

UDRP extension beyond the domain name

UDRP-like alternative dispute resolution remedies should be made available for a broader range of IP violations.

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Preview

- Problem samples
- UDRP solution
 - Describe The Uniform Domain Name Dispute Resolution Policy
 - Addresses only a fraction of this problem (requires trademark rights)
 - Advocate its extension to address other illegal activity on the internet
 - DMCA enhancement
- Key regulatory asset—the contractual foundation of all internet activity—is not fully exploited
- Implementation

The problem

- Illegal activity on Internet is pervasive
 - Especially IP violations
 - Not limited to domain name infringement
- Bad actors are
 - Numerous
 - Anonymous
 - Remote
- National courts
 - Cautious, deliberate, hesitant
 - Expensive and time-consuming
 - Jurisdictional limitations
- UDRP
 - Effective, but
 - Limited to domain name disputes

Examples of IP Violations

Focus of Trademark Counterfeiting

Counterfeits at <bossonlinesale.com>

D2014-2216

The screenshot shows the BOSS HUGO BOSS website interface. At the top left is the BOSS HUGO BOSS logo. To its right, it says "Over \$150, Free Shipping". In the top right corner, there are links for "Log In" and "Create Account" with a small American flag icon. Below these is a shopping cart icon and text: "Shopping Cart: 0 Items \$0.00". A search bar is located below the cart with the placeholder text "Enter search keywords here".

The main navigation menu includes: HOME, HUGO BOSS CLOTHING BOYS, HUGO BOSS SHOES MEN, and CONTACT US. The breadcrumb trail reads: Home >> Hugo Boss Clothing Men >> Shirts >> Casual Shirts. The page title is "Casual Shirts".

Below the title, it says "Displaying 61 to 72 (of 77 products)". There are navigation arrows: "[<< Prev]", "[6]", and "[Next >>]".

The main content area displays a grid of 12 men's shirts. Each item has a product image, a title, and a price. The items are:

- Luxury Men Boss Orange EMOTIONE Shirt blue Boss Outlet: \$188.83 - \$103.67
- Luxury Men Boss Orange EQUATOR Shirt blue Boss Outlet: \$167.20 - \$86.23
- Luxury Men Boss Orange ESLIM Shirt black Boss Outlet: \$134.43 - \$74.10
- Luxury Men Boss Orange EZIPPO Shirt green Boss Outlet: \$150.24 - \$82.82
- Luxury Men Boss Orange EZIPPO Shirt white Boss Outlet: \$149.29 - \$81.87
- Luxury Men Boss Orange Shirt blue Boss Outlet: \$166.86 - \$91.63
- Luxury Men Boss Orange Shirt blue Boss Outlet: \$134.43 - \$74.10
- Luxury Men Boss Orange Shirt gray Boss Outlet: \$142.34 - \$78.47
- Luxury Women BOSS Orange LASVANI Slim fit jeans blue Boss Outlet: \$201.44 - \$106.89

On the right side of the page, there is a sidebar with several sections:


- CURRENCIES: US Dollar
- CATEGORIES: Hugo Boss Clothing Boys, Hugo Boss Accessories Boys, Hugo Boss Accessories Men, Hugo Boss Accessories Women, Hugo Boss Clothing Men, Hugo Boss Clothing Women, Hugo Boss Shoes Men, Hugo Boss Shoes Women, New Products ..., All Products ...
- SPECIALS (MORE): Fashion Women BOSS Orange LESSUNTA3 Slim fit jeans blue Boss Outlet: \$149.29 - \$81.87, and the LASVANI jeans mentioned above.




Counterfeit Viagra <viagra.ninja>

D2014-1854 11/7/14 foobar

VIAGRA[®] (sildenafil) THE LOWEST ONLINE PHARMACY OFFERS


This site offers you the quickest and easiest way to find the lowest prices at which to buy Viagra online

\$0.⁶¹ 

THE BEST RATED PHARMACY OF 2013    WORLDWIDE SHIPPING 

GET THE BEST PRICES ON VIAGRA

Saving money on Viagra has never been easier. This service connects you with reputable online pharmacies so you'll never have to compromise on quality, while still making sure you're getting the very best deal. There's never been a better time to restore your sex life than today, simply by shopping from the convenient privacy of your own home.



