

GIGALAW'S

DOMAIN DISPUTE DIGEST

FIRST QUARTER, 2024

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FOREWORD

Three Lesser-Known Reasons Behind the Ongoing Growth in Domain Name Disputes

The year 2024 began just like the past 10 years have ended: with a record-setting number of domain name disputes under the Uniform Domain Name Dispute Resolution Policy (UDRP).

I've discussed a number of reasons behind the growing problem of cybersquatting for a long time, including the overall effectiveness of the UDRP itself. But I've started to notice a few additional issues that are contributing to the trend:

► **More First-Time Filers.** Many well-known trademark owners continue to file multiple UDRP complaints every quarter, but I also always see unfamiliar names among the list of complainants – and, I'm frequently contacted by companies of all sizes that have never filed a UDRP complaint before. Although some of them have never had a need to file a domain name dispute until a current event occurred or gained their attention, most of them are just now becoming aware of either the problem of cybersquatting or the practical solution of the UDRP. Some of these trademark owners may only ever file a single complaint and will never appear on this Digest's list of frequent filers ([p. 8](#)), but some of them start to tackle cybersquatters regularly once they realize the scope of the issue and the ease with which the UDRP allows them to address it.

► **More Large Complaints.** While most UDRP decisions (about 95 percent) involve only a single domain name ([p. 5](#)), some trademark owners sometimes find it possible to include multiple domain names (as many as 93 in the past quarter) in a single complaint – something referred to as a type of "consolidation" under the UDRP. As I've said

before, consolidated complaints have become less common in recent years, given the popularity of privacy and proxy services as well as the European Union's General Data Protection Regulation (GDPR), which makes it more difficult for trademark owners to identify multiple domain names held by a single registrant. But, savvy trademark owners that find ways to tie domain names together find consolidation to be an incredibly effective and efficient strategy.

► **More ccTLD Disputes.** Although gTLDs continue to account for the overwhelming majority of all UDRP cases, the first quarter of 2024 saw an increase in the number of disputes using .co (Colombia) and .ai (Anguilla) top-level domains. Indeed, there were twice as many .ai decisions in the quarter as compared with the same quarter last year, indicating that both trademark owners and cybersquatters continue to find this ccTLD attractive because of its coincidental connection to the hot topic of artificial intelligence.

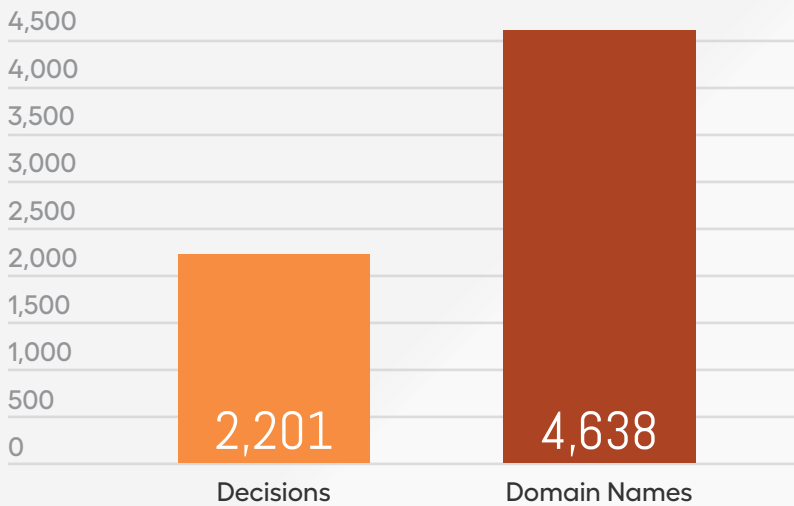
If you want to talk with me directly about any of these issues, I hope you'll join me at the INTA annual meeting in Atlanta, where I'm hosting two table topics on the UDRP ([p. 11](#)).

