

Advisory Committee on Enforcement

Tenth Session

Geneva, November 23 to 25, 2015

THE UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY (UDRP) AS A MODEL FOR THE RESOLUTION OF INTELLECTUAL PROPERTY RIGHTS DISPUTES

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ABSTRACT

As an alternative dispute resolution (ADR) mechanism, the WIPO-initiated Uniform Domain Name Dispute Resolution Policy (UDRP) has already resolved over 32,000 WIPO cases involving the bad-faith registration of trademarks as Internet domain names. Trademark owners from around the world value the UDRP for its speed, transparency, low cost, and international application and enforcement. This paper considers whether the UDRP's design elements might be effectively applied to other online disputes involving Intellectual Property Rights (IPR). After outlining these design elements, the paper identifies two example areas that might benefit from considering such application. First, the paper discusses extending the UDRP model to domain names that are not confusingly similar to another's trademark, but that nonetheless host content that violates IPR, for example through the sale of counterfeit goods. Second, the paper notes that, while online platforms like Google and Facebook have been active in facilitating takedown of alleged IPR infringements, such private protection programs might benefit from adopting the UDRP's emphasis on transparency and neutrality, notably in an appeal mechanism.

* With permission of that article's authors, Part I of the present paper is an abbreviated partial version of a previously published article: Nicholas Smith and Erik Wilbers, *The UDRP: Design Elements of an Effective ADR Mechanism*, 15 (2) *The American Review of International Arbitration* (2004), 215. The views expressed in this document are those of the author and not necessarily those of the Secretariat or of the Member States of WIPO.

I. INTRODUCTION

1. The UDRP has proven successful in providing a low-cost alternative means of resolving disputes involving the bad-faith registration of trademarks as Internet domain names. Adopted by the Internet Corporation for Assigned Names and Numbers (ICANN) on the recommendation of the Geneva-based World Intellectual Property Organization (WIPO), the UDRP came into effect in late 1999. To date, there have been over 50,000 UDRP cases, involving many more domain names. Over 32,000 of those cases¹ have been filed with the WIPO Arbitration and Mediation Center (the Center). The UDRP's relative speed, transparency, low cost and international application and enforcement have made it a popular tool for trademark owners to protect their rights without going to court.

2. Hoping to harvest some of the global respect that the UDRP has earned, this paper briefly considers whether the design elements of the UDRP might be effectively applied to other online disputes involving IPR — including disputes that do not necessarily include trademark-infringing domain names. Referring to the success of the UDRP, one commentator has observed:

“It is surprising that some of the successes of protecting intellectual property online are not employed for broader use. [The] [c]ybersquatting problem, which plagued the Internet in the nineties, before P2P technologies even existed, was effectively tamed not by harsh remedies, but by the novel online alternative dispute resolution approach enforced supranationally through the administrators of the domain name system (DNS) – ... [ICANN] and domain registrars”.²

3. Part II of this paper outlines the design elements of the UDRP, observing that the system not only provides an expedient and cost-effective remedy for domain name disputes, but that it does so with transparency and neutrality.

4. Part III considers whether the elements of the UDRP might be exported to other online disputes. Two example areas are identified that might benefit from considering implementation of a system for ADR based on elements of the UDRP.

5. First, it may be appropriate to consider extending the UDRP model to domain names that are not confusingly similar to another's trademark, but that nonetheless host content that violates IPR. The UDRP model might be effectively extended to this problem and used as a means to cancel or transfer domain names that, for example, facilitate the distribution of counterfeit goods, irrespective of whether the domain name itself infringes another's trademark.

6. Second, elements of the UDRP might be adopted by private enterprises such as Facebook, Google, or eBay that have voluntarily adopted procedures for protecting IPR. While these private programs have been active in facilitating takedown of alleged infringements, they could benefit from adopting the UDRP's emphasis on transparency and neutrality, notably in an appeal mechanism.

¹ Up-to-date WIPO case statistics are available at: <http://www.wipo.int/amc/en/domains/statistics/>.

² Mindaugas Kiškis, *Novel Remedies for IP Rights Infringement Online*, 20 (4) *Jurisprudencija* (2013), 1443, 1450, available at: https://www.mruni.eu/en/mokslo_darbai/jurisprudencija/archyvas/?l=204141.

