

INSURING CONSISTENCY WITHIN THE WIPO'S UDRP DECISIONS ON DOMAIN NAMES LITIGATIONS

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Abstract

The paper presents the need of insuring consistency within the domain name litigations starting with the adoption of the UDRP as a mean to insure uniform dispute resolution and continuing with the creation and application of the different practical instruments of insuring consistency identified and used by the few providers of UDRP services. The paper shall focus on the UDRP's application by the WIPO Mediation and Arbitration Center and the consistency issues under UDRP, by analyzing the working instruments of insuring this consistency at the level of Administrative Panel's decision and how these instruments are thought within the UDRP WIPO's practice. Further the paper shall analyze the correspondence between the independence of the Administrative Panel and the consistency issues and shall conclude on the need to insure consistency as a prerequisite for predictability and stability of the domain names dispute resolution.

Keywords: UDRP, practice, consistency, methods, Administrative Panel

Introduction

Since its creation by ICANN¹ in 1999, the Uniform Dispute Resolution Policy (further called UDRP) have become a constant alternative dispute resolution for the solving the disputes in connection with the domain names. The scope of the UDRP is limited to the abusive registration of the domain names with the infringement of third parties trademarks rights. According to the UDRP, in case that an infringement of the trademark rights occurs by the registration of a domain name, the trademark holder may ask, based on UDRP: the transfer or cancelation of the disputed domain name. The Administrative Panel appointed by the UDRP providers based on a UDRP complaint, shall grant the request for transfer or cancelation if three conditions are cumulatively fulfilled: the disputed domain name is similar or identical with a trademark in which the complainant has rights, the respondent has no rights or legitimate interests in the disputed domain name and the disputed domain name had been registered and used in bad faith.

The UDRP had been thought as an instrument universally applicable for the trademark infringements by an abusive registration of a domain name. Such universality was meant, considering the universality of the internet virtual space, from different legal perspectives, namely the UDRP provisions have no national law reference, the lists of Panelists available on domain names dispute resolution providers websites contain reputable specialists in intellectual property all over the world, therefore with different backgrounds corresponding to different law systems, the Rules for UDRP (further called as "the Rules" as the UDRP itself do not include national law reference and the

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¹ ICANN stands for Internet Corporation for Assigned Names and Numbers. ICANN was formed in 1998 as a not-for-profit public-benefit corporation with participants from all over the world dedicated to keeping the Internet secure, stable and interoperable. It promotes competition and develops policy on the Internet's unique identifiers. Through its coordination role of the Internet's naming system, it does have an important impact on the expansion and evolution of the Internet. Following WIPO conducted consultation process on domain names including the dispute resolution and the recommendation of WIPO for the institution of a policy to be followed uniformly by all registrars in the .com, net, and .org TLDs, ICANN approves on 24th of October the UDRP and the implementation documentation. WIPO becomes the first provider of UDRP. For more details see information available at <http://www.icann.org/en/udrp/udrp-schedule.htm>

Supplemental Rules adopted by each dispute resolutions services providers² do not make more national specific the application of the UDRP. Therefore, the universality of the UDRP has to be supported also by a consistency in application of the said rules so no fundamentally contradictory decisions would rise at least from the application of the UDRP, the Rules and Supplemental Rules as applied firstly from different national law perspectives and secondly based on each Administrative Panel's personal understanding perspective of the UDRP.

The need for consistency in the UDRP practice appears not only in the application of the UDRP by each international provider but also from the perspective of general UDRP practice at the level of the four international existing UDRP providers.

The consistent UDRP application has a strong relevance also considering the provisions of paragraph 4 j³ from UDRP which provides for the availability of Court procedures, before or after the administrative proceedings initiated by the domain name holder takes place. The initiation of the recourse to the Court proceeding, after the UDRP proceedings, suspend the implementation of the UDRP decision by the Registrar until the Registrar receives (i) evidence satisfactory to it of a resolution between the parties; (ii) evidence satisfactory to it that the domain name holder lawsuit has been dismissed or withdrawn; or (iii) a copy of an order from such court dismissing the domain holder lawsuit or ordering that the unsatisfied party do not have the right to continue to use the disputed domain name. In other words, the holder of the domain name unsatisfied with the UDRP decision has the possibility to address the Court of competent jurisdiction for an independent dispute resolution from the UDRP application.

