

MASTERCLASS

Presentation by The Hon Neil Brown QC
For
Canadian International Internet Dispute Resolution Centre
9 December, 2021
Domain Name decisions from the CIIDRC



CIIDRC is accredited by ICANN to administer UDRP disputes



CDRP

Dispute resolution under the CIRA Domain Name Dispute Resolution Policy

The CDRP is the administrative procedure set up by [CIRA](#) to assist individuals and businesses that meet CIRA's [Canadian Presence Requirements](#) in obtaining quick, out-of-court and low-cost dispute resolution of bad faith registration of .CA domain names by filing a complaint under the CDRP.

 [CDRP Process](#)

 [CDRP Rules](#)

 [File a CDRP Complaint](#)

UDRP

Dispute resolution under the Uniform Domain Name Policy

The UDRP is the administrative procedure set up by [ICANN](#) for resolution of disputes that arise from abusive registrations of domain names (for example, cybersquatting). The UDRP is an effective tool for obtaining domain name rights which can be addressed by filing a complaint under the UDRP.

 [UDRP Process](#)

 [UDRP Rules](#)

 [File a UDRP Complaint](#)

- The presentation is about decisions made in UDRP cases administered by CIIDRC.
- CIIDRC's first UDRP decision: 30 Dec. 2019. In 2 years, an impressive array of decisions has been made.
- There are now 42 decisions by CIIDRC panellists on most of the major issues that arise: a great achievement.
- Decisions are not precedents, but are illustrations of what panels have decided in previous cases.
- Some trends emerge and, of course, the decisions show how panels may well decide a case on similar facts in the future.
- Where are the decisions? At:
<https://ciidrc.org/domain-name-disputes/ciidrc-decisions/>
- Who has made these decisions? Panellists appointed by CIIDRC under the UDRP and its Rules.
- Are decisions of 3- person panels more significant than 1-person panels?
- A useful source. *G. Levine, Domain Name Arbitration, Second Edition.*



THE NEED FOR EVIDENCE

- The most important principle is that Complainants must prove all 3 of the 3 elements set out in Paragraph 4(a) of the UDRP.
- “In the administrative proceeding, the complainant must prove that each of these three elements are present.”
- *Daiso Canada Co., Ltd v. Fairchild Property Group Ltd.* UDRP-15164 (CIIDRC’s number), 17 May 2021, <**daisocanada.com**>, DAISO. The claim failed because there was no evidence of the agreement under which the Domain Name had been registered, its terms or how it was terminated.
- Now we turn to the three elements that the Complainant must prove under the UDRP.

FIRST ELEMENT: THE DOMAIN NAME IS IDENTICAL OR CONFUSINGLY SIMILAR TO THE COMPLAINANT'S TRADEMARK. REGARDED AS A REQUIREMENT TO GIVE STANDING

The Complainant must prove its trademark. A common law TM is adequate, if proved. A mere name is not enough.

- *Agreema Inc. v. Joel Kapongo* UDRP-15075, 27 May 2021, <agreema.com>, AGREEMA.
- *Parliam Bank v. CJ Stone*, UDRP-14475, 18 Jan 2021, <jaybloombuffoon.com>, no TM of JAY BLOOM proved.
- *Adrianus Theodorus van Dorp v. MailPlanet.com, Inc.* UDRP-15988, 20 Sept 2021, <vandorp.com>, no TM of VAN DORP proved.

Nor are mere applications for TMs or TMs on the USPTO Supplementary Register adequate:

- *Graham v. Machotech / Luna Morgan*, 16308-UDRP, 28 Nov.2021.
- *Bijouterie Langlois v. Webproaction*, UDRP-15634, <bijouterielanglois.com>, 1 Aug. 2021

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PROOF OF A TRADEMARK:

If the TM is registered, it is easy to prove, by registration certificates.

But if a common law TM, it must be proved by evidence.

- *Unemployed Professors v. Francis Kamau*, UDRP- 14887, 7 April 2021, <unemployedprofessors.net>. Transfer.
- *Unemployed Professors v. Alexander Ershov*, UDRP-15264, 14 May 2021;<unemployedporfessores.com>; 9 years in business; written up in commentary websites like Slate as “global leader” in “original custom essay writing.” Transfer.

