



## WIPO conference on IPR in the ccTLDs: The perspective of the registration authorities

**Nicholas Wood**

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# Intellectual Property Protection Models in the ccTLDs

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What is the current position of IP owners?

What are the factors that influence domain name infringers to select a country?

What are the factors that influence registry design in relation to IP protection?

Can ccTLD registries be classified?

- Three types of registration model
- Six types of Dispute Prevention model

•Conclusions/Questions

**Lest we forget:**

GreatDomains.com<sup>™</sup>  
Where names mean business

Home Customer Service: 1-800-478-8763 (U.S./Canada) & 1-818-308-2200 (outside U.S.), M-F, 6AM-Midnight PST.

NEW Users

**Trade Domains**  
Buy a Domain  
Sell a Domain  
Register a Domain  
Appraisal Information  
Website Valuation  
Escrow Service

Got your .tv domain yet? type your domain  
dotTV www.  .tv GO

**Details for**  
**bmw.tv**  
Details for this Domain Name are shown below.

**Asking Price Make Offer**  
Make Offer (U.S. Dollars) \$  Submit Offer

Sorry, MICROSOFT.WS is taken.

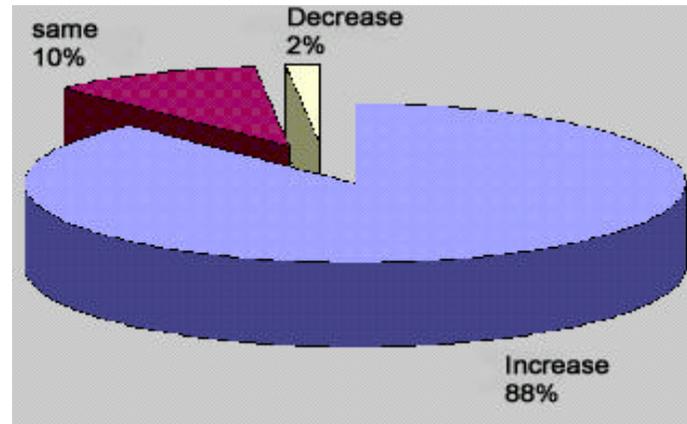
These are available:

M-I-C-R-O-S-O-F-T.WS	MICROSOFTMICROSOFT.WS	1MICROSOFT.WS
1-MICROSOFT.WS	1STMICROSOFT.WS	1ST-MICROSOFT.WS
4MICROSOFT.WS	4-MICROSOFT.WS	MICROSOFT-AUCTION.WS
MICROSOFT-BIZ.WS	MICROSOFT-BUSINESS.WS	MICROSOFT-CENTRAL.WS
MICROSOFT-DOT.WS	MICROSOFT-FIRM.WS	MICROSOFT-INTERNATIONAL.WS
MICROSOFT-NET.WS	MICROSOFT-OFFICE.WS	MICROSOFT-ONLINE.WS
MICROSOFT-SEARCH.WS	MICROSOFT-SHOP.WS	MICROSOFT-SITE.WS
MICROSOFT-STORE.WS	MICROSOFT-SUCKS.WS	MICROSOFT-SUX.WS
MICROSOFT-USA.WS	MICROSOFT-WEB.WS	MICROSOFT-WWW.WS
MICROSOFTAUCTION.WS	MICROSOFTBIZ.WS	MICROSOFTBUSINESS.WS



## The experience of IP practitioners

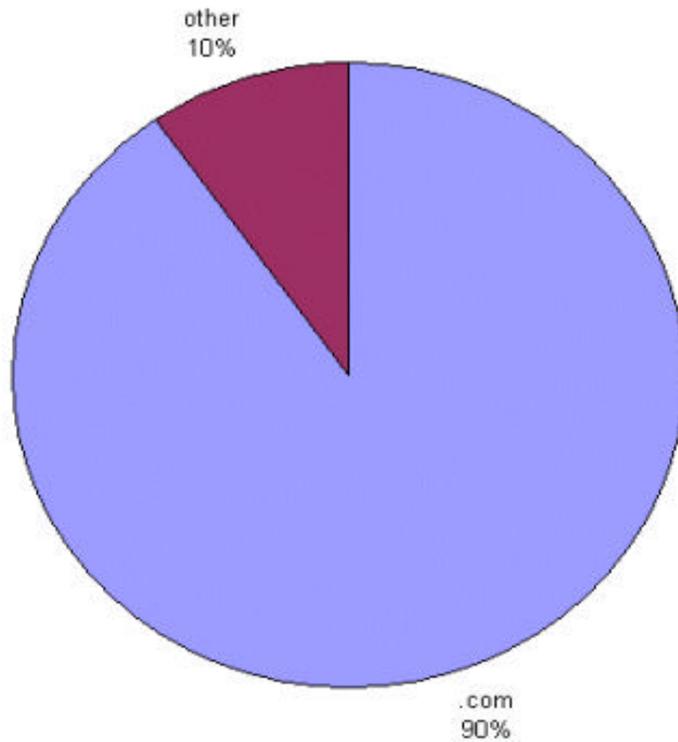
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- Survey of 4000 IP practitioners Summer 2000
- 356 responses from over 25 jurisdictions
- 88% saw their involvement with IP Protection on the Internet increasing over the next 12 months
- Only 32% had Internet IP budget
- 30% had no dedicated personnel for IP on the internet
- 43% spend more than 20 hours a week on internet matters

## The experience of domain name infringement 1

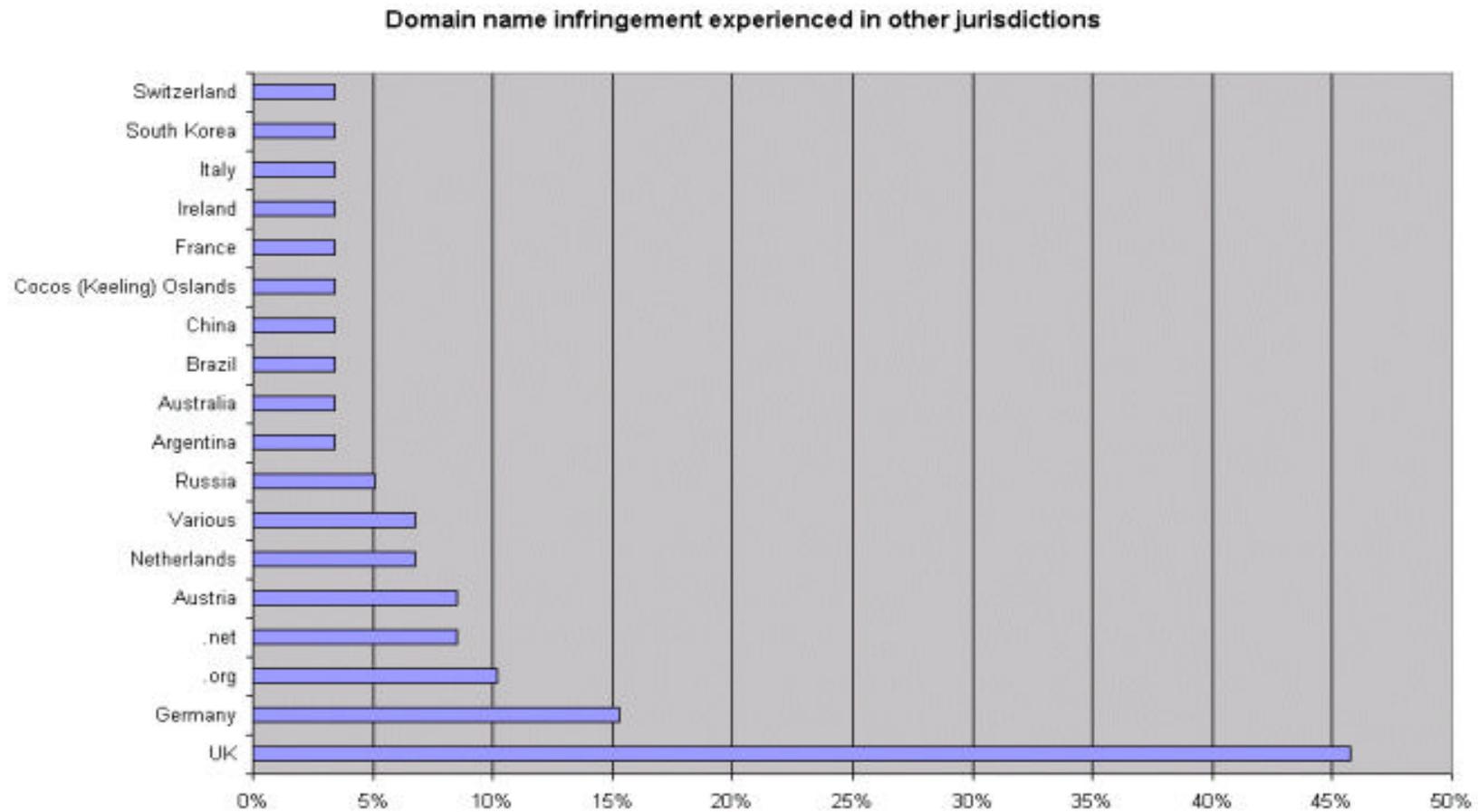
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90% had experienced Internet infringement of whom 93% suffered domain name infringement

