

# How Do I Get My Stolen Domain Name Back?

By Houston Putnam Lowry, Esq., Brown & Welsh, P.C.

Your client's advertising agency is working out the details of a new campaign. The client has decided to build a website as part of the new advertising campaign. The client starts investigating possible domain names, starting with the obvious – their company and product names. As an accountant, you have to make sure your client actually owns the assets necessary to conduct its business.

Each domain name your client tries goes to a competitor's website! Every time a prospective customer types in the name of your client's company and its products, they get directed to your client's competitor and your client loses the sale.

## Hey ... it *could* be worse ...

Of course, it *could* be worse – those potential customers could simply be directed to a pornographic website, which poses its own set of public relations nightmares – as the City of West Haven discovered in 2001 (read the *Hartford Advocate* article at [http://brownwelsh.com/Archive/Domain Extortion.htm](http://brownwelsh.com/Archive/Domain%20Extortion.htm)) when it failed to renew [whaven.com](http://whaven.com) because they weren't going to use it anymore. In fact, for years, [WhiteHouse.com](http://WhiteHouse.com) was a pornographic website.

How can this be happening? Your client is losing sales. Your client is losing customers. Your client's ad campaign grinds to a halt. Your client cannot conduct its business, which affects their ability to get funding. Your blood pressure climbs ...

## How did this happen?

These are a number of possible explanations. A competitor may have bought those domains years ago when your client didn't think eCommerce was important. Perhaps your client didn't renew their domain name on time and a pirate grabbed it when it expired.



Your client's website designer could have registered the domain in his name, but sold it a couple of years ago when they had a billing dispute. A forged transfer document would have been submitted in your client's name. There are a multitude of ways this could have happened – but the bottom line is the same: your client's business is being hurt. Your client needs to take action, but what should it do?

### **Step One: Start at the beginning. Step Two: Weigh your options.**

First and foremost, look up who owns the domain name. This can be done a number of ways, but among the easier ways is to use [www.BetterWhois.com](http://www.BetterWhois.com). This website will normally give the name, address, telephone number, fax number and e-mail address for whoever owns the domain name.

Armed with this information, make a telephone call to the domain name owner before calling a lawyer. Perhaps the owner will transfer the domain to your client for nothing or for a nominal fee. You never know until you ask.

The owner may not be reachable (and pirates are almost never reachable

until ransom needs to be sent). The owner may ask for too much money. Without an agreement, your client has only three choices. The first choice of "doing nothing" is simply not acceptable. The second choice is to sue the owner wherever the owner is located. While the thought of spending years and tens of thousands of dollars litigating on a small Caribbean island will undoubtedly cause a lawyer to remember your client's birthday with great fondness, your client doesn't want to spend that much time and money at this stage.

### **The final option: the Uniform Dispute Resolution Policy.**

The final option is to start a proceeding under the Uniform Dispute Resolution Policy ("UDRP"). This is an expedited, "documents only" procedure that will decide (unless an appeal is taken to the courts) who should own the domain name. The name is automatically transferred ten days after the case is over to the winning party. As a complainant, your client need only prove three points:

**First**, the domain name is identical or confusingly similar to a trademark or

service mark in which your client has rights. This can be done by either showing your client's registered trademark or by showing your client has used its mark long enough in connection with its business that it has acquired rights to the name.

**Second**, your client must show the current domain name owner has no rights or legitimate interests in the domain name. The current domain name owner can demonstrate such rights a number of ways. For instance, the owner's use of the domain name in connection with a *bona fide* offering of goods or services before your client gave notice of a dispute about the domain name dispute will show the current owner has rights. The current owner may be commonly known by the domain name, even if he hasn't acquired any trademark rights. Finally, the current owner may be making a legitimate noncommercial use of the domain name.

**Third**, your client must show the current owner registered the domain name and is using it in bad faith. This

can be shown in a number of ways. It can be shown if the owner registered the domain name primarily for the purpose of transferring the domain name registration to your client or one of your client's competitors.

#### Perhaps ...

Perhaps your client can show the owner registered the domain name to prevent it from reflecting its mark in a corresponding domain name, provided the owner has engaged in a pattern of such conduct. Perhaps your client can prove the owner registered the domain name primarily to disrupt your client's business. Perhaps your client can prove the present owner intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with your client's mark. All of these facts would show the current owner registered the domain name and is using it in bad faith.

If your client can prove these three elements, the Panel will transfer the domain name to your client. The paperwork is submitted to a panel for deci-

sion. No hearing is held because the panel will decide the issue based upon the submitted paperwork. If you prevail and no appeal is filed within ten days, the domain name is promptly transferred to your client by the registrar.

#### Months ... not years.

While there is a significant filing fee required to start a UDRP proceeding, the procedure is fairly quick. Instead of taking years, it will take months. Once it is complete, your client should own the domain name it needs to conduct its business.



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