

THE MERGING OF TWO WORLDS?

CYBER LAW AND TRADE LAW NORMATIVE CONVERGENCE ON INTERNET DOMAIN NAMES

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ABSTRACT

If the Internet were a national economy, it would rank in the world's top five. In the coming years, online economies will play an even larger role in the economies of both developed and developing countries. In this booming economy, Internet domain names play an important role as they reflect the business and activities of all companies. Domain names are assets that belong to economic actors and for which they fight. The Comprehensive and Progressive Agreement for Trans-Pacific Partnership Article 18.28 imposes certain requirements on each Party with respect to the management of its country-code top level domain (ccTLD) names which will be analyzed in this Article. These requirements include ensuring there is available a low cost, fair and equitable, and not overly burdensome dispute settlement procedure that does not preclude resort to court litigation. The Article also requires each Party to provide, in connection with a Party's system for the management of ccTLD names, appropriate remedies when a person registers or holds a domain name that is identical or confusingly similar to a trademark with bad faith intent to profit. There is already a great number of disputes which can only increase in number and magnitude. For a decade, the ICANN has adopted administrative proceedings for resolving domain name disputes outside of the court system—the Uniform Domain-Name Dispute-Resolution Policy. This Article also reviews recent development of the case-law, in respect to cases that involve a party from a developing country, with regard to three elements: (1) the domain name registered is identical or confusingly

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similar to a trademark or service mark; (2) rights or legitimate interests in respect of the domain name; and (3) the domain name has been registered and is being used in bad faith.

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I. INTRODUCTION

The Comprehensive and Progressive Agreement for Trans-Pacific Partnership (CPTPP) signed by 11 Pacific Rim countries on the 8th of March 2018 is a vital Free Trade Agreement (FTA). Even though the United States of America pulled out of the agreement in January 2017,¹ it is expected to boost trade among the Asia-Pacific countries by removing tariffs and non-tariffs barriers for goods. One of the advantages of the CPTPP is that it will enhance trade and investment flows by creating investment opportunities while setting rules to address both existing and emerging trade challenges.² For those in the services sector, it will allow better access to government procurement contracts in other countries, as well as provide access to a wide range of business opportunities.

One of the major features of the CPTPP is its provisions on Intellectual

¹ M. A. Khan et al., *Economic implications of the Comprehensive and Progressive Agreement for Trans-Pacific Partnership (CPTPP) on Pakistan: a CGE approach*, 7 J. ECON. STRUCTURES 2, 3 (2018).

² *Id.* See also Julien Chaisse & Lisa Zhuoyue Li, *Shareholder Protection Reloaded: Re-designing the Matrix of Shareholder Claims for Reflective Loss*, 52 STAN. J. INT’L L. 51, 63 (2016).

Property (IP) rights, which are covered in a complete chapter of the agreement.³ This chapter in the CPTPP specifies the standards required to enforce and protect IP rights across the Asia-Pacific region, including the specifications on practically all classes of rights, expanding on the structure built-up under existing international IP treaties.⁴ However, in concluding the CPTPP, the 11 Pacific Rim countries unanimously consented to the suspension of a number of provisions that were present in the first TPP IP chapter⁵ in the following areas⁶:

- The suspension of the TPP commitments on patent-term amendment and patent-term re-establishment, which accorded them the role of modifying the patent term in respect to patent office and advertisement endorsement delays.
- The suspension of all provisions managing data security for small-molecule drugs and biologics, and also certain provisions on patentable subjects, to more nearly line up with international standards under the World Trade Organization (WTO) Trade-Related Aspects of Intellectual Property Rights Agreement (TRIPS).⁷
- The suspension of the provision regarding the nature of protection for copyright and other related rights, as well as the specification on national treatment regarding payment on copyright and related rights.
- The suspension of provisions on technological protection measures (TPMs, or “digital locks”) and rights management information (RMI, or “digital watermarks” on copyrighted works).
- The suspension of all commitments relating to ISP liability, specifically on legal redress and provision of safe harbours for ISPs.
- The suspension of encrypted program-carrying satellite and cable signals provisions.
- These suspensions served to rebalance the IP chapter and to mirror the rest of the parties’ interests and preferences.

