

ECTA POSITION PAPER FEEDBACK ON INITIAL REPORT OF THE WIPO-ICA UDRP REVIEW PROJECT TEAM

I. INTRODUCTION

On April 17, 2025 World Intellectual Property Organization (WIPO) and Internet Commerce Association (ICA) have published Initial Report of the WIPO-ICA UDRP Review Project Team (the “Initial Report”). The Initial Report was prepared with the aim to provide assistance to Internet Corporation for Assigned Names and Numbers (ICANN) in finding a more efficient, focused, and practical way forward by providing crucial background information that can help direct the Phase 2 Review of Rights Protection Mechanisms (the “Phase 2 Review”). Phase 2 Review will be focused on review of the Uniform Domain Name Dispute Resolution Policy (UDRP), ICANN’s first consensus policy that has been in effect since 1999 and which has been relied upon to resolve over 125,000 cases.

Although the Initial Report is prepared under the leadership of WIPO and ICA, the project team has included a diverse group of UDRP experts from around the world in order to explore the possibilities for consensus within the wider group of stakeholders. Having in mind this background, the project team has produced the Initial Report in order to enable ICANN 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 prioritises 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 specialised track.

As a consequence, the Initial Report consists of 23 subjects for consideration divided into 2 tiers: 1) Tier 1 - Where consensus appears to exist (14 subjects for consideration); and 2) Tier 2 – Where there is no consensus but where further work may be undertaken to attempt to bridge disagreements amongst stakeholders (9 subjects for consideration).

The Initial Report is open for comments from relevant public until June 27, 2025. After gathering the comments on Initial Report, the project team will issue the final report that will be submitted to ICANN in order to facilitate Phase 2 Review process.

II. EXECUTIVE SUMMARY

In order to contribute to discussion on UDRP review process, ECTA has issued this Position Paper where comments are provided in respect to key subjects for consideration. ECTA’s position is based on articulated feedback from its members with relevant experience in the domain name disputes from various roles (UDRP panelists, counsels, etc.). Feedback is predominantly gathered from ECTA’s Internet Committee. The Mission of the Internet Committee is to analyse the legal and practical implications of the internet and of new technologies on trade marks and other distinctive signs and to identify solutions respectful of these rights in case of conflicts.

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Although there was a number of interesting topics that were subjects for consideration, ECTA has decided to provide feedback only on those that may be subject to wider debate and which can be of greater influence to functioning of the UDRP system as we know it.

III. COMMENTS

ECTA has collected the feedback in respect to 8 subjects for consideration (3 from Tier 1 and 5 from Tier 2).

Tier 1 – Unanimity of the Project Team

Subject No. 1 – Loser Pays, Costs, Damages

ECTA acknowledges the complexity that introduction of the “Loser Pays” system would create, and aligns with the consensus of the Project Team not to move forward with this suggestion. However, ECTA strongly encourages further discussion on ICANN level regarding the domain name registration process (which is outside of the scope of Phase 2 Review) that would lead to creation of necessary preconditions of this system. Such changes in the domain name registration process would require, at minimum, processes for identifying and verifying true identity of the registrant and securing the funds from registrant's account.

Subject No. 10 – Mediation

ECTA is strongly in favour of introduction of mediation in the UDRP procedure provided that the following conditions are met: 1) such mediation is voluntary; 2) such mediation is designed at dispute resolution service provider level; and 3) dispute resolution service providers are left to decide whether to include mediation option in their supplemental rules.

ECTA suggests that positive experience from some TLDs (such as .ch) should be taken into account when designing the relevant recommendations.

Subject No. 12 – Scope of UDRP

ECTA agrees that scope of the UDRP should not be widened beyond the trade marks or other IP rights, as such expansion, although tempting, could create a lot of uncertainty. It should be also noted that the UDRP practice has already showed some flexibility where some other distinctive identifiers (such as personal names and company names) have been recognised to a certain extent as unregistered or common law trade marks thereby effectively expanding the scope of the UDRP.

