

GIGALAW'S

DOMAIN DISPUTE DIGEST

FOURTH QUARTER, 2023

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FOREWORD

A Decade of Record-Setting Domain Name Disputes

The number of domain name dispute filings has now risen for 10 consecutive years, as providers for cases under the Uniform Domain Name Dispute Resolution Policy (UDRP) report ongoing enforcement efforts by trademark owners against cybersquatters.

WIPO, the leading UDRP service provider, said that in 2023, “[c]ases filed covered nearly every industry, with the top sectors being banking and finance, biotechnology and pharmaceuticals, Internet and IT, and retail.” WIPO added that trademark owners from the United States, France, and the United Kingdom “represented the top filing country locations.”

In addition, as the charts in this issue of GigaLaw’s Domain Dispute Digest make clear ([p. 8](#)), trademark owners from other industries – such as social media, tobacco, clothing and footwear – also account for a large number of filings.

WIPO has reported that its caseload (which includes decisions under a number of ccTLD policies in addition to the UDRP) has risen 68 percent since the onset of the COVID-19 pandemic. I suspect this represents both an increase in cybersquatting activity as well as a stronger focus among trademark owners on the importance of online brand enforcement.

The fourth quarter of 2023 saw a decision in the largest UDRP case of the year, involving a complaint filed by shoe manufacturer and retailer C. & J. Clark International from the UK, which resulted in a

decision ordering the transfer of 430 domain names. By comparison, the next largest case of the year, filed by casino company Cube, also from the UK, involved “only” 169 domain names in a decision in the first quarter of 2023.

Such large UDRP complaints are increasingly uncommon (and don’t approach the scale of the largest complaint in history – which I filed on behalf of Inter-Continental Hotels in 2009, resulting in the transfer of 1,519 domain names). That’s primarily because the popularity of privacy and proxy services, followed in 2018 by the European Union’s General Data Protection Regulation (GDPR), have made it more difficult for trademark owners to identify large portfolios of domain names held by cybersquatters.

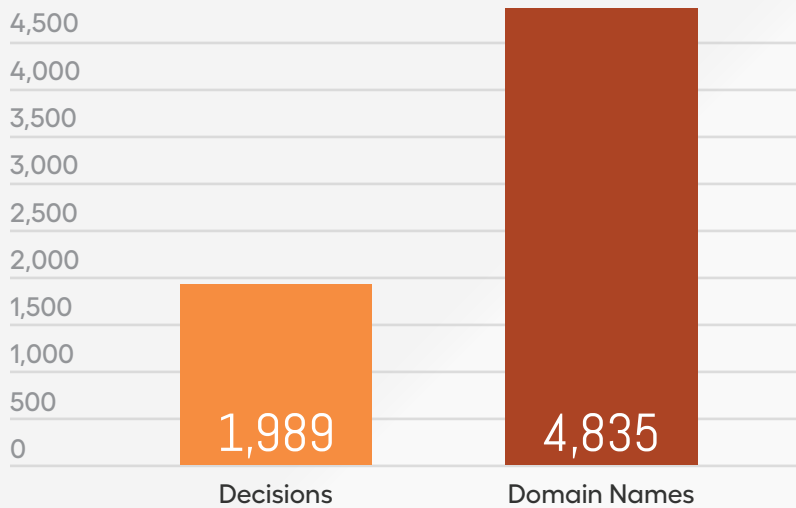
Indeed, as a new chart in the Digest shows ([p. 5](#)), more than 84 percent of all UDRP cases involve only a single domain name, and fewer than 1 percent include more than 10 domain names. This large number of small complaints partially explains the rise in filings, which may be frustrating for trademark owners but, fortunately, has no adverse impact on the importance of the UDRP, which resulted in a transfer rate in the last quarter of more than 95 percent ([p. 5](#)).