Doug Isenberg

Attorney and Founder of GigaLaw
Doug@Giga.Law



Number of UDRP Decisions and Domain Names



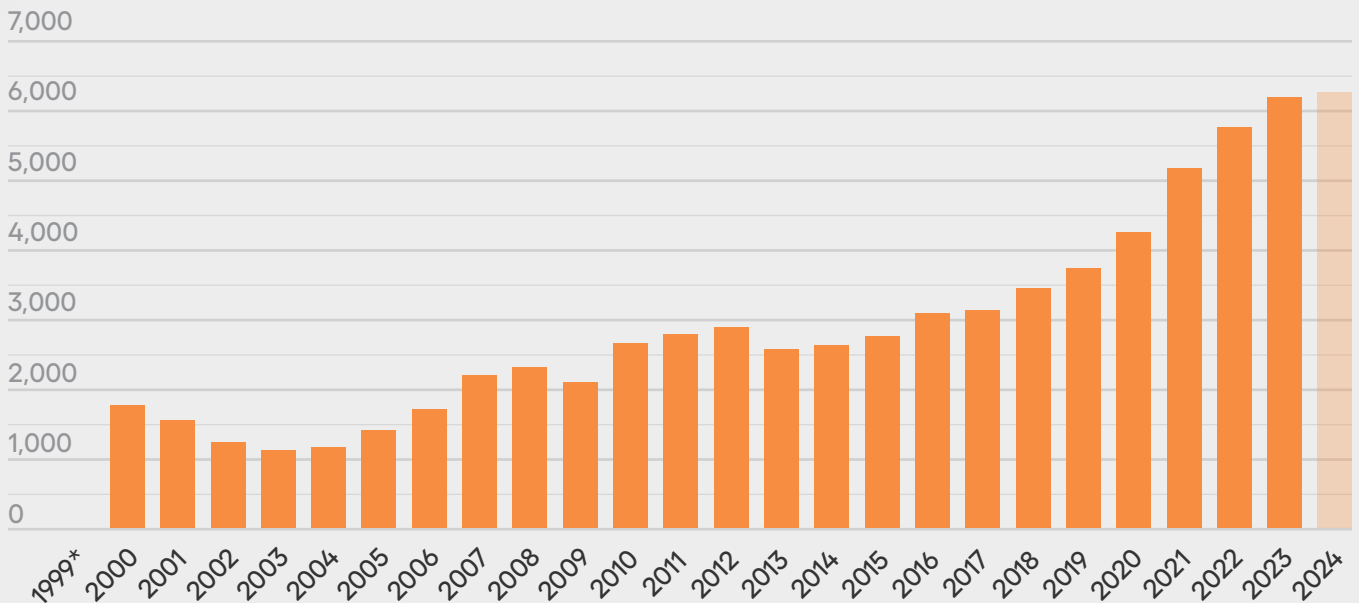
+8.64%

UDRP Decisions v. Q1 2023

+27.52%

UDRP Domain Names v. Q1 2023

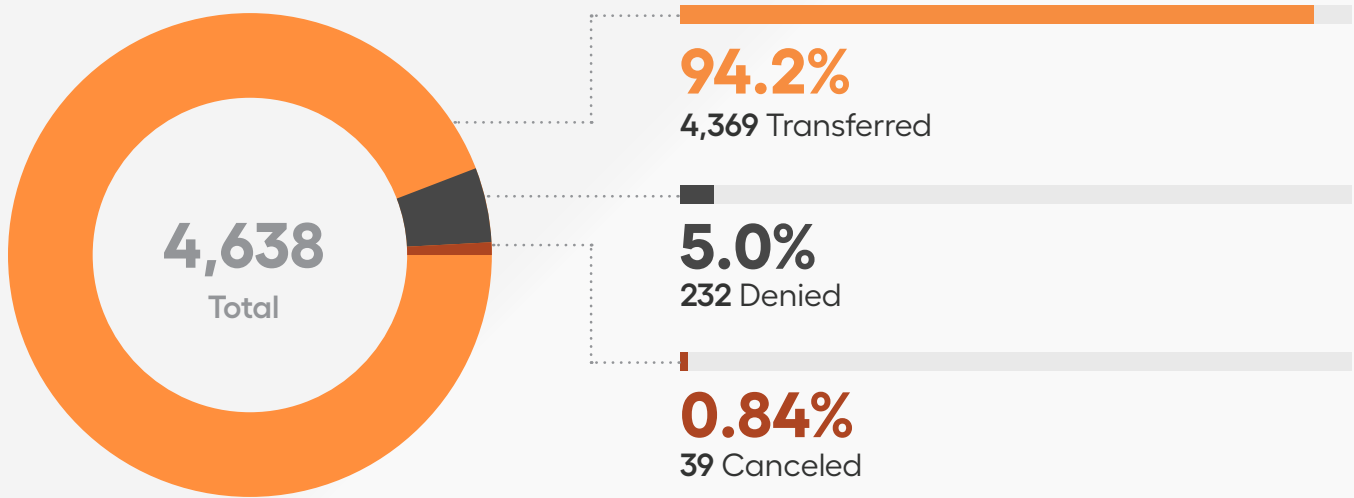
