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A Re-Examination of the Defense of Laches After 18 Years of the UDRP

By [Internet Commerce Association](#) (Sponsored Post)

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After 18 years of the UDRP, it is time to re-examine the defense of laches. When the UDRP was launched in 1999, the defense of "laches" was likely not foremost on anyone's mind. After all, "laches" refers to a lack of diligence in making a legal claim — and since the UDRP was brand new and the commercial use of domain names was in its relative infancy in 1999 [1], nobody was really concerned with a trademark owner having "unreasonably delayed" making a UDRP complaint. Nevertheless, the defense of laches has been regularly raised by respondents as a defense in UDRP proceedings from the very beginning, though it has been rejected by many panelists who have claimed that it is "not available" under the UDRP. Those panelists who have rejected laches as a defense have claimed that it is 'impractical to require a trademark owner to instantly enforce trademarks against cybersquatters' and that since laches is an "equitable remedy," is not applicable to the UDRP because 'the UDRP is intended to provide injunctive relief to prevent abuse' [2].

Nevertheless, after 18 years of the UDRP, laches is a defense which should be considered anew, particularly in light of the breadth of delays in bringing a UDRP complaint which could not have been a significant factor back in 1999. As the UDRP matures, it is conceivable and even likely that UDRP complaints will be in the future be brought 20, 30, and even 40 years after a domain name's registration, and such delays could very well cause prejudice to the registrant in particular circumstances, such that the registrant by all rights should be able to rely on the defense of laches.

Moreover, upon examination, the justifications amongst some panelists for rejecting laches appear to be meritless. It is certainly practical to expect a trademark owner to take action against a domain name registrant within some reasonable period of time, rather than conduct itself in a way that induces a domain name registrant's reliance, such as conscientiously looking on and acquiescing to the domain name owner's registration and usage of the domain name. Furthermore, laches is certainly applicable to the UDRP since laches is a well-entrenched legal principle that is specifically intended to provide equitable relief in the very circumstances that the UDRP is designed to address, namely injunctive relief. As a legal regime which is fundamentally equitable in nature, the UDRP is entirely consistent with, indeed suited for, the inclusion of the type of equitable relief provided by

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laches. This article will examine laches and will demonstrate that laches does, in fact, have an important role to play in the UDRP and should, therefore, be reconsidered.

Laches – Equity Aids the Vigilant

The word, "laches," is an unusual sounding word, as many legal terms tend to be. It originates from the Latin word, "laxus" and the corresponding French word, "laschesse", referring to "slackness" or "negligence" [3]. Black's Law Dictionary, the definitive dictionary of legal terms, defines "laches" as "neglect or failure to assert a right or claim which, taken together with lapse of time and other circumstances causing prejudice to adverse party, operates as a bar in court of equity". Thus, Black's states that the "Doctrine of Laches" is based upon the maxim that "equity aids the vigilant and not those who slumber on their rights".

Laches is often referred to as an "equitable defense" — which is another one of those unusual legal terms which has a specific and uncommon meaning. The term, "equity" refers to what was once a 'parallel system' of justice in England; there were courts of "law" and courts of "equity". The term "equity" referred to the spirit of 'fairness, justice, and right dealing', as contrasted with the often rigid and strictly formulated rules of common law. Today, however, the courts of "law" and "equity" have merged, so that "equitable" defenses can be raised along with "legal" defenses. In other words, an "equitable defense" is a defense that 'fairness and justice demands a certain outcome' despite perhaps that a statute provides that a different outcome is possible.

An example of a defense of laches could be where someone builds a house over his property line, and the other property owner knows about the building and the property line but does nothing about it for many years before suing his neighbour for building the house over the property line. Normally, the law would require that the defendant, i.e. person who built on property that did not belong to him, remove the unlawful structure. Nevertheless, the defendant could possibly assert "laches" as a defense, because the delay in bringing the lawsuit was unreasonably long and the delay prejudiced him, as the house had already been built for many years and he was living there peacefully with his young family. If the aggrieved party would have not waited so long to make its complaint, all the while knowing full-well that the defendant was building across the property line, the defendant could have stopped construction before completion, and avoided much expense and hardship. As such, a party claiming laches must show both unreasonable delay and prejudice.