## The experience of domain name infringement 2- A world phenomenon

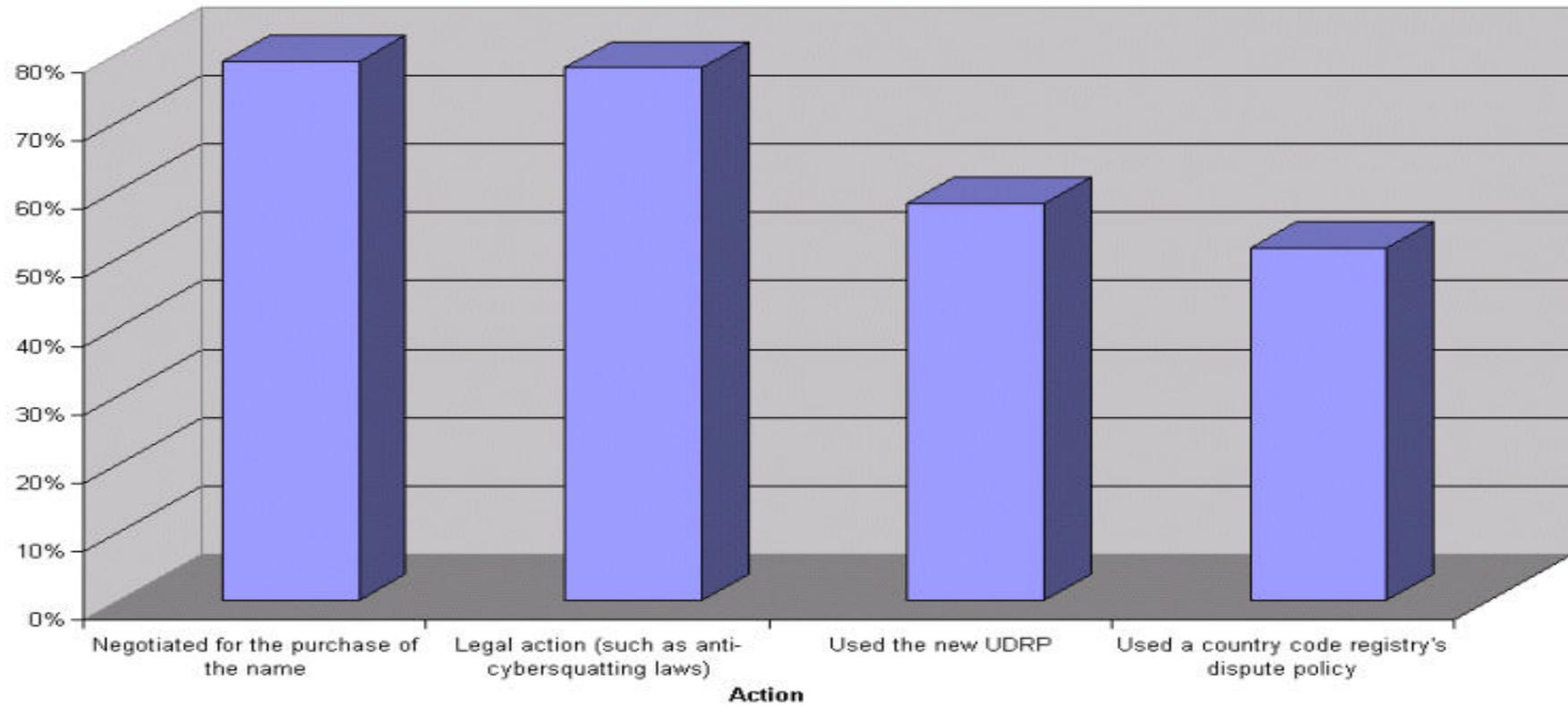
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## The experience of domain name infringement 3: Tackling infringers

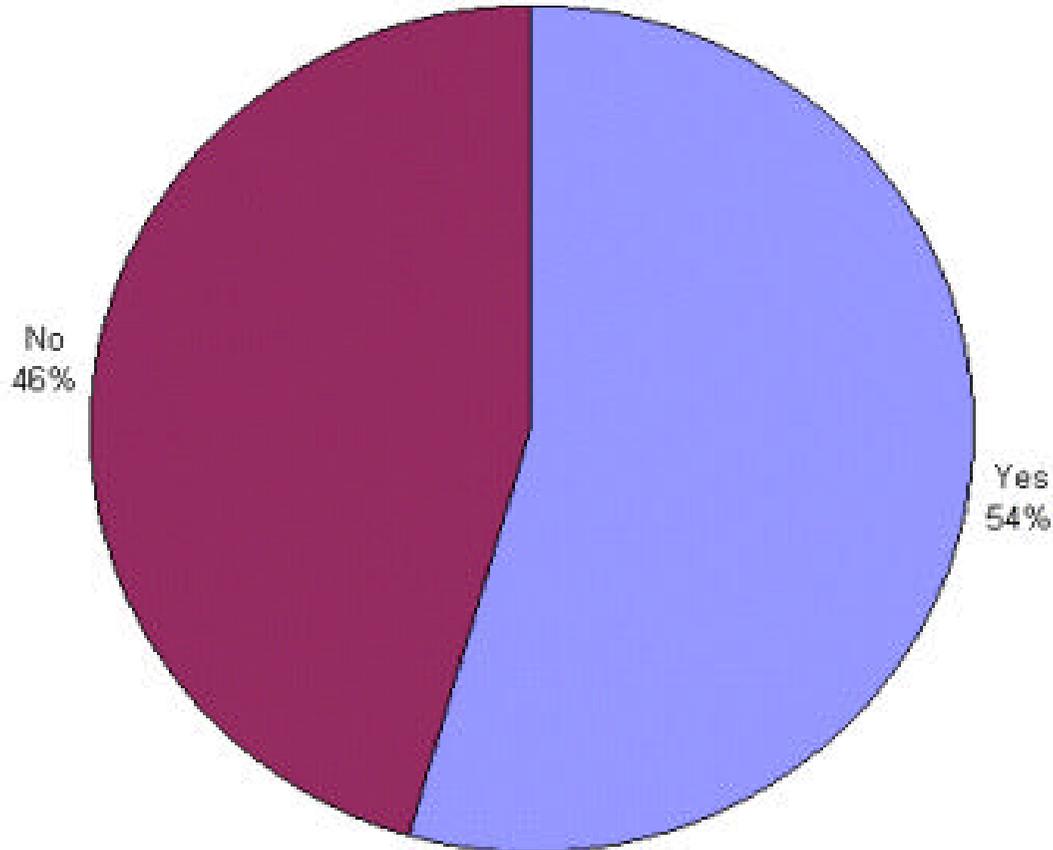
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What action did you take in response to this infringement?



## The experience of buying domains 4: Third Party Purchases

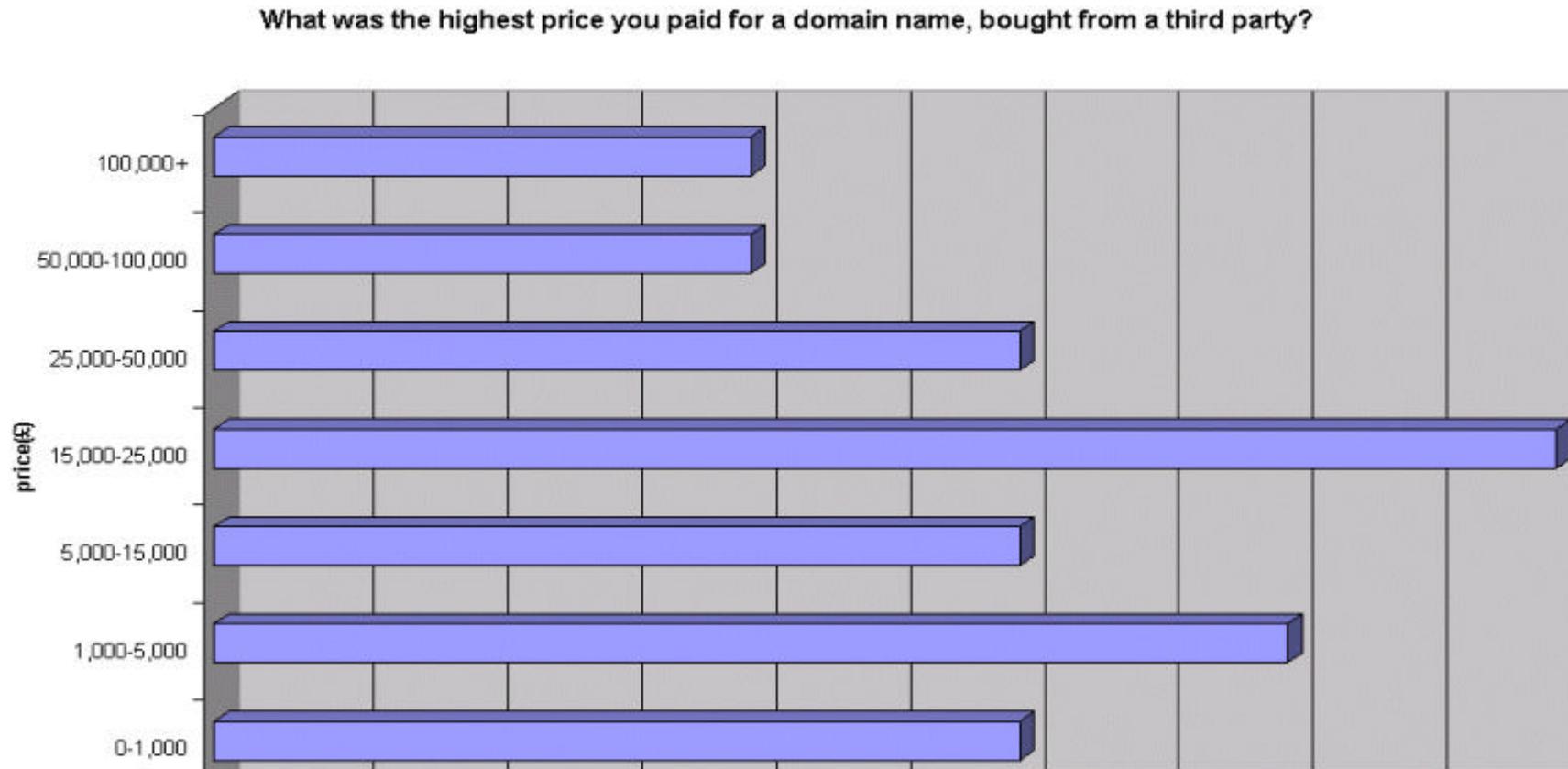
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**54% had bought names from third parties (Note: third parties are not always infringers)**

## The experience of buying domains 5: How much did that name cost?

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## Factors that influence the infringer in choosing a ccTLD:

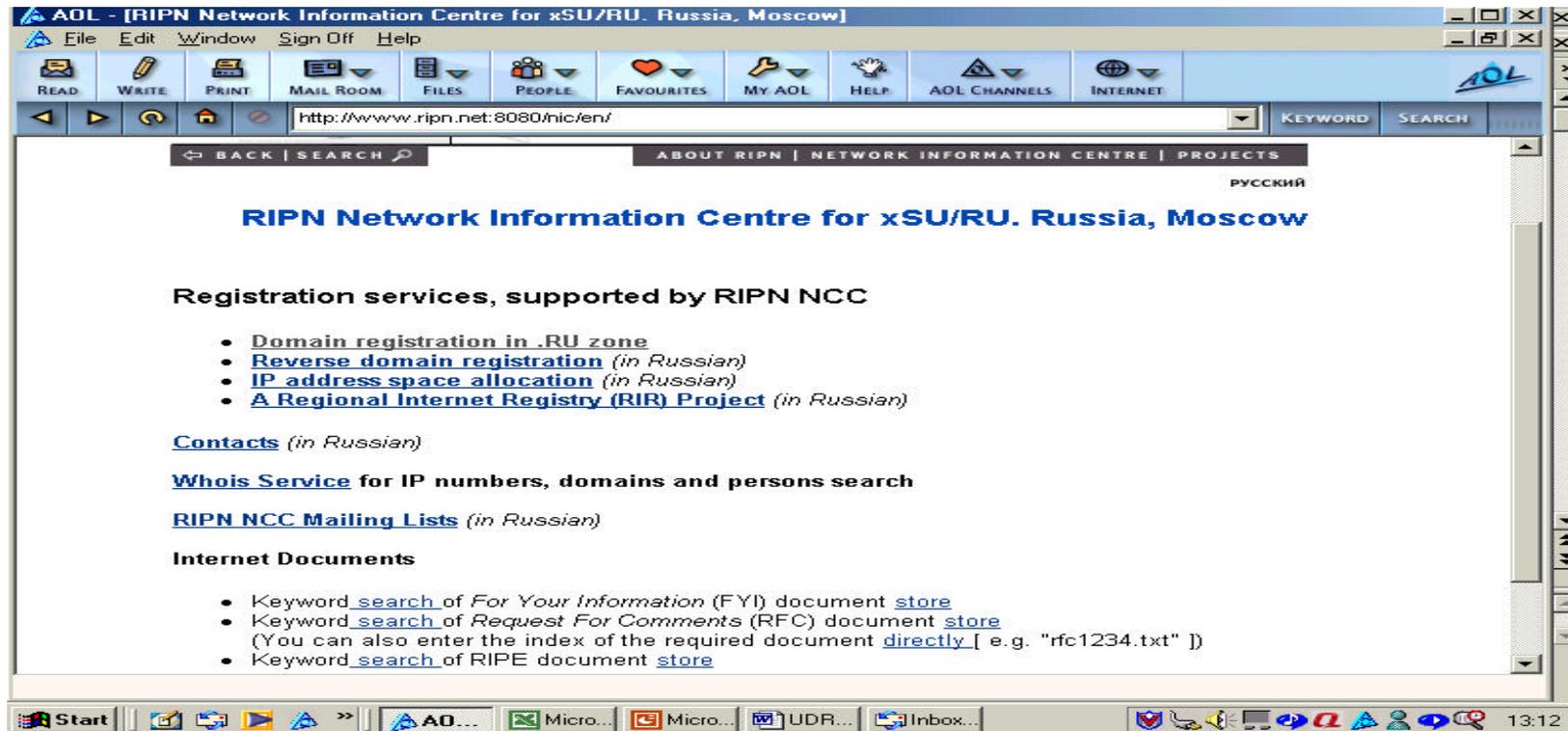
### The buffet approach

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- Ease of application: e-mail template or web form preferred
- Ease of payment: online with credit card preferred
- Registries that charge a small amount for a domain name
- Unrestricted registries that do not require applicants to have a local presence
- Fast registries where new registrations appear on domain servers within 24 hours
- Registries that are liberalising or that charge only a small fee for a name
- Registries that do not provide whois servers (or much information on registrants)
- Registries where other infringers congregate
- Registries in jurisdictions where overseas mark owners would find it exceptionally difficult or expensive to go to court

Help Yourself!

## Russia (.ru):



Unrestricted, first come first served registry, limiting its liability  
Referring complainants to "Normal Legal Methods"

## What influences the design of a registry model in its approach to IPR protection?

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- Available financial resources: registries reflect world economics
- The skills of the staff – often technically expert not legally qualified
- Private sector investment:
  - Lately positively: .Tuvalu, Western Samoa
  - Sometimes negatively in the search for a return on investment
- The need for speed: how to balance the need for a fast automated process without human analysis with measures to protect IP?
- Prior experience of domain name disputes: flexibility and goodwill of informal systems of mediation have been exploited
- The strength/importance of the registration agent lobby vs. the trade mark lobby

## Can ccTLD registries be classified?

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### **Net Searchers classification of registry type to assist in global filing:**

- *A jurisdictions*: Unrestricted registries, open to all (.UK, .MX, .ZA)
- *B jurisdictions*: Semi-restricted registries, where non-national applicants in particular need to show a right to a name (.DE, .TR, .GH)
- *C jurisdictions*: Restricted registries allowing only those with a right to a name in that jurisdiction to register (.PT, .SA, .BG)

### **These classifications inform but do not define models of protection for IPR:**

- Some A countries use UDRP (.MX) or plan new measures to combat infringement (.UK) whilst others are infringers' favourites (.RU)
- Some B countries like Germany feature many local infringers because German nationals can register without restriction but no overseas infringers
- Pre-registration diligence in C countries prevents infringement

### **Therefore an alternative form of classification required**

## A classification of ccTLD registries by models of protection for IPR?

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- The UDRP Registry Model
- The Interventionist Registry
- The Home Team Registry
- The Prophylactic Registry
- The Disinterested Registry
- The Not Interested Registry

## What are the Models of Protection?

### 1: The UDRP Registry Model

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UDRP itself:

- Successful at tackling bad faith registration by pirates
- Popular with 19 ccTLDs because:
  - “It’s a no-brainer – it resolves a problem”
  - At end of 2000: 16 cases filed
- Popular with IP community because:
  - Quicker and cheaper than the courts
  - Mostly fair
  - International in design and implementation
  - A useful chip in negotiating with infringers:

## What are the models of protection?

### 1: The UDRP Registry Model

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#### UDRP models suit

- Unrestricted registries where no pre-registration checks carried out (or all registries?)
- Registries that accept on-line registration
- Registries with limited resources

