



## ICANN's Uniform Domain Name Dispute Resolution Policy: A Critical Analysis

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### Abstract

*The rapid expansion of the internet has transformed domain names into valuable business identifiers, intensifying conflicts between trademark holders and domain registrants. To address cybersquatting and abusive registrations, the Internet Corporation for Assigned Names and Numbers (ICANN) introduced the Uniform Domain Name Dispute Resolution Policy (UDRP) in 1999 as a global, contract-based mechanism for dispute settlement. This paper critically analyses the UDRP through the dual lens of trademark protection and digital freedom. While the policy offers a swift, cost-effective, and uniform process that deters cybersquatting, it has been criticized for its limited procedural safeguards, absence of appeals, and inherent bias towards trademark owners. The ambiguities surrounding “bad faith,” “legitimate interest,” and “confusing similarity” have led to inconsistent panel decisions, raising concerns over predictability and fairness. Moreover, the policy’s weak recognition of free expression and fair use undermines the digital rights of registrants, enabling instances of reverse domain name hijacking. The study argues that while the UDRP is effective in combating cybersquatting, its legitimacy as a global dispute resolution system depends on reconciling the competing interests of trademark protection and digital freedom.*

**Keywords:** Uniform Domain Name Dispute Resolution Policy (UDRP), Cybersquatting, Trademark–Domain Name Conflicts, ICANN and DNS Governance, Bad Faith Domain Registration, Online Dispute Resolution Mechanisms

### 1. Introduction

The numerous disputes that arise between trademark owners and domain name registrants are often influenced by the complexity of trading policies, the requirement to promote businesses online, the preference for words that are easy to remember when creating domain names, and the importance of having a business presence

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online. There has been conflict between the two systems as a result of numerous exploitative and opportunistic strategies for profit motives. This conflict is mainly because of the disconnect between the genuine purpose of the domain name system and the reason why intellectual property protection exists.<sup>1</sup> These tactics involve registering domain names for well-known and other trademarks with the sole purpose of selling the domain names to the owners or taking unfair advantage of the reputation associated with those owners. Furthermore, current processes for resolving disputes between trademark owners and domain name holders are ineffective. In reality, they are frequently regarded as expensive, inconvenient, and ineffective. Moreover, the internet is a worldwide system, there is no established norm as to where jurisdiction belongs, rendering traditional judicial proceedings ineffective in dispute settlement. The Uniform Domain Name Dispute Resolution Policy provides the dispute resolution mechanism for resolving disputes arising between domain name holders and trademark owners. It is designed to provide a speedy, cheap and efficient mechanism alternative to the litigation by submitting a dispute to the approved dispute resolution service provider

## **2. Domain Name System**

Developed in the early 1980s, DNS simplified host identification by names instead of numbers.<sup>2</sup>As the host database expanded, it was no longer feasible to store all of these hosts on a single machine so DNS

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<sup>1</sup>Farooq Ahmad, *Domain Name Disputes and Trademark Law, Cyber Law in India* (Law on Internet) 1st Ed. 2001 Pioneer Books, p-174.

<sup>2</sup>David W. Quinto, *Law of Internet Disputes*, 2<sup>nd</sup> Edition 2002 Supp., *Aspen Law and Business* p-1.

was distributed across servers in 1984.<sup>3</sup> In 1992, NSF<sup>4</sup> and NSI<sup>5</sup> signed an agreement for DNS management, with NSI registering domain names. By 1995, NSI outlined a conflict resolution policy amid the lack of centralized internet oversight<sup>6</sup>. John Postel<sup>7</sup> commissioned the creation of the Internet Assigned Numbers Authority (IANA), with a mandate to allocate and coordinate unambiguous (IP) addresses and domain names throughout the internet.

### **a) Privatizing DNS**

Amid criticism of the U.S. control over DNS, President Clinton proposed privatization on July 1, 1997, promoting competition and international participation. Following public comments, NTIA's 1998 Green and White Papers recommended a U.S.-based, private, non-profit DNS coordinating body. The U.S. pledged to transition DNS management to the private sector, with governments retaining control

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<sup>3</sup>Ravandale C. J and Abhijeet Singh; *Domain Name Disputes: Problems and Prospects; Cyberspace and Law Issues and Challenges, Sovenir on National Conference on Cyber Laws and Legal Education*, a publication of NALSAR University Hyderabad 2004 p- 35.

<sup>4</sup> NSF initiated the development of NSF-net which today provides major backbone communication services for internet. In 1991 – 92 NSF assumed responsibility for coordinating and funding the management of non-military application of the internet. It solicited competitive proposals for the proposals for the provision of infrastructure services.

<sup>5</sup>NSI a private company with which lies the administration of registration procedure of domain names in U.S under 1993 agreements. *Trademarks; Intellectual Property Protection on the Information Super Highway EIPR* 1995 pp. 98-487 also see Mohammad Hussain, *Trademarks and Domain name: Conflict and Conciliation, KULR* 2001, p-101.

<sup>6</sup>In US today, the vast majority of domain names are assigned by single registry Network Solution Inc. under contract from NSF. See Anknit Majumdar and Nandan Kamath, *Name Calling in Cyber Space: Domain Names and the Law; Law Relating to Computers, Internet and E-Commerce, 2002 Universal Publication*, P- 215.

<sup>7</sup> Dr. John Postel, was a graduate student of University of California at Los-Angles who played a quintessential role in development of APRA- net in 1970. He looked the task of maintaining the list of names and addresses of host computers on the system and a list of documents called requested for comment. For a short obituary on Dr. John Postel see “*The Death of an Icon*” “*The Economist*”, Oct. 24–03-1998. Also see <http://wipo2.wirjo.int/process /enp/ nrosesshome.html>. (last visited on April 20, 2025).

over cc-TLDs<sup>8</sup>. The National Telecommunications and Information Administration (NTIA) released a White Paper after the comment period ended.<sup>9</sup> The request in the green paper for the formation of a new private, non-profit business to coordinate certain DNS functions for the benefit of the Internet as a whole was confirmed in the white paper.

*“The US government is dedicated to a transition that will allow the private sector to take control of DNS maintenance, while international organisations may provide specific expertise or serve as advisors to the new corporation, the United States, should not be involved in the management of internet names and addresses. Of course, national governments currently have and will continue to have jurisdiction over their own cc-TLDs in terms of management and policy.”<sup>10</sup>*

### **b) Formation of ICANN**

The Internet Corporation for Assigned Names and Numbers (ICANN) was established as a result of a series of events that took place after the original paper was released. The procedure and discussion that surrounding it resulted in the selection of a Chairman, President CEO, and Board of Directors, and the bylaws of ICANN were framed. California serves as the headquarters of the Internet Corporation for Assigned Names and Numbers (ICANN). It is a non-profit organisation, and bases its choices on the opinion of the online community. ICANN has no statutory or other governmental jurisdiction; its authority is solely based on voluntary contracts and global internet community conformity with its policies. It has no power to compel anyone or anybody to do anything; its authority is merely a reflection of willingness.

The White Paper advised the US government to ask the World Intellectual Property Organization (WIPO) to conduct a consultation study on domain name and trademark problems in addition to creating ICANN. After performing the investigation, WIPO sent its final report to ICANN on April 30, 1999. The paper states that all regional

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<sup>8</sup>V. K. Unni, *Trademark and Emerging Concept of Cyber Property Rights* 2002, Eastern Law House, p.-28.

