

TWO NEW TOOLS TO COMBAT CYBERPIRACY A COMPARISON

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I. INTRODUCTION

A domain name was originally intended to perform a technical function, namely to designate the address of a computer connected to the Internet. Over the years, however, it has become more than that. As explained by one United States court, “a domain name is more than a mere internet address. It also identifies the internet site to those who reach it, much like a person’s name identifies a particular person, or, more relevant to trademark disputes, a company’s name identifies a specific company.”¹ As domain names grew in value as a means of identifying companies on the Internet, they also grew in value to third parties who saw in domain names consisting of a recognizable mark an economic opportunity to ransom the names, sell them to the highest bidder, use them to divert users to their own websites, or otherwise commercially benefit from the use of a known mark.

The initial response to acts of cyberpiracy was ad hoc. Domain name registrars, such as Network Solutions, Inc. and Register.com, adopted individual policies for dealing with claims against cyberpirates. Yet the policy adopted by both was narrowly constructed to cover only those situations where the complaining party had a trademark registration that was identical - right down to graphics and punctuation-to the domain name. As a result, this policy generally proved unsatisfactory.

The United States federal courts, meanwhile, attempted to fit cyberpiracy into existing legal theories of trademark infringement, unfair competition and dilution. This too proved unsatisfactory since these claims all required actual use of the offending mark by the defendant and a cyberpirate oftentimes made no use of a domain name beyond mere registration.

From these beginnings two new procedures have arisen specifically designed to address cyberpiracy. The first is the United States Anticybersquatting Consumer Protection Act (“ACPA”), signed into law on November 29, 1999, and codified in the Lanham Act.² The second is the Uniform Domain Name Dispute Resolution Policy (“UDRP”) adopted by the Internet Corporation for Assigned Names and Numbers (“ICANN”) in the Fall of 1999 and made applicable as of January 1, 2000 to those generic top-level domain names ending in the suffixes .com, .org, and .net.³ These two procedures have now coexisted for several months. As will be

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¹ *Cardservice International, Inc. v. McGee*, 950 F Supp 737, 741, 42 USPQ2d 1850, 1854 (ED Va 1997), affd 129 F3d 1258 (CA 4 1997).

² Pub L No 106-113 (1999), 113 Stat 1501 (1999), 16 USC §§ 1116, 1117, 1125(d) and 1129.

³ It is assumed that when ICANN adopts other generic top-level domain names (applications for which are being accepted through October 5, 2000), domain names using them would be subject to the UDRP as well. As to domain names ending with a country code, disputes are generally handled pursuant to the rules established by the entity who controls those registrations. Although many registrars have no policy at all, certain country code registrars have adopted the UDRP. These include the registrars for Tuvalu, Western Samoa and Niue. See *Christie’s, Inc. v. Ola Ljungberg*, WIPO DNU2000-0002 (applying UDRP to .nu country code top-level domain).

seen below, in routine cases of cybersquatting, the ACPA and UDRP apply essentially identical standards to reach similar results. In such cases, the UDRP has proven quicker and generally more cost effective. However, where cases are not routine, involve acts beyond the registration of a domain name, or require relief beyond the transfer or cancellation of the domain name, a proceeding under the ACPA or under other unfair competition laws is more appropriate.

II. PROCEEDINGS UNDER THE UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY

A. *Overview of UDRP Proceedings*

The UDRP applies to all domain names ending in .com, .org and .net, regardless of the registrar. Currently, all ICANN accredited domain name registrars have adopted the UDRP and require domain name registrants to agree to abide by the terms of that policy. The policy replaces the ad hoc domain dispute procedures that had previously been used by domain name registrars.

The focus of the UDRP is narrow, aimed solely at resolving disputes concerning allegations of abusive domain name registration.⁴ In a UDRP proceeding, the complainant has the burden of proof on four issues: (1) that it has rights in a trademark or service mark; (2) that the domain name at issue is identical or confusingly similar to a trademark or service mark in which the complainant has rights; (3) that the domain name registrant has no rights or legitimate interest in the domain name; and (4) that the domain name was registered and is being used in bad faith.⁵ The policy provides examples of registration and use of a domain name in bad faith. These include: (1) circumstances indicating that the registration was obtained for the purpose of selling, renting or otherwise transferring it to the complainant, or to a competitor, for consideration in excess of out of pocket costs; (2) the domain name was registered to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name; (3) the domain name was registered primarily for purposes of disrupting the business of a competitor; or (4) by using the domain name the registrant has intentionally attempted to attract for commercial gain Internet users to its site by creating a likelihood of confusion.⁶

The complainant will prevail only if it satisfies each and every element of the policy. A domain name registrant has numerous ways of attacking the complainant's case. For example, the domain name registrant can argue that (1) the complainant's mark is not sufficiently distinctive to merit protection; (2) the domain name is not confusingly similar to the trademark owned by the complainant; (3) it has rights or legitimate interests in the domain name by virtue of its use or its demonstrable preparations to use the domain name before it received any notice of the complainant's rights; (4) the registrant has been commonly known by the domain name; or (5) the registrant is making a legitimate commercial or fair use of the domain name.⁷

B. *UDRP Procedures*

⁴ Educational Testing Service v TOEFL, WIPO D2000-0044.

⁵ See UDRP ¶4 and Rules of UDRP ¶3. The UDRP and the Rules for the UDRP can be found at the ICANN website, www.icann.org.

⁶ UDRP ¶4(b).

⁷ UDRP ¶4(c).

A UDRP proceeding is started by the filing of a complaint with one of the dispute resolution service providers approved by ICANN and by paying the appropriate filing fee. The complainant has the right to select the provider.⁸ The complainant also gets to choose whether to submit the dispute to a single panelist or to a three-person panel. If the complainant selects a single panelist, the registrant can overrule this decision by asking for a three-person panel. In that event, the parties will split the provider's fees. In addition, and more importantly, both parties will have an opportunity to nominate panelists.⁹ The provider will attempt to choose one panelist from each party's list of candidates. The third panelist will be drawn from a list of five panelists selected by the provider and submitted to the parties for comment.¹⁰ While each provider follows the UDRP rules, each also has developed its own supplemental rules that govern everything from the form of the complaint, to the means for service, to the costs of filing.¹¹

The complaint that is submitted in a UDRP proceeding is a hybrid of a court complaint and summary judgment brief. The complaint must address each of the UDRP elements, specify the relief requested (transfer or cancellation of the name) and include several general provisions mandated by the UDRP.¹² The complaint should provide details of the complainant's trademark or service mark registrations; its use of the mark, including sales and advertising information; court decisions and other evidence of the fame of complainant's marks; any communications with the domain name registrant; print-outs of the registrant's website; and a listing of the registrant's other domain names. The complaint need not focus on activities in any one country. However, it is advisable to include specific information, to the extent it exists, evidencing the complainant's use and rights in its mark in the country where the domain name registrant or the nexus of its activities appear to be located. Sworn affidavits or similar evidence is not required but can be submitted. Before embarking on drafting the complaint, it is important to check the specific rules of the provider selected since each imposes a page-limit or word limit.

Each provider has established its own requirements for providing notice of the proceeding to the provider, the domain name registrar and the domain name registrant. After determining that the complaint contains all the necessary elements and after verifying with the domain name registrar that the complainant has named the proper party, the provider will send the complaint to the domain name registrant at the address listed in the registrar's directory. If the domain name registrant cannot be found because the contact information is incorrect, this will not prevent the UDRP proceeding from going forward.¹³

⁸ UDRP 14(d). There are currently four providers: disputes.org/eResolutionConsortium, the National Arbitration Forum ("NAF"), the World Intellectual Property Organization ("WIPO"), and CPR Institute for Dispute Resolution. This last entity was approved on May 16, 2000 and did not begin accepting complaints until May 22, 2000.

⁹ The list of panelists used by each provider can be found through a link at www.icann.org/udrp/approved-providers.htm. Generally, the panelists consist of attorneys, professors, corporate counsel and businessmen from various countries. The exception is NAF, whose panelists are all from the United States and most of whom are retired state court judges.

¹⁰ UDRP ¶¶6(c), 6(e).

¹¹ The specific rules, fees and requirements of each provider can be found at their respective websites: www.eresolution.com; www.arbforum.com, www.arbiter.WIPO.int, and www.cpradr.org.

¹² Model complaints are available at each provider's website, all of which can be accessed through www.icann.org. See Also Rules of UDRP ¶3.

¹³ Rules of UDRP ¶4.

Once the complaint has been sent to the domain name registrant, the domain name registrant will have twenty days to respond.¹⁴ Extensions will only be granted in exceptional circumstances. If there is no response, the panel hearing the case will make its decision based on the complaint.¹⁵ If the registrant responds, there is no automatic right for the complainant to submit additional information or to address matters raised in the response, although some providers (notably NAF) have loosened up this restriction. Additional submissions generally are at the discretion of the presiding panel.¹⁶ Once all of the papers are submitted, the panel has approximately fourteen days in which to render its decision unless extraordinary circumstances warrant additional time.¹⁷ The decision is made on the papers, without an argument or a hearing.¹⁸

The decisions reached by panels are limited to whether a domain name should be transferred or canceled. This is the only relief available.¹⁹ The complainant may request either the transfer or cancellation of a domain name. Because cancellation of a domain name will put that domain name back into the available pool of names giving rise to the possibility that a third party will register the name, a complainant should always seek a transfer of the domain name. The panel also may decide that a transfer or cancellation is not appropriate. Such a decision can be based on a finding that the complainant's mark is not sufficiently distinctive, the complainant has not proven each of the elements of the policy, or the issues raised by the complaint go beyond the limited powers of the UDRP and are better resolved by a court. Among those issues that panelists have deemed to be beyond their jurisdiction are questions relating to acquiescence, nominative fair use, likelihood of confusion, the validity or scope of any agreements between the parties, and whether a domain name registrant acted outside the scope of an arrangement with the complainant.²⁰

If a decision is rendered in favor of the complainant, the provider will notify the registrar who will then contact the complainant to make arrangements for the transfer of the domain name.²¹ No documentation or transfer agreement needs to be signed by the domain name registrant. Before notifying the registrar, however, the provider will wait ten business days to allow the registrant an opportunity to commence a lawsuit against the complainant. The lawsuit must be commenced in a court located in the jurisdiction of either the principal office of the

¹⁴ Rules of UDRP ¶5.

¹⁵ Rules of UDRP ¶ 14.

¹⁶ Rules of UDRP ¶12.

¹⁷ Rules of UDRP ¶16(b).

¹⁸ Rules of UDRP ¶13.

¹⁹ In *Sports Car World, Inc. v. Malcolm Cracknell*, NAF FA94448 (2000), the panelist ordered respondent to cease and desist from all use of the domain name. Such an order falls outside the scope of the UDRP.

²⁰ See, e.g., *Adaptive Molecular Technologies, Inc. v. Priscilla Woodward & Charles R. Thornton*, WIPO D2000-0006 (whether use made by domain name registrant constitutes fair use under principles of trademark law is beyond jurisdiction of the panel); *Draw-Tite, Inc. v. Plattsburg Spring Ins*, WIPO D2000-0017 (questions as to whether or not the domain name registrant had a license to use complainant's trademark and whether the domain name registrant overstepped the bounds of its agreement are arguments that are addressed to a court); *Credit Management Solutions, Inc. v. Collex Resource Management*, WIPO D2000-0029 (where there is a genuine dispute on likelihood of confusion, this cannot be resolved in the context of a UDRP proceeding); *Avnet, Inc. v Aviation Network, Inc.*, WIPO D2000-0046 (panel will not make substantive decisions on likelihood of confusion or the validity of a settlement agreement).

²¹ Rules of UDRP ¶16.

registrar or the domain-name holder's address as set forth in the domain name registration when the UDRP complaint is filed, whichever one the complainant has agreed to. If a lawsuit is commenced by the registrant, the decision of the UDRP panel will be put on hold until the lawsuit is resolved.²²

C. *The UDRP Scorecard*

As of August 31, 2000, 1,661 domain name dispute proceedings had been filed under the UDRP,²³ and 991 were disposed of by decision. Of the cases decided, 763, or 77 percent were in favor of the complainant.

