

University of New South Wales Law Research Series

**BEYOND THE GOVERNANCE GAP IN
INTERNATIONAL DOMAIN NAME LAW:
BRINGING THE UDRP IN LINE WITH
INTERNATIONALLY RECOGNIZED HUMAN
RIGHTS**

MONIKA ZALNIERIUTE

forthcoming 2020 56(1) *Stanford Journal of International Law*
[2019] *UNSWLRS* 92

UNSW Law
UNSW Sydney NSW 2052 Australia

E: unswlrs@unsw.edu.au
W: <http://www.law.unsw.edu.au/research/faculty-publications>
AustLII: <http://www.austlii.edu.au/au/journals/UNSWLRS/>
SSRN: <http://www.ssrn.com/link/UNSW-LEG.html>

BEYOND THE GOVERNANCE GAP IN
INTERNATIONAL DOMAIN NAME LAW:
BRINGING THE UDRP IN LINE WITH
INTERNATIONALLY RECOGNIZED
HUMAN RIGHTS

Monika Zalnieriute*

ABSTRACT

This article maps the substantive international human rights implications of the influential Uniform Domain Names Disputes Resolution Policy (“UDRP”). The UDRP is an international legal framework for resolving disputes between trademark owners and domain name holders, created by Internet Corporation for Domain Names and Numbers (“ICANN”)—a multi-stakeholder non-profit corporation, responsible for managing domain names and addresses globally. I sketch out the human rights implications of the substantial aspects of the

• Fellow and Lead of “Technologies and Rule of Law” Research Stream, Allens Hub for Technology, Law and Innovation, Faculty of Law, UNSW Sydney, Australia. I am very grateful to David Lindsay, Kathy Kleiman, Zak Muscovitch, Robin Gross, Stephanie Perrin, and Leah Grolman for their insightful comments on earlier drafts. The author is also grateful to Sophie Kwasny and Lee Hibbard at Council of Europe, and members of the ICANN’s Non-Commercial Users Constituency, in particular Milton Mueller, Farzaneh Badiei, Collin Kurre, Stefania Milan, Niels ten Oever, Vidushi Marda, Aarti Bhavana, Kathy Kleiman and Konstantinos Komaitis, who have worked hard to advocate and promote human rights at ICANN. They stimulated and motivated much of the thinking behind this article.

UDRP from an international perspective because ICANN has recently added a Core Value of respecting “internationally recognized human rights” to its Bylaws, and the UDRP review is underway in 2020. In this article, I analyze the dominant interpretive approaches of UDRP panelists to illustrate how, from an international human rights perspective, the substantive UDRP elements are currently too broad, and lead to problematic outcomes. While international human rights analysis does not automatically generate pinpoint policy prescription, it provides an additional framework to evaluate ICANN’s policies, expanding the focus and range of responses. I argue that a more precise articulation and reflection of the narrow scope and objectives of the UDRP within its substantial elements (including as they are interpreted and applied) is needed if ICANN is to uphold its human rights Core Value and to ensure that the UDRP is interpreted by the panelists as consistently as possible with international human rights principles. I propose several concrete ways to address the problematic substantive aspects of the UDRP from an international human rights perspective. In particular, the upcoming UDRP reform should include: 1) an explicit reaffirmation of the narrow scope and limited objectives of the UDRP; 2) a clear articulation of the relationship between the UDRP objectives and substantive policy elements; 3) a reaffirmation of the cumulative nature of the bad faith requirement; 4) a revision of affirmative defences available to the respondent; 4) an introduction of an additional defence of an unreasonable delay; 5) an introduction of a choice-of-law provision; and 6) a development of “Uniform Consensus View” at ICANN level to increase consistency and reduce the risk of rogue interpretations of the UDRP by panelists. Ultimately, I propose “returning” the UDRP to its original, narrower objectives to reduce the UDRP decisions’ potential to encroach upon fundamental human rights.

TABLE OF CONTENTS

1	<i>Introduction.....</i>	5
	<i>Changing Institutional Context of ICANN.....</i>	8
	<i>Contribution of this Article.....</i>	10
	<i>International Human Rights Analysis to Supplement Earlier US-</i>	
	<i>Focused Literature</i>	12
	<i>Importance of the Human Rights Analysis of the UDRP</i>	14
	<i>Limits and Scope of the Analysis</i>	16
	<i>Structure of the Article</i>	17
2	<i>Domain Names and the Creation of the UDRP.....</i>	18
2.1	Enduring Importance of Domain Names in the Age of Platformization	18
2.2	Early Cybersquatting and The Creation of the UDRP	19
2.3	Controversy over the UDRP and Calls for Reform....	22
2.3.1	Conflicting Views over UDRP Success	22
2.3.2	Calls for Reform and Upcoming Review in 2020	25
3	<i>ICANN and International Human Rights Law</i>	26
3.1	Respect for Human Rights under “Applicable Law”.27	
3.2	ICANN’s Self-Imposed Quasi-Constitutional Limits.29	
3.3	Relevant International Human Rights Framework for the UDRP	30
4	<i>Human Rights Analysis of the Substance of the UDRP: Implications for Freedom of Expression, Equality and Non-Discrimination.....</i>	33
4.1	“Identical or Confusingly Similar to a Trademark or Service Mark”	34
4.1.1	Loosening of Trademark or Service Mark Requirements ...	34
4.1.2	Confusing Similarity with Pejorative Terms	36
4.1.3	Will .sucks Make a Difference?	39
4.1.4	Informational Websites	40
4.2	“No Rights or Legitimate Interests”	43
4.2.1	No Legitimate Interests if Using the Mark in the Domain Name?	44
4.2.2	Special Consideration for U.S. Citizens and Residents?	46
4.3	“Bad Faith”	48
4.3.1	Cumulative Language: Registration and Use	49
4.3.2	Lack of Active Use / Non-Use	50
4.3.3	“Retroactive” Bad Faith Registrations and “Renewals” in Bad Faith	52

4.3.4	Relaxation of the Bad Faith Requirement for Criticism Websites	55
4.4	Three Elements in Action, Three Elements Together	57
5	<i>Fixing the Substance of the UDRP: What should be Done from a Human Rights Perspective?</i>	58
5.1	Explicit Clarification and Reaffirmation of the Narrow Scope and Limited Objectives of the UDRP	59
5.1.1	“Confusing Similarity”	62
5.1.2	“No Rights or Legitimate Interest”	63
5.1.3	“Bad Faith”	63
5.2	Affirmative Defences & Burden of Proof in Practice.	64
5.3	Inclusion of “Unreasonable Delay Defence”	65
5.4	Introduction of a Clear Choice-of-Law Clause.....	66
5.5	Development of a Uniform “Consensus View”	67
6	<i>Conclusion</i>	67

1 Introduction

Domain names are easy to remember alphanumeric codes, such as, for example, *www.apple.com* or *amnesty.org*. Because they contain text—which itself is a form expression—domain names directly affect the human right to freedom of expression,¹ and indirectly the right to freedom of association and assembly.² Sometimes domain names also incorporate elements that might be considered proprietary, such as trademarks. Think about the generic word “Apple,” which is also a trademark of a famous US technology company Apple Inc. or the name of “Amazon” rainforest, which is also trademark of the US technology giant Amazon Inc. This expressive nature of domain names can easily lead to tensions between trademark owners and domain name registrants who might have registered a domain containing the

¹ See Benedek, W., J. Liddicoat, and N. A. N. M. van Eijk, *Comments Relating to Freedom of Expression and Freedom of Association with Regard to New Generic Top-level Domains*, COUNCIL OF EUROPE, DG-I (2012) 4, [http://www.coe.int/t/information/society/documents/DG-I%20\(2012\)%204%20FINAL%20pdf.pdf/](http://www.coe.int/t/information/society/documents/DG-I%20(2012)%204%20FINAL%20pdf.pdf/), visited Sep. 2, 2016 (on the relationship between freedom of expression and the gTLDs). The relationship between the so-called “expression function” of domain names and freedom of expression has also been recognized by the courts: see, e.g., *French Constitutional Council Décision n° 2010-45 QPC du 6 Octobre 2010* § 6, (available at <https://www.conseil-constitutionnel.fr/decision/2010/201045QPC.htm>), (accessed 23 January 2020), official translation into English is available at <https://www.conseil-constitutionnel.fr/en/decision/2010/201045QPC.htm> ((accessed 23 January 2020); U.S. case of *Name.Space, Inc., v. Network Solutions, Inc. and National Science Foundation*, 202 F.3d 573, 577 (2d Cir. 2000), available at <http://www.yale.edu/lawweb/jbalkin/telecom/namespace.pdf> (accessed 23 January 2020).

² Salomon, Eve and Pijl, Kinanya, *Applications to ICANN for Community-based New Generic Top Level Domains (gTLDs): Opportunities and challenges from a human rights perspective*, COUNCIL OF EUROPE DGI (2016), at 17. On gTLDs and the LGBTI community, see generally Monika Zalnieriute, *Digital Rights of LGBTI Communities: A Roadmap for Dual Human Rights Framework*, in WAGNER, B. ET AL (EDS), *RESEARCH HANDBOOK ON HUMAN RIGHTS AND DIGITAL TECHNOLOGIES*, Edward Elgar, 2019; DeNardis, Laura, and Andrea M. Hackl, *Internet control points as LGBT rights mediation*, 19.6 *INFORMATION, COMMUNICATION & SOCIETY* (2016), 753-770; Zalnieriute, M., *The anatomy of neoliberal Internet governance: A queer critical political economy perspective*, in OTTO, DIANNE (ED). *QUEERING INTERNATIONAL LAW*, Routledge, 2017, 67-88.

trademarked name or parts of it (e.g., *applesucks.com*; *amazonbelongstocommunity.org*).

These tensions are addressed in the Uniform Domain Names Disputes Resolution Policy (“UDRP”)³, an international legal framework for resolving disputes between trademark owners and domain name holders. The UDRP primarily concerns economic interests; however, it also affects the exercise of fundamental human rights, such as freedom of expression, or these rights might be ingrained within the UDRP procedure itself, such as the right to fair trial (which I discuss in a separate piece).⁴ In this article, I use an international human rights framework to argue that the substantive policy of the UDRP may not conform with international human rights of freedom of expression, equality and non-discrimination. I suggest that these are not merely technical violations but indications that the UDRP system as a whole may lack basic fairness.

Created in 1998, the UDRP is one of oldest and most controversial policies of Internet Governance, which is defined as “the development and application of shared principles, norms, rules, decision-making procedures, and programs that shape the evolution and use of the Internet.”⁵ The importance of domain names for commercial, political and artistic activity in the digital

³ Information about UDRP is available at ICANN, Uniform Domain-Name Dispute-Resolution Policy, ICANN, <https://www.icann.org/resources/pages/help/dndr/udrp-en>, accessed Dec. 3, 2019. The UDRP consists of three core documents: first, the Uniform Domain Name Dispute Resolution Policy, ICANN, <https://www.icann.org/resources/pages/policy-2012-02-25-en> (“Policy”) which sets out the scope, relief, and basis for mandatory administrative proceedings which may be brought within its ambit; second, the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”) that set out the procedural requirements that must be followed in such a proceeding, available at <https://www.icann.org/resources/pages/udrp-rules-2015-03-11-en>; and third, the “Supplementary Rules” which dispute resolution providers (“DRPs”) have enacted and which provide for additional procedural requirements observed by the particular DRPs.

⁴ Monika Zalnieriute, *Reinvigorating Human Rights in Internet Governance: The UDRP Procedure Through the Lens of International Human Rights Principles*, 43 COLUM. J.L. & ARTS, 197 (2020).

⁵ An influential definition by the Working Group on Internet Governance. See Report of the Working Group on Internet Governance, June 2005, 4. <https://www.wgig.org/docs/WGIGREPORT.pdf> (last visited 24 January 2020).

economy is reflected by the fact that they have been fiercely litigated,⁶ legislated,⁷ and discussed by scholars⁸ and civil society advocates.⁹ The importance of domain names in the digital ecosystem extends well beyond the UDRP (which covers ex post disagreements) and is well illustrated by recent tensions between US technology giant Amazon Inc. and the Brazilian and Peruvian governments over the allocation of .amazon top-level domain name. These tensions lasted from 2012 to 2019, when the U.S. company and its commercial interests prevailed over the public and communal interests in the Amazon rainforest, which were advocated by the governments from South America.¹⁰ In 2020, the UDRP, which could be a potential venue for Brazilian and Peruvian governments to challenge the decision, is set to

⁶ For prominent examples of US litigation, see, e.g., *Panavision Int'l, L.P. v. Toeppen*, 141 F.3d 1316, 1319 (9th Cir. 1998); *Shields v. Zuccarini*, 254 F.3d 476, 481 (3d Cir. 2001).

⁷ For example, in the US, the Congress amended the *Lanham Act* in 1999 to include the *Anti-Cybersquatting Consumer Protection Act* (ACPA), which created a cause of action in federal courts for bad-faith registration of a domain name containing a protected trademark. See 15 U.S.C.A. § 1125 (West 2012).

⁸ The UDRP system has attracted significant scholarly attention. See, e.g., Milton L. Mueller, *Rough Justice: A Statistical Assessment of ICANN's Uniform Dispute Resolution Policy* 17 THE INFORMATION SOCIETY 153, (2001) (analyzing empirics behind the theory that the UDRP system encourages forum-shopping); Michael Fromkin, *ICANN's "Uniform Dispute Resolution Policy" — Causes and (Partial) Cures*, 67 BROOK. L. REV. 605, (2002) (outlining the history of the UDRP and its current shortcomings); DAVID LINDSAY, *INTERNATIONAL DOMAIN NAME LAW: ICANN AND THE UDRP*, Hart Publishing, (2007); Zohar Efroni, *Names as Domains, Names as Marks: Issues Concerning the Interface between Internet Domain Names and Trademark Rights* in PETER K YU (ED), *INTELLECTUAL PROPERTY AND INFORMATION WEALTH: ISSUES AND PRACTICES IN THE DIGITAL AGE*, (2007); Jacqueline Lipton, *Internet Domain Names, Trademarks and Free Speech*, EDWARD ELGAR PUBLISHING, (2010); Konstantinos Komaitis, *The Current State of Domain Name Regulation: Domain Names as Second-Class Citizens in a Mark-Dominated World*, ROUTLEDGE, (2010).

⁹ See, e.g., the work of Domain Names Rights Coalition, (<http://dnrc.tech/what-we-do/>)

which in their own words, “is the first think tank dedicated to supporting the work of the ICANN Community and representatives of domain name holders” (Registrants). See also IP Justice, whose work centers on domain names, ICANN and Internet Governance: IP JUSTICE, <http://www.ipjustice.org/> (last visited 5 December 2020). See also NON-COMMERCIAL USER'S CONSTITUENCY, <http://www.ncuc.org/> (last visited 5 December 2020), who has been the core advocate for the individual users in the domain name policy in ICANN.

¹⁰ See generally ICANN, *Approved Board Resolutions / Special Meeting of the ICANN Board*, ICANN (15 May 2019), <https://www.icann.org/resources/board-material/resolutions-2019-05-15-en#1.c>, accessed 11/11/2019 (ruling on the disagreement between the Amazon corporation and governments of Brazil and Peru).

undergo a comprehensive review.¹¹ Given the high stakes and global scope of domain name disputes, review outcomes will impact many areas of international law and governance, including international economic and intellectual property, international human rights law, cultural heritage, Internet policy and global governance more generally.

Changing Institutional Context of ICANN

The UDRP was created and adopted in 1998 by an Internet Corporation for Assigned Names and Numbers (“ICANN”), which is a private, non-profit corporation, registered in California and founded by the US Department of Commerce in 1998.¹² After more than two decades under US supervision, ICANN is currently undergoing profound institutional reforms, known as the “IANA transition” (IANA standing for Internet Assigned Numbers Authority).¹³ It is beyond the scope of this article to discuss the IANA transition in detail, but in short, until 2016, ICANN’s activities had been supervised by the US government. The National Telecommunications and Information Administration (“NTIA”) supervised ICANN under a contract with the US Department of Commerce.¹⁴ In 2016, the NTIA

¹¹ The UDRP review will be conducted in a second phase of the Rights Protection Mechanisms (RPMs), following an on-going review of the URS and Trademark Clearing House. See Review of all Rights Protection Mechanisms (RPMs) in all gTLDs PDP Working Group Home, <https://community.icann.org/display/RARPMRIAGPWG/Review+of+all+Rights+Protection+Mechanisms+in+all+gTLDs+PDP+Home> (last visited Nov. 11, 2019).

¹² For more about ICANN, see www.icann.org.

¹³ For an overview of the IANA transition, see Kal Raustiala, *An Internet Whole and Free: Why Washington Was Right to Give up Control*, FOREIGN AFF., 96 (2017), 140; Kal Raustiala, *Governing the Internet*, 110.3 AJIL 491, 491–503 (2016); Snyder, Joel, Konstantinos Komaitis, and Andrei Robachevsky *The History of IANA: An Extended Timeline with Citations and Commentary*, INTERNET SOCIETY 1, (2017), available at <https://www.yumpu.com/en/document/view/56851186/the-history-of-iana-an-extended-timeline-with-citations-and-commentary/12>. See Hill, Richard. “Internet governance, multi-stakeholder models, and the IANA transition: shining example or dark side?” 1.2 JOURNAL OF CYBER POLICY 176, (2016) (critiquing IANA transition).

¹⁴ See U.S. DEPARTMENT OF COMMERCE, Award/Contract, No. SA1301-12-CN-0035, October 1, 2012, https://www.ntia.doc.gov/files/ntia/publications/sf_26_pg_1-2-final_award_and_sacs.pdf, (last visited Sept. 20, 2016).

accepted a proposal for transition of the IANA functions to a “global multistakeholder community”,¹⁵ and the original contract of supervision expired in September 2016. It is unclear what exactly this mysterious global community entails, but ICANN operates in line with a principle of multi-stakeholderism, whereby various representatives from private companies, civil society and governments participate in the policy development process.¹⁶ Importantly, as part of the transition proposal, ICANN adopted a bylaw stipulating a new “Core Value”:

In performing its Mission, the following “Core Values” should also guide the decisions and actions of ICANN: ...

(viii) Subject to the limitations set forth in Section 27.2,¹⁷ within the scope of its Mission and other Core Values, respecting internationally recognized human rights as required by applicable law. This Core Value does not create, and shall not be interpreted to create, any obligation on ICANN outside its Mission, or beyond obligations found in applicable law. This Core Value does not obligate ICANN to enforce its human rights obligations, or the human rights obligations of other parties, against other parties.¹⁸

¹⁵ See press release by the NTIA, *NTIA Finds IANA Stewardship Transition Proposal Meets Criteria to Complete Privatization*, <http://www.ntia.doc.gov/press-release/2016/iana-stewardship-transition-proposal-meets-criteria-complete-privatization>, (last visited Nov. 11, 2019).

