

## **The Uniform Domain Name Dispute Resolution Policy and WIPO**

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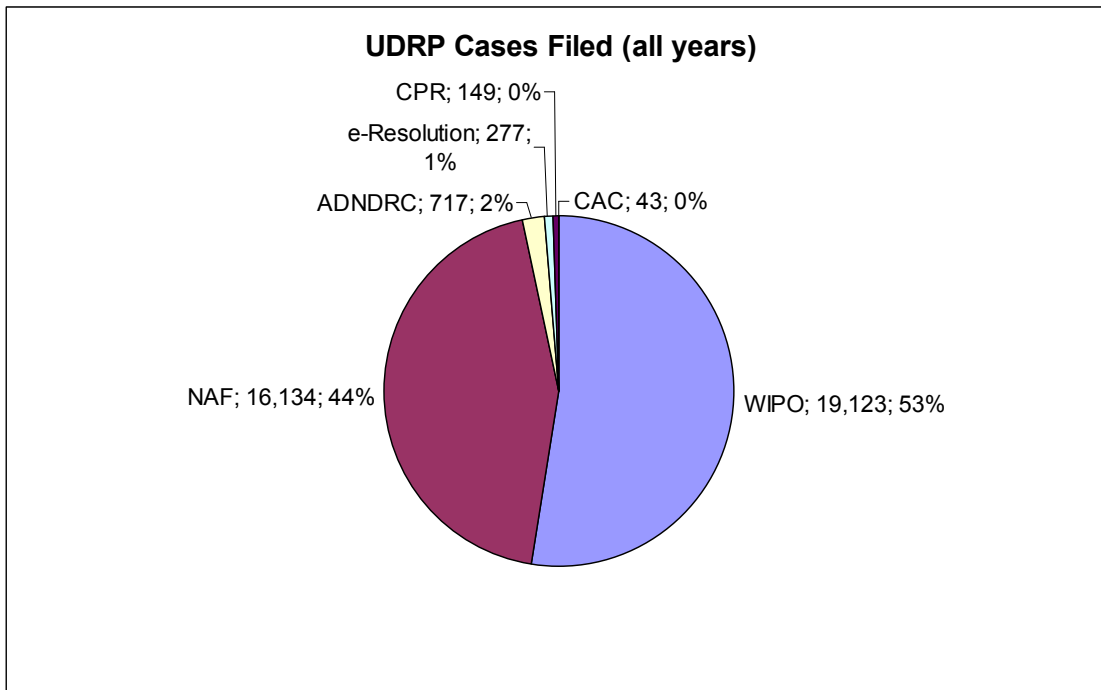
## 1. PREFACE

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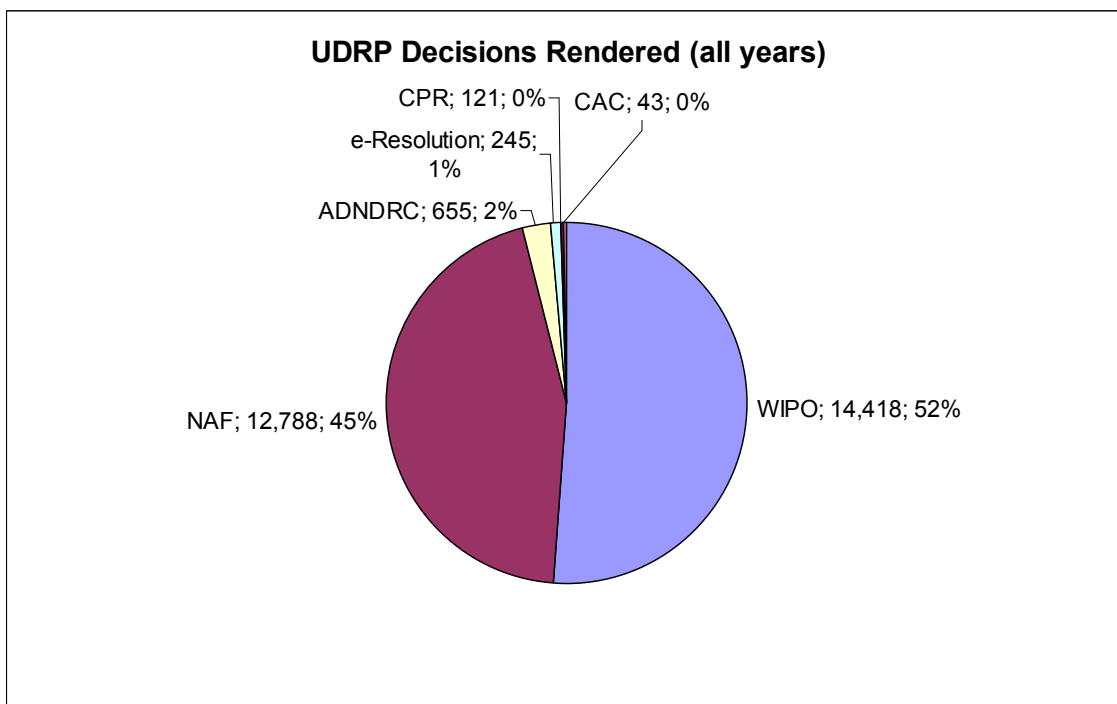
This paper was prepared by the WIPO Arbitration and Mediation Center in August 2011 to provide an overview of the Uniform Domain Name Dispute Resolution Policy and WIPO's role in relation thereto, for the purpose of informing discussion at the September 2011 INTA Conference on Trademarks and the Internet on the issue of whether it would be wise to review and make changes to the UDRP, at least at this time. This paper thus takes its place among numerous other public, non-profit WIPO contributions to the operation and on-going maintenance of the UDRP, including the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition ("WIPO Overview 2.0") (available at [www.wipo.int/amc/en/domains/search/overview2.0/index.html](http://www.wipo.int/amc/en/domains/search/overview2.0/index.html)), the WIPO Legal Index of WIPO UDRP Decisions (available at [www.wipo.int/cgi-bin/domains/search/legalindex](http://www.wipo.int/cgi-bin/domains/search/legalindex)), and extensive WIPO engagement with ICANN on UDRP-related matters (selected correspondence available at <http://www.wipo.int/amc/en/domains/resources/icann/index.html>).

**2. WHAT IS THE UDRP?**

The Uniform Domain Name Dispute Resolution Process was adopted by ICANN in 1999 on the basis of recommendations made by WIPO in the First WIPO Internet Domain Name Process. The UDRP is limited to clear cases of bad-faith, abusive registration and use of domain names and has proven highly popular among trademark owners. To date, some 35,000 UDRP cases have been processed. Looked at holistically, the results speak for themselves in terms of overall numbers of cybersquatting disputes kept out of the courts.



**Table 1: Total UDRP Cases Filed (as at August 8, 2011): 36,443**



**Table 2: UDRP Decisions Rendered (as at August 8, 2011): 28,270**

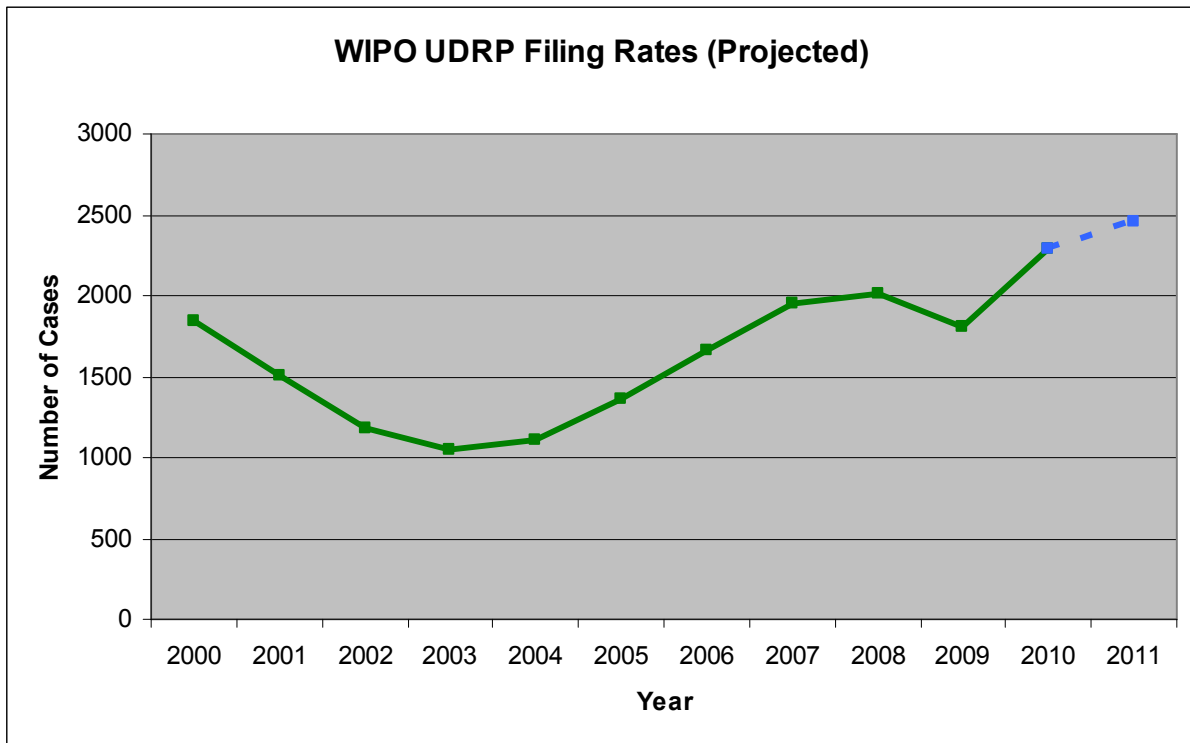
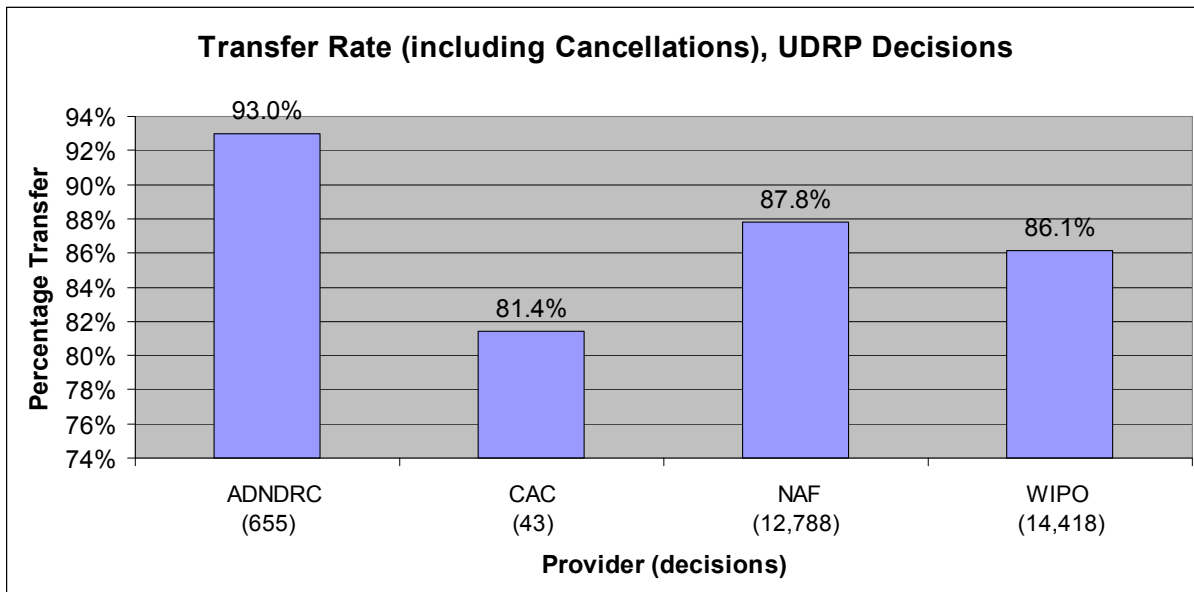
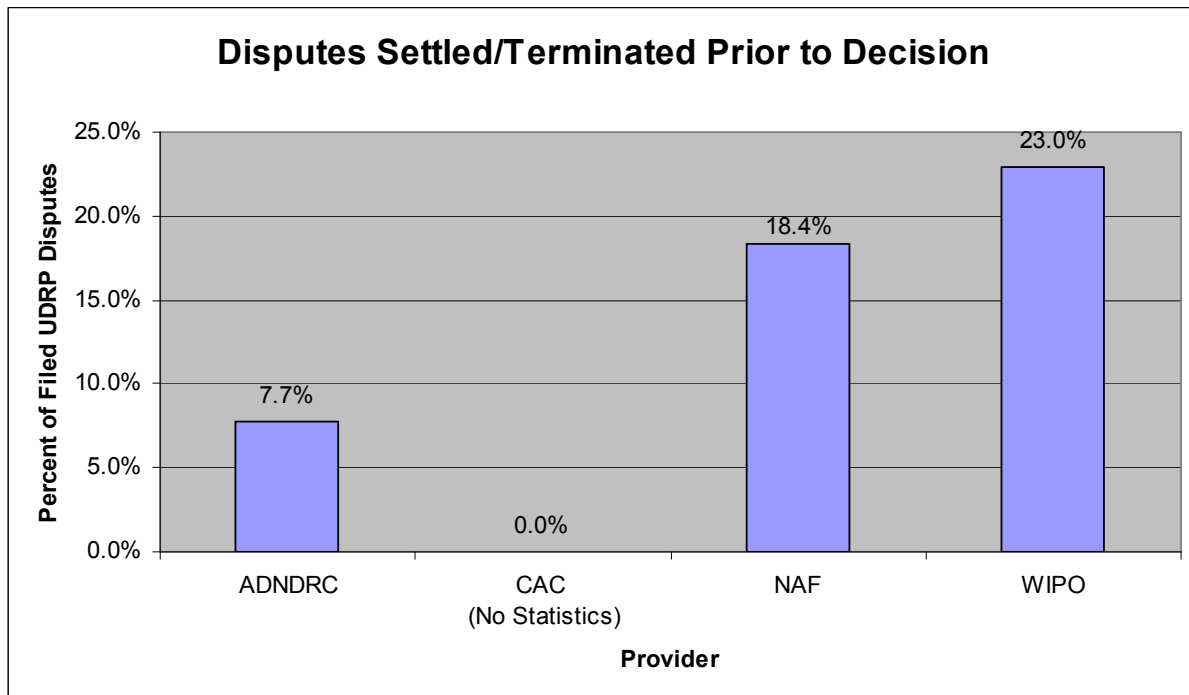


