



NYSBA Annual Meeting International Law and Practice Section

The United Nation's Impact on International Private Law, Trade and Development: WIPO Domain Names Dispute Resolution

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Debevoise & Plimpton LLP
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January 24, 2007**

Peter L. Michaelson, Esq.

- Intellectual property practitioner for 27+ years (since 1979)
 - IP practice heavily emphasizes patent matters involving electronics and software, and mechanical technologies; and trademarks
 - 1984 to present -- Michaelson and Associates; 1982-1984 -- Patent Atty., Pennie and Edmonds; 1979-1982 -- Member Legal and Patent Staff, Bell Telephone Laboratories)
- Arbitrate/mediate IT/IP/technology and other disputes for 16+ years (since 1991)
 - Member of WIPO, CPR, AAA, NAF, ICC and LCIA and various other US and foreign mediation and arbitration panels for IP/IT/commercial and other matters
 - Member of WIPO, CPR, NAF and ADNDRC (Asian Domain Name Dispute Resolution Centre) ICANN arbitration panels for domain name disputes
- Fellow and Chartered Arbitrator, Chartered Institute of Arbitrators (UK)
- Accredited Mediator – Centre for Effective Dispute Resolution (CEDR) (UK)
- Mediator/arbitrator for USDC EDNY and mediator for NJ Sup. Ct.
- Court-appointed expert in patent law for USDC DNJ
- For detailed CV, see www.mandw.com/mich.html

Domain Name System (DNS)

DNS Look-up Table

Domain Name	IP Address
www.mandw.com	71.250.232.1
www.debevoise.com
www.nysba.org
www.wipo.int

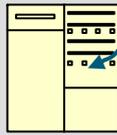
Internet

User's PC



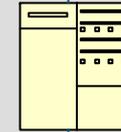
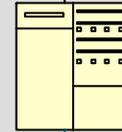
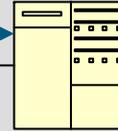
DNS Request (1)

www.mandw.com



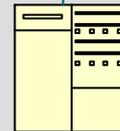
(3)

Root Server



Sub-domains

Request descends through DNS hierarchy (4)



Find?
(2)

No

Yes

71.250.232.1

Authoritative Answer (5)
(IP Addr.)

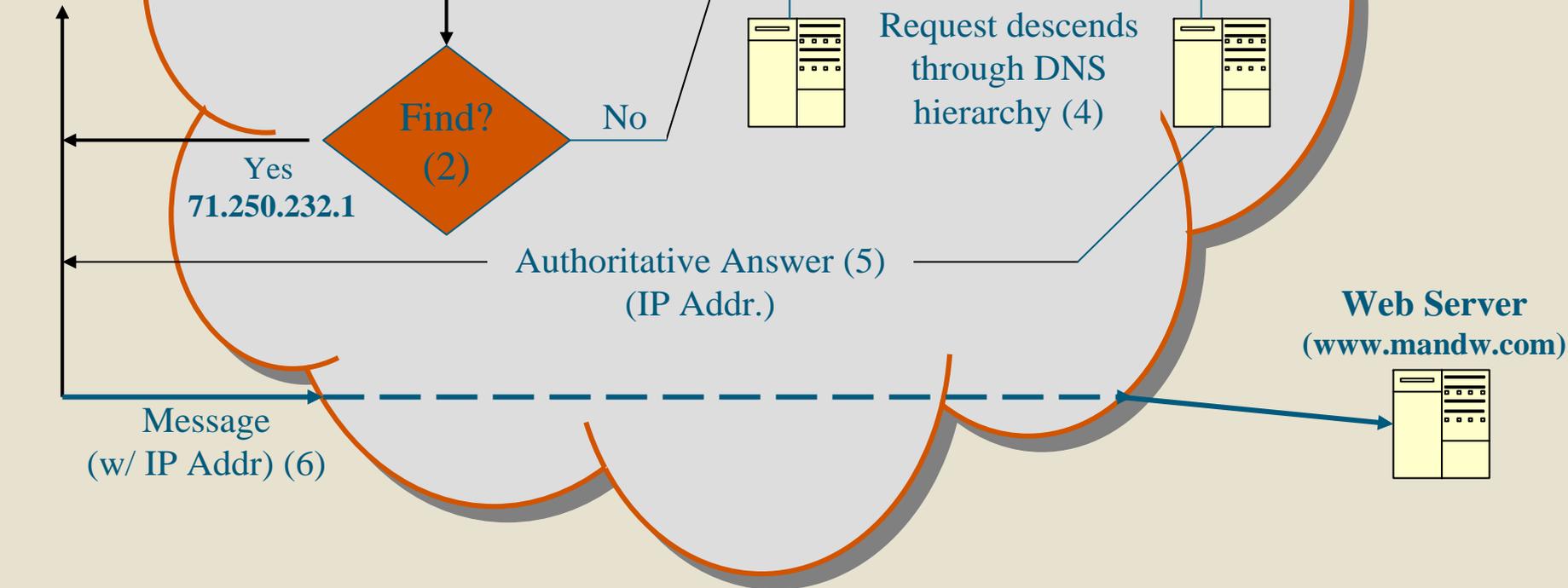
Web Server
(www.mandw.com)

