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**WORLD WRESTLING FEDERATION
ENTERTAINMENT, INC. v. MICHAEL BOSMAN:
A LEGAL BODY SLAM FOR CYBERSQUATTERS
ON THE WEB**

M. Scott Donahey[†] and Ryan S. Hilbert^{††}

I. INTRODUCTION

On January 14, 2000, an arbitration panelist for the World Intellectual Property Organization (WIPO) ordered Michael Bosman of Redlands, California, to transfer ownership of the domain name <worldwrestlingfederation.com> to Stamford, Connecticut-based World Wrestling Federation Entertainment, Inc. (“WWF”), on grounds that Bosman had registered and used the domain name in bad faith.¹ It was the first case ever to be decided under the new Uniform Domain Name Dispute Resolution Policy (the “Policy”) adopted by the Internet Corporation for Assigned Names and Numbers (ICANN) on August 26, 1999.² From the moment the case was electronically submitted on December 2, 1999, until the time a binding decision was rendered, the entire dispute lasted only six weeks.³

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1. World Wrestling Federation Entertainment, Inc. v. Michael Bosman, WIPO, No. D99-0001 (Jan. 14, 2000) <<http://arbiter.wipo.int/domains/decisions/html/d99-0001.html>> [hereinafter *WWF*].

2. See Jeri Clausing, *Wrestling Group Wins Back Use of Its Name on Internet*, N.Y. TIMES, Jan. 17, 2000, at C4. As for the process itself, Bosman stated that he felt that it was even-handed: “‘I think it’s a good organization,’ he said [referring to the World Intellectual Property Organization]. ‘They were fair and unbiased and it didn’t cost me a dime.’” *Id.*

3. See *WWF*, *supra* note 1, for a more detailed description of the Procedural History underlying this case.

II. STATEMENT OF FACTS

The dispute in this case originated in October 1999, when Bosman, a 25-year-old stock broker from Redlands, California, registered the domain name <worldwrestlingfederation.com> with Australian-based Melbourne IT for US\$60 and then offered to sell it to the WWF three days later for US\$1000.⁴ In an e-mail message to the WWF notifying them of his offer, Bosman stated that cybersquatting cases “typically accomplish very little and end up costing the companies thousands of dollars in legal fees, wasted time and energy.”⁵ Further, Bosman indicated that “[t]he payment of US\$1000 would represent more than payment for [his] time and money, but also . . . would serve as consideration for ‘the right to current ownership of the domain name “worldwrestlingfederation.com.””⁶

Rather than agree to Bosman’s offer, on December 2, 1999—one day after ICANN’s new Domain Name Dispute Resolution Policy had come into effect⁷—the WWF submitted a complaint electronically to WIPO’s Arbitration and Mediation Center.⁸ In its complaint, the WWF alleged, *inter alia*, that Bosman had registered a domain name that was identical to its registered service mark and trademark and that Bosman had “no rights or legitimate interests in respect to the domain name at issue.”⁹ The WWF also claimed that Bosman had registered and used the domain name in bad faith.¹⁰

4. See Clausing, *supra* note 2; Michael Utley, *Man Loses Match Over Wrestling Site Name*, KNIGHT-RIDDER TRIB. BUS. NEWS, Jan. 15, 2000. Although the address for the World Wrestling Federation’s current web site is <www.wwf.com>, Bosman was able to register the domain name <worldwrestlingfederation.com> after ICANN changed its rules, allowing names of up to 63 characters to be registered rather than the traditional 22. See Clausing, *supra* note 2.

5. WWF, *supra* note 1.

6. *Id.*

7. The first day complaints could be submitted to dispute-resolution providers for disputes involving domain names registered by registrars other than America Online, the NameIT Corp., and Network Solutions under ICANN’s new Domain Name Dispute Resolution Policy was December 1, 1999. Complaints concerning domain names registered by the other three providers began to be submitted on January 3, 2000. See *Implementation Schedule for Uniform Domain Name Dispute Resolution Policy*, ICANN (visited Feb. 24, 2000) <<http://www.icann.org/udrp/udrp-schedule.htm>>.

8. See WWF, *supra* note 1.

9. *Id.* In addition to the above, the WWF also alleged that Bosman had “not developed a Web site using the domain name at issue or made any other good faith use of the domain name,” and that the domain name was “not, nor could it be contended to be, a nickname of [Bosman] or other member of his family, the name of a household pet, or in any other way identified with or related to a legitimate interest of [Bosman].” *Id.*

10. See *id.*

Pursuant to paragraph 4(a) of the Policy, the WIPO arbitrator assigned to the case considered three elements in rendering a decision.¹¹ These three elements, all of which the WWF had the burden of proving, were: (1) that the domain name was identical or confusingly similar to its own registered trademark and service mark; (2) that Bosman did not have any rights or legitimate interests in the domain name; and (3) that Bosman had registered and used the domain name in bad faith.¹²

With respect to the first element, the arbitrator concluded that “[i]t is clear beyond cavil that the domain name <worldwrestlingfederation.com> is identical or confusingly similar to the trademark and service mark registered and used by [the WWF].”¹³ The arbitrator also determined that Bosman had “no rights or legitimate interests” in the domain name in question.¹⁴ It was the third element, regarding whether Bosman had registered and used the domain name in bad faith, that generated the most discussion.

