

GIGALAW'S

DOMAIN DISPUTE DIGEST

FIRST QUARTER, 2023

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FOREWORD

A More Complete Picture of Domain Name Disputes

This issue of GigaLaw's Domain Dispute Digest expands on previous issues in an important way.

Data on the total number of decisions under the Uniform Domain Name Dispute Resolution Policy (UDRP) includes cases from all of the active UDRP service providers. In the past, some issues did not include a small number of cases from some offices within the Asian Domain Name Dispute Resolution Centre (ADNDRC), which includes locations in Hong Kong, Seoul, Beijing and Kuala Lumpur.

As a result, it's interesting to note that (as the chart on page 4 shows), WIPO and the Forum accounted for the bulk of all UDRP decisions in the first quarter of 2023, at about 61 percent and 28 percent, respectively. I suspect this has been true for a long time.

(As has been the case recently, the Arab Center for Domain Name Dispute Resolution (ACDR) appears not to have reported any UDRP decisions in the quarter. The most recent ACDR decision seems to be from November 2021.)

Despite the lopsided caseload, the outcome across the UDRP service providers appears to be consistent, with transfer decisions in most cases ranging from about 94 to 98 percent. (The CIIDRC

outcome is slightly lower, but its small caseload – only seven decisions – means that a single denial had an undue impact on the result.)

Any trademark owner can choose to file a UDRP complaint with any of the UDRP service providers – regardless of where they, or the alleged cybersquatters, are located. Why some trademark owners choose certain providers can sometimes be difficult to understand, because all of the UDRP service providers apply the same policy and the same rules. Although each provider has adopted its own set of supplemental rules, the substantive differences are not significant. And although the filing fees vary, costs are certainly not the only consideration in deciding whether – and where – to fight cybersquatters.

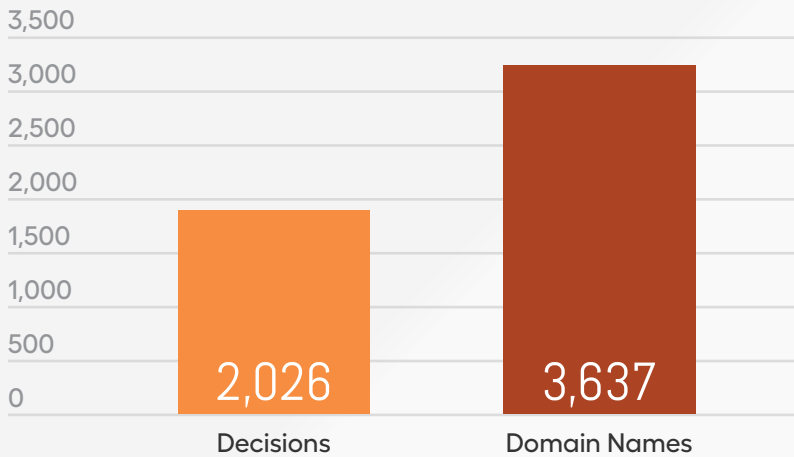
Finally, note that the Digest only reports on UDRP cases that result in decisions. Since many disputes are settled or terminated, the actual number of UDRP complaints filed by trademark owners is much higher.