Often, the common law trademark will have to be proven from complex commercial facts. As in:

- *Haydee Muñoz v. Gianni De Santis* UDRP-14529, 2 March 2021, <mayokarealty.com>. The claimed TM was Complainant’s company name she had used in her business.
- *Jeffrey Edwin Poss v. Jim Laffoley*, UDRP-9149, <caltoncases.com>, 17 March 2020, CALTON CASES.

When the trademark is proved, and the Complainant has standing, it must then prove that the domain name is identical or confusingly similar to its trademark.

Prior decisions have set out some presumptions:

(a) If the domain name contains the whole of a distinctive TM, it is presumed to be confusingly similar.

- *Arbec Forest Products Inc. v. Gilbert Tremblay*, UDRP-15163; <lapetitionarbec.com>; 11 May 2021; ARBEC.

(b) Typosquatting will lead to finding confusing similarity:

- *Lassonde Industries v. Morex*, UDRP-15450, 16 June 2021, <lassnode.com>, LASSONDE.
- *Unemployed Professors v. Alexander Ershov*, UDRP-15264, 14 May 2021, <unemployedporfessors.com>, UNEMPLOYED PROFESSORS.
- *Traxys North America LLC v. Joao Mota Inc*, UDRP-14373, 15 Jan. 2021, <tarxys.com> TRAXYS.

NOTE: the claim may fail: ***Graham v. Machotech / Luna Morgan*, 16308-UDRP, Nov. 28, 2021, GRAHAM.**

SECOND ELEMENT: RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTERESTS IN THE DOMAIN NAME

CRITERIA FOR AN RLI:

- (i) BONA FIDE OFFERING OF GOODS AND SERVICES OR
DEMONSTRABLE PREPARATIONS TO USE IT FOR: PARA 4 (c) (i)
 - *Arbec Forest Products Inc. v. Gilbert Tremblay*, UDRP-15163, 11 May 2021, <lapetitionarbec.com>. The defence failed, as use in an industrial dispute is not a *bona fide* offering of goods or services.
 - *Eric Turvey (VP Unemployed Professors) v. Rowley Smith* UDRP-12953, 21 Sept. 2020, <unemployedprofessors.org>. Defence failed for lack of evidence.

DEMONSTRABLE PREPARATIONS TO USE THE DOMAIN NAME FOR A BONA FIDE PURPOSE UNDER PARA 4(c)(i)

Evidence is particularly important and frequently argued.

A question of degree.

Useful: business plan; business name; marketing;
advertising; consultants; employees; paid advice.

Look for high quality evidence on these issues, by Affidavit
or Declaration.

