

COMPARATIVE CASE STUDY ON ALTERNATIVE RESOLUTION SYSTEMS FOR DOMAIN NAME DISPUTES



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TABLE OF CONTENTS

1	EXECUTIVE SUMMARY	5
2	GENERAL BACKGROUND	8
3	METHODOLOGY.....	9
4	OVERVIEW OF DISPUTE RESOLUTION POLICIES	11
	The UDRP	11
	.AU (.auDRP)	16
	.DK (Danish Domain Name Board)	18
	.EU (euADR)	20
	.IT (Modified UDRP)	23
	.UK (Nominet Dispute Resolution Service (DRS))	25
	.CN (CNDRP)	28
	.JP (JP-DRP).....	30
	.US (usDRP).....	31
	.NL (Modified UDRP).....	33
	SUMMARY STATISTICS.....	35
5	DOMAIN NAME DISPUTE CASE SCENARIOS	37
	INTRODUCTION	37
	SCENARIO #1: REGISTRATION OF DOMAIN NAME IN GOOD FAITH WITH SUBSEQUENT BAD FAITH USE.....	39
	SCENARIO #2: RESELLERS AND IMPORTERS.....	41
	SCENARIO #3: FORMER BUSINESS PARTNER	43
	SCENARIO #4: TRIBUTE SITE.....	44
	SCENARIO #5: CRITICISM SITE.....	45
	SCENARIO #6: GENERIC TERM.....	46
	SCENARIO #7: NON-IDENTICAL TERM.....	48
	SCENARIO #8: PERSONAL NAME.....	49

	SCENARIO #9: CITY, COUNTY OR COUNTRY NAMES	50
	SCENARIO #10: OFFICIAL WEBSITES (GOVERNMENTS, INSTITUTIONS, NGOs etc.)...	52
	SCENARIO #11: SITES THAT INFRINGE INTELLECTUAL PROPERTY RIGHTS SUCH AS TRADE MARKS AND COPYRIGHTS, OR THROUGH WHICH ITEMS THAT INFRINGE INTELLECTUAL PROPERTY RIGHTS, SUCH AS TRADE MARKS OR COPYRIGHTS, ARE OFFERED FOR SALE	54
	CASE SCENARIO COMPARISONS	55
6	SOURCES AND ACKNOWLEDGEMENTS	56
7	GLOSSARY OF TERMS, ABBREVIATIONS AND CONVERSIONS	58

1 EXECUTIVE SUMMARY

While the internet has provided trade mark holders with previously unimaginable access to markets and consumers around the world, the risk of falling victim to intellectual property infringement and other types of fraud has also proliferated online. Trade marks are particularly susceptible to infringement on the web because they can, amongst other reasons, be incorporated into a domain name as text with relative ease, which may lead to an array of abusive domain name registration and/or use practices.

As internet usage began to rise in the late 1990s, internet stakeholders and legislators became increasingly aware of these risks. However, while national courts were used to enforce trade mark rights as such, the borderless and multijurisdictional characteristics of the internet combined with traditionally time-consuming and often costly cross-border litigation processes involved, created problems for efficient enforcement of intellectual property rights against abusive domain name registrations. It was for these reasons that the World Intellectual Property Organization (WIPO) established the Uniform Domain Name Dispute Resolution Policy (UDRP) for the resolution of disputes arising from the registration of internet domain names. In late 1999 the Internet Corporation for Assigned Names and Numbers (ICANN), the organisation responsible for coordinating the maintenance and procedures of the namespaces and numerical spaces of the internet, adopted WIPO's recommendations and implemented the UDRP for all gTLD registrations.

Beyond assisting brand owners in addressing abuse of their trade marks online without the need for costly court proceedings and minimising the burden on national courts, it is also worth pointing out that online dispute resolution such as the UDRP are perceived to facilitate global e-commerce, and that protecting brands online not only helps mitigate consumer confusion and related harms, but also helps to provide a stable platform for economic growth.

Today, all generic top-level domains¹ (gTLDs), including new gTLDs² apply the UDRP to resolve disputes. However, while many country-code top-level domains (ccTLDs)³ also utilise the UDRP, other ccTLDs have opted to either adopt a modified version of the UDRP to accommodate differences in the country's legal code or to create a bespoke Dispute Resolution Policy (DRP) that may function differently to the UDRP. The existence of these different DRPs and the resulting varying rules and policies require specialised knowledge without which there may be confusion amongst intellectual property rights holders as to some of the unique aspects of such DRPs (thus presenting a challenge from a resources point of view).

This study, titled 'Comparative Case Study on Alternative Resolution Systems for Domain Name Disputes', has been commissioned by the EUIPO's European Observatory on Infringements of Intellectual Property Rights (the Observatory) to compare the likely outcomes of 10 selected DRPs (including the UDRP⁴) for 11 pre-defined case scenarios (disputes). The objective of the study, performed with the input from expert panellists in the respective DRPs, was to identify key points of similarity and difference in possible outcomes and to compare and contrast the key characteristics of each DRP such as procedures, fees, durations and case statistics.

¹ Categories of top-level domains (TLDs) maintained by the Internet Assigned Numbers Authority (IANA). The so-called core group of gTLDs consists of the .com, .info, .net, and .org domains.

² Currently amounting to some 1 200 domains (e.g. .top, .loan, .xyz, etc.).

³ Generally used or reserved for a country, sovereign state, or dependent territory identified with a country code (e.g. .uk, .es, .us, etc.).

⁴ The selected DRPs, in brackets [], and associated ccTLDs or gTLDs are: 1) All gTLDs and new gTLDs (e.g. .com, .org, .net, etc.) [UDRP]; 2) .au [auDRP]; 3) .dk [Danish Domain Name Board]; 4) .eu [euADR]; 5) .it [PRSD, Modified UDRP]; 6) .uk [Nominet DRS]; 7) .cn [CNDRP]; 8) .jp [JP-DRP]; 9) .us [usDRP]; 10) .nl [Modified UDRP].

A large number of UDRP and ccTLD-variant cases were considered in total. The study provides a summary table in a dedicated section that provides statistical data on cases that were ruled in favour of the complainant, in favour of the respondent, terminated before a decision was made and other outcomes (e.g. domain is cancelled, fee not paid, invalid complaint). Furthermore, a large amount of data, provided by expert panellists in all of the DRPs, were collected and analysed for the case comparisons. Each case scenario has its own dedicated section within this report.

The study has concluded that with the exception of the Danish Domain Complaints Board (.dk), the DRPs assessed are substantially similar to the UDRP⁵. In fact, some of the DRPs analysed are identical to the UDRP except for a few alterations that are either to align the process to the country's underlying legal code or to include an initial mandatory mediation phase⁶. JP-DRP (.jp), for example, expands the basis for initiating a domain dispute from 'trademarks and service marks' to 'trademark or other indication [*sic*]' to accommodate the narrow definition of trade marks defined under the Japanese Trademark Act.

Therefore, with the exception of the Danish Domain Complaints Board (.dk), the likely outcomes for the eleven theoretical case scenarios were substantially similar across the different DRPs assessed. Despite this, there are a number of key points of divergence between the DRPs:

- Nominet (.uk), .nl and .it, all modified versions of the UDRP, allow for a mediation stage, which provides the opportunity for both the complainant and respondent to resolve a dispute before the panel stage, if both parties are willing. This mediation stage accounts for a reasonable portion of resolved disputes before a case formally commences. For .uk disputes for example, nearly 10 % of total complaints are resolved this way.
- There is some divergence in the requirements for a decision against a respondent⁷. For instance, the UDRP requires the complainant to prove bad faith at the time of registration and as to use (typically at the time of the complaint). In practice this would mean that a domain holder who registers a domain in good faith, but subsequently utilises the domain in bad faith will normally still prevail against a complainant. However, most other DRPs state that it is sufficient to prove that either registration or use of the domain name is in bad faith.
- Furthermore, the three cumulative requirements of the UDRP that a complainant must prove for a decision against a respondent [(i) that the domain name is identical or confusingly similar to the trade mark or service mark, and ii) respondent has no rights or legitimate interests in the domain name and iii) the domain name has been registered and is being used in bad faith)] are not present in euADR (.eu). Instead the euADR states that a complainant must demonstrate why the disputed domain name is identical or confusingly similar to the trade mark or relevant identifier and, **either**: why the disputed domain name has been registered by its holder without rights or legitimate interests **or** why the disputed domain name should be considered as having been registered or being used in bad faith.
- As regards the rights covered, while several DRPs, including the UDRP, tend to consider the protection of trade marks and service marks, other DRPs, including euADR and .nl, both modified versions of the UDRP, consider rights to extend to other areas such as geographical indications or

⁵ The Danish Domain Complaints Board policy draws from three lines in the Danish Act on Internet Domains, which states that 'registrants may not register and use internet domain names in violation of good domain name practice' and 'registrants may not register and maintain registrations of internet domain names solely for resale or rental purposes'. No other guidance is provided.

⁶ Refer to .nl Modified UDRP and .it Modified UDRP.

⁷ The UDRP employs a three-stage test that a complainant must prove when making a complaint against a respondent: i) domain name is identical or confusingly similar to trade mark, ii) respondent has no rights or legitimate interests in respect of the domain name and iii) the domain name has been registered and/or is being used in bad faith.

designations of origin as well as unregistered trade marks, trade names, business identifiers, company names, surnames, and distinctive titles of protected literary and artistic works.

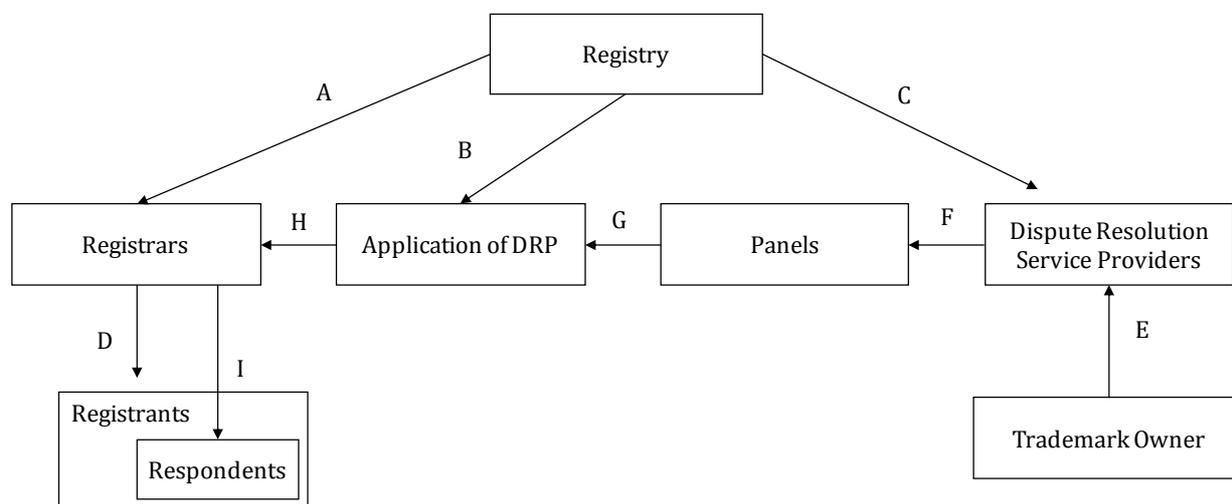
These sometimes subtle divergences may impact both the overall procedure for the respondent and complainant and the approach that panellists take when deciding on a case. Indeed, in some instances they can lead to different case outcomes, e.g. when it comes to standing to file a complaint, or the differences in cumulative requirements to rule against a respondent.

The results of this study should provide more clarity for IP rights holders, domain name stakeholders and policy makers.

2 GENERAL BACKGROUND

Domain names are one of the most common business identifiers for companies and trade mark holders. It is therefore desirable for rights holders to have a domain name that closely approximates their trade mark or trademarked products in order to exercise their trade mark rights⁸.

A company or rights holder wishing to acquire a domain name must apply through a domain accredited registrar. For gTLDs, only ICANN accredited registrars⁹ can register domain names with the domain name registry (e.g. Verisign for .com, Public Interest Registry for .org, etc.). For ccTLDs, registrars are accredited by the domain registries themselves (e.g. the registry for .uk is Nominet, for .nl it is the SIDN, for .dk it is DK Hostmaster). If a rights holder finds that the domain name corresponding to their trade mark has been registered illegitimately by someone else, they can initiate a DRP via an accredited Dispute Resolution Service Provider (DRSP). At the same time, it is important to bear in mind that other businesses active in other areas of goods or services and/or in other jurisdictions may have a legitimate claim to such domain name. The basic structural features of a DRP are provided in the Figure below, with arrows showing the relationships between the various entities¹⁰.



A: Accreditation of registrars by registry (or ICANN, in the case of gTLDs)

B: Adoption of DRP (either UDRP, Modified UDRP or bespoke DRP) by registry

C: In the case of ccTLDs: accreditation of DRSPs by registry

D: Application of DRP on registrants by registrars (through registry contract terms with registrar)

E: Filing of complaint and selection of DRSP by trade mark owners (now referred to as ‘complainants’)

F: Appointment of panel(s) to cases by DRSPs

G: Application of DRP to cases by panels

H: Imposition of panels’ decisions on registrars

I: Execution of DRP remedies against respondents by registrars via registry (if applicable).

⁸ For instance, a 2016 report for the EUIPO on ‘Intellectual Property, SME Scoreboard’ found that internet domain names were one of the top three measures that SMEs report as being important for a company’s ability to derive competitive advantage from their innovative activities. Furthermore, the report found that internet domain names are the single most important kind of protection measure for all SMEs regardless of size.

⁹ For gTLDs, there are 2 466 ICANN-accredited registrars.

¹⁰ Graphic has been modified from Online Dispute Resolution — The Phenomenon of the UDRP, Melbourne Legal Studies Research Paper No 681, Andrew Christie, p. 11.

3 METHODOLOGY

The DRPs selected for the analysis and comparison in this study, in brackets [], and associated ccTLDs or gTLDs are as follows¹¹:

1. all legacy gTLDs and new gTLDs (e.g. .com, .org, .net, etc.) [UDRP]
2. .au [auDRP] (Modified UDRP)
3. .dk [Danish Domain Name Board]
4. .eu [euADR] (Modified UDRP)
5. .it [PRSD] (Modified UDRP)
6. .uk [Nominet DRS] (Modified UDRP)
7. .cn [CNDRP] (Modified UDRP)
8. .jp [JP-DRP]
9. .us [usDRP] (Modified UDRP)
10. .nl (Modified UDRP).

The table below provides a description of the case scenarios under review.