Case law under the UDRP has provided insight into the meaning of each element the complainant must prove. As discussed more fully below, establishing rights in a mark only requires the complaining party to show use of a distinctive mark.²⁴ Similarity of marks is generally found where the domain name registrant takes all or a recognizable part of a mark and incorporates it into a domain name.²⁵ Lack of a legitimate interest in the domain name can be proven by showing that the domain name incorporates a highly distinctive mark, that registrant has made no use of the name, that the domain name registrant owns numerous domain names suggesting that it would be impossible to make legitimate use of any of them, or that the domain name registrant's business name is wholly distinct from the domain name.²⁶ Finally, on the issue of use and registration in bad faith, passive holding or parking of a domain name without use has been held actionable although there is not unanimity on this issue among panelists.²⁷

1. Does Complainant Have Valid Rights?

Turning to the first policy element that the complainant must satisfy, namely whether it has rights in a mark, the most common questions raised are whether the complainant must have a registered mark and, if so, whether the registration must be in the country in which the domain name registrant is located. The answer to both questions is no. So long as complainant can prove that it is using some designation as a "mark,"²⁸ and that the mark is distinctive,²⁹ this will suffice.

²² UDRP ¶4(k).

²³ The website of ICANN, at www.icann.org contains on it a full list of all of the UDRP proceedings that have been brought. The status of each of the cases is listed and the vast majority of the cases can be obtained at the site. Updated summaries can be obtained at www.icann.org/udrp/Proceedings-state.htm. WIPO keeps its own statistics, available at the www.WIPO.int website. As of July 31, 2000, 904 cases had been filed with WIPO and 369 were completed. WIPO panels found for the complainant in 62% of the cases decided, and found for the respondent in 15%. The remaining cases were withdrawn.

²⁴ See *infra* notes 28-33 and accompanying text.

²⁵ See *infra* notes 34-40 and accompanying text.

²⁶ See *infra* notes 41-63 and accompanying text.

²⁷ See *infra* notes 64-94 and accompanying text.

²⁸ See, eg, *Adobe Systems Incorporated v. Domain OZ*, WIPO D2000-0057 (UDRP merely requires that a complainant have rights in a trademark. The policy does not require that a trademark be registered for such rights to exist); *CSA International v. John O'Shannon and Care Tech Industries, Inc.*, WIPO D2000-0071 (UDRP Rules and policy is not confined to marks that are registered); *Bennet Coleman and Company Limited v. Stephen F. Lalwani et. al.*, WIPO D2000-0014 and D2000-0015 (extensive use of mark gives rights that are accorded protection under the UDRP). But see *The British Broadcasting Corporation v Jamie Renteria*, WIPO D2000-0050 (while noting that the UDRP does not limit the application of the policy to a registered trademark and that the WIPO final report on the domain name process did not distinguish between registered and unregistered marks, nevertheless the particular

To determine if there is use of a mark and whether the mark is distinctive, panels will generally look for guidance to the law of the country where the complainant is domiciled.³⁰ Of course, not all of the panels follow United States law to a tee. For example, several panels have held that a complainant established rights in a mark merely by filing an intent to use application, an analysis that is not supported by the Lanham Act.³¹ If the complaining party has a trademark registration, it will be presumed to have valid and protectible rights under the UDRP. Indeed, the panel will not question whether a registration should have been issued but will instead grant the presumption of validity to the registration.³²

The complainant does not have to show that it has obtained rights in the mark worldwide or even in the country where the domain name registrant is located. Complainant's use or registration of its mark anywhere is sufficient for purposes of stating a claim because the Internet has no territorial boundaries.³³

2. Is the Domain Name Confusingly Similar to Complainant's Mark?

The second element that the complainant must prove is that its mark is identical or confusingly similar to the domain name. The use of the term "confusingly similar" in a UDRP proceeding should not be interpreted by reference to the concept of likelihood of confusion under trademark law. Indeed, it has been noted that whether or not there is a likelihood of confusion between the complaining party's mark and a domain name is irrelevant.³⁴ Similarly irrelevant is whether the complainant's mark is famous, whether the goods on which the complainant's mark and domain name are used are similar, or if there are third party marks that are similar.³⁵ Rather,

panel noted that there was no clearly accepted practice among administrative panels applying the UDRP to unregistered trademarks).

²⁹ See Educational Testing Service, *supra* note 4 (noting that TOEFL is presumed distinctive based on its registration on the Principal Register and allowing the UDRP to proceed); *Pet Warehouse v. Pets.com, Inc.*, WIPO D2000-0105 (where evidence showed that PET WAREHOUSE was not distinctive, UDRP proceeding dismissed on the grounds that complainant had failed to establish valid rights in its trademark).

³⁰ See *eAuto L.L.C. v. Triple S Auto Parts*, WIPO D2000-0047 (because parties are both United States residents, panel applied United States law to find that the mark E-AUTO is distinctive in light of the fact that complainant had received a United States trademark registration); *Finter Bank Zurich v. Ginluca Olivieri*, WIPO D2000-0091 (determining complainant's rights by reference to Swiss law where complainant was domiciled). See also Rules of UDRP ¶15(a).

³¹ 15 USC §1057(O). See, eg, *Quixtar Investments, Inc. v. Dennis Hoffman*, WIPO D2000-0253. But see also *Northern Light Technology, Inc. v. Northern Lights Club*, 97 F Supp2d 96 (D Mass 2000) (plaintiff deemed to have had prior rights over domain name registrant where it had filed an intent-to-use application).

³² Educational Testing Service, *supra* note 4; *Busy Body, Inc. v. Fitness Outlet, Inc.*, WIPO D2000-0127.

³³ See *Bennet Coleman*, *supra* note 28 (noting that it is relevant to consider the effect of a domain name registration and use in relation to the registration and use of identical and confusingly similar trademarks in other countries and that it is not appropriate to only consider complainant's rights in the country where the domain name is hosted); *Infospace.com v. Infospace Technology Co. Ltd.*, WIPO D2000-0074 (the fact that complainant did not have a trademark registration in China, where the domain name registrant was located, was of no importance, the panelists finding that the relevance of trademark registrations is accorded little relevance in domain name disputes).

³⁴ See *Shirmax Retail Ltd. v. CES Marketing Group, Inc.*, AF-0104 (2000) (where domain name is identical to mark, first element of test is met "even if there is no likelihood of confusion whatsoever."); *Motorola, Inc. v. NewGate Internet, Inc.*, WIPO D2000-0079 (issue of similarity is independent of whether there is any actual or likelihood of confusion).

³⁵ See *Allocation Network GmbH v. Steve Gregory*, WIPO D2000-0016; *Gateway, Inc. v. Pixelera.com, Inc.*, D2000-0109.

this element is confined solely to a side-by-side comparison of the domain name and the mark parse without any contextual setting.³⁶ If anything, the element of whether or not the domain name is confusingly similar to a complainant's mark under the UDRP is analogous to a determination under trademark law of whether or not the infringing mark is similar to the infringed marks.³⁷ If an Internet search engine, in a response to a search for complainant's mark, pulls up the respondent's domain name, this element of the policy will be met. A domain name registrant cannot escape a finding of similarity by adding a geographic designation or a common or generic term to complainant's mark.³⁸ In addition, differences in the graphics between the trademark and domain name, in punctuation, in spacing, or in design will not effect a finding of confusing similarity.³⁹ Further, the registration of a domain name that is a misspelling of a trademark will be sufficient to invoke the policy.⁴⁰

To date, this has been the easiest element of the policy to satisfy. However, there may be some difficulties down the road. As of August 24, 2000, accredited registrars were able to register .com, .net and .org domain names in non-English characters. Registrations are available in Japanese, Korean and Chinese, and will extend to Spanish, Portuguese and Arabic. The question that is going to confront UDRP panelists is whether the confusing similarity test is met if the foreign domain name either translates to or is the foreign equivalent of an English language (or any other language) trademark.

3. Does the Registrant Have any Legitimate Interest in the Domain Name?

The third element the complainant must prove is that the domain name registrant does not have any legitimate interests in or rights to the domain name. According to one WIPO decision, the complainant's burden on this factor is "relatively light."⁴¹ The policy sets forth examples where legitimate interests would be found, such as registrant's use of the domain name, including use in connection with an active website, before receiving or learning of an objection or before complainant acquired rights in its mark; registrant's legitimate non-commercial or fair use of the domain name; or the registrant being commonly known by the domain name.⁴² This

³⁶ See Gateway, *ibid* (test of similarity is confined to a consideration of the disputed domain name and the trademark). But see Yahoo! Inc. v. Eitan Zviely, WIPO D2000-0273 (confusing similarity turns on similarity of use, marks, products, channels of trade, users and be like).

³⁷ This analogy is not exact, however, because in considering similarity of marks in a trademark infringement case, the court will consider such factors as the context in which the mark appears and the similarity between the parties' goods. These considerations generally are not applicable in UDRP proceedings.

³⁸ Quixtar, *supra* note 31 (QUIXTAR and QUIXTARMORTGAGE legally identical); CSA, *supra* note 28 (CSA and csa-canada.com are confusingly similar); Wal-Mart Stores, Inc. v. Walmarket Canada, WIPO D2000-0160 (WAL-MART and walmartcanada.com are confusingly similar).

³⁹ Chernow Communications, Inc. v. Jonathan D. Kimball, WIPO D2000-0119. Moreover, The Channel Tunnel Group Ltd. v. John Powell, WIPO D2000-0038, states that adding punctuation such as a hyphen is evidence of bad faith.

⁴⁰ Encyclopaedia Britannica, Inc. v. John Zuccarini, WIPO D2000-0330; Reuters Limited v Global Net 2000, Inc., WIPO D2000-0441; Eddie Bauer, Inc. v. Paul White d/b/a Spider, Inc., AF-0246(2000).

⁴¹ See Educational Testing Service v. NetKorea Co., WIPO D2000-0087.

⁴² UDRP ¶4(c). However, such facts are not necessary dispositive. For example, in Quixtar, *supra* note 31, although respondent was using QUIXTARMORTGAGE.COM before any notice of the dispute, the panelist found that in light of evidence showing that respondent was seeking to ride on complainant's rights, such prior use was not bona fide. Similarly, in Fiber-Shield Industries, Inc. v. Fiber Shield Ltd., NAF FA92054 (2000), the domain name registrant had been incorporated and had been doing business in Canada under the name Fiber Shield (Toronto) Ltd.

last factor has been extended to names of pets. Indeed, in one case the domain name registrant's allegations that the domain name miguard.com was based on the domain name registrant's dog who went by the nickname Miguard was credited by the panel and led to a decision for the domain name registrant.⁴³

Case law has added other ways to show that a registrant has a legitimate interest in the contested domain name. For example, if the complainant's mark is weak and could legitimately be used by a variety of individuals or entities, this may be sufficient to defeat complainant's case.⁴⁴ Another case suggests that where there is no evidence that respondent knew or should have known of complainant's mark and where the mark could be descriptive the domain name registrant may be able to show legitimate rights.⁴⁵ Other examples of legitimate rights include registration of common words or phrases for purposes of resale;⁴⁶ registration of a domain name that is identical to the registrant's company name;⁴⁷ and registration of a domain name that is a natural and expected expansion of a prior-used name.⁴⁸

Even if there is a finding of legitimate rights under the UDRP, this does not mean that the complaining party who has lost the proceeding has no basis for pursuing legal action in court. All the finding means is that the streamlined UDRP procedure is not available and that the dispute is a legitimate one that should be decided by the courts.⁴⁹

There are as many different reasons for finding that a registrant lacks rights as there are different panelists and different UDRP cases. The UDRP points to certain facts as evidencing a lack of rights. These include the failure to use or prepare to use the domain name prior to notice of the dispute; the fact that registrant was never commonly known by the domain name; the failure to make legitimate non-commercial or fair use of the name; the use of the name for

Unable to obtain the domain name fibershield.com which was registered to complainant, the company instead registered the domain name fibershield.net. The panel held that it was "clear" that the domain name registrant took fibershield.net with actual awareness of the prior domain name registration owned by the complaining party. The panel also concluded that the domain name was registered in bad faith and that the registrant had no legitimate rights or interest in respect to the domain name. This despite the fact that it was uncontested that the registrant actually was doing business under that name. Not surprisingly, the respondent has filed a lawsuit which effectively stayed the panel's decision canceling the domain name.

⁴³ See *Vanguard Medica Limited v. Theo McCormick*, WIPO D2000-0067.