Doug Isenberg

Attorney and Founder of GigaLaw
Doug@Giga.Law



Number of UDRP Decisions and Domain Names



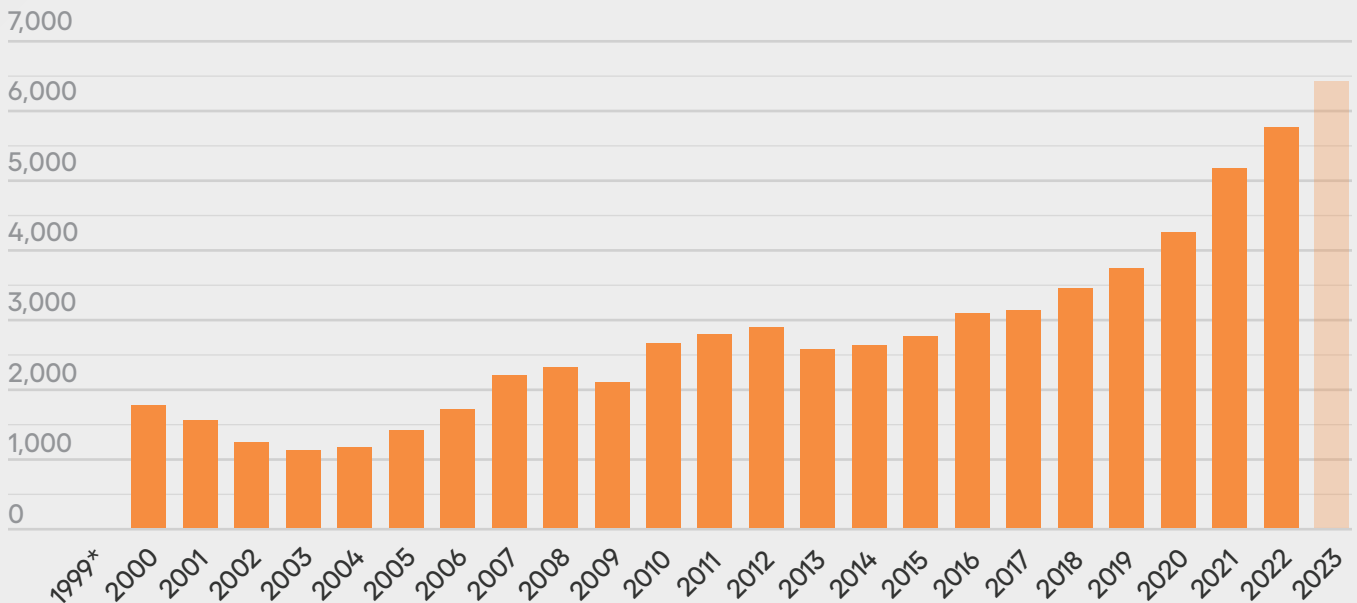
+18.7%

UDRP Decisions v. Q1 2022

+11.6%

UDRP Domain Names v. Q1 2022

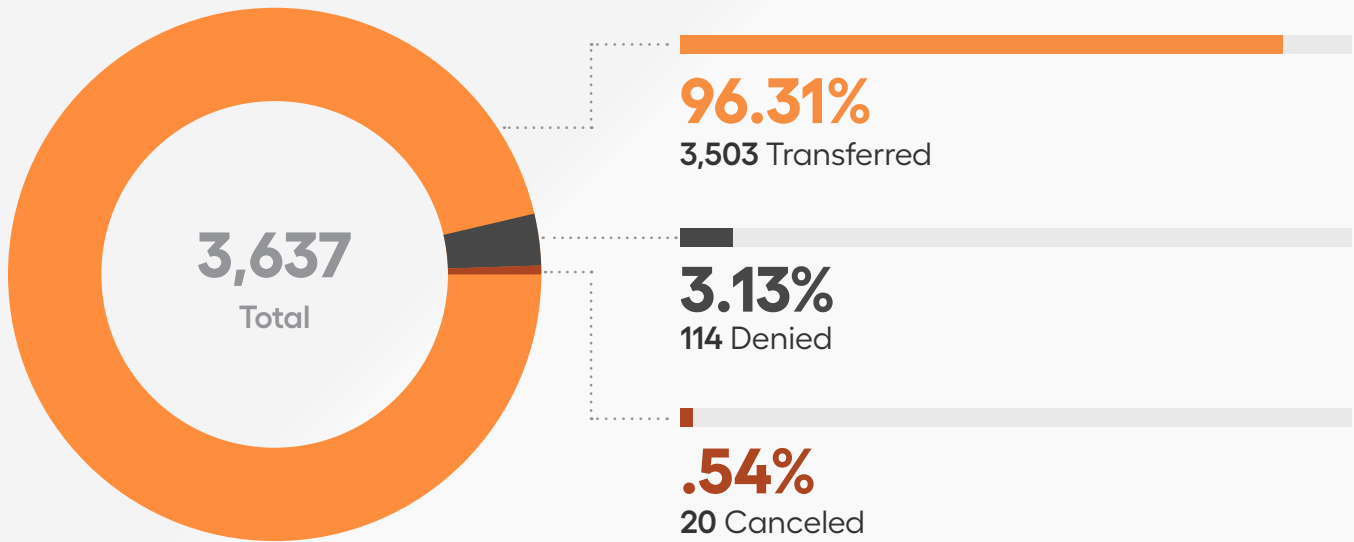
WIPO Domain Name Cases by Year



* One case was filed in 1999 Estimate for 2023

Data on this graph includes all domain name dispute policies administered by WIPO, including cases outside of the UDRP, such as ccTLD-specific policies. Estimate of 2023 cases is based on data as of April 17, 2023.

