The John Marshall Journal of Information Technology & Privacy Law

Volume 22
Issue 3 *Journal of Computer & Information Law - Spring 2004*

Article 4

Spring 2004

A Normative Critique of Private Domain Name Dispute Resolution, 22 J. Marshall J. Computer & Info. L. 625 (2004)

J.R. Hildenbrand

A NORMATIVE CRITIQUE OF PRIVATE DOMAIN NAME DISPUTE RESOLUTION

I. INTRODUCTION

In recent years much has been made of the rapid expansion and tremendous commercial potential of the Internet. As individuals and corporations have begun to harness the vast potential of the Internet, our traditional law has struggled to respond to the rapid evolution of the America West Airlines, Gerber Products Company, The Hoover Company, Seiko Corporation, Wells Fargo & Company, Mattel, Inc., Xerox Corporation, the International Olympic Committee and the United States Olympic Committee each received domain name transfers through domain name dispute arbitration.[1] These corporations have clearly recognized the value of domain names that contain or imply their trademarked words and phrases. Each of these corporations have turned to domain name dispute resolution as a method of capturing the goodwill value of trademark containing domain names held by unaffiliated Internet users. However, the interests of the trademark owners in realizing and protecting the value of their trademarks in Internet domain names create a potential conflict with the interests of the larger community of Internet users as a whole.

The difficulty of balancing the rights of trademark owners with those of Internet users within the burgeoning commercial environment of the Internet has generated extraordinary tension between competing interests and proven a major challenge for the American legal establishment. United States federal law contemplates at least four avenues through which trademark owners may attempt to protect their marks from registration and use as Internet domain names: an action for traditional trademark infringement under the *Lanham Act*,[2] an action for di-

1. ICAAN, *List of Proceedings Under Uniform Domain Name Dispute Resolution Policy*, <http://www.icann.org/udrp/Detail58.htm> (updated May 10, 2004).

2. *The Lanham Act*, or *Trademark Act of 1946*, is codified at 15 U.S.C. §§ 1051-1141(n) (2003) and is the statutory corpus of federal law directed at regulating and protecting trademarks and service marks. Within this Note the term "trademark" or "mark" is intended to encompass both trademarks and service marks. The *Restatement (Third) of Unfair Competition* defines a trademark as "a word, name, symbol, device or other designation, or a combination of such designations, that is distinctive of a person's goods or ser-

lution under section 43(c) of the *Lanham Act*, an action under the *Anti-cyber-squatting Consumer Protection Act* ("ACPA")[3] and the Uniform Dispute Resolution Policy ("UDRP").[4]

This Note explores the relationship between the balance of rights articulated by the UDRP and the system of normative principles that underlies traditional trademark protection. In particular, this Note strives to develop a coherent portrait of the conceptual distinctions and theoretical underpinnings of the UDRP and ultimately to critique the normative and practical justification of ICANN's effort to provide an effective dispute resolution system for conflicts between trademarks and domain names. Part II of this Note examines the perspectives and normative judgments evinced in several relevant documents produced in the years immediately prior to the development and adoption of the UDRP. Part III explores the general workings of the UDRP as well as its relationship to the most similar statutory federal remedy, the ACPA, and the broader implications, normative and otherwise, of the UDRP regime. Part IV evaluates the UDRP's consistency with the normative principles that justify traditional trademark protection and the principles specifically established to govern the UDRP process.

II. PRE-UDRP PERSPECTIVES ON THE CONFLICT BETWEEN TRADEMARKS AND DOMAIN NAMES

Given the complex nature and development of ICANN and its UDRP,[5] there are many potential sources of norms and principles through which the UDRP's normative vision and consistency may be ex-

---

vices and that is used in a manner that identifies those goods or services and distinguishes them from the goods or services of others." *Restatement (Third) of Unfair Competition* § 9 (1995). The Restatement (Third) of Unfair Competition defines a service mark as "a trademark that is used in connection with services." *Id.* The *Lanham Act* § 43 provides similar statutory federal definitions of trademarks and service marks in 15 U.S.C. § 1127 (2003).

3. The ACPA is located under the *Lanham Act* § 43(d)(1)(A), 15 U.S.C. §1125(d)(1)(A) (2003).

4. Kenith L. Port, *Intellectual Property In An Information Economy: Trademark Monopolies in the Blue Nowhere*, 28 Wm. Mitchell L. Rev. 1092 (2002); *see* ICANN, *Uniform Domain Name Dispute Resolution Policy*, <http://www.icann.org/dndr/udrp/policy.htm> (updated May 17, 2002) (implementation documents approved Oct 24, 1999) [hereinafter UDRP]. The UDRP provides the procedure through which ICANN responds to disputes between trademark owners and domain name registrants regarding the use of trademarked terms as domain names.

5. The Internet Corporation for Assigned Names and Numbers ("ICANN") is the not-for-profit corporation to which the United States Department of Commerce has essentially delegated responsibility for DNS management. *See infra* n. 6 & Part II.B. ICANN is a dynamic organization still developing and evolving its procedures and policies in the quickly shifting landscape of the Internet and its governance. However, some commentators insist that it is already clear that ICANN is a failed experiment; regarding a collection of articles for a symposium on ICANN Governance, A. Michael Froomkin wrote,

plored. The most relevant and pressing of these normative sources are those that address the conflicts of rights and interests that created the impetus for the development of the UDRP and those that directly issued the UDRP's normative mandate. The white paper published by the International Trademark Association ("INTA") in 1997 regarding the intersection between domain names and trademarks and the green paper and white papers drafted by the Department of Commerce in 1998 regarding the privatization of domain name system ("DNS")[6] management are such relevant, focused normative sources and they form the foundation of this Note's normative critique of the UDRP.

A. THE INTA "WHITE PAPER"

In 1997 the INTA[7] released a white paper exploring the legal ramifi-

---

As all of these articles demonstrate in their own way, the dream that ICANN may have once seemed the harbinger of a new decentralized form of government is quite firmly dead. While we have not in any way resolved to our common satisfaction how to manage the DNS, or what role an ICANN-like body should play in it, the chance that anyone will point to ICANN as a model for the regulation of anything else now seems comfortably small.

ICANN 2.0: Meet the New Boss, 36 Loy. L.A. L. Rev. 1087, 1100–01 (2003). *See also* David R. Johnson et al., *A Commentary on the ICANN "Blueprint" for Evolution and Reform*, 36 Loy. L.A. L. Rev. 1127 (2003); Dan Hunter, *ICANN and the Concept of Democratic Deficit*, 36 Loy. L.A. L. Rev. 1149 (2003); Wolfgang Kleinwoechter, *From Self-Governance to Public-Private Partnership: The Changing Role of Governments in the Management of the Internet's Core Resources*, 36 Loy. L.A. L. Rev. 1103 (2003); Stefan Bechtold, *Governance in Namespaces*, 36. Loy. L.A. L. Rev. 1239 (2003).

6. "The DNS is a distributed name resolution service that resolves domain names to numerical IP addresses." Bechtold, *supra* n. 6, at 1255 & n. 70. The DNS is an essential technical, structural component of the infrastructure that enables the World Wide Web. Additional commentary regarding the development, design, and political and economic implications of the DNS can be found in Michael Froomkin, *Wrong Turn in Cyberspace: Using ICANN to Route Around the APA and the Constitution*, 50 Duke L.J. 17, (2000); Milton L. Mueller, *Ruling the Root: Internet Governance and the Taming of Cyberspace* 17–26 (2002).

7. The INTA is a not-for-profit international association of trademark owners and professionals. International Trademark Association, *History*, <http://www.inta.org/about/history.html> (accessed Feb. 5, 2004). The association was originally organized on November 21, 1878 as the United States Trademark Association. Throughout its history the INTA has served to develop and design trademark law both within the United States and internationally. In the 1970's the INTA was accredited as a "non-governmental observer" by the World Intellectual Property Organization. In the 1980's the INTA completed a comprehensive study of the Lanham Act and the U.S. trademark regime. This study eventually culminated in The Trademark Revision Act of 1988 and today the INTA characterizes itself as "the world's leading trademark association" as it continues to "advocate for the interests of trademark owners. . . [and] to foster effective trademark laws and policies worldwide." *Id.*; International Trademark Association, *Public Policy*, <http://www.inta.org/policy/> (accessed Feb. 5, 2004).

cations of the "intersection" between trademarks and domain names.[8] In the INTA White Paper the INTA provides a cogent articulation of the normative principles that govern and justify trademark protection, especially within the context of the potential conflicts between Internet domain names and trademarks. Written before the promulgation of the UDRP, the INTA White Paper provides context regarding the legal and technical situation within which the UDRP was designed and insight into the interplay between the interests of trademark owners and those of the Internet community at large.

The INTA White Paper identifies several common, functional justifications of trademark protection: (1) the protection of consumers, both from consumer confusion and by encouraging quality through brand recognition, and (2) the protection of property in the form of business goodwill.[9] Quoting the United States Supreme Court in *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.* the INTA White Paper characterizes trademark protection as an offshoot of the tort of deceit.[10] Essentially, trademarks are a kind of shorthand that reduce the information cost of evaluating the quality of products, allowing consumers to make efficient, rational product purchase decisions.[11] The quality-identifying function of trademarks also serves as an incentive for trademark owners to maintain standards of quality for the products that bear their marks by ensuring that mark holders can take advantage of the consumer loyalty, or good will, that becomes associated with their marks as a result of consistent quality.[12] Trademark law recognizes the value of the quality incen-

8. *See* International Trademark Association, *The Intersection of Trademarks and Domain Names—INTA "White Paper,"* 87 Trademark Rep. 668 (1997) [hereinafter INTA White Paper].

9. *Id.* at 671–72; *see also* McCarthy, *supra* n. 1, at § 2.

