

Cybersquatting of UKM Domains: ukm.biz; ukm.com; ukm.info; ukm.net; ukm.org

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ABSTRACT

The deliberate, bad faith registration of domain names that violates a trade or service marks rights is not restricted to famous and well-known marks only, but personality names and names of institute of higher learning have also been vulnerable to such predatory practices. Two separate searches for the term 'ukm' using the WHOIS database reveal that four out of five of the generic top level domains, only one registrant has a legitimate interest to use 'ukm' for its domain name. Universiti Kebangsaan Malaysia should submit a complaint under the Uniform Dispute Resolution Proceedings (UDRP) to recover the relevant domain names.

ABSTRAK

Pendaftaran nama domain yang sengaja dan mempunyai niat jahat serta melanggar hak terhadap cap dagangan atau cap perkhidmatan tidak terhad kepada cap dagangan terkenal sahaja tetapi, nama personaliti terkenal dan nama institut pengajian tinggi juga tidak terkecuali daripada tindakan sedemikian. Dua carian untuk terma 'ukm' menggunakan pangkalan data WHOIS menunjukkan bahawa empat daripada lima domain generik peringkat pertama, hanya satu pendaftaran sahaja yang dipegang oleh orang mempunyai kepentingan yang sah untuk menggunakan 'ukm' sebagai nama domain. Universiti Kebangsaan Malaysia patut memfailkan satu aduan di bawah Uniform Dispute Resolution Policy untuk mendapatkan kembali nama domain yang berkaitan.

INTRODUCTION

As commercial activities accelerate on the internet, the importance of domain names continues to grow. Many companies are striving to establish an internet presence, which requires them to carefully choose and register a domain name. Indeed, having a domain name which is known to the consumer and similar to one's business is crucial, it will enhance the capability to capture the market and losing a domain name can mean going out of business.¹

¹ Ida Madieha Azmi, 'Domain Names and Cyberspace - The Application of Old Norms to New Problems' [2000] 8 *International Journal of Law and Information Technology*. Oppendahl, Carl, 'Analysis and Suggestion Regarding NSI Domain Name Trade Mark Dispute Policy' [1996] 7:1 *Fordham Intellectual Property, Media & Entertainment Law Journal* 73.

The preference to register domain names that are similar to company names or registered trade marks has in turn, escalates in the number of conflicts between trade marks and domain names. The conflict centers on the issue as to who has the right to register a domain name which is similar to a trade mark or business name. Famous and well-known marks have constantly been the special target of predatory and parasitical practices of domain name registrants.² But the practice is not limited to famous and well-known marks, personal names as well as names of institute of higher learning have also been registered by cybersquatters.

WHAT IS A DOMAIN NAME

Internet domain name is the substitute and the user-friendly form of internet addresses,³ and are commonly used to locate web pages. Every web page has an internet address and a corresponding domain name. Domain name is easier to remember than internet address. As textual address, it facilitates humans to locate a host computer with ease on the internet.⁴ Such names are usually memorable and catchy words such as the name of individuals, companies or trade marks.⁵ For example, the domain name 'wipo.int' is used to locate the World Intellectual Property Organization (WIPO) web site at <http://www.wipo.int>

Domain names contain multiple field of information, and must have at least two parts – top level domain (TLD) and second level domain (SLD). Top level domain is further divided into generic top level domain (gTLD)⁶ and country

² *The Management of Internet Name and Addresses: Intellectual Property Issue*, Final Report of the WIPO Internet Domain Name Process, at <http://wipo2.wipo.int>, last visited on 25th April 2003.

³ The numerical internet addresses are expressed as four numbers between 0 and 255, separated by dots, such as 202.185.48.7. These numbers identifies the network as well as the local user using the computer in the network.

⁴ MYNIC FAQ at <http://mynic.net/mynicfaq>, last visited on 25th April 2003. Internet applications have been designed to automatically translate the numeric internet address into mnemonic domain names, which is done through Domain Name Service (DNS), a distributed database which comprises of computers, data files, software and people working together.