⁴⁴ See, eg, *eAuto L.L.C. v. EAUTO Parts*, WIPO D2000-0096 (where complainant's trademark is weak, it is difficult to argue that domain name registrant lacks legitimate interest in a domain name that is descriptive of a business). This defense seems to be losing ground, however, as shown in some recent cases. See, eg, *The Universal Gift Certificate Company, LLC v. Alexico Health Care Resources, Inc.*, NAF FA94318 (2000) (noting that complainant had rights in the mark UNIVERSAL GIFT CERTIFICATE sufficient to prevent use of universalgiftcertificate.com); *Pentegra Dental Group, Inc. v. Domain Owner*, NAF FA94649 (2000) (awarding complainant protection for the mark E DENTIST); *Excelentísimo Ayuntamiento de Barcelona v. Barcelona.com, Inc.*, WIPO D2000-0505 (ordering transfer of the domain name barcelona.com noting the right and legitimate interest of the city government of Barcelona in being able to use BARCELONA in any manner that the expression can legally appear).

⁴⁵ *Allocation Network*, supra note 35.

⁴⁶ *Ibid.* But see case cited infra note 78.

⁴⁷ *VeriSign Inc v. VeneSign C.A.*, WIPO D2000-0303.

⁴⁸ *Meredith Corp. v. CityHomes, Inc.*, WIPO D2000-0223 (where registrant already using City-Home for real estate services, panel found it was natural to adopt countryhome.com).

⁴⁹ *Metabolife International v. Spectrum Labs*, WIPO D2000-0509.

commercial gain by diverting consumers, or the tarnishment of the mark.⁵⁰ Other circumstances proving the registrant's lack of legitimate rights or interest in the domain name are:

- a. The complainant's mark is so distinctive that no one could legitimately choose it unless trying to trade off the complainant's rights;⁵¹
- b. The complainant's use of its mark predates the registration of the domain name and domain name registrant has no association with complainant;⁵²
- c. The registrant owns numerous domain names which suggests that it is unlikely that the registrant could or would make legitimate use of any one of them;⁵³ or
- d. The domain name registrant has offered to sell the domain name.⁵⁴

One of the more hotly contested issues in UDRP proceedings concerns the right to use a trademark as part of a domain name either to advertise the fact that the site offers the trademark owner's goods or to discuss the trademark owner. Where the respondent is legitimately selling the complaining party's trademarked goods, or commenting on the complainant, one might assume that the respondent would have a legitimate interest in using the complaining party's mark. While certain cases have accepted this argument,⁵⁵ it is far from "black letter" UDRP law. Thus, for example, in *Motorola, Inc. v. NewGate Internet, Inc.*, the panel held that the right to resell genuine products does not create the right to use the mark as a domain name because such activity goes further than what is required to sell goods.⁵⁶ Similarly, in *DFO, Inc. v. Christian Williams*, the panel held that there was no fair use of the domain name *dennys.com* even though it had been used for a chat website about the Denny's restaurant chain.⁵⁷ The reasoning of these

⁵⁰ UDRP ¶4(c).

⁵¹ *Telstra Corp. Ltd. v. Nuclear Marshmallows*, WIPO D2000-0003 ("Telstra" was an invented word and not one that a third party would legitimately choose unless trying to create impression of association); *British Broadcasting*, supra note 28.

⁵² *Compaq Computer Corp. v. Boris Beric*, WIPO D2000-0042.

⁵³ *Nabisco Brands Co. v. The Patron Group, Inc.*, WIPO D2000-0032.

⁵⁴ *Stella D'Oro Biscuit Co. v. The Patron Group, Inc.*, WIPO D2000-0012.

⁵⁵ *Draw-Tite*, supra note 20; *eAuto, Inc. v. Available-Domain-Names.com, d/b/a Intellectual-Assets.com, Inc.*, WIPO D2000-0120; *Weber-Stephen Products Co. v. Armitage Hardware and Building Supply, Inc.*, WIPO D2000-0187; *Bridgestone-Firestone, Inc., et. al. v. Jack Myers*, WIPO D2000-0190 (use of the domain name *bridgestone-firestone.net* to designate a website for criticism and commentary about the complaints constitutes legitimate noncommercial use and fair use under the policy).

⁵⁶ Supra note 34.

⁵⁷ WIPO D2000-0187. *Accord The Channel Tunnel Group*, supra note 39 (no need to use complainant's mark in domain name for website relating to the tunnel); *Daimler Chrysler Corp. v. Brad Bergman*, WIPO D2000-0222 (use of *dodgeviper.com* for fan site is not fair use); *Mission KwaSizabantu v. Benjamin Rost*, WIPO D2000-0279 (use of complainant's mark for domain name attached to site that includes alternative views and critical views of complainant is not fair use but rather tarnishment). See also *People for the Ethical Treatment of Animals v. Doughney*, 2000 US Dist LEXIS 9474 (ED Va June 12, 2000) (use of *PETA.ORG* for alleged parody site is not fair use since the Internet user would not realize it was not an official site until after accessing website).

cases was crystallized in *Monty and Pat Roberts, Inc. v. Bill Keith*:⁵⁸ “the right to express one’s views is not the same as the right to use another’s name to identify one’s self as the source of those views.” The cases suggest that unless a domain name gives a clear indication of what is on the corresponding website or otherwise makes it apparent on its face that it is not the trademark owner’s site, the fair use argument will be unavailing.

Even where a clear indication of the nature of the website can be discerned from the domain name, the outcome of a UDRP proceeding is not at all certain. There are a number of UDRP cases that have been filed which deal with domain names that consist of a famous mark followed by the disparaging term “sucks.”⁵⁹ In the first case dealing with this issue, the WIPO panel held that the domain names *walmartcanadasucks.com*, *wal-martcanadasucks.com*, *walmartuksucks.com* and *walmartpuertoricosucks.com* violated the UDRP.⁶⁰ While the panel recognized that there could be situations where domain names consisting of a trademark plus a critical or pejorative term such as “sucks” would be permissible as fair use, the record in the particular case showed that the intent of the registrant was not to express an opinion about Wal-Mart but rather to show Wal-Mart that it was not adequately protecting its marks on the Internet. The registrant also asked to be compensated for his role as a “domain name consultant.” The panel noted that a demand for payment from the subject of the allegedly critical site “is fundamentally inconsistent with the right of free expression.”

The panel specifically recognized that its decision “does not address legitimate freedom of expression sites established by parties critical of trademark holders.” While domain name registrants are likely to characterize the decision as one that seeks to stifle free expression on the Internet and trademark holders are likely to characterize the decision as prohibiting “sucks” formative domain names, the panel bluntly stated that the decision is not meant to serve either purpose.

Since the Wal-Mart decision, there have been several others dealing with the “sucks” issue. Five decisions came down on August 13, 2000 against the same respondent. That respondent had registered the domain names *natwestsucks.com*, *standardcharterededsucks.com*, *directlinesucks.com*, *dixonssucks.com*, and *freeservesucks.com*. In all cases, the domain name was transferred to the complainant.⁶¹

Do these cases strike a blow against free speech? No. In all of them, the respondents were neither using the domain names nor were they planning on using them in order to provide a forum for free expression about the trademark owner. Rather, the respondents stated that they registered the names to protect the complainants against the risk of such a forum. In effect, it was the registrant who was stifling free expression.

⁵⁸ WIPO D2000-0299. *Accord PACCAR, Inc. v. TeleScan Technologies, LLC*, 2000 US Dist LEXIS 12857 (ED Mich August 25, 2000).

⁵⁹ See WIPO D2000-0583, 684, 686, 636, 662, 681; NAF FA95080 (2000).

⁶⁰ See *Wal-Mart Stores, Inc. v. Walsucks and Walmart Puerto Rico*, WIPO D2000-0477.

⁶¹ See *National Westminster Bank PLC v. Purge I.T. & Purge, I.T. Ltd.*, WIPO D2000-0636; *Standard Chartered PLC v. Purge I.T.*, WIPO D2000-0681; *Direct Line Group Ltd., et. al. v. Purge I.T., Purge I.T. Ltd.*, WIPO D2000-0583; *Dixons Group PLC v. Purge I.T. & Purge I.T. Ltd.*, WIPO D2000-0584; and *Free Serve PLC v. Purge I.T. & Purge I.T. Ltd.*, WIPO D2000-0585. A similar result was reached in *Cabela’s, Inc. v. Cupcake Patrol*, NAF FA95080(2000).

In addressing whether each of the complainants satisfied the elements of the policy, the panel first considered whether the domain names were identical or confusingly similar to the complainant's trademarks. The panel concluded that because the first element in the domain name was the complainant's name or mark, the domain name would not necessarily be recognized as being unaffiliated or unauthorized by the complainant.⁶² Moving to whether the respondents demonstrated legitimate rights or interests in the domain name, the panel found none, stating that there is "no justification for the role of vicarious interferer which the respondents have taken upon themselves."

The panel also had no trouble finding that the respondents registered and were using the domain names in bad faith since the respondents contacted the complainants, advised that the reason for the registrations was to make a modest return for their initiative in registering the domain name, and sought an amount of money for the transfer of the names which exceeded the costs incurred in registering them. Thus, the panel found a violation of UDRP Paragraph 4(b)(1) which states that a domain name is registered and used in bad faith if the registrant registered or acquired the domain name primarily for the purposes of selling it for consideration in excess of out of pocket costs. These cases, like the Wal-Mart case, do not address the use of a trademark in connection with a pejorative term as a domain name which is used solely for a non-commercial site.

One case that did is *CompUsaManagementCo.v Customized Computer Training*.⁶³ The domain names at issue were *stopcompusa.com* and *bancompusa.com*. The panelist found that there was no confusion or similarity between the domain names and the COMPUSA trademark. On the issue of legitimate rights, the panel found that respondent had rights to the names under the First Amendment and could use them to offer criticism of the goods and services provided by complainant. Finally, the panel found no evidence of bad faith. While the panel noted that the point of the registrations was to disrupt the business of the complainant, the UDRP requires a finding that the names were registered for purposes of disrupting the business of a competitor. Since complainant and respondent were not competitors, no bad faith was found.

4. Did the Registrant Use and Register the Domain Name in Bad Faith?

The final element the complainant needs to prove under the UDRP is that the domain name was used and registered in bad faith. While the UDRP speaks of both use and registration, the two issues frequently are combined, at least from an evidentiary standpoint. In fact, in the UDRP the same set of facts and circumstances will evidence both bad faith use and bad faith registration.⁶⁴

The UDRP provides no definition of "use." If "use" were defined as it is under the Lanham Act to mean actual use of the domain name in connection with providing goods or services, then the UDRP would provide little assistance to trademark owners, since in the majority of cybersquatter cases the domain name registrant often warehouses or parks the domain name and may take no other action.

⁶² If the first term of the domain name was critical of the complainant, this may have led to a decision that the mark and domain name were not confusingly similar and thus the policy was not violated.

⁶³ NAF FA95082 (2000).

⁶⁴ UDRP ¶4(b).

What constitutes “use” was addressed in the first case decided under the UDRP *In World Wrestling Federation Entertainment, Inc. v Michael Bofman*,⁶⁵ the panel faced the situation where the registrant had registered the domain name *worldwrestlingfederation.com* but had made no actual use of it.⁶⁶ All the registrant did was to offer to sell the domain name to the complainant. The panel concluded that the offer to sell the domain name constituted use and registration in bad faith.

The World Wrestling decision did not answer the question of what actually constitutes “use” in a UDRP proceeding. This issue was specifically addressed in a subsequent decision, *Telstra Corporation Ltd. v. Nuclear Marshmallows*.⁶⁷ There, the panel was confronted with a situation where the domain name registrant had taken no affirmative steps to use the domain name. The panel stated that the notion of using a domain name in bad faith does not require that affirmative action be taken by the domain name registrant. Rather, to determine whether there is bad faith use of a domain name, all of the circumstances of a case must be examined.

The notion that mere passive holding of a domain name can constitute “use” in bad faith has now become a basic tenet of the UDRP case law.⁶⁸ As explained by one panelist, the term “use” as used by the UDRP does not have the same definition of “use” under trademark laws. Under the UDRP, use includes any kind of activity through which a domain name owner derives or attempts to derive economic benefit or commercial gain.⁶⁹

One of the most common circumstances evidencing bad faith use and registration is an offer by the domain name registrant to sell the domain name. The offer can be direct, as in an email or other communication to the complainant,⁷⁰ or it can be an offer to sell that was made in response to an inquiry from the complainant.⁷¹ It can be more general, such as an offer of the name for auction on such publicly available sites as “eBay,”⁷² or it can be subtle, such as merely

⁶⁵ WIPO D99-0001.