<sup>9</sup> Full text of White Papers is available at [http://www.nita.doc.gov/nitahome/domainname/6-5-98\\_dns.htm](http://www.nita.doc.gov/nitahome/domainname/6-5-98_dns.htm) (last visited on July 20, 2024).

<sup>10</sup> Ibid.

registrars in the .com, .net, and.org TLDs should design and implement a domain name dispute resolution policy. The Uniform Dispute Resolution Policy (UDRP) was developed when ICANN put WIPO's recommendations into practice.

An ICANN consensus policy, known as the Uniform Domain Name Dispute Resolution Policy (the "Policy"), became operative on October 24, 1999. While ICANN staff did not identify any explicit statement of policy goals, but based on a review of UDRP-related documents, community feedback and discussions, the following overarching goals of the UDRP were framed:

- a) An efficient, less expensive, and fair alternative to traditional litigation for cybersquatting cases;
- b) A uniform administrative dispute-resolution procedure for domain name disputes in all gTLDs; and
- c) Effectiveness in addressing specific types of cybersquatting thereby ensures more secure internet.

The registrant's registration agreement, which defines guidelines for domain name registration and usage and disputes between the registrant and third parties, is referred to as the Uniform Dispute Resolution Policy (UDRP).<sup>11</sup>A complainant may challenge any domain name that is confusingly similar to their mark under the UDRP.<sup>12</sup>The regulation provides trademark holders a speedy administrative procedure for contesting "abusive domain name registration," which could result in the registrar suspending or transferring a domain name. Registrants who have been unsuccessful in a UDRP action may seek a "second bite at the apple" by filing a lawsuit in a civil court to get the appropriate remedy.

### 3. Approved Dispute Resolution Service Providers under UDRP

Under UDRP, complainants select from ICANN-approved dispute resolution providers. Currently, six qualified providers handle administrative proceedings:

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<sup>11</sup> Full Text of White Paper Available at <http://www.ntia.doc.gov/ntahome/domainname/6-5-98dns.htm> (last visited on April 20, 2025).

<sup>12</sup> David. W. Quinto, *Law of Internet Disputes*, 2<sup>nd</sup> Ed. 2002 supp., *Aspen Law and Business* p. 4 (7).

- a) **WIPO Arbitration and Mediation Centre (Geneva, Switzerland):** Approved by ICANN on November 29, 1999, WIPO handled the first UDRP case on December 9, 1999.
- b) **National Arbitration Forum (NAF):** Accredited on December 23, 1999, NAF accepted its first case in January 2000.
- c) **Asian Domain Name Dispute Resolution Centre (ADNDRC):** Approved in December 2001, ADNDRC operates with HKIAC and CIETAC.
- d) **Czech Arbitration Court (CAC):** ICANN accredited CAC in January 2008 for UDRP cases.
- e) **Arab Centre for Dispute Resolution (ACDR):** Specializing in the MEAC region, ACDR was established by ASIP and AIPMAS.
- f) **Canada International Internet Dispute Resolution Centre (CIIDRC):** Approved by ICANN in May 2019, CIIDRC launched its complaint system in November 2019.

#### 4. The Uniform Domain-Name Dispute Resolution Policy

UDRP has been adopted by ICANN-accredited registrars in all gTLDs (.aero, .asia, .biz, .cat, .com, .coop, .info, .jobs, .mobi, .museum, .name, .net, .org, .pro, .tel and .travel). According to the Internet Assigned Numbers Authority (IANA) database, there are currently **1,591** registered domain root types (such as .com, .uk, etc.). In total there is about 351.5 million domain name registration available up to second quarter of 2022.<sup>13</sup>

The number of lawsuits filed by each Provider per year that contains one or more domain names based on the Uniform Domain Name Dispute Resolution Policy (UDRP) Status Report prepared by ICANN.org on 3<sup>rd</sup> March 2022<sup>14</sup>, revealed through the data gathered from the websites of the six UDRP Providers. It indicates that more than 38,000 UDRP cases or over 4,800 cases annually on average—have been processed between January 2013 and December 2020. Each of the providers receives about 900 complaints annually on

<sup>13</sup> Available at: [https://www.verisign.com/en\\_US/domain-names/dnib/index.xhtml?loc=en\\_US&section=executive-summary](https://www.verisign.com/en_US/domain-names/dnib/index.xhtml?loc=en_US&section=executive-summary) (last visited on Sep 20, 2022).

<sup>14</sup> Uniform Domain Name Dispute Resolution Policy (UDRP) Status Report Prepared by ICANN.org 3<sup>rd</sup> March 2022 <https://itp.cdn.icann.org/en/files/consensus-policy/udrp-policy-status-report-03-03-2022-03-03-2022-en.pdf> (last visited on March 20, 2025).

average, with WIPO, the largest UDRP Provider, handling more than half of them, followed by Forum. Additionally, since 2014, the number of UDRP complaints filed annually has continuously risen, with the number of domain name disputes filed in 2020 establishing a record. The Table 1 along with Fig. 1 indicates the number of disputes these Providers have received from 2013 to 2020. The continued increase in UDRP submissions globally shows that the UDRP is still a popular and useful instrument and that it is effective enough to be a viable choice for trademark owners to use to combat cybersquatting.

After eight years of record-setting growth, domain name disputes were on the rise again in 2022, with the number of cases across most of the Uniform Domain Name Dispute Resolution Policy (UDRP) providers up 20 percent in the first quarter of the year, as compared with the same quarter in 2021.<sup>15</sup>The number has increased by more than 18 percent in the third quarter of 2023. In 2024, domain name disputes exhibited notable trend, after a decade of consistent growth, the number of decisions under the Uniform Domain Name Dispute Resolution Policy (UDRP) experienced a decline in the third quarter of 2024. Specifically, there was a 6.86% decrease in decisions and a 27.31% reduction in the number of domain names involved compared to the same quarter in the previous year. While there was a temporary decline in UDRP decisions during the third quarter of 2024, the broader trend indicates sustained activity in domain name disputes, reflecting the ongoing challenges trademark owners face in combating cybersquatting.

Since 2013, Reverse Domain Name Hijacking (RDNH) cases have been on the rise, with 2018 being a record-setting year for abusive filings related to Reverse Domain Name Hijacking RDNH involving a total of 917 (Chart 2) Complainants for the 2013 - 2020. In relation to achievement of goal of fairness, the report<sup>16</sup> clearly state that Complainants succeeded in obtaining the disputed domain name in about 78 percent of cases, on average, across all dispute resolution providers during the observation period (2013 - 2020). Over 32,000 UDRP rulings have been made by panels between January 2013 and December 2020 in regard to resolving the misuse. According to UDRP

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<sup>15</sup> Giga Law's Domain Dispute Digest, first quarter, 2022, (last visited Mar 2023).