⁵ Johnson, 'Susan, Internet Domain Names and Trade Mark Disputes: Shifting Paradigms in Intellectual Property' (2001) 43 *Arizona Law Review* 465.

⁶ gTLD consist of .com for commercial organizations, .net for organizations offering network services, .org for non-profit organization, .edu for educational institutions, .int for international organizations, .gov for government agencies, .mil for military agencies, .aero for aero industries, .biz for business, .coop for cooperation, .info for information, .museum for museums, .name for individuals and .pro for professionals. Some of the gTLD are open for all to register while others are restricted to entities fulfilling a number of criteria.

specific top level domain (ccTLD).⁷ Technically, both gTLD and ccTLD fulfill equivalent function but gTLD are preferred. Internet users believe that gTLD, especially .com, is a symbol of prestige and status.⁸

Domain names are allocated on a 'first come first serve' principle. Essentially, this means that if there are two entities operating their businesses using an identical trade mark, the domain name incorporating their trade mark will be given to whomever earlier in registering the domain name.⁹ Registration for gTLD can be made with any of the Internet Corporation for Assigned Names and Numbers (ICANN) accredited registrants.¹⁰ In Malaysia, registration of domain names for ccTLD .my is placed under the Malaysia Network Information Centre (MYNIC).¹¹ MYNIC, which is administered by Mimos Berhad administers the second level domain (SLD) under the ccTLD for '.my' domains, namely, '.co.my', '.net.my', '.org.my', '.gov.my', '.edu.my' and '.mil.my'

DOMAIN NAMES DISPUTES - CYBERSQUATTING

While traditionally serve to facilitate humans to navigate the internet, domain names have acquired a secondary meaning as business identifiers, which has become part of a normal communication tool used by business to identify itself, their product and services.¹² Internet users often assume that a domain name of a particular company or institution is the company's or institution's name followed by a '.com'.¹³ In turn, domain names come into conflict with the system of business that existed before the arrival of the internet and are protected by intellectual property rights.¹⁴

⁷ There are 243 ccTLD around the world. Each ccTLD has two characters in accordance with ISO 3166 standard. Examples of ccTLD are .my for Malaysia, .au for Australia, .sg for Singapore, .tv for Tuvalu and .us for United States of America. Most of the ccTLD are restricted to entities domiciled in the particular while some, such as .tv and .cc are open to all.

⁸ Osterman, Karin, 'Overcoming the Internet Challenge' [1998] *Trade Mark Yearbook* 3; Wood, Nicholas, 'Generic Top Level Domains – What's All the Fuss About?' [1998] *Trademark World* 24 .

⁹ See *Prince Plc v. Prince Sports Group Inc* [1998] FSR 21; *Pitman Training v. Nominet* [1997] FSR 797; *Avnet Incorporated v. Isoact Limited* [1998] FSR 16; *French Connection Ltd v. Sutton* [3 December 1999]; *Efax.com v. Oglesby* [25 January 2000]; *Lawyers Online v. Lawyeronline* [7 July 2000]; *MBNA v. Freeman* [17 July 2000].

¹⁰ ICANN list of accredited and accreditation-qualified registrars at <http://icann.org/list>, last visited on 25th April 2003.

¹¹ Rules on choices of domain names at <http://www.mynic.net.my/doc> last visited on 25th April 2003. MyNIC registers .my domain ie. .com.my, .net.my, .org.my, .gov.my and .mil.my.

¹² Final Report of WIPO Internet Domain Name Process at <http://www.ecommerce.wipo.int/domains/archive>, last visited on 25th April 2003.

¹³ Teo Bong Kwang, *Trade mark law and practice in Malaysia*, Butterworths, 2001, pg. 353.

¹⁴ WIPO Guidelines at <http://www.wipo.int/domains/guidelines>, last visited on 25th April 2003.