³ P. N. Upreti *From TPP to CPTPP: Why Intellectual Property Matters*, J. INTELL. PROP. L. & PRAC. 100, 100 (2018).

⁴ *Id.* See also Julien Chaisse & Puneeth Nagaraj, *Changing Lanes: Intellectual Property Rights, Trade and Investment*, 37 HASTINGS INT’L & COMP. L. REV. 223, 225 (2014).

⁵ Antonia Eliason, *Development and Regional Trade Agreements: Entrenching Structural Inequities*, 46 GA. J. INT’L & COMP. L. 635, 640 (2018).

⁶ Peter K. Yu, *Thinking About the Trans-Pacific Partnership (and a Mega-Regional Agreement on Life Support)*, 2 SMU SCI. & TECH. 97, 105 (2017); Anita Cade & Ted Talas, *IP Bite: Comprehensive and progressive?: The CPTPP is potentially neither in the case of IP laws*, ASHURST 1 (2018).

⁷ See Chaisse & Nagaraj, *supra* note 4, at 225; Julien Chaisse et al., *Deconstructing Service and Investment Negotiating Stance: A Case Study of India at WTO GATS and Investment Fora*, 14 J. WORLD INV. & TRADE 44, 54-55 (2013).

Article 18 section 28 of the CPTPP agreement IP and related rights chapter concurred in the TPP settings to a regularizing, developmental provision on domain names, which reads as follows:

“1. In connection with each Party’s system for the management of its country-code top-level domain (ccTLD) domain names, the following shall be available: (a) an appropriate procedure for the settlement of disputes, based on, or modelled along the same lines as, the principles established in the Uniform Domain-Name Dispute-Resolution Policy, as approved by the Internet Corporation for Assigned Names and Numbers (ICANN) or that: (i) is designed to resolve disputes expeditiously and at low cost; (ii) is fair and equitable; (iii) is not overly burdensome, and (iv) does not preclude resort to judicial proceedings; and (b) online public access to a reliable and accurate database of contact information concerning domain name registrants, in accordance with each Party’s law and, if applicable, relevant administrator policies regarding protection of privacy and personal data.

2. In connection with each Party’s system for the management of ccTLD domain names, appropriate remedies shall be available at least in cases in which a person registers or holds, with a bad faith intent to profit, a domain name that is identical or confusingly similar to a trademark.”⁸

Without a doubt, in the course of the most recent 15 years, the Internet has developed to become a major piece of our society.⁹ In today’s world, the Internet has become a haven where people from all walks of life seek information. The advances in today’s economy incorporate Internet domain names as a vital part of modern businesses that wish to establish a global presence; therefore, it is of paramount importance that such businesses should have a domain name related to their business.¹⁰ Domain names are important economic assets that raise legal issues; the CPTPP is the first among the bilateral, regional, or multilateral FTAs to contain provisions that deliberate on Internet governance in relation to trade regulations.¹¹

Particularly, the CPTPP’s first commitment is to make accessible a method

⁸ Comprehensive and Progressive Agreement for Trans-Pacific Partnership, art. 18.28, Mar. 8, 2018, GOVERNMENT OF CANADA [<https://perma.cc/S8VK-LT4F>] (last visited Oct. 21, 2018) [hereinafter CPTPP].

⁹ See generally Vint Cerf et al., *Internet Governance Is Our Shared Responsibility*, 10 ISJLP 1 (2014).

¹⁰ Ioana Vasii & Lucian Vasii, *Rezolvarea Disputelor Privind Numele De Demoniul Internet [Settlement of Internet Domain Name-Related Disputes]*, ROM. J. INTELL. PROP. L. 15, 17 (2007).

