

IPC APAC Open House

Introducing the Intellectual Property Constituency and preparing for the upcoming review of the Uniform Domain Name Dispute Resolution Policy (UDRP)

Intellectual Property Constituency (IPC)

ICANN68 Policy Forum
Monday, 23 June 2020



Agenda

- 10:00 - 10:10 **Introductions** - Heather Forrest (Australia), IPC President
- 10:10 - 10:30 **Introduction to the UDRP and its pending review** – Brian Beckham, WIPO
- 10:30 - 10:50 **Discussion Topic #1** – IP owner experiences and perspectives in reviewing the UDRP
- 10:50 - 11:10 **Discussion Topic #2** – Exploring opposing perspectives
- 11:10 - 11:25 **Return to plenary** – Leaders of Discussion Topics #1 and #2 will summarise outcomes
- 11:25 - 11:30 **Closing Remarks** – Heather Forrest, IPC President
- 11:30 **Adjourn**

Introduction to IPC and this Session

The IPC:

- is a part of ICANN's Generic Names Supporting Organization (GNSO), the body responsible for developing policy governing generic Top Level Domains (gTLDs)
- represents the views and interests of owners of intellectual property rights in the context of the Domain Name System (DNS)
- members come from private practice, corporate counsel, IP-related organisations and academia

This session:

- will update APAC region IP owners on the current status of the Uniform Domain Name Dispute Resolution Policy (UDRP)
- is an opportunity to identify and record the perspectives of APAC region IP owners' experiences with the UDRP

WIPO Arbitration and Mediation Center

- Facilitates the resolution of commercial disputes between private parties involving IP, through procedures other than court litigation, including mediation and arbitration
- Offices in Geneva and Singapore
- Users around the world
- ADR provider specialized in IP disputes
- WIPO mediators, arbitrators, and experts experienced in IP – able to deliver informed results efficiently
- International neutrality



WIPO: The Leading Global UDRP Provider

- **WIPO Center Staff:**

20+ nationalities / languages

Senior Legal Staff / Case Managers

Case Secretariat

IT Support

- **WIPO Domain Name Panelists:**

Public Panel Roster:

www.wipo.int/amc/en/domains/panel/panelists.html

Nearly 500 experts

Representing nearly 60 countries

- WIPO's (1999) recommendation for resolving cybersquatting disputes, outside the courts: the Uniform Domain Name Dispute Resolution Policy (UDRP)

- International (gTLDs, new gTLDs, many ccTLDs)
- For clear-cut cases of trademark abuse
- Contractually mandated
- Direct enforcement via registrar
- Remedies: transfer or cancellation
- Administrative process with court options preserved

UDRP: Principal Advantages

- **Time-effective**

- 60-75 days



- **Cost-effective**

- fixed fees



- **Predictable**

- 20 years
- 48,000 cases
- 85,000 domain names
 - PPC, unfair competitors, pretextual free speech, phishing, fraud, counterfeiting, employment scams, malware distribution, illegal prescription drugs



UDRP as adopted / adapted by WIPO ccTLDs

UDRP:

.AG, .AI, .AS, .BM, .BS, .BZ, .CC, .CD, .CO, .CY, .DJ, .EC, .FJ,
.FM, .GD, .GQ, .GT, .KI, .LA, .LC, .MD, .ME, .ML, .MW, .NR, .NU,
.PA, .PK, .PN, .PR, .PW, .RO, .SC, .SL, .SO, .TJ, .TK, .TT, .TV,
.UG, .VE, .VG, .WS

Variations:

.AE and امارات., .AO, .AU, .BO, .BR, .CH, .CN and . 中国, .CR,
.DO, .ES, .EU, .FR, .GE, .HN, .IE, .IR, .LI, .MA, .MP, .MX, .NL,
.PE, .PH, .PM, .PY, .QA and قطر., .RE, .SE, .TF, .TM, .TZ, .UA and
.COM.UA, .WF, .YT

WIPO ccTLD web pages

WIPO Domain Name Dispute Resolution Service for .BR

Country /
Territory Code .BR

Country /
Territory Name Brazil

Whois Search [Whois Search](#)

