

A Brief Review of UDRP: Achievements, Challenges and Recommendations

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1. Introduction

A. The Establishment of UDRP

As early as 1998, the Internet Corporation for Assigned Names and Numbers (“ICANN”) was founded as “an experiment in technical self-management by the global Internet community.”¹ One of its primary management objectives was to tackle the notorious ‘Trademark Dilemma.’ When a trademark is used as a domain name without its owner’s consent, consumers may be misled about the source of the product or service offered on the website, and trademark owners may not be able to protect their rights without very expensive litigation.²

In order to initiate a balanced and transparent process to address the Trademark Dilemma, ICANN had sought comments from the general public as well as assistance from the World Intellectual Property Organization (“WIPO”). The WIPO later suggested the establishment of a “mandatory administrative procedure concerning abusive registrations.”³ In response to the WIPO’s suggestion, in 1999, the Uniform Domain-Name Dispute-Resolution Policy (“UDRP”)⁴ was released and later came into effect.

B. The Operation of UDRP

UDRP provided a mandatory administrative proceeding for a third-party (usually a trademark/service mark owner) to complain about his/her trademark infringements if:

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- 1 the domain name holder's domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- 2 the domain name holder has no rights or legitimate interests in respect of the domain name; and
- 3 the domain name holder's domain name has been registered and is being used in bad faith.⁵

A Complainant should make a complaint to an Approved Dispute Resolution Service Provider⁶ (hereinafter Provider). If the Provider considers that the complaint is in compliance with UDRP's requirements, it would notify the domain name holder (hereinafter Respondent) to respond in twenty days.⁷ Afterwards, the Provider would appoint a one- or three-member panel (Panel) based on a publicly published list of panelists. Within 14 days of the appointment, the Panel would render a decision, which has three possible outcomes: (1) Domain Name Transferred; (2) Complaint Rejected; or (3) Domain Name Cancelled.⁸

If the Provider is not informed that the Respondent has commenced a lawsuit against the Complainant within 10 days from when the decision was made, the decision would be implemented.⁹

2. Achievements

A. A Great Success

Being regarded by scholars as a unique, non-national, low cost dispute resolution mechanism,¹⁰ UDRP has been proved a great success in terms of both caseload and effectiveness.¹¹ Although UDRP is not intended to be a substitute for traditional infringement or Cybersquatting litigation, it has become such in many ways.¹² According to the statistics, total WIPO case filings exceeded 33,000 in 2015, encompassing over 61,000 domain names.¹³ In addition, while UDRP was conceived primarily for application in the gTLDs,¹⁴ it has been increasingly adopted at the level of the ccTLDs via the Domain Name Dispute Resolution policy for country code top level domains.¹⁵ The popularity of UDRP in the ccTLDs will "introduce greater uniformity in domain name dispute resolution at the international level and therefore generate significant economies of scale, which would benefit parties, registration authorities and dispute resolution service providers alike."¹⁶