¹¹ See Diane A. Desierto, *ASEAN Investment Treaties, RCEP, and CPTPP: Regional Strategies, Norms, Institutions, and Politics*, WASH. INT’L L.J. 349, 366 (2017).

for the settlement of domain name disputes, on the basis of established principles regarding the Uniform Domain-Name Dispute-Resolution Policy (UDRP), which the CPTPP recognizes as “intended to settle disputes speedily and requiring little to no effort; is reasonable and even-handed; isn’t excessively troublesome; and does not obstruct the resolution to seek legal interventions.”¹² However, the CPTPP clarifies that the provisions for a domain names resolution system stands in the background of well-established, and consolidated foundation for “appropriate remedies [. . .], especially in cases in which an individual treacherously registers or holds a domain name that is identical or confusingly similar to an existing trademark.”¹³

A critical examination of the legal structure designed by the CPTPP with regard to Internet domain names is covered in various sections of this Article. Section 1 deals with the aftermath of the linkage between the structure of the Internet domain name system and the regulatory mechanisms created by the CPTPP. Section 1 also covers the structural specification of the various dispute resolution mechanisms of each CPTPP member country, using the UDRP as a benchmark (Section 2). Section 3 covers the Asian specific domain names dispute resolution methods. This Article concludes by discussing the normative and policy ramifications of the changes brought by the CPTPP to the future generation of free trade agreements.

II. THE STRUCTURE AND REGULATION OF INTERNET DOMAIN NAMES

The fact that domain dispute resolution was only attainable via legal proceedings through the court system during the pre-1999 era was one of the reasons ICANN adopted the UDRP as an out-of-court approach to better resolve rapidly increasing domain-name disputes.¹⁴ China is an example of this phenomena. With the increase in the country’s Internet access and awareness, the disputes over the .cn domain names are increasing.¹⁵ It is important to note that domain name allocation is on a first-come-first-serve basis, giving room for more disputes between domain name registrars and trademark holders.¹⁶ In view of this, it is important to understand the procedural differences in methods of handling domain name disputes, especially for brand owners.

¹² CPTPP, *supra* note 8.

¹³ CPTPP, *supra* note 8, at article 18.1(2).

¹⁴ 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, 182 (2001); Navin Katyal, *The Domain Name Registration .BIZness: Are We Being “Pulled Over” on the Information Super Highway*, 24 HASTINGS COMM. & ENT. L.J. 241, 253-54 (2002).

¹⁵ Xue Hong, *Domain Name Dispute Resolution in China: A Comprehensive Review*, 18 TEMP. INT’L & COMP. L.J. 1, 1, 18 (2004).

¹⁶ Todd W. Krieger, *Internet Domain Names and Trademarks: Strategies for Protecting Brand Names In Cyberspace*, 32 SUFFOLK U. L. REV. 47, 49 (1998).

For instance, the two-year time limit for making domain name related complaints could influence the accomplishment of brand owners' protests.¹⁷

Domain names are much like street addresses that identify a particular house or business.¹⁸ The White House street address, for instance - 1600 Pennsylvania Avenue - is an exact location, like an Internet Protocol (IP) address. You might not know the correct address for the White House, but on getting to Washington, D.C. you can still arrive by advising your cab driver that you need to visit the White House. All devices on the Internet are identified by four sets of numbers separated by periods (.) - xxx.xxx.xxx.xxx.¹⁹ A domain name is an easier address to understand and memorize than the IP address.²⁰ Hence, it's a simple method to reach the correct location of a website without remembering its numeric IP address.

A. *Technical Aspects of the Cyber-World*

In learning about uniform resource locators (URLs) and IP addresses, new users are often confused by the distinction between the two. It is, however, worth the effort to understand the disparities between them due to their ambiguous nature. To explain, the domain name-IP address relationship is similar to a physical address framework, which is why it is necessary for users to utilize terms accurately when conveying to experts or other individuals inside a professional organization.²¹ If one were to view the Internet as a telephone directory, the webpage is like a physical building, and the URL is the exact road address of that building. The IP address would resemble the automobile that moves to its goal. There are likewise other helpful analogies for understanding this relationship. As a result, individuals discover website pages in a similar way to how they utilize maps to discover physical areas.²²

At the point when PC clients type in a web address, specifically into the field at the highest point of their browser window, it starts a procedure of

¹⁷ See generally Anticybersquatting Consumer Protection Act, PUB. L. NO. 106-113 Appendix I, 113 Stat. 1501A-545 (1999).