Table 3: WIPO UDRP Case Filing Trends (by Year)



\*\* Inactive Providers (no longer offering services): CPR (121) 64.5%; eResolution (245) 60.8%

Table 4: Percentage of UDRP decisions in which Panels have found cybersquatting, resulting in an order of Transfer (or Cancellation)



\*\*Inactive Providers: eResolution 11.6%/CPR 18.8%

**Table 5: UDRP Settlement/Termination Rate (as at August 8, 2011)**

Being administrative (and not arbitral), the UDRP procedure is optional for trademark owners, but mandatory for (gTLD) domain name registrants. The UDRP does not prevent either party from submitting a dispute to a national court of competent jurisdiction; but very few cases that have been decided under the UDRP have been brought before national courts.

(See e.g. WIPO Selected UDRP-related Court Cases at [www.wipo.int/amc/en/domains/challenged/](http://www.wipo.int/amc/en/domains/challenged/).)

### 3. APPLICABILITY OF THE UDRP

The UDRP applies to registrations in generic top-level domains (gTLDs), such as .com, .net and .org, and will apply to any new gTLDs introduced. (Additionally, many country-code top-level domains (ccTLDs) have adopted the UDRP or a variation thereof, some 65 of which are administered by WIPO.)

(See e.g. WIPO Domain Name Dispute Resolution Service of ccTLDs at [www.wipo.int/amc/en/domains/cctld/index.html](http://www.wipo.int/amc/en/domains/cctld/index.html).)

### 4. RIGHTS ACTIONABLE UNDER THE UDRP

The UDRP requires a complainant to have rights in a trade or service mark. UDRP Panels have long interpreted this to include unregistered rights. Personal names, descriptive terms and geographical identifiers (though not actionable as such) may be actionable to the extent that they have acquired secondary meaning (through appropriately evidenced use) as a mark.

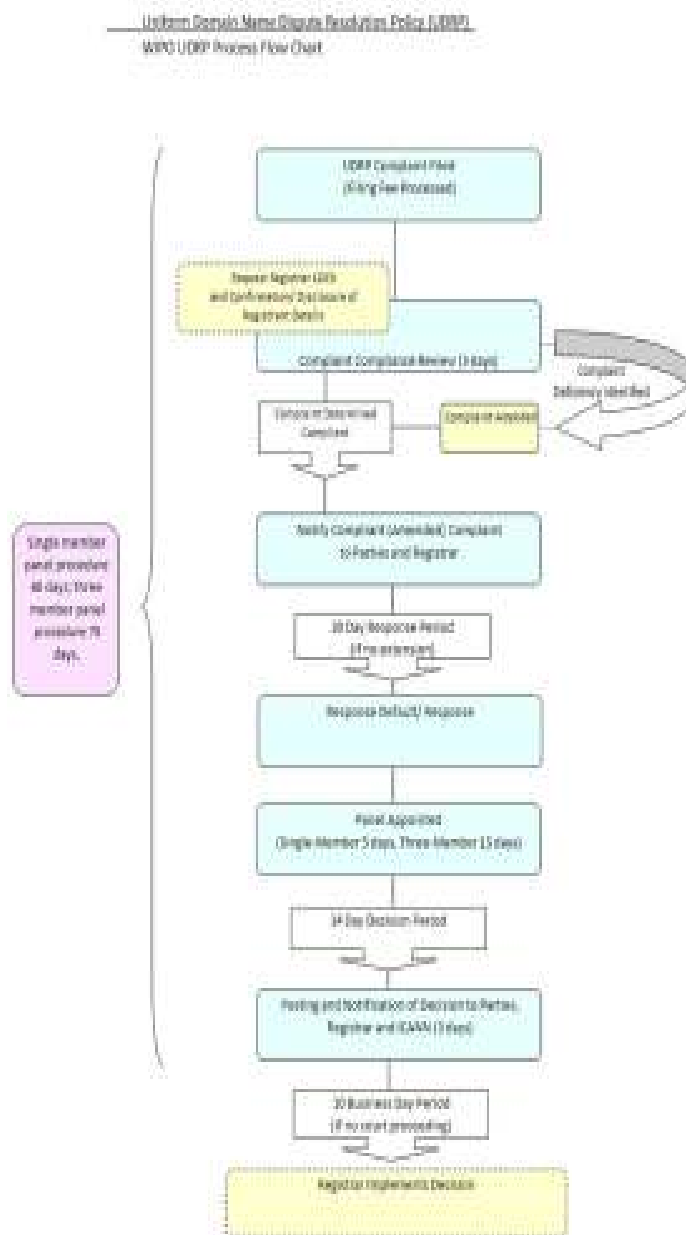
In most circumstances, a licensee of a trademark (or a related company such as a subsidiary or parent to the registered holder of a trademark) would be considered to have rights in a trademark under the UDRP.

(See e.g. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition (“WIPO Overview 2.0”) [www.wipo.int/amc/en/domains/search/overview2.0/index.html](http://www.wipo.int/amc/en/domains/search/overview2.0/index.html), paragraphs 1.4 to 1.8.)

### 5. HOW IT WORKS

Under the UDRP, the rights-holding complainant submits its electronic complaint to the provider, which has five days to conclude an administrative compliance review of the complaint. Typically, this will include registrar verification of relevant registrant name and contact information, along with a request for confirmation that the disputed domain name has been locked pending resolution of the dispute. In the event that any administrative deficiencies are identified in the complaint, the Complainant has five days within which to correct these. On successful conclusion of the administrative compliance check, the provider proceeds to formally commence the proceedings by forwarding a copy of the Complaint (including any Annexes) to the Respondent by email. The provider also sends written notice of the dispute to the Respondent to any available postal address and/or fax number.

The respondent has 20 days to file a response from the date the Provider notifies the respondent of a filed complaint. The Provider then appoints an independent single- or three-member panel to decide the case. (Either party may elect a three-member panel.)



**Table 6: WIPO UDRP Flow Chart**

A reasoned decision is taken within two weeks by the panel. If the panel orders the transfer or cancellation of the domain name (these are the sole remedies available, with monetary damages, in particular, being excluded), the registrar is obliged to implement the decision,

except if the losing domain name registrant files a case concerning the disputed domain name in a competent court against the complainant within ten business days of notification of the panel decision. The UDRP Provider posts notice of the filing of a case and the full text of decisions on its website.

(All WIPO UDRP decisions are searchable through the online index of WIPO UDRP Decisions, which allows structured access to the large quantity of legal and other data contained in those decisions. The WIPO Center also provides a unique jurisprudential overview which draws on the some 20,000 cases administered by WIPO to reflect a balanced statement of some 50 substantive and procedural UDRP issues. The WIPO legal index and jurisprudential overview, which help parties and panels from around the world, are one of a number of freely available UDRP resources on the WIPO Center website, at [www.wipo.int/amc/en/domains/](http://www.wipo.int/amc/en/domains/).)

## **6. UDRP SUBSTANTIVE ELEMENTS**

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For a UDRP complaint to succeed, the complainant must establish that the following three cumulative criteria are met:

- (i) the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
- (ii) the registrant of the domain name has no rights or legitimate interests in respect of the domain name; and
- (iii) the domain name has been registered and is being used in bad faith.

### **6.1. Identity or Confusing Similarity under the UDRP**

The first element of the UDRP has been found by Panels to serve essentially as a low-threshold, standing requirement; although the UDRP requires trade or service mark rights, it does not impose a high-bar, trademark confusion test as such.

Panels have generally found the threshold test for confusing similarity under the UDRP to involve a direct comparison between the trademark and the alphanumeric string of the domain name at issue to assess likelihood of Internet-user confusion. The test is usually applied without regard to website content, or to the relevant gTLD (though new gTLDs may impact on this). The degree of distinctiveness of the mark at issue may be a factor, however, along with the extent to which the domain name at issue may contain alpha-numeric elements additional to those of the mark.