Doug Isenberg

Attorney and Founder of GigaLaw
Doug@Giga.Law



Number of UDRP Decisions and Domain Names



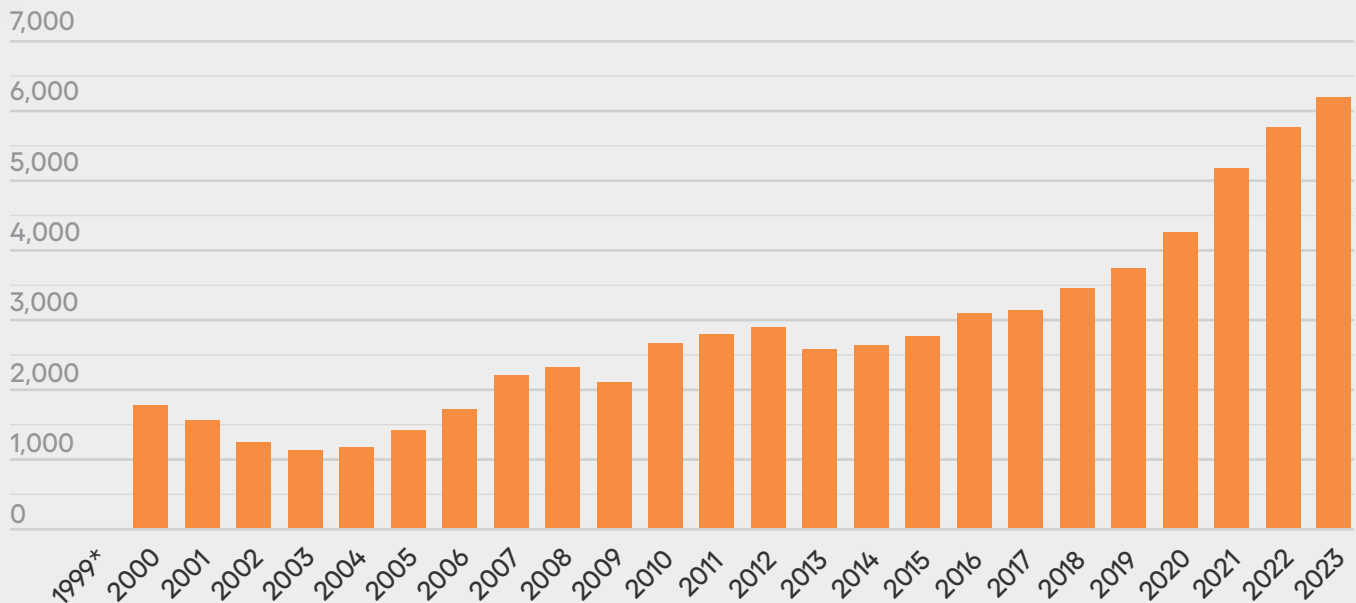
+1.38%

UDRP Decisions v. Q4 2022

+49.18%

UDRP Domain Names v. Q4 2022

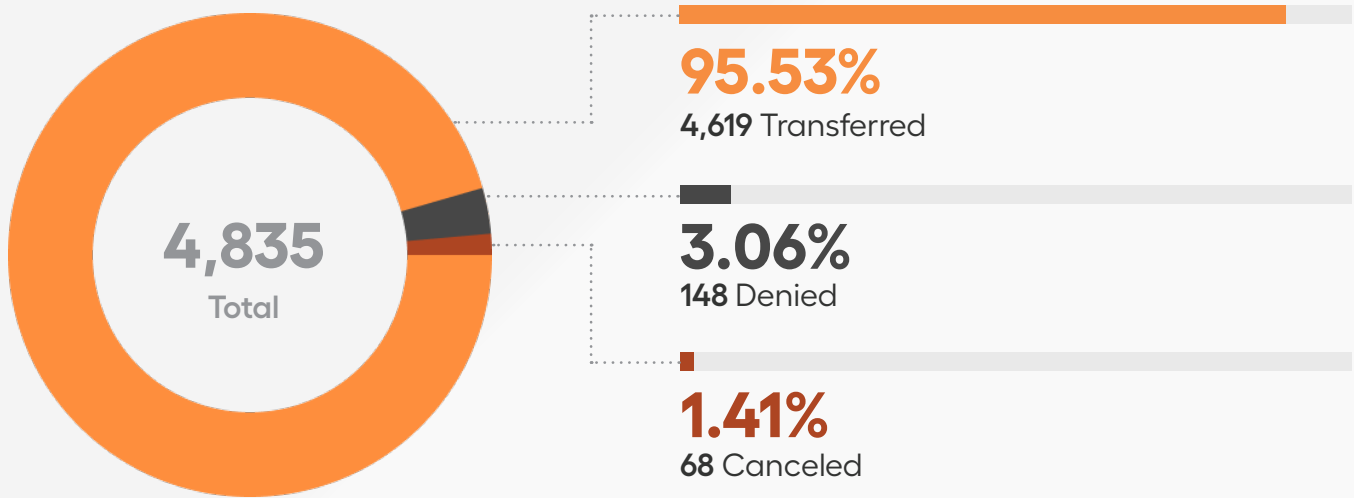
WIPO Domain Name Cases by Year



* One case was filed in 1999

Data on this graph includes all domain name dispute policies administered by WIPO, including cases outside of the UDRP, such as ccTLD-specific policies.

UDRP Outcome



UDRP Case Size

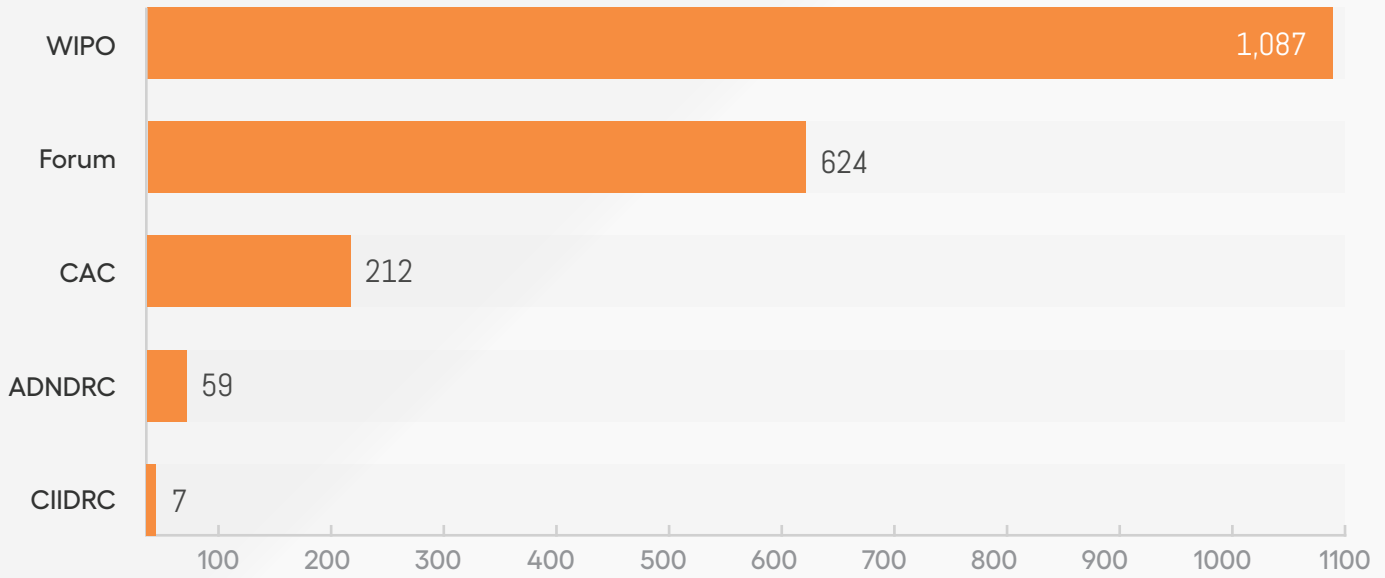
No. of Domain Names	1	2	3	4	5	6	7	8	9	10+
No. of Cases	1,675	133	46	25	18	8	13	10	0	61

