

INTERNET DOMAIN NAMES AND UNIFORM DISPUTE RESOLUTION PROCEDURES (UDRP)

WIPO SUMMER SCHOOL ON INTELLECTUAL PROPERTY BANGKOK MAY 2013

WHAT IS AN INTERNET DOMAIN NAME?

- FRIENDLY FORMS OF INTERNET ADDRESSES WHICH PROVIDE MEMORABLE NAMES TO NUMERICALLY ADDRESSED INTERNET RESOURCES THAT EASY FOR CUSTOMER TO REMEMBER
- GENERALLY USED TO LOCATE THE SPECIFIC SITES IN DOMAIN NAME SYSTEM
- REPRESENT THE INTERNET PROTOCOL RESOURCES.

COMPOSITION OF THE INTERNET DOMAIN NAME

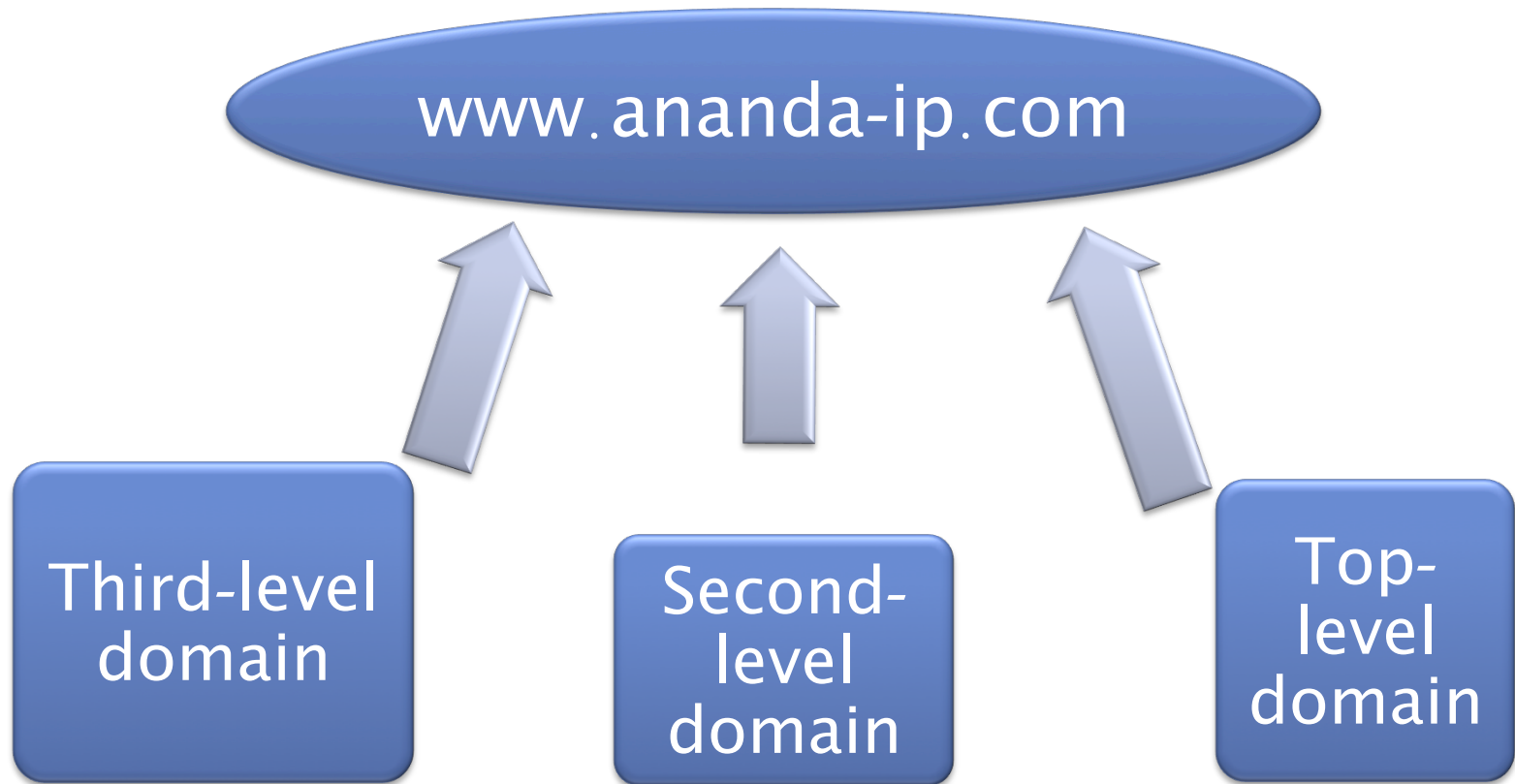
- HTTP (HYPERTEXT TRANSFER PROTOCOL)