According to the arbitrator, although it was clear that Bosman had *registered* the mark in bad faith,¹⁵ he must also have *used* the mark in bad faith in order to be held liable.¹⁶ Citing two United States cases¹⁷ and paragraph 4(b)(i) of the Policy¹⁸ as authority, the arbitrator

11. *See id.* In particular, paragraph 4(a) of ICANN’s Domain Name Dispute Resolution Policy states:

You are required to submit to a mandatory administrative proceeding in the event that a third party (a “complainant”) asserts to the applicable Provider, in compliance with the Rules of Procedure, that: (i) your domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and (ii) you have no rights or legitimate interests in respect of the domain name; and (iii) your domain name has been registered and is being used in bad faith. In the administrative proceeding, the complainant must prove that each of these three elements are present.

Uniform Domain Name Dispute Resolution Policy, ICANN (visited Feb. 24, 2000) <<http://www.icann.org/udrp/udrp-policy-24oct99.htm>> [hereinafter *Policy*].

12. *See WWF, supra* note 1.

13. *Id.*

14. *Id.*

15. *See id.* (stating that “[s]ince the domain name was registered on October 7, 1999, and since [Bosman] offered to sell it to [the WWF] three days later, the Panel believes that the name was registered in bad faith.”).

16. *See id.*

17. The two cases the arbitrator cited were *Panavision International, L.P. v. Toeppen*, 141 F.3d 1316, 1325 (9th Cir. 1998) (holding that defendant’s intention to sell the domain name to the plaintiff constituted “use” of the plaintiff’s mark), and *Intermatic Inc. v. Toeppen*, 947 F. Supp. 1227, 1239 (N.D. Ill. 1996) (noting that defendant’s desire to sell the domain name to plaintiff was sufficient to meet the “commercial use” requirement of the Lanham Act). Incidentally, pursuant to paragraph 15(a) of the Rules for Uniform Domain Name Dispute Resolution Policy, “a Panel shall decide a complaint on the basis of statements and documents

determined that the third element could be met if Bosman had attempted to sell or transfer the domain name “for valuable consideration in excess of” any out-of-pocket costs directly related to [it].”¹⁹ Since Bosman had offered to sell the domain name to the WWF for an amount that was substantially greater than the amount he paid to register it, the arbitrator held that Bosman had used the domain name in bad faith.²⁰

As a result of the arbitrator’s holding, paragraph 4(i) of the Policy required that “the registration of the domain name <worldwrestlingfederation.com> be transferred to [the WWF].”²¹ In addition, pursuant to paragraph 4(k), Bosman had ten days in which to appeal the decision in a court of competent jurisdiction before Melbourne IT was obligated to transfer ownership rights.²²

submitted and in accordance with the Policy, these Rules and *any rules and principles of law that it deems applicable.*” *Rules for Uniform Domain Name Dispute Resolution Policy*, ICANN (visited Feb. 24, 2000) <<http://www.icann.org/udrp/udrp-rules-24oct99.htm>> (emphasis added). As a result, although it was unnecessary to consider the laws of the United States in rendering a decision, because both of the parties were domiciled in the United States, and United States courts had had recent experience in dealing with similar disputes, the arbitrator looked to these cases for assistance. *See WWF, supra* note 1.

18. Paragraph 4(b)(i) of the Policy states that:

[C]ircumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name.

Policy, supra note 11.

19. *WWF, supra* note 1.

20. *See id.*

21. *Id.* Paragraph 4(i) of the Policy states: “The remedies available to a complainant pursuant to any proceeding before an Administrative Panel shall be limited to requiring the cancellation of your domain name or the transfer of your domain name registration to the complainant.” *Policy, supra* note 11.

22. *See Policy, supra* note 11. Paragraph 4(k) of the Policy states:

The mandatory administrative proceeding requirements set forth in paragraph 4 shall not prevent either you or the complainant from submitting the dispute to a court of competent jurisdiction for independent resolution before such mandatory administrative proceeding is commenced or after such proceeding is concluded. If an Administrative Panel decides that your domain name registration should be canceled or transferred, we will wait ten (10) business days (as observed in the location of our principal office) after we are informed by the applicable Provider of the Administrative Panel’s decision before implementing that decision. We will then implement the decision unless we have received from you during that ten (10) business day period official documentation (such as a copy of a complaint, file-stamped by the clerk of the court) that you have commenced a lawsuit against the complainant in a jurisdiction to which the complainant has submitted under paragraph 3(b)(xiii) of the Rules of Procedure. (In general, that

III. ANALYSIS

As the first case decided under ICANN's new Uniform Domain Name Dispute Resolution Policy, the decision regarding ownership of the domain name <worldwrestlingfederation.com> was both closely watched and the subject of much discussion.²³ Originally, ICANN's Policy was a compromise between various constituencies who argued for their particular interests. For example, one group consisted of those that view the Internet as a communications medium where speech should be free and unfettered. This group often distrusts the business community, which it views as having converted a marketplace of ideas into simply a marketplace. Another group was made up of intellectual property owners who view the Internet as a place where unscrupulous individuals can seize their trademarks and service marks and hold them hostage, by registering them as domain names, or by associating those names with scandalous or unseemly content. Even among the intellectual property owners, differences arose between those who had registered marks on the registry of some country, and those who had acquired marks through use, and had not bothered to register. Finally, there was the conflict over the limited number of domains. While a trademark or service mark could be registered by hundreds of different individuals in different markets or with regard to different products and services, there is only one <.com>.

