Topic 5:
WIPO Arbitration and Mediation: Alternative Dispute Resolution

Dr. Luca Barbero,
STUDIO BARBERO, Torino

Treviso - April 10, 2019

© Luca Barbero 2019
AGENDA

- WIPO Arbitration and Mediation Center
- WIPO Mediation
- WIPO Arbitration and Expedited Arbitration
- WIPO Domain Name Dispute Resolution Services
WIPO Arbitration and Mediation Center

- Facilita la risoluzione di controversie commerciali in merito a questioni relative a diritti di Proprietà Intellettuale e Information Technology, attraverso procedure alternative rispetto alla magistratura ordinaria (“Alternative Dispute Resolution”: ADR)
- Gli Arbitri WIPO sono specializzati e con una solida esperienza in IP and IT e pertanto capaci di rendere decisioni e lodi molto accurati ed in modo efficiente
- Le fees WIPO sono molto competitive anche in quanto si tratta di una struttura not-for-profit
- Neutralità internazionale della WIPO
- Sedi a Ginevra e a Singapore
Mediazione, Arbitrato, Determinazione di un Esperto

- **Mediation**: an informal consensual procedure in which a neutral intermediary, the mediator, assists the parties in reaching a settlement of their dispute, based on the parties’ respective interests. The mediator cannot impose a decision. The settlement agreement has the force of a contract. Mediation leaves open court or agreed arbitration options.

- **Arbitration**: a consensual procedure in which the parties submit their dispute to one or more chosen arbitrators, for a binding and final decision (award) based on the parties’ respective rights and obligations and enforceable internationally. Arbitration normally forecloses court option.

- **Expert Determination**: a consensual procedure in which the parties submit a specific matter (e.g. technical question) to one or more experts who make a determination on the matter, which can be binding unless the parties have agreed otherwise.
Motivi per ricorrere ad una WIPO ADR per controversie IP

- **Cost of IP court litigation**
  - Calls for cost-effective procedures

- **Internationalization of creation/use of IP**
  - Calls for cross-border solutions
  - Awards enforceable under the New York Convention

- **Technical and specialized nature of IP**
  - Calls for specific expertise of the neutral

- **Short product and market cycles**
  - Calls for time-efficient procedures

- **Confidential nature of IP**
  - Calls for private procedures

- **Collaborative nature of IP creation and commercialization**
  - Calls for mechanisms that preserve relations
Esiti di un sondaggio WIPO 2018

WIPO Center Report on International Survey of Dispute Resolution in Technology Transactions
Opzioni della WIPO ADR

- ADR contract clause electing WIPO Rules
  - WIPO Mediation, and/or
  - WIPO Arbitration / Expedited Arbitration, and/or
  - WIPO Expert Determination
- **Model clauses**: [www.wipo.int/amc/en/clauses](http://www.wipo.int/amc/en/clauses)
  - Parties can shape the process via the clause (e.g., location, language, law)
- ADR submission agreement electing WIPO Rules, e.g., in existing non-contractual disputes
- Unilateral request for WIPO Mediation by one party (Art. 4 WIPO Mediation Rules)
- Court referrals

- Shares growing experience of IP Offices and WIPO Center in the context of public ADR programs
- Presents options for interested IP Offices to promote and, where desired, integrate ADR options into their existing services
- Available in Chinese, English, French and Spanish and for download on WIPO Center webpage

Developments relating to WIPO mediation

WIPO Mediation Pledge for IP and Technology Disputes

The World Intellectual Property Organization (WIPO) through its Arbitration and Mediation Center contributes to awareness of alternative dispute resolution (ADR) options for resolving IP and technology disputes.

Without binding parties, the WIPO Mediation Pledge for IP and Technology Disputes seeks to encourage the use of mediation to reduce the impact of disputes in innovation and creative processes.

As a signatory of this Pledge, we recognize that mediation may offer a more collaborative, time- and cost-efficient manner of resolving commercial disputes related to IP and technology than court litigation.

In light of this, to the extent we consider this appropriate:

- **Companies, Universities, R&D Centers, and Individuals**
  - We are prepared to explore the inclusion of mediation clauses in contracts and agreements we are party to.
  - In the absence of such clauses, we are prepared to explore the resolution of existing disputes through mediation.

- **Lawyers and Law Firms**
  - So that clients can make informed choices:
    - We are prepared to explore with clients the inclusion of mediation clauses in contracts and agreements they are party to.
    - In the absence of such clauses, we are prepared to explore with clients the resolution of existing disputes through mediation.

We understand that this Pledge creates no legal rights or obligations and does not limit the use of any other dispute resolution options deemed appropriate, including court litigation.

We agree to be listed as a signatory on WIPO’s website.

Signature: ________________________________

Opzioni della WIPO ADR

WIPO Contract Clause/Submission Agreement

(Negotiation)

Mediation

Expert Determination

Determination

Settlement

Expedited Arbitration

Award

Arbitration

Party Agreement

First Step

Procedure

Outcome
Esempi di clausole WIPO: Mediazione seguita da Arbitrato Accelerato

"Any dispute, controversy or claim arising under, out of or relating to this contract and any subsequent amendments of this contract, including, without limitation, its formation, validity, binding effect, interpretation, performance, breach or termination, as well as non-contractual claims, shall be submitted to mediation in accordance with the WIPO Mediation Rules. The place of mediation shall be [specify place]. The language to be used in the mediation shall be [specify language]."