⁶⁶ In fact, no use would have been possible for some time, as many browsers did not accommodate domain names of this length.

⁶⁷ *Supra* note 51.

⁶⁸ See, eg, *Guerlain S.A. v. Peikang*, WIPO D2000-0055; *The Hamlet Group, Inc. v. James Lansford*, WIPO D2000-0073. But see *Sporoptic Pouilloux S.A. v. William H. Wilson*, WIPO D2000-0265 (although registration of *buyvuarnetglasses.com* found to be in bad faith, complaint was denied because there was no use of the domain name).

⁶⁹ See *Educational Testing Service v. NetKorea Co.*, *supra* note 41; *The Chicago Tribune Co. v. Jose P Varkey*, WIPO D2000-0133 (commercial gain of attracting viewers to respondent’s website in order to solicit them to join respondent’s organization is actionable).

⁷⁰ *Surf dog, Inc. v. Dr. Charles Cooper*, WIPO D2000-0065; *Blue Sky Software Corp. v Digital Sierra, Inc.*, WIPO D2000-0165.

⁷¹ *China Ocean Shipping (Group) Co. Ltd. v. Cao Shan Hui*, WIPO D2000-0066. But see *Pacific Place Holdings Ltd. v. Richard Greenwood*, WIPO D2000-0089 (fact that the registrant was agreeable to selling its domain name for \$1500 after being approached on behalf of complainant is not evidence that name was registered for the primary purpose of selling it to complainant); *BSA v. Eric R. Hilding*, WIPO D2000-0320 (where complainant tried to convince respondent to sell name and made initial contact, no bad faith found).

⁷² *Edgar Rice Burroughs, Inc. v. Adtel Comm.*, WIPO D2000-0115 (offer on “eBay”); *NFL Properties, Inc. v. One Sex Entertainment Co.*, WIPO D2000-0118 (offer for sale on public site). But see *Educational Testing Service*, *supra* note 4 (offer to sell domain name on a public website is not evidence of bad faith especially where there are parties other than complainant that could make legitimate use of domain name).

inquiring if the domain name might be of interest to the complainant.⁷³ Indeed, an offer to sell a domain name can even be inferred from the fact that the respondent's website has a counter on it showing the number of hits or visitors to the site.⁷⁴ Oftentimes, the offer to sell a name is embedded in the registration itself. Some domain name registrants, in lieu of providing a name or address for the registrant, will instead use the registration form to announce that the domain name is for sale. Some examples include listing the registrant as "domains for sale" or providing an email address of domain@rentname.com.⁷⁵

Although an offer to sell a name is often a harbinger of bad faith, there have been situations where the sale of domain names has been recognized as a legitimate business. In *Allocation Network GmbH v Steve Gregory*,⁷⁶ the panelist acknowledged that registration of descriptive or generic terms as domain names for purposes of offering them for resale could constitute a legitimate use of the names.⁷⁷ The panelist in *J. Crew International v Crew.com*, disagreed, stating that "[s]peculation is not recognized by the Policy as a legitimate interest in a name ..." and that registering domain names for resale is not permissible.⁷⁸

Other evidence of bad faith use of a domain name includes using the domain name to link to pornographic sites⁷⁹ or to sites of the complainant's competitors;⁸⁰ using the domain name to identify a website that attacks the complainant;⁸¹ using the name as a means to route users to another site of the registrant;⁸² engaging in a pattern of registering domain names that allows for an inference that registrant's business is to acquire and sell domain names for a profit;⁸³ using a domain name beyond the terms of a license agreement;⁸⁴ or placing an "under construction" sign at the website.⁸⁵

Even when the registrant has done nothing but register the name, bad faith still has been found because the domain name registrant could not use the name without violating the complainant's rights under applicable law;⁸⁶ the complainant's mark is distinctive and thus it is unlikely that the registrant would have selected the domain name without knowing of this reputation;⁸⁷ the use or even the existence of the name will lead to consumer confusion;⁸⁸ the

⁷³ *The Stanley Works v. Brett Borden*, NAF FA94204 (2000) (implicit offer to sell is bad faith); *Compaq*, supra note 52 (asking Compaq if it wanted to buy names shows bad faith). But see *ISL Marketing AG v. J.Y. Chung*, WIPO D2000-0034 (email asking if domain names would be useful and advising of a willingness to sell is not bad faith).

⁷⁴ Chernow, supra note 39.

⁷⁵ *Microsoft Corp. v. Amit Mehrotra*, WIPO D2000-0053; *Arla v. PDS*, WIPO D2000-0151.

⁷⁶ Supra note 35.

⁷⁷ *Accord, General Machine Products Co. v. Prime Domains*, NAF FA92531 (2000).

⁷⁸ WIPO D2000-0054.

⁷⁹ *CCA Industries, Inc. v Bobby R. Dailey*, WIPO D2000-0148 (association with pornographic site constitutes bad faith); *World Wrestling Federation Entertainment, Inc. v Matthew Bessette*, WIPO D2000-0256.

⁸⁰ *Zwack Unicom Rt v. Erica J. Duna*, WIPO D2000-0037.

⁸¹ *CSA*, supra note 28.

⁸² *Eddie Bauer*, supra note 40.

⁸³ *J.P. Morgan v. Resource Marketing*, WIPO D2000-0035 (ownership of numerous domain names that are the names or marks of well-known businesses suggests an intent to profit from the activities of others).

⁸⁴ *Heel Quik!, Inc. v. QRS Corp.*, NAF FA92527(2000).

⁸⁵ Chernow, supra note 39.

⁸⁶ See *Telstra*, supra note 51; *Cellular One Group v. Paul Brien*, WIPO D2000-0028.

⁸⁷ *Stralfors AB v. PDS AB*, WIPO D2000-0112.

registrant deliberately hyphenated complainant's mark;⁸⁹ or the registrant failed to respond either to demand letters or the UDRP complaint.⁹⁰ Indeed, cases hold that passive holding or "parking" of a domain name that is confusingly similar to complainant's mark, without more, constitutes bad faith use because domain name use will enable registrant to attract users to its website by trading on the recognition of the complaining party's mark.⁹¹

Distilled to their essence, the cases suggest that a domain name that essentially copies or trades on another's mark will be ordered transferred to the complaining party unless the registrant can provide a credible reason for having adopted the name. As noted by one panel, bad faith will be found where a domain name is so obviously connected with complainant or its product that its use by anyone other than complainant suggests "opportunistic bad faith."⁹²

While the evidence necessary to prove bad faith use and registration generally is identical, the timing of the bad faith use and registration is not. Some panelists have indicated that as long as the domain name is used in bad faith at any point in time, this element of the policy is satisfied.⁹³ However, in terms of registration, the bad faith must be present at the time the registration was obtained.⁹⁴ For this reason, it is important when preparing a complaint to obtain as much information as possible about the registrant, including whether or not it has obtained other domain names. If the registrant has a pattern of registering multiple domain names, it could be inferred that at the time it registered the domain name at issue, such registration was made in bad faith.

D. Drawbacks of UDRP Proceedings

It must be remembered that a UDRP proceeding is limited to the domain name, not the website content. Where an objectionable site is at issue, a UDRP proceeding could result in the website owner simply moving the objectionable content to another domain address. The content of the site, links in the site, metatags and the like will not be affected. Moreover, even with the benefits of the streamlined UDRP proceeding, there are some drawbacks. One particular drawback is in the area of fact finding and credibility determinations. The panel in a UDRP proceeding adjudicates on a cold record. There is no chance to see witnesses or to determine whether, in fact, the allegations made are true. While panelists have noted that the existence of

⁸⁸ Forte (UK) Limited v. Eugenio Ceschel, WIPO D2000-0283.

⁸⁹ The Channel Tunnel Group, supra note 39; Chernow, supra note 39.

⁹⁰ NFL Properties, Inc. v. BBC Ab, WIPO D2000-0147.

⁹¹ InfoSpace.com, Inc. v. Tenebaum Ofer, WIPO D2000-0075; Sanrio Co., Ltd. v. Neric Lau, WIPO D2000-0172; Embratel v. Kevin McCarthy, WIPO D2000-0164 (passive holding of domain name with knowledge of damage it could cause the trademark owner constitutes bad faith use). See also UDRP ¶4(b)(iv).

⁹² Veuve Cliquot Ponsardin v. The Polygenix Group Co., WIPO D2000-0163.

⁹³ See Ingersoll-Rand Co. v. Frank Gully, WIPO D2000-0021 (although the UDRP uses the present tense when referring to use, panel finds that the requirement that the mark is being used in bad faith does not refer to a particular point of time. If at any time following the registration the name is used in bad faith this element is established. This is the case even if the event constituting bad faith has subsequently ceased).

⁹⁴ See Telaxis Communications Corp. v. William E. Minkle, WIPO D2000-0005 (where the original registration was in good faith and respondent later acted in bad faith, complainant was found not to have met its burden); The Wiggles Touring Pty Ltd. v. Thompson Media Pty Ltd., WIPO D2000-0124 (intention to sell a name after the date of registration does not lead to a conclusion that the bad faith intention existed at the time of the registration).

significant factual issues would make a case inappropriate for resolution under the policy,⁹⁵ nevertheless, panelists have not shied away from making factual determinations or from assessing credibility. Thus, for example, where a domain name registrant obtained the name Saint gobain.net claiming that its current intention was to commemorate the role of the Saint Gobain forest in a resistance movement, the administrative panel determined that this was not respondent's "real" goal, which was to prevent the complainant from using its trademark in a domain name.⁹⁶ In another case, respondent offered as evidence of his legitimate right to use the domain name migard.com that Migard was the name of his mixed breed dog. This was supported by nothing more than an allegation by the respondent. The panelist noted that the complainant had no ability to disprove the statement, given the lack of discovery. However, based merely on the allegations made by the respondent, the panelist credited the statement and found against the complaining party.⁹⁷

One of the more disturbing "fact finding" examples occurred in *Entercolor Technologies Corp. v Gigantor Software Development, Inc.*⁹⁸ There, the complainant was the originator of Gigantor, the robot featured in animated programs. The complaining party held United States trademark registrations for GIGANTOR and the Gigantor television series itself was protected by federal copyright. The registrant described itself as a software consulting business that registered the name gigantor.com in 1995, although it never constructed a website. Moreover, the registrant did not incorporate under the name gigantor.com until after receiving three demand letters and provided no evidence of any legitimate business under the name gigantor.com. While the panel noted the uniqueness of GIGANTOR and further indicated that the domain name registrant's claim that it had never heard of the mark seemed improbable, the panel nevertheless found in favor of the domain name registrant merely based on the domain name registrant's assertion that it was in business under the name Gigantor. The panel took the position that there should be no transfer, in part, because the registrant's business was not similar to that of the complaining party, even though this is not one of the criteria under the UDRP

The pitfalls of this type of fact-finding on an incomplete record perhaps are best shown by a comparison of two cases brought by the same complainant. NetGrocer had been using the mark NETGROCER since 1997 and owned the domain name netgrocer.com, which was registered in 1995. NetGrocer also was the owner of a United States service mark registered on January 12, 1999 based on a filing date of December 22, 1995. In *NetGrocer, Inc. v Harry Tahilian*,⁹⁹ complainant brought an action against the registrant of netgrocer.net, which was registered on March 27, 1998. The panel found that the registrant knew or should have known of complainant when it registered the name and therefore found for complainant. Two weeks later, in *NetGrocer, Inc. v Anchor*, a different panelist reached a different conclusion concerning the domain name netgrocer.org registered on December 31, 1999, finding that there was insufficient evidence of bad faith or of an attempt to create confusion.¹⁰⁰

⁹⁵ Adaptive Molecular Technologies, supra note 20.

⁹⁶ *Compagnie de Saint Gobain v.COM-UNION Corp.*, WIPO D2000-0020.

⁹⁷ *Vanguard*, supra note 43. See also *Penguin Books Ltd. v. The Katz Family*, WIPO D2000-0204 (respondent's allegation that Mr. Katz had been known by the nickname "Penguin" credited in light of lack of rebuttal evidence).

⁹⁸ NAF FA93635 (2000).

⁹⁹ NAF FA93768 (2000).

¹⁰⁰ NAF FA94207 (2000).

