



Uniform Dispute Resolution Policy (UDRP):

WIPO's Experience

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Outline

- *Problem:* conflict between trademarks and domain names
 - *Solution:* administrative dispute resolution
 - *Experience:* + 3000 WIPO cases
 - *Developments:* ccTLDs, Second WIPO Process
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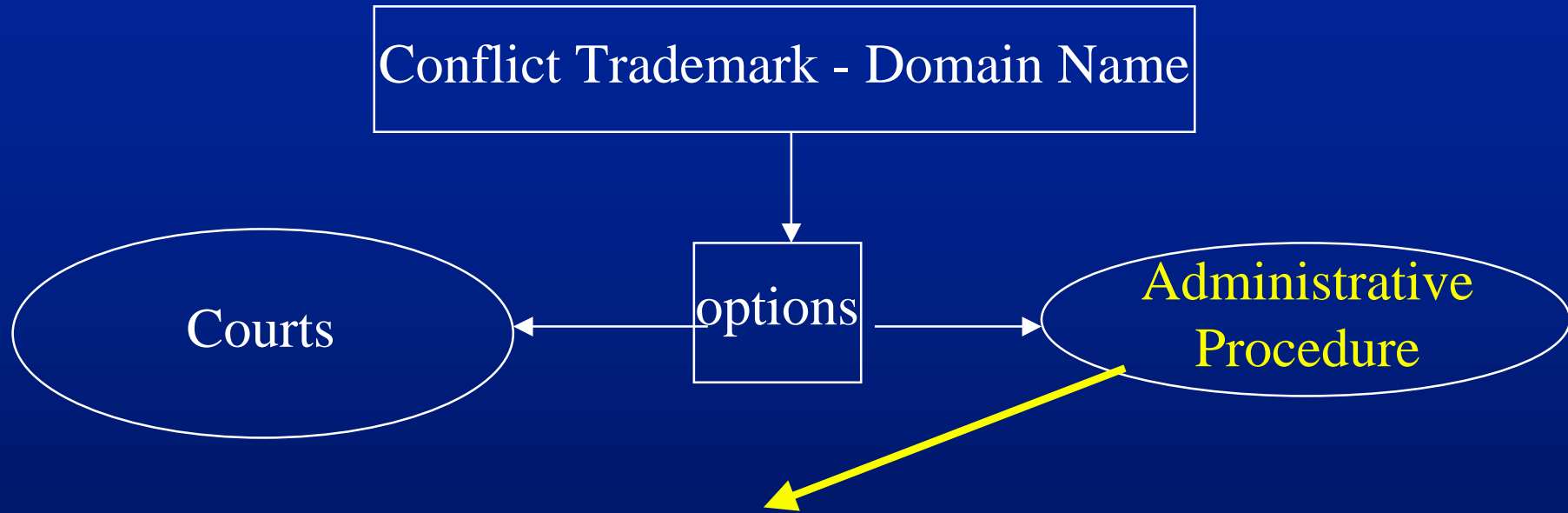
Trademarks-Domain Names Conflicts: Causes

- Domain names are commercially valuable
 - ✗ attract the public to business' web sites
- Domain names are unique
 - ✗ one name operates from and to anywhere in the world (v. territorial publicly regulated trademark system)
- Domain names registered without verification
 - ✗ first-come, first-served, quickly
 - ✗ in principle, no examination

Result → disputes



WIPO Recommendation



A procedure permitting trademark owners to resolve clear cases of abusive domain name registration (cybersquatting) without going to court.



Uniform Dispute Resolution Policy (UDRP) : Background


First WIPO Process Report Recommendations:

- ✓ registration practices to minimize disputes
- ✓ protection for famous and well-known marks
- ✓ caution in introducing new gTLDs
- ✓ uniform administrative dispute resolution procedure
 - UDRP adopted by ICANN, effective December 1999







UDRP : Features

- *Applicable* to gTLDs
 - Plus new gTLDs (.info, .biz, .name, .aero, .pro, .museum, .coop)
 - May be used by ccTLDs through voluntary adoption
 - *Mandatory* part of registration terms and conditions
 - Retro-active to include existing registrations
 - *Administrative*
 - Registrant must submit to UDRP but
 - UDRP does not preclude parties' court options
 - *Remedies*
 - Transfer or cancellation only
 - No monetary damages
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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 to sell or transfer to the trademark owner for profit
 - Registration to prevent the trademark owner from registering
- 