¹⁶ Monika Zalnieriute, *From Human Rights Aspirations to Enforceable Obligations by Non-State Actors in the Digital Age: The Case of Internet Governance and ICANN*, 21 YALE J.L. & TECH 278, 330 (2019).

¹⁷ Section 27.2 states that the human rights Core Value “shall have no force or effect” until a “framework of interpretation for human rights” is approved by the Board: ICANN, *BYLAWS FOR INTERNET CORPORATION FOR ASSIGNED NAMES AND NUMBERS / A California Nonprofit Public-Benefit Corporation*, ICANN (Nov. 28, 2019), <https://www.icann.org/resources/pages/governance/bylaws-en> (last visited 5 December 2019).

¹⁸ The Bylaw reads: Section 1.2.(b)(viii) of the BYLAWS FOR INTERNET CORPORATION FOR ASSIGNED NAMES AND NUMBERS, A California Nonprofit Public-Benefit Corporation, adopted by ICANN Board on 27 May 2016, read: “Subject to the limitations set forth in Section 27.2, within the scope of its Mission and other Core Values, respecting internationally recognized human rights as required by applicable law. This Core Value does not create, and shall not be interpreted to create, any obligation on ICANN outside its Mission, or beyond obligations found in applicable law. This Core Value does not obligate ICANN to enforce its human rights obligations, or the human rights obligations of other parties, against other parties.” Available at <https://www.icann.org/en/system/files/files/adopted-bylaws-27may16->

Human rights advocates, who have lobbied for human rights in ICANN, consider the adoption of this Core Value “an important milestone.”¹⁹ This milestone also begs a question what kind of ethical and legal obligations ICANN may have to ensure that the upcoming UDRP reform of 2020 is consistent with, and incorporates, the new Core Value of respect for “internationally recognized human rights.” Because domain names, regulated under the UDRP, are essential to the operation of the Internet – which is global - their human rights implications have global reach. This new milestone articulating a respect for “internationally recognized human rights” is particularly relevant, given that the UDRP has global reach and transcends borders and jurisdictions of domestic legal systems. However, lack of clarity around the human rights obligations of private actors, such as ICANN, in international law brings the added value of such milestone for the upcoming UDRP review into question. In particular, it is unclear which “internationally recognized human rights” does the “applicable law” might require ICANN to respect.²⁰ Or even if it does require it to respect any such rights.

Contribution of this Article

In this article I engage with these questions and map international human rights implications of the *substantive*

en.pdf. See CCWG-Accountability Supplemental Final Proposal on Work Stream 1 Recommendations, February 23, 2016, <https://www.icann.org/en/system/files/files/ccwg-accountability-supp-proposal-work-stream-1-recs-23feb16-en.pdf>.

¹⁹ Article 19, ICANN approves its bylaws including commitment to respect human rights ahead of June meeting in Helsinki, <https://www.article19.org/join-the-debate.php/244/view/>, visited 02/05/2017. See, e.g., a short comment by Niels ten Oever, who facilitates the CCWP-HR, and who refers to the human rights Core Value as a “commitment” (implying a stronger obligation in the Bylaws, as commitments are structured separately in the Bylaws) in *Human rights catch up with ICANN*, 16 Feb 2016, <http://www.orfonline.org/article/human-rights-catch-up-with-icann/>, visited 22/03/2018.

²⁰ See Zalnieriute, *supra* note 16.

aspects of the UDRP in order to demonstrate how it may not necessarily respect “internationally recognised human rights.” Given the limited space available, I do not focus on human rights concerns arising from *procedural* dimensions of the UDRP. The procedural aspects have received more attention from scholars, civil society and other actors, who have often called for reforms focused exclusively on these aspects (albeit largely focusing on US legal concepts).²¹ For example, the 2018 UDRP reform proposal by the International Commerce Association recommends numerous procedural changes, while proclaiming that the substantive aspects and wording of the UDRP have served the policy goals very well.²² In a separate article, I argue that procedural aspects of the UDRP, too, are problematic from an international human rights perspective – they include important considerations of due process, the right to a fair trial, and deprivation of peaceful enjoyment of property.²³ In contrast, in this article, I argue that reforming the UDRP procedure alone will not suffice to bring it in line with “internationally recognized human rights” to which ICANN is committed under its updated bylaws. I contend that a changing institutional structure and updated ICANN bylaws necessitate a more precise articulation of the narrow scope and objectives of the UDRP within its substantial elements (including as they are interpreted and applied) in the upcoming UDRP review. Doing so will be necessary for ICANN to uphold its new human rights Core Value and remain accountable to a “global multi-stakeholder community.”

Finally, I will make several concrete proposals to address the UDRP’s human rights shortcomings. These might helpful for the upcoming review set to start in April 2020. I recommend: 1) an

²¹ See, e.g., Michael Froomkin, *ICANN’s “Uniform Dispute Resolution Policy” — Causes and (Partial) Cures*, 67 BROOK. L. REV. 605, 613 *passim* (2002).

²² Internet Commerce Association, UDRP POLICY REFORM PLATFORM 2018: ACCOUNTABILITY, UNIFORMITY, PREDICTABILITY, BALANCE, VERSION 1.1., <https://www.internetcommerce.org/wp-content/uploads/2014/05/ICA-Policy-Platform-Feb-2018-V-1.1.pdf> (last visited Jan. 25, 2020).

²³ See Zalnieriute, *supra* note 4.

explicit reaffirmation of the narrow scope and limited objectives of the UDRP; 2) clear articulation of the relationship between the UDRP objectives and substantive policy elements; 3) reaffirmation of the cumulative nature of the bad faith requirement; 4) the revision of affirmative defences available to the respondent; 5) the introduction of an additional defence of an unreasonable delay; 6) the introduction of a choice-of-law provision; and 7) the development of Uniform Consensus View at the ICANN level to increase consistency and reduce the risk of rogue interpretations of the UDRP by panelists. Ultimately, I propose “returning” the UDRP to its initial, narrower objectives as a path to reducing the potential for UDRP decisions to encroach upon fundamental human rights.

International Human Rights Analysis to Supplement Earlier US-Focused Literature

While scholars and civil society advocates have paid attention to human rights issues in the UDRP in the past, they have largely focused on the application of US legal concepts to the UDRP. Through a US constitutional lens, many US scholars criticise the UDRP for lacking procedural fairness²⁴ and insufficient protecting individuals’ rights to free speech, privacy, and reputation.²⁵ Such a focus is not surprising, because the historical roots of the UDRP and ICANN lie within the US legal context. However, as ICANN transitions from US supervision to a fully private policy-making body, accountable solely to the “global multistakeholder community,” the examination of ICANN’s policies against international, rather than domestic, law seems more viable. An international human rights analysis of the UDRP’s substantial policy aspects in this article adds to the earlier US constitutional law-focused scholarship, and

²⁴ See Froomkin, *supra* note 21, at 675.

²⁵ Jacqueline Lipton, *Celebrity in Cyberspace: A Personality Rights Paradigm for a New Personal Domain Name Dispute Resolution Policy*, 65 WASH & LEE L. REV. 1445, 1451-1453 (2008); Komaitis *supra* note 8, 113-119. .

contributes to the emerging digital constitutionalist efforts.²⁶ While traditional constitutional law and human rights doctrines addressed the abuse of power by nation-states, more recent efforts confronted the practices of private companies and quasi-governmental bodies that coordinate or provide critical Internet services and infrastructure.²⁷ The fuzziness around human rights obligations of private actors, coupled with their growing power and influence over public affairs, has become one of the most pressing human right issues in the digital age.²⁸ The urgency for clarity of human rights obligations of private actors under international law is well illustrated by one of the most controversial decisions made by ICANN in 2019, to assign general top-level domain name “.amazon” exclusively to the US technology company Amazon Inc.²⁹ ICANN allocated .amazon to the tech giant despite objection and resistance from the Brazilian and Peruvian governments, who claimed that granting a private company exclusive rights to the domain would “prevent the use of this domain for purposes of public interest related to

²⁶ See Lex Gill, Dennis Redeker, and Urs Gasser, *Towards digital constitutionalism? Mapping attempts to craft an Internet Bill of Rights*, BERKMAN KLEIN CTR. FOR INTERNET AND SOC’Y (2015), <http://nrs.harvard.edu/urn-3:HUL.InstRepos:28552582> (defining “digital constitutionalism” as an umbrella term for the “constellation of initiatives that have sought to articulate a set of political rights, governance norms, and limitations on the exercise of power on the Internet”). See generally Nicolas Suzor, *The Role of the Rule of Law in Virtual Communities*, 25(4) BERKELEY TECH. L. J. 1817 and Kinfe Michael Yilma, *Privacy and Virtues of Multilateral Digital Constitutionalism—Preliminary Thoughts*, 25(2) INT’L J. L. & INFO. TECH. 115.

²⁷ See generally Nicolas Suzor, *Digital constitutionalism: Using the Rule of Law to Evaluate the Legitimacy of Governance by Platforms*, 4 SOC. MEDIA & SOC’Y 1 (2018); McSweeney, Terrell, *FTC 2.0: Keeping Pace with Online Platforms*, 32 BERKELEY TECH. L.J. 1027 (2017); Luca Belli & Nicolo Zingales, eds., United Nations Internet Governance Forum, *Platform Regulations: How Platforms are Regulated, and How Regulate Us?*, (Dec. 2017). For an overview, see generally Nicolas Suzor, Tess Van Geelen, and Sarah Myers West, *Evaluating the Legitimacy of Platform Governance: A Review of Research and a Shared Research Agenda*, 80 INT’L COMM. GAZETTE 385 (2018).

²⁸ David Kaye, *Report of the Special Rapporteur on the promotion and protection of the right to freedom of opinion and expression to the 35th Session of the Human Rights Council*, A/HRC/35/22 (2017), ¶ 82. See also Joseph Cannataci, UN Special Rapporteur on the Right to Privacy, Presentation at the Internet Governance Forum (Nov. 10, 2015).

²⁹ *Approved Board Resolutions / Special Meeting of the ICANN Board*, ICANN (May 15, 2019), <https://www.icann.org/resources/board-material/resolutions-2019-05-15-en#1.c>.

the protection, promotion and awareness raising on issues related to the Amazon biome.”³⁰

Importance of the Human Rights Analysis of the UDRP

The decision over .amazon, which impacts vast geographic areas of the world, illustrates the need for international human rights analysis of ICANN’s policies. Such international analysis is even more pressing given the sheer numbers of decisions delivered under the UDRP. Between December 1999 and November 2019 the World Intellectual Property Organization (WIPO) alone delivered 45,781 decisions related to domain names.³¹ Some commentators have insisted that domain names are no longer relevant due to an increasing use of search engines to locate Internet content.³² But the domain name industry is growing,³³ as is the number of disputes within it.³⁴ Most importantly, the high-level contestations between powerful actors, such as the recent clash between Amazon and the Brazilian and Peruvian governments, suggest that domain names remain important elements in the Internet ecosystem. They have commercial, geographical, communal, and human rights implications.

³⁰ GAC Early Warning – Submittal Amazon-BR-PE-58086, ICANN (Nov. 20, 2012), <https://gac.icann.org/work-products/public/amazon-br-pe-58086-2012-11-20.pdf?version=1&modificationDate=1353452622000&api=v2>.

³¹ Domain Name Dispute Resolution Statistics, WIPO, <https://www.wipo.int/amc/en/domains/statistics/cases.jsp> (last visited Jan 25, 2020).

³² Lindsay Gellman, *How Search Engines Are Killing Clever URLs: Is there any need for “pizza” when everyone just Googles stuff?* THE ATLANTIC (Dec. 15, 2016), <https://www.theatlantic.com/technology/archive/2016/12/how-search-engines-are-killing-clever-urls/510785/>. See BEN WAGNER, GLOBAL FREE EXPRESSION-GOVERNING THE BOUNDARIES OF INTERNET CONTENT 35-52 (2016). See generally Jude A. Thomas, *Fifteen Years of Fame: The Declining Relevance of Domain Names in the Enduring Conflict Between Trademark and Free Speech Rights*, 11 J. MARSHALL REV. INTELL. PROP. L. 1, 6 (2011).

³³ *Global Domain Names Markets to 2024: .com Still Market Leader, But New gTLDs Fast Catching Up*, PR NEWSWIRE, (14 August 2018) <https://www.prnewswire.com/news-releases/global-domain-names-markets-to-2024-com-still-market-leader-but-new-gtlds-fast-catching-up-300696665.html>.

³⁴ See, e.g., WIPO Statistics, *Total Number of Cases per Year*, WIPO, <http://www.wipo.int/amc/en/domains/statistics/cases.jsp>.

Moreover, international human rights analysis of the UDRP is important as scholars and policy-makers increasingly portray it as an “epitome” of the development of alternative dispute resolution (ADR) mechanisms.³⁵ For these scholars, the ADRs are indispensable for solving global Internet-related disputes, and securing “equitable access to justice,”³⁶ because the resolution of these disputes by national and regional courts facilitates “Internet fragmentation.”³⁷ The dangers of Internet fragmentation have often been overcome by deploying critical parts of Internet’s technical infrastructure, such as DNS, to enforce specific public and private legal regimes on a global level.³⁸ The UDRP is a key example of the imposition of binding legal rules on large numbers of Internet users via control over the DNS. In such context, an international human rights analysis of UDRP is vital in securing the importance of human rights norms in the future development of Internet policy and infrastructure-based governance regimes, as well as quasi-judicial mechanisms, such as ADRs, in digital society more generally.

³⁵ Jacques de Werra, *Alternative Dispute Resolution in Cyberspace: The Need to Adopt Global ADR Mechanisms for Addressing the Challenges of Massive Online Micro-Justice*, 26(2) SWISS. REV. INT’L & EUR. L. 289, 297 (2016).

³⁶ De Werra, *supra* note 35, at 289.

³⁷ On Internet fragmentation, see William J. Drake, Vinton G. Cerf and Wolfgang Kleinwächter, *Internet Fragmentation: An Overview*, (World Econ. Forum Future of the Internet Initiative White Paper, Jan. 2016), http://www3.weforum.org/docs/WEF_FII_Internet_Fragmentation_An_Overview_2016.pdf.

³⁸ See Laura DeNardis, *Hidden Levers of Internet Control: An Infrastructure-Based Theory of Internet Governance*, 15 INFO., COMM. & SOC’Y 720, 721 (2012). See also Samantha Bradshaw and Laura DeNardis, *The Politicization of the Internet’s Domain Name System: Implications for Internet Security, Universality, and Freedom*, 20 NEW MEDIA & SOC’Y 332, 333-334 (2016).

Limits and Scope of the Analysis

In this article, I will not engage in a detailed discussion of the relationship between domain names and trademark law.³⁹ As David Lindsay has suggested, because the UDRP was designed to cover the gap left by the trademark law to address clear-cut cybersquatting cases, it is a *sui generis* legal regime, rather than a subset or a branch of trademark law.⁴⁰ Similarly, I will not question whether domain names are “virtual property,” intellectual property, or not property at all. Many others have done this very well.⁴¹ Nor will I analyze the historical, political and technical background of the UDRP in this article. This has also been done exceptionally well by Michael Froomkin, who was himself involved in drafting the UDRP in the late 1990s.⁴² Moreover, I do not discuss the policy around country-code top level domains (ccTLDs), such as .au (Australia), .br (Brazil) or .in (India),⁴³ even though some ccTLDs use UDRP but is not universally required. Finally, in this article I will not engage with the Uniform Rapid Suspension (URS) system, which supplemented the UDRP when ICANN introduced the new set of generic top level domain names (“gTLDs”) in 2013.⁴⁴ The

³⁹ For a discussion of this relationship, see generally Adam Dunn, *The Relationship between Domain Names and Trademark Law* (Mar. 31, 2014) (unpublished LL.M short thesis, Central European University) (on file with the Central European University Electronic Theses and Dissertations Collection), http://www.etd.ceu.hu/2014/dunn_adam.pdf; Christine Haight Farley, *Convergence and Incongruence: Trademark Law and ICANN's Introduction of New Generic Top-Level Domains*, 25 J. MARSHALL J. COMPUTER & INFO. L. 625 (2007); Jacqueline Lipton, *Bad Faith in Cyberspace: Grounding Domain Name Theory in Trademark, Property, and Restitution*, 23 HARV. J.L. & TECH. 447 (2009).

⁴⁰ For a detailed explanation on the differences between traditional trademark law and cybersquatting law, see Lindsay, *supra* note 9, 123 – 127.

⁴¹ For a summary of this debate, see Milton Mueller, Farzaneh Badiei, *Governing Internet Territory: ICANN, Sovereignty Claims, Property Rights and Country Code Top Level Domains*, 18 COLUM. SCIENCE & TECH. L. REV. 435, 438 (2017). See also Eddie Hurter, *The International Domain Name Classification Debate: Are Domain Names 'Virtual Property', Intellectual Property, Property, or Not Property At All?* 42 COMP. & INT'L L.J. SOUTHERN AFRICA 288, 289 (2009).

⁴² For a historical overview of the UDRP development, see Froomkin, *supra* note 21, at 613.

⁴³ On ccTLDs policy, see Mueller and Badiei, *supra* note 41.

⁴⁴ See *About Uniform Rapid Suspension System*, ICANN, <https://www.icann.org/resources/pages/urs-2013-10-31-en> (accessed 23 January

URS permits only the suspension of a domain name rather than its transfer, but it raises many similar human rights issues as the UDRP. However, these two systems are also substantially different, and I cannot engage with both of them meaningfully in an article of this length.

Structure of the Article

The remainder of this article proceeds as follows. In Part 2, I outline background information on domain names, the UDRP and the varying views over its success. Engaging with international legal theory on human rights obligations of private actors, in Part 3, I critically analyze ICANN's commitments to respect "internationally recognized human rights." In Part 4 I focus on the *substantive* aspects of the UDRP: the conditions that must be established to transfer a domain name from the original registrant. In this section, I demonstrate that the substance of UDRP falls short of internationally recognized human rights to freedom of expression, as well as equality and non-discrimination.⁴⁵ I analyze the dominant view of UDRP panelists on the registration of a trademark as part of the domain name to illustrate how key UDRP elements are currently too broad and lead to outcomes that are problematic from a human rights perspective. In Part 5, I discuss the ways in which the UDRP could be brought in line with "internationally recognized human rights." In particular, I argue that a clearer articulation of the

2020). The URS is currently under review by the "Rights Protections Mechanisms" working group in ICANN. See Rachel Reyes, *Review of All Rights Protection Mechanisms in All gTLDs PDP*, ICANN (Aug. 24, 2016), <https://perma.cc/3BLW-N4JK>.

