



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

October 12, 2009

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

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WIPO Arbitration and Mediation Center





Cybersquatting Challenging Court System

- **Not each infringing domain name is worth litigation cost**
- **That cost is increased by the frequently foreign seat of domain name holder**
- **Low domain name registration threshold (low fees, no check of registrant data, transferability) complicates enforcement**
- **Application of trademark protection norms may differ**
- **Court system developing expertise for this type of dispute**

The UDRP Alternative

- **May 1997: gTLD-MoU issued by IAHC**
- **June 1998: USG White Paper**
- **April 1999: Final Report of the First WIPO Internet Domain Name Process**
- **October 1999: Adoption by ICANN of UDRP**
- **December 1999: Entry into force of UDRP**

UDRP Design Elements (I)

- **Uniform application**
- **Claimant pays**
- **Lump sum fees**
- **'Bright-line' criteria**
- **Criteria examples**
- **Fixed timelines**
- **No hearings**
- **One round of pleadings in principle**

UDRP Design Elements (II)

- **Submission word limits**
- **Online communication**
- **Posted decisions**
- **Specified remedies**
- **No damages**
- **Built-in enforcement**
- **Subject to court option**

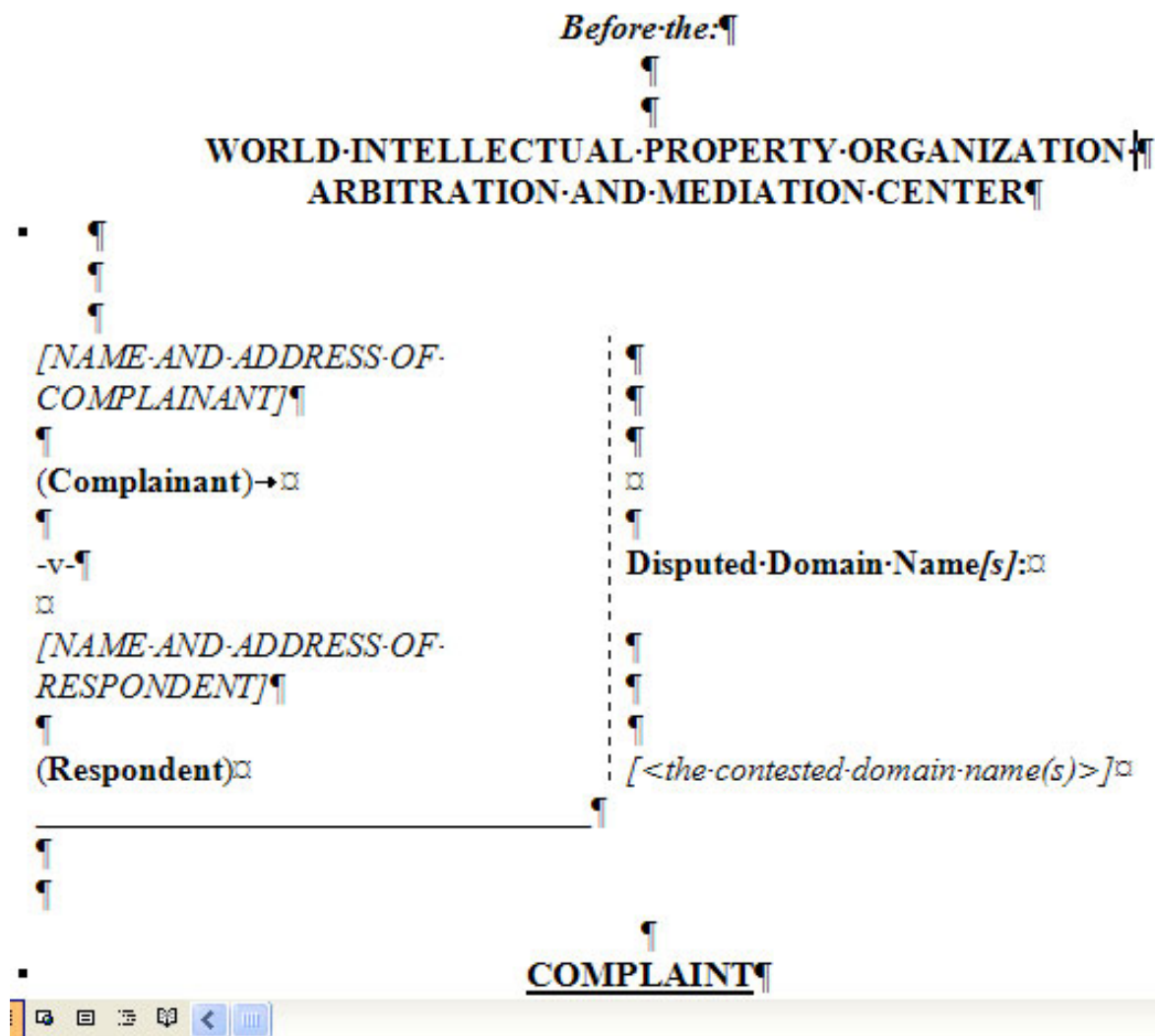
Arbitration and Mediation Center - Trademark Database Portal