Similarly, in the case of *Quirk Nissan, Ina v. Michael J. Maccine*,¹⁰¹ the panel found that *quirknissan.com* was registered in bad faith and violated the complainant's rights. The respondent had argued that the domain name was registered for the noncommercial purpose of providing information over the Internet about complainant. The panel found that the respondent had no rights or legitimate interests with respect to the domain name and that it was registered and being used in bad faith. In *Daniel J. Quirk, Inc. v. Michael J. Maccine*,¹⁰² a different panelist was asked to determine whether the domain names *quirkoldsmobile.com*, *quirkkia.com*, *quirkautos.corn* and *quirkmotors.com* violated the policy. The facts surrounding the use and registration of these names were identical to those in the Quirk Nissan case. In the second case, the panelist found that the respondent was not using the domain names for commercial purposes but rather to detail his experiences at a Quirk dealership. Because the use being made of the domain names was constitutionally protected, the panelist determined that the domain names did not have to be transferred. The panelist noted that his decision was contrary to the Quirk Nissan decision but made no attempt to justify the difference.

E. *Open Issues for UDRP Proceedings*

While the UDRP appears to have the potential for resolving disputes relatively inexpensively and quickly, the procedure raises a number of yet unanswered questions, including:

1. What law applies in a UDRP proceeding where the complainant and registrant are not from the same country?
2. Because the domain name dispute rules do not require that a dispute resolution proceeding be stayed or suspended if a separate legal proceeding is initiated, would a court have the power to issue an order staying the UDRP proceeding?¹⁰³
3. If a domain name registrant avails itself of the right to file a court proceeding in order to delay the implementation of an adverse decision under the UDRP, and if the registrant files a case in an agreed court of mutual jurisdiction, defined as being a court located in the jurisdiction of the principal office of the registrar or in the jurisdiction where the domain name holder is located, what law should be applied? This is of particular concern since often the parties are from different countries.
4. How is a conflict to be decided between a decision in a UDRP and a court in the event the two tribunals reach different determinations about the domain registration?
5. What effect will there be, if any, if two separate complainants file domain name disputes against the same registrant, and choose separate providers? Note that

¹⁰¹ NAF FA94959 (2000).

¹⁰² NAF FA94964 (2000).

¹⁰³ Note that in *Weber-Stephen Products Co. v. Armitage Hardware and Building Supply, Inc.*, 54 USPQ2d 1766 (ND Ill 2000), the court stayed suit in favor of the UDRP although noting that it was not bound by the panel's decision.

from a substantive point of view, this could suggest that neither complainant possesses a sufficiently distinctive mark to merit protection. In addition, it also would provide an argument that the registrant was not specifically targeting any one trademark owner.

6. If a complainant files a UDRP with one provider and loses can it re-file with another provider and, if so, would the doctrines of res judicata or collateral estoppel apply?

III. THE ANTICYBERSQUATTING CONSUMER PROTECTION ACT

Before the ACPA was enacted in November, 1999, United States courts struggled to address cyberpiracy using traditional trademark infringement, unfair competition, and dilution notions. The struggle was due to the fact that the cyberpirate usually was not making trademark use of the domain name. Indeed, cases had held that mere registration of a domain name did not amount to commercial use or subject the registrant to liability under the Lanham Act.¹⁰⁴ To avoid this result, the Ninth Circuit in *Panavision v. Toeppen*, found commercial use of a domain name when the domain name registrant had attempted to sell the name. That the registrant never actually used the domain name in connection with any product or service was irrelevant.¹⁰⁵

The analysis seemed a bit of a stretch, but nevertheless was followed in several subsequent decisions. For example, the court in the Eastern District of Virginia in *Virtual Works, Inc. v. Network Solutions, Inc.*,¹⁰⁶ stated that “internet cyberpiracy constitutes per se trademark dilution” and advocated a rule whereby a domain name must be transferred when it incorporates a mark that on its face obviously belongs to another.

Yet dilution and other unfair competition laws really were not designed to accommodate cyberpiracy; the Anticybersquatting Consumer Protection Act is. The Senate Report states that the purpose of the law is “to protect consumers and American businesses, to promote the growth of online commerce, and to provide clarity in the law for trademark owners by prohibiting the bad-faith and abusive registration of distinctive marks as Internet domain names with the intent to profit from the goodwill associated with such marks - a practice commonly referred to as ‘cybersquatting.’”¹⁰⁷ In this regard, the ACPA has the same general function and purpose as the UDRP. The text of the ACPA, as it is now incorporated into the Lanham Act, is appended at the end of the article as Annex A.

A. *Overview of ACPA Actions*

¹⁰⁴ *Panavision International, LLP v. Zbeppen*, 141 F3d 1316, 1324, 46 USPQ2d 1511, 1518-19 (CA 9 1998) and cases cited therein.

¹⁰⁵ *Ibid.* Other courts have similarly expanded the notion of use to encompass the taking of a domain name that copies another’s mark. Thus, in *People For The Ethical Treatment of Animals*, supra note 57, the court stated that use of a domain name that could prevent Internet users from reaching plaintiff’s own website or who may not continue to search for plaintiff as a result of defendant’s domain name is sufficient to constitute use in connection with goods and services.

¹⁰⁶ 54 USPQ2d 1126, 1128 (ED Va 2000),

¹⁰⁷ S Rep No 106-140 at 4 (1999).

The ACPA applies to all domain names regardless of when they were registered and is designed to stop the bad faith registration, trafficking and/or use of a domain name. However, relief beyond the transfer or cancellation of the name is available only if the registration, trafficking or use of the domain name occurred after November 29, 1999.¹⁰⁸ Under the ACPA, plaintiff must show that: (a) it is the owner of a mark; (b) defendant registered, trafficked in or used a domain name that is identical or confusingly similar to a mark that was distinctive at the time the domain name was registered, or, in the case of a mark that is famous at the time the domain was registered, is identical, confusingly similar to, or dilutive of that mark; and (c) the domain name registrant has a bad faith intent to profit from plaintiff's mark.¹⁰⁹

In a case brought under the ACPA, a court need not determine if plaintiff's trademark meets the rigorous standards of fame required under United States dilution law.¹¹⁰ If a mark is distinctive, a presumption that flows from the mere fact of United States registration, this is sufficient. A court also need not consider whether there is a likelihood of dilution or confusion caused by the defendant's use of the domain name. Instead, the court focuses merely on whether the defendant had a bad faith intent to profit from registering the domain name.¹¹¹

The similarities between the UDRP and the ACPA are striking. Like the UDRP procedure, there is no requirement under the ACPA that the complaining party's mark be registered so long as the mark is distinctive,¹¹² and there likewise is no requirement under the ACPA that the domain name be identical to the complaining party's mark. As in UDRP proceedings, similarity of the mark and domain name under the ACPA is considered in a side-by-side comparison without regard to commercial context.¹¹³ Finally, both the ACPA and the UDRP require that the domain name registrant exhibit bad faith, and both proceedings use similar factors to establish bad faith.

The ACPA lists nine factors to consider in determining whether the domain name registrant registered, trafficked or used the domain name in bad faith.¹¹⁴ As can be seen from Annex B, each of these factors is considered under the UDRP in determining whether the registrant has legitimate rights in the domain name or registered and used the name in bad faith.¹¹⁵

The essential similarity of the UDRP and the ACPA is further shown in Annex C, which shows that each of the bad faith factors listed in the ACPA has been used in a UDRP proceeding

¹⁰⁸ Porsche Cars North America, Inc v. Spencer, 55 USPQ2d 1026 (ED Calif 2000).

¹⁰⁹ 15 USC §1126(d).

¹¹⁰ See 15 USC §1125(c) and the Federal Trademark Dilution Act of 1995, Pub L No 104-98 (1996).

¹¹¹ 15 USC §1125(d)(1)(A).

¹¹² Compare Cello Holdings, L.L.C. v. Lawrence-Dahl Cos., 89 F Supp2d 464, 54 USPQ2d 1645 (SDNY 2000) (summary judgment denied where reasonable fact finder could find that "cello" is not a distinctive mark) with cases cited in supra note 29.

¹¹³ Compare Northern Light, supra note 31, with cases cited in supra note 36. See also InfoSpacemcom, Inc. v. Delighters, Inc., WIPO D2000-0068 (noting that under ACPA and UDRP, the element of similarity is determined by comparing the mark and name alone, independent of other factors).

¹¹⁴ 16 USC §1125(d)(1)(B). According to Mattel, Inc. v. Internet Dimensions, 55 USPQ2d 1260 (SDNY 2000), these factors are not exclusive.

¹¹⁵ UDRP ¶¶4(b), (c).

to prove that a domain name registrant used and registered the domain name in bad faith.¹¹⁶ At least one panel has recognized these similarities. In *Strombecker Corporation v Just Service Ina*, the panel determined that the registration of the domain name *strombecker.com* violated the UDRP.¹¹⁷ The domain name registrant made no use of the domain name and never offered to sell it. He stated that he intended to establish a website to promote interest in model cars. Based on this evidence, the panel found bad faith use and registration since the registration of the domain name prevented the owner of the mark from registering its mark as a domain name. In addition, the registrant would attract Internet users to its site (assuming it had one). The panel concluded that not only did the facts establish a violation of the UDRP, but also that the facts showed a violation of the ACPA. However, a different panel held that a bad faith finding under the ACPA was not binding upon its determination of bad faith use and registration, although it was entitled to “substantial” weight.¹¹⁸ In *Weber-Stephen Products Co. v. Armitage Hardware and Building Supply, Inc.*,¹¹⁹ after reviewing the UDRP procedures, the United States District Court for the Northern District of Illinois held that a court is not bound by the UDRP case outcome and further noted that whether or to what degree a court should give deference to a UDRP decision has not yet been determined. Nevertheless, the court did stay its own case pending the outcome of the UDRP proceeding.

B. *ACPA Scorecard*

As of July 31, 2000, only a handful of cases had been decided under the ACPA. All of the decisions are consistent with the law developed under the UDRP. Indeed, a UDRP proceeding likely would have led to the same result reached by the courts. For example, a preliminary injunction was entered in favor of a plaintiff where defendant had no bona fide business under the domain name, was not known by the domain name, was offering no goods or services under the domain name and registered the domain name to divert traffic to his own website.¹²⁰ A violation of the Act was also found where the domain name registrant had registered numerous domain names that used third parties’ marks and attempted to sell some or all of these names.¹²¹

In one of the most recent cases, the district court granted summary judgment for the plaintiff where the domain name registrant took plaintiff’s recognized mark as a domain name but was using that domain name for a parody website that was obviously not owned, controlled or

¹¹⁶ The UDRP envisions that there may be situations where a complainant needs relief beyond the transfer or cancellation of a domain name. For that reason, the UDRP allows for the contemporaneous filing of a lawsuit. UDRP ¶4(k). However, in most cases there would not be a need for both a UDRP and a suit solely under the ACPA since the elements of a case under the ACPA are essentially identical to those under the UDRP.

¹¹⁷ NAF FA94450 (2000). STROMBECKER is a registered trademark used in connection with toys, including toy model cars.

¹¹⁸ Encyclopedia Britannica, *supra* note 40.

¹¹⁹ *Supra* note 103.

¹²⁰ See *Shields v. Zuccarini*, 89 F Supp2d 634, 54 USPQ2d 1166 (ED Pa 2000); see also *Spear, Leeds & Kellogg v. Rosado*, 2000 US Dist LEXIS 3732 (SDNY March 27, 2000) (permanent injunction granted where domain name registrant had no intellectual property rights in the mark taken and failed to make bona fide use of the mark prior to plaintiff); accord, *Morrison & Forester L.L.P. v. Brian Wick*, 94 F Supp2d 1125 (D Colo 2000) (judgment granted to plaintiff where defendant had no intellectual property right in names taken, the names did not constitute defendant’s trade name or any name he went by and there was no evidence of prior use of the names for bona fide offering of goods or services).

