

SALUSSE MARANGONI

SALUSSE, MARANGONI, PARENTE E JABUR ADVOGADOS

WILSON PINHEIRO JABUR

ADRs IN DOMAIN NAME DISPUTES:

FAST, EFFICIENT AND COST-EFFECTIVE TOOLS AGAINST CYBERSQUATTING



MARKPATENT.ORG
AN IP KNOWLEDGE HUB

13th Annual International Seminar

**Intellectual Property Rights
Smart Solutions to GLOBAL Challenges**

Date
17th & 18th
Feb. 2018

Venue
The Ummed Ahmedabad
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Gujarat, INDIA

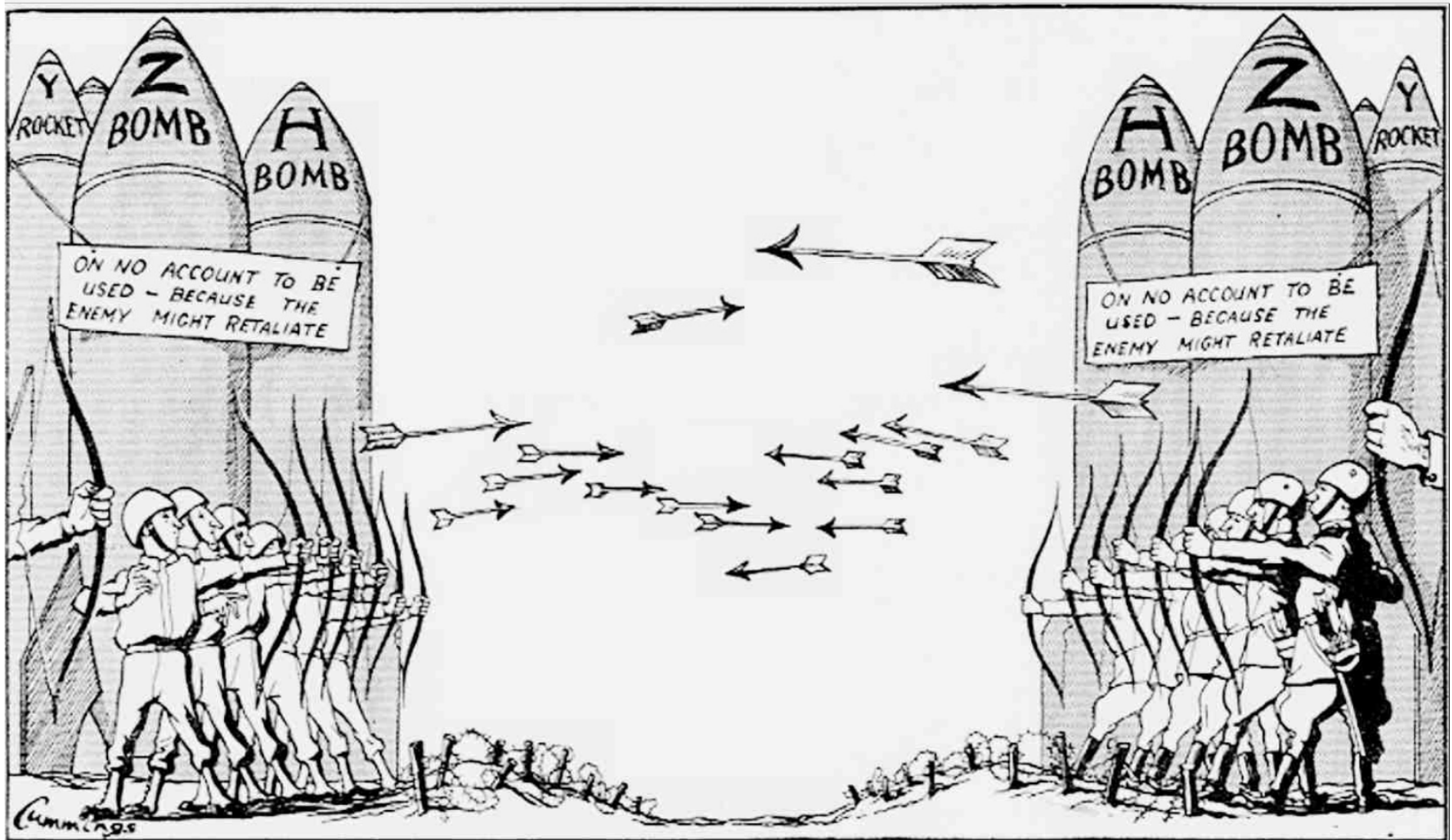
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Summary