⁴⁵ The ICANN Human Rights Framework of Interpretation states that there are many "internationally recognized human rights" that might be relevant for a global policy-making body like ICANN under the new Human Rights Core Value. These include, but are not limited to, those spelled out in the Universal Declaration of Human Rights (UDHR), the International Covenant on Civil and Political Rights (ICCPR), and other significant human rights treaties. See ICANN CROSS COMMUNITY WORKING GROUP ON ENHANCING ICANN'S ACCOUNTABILITY, Human Rights Framework of Interpretation ("HR-FOI") Final Report and Recommendations (Mar. 2018), <https://www.icann.org/en/system/files/files/ccwg-acct-ws2-annex-3-hr-foi-final-recs-27mar18-en.pdf>, (last visited Jan. 25, 2020).

objectives of the UDRP is required to ensure that it is interpreted by panelists in ways consistent with human rights norms. I hope to provide some useful perspectives for the upcoming UDRP review, which is set to start after April 2020.

2 Domain Names and the Creation of the UDRP

2.1 Enduring Importance of Domain Names in the Age of Platformization

Domain names date back to the commercialization of the internet in the mid-1990s. Their history is brief, and it has already become relatively common to assert that domain names no longer matter.⁴⁶ At an early point in the development of the Internet's commercial infrastructure, the DNS was an important source of power and who would be "ruling the root," to use iconic words by Milton Mueller, was a key governance question.⁴⁷ Today, however, some commentators argue that domains matter less as users increasingly rely on smartphones, which rarely display domain names⁴⁸ or locate online content using search engines and social platforms.⁴⁹ Some have even described the DNS as an increasingly irrelevant "aging phone book."⁵⁰

Although this could be an overstatement, or simply a provocation, the meaning and social significance of domain names is arguably evolving and will change in the future.⁵¹

⁴⁶ See, e.g., Gellman, *supra* note 32.

⁴⁷ MILTON MUELLER, RULING THE ROOT: INTERNET GOVERNANCE AND THE TAMING OF CYBERSPACE 12, (2002).

⁴⁸ David Lindsay, *Domain Name Governance: "Scheherazade on Steroids"* in RESEARCH HANDBOOK ON ELECTRONIC COMMERCE LAW 545, 546 (John A. Rothchild ed., 2016).

⁴⁹ Thomas, *supra* note 32, at 6.

⁵⁰ Wagner, *supra* note 32, at 319.

⁵¹ Lindsay, *supra* note 48, at 546.

Although people increasingly locate online content through search engines, the domain name industry is still growing, as is the number of disputes. For example, by early in 2018, ICANN introduced more than 1200 new gTLDs into the DNS.⁵² Recent contestation over the *.amazon* top level domain also suggests that accounts of domain names' irrelevance are exaggerated, and that they will continue to play significant social, cultural, political, and commercial roles.⁵³ Given this enduring importance, it is important to ensure that instruments mediating different claims and rights are in line not only with the interests of trademark holders, but also with international human rights norms.

2.2 Early Cybersquatting and The Creation of the UDRP

Domain names are registered on a first-come, first-served basis, without any checks if there is a trademark registered with the text included in the domain name.⁵⁴ This means that anyone can register a domain name with generic words like *apple* or *bell*; geographic names like *amazon* or *barcelona*; and more unique terms like *coca-cola*, *google*, or *michael jackson*. In the early days of the Internet in the 1990s, some users allegedly registered domains including the names of large companies or celebrities, with the hopes that these targets would pay for the transfer.⁵⁵ A well-known example was Dennis Toeppen, who registered over 200 domains in 1995, including names of popular companies such as *www.panavision.com*, *www.deltaairlines.com*, and

⁵² By early 2020, 1200+ new gTLDs had been introduced. See *Delegated Strings, NEW GENERIC TOP-LEVEL DOMAINS*, <https://newgtlds.icann.org/en/program-status/delegated-strings>, (last visited Jan. 25, 2020). The number of domain name disputes under the UDRP has increased steadily since 2003. See, e.g., *Total Number of Cases per Year*, WIPO, <http://www.wipo.int/amc/en/domains/statistics/cases.jsp>, (last visited Jan. 25, 2020.)

⁵³ For similar views, see Lindsay, *supra* note 48, at 546.

⁵⁴ Jessica Litman, *The DNS Wars: Trademarks and the Internet Domain Name System*, 4 J. SMALL & EMERGING BUS. L. 149, 151 (2000).

⁵⁵ See, e.g., Juliet M. Moringiello, *Seizing Domain Names to Enforce Judgments: Looking Back to Look to the Future*, 72 U. CIN. L. REV. 95, 120 (2003).

www.eddiebauer.com.⁵⁶ Companies and scholars alike widely condemned such practice⁵⁷ and district court of California termed it “cybersquatting” in 1998.⁵⁸ Famous cybersquatting examples include *www.madonna.com* (transferred to pop star Madonna in 2000);⁵⁹ *www.peta.org* (transferred to PETA – People for Ethical Treatment of Animals in 2001);⁶⁰ *www.eminemmobile.com* (transferred to pop star Eminem in 2004);⁶¹ *www.jenniferlopez.org* (transferred to pop star Jennifer Lopez in 2009)⁶² and *www.steviewonder.com* (transferred to the pop star Stevie Wonder).⁶³

In response to rising concerns about cybersquatting in the late-1990s, ICANN developed the UDRP - a mandatory policy for resolving domain name disputes. To be more precise, it was created to address only the most obvious cases of cybersquatting, such as those by Dennis Toeppen. All domain name registrants must agree to UDRP in order to register a domain; they consent to arbitrate *any* claims that the domain infringes on the rights of

⁵⁶ See *Panavision Int’l, L.P. v. Toeppen*, 141 F.3d 1316, 1319 (9th Cir. 1998) (“Toeppen has registered domain names for various other companies including Delta Airlines, Neiman Marcus, Eddie Bauer, Lufthansa, and over 100 other marks. Toeppen has attempted to “sell” domain names for other trademarks such as *intermatic.com* to Intermatic, Inc. for \$10,000 and *americanstandard.com* to American Standard, Inc. for \$15,000.”).

⁵⁷ See, e.g., the early literature following the UDRP adoption, all of which condemned cybersquatting; Walker, Luke A., *ICANN’s Uniform Domain Name Dispute Resolution Policy*, 15 BERKELEY TECH. L.J. 289 (2000), at 305-06, see also Cabell, Diane, *Foreign Domain Name Disputes 2000*, THE COMPUTER & INTERNET LAWYER, Oct. 2000, at 15 (discussing recent judicial and legislative developments around the world aimed at cracking down on cybersquatting); Litman, *supra* note 54.

⁵⁸ See *Avery Dennison v. Sumpton*, No. CV 97-407 JSL. United States District Court, C.D. California. March 16, 1998.

⁵⁹ ABC News, *Madonna Wins Web Site from Cybersquatter*, 16 October 2000, <https://abcnews.go.com/amp/Entertainment/story?id=114442&page=1>, visited Dec. 5, 2019.

⁶⁰ Although PETA was pre-UDRP cybersquatting case, ultimately decided in US Federal Court: see *People for the Ethical Treatment of Animals v. Doughney*, 263 F.3d 359 (4th Cir. 2001).

⁶¹ The Guardian, *Eminem wins cybersquatting case*, 23 February 2004, <https://www.theguardian.com/media/2004/apr/22/digitalmedia.technology>, visited May 2, 2017.

⁶² David Goldstein, *Jennifer Lopez wins cybersquatting case*, DomainPulse, April 13, 2009,

<http://www.domainpulse.com/2009/04/13/jennifer-lopez-wins-cybersquatting-case/>

⁶³ *Stevland Morris a/k/a Stevie Wonder v. Unofficial Fan Club*, 2005 c/o Web Master, NAF Case No: FA0453986.

a *trademark* or *service mark* holder.⁶⁴ As I discuss more in my article on the procedural aspects of the UDRP, the proceedings take place entirely online, and the domain name registrant does not get any compensation if her domain is transferred to a trademark owner.⁶⁵ Today, the UDRP is applied in many countries throughout the world and allows trademark holders with domain names in several countries to adjudicate them simultaneously in one proceeding. It was the first policy developed by ICANN, immediately after it was created in 1998. As a mandatory administrative procedure, the UDRP is the only non-judicial, global standard dispute resolution policy for trademark-related disputes.⁶⁶ Since 1998, ICANN has been actively promoting the UDRP to resolve domain name disputes for all generic top level domains (gTLDs), such as .com, .net, and .org. The UDRP also covers many country level top level domains (ccTLDs), such as .au (Australia), .br (Brazil), .mx (Mexico) and .es (Spain). As of 4 July 2016, WIPO has been providing a new domain name dispute resolution service for the .fr, .pm, .re, .tf, .wf and .yt ccTLDs.⁶⁷ Five ICANN-approved dispute resolution service providers carry out domain name disputes: The Asian Domain Name Dispute Resolution Centre, the US-based National Arbitration Forum (“NAF”), World Intellectual Property Organization (“WIPO”), The Czech Arbitration Court Arbitration Center for Internet Disputes, and the Arab Center for Domain Name Dispute Resolution.⁶⁸

⁶⁴ See UDRP Policy, *supra* note 3, Section 4. Mandatory Administrative Proceeding. Consensus Policies are binding on gTLD Registry Operators and ICANN-accredited Registrars, through the agreements each signs with ICANN. Consensus Policies are developed through a formal Policy Development Process within the GNSO.

⁶⁵ See Zalnieriute, *supra* note 4.

⁶⁶ See Froomkin, *supra* note 8; Laurence R. Helfer & Graeme B. Dinwoodie, *Designing Non-National Systems: The Case of the Uniform Domain Name Dispute Resolution Policy*, 43 WM. & MARY L. REV. 141 (2001).

⁶⁷ See full list at WIPO, *Domain Name Dispute Resolution Service for country code top level domains (ccTLDs)*, available at <http://www.wipo.int/amc/en/domains/ccTld/>, visited Sep. 8, 2016.

⁶⁸ See ICANN, *List of Approved Dispute Resolution Service Providers*, ICANN, <http://www.icann.org/en/help/dndr/udrp/providers>, (last visited 23 January 2020).

2.3 Controversy over the UDRP and Calls for Reform

2.3.1 Conflicting Views over UDRP Success

The UDRP has attracted both fans and vocal critics since its adoption in 1998.⁶⁹ The UDRP proponents, the large majority of whom are intellectual property scholars or lawyers, emphasize that the UDRP decisions are fair and the process is quick, inexpensive and simple.⁷⁰ Indeed, looking at WIPO statistics, the procedure seems to be simple and friendly for complainant: 86% of proceedings result in a domain name transfer to the trademark owner; 2% result in cancellation of the domain name, and the domain name owners can keep the domains only about 12% of the time.⁷¹ The worldwide application of the UDRP is seen as eliminating confusion and adding a degree of predictability to a field which would otherwise be an entirely fragmented international system consisting of different regimes.⁷² Most UDRP fans do, however, accept that the policy should be “limited to clear-cut cases of abusive registration and use and is not well suited to complex factual disputes.”⁷³

⁶⁹ Froomkin, *supra* note 20, at 611, summarizing that “The UDRP was controversial even before its birth. On the one hand, trademark owners originally objected that it was too weak and narrow, and would not serve to adequately protect their rights; opponents objected that the courts already adequately protected legitimate trademark interests, and UDRP gave trademark holders de facto rights in excess of those provided by law.”

⁷⁰ For especially enthusiastic positive opinions, see early literature, *e.g.*, Matt Railo, *Trademark Owners Weigh Courts vs. UDRP*, NAT’L L.J., Jul. 24, 2000; M. Scott Donahey and Ryan S. Hilbert, Note, *World Wrestling Federation Entertainment, Inc. v. Michael Bosman: A Legal Body Slam for Cybersquatters on the Web*, 16 SANTA CLARA COMPUTER & HIGH TECHNOLOGY L.J. 421, 427 (2000); Michael L. LiRocchi, Stephen L. Kepler & Robert C. O’Brien, *Trademarks and Internet Domain Names in the Digital Millennium*, 4 UCLA J. INT’L L. & FOR. AFF. 377, 443 (2000); Orrie Dinstein and Elisabeth Cappuyns, *Assessing the First 100 Days of ICANN’s Dispute Plan*, NEW YORK L.J., Jun. 1, 2000, at 1.

⁷¹ See WIPO Statistics, *Case Outcome (Consolidated): All Year*, http://www.wipo.int/amc/en/domains/statistics/decision_rate.jsp?year=, (visited May 2, 2017).

⁷² UDRP Policy, *supra* note 3.

⁷³ Ritchenya A. Shepard, *Counsels’ Domain Name Pains*, NAT’L L.J., Sep. 4, 2000, at p.1.

Critics of the UDRP, on the other hand, stress that the policy defines many terms loosely, so panels have too much freedom to interpret provisions, resulting in inconsistent decisions that may be at odds with the UDRP goals.⁷⁴ Controversial UDRP decisions from early 2000s prompted free speech advocates to decry the UDRP as biased in favour of trademark owners. The (in)famous transfer of the domain *Barcelona.com*, happened not because the registrant did not have rights to it (as required by the UDRP) but because the city (complainant) had “better or legitimate rights.”⁷⁵ Other widely criticized decisions concerned domains appending the terms *sucks* or *fuck* to existing trademarks (e.g., *fuckphilips.com*;⁷⁶ *fuckAOL.com*;⁷⁷ *philipssucks.com* and *cabellasucks.com*⁷⁸). The free speech advocates argued that the UDRP provided an uncontested forum for trademark owners to challenge any domain name that was remotely similar to one of their marks, thereby expanding trademark rights at the expense of free speech rights.⁷⁹ Another

⁷⁴ See Orna Rabinovich-Einy, *The Legitimacy Crisis and the Future of Courts*, 17, CARDOZO J. CONFLICT RESOL. 23, 54 (2015) (summarizing criticisms of the UDRP).

⁷⁵ *Excelentísimo Ayuntamiento de Barcelona v. Barcelona.com, Inc.*, WIPO Arbitration and Mediation Center, Administrative Panel Decision No. D2000-0505, (Aug. 4, 2000), <https://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0505.html> (ordering the transfer of the domain name to the Complainant). For similar controversial decisions, see also *J. Crew International v. Crew.com*, WIPO Arbitration and Mediation Center, Administrative Panel Decision No. D2000-0054, (Apr. 20, 2000), <https://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0054.html> (ordering the transfer of the domain name to the Complainant); *Rockport Boat Line (1994) v. Ganonoque Boat Line Ltd.*, (2000) National Arbitration Forum, File No. FA0004000094653, (May 10, 2000), <https://www.adrforum.com/DomainDecisions/94653.htm>

⁷⁶ See *Koninklijke Phillips Elecs. v. Snelling Domains Best*, WIPO Arbitration and Mediation Center, Administrative Panel Decision No. D2002-1041 (Dec. 16, 2002) <https://www.wipo.int/amc/en/domains/decisions/html/2002/d2002-1041.html> (finding the <fuckphilips.com> domain name to be confusingly similar to Complainant’s PHILLIPS mark).

⁷⁷ *America Online, Inc. v. Tommy Vercetti*, National Arbitration Forum, Decision, Claim Number: FA0403000244091, (April 23, 2004), <https://www.adrforum.com/DomainDecisions/244091.htm>

⁷⁸ *Cabela’s Inc. v. Cupcake Patrol*, National Arbitration Forum, Decision, Claim Number: FA0006000095080, (Aug. 29, 2000), <https://www.adrforum.com/DomainDecisions/95080.htm> (finding the disputed domain name <cabelassucks.com> confusingly similar to Complainant’s mark, “Cabela’s”)

⁷⁹ See Orna Rabinovich-Einy, *The Legitimacy Crisis and the Future of Courts*, 17 CARDOZO J. CONFLICT RESOL. 23, 54 (2015); Froomkin, *supra* note 21, at 96–101. See also Nicholas Smith & Eric Wilbers, *The UDRP: Design Elements of an Effective ADR Mechanism*, 15 AM. REV. INT’L ARB. 215 (2004).

infamous instance where Microsoft Corporation threatened 17 year-old Mike Row over his *www.MikeRowSoft.com* domain in 2004 demonstrated this point.⁸⁰

The uneasiness with human rights concerns raised by the UDRP is also felt in many countries whose constitutions contain similar protections. For example, in 2011 France suspended application of the UDRP to *.fr* domain names.⁸¹ Since 6 July 2016, an updated procedure managed by registry AFNIC in collaboration with the WIPO has been available to resolve *.fr* (France) and *.re* (Reunion Island) domain name disputes.⁸² Similarly, some countries have developed their own more stringent rules for their country ccTLDs.⁸³ This experience signals broader constitutional implications for the future viability of the UDRP as a system, and highlights the need for reform. If the UDRP falls short of the protections in national constitutions and other domestic law, countries may (and should) develop and adopt their own rules for solving domain name disputes, and not just for the country specific top level domains, such as *.fr*, but also generic top level domains. This would, of course, reduce the uniform application of the UDRP that, according to its proponents, makes UDRP valuable.

⁸⁰ Gary Barker, *Teenager takes on a corporate monster*, The Age, (Jan. 21, 2004, 11.00 AM), <http://www.theage.com.au/articles/2004/01/20/1074360769726.html>

⁸¹ Loi 2011-302 du 22 mars 2011 portant diverses dispositions d'adaptation de la législation au droit de l'Union européenne en matière de santé, de travail et de communications électroniques, [Law 2011-302 of March 22, 2011 making various adaptations to European Union health, right-to-work, and electronic communications law] JOURNAL OFFICIEL DE LA RÉPUBLIQUE FRANÇAISE [J.O.] [OFFICIAL GAZETTE OF FRANCE], Mar. 22, 2011, p. 5186 [hereinafter Law 2011-302], <https://perma.cc/5LDF-U9MC>.

⁸² *You've got a friend in UDRP: WIPO's Brian Beckham reveals how new TLDs are affecting the Arbitration and Mediation Center's Workload*, IP PRO MAGAZINE, (Aug. 16, 2016), http://www.ipprotheinternet.com/editorspicks/editorspicks.php?editors_picks_id=123#.V85XBZN97fY (last visited Jun. 9, 2016).

⁸³ See, e.g., CANADIAN UNIFORM DISPUTE RESOLUTION SYSTEM, <https://cira.ca/policy/domain-name/cira-domain-name-dispute-resolution-policy>, (last visited Dec. 6, 2019). On the main differences between the UDRP and CDRP, see Eric Macramalla, *The Key Differences between the Uniform Dispute Resolution Policy & CIRA Domain Name Dispute Resolution Policy*, <http://www.gowlingsondomains.com/UDRP.asp> (last visited Mar. 6, 2018).

