

GigaLaw's

Domain Dispute Digest

Second Quarter, 2020

A ‘Surge’ in Domain Name Disputes



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This, the second quarterly issue of GigaLaw’s Domain Dispute Digest, greatly expands upon the inaugural issue published earlier this year by adding data from three additional providers of services under the Uniform Domain Name Dispute Resolution Policy (UDRP). Now, in addition to UDRP data from the World Intellectual Property Organization (WIPO) and the Forum, this Digest includes data about domain name disputes from the Czech Arbitration Court (CAC), the Hong Kong office of the Asian Domain Name Dispute Resolution Centre (ADNDRC), and the newly established Canadian International Internet Dispute Resolution Centre (CIIDRC).

Domain name disputes gained even greater importance during the quarter, with many cybersquatters and scammers targeting trademark owners by preying on fears about the coronavirus and COVID-19. As a result, WIPO issued a press release in early June under the headline, “[Cybersquatting Case Filing Surges During COVID-19 Crisis.](#)” The release noted:

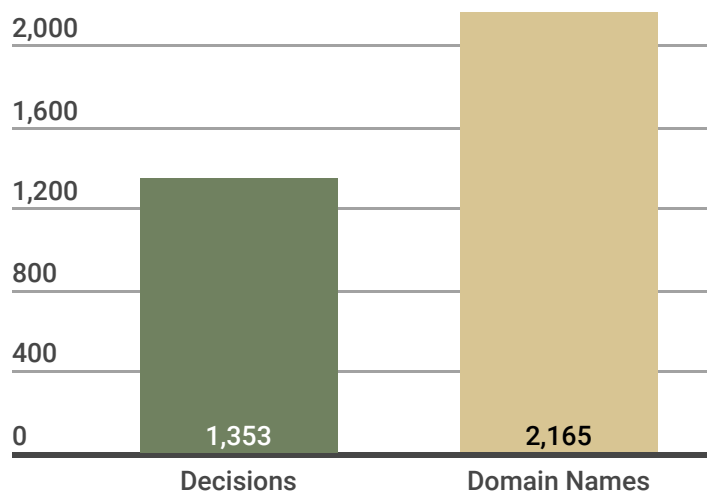
“ The COVID-19 pandemic appears to have fueled an increase in cybercrime. This is also true for cybersquatting cases filed with WIPO’s Arbitration and Mediation Center, which has clocked a steady increase as compared with the same period last year.

Indeed, as the numbers on the following pages make clear, trademark owners are increasingly using the UDRP to enforce their rights against cybersquatters: At WIPO and the Forum (the two most-popular providers), the number of UDRP decisions increased by more than 12 percent in the quarter – indicating that the UDRP remains an important and effective tool for online brand enforcement.

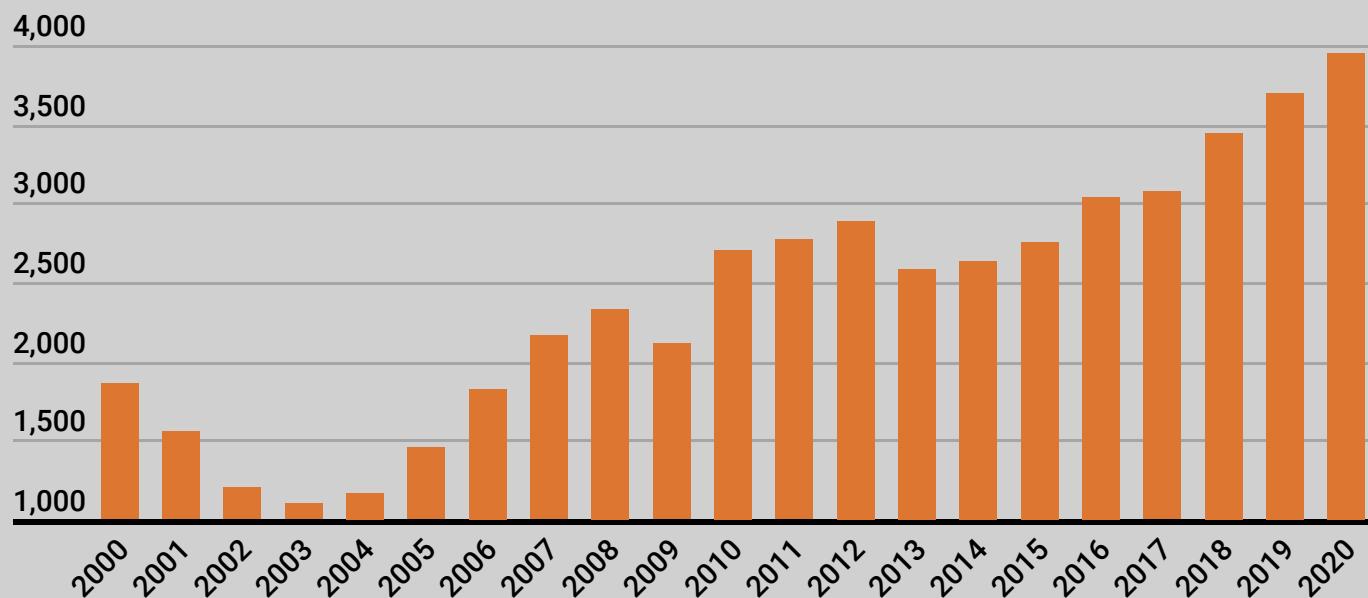
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Number of UDRP Decisions and Domain Names

