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ICANN'S UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY AS A MEANS
OF COMBATING COPYRIGHT INFRINGEMENT

By
Dwight A. Decker, Jr.*

I. INTRODUCTION

The Internet has allowed private individuals to infringe on copyrights more easily than ever. With the rise of torrents, sharing copyrighted material has become simultaneously easier to accomplish and harder to prevent. Also, with the Internet being largely anonymous, it has become easier for individuals to post copyrighted material to the Internet allowing others to view copyrighted material without the appropriate permissions. Copyright holders and their attorneys must stay abreast of the latest technologies in order to protect their interests. The Internet Corporation for Assigned Names and Numbers's Uniform Domain Name Dispute Resolution Policy may provide a copyright holder with a new avenue for preventing copyright infringement. The Internet Corporation for Assigned Names and Numbers (ICANN) manages domain names on the Internet in order to ensure the continued functionality and usability of the Internet.¹ ICANN provides for compulsory arbitration when a complainant asserts that a domain name is "identical or confusingly similar to a trademark or service mark," the domain name holder has "no rights or legitimate interests in respect of the domain name," and the "domain name has been registered and is being used in bad faith."²

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¹ *What Does ICANN Do?*, <http://www.icann.org/en/participate/what-icann-do.html> (last visited January 23, 2011).

² *Uniform Domain Name Dispute Resolution Policy*, <http://www.icann.org/en/udrp/udrp-policy-24oct99.htm> (last visited Jan. 23, 2011)..

II. THE ARBITRAL PROCESS & ITS APPLICATION TO COPYRIGHT INFRINGEMENT

ICANN's Domain Name Dispute Resolution Policy cannot be utilized in many of the cases where large scale distribution of copyrighted material is being distributed such as in the *torrent-finder.com* case but it does provide individuals with an expedited means of addressing more specific instances of infringement.³ In the *torrent-finder.com* case, the American government, in conjunction with ICANN, took down the domain because it was assisting Internet users in locating illegal copies of copyrighted materials.⁴ The public, using a torrent client, would then download these copies over a peer-to-peer network.⁵

In one recent decision before the National Arbitration Forum, the owners of the copyright to a television show called "One Piece" were successful in claiming ownership against Verionmedia, the domain name holder of *watch-onepiece.com*.⁶ FUNimation, the complainant in the case concerning *watch-onepiece.com*, is the licensed distributor of the television show "One Piece" and sought to have the domain name in question transferred to its control.⁷ Verionmedia, the respondent and holder of the domain name *watch-onepiece.com*, maintained a site at that address, which linked its visitors to unauthorized and infringing copies of the show hosted on other sites.⁸ In order to be successful, FUNimation had to show that all three elements; similarity, no legitimate interest, and use in bad faith; of ICANN's Domain Name Dispute Resolution Policy were violated.⁹

³ See generally Ben Sisario, *Music Web Sites Dispute Legality of Their Closing*, N.Y. TIMES (Dec. 19, 2010), <http://www.nytimes.com/2010/12/20/business/media/20music.html>.

⁴ *Id.*

⁵ *Id.*

⁶ *FUNimation Ent. v. Verion Media*, 2010 WL 4681466, National Arbitration Forum Claim No. FA1008001340440, Final Award of October 15, 2010, 8 (Richard Hill).

⁷ *Id.* at 6.

⁸ *Id.*

⁹ *Id.*

These disputes are not unique to the United States. Many international disputes are handled by the World Intellectual Property Organization (WIPO) as seen in *PRL USA Holdings, Inc. v. Huang En Aka Huanxin*.¹⁰ While this case does not directly involve copyright infringement as in the *FUNimation* case, it does help to further illustrate the required elements that must be shown in order to successfully transfer a domain name to the complainant. In *PRL*, the owner of the trademarks to Polo, Rugby, and Ralph Lauren sought to have the rights in the domain names *ralphlauren2010.com* and *rugbyspolos.com* transferred from Huang En Aka Huanxin and to *PRL*.¹¹ Respondent Huanxin was using the sites in question to direct buyers to where they could purchase items related to the trademarks in question.¹² As discussed above, *PRL* had to allege all three elements; similarity, no legitimate interest, and use in bad faith; of ICANN's Domain Name Dispute Resolution Policy.¹³

A. *Domain Name Is Identical Or Confusingly Similar To A Trademark Or Service Mark In Which The Complainant Has Rights*¹⁴

The first element required in a domain name dispute, identical or confusingly similar name, is both the most easily shown and also functions as the most restrictive in who may use this challenge. It is obvious from simple observation that the trademarked "One Piece" is present in the domain name *watch-onepiece.com*.¹⁵ Similarly, in *PRL* the similarities were obvious between the legitimate trademark and the domain names of *ralphlauren2010.com* and

¹⁰ *PRL USA Holdings, Inc. v. Huang En Aka Huanxin*, 2010 WL 4264747, WIPO Arbitration and Mediation Center Case No. D2010-1363, Final Award of October 5, 2010, 1 (Jonathan Agmon).

¹¹ *Id.* at 2.

¹² *Id.* at 6.

¹³ *Id.* at 4-6.

¹⁴ *Uniform Domain Name Dispute Resolution Policy*, *supra* note 2.