WIPO Domain Name Cases by Year



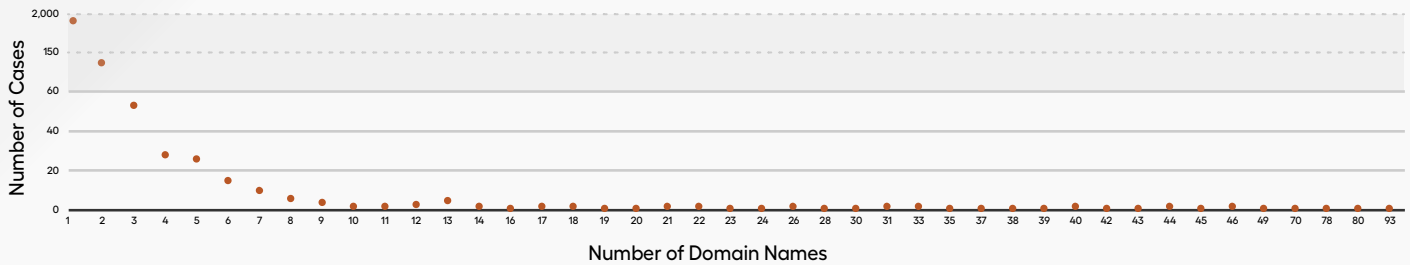
* One case was filed in 1999 Estimate for 2024

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 2024 cases is based on data as of April 16, 2024.