Most domain name disputes arise from the practice of cybersquatting; a term commonly used to describe the deliberate, bad faith, abusive registration of a domain name in violation of rights in trade marks and service marks.¹⁵ In the WIPO Final Report on Domain Names, the registration of a domain name is considered to be abusive when all of the following conditions are met:

1. The domain name is identical or misleadingly similar to a trade or service mark in which the complainant has rights; and
2. the holder of the domain name has no rights or legitimate interests in respects of the domain name; and
3. the domain name has been registered and used in bad faith.¹⁶

The Report also explains the evidence of the registration and use of a domain name on bad faith as:

- a. An offer to sell, rent or otherwise transfer the domain name to the owner of the trade or service mark, or to a competitor of the owner of the trade or service mark, for valuable consideration; or
- b. an attempt to attract, for financial gain, internet users to the domain name holder's website or other on-line location, by creating confusion with the trade or service mark of the complainant; or
- c. the registration of the domain name in order to prevent the owner of the trade or service mark from reflecting the mark in a corresponding domain name, provided that a pattern of such conduct has been establish on the part of the domain name holder; or
- d. the registration of the domain name in order to disrupt the business of a competitor.¹⁷

There are in principle four main users of cybersquatting. In *British Telecommunications PLC and Another v. One In A Million Ltd and Other Action (One In A Million)*,¹⁸ Lord Justice Aldous said:

For a dealer in Internet domain names there are in principle only four uses which the name can be put. The first and most obvious is that it may be sold to the enterprise whose name or trade mark has been used, which may be prepared to pay a high price to avoid the inconvenience of there being a domain name comprising its own name or trade mark which is not under its control. Secondly, it may be sold to a third party unconnected with

¹⁵ Final Report of WIPO Internet Domain Name Process at <http://www.ecommerce.wipo.int/domians/archive>, last visited on 25th April 2003; See also Lea, Gary, 'Trying to evict the cybersquatters: The interaction of trade mark law and internet domain name registration' [1997] 2:3 *Communications Law* 99.

¹⁶ Ibid.

¹⁷ Ibid.

¹⁸ [1999] RPC 1.

the name, so that he may try to sell it to the company whose name is being used, or else use it for the purpose of deception. Thirdly, it may be sold to someone with a distinct interest of his own in the name, for example a solicitor by the name of John Sainsbury or the government of the British Virgin Islands, with a view to its use by him. Fourthly, it may be retained by the dealer unused and unsold, in which case it serves only to block the use of that name as a registered domain name by others, including whose name or trade mark it comprises.

There are profuse courts decisions concerning domain names disputes in the United States and the United Kingdom. Early cases of domain name disputes were settled outside the courthouse but they are warning signs that the practice will be escalating. In *MTV v. Adam Curry*,¹⁹ Adam Curry, a former video disk jockey of MTV Networks registered and use the domain name 'mtv.com'. Curry claimed that he had been given permission to use the name to develop an internet site which dispatched daily reports of gossip regarding the entertainment and music industry.²⁰ He continued to use the site even after his employment was terminated. The case was settled outside the courthouse, when Curry hand over the name to MTV on undisclosed terms.

In *Stanley Kaplan v. Princeton Review*,²¹ a dispute between two rival test preparation companies, Princeton registered the name 'kaplan.com' and use the site to provide electronic materials disparaging the quality of Kaplan services and extolling the comparative advantages of Princeton courses.²² Princeton told Kaplan that the site was done as a joke and offered to sell back the name to Kaplan. Kaplan rejected the offer and the parties agreed to submit the case to an arbitrator, who ordered that Princeton Review had to give up the domain name 'kaplan.com'.

In a landmark UK case of *One in A Million*,²³ the respondents Marks & Spencer PLC, J Sainsbury PLC, Virgin Enterprises Ltd, British Telecommunications PLC, Telecom Securicor Cellular Radio Ltd and Ladbrokes PLC are well known companies. The appellants are dealers in internet domain names. They register domain names for use on the internet comprising of well-known trade marks without the consent of the company. The respondents complained that the activities of registering domains names 'ladbrokes.com', 'sainsbury.com', 'j-sainsbury.com', 'markandspencer.com', 'cellnet.com',

¹⁹ 867 F. Supp 202 (SDNY 1994).