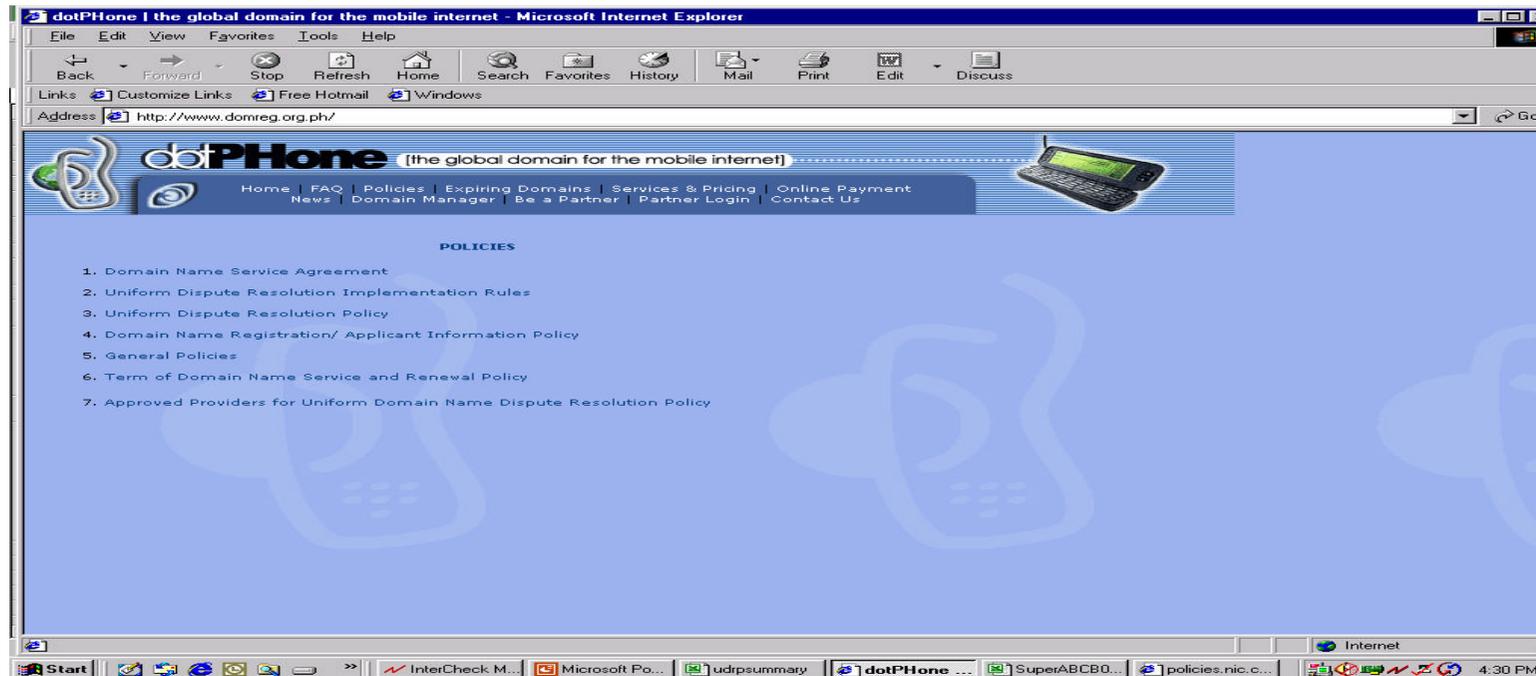
#### Variations on UDRP possible

#### Examples

- Philippines
- Romania

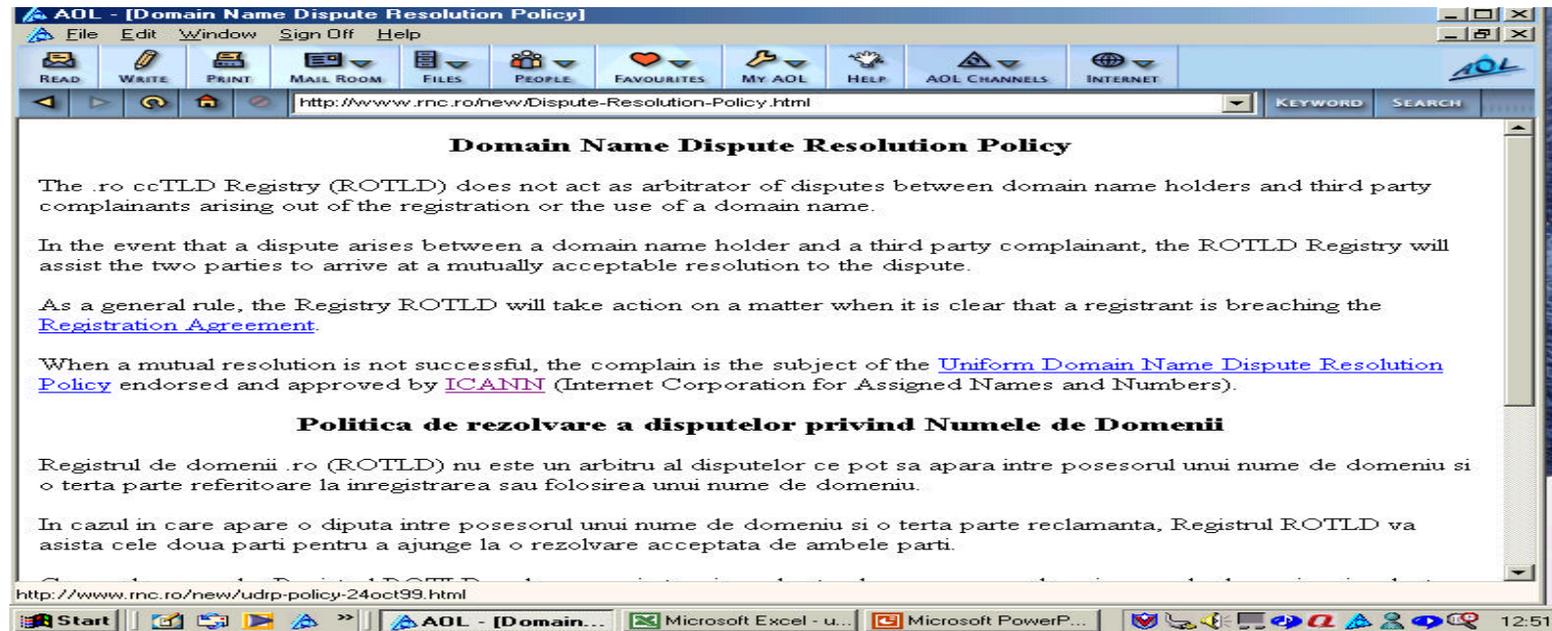
## Philippines (.ph) - UDRP Straight Up

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Unrestricted registry that uses UDRP without variation

## Romania (.ro) – UDRP with a twist:



“The .ro ccTLD Registry (ROTLD) does not act as arbitrator of disputes between domain name holders and third party complainants arising out of the registration or the use of a domain name. In the event that a dispute arises between a domain name holder and a third party complainant, the ROTLD Registry will assist the two parties to arrive at a mutually acceptable resolution to the dispute. As a general rule, the Registry ROTLD will take action on a matter when it is clear that a registrant is breaching the Registration Agreement. When a mutual resolution is not successful, the complain is the subject of the Uniform Domain Name Dispute Resolution Policy endorsed and approved by ICANN (Internet Corporation for Assigned Names and Numbers). “

## What are the models of protection?

### 2: The Interventionist Registry Model

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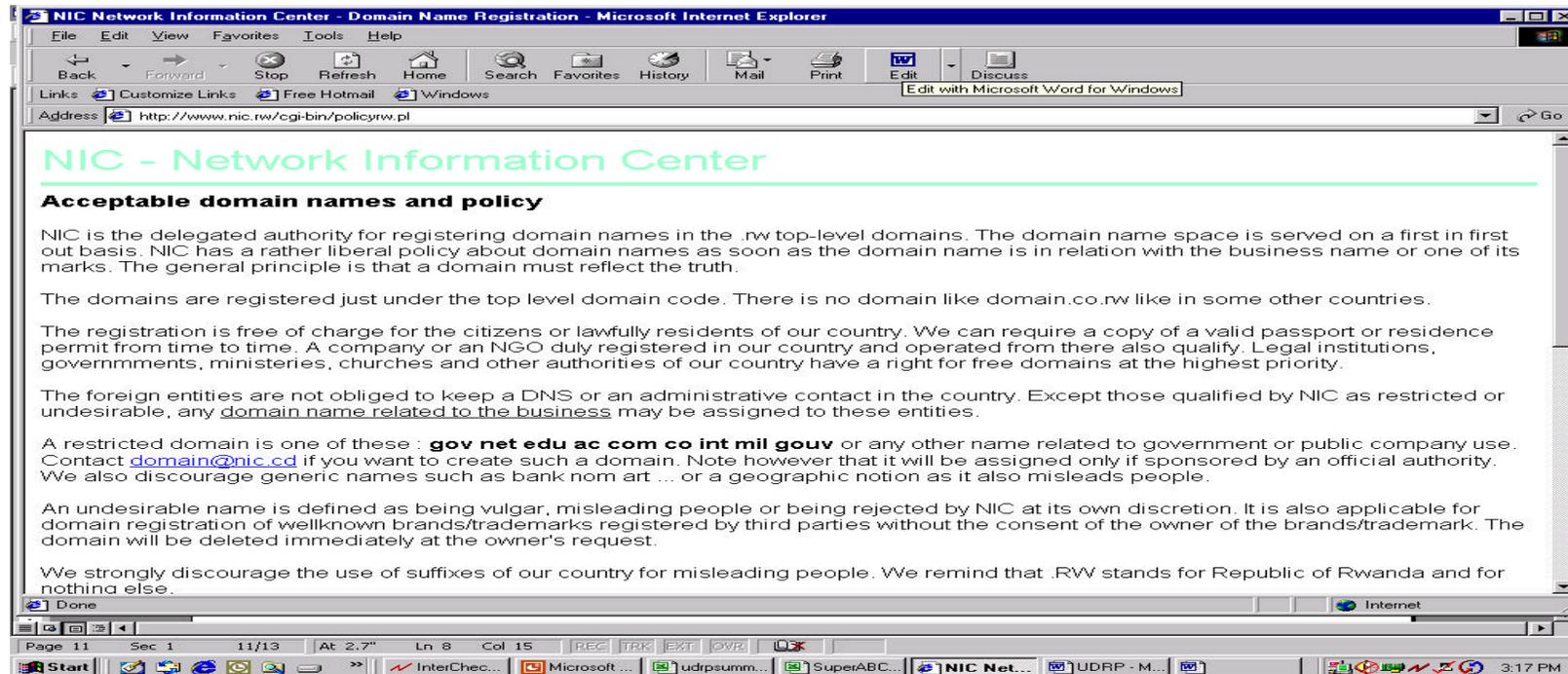
#### Interventionist registries:

- Recognise the menace of domain name infringement
- Devise systems that suit local laws and local circumstances
- Will intercede when abuse comes to their attention
- Focus on registered trade mark rights

#### Examples of interventionist registries

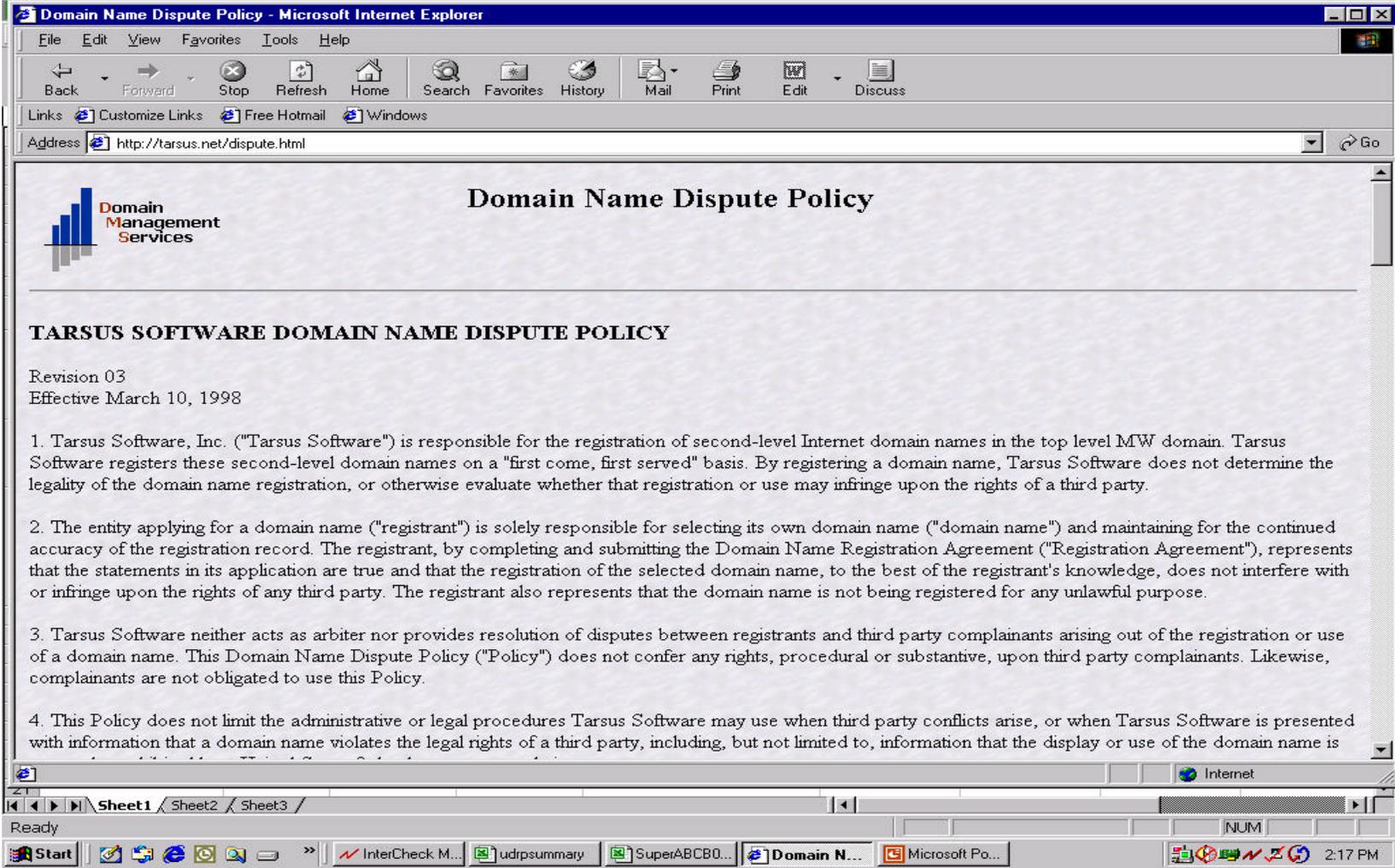
- Rwanda
- Gambia

## Rwanda (.rw)



“An undesirable name is defined as being vulgar, misleading people or being rejected by NIC at its own discretion. It is also applicable for domain registration of wellknown brands/trademarks registered by third parties without the consent of the owner of the brands/trademark. The domain will be deleted immediately at the owner's request....”

