

Draft WGIG issues paper on Dispute Resolution

This paper is a 'draft working paper' reflecting the preliminary findings of the drafting team. It has been subject to review by all WGIG members, but it does not necessarily present a consensus position nor does it contain agreed language accepted by every member. The purpose of this draft is to provide a basis for the ongoing work of the group. It is therefore not to be seen as a chapter of the final WGIG report, but rather as raw material that will be used when drafting the report. This draft working paper has been published on the WGIG website for public comment, so it will evolve, taking into account input from governments and stakeholders.

1. Issue (what?)

Please identify an issue listed on the table "Inventory of Public Policy Issues" and describe this issue.

Dispute Resolution

Legal conflicts and disputes are resolved through litigation in public courts; however other processes have been adopted such as conciliation, mediation or arbitration. These methods are referred to as Alternative Dispute Resolution ("ADR"), as they do not involve official court procedures. Here a third-party provides the decision or assists the parties in reaching a settlement. ADR is preferred in some cases as it may be faster and less costly.

In the case of disputes on the internet ADR take on an added importance due to the internet's dynamics, large-scale application and technological specificities. However, and while ADR is available for domain names, there is nothing clear for dealing with disputes regarding the content.

Registrars in the .biz, .com, .info, .name, .net, and .org top-level domains (TLDs) follow the Uniform Domain-Name Dispute-Resolution Policy (often referred to as the "UDRP"), which is the most famous and widely used ADR (full details about it can be found on <http://www.icann.org/udrp>).

The UDRP was created when the so-called *cybersquatting* phenomenon arose. A cybersquatter is a person or company, which registers a domain name that corresponds to the name or trademark of another person or company, with the sole purpose of trying to re-sell it to the interested party for an increased fee.

Under the UDRP policy most types of trademark-based domain-name disputes must be resolved by agreement, court action, or arbitration before a registrar will cancel, suspend, or transfer a domain name. Disputes alleged to arise from abusive registrations of domain names (for example, cyber squatting) might be addressed by expedited administrative proceedings that the holder of trademark rights initiates by filing a complaint with an approved dispute-resolution service provider. The registrant is bound by the Registration Agreement to become a party to the administrative proceeding.

To invoke the policy, a trademark owner should either (a) file a complaint in a court of proper jurisdiction against the domain-name holder (where appropriate an in-rem action concerning the domain name) or (b) in cases of abusive registration submit a complaint to an approved dispute-resolution service provider.

The UDRP can be used in the following cases of disputes:

- The domain name at issue is identical or confusingly similar to a trademark or service mark in which the complainant holds rights.
- The domain name registrants have no rights or no legitimate interest in respect of the domain name.
- The registrant has registered the domain name in bad faith.

The UDRP enables trademark holders to acquire the corresponding domain names without a costly and lengthy legal process. This policy has been adopted for all accredited domain-name registrars for gTLDs domain names as well as certain managers of ccTLDs.

Other dispute resolution policies available for the other gTLDs and some ccTLDs are:

- [Charter Eligibility Dispute Resolution Policy](#) (.aero, .coop, .museum)
- [Eligibility Reconsideration Policy](#) (.aero)
- [Eligibility Requirements Dispute Resolution Policy](#) (.name)
- [Intellectual Property Defensive Registration Challenge Policy](#) (.pro)
- [Restrictions Dispute Resolution Policy](#) (.biz)
- [Start-Up Trademark Opposition Policy](#) (.biz)
- [Sunrise Challenge Policy](#) (.info)
- [Transfer Dispute Resolution Policy](#) (gTLDs transfers)

An open issue is whether UDRP should be extended to cover other non-trademark names. In the so-called WIPO-II process, WIPO has already expressed in favour of an extension to country and IGO names; this proposal is now under discussion at ICANN. Similarly, individuals usually desire to be protected against cybersquatting of their own personal and family names, even if such names are not trademarked or used for commercial purposes. While this kind of protection is highly desirable for the owners of rights on such names, some fear that such extension might effectively create new international rights not foreseen by any treaty.

Some stakeholders – namely, trademark owners and lawyers – would like to see the UDRP instrument extended or another dispute resolution mechanism, so to cover not just domain names, but the content of websites and other content posted to the Internet. Others – namely civil society groups – fear that this extension would further endanger the freedom to speak against commercial interests and the ability to use the Internet for non-commercial purposes, without all the warranties offered by a proper legal process.

Civil society groups that deal with online liberties have been complaining about perceived unfairnesses in the UDRP or in the way it was being applied by panels. As trademark pertain to commercial uses of names in specific business sectors, their application as a privileged right on generic domain names is considered by some as unfair towards other categories who use names in other contexts and without trademarking them – for example, personal names or names of non-profit organizations. So, these groups often complain about the undue extension of the scope of the UDRP from preventing cybersquatting to granting priority to commercial uses of domain names over non-commercial ones, and in some cases even to prevent criticism against corporations.

2. Attribution to category / ies

Please attribute the issue to one or more of the five categories on the table Inventory of Public Policy Issues and Priorities.

