



ICANN WEBINAR
ON
*THE CURRENT STATE OF THE
Uniform Dispute Resolution Policy
(UDRP)*

Margie Milam, Moderator
ICANN Senior Policy Counselor

10 May 2011

Today's Agenda

Introduction	(5 min)
UDRP Providers	(20 min)
ICANN Compliance	(5 min)
Registrars	(5 min)
UDRP Panelists	(25 min)
Complainants	(10 min)
Respondents	(5 min)
Academics	(10 min)
Q & A	(30 min)

Introduction & Timeline

Feb 2011

- GNSO Council requests Issue Report on the Current State of the UDRP

Today

30 May 2011

- Experts share their views on the UDRP
- Public Comment Forum to be opened on the Preliminary Issue Report

June 2011

July 2011

Aug 2011

- UDRP Session @ ICANN Singapore
- Final Issue Report published
- GNSO Council to decide whether to commence policy development process on the UDRP

The UDRP Provider Perspective

Erik Wilbers
World Intellectual
Property Organization

Kristine Dorrain
National Arbitration Forum

Dennis Cai
Asian Domain Name
Dispute Resolution Centre

Tereza Bartoskova
Czech Arbitration Court
Arbitration Center for
Internet Disputes

The UDRP Provider Perspective



Erik Wilbers
World Intellectual Property
Organization



ICANN UDRP WEBINAR

WIPO Observations on
Proposed ICANN Revision of
the UDRP

**10 May
2011**

Erik Wilbers
Director, WIPO Arbitration and Mediation Center

WIPO and the UDRP

- WIPO provided ICANN with the UDRP blueprint in 1999 WIPO Report, after extensive international consultations.
- Always on a non-profit basis, WIPO has:
 - processed some 20,000 UDRP cases
 - created freely available and globally unique UDRP resources, such as the WIPO jurisprudential overview and the WIPO legal index
 - convened annual WIPO Panelists Meetings and UDRP workshops attended by parties and counsel from around the world
- No one has invested more than WIPO in the continuing health of the UDRP – we care about its well-being.
- A fuller WIPO letter of May 6, 2011 has been provided to ICANN for posting, and also made available on the WIPO Arbitration and Mediation Center website (<http://www.wipo.int/amc/en/>).

WIPO View on ICANN UDRP Revision

- The UDRP has been offering an effective solution for trademark owners, domain name registrants, and registration authorities.
- By accommodating evolving norms and practices, the UDRP has proven to be a flexible and fair dispute resolution system.
- With vast DNS growth around the corner and untested new RPMs in development, the time is wrong to revise the UDRP.
- Institutionally stacked, an ICANN revision process would likely end up overburdening and diluting the UDRP.
- Fundamental questions about the business and DNS beneficiaries of cybersquatting must be addressed before targeting the very mechanism intended to address this practice.

WIPO Recommends

- Instead of allowing the UDRP to be placed in the dock, ICANN should transparently address the following issues:
 - the relationship between cybersquatting and the activities, revenues and budgets of DNS actors
 - the incidence of UDRP cybersquatting findings in relation to wider trademark abuse in the DNS overall, with filed UDRP cases merely representing the tip of the iceberg
 - the degree of proportionality between trademark rights enforcement burdens and domain name registration opportunities in the DNS
- WIPO urges ICANN to:
 - recognize the overall positive functioning of the UDRP to date
 - not to add the UDRP to the issues which ICANN has to manage
- A decision process weighted against IP interests will damage the UDRP, and the DNS in the process.
- ICANN revision of the UDRP is a choice, not an inevitability; WIPO counsels against it.

