

Michigan

COMPUTER LAWYER

Editor

Paul J. Raine

praine@home.msen.com

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By Paul J. Raine,
Attorney at Law

State Bar of Michigan Computer Law Section

Springtime

Even my laptop computer is confused as to whether it is Spring or Summer lately. After a long Winter it appears to have a bad case of cabin fever. Sending print jobs to network printers takes a lot more time these days, and when I take it home, it refuses to work at all. Perhaps I should follow its lead and take time to enjoy the change of season.

Each year, the Computer Law Section marks the arrival of Spring with its annual networking luncheon. Past topics have included computer crime, UCITA and e-commerce. The discussion is always very timely and the speakers very prominent in the field. Equally important, the format encourages attendees to relax and mingle. It is always our best attended event of the year, and it is always very difficult to end the luncheon and begin the Council business meeting.

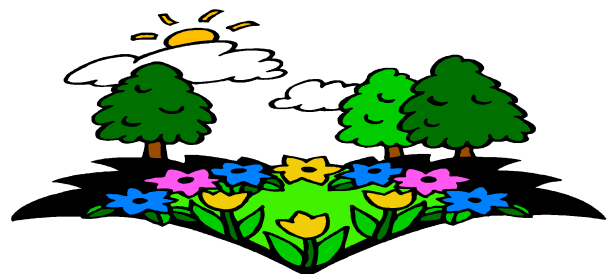
This year's networking luncheon will continue that tradition, on May 23, 2002 at the Livonia Marriott in Laurel Park. Once again, Kim Paulson is responsible for the arrangements, this time with the help of past-chair Larry Jordan. More information about the luncheon will appear in this Newsletter and in materials you will receive by email and regular mail. I encourage all members to attend. It is a great opportunity to make contact with others who share our interest in computer law and to learn a great deal about the featured topic.

The networking luncheon is a good example of your council's concern that it provide value to section members. This newsletter, the Ed Langa Annual Writing Award, ICLE seminars and open programs at our council meetings are other examples. Our impression, based upon attendance at other events we have sponsored, is that our members prefer these relatively brief, highly informative and fairly frequent educational opportunities. We have tried golf weekends like other sections (and we're happy to try one again), but nothing attracts an audience as well as our core events. I leave it for others to speculate on the reasons for this.

Of course, the council is always open to new ideas. Last year we implemented the section's seminar reimbursement policy under which section members may seek reimbursement for attending a seminar on a relevant topic. In return, we expect the member to discuss the seminar at a council meeting and to prepare a paragraph or two on the subjects discussed for the section newsletter. We all benefit.

So, we urge you to share any other ideas you have as to how the section can provide you with timely, useful benefits. Contact me (jraphelson@bodmanlongley.com) or any other council member (contact information is available through www.michbar.org) with your thoughts. Your council always welcomes your input.

In the meantime, go out and enjoy the nice weather.



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Assessing the UDRP: Trademark Owners are Unfairly Favored

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Spring Network Luncheon Registration Form



Michigan Computer Lawyer is published bi-monthly. If you have an article you would like considered for publication, send a copy to:

Paul J. Raine
Attorney at Law
PO Box 99773
Troy, MI 48099
praine@home.msen.com

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Unless otherwise stated, the views and opinions expressed in the Michigan Computer Lawyer are not necessarily those of the Computer Law Section, or the State Bar of Michigan.

Register Now

The Annual Spring Networking Luncheon is scheduled for May 23, 2002.

Turn to page 15 for registration information.



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Assessing the UDRP: Trademark Owners are Unfairly Favored

By Tracy Zawaski,

Second place winner of the 2001 writing competition

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I. INTRODUCTION

Since its creation, the Internet Corporation for Assigned Names and Numbers ("ICANN") has faced considerable criticism and controversy, largely on account of its Uniform Dispute Resolution Policy ("UDRP"). Proponents of the UDRP favor the policy because it facilitates resolution of domain name disputes; however, the benefits may well be outweighed by the costs. The policy extends the rights of trademark owners to an unprecedented and unwarranted level, at the expense of individual rights.

Because of the importance of the Internet and development of the global information infrastructure, the U.S. government has tremendous interest in legitimizing ICANN and its authority over the domain name system ("DNS").¹ In particular, the UDRP is a small step in worldwide Internet policy, which could eventually lead to worldwide Internet laws, such as content control regulations, and mandating and enforcing privacy and security policies.²

This paper discusses the implementation of the UDRP and its effects on the Internet's evolution. This paper takes the position that the UDRP unfairly favors trademark holders because it permits the complainant to engage in forum shopping. In addition, certain key terms are defined ambiguously, thereby allowing arbitrators considerable discretion to employ their own judgment with utter disregard to established trademark principles. The lack of legal guidelines compromises free speech and fair use rights normally associated with trademark law, and the UDRP creates conflicting laws that are not subject to the checks and balances of customary judicial proceedings. For these reasons, the UDRP prefers trademark holders over non-trademark holders.

II. BACKGROUND

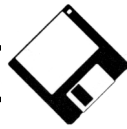
A. Internet Protocol Numbers and the DNS System

Every computer connected to the Internet must have an Internet Protocol ("IP") number to send and receive information.³ For example, the IP number for one of the servers at Wayne State University ("WSU") is "141.217.1.15".⁴ Rather than typing in this number to access the WSU website, however, an Internet user can type "www.wayne.edu" to achieve the same result. This is possible because of the DNS,⁵ a system that maps IP numbers and domain names to make it easier for Internet users to navigate the World Wide Web.⁶

B. How the Domain Name System Works

The DNS is a hierarchical mapping system that directs an Internet user to the desired website or email address.⁷ The DNS is divided into top-level domains ("TLD") such as

continued on page 4



“.com”, “.edu.”, “.org.”, “.ca”, etc.⁸ Each TLD is divided into second-level domains (“SLD”).⁹ The SLD is the part of the address immediately preceding the TLD, such as the term “wayne” in the “www.wayne.edu” example. The SLDs are further separated, and so on. When a person types an alphanumeric Uniform Resource Locator (URL), which is the entire phrase following “http://”, the host computer will translate the URL into an IP number.¹⁰

At the very top of the Internet hierarchy is the “root file.”¹¹ The root file is a single data file that contains the list of computers that hold the master lists of TLDs.¹² Several “root servers,” which contains information about every entry in the DNS, serve the root file.¹³ For example, in the “www.wayne.edu” illustration, the user’s computer will query one of the root servers, which would lead the user’s computer to the particular computer listing the domain names with the TLD “edu.”¹⁴ The computer listing the “edu” TLDs would then lead the user’s computer to the computer listing domains within the “wayne” SLD and point the user’s computer to the proper Internet address.¹⁵

However, it may not be necessary for the user’s computer to query the root servers, as many Internet Service Providers keep a “cache” of frequently-requested domain addresses to serve their customers more efficiently.¹⁶ Thus, when an Internet user types in the “www.wayne.edu” domain name, the user’s computer will look to local DNS servers to find the IP address matching that domain name.¹⁷ If the local DNS servers can’t make the match, the inquiry is transmitted to a higher level of servers.¹⁸ An inquiry, therefore, may result in a match at a low local server level, or it may travel up the hierarchy all the way to a root server before a match is achieved.¹⁹

C. History of the Internet

The U.S. Department of Defense developed the Internet’s predecessor in the 1960’s by funding a project to develop a communication network to link government agencies, universities and research facilities.²⁰ The purpose of the project was to facilitate sharing of research and other information.²¹ The initial project, called ARPANET, was an experimental project of the advanced Research Project Agency (“ARPA”).²² The ARPANET became known as “DARPA Internet,” and eventually the “Internet.”²³

The ARPANET/Internet development work was contracted to various universities, including the University of Southern California’s Information Sciences Institute (“ISI”) at Los Angeles.²⁴ Dr. Jon Postel, then a graduate student at the university, was charged with maintenance of the master list of host names and addresses, as well as other ARPANET documents.²⁵ ARPANET was later linked to networks established

by other government agencies, universities and research facilities. This “network of networks”²⁶ became the Internet as we know it.