Largest UDRP Cases

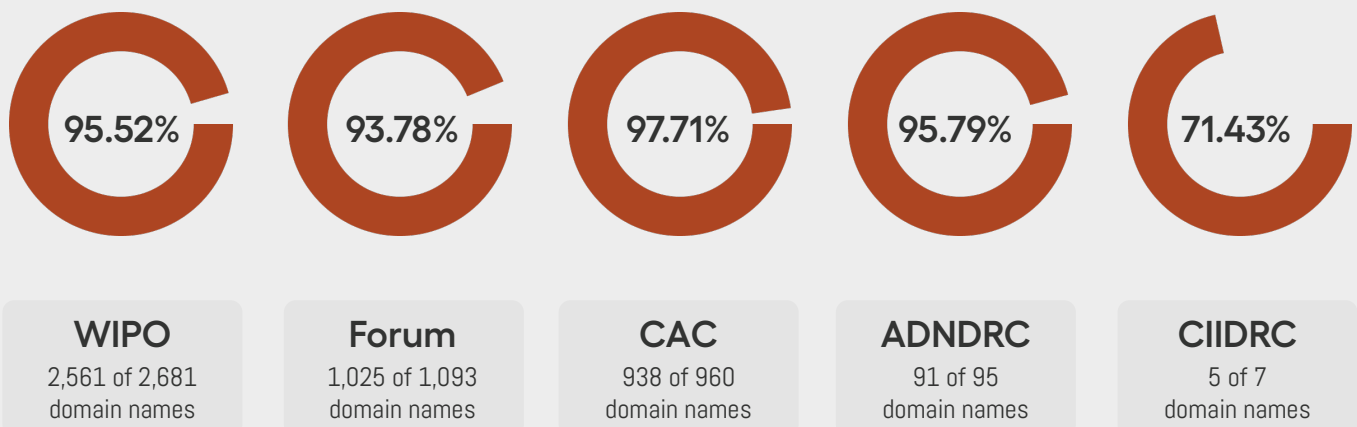
Complainant	Case No.	No. of Domains
C. & J. Clark	D2023-2969	430
Tory Burch	D2023-2690	106
Radisson	FA2310002068364	88
Tecnica Group	CAC-UDRP-105792	88
Fast Retailing	CAC-UDRP-105760	87
Marshall	CAC-UDRP-105793	86
Tommy Hilfiger	CAC-UDRP-105810	83
Loro Piana	CAC-UDRP-105776	73
Moscot	FA2310002065233	63
Athleta, Banana Republic, GAP	CAC-UDRP-105823	57
Aime Leon	D2023-4628	44

Complainant	Case No.	No. of Domains
Babolat	D2023-3362	42
Tod's	CAC-UDRP-105956	41
Calvin Klein	D2023-4071	41
Z&V	D2023-3663	40
Omega and Swatch	D2023-3271	39
Skechers	FA2310002067213	39
Daniel Wellington	D2023-4015	38
Yonex	CAC-UDRP-105833	36
Nudie Jeans	D2023-4365	36
Valentino	D2023-4096	36