Dispute
Resolution
Policy **Variation of UDRP**
[Regulamento do Sistema Administrativo de Conflitos de Internet Relativos a Nomes de Domínios
Sob ".BR" — Saci-Adm](#)

Relevant differences between the UDRP and the .BR Policy

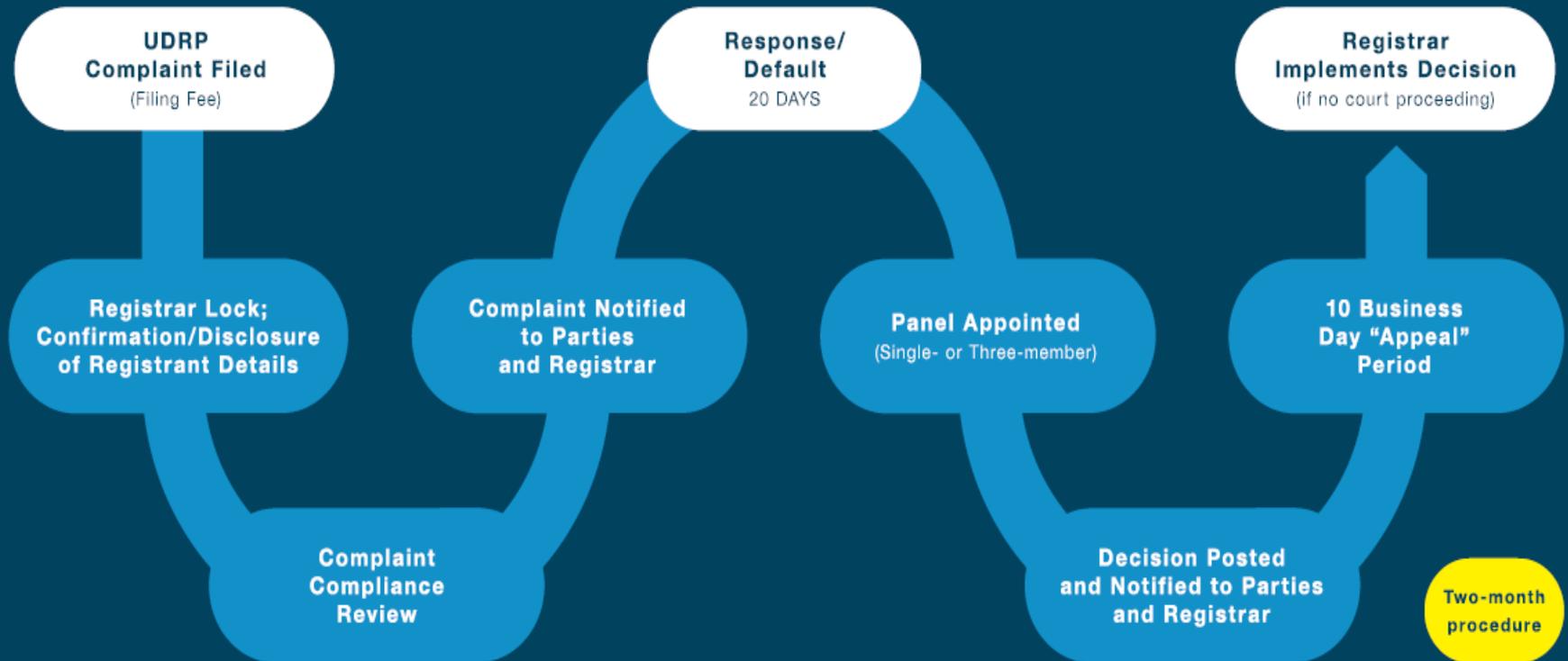
- ▶ [Rights Covered](#)
- ▶ [Rights or Legitimate Interests](#)
- ▶ [Bad Faith](#)
- ▶ [Language of Proceedings](#)
- ▶ [Mutual Jurisdiction](#)
- ▶ [Representation](#)
- ▶ [Applicability](#)
- ▶ [Decision implementation](#)

