

## Counterfeit Analysis

The world of counterfeits and  
the rise of the internet

## Domain Demesne

A brand new UDRP round-up



# A post-GDPR world

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## Domain demesne

In the first of a new series of UDRP round-ups, American Family, Mojang, Ikea and Marlboro feature, while Joe Englander gives his insight

**Minecraft game publisher Mojang AB, and its owner Microsoft has argued ownership of a domain that allegedly sold counterfeit Minecraft merchandise.**

Sam Wong of China, who initially used a privacy shield for its WHOIS information, incorporated Minecraft's trademarked name to use minecraftbackpacks.com to sell unauthorised and counterfeit merchandise. Microsoft, who owns the licence to Minecraft after purchasing Mojang AB, filed its complaint in a UDRP dispute at the

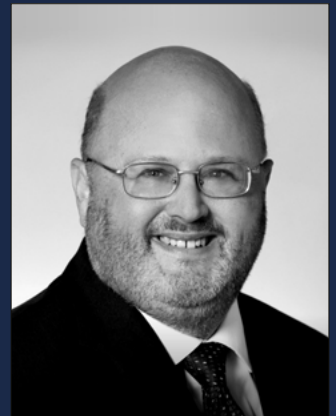
Alternative Dispute Resolution Forum. Wong, who did not submit a response to Mojang's complaint, is not licensed to sell Minecraft merchandise, nor to use the trademark.

Sole panellist Charles Kuechenmeister ordered the disputed domain to be transferred to Mojang, after finding that it was created to mimic Minecraft, by "reproduc[ing] [the] Minecraft trademark and colour schemes, depicts imagery identical or very similar to that on minecraft.com, and purports to offer Minecraft merchandise for sale".

Microsoft, the owner of the trademark, filed a UDRP before using ADF's procedures and obtained transfer of the disputed domain name. Its case was made easier to prove because the respondent filed no response. Since no response was filed, the panel presumed that the respondent lacked rights and legitimate interests in the domain name.

Noting the wide use of the complainant's marks and that the respondent's domain name closely mimics and impersonates complainant's web site and not just the complainant's trademark, The panel found that respondent clearly knew of complainant at registration and held that the knowledge is clear evidence of bad faith registration and use.

Joe Englander  
Shareholder  
Fowler White Burnett



### Swedish furniture giant Ikea has claimed ownership of an infringing domain from an alleged Ikea kitchen installer.

In a UDRP dispute at the World Intellectual Property Organization Arbitration and Mediation Centre, Robert Amirillas of Extreme Construction in Arizona claimed that he owned the domain and it's already "under dispute".

Amirillas admitted that he "really doesn't know what to do at this point" and offered to sell it. He added: "I install Ikea cabinets for a living and I'm planning to build my company around this domain."

The furniture retailer, however, alleged that the domain infringes its trademark in its entirety, and that the domain has "essentially been unused by the respondent since its registration".

Sole panellist Mathias Lilleengen found that Amirillas "prevents the owner of the trademark from reflecting the mark in a corresponding domain name".

Lilleengen also found that Amirillas "effectively impersonates or suggests sponsorship or endorsement" from Ikea.

### Insurance company American Family has claimed ownership of seven domains, which were registered to criticise the company.

Americanfamilyclaims.com, americanfamilyclaims.exposed, and amfamclaims.exposed were just some of the domains registered by Joe Caulfield of Missouri to "place non-commercial criticism and commentary of American Family on these sites". Caulfield claimed that he hadn't made any public postings on the websites due to an ongoing dispute with the insurance company.

American Family had alleged that the domains infringe its trademarks and have been "parked" for commercial gain, therefore, indicating bad faith. Despite not challenging American Family's trademark claims, he argues that he chose ".exposed" domains names to emphasise his intent to criticise the insurance company and denies any intent to mislead internet users.

Sole panellist Scott Blackmer found that the domains were confusingly similar, as they utilise the American Family or AmFam trademarks in its entirety, despite the specific choice of the ".exposed" domain. Despite intending to use the domains to criticise the insurance company, Blackmer ruled that as Caulfield hasn't posted anything to them for three years.

Blackmer concluded by ordering the disputed domains to be transferred to American Family.

### American cigarette manufacturers Marlboro has won the rights to a domain that infringes its trademarked name from a Chinese individual.

Wang Yan of Beijing, who originally registered the domain, did not submit a defence to Marlboro's complaint, but did claim that it was registered because he "loved the Marlboro brand and was only used for private mail delivery".

Yan argued that he never engaged in any activities apart from private use, and requested a postcard of Marlboro Company as compensation. Marlboro had alleged that Yan's registering and use of the domain was "malicious" and that he had no rights to the disputed domain.

Sole panellist Rachel Tan ruled that the disputed domain should be transferred to Marlboro, as despite his intended use, Yan "did not submit any evidence to prove its legal rights to the disputed domain name".

Tan also found that the domain was registered to be "a motive for confusing internet users", therefore, constituting bad faith.

In this case, the decision to transfer the domain was largely based upon a lack of fair use and respondent's bad faith. Respondent had claimed that its registrations and use were fair use for criticism sites.

However, the panel inferred bad faith because Respondent registered seven domain names, which might be considered excessive to establish a criticism site, where three of them on their face (those lacking the ".exposed" gTLD) appeared to be sponsored by the complainant itself. The panel found that the respondent's lack of use for criticism, coupled with its parking of the domain names for years for the registrar's commercial benefit, to be antithetical to a claim of "fair use".

Also, the panel found no reason to doubt respondent's argument that respondent objected to the complainant's handling of the respondent's insurance claim and contemplated criticising the complainant's decision and practices. However, from the time of registration and for the four years since, the respondent has only allowed another party to use the domain names, incorporating the complainant's trademarks, to advertise its own commercial services.

This conduct, along with the selection of numerous domain names that appear to be affiliated with the complainant, strongly suggested a lack of regard for the complainant's trademark rights. The panel found bad faith and ordered transfer of the domain names.