Moreover, the need and scope of consistency is determined, as in any dispute resolution practice, either ADR or judicial, by the need of predictability of the UDRP practice.

This article shall analyze the need and scope for consistency within the UDRP practice of first approved by ICANN of the four international providers of domain disputes resolution – the WIPO Center for Mediation and Arbitration, the practical implementation instruments initiated by the said provider to assist the UDRP practice itself in building its consistency, while comparing with the others providers implementation and focusing on the internal as well as external determinations and effects of such consistency.

² Complaints under the Uniform Dispute Resolution Policy may be submitted to any approved dispute-resolution service provider as approved by ICANN. The list of approved providers by ICANN at February 20th, 2011 available at the internet address: <http://www.icann.org/en/dndr/udrp/approved-providers.htm>,

Asian Domain Name Dispute Resolution Centre, Dispute Proceedings/Decisions:; https://www.adndrc.org/hk/case_decision.php

National Arbitration Forum, Dispute Proceedings/Decisions: <http://domains.adrforum.com/decision.aspx>

WIPO, Dispute Proceedings/Decisions: <http://www.wipo.int/amc/en/domains/search/index.html>

The Czech Arbitration Court Arbitration Center for Internet Disputes, Dispute Proceedings/Decisions: <http://www.adr.eu/adr/decisions/index.php>

³ According to paragraph 4 letter j from **UDRP**: “*The mandatory administrative proceeding requirements set forth in Paragraph 4 shall not prevent either you or the complainant from submitting the dispute to a court of competent jurisdiction for independent resolution before such mandatory administrative proceeding is commenced or after such proceeding is concluded. If an Administrative Administrative Panel decides that your domain name registration should be canceled or transferred, we will wait ten (10) business days (as observed in the location of our principal office) after we are informed by the applicable Provider of the Administrative Administrative Panel's decision before implementing that decision. We will then implement the decision unless we have received from you during that ten (10) business day period official documentation (such as a copy of a complaint, file-stamped by the clerk of the court) that you have commenced a lawsuit against the complainant in a jurisdiction to which the complainant has submitted under Paragraph 3(b)(xiii) of the Rules of Procedure. (In general, that jurisdiction is either the location of our principal office or of your address as shown in our Whois database. See Paragraphs 1 and 3(b)(xiii) of the Rules of Procedure for details.) If we receive such documentation within the ten (10) business day period, we will not implement the Administrative Administrative Panel's decision, and we will take no further action, until we receive (i) evidence satisfactory to us of a resolution between the parties; (ii) evidence satisfactory to us that your lawsuit has been dismissed or withdrawn; or (iii) a copy of an order from such court dismissing your lawsuit or ordering that you do not have the right to continue to use your domain name*”

The consistency subject is of utmost importance within the UDRP practice as it is in general within the ADR and judicial practice, as consistency represents the basis of creation of confidence and stability in the dispute resolution. Moreover the consistency implementation instruments created by the domain dispute resolution providers may serve, despite of being determined by specific causes as the generally common regulations of the trademark rights and by the universality of internet, as a good model which adapted would be able to be function also within the national legal orders.

1. Legal framework

The legal framework shall consider the UDRP, the Rules and the Supplementary Rules adopted by the WIPO Mediation and Arbitration Center in respect to the domain name dispute resolution as well as the practice of the Administrative Panels under the UDRP within the Center.

2. Consistency created by UDRP practice itself

The UDRP, the Rules and the Supplemental Rules adopted by the WIPO Mediation and Arbitration Center provide any express requirement for consistency.

The UDRP represents a common body of substantive and procedural rule rules.

In addition to UDRP, the Rules and the Supplemental Rules provide for the procedural framework in which the UDRP cases are considered by the WIPO Mediation and Administrative Center.

The UDRP had been thought as a hybrid mediation/arbitration scheme⁴⁵ operated primarily by private entities based on a contract – the Registration Agreement- concluded among the parties responsible for the registration of the domain name: the registrant, the registrar and ICANN. The contractual nature of the UDRP supplemented by ICANN with the Rules and further by each dispute resolution providers with the Supplemental Rules created a significant freedom of appreciation by the Administrative Panel of the domain names disputes.

In this sense, the UDRP provides at paragraph 10 the general powers of the Administrative Panel, which instructs the Administrative Panel to

- conduct the administrative proceeding in such manner as it considers appropriate in accordance with the Policy and these Rules.
- to treat and ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case.
- to determine the admissibility, relevance, materiality and weight of the evidence.

