

# Second WIPO International Conference on Electronic Commerce and Intellectual Property

## The UDRP, Now and in the Future


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# *OUTLINE*


- *Problem:* conflict between trademarks and domain names
  - *Solution:* administrative dispute resolution
  - *Experience:* 3000 WIPO cases
  - *Future:* modifications, application
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# *TM-DN CONFLICT*

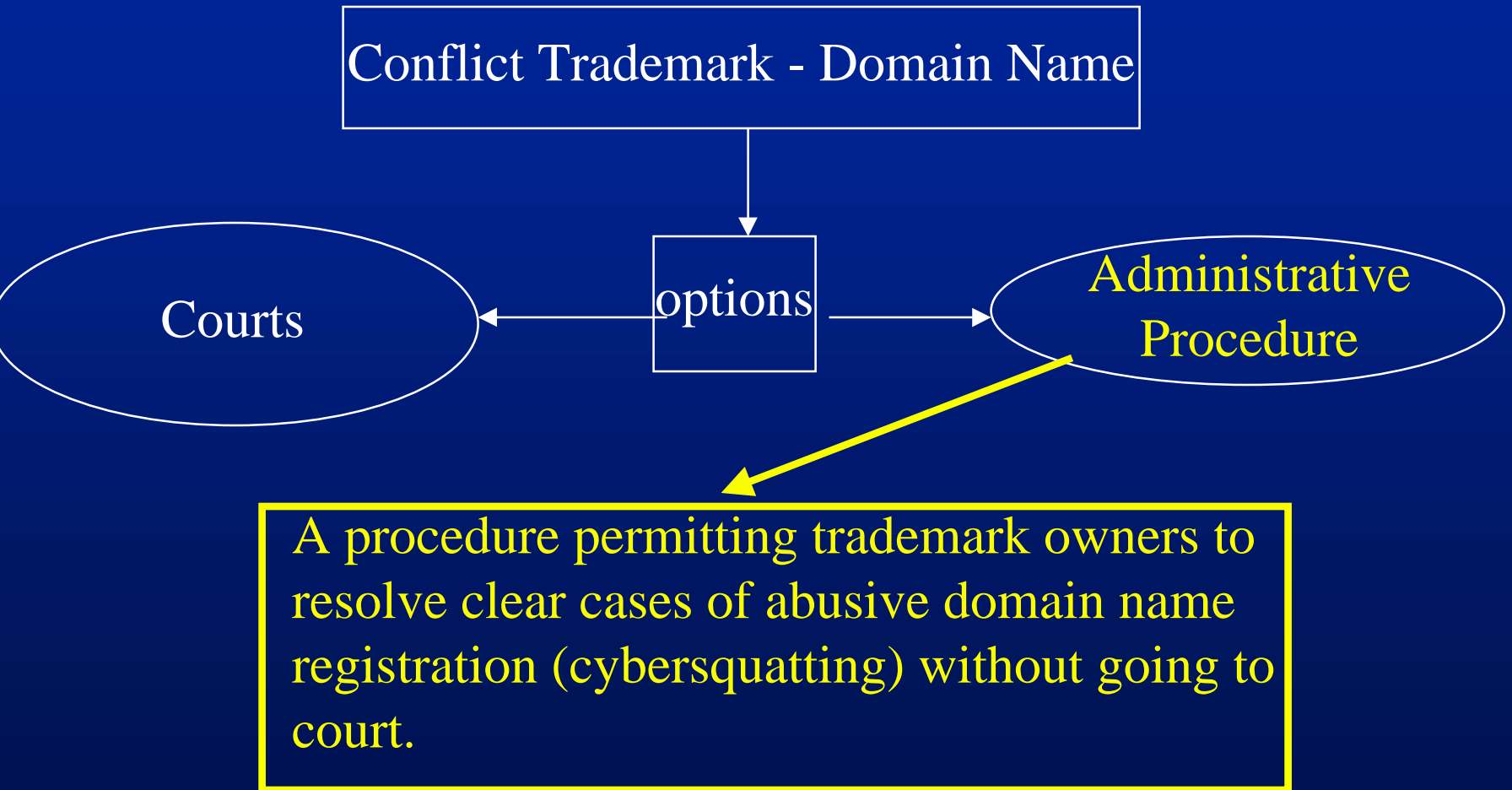
- *Trademarks*

- Territorial registration and application
- Different classes
- Examination and opposition
- Goods and services in commerce