UDRP Outcome



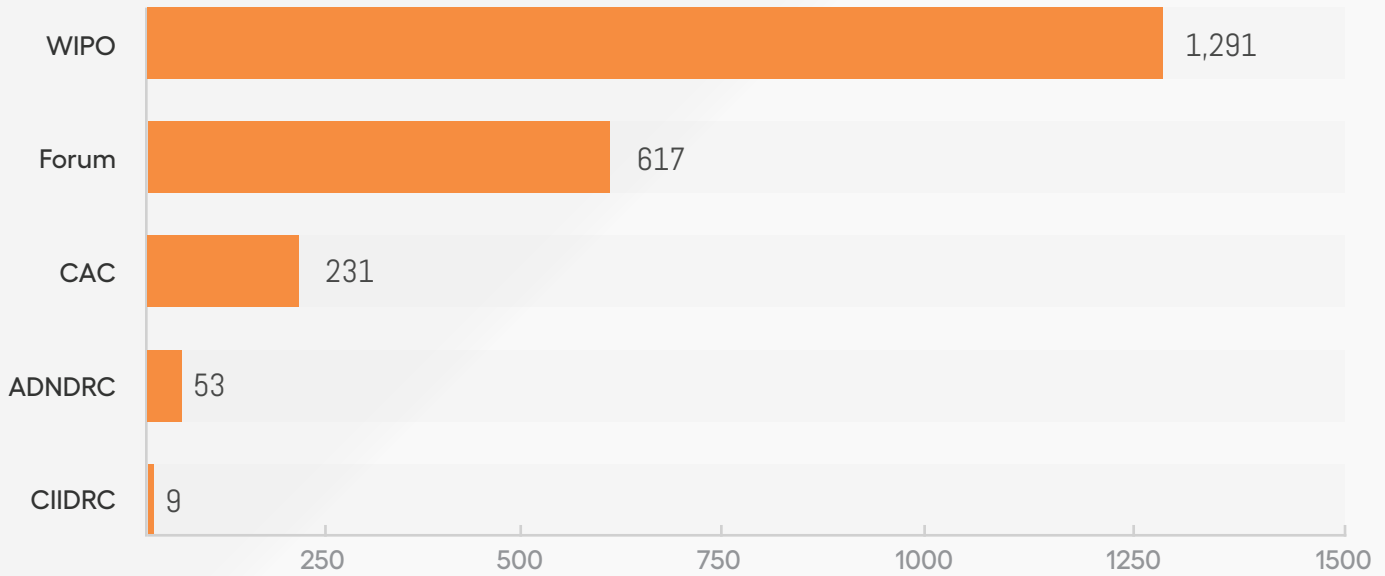
UDRP Case Size



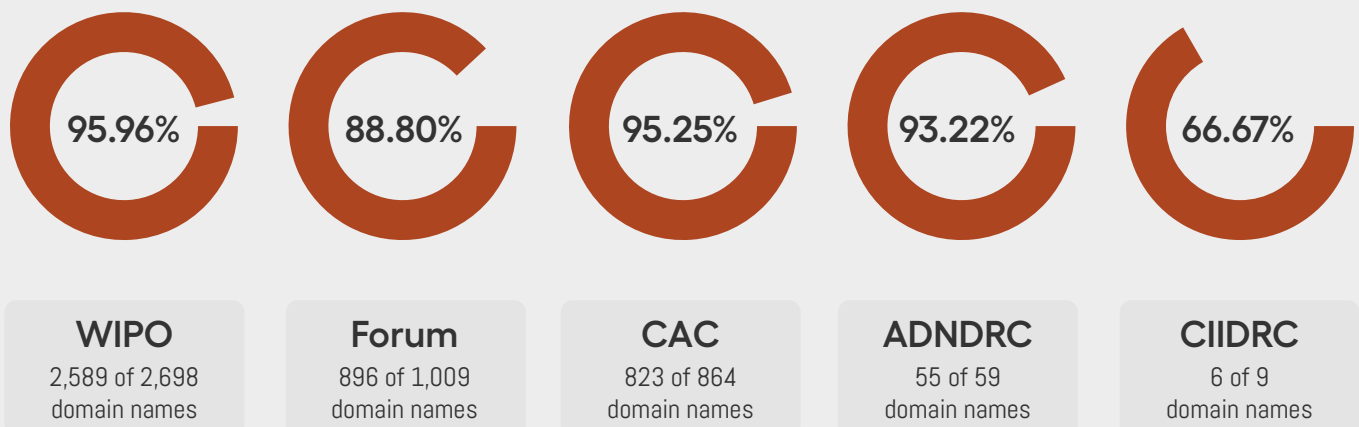
Largest UDRP Cases

Complainant	Case No.	No. of Domains	Complainant	Case No.	No. of Domains
Canva	D2023-2921	174	Off-White	CAC-UDRP-106224	44
Jellycat	CAC-UDRP-106159	102	Aime Leon Dore	D2023-4628	44
Under Armour	CAC-UDRP-105992	93	Jacquemus	D2023-4723	43
Osprey Packs	CAC-UDRP-106098	80	Lidl	D2024-0059	42
Sisco Textiles	FA2311002073025	78	All Saints Retail	CAC-UDRP-105978	40
Merryvale	D2023-4836	70	Jacquemus	D2023-4727	40
Deutsche Börse	CAC-UDRP-106151	49	Fat Face	D2023-3516	39
Yves Salomon	D2023-5151	46	Kenvue	FA2402002085370	38
Frankie Shop	D2023-4362	46	Skims Body	D2023-4777	37
Decathlon	D2024-0020	45	Jacquemus	D2023-4751	35