#	SCENARIO	EXAMPLE
1	Registration of domain name in good faith with subsequent bad faith use.	An initial fan page that over time comes to sell competing products.
2	Circumstances under which resellers/importers are allowed to use a third-party domain.	An importer of a product registers a ccTLD domain with the same name as the manufacturer's global website.
3	Consideration of former business partner's interests.	A party registers a domain incorporating a former partner's name without the consent of that former partner.
4	Treatment of tribute sites.	A fan site domain that is not owned or operated by the person the site refers to.
5	Treatment of criticism sites.	An organisation registers a website that is used to criticise a competing brand.
6	Treatment of possibly generic terms.	A domain is registered using a term that is generic in some countries, but not in others.
7	Treatment of non-identical terms (i.e. slight variations of terms such as misspellings, use of plural, differing use of punctuation, etc., and the extent necessary for such variations to be considered non-infringing).	A domain that is registered that contains an intentional minor misspelling of a well-known brand name as a means of selling competing products.
8	Treatment of personal names.	A domain name that relates to the owner's surname, that coincides with a trade mark.
9	Treatment of city, county or country names.	A domain name that includes country abbreviations combined with new gTLDs such as 'de.travel' instead of 'travel.de'.

¹¹ .cx had initially been shortlisted at the beginning of the project but was dropped for lack of data and primary sources.

10	Treatment of official websites (governments, Institutions, NGO's, etc.).	A domain name that incorporates the use of the name of a governmental organisation, where there is no official link to that organisation.
11	Treatment of websites that infringe intellectual property rights (such as trade marks and copyrights), or through which items that infringe intellectual property rights, such as trade marks or copyrights, are offered for sale.	A domain that does not infringe any trade mark or copyrights in itself, but items offered for sale through the website do.

The study consulted both primary and secondary sources to develop the findings. Firstly, expert panellists drawn from the public lists of DRPs were engaged to discern decision criteria for each case scenario. Data on each scenario was collected by means of a questionnaire, which experts filled out according to the DRP of their expertise. Further telephone discussions and email correspondence was also conducted where necessary for clarification. For each of the case scenarios, experts provided their input on the following areas.

- Approach employed by the panel.
- Key factors to consider.
- Under what conditions would the DRP decide in favour of the domain holder?
- Under what conditions would the DRP decide against the domain holder?
- What proportion of similar applicable cases has been decided in favour of the domain holder?
- What are the landmark cases that define precedent in such cases?
- Under what circumstances would a case of this nature be referred to the court system?
- Sources and links.

In addition to the case scenarios, the study also took a thorough look at each DRP and identified points of similarity and difference. The following areas were covered through a combination of primary and secondary research for the abovementioned dispute resolution policies:

- registration requirements for domain names;
- description of the systems, including dispute procedure, costs, presentation of evidence, fast track, etc.;
- statistics, such as number of cases and lengths of proceedings.

Case statistics, with the exception of two DRSPs for the UDRP, were publicly accessible either via the DRPs themselves or the domain registries. Case decisions converged on four decision categories, which are presented in this report for each DRP: Accepted/Transfer, Denied, Termination and Other. Decisions that are categorised as Accepted/Transfer denote cases ruled in favour of the complainant and as a result the domain name was transferred to the complainant. Cases that are denoted as Denied are where the respondent prevailed. Cases that were Terminated could be either a case that was resolved via facilitated mediation or settlement between the parties themselves before the panel could make a decision, or that the case was terminated by the complainant for another reason. The Other category refers to cases that did not reach a decision for other reasons, mostly administrative errors on behalf of the complainant (e.g. not paying the fee) or other invalid submission material. These data sets, along with the total number of cases filed for each DRP, were recorded for the time period 2015-2017 and can be found in the following chapter.

4 OVERVIEW OF DISPUTE RESOLUTION POLICIES

The UDRP

BACKGROUND

The UDRP was developed by WIPO and adopted by ICANN in late 1999 to provide a solution to the challenges that traditional offline court-based legal processes faced in dealing with unprecedented volumes of trade mark-related domain name abuse¹². Today, the UDRP is utilised for all gTLD¹³ disputes and a large number of ccTLDs. The UDRP also applies to new gTLDs, which currently amount to some 1 200 domains¹⁴.

Domain names in gTLDs may be registered with one of over 2 000 ICANN-accredited registrars, or their resellers¹⁵. A domain name registrant enters into an agreement with the registrar, which, further to establishing the UDRP as the agreed procedure for domain dispute resolutions, states that the registrant agrees not to engage in or facilitate illegal activity via the domain name. Registrars, for their part, must at least establish and maintain a dedicated abuse point of contact, including a dedicated email address and telephone number that is monitored 24 hours a day, 7 days a week, to receive reports of illegal activity¹⁶.

KEY FACTS

Governing Rules: Rules for the UDRP¹⁷.

Administrative Panel: A panel is appointed by the DRSP to rule on a domain name dispute. Panellists are sourced from the provider's publicly available list of panellists and are experienced practitioners in the areas of intellectual property law, electronic commerce and the internet¹⁸. Each provider publishes the list of panellists and their qualifications.

DRSPs: Available DRSPs are the Arab Centre for Domain Name Dispute Resolution (ACDR), the Asian Domain Name Dispute Resolution Centre (ADNDRC), the Czech Arbitration Court (CAC) — Arbitration Center for Internet Disputes, the National Arbitration Forum (NAF) and the WIPO Arbitration and Mediation Center. A complainant can select any one of these DRSPs to resolve their dispute, regardless of location or geography.

Complaint Filing Requirements: Any person or entity may initiate an administrative proceeding by submitting a complaint to any of the providers listed above for all gTLDs. The complaint must specify the trade mark(s) on which the complaint is based and describe in particular (1) the manner in which the

¹² Online Dispute Resolution — The Phenomenon of the UDRP, Melbourne Legal Studies Research Paper No 681, Andrew Christie.

¹³ The main gTLDs are .com, .org, .net, .int, .edu and .gov

¹⁴ <https://archive.icann.org/en/tlds/> (last visited November 2018);

<https://newgtlds.icann.org/en/about/program/materials> (last visited November, 2018);

<https://newgtlds.icann.org/en/program-status/statistics> (last visited November 2018).

¹⁵ <https://www.icann.org/registrar-reports/accredited-list.html> (last visited November 2018).

¹⁶ <https://www.icann.org/resources/pages/approved-with-specs-2013-09-17-en> (last visited November 2018).

¹⁷ The UDRP Rules can be found at <https://www.icann.org/resources/pages/udrp-rules-2015-03-11-en>

¹⁸ It is the complainant who initially elects to have the dispute decided by either a single-member or a three-member panel. In the event complainant elects a three-member panel, the complainant must provide the names and contact details of three candidates to serve as one of the panellists (drawn from any ICANN-approved provider's list of panellists). If the complainant elects a single-member panel, the respondent can then elect to have the dispute decided by a three-member panel. If either complainant or respondent elects a three-member panel, the respondent must provide the names and contact details of three candidates to serve as one of the panellists. Most UDRP proceedings are conducted with one-member panels (95 %).

domain name(s) is/are identical or confusingly similar to a trade mark or service mark in which the complainant has rights; (2) why the respondent should be considered as having no rights or legitimate interests in respect of the domain name(s); and (3) why the domain name(s) should be considered as having been registered and being used in bad faith.

Timeframe: A domain name dispute filed through the UDRP usually takes around 60 days, with a maximum timeframe of 75 days¹⁹.

Possibilities to Appeal: the UDRP contains no internal appeal mechanism. Parties who wish to do so may, however, pursue the matter in court. However, this option is only available within the UDRP framework if official documentation (such as a copy of a complaint, file-stamped by the clerk of the court) is provided within 10 business days of the decision being communicated to the parties. If this documentation is not provided then the decision will be carried out. If the registrar receives the documentation within the 10 business day period, they will not implement the panel's decision, and they will take no further action, until they receive either (i) satisfactory evidence that a resolution between the parties has been reached; (ii) satisfactory evidence that the lawsuit has been dismissed or withdrawn; or (iii) a copy of an order from such court dismissing the lawsuit. Nothing, however, prevents either party from seeking judicial redress outside the UDRP context.

DISPUTE PROCEDURE

There are five basic stages of a UDRP administrative procedure:

- filing of a complaint with an ICANN-accredited dispute resolution service provider chosen by the complainant, such as the WIPO Arbitration and Mediation Center;
- filing of a response (or a default) by the person or entity against whom the complaint was made;
- appointment by the chosen dispute resolution service provider of an administrative panel of one or three persons who will decide the dispute;
- issuance of the administrative panel's decision and the notification of all relevant parties; and
- submission by registrar to registry for the imposition of the panel's decision should there be a decision that the domain name(s) in question be cancelled or transferred.

The core underpinnings of the UDRP (paragraph 4²⁰) states that the complainant must prove that each of the following three elements are present in the complaint being filed:

- (i) the domain name is identical or confusingly similar to a trade mark or service mark in which the complainant has rights; and
- (ii) the respondent 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.

The UDRP also establishes guidance on when the requirements for ii) and iii) above are satisfied, such as²¹:

- circumstances indicating that the respondent has registered the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trade mark or service mark or to a competitor of that

¹⁹ <http://www.wipo.int/amc/en/domains/guide/#b1> (last visited November 2018).

²⁰ <https://www.icann.org/resources/pages/policy-2012-02-25-en#4b> (last visited November 2018).

²¹ <https://www.icann.org/resources/pages/policy-2012-02-25-en#4b> (last visited November 2018).

complainant, for a value in excess of documented out-of-pocket costs directly related to the domain name; or

- the respondent has registered the domain name in order to prevent the owner of the trade mark or service mark from reflecting the mark in a corresponding domain name; or
- the domain name was registered primarily for the purpose of disrupting the business of a competitor; or
- by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, internet users by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on their website or location.

Paragraph 4c of the UDRP also establishes that a respondent can demonstrate its rights and legitimate interest in a particular domain name by proving 'use of, or demonstrable preparations to use, the domain name in connection with a bona fide offering of goods or services', or that the individual or organisation has been commonly known by the domain name, even if no trade mark or service mark rights have been acquired, or 'if the respondent is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue'²². Moreover, noting in particular the global nature of the internet, the jurisdiction(s) where the trade mark is valid is not considered relevant to panel assessment²³.

Paragraph 10 of the UDRP — General Powers of the Panel — lays out the powers of the panellists in a UDRP dispute as follows²⁴:

- (a) 'The panel shall conduct the administrative proceeding in such manner as it considers appropriate in accordance with the Policy and these Rules.
- (b) In all cases, the panel shall ensure that the parties are treated with equality and that each party is given a fair opportunity to present its case.
- (c) The panel shall ensure that the administrative proceeding takes place with due expedition. It may, at the request of a Party or on its own motion, extend, in exceptional cases, a period of time fixed by these rules or by the panel.
- (d) The panel shall determine the admissibility, relevance, materiality and weight of the evidence.
- (e) A panel shall decide a request by a party to consolidate multiple domain name disputes in accordance with the Policy and these Rules.'

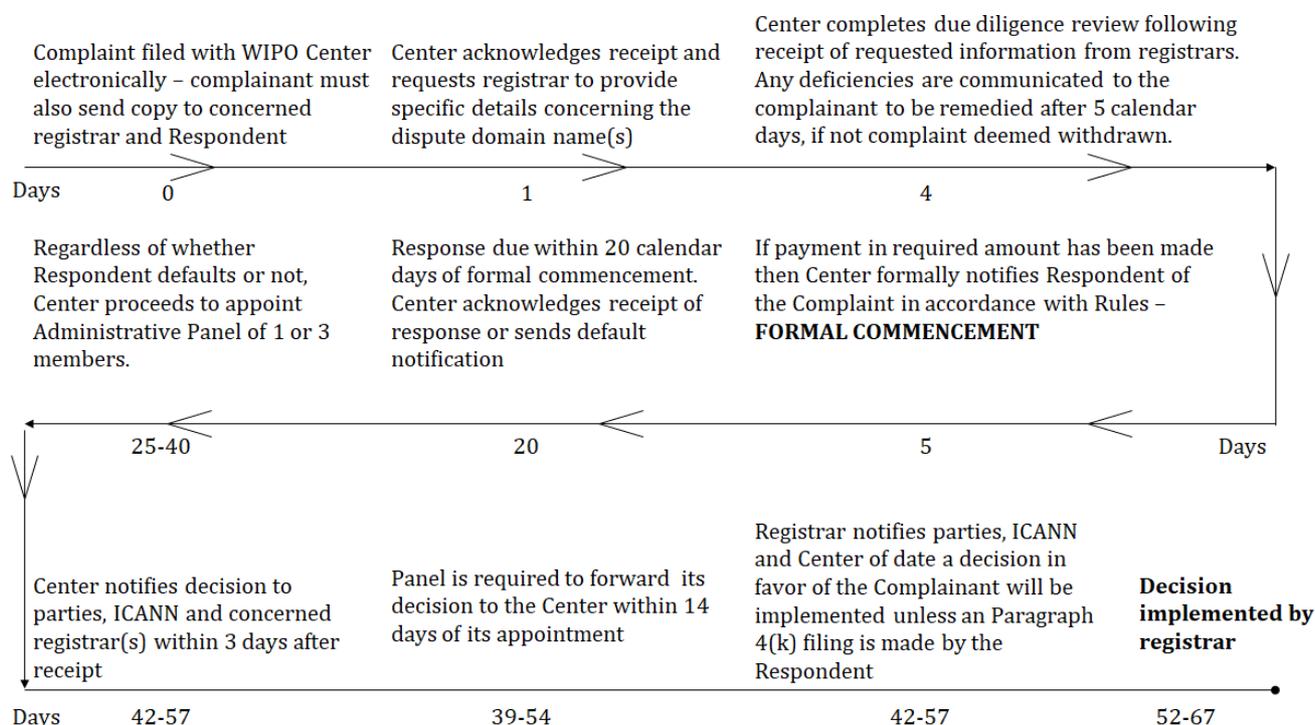
A process flow diagram is provided on the following page to provide a visual illustration of a typical UDRP process flow as executed by the WIPO Arbitration and Mediation Center.

²² <https://www.icann.org/resources/pages/policy-2012-02-25-en#4b> (last visited November 2018).

²³ <http://www.wipo.int/amc/en/domains/search/overview3.0/#item1> (last visited November 2018).

²⁴ <https://www.icann.org/resources/pages/udrp-rules-2015-03-11-en> (last visited November 2018).

The Uniform Domain Name Dispute Resolution Procedure Process Flow²⁵



FEES²⁶

For WIPO cases where one panellist is required, the typical fees are USD 1 500 (EUR 1 293), which is split USD 1 000 (EUR 862) for the panellist and USD 500 (EUR 431) for WIPO as an administrative fee²⁷. For larger cases involving more than 10 domain names, the fees increase on a sliding scale. Where three panellists have been requested, the typical fees are USD 4 000 (EUR 3 448), which is split between presiding panellist USD 1 500 (EUR 1 293), two co-panellists USD 750 (EUR 646) and WIPO's administrative fee USD 1 000 (EUR 862).

The ACDR fee structure is virtually identical to WIPO.

ADNDRC fees for one panellist are USD 1 300 (EUR 1 120), which is split USD 700 (EUR 603) for the panellist and USD 600 (EUR 517) for ADNDRC as an administrative fee. Again, these fees could be higher if more than 10 domain names are included in the complaint²⁸. Where three panellists have been requested, the fees are USD 2 800 (EUR 2 413), which is split between presiding panellist USD 1 000 (EUR 862), two co-panellists USD 600 (EUR 517) and an ADNDRC fee USD 600 (EUR 517). These fees could be higher if more than 10 domain names are included in the complaint²⁹.

