



An Overview of Entertainment and Sports Domain Disputes

By Bobby Desmond

Introduction

Virtually every sport and nearly every facet of the entertainment industry has been targeted by cybersquatters seeking to profit off the goodwill and reputation of a celebrity or organization through an abusive domain name. The Anticybersquatting Consumer Protection Act (ACPA) allows trademark owners to pursue civil actions against those who, in bad faith, register a domain name that is identical or confusingly similar to a mark.¹ However, filing and trying such a lawsuit takes considerable time and expense. Fortunately, there is a quicker and less costly way to resolve domain name disputes.

The Uniform Domain Name Dispute Resolution Policy (policy)² was adopted in 1999 by the Internet Corporation for Assigned Names and Numbers (ICANN),³ and the current set of related rules were implemented in 2015 (rules).⁴ The policy and the rules apply to domain names that use (i) generic top level domains such as <.com>, <.net>, and <.org>; (ii) certain country code top level domains that have adopted the policy on a voluntary basis such as <.au>, <.cn>, and <.es>; or (iii) one of the more than 1,300 New gTLDs, such as <.gay>, <.mobile>, and <.latino>.⁵ Registrations that use any other top level domain are subject to different domain dispute policies.⁶

The policy provides a mandatory online alternative dispute resolution method by which a trademark owner (complainant) may institute a proceeding against a cybersquatter (respondent) to request cancellation or transfer of a domain

name that infringes upon the mark.⁷ However, cancellation is generally advised against because it leaves open the possibility of the respondent immediately re-registering the domain name—which would, in turn, require the complainant to file a second complaint for the same domain name.⁸

I. Policies and Procedures⁹

A. Complaint and Response

The complainant must electronically file a complaint¹⁰ before the World Intellectual Property Organization's Arbitration and Mediation Center (WIPO)¹¹ or the Forum¹² (each, a "provider").¹³

The complaint must include the contact information of the complainant and the respondent;¹⁴ a preferred method of communication; the domain name(s) and associated registrar(s); the marks; the remedy sought; an identification of any other relevant legal proceedings; and a signed statement that the complainant submits to the jurisdiction of the courts in at least one specific mutual jurisdiction.¹⁵ The complaint must also provide evidence of (i) the manner in which the domain name is identical or confusingly similar to the mark, (ii) why the respondent has no rights or legitimate interests in the domain name, and (iii) the manner in which the domain name was registered and is being used by the respondent in bad faith.¹⁶

After a complaint is filed, the provider will submit a request for the registrar to lock the domain name during the

proceedings.¹⁷ From the commencement of the proceeding until 15 business days after it has concluded (and during any pending court proceeding), the respondent may not transfer the domain name to another holder or registrar—except that the respondent may transfer the domain name to another registrar during a pending court proceeding if the dispute remains subject to the policy.¹⁸

Once the provider confirms that the complaint satisfies the minimum requirements of the policy, the provider notifies the respondent of the commencement of the proceeding.¹⁹ Within 20 days of the commencement of the proceeding, the respondent may submit a response in electronic form, which responds to the allegations of the complaint and includes any and all bases for the respondent to retain registration and use of the domain name.²⁰ This deadline must be extended by an additional four days upon the respondent's request,²¹ and this deadline may be further extended by the panel in exceptional circumstances.²² The response must include the respondent's contact information; a preferred method of communication; an identification of any other relevant legal proceedings; a signed statement; and relevant evidence.²³ If no response is submitted, the panel will decide the dispute based solely upon the complaint, unless exceptional circumstances exist.²⁴

The complainant must elect to have the proceeding decided by a single panelist or a three-member panel.²⁵ It must pay for the cost of the proceeding, except in cases where the respondent seeks to expand from a single panelist to a three-member panel.²⁶ In such cases, the fee is split evenly.²⁷

Unless either party selects a three-member panel, the provider will appoint a panelist within five calendar days of receiving the response or the lapse of the time period to submit a response.²⁸ The panel must be impartial and independent, and the panelists must disclose to the provider any circumstances giving rise to justifiable doubt as to their impartiality or independence.²⁹ All communications between the panel and either party must be made through a case administrator appointed by the provider.³⁰ The panel shall treat the parties with equality; conduct the proceeding with due expedition; and determine the admissibility, relevance, materiality, and weight of the evidence.³¹

B. Consolidation

The panel may also decide to consolidate multiple disputes into a single proceeding,³² if the domain names are registered by the same Registrant.³³ More specifically, consolidation is permitted where the complainant shows that the domain names “are subject to common control” and the panel determines that consolidation is procedurally efficient, fair, and equitable to all parties.³⁴

The provider must first determine whether there is a *prima facie* case to permit consolidation.³⁵ If the panel later finds otherwise, it may permit separation of the proceedings.³⁶

Examples of evidence that support consolidation include, but are not limited to, proof that (i) the domain names are registered in the same person's name,³⁷ (ii) the domain names are registered to different people or organizations that share the same contact information,³⁸ (iii) the domain names are registered to registrants in the same country,³⁹ (iv) the domain names are registered with fictitious names or addresses,⁴⁰ (v) the domain names use the same or similar naming patterns or structures,⁴¹ (vi) the domain names resolve to websites with the same or similar layouts, menus, fonts, logos, or content,⁴² (vii) the domain names resolve to websites that are engaged in the same or similar bad faith behavior, such as allowing users to access content pirated from the complainant's services,⁴³ (viii) the domain names resolve to websites that offer the same or similar services, product plans, and prices,⁴⁴ (ix) the domain names were registered on the same date or around the same time,⁴⁵ (x) one or more of the domain names was/were registered after the respondent received a demand letter from the complainant,⁴⁶ (xi) the domain names were registered at the same registrar⁴⁷ or (xii) the domain names were registered using a privacy service.⁴⁸