Until about 1984, the Internet was used almost exclusively for research purposes, and there were few enough computers connected that a formal organizational system was not required.²⁷ However, since the Internet is decentralized in nature, a properly-functioning addressing system is essential to properly direct Internet communications.²⁸ Therefore, when it the name list became difficult to maintain,²⁹ scientists, including Dr. Postel, created the DNS.³⁰ Management of the DNS, along with various other Internet infrastructure functions, was conducted by an entity which eventually became known as the Internet Assigned Numbers Authority (“IANA”).³¹ The Department of Defense, which directed and funded most of the Internet’s development, entered into contracts with ISI to perform the management functions.³²

The National Science Foundation (“NSF”)³³ later took over the Department of Defense’s function of Internet funding. In 1993, NSF entered a cooperative agreement with a private company, Network Solutions, Inc. (“NSI”), whereby NSI became the registrar for certain top-level domain names.³⁴ Under the initial agreement, IANA continued to supervise the allocation of IP numbers and domain name registrations.³⁵

In 1995, NSF changed its agreement with NSI to give NSI control over the second-level domains.³⁶ Under the amended agreement, NSI was also permitted to charge registrants for its registration services.³⁷ NSI was the exclusive domain name registrant for top-level domain names for the next several years. However, many people were unhappy with NSI’s control over the DNS, particularly with the registration fees.³⁸ Critics ranged from “old-school Netheads who argue that the domain names should be managed through open protocols, to large corporations that have complained about NSI’s procedures for resolving disputes over trademarks.”³⁹

D. NSI’s Dispute Resolution Policy

NSI was heavily criticized for its first-come, first-served domain name registration procedures, as well as its inadequate dispute resolution policies.⁴⁰ NSI’s policy, which was adopted in 1995,⁴¹ permitted trademark owners to challenge a domain name registration based on their trademark rights.⁴² In 1998, the policy was modified to permit trademark owners to “cut-off” a disputed domain name until the dispute was resolved.⁴³ Both the 1995 and 1998 policies disregarded the “likelihood of confusion” standard for trademark infringement, resulting in a dispute resolution policy that was both under and overinclusive.⁴⁴ The policy applied only to identical trademarks, and therefore was too narrow from a trademark



owner's perspective. As a result, a trademark owner with a registration for "MICROSOFT" could prevent someone else from using the domain name "www.microsoft.com" to sell baked goods (or anything, regardless of whether there was a likelihood of confusion), but could not invoke the policy against the domain name "www.microsoftsoftware.com."⁴⁵

Meanwhile, Dr. Postel proposed that IANA authorize new top-level domains to be operated by third parties.⁴⁶ The International Ad Hoc Committee ("IAHC")⁴⁷ was organized to evaluate Dr. Postel's proposal. The IAHC proposed to add seven new top-level domains to the DNS.⁴⁸ The IAHC proposal included multiple, globally-dispersed registrars that would operate under a Council of Registrars ("CORE").⁴⁹ CORE was organized as a non-profit association to control the new registry from its headquarters in Switzerland.⁵⁰

In response to the IAHC proposal, CORE registrars began "pre-selling" domain name registrations in the new domains.⁵¹ However, NSI still controlled the root server under its contract with the U.S. government, and refused to insert the new domains into the root server without specific authorization.⁵² The U.S. government ordered NSI to wait, as the Clinton administration was analyzing the domain name situation from the government's perspective.⁵³

In July 1997, President Clinton ordered the Secretary of Commerce to privatize the DNS to increase competition and facilitate international participation in its management.⁵⁴ The Department of Commerce issued a "Request for Comment" regarding administration of the domain name system, and then published a notice of proposed rulemaking⁵⁵ known as the "Green Paper."⁵⁶ The Green Paper recommended formation of a U.S.-based nonprofit corporation to run the domain name system.⁵⁷ Much like the IAHC proposal, the Green Paper further recommended the immediate creation of additional top-level domains and competing registries and registrars.⁵⁸

In response to public comment to the proposed rulemaking,⁵⁹ the Department of Commerce issued the "White Paper" in 1998.⁶⁰ The White Paper sought to stop the role of the U.S. government in the DNS.⁶¹ The White Paper announced the Department's decision to "enter into agreement with a new not-for-profit corporation formed by private sector Internet stakeholders to administer policy for the Internet name and address system."⁶² The White Paper identified several principles, namely, stability, competition, private, bottom-up coordination, and representation, to guide the new entity.⁶³

The White Paper was met with several proposals.⁶⁴ NSI initiated a group called the International Forum for the White Paper, which held a series of meetings in Virginia, Geneva, Singapore, and Buenos Aires.⁶⁵ However, a "wrap-up" meeting failed to occur, leading to the formation of two new groups, the

Boston Working Group and the Open Root Server Confederation ("Open-RSC").⁶⁶ Both the Boston Working Group and Open-RSC submitted proposals for the organization of a new non-profit entity.⁶⁷

Ronda Hauben submitted a third proposal,⁶⁸ and Jeffrey A. Williams submitted a proposal on behalf of INEG Inc.⁶⁹ Finally, Dr. Postel submitted IANA's proposal for ICANN.⁷⁰ All proposals were published for comment for a ten-day period, after which the National Telecommunications and Information Administration ("NTIA") entered into a "memorandum of understanding" with ICANN.⁷¹ The memorandum of understanding required the Department of Commerce and ICANN to jointly develop procedures for transferring DNS management to the private sector.⁷²

E. Creation of ICANN

Under IANA's proposal, Dr. Postel, as ICANN's Chief Technological Officer, agreed to perform IANA's technical management functions under the principles espoused in the White Paper.⁷³ ICANN's initial Board of Directors was composed of "distinguished personages with little involvement in (and, for the most part, little knowledge of) the 'DNS wars' of the previous few years."⁷⁴ Little is known about the selection process for the Board on account of the clandestine recruiting efforts and discussions.⁷⁵ An effort to include neutral persons on the Board (*i.e.*, people without past involvement in the DNS wars) resulted in a Board with little DNS expertise.⁷⁶ However, the Board's lack of technical expertise was not viewed as a problem because Dr. Postel would manage the technical aspects of ICANN as Chief Technological Officer.⁷⁷ Unfortunately, before the NTIA entered into the memorandum of understanding with ICANN, Dr. Postel underwent heart surgery and died shortly thereafter.⁷⁸

As a result of Dr. Postel's sudden death, crucial decisions regarding ICANN's organization and administration were made by ICANN's Board of Directors.⁷⁹ The Board was heavily influenced by those with high stakes in Internet administration, such as NSI, trademark owners, intellectual property scholars and attorneys, and international standards organizations.⁸⁰ Establishing the UDRP was one of the Board's first major decisions, and pressure levied on the board by trademark interests resulted in a UDRP that unfairly favors trademark holders.⁸¹

F. Structure of the UDRP

The UDRP is divided into nine sections, the most important providing for "mandatory" administrative proceedings to resolve trademark disputes.⁸² The UDRP differs from NSI's dispute resolution policy in three respects.⁸³ First, there is no provision for trademark owners to cut off domain names pending



resolution of a dispute.⁸⁴ Second, there is a “bad faith” predicate for invoking the UDRP.⁸⁵ Finally, the UDRP requires mandatory dispute resolution, through arbitration by an ICANN-approved provider.⁸⁶

Under the UDRP, anyone can initiate a dispute by submitting a complaint to the ICANN-approved provider of its choice.⁸⁷ A complaint must allege that a domain name registrant:

- 1) has registered a domain name which is “identical or confusingly similar to a trademark or service mark in which the complainant has rights”; and
- 2) has “no rights or legitimate interests in respect of the domain name;” and
- 3) the “name has been registered and is being used in bad faith.”⁸⁸