In order to satisfy the UDRP test, the relevant trademark would generally need to be recognizable, as such, within the domain name, with the addition of common, dictionary, descriptive or negative terms typically regarded by Panels as insufficient to prevent threshold Internet-user confusion.

A domain name consisting of a trademark and a negative or pejorative term (such as [trademark]sucks.com) would generally be considered confusingly similar to the complainant's trademark for the purpose of satisfying the standing requirement under the first element of the UDRP (with the merits of such cases typically decided under subsequent elements).

(See e.g. [WIPO Overview 2.0](#), paragraphs 1.2 and 1.3).

Examples of UDRP “sucks” cases in which WIPO panels have found confusingly similarity for first element UDRP purposes have included: D2000-0662 <**wal-martsucks.com**>; D2006-1627 <**dellorussosucks.com**>; D2007-0143 <**airfrancesuck.com**>; D2008-0006 <**bakersdelightlies.com**>; D2008-0253 <**redbullsucks.com**>; D2008-0430 <**metrolinksucks.com**>; D2008-0647 <**sermosucks.com**>; D2008-1325 <**alamo-sucks.com**>; D2009-0020 <**airaustralsucks.com**>.

## 6.2. UDRP Safe Harbors – Rights and Legitimate Interests

The UDRP lists several (non-exclusive) examples of registrant rights or legitimate interests, including using the domain name in connection with a *bona fide* offering of goods or services, the registrant being commonly known by the disputed domain name, and legitimate non-commercial or fair use.

While the overall burden of proof under the UDRP falls on the Complainant, UDRP panels have recognized the difficulties inherent in proving a negative with respect to registrant rights or legitimate interests. Hence, where a Complainant makes an initial *prima facie* case that the Respondent lacks rights or legitimate interests in a disputed domain name, the burden of production on this element generally passes to the Respondent.

(See e.g. [WIPO Overview 2.0](#), paragraph 2.1.)

Panels have recognized that mere registration of a domain name – even one that is comprised of a confirmed dictionary word or phrase (which may be generic with respect to certain goods or services) – may not in and of itself confer rights or legitimate interests in the domain name. Normally, in order to find rights or legitimate interests in a domain name based on the generic or dictionary meaning of a word or phrase contained therein, the domain name would need to be genuinely used or at least demonstrably intended for such use in connection with the relied-upon meaning (and not, for example, to trade off third-party rights in such word or phrase). (e.g. a respondent may well have a right to a domain name “apple” if it uses it for a genuine site for apples, but not if the site is aimed at selling computers or MP3 players, for example, or an inappropriate other purpose).

(See e.g. [WIPO Overview 2.0](#), paragraph 2.2.)

## 6.3. UDRP Registration and Use in Bad Faith

The requirement under the UDRP for registration *and* use in bad faith has, for the most part, been interpreted by Panels as imposing a cumulative (or conjunctive) requirement.

The UDRP lists several inclusive examples of bad faith, for example, indications that the domain name has been registered for the purpose of selling it to the complaining trademark owner or their competitor, or used for attracting visitors to the registrant’s site for commercial gain by creating a likelihood of confusion with complainant’s trademark.

“Registration” of a domain name has generally been interpreted by Panels to include “acquisition” (e.g. in the case of bulk sale of domain name portfolios, assessment of the purchasing party’s *bona fides* would typically be at the time of that party’s (new or most recent) acquisition of the relevant domain name registrations), and in a very small number of cases, has been extended to include domain name “renewal”.

(See e.g. [WIPO Overview 2.0](#), paragraph 3.7.)

“Use” of a domain name has generally been interpreted by Panels to encompass passive holding of a domain name in certain circumstances (which can include mere sporadic use or parking by a third party), and registrants will normally be deemed responsible for third party



or "automatically" generated material (e.g. pay-per-click advertising found to be targeting complainant trademark value) appearing on a website at a disputed domain name, unless registrants can show some good faith attempt to have such material removed.

(See e.g. [WIPO Overview 2.0](#), paragraphs 3.2. and 3.8.)

While recognizing that use of a privacy or proxy registration service may not, in and of itself, be an indication of bad faith, Panels have found that the manner in which such services are used can, in certain circumstances, constitute a factor indicating bad faith (e.g. when used in combination with otherwise incomplete contact information, or a continued concealment of the "true" or "underlying" registrant, possibly including that registrant's actual date of acquisition, upon the institution of a UDRP proceeding).

(See e.g. [WIPO Overview 2.0](#), paragraph 3.9.)

## **7. UDRP PROCEDURAL ELEMENTS**

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### 7.1. Precedent?

The UDRP does not operate on a strict doctrine of precedent. However, panels consider it desirable that their decisions are consistent with prior panel decisions dealing with similar fact situations. This ensures that the UDRP system operates in a fair, effective and predictable manner for all parties, while responding to the continuing evolution of the domain name system.

(See e.g. [WIPO Overview 2.0](#), paragraph 4.1.)

### 7.2. Supplemental Filing

As the UDRP Rules grant the Panel sole discretion to request further statements and determine the admissibility of evidence which may include an unsolicited filing, such filings, when received from a party, would (at WIPO) typically be put before the panel upon the panel's appointment for determination as to admissibility, and assessment of need for any further procedural steps.

The party submitting its filing would normally need to show its relevance to the case and why it was unable to provide that information in the complaint or response. Most panels that have allowed unsolicited filings have tended to require some showing of "exceptional" circumstances.

Panels which accept a supplemental filing from one side typically allow the other party the opportunity to file a reply to such supplemental filing. In either scenario, or on its own initiative, a panel may request further evidence, information or statements from one or other of the parties by way of administrative panel order.

(Whether or not ultimately accepted by a Panel, there is no extra processing charge for Supplemental Filings at WIPO.)

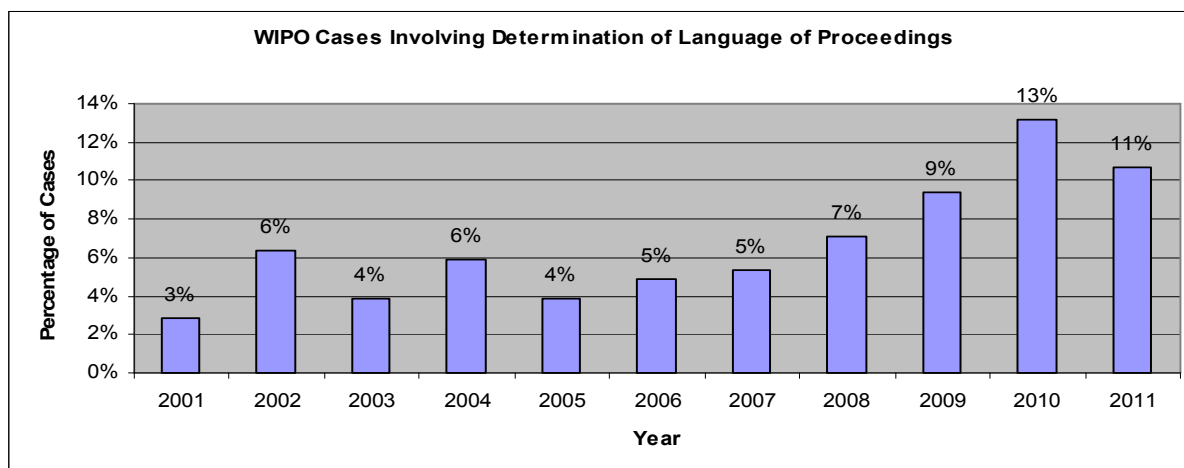
(See e.g. [WIPO Overview 2.0](#), paragraph 4.2).

### 7.3. Language of Proceeding

The language of the proceeding is the language of the registration agreement, unless both parties agree otherwise, or the panel determines otherwise under paragraph 11 of the UDRP Rules.

Recognizing the practical need which may arise for a preliminary determination of the language of proceeding prior to their appointment, WIPO panels have found that, in certain situations, where the respondent can apparently understand the language of the complaint (or having been given a fair chance to object has not done so), and the complainant would be unfairly disadvantaged by being forced to translate its pleadings, a provider may accept the language of the complaint, even if it is different from the language of the registration agreement. Such acceptance is subject to the panel's authority to determine the appropriate language of the proceeding on appointment. Likewise, in appropriate circumstances, a response in a language different from that of the complainant may be accepted.

(See e.g. [WIPO Overview 2.0](#), paragraph 4.3, including for a description of the language request and party comment process offered at WIPO, and for which WIPO does not charge extra.)



**Table 7: WIPO UDRP cases (est %) requiring language of proceedings determination by year**

### 7.4. Appeals and Refilings

The UDRP does not include an appeals process as such – parties who wish to do so may pursue a matter *de novo* in court. The UDRP was originally designed as a simple, expedient and cost effective alternative to court options for clear cases of cybersquatting operating across multiple legal jurisdictions. Any appeals option introduced as a matter of right within such framework would inevitably add time, complexity and uncertainty to the process. (By way of example, the UDRP operates over a maximum time frame of some 75 days for a three-member panel, whereas under the Uniform Rapid Suspension System (as shaped by ICANN), which includes provision for multiple experts and panels, defaulting respondent extensions of up to a year, and an appeals mechanism, it may take over one year to resolve a single dispute under the Uniform Rapid Suspension System (URS), even before subsequent UDRP and/or national court options may be considered.)

UDRP Panels have recognized a limited basis within the UDRP on which an unsuccessful UDRP complainant of first instance may qualify to bring a refiled UDRP case.

A refiled case concerns the complainant submitting a second complaint involving the same domain name(s) and the same respondent(s) as in an earlier complaint that had been

denied. A refiled case may only be accepted in limited circumstances. These circumstances include when the complainant establishes in the complaint that relevant new actions have occurred since the original decision, or that a breach of natural justice or of due process has occurred, or that there was other serious misconduct in the original case (such as perjured evidence). A refiled complaint would usually also be accepted if it includes newly presented evidence that was reasonably unavailable to the complainant during the original case.

A refiling complainant must clearly indicate the grounds allegedly justifying the refiling of the complaint, and a refiling complainant's failure to clearly identify that its complaint is a refiling of an earlier UDRP complaint may constitute a material omission for the purpose of any panel assessment of reverse domain name hijacking.

(See e.g. [WIPO Overview 2.0](#), paragraph 4.4.)

### 7.5. Standard of Proof

The general standard of proof under the UDRP is "on balance" – often expressed as the "balance of probabilities" or "preponderance of the evidence" standard. Under this standard, an asserting party would typically need to establish that it is more likely than not that the claimed fact is true. (This may be contrasted with, for example, the more onerous standard of ("clear and convincing") proof required to obtain the lesser remedy of suspension under the procedurally more complex URS.)

(See e.g. [WIPO Overview 2.0](#), paragraph 4.7.)

A respondent is not obliged to participate in a UDRP proceeding, and a default does not result in an automatic determination in complainant's favor, but if a respondent fails to reply, asserted facts may be taken as true, and reasonable inferences drawn from information provided by the complainant.