Laches in Trademark Disputes

In the context of traditional trademark disputes, the doctrine of laches can be asserted and is sometimes successful. For example, in *Eat Right Foods, Ltd v. Whole Foods Mkt., Inc.*, No. C13-2174, 2015 U.S. Dist. LEXIS 63578 (W.D. Wash. May 14, 2015), the US District Court for the Western District of Washington found that laches barred the plaintiff's claim over Whole Foods' alleged infringing use of the EATRIGHT mark. The Court noted that since there was no federal limitation period for trademark infringement actions, the Court would look to state law, where a 3 year limitation period applied for trade name infringement. The Court noted that the plaintiff allowed the defendant to use the infringing mark for 3 years before demanding that it cease, and another 3 years before it filed suit and that this delay was unreasonable. The Court also noted that the defendant, Whole Foods, during this long period of unreasonable delay, was prejudiced. It had invested a significant amount of time and money and had heavily promoted its EAT RIGHT AMERICA diet. Accordingly, the Court found that since unreasonable delay and prejudice was found to have existed, and since the closest analogous limitation period had expired, the plaintiff's claim for trademark infringement was barred due to the doctrine of laches. In other words, it was unfair to bring a claim so late in the game, after the defendant had

already been using it with the plaintiff's knowledge for so long, and after the defendant had invested in its brand.

Laches in Domain Name Dispute Court Cases

Laches is also an available defense in domain name dispute court cases, at least in the United States. For example, in *Roca Labs, Inc. v. Boogie Media, LLC*, Case No. 8:12-cv-2231 (M.D. Fla. Apr. 19, 2013), the Court noted that federal trademark and cybersquatting statutes do not contain a limitations period; rather laches principles apply. The Court also noted that in determining when a plaintiff's suit should be barred, courts have consistently used principles of laches as developed by courts of equity. The Court made reference to *What-A-Burger of Va. v. Whataburger of Corpus Christi*, 357 F.3d 441, 449 (4th Cir. 2004), which stated that, "Courts use the doctrine of laches to address the inequities created by a trademark owner who, despite having a colorable claim, allows a competitor to develop its product around the mark and expand its business, only then to lower the litigation boom".

Laches in UDRPs

Neither the UDRP (the "Policy") nor the UDRP Rules expresses any position on laches nor is any limitation period provided for. Nevertheless, from the early days of the UDRP laches has quite properly been raised as a defense to UDRP Complaints on the basis of Rule 15(a) of the [UDRP Rules](#) which clearly states that "a Panel shall decide a complaint on the basis of...any rules and principles that it deems applicable". The first UDRP case where laches was given serious consideration by the panel was *Bank United Corp. and Bank United v. BuildPro Communications* (NAF, September 19, 2000), and concerned the disputed domain name, BANKU.COM. Although the majority, consisting of the Hon. Charles K. McCotter, Jr. and the Hon. Theodore R. Kuferman, held that the domain name should be transferred, the dissenting panelist, Hon. James A. Carmody, came to an entirely different conclusion, and expressly ruled on laches:

"I respectfully dissent from the Decision of the majority of the Panel for several reasons. First of all, the Respondent registered the domain "BANKU.COM" on February 20, 1997, nearly three and one-half years prior to the commencement of this proceeding. ICANN UDRP proceedings are, within the structure of specific Policy provisions, essentially equitable in nature due to the types of relief available. I would hold that Complainant sat on its rights for too long to be entitled to relief from this Panel. Such a delay of claim assertion constitutes the equivalent of laches in the fast-moving world of the Internet."

As can readily be seen, the dissenting panelist clearly recognized that the UDRP was essentially equitable in nature; i.e. the Policy is a framework for providing equitable remedies such as transfer or cancellation of domain names based upon a three-part test designed to determine whether or not a particular registration is fundamentally, "fair" or "unfair. This is the essence of equity.