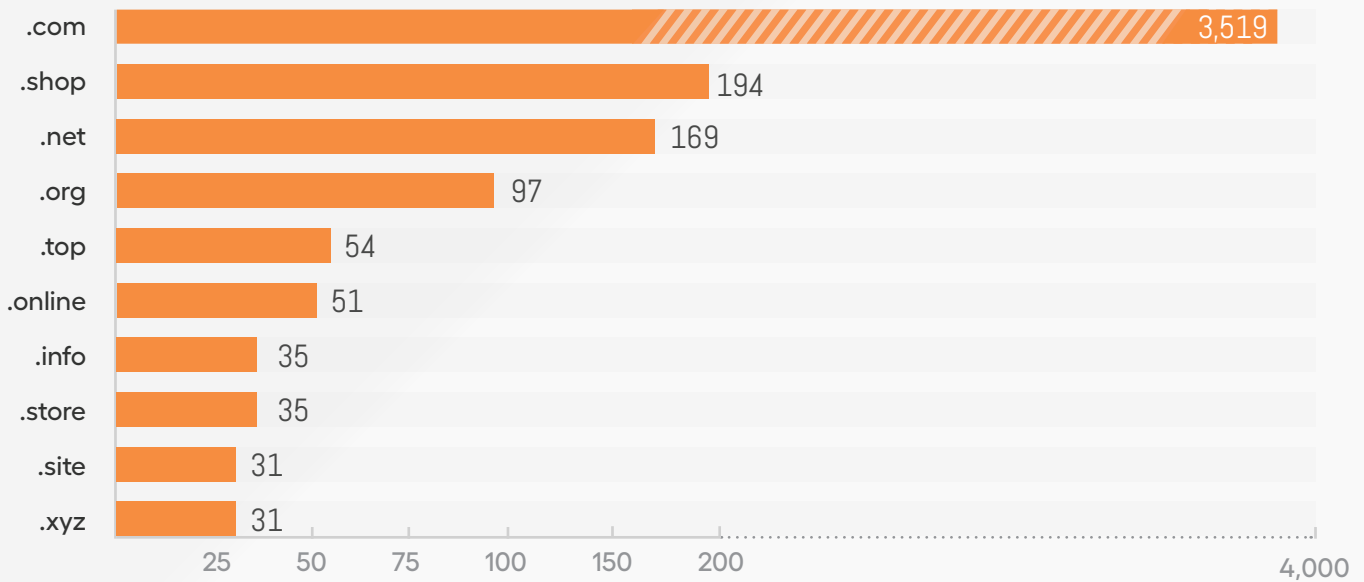
Number of UDRP Decisions by Provider



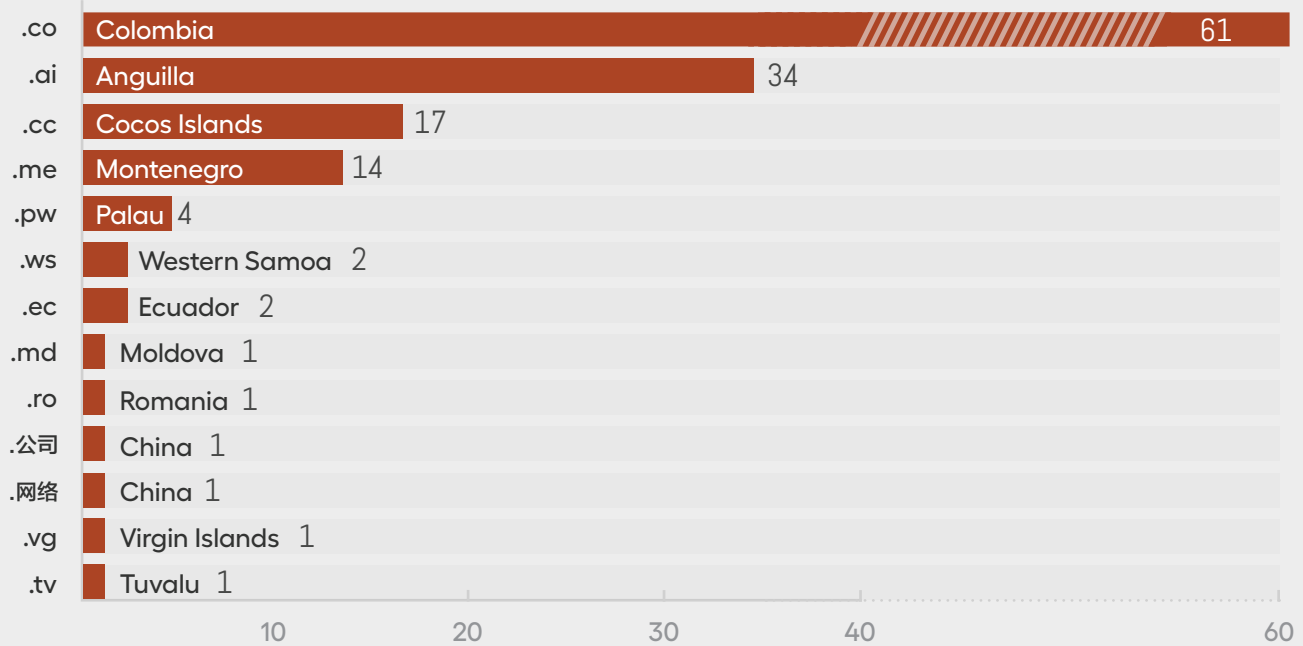
Transfer Rate by Provider