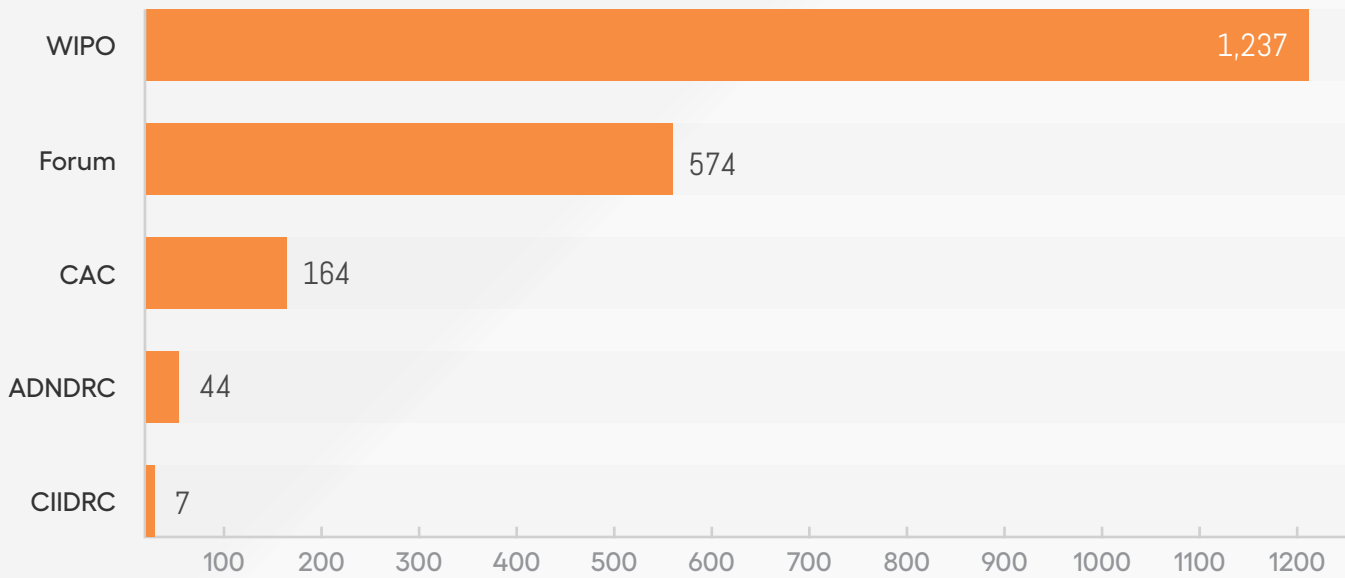
UDRP Outcome



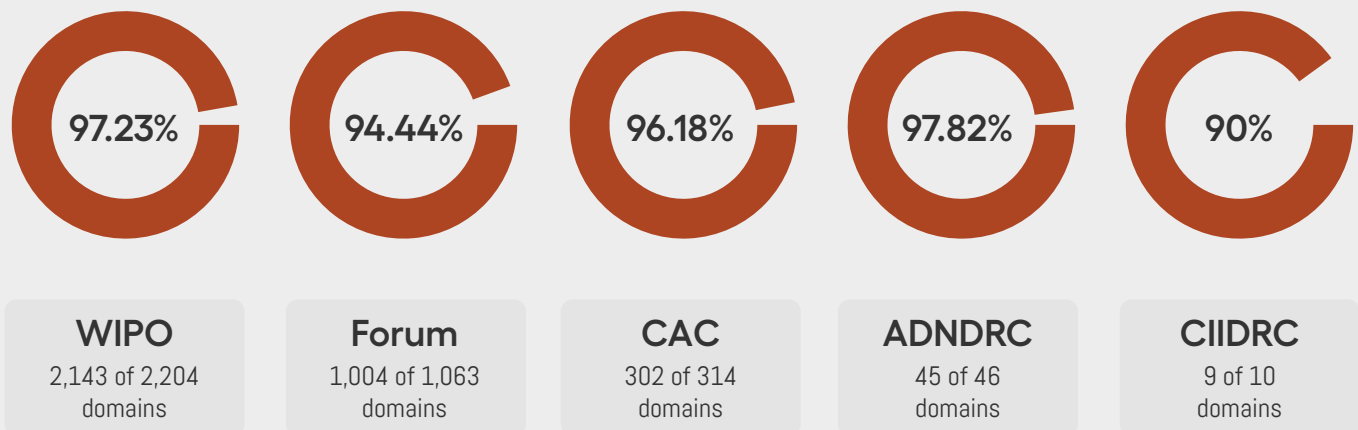
Largest UDRP Cases

Complainant	Case No.	No. of Domains	Complainant	Case No.	No. of Domains
Cube	WIPO D2022-5023	169	Jemella	WIPO D2022-4552	28
Wolverine	Forum 2025167	98	Skechers	Forum 2033528	26
Middleby	WIPO DC02022-0099	60	Meta Platforms	WIPO D2022-4374	26
Longchamp	WIPO D2023-0022	56	Entain	CAC 105051	25
Early Warning Svcs	WIPO D2022-4480	44	Skechers	Forum 2033375	21
Fiorucci	WIPO D2022-4839	36	Caterpillar	Forum 2029779	20
Cube	WIPO D2022-4941	32	Caterpillar	Forum 2031793	20
Prada	WIPO D2022-4776	32	Artemis	WIPO D2022-4398	18
Lamborghini	CAC 105048	30	Caterpillar	Forum 2024293	18
Nike	CAC 105109	30	Decathlon	WIPO D2022-5021	17