C. Language of the Proceedings

The proceedings will be conducted in the language of the registration agreement, unless the parties agree otherwise, the registration agreement specifies otherwise, or the panel finds otherwise.⁴⁹ It is proper to conduct the proceedings in another language where substantial expense and delay would be incurred if the complaint had to be translated to the language of the registration agreement, and where there is evidence that the respondent understands the other language.⁵⁰ Relevant evidence includes (i) the language of the domain name, the website, or its script, (ii) prior cases involving the respondent in a particular language, (iii) prior correspondence between the parties, (iv) evidence of other domain names owned by the respondent corresponding to a particular language, (v) the use of a particular language agreement for some (but not all) of the domain names, (vi) currencies accepted on the domain name, and (vii) other indicia tending to show that it would not be unfair to proceed in a particular language.⁵¹

D. Settlements

The parties may negotiate a settlement and terminate the proceeding by providing written notice of a request to suspend followed by a completed settlement form.⁵² It is important to note that the settlement forms provided by the providers are not intended to take the place of a fully executed settlement agreement but are instead intended to summarize the essential terms of such an agreement.⁵³ Settlement dis-

cussions are considered admissible.⁵⁴ In the event of a settlement, the fee will be refunded.⁵⁵

E. Decisions

If no settlement is reached, the panel will make a decision within 14 days of appointment.⁵⁶ Then, within three business days, the provider will notify the parties, ICANN, and the registrar of the decision,⁵⁷ which will be published in full online, unless a portion is redacted due to exceptional circumstances.⁵⁸

If the panel decides that the domain name should be canceled or transferred, ICANN waits 10 business days after receiving notice from the provider before implementing the decision.⁵⁹ During that time, either party may commence a lawsuit, which will cause ICANN to postpone implementation of the decision until it receives (i) evidence of a resolution between the parties; (ii) evidence that the lawsuit has been dismissed or withdrawn; or (iii) a copy of an order from the court dismissing the lawsuit or ordering that the respondent cease using the domain name.⁶⁰

II. Standing

The complainant must show standing by proving that it has valid trademark rights in the mark.⁶¹ The policy may be used to protect both registered and unregistered (or “common law”) marks.⁶² The jurisdiction(s) where the mark is valid, the relevant goods and services, the filing or priority date, date of registration, and date of first use are not relevant under the first element, but may bear on the second and third elements.⁶³ Further, a registered mark is prima facie evidence that the complainant has standing to file a complaint.⁶⁴

A complainant may assert common law rights in an unregistered mark that has acquired secondary meaning through specific evidence that the mark has become a distinctive identifier that consumers associate with the complainant’s goods and/or services, such as proof of (i) the duration and nature of use of the mark, (ii) the amount of sales under the mark, (iii) the nature and extent of advertising using the mark, and (iv) actual recognition by consumers, the industry, and the media.⁶⁵ Similarly, acquired distinctiveness must be shown if a complainant asserts rights in a registration on the U.S. Patent and Trademark Office’s (USPTO’s) Supplemental Register.⁶⁶

Many entertainers and athletes may attempt to register their personal names as domain names, only to find that the domain names were already registered by cybersquatters. If an entertainer or athlete has a trademark registration on their personal name, then that mark will provide standing to file a complaint.⁶⁷ However, if the complainant does not have a registration on their personal name, then the complainant must establish common law rights by showing that their per-

sonal name is being used as a trademark.⁶⁸ Merely having a famous name is insufficient, especially where that name is a common or generic word, such as STING.⁶⁹

III. Confusingly Similar

The first element requires the complainant to show that the domain name is identical or confusingly similar to the mark.⁷⁰ The test to prove confusing similarity typically involves a side-by-side textual and phonetic comparison of the domain name and the mark.⁷¹

The applicable top-level domain (TLD) in a domain name “is normally disregarded” under the confusing similarity test, since inclusion of a TLD is “a mere technical requirement of domain name registration.”⁷² However, the TLD should be considered under the confusing similarity test where the combination of the applicable TLD and the second-level portion of the domain name comprise the mark.⁷³

A. Entire Mark

Incorporating a mark in its entirety is sufficient to establish that a domain name is identical or confusingly similar to the mark.⁷⁴ For example, many of the decisions cited in this article include domain names that are identical to a mark, including the names of celebrities, like <madonna.com>, <juliaroberts.com>, <celinedion.com>, and <mirandakerr.com>, and the names of companies, like <redbull.org>.⁷⁵

The addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) do not prevent a finding of confusing similarity.⁷⁶ For example, many of the decisions cited in this article include domain names comprised of a mark and an additional term that did not prevent a finding of confusing similarity, such as <whitespeedos.com>, <vogueaustralia.com>, and <officialnascar.com>.⁷⁷

B. Dominant Feature of the Mark

The domain name will typically be considered confusingly similar to the mark if a dominant feature of the mark is recognizable in the domain name through typosquatting.⁷⁸ That occurs when the domain name consists of a common, obvious, or intentional misspelling of the mark using (i) adjacent keyboard letters, (ii) substituting similar characters,⁷⁹ (iii) non-Latin internationalized or accented characters,⁸⁰ or (iv) additional interspersed letters or numbers.⁸¹

A less frequent type of dispute involves a domain name that involves a truncated or abbreviated version of the mark. For example, <leakedfanscontent.com> and <leakedof.com> were found to be confusingly similar to the ONLYFANS mark, despite only containing the word FANS or the abbreviation OF.⁸²

Although typically disregarded under the first element, a panel may consider the broader context of a dispute if the panel would benefit from affirmation as to confusing similarity with the mark.⁸³ This broader context may include, for example, evidence that the respondent is targeting the mark, such as where <leakedfanscontent.com> and <leakedof.com> featured content pirated from <onlyfans.com>.⁸⁴

Since geographical terms are often a component of entertainment and sports marks, an issue could arise where a sports or entertainment mark contains a disclaimed geographical term in the mark. For example, CBS has a registration on CSI: VEGAS, which disclaims the geographic term VEGAS.⁸⁵ Hypothetically, this registration would not provide legal grounds if the domain name contains only the geographical term, such as where a respondent promotes Nevada tourism on <visitvegas.com>. However, there would almost certainly be a likelihood of confusion if the broader content shows the respondent is targeting the mark, such as by selling t-shirts containing images of CSI: VEGAS characters on <vegasmerch.com>.