¹²¹ See *Northern Light*, *supra* note 31; accord *Porsche Cars*, *supra* note 108.

sponsored by the plaintiff.¹²² The court held that even if consumers can determine upon reaching the website that the plaintiff and defendant have no connection, this is not a defense to a cybersquatting claim under the ACPA noting that because of the nature of the Internet a domain name is an external label that on its face can cause confusion among Internet users.¹²³ UDRP cases also have rejected the disclaimer defense for the same reason.¹²⁴

In those cases where the plaintiff did not prevail in its ACPA claim, the reasons are-almost identical to the reasons why a complainant also would not prevail in a UDRP proceeding. For example, in *Cello Holdings, L.L.C. v Lawrence-Dahl Companies*, summary judgment was denied on the ground that a question of fact existed as to whether plaintiffs mark CELLO was distinctive, and whether plaintiff could prove that defendant had an intent to target plaintiff by registering the domain name cello.com.¹²⁵

C. *Advantages of the ACPA: Are They Real?*

The ACPA, at least on paper, provides both substantive and remedial advantages over a UDRP proceeding. However, many of these advantages may be illusory. In addition, many of the advantages of an ACPA proceeding would be available to plaintiffs who file a lawsuit under other Lanham Act claims.¹²⁶

Substantively, the ACPA specifically provides relief in cases where a registrant takes a domain name that consists of a personal name and the personal name does not function as a trademark or service mark.¹²⁷ It is unclear if the UDRP will extend this far. The UDRP itself requires that the domain name be confusingly similar to a “trademark or service mark in which the complainant has rights.”¹²⁸ This wording does not lend itself to apply to personal names that do not function as trademarks or service marks. To date, UDRP proceedings have only gone so far as to protect unregistered personal names that have acquired secondary meaning. Thus, for example, in *Julia Fiona Roberts v Russell Boyd*,¹²⁹ the actress Julia Roberts was able to obtain

¹²² See *People For the Ethical Treatment of Animals*, supra note 57. The case is now on appeal.

¹²³ See also *Ford Motor Company v. Ford Financial Solutions, Inc.*, 55 USPQ2d 1217 (ND Iowa 2000). As with UDRP proceedings, fair use arguments may be accorded more weight if the domain name includes a descriptive term in it that makes it clear the site is not associated with the mark holder. See *Bally Total Fitness Holding Corp. v. Faber*, 29 F Supp2d 1161, 50 USPQ2d 1840 (CD Calif 1998); *Lucent Technologies, Inc. v. LucentSucks.com*, 95 F Supp2d 528, 54 USPQ2d 1653 (ED Va 2000).

¹²⁴ See *IATA v. Traverse Zoo*, WIPO D2000-0192.

¹²⁵ Supra note 112.

¹²⁶ For example, in *Mattel*, supra note 114, the court found that the registration of the domain name *barbiesplaypen.com* used for an adult entertainment site violated the ACPA. It is clear from prior case law that Mattel also would have been able to enjoin the use of the *barbiesplaypen.com* domain name under the dilution laws which had been used prior to the enactment of the ACPA to stop the use of trademarks as domain names when those domain names are used in connection with adult sites. See, eg, *Archdiocese of St. Louis v. Internet Entertainment Group, Inc.*, 34 F Supp2d 1145 (ED Mo 1999). See also cases cited in supra note 79.

¹²⁷ As codified at 15 USC §1129, any person who registers a domain name that consists of the name of another living person, or a name substantially and confusingly similar thereto, without that person’s consent, and with the intent to profit from the name by selling it, is liable in a civil action. The provision does not apply to deceased individuals or their heirs. However, there may be other kinds of relief that would be available in such circumstances, including claims for violation of right of publicity statutes.

¹²⁸ UDRP ¶4(a)(i).

¹²⁹ WIPO D2000-0210.

the transfer of the domain name juliaroberts.com The respondent argued that Ms. Roberts did not have trademark rights in her name. The panel, however, found that common law trademark rights existed under United States law based on the existence of secondary meaning. A similar result, applying English law, was reached in *Jeanette Winterson v. Mark Hogarth*.¹³⁰ There, the complainant was an author who asserted common law trademark rights in her personal name based on the recognition that had been developed in the name. The panel noted that in determining whether such rights exist it is irrelevant if the name could be registered as a mark or was registered as a mark.¹³¹

Being famous does not mean that you are guaranteed to win under the UDRP or obtain an immediate transfer of the domain name. While Julia Roberts prevailed in her UDRP proceeding, after the panel reached its decision the registrant filed suit, thereby preventing the transfer from going forward. However, Julia Roberts fared far better in her proceeding under the UDRP than did the performer Sting, who brought a UDRP proceeding against a Georgia native who had registered the domain name sting.com in 1995.¹³² Sting claimed that the respondent offered to sell the sting.com domain name to him for \$25,000. The registrant admitted this but said the offer was made only in response to a solicitation by complainant. While the panel noted that cases have treated the name of a famous or widely-known person as an unregistered mark sufficient to satisfy the requirements of the UDRP, it questioned whether such findings were appropriate. The panel quoted from the Report of the WIPO Internet Domain Name Process which stated that the UDRP should not cover domain name registrations that violate personality rights. Although the panel recognized that Gordon Sumner is a world famous entertainer known by the name “Sting,” it would not conclude that he had rights in STING as a trademark or service mark, since Sting, while acting as a personal name, also is a common word in the English language with different meanings many of which have no relationship to the performer.¹³³ Under the ACPA, this issue likely would not have arisen.

Another substantive advantage of a claim brought under the ACPA over a UDRP proceeding is that by its terms the ACPA is not limited to generic top-level domain names. Rather, the statute refers generally to domain names and thus should be interpreted to cover any, including those ending in country codes. While theoretically the ACPA provides such coverage, in practice it may be difficult to apply.

Many registrants of country code top-level domain names do not reside or conduct business in the United States. Thus, it may be virtually impossible to get personal jurisdiction

¹³⁰ WIPO D2000-0235.

¹³¹ Similar protection has recently been extended to an apparently well-known equestrian, see *Monty*, supra note 68, and to an investment banker. *Steven Rattner v. BuyThisDomainName*, WIPO D2000-0402.

¹³² *Gordon Sumner, P/K/A Sting v. Michael Urvan*, WIPO D2000-0696.

¹³³ While the panel stated that it was inclined to hold that Sting was not a trademark or service mark within the scope of the policy, its actual decision was based on the complainant’s failure to prove that the domain name was registered and used in bad faith, including the failure to provide evidence to support its assertion that the respondent offered to sell the domain name. This case is difficult to square with *World Wrestling Federation v. Bessette*, supra note 79, where registrant took *www.stonecold.com* as a domain name. STONE COLD is the name of one of complainant’s wrestling characters. However, complainant did not have a registration for the name. The panel did not address whether the UDRP would apply to character names that were not the subject of a registered trademark. Nor did the panel consider whether STONE COLD could have a meaning other than in relation to complainant’s characters.

over them. The in rem provision of the ACPA provides little help, since that provision requires that in rem actions be brought in the judicial district where the domain name registrar is located.¹³⁴ Since most, if not all, of the registrars for country code top-level domain names are not in the United States, an in rem proceeding would be impossible. Thus, this advantage of the ACPA would only apply in cases where the registrant of the country code top-level domain name is a United States citizen or is otherwise amenable to the personal jurisdiction of a United States federal court.

It may turn out that the most significant substantive advantage of a proceeding under the ACPA is its clear language that mere registration of a domain name, without any use, is actionable if that registration is in bad faith.¹³⁵ The UDRP by its terms requires both bad faith use and bad faith registration.¹³⁶ While the majority of UDRP decisions hold that use can be equivalent to non-use, the wording of the policy is subject to interpretation and panels can reject the UDRP complaint where no use of the domain name can be demonstrated.¹³⁷

The ACPA also provides a greater array of remedies than does a proceeding under the UDRP. Aside from the transfer or cancellation of the domain name, a prevailing plaintiff in an ACPA action is also entitled to broad injunctive relief that would bar defendant from the commercial use and infringement of any of the plaintiff's trademarks.¹³⁸ In addition, if the defendant used, registered or trafficked in a domain name in bad faith and the action occurred after November 29, 1999, a prevailing plaintiff may also be entitled to an award of defendant's profits, plaintiff's damages, and attorney's fees if the case is exceptional.¹³⁹

Because of the difficulty of proving profits and damages, the ACPA provides that the plaintiff can elect to recover statutory damages of \$1,000 to \$100,000 per domain name as the court considers just.¹⁴⁰ This provision may have more of an in terrorem affect than an actual fiscal benefit since it is uncertain whether a domain name registrant will have sufficient assets to allow the plaintiff to collect on a judgment. Nevertheless, statutory damages have been awarded in ACPA actions.¹⁴¹

The Lanham Act was amended to make clear that a prevailing plaintiff in an exceptional case may be awarded attorney's fees under the ACPA at the discretion of the court. Attorney's fees have always been available in exceptional cases for claims of trademark infringement and unfair competition.¹⁴² The difficulty in getting attorney's fees in most cases of trademark infringement and unfair competition is the inability of a plaintiff to show that the case is exceptional or that the defendant acted in bad faith. However, in order for a plaintiff to prevail

¹³⁴ 15 USC §1125(d)(2)(A).

¹³⁵ 15 USC §1125(d)(1)(A)(ii).

¹³⁶ UDRP ¶4(a)(iii).

¹³⁷ See *Sporoptic*, supra note 68.

¹³⁸ 15 USC §1116.

¹³⁹ 15 USC §1117. One court has indicated that where a defendant used the domain name prior to the enactment of the ACPA and continued to use it after the enactment of the ACPA, such use would trigger the availability of the damage provision of the ACPA. See *Mattel*, supra note 114.

¹⁴⁰ 15 USC §1117.

¹⁴¹ See *United Greeks, Inc. v. Jeffrey Klein*, 2000 US Dist LEXIS 5670 (SDNY May 2, 2000).

¹⁴² See 15 USC §1117.

under the ACPA, the court must find that the defendant registered, trafficked in or used a domain name in bad faith. Thus, a question that is sure to be litigated is whether a judgment under the ACPA automatically qualifies a case as being exceptional such that attorney's fees should be awarded.¹⁴³ The Second Circuit, in *Sporty's Farm LLC v Sportsman's Market, Ina*, has signaled that cybersquatting cases may not all be "exceptional" stating that the bad faith requirement of the ACPA is a term of art and is not necessarily the same as bad faith used in other contexts.¹⁴⁴

IV. UDRP v. ACPA: HOW DOES A COMPANY CHOOSE?

In cases of true cybersquatting, where a third party has taken a domain name consisting of a company's trademark, service mark or trade name and has clearly done so in bad faith, the UDRP has proven to be a fast and effective remedy that has many advantages over a lawsuit.

First, the UDRP does not require the complainant to actually locate the domain name registrant in order to commence the action. This is generally required for a lawsuit to proceed. If the domain name registrant provides incomplete or false contact information in its domain registration form, it is at the domain name registrant's peril.

A second advantage of the UDRP is one of cost. While the initial filing fee for UDRP proceedings exceeds the filing fee for a United States court action,¹⁴⁵ in the final analysis, a lawsuit under the ACPA will be more expensive. The initial pleading submitted by a complainant in support of a lawsuit or in support of a UDRP proceeding is similar. Once a complaint is filed with the UDRP provider, however, there are generally few additional costs for the complainant. This is true even if the domain name registrant defaults. By contrast, in a lawsuit significant costs can be incurred in locating and serving the domain name registrant, conducting discovery and motion practice, attending court hearings, and preparing additional filings.¹⁴⁶ Even where the domain name registrant never responds, the complaining party will likely have to make a motion for a default judgment, prepare a judgment, perhaps appear before the court to get the default judgment entered, and then forward a certified copy of the judgment to the domain name registrar so it can be implemented. Yet another cost factor that favors a UDRP proceeding is that the UDRP does not require that the complaining party be represented by a lawyer or by outside counsel. Thus, a company can develop its own procedures for bringing a UDRP action and can do so in-house.

¹⁴³ Unlike 15 USC §1117, which allows the recovery of attorney's fees for a violation of the ACPA only in exceptional cases, that portion of the ACPA dealing with personal names, 15 USC §1129, allows for the award of attorney's In to the prevailing party at the court's discretion. No explicit finding that the case is exceptional is required. This could be due to the fact that liability under this section is predicated upon a finding of bad faith intent to profit.

¹⁴⁴ 202 F3d 489, 499 fn 134, 53 USPQ2d 1570, 1577 (CA 2 2000).

¹⁴⁵ The filing fee in most district courts is \$150 while the fee for a UDRP proceeding ranges between \$1000 and \$1500, depending on the provider.