As noted on the previous page, WIPO has reported a “surge” in domain name disputes. The number of decisions and disputed domain names in the second quarter reflects this trend among all of the UDRP service providers included in this issue of GigaLaw’s Domain Dispute Digest.

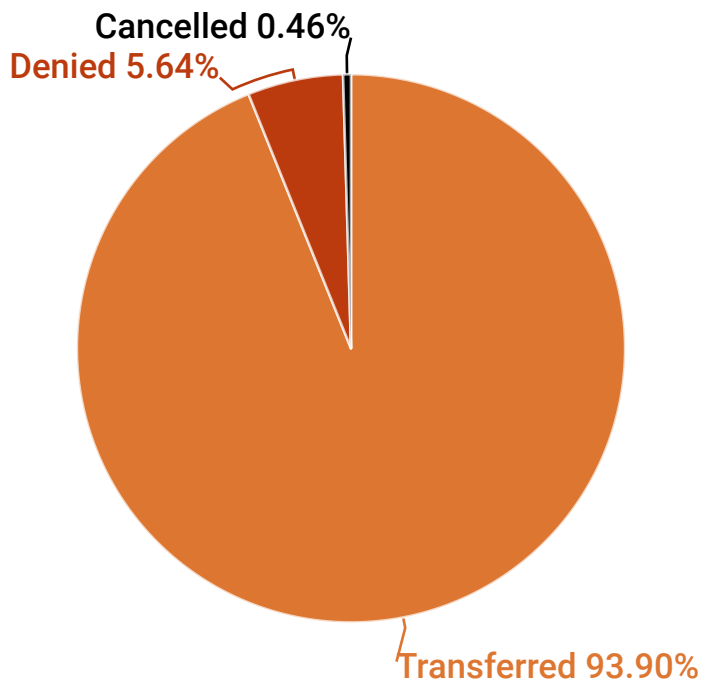


WIPO Domain Name Cases by Year



The number of domain name dispute cases at WIPO – the largest UDRP service provider and the only one from which real-time data is publicly available – is rising in 2020, continuing a seven-year trend. (Note: Data for 2020 is extrapolated for the full year, as of July 20, 2020, and includes all domain name dispute policies administered by WIPO, including non-UDRP.)

Outcome



The outcome of UDRP decisions in the second quarter remained quite similar to the first quarter, with 93.9 percent of disputed domain names resulting in a transfer decision, versus 94.69 percent in the first quarter – demonstrating the ongoing effectiveness of the UDRP for trademark owners.

