

International Developments

-

UDRP (WIPO) & Nominet DRS

Tony Willoughby

Johannesburg

14 April 2014

Session Outline - part I - UDRP

- Trade Mark Rights
- Confusing Similarity
- Resellers
- Gripe/Tribute Sites
- Conjunctive Requirement
- Paragraph 2

Trade Mark Rights

- registered
- unregistered
 - personal names
 - evidence required
 - uniformity across jurisdictions?
- timing of the rights

Registered trade marks

WIPO Case No.
DAU2013-0010

<trademarkdirect.com.au>

Launching Soon

Exciting new clothing brand brought to you by the owners of Babybeehinds & Britt Design

Its been over 12 months in the making the hard work is done watch this space

TradeMarkDirect

US State Registrations

TM application filed
October 1, 2010

TM registered
October 1, 2010

WIPO Case No.
D2011-1243
<k2incenseblend.com>

STATE OF KANSAS
OFFICE OF SECRETARY OF STATE

I, CHRIS BIGGS, Kansas Secretary of State, certify that the records of this office reveal the following:

I, CHRIS BIGGS, Secretary of State of the State of Kansas do hereby certify that the trademark registration for

K2


to be used in conjunction with CLASS 003,
" "
for:

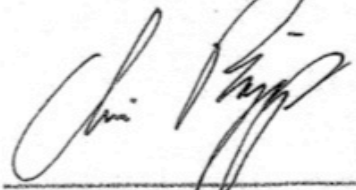
THIS MARK WILL BE USED TO IDENTIFY INCENSE
claimed by registrant to have been first used since
March 31, 2009 and first used in the state of
Kansas since March 31, 2009 has been filed by

BOUNCING BEAR BOTANICALS, INC.
PO BOX 1993
LAWRENCE KANSAS 66044

A facsimile of said mark is hereto attached and the fee
due this office has been paid. Said mark is registered for a
period of five years from the date of original filing, or
renewal, October 1, 2010

IN TESTIMONY WHEREOF:
I hereto set my hand and
cause to be affixed my
official seal. Done at the
city of Topeka, this 1ST
day of October A.D. 2010




CHRIS BIGGS
KANSAS SECRETARY OF STATE

US Supplemental Register

The screenshot displays the Everett Print website interface. At the top left is the Everett Print logo, which consists of three overlapping circles in red, blue, and yellow. To the right of the logo is a dark blue navigation bar containing four buttons: 'ESTIMATE', 'ORDER', 'REORDER', and 'SEND A FILE', each with a right-pointing arrow. Below the navigation bar is a dark grey 'ACCOUNT CENTER' menu with the following items: 'MY JOBS', 'MY ACCOUNT', 'SIGN OUT', 'PRODUCTS', 'RESOURCES', 'COMPANY', 'E-MAIL US', and 'HOME'. The main content area features a large photograph of two men in business attire smiling and looking at a computer monitor. Overlaid on the bottom right of the photograph is the text 'Manage your printing online with ease' with a yellow arrow pointing to the left.

WIPO Case No. D2013-0219 <IntegratedPrintSolutions.com>

Trade Mark Rights

- registered
- unregistered
 - personal names
 - evidence required
 - uniformity across jurisdictions?
- timing of the rights

Personal Names



WIPO Case No. D2013-0791
<RichardBransonInvestment.com>

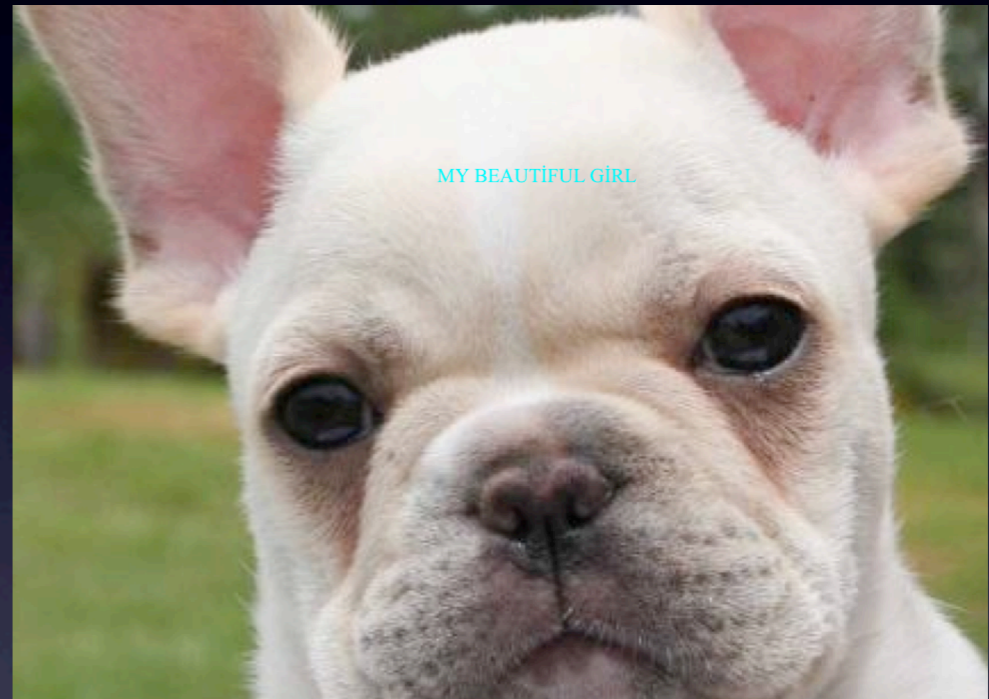


WIPO Case No. D2010-1954
<BackBoris.com>

Personal Names



WIPO Case No. D2013-1255
<PhilippePierreDauman.com>



WIPO Cases Nos. D2013-1123
and D2013-1124
<AnanyashreeBirla.com>
<AdvaiteshaBirla.com>
<AryamanVikramBirla.com>

requisite evidence



WIPO Case No. D2012-0651
<BrisbaneGlass.com>

requisite evidence

WIPO Case No. D2008-1036 <MancinisSleepworld.com>

Jurisdictional issue



WIPO Case No. D2009-1934
<PalaisStephany.com>

Trade Mark Rights

- registered
- unregistered
 - personal names
 - evidence required
 - uniformity across jurisdictions?
- timing of the rights

Timing of Trade Mark Rights



WIPO Case No. D2009-0943 <meeza.com>

Confusing Similarity

- the nature of the test
- trade mark + added matter (distinctive, descriptive, pejorative)
- disclaimers
- device marks

Confusing Similarity

- Is <tumbr.com> confusingly similar to TUMBLR? D2013-0106
- Is <tumblrcom> confusingly similar to TUMBLR? D2013-0203
- Is <tumblor.com> confusingly similar to TUMBLR? D2013-0213
- Is <tumbl.com> confusingly similar to TUMBLR? D2013-0214
- Is <tublr.com> confusingly similar to TUMBLR? D2013-0220
- Is <tumblr.com> confusingly similar to TUMBLR? D2013-0242
- Is <tubmlr.com> confusingly similar to TUMBLR? D2013-0243
- Is <tumlr.com> confusingly similar to TUMBLR? D2013-0244
- Is <umblr.com> confusingly similar to TUMBLR? D2013-0421
- Is <yumblr.com> confusingly similar to TUMBLR? D2013-0424
- Is <tymblr.com> confusingly similar to TUMBLR? D2013-0441