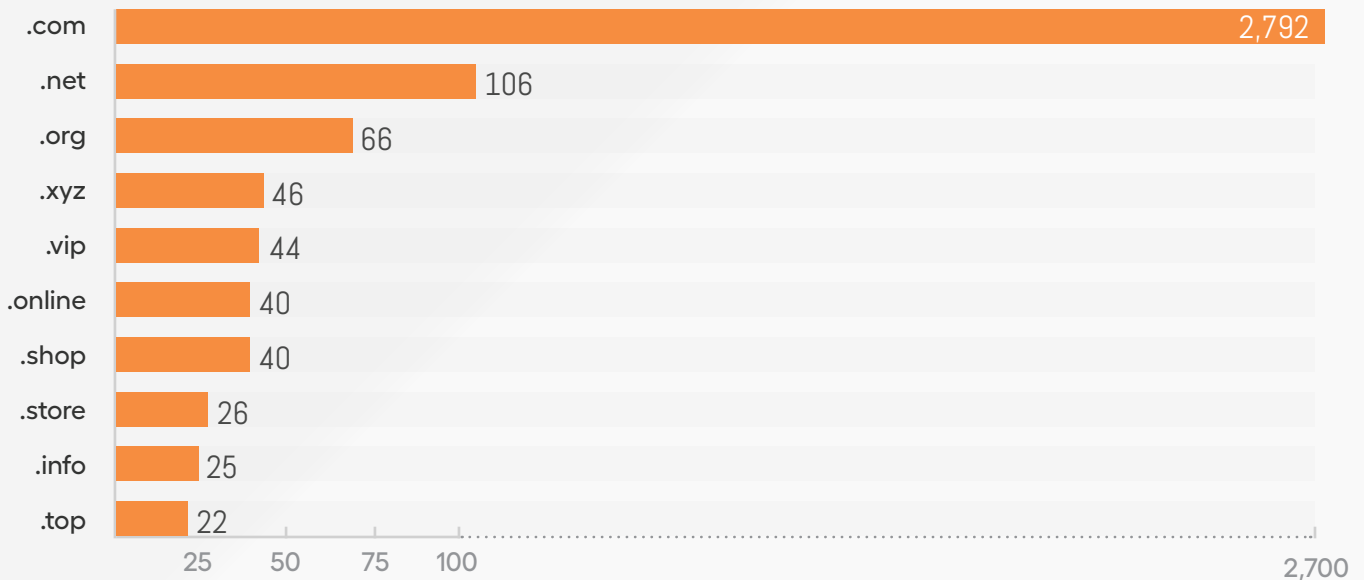
Number of UDRP Decisions by Provider



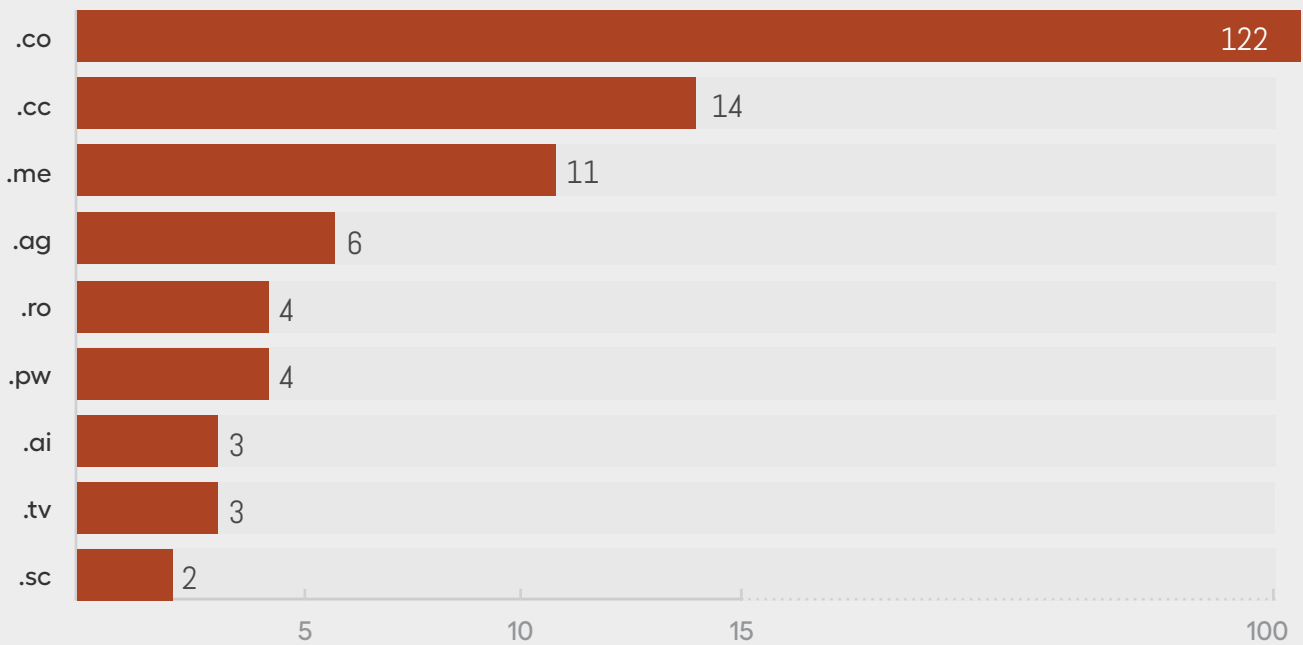
Transfer Rate by Provider



