



Domain name complaints under the Uniform Domain-Name Dispute-Resolution Policy (UDRP)

Background

The Uniform Domain Name Dispute Resolution Policy (UDRP) allows disputes over domain names to be resolved in a cost effective and efficient manner, without resorting to expensive litigation. UDRP complaints can be filed with various providers including the World Intellectual Property Office (WIPO).

Registrars of generic top level domains (gTLDs) and some country code top level domains (ccTLDs), which are accredited with ICANN, and holders of such domain names are required to abide by the UDRP.

Multiple and consolidated UDRP complaints

There are benefits to filing multiple or consolidated complaints and according to Rule 3 (c) of the UDRP Rules a UDRP complaint can be filed against more than one domain name (a multiple domain name complaint) provided all domains are owned by the same domain name holder.

Where the Whois records show the domains as registered in the same name the situation is straightforward. The situation is less straightforward where an individual or entity has registered several domains under different names.

Rule 10 (e) of the UDRP Rules state that the Panelists appointed to decide a UDRP complaint have the power to consolidate several complaints into one. The test for consolidation of complaints where the domain name

holder from Whois records is different, established through numerous UDRP decisions, is whether:

- the domain names, or the websites to which they resolve, are subject to common control and;
- consolidation would be fair and equitable to both parties.

This means in practice it is possible to file a domain name complaint against more than one domain, even where from Whois records the domain name holder appears to be different for each domain name, provided this two part test can be met.

How to demonstrate common control

Two recent UDRP decisions issued by WIPO in a consolidated complaint (D2013-0994 Seiko Holdings Kabushiki Kaisha (trading as Seiko Holdings Corporation) v. L. Collins Travis et. al and D2012-2212 Guccio Gucci S.p.A v. Andrea Hubner) concerned 138 domain names registered by 106 differently named Registrants and 128 domain names registered by 18 Registrants respectively. The Panelists found that on the balance of probabilities the domains were subject to common control due to the following factors:

- The use of common registration information such as administrative contact details, technical contact details, postal addresses, email addresses, IP addresses, and telephone and fax numbers;

- The websites to which the disputed domain names resolve are the same or that feature similar content and serve the same function, e.g. to sell a certain type of product;
- Use of the same domain name servers;
- Use of the same domain name registrars;
- A close similarity between the disputed domain names, e.g. each incorporates the trade mark in its entirety in conjunction with non-distinctive, generic or geographical terms.
- A pattern of use of obviously fake physical addresses and e-mail contact addresses hosted by the same two servers;
- Registration of all the disputed domain names on the same four dates in 2012 and 2013;
- The disputed domain names use the same or closely related domain name servers (i.e. the same hosting service).

It would seem that this list is not exhaustive and Panels are likely to accept other factors as evidence of common control.

The first two factors set out above are the most indicative of common control and Panels have accepted either of these factors on their own as evidence of common control. The other factors are only likely to build a picture of common control if presented in conjunction with one or more of the other factors.

When is Consolidation Fair and Equitable?

An important objective of the UDRP is that all complaints are conducted in a way that is procedurally efficient in order to maintain the purpose of the UDRP as a cost effective and efficient way to resolve domain disputes, where expensive litigation is not viable or necessary. If a Panel is prepared to accept from evidence that on the balance of probabilities several domains are in fact owned by the same holder, the test for 'fair and equitable' is met. If this was not the case, Complainants would be forced to incur considerable expense in filing several individual UDRP complaints, which would not be consistent with ensuring procedural efficiency.

Cost benefits

The official fee to file one UDRP complaint against multiple domain names is lower than the official fee to file several individual complaints. Time spent on research prior to filing a UDRP complaint could prove cost effective in the long term, if it enables you to identify other domains registered in the same name as well as domain names which can be shown to be subject to common control.

Locating other domains owned by an individual or entity

Due to the cost benefits of targeting repeat cyber squatters with multiple and consolidated complaints, rather than on a piecemeal basis, it is sensible to try to locate as many domains owned by one individual or entity before filing a complaint against just one domain.

There are ways we can do this:

■ Watch Services

There are various providers of domain name watch services, which will report registration of any domains containing a particular trade mark. A benefit of the watch is that it will provide a searchable log of the domains reported, allowing you to find any other domains registered by the same domain name holder or, for example, using the same email address in Whois records.

■ Reverse Whois reports

These are easily obtained online for reasonable costs and will flag up all domains registered to a particular name or identifying a particular email address. The results of a Reverse Whois report can not only find domains that can be included in a multiple or consolidated complaint, but also provide valuable evidence of bad faith.

Additional analysis is required to get the most out of the results of domain name watches or reverse Whois reports, in order to gather enough evidence relating to as many domains as possible to show common control.

How A. A. Thornton & Co. can help

At A.A. Thornton & Co. our trade mark attorneys are qualified to advise on all aspects of trade mark law. The services of our trade mark attorneys include:

- Review domain name portfolios generally, identify gaps and assist with registration of domain names
- Provide advice in relation to domain names registered by third parties that are of concern or you would like to have and outline options for acquiring or objecting
- Drafting and filing of complaints and compiling evidence, including obtaining Reverse Whois reports
- Discuss putting in place domain name watches and compile strategies for targeting abusive domain names

Contact

For more information please contact **Louise Foster** via email at lxf@aathornton.com or your usual A.A Thornton & Co. advisor.

For general information please visit: www.aathornton.com

Partners

Vanessa Lawrence
vabl@aathornton.com

Ian Gill
isg@aathornton.com

Martin Hedges
mnh@aathornton.com

Craig Turner
crt@aathornton.com

Rachel Havard
rsh@aathornton.com

Adrian Bennett
arb@aathornton.com

Mike Jennings
mjj@aathornton.com

Emily Cottrill
eehc@aathornton.com

Lawrence King
llk@aathornton.com

Associates

Nick South
ngs@aathornton.com

Heather Donald
hrd@aathornton.com

Sarah Darby
smd@aathornton.com