Note that not all intellectual property offices and organizations have publicly accessible on-line trademark databases and that any searches using the links provided on this site will not be sufficient to determine definitively whether or not the domain name is infringing.

Last updated: 08-Apr-2009

REGISTRATION AUTHORITY	TRADEMARK DATABASE
Madrid International Registrations	http://www.wipo.int/madrid/en/services
Office for Harmonization in the Internal Market (Community Trademarks)	http://oami.europa.eu/CTMOnline/RequestManager/en_SearchBasic
Benelux Trademarks Office	http://www.bmb-bbm.org/qb/pages/index.htm
Andorra	(access subject to payment) Database exists but not available on publicly accessible web site, please contact: Trademarks Office of the Principality of Andorra Xavier Cuenca Baixada del Molí, 26 Andorra La Vella Telephone: 376 86 57 00 Facsimile: 376 86 68 61 E-mail: ompa@andorra.ad
Argentina	Database exists but not available on publicly accessible web site, please contact: National Institute of Industrial Property Roxana Bardi Paseo Colón 717 1063 Buenos Aires Argentina Telephone: 54 11 43 44 49 36 Facsimile: 51 11 43 44 49 38

WIPO Model Complaint



WIPO Panelists

ORGANISATION MONDIALE
DE LA PROPRIÉTÉ INTELLECTUELLE

Centre d'arbitrage et de médiation de l'OMPI



WORLD INTELLECTUAL
PROPERTY ORGANIZATION

WIPO Arbitration and Mediation Center

WIPO LIST OF NEUTRALS

BIOGRAPHICAL DATA

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Edward Ball Eminent Scholar
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Nationality: American

EDUCATIONAL AND PROFESSIONAL QUALIFICATIONS

LL.M., University of California, Berkeley, School of Law, 1989;
J.D., Yale Law School, 1977;
B.A., "With Highest Honors" (Summa Cum Laude) and "With Great Distinction in the Major".

WIPO Daily Decision Mailing List

Most recently notified WIPO Domain Name Decision(s):

<http://www.wipo.int/amc/en/domains/decisions/html/2009/des2009-0036.html>

panaria.es
> Transfer

<http://www.wipo.int/amc/en/domains/decisions/html/2009/dae2009-0002.html>

hardees.ae
> Transfer

<http://www.wipo.int/amc/en/domains/decisions/html/2009/d2009-1121.html>

livefoxsports.info
> Transfer

<http://www.wipo.int/amc/en/domains/decisions/html/2009/d2009-1084.html>

dkb.com
> Transfer

<http://www.wipo.int/amc/en/domains/decisions/html/2009/d2009-1078.html>

talbots-corp.com
> Transfer

<http://www.wipo.int/amc/en/domains/decisions/html/2009/d2009-1070.html>

feiyue-sneakers.com

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MEDIATION CENTER

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WIPO Overview of WIPO Panel Views on Selected UDRP Questions

[WIPO eUDRP Initiative](#) **New**

[Added Legal Index Search Categories as of March 20, 2008](#)

Decision-making authority under the Uniform Domain Name Dispute Resolution Policy and Rules (UDRP) lies exclusively with the appointed panels. To assist awareness of their views on certain questions that commonly arise in proceedings under the UDRP, the WIPO Arbitration and Mediation Center has produced the following informal overview of panel positions on key procedural and substantial issues. Decision references supporting each line of opinion are included, with over 100 decisions from over 80 different UDRP panelists listed.