10. INTA White Paper, *supra* n. 9, at 672.

11. INTA White Paper, *supra* n. 9, at 671. The protection of trademarks facilitates efficient product quality evaluations by maintaining assumption that goods sold under a particular mark are of the same quality as goods sold under the same mark with which consumers have had prior experience and opportunity to evaluate. By lowering information costs trademarks create a more economically efficient commercial process. If confusingly similar trademark uses are allowed the validity of the quality assumption may be undermined as consumers become confused when inferior goods are sold under marks previously associated with quality goods or with an established reputation for quality. If the quality assumption is compromised by such confusing uses then information costs may be increased. For a more complete discussion of the information cost reduction justification of trademarks *see* McCarthy, *supra* n. 1, at § 2:5.

12. INTA White Paper, *supra* n. 9, at 671–72. The essential character of this function of trademark protection can easily be seen in the rules governing the license of trademarks. A trademark may be validly licensed "under any circumstances where the licensor exercise quality control over the goods and services that reach the customer under the licensed mark . . . . Under the quality theory of trademark and service mark function, which is the law today, the consumer is entitled to assume an equal level of quality of goods and services

tives created by good will and generates a property interest in the mark that allows mark holders to prevent others from using the mark and disrupting the goodwill associated with it.[13] This limited trademark property interest protects mark holders against the loss of goodwill through unauthorized use, but it extends only far enough to protect the quality-identifying value of a mark.[14] When trademarks cease to serve as indicators of the source of the goods with which they are associated, trademark owners lose their rights to prevent others from using the mark.[15] The loss of the limited property right in a trademark when the mark ceases to identify the source of a good reflects the erosion of the mark's ability to serve as a shorthand for quality and, with it, the erosion of the justification for a grant of exclusive use. In this sense the protection of consumer quality assumptions function of trademark law serves not only as a rational policy justification for trademark protection, but also as a logical limit on property rights employed to protect and enhance the quality assumption.

According to the INTA the value of trademarks to corporations in the form of good will and customer loyalty[16] is obvious, but a similar recognition of the potential marketing value of domain names was initially overlooked.[17] As corporations began to realize the Internet's vast potential as a marketplace and marketing platform, domain names began to accrue significance and value as indicators of goodwill separate from, though related to, trademarks.[18] Because consumers often gravitate toward easy to remember domain names that relate to a corporation's products and often attempt to locate a corporation's web presence by searching for a domain name that matches a company's primary trademark, domain names have become very valuable tools of source identification for companies engaged in Internet commerce.[19] The balance struck between traditional trademark indicia of good will and newer electronic domain name indicia of good will is of paramount im-

---

sold through many franchised outlets using a single mark." McCarthy, *supra* n. 1, at § 3.11.

13. INTA White Paper, *supra* n. 9, at 672.

14. *Id.* at 672. *See also* discussion *supra* n. 13.

15. INTA White Paper, *supra* n. 9, at 672.

16. *Id.*

17. *Id.* at 676.

18. *Id.*

19. *Id.* The importance of principal trademark domain names can be seen in the domain names sought by the entities listed in the text associated with *supra* n. 2. For example The Hoover Company obtained the transfer of "hooverwindtunnel.com" and Xerox Corporation obtained the transfer of "wwwxerox.com," both of which obviously relate to the principal trademarks of those corporations. *See* ICAAN, *List of Proceedings Under Uniform Domain Name Dispute Resolution Policy*, <http://www.icann.org/udrp/Detail58.htm> (updated Feb. 25, 2004).

portance within any coherent scheme of trademark regulation today.[20]

After exploring the system of norms and principles that justify and limit established trademark law, the INTA White Paper examines the NSI dispute policy, a processor to ICANN's UDRP, designed to deal with potential trademark and domain name conflicts.[21] The NSI's dispute resolution procedure provided little real relief for mark holders and primarily served to limit the NSI's liability in lawsuits by third parties.[22] The ITA identifies a further weakness in the dispute resolution policy of the NSI: "A problem with NSI's policy is that the same rules apply whether the domain name holder is merely an extortionist or has a legitimate business interest. This problem typifies the difficulty inherent in trying to establish a dispute policy under these circumstances where there may be many equities to consider."[23]

The INTA White Paper culminates in an INTA proposal for a new domain name dispute resolution system and a domain name registry policy. In its proposal the INTA recognizes "that the Internet was not created solely for commercial enterprise and that domain names should not be the exclusive province of trademark owners."[24] The INTA further observes:

> it is not necessary to have a second level domain name to do business effectively or successfully on the Internet, and thus while it may be preferable to acquire the second level domain name of one's choice, it is not an absolute right and may have to bend to accommodate competing interests.[25]

The INTA White Paper suggests a "sui generis" approach that allows the adaptation and evolution of a domain name resolution policy rooted in

---

20. INTA White Paper, *supra* n. 9, at 676.

21. *Id.* at 679. The NSI policy required, among other things, that domain name applicants submit a statement that the requested domain name did not infringe on any third parties' rights and provided a challenge procedure for the owners of registered marks identical to requested domain names. The challenge procedure provided domain name applicants thirty days to provide proof that the domain name predates the challenging mark holder's rights or that the domain name applicant has its own trademark registration. If the domain name applicant could provide such proof then the registration continued, but with an obligation to indemnify the NSI. If the registrant could not provide such proof then the domain name was placed on hold.

22. INTA White Paper, *supra* n. 9, at 679.

23. *Id.* at 679–80. The problem of balancing the multiple equities of the complex situations that can arise when trademarks and domain names conflicts is a significant challenge to the UDRP's ability to fairly and efficiently resolve conflicts between the rights domain name holders and those of mark holders. For a further discussion of this problem see *infra* Part VI and for a potential rebuttal by the INTA on behalf of the UDRP *see infra* n. 161.

24. INTA White Paper, *supra* n. 9, at 699.

25. *Id.* at 700.

procedure.[26] The INTA's proposal deigned to leave the substantive issues of conflicts between domain names and trademarks to the courts and trademark tribunals.[27]

In its proposal for a new domain name registry policy the INTA makes explicit the judgment that underlies its proposal for a new domain name dispute policy, viz. that the existing body of substantive trademark law is sufficient to effectively regulate the relationship between domain names and trademarks, if it is simply allowed to do so. The INTA says, "there is nothing about the Internet that is so new or different that we need to adopt draconian and potentially unfair procedures to protect the interests of trademark owners. . . . there is little to justify the current InterNIC/NSI dispute policy and its potentially unjust result. . . ."[28] As an organization "dedicated to the support and advancement of trademarks and related intellectual property as elements of fair and effective national and international commerce"[29] it is perhaps initially surprising, though ultimately intuitive, that the INTA developed such a progressive and even-handed proposal for domain name dispute resolution. The INTA's proposal was predicated on the rational realization that any effective scheme of domain name dispute resolution would have to service the legitimate interests of both users of the Internet and trademark owners.[30] A domain name dispute resolution system that is not sensitive to the balance of rights articulated by the law of trademark, justified by the quality assumptions of consumers and servicing the valuable ends of fairness and economic efficiency is a failure.

The INTA White Paper articulates the general principles that define and justify trademark protection within the context of the potential conflict between trademarks and domain names on the Internet. In tying the interests of trademark owners in domain names to the principles that both underlie and limit traditional trademark protection the INTA White Paper establishes a benchmark against which any attempt to resolve the conflict between domain names and trademarks must rationally be measured: the logical relationship between the protection of trademark interests in domain names and the principles that underlie trademark protection must be both coherent and valid. The details of the INTA's flexible, "sui generis" approach to the protection of trademark

26. *Id.* at 700. For an interesting analysis of the evolutionary blueprint of ICANN *see* Johnson et al., *supra* n. 6.

27. *Id.* at 700.

28. *Id.* at 703.

29. International Trademark Association, *About INTA*, <http://www.inta.org/about> (accessed Feb. 5, 2004).

30. INTA White Paper, *supra* n. 9, at 703. For some discussion of recent INTA Internet Committee analysis potentially defending the UDRP on this score see the *infra* n. 158.

interests in domain names are not as important as the explicit faith in the traditional law of trademarks to effectively resolve conflicts between trademarks and domain names that characterizes and informs the INTA's plan. The endurance of the traditional trademark regime and its principles in the resolution of disputes between trademark owners and domain name registrants is, as such, an issue of central importance, a conclusion that is buttressed by the 1998 green and white papers of the Department of Commerce.[31]

B. United States Department of Commerce Green Paper and White Paper

After soliciting public input on the general working of the administration of the domain name system ("DNS"), the Department of Commerce, though the National Telecommunications and Information Administration ("NTIA"), issued a green paper proposing the privatization of the domain name system's management to create "robust competition" and facilitate international participation in Internet management.[32] Following the green paper comment period the NTIA issued a policy-making white paper that set forth the guidelines under which the domain name system was to be privatized and identified the substantive norms that provided the foundation for the privatization process that was to eventually yield ICANN and the UDRP.[33]

Four primary principles were set forth in the Green Paper and the NTIA White Paper to inform the development of the new DNS: representation, competition, stability and bottom-up coordination.[34] The NTIA White Paper indicated that the policy it articulated would not disturb or

---

31. *See infra* Part II.B.

32. *Improvement of Technical Management of Internet Names and Addresses*, 63 Fed. Reg. 8826 (Feb. 20, 1998) (available at http://www.ntia.doc.gov/ntiahome/domainname/022098fedreg.htm>) [hereinafter Green Paper].

33. *Management of Internet Names and Addresses*, 63 Fed. Reg. 31,741 (June 10, 1998) (available at <http://www.icann.org/udrp/udrp-schedule.htm>) [hereinafter NTIA White Paper].

