

LAW OF THE DIGITAL DOMAIN: TRADEMARKS, DOMAIN NAMES, AND THE AI FRONTIER

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ABSTRACT

Domain names remain a critical component of the internet landscape despite the advent of new technologies and search engines. This alphanumeric sequence plays a crucial role in online branding, identity, and search engine optimization, serving as the real estate of the 21st century. The convergence of legal principles governing trademarks and domain names highlights the importance of establishing clear identities and avoiding confusion between the two. The Uniform Domain Name Dispute Resolution Policy (UDRP) provides a reasonable resolution to conflicts between domain names and trademarks while inspiring legislators to refine the trademark system. This paper explores the interplay between trademark and domain name systems and highlights the lessons that each system can learn from the other. One of the significant lessons is the need for a cohesive and efficient intellectual property rights (IPR) system that generates synergistic benefits. Artificial Intelligence (AI) has the potential to transform the interplay between trademarks and domain name systems by automating domain name availability checks and improving

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dispute resolution processes. However, stakeholders must carefully consider the implications and benefits of incorporating AI language models into the legal landscape. This paper highlights the need for vigilance and adaptability in managing intellectual property rights in the digital era. As emerging technologies, such as blockchain and AI, continue to shape the domain name landscape, policymakers, regulators, and stakeholders must explore how domain name systems can adapt to these technologies to ensure their continued relevance and effectiveness in safeguarding intellectual property rights. The interplay between trademarks and domain names has the potential to foster significant growth and improvement for both systems.

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I. INTRODUCTION

In the digital age, the intersection of trademarks and domain names as pivotal legal principles can be attributed to the insightful perspective offered by GoDaddy.com founder, Bob Parsons, who likened domain names to the real estate of the 21st century, serving as both contract rights and

intangible property.¹ The evolution of domain names into an integral facet of the internet landscape, since the establishment of the Domain Name System (DNS) in the 1980s, has rendered their value inextricably linked to trademark systems, resulting in conflicts due to distinct registration processes.² ICANN, with the help of WIPO, has undertaken initiatives such as the Uniform Domain Name Dispute Resolution Policy (UDRP) and the Uniform Rapid Suspension Policy (URS) for specific generic top-level domains (gTLDs).³ The absence of a centralized governmental or intergovernmental regulatory body for domain names underscores the pressing need for comprehensive international guidelines to oversee the administration of IP numbers and associated domain names

¹ Randy Herschaft, *Internet domain names the new 21st century real estate*, THE SYDNEY MORNING HERALD (July 24, 2007), www.smh.com.au/national/internet-domain-names-the-new-21st-century-real-estate-20070724-gdqoyi.html [<https://perma.cc/UZ2S-5QQS>]; see also Frederick M. Abbott, *On the Duality of Internet Domain Names: Propertization and Its Discontents*, 3 NYU J. INTELL. PROP. & L. 1 (2013). The comparison with eminent domain has also been made. The power of the government to take private property and convert it into public use is replaced by private property of a website that is taken by the power of the Uniform Dispute Resolution Policy and transferred to the trademark holder in the name of trademark protection. See G. Peter Albert Jr., *Eminent Domain Names: The Struggle to Gain Control of the Internet Domain Name System*, 16 J. MARSHALL J. COMPUTER & INFO. L. 781 (1998); see also Brian W. Borchert, *Imminent Domain Name: The Technological Land-Grab and ICANN's Lifting of Domain Name Restrictions*, 45 VAL. U. L. REV. 505 (2011).

² *Brief History of the Domain Name System*, BERKMAN KLEIN CENTER FOR INTERNET & SOCIETY AT HARVARD UNIVERSITY, <https://cyber.harvard.edu/icann/pressingissues2000/briefingbook/dnshistory.html> [<https://perma.cc/8L9T-LWAN>] (last visited Feb. 2, 2024).

³ Assafa Endeshaw, *The Threat of Domain Names to the Trademark System*, 3 J. WORLD INTELL. PROP. 323 (2000).

amidst an era marked by relentless technological advancements and intricate network configurations.⁴

When a user inputs a domain name into their web browser, their computer initiates a request to an Internet Protocol (IP) address, enabling a connection to the corresponding website.⁵ The DNS serves as a crucial mechanism in this process, as it seamlessly converts alphanumeric domain names into numerical IP addresses. A domain name is a mnemonic substitute for the numerical address, not unlike a 1-800 number,⁶ that may be entered into an internet browser.⁷ Domain names continue to play a critical role in the internet ecosystem, serving as a vital component of online presence, branding, and identity. While search engines are widely used to navigate to different websites, the value of domain names extends far beyond this utility. They enhance brand recognition, streamline direct navigation,⁸ and play a pivotal role in search engine

⁴ Laurence R. Helfer, *International Dispute Settlement at the Trademark-Domain Name Interface*, 29 PEPP. L. REV. 87 (2001).

⁵ Andrew Birnberg, *What happens when you type a URL in your browser and press enter?*, MEDIUM, (Nov. 27, 2017), <https://medium.com/@birnbera/what-happens-when-you-type-a-url-in-your-browser-and-press-enter-f5f4957ba108> [<https://perma.cc/3FQR-V8U6>].

⁶ In this sense, they are comparable to mnemonic telephone numbers, such as 1-800 numbers. J. Theodore Smith, Note, “1-800-Ripoffs.com”: *Internet Domain Names are the Telephone Numbers of Cyberspace*, 1997 U. ILL. L. REV. 1169 (1997); Gayle Weiswasser, *Domain Names, the Internet, and Trademarks: Infringement in Cyberspace*, 13 SANTA CLARA HIGH TECH. L.J. 137, 165 (1997).

⁷ Singh proposed gateway pages as a solution to two similar or identical domain names. Search engines take a similar, although externalized, approach by providing several options based on the function of the websites. Puneet Singh, *Gateway Pages: A Solution to the Domain Name Conflict?*, 91 TMR 1226 (2001).

⁸ *Signposts in Cyberspace; The Domain Name System and Internet Navigation*, NATIONAL RESEARCH COUNCIL OF THE NATIONAL ACADEMIES (National Academies Press, 2005).

optimization.⁹ Moreover, customized domain names exude an aura of professionalism and credibility by establishing trust with users and providing superior control and adaptability in the management of an individual's digital footprint. As such, the role of domain names in digital navigation and internet law is not merely restricted to their service as mnemonic alternatives for numerical Internet Protocol addresses. The term "Uniform Resource Locator" (URL) is constituted by a domain name, along with certain technical details that assist in locating an online resource. To illustrate, "en.wikipedia.org" denotes a domain name while "https://en.wikipedia.org/wiki/Main_Page" is an example of a URL.¹⁰ Domain names, as crucial elements of the internet networking infrastructure, consist of unique combinations of alphanumeric characters. They offer a more user-friendly alternative to complex IP addresses, thus simplifying the process of locating websites on the internet.¹¹ They serve not just as an address but also as a name, much as a trademark does when it comes to identifying the origin of anything. However, this combination of functions can lead to confusion,¹² especially between domain names and

⁹ Stephen O'Neill, *The Core Aspects of Search Engine Optimisation Necessary to Move up the Ranking*, 3:4 INT'L J. OF AMBIENT COMPUT. AND INTEL., 62–70 (2011).

¹⁰ Memorandum from the URI working group of the Internet Engineering Task Force on Uniform Resource Locators (URL), RFC 1738 (Dec. 1994) (on file with author).

¹¹ Geoffrey S. Weil, *The Trademark Battle for Internet Domain Names*, 1 LOY. INTELL. PROP. & HIGH TECH. L.Q. 24 (1996–1997).

¹² If the content of the website is critical, parodic, noncommercial, or can be characterized as fair-use, it might lead to initial-interest confusion. David M. Kelly, "Trademark.com" *Domain Names: Must They Communicate the Website's Protected Content to Avoid Trademark Liability?*, 33 AIPLA Q. J. 397, 399–400 (2005). However, according to Litman, this confusion will subside after a few years once the number of gTLDs increases. Jessica Litman, *Commentary: Trademark Law and Domain Names*, 6 INT'L INTELL. PROP. L. & POL'Y 22-2 (2001).

trademarks in the commercial world,¹³ where corporations derive sales from their name and goodwill in the market.¹⁴ In order to avoid confusion, legal documentation is required to ensure that domain names and trademarks are kept separate. Given the increasing importance of the World Wide Web for businesses and the sheer volume of organizations utilizing it, establishing clear identities has become crucial.¹⁵ In the internet's early days, regulations governing the online landscape were scant, leading to confusion in commercial transactions¹⁶.

It is imperative to clarify that the advent of AI language models, while impacting legal issues related to domain names, does not spell the end of the domain name system. Although AI-generated domain name suggestions may potentially conflict with existing trademarks or domain names by exacerbating disputes or cybersquatting, these technologies can also be leveraged to address legal challenges and enhance the domain name ecosystem. AI models can streamline the domain name registration process by automating domain name availability checks and

¹³ However, there are not necessarily trademark rights in the name of a celebrity; there can be legitimate rights by a third party, such as fan sites, and there can be a lack of bad faith. P. Landon Moreland & Colby B. Springer, *Celebrity Domain Names: ICANN Arbitration Pitfalls and Pragmatic Advice*, 17 SANTA CLARA HIGH TECH. L.J. 385, 389 (2001).

¹⁴ See Dan L. Burk, *Trademarks Along the Infobahn: A First Look at the Emerging Law of Cybermarks*, 1 RICH. J.L. & TECH. 1, 29–33 (1995); see also Emily M. Weitzenboeck, *Hybrid net: The regulatory framework of ICANN and the DNS*, 22(1) INT'L J.L. AND INFO. TECH. 49 (2014).

¹⁵ The boom of the 2000s in e-commerce led to the dotcom bubble. *The Complete History of the World Wide Web (From Web1 to Web3)*, DOCK BLOG (Aug. 8, 2022), <https://blog.dock.io/the-complete-history-of-the-world-wide-web/> [<https://perma.cc/9TDA-HF33>].

¹⁶ Jacqueline D. Lipton, 23 – *Legal Regulation of Internet Domain Names in North America*, *The Cambridge Handbook of International and Comparative Trademark Law* 383–97 (Irene Calboli & Jane Ginsburg eds., 2020).

identifying potential conflicts with existing trademarks.¹⁷ This expedites conflict detection and helps prevent disputes from arising. Furthermore, AI technology can contribute significantly to domain name dispute resolution processes, such as analyzing cases under the UDRP, thereby improving efficiency and accuracy.¹⁸ In a nutshell, advancements in AI language models do not portend the end of domain names; rather, they offer opportunities to refine and fortify the domain name system, addressing extant challenges and optimizing stakeholder experiences.

The existing regime for domain names and its dispute resolution regime has drawn criticism, praise, and frequent comments in-between highlighting both the importance of the UDRP and the need to further refine the regime.¹⁹ In this connection, leading scholars, such as Michael Froomkin,²⁰

¹⁷ Dev S. Gangjee, *Chapter 17 A Quotidian Revolution: Artificial Intelligence and Trade Mark Law*, in RSCH. HANDBOOK ON INTELL. PROP. AND A.I. 325 (Ryan Abbott ed., 2022).

¹⁸ Agus Agus et al., *The Use of Artificial Intelligence in Dispute Resolution Through Arbitration: The Potential and Challenges*, 29:3 SASI 570–78 (2023).

¹⁹ Jessica Litman has characterized the emergence of the UDRP as a collision of trademark law and culture with the DNS. See Jessica Litman, *The DNS Wars: Trademarks and the Internet Domain Name System*, 4 J. SMALL & EMERGING BUS. L. 149, 152 (2000). Julie McMurry provided a comparison between UDRP and litigation. See Julie J. McMurry, *The UDRP v. Traditional Litigation: May the Best Process Win*, 20 ST. LOUIS UNIV. PUB. L. REV. 379 (2001). Chad Emerson even suggested to skip the UDRP altogether and go directly to a national court. See Chad D. Emerson, *Wasting Time in Cyberspace: The UDRP's Inefficient Approach toward Arbitrating Internet Domain Name Disputes*, 34 U. BALT. L. REV. 161, 163 (2004). Carl Oppedahl advocated a more balanced policy for registration authorities that do not implement chances retroactively. See Carl Oppedahl, *Analysis and Suggestions Regarding NSI Domain Name Trademark Dispute Policy*, 7 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 73, 116 (1996).

²⁰ A. Michael Froomkin, *ICANN's "Uniform Dispute Resolution Policy"—Causes and (Partial) Cures*, 67 BROOK. L. REV. 605 (2002).

Michael Geist,²¹ and Annette Kur,²² have proposed reform of the UDRP with regard, among many issues, to forum shopping, panel selection, and pleading rules.²³

The internet and globalization make this de-territorialization, to a great extent, desirable.²⁴ In contrast, the domain name system is transnational and has a national UDRP.²⁵ Then again, the external relation with national courts and national IPR systems are still relevant,²⁶ or it can

²¹ Michael Geist, *Fair.com?: An Examination of the Allegations of Systemic Unfairness in the ICANN UDRP*, 27 BROOK. J. INT'L L. 903 (2002).