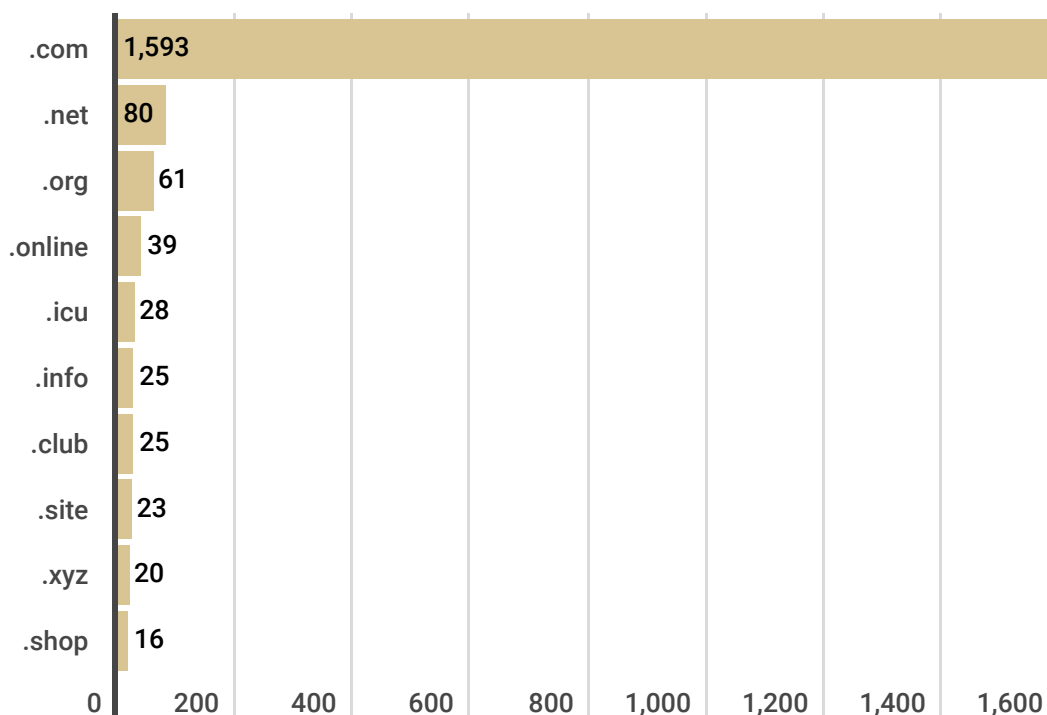
Largest Cases

The average number of disputed domain names per UDRP complaint was 1.6 in the second quarter of the year, a slight decrease that may be attributable to one especially large complaint (for 496 domain names) that skewed this statistic in the first quarter.

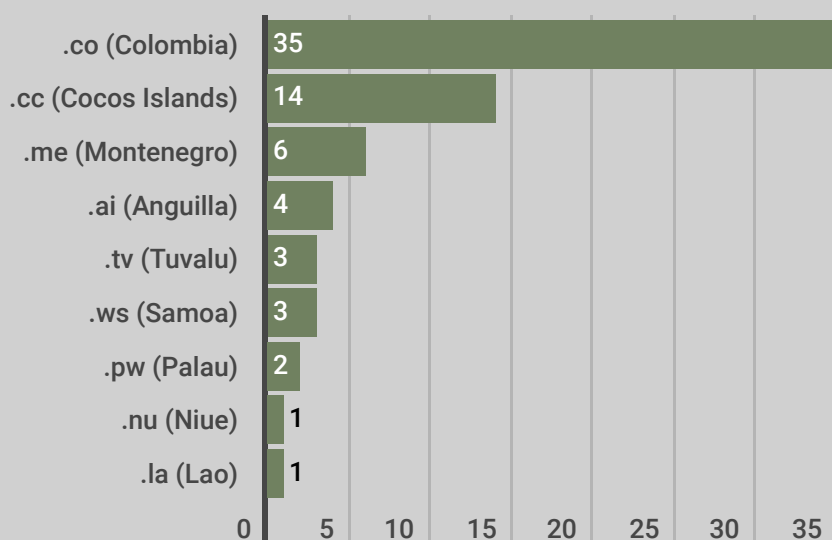
Complainant	Case No.	No. of Domains
Cube	WIPO D2020-0703	87
NextPoint	Forum 1893165	60
Cube	WIPO D2020-0382	39
Combined Ins. Co.	WIPO D2020-0863	37
Agfa	WIPO D2020-1096	25
Crédit Mutuel	WIPO D2020-0491	25
Dareos	WIPO D2020-0769	24
IBM	WIPO D2020-0274	23
UPS	Forum 1890111	20
Endeavor/IMG/Wm. Morris	WIPO D2020-0594	19
Altria/Philip Morris	WIPO D2020-0335	18

Most Common gTLDs

The most commonly disputed gTLDs remain .com (by far), .net, and .org, with .online remaining the top new gTLD to make the list this quarter. New arrivals on this list include .icu and .shop, while .store and .top dropped off.