¹⁸ J. Thomas McCarthy, *Trademarks, Cybersquatters and Domain Names*, 10 DePaul-LCA J. Art & Ent. L. 231 (2000). See also Julien Chaisse, *Cybersecurity and the Protection of Digital Assets Assessing the Role of International Investment Law and Arbitration*, 21 Vand. J. Ent. & Tech. L. 549, 558-560 (2019).

¹⁹ George S. Takach, *Internet Law: Dynamics, Themes and Skill Sets*, 32 CAN. BUS. L.J. 1, 6 (1999).

²⁰ Karl M. Manheim & Lawrence B. Solum, *An Economic Analysis of Domain Name Policy*, 25 HASTINGS COMM. & ENT. L.J. 359, 365 (2003).

²¹ *Id.*

²² See Carl W. Chamberlin, *To the Millennium: Emerging Issues for the Year 2000 and Cyberspace*, 13 NOTRE DAME J.L. ETHICS & PUB. POL'Y 131, 146-47 (1999).

finding the requested page.²³ To do so, the directions contained inside the URL, including the domain name, should accurately point to the location identified by the IP address.²⁴ Between the domain name and the IP address is the Domain Naming System (DNS), the process or program that maps/resolves the domain name to the IP address.²⁵ To locate a device on the Internet, the web browser utilizes the URL, which contains a whole set of detailed information, of which the domain name is just one part and also the most easily recognized part.²⁶

An IP address is characterized by four set of octet numerals, which is different from a domain name in that it is an actual set of instructions that communicate the correct information about the location and the state of the device it represents in a manner that is comprehensible to the computer, if not to humans.²⁷ While the domain name functions as a link to the IP address, it does not contain the actual data, but points to where the IP address data is located.²⁸ In summary, the domain name is a part of the URL that points to the IP address. Therefore, it is useful to think of the IP address, e.g. 232.17.43.22, as the actual name and the domain name as an alias to the IP address.²⁹

The specific nature of the naming system pertaining to the acquisition of domain names requires close regulation in order to prevent confusion or duplicate addresses.³⁰ In recent times the world has seen a drastic shortage in IP address version 4 (IPv4) due to increasing demand.³¹ A new Internet Protocol version IPv6 was therefore created to extend the measure of accessible domain names.

The functionality of a domain name is expressed in its purpose, which is to provide users with a short name that is easy to remember. A user enters a web address into the address field in his browser window from 'left to right', whereas the browser actually reads the domain name or the entire URL from

²³ Derek E. Bambauer, *Solving the Inbox Paradox: An Information-Based Policy Approach to Unsolicited E-mail Advertising*, 10 VA. J.L. & TECH. 1, 5 (2005).

²⁴ Chamberlin, *supra* note 22.

²⁵ Brian W. Borchert, *Imminent Domain Name: The Technological Land-Grab and ICANN's Lifting of Domain Name Restrictions*, 45 VAL. U. L. REV. 505, 509 (2011).

²⁶ Melinda M. Kline, *Missing the Mark: The Trademark Battle over Software-Based Contextually Targeted Advertising on the Internet*, 54 CASE W. RES. L. REV. 917, 918 (2004).

²⁷ Minqin Wang, *Regulating the Domain Name System: Is the .Biz Domain Name Distribution Scheme an Illegal Lottery?*, U. Ill. L. Rev. 245, 247 (2003).

²⁸ *Id.*

²⁹ *Id.*

³⁰ See Ann Bartow, *Trademarks of Privilege: Naming Rights and the Physical Public Domain*, 40 U.C. DAVIS L. REV. 919 (2007).

³¹ Brent Rowe & Michael Gallaher, *Could IPv6 Improve Network Security? And, If So, at What Cost?*, 2 I/S: A J. OF L. & POL'Y 231, 231-32 (2005).