Nature of the test

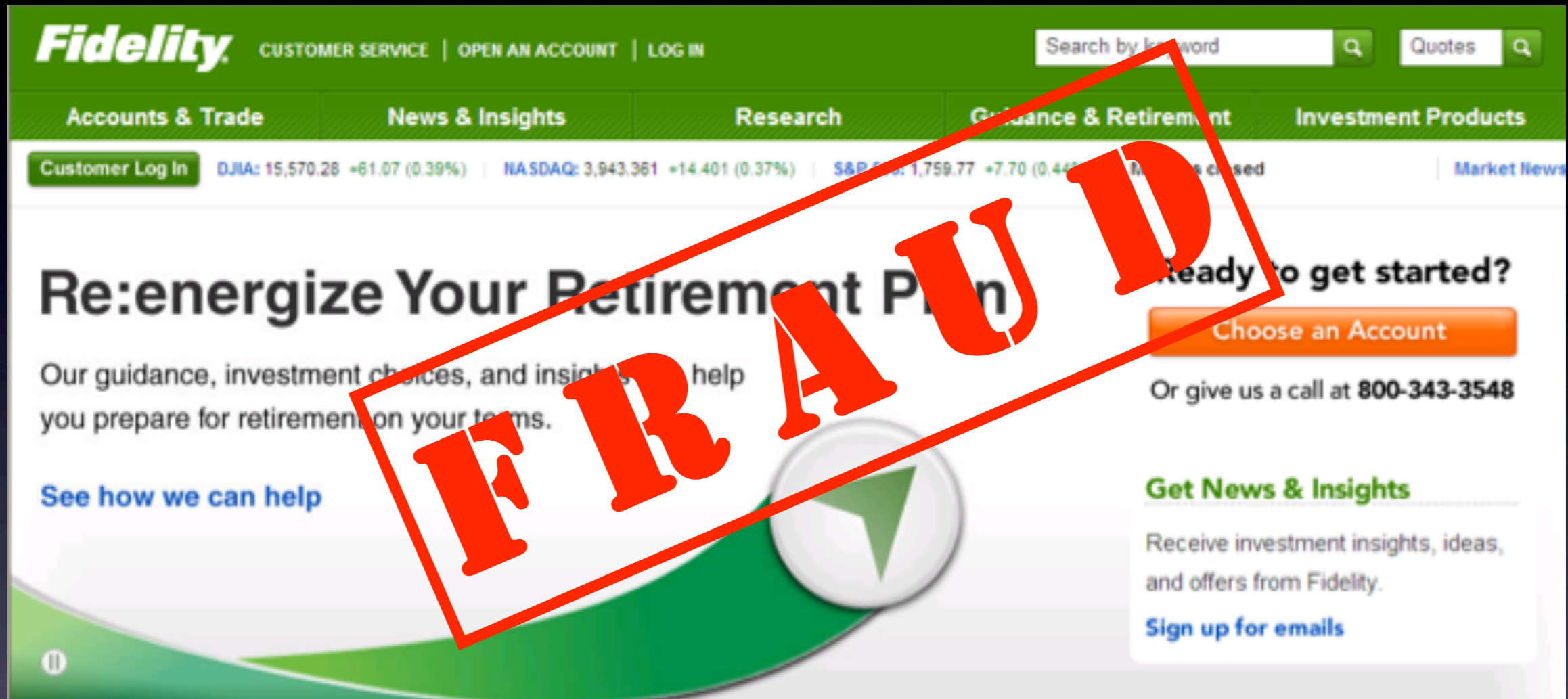
- standing requirement
- comparison between TM and domain name to assess likelihood of confusion
- straightforward visual or aural comparison
- TM must be recognisable
- website content generally irrelevant

Likelihood of confusion

The screenshot shows the website for 'OCCUPIED CHICAGO TRIBUNE'. The logo features a stylized 'O' and 'T' in red and blue. The tagline 'Media for the 99%' is in the top right. The navigation menu includes 'Home', 'News', 'Features', 'Commentary', 'Announcements', 'Issue 4', and 'Issue 3'. A search bar is on the right. The main content area features a large article titled 'All Charges from Occupy Chicago Mass Arrests at "The Horse" Dismissed' with a sub-headline '(0)'. The article text states: 'The mass midnight arrests of Occupiers in October at Grant Park were ruled unconstitutional by a Chicago court Thursday. The two nights of actions were part of a spirited attempt to "Take the Horse" (a reference to The Bowman statue) and set up an encampment in Chicago.' To the right, a 'Recent Stories' section lists: 'Rahm's Strike Commercial Misses the Mark', '"We Fought the City with Gatorade and Water": A History of Parent Action', 'What the CTU Contract Means for the Families of CPS', 'What's Going On? A Legal Explanation of Injunctions, Sympathy Strikes, and More', and 'Strike Day 9: Tuesday Events'. Below the article is a carousel of four smaller article thumbnails with titles: 'All Charges from Occupy Chicago Mass Arrests at "The Horse"', 'Rahm's Strike Commercial Misses the Mark', 'What the CTU Contract Means for the Families of CPS', and 'Strikebot Makes Rahm's Head Spin'.