(www.mandw.com)



Message
(w/ IP Addr) (6)

(w/ IP Addr) (6)





Procedure: The Complaint

Before the:

WORLD INTELLECTUAL PROPERTY ORGANIZATION
ARBITRATION AND MEDIATION CENTER

RYANAIR LIMITED

(Complainant)

-v-

MR MICHAEL COULSTON

(Respondent)

Disputed Domain Name:

<ryanaircampaign.org>

COMPLAINT

(Rules, para. 3(b))

I. Introduction

1. This Complaint is hereby submitted for decision in accordance with the Uniform Domain Name Dispute Resolution Policy (the **Policy**), approved by the Internet Corporation for Assigned Names and Numbers (**ICANN**) on October 24, 1999, the Rules for Uniform Domain Name Dispute Resolution Policy (the **Rules**), approved by ICANN on October 24, 1999 and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the **Supplemental Rules**).

II. The Parties

A. The Complainant

(Rules, para. 3(b)(ii) and (iii))

2. The Complainant in this administrative proceeding is Ryanair Limited ("Ryanair") a company incorporated and registered in Ireland on 5 June 1996 under company number 104547. The Complainant commenced

- Any person may initiate an administrative proceeding by submitting a Complaint to any Provider approved by ICANN
- The Provider reviews the Complaint for compliance with the UDRP's administrative and procedural rules

Procedure: Notification of Complaint



September 27, 2006

Re: Case No. D2006-1194
<ryanaircampaign.org>
Notification of Complaint and Commencement of Administrative Proceeding

1. **Notification.** You are hereby notified that an administrative proceeding has been commenced against you pursuant to the Uniform Domain Name Dispute Resolution Policy, approved by the Internet Corporation for Assigned Names and Numbers (ICANN) on October 24, 1999 (the *Policy*) (<http://arbitrator.wipo.int/domains/rules/>).

The Policy is incorporated by reference into your Registration Agreement with the Registrar of your domain name(s), pursuant to which you are required to submit to and participate in a mandatory administrative proceeding in the event that a third party (the *Complainant*) submits a Complaint to an ICANN-approved dispute resolution service provider (<http://www.icann.org/gdrp/approved-providers.htm>) concerning the domain name(s).

(Please note that the administrative proceeding has been commenced against the registrant of the domain name(s) that is/are the subject of the Complaint and not the technical contact, zone contact, administrative contact or billing contact, if different from the domain name registrant. The technical contact, zone contact, administrative contact or billing contact, if different from the domain name registrant, are requested to forward this notification and any attachments to the registrant of the domain name(s) in question.)

