



WIPO Conference: 10 Years UDRP – What's Next?

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**Theme 1.2: Key Issues for Panelists – Forks in the Road – Reflections
on the UDRP and Beyond**

Reverse Domain Name Hijacking

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Reverse Domain Name Hijacking – *What is it?*

- Rule 1: **Reverse Domain Name Hijacking** means using the Policy in bad faith to attempt to deprive a registered domain-name holder of a domain name.
- "The efficacy of the Policy depends upon limiting its use to the carefully circumscribed class of cases for which it was intended – cybersquatting. Those who use it for broader business disputes or for harassing a competitor, as Complainant here has done, divert providers' and panelists' resources from the Policy's intended purpose and inflict unnecessary expense on legitimate domain name holders such as Respondent."
[*Bittorrent Marketing GmbH v. AdIntensity Ltd, Adam Smith*, WIPO Case No. D2007-1033 (opinion dissenting from denial of RDNH)]

Reverse Domain Name Hijacking – *How common is it?*

- Granted rarely: In cases decided between January 1, 2008 and September 15, 2009, 13 cases in which a finding of reverse domain name hijacking was made. This represents 0.53% of the 2,431 cases that were decided during this date range. There were an additional six cases in which bad faith findings were entered against complainants for total between the two categories of 19 cases, or 0.78%.
- Requested far more often! It has sometimes been requested in cases in which the Panel found for Complainant.

Reverse Domain Name Hijacking – *What's the standard?*

- While all panels appear to treat RDNH as discretionary, there is no consensus view on what standard applies.

Some examples:

- "The Panel agrees with the Respondent that ordinarily the launching of such an obviously and fundamentally flawed complaint ought to lead to a finding of reverse domain name hijacking. In the present case, the Complainant knew (and has admitted that it knew) that the Respondent registered the disputed domain name well before the Complainant even thought of using it. ... Against this must be balanced the consideration that there is ***nothing in the record to indicate actual malice*** on the part of the Complainant." [*Meeza QSTP-LLC v. Torsten Frank / medisite Systemhaus GmbH*, WIPO Case No D2009-0943; RDNH denied by majority vote.]

Reverse Domain Name Hijacking – *What's the standard?*

- "To prevail on such a claim, **a respondent must show that the complainant knew of the respondent's strong rights or legitimate interests** in the disputed domain name or the clear lack of bad faith registration and use, **and nevertheless brought the complaint in bad faith.**" [Oystar USA, Inc. v. Domain Administrator info@heavylifting.com HeavyLifting, LLC, WIPO Case No. D2009-0025 [citing Sydney Opera House Trust v. Trilynx Pty. Limited., WIPO Case No. D2000-1224; Goldline International, Inc. v. Gold Line, WIPO Case No. D2000-1151.]
- "When, as here, **the face of the complaint includes facts that demonstrate no likelihood of success, the respondent is entitled to a finding of Reverse Domain Name Hijacking.**" [1 Model Management, LLC. v. L.A.S. Inc., Latifa Aadess, 1 Models LLC, WIPO Case No. D2008-1173; accord, Mirabella Beauty Products, LLC v. Mrs. Jello, LLC, WIPO Case No. D2009-0673.]

Reverse Domain Name Hijacking – *What's the standard?*

- ***"On the uncontested facts (all contained in the Complaint) there was no basis for Complainant's counsel's certification, required by paragraph 3(b)(xiv) of the Rules,*** that "the assertions in this Complaint are warranted under these Rules and under applicable law, as it now exists or as it may be extended by a good-faith and reasonable argument." Complainant and its counsel have not even sought to explain why the Panel should depart from settled Policy precedent on the determinative issue in this matter." [*Liquid Nutrition Inc. v. Liquidnutrition.com/Vertical Axis Inc.*, WIPO Case No. D2007-1598]

Reverse Domain Name Hijacking – *What's the standard?*

- "In particular, ***proceedings must not be commenced in a brash and totally unjustifiable attempt to pressure a domain name owner into releasing a legitimately held domain name*** that considerably pre-dates any trademark rights held by the complainant," see *Sustainable Forestry Management Limited v. SFM.com and James M. van Johns "Infa dot Net" Web Services*, WIPO Case No. D2002-0535." [Cited by dissenting panelist in *Liquid Nutrition*.]