C. Multiple Marks

A common issue in entertainment and sports domain disputes are domain names comprised of more than one mark owned by more than one party, such as <legostarwarsvideo-game.info>⁸⁶ and <nfl-nba-nhl-mlb-ncaa-online-betting-lines-odds.com>.⁸⁷ In such cases, the domain name may be transferred to the complainant without prejudice to the owners of the other trademarks.⁸⁸

IV. Rights or Legitimate Interests

The standard of proof in disputes under the policy is a preponderance of the evidence.⁸⁹ As the overall burden of proof is on the complainant, it is commonly recognized that the complainant has the “impossible task of proving a negative proposition, requiring information that is primarily if not exclusively within the knowledge of the respondent.”⁹⁰ Thus, once the complainant makes a prima facie showing that the respondent lacks rights or legitimate interests in the domain name, the burden shifts to the respondent to provide evidence demonstrating that it has rights or legitimate interests in the domain name.⁹¹ The policy explicitly provides three non-exhaustive instances where a respondent has rights and legitimate interests in the domain name.⁹²

A. Bona Fide Offering of Goods and Services

First, a respondent may show that it has rights and legitimate interests in the domain name if it is used in connection with a bona fide offering of goods or services before any notice to the respondent of the dispute.⁹³ Evidence that may be used to show a bona fide prior use include, but is not limited to, evidence predating notice of the dispute, which

shows (i) business formation, due diligence, and legal advice, (ii) credible investment in website development or promotional materials (iii) a genuine business plan, and/or (iv) registration and use of related domain names.⁹⁴ For example, although CBS is easily able to prove trademark rights in the SURVIVOR mark, even without a registration, CBS would be unsuccessful if it brought a complaint against a hypothetical respondent who offered online support groups to survivors of cancer on <survivor.com> before the hit reality television show premiered in 2000.

B. Respondent is Commonly Known by the Domain Name

Second, a respondent may show that it has rights and legitimate interests in the domain name if the respondent is “commonly known” by the domain name.⁹⁵ This occurs when the domain name contains the respondent’s actual given name, stage name, nickname, initials, or other moniker.⁹⁶ For example, a previously registered trademark corresponding to the domain name can be used to show rights or legitimate interests, unless such registration was a pretext to circumvent application of the policy.⁹⁷

While the respondent need not prove that it has acquired trademark rights in the name, it must provide evidence that it is actually known by that name, including, but not limited to, (i) a birth certificate, driver’s license, or other government-issued ID, (ii) independent and sustained secondary material, such as websites, articles, or correspondence, (iii) bills/invoices, and/or (iv) business formation documentation.⁹⁸ For example, a respondent who claimed that his childhood nickname was Red Bull did not have an interest in <redbull.org>, because he did not provide any evidence to that fact.⁹⁹ If the respondent does not put forth any evidence that it is “commonly known” by the domain name, then the panel may consider the respondent’s WhoIs registration information in determining that there is no evidence indicating that the respondent has been commonly known by the domain names.¹⁰⁰

C. Fair Use

Finally, a respondent may show that it has rights and legitimate interests in the domain name if the respondent makes a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the mark.¹⁰¹

The fair use defense allows anyone to use a mark, provided that (i) the good or service is not readily identifiable without using the mark, (ii) the mark is only used as is reasonably necessary to identify the good or service, and (iii) the use of the mark does not suggest sponsorship or endorsement by the owner of the mark.¹⁰²



Panels will consider the broader context of a case when determining whether a use is fair, including, but not limited to, whether (i) the domain name was registered and is being used as a pretext for commercial gain, (ii) the respondent reasonably believes its referential, laudatory, or derogatory use is truthful and well-founded, (iii) it is clear that the website is not operated by the complainant, including whether a disclaimer is used, (iv) there is an actual connection between the content of the website and the complainant or a competitor, (v) the respondent engaged in a pattern of abusive domain registrations, (vi) the respondent provided false contact information, or (vii) the respondent engaged in cyberflight.¹⁰³

Fair use does not typically extend to a domain name that is identical to a mark (that is, <trademark.tld>), since such use creates an impermissibly high risk of impersonation or implied affiliation.¹⁰⁴ Additionally, fair use does not typically extend to a domain name containing a mark (such as MISS USA) and an additional term that refers to the complainant's goods or services (such as "pageant.")¹⁰⁵

However, fair use may extend to a domain name containing a mark and an additional term in some instances. Fair use may exist where the website contains (i) a laudatory term (such as "fan") praising the complainant,¹⁰⁶ (ii) a derogatory term (such as "sucks") criticizing the complainant,¹⁰⁷ or (iii) an unflattering, pejorative, or inflammatory word parodying the complainant.¹⁰⁸ Fair use does not exist where the website (i) contains false or misleading statements amounting to defamation or tarnishment¹⁰⁹ or (ii) engages in commercial activity beyond what is incidental to offset the costs of operating the website.¹¹⁰

Fair use may also exist where a reseller or repair service (i) uses the website to resell or repair only the complainant's goods or services,¹¹¹ (ii) accurately and prominently discloses its relationship to the complainant,¹¹² (iii) does not corner

the market on domain names containing the mark,¹¹³ and (iv) does not have a prior agreement prohibiting the registration and use of domain names incorporating the mark.¹¹⁴ For example, the registrant of 19 domain names containing the NFL mark could not assert a reseller fair use defense, because (i) the respondent linked to third party gambling websites unrelated to the NFL or its football games, (ii) the website did not include a disclaimer, and (iii) registering 19 domains is more than necessary to meet the legitimate requirements of a *bona fide* reseller.¹¹⁵