WIPO Case No. D2012-1076
<OccupiedChicagoTribune.org>

Likelihood of confusion



WIPO Case No. D2013-0459
<fidelity-allows-fraud.com>

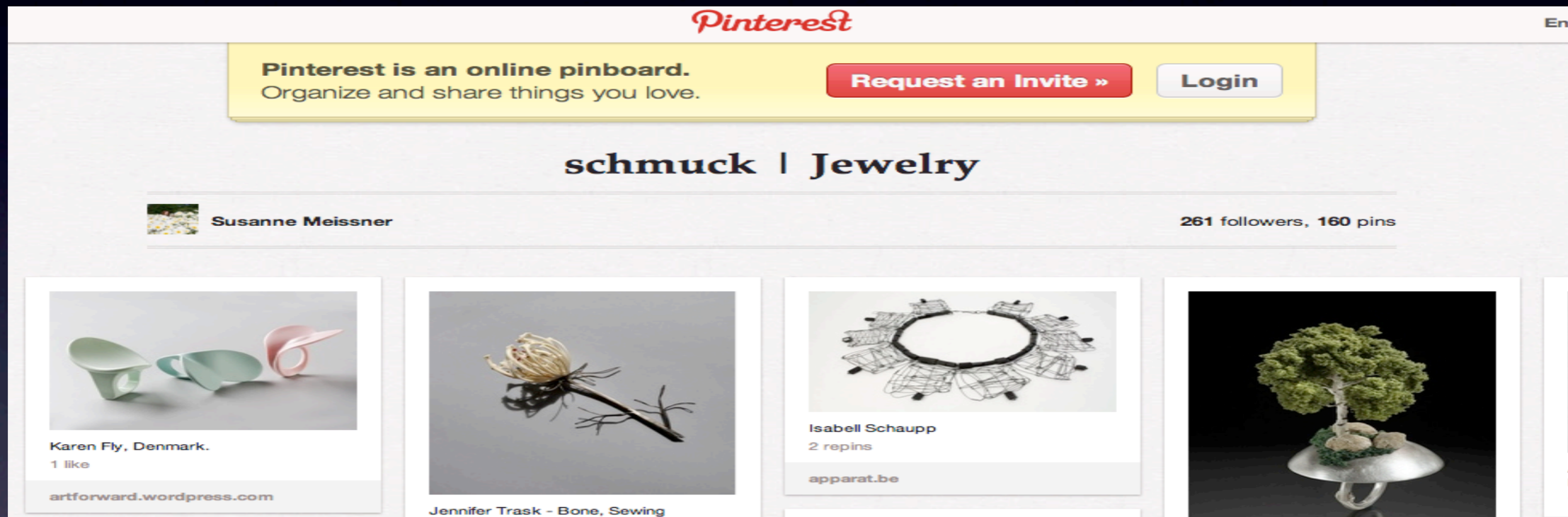
Likelihood of confusion

One view: You don't need to look for likelihood of confusion. *“When a domain name wholly incorporates a complainant's mark, it is sufficient to establish confusing similarity for purposes of the UDRP”*
(WIPO Cases Nos. D2011-0771 <gqbar.com> and D2000-0662 <wal-martsucks.com>)

Another view: *“Is it likely that, because of the similarity between the domain name on the one hand and the Complainant's trademark on the other hand, people will wonder whether the domain name is associated in some way with the Complainant?”*
(WIPO Case No. D2007-0648 <ambienwatch.org> and <ambienisdangerous.com>)

Others find confusing similarity because non-English speakers may not recognize the word as a pejorative.

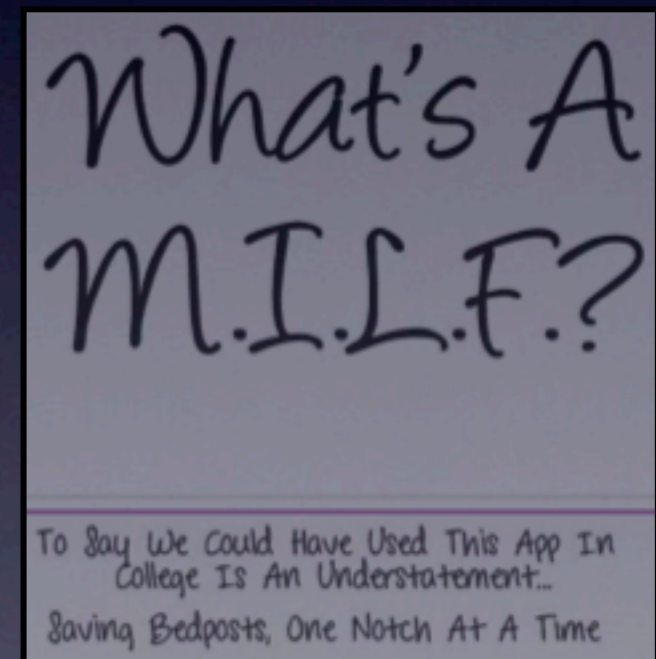
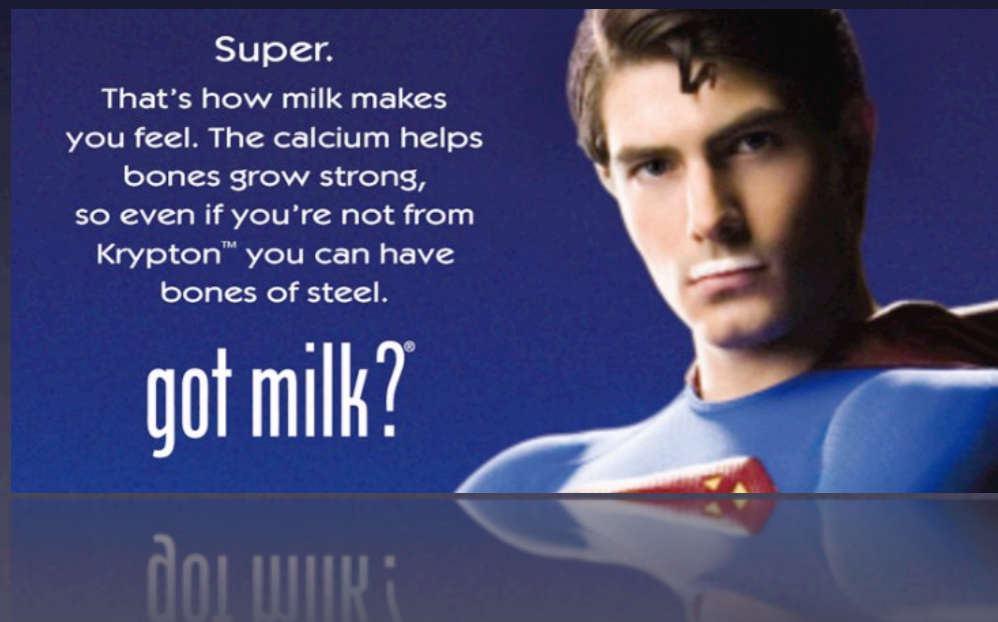
significance of language



WIPO Case No. D2013-0741
<swarovskischmuckoutlet.com>

Likelihood of confusion

“The Panel majority concludes that an Internet user confronted with this Domain Name is likely to be grinning, or groaning, or nonplussed - not confused”



WIPO Case No. D2012-2285
<gotmilf.com>

Website content

WIPO Overview 2.0, Paragraph 1.2 – “The content of a website (whether it is similar to or different from the business of a trademark holder) would usually be disregarded in the threshold assessment of risk of confusing similarity under the first element of the UDRP, although such content may be regarded as highly relevant to assessment of intent to create confusion (e.g., within a relevant market or language group) under subsequent UDRP elements (i.e., rights or legitimate interests and bad faith).”



WIPO Case No. D2008-1267 <HairyWinston.com>

Website content

Welcome to :::: RapidPiracy # 1 Community For Desi Pirates! ::::

There are many great benefits that are not available to guests at RapidPiracy.com including:



- Download Apps, Cracks, Serials etc.
- Download Bollywood, Hollywood & Tollywood DVD Movies, Latest Videos & Music
- Adult Pics, Clips, DVDs & Premium website Passes
- Rapidshare, Megaupload Premium Accounts
- Deal and Buy in Marketplace All Kind Of Stuff

Easy way to get Rapidshare Premium Account for Indians,
Use free Rapidshare download Service without Premium Account
<http://rspremiumdownload.com>