### 7.6. Privacy and Proxy Services

WIPO UDRP panels have recognized on the issue more generally, pending any uniform instructions from ICANN on the issue, that where a disclosure of an "underlying registrant" occurs, the following is appropriate:

(i) the WIPO Center makes the (typically registrar-disclosed) "underlying registrant" information available to the complainant, and provides the complainant with an opportunity to amend the complaint to reflect that information should the complainant so choose;

(ii) should a complainant choose not to amend its complaint in such circumstances, this would not normally amount to a complaint deficiency for the purpose of administrative compliance under the UDRP Rules;

(iii) in practical terms, a complainant's choices include either to *add* a disclosed underlying registrant as a co-respondent to the complaint, or to *replace* the originally named privacy or proxy service with the disclosed "underlying registrant", and may choose to amend or supplement its substantive pleadings in light of any such disclosure;

(iv) in light of the definition of mutual jurisdiction in the UDRP Rules, a complainant may rely for such purposes on the location of the registered domain name holder as it appeared in the "Whois" when the complaint was filed (even if that may be the location of the initially-listed proxy or privacy service);

(v) preserving panel discretion to determine the identity of the proper respondent in any case in which there may be ambiguity, forwarding a copy of the complaint on commencement and notification by the provider to any disclosed underlying registrant, as well as to the originally-named privacy or proxy service, and placing before the panel any timely reply received from either of these.

(WIPO does not charge extra for processing such cases, or any cases involving multiple party identity or aliases.)

(See e.g. [WIPO Overview 2.0](#), paragraph 4.9.)

### 7.7. Settlement

WIPO panels have recognized that UDRP proceedings may be suspended at the request of the parties to enable settlement of their dispute prior to panel appointment. Where a signed suspension request for such purpose identifying the period of time sought (typically not more than 30 days) is submitted to the WIPO Center by the complainant (and not objected to by the copied respondent) or by both parties, a notification would normally be issued to the parties and registrar advising the period of the suspension, and that the domain name should be unlocked only for the purpose of any transfer of the domain name from the registrant to the complainant under the terms of any agreed settlement between the parties.

In the latter scenario, in order to encourage settlement where appropriate, WIPO will fully refund the fee advanced for the not-yet-appointed panel. (See Table 5 concerning UDRP Settlement/Termination Rate (as at August 8, 2011).)

(WIPO does not charge extra for considering or giving effect to such requested suspensions.)

(See e.g. [WIPO Overview 2.0](#), paragraph 4.12.)

Where agreed, parties may wish to use such suspension periods to avail themselves of mediation options to facilitate settlement.

A request from the parties to suspend proceedings to explore possible settlement options only after panel appointment would be at the discretion of the panel. Whether or not the proceedings have been suspended, where a settlement is found to have occurred prior to the rendering of the panel's decision, the panel would normally order the proceedings terminated in accordance with paragraph 17 of the UDRP Rules.

(The overall settlement/termination rate at WIPO in domain name disputes (gTLD+ccTLD) prior to panel appointment stands at 23.30% (amounting to 4,798 of 20,595 domain name cases filed with WIPO overall).

### 7.8. Consolidation

WIPO panels have articulated principles governing the question of whether a UDRP complaint filed by multiple complainants may be brought against (one or more) respondents.

These criteria encompass situations in which (i) the complainants either have a specific common grievance against the respondent, or the respondent has engaged in common conduct that has affected the complainants' individual rights in a similar fashion; (ii) it would be equitable and procedurally efficient to permit the consolidation; or in the case of complaints brought (whether or not filed by multiple complainants) against more than one

respondent, where (i) the domain names or the websites to which they resolve are subject to common control, and (ii) the consolidation would be fair and equitable to all parties.

In order for the filing of a single complaint brought by multiple complainants or against multiple respondents which meets the above criteria to be accepted, such complaint would typically need to be accompanied by a request for consolidation which establishes that the relevant criteria have been met. The onus of establishing this falls on the filing party/parties.

(See e.g. [WIPO Overview 2.0](#), paragraph 4.16.)

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## **8. UDRP PANEL TYPE**

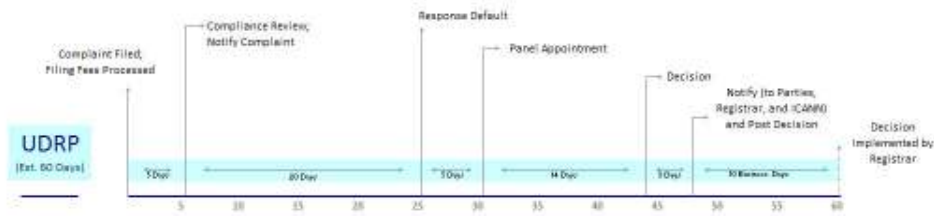
The UDRP includes provision for single-member and three-member panel types, depending on the election of the parties. In the event that a single member panel is selected by the complainant, and the respondent does not opt for a three-member panel, the cost of the panel is born by the Complainant, and the provider will appoint a single member panel from its published list of panelists.

Either party may opt for a three-member panel. In the event that the complainant opts for a three-member panel, the cost is born by the complainant as the initiating party of the dispute. In the event that the respondent opts for a three-member panel, the cost of that three-member panel is shared equally between the parties.

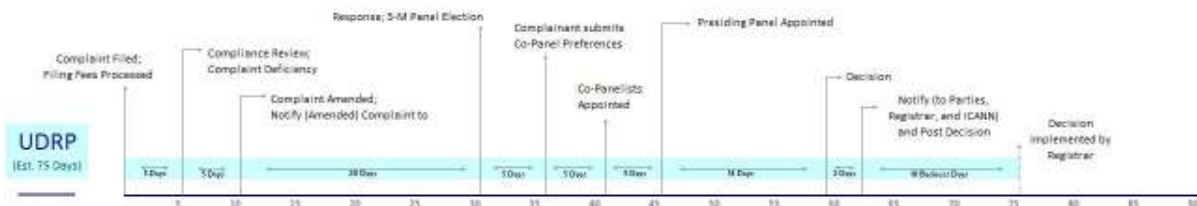
Under the UDRP Rules for appointment of three-member panels, each party may nominate three preferred co-panelists, which the provider will endeavor to appoint. The provider then supplies a list of five names for presiding panelist, which the parties then rank, and the provider then appoints the presiding panelist from that list in a manner which reasonably balances submitted party rankings.

The UDRP procedure for a single-member Panel typically runs over a 60 day period, with the procedure for a three-member Panel running over a 75 day period.

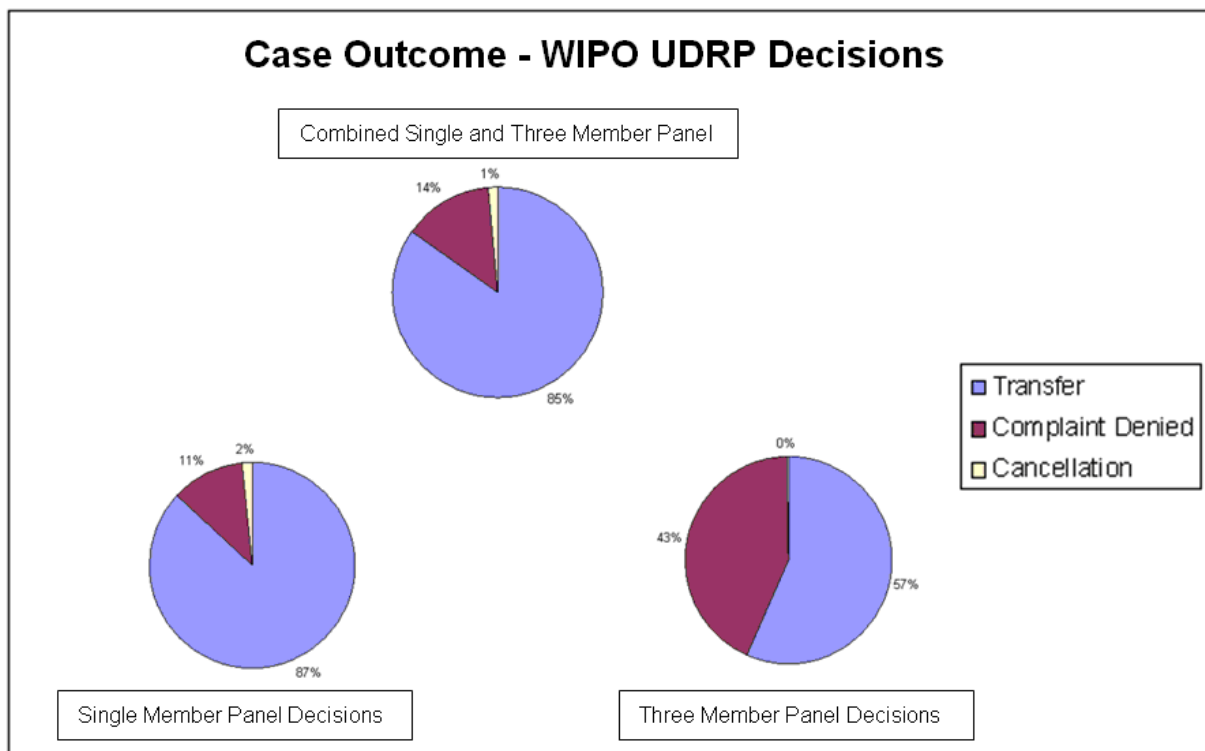
**UDRP Domain Name Dispute Timeline: Single Member Panel**



