

# INITIAL REPORT OF THE WIPO-ICA UDRP REVIEW PROJECT TEAM

(April 17, 2025)



## Executive Summary

- We convened a group of 16 UDRP experts with extensive practical experience as counsel, as panelists, and as parties
- We additionally brought in 28 specific subject matter experts including scholars, panelists, counsel, ccTLD representatives, registrars and registries, registrants, brand owners, noncommercial users, and UDRP Providers
- Based upon the project team's discussions and sessions with subject matter experts, we created a series of survey questions to gather the project team's views on a broad range of UDRP-related topics
- We evaluated the accumulated data from the survey and categorized each topic into a category of "Unanimous Support" or, "Consensus Achievable with Further Exploration"
- We published this Initial Report for broad public comment and will then submit our Final Report to ICANN's GNSO Council for its consideration

## **Introduction**

We are pleased to submit the following Initial Report, on the consultative process of reviewing the UDRP, jointly undertaken by WIPO and ICA along with a project team of UDRP experts, including panelists, party representatives, registrants, and brand owners (the “Review Project”).

ICANN completed its Phase 1 Review of Rights Protection Mechanisms (“Phase 1”) in 2020.<sup>1</sup> Phase 1 primarily covered the Uniform Rapid Suspension system and the Trademark Clearinghouse and took over four years to complete its work. Phase 2 (the “Phase 2 Review”), which has not yet been commenced, is likely far more ambitious since it will review the Uniform Domain Name Dispute Resolution Policy (the “UDRP”), ICANN’s first Consensus Policy, a dispute resolution procedure that has been in effect since 1999 and which has been relied upon to resolve over 125,000 cases and is used every day by trademark owners from around the world to deal with cybersquatting.

The UDRP has struck a careful balance between the interests of trademark owners and registrants and has historically been the subject of much interest, including various proposals for its expansion or reform, often with divergent views among stakeholders. It is anticipated that Phase 2 Review could take far longer and be far more involved and onerous on participants, absent serious efforts to find a more efficient, focused, and practical way forward.

The purpose of the Review Project is to provide ICANN with assistance in finding a more efficient, focused, and practical way forward by providing crucial background information that can help direct the Phase 2 Review. By working with a diverse group of UDRP experts from around the world under the leadership of WIPO and the ICA, we have identified areas of the UDRP where consensus appears to exist – both in terms of suggestions to update the operation of the UDRP, and also in terms of areas where there is agreement not to pursue changes. We have also identified areas where there is no agreement but where further work may be undertaken to attempt to bridge disagreements amongst stakeholders.

We hope that by providing this crucial information garnered through extensive consultation and deliberation from experts with hands-on experience with the UDRP, that ICANN will be able to:

- a) Commence a Phase 2 Review with a clear sense of what may reasonably be accomplished and thereby better direct the work (both in terms of scope and duration) and ICANN’s resources;**
- b) Charter the Phase 2 Review in a manner which prioritizes areas where consensus appears likely;**
- c) Appropriately manage and direct certain topics for which consensus may require specific additional work (e.g., a dedicated work stream); and,**
- d) Consider leaving topics which appear very unlikely to reach consensus out of the Phase 2 Review ICANN work charter and/or defer them to a specialized track.**

We believe that this Project affords ICANN with a unique opportunity to make the Phase 2 Review as efficient and productive as possible by focusing on the achievable, as identified

---

<sup>1</sup> See [Final Report on the Review of All Rights Protection Mechanisms in All gTLDs Policy Development Process](#), dated November 24, 2020.

collectively by a generally representative group of experts with hands-on UDRP experience. We further believe that by appropriately harnessing the information and recommendations in this Draft Report, ICANN can confidently embark on a focused Phase 2 Review that achieves positive results with substantially less effort than would otherwise have to be expended by many stakeholders over many years. We encourage the GNSO to use the Final Report of this Review Project proactively and productively for the benefit of the entire ICANN community, and would be pleased to provide further advice and recommendations as the Council sees fit.

## **Background to the UDRP**

In the late 1990s, WIPO Member States requested the development of recommendations for a uniform approach to resolving trademark-based domain name disputes. Following a robust international process spanning numerous consultations, WIPO produced a Report recommending a process to address cases of trademark “cybersquatting” by domain name registrants across jurisdictions which was adopted by ICANN’s precursor to the GNSO, the DNSO, and which became the UDRP. Since the adoption of the UDRP by ICANN in 1999, and with the benefit of WIPO’s leadership and institutional investment, the UDRP is widely recognized as a unique global success and dispute resolution best practice:

- Over 125,000 domain names have been reclaimed by hundreds of brand owners at WIPO alone from every corner of the world and some 7,000 cases have been dismissed in favor of the registrant (including some 500 where the panel admonished counsel for abuse of process); overall the UDRP is the preferred alternative to cost-prohibitive multi-jurisdictional court litigation.
- Domain Name registration authorities (registries and registrars) rely on UDRP providers to manage trademark-based complaints without being dragged into resource-consuming cybersquatting disputes.
- Nearly 100 country code Top Level Domains (ccTLDs) use the UDRP directly or as a tailored model of a global best practice.

As was stated in an ICANN *Issue Report on The Current State of the UDRP (2011)*:

*“In the last decade, the Internet community has come to rely on the consistency, predictability, efficiency, and fairness generally associated with the [...] UDRP.”*

That is not to say that the UDRP hasn’t attracted some criticism, particularly from registrants, taking issue with various aspects of it and seeking improvements or changes. Observers have also consistently pointed out that the UDRP has played a critical role in preserving, if not creating, the domain name secondary market by its codification of certain protections for registrants.

## **The Review Project, Project Team, and Methodology**

The Internet Commerce Association (ICA) has been a leader in examining the UDRP and raising public awareness of opportunities for improvement, and is pleased to join with WIPO, the acknowledged pioneer and recognized thought leader of the UDRP, in contributing to the discussion and policy review process. Drawing on WIPO’s expertise and experience in

providing the blueprint for the UDRP and also drawing upon ICA's expertise and experience with the UDRP, and in anticipation of the UDRP review planned by the ICANN GNSO Council, WIPO and the ICA believe that to assist ICANN and DNS stakeholders, a similar approach be undertaken to produce a report based on 25 years of experience with the UDRP to identify whether there are high-consensus areas that might lend themselves to policy or practice updates, but equally to identify areas that appear unlikely to result in consensus policy recommendations or which may merit further exploration (in an ICANN working group or otherwise).<sup>2</sup> By assisting the ICANN community in identifying areas of stakeholder agreement and disagreement, it is expected that ICANN's eventual review process will benefit from greater focus and efficiency.

In that spirit, it is hoped that the report of this consultative process assists whatever ICANN processes may unfold.

### **The Project Team**

The project team (the "Project Team"), comprising experts and UDRP stakeholders from around the world, includes:

- Lead faculty for the WIPO Advanced Workshop on Domain Name Dispute Resolution: David Bernstein (United States of America) and Andrew Lothian (United Kingdom);
- ICANN Board member and liaison: Sarah Deutsch (United States);
- Party counsel: Paul Keating (Spain/United States), Jane Seager (France/United Kingdom), Jason Schaeffer (United States), and Marc Trachtenberg (United States);
- UDRP panelists: Shwetashree Majumder (India), Francine Tan (Singapore), Adam Taylor (Ireland), Kiyoshi Tsuru (Mexico), Nicholas Smith (Australia), Jeremy Speres (South Africa), and Deanna Wong Mai Man (Hong Kong, China/New Zealand);
- Domain name registrant: Nat Cohen (United States); and,
- Brand owner representative: Mette Andersen (Denmark).

