

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

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Theme 2.4: What Are the Key Elements of Rights Protection Mechanisms You Would Like to See as part of the New gTLD Expansion?

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Post-Delegation Dispute Resolution Procedure

- **WIPO proposal published to ICANN March 13, 2009**
 - ▶ (i) the registry operator's manner of operation or use of a TLD, which is identical or similar to the complainant's mark, causes or materially contributes to such TLD (a) taking unfair advantage of the distinctive character or the reputation of the complainant's mark, or (b) unjustifiably impairing the distinctive character or the reputation of the complainant's mark, or (c) creating an impermissible likelihood of confusion with the complainant's mark; or (ii) the registry operator's manner of operation or use of the TLD causes or materially contributes to domain name registrations therein, which are identical or similar to the complainant's mark, meeting any of the conditions (a), (b), or (c) above.

Post-Delegation Dispute Resolution Procedure

- **WIPO proposal (cont'd)**
- **Consideration Factors:**
 - ▶ (i) Whether the registry operator intentionally induced, knowingly permitted, or could not have reasonably been unaware of domain name registrations in the TLD that meet any of the conditions (a), (b), or (c) described in Paragraph A;
 - ▶ (ii) Whether the registry operator specified and effectively implemented processes and procedures for launch of the TLD and initial registration-related and ongoing protection of third parties' mark rights (Rights Protection Mechanisms) to reasonably avoid the conduct described in Paragraph A;
 - ▶ (iii) Whether the registry operator's manner of operation or use of the TLD is consistent with the representations made in the TLD application as approved by ICANN or the terms of the New gTLD Agreement.

Post-Delegation Dispute Resolution Procedure

- **DAG, version 3, published October 4, 2009; public comment period open to November 22, 2009.**
- **Top-Level:**
 - ▶ by clear and convincing evidence that the registry operator's affirmative conduct in its operation or use of its gTLD, that is identical or confusingly similar to the complainant's mark, causes or materially contributes to the gTLD: (a) taking unfair advantage of the distinctive character or the reputation of the complainant's mark, or (b) unjustifiably impairing the distinctive character or the reputation of the complainant's mark, or (c) creating an impermissible likelihood of confusion with the complainant's mark.

Post-Delegation Dispute Resolution Procedure

- **DAG, version 3 (cont'd)**
- **Second-Level:**
 - ▶ by clear and convincing evidence: (a) that there is substantial ongoing pattern or practice of specific bad faith intent by the registry operator to profit from the sale of trademark infringing domain names; **and** (b) of the registry operator's bad faith intent to profit from the systematic registration of domain names within the gTLD, that are identical or confusingly similar to the complainant's mark, which: (i) takes unfair advantage of the distinctive character or the reputation of the complainant's mark, or (ii) unjustifiably impairs the distinctive character or the reputation of the complainant's mark, or (iii) creates an impermissible likelihood of confusion with the complainant's mark. In this regard, it would not be nearly enough to show that the registry operator was on notice of [the possibility] of trademark infringement through registrations in the gTLD.

Post-Delegation Dispute Resolution Procedure

- **The IRT Final Report adapted the earlier WIPO proposal:**
 - ▶ 2.1.1.1 The Registry Operator's manner of operation or use of a TLD is inconsistent with the representations made in the TLD application as approved by ICANN and incorporated into the applicable Registry Agreement and such operation or use of the TLD is likely to cause confusion with the complainant's mark; **or**
 - ▶ 2.1.1.2 The Registry Operator is in breach of the specific rights protection mechanisms enumerated in [the] Registry Operator's Agreement and such breach is likely to cause confusion with complainant's mark; **or**

Post-Delegation Dispute Resolution Procedure

- **IRT Final Report (cont'd)**

- ▶ 2.1.1.3 The Registry Operator manner of operation or use of the TLD exhibits a bad faith intent to profit from the systemic registration of domain name registrations therein, which are identical or confusingly similar to the complainant's mark, meeting any of the following conditions: (a) taking unfair advantage of the distinctive character or the reputation of the complainant's mark, or (b) unjustifiably impairing the distinctive character or the reputation of the complainant's mark, or (c) creating an impermissible likelihood of confusion with the complainant's mark.