UDRP extension beyond the domain name

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

Lawrence Nodine
Partner
Ballard Spahr LLP, Atlanta
nodinel@ballardspahr.com
678.420.9422

Adjunct Professor
Internet Law
Emory University
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
Focus of Trademark Counterfeiting
Counterfeits at <bossonlinesale.com>
Counterfeit Viagra <viagra.ninja>

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

$0.61

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.
Buying medications online

In this comparison table you can see the most known and reputable online pharmacies. Some of them sell 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.

<table>
<thead>
<tr>
<th>Online Pharmacy</th>
<th>SKY Pharmacy</th>
<th>My USA Express</th>
<th>Canadian HealthCare Mall</th>
<th>CanadianDrugStore</th>
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<tbody>
<tr>
<td>Prices</td>
<td>Baclofen from $0.36</td>
<td>Baclofen from $0.33</td>
<td>Baclofen from $0.33</td>
<td>Baclofen from $0.33</td>
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<td>Worldwide</td>
<td>Worldwide</td>
<td>Worldwide</td>
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<tr>
<td></td>
<td>Air mail (10-21 days), express courier (2-4 days)</td>
<td>Registered Mail: 7-14 days, express courier (for Canadian only)</td>
<td>Airmail (10-21 days), express courier (for Canadian only)</td>
<td>Worldwide</td>
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<tr>
<td>Prescription</td>
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## Generic For Bactrim

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</tr>
</thead>
<tbody>
<tr>
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<td>Bactrim from 50.55</td>
<td>Bactrim from 50.55</td>
<td>Bactrim from 50.55</td>
</tr>
<tr>
<td>Shipping</td>
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<td>Worldwide Registered Mail, 7+ days, EMS: 2-3 days</td>
<td>Worldwide Airmail (10-21 days), EMS: 2-3 days</td>
<td>Worldwide Trackable Courier Service (5-9 days), Standard International Airmail (10-21 days)</td>
</tr>
<tr>
<td>Payment Methods</td>
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- #1 for customer service (by customer votes)
- #1 for discountulous promotions (by customer)
- Special low entry price (save 15%)
- Free bonus pills for ALL ORDERS
- Money back guarantee
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
  - 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
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.

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