THE UNDERLYING PROTOCOL USED BY THE WORLD WIDE WEB. HTTP DEFINES HOW MESSAGES ARE FORMATTED AND TRANSMITTED, AND WHAT ACTIONS WEB SERVERS AND BROWSERS SHOULD TAKE IN RESPONSE TO VARIOUS COMMANDS

- HTTPS (HYPERTEXT TRANSFER PROTOCOL SECURE)

A COMBINATION OF THE HTTP WITH THE SSL/TLS PROTOCOL. IT PROVIDES ENCRYPTED COMMUNICATION TO PREVENT EAVESDROPPING AND TO SECURELY IDENTIFY THE WEB SERVER WITH WHICH YOU ARE ACTUALLY COMMUNICATING.

COMPOSITION OF THE INTERNET DOMAIN NAME



COMPOSITION OF THE INTERNET DOMAIN NAME

WHAT ARE THE DIFFERENT TYPES OF INTERNET DOMAIN NAMES?

TOP-LEVEL DOMAIN TRADITIONALLY DIVIDED INTO 2 GROUPS

- gTLDs (THE GENERIC TOP-LEVEL DOMAIN)
 - gTLDs REPRESENTED A SET OF CATEGORIES OF NAMES AND MULTI-ORGANIZATIONS THAT CONTAIN SEVEN gTLDs THAT ARE .COM, .NET, .ORG, .EDU, .GOV, .MIL AND .INT)
 - ON NOVEMBER 16, 2000 ICANN ANNOUNCED THE SEVEN NEW TLDs WHICH ARE AERO, BIZ, COOP, INFO, MUSEUM, NAME AND PRO.
 - ICANN ADDED FURTHER SIX NEW SPONSORED TLDs WHICH ARE .ASIA .CAT .JOBS .MOBI .TEL AND .TRAVEL. AS FOR .XXX, IT WAS FINALLY APPROVED IN MARCH 2011.

WHAT ARE THE DIFFERENT TYPES OF INTERNET DOMAIN NAMES?

gTLDs	CONDITIONS
.com	Open TLD, used by all types of entities including nonprofits, schools and private individuals.
.org	Open TLD, used by non-profit organizations
.net	Open TLD, originally for network infrastructures,
.info	Open TLD, any person or entity is permitted to register
.edu	Only post-secondary institutions and organizations that located in the U.S., legally organized in the U.S., or recognized by a U.S. state, territorial, or federal agency.
.gov	Limited to use by the United States of America government
.mil	Limited to use by the United States of America Military
.int	Strictly limited to organizations, offices, and programs which are endorsed by a treaty between two or more nations.
.aero	Only for the entire aviation community

WHAT ARE THE DIFFERENT TYPES OF INTERNET DOMAIN NAMES?

gTLDs	CONDITIONS
.biz	Open TLD, any person or entity is permitted to register
.coop	Only cooperatives, cooperative service organizations and subsidiaries of cooperatives will be eligible to use the .coop
.museum	Enables museums, museums associations and museum professionals to register for the global museum community
.name	Designed for use with individuals' real names, nicknames, screen names, pseudonyms or other personal names.
.pro	Available to all government certified individuals and businesses
.travel	Intended and used by travel agents, airlines, bed and breakfast operators, tourism bureaus, and others in the travel industry
.xxx	Provided for the adult entertainment and adult content websites
.mobi	Used for mobile-compatible sites in accordance with standards
.tel	To help manage and exchange contact information about people and companies.

WHAT ARE THE DIFFERENT TYPES OF INTERNET DOMAIN NAMES?