<cartierlovejewelry.com>

The screenshot shows the Cartier Love Jewelry website. At the top, the navigation menu includes: COLLECTIONS, CATEGORIES, MATERIALS, SALE, NEW, ABOUT US, CONTACT US, and FAQ. Below the navigation, a secondary menu lists product categories: LOVE, C MOTIF, TRINITY, PANTHERE DE CARTIER, AGRAFE, LANIERES, HEARTS OF CARTIER, MAILLOH PANTHERE DE CARTIER, and LE BAISER DU DRAGON. The main banner features a dark red background with a gold Cartier bracelet and necklace. The text reads: "Holiday Clearance Sale 20% OFF SITE-WIDE. Enter **CTLOVEJ20** at Checkout." A red ribbon graphic contains the text "How customers say about our products?". Below this, three product categories are highlighted: "RING COLLECTION START AT \$39", "LOVE BANGLE COLLECTION START AT \$58", and "CARTIER PENDANT START AT \$39". The footer contains several sections: "SIGN UP FOR NEWSLETTER GET \$10 COUPON NOW" with a form to enter an email address and a "SIGN UP" button; "WHY CHOOSE CARTIERLOVEJEWELRY.COM?" listing benefits like Secure Payment, Quick Delivery, Reasonable Prices, Good Quality, Fine Workmanship, and Satisfactory After-Sale Service; "CUSTOMER SERVICE" with links for Delivery, Return Policy, Privacy Policy, Disclaimer, and Payment Options; and "YOUR ACCOUNT" with links for Sign in, Your account, Your Orders, Your Shopping Cart, and Log Out. Payment logos for VISA, MasterCard, AMERICAN EXPRESS, Maestro, DISCOVER, and 9040 are also visible.

Buying medications online



Bactrim

In this comparison table you can see the most known and reputable online pharmacies. Some of them sells only generics, others - brands and generics at the same time. Also they have a differences in price, payment methods and delivery types, so you can choose the one that fits you best.

Online Pharmacy	SKY Pharmacy	My USA Express	Canadian Health&Care Mall	CanadianDrugStore
Prices	Bactrim from \$0.36	Bactrim from \$0.55	Bactrim from \$0.35	Bactrim from \$0.77
Shipping	Worldwide Airmail (10-21 days), EMS courier (3-8 days)	Worldwide Registered Mail: 7+ days, EMS: 2-3 days	Worldwide Airmail (10-21 days), Express Courier (US Customers Only)	Worldwide Trackable Courier Service (5-9 days), Standard International Airmail (10-21 days)
Payment Methods	Visa, MasterCard	Visa, MasterCard, AmEx, Echeck, Diners Club, JCB	Visa, AmEx, eCheck	Visa, MasterCard
Currency	USD, GBP, CAD, EUR, AUD	USD, EUR, GBP	USD, GBP, CAD, EUR, AUD, CHF	USD, EUR, GBP
Language	English, Italian, Español, Deutsch, Français	English, Italian, Spanish, French, German	English, Deutsch, Español, Français	English, Français
Prescription	No	No	No	No

ONLINE SHOPPING – BEST OFFERS FOR YOUR MEDS



Generic For Bactrim

In this comparison table you can see the most known and reputable online pharmacies. Some of them sells only generics, others - brands and generics at the same time. Also they have a differences in price, payment methods and delivery types, so you can choose the one that fits you best.

Online Pharmacy	SKY Pharmacy	My USA Express	Canadian (HealthCare Mail)	CanadianDrugStore
Prices	Bactrim from \$0.36	Bactrim from \$0.55	Bactrim from \$0.35	Bactrim from \$0.77
Shipping	Worldwide Airmail (10-21 days), EMS courier (3-8 days)	Worldwide Registered Mail: 7+ days, EMS: 2-3 days	Worldwide Airmail (10-21 days), Express Courier (US Customers Only)	Worldwide Trackable Courier Service (5-9 days), Standard International Airmail (10-21 days)
Payment Methods	Visa, MasterCard	Visa, MasterCard, AmEx, Echeck, Diners Club, JCB	Visa, AmEx, eCheck	Visa, MasterCard
Currency	USD, GBP, CAD, EUR, AUD	USD, EUR, GBP	USD, GBP, CAD, EUR, AUD, CHF	USD, EUR, GBP
Language	English, Italian, Español, Deutsch, Français	English, Italian, Spanish, French, German	English, Deutsch, Español, Français	English, Français
Prescription	No	No	No	No
	#1 for customer service (by customers votes) #1 for discount&bonus program (by customers)	Special re-order price - save 15% Apart from the 5%, 10%	4 Free Bonus Pills for ALL orders! Free Regular Airmail (10-	Free pill samples! Money back guarantee

http://f1atms001.net/ Tue Dec 10 20:14 11:50:17 GMT-0500 (Eastern Standard Time)