With a global ticket scalping market valued at \$1.5 billion,¹¹⁶ sports and entertainment companies are bound to eventually find a cybersquatter engaged in such activity. Simply purchasing tickets from the complainant does not guarantee the respondent a fair use right to scalp those tickets on a domain name that is confusingly similar to the complainant's entertainment or sports mark. The scalper must comply with the fair use test for resellers. For example, one respondent had a fair use right to resell tickets on domain names containing the terms "seats" or "tickets" and NCAA marks, since the website included a disclaimer.¹¹⁷

On the other hand, one respondent was denied a fair use defense to resell tickets to NCAA games on 10 domain names containing NCAA marks, since the website sold tickets at highly inflated prices and also sold tickets to other events.¹¹⁸ Similarly, that same respondent could not resell DAYTONA 500 tickets on a different website, which (i) sold tickets to races sponsored by third parties, and (ii) did not include a disclaimer.¹¹⁹ Further, evidence that the respondent may be violating laws that prohibit reselling tickets at substantially inflated prices may be relevant to fair use evaluation; however, proceedings under the policy are not the appropriate forum to adjudicate such allegations if they are contested by the respondent.¹²⁰

V. Bad Faith Registration

The third element requires the complainant to show that the domain name was registered in bad faith.¹²¹

A. Rights in the Mark Must Pre-Date the Domain Name Registration

Bad faith registration generally is not found unless the respondent registered or obtained the domain name before the complainant obtained rights in the mark—that is, before the mark was registered or acquired distinctiveness.¹²² Bad faith registration may be found even when the domain name pre-dates the complainant's rights in the mark, if the domain name was registered (i) shortly before or after the complainant announced a merger or product launch, (ii) with insider knowledge (such as if the respondent was a former employee of the complainant), (iii) in response to significant media attention, or (iv) after the complainant filed a trademark application.¹²³ For example, bad faith registration was found in relation to <pac-12neetwork.com>, <pac12network.com>, and <pac-12network.org>, because the Pacific-10 Conference was publicly considering expanding at the time when the respondent registered the domain names.¹²⁴

B. Presumption of Bad Faith for Famous or Well-Known Marks

Registering a domain name that is identical or confusingly similar to a famous or well-known mark creates a presumption of bad faith.¹²⁵ As many entertainment and sports marks are widely known, it may often be inferred that a respondent could not credibly claim to have been unaware of the mark at the time of registration, unless the mark is a dictionary term or inherently attractive as a domain name.¹²⁶

VI. Bad Faith Use

The third element also requires the complainant to show that the domain name is being used in bad faith.¹²⁷ The policy explicitly provides the following four non-exhaustive instances of bad faith use.¹²⁸

A. Offering to Sell the Domain Name for a Profit

First, a complainant may show that the respondent is acting in bad faith if the respondent registered or acquired the domain name for the primary purpose of selling, renting, or otherwise transferring the domain name to the complainant for valuable consideration in excess of the respondent's out-of-pocket costs directly related to the domain name.¹²⁹

An offer to sell a domain name is not evidence of bad faith on its own.¹³⁰ For example, in response to a demand letter from NASCAR, a respondent stated: "I estimate a loss of \$27,600.00. With this amount I would be willing to immediately turn over the <nascaracing.com> domain name to NASCAR."¹³¹ This was insufficient to show that the re-

spondent registered the domain name *primarily* to sell it for profit.¹³²

More evidence is necessary to show an intent to sell the domain name in excess of costs, such as proof of (i) the respondent's knowledge of the mark, (ii) the distinctiveness of the mark, (iii) a pattern of abusive registrations by the respondent, (iv) website content targeting the mark or linking to the complainant's competitors, and (v) a respondent's past conduct or business dealings.¹³³ For example, a respondent's offer to sell <officialnascar.com> to NASCAR for \$500 and then threaten to auction the domain name on eBay was in bad faith, when the prevailing rates for registering and transferring a domain name with the registrar at that time were less than \$500.¹³⁴ Even if the respondent provided evidence that the costs were greater than \$500, the threat to auction the domain name "betrays a clear motive to extract the maximum available profit from the domain name," which is proof of bad faith.¹³⁵ Similarly, a respondent's attempt to seek \$60,000 for <vogueaustralia.com> was found to be "extortionate" when it was revealed that the figure was based on "nonexistent/irrelevant business expenses."¹³⁶

B. Preventing the Complainant from Registering the Domain Name

Second, a complainant may show that the respondent is acting in bad faith if the respondent registered the domain name to prevent the complainant from using the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct.¹³⁷ Evidence that the respondent is a "serial cybersquatter" who engages in a pattern of registering domain names containing the marks of the complainant or a third party is evidence of bad faith.¹³⁸ For example, bad faith has been found where the respondent admitted to registering multiple domain names containing the names of famous celebrities.¹³⁹

C. Disrupting Business

Third, a complainant may show that the respondent is acting in bad faith if the respondent registered the domain name primarily to disrupt a competitor's business.¹⁴⁰ Business disruption has been found where the respondent uses the domain name primarily for the purpose of diverting potential customers from the complainant's sporting goods business.¹⁴¹ However, business disruption is not often discussed at length by panels deciding disputes involving entertainment and sports marks.

D. Attracting Users for Commercial Gain

Fourth, a complainant may show that the respondent is acting in bad faith if the respondent uses the domain name with the intention of attracting, for commercial gain, internet users to the respondent's website or another website, by

creating a likelihood of confusion with the mark as to the source, sponsorship, affiliation, or endorsement of such website or a product or service thereon.¹⁴²

Evidence of attraction for commercial gain may include, but is not limited to, proof of (i) actual confusion, (ii) seeking to cause confusion, even if unsuccessful, and (iii) redirecting the domain name to a website owned by the complainant, its competitor, or the respondent, even if a disclaimer is used.¹⁴³ For example, a respondent with agreements to promote other websites does so in bad faith, regardless of whether the respondent receives payments or merely the benefit of cross-promotion without money changing hands.¹⁴⁴

Direct competition occurs when the respondent offers similar products or services as the complainant or links to the complainant's competitors.¹⁴⁵ For example, in one case, "[t]he respondent offer[ed] online sports coverage, including live games, matches, and tournaments" on <livefoxsports.info>, which directly competed with the "online sports entertainment, including news, information, up-to-date scores, play-by-play coverage of games, and streaming videos" offered by Twentieth Century Fox.¹⁴⁶