While some of the listed issues arise only infrequently, all of them are, or are perceived to be, relevant to the operation of the UDRP. On most of these issues, consensus or clear majority views have developed. Certain other questions continue to attract a diversity of views. The Center's identification of questions and evaluation of opinions is based on the 7,000 UDRP cases it has administered through February 2005. **Broad information on all views is available from the Center's online Legal Index of WIPO UDRP Panel Decisions (<http://www.wipo.int/amc/en/domains/search/>), as well as from the full posting of all decisions (<http://www.wipo.int/amc/en/domains/decisions.html>).**

This overview is created in recognition of the need that has been expressed to identify, as much as possible, consensus among UDRP decisions, so as to maximize the consistency of the UDRP system. It should be understood that, with UDRP decisions covering a multitude of facts and arguments, genuine differences of opinion may be difficult to avoid on particular issues, all the more so where panelists and parties come from a multitude of jurisdictions. However, it is hoped that this update on the UDRP experience will be found helpful by identifying views expressed by panels and providing decisions which help to put those views in context.

While predictability remains a key element of dispute resolution systems, neither this informal overview nor prior panel decisions are binding on panelists, who will make their judgments in the particular circumstances of each individual proceeding. Also, it remains the

WIPO Legal Index of WIPO Panel Decisions

Legal index to WIPO panel decisions

I. General

- A. Competence
- B. Mandatory Proceeding

II. Substance

- A. Identical or Confusingly Similar to a Trademark or a Service Mark in which the Complainant has Rights (Policy, Para. 4(a)(i))

1. Trademark / Service Mark

- a. General
- b. Goods or services associated with mark
- c. Distinctiveness
 - (i) General
 - (ii) Generic / Descriptive
 - (iii) Suggestive
 - (iv) Arbitrary; Fanciful
- d. Mark validity in question
- e. Device mark
- f. Registered mark
- g. Unregistered mark
- h. Well-known mark
- i. Personal names

Registered

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Selection of UDRP-related Court Cases

This section offers a selection of court orders and decisions in relation to the [UDRP](#) or specific UDRP cases that have come to the attention of the WIPO Arbitration and Mediation Center. While every effort is being made to keep this list complete and up-to-date, the Center cannot guarantee that it includes all relevant cases.

Court cases that are pending or for which no order/decision is available are not published on this list. Relevant court orders and decisions that are not listed may be [brought to the attention](#) of the Center.

COURT REFERENCE	DOMAIN NAME(S)	UDRP CASE NUMBER
Pankajkumar Patel v Allos Therapeutics Inc, High Court of Justice Chancery Division, Claim No: HC07C01730, June 13, 2008 (2008 WL 2442985) [United Kingdom]	allostherapeutics.com	WIPO Case No: D2007-0521
MailPlanet.com, Inc. v. Lo Monaco Hogar, S.L., Case No. 08-11402-G U.S. U.S. Court of Appeals for the 11th Circuit [United States of America]	lomonaco.com	WIPO Case No: D2005-0896
Gioacchino Zerbo v. Microsoft Corporation, La Corte d'Appello di Milano, July 13, 2006 [Italy]	internetexplorer.com	WIPO Case No: D2005-0644
Junghu Kang v. Myspace, Inc., Seoul Central District Court, August 30, 2007 [Republic of Korea]	mypsce.com	NAF FA672160
Victoria's Secret Stores, et al., v. Artco Equipment Company, Inc. Case No. C-2-01-198, United States District Court, S.D. Ohio, Eastern Division, March 27, 2002 [United States of America]	victoriassecrets.net	NAF FA94342

WIPO Domain Name Dispute Resolution Statistics

Filing and Parties

- [Total number of cases by year](#)
- Total number of cases per month for
- [Geographical distribution of parties \(Alphabetical\)](#)
- [Complainant country filing \(Ranking\)](#)
- [Respondent country filing \(Ranking\)](#)
- Complainant filing by country
- Respondent filing by country
- Filing by named complainant
- Named respondent
- [Areas of complainant activity \(Decided Cases\)](#)
- [All case languages by year and total](#)
- All case languages (Ranking)
- Case language by year

