights to their name, which are retained after death.
example: MarlonBrando.net

I. The Respondent must show personal rights to the domain name. The Respondent cannot show a third party has rights and try to use those rights.
example: BarbieBell.com

J. If someone registers a domain name with your permission, you cannot use the UDRP to get it back. You are stuck with going to court.
example: FunJetVacations.net