²² Annette Kur, *UDRP*, A Study by the Max-Planck-Institute for Foreign and International Patent, Copyright and Competition Law, Munich in Cooperation with Institute for Intellectual Property Law and Market Law, University of Stockholm, and Institute for Information Law, Technical University of Karlsruhe (2002).

²³ Mueller asserted that the UDRP is biased towards trademark holders. See Milton Mueller, *Rough Justice: A Statistical Assessment of ICANN's Uniform Dispute Resolution Policy*, 17 THE INFO. SOC'Y 151 (2001). Roberta Horton and Michael Kientzle argue that the UDRP standard for personal names needs to be improved. See Roberta Horton & Michael Kientzle, *A Better UDRP Standard for Personal Names*, 63 THE PRAC. LAW. 43 (2017). Michael Karanicolas argued that the UDRP provides a maximalist enforcement to trademark holders that vastly exceeds protection under domestic legal systems that can not only be used defensively, but offensively as well. See Michael Karanicolas, *The New Cybersquatters: The Evolution of Trademark Enforcement in the Domain Name Space*, 30 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 399 (2020). See John Selby, *Competitive Justice?: The Role of Dispute Resolution Providers under ICANN's UDRP*, 1 MACQUARIE J. BUS. L. 23 (2004).

²⁴ Frank J. Garcia, *Between Cosmopolis and Community: The Emerging Basis for Global Justice*, 46 N.Y.U. J. INT'L L. & POL'Y 1 (2013). However, Trimble sees the territorialization of the internet as a growing trend. Marketa Trimble, *Territorialization of the Internet Domain Name System*, 45 PEPP. L. REV. 623 (2018).

²⁵ David Muls, *WIPO Domain Names Dispute Resolution Program*, 7 INT'L INTELL. PROP. L. & POL'Y 100-1 (2002).

²⁶ Laurence R. Helfer, *Whither the UDRP: Autonomous, Americanized, or Cosmopolitan?*, 12 CARDOZO J. OF INT'L & COMP. L. 493 (2004).

be decisive.²⁷ After all, trademark holders can choose for a judicial review of a UDRP decision,²⁸ or they can go directly to litigation.²⁹ The trademark system is intended to take the opposing goals of consumers and competitors into account³⁰ on the one hand, and company owners of registered trademarks on the other hand. The Paris Convention for the Protection of Industrial Property³¹ and the Agreement on Trade-Related Aspects of Intellectual Property Rights were the primary sources of inspiration for the formation of its regulations.³² In contrast to this, the management of the domain name system is carried out by a technocratic organization known as the Internet Corporation for Assigned Names and Numbers (ICANN). This organization was established on the premise of a transition toward

²⁷ Holger P. Hestermeyer, *The Invalidity of ICANN's UDRP Under National Law*, 3 MINN. INTELL. PROP. REV. 1 (2002); Amanda Rohrer, *UDRP Arbitration Decisions Overridden: How Sallen Undermines the System*, 18 OHIO ST. J. DISP. RESOL. 563 (2003).

²⁸ David E. Sorkin, *Judicial Review of ICANN Domain Name Dispute Decisions*, 18 SANTA CLARA COMPUT. & HIGH TECH. L.J. 35 (2001).

²⁹ See Jessica Sganga, *Trademark Owner's Strategy: Litigation Versus the UDRP*, 13 PEPP. DISP. RESOL. L.J. 301 (2013); see also Janet Moreira, *Making an Informed Choice between Arbitration or Litigation: The Uniform Domain-Name Dispute Resolution Policy vs. The Anti-Cybersquatting Act*, 44 IDEA 147 (2003).

³⁰ Protecting descriptive and nominative fair use, respectively: KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc., 543 U.S. 111 (2004); *New Kids on the Block v. News America Pub., Inc.*, 971 F.2d 302 (9th Cir. 1992).

³¹ World Intellectual Property Organization [WIPO], *Paris Convention for the Protection of Industrial Property*, WIPO Doc. TRT/PARIS/001 (Sep. 28, 1979), <https://www.wipo.int/wipolex/en/text/287556> [<https://perma.cc/8WXG-6JNV>].

³² See generally Agreement on Trade-Related Aspects of Intellectual Property Rights, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, 1869 U.N.T.S. 299 [hereinafter TRIPS].

“multistakeholder governance,”³³ which transpired in 2016,³⁴ and it is responsible for handling the administration of the DNS.³⁵ Some commentators have questioned whether ICANN lacks legitimacy.³⁶ WIPO,³⁷ which is a self-funding specialized agency of the United Nations (UN),³⁸ provided recommendations to ICANN in 1999 for a domain name dispute-resolution policy that uniformly implements across all gTLDs to address the issue of abusive registrations of domain names.³⁹ The ICANN Board approved the implementation documents of the UDRP in accordance with public comments in October 1999⁴⁰.

In this article, we posit that the legal frameworks of trademark and domain name systems are experiencing a

³³ Kathryn Kleiman, *Crash Goes ICANN's Multistakeholder Model*, 11 AM. UNIV. INTELL. PROP. BRIEF 3, 7 (2020).

³⁴ LENNARD G. KRUGER, CONG. RSCH. SERV., R44022, *THE FUTURE OF INTERNET GOVERNANCE: SHOULD THE UNITED STATES RELINQUISH ITS AUTHORITY OVER ICANN?* 1 (2016).

³⁵ Aaron van Klyton, Mary-Paz Arrieta-Paredes & Ayush Soomaree, *The multistakeholder model of Internet governance, ICANN, and business stakeholders – practices of hegemonic power*, GREENWICH PAPERS IN POL. ECON. (2018) (Working Paper GPERC64).

³⁶ Jonathan Weinberg, *ICANN and the Problem of Legitimacy*, 50 DUKE L.J. 187 (2000); Dan Hunter, *ICANN and the Concept of Democratic Deficit*, 36 LOY. L.A. L. REV. 1149 (2003); Susan P. Crawford, *The ICANN Experiment*, 12 CARDOZO J. INT'L & COMP. L. 409 (2004).

³⁷ Erich Schweighofer, *A Review of the Uniform Dispute Resolution Policy of the Internet Cooperation for Assigned Names and Numbers (ICANN)*, 6 AUSTRIAN REV. INT'L & EUR. L. 91, 102 (2001).

³⁸ *About WIPO*, WIPO, <https://www.wipo.int/about-wipo/en/> [<https://web.archive.org/web/20240213042819/https://www.wipo.int/about-wipo/en/>] (last visited Feb. 2, 2024).

³⁹ WIPO, *The Management of Internet Names and Addresses: Intellectual Property Issues* 1, 49 (Apr. 30, 1999), <https://www.wipo.int/amc/en/processes/process1/report> [<https://perma.cc/D5LB-U4X6>].

⁴⁰ *Timeline for the Formulation and Implementation of the Uniform Domain-Name Dispute-Resolution Policy*, ICANN (Feb. 25, 2012), <https://www.icann.org/resources/pages/schedule-2012-02-25-en> [<https://perma.cc/B3BY-L297>].

convergence. As domain names increasingly challenge the trademark registration procedures in various nations, the 2000 WIPO Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks emerges as a pivotal resource. This document provides a definition for “domain name,” delineates the rules governing conflicts, and prescribes that a domain name constitutes an infringement on a well-known mark if it, or a significant portion thereof, replicates, emulates, translates, or transcribes the mark in bad faith.⁴¹ The near-global adoption of the Uniform Domain Name Dispute Resolution Policy (UDRP) not only offers a reasonably satisfactory resolution to conflicts between domain names and trademarks, but it also inspires legislators to further refine the trademark system.⁴²

As trademark databases from an expanding array of jurisdictions merge and registration processes become increasingly automated, the relevance of domain name registration authorities consulting a consolidated database prior to granting domain names intensifies. The domain name system and the trademark system both stand to benefit from mutual insights on efficiency and cost management, with each system possessing valuable lessons for the other. Thus, the interplay between these two systems has the

⁴¹ The World Intellectual Property Organization (“WIPO”) provides a definition of “domain name,” which means “an alphanumeric string that corresponds to a numerical address on the Internet.” *Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks*, at Art. 1(v), World Intellectual Property Organization [WIPO] Doc. 833(E) (Sep. 29, 1999), <https://www.wipo.int/edocs/pubdocs/en/marks/833/pub833.pdf> [<https://perma.cc/T3FW-ZQKP>] [hereinafter *Joint Recommendation*].

⁴² “The PTO and the various registrars need to coordinate their efforts to achieve the goal of consistency between real world trademarks and domain names.” Jonathan O. Nilsen, *Mixing Oil with Water: Resolving the Differences between Domain Names and Trademark Law*, 1 J. HIGH TECH. L. 47, 55 (2002).

potential to foster significant growth and improvement for both.

With the goal of fostering a cohesive and efficient intellectual property rights (IPR) system that generates synergistic benefits, this article aims to examine the mutual lessons that trademark and domain name systems can glean from each other. Part 2 delves into the evolution of internet domain names, the introduction of new generic top-level domains, and the crucial role of IPR in safeguarding brands and companies. This section also elucidates that the UDRP is designed to resolve conflicts between domain name registrants and third parties. Part 3 scrutinizes the intricate interplay between domain names and trademarks, explicating how domain names serve as both website addresses and trademarks, which necessitates robust intellectual property protection to prevent confusion and ownership disputes. This article also investigates the converging trajectories of domain name and trademark systems. Part 4 highlights ICANN's endeavors to revamp the UDRP in response to the ever-changing domain name landscape, detailing how ICANN aims to ensure the smooth functioning of the DNS while combatting fraudulent activities such as cybersquatting and other forms of online crime. Part 5 concentrates on the UDRP's impact on the global governance of IPR. The domain name landscape is in constant flux, with emerging technologies poised to significantly influence domain name usage and management. For instance, blockchain technology may present new opportunities for domain name registration and administration, enhancing security and transparency in domain name management. Additionally, artificial intelligence (AI) could also contribute to domain name management, potentially offering novel solutions to issues like trademark infringement and cybersquatting. As these developments unfold, vigilance and adaptability are

essential in staying ahead of the curve and maintaining a robust online presence.

II. THE EVOLVING UNIVERSE OF INTERNET DOMAIN NAMES

The universe of Internet domain names has been developing and extending throughout time, with new generic top-level domains (gTLDs) being launched to stimulate competition and increase user choice.⁴³ Because of this enlargement, a whole new set of domain names, such as city names and brand names, are now open for registration and may be used. Also, in order to guarantee the safety of domain name registration and the impartial resolution of any disagreements that may arise about domain names, brand new regulations and processes have been implemented. Despite these modifications, the development of Internet domain names continues, and it is anticipated that upcoming technologies such as blockchain and artificial intelligence will have an influence on the future of domain name registration and administration.⁴⁴ The ever-expanding realm of internet domain names has brought to light the importance of intellectual property rights. This is because the merging of the functions of domain names and trademarks may result in misunderstanding as well as disagreements about ownership. The launch of new generic top-level domains (gTLDs) has resulted in the creation of new chances for trademark infringement and cybersquatting,⁴⁵ stressing the

⁴³ See Ukeme Awakessien Jeter, *ICANN Dot-Anything: Rethinking the Scope of the New gTLD Expansion, Its Effect on Government Regulation, and Its Impact on Trademark Owners*, 103 TMR 962 (2013).

⁴⁴ AIContify team, *A Journey Through Domains: Exploring the Fascinating History*, AICONTIFY (Nov. 6, 2023), <https://aicontentfy.com/en/blog/journey-through-domains-exploring-fascinating-history> [<https://perma.cc/M8MD-LCPQ>].

⁴⁵ James Nurten & Eileen McDermott, *Reports Reveal Scale of Cybersquatting Threat*, MANAGING INTELL. PROP. 10 (2009).

need for strong intellectual property protection to prevent such acts. As the structure of domain names continues to change, intellectual property rights will continue to be an essential component in ensuring honest competition and safeguarding the reputation of companies and brands that operate online. The terms “intellectual property rights” and “intellectual property” are both terms that relate to the rights that are granted to the inventor in order to safeguard his innovation for a certain amount of time.⁴⁶ However, just like trademark rights,⁴⁷ domain names can be extended in perpetuity, as long as the renewal fees are paid.

Because of this, the creator will be able to make full use of the work for the duration of the allotted time in a consecutive manner. The Uniform Domain Name Dispute Resolution Policy (UDRP) is what establishes the framework upon which disputes between a domain name registrant and a third party are resolved.⁴⁸ These disputes can be brought about by the abusive registration and use of a domain name in the generic top-level domains.⁴⁹ This article delves into the ever-expanding field of Internet domain names and is structured according to the following three subsections: The first subsection examines the influence that intellectual property rights have had on the establishment of regulations governing domain names. The second subsection delves further into the core regulations, organizations, and concepts that are associated with domain names. The last subsection examines the impacts that both globalization and business have had on the internet, focusing particularly on how domain names have been impacted as a

⁴⁶ See Joseph E. Stiglitz, *Economic Foundations of Intellectual Property Rights*, 57 DUKE L.J. 1693, 1705 (2008).

