



WIPO Conference on
Intellectual Property Questions
Relating to the ccTLDs

The UDRP and the Role of
Alternative Dispute
Resolution

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Outline

- *Problem:* conflict between trademarks and domain names
 - *Solution:* administrative dispute resolution
 - *Implementation:* WIPO domain name dispute resolution service
 - *Experience:* one year of WIPO cases
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Trademark-Domain Name Conflict

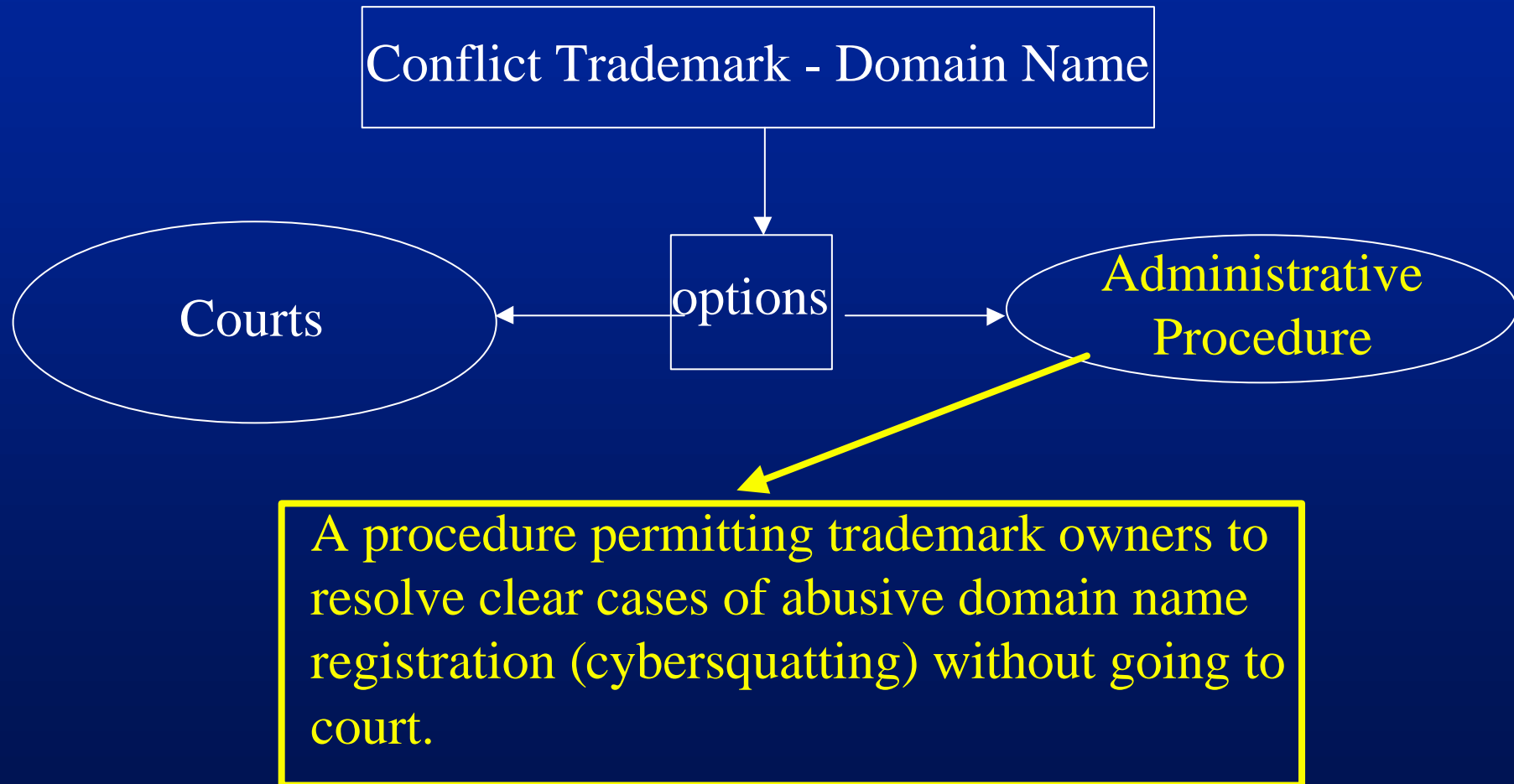
- *Trademarks*

- 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



Administrative 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 principles
 - Registrar *implements* panel decision
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Uniform Domain Name Dispute Resolution Policy (UDRP)


- *Adopted* by ICANN effective December 1999
 - *Applicable* to gTLDs: .COM, .NET, .ORG
 - Possible application to new gTLDs
 - May be used by ccTLDs through voluntary adoption
 - *Mandatory* part of registration terms and conditions
 - Retro-active to include existing registrations
 - *Administrative*
 - Complainant can go to court or use UDRP
 - Both parties can go to court after UDRP
 - *Remedies*
 - Transfer or cancellation only
 - No monetary damages
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UDRP Panel 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




WIPO UDRP Implementation

- Full Web site including model Complaint and model Response
 - Online case filing and communication (E-mail and Web forms)
 - Multilingual case administration
 - Non-profit fees
 - Procedural advice for registrars
 - WIPO Panelists
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WIPO UDRP Panelists

- Intellectual property and Internet specialists
 - Posted detailed resumes
 - 200 members from 37 countries in all regions
 - Including ccTLD-recommended neutrals
 - Multilingual capacity
 - Modest lump-sum fee
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WIPO gTLD Experience

- *Received cases (15-2-01): 2087 (+ 60% of UDRP cases)*
 - over 3500 domain names
 - famous marks, small and medium enterprises, individuals
 - parties from 74 countries
 - *Resolved cases (in 2000): 1286 (70%)*
 - WIPO panel decisions: 1007
 - 80 % transfer rate
 - party settlement: 279
 - *Completion time per case: within 2 months*
 - *Communication:*
 - Over 1 million monthly Web site hits by December
 - Over 40,000 online case communications
 - Multiple case languages
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WIPO ccTLD Experience

- Intellectual property advice to 44 ccTLDs
 - WIPO dispute service adopted by 18 ccTLDs
 - 27 cases received, including consolidated ones
 - Inclusion of ccTLD-recommended neutrals
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Conclusions

- Enormous demand
 - Highly effective process
 - Acceptance online character
 - Reduced registrar burden
 - Enhanced user confidence
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Developments

- Growing WIPO case load
- New gTLDs
- “Multilingual” domain names
- *<http://arbiter.wipo.int/domains>*