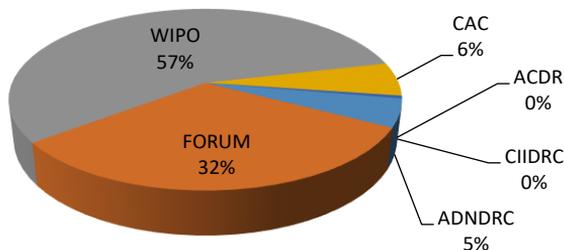
<sup>16</sup>*ibid.*

findings for the 2013 to 2020, there were 300 more complaints filed year on average across all UDRP providers, and there were 7 percent more outcomes in favour of complainants.

**Table 1: disputes received from 2013 to 2020**

Year	ADNDRC	FORUM	WIPO <sup>17</sup>	CAC	ACDR <sup>18</sup>	CIIDRC	Total	Average
2013	183	1597	2585	105	0	N/A	4157	831
2014	226	1433	2634	110	0	N/A	4072	814
2015	245	1410	2754	150	0	N/A	4198	840
2016	249	1320	3036	151	1	N/A	4374	875
2017	221	1465	3074	331	4	N/A	4624	925
2018	217	1636	3447	346	0	0	5169	1034
2019	187	1646	3693	428	4	3	5484	914
2020	189	1926	3561	564	0	31	6271	1045
2021	206	1969	5128	500	128	30	7961	1326
2022	272	2312	4408	572	119	38	7676	1279
2023	59	624	1087	212	0	7	1989	331
2024 <sup>19</sup>	35	555	1175	201	35	16	2017	336
Total	2289	17893	36609	3770	291	125	56971	9495

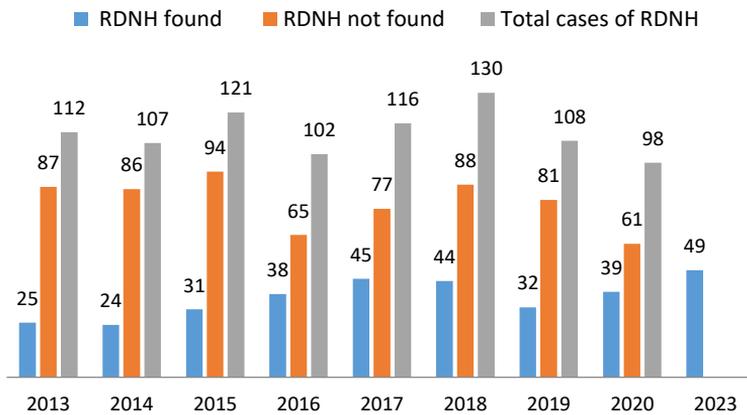
**Fig. 1: Complaints with the Service Providers 2013-2024**



<sup>17</sup>[www.wipo.int/amc/en/domains/statistics/cases.jsp](http://www.wipo.int/amc/en/domains/statistics/cases.jsp) (last visited on September 11, 2022).

<sup>18</sup> <http://acdr.aipmas.org/Default.aspx> (last visited on Oct 20, 2023).

<sup>19</sup>Giga Law's Digest Quarter 1,2,3,4, 2022  
<https://static1.squarespace.com/static/58febfdfcbf629aa913a85974/t/635b4c1aa6daf021404a8ab9/1666927642492/2022-q3-domain-dispute-digest.pdf> (last visited on November 10, 2024).

**Fig. 2: Cases of Reverse Domain Name Hijacking (RDNH) (2013-2020)**

With the filing of its 50,000th “cybersquatting” case in Nov 20,2020, the WIPO Arbitration and Mediation Centre has reached a significant milestone that marks the culmination of two decades of pro-consumer work to ensure that Internet users can readily find legitimate sites for the companies they love and trust. The COVID-19 pandemic has increased the number of cybersquatting complaints submitted to the WIPO Arbitration and Mediation Centre, contributing to this year’s record WIPO filing. The WIPO Centre handled 3,405 cases from January to October 2020, an increase of 11% from the same period in 2019. Erik Wilbers, Director of the WIPO Arbitration and Mediation Centre, commented on the rise in WIPO case filings, said: “With more individuals spending more time online during the epidemic, cybersquatters are finding an increasingly target-rich environment. Meanwhile, as rights holders increasingly rely on online marketing and commerce, they are ramping up their brand enforcement online”.<sup>20</sup> In 2023, the Uniform Domain Name Dispute Resolution Policy (UDRP) experienced a record number of filings, accompanied by an unprecedented rise in cases identified as reverse domain name hijacking (RDNH).<sup>21</sup>

<sup>20</sup> Available at: [www.wipo.int/pressroom/en/articles/2020/article\\_0026.html](http://www.wipo.int/pressroom/en/articles/2020/article_0026.html) (last visited March 06, 2022).

<sup>21</sup> Attorney John Berryhill’s analysis of data from the World Intellectual Property Organization (WIPO) and the Forum, available at;

## 5. UDRP and its Objectives

The UDRP was adopted by ICANN to establish a globally accepted dispute resolution system, ensuring legitimacy, consistency, and standardized rules for conflicts involving trademark owners and domain name registrants. It was designed to handle only “abusive registrations” and reduce legal expenses for trademark holders. Incorporated into registrant agreements, the UDRP governs disputes between registrants and third parties. Accredited providers began receiving complaints in December 1999, and full implementation started on January 3, 2000. Its limited scope ensures that only abusive registrations, not competing legitimate claims, are addressed.

### 5.1 UDRP Proceedings

The proceedings of UDRP are mandatory. To settle domain name disputes, the Uniform Domain Name Dispute Resolution Policy (UDRP) provides an expedited administrative procedure.<sup>22</sup> It starts with the filing of complaint by trademark owner against the domain name registrant for abusive registration of domain name or against cybersquatter. Since it is evident that those responsible for such actions would never submit to procedure voluntarily, it is made mandatory.<sup>23</sup>

These processes take place in front of a certified dispute resolution service provider.<sup>24</sup> Currently, accredited providers available are

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<https://domainnamewire.com/2024/01/26/reverse-domain-name-hijacking-cases-hit-record-high-in-2023> (last visited on January 11, 2025).

<sup>22</sup> An administrative proceeding may be defined as a process in which two parties present their respective views of a conflict to a neutral and impartial third party, the panel see <http://www.resolution.ca/services/dnd/arb.html>. (last visited on January 11, 2025).

<sup>23</sup> V. K. Unni, *Trademark and Emerging Concepts of Cyber Property Rights*, 1st Ed. 2002, Eastern Law House p- 69.

<sup>24</sup> The list of providers is available at <http://www.cann.org/urdp/approved/providers.html>. (last visited on February 10, 2025).

WIPO<sup>25</sup>, National Arbitration Forum (NAF)<sup>26</sup>, dispute.org/e-resolution consortium<sup>27</sup>, CPR Institute for Dispute Resolution<sup>28</sup>, ADNDRC<sup>29</sup>. UDRP must be followed by all registrars in the .com, .net, and .org top level domains. Since the adoption of the UDRP, the most well-known provider of dispute resolution has so far been WIPO.

## 5.2 UDRP Application Requirements

The UDRP applies to specific cases involving “abusive registrations.” Complainants initiate the process by filing a complaint with an ICANN-approved dispute resolution provider. Registrants must participate in the mandatory proceeding.

## 5.3 Criteria for Abusive Registration

A domain name is deemed abusive when the complainant proves:

- **Similarity:** The domain name is identical or confusingly similar to the complainant’s trademark.