- ccTLDs (THE COUNTRY CODE TOP-LEVEL DOMAIN)
 - ccTLDs HAVE BEEN ESTABLISHED FOR OVER 250 COUNTRIES AND EXTERNAL TERRITORIES.
 - THESE ccTLDs ARE ADMINISTERED INDEPENDENTLY BY NATIONALLY DESIGNATED REGISTRATION AUTHORITIES.
 - BASED ON THE TWO-CHARACTER CODES OF COUNTRY ABBREVIATION. FOR EXAMPLE, .TH FOR THAILAND .CN FOR CHINA .CA FOR CANADA AND .KR FOR SOUTH KOREA

WHAT ARE THE DIFFERENT TYPES OF INTERNET DOMAIN NAMES?

ccTLDs	CONDITIONS
.th	Used for a company locally incorporated in Thailand or Foreign company which has a local representative office in Thailand
.cn	Intended for multi-national entities that have a China branch, commercial entities registered in Hong Kong and legal entities incorporated in Malaysia or Singapore
.eu	Restricted to companies and individuals who have residency in the European Union.
.asia	Legal entities within Asia, Australia and Pacific region
.us	Used for a citizen or permanent resident of the U.S. and entity or organization that is incorporate within U.S. states, the District of Columbia or has a bona fide presence in the U.S.
.kr	For Korean commercial organizations or individuals who have the local presence within South Korea
.sg	Open to all registrant with local presence in Singapore

NEW GENERIC TOP-LEVEL DOMAIN NAMES: A REVOLUTION!



History



The Applicant Guidebook has gone through several iterations in draft form and is the result of years of careful implementation of GNSO policy recommendations and thoughtful review and feedback from the ICANN stakeholder community. Each version of the Applicant Guidebook was posted for public comment. More than one thousand public comments have been reviewed and considered, making the program what it is today.

Applicant Guidebook June 2012

- January 2012

2012

2011

Applicant Guidebook September 2011

- May 2011
- April 2011 Discussion Draft
- November 2010 (Proposed Final version)
- May 2010 (version 4)
- February 2010 (excerpts)
 - October 2009 (version 3)
 - May 2009 (excerpts)
 - March 2009 (version 2)

2010

2009

Applicant Guidebook (version 1) Oct. 2008

2008

In June 2008, during ICANN's Paris meeting, the ICANN Board approved the GNSO recommendations for introducing new gTLDs to the Internet's addressing system.

2007

2005

2004

.asia, .cat, .jobs, .mobi,
.post, .tel, .xxx, and .travel

ICANN successfully carried out two previous application rounds for new gTLDs

2000

.aero, .biz, .coop, .info,
.museum, .name, and .pro

Before 1998

.com, .edu, .gov, .int,
.mil, .net, .org, and .arpa

The first version of the Applicant Guidebook was posted October 2008. The Applicant Guidebook documents how ICANN has implemented the GNSO policy recommendations and is a comprehensive guide for applicants on the program's requirements and evaluation process.

ICANN's Generic Names Supporting Organization (GNSO) conducted their policy development process between December 2005 and September 2007. This work produced a set of principles and recommendations on what should be included when implementing the program.

Eight gTLDs predate ICANN's creation

THE NEW GENERIC TOP-LEVEL DOMAIN NAMES

- WHEN YOU APPLY FOR A NEW gTLD YOU ARE APPLYING TO RUN A REGISTRY BUSINESS. YOU WILL BE RESPONSIBLE FOR A CRITICAL AND HIGHLY VISIBLE PIECE OF INTERNET INFRASTRUCTURE. JUST AS VERISIGN IS RESPONSIBLE FOR ALL THE DOMAIN NAMES REGISTERED IN THE .COM TOP-LEVEL DOMAIN, SO YOU WOULD BE RESPONSIBLE FOR ALL THE DOMAIN NAMES REGISTERED IN YOUR .SOMETHING gTLD.
- WHILE OPERATING A TOP-LEVEL DOMAIN REGISTRY OFFERS EXCITING OPPORTUNITIES AND REWARDS, IT CARRIES GREAT RESPONSIBILITIES AS WELL. THE PURPOSE OF THIS BRIEF IS TO HELP PROSPECTIVE APPLICANTS EVALUATE THE NEW gTLD PROGRAM BY CONSIDERING THE BENEFITS AS WELL AS THE RISKS AND RESPONSIBILITIES.