---

<sup>2</sup> Aware that ICANN's GNSO Council had nevertheless planned a review of the UDRP, [the \[June 2022\] ICANN GAC Hague Communiqué](#) (ICANN 74) noted that:

*"[t]he [Governmental Advisory Committee] received an update on the status of a planned review of the UDRP, and in particular notes reference to section 13.1 of the ICANN Bylaws which calls on and indeed encourages, the Board and constituent bodies to seek advice from relevant public bodies with existing expertise that resides outside of ICANN (notably [ ] WIPO, as author and steward of the UDRP) to inform the policy process, and looks forward to further exploring this provision prior to any review of the UDRP."*

Such approach has also been called for in a letter to ICANN from MARQUES, the European association representing brand owners:

*"ICANN could request the World Intellectual Property Organization as the global leader, which was commissioned in 1998 to develop a solution which became the UDRP, to select and chair this independent expert group."*

The project coordinators are, from WIPO, Brian Beckham, and from ICA, Zak Muscovitch.

We are aware that the above Project Team is a small representative sample and that many other individuals have relevant UDRP and domain name/trademark experience. Nevertheless, we made significant efforts to include a diverse group of individuals whose perspectives were likely to be, to some degree representative of direct participants in the UDRP procedure since we prioritized a smaller group for the sake of efficiency. This effort is independent from ICANN and was not an open-call working group, and above all it was felt that our approach would be an effective way to produce a consensus-based report in a reasonable timeframe.

In recognition of the fact that our Project Team was limited, we additionally invited a number of identified subject matter experts to provide valuable insight and perspective to the Project Team. Those included:

- Scholars: Gerald Levine (author, panelist, and counsel) (United States);
- ccTLD counsel: Nick Wenban-Smith (General Counsel, Nominet) (United Kingdom);
- Experts with recognized institutional knowledge: John Berryhill (United States), Steve Levy (United States), Georges Nahitchevansky (United States), Tony Willoughby, Nick Gardner (United Kingdom);
- Registrar representatives: Chris Patterson (GoDaddy) (United States), Reg Levy and Rich Brown (Tucows) (United States), Owen Smigelski (Namecheap) (United States);
- Registrant representatives: Jay Chapman (Digimedia) and Nat Cohen (Telepathy) (United States);
- Brand owner representatives: Patrick Flaherty (Verizon) (United States, Ireland), and Margie Milam (Meta) (United States), Natalie LeRoy (Meta) (France/United Kingdom);
- Noncommercial user representatives: Konstantinos Komaitis (Atlantic Counsel and Freedom Online Coalition) (Greece), Christine Farley (American University) (United States), Rebecca Tushnet (Harvard) (United States);
- Party Representatives, Nathalie Dreyfus (France) and Cecilia Borgenstam (Sweden);
- UDRP provider representatives: Renee Fossen (Forum) (United States), Ina Ergasheva (CIIDRC) (Canada), Lenka Nahlovska (CAC) (Czech Republic), ADNDRC (invited); and
- Brand enforcement representatives; Caroline Valle (SafeNames) (France), Tim Brown (Com Laude) (United Kingdom), Vincent D'angelo (CSC) (United States), Joe Viviani (CSC) (United States), and Özge Şentürk (CSC) (United Kingdom, Türkiye).

## **Identifying Subjects for Consideration**

Through consultations, deliberations, and review of previous ICANN and community discussions on potential targeted amendments to the UDRP and its overall framework, the Project Team identified the following subjects for potential consideration in an ICANN review of the UDRP, in no particular order:

- Loser Pays, Costs, Damages
- Fee Payment Deadlines
- Reviewing and Reinforcing ICANN's Role in Compliance
- Providing UDRP-related Information for Registrars
- Regulating Complaint Withdrawals
- Clarifying Registrar Verification Procedures
- Identifying Dissenting Panelists
- ICANN Contribution to the UDRP
- Educational Materials
- Mediation
- Laches/Statute of Limitations
- Scope of UDRP
- Name Redaction
- Registrars to Provide Additional Notice
- Appeals Layer
- Changing "and" to "or"
- Supplemental Filings
- Expedited or Summary Procedures
- Remedy: True Cancellation
- Panelist Appointment, Accreditation, and Quality
- Codification of Case Law
- Free Speech
- Decision Format

From this list of subjects, we identified those areas:

- a) Where consensus appears to exist (whether that is a recommendation to make a change, or agreement not to pursue a specific change to the UDRP); and,
- b) Where there is no consensus but where further work may be undertaken to attempt to bridge disagreements amongst stakeholders.

## **Overarching Principles Guiding this UDRP Review Project:**

Over the course of more nearly 25 years and tens of thousands of cases which have given rise to a rich body of case jurisprudence – as demonstrated in the WIPO Overview – the UDRP has proven to be an effective process to quickly, consistently, efficiently, and predictably resolve clear cases of cybersquatting for parties around the world, in a framework of legal certainty.

Any recommendations to update the UDRP framework or its implementation must be considered against this background, in full consideration of the potential implications and their impact on jurisprudence and party expectations – in particular so that the UDRP can continue to

reliably be used with generally predictable results. In recognition of this principle, any policy recommendations should not be made on the basis of outlier cases or views which are unlikely to garner consensus.

While there may be differences of opinion on individual cases, overall it is recognized by the Project Team that the UDRP has generally worked well, and that there is no pressing need or desire to undertake a wholesale revision of its overarching trademark-based framework set out in the UDRP and Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”).

In undertaking the present exercise, and indeed more generally in terms of any review of and recommendations to update the UDRP and its framework, the practical experience-based views of panelists, counsel, parties, and providers should be the primary basis for any such recommendations. Over the course of their nearly 25 years of UDRP experience, practitioners, panelists, and parties in particular, have identified potential areas where improvements to the UDRP could be considered. These are driven in part by the substantially greater importance and value that domain names currently play in the Internet economy compared to their original nascent state and indeterminate potential back in 1999 when the UDRP was first adopted. Similarly, they are driven by the increased frequency of cybersquatting and new methods to abuse domains that did not exist in 1999 when “classic” cybersquatting, namely registering a domain name before a brand could adopt its own corresponding domain name, was more prevalent than today where abusive registrations are often typified by typosquatting, fraud, and phishing.

In addition to hands-on experience, the present effort has also taken account of a number of public resources, including but certainly not limited to, ICANN’s Current State of the Uniform Domain Name Dispute Resolution Policy: Final Issue Report (October 2011), the Charter for ICANN’s Review of All Rights Protection Mechanisms in All gTLDs (March 2016), and the ICANN Staff UDRP Policy Status Report (March 2022).

Mindful of the imperative not to derail the utility of the UDRP which is relied upon daily by brand owners and a range of other DNS stakeholders, the present effort has equally not shied away from suggesting improvements that nearly 25 years of UDRP experience shows could be usefully made to the UDRP and its framework without causing major disruption to the well-established and successful fundamental framework or case law. In this respect, such suggestions are made in full awareness of the fact that some topics, e.g., appeals, were considered but not adopted in the 1999 Final Report of the WIPO Internet Domain Name Process.