II. DESIGN OF THE UDRP

7. A UDRP case is launched when a party asserting trademark rights (the Complainant) prepares and sends a Complaint to an ICANN-accredited UDRP dispute resolution service provider.³ In addition to WIPO as the major provider, there are several other UDRP dispute resolution providers. The Center will then contact the registrar⁴ of the domain name to confirm the identity of the domain name holder (the Respondent) and to direct the domain name to be locked, so that it cannot be transferred to a third party during the proceeding.⁵ Once the Center has confirmed that the Complaint is directed against the correct Respondent and is otherwise in compliance with the applicable UDRP requirements, it notifies the Complaint to the Respondent, using all means of communication and all addresses at the Center's disposal.⁶ The Respondent has 20 days to file a Response.⁷ Upon expiry of this period the Center forwards the Complaint and, if received, the Response to an administrative Panel composed of either one or three legal experts for decision.

8. UDRP Panels consist of external, independent trademark law experts, either appointed by the Center, or nominated by the parties. For both of these purposes, the Center maintains a list of several hundred such Panelists from some 60 countries, with publicly available profiles.⁸ If the Panel finds that the Complainant has established its case under the requirements of the UDRP, it will issue a decision ordering the transfer (or cancellation) of the domain name.⁹ The decision is then forwarded to the parties, and the registrar which, unless the decision is challenged in a court of competent jurisdiction within 10 days, will implement the decision of the Panel.¹⁰

A. UNIFORM AND UNIVERSAL APPLICATION

9. The UDRP dispute resolution process can be applied uniformly to all disputes involving domain names ending with .com and all other so-called generic Top Level Domains (gTLDs).¹¹ In addition, as a best practice, the UDRP has been adopted by many registration authorities for country-code Top Level Domains (ccTLDs).¹² The UDRP has universal application because all domain name registrants must agree to be bound by the UDRP as a condition of their ICANN-imposed registration agreements.¹³

10. This special mechanism ensures that the UDRP can be invoked against all domain name holders, at any time, regardless of the identity and location of the domain name holder.¹⁴ Additionally, in the international domains, the global application of the UDRP removes a range of possible jurisdictional concerns.

³ UDRP Rules, Para. 3(a) (version effective July 31, 2015).

⁴ The technical entities (accredited with ICANN) with which companies and individuals can register domain names.

⁵ UDRP Rules, Para. 4.

⁶ UDRP Rules, Paras. 2(a) and 4(c).

⁷ UDRP Rules, Para. 5(a).

⁸ See <http://www.wipo.int/amc/en/domains/panel/panelists.html>.

⁹ A rarely used alternative remedy is cancellation of the domain name, see UDRP, Para. 4(i).

¹⁰ UDRP, Para. 4(k).

¹¹ See ICANN, *Domain Name Dispute Resolution Policies*, at <http://www.icann.org/udrp>.

¹² As of July 2015, WIPO provides dispute resolution services for 71 ccTLDs. Some of these domains have added further design features.

¹³ See <http://www.icann.org/registrars>.

¹⁴ *Justice for Children v. R neetso / Robert W. O'Steen*, WIPO Case No. D2004-0175.

B. COURT OPTION MAINTAINED

11. While the procedure itself is often viewed as an abbreviated arbitration process, the UDRP differs from arbitration in several respects, the most important of which is its relationship to the court system.¹⁵ Trademark owners have the option of either presenting their domain name case to a competent court, or invoking the dispute clause contained in every domain name registration contract to commence a UDRP case; in the latter event, trademark owners retain the possibility to go to court during or after such UDRP proceedings.

C. COMPLAINANT PAYS

12. As a base principle, the UDRP provides that a Complainant launching the procedure pays the entire fee for the proceeding.¹⁶ As a matter of fairness and with a view to optimal enforceability of the end result, the UDRP has been designed to minimize the Respondent's payment burden for this mandatory proceeding. Respondents are not obliged to make payments in order to defend their case.