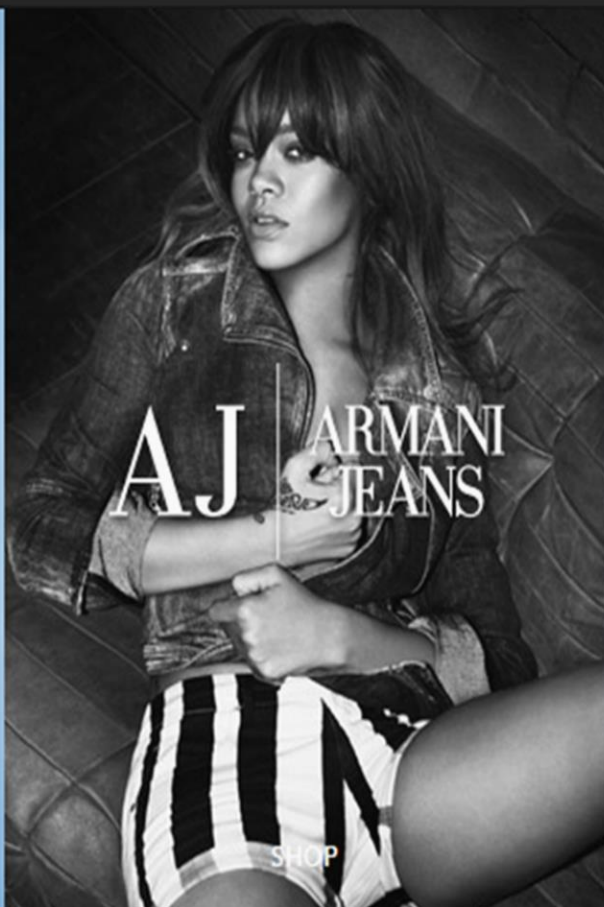


A photograph of a wooden gavel resting on a document titled "AFFIDAVIT". The document is white and lies on a light brown, textured surface. A silver paperclip is visible on the left side of the document. The gavel is made of dark wood and is positioned diagonally across the top right of the document. The word "AFFIDAVIT" is printed in large, bold, black capital letters, slanted upwards from left to right.

AFFIDAVIT

(ii) THE RESPONDENT WAS COMMONLY KNOWN
BY THE DOMAIN NAME: PARA 4(c)(ii)

- *G. A. Modelfine S.A. v. A.R. Mani*, <armani.com>, WIPO Case D2001-0537



(iii) USING THE DOMAIN NAME FOR A LEGITIMATE NON-COMMERCIAL OR FAIR USE: PARA 4 (C)(iii)

Fan sites, gripe sites, political speech, dictionary words.

- *Arbec Forest Products Inc. v. Gilbert Tremblay*, UDRP-15163, 11 May 2021, <lapetitionarbec.com>. That defence failed, as the aim of the DN and the petition was to injure the Complainant by way of a boycott.
- *Levy Zavet LLP v. Unknown*, UDRP-11857, <levyzavetllp.com>, 11 June 2020, LEVY ZAVET

Can be no RLI where the domain name is used for a fraud.

AN ISSUE OF GREAT CONTROVERSY: GENERIC WORDS

- *Klir Platform Europe Limited v. As Identified In the Notification of Commencement* UDRP-15008, 2 April 2021, <klir.com>, KLIR.

Short domain names and acronyms have inherent value. Also, no targeting of the Complainant. Respondent bought the domain name at a public auction. This gave it an RLI in this 4 letter domain name.

The Respondent acquired the domain name before the Complainant acquired its trademark rights; therefore no bad faith registration.

Also, a finding of RDNH against the Complainant, as a Plan B where the Respondent had rejected offers from the Complainant to buy the domain name.

Must the DN be used within the meaning of the generic word itself?

- *E. Arvanitakis & SIA OE (Deltos Publishing) v. Stavros Bazigos*, UDRP-13576,<deltosbooks.com> and <communicateingreek.com>, 20 Oct.2020.

THIRD ELEMENT: BAD FAITH REGISTRATION AND USE

Difficult to prove bad faith registration if the domain name was registered before the TM rights were acquired.

- *Klir Platform Europe Limited v. As Identified In the Notification of Commencement* UDRP-15008, 2 April 2021, <klir.com>, KLIR.

But the defaulting buyer of a business may still have registered the domain name in bad faith.

- *Jeffrey Edwin Poss v. Jim Laffoley*, UDRP-9149, <caltoncases.com>, 17 March 2020, CALTON CASES.

CRITERIA FOR ESTABLISHING BAD FAITH

(i) RESALE: PARA 4 (b) (i)

- *Bijouterie Langlois v. Webproaction*, UDRP-15634, <bijouterielanglois.com>, 1 Aug. 2021; BIJOUTERIELANGLOIS. Extortion.

(ii) REFLECTING THE MARK BEING USED IN THE DOMAIN NAME : PARA 4 (b)(ii)

- *Humdinner, Inc. v. Brett Gould*, 14528-UDRP, 2 February 2021, <humdinner.com>.

BIJOUTERIE PAUL A. LANGLOIS

FABRICANT

DIAMANTS

BAGUES

PERLES

MONTRES

RÉPARATIONS

200

NOTAIRE

Valérie Gravel

Tél. 418 653-2442

CENTUM

210

PAUL A.
Langlois
BIJOUTERIE

PAUL A.
Langlois

ÉTABLI DEPUIS 1953



(iii) DISRUPTING BUSINESS: PARA 4 (b) (iii)

- A clear case in *Sunspace Modular Enclosures Inc. v. Kathy Beaman*, 15868-UDRP, 1 Oct. 2021
<sunspaceofcharleston.com>, SUNSPACE.
 - (a) being a former agent;
 - (b) terminated;
 - (c) retaining the domain name;
 - (d) using the TM;
 - (e) preventing the Complainant from using a domain name for its Charleston business;
 - (f) passing off.

