



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

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Theme 1.3: Building on the UDRP – Variations in the ccTLD Space

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Evolution of the ccTLD domain name space

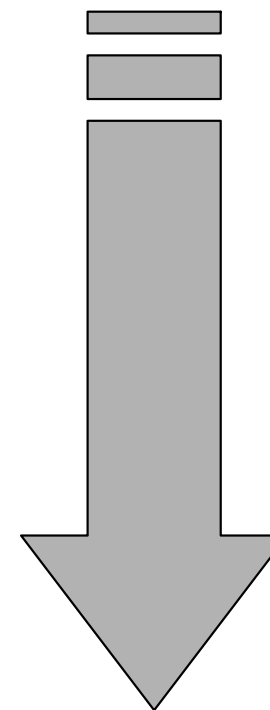
“Restricted” vs. “Open”

- **Restricted eligibility criteria**

- ▶ Entities / Individuals
- ▶ National connection – locality, company name, business name, trading name, trade mark

- **Open commercialization models**

adopted by many registries today .me, .tv, .es



Substantive variations across different (WIPO administered) ccTLD policies

- **UDRP: 37**
 - ▶ .ag, .am, .as, .bm, .bs, .bz, .cc, .cd, .co, .cy, .dj, .ec, .fj, .gt, .ki, .ky, .la, .lc, .md, .me, .mw, .na, .nr, .nu, .pa, .pk, .pn, .pr, .ro, .sc, .sl, .tk, .tt, .tv, .ug, .ve, .ws
- **Variations of UDRP: 14**
 - ▶ .ae, .ao, .au, .bo, .es, .ie, .ir, .hn, .nl, .mp, .mx, .pe, .ph, .tm
- **Other (UDRP-inspired) administrative procedure: 5**
 - ▶ .ch, .fr, .li, .ma, .re
- **Arbitration: 4**
 - ▶ .ac, .io, .pl, .sh



Key variations across ccTLD policies (1)

- **1st Element: scope of protection**
 - ▶ Trade Mark Rights or More?
 - ▶ Registered trade mark rights
 - ▶ Unregistered trade mark rights
 - ▶ Common law
 - ▶ Unfair competition
 - ▶ Copyright (.fr)
 - ▶ Identical or confusingly similar?
 - ▶ Infringement under national law
 - ▶ .ch
 - ▶ .fr: - complainant only proves 1st element
 - respondent can rebut based on 2nd and 3rd elements

Key variations across ccTLD policies (2)

- **2nd Element**
 - ▶ As an alternative to bad faith?
.eu
- **3rd Element: extent of bad faith**
 - ▶ The “and” / “or” dichotomy
.au, .uk, .ie, .es
- **.UK – “Abusive registration” Concept**
 - ▶ List of circumstances indicating “abusive registration”
 - ▶ List of factors indicating not an “abusive registration”



Key variations across ccTLD policies (3)

- **Other key variations**
 - ▶ Internal Registry Review Procedure
 - ▶ Reserved names / marks (.au, .fr)
 - ▶ Obviously prohibited domains (.au, .fr)
 - ▶ Alternative Dispute Resolution
 - ▶ Mediation
 - ▶ .uk, .ch
 - ▶ Summary Decision Procedure
 - ▶ In case of Respondent's default (.uk)
 - ▶ In case of obvious infringement (.fr)

Key variations – Examples for the UDRP? (1)

3rd Element

- Does the domain name need to be “registered” and “used” in bad faith?
- Should plain *indicia* of bad faith suffice?
 - ▶ Statistics based on WIPO Cases:
 - ▶ UDRP (1999-2009): 85% of transfers or cancellations
 - ▶ .au (2002-2009): 63% of transfers of cancellations
 - ▶ .fr (2004-2009): 88% of transfers or cancellations



Key variations – Examples for the UDRP? (2)

Internal Registry Review Procedures - .au

- **Reserved Names List**

.au Registry performs audits in its database and removes domain names from the registry

- ▶ names (including letters, numbers and hyphens) restricted under Commonwealth legislation; or
- ▶ names that may pose a risk to the operational stability and utility of the .au domain

Examples: “Commonwealth Federal”, “Anzac”, “United Nations”

<http://www.auda.org.au/policies/auda-2008-03/>



Key variations – Examples for the UDRP? (3)

Internal Registry Review Procedures - .au

- **Prohibition on Misspellings Policy (2008-09)**

- ▶ **Scope of the prohibition**

- a person deliberately registers a misspelling of a popular domain name in order to divert trade or traffic
- covers “entity names”, “personal names”, and “brand names”

- ▶ **Proceedings**

registrants are given 7 days to prove their domain name is not a prohibited misspelling or else auDA will instruct the registrar to delete the domain name

Examples: yhoo.com.au, 9msn.com.au, wwwseek.com.au,
micro-soft.com.au

<http://www.auda.org.au/policies/auda-2008-09/>



Key variations – Examples for the UDRP? (4)

Alternative Dispute Resolution – Mediation, .uk, .ch

- ▶ After receipt of Respondent's response
- ▶ Compulsory (.uk) or voluntary (.ch)
- ▶ Limited time period: 10 day period (.uk) or 20 day period (.ch)
- ▶ Conducted by Registry staff (.uk) or by an independent third party (.ch)
- ▶ Free (.uk) or not (.ch, fees CHF 600)
- ▶ Confidential



Key variations – Examples for the UDRP? (5)

Summary Decision Procedure

- **Respondent's default (.uk)**
 - ▶ Option between summary decision (only available when Respondent defaults) (fees £200 + VAT) and full decision (fees £750 + VAT)
- **Obvious infringements (.fr)**
 - ▶ Fees €250 + VAT
 - ▶ From July 2008 to September 2009, 92 decisions
 - ▶ Panel: AFNIC's Director and AFNIC staff
 - ▶ No appeal
 - ▶ No implementation of the decision if a party files a court proceeding or an administrative complaint (within 15 days of the day of the publication of the decision)

Evolution of ccTLDs in WIPO Cases

- **A growing number of ccTLDs are using WIPO dispute resolution services**
- **As a proportion of the total, the relative number of ccTLD domain name cases filed with WIPO has been increasing over the years**
 - ▶ 2000: less than 1%
 - ▶ 2008: 13%
 - ▶ 2009: 14% (estimate)
 - ▶ From December 1999 to September 2009: 1,217 ccTLD cases