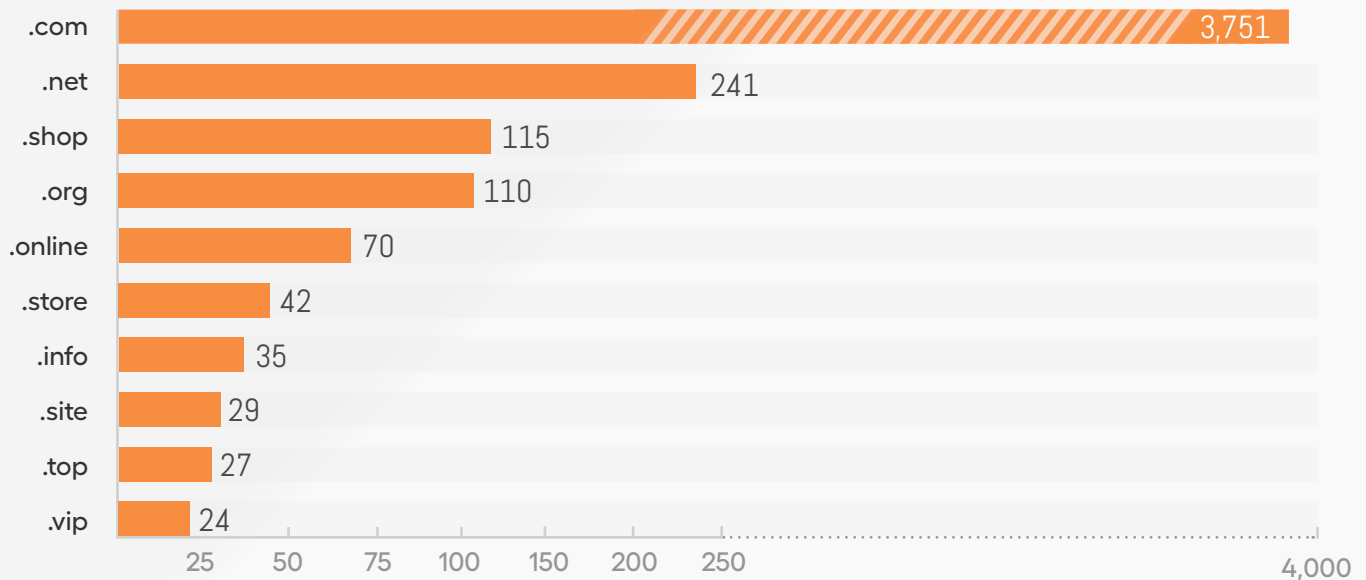
Number of UDRP Decisions by Provider



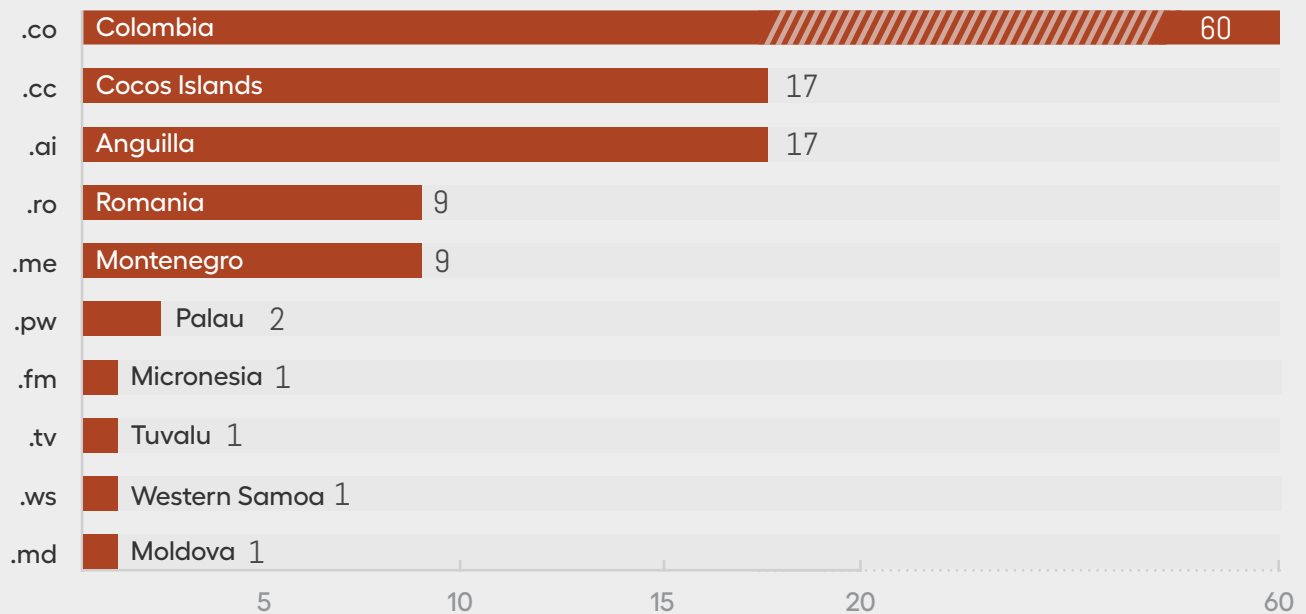
Transfer Rate by Provider



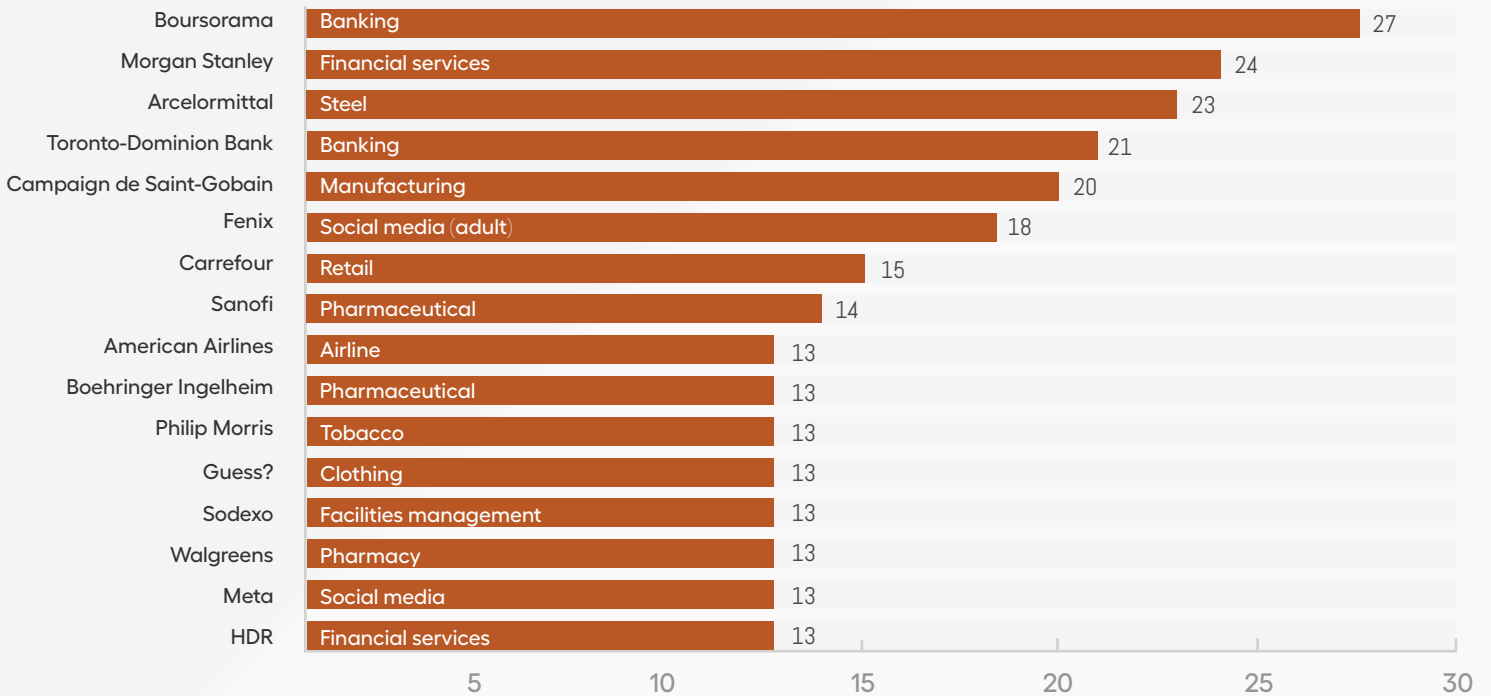
Most Common gTLDs in UDRP Cases