If, and to the extent that, any such dispute, controversy or claim has not been settled pursuant to the mediation within [60][90] days of the commencement of the mediation, it shall, upon the filing of a Request for Arbitration by either party, be referred to and finally determined by arbitration in accordance with the WIPO Expedited Arbitration Rules. Alternatively, if, before the expiration of the said period of [60][90] days, either party fails to participate or to continue to participate in the mediation, the dispute, controversy or claim shall, upon the filing of a Request for Arbitration by the other party, be referred to and finally determined by arbitration in accordance with the WIPO Expedited Arbitration Rules. The place of arbitration shall be [specify place]. The language to be used in the arbitral proceedings shall be [specify language]. The dispute, controversy or claim referred to arbitration shall be decided in accordance with [specify jurisdiction] law."

Il ruolo della WIPO

**WIPO Center can**
- provide information and procedural advice
- assist parties in considering the referral of a dispute to WIPO proceedings
- assist parties in the selection of specialized mediators, arbitrators, or experts
- arrange for support services, including meeting rooms and videoconferencing facilities
- WIPO ECAF (optional online case management)

**WIPO Center cannot**
- provide legal advice or represent parties in a dispute
- force any party to participate in WIPO proceedings
WIPO Electronic Case Facility (ECAF)

- Facile ed immediato accesso a tutti di documenti; Centralizzato; Sicuro; Disponibile su richiesta delle parti

Esempi di tipiche materie del contendere in casi WIPO

- **Contractual**
  - patent licenses
  - software and other information technology
  - research and development agreements
  - trademark coexistence agreements
  - distribution agreements
  - joint ventures
  - IP settlement agreements

- **Non-contractual infringement of IP rights**

- 2018: 60 mediation, arbitration, and expert determination cases in different areas of IP
Tipiche materie del contendere in casi WIPO

- **Trademarks**
  - Coexistence
  - Infringements
  - Licenses
  - Oppositions
  - Revocations
  - 17%

- **Copyright**
  - Art
  - Broadcasting
  - Entertainment
  - Film and Media
  - Infringements
  - TV Formats
  - 25%

- **Patents**
  - Cross-licensing
  - Infringements
  - Licenses
  - Ownership
  - Patent Pools
  - R&D / Tech Transfer
  - Royalty Payment
  - 28%

- **ICT**
  - Mobile Apps
  - Outsourcing
  - Systems Integration
  - Software Development
  - Software Licensing
  - Telecommunications
  - 21%

- **Commercial**
  - Distribution
  - Energy
  - Franchising
  - Marketing
  - Sports
  - 9%
Tempi e costi medi dei casi WIPO

* Excluding cost of parties legal representation
Mediation, ( Expedited ) Arbitration, Expert Determination Fee Calculator

The fees referenced below are estimates, in United States dollars. Final amounts payable are to be decided in consultation with the Center.

Type of Procedure

- Mediation

Amount in Dispute in USD

- 500000

Dispute is not quantifiable or Request does not indicate any claims for a monetary amount

- ✔

WIPO PCT Filer, Hague System Filer, Madrid System Filer, WIPO Green Technology Provider or Seeker

- ✔

Schedule of Fees

- Mediation
- Arbitration / Expedited Arbitration
- Expert Determination
- Emergency Relief Proceedings (Effective from June 1, 2014)

Registration Fee

- No Registration Fee

Administration Fee

- USD 375

Mediator's Fee

- Amount in dispute up to USD 250,000: USD 2,500. Amount in dispute over USD 250,000: USD 300-USD 600 per hour USD 1,500-USD 3,500 per day.

For further information and payment details, click on the applicable schedule of fees and costs on the right hand side of the page.
Step 3 – Build your clause: WIPO Mediation followed, in the absence of a settlement, by Arbitration Clause

Mediation

The parties should determine where they want the mediation to take place.

- The place of mediation shall be [specify place].

Arbitration

Any dispute, controversy or claim arising under, out of or relating to this contract and any subsequent amendments of this contract, including, without limitation, its formation, validity, binding effect, interpretation, performance, breach or termination, as well as non-contractual claims, shall be submitted to mediation in accordance with the WIPO Mediation Rules.

The place of mediation shall be [specify place].

The language to be used in the mediation shall be [specify language].

If, and to the extent that, any such dispute, controversy or claim has not been settled pursuant to the mediation within [specify timeline] days of the commencement of the mediation, it shall, upon the filing of a Request for Arbitration by either party, be referred to and finally determined by arbitration in accordance with the WIPO Arbitration Rules. Alternatively, if, before the expiration of the said period of [specify timeline] days, either party fails to participate or to continue to participate in the mediation, the dispute, controversy or claim shall, upon the filing of a Request for Arbitration by the other party, be referred to and finally determined by arbitration in accordance with the WIPO Arbitration Rules.

The arbitral tribunal shall consist of [a sole arbitrator][three arbitrators].

The place of arbitration shall be [specify place].