The Rejection of Laches as a UDRP Defense

Nevertheless, with a handful of notable exceptions, laches has not been successfully asserted by many respondents to-date. Despite what appeared to be a promising dissent in the BANKU.COM case, laches or its equivalent has largely been rejected by most panelists. The latest WIPO Consensus View [\[4\]](#) describes the basis for this rejection as follows:

"Panels have widely recognized that mere delay between the registration of a domain name and the filing of a complaint neither bars a complainant from filing such case, nor from potentially prevailing on the merits."

Panels have noted that the UDRP remedy is injunctive rather than compensatory and that a principal concern is to halt ongoing or avoid future abuse/damage, not to provide equitable relief. Panels have furthermore noted that trademark owners cannot reasonably be expected to permanently monitor for every instance of potential trademark abuse, nor to instantaneously enforce each such instance they may become aware of, particularly when cybersquatters face almost no (financial or practical) barriers to undertaking (multiple) domain name registrations.

Panels have therefore declined to specifically adopt concepts such as laches or its equivalent in UDRP cases.

Panels have however noted that in specific cases, certain delays in filing a UDRP complaint may make it more difficult for a complainant to establish its case on the merits, particularly where the respondent can show detrimental reliance on the delay."

In the earliest case cited by the WIPO Consensus Views 3.0 in support of the above, [The Hebrew University of Jerusalem v. Alberta Hot Rods](#), WIPO Case No. D2002-0616 (October 7, 2002), the three-member Panel rejected laches despite the respondent's claim that the complainant had waited over 5 years to claim a right to the disputed domain name, ALBERTEINSTEIN.COM. The panel recognized that although laches 'was a well-established equitable defense generally', the remedy available under the UDRP is "not equitable" in nature at all, but rather brought pursuant to the Policy which is part of the domain name Registration Agreement. As such, and particularly since there is no "limitation period" as part of the Policy, the panel held that "the defense of laches has no application". In essence, the panel in ALBERTEINSTEIN.COM was treating the UDRP as a 'complete code' which did not permit extraneous notions of "fairness" to come into play, and this notion ultimately found its way into the Consensus View and has been repeatedly upheld by numerous panels, seemingly without any critical reappraisal of its underlying assumptions.

One of the cases frequently cited in support of this view that laches is inapplicable is [Mile, Inc. v. Michael Burg](#), WIPO Case No. D2010-2011, concerning LIONS DEN.COM. The three-member panel consisting of W. Scott Blackmer, David H. Bernstein, and David E. Sorkin, noted that the respondent had specifically stated that; "At some point, a domain name registrant is entitled to quiet enjoyment of his domain name, free from the fear that a trademark owner can take it from him by a UDRP". The panel also recognized that both parties were in the United States, "where courts recognize the equitable doctrine of laches, which can result in the dismissal of a complaint for undue delay in asserting legal claims". But the panel further noted that "in the United States, the defense of laches typically bars the recovery of damages incurred before the filing of a lawsuit, and courts have concluded that the rationale behind the doctrine of laches does not militate against injunctive relief in a trademark action that seeks to avoid future confusion in the marketplace".

Is this panel's view correct that 'courts don't allow laches to prevent injunctive relief, but rather only uses laches to stem damages caused by inexcusable delay'? In the case of [Abraham v. Alpha Chi Omega](#), 708 F.3d 614, 627 (5th Cir.), cert. denied, 134 S. Ct. 88 (2013), the appeals court apparently came to a different conclusion.

The *Abraham* case involved a manufacturer of wooden panels engraved with fraternity and sorority emblems. The defendant, Thomas Kenneth Abraham, founded his business, Paddle Tramps, in Lubbock, Texas in 1961 and began selling its engraved paddles by catalogue and via wholesaling to college bookstores. Paddle Tramps continued to sell almost exactly the same products it had been selling in the 1960s via catalogue and college bookstores after the creation of its website in 1997. Abraham invested heavily in equipment, advertising, and employees. He had to completely rebuild his business three

times — once after a fire in 1966, then after a tornado in 1970, and still again after another fire in Paddle Tramps's manufacturing plant in 1980. In 1990, 29 years after Abraham founded Paddle Tramps, the Greek Organizations contacted him for the first time about licensing to which Abraham did not respond. Further demands were made to Abraham over the next 13 years. Finally, in 2007, the Greek Organizations sued Abraham. Ultimately, the United States Court of Appeals for the Fifth Circuit found in favour of Abraham in part, and the Supreme Court of the United States refused to hear an appeal.

