WIPO Conference: 10 Years UDRP
– What’s Next?

October 12, 2009

Theme 1.2: Key Issues for WIPO Panelists – Forks in the Road – Reflections on the UDRP and Beyond

Fair Use

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The Free Speech Fork – No Consensus (Yet?)

WIPO Overview of WIPO Panel Views on Selected UDRP Questions

Decision-making authority under the Uniform Domain Name Dispute Resolution Policy and Rules (UDRP) lies exclusively with the appointed panels. To assist awareness of their views on certain questions that commonly arise in proceedings under the UDRP, the WIPO Arbitration and Mediation Center has produced the following informal overview of panel positions on key procedural and substantial issues. Decision references supporting each line of opinion are included, with over 100 decisions from over 80 different UDRP panelists listed.

While some of the listed issues arise only infrequently, all of them are, or are perceived to be, relevant to the operation of the UDRP. On most of these issues, consensus or clear majority views have developed. Certain other questions continue to attract a diversity of views. The Center’s identification of questions and evaluation of opinions is based on the 7,000 UDRP cases it has administered through February 2005. Broad information on all views is available from the Center’s online Legal Index of WIPO UDRP Panel Decisions (http://arbiter.wipo.int/domains/search), as well as from the full posting of all decisions (http://arbiter.wipo.int/domains/decisions).

This overview is created in recognition of the need that has been expressed to identify, as much as possible, consensus among UDRP decisions, so as to maximize the consistency of the UDRP system. It should be understood that, with UDRP decisions covering a multitude of facts and arguments, genuine differences of opinion may be difficult to avoid on particular issues, all the more so where panelists and parties come from a multitude of jurisdictions. However, it is hoped that this update on the UDRP experience will be found helpful by identifying views expressed by panels and providing decisions which help to put those views in context.
No Consensus Has Emerged

2.4 Does a respondent using the domain name for a criticism site generate rights and legitimate interests?

View 1: The right to criticize does not extend to registering a domain name that is identical or confusingly similar to the owner’s registered trademark or conveys an association with the mark.

View 2: Irrespective of whether the domain name as such connotes criticism, the respondent has a legitimate interest in using the trademark as part of the domain name of a criticism site if the use is fair and non-commercial.
No Consensus Has Emerged

2.5 Can a fan site constitute a right or legitimate interest in the disputed domain name?

View 1: An active and clearly non-commercial fan site may have rights and legitimate interests in the domain name that includes the complainant’s trademark. The site should be non-commercial and clearly distinctive from any official site.

View 2: Respondent does not have rights to express its view, even if positive, on an individual or entity by using a confusingly similar domain name, as the respondent is misrepresenting itself as being that individual or entity. In particular, where the domain name is identical to the trademark, the respondent, in its actions, prevents the trademark holder from exercising the rights to its mark and managing its presence on the Internet.
Criticism Sites

Case No. D2000-0300

Case No. D2000-0190

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Fan Sites

http://www.patbenatar.com

Welcome to PatBenatar.com

Precious Times!
Late breaking news on appearances.

Pat Benatar is expected to be included in VH1 Classic’s rebroadcast of Headline Act! Find out more here!

Case No. D2004-0001

Case No. D2002-0726

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Bridging the Divide

• Lamparello v. Falwell, 420 F.3d 309 (4th Cir. 2005)
• TMI, Inc. v. Maxwell, 368 F.3d 433 (5th Cir. 2004)
• Taubman Co. v. Webfeats, 319 F.3d 770 (6th Cir. 2003)
• Lucas Nursery v. Grosse, 359 F.3d 806 (6th Cir. 2004)
• Nissan Motor v. Nissan Computer, 378 F.3d 1002 (9th Cir. 2004)
• Bosley Med. Inst., Inc. v. Kremer, 403 F.3d 672 (9th Cir. 2005)
• Utah Lighthouse Ministry v. Foundation for Apologetic Info. and Research, 527 F.3d 1045 (10th Cir. 2008)
Bridging the Divide

2.4 Does a respondent using the domain name for a criticism site generate rights and legitimate interests?

There is also some division between proceedings involving US parties and proceedings involving non-US parties, with few non-US panelists adopting the reasoning in View 2.
Bridging the Divide

Sermo.com, Corporate Self-Interest, and the Death of Free Speech

http://www.sermosucks.com/

sermosucks.com

Know more. Know the truth.

Header Design Changed. Message Remains the Same: SermoSucks

Sermo is dying in the light of truth. They are forced to send these dark agents to engage in terrorist activities to silence and sabotage the truth bringers. They are trying to attack free speech by filing a complaint with the World Intellectual Property Organization. In some nifty legal maneuvering they were able to breach the privacy certificate purchased from GoDaddy.com. I could care less if they know who I am! Like they had not already figured that out. They will continue to disparage and defame me as they have already done and I will have my day in court. They are going to be spending a lot of money fighting this and many other legal battles that are on the horizon.

Case No. D2008-0647

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Case No. D2007-1947