**UDRP Domain Name Dispute Timeline: Three Member Panel**



**Table 8: UDRP Time Charts for Single and Three-Member Panels**



**Table 9: Case Outcome – WIPO UDRP Decisions - Combined Single and Three Member Panel (All Years)**

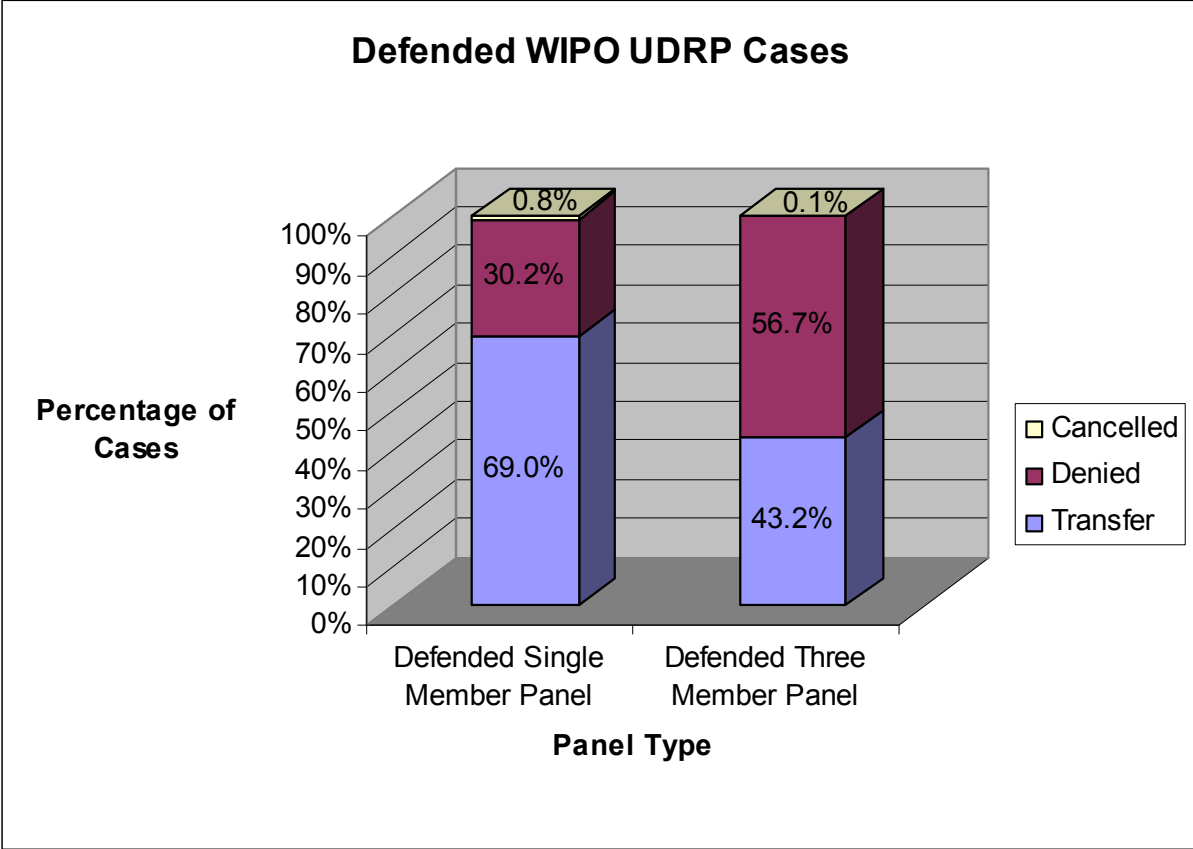
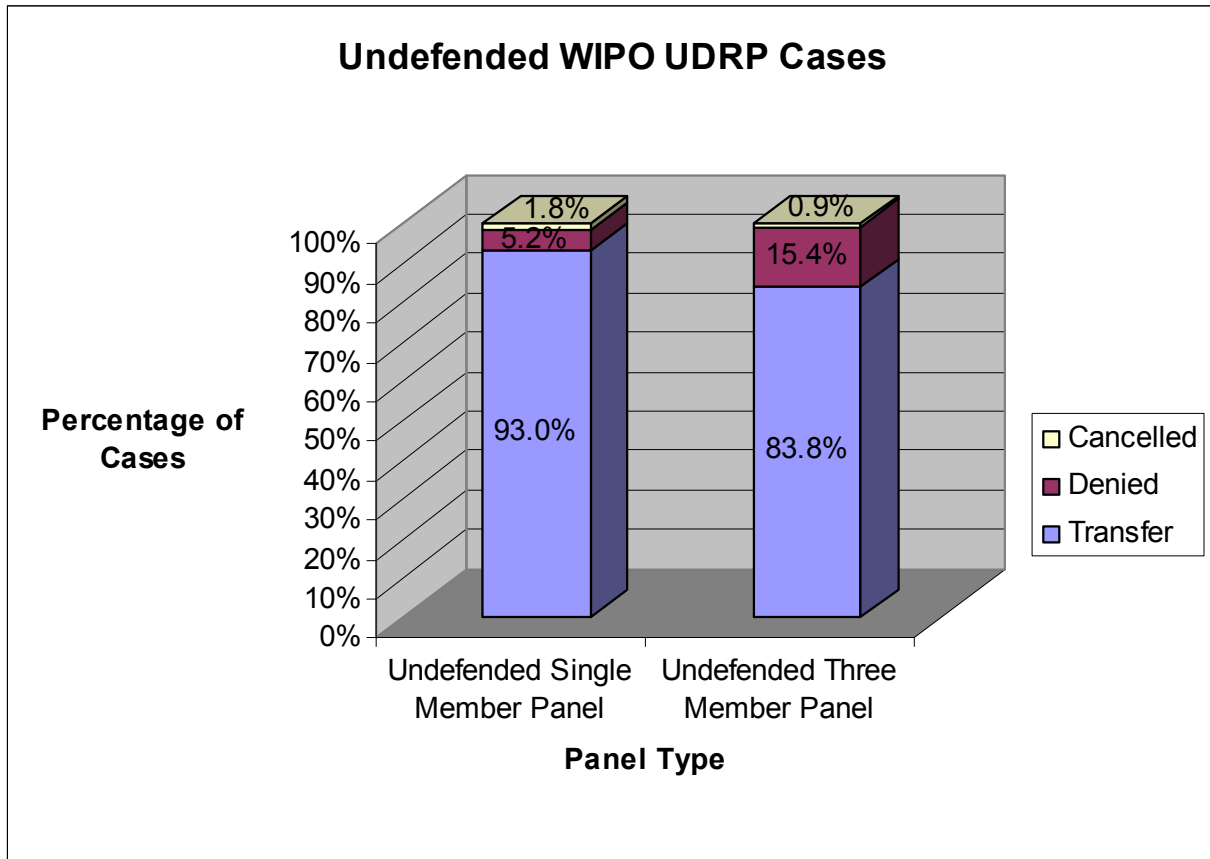
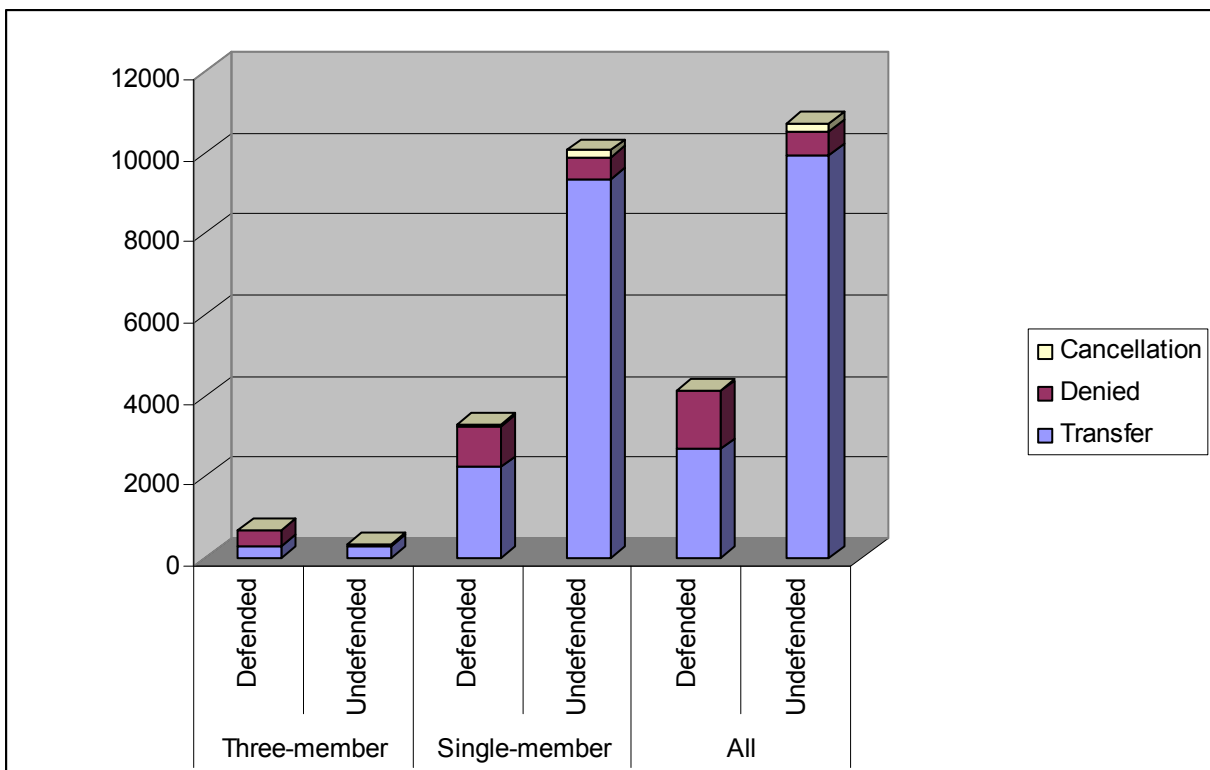


Table 10: WIPO UDRP Cases (Percentage Defended Cases - Single and Three-Member Panels)

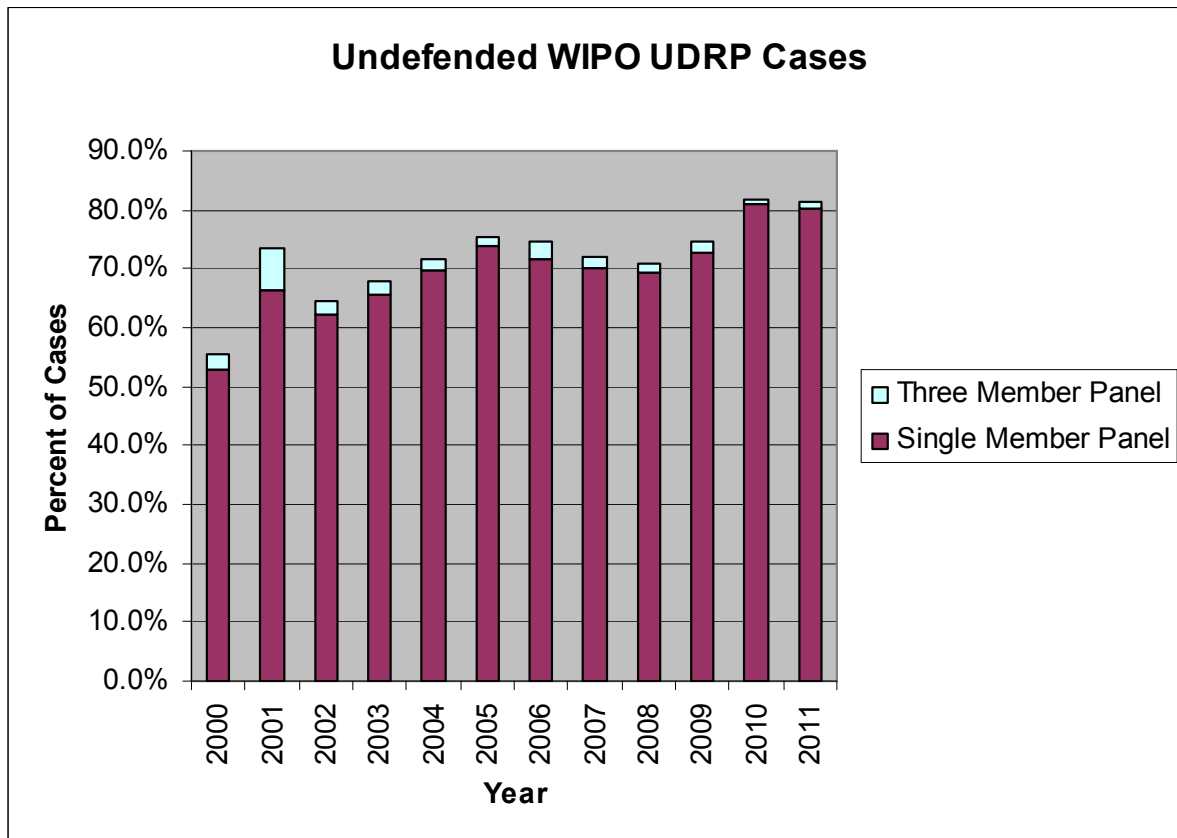


**Table 11: WIPO UDRP Cases (Percentage Undefended Single and Three-Member Panels)**



**Table 12: WIPO UDRP Case Outcome in Defended/Undefended Cases Overall and by Panel Type**





**Table 13: WIPO UDRP Case Outcome in Undeferred Cases**

With respect to Panel appointments at WIPO, the process of panel appointment is a matter that the WIPO Center gives serious consideration to in each and every case, on the basis of objective appointment criteria, including party location, party citations, language, panel availability, conflicts, and panel professional experience, which are transparently discussed every year at Panelists Meetings and Domain Name Workshops. Subject to these criteria, the WIPO Center endeavors to responsibly spread appointments across as broad a range of listed panelists as possible.

