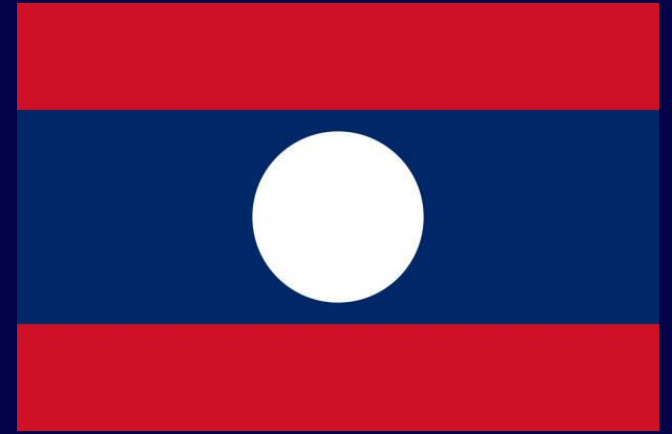


# APTLD 83



## Session 9 – Trademark Protection under Different Legal Regimes

### UDRP Trademark

Raedene McGary, VP Registry Services

**tucows/registry**

**tucows/registry**

# Legal & Policy Services

Making the Internet Better

**Date: 22 Feb 22**


## Tucows

Tucows started in 1993 as a simple shareware site, and has grown into a stable of 3 businesses each sharing the same goal: making the internet better.

Tucows Domains is the world's second largest domain registrar. We manage millions of domains to help people and businesses all over the world find their places online.

Ting Internet is committed to delivering future proof fiber internet access to communities across the US providing faster more reliable internet connectivity.

Wavelo is a telecom SaaS start-up that revolutionizes how communication service providers (CSPs) do business. We modernize the software that powers telecoms around the world simplifying BSS and OSS to enable features, functionality and new customer experiences.

The logo for Tucows Domains, featuring a white forward slash followed by the word "domains" in a white, lowercase, sans-serif font, all set against a solid purple rectangular background.The logo for Ting, featuring the word "ting" in a white, lowercase, sans-serif font. Above the letters "i" and "n" are three small white star-like sparkles. In the bottom right corner, there is a small white icon of a rocket ship with a trail, set against a solid blue rectangular background.The logo for Wavelo, featuring a stylized white script "W" followed by the word "wavelo" in a white, lowercase, sans-serif font. The background is a dark purple rectangle with abstract, colorful, wavy lines in shades of blue and pink.

# UDRP URS

Trademark disputes can be clear cut or complicated especially in a global market place

**/registry**

# **ICANN PROVIDERS of Dispute Resolution**

Arab Center for Dispute Resolution (ACDR)\*

Asian Domain Name Dispute Resolution Centre  
(ADNDRC)

Canadian International Internet Dispute  
Resolution Center (CIIDRC)

Czech Arbitration Court Arbitration Center for  
Internet Disputes

National Arbitration Forum\*

WIPO – World Intellectual Property Organisation

MFSD srl \*

# **3 Elements Test for successful UDRP claim...**



**Domain name must be identical or confusingly similar any marks can included common law marks**

**Why the Respondent (current registrant) has no rights or interest in the domain**

**The manner in which the domain was used in bad faith**

# Test for successful URS claim...



URS is a fast, inexpensive dispute procedure to combat cybersquatting and trademark infringement by domain name registrants **stop cyber-squatting in new gTLDs**

**Domain name must be identical or confusingly similar to trademark – national, court or treaty**

**Why the Respondent (current registrant) has no rights or interest in the domain**

**Clear and convincing evidence (higher burden of proof)**

**The manner in which the domain was used in bad faith**

# ICANN's IP Dispute process

**UDRP – Claim**

**URS – Claim**



## **Case Requirements to file**

UDRP – 3 Elements Test

URS – 3 Elements clear cut



## **Outcome Scores**

- UDRP transfer to claimant
- URS suspension for the remaining life of the registration



## Unintended consequences

Many trademark owners realised that many small domain registrants would not defend the proceedings, even if innocent passive holding not infringing. If sales negotiations broke down or were seen to be prolonged, brands have launched UDRP proceedings – in bad faith, a plan B if commercial negotiations broke down.

Lorem ipsum dolor

# What is bad faith?

**What if the registrant is just passively holding the domain name?**

**/registry**

**REVERSE DOMAIN NAME**

**HIJACKING**

# Reverse Domain Name Hijack Case 1

Nubank.com – WIPO Case Key points



**Claimant Nubank** – Brazilian finance company that raised billions



**Registrant held the domain for long time** – but didn't respond to case. Held well before Nubank existed



**Claimant offered \$\$ to registrant**  
Apparently there was no interest to sell.



**Result – Reverse DN Hijacking**  
Panel found case brought in bad faith, admitted the failed negotiations and evidenced showed the domain was registered before Nubank started using the trademark.

*REVERSE DOMAIN NAME*

***HIJACKING***

# Reverse Domain Name Hijacking Case 2

transcrip.com – Case Key points



**Claimant biopharmaceutical co**



**Registrant – domain investor held the domain for long time since 2014– pay per click parking page links to transcription services**



**Claimant offered \$\$ to registrant**

Apparently never raised the trademark rights only tried to buy unsuccessfully



**Result – Reverse DN Hijacking**

Panel found case brought in bad faith, admitted the failed negotiations and evidence lacking of to prove the registrant is acting in bad faith.

# Questions?

[/registry](#)

**Would you like  
to know how to  
adopt the URS  
or UDRP and  
appoint  
providers?**

/registry

**/registry**



**Contact us**

**trs@tucows.com**



# Thank you!

[tucows/registry](https://tucows/registry)