⁴⁷ *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 163 (1995).

⁴⁸ *WIPO Guide to the Uniform Domain Name Dispute Resolution Policy (UDRP)*, WIPO, <https://www.wipo.int/amc/en/domains/guide/#a3> [<https://perma.cc/VW4N-8E6U>] (last visited Jan. 19, 2024).

⁴⁹ *Id.*

result of these forces. When considered as a whole, these subsections provide a comprehensive overview of the ever-changing and intricate world of Internet domain names.

A. *The Influence of IPR on the Design of Domain Name Regulation*

Over the course of the last four decades, there has been an explosion in the number of websites⁵⁰ and domain names,⁵¹ which has facilitated the widespread use of intellectual property rights (IPRs), including trademarks, on the internet. The concurrent usage of a portion of the domain names, which contains pre-existing trademarks,⁵² has resulted in a major increase in the level of conflict with those who own trademarks.⁵³ This section provides a history of the legal loopholes and entanglements that are associated with the registration of domain names, as well as the disputes that occurred in the area of intellectual property rights as a result of this new realm of interaction. Each of the three parties—the person who owns the trademark, the person who owns the domain name, and the body that registers domain names—has their own unique set of objectives and concerns. This means taking action against infringement and having predictability in the case of the person who owns

⁵⁰ As of February 16, 2023, there are 1.16 billion websites on the internet. However, only 18% of these sites are active. Nick Huss, *How Many Websites Are There in the World?*, SITEEFY (Feb. 16, 2023), <https://siteefy.com/how-many-websites-are-there/> [https://perma.cc/H5RV-8J8H].

⁵¹ As of Quarter 1 of 2021, there were 363.5 million registered domain names. Verisign, *Domain Name Report*, 18 THE DOMAIN NAME INDUS. BRIEF 1, 2 (June 2021), <https://dnib.com/media/downloads/reports/pdfs/2021/domain-name-report-Q12021.pdf> [https://perma.cc/FD4N-CD3H].

⁵² See Luke M. Rona, *Who Are You? Difficulties in Obtaining Trademark Protection for Domain Names*, 8 WASH. J.L. TECH. & ARTS 61 (2012).

⁵³ Helfer, *supra* note 4, at 88.

the trademark, having predictability in the case of the person who owns the domain name, and avoiding legal action in the case of registration authority.⁵⁴ The legal story of domain names began with the advent of the World Wide Web in 1993, as most trademark holders did not act in time to register their trademarks as domain names, and there was the perception that domain names were registered and operated in a legal void.⁵⁵ Thus, trademark squatting became a serious problem, with Dennis Toeppen as its infamous paragon.⁵⁶ In 1994, Jon Postel, the first manager of the Internet Assigned Numbers Authority (IANA), proposed a role for a domain name registration authority in a document called Request for Comments 1591 on Domain Name System Structure and Delegation.⁵⁷ In July 1995, the Network Solutions, Inc. (NSI), the registration authority for the top-level domain name “.com,” implemented a policy that would deactivate any registration in thirty days after they received a letter from a trademark holder.⁵⁸ This arguably benefited trademark holders even if they did not have any bona fide case of trademark infringement. In 1996, domain name holders whose domain names were deactivated, according to the NSI’s “thirty days letter”

⁵⁴ Oppedahl, *supra* note 19, at 82–83.

⁵⁵ See Joshua Quittner, *Billions Registered: Right now, there are no rules to keep you from owning a bitchin' corporate name as your own internet address*, WIRED 50 (Oct. 1, 1994), <https://www.wired.com/1994/10/mcdonalds/> [<https://web.archive.org/web/20240117142000/https://www.wired.com/1994/10/mcdonalds/>].

⁵⁶ See *Panavision Intern., L.P. v. Toeppen*, 945 F. Supp. 1296 (C.D. Cal. 1996); see also Michael A. Sartori, *A Proposal for the Registration of Domain Names*, 87 TMR 638 (1997).

⁵⁷ Memorandum from the ccNSO working group on Domain Name System Structure and Delegation, RFC 1591 (Mar. 1994) (on file with the author).

⁵⁸ Kevin Eng, *Breaking Through the Looking Glass: An Analysis of Trademark Rights in Domain Names Across Top Level Domains*, 6 B.U. J. SCI. & TECH. L. 34 (2000).

policy, started to sue NSI.⁵⁹ In five out of seven cases, the NSI was willing to derogate its policy before the hearing date of these cases. In each of the cases where NSI was sued, the domain name holder prevailed.⁶⁰

The regulations that were in place to control domain names went through a significant overhaul in the year 1996. Network Solutions, Inc. (NSI) approved its fourth policy in September of 1996. At the time, this policy represented a new direction for the organization. According to the new policy, trademark owners can only use their registration to halt the registration of a domain name if they obtained the registration before the beginning of the NSI challenge proceeding.⁶¹ If they did not obtain the registration before the beginning of the NSI challenge proceeding, they would not be able to use their registration.⁶² The only way for owners of domain names to have had any kind of protection, as stated in the fourth policy of the NSI, was to register an eponymous trademark as their domain name.⁶³ Just two years were required to complete the writing of the Universal Domain Name Dispute Resolution Policy (UDRP). This includes a proposal by the United States Department of Commerce, an investigation by the World Intellectual Property Organization (WIPO), as well as changes and implementation by the ICANN.⁶⁴

⁵⁹ Oppedahl, *supra* note 19, at 89 (citing *Roadrunner v. Network Solutions, Inc.*, No. 96 Civ. 413A (E.D. Va. dismissed June 21, 1996)).

⁶⁰ Oppedahl, *supra* note 19, at 90–91.

⁶¹ Neal J. Friedman & Kevin Siebert, *The Name Is Not Always the Same*, 20 SEATTLE UNIV. L. REV. 631, 638 (1997).

⁶² *Id.*

⁶³ *Id.* at 649.

⁶⁴ Second WIPO Internet Domain Name Process, *The Recognition of Rights and The Use of Names in The Internet Domain Name System, Report of the Second WIPO Internet Domain Name Process*, WIPO (Sept. 3, 2001), <https://www.wipo.int/amc/en/processes/process2/report/html/report.html#:~:text=The%20Second%20WIPO%20Process%20co>

The UDRP and, by the same token, the effective new regulation of domain names came into being in 2000.⁶⁵ A panel decision of the WIPO Arbitration and Mediation Center, *World Wrestling Federation Entertainment, Inc. v. Michael Bosman*, was the first UDRP case which was launched on December 1st, 1999 and decided on January 14th, 2000.⁶⁶ Panelists under the UDRP are not bound by precedent, but the practice is neither expressly prohibited nor condoned.⁶⁷ For the sake of predictability and consistency, arbitration service centers, such as WIPO, have captured the evolving UDRP jurisprudence. In 2011, this led to the WIPO Overview 2.0,⁶⁸ and in 2017, it led to the WIPO Overview 3.0.⁶⁹ Some IPR scholars have looked to the UDRP for inspiration: Mark Lemley and Anthony Reese see some aspects of the UDRP as exemplary for resolving digital

cerns,those%20identifiers%20as%20domain%20names
[<https://perma.cc/QD9R-E2FD>].

⁶⁵ *Id.*

⁶⁶ See *World Wrestling Fed'n Ent., Inc. v. Michael Bosman*, No. D99-0001 (Jan. 14, 2000), <https://www.wipo.int/amc/en/domains/decisions/html/1999/d1999-0001.html> [<https://perma.cc WR95-4XAN>]; see also Brian Young, *World Wrestling Federation Entertainment, Inc. v. Michael Bosman: ICANN's Dispute Resolution at Work*, 1 N.C. J.L. & TECH. 65 (2000).

⁶⁷ Elizabeth C. Woodard, *The UDRP, ADR, and Arbitration: Using Proven Solutions to Address Perceived Problems with the UDRP*, 19 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 1169, 1197–98 (2009).

⁶⁸ *WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition (“WIPO Overview 2.0”)* (2011), <https://www.wipo.int/amc/en/domains/search/overview2.0/> [<https://perma.cc/C29Y-BXVU>]; Andrew F. Christie & Fiona Rotstein, *The Evolution of Precedent in Mandatory Arbitration - Lessons from a Decade of Domain Name Dispute Resolution*, 30 THE ARBITRATOR & MEDIATOR 65, 73 (2011).

⁶⁹ *WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Overview 3.0”)*, <https://www.wipo.int/export/sites/www/amc/en/docs/overview3.pdf> [<https://perma.cc/FJ4C-CGG9>]; see Justin Chay & Brian Beckham, *WIPO's Revised Overview 3.0 Assesses Evolutions in UDRP Jurisprudence*, 269 MANAGING INTELL. PROP. 1, 11 (2017).

copyright disputes,⁷⁰ and so does Graeme Dinwoodie,⁷¹ Jorge Contreras, and David Newman in regard to patent law,⁷² while Andrew Christie sees its potential for other IP disputes on the internet.⁷³ Jacques de Werra, proposes that the UDRP can be a template mechanism to address the right to be forgotten and other ‘massive online micro-justice’ challenges,⁷⁴ while Edward Anderson and Timothy Cole see the UDRP as a model for disputes in e-commerce.⁷⁵

B. The Domain Name Sphere: Technical, Legal, and Dispute Resolution Considerations

The domain name sphere, a legal hybrid of technology and trademark law,⁷⁶ contains different crucial concepts. The associated concepts of domain names starts with the DNS (Domain Name System), which has both technical and legal notions. The DNS is a guiding algorithm

⁷⁰ Mark Lemley & R. Anthony Reese, *A Quick and Inexpensive System for Resolving Digital Copyright Disputes*, 23(1) CARDOZO ARTS & ENT. L.J. (2005).

⁷¹ Graeme B. Dinwoodie, *A New Copyright Order: Why National Courts Should Create Global Norms*, 149 U. PA. L. REV. 469 (2000).

⁷² Jorge L. Contreras & David L. Newman, *Developing a Framework for Arbitrating Standards-Essential Patent Disputes*, 2014 J. DISP. RESOL. 23 (2014).

⁷³ Andrew Christie, *The ICANN Domain-Name Dispute Resolution System as a Model for Resolving Other Intellectual Property Disputes on the Internet*, 5 J. WORLD INTELL. PROP. 105 (2002).

⁷⁴ Jacques de Werra, *Alternative Dispute Resolution in Cyberspace: The Need to Adopt Global ADR Mechanisms for Addressing the Challenges of Massive Online Micro-Justice*, 26 SWISS REV. OF INT’L AND EUROPEAN L. 289 (2016).

⁷⁵ Edward C. Anderson & Timothy S. Cole, *The UDRP - A Model for Dispute Resolution in E-Commerce*, 6 J. SMALL & EMERGING BUS. L. 235 (2002).

⁷⁶ Marshall Leaffer, *Domain Names, Globalization, and Internet Governance*, 6 IND. J. GLOB. LEGAL STUD. 145–46 (1998).

for the internet.⁷⁷ Moreover, it works on converting easy to remember domain names into IP addresses that are hard to remember for humans, but easily stored in the memory of advanced machines (for an illustration see *dns5.websites.com*).

The expansion of generic top-level domain name extensions continues to be a concern for trademark holders. Internet domain names carry different extensions for the identification process.⁷⁸ Different domain names such as “.org,” “.com,” and “.in” identify the nature of websites for the concerned customers. Under certain conditions, ICANN allows proposals for new generic top-level domain names, such as “.aero,” “.accountant,” “.amazon,” and “.beer.”⁷⁹

ICANN’s foundation may be traced back to the year 1998 in the US.⁸⁰ Overtime, it developed into a multi-stakeholder, non-profit organization in charge of assigning names and numbers to components of the internet. The fundamental objective of ICANN is to ensure the single, stable, and globally interoperable internet,⁸¹ and maintain its consistency, safety, and cohesion.⁸² Today, ICANN is a

⁷⁷ Emily M. Weitzenboeck, *Hybrid net: the regulatory framework of ICANN and the DNS*, 22(1) INT’L J.L. AND INFO. TECH. 49–73 (2014).

⁷⁸ Alexandra Morgan Joseph, *I Can’t Believe It’s Not Better: Why New GTLDs Are for Brand Owners and Trademark Law*, 20 J. INTELL. PROP. L. 149 (2012); Daniela Michele Spencer, *Much Ado about Nothing: ICANN’s New GTLDs*, 29 BERKELEY TECH. L.J. 865 (2014).