34. *Id.* at 31,743. The NTIA White Paper also contains a response to comments submitted during the Green Paper comment period urging that the new policy take into account other principles, "including principles related to the protection of human, rights, free speech, open communication, and the preservation of the Internet as a public trust." The NTIA White Paper addresses these concerns in saying,

> Existing human rights and free speech protections will not be disturbed and, therefore, need not be specifically included in the core principles for DNS management. In addition, this policy is not intended to displace other legal regimes (international law, competition law, tax law and principles of international taxation, intellectual property law etc.) that may already apply. The continued application of these systems as well as the principle of representation should ensure that DNS management proceeds in the interest of the Internet community as a whole.

Id.

displace legal systems that already addressed issues related to Internet governance and that the principle of representation would guarantee a system of domain name management that advances the interest of the entire community of Internet users.[35]

The Green Paper proposed to privatize the DNS through a new non-profit, private corporation designed to administer the domain name system in the interest of the Internet community as a whole.[36] In the NTIA White Paper the U.S. Government called for the establishment of the private corporation contemplated in the Green Paper and announced its expectations for the transfer of the management of the domain name system to the private sector.[37] The NTIA White Paper entreats the World Intellectual Property Organization to draft recommendations for the forthcoming private corporation for DNS management regarding the resolution of disputes between domain names and trademarks.[38]

Within the Green Paper and the NTIA White Paper discussions of potential conflict between trademark owners and domain name registrants the U.S. Government established a series of normative guidelines for the dispute resolution policy ultimately adopted by the forthcoming private corporation for DNS management. The NTIA White Paper comments, "For cyberspace to function as an effective commercial market, businesses must have confidence that their trademarks can be protected. On the other hand, management of the Internet must respond to the needs of the Internet community as a whole, and not trademark owners exclusively."[39] The Green Paper proposed balancing the Internet community's interests with the legitimate fears of trademark holders in an effort, among other things, to ensure trademark holders the same protections they enjoy in the physical world.[40] In response to the mixed criticism generated by the various proposals of the Green Paper regarding domain name dispute resolution, the NTIA White Paper called on the World Intellectual Property Organization to generate a process for dispute resolution that is both balanced and transparent.[41]

The Green Paper and the NTIA White Paper expressly established the normative mandate of ICANN and its UDRP. The Department of Commerce clearly articulated the overarching principles of the contemplated privatization of DNS management functions as representation, competition, stability and bottom-up coordination. The NTIA White Paper's explicit intention not to displace established legal regimes that al-

35. *Id.* at 31, 743. *See also* discussion *supra* n. 36.
36. Green Paper, *supra* n. 34, at 8828–29; NTIA White Paper, *supra* n. 35, at 31, 743.
37. NTIA White Paper, *supra* n. 35, at 31, 745.
38. *Id.* at 31, 747.
39. *Id.* at 31, 746.
40. Green Paper, *supra* n. 34, at 8830; NTIA White Paper, *supra* n. 35, at 31, 747.
41. NTIA White Paper, *supra* n. 35, at 31,747.

ready address issues of import to Internet governance, coupled with the broad principle of representation designed to ensure that the new system of DNS management services the interests of the entire Internet community, provides both theoretical justification and practical guidance for the dispute resolution procedure called for in the Green Paper and the NTIA White Paper. Though silent on the precise details of the contemplated dispute resolution procedure, the NTIA White Paper called for a balanced policy sensitive to the legitimate interests of trademark holders and the wider community of Internet users. Together with the principle of representation adopted to govern the new, private system of DNS management, the norms of balance and transparency mandated by the NTIA White Paper create a core normative concept potentially capable of contributing both legitimacy and coherence to the forthcoming UDRP process.

III. THE UDRP AND ITS IMPLICATIONS

In response to the 1998 NTIA White Paper urging the creation of a non-profit corporation to deal with the technical management of the Internet,[42] the Internet Corporation of Assigned Names and Numbers ("ICANN")[43] was created. The United States government promised to transfer control over the domain name root server to the fledgling corporation, creating the leverage ICANN used to force domain name registrars to accept the Uniform Dispute Resolution Policy ("UDRP") it developed.[44] By December 1, 1999, complaints could be submitted under the UDRP and ICANN's dispute resolution procedure, arguably, became the fastest and most cost effective method for resolving domain name conflicts.[45] The UDRP creates a set of global rules for domain name dispute resolution and effectively "expands trademark rights in cyberspace."[46] According to the UDRP timeline provided by ICANN,[47] the UDRP represents a consensus between trademark owners and various Internet rights, free speech and fair use interest groups.[48]

---

42. ICANN, *Timeline for the Formulation and Implementation of the Uniform Domain-Name Dispute-Resolution Policy*, <http://www.icann.org/udrp/udrp-schedule.htm> (accessed Fed. 5, 2004) [hereinafter Timeline]; *see also* NTIA White Paper, *supra* n. 35, at 31744–45.

43. For an interesting discussion of the nature of ICANN as a quasi-governmental corporation and its amenability to suit under United States antitrust law see A. Michael Froomkin & Mark A. Lemley, *ICANN and Antitrust*, 2003 Ill. L. Rev. 1 (2003).

44. Orion Armon, Student Author, *Is This as Good as It Gets? An Appraisal of ICANN's Uniform Domain Name Dispute Resolution Policy (UDRP) Three Years After Implementation*, 22 Rev. Litig. 99, 111 (2003).

45. Timeline, *supra* n. 44; Armon, *supra* n. 46, at 112.

46. Armon, *supra* n. 46, at 110.

47. Timeline, *supra* n. 44.

48. Armon, *supra* n. 46, at 112.

A. THE MECHANICS OF THE UDRP

The UDRP allows anyone to challenge the registration of a domain name and if the conditions of the policy are met it provides for the transfer or cancellation of the challenged domain name. UDRP paragraph 1 defines the purpose of the policy in resolving disputes regarding the use and registration of domain names.[49] Paragraph 2 of the UDRP provides a list of affirmative representations implied from a domain name registration application or contract, including:

> [T]hat (a) the statements that you made in your Registration Agreement are complete and accurate; (b) to your knowledge, the registration of the domain name will not infringe upon or otherwise violate the rights of any third party; (c) you are not registering the domain name for an unlawful purpose; and (d) you will not knowingly use the domain name in violation of any applicable laws or regulations.[50]

UDRP paragraph 3 sets forth various conditions upon which ICANN will transfer or cancel domain name registrations.[51] Paragraph 4, the key section of the UDRP, outlines the substantive and basic procedural workings of the mandatory administrative proceeding to resolve domain name disputes.[52]

Under UDRP ¶ 4(a) a complainant must prove: that "[the registrant's] domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and [the registrant has] no rights or legitimate interests in respect of the domain name; and [the registrant's] domain name has been registered in bad faith."[53] Paragraph 4(b) of the UDRP establishes a non-exhaustive list of circumstantial evidence of bad faith in the registration of the domain name.[54] Paragraph 4(c) provides a non-exhaustive list of circumstances that may be proven to demonstrate a legitimate interest in a domain name.[55] Paragraphs 4(e)-(h) define the basic procedure for the administrative proceeding contemplated by the UDRP and ¶ 4(i) limits the remedies for proceedings under the UDRP to the cancellation or transfer of the dis-

---

49. UDRP, *supra* n. 5, at ¶ 1. The full text of the UDRP and supplementary materials are available from ICANN, *Uniform Domain Name Dispute Resolution Policy*, <http://www.icann.org/dndr/udrp/policy.htm> (last updated May 17, 2002).

50. UDRP, *supra* n. 5, at ¶ 2.

51. UDRP, *supra* n. 5, at ¶ 3.

52. UDRP, *supra* n. 5, at ¶ 4.

53. UDRP, *supra* n. 5, at ¶ 4(a). The details and specific provisions of the UDRP are discussed in greater detail in Part IV of this Article in comparison with the protections of the Anti-cybersquatting Consumer Protection Act ("ACPA"). However, it is important to develop a working understanding of the UDRP at this juncture to prepare for a more detailed examination of its theoretical and practical implications.

54. *See* UDRP, *supra* n. 5, at ¶ 4(b); *see supra* Part III.

55. *See* UDRP, *supra* n. 5, at ¶ 4(c); *supra* Part III.

puted domain name.[56] The basic procedural mechanics of UDRP proceedings are governed by the Rules for Uniform Domain Name Dispute Resolution.[57] UDRP ¶ 4(k) provides for the non-exclusivity of proceedings under the UDRP, insuring that challengers and registrants may choose to pursue legal remedies available under the federal law despite a UDRP proceeding.[58]

The UDRP is generally justified by at least four familiar and intuitive, if questionable, lines of reasoning: it attempts to create an easy way of enforcing trademark rights,[59] it provides an alternative to the timely and expensive process of filing in federal court, it immunizes registrars from suits by third parties and it creates a global body of precedent regarding domain name disputes.[60] At its essence the UDRP operates as an adhesion contract for everyone who registers a domain name and those who refuse to subject themselves to the provisions of the UDRP will either lose their domain name registrations or never receive them in the first place.[61] The decisions generated by the UDRP process are very fast, issued just one to three months after filing, and are not subject to an appeal process under UDRP.[62] Some have criticized the UDRP for failing to provide an adequate procedural framework within which UDRP decisions with precedential value could be identified and applied.[63] UDRP proceedings are heard before single-member panels or three-

56. *See* UDRP, *supra* n. 5, at ¶¶ 4(d)-(i).

57. Port, *supra* n. 5, at 1101; ICANN, *Rules for Uniform Domain Name Dispute Resolution Policy,* <http://www.icann.org/udrp/udrp-rules-24oct99.htm> (updated Oct. 24, 1999) [hereinafter Rules].

58. *See* UDRP, *supra* n. 5, at ¶ 4(k).

59. For a discussion of the UDRP's actual relationship to the balance of trademark rights and their theoretical justifications see *infra* Parts III.B-C.