2.3.2 Calls for Reform and Upcoming Review in 2020

Calls for the UDRP reform have been made since its very adoption in 1998.⁸⁴ In the early 2000s, some scholars proposed to establish an appellate mechanism to resolve inconsistencies in panelists' interpretations and resulting decisions.⁸⁵ Others advocated expanding the UDRP to cover online copyright disputes.⁸⁶ Some commentators argued for establishing an entirely new international body to remedy the legal and political tensions arising from the UDRP.⁸⁷ These proposals never materialized because the policy has not been subjected to a thorough policy review since its adoption 20 years ago.⁸⁸

The first comprehensive policy review of the UDRP is under way in 2020 and will be conducted in the second phase of the Review of the Rights Protection Mechanisms ("RPMs").⁸⁹ The final report of the first phase of the RPM review is due in April

⁸⁴ See, e.g., Jon G. White, *ICANN's Uniform Domain Name Dispute Resolution Policy in Action*, 16, BERKELEY TECHNOLOGY LAW JOURNAL 229 (2001) (written 1 year after the UDRP was put in place, stating that: "Now that the Policy has been in place for over a year, ICANN should take immediate steps to evaluate the Policy's performance and implement improvements where appropriate", at 248).

⁸⁵ See, e.g., Donahey, Scott, *A Proposal for an Appellate Panel for the Uniform Dispute Resolution Policy*, 18 JOURNAL OF INT'L ARBITRATION, 131 (2001).

⁸⁶ For applying the UDRP for copyright disputes, see, e.g., Steven Tremblay, *The Stop Online Piracy Act: The Latest Manifestation of a Conflict Ripe for Alternative Dispute Resolution*, 15 CARDOZO J. CONFLICT RESOL. 819 (2014); Mark A. Lemley and Anthony R. Reese, *A Quick and Inexpensive System for Resolving Peer-to-Peer Copyright Disputes*, 23 CARDOZO ARTS & ENT. L.J. 1 (2005); Andrew Christie, *The ICANN Domain-Name Dispute Resolution System as a Model for Resolving Other Intellectual Property Disputes on the Internet*, 5 JOURNAL OF WORLD INTELLECTUAL PROPERTY 105 (2002).

⁸⁷ See, e.g., Ben Norton, *Constitutional Internationalization of ICAAN's UDRP*, ARIZ. J. INT'L & COMP. L. 29, 137 (2012).

⁸⁸ ICANN has announced the review of the UDRP several times in the past, but they were inexplicably delayed. Originally, the UDRP review was announced back in 2000, see ICANN BOARD, *Special Meeting of the Board Minutes* (June 6, 2000), <https://www.icann.org/resources/board-material/minutes-2000-06-06-en> (referring to review "later this year"). However, such review has not yet taken place, although it is planned. ICANN has issued Preliminary Issue Reports on the UDRP, which have not led to policy development/review process: see, e.g., ICANN, *Preliminary Issue Report on the Current State of the UDRP*, (May 27, 2011), https://gnso.icann.org/sites/default/files/filefield_24715/prelim-report-current-state-udrp-27may11-en.pdf (last visited Dec. 8, 2018).

⁸⁹ See *New gLTD Program Reviews*, ICANN, <http://newgtlds.icann.org/en/reviews> (last visited 23 January 2020); Generic Names Supporting Org. ("GNSO"), *PDP Review of All Rights Protection Mechanisms in All gTLDs*, ICANN, <https://perma.cc/5GDS-LA28> (last updated Feb. 5, 2019).

2020, after which the UDRP review is set to start.⁹⁰ In its Charter, the Working Group on the RPMs listed many questions related to international human rights, such as “Should the term ‘free speech and the rights of non-commercial registrants’ be expanded to include ‘free speech, freedom of expression and the rights of non-commercial registrants’ to include rights under US law and the United Nations’ Universal Declaration of Human Rights?”⁹¹ and “Are recent and strong ICANN work seeking to understand and incorporate Human Rights into the policy considerations of ICANN relevant to the UDRP or any of the RPMs?”⁹² In light of such questions, an international human rights analysis of the UDRP might prove to be useful in the upcoming review.

3 ICANN and International Human Rights Law

The UDRP was created by ICANN - a private, non-profit body, registered in the USA. As a corporation, ICANN operates in accordance with corporate law, rather than a more traditional public law regime governing public authorities. But even in the U.S., ICANN has largely escaped antitrust (competition law) liability.⁹³ This is despite ICANN’s unique quasi-governmental nature, its public mission overseeing DNS and the fact that it makes policy that has global reach.⁹⁴ This has led some to

⁹⁰ E-mail from Rafik Dammak, Chair of GNSO Council, to author (Nov. 11, 2019) (on file with author and public mailing list cc-humanrights@icann.org) (“RPM is still on [its] phase 1 and final report [is] scheduled for April 2020 based on current timeline provided by the [working group]. Phase 2 which includes the UDRP review should start after but possibly there would be some changes before.”).

⁹¹ WORKING GROUP CHARTER, ICANN (Mar. 16, 2016), <http://gnso.icann.org/en/drafts/rpm-charter-15mar16-en.pdf/> (last visited 23 January, 2020).

⁹² *Supra*, see “Additional Questions and Issues” section.

⁹³ See Justin T. Lepp, *ICANN’s Escape from Antitrust Liability*, 89 WASHINGTON UNIVERSITY LAW REVIEW 931 (2012). See also A. Michael Froomkin and Mark A. Lemley, *ICANN and Antitrust*, 1 U. ILL. L. REV. 1 (2003).

⁹⁴ See Gianpaolo Maria Ruotolo, *Fragments of fragments. The domain name system regulation: global law or informalization of the international legal order?* 33 COMPUTER LAW & SECURITY REVIEW, 159-170 (2017) (regarding ICANN’s quasi-

describe ICANN as a “hybrid intergovernmental-private administration.”⁹⁵ Whatever the label given to ICANN, it is unclear whether it is subject to international human rights law or the law of any other jurisdiction beyond California, where it is based, or U.S. federal law.⁹⁶

3.1 Respect for Human Rights under “Applicable Law”

ICANN Bylaws state that it will respect “internationally recognised human rights as required by applicable law.”⁹⁷ But what is this “applicable law”? International community generally interpret international law as created by and for nation states.⁹⁸ Because international human rights law – at least as it currently stands – is no exception to the general principles of international law, it is also generally understood to apply directly only to states, not private actors.⁹⁹ To come back to our question,

governmental status). See also A. Michael Froomkin, *Wrong Turn in Cyberspace: Using ICANN to Route Around the APA and the Constitution*, 50 DUKE L.J. 17 (2000) (regarding ICANN’s relationship with US public and constitutional law).

⁹⁵ Benedict Kingsbury, Nico Krisch & Richard B. Stewart, *The Emergence of Global Administrative Law*, 68 LAW & CONTEMPORARY PROBLEMS, 15-61 (2002) (describes ICANN as a “hybrid intergovernmental-private administration” which was “established as a non-governmental body, but which has come to include government representatives who have gained considerable powers, often via service on ICANN’s Governmental Advisory Committee, since the 2002 reforms”, 22).

⁹⁶ See Monika Zalnieriute & Thomas Schneider, *ICANN’s procedures and policies in the light of human rights, fundamental freedoms and democratic values*, COUNCIL OF EUROPE DGI (2014) 12 (illustrating that international or European human rights law does not seem to apply to ICANN). See also, Article 29 Data Protection Working Party, *Opinion 2/2003 on the application of the data protection principles to the Whois directories*, WP 76 10972/03 (indicating, however, that EU data protection law may apply to the WHOIS database operated by ICANN, particularly the parts of the database compiled and managed by the European Regional Internet Registry RIPE NCC which is headquartered in Amsterdam).

⁹⁷ See Article 1.2.b(viii) of the BYLAWS FOR INTERNET CORPORATION FOR ASSIGNED NAMES AND NUMBERS, as amended 28 November 2018, <https://www.icann.org/resources/pages/governance/bylaws-en> (last visited Dec. 5, 2017).

⁹⁸ See IAN BROWNLIE, *PRINCIPLES OF PUBLIC INTERNATIONAL LAW*, (5th ed. 1998), 57-58.

⁹⁹ See, e.g., ICCPR Article 2. See also, e.g., International Covenant on Economic, Social, and Cultural Rights art. 2, Dec. 16, 1966, 993 U.N.T.S. 3 [hereinafter ICESCR], https://treaties.un.org/doc/Treaties/1976/01/19760103%2009-57%20PM/Ch_IV_03.pdf (last visited Dec. 6 2019). See also Angela M. Banks, *CEDAW, Compliance, and Custom: Human Rights Enforcement in Sub-Saharan*

it is very unlikely that “applicable law” means international law because ICANN is a private actor.

If no international law, including international human rights law, applies to ICANN, then the “applicable law” under the Bylaw may only refer to national law (or, in the case of EU Member States, it could be directly binding EU law).¹⁰⁰ If this narrow interpretation is correct, the critical question becomes whether the applicable national law in question requires private actors, such as ICANN, to respect “internationally recognized human rights.” The answer will differ from jurisdiction to jurisdiction and partly depend on whether the country in question has ratified international human rights instruments. However, domestic human rights legislation is rarely applicable and enforceable horizontally, that is, between private actors. Put simply, domestic human rights law also does not generally apply to private bodies. It thus could be argued that, apart from certain areas of anti-discrimination laws, data privacy laws, labour standards or prohibitions on gross human rights abuses,¹⁰¹ “applicable law” under ICANN’s Core Value generally does not require ICANN to “respect internationally recognized human rights.” Given such limited application of international and national human rights law to private actors – at least as it currently stands - the new ICANN Core Value on human rights seems to resemble an empty the public relations campaign. With latest negotiation of a Treaty on Business and Human Rights at the United Nations, which would impose directly binding human

Africa, 32 *FORDHAM INT’L L.J.* 781, 782 (2009) (indicating, however, that international legal institutions typically only have advisory powers and are unable to “make” states take particular action). For discussions of these issues in depth, see SURYA DEVA & DAVID BILCHITZ (EDS.), *BUILDING A TREATY ON BUSINESS AND HUMAN RIGHTS: CONTEXT AND CONTOURS* (2017) (forthcoming).

¹⁰⁰ See generally The draft Framework of Interpretation, <https://www.icann.org/en/system/files/files/proposed-foi-hr-04apr17-en.pdf> (last visited Dec. 6 2019) (confirming this line of reasoning and stating that “‘Applicable law’ refers to the body of law that binds ICANN at any given time, in any given circumstance and in any relevant jurisdiction. It consists of statutes, rules, regulations, etcetera, as well as judicial opinions, where appropriate. It is a dynamic concept inasmuch as laws, regulations, etcetera, change over time.”).

¹⁰¹ See generally John H. Knox, *Horizontal Human Rights Law*, 102 *AM. J. INT’L L.* 1 (2008) (for a discussion on the horizontal application for human rights).

rights obligations on private actors under international law, this situation may well change in the future.¹⁰² May it be giving a mere lip service to human rights, rather than imposing any serious legal limits on the exercise of ICANN's powers in its global policy-making?

3.2 ICANN's Self-Imposed Quasi-Constitutional Limits

Importantly, ICANN has also imposed on itself quasi-constitutional limits in its founding documents. According to Article 4 of ICANN's Articles of Incorporation, it "shall operate for the benefit of the Internet community as a whole, carrying out its activities in conformity with relevant principles of international law and applicable international conventions and local law."¹⁰³ Again, with the exception of principles of international criminal law,¹⁰⁴ however, it seems that generally there are no international conventions¹⁰⁵ or principles of international law that might be directly applicable to private actors such as ICANN.

Interestingly, in the international arbitration case concerning the .xxx generic top level domain name ("gTLD"), ICANN suggested that the "relevant principles of international law" under Article 4 of its Articles of Incorporation, refer to those

¹⁰² For more on these efforts, see in particular Monika Zalnieriute, *supra* note 16, at 326-334.

¹⁰³ *Amended and Restated Articles of Incorporation of Internet Corporation for Assigned Names and Numbers*, Art. 4, ICANN (Sept. 30, 2016), <https://perma.cc/4SHY-Y9K6> (emphasis added).

¹⁰⁴ See Rome Statute of the International Criminal Court art 5-8, Preamble, Nov. 10, 1998, 2187 U.N.T.S. 38544 (explaining that international criminal law is concerned only with the prosecution of "the most serious crimes of concern to the international community as a whole, specifically genocide, crimes against humanity, war crimes and the crime of aggression"). See generally Shane Darcy, *The Potential Role of Criminal Law in a Business and Human Rights Treaty* in DEVA & BILCHITZ, *supra* note 99 (relating to international criminal law and private actors).

¹⁰⁵ See Vienna Convention on the Law of Treaties, May 23, 1969. 1155 U.N.T.S. 331 (1969), p. 331 (which codifies this principle, and therefore shows that this is a well-developed principle of international law).

principles that are “specially directed to concerns relating to the Internet, such as freedom of expression or trademark law.”¹⁰⁶ Such interpretation proposed by ICANN reveals that it envisages the right to freedom of expression – and potentially other human rights relevant to the Internet, such as rights to equality and non-discrimination, or data protection and privacy – as principles of international law with which it has committed itself to conforming. There is nothing in the Californian legal system (where ICANN is registered), the US federal law or in international law to prevent private actors imposing binding obligations upon themselves. In fact, private actors often adopt procedural principles to increase their legitimacy. ICANN is not an exception: it has explicitly subjected some of its global policies to international law standards. For example, in the procedure concerning the *limited public interest objection* to the new gTLD applications, ICANN assesses the compatibility of the particular gTLD string against the principles relating to public order and morality under international human rights law.¹⁰⁷ We therefore can conclude that ICANN has imposed on itself an obligation to operate in conformity with international human rights law. Next section discusses what principles of this law are relevant for the substantial policy aspects of the UDRP.

3.3 Relevant International Human Rights Framework for the UDRP

Because the UDRP concerns the transfer or cancellation of a domain name, which itself constitutes expression, it directly impacts the right to freedom of expression. Freedom of

¹⁰⁶ *ICM Registry v. ICANN*, Declaration, para. 106, <https://www.icann.org/en/system/files/files/-panel-declaration-19feb10-en.pdf> (last visited Dec. 6 2019).

¹⁰⁷ See Adamantia Rachovitsa, *International Law and the Global Public Interest: ICANN's Independent Objector as a Mechanism of Responsive Global Governance in NON-STATE ACTORS AND INTERNATIONAL OBLIGATIONS: CREATION, EVOLUTION AND ENFORCEMENT* 342 (James Summers & Alex Gough eds., 2018). See also Eyal Benvenisti, *THE LAW OF GLOBAL GOVERNANCE* 58 (Hague Academy of International Law ed., 2014).

expression is one of the classic fundamental rights recognized in many countries' constitutions and secured in international human rights treaties, including the UDHR¹⁰⁸ and ICCPR,¹⁰⁹ as well as numerous regional human rights instruments, such as the European Convention on Human Rights ("ECHR")¹¹⁰ and American Convention on Human Rights ("ACHR").¹¹¹ The right to freedom of expression has been recognised as an especially significant right in the age of information and digital technologies. For example, Frank la Rue, the UN Special Rapporteur on the Promotion of the Right to Freedom of Opinion and Expression, suggested that: "the right to freedom of opinion and expression is as much a fundamental right on its own accord as it is an 'enabler' of other rights ... by acting as a catalyst for individuals to exercise their right to freedom of opinion and expression, the Internet also facilitates the realization of a range of other human rights."¹¹²

Freedom of expression, however, is not an absolute right under human rights law. It may be subjected to certain restrictions as long as these are provided by law, are necessary and proportionate for securing either the rights of others or protection of national security or of public order (*ordre public*), or of public health or morals.¹¹³ To be legitimate, restrictions on freedom of

¹⁰⁸ Universal Declaration of Human Rights, G.A. Res. 217, U.N. GAOR, 3rd Sess., at 71, U.N. Doc. A/810 (1948) [hereinafter UDHR]. Article 19 of the UDHR provides: "Everyone has the right to freedom of opinion and expression; this right includes freedom to hold opinions without interference and to seek, receive and impart information and ideas through any media and regardless of frontiers."

¹⁰⁹ International Covenant on Civil and Political Rights, Mar. 23, 1976, 999 U.N.T.S. 171 [hereinafter ICCPR]. Article 19 of the ICCPR provides: "1. Everyone shall have the right to hold opinions without interference. 2. Everyone shall have the right to freedom of expression; this right shall include freedom to seek, receive and impart information and ideas of all kinds, regardless of frontiers, either orally, in writing or in print, in the form of art, or through any other media of his choice."

¹¹⁰ European Convention for the Protection of Human Rights and Fundamental Freedoms, Nov. 4, 1950, 213 U.N.T.S. 221.

¹¹¹ American Convention on Human Rights, Nov. 22, 1969, 1144 U.N.T.S. 123.

¹¹² United Nations Human Rights Council, *Report of the Special Rapporteur on the promotion and protection of the right to freedom of opinion and expression*, Frank La Rue, U.N. Doc. A/HRC/17/27, para. 22 (May 16, 2011).

¹¹³ Under 19(3) of the ICCPR, restrictions "shall only be such as are provided by law and are necessary: a) for respect of the rights or reputations of others; b) for the protection of national security or of public order (*ordre public*), or of public health or

expression must be precise enough and publicly accessible in order to limit the authorities' discretion and provide individuals with adequate guidance.¹¹⁴ To be necessary, a restriction must be more than merely useful, reasonable or desirable.¹¹⁵ It is also well established that the necessity of a restriction is assessed by a test of proportionality.¹¹⁶ Proportionality requires demonstrating that restrictive measures are the least intrusive instrument among those which might achieve their protective function and proportionate to the interest to be protected.¹¹⁷

When restrictions on the exercise of freedom of expression fail to meet these standards, collectively known as the three step-test in human rights jurisprudence, individuals enjoy the right to an effective remedy, which is also recognised under ICCPR and numerous regional human rights treaties.¹¹⁸ Moreover, international human rights law requires all individuals to be treated equally with regards to their exercise of substantial human rights, such as freedom of expression or the right to an effective remedy.¹¹⁹

Given the widespread recognition of these human rights among

morals." The UDHR also proclaims that in the exercise of one's rights and freedoms, everyone shall be subject only to such limitations as "are determined by law solely for purpose of securing due recognition and respect for the rights and freedoms of others and of meeting the just requirements of morality, public order and the general welfare in a democratic society."

¹¹⁴ See UN Human Rights Committee, *General comment no. 34, Article 19, Freedoms of opinion and expression*, U.N. Doc. CCPR/C/GC/34, (Sept. 12, 2011) [hereinafter HRC].

¹¹⁵ See, e.g., *The Sunday Times v. The United Kingdom*, No. 6538/74, Application, Eur. Ct. H.R. para. 59 (1979).

¹¹⁶ CCPR General Comment No. 27: Article 12 (Freedom of Movement) Adopted at the Sixty-seventh session of the Human Rights Committee, on 2 November 1999 and contained in U.N. Doc.(contained in U.N. Doc. CCPR/C/21/Rev.1/Add.9) para. 14. *Lohe Issa Konate v. Burkina Faso*, No. 004/2013, Application, African Court Human and Peoples' Rights [Afr. Ct. H.P.R.], ¶ 148, 149 (2014); *The Sunday Times v. The United Kingdom*, No. 6538/74, Application, Eur. Ct. H.R. para. 62 (1979).