As but one illustration of the truly global scope of the UDRP, across the 15,793 domain name disputes processed by WIPO to date in which the matter proceeded to a decision (with approximately a quarter of filed disputes settling prior to panel appointment), 488 different WIPO panelists have been appointed to serve. These panelists have come from 57 countries, across all continents.

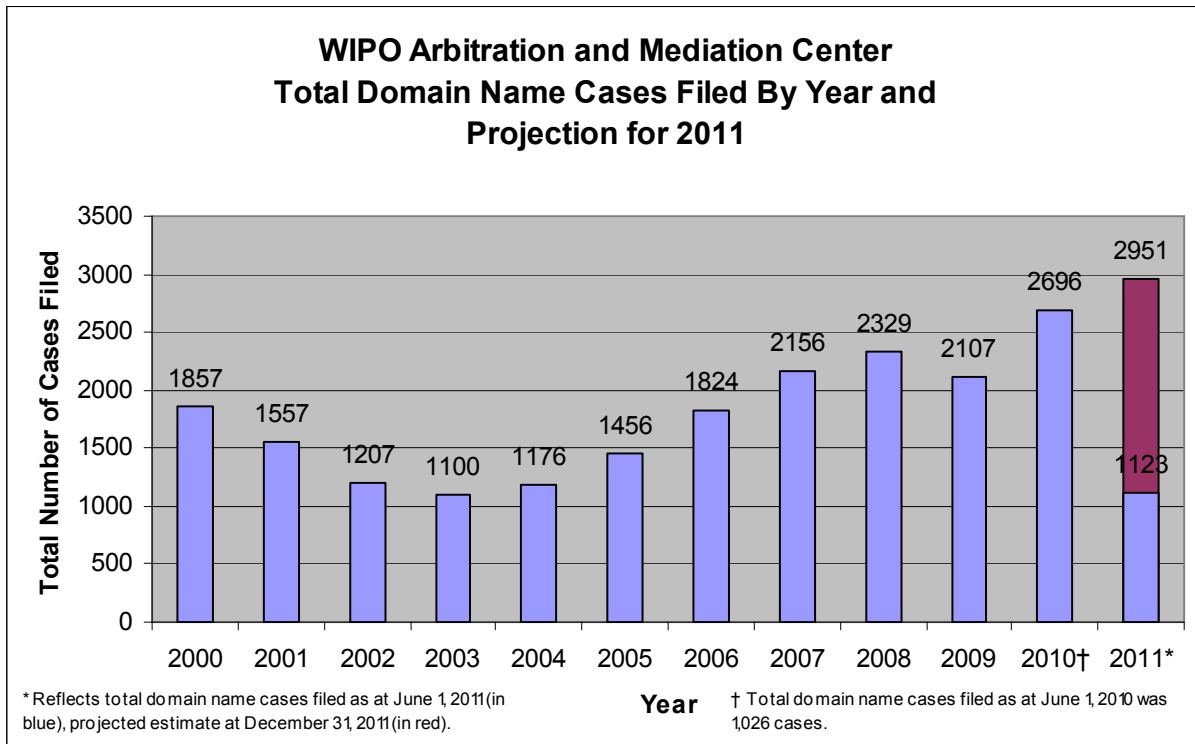
Of the 838 domain name disputes processed by WIPO so far in 2011 (through August 8, 2011) where the matter proceeded to a decision, 271 different WIPO panelists were appointed to serve on the panel. These 271 panelists came from 44 different countries, representing appointment across all continents.

WIPO's declaration document is publicly posted on the WIPO website.

The WIPO roster as at August 8, 2011 comprising 456 members is kept under regular review in light of operational needs, and a number of panelists have been added in view of such needs, or have retired over the past 12 years.

**9. WIPO AND THE UDRP**

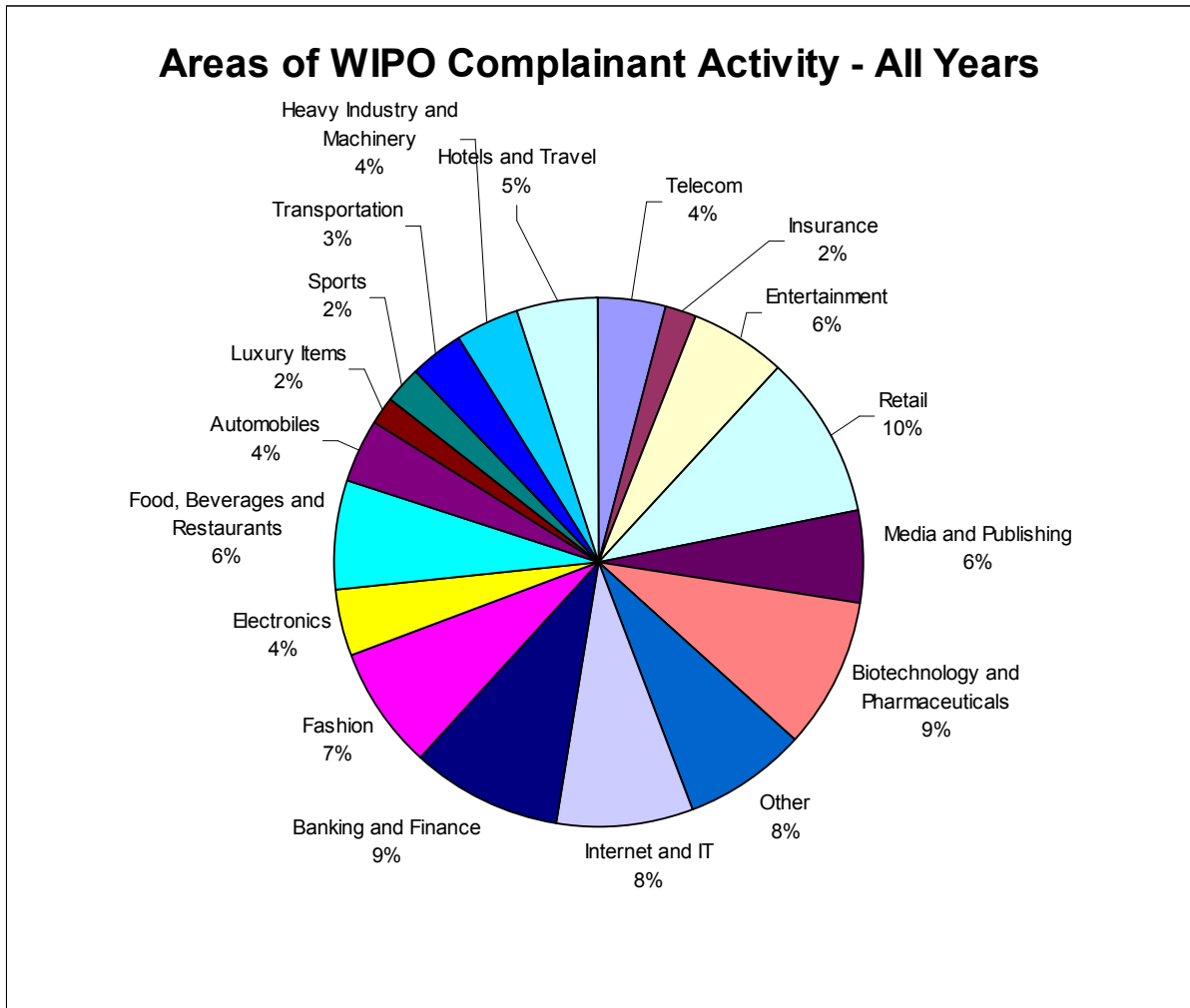
Since December 1999 through August 8, 2011, the WIPO Arbitration and Mediation Center has administered more than 21,097 UDRP and UDRP-based cases. Demand for this WIPO service continued in 2010 with trademark holders filing 2,696 complaints, an increase of 28% over the 2009 level. This trend has continued into 2011, with trademark holders having filed 1618 complaints to date, with projections indicating a likely increase of between 5 and 10% over the 2010 level.



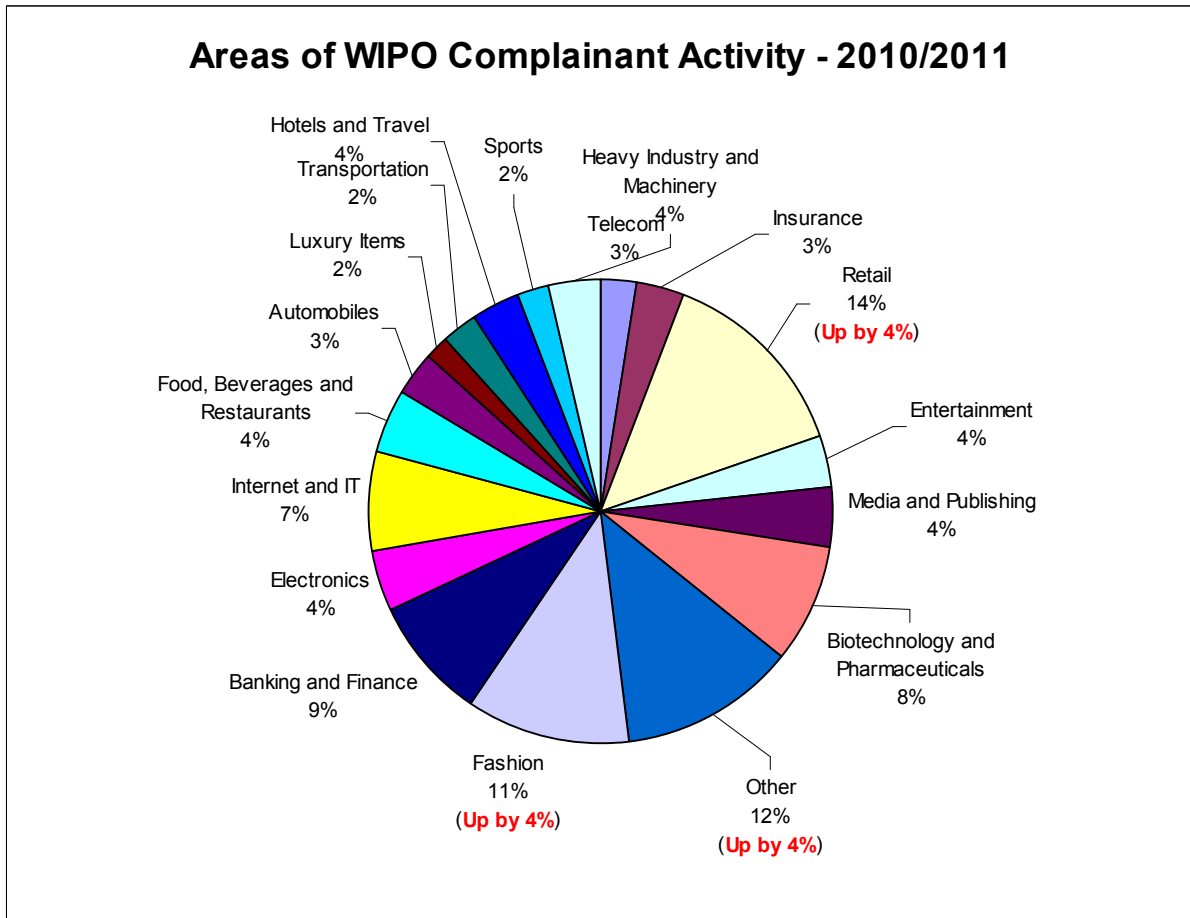
**Table 14: WIPO Domain Name Cases By Year**