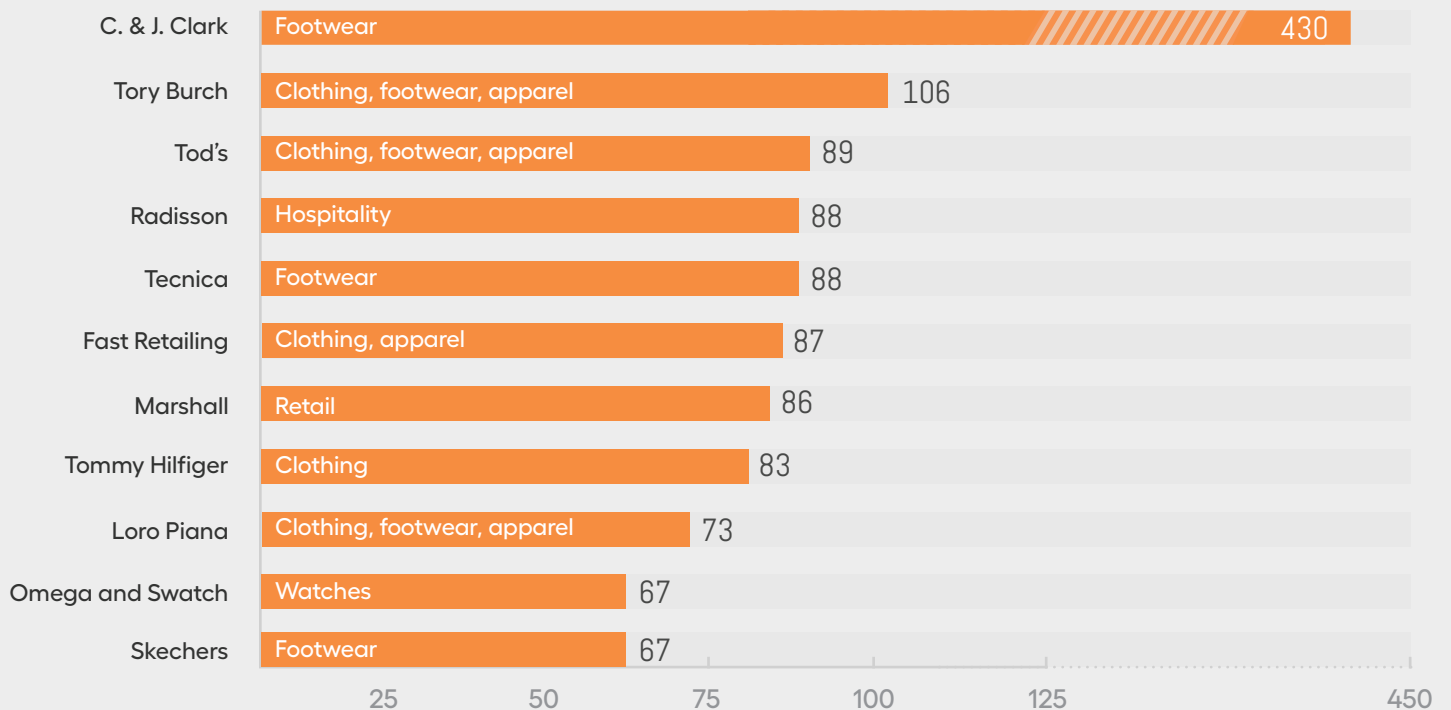
Most Common ccTLDs in UDRP Cases



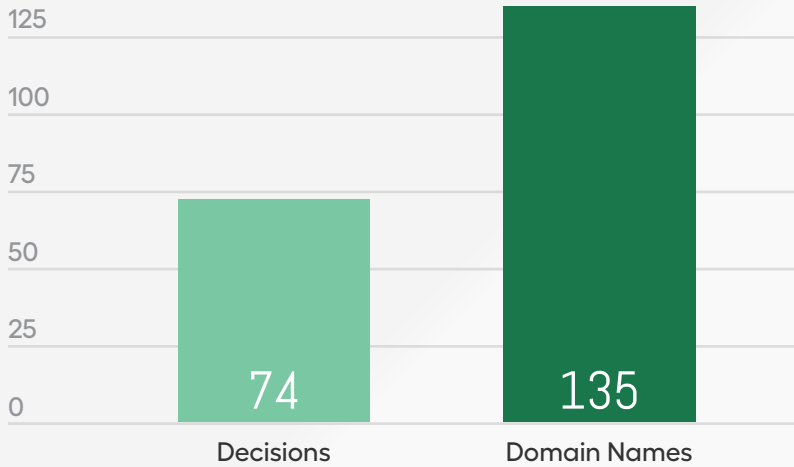
Most Active Trademark Owners (UDRP Cases)



Most Active Trademark Owners (Domain Names in UDRP)