Finally, the present effort recognizes that there may be topics identified in which consensus may not be presently possible, but that such topics may nevertheless still warrant future consideration in another dedicated and specialized forum.

In sum:

1. The UDRP has demonstrated itself to overall be an effective and successful procedure for resolving clear cases of cybersquatting. Any perceived faults or inadequacies of the UDRP do not warrant a wholesale revision of the Policy.
2. It is imperative that the consensus approaches to the interpretation and application of the Policy, derived from nearly 25 years of case law, be identified and – unless there is compelling evidence supporting a change which does not destabilize the

procedure and which enjoys consensus support – be maintained so that the UDRP can continue to fairly and reliably be used with generally predictable results.

3. The present UDRP review effort should not be opened up beyond its existing trademark-based framework. The direct and practical experience of panelists, counsel, parties, and providers should be the primary basis for any such improvements to the UDRP.

Below are the specific issues discussed, a relevant summary of points of input and conversation, and the level of consensus towards a recommendation.

--

### **Tier 1 – Unanimity of the Project Team**

*These are areas where the Project Team reached unanimous agreement and therefore we believe that consensus is likely to exist in the Phase 2 Review.*

*Against that backdrop, these are topics that the Project Team considers should form part of the work charter for ICANN's Phase 2 review of the UDRP.*

### **Loser Pays, Costs, Damages**

Both brand owners who face whack-a-mole scenarios, as well as prevailing registrants, have expressed interest in a “loser pays” model.

At the same time – and assuming panelists would be comfortable in making such awards – it is recognized that such awards may ultimately be unenforceable absent some form of bond payment system which ensures that the successful party receives its cost award. Moreover, between complainants and respondents, it is more likely that costs could be recovered from an unsuccessful complainant than a losing cybersquatter, presenting a vastly inequitable situation.

Moreover, requiring a bond to be paid by a registrant (or held against their credit card used to register a domain name) creates potential access to justice but also practical issues. Neither UDRP Providers nor registration authorities would seem inclined to assume the responsibility and costs for a bond payment system.

We considered the following questions: would a “loser pays” system be worth creating despite:

- a) the change to the UDRP required – noting (ICANN) contractual and legal ramifications;
- b) the additional work (and potential discomfort) required by parties and panelists to request or to rule on costs;
- c) the fact that it would likely require the prevailing party to chase up any monetary compensation in a national (e.g., small claims) court; and



d) some respondents might defend against a complaint when they otherwise might not have solely due to the risk of a costs order against them.

***Recommendation:*** While there was support for the principle of addressing the imbalance in enforcement costs and providing a deterrent against bad actors, given the complexities in administering such a system, we would recommend against the adoption of a loser pays system.

### **Fee Payment Deadlines**

Currently there is no fixed time frame in the Rules for complainants to pay the additional fees required for a three-member panel case. While normally this is not an issue, in a very small number of cases, it has put Providers in an awkward position of chasing a party.

We considered whether there should be a reasonable but fixed length of time for complainants to pay any additional required filing fees in a three-member panel case.

***Recommendation:*** We would recommend that the Rules be amended to require a reasonable but fixed length of time for complainants to pay any additional required filing fees in three-member panel cases.

### **Reviewing and Reinforcing ICANN's Role in Compliance**

ICANN Registrar Compliance plays a crucial role in ensuring that registrars comply with their obligations under the UDRP.

Nevertheless, there have been reports, particularly from complainants, that ICANN Compliance is sometimes unable to intervene in a timely or satisfactory manner, e.g., where a registrar fails to appropriately lock a domain name which is the subject of a UDRP case, or refuses to implement a UDRP decision in their favor.

We considered the question of whether ICANN should review and reinforce its role in ensuring timely compliance of registrars with respect to their duties under the UDRP and the corollary that registrars receive greater training and information on these obligations.

As the party ultimately responsible for (contractual) compliance with its own Consensus Policies, it was felt to be a rather obvious point that ICANN should be required to act in a specified timely manner when compliance questions are raised to its attention.

***Recommendation:*** We would recommend that ICANN review and reinforce its role in ensuring specifically-delineated timely compliance of registrars with respect to their duties under the

*UDRP and that registrars receive greater training and information on their obligations.*

### **Providing UDRP-related Information for Registrars**

Registrars play a crucial role in the UDRP by locking and unlocking domain names, providing underlying registrant details, and enforcing transfer orders. Nevertheless, some complainants have reported occasional issues and delays with some registrars in performing their duties to lock a domain name, provide registrant information, or transfer the domain name to a successful complainant. In a few cases, this has even resulted in a third party registering the domain name after the UDRP case, thus forcing the complainant to file a second case.

We considered whether a one or two-page FAQ document for registrars be prepared by ICANN in consultation with stakeholders.

We also considered whether registrars should be required to undergo a short “UDRP Bootcamp” so as to better inform them how to process UDRP complaints and transfer.

***Recommendation:*** *We would recommend that ICANN prepare an FAQ for registrars, in consultation with UDRP stakeholders.*

*We also recommend that ICANN sponsor an optional “UDRP Bootcamp” webinar to better inform registrars how to process UDRP complaints and transfer orders.*

### **Regulating Complaint Withdrawals**

The Rules do not specifically address situations where a complainant wants to withdraw a filed complaint without the respondent’s consent. This can sometimes arise where a respondent wants a determination on the merits. At some Providers (e.g., WIPO), if there is a known respondent and/or Response, this would be subject to comments from, and usually consent by, the respondent. At other providers, apparently this may not be the case.

We considered the question of whether the Rules should be clarified to regulate complaint withdrawals and make the procedure and considerations uniform across all Providers.

***Recommendation:*** *We would recommend that the Rules be amended to regulate withdrawals and to thereby make the procedure uniform across all Providers.*

### **Clarifying Registrar Verification Procedures**

Registrar Verification to Providers is sometimes unclear depending on how the answers provided by the registrars are produced/formatted. Sometimes it is a complete copy-paste of the WHOIS (RDAP) information, other times it seems to be more ad hoc. Registrar Verification

can in some cases be an important part of the evidentiary record; the Rules currently do not however require that it be shared with both parties and the panel, resulting in potentially inconsistent distribution of this information.

We considered the question of whether there should be a requirement that the registrar's obligation vis-à-vis the registrant contact information be specifically defined to provide (in addition to answers to questions such as the language of the registration agreement or confirmation that the domain name is locked) the complete and unredacted underlying registration data for the disputed domain name. NB while the Project Team did not examine the ICANN PPSAI in detail, it is presumed that whatever framework ICANN eventually deploys, that this would facilitate the provision of the actual underlying customer information in UDRP proceedings and provide specific parameters for timing and method of such disclosure; it is also noted that absent any such disclosure, section 3.7.7.3 of the ICANN RAA specifies the liability of the publicly-named registrant (the "Registered Name Holder").

We also considered the question of whether (and to the extent that a Provider is not already doing so) RDAP data be provided to both parties and the panel.

***Recommendation:***

*We would recommend that, to the extent not already being done so by a Provider, in the case of a discrepancy between the information provided in the complaint, the registrant's registration data be provided to both parties and the panel by the Provider.*

**Identifying Dissenting Panelists**

In a few very rare occasions, a dissenting panelist has not been identified in a decision. If a dissenting panelist is not identified, it is unclear which panelist holds which views.

This lack of transparency undercuts the ability of parties to make informed choices when selecting panelists for a three-member panel case.

