

GIGALAW'S

# DOMAIN DISPUTE DIGEST

THIRD QUARTER, 2023

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FOREWORD

# Behind the Headlines of Domain Name Disputes

Another quarter, another record-setting pace for domain name disputes.

Nothing seems to be slowing down as trademark owners continued filing complaints in the third quarter of 2023 against cybersquatters under the Uniform Domain Name Dispute Resolution Policy (UDRP), which is the focus of GigaLaw's Domain Dispute Digest.

And while the numbers on the following pages tell the story of just how popular and effective the UDRP continues to be, here are a few highlights I found by examining the data behind the headlines:

- ▶ Consolidated complaints (involving multiple domain names) continue to be a popular way for trademark owners to pursue cybersquatters efficiently (although there are some important considerations – see [p. 11](#)), with 60 UDRP decisions last quarter that included 10 or more domain names.
- ▶ Eighty-seven generic top-level domains (gTLDs) appeared in UDRP decisions, with 50 showing up just once or twice, including such obscure gTLDs as .love, .istanbul, and .business. (I discuss one of the few UDRP cases for the .gay gTLD, filed by MIT, in a [video](#) on the GigaLaw YouTube channel.)
- ▶ While well-known trademark owners and those that frequently file UDRP complaints often seem to attract attention, most trademark owners appeared in only one decision in the quarter, accounting for 902 of the 1,178 cases. This seems to indicate that the UDRP broadly appeals to trademark owners of all sizes – and that almost no trademark owner is immune from being a target of cybersquatters.

Finally, I want to take this opportunity to thank a number of organizations that have recently invited me to speak about the UDRP or attend their programs:

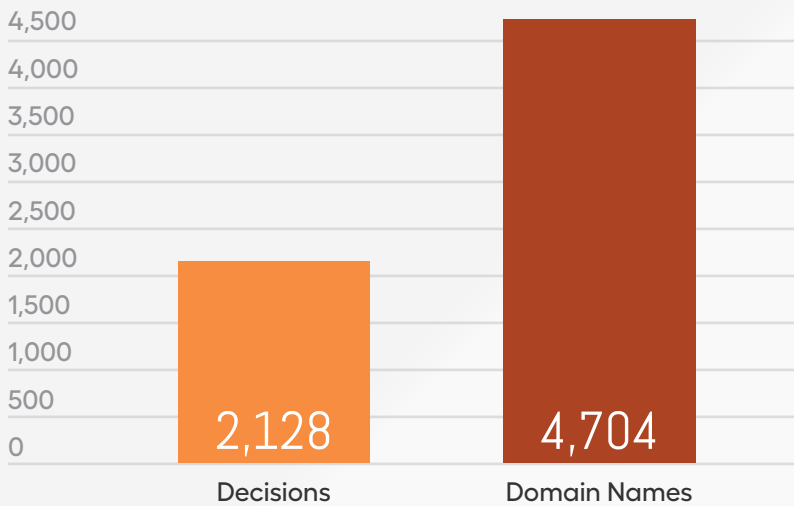
- ▶ In September, I spoke at a webinar organized by Markmonitor, titled “**UDRP and You: Things to Consider in Domain Disputes in 2023.**”
- ▶ In October, I facilitated a **training workshop for UDRP panelists** organized by the Canadian International Internet Dispute Resolution Centre (CIIDRC).
- ▶ In November, I am attending the annual meeting of **WIPO domain name panelists** in Geneva, as I do every year.
- ▶ In January, I will provide an update on “**Developments in Internet Law**” at the IP CLE Conference in Snowmass, Colorado. This will be my third consecutive year speaking at this event, which offers 16 MCLE credit hours in a resort setting with attorneys from both private practice and in-house roles. If you're interested in attending, please email me and I can provide registration details.

## Doug Isenberg

Attorney and Founder of GigaLaw  
[Doug@Giga.Law](mailto:Doug@Giga.Law)