²⁰ Weiswasser, Gayle, 'Domain Names, the Internet and Trademarks: Infringement in Cyberspace' [1997] 13 *Computer and Technology Law Journal*.

²¹ 1604 (MGC)(SDNY) 1994. See also *McDonalds v. Quitter*, where Quitter registered 'mcdonalds.com' who later transfer the name to McDonalds after the latter agreed to donate \$3,500 to a public school.

²² Burk, Dan, 'Trademark Along the Infobahn: A First Look at the Emerging Law of Cybermarks' 1 *Richmond J.L. & Tech.*

²³ [1999] RPC 1.

'bt.org', 'virgin.org', 'markandspencer.co.uk', 'britishtelecom.co.uk', 'britishtelecom.net' and 'britishtelecom.net' amounted to passing off and infringement of their registered trade mark.

Lord Justice Aldous in that case observed that:

...the name Marks & Spencer denotes Marks & Spencer Plc and nobody else. Thus, anybody seeing or hearing the name realizes that what is being referred to is the business of Marks & Spencer Plc. It follows that registration by the appellants of a domain name including the name Marks & Spencer makes a false representation that they are associated or connected with Marks & Spencer Plc. This can be demonstrated by considering the reaction of a person who taps into his computer the domain name marksanspencer.co.uk and presses a button to execute a 'whois' search. He will be told that the registrant is One In A Million Ltd. A substantial number of persons will conclude that One In A Million Ltd must be connected or associated with Marks & Spencer Plc. That amount to a false representation which constitutes passing off.

From the above, a person who wants to find a site, they will usually type the name followed by .com or .org, etc. Therefore, it can be said that people associate a domain name with trademark.

WIPO UNIFORM DISPUTE RESOLUTION POLICY

The WIPO Uniform Dispute Resolution Policy (UDRP) is a dispute resolution policy adopted by the Internet Corporation for Assigned Names and Numbers (ICANN) for domain name disputes ending in generic top-level domains (gTLD) for example, domain names ending with .com, .net, .edu, .gov, .int, .mil, .org. The UDRP contained terms and conditions applicable to any party who register any gTLD with a registrar,²⁴ and binds the party to any dispute with regard to the registered gTLD that might arise between the party and any other third party.

Today, a dispute resolution policy is the most appropriate method of dealing with domain name disputes.²⁵ Indeed, the global character of the internet and the effect of internet activity which is trans-national in nature, calls for the establishment of a dispute resolution policy for domain names that international and consistent in scope.²⁶ A dispute resolution policy is a useful mechanism in reaching fast and effective commercial settlement in domain name disputes.²⁷

²⁴ The registrar refers to any accredited registration authority.

²⁵ ccTLDs Best Practices for the Prevention and Resolution of Intellectual Property Disputes (Version February 21, 2001).

²⁶ Request For Comments on Issues Addressed in the WIPO Internet Domain Name Process (WIPO RFC-2).

²⁷ Wilkins, Julian, *Alternative Dispute Resolution and Its role in Domain Name Disputes*, *Domain Names and E-Commerce*, p.10. The author describes the key advantages of Alternative Dispute

A dispute under the UDRP proceedings will be decided by an administrative panel to be appointed by the administrative-dispute-resolution service provider.²⁸ The panel may award the complainant the remedies of cancellation or transfer of the domain name.²⁹ Nevertheless, the mandatory administrative proceeding will not prevent any party to the proceeding to bring an action to court of competent jurisdiction.³⁰

Paragraph 4 of the UDRP provides for a mandatory administrative proceeding which sets out the elements that must be fulfilled by any party (the complainant) who wish to initiate a complaint on the gTLD. The complainant must prove a three-fold test as required under paragraph 4:

1. The domain name in dispute is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
2. the owner of the registered gTLD has no rights or legitimate interests in respect of the domain name; and
3. the owner of the registered gTLD has been registered and is being used in bad faith.