THE NEW GENERIC TOP-LEVEL DOMAIN NAMES

RISKS AND RESPONSIBILITIES:

- **INVESTMENT.** US \$185,000 EVALUATION FEE AND ONGOING REGISTRY OPERATING COSTS, APPLICANTS MUST DEMONSTRATE SUFFICIENT FINANCIAL DEPTH TO KEEP THE REGISTRY FULLY OPERATIONAL FOR AT LEAST THREE YEARS EVEN IF THE BUSINESS PLAN DOES NOT ACHIEVE ITS OBJECTIVES.
- **LOSS OF INVESTMENT.** THERE IS NO GUARANTEE YOU WILL GET THE STRING YOU APPLIED FOR. IF YOU DO NOT PASS THE EXTENSIVE EVALUATION PROCESS YOU COULD LOSE SOME OR ALL OF YOUR INITIAL INVESTMENT. AS WITH ANY NEW BUSINESS, GETTING THE OPERATION STARTED DOES NOT GUARANTEE THAT REVENUES WILL PROFITABLY SUSTAIN IT.

THE NEW GENERIC TOP-LEVEL DOMAIN NAMES

- INTERNATIONALIZED DOMAIN NAMES (IDNs)

DOMAIN NAMES REPRESENTED BY CHARACTERS OTHER THAN THE TRADITIONAL ASCII CHARACTERS (A THROUGH Z). SUCH DOMAIN NAMES COULD CONTAIN LETTERS OR CHARACTERS FROM NON-LATIN SCRIPTS (FOR EXAMPLE, ARABIC OR CHINESE).

MANY EFFORTS ARE ONGOING IN THE INTERNET COMMUNITY TO MAKE DOMAIN NAMES AVAILABLE IN MANY LANGUAGES OTHER THAN THOSE BASED ON THE LATIN SCRIPT.

THE NEW GENERIC TOP-LEVEL DOMAIN NAMES

MAY 10, 2013 ABOUT 300 APPLICATIONS PASSED THE EVALUATION:

SOME EXAMPLES:

.WIKI (OWNED BY TOP LEVEL DESIGN LLC)

.PARIS (OWNED BY VILLE DE PARIS)

.LOREAL, .LANCOME, .HAIR, .BEAUTY ETC (OWNED BY L'OREAL)

.LUXE (OWNED BY TOP LEVEL DOMAIN HOLDING LIMITED)

.[삼성](#) (OWNED BY SAMSUNG)

SEE FOR FULL LIST:

[HTTPS://GTLRESULT.ICANN.ORG/APPLICATION-RESULT/APPLICATIONSTATUS/
VIEWSTATUS](https://gtldresult.icann.org/application-result/applicationstatus/viewstatus)

HOW ARE THE INTERNET DOMAIN NAMES PROTECTED?

- DOMAIN NAMES CAN BE REGISTERED THROUGH MANY DIFFERENT REGISTRARS THAT WILL ASK REGISTER TO PROVIDE VARIOUS CONTACT AND TECHNICAL INFORMATION THAT MAKES UP THE REGISTRATION.
- THEN, REGISTRAR WILL KEEP RECORDS OF CONTACT INFORMATION AND SUBMIT THE TECHNICAL INFORMATION TO REGISTRY THAT PROVIDES OTHER COMPUTERS THE NECESSARY INFORMATION ON INTERNET TO SEND E-MAIL OR TO FIND REGISTER'S WEBSITE.
- THE REGISTER WILL BE REQUIRED TO ENTER A REGISTRATION CONTRACT WITH REGISTRAR WHICH SETS FORTH THE TERMS UNDER WHICH THE REGISTRATION IS ACCEPTED AND WILL BE MAINTAINED.

HOW ARE THE INTERNET DOMAIN NAMES PROTECTED?