The complaint must also fulfill various procedural requirements and specify whether the complainant elects a single-member or three-member arbitration panel.⁸⁹ After a complaint is submitted, the provider will verify compliance with the administrative regulations, and forward a copy to the registrant.⁹⁰ Under the Rules, the registrant has 20 days to respond to the complaint, and may request either a single-member or three-member arbitration panel.⁹¹ If either party requests a three-member panel, each party may specify three potential arbitrators to comprise one panel member.⁹² The provider then has five days to select a panel (from an ICANN-approved list). The provider must select one arbitrator from each party’s list of potential arbitrators if possible, but may select the panel itself if it is unable to “secure the appointment” of a particular arbitrator within the five-day period.⁹³ The complaint and response are then submitted to the panel, which has fourteen days to issue a decision.⁹⁴ The panel may apply “any rules and principles of law that it deems applicable”⁹⁵ to resolve the matter. The decision must be in writing, and if a three-member panel has been chosen, a majority decision is required.⁹⁶ However, dissenters must also issue a written opinion.⁹⁷ A decision must be communicated to the parties within three days, and all decisions are published on ICANN’s website.⁹⁸

G. Types of Domain Name Disputes

There are five basic types of conflicts that arise with respect to domain names: cybersquatting disputes, competitor disputes, “palming off” disputes, parody disputes, and conflicting interest disputes.⁹⁹ Cybersquatters register domain names to later sell them to others for a profit. Cybersquatting can be legal – for example, one company bought the name “business.com” from an individual for \$150,000, and was later able to sell it for \$7.5 million.¹⁰⁰ On the other hand, federal law makes it illegal to register someone else’s company or brand name with “a bad faith intent to profit[.]”¹⁰¹ Finally, some

cyberquatters register the personal names of celebrities, such as “juliaroberts.com.”¹⁰² Motives for this type of registration range from hopes of selling the name, to using the name for a fan site, to a parody, to linking the name to another site to generate traffic.

Competitor disputes arise when a company registers the name or mark of its competitor to prevent them from that particular domain name, or to detour potential customers to the registrant’s own website.¹⁰³ Palming off disputes occur when someone registers a domain name merely to benefit from traffic intended for someone else. For example, the operator of a pornographic website might register the domain name “juliaroberts.com” to generate traffic for its website from people looking for Julia Roberts.

Parody disputes occur when a person registers a domain name that is similar to a company’s name or trademark (*i.e.*, www.walmartsucks.com) to criticize or satirize the company.¹⁰⁴ Finally, competing interest disputes arise when two people with legitimate interest in the same name or mark wish to register the same domain name.¹⁰⁵

H. Collision between Domain Names & Trademark Law

Trademark law is intended to keep consumers from being confused.¹⁰⁶ Trademark law does not give a person the exclusive right to use a name or word; rather, it grants the “right to make trademark use of a word on the products you sell in those markets in which you have actually done business.”¹⁰⁷ Thus, most trademarks are both territorial and product specific in nature.¹⁰⁸ Accordingly, multiple parties can use the same name or word to identify their particular goods or services. For example, United Van Lines has the exclusive right to use the UNITED mark for its moving services, while United Airlines has a contemporaneous right to use the UNITED mark for its airline services.¹⁰⁹ Conversely, a domain name registration for “united.com” can only go to one or the other.¹¹⁰

The narrow time limits set by the Rules and the arbitration fees prescribed by the various providers make the UDRP fast and cheap in comparison to customary litigation in the United States. The cost and ease of resolving disputes make it a powerful tool for trademark owners. Unfortunately, it appears that the UDRP has caused unwarranted extensions of trademark law to the detriment of individual rights and free speech. Arbitration panels that lack proper guidelines, expertise and time, make terrible decisions, mostly in favor of trademark owners. The problem is exacerbated by the arbitrators’ tendency to cite prior decisions as binding precedent, even though the UDRP does not require arbitrators to defer to prior decisions.¹¹¹



III. ANALYSIS

The UDRP is unfairly biased toward trademark owners for several reasons. First, the complainant gets to pick the arbitrator, and can therefore engage in forum shopping. Second, certain key terms in the UDRP are unintelligibly defined, or not defined at all. This facilitates bad decisions by arbitrators who are generally not trained in trademark law. Third, the UDRP's defenses fail to adequately protect non-trademark interests. Fourth, prior decisions are often cited as precedent; however, lack of uniformity between the law and rules applied in a given case provide little predictability for future parties. Finally, despite the anti-reverse domain name hijacking provision, the UDRP can and has been invoked to snatch domain name registrations away from legitimate users.

A. Forum Shopping

The UDRP permits complaints to engage in forum shopping. The complainant chooses the arbitrator, therefore the complainant can speculate as to which arbitrator is most likely to decide in its favor. Four arbitrators have been approved for by ICANN for dispute resolution purposes: the World Intellectual Property Organization ("WIPO"), the National Arbitration Forum ("NAF"), eResolution,¹¹² and CPR Institute for Dispute Resolution ("CPR").¹¹³ Since the complainant pays the arbitration bill, the arbitrators have an inherent incentive to decide cases in the complainant's favor.

As of April 19, 2001, approximately 3487 disputes have been commenced under the UDRP.¹¹⁴ 2117 of such disputes were submitted to WIPO, 1125 disputes were submitted to NAF, 223 disputes were submitted to eResolution, and 22 disputes were submitted to CPR.¹¹⁵ Researchers suggest four factors may impact a complainant's decision, namely, the average cost, probability of a favorable outcome, the complainant's country of origin, and average decision time.¹¹⁶

1. Average cost

The table to the right summarizes the costs for arbitration with the various ICANN-approved agencies.

SINGLE ARBITRATOR				
	WIPO	eResolution	NAF	CPR
NUMBER OF DOMAIN NAMES				
1	\$1500	\$1250	\$950	\$2000
2	\$1500	\$1250	\$1100	\$2000
3	\$1500	\$1500	\$1250	\$2500
4	\$1500	\$1500	\$1400	\$2500
5	\$1500	\$1500	\$1400	\$2500
6	\$2000	\$1850	\$1750	*
7	\$2000	\$1850	\$1750	*
8	\$2000	\$1850	\$1750	*
9	\$2000	\$1850	\$1750	*
10	\$2000	\$1850	\$1750	*
11-15	*	\$2300	\$2000	*

THREE ARBITRATORS				
	WIPO	eResolution	NAF	CPR
NUMBER OF DOMAIN NAMES				
1	\$3000	\$2900	\$2500	\$4500
2	\$3000	\$2900	\$2500	\$4500
3	\$3000	\$3250	\$2500	\$6000
4	\$3000	\$3250	\$2500	\$6000
5	\$3000	\$3250	\$2500	\$6000
6	\$4000	\$3250	\$3500	*
7	\$4000	\$3900	\$3500	*
8	\$4000	\$3900	\$3500	*
9	\$4000	\$3900	\$3500	*
10	\$4000	\$3900	\$3500	*
11-15	*	\$4600	\$4000	*

* To be determined by consultation

Prior studies by Dr. Milton Mueller indicate that the cost of arbitration possesses an almost inverse relationship with market share.¹¹⁷ Although WIPO's market share appears to have decreased slightly since Dr. Mueller's study was conducted in November 2000,¹¹⁸ WIPO still enjoys approximately 60% of the market share overall, despite its higher prices as compared to both eResolution and NAF.¹¹⁹

2. Favorable Outcome

According to ICANN's statistics, as of April 19, 2001 there were a total of 2639 dispositions by decision.¹²⁰ Out of these 2639, 2102 (79.65%) were decided in the complainant's favor.¹²¹ Of the remaining 537, 519 (19.67%) were decided in the respondent's favor, and there were 18 split decisions.¹²²





This author's review of ICANN's List of Proceedings resulted in slightly different numbers; however, the results confirm that nearly 80% of all decisions favor the complainant.¹²³ The following table summarizes decisions by the ICANN-approved arbitrators.