# Gambia (.gm)



## The Gambia – an interventionist registry

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**Dispute Procedures.** In those instances where a third party claim is based upon and complies with Section 8(a and b), Tarsus Software may apply the following procedures, which recognize that trademark ownership does not automatically extend to the right to register a domain name and which reflect no opinion on the part of Tarsus Software concerning the ultimate determination of the claim:

(a) Tarsus Software shall determine the creation date of the registrant's domain name registration ("domain name creation date").

(b) If the registrant's domain name creation date precedes the effective date of the valid and subsisting certified registration owned by the complainant, Tarsus Software will take no action on the complainant's request.

(c) If the domain name creation date is after the effective date of the valid and subsisting certified registration owned by the complainant, then Tarsus Software shall request from the registrant proof of ownership of registrant's own registered trademark or service mark by submission of a certified registration, of the type and nature specified in Section 8(a) above. The certified registration must be owned by the registrant and the effective date must be prior to the date of any third party's notice of a dispute to the registrant. If the registrant satisfies the requirements of this Section 9(c), Tarsus Software will take no further action on the complainant's request.”

“Trademark ownership does not automatically extend to the right to register a domain name..”

## What are the models of protection?

### 3: The Home Team Registry Model

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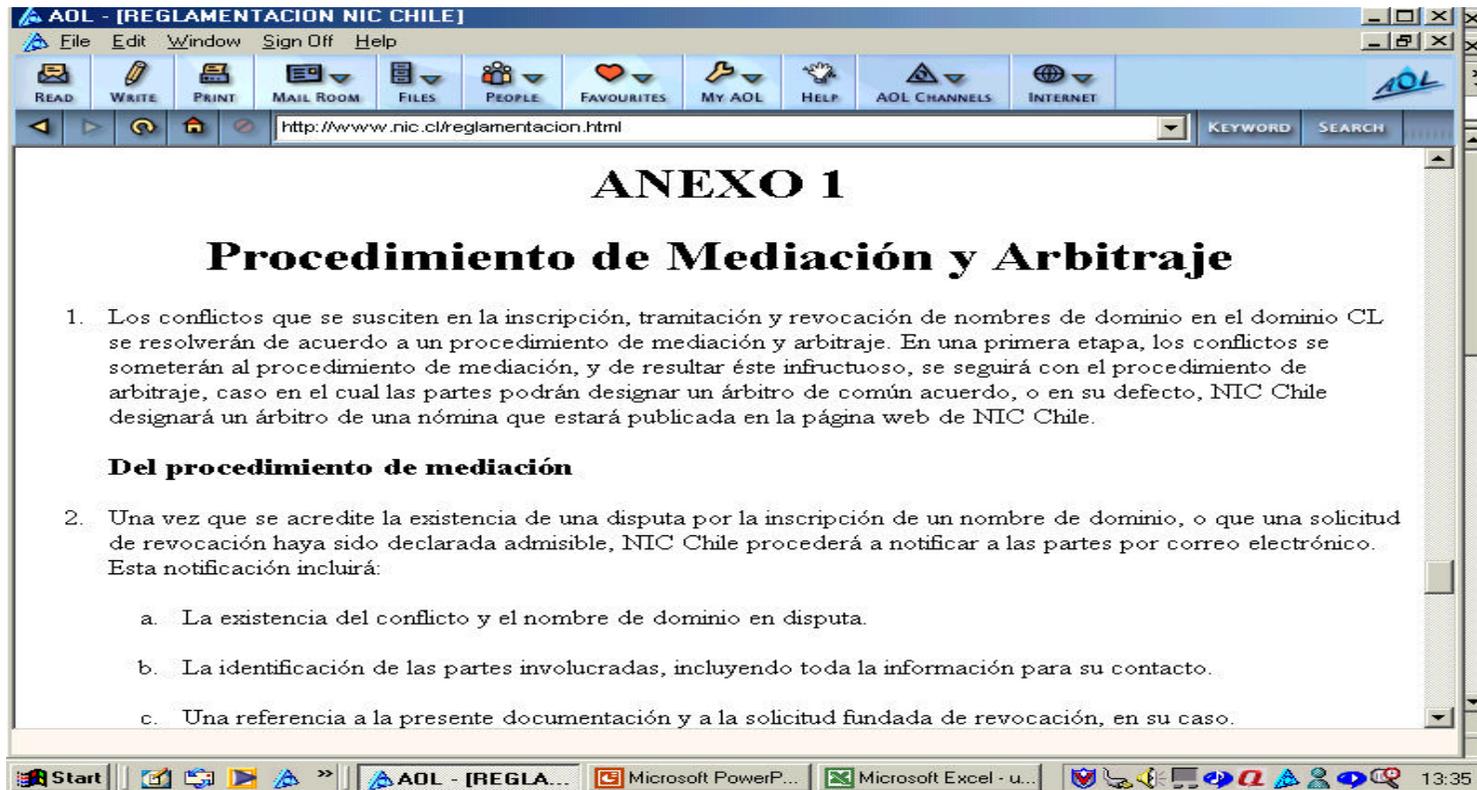
Home Team registries:

- Use local panels and local advisors
- Balance the openness of the registry with a dispute procedure that offers complainants a path to resolution within a fixed time

Examples

- Chile
- Denmark
- UK

## Chile (.cl)



**ANEXO 1**

### Procedimiento de Mediación y Arbitraje

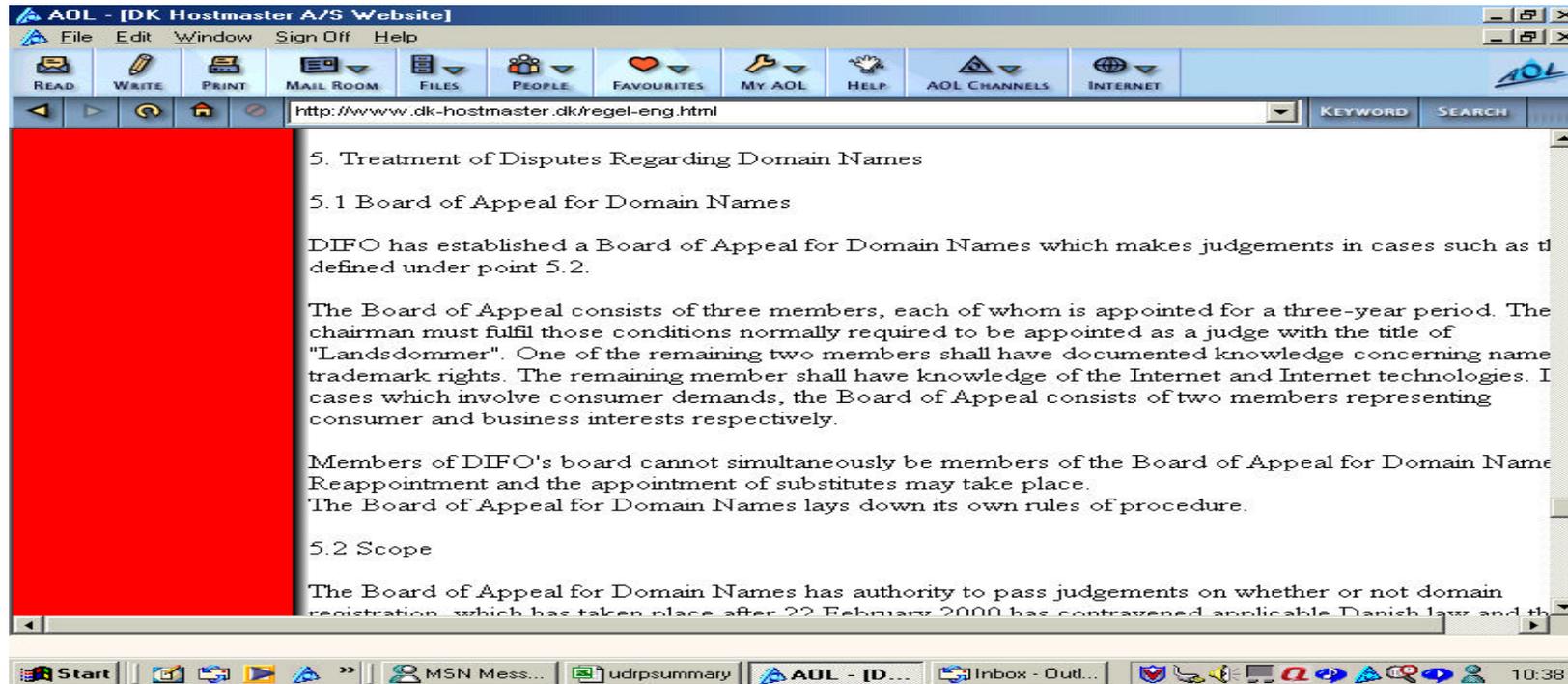
1. Los conflictos que se susciten en la inscripción, tramitación y revocación de nombres de dominio en el dominio CL se resolverán de acuerdo a un procedimiento de mediación y arbitraje. En una primera etapa, los conflictos se someterán al procedimiento de mediación, y de resultar éste infructuoso, se seguirá con el procedimiento de arbitraje, caso en el cual las partes podrán designar un árbitro de común acuerdo, o en su defecto, NIC Chile designará un árbitro de una nómina que estará publicada en la página web de NIC Chile.

**Del procedimiento de mediación**

2. Una vez que se acredite la existencia de una disputa por la inscripción de un nombre de dominio, o que una solicitud de revocación haya sido declarada admisible, NIC Chile procederá a notificar a las partes por correo electrónico. Esta notificación incluirá:
  - a. La existencia del conflicto y el nombre de dominio en disputa.
  - b. La identificación de las partes involucradas, incluyendo toda la información para su contacto.
  - c. Una referencia a la presente documentación y a la solicitud fundada de revocación, en su caso.