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<sup>25</sup> World Intellectual Property Organization effective from 1st Dec. 1999. WIPO Arbitration and Mediation Centre became the first authorized administrative proceeding provider, to offer online dispute resolution system in names registered in the .com, net. and org TLD’s. WIPO has developed voluntary guidelines intended to assist administrators of 24 cc-TLD’S to curb abusive and bad faith registration, David. W. Quinto, *Law of Internet Disputes*, 2<sup>nd</sup> Ed. 2002 *supp. Aspen Law and Business* p- 4 & 20.

<sup>26</sup> Effective from 23<sup>rd</sup> Dec. 1999, second administrative proceeding provider to implement UDRP. The cases it tries are “where one party abuses another party’s right by holding a domain name that is confusingly similar to the other party’s trademark or service mark”. It provides decision within 45 days. The decisions are available at <http://arbforum.com/domains/domain-decision/html>. *ibid* p-21. (last visited on February 10, 2025).

<sup>27</sup> Effective from 1st Jan 2002 [www.e-resolution.com/services/and/dcision/](http://www.e-resolution.com/services/and/dcision/).html/ it provides that decision will be rendered within 60 days *ibid*. p- 23. (last visited on February 10, 2025).

<sup>28</sup> Effective from 22 May 2000. <http://cpradr.org/cnn.cases.html>. *ibid* p. 23. (last visited on February 10, 2025).

<sup>29</sup> Effective from Nov. 30, 2001, ICANN has approved the new administrative proceeding provider the Asian Domain Name Dispute Resolution Centre (ADNDRC). ICANN explained that ADNDRC will specialize in resolution of Asian Language Domain Name Disputes. ADNDRC began accepting cases from 28 Feb 2002. *ibid*. P- 24.

- **No Legitimate Interest:** The registrant lacks rights or legitimate interest in the domain name.
- **Bad Faith:** The domain name was registered and used in bad faith.

All three elements must be established. Bad faith is assessed by considering actions such as:

- a) Registering the domain mainly to sell or transfer it for profit beyond documented costs.
- b) Preventing a trademark owner from using a similar domain due to repeated conduct.
- c) Disrupting a competitor's business.
- d) Using the domain to mislead users for commercial gain.

These factors guide arbitration panels in determining abuse

The above elements are only indicative; the arbitration panel may consider other considerations in determining bad faith.

*World Wrestling Federation Entertainment Inc. v. Micheal Bosman*<sup>30</sup> was the first case brought before the WIPO addressing domain name registration and use.

The complaint, the World Wrestling Federation, was a corporation that had registered the trademark/service mark "World Wrestling Federation" between 1985 and 1989. The respondent began registering the domain name [worldwrestlingfederation.com](http://worldwrestlingfederation.com) on October 7th, 1999, for a two-year period. Three days after registering the domain name, on October 10, the respondent informed the complainant of the registration *via* email. He stated that his main motivation for doing so was to sell, rent, or otherwise transfer the domain name to the complainant for a valuable consideration in excess of out-of-pocket costs (\$1,000,00).

In his e-mail, respondent stated that cybersquatting cases "typically accomplish very little and end up costing the companies thousands of dollars in legal fees, wasted time and energy".<sup>31</sup>

The most crucial criterion to evaluate was whether respondent had created a website utilizing the domain name in question or used it in any other way in good faith. Whether the name in question was a

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<sup>30</sup> Case no. D 99 0001 full information *available at* <http://arbitrator.wipo.int/domains/decisions/html/1999/d/199-000/html>. (last visited on February 10, 2025).

<sup>31</sup> *Ibid.*

nickname of the respondent or a member of his family, or was associated with or related to a legitimate interest of the respondent in any other way.

The complainant asserted that the respondent had registered and was making use of a domain name that was identical to its service mark and trademark, that the respondent lacked any legal or legitimate interest in the domain name in question, and that the respondent had registered and was making use of the domain name in question.

The panel in *World Wrestling Federation* determined that the respondent's domain name was identical to the complainant's registered trademark and that the respondent had no legitimate claim to it. Registered in bad faith, the domain name was offered for sale at an inflated price shortly after registration. Similarly, in *InfoSpace.com, Inc. v. Hari Prakash*<sup>32</sup>, the panel ruled that adding "India" to a domain name similar to "Infospace" created confusion, leading users to think it was related to the complainant's Indian operations. This domain was also registered in bad faith, and the complainant received control of it. Under URDP Para 4(a), WIPO considers confusing similarity, legitimate interest, and bad faith in such cases.

To further comprehend the complexities inherent in dispute settlement under the policy, the case of *Red Bull GmbH v. Unasi Management Inc*<sup>33</sup> Red Bull alleged that Unasi's domain, [www.redbull.com](http://www.redbull.com), deceptively imitated Red Bull's brand to mislead users. Unasi's site, displaying links to competing energy drinks, caused confusion due to its similarity to Red Bull's trademark, especially with only the "www" prefix as a distinction. Red Bull argued that Unasi was exploiting its brand reputation for profit. The WIPO panel concluded that the domain name had "deceptive similarity," that Unasi held no legitimate interest, and that the registration was in "bad faith." The panel ruled in favor of Red Bull, ordering domain transfer.

#### **5.4 Complaint Procedure**

Any person or organisation may start an administrative proceeding by submitting a complaint to any ICANN-approved Provider in

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<sup>32</sup> Case No. D2000-0076, available at <http://arbiter.wipo.int/domains/decisions/html/2000/d2000-0076.html> (last visited on February 10, 2025).

<sup>33</sup> *Bull GmbH v. Unasi Management Inc.* 2005 (31) PTC 90 (WIPO).

accordance with the policy and guidelines. However, the ability of providers to take complaints may be temporarily limited owing to capacity restrictions or other factors. In that case, the Provider will reject the complaint and forward it to another Provider.<sup>34</sup>

Except for annexes, the complaint must be presented in physical copy and electronically, and it must include the following, amongst other things:

- a) Request that the complaint be submitted for decision in accordance with the UDRP and its Rules;
- b) Provide the complainant's or his authorised representative's complete address. The complaint of the complainant won't be declared invalid for failing to provide the Respondent's (Registered Name Holder) name and all additional pertinent contact details needed by Section 3 of the UDRP Rules if the Respondent's contact details are not available in registration data or not otherwise known to the complainant or is publicly accessible in RDDS. In this situation, the complainant may submit a Doe complaint. Upon receipt of a "Doe" complaint, the Provider shall give the pertinent contact information of the Registered Name Holder;<sup>35</sup>
- c) Indicate preferred method of communication;
- d) Provide whether the complainant wants to resolve the dispute by a single- or three-member panel and in case three-member panel

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<sup>34</sup> See Rule 3(a) of Rules for UDRP.

