

## Using UDRP Arbitration to Squash Typosquatters

**Ryan P. Siney, Esquire**  
**Tucker Arensberg, P.C.**

Typosquatting is the practice of intentionally confusing internet users who lack perfect typing or spelling skills by diverting them to a site different from the one they attempted to reach. The Uniform Domain Name Dispute Resolution Policy (“UDRP”) provides owners of marks with an efficient method of resolving typosquatting, cybersquatting and other domain abuses. The UDRP is included among the terms to which every domain registrant agrees when a domain is registered worldwide, and thus every registrant agrees to resolve domain disputes using the UDRP’s administrative arbitration procedure through one of several arbitration service providers.

A mark owner can initiate arbitration against a registrant who infringes upon a registered or common law mark by intentionally diverting users seeking goods or services associated with the mark. To prevail, a complainant must establish three elements. First, the domain must be identical or confusingly similar to a mark in which the complainant has rights. Second, the respondent must have no right or legitimate interest in the domain. Finally, the domain must have been registered and used in bad faith. If these elements are satisfied, the domain is transferred to the complainant.

Arbitration panels have routinely decided that a domain which differs from the complainant’s mark by only one letter (the most common form of typosquatting) is confusingly similar to the complainant’s mark. Creative attempts to capitalize on other errors may also be confusingly similar, such as word reversals (for example, vespavintage.com was found to be confusingly similar to “Vintage Vespa”), the addition of relevant words (marriott-hotel.com is confusingly similar to “Marriott”) and the addition of a hyphen (euro-tunnel.com is confusingly similar to “EuroTunnel”).

Another common mistake seized upon by typosquatters is the use of the wrong top level domain (.com, .org, .net, .info, etc.). Arbitration panels have confirmed that merely attaching a different top level domain to the complainant’s mark is confusingly similar (hp.net is confusingly similar to hp.com).

The UDRP does not preclude a registrant from using a similar domain for a legitimate noncommercial or fair use. A domain which incorporates another’s mark to protest or comment on the mark’s owner may establish a sufficient interest in the domain. For example, an

arbitration panel suggested that wal-martsucks.com, if used to protest Wal-Mart, could be a legitimate use of the Wal-Mart mark.

If the complainant makes a prima facie showing that the respondent has no rights or legitimate interest in the mark, the burden shifts to the respondent to rebut that presumption. A respondent may then demonstrate that it uses the domain for a bona fide offering of goods or services without the intent to deceive. The respondent may also assert that it has legitimately used or is known by the domain, even if the domain happens to be similar to the complainant's pre-existing mark.

Bad faith is often the most problematic element. Some arbitration panels require that bad faith exist at the time of registration and at the time the domain was put into use; others require bad faith at only one of these points in time.

Bad faith at registration exists if the respondent registered the domain for the primary purpose of disrupting the complainant's business. If the respondent intended to divert users from the complainant and instead direct them to the respondent's site, then the respondent acted in bad faith. Knowledge of the existence or fame of the complainant's mark is also suggestive of bad faith at registration.

Bad faith in the use of the domain requires evidence that the respondent sought commercial gain by intentionally creating a likelihood of confusion about the source of the respondent's goods or the sponsorship the respondent's site. Bad faith is often shown by evidence that the respondent intends for users to think the respondent's site is owned by the complainant. In typosquatting cases, bad faith can also be presumed if the respondent unquestionably intended to cause confusion by registering and using a confusingly similar domain.

If the arbitration panel decides in favor of the complainant, the domain registrar (the service used to register the domain) transfers the domain to the complainant. The respondent may contest the decision in court; the transfer is then stayed until resolution of that action. Depending on the respondent's answer to the complaint and other factors, a UDRP arbitration can be resolved in as short as six weeks.

The UDRP can operate as both a shield and a sword: swift action can be taken against confusingly similar competitors worldwide, but new site owners could find themselves the target of a UDRP action if they register a domain similar to another's existing mark. Ideally, businesses should be proactive by registering all potential misspellings of their domains and marks in anticipation of the less than perfect typist and to prevent potential typosquatters from registering confusingly similar domains.

Ryan P. Siney is an intellectual property, business and commercial litigation attorney at Tucker Arensberg, P.C. For more information, please contact Ryan P. Siney at (717) 234-4121 or [rsiney@tuckerlaw.com](mailto:rsiney@tuckerlaw.com).

*This article originally appeared in the Maryland Bar Bulletin and is reprinted with permission of the Maryland State Bar Association.*