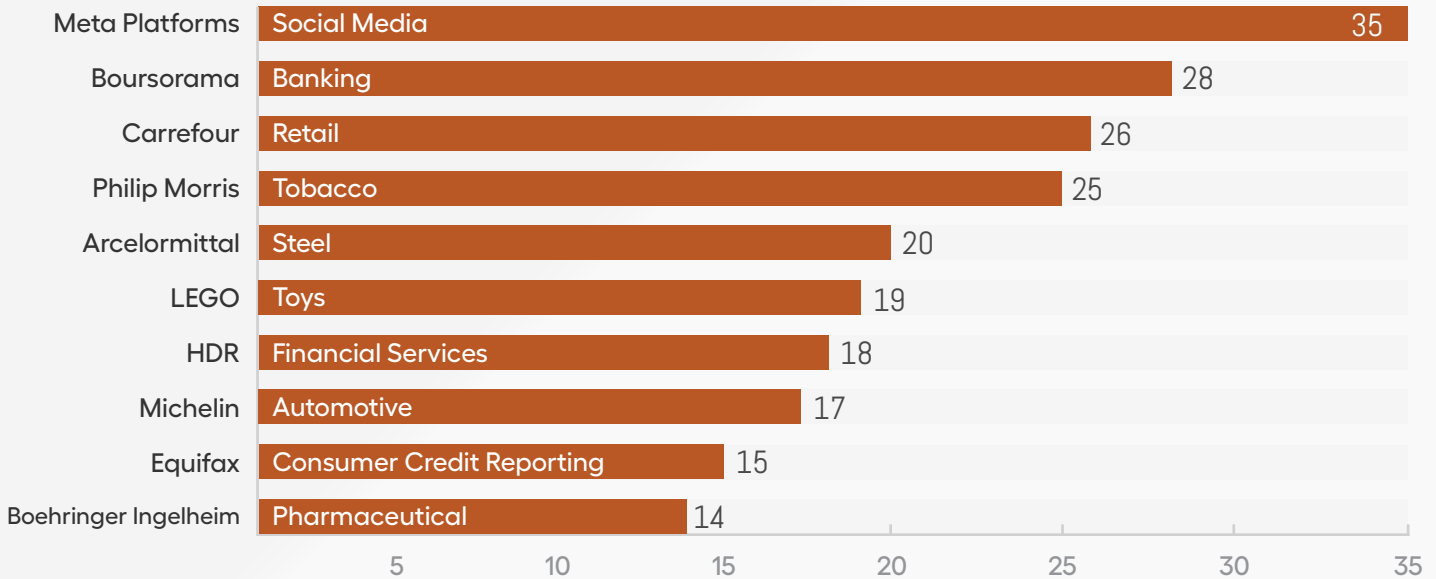
Most Common gTLDs in UDRP Cases



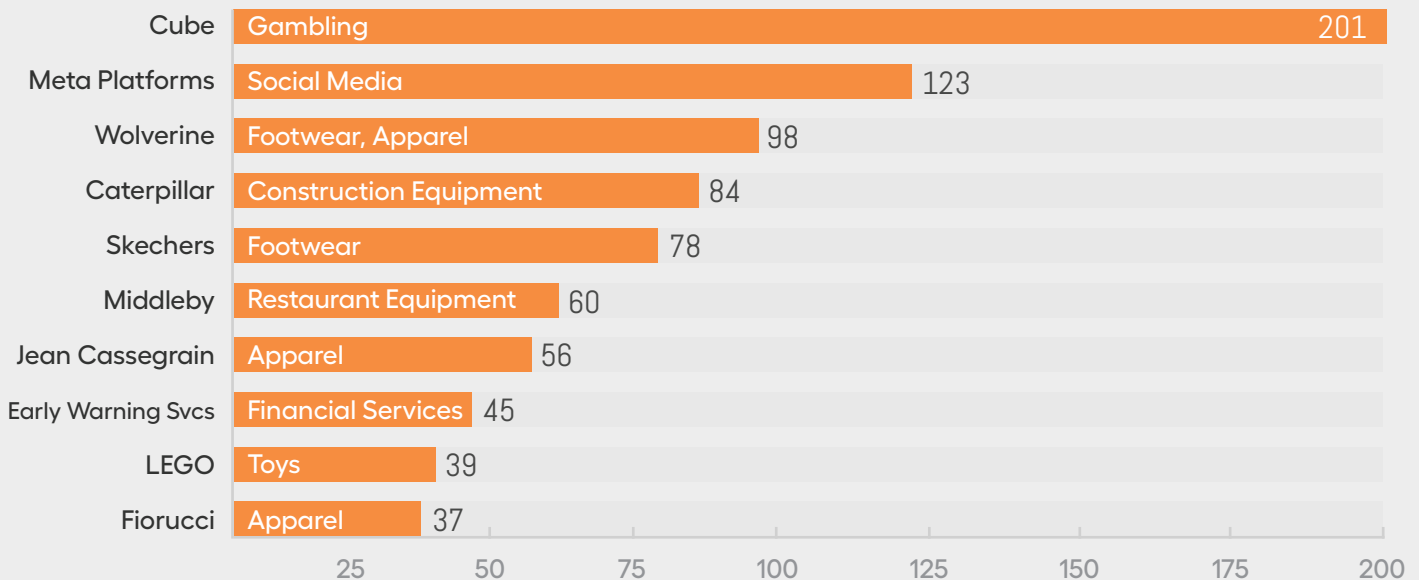
Most Common ccTLDs in UDRP Cases