60. Port, *supra* n. 5, at 1098.

61. *Id.* at 1099; This characterization of the UDRP is buttressed by a simple reading of UDRP ¶ 1 that states:

> This Uniform Domain Name Dispute Resolution Policy (the "Policy") has been adopted by the Internet Corporation for Assigned Names and Numbers ("ICANN"), is incorporated by reference into your Registration Agreement, and sets forth the terms and conditions in connection with a dispute between you and any party other than us (the registrar) over the registration and use of an Internet domain name registered by you.

UDRP, *supra* n. 5, at ¶ 1. For further discussion regarding the "web of contracts" with which ICANN has "enveloped domain namespace" *see* Bechtold, *supra* n. 6, at 1256.

62. Port, *supra* n. 5, at 1102. The only hope for relief following an adverse finding in a UDRP proceeding is a suit in federal court. It is interesting to note that UDRP is frequently justified as a cost effective alternative to federal court, but de facto requires a suit in federal court to redress every error during a UDRP proceeding.

63. Armon, *supra* n. 46, at 120. The lack of a system of precedent has often been blamed for the apparent lack of consistency among UDRP proceeding decisions and panelists, though other factors certainly contribute. Frightening (and frankly hilarious) decisions abound in the body of UDRP decisions. One author has compiled an excellent short list of absurd UDRP decisions in Port, *supra* n. 5, at 1113–15, pointing out that the fre-

member panels according to the request of the complainant and the objection of the registrant against whom the trademark holder is proceeding.[64] Generally, UDRP proceedings are conducted without the opportunity to file supplemental documents or engage in in-person hearings, although in extraordinary circumstances a UDRP panel may request documents or conduct face-to-face proceedings.[65] According to the most recent data provided by ICANN, 80% of UDRP proceedings result in a finding for the complainant with roughly 19% concluding in a finding for the respondent and 1% ending in split decisions.[66] Some cite ICANN's UDRP as an exemplar of the tremendous potential of dispute resolution online and its supporters suggest that it may be a model for other online legal dispute programs because of its international scope and relative speed and economy.[67]

B. THE UDRP AND FEDERAL CYBERSQUATTING LEGISLATION

The UDRP's relationship with existing trademark law is both complicated and tenuous. Although the UDRP is not federal law and has never been interpreted in federal court, it has been sanctioned in some capacity by the United States government.[68] In the four-member universe of avenues for relief for domain name infringement on a trademark, the UDRP is most substantively similar to the ACPA.[69] The UDRP and the ACPA both regulate the comparatively narrow field of bad faith use and as such cover less conceptual and practical ground

---

quency and severity of absurd results under the UDRP may be cause to question the legitimacy and effectiveness of the process it creates.

64. Armon, *supra* n. 46, at 120.

65. Armon, *supra* n. 46, at 121.

66. ICANN, *Statistical Summary of Proceedings Under Uniform Domain Name Dispute Resolution Policy* <http://www.icann.org/udrp/proceedings-stat.htm> (last updated Jan. 30, 2003); *see also* Port, *supra* n. 5, at 1105–06 (discussing in detail UDRP statistics through January 2, 2002).

67. Michael Geist, *Fair.com?: An Examination of the Allegations of Systemic Unfairness in the ICANN UDRP* 1, <http://aix1.uottawa.ca/~geist/geistudrp.pdf> (Aug. 2000). Professor Geist includes a compelling example of this attitude regarding UDRP and it apparent success in the comments of ICANN board member Masanobu Katoh. *Id.* at 1, n. 4. However, the fairness of UDRP proceedings has been widely challenged and bias has been alleged in almost ever facet of the process outlined in the UDRP. *See* Benjamin G. Davis, *Une Magouille Planetaire: The UDRP is an International Scam*, 72 Miss. L.J. 815 (2002). For further discussion of the fairness and bias of UDRP proceedings *see infra* Parts III.B-VI.

68. NTIA White Paper, *supra* n. 35, at 31744–45.

69. Useful background material regarding the purpose and function of the ACPA can be found in Elizabeth D. Lauzon, *Annotation, Validity, Construction, and Application of Anticybersquatting Consumer Protection Act, 15 U.S.C.A. § 1125(d)*, 177 A.L.R. Fed 1 (2003).

than infringement or dilution actions.[70] The parallel natures of the UDRP and the ACPA provide a useful basis of comparison from which the relatively convoluted conceptual underpinnings and normative justifications for the process created by the UDRP can be examined.

1. *Bad Faith*

Each of the four circumstances contained in UDRP ¶ 4(b) is sufficient, standing alone, to evidence bad faith.[71] UDRP ¶ 4(b)(i) describes a classic cybersquatting case in which the domain name was registered with the intent of arbitraging the domain name by selling it to the complainant trademark owner for a profit.[72] UDRP ¶ 4(b)(ii) and UDRP ¶ 4(b)(iii) describe situations in which the domain name is registered with the intent of injuring the owner of the corresponding trademark, the former dealing with attempts to deprive mark owners of the value of their marks and the latter dealing with attempts to disrupt the business of competitors.[73] UDRP ¶ 4(b)(iv) simply attaches liability for initial interest confusion generated by the use of the trademarks of others to attract attention to an unrelated web site.[74]

UDRP ¶ 4(a)(ii) qualifies the bad faith evaluation of ¶ 4(b) by requiring that a domain name that is confusingly similar or identical to a complainant's mark and was registered and used in bad faith must also not be subject to the "rights or legitimate interests" of the registrant.[75] UDRP ¶ 4(c) provides a non-exhaustive list of three circumstances that are sufficient to demonstrate rights or legitimate interests under UDRP ¶ 4(a)(ii). If prior to notice of a dispute the registrant uses the domain name, or a corresponding name, "in connection with a bona fide offering of goods or services," then a legitimate interest or right under UDRP ¶ 4(a)(ii) will be demonstrated.[76] Also, UDRP ¶ 4(c)(ii) indicates that a legitimate interest may be demonstrated where the registrant was com-

70. *See* UDRP, *supra* n. 5, at ¶ 4(a); 15 U.S.C. § 1125(a)-(d).

71. UDRP, *supra* n. 5, at ¶ 4(b).

72. UDRP, *supra* n. 5, at ¶ 4(b)(i).

73. UDRP, *supra* n. 5, at ¶¶ 4(b)(ii)-(iii).

74. UDRP, *supra* n. 5, at ¶ 4(b)(iv); McCarthy, *supra* n. 1, at § 23:6.

75. UDRP, *supra* n. 5, at ¶ 4(a)(ii). Although it is convoluted and a bit circuitous, UDRP ¶ 4(a)(ii) basically provides functional defenses to a finding of bad faith and identity or confusing similarity with the complainant's mark. One is left wondering why the essentially "good faith" defenses outlined in UDRP ¶ 4(c) to substantively define the requirements of UDRP ¶ 4(a)(ii) are necessary if one must prove bad faith as an element of the UDRP procedure. Read together perhaps the bad faith conditions of UDRP ¶ 4(b) and the legitimate interest defenses of UDRP ¶ 4(c) simply create a more complete picture of the kind of bad faith necessary to merit the cancellation or transfer of a mark under the UDRP, but one can easily see the opportunity for confusion that could arise in the practical application of UDRP ¶ 4(b) and UDRP ¶ 4(c).

76. UDRP, *supra* n. 5, at ¶ 4(c)(i).

monly known by the domain name, even in the absence of trademark rights.[77] UDRP ¶ 4(c)(iii) provides exemptions for noncommercial or fair use, so long as the registrant did not intend to divert customers through confusion or tarnish the mark at issue.[78]

Instead of a list of sudden death factors and explanatory defenses, the ACPA employs a nine-factored analysis to determine bad faith intent that has been interpreted as both non-mandatory and non-exclusive in recent decisions.[79] Several of the ACPA bad faith intent factors roughly correspond to those employed by UDRP to determine bad faith registration or legitimate interest, but the differences are telling. The ACPA inquires into the legitimate intellectual property rights of the registrant in the domain name, roughly corresponding to UDRP's examination of rights and legitimate interests.[80] The ACPA considers the use of a name commonly used to designate the registrant, a provision mirrored by the UDRP.[81]

The ACPA also addresses noncommercial fair use, in a fashion similar to the UDRP, but includes no limitation regarding intent for commercial gain or to tarnish.[82] Lanham Act 43(d)(1)(B)(i)(V)[83] is similar to UDRP¶ (c)(iii), but deals with intent for commercial gain or to tarnish only by the creation of "a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the site." In this regard the UDRP has expanded its applicability beyond the scope of the ACPA protection.[84] The UDRP has potentially narrowed the fair use and noncommercial defenses by allowing them only in the absence of the prohibited

77. UDRP, *supra* n. 5, at ¶ 4(c)(ii).

78. *See* UDRP, *supra* n. 5, at ¶ 4(c)(iii).

79. *See* 15 U.S.C. § 1125(d)(1)(A)(i); *Sporty's Farm L.L.C. v. Sprotsman's Market, Inc.*, 202 F.3d 489, 498 (2d Cir. 2000); *Morrison & Foerster LLP v. Wick*, 94 F. Supp. 2d 1125, 1131 (D. Colo. 2000).

80. *See* 15 U.S.C. § 1125(d)(1)(A)(i)(I); UDRP, *supra* n. 5, at ¶ 4(c)(i).

81. *See* 15 U.S.C. § 1125(d)(1)(B)(i)(II); UDRP, *supra* n. 5, at ¶ 4(c)(ii). Additionally, 15 U.S.C. §1125(d)(1)(B)(i)(III) uses language almost identical to UDRP ¶ 4(c)(i).

82. *See* 15 U.S.C. § 1125(d)(1)(B)(i)(IV); UDRP, *supra* n. 5, at ¶ 4(c)(iii). In *Harrods Limited v. Sixty Internet Domain Names*, 157 F. Supp. 2d 658, 673 (E.D. Va. 2001) the fair use factor articulated by 15 U.S.C. § 1125(d)(1)(B)(i)(IV) is interpreted to protect First Amendment free speech from disruption from the ACPA. For further judicial interpretation of this factor *see Lucent Technologies, Inc. v. Lucentsucks.Com*, 95 F. Supp. 2d 528, 535-36 (E.D. Va. 2000) & *People for the Ethical Treatment of Animals, Inc. v. Doughney*, 113 F. Supp. 2d 915, 921 (E.D. Va. 2000).