Procedure

- Complainant files *complaint* with dispute resolution service provider, e.g. WIPO Center
 - Provider *notifies* domain name registrant of opportunity to respond (20 days)
 - Provider appoints independent *panel* from list
 - Panel *decides* (14 days)
 - Registrar *implements* panel decision
 - Length: 50 days
- 



WIPO UDRP Panelists

- Intellectual Property and Internet Specialists
- Posted Detailed Resumes
- 250 members from 42 countries in all regions
- Multilingual capacity






Demand

- 3, 030 WIPO cases (per 03-10-2001) - Over 5,600 domain names
 - Current filing rate approximately 4 complaints per day
 - Multinationals, SMEs, individuals
 - Parties from 86 countries
 - United States: 48.5% complaints
 - Europe: 39,9%
 - » United Kingdom: 9,5%
 - » France: 5,4%
 - » Spain: 5%
 - » Germany: 4,2%
 - Switzerland: 2,9%
 - Australia: 2,4%
 - Japan: 2,1%
 - India: 1,9%
 - Brazil: 1;6%
- 

Dispute Resolution in gTLDs

- 2,189 decisions
 - 1,756 transfers (80,2%)
 - 14 cancellations (0,6%)
 - 419 complaints denied (19,3%)
 - 541 cases terminated on the basis of settlement agreement between parties

 - 2,730 cases resolved (90%)
- 

Why the demand?

- UDRP is generally considered to be meeting its purpose of offering an
 - effective,
 - fast (under 50 days),
 - affordable (1,500US\$ to 3,000US\$)
- anti-cybersquatting option for owners of trademark rights





Developments

- ccTLD administrators increasingly adopt UDRP (versions)
 - 22 have designated WIPO Center (.AG, .AC, .AS, .BS, .BZ, .CY, .FJ, .GT, .LA, .MX, .NA, .NU, .PA, .PN, .PH, .RO, .SH, .TT, .TV, .WS)
 - 55 WIPO ccTLD cases filed, 43 resolved cases
- Second WIPO Domain Names Process




Dispute Resolution and ccTLDs

- WIPO ccTLD Best Practices
 - ccTLD administrators are encouraged to adopt ADR procedures because they avoid:
 - Jurisdictional problems resulting from the global presence offered by domain names
 - Multiple court actions in case of abusive registrations across several TLDs
 - Slow pace of court litigation
 - High cost of court litigation
 - Registration authorities being joined in litigation proceedings
- 



UDRP: Excellent reference model and starting basis

- Result of broad international consultation (WIPO and ICANN)
 - Considerable real-world experience
 - Favorable review of overall majority of decisions
 - Introduction of greater uniformity
 - Possibility of consolidation of complaints
 - Restricted scope (« abusive registrations ») limits controversy
- 


Adjusting and Localizing the UDRP

- Tailored to local exigencies of the ccTLD
 - Local or foreign trademark
 - Bad faith registration and/or use
 - Number and nationality of panelists
 - Languages
 - Dispute resolution providers
- WIPO's experience: .mx





Outstanding Issues...

- Minimalist approach - trademark and domain names
 - Second WIPO Internet Domain Name Process
 - began July 2000 with Requests for Comments, online consultations, regional consultations
 - Final Report published September 3, 2001
 - Conflicts addressed five identifiers:
 - ✗ International Nonproprietary Names (INNs) for pharmaceutical substances
 - ✗ Names/acronyms of international organizations
 - ✗ Personal names
 - ✗ Geographical identifiers
 - ✗ Trade names
- 



International Nonproprietary Names for Pharmaceutical Substances (INNs)

- Ex: ampicillin, ibuprofen, sildenafil (a.k.a. "viagra")
- Consensus-based system for attributing names to new pharmaceutical substance, supported by World Health Organization Assembly resolution
- some 8,000 INNs (plus 120-150 each year)

Recommendation:

Administrative mechanism to allow interested party to notify WIPO that a domain name registration is identical to an INN