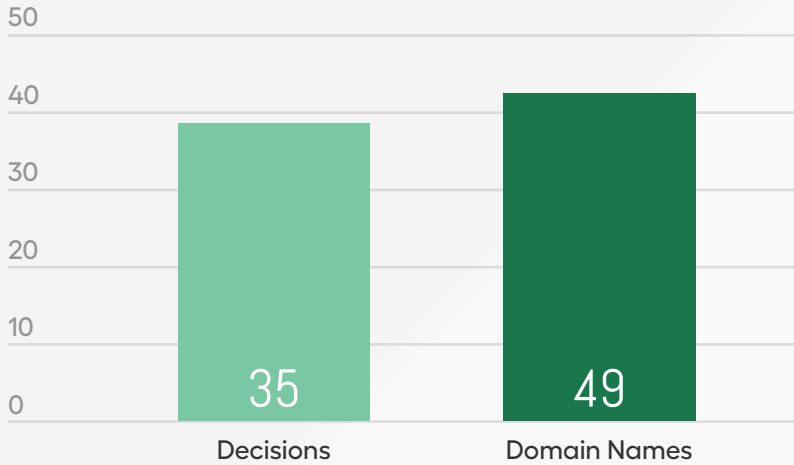
Most Active Trademark Owners (UDRP Cases)



Most Active Trademark Owners (Domain Names in UDRP)