Domain Names

From the 1st WIPO UDRP-based Case ... (worldwrestlingfederation.com)



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

World Wrestling Federation Entertainment, Inc. v. Michael Bosman

Case No. D99-0001

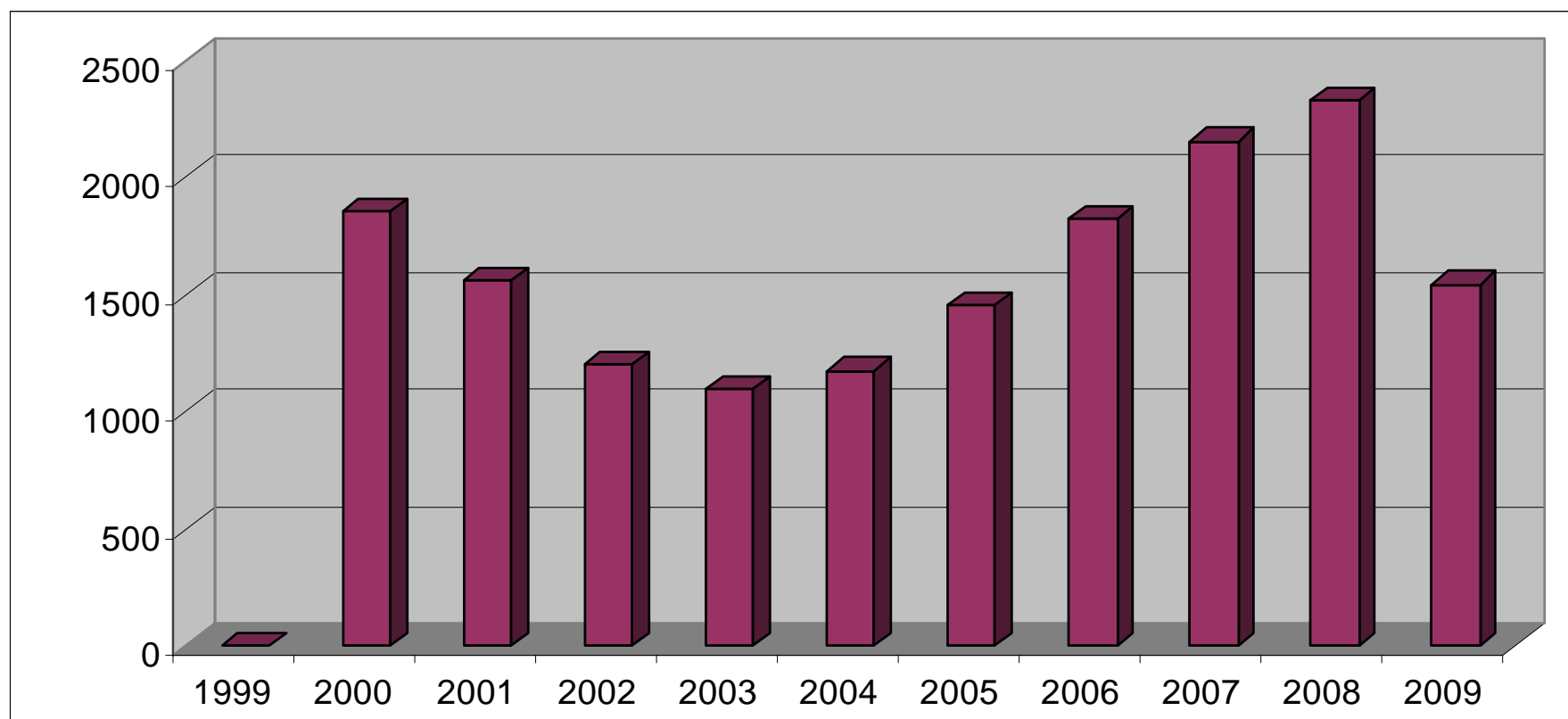
1. The Parties

The complainant is World Wrestling Federation Entertainment, Inc., f/k/a Titan Sports, Inc., a corporation organized under the laws of the State of Delaware, United States of America, having its principal place of business at Stamford, Connecticut, United States of America. The respondent is Michael Bosman, an individual resident in Redlands, California, United States of America.