Board Index

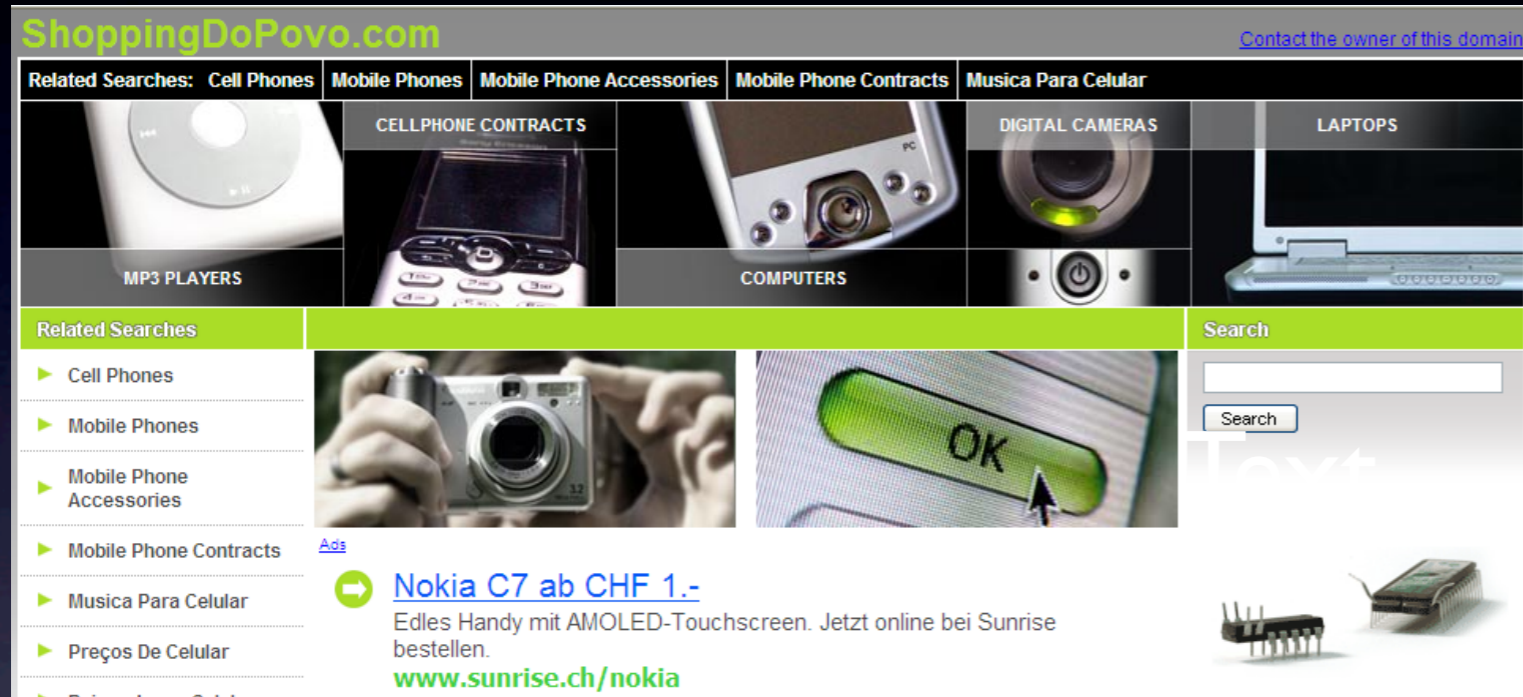
· ShoutBox Rules - Please do not trade or share ids in Sh !!! Instead use PM system !!! Yaha pe Dadagiri karna mana hai!!!!!!

(last edit - 100 July 2010 - 11:13 AM)
please help

is <rapidpiracy.com
confusingly similar to
RAPID SHARE™ ?

WIPO Case No. D2010-1089 <RapidPiracy.com>

Disclaimers



“Shopping for the People”



WIPO Case No. D2011-0734
<shoppingdopovo.com>

Device Marks

Case details for Community Trade Mark E3575867

[Explanation of terms used on this page](#)

Mark



Mark text:

CONSEJO REGULADOR CAVA

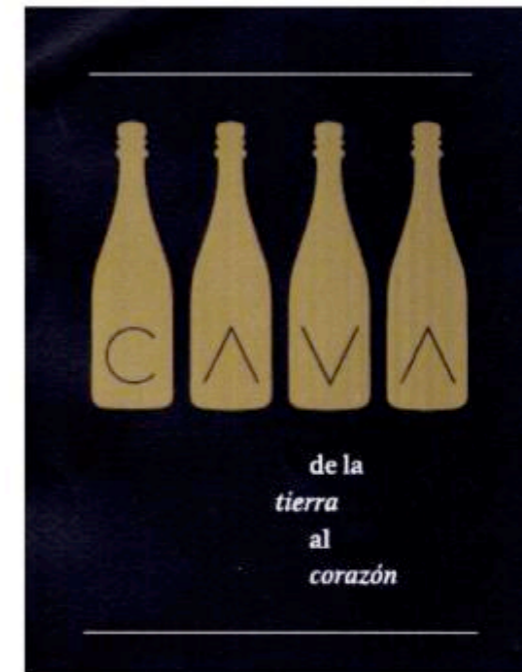
Description of colours
claimed:

Gold, green.

Case details for Community Trade Mark E6968036

[Explanation of terms used on this page](#)

Mark



Mark text:

CAVA DE LA TIERRA AL CORAZON

Description of colours
claimed:

Golden, black, white.

WIPO Case No. D2008-1939 <cava.com>

Rights or Legitimate Interests

Paragraph 4(c) of the UDRP

bona fide offering of goods or services - para. 4(c)(i)

use of own name - para. 4(c)(ii)

“legitimate noncommercial or fair use of the domain name without intent for commercial gain to misleadingly divert consumers or to tarnish the trade mark or service mark in issue” - para. 4(c)(iii)