<sup>35</sup> In May 2018, the European Union's General Data Protection Regulation (GDPR) went into effect. This resulted in temporary changes to the UDRP, as a registrant's registration data are no longer available in registration data directory services for a significant number of registrations affected by the regulation. On 17 May 2018, the ICANN Board approved the Temporary Specification for gTLD Registration Data ("Temp Spec"), which became effective 25 May 2018. "Appendix E: Uniform Domain Name Dispute Resolution Policy" in the Temp Spec contains supplemental requirements for the Rules for UDRP. For Complainants filing a complaint on or after 25 May 2018,

<https://itp.cdn.icann.org/en/files/consensus-policy/udrp-policy-status-report-03-03-2022-03-03-2022-en.pdf> (last visited on February 10, 2025).

is chosen then provide the name and addresses of three persons among the ICANN'S approved list who will act as panellists.;<sup>36</sup>

- e) Provide with the Respondent's complete address;<sup>37</sup>
- f) Identify the registrar of domain name and specify the domain name subject complaint;
- g) List the trademark(s) or service mark(s) that are the subject of the complaint and describe the goods or services, if any, that each mark is currently associated with or that the complainant anticipates using in the future.<sup>38</sup>

The complainant must provide details in his complaint regarding the following:

- (a) How the domain name(s) is/are identical or confusingly similar to a trademark or service mark in which the complainant has rights;
- (b) Why the Respondent (holder of the domain name) should be considered to have no rights or legitimate interests in respect of the domain name(s) that are the subject of the complaint;
- (c) Why the domain names should be considered to have been registered and used; and
- (d) The complainant must state the remedies he is seeking in his complaint, as well as any other legal processes that have been started or ended in connection with or connected to any of the domain name(s) that are the subject of the complaint. The complaint may apply to more than one domain name, as long as the domain names are all registered by the same person.

After verifying that the complaint complies with the UDRP and its regulations, the Provider must submit it to the Respondent within three calendar days of receiving the fees that the complainant must pay. If he finds any administrative errors in the complaint, he must immediately inform both the complainant and the respondent. If the complainant does not resolve these deficiencies within 5 calendar days, the complaint will be deemed withdrawn, without affecting the complainant's ability to file a subsequent complaint.<sup>39</sup>

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<sup>36</sup>Panellist means an individual appointed by provider to be a member of a panel Rule I of Rules for UDRP.

<sup>37</sup> Respondent means the holder of a domain name registration against which a complaint is initiated. Rule 1 of Rules for UDRP.

<sup>38</sup> See Rule 3 of Rules of UDRP.

<sup>39</sup> Rule 4 also see Graham J. H. Smith, *Internet Law and Regulations*, 2<sup>nd</sup> Ed. 1999, p. 47.

The Provider is in charge of notifying the Respondent of the complaint and using reasonably accessible channels designed to provide the Respondent genuine notice. However, if the Provider receives true notification or takes the necessary steps to do so, he is released from this responsibility<sup>40</sup>.

The administrative proceeding will begin on the day the Provider completes his obligation to deliver the complaint to the Respondent. The Provider must give early notice of the administrative proceeding's start date to the complaint, respondent, affected registrar(s), and ICANN.<sup>41</sup>

The Respondent shall deliver a response to the Provider in hard copy (save for annexes), in electronic form, within twenty (20) days of the date of the commencement of the action.<sup>42</sup> The response must directly respond to the allegations and statements made in the complaint, as well as provide Respondent's grounds for claiming ownership of the disputed domain name.<sup>43</sup> The response should also provide the Respondent's complete address, as well as the address of any Domain Name Disputes and Trademark Law representative authorised to represent the Respondent in the administrative procedure<sup>44</sup>, as well as the Respondent's preferred form of communication.<sup>45</sup>

If the complainant has chosen a single-member panel to hear the complaint, but the Respondent prefers his case to be heard by a three-member panel, he must inform the Provider of his decision.<sup>46</sup> Anyone electing a three-member Panel, whether a complainant or a respondent, should offer the names and contact information for three applicants to serve as Panelists.<sup>47</sup>

The respondent is required to pay one-half of the relevant fees for a three-member panel as specified in the Providers Supplementary Rules where the complainant seeks a single-member panel to decide the dispute while the respondent requests a panel of three. If this

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<sup>40</sup>Rule 2 of Rules of UDRP.

<sup>41</sup> Rule 4(C) of Rules of UDRP.

<sup>42</sup> Rule 5(a) of Rules of UDRP.

<sup>43</sup> Rule 5(a) of Rules of UDRP.

<sup>44</sup> Rule 5(a) (ii) of Rules of UDRP.

<sup>45</sup> Rule 5(a) (iii) of Rules of UDRP.

<sup>46</sup> Rule 5(a) (iv) of Rules of UDRP.

<sup>47</sup> Rule 5(a) (v) of Rules of UDRP.

payment is not made in conjunction with the filing of the answer to the Providers, a single-member Panel will adjudicate the dispute.<sup>48</sup>

The Respondent may ask the Provider to extend the time for filing the response under unusual circumstances. The Provider must authorise the provision before the parties can agree to an extension in writing. If the Respondent does not submit his answer, the Panel will settle the subject on the basis of the complaint.<sup>49</sup>

#### **(i) Rights of a Domain Name Holder**

If it is determined that the evidence provided by the domain name holder in response to the complainant's allegations is relevant to the dispute, it will be considered acceptable. However, if the Panel determines that the domain name holder has rights and legitimate interests in any of the following circumstances, in particular but not exclusively, and on the basis of all available evidence:

- a) That the registrant utilised or made clear plans to use the domain name or a name that is similar to the domain name in conjunction with a legitimate offer to sell goods or services prior to obtaining notice of the dispute;
- b) Despite not having any rights to a trademark or service mark, the registrant (whether an individual, corporation, or other organisation) is well-known for his affiliation with the disputed domain name; or
- c) That the registrant is making a legitimate non-commercial or fair use of the domain name, without intent to deceive consumers or tarnish the trademark or service mark at issue.<sup>50</sup>

#### **(ii) Composition and Powers of UDRP Panel**

UDRP cases are decided by panels comprising experts in intellectual property and internet law. This ensures that the decision-makers possess the requisite knowledge to handle complex trademark and domain name issues. The Provider must maintain and publicly share a list of Panelists' qualifications. The parties will select Panelists from this list. If neither the complainant nor the respondent requests a three-member panel, the Provider must appoint a single Panelist within five calendar days of receiving the respondent's response, with the complainant covering the full cost of the one-member panel.

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<sup>48</sup> Rule 5(c) of Rules of UDRP.

<sup>49</sup> Rule 5(e) of Rules of UDRP.

<sup>50</sup> See UDRP Para 4(c).

If the respondent opts for a three-member Panel, the complainant must submit three Panelist candidates to the Provider within five calendar days after receiving the response. The Provider will attempt to select one Panelist from each party's list. If the selected Panelists cannot be contacted within five days, the Provider will appoint a Panelist from its list. The complainant pays for the full cost of a three-member Panel unless the respondent also selects one. In rare cases (e.g., in-person hearings), the Provider may charge additional fees. The Provider will not proceed with the complaint until the complainant's initial fee is received within 10 calendar days. If not, the complaint will be withdrawn. The Provider will notify the parties of the chosen Panelists and the decision deadline, unless exceptional circumstances arise.

Any concerns regarding a Panelist's objectivity or independence must be reported before their appointment. The Provider must remain impartial and independent. If new concerns arise during the process, the Provider may replace the Panelist.

