

February 11, 2011

Intellectual Property Constituency  
UDRP Issue Report Working Group

RE: National Arbitration Forum comments on Uniform Domain Name Dispute Resolution Policy (UDRP)

Dear UDRP Issue Report Working Group:

Thank you for reaching out to the National Arbitration Forum (“Forum”) for comments on the effectiveness of the UDRP to date and suggestions for improvements going forward.

First, the Forum takes no official position on the substantive portion of the UDRP (paragraph 4(a)-(c)). While other Providers might find it within their mandate to advocate for intellectual property considerations, the Forum considers itself neutral and takes no position on that portion of the UDRP.

Second, some of the questions or clarification points mentioned are routinely brought up by parties; the Forum does not necessarily advocate for a specific resolution on those comments and will so note as appropriate.

Third, the Forum urges the Working Group to review its comments submitted December 10, 2010 for the URS (also submitted again with this letter). We believe it’s possible that some of the ideas incorporated into the URS might be considered for inclusion into proposed UDRP changes and we strongly urge the Working Group to consider the pitfalls flagged in that document and address those issues.

Finally, we know there is strong IP Community interest in a “loser pays” model for the UDRP. The Forum takes no position on that topic, but is strongly opposed to any system that requires the Provider to try to collect money from losing Respondents; we are an arbitration provider, not a collection agency.

The Forum hereby submits its specific comments for consideration. The Forum is available for consultation and comment on the likely effect of any proposed recommendations, particularly ideas heretofore unproposed. Indeed, the FORUM strongly encourages the IPC and the Working Group to reach out to the Forum for consultation on matters with which the Forum has significant experience: the procedural implementation of domain name dispute systems.

We submit our comments in order of importance.

1. Include a requirement that the Provider request verification and a lock from the Registrar for each domain name and that the Registrar respond within 48 hours. Currently, there is no provision for this, but Rule 2 requires the Provider to serve the billing address, which we can obtain no other way than through the Registrar, and Policy para. 8 forbids transfer, but we don't have any indication that the Registrar intends to comply. If the Registrar never replies, we are in a position of proceeding without a lock and there is a higher incidence of cyberflight on these cases. Because there is no formal requirement for this, it appears that ICANN's hands are tied—no action can be taken against the Registrars that don't comply. The information we need from the Registrar for each domain name:
  - a. Confirmation that the domain name(s) is/are registered with that Registrar.
  - b. The name and billing address for the registrant(s) (Rule 2)
  - c. Confirmation that the domain name(s) is/are locked. (Policy Para 8)
  - d. The language of the Registration Agreement (Rule 11)
  - e. The expiration date (the Whois often projects it out a year)
  - f. Confirmation that the domain name will not be allowed to expire or be deleted during the pending UDRP proceeding, as provided under the Expired Domain Deletion Policy (EDDP).
  
2. Revise Rule 11(a). Currently the Rule says “Unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.”
  - a. The Rule is impossible to administer as written. The language of the proceedings is determined well before commencement, at the time the domain name is verified by the Registrar, causing Complainant to have to translate the complaint during the deficiency period (see item 3 below). At that point, the case is not commenced and no panel is appointed. Therefore, it's impossible to ask a Panel to determine if the Complaint need not be translated. If we were to “pre-appoint” the Panel, it would remove Respondent's ability to select a three member panel since a Panel would already be appointed.
  - b. We understand that at least one Provider allows the Complainant to send an English language complaint and then only sends the written notice in the language of the registration agreement, allowing the Panel to determine later if everyone was served to the Panel's satisfaction. The problem as we see it is:
    - i. This appears to violate the Rule that the default language is “the language of the administrative proceeding”...that is not the exception.
    - ii. The Respondent was notified of a dispute in its language, but may not have been able to read the pleadings and therefore may not fully comprehend the nature of the Complaint. Respondent also may be more likely to ignore the Complaint as irrelevant or spam/junk mail.