The language to be used in the arbitral proceedings shall be [specify language].

The dispute, controversy or claim shall be decided in accordance with the law of [specify jurisdiction].

Step 4 – Download or copy the final result
- WIPO Mediation
Procedura in una Mediazione

COMMENCEMENT

APPOINTMENT OF MEDIATOR

INITIAL CONFERENCE

MEETINGS

CONCLUSION
Mediation of a Trademark Coexistence Dispute

North American company requested mediation with two Italian companies and one Spanish company on the basis of an agreement which the parties had reached for mediation under the WIPO Mediation Rules.

The goal of the mediation was to help the parties avoid confusion and misappropriation of their similar trademarks and to regulate future use of their marks.

Although Italian was agreed as the language of proceedings, any settlement agreement would be recorded in both Italian and English.
The Center suggested to the parties potential mediators with specific expertise in European trademark law and fluency in Italian and English.

The parties selected an Italian mediator with a trademark practice.

The mediator conducted an initial telephone conference with the lawyers of the parties in which he scheduled the mediation timing, and agreed on the procedure.
Two months later, the mediator met with the parties in a two-day session in Milan.

The meeting was held in joint session with the exception of two brief caucuses.

At the end of the second day the parties - with the assistance of the mediator - were able to draft and sign a settlement agreement covering all of the pending issues in dispute.

• WIPO Arbitration and Expedited Arbitration
**Procedura**

**WIPO ARBITRATION**

- Request for Arbitration
- Answer to Request for Arbitration (30 days)
- Appointment of Arbitrator(s)
- Statement of Claim (30 days)
- Statement of Defense (30 days)
- Further Written Statements and Witness Statements
- Hearings
- Closure of Proceedings (9 months)
- Final Award (3 months)

**WIPO EXPEDITED ARBITRATION**

- Request for Arbitration and Statement of Claim
- Answer to Request for Arbitration and Statement of Defense (20 days)
- Appointment of Arbitrator
- Hearing (maximum 3 days)
- Closure of Proceedings (3 months)
- Final Award (1 month)

- One exchange of pleadings
- Shorter time limits
- Sole arbitrator
- Shorter hearings
- Fixed fees
Arbitration of a Telecom Infrastructure Dispute (I)

A company that provides wireless communication services and a company that sells, installs and maintains telecom infrastructures concluded an agreement for the purchase of infrastructure equipment for wireless communication networks.

Both companies were based in the United States.

The purchase agreement provided that any dispute arising out of or in connection with the agreement would be resolved under the WIPO Arbitration Rules.
The seller delivered the equipment which was used by the purchaser despite alleged performance shortfalls.

Several years after the delivery of the system, the purchaser filed a request for arbitration including, inter alia, claims for breach of contract and damages.

The parties chose to appoint as sole arbitrator one of several candidates proposed by the WIPO Center: a lawyer with considerable experience with telecom infrastructure disputes.
The sole arbitrator considered substantial documentary evidence

Held a three-day hearing in California for the cross-examination of witnesses

Rendered a final award rejecting the claims.

WIPO Arbitrato Accelerato

- **Main features compared to regular arbitration:**
  - Shorter procedural timelines
  - In principle, a sole arbitrator

- **When consider WIPO Expedited Arbitration?**
  - Value in dispute does not justify the cost of more extensive procedures
  - Limited number of issues in dispute
  - Parties urgently need a final and enforceable decision
  - Parties wish to commence with an ambitious time/cost frame, subject to case developments
  - Trademarks and software disputes
La contrattualistica in materia di IP e IT deve **prevedere e disciplinare** in dettaglio l’insorgenza di controversie.

Si devono **contemplare tutti gli aspetti internazionali** della disputa quali le parti in causa, i diritti violati e la legge applicabile.

La Dispute policy deve essere strutturata per **minimizzare il tempo e i costi**, più che ogni altro aspetto.

La Dispute policy deve preferibilmente includere una prima fase dedicata alla **mediazione**.

Fra l’arbitrato e la procedura presso le corti competenti, è opportuno considerare l’**arbitrato come l’opzione più veloce e meno costosa**, specie se si opta per la versione **expedited**.
WIPO Domain Name Dispute Resolution Services
L'esperienza WIPO

Domain Name Dispute Resolution

The WIPO Arbitration and Mediation Center provides time- and cost-efficient mechanisms to resolve internet domain name disputes, without the need for court litigation. This service includes the WIPO-initiated Uniform Domain Name Dispute Resolution Policy (UDRP), under which the WIPO Center has processed over 42,000 cases.