2. **Date Complaint Received.** The Complaint submitted by Ryanair Limited was received by e-mail on September 15, 2006 and in hard copy on September 20, 2006 by the WIPO Arbitration and Mediation Center (the *Center*). A document titled Complaint Deficiency Rectification amending the Complaint in response to a complaint deficiency notification was received by email on September 26, 2006 by the Center. A copy of the Complaint and the Complaint Deficiency Rectification document accompanies this notification.

- If the Complaint complies with the Rules and Policy, the Provider shall notify the Respondent of the Complaint
- Notice by email, fax and courier
- Respondent has 20 days to submit a Response

Procedure: Response

Before the

WORLD-INTELLECTUAL-PROPERTY-ORGANIZATION
ARBITRATION-AND-MEDIATION-CENTER

[NAME AND ADDRESS OF COMPLAINANT AS STATED IN COMPLAINT]	Case No.: [indicate assigned case number]
(Complainant)	
-v- [NAME AND ADDRESS OF RESPONDENT]	Disputed Domain Name(s)
(Respondent)	[<the contested domain name(s)>]

RESPONSE
(Rules, para. 5(b))

I. Introduction

[1.] On [indicate date on which the Notification of Complaint and Commencement of Administrative Proceeding was received], the Respondent received a Notification of Complaint and Commencement of Administrative Proceeding from the WIPO Arbitration and Mediation Center (the **Center**) by [e-mail/post/courier] informing the Respondent that an administrative proceeding had been commenced by the Complainant in accordance with the Uniform Domain Name Dispute Resolution Policy (the **Policy**), approved by the Internet Corporation for Assigned Names and Numbers (**ICANN**) on October 24, 1999, the Rules for Uniform Domain Name Dispute Resolution Policy (the **Rules**), approved by ICANN on October 24, 1999, and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the **Supplemental Rules**). The Center set [insert date] as the last day for the submission of a Response by the Respondent.

- Respondent can refute the factual claims and legal arguments
- WIPO offers model form for Response on its website