Moreover, according to paragraph 15 letter a from UDRP, the Administrative Panel shall decide a request under a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable. Such freedom of appreciation provided for the Administrative Panel by the UDRP may be considered to create apparently the premises for inherent inconsistency among the UDRP decisions.

The determinations of such inherent inconsistency are related to the universal character of the UDRP together with a flexible wording of the UDRP, the globalization of the trademarks and the last but not the least to the freedom of legal appreciation that an UDRP Administrative Panel has in deciding an UDRP case. While UDRP creates substantive rules based on which an Administrative Panel has to decide the transfer or cancelation of a disputed domain name namely the identity or similarity between the disputed domain name with a trademark, the lack of the rights or legitimate interest of the disputed domain name holder, the registration and use in bad faith of the disputed domain name, the universal character of the UDRP leads to the application of such substantive rules

⁴ For more details see David W. Maher, *The UDRP: The Globalization of Trademark Rights*, IIC, *The International Review of Intellectual Property and Copyrights Law*, Max Planck Institute for Intellectual Property, Competition and Tax Law, Vol. 33, 8/20, pp 924 -948, ©Verlag, CH Beck, oHG, Munich available at the internet address: <http://dmaher.org/Publications/globaliz.pdf>.

in connection with two different determinations: the national law background of the trademarks registration and the national law background of the Administrative Panel which resolve the domain name dispute. Such determination cannot be avoided despite the universal UDRP application and universality of the internet virtual space. Apparently, there is no room for creating a consistent UDRP practice under the said determinations. Moreover, the lack of any consistency requirements under the UDRP, the Rules and the Supplemental Rules may weaken the chances for a coherent consistent UDRP practice within the same dispute resolution provider. An example of the flexibility of the UDRP language which would encourage inconsistency is the provisions at paragraph 11 – language of proceedings – letter , which states that “*unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Administrative Panel to determine otherwise, having regard to the circumstances of the administrative proceeding*”. It is evident that the rule of having the administrative proceedings conducted in the language of the Registration Agreement has different exceptions which give the Administrative Panel the freedom and flexibility to decide in any way based on the circumstance of cases even against the rule.

While, internally, within each UDRP dispute resolution providers there is no rule providing for consistency, externally the existence of four different UDRP dispute resolution providers may worsen the situation, as no specific instrument contractually provided requires the insurance of UDRP decisions consistency among the decisions issued by the different providers.

The UDRP, the Rules and the WIPO Supplemental Rules present the flexibility and a reduced formalism specific to ADR which makes the ADR preferable to the judicial dispute resolution.

As presented, the administrative proceedings under UDRP contain all the internal and external determination possible to result in an inconsistent practice.

In spite of such determinations, consistency had been initiated through the UDRP practice itself. It cannot be denied that an important body of Administrative Panelists on WIPO Administrative Panelists list⁶ came from the common law systems which value the precedent as a source of law. This body of Administrative Panelists marked the UDRP practice and initiated the consistency practice. Moreover the need for predictability and stability in their own legal systems became more and more important in the Administrative Panelists⁷ with German Law background and contributed to a convergence of opinion in continuation of the trend of the consistency within the UDRP practice.

It was the UDRP Administrative Panels that considered that UDRP should not be a roulette wheel⁸; that they should aim for a high degree of consistency (which is the basis for predictability).

From the WIPO case, 3636275 Canada, dba eResolution v. eResolution.com, D2000-0110⁹, the WIPO UDRP decisions had initiated and valued the precedent considering that “*The jurisprudence which is being rapidly developed by a wide variety of Panelists world-wide under the ICANN Policy provides a fruitful source of precedent*”. In the case, Time Inc. v. Chip Cooper¹⁰, D2000-1342, which decided the transfer of the disputed domain names “lifemagazine.com”, “lifemagazine net”, lifemagazine.org”, the Administrative Panels went further and has underlined the consistency which imposes itself from the need of predictability and stability of the UDRP practice: “*The majority believes that the UDRP procedure should be governed by the rule of law, rather than*

⁶ The WIPO Domain Names Administrative Panelists list is available at the internet address: http://www.wipo.int/amc/en/domains/Administrative_Panel.html