The appeals court found that Abraham's intent was not to capitalize on the Greek Organization's goodwill in bad faith and that he never passed himself off as the Greek Organizations. Rather, his intent was to service fraternities and sororities, and he had been doing so since 1961. Furthermore, the appeals court found that the Greek Organization's lengthy and inexcusable delay in bringing suit caused Abraham "undue prejudice", as "had the Greek Organizations brought suit earlier, Abraham may not have rebuilt his business after the fires or tornado and may not have invested millions of dollars into the business".

The court also made the critical holding that "*a finding of laches or acquiescence may bar injunctive relief if the trademark owner conducted itself in a way that induced the infringer's reliance or if an injunction would result in substantial prejudice to the infringer*". The court noted that there is "considerable discretion in fashioning an appropriate remedy for infringement" and the court, therefore, upheld the lower court's refusal to enjoin Abraham from continuing to sell certain of his products since he would otherwise be prejudiced as a result of his considerable investment in his business due to the trademark owner's delay.

Accordingly, it seems that the fundamental assumption in the *Mile, Inc.* panel's reasoning, i.e. that 'courts won't invoke laches to prevent injunctive relief in a trademark action', may be incorrect. Moreover, the WIPO Consensus View's position (which relies in part upon the panel's position in *Mile, Inc.*, namely that 'the UDRP remedy is injunctive rather than compensatory' and that 'the principal concern is not to provide equitable relief'), appears equally incorrect as well. First, the fact that the UDRP offers no compensation is wholly irrelevant to the analysis, as even within the context of injunctive relief, equity still maintains a role, as shown in *Abraham*. Second, the entire notion of equitable relief generally is premised on the existence of a legal regime which does not *specifically* provide for relief based upon inexcusable delay and prejudice. Accordingly, equity figures in the 'complete code' of the UDRP, just like any statutory regime. There is therefore simply no principled basis for excluding the doctrine of laches from the UDRP.

Nor is there any practical reason for excluding laches from the UDRP. The WIPO Consensus View states that "trademark owners cannot reasonably be expected to permanently monitor for every instance of potential trademark abuse, nor to instantaneously enforce each such instance they may become aware of", and thereby purports to deny laches as an available remedy. However, making laches available as a defense in no way necessarily disentitles a complainant to a remedy merely as a result of delay, since delay alone, even if inexcusable, does not form a basis for a successful defense of laches absent the equally important aspect of 'prejudice'. Therefore, if a complainant takes 15 years to bring its complaint but the respondent is unable to show any undue prejudice, such as the substantial investment and reliance which was evident in *Abraham*, laches will not succeed as a defense to a UDRP complaint. Moreover, it will likely only be in exceptional circumstances where a respondent will be able to show such undue prejudice while at the same time having 'clean hands' (as is also a requirement for laches, as per *Abraham*), and thereby succeed in avoiding transfer or cancellation.

While the WIPO's Consensus View helpfully attempts to distill the "consensus views" of UDRP panelists on numerous issues of interpretation and implementation of the Policy, it sometimes has to be revised based upon evolution in thinking amongst panelists or based upon further examination and study of important legal principles. For example, the

interpretation of the UDRP known as 'Retroactive Bad Faith' was included in the WIPO Consensus View 2.0 but has since been removed from the updated WIPO Consensus View 3.0 due to it having been discredited as a valid interpretation of the UDRP [5]. Accordingly, when the WIPO Consensus View states that 'laches is not an appropriate defense for the UDRP', it is important to treat this proposition critically and not take for granted that it is either entirely accurate or carved in stone. Indeed, [Version 3.0](#) now states [6] in an arguably misleadingly fashion, that "Panels [have] declined to specifically adopt concepts such as laches or its equivalent in UDRP cases" when in fact, many panels have continued to seriously consider laches from the very beginning of the UDRP, and it is arguably the Consensus View itself which is holding back panelists from quite appropriately and justifiably allowing the defense of laches to be considered in appropriate circumstances.