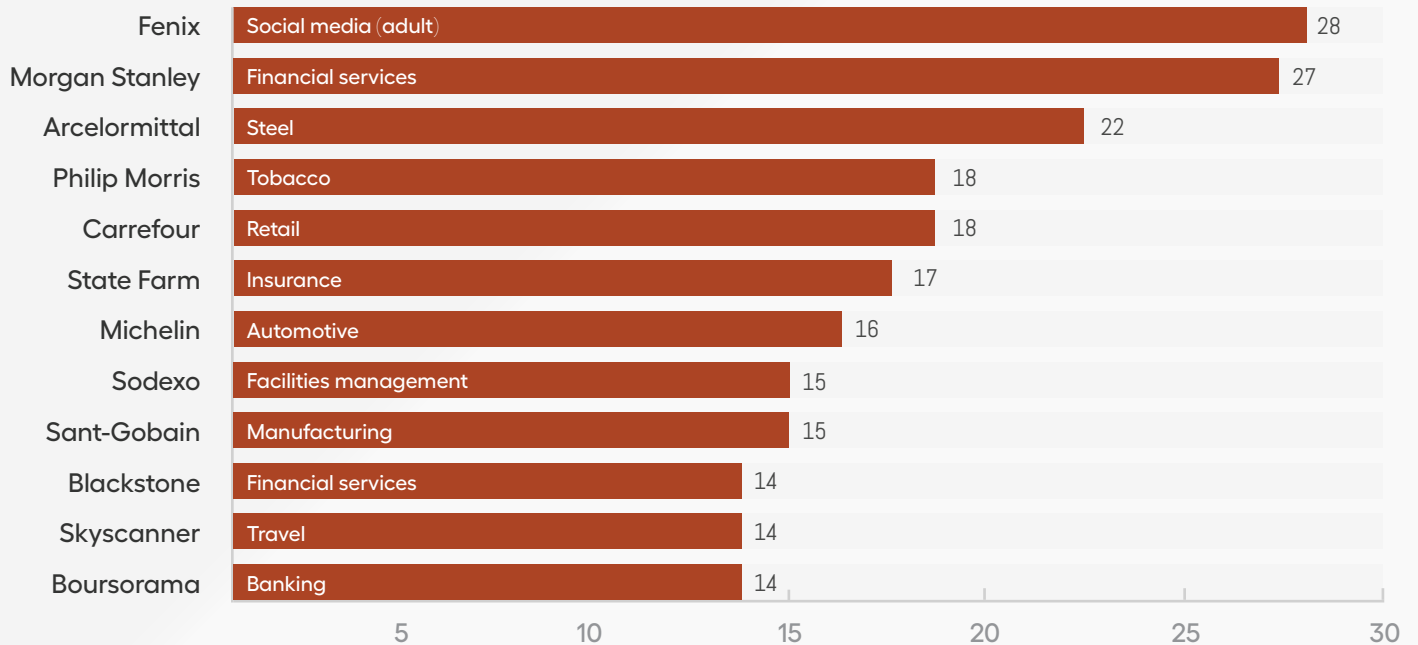
Most Common gTLDs in UDRP Cases



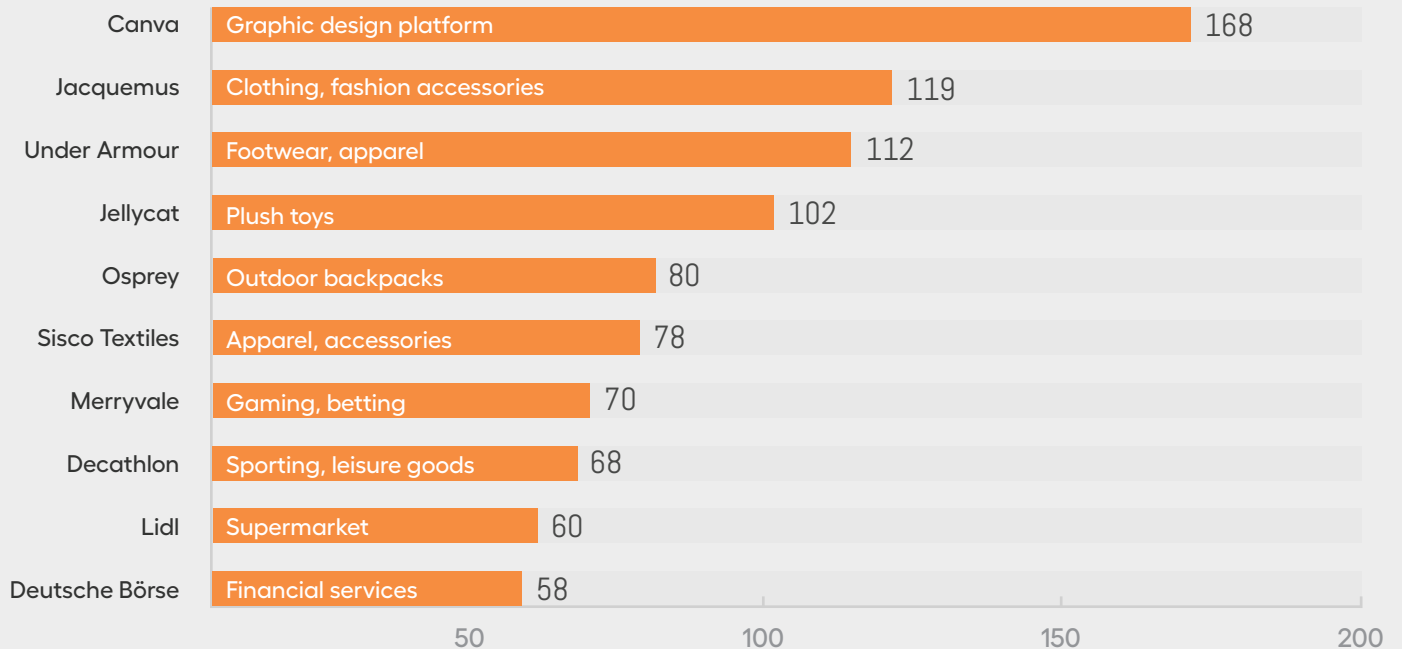
Most Common ccTLDs in UDRP Cases