¹¹⁷ See UN Human Rights Committee, *General comment no. 34, Article 19, Freedoms of opinion and expression*, U.N. Doc. CCPR/C/GC/34, (Sept. 12, 2011).

¹¹⁸ Article 2 (3) of the ICCPR, Article 7 of the ECHR. See also MARTIN SENFTLEBEN, COPYRIGHT, LIMITATIONS, AND THE THREE-STEP TEST: AN ANALYSIS OF THE THREE-STEP TEST IN INTERNATIONAL AND EC COPYRIGHT LAW (2004) (in the context of intellectual property).

¹¹⁹ See Articles 1 and 2 of the UDHR, Article 26 of the ICCPR.

international community, it would be hard to disagree that the rights to freedom of expression and equality are indeed “internationally recognized human rights,” which ICANN has in its Bylaws committed to respect. Moreover, ICANN has itself spelled out that it regards freedom of expression to be one of the “relevant principles of international law” that it has committed to act in conformity with under its Articles of Incorporation. The following part of this article discusses whether the UDRP lives up to these commitments.

4 Human Rights Analysis of the Substance of the UDRP: Implications for Freedom of Expression, Equality and Non-Discrimination

The substantive part of the UDRP concerns the definition of grounds and conditions for the transfer of a domain name. In order to secure a domain name transfer from the original registrant, the UDRP requires a complainant to establish that: (i) the domain name is identical or confusingly similar to the trademark or service mark in which the complainant has rights; (ii) the defendant has no rights or legitimate interests in the domain; and (iii) the domain name was registered and used in bad faith.¹²⁰ From a human rights perspective, these three substantive elements under the UDRP policy define the instances of interferences with the exercise of freedom of expression and non-discrimination that pursue the legitimate aims of “protecting rights of others” – that is, the rights of trademark holders. Such interference, however, is only legitimate from a human rights perspective if it satisfies all the elements of the famous three-step test of human rights: interference must be in accordance with the law pursue a legitimate aim, and satisfy the requirements of necessity and

¹²⁰ UDRP Policy, *supra* note 3, sec. 4(a).

proportionality. The following sections of this article scrutinise each of these elements and their human rights implications before analysing them as a whole against the overall objectives of the UDRP.

4.1 “Identical or Confusingly Similar to a Trademark or Service Mark”

The first element that a complainant must prove in order to secure a domain name transfer under the UDRP is that the “domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights.”¹²¹ What appears to be problematic for freedom of expression is the potential for an overly broad interpretation of “confusingly similar” and the inclusion of other categories of names beyond trademarks or service marks.

4.1.1 Loosening of Trademark or Service Mark Requirements

The potential for inclusion of other categories of names beyond trademarks or service marks is well illustrated with the *Barcelona.com* case. In that case, the complainant, the Barcelona city council, did not have a trademark for the term “Barcelona” in Spain (Spanish trademark law prohibited registration of marks consisting exclusively of “geographical origin”) or elsewhere. However, the UDRP panel decided that “confusingly similar” criteria was satisfied because it did have various trademark registrations which included “one main element, namely the expression ‘Barcelona.’”¹²² This case was ultimately reversed by the US Court of Appeals (4th Circuit).¹²³ Similarly, despite the UDRP’s explicit limitation to trademark or service mark rights

¹²¹ UDRP Policy, *supra* note 3, sec. 4(a)(i).

¹²² *Excelentísimo Ayuntamiento de Barcelona v. Barcelona.com, Inc.*, WIPO, No. D2000-0505.

¹²³ *See Barcelona.com, Incorporated v. Excelentísimo Ayuntamiento de Barcelona*, 330 F.3d 617 (2003).

in its wording, some panels have applied the UDRP to personal names based on the theory that such names are “common law trademarks” or a source of identification similar to trademarks, leading to confused and often contradictory results.¹²⁴ As noted by Zorik Pesochinsky:

a panel granted Julia Roberts rights to the website *juliaroberts.com*, while another panel denied Bruce Springsteen rights to the website *brucespringsteen.com* (albeit with a dissenting opinion). Similarly, it was decided that Hillary Clinton has rights to *hillaryclinton.com*, while Kathleen Kennedy Townsend did not have rights to *kathleenkennedytownsend.com*.¹²⁵

It is beyond the scope of this article to analyse the nuances between trademark law and domain name law.¹²⁶ Suffice it to say that broadening the scope of the UDRP to include other categories of names beyond those explicitly recognised in the UDRP is problematic from the human rights perspective because of the failure of this encroachment on freedom of expression to meet the three-step test for legitimate interferences with human

¹²⁴ See LINDSAY, *supra* n.8, at 5.20.2 (noting how some UDRP panelists have applied a “straightforward, orthodox approach to determining whether common law rights arise in a personal name[.]” while others have been “perfunctory in the application of US trade mark law in finding rights in personal names” and thus applied a “relatively loose” standard to finding trademark rights in personal names).

¹²⁵ Zorik Pesochinsky, *Almost Famous: Preventing Username-Squatting on Social Networking Websites*, 28 CARDOZO ARTS & ENT. L.J. 223, 235 (2010), citing Julia Fiona Roberts v. Russell Boyd, WIPO Case No. D2000-0210 (May 29, 2000); Bruce Springsteen v. Jeff Burgar and Bruce Springsteen Club, WIPO Case No. D2000-1532 (January 25, 2001); See Hillary Rodham Clinton v. Michele Dinoia a/k/a SZK.com, National Arbitration Forum, Claim No. FA0502000414641 (March 18, 2005); Townsend v. Birt, WIPO Case No. D2002-0030 (July 31, 2002).

¹²⁶ For such analysis, see, e.g., Adam Dunn, *Relationship between Domain Names and Trademark Law*, CENTRAL EUROPEAN UNIVERSITY THESIS (2014), etd.ceu.hu; Christine Haight Farley, *Convergence and Incongruence: Trademark Law and ICANN's Introduction of New Generic Top-Level Domains*, 25 J. MARSHALL J. COMPUTER & INFO. L., 625 (2007); Jacqueline Lipton, *Bad Faith in Cyberspace: Grounding Domain Name Theory in Trademark, Property, and Restitution*, 23 HARV. JL & TECH., 447 (2009); LINDSAY, *supra* n.40.

rights.¹²⁷ It is not clear whether the UDRP in such cases still pursues the legitimate aim of “protecting the rights of others.” One could ask whether individuals or cities do in fact have any rights in geographic identifiers. Even assuming that they do, the three-step test requires that such interference must be in accordance with the law and limited to what is explicitly articulated in the law — or in this case, the policy.¹²⁸ This criterion of the three-part test is only satisfied if the law is clear, accessible, predictable, and uniformly applied. Broadening of scope of the UDRP by the panelists to cover other categories beyond those explicitly included, however, renders it unpredictable and not uniformly applied.

4.1.2 Confusing Similarity with Pejorative Terms

Secondly, loose interpretations of “confusing similarity” requirements might not suffice to satisfy the strict necessity requirements for any interference with the exercise of human right[s] under three-step test of international human rights law. The protection of freedom of expression includes political speech, views on religion, and opinions, and expressions that are not only favourably received or regarded as inoffensive but also those that may offend, shock, or disturb others.¹²⁹

Such overly broad interpretations are well illustrated by disputes over domains that contained a popular trademark followed by

¹²⁷ See, e.g., *Lohe Issa Konaté v. Burkina Faso*, ACHPR, App. No. 004/2013, ¶148–49 (December 5, 2014) *Case of The Sunday Times v. The United Kingdom*, 30 Eur. Ct. H.R. (ser. A) ¶62 (1979); More generally on the legitimate restriction on freedom of expression, see David Kaye (UN Special Rapporteur on the Promotion and Protection of the Right to Freedom of Opinion and Expression), *Report of the Special Rapporteur on the promotion and protection of the right to freedom of opinion and expression*, David Kaye, ¶30–35 UN. Doc. A/HRC/29/32 (May 22, 2015). www.ohchr.org/EN/HRBodies/HRC/RegularSessions/.../A.HRC.29.32_AEV.doc.

¹²⁸ For more on three step test and intellectual property, see Laurence R. Helfer, *The New Innovation Frontier-Intellectual Property and the European Court of Human Rights*, 49 HARV. INT’L LJ, 1 (2008).

¹²⁹ *Zalnieriute & Schneider*, *supra* n 96, at 26 and the references cited therein; and the famous ECtHR decision in *Handyside v. the United Kingdom*, 24 Eur. Ct. H.R. (ser. A), ¶49 (December 7, 1976).

the word “sucks” such as *philipssucks.com*¹³⁰, *walmartuksucks.com* and *walmartpuertorico.com*,¹³¹ *www.airfrance-suck.com*,¹³² *www.alsthom-sucks.com*¹³³ and *www.drmartensucks.com*.¹³⁴ A majority of the UDRP panels have held that such domains are “confusingly similar” to the trademarks used in the domain names simply because they included the trademarks, regardless of any other terms included in the domain name.¹³⁵ However, as mentioned above, right to freedom of expression includes political speech, and this clearly covers cases of *-suck.com*, *-fuck.com*, *-fraud.com* and *.sucks*, however inconvenient, disturbing and embarrassing this might be to others, including the trademark owners. Although a conservative argument is often made by the UDRP panelists that the domain name holders could have exercised their freedom of expression by selecting a different, “not confusingly similar” domain name, this approach has a chilling effect on legitimate criticism and infringes on the right to freedom of expression where it is most relevant.

In some cases such as *ADTsucks.com*, a domain name was found to be “confusingly similar” because it could reasonably be confused with the trademark holder’s official complaint site.¹³⁶ The reasoning was that non-English-speaking consumers could be confused by the use of the term “sucks” and may not be able “to give it any very definite meaning and will be confused about the potential association with the Complainants.”¹³⁷ The addition of the word “fraud” to the trademark in the domain

¹³⁰ Koninklijke Philips Electronics N.V. v. SC Evergreen Consult & Aviation SRL, WIPO Case No. DRO2001-0001, ¶1 (May 16, 2001).

¹³¹ See, e.g., Wal-Mart Stores, Inc. v. MacLeod, UDRP-ARB Case No. D2000-0662 (September 19, 2000).

¹³² See, e.g., Société Air France v. Mark Allaye-Chan, WIPO Case No. D2009-0327 (May 14, 2009).

¹³³ See, e.g., ALSTOM v. Jerry Jonn, WIPO Case No. D2010-2075 (March 28, 2011).

¹³⁴ See, e.g., Dr. Martens’ International Trading GmbH and “Dr. Maertens” Marketing GmbH v. MCPs, Timothy Marten, WIPO Case No. D2011-1728 (December 15, 2011).

¹³⁵ See, e.g., Koninklijke Philips Elecs., WIPO, No. DRO2001-0001 (May 16, 2001).

¹³⁶ See, e.g., ADT Services AG v. ADTSucks.com, WIPO Case No. D2001-0213 (April 23, 2001).

¹³⁷ *Id.*

name was also found “confusingly similar” to the trademark, as demonstrated by transfer of domain names such as *www.algaecalfraud.com*,¹³⁸ *www.migbankfraud.com*¹³⁹ and *www.streamtel-is-fraud.com*¹⁴⁰ to the complainants.

In all cases with pejorative additions, a minority of the UDRP panelists found no “confusing similarity” because the addition of a pejorative word to the mark served as a clear indication that the domain was not affiliated with the trademark.¹⁴¹ For example, in respect of *www.fuckcalvinklein.com*, the Panel found that the:

The Panel finds that Respondent’s <fuckcalvinklein.com> domain name is not confusingly similar to Complainant’s CALVIN KLEIN mark under Policy ¶ 4(a)(i), because the term “fuck” provides an indication that Respondent is not affiliated with Complainant and the Internet user entering the domain name could not possibly expect Complainant to be, or desire to be, affiliated with such a domain name.¹⁴²

¹³⁸ See *AlgaeCal Inc. v. AlgaeCal Fraud*, WIPO Case No. D2013-1248 (September 12, 2013).

¹³⁹ See *MIG Banque SA (MIG Bank Ltd) v Akram Mohammad Khalid*, WIPO Case No. D2011-0159 (May 18, 2011) (citing *Société Air France v. Mark Allaye-Chan*, WIPO Case No. D2009-0327 (May 14, 2009) (finding “the addition of ‘fraud’ was not sufficient to negate the confusing similarity between the disputed domain names and the Complainant’s Trade Mark.”)).

¹⁴⁰ See *Streamtel Corporation SRL v. Ton Kcimminga*, WIPO Case No. D2010-0423 (May 13, 2010).

¹⁴¹ See, e.g., *Lockheed Martin Corp. v. Parisi*, UDRP-ARB Case No. D2000-1015 (January 26, 2001); *Koninklijke Philips Elecs.*, WIPO, No. DRO2001-0001 (2001). For a mid-2000s case, see *KB Home v. RegisterFly.com*, Ref. No. 9323034, FA 506771 (Nat. Arb. Forum Aug. 30, 2005) (finding that the addition of the term “sucks” to the complainant’s KB HOME mark in the <kbhomesucks.com> domain name did not make the domain name confusingly similar to the mark because a reasonable person would not conclude that a person who registers a domain name containing the term “sucks” has any relation to the owner of the mark).

¹⁴² *Calvin Klein Trademark Trust & Calvin Klein, Inc. v. Alan Sleator*, Nat. Arb. Forum Case No. FA1403001547828 (April 11, 2014).

4.1.3 Will .sucks Make a Difference?

However, the “sucks” cases in 2000 prompted some activists to write a letter to ICANN championing the creation of a *.sucks* gTLD in the interests of free speech and corporate criticism.¹⁴³ Under the proposal, trademark owners would not be allowed to also own *.sucks*, and instead activists could, for instance, start *McDonalds.sucks*, *aol.sucks*, *wipo.sucks* or *greenpeace.sucks* sites. Parts of this proposal became a reality when, in December 2014, ICANN signed an agreement with the Vox Populi registry to sell *.sucks* domain names, despite several warnings from the US Federal Trade Commission.¹⁴⁴ However, instead of promoting freedom of expression, corporate criticism and expanding “domain name space in an important way,” as it was envisaged in the original *.sucks* championing letter back in 2000, the ICANN–Vox Populi arrangement seems to cater more to trademark owners than individuals eager to exercise their right to freedom of expression. Vox Populi allows trademark owners to take their names off the *.sucks* table, during the so-called “sunrise” period (an exclusive pre-sale phase that ended on 21 June 2015) at enormous prices of US\$2,499 per domain, per year.¹⁴⁵ US actor Kevin Spacey and singer Taylor Swift appear to have bought their own *.sucks* domains, along with many corporations, such as Microsoft.¹⁴⁶

Thus, while the creation of *.sucks* gTLDs on the surface appeared to provide an opportunity for legitimate criticism to exist in the domain name space, it is not clear whether UDRP panels will treat *.sucks* gTLD cases any differently from the

¹⁴³ John Richard & James Love, Letter by Essential Information and Consumer Project on Technology to ICANN asking to create new Internet Top Level Domains, March 1, 2000, available at <http://www.cptech.org/ecom/icann/tlds-march1-2000.html>, last visited May 5, 2017.

¹⁴⁴ Kieren McCarthy, *.sucks-gate: How about listening to us the first two times, exasperated FTC tells ICANN*, THE REGISTER (May 28, 2015), http://www.theregister.co.uk/2015/05/28/ftc_icann_sucks/.

¹⁴⁵ See *id.*

¹⁴⁶ Roger Kay, *Saga of .Sucks Domain Generates Laughter, Agony*, FORBES (June 29, 2015), <http://www.forbes.com/sites/rogerkay/2015/06/29/saga-of-sucks-domain-generates-laughter-agony/#58bc1e218c17>.

older 2000s *sucks.com* saga or would still find them “identical or confusingly similar” to the trademark in question.¹⁴⁷ At the moment, only a handful of *.sucks* UDRP cases (none decided by the US courts) exist. They involve straightforward instances of cybersquatting (a domain directing to either a pay-per click site or offering competing services¹⁴⁸), providing little guidance on whether a registrant using “.sucks” might still be found to have registered a “confusingly similar” domain in more complex contexts. While it is difficult to draw more generalised conclusions from these cases, WIPO Overview 3.0 provides more guidance: “A domain name consisting of a trademark and a negative or pejorative term (such as [trademark]sucks.com ... or even *trademark.sucks*)” is considered confusingly similar to the complainant’s trademark for the purpose of satisfying standing under the first element.¹⁴⁹ If the panelists are to follow WIPO 3.0, this line of reasoning would be disturbing from the freedom of expression perspective, as even an explicitly different gTLD would not provide a chance for legitimate criticism that is not held to be “confusingly similar” by the UDRP.

4.1.4 Informational Websites

Other problematic UDRP cases from the freedom of expression perspective deal with criticism websites created for informational purposes or to, for example, provide a platform to the clients of the complainant to post their feedback and

¹⁴⁷ Kevin Murphy, *Could you survive a .sucks UDRP?*, DOMAIN INCITE (March 17, 2015),

<http://domainincite.com/18164-could-you-survive-a-sucks-udrp>, visited 17/05/2017.

¹⁴⁸ See the pretty straightforward case of *Lockheed Martin Corp v. Sam Kadosh*, UDRP-ARB Case No FA1710001751762 (November 2, 2017) (ordering transfer of www.lockheedmartin.sucks, which directed to a pay-per-click site. In finding confusing similarity between the disputed domain name and the complainant’s LOCKHEED MARTIN mark, the panelist compared it to a case holding “.com” generic -- thus site. In finding confusing similarity between the disputed domain name and the complainant’s LOCKHEED MARTIN mark, the panelist compared it to a case holding “.com” generic -- thus implying that “.sucks” is also generic).

¹⁴⁹ WIPO, *WIPO Overview of WIPO Panel Views on Selected UDRP Questions*, Third Edition (2017). Available at <https://www.wipo.int/amc/en/domains/search/overview3.0/>.

comment about an organisation (e.g., *www.pinsentmasons.lawyer*), or to provide a warning to prospective customers of the complainant regarding allegedly deceptive business practices of the complainant (e.g., *www.anastasia-international.info*), or to domain names set as part of preparations for a possible class action suit against a complainant (*www.cpaglobal-litigation.com*), or to public awareness websites about health-effects of the complainant's products (e.g., *philipmorriscigarettediseases.org*, *philipmorriscigaretteskill.com*, *philipmorriscigarettescankill.com*, and *philipmorriscigarettediseases.com*).