Number of URS Decisions and Domain Names



-2.78%

URS Decisions v. Q1 2022

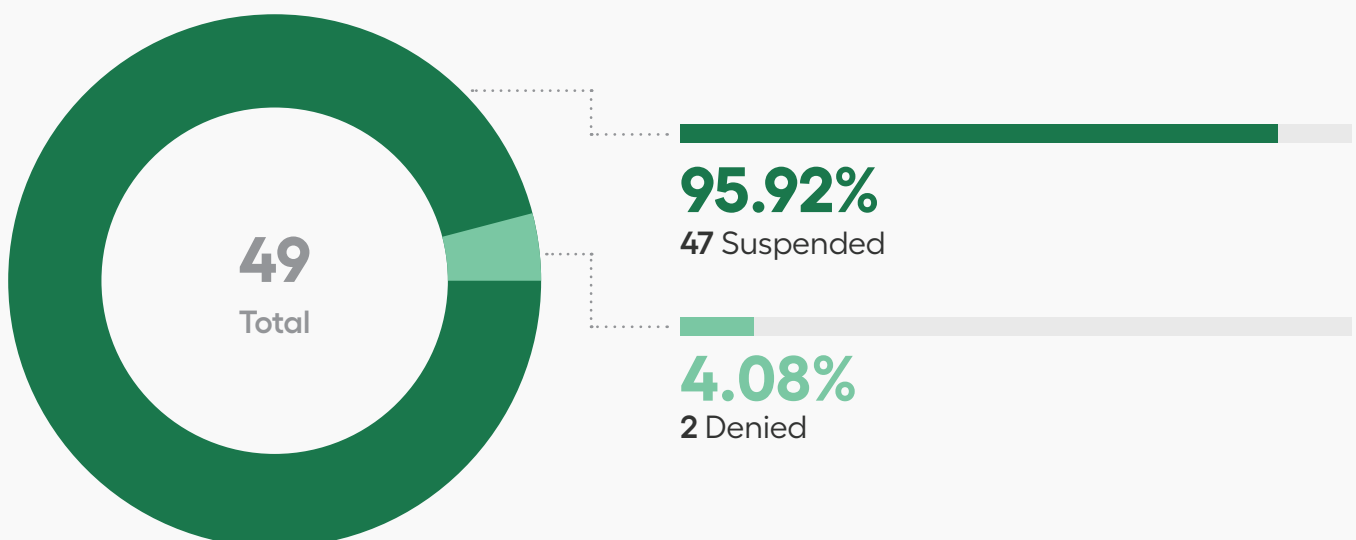
+13.95%

URS Domain Names v. Q1 2022

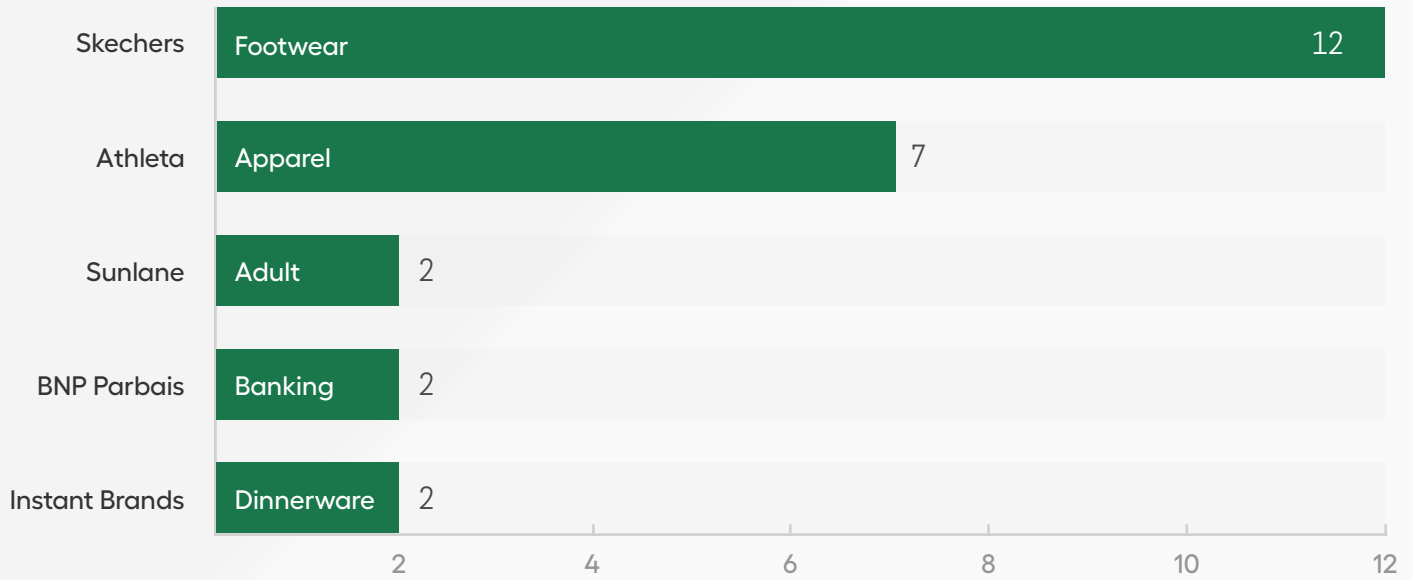
URS or UDRP?