Piracy and counterfeiting are more brazen and troublesome ways a respondent may use an entertainment or sports mark in a domain name to attract users for commercial gain. While direct competition involves a respondent offering similar services, piracy involves the respondent offering the complainant's services themselves (such as stolen entertainment content),¹⁴⁷ and counterfeiting involves the respondent offering fake versions of the complainant's services (such as jerseys bearing an imitation of a sports team's logo).¹⁴⁸

Bad faith may also be shown by any other evidence of illegal activities by the respondent such as phishing, distributing malware, hacking, and other types of fraud.¹⁴⁹ For example, bad faith may be shown if the website offers illegal cheat codes, hacks, or jail breaks that provide unauthorized access to video games.¹⁵⁰

Conclusion

The policy is an extremely useful tool for entertainment and sports brands seeking to obtain or cancel domain names that are identical or confusingly similar to their marks. However, the policy has its limits. Complaints are typically ineffective in cases of anticipatory cybersquatting¹⁵¹ where the domain name was registered prior to the entertainment or sports brand registering its mark or obtaining acquired distinctiveness. Further, complaints are always ineffective if brought against a good-faith registrants with legitimate rights or interests in the domain name, such as a respondent who was commonly known by the domain name before the complainant obtained rights in the Mark, a respondent engaging

in comment or criticism, and a respondent who is engaged in reselling or repairing the complainant's goods or services.

Despite these inherent limitations, the policy is an effective and efficient method of combating abusive registrations that seek to extort the complainant, prevent the complainant from registering a domain name, disrupt or directly compete with the complainant's business, or that engage in illegal activities common in the entertainment and sports industries such as piracy and counterfeiting.

If either party believes that the dispute was decided incorrectly, the aggrieved party can bring suit in federal court. If the complainant wins the proceeding and the domain name is transferred or cancelled, the aggrieved respondent may file suit alleging that the complainant acted in bad faith in bringing the proceeding and engaged in reverse domain name hijacking.¹⁵² If the respondent raises a successful defense and maintains registration of the domain, the complainant may file suit for trademark infringement.¹⁵³



Bobby Desmond is an attorney at Walters Law Group where his practice focuses on intellectual property, internet law, and First Amendment issues, especially relating to adult entertainment and gaming businesses. Desmond has represented numerous individuals and entities in the entertainment and sports industries.

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Endnotes

1. Pub.L. No. 106-113 § 3001 *et. seq.*, 113 Stat. 1501A-545; 15 U.S.C. §§ 1125(d), 1114.
2. *See Uniform Domain Name Dispute Resolution Policy*, ICANN (Oct. 24, 1999), <https://www.icann.org/resources/pages/policy-2012-02-25-en>.
3. Policy, Paragraph 1.
4. *See Rules for Uniform Domain Name Dispute Resolution Policy*, ICANN (Sept. 28, 2013), <https://www.icann.org/resources/pages/udrp-rules-2015-03-11-en> (applicable to all complaints filed on or after July 31, 2015) ("Rules").
5. *See WIPO Guide to the UDRP*, section A, WIPO, <https://www.wipo.int/amc/en/domains/guide/>; Delegated Strings, ICANN, <https://newgtlds.icann.org/en/>.
6. *See, e.g., the Dispute Resolution Service Policy for .uk Domains*, Nominet, <https://www.nominet.uk/domain-support/uk-domain-disputes/>. As most disputes can be brought under the Policy and the elements of other domain dispute policies often share substantial similarities with the Policy, this article focuses on the elements of the Policy and highlights cases brought under the Policy.
7. Policy, Paragraph 4 (note that although the Policy's procedure is mandatory, neither party is prevented from submitting the dispute

