



WIPO Conference: 10 Years UDRP – What's Next?

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**Theme 1.2: Key Issues for WIPO Panelists – Forks in the Road –
Reflections on the UDRP and Beyond**

National Law Perspectives

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Ambiguous status of National Law

- **Rules of national law long accepted as relevant to assessment of trade mark rights**
 - ▶ *Technologies, Inc. v. International Electronic Communications, Inc.*, WIPO Case No. D2000-0270
- **But to what extent is it otherwise relevant, particularly on the issue of bad faith?**

Limited Guidance of Policy and Rules

- **Rules paragraph 15:**

“A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules, and any rules and principles of law that it deems applicable”

- **Policy paragraph 4(k) reference to local court and proceedings being resolved by:**

“a copy of an order from such court dismissing your lawsuit or ordering that you do not have the right to continue to use your domain name”.

Different Approaches?

- **The “both parties in the same jurisdiction then local law applies” approach**
 - ▶ *Document Technologies, Inc. v. International Electronic Communications, Inc.*, WIPO Case No. D2000-0270 (applying U.S. law);
 - ▶ *American Mensa, Ltd. v. Alan Heigl et al.*, WIPO Case No. D2005-0068 (applying U.S. Law).
- **The choice of law approach:**
 - ▶ *Sermo Inc v Catalyst MD LLC*, WIPO Case No. D2008-0647

Non-local “sui generis” approach (1)

- ***Delta Air Transport NV (trading as SN Brussels Airlines) v. Theodule de Souza*, WIPO Case No. D2003-0372**

“trademark infringement and abusive registration within the meaning of para 4(a)(iii) of the Policy are two different things”

and

“the fact that a particular set of facts may constitute trade mark infringement has of itself no bearing on whether it is an abusive registration”

Sui Generis (2)

- ***Covance Inv v The Covance Campaign* D2004-0206**

“As a matter of principle, this Panel would not have thought that it was appropriate to import unique national legal principles into the interpretation of paragraph 4(c) of the Policy. This is so even if the effect of doing so is desirable in aligning decisions under the Policy with those emerging from the relevant courts and thus avoiding instances of forum shopping”

Sui Generis (3)

- ***1066 Housing Association Ltd. v. Mr. D. Morgan*, WIPO Case No. D2007-1461**

“This Panel would suggest that there is no real justification for such a local laws approach either in the Policy or the Rules and that such approach should be avoided wherever possible. It risks the UDRP fragmenting into a series of different systems, where the outcome to each case would depend upon where exactly the parties happened to reside.” (Para 6.60)

- ***Followed in Fundación Calvin Ayre Foundation v. Erik Deutsch*, WIPO Case No. D2007-1947**

In Practice

- **Rare that local law is determinative.**
- **In vast majority of cases, there is a decision by reference to the Policy wording alone and the now extensive Policy jurisprudence.**
- **Claims of local law seems to raise their head in more controversial issues under the Policy.**
- **But even in controversial cases there is often a striving towards a consensus that is not dependant on local law:**

E.g. *Grupo Costamex, SA de C.V. v. Stephen Smith et. al*, WIPO Case No. D2009-0062

Reaction of the Courts?

- **Practical criticism of “sui generis” approach is a claim that if the Policy strays too far from local law approach then local law court challenges will be so frequent that the Policy will be brought into disrepute.**
- **So what is the reaction of the courts to paragraph 4(k) actions following decisions?**

Reaction of the Courts?

- **English Courts:**
 - ▶ *Patel v. Endo Pharmaceuticals Inc (High Court, Chancery Division, November 30, 2006);*
 - ▶ *Pankajkumar Patel v. Allos Therapeutics Inc (High Court, Chancery Division, June 13, 2008);*
<http://www.nominet.org.uk/disputes/caselaw/index/patelvallos/>
- **Detailed analysis of jurisdiction and reluctance to intervene**
- **Will other courts adopt a similar self denying approach?**