

Problem Set 5

1. Your client bought a domain name, www.hikitty.com, for her 3-year-old daughter, Kitty, as a birthday gift. Most recently, she received a cease-and-desist letter from a Japanese corporation. In the next few days, she received five more letters from the European, Hong Kong, Korean, Taiwanese, and U.S. licensees of Hello Kitty® products, as well as some vicious letters from Hello Kitty® fans. She's very concerned about the letters and asked you the following questions regarding the UDRP, which she has never heard of in her life. What would be your responses?

- (a) What are the three basic elements a complainant must prove to secure a domain name transfer?
- (b) Must the complainant be the holder of a valid trademark or service mark?
- (c) What are the permissible affirmative defenses under the UDRP? Are these defenses exclusive?
- (d) Who will bear the costs of the fees of the dispute resolution provider?
- (e) Who will choose the dispute resolution provider?
- (f) Can the respondent demand a 3-person dispute resolution panel if the complainant *insists* on having only one panelist? If yes, who will choose and pay for the panelists? If no, which provision prevents the respondent from doing so?
- (g) How is notice served on the respondent?
- (h) Can the respondent seek a judicial determination before the UDRP proceeding? During the proceeding? And after the proceeding?
- (i) Who will prevail under the UDRP proceeding?

2. Mammajamalaluha is a famous ethnic restaurant chain headquartered in London. Its restaurants are located in 154 cities in 23 countries, many of which are EU member states. Most recently, the restaurant chain noticed that your client has registered the domain name www.mammajamalaluha.com and initiated an action under the UDRP. Your client claimed that she created the word "mammajamalaluha" herself and has used it in a novel she is currently working on. Upon your request, she produced computer files, handwritten drafts, and even witnesses to support her defense. Unfortunately, the dispute resolution provider is not willing to consider any of this evidence, citing that a court, rather than a dispute resolution provider, will be in a better position to evaluate the authenticity and veracity of the evidence. Your client lost the case before the UDRP panel.

To prevent the domain name transfer, you advised your client to seek a declaratory judgment from a federal court that her registration does not violate the Anticybersquatting Consumer Protection Act (ACPA). Mammajamalaluha moved to dismiss the case, citing that it had no intention of bringing any claims under the ACPA or under federal trademark and unfair competition laws. Should the court dismiss the case? If it does, would you recommend your client to appeal the case? Would your client be able to prevent the registrar from transferring her domain name while she is awaiting the determination of the appellate court? Would the answer be different if she relies on the domain name for her business?

3. Your client, www.uk.com, runs an Internet portal and provides web hosting, design, and support services for businesses and individuals who have interest in establishing domain names and email addresses ending in uk.com (e.g., ilove.uk.com). He is nonetheless concerned about his legal liability regarding his customers' abusive and predatory registration of domain names that infringe upon third-party intellectual property rights holders. He sought your counsel. What would be your advice?