⁷ The European Human Rights Court

⁸ See information available at the internet address: <http://udrpcommentaries.wordpress.com/2010/09/30/predictability-and-consistency-in-application-of-udrp-jurisprudence/>

⁹ The decision is available at the internet address: <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0110.html>

¹⁰ The decision is available at the internet address: <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-1342.html>

by the individual consciences of the Administrative Panelists. If a principle enunciated in a decision is well-reasoned and repeatedly adopted by other Panels, the majority believes that absent compelling reasons which require a determination otherwise, the rule established should be respected. The majority believes that potential users of the UDRP are entitled to some degree of predictability. Counseling one who is considering filing a Complaint should consist of more than, "It depends what Administrative Panelist you draw."

Nowadays, the consistency is also valued in the UDRP jurisprudence as an act of control in the case, *Pantaloon Retail India Limited v. RareNames, WebReg*¹¹, D2010-0587 (WIPO June 21, 2010), the Administrative Panel considered that: *"There is a substantial consensus among Administrative Panelists that the acquisition and offering for sale of domain names and/or using them to provide links to other sites may well (provided it is not directed at trademark misuse in breach of the Policy) be a legitimate business, a business engaged in not only by Respondent but by other operators who acquire and "warehouse" domain names which they think others might consider valuable. Whether that consensus is justified may be a matter for debate, but in the opinion of the Administrative Panel there is a strong body of precedent which, though not binding, is strongly persuasive"*.

The UDRP practice serves as a good example of the self-imposed limitations of the Policy dictating the judgments under the UDRP.

Self building of such role by the UDRP WIPO practice determined the administrative management of the WIPO Mediation and Arbitration Center to identify, in consultation with the Administrative Panelists and develop instruments to ease the application and following up of the consistency. In this sense the Center developed chronologically in this order the full on line posting of all decisions at <http://www.wipo.int/amc/en/domains/decisions.html>, Center's online Legal Index of WIPO UDRP Administrative Panel Decisions at the address: <http://www.wipo.int/amc/en/domains/search/>, Search WIPO Cases and WIPO Decisions at address: <http://www.wipo.int/amc/en/domains/search/>, the WIPO overview of WIPO Administrative Panel Views on Selected UDRP Questions at the address: <http://www.wipo.int/amc/en/domains/search/overview/index.html> and finally the Selection of UDRP related cases at the address: <http://www.wipo.int/amc/en/domains/challenged/>. These instruments represent equally the framework and the means to insure the persuasive body of precedent necessary to maximize consistency within the WIPO UDRP practice.

4. WIPO consistency implementation instruments

Self building consistency within the WIPO UDRP practice has been facilitated and increased by the implementation instruments analyzed below. It is necessary to note that all these instruments may be used in supplementing each other with the final purpose to enhance predictability and stability within the WIPO UDRP practice through consistency.

4.1. The posting of all WIPO decisions

The Center provides for the online posting of all WIPO decisions. The Decisions are organized and posted per years with the indication of the case number.

4.2. Index of WIPO UDRP administrative panel decisions

The index of WIPO UDRP Administrative Panel Decisions represents a valuable instrument useful in the UDRP practice equally to the Administrative Panelist but also to the dispute parties. The index offers identifications on two main categories of all the WIPO UDRP decisions: decided WIPO Cases by domain names categories and a legal index. The Legal Index contains also supplementary

¹¹ The decision is available at the internet address: <http://www.wipo.int/amc/en/domains/decisions/text/2010/d2010-0587.html>

an identification of the WIPO decision considering legal categories under UDRP as the legal categories under UDRP substance or UDRP procedure.

4.3. Search WIPO cases and decisions engine

The search WIPO cases and decisions instrument creates several search engine which facilitates the identification of an WIPO decisions considering criteria as full text search on WIPO Administrative Panel Decisions, search WIPO Cases by Domain Name, or search by named complainant or by the named respondent.

4.3. WIPO overview of WIPO administrative panel views on selected UDRP questions

One of the most useful instruments in assisting equally the Administrative Panelists and UDRP applicants in the consistent application of the UDRP is the WIPO overview of Administrative Panel views on selected UDRP questions. While for the Administrative Panelists the WIPO overview is a mean to identify the majority Administrative Panel views on legal issues which commonly arise, in the interpretation and application of the UDRP for the latter is a mean to stability and predictability of this practice. The WIPO overview is deemed to be an informal overview of Administrative Panel positions on what is considered to be key procedural and substantial issues.