¹⁴⁶ The ACPA does have an in rem provision, so that if the complainant cannot get personal jurisdiction over the registrant or the domain name registrant cannot be found, action can be taken against the domain names themselves. See 15 USC §1125(d)(2)(c). The constitutionality of this provision was upheld in *Caesars World, Inc. v. Caesars-Palace.com*, 54 USPQ2d 1121 (ED Va 2000). However, proceeding in rem can be expensive since it requires moving papers to obtain this relief, and, in those situations where the complainant claims the registrant cannot be found, requires that the court's order be published in a recognized newspaper. Publication of an order itself can cost in excess of \$1,000.

A third advantage of a UDRP is that unlike in a civil lawsuit, including one brought under the ACPA, the complainant is not subject to discovery.

Speed is a fourth advantage of the UDRP proceedings. In general, decisions are issued within six to eight weeks after the complaint is instituted. By contrast, it could take months for a final decision to be issued in a lawsuit, even a lawsuit where the domain name registrant defaults.

Given the above, there is little reason for bringing a claim under the ACPA if it can be disposed of through a UDRP proceeding. However, where the domain name registrant does more than register a domain name, issues may arise concerning the nature of the website, the use of metatags, framing, and deep linking.¹⁴⁷ In those circumstances, the general concepts of trademark infringement, unfair competition and copyright infringement should be applied, with the ACPA being asserted as an additional claim.¹⁴⁸

V. “THE DOG MADE ME DO IT” AND OTHER DEFENSES

If nothing else, the UDRP and ACPA have led to some amusing excuses by domain name registrants and defendants to justify their acts of cyberpiracy. For example, in *Sporty’s Farm, LLC v. Sportsman’s Market, Inc.*,¹⁴⁹ a case arising under the ACPA, the domain name registrant attempted to justify taking a domain name the trademark of a known competitor by claiming that the CEO of the defendant as a boy owned a dog named Spotty. When that dog ran away, he went to an upstate farm which he came to call Spotty’s Farm. The name Sporty’s Farm, and hence the domain name sporty.com, was an alleged subsequent derivation from the name of Spotty, the dog. As the court noted, such an explanation “is more amusing than credible.”¹⁵⁰

Another shaggy dog story was raised by the registrant of the domain names finter.com and finter.org over the objection of Finter Bank in a UDRP proceeding. The domain name registrant claimed that he registered the name to honor his dog, Ruby del Finter. The fact that the domain name registrant offered to sell the domain name to complainant ten business days after the domain name was registered led the panel to discredit the excuse.¹⁵¹ An award for ingenuity could go to the domain name registrant who took the name walmartcanada.com claiming it had a right to this name because the domain name registrant sought to sell wall products, lighting and fixtures over the Internet in Thailand.¹⁵² However, that excuse almost pales in comparison to the one provided by the domain name registrant who took the names of most teams in the National Football League as domain names. His excuse, rejected by the panel, was that the names were registered for the non-commercial education of the domain name registrant’s children about the Internet. Although the presiding panelist rejected this argument, he did go out of his way to

¹⁴⁷ In *VeriSign*, supra note 47, the panel noted that respondent’s use of its domain name on its website could violate complainant’s rights and may constitute unfair competition.

¹⁴⁸ Although the UDRP recognizes that a complaining party has the right to proceed in court as well as under the UDRP, the UDRP panel is likely to suspend the administrative proceeding if court proceedings on the same matter have begun. See Rules of UDRP ¶118; *BroadBridge Media, LLC v. Hyper CD.com*, 106 F Supp2d 506, 56 USPQ2d 1426 (SDNY 2000) (in case where UDRP and lawsuit were brought concerning the same domain name, the UDRP panel suspended the administrative proceeding pending the outcome of the litigation).

¹⁴⁹ Supra note 144.

¹⁵⁰ Id at 499, 53 USPQ2d at 1577.

¹⁵¹ See *Finter*, supra note 30.

¹⁵² *Wal-Mart Stores, Inc. v. Walmarket Canada*, supra note 38.

encourage the domain name registrant to choose another domain name which would allow the registrant's children to learn about and participate in the Internet.¹⁵³

Other memorable excuses include: (a) the registrant did not act in bad faith because he successfully sold other domain name to third parties;¹⁵⁴ (b) even though registrant knew of the complainant's trademark and registered a domain name consisting of that mark, he should not be held accountable because the domain name was "catchy;"¹⁵⁵ (c) registrant took the domain name babydior.com in good faith to honor Barney the dinosaur, which is a favorite children's character;¹⁵⁶ (d) registrant took the name grasstelefactor.com in honor of his son Gilbarco;¹⁵⁷ and (e) the domain name should not be transferred or canceled because it was a symbol of freedom and dignity.¹⁵⁸

VI. SUMMARY

Perhaps a confession is appropriate at this point. After initially reviewing the UDRP and comparing it to the ACPA, a lawsuit seemed more desirable. Now, experience with proceedings under both the UDRP and the ACPA has shown that the UDRP provides a fast, effective and cost-efficient way to resolve cyberpirating cases. Granted, the UDRP is not appropriate for every case. When one is dealing with an individual or entity who has a pattern and practice of registering domain names that copy marks, it may be more appropriate to bring a proceeding under the ACPA so that you can get injunctive relief prohibiting such future conduct. A court order can then be enforced under the court's contempt provisions. In addition, if there is a situation in which the domain name registrant has clearly profited from the use of a domain name that copies a mark, a suit under the ACPA may be more advisable so that the complaining party has an opportunity for monetary recovery. One year ago, a company or individual whose name had been taken as a domain name had little options and little chance of effective remedy. Now two options exist, both of which can provide effective relief from acts of cyberpiracy.

ANNEX A

Excerpts from the Lanham Act

Injunctions

SEC. 34 (15 USC 1116). (a) The several courts vested with jurisdiction of civil actions arising under this Act shall have power to grant injunctions, according to the principles of equity and upon such terms as the court may deem reasonable, to prevent the violation of any right of the registrant of a mark registered in the Patent and Trademark Office or to prevent a violation under subsection (a), (c) or (d) of section 43. Any such injunction may include a provision directing the defendant to file with the court and serve on the plaintiff within thirty days after the service on the defendant of such injunction, or such extended period as the court may direct, a report in

¹⁵³ NFL Properties, Inc., et. al. v. Rusty Rahe, WIPO D2000-0128.

¹⁵⁴ Guerlain, supra note 68.

¹⁵⁵ Easyjet Airline Company Ltd. v. Andrew Steggles, WIPO D2000-0024.

¹⁵⁶ Christian Dior Couture SA v. Liage International, Inc., WIPO D200-0098.

¹⁵⁷ Astro-Med, Inc. v. Merry Christmas Everyone!, WIPO D2000-0072.

¹⁵⁸ Compagnie de Saint Gobain, supra note 96.

writing under oath setting forth in detail the manner and form in which the defendant has complied, with the injunction. Any such injunction granted upon hearing after notice to the defendant, by any district court of the United States, may be served on the parties against whom such injunction is granted anywhere in the United States where they may be found, and shall be operative and may be enforced by proceeding to punish for contempt, or otherwise, by the court by which such injunction was granted, or by any other United States district court in whose jurisdiction the defendant may be found.

Monetary Relief

SEC. 35 (15 USC 1117). (a) When a violation of any right of the registrant of a mark registered in the Patent and Trademark Office, a violation under section 43(a), (c) or (d), or a willful violation under section 43(c), shall have been established in any civil action arising under this Act, the plaintiff shall be entitled subject to the provisions of sections 29 and 32 and subject to the principles of equity, to recover (1) defendant's profits, (2) an damages sustained by the plaintiff; and (3) the costs of the action The court shall assess such profits and damages or cause the same to be assessed under its direction. In assessing profits the plaintiff shall be required to prove defendant's sales only; defendant must prove all elements of cost or deduction claimed. In assessing damages the court may enter judgment, according to the circumstances of the case, for any sum above the amount found as actual damages, not exceeding three times such amount. If the court shall find that the amount of the recovery based on profits is either inadequate or excessive the court may, in its discretion, enter judgment for such sum as the court shall find to be just, according to the circumstances of the case. Such sum in either of the above circumstances shall constitute compensation and not a penalty. The court in exceptional cases may award reasonable attorney fees to the prevailing party.

(b) In assessing damages under subsection (a), the court shall, unless the court finds extenuating circumstances, enter judgment for three times such profits or damages, whichever is greater, together with a reasonable attorney's fee, in the case of any violation of section 32(l)(a) of this Act (15 USC 1114(1)(a)) or section 110 of the Act entitled "An Act to incorporate the United States Olympic Association", approved September 21, 1950 (36 USC 380) that consists of intentionally using a mark or designation, knowing such mark or designation is a counterfeit mark (as defined in section 34(d) of this Act (15 USC 1116(d)), in connection with the sale, offering for sale, or distribution of goods or services. In such cases, the court may, in its discretion, award prejudgment interest on such amount at an annual interest rate established under section 6621 of the Internal Revenue Code of 1954, commencing on the date of the service of the claimant's pleadings setting forth the claim for such entry and ending on the date such entry is made, or for such shorter time as the court deems appropriate.

(c) In a case involving the use of a counterfeit mark (as defined in section 34(d)(15 USC 1116(d)) in connection with the sale, offering for sale or distribution of goods or services, the plaintiff may elect, at any time before final judgment is rendered by the trial court, to recover, instead of actual damages and profits under subsection (a), an award of statutory damages for any such use in connection with the sale, offering for sale, or distribution of goods or services in the amount of

(1) not less than \$500 or more than \$100,000 per counterfeit mark per type of goods or services sold, offered for sale, or distributed, as the court considers just; or

(2) if the court finds that the use of the counterfeit mark was willful, not more than \$1,000,000 per counterfeit mark per type of goods or services sold, offered for sale, or distributed, as the court considers just.

(d) In a case involving a violation of section 43(d)(1), the plaintiff may elect, at any time before final judgment is rendered by the trial court, to recover, instead of actual damages and profits, an award of statutory damages in the amount of not less than \$1,000 and not more than \$100,000 per domain name, as the court considers just.

Cyberpiracy Prevention

SEC. 43 (15 USC 1125) (d)(1)(A) A person shall be liable in a civil action by the owner of a mark, including a personal name which is protected as a mark under this section, if, without regard to the goods or services of the parties, that person -

(i) has a bad faith intent to profit from that mark, including a personal name which is protected as a mark under this section and

(ii) registers, traffics in, or uses a domain name that -

(I) in the case of a mark that is distinctive at the time of registration of the domain name, is identical or confusingly similar to that mark;

(II) in the case of a famous mark that is famous at the time of registration of the domain name, is identical or confusingly similar to or dilutive of that mark; or

(III) is a trademark, word, or name protected by reason of section 706 of title 18, United States Code, or section 22 0506 of title 36, United States Code.

(B)(i) In determining whether a person has a bad faith intent described under subparagraph (A), a court may consider factor, such as, but not limited to -

(I) the trademark or other intellectual property rights of the person, if any, in the domain name;

(II) the extent to which the domain name consists of the legal name of the person or a name that is otherwise commonly used to identify that person;

(III) the person's prior use, if any, of the domain name in connection with the bona E de offering of any goods or services;

(IV) the person's bona fide noncommercial or fair use of the mark in a site accessible under the domain name;

(V) the person's intent to divert consumers from the mark owner's online location to a site accessible under the domain name that could harm the goodwill represented by the mark, either for commercial gain or with the intent to tarnish or disparage the mark, by creating a likelihood of confusion as to the source sponsorship, affiliation, or endorsement of the site;

(VI) the person's offer to transfer, sell or otherwise assign the domain name to the mark owner or any third party for financial gain without having used, or having an intent to use, the domain name in the bona fide offering of any goods or services, or the person's prior conduct indicating a pattern of such conduct;

(VII) the person's provision of material and misleading false contact information when applying for the registration of the domain name, the person's intentional failure to maintain accurate contact information, or the person's prior conduct indicating a pattern of such conduct;

(VIII) the person's registration or acquisition of multiple domain names which the person knows are identical or confusingly similar to marks of others that are distinctive at the time of registration of such domain names, or dilutive of famous marks of others that are famous at the time of registration of such domain names, without regard to the goods or services of the parties; and

(IX) the extent to which the mark incorporated in the person's domain name registration is or is not distinctive and famous within the meaning of subsection (c)(1) of section 43.

(ii) Bad faith intent described under subparagraph (A) shall not be found in any case in which the court determines that the person believed and had reasonable grounds to believe that the use of the domain name was a fair use or otherwise lawful.

