



## Mediation/Arbitration - A bridge between two disputing parties

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### Abstract

The presentation will be focused on how trademark owners can protect their brands against cybersquatters. Procedure called „**domain name dispute**“ will be introduced and it will be referred on what do the Complainants need to start the proceedings before one of the ADR Providers. I will compare three kinds of domain name proceedings that can be held before the Czech Arbitration Court, show the procedural steps and give some tips to the Parties and their Representatives on how to smoothly go through the proceedings and also how to establish a **bridge between them** – how to settle a dispute and what are the requirements.

The Czech Arbitration Court (“CAC”) provides currently three kinds of domain name proceedings - .eu (+.eu), UDRP (+ co.nl, co.no and .sx) and .cz. Each kind of the proceedings is governed by its own rules, however is very similar in the main pillars. Most of the CAC cases are in UDRP which refers to Uniform Dispute Resolution Policy and Rules and it is about generic top level domain names (“gTLDs”), including so called new gTLDs. These are the domain names with endings .com, .org, .net, .info or .museum, .weather, .eat, .shop, ford, .alibaba etc. (currently ca. 1150 gTLDs available for registration). To **succeed in UDRP** proceedings as the Complainant, you have to prove that:

1. The disputed domain name is identical or confusingly similar to your **trademark** (or **service mark**),
2. The Respondent (domain name holder) has no rights or legitimate interest in the disputed domain name **and**
3. The Respondent has registered and is being used the disputed domain name in bad faith

I will refer to latest decisions in UDRP regarding the question if the second and third element of UDRP can be considered together and also show that the case should be considered as whole under so called “common sense“ criteria. Further I will go through important topics and relevant decisions, like:

- Test for identity or confusing similarity (trademark vs. the disputed domain name) + does the gTLD matters? (reflecting recent development of decisions regarding new gTLDs)
- Domain names including trademark + expression for reparation, resale, distribution.. – Oki Data test
- Criticism sites, sucks cases – is it a fair use of the domain name?
- Non-use of the domain name and other supportive arguments to prove bad faith

I will show Panels attitude to above mentioned points in recent CAC cases.

CAC is also an .eu provider – it has administered over 1.500 .eu cases since 2006 (most of them during the .eu Sunrise period against the .eu Registry – EURid). Currently it administers around 60 cases a year in all EU languages. The .EU proceedings is quite similar to UDRP, however it differs in few points.

To **succeed in .EU** proceedings as the Complainant, you have to prove that:

1. The disputed domain name is identical or confusingly similar to your **name in respect of which a right is recognized or established by the EU law or law of the member state**
2. The Respondent (domain name holder) has no rights or legitimate interest in the disputed domain name **or**
3. The Respondent has registered and is being used the disputed domain name in bad faith

To help the trademark owners to better orientate in the .EU proceedings, the CAC launched second edition of .EU jurisdiction (“**CAC .EU Overview 2.0**“) in January 2017. The presentation will introduce some interesting points, like:

- Company names, family names, public bodies, geographical terms – are these relevant rights and under which circumstances?
- Can non-EU entities file an .EU Complaint and which remedies they can request?
- Language trials: recent development

Third domain name proceedings that can be currently conducted before the CAC is the .CZ proceedings. To **succeed in .CZ** proceedings as the Complainant, you have to prove that:

1. The disputed domain name is identical or confusingly similar to your **protected rights**
2. The Respondent (domain name holder) has no rights or legitimate interest in the disputed domain name **or**
3. The Respondent has registered and is being used the disputed domain name in bad faith

In all three above mentioned domain name proceedings only a transfer of the domain name or its cancellation can be requested. The fee is to be paid by the Complainant, unless the Respondent elects the case to be decided by a three-member panel – in this case each party pays half of the fee.

The CAC has a split fee in UDRP based on the fact whether the case is simplified or complex. It is considered complex if an administrative complaint response has been filed or if there is some complex issue based on which the Panel conducts e.g. its own investigation. Around 80 % of the cases are considered simplified. This is not to be distinguished in the .eu cases, on the other hand the EURid massively financially contributes to each complaint.

The CAC has currently 60 Panellists on the UDRP list, these names you can mostly found on lists of other UDRP centres. There are 112 .EU Panellists to cover all the EU languages and 18 Panellists in .CZ disputes.