²⁵ Adapted from <http://www.wipo.int/export/sites/www/amc/en/docs/UDRPflowchart.pdf> (last visited November 2018).

²⁶ <http://www.wipo.int/amc/en/domains/fees/> (last visited November 2018).

²⁷ Cost ranges are triggered by the number of domain names included in the complaint. Most cases only have 1-2 domains included. The WIPO fees and breakdowns can be viewed here <http://www.wipo.int/amc/en/domains/fees/> (last visited November 2018).

²⁸ This appears to be a rare incurrence for all domain disputes. Complaints are normally for 1 or 2 domain names.

²⁹ <https://www.adndrc.org/mtsc/bjen/udrp1.php?st=3#fee> (last visited November 2018).

The CAC³⁰ charges between EUR 800 and EUR 1 100 for a single panellist for 1 to 10 disputed domains. Fees for three panellists range between EUR 2 600 and EUR 3 200. However, the CAC also has separate additional fees of EUR 300 to EUR 400 for each complaint once the respondent has responded to the statements and allegations contained in the complaint.

The NAF charges between EUR 1 120 and EUR 1 550 for a single panellist for 1 to 10 disputed domains. Fees for three panellists range between EUR 2 240 and EUR 3 100³¹.

Generally, in the event of the withdrawal of a complaint or termination of an administrative proceeding prior to the appointment of a panel, the DRSP will withhold a processing or administrative fee³² while the remainder is returned to the respective parties.

STATISTICS

WIPO processed over 3 000 domain name disputes in 2017 and 93 % of all decided cases were decided in favour of the complainant in that year³³. The CAC processed 201 cases in 2017, with 186 case decisions (92 %) being accepted in favour of the complainant³⁴. The NAF on the other hand processed 1 390 cases in 2017 with a similar acceptance for complainants (93 %). Statistics data for the ACDR and the ADNDRC was unavailable at the time of writing the report³⁵.

DISPUTE RESOLUTION PROVIDER (GTLDS ONLY)	2015					2016					2017				
	Cases	Transfers	Denied	Terminated	Other	Cases	Transfers	Denied	Terminated	Other	Cases	Transfers	Denied	Terminated	Other
ACDR	N/A	N/A	N/A	N/A	N/A	N/A	N/A	N/A	N/A	N/A	N/A	N/A	N/A	N/A	N/A
ADNDRC	N/A	N/A	N/A	N/A	N/A	N/A	N/A	N/A	N/A	N/A	N/A	N/A	N/A	N/A	N/A
CAC	96	82	11	0	3	97	88	9	0	0	201	186	14	N/A	1
NAF	1 267	1 138	123	2	4	1 181	1 075	100	2	4	1 390	1 294	88	5	3
WIPO	2 754	1 943	183	575	53	3 036	2 253	185	541	57	3 074	2 331	167	535	41

³⁰ http://udrp.adr.eu/arbitration_platform/fees.php (last visited November 2018).

³¹ <http://www.adrforum.com/UDRPFees> (last visited November 2018).

³² Amounts or percentages are not mentioned by the DRSPs themselves but it could be as high as 50 % of the total fees.

³³ <http://www.wipo.int/amc/en/domains/statistics/> (last visited July 2018).

³⁴ Please note that the total figure does not include cases that are terminated before a panel has been assembled.

³⁵ For this study, several attempts were made to contact both organisations. The ADNDRC has a statistics section on their website but the data is either incomplete or inaccessible.

NOTES³⁶

- The NAF data is from the decision date, whereas the CAC and WIPO data is from filing date of the complaint itself. This could lead to minor discrepancies in annual data because a complaint filed in December 2016 would likely appear under the 2016 column for WIPO and the CAC but will likely appear in the 2017 for the NAF because the decision would have been made in that year.

.AU (.auDRP)

BACKGROUND

.AU domain names are managed by au Domain Administration Ltd (auDA). .AU domain names are restricted to Australian registrants (either as companies operating in the country or citizens or residents, in the case of id.au)³⁷. There are over 3 million .au registrations with roughly 40 certified registrars for the .au domain³⁸. Within the .au domain, there are several different second-level domains (2LDs), each with their own eligibility and allocation rules. It is not possible to register domain names directly under .au³⁹. Generally, 2LDs are utilised for specific purposes, as described below:

- asn.au: for incorporated associations, political parties, trade unions, sporting and special interest clubs;
- com.au: for commercial entities, such as companies (with ACN as registered through ASIC), and businesses (registered with state governments);
- net.au: for commercial entities, such as companies (with ACN as registered through ASIC), and businesses (registered with state governments);
- id.au: for individuals who are Australian citizens or residents;
- org.au: for charities and non-profit organisations.

KEY FACTS

Governing Rules: auDRP Rules⁴⁰ administered by auDA and based on the UDRP.

Administrative Panel: Same as UDRP. Each auDRP provider is wholly responsible for the appointment of its listed panellists.

DRSP: WIPO and the Resolution Institute (Australian arbitration and dispute resolution services firm).

Complaint Filing Requirements: Same as UDRP, although complainants must meet the eligibility and allocation rules for .AU described above.

³⁶ As set out in the Chapter on Methodology, the categories are divided into Accepted/Transfer, Denied, Termination and Other. Decisions that are categorised as Accepted/Transfer denote cases ruled in favour of the complainant and as a result the domain name was transferred to the complainant. Cases that are denoted as Denied are where the respondent prevailed. Cases that were Terminated could be either a case that was resolved via facilitated mediation or settled between the parties themselves before the panel could make a decision, or that the case was terminated by the complainant for another reason. The Other category refers to cases that did not reach a decision for other reasons, mostly administrative errors on behalf of the complainant (e.g. not paying the fee) or other invalid submission material.

³⁷ <https://www.auda.org.au/policies/index-of-published-policies/2012/2012-05/> (last visited November 2018).

³⁸ <https://www.auda.org.au/industry-information/registrars/> (last visited November 2018).

³⁹ <https://www.auda.org.au/policies/index-of-published-policies/2012/2012-04/> (last visited November 2018).

⁴⁰ <https://www.auda.org.au/assets/pdf/auda-2016-01.pdf> (last visited November 2018).

Timeframe: The average auDRP proceeding takes 45 days⁴¹.

Possibilities to Appeal: Same as UDRP. Panel decisions under auDRP are binding on both parties. There is no appeal mechanism. Filing court proceedings are subject to the same time limits as UDRP.

DISPUTE PROCEDURE

The auDRP is modelled on UDRP and is virtually identical with the exception of the following two differences⁴²:

- rights covered — the auDRP applies to domain names that are identical or confusingly similar, not only to a trade mark or service mark, but to any 'name' in which the complainant has rights, including the complainant's company, business or other legal or trading name, as registered with the relevant Australian government authority; or the complainant's personal name;
- bad faith — it is sufficient to prove that either registration or use of the domain name by the registrant is in bad faith, whereas the UDRP requires the complainant to prove both.

In very broad terms, the steps involved in an auDRP do not differ from the UDRP, and are presented as follows:

1. complaint is filed with an approved DRSP;
2. DRSP reviews the complaint to ensure that it complies with the policy, and then forwards the complaint to the respondent;
3. the respondent files a response (within 20 days);
4. DRSP appoints the panel (which can consist of either one or three panellists);
5. the panel reviews the complaint and the response, and forwards its decision to the DRSP (usually within 14 days);
6. DRSP delivers the full text of the decision to each party, and publishes the decision on the website;
7. registrar submits decision to registry to impose decision (if relevant).

FEES

WIPO and Resolution Institutes' fees are very similar. The filing fee to commence a proceeding under the auDRP is AUD 2 000 (EUR 1 273) in the case of a one-member panel and AUD 4 500 (EUR 2 866) in the case of a three-member panel⁴³. The fee will be higher if more than five domain names are being disputed, however, this is also a rare occurrence.

STATISTICS

In 2017, a total of 55 matters were lodged between WIPO and the Resolution Institute. Out of these cases, 38 were found in favour of the complainant, 6 in favour of the respondent, 11 withdrawn or terminated before decision⁴⁴.

⁴¹ <https://www.auda.org.au/pdf/auda-audrp-2007.pdf> (last visited November 2018).

⁴² <http://www.wipo.int/amc/en/domains/cctld/au/index.html> (last visited November 2018).

⁴³ <http://epiphany.law/articles/domain-names/audrp-faqs> (accessed November 2018).

<http://www.wipo.int/amc/en/domains/fees/cctlds/au/index.html> (accessed November 2018).

⁴⁴ <https://www.auda.org.au/assets/Annual-Reports/2016-17-auDA-Annual-Report.pdf>

DRSP	2015					2016					2017				
	Cases	Transfers	Denied	Terminated	Other	Cases	Transfers	Denied	Terminated	Other	Cases	Transfers	Denied	Terminated	Other
RESOLUTION INSTITUTE	12	3	6	3	0	8	5	1	1	0	13	10	2	1	0
WIPO	39	24	6	9	0	52	33	4	14	1	42	28	4	10	0

.DK (Danish Domain Name Board)

BACKGROUND

.DK domain names are managed by DK Hostmaster (owned by Dansk Internet Forum, DIFO)⁴⁵. There are 1.3 million registered .dk domain names and there are over 200 registrars licensed by DK Hostmaster to resell .dk domain names⁴⁶. While the eligibility criteria for registrants is rather straightforward, DK Hostmaster reserves the right to suspend a domain name if illegal activity is suspected⁴⁷.

KEY FACTS

Governing Rules: Regulations of the Complaints Board for Domain Names and Rules of Procedure⁴⁸. An important distinction between the .dk dispute resolution system and the UDRP and other DRPs is that .dk complainants can invoke Danish law in general as legal grounds, meaning that complaints are not restricted to bad faith registration and/or use.

Administrative Panel: The Danish Complaints Board for Domain Names (Complaints Board) handles all domain name disputes. The Complaints Board comprises one chairperson and one vice-chairperson who must be judges, two members with theoretical and practical expertise in law as well as two members representing consumer and commercial interests, respectively. Substitutes for each of the two members with expertise in law and for the consumer and commercial representatives have also been appointed⁴⁹.

DRSP: The Danish Complaints Board for Domain Names.

and <http://www.wipo.int/amc/en/domains/search/domain.jsp> (last visited November 2018).

⁴⁵ DIFO has overall responsibility for the top-level domain '.dk'. The Danish Ministry of Industry, Business and Financial Affairs has appointed DIFO as the association responsible for administering the .dk domain. DIFO was founded on 1 July 1999 with the sole purpose of assuming administration of the top-level domain '.dk'. DK Hostmaster A/S is DIFO's subsidiary company, and administers all .dk domain names and ensures the operation of the Danish internet infrastructure. DIFO owns DK Hostmaster and defines the framework for its activities.

⁴⁶ <https://www.dk-hostmaster.dk/en/domain-name-administration> (last visited November 2018).

⁴⁷ <https://www.dk-hostmaster.dk/en/terms> (last visited November 2018).

⁴⁸ <https://www.domaeneklager.dk/sites/default/files/2017-08/Regulations%202017.pdf> and <https://www.domaeneklager.dk/sites/default/files/2017-08/RULES%20OF%20PROCEDURE%202017%20-%20ENG.pdf> (last visited November 2018).

⁴⁹ For instance, the current Chairperson is Kaspar Linkis, High Court Judge and Vice-Chairperson is Jacob Waage, Judge, please refer to <https://www.domaeneklager.dk/en/node/406> (last visited November 2018).

Complaint Filing Requirements: Any person or entity may file a complaint. The chairperson of the Complaints Board decides whether the complainant has sufficient interest.

Timeframe: 60-70 days

Possibilities to Appeal: No appeal mechanism. Cases can only be reopened if special reasons so warrant at the Complaints Board's discretion including, for instance, lawful absence of a party who has not expressed his or her opinion in the case, or new information which — had it been available during the hearing of the case by the Complaints Board — would presumably have resulted in a different outcome of the case⁵⁰. Moreover, the Complaints Board's decision does not prevent either party from submitting a complaint to the Board on a new basis concerning the same domain name.

Furthermore, the Board does not have the authority to refer a case to the court system. Each party may bring the decision of the Board to the competent court within 8 weeks from the date of the decision. Such cases will be brought against the other party to the proceeding and not the Board.

DISPUTE PROCEDURE

As regards the overall process, .dk represents the most significant deviation from the UDRP. It is the outlier of this DRP analysis because the policy is not founded on the three cumulative requirements found in the UDRP and the majority of other DRPs.

Cases are ruled according to the Act on Domain Names, which stipulates in Article 5 that 'registrants may not register and use domain names in violation of good domain name practice ..., (and) registrants may not register and maintain domain name registrations solely for resale or rental purposes⁵¹.' The decision based on this criterion is left to the Complaints Board itself. In the Complaints Board's handling of cases, the chairperson or the vice-chairperson will take part as well as the two members with expertise in law. In cases involving non-commercial use of domain names and in cases of fundamental importance, the representatives for consumer and commercial interests will also take part.

The secretariat presents the complaint to the respondent with a request to present a statement (defence) as soon as possible and at the latest 2 weeks from receipt of the complaint. The respondent's comments must then be presented to the complainant for a statement with a corresponding response deadline. The complainant's response is presented to the respondent in the same way. If it is obvious that the respondent's reply and the complainant's response do not contain new information or assessments and that each party is thus undoubtedly aware of their contents, the secretariat need not present the reply to either party.

FEES

The complainant must pay a fee for the hearing of a complaint before the Complaints Board. The complaint fee is DKK 160 (EUR 21.5) where the disputed domain name is specified for non-commercial activities. In all other cases, the complaint fee is DKK 500 (EUR 67). If the complaint concerns several

⁵⁰ Furthermore, the Danish Domain Name Board (the Board) does not have the authority to refer a case to the court system. According to § 30,2 of the Domain Name Act each party may bring the decision of the Board to the competent court within 8 weeks from the date of the decision. Such cases will be brought against the other party to the proceeding and not the Board.

⁵¹ <https://www.retsinformation.dk/Forms/R0710.aspx?id=161869>, English translation, (last visited November 2018).

domain names, a fee is paid for each individual domain name. The Complaints Board does not charge any other fees for hearing the case.

If the Complaints Board allows the complainant’s claim in full or in part or if the case is settled on terms in this respect, the complaint fee is refunded to the complainant. The same applies if a complaint is withdrawn before the Complaints Board has made a decision in the case.

STATISTICS

Around 200 cases are filed per year to the Complaints Board with around 50 % of cases being ruled in favour of the complainant⁵².

DRSP	2015					2016					2017				
	Cases	Transfers	Denied	Terminated	Other	Cases	Transfers	Denied	Terminated	Other	Cases	Transfers	Denied	Terminated	Other
DANISH COMPLAINTS BOARD FOR DOMAIN NAMES	207	89	75	28	15	169	82	61	18	8	248	99	63	9	77

.EU (euADR)

BACKGROUND

EURid is the registry of the .eu (or ею in Cyrillic script) ccTLD. Introduced in 2005, there are now around 4 million registered .eu domains⁵³. Any company, individual or organisation based in the European Union or in Iceland, Liechtenstein or Norway can register a .eu or .ею domain name⁵⁴. There are around 700 accredited registrars that can register domains for registrants.