- Internet, domain names & **cybersquatting**
- ADRs
 - UDRP
 - URS
 - UDRP+
- Conclusion



The Creation of the Internet



Military phase

- Late 1960's:
 - “*Internetwork*”: experimental project of the U.S. Department of Defense
 - 1969: ARPAnet - *Advanced Research Projects Agency*



Academic phase

- Late 1980's:
 - TCP/IP Protocol: Transmission Control Protocol/Internet Protocol (“unix” language for the transmission and exchange of data between computers)



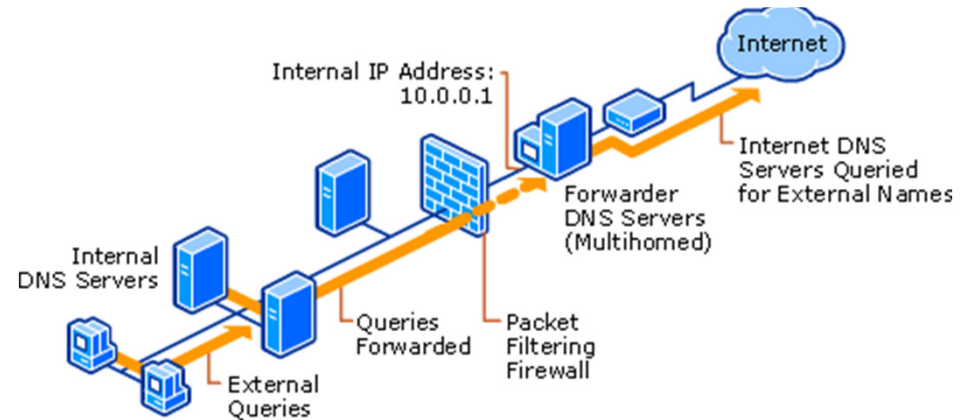
3rd phase



- 1989/1991:
- Tim Berners-Lee creates the WWW language: “*World Wide Web*”, which allows the exhibition of documents as hypertexts.
- *http = hypertext transfer protocol*



D.N.S.



- Every computer on the Internet receives a unique address known as an "IP address", which consists of a numeric sequence.
- The DNS system allows them to be represented by a sequence of letters or combination of letters and numbers, which are the domain names, converting the name entered to the corresponding IP address.



Domain names



- The structure of a domain name at the hypertext transfer protocol usually consists of:

_____ . _____
(core of the name) GTLD

or

_____ . _____ . _____
(core of the name) (SLD) CCTLD

in which:

- *GTLD: generic top level domain*
- *SLD: Second level domain / sub categories*
- *CCTLD: country code top level domain*



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Pessoas Jurídicas

SEM RESTRIÇÃO

AGR.BR	Empresas agrícolas, fazendas
ESP.BR	Esporte em geral
ETC.BR	Empresas que não se enquadram nas outras categorias
FAR.BR	Farmácias e drogarias
IMB.BR	Imobiliárias
IND.BR	Indústrias
INF.BR	Meios de informação (rádios, jornais, bibliotecas, etc..)
RADIO.BR	Empresas que transmitem áudio
ORG.BR	Instituições não governamentais sem fins lucrativos
PSI.BR	Provedores de serviço Internet
DNSSEC OBRIGATÓRIO	
B.BR	Bancos
DEF.BR	Defensorias Públicas
JUS.BR	Instituições do Poder Judiciário
LEG.BR	Instituições do Poder Legislativo
RIO.BR	Rio de Janeiro (em breve)
RIOBRANCO.BR	Rio Branco
SALVADOR.BR	Salvador
SAMPA.BR	São Paulo
THE.BR	Teresina