The Persistent Recourse to Laches

Notwithstanding the frequent holding by panels as to the purported 'inapplicability of laches' (often relying upon the guidance from the Consensus View), it has nevertheless persisted in making its appearance in UDRP decisions. Panelists have consistently acknowledged laches as a defense, albeit mainly in conjunction with other established defenses under the Policy. In [True Value Company v. John Hills / Internet Locations](#), NAF Claim Number: FA1508001633289 (September 25, 2015), the panelist, the Hon. Karl V. Fink (Ret.) found that even if the doctrine of laches is not an accepted defense under the Policy per se, it nevertheless "supports the denial of relief for Complainant". Similarly in [Alan M. Peters / Can Do Canines v. Marilyn Mathis / Can Do Canines](#), NAF Claim Number: FA1503001611655 (May 12, 2015), panelist Nathalie Dreyfus acknowledged that while the doctrine of laches is not by itself a defense under the Policy, she nonetheless "considered the doctrine of laches as evidence of Respondent in its considerations of the elements of the Policy". In [City Bank v. Domain Admin / Inavit, Inc.](#), NAF Claim Number: FA1406001564337 (June 21, 2014), the panel again held that "delay should be taken into account" when evaluating legitimate interest and bad faith, but declined to allow it to be a stand-alone defense under the Policy. In [Novartis AG v. Name Administration Inc. \(BVI\)](#), NAF Claim Number: FA1403001548210 (April 24, 2014), the three-member panel, which included James Carmody as chair (the same panelist who 14 years earlier in [BANKU.COM](#), supra, had issued the dissent in favour of laches), stated (while acknowledging the case law that stated that laches is not a defense itself under the Policy), that "the Panel would also find that the equitable doctrine of laches militates in favor of the denial of relief for Complainant, since "any business disruption or confusion was either non-existent or di minimis, else Complainant would have taken action in a more timely fashion".

Accordingly, the WIPO Consensus View 3.0 (and its earlier incarnation for that matter), appears to significantly misrepresent the actual consensus — it makes it appear as though laches, or any laches equivalent, has no place whatsoever in the UDRP, apart from 'considering delay within the rubric of legitimate interest and bad faith'. But as shown above, that is not really the case. Panelists have tended to acknowledge laches or its equivalent, and in some cases, have accepted it as a 'stand-alone defense' in the UDRP. One case which comes close to outright adopting laches as an equitable defense is [Twin Lakes Telephone Cooperative Corporation v. DNS ADMIN / BEST WEB LIMITED](#), NAF Claim Number: FA1704001725012, where the panel consisting of John J. Upchurch (chair), Hon Carolyn Marks Johnson, and the Hon. Neil Brown, Q.C., stated that, "the 12 year delay between Respondent's registration of the domain name and the bringing of this action presents equitable grounds for invoking estoppel as a potential defense to this untimely Complaint", but the panel at the same time also softened its approach by implicitly adopting delay as a defense only insofar as it "draws into serious question Complainant's

assertion of Bad Faith", thereby apparently avoiding the panel's natural conclusion that laches is indeed appropriate and legitimate as a stand-alone defense.

This was in contrast to the case of [The New York Times Company v. Name Administration Inc. \(BVI\)](#), NAF Claim Number: FA1009001349045, where the Panel expressly stated that;

"the doctrine of laches should be expressly recognized as a valid defense in any domain dispute where the facts so warrant. Prior decisions rejecting the applicability of the doctrine due to the failure of its express recognition in the UDRP Policies appear to be an unsound basis for ignoring the potential defense".

Crucially, this panel consisting of the Hon. Ralph Yachnin (Ret.), James Carmody, and Prof. Darryl C. Wilson, unanimously stated as follows:

"While the Panel recognizes that the UDRP is administrative in nature, the practical effect of the proceeding is to provide equitable relief to the successful party. Thus, if equitable relief is the outer extent of the remedy available equitable defenses should also be considered in evaluating the whether any relief should be forthcoming.

*In the instant proceeding **the Respondent emphasizes on numerous occasions that it has held the domain name and used it in connection with its website offerings for in excess of six years and rightfully posits the question of what should be made of the fact that the Complainant has done nothing during that time despite claiming that its development of the identical trademark and subsequent use predates that of the Respondent.***

...

