

Summary of UDRP domain name dispute resolution procedure

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Introduction

The UDRP (Uniform Domain Name Dispute Resolution Policy) dispute resolution procedure covers generic top level domains such as .com, .biz, .info, .mobi, .name, .net, .org and some country level domains such as .co.

How the UDRP process works

The UDRP is administered by ICANN through several accredited dispute resolution service providers, the principal one being WIPO (the World Intellectual Property Office).

The UDRP uses an online process (using an online form or emailed Word form) for registering complaints, responses and replies.

What a complainant must prove

If you are the "complainant" you must establish **three** factors:

1. The disputed domain name is **identical or confusingly similar** to a trade mark or service mark in which you have rights; and
2. The respondent has **no rights or legitimate interests** in respect of the disputed domain name; and
3. The disputed domain name has been **registered and is being used** by the respondent in **bad faith**.

How a respondent can defend a complaint

If you are the "respondent" you can argue that:

1. Before the complainant notified you of the dispute, you can show use of, or preparations to use, the disputed domain name in connection with a genuine offering of goods or services; or
2. Your business has been commonly known by the disputed domain name, even if you have acquired no trade mark or service mark rights; or
3. You are making a legitimate non-commercial or fair use of the disputed domain name, without intent for commercial gain, to mislead or divert consumers, or to tarnish the complainant's trade mark or service mark.

Appeals and court proceedings

There is no provision for an appeal of a UDRP decision within the UDRP system.

For a complainant, proceedings under the UDRP do not prevent you from taking action in the High Court in New Zealand to enforce any trade mark or similar rights you may have.

Court proceedings may be issued before, during or after the commencement of UDRP proceedings. If court proceedings are issued before or during the UDRP proceedings, the Panel may suspend or terminate those proceedings.

You may also challenge a UDRP decision if you have a legal right to do so in either the country where the principal office of the domain name Registrar (the person with whom the domain

name was registered) is located, or the country where the domain name registrant is located, as recorded in the Whois details at the time the complaint was filed.

It appears that in some countries (such as the United States), there is a specific right to challenge a UDRP decision.

However, in New Zealand, there is no such specific provision, and the legal options for trying to bring such a challenge appear very limited, if it is in fact possible at all.

Costs – official fees

There is no fee to file a complaint or a response.

Fees are payable by the complainant if the proceedings are referred to a Panel. As at April 2011, the fees are:

- For a complaint involving between 1 and 5 domain names: USD\$1500 (if decided by 1 Panelist) or USD\$4000 (if decided by 3 Panelists).
- For a complaint involving between 6 and 10 domain names: USD\$2000 (if decided by 1 Panelist) or USD\$5000 (if decided by 3 Panelists).

The complainant is usually responsible for paying the fees. However, if the complainant chooses to have the complaint decided by 1 Panelist but the respondent chooses to have the complaint decided by 3 Panelists, then the respondent will have to pay 50% of the fees.

In exceptional circumstances, either the Panel or WIPO may ask the parties to make additional payments to settle the costs of the administrative procedure. For example, if

there are more than 10 domain names in dispute.

Neither party is entitled to an award of costs or damages.

Costs – legal fees

Fees for legal advice are in addition to the above and are determined on a case-by-case basis.

Legal representation

Legal representation is not mandatory in proceedings under the UDRP. However, legal representation is recommended in order to maximise chances of success either as a complainant or respondent.

We are experienced in domain name dispute resolution under the UDRP and can help you with a complaint whether you are the complainant or the respondent.

Disclaimer

The above is provided for general information purposes only and does not take the place of specific legal advice. For more specific advice on all aspects of intellectual property law please contact us.

UDRP procedure overview

Time to resolution: 12 - 14 weeks

