Copyright and You
Domain Name Dispute Resolution for Educators

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If a website is the schoolhouse of 21st-century education, then a domain name is like a street address — that crucial piece of information that brings visitors to the door. But domain names are even more than that — federal courts have recognized that domain names identify the entity that owns the website. In that way, domain names function as trademarks by identifying the source of the goods or services being offered on the Internet. Domain names, like trademarks, are valuable assets.

For example, universities have seized upon an increasingly lucrative market — the sales of university merchandise. This merchandise, through websites, bookstores and other venues, can bring in sizable revenue, amounting to millions. In addition to clothing, coffee cups, mascot dolls and so on, other items for sale include calendars, image cds, logos for cars and other vehicles, including airplanes! Universities license the production and sales of this merchandise through approved vendors. Because these sales are lucrative, counterfeit merchandise can be, produced and sold on the internet, much like other merchandise. Additionally, university faculty often participate in consulting businesses which have their own logos and domain names which could be capitalized upon by imitators.

For some of these reasons, domain names also present an avenue by which an institution's name can be misused or its trademark rights infringed. Because registering a domain name is a quick and inexpensive process, it is easy for anyone to register a domain name that incorporates a trademark, whether that trademark belongs to that person or not. This may very well confuse visitors to your site. A cyberpirate can hijack a name or term and divert a potential visitor seeking your site to its own website or that of another. Thus, every educator should be aware of the importance of domain names and know how to protect the institution's valuable intellectual property assets, good name and potential user base.

Resolving disputes over domain names requires an understanding of the nuances of trademark law. You should be aware of the means of protection from infringement and the unique ways in which a name or trademark can be misused in cyberspace, such as cybersquatting and typosquatting.

What is cybersquatting?

Cybersquatting occurs when a party registers as a domain name another's name or trademark for the purpose of selling the domain name to the rightful owner at an inflated price. Joe Toeppen was one of the first notorious cybersquatters. In the mid-1990s, when the system of domain name registration was still in its infancy, Toeppen registered hundreds of words as domain names. Some of the registrations he acquired were for generic words, like <water.com>, and some were trademarks, like <deltaairlines.com>, <eddiebauer.com> and <neimanmarcus.com>. Toeppen offered to sell his registrations to the trademark owners for thousands of dollars. Some of the trademark owners were outraged and filed suit in federal court in California. The district court addressed the then-novel question of whether Toeppen's Internet activities were sufficient to subject the Illinois man to personal jurisdiction in California and ultimately ruled in favor of the California plaintiff. Although courts do exercise jurisdiction over foreign defendants engaging in cyber-misconduct, cybersquatting still occurs, as do other methods of misusing domain names.

Typosquatting is another type of domain name misuse. Typosquatting occurs when a party registers a domain name that is very close to another's trademark or name for the purpose of capitalizing on an Internet user's typographical errors when entering a web address. For example, the domain name <microsof.com> would catch a number of Internet users searching for Microsoft, and <ggogle.com> would divert users seeking to reach Google. Typosquatters position themselves to take advantage of potential visitors' mistakes and either cause them to think they have reached the intended site or lure them away from that site. Even if the visitor quickly realizes that the site is not the one desired, the typosquatter will already have diverted the visitor to its own activities.

Dealing with URL misuse

What can you do if someone is using <institution.edu> or <trademark.com> as a domain name without permission of the rightful owner? Or what if someone is using a domain name that is intended to divert visitors away from your own or your institution's website?
One option is to sue in federal court. In 1999, Congress passed the Anti-Cybersquatting Consumer Protection Act, which has been codified as part of the Lanham Act, the law that governs unfair competition and trademark law. A federal lawsuit can, however, be very expensive and take years to reach a resolution. Also, the international nature of the Internet means that the entity misusing another's name in cyberspace may be located in a foreign jurisdiction. Filing a lawsuit in U.S. courts is possible, but the complication and expense of the litigation increase when there are foreign parties.

