# UDRP extension beyond the domain name

UDRP-like alternative dispute resolution remedies should be made available for a broader range of IP violations.

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#### Preview

- Problem samples
- UDRP solution
  - Describe The Uniform Domain Name Dispute Resolution Policy
  - Addresses only a fraction of this problem (requires trademark rights)
  - Advocate its extension to address other illegal activity on the internet
  - DMCA enhancement
- Key regulatory asset—the contractual foundation of all internet activity—is not fully exploited
- Implementation



### The problem

- Illegal activity on Internet is pervasive
  - Especially IP violations
  - Not limited to domain name infringement
- Bad actors are
  - Numerous
  - Anonymous
  - Remote

- National courts
  - Cautious, deliberate, hesitant
  - Expensive and time-consuming
  - Jurisdictional limitations
- UDRP
  - Effective, but
  - Limited to domain name disputes



## Examples of IP Violations

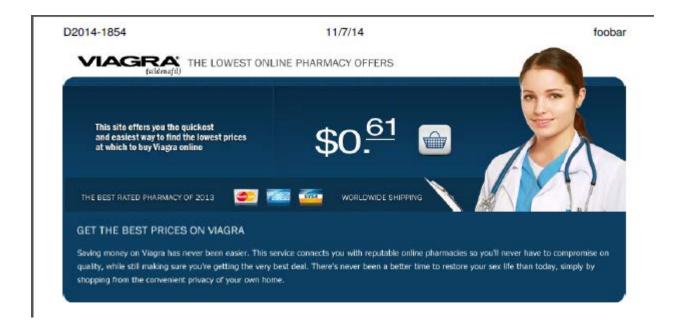
Focus of Trademark Counterfeiting

#### Counterfeits at <bossonlinesale.com>

D2014-2216



## Counterfeit Viagra < viagra.ninja >

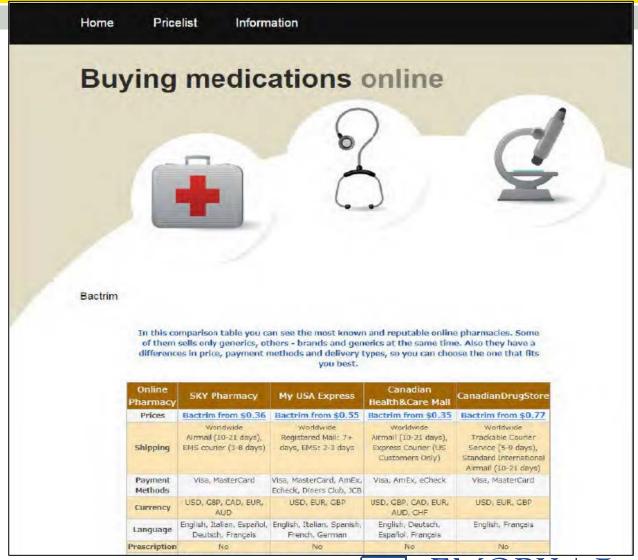


## <cartierlovejewelry.com>









#### ONLINE SHOPPING — BEST OFFERS FOR YOUR MEDS

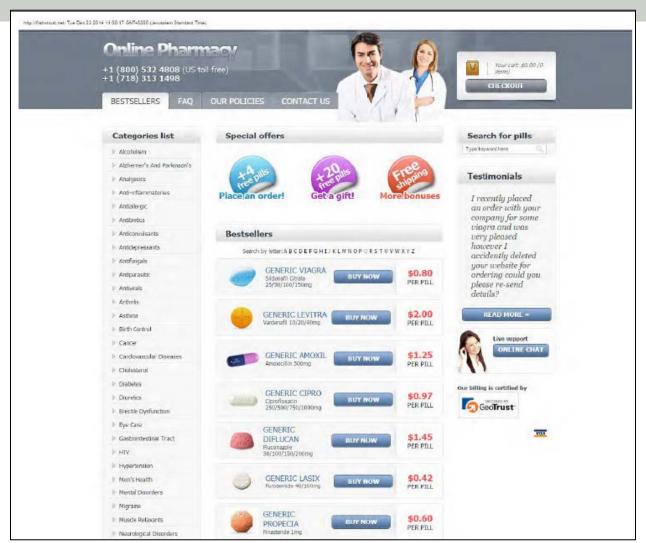


#### Generic For Bactrim

In this comparison table you can see the most known and reputable online pharmacles. Some of them sells only generics, others - brands and generics at the same time. Also they have a differences in price, payment methods and delivery types, so you can choose the one that fits you best.