Each of these three elements must be proven by the complainant to be successful in the proceeding.

THE CONCEPT OF CONFUSING SIMILARITY

A domain name is confusingly similar if it incorporates the primary, distinctive and prominent elements of a trade mark.³¹ The top level domain (TLD) such as “.com”, “.net” or “.biz” are common elements in all domain names, the dominant distinctive part is the second level domain (SLD).³² The inclusion of the “.com” suffix or a space or hyphen are insignificant to an evaluation of confusing

Resolution (ADR) are; (i) most commercial institutions prefers to settle their disputes outside the courtroom; (ii) ADR proceedings are faster and more efficient; (iii) ADR saves time and money; (iv) ADR approach is more flexible in its approach; (v) and ADR may offer effective and attractive remedy. There are different types of ADR ie mediation, adjudication and conciliation but the most commonly used for domain names disputes is arbitration; See also Maher, David, 'The UDRP: The Globalization of Trademark Rights' [2002] 33 *IIC* 924.

²⁸ Paragraph 4(e) of the UDRP.

²⁹ Paragraph 4(i) of the UDRP.

³⁰ Paragraph 4(k) of the UDRP.

³¹ *AP Moller v. Web Society*, Case no. D2000-0135 <maersksealand.com> <maersk-sealand.com>; *Pharmacia & Upjohn AB v. Sol Meyer*, Case no. D2000-0785 <pharmaciamonsanto.com>.

³² *International Air Transport Association (IATA) v. Traverse Too and ASB (Schweiz)* <iata.com> <iata.net> Case no D2000-0192; *Miba Gleitlager Aktiengesellschaft v. Vishnu Prasad Miba*, <miba.com> Case no. D2001-1399; *Echelon Corporation v. Jung Hochul*, Case no. D2001-0939 <lonmark.com> the domain name is identical to the complainant's trademark.

similarity;³³ particularly if the domain name is first used some time after the registration of the registered trade mark.³⁴ Such negligible variations are irrelevant to the consumers, internet users or search engines.³⁵ In *Empresa Brasileira de Telecomunicacoes S.A – Embratel v. Gustavo Teles*,³⁶ <embratel.net> the panel found that the additional particle “.net” is not sufficient to distinguish the domain name from the EMBRATEL trade mark since “.net” is a common particle in domain names.

The addition of other words to the trade mark may not make the domain name less identical or less confusingly similar. In *Tata Sons Limited v. D & V Enterprise*,³⁷ <bodacious-tatas.com> In this case, the respondent had used the word “tata” plus the addition ‘s’, while the complainant trade mark has no ‘s’. The respondent has also included the word ‘bodacious’. On the issue was whether the domain name <bodacious-tatas.com> is identical or confusingly similar to the complainant trade mark “TATA”, the panel said:

...the addition of the letter ‘s’ is of no benefit to the respondent, the Tata Group of Companies is collectively referred to as “Tatas” throughout the world. One might think that the inclusion of the word “bodacious” in the domain name, taken together with the addition of the letter ‘s’ to TATA, could create sufficient distinction, for trade mark purposes, between the complainant TATA trade mark and the respondent domain name. Such a contention is untenable, by virtue of the very high level of goodwill that both TATA and TATAS have acquired. Further, TATA, without any vestige of doubt, constitutes a famous mark...³⁸

³³ *Royal Crown Company Inc v. New York Broadcast Services Inc*, Case no. D2000-0315 <dieter.com> the disputed domain name is so similar to the complainant mark as to cause confusion and lead to deception as to the sponsorship of the complainant goods. In *Pfizer Inc v. wwwviagra.com*, Case no. D2001-1455 <wwwviagra.com> the additional prefix “www” before the word “Viagra” was confusingly similar to the trade mark VIAGRA.

³⁴ *Wal-Mart Stores Inc v. Walmart Canada*, Case no. D2000-0150 <walmartcanada.com> The panel said that it would be difficult to imagine that any court would uphold the use of a name confusingly similar to a registered trade mark where that name had first been used some 4 years after the registration of the mark.