KEY FACTS

Governing Rules: .eu Alternative Dispute Resolution Rules (the ‘ADR Rules’)⁵⁵.

Administrative Panel: Same as UDRP. A panel is appointed by the dispute resolution provider to rule on a domain name dispute. Panellists are sourced from the provider’s publicly available list of panellists

⁵² <https://www.domaeneklager.dk/sites/default/files/2018-02/Klagenaevnets%20arsberetning%202017%20-%20ENDELIG.pdf> (last visited November 2018).

⁵³ 3.82 million in 2017, <https://eurid.eu/en/about-us/> (last visited November 2018).

⁵⁴ To register a .EU domain name, an applicant must: i) have its registered office, central administration or principal place of business within the European Union, Norway, Iceland or Liechtenstein; or ii) be an organisation established within the European Union, Norway, Iceland or Liechtenstein without prejudice to the application of national law; or iii) be a natural person resident within the European Union, Norway, Iceland or Liechtenstein.

⁵⁵ https://eurid.eu/d/97230/ADRRules_EN.pdf (last visited July 2018).

and are experienced practitioners in the areas of intellectual property law, electronic commerce and the internet.

DRSPs: The CAC and WIPO.

Complaint Filing Requirements: Any person or entity registered or residing within the European Union, Iceland, Liechtenstein or Norway may initiate an administrative proceeding by submitting a complaint to any of the providers listed above. The slight difference to the UDRP is the complainant has to specify why the domain name is identical or confusingly similar to the domain name(s) of which a right or rights are recognised or established by national and/or and, **either** why the domain name has been registered by its holder without rights or legitimate interests or why the domain name should be considered as having been registered or being used in bad faith.

Timeframe: A domain name dispute filed through euADR usually takes around 60-75 days.

Possibilities to Appeal: Decisions of panellists are final and not subject to appeal⁵⁶. However, should a complainant or registrant initiate court proceedings within 30 days of the decision being communicated then the registry will not implement the panel's decision until the matter has been satisfactorily resolved.

DISPUTE PROCEDURE

euADR is founded by the following European legislation:

- Regulation (EC) No 733/2002 of the European Parliament and of the Council of 22 April 2002 on the implementation of the .eu Top Level Domain (TLD)⁵⁷, and
- Regulation (EC) No 874/2004 of 28 April 2004 laying down public policy rules concerning the implementation and functions of the .eu TLD and principles governing registration⁵⁸.

While the structure of euADR is substantially similar to the UDRP, there are five key differences to note:

- whereas the UDRP is limited to the protection of trade mark rights, euADR Rules aim to protect not only trade mark rights, but also certain other rights protected in Europe such as geographical indications or designations of origin, and, in as far as they are protected under national law in the Member State where they are held: unregistered trade marks, trade names, business identifiers, company names, surnames, and distinctive titles of protected literary and artistic works;

⁵⁶ Neither panels nor dispute resolution providers have the authority to formally refer a case to the national court system. However, as with the UDRP, if a panel concludes that a given case contains complex factual issues or is outside the scope of the DRP it may issue a denial of the complaint and suggest, in the decision, that the case would be better decided in a court setting. This typically happens where the fact issues or external legal claims may impact the rights or defences of the parties in the case as they relate to the disputed domain name (e.g. questions of contract law, employment, etc.). In this regard, courts can adjudicate a greater range of legal claims and may offer the parties greater opportunities to develop the factual record of the case if discovery and witness examination are available.

⁵⁷ https://eurid.eu/media/filer_public/11/df/11dff973-2b59-42ee-8fe3-4bc699052c99/733_2002_en_1.pdf (last visited July 2018).

⁵⁸ https://eurid.eu/media/filer_public/4f/cf/4fcfff7a-b24c-4de4-9bb4-eac3026921df/874_2004_en_0.pdf (last visited July 2018).

- under the euADR Rules, it is sufficient to prove that either registration or subsequent use of the domain name by the registrant occurred in bad faith, whereas the UDRP requires the complainant to prove both elements;
- furthermore, while the UDRP sets three cumulative requirements, under ADR a complainant needs to demonstrate why the challenged domain name is identical or confusingly similar to the name or names in respect of which a right or rights are recognised or established by national and/or Community law and, **either** why the challenged domain name has been registered by its holder without rights or legitimate interests in respect of the domain name that is the subject of the Complaint; **or** why the challenged domain name should be considered as having been registered or being used in bad faith;
- the language of euADR proceedings must be one of the official EU languages. Unless otherwise agreed by the parties or specified otherwise in the registration agreement between the domain holder and the registrar, the language of the euADR proceeding will be the language of the registration agreement for the disputed domain name⁵⁹;
- there are also some timing differences, which make euADR cases slightly longer than the UDRP. For instance, whereas under the UDRP a panel has 14 days from its appointment to forward its decision to the dispute resolution provider, under euADR Rules, the panel has 1 month for submitting its decision.

FEES

WIPO

The complainant pays the dispute resolution provider. Costs for a single panellist range from EUR 1 300 to EUR 1 600 depending on the number of domains being contested. Three panellists will range from EUR 3 100 to EUR 4 000 depending on the number of domains being contested. However, as of 01/01/2018 EURid has arranged to temporarily subsidise EUR 1 000 toward the standard filing fee for each .eu domain name dispute filed with the WIPO Arbitration and Mediation Center meaning that this amount must be discounted from the official amount.

The CAC

Costs for a single panellist range from EUR 1 300 to EUR 1 600 depending on the number of domains being contested. Three panellists will range from EUR 3 100 to EUR 4 000 depending on the number of domains being contested. Furthermore, as of 01/01/2018 EURid has arranged to temporarily subsidise EUR 1 000 toward the standard filing fee for each .eu domain name dispute filed with the CAC.

STATISTICS

In 2017, 46 cases were filed with the CAC and 13 with WIPO⁶⁰.

⁵⁹ https://eu.adr.eu/html/en/adr/adr_rules/eu%20adr%20rules.pdf (last visited July 2018).

⁶⁰ http://www.wipo.int/amc/en/domains/statistics/cctlds_yr.jsp?year=2017, (last visited November 2018).
https://eu.adr.eu/adr/disputed_domain_names/index.php?order_by=filing_date&dir=DESC&page=3 (last visited July 2018).

DRSP	2015					2016					2017				
	Cases	Transfers	Denied	Terminated	Other	Cases	Transfers	Denied	Terminated	Other	Cases	Transfers	Denied	Terminated	Other
WIPO	N/A	N/A	N/A	N/A	N/A	N/A	N/A	N/A	N/A	N/A	13	7	0	4	2
CAC	50	46	4	0	0	57	48	9	0	0	46	40	6	0	0

.IT (Modified UDRP)

BACKGROUND

The .it domain name is managed by Registro.it and has over 3 million registered domain names. There are over 1 200 licensed registrars. The registration of a domain name in the ccTLD .it is permitted only to persons who have citizenship, residence or a registered office in the EU, Republic of San Marino, Switzerland and the Vatican⁶¹. However, many registrants address these regulations by contracting 'Trustee Services'.

KEY FACTS

Governing Rules: Dispute Resolution Rules for .it domain⁶² and Legal Guidelines⁶³.

Administrative Panel: Same as UDRP. A panel is appointed by the dispute resolution provider to rule on a domain name dispute. Panellists are sourced from the provider's publicly available list of panellists and are experienced practitioners in the areas of intellectual property law, electronic commerce and the internet. Each provider publishes a list of panellists and their qualifications.

DRSP: CRDD (Centro Risoluzione Dispute Domini), MFSD⁶⁴, Tonucci & Partners⁶⁵, Camera Arbitrale Nazionale e Internazionale di Milano and ADR Company⁶⁶.

Complaint Filing Requirements: Same as UDRP. Any person or entity may initiate an administrative proceeding by submitting a complaint to any of the providers listed above⁶⁷. There is no reference in either the Rules or Legal Guidelines to restrictions for parties that do not meet the eligibility criteria described above.

⁶¹ <http://www.nic.it/en/faq#t127n81932> (last visited November 2018).

⁶² https://www.nic.it/sites/default/files/docs/Dispute_Resolution_v2.1.pdf (last visited November 2018).

⁶³ https://www.nic.it/sites/default/files/docs/Dispute_Resolution_Guidelines_v3.1.pdf (last visited July 2018).

⁶⁴ The name is an acronym of the founders' surnames, http://www.mfsd.it/mfs_presentazione.php?lang_set=en_UK (last visited November 2018).

⁶⁵ Arbitration Firm, www.tonucci.com

⁶⁶ Listed on nic.it website but link to page is broken, <http://www.adrcompany.it/> (last visited September 2018).

⁶⁷ When trustee services are used, the trustee service reviews the registration request to prevent trade mark infringement and reduce the number of disputes or legal issues. It is not clear who would legally be considered the 'registrant' in this case, but it seems to be common practice (and legitimated by registrars themselves).

Timeframe: A domain name dispute filed through the .it domain dispute resolution providers usually takes around 50 days.

Possibilities to Appeal: Decisions of panellists are final and not subject to appeal unless new information comes to light⁶⁸. However the guidelines also highlight that dispute resolution procedure ‘has no legal validity and as such does not preclude the parties’ right to appeal, also subsequently, to the law court or arbitration⁶⁹’.

DISPUTE PROCEDURE

The procedure for reassigning an .it domain name is based on the UDRP and requires the same three cumulative tests⁷⁰:

- the domain name in dispute is identical to or such as to cause confusion with a trade mark or other distinctive business sign, for which the complainant claims rights, or to its name and surname; and that
- the respondent has no right to the domain name object of opposition and, finally, that
- the domain name has been registered and is used in bad faith (‘mala fide’).

Unlike the UDRP, the Italian procedure provides for an initial mandatory ‘informal arbitration’ stage. This is designed to give the parties time to settle the dispute before the process progresses to a more formal dispute resolution procedure⁷¹.

FEES

Panellist fees from the five providers converge along similar lines. Costs for a single panellist range from EUR 1 200 to EUR 2 400 depending on the number of domains being contested. Two panellists will range from EUR 3 000 to EUR 5 000⁷².

⁶⁸ See 4.2.22 in https://www.nic.it/sites/default/files/docs/Dispute_Resolution_Guidelines_v3.1.pdf (last visited November 2018); neither panels nor dispute resolution providers have the authority to formally refer a case to the national court system. However, if a panel concludes that a given case contains complex factual issues or is outside the scope of the DRP it may issue a denial of the complaint and suggest, in the decision, that the case would be better decided in a court setting. This typically happens where the fact issues or external legal claims may impact the rights or defences of the parties in the case as they relate to the disputed domain name (e.g. questions of contract law, employment, etc.) In this regard, courts can adjudicate a greater range of legal claims and may offer the parties greater opportunities to develop the factual record of the case if discovery and witness examination are available.

⁶⁹ Dispute Resolution Guidelines v2.1, https://www.nic.it/sites/default/files/docs/Dispute_Resolution_v2.1.pdf (last visited November, 2018).

⁷⁰ https://www.nic.it/sites/default/files/docs/Dispute_Resolution_v2.1.pdf (last visited November 2018).

⁷¹ <http://www.worldtrademarkreview.com/Magazine/Issue/66/Country-correspondents/Alternative-dispute-resolution-proceedings-involving-it-domain-names-in-2016>, (last visited November 2018),

http://www.nic.it/sites/default/files/docs/Dispute_Resolution_Guidelines_v3.1.pdf (last visited November 2018).

⁷² <https://www.camera-arbitrale.it/en/domain-names-disputes/fees.php?id=107> (last visited November 2018).

STATISTICS

In 2017, 37 cases were decided through proceedings across all five DRSPs. In nearly 70 % of decisions, the panels upheld the complaint and ordered the transfer of the contested domain name to the complainant⁷³.

DRSP	2015					2016					2017				
	Cases	Transfers	Denied	Terminated	Other	Cases	Transfers	Denied	Terminated	Other	Cases	Transfers	Denied	Terminated	Other
5 LICENSED PROVIDERS	25	17	0	3	5	35	24	0	6	5	37	24	0	5	8

NOTES

- 'Terminated' category, according to nic.it data could refer to cases that were either settled by mediation or not.
- Within the 'Other' category is an 'inadmissible' designation, which was provided in the raw data set provided by nic.it but it is unclear on what basis these cases were not resolved.

.UK (Nominet Dispute Resolution Service (DRS))

BACKGROUND

Nominet is the registry for the .uk domain which has over 10 million domain name registrations and around 3 000 accredited registrars. There are no territorial restrictions for .uk domain names; applicants do not need to have any connection to the UK⁷⁴. The four main top-level domains (TLDs) within the .uk domain are⁷⁵:

- .uk
- .co.uk
- .org.uk
- .me.uk

KEY FACTS

Governing Rules: Nominet DRS Policy⁷⁶.

⁷³ <http://www.nic.it/en/psrd-decisions> (last visited July 2018).

⁷⁴ There are some restrictions for select domains known as 'restricted second level domains' such as, for example, .ltd.uk.

⁷⁵ <https://www.theukdomain.uk/faqs/> (last visited November 2018).

⁷⁶ <https://s3-eu-west-1.amazonaws.com/nominet-prod/wp-content/uploads/2017/10/17150434/final-proposed-DRS-policy.pdf> (last visited November 2018).

Administrative Panel: If the case could not be settled by mediation, the complainant can appoint (for a fee, see below) an independent adjudicator, referred to as the Expert, to make a binding decision about what should happen to the domain name. Experts are screened by Nominet and their profiles are publicly available on the website⁷⁷. An Expert can arrive at a 'summary decision', which does not contain a detailed written decision, if the respondent does not submit a response to the complaint. However, if the respondent does respond, a full decision must be reached⁷⁸. The summary decision is not a 'default' win for the complainant, though, as the Expert still has to satisfy itself that the complaint should succeed and that no detailed written decision is needed.

DRSP: Nominet.

Complaint Filing Requirements: The complaint must describe the grounds on which the complaint is made including in particular: what rights the complainant asserts in the name or trade mark; why the domain name should be considered to be in bad faith, as well as any other grounds that support the complainant's assertion.

Timeframe: Mediated and summary decision cases take around 60 days, whereas full decision cases can take nearly 100 days⁷⁹.

Possibilities to Appeal: An internal appeal mechanism is available with Nominet. An appeal must be filed within 10 working days of the original decision being made. Either party is at liberty to submit the dispute to a court, however, if it is submitted during the dispute process this will result in the dispute process being suspended until the outcome of those legal proceedings.

DISPUTE PROCEDURE

Nominet's DRS follows a set of rules called the DRS Policy, and follows a path made up of different stages, which is similar in substance to the UDRP⁸⁰.

Stage 1 — Complaint and Response — The complainant submits its complaint to Nominet. Nominet sends a copy of this complaint to the registrant/respondent. The respondent has a set time frame to submit a response. This is then sent to the complainant, who can comment on it.

Stage 2 — Mediation — If there has been a response, the complainant and respondent are given the (obligatory) opportunity to use Nominet's free mediation service to try and settle their dispute, although the respondent is not required to respond. One of Nominet's internal mediators helps the parties to discuss a potential settlement. Mediators are neutral and will not judge the case. Mediation is always confidential.