- UDRP
- WIPO Jurisprudential Overview 3.0
- Country code top-level domains (ccTLDs)
- WIPO domain name panelists
- Fees

https://www.wipo.int/amc/en/domains
Uniform Dispute Resolution Policy

- Uniform Domain Name Dispute Resolution Policy adottata il 24 ottobre 1999 dall’ ICANN come procedura amministrativa internazionale
- Adottata da tutti i Registrars accreditati ICANN per i gTLDs (.com .net .org .biz .info .name) ed è efficace dal 1 dicembre 1999
- UDRP incorporata in ogni contratto di registrazione di un nome a dominio generico (anche dei new Generic Top Level domains come i .store, .bike, .club) e pertanto è vincolante fra le parti (ICANN, Registrars, Registrants)
- La UDRP è stata in seguito adottata anche da 75 ccTLDs
<table>
<thead>
<tr>
<th>Domain</th>
<th>Country</th>
</tr>
</thead>
<tbody>
<tr>
<td>.AC</td>
<td>Ascension Island</td>
</tr>
<tr>
<td>.AE</td>
<td>United Arab Emirates</td>
</tr>
<tr>
<td>.AG</td>
<td>Antigua and Barbuda</td>
</tr>
<tr>
<td>.AO</td>
<td>Angola</td>
</tr>
<tr>
<td>.AS</td>
<td>American Samoa</td>
</tr>
<tr>
<td>.AU</td>
<td>Australia</td>
</tr>
<tr>
<td>.BM</td>
<td>Bermuda</td>
</tr>
<tr>
<td>.BO</td>
<td>Bolivia (Plurinational State of)</td>
</tr>
<tr>
<td>.BR</td>
<td>Brazil</td>
</tr>
<tr>
<td>.BS</td>
<td>Bahamas</td>
</tr>
<tr>
<td>.BZ</td>
<td>Belize</td>
</tr>
<tr>
<td>.CC</td>
<td>Cocos Islands</td>
</tr>
<tr>
<td>.CD</td>
<td>Democratic Republic of the Congo</td>
</tr>
<tr>
<td>.CH</td>
<td>Switzerland</td>
</tr>
<tr>
<td>.CO</td>
<td>Colombia</td>
</tr>
<tr>
<td>.CR</td>
<td>Costa Rica</td>
</tr>
<tr>
<td>.CY</td>
<td>Cyprus</td>
</tr>
<tr>
<td>.DJ</td>
<td>Djibouti</td>
</tr>
<tr>
<td>.DO</td>
<td>Dominican Republic</td>
</tr>
<tr>
<td>.EC</td>
<td>Ecuador</td>
</tr>
<tr>
<td>.EU</td>
<td>European Union</td>
</tr>
<tr>
<td>.ES</td>
<td>Spain</td>
</tr>
<tr>
<td>.FJ</td>
<td>Fiji</td>
</tr>
<tr>
<td>.FM</td>
<td>Micronesia (Federated States of)</td>
</tr>
<tr>
<td>.FR</td>
<td>France</td>
</tr>
<tr>
<td>.GD</td>
<td>Grenada</td>
</tr>
<tr>
<td>.GQ</td>
<td>Equatorial Guinea</td>
</tr>
<tr>
<td>.GT</td>
<td>Guatemala</td>
</tr>
<tr>
<td>.HN</td>
<td>Honduras</td>
</tr>
<tr>
<td>.IE</td>
<td>Ireland</td>
</tr>
<tr>
<td>.IO</td>
<td>British Indian Ocean Territory</td>
</tr>
<tr>
<td>.IR</td>
<td>Islamic Republic of Iran</td>
</tr>
<tr>
<td>.KI</td>
<td>Kiribati</td>
</tr>
<tr>
<td>.LA</td>
<td>Lao People's Democratic Republic</td>
</tr>
<tr>
<td>.LC</td>
<td>Saint Lucia</td>
</tr>
<tr>
<td>.LI</td>
<td>Liechtenstein</td>
</tr>
<tr>
<td>.MA</td>
<td>Morocco</td>
</tr>
<tr>
<td>.MD</td>
<td>Republic of Moldova</td>
</tr>
<tr>
<td>.ME</td>
<td>Montenegro</td>
</tr>
<tr>
<td>.ML</td>
<td>Mali</td>
</tr>
<tr>
<td>.MP</td>
<td>Commonwealth of the Northern Mariana Islands</td>
</tr>
<tr>
<td>.MW</td>
<td>Malawi</td>
</tr>
<tr>
<td>.MX</td>
<td>Mexico</td>
</tr>
<tr>
<td>.NL</td>
<td>Netherlands</td>
</tr>
<tr>
<td>.NR</td>
<td>Nauru</td>
</tr>
<tr>
<td>.NU</td>
<td>Niue</td>
</tr>
<tr>
<td>.PA</td>
<td>Panama</td>
</tr>
<tr>
<td>.PE</td>
<td>Peru</td>
</tr>
<tr>
<td>.PH</td>
<td>Philippines</td>
</tr>
<tr>
<td>.PK</td>
<td>Pakistan</td>
</tr>
<tr>
<td>.PL</td>
<td>Poland</td>
</tr>
<tr>
<td>.PM</td>
<td>St. Pierre and Miquelon</td>
</tr>
<tr>
<td>.PN</td>
<td>Pitcairn Islands</td>
</tr>
<tr>
<td>.PR</td>
<td>Puerto Rico</td>
</tr>
<tr>
<td>.PW</td>
<td>Palau</td>
</tr>
<tr>
<td>.QA</td>
<td>Qatar</td>
</tr>
<tr>
<td>.RE</td>
<td>Reunion Island</td>
</tr>
<tr>
<td>.RO</td>
<td>Romania</td>
</tr>
<tr>
<td>.SC</td>
<td>Seychelles</td>
</tr>
<tr>
<td>.SE</td>
<td>Sweden</td>
</tr>
<tr>
<td>.SH</td>
<td>St. Helena</td>
</tr>
<tr>
<td>.SL</td>
<td>Sierra Leone</td>
</tr>
<tr>
<td>.SO</td>
<td>Somalia</td>
</tr>
<tr>
<td>.TF</td>
<td>French Southern Territories</td>
</tr>
<tr>
<td>.TJ</td>
<td>Tajikistan</td>
</tr>
<tr>
<td>.TK</td>
<td>Tokelau</td>
</tr>
<tr>
<td>.TM</td>
<td>Turkmenistan</td>
</tr>
<tr>
<td>.TT</td>
<td>Trinidad and Tobago</td>
</tr>
<tr>
<td>.TV</td>
<td>Tuvalu</td>
</tr>
<tr>
<td>.TZ</td>
<td>United Republic of Tanzania</td>
</tr>
<tr>
<td>.UG</td>
<td>Uganda</td>
</tr>
<tr>
<td>.VE</td>
<td>Venezuela (Bolivarian Republic of)</td>
</tr>
<tr>
<td>.VG</td>
<td>Virgin Islands (British)</td>
</tr>
<tr>
<td>.WF</td>
<td>Wallis and Futuna Islands</td>
</tr>
<tr>
<td>.WS</td>
<td>Samoa</td>
</tr>
<tr>
<td>.YT</td>
<td>Mayotte</td>
</tr>
</tbody>
</table>
Quando si può azionare una procedura ai sensi della UDRP?