(C) In any civil action involving the registration, trafficking, or use of a domain name under this paragraph, a court may order the forfeiture or cancellation of the domain name or the transfer of the domain name to the owner of the mark.

(D) A person shall be liable for using a domain name under subparagraph (A) only if that person is the domain name registrant or that registrant's authorized licensee.

(E) As used in this paragraph, the term `traffics in' refers to transactions that include, but are not limited to, sales, purchases, loans, pledges, licenses, exchanges of currency, and any other transfer for consideration or receipt in exchange for consideration.

(2)(A) The owner of a mark may file an in rem civil action against a domain name in the judicial district in which the domain name registrar, domain name registry, or other domain name authority that registered or assigned the domain name is located if

(i) the domain name violates any right of the owner of a mark registered in the Patent and Trademark Office, or protected under subsection (a) or (c); and

(ii) the court finds that the owner

(I) is not able to obtain in personam jurisdiction over a person who would have been a defendant in a civil action under paragraph (1); or

(II) through due diligence was not able to find a person who would have been a defendant in a civil action under paragraph (1) by

(aa) sending a notice of the alleged violation and intent to proceed under this paragraph to the registrant of the domain name at the postal and e-mail address provided by the registrant to the registrar; and

(bb) publishing notice of the action as the court may direct promptly after filing the action.

(B) The actions under subparagraph (A)(ii) shall constitute service of process.

(C) In an in rem action under this paragraph, a domain name shall be deemed to have its situs in the judicial district in which -

(i) the domain name registrar, registry, or other domain name authority that registered or assigned the domain name is located; or

(ii) documents sufficient to establish control and authority regarding the disposition of the registration and use of the domain name are deposited with the court.

(D)(i) The remedies in an in rem action under this paragraph shall be limited to a court order for the forfeiture or cancellation of the domain name or the transfer of the domain name to the owner of the mark. Upon receipt of written notification of a filed stamped copy of a complaint filed by the owner of a mark in

United States district court under this paragraph, the domain name registrar, domain name registry, or other domain name authority shall -

(I) expeditiously deposit with the court documents sufficient to establish the court's control and authority regarding the disposition of the registration and use of the domain name to the court, and

(II) not transfer, suspend, or otherwise modify the domain name during the pendency of the action, except upon order of the court.

(ii) The domain name registrar or registry or other domain name authority shall not be liable for injunctive or monetary relief under this paragraph except in the case of bad faith or reckless disregard, which includes a willful failure to comply with any such court order.

(3) The civil action established under paragraph (1) and the in rem action established under paragraph (2), and any remedy available under either such action, shall be in addition to any other civil action or remedy otherwise applicable.

(4) The in rem jurisdiction established under paragraph (1) shall be in addition to any other jurisdiction that otherwise exists; whether in rem or in personam.

Cyberpiracy Protections for Individuals

(15 USC 1129)

(1) In general

(A) Civil liability

Any person who registers a domain name that consists of the name of another living person, or a name substantially and confusingly similar thereto, without that person’s consent, with the specific intent to profit from such name by selling the domain name for financial gain to that person or any third party, shall be liable in a civil action by such person.

(B) Exception

A person who in good faith registers a domain name consisting of the name of another living person, or a name substantially and confusingly similar thereto, shall not be liable under this paragraph if such name is used in, affiliated with, or related to a work of authorship protected under Title 17, including a work made for hire as defined in section 101 of Title 17, and if the person registering the domain name is the copyright owner or licensee of the work, the person intends to sell the domain name in conjunction with the lawful exploitation of the work, and such registration is not prohibited by a contract between the registrant and the named person. The exception under this subparagraph shall apply only to a civil action brought under paragraph (1) and shall in no manner limit the protections afforded under the Trademark Act of 1946(15 USC 1051 et seq)or other provision of Federal or State law.

(2) Remedies

In any civil action brought under paragraph (1), a court may award injunctive relief, including the forfeiture or cancellation of the domain name or the transfer of the domain name to the plaintiff. The court may also, in its discretion, award costs and attorneys fees to the prevailing party.

(3) Definition

In this section, the term “domain name” has the meaning given that term in section 45 of the Trademark Act of 1946 (15 USC 1127).

(4) Effective date

This section shall apply to domain names registered on or after November 29, 1999. (Pub. L. 106-1 13, Div. B, § 1000(a)(9) [S. 1948, Title III, § 3002(b)], Nov.29,1999,113 Stat.1536,1537-)

ANNEX B

A Comparison of Elements to Establish Claims Under ACPA and UDRP

<i>ACPA</i>	<i>UDRP</i>
Does the registrant have trademark or other intellectual property rights in the domain name.	Did registrant, prior to notice of the dispute, use or make demonstrable preparations to use the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods.
Does the domain name consist of the legal name of the person or is it a name that is	Has the registrant been commonly known by the domain name even if it has acquired no

otherwise commonly used to identify the registrant.	trademark or service mark rights in the domain name.
Has the registrant made prior use of the domain name in connection with a bona fide offering of any goods or services.	See above.
Has the registrant made a bona fide noncommercial or fair use of the mark in a site accessible under the domain name.	Is registrant making 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.
Does the registrant have an intent to divert consumers from the mark owner's online location to a site accessible under the domain name that could harm the goodwill represented by the mark, either for commercial gain or with the intent to tarnish or disparage the mark, by creating a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the site.	By using the domain name has the registrant intentionally attempted to attract, for commercial gain, Internet users to its website 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 its website or location or of a product or service on its website or location.
Has the registrant offered to transfer, sell or otherwise assign the domain name to the mark owner or any third party for financial gain without having used, or having an intent to use, the domain name in the bona fide offering of any goods or services, or does registrant have a pattern of such conduct	Has the registrant registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name.
Has the registrant provided material and misleading false contact information when applying for the registration of the domain name; has registrant intentionally failed to maintain accurate contact information or does it have a pattern of such conduct.	No specific counterpart in UDRP but case law holds that such action under the UDRP constitutes evidence of bad faith.
Has the registrant registered or acquired multiple domain names which the person knows are identical or confusingly similar to marks of others that are distinctive at the time of registration of such domain names, or dilutive of famous marks of others that are famous at the time of registration of such domain names, without regard to the goods or services of the parties	Has the domain name been registered in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that registrant has engaged in a pattern of such conduct.
Does the registrant have trademark or other intellectual property rights in the domain name?	Did registrant, prior to notice of the dispute, use or make 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?
Does the domain name consist of the legal name of the person or is it a name that is otherwise commonly used to identify the registrant?	Has the registrant been commonly known by the domain name even if it has acquired no trademark or service mark rights in the domain name?
Has the registrant made prior use of the domain name in connection with a bona fide offering of any <u>goods or services</u> ?	See above.
Has the registrant made a bona fide noncommercial or fair use of the mark in a site accessible under the domain name?	Is registrant making 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 <u>issue</u> ?
Does the registrant have an intent to divert consumers from the mark owner's online location to a site accessible under the domain name that could harm the good will represented by the mark, either for commercial gain or with the intent to tarnish or disparage the mark, by creating a likelihood of confusion as to the source, sponsorship, <u>affiliation, or endorsement of the site</u> ?	By using the domain name, has the registrant intentionally attempted to attract, for commercial gain, Internet users to its website 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 its website or location or of a product or service on its website or location?
Has the registrant offered to transfer, sell or otherwise assign the domain name to the mark owner or any third party for financial gain without having used, or having an intent to use, the domain name in the bona fide offering of any goods or services, or does registrant have a pattern of such conduct?	Has the registrant registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name?
Has the registrant provided material and misleading false contact information when applying for the registration of the domain name; has registrant intentionally failed to maintain accurate contact information or does it have a pattern of such conduct?	No specific counterpart in UDRP but case law holds that such action under the UDRP constitutes evidence of bad faith.
Has the registrant registered or acquired multiple domain names	Has the domain name been registered in order to prevent the owner of the trademark or

<p>which the person knows are identical or confusingly similar to marks of others that are distinctive at the time of registration of such domain names, or dilutive of famous marks of others that are famous at the time of registration of such domain names, without regard to the goods or services of the parties?</p>	<p>service mark from reflecting the mark in a corresponding domain name, provided that registrant has engaged in a pattern of such conduct?</p>
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ANNEX C

**UDRP Case Law Finding Bad Faith Use
And Registration Based on the ACPA Factors**

ACPA CASES	UDRP CASES
Does the registrant have trademark or other intellectual property rights in the domain name.	<u>Compaq Computer Corporation v. Boris Beric</u> , WIPO D2000-0042 (Bad faith use and registration found in part by the domain name registrant’s failure to make any use of the domain name); <u>The Hamlet Group, Inc. v. James Lansford</u> , WIPO D2000-0073 (Lack of non-commercial or fair use of the mark or any other acquisition of the rights in the mark leads to inference that the primary intention in registering the domain name was to sell it or to prevent complainant from using it).
Does the domain name consist of the legal name of the person or is it a name that is otherwise commonly used to identify the registrant.	<u>PlanetRx.com, Inc. v. Intertainment, Inc.</u> , NAF 0001000092973 (That domain name bears no relationship to the registrant’s trade name is evidence of bad faith); <u>Tourism and Corporate Automation Ltd. v. TFI Limited</u> , AF-0096 (Registration of a domain name completely different from one’s own mark allows inference to be drawn that the domain name was registered to destroy the business of the complaining party and this constitutes bad faith).
Has the registrant made prior use of the domain name in connection with a bona fide offering of any goods or services.	<u>See cases cited in connection with the first factor.</u>
Has the registrant made a bona fide noncommercial or fair use of the mark in a site accessible under the domain name.	<u>The Hamlet Group, Inc. v. James Lansford</u> , WIPO D2000-0073 (Lack of non-commercial or fair use of the mark or any other acquisition of rights in the mark leads to inference that the primary intention in registering the domain name was to sell it or to prevent complainant from using it).
Does the registrant have an intent to divert consumers from the mark owner's online location to a site accessible under the domain name that could harm the goodwill represented by the mark, either for commercial gain or with the intent to tarnish or disparage the mark, by creating a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the site?	<u>Bennett Coleman & Co. Ltd. v. Stephen S. Lalwani et. al.</u> , WIPO D2000-0014 and D2000-0015 (Panel finds that registration and use of the domain name is in bad faith since the use amounted to an attempt to intentionally attract for commercial gain Internet users to the registrant’s website by creating a likelihood of confusion with the complainant’s marks as to source, sponsorship, affiliation or

	endorsement); <u>Tata Sons Ltd. v. The Advanced Information Technology Association</u> , WIPO D2000-0049 (By virtue of the similarity between the domain name registration and the trademark, Internet users are likely to believe that the registrant's website is authorized or endorsed).
Has the registrant offered to transfer, sell or otherwise assign the domain name to the mark owner or any third party for financial gain without having used, or having an intent to use, the domain name in the bona fide offering of any goods or services, or does registrant have a pattern of such conduct	<u>World Wrestling Federation Entertainment, Inc. v. Michael Bofman</u> , WIPO D99-0001 (Offering to sell domain name is evidence of bad faith use and registration); <u>accord, Surf Dog, Inc. v. Dr. Charles Cooper</u> , WIPO D2000-0065.
Has the registrant provided material and misleading false contact information when applying for the registration of the domain name; has registrant intentionally failed to maintain accurate contact information or does it have a pattern of such conduct.	<u>Telstra Corporation Limited v. Nuclear Marshmellows</u> , WIPO D2000-0003 (The fact that domain name registrant actively provided and failed to correct false contact details in breach of its registration agreement is evidence of bad faith use and registration); <u>Home Director, Inc. v. HomeDirector</u> , WIPO D2000-0111 (Evidence of bad faith is the registrant's use of false or misleading information in connection with the registration of the domain name).
Has the registrant registered or acquired multiple domain names which the person knows are identical or confusingly similar to marks of others that are distinctive at the time of registration of such domain names, or dilutive of famous marks of others that are famous at the time of registration of such domain names, without regard to the goods or services of the parties	<u>Nabisco Brands Company v. The Patron Group, Inc.</u> , WIPO D2000-0032 (Ownership of numerous domain names suggests a studied selection of domain names for the purpose of profiting rather than maintaining active websites for providing goods and services in commerce); <u>J. P. Morgan v. Resource Marketing</u> , WIPO D2000-0035 (Noting numerous panel decisions finding that ownership of multiple domain names suggests an intent to profit from the activities from others).