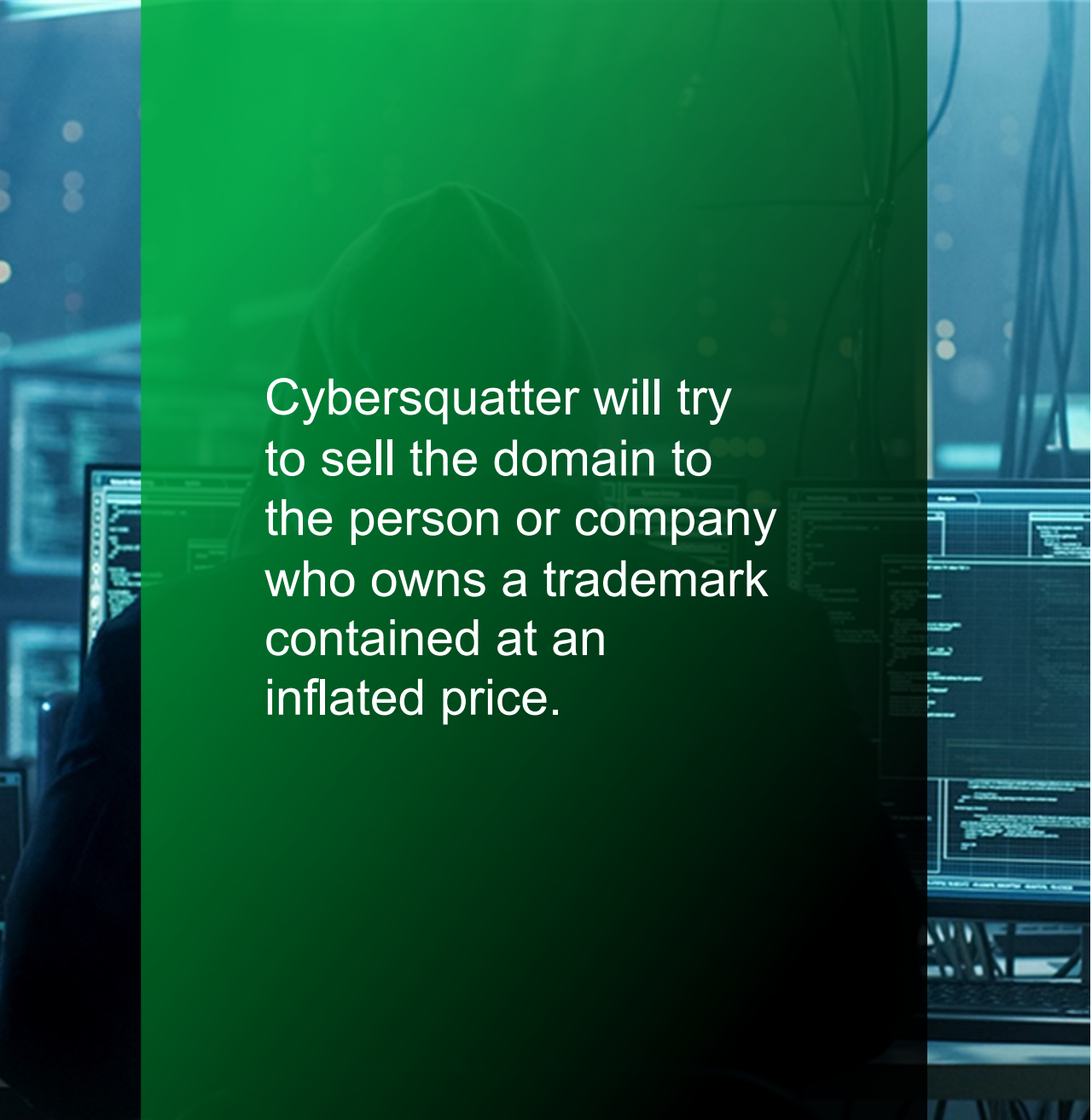


Hijackers & Cybersquatters

Practical Tips to Protect Your Domain Names and Trademarks Against Bad Actors

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Cybersquatter will try to sell the domain to the person or company who owns a trademark contained at an inflated price.

Cybersquatting

- Unauthorized registration and use of Internet domain names that are identical or similar to trademarks, service marks, company names, or personal names.
- Cybersquatters obtain and use the domain name with the bad faith intent to profit from the goodwill of the actual trademark owner.





Types of Cybersquatting

1. Typosquatting


Cybersquatter intentionally buys misspelled domain names of popular brands to create an illegitimate website that people will land on when they make a typing error.

Examples:

- faeggredrinker.com;
- fegredrinker.com;
- faegrerinker.com

With popular web sites that have millions of visitors, the typosquatter will receive lots of free traffic on their illegitimate websites if a small fraction of people make a typo.





Types of Cybersquatting


2. Look-Alike Domain

- Cybersquatters buy domain names that have added special characters, numbers, or common words to brand.
 - Examples: faegredrinkerlaw.com; faegrelegal.com; drinkerfaegre.com

3. gTLD Exploitation

- Top-level domains (TLDs) are the last part of a domain name like .com, .org, .ca, .adult, .legal, .sucks. There are more than 2,000 TLDs available in the market.
- Cybersquatters will buy matching domains with different TLDs.
 - Example: faegredrinker.law





Types of Cybersquatting

4. Gripesites

Example: Faegrelawsucks.com

5. Celebrity Names

Example: kevinspacey.com



Preventive measures

1. Monitoring

- Trademark Clearinghouse
<https://www.trademark-clearinghouse.com/>
- Domain name monitoring services

2. Defensive domain name registration



Options for fighting Cybersquatters

In the United States there are two options:



International arbitration system created by the Internet Corporation of Assigned Names and Numbers (ICANN);



Sue under the provisions of the Anticybersquatting Consumer Protection Act (ACPA).



Uniform Domain Name Dispute Resolution Policy

- An action brought by any person who can establish that:
- domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights;
- domain name owner (registrant) does not have any rights or legitimate interests in the domain name; and
- domain name has been registered and is being used in "bad faith."

No financial remedies. See, <https://www.icann.org/>



- Allows for payment of monetary damages.
- Allows for filing of in rem action against the domain name in the judicial district where the domain name registrar is located.

Anticybersquatting Consumer Protection Act

15 U.S.C. § 1125(d)

ACPA authorizes a trademark owner to sue an alleged cybersquatter in federal court and obtain a court order transferring the domain name back to the trademark owner.



ACPA

Trademark owner must prove all of the following:

- Plaintiff's trademark is distinctive or famous and therefore entitled to protection;
- Domain name is identical or confusingly similar to plaintiff's mark; **and**
- Defendant registered domain name in bad faith with the objective of profiting from it.

Bad faith must occur at time of registration, and shown by:

- Registrant's trademark or other intellectual property rights in the domain name;
- Whether the domain name contains the registrant's legal or common name;
- Registrant's prior use of the domain name in connection with the bona fide offering of goods or services;
- Registrant's bona fide noncommercial or fair use of the mark in a site accessible by the domain name;
- Registrant's intent to divert customers from the mark owner's online location that could harm the goodwill represented by the mark, for commercial gain or with the intent to tarnish or disparage the mark;
- Registrant's offer to transfer, sell, or otherwise assign the domain name to the mark owner or a third party for financial gain, without having used the mark in a legitimate site;
- Registrant's providing misleading false contact information when applying for registration of the domain name;
- Registrant's registration or acquisition of multiple domain names that are identical or confusingly similar to marks of others; and
- Extent to which the mark in the domain is distinctive or famous.



Thank you!



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