The WIPO Center makes available extended online statistics to assist WIPO case parties and neutrals, trademark attorneys, domain name policy makers, the media and academics. (Available WIPO statistics cover many categories, such as “areas of complainant activity”, “named respondents”, “domain name script” and “25 most cited decisions in complaint”. See [www.wipo.int/amc/en/domains/statistics](http://www.wipo.int/amc/en/domains/statistics).)

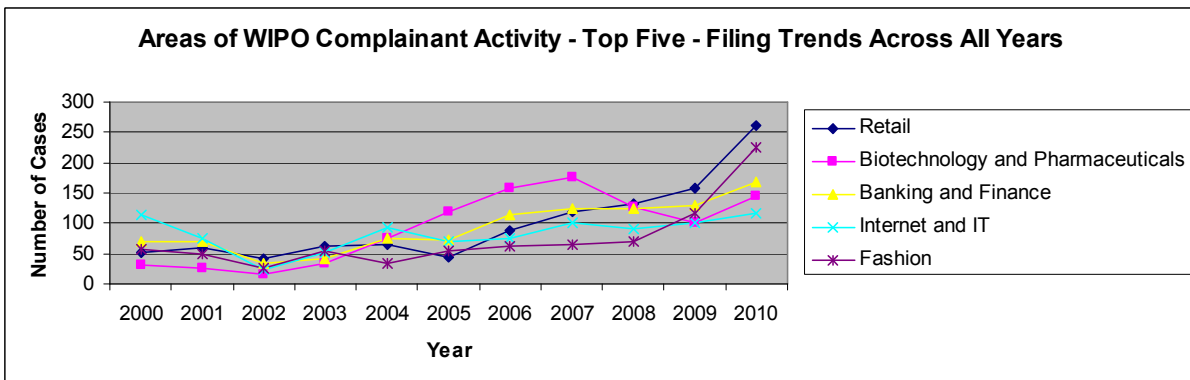
A diverse mixture of brand-owning individuals and enterprises, foundations and institutions rely on the WIPO Center’s dispute resolution procedures. The top five sectors for complainant business activity overall have been Retail, Fashion, Banking and Finance, Biotechnology, Internet and IT.



**Table 15: Areas of WIPO Complainant Activity – All Years**



**Table 16: Areas of WIPO Complainant Activity – 2010/2011**



**Table 17: Areas of WIPO Complainant Activity – Top Five – Filing Trends Across All Years**

WIPO UDRP proceedings have through August 2011 involved parties from 163 countries. Reflecting the truly global scope of this dispute mechanism, complainants in WIPO cases have represented over 98 countries.

Complainant Country	Number of Cases	Percentage of Cases
United States of America	8589	40.74%
France	2358	11.18%
United Kingdom	1588	7.53%
Germany	1165	5.53%
Switzerland	1099	5.21%
Spain	899	4.26%
Italy	742	3.52%
Netherlands	509	2.41%
Denmark	467	2.21%
Canada	398	1.89%

**Table 18: WIPO Top Ten Named Complainant Countries – All Years**

Complainant Country	Number of Cases	Percentage of Cases
United States of America	1475	34.00%
France	518	11.94%
United Kingdom	322	7.42%
Denmark	261	6.02%
Switzerland	240	5.53%
Germany	199	4.59%
Italy	194	4.47%
Netherlands	164	3.78%
Spain	137	3.16%
Sweden	112	2.58%

**Table 19: WIPO Top Ten Named Complainant Countries – 2010/11**

Respondent Country	Number of Cases	Percentage of Cases
United States of America	7713	36.58%
United Kingdom	1716	8.14%
China	1436	6.81%
Spain	912	4.33%
Canada	891	4.23%
Republic of Korea	712	3.38%
France	697	3.31%
Australia	549	2.60%
Netherlands	483	2.29%
India	367	1.74%

**Table 20: WIPO Top Ten Named Respondent Countries – All Years**

Respondent Country	Number of Cases	Percentage of Cases
United States of America	1252	28.86%
China	537	12.38%
United Kingdom	303	6.98%
Netherlands	181	4.17%
Spain	158	3.64%
Australia	155	3.57%
France	153	3.53%
Turkey	127	2.93%
Canada	113	2.60%
India	101	2.33%

**Table 21: WIPO Top Ten Named Respondent Countries – 2010/11**

In function of the language of the applicable registration agreement of the domain name at issue, or as may be otherwise determined by the Panel, WIPO UDRP proceedings have so far been conducted in 18 different languages, with the top five overall being English, Spanish, French, Chinese, Korean.

Case Language	Number of Cases	Percentage of Cases
English	18,721	88.70%
Spanish	856	4.06%
French	597	2.83%
German	255	1.21%
Korean	244	1.16%
Dutch	192	0.91%
Chinese	113	0.54%
Italian	38	0.18%
Japanese	24	0.11%
Portuguese	16	0.08%

**Table 22: Top Ten Languages of WIPO Proceeding**

## 10. WIPO UDRP FILING FEES

Under the UDRP, payment of the appropriate filing fee for a complaint is a precondition for the provider commencing work on it. (Given the UDRP restrictions (see paragraphs 3 and 8(a)) on transfer of a disputed domain name during pending UDRP proceedings, and the typical issue of a lock request by the provider to the concerned registrar on complaint filing, this acts in part as a safety valve against the tactical filing of groundless complaints which a party does not in fact intend to pursue.)

WIPO is a non-profit provider, with its published schedule of filing fees based on a simple metric of the number of disputed domain names, and the panel type selected. See WIPO Schedule of UDRP Fees at [www.wipo.int/amc/en/domains/fees/index.html](http://www.wipo.int/amc/en/domains/fees/index.html).

For example, the WIPO filing fee for a UDRP single-member panel case involving between 1-5 disputed domain names is USD 1,500. This comprises a USD 500 processing fee for the WIPO Center, and USD 1,000 payable to the Panel in the event of appointment and decision. In the event that the matter is suspended, settled and terminated prior to panel appointment, WIPO will typically refund the Complainant the USD 1,000 that would otherwise have been payable to the Panel.

As a non-profit provider, WIPO does not charge extra for correction of identified complaint deficiencies, for cases involving privacy or proxy services, for registrants with multiple aliases, for language of proceeding requests, for consolidation requests, for respondent extension requests, or for supplemental filing requests by either party. Applicable fees are limited to those transparently indicated (by reference to domain name number and panel type) in the relevant WIPO Schedule.

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## 11. WIPO CONTINUING LEGAL EDUCATION FOR UDRP PRACTITIONERS

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Unique among UDRP providers, the WIPO Center has long offered regular Domain Name Dispute Resolution Workshops for interested parties and organized annual meetings of its Domain Name Panelists. (See e.g. information concerning this year's upcoming WIPO Advanced Domain Name Workshop on Domain Name Dispute Resolution: Overview on Practice and Precedent at [www.wipo.int/amc/en/events/workshops/2011/domainname/](http://www.wipo.int/amc/en/events/workshops/2011/domainname/).)

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## 12. IMPROVING THE WIPO UDRP EXPERIENCE

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The WIPO Center regularly conducts market research and engages in outreach with UDRP users regarding their experience of WIPO UDRP services and resources. WIPO client feedback is actively sought and welcome, including by email to the WIPO Center at [arbiter.mail@wipo.int](mailto:arbiter.mail@wipo.int). We endeavor to be proactive in meeting user needs where feasible, as well as responsive to received feedback. As a responsible Provider, we believe in workable adjustment to WIPO practice in light of DNS developments wherever feasible within the UDRP framework.

Although WIPO and its Panelists constantly deploy long-standing expertise in applying the UDRP and UDRP Rules, these are ultimately ICANN consensus policies, and can therefore only be amended by ICANN. WIPO does, however, have an extensive history of engagement with ICANN on the UDRP. (See e.g. Selected WIPO Correspondence with ICANN, on UDRP-related matters at [www.wipo.int/amc/en/domains/resources/icann/index.html](http://www.wipo.int/amc/en/domains/resources/icann/index.html).) While this active WIPO engagement concerns all aspects of UDRP operation, one more visible result is ICANN's adoption of the eUDRP enabling paperless filing.

Although implementation of UDRP decisions is ultimately a matter for the parties and the concerned registrar, and for ICANN as the accrediting agency, WIPO maintains a registrar liaison service that works with WIPO parties, concerned registrars (of which ICANN has accredited over a thousand to date), and (where necessary) ICANN compliance staff towards resolving registrar-related issues that may arise at any stage of a UDRP proceeding. This service aims to improve understanding with respect to relevant obligations under the Policy and Rules. WIPO's UDRP registrar liaison service, which operates from [registrar.liaison@wipo.int](mailto:registrar.liaison@wipo.int), has (over the 2010/11 period) dealt with an average of four UDRP case-related queries per working day in addition to numerous telephone queries on the subject. For WIPO correspondence with ICANN on various registrar issues, see e.g. [www.wipo.int/amc/en/domains/resources/icann/index.html](http://www.wipo.int/amc/en/domains/resources/icann/index.html).

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## 13. WIPO DECISIONS AND RESOURCES

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All WIPO panel decisions are posted on the Center's website. The WIPO Center offers an online overview of broad decision trends on important case issues via the [WIPO Overview 2.0](http://www.wipo.int/amc/en/domains/search/overview2.0/index.html) which distills thousands of UDRP cases handled by the Center, which is available at [www.wipo.int/amc/en/domains/search/overview2.0/index.html](http://www.wipo.int/amc/en/domains/search/overview2.0/index.html). This globally-used instrument was created and is updated in collaboration with WIPO Panelists in recognition of the need that has been expressed to identify, as much as possible, consensus among UDRP decisions so as to help maintain the consistency of WIPO UDRP jurisprudence.