“.br”: 100+ subcategories

Cidades

Para pessoas físicas ou jurídicas

9GUACU.BR	Nova Iguaçu (a partir de 16/11/2017 12h)
ABC.BR	Região ABC Paulista

FEIRA.BR	Feira de Santana
FLORIPA.BR	Florianópolis
FORTAL.BR	Fortaleza
FOZ.BR	Foz do Iguaçu (a partir de 30/11/2017 12h)
GOIANIA.BR	Goiânia
GRU.BR	Guarulhos
MORENA.BR	Campo Grande
NATAL.BR	Natal

<https://registro.br/estatisticas.html>

Profissionais liberais

Somente para pessoas físicas

ADM.BR	Administradores
ADV.BR	Advogados
ARQ.BR	Arquitetos
ATO.BR	Atores
BIO.BR	Biólogos
BMD.BR	Biomédicos
CIM.BR	Corretores
CNG.BR	Cenógrafos
CNT.BR	Contadores
ECN.BR	Economistas
ENG.BR	Engenheiros
PRO.BR	Professores
PSC.BR	Psicólogos
QSL.BR	Rádio amadores
SLG.BR	Sociólogos
TAXI.BR	Taxistas
TEO.BR	Teólogos
TRD.BR	Tradutores
VET.BR	Veterinários
ZLG.BR	Zoólogos

Genéricos

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ART.BR	Artes: música, pintura, folclore
COM.BR	Atividades comerciais
ECO.BR	Atividades com foco eco-ambiental
EMP.BR	Pequenas e micro-empresas
NET.BR	Atividades comerciais

Universidades

EDU.BR	Instituições de ensino superior
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Pessoas Físicas

BLOG.BR	Web logs
FLOG.BR	Foto logs
NOM.BR	Pessoas Físicas
VLOG.BR	Vídeo logs
WIKI.BR	Páginas do tipo 'wiki'

e-business



- Initial function of domain names: **simple electronic address**
- Mid-1990s: beginning of the commercial use of the Internet which lead to the ***e-business***
- New role played by domain names: identification of the "virtual establishment“, being domains capable of playing the role of true **distinctive signs**



- Home Page
- World
- U.S.
- Weather
- Business at CNNMoney
- Sports at SI.com
- Politics
- Law
- Technology**
- Science & Space
- Health
- Entertainment
- Travel
- Education
- Special Reports
- Autos with EDMUNDS.com

TECHNOLOGY

Domain names once again fetch top dollar

Thursday, December 25, 2003 Posted: 2:12 PM EST (1912 GMT)

NEW YORK (AP) -- One more sign the technology sector is rebounding: An Internet domain name is again commanding seven figures.

Last week, a Florida man sold men.com for \$1.3 million, a healthy profit over the \$15,000 he paid for it in 1997.

The buyers, largely entertainment industry folks who have opted to remain anonymous behind the acquiring company, men.com LLC, want to create a portal for men.

"In the last couple of years, the domain names were selling for significantly less than what they did in '99, 2000," said Monte Cahn, chief executive of Moniker Online Services, which brokered the sale.



- Story Tools**
- SAVE THIS
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- RELATED**
- Business 2.0: [False Internet hopes on fantasy island](#)
 - Business 2.0: [Has VeriSign overstepped its domain?](#)

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careerbuilder.com SEARCH

If you died today, who would fund your family's future?

Protect Your Family With Life Insurance

10-Yr Level Term Life Insurance
\$500,000 Policy
(monthly premiums)