The first case involving the WWF was relatively straightforward. The registrant clearly had no legitimate interest in the domain name at issue and could not demonstrate one. However, imagine if the domain name in question had been not <worldwrestlingfederation.com>, but rather <wwf.com>, and that the

jurisdiction is either the location of our principal office or of your address as shown in our Whois database. See paragraphs 1 and 3(b)(xiii) of the Rules of Procedure for details.) If we receive such documentation within the ten (10) business day period, we will not implement the Administrative Panel's decision, and we will take no further action, until we receive (i) evidence satisfactory to us of a resolution between the parties; (ii) evidence satisfactory to us that your lawsuit has been dismissed or withdrawn; or (iii) a copy of an order from such court dismissing your lawsuit or ordering that you do not have the right to continue to use your domain name.

Id. As a final note, it should also be pointed out that although the WWF could have litigated this case under the United States Anticybersquatting Consumer Protection Act, Pub. L. No. 106-113, 113 Stat. 1501, 1537 (1999) (to be codified at 15 U.S.C. § 1125(d)), it elected not to do so in order to "protect [its] intellectual property interests while preserving the relationship between [it] and its fans at a minimal cost to all concerned." *WWF, supra* note 1.

23. More specifically, this case was given substantial attention both in the general press and particularly in Internet-related publications.

registrant's name had been not Michael Bosman, but William Wright Franklin. The analysis of all of the factors would have to have been much more protracted and painstaking in order to reach a just resolution.

Compare the ICANN Policy to the Anticybersquatting Consumer Protection Act (the "Act")²⁴ recently passed by Congress. Under the Act, *in rem* jurisdiction can be had at the site of the registrar, where the registrar is located in the United States. This means that parties can be forced to travel great distances to attend hearings and the trial of the matter. Since the registrants are often individuals, who may have a legitimate claim to the domain name at issue, the registrants may be spent into submission. The plaintiff may also collect damages against the registrant under the Act, a remedy which is unavailable under the Policy. If what the plaintiff really wants is the domain name registration, damages amount to a form of vengeance.

Under the Policy, the complainant pays a registration fee in an amount dependant upon the provider and the number of panelists (1 or 3) desired. In no event is this fee more than \$5,000, and for one panelist, it does not exceed \$1,000.²⁵ Unless the respondent desires a three-person panel when the complainant has elected a single panelist, the respondent pays nothing.²⁶ A decision is made on the basis of written documents submitted electronically and by courier, and there is no hearing absent a finding of exceptional circumstances.²⁷ Decisions issue within a short period of time, usually less than thirty days from the constitution of the panel.²⁸ Decisions are enforced within ten days of their publication on the ICANN web site, unless a party chooses to appeal by filing an action in a court of competent jurisdiction.²⁹

Thus the only costs involved in addition to legal representation are any costs for legal representation. These are limited in nature, since there is generally only one written submission per party and no hearings.

24 Pub. L. No. 106-113, 113 Stat. 1501, 1537 (1999) (to be codified at 15 U.S.C. § 1125(d)).

25. See *Schedule of Fees (Annex D)*, World Intellectual Property Organization Arbitration and Mediation Center (visited Mar. 13, 2000) <<http://arbiter.wipo.int/domains/fees/index.html>>.

26. See *WIPO Guide to Domain Name Dispute Resolution*, World Intellectual Property Organization Arbitration and Mediation Center (visited Mar. 13, 2000) <<http://arbiter.wipo.int/domains/guide/index.html>>.

27. See *id.*

28. See *id.*

29. See *Policy*, *supra* note 11.

IV. CONCLUSION

The ICANN procedure is designed to be expedient and inexpensive. It provides a level playing field for the parties, and even the unsuccessful party of the first case involving the domain name <worldwrestlingfederation.com> has called it “fair and unbiased.”³⁰ An individual registrant cannot be forced to abandon his claim to the domain name at issue simply because the defense of the matter is more than the individual can pay. It is a process in which the rights and interests of all the constituencies can be considered and balanced. It is not only international in nature, but *anational*. As such, there is no risk that countries will retaliate against national legislation passed in another country which is considered to be unfair or burdensome. It is private justice, sponsored by a private corporation, concerning a medium that developed without the assistance of national legislation or regulation. It should be allowed to develop and respond to the needs of its constituents.

30. Clausing, *supra* note 2.