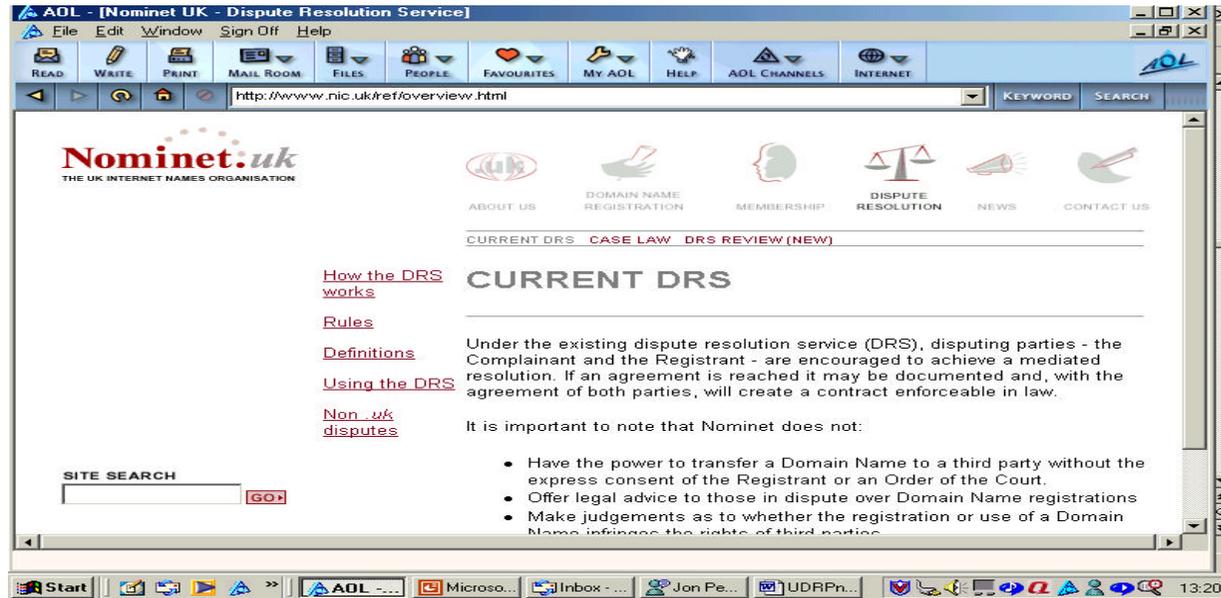
Nic.cl provides an objection system and a binding mediation service, using local experts who publish judgements on line and award costs

## Denmark (.dk)



3 person Board of Appeal appointed for 3 years; judgements take 14 days; if a name contravenes registration rules or Danish law it may be deleted, transferred or suspended

## United Kingdom (.co.uk)



Currently operates mediation service; new DR service under consideration features mediation then binding arbitration using local panellists focussed upon bad faith registration with a right of appeal. Names registered or used in bad faith can be challenged. Freedom of speech defence.

## What are the models of protection?

### 4: The Prophylactic Registry Model

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#### Prophylactic registries:

- Deter infringers through strict pre-registration requirements
- Require documentation to support an application for a name
- May restrict registration to locally based organisations
- May limit the number of registrations an organisation can have

#### Examples

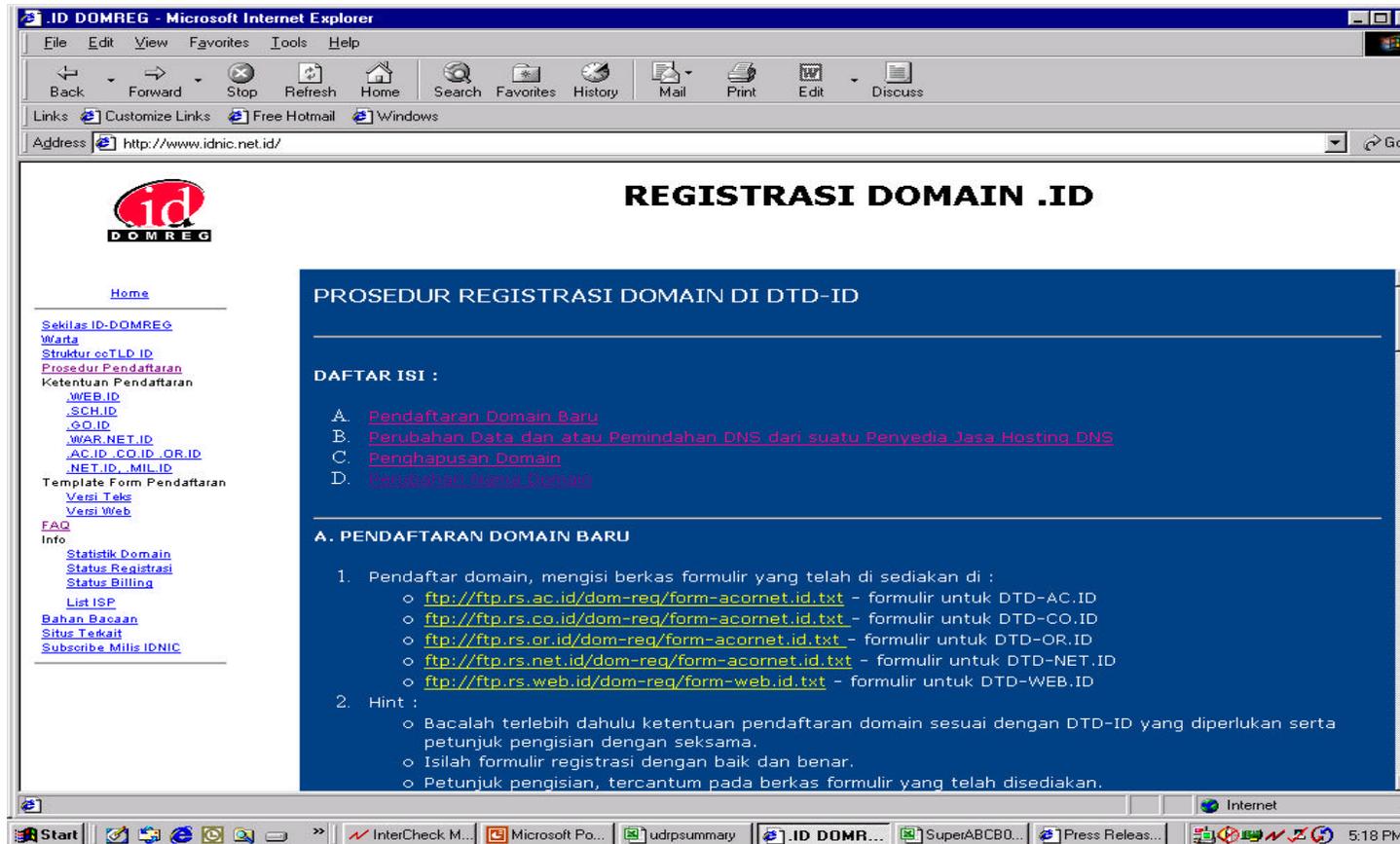
- Colombia
- Indonesia
- Ireland
- Lebanon

## Colombia (.com.co)



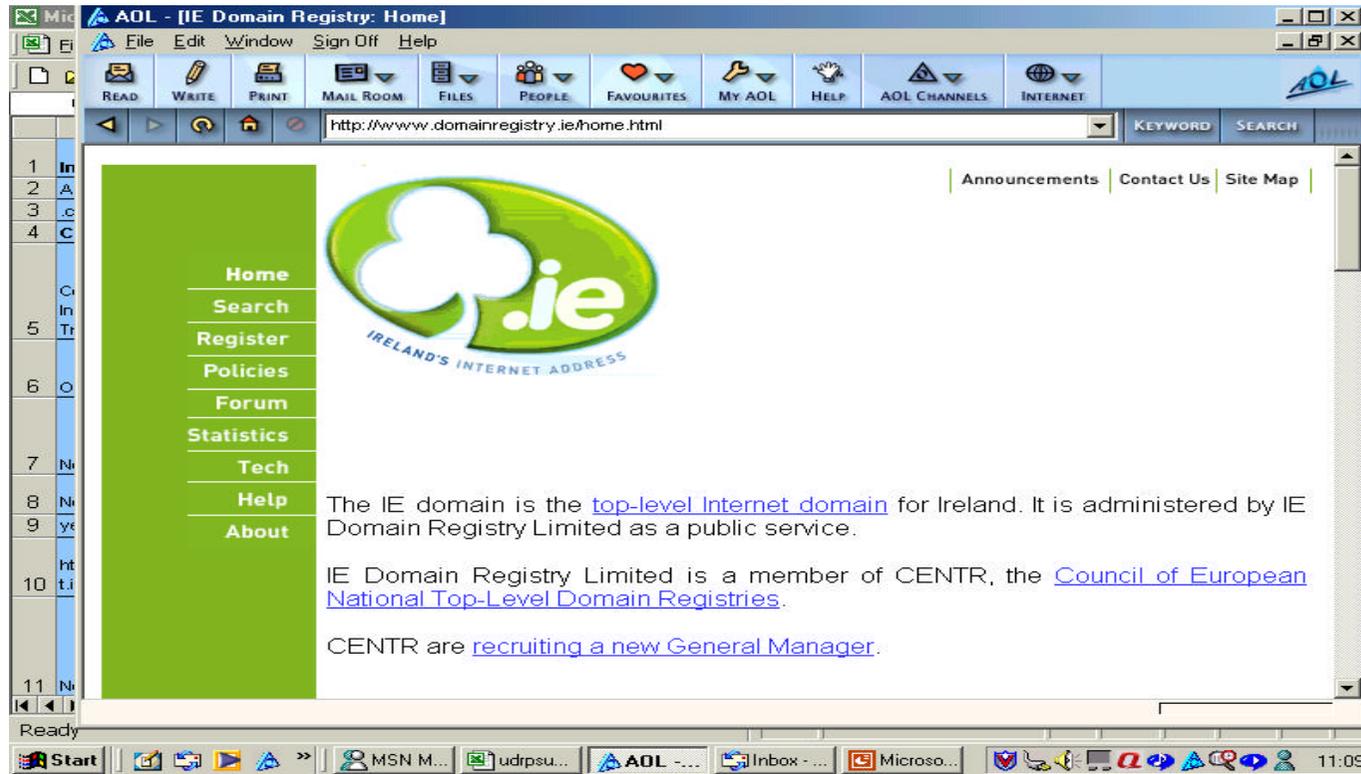
Generally, only company names and trade marks are registered but a Service or product name may be allowed via written submission