	SKY Pharmacy	My USA Express		
Prices	Bactrim from \$0.36	Bactrim from \$0.55	Bactrim from \$0.35	Bactrim from \$0.77
Shipping	Worldwide Airmail (10-21 days), EMS courier (3-8 days)	Worldwide Registered Mail: 7+ days, EMS: 2-3 days	Worldwide Airmail (10-21 days), Express Courier (US Customers Only)	Worldwide Trackable Courier Service (5-9 days), Standard International Airmail (10- 21 days)
Payment Methods	Visa, MasterCard	Visa, MasterCard, AmEx, Echeck, Diners Club, JCB	Visa, AmEx, eCheck	Vise, MasterCard
Currency	USD, GBP, CAD, EUR, AUD	USD, EUR, GBP	USD, GBP, CAD, EUR, AUD, CHF	USD, EUR, GBP
Language	English, Italian, Español, Deutsch, Français	English, Italian, Spanish, French, German	English, Deutsch, Español, Français	English, Français
Prescription	No	No	No	No
	#1 for customer service (by customers votes) #1 for discount@bonus program (by customers	Special re-order price - save 15% Apart from the 5%, 10%	4 Free Bonus Pills for ALL orderst  Free Regular Airmail (10-	Free pill samples!  Money back guarantee





# History of UDRP- the "Uniform Domain Name Dispute Resolution Policy"

- Rampant "Cybersquatting" before 1999
  - Speculators or worse registered domain names important to others
  - Held them hostage
  - Demanded extortionist sums to transfer
- ICANN adopts the UDRP in 1999 on the basis of WIPO recommendations (First WIPO Internet Domain Name Process)

### ICANN adopted UDRP in 1999

- ICANN is the "Internet Corporation for the Assignment of Names and Numbers"
  - Governing body for the internet
  - Derives authority from the United States Department of Commerce
- ICANN acts through "registries" and "registrars" that distribute domain names.
  - ICANN has contracts with the registries and registrars
  - These contracts require
    - Warranties/Covenants not to violate law or IP rights
    - Consent to dispute resolution under the UDRP



#### **UDRP** Overview

- Administrative proceeding
  - based on consent in domain name registration agreement
  - international IP experts as panelists
- Limited focus and remedy: transfer of domain name
  - No money damages
- Solves
  - the jurisdiction problem
  - the anonymity problem
- Inexpensive, compared to litigation.
- Fast: Start to finish in 75-90 days.



### UDRP does not supplant National Courts

- Submission to jurisdiction for follow-on litigation
- UDRP decision not take effect if either party files a lawsuit within 10 days.
- Court challenges extremely rare
  - More than 10,000 UDRP decisions involving United States respondents
  - Less than 25 reported cases in US involve prior UDRP decisions

# UDRP– Bright Line Criteria Trademark holder must prove

- identity or confusing similarity between Trademark and domain name
- lack of registrant rights or legitimate interests in domain name
- registration and use of domain name in bad faith

## UDRP design elements

- Uniform And Universal Application
  - All "Top Level Domains"--. Com, .Net, .Org, Etc.
  - Many Country Code" TLDs- .CO, .MW, .PW
- Fast and Fixed Timeline
  - 20 Days To Respond
  - 14 Days To Decide
  - Total Time: 75-90 Days
- Limited Remedies
  - Transfer, cancellation
  - No damages
- Court Option Maintained
  - Court Challenge Of Results

- Complainant Pays
  - Lump-sum Fees
- Respondent's language
- Legal Representation Not Required
  - "Jurisprudential Overview"
- Single Round Of Pleadings
- Paperless; all proceedings digital
- Posted Decisions

WIPO Center's ccTLD program: <a href="http://www.wipo.int/amc/en/domains/cctld/">http://www.wipo.int/amc/en/domains/cctld/</a>