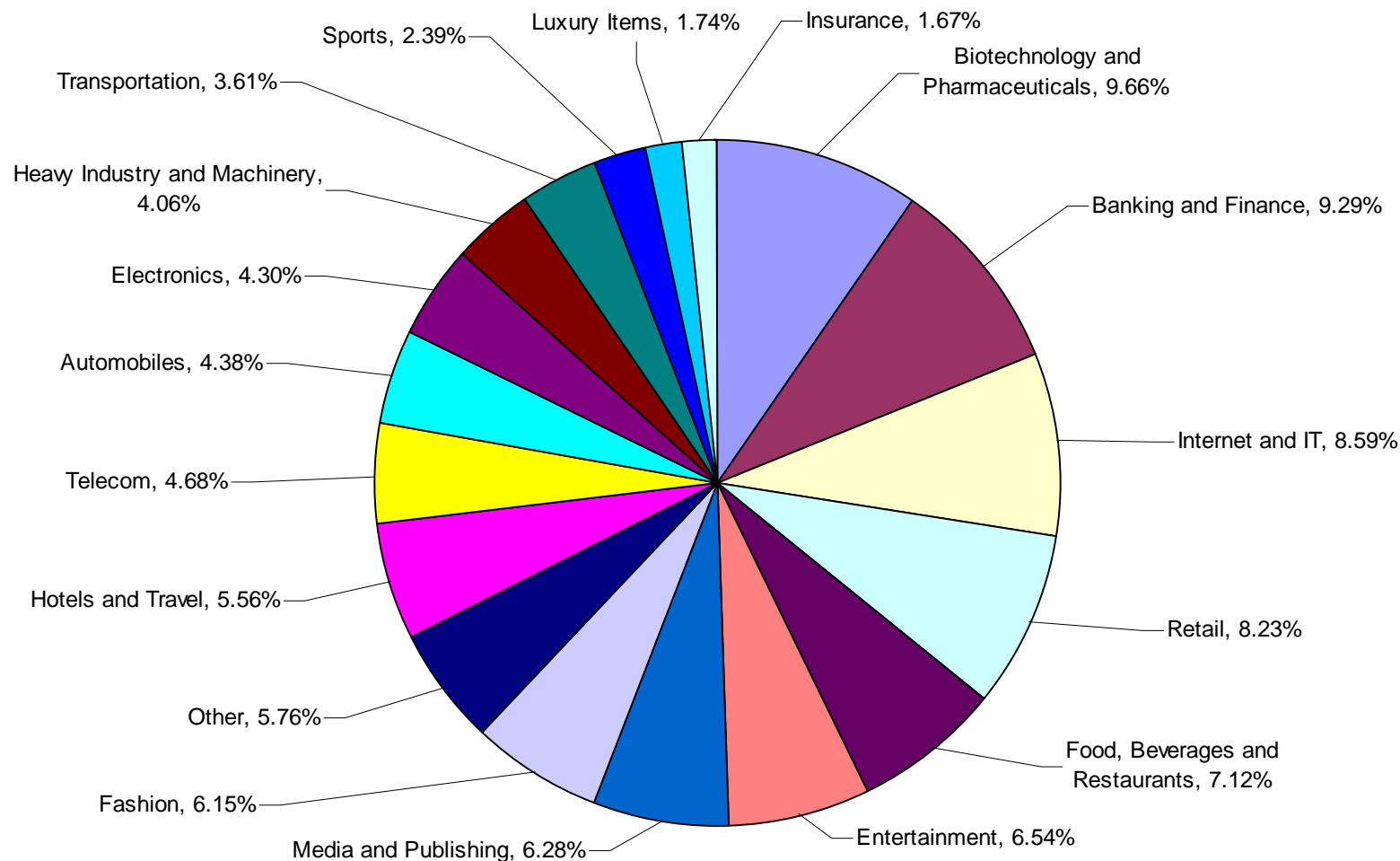
... to the 16,000th
(metsuki.com)