We considered the question of whether dissenting panelists should be identified in decisions by name.

***Recommendation:*** *We would recommend that the Rules be amended to require that dissenting panelists be identified in all decisions.*

**ICANN Contribution to the UDRP**

Millions of dollars are spent annually on UDRP filing fees – mostly by complainants.

At the same time, not only complainants, but also, registries, registrars, and registrants all generally benefit from the UDRP's good functioning to resolve domain name disputes out of court. ICANN benefits from the UDRP as it contributes to overall stability in the domain name

system. Nevertheless, and unlike other intermediaries such as online marketplaces (see for example, the eBay v Tiffany case) the overwhelming lion's share of the costs to administer the UDRP are borne by parties and Providers. Merely one penny per registration or renewal (from that already paid by ICANN Contracted Parties) would produce about USD \$2,000,000 annually.

We considered whether there should be a subsidy drawn from registration fees going towards the UDRP in some fashion such as lowering or reimbursing a portion of filing fees (especially for non-profits or SMEs both on the complainant and respondent side), UDRP education and training, panel remuneration, developing UDRP guidance material, etc.

***Recommendation:*** *Given the benefit to registration authorities in outsourcing dispute resolution under the UDRP, we would recommend that consideration be given to a very small subsidy drawn from registration fees going towards the UDRP in some fashion such as lowering or reimbursing a portion of complaint filing fees (especially for non-profits or SMEs), UDRP education and training, panel remuneration, developing UDRP guidance material, etc.*

## **Educational Materials**

We believe that there is a role for ICANN in reducing the frequency of poorly-conceived or unsubstantiated pleadings by providing parties with neutral and standardized educational materials covering not only the obligation not to infringe third party rights when registering a domain name, but also the basic requirements of a UDRP complaint and response. The educational materials would alert parties to the most common deficiencies in poorly drafted complaints and inadequate responses (e.g., the failure to submit proof of adequate and timely trademark rights; the need to support contentions with documentary evidence and not through unsubstantiated allegations; explanations of bona fide noncommercial fair use or valid legitimate interests, etc.). The materials would be made available in plain language for those who are not trained legal professionals or otherwise have little experience in this field.

This information would benefit meritorious complainants and their counsel who are unfamiliar with the UDRP by alerting them to potential pitfalls. It could also benefit both complainants and respondents by helping unwitting complainants and their counsel avoid bringing complaints that will not succeed and could possibly result in a finding of RDNH. Similarly, educational materials could help educate respondents about trademark rights and clarify that registering a domain name that is available may conflict with pre-existing trademark rights and would not automatically provide rights to such a domain name.

Care must be taken with such materials so as not to deter lawful registration of domain names or discourage legitimate complaints. Providers could offer links to these educational materials at prominent points most likely to be seen by parties prior to submission of their pleadings, such as on their home pages, facilities for online submission of complaints and responses, notice of commencement emails, etc.

***Recommendation:*** We would recommend the creation and publication of educational material for use by all parties, and which may be made available on each Provider's website and on ICANN's own website.

## **Mediation**

A number of ccTLDs employ mediation, for example, .CH, .LI, .NL, and .UK, with varying approaches and with different funding frameworks. While some experts found that mediation could be useful, others question its functioning within the context of the UDRP, primarily since the parties are free to engage in self-directed settlement discussions or may have already failed to reach an agreement prior to the commencement of proceedings.

While questions such as "at which stage(s) of the case mediation would occur" (e.g., before or after pleadings), and "who would bear the costs" (e.g., both parties or a single party) would need to be resolved, it has been suggested that a voluntary mediation could *already* be offered today by any provider under the existing UDRP framework without the need for any Rules or Policy change.

At the same time, there was little appetite for mandatory mediation as it could add to time and costs without a corresponding benefit in many cases (e.g., where one or both of the parties are not genuinely interested in participating in mediation in good faith (noting also the high respondent default rate)).

***Recommendation:*** We believe that mandatory mediation should not be adopted.

*At the same time, we believe that although instances may be relatively infrequent where both parties are interested in availing themselves of a voluntary mediation procedure offered by a Provider, it may nonetheless be offered for those that want it without interfering or compelling those that do not.*

*In that light, we recommend however that individual Providers should be free to offer voluntary mediation to parties, provided that they both agree to participate under the Provider's mediation framework, rules, and fees.*

## **Laches/Statute of Limitations**

Laches and Limitation Periods are strictly-speaking, two distinct concepts but they are discussed here together, insofar as they bear some conceptual relation. The defense of laches requires delay on the part of the rights holder (the complainant) combined with detrimental reliance on the part of the respondent, whereas a limitation period is simply a clear line after which no complaint may be brought. Laches as understood in law, requires very specific

circumstances to be properly invoked; it is not the same as simply a dismissal for delay. It requires awareness and detrimental reliance, and in the context of domain name disputes may require a party invoking such a claim to demonstrate that they, for example, built a business while the complainant knowingly chose not to take action against the respondent.

Some conflate the defense of laches with a statute of limitations. A statute of limitations would bar commencing proceedings a fixed number of years after the domain name is registered, or a fixed number of years after the brand owner becomes aware of an alleged cybersquatting case.

Although there may be questions as to why a party may occasionally commence a UDRP some 20 years after a domain name is registered, panels can – and do – generally take such delay into account in assessing the strength of a party's case but will generally not dismiss a case for delay alone. As is captured in the WIPO Overview, panels have 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.

The Project Team considered and deliberated upon the question of whether the defense of laches or a limitation period should be adopted and was unable to reach unanimous agreement on this issue. Most of the Project Team was of the view that the current consensus view as is captured in the WIPO Overview already allows panels to sufficiently consider delay as a factual element in the assessment of bad faith, and that a limitation period would unnecessarily prevent complaints against cybersquatters who should not benefit from the mere passage of time. On the other hand, some members of the Project Team believe that more robust consideration of delay should be given by panelists and that complainants should be required to address a delay in bringing a complaint.

***Recommendation:*** *As a result of the extensive investigations, consultations, and deliberations by the Project Team, we recognize that delay, especially as some domain names are as old as the UDRP, is a factor that ought to be considered by panels, and it currently is.*

*We therefore do not see sufficient basis for changing the UDRP to better address laches except perhaps by codification of existing case law principles.*

*Overall, we believe that a limitation period should not be adopted and that laches, even if it were adopted as a formal defense under the Policy, would be unlikely to have any appreciable effect given the rarity in which circumstances which lend themselves to laches arise.*

## **Scope of UDRP**

Although the UDRP has proven generally effective for dealing with cybersquatting, some believe that it could be expanded to deal with additional types of disputes. Although expanding the scope of rights covered by the UDRP is in theory possible, it would introduce operational,

procedural, and substantive complexities which would make ICANN's Phase 2 Review even more complex than it already is expected to be. Such an expansion would also be a fundamental shift in application if it involved for example, the expansion of the scope of the UDRP to add copyright, or Geographical Indications, or domain names where there is no trademark corresponding to the domain name (e.g., fakewatches.com). (This approach takes account the fact that, although the Second WIPO Internet Domain Name Process considered the extension of the UDRP to certain non-trademark identifiers, such as International Nonproprietary Names for Pharmaceutical Substances (INNs), the names and acronyms of international intergovernmental organizations (IGOs), personal names, geographical identifiers, and trade names), follow-up work in that respect remains inconclusive and, for geographical names and geographical indications, for example, discussions at the WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications are ongoing (SCT), e.g., SCT 31/8 and SCT 41/6 on which consensus has not been reached.)