Provider	Decisions for Complainant**	Decisions for Respondent	Split Decisions	Total Number of Decisions
WIPO	1243	280	10	1533
NAF	742	156	1	899
eResolution*	110	75	1	186
CPR	12	7	1	20
TOTAL	2107	518	13	2638

*Also includes decisions by Disputes.org/eResolution Consortium, eResolution's predecessor

** Includes outcomes where the domain name registration was transferred or cancelled

As shown in the table above, the majority of cases are submitted to WIPO for disposition, followed not so closely by NAF.¹²⁴ Both WIPO and NAF appear to be a better choice from the complainant's perspective, with a low probability (less than 20%) that the complainant will lose.¹²⁵ In contrast, eResolution and CPR are much more likely to resolve disputes against the complainant (about 40% and 35%, respectively).¹²⁶

3. Complainant's Country of Origin

Complainants from outside the United States and Canada tend to choose WIPO because of its international reputation.¹²⁷ WIPO is based in Geneva, Switzerland.¹²⁸ NAF is a U.S. organization, with retired judges, attorneys, and law professors comprising its arbitrators.¹²⁹ eResolution is a Canadian organization, based in Montreal, Quebec.¹³⁰ Dr. Mueller's studies indicate that national preferences may play more than a trivial role in provider selection, e.g., non-U.S./non-Canadian complainants will choose WIPO, Canadian complainants choose eResolution, and U.S. complainants are likely to choose NAF.¹³¹ However, the studies were conducted when only 621 cases were decided, a small fraction of the current total number of cases. The studies must be updated to verify that the patterns continue as the total number of cases grows.

4. Decision Time

Dr. Mueller's studies further analyzed the average amount of time for a provider to issue a decision. According to such studies, it took eResolutions 55 days, WIPO 45 days, and NAF 37 days to make a decision.¹³² However, as discussed above, the studies were conducted with only a sample of 621 cases, and further investigation is required.

The UDRP attempts to balance any preference secured by the complainant (e.g., the trademark owner) via forum shopping by permitting the respondent to request a three-member panel. If the respondent elects a three-member panel, respondent may suggest three potential candidates for one of the arbitration positions. However, this option fails to ensure a level playing field for several reasons. First, if respondent requests a three-member panel, it must bear one-half of the arbitration fee. The fee currently ranges from \$2500 to \$4500 if a single domain name is involved, and half of this amount may be an insurmountable barrier to an individual. Second, although the Rules permit each party to suggest three potential candidates for one of the arbitration positions, the parties have no way of knowing if their candidates are available to serve on the panel.¹³³ If the candidates are unavailable or ineligible to serve, the provider chooses alternates.¹³⁴ As a result, all three panelists may end up being chosen by the provider, who is selected by the complainant.¹³⁵

B. Ambiguously-defined Terms

Some of the UDRP's key terms are ambiguously defined, or not defined at all. For example, a complainant must establish that the domain name "has been registered and is being **used in bad faith**."¹³⁶ The UDRP lists four circumstances (without limitation) that shall be evidence of bad faith:

- (i) circumstances indicating that you have registered or you have 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 your documented out-of-pocket costs directly related to the domain name; or
- (ii) you have 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 you have engaged in a pattern of such conduct; or
- (iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, you have 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 your web site or location or of a product or service on your web site or location.¹³⁷



1. "Use" of the Domain Name

It is unclear how broadly the term "use" can be construed.¹³⁸ In *Telstra Corporation Limited v. Nuclear Marshmallows*, a single panelist concluded that "the passive holding of the domain name by the Respondent amounts to the Respondent acting in bad faith[.]"¹³⁹ thereby substituting "acting" for the "used in bad faith" requirement.¹⁴⁰ However, in *Loblaws, Inc. v. Yogeninternational*, another single panelist failed to find bad faith use when the registrant merely put up an "under construction" page at the disputed domain address (presidentschoicesucks.com).¹⁴¹ Conflicting decisions such as these show that the UDRP is in fact far from uniform.¹⁴²

2. Defenses

The UDRP includes defenses where the registrant has "legitimate rights and interests" in the domain name. The UDRP contemplates three situations that "shall demonstrate your rights or legitimate interests[.]"¹⁴³ Specifically, if any of the following applies with respect to the registrant, a complainant cannot establish the second element required to prevail in a dispute (e.g., that the registrant has "no rights or legitimate interests in respect of the domain name").¹⁴⁴

- (i) before any notice to you of the dispute, your 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; or
- (ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you are 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.¹⁴⁵

However, despite the unambiguous language, at least one decision indicates that arbitration panels may not view the above as a complete defense.¹⁴⁶ Specifically, in *Fiber-Shield Industries, Inc. v. Fiber Shield Ltd.*,¹⁴⁷ the registrant was incorporated and doing business in Canada under the name "Fiber Shield (Toronto) LTD."¹⁴⁸ Although this seems to fit squarely within the second exception cited above, the arbitrator cancelled respondent's domain name registration for "fibershield.net," holding that the respondent had "no legitimate interest" in the domain name.¹⁴⁹

Additionally, in *Excelentísimo Ayuntamiento de Barcelona v. Barcelona.com Inc.*,¹⁵⁰ the arbitration panel essentially negated the defense, declaring that some parties have "better rights or more legitimate interests" than others.¹⁵¹

With respect to the fair use defense, many panels have failed to accord substantial weight to a registrant's free speech rights.¹⁵² It has been somewhat common for a person or entity to register "[trademark]sucks.com" for use as a critical or parody website.¹⁵³ There have been eleven disputes relating to use of a "sucks.com" domain name, nine of which resulted in a transfer of the domain name, despite the fact that no one would actually be confused about the source of the website.¹⁵⁴ One court stated that "Respondent's domain names are sufficiently similar to Complainant's mark... that Internet search engine results will list Respondent's domain names and websites when searching Complainant's mark[]" therefore diverting customers from Complainant's website.¹⁵⁵

3. Generic Terms

Trademark law does not protect generic words.¹⁵⁶ The UDRP also provides a defense for domain names registered as a "legitimate noncommercial or fair use of the domain name" without bad faith.¹⁵⁷ More than one panel, however, has concluded that a domain name registration for a generic word does not constitute fair use.¹⁵⁸ For example, in *J. Crew International, Inc. v. crew.com*,¹⁵⁹ the panel ordered the domain name "crew.com" transferred to J. Crew, reasoning that its trademark registration for "CREW" entitled it to the corresponding domain name registration.¹⁶⁰ Unfortunately, other cases have adopted similar reasoning.¹⁶¹

C. Precedent Problems

The UDRP requires each decision to be published on the Internet. However, the UDRP is silent with respect to the precedential value of prior decisions. Rather, the UDRP directs panels only to make decisions "in accordance with this Policy, these Rules and any rules and principles of law that it deems applicable."¹⁶² The fact-specific nature of the cases and divergent applications of existing trademark law, coupled with differences among the individual arbitrators, creates a "maze of international domain name decisions that... collide and conflict."¹⁶³

In addition, permitting the use of decisions as precedent promulgates the problem. A bad decision may be cited over and over as precedent for further bad decisions. A particular decision might apply a combination of domestic and foreign legal principles, or even "invented" law.¹⁶⁴ Further, a decision may be published in a foreign language, which makes it very difficult to search for potentially "precedential" decisions.¹⁶⁵ Indeed, it is possible that the UDRP may mutate "into the same litigation framework [it] was intended to circumvent."¹⁶⁶ This provides very little predictability for future UDRP participants.

UDRP decisions are appealable to a court of "mutual jurisdiction." However, appealing a bad decision may not be feasible, particularly if the loser is an individual or entity with lim-



ited resources. It is also important to note there is no mechanism for resolving conflicts between UDRP decisions.¹⁶⁷ Thus, under the UDRP, ICANN can prescribe and enforce rules without the checks and balances of a normal judicial system.¹⁶⁸

D. Reverse Domain Name Hijacking

Reverse domain name hijacking occurs when a trademark owner attempts to oust a legitimate user from its domain name registration in bad faith.¹⁶⁹ The J. Crew case described above is a good example of domain name hijacking; unfortunately, the respondent's arguments to this end were rejected by a majority of the panel. However, the dissenting arbitrator recognized the creation of "a dangerous and unauthorized situation whereby the registration and use of common generic words as domains can be prevented by trademark owners wishing to own their generic trademarks in gross."¹⁷⁰

Although a substantial number of plaintiffs have alleged reverse domain name hijacking, many arbitrators seem unwilling to entertain such proposals.¹⁷¹ In fact, several panelists have declined to find reverse domain name hijacking absent clear guidelines from ICANN.¹⁷²

IV. CONCLUSION

Trademark owners' rights have been unjustly expanded to the detriment of individuals and individual rights. Free expression and fair use are limitations on the rights afforded to trademark owners.¹⁷³ However, the arbitrators do not appear to recognize similar principles when applying the UDRP. Bestowing all-encompassing rights on trademark owners via the UDRP threatens to compromise free speech on the Internet. Domain names are not trademarks; rather, they are addresses, and should therefore be treated as such.¹⁷⁴

If the UDRP continues on its wayward course, it is likely that ICANN (and therefore the U.S. government) may lose its "top dog" position in Internet policymaking. There are no technical bars to creation of another worldwide networking system,¹⁷⁵ and in fact, some alternate TLDs have been available for as long as five years.¹⁷⁶ Domain names ending in ".web," ".ocean," ".mart," ".this," ".here," ".event," ".bot," ".pics," ".per," ".shop," ".family," ".chat," ".video," ".travel" and ".law" are yours for the asking (and the registration fee, of course).¹⁷⁷ However, others can't visit your website, or even know it exists, unless they program their computers to run off an alternate root server rather than the root file controlled by ICANN. Thus, it is possible that ICANN and its DNS could eventually become one addressing system in a sea of many, resulting in a very tangled World Wide Web.