Dispute resolution is categorized in:

- Equitable distribution of resources
- Stable and secure functioning of the Internet

Note: Maybe it should be added to the “Multilingualization and contents” since it is expected to be an important issue when the Internet is Multilingual.

3. SWOT Analysis

Please assess the strengths and weaknesses of the present system (internal factors). What are its opportunities and threats (external factors)?

Strengths:

- Relatively inexpensive and short period till the opponents receive the results.
- Proven very good in the gTLDs to defend the interests of trademark owners.
- Some ccTLDs started to adopt it
- Its success in the domain names vs. trademarks can be the basis to be a test case, or have similar dispute resolution mechanisms that may be used for other important issues faced by the Internet users, like Spam.

Weaknesses:

- Lack of an appeal mechanism
- Inconsistent decisions
- Decisions biased towards trademark holders and decisions that create extended rights to trademark holders
- Some decisions reached by *stare decisis* rather than reviewing each case individually on its merits
- Non-compliance with decisions by certain registrars
- Maximum penalty under the UDRP is transfer or cancellation of the Domain Name

Opportunities:

- Advancement of technology
- Continuous update of the available dispute resolution policies.

Threats:

- Multilingualization of the Internet (will the UDRP be used)??
- Lack of coordination between the players.

4. Actors (who, with whom?)

Please identify the main actor (government, private sector, civil society or international organization) dealing with this issue and who else among the relevant stakeholders is involved.

The Internet Corporation for Assigned Names and Numbers (ICANN) is responsible for managing and coordinating the Domain Name System (DNS) to ensure that every address is unique and that all users of the Internet can find all valid addresses. Among its responsibilities, ICANN approves and maintains the UDRP and the accreditation of resolution providers.

The system functions through the accredited centers by ICANN, which are:

[Asian Domain Name Dispute Resolution Centre](#) [ADNDRC]

[CPR Institute for Dispute Resolution](#) [CPR]

[The National Arbitration Forum](#) [NAF]

[World Intellectual Property Organization](#) [WIPO]

5. Forums (where?)

(a) Who participates

(b) Nature of forum

Please describe where this issue is being discussed or dealt with and at what intervals? Do these meetings make decisions? What is the nature of possible decisions? Who participates in discussions and decision-making processes? What are the decision-making procedures?

More than a forum discusses the dispute resolution policies, mainly:

- Intellectual Property Constituency (IPC) of ICANN
- Internet committee of the International Trademark Association (INTA), mainly the Registration Practice and DNS Administration subcommittee.
- WIPO

The above forums do not make decisions, but make recommendations or comments (like that on the recent WIPO II process).

Intellectual Property experts participate in these forums and some other professional and business experts.

Other ICANN constituencies, as well as trade associations and civil society organizations, discuss the UDRP in their own forums, for the parts that affect their interests and needs.

6. Governance mechanisms (how?)

(a) Objectives of the rules system

(b) Content of principles, norms and rules

Please describe the overarching objectives of the rules system or norms in question. What is the actual content of the principles, norms and rules designed to achieve these objectives?

The available system is governed by ICANN, which all the accredited gTLD registries and registrars should follow (part of their agreements with ICANN). To implement dispute resolution system on the contents for example may not be possible mainly since no single authority available and will have to be taken to courts.

7. Adequacy measured against criteria / benchmarks set out in Declaration of Principles:

(a) multilateral

(b) transparent

(c) democratic

(d) capacity to address Internet governance in a coordinated manner

(e) multi-stakeholder approach

(f) other

Please assess whether the mechanisms described above are adequate when measured against the criteria or benchmarks set out in the Declaration of Principles. Are they multilateral, transparent and democratic? Are they addressed in a coordinated manner? Are they based on a multi-stakeholder approach? Are there other principles they respect or should respect?

The available dispute resolution (UDRP) can be categorized as a **transparent, democratic and multi-stakeholder approach**. However, civil society groups have complained that, in the creation of the UDRP, their opinions have not been taken into proper account – and, as such, the UDRP is biased against non-commercial interests

8. Additional comments

Please make any additional comments you may wish to make with regard to this issue.

It is important to note that most of the new TLDs have adopted a “sunrise period” before offering registration services to the public; this should decrease the disputes arising later between trademark and Domain name holders.

While Some Trademark owners supported the sunrise period others saw it unduly burdensome, as it may; add unnecessary expenses and not be feasible in a multilingual domain names system. Their idea was to adopted a better dispute resolution policy, subsequently their would be no need for the sunrise period.

Also, civil society groups think that sunrise periods reserved to trademark owners unduly privilege commercial uses of the Internet, by giving priority to commercial registrants over non-commercial registrants who would like to use the same name, especially in cases where such non-commercial users could have similar rights to the name (for example, when the domain name corresponds both to a trademark and to the name of an individual).

It needs to be examined whether maximum penalty of transfer or cancellation of the Domain Name under the UDRP is sufficient to discourage “bad faith” registrants.