***Recommendation:*** *While the Project Team recognizes that the success of the UDRP could encourage its expansion beyond trademark-based cybersquatting cases, it is not recommended that the ICANN's Phase 2 Review consider as part of its initial work charter the expansion of the scope of the UDRP.*

*We believe that any such scope consideration be addressed in a separate work track, if at all, in order to avoid adding to an already delicate and complex policy review process.*

## **Name Redaction**

Parties' names are included in decisions so that subsequent parties can determine a party's decision history; indeed, this concept is built into the black-letter of the UDRP. In the case of respondents for example, it is important for complainants to know the identity of the respondent so that they can establish whether a pattern of cybersquatting has occurred. However, in the case of a successful respondent, for example where the respondent was completely innocent and the victim of an abusive complaint, some have argued that there is little justification for disclosing a respondent's name on the Internet. Equally, a respondent may actually want their name in a decision to provide a public record of a panel finding in their favor which they may use in the specific case, or in future cases as evidence of their bona fides.

In some cases, the named respondent claims to be a victim of identity theft; in such cases, panels tend to redact the name in the decision already and append an annex to the registrar only for purposes of the transfer order.

Accordingly, outside of identity theft situations, there does not appear to be any bright line for when a respondent's identity should be disclosed or not, as it depends on the particular circumstances and therefore remains properly within a panel's discretion. Nevertheless, there is no clear rule expressly allowing a party to request redaction – either during or after the conclusion of a case – nor for panels required to consider such a request.

It is however noted that WIPO publishes a “Q&A: domain name WHOIS data and the UDRP” which sets out a process for a party to request name redaction during or following a case.

***Recommendation:*** We recognize the increasing importance of privacy generally and in particular when it comes to protecting the privacy of innocent registrants. We also recognize the importance of publication of party names where warranted for the efficacy of the UDRP.

*We believe that panels currently have the power under the Policy and Rules, to redact party names where appropriate and therefore neither a Policy nor Rule change is required.*

*Nevertheless, we recommend that the discretionary best practices applicable to redaction of party names by panelists should be further shared and published by all Providers.*

### **Registrars to Provide Additional Notice**

Currently, notices of a dispute are issued by the Provider directly to the respondent. However, there have been some reported instances of a registrant not responding to or not recognizing the import of the Provider’s notice, as the respondent is not familiar with the Provider or with the UDRP. (Indeed, Internet users are often advised not to open attachments from unknown senders.) If a registrant is notified by its registrar that a UDRP case has been commenced against it, it is expected that the registrant will generally be more likely to read it and to trust that the notice is legitimate. Registrants have a relationship with their registrar and will generally be familiar with and trusting of notices received from their registrar. Some registrars notably already provide this additional notice to their customers as a matter of good customer service.

***Recommendation:*** Although the UDRP has been generally successful in providing notice of a dispute to respondents, the process can be easily improved with a small adjustment. We believe that it would increase effectiveness and would be prudent and manageable for registrars to provide an additional form of notice to respondents.

*We propose that this practice become universal and mandatory across all registrars – in support of due process for registrants.*

*Registrars, however, would not be required to serve the complaint; that function would still be left to the Provider. (The registrar’s actions would be limited to emailing its customer at all available email addresses (including the account holder address*



*and not just the registrant's recorded WHOIS address) and providing notification to its customer that the disputed domain name has been locked and that they will have received or will shortly receive a Notice of Commencement of Proceedings from the Provider.)*

*Although the Project Team was not in unanimous agreement about removing the current requirement to deliver a hard copy of the notice of proceedings, there was strong support – also noting the registrant's obligation to provide accurate contact information – on this issue.*

- -

### ***Tier 2 – No Unanimity of the Project Team, But Consensus Potentially Achievable***

*These are areas where the Project Team did not reach unanimous agreement and therefore we believe that consensus may be achievable through dedicated and specialized work in a “secondary” work track in Phase 2.*

### **Appeals Layer**

An appeals layer has been consistently raised from across stakeholder groups as a desired feature to be added to the existing UDRP. While the Final Report of the First WIPO Internet Domain Name Process recommended against the inclusion of a specific internal appeals layer, preferring recourse to national courts for a de novo review, experience has shown that this design element may be worth revisiting. Moreover, concerns have been raised that a number of jurisdictions' legal systems may not provide a cause of action under national law for cases to be heard following a UDRP decision.

In principle, the Project Team was in unanimous support for the idea of an appeals layer; there was however a range of views on the exact details.

An appeals procedure has been largely considered as a potential means of:

(a) providing recourse to parties whose national courts may not provide a cause of action following a UDRP case;

(b) providing a means of allowing the parties to challenge what they believe may be an incorrect decision while also saving significant time and cost in comparison to courts (where available), in particular where the parties may come from different jurisdictions thus requiring use of foreign counsel; and

(c) further enhancing the stability and predictability of the UDRP system as a jurisprudential system driven by consensus, in a more structured way.

Set against the backdrop of the potential enhancement to the UDRP that an appeal layer could enable, is the fact that the vast majority of UDRP decisions are agreed to be solid and lacking in genuinely appealable aspects. This conclusion is illustrated by the nature of most domain name disputes which involve “indefensible” or obvious cybersquats where, as a result, the respondent does not even contest the allegations. Beyond that, only the rarest of UDRP cases is ever moved to a national court – even in those jurisdictions where a cause of action is well-established, such as in the case of the ACPA in the United States of America.

Then again, as with all legal regimes, there are occasionally outlier cases that are believed to be incorrectly decided and deserving of reconsideration, and resort to national courts may be impractical given the considerable expense or even due to the unavailability of recourse under national legal regimes.

The concept of an appeals layer has raised some dialogue as to whether an appeals option could be abused to lengthen proceedings and to increase costs, whether by losing complainants or losing respondents. Such risks could however be mitigated by appeals fee payments. It is also notable that even without a UDRP appeals procedure, parties can (and have) attempted to lengthen proceedings and frustrate transfers by commencing post-UDRP court proceedings in relatively slow and low-cost foreign jurisdictions. (See e.g., <https://www.wipo.int/amc/en/docs/icann090409.pdf>)

Discussions also considered the risk that a party that uses an internal UDRP appeal should not also be able to go to court in order to avoid too many “bites at the apple”. However, as a practical matter, it may not be possible (or desirable) to prevent this. Preventing a party from going to court could raise access to justice issues, complex national legal issues, and complexity in revising UDRP Paragraph 4(k) in particular.

When it comes to determining how exactly an appeals procedure could work, a number of questions arise. For example, if an appeal decision were to be binding instead of corrective, the composition of an appeals panel may take on increased importance as its composition would not only determine the outcome of the particular case, but also set precedent for future cases. Furthermore, if there were multiple appeals providers, an appeals decision from one could in theory be inconsistent with an appeal decision from another – this speaks to the risk of fragmented or inconsistent appeals results vs the benefit of a single appeals board managed by a single body, such as WIPO given its role in creating and acting as steward of the UDRP (e.g., as reflected by its institutional investment in the WIPO Overview).

Consideration was also given to an appeals layer that only permits appeals from single-member panel decisions, based upon the rationale that replacing the judgment of one three-member panel with that of another three-member appeals panel, might not necessarily result in a better decision, but perhaps only a different one.