## Number of UDRP Decisions and Domain Names



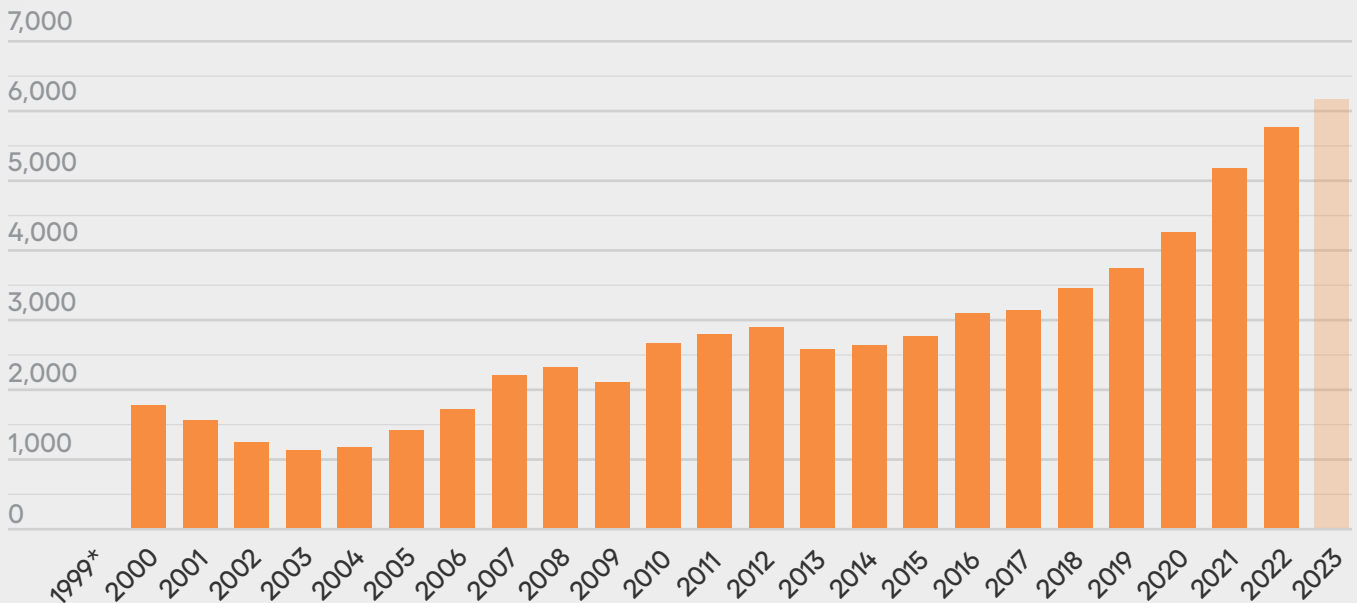
**+4.83%**

UDRP Decisions v. Q3 2022

**+18.52%**

UDRP Domain Names v. Q3 2022

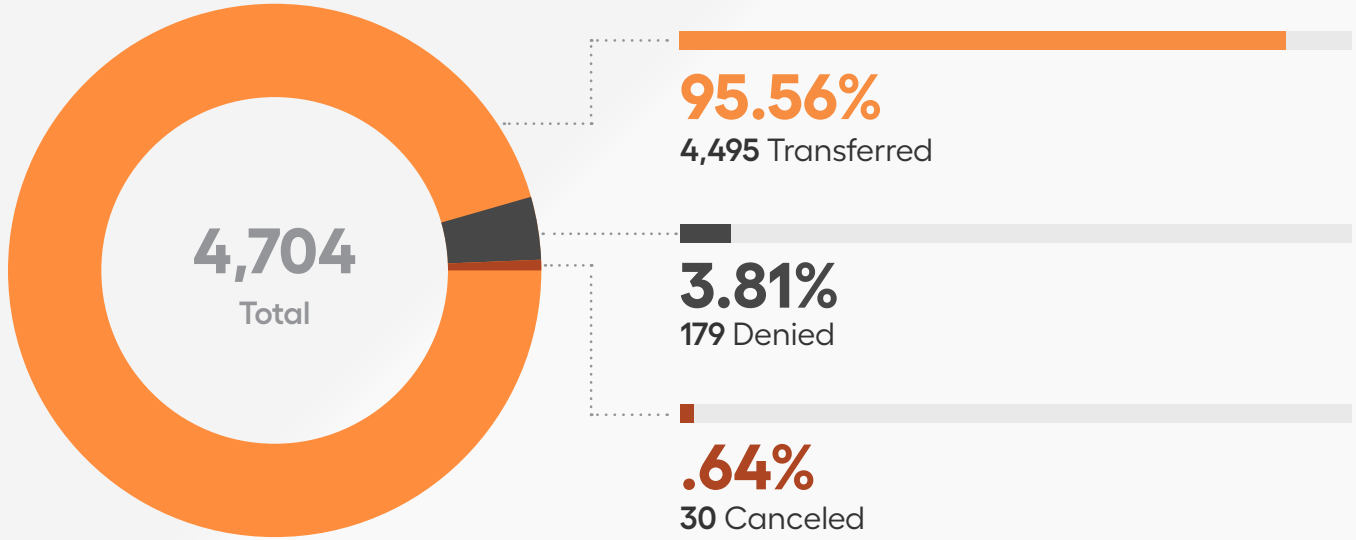
## WIPO Domain Name Cases by Year



\* 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 October 20, 2023.

