

ICANN Paris - UDRP Workshop

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ICANN Paris 26 June 2008

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Content

(1) The purpose of the UDRP

(2) ADR and domain names

(3) Some experience

- as an attorney acting for one of the parties
- as a panelist

(4) The Future of the UDRP?

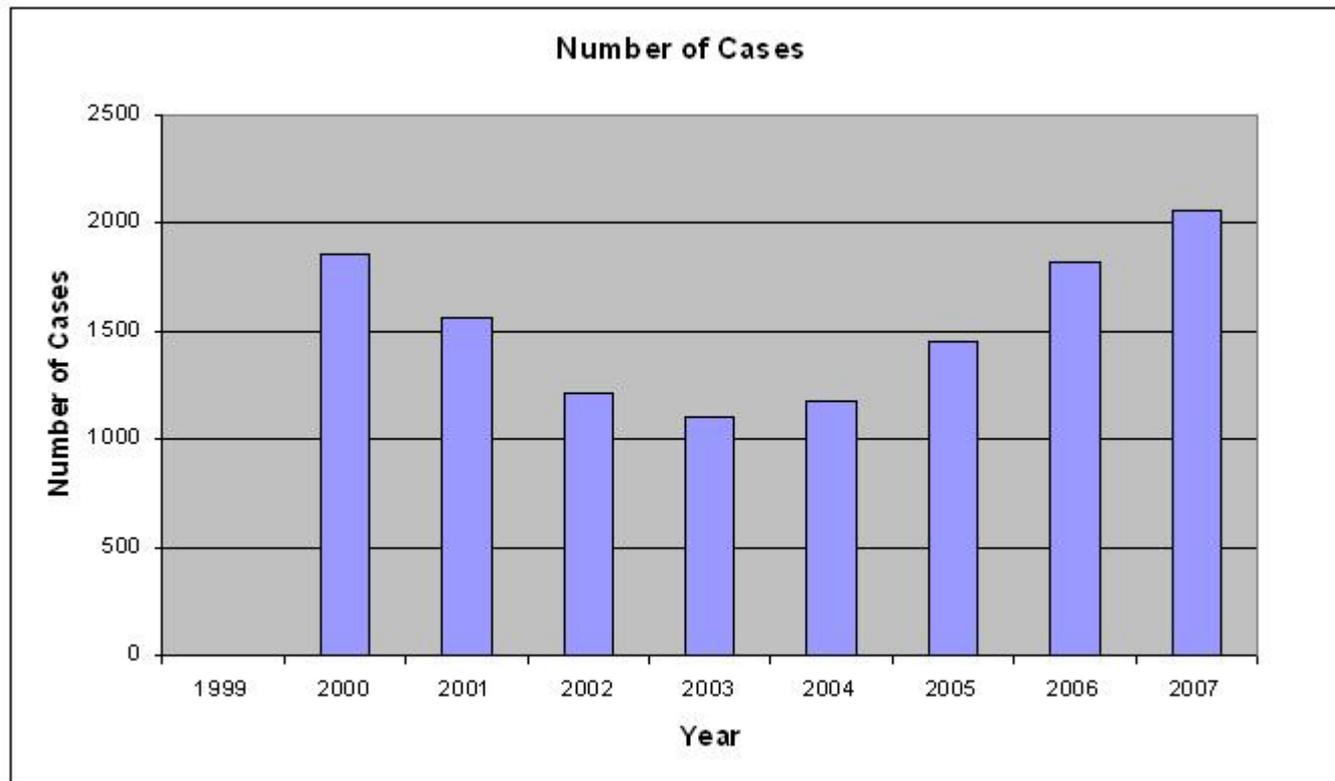
Has the UDRP fulfilled its purpose?

- What is the purpose of the UDRP?
 - For cyberspace to function as an effective commercial market, businesses must have confidence that their trade marks can be protected and consumers should not be misled about the source of the product or service offered on the Internet (White Paper on the management of the Internet Domain Name System June 1998)
 - To seek to provide an inexpensive and efficient alternative to litigation for resolving disputes between trademark owners and domain name registrants wherever they may be based
 - Not intended to provide IPR holders with more protection online than offline

Has the UDRP fulfilled its purpose?

- Has been controversial
 - overly weighted towards rights holders?
 - unexpected / inconsistent decisions?
 - compliance issues?
 - "Fair.com" and "Fundamentally Fair.com"
 - WIPO letter of 16 April 2008 to ICANN and ICANN response
- Generally agreed that not perfect, but works

UDRP (Uniform Domain Name Dispute Resolution Policy) - WIPO figures



- Total has increased every year since 2003
- In 2007 highest ever, a total of 2,156 cases filed
- 53 ccTLDs have adopted (a variation of) the UDRP

Geographical distribution of parties gTLDs

(to March 2008)

Complainant	
Ranking	Country
1	USA
2	France
3	UK
4	Germany
5	Switzerland
6	Spain
7	Italy
8	Canada
9	Australia
10	Netherlands

Up

Respondent	
Ranking	Country
1	USA
2	UK
3	China
4	Canada
5	Spain
6	R. of Korea
7	France
8	Australia
9	Italy
10	Switzerland