To facilitate access to these decisions according to subject matter, the WIPO Center also offers an online searchable [Legal Index](http://www.wipo.int/cgi-bin/domains/search/legalindex) of WIPO UDRP Decisions, which is available at [www.wipo.int/cgi-bin/domains/search/legalindex](http://www.wipo.int/cgi-bin/domains/search/legalindex). Among WIPO's most visited web pages, the Overview and Legal Index have become essential professional resources, allowing panelists, parties, academics or any interested person to familiarize themselves with WIPO case precedent. The Index and Overview are updated periodically to include new categories that primarily reflect developments in the DNS itself.

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## 14. DNS DEVELOPMENTS

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One such development has concerned the growth in the number of professional domain name investors and the volume of their activity, and the use of computer software to automatically register (sometimes expired) domain names and their “parking” of often competing advertisements on pay-per-click portal sites. In addition to their value as commercial identifiers, domain names have increasingly taken on aspects of commodities for speculative gain. Whereas traditional domain name abuse involved the registration of domain names by individuals seeking to turn a profit on the “squatted” names, nowadays a growing number of “domainers” are deriving income from the large-scale automated registration of domain names corresponding not only to dictionary terms but also to third-party identifiers.

Another such area of attention is the widespread use of privacy and proxy registration services, which according to ICANN estimates now involves some 25% of domain name registrations. In combination with varying reliability of “Whols” registrant contact data, this can pose significant challenges for filing parties, providers, and panels in ascertaining appropriate respondent identity in UDRP proceedings.

Both of these, and many others, are areas which have been addressed extensively by WIPO Panels over many reasoned UDRP decisions in an effort to find practical and workable solutions within the existing UDRP framework. (See e.g. [WIPO Overview 2.0](#), paragraphs 2.6, 3.4, 3.8, 3.9, 4.9.)

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## 15. DEVELOPMENTS IN UDRP FILING

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Following ICANN's acceptance of a WIPO proposal, from December 2009 the WIPO Center became the first UDRP provider to remove the requirement to submit and distribute paper copies of pleadings in the UDRP process. This benefits all stakeholders by eliminating the use of vast quantities of paper and the associated production and shipping costs, as well as improving the timeliness of UDRP proceedings without prejudicing either complainants or respondents. It is probable that this change has contributed in part to the increase (by more than a quarter) in UDRP filings over the course of 2010/11.

(Full details of WIPO's eUDRP implementation are available at [www.wipo.int/amc/en/domains/rules/eudrp/](http://www.wipo.int/amc/en/domains/rules/eudrp/) and [www.wipo.int/export/sites/www/amc/en/docs/icann301208.pdf](http://www.wipo.int/export/sites/www/amc/en/docs/icann301208.pdf).)



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## 16. EFFECTIVENESS OF THE UDRP

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The UDRP has long been offering an effective solution for trademark owners, domain name registrants, and registration authorities. Introduced to meet the need for an administrative dispute resolution mechanism purpose-designed to resolve certain trademark-based online conflicts occurring across national jurisdictions while retaining court options, it has won international respect as an expedient alternative to those court options.

Looked at holistically, it has served to keep tens of thousands of disputes out of the courts, and as but one measure of how the system has held up, it is only in the rarest of cases that a UDRP decision has been successfully challenged in court.

It is important to recognize that, in different ways, the existing UDRP framework continues to work to the benefit of all DNS actors. It continues to underpin commercial and legal stability in the DNS, and is widely acknowledged to be functioning well. On the one hand, trademark owners have the benefit of an administrative dispute system which is much quicker and cheaper than the courts, which delivers them an overall success rate in the vast majority of cases with outcomes very rarely challenged in courts. On the other hand, instead of being sued for domain names and damages in court, registrants have the benefit of a more contained system, which moreover includes a three-member panel option in which parties can nominate and rank candidates. Both sides have the benefit of making informed decisions based on more than a decade of collective reasoned jurisprudence, and both have the option of preserved court options for those rare cases in which either party elects to pursue a particular UDRP matter further in a court.

Moreover, by accommodating evolving norms and practices, the UDRP framework has proven to be both effective and flexible. By not seeking to micro-legislate for moments in time, its non-exhaustive concepts of respondent rights or legitimate interests and bad faith are subject to panel interpretation in light of evolving legal norms and business practices. Similarly, panels have appropriate procedural powers. Building on this flexibility, the UDRP, in effect, represents the collective wisdom and public stewardship of hundreds of UDRP panelists across jurisdictions exercised over the course of tens of thousands of reasoned decisions.

As mentioned, examples of practical issues addressed by UDRP panels include privacy and proxy registration services, multiple parties and consolidation principles, language requests, consideration of supplemental filings, and suspension procedures to facilitate party-agreed settlement. The list is long, with these and many other issues continuing to be streamlined by WIPO UDRP panelists in live cases every day.

In this way, the UDRP has incrementally developed as a public system of jurisprudence over many years and thousands of published panel decisions. (See e.g. the [WIPO Overview 2.0](#), which distills broadly-held panel positions on nearly 50 of the most important procedural and substantive issues in some 20,000 WIPO UDRP cases.) The UDRP functions today as the unique result of the care invested by many stakeholders over more than ten years, for public and private benefit.

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## 17. REVISING THE UDRP?

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Of course, any legal mechanism might be improved, and from an IP rights holders' perspective, there are numerous ways in which the UDRP might be amended. It could operate on condensed timelines and default decisions. Its scope could extend beyond trademark rights, and additional bad-faith scenarios expressly included.

For example, in 2010/11, WIPO estimates that some form of counterfeiting was alleged in approximately 20% of filed complaints. Calls have been made for damages options and “loser pays” models. The UDRP could also be expanded to address certain forms of intermediary behavior. Some stakeholders are on record with calls for revision to the UDRP definition of cybersquatting, and for the introduction of layered appeal processes.

But the question today is not so much whether the UDRP might be improved in theory or concept – although that in itself may be an important discussion – but rather, whether it could effectively survive an ICANN process nominally directed to that end. Institutionally IP occupies only a minor ICANN voting role, and experiences to date with new gTLD RPMs, including the URS on the second level, unmistakably demonstrate this.

Furthermore, early-day ICANN efforts to revise the UDRP merely produced polarized debate, with its only successful amendment resulting from the highly-targeted, non-contentious ICANN adoption of the WIPO-proposed paperless “eUDRP”.

Subjecting the UDRP model to an ICANN decision process weighted against legitimate IP interests hardly seems likely to produce positive net results for this mechanism. It is likely to be highly contentious and resource-intensive and to foster a sense of destabilization at a time when brand-owners will be looking to the existing UDRP as the only proven mechanism in place to absorb the impact of gTLD expansion.

Discussing possible improvements to the framework of any legal mechanism can be healthy, but the process and timing for serious change must be right. Is this really the time to be talking about opening up the functioning and overall effective UDRP to still more rounds of ICANN process, or rather to be focusing ICANN’s attention on the value of the existing UDRP as a known and reliable quantity?

Might it be more propitious to encourage ICANN to respect its own expressed acknowledgment of the overall success as well as the commercially important role presently played by the “existing, long-standing and tested” UDRP, and to instead refocus its spotlight on the much older (and less transparent) practice of cybersquatting, which the UDRP was introduced to address?

(See further WIPO letters to ICANN of July 15, 2011 and May 6, 2011 regarding the current state of the UDRP, which are posted on the WIPO Center’s website at [www.wipo.int/export/sites/www/amc/en/docs/icann150711.pdf](http://www.wipo.int/export/sites/www/amc/en/docs/icann150711.pdf) and [www.wipo.int/export/sites/www/amc/en/docs/icann060511.pdf](http://www.wipo.int/export/sites/www/amc/en/docs/icann060511.pdf) respectively).

## **18. WIPO CONCLUDING REFLECTIONS ON CERTAIN PROPOSALS TO REVISE THE UDRP**

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### Loser pays

Introduction of some form of loser pays model into the UDRP may be attractive to brand owners in principle, but would warrant very serious reflection. Such a revision would require a Policy and Rules change (with the risk of dilution and destabilization this may imply if pursued through a minority IP controlled ICANN process). It would inevitably add time, complexity and probably administration cost to what is intended to be a simple mechanism for clear cases of cybersquatting. Payment enforceability would be a major issue (including from who and how to collect). An escrow obligation on registrants merely to be heard and participate would be highly contentious, and “locking out” non-paying respondents submitting timely replies may raise procedural fairness issues (including in courts down the line).

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Deterrent value overall may be marginal, given also that most UDRP cases are not defended. Anecdotally, defended cases also tend to be those that are less clear or more evenly balanced, and have a lower transfer rate (would a loser pays model really be in either side's interest if brand-owners are unlikely to be able to enforce especially in defaults, and both parties more or less "break even" in defended cases?).

Dare to dream: ICANN sets up a cybersquatting offset fund to compensate successful UDRP complainants (no Policy or Rules change required, brand-owners mostly get what they want, with ICANN picking up the tab for cybersquatters in the second level gTLD space which it and accredited intermediaries are not otherwise inclined to reign in). The amount of revenue which registrars, registries and ICANN make out of infringing domain names (whether or not concerned by UDRP cases) should provide a healthy foundation.

The debate over bad faith – and/or

It bears reflecting that this issue in practice in fact only concerns a very small number of decided UDRP cases overall (findings of clear bad use absent findings of actual or inferred bad faith registration are rare). Still, it is a proposal likely to be attractive to brand owners. There are clear and workable precedents in the ccTLD space (including the Nominet DRP and the .auDRP models). Changing the "and" to an "or" in the UDRP would require a Policy and Rules change (with the above-mentioned risks if pursued through a minority IP ICANN process at this time). WIPO believes this could be a good change for the UDRP in principle, but the timing and process would have to be right.

The value (or not) of a formal appeals process

Introduction of a formal appeal mechanism within the existing UDRP framework would certainly add time, complexity and cost, if not controversy. It would require a significant Policy and Rules change (with the above-mentioned risks if pursued through a minority IP ICANN process at this time). There are working precedents for formal appeals mechanisms in the ccTLD space (including the Nominet DRP) – but these operate (broadly speaking) within the scope of a single national legal system, and the appeal panelists are (in general) drawn from the same (or similar) legal traditions and systems. The UDRP is in that respect a wholly different system, operating as it does across many different legal systems, with panelists from numerous diverse jurisdictions around the world. It is not clear in that context that a formal UDRP appeals system would add any additional consistency – and may well in fact have the opposite effect, especially if operated across multiple panelists and providers.

As things currently stand under the existing UDRP framework, brand owners have the benefit of a system that delivers an overall success rate in the vast majority of cases. (Why bring in additional appeals if you are already mostly winning, and you have limited exception for refiled cases where new evidence not available at the time of the Complaint may be brought to light?) Both parties have the option of a three-member panel election, which is still much faster and cheaper than court, and in which the average overall transfer rate is closer (at least at WIPO) to fifty-fifty. (Why bring in additional appeals if you already have an option in which you are achieving close to parity, in a system designed to address clear cases of cybersquatting, in which either party can still fall back on going to court if it wishes?)

There are of course reasons why a formal appeals process was not included in the original blueprint of the UDRP mechanism. More generally, there may be questions about the wisdom of dressing up (in the UDRP's case a global, streamlined, lower cost) alternative to the courts with some of the heavier features of that very court system.