Unilateral communication with the Panel is prohibited; all communication must go through the Provider's case administrator. In exceptional cases, the Panel may extend deadlines or combine related domain name disputes. There will be no in-person hearings unless the Panel determines one is necessary in extraordinary circumstances.

If a party fails to comply with any deadlines, the Panel may proceed with the case and draw appropriate inferences from non-compliance. The administrative proceeding will be conducted in the language of the Registration Agreement unless otherwise agreed or specified. The Panel may also require translations of documents into the proceeding's language.

### **(iii) Remedies**

All domain name disputes, regardless of their nature, are not covered by the UDRP, and the available remedies are likewise constrained. The complaint has two options for redress:

- (1) Domain name in issue deletion; and
- (2) Transfer of the disputed domain name to the complainant.<sup>51</sup>

The Panelists do not have powers to grant compensation or award or costs.

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<sup>51</sup>Paragraph 21 of UDRP.

**(iv) Panel Decision Enforcement Process**

The complaint will be resolved by the Panel using the testimony and required documents in line with the policy, its laws, and any other applicable rules and legal precepts.<sup>52</sup> Except in rare situations, the Panel must send its decision on the complaint to the Provider within fourteen days after its appointment.<sup>53</sup> The decision must be in writing, and it must include the reasons for the decision, as well as the date it was made and the names of the Panelists.<sup>54</sup> When a three-member Panel is formed, the Panel's decision is made by a majority of the members.<sup>55</sup>

If the Panel determines that the complaint does not fall within the scope of the policy, it will so express in its ruling. The Panel shall state in its ruling that the complaint was lodged in bad faith and constitutes an abuse of the administrative proceeding,<sup>56</sup> if it determines after reviewing the submissions that it was made in an effort to harass the domain name holder or to engage in reverse domain name hijacking.<sup>57</sup> Within three calendar days of obtaining the Panel's decision, the Provider must send the whole decision to all parties, including the relevant Registrar(s) and ICANN. Each party, the Provider, and ICANN shall receive early notification of the date on which the decision will be implemented in compliance with the policy from the impacted Registrar(s).<sup>58</sup>

Unless the Panel decides to omit portions of its decision in an extraordinary scenario, the Provider must publish the whole decision along with the date of implementation on an easily accessible website.<sup>59</sup> Any decision that determines whether a complaint was brought in bad faith must, in any case, make that section public.<sup>60</sup>

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<sup>52</sup> Rule 15(a) of Rules of UDRP.

<sup>53</sup> Rule 15(b) of Rules of UDRP.

<sup>54</sup> Rule 15(d) of Rules of UDRP.

<sup>55</sup> Rule 14(a) of Rules of UDRP.

<sup>56</sup> Rule 15(e) of Rules of UDRP.

<sup>57</sup> Reverse Domain Name Hijacking means using the policy in bad faith to attempt to deprive a registered domain-name holder of a domain name see Rule 1 of Rules of UDRP.

<sup>58</sup> Rule 16(a) of Rules of UDRP.

<sup>59</sup> Paragraph 2(J) of UDRP.

<sup>60</sup> Rule 16(b) of Rules of UDRP.

The Panel will stop the administrative process if the parties come to an agreement before the Panel renders its decision, unless a party has good cause to protest within the Panel's allotted time.<sup>61</sup> Unless a party provides legitimate grounds for objection within a window of time set by the Panel, the Panel will end the administrative process if it becomes superfluous or impossible to continue for any reason prior to the Panel's determination.<sup>62</sup>

#### **(v) Court Proceedings (second bite of apple)**

The complainant or respondent may take the dispute before or after the UDRP's required administrative procedure to a court with appropriate jurisdiction for independent adjudication.<sup>63</sup>

If any such judicial procedures have been filed, the Panel will have the authority to decide whether the administrative proceeding should be suspended or terminated, or if it should be continued for a ruling.<sup>64</sup>

During the pendency of an administrative case, the party bringing legal action must quickly notify the Panel and the provider of its decision.<sup>65</sup>

If the Panel finds that the domain name in question should be cancelled or transferred, the Registrar<sup>66</sup> must wait ten business days after being notified of the Panel's decision by the appropriate Provider before acting on it. Unless Respondent submits official documentation (such as a copy of a complaint, file stamped by the (clerk of the court) indicating that the law suit has been filed against the complainant in a court of mutual jurisdiction<sup>67</sup> during that ten-business day period, the Registrar will implement that decision.<sup>68</sup>

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<sup>61</sup> Rule 17(a) of Rules of UDRP.

<sup>62</sup> Rule 17(b) of Rules of UDRP.

<sup>63</sup> Paragraph 4(k) of UDRP.

<sup>64</sup> Rule 18(a) of Rules of UDRP.

<sup>65</sup> Rule 18(b) of Rules of UDRP.

<sup>66</sup> Registrar means the entity with which the Respondent has registered a domain name that is the subject of the complaint. See Rule 1.

<sup>67</sup> Mutual Jurisdiction means a court Jurisdiction at the location of either (a) the principal Office of the Registrar (provided the domain name holder has submitted in its Registration Agreement to that Jurisdiction for court adjudication of disputes concerning or arising from the use of the domain name) or (b) the domain name holder's address as shown for the registration of the domain name in Registrar's who is database at the time the complaint is submitted to the provider, See Rule 1.

<sup>68</sup> Paragraph 4(k) of UDRP.

The Panel's decision will not be implemented after receiving such official documentation, and no further action will be taken until either (a) the Registrar has received satisfactory evidence that the matter has been resolved by the parties, (b) satisfactory evidence has been received indicating that the lawsuit has been dismissed or withdrawn, (c) a copy of an order from such court discussing the lawsuit or stating that the registrant has no right to file has been produced.<sup>69</sup>

**(vi) Ban on Transfers during a Dispute**

Unless the party to whom the domain name registration is being transferred agrees in writing to be bound by the court's or arbitrator's decision, the registrant may not transfer his domain name registration to another holder (a) while a pending administrative proceeding under the UDRP is ongoing, or for a period of fifteen business days after such proceeding is finished; or (b) while a pending court proceeding or arbitration regarding the disputed domain name has been commenced. The Registrar may terminate any domain name registration transfer "to another holder" that is conducted in contravention of the UDRP.<sup>70</sup>

Similarly, during a UDRP administrative procedure or for fifteen working days after the completion of one, the registrant may not transfer domain name registration to another Registrar. The registrant may transfer control of his domain name registration to another Registrar while a court case or arbitration is underway, provided that the disputed domain name is still subject to the measures taken against the registrant in accordance with the terms of the policy.<sup>71</sup>

**(vi) Policy Modifications**

The Registrars maintain the right to modify the policy at any time with ICANN's approval. Prior to going into effect, the revised policy will be accessible at URL for at least thirty days. The policy in effect at the time a complaint is made to the Provider governs the situation. No matter when the disagreement arose—before, during, or after the policy change's effective date—any policy change will be binding on the registrant. The sole course of action for a registrant who objects to

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<sup>69</sup> Paragraph 4(k) of UDRP.

<sup>70</sup> Paragraph 8(a) of UDRP.