- Quando concorrono le seguenti condizioni:
  
  i) the domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
  
  ii) the holder of the domain name has no rights or legitimate interests in respect of the domain name; and
  
  iii) the domain name has been registered and is being used in bad faith.
I tempi della procedura UDRP

- Complainant presenta il ricorso presso un Resolution Service Provider
  - in 5-10 giorni
- RSP lo notifica al titolare del DN invitandolo a presentare una replica
  - entro 20 giorni
- Respondent presenta la replica (ma decorso il termine previsto si procede comunque in “default”)
  - in 5-10 giorni
- RSP nomina il Panel traendo i nomi dall’elenco
  - entro 14 giorni
- Panel decide la controversia.

- In assenza di ricorsi alla magistratura ordinaria entro 10 giorni, il Registrar attua la decisione trasferendo direttamente il DN in capo al titolare del marchio
  - TEMPO TOTALE MEDI O = 60 – 75 GIORNI
I tempi della procedura UDRP

**UDRP Domain Name Dispute Timeline: Single Member Panel**

- Complaint Filed; Filing Fees Processed: 3 Day
- Compliance Review; Notify Complaint: 20 Day
- Response Default: 1 Day
- Panel Appointment: 16 Day
- Decision: 3 Day
- Notify to Parties, Registrar, and ICANN and Post Decision: 10 Business Days
- Decision Implemented by Registrar

**UDRP Domain Name Dispute Timeline: Three Member Panel**

- Complaint Filed; Filing Fees Processed: 3 Day
- Compliance Review; Complaint Deficiency: 5 Day
- Complaint Amended; Notify (Amended) Complaint to: 20 Day
- Co-Panelists Appointed: 5 Day
- Presiding Panel Appointed: 14 Day
- Decision: 5 Day
- Notify to Parties, Registrar, and ICANN and Post Decision: 10 Business Days
- Decision Implemented by Registrar

**UDRP**

- Est. 60 Days

- Est. 75 Days
Il ricorso ai sensi della UDRP deve contenere (1)

- i) the request that the dispute be submitted for decision in accordance to the Uniform Domain Name Dispute Policy (www.icann.org/udrp/udrp-policy-24oct99.htm), Rules (www.icann.org/udrp/udrp-rules-24oct99.htm) and the supplemental rules of the dispute-resolution Provider selected;

- ii) the full data of the Complainant or of the Agent

- iii) the preferred mean of communication (usually e-mail)
iv) The Complainant should elect to have the dispute decided by a single-member or a three-member panel and, in the case of the three-member panel, provide the names and contact details of three candidates to serve as one of the Panelist (the candidates may be drawn from any ICANN-approved Provider’s list of panelists; WIPO list is available at http://arbiter.wipo.int/domains/panel/panelists.html)

v) the name of the Respondent

vi) the domain name/s that is/are subject of the complaint
WIPO LIST OF NEUTRALS

BIOGRAPHICAL DATA

Dr. Luca BARBERO
Studio Barbero
Via Tripoli, 104
10137 Turin
Italy

Telephone: +39 011 353599
+39 339 1412764

Fax: +39 011 3819996
E-mail: luca.barbero@studiobarbero.com

Date of birth: January 18, 1964
Il ricorso ai sensi della UDRP deve contenere (3)

- vii) the Registrar with whom the domain name are registered
- viii) the trademarks or service mark on which the complaint is based
- ix) the grounds on which the complaint is made
- x) the remedies sought (…)

STUDIO BARBERO S.p.A.

BARBERO & ASSOCIATES Ltd
L’esperienza WIPO - Legal Index

Legal Index of WIPO UDRP Panel Decisions

This Legal Index covers all WIPO UDRP decisions. New decisions are added as relevant. The Center also makes available a separate WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition.