Where such a Complainant fails to police its claimed mark and does nothing for a substantial time while a Respondent develops an identical domain name for its own legitimate purposes, laches should bar that Complainant from turning a Respondent's detrimental reliance to its own unjust benefit."

[emphasis added]

Accordingly, this Panel got the issue exactly right: a) the UDRP is *all about* equitable relief, so laches should not be capriciously excluded; b) a Complainant's failure to take action in the face of investment and development by a respondent surely must be taken into account; and c) just like in court, laches can apply where there has been an unreasonable delay and a detrimental reliance. Sure, laches in and of itself must by necessity work in combination with a legitimate interest and/or good faith, and the two will necessarily complement each other, but there is no justiciable reason for disallowing laches, period.

How Laches Should be Applied

A great example of how laches ought to operate in the UDRP is demonstrated in the case of [Craiglist, Inc. v. Craig Solomon Online Services](#), NAF Claim Number:

FA1205001445057. Here, the panel (consisting of James A. Carmody, G. Gervaise Davis III, and the Hon. Bruce E. Meyerson), adopted laches as a defense and did so even when they clearly could have instead dismissed the case based upon 'legitimate interest' alone.

The Craiglist case involved a domain name registered in 2003 which was subject to a UDRP brought in 2012. The panel expressly and correctly acknowledged that "laches is an equitable defense that has been held to apply in actions to enforce trademark rights.

[Hubbard Feeds, Inc. v. Animal Feed Supplement, Inc.](#), 182 F.3d 598, 601 (8th Cir.1999)"

and explained that "laches applies when a claimant inexcusably delays in asserting its claim and thereby unduly prejudices the party against whom the claim ultimately is asserted. [Ray Commc'ns, Inc. v. Clear Channel Commc'ns, Inc.](#), 673 F.3d 294, 300 (4th Cir. 2012)".

The panel went on to thoroughly consider laches and expressly concurred "with the decision in *N.Y Times Co.* case, *supra*, where the panel ruled that that laches is 'a valid defense in any domain dispute where the facts so warrant'". The panel also referenced [*Professional Rodeo Cowboys Ass'n, Inc. v. Alternative Advertising Concepts, Inc. / Kenneth Forman*](#), FA 1440736 (Nat. Arb. Forum June 26, 2012) [7], which noted, as set out above, that laches has in principle been long-applied in the UDRP despite not being expressly recognized:

While the doctrine is not expressly recognized as a defense in UDRP proceedings, the principle has long been applied in many cases even when the language has not. See Square Peg Interactive Inc. v. Naim Interactive Inc., FA 209572 (Nat. Arb. Forum Dec. 29, 2003) ("Although laches by itself is not a defense to a complaint brought under the Policy, Complainant's delay in seeking relief is relevant to a determination of whether Respondent has been able to build up legitimate rights in the Domain Name in the interim, and whether it is using the Domain name in bad faith."); see also Meat & Livestock Comm'n v. Pearce, D2003-0645 (WIPO Oct. 27, 2003) ("Although laches is not a defence in itself under the Policy, the absence of any complaint over a long period of time in which domain names are in active use can suggest that such use does not give rise to a serious problem.")

The panel in *Professional Rodeo Cowboys*, *supra* also called out the erroneous Consensus View, as followed by numerous panels such as in *Mile, Inc.*, *supra*, for carrying on with the canard that 'the UDRP does not and should not provide equitable relief';

The arguments against the application of laches in UDRP proceedings has frequently been based on formality more than reality as it is oft-repeated that equitable relief is not part of an administrative proceeding. However the reality is that the UDRP only offers what amounts to equitable relief and there has been a growing recognition and willingness to expressly consider laches as an equitable defense in a proceeding where equitable relief is the only possible remedy. Furthermore laches is a well-recognized defense in trademark law in the United States where both parties reside. In N.Y. Times Co. v. Name Admin. Inc. (BVI), (Nat. Arb. Forum Nov. 17, 2010), the panel expressly recognized laches as a valid defense where the Complainant was a sophisticated entity that had been in business for a substantial period of time and had registered several trademarks and domain names, and the Complainant stood by without explanation and watched the Respondent actively build a business using the disputed domains that allegedly included its protected marks for more than six years.