Procedural **Variation of UDRP**

- Contains information and resources to over 70 WIPO ccTLDs
- Registration agreement
- Whois search tools
- Dispute resolution policy
- Procedural rules
- Differences between specific ccTLD policy and the UDRP
- Model pleadings
- Eligibility criteria
- Supported characters

UDRP – UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY

APPLIES TO GTLDS, NEW GTLDS AND NUMEROUS CCTLDS



The UDRP Test - Three Elements

(UDRP, paragraph 4(a)(i)-(iii))

Trademark **identical or confusingly similar** to the domain name;
and

Lack of registrant **rights or legitimate interests**; and

Domain name **registered and used** in bad faith

Identical

ZIONS BANK

<zionsbank.info>

SWAROVSKI

<swarovski>

HERMÈS



<hermesclub.net>

Confusingly Similar

facebook

<facebook-privacy.com>

<fbk-marketplace.com>

YAHOO!

ياهو.com ([xn--mgb8dd93c.com])

SIEMENS

<siemens.com>

[xn--semens-p9a.com]

Confusingly Similar: additional terms



<voguemag.com>

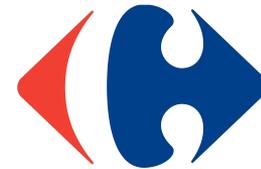
<boutiqueprada.net>



Confusingly Similar: typosquatting

<instagramn.com>

Instagram



Carrefour

<carrifour.com>

<virgnimedia.com>



Key First Element topics in WIPO Overview

- Test for confusing similarity (1.7)
 - Recognizability
- Significance of the TLD (1.11)
- Website content relevance (1.15)

The Second Element

“(ii) you have no rights or legitimate interests in respect of the domain name”

Respondent Defenses, UDRP, paragraph 4(c)

- Use or demonstrable preparations to use the domain name for a bona fide offering of goods or services
- Being commonly known by the domain name
- Legitimate noncommercial or fair use
 - without intending to misleadingly divert consumers or tarnish the complainant's trademark

Legitimate noncommercial or fair use

- corresponding website content prima facie supports the claimed purpose (e.g., for referential use, commentary, criticism, praise, or parody)
- domain name may not be used as pretext for commercial gain
- a domain name will not be considered “fair” if it falsely suggests affiliation with the trademark owner
- mark plus a derogatory term (e.g., <trademarksucks.tld>)
- fan sites

Second Element - Rights or Legitimate Interests

Burden of Proof

- The burden of proof rests with the complainant

Prima facie

- The complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests

Relevant evidence

- The burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name

“(iii) your domain name has been registered and is being used in bad faith”

Examples in UDRP, paragraph 4(b)

- Seeking primarily to sell the domain name to the trademark owner (or their competitor); or
- Pattern of registering domain names to prevent the trademark owner from obtaining the corresponding domain name; or
- Registering the domain name primarily to disrupt the business of a competitor; or
- Intentionally attempting to attract users, for commercial gain, by creating a likelihood of confusion with the complainant's mark

WHOIS: before & after GDPR

REGISTRANT CONTACT

Name: Domain Name Administrator Law Department
Organization: PepsiCo, Inc
Street: 700 Anderson Hill Road
City: Purchase
State: NY
Postal Code: 10577
Country: US
Phone: +001.914.2532000
Fax: +001.914.2533123
Email: domain.billing@PBSG.COM

REGISTRANT CONTACT

Name: REDACTED FOR PRIVACY
Organization: Andreas Krassnigg
Street: REDACTED FOR PRIVACY
City: REDACTED FOR PRIVACY
State: AT
Postal Code: REDACTED FOR PRIVACY
Country: AT
Phone: REDACTED FOR PRIVACY
Fax: REDACTED FOR PRIVACY
Email: <https://contact.domain-robot.org/websiteberater.com>

Impact of Changes to Availability of Whois Data on the UDRP: WIPO Center Informal Q&A

Stemming from changes to applicable regulations, such as the European Union's General Data Protection Regulation (GDPR), a Whois search may no longer reveal contact information for domain name registrants. At the same time, service providers must balance privacy and personal data concerns against legitimate third party interests, such as addressing legal disputes. In these conditions, changes to the availability of registrant contact details in public Whois databases may impact some aspects of dispute resolution under the Uniform Domain Name Dispute Resolution Policy (UDRP).