- WHOIS
 - WHEN YOU REGISTER A DOMAIN NAME, ICANN REQUIRES YOUR DOMAIN NAME REGISTRAR TO SUBMIT YOUR PERSONAL CONTACT INFORMATION TO THE WHOIS DATABASE.
 - ONCE YOUR LISTING APPEARS IN THIS ONLINE DIRECTORY, IT IS PUBLICLY AVAILABLE TO ANYONE WHO CHOOSES TO CHECK DOMAIN NAMES USING THE WHOIS SEARCH TOOL.

WHAT IS ICANN?

- AN ABBREVIATION OF INTERNET CORPORATION FOR ASSIGNED NAMES AND NUMBERS
- THE INTERNATIONAL NON-PROFIT ORGANIZATION AND RESPONSIBLE FOR MANAGING AND COORDINATING THE DOMAIN NAME SYSTEM (DNS)
- TO ENSURE THAT EVERY ADDRESS IS UNIQUE AND ALL USERS CAN FIND ALL VALID ADDRESSES
- ICANN IS ALSO RESPONSIBLE FOR ACCREDITING THE DOMAIN NAME REGISTRARS

WHAT IS UDRP?

THE UDRP OR THE UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY IS THE POLICY ADOPTED BY ICANN

- USE FOR EXAMPLE WHEN THIRD PARTIES' INTERNET DOMAIN NAMES CORRESPOND TO TRADEMARK RIGHTS/ BAD FAITH REGISTRATION
- ONE MAIN PURPOSE OF UDRP IS TO PROTECT TRADEMARKS AGAINST THEIR ABUSIVE REGISTRATION AS DOMAIN NAMES

HOW ARE .COM DISPUTE SETTLED BY UDRP?

TO BRING A COMPLAINT AGAINST A DOMAIN NAME REGISTRANT UNDER THE ICANN REGIME:

THE COMPLAINANT MUST PROVE THAT EACH OF THESE THREE ELEMENTS BELOW ARE PRESENT:

- THE DOMAIN NAME IS IDENTICAL OR CONFUSINGLY SIMILAR TO A TRADEMARK OR SERVICE MARK IN WHICH THE COMPLAINANT HAS RIGHTS; AND
- THE RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DOMAIN NAME; AND
- THE RESPONDENT'S DOMAIN NAME HAS BEEN REGISTERED AND IS BEING USED IN BAD FAITH.

HOW ARE .COM DISPUTE SETTLED BY UDRP?

ONCE A COMPLAINT IS FILED, IT IS FORWARDED TO THE DOMAIN NAME REGISTRANT WHILE THE REGISTRANT HAD 20 DAYS TO FILE A RESPONSE.

WHEN THE RESPONSE IS FILED, A PANEL OF ARBITRATIONS IS CHOSEN WITHIN 5 DAYS AND A DECISION IS RENDERED WITHIN AN ADDITIONAL 14 DAYS. THE PARTIES ARE NOTIFIED APPROXIMATELY 3 DAYS AFTER DECISION.

HOW ARE .COM DISPUTE SETTLED BY UDRP?

COST DEPENDS ON TWO CRITERIA:

- THE NUMBER OF DOMAINS INCLUDED IN THE DISPUTE
- THE NUMBER OF PANELISTS (ONE OR THREE)

THE FEE IS COMPOSED OF AN AMOUNT TO BE RETAINED BY THE CENTER AS AN ADMINISTRATION FEE AND AN AMOUNT TO BE PAID TO THE PANELIST(S)

IN TERM OF WHO PAYS

- IN CASE OF SINGLE MEMBER PANEL, THE FEE, IS DUE FROM THE COMPLAINANT.
- IN CASES OF THREE MEMBER PANEL,
 - IF REQUESTED BY THE COMPLAINANT, THE FEE, IN FULL, IS DUE FROM THE COMPLAINANT.
 - IF REQUESTED BY THE RESPONDENT, THE FEE IS SPLIT EQUALLY.

HOW ARE .COM DISPUTE SETTLED BY UDRP?