Domain name registrations are easier and cheaper to obtain than are federal trademark registrations. Domain name registration, unlike federal trademark registration, is not regulated by an agency that works to weed out duplication or attempts to avoid the likelihood of confusion. If the rightful owner of the mark is forced to litigate domain name disputes, then the cost of owning and protecting one's trademark or organization's name becomes even greater.

While domain names, like trademarks, are often business assets valuable enough to justify the time and expense of a federal lawsuit, there is an alternative means for resolving domain name disputes that is faster and less expensive.

Mandatory online arbitration system

As an alternative to federal court, there is an international arbitration system, which provides a quick and inexpensive forum to resolve domain name disputes.

The Internet Corporation for Assigned Names and Numbers ("ICANN") is a private, nonprofit technical coordination body for the Internet's name and numbering system. ICANN coordinates the domain name system to ensure that every address is unique and that all users of the Internet can locate valid addresses. ICANN also sets minimum standards for domain name registrars. In that capacity, ICANN adopted a Uniform Domain Name Dispute Resolution Policy (the "Policy"). All ICANN-accredited domain name registrars have adopted the Policy, which includes all registrars for names ending in .com, .net, .org, .mil, .pro and .edu. Anyone registering a domain name through an accredited registrar agrees to be bound by the Policy, which sets out guidelines for the dispute resolution procedure. Thus, the arbitration system is mandatory for respondents.

ICANN does not itself resolve disputes between parties. Instead, disputes are arbitrated by one of several approved domain name resolution service providers that must follow ICANN's Policy. The World Intellectual Property Organization ("WIPO") is one such approved service. WIPO is an international intellectual property organization associated with the United Nations. It has been providing domain name mediation services since 1994. While WIPO is not the only approved domain name resolution service provider, it is the oldest and one of the most respected.

WIPO arbitration procedure

To attempt to stop interference with an organization or diversion of potential visitors away from a website through cybersquatting or other improper domain name use, a complaint can be filed with the WIPO domain name dispute arbitration panel. The dispute can be resolved by a three-member panel or by one arbitrator. The cost for filing a complaint and electing one arbitrator is $1,500. Once the complaint is filed and the dispute resolution provider formally commences the administrative proceeding, the respondent has 20 days to submit a response. If the case is to be decided by a single arbitrator, the administrator will appoint an arbitrator within five days of the receipt of the respondent's reply. The complainant then has an opportunity to submit an additional filing, but whether the arbitrator reads the additional filing is discretionary. After appointment, the arbitrator will decide the issue and notify the relevant parties within 17 days.

The law applied by the arbitrator is determined by the contract between the registrar and the respondent. The domain name registration agreement, which binds the registrant to the mandated system, also sets forth the governing law. Thus, in arbitrating a claim based on a domain name registered through a registrar in the United States, the panel will use U.S. law, including relevant principals of U.S. trademark law.

The arbitrator will resolve the complaint in one of three ways: (1) The arbitrator will order the domain name registrar to cancel the domain name; (2) the arbitrator will order the domain name registrar to transfer the registration to the complainant; or, (3) if the complainant fails to carry the substantive burden, the arbitrator will deny the complaint.

Substantive burden

To prevail in the dispute and have the respondent's domain name cancelled, the complainant must establish that its domain name is identical or confusingly similar to the respondent's domain name or trademark, that the other party has no legitimate interest with respect to the name, and that the other party has registered or is using the domain name in bad faith.

The first element, showing that the domain name is identical or confusingly similar, involves analysis of the same factors that govern a trademark infringement lawsuit's finding of a likelihood of confusion. A WIPO arbitration panel that determined <walsucks.com> was likely to be confused with <walmart.com> relied on the same eight-factor test developed for the resolution of trademark infringement suits. The test for likelihood of confusion weighs the following factors: strength of the mark; proximity of the goods; similarity of the marks; evidence of actual confusion; marketing channels used; type of goods and the degree of care likely to be exercised by a purchaser; defendant's intent in selecting the mark; and the likelihood of the expansion of product lines.

A domain name can be deemed identical to a word mark, notwithstanding the domain name format. All domain names contain