'right to left' as explained below in the naming hierarchy.³² This connection gives bearings to the device/website location, which eventually brings about a successful page load at the user end of the transaction.

The often-used exemplary domain name, *www.example.com*, is comprised of three essential parts:

- *.com* — This is the top-level domain.
- *.example.* — This is a sub-domain.
- *www.* — This is a sub-domain prefix for the World Wide Web.³³

A complete domain name consists of three parts (as illustrated above): the top-level domain, the subdomain and the domain prefix (*www*).³⁴ The original naming system was created with top-level domains to represent countries and organizations, as well as categories, eg. *com*, *org*, *net*, *edu* and *eu*.³⁵ However, most top-level domains use a three-letter naming convention, which is separated from the sub-domain by a dot.

According to the convention explained above, there are top-level domain names that represent countries, which are easily recognizable to new users because the abbreviations are the same as the ones used for other purposes. The name hierarchy for only one purpose has been severally discussed, debated and modified in terms of organization, reservation, availability and affordability; and it is expected to continue.

It is noteworthy that domain name, being the most easily understood, memorized and human-readable part of a URL is organized to the left of the TLD.³⁶ Some countries, however, have developed specific patterns of organization to communicate information within their internal naming systems.³⁷

B. The Role of the ICANN

The ICANN is in charge of organizing the DNS Internet number assets, including IP addresses and Autonomous System Numbers ("ASNs"), space allocation, protocol identifier assignment, generic TLD ("gTLD") and country code TLD ("ccTLD"), top-level DNS administration, and root server system administration functions. ICANN depends on a bottom-up, agreement-

³² John H. Oram, *Will the Real Candidate Please Stand Up?: Political Parody on the Internet*, 5 J. INTELL. PROP. L. 467, 470 n.6 (1997).

³³ The original use of this prefix was partly accidental, and pronunciation difficulties raised interest in creating viable alternatives. Amer Raja, *ICANN's New Generic Top-Level Domain Program and Application Results*, 4 AM. U. INTELL. PROP. BRIEF 22, 24 (2012).

³⁴ Manheim & Solum, *supra* note 20, at 365.

³⁵ Marketa Trimble, *Territorialization of the Internet Domain System*, 45 PEPP. L. REV. 623, 635 (2018).

³⁶ Benjamin D. Silbert, *Trademark Law, ICANN, and Domain Name Expiration*, 36 AIPLA Q. J. 311, 316 (2008).

³⁷ Tamar Frankel, *Governing by Negotiation: The Internet Naming System*, 12 CARDOZO J. INT'L & COMP. L. 449, 487 (2004).

driven, multi-partner model to achieve its goal.³⁸

ICANN, as a non-government and non-profit corporation, has functionally taken-over the service previously handled by the Internet Assigned Numbers Authority (“IANA”).³⁹ The IANA derived its power under a contract from the U.S. government-funded research network, the Advanced Research Projects Agency Network, from which the Internet developed.⁴⁰

As a result of the tremendous growth of the Internet and its resources, the need arose to centralize the governance of the Internet, leading the U.S. government to delegate these duties to the ICANN as a worldwide, autonomous body to deal with the systems and protocols of the Internet.⁴¹

The ICANN Board of Directors consists of twenty members who serve a one-year term and are succeeded by electorates of ICANN’s original member organizations, nine nominees, presented by supporting member organizations and the President/CEO (ex officio).⁴²

As depicted in diagram 1 below, ICANN adopts a multi-stakeholder approach in discharging its duties and responsibilities.⁴³ This approach is led by a Board of Directors chosen or designated from various supporting associations, technical and advisory committees and in general via a nominating committee.⁴⁴

³⁸ Borchert, *supra* note 25, at 513 n.50.

³⁹ Jonathan Weinberg, *ICANN and the Problem of Legitimacy*, 50 DUKE L.J. 187, 209-11 (2000).

⁴⁰ Kevin McGillivray, *Give It Away Now: Renewal of the IANA Functions Contract and Its Role in Internet Governance*, 22 INT’L J.L. & INFO. TECH. 3, 7 (2014).