Any time you select more than one category, the search result will yield ONLY those decisions that are indexed in ALL of the categories so selected.

Search tips and examples ↓

Decided WIPO cases by domain name categories

Legal Index to WIPO panel decisions

Select all Deselect all Expand all

Collapse all

1. General
2. Substance
3. Procedure
4. National Court Proceedings Relating to UDRP

Select all Deselect all Expand all

Collapse all

1. I. Associations and Institutions
   2. II. Geographical Identifiers
   3. III. Individuals
   4. IV. Industry and Commerce
   5. V. Non-ASCII Script Registrations
      6. VI. Professional Firms
         7. VII. Education
         8. VIII. Public Sector (Governments)
WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Jurisprudential Overview 3.0”)

© 2017 World Intellectual Property Organization
All Rights Reserved

Resulting from WIPO’s care for effective remedies under a sustainable UDRP, this WIPO Jurisprudential Overview reflects, and assists the predictability of, UDRP decisions by panels appointed in WIPO cases.

> Introduction

QUESTIONS
1. First UDRP Element
2. Second UDRP Element
3. Third UDRP Element
4. Procedural Questions

1. First UDRP Element
1.1 What type of trademark rights are encompassed by the expression “trademark or service mark in which the complainant has rights” in UDRP paragraph 4(a)(i)?
1.2 Do registered trademarks automatically confer standing to file a UDRP case?
1.3 What does a complainant need to show to successfully assert unregistered or common law trademark rights?
1.4 Does a trademark owner’s affiliate or licensee have standing to file a UDRP complaint?
1.5 Can a complainant show UDRP-relevant rights in a personal name?
1. First UDRP Element
1.1 What type of trademark rights are encompassed by the expression “trademark or service mark in which the complainant has rights” in UDRP paragraph 4(a)(i)?
1.2 Do registered trademarks automatically confer standing to file a UDRP case?
1.3 What does a complainant need to show to successfully assert an unregistered or common law trademark right?
1.4 Does a trademark owner’s affiliate or licensee have standing to file a UDRP complaint?
1.5 Can a complainant show UDRP-relevant rights in a personal name?
1.6 Can a complainant’s rights in a geographical term provide standing to file a UDRP complaint?
1.7 What is the test for identity or confusing similarity under the first element?
1.8 Is a domain name consisting of a trademark and a descriptive or geographical term confusingly similar to a complainant’s trademark?
1.9 Is a domain name consisting of a misspelling of the complainant’s trademark (i.e., typosquatting) confusingly similar to the complainant’s mark?
1.10 How are trademark registrations with design elements or disclosed text treated in assessing identity or confusing similarity?
1.11 Is the Top Level Domain relevant in determining identity or confusing similarity?
1.12 Is a domain name consisting of the complainant’s mark plus a third-party trademark confusingly similar to the complainant’s trademark?
1.13 Is a domain name consisting of a trademark and a negative term (“sucks cases”) confusingly similar to a complainant’s trademark?
1.14 Is a domain name that consists of or is comprised of a translation or transliteration of a trademark identical or confusingly similar to a complainant’s trademark?
1.15 Is the content of the website associated with a domain name relevant in determining identity or confusing similarity?

2. Second UDRP Element
2.1 How do panels assess whether a respondent lacks rights or legitimate interests in a domain name?
2.2 What qualifies as prior use, or demonstrable preparations to use the domain name, in connection with a bona fide offering of goods or services?
2.3 How would a respondent show that it is commonly known by the domain name or a name corresponding to the domain name?
2.4 How does the UDRP account for legitimate fair use of domain names?
2.5 What are some core factors UDRP panels look at in assessing fair use?
2.6 Does a criticism site support respondent rights or legitimate interests?
2.7 Does a fan site support respondent rights or legitimate interests in a domain name?
2.8 How do panels assess claims of nominative (fair) use by resellers or distributors?
2.9 Do “parked” pages comprising pay-per-click links support respondent rights or legitimate interests?
2.10 Does a respondent have rights or legitimate interests in a domain name comprised of a dictionary word/phrase or acronym?
2.11 At what point in time of respondent conduct do panels assess claimed rights or legitimate interests?
2.12 Does a respondent trademark corresponding to a domain name automatically generate rights or legitimate interests?
2.13 How do panels treat complaint claims of illegal (e.g., counterfeit) activity in relation to potential respondent rights or legitimate interests?
2.14 Is the TLD under which a domain name is registered relevant in assessing respondent rights or legitimate interests?
2.15 What is the relation between the 2nd and 3rd UDRP elements?