Total Number of WIPO Cases per Year (as at October 7, 2009)



Areas of WIPO Complainant Activity



Top 25 WIPO Complainant Country Filing

Country	Number of Cases	Percentage of Cases
United States of America	6924	42.72%
France	1769	10.91%
United Kingdom	1228	7.58%
Germany	937	5.78%
Switzerland	827	5.10%
Spain	739	4.56%
Italy	523	3.23%
Canada	329	2.03%
Netherlands	323	1.99%
Australia	286	1.76%
Sweden	238	1.47%
Denmark	184	1.14%
Japan	183	1.13%
India	168	1.04%
Brazil	141	0.87%
Austria	127	0.78%
Mexico	116	0.72%
Turkey	113	0.70%
Finland	92	0.57%
Monaco	76	0.47%
Belgium	71	0.44%
China	71	0.44%
Republic of Korea	68	0.42%
Ireland	61	0.38%
Singapore	48	0.30%

Top 25 WIPO Respondent Country Filing

Country	Number of Cases	Percentage of Cases
United States of America	6332	39.07%
United Kingdom	1358	8.38%
China	831	5.13%
Canada	760	4.69%
Spain	732	4.52%
Republic of Korea	623	3.84%
France	525	3.24%
Australia	379	2.34%
Netherlands	280	1.73%
India	257	1.59%
Germany	251	1.55%
Italy	234	1.44%
Russian Federation	233	1.44%
Switzerland	229	1.41%
Panama	185	1.14%
Bahamas	168	1.04%
Turkey	159	0.98%
Mexico	140	0.86%
Saint Kitts and Nevis	123	0.76%
Japan	107	0.66%
Sweden	107	0.66%
Belize	87	0.54%
Ireland	85	0.52%
Kenya	81	0.50%
Israel	80	0.49%

gTLDs in WIPO Cases

gTLDs	Number of Domain Names	Percentage
.com	21059	78.38%
.net	2762	10.28%
.org	1624	6.04%
.info	829	3.09%
.biz	378	1.41%
.mobi	152	0.57%
.name	22	0.08%
.travel	12	0.04%
.pro	11	0.04%
.asia	8	0.03%
.tel	5	0.02%
.cat	4	0.01%
.aero	1	0.00%
.edu	1	0.00%

Domain Name Scripts in WIPO Cases

Character Set	Percentage of Domain Names
ASCII (English)	99.57%
German	0.13%
Chinese	0.07%
French	0.07%
Japanese	0.05%
Korean	0.05%
Spanish	0.04%
Hebrew	0.01%
Danish	0.01%
Norwegian	0.01%
Swedish	0.01%

WIPO Case Languages Used

Case Language	Number of Cases	Percentage of Cases
English	14511	89.53%
Spanish	610	3.76%
French	425	2.62%
Korean	230	1.42%
German	187	1.15%
Dutch	93	0.57%
Chinese	71	0.44%
Italian	28	0.17%
Japanese	19	0.12%
Russian	10	0.06%
Portuguese	6	0.04%
Romanian	6	0.04%
Danish	3	0.02%
Swedish	3	0.02%
Hebrew	1	0.01%
Norwegian	1	0.01%
Turkish	1	0.01%
Total:	16205	

450 WIPO Panelists Appointed since 1999



WORLD INTELLECTUAL PROPERTY ORGANIZATION

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WIPO Domain Name Panelists

Uniform Domain Name Dispute Resolution Policy

The links below point to files in the Adobe Portable Document (PDF) format. Please note that your computer must have a viewing program like [Acrobat Reader](#) from [Adobe](#). The Acrobat Reader is freely available for most computer platforms.