Stage 3 — Expert Decision — If there was no response from the respondent within 10 days, or if the case could not be settled by mediation, the complainant can appoint (for a fee, see below) an independent adjudicator, referred to as the Expert, to make a binding decision about what should happen to the domain name.

⁷⁷ <https://s3-eu-west-1.amazonaws.com/nominet-prod/wp-content/uploads/2017/12/06105119/DRS-Experts-List-2017.pdf> (last visited November 2018).

⁷⁸ According to Nominet data, in 2017 there were 712 complaints made, 106 were resolved by parties themselves, 76 by mediation, 184 by summary decision and 104 by full decision. Other outcomes that did not result in a decision include fee not paid, invalid, and withdrawn.

⁷⁹ <https://s3-eu-west-1.amazonaws.com/nominet-prod/wp-content/uploads/2018/06/29131553/2017-in-UK-web-domain-dispute-resolution-2017.pdf> (last visited November 2018).

⁸⁰ <https://www.nominet.uk/domains/resolving-uk-domain-disputes-and-complaints/> (last visited November 2018).

Stage 4 — Appeal — Appeals are rare, but parties who want their case re-examined, can file an appeal. An appeal must be filed with Nominet within 10 working days of the original decision being made.

Final Stage (Closure) — If the Expert awards a transfer, cancellation or suspension of the domain name, Nominet will make the required changes to the domain name registration records. The Expert decision will also be published on the Nominet website. If the parties entered into a settlement in mediation, the mediator will help the parties to fulfil the terms of such settlement. If neither party takes any further action, the DRS case file will be closed.

An important distinction between Nominet DRS and the UDRP is that the Nominet DRS does not require that both the registration and use of the domain name be unfair (in bad faith). It is also important to note that, as with the UDRP, unfair use of a domain name covers use for any purpose, such as for a website or email.

FEES⁸¹

In cases where there was no response from the respondent during the mediation, the complainant can opt for the Expert to make a summary decision on the case. This costs GBP 200 plus VAT (EUR 227).

In all other cases, for instance if the parties failed to come to a settlement during mediation, an Expert (full) decision costs GBP 750 plus VAT (EUR 852). In the case of an appeal, the appeal will be heard by a panel of three Experts and costs GBP 3 000 (EUR 3 360) plus VAT.

STATISTICS

According to Nominet data, in 2017 there were 712 complaints made, 106 were resolved by the parties themselves⁸², 76 by mediation (aggregated as 'Terminated' in the table below), 184 by summary decision and 104 by full decision. Other outcomes that did not result in a decision include: fee not paid, invalid, and withdrawn⁸³.

⁸¹ <https://www.nominet.uk/domains/resolving-uk-domain-disputes-and-complaints/> (last visited November 2018).

⁸² It is not clear how disputes were resolved by the parties themselves without mediation. It is assumed that this is something done informally before the official mediation process begins.

⁸³ <https://s3-eu-west-1.amazonaws.com/nominet-prod/wp-content/uploads/2018/06/29131553/2017-in-UK-web-domain-dispute-resolution-2017.pdf> (last visited November 2018).

Out of the nearly 300 Expert decisions in 2017, 200 resulted in a transfer decision (i.e. in favour of the complainant)⁸⁴.

DRSP	2015					2016					2017				
	Cases	Transfers	Denied	Terminated	Other	Cases	Transfers	Denied	Terminated	Other	Cases	Transfers	Denied	Terminated	Other
NOMINET DRS	728	220	40	253	215	703	248	52	179	224	712	247	39	182	244

.CN (CNDRP)

BACKGROUND

The .cn domain name system is managed by the China Internet Network Information Centre (CNNIC) registry. Any individual may register a .cn domain name, and there are hundreds of domestic and foreign accredited registrars. There are now over 20 million .cn registered domains.

KEY FACTS

Governing Rules: Domain name disputes are resolved through the CNNIC ccTLD Dispute Resolution Policy (CNDRP⁸⁵) and Rules⁸⁶.

Administrative Panel: Same as UDRP⁸⁷.

DRSP: China International Economic and Trade Arbitration Commission (CIETAC) and Hong Kong International Arbitration Centre (HKIAC)⁸⁸.

Complaint Filing Requirements: Filing requirements are the same as the UDRP. However, in the event that the domain name concerned has been registered for more than 2 years, the two providers (CIETAC and HKIAC) do not accept complaints concerning this domain name. Consequently, brand owners that fail to file a complaint within 2 years of registration of the domain are limited to seeking redress from the Chinese courts⁸⁹. In such circumstance, the dispute may only be submitted to a national court for resolution. However, the HKIAC has recently ruled that the transfer of a '.cn' domain name from one party to another constitutes a new registration under the CNDRP and 'resets' the 2-year time limit for bringing a domain name complaint⁹⁰. In this case, filing requirements are the same as the UDRP.

⁸⁴ <https://secure.nominet.org.uk/drs/search-disputes.html?action.browseBasicSearchResults=y&sortAscending=false&sortColumn=&page=8> (last visited November 2018).

⁸⁵ http://cnnic.com.cn/IS/CNym/cnzcfg/201411/t20141117_50211.htm (last visited November 2018).

⁸⁶ http://cnnic.com.cn/IS/CNym/cnzcfg/201411/t20141117_50212.htm (last visited November 2018).

⁸⁷ Chapter I, K in the Rules — Panellists are individuals who are listed in the name list of panellists approved by the provider and published on the provider's website, and qualified to be members of the panel for the resolution of the domain name disputes.

⁸⁸ <http://cnnic.com.cn/IS/CNym/cnymyhfq/> (last visited November 2018).

⁸⁹ https://www.inta.org/INTABulletin/Pages/China_2_7120.aspx (last visited November 2018).

⁹⁰ https://www.inta.org/INTABulletin/Pages/China_2_7120.aspx (last visited November 2018).

Timeframe: 50-60 days.

Possibilities to Appeal: No appeal mechanism. The same procedure as the UDRP for delaying the enforcement of a decision in light of court proceedings applies.

DISPUTE PROCEDURE

The CNDRP is substantially the same as the UDRP, with two key differences:

- bad faith — it is sufficient to prove that either registration or use of the domain name by the registrant is in bad faith, whereas the UDRP requires the complainant to prove both;
- rights covered — requisite rights that the complainant can refer to in their complaint under CNDRP are referred to as 'civil rights or interests' instead of 'name or mark', which clearly extend beyond trade mark rights as in the UDRP.

FEES

Fees range from CNY 8 000 to CNY 16 000 (EUR 1 064 to EUR 2 128) for one panellist and CNY 14 000 to CNY 24 000 (EUR 1 862 to EUR 3 191) for three panellists depending on the number of domain names being contested per case.

STATISTICS

58 cases were filed and resolved through the CIETAC Online Dispute Resolution Centre in 2017. 75 were filed through the HKIAC in 2017⁹¹.

DRSP	2015					2016					2017				
	Cases	Transfers	Denied	Terminated	Other	Cases	Transfers	Denied	Terminated	Other	Cases	Transfers	Denied	Terminated	Other
CIETAC	64	48	8	4	4	63	54	5	0	4	58	52	2	1	3
HKIAC	59	57	1		1	52	45	1	3	3	75	66	5	1	3

⁹¹ <http://dndrc.cietac.org/> and <http://www.hkiac.org/ip-and-domain-name/domain-dispute-resolution/statistics> (last visited November 2018).

.JP (JP-DRP)

BACKGROUND

The .jp domain name system is managed by the Japan Registry Services (JPRS) registry. There are over 1.5 million .jp domain names in existence today⁹². Individuals and companies can register a .jp domain name if they reside or operate in Japan (the registrant contact country must be Japan).

KEY FACTS

Governing Rules: JP Domain Name Dispute Resolution Policy⁹³ and Rules⁹⁴ (JPD-DRP).

Administrative Panel: Same as UDRP.

DRSP: The Japanese Intellectual Property Arbitration Centre (JIPAC).

Complaint Filing Requirements: Same as UDRP.

Timeframe: 60-70 days.

Possibilities to Appeal: No appeal mechanism. The same procedure as the UDRP for delaying the enforcement of a decision in light of court proceedings applies.

DISPUTE PROCEDURE

JP-DRP is substantially modelled on the UDRP, however, some of its provisions do not reproduce the provisions of the UDRP as they stand, but have been partially localised to reflect local and national requirements in Japan with regard to the following⁹⁵.

- ‘Trademarks’ as a basis for filing a domain dispute — Under the UDRP, the basis for a complaint are ‘trademarks or service marks’, including well-known personal names and brands⁹⁶. However, in JP-DRP, if a ‘trademark’ is used as the basis for a complaint, this will be construed as being restricted to ‘trademarks’ as defined under the Japanese Trademark Act, and to not include well-known personal names or brands. Given that well-known personal names could become a target for cyber-squatting, the JP-DRP therefore specifies ‘trademark or other indication [sic]’ as the basis of the complaint. This can be interpreted more broadly than ‘trademarks’ as defined under the Trademark Act and also allows well-known personal names and non-trademarked brands to be covered in a complaint⁹⁷.
- Determining registration and use in bad faith or for unfair purposes — Under the UDRP, complainants are required to prove that the domain name has been registered ‘and’ is being used

⁹² <https://jprs.co.jp/en/press/2018/180205.html> (last visited November 2018).

⁹³ <https://www.nic.ad.jp/doc/jpnic-01221.html> (last visited November 2018).

⁹⁴ <https://www.nic.ad.jp/doc/jpnic-01222.html> (last visited November 2018).

⁹⁵ <https://www.nic.ad.jp/en/drpdifferences.html> (last visited November 2018).

⁹⁶ <https://www.nic.ad.jp/en/drpdifferences.html> (last visited November 2018).

⁹⁷ <https://www.nic.ad.jp/en/drpdifferences.html> (last visited November 2018).

in bad faith. Under the JP-DRP, the complaint will be accepted if the domain name has been registered 'or' is being used in bad faith⁹⁸.

FEES

In cases that are heard by one panellist, the fee is JPY 180 000 (EUR 1 411). However, in cases where the number of domain names in the same written application exceeds four, the complainant is charged JPY 10 000 (EUR 78) for each additional domain. In cases that are heard by three panellists, the fee is JPY 360 000 (EUR 2 822) with the same additional fee structure applying for more than four domain names⁹⁹.

STATISTICS

Only five procedures were filed in the whole of 2017¹⁰⁰.

DRSP	2015					2016					2017				
	Cases	Transfers	Denied	Terminated	Other	Cases	Transfers	Denied	Terminated	Other	Cases	Transfers	Denied	Terminated	Other
JIPAC	7	5	0	1	1	9	6	0	3	0	5	3	0	2	0

.US (usDRP)

BACKGROUND

Neustar Inc., a provider of registry services, manages the .us domain name on behalf of the US Department of Commerce¹⁰¹. The .us domain name was introduced in 1985. There are now approximately 2 million registered .us domain names, and 158 licensed registrars. Registrants of .us domains must be US citizens, residents, or organisations, or a foreign entity with a presence in the US.

KEY FACTS

Governing Rules: usTLD Dispute Resolution Policy¹⁰².

Administrative Panel: Same as UDRP.

DRSP: National Arbitration Forum (NAF), American Arbitration Association (AAA).

⁹⁸ 'Bad faith' and 'unfair purposes' are used interchangeably in JP-DRP, generally referring to 'unfair purposes, that is, purposes of gaining unfair interests, of causing damages to others and other unfair purposes' Art 2. JP-DRP Rules, <https://www.nic.ad.jp/doc/jpnic-01221.html> (last visited November 2018).

⁹⁹ <https://www.ip-adr.gr.jp/eng/business/domain/jp-4.php> (last visited November 2018).

¹⁰⁰ <https://www.nic.ad.jp/ja/drp/list/2017/> (last visited November 2018).

¹⁰¹ <http://www.about.us/faqs> (last visited November 2018).

¹⁰² <https://www.about.us/policies/ustld-dispute-resolution-policy> (last visited November 2018).

Complaint Filing Requirements: Same as UDRP. No reference is made in the Rules or the Procedure to eligibility criteria for filing a complaint.

Timeframe: 60-70 days in most cases.

Possibilities to Appeal: No appeal mechanism. The same procedure as the UDRP for delaying the enforcement of a decision in light of court proceedings applies.

DISPUTE PROCEDURE

The usDRP is substantially the same as the UDRP, both in terms of process and in policy, with the following two differences:

- ‘How to demonstrate rights to legitimate interests in the domain name ...’¹⁰³, which specifies that a respondent can demonstrate its legitimate rights by proving to be the ‘... owner or beneficiary of a trade or service mark that is identical to the domain name.’¹⁰⁴, and
- the use of the disjunctive ‘or’ rather than ‘and’ in the bad faith element under 4(a)(iii) of the usTLD Dispute Resolution Policy¹⁰⁵.

FEES

Fees range from USD 1 300 to USD 2 250 (EUR 1 121 to EUR 1 939) for a single-member panel and USD 2 600 to USD 5 000 (EUR 2 241 to EUR 4 310) for a three-member panel depending on the number of disputed domain names¹⁰⁶.

STATISTICS

The AAA has unofficially ceased to operate as a dispute resolution services provider for the .us domain. The NAF therefore processes all of the cases, of which there were nearly 100 filed in 2017 with 87 % ruled in favour of the complainants¹⁰⁷.

¹⁰³ <http://www.about.us/policies/ustld-dispute-resolution-policy> (last visited November 2018).

¹⁰⁴ Paragraph 4c (i), <https://www.about.us/policies/ustld-dispute-resolution-policy> (last visited November 2018); This factor does not alter the procedure or decision-making criteria in any material fashion but it is an additional factor not included in the UDRP.

¹⁰⁵ <http://www.adrforum.com/ccTld> (last visited November 2018).

¹⁰⁶ <http://www.adrforum.com/resources/CcTld/usDRP/usDRP%20Supp%20Rules%202014%20FINAL.pdf> (last visited November 2018).

¹⁰⁷ <http://www.adrforum.com/SearchDecisions> (last visited July 2018).

DRSP	2015					2016					2017				
	Cases	Transfers	Denied	Terminated	Other	Cases	Transfers	Denied	Terminated	Other	Cases	Transfers	Denied	Terminated	Other
NAF	35	33	2	0	0	42	40	2	0	0	71	70	1	0	0

.NL (Modified UDRP)

BACKGROUND

The .nl domain was introduced in 1986 and now has over 5.8 million registered domain names. It is administered by the Foundation for Internet Domain Registration Netherlands (SIDN), which has licensed over 1 300 .nl registrars¹⁰⁸.

KEY FACTS

Governing Rules: Dispute Resolution Regulations for .nl Domain Names framework¹⁰⁹.

Administrative Panel: Same as UDRP.

DRSP: WIPO.

Complaint Filing Requirements: Same as UDRP.

Timeframe: 40-60 days (90 days in cases involving mediation).

Possibilities to Appeal: No appeal mechanism. The same procedure as the UDRP for delaying the enforcement of a decision in light of court proceedings applies.