13. In its Complaint the Complainant must indicate whether it seeks a single- or three-member Panel to decide the case.¹⁷ While a single-member Panel is appointed by the Center, a three-member Panel gives each party the opportunity to select a Panelist and to indicate preferences for the presiding Panelist. Even if the Complainant elects to have the dispute decided by a single-member Panel, the Respondent can request a three-member Panel, in which case it would pay half of the fee of such three-member Panel.¹⁸

D. LUMP-SUM FEES

14. UDRP fees have been set in a lump-sum format, basically varying only depending on Panel size or when the case concerns a larger number of domain names. This lump-sum arrangement allows for certainty on the part of the parties. The UDRP is maintained by WIPO on a not-for-profit basis. The same is true for many WIPO Panelists, again enhancing the UDRP's role as a cost-effective alternative to litigation. The Center additionally encourages settlement of UDRP disputes by refunding a significant proportion of the UDRP fees if a case is terminated prior to the appointment of the Panel.¹⁹

E. RESPONDENT-BASED LANGUAGE OF PROCEEDING

15. The UDRP provides that the language of the proceeding should normally be the language of the registration agreement which the Respondent used to register the domain name.²⁰ This provision optimizes the chances of properly notifying the Respondent of the case and minimizes the expense for a Respondent that wishes to defend itself. Both parties can agree to apply a different language from that of the registration agreement.²¹

¹⁵ UDRP, Para. 4(k).

¹⁶ UDRP, Para. 4(g).

¹⁷ UDRP Rules, Para. 3(b)(iv).

¹⁸ UDRP Rules, Para. (5)(b)(iv); UDRP, Para. (5)(d).

¹⁹ See WIPO Supplemental Rules, Annex D, note 2.

²⁰ UDRP Rules, Para. 11(a).

²¹ UDRP Rules, Para. 11(a).

F. NO LEGAL REPRESENTATION REQUIREMENT

16. UDRP parties have no obligation to retain counsel, meaning that both Complainants and Respondents have lower barriers to access and participation. It would be unrealistic to impose the requirement of counsel on parties of such diverse status and in so many different locations.

G. BRIGHT LINE CRITERIA

17. The UDRP places the basic onus on the Complainant to establish three criteria. The Panel will issue an order for the transfer (or cancellation) of the domain name if the following criteria are established:

- a) the domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- b) the domain name holder has no rights or legitimate interests in respect of the domain name; and
- c) the domain name has been registered and is being used in bad faith.²²

18. Especially in a dispute system which is mandatory for the defending party, it is vital for the credibility and enforceability of the results that they be as uncontroversial as possible. This purpose is served by the UDRP's limitation to clear cases of bad-faith behavior. The system is not designed to address claims against Respondents which, for example, have legitimate competing trademark rights, but rather aims to resolve clear cases of cybersquatting, which preserves fairness.

19. The UDRP criteria reflect common principles of trademark law. While the UDRP does not mandate the application of national law (outside the context of establishing trademark rights),²³ where parties are from a common jurisdiction, a Panel of the same nationality is normally appointed. In such cases, parties remain free to invoke principles of national law and Panels have authority to apply these principles within the broader UDRP context. Where local knowledge is deemed critical, Panels may also request specific submissions from the parties.²⁴

H. CRITERIA EXAMPLES

20. The first UDRP criterion tends to be a question of objective determination, at least where registered trademark rights are concerned. The application of the second and third criteria is assisted by the inclusion in the UDRP of actual examples of when a party may be deemed to have met such a test. Thus, the UDRP's bright line criteria are supported by concrete scenarios that are easy to understand for lawyers and laymen alike. This not only facilitates the filing and conduct of UDRP cases, but also has a policy and preventive effect; anyone wishing to register a domain name can easily grasp what is clearly prohibited under the UDRP as well as the types of behavior that are not normally subject to UDRP sanctions. UDRP decisions have also successfully developed a variety of bad-faith circumstances that are understood to be within the scope of this mechanism. Likewise, Panel decisions have identified a range of actions that are deemed permissible by the standards of the UDRP.

²² UDRP, Para. 4(a).

²³ UDRP Rules, Para. 15(a).

²⁴ UDRP Rules, Para. 12.

I. FIXED TIME LINE

21. An important procedural feature is the basic fixed time line of UDRP proceedings. Once the Complaint has been notified to the Respondent, the Respondent has 20 calendar days to prepare and send its Response to the Center and the Complainant.²⁵ After the Center has appointed a Panel, the Panel has 14 calendar days to submit its decision to the Center.²⁶

22. While the Center and the Panel can extend either of the periods,²⁷ this basic brevity reduces the legal costs for the parties, limits opportunistic parties in their efforts to drag out the procedure, and enables parties to predict the time frame for receiving a decision to within a few weeks. This speed and predictability also provide an incentive for rapid and successful settlement efforts by the parties.²⁸