In addition to alternate root servers, New.net, one of ICANN's competitors, recently made arrangements with ISPs such as Juno Online Services, EarthLink, ExciteAtHome and

NetZero for recognition of a series of 20 new TLD-like designations.¹⁷⁸ Users supported by these ISPs will be able to type in alternate endings, including ".sports," ".xxx," ".shop," ".inc." and ".tech" and be directed to websites registered under these alternate designations.¹⁷⁹ However, the designations are not true TLDs; rather, the company's software automatically (and invisibly) adds the extension ".new.net" to each designation, thereby routing the request to New.net's own servers for resolution.¹⁸⁰ As a technical matter, New.net is registering fourth-level domain names within the ".net" TLD.¹⁸¹

While there is at present no conflict between New.net's extensions and ICANN's TLDs, 18 of New.net's 20 extensions conflict with alternate TLDs already in use by alternate ISPs.¹⁸² The domain address would not be exactly the same (*i.e.*, whatever.xxx as compared to whatever.xxx.new.net); however, typing the same request (whatever.xxx) would take a person with New.net's software to the latter address, while everyone else would be taken to the former address.¹⁸³ While this might bring new meaning to the concept of confusion, it is a foreseeable result of ICANN's failure to play fair.

Endnotes

- ¹ See Jonathan Weinberg, *ICANN and the Problem of Legitimacy*, 50 DUKE L.J. 17, 187 (2000); Keith Perine, *Throwing Rocks at ICANN*, THE STANDARD (Mar. 27, 2000) <<http://www.thestandard.com/article/display/0,1151,13205,00.html>>.
- ² See Carl S. Kaplan, *A Kind of Constitutional Convention for the Internet*, THE NEW YORK TIMES CYBER LAW JOURNAL, Oct. 23, 1998 <www.nytimes.com/library/tech/98/10/cyber/cyberlaw/23law.html>; Kathleen Murphy, ICANN Tackles Question of Top-Level Domains Amid Never-Ending Questions About its Board Make-Up and Constitutionality, INTERNET WORLD MAGAZINE, Dec. 1, 2000 <<http://www.internetworld.com/120100/12.01.00ebusiness1.jsp>>.
- ³ See Domain Name System Privatization: Is ICANN Out of Control?: Hearings Before the Subcomm. on Oversight and Investigations, 106th Cong. (1999) [hereinafter *Hearings*] (testimony of Jon Weinberg, Professor of Law, Wayne State University).
- ⁴ See Jessica Litman, *The DNS Wars: Trademarks and the Internet Domain Name System* (2000) 4 J. SMALL & EMERGING BUS. L. 149, 150. Several websites offer domain name registry search services, such as Network Solutions, at <http://www.networksolutions.com/cgi-bin/whois/whois> (searchable by NIC handle (or contact), name, company name, domain name, IP address, and host/nameserver), and Internic, at <http://www.nsiiregistry.net> (searchable by domain, registrar and nameserver).
- ⁵ See JANET ABBATE, *INVENTING THE INTERNET* 189 (MIT Press Paperback Ed. 2000). The DNS was developed in large part by Paul Mockapetris in the mid-1980's. See *id.*
- ⁶ See *id.* at 188-89; A. Michael Froomkin, *Wrong Turn in Cyberspace: Using ICANN to Route Around the APA and the Constitution*, 50 DUKE L.J. 17, at 37-38 (2000) [hereinafter *Froomkin*].
- ⁷ See *Hearings*, *supra* note 3, at 2 (testimony of Jon Weinberg, Professor of Law, Wayne State University).
- ⁸ See Milton Mueller, *Technology and Institutional Innovations: Internet Domain Names*, 5 INT'L J. COMM. L. & POL'Y 1, 7 (2000). There are currently 252 TLDs. 244 are country TLDs, seven are generic TLDs, and the final one is ".arpa", which is used for reverse IP lookups. See *Froomkin*, *supra* note 6, at 39-40 n.62. Further, on November 16, 2000, ICANN approved seven new TLDs. See Oscar S. Cisneros, *ICANN: The Winners Are...*, WIREDNEWS (Nov. 16, 2000) <<http://www.wirednews.com/news/politics/0,1283,40228,00.html>>. Specific-