83. For judicial interpretation of this provision *see Virtual Works, Inc. v. Network Solutions, Inc.*, 106 F. Supp.2d 845, 847 (E.D. Va. 2000).

84. It is important to note that the UDRP does not employ a factor based analysis, but rather decides conflicts based on a list of sudden death circumstances. This is troubling on its own on account of its potential to enlarge the set of cases to which the UDRP is ultimately applicable; it is doubly troubling when considered in conjunction with the complete lack of an appeals system within the UDRP framework.

intents, where the ACPA merely balances the prohibited intents against the fair use and noncommercial nature of a registrant's use and intent.[85] Additionally, the ACPA only considers intent for commercial gain and intent to tarnish where there is a genuine likelihood of confusion, a check entirely absent on the qualification placed on the noncommercial and fair use defenses under UDRP ¶ 4(c)(iii).

The ACPA contemplates offers to transfer a domain name to a mark owner with an intent to profit, just as the UDRP, with a limitation similar to that expressed under the "good faith" defense articulated in UDRP ¶ 4(c)(i).[86] The ACPA also takes into account a registrant's use of false or misleading contact information, a factor that lacks a parallel within the UDRP mandatory administrative proceeding, but is roughly reflected under the UDRP within the representation assumptions of UDRP ¶ 2.[87] The ACPA also evaluates two factors unreflected in the UDRP: the registrant's accrual of multiple domain names that he or she knows to infringe on distinctive marks or dilute famous marks[88] and the degree to which the mark corresponding to the disputed domain name is not famous and distinctive according to the dilution provisions of the Lanham Act.[89]

2. *Safe Harbor*

Perhaps the most striking and revealing difference between the scheme created by the UDRP and that contemplated by the ACPA is the UDRP's lack of a safe harbor provision. The ACPA provides a sweeping defense to a finding of bad faith within its framework of factor-based analysis. The ACPA safe harbor provision reads: "Bad faith intent described under subparagraph (A) shall not be found in any case in which the court determines that the person believed and had reasonable grounds to believe that the use of the domain name was a fair use or otherwise lawful."[90] Although UDRP § 4(c) does work to clarify the type of bad faith the policy is targeting, the UDRP contains nothing like the sweeping safe harbor provision of the ACPA. The ACPA's safe harbor provision helps to ensure that only those registrants that have acted in

85. Although the defenses of noncommercial and fair use are narrower under the UDRP, they have potentially greater impact as absolute protection against cancellation or transfer rather than factors to be balanced.

86. *See* 15 U.S.C. § 1125(d)(1)(B)(i)(VI); UDRP, *supra* n. 5, at ¶ 4(b)(i).

87. *See* 15 U.S.C. § 1125(d)(1)(B)(i)(VII).

88. *See* 15 U.S.C. § 1125(d)(1)(B)(i)(VIII).

89. *See* 15 U.S.C. § 1125(d)(1)(B)(i)(IX); 15 U.S.C. § 1125(c)(1).

90. *See* 15 U.S.C. § 1125(d)(1)(B)(ii); 15 U.S.C. § 1125(d)(1)(B)(i). It does not seem likely that those defending actions brought under the ACPA will frequently be in a position to avail themselves of this safe harbor provision that functions to protect a species of misguided good faith, but its inclusion in the statute has important normative implications for those analyzing the ACPA's conceptual foundations and justification.

bad faith are subjected to the remedies provided in the act. The ACPA's safe harbor provision also provides a procedural safeguard to eliminate close cases from ACPA liability and a check on the potential misapplication of the statute's test for bad faith. The ACPA seeks to regulate bad faith domain name registration, just as the UDRP does, but the ACPA remains internally consistent with its normative vision and general trademark and legal principles where the UDRP seems to flounder.

The circumstances outlined in UDRP ¶ 4(b) and UDRP ¶ 4(c) are all or nothing propositions; a finding of a UDRP ¶ 4(c) circumstance will save a disputed domain name from cancellation or transfer just as a finding of a UDRP ¶ 4(b) circumstance will lead to a cancellation or transfer (in the absence of a defense under UDRP ¶ 4(c)). In contrast, the balancing test of the ACPA weighs multiple interests and circumstances against one another when resolving domain name disputes. As such, one would expect to find a catchall safe harbor provision in the UDRP before the ACPA, so as to ensure that the harsh, conclusory procedure of the UDRP would only be applied to clearest and most obvious cases of bad faith.[91] Additionally, the UDRP's sudden death approach bears little similarity to the interest balancing approach of trademark law[92] and, for all the UDRP's touted flexibility it seems to lack a mechanism to effectively balance the right of registrants and complainants in novel or close cases.

The UDRP's requirement of bad faith and the related requirement of no legitimate interest or right in the domain name serve to carve out a narrow segment of the intersection of trademark rights and domain names that can theoretically be dealt with cheaply and quickly, essentially because bad faith generally makes easy questions of law. Though the success of the UDRP on this score has been widely touted by its supporters, a comparison between the UDRP and the similarly focused ACPA reveals a potential incongruity within the UDRP's normative framework, perhaps resulting from an overemphasis on speed and economy within the process of the UDRP. Instead of carving out a narrow section of easily resolved questions regarding the intersection of trademark rights and domain names, the UDRP has potentially overstepped

91. However, the potentially harsh monetary damages that may be awarded under the ACPA, a possibility absent under the UDRP, may also bolster the ACPA's need for a safe harbor provision. *See* 15 U.S.C. §§ 1117(a)-(c) (2003); Elizabeth D. Lauzon, *Annotation, Validity, Construction, and Application of Anticybersquatting Consumer Protection Act*, 15 U.S.C.A. § 1125(d), 177 A.L.R. Fed 1 (2003).

92. The most famous example of interest balancing in trademark law is in the multifactored tests for the likelihood of confusion, but even the ACPA adopts a factor based balancing approach to effectively balance the competing interests served by trademark law. For an example of likelihood of confusion factor analysis see *Polaroid Corp. v. Polarad Electronics Corp.*, 287 F.2d 492 (2d Cir. 1961). For an explication of the ACPA's balancing approach *see* 15 U.S.C. § 1125(d)(1)(B)(i).

the normative limitations of its sparse procedural mechanisms with a scope of application not tied strongly enough to obvious cases of abusive registration in bad faith.

C. THE UDRP'S TRADEMARK OWNER BIAS

The UDRP threatens to undermine the balance of rights that has come to characterize the trademark law of the United States.[93] Instead of reducing information costs and encouraging quality,[94] the UDRP has become "a weapon that makes it easier for trademark holders to take domain names away from those who have registered them."[95] The UDRP maintains few ties to the goodwill centric trademark principles whose economic and equitable utility justifies the grant of limited property rights in trademarks.

The UDRP is frequently criticized as harboring a deeply rooted and significant procedural bias in favor of trademark owners in UDRP proceedings.[96] The UDRP imposes unreasonable time limits on the registrant respondents in UDRP proceedings.[97] The registrant of a disputed domain name has a twenty-one day period within which to prepare and submit a response to a UDRP complaint, but trademark owners may prepare their cases for months before filing a complaint under the UDRP.[98] In effect the burden of the UDRP's expedited dispute resolution procedure is borne by the domain name registrants, while its benefits primarily accrue to trademark owners. Additionally, the circumstantial cases outlined in UDRP § 4(b) and UDRP § 4(c) do not directly define what evidence is necessary to prove guilt under the UDRP,[99] but rather indicate particular circumstances that are evidence of guilt. Without clear principled guidelines it is difficult to imagine the UDRP reaching consistently principled outcomes.[100] Indeed the vagueness of the UDRP's language on this point may contribute to the frequency with which some commentators believe the UDRP generates inconsistent, incorrect or nonsensical opinions.[101]

---

93. Port, *supra* n. 5, at 1192.

94. *See supra* Part II; *infra* Part VI.

95. Pamela Segal, *Attempts to Solve the UDRP's Trademark Holder Bias: A Problem that Remains Unsolved Despite the Introduction of New Top Level Domain Names*, 3 Cardozo Online J. Conf. Res. 1, 13 (2001); *see also* Port, *supra* n. 5, at 1192.

96. Segal, *supra* n. 97, at 37; Port, *supra* n. 5, 1092 & 1106-1116.

97. Segal, *supra* n. 97, at 36.

98. *Id.*

99. *Id.*

100. *Id.* The vagueness of the UDRP on the standards it employs also implicates the transparency mandate of the NTIA White Paper. *See supra* Part II.B.

101. *See* Port, *supra* n. 5, at 1113-1115.