¹⁵ *FUNimation Ent. v. Verion Media*, 2010 WL 4681466, National Arbitration Forum Claim No. FA1008001340440, Final Award of October 15, 2010, 7 (Richard Hill).

rugbyspolos.com.¹⁶ Simple additions such as the word “watch” followed by a hyphen or the addition of the number “2010” is not enough to sufficiently distinguish the domains in question from the legitimate trademark or service mark interests.¹⁷

*B. No Rights Or Legitimate Interests In Respect Of The Domain Name*¹⁸

ICANN enumerates three rights or legitimate interests in its Domain Name Dispute Resolution Policy:¹⁹

- (i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
- (ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.²⁰

¹⁶ *PRL USA Holdings* at 4.

¹⁷ *FUNimation* at 7; *PRL USA Holdings* at 4.

¹⁸ *Uniform Domain Name Dispute Resolution Policy*, *supra* note 2.

¹⁹ *Id.*

²⁰ *Id.*

This list is not exhaustive but rather illustrative, as the panel may find other rights or legitimate purposes allowing for the continued operation of a questionable domain name.²¹

Respondent Verionmedia in the FUNimation case relied on previous arbitration panel rulings which held the use of a trademark as a description of a lawful business was a legitimate purpose under ICANN's Domain Name Dispute Resolution Policy.²² Although the respondent disputed it, the Panel ruled that the website watch-onepiece.com was a copyright infringement and as such could not be a bona fide use.²³ The linking to unauthorized distributions of complainant's copyrighted series was a serious enough offense to disqualify any claims of a legitimate right or interest.²⁴ The Panel in *PRL* determined that complainant PRL had established a *prima facie* case that respondent lacked legitimate rights or interests and that his failure to respond to said complaint solidified the absence of any legitimate right or interest.²⁵

C. *Domain Name Has Been Registered And Is Being Used In Bad Faith*²⁶

Like the second element, ICANN enumerates a number of ways by which a domain name can be registered and used in bad faith:²⁷

- (i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name

²¹ *Id.*

²² *FUNimation* at 7 (“MercedesShop” was used to describe a legitimate business concerning the discussion of Mercedes as well as the sale of parts and accessories).

²³ *Id.* at 8.

²⁴ *Id.*

²⁵ *PRL USA Holdings, Inc. v. Huang En Aka Huanxin*, 2010 WL 4264747, WIPO Arbitration and Mediation Center Case No. D2010-1363, Final Award of October 5, 2010, 5 (Jonathan Agmon).

²⁶ *Uniform Domain Name Dispute Resolution Policy*, *supra* note 2.

²⁷ *Id.*

registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.²⁸

Again, this list is not exhaustive but merely an illustration of some ways by which a website may be maintained in bad faith according to ICANN.²⁹

Respondent Verionmedia, by his own admissions, was operating the disputed website in bad faith.³⁰ Respondent admitted that he derived revenue from the operation of his website, that he chose the name because of its similarity and likelihood to attract users, and that his site likely diverted users from the

²⁸ *Id.*

²⁹ *Id.*

³⁰ FUNimation Ent. v. Verion Media, 2010 WL 4681466, National Arbitration Forum Claim No. FA1008001340440, Final Award of October 15, 2010, 8 (Richard Hill).

complainant's website.³¹ These admissions neatly fit into the fourth example of bad faith provided by ICANN in its Uniform Domain Name Dispute Policy.³² Respondent relied on a disclaimer contained on his webpage to mitigate his bad faith and absolve him of responsibility; however, his disclaimer was found inadequate and his bad faith remained.³³

The WIPO panel in PRL, seems to condense the policy enumerated by ICANN by holding "that attracting Internet traffic by using a domain name that is identical or confusingly similar to a registered trademark may be evidence of bad faith."³⁴ Additionally, respondent infringed on PRL's copyright, which "may amount in itself to bad faith", by including images owned by Respondent.³⁵

III. CONCLUSION

ICANN's Uniform Domain Name Dispute Policy may not be applicable to large websites that aggregate torrents so that individuals may download copyrighted files without the appropriate permissions, but, it does have a place in any tool box used to fight copyright infringement. Where large scale actions, such as the Department of Homeland Security's Immigration and Customs Enforcement's take down of torrent-finder.com, make big headlines, ICANN's policy provides for a quiet way to claim ownership of a domain name.³⁶ The biggest limitation on using ICANN's Uniform Domain Name Dispute Policy in order to thwart copyright infringement is that it is limited to domain names that are identical or confusingly similar to a registered trademark.³⁷ This is why sites such

³¹ *Id.*

³² *Uniform Domain Name Dispute Resolution Policy, supra note 2.*

³³ *FUNimation* at 8.

³⁴ PRL USA Holdings, Inc. v. Huang En Aka Huanxin, 2010 WL 4264747, WIPO Arbitration and Mediation Center Case No. D2010-1363, Final Award of October 5, 2010, 6 (Jonathan Agmon).

³⁵ *Id.*

³⁶ Ben Sisario, *supra note 3.*

³⁷ *Uniform Domain Name Dispute Resolution Policy, supra note 2.*

as watch-onepiece.com may be taken down through arbitration but larger more generic sites such as torrent-finder.com requires more drastic action; however, it must be kept in mind that this is only one of three elements that could theoretically be retired through a change in ICANN's policy.