



« The WIPO ccTLD Dispute Resolution Experience »

International ccTLD Conference
Sofia, Bulgaria, September 9, 2008

Erik Wilbers

World Intellectual Property Organization (WIPO)
Arbitration and Mediation Center



The Emergence of Cybersquatting

- Domain names becoming business identifiers (money makers)
- First-come first-served registration system
- Emergence of ‘cybersquatting’: domain name registrations capitalizing and infringing on third-party trademarks and other intellectual property rights

A Challenge for the National Courts

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

The Uniform Domain Name Dispute Resolution Policy (UDRP)

- WIPO-recommended, effective Dec. 1999
- Binding through registration conditions
- Uniform applicability (‘.com’ et al.)
- ‘Administrative’ - leaves open court option
- Limited to abusive cases of ‘bad faith’
- Scope limited to trademark rights
- Restricted to transfer; no ‘damages’
- Transfer done if no court within ten days
- Abbreviated process

Two-Month Online Procedure

- Complainant files Complaint with provider
- Provider checks compliance/registrant data
- Provider notifies Respondent of 20-day opportunity to file Response
- Provider appoints independent Panel from posted WIPO list - 14 days for decision
- Provider formats, notifies, posts decision
- Registrar implements decision, if no competent court case within ten days

UDRP Panel Decision Criteria

- Complainant wins case and gets the domain name if:
- Complainant has rights in trademark and Respondent's domain name is identical or confusingly similar to such trademark; *and*
- Respondent has no right or legitimate interests in domain name (UDRP provides examples); *and*
- Respondent registered and uses domain name *in bad faith* (UDRP provides examples)

WIPO UDRP Filing Numbers

- WIPO UDRP Cases since December 1999: *13,881*
- Case parties from 145 countries
- Cases cover 24,944 domain names
- Domain name scripts involved sofar:
English (99.53%) German French
Chinese Japanese Korean Spanish
Norwegian Swedish Danish

ccTLD Dispute Models

- No obligation to adopt the UDRP, but:
- 1. How does the ccTLD protect trademark and other intellectual property rights?
- 2. National courts are generally less suitable the more “open” the registration policy of a ccTLD is

Advantages of the UDRP for ccTLDs (1)

- Mandatory procedure
 - ▶ Part of domain name registration agreement
- Efficient: quick results at moderate cost
- Direct enforcement of transfer
- Limited scope and streamlined procedure
 - ▶ Written (online) procedure
 - ▶ Single exchange of pleadings
 - ▶ Deadlines
- Blocking domain name during procedure

Advantages of the UDRP for ccTLDs (2)

- Preserves recourse to national courts
 - ▶ Facilitates acceptance (UDRP: <1% of decisions contested)
- Neutrality
 - ▶ Independent of registry
 - ▶ Impartial and independent decision makers
 - ▶ Reasoned decisions, available to the public
 - ▶ Notice of registrant by all possible means
 - ▶ Burden of proof rests on Complainant

The WIPO ccTLD Experience

- WIPO case services adopted by 55 *ccTLD registries* (the list is growing)
 - ▶ **Examples:** .au .am .ch .co .es .fr .ie .ir .ma
.mx .nl .pe .ph .pl .ro .tm .ug .ve
- Over 600 *WIPO ccTLD cases* since December 1999
- Covering 1,156 *ccTLD names*
- ccTLD disputed name share growing: 7% in 2007

WIPO ccTLD Dispute Policy Models

- UDRP: 35
- Variation of UDRP: 16
- Other model: 4

UDRP as a Flexible Model

Adjustable Elements (1)

- Bad faith registration and/or use, or any infringement of (IP) rights?
 - ▶ Infringement under national law (.ch, .es, .fr)
- Local rights only or also “foreign” rights?
 - ▶ ccTLD typically addresses a certain territory
 - ▶ Location requirement for dn registration?
- Protecting only trademarks or also other identifiers?
 - ▶ Trade names, personal names, gi’s,...

UDRP as a Flexible Model

Adjustable Elements (2)

- ▶ Local language(s)
- ▶ Nationality and qualification of Panelists
 - ▶ Factors:
 - ▶ Decisions to be made in accordance with local law rather than standard (bad faith) conditions
- ▶ Local/regional and international dispute resolution providers
- ▶ Mediation element (.ch)