J. SINGLE ROUND OF PLEADINGS

23. The UDRP only provides for one round of party pleadings;²⁹ the Panel normally will reach a decision on a Complaint and any Response received, although the UDRP gives the Panel the discretion to conduct the proceedings as it sees fit.³⁰ A Panel may invite supplemental submissions, or may consider additional, uninvited submissions from parties.³¹

K. WORD LIMITS FOR PLEADINGS

24. The UDRP provides word limits for the facts and arguments set out in party pleadings. The Center's Supplemental Rules clarify that neither the Complaint nor the Response shall be over 5,000 words, excluding evidentiary attachments.³²

L. MODEL SUBMISSIONS

25. The uniform format of the UDRP has allowed the Center to offer on its website a Model Complaint and a Model Response, reducing the cost and increasing the efficiency of the proceeding.³³ The Model Complaint and Response are templates which reflect the procedural formalities of the UDRP and the substantive criteria to be addressed. This makes it easier for parties to prepare adequate submissions.

26. While use of the Model submissions is not compulsory, they are often utilized. However, when a Respondent submits a simpler, less formal communication, it is not disqualified.

²⁵ UDRP Rules, Para. 5(a).

²⁶ UDRP Rules, Para. 15(b).

²⁷ UDRP Rules, Paras. 5(e) and 10(c).

²⁸ Over 20 % of WIPO UDRP cases are settled by the parties.

²⁹ UDRP Rules, Paras. 3 and 5.

³⁰ UDRP Rules, Para. 10(a).

³¹ *AutoNation Holding Corp. v. Rabea Alawneh*, WIPO Case No. D2002-0058.

³² WIPO Supplemental Rules, Para. 11.

³³ See <http://www.wipo.int/amc/en/domains/gtld/udrp/index.html>.

M. ONLINE COMMUNICATION

27. Subject to exceptions designed to maximize the Complaint notification options, the UDRP provides for electronic conduct of the case;³⁴ virtually all communication takes place by email. Furthermore, the UDRP contains a provision designed to discourage the holding of hearings, which are left entirely to the discretion of the Panel;³⁵ none have been held in WIPO cases so far.

N. POSTED DECISIONS

28. Covering a public resource, and based on a mandatory clause, the UDRP has been designed to maximize transparency of process and outcome. To this end, the Center posts all WIPO UDRP Panel decisions on its publicly accessible website after they are notified to the parties.³⁶ Public access to UDRP decisions is essential to developing and maintaining public and party trust in the UDRP system, the decision-makers, and the case administrators.

29. The posting of decisions also benefits party filing. While the UDRP does not operate on a strict doctrine of precedent, decision publication stimulates and enables parties and Panelists to take account of prior decisions covering similar circumstances, which can furthermore be identified through the Center's Legal Index³⁷ and its Jurisprudential Overview³⁸, both available for free online.

O. SPECIFIED AND LIMITED REMEDIES

30. The remedies of the UDRP procedure are specified and limited. The Complainant must choose between requesting the transfer (by far the more popular option) or the cancellation of the disputed domain name.³⁹ Likewise, Panelists are confined to accepting or rejecting the remedy requested. In particular, no party may seek, and the Panel has no authority to grant, any monetary compensation. This limitation avoids complicated damages questions.

P. BUILT-IN ENFORCEMENT

31. As noted, domain name holders are bound to the UDRP system through the ICANN-imposed obligation for registrars to include a UDRP clause in their registration agreements. Likewise, under the UDRP, registrars freeze the object of the dispute (the domain name registration) for the duration of the proceeding.⁴⁰ The final and crucial part of this cycle is the registrar's obligation to enforce the remedy decided by the Panel and notified to the registrar by the Center, subject only to the exception discussed in Section Q below.⁴¹

³⁴ UDRP Rules, Para. 2.

³⁵ UDRP Rules, Para. 13.

³⁶ See <http://www.wipo.int/amc/en/domains/search/legalindex.jsp>.

³⁷ See <http://www.wipo.int/amc/en/domains/search/legalindex.jsp>.

³⁸ See <http://www.wipo.int/amc/en/domains/search/legalindex.jsp>.

³⁹ UDRP, Para. 4(i).

⁴⁰ UDRP, Para. 8.

⁴¹ UDRP, Para. 4(k).