The UDRP Provider Perspective



Kristine Dorrain
National Arbitration Forum

The UDRP Provider Perspective



Dennis Cai
Asian Domain Name
Dispute Resolution Centre

The UDRP Provider Perspective



**Tereza Bartoskova
Czech Arbitration Court
Arbitration Center for
Internet Disputes**

The ICANN Compliance Perspective



**Khalil Rasheed
ICANN Contractual
Compliance Staff**

The Registrars Perspective



Statton Hammock
Registrar Stakeholder Group

The Registrars Perspective

- 1. Current policy does not require that Registrars receive a copy of the complaint**
 - In some cases, Registrars are not provided with the contact information for the disputing parties and are therefore unable to lock down the domain name or send communications to the parties.
- 2. Policy does not contain any provision addressing the necessity of paying renewal fees while a complaint is being adjudicated**
 - If a domain expires during adjudication, registrants needs to be informed that they must renew.
- 3. Nothing in the current policy requires a prevailing party or gaining registrar to act within a certain time frame after a decision, that would require a transfer, is made**
 - Registrars must rely on prevailing party to proceed with the transfer. Sometimes that takes place months after a decision, sometimes, not at all. Gaining registrars have different processes which may take time. Also, prevailing parties often do not provide sufficient information to effectuate transfer (Nameservers, gaining registrar, etc.).

The Registrars Perspective

4. **The meaning of “Maintaining the Status Quo” in Section 7 of the Policy is not clear**
 - No explanation of “Legal Lock” mechanisms and when they go into effect or when they should be removed.
5. **Policy does not provide guidance on what a registrar is to do if a claim is stayed or suspended**
 - Is the legal lock to be removed or remain in place?
6. **Policy does not address Privacy and Proxy Registrations or require complaining party to amend complaint once infringing party identified**
 - There is no provision to address the “conflict of laws” problem.
7. **No explanation on what a registrar should do when a UDRP decision conflicts with an injunctive order issued by a court of local jurisdiction**
8. **Policy does not require registries to communicate to registrars when a decision has been implemented at the registry level**

The Registrars Perspective-

Recommended Changes and Improvements

- 1. Revise Section 7 of the UDRP to explain what is actually meant by “Maintaining the Status Quo”**
 - Describe what a “legal lock” is, when it shall be implemented, when it will be lifted or removed by a registrar and what happens if a case is stayed or suspended.
- 2. Add a new provision which requires the prevailing party to initiate and complete transfer within a specified time. Provide a timeline for gaining registrar to act upon transfer request. Also, add a provision requiring the prevailing party to provide specific information needed for transfer.**
- 3. Add a new provision to address the “conflict of laws” problem**
 - A “superseding authority” clause could be added deferring UDRP process to law of applicable jurisdiction. Or, in the alternative, allow Registrar to keep domain on “legal lock” without violation until all claims are resolved.
- 4. Add a requirement that the arbitrator provide the prevailing party contact information with the UDRP decision so that registrar can verify that legal counsel has authority to request transfer on behalf of client**

The Panelist Perspective

**Matthew Harris
Waterfront Solicitors
Czech Arbitration Court**

The Panelist Perspective



Neil Brown
Asian Domain Name
Dispute Resolution
Centre

The Panelist Perspective



James Carmody
National Arbitration
Forum

The Panelist Perspective



David Bernstein
Debevoise & Plimpton LLP
WIPO

The Panelist Perspective



Tony Willoughby
Rouse Legal
WIPO

The Complainant Perspective

Aimee Gessner
BMW

UDRP Observations of Complainants/Counsel

Qualifications of Aimee Gessner:

Senior Trademark Counsel at the BMW Group

Responsible for the automotive brands BMW, MINI, Rolls-Royce



Over 11 years experience in domain name portfolio management and rights enforcement issues

Participating today as:

- A representative of a brand owner,
- A UDRP user and in-house counsel, and
- A WIPO Advanced Domain Name Workshop faculty member

UDRP Observations of Complainants/Counsel

The UDRP has proven very useful:

- Will not solve all of a trademark owner's problems but it is a simple and cost-effective solution to clear cases of cybersquatting
- The UDRP definition of "cybersquatting" is widely recognized and sets a clear standard for prohibiting and for sanctioning certain types of conduct
- Has grown to be a stable and predictable system, due to a very large body of published decisions, indexes and legal commentaries
- The policy sufficiently balances the rights between Complainants and Respondents

Main limitation of the UDRP:

- Cannot by itself address cybersquatting effectively because the UDRP is not a curative or a deterrent mechanism
- The only consequence for a cybersquatter is the potential loss of their domain name
- Other remedies which could curb cybersquatting and prevent repeated abuses would be welcome

UDRP Observations of Complainants/Counsel

The real problem, however, is not the UDRP:

Other practices since the launch of the UDRP in 1999 have contributed largely in encouraging cybersquatting: e.g.