bona fide offering

MINE spec
Compliant · Cost-effective · Convenient

1300 938 540

HOME | ABOUT US | PRODUCTS | SOLUTIONS | SPECIALS | CONTACT US

VEHICLE SOLUTIONS
Custom designs & solutions to meet your needs & budget

REQUEST A QUOTE
A Minespec representative will contact you within 3 hours*

MINESPEC PRODUCTS
We offer Australia wide shipping on all Minespec products

COMPLIANT MINE FITOUTS FROM \$5,995*

rebutting a
prima facie
case

WIPO Case No. DAU2012-0019 <minespec.com.au>

bona fide offering

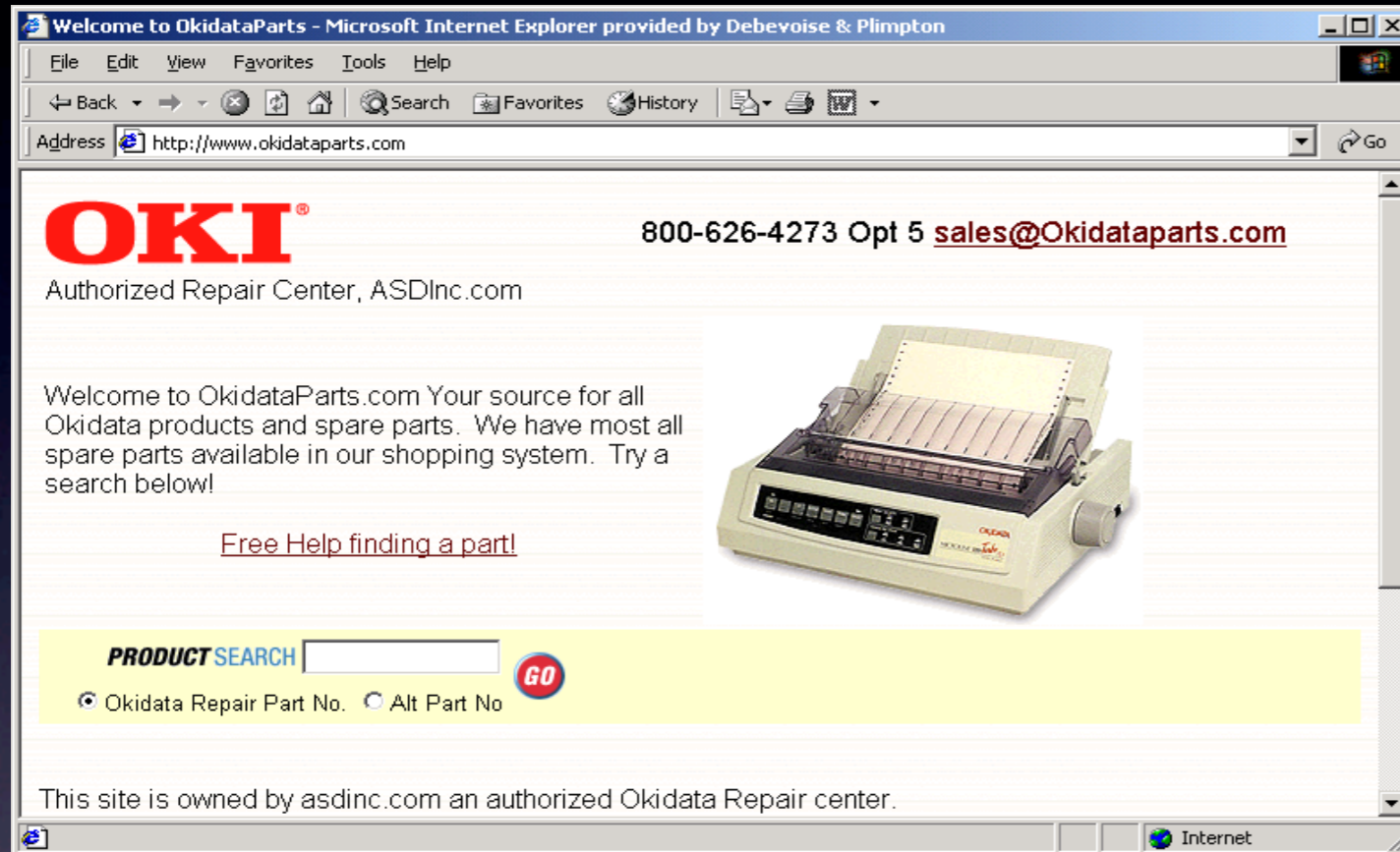
The screenshot shows the website **yahclick.co.uk** with a navigation menu on the left and a search bar on the right. The main content area displays several search results for advertising services:

- Neukundengewinnung mit Tweasy-App.** Neue Kunden gewinnen & Kundenbindung stärken. Hier testen! kmu-businessworld.ch/Tweasy
- Der Freelancer Marktplatz** Jetzt kostenlos Profil erstellen Sofort online Aufträge finden! www.twago.de/Auftrag-finden
- Werbeartikel Suchmaschine** Über 2500 Werbeartikel für Ihre Kunden und Mitarbeiter www.bbtrading.ch
- Mehr Motivation & Erfolg**

The website also features a search bar with a "Suchen" button and a "Genauere Suche" (More precise search) section with various categories like "Werbung Online", "Partnerprogramme", "Bannerwerbung", etc.

WIPO Case No. D2013-0570 <yahclick.com>

Resellers



Must actually offer branded goods or services at issue

Website must sell only the branded goods

Site must accurately disclose relationship with trade mark owner

Cannot seek to corner the domain name market in all permutations

WIPO Case No. D2001-0903
<OkidataParts.com>

Resellers



Must actually offer branded goods or services at issue **PASS**

Website must sell only the branded goods **FAIL**

Site must accurately disclose relationship with trade mark owner **FAIL**

Cannot seek to corner the domain name market in all permutations **PASS**

WIPO Case No. D2012-1202
<Birkenstock-China.com>

use of own name

Massage Boxing Tata Massage
Face Slapping Natural

Don't give a care if you want to be beautiful. Don't give a care if you want to be handsome.

HOME **ABOUT TATA** **SERVICES** **MEDIA** **CONTACT US**

Welcome
Open 8am
Close 6pm
Closed on Mondays
Call to make an appointment:
781-632-8585
781-632-8228
415-742-0644

MAWIN
CHANALURDPATTAWEE
NEW SERIES WORLD
San Francisco, CA USA
781-632-8228
781-632-8585
415-742-0644

Massage Boxing

TATA
RASSAMEESAITARN
NEW SERIES WORLD
San Francisco, CA USA
781-632-8228
781-632-8585
415-742-0644

Rules
Attention Customers

1. Face Slapping consultation fee **\$5** before treatment.
2. Before we start your treatment, you will know the expectations of your results. The words "no results" or "no change" is impossible. If we accept to start your treatment, you need to take before and after photo, follow the store's rules, and sign your name as proof of agreeing to the results that were discussed before treatment.

Full Course \$1,000/4 times within a month
Firming \$350/1 time
Specific area \$350/1 time

WIPO Case No. D2012-2467 <tatamassage.com>

Gripe/Tribute Sites

View 1: The right to criticize does not necessarily extend to registering and using a domain name that is identical or confusingly similar to the complainant's trademark. That is especially the case if the respondent is using the trademark alone as the domain name (*i.e.*, <trademark.tld>) as that may be understood by Internet users as impersonating the trademark owner.

Gripe/Tribute Sites

andreasfrei.net

Deutsch

English

Whistleblowing

**Willkommen bei Dr. med. Andreas Frei
Oberarzt Forensischer Dienst Luzerner Psychiatrie**

Was ich zu bieten habe:

Teil 1: Interview im Blick

Teil 2: Vernichtung einer Existenz

Teil 3: Escholzmatt, 5 Tote

Teil 4: Schübelbach, 1 Tote



WIPO Case No. D2013-0560 <andreasfrei.net>

Gripe/Tribute Sites

View 2: Irrespective of whether the domain name as such connotes criticism, the respondent has a legitimate interest in using the trademark as part of the domain name of a criticism site if such use is fair and noncommercial.