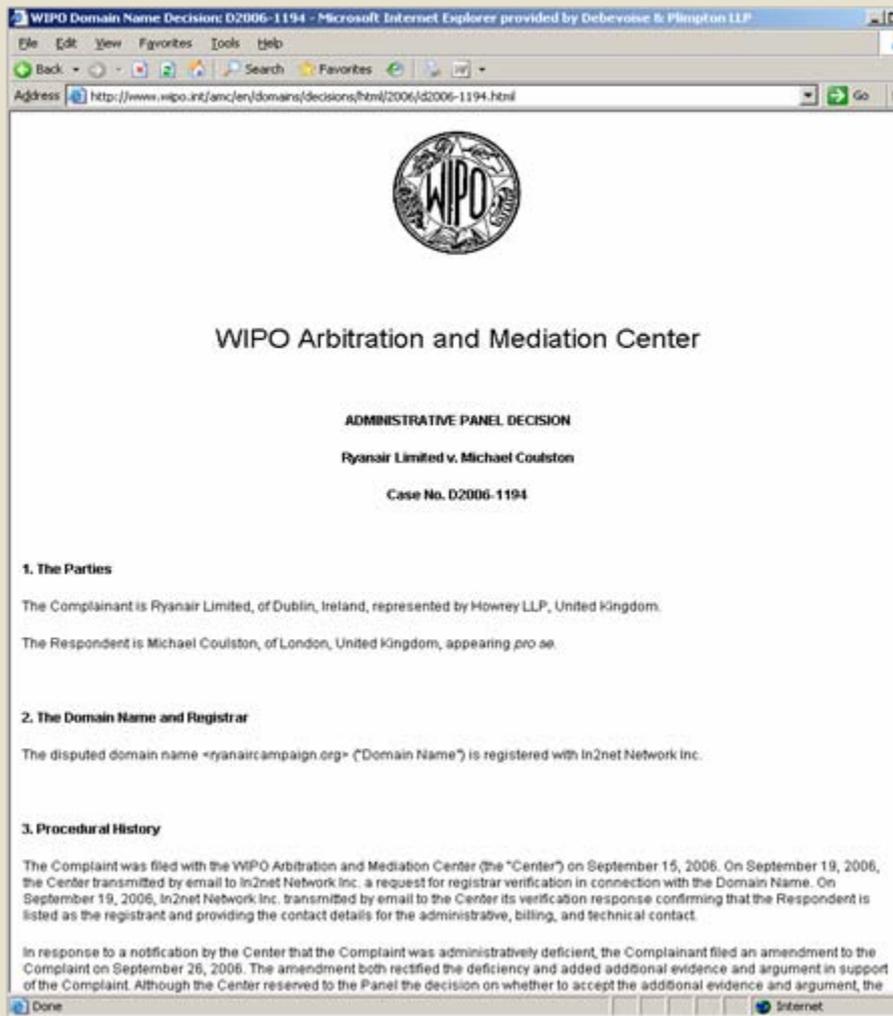


Procedure: Composition of the Panel

- Complainant Options
- Respondent Options
- Provider Responsibilities



Procedure: The Decision



- The Panel generally has 14 days to forward its decision to the Provider
- Provider communicates the decision to the parties, the Registrars, and ICANN
- Provider generally publishes the decision on its web site

Procedure: Enforcement

330 F.3d 617, *2003 U.S. App. LEXIS 10840, ***
67 U.S.P.Q.2D (BNA) 1025

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**BARCELONA.COM, INCORPORATED, Plaintiff-Appellant, v.
EXCELENTISIMO AYUNTAMIENTO DE BARCELONA, Defendant-Appellee.**

No. 02-1396

UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT

330 F.3d 617; 2003 U.S. App. LEXIS 10840; 67 U.S.P.Q.2D (BNA) 1025

February 28, 2003, Argued

June 2, 2003, Decided

Section Break (Continuous)
COUNSEL: ARGUED: Larry Zinn, San Antonio, Texas, for Appellant.

Jordan Scot Weinstein, OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C., Arlington, Virginia, for Appellee.

ON BRIEF: Jonathan Hudis, OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C., Arlington, Virginia, for Appellee.

JUDGES: Before WILKINSON, NIEMEYER, and MOTZ, Circuit Judges. Judge Niemeyer wrote the opinion, in which Judge Wilkinson and Judge Motz joined.

OPINION BY NIEMEYER:

OPINION: *619 NIEMEYER, Circuit Judge:

Barcelona.com, Inc. ("Bcom, Inc."), a Delaware corporation, commenced this action under the Anticybersquatting Consumer Protection Act against Excelesntisimo Ayuntamiento de Barcelona (the City Council of Barcelona, Spain) for a declaratory judgment that Bcom, Inc.'s registration and use of the domain name barcelona.com is not unlawful under the Lanham Act (Chapter 22 of Title 15 of the United States Code). The district court concluded that Bcom, Inc.'s use of barcelona.com was confusingly similar to Spanish trademarks owned *622 by the City Council that include the word "Barcelona." Also finding bad faith on the basis that Bcom, Inc. had attempted to sell the barcelona.com domain name to the City Council for a profit, the court ordered the transfer of the domain name to the City Council.

Because the district court applied Spanish law rather than United States law and based its transfer order, in part, on a counterclaim that the City Council never filed, we reverse the judgment of the district court denying

Bcom, Inc. relief under *620 the Anticybersquatting Consumer Protection Act, vacate its memorandum opinion and its order to transfer the domain name barcelona.com to the City Council, and remand for further proceedings consistent with this opinion.

In 1996, Mr. Joan Noguera Cobo ("Noguera"), a Spanish citizen, registered the domain name barcelona.com in the name of his wife, also a Spanish citizen, with the domain registrar, Network Solutions, Inc., in Herndon, Virginia. In the application for registration of the domain name, Noguera listed himself as the administrative contact. When Noguera met Mr. Shahab Hanif, a British citizen, in June 1999, they developed a business plan to turn barcelona.com into *623 a tourist portal for the Barcelona, Spain, region. A few months later they formed Bcom, Inc. under Delaware law to own barcelona.com and to run the website, and Noguera, his wife, and Hanif became Bcom, Inc.'s officers. Bcom, Inc. was formed as an American company in part because Noguera believed that doing so would facilitate obtaining financing for the development of the website. Although Bcom, Inc. maintains a New York mailing address, it has no employees in the United States, does not own or lease office space in the United States, and does not have a telephone listing in the United States. Its computer server is in Spain.