3. Third UDRP Element
3.1 How does a complainant prove a respondent’s bad faith?
3.2 What circumstances further inform panel consideration of registration in bad faith?
3.3 Can the “passive holding” or non-use of a domain name support a finding of bad faith?
3.4 Can the use of a domain name for purposes other than hosting trademark-abusive content constitute bad faith?
3.5 Can third-party generated material “automatically” appearing on the website associated with a domain name form a basis for finding bad faith?
3.6 How does a registrant’s use of a privacy or proxy service impact a panel’s assessment of bad faith?
3.7 How does a disclaimer on the webpage to which a disputed domain name resolves impact a panel’s assessment of bad faith?
3.8 Can bad faith be found where a domain name was registered before the complainant acquired trademark rights?
3.9 Can the respondent’s renewal of its domain name registration support a finding of (registration in) bad faith?
3.10 Will panels consider statements made in settlement discussions?
3.11 Can the use of “robots.txt” or similar mechanisms to prevent website content being accessed in an online archive impact a panel’s assessment of bad faith?
3.12 Can tarnishment form a basis for finding bad faith?
L’esperienza WIPO

<table>
<thead>
<tr>
<th>Year</th>
<th>Number of Cases</th>
</tr>
</thead>
<tbody>
<tr>
<td>1999</td>
<td>1</td>
</tr>
<tr>
<td>2000</td>
<td>1857</td>
</tr>
<tr>
<td>2001</td>
<td>1567</td>
</tr>
<tr>
<td>2002</td>
<td>1267</td>
</tr>
<tr>
<td>2003</td>
<td>1100</td>
</tr>
<tr>
<td>2004</td>
<td>1178</td>
</tr>
<tr>
<td>2005</td>
<td>1456</td>
</tr>
<tr>
<td>2006</td>
<td>1824</td>
</tr>
<tr>
<td>2007</td>
<td>2156</td>
</tr>
<tr>
<td>2008</td>
<td>2329</td>
</tr>
<tr>
<td>2009</td>
<td>2167</td>
</tr>
<tr>
<td>2010</td>
<td>2686</td>
</tr>
<tr>
<td>2011</td>
<td>2764</td>
</tr>
<tr>
<td>2012</td>
<td>2884</td>
</tr>
<tr>
<td>2013</td>
<td>2565</td>
</tr>
<tr>
<td>2014</td>
<td>2634</td>
</tr>
<tr>
<td>2015</td>
<td>2754</td>
</tr>
<tr>
<td>2016</td>
<td>3086</td>
</tr>
<tr>
<td>2017</td>
<td>3074</td>
</tr>
<tr>
<td>2018</td>
<td>3447</td>
</tr>
<tr>
<td>2019</td>
<td>910</td>
</tr>
<tr>
<td>Total</td>
<td>43846</td>
</tr>
</tbody>
</table>
L’esperienza WIPO

http://wipo.int/amc/en/domains/statistics/cases.jsp
WIPO Cybersquatting Cases Grow by 12% to Reach New Record in 2018

Geneva, March 15, 2019
PR/2019/029

Trademark owners filed a record 3,447 cases under the Uniform Domain Name Dispute Resolution Policy (UDRP) with WIPO's Arbitration and Mediation Center in 2018 as businesses reacted to the proliferation of websites used for counterfeit sales, fraud, phishing, and other forms of online trademark abuse. (Annex 1)

WIPO Director General Francis Gurry said: “Domain names involving fraud and phishing or counterfeit goods pose the most obvious threats, but all forms of cybersquatting affect consumers. WIPO’s UDRP caseload reflects the continuing need for vigilance on the part of trademark owners around the world.”

WIPO’s 2018 caseload covered 5,665 domain names in total. Disputes involving domain names registered in new generic Top-Level Domains (gTLDs) accounted for some 13% of the total, with disputes most commonly found in .ONLINE, .LIFE, and .APP (Annex 2). Representing 73% of the gTLD caseload, .COM demonstrated the continuing popularity of the legacy gTLDs.

WIPO UDRP cases in 2018 involved parties from 109 countries. The U.S., with 976 cases filed, remained the first-ranked filing country, followed by France (553), the U.K. (305), Germany (244), and Switzerland (193). (Annex 3)

The top three sectors of complainant activity were banking and finance (12% of all cases), biotechnology and pharmaceuticals (11%), and Internet and IT (11%). (Annex 4) Annex 5 provides the list of top WIPO UDRP filers in 2018.
L’esperienza WIPO

<table>
<thead>
<tr>
<th>Outcome</th>
<th>Number of Cases</th>
<th>Percentage</th>
</tr>
</thead>
<tbody>
<tr>
<td>Cancellation</td>
<td>546</td>
<td>1.61%</td>
</tr>
<tr>
<td>Transfer</td>
<td>29591</td>
<td>87.35%</td>
</tr>
<tr>
<td>Complaint denied</td>
<td>3739</td>
<td>11.04%</td>
</tr>
</tbody>
</table>

WIPO UDRP: Settori di attività dei Ricorrenti
WIPO UDRP: Top 10 gTLDs in WIPO Cases (2018)
Outcome in WIPO Cases: All Years

Combined Single and Three Member Panel Decisions
- Denied: 13%
- Cancelled: 1%
- Transfer: 86%

Single Member Panel Decisions
- Cancelled: 2%
- Denied: 11%
- Transfer: 87%

Three Member Panel Decisions
- Cancelled: 1%
- Transfer: 54%
- Denied: 45%
Suggerimenti “pratici” (1)

- Ricerche esaustive sul titolare del nome a dominio al fine di acquisire ogni informazione rilevante, come ad esempio:
  - altri nomi a dominio in capo allo stesso titolare;
  - attività poste in essere dal titolare attraverso altri siti Internet e social media;
  - decisioni arbitrali nei confronti dello stesso titolare;
  - altre informazioni utili per provare l’eventuale malafede del titolare.
Suggerimenti “pratici” (2)

- Contatto attraverso una società fiduciaria allo scopo di accertare le effettive intenzioni del titolare in relazione al nome a dominio (in particolare quando il nome a dominio non è utilizzato per un sito attivo).