- to a court of competent jurisdiction for independent resolution before the proceeding begins or after it concludes).
8. *National Football League v. Online Marketing International also known as International Marketing Group*, D2008-2006 (WIPO Mar. 2, 2009), <https://www.wipo.int/amc/en/domains/decisions/html/2008/d2008-2006.html> (cited herein as NFL).
 9. For brevity, this article focuses on the procedures related to disputes brought before WIPO, as those procedures are laid out in the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, <https://www.wipo.int/amc/en/domains/search/overview3.0/> (Overview).
 10. Rules, Paragraph 3(a); WIPO provides a model complaint form and filing guidelines at <https://www.wipo.int/amc/en/domains/complainant/>; Form provides a model complaint form at <https://www.adrforum.com/assets/resources/UDRP/UDRPMModelComplaint2016.docx>.
 11. WIPO, <https://www.wipo.int/amc/en/domains/>.
 12. Forum, <https://www.adrforum.com/domain-dispute/udrp>.
 13. Previous providers included the eResolution Consortium and the International Institute for Conflict Prevention & Resolution until 2001 and 2006, respectively. See *Domain Name Administrative Decisions*, Disputes.org, <http://www.disputes.org/index.htm>; *ICANN Decisions*, CPR, <https://www.cpradr.org/resource-center/icann-decisions>.
 14. Overview, section 4.4.1 (if the Respondent uses a privacy service, WIPO will disclose the Registrant's contact information to the Complainant after filing and invite the Complainant to amend the complaint in light of the new information).
 15. Rules, Paragraph 3(b).
 16. Rules, Paragraph 3(b)(ix).
 17. Rules, Paragraph 4(a).
 18. Policy, Paragraph 8.
 19. Rules, Paragraph 4(f).
 20. Rules, Paragraphs 5(a) and 5(c)(i); WIPO provides a model response form and filing guidelines at <https://www.wipo.int/amc/en/domains/respondent/>; Forum provides a model response form at <https://www.adrforum.com/assets/resources/UDRP/UDRPMModelResponse.docx>.
 21. Rules, Paragraph 5(b).
 22. Rules, Paragraph 5(e).
 23. Rules, Paragraph 5(c).
 24. Rules, Paragraph 5(f).
 25. Rules, Paragraph 3(b)(iv).
 26. Policy, Paragraph 4(g).
 27. *Id.*
 28. Rules, Paragraph 6(b).
 29. Rules, Paragraph 7.
 30. Rules, Paragraph 8.
 31. Rules, Paragraph 10.
 32. Rules, Paragraph 10(e).
 33. Rules, Paragraph 3(c).
 34. *Speedo Holdings B.V. v. Programmer, Miss Kathy Beckerson, John Smitt, Matthew Simmons*, D2010-0281 (WIPO May 18, 2010), <https://www.wipo.int/amc/en/domains/decisions/text/2010/d2010-0281.html>.
 35. Overview, Section 4.11.
 36. Overview, Section 4.11.
 37. See, e.g., *Fenix International Limited v. Nemanja Krecelj, Rocket Science Group*, D2021-2667 (WIPO Nov. 10, 2021), <https://www.wipo.int/amc/en/domains/search/text.jsp?case=D2021-2667>; *Fenix International Limited v. Ladislav Hricko/1a world Ltd, admin Mel/Whois Privacy Corp.*, D2021-2522 (WIPO Oct. 5, 2021), <https://www.wipo.int/amc/en/domains/search/text.jsp?case=D2021-2522>.
 38. See, e.g., *Speedo*, *supra* note 34.
 39. See, e.g., *Fenix International Limited v. Domain Administrator; see PrivacyGuardian.org/Kelly Smit, onlyfansleak and Withheld for Privacy Purposes, Privacy service provided by Withheld for Privacy ehf/Robert Scean*, WIPO D2021-2706 (Oct. 11, 2021), <https://www.wipo.int/amc/en/domains/search/text.jsp?case=D2021-2706>.
 40. See, e.g., *Scean*, *supra* note 39.
 41. *Id.*
 42. See, e.g., *Scean*, *supra* note 38; *Hricko*, *supra* note 37; *NFL*, *supra* note 8.
 43. See, e.g., *Scean*, *supra* note 39.
 44. See, e.g., *Speedo*, *supra* note 34; *Hricko*, *supra* note 37.
 45. See, e.g., *Fenix International Limited v. WhoisGuard Protected, WhoisGuard, Inc./Yazid Laiss/Stive Belb/Ahmed Bel Bouabli*, D2021-0152 (WIPO Mar. 25, 2021), <https://www.wipo.int/amc/en/domains/search/text.jsp?case=D2021-0152>.
 46. See, e.g., *Hricko*, *supra* note 37.
 47. See, e.g., *Laiss*, *supra* note 45.
 48. *Id.*
 49. Rules, Paragraph 11(a).
 50. *xHamster IP Holdings LTD v. zhanglong*, D2020-0743 (WIPO June 6, 2020), <https://www.wipo.int/amc/en/domains/search/text.jsp?case=D2020-0743>.
 51. *xHamster*, *supra* note 50; *Fenix International Limited v. Kiril Kirilov*, D2021-0853 (WIPO May 27, 2021), <https://www.wipo.int/amc/en/domains/search/text.jsp?case=D2021-0853>.
 52. Rules, Paragraph 17(a).
 53. Rules, 17(a)(iii).
 54. *Advance Magazine Publishers Inc. v. Marcellod Russo*, D2001-1049 (WIPO Nov. 22, 2001), <https://www.wipo.int/amc/en/domains/decisions/html/2001/d2001-1049.html>.
 55. Overview, section 4.9.
 56. Rules, 15(b).
 57. Rules, 16.
 58. Policy, Paragraph 4(j).
 59. Policy, Paragraph 4(k).
 60. *Id.*
 61. Rules, 3(b)(ix)(1); Overview, section 1.7.
 62. Overview, section 1.1.1.
 63. Overview, Section 1.1.2.
 64. Overview, Section 1.2.1.
 65. Overview, Section 1.3.
 66. Overview, Section 1.2.2.