Shortly after Noguera registered the domain name barcelona.com in 1996, he placed some Barcelona-related information on the site. The site offered commercial services such as domain registry and web hosting, but did not offer much due to the lack of financing. Before developing the business plan with Hanif, Noguera used a web form on the City Council's official website to e-mail the mayor of Barcelona, Spain, proposing to "negotiate" with the City Council for its acquisition of the domain name barcelona.com, but Noguera received no response. And even after *624

- Registrar waits 10 days
- If no challenge, Registrar transfers or cancels domain name, as ordered by Panel
- If either party files suit in appropriate court, Registrar suspends action pending court order or decision

Elements of a Claim



- Domain name is identical or confusingly similar to a trademark in which the complainant has rights.
- Respondent has no rights or legitimate interests in the domain name.
- Respondent registered and used the domain name in bad faith.



Trademark Rights

Int. Cl.: 32

Prior U.S. Cls.: 45, 46 and 48

United States Patent and Trademark Office

Reg. No. 2,974,987

Registered July 26, 2005

**TRADEMARK
PRINCIPAL REGISTER**

VITAMINWATER

ENERGY BRANDS, INC. (NEW YORK CORPORATION)
17-20 WHITESTONE EXPRESSWAY
WHITESTONE, NY 11357

FIRST USE 3-12-1999; IN COMMERCE 3-12-1999.

SEC. 2(F).

FOR: VITAMIN ENHANCED FLAVORED
DRINKING WATER, IN CLASS 32 (U.S. CLS. 45, 46
AND 48).

SER. NO. 75-734,223, FILED 6-23-1999.

CYNTHIA SLOAN, EXAMINING ATTORNEY

- Federally registered marks enjoy prima facie evidence of validity
- Complainants must prove trademark rights in common law marks
 - Use in commerce
 - Secondary meaning for descriptive marks



Trademark Rights

www.scubadiving.biz

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The advertisement features a central image of a diver in a blue and green wetsuit swimming in clear blue water with many small orange fish. To the left, a yellow circular bubble contains the text 'Respond Now & Get This FREE GIFT!'. Above the diver, a small magazine cover titled 'Dive Like a PRO' is shown, featuring a diver and the text '200 Tips & Techniques'. To the right, two larger magazine covers are displayed. The first cover is titled 'WORLD'S Lushest Dive Sites' and features a large orange butterflyfish. The second cover is titled 'World's Best Diving for Beginners' and features a diver and the text 'HOW TO TAKE YOUR DIVE TO THE NEXT LEVEL'. The background of the advertisement is a gradient from white at the top to blue at the bottom.



Identical or Confusingly Similar



www.NHLCoolShots.com



www.ElectronicBotique.com



www.Oxygen.com



www.BunsAndNoble.com



Identical or Confusingly Similar

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[*Click on the picture to enter*](#)

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#2. You stumbled upon our site. Please understand that this is a site of opinions. Not all stories can be verified for truthfulness. A considerable amount of content on this site is from other web sites from around the world.

#3. You work for Wal*Mart and you are trying to kiss your manager's butt.