DISPUTE PROCEDURE

While the .nl dispute procedure is substantially the same as the UDRP, there is an important addition of a (mandatory) mediation stage, similar to those stipulated for the .it and .uk domain name disputes¹¹⁰. This is a free-of-charge process and begins once a dispute has been filed with WIPO. The mediation process ends within 30 calendar days of its commencement, or as soon as the SIDN determines that mediation has not been successful¹¹¹.

¹⁰⁸ <https://www.sidn.nl/a/about-sidn/what-we-do> (last visited November 2018).

¹⁰⁹ <https://www.sidn.nl/downloads/procedures/Dispute+Resolution+Regulations+for+nl+Domain+Names.pdf> (last visited November 2018).

¹¹⁰ <https://www.sidn.nl/downloads/procedures/Dispute+Resolution+Regulations+for+nl+Domain+Names.pdf> (last visited July 2018).

¹¹¹ <http://www.wipo.int/amc/en/domains/cctld/nl/index.html> (last visited November 2018).

There are four additional differences in procedure compared with the UDRP¹¹²:

- whereas the UDRP is limited to the protection of trade mark rights against infringement through bad faith registration and use of a domain name, the ‘Dispute Resolution Regulations for .nl Domain Names’ aims to protect not only trade mark rights, but also certain other rights such as trade names and registered personal names protected in the Netherlands;
- it is sufficient to prove that either registration or use of the domain name by the registrant is in bad faith, whereas the UDRP requires the complainant to prove both;
- only one-person panels are permitted (no three-member panels are possible);
- proceedings can also be conducted in English depending on the location of the parties and the circumstances of the case.

FEES

Fees are EUR 1 500 for between 1 and 5 domain names and EUR 2 000 for between 6 and 10 domain names¹¹³.

STATISTICS

There were 74 cases filed at WIPO in 2017 with slightly more than half of cases ruled in favour of the complainant.

DRSP	2015					2016					2017				
	Cases	Transfers	Denied	Terminated	Other	Cases	Transfers	Denied	Terminated	Other	Cases	Transfers	Denied	Terminated	Other
WIPO	75	37	2	36	0	65	35	4	25	1	74	37	0	37	0

¹¹² <http://www.wipo.int/amc/en/domains/cctld/nl/index.html> (last visited November 2018).

¹¹³ <http://www.wipo.int/amc/en/domains/fees/cctlds/nl/index.html> (last visited November 2018).

SUMMARY STATISTICS

#	gTLD/ ccTLD	DRP	DRSP	Mediation Stage	Procedure Timeframe	Appeal Mechanism	Restrictions	Fees (range)*	
								1 Panellist	3 Panellists
1	All gTLDs	UDRP	ACDR	No	~50 days	None	None	€1 290-€1 720	€3 450-€4 310
			ADNDRC					€1 120-€1 640	€2 410-€3 275
			CAC					€800-€1 100	€2 600-€3 200
			NAF					€1 110-€1 540	€2 230-€3 090
			WIPO					€1 290-€1 720	€3 450-€4 310
2	.AU	.auDRP	RI	No	~45 days	None	Must be Australian citizen or foreign company licensed to operate in Australia	€1 270	€2 870
			WIPO					€1 270	€2 870
3	.DK	Danish Domain Name Board	Complaints Board	At discretion of secretariat	60-70 days	None	None	€21-€70	-not an option under DRP
4	.EU	euADR	WIPO	No	60-75 days	None	Person or entity registered or residing within the European Union, Iceland, Liechtenstein or Norway	€1 300-€1 600	€3 100-€4 000
			CAC					€1 300-€1 600	€3 100-€4 000
5	.IT	Modified UDRP	5 licensed providers	Yes	50-60 days	None	None	€1 200-€2 400	€3 000-€5 000 (2 panellists only)
6	.UK	Nominet DRS	Nominet	Yes	60 days for mediation or summary; 90 for full decisions	Yes	None	€850	-not an option under DRS
7	.CN	CNDRP	CIETAC	No	50-60 days	None	None	€1 064-€2 128	€1 862-€3 191
			HKIAC	No				€1 064-€2 128	€1 862-€3 191
8	.JP	JP-DRP	JPNIC	No	60-70 days	None	None	€1 410	€2 820
9	.US	.USDRP	NAF	No	60-70 days	None	None	€1 121-€1 939	€2 241-€4 310
10	.NL	Modified UDRP	WIPO	Yes	40-60 days (90 days in cases involving mediation)	None	None	€1 500	-not an option under DRP

*Assumed less than 10 domain names are disputed

#	gTLD/ ccTLD	DRP	DRSP	Statistics														
				2015					2016					2017				
				Cases	Transfer	Denied	Terminated	Other	Cases	Transfer	Denied	Terminated	Other	Cases	Transfer	Denied	Terminated	Other
1	All gTLDs adopting UDRP	UDRP	ACDR	N/A	N/A	N/A	N/A	N/A	N/A	N/A	N/A	N/A	N/A	N/A	N/A	N/A	N/A	N/A
			ADNDRC	N/A	N/A	N/A	N/A	N/A	N/A	N/A	N/A	N/A	N/A	N/A	N/A	N/A	N/A	N/A
			CAC	96	82	11	0	3	97	88	9	0	0	201	186	14	0	1
			NAF	1 267	1 138	123	2	4	1 181	1 075	100	2	4	1 390	1 294	88	5	3
			WIPO	2 754	1 943	183	575	53	3 036	2 253	185	541	57	3 074	2 331	167	535	41
2	.AU	.auDRP	RI	12	3	6	3	0	8	5	1	1	0	13	10	2	1	0
			WIPO	39	24	6	9	0	52	33	4	14	1	42	28	4	10	0
3	.DK	Danish Domain Name Board	Complaints Board	207	89	75	28	15	169	82	61	18	8	248	99	63	9	77
4	.EU	euADR	WIPO	N/A	N/A	N/A	N/A	N/A	N/A	N/A	N/A	N/A	N/A	13	7	0	4	2
			CAC	50	46	4	0	0	57	48	9	0	0	46	40	6	0	0
5	.IT	Modified UDRP	5 licensed providers	25	17	0	3	5	35	24	0	6	5	37	24	0	5	8
6	.UK	Nominet DRS	Nominet	728	220	40	253	215	703	248	52	179	224	712	247	39	182	244
7	.CN	CNDRP	CIETAC	64	48	8	4	4	63	54	5	0	4	58	52	2	1	3
			HKIAC	59	57	1	0	1	52	45	1	3	3	75	66	5	1	3
8	.JP	JP-DRP	JPNIC	7	5	0	1	1	9	6	0	3	0	5	3	0	2	0
9	.US	.USDRP	NAF	35	33	2	0	0	42	40	2	0	0	71	70	1	0	0
10	.NL	Modified UDRP	WIPO	75	37	2	36	0	65	35	4	25	1	74	37	0	37	0

5 DOMAIN NAME DISPUTE CASE SCENARIOS

INTRODUCTION

As previously described, the report enlisted the support of sitting panellists from each of the DRPs assessed. For each of the eleven hypothetical case scenarios provided, the panellists defined the key factors to consider according to the requirements stipulated in their DRPs of expertise as well as the conditions for deciding in favour of the complainant and registrant and the filing frequency of similar real-life cases. This information is summarised in colour-coded tables in the following pages for each case scenario.

Importantly, given all of the DRPs (with the exception of the Danish Domain Name Board) comprise three fundamental tests that must be met for a decision in favour of the complainant¹¹⁴, it is assumed that all panels will take these into account during their deliberations. However, in scenarios where decisions diverge, the analysis looks at different interpretations of these three tests and identifies decision-making frameworks that have been developed based on case precedent.

Furthermore, the depth of analysis and number of factors to consider varies between the different case scenarios. This is due to the varying level of detail provided in the case description. For instance, Scenario #1 (Registration of domain name in good faith with subsequent bad faith use) states that initial good faith registration and subsequent bad faith usage has been established, meaning that the analysis must focus exclusively on the DRP decision based on its own policies and rules. However, other cases such as Scenario #8 (domain name that relates to the owner's surname, that coincides with a trade mark) and #9 (domain name that includes country abbreviations combined with new gTLDs such as 'de.travel' instead of 'travel.de') do not provide such context, resulting in panellists reviewing related — hypothetical — scenarios to outline key factors that would need to be considered. For instance, both Scenario #8 and #9 necessitated establishing the grounds for which a complainant or respondent can assert their rights in a registered or unregistered trade mark. It is only after this is established that the panellist can determine whether the domain is identical or confusingly similar to the trade mark and whether the registrant has acted in bad faith.

The characteristics of the given scenarios are central to interpreting the data because decisions revolve around specific details of each case brought to a panel. For example, in relation to Scenario #4 (Tribute Site), all of the panellists agreed that decisions would favour the respondent only if all factors of the given scenario were present and found to be correct. In this instance, that would mean that the panel would find beyond reasonable doubt that the fan page was being operated in good faith (in other words, the fan site is found to be a legitimate fan site) and was not being operated for any improper commercial gain. These aspects seem to be taken for granted in the given scenarios, but it is still important to note.

Similarly, in relation to Scenario #6 (Generic Terms), while it was not specified in the scenario description, it was concluded that a panel would need to assess whether the generic term is being utilised in its generic sense and not encroaching on the trade mark's business or commercial interests. Only if the domain name was found to be used in its generic sense and the website was being operated in good faith, would panels be likely to rule in favour of the respondent.

Finally, it is important to acknowledge that the scenario findings are based on the opinions of one panellist from each DRP. While many panellists relied on jurisprudential overviews of their respective DRPs, it is still possible that their opinions may not represent a consensus viewpoint. While measures

¹¹⁴ As set out in Section 4, these requirements are variations of the following: i) domain name is identical or confusingly similar to trade mark, and ii) respondent has no rights or legitimate interests in respect of the domain name and iii) the domain name has been registered and/or is being used in bad faith.

have been taken during this analysis to ensure that panellists referred to consensus views as well as minority views, the possibility of a different outcome from another panellist exists.

SCENARIO #1: REGISTRATION OF DOMAIN NAME IN GOOD FAITH WITH SUBSEQUENT BAD FAITH USE

Example: An initial fan page that over time comes to sell competing products.

Ruling in favour of respondent in given scenario	Ruling in favour of complainant in given scenario	Rulings dependent on specific variables within scenario	Outside scope of DRS
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	Key Factors
UDRP	<ul style="list-style-type: none"> Article 4 (a) (iii) requires panel to consider registration and use If registration is found to be in good faith then panel will tend to rule in favour of respondent
.auDRP	<ul style="list-style-type: none"> Subsequent use in bad faith is sufficient to rule in favour of the complainant Panel looks at subsequent bad faith usage irrespective of original registration
.DK	<ul style="list-style-type: none"> Registration and use of a domain name must not be contrary to 'good domain name practise'
euADR	<ul style="list-style-type: none"> Subsequent use in bad faith is sufficient to rule in favour of the complainant Panel looks at subsequent bad faith usage irrespective of original registration
.ITADR	<ul style="list-style-type: none"> As UDRP
.UKADR	<ul style="list-style-type: none"> Subsequent use in bad faith is sufficient to rule in favour of the complainant Panel looks at subsequent bad faith usage irrespective of original registration
CNDRP	
JP-DRP	
usDRP	
.nlADR	

NOTES

While fan sites are generally allowed under all of the studies' dispute resolution procedures on the basis that they are active and non-commercial, this scenario has been interpreted by the panellists on the basis that notwithstanding a legitimate initial registration purpose, bad faith use is obvious. This is to say that the question is how the panel will likely rule given good faith at the time of registration with bad faith use only established afterwards.

With the exception of the UDRP and .ITADR, this scenario will be judged mainly on whether the disputed domain name has been registered or is being used in bad faith¹¹⁵. Due to the use of the word 'or' (in contrast to use of the word 'and', which is utilised in the UDRP and .ITADR), panels need only specifically consider the present use by the domain holder. Given the scenario description, all DRPs with the exception of the UDRP and .ITADR would therefore likely rule in favour of the complainant, if it is established that the current use is in bad faith.

In contrast to the other DRPs, the Danish Domain Name Board considers a much broader and more general set of rules. As the concept of 'bad faith' is not directly applied in .dk disputes, the Danish Domain Name Board will consider whether the use of a domain name is contrary to 'good domain name practise'. In cases of bad faith, this would likely lead the Panel to rule in favour of the complainant, but it

¹¹⁵ This is paraphrasing the rules of all of the DRPs with the exception of the UDRP, .ITADR and the Danish Domain Name Board.

is important to note that the decision would not be guided by a formal set of rules and requirements to be established as in the other DRPs.

Experts were generally in agreement that these types of cases comprise less than 5 % of total cases.

SCENARIO #2: RESELLERS AND IMPORTERS

Example: An importer of a product registers a ccTLD domain with the same name as the manufacturer's global website.

Ruling in favour of respondent in given scenario	Ruling in favour of complainant in given scenario	Rulings dependent on specific variables within scenario	Outside scope of DRS
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	Key Factors
UDRP	<p>Only if the following four 'Oki Data test' principles are met:</p> <ul style="list-style-type: none"> • respondent must actually be offering the goods or services at issue; • respondent must use the site to sell only the trademarked goods or services; • site must accurately and prominently disclose the respondent's relationship with the trade mark holder; • domain name may not consist solely of the complainant's trade mark.
.auDRP	Same as UDRP
.DK	<ul style="list-style-type: none"> • Scenario would be ruled as trade mark infringement.
euADR	Same as UDRP
.ITADR	
.UKADR	
CNDRP	
JP-DRP	
usDRP	
.nlADR	

NOTES

Panellists across all of the DRPs (excluding the Danish Domain Name Board) all recognised that resellers, distributors or importers using a domain name containing a complainant's trade mark may be making a bona fide offering of goods and services and thus have a legitimate interest in the domain name, even when making the presumption that the registrant did not have prior authorisation of the trade mark holder to register the domain. However, this would only be the case if certain criteria, known as the Oki Data test, are met. Panellists refer to the Oki Data case¹¹⁶, which set out a four-factor test to determine if an authorised reseller, importer or other distributor is making a fair referential use of the complainant's mark by incorporating it into a domain name.

- The respondent must actually be offering the goods or services at issue.
- The respondent must use the site to sell only the trademarked goods or services. Otherwise it could be using the trade mark to bait internet users and then switch them to other goods.

¹¹⁶ Oki Data Americas, Inc. v. ASD, Inc., WIPO Case No D2001-0903, <okidataparts.com>.

- The site must accurately and prominently disclose the respondent's relationship with the trade mark holder. The respondent may not, for example, falsely suggest that it is the trade mark owner, or that the website is the official site, if, in fact, it is only one of many sales agents.
- The respondent must not try to 'corner the market' in domain names that reflect the trade mark. In other words, the domain name may not consist solely of the complainant's trade mark and the respondent must not have registered multiple domains that incorporate the complainant's trade mark or other protected name.

Provided all the requirements are met, and there are no other facts that would indicate that the domain holder lacks rights or legitimate interests in the disputed domain name, the panel will likely rule in favour of the respondent. If not all of the above requirements are met, the panel will likely rule in favour of the complainant. The most common situation in which this occurs is where goods are sold on a website that competes with the complainant's own products or where the website fails to sufficiently disclose the relationship (or lack thereof) with the complainant.