Tier 2 – No Unanimity of the Project Team, but Consensus Potentially Achievable

Subject No. 15 – Appeals Layer

ECTA strongly supports introduction of the appeals layer within the UDRP. As correctly noted by the Project Team, introduction of this additional layer can significantly contribute to overall stability of the UDRP system and it is likely that it would further diminish the already rare

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cases of court review of the UDRP decisions. ECTA holds that appeals procedure should not be a default remedy available for all cases (unlike court proceedings which in any event should remain available in all cases due to access to court issues), but more of an exceptional remedy that can be used under predefined circumstances (e.g. decision issued by a single-member panel, default decisions, etc.). Understanding the complexity of this issues and a need to properly design the appeals layer, ECTA agrees with the project team that this subject should be left for secondary track of the Phase 2 Review.

Subject No. 16 – Changing “and” to “or”

ECTA holds that this is one of the most delicate questions raised in the UDRP review process and that introduction of such change without proper review could disbalance the UDRP and create potential problems in the future. Being aware that many ccTLD polices recognise that it is sufficient to prove either registration or use of the disputed domain name in bad faith, ECTA would suggest thorough review of decisions rendered under such polices and potential impact that adoption of such system would have on the UDRP. In that sense, ECTA believes that, at the moment, there is no sufficient information for achieving consensus on this subject and agrees with the Project Team that this subject should be put on a secondary track of the Phase 2 Review.

Subject No. 18 – Expedited or Summary Procedures

ECTA is in favour of introduction of the expedited or summary procedures within the UDRP that would enable an even quicker resolution of the clear-cut cases and/or default cases. It is understandable that selection of appropriate mechanism might be a difficult task and that such mechanism should not interfere with the existing mechanisms (such as the Uniform Rapid Suspension - URS). ECTA suggests using the positive experience from other TLDs, such as the experience with summary proceedings for .uk ccTLD.

Subject No. 19 – Remedy: True Cancellation

ECTA is strongly in favour of the introduction of true cancellation as a new remedy in the UDRP provided that a clear guidance on lifting the cancellation is issued and adopted by ICANN.

Subject No. 21 – Codification of Case Law

ECTA welcomes the idea of pan-provider codification of case law and generally supports collaboration among the providers and harmonising their practices as much as possible.

IV. FINAL REMARKS

ECTA supports the efforts done by WIPO-ICA Project Team in order to facilitate Phase 2 Review process before ICANN and hopes that these comments will contribute to shaping of the final report that would lead to widely acceptable conclusion of the UDRP review process.

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ECTA, which was formed in 1980, is an organisation concerned primarily with intellectual property matters. ECTA has approximately 1,300 members, coming from all the Member States of the EU, with associate Members from more than 50 other countries throughout the world.

ECTA brings together those practicing in the field of IP, in particular, trade marks, designs, geographical indications, patents, copyright and related matters. These professionals are lawyers, trade mark and patent attorneys, in-house lawyers concerned with IP matters, and other specialists in these fields.

The extensive work carried out by the Association, following the above guidelines, combined with the high degree of professionalism and recognised technical capabilities of its members, has established ECTA at the highest level and has allowed the Association to achieve the status of a recognised expert spokesman on all questions related to the protection and use of trade marks, designs and domain names in and throughout the European Union, and for example, in the following areas:

- Harmonization of the national laws of the EU member countries;
- European Union Trade Mark Regulation and Directive;
- Community Design Regulation and Directive;
- Organisation and practice of the EUIPO.

In addition to having close links with the European Commission and the European Union Intellectual Property Office (EUIPO), ECTA is recognised by WIPO as a Non-Government Organisation (NGO).

ECTA does also take into consideration all questions arising from the new framework affecting trade marks, including the globalization of markets, the explosion of the Internet and the changes in the world economy.