- WIPO and WHO verify and notify to ICANN

- ICANN notify to registrar to cancel the registration






Names and Acronyms of International Organizations

- Ex: wiposucks.com
- Protected, following notification, under Article 6 *ter* of the Paris Convention and TRIPs Agreement against misleading registration or use as trademark
- Evidence of abuses

Recommendation :

States, as constituents of IGOs, should examine desirability of special administrative procedure, modeled on UDRP, to protect names and acronyms of IGOs against misleading registration as domain names



Personal Names

- Protected in some jurisdictions by personality rights, privacy rights, trademark law, unfair competition law, anticybersquatting law
- UDRP applies only if qualify as trademarks
 - » juliaroberts.com
 - » brucesteen.com
- No protection for historical, political, religious, scientific figures

Recommendation:

International community needs to decide whether to work towards further protection





Geographical Identifiers: Indications of Source and Geographical Indications

- Existing international norms
 - prohibit misleading use of indications of source
 - » Paris Convention, TRIPs Agreement, Madrid Agreement (Indications of Source)
 - prohibit misuse of geographical indications
 - » Paris Convention, TRIPs Agreement, Lisbon Agreement
- Limits:
 - Trade in goods
 - Variety of national approaches > Applicable law?

Recommendation

International community needs to decide whether and how to create rules for harmonizing national appreciation of geographical indications (ex: an agreed list)





Geographical Identifiers: Names of Countries, Indigenous People and Places

- Country insignia protected, following notification, under Paris Convention and TRIPs Agreement
- No further existing international norms
- Abundant Evidence of Abuses (see Annex XII of the Report) - **Ex : sweden.com**

Recommendation :

International community needs to decide whether and, if so, how it wishes to deal with this situation



Sweden.com - Netscape

File Edit View Go Communicator Help



Bookmarks Location: What's Related

Sweden.com
your window on Sweden

Free Store Listing \$\$\$

HOME BUSINESS COMMUNITY TRAVEL CULTURE NEWS SPORT SHOPPING



Channels	Club Sweden	Search	Our Favourites
Business Community Travel Culture	Existing Users <input checked="" type="radio"/> Log into Club <input type="radio"/> Check E-Mail Username: <input type="text"/>	Sweden.com Search Find People on Sweden.com <input type="text"/> <input type="text"/> <input type="button" value="Search"/>	Discussions Guest book Love Online Maps Photos Postcards Survey Trade Board

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Welcome to uwhois.com - Netscape

File Edit View Go Communicator Help

Back Forward Reload Home Search Netscape Print Security Shop Stop

Bookmarks Location: <http://www.uwhois.com/cgi/whois.cgi> What's Related

Visual Search

Save here with no fee for one year

Registrant:

Virtual Countries, Inc. (SWEDEN-DOM)
3213 West Wheeler St., #149
Tel. 206.954.9992
paley@paley.com
Seattle, WA 98199
US

Domain Name: SWEDEN.COM

Administrative Contact:

Hall, Camden (YGFPNTHBYI) hallc@FOSTER.COM
Foster, Pepper Sheffelman
1111 Third Avenue, Suite 3400
Seattle, WA 98101
US
(206) 447-4400 (206) 447-9700

Technical Contact, Billing Contact:

Paley, Gregory (GP107) paley@PALEY.COM
Virtual Countries, Inc.
3213 West Wheeler Street, #149
Seattle, WA 98199
US
206.954.9992 206.282.2825

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Trade Names

- Paris Convention (Art. 8)
 - e.g., International Business Machines Corporation - trademarked as 'IBM'
 - ✗ no universal definition
 - ✗ no requirement of registration
 - ✗ coexist in different territories and fields of activity

Recommendation:

International community needs to decide whether the existing framework should be supplemented to deal with misuse of this form of identifier in the DNS





Conclusion

- WIPO Member States Assemblies
(September 24 to October 3, 2001)
- Special sessions of the Standing
Committee on the Law of Trademarks,
Industrial Designs and Geographical
Indications
 - November 29 to December 4, 2001
 - May 2002



Further Information

- <http://ecommerce.wipo.int>
- <http://arbiter.wipo.int>
(WIPO Arbitration and Mediation Center)
- <http://wipo2.wipo.int>
(WIPO Internet Domain Name Processes)