Up

Up

ADR and domain names

- Where is the UDRP applicable?
 - All generic (and upcoming) Top Level Domains: .aero, .asia, .biz, .cat, .com, .coop, .info, .jobs, .mobi, .museum, .name, .net, .org, .pro, .travel
 - 53 ccTLDs (UDRP or variation: WIPO)
 - Not all ccTLDs

Dispute Resolution Policies across the EU

- 10 ccTLDs have adopted UDRP or variation of it
 - (.uk, .it, .be, .dk, .fr, .es, .ie, .lv, .cy, .ro, .nl,)
- 10 ccTLDs have no ADR at all
 - (.de, .gr, .fi, .sk, .ee, .lt, .lu, .mt, .si, .bg)
- 4 ccTLDs are subject to arbitration
 - (.pl, .cz, .pt, .hu)
- 2 ccTLDs have specific ADR rules
 - (.at, .se)

Some experiences

- As Counsel for complainant
 - The key issue is whether UDRP / LDRP is appropriate
 - negotiate (with registrant or registrar)? (50%)
 - UDRP / LDRP? (30%)
 - Court action? (20%)
 - Cease and desist (80%)
 - Therefore only 6% actually go to UDRP

Example of ccTLD using UDRP .ie (Ireland)

- Facebook.ie (WIPO Complaint DIE 2007-0009)
 - Registrant Talk Beans Media Ltd
 - Cease and desist,
 - Complaint filed with WIPO

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All Cases: D2007-0001 - D2007-0199

Last updated: 18-Apr-2008

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Case Number	Domain Name(s)	Commencement Date	Case Status
DIE2007-0001	gogle.ie google.ie googl.ie googol.ie	-	Terminated
DIE2007-0002	kelkoo.ie	-	Decided
DIE2007-0003	myhomes.ie	-	Terminated
DIE2007-0004	dermalogics.ie	-	Decided
DIE2007-0005	champagne.ie	-	Decided
DIE2007-0006	bebo.ie	-	Terminated
DIE2007-0007	whatcar.ie	-	Decided
DIE2007-0008	sedo.ie	-	Terminated
DIE2007-0009	facebook.ie	-	Decided

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Suzi Doherty

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dancing everyone friends gerrard getting girl girls good great
john life loads lost love making meet meeting michael
movies music myself name next park people
pink play pretty read reading really right soaps soccer
something stephen student taking things think time work



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Facebook Inc. v. Talkbeans Media Limited

Case No. DIE2007-0009

1. The Parties

The Complainant is Facebook Inc., Palo Alto, California, of United States of America, represented by Lovells, France.

The Registrant is Talkbeans Media Limited, Shankill, Co. Dublin, Ireland, and Dublin, Co. Dublin, of Ireland, represented by LK Shields Solicitors, Ireland.

2. The Domain Name and Registrar

The disputed domain name <facebook.ie> is registered with IE Domain Registry Limited.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on December 14, 2007.

On December 17, 2007, the Center transmitted by email to IE Domain Registry Limited a request for registrar verification in connection with the domain name at issue.

Some experiences

- As Counsel for respondent
 - If as registrant have a legitimate interest in the domain name then defend the case and do not default
 - if no legitimate interest then respond to the cease and desist and agree and assist in the transfer

Some experiences

- As Panelist
 - See excellent complaints, but often some very poorly argued complaints
 - All too often the registrant does not respond, a shame, a number may well have retained the domain name if they had challenged bad faith allegations / demonstrated a legitimate interest

Compliance – examples encountered

- UDRP decision sent by WIPO to registrar, in many instances we have to resend a copy before action will be taken
- Where the actual registrar is a reseller, the main registrar may have been notified but not the reseller
- Very few examples of registrars implementing UDRP Rule 16 and communicating the date for the implementation of the decision to all parties
- Certain registrars require credits be purchased before domain names can be moved from the account
- Problem with a large EU-based registrar
 - complied with a UDRP decision to transfer
 - but merely changed the contact information to that of the Complainant
 - left the domain in the Respondent's registrar account.

Compliance – examples encountered

- Delays: 1-5 months due to uncooperative registrars
 - when provided with a decision request payment of fees, even though renewal date in the future,
 - refusing to update admin-c details on the record,
 - support people not speaking English, French, German or Spanish,
 - insisting on German bank details
 - One example:
 - UDRP Decision issued 25 April,
 - WIPO notification 5 May, (10 days instead of 3 under Rule 16)
 - Registrar unresponsive through to 30 July
 - Registrars unlocking the domain name during the UDRP process

Other issues...

- Lawyers not understanding the transfer process
- A registrar encouraging users to register domain names including "myspace" "tmobile" "ipod" as "they are gold in this market"
- Whois Privacy Services – variation in practice of disclosing the "underlying registrant"

The Future of the UDRP?

- Great if could consider having a standard procedure across all registrars for transfer post UDRP e.g:
 - registrar or we create an account and place the domain name in that account
 - provide username and password for the account
 - but difficult perhaps as each scenario of complaint / complainant / registrar is unique

Possible changes to the UDRP?

- Translate the UDRP Policy and Rules to other languages?
- Fast track process for serial cybersquatters or where no response?
- Appeal process to enable clear mistakes or bad decisions to be rectified cf three panellist option?
- Class actions (CAC)?

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