## UDRP Outcome

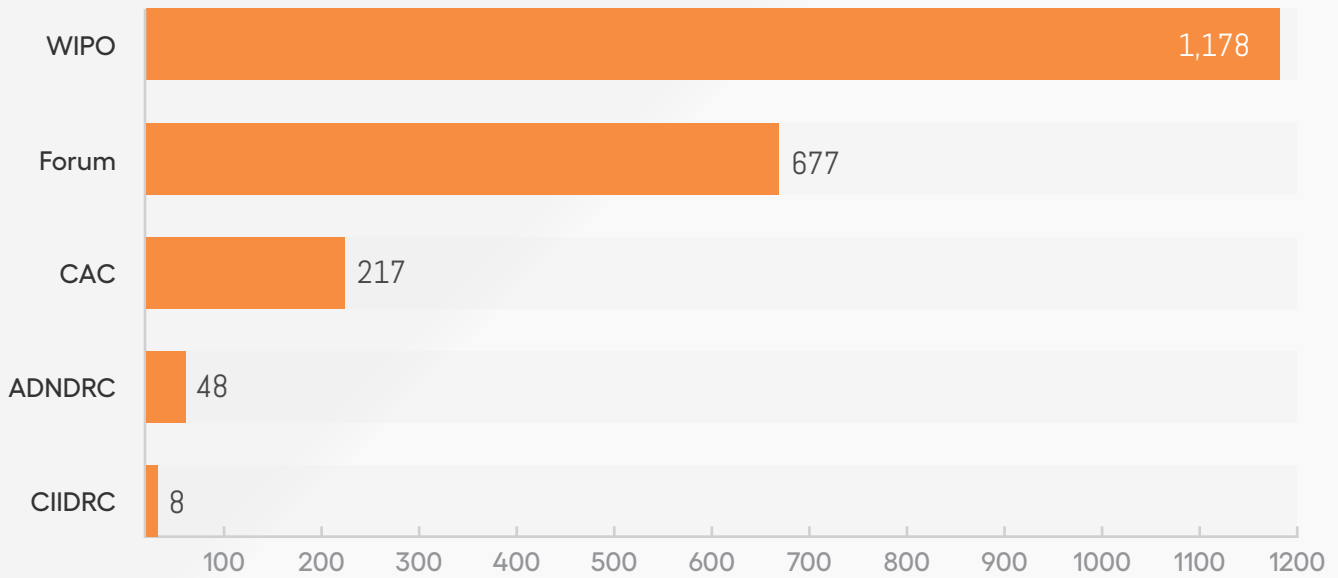


## Largest UDRP Cases

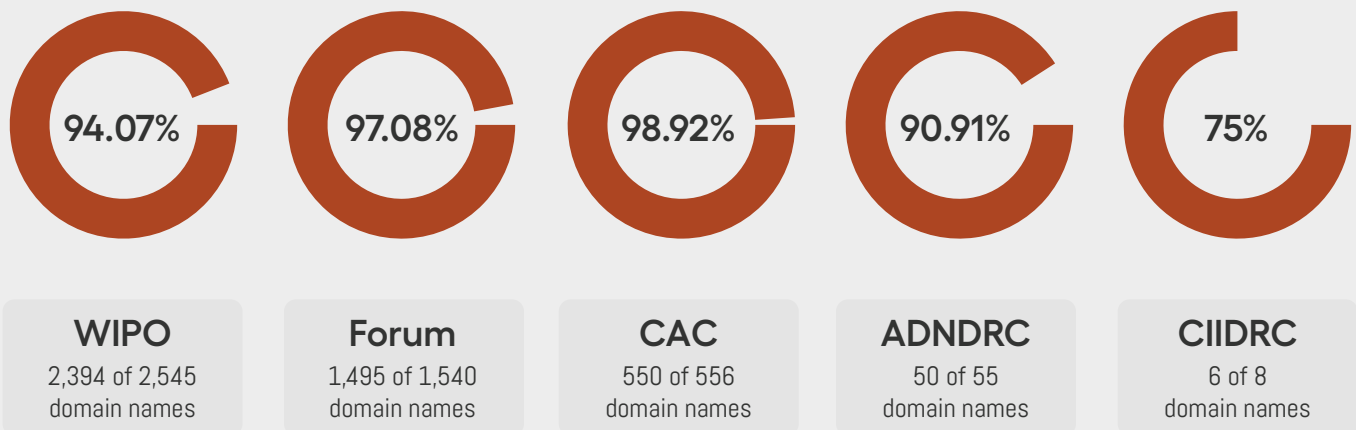
Complainant	Case No.	No. of Domains
IBM	D2023-1485	155
Manduka	D2023-3098	81
Victor Rackets	D2023-2080	80
Amazon	Forum 2048287	61
Family First Life	Forum 2052255	61
Kamik Canada	CAC 105481	60
Liu.Jo	CAC 105699	54
OOFOS	Forum 2051390	54
Early Warning Services (Zelle)	D2023-2229	50
Early Warning Services (Zelle)	D2023-2170	49

Complainant	Case No.	No. of Domains
Early Warning Services (Zelle)	D2023-2025	49
Early Warning Services (Zelle)	D2023-2168	49
Early Warning Services (Zelle)	D2023-2374	49
Amazon	Forum 2057872	42
Moncler	CAC 105522	36
Valentino	D2023-2189	35
Dansko	D2023-2498	34
CS Calzature	D2023-2407	33
Moscot	Forum 2045789	31