Online Pharmacy

+1 (800) 532 4808 (US toll free)
+1 (718) 313 1498



Your cart: \$0.00 (0 items)

CHECKOUT

- BESTSELLERS
- FAQ
- OUR POLICIES
- CONTACT US

Categories list

- Alcoholism
- Alzheimer's And Parkinson's
- Analgesics
- Anti-inflammatories
- Antibacterial
- Antibiotics
- Anticonvulsants
- Antidepressants
- Antifungals
- Antiparasitic
- Antivirals
- Arthritis
- Asthma
- Birth Control
- Cancer
- Cardiovascular Diseases
- Cholesterol
- Diabetes
- Diuretics
- Erectile Dysfunction
- Eye Care
- Gastrointestinal Tract
- HIV
- Hypertension
- Men's Health
- Mental Disorders
- Migraine
- Muscle Relaxants
- Neurological Disorders

Special offers

+4 free pills
Place an order!

+20 free pills
Get a gift!

Free shipping
More bonuses

Bestsellers

Search by letter: A B C D E F G H I J K L M N O P Q R S T U V W X Y Z

	GENERIC VIAGRA Sildenafil Citrate 25/50/100/150mg	BUY NOW	\$0.80 PER PILL
	GENERIC LEVITRA Vardenafil 10/20/40mg	BUY NOW	\$2.00 PER PILL
	GENERIC AMOXIL Amoxicillin 500mg	BUY NOW	\$1.25 PER PILL
	GENERIC CIPRO Ciprofloxacin 250/500/750/1000mg	BUY NOW	\$0.97 PER PILL
	GENERIC DIFLUCAN Fluconazole 50/100/150/200mg	BUY NOW	\$1.45 PER PILL
	GENERIC LASIX Furosemide 40/100mg	BUY NOW	\$0.42 PER PILL
	GENERIC PROPECIA Finasteride 1mg	BUY NOW	\$0.60 PER PILL

Search for pills

Type keyword here

Testimonials

I recently placed an order with your company for some viagra and was very pleased however I accidentally deleted your website for ordering could you please re-send details?

READ MORE >>

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History of UDRP- the “Uniform Domain Name Dispute Resolution Policy”

- Rampant “Cybersquatting” before 1999
 - Speculators or worse registered domain names important to others
 - Held them hostage
 - Demanded extortionist sums to transfer
- ICANN adopts the UDRP in 1999 on the basis of WIPO recommendations (First WIPO Internet Domain Name Process)

ICANN adopted UDRP in 1999

- ICANN is the “Internet Corporation for the Assignment of Names and Numbers”
 - Governing body for the internet
 - Derives authority from the United States Department of Commerce
- ICANN acts through “registries” and “registrars” that distribute domain names.
 - ICANN has contracts with the registries and registrars
 - These contracts require
 - Warranties/Covenants not to violate law or IP rights
 - Consent to dispute resolution under the UDRP

UDRP Overview

- Administrative proceeding
 - based on consent in domain name registration agreement
 - international IP experts as panelists
- Limited focus and remedy: transfer of domain name
 - No money damages
- Solves
 - the jurisdiction problem
 - the anonymity problem
- Inexpensive, *compared to litigation.*
- Fast: Start to finish in 75-90 days.

UDRP does not supplant National Courts

- Submission to jurisdiction for follow-on litigation
- UDRP decision not take effect if either party files a lawsuit within 10 days.
- Court challenges extremely rare
 - More than 10,000 UDRP decisions involving United States respondents
 - Less than 25 reported cases in US involve prior UDRP decisions

UDRP– *Bright Line Criteria*

Trademark holder must prove

- **identity or confusing similarity** between Trademark and domain name
- lack of **registrant rights or legitimate interests** in domain name
- **registration and use** of domain name in bad faith

UDRP design elements

- Uniform And Universal Application
 - All “Top Level Domains”-- .Com, .Net, .Org, Etc.
 - Many Country Code” TLDs-- .CO, .MW, .PW
- Fast and Fixed Timeline
 - 20 Days To Respond
 - 14 Days To Decide
 - Total Time: 75-90 Days
- Limited Remedies
 - Transfer, cancellation
 - No damages
- Court Option Maintained
 - Court Challenge Of Results
- Complainant Pays
 - Lump-sum Fees
- Respondent’s language
- Legal Representation Not Required
 - “Jurisprudential Overview”
- Single Round Of Pleadings
- Paperless; all proceedings digital
- Posted Decisions