ANDERSON COOPER 360

CNN WEEKNIGHTS 10 PM ET

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 - Your E-mail Alerts
 - RSS
 - CNNtoGO
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 - Contact Us
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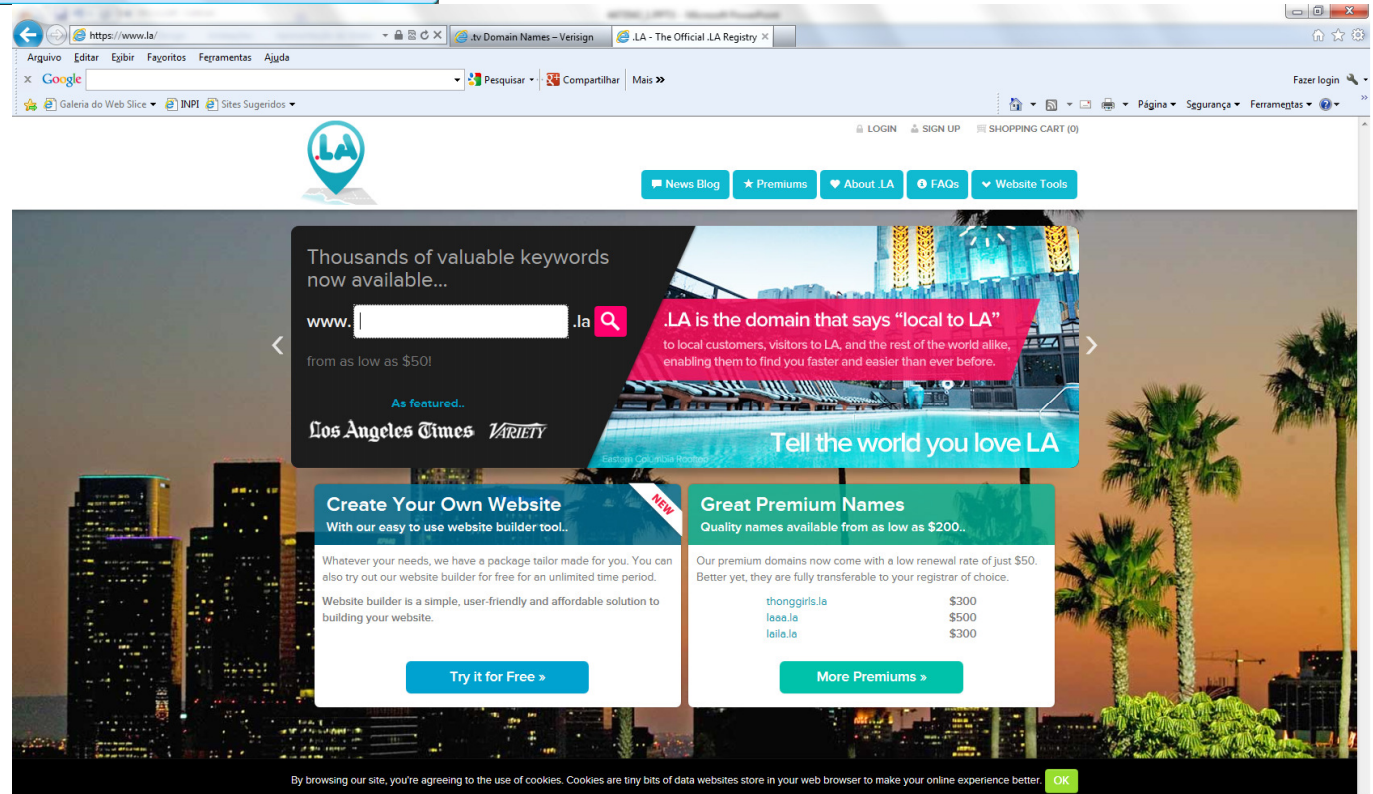
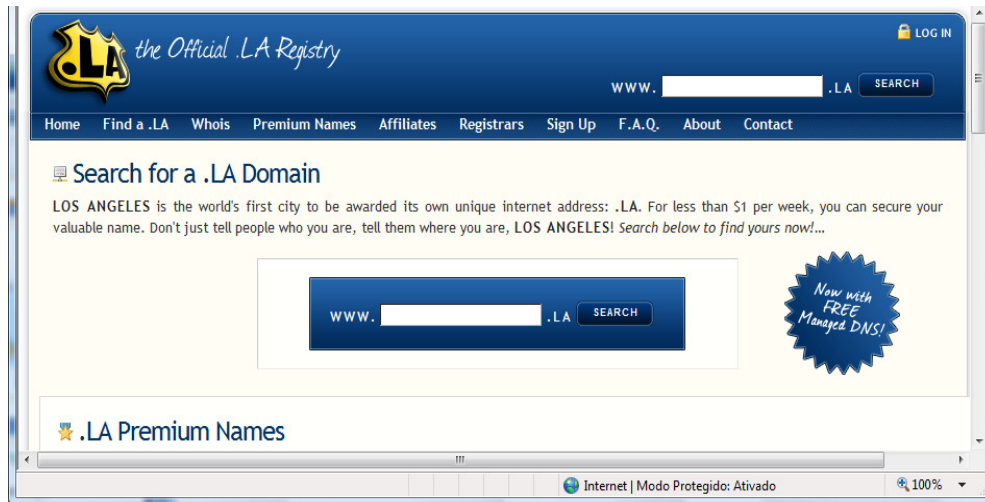
\$\$\$