To facilitate an understanding of this potential impact, the WIPO Center offers the present Q&A. While this Q&A represents a faithful effort to assist parties' awareness, it is not intended to be future-proof, comprehensive, or legal advice.

- › How can a trademark owner submit a UDRP complaint if the publicly-available Whois data does not provide the domain name registrant's identity and contact details?
- › In preparing a UDRP complaint post-GDPR, how can a trademark owner conduct a Whois search/access the domain name registrant's details?
- › Once the UDRP complaint has been filed, does WIPO have access to the domain name registrant's Whois data?
- › Will WIPO provide the registrar-confirmed Whois data to UDRP complainants?
- › Does the GDPR impact WIPO's fees for domain name disputes?
- › How will requests to consolidate UDRP cases be handled by Panels?
- › How will UDRP Panels apply the substantive UDRP criteria in light of Whois evolution?
- › What is the legitimate purpose for which WIPO collects and processes personal data?
- › Will party names still be included in published UDRP decisions?



www.wipo.int/amc/en/domains/gdpr

The screenshot shows the WIPO website's search interface. At the top, the WIPO logo and navigation menu are visible. The main navigation bar includes links for IP Services, Policy, Cooperation, Reference, About IP, and Inside WIPO. A search bar is located on the right side of this bar. Below the navigation bar, there are tabs for Home, IP Services, Alternative Dispute Resolution, Domain Name Disputes, and Search. The WIPO | ADR logo is also present. The main heading is "Full Text Search on WIPO Panel Decisions". Below this, there are two tabs: "Simple Search" and "Advanced Search". A search input field is followed by a "Search" button and an information icon. To the right of the search field is a checkbox labeled "Display case reference only (without case excerpt)". Below the search field, there are filters for "From" and "To" dates, each with "Day", "Month", and "Year" dropdowns. There is also a "Language of Proceeding" dropdown menu with options: Chinese, Danish, Dutch, English, French, German, and Hebrew. Finally, there is a "Case prefix" dropdown menu with options: D, DAC, DAD, DAE, DAF, DAG, and DAI.

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WIPO
WORLD INTELLECTUAL PROPERTY ORGANIZATION

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WIPO | ADR

Full Text Search on WIPO Panel Decisions

Simple Search | Advanced Search

Search ⓘ

Display case reference only (without case excerpt)

From: Day ▾ Month ▾ Year ▾

To: Day ▾ Month ▾ Year ▾

Language of Proceeding

- *** Any ***
- Chinese
- Danish
- Dutch
- English
- French
- German
- Hebrew

Case prefix

- *** Any ***
- D
- DAC
- DAD
- DAE
- DAF
- DAG
- DAI

WIPO Resources

The screenshot shows the WIPO website interface. At the top, there is a dark blue header with the WIPO logo and the text 'WORLD INTELLECTUAL PROPERTY ORGANIZATION'. Below this is a navigation bar with links for 'IP Services', 'Policy', 'Cooperation', 'Reference', 'About IP', and 'Inside WIPO'. A search bar is located on the right side of the navigation bar. The main content area features a breadcrumb trail: 'Home > IP Services > Alternative Dispute Resolution > Domain Name Disputes > Search'. The title of the document is 'WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Jurisprudential Overview 3.0")'. Below the title, it states '© 2017 World Intellectual Property Organization All Rights Reserved'. A paragraph of text follows: 'Resulting from WIPO's care for effective remedies under a sustainable UDRP, this WIPO Jurisprudential Overview reflects, and assists the predictability of, UDRP decisions by panels appointed in WIPO cases.' There is a link for 'Introduction'. Under the heading 'QUESTIONS', there are four numbered items: '1. First UDRP Element', '2. Second UDRP Element', '3. Third UDRP Element', and '4. Procedural Questions'. Below this, there are three numbered questions: '1. First UDRP Element', '1.1 What type of trademark rights are encompassed by the expression "trademark or service mark in which the complainant has rights" in UDRP paragraph 4(a)(i)?', '1.2 Do registered trademarks automatically confer standing to file a UDRP case?', and '1.3 What does a complainant need to show to successfully assert unregistered or common law trademark rights?'. On the right side, there is a 'WIPO UDRP Toolkit' section with a list of links: 'UDRP', 'UDRP Rules', 'WIPO Supplemental Rules', 'WIPO Jurisprudential Overview 3.0', 'Legal Index of WIPO UDRP Panel Decisions', 'Search WIPO Cases and WIPO Panel Decisions', 'WIPO Model Complaint', 'WIPO Model Response', and 'Schedule of Fees'.