Alternatively, appeals could be heard from three-member panels and not just single member panels at first instance which could involve a special “Appeals Panel Roster” (as Nominet does, and with the panelists for such roster to be drawn from the broader pool of panelists across providers). Based upon the Project Team’s discussions and hearing from the outside experts, and given the considerations about creating an appeals layer that is appropriately balanced, an appeals system featuring the following elements could be feasible:

(a) whether removing the three-member panel option for cases at first instance or leaving both current options intact, creating an appeals roster which would be a community-agreed specially-constituted roster of the most experienced panelists; or

(b) corrective as to the appealed case between the involved parties, rather than establishing a binding precedent on future parties (bearing in mind that inevitably such decisions may nonetheless have persuasive value) such that an appeals panel would not create binding case precedent on all subsequent panels. NB on this topic there were divergent views, and the question of appeals being binding as precedent merits specific consideration.

Questions also arose as to whether an appeals procedure should involve a closed evidentiary record drawn from the original hearing, subject to appeals panel discretion/exceptional circumstances. Consideration would also need to be given to the means of commencing an appeal and within which set time frame along with payment of a fee gauged to discourage frivolous appeals.

Despite the attraction of some or all of these potential elements in a possible appeals procedure, concerns have still been raised including within the Project Team. For example, some believe that given the heavy lift, complexity, panel composition issues, binding precedent issues, and the general rarity of decisions that some parties believe warrant reconsideration, an appeals procedure is not worth pursuing, preferring the status quo which enables recourse to national courts in most instances. Others believe that the most obvious approach of confining appeals to appeals from single-member panel decisions, though attractive at first impression, could likely result in parties being forced to participate in two hearings (the initial one and the appeal) in many instances, making the concept undesirable.

On the other hand, within the Project Team, the view was also endorsed that an appeals procedure would serve to enhance the UDRP by providing a relatively simple and low-cost mechanism for addressing the relatively occasional errant decision particularly by a single-member panel, and believe that despite the procedural questions to be addressed, it is worth pursuing.

***Recommendation:*** *As a result of the extensive investigations, consultations, and deliberations by the Project Team, we believe that although an appeals procedure can provide enhanced stability to the UDRP and on the whole appears to be a workable concept, complex procedural issues would need to be worked out.*

*As a result, we would recommend that the concept of an appeals layer be considered in a “Secondary Track” in Phase 2 wherein the ICANN Community can deliberate the different facets and considerations of an appeals layer.*

As stated above, the concept of an appeals layer was perhaps the one that on the surface had the most support, and which would preserve the good functioning of the UDRP into the future. In the time available however, it was not possible to fully settle on the different facets of an appeals layer. More than any other topic in this Report, it is felt that any ICANN Phase 2

Review work on the appeals layer concept should be undertaken by a narrow group with experience in the UDRP and court litigation. In sum it was felt that consensus on the workings of an appeals layer might be possible.

### **Changing “and” to “or”**

The UDRP requires both registration, and use of the disputed domain name in bad faith. While in many cases, the two are interconnected, in some very rare cases over the years, a domain name originally registered without the intent to target a brand owner in bad faith (e.g., because the complainant did not yet exist), is later used in a clearly bad faith infringing manner. More commonly but still relatively rare, are cases where a registrant associated with the Complainant registered a domain name in good faith, but the relationship was subsequently severed and the Respondent nevertheless continued to use the domain name in bad faith. An example of this is the “Octogen” case, where the panel nonetheless decided in the complainant’s favor, setting off a controversy as to the correct interpretation of the UDRP. In the intervening years, a clear consensus coalesced around the fact that the view expressed by the Octogen panel was out of step with the plain language of the UDRP. This has not, however, answered the dilemma faced by the Octogen case of a registrant’s original good faith and subsequent bad faith not being covered by the UDRP.

Even prior to Octogen, changing “and” to “or” has been the subject of considerable interest and discussion over the years. In the discussions amongst the Project Team, one view was that the change to “and/or” would be an undesirable or potentially destabilizing expansion of the Policy. By way of compromise, others put forward a proposal to introduce the “or” concept in a manner which targets a limited set of scenarios where a domain name was registered in good faith (or in unclear circumstances) but subsequently used in a clearly egregious manner.

One specific scenario raised was where a domain name was registered in good faith pursuant to a license or other business arrangement (e.g., an IT or web hosting services company or by a former employee), but after the termination of the parties’ relationship, the registrant continued to hold the domain name despite the terminated relationship. It was felt that the UDRP could be adapted to fairly address this kind of particular and discrete scenario that the UDRP does not currently adequately address, without otherwise broadening the applicability of the UDRP. Nevertheless, some felt that such scenarios can be left to the courts to determine, as the UDRP was not intended to address cases that did not involve both bad faith registration and use, and that contractual issues are not the proper jurisdiction of the UDRP.

Others believe that without strict limitations on the application of “and/or”, valuable domain names could be targeted as a result of merely offering them for sale, or as a result of an inadvertent PPC link, even when the domain name clearly pre-existed the complainant’s trademark rights and was registered in good faith. One potential solution raised in that respect was that “and/or” could be introduced into the Policy on the explicit understanding that there would be sufficient express safeguards added to the UDRP to limit its application only to specified (e.g., licensee/former employee) scenarios.

It is apparent that a significant number of ccTLDs use the and/or formulation with apparent fairness and success, but it was also felt that such a change in the Policy could in the short term affect UDRP jurisprudence and that even the expressed benefits might not be worth the effort since such a change may ultimately impact only a relatively small number of cases.

**Recommendation:** *As a result of the extensive investigations, consultations, and deliberations by the Project Team, we believe that although a change from “and” to “and/or” may be possible to implement in order to address discrete and limited instances of bad faith use following good faith registration such as a licensee/former employee scenario, the instances of such cases are relatively infrequent, therefore raising a question as to the overall utility of undertaking such a change given the nuanced effort involved.*

*As a result, we would recommend that an examination of the possible introduction of “and/or” in limited circumstances such as licensee/former employee scenarios, and the inclusion of potential express safeguards, be deferred to a “Secondary Track” in Phase 2 wherein the ICANN Community can engage in what would appear to be required lengthy and complex deliberations with possible consensus achievable, but not immediately available. That is not to prejudge whether ultimately the ICANN community will decide in favor or against a limited introduction of “and/or”, but we identify this topic as one where it is at least conceivable that with further work a consensus may be achieved through delicate balance.*

## **Supplemental Filings**

Neither the UDRP nor the Rules regulate supplemental filings other than making it within the discretion of the panel to request them. Nevertheless, in practice, supplemental filings are sometimes submitted without a panel requesting them and thereby slow down or increase the burden on panelists and other parties. Sometimes supplemental filings are unwarranted and moreover they do not meet the test for admission set out in prior cases. As is captured in the WIPO Overview, panels have repeatedly affirmed that the party submitting or requesting to submit an unsolicited supplemental filing should clearly show its relevance to the case and why it was unable to provide the information contained therein in its complaint or response (e.g., owing to some “exceptional” circumstance).

Often, when an unsolicited supplemental is filed by one party, whether justified or not, the other party feels it is obliged to respond to it (sometimes at significant cost and effort) even if the original supplemental filing is repetitive and/or ultimately disallowed. There are no rules governing the length or content of a supplemental filing.