⁷⁹ R. Parrish Freeman Jr., *Surviving the Coming Flood of New Generic Top-Level Domains - How to Keep Your Property Safe and Dry*, 6 LANDSLIDE 18 (2014).

⁸⁰ The History of ICANN, ICANN HISTORY PROJECT, <https://www.icann.org/history> [<https://perma.cc/D7QK-NXTX>] (last visited Feb. 2, 2024).

⁸¹ Government and Intergovernmental Organization Engagement, ICANN, <https://www.icann.org/en/government-engagement> [<https://perma.cc/4BLP-RQZV>] (last visited Jan. 19, 2024).

⁸² See *ICANN for Beginners*, ICANN, <https://www.icann.org/en/beginners> [<https://perma.cc/PFG6-GDKA>] (last visited Jan. 15, 2024).

regulatory body that is officially authorized to oversee and regulate the various domain names sphere.⁸³ This includes the allocation of IP address space, generic Top-Level Domains (gTLD), country-code Top-Level Domains (ccTLD) that are not covered by the UDRP but subject to a system similar to the UDRP, and other management tasks and responsibilities.⁸⁴ It is not able to control the content on the internet, nor is it able to stop spam or deal with access to the internet. However, because of the role it plays in coordinating the naming system of the internet, ICANN has a relevant impact on the expansion and evolution of the internet. Schiavetta and Komaitis argue that ICANN, via the UDRP, exerts substantial control over the “inhabitants” of the internet.⁸⁵

The responsibility of assigning domain names was previously managed by a company called Network Solutions, Inc. (NSI). Prior to December 1999, NSI was the primary organization responsible for handling domain name allocation requests submitted by parties to the relevant association. As the sole entity accountable for assigning domain names, NSI oversaw the distribution of domain

⁸³ *Welcome to ICANN!*, ICANN, <https://www.icann.org/resources/pages/welcome-2012-02-25-en>, [https://perma.cc/3CG4-EEKC] (last visited Jan. 15, 2024).

⁸⁴ ccTLD (country-code Top Level Domain), which is a self-explanatory concept. ccTLD, is another form of domain extensions that has been assigned to a particular country. This top-level domain is of two digits only, expressing the country name (.uk, .ca) and sometimes limited to the residents of a particular country. The ccTLD of Tuvalu and British Indian Ocean Territory are notable exceptions, for ‘.tv’, which is used by those active in the television industry, and ‘.io’, which is used as an abbreviation for input/output, relevant for computing processes. Brian J. Winterfeldt & Diana Moltrup, *Brand Protection on the Internet: Domain Names, Social Media, and Beyond*, INT’L TRADEMARK ASSOC. (2015).

⁸⁵ Susan Schiavetta & Konstantinos Komaitis, *ICANN’s Role in Controlling Information on the Internet*, 17 INT’L REV. L. COMPUT. & TECH. 267 (2003).

names within the most recognized top-level domains.⁸⁶ Later, seeing the rise in conflicts between the parties over the same domain names, NSI adopted the policy of a '*first come, first served*' arrangement.⁸⁷ The assignment of domain names has been brought in the hands of different enlistment centers or registrars. ICANN regulates the different enlistment centers that are responsible for the registration of domain names.⁸⁸ Domain Name Disputes are inextricably linked with the registration and use of domain names and the concomitant conflicts this could cause with existing trademark holders. The expanded cyber sphere makes it *prima facie* evident that the internet domain names are a significant and elementary basis for any company. An obligation is created on the concerned person to do thorough research on existing domain names before registering. Distinctiveness of domain names holds significant value in determining the existence and allocation of domain names. A dispute arises in a circumstance where the organization decides to battle over the domain names with the existing proprietor rather than going for an alternative domain name or where a party already owns the domain name and wants to exclude others that use a similar domain name.⁸⁹ Domain name disputes are often the result of abusive registrations. Miscreants who have no legitimate interests in the

⁸⁶ Julien Chaisse, *The Merging Of Two Worlds? Cyber Law and Trade Law Normative Convergence on Internet Domain Names*, 37 BOSTON UNIV. INT'L L.J. 281 (2019).

⁸⁷ Friedman & Siebert, *supra* note 61, at 637. Michael Tanner, *Trademarks, Internet Domain Names, and the NSI: How Do We Fix a System That Is Already Broken*, 3 J. TECH. L. & POL'Y 122 (1998). Oppedahl advocated for this. Oppedahl, *supra* note 19, at 118.

⁸⁸ Schiavetta & Komaitis, *supra* note 85.

⁸⁹ *State Farm Mutual Automobile Insurance Company v. Chicago Insurance Prof c/o Tim Wipert*, Claim Number: FA0810001231199 (Dec. 9, 2008), <https://www.adrforum.com/domaindecisions/1231199.htm> [<https://perma.cc/ZFW6-XFJL>].

registration of domain names use the shortcomings with *malafide* intention for solely abusive purposes.

Cybersquatting disputes arise when registering a domain name similar to a well-known trademark while having a malicious intention.⁹⁰ The main purpose of cybersquatting is to extract a huge sum of money from the trademark owner for transferring the domain name.⁹¹ In *Philip Morris Incorporated v. r9.net*,⁹² the WIPO Panel agreed the domain name was registered in bad faith⁹³ and transferred the domain names to the owner of the well-known trademark.⁹⁴ The Anticybersquatting Consumer Protection Act (ACPA)⁹⁵ was adopted by the U.S. Congress in 1999 in response to the abusive domain names registrations by infamous cybersquatters,⁹⁶ such as Dennis

⁹⁰ Dr. Harman Preet Singh, *Domain Name Disputes and Their Resolution under UDRP Route: A Review*, 6 ARCHIVES OF BUS. RSCH. 147 (2018).

⁹¹ Bernadette Dino, *Passive Warehousing under ICANN's Uniform Dispute Resolution Policy: A Utilitarian Perspective*, 10 COMMLAW CONSPECTUS 301 (2002); Ahmed & Slahudeen, *Cybersquatting: Pits and Stops*, 1 INDIAN L. INST. L. REV. 79 (2010).

⁹² *Philip Morris Incorporated v. r9 net*, D2003-2004, Administrative Panel Decision (Feb. 28, 2003), <https://www.wipo.int/amc/en/domains/decisions/html/2003/d2003-0004.html> [<https://perma.cc/LW3U-926K>].

⁹³ *Cyberlaw - Trademark Law - WIPO Arbitrators Uphold Conjunctive View of Bad Faith under the Uniform Domain Name Dispute Resolution Policy*, 127 HARV. L. REV. 2130 (2014); Karl Maersch, *ICANN't Use My Domain Name - The Real World Application of ICANN's Uniform Domain-Name Dispute Resolution Policy*, 34 J. MARSHALL L. REV. 1036 (2001).

⁹⁴ *Id.*

⁹⁵ Anticybersquatting Consumer Protection Act, Pub. L. No. 106-113, 113 Stat. 1501A-445-552 (1999) (codified at 15 U.S.C. § 1125(d) and 15 U.S.C. § 8131); see also Bukola Faturoti, *Business Identity Theft under the UDRP and the ACPA*, 10 J. INT'L COM. L. & TECH. 1 (2015).

⁹⁶ Susan Thomas Johnson, *Internet Domain Name and Trademark Disputes: Shifting Paradigms in Intellectual Property*, 43 ARIZ. L. REV. 476 (2001).

Toeppen.⁹⁷ The ACPA introduced *in rem* jurisdiction for domain name disputes, since *in personam* jurisdiction often cannot be established.⁹⁸ It is conceivable for the ACPA to have an impact retroactively on registrations that were made before to the execution of its provisions, and in addition, it outlines a new group of remedies.⁹⁹ When each of the four elements of the test is satisfied, liability is generally imposed in accordance with the ACPA, and the owner of the trademark may win powerful and effective remedies, such as the forfeiture or cancellation of the domain name, as well as its transfer to the owner of the trademark. In other words, when all four elements of the test are satisfied,¹⁰⁰ liability is generally imposed in accordance with the ACPA. In addition, the ACPA enables trademark owners to seek statutory damages of up to US\$100,000 per infringing domain name, in addition to other remedies provided under the Lanham Act, such as actual damages and attorneys' fees.¹⁰¹ This is on top of the ability of trademark owners to

⁹⁷ Toeppen was described by the court as “what is commonly referred to as a cyber-squatter. . . . These individuals attempt to profit from the Internet by reserving and later reselling or licensing domain names back to the companies that spent millions of dollars developing the goodwill of the trademark.” *Intermatic Inc. v. Toeppen*, 947 F. Supp. 1227, 1233 (N.D. Ill. 1996).

⁹⁸ 15 U.S.C. § 1125(d).

⁹⁹ Tenesa S. Scaturro, *The Anticybersquatting Consumer Protection Act and The Uniform Domain Name Dispute Resolution Policy The First Decade: Looking Back and Adapting Forward*, 11 NEVADA L.J. 877, 894 (2011).

¹⁰⁰ (1) the registrant has a bad faith intent to profit; (2) the registrant registers, traffics in, or uses a domain name; (3) the domain name is famous or distinctive; and (4) the domain name is identical or confusingly similar, or in the case of a famous mark, dilutive. 15 U.S.C. § 1125(d)(1)(A). See Jason S. Kaplan, *The Anticybersquatting Consumer Protection Act: Will it End the Reign of the Cybersquatter?*, 8 UCLA ENT. L. REV. 47 (2000).

¹⁰¹ 15 U.S.C. § 1117.

seek real damages under the Lanham Act.¹⁰² Badgley proposed ten steps to improve ACPA.¹⁰³

Cyber Smearing is when negative connotations in the domain name defames a trademark.¹⁰⁴ This could lead to a claim of trademark dilution by tarnishing according to the Lanham Act,¹⁰⁵ or being “detrimental to” the reputation.¹⁰⁶ Tarnishing occurs when a wrongdoer attaches the negative connotations with the prevailing trademark leaving the domain name in a derogatory state. The lack of a pejorative word distinguishes gripe sites from cyber smearing from the

¹⁰² *Id.* “[ACPA] generally authorizes causes of action in federal district courts where jurisdiction is found based on ownership of trademark rights, including personal names protectable as trademarks.” See Abbott, *supra* note 1, at 9. The rule enacted to address the globally active issue of abuse of domain name registration and U.S. Congress succeeded addressing the issue without facing the issue of jurisdiction.

¹⁰³ 1. Clarify the Effect of a “Defaulting” Respondent; 2. Clarify Whether the Panel Has the Discretion to Accept Unsolicited Supplemental Pleadings; 3. Extend the Time for Enforcement of a Panel’s Transfer Order; 4. Abrogate the Manchester Airport Statement Regarding Settlement Communications; 5. Penalize Bad-Faith Complaints; 6. Clarify the Analysis Required to Establish “Identity or Confusing Similarity”; 7. Confirm That a “Sucks.com” Domain Name is not “Identical or Confusingly Similar” to the Complainant’s Trademark; 8. Clarify the Relationship Between Free-Speech Rights and Trademark Rights in the Context of “Gripe Web Sites”; 9. Clarify the Definition of “Competitors”; 10. Clarify the Burden of Proof on the “Rights or Legitimate Interests” Element. Robert A. Badgley, *Improving ICANN in Ten Easy Steps: Ten Suggestions for ICANN to Improve Its Anti-Cybersquatting Arbitration System*, 2001 UNIV. ILL. J.L. TECH. & POL’Y 109 (2001).

¹⁰⁴ Michael Workman, *Rash impulsivity, vengefulness, virtual-self and amplification of ethical relativism on cyber-smearing against corporations*, 28:1 COMPUT. IN HUM. BEH. 2017 (2012).

¹⁰⁵ 15 U.S.C. § 1125(c).

¹⁰⁶ Council Directive 2015/2436, art. 10(2)(c), 2015 O.J. (L 336) 11 (EC).

absence of the use of a pejorative word.¹⁰⁷ Other forms of domain name disputes are Typo-squatting, Cyber Piracy, and Pseudo Cybersquatting¹⁰⁸ and Reverse domain name hijacking.¹⁰⁹ Court remedies require for domain name disputes, the affected party can take various steps. Essentially, the affected party can follow the simple formula of filing a complaint with the court for unfair and deceptive competition, but this process is time-consuming and costly. Instead, ICANN developed a more efficient process under the UDRP, where parties can approach for arbitrational proceedings under the UDRP as a remedial step. It also provides an expedient process of contesting over the abusive registration of domain names. The resolution passed under the UDRP allows companies to cancel, suspend or transfer their domain names.¹¹⁰

¹⁰⁷ Robert A. Badgley, *Internet Domain Names and ICANN Arbitration: The Emerging Law of Domain Name Custody Disputes*, 5 TEX. REV. L. & POL'Y. 363 (2001).

¹⁰⁸ Ariane C. Strombom, *Internet Outlaws: Knowingly Placing Ads on Parked Domain Names Invokes Contributory Trademark Liability*, 17 MARQ. INTELL. PROP. L. REV. 319 (2013); Singh, *supra* note 90, at 149.