1. *Forum Shopping and Provider Bias*

A problematic manifestation of the trademark owner bias of the UDRP is the opportunity for and pervasiveness of forum shopping within the UDRP framework. The UDRP process places the choice of arbitration provider at the discretion of the trademark owners who file UDRP complaints.[102] Of the arbitration providers initially approved by ICANN, the two that most frequently resolved disputes in favor of complainants, the World Intellectual Property Organization ("WIPO") and the National Arbitration Forum ("NAF"), quickly established dominance in the UDRP arbitration market.[103] Indications are that provider forum shopping under the UDRP has increased with time.[104] In 2001, UDRP complainants won 82.2% of the time with the WIPO and 82.9% of the time with the NAF, compared to 63.4% of the time with the third major provider at that time, eResolutions.[105] Following the release of a 2001 study detailing forum shopping grounded in provider bias under the UDRP, the least complainant friendly provider, eResolutions, lost its remaining market share and ceased providing UDRP dispute resolution services.[106] In 2001, before eResolutions closed its doors to UDRP complaints, one commentator observed:

> WIPO and NAF are known as the most complainant-friendly providers and eResolutions as the most defendant-friendly. As a result, WIPO and NAF receive a large proportion of cases. While these organizations tend to interpret the UDRP in ways that favor the trademark holders over other Internet users, eResolutions tends to decide cases in accordance with the strict language of the UDRP.[107]

---

102. UDRP ¶ 4(d) states: "The complainant shall select the Provider from among those approved by ICANN by submitting the complaint to that Provider. The selected Provider will administer the proceeding, except in cases of consolidation as described in Paragraph 4(f)." In effect complainants have the opportunity to select the arbiter who will judge the complaint they are bringing and forum shopping occurs when those complainants make the rational decision to select a provider who tends to favor their position. The only choice a respondent registrant has in selection of the arbiter of the dispute is the opportunity provided by Paragraph 5(b)(iv) of the Rules of Procedure for UDRP to elect and pay for (the costs of a UDRP proceeding fall on the complainant for a single-member panel arbitration and are split between the registrant and complainant in the case of a three-member panel proceeding) a three member panel comprised of members of any ICANN-approved Provider's list). *See* UDRP, *supra* n. 5, at ¶ 4(g). However, the respondent's option means little as ICANN-approved Provider's overwhelmingly find in favor of the complainant. *See* Geist, *supra* n. 69, at 6.

103. Geist, *supra* n. 69, at 3.

104. *Id.*

105. *Id.* at 6.

106. Port, *supra* n. 5, at 1112; Geist, *supra* n. 69, at 6.

107. Segal, *supra* n. 97, at 37. *See also* Milton Mueller, *Rough Justice: An Analysis of ICANN's Uniform Dispute Resolution Policy*, <http://www.acm.org/usacm/IG/roughjustice.pdf> (accessed Feb. 5, 2004).

The fact that the ICANN-approved arbitration provider that most closely held to the actual language of the UDRP was forced from the UDRP arbitration market is a strong indictment of not only the UDRP's frightening weakness to forum shopping, but also the systematic UDRP bias in favor of trademark owners that supports it. This weakness is allowing UDRP complainants to transform the UDRP into "an inexpensive tool to purchase a domain name without compensating the registrant."[108] It is difficult to envision a justification for such an uneven playing field in any of the good will or consumer protection justifications of traditional trademark law or the norms of fairness and justice that attend any legitimate adjudicatory process.[109]

2. *Reverse Domain Name Hijacking*

The problem of UDRP trademark owner bias is extended by the potential, if not incentive, under the UDRP for reverse domain name hijacking. Reverse domain name hijacking is the bad faith use of the UDRP by a trademark holder to "deprive a registered domain name holder of a domain name."[110] ICANN itself has recognized the possibility of reverse domain name hijacking under the UDRP, but has provided no robust attempt to deter it.[111] When ICANN acknowledges an occurrence of reverse domain name hijacking it merely declares and publishes its finding that a complaint was brought in bad faith.[112] No sanctions accompany a finding of reverse domain name hijacking under the UDRP, beyond the publication of the finding itself.[113] One commentator has characterized reverse domain name hijacking in the developing years of the Internet as "nearly as frequent and equally as onerous" as cyber-

108. Segal, *supra* n. 97, at 38–39.

109. For further analysis and general information on UDRP arbitration provider bias and the reverse domain name hijacking it supports *see* Geist, *supra* n. 69; Michael Geist, *Fundamentally Fair.com? An Update on Bias Allegations and the ICANN UDRP*, <www.udrpinfo.com/resc/fairupdt.pdf> (accessed Sept. 20, 2004); Mueller, *supra* n. 109.

110. Rules, *supra* n. 59.

111. ICANN, *The Staff Report on Implementation Documents for the Uniform Dispute Resolution Policy*, <http://www.icann.org/udrp/staff-report-29sept99.htm> (Sept. 29, 1999) indicates that in August of 1999 the ICANN board resolved that revisions should be made to the Model Domain Name Dispute Resolution Policy for Voluntary Adoption by Registrars and the Model Rules for Uniform Domain Name Dispute Resolution Policy, the precursors to the UDRP and the Rules for Uniform Domain Name Dispute Resolution Policy respectively, to "define and minimize reverse domain name hijacking." Although the Rules do define reverse domain name hijacking, the "countermeasures" it provided in Rules ¶ 15(e) include no sanctions for attempts to hijack a domain name through the UDRP. *See* Dawn C. Nunziato, *Freedom of Expression, Democratic Norms, and Internet Governance*, 52 Emory L.J. 187, 278 (2003).

112. *See* Rules, *supra* n. 59, at ¶¶ 15(e), 16(b).

113. Nunziato, *supra* n. 113, at 213.

squatting.[114] However, the policy tradeoff of the UDRP, to create faster and easier procedures for trademark holders to challenge abusive domain name registrations, also creates an additional incentive for domain name hijacking.[115] According to recent report prepared by Dr. Milton Mueller, an associate professor at the Syracuse University's School of Information Studies and a WIPO arbitration panelist,[116] probing the phenomena of reverse domain name hijacking under the UDRP: "[a] significant number of complainants have attempted to use the UDRP to acquire property rights over generic terms or to seize valuable names from legitimate owners."[117]

In his report Dr. Muller identifies several cases of reverse domain name hijacking that demonstrate the weakness of the UDRP on this point.[118] In one such case, Case No. D2000-0376, a WIPO arbitration panel transferred the domain name tonsil.com to a large German chemical manufacturer with trademark interests in the word "Tonsil."[119] The respondent in the case was technically tonsil.com, however Ms. Virginia Comito of Cupertion, California, tonsil.com's administrative contact, acted on behalf of the respondent.[120] The complainant was Süd-Chemie AG of Munich, Germany, a maker of bleaching earths and clays, who holds several trademark registrations for "Tonsil" and "TONSIL."[121]

In considering the respondent's legitimate rights or interests under 4(c) the arbitration panel states:

> Respondent offers a letter, not on letterhead, that purports to be from Mr. Nicholas W. Blasgen (Ex. F1), purportedly the Co-Founder and CEO of Refract, LLC. Since November 18, 1998, Refract is allegedly the host provider for the web address Tonsil.com. . . . the Panel would have expected her to present what she or counsel must have known was an important document in a form which would have had probative value. . . In its present form, pursuant to the authority conferred upon it by Rule 10(d), the Panel finds that this letter is without probative value, and therefore Ms. Comito has not proven any use whatsoever of the domain

114. Mueller, *supra* n. 109, at 3.

115. *Id.* at 5.

116. Geist, *supra* n. 111, at 26.

117. Mueller, *supra* n. 109, at 26. The Muller report indicates that UDRP arbitration "panelists have been extremely reluctant to make RDNH findings" and continues to explain that "panelists have cited the lack of clear criteria in the ICANN policy to guide a finding . . . ." of reverse domain name hijacking. *Id.*

118. For more examples of reverse domain name hijacking identified by Dr. Muller *see* Mueller, *supra* n. 109, at 26.

119. *Süd-Chemie AG v. tonsil.com*, WIPO Arbitration & Mediation Center Case No. D2000-0376 (July 3, 2000) (available at http://arbiter.wipo.int/domains/decisions/html/2000/d2000-0376.html).

120. *Id.*

121. *Id.*

name of her alleged website.[122]

It is important to note that UDRP 4(a) places the burden of proof squarely on the shoulders of the complainant in a UDRP proceeding.[123] In the excerpt above the arbitration panel seems to demonstrate its hostility toward the respondent by reversing that burden and requiring the respondent prove its use, rather than requiring the complainant disprove it; an ill effect only compounded by its decision to discount the proof offered by the respondent because it is not presented in the appropriate form. In an online dispute resolution procedure as spare as that outlined by the UDRP and the Rules for UDRP one would not expect such hostility from a UDRP arbitration panel regarding the form of the evidence submitted, but as the Tonsil.com website was not online during the "several occasions" the panel attempted to visit it,[124] perhaps the panel was simply skeptical.

The panel's cursory treatment of Ms. Comito's reverse domain name hijacking claim also evidences the bias of the UDRP toward trademark owners and the potential hostility of the UDRP process toward the interests of other Internet users. In response to the reverse domain name hijacking claim, the panel merely says, "The Complainant proved all three elements set forth in paragraph 4(a) of the Policy. The Complainant therefore did not act in bad faith by bringing its Complaint. A ruling on the Respondent's claim of reverse domain name hijacking is inappropriate."[125] First, close attention to the panel's language regarding the legitimate interest portion of its analysis indicates not that the complainant proved UDRP § 4(a)(ii), but that the respondent failed to disprove them.[126] Second, any meaningful analysis of the claimant's reverse domain name hijacking claim was forestalled by the finding in favor of a transfer of tonsil.com to Süd-Chemie AG.

When charges of reverse domain name hijacking are at their most serious, viz. when the complainant will succeed in hijacking the domain name, the charge is always moot. A charge of reverse domain name hijacking does not trigger any sort of review or independent analysis.[127] Instead reverse domain name hijacking charges are simply dealt with by the panel in the course of its regular proceeding and are not subject to

122. *Id.* On this point the arbitration panel seems much more concerned with the behavior of the respondent and the format employed than the merits of the case before it. *See* Mueller, *supra* n. 109, at 23 (Table 11).

123. UDRP, *supra* n. 5, at ¶ 4(a).

124. *Süd-Chemie AG v. tonsil.com*, WIPO Arbitration & Mediation Center Case No. D2000-0376 (July 3, 2000) (available at http://arbiter.wipo.int/domains/decisions/html/2000/d2000-0376.html).