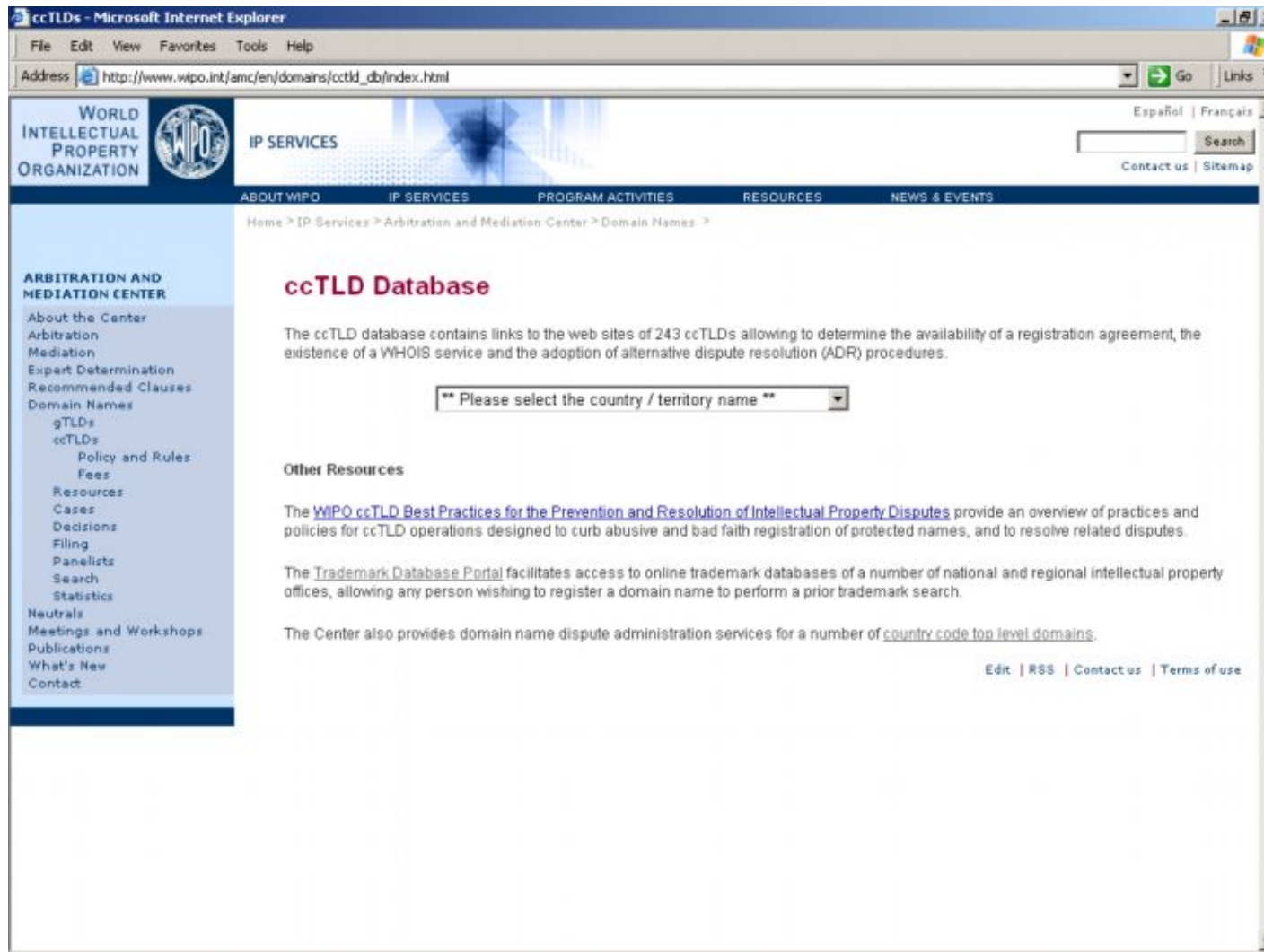
Adopting or Adapting the UDRP?

- *Balance/choice between:*
- Applying the global norm
 - ▶ Available precedent
 - ▶ Predictable model for parties
 - ▶ Proven efficiency and enforcement
 - ▶ Light burden for registrars and registries
 - ▶ Possibility to consolidate cases against same registrant
- and
- Desire to adapt to local environment

WIPO ccTLD Services

- ▶ Part of Intergovernmental Organization of 184 Member States
 - ▶ Non-profit and neutral
- ▶ Model registration agreements
- ▶ Free dispute policy advice and drafting
- ▶ Experienced case administration
 - ▶ Unique case facilities, including online legal decision index
- ▶ Quality decision makers and staff
- ▶ Posting of ccTLD information and online ccTLD database

WIPO ccTLD Database



ccTLDs - Microsoft Internet Explorer

Address: http://www.wipo.int/amc/en/domains/ccTld_db/index.html

World Intellectual Property Organization

IP SERVICES

ABOUT WIPO | IP SERVICES | PROGRAM ACTIVITIES | RESOURCES | NEWS & EVENTS

Home > IP Services > Arbitration and Mediation Center > Domain Names >

ccTLD Database

The ccTLD database contains links to the web sites of 243 ccTLDs allowing to determine the availability of a registration agreement, the existence of a WHOIS service and the adoption of alternative dispute resolution (ADR) procedures.

**** Please select the country / territory name ****

Other Resources

The [WIPO ccTLD Best Practices for the Prevention and Resolution of Intellectual Property Disputes](#) provide an overview of practices and policies for ccTLD operations designed to curb abusive and bad faith registration of protected names, and to resolve related disputes.

The [Trademark Database Portal](#) facilitates access to online trademark databases of a number of national and regional intellectual property offices, allowing any person wishing to register a domain name to perform a prior trademark search.

The Center also provides domain name dispute administration services for a number of [country code top level domains](#).

Edit | RSS | Contact us | Terms of use

ARBITRATION AND MEDIATION CENTER

- About the Center
- Arbitration
- Mediation
- Expert Determination
- Recommended Clauses
- Domain Names
 - gTLDs
 - ccTLDs
 - Policy and Rules
 - Fees
- Resources
 - Cases
 - Decisions
 - Filing
 - Panelists
 - Search
 - Statistics
- Neutrals
- Meetings and Workshops
- Publications
- What's New
- Contact

WIPO Information and Contact

- <http://www.wipo.int/amc/en/domains/>
- erik.wilbers@wipo.int