- Domain name tasting
- Increasing domain parking sites / pay per click sites
- Drop-catching
- Use of privacy registration services to hide identities of cybersquatters
- Establishment of bogus “registrars” that have no purpose other than to cybersquat

Summary:

- The UDRP is working fairly and efficiently for its intended purpose
- There are many other causes today for the steady increase in cybersquatting which ICANN should rather review
- Brand owners are concerned at this time with what the expansion of the DNS will cause in terms of cybersquatting and other forms of rights infringement
- Unwise to review and possibly compromise the UDRP system at such a critical time

The Complainant Perspective



Paul McGrady
Greenberg Traurig



Inefficiencies

Problem: Multiple UDRPs against the same Respondent

Solution: Upon filing, Registrars provide list of all domain names in Respondent's account and any related accounts e.g. same email address or credit card. All domain names locked down and Complainant given 5 days to amend complaint.

Problem: WHOIS record modifications after filing but before commencement lead to unnecessary deficiencies and amendments.

Solution: Upon filing, all domain names mentioned in the complaint are to be locked down with the WHOIS information showing at the time of filing.

Inequalities

Problem: UDRP proceedings costs brand owners millions of dollars a year and costs the squatter community almost nothing.

Solution: Loser pays model. Loser pays provider fees as well as a set \$5000 attorneys' fees amount to the other side.

Problem: On rare occasion, a UDRP complaint is filed with absolutely no rational basis (as opposed to one filed with a basis but not a strong enough basis to win) and a finding of Reverse Domain Name Hijacking is or should be found.

Solution: Loser pays model. Loser pays provider fees as well as a set \$5000 attorneys' fees amount to the other side. Additionally, clarify Policy to make clear that a respondent need not ask for a RDHJ finding in order for a panelist to find one.

Unfairness

Problem: “and” - conjunctive bad faith requirement allows gaming, especially against filers of ITU applications.

Solution: Modernize the UDRP to mimic UK and AU policies by replacing “and” with “or”

Problem: Respondent gets to control appeals jurisdictions through its choice of residency (real or false) and its choice of registrar.

Solution: Make the judicial district where ICANN’s Headquarters are located a third choice.

The Respondent Perspective

John Berryhill, PHD

The Academic Perspective



Konstantinos Komaitis
University of Strathclyde

The Academic Perspective



Cédric Manara
EDHEC

Evidence ↔

Time granted for review

- *Idem est non esse et non probari*
- UDRP is designed for quick decisions
 - 5,000 words limit
 - 14 days to decide
 - Online
- Speed does not (always) allow an efficient review of documentary evidence
 - Lack of time
 - Number of documents

Evidence ⇔

Increasingly distorted view?

- *“The Panel shall determine the admissibility, relevance, materiality and weight of the evidence”* [Rules, 10.d]
- Rules written in 1999, when there were no personalized web pages
- Web content now increasingly depends on user location
 - Search tool results
 - Parking pages, etc.
- Suggestion: Education of panelists?

Evidence ⇔

Possible forgery of documents

- Parallel trends:
 - Electronic proceedings
 - Photoshop banalization
- Complainant/Respondent (only)
 - *“certifies that the information contained in the Complaint/Response is to the best of Complainant’s/Respondent’s knowledge complete and accurate”* [3.b(xiv) / 5.b(vii)]
 - No sanction
- Suggestion: Post evidence online
 - More accountability of Parties/Counsels
 - Enable crowdsourcing control



Questions?

*Please submit questions in chat
for Moderator to pose to panelists*