For example, in the 2015 cases involving the Philip Morris mark, the panel held that: "adding a generic term to a complainant's mark does not alleviate confusing similarity."¹⁵⁰ Similarly, "the addition of the descriptive term 'litigation' does not prevent a finding of confusing similarity."¹⁵¹ This seems to contrast with the earlier mentioned Calvin Klein case from 2014 (which concerned the addition of a pejorative word), but in the Philip Morris cases to support its view, the panel quoted a 2004 decision holding the "*amextravel.com* domain name [to be] confusingly similar to Complainant's AMEX mark because the 'mere addition of a generic or descriptive word to a registered mark does not negate' a finding of confusing similarity under Policy ¶ 4(a)(i)."¹⁵² However, arguably, the *amextravel.com* and *philipmorriscigarettescankill.com* cases are quite different: whereas the former could confuse consumers because American Express offers credit cards that provide various benefits for travelling, the latter instance sends a critical, health-related

¹⁵⁰ See Philip Morris USA Inc. v. LORI WAGNER/DAVID DELMAN/DAVID@DELMAN.TV, ARB Claim Number: FA1507001627979 (November 2, 2017).

¹⁵¹ See CPA Global Limited v. Perfect Privacy, LLC / Kobre and Kim LLP, WIPO Case No. D2017-1964 (December 26, 2017) (<*cpaglobal-litigation.com*>. Denying complaint).

¹⁵² See Am. Express Co. v. MustNeed.com, Nat. Arb. Forum Case No. FA 257901 (June 7, 2004).

message about the complainant's business, which hardly anyone would believe to be a website of Philip Morris. This decision is arguably contradictory with the *fuckcalvinklein* decision, because Internet user[s] entering the domain name *philipmorriscigarettescankill.com* "could not possibly expect Complainant to be, or desire to be, affiliated with such a domain name."¹⁵³

This expansive approach was confirmed in the 2017 case involving the Marlboro mark of Philip Morris and the domain name *marlborosucks.com*. The panel confirmed:

It has become very well-established in UDRP precedent, including numerous decisions previously rendered by this Panel, that a minor variation to a mark is usually insufficient in and of itself, when used in forming a domain name, particularly a Second-Level Domain (SLD), that results from modifying the mark, to confer requisite and sufficient distinctiveness to the resulting domain name to avoid a finding of confusing similarity. Here, the Respondent's incorporation of the term "sucks" to form the SLD clearly constitutes such a minor variation and, as such, does not avoid a finding of confusing similarity.¹⁵⁴

This view is also confirmed in the Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0").¹⁵⁵ Such broad interpretations of the "confusing similarity" element conflict with the right of individuals to freely express themselves online and to access information and the

¹⁵³ See Calvin Klein Trademark Trust & Calvin Klein, Inc. v. Alan Sleator, Nat. Arb. Forum Case No. FA1403001547828 (April 11, 2014).

¹⁵⁴ See Philip Morris USA Inc. v. Computer Services, Inc. Case No. D2017-0847 (June 15, 2017).

¹⁵⁵ WIPO, *WIPO Overview of WIPO Panel Views on Selected UDRP Questions*, Third Edition (2017), para 1.13.

opinions and expressions of others. While it is true that the right to freedom of expression may be restricted for the sake of the “reputation or rights of others,” such restrictions must be in accordance with law and must be assessed as “the least intrusive instrument amongst those which might achieve the desired result.”¹⁵⁶ A blanket ban on domain names incorporating the trademark, irrespective of the additional words added and content of the website, seems to be disproportionate to the aim sought of protecting the rights of others. The proportionality requirement envisages a balancing act — compromises where necessary in the particular circumstances of a case — rather than blanket bans. Overall, the broad interpretation of “confusing similarity” seems to fail the strict necessity and proportionality requirements under international human rights law.

4.2 “No Rights or Legitimate Interests”

The second element that a complainant must establish under the UDRP is that the respondent has “no rights or legitimate interests in respect of the domain name.”¹⁵⁷ The wording of this element gives rise to the question of what is a “right or legitimate interest.” To address this question, the UDRP sets out three non-exhaustive circumstances in which a domain name registrant can demonstrate that they have a legitimate interest in the domain name in question. These circumstances, also known as affirmative defences, are listed under paragraph 4(c) of the UDRP:

- (i) before any notice to the domain name holder of the dispute, use of, or demonstrable preparations to use, the domain name

¹⁵⁶ See *Issa Konate v. Burkina Faso*, ACHPR App. No. 004/2013, ¶148–49 (2014); see also *Case of The Sunday Times*, 30 Eur. Ct. H.R. (ser. A), ¶62. More on the legitimate restriction on freedom of expressions, see generally David Kaye, *Report of the UN Special Rapporteur on the promotion and protection of the right to freedom of opinion and expression*, David Kaye, May 22, 2015, A/HRC/29/32, ¶30–35. www.ohchr.org/EN/HRBodies/HRC/RegularSessions/.../A.HRC.29.32_AEV.doc.

¹⁵⁷ ICANN, *UDRP Policy*, *supra* note 3, sec. 4(a)(ii).

or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
(ii) domain name holder (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
(iii) domain name holder is making a legitimate noncommercial 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.¹⁵⁸

4.2.1 No Legitimate Interests if Using the Mark in the Domain Name?

The inclusion of these in the UDRP is a great achievement for civil society advocates, and doing so proved to be a hard task.¹⁵⁹ However, there are concerning examples in which UDRP panels have interpreted this second element very loosely and affirmative defences were consequently found not to apply. For instance, in the *Barcelona.com* case, the panel did not accept the respondent's evidence of planned website business activity as a legitimate interest under UDRP paragraph 4(a)(ii), despite the defence available under paragraph 4(c)(i). Similarly, in a recent 2015 case involving the Philip Morris mark and several domains, such as *philipmorriscigarettediseases.org* and *philipmorriscigaretteskill.com*, the defence of fair use of trademarks was further brought into question, when the panel noted: "A respondent has a right to comment or criticise complainants' business practices but respondent had no right to do so in this manner, namely, registering a domain name which contains the entire 'Philip Morris' mark."¹⁶⁰

¹⁵⁸ See 4(c) of the UDRP.

¹⁵⁹ Comment from the co-founder of the Non-Commercial User Constituency (NCUC) in ICANN, Kathy Kleiman, US Attorney who participated in the adoption process of the UDRP. Personal file, to request from Author.

¹⁶⁰ *Philip Morris USA Inc. v. LORI WAGNER / DAVID DELMAN / DAVID@DELMAN.TV*
Claim Number: FA1507001627979

Therefore, while the panel accepted that the respondent's use of the domain names was legitimate because it aimed to provide non-commercial anti-smoking commentary, it still held that the legitimate fair use defence in paragraph 4(c)(iii) could not apply. Similarly, in a 2016 case involving a *philipmorrisgripesite.com* domain, which resolved to a so-called criticism website (a site criticizing particular organization or corporation, in this case - Philip Morris), the panel held that although the Respondent may have had the right to criticize the Complainant, the Respondent did not have the right to misappropriate the Complainant's trademark in a domain name to divert the Complainant's customers to the Respondent's criticism site.¹⁶¹

Therefore, it appears that even if the registrants are found to have a legitimate interest in the domain name for the expression of criticism, the UDRP panels still find in favour of the complainant on the basis that registrants can engage in criticism without creating confusion, as it was held in, for example, the *fuckAOL.com* or *natwestsucks.com* cases.¹⁶² Such reasoning by the panelists is underpinned by the argument that registrants have a choice to register another domain that does not create a likelihood of confusion.¹⁶³ Therefore, the UDRP panels reason that the first element of "confusing similarity" is determinative

¹⁶¹ *Jonah Hunt v. Robert Racansky*, Claim No: FA 1471550 ("[W]hile Respondent may have rights and legitimate interests in maintaining . . . a complaint website . . . Respondent is not making a legitimate use of a domain name when it uses Complainant's own trademark in the domain name to divert complainant's customers to the gripe site."); see also *Diners Club International, Limited v. Infotechnics Ltd.*, Claim No: FA 169085. ("Respondent may have the right to post criticism of Complainant on the Internet, however, Respondent does not have the right to completely appropriate Complainant's registered trademark in a domain name in a way that will mislead Internet users as to the source or affiliation of the attached website").

¹⁶² *America Online, Inc. v. Tommy Vercetti*, Claim Number: FA0403000244091.; *The Royal Bank of Scotland Group plc, National Westminster Bank plc A/K/A NatWest Bank v. Personal and Pedro Lopez*, WIPO Case No. D2003-0166. See Jennifer Arnette-Mitchell, *State Action Reborn Again: Why the Constitution Should Act as a Checking Mechanism for ICANN's Uniform Dispute Resolution Policy*, 27 HAMLINE J. PUB. L. & POL'Y 307 (2006).

¹⁶³ See *The Royal Bank of Scotland Group plc, National Westminster Bank plc A/K/A NatWest Bank v. Personal and Pedro Lopez*, WIPO Case No. D2003-0166.; *Bett Homes Limited and Bett Brothers PLC v. McFadyen*, WIPO Case No. D2001-1018.

of the second element of “legitimate interest.” Such practice seems to contradict the text of the UDRP, as it leaves the second element with no work to do. It also falls short of the three-step test requirement under international human rights law, which requires a balancing act between competing rights and interests.

One could ask: In what circumstances can a registrant use a domain name for criticism? The decisions to date seem to suggest that using a domain name in this way inevitably results in a transfer under the UDRP, regardless of the content on the website to which the domain name resolves or the inclusion of other words in the domain name.¹⁶⁴ If panels continue to take this approach, the legitimate fair use defence, which currently provides protection for freedom of expression under the UDRP, would effectively be erased.

4.2.2 Special Consideration for U.S. Citizens and Residents?

Confusing similarity, however, was not always sufficient for establishing a respondent’s lack of legitimate interest in the domain name under UDRP. For example, in *www.sermosucks.com*¹⁶⁵ the registrant was a U.S. resident, so the panel applied U.S. legal principles—which are generally more receptive to free speech concerns¹⁶⁶—and held that the complainant failed to establish a lack of legitimate interest. From a human rights perspective, it is significant that the nationality or residency of the parties to the dispute might lead to different outcomes. An empirical study has demonstrated that the nationality of respondents and/or panelists influences the outcome of fair use cases. In particular, the study has revealed

¹⁶⁴ For more on the erosions of the fair use defence, see Steven Levy, *Fair Use: Has the Defence Gone Up in Smoke?* TRADEMARKS & BRANDS ONLINE, <https://www.trademarksandbrandsonline.com/article/fair-use-has-the-defence-gone-up-in-smoke> (last visited December 12, 2017).

¹⁶⁵ *Sermo, Inc. v. CatalystMD, LLC*, Case No. D20080647.

¹⁶⁶ See Ian Cram, *Contested words: legal restrictions on freedom of speech in liberal democracies*, Routledge (2016); Cass Sunstein, *Democracy and the problem of free speech*, 1ST FREE PRESS, (1995).

that, when using the fair use defence under the UDRP, “U.S. respondents won 35% of the time while other respondents won only 17% of the time,” and, “U.S. panels found fair use 36% of the time. Other panels, by contrast, found fair use only 20% of the time.”¹⁶⁷ Overall, this empirical evidence suggests that (a) US panels, which hear about half of all fair use proceedings, are friendlier to the domain name holders’ right of freedom of expression than that of their foreign counterparts, and that (b) WIPO panels apply the UDRP fair use defence more favourably to U.S. respondents than to other respondents.

This differential in the level of protection that UDRP panels have given with respect to freedom of expression is problematic from a human rights perspective. Inconsistent application of the fair use defence results in disparate limits on the right to freedom of expression; it contradicts the principles of equality and non-discrimination based on nationality under international human rights law.¹⁶⁸ This aspect is closely interlinked with, and further complicated by, the UDRP’s lack of clear stipulation of the “choice-of-law” rules to be applied in its proceedings.¹⁶⁹ Under the current reasoning evidenced by the panels’ decisions, it is obvious that the two opposing decisions could be “correct” at the same time, which undermines the consistency and predictability of the UDRP system as a whole.¹⁷⁰ Overall, such interpretative practices of the panels with respect to the affirmative defences

¹⁶⁷ See David A. Simon, *An Empirical Analysis of Fair Use Decisions Under the Uniform Domain-Name Dispute-Resolution Policy*, 53 B.C. L. REV. 65, 67-68 (2012). (“In other words, U.S. panels began importing U.S. law-law that is generally (viewed as) more sensitive than the law of other countries to free speech interests-into UDRP disputes with higher frequency than did foreign panels. More than non-U.S. panels, U.S. panels also applied U.S. law in cases where the respondent was from the United States. Because U.S. law is (viewed as) more friendly to speech interests than foreign law, the use of U.S. law favored respondents.”).

¹⁶⁸ The application of different legal norms depending on nationality of the respondents/claimants, amounts to violation of the principles of equality and non-discrimination under Article 2 of the UDHR and Articles 2(1) and 26 of the ICCPR.

¹⁶⁹ See UDRP Rules, *supra* note 3. Section 15(a).

¹⁷⁰ Schovsbo, Jens, *The Private Legal Governance of Domain Names* (June 17, 2015). “User Generated Law. Reconstructing Intellectual Property Law in a Knowledge Society” edited by Thomas Riis (on Edward Elgar), Forthcoming; UNIVERSITY OF COPENHAGEN, LEGAL STUDIES RESEARCH PAPER Paper No 2015-2. Available at SSRN: <https://ssrn.com/abstract=2619714>.

under the UDRP are at odds with the internationally recognised human rights of freedom of expression, freedom from discrimination, and equality before the law.

4.3 “Bad Faith”

The third element under the UDRP that a complainant must establish is that the disputed domain name “has been registered and is being used in bad faith” (which I will call the “bad faith requirement”).¹⁷¹ The UDRP offers a non-exhaustive list of four considerations to be taken into account in establishing the bad faith requirement, including circumstances indicating that:

- 1) the defendant registered or acquired the domain primarily for the purpose of selling the domain to the trademark holder or some third party;
- 2) the defendant registered the domain to prevent the trademark holder from reflecting the mark in a corresponding domain name;
- 3) the defendant registered the domain primarily for the purpose of disrupting the practices of a competitor; and
- 4) the defendant used the domain specifically to cause confusion in an attempt to attract consumers to the defendant’s web site.¹⁷²

In 2017, WIPO, in its Overview 3.0, listed additional factors that panels have taken into account in finding the bad faith requirement to be met. It states that an interference of bad faith would be supported by:

a clear absence of the respondent’s own rights or legitimate interests, the nature of the domain name itself (i.e., the manner in which the domain name incorporates the complainant’s mark), the content of any website to which the domain name points –

¹⁷¹ UDRP Policy, *supra* note 64 sec. 4(a)(iii).

¹⁷² UDRP Policy, *supra* note 64 sec. 4(b).

including any changes and the timing thereof, the registrant's prior conduct generally and in UDRP cases in particular, the reputation of the complainant's mark, the use of (false) contact details or a privacy shield to hide the registrant's identity, the failure to submit a response, the plausibility of any response, or other indicia that generally cast doubt on the registrant's bona fides.¹⁷³

The interpretation of the bad faith requirement by the UDRP panels is problematic from a human rights perspective for several reasons. In the following sub-sections, I draw together examples of where panels have given a loose interpretation of the bad faith requirement. I argue that these examples further demonstrate the way in which panels' loose interpretations of requirements under the UDRP may result in overly broad applications of the UDRP, which seem to encroach upon the internationally recognised human right to freedom of expression.

4.3.1 Cumulative Language: Registration and Use

Panels have usually adopted the position that the conjunctive language in the bad faith requirement in the UDRP imposes a cumulative requirement on the complainant that the disputed domain name be both registered *and* used in bad faith.¹⁷⁴ Lindsay discusses *Shirmax Retail Ltd/De'taillants Shirmax Lte'e v CES Marketing Group Inc* as an example of this approach.¹⁷⁵ In that case, the panel observed:

The requirement of bad faith registration and use in paragraph 4(a)(iii) is stated in the conjunctive. Registration in bad faith

¹⁷³ WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), <https://www.wipo.int/export/sites/www/amc/en/docs/overview3.pdf> (accessed 24 January 2020), para. 3.2.1, page 62.

¹⁷⁴ DAVID LINDSAY, INTERNATIONAL DOMAIN NAME LAW: ICANN AND THE UDRP, Hart Publishing, (2007), 367.

¹⁷⁵ *Ibid.*

is insufficient if the respondent does not use the domain name in bad faith, and conversely, use in bad faith is insufficient if the respondent originally registered the domain name for a permissible purpose.¹⁷⁶

It is important to note that the *WIPO Final Report* on the UDRP published in 1999 recommended that the word “and” be replaced with “or,” given that complainants would be more concerned with the use (as opposed to registration) of a domain name.¹⁷⁷ However, this recommendation was not followed in the final text of the UDRP.¹⁷⁸

4.3.2 Lack of Active Use / Non-Use

The use of “and” instead of “or” in the UDRP has caused difficulty for complainants in establishing the bad faith requirement. Gradually, panels have effectively softened the cumulative requirement by holding that a lack of active use of the domain name by a registrant—also known as non-use¹⁷⁹—may be sufficient to find evidence of the bad faith requirement. This was true in the *www.Barcelona.com* case and the *www.Telstra.org* case.¹⁸⁰ The general rationale the panelists now

¹⁷⁶ *Shirmax Retail Ltd/De'taillants Shirmax Lte'e v CES Marketing Group Inc*, ICANN Case No AF-0104, 4.

¹⁷⁷ World Intellectual Property Organization, *The Management of Internet Names and Addresses: Intellectual Property Issues* (FINAL REPORT, WIPO INTERNET DOMAIN NAME PROCESS, 30 April 1999) <https://www.wipo.int/export/sites/www/amc/en/docs/report-final1.pdf> (accessed 24 January 2020) (“WIPO Final Report”), paras. 171-172.

¹⁷⁸ Zak Muscovitch, a domain name attorney, speculates that one reason for this could be that mere infringing use can be dealt with in the courts as per usual, instead of through the UDRP (private comment made to the author).

¹⁷⁹ For the purposes of this analysis, “non-use” cases refer to instances where a domain name has not been “used” in any positive/active sense — e.g., there has been no webpage or website associated with that disputed domain name. For a different/contrary perspective and discussion how cumulative bad faith requirement and non-use decisions are undermining the effectiveness of the UDRP, see Roy, A., and Althaf M., ‘Bad faith’ and ‘rights or legitimate interests’ under domain name law: emerging themes from the UDRP and auDRP, *MEDIA & ARTS L. REV.* 20 (2015): 282-305.