Gripe/Tribute Sites

Towersonthepark WIPO Decision Why I do this.
Voting regulations Page 316 and 317



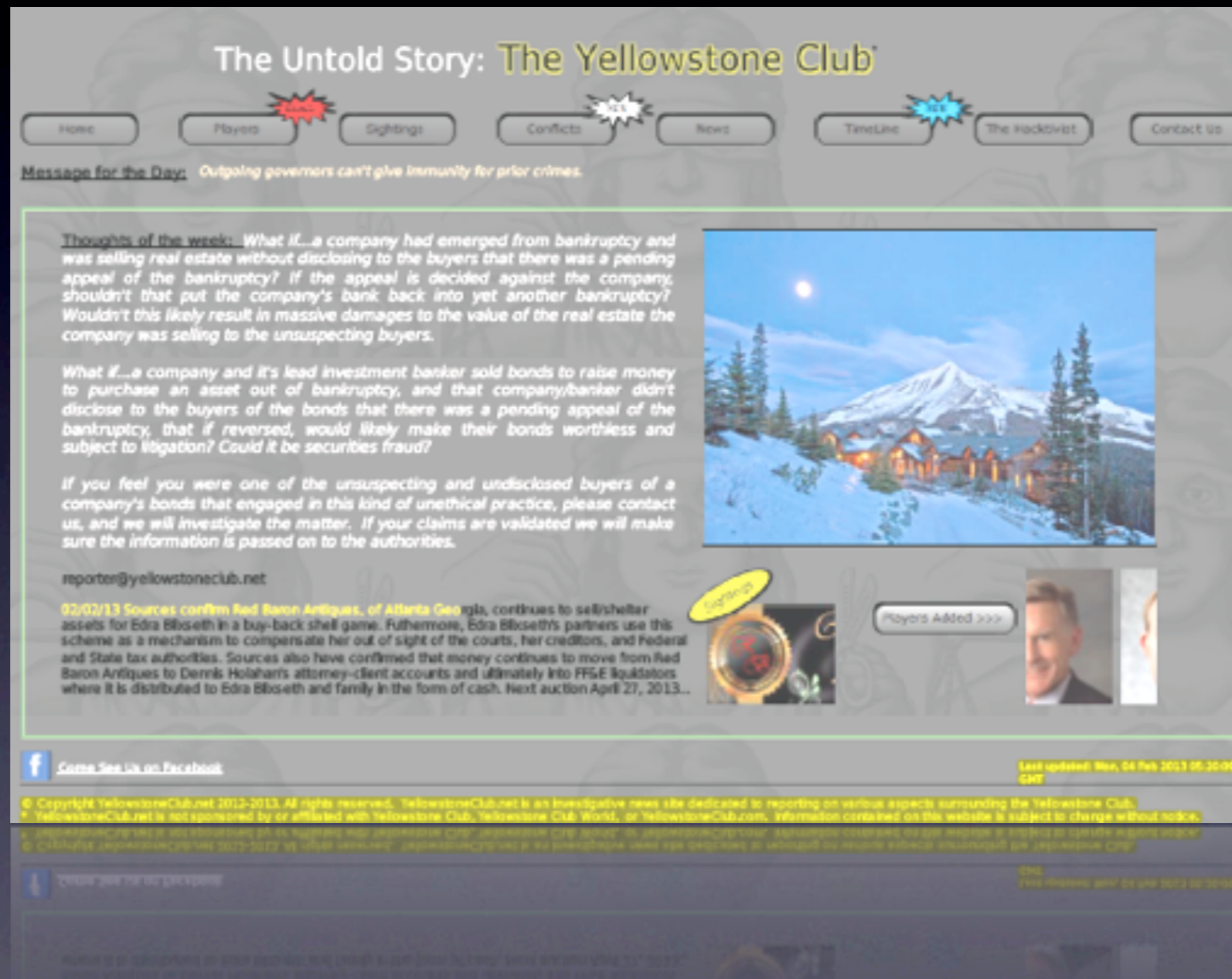
Towers on the Park

Disclaimer: This website is not an official website of Towers On The Park Condominium . It is not written by the board of directors, on site manager, or the building's management company. It is written by me, Paul Adao, with help from friends and homeowners. I try to keep it factual but I am not perfect. I ask you or anyone connected to Towers On The Park to write to me so we can keep this website factual. This is the third disclaimer on this site and from the first day I have always had a disclaimer on this site.

I have always had a disclaimer on this site.
The Park to write to me so we can keep this website factual. This is the third disclaimer on this site and from the first day
from friends and homeowners. I try to keep it factual but I am not perfect. I ask you or anyone connected to Towers On
board of directors, on site manager, or the building's management company. It is written by me, Paul Adao, with help
Disclaimer: This website is not an official website of Towers On The Park Condominium . It is not written by the

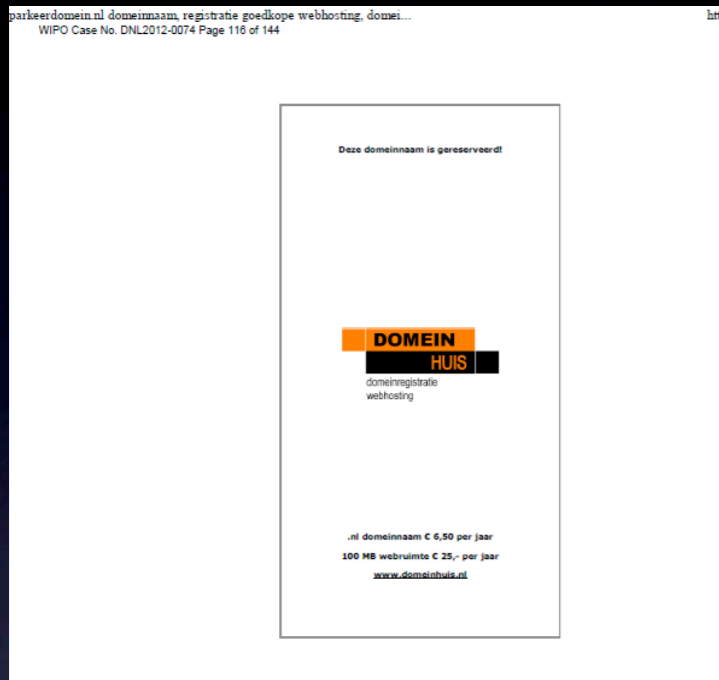
WIPO Case No.
D2012-1054
<TowersOnThePark.com>

Gripe/Tribute Sites



WIPO Case No. D2013-0097
<YellowstoneClub.net> and <YellowstoneClubScandal.com>

Fair Use or Foul?



“My little nephew made this sound”