¹⁰⁹ Steve DelBianco & Braden Cox, *ICANN Internet Governance: Is it Working*, 21 PAC. MCGEORGE GLOB. BUS. & DEV. L.J. 27 (2008).

¹¹⁰ A Registrar-Lock, is the register status code on a domain name to prevent any unauthorized, unwanted changes to the domain name. *About Locked Domain*, ICANN, <https://www.icann.org/resources/pages/locked-2013-05-03-en> [<https://perma.cc/E5R2-EM29>] (last visited Feb. 13, 2024). Once the registrar-lock is applied, the domain names cannot be transferred or deleted. Danny Friedmann, *The Uniqueness of the Trade Mark: A Critical Analysis of the Specificity and Territoriality Principles*, 38(11) E.I.P.R. 678–86 (2016). There is an option or submit a Transfer Complaint if the registrar lock does not unlock the domain or provide you with a reasonable method to unlock it within five days of request.

C. *The Legal Implications of Domain Name Disputes in the Globalized Virtual Marketplace: Intellectual Property Rights, Trademark Enforcement, and Territorial Jurisdiction*

The expansion of internet use internationally makes the internet a global marketplace. The global market, to a great extent, shifted its virtual sphere where different companies were setting up their businesses and bringing in fair market competition.

Yet, in their haste to secure top positions in this global market, numerous companies resorted to unethical measures in the realm of virtual competition. Arbitration and litigation over domain names have witnessed a considerable rise as a direct result of the enormous conflicts that have arisen over the internet's domain names.¹¹¹ So the existence of unbound territorial jurisdiction is made manifest by the fact that several entities maintain a worldwide presence.¹¹² In addition, the fact that they have the domain name registered in one nation does not protect them against infringement in any of the other nations.¹¹³

Within the context of the laws governing intellectual property rights, there is the potential for a serious debate to emerge around domain names. The proprietor of the brand is attempting to exploit the exclusive right it has over the corresponding domain names. When enforcing trademark rights against owners of domain names, in the same spirit as

¹¹¹ Doug Isenberg, *Trademark Owners File – and Win – More UDRP Cases Than Ever (Domain Dispute Digest, Q4 2022)*, GIGALAW (Jan. 31, 2023), <https://giga.law/blog/2023/1/31/domain-dispute-digest-q4-2022> [<https://perma.cc/V2L7-9YE9>].

¹¹² James E. Darnton, *The Coming of Age of the Global Trademark: The Effect of TRIPS on the Well-Known Marks Exception to the Principle of Territoriality*, 20 MICH. ST. UNIV. L. INT'L L. REV. 11 (2011).

¹¹³ Lisa P. Ramsey, *Trademark Protection and Territoriality Challenges in a Global Economy*, 5 IP L. REV. 1 (2014).

defending against dilution, it is necessary to protect a trademark outside of the obvious context of its consumer market to avoid confusion. This is because domain names are utilized in every region of the globe and are not restricted in the kinds of goods or services to which they might refer. In addition, domain names may be likened to intangible assets since they have the same unique traits as trademarks and are worthy of the same protection that is provided to trademarks.¹¹⁴

The protection afforded to trademarks should extend to domain names as well because they are of comparable significance to other valuable company assets. In a nearly identical case in *Bombay High Court* in 1999 involving Rediff Communication Ltd, “the confusingly similar domain name battled for the exclusive right over the registered domain name.”¹¹⁵ The Court held that the internet domain names are equally significant and hold the same value as the company’s assets.¹¹⁶

III. THE COMPLEX RELATIONSHIP BETWEEN DOMAIN NAMES AND TRADEMARKS

The relationship between domain names and trademarks is complex because domain names can function both as an address for a website and as an indication of source. This fusion of functions can lead to confusion and disputes over ownership, especially in cases where a domain name is similar to or infringes upon an existing trademark. This complexity highlights the need for effective intellectual property protection and legal documentation to draw distinctions and avoid confusion. Several business entities

¹¹⁴ Alice A. Wang, *Diversifying the Domain Name Governance Framework*, 32 BERKLEY TECH. L.J. 158–59 (2017).

¹¹⁵ Rediff Commc’n Ltd. v. Cyberbooth & Another, AIR 2000 Bom 27 (1999) (India).

¹¹⁶ *Id.*

form the domain name on the basis of the registered trademark, or *vice versa*. IPRs are enforceable intangible rights and not subjected to the physical possession of property. Domain names, comprising a series of strings and letters, also are considered intangible assets. The two core principles of each trademark regime are territoriality and specificity. The uniqueness of a non-famous trademark is limited to both its jurisdiction (territoriality) and particular combination of classes of goods and services (specificity).¹¹⁷ However, the trademark system does have some territoriality undermining aspects, such as the priority registration,¹¹⁸ well-known marks,¹¹⁹ *telle quelle* registration,¹²⁰ and the Madrid System.¹²¹ Domain names are unique within their top level, but in contrast to most trademarks they can be enforced internationally.

This Section 2 shows that each domain name has inherited and holds immense value to each firm. However, in contrast to trademark law, a domain name does not require any distinctiveness for its registration and enforcement, nor does it require the specific skill required in patent law, or the creativity required in copyright law. One can observe that some trends are converging between domain names and trademark systems, such as the increasingly shorter examination periods and an emphasis on bad faith and use requirements. In this section, we will delve into the complex relationship between domain names and trademarks. This topic is divided into three sub-sections. The first sub-section explores conflicts that arise between domain names and

¹¹⁷ Friedmann, *supra* note 110.

¹¹⁸ Paris Convention for the Protection of Industrial Property, art. 4, 21 U.N.S.T 1583 (Sep. 28, 1979) [hereinafter Paris Convention].

¹¹⁹ *Id.* at art. 6*bis*.

¹²⁰ *Id.* at art. 6*quinquies*.

¹²¹ *See generally* Madrid Agreement Concerning the International Registration of Marks, 828 U.N.T.S. 389 (Apr. 14, 1891); Protocol Relating to the Madrid Agreement Concerning the International Registration of Mark (June 27, 1989).

trademarks. The second sub-section examines the crucial role that WIPO played and still plays in shaping the UDRP. Finally, the third sub-section discusses key legal challenges in this area, highlighting the most pressing issues that require attention. Through this detailed exploration, the article helps to gain a better understanding of the intricacies involved in this critical aspect of intellectual property law.

A. Conflicts Between Domain Names and Trademarks

Trademark and domain names are relatable because both are signifiers of a business entity. Trademarks act as a striking graphic signifier of the goods and services available online and offline.¹²² Additionally, domain names act as a magnificent navigator to trademarks and brands on the internet.¹²³ Before discussing “the trademark dilemma,” it is important to contemplate whether internet domain names can be registered as a trademark. Indeed, domain names can be registered and protected as trademarks, provided that the essential elements of trademark registration are fulfilled. The domain names were considered a valid trademark in *Satyam Infoway Ltd v Sifynet Solutions Pvt Ltd*.¹²⁴ The Court stated that domain names shifted their role to carrying out a commercial activity, maintaining exclusivity (identity), and advertising their presence on the web.¹²⁵ According to

¹²² Hemant Goyal & Mohit Porwal, *India: Protection of Domain Name as a Trademark*, MONDAQ (July 14, 2014), <https://www.mondaq.com/india/trademark/327272/protection-of-domain-name-as-a-trademark> [<https://perma.cc/47RF-EZRQ>].

¹²³ *Id.*

¹²⁴ *Satyam Infoway Ltd. v. Sifynet Solutions Pvt Ltd.*, AIR 2004 SC 3540 (2004) (India).

¹²⁵ *Id.*

Section 12 of the German Civil Code (BGB),¹²⁶ if a well-known trademark is registered as a domain name without authorization from the well-known trademark holder, it would amount to infringement of the trademark.¹²⁷

However, if the registration of a domain name was done in bad faith and prejudices the other party, then the use of a trademark as a domain name without authorization cannot remain valid. This contention was provided in *Aqua Minerals Ltd v Pramod Borse*.¹²⁸

B. WIPO and ICANN: Collaborative Governance and the Evolution of the Uniform Domain Name Dispute Resolution Policy

WIPO played a crucial role in shaping the Uniform Domain Name Dispute Resolution Policy (UDRP). In 1998, WIPO released a report that highlighted the need for a dispute resolution mechanism for domain names.¹²⁹ The report suggested that a new policy be developed to address disputes arising from the registration and use of domain names.¹³⁰ The report was well-received, and in less than a year, ICANN adopted a uniform mechanism, the UDRP, which was developed with the assistance of WIPO.¹³¹ The

¹²⁶ Bürgerliches Gesetzbuch [BGB] [Civil Code], § 12, https://www.gesetze-im-internet.de/englisch_bgb/englisch_bgb.html#p0049html, [<https://perma.cc/5332-4EEV>], (Ger.).

¹²⁷ “Homepages with no content do not in principle constitute use that infringes trademark rights, because the domain name is not yet associated with any specific goods or services; there can therefore also be no likelihood of confusion” BGH, 2008, I ZR 151/05.

¹²⁸ *Aqua Minerals Ltd. v. Pramod Borse*, AIR 2001 Del 463 (2001) (India).

¹²⁹ *Uniform Domain Name Dispute Resolution Policy*, ICANN (Aug. 26, 1999), <https://www.icann.org/resources/pages/policy-2012-02-25-en> [<https://perma.cc/WA9X-Y6B4>] [hereinafter UDRP].

¹³⁰ *Id.*

¹³¹ *Id.*

UDRP is based on the principles outlined in the WIPO report and has been an effective tool in addressing issues of abusive registration of domain names. WIPO also provides dispute resolution services under the UDRP and has played an important role in resolving domain name disputes. Astonishingly, by the end of 2002, some 7,000 gTLD cases were filed under the UDRP.¹³²

ICANN placed two major restrictions on the UDRP in terms of addressing the IPR issues.¹³³ Firstly, it is limiting the scope of the nature of cases that would be tackled, i.e. bad-faith and abusive registration, instead of situations where both parties have competing legal interests. Secondly, it restricts its activities with respect to abusive registration of trademarks and service marks as domain names. It sets out three fundamental criteria for trademark holders to prevail, according to different thresholds, on UDRP complaints: (1) that the respondent has a domain name that is identical or confusingly similar to a trademark in which the complainant has rights, (2) that the respondent has no legitimate interest in the domain name, and (3) that the respondent registered and is using the domain name in bad faith.¹³⁴

The major restrictions placed by ICANN over the UDRP have both pros and cons. On the one hand, these restrictions have provided a uniform mechanism to tackle the issues of abusive registration across all forms of domains. This has helped in preventing cybersquatting and has

¹³² World Intellectual Property Organization, *COURSE ON DISPUTE SETTLEMENT - Module 4.2 World Intellectual Property Organization: Domain Name Dispute Resolution*, U.N. CONF. ON TRADE AND DEV. (Dec. 2003), https://unctad.org/system/files/official-document/edm_misc232add35_en.pdf [<https://perma.cc/8Y2C-RH9A>].

¹³³ *Id.*

¹³⁴ World Intellectual Property Organization, *The Uniform Domain Name Dispute Resolution Policy and WIPO*, WORLD INTELLECTUAL PROPERTY ORGANIZATION (Aug. 2011), <https://www.wipo.int/export/sites/www/amc/en/docs/wipointaudrp.pdf> [<https://perma.cc/AU87-DPJ4>].

protected the interests of trademark and service mark holders. The UDRP has become a strong tool to combat the issues of abusive registration and has helped in preventing domain name disputes. On the other hand, the major restrictions placed by ICANN have limited the scope of the nature of cases that can be tackled through the UDRP. The UDRP only addresses cases of bad-faith and abusive registration, and it only focuses on the abusive registration of trademarks and service marks as domain names. This has left out other forms of trademark issues that may arise in the digital environment. The UDRP's criteria for trademark holders to prevail have been criticized as being too broad and not sufficiently protective of the rights of domain name holders. Some argue that the UDRP process favors trademark holders over domain name holders. In a nutshell, while the major restrictions placed by ICANN have helped in preventing cybersquatting and have provided a uniform mechanism for addressing the issues of abusive registration, the limitations of the UDRP¹³⁵ have left out other forms of IPR issues and have been criticized for favoring trademark holders over domain name holders, and for the uneven application of trademark protection due to independent initiatives by gTLD registry operators.¹³⁶

¹³⁵ Danielle Weinberg Swartz, *The Limitations of Trademark Law in Addressing Domain Name Disputes*, 45 UCLA L. REV. 1487, 1508 (1998).

¹³⁶ Sheri Lyn Falco, *Trademarks, Domain Names, and ICANN: An Evolving Dance*, 26 ST. THOMAS L. REV. 191 (2014).