- c. We recommend Rule 11 be amended to either codify the practice outlined in (b) above, or outline a new practice for the Providers, consistent with the UDRP timeline. While this Rule appears sound on its face, it's not until you get into the practical implementation of it that the problems surface.
3. Currently, when a complainant has to translate a complaint, more time is needed than the five (5) day deficiency period. As a result, the Forum has a rule allowing a complainant to withdraw and then refile for a nominal administrative fee. The challenge with this, is that the withdrawal releases any lock that had previously been on the domain name. It would be helpful to write in an allowable extension of the deficiency period, only for use when complainant has to translate. While the UDRP is supposed to be fast, it's clear the UDRP drafters didn't consider the translation issue.
4. Communication and transmission of documents via a portal (Rule 2 except Rule 2(a)). The Forum has developed a portal that its parties may use to upload and access file documents. The system notifies the parties when a new file has been uploaded via email. The only difference is, the parties are not sent an attachment of the document, but are provided with a link to the portal. We would like to:
  - a. See this explicitly addressed and approved.
  - b. Verify and have it explicitly addressed in the UDRP, that a party's burden for copying everyone else is met by a party uploading a file to the portal and the Forum's system notifying everyone of its presence.
  - c. The Forum does not seek to overturn the commencement process as outlined in Rule 2(a).
5. Policy paragraph 8(a). Clarify if the clause beginning "unless the party to whom the domain name registration is transferred agrees..." refers only to preceding romanette (ii) or to both (i) and (ii). We read this paragraph to mean that a domain name may not be transferred during a pending administrative hearing. We interpret the paragraph to mean the rest of the sentence does not apply to UDRP cases but we know that others have a different interpretation. It might also help to clarify if the lifting of a privacy shield constitutes a transfer.
6. Complaints and comments made by parties. The Forum does not necessarily endorse these comments, but passes them along for consideration.
  - a. Is there any recourse for a party when a decision was published per UDRP para 4(j) and Rule 16(b) and the decision was either overturned in court, or the parties agree they don't want the decision out there? [Forum comment: if anything is done to address this, the onus should be on the parties to notify the Provider of the court's decision/party agreement with evidence to the Forum's satisfaction.]
  - b. Paragraph 4(k) outlines how the Registrar needs to be notified. There is no requirement that the Complainant actually be served and in many cases, the Complainant is not served till much later, and only after vocal complaints. There

is also no real requirement as to what constitutes service or even a complaint. We've seen a wide variety of documents passing for a "complaint"—some have turned out to be fraudulent. Also, it would help if the Provider was also provided with a copy of the complaint, as complainants often turn to us to help enforce decisions.

- c. Appeals. Parties have asked for an appeal process.

Finally, with respect to how the UDRP has functioned to date, we make the following observations:

1. The process is fast (on average 42 days, but frequently as few as 28 days when the parties haven't requested Stays).
2. The process is usually hassle-free. Few parties report to us that they have serious problems with having decisions implemented, and in a large number of those cases, it's the complainant who didn't understand how the process worked, or didn't follow up in a timely manner. However, I note that ICANN rarely follows up on Rule 16(a) violations. No matter how many times we bring to ICANN's attention that a Registrar is not notifying the Parties and Provider of the date on which the decision will be implemented, nothing is done about it. Many of the largest registrars are complying, notably, GoDaddy, eNom, and Tucows. Of the ones that don't comply, there are few problems with transfer so it seems the non-compliance has little negative effect. However, for a handful of Asian-based registrars with whom obtaining transfer proves to be most difficult, ICANN isn't enforcing Rule 16(a), which should be the first step in enforcing the decision. The only entity that has leverage over Registrars that don't comply with UDRP Panel Orders is ICANN. So if ICANN is not enforcing 16(a) or a registrar's refusal to contact/work with a prevailing complainant, the UDRP becomes worthless.
3. The UDRP has by-and-large stood the test of time. The Internet has changed drastically since the UDRP was approved and few changes have arisen to really confound the process. We caution ICANN and the Working Group to consider the thousands of UDRP decisions serving as precedent when suggesting substantive changes to the UDRP.

We urge the Working Group and ICANN to include the Forum in discussions regarding potential changes to the UDRP and remain willing to help in any way we can. Again, we thank you for soliciting our comments.

Sincerely,

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