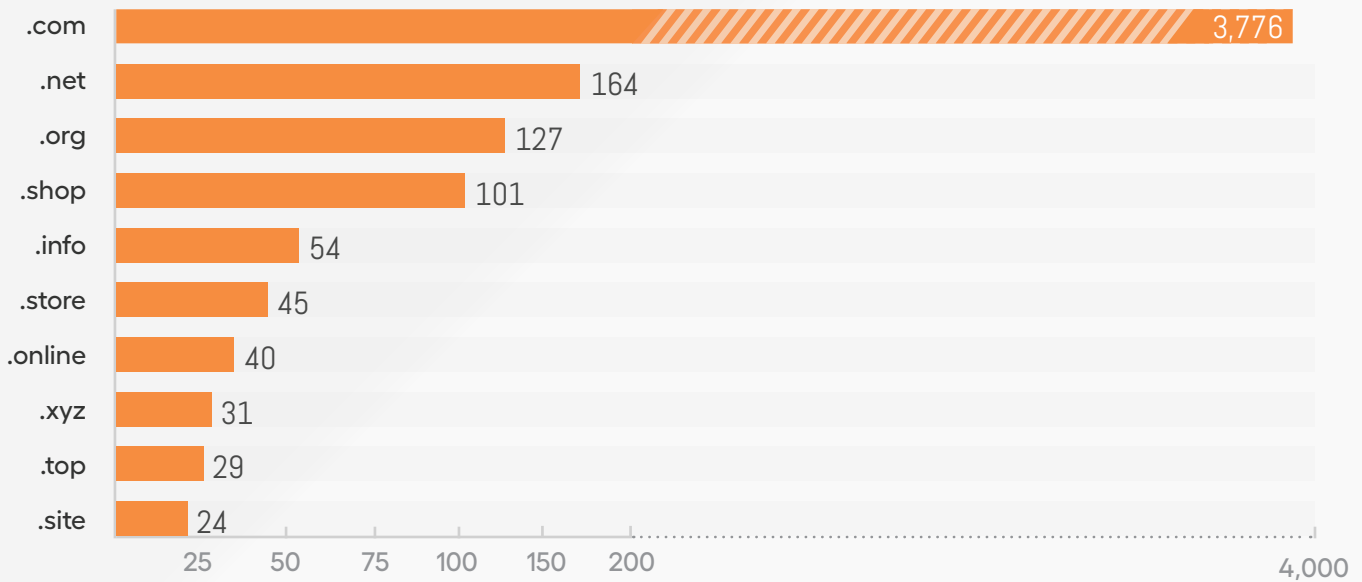
## Number of UDRP Decisions by Provider



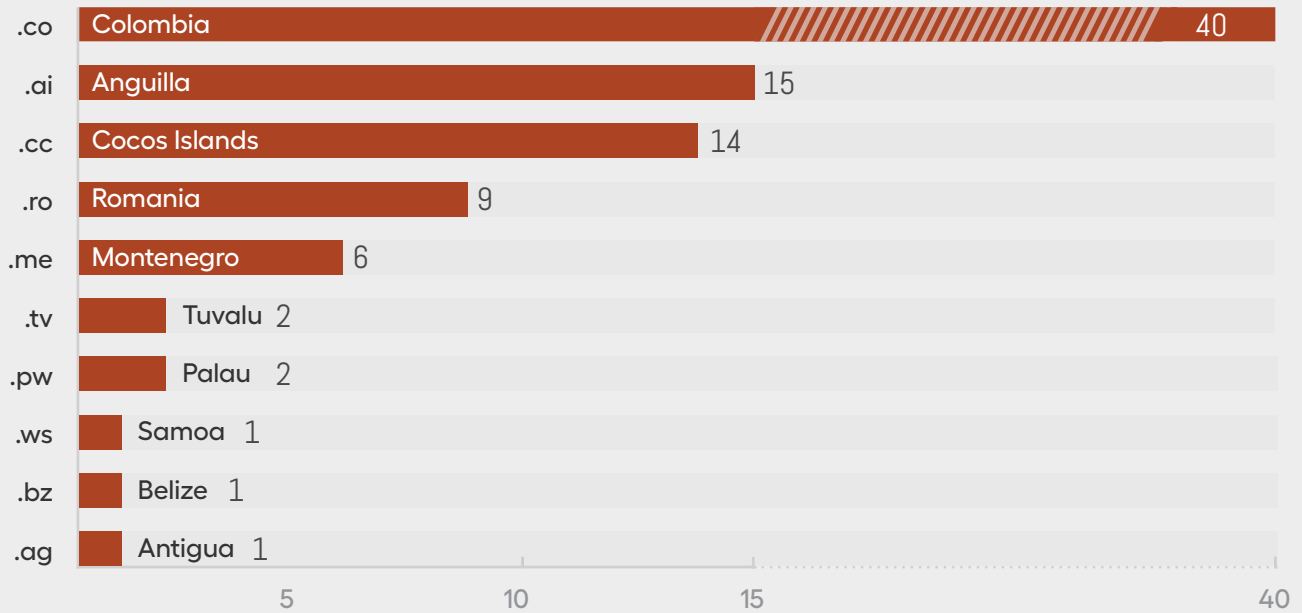
## Transfer Rate by Provider