**Recommendation:** *Although the Project Team was unable to reach unanimous agreement on the specifics concerning supplementary filing issues with some disagreement about whether a Rule change was required or whether a codification of*

*the case law or status quo is preferable, the Project Team agrees that supplemental filings should be further considered with a view to finding consensus on an improved and uniform manner of treating supplemental filings, which is consistent with the existing case law. This may take the form of codification of current practices and discouraging supplemental filings. The Project Team therefore recommends that this issue be further explored and deliberated upon in a Secondary Track of Phase 2.*

### **Expedited or Summary Procedures**

Brand owners have often expressed interest in a faster-track UDRP-style process (if not simply a faster UDRP). Such a procedure was supposed to have been created for new gTLDs, namely the URS, but unfortunately it has a number of aspects which have severely limited its attractiveness and use. For example, the URS is only available for non-legacy new gTLDs and does not enable transfer, but rather suspension only. Furthermore, it increases the burden on complainants in terms of monitoring a suspended domain name including for a possibly extended period of time. It also contains several different types of appeals possibilities.

WIPO had also in 2009 proposed an Expedited Suspension Mechanism – a conceptual hybrid of the DMCA and UDRP where a respondent's failure to respond could trigger an expedited procedure and in particular, a finding of default which would have led to a suspension of the domain name for the duration of its registration period; where the complainant wished for the domain name to be transferred or permanently canceled a panel determination would be necessary. It has also been suggested that an expedited transfer procedure could focus on helping complainants who frequently have to use the UDRP to defend the same trademark repeatedly. Others still have proposed that, notwithstanding that it was proposed and rejected in the ICANN Phase 1 Review, that the URS be applied to all gTLDs, including “.com”.

The Project Team agreed that an expedited element in the UDRP would be useful to address the disproportionate enforcement burdens brand owners are forced to contend with, not to mention the increased volume of fraud-based cases in recent years. While agreeing on the concept, the Project Team differed on the specific attributes an expedited procedure should contain.

The Project Team considered the following possibilities: (i) a Nominet-style summary/full decision model for faster and cheaper default cases; (ii) a fast-track available for trademarks that are repeatedly targeted; (iii) default decisions i.e., no panel if there is no response, with the domain name temporarily suspended (which suspension can be lifted, possibly with conditions, if a response is filed prior to the duration of the registration), but a panel is appointed if the brand owner wishes for a transfer or permanent cancellation remedy; and/or, (iv) procedures for time-sensitive fraud-related issues.

The above possibilities were not meant to be mutually exclusive, i.e., it could be possible to combine certain attributes of some or all of them in addressing the desire to provide an expedited path for certain types of UDRP cases.

It was also clear that there may be things a Provider could do within its fee structure to meet some of the expressed concerns even absent a Policy or Rules change.

***Recommendation:*** *The Project Team felt that although agreeing on the form of any expedited procedure would require further discussion, it is nevertheless highly worthwhile to further investigate and deliberate upon the details of such a procedure with a view to finding a solution that deals with certain kinds of cybersquatting abuse on an expedited basis, while ensuring that rights of legitimate registrants are protected.*

*We would therefore recommend that such consideration be subject to a “Secondary Track” in Phase 2 as consensus appears achievable.*

### **Remedy: True Cancellation**

Cancellation has always been a remedy available under the UDRP however it is infrequently used because complainants would rather obtain a transfer of the domain name – even if it means continually paying registration and renewal fees, rather than permitting a domain name to re-enter circulation following a “cancellation” order.

Owing to the costs to maintain a registration for a domain claimed under a UDRP, brand owners have often asked that the UDRP enable a domain name to be permanently canceled, such that renewal fees do not need to be paid merely to keep the domain name out of the hands of cybersquatters. This could be subject to a periodic proof by the brand owner that its (registered) mark remains valid. Arguably, registries and registrars should be willing to forgo the revenue from domain names which panels have determined should have never been registered in the first place.

Nevertheless, because of the possibility of coexistence of trademarks or use of words in a non-trademark sense – such that certain domain names should not be permanently kept out of circulation where another party may be able to use it in good faith without infringement – consideration must also be given to how to deal with such instances. For example, the Australian ccTLD manager AUDA once managed this (in a policy it called the Prohibition on Misspellings) by allowing a third party to ask that a name be lifted from its cancelled/suspended state upon the showing of a legitimate claim to the domain name. The operational considerations (e.g., a process to lift a domain name out of cancellation) that such a potential remedy brings to the UDRP would of course have to be considered if cancellation was repurposed to mean that a domain name was taken “off the grid” and no longer in the pool of generally available domain names.

The Project Team was in favor of true cancellation as a new remedy, but did not fully advance a solution for exactly how such a system would work, particularly with regard to lifting a cancellation due to potential third-party good faith use.

**Recommendation:** *The Project Team felt that “true cancellation” should be considered as a remedy under the UDRP, provided that a suitable mechanism for lifting the cancellation so that third parties are not prevented from legitimate registrations can be determined.*

*Figuring out a satisfactory method may require some nuance but appears not only to be within reach, but worth a dedicated effort. We therefore recommend that this issue be prioritized in a dedicated “Secondary Track” in Phase 2 in order to achieve consensus.*

### **Panelist Appointment, Accreditation, and Quality**

Another issue which has been raised, including in the Phase I Charter, is whether there should be rules for the appointment of UDRP panels, such as formalized rotations. Some believe that a “cab rank” concept is a good idea, but others believe that panelist appointments should be made with regard to other criteria, such as expertise, experience, nationality, language, etc. Additionally, the qualification of panelists lacks a uniform approach to accreditation, re-accreditation, continuing education, or de-accreditation amongst Providers.

The question of whether panelists should be permitted to also act as advocates has also been raised. There are however considerations such as: would a prohibition against panelists also acting as advocates result in an unsatisfactory depletion of subject matter expertise available to hear cases? Would such a prohibition prevent entire firms from acting as counsel if a panelist was at the firm? Would solo practitioners be disadvantaged since they cannot have an associate at their firm file a pleading for them unlike lawyers at larger firms? What about a person filing under an associate’s name in order to circumvent a prohibition against acting both as panelist and counsel? These are issues which involve many considerations which – to be clear – do not lend themselves to an immediate or easy solution.

Lastly, the issue of panelist neutrality and quality has been raised and there are currently no Provider-wide criteria for panelist accreditation, quality, or requirement for continuing education.

**Recommendation:** *The Project Team was unable to reach unanimous agreement on these issues.*

*Most of the Project Team however expressed support for consideration in any future UDRP review of matters such as a process to raise concerns about panelist performance and panelist continuing education.*

### **Codification of Case Law**

The Project Team considered the question of whether consensus based upon established case jurisprudence should be codified in the Policy. A wide body of jurisprudence has resulted in



clear and well-established interpretations of the UDRP in the vast majority of cases. The WIPO Overview has captured much of this. However, a question arises as to whether interpretive guidance or “rules” arising from such jurisprudence should be codified within the Policy itself as a binding interpretative tool across all Providers and panelists.