Q. COURT CHALLENGE OF RESULTS

32. If a Panel issues a transfer order, the UDRP grants the losing Respondent ten working days to submit official court documentation that it has commenced a lawsuit in an appropriate jurisdiction against the Complainant over the domain name registration. This court option, which allows the domain name holder the opportunity to further defend its rights to the domain name after an unsuccessful UDRP decision, fits with the UDRP's purpose of providing an additional procedure for resolving these types of disputes, not an alternative mechanism that takes away existing dispute options. It is in this regard again that the UDRP distinguishes itself from arbitration.

33. The UDRP not only leaves intact the court option, but in fact for a losing Respondent facilitates it through a "mutual jurisdiction" clause.⁴² Included in recognition of the mandatory nature of the UDRP for Respondents, this provision requires filing Complainants to accept a particular court jurisdiction (the Complainant must choose between the location of the Respondent or the location of the registrar) for the event that the Complainant prevails in the UDRP case and the Respondent wishes to take the dispute to court. Even if the UDRP enhances this court option, the Center's informal listing of known court cases shows that Respondents rarely present a UDRP case to court, primarily because most Respondents would not expect to do better in court.⁴³

34. In those rare instances where courts have been asked to pronounce themselves, they have generally reached the same conclusion as did the UDRP Panel.⁴⁴ Also, while finding that each court proceeding should be treated as a first instance proceeding under local law rather than an appeal under the UDRP, courts have not challenged the jurisdictional basis and procedural structure of the UDRP system as such.⁴⁵

III. EXTENDING THE UDRP MODEL TO OTHER ONLINE IPR DISPUTES

35. The design elements of the UDRP might be effectively applied notably in two further areas. First, whether by extending the scope of the UDRP or by taking its design into a new mechanism, the UDRP model might be applied to give IPR owners an ADR mechanism to challenge websites containing content that infringes IPR, even if the domain name itself does not infringe rights. Second, the UDRP model could be used to enhance the perceived fairness of private IPR policing systems. These systems could benefit from the neutrality and transparency of the UDRP.

A. EXTENDING THE UDRP TO IPR DISPUTES ABOUT WEBSITE CONTENT

36. It may be appropriate to consider extending the UDRP model to domain names that are not confusingly similar to another's trademark, but which are used for websites hosting content that infringes IPR.

37. A UDRP Complaint must meet all three of the substantive criteria outlined in section II. G above. For example, if the domain name is not confusingly similar to another's trademark, the Complaint must fail, even if the website associated with the domain name is used to sell counterfeit goods. Counterfeiters need not employ trademark-infringing domain

⁴² UDRP Rules, Paras. 1 and 3(b)(xii); UDRP Para. 4(k).

⁴³ See <http://www.wipo.int/amc/en/domains/challenged/index.html>.

⁴⁴ See <http://www.wipo.int/amc/en/domains/challenged/index.html>.

⁴⁵ See <http://www.wipo.int/amc/en/domains/challenged/index.html>.

names to attract Internet users; even without another's trademark in the domain name, search engines easily find webpages that use trademarks in website content to promote counterfeits. The harm to IPR owners is the same regardless of whether the trademark appears in the domain name, especially given the heavy use of search engines, rather than typed-in domain names, to locate websites.

38. UDRP decisions already recognize that the sale of counterfeit goods on a website is not a *bona fide* use of another's trademark and that such conduct is evidence of bad-faith registration and use of the domain name.⁴⁶ The UDRP decisions also display skepticism about conclusory allegations of counterfeiting, insisting instead that bare allegations be supported by facts supporting such allegations.⁴⁷ This is important when considering whether to extend the UDRP model because it not only illustrates the value of publishing transparent decisions, but also demonstrates that a procedure for resolving online disputes about website content can be administered with due regard for respondents' rights, even those of counterfeiters that make no effort to respond.

39. The broad legal foundation for employing the design elements of the UDRP model to infringements occurring only in the content of a webpage already exists. ICANN's Registrar Accreditation Agreement stipulates that Registrars require all Registered Name Holders to represent that, to the best of their knowledge, "neither the registration of the Registered Name nor the manner in which it is directly or indirectly used infringes the legal rights of any third party".⁴⁸ Even if a registered domain name does not itself infringe a trademark, the example of domain name use for a webpage that offers counterfeit goods could be considered use to infringe the legal rights of a third party. The ICANN Registrar Accreditation Agreement also requires that domain name owners agree that the domain name "be subject to suspension, cancellation, or transfer pursuant to any Specification or Policy ... for the resolution of disputes concerning the Registered name".⁴⁹