67. See, e.g., *Madonna Ciccone, p/k/a Madonna v. Dan Parisi and "Madonna.com"*, D2000-0847 (WIPO Oct. 12, 2000), <https://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0847.html>.
68. See, e.g., *Julia Fiona Roberts v. Russell Boyd*, D2000-0210 (WIPO May 29, 2000), <https://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0210.html>; *Celine Dion and Sony Music Entertainment (Canada) Inc. v. Jeff Burgar operating or carrying on business as Celine Dion Club*, D2000-1838 (WIPO Feb. 13, 2001), <https://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-1838.html>.
69. See, e.g., *Gordon Sumner, p/k/a Sting v. Michael Urvan*, D2000-0569 (WIPO July 20, 2000), <https://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0596.html> (finding STING did not act as a trademark, because it is also a common word in the English language with numerous meanings).
70. Rules, Paragraph 3(b)(ix)(1).
71. Overview, Section 1.7.
72. See, e.g., *Hricko, supra* note 37 (disregarding <.com> TLD in <buyofansubs.com>, <buyonlyfansubs.com>, <ofsubs.com>, and <onlyfansubs.com>; *Scean, supra* note 39 (disregarding <.cc> TLD in <onlyfansleaks.cc>).
73. Overview, section 1.11.3 ("For example, a hypothetical TLD ".mark" and a mark "TRADEMARK," the domain name <trade.mark> would be confusingly similar for UDRP standing purposes").
74. *Kirilov, supra* note 51 (transferring <upgradeonlyfans.com> to owner of ONLYFANS mark).
75. *Madonna, supra* note 67; *Julia Fiona Roberts, supra* note 68; *Celine Dion, supra* note 68; *Miranda Kerr, infra* note 106; *Red Bull, infra* note 99.
76. *Krecej, supra* note 37.
77. *Speedo, supra* note 34; *Advance Magazine Publishers, supra* note 54; *Imaging Solutions, infra* note 134.
78. *xHamster, supra* note 50.
79. See, e.g., *Laiss, supra* note 45 (replacing the letter "s" with the letter "z" in <onlyfanz.xyz>).
80. Overview, Section 1.9.
81. See, e.g., *xHamster, supra* note 50 (adding the numeral 5 in <xhamster5.com>).
82. *Krecej, supra* note 37.
83. Overview, Sections 1.7 and 1.15.
84. *Krecej, supra* note 37.
85. USPTO Reg. No. 90639534.
86. *LEGO Juris A/S v. Ken Rolling*, D2011-1413 (WIPO Oct. 21, 2011), <https://www.wipo.int/amc/en/domains/search/text.jsp?case=D2011-1413>.
87. *NFL, supra* note 8.
88. *Id.*
89. *Madonna, supra* note 67.
90. *Harpo, Inc. and Oprah's Farm, LLC v. Robert McDaniel*, D2013-0585 (WIPO June 17, 2013), <https://www.wipo.int/amc/en/domains/search/text.jsp?case=D2013-0585>.
91. *Id.*
92. Policy, Paragraph 4(c).
93. Policy, Paragraph 4(c)(i).
94. Overview, Section 2.2; see also *Oprah, supra* note 90 (finding that the Respondent offered no supporting evidence of "demonstrable preparations" to use the site as a noncommercial blog).
95. Policy, Paragraph 4(c)(ii).
96. Overview, Section 2.3.
97. *Madonna, supra* note 67 (finding the Respondent's Tunisian MADONNA registration was a pretense to abuse).
98. *Id.*
99. *Red Bull GmbH v. Harold Gutch*, D2000-0766 (WIPO Sept. 21, 2000), <https://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0766.html>.
100. See, e.g., *Krecej, supra* note 37 (finding registrant name "Nemanja Krecej" and Organization name "Rocket Science Group" do not correspond to the domain name); *Hricko, supra* note 37 (finding registrant name "Ladislav Hricko" and organization name "1a world Ltd, admin Me" do not correspond to the domain name).
101. Policy, Paragraph 4(c)(iii).
102. *New Kids on the Block v. News America Publishing Inc.*, 971 F.2d 302, 306-08 (9th Cir. 1991).
103. Overview, Section 2.5.2; see, e.g., *Playboy Enterprises International Inc. v. Global Media Domain Trust*, D2006-1543 (WIPO Feb. 21, 2007), <https://www.wipo.int/amc/en/domains/decisions/html/2006/d2006-1543.html> (explaining that "cyberflight" is an attempt to avoid or delay legal proceedings by changing the registration details).
104. *Willem Vedovi, Galerie Vedovi S.A. v. Domains By Proxy, LLC/ Jane Kelly*, D2014-0780 (WIPO July 9, 2014), <https://www.wipo.int/amc/en/domains/search/text.jsp?case=D2014-0780> (finding that the Respondent could have a fair use defense in <thetruthaboutwillemvedovi.com> but not <willemvedovi.com>, because the latter falsely conveyed association with the Complainant).
105. *Miss Universe L.P. v. The Marketing Model/Steven Roddy*, D2010-1939 (WIPO Dec. 29, 2010), <https://www.wipo.int/amc/en/domains/search/text.jsp?case=D2010-1939>.
106. *Miranda Kerr v. orangresarecool.com*, D2013-0553 (WIPO May 28, 2013), <https://www.wipo.int/amc/en/domains/search/text.jsp?case=D2013-0553> (finding that, although <mirandakerrweb.com> was "a fan site containing photographs and news about" Miranda Kerr, such use was not fair, because the website contained "unrelated third party ads with pay-per-click links.").
107. *Vedovi, supra* (criticizing the Vedovi art gallery); *Bloomberg L.P. v. Secaucus Group*, FA0104000097077 (Forum June 7, 2001), <https://www.adrforum.com/DomainDecisions/97077.htm> (finding fair use where the Respondent used <michaelbloombergsucks.com> to criticize the media company); *Lou Taylor v. Noelle Van Der Valk*, D2021-2824 (WIPO Dec. 2, 2021), <https://www.wipo.int/amc/en/domains/search/text.jsp?case=D2021-2824> (denying complaint where <loutaylorinvestigation.com> criticized the sports and entertainment business manager).
108. *Mercury Radio Arts, Inc. and Glenn Beck v. Isaac Eiland-Hall*, D2009-1182 (WIPO Oct. 29, 2009), <https://www.wipo.int/amc/en/domains/decisions/html/2009/d2009-1182.html> (denying complaint where <glennbeckrapedandmurderedayounggirlin1990.com> parodied Glenn Beck's interview style).
109. *Lou Taylor, supra* note 107.
110. Overview, Section 2.6.3; see, e.g., *Kerr, supra* note 106.
111. Overview, Section 2.13.