Importantly, domain names owned by resellers, distributors or importers that are identical to a complainant's trade mark will not be deemed good faith under any of the DRPs. The criteria established in the Oki Data decision would only be applied in cases where the domain name consists of a trade mark plus an additional term, for example, <[brand]parts.nl>. Although in this instance it is not clear from the hypothetical scenario description whether the domain name has been registered with an additional term, it is assumed to be the case.

The Danish Domain Name Board is the outlier in this scenario, such that the panel would likely rule in favour of the complainant because registration of the domain name is regarded as trade mark infringement regardless of whether an additional term is present. However, this decision would also be based on the presumption that the registration of the domain name has not been authorised by the trade mark holder, which is not stipulated in the scenario description.

Experts suggested that these types of scenarios could appear in between 5 and 10 % of total cases.

SCENARIO #3: FORMER BUSINESS PARTNER

Example: A party registers a domain incorporating a former partner's name without the consent of that former partner.

Ruling in favour of respondent in given scenario	Ruling in favour of complainant in given scenario	Rulings dependent on specific variables within scenario	Outside scope of DRS
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	Key Factors
UDRP	<ul style="list-style-type: none"> • Panellists assume that permission had not been granted (either explicitly or implied). • Panel will consider whether domain name is identical to former partner's name; if additional (typically critical) words (e.g. 'sucks') are employed then respondent could prevail.
.auDRP	
.DK	
euADR	
.ITADR	
.UKADR	
CNDRP	
JP-DRP	
usDRP	
.NLADR	

NOTES

Panellists tend to consider a former business partner to be a competitor in the context of this scenario. Therefore, if the former partner's name is being used without adornment to derive commercial advantage virtually all decisions will likely be against the domain holder on the basis that the domain name has been registered and is being used to disrupt the business of the former partner.

One of the key factors to consider is whether the domain holder has used the domain name without the consent of the former business partner. On the basis of this point being explicitly clear in the scenario description (i.e. no permission), panellists were unanimous in their opinions that decisions would favour the complainant.

However, panellists may reject the complaint, if the complainant business partner initially gave express consent for use of the domain name (e.g. via a partnership agreement), but later rescinded consent due to a business or personal dispute. Another situation in which a domain holder might prevail would be when the complainant business partner demonstrates its implied consent to the use of the domain name by actively participating in the domain holder's business that involved the domain name or by failing to raise its concerns for an extended period of time despite knowledge of its use. The panel could also rule in favour of the respondent if the domain name combined the former partner's name with a modifier making clear the nature of the use (e.g. appending 'sucks' or something similar to signal that there was a dispute between the parties).

Experts were generally in agreement that these types of cases comprise less than 5 % of total cases.

SCENARIO #4: TRIBUTE SITE

Example: A fan site domain that is not owned or operated by the person the site refers to.

Ruling in favour of respondent in given scenario	Ruling in favour of complainant in given scenario	Rulings dependent on specific variables within scenario	Outside scope of DRS
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	Key Factors
UDRP	<ul style="list-style-type: none"> • Domain name must not be identical to trade mark. • Site must be active and genuinely non-commercial and generally found to be operating in good faith.
.auDRP	
.DK	
euADR	
.ITADR	
.UKADR	
CNDRP	
JP-DRP	
usDRP	
.NLADR	

NOTES

Legitimate fan site cases will typically be ruled in favour of the respondent, but only on the basis that the site is active, genuinely non-commercial and the domain name is clearly not identical to the complainant's trade mark, that is, where it includes an additional term (e.g. <celebrity-fan.tld>). If commercial activity beyond that normally associated with a bona fide fan site takes place, the registration may be considered abusive. Panellists assumed that in this scenario, the fan site complies with these criteria. However, even for a genuine non-commercial¹¹⁷ fan site, panels have tended to find that a general right to operate a fan site does not necessarily extend to a domain name that is identical to the complainant's trade mark (i.e. <trademark.tld>).

Experts were generally in agreement that these types of cases comprise less than 5 % of total cases.

¹¹⁷ A fair amount of discretion is employed by panellists in determining 'non-commercial' usage. Generally, panellists will look to evidence that suggests that the site is primarily intended for commercial gain such as commercial or pay per click links or references to a respondent's business, or that the 'fan site' is in reality a pretext for commercial gain.

SCENARIO #5: CRITICISM SITE

Example: An organisation registers a website that is used to criticise a competing brand.

Ruling in favour of respondent in given scenario	Ruling in favour of complainant in given scenario	Rulings dependent on specific variables within scenario	Outside scope of DRS
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	Key Factors
UDRP	<p>• While criticism sites are generally allowed provided that the domain name is not identical to a trade mark and the site must be active and genuinely non-commercial, the fact that the site is run by a competitor will lead panels to rule in favour of the complainant.</p>
.auDRP	
.DK	
euADR	
.ITADR	
.UKADR	
CNDRP	
JP-DRP	
usDRP	
.NLADR	

NOTES

Consistent with the consensus for Scenario #4 (fan site), panellists will generally allow criticism sites on the basis that the site is active, genuinely non-commercial and the domain name is not identical to the complainant's trade mark, but includes an additional term (e.g. <[trademark]sucks.tld>). However, since the scenario description states the website is being run by a competitor, it would fail the non-commercial test of the requirement. Panellists in this scenario are likely to rule in favour of the complainant in all of the DRPs.

Experts were generally in agreement that these types of cases comprise less than 5 % of total cases.

SCENARIO #6: GENERIC TERM

Example: A domain is registered using a term that is generic in some countries, but not in others.

Ruling in favour of respondent in given scenario	Ruling in favour of complainant in given scenario	Rulings dependent on specific variables within scenario	Outside scope of DRS
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	Key Factors	
UDRP	<ul style="list-style-type: none"> Usage of term must be in its generic sense and not targeting a third-party trade mark (in the local language, if relevant) for ruling in favour of respondent. If complainant's trade mark is famous, a panel may consider that the respondent is targeting the mark regardless of whether its wording is generic in a particular country or language. However, if the confusion is likely to be very limited, a panel might conclude that it would be unjust to deprive the respondent of the domain name. 	
.auDRP		
.DK		
euADR		
.ITADR		
.UKADR		
CNDRP		
JP-DRP		
usDRP		<ul style="list-style-type: none"> Generic terms do not adequately distinguish a domain from a trade mark.
.NLADR		

NOTES

Panellists generally concluded that decisions in this scenario will depend on case-specific variables that are not stipulated in the scenario description. For example, while a domain name based on its dictionary meaning could be allowed if genuinely used in connection with the dictionary definition and not to trade off third-party trade mark rights, the status and fame of the complainant's trade mark would have to be taken into account. In this regard, if the complainant's trade mark is famous, a panel may consider that the respondent is targeting the mark regardless of whether its wording is generic in a particular country or language¹¹⁸. However, if the confusion is considered to be unlikely, a panel might conclude that it would be unjust to deprive the respondent of the domain name.

For example, a hypothetical respondent may have a legitimate interest in the domain name <orange.com> if it uses the domain name for a website providing information about the fruit or the colour orange. However, the same respondent might not have a legitimate interest in the domain name if the corresponding website was aimed at goods or services in the field of telecommunications¹¹⁹.

Generally, the actual use of the domain will be a decisive factor. If the content of the website suggests a connection to the trade mark owner or it takes unfair advantage of the trade mark (for example, if the website contains sponsored links corresponding to the complainant's trade mark or ads of competitors),

¹¹⁸ See, for example, *Swarovski Aktiengesellschaft v yuefang wu* WIPO Case No D2013-0741 at <http://www.wipo.int/amc/en/domains/decisions/text/2013/d2013-0741.html>, where the term 'schmuck' was understood to mean 'jewelry' in German (last visited in November 2018).

¹¹⁹ See the broader explanation given in the WIPO Overview 3.0 at <http://www.wipo.int/amc/en/domains/search/overview3.0/#item210> (last visited in November 2018).

the panel will likely rule in favour of the complainant. Likewise, the panel will likely rule in favour of the complainant if the claimed generic use is not credible (e.g. dunkin.menu for a series of basketball classes teaching a 'menu' of techniques for 'dunking' the ball)¹²⁰. Further, where a term is considered generic in one country but not in the complainant's country, the website content or other activities of a domain holder that clearly target the complainant's customers in the second country could be viewed as exhibiting bad faith.

While all panellists highlighted these case variables as important facts to establish before making a decision, the usDRP will tend to rule in favour of the complainant regardless of whether the site is being used in its generic sense on the basis that the complainant owns a trade mark that the respondent is using in its domain name without any additional terms. This perhaps reflects a slightly different interpretation of the scenario by the usDRP panellist but highlights an important deviation in the approach from the other DRPs.

Experts were generally in agreement that these types of cases comprise less than 5 % of total cases.

¹²⁰ This is a fictitious example.

SCENARIO #7: NON-IDENTICAL TERM

Example: A domain that is registered that contains an intentional minor misspelling of a well-known brand name as a means of selling competing products.

Ruling in favour of respondent in given scenario	Ruling in favour of complainant in given scenario	Rulings dependent on specific variables within scenario	Outside scope of DRS
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	Key Factors
UDRP	<ul style="list-style-type: none"> Domain names that consist of a common, an obvious, or an intentional misspelling of a well-known brand name are most likely considered to be registered and used in bad faith.
.auDRP	
.DK	
euADR	
.ITADR	
.UKADR	
CNDRP	
JP-DRP	
usDRP	
.NLADR	

NOTES

In this scenario, all panellists will tend to rule in favour of the complainant on the basis that they would likely consider the intentional misspelling as evidence that the domain holder was aware of the third party's rights, and the selling of competing goods as being bad faith use.

The scenario describes what the panellists refer to as a case of 'typosquatting'; that is, to register a domain name that contains a typographical error of a well-known trade mark or other protected name. Such domains are obviously confusingly similar to the mark or protected name and almost self-evidently likely to be used in bad faith. The function of a domain (e.g. pay-per-click, phishing, competitive product website) may further support a finding of bad faith and support a decision against the domain holder.

Panellists will typically employ a side-by-side comparison of the domain name and the textual components of the relevant trade mark to assess whether the mark is recognisable within the disputed domain name.

Experts were generally in agreement that these types of cases do appear relatively frequently and could comprise between 5 and 10 % of total cases.

SCENARIO #8: PERSONAL NAME

Example: A domain name that relates to the owner’s surname, that coincides with a trade mark.

Ruling in favour of respondent in given scenario	Ruling in favour of complainant in given scenario	Rulings dependent on specific variables within scenario	Outside scope of DRS
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	Key Factors
UDRP	<ul style="list-style-type: none"> • First come, first served principle.
.auDRP	
.DK	
euADR	
.ITADR	
.UKADR	
CNDRP	
JP-DRP	
usDRP	
.NLADR	

NOTES

The fact that the domain name reflects the domain owner’s name will typically lead panellists to conclude that he or she has a right or legitimate interest in the domain name, provided that the site is not used to capitalise on the reputation of the corresponding trade mark.

Most of the DRPs regard surnames as relevant rights even where that name is neither a registered trade mark nor an unregistered trade mark. In the UDRP terms, one of the codified defences is whether the respondent is ‘commonly known by’ the domain name¹²¹. Regardless, registering a domain name that relates to the owner’s surname and coincides with a trade mark but where there is no bad faith use is subject to the first come, first served principle.

Experts were generally in agreement that these types of cases are rare.

¹²¹ Specifically, the UDRP paragraph 4(c)(ii) states ‘you (as an individual, business, or other organisation) have been commonly known by the domain name, even if you have acquired no trade mark or service mark rights’.

SCENARIO #9: CITY, COUNTY OR COUNTRY NAMES

Example: A domain name that includes country abbreviations combined with new generic TLDs such as 'de.travel' instead of 'travel.de'.

Ruling in favour of respondent in given scenario	Ruling in favour of complainant in given scenario	Rulings dependent on specific variables within scenario	Outside scope of DRS
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	Key Factors
UDRP	• First come, first served principle.
.auDRP	• First come, first served principle.
.DK	
euADR	• A territory may be protected if registered by responsible entity during 'sunrise period' of PPR.
.ITADR	• First come, first served principle, except for Italian regions, provinces and municipalities (e.g. toscana.it, pisa.it, viareggio.lucca.it) that are reserved and cannot be assigned to any registrant.
.UKADR	• First come, first served principle.
CNDRP	• Country names cannot be registered under the CNNIC. • Abbreviations depend on good/bad faith.
JP-DRP	• First come, first served principle.
usDRP	
.NLADR	• Dutch city or county rulings depend on 'relevant rights' according to national law. • Other (non-Dutch) names and abbreviations depend on good/bad faith.

NOTES

New gTLD-related disputes are managed exclusively through the UDRP. The UDRP experts concluded that seeing as the UDRP applies to trade mark rights and does not contain specific provisions on geographical terms as such, such country names or abbreviations combined with new gTLDs would, as a starting point at least, be available to register and to use in their ordinary geographical sense. Panels would therefore most likely rule in favour of the respondent based on the first come, first served principle. Furthermore, in order to apply the UDRP it is a precondition that the complainant holds trade mark rights, even if unregistered.

Panellists in the other DRPs interpreted the question more broadly as referring to rights of geographical terms in general. Panellists in JP-DRP, usDRP, .uk, .auDRP and .dk would tend to rule in favour of the respondent in these cases on the basis that it is difficult for an entity affiliated with, or responsible for, a geographical area (which has not otherwise obtained a relevant trade mark registration) to demonstrate unregistered trade mark rights in that geographical term. The decision would therefore likely be made on a first come, first served basis.

There are some geographic variances to consider in this scenario, however:

- euADR would defer to Regulation (EC) No 874/2004 of 28 April 2004, which concerns the implementation and functions of the .eu TLD (known as PPR). PPR sets out a so-called 'sunrise period' for public bodies to register the complete name of the territory for which they are responsible. If the public body did not apply for the domain name regarding the name of the

territory during this sunrise period, it can no longer rely on the benefits of PPR and has to prove the name being protected by national and/or Community law.

- In Italy, names corresponding to Italian regions, provinces and municipalities (e.g. toscana.it, pisa.it, viareggio.lucca.it) are reserved and cannot be assigned to any registrant.
- The CNNIC in China has also implemented a reservation list, under which names of countries in the world are normally not open to the public for registration. For example, 'france.cn', cannot be registered unless the application is from the relevant authority of the country concerned.
- Dutch cities and counties (provinces) can rely on the protection granted for the names of Dutch public legal entities. As a result the municipality, for example, of Rotterdam would be successful as a complainant in a dispute related to the domain name <rotterdam.nl>.

Experts were generally in agreement that these types of cases comprise less than 5 % of total cases.

SCENARIO #10: OFFICIAL WEBSITES (GOVERNMENTS, INSTITUTIONS, NGOs etc.)

Example: A domain name that incorporates the use of the name of a governmental organisation, where there is no official link to that organisation.