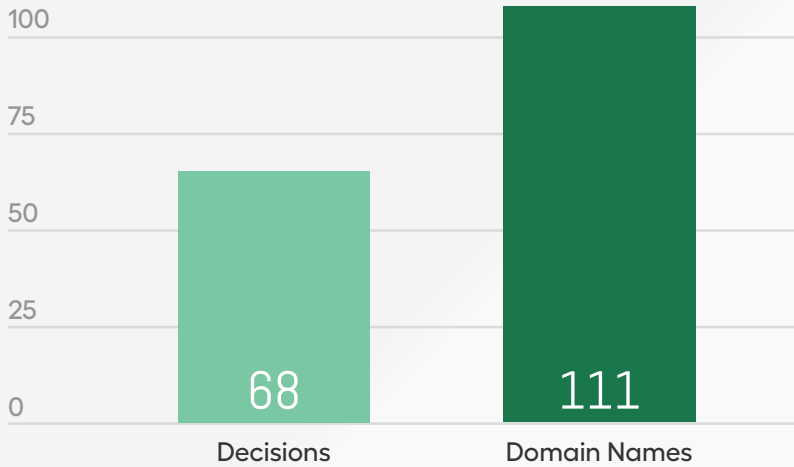
Most Active Trademark Owners (UDRP Cases)



Most Active Trademark Owners (Domain Names in UDRP)