¹⁸⁰ *Excelentísimo Ayuntamiento de Barcelona v. Barcelona.com, Inc.*, WIPO, No. D2000-0505; *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No: D2000-0003. Cf, however a case in *Loblaws, Inc. v. Yogeninternational*, ICANN Case No: AF-0164, available at <http://www.disputes.org/decisions/0164.htm>, where the

employ is that no active use indicates that a respondent simply registered the domain name to later sell it to the trademark owner.¹⁸¹

This interpretation of the bad faith requirement contrasts with a well-known practice of trademark owners to defensively register various domain names, using lawyers or other agents as proxies.¹⁸² The legitimacy of such a practice of buying domain names for non-use is also well illustrated by the “sunrise” period pre-sales mentioned above in sub-section 4.1.3. If trademark owners buy *.sucks*, *.porn*, *.wtf* or any other new gTLDs that they might find embarrassing or damaging, but never use them, should this be considered evidence of “bad faith”?

Generally, in order to infringe the trademark rights of others and thus commit a violation under trademark law, one needs to actually *use* the registered mark.¹⁸³ This principle is not exactly followed in the UDRP, which suggests that *lack of active use* or *non-use* might be evidence of bad faith *use*. In this way, the UDRP is much broader in its scope than the traditional trademark law in addressing the passive squatting of domain

panel found that inactive use was insufficient evidence of “bad faith” and allowed the respondent to retain the name. The panel distinguished its opinion from *Telstra* in that the complainant did not deliberately conceal contact information or register the complainant’s actual mark.

¹⁸¹ *Educational Testing Service v. TOEFL* (toefl.com) WIPO Case No: D2000-0044.; Roy, A., and Althaf M. ‘Bad faith’ and ‘rights or legitimate interests’ under domain name law: emerging themes from the UDRP and auDRP, *MEDIA & ARTS L. REV.* 20 (2015): 282-305, at 288.

¹⁸² See AGIP, ‘What is a defensive registration for Intellectual Property and brand names?’ 3 October 23003, <http://www.agip.com/news.aspx?id=339&lang=en>, visited May 2, 2017. For an overview of trademark industry domain name management strategies, including defensive registrations, see Elisa Cooper, *Domain Registration and Management Strategies for 2015*, *WORLD TRADEMARK REVIEW*, <http://www.worldtrademarkreview.com/Intelligence/Online-Brand-Enforcement/2015/Chapters/Domain-registration-and-management-strategies-for-2015>, (last visited May 2, 2017).

¹⁸³ See, e.g., *CSR Ltd v Resource Capital Australia Pty Ltd* (2003) 128 FCR 408 (Austl.), where the court denied a trade mark owner relief against a respondent who registered a domain name corresponding to the trade mark, although did not put that domain name into any form of use — use of a trade mark being a formal requirement to succeed in any trade mark infringement suit. See, Mary LaFrance, *Steam Shovels and Lipstick: Trademarks, Greed, and the Public Domain*, 6 *NEV L.J.* 447 (2005).

names.¹⁸⁴ As some scholars have noted, “it is necessarily the case that, in order to prevent bad faith registration, in certain circumstances passive warehousing (or passive holding) of a domain name must amount to “using” the domain name in bad faith.”¹⁸⁵

Even if there might be reasons to consider passive registration as “use,” such an interpretation seems to be at odds with the original goals of the UDRP to achieve a fair balance between the interests of registrants and trademark owners, as worded under paragraph 4(a)(iii) of the UDRP requiring both registration *and* use. Moreover, it seems to be at odds with the international human rights norms, whereby any limitations and restriction on freedom of expression must be *precise* enough and publicly accessible in order to limit the authorities’ discretion and provide individuals with adequate guidance on how to conduct their affairs.¹⁸⁶

4.3.3 “Retroactive” Bad Faith Registrations and “Renewals” in Bad Faith

A number of panels in 2009 and 2010 found “retroactive” bad faith registrations if the domain names in question were registered before trade mark rights accrued (either by registration or common law).¹⁸⁷ Such practice arguably interferes with the right to freedom of expression of the domain name owners, because it limits their expression based on a balancing of their rights with not-yet-existent rights of others. From a human rights perspective, such practice fails a

¹⁸⁴ LaFrance, Mary, *Steam Shovels and Lipstick: Trademarks, Greed, and the Public Domain*, NEV. LJ 6 (2005): 447. Perhaps comparisons could be made between the UDRP and the dilution laws of the “tarnishment” variety which applies to unauthorized uses which are thought to reflect negatively on the mark and damage its reputation.

¹⁸⁵ Lindsay, *supra* note 8, at 367.

¹⁸⁶ See UN Human Rights Committee (HRC), *General comment no. 34, Article 19, Freedoms of opinion and expression*, 12 September 2011, CCPR/C/GC/34, available at: <https://www.refworld.org/docid/4ed34b562.html> [accessed 3 December 2019].

¹⁸⁷ See *City Views Limited v. Moniker Privacy Services / Xander, Jeduyu, ALGEBRALIVE*, WIPO Case No. D2009-0643 (Mummygold.com); *Octogen Pharmacal Company, Inc. v. Domains By Proxy, Inc. / Rich Sanders and Octogen e-Solutions*, WIPO Case No. D2009-0786; *Jappy GmbH v. Satoshi Shimoshita*, WIPO Case No. D2010-1001.; *Ville de Paris v. Je Walter*, WIPO Case No. D2009-1278. [17]

“legitimate aim” of the “protecting the rights of others” requirement under the three-step test, as the rights of others in such cases do not yet exist.

In addition to “retroactive” registration as evidence of bad faith, another alarming tendency from the freedom of expression perspective is that some panelists have engaged in a practice of approving the transfers of valuable domains that were “registered in good faith” but which, according to the panelists’ findings, were “renewed in bad faith.” This was the case in the *Sporto.com* decision of 2010,¹⁸⁸ where the sole panelist held that the date of domain name renewal will be “the date on which to measure whether the disputed domain name was registered and used in bad faith.” This seems to be a finding of “retroactive bad faith” through the back door.

While such retroactive bad faith or renewal in bad faith decisions such as *Octogen*, *Mummygold* and *Sporto* were generally viewed as a radical departure from more than a decade of well-established UDRP practice, they were relied upon in some other UDRP decisions¹⁸⁹ and were included in the 2011 WIPO Overview 2.0, which purported to distil the consensus views of panelists to promote uniformity in the application of the UDRP. The inclusion of these cases in WIPO Overview 2.0 resulted in a record number of abusive UDRP complaints, which harnessed theories of “retroactive bad faith,” being launched.¹⁹⁰ The

¹⁸⁸ *Eastman Sporto Group LLC v. Jim and Kenny (Sporto.com)*, WIPO Case No. D2009-1688.

¹⁸⁹ As Internet Commerce Association noted, “the *Octogen* and *MummyGold* decisions were cited several months late by *Phillip Securities Pte Ltd v. Yue Hoong Leong*, ADNDRC Decision DE-0900226, *Ville de Paris v. Jeff Walter*, WIPO Case No. D2009-1278 (overturned in court), and *Country Inns & Suites By Carlson, Inc. v. Shuai Nian Qing, La Duzi*, WIPO Case No. D2009-1313 (where the sole panelist used the *Octogen/MummyGold* reasoning to find that “intent” at the time of registration was no longer required),” see Circle ID, (2017) *The Rise and Fall of the UDRP Theory of ‘Retroactive Bad Faith’*, http://www.circleid.com/posts/20170507_rise_and_fall_of_udrp_theory_of_retroactive_bad_faith/, visited Dec. 06, 2019.

¹⁹⁰ Internet Commerce Association noted how “WIPO’s inclusion of these cases, which it characterized as “a developing area of UDRP jurisprudence”, implicitly legitimized these outlier theories and thereby encouraged complainants and panelists

decisions about *www.Ovation.com* and *www.Big5.com* are examples of where the panels relied primarily on the “renewed in bad faith” interpretation to order transfers of domain names.

Commentators have suggested that WIPO Overview 2.0 lent legitimacy to the theory of retroactivity and, in this way, undermined the integrity of the UDRP.¹⁹¹ It is a welcoming sign from a human rights perspective, that the 2017 WIPO Overview 3.0 aimed to rectify the situation by stating that:

<..> where a respondent registers a domain name before the complainant’s trade mark rights accrue, panels will not normally find bad faith on the part of the respondent.¹⁹²

[and]

<..>the mere renewal of a domain name registration by the same registrant is insufficient to support a finding of registration in bad faith.¹⁹³

More recent cases, such as *TOBAM* (2016)¹⁹⁴ and *Webster Financial Corporation*¹⁹⁵ have also confirmed that the “retroactivity” theory is incompatible with the UDRP. Such decisions, establishing retroactive bad faith and renewal in bad faith standards, demonstrate that the UDRP could be increasingly used not only as it was originally intended—to “combat ‘clear-cut cybersquatting instances, such as ... [swarovskijewelrywholesale.com](http://www.swarovskijewelrywholesale.com) and ukjimmychooshoes.com’”—but also “as a means for business to acquire valuable domains that they are unwilling to purchase in

to adopt “retroactive bad faith” despite it running contrary to the well-established interpretation of the UDRP and despite the ostensible purpose of the Overview, which was to set out “consensus views” rather than promulgate outlier and novel theories.”, see Circle ID, note 189.

¹⁹¹ Circle ID, (2017) The Rise and Fall of the UDRP Theory of ‘Retroactive Bad Faith’, http://www.circleid.com/posts/20170507_rise_and_fall_of_udrp_theory_of_retroactive_bad_faith/, visited Dec. 15, 2017.

¹⁹² WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Overview 3.0”), paragraph 3.8.1. ^[192]

¹⁹³ WIPO Overview 3.0, paragraph 3.9.

¹⁹⁴ *TOBAM v. M. Thestrup / Best Identit*, WIPO Case No. D2016-1990.

¹⁹⁵ *Webster Financial Corporation v. Domain Manager / Affordable Webhosting, Inc., Advertising*, NAF Claim Number: FA1612001705353.

the marketplace.”¹⁹⁶ This practice is labelled as reverse domain name hijacking (“RDNH”), which is “using a Policy in bad faith to attempt to deprive a registered domain name holder of a domain name.”¹⁹⁷ While the number of official RDNH findings is increasing, however, such bad faith complainants are not held liable for such complaints,¹⁹⁸ permitting trademark owners to exploit the gaps in the UDRP system by filing a frivolous claim attempting to “wrongfully deprive a legitimate registrant of a domain name.”¹⁹⁹ Arguably, lack of provision in the UDRP addressing RDNH further undermines the right to freedom of expression.

4.3.4 Relaxation of the Bad Faith Requirement for Criticism Websites

Finally, the relaxation of the bad faith requirements in recent cases concerning “criticism websites” is also problematic from a human rights perspective because it could lead to violation of the right to freedom of expression. For example, in 2016, the Forum arbitration panel held:

Respondent uses the *philipmorrisgripesite.com* domain name in bad faith under Policy ¶ 4(a)(iii) because the domain name incorporates Complainant’s trademark to resolve to a website containing information critical of Complainant. While Respondent is free to criticize Complainant on its website,

¹⁹⁶ DomainArts, *Surge in misuse of UDRP for attempted domain theft leads to record year for Reverse Domain Name Hijacking decisions*, 18 December 2013, <http://www.domainarts.com/2013/12/18/surge-in-misuse-of-udrp-for-attempted-domain-theft-leads-to-record-year-for-reverse-domain-name-hijacking-decisions/>

¹⁹⁷ UDRP Rules, Section 1, Definitions, “Reverse Name Hijacking.”

¹⁹⁸ UDRP Rules, Section 1, Definitions, “Reverse Name Hijacking.” There do not appear to be significant consequences for RDNH under the UDRP: it simply directs UDRP panels to, when appropriate, declare that the complaint was brought in bad faith. A list of RDNH decisions is available at www.rdnh.com.

¹⁹⁹ See Schultz, Catherine A. and Hofflander, Courtney A. (2013), *Reverse Domain Name Hijacking and the Uniform Domain Name Dispute Resolution Policy: Systematic Weaknesses, Strategies for the Respondent, and Proposed Policy Reforms*, CYBARIS@: Vol. 4: Iss. 2, Article 2, <http://open.mitchellhamline.edu/cybaris/vol4/iss2/2>, p.220.

Respondent cannot use Complainant's trademark in a domain name directing Internet users to its criticism website.²⁰⁰

This is problematic from a human rights perspective because criticism and critical speech is protected under the right to freedom of expression, which can only be limited where such limitation is proportionate as assessed by the three-step test. That usually does not permit infringement of the right to freedom of expression in circumstances where the limitation is to avoid inconvenience or embarrassment to others.²⁰¹ As it was mentioned earlier, the right to freedom of expression covers expression that may "offend, shock or disturb" certain groups in society.²⁰²

As put by one prominent domain names attorney Zak Muscovitch: 'Domain names are of utility for more than just trademarks and trademark owners.'²⁰³ However, recent reasoning of the panels in the *Philip Morris* and *Marlboro*²⁰⁴ cases seem to suggest that the bad faith requirement is satisfied simply because the trademark is incorporated into the domain name of the criticism website. Such reasoning potentially has a substantial chilling effect on the right to freedom of expression.

²⁰⁰ See *Philip Morris USA Inc. v. LORI WAGNER / DAVID DELMAN / DAVID@DELMAN.TV*, Claim Number: FA1601001655503 (Forum, February 13, 2016) (where the respondent's bad faith use or registration was found to be indefensible by any claim that using a confusingly similar domain name was protected by free speech rights). See also *Diners Club International, Limited v. Infotechnics Ltd.*, Claim No: FA 169085 (where the respondent's registration and use of a domain name nearly identical to the complainant's mark to criticize complainant's business practices was found to be evidence of registration and use of the <dinners-club.net> domain name in bad faith pursuant to Policy ¶ 4(a)(iii)).

²⁰¹ See UN Human Rights Committee (HRC), *General comment no. 34, Article 19, Freedoms of opinion and expression*, 12 September 2011, CCPR/C/GC/34, available at: <https://www.refworld.org/docid/4ed34b562.html> [accessed 3 December 2019].

²⁰² Handyside case, *supra* note.

²⁰³ Quote by Zak Muscovitch, 12th February 2018, on file with Author.

²⁰⁴ Discussed above in section 4.1.4.

4.4 Three Elements in Action, Three Elements Together

While the text of the UDRP requires complainants to demonstrate all three elements of “confusing similarity”, ‘legitimate interest’ and “bad faith”;²⁰⁵ sometimes panelists treat these elements as optional factors and decide a case in favour of the complainant when any two of the three favour the complainant.²⁰⁶ In particular, the panels occasionally combine the ‘legitimate interest’ and “bad faith” requirements into one. WIPO Overview 3.0 also confirms: “[i]n some cases...panels assess the second and third UDRP elements together, for example where clear *indicia* of bad faith suggest there cannot be any respondent rights or legitimate interests. In such cases, panels have found that the facts and circumstances of the case would benefit from a joint discussion of the policy elements.”²⁰⁷ For instance, in a case concerning *ado.com*,²⁰⁸ instead of analysing whether the registrants had a legitimate interest in a valuable generic domain name, the panel moved on to “bad faith”, which they found to be established even when the respondent did not know of the complainant’s ‘famous’ mark because the respondent had failed to make inquiries about the existence of the complainant’s mark:

[It] does not excuse wilful blindness in this case, as it seems apparent from the record that even a cursory investigation by Respondent would have disclosed Complainant's mark especially given the use made of the Domain Name of which

²⁰⁵ If any doubt remained despite there being an “and” between each element, it is resolved by the words: “In the administrative proceeding, the complainant must prove that each of these three elements are present.”: UDRP Policy, *supra* note 3, paragraph 4(a).

²⁰⁶ See, e.g., *Wachovia Corp. v. Flanders*, WIPO Case No. D2003-0596.

²⁰⁷ Section 2.15 of *WIPO Overview 3.0*, note 173.

²⁰⁸ *Autobuses de Oriente ADO, S.A. de C.V. v. Private Registration / Francois Carrillo*, Case No. D2017-1661, <https://www.wipo.int/amc/en/domains/search/text.jsp?case=D2017-1661>, accessed Dec. 5, 2019.

Respondent was aware when negotiating for the Domain Name.

It seems that the panelist lumped ‘legitimate interest’ and “bad faith” together, finding that the asking price for the domain name made it clear that there was no legitimate interest and that it was registered and used in bad faith.²⁰⁹ Such interpretative practice of conflating two elements, however, undermines the fair balance that is sought by the UDRP rules, which explicitly provide that the complainant must prove each of the three elements.²¹⁰

Overall, the loose manner that the three elements—separately and together—have been interpreted by some panels entails significant implications for the right to freedom of expression, equality and non-discrimination. The next section considers what might be done in the upcoming review process to bring the UDRP in line with internationally recognised human rights so that ICANN has a better chance at making good on its newly pronounced commitment to respect those rights.

5 Fixing the Substance of the UDRP: What should be Done from a Human Rights Perspective?

Numerous aspects of the UDRP are problematic from a human rights perspective and it is beyond the scope of this paper to

²⁰⁹ In *Autobuses de Oriente ADO, S.A. de C.V. v. Private Registration / Francois Carrillo*, Case No. D2017-1661, <https://www.wipo.int/amc/en/domains/search/text.jsp?case=D2017-1661>, accessed Dec. 5, 2019, the panel held: “In conclusion, the Panel determines that, for all of the above reasons, the Domain Name was registered and is being used in bad faith. Accordingly, Complainant has satisfied the second and third element of the Policy.”

²¹⁰ Similar arguments made by Jennifer Arnette-Mitchell, *State Action Reborn Again: Why the Constitution Should Act as a Checking Mechanism for ICANN’s Uniform Dispute Resolution Policy*, 27 HAMLIN J. PUB. L. & POL’Y 307 (2006), at 33; Norton *supra* note 87, at 151.

propose fixes to all of them. However, many of the considerations raised in this article in relation to each substantive element under the UDRP, and the relationship of those elements to one another, arise from the text of the UDRP being insufficiently precise about the Policy's objectives. Therefore, in this section, I argue that the upcoming review process must, first of all, clarify the UDRP's objectives, translating them into the substantive elements with precision to ensure that the UDRP is in line with international human rights law. In this section, I propose some of the ways that the reviewers of the UDRP might achieve this.

5.1 Explicit Clarification and Reaffirmation of the Narrow Scope and Limited Objectives of the UDRP

First, explicit clarification and reaffirmation of the narrow scope and limited objectives would create room for respecting and protecting the right to freedom of expression. Looking at the drafting history of the UDRP might help to clarify the UDRP's objectives. The UDRP was developed as a supplement to address the insufficiencies of trademark law, in particular in the USA.²¹¹ Therefore, the UDRP was intended to cover only a narrow range of domain name disputes: claims of "abusive registration" of a domain name made with the intent to profit from another's trademark, that is, clear-cut cases of cybersquatting.²¹² Indeed,

²¹¹ I am grateful for this point to David Lindsay via e-mail communication on 17th March 2018.