# Indonesia (.co.id)



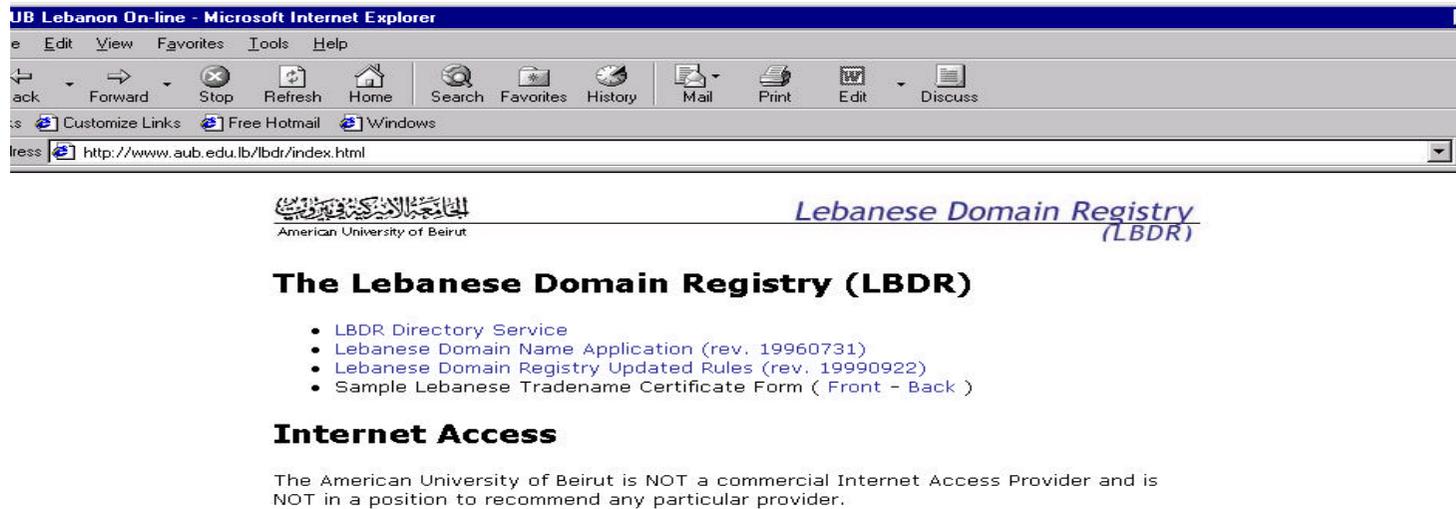
Online application but for company name or trade mark only

## Ireland (.ie)



Online application must be supported by documentation. Only a company name, registered business name or trade mark allowed

## Lebanon (.lb)



The screenshot shows a Microsoft Internet Explorer browser window with the title "UB Lebanon On-line - Microsoft Internet Explorer". The address bar displays "http://www.aub.edu.lb/lbdr/index.html". The page content includes the logo of the American University of Beirut and the text "Lebanese Domain Registry (LBDR)". Below this, the heading "The Lebanese Domain Registry (LBDR)" is followed by a bulleted list of services: "LBDR Directory Service", "Lebanese Domain Name Application (rev. 19960731)", "Lebanese Domain Registry Updated Rules (rev. 19990922)", and "Sample Lebanese Tradename Certificate Form ( Front - Back )". A section titled "Internet Access" contains the text: "The American University of Beirut is NOT a commercial Internet Access Provider and is NOT in a position to recommend any particular provider."

Registration open only to local companies for company names or trade marks;  
electronic application must be supported by company or trade mark certificates



The screenshot shows a Windows taskbar with several open applications: "InterCheck Monitor", "Microsoft PowerP...", "udrpsummary", and "AUB Lebanon...". The browser window in the background shows the URL "http://www.aub.edu.lb/lbdr/search.html".

## What are the models of protection?

### 5: The Disinterested Registry model

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#### Disinterested registries

- Protect their independence as neutral third parties acting in good faith
- Do not want to be involved in settling disputes
- Prefer disputes to be settled through the courts

#### Examples

- Luxembourg
- New Zealand
- Singapore

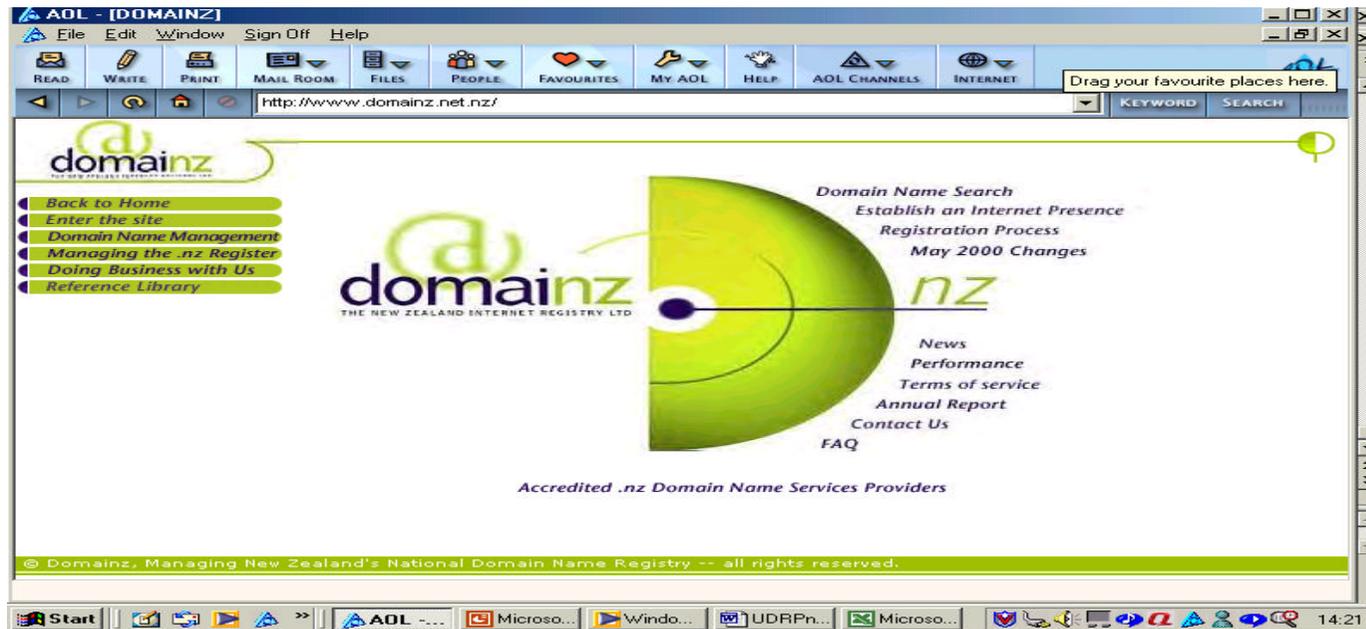
## Luxembourg (.lu)

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- Solving conflicts
- When a domain name has been registered by another entity or is in progress of registering, **it is the responsibility of the applicant to research the existing repository and pursue any litigation which may be necessary against the existing registrant, should the applicant believe that the existing registrant has no right to the domain.**
- Entities and registrants acknowledge and agree that DNS-LU cannot act as arbiter of disputes arising out of the registration and use of domain names. Registration of a pending application for a domain name will be suspended by DNS-LU in case of a conflict with another pending application or an already registered active or inactive domain name until the conflicting registrants present a written and duly signed settlement of the conflict or a court decision resolving the dispute in favour of one of the conflicting parties.

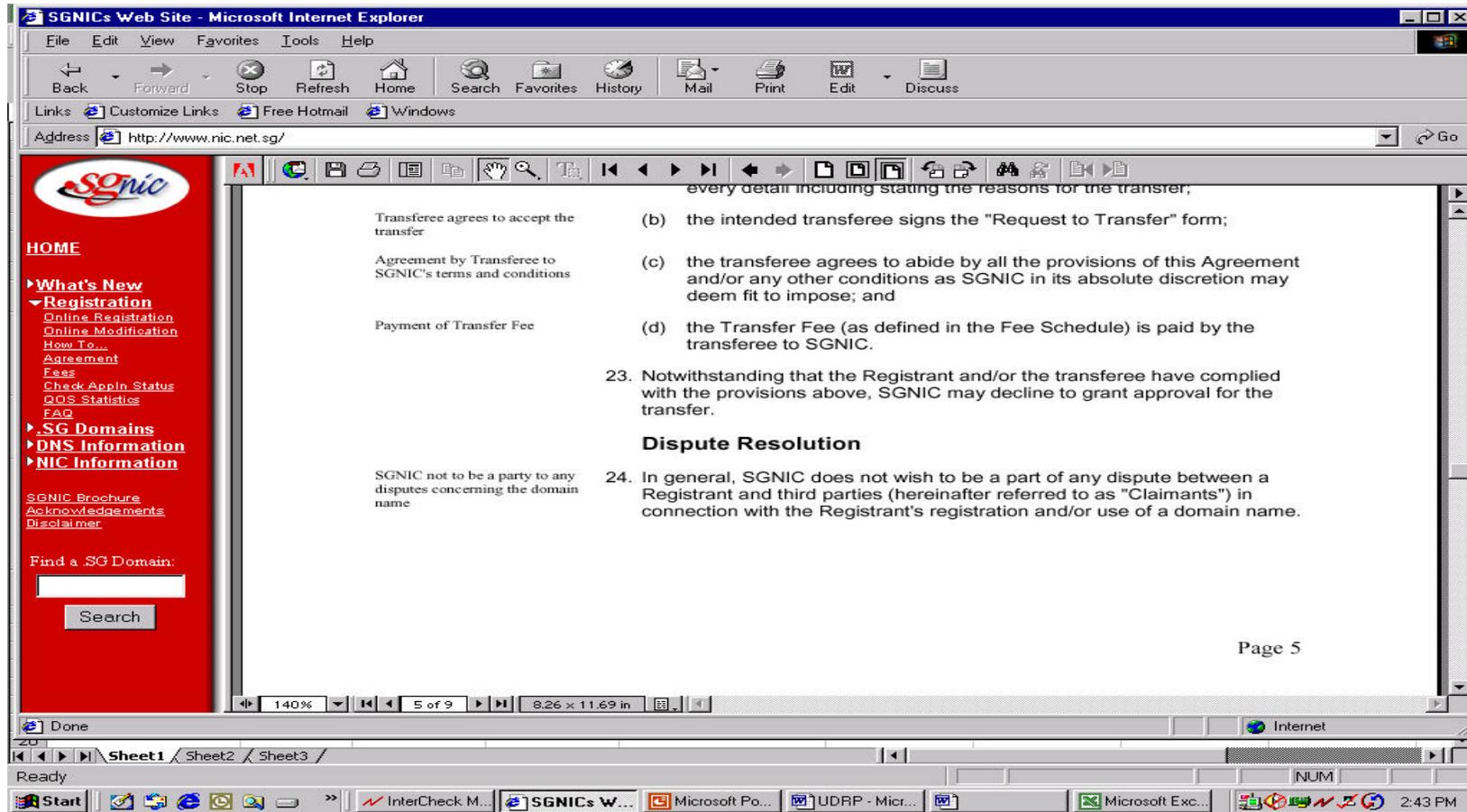
DNS-LU “is exempted from any and all responsibility for the verification of rights to a name”