***Recommendation:*** *The Project Team was unable to reach agreement on whether existing case jurisprudence should be codified in a binding manner across all Providers. It was however recognized that there is value in ensuring consistency in cases across Providers and also ensuring that after 25 years of accepted case outcomes, an accurate and accepted consensus be encapsulated and followed.*

*We recommend in that respect that the concept of a [binding] Pan-Provider codification of jurisprudence, building on the consensus views captured in the WIPO Overview be further explored in a similar manner as this WIPO-ICA-led Review Project (i.e., outside of ICANN’s policy development processes).*

## **Free Speech**

Beginning with the Final Report of the First WIPO Internet Domain Name Process April 30, 1999, at Paragraph 172, protection of legitimate free speech rights has been addressed by the UDRP:

“Domain name registrations that are justified by legitimate free speech rights or by legitimate non-commercial considerations would likewise not be considered to be abusive”.

This is reflected by the intentional guardrails and limitations of the Policy – explicitly codifying noncommercial fair use. As is further illustrated in the summary of consensus views set out in the WIPO Overview, cases draw a distinction between instances of genuine free speech, versus cases claiming to be engaged in free speech but which are determined to be a pretext for cybersquatting. Therefore, while the term “free speech” does not appear in the UDRP itself, legitimate free speech is protected not only at the level of the Policy insofar as it expressly allows for noncommercial fair use, but also as a principle in the case jurisprudence.

Nevertheless, free speech and its application to domain names has been an area where the case jurisprudence historically saw some disagreement; this was expressed at the time of the WIPO Overview 2.0 as a “view 1” and a “view 2” approach and was based on differences in national law. Though there have been a number of cases which suggest a coalescence around a uniform approach, it is nevertheless perceived by some observers that differences amongst some panelists remain. WIPO Overview 3.0 suggests that a legitimate right to criticism “does not necessarily extend to registering or using a domain name identical to a trademark” and panels therefore support transfer of critical domain names when such domain names are identical to a complainant’s trademark. The relevant cases have also tended to focus on a

holistic test which looks to whether the claimed free speech is legitimate versus being a pretext for cybersquatting.

Although free speech does not arise very often in UDRP disputes, we recognize that it is an important issue and – mindful that this is an area of law that can be very fact specific and cases might lead to reasonable differences of opinion – that consistency in the approach of panels to free speech is desirable.

The Project Team was unable to reach agreement on whether it was necessary to change the language of the Policy when it comes to free speech.

***Recommendation:***

*We would recommend against a change in the language of the Policy with respect to free speech as the current language is adequate to protect legitimate noncommercial free speech.*

*Nevertheless, we believe that further discussion on the application of the Policy in such cases might be desirable in order to confirm the degree of consistency amongst panels.*

*We would therefore recommend that an examination of the application of the Policy to free speech issues and a possible codification and clarification of case jurisprudence be deferred to a “Secondary Track” in Phase 2.*

**Decision Format**

The Rules do not address the format of decisions, neither on a technical, nor on a structural level. There is clear inconsistency between the readability of decisions amongst Providers. For example, the decisions of some Providers are often criticized as being more difficult to follow than others, WIPO being cited as a best practice in terms of structural readability.

***Recommendation:*** *Although there was no agreement on the specifics of a technical decision format, we recognize that readability and uniformity of form are desirable. While there was a view expressed that machine readability of decisions to search decisions across all Providers would be useful, the majority view was that this should not impose undue burdens on Providers, and that the idea of a section-by-section template as is e.g., used by WIPO should be followed by all Providers.*

## **About WIPO and its Arbitration and Mediation Center**

The World Intellectual Property Organization (WIPO), a Specialized Agency of the United Nations, is the global forum for [intellectual property](#) (IP) services, policy, information and cooperation. WIPO is a self-funding agency of the [United Nations](#), with 193 member states. WIPO's mission is to lead the development of a balanced and effective international IP system that enables innovation and creativity for the benefit of all.

In respect of the UDRP, beginning in June 1998, WIPO undertook a series of international consultative processes to develop recommendations concerning the intellectual property issues associated with Internet domain names, including domain name dispute resolution. The First WIPO Internet Domain Name Process was finalized in April 1999 with the publication of a [Final Report](#). The recommendations contained in the Final Report were endorsed by the WIPO Member States and were also made available to the then-new organization, the Internet Corporation for Assigned Names and Numbers (ICANN), which was formed to manage the policy and technical aspects of the Internet Domain Name System. In 1999, ICANN adopted the UDRP based on the Final Report of the First WIPO Process.

Since then, WIPO has remained the global leader in the provision of UDRP and related services, having managed over 75,000 cases covering over 135,000 domain names to date.

Domain name disputes are managed by the [WIPO Arbitration and Mediation Center](#) which offers time- and cost-efficient alternative dispute resolution (ADR) options, such as [mediation](#), [arbitration](#), [expedited arbitration](#), and [expert determination](#) to enable private parties to settle their domestic or cross-border commercial disputes. The WIPO Center is international and specialized in IP and technology disputes.

## **About ICA**

The Internet Commerce Association (ICA) is a non-profit advocating for the rights and interests of domain name owners and related service providers.

Founded in 2006, the ICA is made up of responsible businesses and individuals who have joined together to improve public confidence in Internet commerce. Based in Washington D.C., the ICA's mission is to promote and share best practices among participants in the domain name industry and to educate consumers, policy makers, lawmakers and the media about the value and benefits of domain names and respect for intellectual property.

The ICA brings together a diverse group of individuals and companies from all over the world that own, buy, sell and develop domain names, as well as registries, registrars, brokers, sales platforms, lawyers, and other service providers.

## **Annex – list of acronyms**

ACPA - The Anticybersquatting Consumer Protection Act, 15 U.S.C. § 1125(d) is a United States law enacted in 1999 addressing the registration, trafficking in, or using a domain name confusingly similar to, or dilutive of, a trademark or personal name.

ccTLD - A country code top-level domain is an Internet top-level domain used or reserved for a country, sovereign state, or dependent territory identified by a unique 2-character code.

DMCA - The Digital Millennium Copyright Act is a 1998 United States copyright law that implements two 1996 treaties of the World Intellectual Property Organization.

DNS - The Domain Name System is a hierarchical and distributed name service that provides a naming and routing system for the Internet.

GNSO - The Generic Names Supporting Organization is the ICANN policy development body responsible for recommending policies to the ICANN Board.

GNSO Council - the manager of ICANN's policy process, comprised of a range of diverse stakeholder groups, and separated into a "Contracted Party House" (i.e., registries and registrars) and Non-Contracted Party House" (commercial and noncommercial constituencies).

ICA - The Internet Commerce Association is a non-profit advocating for the rights and interests of domain name owners and related service providers.

ICANN - The Internet Corporation for Assigned Names and Numbers is a nonprofit organization headquartered in the United States responsible for ensuring the stable and secure operation of the Internet's unique identifier systems.

PPSAI - Privacy & Proxy Services Accreditation Issues, adopted by the ICANN Board in 2016.

SCT - WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications. The SCT was created in 1998 to serve as a forum to discuss issues, facilitate coordination and provide guidance on the progressive development of international law on [trademarks](#), [industrial designs](#) and [geographical indications](#), including the harmonization of national laws and procedures.

UDRP - Uniform Domain Name Dispute Resolution Policy; adopted by ICANN in 1999 on the recommendations of WIPO.

URS - The Uniform Rapid Suspension System is a policy designed by ICANN to address concerns of increased cybersquatting in new gTLDs.

WIPO - The World Intellectual Property Organization is a Specialized Agency of the United Nations, and is the global forum for intellectual property services, policy, information and cooperation.