- *Domain names*

- First come first served
  - One unique registration
  - Application across jurisdictions
  - In principle, no examination
  - Broad use
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# WIPO RECOMMENDATION




# *Uniform Domain Name Dispute Resolution Policy (UDRP)*

- *Adopted* by ICANN effective December 1999
- *Applicable* to gTLDs
  - To include new gTLDs
  - May be used by ccTLDs through voluntary adoption
- *Mandatory* part of registration terms and conditions
  - Retro-active to include existing registrations
- *Administrative*
  - Registrant must submit to UDRP but
  - UDRP does not preclude parties' court options
- *Remedies*
  - Transfer or cancellation only
  - No monetary damages

# DECISION CRITERIA

- *Conditions* for obtaining remedies:
  - 1. Trademark must be identical or confusingly similar to domain name; *and*
  - 2. Registrant has no rights or legitimate interests in domain name; *and*
  - 3. Domain name is registered and used in bad faith.
- *Examples* of rights or legitimate interests:
  - Registrant commonly known by the domain name
  - Use for *bona fide* offering of goods or services
- *Examples* of bad faith:
  - registration for purpose of profit sale to trademark owner
  - pattern of preventing trademark owners from registration

# *PROCEDURE*

- Complainant files *complaint* with dispute resolution service provider, e.g. WIPO Center
  - Provider *notifies* domain name registrant of opportunity to respond
  - Provider appoints independent *panel* from list
  - Panel *decides* based on common criteria
  - Registrar *implements* panel decision
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# *DEMAND*


- 2,927 WIPO cases (per 31-8-2001)
- Current filing rate approximately 4 complaints per day
- Multinationals, SMEs, individuals
- Parties from 86 countries
- Over 5,500 domain names
- Including 16 non-ASCII names



## *WHY THE DEMAND?*


- UDRP is generally considered to be meeting its purpose of offering an
  - effective,
  - fast,
  - affordable, and
  - transparent
- anti-cybersquatting option for owners of trademark rights

# *gTLD RESULTS*


- 2,105 WIPO panel decisions
    - transfer: 1,685 (80%)
    - cancellation: 14 (0,7%)
    - complaint denied: 406 (19,3%)
  - 512 party settlements
  - Total resolved: 2,617 (89%)
  - Direct enforcement; few court ‘appeals’
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## *TIME*

- Less than two months
  - Fixed timelines for parties + panels
  - Word limits for pleadings
  - Normally no additional submissions
  - Online filing and communication
  - Bright-line decision criteria
  - No appeal within UDRP
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# *MONEY*

- Time is money
  - Model complaint and response
  - Fixed non-profit Center + panel fee
  - Costs normally for complainant
  - No award of damages
  - Legal representation not required
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# OPEN

- Center site: over 1 million hits per month
    - posted table of cases
    - posted detailed panelist resumes
    - posted full decisions
  - Decisions:
    - Based on criteria including examples
    - Reasoned
    - Daily e-mail notification of new dec's
  - Communication in appropriate language
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# *MODIFICATIONS?*

- WIPO procedural Rules suggestions
- DNSO UDRP Review Task Force
- Appeal mechanism
  - Is there a problem?
  - If so, would it justify such mechanism?
  - How would the appeal panel be composed?
  - Would it enhance uniformity?
- Report of the Second WIPO Internet Domain Name Process

# *APPLICATION*

- ccTLD administrators increasingly adopt UDRP (versions)
    - benefits of uniformity
    - 22 have designated WIPO Center
    - 52 WIPO ccTLD (-only) cases
  - New gTLDs to use UDRP, plus
    - 'sunrise' procedures
    - eligibility procedures
  - Capable of application regardless of script or language
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# *MORE INFORMATION*

- *[http://arbiter.wipo.int/  
domains](http://arbiter.wipo.int/domains)*