## New Zealand (.co.nz)



***“When I register a domain name, what's the legal position?  
Registration means that you enter into a contract with Domainz.  
As part of that contract, you warrant that you have rights to use  
the name, and you indemnify us for any actions or disputes that may arise. “***

# Singapore(.com.sg)



“SGNIC does not wish to be a part of any dispute”

## What are the models of protection?

### 6: The Not Interested Registry Model

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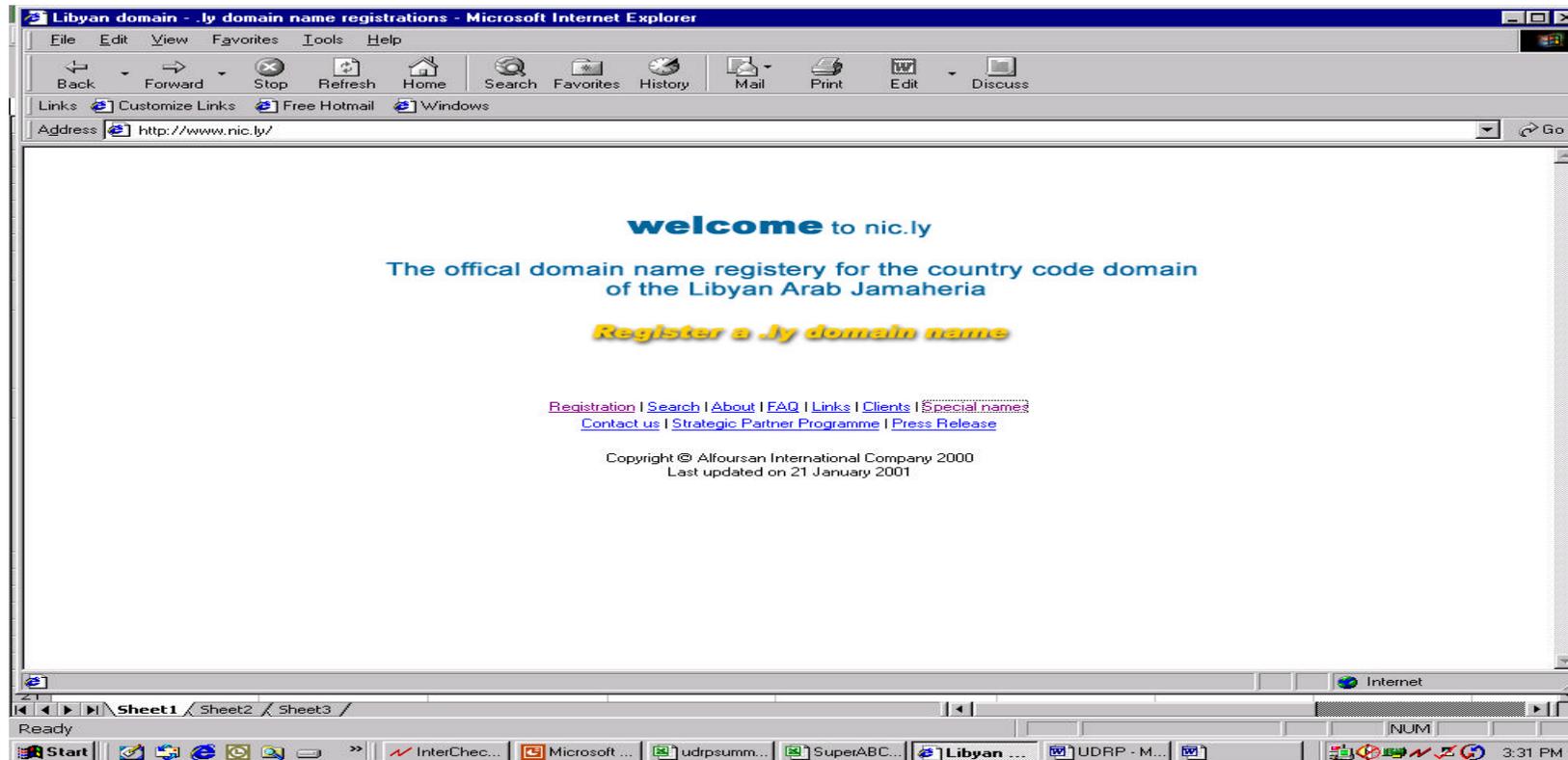
#### Not Interested registries

- Are unrestricted, allowing anyone to register anything
- Accept applications via a web interface and/or on an email template
- Often do not provide whois information
- Often do not publish any information on dispute support

#### Examples

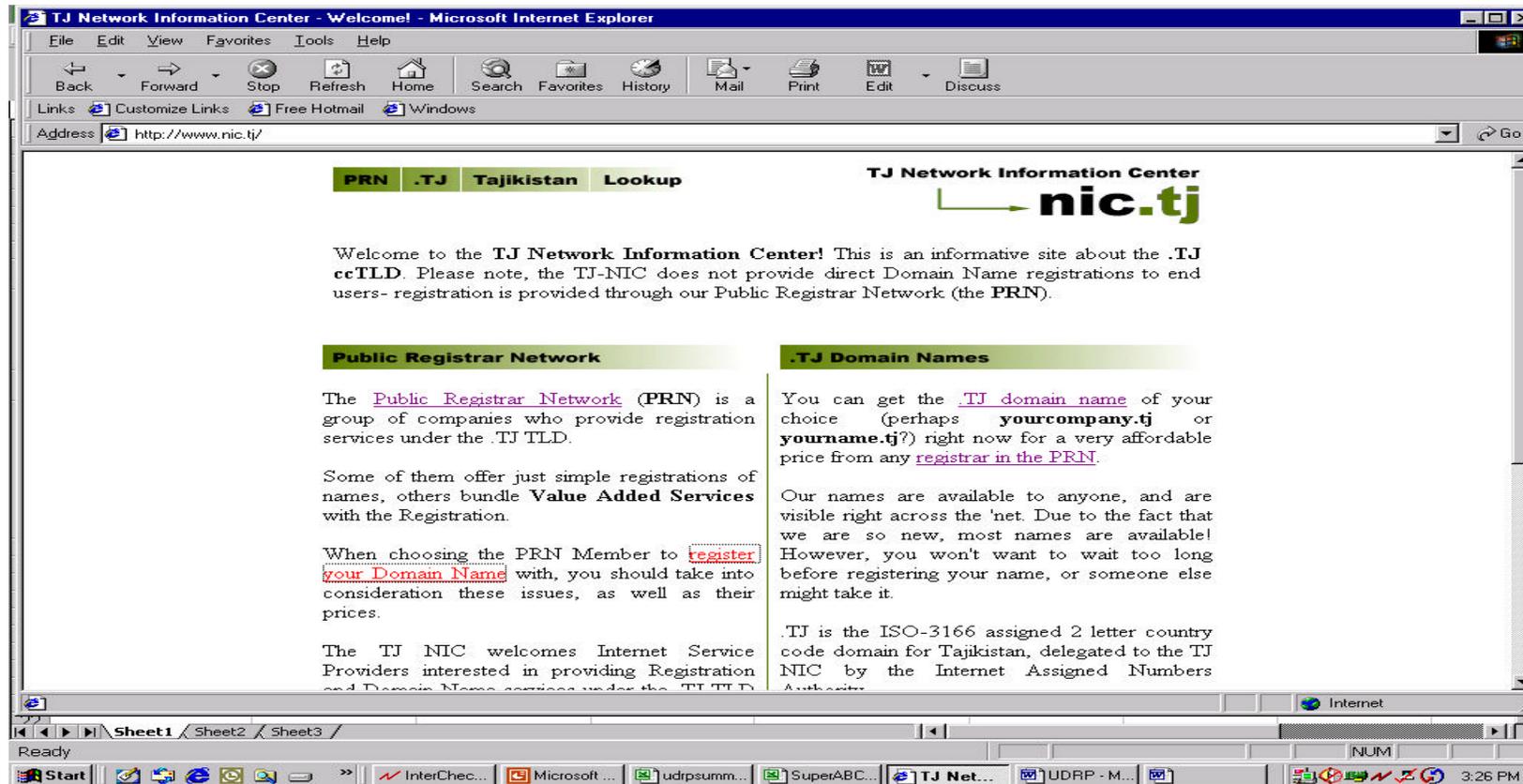
- Christmas Islands
- Libya
- Tajikistan

## Libya (.ly):



Unrestricted registry without any discoverable online dispute policy

## Tajikistan (.tj)



“Our names are available to anyone...however, you won't want to wait too long Before registering your name or someone else might take it!” – No visible dispute policy.

## Conclusions/Questions

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### **Is there an ideal model of protection for IPR in the ccTLDs?**

- Probably not – but great benefit in models of best practice covering registration procedures and dispute resolution

### **Is there a real need for change?**

- Yes say business (eg the IP community) who want stability
- Yes say the naming community serving the business community

### **Is there an alternative to harmonisation and best practice?**

- Yes: continue the status quo but watch gTLDs (with currently c.28 million registrations) pull away from ccTLDs (with currently c. 8 million registrations) and national governments involve themselves one by one