The panel on Craigslist, *supra*, then invoked laches and dismissed the Complaint:

In this matter, the Complainant claims to have been using its marks for several decades although it only sought registration in or around 1996. Complainant claims to have maintained an active Internet presence and stated that it "persistently" and "consistently" policed its marks. However, Complainant failed to offer any explanation for not contacting Respondents for fourteen years, until 2010, or bringing a UDRP proceeding until 2012. Complainant was well aware that others sold tickets to its events and there is no indication that Complainant was not aware of Respondents as well, especially in light of Respondents' notoriety as the leading ticket reseller to Complainant's events. As the panel in the N.Y. Times Co. case stated when a Complainant fails to act for a substantial time while a Respondent develops an identical domain name for its own legitimate purposes, "laches should bar that Complainant from turning a Respondent's detrimental reliance to its own unjust benefit." See also Hinkley Lighting, Inc. v. Tucows.com Co., (Nat. Arb. Forum May 27, 2011) (panel recognized laches where complainant failed to take action for fifteen years).

What is particularly interesting in *Craiglist, supra*, other than that it thoroughly rebutted the incorrect and misleading purported "Consensus View", is that the panel could have used 'legitimate interest' alone to find for the respondent, i.e., the panel could have used the same facts to show that the respondent had a legitimate interest as a result of operating a bona fide business in association with the domain name prior to notice of the dispute. But the panel quite rightly found that laches provided the most fitting and appropriate analysis for this particular case, and therefore proceeded to harness laches for the dismissal, rather than purposefully avoiding it just because it is supposedly "not an available defense" according to the Consensus View and past panels who have taken that misleading and incorrect determination for granted without any critical thought.

Moreover, the panel in *Craiglist, supra*, lucidly expressed the most confounding aspect of the rejection of laches by the Consensus View and by panels attempting to follow it, namely that merely repeating that 'laches does not apply', does not make it so, nor does it provide any principled justification for its rejection. It is clear that laches is a well-established principle that need be recognized by panels pursuant to Rule 15, and the "growing recognition and willingness to expressly consider laches as an equitable defense in a proceeding where equitable relief is the only possible remedy" should not be stymied by a Consensus View which is effectively a self-fulfilling prophecy and which provides no sound basis for the rejection of laches.

A Re-examination of Laches is Called For

Indeed, there have already been previous express calls for a re-examination of laches. In an article in *Managing Intellectual Property*, dated November 24, 2010 — over 7 years ago — the author who is also a UDRP panelist, wrote , "[Laches Defense Now Possible in UDRP](#)" and noted that "it was time to look at the idea of allowing delay or laches as a defense" as a result of "disturbing delays...in bringing some UDRP cases". He also noted therein that the *NY Times* case, *supra*, established that laches was a viable defense. But that was 7 years ago, and in the interim, despite the *NY Times* case and others, the WIPO Consensus View did not retreat from its conclusion that laches was simply and inexplicably, "not an available defense" — rather, it went so far as to remove any mention of it even catching on as a defense in its most recent version, as aforesaid. Moreover, panelists who properly strive to follow established Policy interpretations are in a conundrum, as on one hand, many naturally are inclined to accept laches as an appropriate and viable defense just as it is in any other legal proceeding, but on the other hand, respect and attempt to adhere to the guidance provided by the Consensus View. Various panels have found that the UDRP is indeed an equitable proceeding and that the equitable defense of laches is entirely appropriate to UDRP jurisprudence, but have recognized that this viewpoint has been significantly thwarted by the Consensus View. It is past time for laches to assume its natural and rightful place in the UDRP. As we have seen above, the Consensus View, as a living document, is not cast in stone, and its authors have shown a willingness to revise and update it where appropriate.