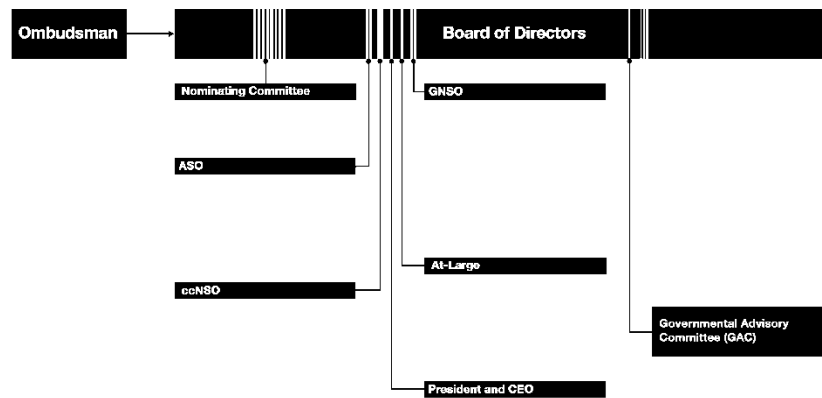
⁴¹ A. Michael Froomkin, *Almost Free: An Analysis of ICANN’s Affirmation of Commitments*, 9 J. ON TELECOMM. & HIGH TECH. L. 187, 188 (2011).

⁴² A. Michael Froomkin & Mark A. Lemley, *ICANN and Antitrust*, U. ILL. L. REV. 1, 10 (2003).

⁴³ See Annemarie Bridy, *Notice and Takedown in the Domain Name System: ICANN’s Ambivalent Drift into Online Content Regulation*, 74 WASH. & LEE L. REV. 1345, 1349-50 (2017).

⁴⁴ See *id.*

Diagram 1: ICANN's multi-stakeholder model



Source: ICANN Website (accessed on Jun 30, 2018)

Since its inception, ICANN has managed a lot of questionable issues in relation to domain name registration in order to avoid disputes; for example, what new top-level domain names ought to be allowed and whether alternative root systems ought to be permitted.⁴⁵

C. Comparison of Trademark Law to the UDRP

The UDRP is a relatively new approach in domain name dispute resolution, with improperly defined terms and its interpretations do not always cite to *stare decisis*. On the other hand, trademarks and name rights enjoy a long history of legal elucidation and are well-established.⁴⁶

Trademark laws put certain conditions such as consumers' choice and perception into consideration, such that trademark enables dealers to utilize an indistinguishable word on their merchandise or services as long as the buyer is not likely to be confused with regard to the source or origin of these goods

⁴⁵ Jacqueline D. Lipton, *Celebrity in Cyberspace: A Personality Rights Paradigm for Personal Domain Name Disputes*, 65 WASH. & LEE L. REV. 1445, 1448 n.7 (2008).

⁴⁶ Thomas H. Webster, *Domain Name Proceedings and International Dispute Resolution*, BUS. L. INT'L 215, 215 (2001).

or services.⁴⁷ In the event that logo appearance, product types and showcasing domains are distinct, such confusion may not arise.⁴⁸ In contrast, a domain name is text-based and has no distinctive attributes such as a logo design, holds no geographic limit, paying little respect to the domain name holder's plan to confine sales to a local area.⁴⁹

The UDRP is not specific to any locality or application of any territorial law; hence, it is designed to be global in its application.⁵⁰ Unlike the UDRP, trademark law is regional/territorial and differs from one legal system to another.⁵¹

Trademark law applies to business enterprise, while the majority of Internet use is non-profit. Trademark rights are implemented by the government; the UDRP is upheld by contractual agreement.⁵² In contrast with the slow, costly, deliberative process of trademark cases, requiring thorough benchmarks of verification with application restricted to the local legal system, the UDRP was intended to give a snappy and moderately economical procedure that could be utilized by trademark owners around the globe against the individuals who enlist domain names in dishonesty, without rights and with bad intentions.⁵³

There is a last legal issue - the burdens of proof - which is approached in a very unique manner in the context of the UDRP.⁵⁴ In this respect, the UDRP requires that no less than five elements be established:⁵⁵

- First, the Complainant must demonstrate it has a trademark or service mark rights in the dispute domain name;
- Second, the Internet domain name must be identical or confusingly similar to the mark;
- Third, there must be both a registration and use of the disputed

⁴⁷ Michael Grynberg, *Trademark Litigation as Consumer Conflict*, 83 N.Y.U. L. REV. 60, 66 (2008).