#	Year	Domain	TLD	Price
1	2010	insurance	.com	US\$35.6 million
2	2007	vacationrentals	.com	US\$35 million
3	2012	privatejet	.com	US\$30.18 million
4	2014	sex	.com	US\$24 million
5	2009	internet	.com	US\$18 million
6	2015	360	.com	US\$17 million
7	2009	insure	.com	US\$16 million
8	2001	hotels	.com	US\$11 million
9	2008	fund	.com	US\$9.9 million
10	2007	porn	.com	US\$9.5 million
11	2015	porno	.com	US\$8.5 million
12	2010	fb	.com	US\$8.5 million
13	1999	business	.com	US\$7.5 million
14	2006	diamond	.com	US\$7.5 million
15	2004	beer	.com	US\$7 million

<https://www.youtube.com/watch?v=TT6rrDlmbAs>



Laos [.la]



Tuvalu [.tv]

get your own **ADDRESS** | features & **BENEFITS** | the **GALLERY** | the **CONTEST**

tv
DEFINED

.tv is the address for rich and dynamic media on the Web. It's the preferred destination for

the .TV WEBMERCIAL contest

Create and upload your own webmercial for .tv

Show everyone that .tv is the home for



UNDER ATTACK? | NEWSROOM | INVESTORS | SUPPORT | UNITED STATES

VERISIGN | DOMAIN NAMES | NETWORK AVAILABILITY | CYBER SECURITY | INNOVATION

tv
powered by VERISIGN

The Place to Showcase your Video and Broadcast-related Content on the Web

Find your .tv domain name

West Samoa [.ws]

SamoaNIC
.WS (WebSite) Domain Registration Center

(685) 209 26 / 209 27
helpdesk@samoa.ws

Home My Account Renewals Pricing FAQs Whois Lookup

- Home
- My Account
- Renewals
- Pricing
- FAQs
- Whois Lookup
- About Us

Global Domains International, Inc. *Your Internet Address for Life®*

WebSite.ws

HOME THE .WS STORY FOR REGISTRARS PREMIUM DOMAINS FAQ PRICING

.WS = WebSite

Lost in the .COM crowd?
Free yourself with .WS!
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Register .WS Whois Lookup

Register Your .WS Domain Now!

Need Ideas? Search

.WS IS WEBSITE EMAIL DOMAIN FORWARDING SITEBUILDER PREMIUM DOMAINS

Seguro | <https://www.worldsite.ws>

Global Domains International, Inc. *WorldSite.ws*

Home Our Mission Investment Opportunity Purchase Emoji

Inc. 500
TOP 50 COMPANY

.WS is a globally accessible top level domain. Anyone, anywhere, can register a .WS domain address for life.

ICANN
MEMBER

.WS is easy to remember; .WS is WebSite! For why Global Domains International has been the fastest growing companies.

Are you interested in earning? Our affiliate program allows you promoting a monthly package registration, hosting, email, and more.

Learn more



 V

An Internati (IDN) is an contains ch English apl Chinese, Ar more.

A tradition

GTLDs

- **Generic domains:**

- **.com**,
- **.net**,
- **.org**
- **.arpa**: network infrastructure
- **.edu**: Originally reserved for higher education institutions officially recognized by one of the agencies listed by the US Department of Education;
- **.gov**: Reserved exclusively for the US government;
- **.int**: Intergovernmental organizations established by international treaties or between national governments;
- **.mil**: Reserved exclusively for US military bodies.