**C. *The Intersection between Domain Names
and Trademarks: An Analysis of the
Trademark Dilemma, Fair Use, and
Jurisdictional Challenges in the UDRP Era***

The intersection between domain names and trademarks includes trademark use in website addresses,¹³⁷ leading to the trademark dilemma, as pointed out above: domain names that are identical or confusingly similar to a trademark designated for identical or similar goods or services.

In a proceeding that is brought under the Uniform Domain Name Dispute Resolution Policy (“UDRP”), the trademark owner, the complainant, is required to establish a *prima facie* demonstration that the person who owns the domain name, the respondent, does not have any rights or legitimate interests in the mark.¹³⁸ In other words, the complainant must prove that the respondent is not entitled to use the mark in any way. In legal parlance, this is referred to as “proving a *prima facie* finding of ill faith.” Following that, it is the responsibility of the current owner of the domain name to provide evidence to refute the demonstration that they do not have the rights to the domain name or legitimate interests in making use of the domain name.¹³⁹ Specifically, the evidence should show that the

¹³⁷ *The Intersection of Trademarks and Domain Names - INTA White Paper*, 87 TRADEMARK REP. 668, 668 (1997). Trademarks used as metatags can also lead to trademark infringements. See also Anant Raje, *Trademark Infringements: Domain Names and Meta Tags*, 5 NUALS L.J. 89, 90 (2011). Sherwin argues that trademarks should not be granted protection against hashtags. Robert T. Sherwin, *#HaveWeReallyThoughtThisThrough: Why Granting Trademark Protection to Hashtags Is Unnecessary, Duplicative, and Downright Dangerous*, 29 HARV. J. L. & TECH. 455, 488 (2016).

¹³⁸ UDRP, *supra* note 129, at ¶ 4.c.

¹³⁹ Joan Meadows, *Trademark Protection for Trademarks Used as Internet Domain Names*, 65 UNIV. CIN. L. REV. 1323, 1338 (1997).

current owner has rights to the domain name. This duty is delegated to the person who currently has ownership of the domain name. Ownership of a domain name can be established through utilization of, or demonstrable preparations to utilize, the domain name or a corresponding name in connection with a bona fide offering of goods or services; alternatively, ownership can be established when the domain name is commonly known, even if the owner of the domain name has not acquired any trademark rights in connection with the domain name. The exercise of one's constitutionally guaranteed right to freedom of expression on the internet necessitates more breathing room for the speaker.¹⁴⁰ As a consequence of this, there is a significant amount of debate on the level of protection afforded to trademark holders against the registration of domain names that make light of or criticize their brand or themselves in their capacity as trademark holders,¹⁴¹ or against unwelcome fan sites.¹⁴²

Panels have recognized that the mere registration of a domain name that consists of a generic word or phrase, cannot be registered as a trademark. However, in *USPTO v. Booking.com*, the Supreme Court of the United States held that if consumers do not perceive generic names as generic, they can be protected as trademarks.¹⁴³ The UDRP does not require that the mark be registered in the country in which

¹⁴⁰ Jacqueline Lipton & Mary Wong, *Trademarks and Freedom of Expression in ICANN's New gTLD Process*, 38 *MONASH UNIV. L. REV.* 188, 193 (2012).

¹⁴¹ Robert J. Shaughnessy, *Trademark Parody: A Fair Use and First Amendment Analysis*, 77 *TRADEMARK REP.* 177, 178 (1987).

¹⁴² See, e.g., *Vergara v. Bouchard*, No. D2014-2008, Administrative Panel Decision, ¶ 4 (Dec. 24, 2014), <https://www.wipo.int/amc/en/domains/search/text.jsp?case=D2014-2008> [<https://perma.cc/ZDK6-JHBU>].

¹⁴³ *USPTO v. Booking.com*, 140 S. Ct. 2298, 2304 (2020).

the Respondent operates. It is sufficient that a complainant can demonstrate a mark in some jurisdiction.¹⁴⁴

In court, a domain name user can make the affirmative defense of classic or nominative fair use. Applied to the trademark dilemma, classic fair use is when the domain name holder has to use someone else's trademark to refer to its own goods or services.¹⁴⁵ Nominative fair use is when the domain name holder has to use the trademark of another as a reference to describe another product or to compare its own, which is limited to subsidiarity and proportionality.¹⁴⁶

Retroactivity of the bad faith domain name registration doctrine (applied under ACPA and codified in the Lanham Act, is disapproved by the WIPO panelists. Retroactivity is rejected or frowned upon by legal scholars, since it deprives the legal parties of the principle of equality, certainty and predictability. However, a case can be made that the doctrine of bad faith predates the internet and is generally accepted and was already part of customary law.

Globalization has increased the tension between universality of domain names and territoriality and specificity of trademarks. For example, the Greek

¹⁴⁴ Koninklijke KPN N.V. v. Telepathy Inc., No. D2001-0217, Administrative Panel Decision (May 7, 2001), <https://www.wipo.int/amc/en/domains/decisions/html/2001/d2001-0217.html> [<https://perma.cc/8JVP-T7LB>].

¹⁴⁵ KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc., 408 F.3d 596 (9th Cir. 2005). Applied under the UDRP, *e.g.*, The Orange Bowl Committee, Inc. v. Front and Center Tickets, Inc, Administrative Panel Decision, No. D2004-0947, (Jan. 20, 2005), <https://www.wipo.int/amc/en/domains/decisions/html/2004/d2004-0947.html> [<https://perma.cc/9EG6-QDYG>].

¹⁴⁶ New Kids on the Block v. News Am. Pub., Inc., 971 F.2d 302 (9th Cir. 1992). Applied under the UDRP, *e.g.*, Rakuten Kobo Inc. v. World Public Library, Administrative Panel Decision, No. D2016-1708, (Oct. 17, 2016), <https://www.wipo.int/amc/en/domains/search/text.jsp?case=D2016-1708> [<https://perma.cc/UEZ5-5DVF>].

mythological hero “Ajax” can be a trademark for different producers of washing powder in different jurisdictions, and within one jurisdiction, there can be different trademark holders for the “Ajax” trademark: one for detergents, one for fire extinguishers, and one for a football club.¹⁴⁷ This leads also to conflicts about which trademark holder can claim what domain name.

The fact that the UDRP does not include regulations regarding the choice of law highlights the global nature of the policy. On the other hand, this may result in somewhat varying interpretations being given by the courts and *dépeçage* (the concept of conflict of laws whereby different issues within a single case are governed by the laws of different jurisdictions).¹⁴⁸

Supplemental rules on multiple complainant class complaints could enable multiple complainants to consolidate their complaints against one respondent unifying their resources and efforts. The Czech Arbitration Court has codified this possibility.¹⁴⁹ More jurisdictions could consider implementing this possibility in their supplemental rules. A brief historical overview of the activities of the UDRP, which includes core global and regional statistics, discusses some general successes and failures.

After the restrictions placed by ICANN on the UDRP regarding the variety of issues covered, there has been a magnificent increase in the cases related to registered trademarks in comparison to other cases. The graph shows

¹⁴⁷ Friedmann, *supra* note 110, at 681.

¹⁴⁸ Willis L. M. Reese, *Dépeçage: A Common Phenomenon in Choice of Law*, 73 COLUM. L. REV. 58, 59 (1973).

¹⁴⁹ Micah Ogilvie, *The UDRP: a dispute resolution policy to stand the test of time?*, WORLD TRADEMARK REV. (Feb. 7, 2017), <https://www.worldtrademarkreview.com/global-guide/anti-counterfeiting-and-online-brand-enforcement/2017-obe/article/the-udrp-dispute-resolution-policy-stand-the-test-of-time> [<https://perma.cc/745Z-AUEX>].

a clear preponderance of trademark cases, 84.26 percent, filed before the dispute resolution service providers of the UDRP, and the remaining 15.74 percent secured for a variety of cases based on different factors or elements.¹⁵⁰

As can be gleaned from the official statistics, the year 2020 showed the highest surge in domain names, setting a new record for the UDRP. At the beginning of the UDRP's history, the graph indicates greater fluctuation. However, later periods show a continuous surge in domain name dispute cases.

In 2021, a record number of 4,204 complaints were submitted to WIPO, the leading UDRP dispute resolution service provider.¹⁵¹ This represents a considerable rise of 13.8 percent in the number of disputes under the UDRP and other domain name dispute rules that it handles.¹⁵² There were 1,281 judgments handed down during the fourth quarter of 2020 by all of the UDRP dispute resolution service providers, and these rulings included 2,100 different domain names.¹⁵³

IV. ICANN'S EFFORTS IN RESHAPING UDRP: ENSURING FAIRNESS AND INTEGRITY IN THE DOMAIN NAME SYSTEM

ICANN, the organization that is responsible for managing domain names and IP addresses, works hard to ensure the efficient operation of the Domain Name System

¹⁵⁰ Annette KUR, *A Study by the Max-Planck-Institute for Foreign and International Patent, Copyright and Competition Law, Munich*, (Jan. 15, 2002), https://www.zar.kit.edu/DATA/projekte/udrp_705937a.pdf [https://perma.cc/BUX7-44KT].

¹⁵¹ Doug Isenberg, *A Record-Breaking Year for Domain Name Disputes (GigaLaw's Domain Dispute Digest, Q4 2020)*, GIGALAW (2020), <https://giga.law/blog/2021/1/27/domain-dispute-digest-q4-2020> [https://perma.cc/UJ9F-4YT8].

¹⁵² *Id.*

¹⁵³ *Id.*

(DNS) and has made efforts to reshape the UDRP to keep up with the ever-evolving landscape of internet domain names. Both of these goals are necessary to ensure that ICANN is able to effectively manage domain names and IP addresses. The UDRP has to be changed by ICANN if the domain name system is to retain its impartiality and transparency. By helping trademark owners safeguard their intellectual property rights, the UDRP allows for others to make valid use of domain names. The UDRP is subject to a number of limitations imposed by ICANN to prevent misuse of the system and to ensure that only valid complaints are considered by the organization. These kinds of initiatives serve to avoid fraudulent activities like cybersquatting and other types of online crime, which may be harmful to companies as well as individual consumers. In addition, the work done by ICANN to reform the UDRP contributes to the guarantee that the domain name system will continue to be a stable and dependable resource for users of the internet all around the globe. To accomplish this goal, ICANN has created a working group with the mission of reviewing and proposing revisions to the UDRP. Moreover, ICANN has developed the UDRP Rules for New gTLDs in order to address special problems.¹⁵⁴ ICANN aims to ensure that the UDRP remains fair, efficient, and effective in resolving domain name disputes. ICANN's work is mostly done by structured volunteer organizations, such as the Generic Names Supporting Organizations ("GNSOs"),¹⁵⁵ which consist of representatives from various stakeholder groups involved with generic top-level domain names. Through its working groups, the GNSO develops policies and makes

¹⁵⁴ Brandon Marsh, *ICANN'T Help Myself: Beneficial Adjustments to the New Generic Top-Level Domain Name Expansion Process*, 95 J. PAT. & TRADEMARK OFF. SOC'Y 195, 204 (2013).

¹⁵⁵ ICANN, GENERIC NAMES SUPPORTING ORGANIZATION, <https://gnso.icann.org/en> [<https://perma.cc/Y4RD-K8CL>] (last visited Feb. 2, 2024).

recommendations to the Board, which can be adopted as Consensus Policies. This article delves into the critical role played by ICANN in ensuring a unified process in the world of intellectual property rights, specifically its success through the Working Group in ensuring stable and secure operations. This section is divided into three sub-sections: The first sub-section examines ICANN and the GNSO Review of Rights Protection Mechanisms. The second sub-section highlights ICANN's successes in Phase One of the Working Group's review of the New gTLD RPMs. Finally, the third subsection outlines the planned results of Phase Two, which focuses on the review of the UDRP.

***A. Protecting Intellectual Property Rights in
the Domain Name System: ICANN's Role
and the Ongoing Review of Rights
Protection Mechanisms***

ICANN was incorporated for the effective and uniform management of the prevailing issues of internet domain names. ICANN neither represents itself as an intergovernmental organization nor a classic non-governmental organization.¹⁵⁶ The incorporation of ICANN is the result of input provided by the global internet stakeholders. According to ICANN Bylaws, the formation of ICANN is based on the principle of the '*Californian Nonprofit Public Benefit Corporation Law for Charitable and Public Purpose*'.¹⁵⁷ The goal of ICANN, its promises,

¹⁵⁶ Wolfgang Kleinwächter, *ICANN between technical mandate and political challenges*, 24 TELECOMM. POL'Y 553, 554 (2000); see also Zalnieriute & Schneider, *ICANN's procedures and policies in the light of human rights, fundamental freedoms and democratic values*, COUNCIL OF EUROPE (2015), <https://rm.coe.int/16806fc29c> [<https://perma.cc/G4TF-2FRP>].