- cally, the TLDs “.biz” (for businesses), “.info,” “.name” (for individuals), “.pro” (for professionals), “.museum,” “.aero” (for the aeronautical industry), and “.coop” (for business cooperatives) will be available sometime this year. *See id.*
- ⁹ *See Froomkin, supra* note 6, at 39.
- ¹⁰ *See id.* at 41-42.
- ¹¹ *See id.* at 42. The root file is also called the “root zone” or “legacy root.” *See id.*
- ¹² *See* A. Michael Froomkin, *Habermas@discourse.net: Towards a Critical Theory of Cyberspace* (last modified Sept. 27, 2000) <<http://www.law.tm>>. The root file is maintained in parallel by 13 different computers. *See id.*
- ¹³ *See Froomkin, supra* note 6, at 42-43.
- ¹⁴ *See* Joseph P. Liu, *Legitimacy and Authority in Internet Coordination: A Domain Name Case Study*, 74 *IND. L.J.* 587, 591 (1999).
- ¹⁵ *See id.*; Joe Paone, Hold This for a While, then Cache it, *LANTIMES* (Jan. 1998) <<http://www.lantimes.com/98/98jan/801b044a.html>>.
- ¹⁶ *See* Joe Paone, Hold This for a While, then Cache it, *LANTIMES* (Jan. 1998) <<http://www.lantimes.com/98/98jan/801b044a.html>>.
- ¹⁷ *See* Jonathan Weinberg, *Internet Governance*, in *TRANSNATIONAL CYBERSPACE LAW* (Makoto Ibusuki ed. 2000) [hereinafter *Weinberg*].
- ¹⁸ *See Froomkin, supra* note 6, at 43.
- ¹⁹ *See Weinberg, supra* note 17, at 2.
- ²⁰ *See General Accounting Office Report*, Department of Commerce: Relationship with the Internet Corporation for Assigned Names and Numbers, July 7, 2000, available at <<http://www.gao.gov/ew/items/og00033r.pdf>> [hereinafter *GAO Report*]; *ACLU v. Reno*, 929 F. Supp. 824, 831 (E.D. Penn. 1996).
- ²¹ *See ACLU v. Reno*, 929 F. Supp. at 831.
- ²² *See id.*
- ²³ *See id.* *See generally* ABBATE, *supra* note 5.
- ²⁴ *See GAO Report, supra* note 20.
- ²⁵ *See Hearings, supra* note 3, at 2 (testimony of Jon Weinberg).
- ²⁶ *See GAO Report, supra* note 20, at 3.
- ²⁷ *See id.*; *Hearings, supra* note 3, at 2 (testimony of Jon Weinberg).
- ²⁸ *See* The Cook Report on Internet, Commerce Department Formation of ICANN Seen As Illegal End run Around the Administrative Procedures Act and the United States Constitution (visited Apr. 20, 2001) <<http://www.cookreport.com/illegal.shtml>>; *Froomkin, supra* note 6, at 20-21.
- ²⁹ There are currently at least 14 million registered websites, and about 59% of these sites are based in the United States. *See* Marilyn Geewax, *Plenty at Stake in Internet Site Address System*, *OHIO.COM TECH NEWS*, July 24, 2000, <<http://www.ohio.com/tech/news/docs/026915.htm>>. By 2003, there are expected to be about 160 million registered sites throughout the world. *See id.*
- ³⁰ *See GAO Report, supra* note 20; *Hearings, supra* note 3, at 2 (testimony of Jon Weinberg).
- ³¹ *See Weinberg, supra* note 17.
- ³² *See id.* at 2.
- ³³ NSF has authority for “supporting and strengthening basic scientific research, engineering, and educational activities in the United States, including the maintenance of computer networks to connect research and educational institutions.” *GAO Report, supra* note 20, at 2. NSF is an independent government agency that derives its authority from the National Science Foundation Act of 1950, as amended, and related legislation, 42 U.S.C. 1861 et seq., the Science and Engineering Equal Opportunities Act (42 U.S.C. 1885), and Title I of the Education for Economic Security Act (20 U.S.C. 3911 to 3922).
- ³⁴ NSF is the registrar for the “.com”, “.org”, “.net”, “.edu”, and “.gov” domains. *See GAO Report, supra* note 20, at 6.
- ³⁵ *See id.*
- ³⁶ The agreement was amended on September 13, 1995. *See id.*
- ³⁷ *See id.* The domain name services were underwritten by NSF, so registering a domain name was free to Internet users under this scheme. *See Weinberg, supra* note 17.
- ³⁸ *See Hearings, supra* note 3, at 3 (testimony of Jon Weinberg).
- ³⁹ Todd Lappin, *Playing Monopoly*. *BUSINESS 2.0*, May 1, 1999. *See* PGM Media, Inc. v. Network Solutions, Inc., 51 F.Supp.2d 389, 292-94 (S.D.N.Y. 1999), aff’d sub nom. Name.Space, Inc. v. Network Solutions, Inc., 202 F.3d 573 (2d. Cir. 2000). *See also* ELLEN RONY & PETER RONY, *THE DOMAIN NAME HANDBOOK* (1998) (provides information about more than four dozen domain disputes).
- ⁴⁰ *See* Luke A. Walker, *ICANN’s Uniform Domain Name Dispute Resolution Policy*, 15 *BERKELEY TECH. L.J.* 289, 295 (2000) [hereinafter *Walker*]; Oppedahl & Larson, *NSI Flawed Domain Name Policy* information page (last modified Dec. 21, 1999) <<http://www.patents.com/nsi.htm>>; *Panavision Intern., L.P. v. Toeppen*, 945 F.Supp. 1296, 1302 fn.2 (C.D. Cal. 1996).
- ⁴¹ Prior to 1995, NSI did not have a formal dispute resolution policy. *See Walker, supra* note 40, at 295.
- ⁴² *See id.*
- ⁴³ *See id.*
- ⁴⁴ *See id.* at 295-96.
- ⁴⁵ *See id.* at 296; Lisa T. Oratz, *Trademarks and the Internet* (last modified Apr. 16, 2001) <<http://www.perkinscoie.com/resource/ecomm/trademarks.htm>>.
- ⁴⁶ *See Weinberg, supra* note 17, at 3.
- ⁴⁷ The Internet Ad Hoc Committee was comprised of members from many other organizations, including the Internet Society, IANA, the Internet Architecture Board, the Federal Networking Council, the International Telecommunications Union, the International Trademark Association, and the World Intellectual Property Organization, as well as members from the Clinton administration. *See* <<http://www.iahc.org>> for a complete list of members.
- ⁴⁸ The top-level domains proposed by IAHC were “.firm” for businesses or firms; “.store” for businesses offering goods to purchase; “.web” for entities emphasizing activities related to the World Wide Web; “.arts” for entities emphasizing cultural and entertainment activities; “.rec” for entities emphasizing recreation/entertainment activities; “.info” for entities providing information services; and “.nom” for those wishing individual or personal nomenclature. *See* INTERNATIONAL AD HOC COMMITTEE, *FINAL REPORT OF THE INTERNATIONAL AD HOC COMMITTEE: RECOMMENDATIONS FOR ADMINISTRATION AND MANAGEMENT OF gTLDs* (Feb. 4, 1997).
- ⁴⁹ *See Weinberg, supra* note 17, at 3.
- ⁵⁰ *See id.*
- ⁵¹ *Id.*
- ⁵² *Id.*
- ⁵³ *Id.*
- ⁵⁴ William J. Clinton & Albert Gore, Jr., *A Framework for Global Electronic Commerce* (1997), available at <<http://www.ecommerce.gov/framework.htm>>. A presidential directive accompanying the report requesting the Secretary of Commerce to “support efforts to make the governance of the domain name system private and competitive and to create a contractually based self-regulatory regime that deals with potential conflicts between domain name usage and trademark laws on a global basis.” White House, *Memorandum for the Heads of Executive Departments and Agencies, Presidential Directive on Electronic Commerce*, July 1, 1997.
- ⁵⁵ *Improvement of Technical Management of Internet Names and Addresses*, 63 *Fed. Reg.* 8825 (1998) [hereinafter *Green Paper*].
- ⁵⁶ *See GAO Report, supra* note 20, at 7.
- ⁵⁷ *See Green Paper, supra* note 55, at 8827-28.
- ⁵⁸ *See id.* at 8828-29.
- ⁵⁹ *See GAO Report, supra* note 20, at 7. The Green Paper was criticized for being overanxious in its effort to create new domains and because of the absence of trademark dispute resolution policy. *See Trademarks, Electronic Commerce, and the Future of the Domain Name Assignment System: Hearing Before the Subcomm. on Telecomm., Trade, and Consumer Protection of the House Comm. on Commerce*, 105th Cong. (1998) (last modified July 6, 1998) <<http://www.inta.org/telcm.htm>> (testimony of Anne Chasser, Executive Vice President, International Trademark Association). In addition, critics complained that, despite the government’s purported relinquishment of power to the private sector, the government was actually expanding its control by “dictate the details” of the new system “which is the imposition of authority.” Malcolm MacLachlan, *Analysts Cautious but Positive on Green Paper* (last modified Feb. 2, 1998) <<http://www.techweb.com/wire/story/>