According to the information available at the address <http://www.wipo.int/amc/en/domains/search/overview/index.html>, the WIPO Overview uses questions and implies and evaluation of opinions based on the 7,000 UDRP cases the WIPO Mediation and Arbitration Center has administered through February 2005.

This instrument is clearly stated as having a non binding nature, as it is the nature of prior Administrative Panels decisions. Each Administrative Panel is free to make its judgment in the particular circumstances of each individual proceeding and each case party is responsible for making its own independent assessment of decisions relevant to its case.

4.3. Selection of UDRP related cases

As mentioned above consistency implementation instruments serves building consistency among the UDRP decisions based on the persuasive although non - binding nature of the UDRP precedent. In addition the Center created a further instrument, this time external for creating the consistency through the posting of selection of UDRP related cases in the national Courts. The effects of such selection of related UDRP cases represents an useful instrument to consider the UDRP decisions from the perspective of the external effects of such decision in case of Court challenge under the national jurisdiction

5. Other UDRP CONSISTENCY IMPLEMENTATION INSTRUMENTS

Other UDRP providers offer to their UDRP Administrative Panels data base of all cases under their administration with specific search engines which facilitates the identification of the decision. National Arbitration Forum is going even further in assisting the Administrative Panels in their work for building the consistency and supplements the Administrative Panel appointed in an UDRP case with a memo with the possible legal standings on the three cumulative conditions for the transfer or cancelation of disputed domain name according to the specific elements of the case. The memo is drafted by the National Arbitration Forum and documents the eventual legal standing on prior UDRP Administrative Panel decisions. It has to be noted that the National Arbitration Forum memos are always documented not only on the NAF UDRP Administrative Panels decisions but also on decisions adopted by the UDRP Administrative Panels under all the domain name disputes resolution providers. As in WIPO case, neither the prior NAF Administrative Panels' decisions nor the memos are binding for a Administrative Panel appointed in a domain name dispute.

6. The need for consistency and the independence of the Administrative Panel

The Rules contain at paragraph 7, express provisions regarding the impartiality and independence of the Administrative Panels solving the domain name disputes, and the mandatory disclosure of any circumstance giving rise to the justifiable doubts as to such impartiality and independence.

While the matter of independence has generally the meaning of absence of any bias deriving from direct prior activities of the Panelist appointed, a question arises also as to the biasing nature of the self built consistency within UDRP practice. May any one say that the self stated consistency need, the persuasive nature of the precedent may be considered a bias to the appointed panelist? Could a panelist be kept by the body of precedent in taking the decision under UDRP?

The instruments presented above are clearly stated as having a non binding nature. Finally it is the UDRP, the Rules and The Supplemental Rules which governs the adoption of the UDRP decision by the Panel, and they do not impose consistency and offer enough flexible wording to allow the Panel to decide even against the acknowledged UDRP practice if the circumstances of the case and his understanding of the case represent the basis of solid line of reasoning. This is ultimately the beauty of the UDRP which allows for the building of an extensive UDRP practice enriched with the valuable national law systems diversity.

7. Conclusions

Drawing conclusions on the consistency within UDRP practice, it s worth to underline that in spite the lack of specific rules for insuring consistency, the practice itself built such consistency from a natural need for stability and predictability. It was the merit of the UDRP services providers to identify and develop the necessary practical instruments for assisting the Administrative Panel in further building consistency with the UDRP practice, while leaving the legal creativity of the panelists to add value to the different questions of interpretation and application of UDRP.

There is a lot to learn from the model initiated by WIPO as an UDRP provider for encouraging the consistency. While developed for the specific circumstances of the trademark rights globalization under UDRP, the WIPO model could be adapted and used for the implementation of consistency at national level.

References

- David W. Maher, The UDRP: The Globalization of Trademark Rights, IIC, The International Review of Intellectual Property and Copyrights Law, Max Planck Institute for Intellectual Property, Competition and Tax Law, Vol. 33, 8/20 (<http://dmaher.org/Publications/globaliz.pdf>).
- <http://udrpcommentaries.wordpress.com/2010/09/30/predictability-and-consistency-in-application-of-udrp-jurisprudence/>
- <http://www.wipo.int/amc/en/domains/search/overview/index.html>