<sup>71</sup> Paragraph 8(b) of UDRP.

the policy change is to terminate the registration of his domain name and give up any claims to the registration fee he paid.<sup>72</sup>

It is not only worldwide in character, but also national, so there is no danger of nations retaliating against unjust or oppressive national law produced in another country. ICANN's policy assesses and balances the rights and interests of all parties.<sup>73</sup>

## 6. UDRP Limitations

The UDRP undoubtedly contributes significantly to the out-of-court process that may be utilised globally to settle domain name disputes. The answer to the issue of whether the method is as strict and effective as it should be is difficult to give. The UDRP currently contains the following problems, which may be distinguished:

### (i) Discrimination against trademark owners

The UDRP has gained tremendous popularity among trademark owners. However, several experts and registrants have had issues with the policy. This is due to the fact that, even though the Policy has generally been executed correctly, all three of its essential components have occasionally been misunderstood, misread, or ignored. Some judgements have been made based on arguments that are blatantly contrary to the text requirements. In majority of cases, the policy was applied incorrectly, favoring the complainant. The gripe sites are the clearest illustration of the first element of the policy being eroded.

*Wal-Mart Stores Inc. Walsucks*<sup>74</sup> a case regarding the domain name [www.walmartcanadasucks.com](http://www.walmartcanadasucks.com), defined the basic approach to grip sites. Despite the fact that “users, including potential customers of complainant, are unlikely to conclude that complainant is the sponsor of the identified websites,” the court found that “users, including potential customers of complainant, are unlikely to conclude that complainant is the sponsor of the identified websites.” The panel found the first element of a UDRP claim, confusing similarity, on the surprising assumption that “such users are likely to opt to access the sites, if only to satiate their curiosity.” This rationale is erroneous,

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<sup>72</sup> Policy Paragraph 9.

<sup>73</sup> M. Scott Donahey and Ryan Shiibert *World Wrestling Federation Entertainment Inc v. Michael Bosman: A Legal-Body Slam for Cybersquatters on the web, Computer and High Tech*. LJ 16(2000) at 427.

<sup>74</sup>(2000) WIPO Case No.D2000-0477.

because it also extends trademark holders' rights to uses that are not confusingly similar.

Some critics even contend that by giving complainants the option of provider and covering Panelists' fees<sup>75</sup> Panelists will have a strong incentive to develop a reputation for rendering decisions that are favourable to complainants. It's important to note that providers offer statistics on win/loss records, which act as an indirect form of advertising to trademark owners looking to choose the most complainant-friendly dispute resolution firm.

### **(ii) Vague Definition**

The UDRP was created to offer a standardised process for resolving domain name disputes. Given the multiplicity of current trademark rules and conceptions, it can be difficult to establish uniform standards when the essential phrases are ambiguous and unfamiliar, possibly on purpose. These lines have been read in a number of recorded rulings by different panels in ways that are sharply at conflict with one another. Due to this, even after thousands of judgments, domain name registrants are still uncertain as to whether usage scenarios fall within the categories of "rights or reasonable interests" and "bad faith." Both sides have cited the regulations' ambiguity to support their respective claims.

How extensively the term "usage" can be understood in the context of "bad faith" is one unresolved issue. Despite in absence of any additional overt activity, the tribunal in *Telstra Corporation Limited v. Nuclear marshmallows*,<sup>76</sup> concluded that in some circumstances, registration may be sufficient to convey bad faith. But in *Loblaws Inc.*

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<sup>75</sup> In single-panellist cases, respondents may elect to have a three-person panel, but as they then have to split the (increased) costs with the complainant, few do so and less than 10 of the decisions are made by three-person panel. M. Geist, Fair Com? 2002 <http://aixl.uottawalca/~geist/geistudrp.pdf>. (last visited on February 10, 2025).

<sup>76</sup>(telstra.org) WIPO Case No.D2000-0003 (commenced Jan. 12, 2000), <http://arbiter.wipo.int/domains/decisions/html/d2000-0003.html>. (The complainant was telstra Corporation Limited, the largest company listed on the Australian stock exchange, and the respondent was Nuclear Marshmallows, an unregistered business name of an unidentifiable business entity with an Australian address).

v. *Yogen International*,<sup>77</sup> the respondent was permitted to preserve the name after the panel determined that inactive use did not constitute sufficient proof of “bad faith.” Although it agreed that the domain name may have been registered in bad intent, it decided that the appearance of a standard “under construction” page did not satisfy the necessary proof of bad faith usage.<sup>78</sup>

### **(iii) Appeal to Courts**

The ten-day deadline effectively suggests that those registrants who had legal representation at the initial proceedings will have the opportunity to do so, and it is debatable whether they will have any cause of action. A panel’s decision may only be appealed to a court in certain circumstances (although the ACPA specifically allows for such an action in the United States). The right to ask for judicial review has occasionally, but regularly, been used by domain name registrants. Domain name registrants have occasionally, but frequently, exercised their right to request judicial review. The empirical data shows that just 73 of the over 7,324 UDRP judgements have been appealed in a municipal court.<sup>79</sup>

### **(iv) Generic Names**

Due to their extensive use and the intention to keep the word relevant in a variety of contexts, generic phrases are typically not protected by trademark law. The generic term is often viewed as being in the public domain, despite the fact that it can be coupled with another word or phrase to create a trademark. Generic terms are typically allowed when registering domain names, and in the event of a disagreement, the person who registered the word first is given preference over the

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<sup>77</sup>presidentschoicesocks.com, eResolution Case No.AF-0164 (commenced Apr. 3, 2000), <http://www.eresolution.ca/services/dand/decisions/0164.html>. (last visited on February 10, 2025).

<sup>78</sup>The panel distinguished its opinion from *Telstra* in that the complainant did not deliberately conceal contact information or register the complainant’s actual mark (“President’s Choice” as opposed to “President’s Choice Socks”)

<sup>79</sup> Jones P, *The UDRP-Court Challenge Database (2002) UDRPlaw.net*, available at <http://www.udrplaw.net/udrpappeals.html> (last visited on February 13, 2025).

rest. In *CRS Technology Corp v CondenetInc*<sup>80</sup> (concierge.com), the panel reiterated this logic, holding that in situations where the domain name is a generic word, the first individual or company to register the domain name should triumph.

### **(v) Procedure**

Despite being lauded as one of its benefits, the UDRP's condensed structure might not be appropriate for cases that are more intricate and include several claims and factual allegations. In-person hearings, including teleconferences, videoconferences, and online conferences, are frequently prohibited by administrative panels. In the arbitration procedure, there is no witness, cross-examination, briefing, or discussion, and the only power of discovery available is the opportunity to ask for further documents. Rebuttals are subject to the Panelists' discretion, which is constrained. Facts like trademark rights may be only asserted under the UDRP because it does not have a process for evidence assessment. Although the document does not need to be certified, photocopies of trademark certificates, advertisement copies, and letterheads are frequently provided as evidence to a complaint. When the plaintiff has a common-law mark but no registration to present, the situation becomes substantially more challenging. Despite the fact that many Panelists lack any special experience in trademark law, the panel is frequently asked to decide whether or not contested trademark rights exist.

