

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

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Theme 1.1: The UDRP - Design Elements, the Changing Domain Name Industry, and the Evolution of Precedent and Procedural Practice – The Road Thus Far

The Evolution of Procedural Practice

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Precedent and Procedural Practice

- Just as important as the value of predictability and (non-binding) decision precedent in matters of UDRP substance, is its indispensability on matters of procedural practice.
- The UDRP Rules provide the key framework for guidance to filing parties, providers and panels on matters of procedure in UDRP cases – supplemented where appropriate by provider Supplemental Rules.
- There are also many practical (but no less important) aspects on which the Rules may be silent, or provide only general guidance - or which reserve to the panel discretion to make an appropriate determination.



Precedent and Procedural Practice

- For example, panels have certain explicit discretions under the UDRP Rules:
 - ▶ e.g. to request further statements under para. 12, or decide language under para. 11, and determine admissibility of evidence under para. 10(d)).
- Panels also have broad general powers to conduct a UDRP proceeding as they consider appropriate – subject to ensuring the parties are treated with equality, and that the proceeding is conducted with due expedition (paras. 10(a), (b) and (c)).



Precedent and Procedural Practice

- Collectively, these powers provide a necessarily *tensile* basis for panels ‘filling in the mortar’ between the procedural bricks of the UDRP process.
- And as panel decisions accumulate, they can also provide a valuable basis for the development of procedural practices over time which address practical party needs.



Precedent and Procedural Practice

- This is important for UDRP providers and parties because:
 - ▶ many of the procedural issues that come up in a UDRP case can occur and require practical resolution *before* a panel is even appointed; and
 - ▶ providers *per se* have limited power under the UDRP Rules to make determinations where there is uncertainty.

Precedent and Procedural Practice

- Hence, the value of accumulating and distilling panel guidance on such matters – it can give providers and parties a predictable basis on which to anticipate the way in which panel discretion on particular procedural questions has tended to be exercised in prior cases.



Precedent and Procedural Practice

- The challenge for WIPO as a provider (on behalf of users of its UDRP services where the Rules are unclear) is therefore to:
 - ▶ provide a clear basis for predictably resolving procedural issues which are not always expressly covered by the Rules;
 - ▶ in a manner consistent with the general framework (and in the spirit of fairness and expediency) of the UDRP Rules;
 - ▶ which aligns with the approach prior panels have taken in their decisions;
 - ▶ while also preserving panel discretion to review all such matters on appointment in the individual case.

Precedent and Procedural Practice

- This requires provider investment in the infrastructure of UDRP case administration.
- Two contributions WIPO has made to the collection and distillation of WIPO panel thinking on matters of procedural practice are through the WIPO Overview of panel decisions (<http://www.wipo.int/amc/en/domains/search/overview/index.html>), and the WIPO Legal Index (<http://www.wipo.int/amc/en/domains/search/legalindex.jsp>).
- The WIPO Overview is currently being extensively revised in consultation with WIPO panelists, and new categories and decisions are regularly updated in the WIPO Legal Index.

Precedent and Procedural Practice

- **Re-filing**

- ▶ The UDRP and Rules are silent on the issue of when and in what circumstances a refiled complaint be accepted?
- ▶ WIPO Panels have laid down principles restricting the filing of such complaints to circumstances in which, for example, new evidence not available at the time of filing has come to light – and charged providers with conducting a *prima facie* assessment to disallow the filing of such complaints where there is no possibility of a panel accepting the complainant's request.
- ▶ The *Creo* case (WIPO Case No. D2000-1490).

Precedent and Procedural Practice

Privacy and respondent identity

- ▶ WIPO panels have endorsed a WIPO practice in which registrar-disclosed information about an underlying registrant is provided by WIPO to the complainant - who then has the option to amend their complaint (or not) - with a response accepted either from the privacy provider or the underlying registrant.
- ▶ The *Research in Motion Cases, inter alia*, (WIPO Case Nos. D2009-0320 and D2009-0324).

Precedent and Procedural Practice

- **Suspension and settlement (25% of cases settle prior to Panel Appointment)**
 - ▶ WIPO panels have endorsed a long-standing WIPO mechanism in which parties may request a settlement suspension period, in which registrars would implement any transfer agreement reached by the parties prior to panel appointment (with panel fee fully refunded by WIPO if settled, and proceedings moving forward if not).
 - ▶ The *ANOVO* and *AT&T* cases, *inter alia*, (WIPO Case Nos. D2009-0091 and D2000-1723).

Precedent and Procedural Practice

Supplemental filings

- ▶ Rules give panel power to request further statements, and determine weight and admissibility of evidence (Rules paras. 12 and 10(d)).
- ▶ WIPO panels have endorsed WIPO's placement of unsolicited supplemental filings before the appointed panel for determination by that panel on acceptance and admissibility (if any) at that panel's discretion (WIPO does not charge for this).
- ▶ The *Wal-Mart Case, inter alia*, WIPO Case No. D2008-0193.

Precedent and Procedural Practice

- **Language of proceedings (LOP)**
 - ▶ Rules give panel discretion to determine (Rules para. 11).
 - ▶ WIPO panels have endorsed a WIPO practice in which both parties are given an opportunity to comment on language before commencement, a preliminary determination may be made by the provider to accept a complaint and response in either language, and conduct proceedings in dual language (all subject to panel review).
 - ▶ Provides fairness to both parties, recognizing the reality that many cases tend to be defaults, and minimizes abuse of the LOP provision.
 - ▶ The *Fissler* and *Zappos.com* Cases, *inter alia*, WIPO Case Nos. D2008-1002 and D2008-1191.

Precedent and Procedural Practice

- **Consents to transfer**
 - ▶ WIPO panels have laid down a basis on which genuine respondent consent to a remedy sought by a complainant may be given expeditious effect without necessarily requiring the recording of substantive determination on the merits - e.g. where there is clear consent, complainant has trademark rights, and respondent is not abusing the process to cause delay.
 - ▶ The *Brownells* and *John Bowers Cases*, *inter alia*, (WIPO Case Nos. D2007-1211 and D2008-1720).

Precedent and Procedural Practice

- **Consolidation**

- ▶ UDRP Panels have power to consolidate multiple domain name disputes (Rules para. 10(e)).
- ▶ WIPO panels have laid down principles on when and in what circumstances complaints may be brought by multiple complainants with a *common grievance* or *common legal interest* - where *equitable* and *procedurally efficient* to do so.
- ▶ The *Fulham Football Club* and *Phillies and Padres* Cases, *inter alia*, (WIPO Case Nos. D2009-0331 and D2009-0985).

Precedent and Procedural Practice

- The development of such procedural practice through panel precedent - always within the broader framework of the Policy and Rules - can also help the UDRP mechanism evolve with the times.
- And in many ways, an effective, predictable and forward-looking UDRP procedure is a necessary complement to the substantive determinations made by panels in fulfilling the UDRP's broader objective of providing a fair and cost effective mechanism for resolving clear cases of abusive cyber squatting – especially in the context of an expanding domain name system.