³⁵ *Christian Dior Couture SA v. Liage International Inc*, Case no. D2000-0098 <babydior.com> <babydior.net>.

³⁶ Case no D2000-0155.

³⁷ Case no D2000-0479. See also *Yahoo! Inc v. Jorge O. Kirovsky*, Case no. D2000-0428 <yahoomail.net> <yahoofree.net> <yahoofree.com> <yahoochat.net> .

³⁸ The panel also took upon himself to seek a dictionary meaning for the word “bodacious” [1. “through”; “blatant”; “unmistakable”; 2. “remarkable”; “outstanding” 3. “audacious”; “bold”; “brazen” – *Webster’s Encyclopedic Unabridged Dictionary of the English Language (1989)*] The panel concluded that the addition of the letter ‘s’ does not render the domain name less identical or less confusingly similar to a trade or service mark. Indeed, the opposite is true, particularly when one considers most of the meanings attributed to the word “bodacious”.

RIGHTS OR LEGITIMATE INTEREST

A complainant must prove that he has rights or legitimate interests in respect of the domain name. The UDRP creates a new threshold of the concept of rights of trade mark owner. Under the UDRP, the complainant is required to show that there is a trade mark or service mark in which he has rights.³⁹ The 'rights of trade mark owner' test under the UDRP ought not to be a very difficult test.⁴⁰ There is no requirement under the UDRP that the complainant mark must be registered,⁴¹ or that the complainant must be a trade mark owner;⁴² it is sufficient to show that he has some rights on the trade mark, either registered or unregistered,⁴³ which suggests that a licensee can be a complainant.⁴⁴

The complainant must also prove that the respondent has no right or legitimate interest in respect of the domain name. The complaint will be denied if the respondent can show that he has some right or legitimate interest to use the domain name. Normally, a license or other permission is needed for the respondent to use the domain name.⁴⁵ Guidance on the standards of rights or legitimate interest, or the lack of it, can be observed from paragraph 4(c) of the UDRP Policy,⁴⁶ which provides that any of the following circumstances, in particular but without limitation, shall demonstrate that your [the respondent] rights or legitimate interest to the domain name:

1. Before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name, in connection to a bona fide offering of goods or services; or
2. you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trade mark or service mark rights; or

³⁹ Para 4(a) of the UDRP.

⁴⁰ Willoughby, Tony, 'The Uniform Dispute Resolution Policy fro Domain Names From the Perspective of a WIPO Panelist' 134 *Trademark World* 34.

⁴¹ Jones, Stephen, 'A Child's First Steps: The First Six Months of Operation – the ICANN Dispute Resolution Procedure fro Bad Faith Registration of Domain Names' [2001] *EIPR* 66.

⁴² Bettink, Wolter, 'Domain Name Dispute Resolution under the UDRP: The First Two Years' [2002] *EIPR* 244.

⁴³ Willoughby, Tony, 'The Uniform Dispute Resolution Policy for Domain Names', pg. 34.

⁴⁴ Bettink, Wolter, 'Domain Name Dispute Resolution under the UDRP: The First Two Years' [2002] *EIPR* 244. See also <webergrills.com> Case no. D2000-0187; <drawtite.com> Case no. D2000-0017.

⁴⁵ *Valio Oy v. TCOVA Oy*, Case no. D2001-0805 <valio.com>; *Red Bull GmbH v. Ian Andrew*, Case no. D2001-0709 <givesyouwings.com>; *Guinness UDV North America Inc v. UKJENT*, Case no. D2001-0684 <s-m-i-r-n-o-f-f.com>.

⁴⁶ The heading of the paragraph begins with '*how to demonstrate your rights and legitimate interest in the domain name in responding to a complainant...*' It is odd that the wording of the paragraph is not drafted in neutral terms, but with the respondent, rather than the complainant in mind.

3. you are making a legitimate non commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert customers or to tarnish the trade mark or service mark at issue.