125. *Id.*

126. *Id.*

127. Nunziato, *supra* n. 113, at 213.

appeal.[128] As such, Ms. Comito's complaint was "properly" dismissed because the panel has determined the complainant proved all of the necessary elements. This weakness becomes even more troublesome when a more objective analysis of the *Süd-Chemie AG v. Tonsil.com* proceeding indicates that tonsil.com was in fact clearly hijacked through the UDRP process.[129]

The *Tonsil.com* case is obviously an example not only of reverse domain name hijacking, but also of the poor quality decisions that can be generated by the process outlined by the UDRP.[130] The *Tonsil.com* case is an extreme example, but it is not the most extreme.[131] The *Tonsil.com* arbitration was provided under the auspices of the WIPO, an organization that not only had a hand in the creation of the UDRP,[132] but also administers a majority of its arbitrations.[133] In the majority of the cases of reverse domain name hijacking identified by Dr. Muller, reverse domain name hijacking claims were either denied or ignored.[134] The lack of sanctions to accompany a reverse domain name hijacking finding[135] do little to reduce the financial incentives for trademark owners to employ the UDRP, biased as it is in their favor, to obtain potentially valuable domain names from legitimate users of the Internet for a nominal fee.

The options for a victim of reverse domain name hijacking, or anyone who has wrongly lost a domain name in a UDRP proceeding, are extremely limited. Although the UDRP purports to serve the interests of both trademark holders and domain name registrants, the UDRP provides no appeal procedure for a non-prevailing party.[136] This means that a domain registrant who has lost a UDRP proceeding must obtain a

128. *See* Nunziato, *supra* n. 113, at 213 & 278. For more discussion of the lack of an appellate process within the UDRP framework *see* Port, *supra* n. 5, at 1102 & *supra* n. 64 and accompanying text.

129. Mueller, *supra* n. 109, at 25.

130. *Id.* at 23, 25.

131. *Id.* at 23. At the top of Dr. Muller's list of RBDs (Really Bad Decisions) is the *Crew.com* case, WIPO D2000-0054, in which arbitration panel crafted "a 'preclusion doctrine' that holds that the prior registration of a name constitutes bad faith under 4(b)ii of the policy because it prevents the trademark holder from having the name. Since domain name registrations are by definition exclusive, this could be used to justify bad faith for any name a trademark holder wants." *Id.* (Table 11).

132. Timeline, *supra* n. 44.

133. Geist, *supra* n. 69, at 6. The data of the Geist study, as of July 7th, 2001, relating to forum shopping indicates that the WIPO enjoyed a fifty-eight percent share of the UDRP arbitration market, a figure that has likely increased with the withdrawal of eResolutions from the arbitration business. For an update essentially confirming the earlier findings of the Geist study *see* Geist, *supra* n. 111.

134. Mueller, *supra* n. 109, at 25 (Table 13).

135. Nunziato, *supra* n. 113, at 213.

136. Port, *supra* n. 5, at 1102.

federal court injunction to prevent the registrar from transferring or canceling a domain name.[137] The UDRP provides a fast and cost effective procedure for resolving disputes in favor of a trademark holder, but no corollary procedure to protect or even address the rights of domain name registrants.[138] As such, a reverse domain name hijacking victim must bear the cost, in time and money, of a federal suit to obtain redress. Conversely, the UDRP imposes no cost on trademark holders it identifies as reverse domain name hijackers.[139] The poor practical and theoretical balance struck by the UDRP between trademark owners and domain name registrants demonstrates the inconsistency of the UDRP with the norms of traditional trademark law and those articulated for the development of the UDRP itself through the Green Paper and NTIA White Paper.

IV. ANALYSIS OF THE UDRP'S NORMATIVE CONSISTENCY

Though there is some disagreement between economists as to whether trademarks create barriers to market entry,[140] the value of trademarks to competition far outweighs their potentially monopolistic effects.[141] Trademarks provide a system of consumer information regarding the quality and source of goods that is absolutely essential to existence of rational decision-making in a market context.[142] In reporting the measure that became the Lanham Act the Senate Committee on Patents clarified the essential significance of and justification for trademark protection:

> Trademarks, indeed, are the essence of competition, because they make possible a choice between competing articles by enabling the buyer to distinguish one from the other. Trademarks encourage the maintenance of quality by securing to the producer the benefit of the good reputation which excellence creates. To protect trademarks, therefore, is to protect the public from deceit, to foster fair competition, and to secure the business community the advantages of reputation and good will by their diversion from those who have created them to those who have not.[143]

Unfortunately, the UDRP does far more than secure businesses the advantages of their reputation and goodwill; the UDRP systematically fa-

137. *Id.*

138. A domain name registrant cannot file a complaint under UDRP without rights in a trademark that is confusingly similar to the disputed domain name. As such, the UDRP can be employed as a tool to transfer domain names to trademark owners, but never to transfer or restore domain names to registrants without trademark rights.

139. Nunziato, *supra* n. 113, at 213.

140. McCarthy, *supra* n. 1, at § 2:12.

141. *Id.* at § 2:13.

142. *Id.*

143. S. Rep. 1333, 79th Cong., 2d Sess. (1946) (reprinted in 1946 U.S.C.C.A.N. 1275).

vors trademark holders in a property-shifting regime that bears little relation to the consumer protective, good will focused justifications of traditional trademark law.

A. THE UDRP'S CONSISTENCY WITH THE NORMS OF THE INTA WHITE PAPER

Although the UDRP is undeniably more robust than the previous domain name dispute resolution policy created by the NSI and discussed in the 1997 INTA White Paper, it falls far short of the balanced, "sui generis" policy keyed to traditional trademark norms that is advocated by the INTA. With its strong trademark owner bias and practical tolerance of reverse domain name hijacking, the UDRP is subject to many of the criticisms leveled against the NSI policy in the INTA White Paper. Although in theory the UDRP does not apply to legitimate users or those not operating in bad faith, in practice the UDRP often treats legitimate users the same as Internet pirates, just as the previous NSI policy did.[144] UDRP's bias toward trademark holders is at odds with the INTA's focus on the need for a balanced system sensitive to the multiple equities of Internet users and trademark owners.[145] The INTA's confidence in the flexibility and sufficiency of traditional trademark law and courts is undermined by the UDRP's creation of a process that expands the rights of trademark holders on the Internet.[146]

The UDRP fails to operate in harmony with the traditional principles of trademark protection. The INTA White Paper explores the inter-

144. *See* INTA White Paper, *supra* n. 9, at 679–80.

145. It is interesting to n. that INTA, through the INTA Internet Committee, has attempted to rebut the analyses of Mueller, *supra* n. 109 and Geist, *supra* n. 69 regarding the inherent trademark owner bias of the UDRP. The INTA has drafted two rather short rebuttal documents attacking the methods and conclusions of Geist and Muller in their efforts to evaluate the limited statically data available regarding the UDRP process and its outcomes. *See* International Trademark Association, *The UDRP by All Accounts Works Effectively: Rebuttal to Analysis and Conclusions of Professor Michael Geist in "Fair.com?" and "Fundamentally Fair.com?"*, <http://www.inta.org/downloads/tap_udrp_2paper2002.pdf> (May 6, 2002); International Trademark Association, *UDRP—A Success Story: A Rebuttal to the Analysis and Conclusions of Professor Milton Mueller in "Rough Justice"*, <www.inta.org/downloads/tap_udrp_1paper2002.pdf> (May 6, 2002). Although the INTA rebuttal documents do not implicate the relevant quality centric norms the INTA White Paper has contributed to this Note's analysis of the normative consistency of the UDRP, they do offer a relevant, if narrow and cursory, critique of the relevant works of Geist and Mueller. The INTA's defense of the UDRP on this score indicates a potential divergence between the INTA's pre-UDRP and post-UDRP policies regarding domain name dispute resolution as demonstrated by the marked differences between the UDRP and the INTA's "sui generis" plan for domain name dispute resolution. It will be interesting to see how the INTA and allied organizations, such as the WIPO, further respond to the growing body of scholarship exploring and condemning the UDRP's trademark holder bias.

146. *See supra* Part II.A.

section of trademark rights and domain names, articulating the traditional consumer and quality protective justifications of trademark protection as both favoring and limiting the property interest of trademark owners in domain names that contain their trademarks. The UDRP has exceeded the logical limitations of trademark protection by establishing a blunt, insensitive process through which trademark holders expand, rather than protect their trademark interests.[147] The limitations and distinctions of traditional trademark law articulate a system of rights that centers on encouraging quality, maintaining the validity of the consumer quality assumption and, ultimately, protecting consumers from deceit, yet in practice the UDRP services none of these essential functions. The fundamental normative failure of the UDRP calls into question the validity of the UDRP and the expedited process it creates and challenges potential justifications for its spare process.

B. UDRP's Consistency with the Norms of the Green Paper and NTIA White Paper

In practice and theory the UDRP fails to adequately address many of the norms identified to govern it in the Green Paper and NTIA White Paper issued by the United States government. The guiding principles articulated by the NTIA White Paper are representation, competition, stability and bottom-up coordination. The stability of the Internet is harmed when trademark owners seek the transfer of well-established domain names to satiate their desire forever expanding Internet presence and additionally when those names are hijacked by trademark holders through the less than balanced process of the UDRP.[148] With its pervasive trademark owner bias and allowance of forum shopping, the UDRP also fails in its representation of the interests of the Internet community as a whole. The UDRP has become a tool that expands the rights of trademark owners on the Internet and subsidizes their exploitation of the Internet at the expense of other Internet users.[149] In practice UDRP

147. Recall the discussion and quotation of *supra* n. 11 detailing the limitations of the property trademark property interest originating in the tort of deceit. In practice the UDRP has stepped beyond these traditional, logical boundaries and established an offensive weapon that expands the rights of mark holders on the Internet beyond those conferred in the physical world. Rather than protecting the quality assumption of consumers and reducing consumer information costs (a tall order given the extraordinarily low cost of obtaining information on the Internet) the UDRP provides a system that subsidizes trademark owners in their attempts to acquire new property. The previously peripheral benefit of encouraging producer quality by protecting goodwill has been twisted into a license for mark owners to take what they like without regard to the interests of others or the justification or validity of the process through which their acquisitions are accomplished. *See supra* Parts III.C.1-2.