- » [Argentina](#)
- » [Australia](#)
- » [Austria](#)
- » [Belgium](#)
- » [Brazil](#)
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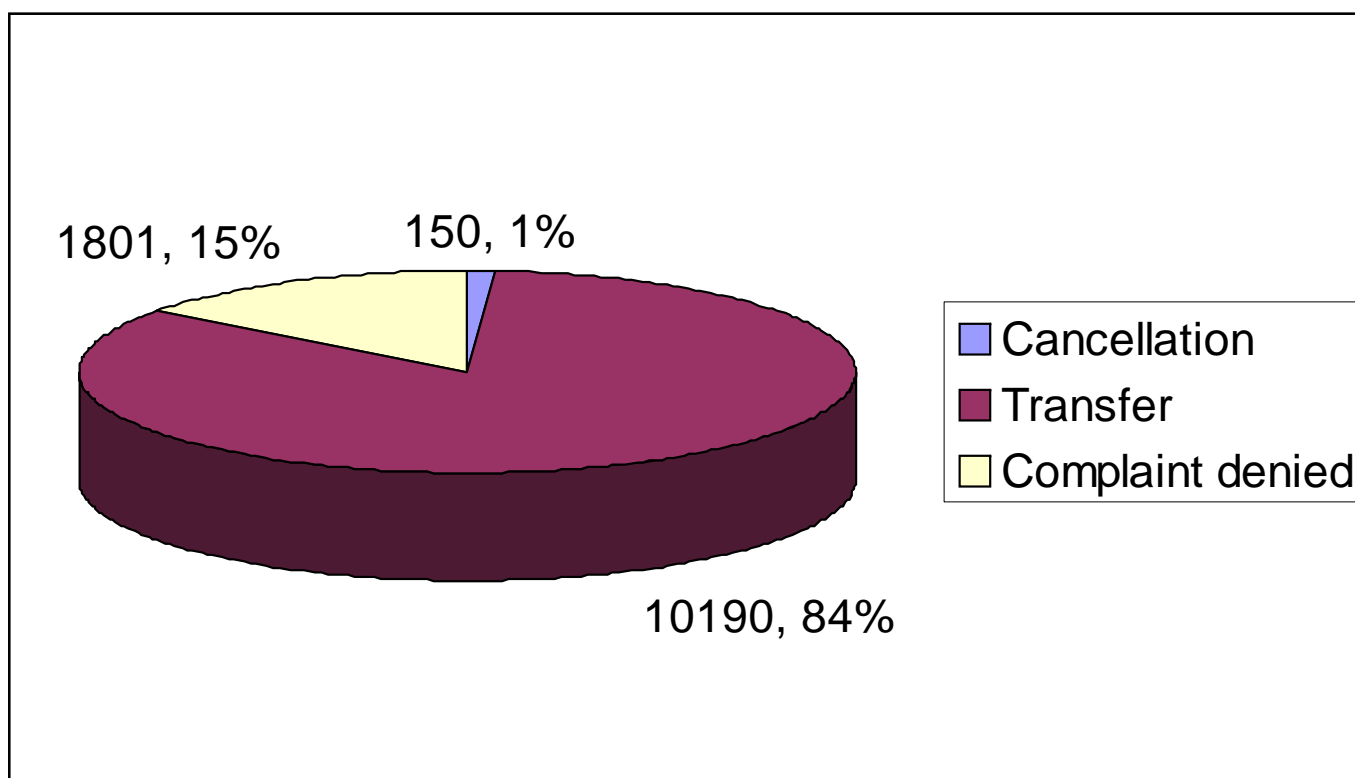
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WIPO Case Outcome



The Challenge for the UDRP

- **Balancing fairness and efficiency**
- **In a rapidly evolving environment**
 - ▶ Technological
 - ▶ Economic
 - ▶ Normative
- **Requiring progressive custodianship in practice, precedent and policy: WIPO and its panelists**

The Road Ahead



Recently Added WIPO Legal Index Categories (1)