THE CRITERIA OF BAD FAITH

Finally, the complainant must prove that the domain name has been registered and used in bad faith. The circumstances in which bad faith may exist are:

1. The use of the domain name for purposes of selling, renting or transferring the domain name registration to the owner of the trademark or service mark or a competitor of the owner of the trademark or service related to the domain name; or⁴⁷
2. the registration of the domain name was made in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name; or⁴⁸
3. the registration of the domain name was to disrupt the business of a competitor; or⁴⁹
4. the registration of the domain name was made to attract for commercial gain Internet users to your websites by causing confusion to the owner of the trademark or service mark.⁵⁰

Bad faith can be inferred from the respondent registration and use of a domain name consisting wholly of the complainant's well-known marks.⁵¹ The fact that a trade mark is famous and that the respondent was probably aware of this or should have noticed of this fact, is an element indicating bad faith.⁵² Awareness however is a substantive factor that cannot be measured easily.

⁴⁷ Paragraph 4(c)(i) of the UDRP.

⁴⁸ Paragraph 4(c)(ii) of the UDRP.

⁴⁹ Paragraph 4(c)(iii) of the UDRP.

⁵⁰ Paragraph 4(c)(iv) of the UDRP.

⁵¹ *Champagne Loius Roederer v. David Lloyd-Jones*, Case no. D2001-0366 <louis-roederer.com>; *Microsoft Corporation v. Mindkind*, Case no. D2001-0193 <microsofthealth.com> The panel also found that such use suggests an attempt by the respondent to profit from the enormous level of internet traffic seeking official Microsoft web site by the incorporation of the MICROSOFT mark in the domain name in issue.

⁵² *V&S Vin&Spirit AB v. Oliver Garcia*, Case no. D2002-1081; *Valio Oy v. TCOVA Oy*, Case no. D2001-0805 <valio.com> the trade mark "VALIO" is a mark which has a 'reputation' in Finland under Article 6 of the Finnish Trademark Act; which is similar to the notion of 'well-known' mark. The panel concludes that the respondent must be aware of the existence of the trade mark "VALIO" at the time of registration of the domain name.

WIPO UDRP DECISIONS FOR EDUCATION

So far, WIPO has administered some 30 cases involving universities and educational institutions. In 28 instances, WIPO Panels ordered that the domain names be transferred to the complainant i.e. the universities, and only two cases are denied.

The Chancellor, Masters and Scholars of the University of Oxford v. DR Seagle
(Case No. D2000-0308)

The complainant is the University of Oxford, formally known as The Chancellor, Masters and Scholars of the University of Oxford, Oxford, United Kingdom and the respondent is DR Seagle of Australia. The respondent registered the domain name at issue 'www.oxford-university.com' on 12th December 1998 and the complainant became aware of it in March 1999.

The complainant alleges that the respondent's act amounted to the tort of passing off and violated the complainant's trade mark registration for OXFORD UNIVERSITY in South Africa. The complainant further contends that, in the circumstances, the respondent's primary purpose in registering the domain name was either to:

1. Sell, rent or otherwise transfer the domain name registration to the complainant, the owner of the trade mark or service mark or to a competitor of that complainant, for valuable consideration in excess of the domain name registrant's out-of-pocket costs directly related to the domain name; and/or
2. prevent the complainant from reflecting the mark in a corresponding domain name; and/or
3. disrupt the business of the complainant; and/or
4. to attract for financial gain, Internet users to the respondent's web site of other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's web site or location or of a product or services on the respondent's web site or location.

The respondent did not file a proper reply to the Complaint but responds via email to the complainant's counsel and copied to WIPO, where he asserted that his name is Oxford University.

J.C.Thomas, a sole panelist in deciding the case, finds that the domain name at issue is identical or confusingly similar to a trade mark or service mark in which the complainant has rights. The domain name 'www.oxford-university.com' is confusingly similar to OXFORD UNIVERSITY and to the complainant's own domain name 'oxforduniversity.com'.