Wal Mart in Bangor, Maine, Store #1956 207-047-6264



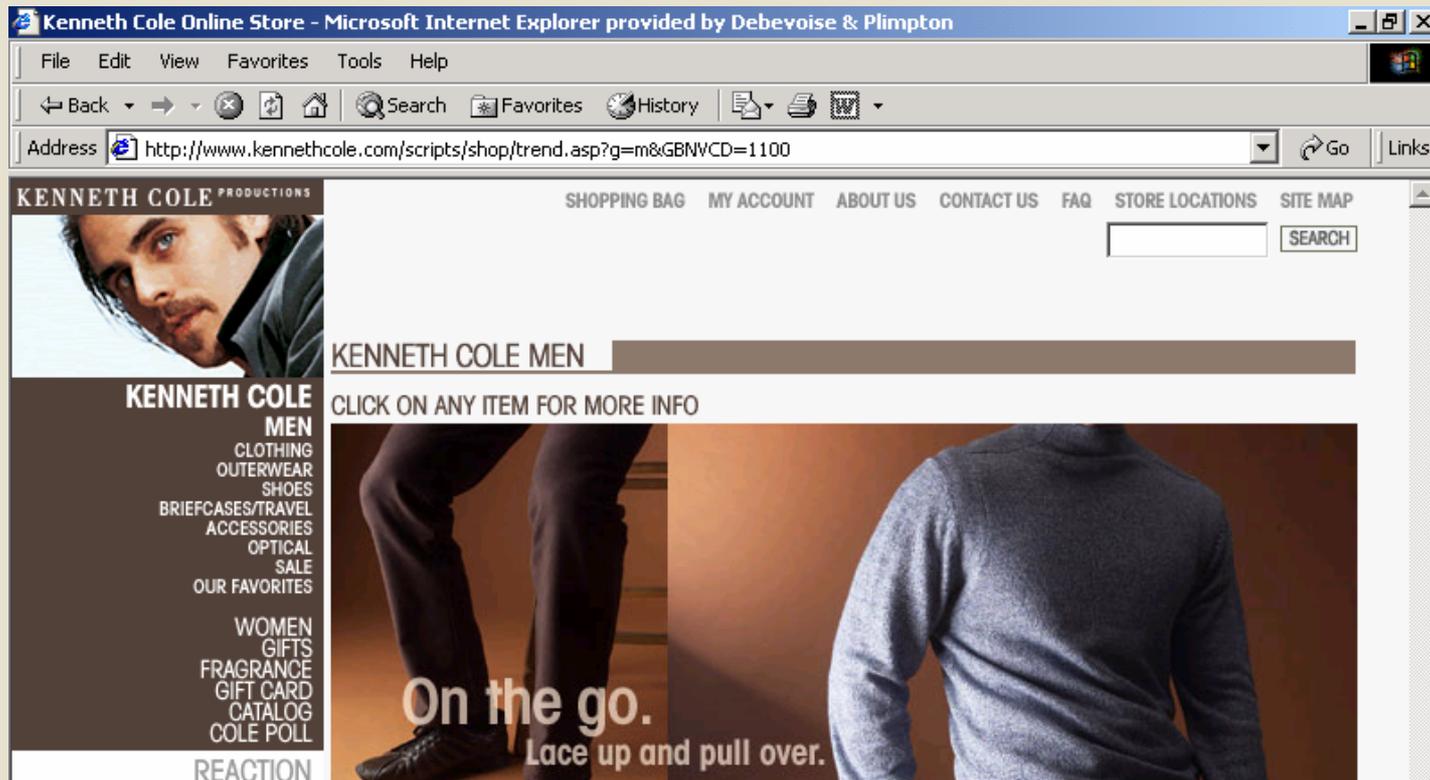
Legitimate Interest

- 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.
- 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.
- 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.



Legitimate Interest

www.KennethCole.biz





Legitimate Interest

www.scholastics.com

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Chess for Life

Is it simply a game like Monopoly? Or Checkers? The answer to this question has only recently been fully searched out -- and the results are astounding.

When a Pennsylvania school board approved a 5-year study on the effects of children learning chess, they were most likely not prepared for the breakthrough results they would achieve. The study was conducted on 7th and 8th graders and included other enrichment activities like Dungeons and Dragons, problem solving with computers, creative writing, and independent study.