148. *See supra* Part III.C.2

149. *See supra* n. 149.

arbitrations have proven insensitive to the concerns of legitimate Internet users and the UDRP's lack of procedural protections has allowed trademark owners to deprive legitimate Internet users of their domain names through reverse domain name hijacking. To add insult to injury, the UDRP provides no appeal procedure through which wronged domain name registrants may seek redress in the same sort of speedy and economical process granted trademark owners.

The UDRP's fundamental insensitivity to the normative principle of representation reveals a critical inconsistency within its normative framework. The NTIA White Paper explains that the principle of representation combined with the fact that the new policy was not intended to supplant existing legal principles and regimes, including those of trademark law, was to ensure that the interest of the entire Internet community would be served by the new DNS policy. The UDRP's failure to address the needs of the whole Internet community and the degree to which it displaces previous trademark law and principles create a dichotomy between the UDRP's practical and theoretical function and its essential, normative mandate.

The NTIA White Paper calls on the World Intellectual Property Organization to design a balanced and transparent dispute resolution process,[150] but the UDRP is neither. Though the publication guidelines of UDRP 4(j) assure that the mandatory administrative proceedings contemplated by the UDRP are in some part subject to public scrutiny,[151] the UDRP process is far from transparent. The UDRP contains no clear principles to govern determinations of guilt or innocence, but instead relies upon circumstantial cases that provide evidence of the elements to be proven.[152] The lack of transparency and clarity with regard to the standards to be applied within a UDRP proceeding creates a serious challenge for a domain name registrant attempting to draft a response within the limited process of the UDRP.[153] Also, the tacit hostility of some UDRP arbitration service providers toward the rights and claims of

150. NTIA White Paper, *supra* n. 35, at 31,747.

151. UDRP, *supra* n. 5, at ¶ 4(j).

152. *See* Segal, *supra* n. 97, at 36.

153. *See* Segal, *supra* n. 97, at 36 & n. 220. Given the tight timetable of a respondent in a UDRP action and the inability to file supplementary materials or obtain a face-to-face hearing, the lack of clear principles is a serious impediment to respondents within the UDRP process. After all, the arbitration panel in a UDRP proceeding is free to examine any circumstance it deems relevant and a respondent has no opportunity to rebut or appeal an adverse finding and little chance of anticipating what factors the panel will choose to examine. *See Süd-Chemie AG v. tonsil.com*, WIPO Arbitration & Mediation Center Case No. D2000-0376 (July 3, 2000) (available at http://arbiter.wipo.int/domains/decisions/html/2000/d2000-0376.html) (providing an example of a UDRP proceeding that considered a wide berth of factors not specifically enumerated in the UDRP and only tangentially related to the principles of analysis it sets forth).

domain name registrants and the inherent bias in the UDRP encouraging providers to cater to forum shopping complainants creates the potential for corruption and injustice below the slick veneer of the UDRP's vague, but polished language. The trademark holder bias can transform seemingly simple and clear UDRP proceedings into machinations of rationalization capable of entirely subverting not only the intent of the UDRP's hazy provisions, but also the normative principles that justify and ought to inform the UDRP's specialized process for resolving disputes between domain names and trademarks.[154]

Similarly, the NTIA White Paper mandate that the domain name dispute resolution system adopted by the new DNS management corporation be a balanced process is at odds with the UDRP's theoretical design and practical workings. Obviously, any characterization of the UDRP as balanced is subject to strong criticism insofar as the UDRP is biased in favor of trademark holders. The various procedural and substantive manifestations of the UDRP's systematic service of the interests of trademark holders to the exclusion of a real and robust consideration of the rights and interests of other Internet community members speaks for itself. The balance of the UDRP is also impeached by the mechanical, sudden death approach of the process outlined in UDRP ¶ 4(a)-(c).[155] The UDRP's divergence from the factor balancing analysis of the ACPA and trademark law more generally, practically limits the UDRP's ability to balance the equities and interests of individual situations. The UDRP's openness to naked forum shopping by trademark owner complainants generates a practical process that panders to the interests of mark holders and forces domain name registrants to respond to actions at a sever disadvantage to the trademark owners seeking the transfer or cancellation of the disputed domain names. The mechanical nature of the substantive process outlined in the UDRP forces a narrow analysis subject to manipulation and the biases of the UDRP's procedure and individual arbitrators.[156] As such, the UDRP utterly fails to comply with

154. *See supra* Part III.C; *Süd-Chemie AG v. tonsil.com*, WIPO Arbitration & Mediation Center Case No. D2000-0376 (July 3, 2000) (available at http://arbiter.wipo.int/domains/decisions/html/2000/d2000-0376.html); *J. Crew Intl, Inc. v. crew.com*, WIPO Arbitration & Mediation Center Case No. D2000-0054 (April 20, 2000); Muller, *supra* n. 117, at 23–25.

155. *See supra* Part IV & n. 86.

156. The UDRP's analysis is narrowed because the vague and spare, though non-exclusive, evidentiary cases included in UDRP ¶¶ 4(b) & (c) call for de-contextualized conclusions regarding rigid factors. This type of analysis allows little opportunity for the consideration of the complex equities of individual situations that may easily straddle and strain the limits of the UDRP's analytical framework. It should be noted that the cases outlined in UDRP ¶¶ 4(b) & (c) are open in the sense that they allow for the inclusion of additional circumstances that may serve as evidence of the lack of legitimate interest and the presence of bad faith, but their language does not allow for the inclusion of additional factors that may mitigate or disprove either finding. If the UDRP's burdens of proof are

the norms of balance, transparency and representation mandated by the NTIA White Paper and remains at odds with the principles and policies that presume to justify and validate it as an efficient alternative to a suit in federal court.

C. Suggestions and Summary of Critique

This Note has suggested that the UDRP process has expanded well beyond the limits of its normative justification in the protection of trademark rights and the guidelines provided for it by the Department of Commerce. The inconsistency of the UDRP with the norms that ought to govern its operation is a serious issue, striking to the heart of the validity of the UDRP as an adjudicatory process. The UDRP provides a fast and economical process for resolving disputes between domain names and trademarks, but it does so in an unprincipled fashion. How can a process as biased and inconsistent as the UDRP be allowed to stand within the developed and sophisticated legal culture of the United States? The answer is simple: the UDRP is an experiment that has failed, but we are stuck with the results.[157]

However, some good may yet come from the failure of the UDRP; the UDRP can teach us what not to do in the future. The process of the UDRP is simply too spare and too subject to manipulation to provide just results. An effective regime of domain name dispute resolution will have to harmonize more effectively with the basic principles and standards of traditional trademark law than the UDRP. Particularly, a more effective domain name policy needs to pack its protection of trademarks to the justifications and limitations of those protections rooted in consumer protection and the encouragement of quality through the protection of business goodwill.[158] It also ought to employ a factor based balancing test with clear, principled guidelines that provide for the interests of trademark owners and Internet users alike.[159] An effective domain name dispute policy will also have to include a significant and accessible appellate process and combat forum shopping with a system of random-

---

strictly maintained the effects of this weakness may be lessened, but it is not entirely clear that the burden of proof is always properly borne by complainants in UDRP proceedings. Additionally, the vagueness of the UDRP's language, its weakness forum shopping weakness and the lack of a mechanism for appellate review within the UDRP framework create an environment that seems vulnerable to limited manipulation of complainants and unchecked manipulation by biased arbitrators. For examples demonstrating the import of these and allied weakness *see* the lists discussed in *supra* nn. 68 & 144. For further discussion of the failure of the UDRP to exclude individual arbitrator biases *see* Segal, *supra* n. 97, at 37.

157. *See* Froomkin, *supra* n. 6, at 1100–01.

158. *See supra* Parts III.B, IV.A-B.

159. *See supra* Parts III.C & IV.B.

ized provider selection.[160] Additionally, to protect its legitimacy and ensure loyalty to its normative mandate a more effective domain name dispute resolution policy has to contain a safe harbor provision and allow a more flexible submission process capable of allowing respondents the opportunity to adequately prepare a response and provide all the supplementary materials necessary to ensure a just and equitable resolution.[161]

V. CONCLUSION

The INTA White Paper, the NTIA White Paper and Green Paper articulate interlocking systems of norms that theoretically furnish the UDRP with legitimacy and validity as an adjudicatory process. However, the UDRP has stepped beyond the normative mandate of the NTIA White Paper and logical limitations of trademark protection elucidated in the INTA White Paper. The prevalence of forum shopping and the unchecked potential, if not license, for reverse domain name hijacking under the UDRP provide serious challenges to any coherent, rational synthesis of the UDRP's normative mandate and its practical function. The UDRP process has become isolated from the very principles that justified its creation as a novel, private dispute resolution program to provide economical and expedient relief to trademark owners besieged by the abusive, predatory behavior of Internet pirates. Instead of protecting trademark owners against the abusive use of their marks by Internet profiteers, the UDRP has allowed trademark owners to greatly expand their property interest in their marks online, at the expense of the rights and interests of the wider community of Internet users. The UDRP today fails to describe a meaningful solution to the potential conflicts presented by the intersection of domain names and trademarks, but its fatal failure to generate a balance among the many relevant interests underscores the need to focus on principled approach and a tight relationship between the process and the norms that justify it in whatever system ultimately succeeds the UDRP.

J.R. Hildenbrand†

160. For more regarding the potential of randomized provider selection *see* Segal, *supra* n. 97, at 42-43.

161. *See supra* Part III.B.2 & III.C.

† J.D., The Ohio State University Moritz College of Law, 2005; B.A., Case Western Reserve University, 2002. Thank you to Professor Sheldon Halpern for his assistance and to JT and my family for their support.