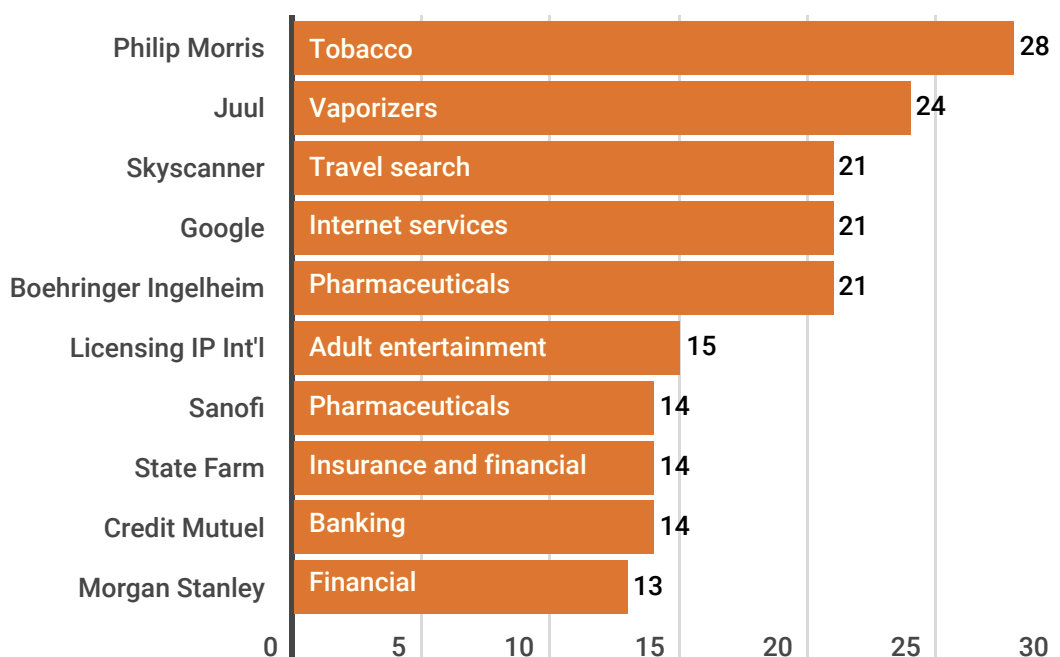


Most Common ccTLDs



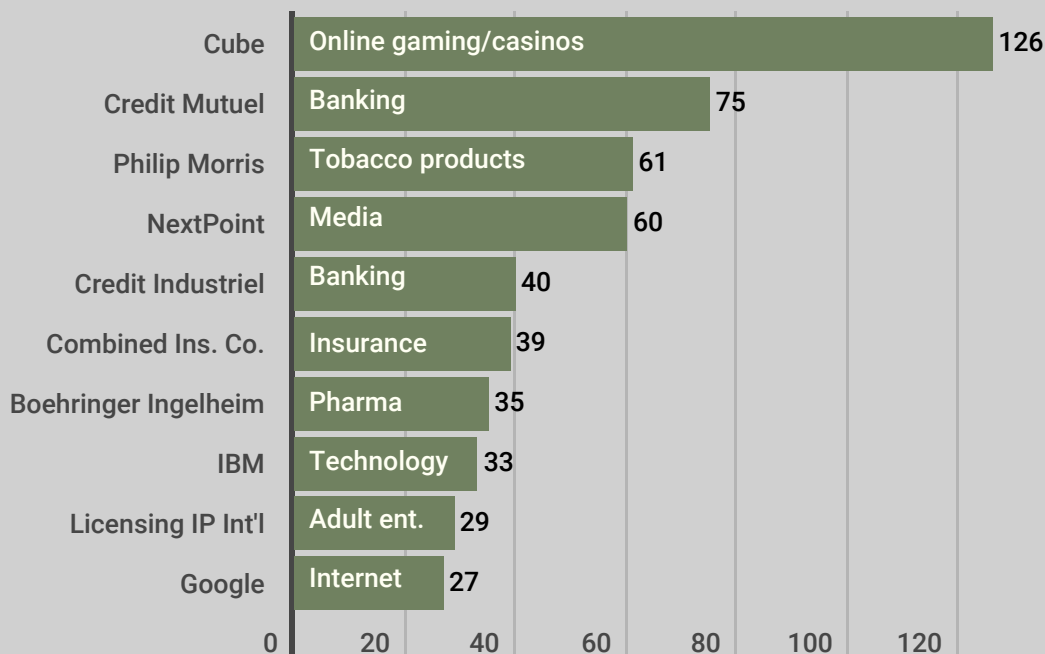
Once again, .co was the most commonly disputed ccTLD in UDRP cases (certainly because of its similarity to .com, which cybersquatters find appealing), appearing in even more decisions than the first quarter of the year, while .cc saw a relatively big increase in decisions, too.