112. *Beyonce Knowles v. Sonny Ahuja*, D2010-1431 (WIPO Oct. 15, 2010), <https://www.wipo.int/amc/en/domains/search/text.jsp?case=D2010-1431> (finding that a fragrance business could not use <beyoncefrance.com> to sell the BEYONCE fragrance, because the business failed to “accurately disclose” its relationship to Beyonce).
113. Overview, Section 2.8.1.
114. *Id.*
115. *NFL*, *supra* note 8.
116. *Secondary Ticket Market Overview*, All The Research (July 2021), <https://www.alltheresearch.com/report/730/secondary-ticket-market>.
117. *NCAA v. Randy Pitkin*, D2000-0903 (WIPO Mar. 9, 2001), <https://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0903.html>.
118. *National Collegiate Athletic Association and March Madness Athletic Association, L.L.C. v. Mark Halpern and Front & Center Entertainment*, D2000-0700 (WIPO Dec. 10, 2000), <https://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0700.html>.
119. *HBP, Inc. v. Front and Center Tickets, Inc.*, D2002-0802 (WIPO Feb. 11, 2003), <https://www.wipo.int/amc/en/domains/decisions/html/2002/d2002-0802.html>.
120. *Id.*
121. Rules, 3(b)(ix).
122. *Pacific-10 Conference v. Kevin Lee*, D2011-0200 (WIPO May 17, 2011), <https://www.wipo.int/amc/en/domains/search/text.jsp?case=D2011-0200>.
123. *Id.*
124. *Id.*
125. *Fenix International Limited clo Walters Law Group v. Privacy Service Provided by Withheld for Privacy ehflAndrei Ivanov and Andruce Petr*, D2021-3384 (WIPO Nov. 29, 2021), <https://www.wipo.int/amc/en/domains/search/text.jsp?case=D2021-3384>; *see also Hricko*, *supra* note 37.
126. Overview, Section 3.2.2; *NFL*, *supra* note 8 (finding that that “[t]he Respondent was obviously aware of the Complainant’s NFL and SUPER BOWL marks when the domain names were registered. Both marks are extremely well known, and the contents of the Respondent’s websites leave no room for doubt that the Respondent was aware of the marks.”).
127. Rules, Paragraph 3(b)(ix).
128. Policy, Paragraph 4(b).
129. Policy, Paragraph 4(b)(i).
130. Overview, Section 3.1.1.
131. *National Association for Stock Car Auto Racing, Inc. v. Steven R. Shacklette*, D2001-1350 (WIPO Feb. 4, 2002), <https://www.wipo.int/amc/en/domains/decisions/html/2001/d2001-1350.html>.
132. *Id.*
133. *Id.*
134. *National Association for Stock Car Auto Racing, Inc. v. Imaging Solutions*, D2001-0777 (WIPO Aug. 13, 2001), <https://www.wipo.int/amc/en/domains/decisions/html/2001/d2001-0777.html>.
135. *Id.*; *see also Miss Universe*, *supra* note 105 (bad faith due to threat to auction after offer in excess of expenses).
136. *Advance Magazine Publisher*, *supra* note 54.
137. Policy, Paragraph 4(b)(ii).
138. *See, e.g., Ivanov*, *supra* note 125 (finding bad faith where “the Respondent is a serial cybersquatter” who “has been the unsuccessful respondent in eleven other cases decided under the Policy”); *Krecelj*, *supra* (finding bad faith where there was “a previous proceeding under the Policy between the Parties”).
139. *Julia Roberts*, *supra* note 68; *Celine Dion*, *supra* note 68; *Miranda Kerr*, *supra* note 106.
140. Policy, Paragraph 4(b)(iii).
141. *Sports Holdings, Inc. v. WhoisGuard Protection*, D2006-1360 (WIPO Jan. 11, 2006), <https://www.wipo.int/amc/en/domains/decisions/html/2006/d2006-1360.html>.
142. Policy, Paragraph 4(b)(iv).
143. *NFL*, *supra* note 8 (finding bad faith where the Respondent reproduced the NFL logos to make it appear as if the websites were “official NFL websites” or “authorized by or affiliated with NFL”); *Andrey Ternovskiy dba Chatroulette v. Whois Agent, Domain Protection Services, Inc./Marco Carta, MC*, D2018-2678 (WIPO Jan. 14, 2019), <https://www.wipo.int/amc/en/domains/search/text.jsp?case=D2018-2678> (finding “the presence of a disclaimer on the domain name <chatrouletteit.com> website makes it abundantly clear that the Respondent knew of the Complainant when registering and using this domain name”).
144. *See, e.g., National Association for Stock Car Auto Racing, Inc. v. David Crawford, Jr.*, D2001-1338 (WIPO Jan. 20, 2002), <https://www.wipo.int/amc/en/domains/decisions/html/2001/d2001-1338.html>; *Imaging Solutions*, *supra* note 134; *Shacklette*, *supra* note 131; *LEGO*, *supra* note 86.
145. *See, e.g., Playboy*, *supra* note 103.
146. *Twentieth Century Fox Film Corporation v. Domains by Proxy, Inc./Samina Rahman*, D2009-1121 (WIPO Oct. 6, 2009), <https://www.wipo.int/amc/en/domains/decisions/html/2009/d2009-1121.html>.
147. *See, e.g., Krecelj*, *supra* note 37; *Scean*, *supra* note 39.
148. *Miami Heat Limited Partnership v. Whois Privacy Corp./Ryan G Foo, PPA Media Services*, D2015-1479 (WIPO Nov. 10, 2015), <https://www.wipo.int/amc/en/domains/search/text.jsp?case=D2015-1479>.
149. Overview, Sections 2.13.1 and 3.1.4.
150. *See, e.g., Nintendo of America, Inc. v. Ali Asad Ur Rehman*, FA2001001881671 (Forum Feb. 26, 2020), <https://www.adrforum.com/DomainDecisions/1881671.htm>.
151. Kurtzman, Tamara, *CYBER CENTER: The Continued Hijacking and Ransoming of the Domain Name System by Modern-Day Corporate Privateers*, American Bar Association (June 20, 2016), [https://www.americanbar.org/groups/business_law/publications/blt/2016/06/cyber_center_kurtzman/#:~:text=The%20Anti%2DCybersquatting%20Consumer%20Protection%20Act%20\(ACPA\)%20was%20enacted,back%20to%20the%20trademark%20owner](https://www.americanbar.org/groups/business_law/publications/blt/2016/06/cyber_center_kurtzman/#:~:text=The%20Anti%2DCybersquatting%20Consumer%20Protection%20Act%20(ACPA)%20was%20enacted,back%20to%20the%20trademark%20owner) (Anticipatory cybersquatting” occurs when a domain name “with minimal present value” is registered “in the hopes that these names will become desirable” so it can be resold “at a later stage to companies that have a legitimate connection to that domain” for “a much higher price”).
152. 15 U.S.C. § 1114(2)(D); *Gen. Media Commc’ns, Inc. v. Crazy Troll*, LLC, No. 06 CIV. 4051 LAKFM, 2007 WL 102988, at *7 (S.D.N.Y. Jan. 16, 2007) (explaining the differences in two reverse domain name hijacking provisions).
153. *Id.* (finding decision declining to transfer <penhouseboutique.com> under the Policy was decided incorrectly).