Number of URS Decisions and Domain Names



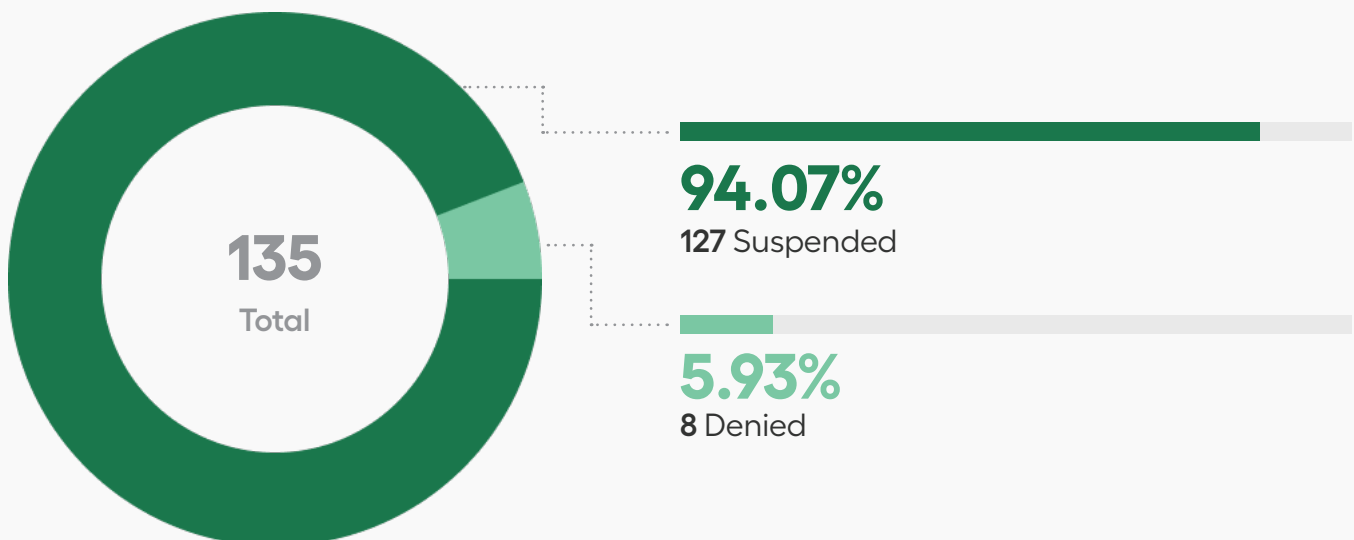
+89.74%
URS Decisions v. Q4 2022

+221.43%
URS Domain Names v. Q4 2022

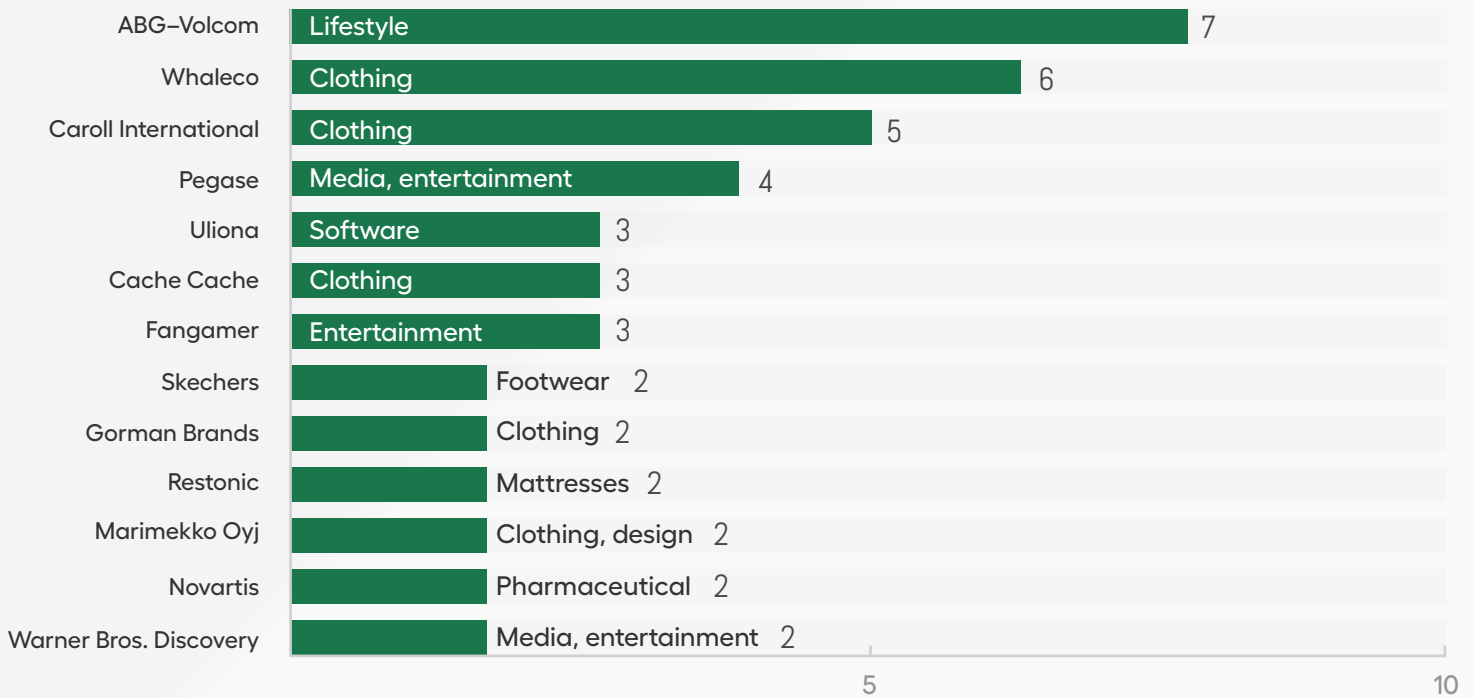
URS or UDRP?

Although the Uniform Rapid Suspension System (URS) is less expensive and usually faster than the UDRP, it remains unpopular because it does not apply to .com domain names, it only allows for the temporary suspension (not transfer) of domain names, and it has a higher burden of proof than the UDRP. Given the relatively few cases that are filed, data for any quarter is of limited value.

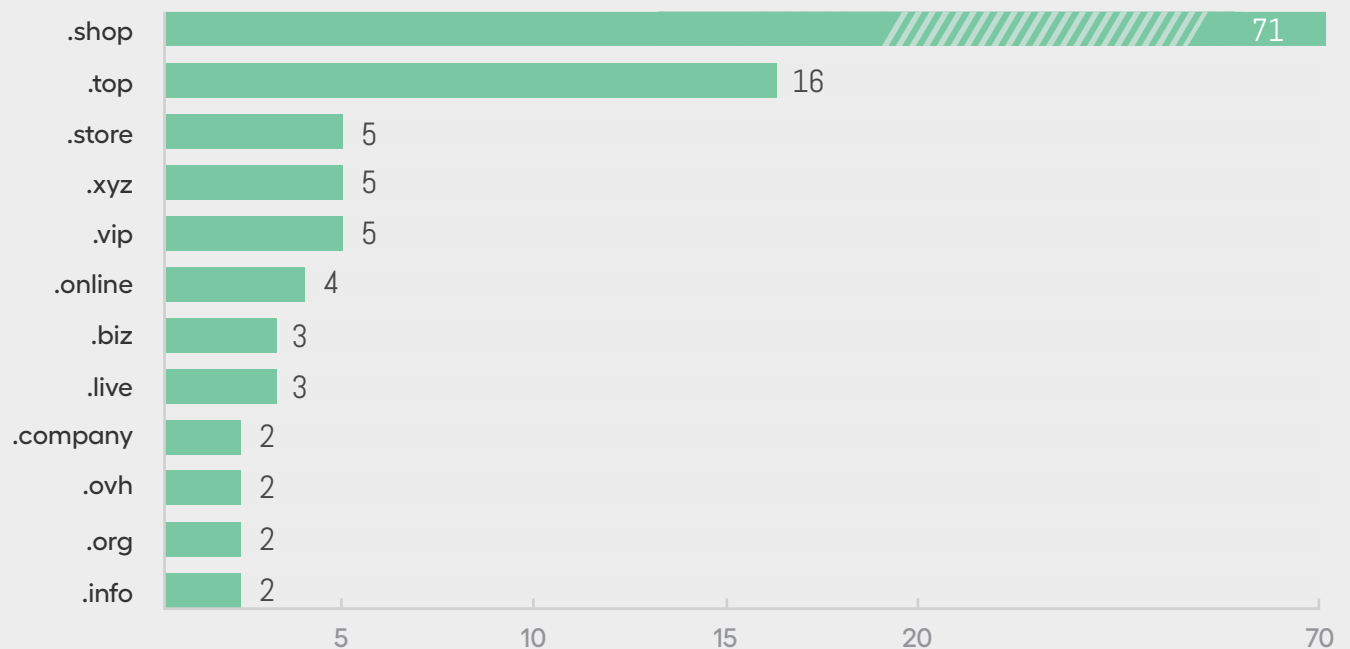
URS Outcome



Most Active Trademark Owners (URS Cases)



Most Common gTLDs (URS Cases)



SPOTLIGHT

Doug Isenberg to Host Two ‘Table Topics’ at INTA Annual Meeting

Meet Doug Isenberg at the annual meeting of the International Trademark Association (INTA) in Atlanta in May as he hosts two table topics on domain name disputes.