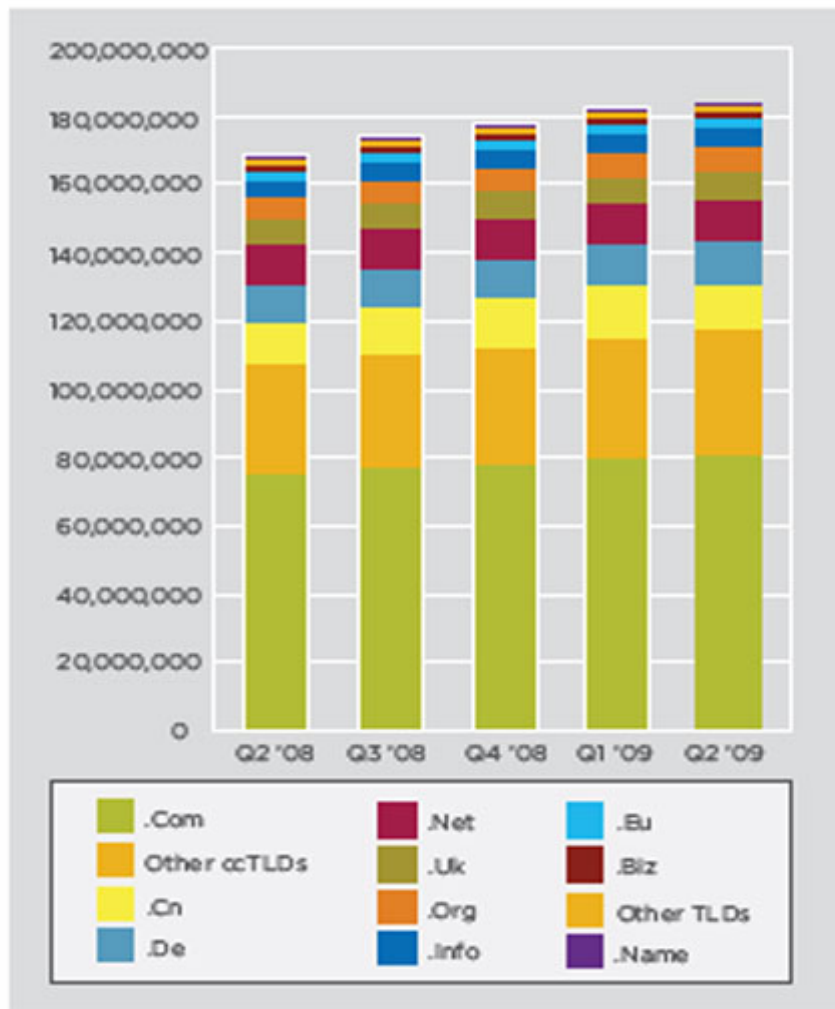
- **Parking/landing pages**
- **Tarnishment**
- **Use of robots.txt**
- **Addition of domain names**
- **On-line archives**
- **Consent to transfer**
- **Registrar Issues**

Recently Added WIPO Legal Index Categories (2)

- **Use of dictionary term**
- **Use of privacy service**
- **Automated registration**
- **Advertising revenue arrangements**
- **Unauthorized acquisition of domain name**
- **Privacy**
- **Delay in bringing Complaint**

Total Domain Name Registrations

Total Domain Name Registrations



Source: Zooknic, July 2009; VeriSign, July 2009

The Challenge for the UDRP

- **Balancing fairness and efficiency**
- **In a rapidly evolving environment**
 - ▶ Technological
 - ▶ Economic
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- **Requiring progressive custodianship in practice, precedent and policy: WIPO and its panelists**

Some WIPO Ideas on Future WIPO UDRP Directions (1)

- **Opportunity for future complainant to complete online form indicating preliminary intent to file case (possibly subject to (partial) advance of filing fee)**
 - ▶ Permits respondent, if so inclined:
 - ▶ To indicate agreement to transfer of domain name (e.g. on certified check-box basis), or
 - ▶ To indicate intent to file a formal response (before or during standard response filing period) (e.g. on a certified check-box basis)
 - ▶ Permits Center effort, where registration is under privacy shield, to obtain and convey underlying registrant information, allowing the latter to be addressed as the respondent in any actual complaint to be filed

Some WIPO Ideas on Future WIPO UDRP Directions (2)

- **In principle unless a serious response filing intent has already been indicated: abbreviated filing of form complaint, with a possible further round of party filing in case of a response (subject to panel discretion)**
 - ▶ 2009 WIPO respondent default rate:
 - ▶ 80% of filed cases
 - ▶ 72% of decided cases
- **eUDRP: no more paper pleadings, only a paper notification document (“Written Notice”)**
- **Summary decisions in default cases, provided *prima facie* obviously qualifying facts; always subject to the UDRP court option**