#### UDRP cases at WIPO

- Total number UDRP-based cases since 1999
  - More than 33,000 cases
  - More than 60,000 domain names
- Country code Top-Level Domains account for 14% of 2015 case load so far
- In 2015 (mid November):
  - Parties from 111 countries
  - Most filers: US, France, Germany, UK, Switzerland
  - More than 300 panelists from 51 countries



#### However

- The UDRP may only be brought by a trademark holder
  - Namely, no domain names identical or confusingly similar to a trademark
- If domain name does not relate to a trademark, then no UDRP
- What we need is a UDRP-like remedy for illegal activity other than domain name infringements
- This presentation advocates such a plan

## Legal Foundation for Extending the UDRP

Registrants already agree to more than mere compliance with UDRP

### The key regulatory asset

- All domain names begin with a contract
- The Registrar MUST require that domain names not be used for illegal activity
- Typical domain name registration agreements typically require broad warranties and covenants not to engage in any unlawful activity

# ICANN Registration Accreditation Agreement Para. 3.7.7.9

 Registered Name Holders shall represent that "neither the registration of the Registered Name nor the manner in which it is directly or indirectly used infringes the legal rights of any third party."

# A typical domain name registration agreement. See Fabulous.com

- To abide by UDRP
- The domain name nor the manner in which it is "used, directly or indirectly, infringes the intellectual property rights or other legal rights of any third party..."
- Used in a way that is "invades another person's privacy or property rights or otherwise in breach of a duty owed to a third party."
- "Infringes the registered trademark, copyright or patent rights of a third party"

- "violates any applicable local, state, national or international law or regulation"
- "Promotes, is involved in or assists in, the conduct of illegal activity of any kind..."
- Registrar may suspend, cancel, transfer domain name if it is "being used for or in connection with Misleading Activity or an Illegal Activity..."





#### Also learn from the DMCA Model

#### DMCA Procedure:

- Copyright owner sends notice to ISP
- ISP takes accused page down "expeditiously" (1 or 2 days)
- If Webpage owner responds with "Counter notice" the page must be restored within 14 days
  - Copyright owner must file lawsuit
  - ISP immune

## DMCA Model Adopted in Many Countries

- 18 countries have notice-takedown models similar to DMCA:
  - Australia, Peoples Republic of China, El Salvador, Finland, France, Germany, Hungary, India, Italy, Japan, Malaysia, Mongolia, New Zealand, Singapore, South Africa, South Korea, Spain, and UK
- Template for similar defenses in European Union
- Over a million takedown notices to Google alone
- Counter notices in only 0.020% of the United States cases.

Daniel Seng, The State of the Discordant Union: An Empirical Analysis of DMCA Takedown Notices, 18 Va. J. L. & Tech. 369, \*37 (2014), <a href="http://papers.ssrn.com/sol3/papers.cfm?abstract\_id=2411915">http://papers.ssrn.com/sol3/papers.cfm?abstract\_id=2411915</a>.

### How might extended UDRP work?

#### Two steps before Court option:

- Step 1: Modeled on DMCA's "Notice and Takedown":
  - Trademark owner gives notice of trademark violation to intermediary (ISP / registrar / registry?)
  - Confusingly similar domain name not required for standing or remedy
  - Confusingly similar content required
  - Opportunity for page owner to give counter notice
  - If no counter notice, page taken down
- Step 2: Modeled on UDRP
  - If a counter-notice is submitted, the mark owner may commence a UDRP-like proceeding
  - Transfer, suspension or cancellation only remedy
- Court option follows

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### Implementation?

- Advocate that ICANN extend the UDRP
  - Not likely without pressure or in response to liability risk
- Alternatively,
  - ccTLDs
  - ISPs, registrars
  - National legislation
  - Judicial imposition of liability on intermediaries
    - This is the stimulus to accepting procedures
    - Registrar's typically passive, even hostile, to regulation.

#### Summary

- UDRP has successfully addressed trademark infringement in domain names
- But problems are bigger than domain names
- Key regulatory asset: all domain names start with a contract
- We have successful models
  - UDRP-fast, fair administrative-dispute resolution-before resort to national court
  - DMCA-notice and take down
- Implement outside ICANN