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.

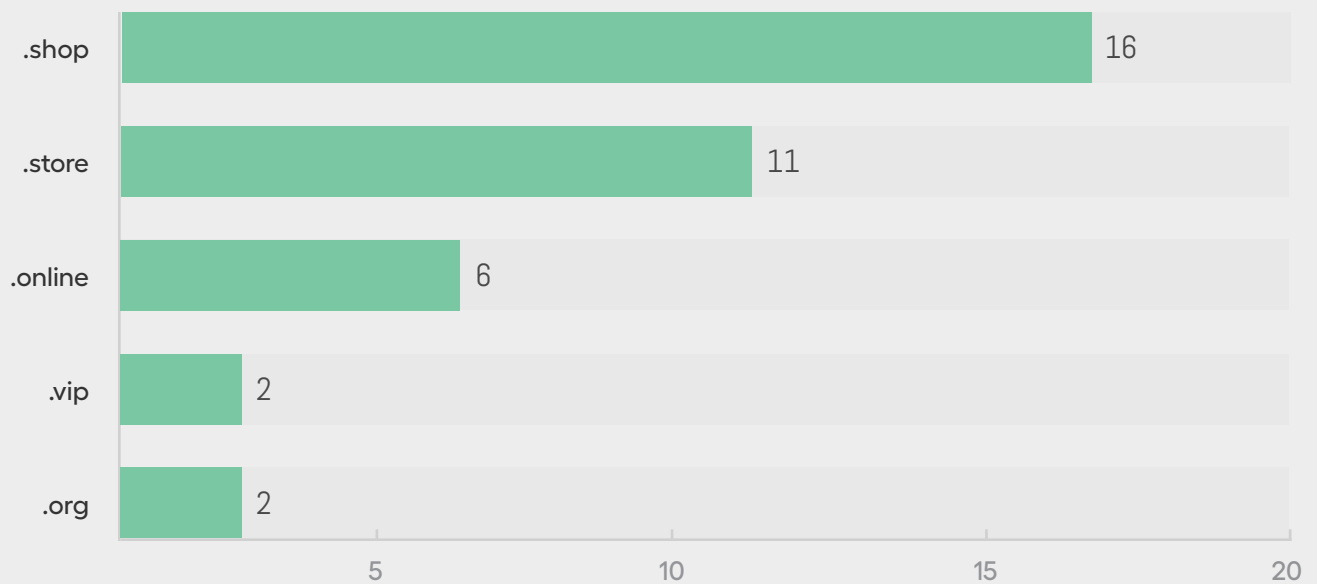
URS Outcome



Most Active Trademark Owners (URS Cases)



Most Common gTLDs (URS Cases)



SPOTLIGHT

Spanning the Dot in Domain Name Disputes: The <nes.cafe> Case

Nestle, the food and drink company, won a domain name dispute for <nes.cafe>, by relying on a seldom-used but important concept known as “spanning the dot,” as Doug Isenberg discusses in [a new video](#) on the [GigaLaw YouTube channel](#).

Although the top-level domain (TLD) is usually disregarded in cases under the Uniform Domain Name Dispute Resolution Policy (UDRP), the panel in this case said that “it may be appropriate to ‘span the dot’ and consider the TLD” because the disputed domain name <nes.cafe> — “considered in its entirety” — is confusingly similar to the NESCAFE trademark.

The issue has arisen in a small but important number of other UDRP cases through the years, including for <zionsbank.holdings>, <mr.green>, <creditmutuel.group> and <tes.co> and <b.mw>.

The issue relates to the first element of the UDRP, which requires a complainant to prove that the disputed domain name is identical or confusingly similar to a trademark in which it has rights. Usually, this means that only the second-level portion of the domain name – the characters to the left of a TLD, which an accused cybersquatter has actually registered – are compared with the trademark, ignoring the TLD itself, such as .com.

But in unusual situations, this is not always the rule. Here’s what the panel concluded in the Nescafe case:

In some limited circumstances..., as part of a holistic review of the facts, it may be appropriate to ‘span the dot’ and consider the TLD....

[T]he Panel finds that the disputed domain name <nes.cafe>, considered in its entirety, is confusingly similar to the Complainant’s NESCAFE trademark.

Given the expansion of the number of top-level domains in recent years – and there are now more than 1,500 available, from .aaa and .aarp to .zuerich and .zw – it’s not surprising to see disputes in which a trademark, like NESCAFE, spans the dot. It’s an issue that all trademark owners should be aware of when seeking to protect their brands online.



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 42 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 January 1 – March 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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