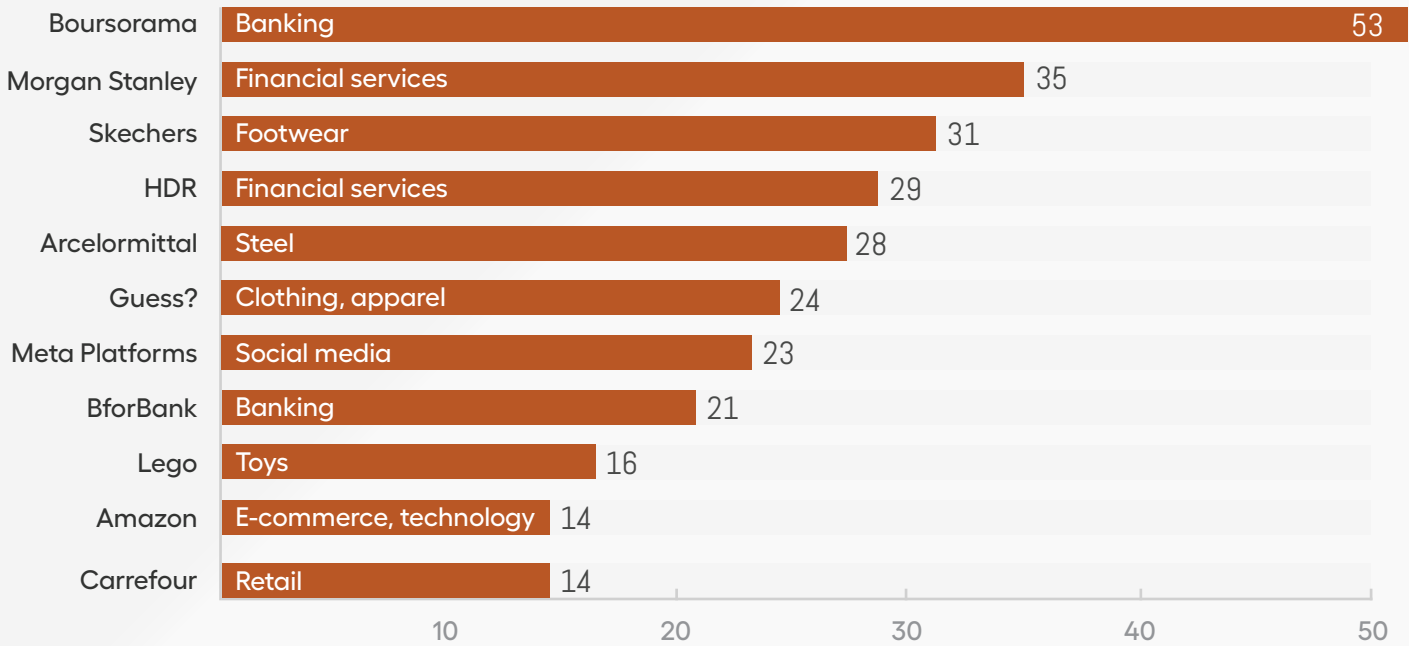
## Most Common gTLDs in UDRP Cases



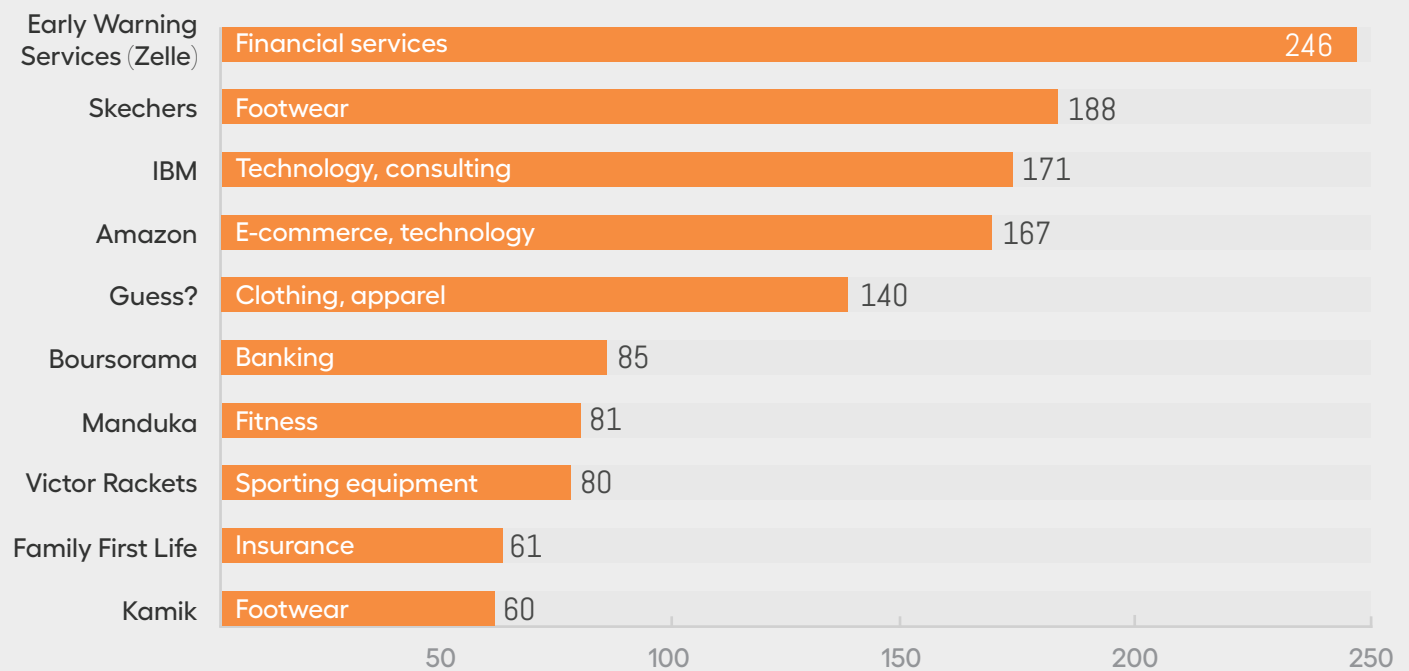
## Most Common ccTLDs in UDRP Cases



## Most Active