Reverse Domain Name Hijacking – *What to consider?*

- The merits.
- Respondent's conduct [*Oystar USA, supra; Bittorrent Marketing GmbH v. AdIntensity Ltd, Adam Smith*, WIPO Case No. D2007 1033; *Rudy Rojas v. Gary Davis*, WIPO Case No. D2004-1081 ("In this proceeding Complainant's conduct, as demonstrated by the evidence before the Panel, approaches the bad faith necessary for a finding of reverse domain name hijacking. He has used the Policy to air a dispute much broader than mere entitlement to the disputed domain names. Represented by counsel, he nonetheless has advanced a legal theory that can most charitably be described as questionable under trademark law and wholly inappropriate under the Policy. By omitting any reference to his principal brand Native Threads he has presented a misleading picture of the case. But Respondent's conduct is scarcely better, if at all.

Reverse Domain Name Hijacking – *What to consider?*

Some of his evidence, such as references to his company name (in fact "inactive" and not registered until 2004), is misleading. Like Complainant, he indulges in needless name-calling and diatribe that have no place in Policy proceedings. In these circumstances no finding of reverse domain name hijacking is justified, if only to prevent Respondent's citing to such a finding in any subsequent court or administrative proceedings. The Panel instead chooses the approach of **'a plague o' both your houses'** in order to leave the parties as it found them."}]

Reverse Domain Name Hijacking – *What to consider?*

- Whether Complainant is represented by counsel. [*Urban Logic, Inc. v. Urban Logic, Peter Holland*, WIPO Case No. D2009-0862 ("A non-lawyer party might be excused from failing to distinguish registration in bad faith from use in bad faith, or not understanding that both must be proven (and proven with evidence not allegations), but counsel must further certify that 'the assertions in this Complaint are warranted under these Rules and under applicable law, as it now exists or as it may be extended by a good-faith and reasonable argument.' Rules, paragraph 3(b)(xiv). ***The Panel can discern no reasonable basis for Complainant's counsel's certification in this proceeding, as establishing both registration and use in bad faith are required by the plain language of paragraph 4(a)(iii) and ten years of unbroken Policy precedent.***"); *LaFrance Corp. v. David Zhang*, WIPO Case No. D2009-0415 ("Had Complainant been represented by counsel the Panel would not have hesitated to make an RDNH finding"); *Liquid Nutrition, supra*]

Reverse Domain Name Hijacking – *What to consider?*

- Rule 3(b)(xiv): "Complainant certifies that the information contained in this Complaint is to the best of Complainant's knowledge complete and accurate, that this Complaint is not being presented for any improper purpose, such as to harass, and that the assertions in this Complaint are warranted under these Rules and under applicable law, as it now exists or as it may be extended by a good-faith and reasonable argument."
- The consequences of an RDNH finding ["[Complainant's case theory] approaches the bad faith justifying a finding of reverse domain name hijacking. The only thing that gives the Panel pause in entering such a finding here is that it may, perversely, encourage further proceedings such as litigation by Complainant against Respondent. Suffice it to say that in this Panel's view the Complainant was ill advised to bring this proceeding on the facts demonstrated in the Complaint. *Allegra Holdings, LLC v. Hyped Media, Domain By Proxy Inc., Signs Up Now Inc.*, WIPO Case No. D2008-0539 (citations omitted)]

Reverse Domain Name Hijacking – *Are there alternatives?*

- Rule 15(e): "... If after considering the submissions the Panel finds that the complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking **or** was brought primarily to harass the domain-name holder, the Panel shall declare in its decision that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding." (Emphasis added.) [See *LaFrance Corp. v. David Zhang*, WIPO Case No. D2009-0415; *Wild West Domains, Inc. v. Brynne Heaton*, WIPO .Case No. D2004 0789.]
- "A plague o' both your houses." [*Rudy Rojas v. Gary Davis*, WIPO Case No. D2004-1081].

Reverse Domain Name Hijacking – *What good does it do?*

- ▶ Deterrence? Of whom or what?
- ▶ A reminder to a court? Or possibly a panel in a subsequent proceeding?