WIPO Case No. DNL2012-0074 <MiuMiu.nl>

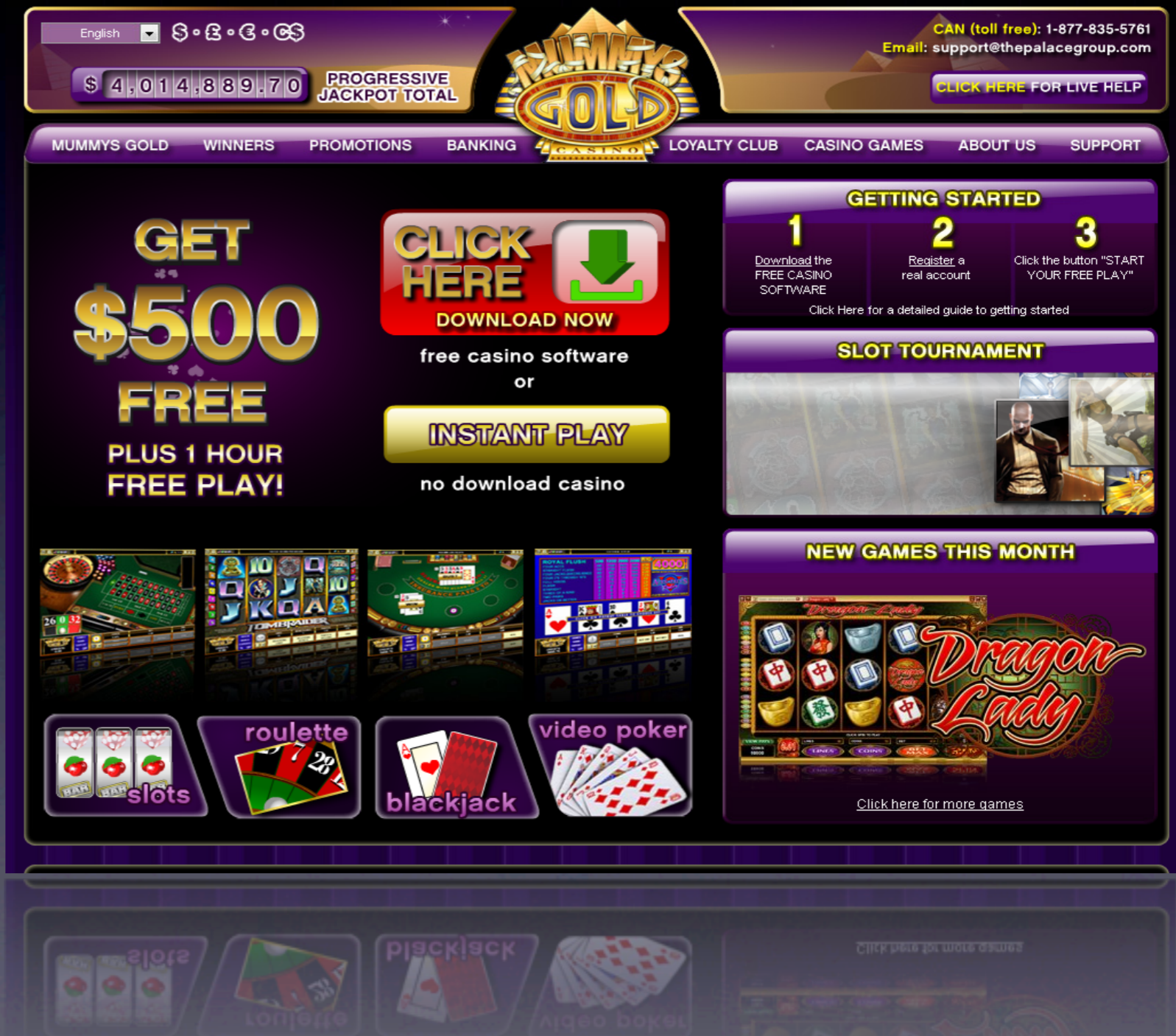
The Third Element

The Conjunctive Requirement

“The Domain Name was registered
AND is being used in bad faith”

Conjunctive Requirement

WIPO Case No.
D2009-0643
<mummygold.com>



Conjunctive Requirement

D2009-1278 <parvi.org> Christie

NAF 1282148 <denverpostjobs.com> Franklin, Bernstein, Kuechenmeister

D2009-1413 <validas.com> Limbury

D2009-1455 <torus.com> Smith

D2009-1688 <sporto.com> Lyon

D2009-1716 <walkydogusa.com> Willoughby

D2010-0217 <trueroots.com> Barker, Limbury; **Donahey dissent**

D2010-0470 <bgt.com> Rothnie, Harris, Samaras

D2010-0800 <ferrlecit.com> Turner, Smith; **Donahey dissent**

D2010-1001 <jappy.com> Perkins, Christie, Clark

D2010-2011 <lionsden.com> Blackmer, Bernstein, Sorkin

D2010-2069 <simplybusiness.com> Abbott, Swinson; **Christie dissent**

D2011-0219 <1000places.com> Bernstein

D2012-0771 <sidetrack.com> Michaelson, Fong, Willoughby

D2012-0918 <dealz.com> Swinson

Paragraph 2

“By applying to register a domain name, or by asking us to maintain or renew a domain name registration, you hereby represent and warrant to us that ... (b) to your knowledge, the registration of the domain name will not infringe upon or otherwise violate the rights of any third party; (c) you are not registering the domain name for any unlawful purpose; and (d) you will not knowingly use the domain name in violation of any applicable laws or regulations. It is your responsibility to determine whether your domain name registration infringes or violates someone else’s rights.”

Paragraph 2

- what is the UDRP?
- is paragraph 4 a discrete self-contained ADR procedure?
- does paragraph 2 have a part to play?
- registration, maintenance and renewal of domain names
- Respondent obligation to conduct trade mark searches?

Renewals



WIPO Case NO. D2009-1688 <sparto.com>

Maintenance

if 'renewal'

is akin to 'registration'

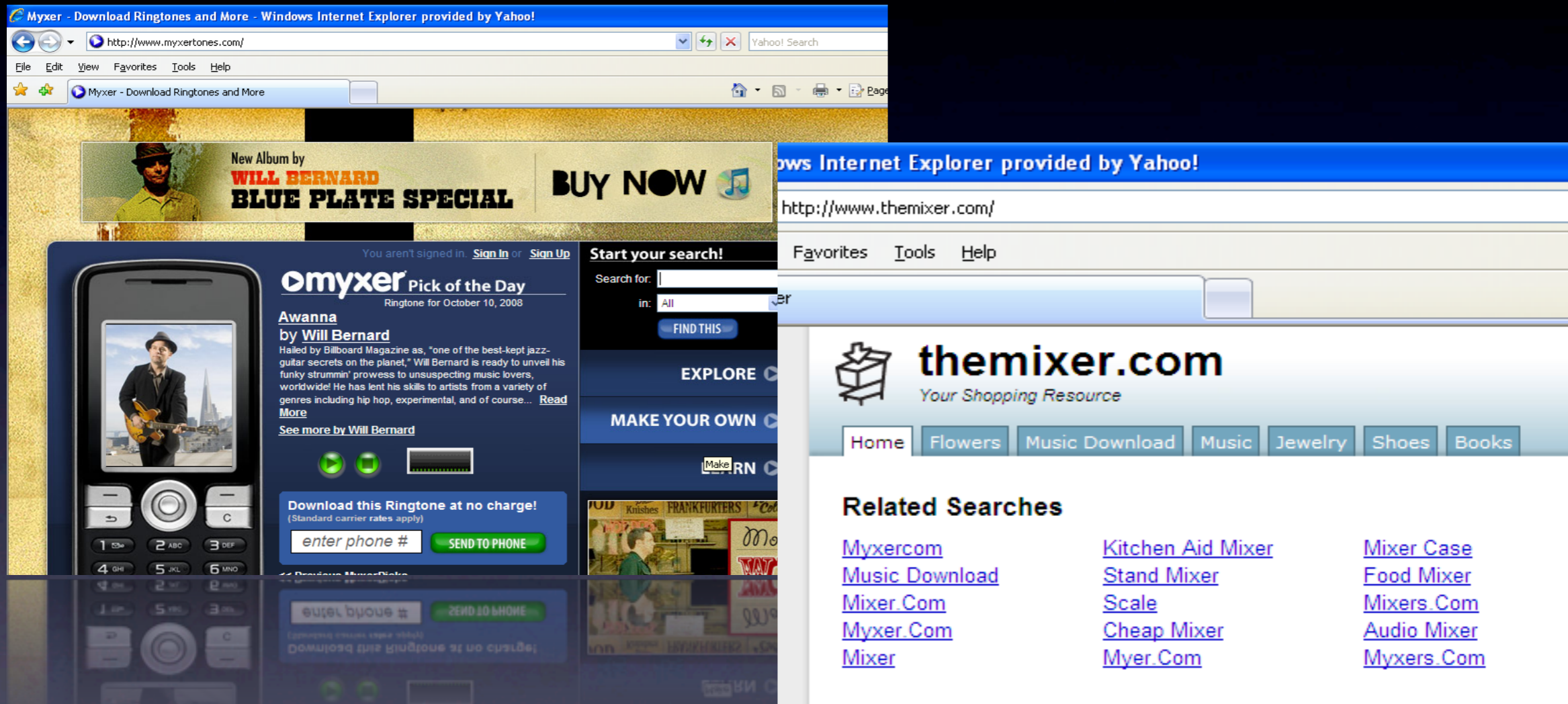
for this purpose, what about
'maintenance'?