40. Actual implementation of such UDRP application would no doubt be subject to a degree of complexity. However, as one commentator who has advocated the extension of the UDRP to authorize seizure of domain names engaged in a broad range of IPR infringement has aptly observed:

"The UDRP procedure offers major procedural advantages, compared to the national judicial procedures. It is a streamlined – very fast and relatively inexpensive – procedure. Cases are decided by specialized intellectual property law experts, rather than general competence judges, the body of UDRP arbitrators is international, free from political influences and governmental complexities. The author believes that domain seizure through the UDRP also [owes] its success to addressing the three "offline" limitations of the traditional remedies, *i.e.*, the UDRP effectively deals with the unknown party and

⁴⁶ See, e.g., *Karen Millen Fashions Limited v. Belle Kerry*, WIPO Case No. D2012-0436 (Panelist David Bernstein: "[T]here can be no legitimate interest in the sale of counterfeit goods."); *Mattel, Inc. v. Magic 8 ball factory*, WIPO Case No. D2013-0058 (Panelist Isabel Davies: "Panelists in other decisions have found bad faith registration where the respondent sells counterfeit merchandise.") (Collecting cases); *Paul's Boutique Limited v. yang zhi he*, WIPO Case No. D2013-0088 (Panelist M. Scott Donahey: "Panel decisions have held that the offering for sale of counterfeit goods on a web site ... constitutes bad faith registration and use under paragraph 4(b)(iv) of the Policy.")

⁴⁷ See, e.g., *Karen Millen Fashions Limited v. Belle Kerry*, footnote 46 above, (rejecting mere allegation that goods were "verified" to be counterfeit and calling for supplemental evidence such as customer complaint logs, "a review of the product images (with an explanation as to why the color, cut, fabric, or other elements make the products appear not to be authentic), or on evidence that the pricing is so low as compared to the regular prices that counterfeiting can be inferred, or other circumstantial evidence").

⁴⁸ ICANN Registrar Accreditation Agreement, Para. 3.7.7.9, available at: <https://www.icann.org/en/system/files/files/approved-with-specs-27jun13-en.pdf>.

⁴⁹ ICANN Registrar Accreditation Agreement, Para. 3.7.7.11.

foreign jurisdiction problems. The UDRP and domain seizure remedy are aimed directly at the infringer, rather than at the unknown and anonymous party. [A] [d]omain name, which is used for illicit activities, is very close to the source of the infringement ... ”.⁵⁰

B. UDRP TRANSPARENCY AND NEUTRALITY COULD ENHANCE THE PERCEIVED LACK OF FAIRNESS OF PRIVATE IPR PROTECTION

41. Over the last decade, online platforms have made available dispute resolution mechanisms to respond to the needs of IPR owners facing infringements and counterfeiting online. The various “notice and takedown” mechanisms offered by platforms such as Google, Facebook, and eBay have provided important relief for widespread abuses. Still, public support for these systems could be improved by such systems adhering to the transparency and neutrality principles reflected in the UDRP.

42. As one UDRP Panelist has observed, compared to the transparency of the UDRP system, private determination procedures are typically opaque.⁵¹ There is generally little or no information about how decisions are made. For example, Google’s policy for policing the use of AdWords to sell counterfeit goods states only that Google “will investigate all reasonable complaints”.⁵² And “[i]n contrast to Google’s avowed philosophy of transparency in takedown notices, the exact details of [its Trusted Copyright Removal program (TCRP)] are shrouded in relative secrecy”.⁵³ Twitter reports on the number of takedown requests it receives, the percentage that result in takedowns, and the number of accounts affected, but it does not disclose the particulars of any investigation.⁵⁴

43. The same is true for outcomes. None of the considered private IPR protection systems publishes a record of particular outcomes.

44. In terms of motivation, it bears emphasis that online platforms generally employ “notice and takedown” procedures because national laws such as the Digital Millennium Copyright Act (DMCA) in the United States and the European Union’s Electronic Commerce Directive require such procedures as a precondition to safe-harbor immunity for online service providers. Comparable legislation has been adopted in other parts of the world.⁵⁵

⁵⁰ Mindaugas Kiškis, footnote 2 above, 1450.

⁵¹ Andrew Christie, *Voluntary Mechanism for resolving IP Disputes*, document prepared for the eighth session of the WIPO Advisory Committee on Enforcement, WIPO/ACE/8/10 (2012), available at: http://www.wipo.int/meetings/en/doc_details.jsp?doc_id=218926.