Ruling in favour of respondent in given scenario	Ruling in favour of complainant in given scenario	Rulings dependent on specific variables within scenario	Outside scope of DRS
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	Key Factors
UDRP	• Ruling depends on the existence of trade mark rights, and whether registration and/or usage is in good or bad faith.
.auDRP	
.DK	• Generally considered to be bad faith.
euADR	• A government organisation may be protected if registered by responsible entity during 'sunrise period' of PPR.
.ITADR	
.UKADR	• Ruling depends on whether registration and/or usage is in good or bad faith.
CNDRP	• Government names generally cannot be registered under the CNNIC. • Abbreviations depend on good/bad faith.
JP-DRP	• Practically impossible for unofficial organisations to obtain official domains.
usDRP	• Ruling depends on whether registration and/or usage is in good or bad faith.
.NLADR	• Dutch city or county rulings depend on 'relevant rights' according to national law. • Other (non-Dutch) names and abbreviations depend on good/bad faith.

NOTES

Panellists agreed that more context was required in the scenario description to provide a definitive assessment of this scenario. However, it was widely assumed that a government entity bringing a complaint of this nature will likely satisfy the requirement for demonstrating (possibly unregistered) rights (as defined in the Rules and Procedure) in the invoked name. However, even where such rights exist, the registrant may prevail if the disputed domain name is used in the ordinary (dictionary) sense of the term, or less often, for a criticism site (or indeed a fan site) provided that the conditions for such sites as described above in Scenario #4 and #5 are met.

Once rights have been established, panellists will likely rule in favour of the complainant if both the registration and use of the domain is in bad faith, such as if the registrant uses as a phishing scam, or if the registrant is using the domain name for commercial purposes.

Specific variances worth noting are listed here.

- Under JP-DRP, it is understood that this type of case would never occur because Japanese registrars will filter the registrations and request the necessary documents from government authorities or agencies under the Japanese authority's jurisdiction, or government-affiliated corporations or any other organisations. Therefore, it is practically impossible for unofficial organisations to obtain official domains.

- euADR panellists would defer to Regulation (EC) No 874/2004 of 28 April 2004, which concerns the implementation and functions of the .eu TLD (known as PPR). PPR sets out a so-called 'sunrise period' for public bodies to register the complete name of the organisational body for which they are responsible. If the public body did not apply for the domain name regarding the name of the organisation during this sunrise period, it can no longer rely on the benefits of PPR and has to prove the name being protected by national and/or Community law.
- The CNNIC has a reservation list, under which names of countries in the world are normally not open to the public for registration. For example, 'france.cn', cannot be registered unless the application is from the relevant authority of the country concerned.
- Dutch cities and counties (provinces) could rely on the protection granted for the names of Dutch public legal entities. As a result, for example the municipality of Rotterdam would be successful as a complainant in a dispute related to the domain name <rotterdam.nl>.

Experts were generally in agreement that these types of cases comprise less than 5 % of total cases.

SCENARIO #11: SITES THAT INFRINGE INTELLECTUAL PROPERTY RIGHTS SUCH AS TRADE MARKS AND COPYRIGHTS, OR THROUGH WHICH ITEMS THAT INFRINGE INTELLECTUAL PROPERTY RIGHTS, SUCH AS TRADE MARKS OR COPYRIGHTS, ARE OFFERED FOR SALE

Example: A domain that does not infringe any trade mark or copyrights in the domain name itself, but items offered for sale through the website do.

Ruling in favour of respondent in given scenario	Ruling in favour of complainant in given scenario	Rulings dependent on specific variables within scenario	Outside scope of dispute resolution procedure
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	Key Factors
UDRP	• Outside the scope of the dispute resolution procedure.
.auDRP	
.DK	• Except in situations where the generic term that is reflected in the disputed domain name is unambiguously associated with the complainant.
euADR	• Outside the scope of the dispute resolution procedure.
.ITADR	
.UKADR	
CNDRP	
JP-DRP	
usDRP	
.NLADR	

NOTES

In a situation where the domain name itself does not contain any trade mark, copyright, or other protected name owned by the complainant, a panellist will likely find that the dispute is outside the scope of the DRP and refer the complainant to the civil courts where the content of the website itself may be considered for intellectual property infringement.

The exception would be the Danish Domain Board. Although the Board will in most cases rule in favour of the respondent, the weighing of interests between the registrant and the complainant may in rare circumstances fall to the advantage of the complainant. For instance, if *sneakersale.dk* is registered and used by a commercial entity for a website on which it sells counterfeit sneakers of a particular brand, then the brand owner may be considered to have a legitimate interest in getting the domain name transferred that substantially exceeds the interests of the registrant in keeping the domain name, provided that it can be demonstrated that the term 'sneakers on sale' is unambiguously associated with the complaining brand owner. At present, the Board has not decided in cases exactly like the one described, but has decided a number of other cases dealing with the weighing of interests in generic domain names, some of which have been transferred to the complainant. Panellists had never come across a case like this before.

CASE SCENARIO COMPARISONS

Ruling in favour of respondent in given scenario	Ruling in favour of complainant in given scenario	Rulings dependent on specific variables within scenario	Outside scope of dispute resolution procedure
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	#1	#2	#3	#4	#5	#6	#7	#8	#9	#10	#11
UDRP	• If registration is in good faith, ruling in favour of respondent	Only if 'Oki Data test' factors are met	If permission has not been granted by the former business partner	If domain name is not identical to trade mark	Criticism by competing brand is an attempt to use the disputed domain name to disrupt the business of that brand	Ruling depends on whether registration and/or usage is in good or bad faith: Usage of term must be in its generic sense and not targeting the third party trade mark (in the local language if relevant)	Domain names that consist of a common, an obvious, or an intentional misspelling of a well-known trade mark are confusingly similar to the mark and therefore in bad faith	First come, first served principle	First come, first served principle	Ruling depends on whether registration and/or usage is in good or bad faith	Outside scope of dispute resolution procedure
.auDRP	• Subsequent use in bad faith is sufficient	• Interpreted as trade mark infringement								Considered to be bad domain practice	
.DK									• A territory may be protected if registered by responsible entity during 'sunrise period' of PPR		• Gov. org. may be protected if registered by responsible entity during 'sunrise period' of PPR
euADR		• First come, first served principle, except for Italian regions, provinces and municipalities that are reserved and cannot be assigned to any registrant								Ruling depends on whether registration and/or usage is in good or bad faith	
.ITADR									First come, first served principle		Country names cannot be registered under the CNNIC. Abbreviations depend on good/bad faith.
.UKADR	First come, first served principle										
CNDRP		First come, first served principle							Ruling depends on whether registration and/or usage is in good or bad faith		
JP-DRP	Generic terms do not adequately distinguish domain from a mark									Ruling depends on whether registration and/or usage is in good or bad faith	
usDRP		Same as above	Depends on whether registration and/or usage is in good or bad faith								
.NLADR	Depends on 'relevant rights' of Dutch city or county. Other names depend on good/bad faith.			Depends on whether registration and/or usage is in good or bad faith							

Scenario #1: An initial fan page that over time comes to sell competing products.

Scenario #2: An importer of a product registers a ccTLD domain with the same name as the manufacturer's global website.

Scenario #3: A party registers a domain incorporating a former partner's name without the consent of that former partner.

Scenario #4: A fan site domain that is not owned or operated by the person the site refers to.

Scenario #5: An organisation registers a website that is used to criticise a competing brand.

Scenario #6: A domain is registered using a term that is generic in some countries, but not in others.

Scenario #7: A domain that is registered that contains an intentional minor misspelling of a well-known brand name as a means of selling competing products.

Scenario #8: A domain name that relates to the owner's surname, that coincides with a trade mark.

Scenario #9: A domain name that includes country abbreviations combined with new gTLDs such as 'de.travel' instead of 'travel.de'.

Scenario #10: A domain name that incorporates the use of the name of a governmental organisation, where there is no official link to that organisation.

Scenario #11: A domain that does not infringe any trade mark or copyrights in itself, but items offered for sale through the website do.

6 SOURCES AND ACKNOWLEDGEMENTS

This project recruited eleven experts, including two advisors, to support the analysis and provide first-hand knowledge of how a panel is likely to rule in the given case scenarios. Their profiles and areas of expertise are provided in the table below.

#	DRP/DRS	DOMAIN	ROLE
1	Resolution Institute	.au	DRP-specific adviser
2	Asian Domain Name Dispute Resolution Centre (ADNDRC)	.cn	DRP-specific adviser
3	ADR.EU — CAC	.eu	DRP-specific adviser
4	Modified UDRP	.it	DRP-specific adviser
5	JP-DRP	.jp	DRP-specific adviser
6	Modified UDRP	.nl	DRP-specific adviser
7	Nominet	.uk	DRP-specific adviser
8	National Arbitration Forum	.us	DRP-specific adviser
9	UDPR/Danish Domain Name Board	.dk, .com, .org, etc. and various ccTLDs	DRP-specific adviser
10	UDRP	.com, .org, etc. and various ccTLDs	DRP-specific adviser
11	UDRP/nzDRP	.com, .org, etc. and various ccTLDs	DRP-specific adviser

A number of secondary sources have also been consulted during this analysis, which have been referenced in the footnotes on each page. Provided below is a summary chart of the websites consulted for each DRP.

#	gTLD/ ccTLD	DRP	WEBSITES AND PUBLICATIONS
1	All gTLDs adopting UDRP	UDRP	Policy — https://www.icann.org/resources/pages/policy-2012-02-25-en
			Rules — https://www.icann.org/resources/pages/udrp-rules-2015-03-11-en
			WIPO overview of WIPO panel views on selected UDRP questions, third edition — http://www.wipo.int/amc/en/domains/search/overview3.0
			WIPO domain name disputes website — http://www.wipo.int/amc/en/domains/
2	.AU	.AUDRP	Policy — https://www.auda.org.au/policies/index-of-published-policies/2016/2016-01/
			Overview — https://www.auda.org.au/policies/audrp/audrp-overview/
3	.DK	Danish Domain Name Board	Rules — https://www.domaeneklager.dk/en/my-dk
			Annual Report — https://www.domaeneklager.dk/en/node/92
4	.EU	ADR	EU ADR Rules — http://www.wipo.int/amc/en/domains/cctld/eu/index.html

			Overview — http://eu.adr.eu/html/en/handbook_final_for_publication.pdf
5	.IT	Modified UDRP	Regulations — https://www.nic.it/en/docs/dispute-resolution-cctld-it-regulations-version-2-1
			Guidelines — https://www.nic.it/en/docs/dispute-resolution-cctld-it-guidelines-version-3-0
6	.UK	NOMINET DRS	DRS policy — https://s3-eu-west-1.amazonaws.com/nominet-prod/wp-content/uploads/2017/10/17150434/final-proposed-DRS-policy.pdf
			Overview — https://s3-eu-west-1.amazonaws.com/nominet-prod/wp-content/uploads/2017/09/20161122/expert-overview.pdf
7	.CN	CNDRP	Rules — http://www.wipo.int/edocs/lexdocs/laws/en/cn/cn164en.pdf
8	.JP	JP-DRP	Rules — https://www.nic.ad.jp/en/dr/whatis-jpdrp.html
9	.US	.USDRP	Policy — https://www.about.us/policies/ustld-dispute-resolution-policy
10	.NL	Modified UDRP	Rules — https://www.sidn.nl/downloads/procedures/Dispute+Resolution+Regulations+for+nl+Domain+Names.pdf

7 GLOSSARY OF TERMS, ABBREVIATIONS AND CONVERSIONS

ABBREVIATION	DESCRIPTION
2LD	Second level domain
AAA	American Arbitration Association
ACDR	Arab Center for Domain Name Dispute Resolution
ACN	Australia Company Number
ADNDRC	Asian Domain Name Dispute Resolution Centre
ADR	Alternative Dispute Resolution — utilised as a generic term for domains not utilising the UDRP (please also refer to DRP and DRS)
ASIC	Australia Securities and Investments Commission
.AUDA	.au Domain Administration
.AUDRP	Dispute Resolution Policy utilised by .au domain
CCTLD	country code Top-Level Domain
CAC	Czech Arbitration Court
.CNDRP	Dispute Resolution Policy utilised by .cn domain
CIETAC	China International Economic and Trade Arbitration Commission
CNDRP	Dispute Resolution Policy utilised by .cn domain
CNNIC	China Internet Network Information Center
DIFO	Danish Internet Forum
DRP	Dispute Resolution Policy — utilised as a generic term for all domain dispute resolution systems (also referred to as DRS and ADR)
DRS	Dispute Resolution System — the Nominet dispute resolution system
DRSP	Dispute Resolution Service Provider
GTLD	generic Top-Level Domain
HKIAC	Hong Kong International Arbitration Centre
IAMA	The Institute of Arbitrators and Mediators Australia
ICANN	The Internet Corporation for Assigned Names and Numbers
ITADR	Italian Dispute Resolution Service Providers
JIPAC	Japanese Intellectual Property Arbitration Center
JP-DRP	Dispute Resolution Policy utilised by .jp domain
NAF	National Arbitration Forum
PRSD	Prestatori del Servizio di Risoluzione delle Dispute
SIDN	Stichting Internet Domeinregistratie Nederland (Foundation for Internet Domain Registration Netherlands)
STLD	Sponsored top-level domain
TLD	Top-level domain

UDRP	Uniform Domain Name Dispute Resolution Policy — a process first established by the World Intellectual Property Organization (WIPO) and adopted by the Internet Corporation for Assigned Names and Numbers (ICANN) for the resolution of disputes regarding the registration of internet domain names
USDRP	Dispute Resolution Policy utilised by .us domain
WIPO	World Intellectual Property Organization

TERM	DESCRIPTION
BAD FAITH	Broadly understood to occur when a respondent takes unfair advantage of or otherwise abuses a complainant's mark.
COMPLAINANT	The party filing a complaint against a respondent of a domain name.
PANEL	An administrative panel appointed by a DRP to decide a complaint concerning a domain-name registration. A panellist means an individual appointed by a DRP to be a member of a panel.
REGISTRAR	The entity with which the respondent has registered a domain name that is the subject of a complaint. Registrars are normally licensed by the registry operator.
REGISTRANT	Someone who has registered a domain name and agreed to the UDRP in the registration agreement.
REGISTRY OPERATOR	The role of registry operators within the internet ecosystem is to keep the master database of all domain names registered in the TLD under their registry and generate the 'zone file' that allows computers to route internet traffic to and from TLDs anywhere in the world.
RESPONDENT	Another term used for a registrant; used to refer to the party that is expected to respond to a complaint made via the UDRP or other dispute resolution framework.
SUPPLEMENTAL RULES	Rules adopted by a provider administering a proceeding to supplement the main DRP rules. Supplemental rules cannot be inconsistent with the policy itself and cover such topics as fees, word and page limits and guidelines, file size and format modalities, the means for communicating with the provider and the panel, and the form of cover sheets ¹²² .

CURRENCY	EXCHANGE RATE (CONSULTED JUNE 2018)
USD (\$)	EUR 1.16
AUS (\$)	EUR 1.57
DKK (KR.)	EUR 7.46
GBP (£)	EUR 0.88
CNY (¥)	EUR 7.52
JPY (¥)	EUR 127.55

Currencies consulted at <https://www.xe.com/currencyconverter/>

¹²² All of the DRP providers consulted for this study publish supplemental rules on their websites.

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