WIPO Case NO. D2009-1688 <sporto.com>

Knowledge

- Actual
- Inferred
- Implied
- Constructive or Deemed

Obligation to search?



WIPO Case NO. D2007-1141 <imyxer.com>

Obligation to search?

http://web.archive.org/web/20050905173015/http://www.backberry.com/

September 4, 2005

information.com
What you need, when you need it

Video Games | Airline Tickets | Hotels | Free Casino Games | Cell Phones | Free Coupons | Online Gambling

Popular Links

- Video Games
- Airline Tickets
- Hotels
- Free Casino Games
- Cell Phones
- Free Coupons
- Online Gambling
- Jewish Singles
- Work From Home
- Finance

Popular Categories

Video Games	Airline Tickets	Hotels
Free Casino Games	Cell Phones	Free Coupons
Online Gambling	Jewish Singles	Work From Home
Finance	Christian Singles	Texas Holdem
Car Rental	Free Credit Report	Online Banking
Weight Loss	Casino	Car Insurance

Favorite Categories

Travel	Money Savers	Gambling
Airline tickets	Online Banking	Free Casino Games
Hotels	Online Payment	Poker
Car Rental	Debt Consolidation	Texas Holdem
Air Charter	Foreclosures	Blackjack
South Beach Hotels	Free Credit Report	Casino

Services

- [Car Insurance](#)
- [Mortgage](#)
- [Business Opportunities](#)
- [Life Insurance](#)
- [Work from Home](#)

Leisure

- [Music](#)
- [Dating](#)
- [Christian Singles](#)
- [Cell Phones](#)
- [Jewish Singles](#)

Learn More

- [Real Estate Training](#)
- [College](#)
- [Weight Loss](#)
- [Alcohol Treatment](#)
- [MCSE Certification](#)

Search: Search

WIPO Case No.
D2009-0320
<backberry.com>

Session Outline - part 2 - Nominet

- Rights
- Similarity
- Gripe/Tribute Sites
- Appeals
- Review of the Overview & the Policy

Rights

- “in respect of a name or mark”
- enforceable by complainant
- *<ireland.co.uk>*
- *<hvidbro-mitchell.co.uk>*
- “whether under English law or otherwise”
- uniformity across jurisdictions?

Contractual Rights



DRS 4632 <ireland.co.uk>

Rights

- “in respect of a name or mark”
- enforceable by complainant
- *<ireland.co.uk>*
- *<hvidbro-mitchell.co.uk>*
- “whether under English law or otherwise”
- uniformity across jurisdictions?

Data Protection Act etc.

Outstanding Debts encapsulated in Court Orders and Judgments owed by Simon Hvidbro-Mitchell

I have created this site to highlight how my ex-husband Simon James Hvidbro-Mitchell (previously known as Simon James Mitchell) has not paid [court orders and judgments](#) relating to his two children. These child maintenance debts have been accruing since 2004 and are in excess of £78,000 including interest and costs. Interest accrues at a daily rate of £11.98 which equates to an annual rate of £4372.70. In addition Mr Hvidbro-Mitchell also has child maintenance arrears through the [CSA](#) of £1982.28 (as of 10th Dec 2012), so in total owes me more than £80,000. Mr Hvidbro-Mitchell claims to be unemployed therefore the CSA assessment has been set back to £0.00 per week - this is the subject of a forthcoming Tribunal Hearing.

Simon has not had any contact with his children Scarlett and Jamie (pictured above) for the past 13 years which has upset them greatly over the years. Neither has he made regular maintenance payments during this time.

Child Support Agency

From July 2005 through until January 2012 I didn't receive any CSA maintenance until the arrears team tracked Simon Hvidbro-Mitchell down and started collecting £100pcm to clear arrears. On a number of occasions and until recently the [CSA](#) have advised that he claims he is not working and that his parents are supporting him. However I demonstrated to the [CSA](#) that his lifestyle was not in keeping with his lack of income and showed that his two children from his 3rd marriage are attending a local independent school in Maidstone with fees in the region of £2000pcm for 2 children. They then assessed him at £131pcm based on this information. I received this first payment mid Sept 2012. However, in an attempt to get this assessment set aside, on 15th October, Mr Hvidbro-Mitchell advised the [CSA](#) that he does not pay school fees for his children, but his ex-partners family did. This is now in the throes of a Tribunal Hearing (date yet to be set)

On 6th September 2012 his solicitor commented that Mr Hvidbro-Mitchell was working as a contractor. I subsequently sent the correspondence from his solicitor to the [CSA](#) to prove that he was actually working after all, despite his claims to the contrary. Material I received on 22nd February 2013 in relation to a forthcoming CSA Tribunal hearing showed that Mr Hvidbro-Mitchell's contract of employment started in March 2012.

After I notified the [CSA](#) that Mr Hvidbro-Mitchell was indeed working they managed to contact him and he advised them that he only earns £151 per week contracting in Saudi Arabia.

On 16th November 2012 his solicitor stated that his contract had been terminated as a result of my actions. In December the [CSA](#) advised that Mr Hvidbro-Mitchell had stopped making payments as he claimed his contract had been terminated due to my website and was thus unemployed. This is also the subject of a Tribunal Hearing.

I have posted the documents from the [CSA](#) on the Child Support Agency tab above. Further pertinent Tribunal Material will be posted shortly.

Family Background Information

Simon has been married 3 times with 2 children from each marriage. I believe he does not have any contact with his children from his first marriage either. This is based on discussions that the 4 children have had amongst themselves about their father

Scarlett and Jamie have stayed in contact with his parents (their grandparents) and have frequently spent holidays at their home in Maidstone. Jamie has implored his grandmother to facilitate contact with his father, but nothing has ever been forthcoming. Jamie has been desperately hurt by the absence of his father in their life. Scarlett doesn't remember her father as he left when she was only 2 years old. Sadly, Christmas 2012 came and went without any contact, card or present from their grandparents, unlike in previous years.

DRS 12276 <hvidbro-mitchell.co.uk>

Rights

- “in respect of a name or mark”
- enforceable by complainant
- *<ireland.co.uk>*
- *<hvidbro-mitchell.co.uk>*
- “whether under English law or otherwise”
- uniformity across jurisdictions?

Similarity

Ryanair, the World's most hated airline, have launched a new website design that resembles a steaming pile of cat puke on the pavement.



DRS 8527 <ihaternair.co.uk>

Gripe/Tribute Sites

- “Fair use may include sites operated solely in tribute to or in criticism of a person or business” Policy 4(b)
- <*rayden-engineering.co.uk*>
- <*ihateryanair.co.uk*>
- <*opticalexpressruinedmylife.co.uk*>
- Experts’ Overview 4.8

Appeals

- the Expert Review Group
- “new evidence”
- appeals from summary decisions
- appeals to the Court

Review of the Overview & Policy

- Annual meetings of the Expert Review Group
- Annual Experts' meetings
- The Experts' Overview
- Nominet Consultation Process

thank you