The panel also finds that the respondent has no right or legitimate interest in respect of the domain name. Although the respondent asserted that his name is Oxford University, according to WHOIS database, the respondent is registered as DR Seagle, an individual, while the complainant's right in the name OXFORD UNIVERSITY are manifestly long-standing and settled.

On the issue of bad faith, the panel concluded that the domain name 'www.oxford-university.com' has been used as a parody of the complainant. The respondent statement to the respondent that it could "buy the site if you want to, or can afford to" and that the registrant was "considering approving a number of commercial products... Please send me large donations" is illustrative that the domain name has been registered and used in bad faith. Accordingly, the Panel ordered that the domain name 'www.oxford-university.com' be transferred to the complainant, the University of Oxford.

The University of Wyoming v. David Horton (Case No. D2000-0366)

The complainant, The University of Wyoming, is actively involved in trademark licensing in the mark "University of Wyoming", "Cowboy", "Cowboys", and "UW". The domain name in disputes are 'uwcomboys.com', 'wyomingcowboys.com', 'uwyo.com', 'uwyoming.com' and 'wyocowboys.com'.

The complainant's Manager of Trademark and Licensing contacted the respondent to ascertain his intention regarding the domain name. The respondent stated that other schools around the country paid large sums of money to individuals who registered domain names similar to the schools trademark. The respondent further indicated that he did not plan to use the name for his own business purpose. He indicated that he would consider relinquishing the domain name if the university would provide free tuition to his daughter.

Jaffrey M. Samuels, sole panelist determined that the domain names in dispute are either identical or confusingly similar to marks which the complainant has rights. On the issue of bad faith, the panelist, relying on the evidence that the respondent knew that other schools had paid significant sums of money for the transfer of domain names and that, acting on such knowledge, offered to sell the domain name to the complainant in exchange of free tuition fee for his daughter, concluded that the respondent had acted in bad faith.

CYBERSQUATTING OF UKM DOMAINS

Two separate searches using the WHOIS database for 'ukm' in several top level domains (TLD) was done on 5th April 2001 and 29th November 2002 reveals:

The search indicated that 'ukm' domains have been registered by persons not connected or have no legitimate interest with the 'ukm'. It appears that only the registrant for 'ukm.info' which is the home page of Universitatsklinikum

Domains	Availability	Registrant	Web page status
ukm.biz	Unavailable	Simon Haley Richard Tracey Stapleton Stoney Hills Essex CM08QA Great Britain (UK)	Not active Notice: ukm-biz domain for sale
ukm.com	Unavailable	Anything.com Ltd. (.ky) P.O. Box 309, Ugland House George Town, Grand Cayman KY	Not active Site Planned for Development Link to Adult Content
ukm.info	Unavailable	Schiedel, Frank IGELsoft Internetservice GbR Postfach 2014 Rheine DE 48410	Active Homepage of Universitätsklinikum Munste
ukm.net	Unavailable	Telepathy Inc P.O Box 53344 Washington DC 20009	Not active Site Planned for Development
ukm.org	Unavailable	Name 4 Sale, Div of QBX Inc P.O Box 50547 Seattle WA 98138	No access

Munste, has a valid and legitimate interest. Indeed, the result is very alarming. Note that the domain 'ukm.com' has a link to adult site. This may be prejudicial and defamatory to Universiti Kebangsaan Malaysia (UKM). Our good name as a distinguished institution of higher learning is at stake and may be tarnished. Internet users may assume that 'ukm.com' is a site maintained by UKM or its affiliates.

CONCLUSION

The conflicts between domain names and trade marks are inevitable but proactive approach must be taken so that the conflicts can be reduced to a minimal. Those who have a right or a legitimate interest over the domain name should guard their domain name accordingly. In the event that their names have been registered

as a domain names by cybersquatters, appropriate actions must be taken either in a court of proper jurisdiction or by submitting a complain under a dispute resolution policy. Such policy is a useful mechanism in reaching fast and effective commercial settlement in domain name disputes.

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