Trademark Owners (UDRP Cases)

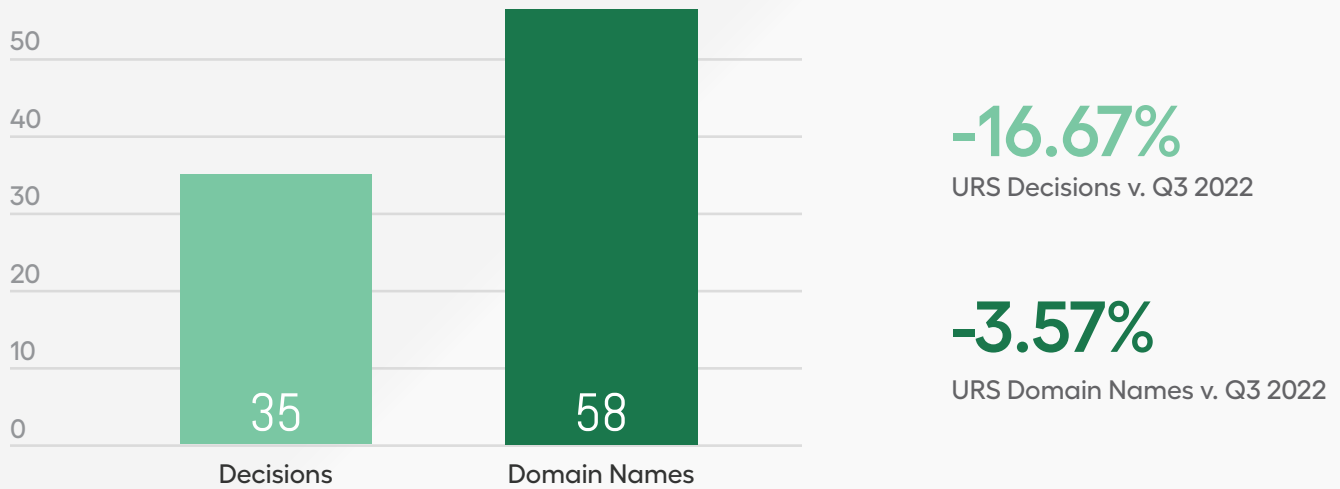


## Most Active Trademark Owners (Domain Names in UDRP)





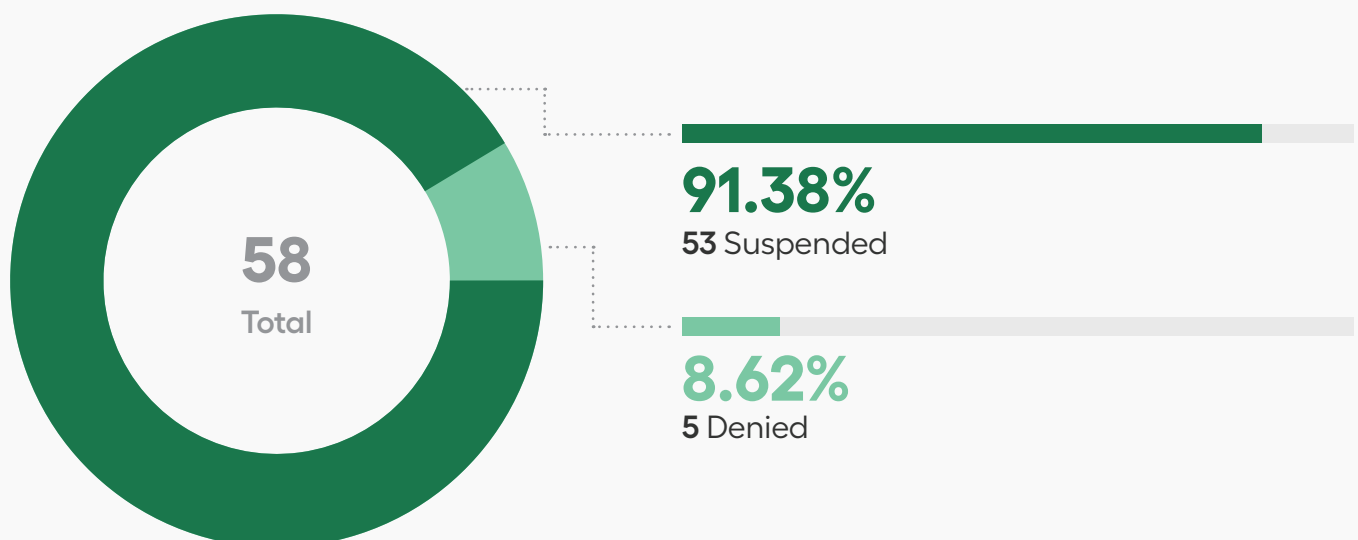