¹⁵⁷ See also *Articles of Incorporation Article II*, ICANN (Aug. 10, 2016), <https://pti.icann.org/articles-of-incorporation> [<https://perma.cc/SYA2-3JUD>].

and its basic principles are all outlined in Article 1 of the ICANN Bylaws.¹⁵⁸ It is made abundantly apparent that ICANN is responsible for coordinating the unique identifier systems used on the worldwide internet and, in particular, for ensuring the reliable and secure functioning of the internet's unique identifier systems.

One of the main concerns for ICANN is the protection of intellectual property rights in the domain name system. In order to address this concern, ICANN has implemented various Rights Protection Mechanisms (RPMs) to prevent the abuse of trademarks in the DNS. The GNSO is responsible for conducting a periodic review of the RPMs in order to ensure that they are effective in protecting intellectual property rights.¹⁵⁹ The GNSO Review of RPMs is an ongoing process that seeks to evaluate the effectiveness of RPMs and recommend changes if necessary. The review process is conducted in three phases. The first phase involves data collection and analysis, where the GNSO collects data on the effectiveness of RPMs and evaluates the data to identify areas that need improvement.¹⁶⁰ The second phase involves developing recommendations for improvements to the RPMs based on the data collected in the

¹⁵⁸ ICANN Bylaws 2013, art 1, (2013) <https://www.icann.org/resources/pages/bylaws-2014-04-04-en#I> [<https://perma.cc/7WR3-BVQ3>].

¹⁵⁹ The GNSO is a body which is concerned with the development of different policies for the ICANN Board and recommending and developing of different policies that concern with the gTLDs.

¹⁶⁰ GNSO, *GNSO Review of All Rights Protection Mechanisms in All gTLDs Policy Development Process Phase 1 Final Recommendations for ICANN Board Consideration*, ICANN (Apr. 7, 2021), <https://www.icann.org/en/public-comment/proceeding/gnso-review-of-all-rights-protection-mechanisms-in-all-gtlds-policy-development-process-phase-1-final-recommendations-for-icann-board-consideration-07-04-2021> [<https://perma.cc/7GNK-LMLM>].

first phase.¹⁶¹ The third phase involves the implementation of the recommendations.¹⁶²

The GNSO Review of Rights Protection Mechanisms is an important step in the process of ensuring that the Domain Name System (DNS) will continue to be a safe and reliable location for the storage of intellectual property rights. This review is being conducted by the GNSO which is tasked with carrying out the duty of performing the examination of the functional structures of a variety of organizations (including the GNSO Working Group, the GNSO Council, and constituencies).¹⁶³ As a component of the current study, the efficacy of the structural changes that came about as a direct consequence of the previous evaluation will be evaluated in relation to the efficiency with which the GNSO functions as an organization.¹⁶⁴ These changes came about as a direct consequence of the previous evaluation. As a result of the 360 Assessment, interviews, and consultations that have been carried out, members of the GNSO community have had the opportunity to express their thoughts about the GNSO structure. ICANN is able to guarantee that trademark owners are safeguarded from misuse in the DNS by routinely examining and modifying RPMs. In addition to this, the review process ensures that RPMs are functional and treat all of the parties participating in the DNS in an equitable manner.¹⁶⁵

¹⁶¹ *Id.*

¹⁶² *Id.*

¹⁶³ More specifically, Generic Names Supporting Organization (GNSO1) (2008-2012) and Generic Names Supporting Organization (GNSO2) (2014-2015).

¹⁶⁴ ICANN, *Draft Report: Review of the Generic Names Supporting Organization*, ICANN (June 1, 2015), <https://www.icann.org/en/public-comment/proceeding/draft-report-review-of-the-generic-names-supporting-organization-01-06-2015> [<https://perma.cc/Y3BD-72C9>].

¹⁶⁵ *Id.*

In February of 2016, a Policy Development Process was initiated to address and examine a variety of RPM concerns. URS, the Trademark Clearinghouse,¹⁶⁶ and the Trademark Post-Delegation Dispute Resolution Process are the three RPMs that are relevant to new gTLDs. The RPM Final Issue Report is the product of an in-depth analysis of the RPMs employed in the domain name system.¹⁶⁷ These RPMs are intended to safeguard the legal rights of trademark owners and deter the abusive use of domain names.¹⁶⁸ The report analyzes the effectiveness of the existing RPMs, such as the UDRP, and suggests improvements to the system. The review also takes into account the potential impact of new gTLDs on the RPMs. The report makes several recommendations for changes to the RPMs, including the creation of a centralized global database of trademark rights information to be used in the domain name registration process, the expansion of the UDRP to include all gTLDs, the creation of new RPMs specific to geographic indications, and two-character country codes. The goal of the RPM Final Issue Report is to improve the effectiveness of the existing RPMs and to ensure that the domain name system is fair and secure for all stakeholders, including trademark holders, domain name registrants, and internet users. The report is an important resource for policymakers and stakeholders in the domain name industry and will inform the ongoing development of the RPMs.

¹⁶⁶ Joshua M. Borson, *World of Infinite Domain Names: Why ICANN's New GTLD Policy Inadequately Addresses Consumer Protection and Legitimate Trademark Concerns*, 58 WAYNE L. REV. 481, 493 (2012).

¹⁶⁷ GNSO, *Phase I Final Report on the Review of All Rights Protection Mechanisms in All gTLDs Policy Development Process*, ICANN (Nov. 24, 2020), <https://gns0.icann.org/sites/default/files/file/field-file-attach/rpm-phase-1-proposed-24nov20-en.pdf> [<https://perma.cc/R37X-KGK9>].

¹⁶⁸ GNSO, *PDP Review of All Rights Protection Mechanisms in All gTLDs*, ICANN (Aug. 30, 2021), <https://gns0.icann.org/en/group-activities/active/rpm> [<https://perma.cc/D7U8-Q8LB>].

B. *Achievements of the ICANN’s Working Group Phase One: Review the New gTLD RPMs*

The ICANN’s Working Group Phase One: Review the New gTLD RPMs has achieved several goals. First, it identified the current state of the New gTLD RPMs and their effectiveness. Second, it conducted a thorough evaluation of the RPMs, including their impact on trademark protection, access to information and freedom of expression, and the overall efficiency of the RPMs. Third, it examined the possible improvements to the RPMs and recommended changes to the RPMs to enhance their effectiveness. Fourth, it provided a comprehensive analysis of the potential costs and benefits of the proposed changes. Finally, it engaged the community through various outreach and consultation processes to gather feedback and ensure that the proposed changes reflect the needs and concerns of all stakeholders.¹⁶⁹

The first phase of the Policy Development Process (PDP) focused on analyzing all of the RPM and related structures that are relevant to the gTLD.¹⁷⁰ Phase One focuses specifically on some structures that were newly developed as part of the 2012 program for new gTLDs. These structures are as follows: (1) the URS; (2) the Trademark Clearinghouse; (3) the Sunrise Periods and Trademark Claims Service provided by the Trademark

¹⁶⁹ Governmental Advisory Committee, *Rights Protection Mechanisms*, ICANN (Nov. 24, 2020), https://gac.icann.org/briefing-materials/public/icann70-gac-briefing-7-rights-protection-mechanisms-v2-en.pdf?language_id=1 [<https://perma.cc/GA59-U6DA>] [hereinafter Governmental Advisory Committee].

¹⁷⁰ ICANN, *Phase 1 Initial Report of the Review of All Rights Protection Mechanisms in All gTLDs Policy Development Process*, ICANN (Mar. 18, 2020), <https://www.icann.org/en/public-comment/proceeding/phase-1-initial-report-of-the-review-of-all-rights-protection-mechanisms-in-all-gtlds-policy-development-process-18-03-2020> [<https://perma.cc/32DL-QLM5>].

Clearinghouse;¹⁷¹ and (4) the Trademark Post-Delegation Dispute Resolution Procedure. The proliferation of new gTLDs was the impetus for the creation of the measures that were designed to address and reduce the risk. During the years 2008 and 2012, the required work that was outlined in the Phase One recommendation was successfully completed.

The Uniform Rapid Suspension System (“URS”) is a tool that may be used to settle disagreements about domain names.¹⁷² This system gives owners of trademarks the chance to lodge a complaint and, if successful, have a domain name temporarily suspended. In a similar vein, the UDRP may assist trademark owners in their fight against cybersquatting on the internet. In fact, the URS was created with the intention of resolving domain name disputes even more quickly and at a lower cost than the UDRP. Nevertheless, the URS does not apply to top-level domains that end in “.com”, “.net”, or “.org”; rather, it is only applicable to “new” generic top-level domains (such as those granted after ICANN’s 2012 domain name expansion). In addition, in contrast to the UDRP, which permits trademark owners to either cancel or acquire domain names and transfer them to themselves, the URS only permits the temporary suspension of the domain name in question. The Trademark Clearinghouse ensures that there are no adoptions of names that are confusingly similar to already established, authorized names that put the rights of registered trademark holders in jeopardy in a world where domain names and extensions are constantly being created to be specific to particular regions and the corresponding languages. It is a centralized database for trademarks that stores information on confirmed trademarks from all countries and in all scripts. Moreover, it monitors all

¹⁷¹ *Id.*

¹⁷² *UNIFORM RAPID SUSPENSION SYSTEM (“URS”)*, ICANN (Mar. 1, 2013), <https://newgtlds.icann.org/sites/default/files/procedure-01mar13-en.pdf> [<https://perma.cc/4RRY-HF4C>].

registrations and keeps track of the information included in those registrations. That is the only global storage that ICANN has provided to this point.

Before domain names are made available to the general public, the Trademark Clearinghouse database is accessed by the Sunrise services made available by ICANN.¹⁷³ This allows ICANN to provide trademark owners with pre-registration opportunities and perks for domain names that correspond to their marks before the names are made available to the general public. gTLD Registry Operators also have a Sunrise Dispute Resolution Policy in place,¹⁷⁴ which allows for the verification of whether or not the domain name of a third party is similar to the domain name of a trademark holder who has used Sunrise services. The Trademark Claims Period will begin after this step has been completed. If an applicant tries to register a domain name that already exists with the Trademark Clearinghouse, he or she will be notified of this.¹⁷⁵ The Claims Notice is intended to provide clear notice to the prospective domain name registrant of the scope of the Trademark Holder's rights. In the event that the applicant

¹⁷³ *Sunrise Dispute Resolution Policy*, ICANN (Jan. 1, 2017), <https://portal.icann.org/servlet/servlet.FileDownload?file=00P4M00000n8FMjUAM> [<https://perma.cc/ZHK9-X7H4>] [hereinafter *Sunrise Policy*]; *Sunrise Seminar III: ICANN: Rights Protection Mechanisms*, Twenty-Seventh Annual Conference International Intellectual Property Law & Policy, Fordham University School of Law (Apr. 26, 2019), https://ir.lawnet.fordham.edu/cgi/viewcontent.cgi?article=1030&context=ipli_conf_27th_2019 [https://web.archive.org/web/20231113150527/https://ir.lawnet.fordham.edu/cgi/viewcontent.cgi?article=1030&context=ipli_conf_27th_2019].

¹⁷⁴ *Sunrise Policy*, *supra* note 173.

¹⁷⁵ See ICANN, *Sunrise Policy Article 7 Claims Period Policies*, INTRACOMME (June 2014), https://www.intracomme.com/file/Sunrise_Policy_v1.0.pdf [<https://perma.cc/9UZ3-ZNFA>] (stating “the Claims Notice is intended to provide clear notice to the prospective domain name registrant of the scope of the Trademark Holder's rights”).

persists and successfully registers the domain name, the owner of the trademark is notified of the development.

Aside from dispute resolution policies addressing bad faith registrations of domain names,¹⁷⁶ such as the UDRP and URS; there are also Post-Delegation Dispute Resolution Procedures that deal with the conduct of the gTLD Registry Operators themselves in handling the domain that leads to trademark infringements.¹⁷⁷

Overall, the ICANN's Working Group Phase One has made significant progress in enhancing the New gTLD RPMs and addressing the concerns of the community.

C. Planned Results of ICANN's Working Group Phase Two: Review of the UDRP

Phase Two of RPM review is the long-anticipated review of the UDRP procedure.¹⁷⁸ The charter that was used for the work on Phase One has many deficiencies, and it will need to be redrafted in order to be used for Phase Two. The rechartering will also provide an opportunity to ensure that issues such as whether the URS should be based on consensus policy and whether it should form an integrated process within the UDRP are clearly confirmed as being within scope. Due to the fact that the rechartering will provide an opportunity to make systemic improvements, this confirmation will be able to take place and ensure that the

¹⁷⁶ Yee Fen Lim, *Internet Governance, Resolving the Unresolvable: Trademark Law and Internet Domain Names*, 16 INT'L REV. L. COMPUT. & TECH. 199, 205 (2002).

¹⁷⁷ *Trademark Post-Delegation Dispute Resolution Procedure (Trademark PDDRP)*, ICANN (June 4, 2012), <https://newgtlds.icann.org/sites/default/files/pddrp-04jun12-en.pdf> [<https://perma.cc/PMA5-ZX39>].