A large yellow sun with wavy lines at its base, partially obscured by the word 'SUNSPACE'.

SUNSPACE

OF
CHARLESTON LLC

843-212-2437

SUNSPACECHARLESTON.COM

- Same, in *Arbec Forest Products Inc. v. Gilbert Tremblay*, UDRP-15163, 11 May 2021, <lapetitionarbec.com> because the petition asked for a boycott, so the intention must have been to disrupt the Complainant's business within Policy 4 (b)(iii).
- *Husky Oil Operations Ltd., v. Emilky Pulse*, UDRP-14889, 13 April 2021, <huskyenergy-inc.com>.

Based on Respondent phishing and redirection to Complainant's site.



(iv) CAUSING CONFUSION IN THE MARKET: PARA 4 (b)(iv)

Seraphim Sense Ltd v. Przemyslaw Siberia, UDRP-12286 -, 3 November 2020.

On bad faith, the conduct of the Respondent showed bad faith. Some of its allegations were proved to be untrue and a simple search would have shown the existence of the Complainant. Implausible for the Respondent to have chosen this name in ignorance. So, in toto, the case comes under 4(b)(iv), confusion.

Engaging in an employment scam:

- *Stantec Consulting Ltd. v. Colin Jackson* , UDRP-12896, 14 Aug. 2020, <stantecgroup.com>
- *Lassonde Industries Inc v. Samuel*. UDRP-14286, 23 Dec. 2020, <lassondes.com>
- *Graham v. Machotech / Luna Morgan*, 16308-UDRP, 28 Nov.2021.

General Bad Faith

- *Autopath Technologies Inc., Melanie Chapple*, UDRP-6911, <carpages.com>, CAR PAGES, 13 Jan. 2020

OTHER ISSUES

1. LANGUAGE OF THE PROCEEDING

The language is that of the registration agreement, unless the Panel determines otherwise.

- *Edutec Limited v. Maria Antonyuk*, UDRP-11941, <24author.com>, 26 April 2020, (Russian trademark).

To determine confusing similarity when the domain name and the TM are in different languages, take the meaning understood by “a considerable part of the public understanding the meaning of the translation.”

2. CONSOLIDATION

Provided for in the Policy itself, at Paragraph 4 (f); discretionary.

Allowed in:

- *Mejuri Inc. v. Sindy Chen, Allen Lee, Tracy Wu*, UDRP-12282, 19 June 2020, <mejurishop.com>, <mejurisale.com>, <mejuristore.com>.

3. EVIDENCE

Can additional evidence be submitted by supplementary submission?

Must show “exceptional circumstances”.

Be careful; sometimes leave is refused.

- *Edutec Limited v. Антонюк Мария Валерьевна* (Maria Antonyuk) UDRP-11941 26 April 2020 24author.com; AEMOP24

4. ALL IS NOT LOST

A domain name may be recovered although the registration was not renewed when due and/or it was hijacked.

- *Seraphim Sense Ltd v. Przemyslaw Siberia*, 12286 -UDRP, 3 November 2020; <angelsensor.com>, ANGEL SENSOR. Copied website and imitated Complainant.

5. PANELIST MAY DO LIMITED PRIVATE RESEARCH; INC. WAYBACK MACHINE

- *Seraphim Sense Ltd v. Przemyslaw Siberia* (supra). Website.

6. UDRP MAY NOT BE USED FOR GENERAL COMMERCIAL DISPUTES

- *Agreema Inc. v. Joel Kapongo*

7. REVERSE DOMAIN NAME HIJACKING (RDNH).

- YES. *Klir Platform Europe Limited v. As Identified In the Notification of Commencement* UDRP-15008, 2 April 2021, <klir.com>, KLIR.
- NO . *Agreema Inc. v. Joel Kapongo*

But is RDNH of any value?

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Remember: “...prove...” and evidence.

Thank you.

Further information: www.domaintimes.info

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