⁵² Google discloses the number and identity of copyright owners, and the identity of the related domains that are the subject of the notice, see <http://www.google.com/transparencyreport/>.

⁵³ Daniel Seng, *The State of the Discordant Union: An Empirical Analysis of DMCA Takedown Notices*, 18 Virginia Journal of Law and Technology (2014), 369, 462, available at: http://papers.ssrn.com/sol3/papers.cfm?abstract_id=2411915 (based on Google data, only 0.020% of takedown notices result in counter notices).

⁵⁴ See <http://ipspotlight.com/2012/11/08/twitter-announces-new-policy-to-publicize-copyright-takedown-notice/> and <https://support.twitter.com/groups/33-report-a-violation/topics/148-policy-information/articles/15795-copyright-and-dmca-policy>.

⁵⁵ Daniel Seng, footnote 53 above, 373: “In October 2013, the [United States] Digital Millennium Copyright Act (DMCA) celebrated its fifteenth anniversary. Enacted to limit the liability of Internet intermediaries as service providers, the DMCA safe harbor provisions have been credited with ensuring the very existence of the Internet and preserving the variety and quality of its content. They have further served as the basis for similar provisions in the intellectual property chapter in the free trade agreements entered into between the United States and Australia, Bahrain, Central America–Dominican Republic states, Chile, Colombia, [Republic of] Korea, Morocco, Oman, Panama, Peru, and Singapore. They also have served as the template for the enactment of similar defenses in the European Union, including the United Kingdom, and the People’s Republic of China. Considering that the safe harbor provisions form no part of any international intellectual property and copyright treaties, the DMCA safe harbors have indeed gone global. And the world has embraced the DMCA”.

45. Despite evidence that the notice-and-takedown system is successful,⁵⁶ lack of transparency in the decision-making process and the failure to publish individualized outcomes can contribute to a perception of unfairness.⁵⁷ Such concerns are relevant to all stakeholders because they relate to the integrity of IPR enforcement systems. If a voluntary IPR protection system is seen as unfair, it will garner only limited support.

46. As one option to alleviate such concerns, the private takedown determination could continue as the initial determination of the dispute, but could be followed by an option to commence an “appeal” based on the UDRP model. This would allow the vast majority of disputes to be handled by the private mechanism, but allow parties dissatisfied with the private decision to have recourse before, or without, resorting to the national courts. While platform providers may want to retain a degree of discretion and flexibility overall, adding transparency and neutrality based on the UDRP model could enhance public support for their private IPR adjudication.

47. Because Internet users increasingly rely on dominant online platforms like Facebook, Google, Alibaba, and eBay, the processes and procedures these providers employ to protect IPR have a substantial impact in the enforcement of such rights throughout the world. Where scalable in this specific context, the UDRP could serve as a model to strengthen such providers’ IPR decisions.

IV. CONCLUSION

48. The UDRP has met with great demand as a respected mechanism for resolving IP disputes about domain names expeditiously and fairly. It is appropriate to consider whether its design elements may be usefully applied to other online disputes.

49. Notably, the UDRP model could offer a procedure for authorizing the transfer of a domain name hosting webpage content that violates IPR (such as selling counterfeit goods), even if those webpages operate under domain names that do not themselves infringe another’s trademark.

50. As a further example, the UDRP model could be considered as an appellate mechanism to alleviate concerns about takedown decisions by private IPR protection decision-makers.

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⁵⁶ See footnote 53 above.

⁵⁷ For example, political groups have secured takedown notices to stop use of an opponent’s media in negative political advertising on YouTube (see <http://www.queerty.com/stand-for-marriage-maine-is-hateful-but-they-should-be-able-to-use-nprs-report-20091021> and <https://www.eff.org/takedowns/cbs-news-censors-mccain-ad-during-heated-presidential-campaign>), and creators of parodies published on YouTube and Twitter accounts have complained about unfair takedowns (see <http://www.dailydot.com/society/new-york-times-parody-twitter-on-it/> and <http://www.dailydot.com/news/time-warner-cable-customer-service-worse/>). The work of several policy advocacy groups, such as the University of California-Berkeley’s “Takedown Project” (<http://takedownproject.org/>), reflects their perception that private IPR protection systems are not protecting the rights of users.