Most Active Trademark Owners (Cases)



Philip Morris remained the most active filer of UDRP complaints this quarter, joined on this list by two pharmaceutical companies, Boehringer Ingelheim and Sanofi, as cybersquatters target healthcare companies during the coronavirus pandemic.

Most Active Trademark Owners (Domain Names)



Because trademark owners can include multiple domain names in a single UDRP complaint (see "Largest Cases," p. 4), some larger-than-typical decisions identify other active brand owners, which cover a variety of industries.

Spotlight: Supreme Court's Booking.com Domain Decision

In its first case involving the intersection of domain names and trademarks, the U.S. Supreme Court held that a domain name consisting of a generic word plus a top-level domain (such as .com) can be registered as a trademark if the domain name as a whole has obtained “acquired distinctiveness” or “secondary meaning” in the minds of the public.

The [Supreme Court's opinion](#), on June 30, 2020, allows Booking.com B.V. to obtain a trademark registration for the domain name <booking.com>, overturning a decision from the U.S. Patent and Trademark Office.

“[W]hether ‘Booking.com’ is generic turns on whether that term, taken as a whole, signifies to consumers the class of online hotel-reservation services,” the Court wrote. “Because ‘Booking.com’ is not a generic name to consumers, it is not generic.”

Despite the importance of this case, the Supreme Court's opinion is unlikely to have any immediate far-reaching impacts on trademark registrations, let alone domain name disputes under the Uniform Domain Name Dispute Resolution Policy (UDRP). Indeed, the opinion has no direct effect on the overwhelming majority of domain name disputes, which continue to be resolved outside of court, under the UDRP and other domain name dispute policies.

From the GigaLaw Website:

- [Understanding the Supreme Court's Booking.com Domain Name Trademark Opinion](#)
- [What the Supreme Court Said About Domain Name 'Wordplay'](#)
- [Court TV Interviews Doug Isenberg About Supreme Court's Domain Name Case](#)

About the UDRP and GigaLaw

The Uniform Domain Name Dispute Resolution Policy (UDRP) is a domain name dispute policy created by the Internet Corporation for Assigned Names and Numbers (ICANN) in 1999 that provides trademark owners with an inexpensive and quick legal process to combat cybersquatting. It applies to .com and all of the global or generic top-level domains, as well as about 40 country-code top-level domains.

GigaLaw is a law firm founded by Doug Isenberg (right), one of the world's most active domain name attorneys. Isenberg frequently represents trademark owners under the UDRP and other domain name dispute policies, and he filed the largest UDRP complaint ever, for more than 1,500 domain names, in 2009. He also serves as a domain name panelist for the World Intellectual Property Organization (WIPO), the Forum, and other domain name dispute providers.

The *World Trademark Review* has said that Isenberg is “a whiz on all things to do with Internet law and domain names.”

For more information, visit www.Giga.Law or email Doug@Giga.Law



This issue of GigaLaw's Domain Dispute Digest includes data from WIPO, the Forum, CAC, ADNDRC's Hong Kong office, and CIIDRC. Analyzed data is from decisions dated April 1-June 30, 2020, and acquired no later than July 17, 2020, unless otherwise noted. This report is for general informational purposes only, provides only a summary of specific issues, and is not intended to be and should not be relied upon as legal advice regarding any specific situation. This report is not intended to create, and does not constitute, an attorney-client relationship. Readers should consult with legal counsel to determine how laws, policies or decisions and other topics discussed in this report apply to the readers' specific circumstances. This report may be considered attorney advertising under court rules of certain jurisdictions. Copyright © 2020 The GigaLaw Firm, Douglas M. Isenberg, Attorney at Law, LLC.