- domnam/TWB19980202S0014>. Further, critics argued that the proposed system left too much control with NSI. *See id.* Finally, others contended that the proposal failed to consider international interests. *See id.* The government received more than 650 comments to the proposed rulemaking. *See GAO Report, supra* note 20, at 7.
- ⁶⁰ *See* Management of Internet Names and Addresses, 63 Fed. Reg. 31,741, 31, 742 (1998) [hereinafter *White Paper*].
- ⁶¹ *See id.* at 31,749.
- ⁶² *GAO Report, supra* note 20, at 7.
- ⁶³ *See White Paper, supra* note 60, at 31749.
- ⁶⁴ *See GAO Report, supra* note 20, at 7.
- ⁶⁵ *See id.* at 8.
- ⁶⁶ *Id.*
- ⁶⁷ *Id.*; Letter from Boston Working Group to Ira Magaziner, Office of the President, and Becky Burr, NTIA (Sept. 28, 1998) (visited Apr. 17, 2001) <<http://www.ntia.doc.gov/ntiahome/domainname/proposals/bosgrp/submission-letter.html>>; Letter from Einar Stefferud, Temporary Chairman of the Board of Directors, Open Root Server Confederation, Inc., to Honorable William M. Daley, Secretary of Commerce (Oct. 8, 1998) (visited Apr. 17, 2001) <http://www.ntia.doc.gov/ntiahome/domainname/proposals/orsc/ORSC_PRO.htm>.
- ⁶⁸ Ms. Hauben's proposal against a private corporation as proposed in the White Paper, recommending instead "an international cooperative collaboration to administer and protect these key functions of the Internet from commercial and political pressures." Ronda Hauben, Proposal Toward an International Public Administration of Essential Functions of the Internet - The Domain Name System (visited Apr. 17, 2001) <<http://www.ntia.doc.gov/ntiahome/domainname/proposals/hauben/hauben.html>>.
- ⁶⁹ *See GAO Report, supra* note 20, at 8. Mr. Williams' proposal contended that "the current IANA proposal in its current form does not meet the requirements of the White Paper put out by the NTIA, and is not in the best interest of the vast majority of the Stakeholders." Letter from Jeffrey A. Williams, Director of Internet Network Engineering, Information Network Engineering Group to DNS Policy (Oct. 5, 1998) (visited Apr. 17, 2001) <<http://www.ntia.doc.gov/ntiahome/domainname/proposals/ineginc/ineginc.htm>>.
- ⁷⁰ *See GAO Report, supra* note 20, at 8. The ICANN proposal can be viewed at <<http://www.ntia.doc.gov/ntiahome/domainname/proposals/icann/icann.html>>.
- ⁷¹ *See GAO Report, supra* note 20, at 8.
- ⁷² *See Weinberg, supra* note 17, at 4.
- ⁷³ *Id.*
- ⁷⁴ *See id.* at 5.
- ⁷⁵ *See* Jay Fenello, *Power Politics and the New Internet Order*, IPERDOME, (visited Apr. 20, 2001) <<http://www.iperdome.com/writings/power.htm>>.
- ⁷⁶ *See Froomkin, supra* note 6, at 157.
- ⁷⁷ *See Weinberg, supra* note 17, at 5.
- ⁷⁸ *Id.*
- ⁷⁹ *Id.* ICANN held its initial meetings behind closed doors, proposed a tax scheme for domain name registrations that was hailed as "taxation without representation," and ICANN's feud with Network Solutions, Inc., who resisted ICANN's claims of authority. *See* Keith Perine, *Throwing Rocks at ICANN*, THE STANDARD (Mar. 27, 2000) <<http://www.thestandard.com/article/display/0,1151,13205,00.html>>; Anick Jesdanun, *Lord of the Domains: Conference to Discuss Addition of More Domain Names*, ABCNEWS.COM (July 10, 2000) <<http://www.abcnews.go.com/sections/tech/DailyNews/domains000710.html>>.
- ⁸⁰ *See Froomkin, supra* note 6, at 158. ICANN's interim Board approved six out of seven constituencies to make up the Domain Name Supporting Organization ("DNSO"), including ccTLD registries, commercial and business entities, gTLD registries, intellectual property interests, ISPs and connectivity providers, and registrars. *See* Resolution on DNSO Constituencies (May 27, 1999) <<http://www.icann.org/berlin/berlin-resolutions.html#1>>. The DNSO advises the ICANN Board on policy issues. *See* DSNO (visited Apr. 16, 2001) <<http://www.dnso.org/dns/aboutdnso.html>>. ICANN failed to approve the constituency representing non-commercial domain name holders. *See ICANN't Believe What They're Doing*, NATIONAL JOURNAL'S TECHNOLOGY DAILY (June 15, 1999) <<http://cyber.law.harvard.edu/pil-99/icannt.txt>>.
- 81 *See Froomkin, supra* note 6, at 23-25.
- 82 *See* ICANN, *Uniform Domain Name Dispute Resolution Policy* (Oct. 24, 1999) <<http://www.icann.org/udrp/udrp-policy-24oct99.htm>> [hereinafter *Policy*]. The UDRP applies to trademark disputes in the ".com," ".net" and ".org," as well as certain country-code TLDs. *See id.*
- 83 *See Walker, supra* note 40, at 299-300.
- 84 *See id.* at 299.
- 85 *See id.*; *Policy, supra* note 82.
- 86 *See Walker, supra* note 40, at 300; *Policy, supra* note 82.
- 87 *See Walker, supra* note 40, at 301.
- 88 *See Policy, supra* note 82, at ¶ 4(a).
- 89 *See Policy, supra* note 82.
- 90 *See id.* ¶ 4.; *Walker, supra* note 40, at 301-02. If the Complainant requests a single-member panel, and Respondent requests a three-member panel, then Respondent must pay one-half of the arbitration fee. *See Policy, supra* note 82 ¶ 4. Otherwise, the Complainant is responsible for the arbitration fee. *See id.* at ¶ 6(b).
- 91 *See* ICANN, *Rules for Domain Name Dispute Resolution Policy* (Oct. 24, 1999) <<http://www.icann.org/udrp/udrp-rules-24oct99.htm#5>> [hereinafter *Rules*].
- 92 *See id.* at ¶ 3(b)(iv); ¶ 5(b)(v).
- 93 *See id.* at ¶ 6(e).
- 94 *See id.* at ¶ 15(b).
- 95 *Id.* at ¶ 15(a).
- 96 *See id.* at ¶ 15(c)-(d).
- 97 *See id.* at ¶ 15(e).
- 98 *See id.* at ¶ 16(a)-(b).
- 99 *See* Melinda S. Giftos, *Reinventing a Sensible View of Trademark Law in the Information Age*, 2 J. INTELL. PROP. 2 (2000), available at <http://www.kentlaw.edu/student_orgs/jip/Vol2No1/trademark.htm> [hereinafter *Giftos*].
- 100 *See* Jeff Peline, *eCompanies plans business-to-business Net service*, CNET (Nov. 30, 1999) <<http://news.cnet.com/news/0-1005-200-1474285.html>>.
- 101 The Anti-cybersquatting Consumer Protection Act, 15 U.S.C. § 1125(d) (1999).
- 102 *See Giftos, supra* note 99.
- 103 *See id.*
- 104 *Id.*
- 105 *Id.*
- 106 *See* Jessica Litman, *The DNS Wars: Trademarks and the Internet Domain Name System*, 4 J. SMALL & EMERGING BUS. L. 149, 154 (2000) [hereinafter *Litman*].
- 107 *Id.* at 153.
- 108 This paper ignores special protection afforded to "famous" trademarks such as "KODAK" and "XEROX." Owners of so-called famous marks are generally able to stop non-confusing commercial uses of marks that are likely to blur the famous mark's significance. *See Litman, supra* note 106, at 154.
- 109 *See* Dori Kornfield, *Evaluating the Uniform Domain Name Dispute Resolution Policy* (visited May 1, 2001) <<http://cyber.law.harvard.edu/icann/pressingissues2000/briefingbook/udrp-review.html>> [hereinafter *Kornfield*]. There are approximately 53 active U.S. federal and state trademark applications/registrations for the mark UNITED. There are approximately 2,313 active U.S. federal and state trademark applications/registrations for marks containing the term "UNITED."
- 110 *See id.* The domain name "www.united.com" belongs to United Airlines.
- 111 *See* Jo Saxe Levy, *Precedent and Other Problems with ICANN's UDRP Structure* (visited May 4, 2001), available at <<http://www.dnrl.com/reporter/levyicann.shtml>> [hereinafter *Levy*].
- 112 Formerly the Disputes.org/eResolution Consortium.
- 113 *See* ICANN, *Approved Providers for Uniform Domain Name Dispute Resolution Policy* (updated Apr. 14, 2001) <<http://www.icann.org/udrp/approved-providers.htm>> [hereinafter *Providers*].
- 114 *See* ICANN, *Statistical Summary of Proceedings Under Uniform Domain Name Dispute Resolution Policy* (updated Apr. 19, 2001) <<http://www.icann.org/udrp/statistical-summary.htm>>.