WIPO Center’s ccTLD program:
<http://www.wipo.int/amc/en/domains/cctld/>

UDRP cases at WIPO

- Total number UDRP-based cases since 1999
 - More than 33,000 cases
 - More than 60,000 domain names
- Country code Top-Level Domains account for 14% of 2015 case load so far
- In 2015 (mid November):
 - Parties from 111 countries
 - Most filers: US, France, Germany, UK, Switzerland
 - More than 300 panelists from 51 countries

However

- The UDRP may only be brought by a trademark holder
 - Namely, no domain names identical or confusingly similar to a trademark
- If domain name does not relate to a trademark, then no UDRP
- What we need is a UDRP-like remedy for illegal activity other than domain name infringements
- This presentation advocates such a plan

Legal Foundation for Extending the UDRP

Registrants already agree to more than
mere compliance with UDRP

The key regulatory asset

- All domain names begin with a contract
- The Registrar **MUST** require that domain names not be used for illegal activity
- Typical domain name registration agreements typically require broad warranties and covenants not to engage in any unlawful activity

ICANN Registration Accreditation Agreement Para. 3.7.7.9

- Registered Name Holders shall represent that “neither the registration of the Registered Name nor the manner in which it is directly or indirectly used infringes the legal rights of any third party.”

A typical domain name registration agreement. See Fabulous.com

- To abide by UDRP
- The domain name nor the manner in which it is “used, directly or indirectly, infringes the intellectual property rights or other legal rights of any third party...”
- Used in a way that is “invades another person’s privacy or property rights or otherwise in breach of a duty owed to a third party.”
- “Infringes the registered trademark, copyright or patent rights of a third party”
- “violates any applicable local, state, national or international law or regulation”
- “Promotes, is involved in or assists in, the conduct of illegal activity of any kind...”
- Registrar may suspend, cancel, transfer domain name if it is “being used for or in connection with Misleading Activity or an Illegal Activity...”

Also learn from the DMCA Model

- DMCA Procedure:
 - Copyright owner sends notice to ISP
 - ISP takes accused page down “expeditiously” (1 or 2 days)
 - If Webpage owner responds with “Counter notice” the page must be restored within 14 days
 - Copyright owner must file lawsuit
 - ISP immune

DMCA Model Adopted in Many Countries

- 18 countries have notice-takedown models similar to DMCA:
 - Australia, Peoples Republic of China, El Salvador, Finland, France, Germany, Hungary, India, Italy, Japan, Malaysia, Mongolia, New Zealand, Singapore, South Africa, South Korea, Spain, and UK
- Template for similar defenses in European Union
- Over a million takedown notices to Google alone
- Counter notices in only 0.020% of the United States cases.

Daniel Seng, *The State of the Discordant Union: An Empirical Analysis of DMCA Takedown Notices*, 18 Va. J. L. & Tech. 369, *37 (2014), http://papers.ssrn.com/sol3/papers.cfm?abstract_id=2411915.

How might extended UDRP work?

Two steps before Court option:

- Step 1: Modeled on DMCA’s “Notice and Takedown”:
 - Trademark owner gives notice of trademark violation to intermediary (ISP / registrar / registry?)
 - Confusingly similar domain name not required for standing or remedy
 - Confusingly similar content required
 - Opportunity for page owner to give counter notice
 - If no counter notice, page taken down
- Step 2: Modeled on UDRP
 - If a counter-notice is submitted, the mark owner may commence a UDRP-like proceeding
 - Transfer, suspension or cancellation only remedy
- Court option follows

Implementation?

- Advocate that ICANN extend the UDRP
 - Not likely without pressure or in response to liability risk
- Alternatively,
 - ccTLDs
 - ISPs, registrars
 - National legislation
 - Judicial imposition of liability on intermediaries
 - This is the stimulus to accepting procedures
 - Registrar's typically passive, even hostile, to regulation.

Summary

- UDRP has successfully addressed trademark infringement in domain names
- But problems are bigger than domain names
- Key regulatory asset: all domain names start with a contract
- We have successful models
 - UDRP-fast, fair administrative-dispute resolution-before resort to national court
 - DMCA-notice and take down
- Implement outside ICANN