²¹² The ICANN staff report released when the policy was approved describes its scope as follows: "[The UDRP] calls for administrative resolution for only a small, special class of disputes. Except in cases involving 'abusive registrations' made with bad-faith intent to profit commercially from others' trademarks (e.g., cybersquatting and cyberpiracy), the adopted policy leaves the resolution of disputes to the courts (or arbitrators where agreed by the parties) and calls for registrars not to disturb a registration until those courts decide. The adopted policy establishes a streamlined, inexpensive administrative dispute-resolution procedure intended only for the relatively narrow class of cases of "abusive registrations." Thus, the fact that the policy's administrative dispute-resolution procedure does not extend to cases where a registered domain name is subject to a legitimate dispute (and may ultimately be found

the narrow scope of the policy was acknowledged by the drafters, who stated that the UDRP was not meant “to regulate the whole universe of interface between trademarks and domain names, but only to implement the lowest common denominator of internationally agreed and accepted principles concerning the abuse of trademarks.”²¹³ These words acknowledge that the UDRP was not meant to address the more complex and controversial issues, leaving them to be resolved according to law not found in the UDRP.²¹⁴ The 2001 WIPO report noted further that the drafting of the UDRP “was less about legislation than about the efficient application of existing law in a multijurisdictional and cross-territorial space.”²¹⁵

Therefore, the UDRP itself contemplates that most domain name disputes, including all “legitimate” disputes, are beyond its scope.²¹⁶ Taking the limited scope and objectives of the UDRP seriously, it is clear that many domain name disputes are about different issues from those which the UDRP was designed to address. It is widely agreed that those different issues would be better addressed by the national courts and not the UDRP.²¹⁷ I therefore argue that the reform process should explicitly clarify

to violate the challenger’s trademark) is a feature of the policy, not a flaw. The policy relegates all “legitimate” disputes, such as those where both disputants had longstanding trademark rights in the name when it was registered as a domain name, to the courts; only cases of abusive registrations are intended to be subject to the streamlined administrative dispute-resolution procedure.” See ICANN, *Second Staff Report on Implementation Documents for the Uniform Dispute Resolution Policy* 4.1(c) (Oct. 25, 1999), at <https://archive.icann.org/en/udrp/udrp-second-staff-report-24oct99.htm>.

²¹³ WIPO Report, *Recognition of Rights and the Use of Names in the Internet Domain Name System: Report of the Second Wipo Internet Domain Name Process*, WIPO 3rd September 2001, <http://www.wipo.int/export/sites/www/amc/en/docs/report-final2.pdf>, accessed 06 December 2019, at 21-22.

²¹⁴ Laurence R. Helfer, *Whither the UDRP: Autonomous, Americanized, or Cosmopolitan?*, 12 CARDOZO J. INT’L & COMP.L. 493, at p. 494 (2004) (noting that the UDRP was designed to supplement, but not replace, domestic cybersquatting litigation).

²¹⁵ WIPO Report, *supra* note 213, pp. 21-22.

²¹⁶ ICANN, *Second Staff Report on Implementation Documents for the Uniform Dispute Resolution Policy* 4.1(c) (Oct. 25, 1999), at <https://archive.icann.org/en/udrp/udrp-second-staff-report-24oct99.htm>.

²¹⁷ Froomkin, *supra* note 21.

and reaffirm this narrow scope of the UDRP, which seems to have been long buried.

The clarification and reaffirmation of the narrow scope of the UDRP should be further strengthened via a clear articulation of the nexus between the UDRP objectives and substantive policy elements. In particular, the limited objectives should shape the substantive elements of the policy and their interpretation by the panelists. This is needed urgently because, as the drafting history reveals, numerous policy aspects were drafted in an *ad hoc* manner without clear reference to either the purpose of the UDRP or the precise role individual substantive elements were to play.²¹⁸ Many deficiencies and irregularities in the UDRP drafting process were noted by commentators and scholars who participated in an international consultative process, through which the UDRP was developed and adopted in the very first ICANN meeting in 1998.²¹⁹

Lack of clarity around the purpose of the UDRP and the precise role individual substantial elements were to play, in turn, leaves panelists to adopt either a broad or narrow approach to the application of the three substantive UDRP elements. As David Lindsay notes, two sharply contrasting interpretative positions can be distinguished in the UDRP jurisprudence: 1) that registration of a mark as a domain name is inherently suspect; or 2) that people should be free to register marks as domain names unless the registration and use of the mark is abusive or in bad faith.²²⁰ It is beyond the scope of this paper to, other than very briefly, explore the fundamental tension between these positions and their relation to trademark law.²²¹ However, in the following sections, I argue that the narrow scope and limited objective of the UDRP—to prevent clear-cut cybersquatting—should affect

²¹⁸ Froomkin, *supra* note 21.

²¹⁹ Froomkin, *supra* note 21.

²²⁰ Lindsay, *supra* note 8, at [3.15].

²²¹ As Lindsay notes in his detailed and authoritative book on the UDRP (Lindsay, *supra* note 8 at [3.15].), similar tension also exists under national laws – for example, the action in passing off as dealt with in the *One in a Million* case.

and shape the elements of the policy, their interpretation, and provide room for respect and protection of the right to freedom of expression.

5.1.1 “Confusing Similarity”

If the UDRP was specifically designed to prevent clear-cut cybersquatting that was not addressed by trademark law,²²² then the standard of “confusing similarity” under the UDRP must be a different concept than that of the “source of confusion” or “likelihood of confusion” under trademark law.²²³ Given this objective to cover the gap that the trademark law failed to cover, “confusing similarity” under the UDRP might be similar to the ‘initial interest confusion’ doctrine under US trademark law.²²⁴ Taking the objectives of preventing cybersquatting into account, the interpretation of the first element as applying to *sucks*-type domain names might be suitable, provided that the freedom of expression concerns discussed above are addressed in the subsequent elements of the policy.

Therefore, the objective of the UDRP to prevent clear-cut cybersquatting requires a clear articulation in the reformed policy and the accompanying “consensus view” documents that the first element should be treated as a threshold requirement

²²² Early efforts in the US to fight cybersquatting involved traditional trademark infringement and dilution claims, see Kevin Eng, *Breaking Through the Looking Glass: An Analysis of Trademark Rights in Domain Names Across Top Level Domains*, 6 B.U. J. SCI. & TECH. L. 7 (2000), at <http://www.bu.edu/law/scitech/volume6/Eng.htm>.

²²³ See Bartow, Ann, *Likelihood of confusion*, 41 SAN DIEGO L. REV. 721 (2004); See also Greene, Kevin J., *Abusive trademark litigation and the incredible shrinking confusion doctrine-trademark abuse in the context of entertainment media and cyberspace*, 27 HARV. JL & PUB. POL’Y 609 (2003).

²²⁴ “Initial interest confusion” is a legal doctrine under trademark law, and is different from standard of likelihood of confusion - in that it permits a finding of infringement when there is temporary confusion that is dispelled before the purchase is made, see Rothman, Jennifer E., *Initial interest confusion: standing at the crossroads of trademark law*, 27 CARDOZO L. REV. 105 (2005); Scott, Clifford D. *Trademark strategy in the internet age: Customer hijacking and the doctrine of initial interest confusion*, 89.2 JOURNAL OF RETAILING 176 (2013); Zweihorn, Zachary J., *Searching for Confusion: The Initial Interest Confusion Doctrine and Its Misapplication to Search Engine Sponsored Links*, 91 CORNELL L. REV. 1343 (2005).

only. In other words, that it should be adequate for the domain name to be sufficiently confusing for the purposes of cybersquatting; for example, attracting unsuspecting Internet users. However, a holistic approach to the UDRP elements—together with the acknowledged policy that the UDRP should only apply to the most obvious cases of cyber-squatting—requires an explicit reaffirmation in the reform process that the UDRP was never meant to apply to prevent use of a trademark in a domain name for the purpose of genuine criticism or information sites, as secured by the right to freedom of expression.

5.1.2 “No Rights or Legitimate Interest”

From a human rights perspective, the protection and respect for the right to freedom of expression (and non-discrimination) could be best dealt with under the second UDRP element, requiring a claimant to prove that the respondent has “no rights or legitimate interest” in the domain name. This means that, even if a domain name is “confusingly similar,” that should not in itself prevent the existence of a legitimate interest in the domain; for example, a website criticising and providing information about the claimant or their business. However, as numerous examples discussed in this article reveal, the divergent interpretations and application of differential standards results in many problems for protecting and respecting freedom of expression under the second UDRP element. To alleviate these problems, defences available to the respondent need to be substantially revisited (see 5.3 below), along with an explicit reaffirmation of the cumulative nature of the requirement of registration *and* use under the bad faith element.

5.1.3 “Bad Faith”

Because the three-step test requires any limitation and restriction on freedom of expression to be *precise* enough and publicly

accessible in order to respect internationally recognised standards for freedom of expression, the upcoming UDRP reform needs to clarify the cumulative nature of the bad faith requirement as entailing both registration and use. In particular, the divergence between the wording of the policy and its interpretation among different panelists creates confusion and does not provide registrants with adequate clarity and guidance when their rights to exercise freedom of expression could be legitimately limited.²²⁵

5.2 Affirmative Defences & Burden of Proof in Practice

The upcoming reform should rectify an imbalance in existing practice between the grounds for finding lack of legitimate interest and the presence of bad faith, and the number of defences that may mitigate or disprove either finding. While both the grounds in UDRP paragraphs 4(b) and (c) and the affirmative defences are non-exhaustive in theory,²²⁶ it seems that respondents have been unsuccessful in finding new circumstances in practice.²²⁷ This imbalance becomes particularly acute when combined with another problematic issue in the affirmative defences, namely, the loose application of the burden of proof principles. For instance, the claimant only needs to make a *prima facie* case that the respondent has “no rights or legitimate interests” before the burden of proving such rights then shifts to the respondent.²²⁸ This means that transfers of domain name might occur not only when the complainant

²²⁵ See UN Human Rights Committee (HRC), *General comment no. 34, Article 19, Freedoms of opinion and expression*, U.N. Doc CCPR/C/GC/34 (Sept. 12, 2011), <https://www.refworld.org/docid/4ed34b562.html> (last visited Dec. 3, 2019).

²²⁶ UDRP Policy, *supra* note 3 sec.4c(3) states: “Any of the following circumstances, in particular but without limitation <..>.”

²²⁷ HEDLEY, S., *THE LAW OF E-COMMERCE AND THE INTERNET IN THE UK AND IRELAND* 200 (2006).

²²⁸ See 5(c)(i) of the UDRP Rules that the respondent must “[r]espond specifically to the statements and allegations contained in the complaint and include any and all bases for the Respondent (domain-name holder) to retain registration and use of the disputed domain name.”

proves UDRP paragraph 4(a)(ii), but also when the respondent fails to disprove them.²²⁹ The implications of this imbalance may be mitigated through a procedural reform of maintaining the burden of proof on the claimant and, potentially, the articulation of additional defences to make the UDRP more predictable and consistent.

5.3 Inclusion of “Unreasonable Delay Defence”

A defence of an unreasonable delay—also known as “laches” in the US—should be recognised and included in the updated UDRP list of defences in light of the length of delays in bringing some UDRP complaints.²³⁰ A defence of unreasonable delay has been raised regularly by respondents in UDRP proceedings since the early days of the policy in late 1990s and early 2000s, though it was rejected by many panelists who argued that it was “not available” under the UDRP.²³¹ However, this equitable defence, which is not suited for claims for legal relief such as damages, perfectly aligns with the UDRP provision for equitable relief, that is, the transfer of the domain name. Therefore, the imbalance between the limited defences available to the respondent and non-exhaustiveness of circumstances providing evidence for “no rights or legitimate interests” may be rectified by recognition of defence of unreasonable delay. Such defence should work in combination with a legitimate interest and/or good faith defence; and should decrease numbers of frivolous complaints against

²²⁹ For a reversal of burden of proof in the UDRP, see J. R. Hildenbrand, *A Normative Critique of Private Domain Name Dispute Resolution*, 22 J. MARSHALL J. COMPUTER & INFO. L. 625 (2004).

²³⁰ For a doctrinal overview of and proposal to include laches defence in the UDRP, see Zak Mustakovich *A Re-Examination of the Defense of Laches After 18 Years of the UDRP*, CIRCLEID, Jan. 15 2018, http://www.circleid.com/posts/20180115_re_examination_of_the_defense_of_laches_after_18_years_of_the_udrp/#ref2 (last visited Dec. 19, 2019).

²³¹ WIPO Consensus View 3.0 Section 4.17, *supra* note 173, stating that the defence has been rejected on the basis that it is “impractical to require a trademark owner to instantly enforce trademarks against cybersquatters” and that since laches is an “equitable remedy,” is not applicable to the UDRP because “the UDRP is intended to provide injunctive relief to prevent abuse.”

aged domains and provide the registrants of aged domains with a reliable defence.

5.4 Introduction of a Clear Choice-of-Law Clause

The upcoming reform should introduce a clear choice-of-law clause which would address a substantial policy gap and eliminate the discretion of panelists "to apply any rules and principles of law that [they] deem applicable."²³² While concerns around the lack of a choice-of-law provisions also fall within discussions about procedural aspects of the UDRP, they nonetheless intersect significantly with substantial UDRP issues. In particular, they touch on an important question as to whether the UDRP is a *sui generis* international framework or whether national law should be applied in UDRP proceedings.²³³

Absence of a choice-of-law clause in the UDRP is surprising, given the officially acknowledged aim of the UDRP drafters that the system was not meant "to regulate the whole universe of interface between trademarks and domain names, but only to implement the lowest common denominator of internationally agreed and accepted principles concerning the abuse of trademarks."²³⁴ In this regard, it is paramount to resolve the lack of choice-of-law clause in the UDRP because, as was demonstrated above, the murky clause has led to numerous interrelated issues including: the application of different law and different outcomes based on the nationalities of the parties and/or the panelists; forum shopping; or inconsistent application and unpredictability of outcomes based on similar facts. To increase predictability and uniformity of the UDRP, as well as bring it in line with international human rights to equality

²³² 15(a) of the UDRP Rules state: "A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

²³³ See, e.g., Laurence R. Helfer, *supra* note 214 at 495 (explaining that "certain reforms of the UDRP would enhance its status as a distinct body of law and further distance it from national legal systems.").

²³⁴ WIPO Report, *supra* note 213, at 21-22.

and non-discrimination, a clear choice-of law clause must be developed.

5.5 Development of a Uniform “Consensus View”

Finally, an explicit, uniform “consensus view” of the legitimate interest defences and evidence of bad faith needs to be developed at an ICANN level—not individual DRP—in the upcoming reform process to avoid what, in practice, is a denial of affirmative defences or yet another “retroactive bad faith theory.” Such consensus view would further clarify the issues that attracted conflicting interpretations, such as the treatment of parody, criticism and informational websites, as well as define contentious terms, such as the common law trademark. In other words, an ICANN-level consensus view should be developed to provide guidance to arbitrators and ensure the overall predictability and fairness of the system. Most of all, the introduction of such uniform guidance would help to ensure that the UDRP and ICANN are fulfilling ICANN’s new Core Value of respecting “internationally recognized human rights.”

6 Conclusion

The UDRP was developed to protect economic interests and resolve disputes on trademarks and domain names. However, protection of economic interests often also impacts the exercise of fundamental human rights. The UDRP is not an exception, and it affects freedom of expression and association, and ingrains some human rights concerns within the UDRP procedure itself, such as the right to fair trial (which I discuss in a separate piece).²³⁵ In this article, I have used an international human rights framework to analyze the effectiveness of the substantive policy of the UDRP. I overviewed human rights law

²³⁵ See Zalnieriute, *supra* note 4.

as it applies to the UDRP and ICANN; and critiqued of the current UDRP through the lens of international human rights law. Applying a human rights lens to the substantive UDPR provisions and their interpretation suggests that they may not conform with “internationally recognised human rights” of freedom of expression, equality, and non-discrimination. I argue that these are not merely trivial externalities but indications that the UDRP system as a whole may lack basic fairness and impartiality; and needs to be reformed.

The dangers of invoking trademark protection as a means to limit freedom of expression has been previously highlighted both in the academic literature,²³⁶ and more recently by intergovernmental organisations, such as the Council of Europe.²³⁷ These organisations, along with ICANN’s Cross Community Working Party on ICANN and Human Rights (CCWP-HR) point to the need for reform to better reflect ICANN’s mission to operate in the public interest and in accordance with its Bylaws. More emphasis on internationally recognised human rights in the upcoming UDRP review is particularly needed for ICANN to fulfil its global public interest role and ensure human rights protection. This call is even more acute now, as the IANA transition is taking place and ICANN is developing its “Accountability Package”, in which human rights have received special explicit recognition. This recognition requires ICANN to ensure that the human rights baseline is taken into account in everyday operation of the UDRP, and the upcoming UDRP review process.

While human rights analysis does not yield precise policy prescription, it allows to scrutinize ICANN’s policies, expanding the ambit of potential policy reforms in the upcoming

²³⁶ W. Sakulin, *Trademark Protection and Freedom of Expression: An Inquiry into the Conflict between Trademark Rights and Freedom of Expression under European, German, and Dutch Law*, UNIVERSITY OF AMSTERDAM, 2010. Online: <http://dare.uva.nl/document/169804>, p. 210.

²³⁷ Zalnieriute & Schneider, *supra* note 96, p. 29.

UDRP review. In this article, I argued that bringing the UDRP in line with internationally recognized human rights requires an explicit reaffirmation of the narrow scope of the UDRP and offered six concrete proposals for how this might be achieved. I have in particular argued that without more clearly translating the overall objectives and purpose of the UDRP into its substantial elements, the upcoming UDRP review will not fundamentally “reform” the UDRP. I suggested lack of clear articulation and reflection of the UDRP objectives in the substantial elements has left it open for panelists to adopt interpretations of the three substantive UDRP elements that are overly broad and problematic from a human rights perspective. I argued that the dominant view adopted by the UDRP panelists (and also codified in the latest WIPO consensus view) —that the registration of a mark as a domain name is inherently suspicious under the UDRP (unless proven otherwise) —is incompatible with the internationally recognised right to freedom of expression. It also contravenes the narrow scope of the UDRP. Given that the UDRP was designed to deal only with the most obvious cases of cybersquatting, the policy should never be interpreted to prevent uses of a mark for genuine criticism or information sites, as secured by the right to freedom of expression. In other words, the narrow scope of the UDRP requires a narrow interpretation: that individuals should be free to register marks as domain names unless the registration and use of the mark is abusive and in bad faith. Reading the UDRP narrowly is not depriving claimants of a remedy because they can get that through municipal courts.

Currently however, the UDRP’s substantial policy falls short of internationally recognized human rights protections. If such a system is used as a model for the development of other infrastructure-based global policies, alternative dispute resolution (ADR) mechanisms, and future development of access to justice, there is a danger that the role of fundamental

human rights, and their protection in the digital age, will be very limited. We should not let that happen.