THE PERSON WHO MAKES A DECISIONS

- AN EXPERT NEUTRAL OR PANELIST IS APPOINTED BY WIPO TO REVIEW THE DISPUTE AND ISSUE A DECISION
- EITHER PARTY TO THE DISPUTE MAY OPT TO HAVE ONE OR THREE PANELISTS ASSIGNED TO THE CASE.
- UNDER THE UDRP THE PANELIST CAN ONLY DECIDE TO TRANSFER OR CANCEL THE DOMAIN NAME(S), OR DENY THE COMPLAINT. IT IS NOT POSSIBLE FOR THE PANEL TO MAKE ANY MONETARY JUDGMENTS.

EXAMPLE OF DOMAIN NAME DISPUTE SETTLED BY UDRP

Complainant Domain name	www.maybellinenewyork.com
Respondent Domain name	www.maybelline-newyork.com
Identical or Confusingly similar	Yes, the geographically descriptive words would be perceived by internet users as descriptive of a website. The hyphen is not of source-indicating value.
Rights or Legitimate interests	Yes, the respondent has used the disputed domain name to divert internet users via sponsored links to website that are unaffiliated with the complainants or complainant's services.
Registered and Used in bad faith	Yes, the respondent offered to sell the disputed domain name to the complainants for 500-1,000 Euros and has been named as a defendant in several UDRP complaints transferring well-known marks
Decision	Disputed domain name to be transferred to complainant.

EXAMPLE OF DOMAIN NAME DISPUTE SETTLED BY UDRP

Complainant Domain name	www.elephantparade.com
Respondent Domain name	www.theelephantparade.com
Identical or Confusingly similar	Yes, the text “elephant parade” is distinctive and identical to the dominant portion of the complainant’s mark that internet users may assume that it is related to the complainant.
Rights or Legitimate interests	Yes, the disputed domain name is being used for commercial and no evidence that respondent has been commonly known by disputed domain name. In addition, it is not descriptive of goods or serviced or related to the website content.
Registered and Used in bad faith	Yes, the search reveals the complainant and the related website as the top search result. There is more likely that respondent had knowledge of the complainant and its mark at the time of registering, such that the registration was made in bad faith.
Decision	Disputed domain name be transferred to complainant.

EXAMPLE OF DOMAIN NAME DISPUTE SETTLED BY UDRP

Complainant Domain name	www.yahoo.com
Respondent Domain name	www.yahooasian.com, www.yahooasian.net, www.yahoo-asian.com, www.yahoo-asian.net and yahoo-asian.org
Identical or Confusingly similar	Yes, each disputed domain names incorporates the essence of the “YAHOO!” mark. The addition of “ASIAN” and either .com .net or .org do nothing to detract from and are likely to reinforce the strong association between the word “YAHOO” and the complainant.
Rights or Legitimate interests	Yes, though the services on its website are genuine but the respondent’s use is not legitimate because of the intention to divert internet users to respondent’s website.
Registered and Used in bad faith	Yes, due to the fame and the knowledge of the complainant’s mark that the respondent must have had when registering the disputed domain names, the respondent must have anticipated and intended to benefit from the confusion.
Decision	Disputed domain name to be transferred to complainant.

HOW ARE OTHER INTERNET DISPUTED SETTLED FOR COUNTRY SPECIFIC EXTENSIONS

Complainant Domain name	www.vodafone.ph
Respondent Domain name	www.vodafone.com.ph
Identical or Confusingly similar	Yes, the disputed domain name wholly incorporates and is confusingly similar to the widely-known VODAFONE trademark
Rights or Legitimate interests	Yes, the complainant has established a prima facie case that the respondent does not have rights or legitimate interests in the disputed domain name, which respondent has not rebutted.
Registered and Used in bad faith	Yes, it can be inferred that the respondent's purpose of acquiring the disputed domain name was to prevent the complainant from having it and there is no conceivable use which could be made of the domain name would be use in good faith
Decision	Disputed domain name to be transferred to complainant.

Contact:

Ananda Intellectual Property Limited

53/3, 4th Floor, A-4 | Goldenland Building | Soi Mahardlekluang 1
Rajdamri Road, Lumpini, Phatumwan | Bangkok 10330, Thailand

T: +66(0)2 684 1145 | F: +66(0)2 684 5990 | E: aip@ananda-ip.com

www.ananda-ip.com