After 18 years of the UDRP, the implication of substantial and prejudicial delays must no longer be ignored or sidelined. As time goes on, we will see more and more cases of domain names registered 15, 20, 25 and more years ago that are attacked by a trademark owner who stood idly by while a respondent built a business around the domain name. The prospect of a 20+ year delay in bringing a complaint may have been a remote possibility back in 1999 when the UDRP was launched, but today in 2017, it is not a remote possibility at all, but rather a very real and existing fact, as easily demonstrated by looking at the recent case of *Knud Jepsen A/S v. Rick Schwartz, Virtual Dates Inc.*, WIPO Case No. D2017-0679 (June 20, 2017). The complainant brought the UDRP Complaint nearly 20 years after the respondent registered the disputed domain name, QUEEN.COM, on August 22, 1997, and the respondent had in the meantime built a business around it.

If laches squarely fits the facts, then there is no reason that it should not be applied. Surely if there is good evidence that a complainant actually acquiesced to a respondent's use over a long period of time, and the respondent was prejudiced by such delay, a UDRP panel should not only find that a legitimate interest exists, but also find that there was an unreasonable delay and a detrimental reliance, i.e., laches, just as in *Abraham* and in *Craigslis*, *supra*. Fair-minded panelists know very well that an unexplained and unreasonable delay that prejudiced the respondent is, and must be, a valid defense. Moreover, the fact that it may be advanced in conjunction with other defenses is no reason to treat it as either unnecessary or subsumed, as it has merit on its own and may be effectively advanced as in *Craigslis*, *supra*.

When the ICANN Rights Protection Mechanisms Working Group begins its consideration of the UDRP in the next year or two, the applicability of laches will certainly be a matter for discussion. The UDRP was created to bring equitable relief to trademark holders, but it should not be monopolized as domain name owners are entitled to fairness too. A domain registrant who has made a consistent use of a domain name for many years should at some point be confident that based upon this longstanding use, his or her rights will be equitably protected through the doctrine of laches. Formalizing the proper role for the concept of 'delay' in UDRP jurisprudence will remove a source of inconsistency in UDRP practice and will improve the equitable treatment of all parties to the UDRP.

Trademark owners and the IP bar have very little to fear from the applicability of laches. As can be seen from the *Craigslis* case, *supra*, a successful laches defense will nearly invariably coincide with a successful case being made for a respondent's rights and legitimate interest. In this manner, the application of laches does not present a substantial change in likely outcomes of UDRP cases but rather informs the route that the panel is entitled to take to get there. If a respondent has a right or legitimate interest arising from longstanding use of a domain name in connection with a bona fide business that was created while the complainant acquiesced, then the respondent will also likely have a case under the doctrine of laches. But where a respondent cannot meet the onerous test of demonstrating laches, mere delay will not serve to avoid a transfer or cancellation, and a complainant trademark owner, even a slow one, will not generally lose its case. As such, the embrace of laches is best seen as bringing a more robust, legally sound, and intellectually honest analytical framework to the UDRP, rather than changing it in any substantial way.

[1] As of January 1, 1999, there were reportedly only 4,038,744 TLD's registered (See; <https://www.zooknic.com/Domains/counts.html>) . By comparison, as of March, 2017, there were reportedly over 197 million gTLD domain names registered (See; <https://www.icann.org/resources/pages/cct-metrics-domain-name-registration-2016-06-27-en#5.5>)

[2] See [WIPO Consensus View 3.0](#) at Section 4.17.

[3] <http://www.dictionary.com/browse/laches>

[4] See "WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition".

[5] See *Etsy, Inc. v. Domain Administrator / Portmedia Holdings Ltd.*, Claim Number: FA170001753224 (November 27, 2017) ("Complainant's arguments find no support within any exception of the now largely-discredited *Mummy/Octogen* line of decisions"); and also see WIPO Consensus View 3.0 at Paragraph 3.2.1, "this so-called retroactive bad faith registration [approach] has not been followed in subsequent cases".

[6] [Version 2.0](#) previously acknowledged that "a small number of panels have also begun to acknowledge the possible applicability, in appropriate and limited circumstances, of a defense of laches under the UDRP where the facts so warrant".

[7] Panelists, The Honourable Neil Anthony Brown Q.C., Honorable Charles K. McCotter, Jr. (Ret.), Prof. Darryl C. Wilson, Esq.



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