## Number of URS Decisions and Domain Names



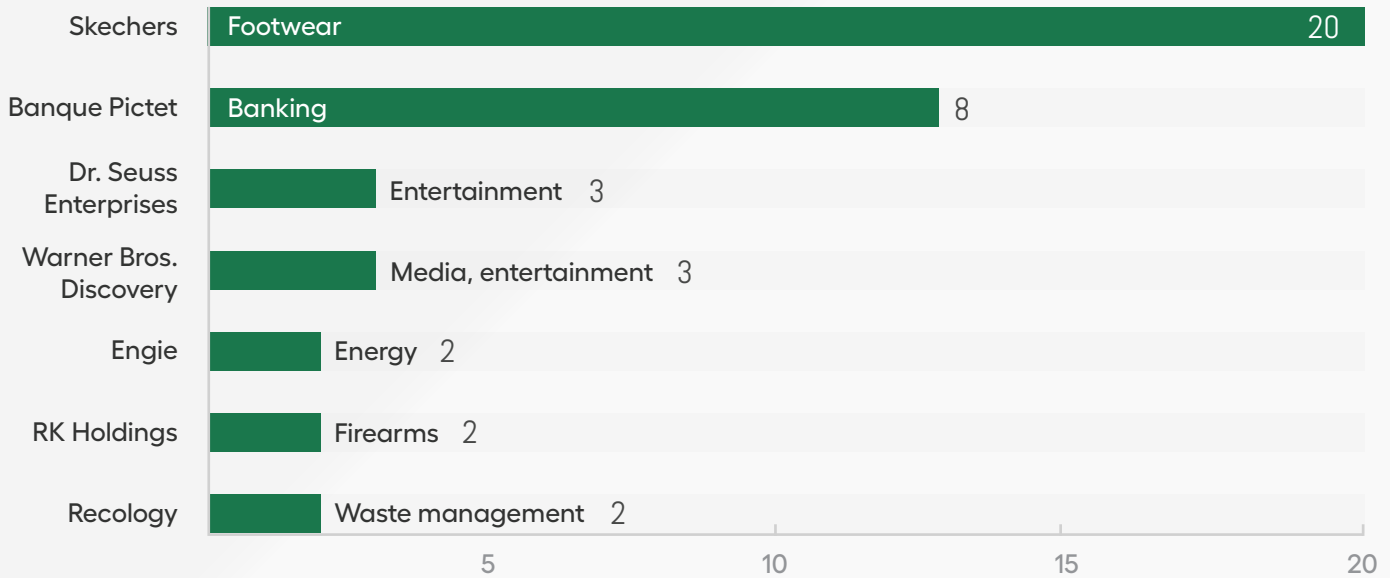
### URS or UDRP?

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.