- Reflects consensus on some 60 substantive and procedural UDRP issues
- Draws on the thousands of cases administered by WIPO and decided by WIPO panelists

ICANN RPM Working Group

- 150 members
 - IP, domainers, civil society/EFF, registries/registrars
 - 3 co-chairs
- Illustrative RPM WG observations:
 - Should Apple have a trademark?
 - Does (Apple's) sunrise kill free speech?
 - Delays, open-ended data-gathering, re-litigating policy positions

Discussion Topic #1

Leaders:

- Syed Abedi, SeedIP
- John McElwaine, Nelson Mullins

- UDRP Benefits:
 - Scalable
 - Proven
 - Benefits to domainers:
 - RDNH
 - Damages are lower (no attys fees / no damages)
 - Process is in place with due process rather than being left to opaque platform judgment
 - Value of domain names is inflated to the cost of a UDRP
 - Avoids court cases and state courts, such as Utah's statute
 - Benefits to ICANN and Contracted Parties: Again, keeps them out of court
 - Benefits to Non-Commercials:
 - Free speech arguments have been well aired.

List of Suggestions for the UDRP

- ⊙ Bad faith standard: “bad faith registration and use” – change “and” to “or”
- ⊙ Repeat/Serial Offenders
- ⊙ Process for early optional mediation
- ⊙ Loser pays
- ⊙ Appeals process
- ⊙ Default versus contested proceedings
- ⊙ Privacy Shields & Redacted Whois

Discussion Topic #2 – Exploring other perspectives

Leaders:

- Brian King, Clarivate
- Yoshitaka Murakami, Com Laude Japan

Consider the UDRP from the non-IP owner perspective

- Do you have personal experience representing registrants facing UDRP actions that you can share? If not, try to consider the UDRP from that perspective
- What are the main advantages you see in the UDRP system?
- What disadvantages/issues have you encountered with the UDRP?
- If you were reviewing the UDRP, what might you seek to change?

As a brand owner, what do you think about these suggestions?

Some examples that have been raised in the past follow, to start the discussion

Discussion Topic #2 – changes sought by others?

- Appeal process:
 - Unlike URS, UDRP has no specific appeal mechanism; decisions challenged at court
 - Should there be a designated appeals process built into UDRP? Who would pay?
- Limitation period for bringing an action
- “Accountability” for DRP providers:
 - DRP providers to be under formal contract rather than “simply” accredited by ICANN
 - Framework for oversight with performance standards, monitoring and investigation of complaints
- Fixed and transparent process for allocating panelist to a particular case:
 - Should there be a “taxi-rank” process for allocating panelists?
 - What about considerations of language skills? Complexity of case?
- Panelists should not also represent parties in separate UDRP proceedings:
 - Some believe this leads to conflict of interest and panelists developing precedent that will benefit their own later clients
 - How do you incentivise quality panelists if they must choose one or the other?
 - Should there be a conflict of interest policy?
- Adopt a mandatory mediation step
 - Some dispute processes, such as .UK include mediation and it can be effective
 - Should this be adopted into UDRP? How would it be funded and managed? Would it cause undue delay?

IPC's role in gTLD policy development

IPC participates in GNSO policy development through its members and its two GNSO Councilors



IPC welcomes new member applications via its website:
<https://www.ipconstituency.org/>

Engage with ICANN



Thank You and Questions

Visit us at icann.org

Email: IPC President Heather Forrest (Australia)

haforrestesq@gmail.com



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