The panel in *Document Technologies Inc v International Electronic Communications Inc*<sup>81</sup> (htmllease.com) stated that UDRP hearings had a limited capacity. The panel responded to the complainant's contention that cross-examination of the respondent's evidence would establish bad faith registration and use, saying that such a case should be resolved in court such as a United States Court, that allows for a more thorough and ruthless search for the truth. Given the paucity of discovery and, in the regular course, the lack of live testimony, this hearing is not conducive to such credibility

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<sup>80</sup> *CRS Technology Corp v. CondenetInc (concierge.com)*, Arb. Fourm Case No. FA0093547 (commenced Feb. 3, 2000).

<sup>81</sup> *Document Technologies Inc v. International Electronic Communications Inc (htmllease.com)* WIPOCase No. D2000-270 (commenced April 17, 2000).

determinations.” The system is difficult to evaluate due to the UDRP’s weak evidence requirements.

#### **(vi) Choice of the Law**

The UDRP offers little guidance as to which jurisdiction’s laws should take precedence when parties involved are from different countries with contradictory laws. According to section 15(a):

“A panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the policy, rules, and any rules and principles of law that it deems applicable”.

Since various criteria are imposed by national trademark laws for purposes like parody and criticism, Panelists may be forced to weigh the interests and laws of two distinct nations. Numerous instances highlight the ambiguity of the choice of law issue.

Panelists dismissed both parties’ jurisdictional laws in *Tourism and Corporate Automation Ltd v TSI Ltd*.<sup>82</sup> (tourplan.com). A New Zealand complainant with offices in London disputed an Australian citizen’s registration in Australia.

*It was stated by a US panel member that “the UDRP does not specify any mandatory body of law to follow in making a decision therefore I determine that it is not feasible for an arbitrator or panel to be familiar with all bodies of trademark and unfair trade law in all countries reached by the Internet, and that it is therefore sufficient for this proceeding that I am reasonably familiar with US trademark law, and that I would therefore apply US law”.*

#### **(vii) Solutions to the Problem**

If panels were given less discretion, many of the UDRP’s current problems might be resolved, which could be done if the policy was made clearer. The UDRP should be revised to make clear its position on bad faith, grievance sites, geographical indicators and personal names (which are beyond the policy’s purview), as well as the fact that criticism is a legitimate interest (that it is a separate element that the complainant must prove). Future issues, notably inconsistent judgements, may be avoided if an appeal level was added to the system. Inconsistencies in interpretation may be promptly remedied if an appeal panel’s decisions were to be considered binding

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<sup>82</sup>Tourism and Corporate Automation Ltd v. TSI Ltd (tourplan.com) AF-0096.

precedent by subsequent panels. The idea of an appeal level was initially rejected as unnecessary due to the availability of appeal to Courts, and too complicated for the streamlined procedure.<sup>83</sup> However, the appeal to national Courts option has proven ineffective, and an appeal level would not greatly complicate the process if it were kept to a similar timescale as the initial procedure,<sup>84</sup> and if appeals were limited to resolving inconsistencies and questions of interpretation.<sup>85</sup> Even with an internal appeals system, the external constraints of appeals to national courts need to be made more practical. The decision of the panel could still take effect within 10 days, unless the registrant notifies the provider of his intention to bring a Court action. The registrant could then have perhaps 30 days to file in Court. The power of providers to control the allocation of cases to particular Panelists should be eliminated. Instead, each provider should be made to operate a 'cab-rank' rule, where Panelists are allocated cases in a certain order, subject to availability and conflicts of interest.<sup>86</sup> This would require a certain amount of policing by ICANN, but would not be time-consuming, requiring a simple check of published decisions to ensure that all Panelists were here in an approximately the same number of cases.

## 7. Conclusion

UDRP performs an important function to resolve the disputes pertaining to Domain names in an out of court Proceedings that can be implemented on international basis. But there are certain flaws in the present form of the policy raising the questions about the fairness

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<sup>83</sup> WIPO, *The Management of Internet Names and Address: Intellectual Property Issues*, Final Report of WIPO Internet Domain Names Process (1999). Available at <http://wipo2.wipoint/process1/report/finalreport.html> (last visited on February 10, 2025).

<sup>84</sup> Gey P, *Bad Faith Under ICANN's UDRP*, *European Intellectual Property Review*, 23, 2001, 507. (The author suggests that an appeal would at 2 months at most).

<sup>85</sup> See Bernstein D, *Domain Name Dispute Resolution: A Model for the Future?* 2000 <http://arbiter.weipo.int/events/conferences/2000/presentations/vernstein/doc.html> (last visited on February 10, 2025).

<sup>86</sup> See Nominet.uk. *The Dispute Resolution Service*, (2002).

and effectiveness of its procedure as it is biased in favor of trademark holders. It creates an enormous potential reverse Domain name hijacking by threatening the domain name registrants to surrender the domain name thereby threatening registrants to surrender domain names. It provides little guidance as to which law should prevail when parties belong to different jurisdictions. It provides minimum evidentiary requirement for the proceedings, thereby rendering the proceedings difficult to evaluate. It fails to protect fundamental free speech interests including parody and criticism of corporations and its key terms are both vague and unfamiliar.

There have been efforts by the domain name registrants to evolve their own dispute resolution mechanism which has come as a significant development. However, they being formulated on similar lines of UDRP are also not free from loopholes. Moreover, the multiplication of dispute resolution forms and growing number of mechanisms is also a concern for future ahead. Although the UDRP has short comings, nevertheless it has done a commendable job.

## **8. Suggestions**

The UDRP is working effectively on a whole but with the introduction of new Top-Level Domains, the litigation has increased and the chances of potential explosion of disputes are expected if personal domain names (.me extension) get introduced. So, it is suggested that dispute resolution system need to be robust to meet these challenges and it is the need of the hour to incorporate following changes in Uniform Dispute Resolution Policy:

- a) UDRP provides minimum evidentiary requirement for proceedings and gives more discretion to Panelists thereby rendering system difficult to evaluate. It is, therefore, suggested that UDRP shall provide certain guidelines for evidentiary documentation especially for common law mark owners.
- b) UDRP provides little guidance as to which law should prevail when two parties are from different jurisdictions. It is suggested that choice of law provision be made in UDRP to guide disputes among complaints and respondents of diverse jurisdictions.
- c) UDRP's key terms are both vague and unfamiliar. It is therefore suggested that more precise definitions and more examples for the terms like bad faith and legitimate interests be provided.

- d) The UDRP does not provide the reasons for the refusal of cases by providers, so proper guidelines be provided for refusal of cases by these dispute resolution providers.
- e) The remedies under UDRP are limited to cancellation and transfer of disputed domain name. It is suggested that Panelists be given power to grant compensation or award costs so that there will be a fear in the minds of cyber squatters and other infringers of losing both domain name and money, if they indulge in abusive registrations.
- f) Alternate Dispute Resolution mechanism to be incorporated

Another area of concern is the growing casual approach towards the traditional means of dispute settlement by ADR. Since UDRP and other domain name dispute resolution forums take maximum cases with bad faith registration, most of the other problems are not addressed by them. The researcher suggests that possible solutions can be arrived by submitting the disputes to non-adversarial means of ADR like negotiation, mediation and conciliation. Having said that, the researcher does not in any case advocate for substitution of current system by ADR. It is recommended that if bad faith registrations are dealt by UDRP, good faith and honest disputes may be referred to ADR and mechanisms like negotiation, mediation and conciliation needs to be popularized.