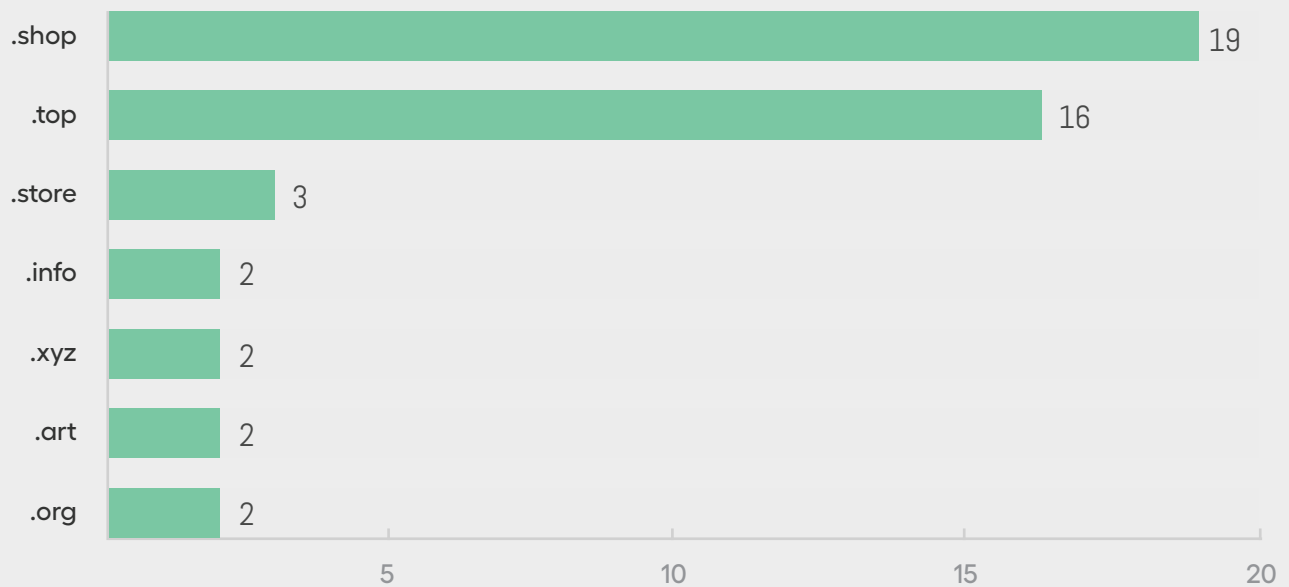
## URS Outcome



## Most Active Trademark Owners (URS Cases)



## Most Common gTLDs (URS Cases)



SPOTLIGHT

## The Challenges of ‘Consolidation’ in Large UDRP Complaints

Consolidating multiple domain names into a single UDRP complaint can be an incredibly efficient way for a trademark owner to tackle cybersquatters, but doing so is not always the right choice and needs to be taken seriously.

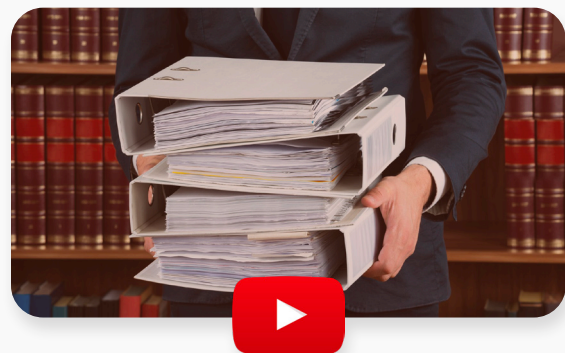
I discussed this topic in a UDRP case study video on the GigaLaw YouTube channel, [“When to Avoid Large Complaints.”](#) In the case I highlight in the video, a trademark owner, Fenix International, tried to include 14 domain names in a single UDRP complaint but was rejected by a panelist who found that consolidation was not appropriate.

The UDRP Rules say that a “complaint may relate to more than one domain name, provided that the domain names are registered by the same domain-name holder.” Before the widespread use of privacy and proxy services and the arrival of the European Union’s General Data Protection Regulation (GDPR) in 2018, large UDRP complaints were more common than they are today. (In 2009, I filed the largest UDRP complaint on record, which resulted in an order transferring 1,519 domain names to a single client.)

In the Fenix case, the company argued that consolidation was appropriate even though there were multiple registrants involved because all of the registrants were actually the same person or entity, that they were all connected to each other, and that they were under common control.

But the UDRP panelist was not convinced. After noting that registrants of two of the disputed domain names filed responses stating that they were not associated with the other domain names, the panelist said that Fenix had not clearly substantiated its claims for consolidation and that Fenix “may file new UDRP proceedings, should it wish to do so, in respect of [some of] these disputed domain names.” As a result, Fenix ended up filing at least five new and separate complaints for five of the domain names in the original case.

The lesson for trademark owners here is that it’s important to make a strong and well-documented case for consolidation when including multiple domain names in a single complaint. While consolidation is attractive, failing to make the case could lead to additional expenses and delays that could have been avoided by filing multiple complaints from the beginning.



[www.Giga.Law/2023-consolidation](http://www.Giga.Law/2023-consolidation)

# 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](http://www.Giga.Law) or email [Doug@Giga.Law](mailto: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 July 1 – September 30, 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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