GTLDs

- **.aero**: companies, organizations and individuals in the aviation industry or belonging to SITA - Société Internationale de Télécommunications Aéronautiques - sponsor
- **.asia**: "restricted" to Asian and pan-Asian organizations. Sponsor: DotAsia Org. Ltd.
- **.biz**: alternative for “business”
- **.cat**: for the Catalan cultural and linguistic community - sponsor: Fundació puntCat.
- **.coop**: only cooperatives, cooperative service organizations - sponsor: DotCooperation LLC ("dotCoop").
- **.info**: for “information”
- **.jobs**: sponsor: Employ Media LLC.



GTLDs

- **.mobi**: sponsor: mTLD Top Level Domain, Ltd.
- **.museum**: only genuine museums, their professional associations or individual members of the profession - sponsor: Museum Domain Management Association
- **.name**: for individuals
- **.post**: sponsor Universal Postal Union
- **.pro**: Members of the medical, legal, accounting and engineering professions, licensed in the United States, Canada, Germany and the United Kingdom.
- **.tel**: for individuals and companies to publish their contact information - sponsor: Telnic Limited.
- **.travel**: sponsor: Tralliance Corporation.
- **.xxx**: sponsor: ICM Registry LLC



1300+ NEW EXTENSIONS



BRAND

PAY PER CLICK



CYBERSQUATTING



Bad faith

- Circumstances indicating that the domain name was registered or acquired primarily for the purposes of selling, renting, or otherwise transferring the domain name to the owner of a trademark, for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name; or



Bad faith

- pattern of the domain name registrations preventing the owner of the trademark from reflecting the mark in a corresponding domain name; or



Bad faith

- the domain name was registered primarily for the purpose of **disrupting the business of a competitor**; or



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Smart Solutions to GLOBAL Challenges

seminar@markpatent.org • +91 79 2764 5254/5255/5256
www.markpatent.org • +91 79 2764 5257/4167

Bad faith

- by using the domain name, the Respondent intentionally attempted to attract, for commercial gain, Internet users to its web site or other on-line location, by creating a **likelihood of confusion** with the complainant's mark as to the **source**, **sponsorship**, **affiliation**, or **endorsement** of your web site or location or of a product or service on the Respondent's web site or location.



Domain Name Disputes

- Courts
 - Jurisdiction issues
 - Costs
 - Time
- ADRs



Traditional ADRs

- Arbitration: arbitrator rules, excluding the Courts; binding;
- Mediation: flexibility, informality, confidentiality and agility;
- Conciliation: trying to adjust opposing ideas.



ICANN ADRs

- The dispute resolution mechanism arises not from the law but from the parties' adherence to rules and procedures set at the domain name registration agreement



ARBITRATION vs ICANN ADRs

Similarities

- Disputes are submitted to the decision by third parties;
- There is a certain freedom in choosing who will decide;
- They are both adversary mechanisms.

Differences

- The UDRP system does not exclude the Court's competence to rule on the dispute;
- The decision is not really mandatory since it can be reviewed by Courts.



ICANN ADRs

- UDRP - Uniform Domain-Name Dispute Resolution Policy
- CEDRP - Charter Eligibility Dispute Resolution Policy
- ERP - Eligibility Reconsideration Policy
- ERDRP - Eligibility Requirements Dispute Resolution Policy
- IPDRCP- Intellectual Property Defensive Registration Challenge Policy
- QCP - Qualification Challenge Policy
- RDRP - Restrictions Dispute Resolution Policy
- STOP - Start-Up Trademark Opposition Policy
- SCP - Sunrise Challenge Policy
- TDRP - Transfer Dispute Resolution Policy