Number of URS Decisions and Domain Names



+94.29%

URS Decisions v. Q1 2023

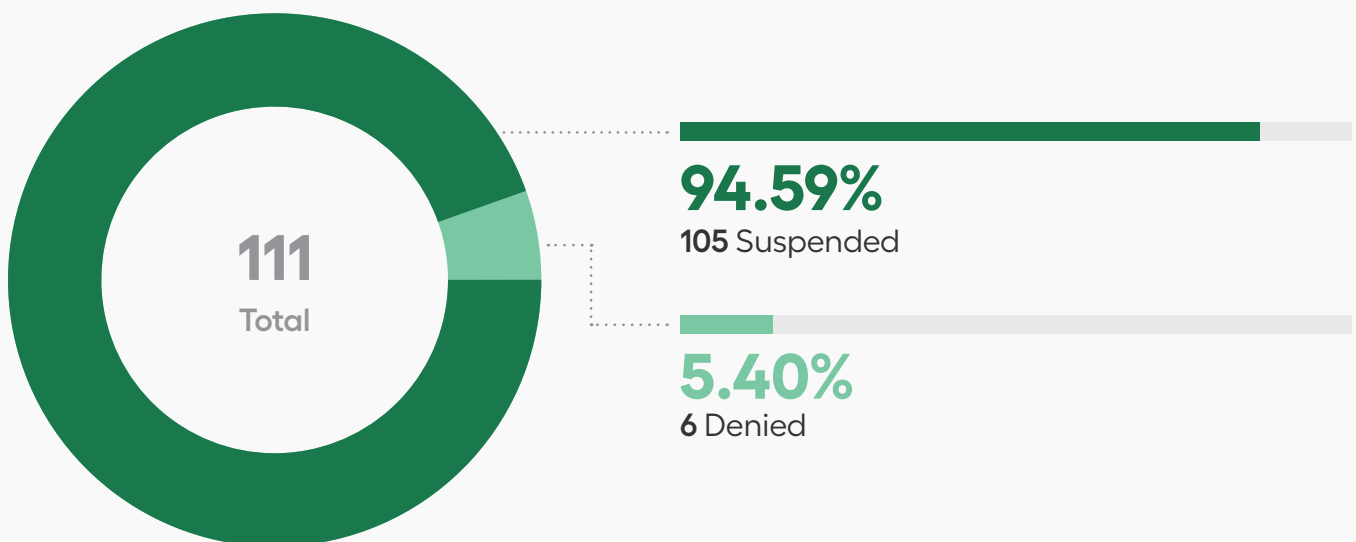
+126.53%

URS Domain Names v. Q1 2023

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.

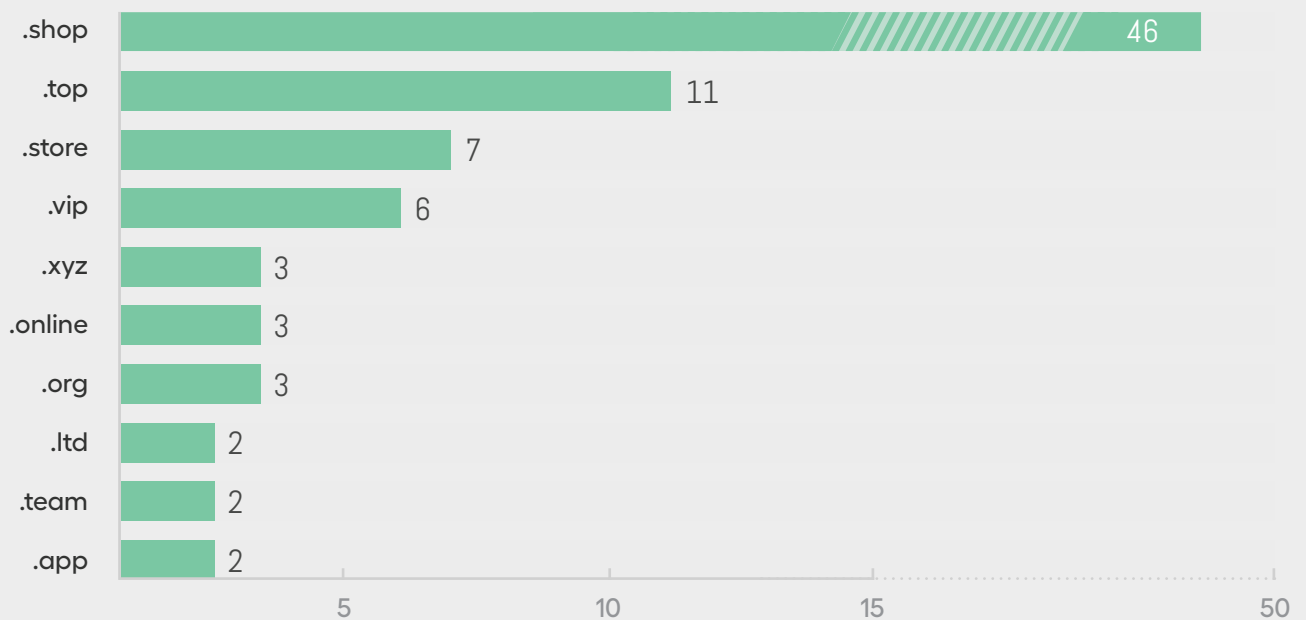
URS Outcome



Most Active Trademark Owners (URS Cases)



Most Common gTLDs (URS Cases)



SPOTLIGHT

Meet Doug Isenberg at INTA 2024 in Atlanta on May 22, 2024

Doug Isenberg is hosting the following two table topics at the annual meeting of the International Trademark Association (INTA) in Atlanta on **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.



Register for Doug’s Table Topics:

1. Follow [this link](#) to log in to INTA.org and view events.
2. Click on the **Details** button next to 2024 Annual Meeting.
3. Under **Order Details** on the right side of the page, click on the **Add Session** button.
Note: You can use these terms to search for Doug’s sessions: “skyrocketing” for the first session, and “mistakes” for the second session.
4. Click on the **Select** button next to the add-on/session you want to sign up for.
5. Click **Checkout** and follow the prompts to make your payment.

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 January 1 – March 31, 2024, unless otherwise noted. The current Digest attempts to capture UDRP decisions published but not necessarily dated 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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