Doug is hosting the following table topics on Wednesday, May 22, 2024:

► **“Why are UDRP Complaints Skyrocketing?”**
(8 a.m.): Cases under the UDRP have been on the rise for the past 10 years, thanks to an increase in cybersquatting activity, expansion of the number of top-level domains, the rise of privacy services and the EU’s GDPR, and increased awareness of the UDRP and its effectiveness. This table topic will discuss how trademark owners can prioritize their cybersquatting problems under the UDRP and utilize the policy to its full potential while also considering alternatives such as demand letters, take-down notices, the seldom-used URS, and other options.

► **“Common Filing Mistakes Under the UDRP”**
(1 p.m.): Drafting a cybersquatting complaint under the UDRP may seem easy, but the process can be complicated – both substantively and procedurally. Even sophisticated trademark owners make mistakes, such as citing inapplicable national trademark law, failing to properly argue all three parts of the UDRP’s test, not recognizing the requirement for both bad faith registration as well as bad faith use, failing to cite previous decisions and other relevant authority, avoiding the inclusion of relevant evidence, and submitting unsupported supplemental filings. This

table topic will discuss how to avoid these common mistakes, and much more.

For more information about the INTA annual meeting, visit www.inta.org/events/2024-annual-meeting, and contact Doug directly for questions about his table topics described above.

If you are attending the INTA annual meeting in Atlanta, please let Doug know in advance, to coordinate meetings. Atlanta is not only home to some of the greatest brands in the world, it is also home to The GigaLaw Firm, so Doug looks forward to meeting clients, other trademark owners, and like-minded professionals in his hometown known as “Hotlanta,” “the city too busy to hate,” and the “Hollywood of the South!”



INTA is a not-for-profit global association of brand owners and professionals. Its annual meeting is the world’s largest gathering of trademark practitioners, corporate counsel, and brand owners, attracting thousands of registrants.

Glossary

ADNDRC

The Asian Domain Name Dispute Resolution Centre, an ICANN-approved provider of UDRP services, has four operating offices: the Hong Kong International Arbitration Centre (HKIAC), the Korea Internet Address Dispute Resolution Committee (KIDRC), the China International Economic and Trade Arbitration Commission (CEITAC), and the Asian International Arbitration Centre (AIAC).

Business Email Compromise

A business email compromise (BEC) scam is a type of phishing activity that attempts to get someone to divulge confidential company information or send payment for a fraudulent invoice or to an inaccurate account. Like phishing in general, BEC scams rely on cybersquatting to trick their targets into taking action.

CAC

The Czech Arbitration Court, an ICANN-approved provider of UDRP services, is based in Prague and also provides services for .eu disputes.

ccTLD

A country-code top-level domain (ccTLD) refers to a TLD used by a specific country, such as .us for the United States. All ccTLDs consist of only two letters and may be subject to various domain name dispute policies. Of the 316 ccTLDs, about 44 participate in the UDRP, while some others have adopted different dispute policies, and some have no dispute policies at all.

CIIDRC

The Canadian International Internet Dispute Resolution Centre, an ICANN-approved provider of UDRP services, is based in Vancouver and is the newest UDRP service provider. CIIDRC also provides services for .ca disputes.

Complainant

A complainant in the context of a domain name dispute, such as the UDRP, refers to a trademark owner who files a complaint against a domain name registrant or cybersquatter, seeking transfer, cancellation or (in the case of a URS proceeding) suspension of a domain name.

Cybersquatting

"Cybersquatting" is a term that describes the registration and/or use of a domain name that is identical or confusingly similar to someone else's trademark, without permission. The word surely is an extension of the legal definition of "squatter," which apparently was first used in 1788 to describe "one that settles on property without right or title or payment of rent." One of the earliest judicial references to "cybersquatting" is in a 1998 opinion from the U.S. District Court for the Central District of California. Cybersquatting often prompts trademark owners to file complaints under domain name dispute policies such as the UDRP to seek transfer of one or more disputed domain names.

Domain Name

A domain name refers to a top-level domain (TLD) plus, at least, a second-level domain. For example, "example.com" is a domain name.

Domaining

"Domaining" is a term that is loosely used to describe the business of trafficking in domain names. While some domaining activity is illegal and may violate dispute policies such as the UDRP, other domaining activity – such as the registration of domain names that are not identical or confusingly similar to preexisting trademarks or the use of domain names in ways that are unrelated to trademarks – may be legal and appropriate.

Forum

Formerly known as the National Arbitration Forum, the Forum is an ICANN-approved provider of UDRP services based in Minneapolis, Minnesota (USA). The Forum also provides services under the URS; for the .us ccTLD; and for certain registry-specific dispute policies.

gTLD

A generic or global top-level domain (gTLD) refers to a TLD that is not assigned to a specific country (a ccTLD) or reserved for use and sponsored by specific types of entities. Popular gTLDs include .com, .net and .org.

ICANN

The Internet Corporation for Assigned Names and Numbers, formed in 1998, is a nonprofit public benefit corporation that manages the domain name system, including many domain name dispute policies (especially the UDRP) and the programs for creation of new gTLDs. ICANN's mission is "to help ensure a stable, secure, and unified global Internet."

MFSD

Described as an "independent private Italian alternative dispute resolution center with focus on IP issues," MFSD is an ICANN-approved provider of URS services and also handles disputes for the .it ccTLD.

