

CAPES SOKOL CLIENT PREVAILS IN DOMAIN NAME DISPUTE ARBITRATION

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Capes Sokol recently prevailed on behalf of their client in a contentious Uniform Domain-Name Dispute-Resolution Policy (UDRP) proceeding, in which the National Arbitration Forum agreed that a domain name was registered and used in bad faith. The Forum agreed with Capes Sokol that the appropriate remedy was to transfer the domain name to Capes Sokol's client.

The UDRP is a process established by the Internet Corporation of Assigned Names and Numbers (ICANN) to resolve domain name disputes. Most common are trademark disputes, whereby one complains that the registration and use of a particular domain name infringes upon one's trademark. The UDRP process is mandatory, because a domain registrant, at the time of registering a domain name, must do things: **(1)** represent and warrant that the registration will not "infringe upon or otherwise violate the rights of any third-party," and **(2)** agree to participate in a UDRP arbitration proceeding, should a dispute arise.

The complainant in the UDRP proceeding may request either that the registration be cancelled or the domain name be transferred to the complainant. In order to prevail, the complainant must allege and prove that: **(1)** the domain name registered by the respondent is identical or confusingly similar to a trademark or service mark in which the complainant has rights; **(2)** respondent has no rights or legitimate interests in the domain name; and **(3)** the domain name was registered and is being used in bad faith.

In the instant proceeding, the National Arbitration Forum (one of three authorized UDRP arbitration forums), confirmed the following principles:

- Registration includes both initial registration and domain transfer. For example, a party who purchases a domain name from a prior registrant and subsequently begins using the domain name in bad faith is still subject to the UDRP;
- Redirecting a domain name to a website that competes with the a complainant constitutes "bad faith" use, as required under the UDRP; and
- Even though federal trademark registration occurred after the domain name was registered, a

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complainant may still prevail where its common law trademark rights predate the registration.

Legal representation in UDRP proceedings is recommended, because the requirements are highly technical and must be strictly followed.

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