- /www.icann.org/udrp/proceedings-stat.htm>. This number does not include twelve proceedings which were terminated for recommencement. See *id.*
- 115 See *Providers*, *supra* note 113.
- 116 See Milton Mueller, *Rough Justice: An Analysis of ICANN's Uniform Dispute Resolution Policy*, Version 2.1 (visited Apr. 22, 2001) <<http://dcc.syr.edu/roughjustice.htm>> [hereinafter *Mueller*].
- 117 See *id.*
- 118 Dr. Mueller's study indicated that WIPO's market share ranged from 61% to 66% between May and October 2000. See *id.*
- 119 2120 out of 3492 disputes have been submitted to WIPO since the UDRP was instituted. See *Providers*, *supra* note 113.
- 120 See ICANN, *Statistical Summary of Proceedings Under Uniform Domain Name Dispute Resolution Policy* (updated Apr. 19, 2001) <<http://www.icann.org/udrp/proceedings-stat.htm>>.
- 121 See *id.*
- 122 See *id.*
- 123 See ICANN, *List of Proceedings Under Uniform Domain Name Dispute Resolution Policy* (updated Apr. 19, 2001) <<http://www.icann.org/udrp/proceedings-list-number.htm>>. Unless otherwise noted, all statistical data are that of the author.
- 124 *Id.*
- 125 *Id.*
- 126 *Id.*
- 127 See *Mueller*, *supra* note 116.
- 128 See *The WIPO Arbitration and Mediation Center* (visited Apr. 22, 2001) <<http://arbiter.wipo.int/center/index.html>>.
- 129 See *Mueller*, *supra* note 116.; National Arbitration Forum, Forum Arbitrators (visited Apr. 22, 2001) <<http://www.arbforum.com/about/arbitrators.asp>>.
- 130 See *Mueller*, *supra* note 116. eResolution contact information is located at <<http://www.eresolution.ca/contact.htm>>.
- 131 See *Mueller*, *supra* note 116.
- 132 See *Mueller*, *supra* note 116. CPR was not analyzed because of insufficient data. See *id.*
- 133 See *Kornfield*, *supra* note 109.
- 134 See *id.*; *Rules*, *supra* note 91.
- 135 See *Kornfield*, *supra* note 109.
- 136 See *Policy*, *supra* note 82 ¶ 4(a)(iii) (emphasis added).
- 137 *Id.* at ¶ 4(b) (i) - (iv).
- 138 See *Kornfield*, *supra* note 109.
- 139 Telstra Corporation Limited v. Nuclear Marshmallows, D2000-0003 (Feb. 18, 2000) (Christie, Arb.), available at <<http://arbiter.wipo.int/domains/decisions/html/2000/d2000-0003.html>>. Several subsequent decisions have adopted the same rationale. See *Do The Hustle, LLC v. Donald Wilson*, D2000-0627 (Aug. 18, 2000) (Donahey, Arb.), available at <<http://arbiter.wipo.int/domains/decisions/html/2000/d2000-0627.html>> (inactive "polyesters.com" website plus failure to respond to Complainant's registered letters constitutes bad faith use and registration); *Sanrio Company, Ltd. and Sanrio, Inc. v. Neric Lau*, D2000-0172 (Apr. 20, 2000) (Samuels, Arb.), available at <<http://arbiter.wipo.int/domains/decisions/html/2000/d2000-0172.html>> (passive holding of a domain name constitutes bad faith use).
- 140 See *British Travel Agents Ltd. v. Sterling Hotel Group Ltd.*, WIPO D2000-0086 (Mar. 29, 2000) (Perkins, Arb.) (a "threat to infringe Plaintiff's well known trade marks" by bad faith registration of a domain name amounts to bad faith use).
- 141 See *Loblaws, Inc. v. Yogeninternational*, AF-0164 (June 9, 2000) (Grierson, Arb.), available at <<http://www.eresolution.ca/services/dnd/decisions/0164.htm>>.
- 142 See *Kornfield*, *supra* note 109.
- 143 See *Policy*, *supra* note 82, at ¶ 4(c).
- 144 See *id.* at ¶ 4(a)(ii).
- 145 *Policy*, *supra* note 82, at ¶ 4(c)(i) - (iii).
- 146 See *Kornfield*, *supra* note 109.
- 147 FA0001000092054 (Feb. 29, 2000) (Carmody, Arb.), available at <<http://www.arbforum.com/domains/decisions/92054.htm>>.
- 148 See *id.* at ¶ 4.
- 149 See *id.* (no "rights or legitimate interest in the domain name 'fibershield.net'.")
- 150 D2000-0505 (Aug. 4, 2000) (Porzio, Arb.), available at <<http://arbiter.wipo.int/domains/decisions/html/2000/d2000-0505.html>>.
- 151 *Id.*
- 152 See *Kornfield*, *supra* note 109.
- 153 See *supra* § II(F).
- 154 See ICANN, *List of Proceedings Under Uniform Domain Name Dispute Resolution Policy* (updated May 4, 2001) <<http://www.icann.org/udrp/proceedings-list.htm>>.
- 155 *Wal-Mart Stores, Inc. v. Walsucks and Walmarket Puerto Rico*, D2000-0477 (July 20, 2000) (Abbott, Arb.) available at <<http://arbiter.wipo.int/domains/decisions/html/2000/d2000-0477.html>>.
- 156 See *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111 (1938).
- 157 *Policy*, *supra* note 82, at ¶ 4(c)(iii).
- 158 See *Mueller*, *supra* note 116.
- 159 D2000-0054, (Apr. 20, 2000) (Page et al., Arb.) available at <<http://arbiter.wipo.int/domains/decisions/html/2000/d2000-0054.html>>.
- 160 See *id.*
- 161 See *Traditions Ltd. v. noname.com*, 0004000094388 (May 8, 2000) (Kalina, Arb.) available at <<http://www.arbforum.com/domains/decisions/94388.htm>> (purchasing generic domain names not legitimate business activity).
- 162 See *Rules*, *supra* note 91, at ¶ 15(a).
- 163 *Levy*, *supra* note 111.
- 164 See *id.* There are no evidentiary rules for UDRP proceedings; rather, documents may be submitted without authentication. See *Kornfield*, *supra* note 109. There are no provisions for discovery, testimony or cross examination, and rebuttals are discretionary. See *id.*
- 165 See *Levy*, *supra* note 111; *Kornfield*, *supra* note 109.
- 166 *Levy*, *supra* note 111.
- 167 See *id.*
- 168 See *id.*
- 169 See *Rules*, *supra* note 91.
- 170 *J. Crew International, Inc. v. crew.com*, D2000-0054, (Apr. 20, 2000) (Page et al., Arb.) available at <<http://arbiter.wipo.int/domains/decisions/html/2000/d2000-0054.html>>.
- 171 See *Mueller*, *supra* note 116.
- 172 See *id.*; *Strick Corporation v. Strickland*, FA # 94801 (July 3, 2000) (Condon, Arb.) available at <<http://www.arbforum.com/domains/decisions/94801.htm>>.
- 173 See *Mueller*, *supra* note 116.
- 174 See *id.* Of course, some domain names can function as trademarks, and such names should be accordingly be afforded trademark status. *Id.*
- 175 See *Froomkin*, *supra* note 6, at 39.
- 176 See *generally* *Open Root Server Confederation* (visited Apr. 22, 2001) <<http://www.open-rsc.org/>>.
- 177 See *Thor Olavsrud, New.net Offers TLDs but Raises Issues*, INTERNET NEWS (Mar. 9, 2001) <http://www.internetnews.com/isp-news/article/0,,8_709701,00.html> [hereinafter *Olavsrud*]; *Wahmpreneur*, ICANN Releases Prelim Report on New TLDs (visited Apr. 24, 2001) <<http://www.wahmpreneur.com/Archives/Nov00/newtlds.html>>.
- 178 See *Don Clark, New Twist in Top-level Domain Name Game*, ZDNET NEWS (Mar. 5, 2001) <<http://www.zdnet.com/zdnn/stories/news/0,4586,2692518,00.html>>; *Thor Olavsrud, New.net Offers TLDs but Raises Issues*, INTERNET NEWS (Mar. 9, 2001) <http://www.internetnews.com/isp-news/article/0,,8_709701,00.html>.
- 179 See *Olavsrud*, *supra* note 177.
- 180 See *id.*
- 181 See *Paul Prince, Routing Around*, TELE.COM (Mar. 19, 2001) <<http://www.teledotcom.com/article/TEL20010319S0006>>.
- 182 See *id.*
- 183 See *id.*



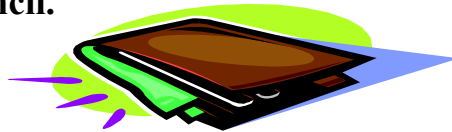
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