¹⁷⁸ *First Phase of ICANN's RPMs Review: What does this mean for brand owners?*, COMLAUDE (Jan. 13, 2021), <https://comlaude.com/first-phase-icann-rpms-review/> [<https://perma.cc/DRC5-LPNN>].

URS should be established on the principle of consensus.¹⁷⁹ In Phase Two, the revision of the UDRP, which is applicable in the context of all gTLDs and many additional country code top-level domains, is the primary emphasis.¹⁸⁰ The Policy Development Process (“PDP”), which will be reviewing the UDRP, was announced by a government advisory body that discussed its perspective on the various rights protection mechanisms included in all gTLDs.¹⁸¹

V. IMPACT OF THE UDRP ON THE GLOBAL GOVERNANCE OF INTELLECTUAL PROPERTY RIGHTS

The UDRP, developed by ICANN, was designed to address issues related to trademark infringement in the use of domain names. The influence of Phases One and Two RPMs on the UDRP process has led to an important question regarding the validity of using a trademark name as a domain name. While the establishment of different RPMs has helped prevent malicious registration and unauthorized use of trademark names as domain names, it has also had a significant impact on the broader IPR framework. The UDRP has been designed as a uniform dispute resolution mechanism that has a magnetic effect on the IPR framework, helping to address domain name disputes globally instead of being limited to a particular jurisdiction. This section examines the impact of the UDRP on the world of IPR and is divided into two subsections. The first subsection explores the influence of ICANN’s innovative UDRP on the global governance of IPR, while the second subsection

¹⁷⁹ *Id.*

¹⁸⁰ Governmental Advisory Committee, *supra* note 169.

¹⁸¹ *BYLAWS FOR INTERNET CORPORATION FOR ASSIGNED NAMES AND NUMBERS Annex A: GNSO Policy Development Process*, ICANN (Oct. 11, 2023), <https://www.icann.org/resources/pages/governance/bylaws-en/#annexA> [<https://perma.cc/DE7G-3C7A>].

examines the influence of Phase One and Two RPMs on the UDRP process and the issues that continue to resonate in the IPR world.

A. *UDRP's Influence on the International Intellectual Property Rights Framework*

Since domain names are recognized as a phenomenon that occurs on a worldwide scale, issues about ownership of domain names might arise anywhere in the world. With the introduction of the concept of domain names came an increase in the possible threat for the owner of the trademark. An application for the validation and registration of domain names is permitted to use a trademark name even if doing so would violate the rights of the owner of the brand. When domain names first became available, registering them did not cost very much, and prospective applicants were not required to do any pre-application checks to ensure that there would be no confusion with an existing trademark. The major conflict pertaining across the globe is having the trademark registration in a specific jurisdiction, based on territoriality and specificity, while the presence of a domain name is neither bound to a territory nor to a particular class of goods or services.

As an allocator of domain names, the pressure falls on ICANN for the infringement cases of trademarks.¹⁸² ICANN aimed to resolve the issue of trademark infringement by domain names and adopted the UDRP as a mechanism. ICANN also accredited six dispute resolution service providers, including the WIPO Arbitration and Mediation Center (based in Switzerland) and the National

¹⁸² Adam Dunn, *The Relationship between Domain names and Trademark*, CENTRAL EUROPEAN UNIV. 1, 11 (Mar. 31, 2014) (stating the U.S. Department of Commerce, ICANN, and Network Solutions Incorporation allocated the power to register domain names to different entities in the hand of ICANN [. . .]”).

Arbitration Forum (“NAF”) based in the United States.¹⁸³ The party is required to establish three major elements to approach the UDRP for resolving the issue: (1) a complainant that possesses a valid right in said trademark and the domain name is confusingly similar to that trademark, (2) the breaching party has no legitimate interest and (3) the respondent is using the trademark as a domain name with a malicious intention.¹⁸⁴

The establishment of the UDRP by ICANN to resolve domain name disputes gives legitimate power to the trademark holder to challenge the validity of a domain name. The very first case, *World Wrestling Federation Entertainment Inc.*,¹⁸⁵ addressed by the Arbitration Centre of WIPO was approved by ICANN. The introduction of WIPO in resolving domain name disputes attracts other organizations for the settlement of domain name disputes such as the ‘Asian Domain Name Dispute Resolution Centre,¹⁸⁶ the Canadian International Internet Dispute Resolution Centre, the Czech Arbitration Court Arbitration Center for Internet Disputes, and the Arab Center for Domain Name Dispute Resolution.’¹⁸⁷

B. Looking at Phases One and Two: UDRP Issues Resonating in The IPR World

The development of the UDRP by ICANN has tried to decrease the issues of IPRs infringement by the use of a

¹⁸³ *List of Approved Dispute Resolution Service Providers*, ICANN (Feb. 25, 2012), <https://www.icann.org/resources/pages/providers-6d-2012-02-25-en> [<https://perma.cc/B98F-5JHS>].

¹⁸⁴ UDRP, *supra* note 129, at ¶ 4.a.

¹⁸⁵ *World Wrestling Fed’n Ent., Inc. v. Michael Bosman*, No. D99-0001 (Jan. 14, 2000), <https://www.wipo.int/amc/en/domains/decisions/html/1999/d1999-0001.html> [<https://perma.cc/WR95-4XAN>]

¹⁸⁶ Yeo Yee Ling, *Domain Name Dispute Resolution within the Asian Region*, 38 U. TOL. L. REV. 403, 412 (2006).

¹⁸⁷ *Supra* note 183.

trademark as a domain name for the website of the entity. After the contemplation of Phases One and Two, the substantially important question that resonates in the IPR world is about the validity of the use of a trademark name as a domain name for the online sphere. Just like in the IPR sphere, the establishment of different RPMs neglects the malicious registration of domain names, the use of trademark names as domain names without authorization, and the creation of databases of all existing trademark names to prevent resemblance with the existing trademark names. The establishment of different RPMs in Phase One and the applicability of the UDRP to all gTLDs leave an unmatched effect on the general IPR framework. Additionally, the contemplation of issues and the establishment of the UDRP by ICANN, designed by WIPO, as a dispute resolution mechanism uniformly brings a magnetic effect to the IPR framework. This effect is seen in the context of having a uniform dispute resolution mechanism across the globe instead of restraining the addressing of domain name disputes to a particular jurisdiction.

Phases One and Two of the ICANN Working Group's review of the New gTLD RPMs provided several lessons for the IPR world. One of the main lessons learned was that the implementation of new RPMs needs to be carefully planned and executed, with input from all stakeholders. It is important to strike a balance between protecting the rights of trademark holders while also allowing for fair use and innovation. Another key lesson is the importance of clear and consistent guidelines for dispute resolution. The UDRP is an example of a policy that has been effective in resolving disputes related to domain names. However, there are still challenges with determining who has the legitimate title to a domain name, and how to balance the interests of trademark holders and domain name holders. UDRP issues resonate in the IPR world because domain names have become a crucial part of brand identity and

marketing strategies. The UDRP provides a way for trademark holders to protect their intellectual property rights and prevent cybersquatting, which can cause confusion among consumers and dilute the value of a brand. As the internet continues to evolve and new gTLDs are introduced, it is important to review and update the RPMs to ensure that they remain effective and relevant.

The ever-increasing usage of the internet and the rising relevance of domain names for companies have brought UDRP problems to the forefront of the intellectual property rights community. Since companies continue to depend on domain names as their principal identifiers on the internet, trademark holders run a growing risk of having their rights infringed upon and diluted by others who register domain names that are close to or identical to their own. This is particularly true for more modest enterprises, which often lack the financial resources necessary to register each and every conceivable version of their brand online as a domain name. The UDRP has evolved into an essential tool for trademark owners to use in order to safeguard their legal rights in the digital sphere. Despite this development, the UDRP continues to raise important questions regarding due process, jurisdiction, and the appropriate relationship that should exist between the rights of trademark owners and those of domain name registrants. The UDRP and other RPMs will need to be modified so that they are compatible with emerging technologies and business models. Some examples of these include the growing prevalence of mobile app and social media platform use. Throughout Phases One and Two of the evaluation of the new gTLD RPMs by the ICANN Working Group, one of the most important things that we learned was that there has to be a more standard and simplified approach to RPMs across all of the various TLDs. The Working Group identified a number of inconsistencies and gaps in the current RPMs, such as the lack of uniformity in the application of the URS and the necessity for better

coordination between the various RPM providers. Both of these issues were brought to light by the Working Group. Another lesson learned is how essential it is to strike a balance between the interests of those who own trademarks and those who register domain names. The UDRP is an efficient instrument for safeguarding trademarks; nevertheless, it also has the potential to be exploited by trademark holders who are interested in misappropriating and controlling legally registered domain names. The Working Group has proposed a number of changes to the UDRP in order to address these issues. These changes include requiring trademark holders to prove bad faith registration and use of a domain name and allowing registrants to recover their costs in defending themselves against frivolous UDRP claims.

This article demonstrates that there is a need to strike a balance between the interests of trademark owners and domain name registrants in order to make UDRP concerns relevant in the intellectual property rights community. The UDRP and other RPMs will need to be modified to accommodate emerging technologies and business models in order to continue serving their purpose of protecting intellectual property rights in the digital sphere as the internet continues its rapid pace of change. In conclusion, the UDRP concerns have important ramifications for the realm of intellectual property rights as a result of the increasing relevance of domain names for companies. The UDRP and other RPMs need to be modified to accommodate emerging forms of technology and business models if they are to continue serving their purpose of safeguarding intellectual property rights in the digital sphere.

VI. CONCLUSION

This article investigates the ways in which legal concepts governing trademarks and domain name systems

overlap and interact with one another. Even though search engines and virtual assistants have partially taken over their function, domain names are still imperative because of their preeminent function as signifiers of companies on the internet.

As the digital landscape evolves, AI language models have the potential to transform the interplay between trademarks and domain name systems. These advanced models can facilitate a more streamlined and efficient registration process by automating the evaluation of domain name availability and identifying potential conflicts with existing trademarks. More legal research will soon be needed but it seems that by quickly detecting possible issues, AI models can help prevent disputes before they arise, reducing the strain on both domain name and trademark systems. Furthermore, AI language models can be employed to support domain name dispute resolution processes, such as the analysis of cases under the UDRP, enhancing the efficiency and accuracy of these proceedings. This integration of AI technology into the legal landscape can lead to a more agile and adaptive system, better equipped to address the complexities of managing intellectual property rights in the digital era. As AI continues to advance, it is crucial for policymakers, regulators, and stakeholders to consider the implications and benefits of incorporating AI language models into the trademark and domain name systems.

In any case, the use of a trademark in whole or in part in a domain name may increase the possibility of consumer misunderstanding and lead to the dilution of trademark via blurring or tarnishing, and the reduction of the goodwill and value of the brand. Since a trademark and a domain name may be two facets of the same corporation, it stands to reason that both will be essential to the architecture of the future internet. When someone registers a domain name, they should be made aware that a trademark may already exist

that is the same as or very similar to the domain name. While deciding whether or not to grant the domain name, the registrar should have this information in mind before making its choice. In the same vein, the agency that oversees trademarks needs to take domain names into account before choosing whether or not to award a trademark. This form of natural integration might help avoid disputes and lead to package offers, in which an individual could register both a trademark for particular classes of products and services as well as receive a corresponding domain name at the same time. In a broader sense, the UDRP paves the way for a dispute resolution system that is more universal, convenient, cost-efficient, and expeditious for the different IPRs.

Due to the tremendous influence that the internet has had on the still-nascent field of intellectual property rights law, the path towards satisfying the requirement for clear agencies and regulations to control domain name adoptions and protect trademark holders has been a rocky one. Before settling on the UDRP as a global policy to unify the database and make it simpler to deal with domain name disputes, ICANN and NSI went through a process of trial and error to arrive at their decisions. Yet, the question of establishing who genuinely owns the legal title continues to be a problem. In addition, it remains a challenge to strike a balance between the competing interests of those who hold trademarks and those who hold domain names. Cybersquatting and cyber smearing are two tactics that may be used deliberately to annoy and harm trademark owners. Yet, some experts are concerned that the UDRP provides trademark holders too much power to establish their supremacy which can dent the freedom of expression. The article sheds light on the difficulties that have surfaced in a number of nations as a direct result of the expanding usage of domain names, which has resulted in increased strain being placed on the trademark.

In conclusion, the convergence of legal principles governing trademarks and domain names in the digital age is a complex and dynamic process. As AI language models continue to advance, they have the potential to both generate and reduce legal issues related to domain names. However, by leveraging these technologies to streamline the registration process, prevent disputes, and improve dispute resolution, the domain name system can become more agile and adaptive. To achieve this, policymakers, regulators, and stakeholders must work together to carefully consider the implications and benefits of incorporating AI language models into the legal landscape. By doing so, we can enhance the protection of intellectual property rights in the digital era while fostering innovation and growth in the online marketplace.