UDRP - Uniform Domain-Name Dispute Resolution Policy



UDRP



- Included between the registrar and domain owners in all Registrar Agreements by all registrars recognized by ICANN.
- Applicable to :
 - .aero, .asia, .biz, .cat, .com, .coop, .info, .jobs, .mobi, .museum, .name, .net, .org, .pro, .tel and travel.
 - + 42 ccTLDs (.AG, .AS, .BM, .BS, .BZ, .CC, .CD, .CO, .CY, .DJ, .EC, .FJ, .FM, .GD, .GQ, .GT, .KI, .LA, .LC, .MD, .ME, .ML, .MW, .NR, .NU, .PA, .PK, .PN, .PR, .PW, .RO, .SC, .SL, .SO, .TJ, .TK, .TT, .TV, .UG, .VE, .VG, .WS)
- Against abusive domain registration
- Can be initiated by the brand owner



Providers

- ADNDRC - Asian Domain Name Dispute Resolution Centre – approved on February 28, 2002 with four centers (Beijing, Hong Kong, Kuala Lumpur and Seoul);
- CPR - CPR Institute for Dispute Resolution – approved on May 22, 2000;
- eRes - eResolution – approved since January 1st, 2000 but only took cases until November 30, 2001;
- NAF - The National Arbitration Forum (FORUM) – approved since December 23, 1999
- WIPO - World Intellectual Property Organization – approved since December 1st, 1999.
- CAC (ADR.eu) - The Czech Arbitration Court Arbitration Center for Internet Disputes – approved on January 2008.
- Arab Center for Domain Name Dispute Resolution (ACDR) – approved on May 18, de 2013.



Cost-comparison UDRP



Provider	Domains under dispute	1 Panelist	3 Panelists
ADNDRC	1 to 2	US\$1,300.00	US\$2,800.00
FORUM (NAF)	1 to 2	US\$1,300.00	US\$2,600.00
WIPO	1 to 5	US\$1,500.00	US\$4,000.00
CAC (ADR.eu)	1 to 5	Euro 500.00 (+ Euro 800.00, if there is a reply or complexity)	Euro 3100.00 (+ Euro 800.00, if there is a reply or complexity)
ACDR	1 to 2	US\$1,500.00	US\$2,600.00



Requirements

- The Complainant's trademark is identical or similar to the disputed domain name; and
- The domain name holder has no rights or legitimate interest in relation to the disputed domain name; and
- The disputed domain name has been registered and is being used in bad faith.