- Ogni informazione fornita direttamente dal titolare può essere utile al fine di provare la sua malafede.

- Quando il primo contatto col titolare del marchio è esperito direttamente dal titolare del nome a dominio, è generalmente opportuno rispondere richiedendo di fornire spiegazioni sui motivi che hanno determinato la registrazione e la natura delle richieste.

- Quando il corrispettivo richiesto è solo indicato sul sito Internet, si deve cercare di ottenere una conferma direttamente da parte del titolare del nome a dominio.
Suggerimenti “pratici” (3)

- Invio al titolare del nome a dominio di una lettera di diffida (circa il 78% dei casi sono risolti con successo in questa fase).
- Inviare una diffida è sempre opportuno in previsione di eventuali successive procedure arbitrali ai sensi della UDRP.
- Nei casi in cui le violazioni dei diritti di privativa vengano posti in essere principalmente attraverso i contenuti pubblicati sul sito web corrispondente al nome a dominio, è opportuno inviare una lettera di diffida anche al web hosting provider.
BENETTON GROUP SpA v Domain for Sale
<b>benettonssportsystem.com</b>
(WIPO Case No. D 2001-1498 - TRANSFER)
"Thanks for writing about ilovenutella.com. For the right amount I would be willing to sell to you... But before we talk about price, maybe I have a better idea... The reason I originally bought the nutella URL was in fact, because I had a similar idea to yours: to approach Ferrero."
Inviato: mercoledì 17 dicembre 2008 20:18
A: (…)
Oggetto: Re: Question about tampax.net

Thank you very much for your interest in tampax.net. The current price for this domain name is $3000. Is that acceptable with you? Thank you.

Best Regards,
Lee
Bacardi & Company Limited v. Kitty Lemmer
<martini-love.com>
(WIPO Case No. D2011-0940 - TRANSFER)
CéLINE V. Peujun Chen, Jason Zhao – <celine.online> and <celine-online.com> (WIPO Case No. D2017-0078 - TRANSFER)
Valentino S.p.A. v. Yu Juanjuan; Li Xiang Song; Hua Zhong, Fei Yang - <authenticvalentino.com> + 9 domain names (WIPO Case No. D2017-2599 - TRANSFER)
<borse-gucciborse.com> + 127 domain names
(WIPO Case No. D2012-2212 - TRANSFER)
Guccio Gucci S.p.A. v. Wode
<all-gucci-japan.com> + 164 domain names
(WIPO Case D2013-0632 - TRANSFER)
<guccibyhabitjp.org> + 183 domain names
(WIPO Case D2013-1919 - TRANSFER)
Moncler S.p.A. v. Trani Johanna, newbeta
<blackfridaymoncler.com> + 193 domain names
(WIPO Case D2017-0547 - TRANSFER)
WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION


Case No. D2013-2164

1. The Parties

Complainant is Gucci Gucci S.p.A. of Florence, Italy, represented by Studio Barbero, Italy.

Respondent is Lin Shi Jiang of Hong Kong, China.

2. The Domain Names and Registrar

The following disputed domain names (the “Domain Names”)

<allguccisalejapan.com>
<bestguccisalejapan.com>
<bestgucciwallet.com>
<biggucciwallet.com>
<cheapgucciwallet.com>
<cheapgucciyahoo.com>
<easygucciwallet.com>
<easygucciyahoo.com>
<findgucciwallet.com>
Conclusioni (1)

- Procedure ai sensi della UDRP e altre procedure alternative di risoluzione delle controversie sono relativamente semplici e poco costose

- Conducono ad una rapida soluzione della controversia

- Consentono di superare le incertezze legate alla scelta del foro ad alla legge applicabile

- Decisioni anche in “default” del Respondent
Conclusioni (2)

- Insieme pertanto ad un’efficace strategia di **registrazione preventiva di nomi a dominio** nelle estensioni generiche (anche qualche New gTLDs) e anche come CC in tutti i paesi di potenziale interesse e

- **un’accurata sorveglianza** sull’uso dei segni distintivi on line (anche nei Social Media) da parte di terzi,

- le **procedure alternative di risoluzione delle controversie** forniscono alle imprese un valido strumento per tutelare efficacemente i propri diritti di privativa industriale, anche su Internet.
Per ulteriori informazioni:

- Queries: arbiter.mail@wipo.int
- Clauses: www.wipo.int/amc/en/clauses
- Rules: www.wipo.int/amc/en/rules
- Neutrals and case examples: www.wipo.int/amc

**WIPO Arbitration and Mediation Center Offices**
- Geneva, Switzerland
- Singapore, Singapore

**WIPO External Offices**
- Rio de Janeiro, Brazil; Beijing, China; Tokyo, Japan;
- Moscow, Russia; Singapore, Singapore
Vi ringrazio per l’attenzione