New gTLD

A "new" generic or global top-level domain (gTLD) refers to a domain name created following ICANN's expansion of the domain name system that resulted from an application process in 2012. More than 1,000 new gTLDs were delegated by ICANN in the years since applications were opened, resulting in relatively popular new gTLDs such as .xyz, .online and .top – as well as more obscure new gTLDs such as .pharmacy, .dad and .kitchen. Some of the new gTLDs are restricted and are referred to as "branded domains" managed by trademark owners, such as .apple, .xbox and .marriott.

Panel

A panel refers to the person(s) who are assigned to review a file in a domain name dispute case, such as a UDRP proceeding, and issue a decision, including whether to transfer the domain name to the complainant or allow it to remain with the respondent. In UDRP cases, a panel consists of one or three people, depending on the elections made by the parties.

Phishing

The U.S. Federal Trade Commission (FTC) defines phishing as "a type of online scam that targets consumers by sending them an e-mail that appears to be from a well-known source – an internet service provider, a bank, or a mortgage company, for example." Most phishing scams rely on cybersquatting to trick their targets into providing personal identifying information.

PPC

A pay-per-click (PPC) web page contains targeted advertisements (typically consisting exclusively or primarily of text and relating to the domain name used by the website) in which the advertiser pays a fee based on the number of times Internet users click on a link in the advertisement.

Registrant

A domain name registrant, or simply a registrant, is the holder of a domain name registration (such as <example.com>) and is typically referred to in a domain name dispute proceeding as the respondent.

Registrar

A registrar is a company engaged in the business of offering domain name registrations, typically pursuant to an agreement with ICANN. Popular retail registrars (which offer registrations to the public) include GoDaddy, Namecheap, Tucows and Network Solutions.

Registry

A registry operator, or simply a registry, is an entity responsible for management of a TLD. Every TLD is associated with a single registry, which in turn typically contracts with registrars that offer domain name registrations to the public. For example, VeriSign Global Registry Services is the registry operator for .com and .net.

Respondent

A respondent in the context of a domain name dispute, such as the UDRP, refers to a domain name registrant against whom a trademark owner files a complaint.

Second-Level Domain

A second-level domain (SLD) refers to that portion of a domain name immediately to the left of a TLD, and is often the portion of a domain name that is registered by a registrant. For example, in the domain name <example.com>, “example” is the second-level domain.

Sponsored TLD

A sponsored top-level domain (TLD) is reserved for use by specific entities that meet defined criteria, such as .int for certain intergovernmental organizations; .gov for U.S.-based government organizations; and .edu for U.S.-based postsecondary institutions.

TLD

A top-level domain (TLD) refers to the rightmost characters in a domain name, such as .com. For example, in the domain name <example.com>, “.com” is the TLD. Every TLD is managed by a single registry operator and is subject to certain policies, such as those for resolving domain name disputes.

Typosquatting

“Typosquatting” is a type of cybersquatting that describes the registration and/or use of a domain name that contains a typographical variation of a trademark, such as by omitting or adding a character or transposing one or more characters, usually for the purpose of creating a likelihood of confusion.

UDRP

The Uniform Domain Name Dispute Resolution Policy (UDRP) is the popular domain name dispute policy adopted by ICANN in 1999, pursuant to which trademark owners file complaints against registrants or cybersquatters seeking the transfer or cancellation of a domain name. A successful UDRP complaint requires a complainant to prevail on all elements of a three-part test.

URS

The Uniform Rapid Suspension System (URS) is a domain name dispute policy created as an alternative to the UDRP when ICANN engaged in expansion of the domain name system that led to new gTLDs. However, unlike the UDRP, the URS does not apply to .com domain names, and trademark owners can only seek the temporary suspension – not transfer – of a disputed domain name. Because of these limitations and its high burden of proof, the URS, unlike the UDRP, has not proven popular.

WIPO

The World Intellectual Property Organization’s Arbitration and Mediation Center is the largest of the ICANN-approved UDRP service providers and helped create the UDRP. Based in Geneva, WIPO is a self-funding agency of the United Nations, with 193 member states. In addition to the UDRP, WIPO provides services for about 40 ccTLD dispute policies.

WIPO Overview

The WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (more informally known as the “WIPO Overview”) is a document created by WIPO that purports to “summarize consensus panel views on a range of common and important substantive and procedural issues” under the UDRP. The document contains references to many relevant UDRP decisions and is often cited by complainants, respondents and panels in UDRP proceedings.

About Domain Name Disputes and GigaLaw

This report focuses primarily on the Uniform Domain Name Dispute Resolution Policy (UDRP), the ICANN policy that provides trademark owners with an inexpensive and quick legal process to combat cybersquatting. It applies to .com and all of the global or generic top-level domains (gTLDs),

as well as about 44 country-code top-level domains (ccTLDs). This report also includes data on the Uniform Rapid Suspension System (URS), a more limited policy that primarily addresses only disputes in the new gTLDs (.aaa to .zuerich) created in recent years.



Doug Isenberg (left), founder of GigaLaw and one of the world’s most active domain name attorneys, frequently represents trademark owners under the UDRP, the URS and ccTLD-specific policies. He filed the largest UDRP complaint ever, for more than 1,500 domain names, in 2009. He also serves as a domain name panelist for most of the UDRP service providers, including the World Intellectual Property Organization (WIPO) and the Forum. The World Trademark Review has said that Doug is “a whiz on all things to do with Internet law and domain names.”

For more information, visit www.Giga.Law or email Doug@Giga.Law

This issue of GigaLaw’s Domain Dispute Digest includes UDRP data from WIPO, the Forum, CAC, ADNDRC and CIIDRC; and URS data from the Forum and MFSD. Analyzed data is for decisions from October 1 – December 31, 2023, unless otherwise noted. The current Digest attempts to capture UDRP decisions dated but not published in the quarter, which may differ from the analysis applied in previous issues of the Digest. This report is for general informational purposes only, provides only a summary of specific issues, and is not intended to be and should not be relied upon as legal advice regarding any specific situation. This report is not intended to create, and does not constitute, an attorney-client relationship. Readers should consult with legal counsel to determine how laws, policies or decisions and other topics discussed in this report apply to the readers’ specific circumstances. This report may be considered attorney advertising under court rules of certain jurisdictions.

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