Remedies



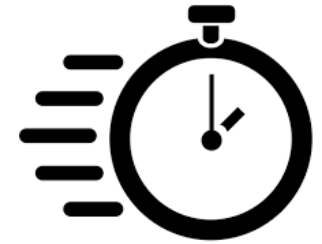
- Transfer

Or

- Cancellation

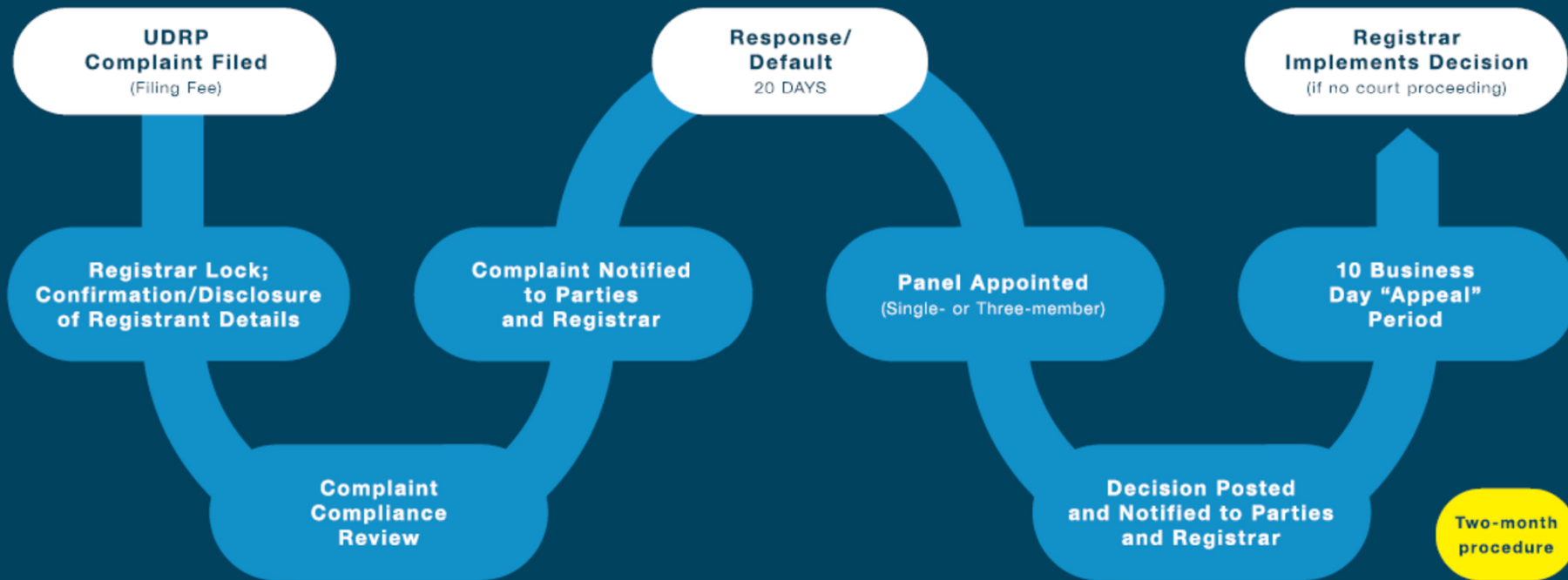


Timeline



UDRP – UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY

APPLIES TO GTLDS, NEW GTLDS AND NUMEROUS CCTLDS



Mutual Jurisdiction



- A court jurisdiction at the location of either:
 - (a) the principal office of the Registraror
 - (b) the domain-name holder's address as shown for the registration of the domain name in Registrar's Whois database at the time the complaint is submitted



Personal names



WIPO D2017-0035
victoriabeckham.info>



WIPO D2016-0256
<halleberry.com>



WIPO D2015-2209
<victortopa.com> et. al.



- WIPO Overview 3.0
- Merely having a famous name (such as a businessperson or cultural leader who has not demonstrated use of their personal name in a trademark/source-identifying sense), or making broad unsupported assertions regarding the use of such name in trade or commerce, would not likely demonstrate unregistered or common law rights for purposes of standing to file a UDRP complaint.



URS - Uniform Rapid Suspension



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URS

- Created in 2013 for the new categories of domain names accepted by ICANN in addition to the UDRP;
- Against "clear-cut cases of infringement";
- Its sole remedy is the **suspension** of the registration of the domain name



URS Providers

- NAF - The National Arbitration Forum (FORUM) – approved since February 20, 2013;
- ADNDRC - Asian Domain Name Dispute Resolution Centre – approved on April 19, 2013;
- MFSD Srl – approved on December 15, 2015.



Cost-comparison URS



Provider	Domains under dispute	Filing	Reply	Reexam
NAF / FORUM	1 to 14	US\$375.00	US\$375.00	US\$200.00
ADNDRC	1 to 5	US\$360.00	0	US\$180.00
MFSD	1 to 2	Euro\$200.00	0	Euro\$100.00



Requirements

- The **NOMINATIVE** trademark,
 - (i) **registered** and **in use**, or
 - (ii) which has been validated in Court, or
 - (iii) protected by law or treaty in force at the time of the filing of the procedure,
- of the Complainant is identical or **similar** to the disputed domain name; and
- The domain name owner has no rights or legitimate interest in relation to the domain name; and
- The domain name has been registered and is being used in bad faith.



CLEAR AND CONVINCING EVIDENCE

- *No genuine issue of material fact, only clear cases of trademark abuse”*



Other ADRs and tendencies



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URDP+

The domain name is **identical** or **confusingly similar** with a:

a) previous trademark, filed or registered in Brazil; or

b) well-known trademark; or

c) title of establishment,
trade name,
civil name,
family name or patronymic,
notorious pseudonym or
nickname

singular name or collective artistic name

or even another domain name



over which the
Complainant has
prior rights

Conclusion

ADRs = ✓ **FAST**
✓ **EFFICIENT**
✓ **COST EFFECTIVE**



SALUSSE, MARANGONI, PARENTE E JABUR ADVOGADOS

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**Thank you for your
attention!**

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