At the end of the study, students regularly engaged in chess classes showed a whopping 17.3% improvement on school test results. This compared with only 4.56% for the other activities. This led the Watson-Glaser Thinking Appraisal, the organization monitoring the results of the

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Legitimate Interest

www.RyanairCampaign.org

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Grenoble Lyon £0.01	Carcassonne £0.01
Knock-IrelandWest £0.01	Dinard £0.01
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Valencia £0.01	Salzburg £0.01
Zaragoza(Pyrenees) £0.01	Shannon £0.01

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Ryanair Campaign

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This Web site does not offer advice or seek to elicit money.

It gives only individual observations and experiences relating to Ryanair, which may be of interest to other passengers who have afforded it.

Ryanair and similar companies which concentrate on booking via the Internet have made air travel across Europe available to many passengers who have afforded it.

But there is an element of Russian Roulette. There is a good chance that you will get very cheaply to where you want to go with no passengers can find themselves in a situation where they are left helpless and/or have to pay a lot of money. Ryanair is often solely responsible for creating such a situation.

Latest News

Ryanair's Domain Name Complaint Denied

The World Intellectual Property Organisation (WIPO) has denied Ryanair's complaint about the registration of this domain name (ryanaircampaign.org). We now have a new page commenting on the domain name situation.

Ryanair Forced to Make Changes to Terms and Conditions

Thank you to everyone who offered to contribute to the Sky News report on the item about the Office of Fair Trading's complaint. Click on the recorded news story.

Ask Your MP to Help Get Parliament to Debate the Difficulty of Contacting Companies Like Ryanair

Please write to your MP asking them to support Sharon Hodgson's [Early Day Motion 2643](#). If enough MPs sign this motion, it could be easy to fax your MP via <http://www.writetothem.com>.

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Bad Faith



- Offer to sell domain name to trademark owner or competitor
- Prevent trademark owner from using mark in domain name (if Respondent has a pattern of such misconduct)
- Disrupt competitor's business
- Attract Internet users through confusion for commercial gain



Bad Faith





Bad Faith

[http:// www.SandsOfTheCaribbean.com](http://www.SandsOfTheCaribbean.com)



WIPO Overview of UDRP Decisions

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Activities & Services

WIPO Overview of WIPO Panel Views on Selected UDRP Questions

Decision-making authority under the Uniform Domain Name Dispute Resolution Policy and Rules (UDRP) lies exclusively with the appointed panels. To assist awareness of their views on certain questions that commonly arise in proceedings under the UDRP, the WIPO Arbitration and Mediation Center has produced the following informal overview of panel positions on key procedural and substantial issues. Decision references supporting each line of opinion are included, with over 100 decisions from over 80 different UDRP panelists listed.

While some of the listed issues arise only infrequently, all of them are, or are perceived to be, relevant to the operation of the UDRP. On most of these issues, consensus or clear majority views have developed. Certain other questions continue to attract a diversity of views. The Center's identification of questions and evaluation of opinions is based on the 7,000 UDRP cases it has administered through February 2005. **Broad information on all views is available from the Center's online Legal Index of WIPO UDRP Panel Decisions (<http://arbiter.wipo.int/domains/search>), as well as from the full posting of all decisions (<http://arbiter.wipo.int/domains/decisions>).**

This overview is created in recognition of the need that has been expressed to identify, as much as possible, consensus among UDRP decisions, so as to maximize the consistency of the UDRP system. It should be understood that, with UDRP decisions covering a multitude of facts and arguments, genuine differences of opinion may be difficult to avoid on particular issues, all the more so where panelists and parties come from a multitude of jurisdictions. However, it is hoped that this update on the UDRP experience will be found helpful by identifying views expressed by panels and providing decisions which help to put those views in context.

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Questions?



NYSBA Annual Meeting International Law and Practice Section

The United Nation's Impact on International Private Law, Trade and Development: WIPO Domain Names Dispute Resolution

**David H. Bernstein
Debevoise & Plimpton LLP**

**Peter L. Michaelson
Michaelson & Associates**

January 24, 2007