⁴⁸ *See id.* at 75 n.64.

⁴⁹ *See, e.g.,* Matthew Edward Searing, *What's in a Domain Name – A Critical Analysis of the National and International Impact on Domain Name Cybersquatting*, 40 WASHBURN L.J. 110, 113 (2000).

⁵⁰ Elizabeth C. Woodard, *The UDRP, ADR, and Arbitration: Using Proven Solutions to Address Perceived Problems with the UDRP*, 19 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 1169, 1174-75 (2009).

⁵¹ Brendan J. Witherell, *Trademark Law*, 29 W. NEW ENG. L. REV. 193, 197 (2006).

⁵² Lisa M. Sharrock, *The Future of Domain Name Dispute Resolution: Crafting Practical International Legal Solutions from within the UDRP Framework*, 51 DUKE L.J. 817, 824, 829 (2001).

⁵³ *Id.* at 828.

⁵⁴ Jessica Sganga, *Trademark Owner's Strategy: Litigation versus the UDRP*, 13 PEPP. DISP. RESOL. L.J. 301 (2013).

⁵⁵ *See* Woodard, *supra* note 50, at 1181.

domain name;

- Fourth, the registration and use must have been in bad faith; and
- Fifth, the registration and use must have been without rights or legitimate interest.

The UDRP stands in sharp contrast with trademark law, as the most common elements are only three as follows:⁵⁶

- First, trademark law requires the existence of senior trademark or service mark rights;
- Second, trademark law requires the commercial use of the name; and
- Third, trademark law requires the use to be likely to confuse consumers as to the source or origin of the goods or services being offered by the infringer.

Since the domain name system is relatively new, more interaction with the system creates a better experience, which uncovers its weaknesses. In fact, the community of internet users should resort to self-resolution as most of these domain related disputes arise. ICANN, as the major UDRP administrator, has the ability to hold open forums where such issues can be voiced, and where active forums can be formed to prompt on improvements.⁵⁷

III. THE UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY

Most companies now understand that having a domain name similar to or exactly the same as their company or product name is of extreme importance because of the rapid growth of the internet. Therefore, in order to establish a global presence, a company must first file an application with the respective agency in charge for domain name registration, which will require a pre-registration search to ascertain the availability of the desired name.⁵⁸ In the event that the desired domain name corresponding to the company or product name or trademark is already claimed by another person, the organization can either pick an alternate name or start a battle to recover the domain name from its present proprietors.⁵⁹

If the above scenario results in a dispute, both parties may seek legal redress, since the courts reserve the authority to preside over domain name ownership and control.⁶⁰ However, court procedures are considerably slow.

⁵⁶ Sganga, *supra* note 54, at 302-03.

⁵⁷ Chad D. Emerson, *Wasting Time in Cyberspace: The UDRP's Inefficient Approach Toward Arbitrating Internet Domain Name Disputes*, 34 U. BALT. L. REV. 161, 171 (2004).

⁵⁸ Borchert, *supra* note 25, at 511 n.42.

⁵⁹ *Id.*

⁶⁰ Marc Lorelli, *How Trademark Litigation Over Internet Domain Names Will Change After Section 43(d) of the Lanham Act*, 78 U. DET. MERCY L. REV. 97, 117-18 (2000) (stating that court procedures are considerably slow and “[t]his dispute resolution policy is faster and

Alternatively, it is best to use the domain name dispute policies that have been set up by the domain names registrar, which is a route that many disputing parties have turned to.

A. *Fraudulent Practices*

In terms of registration of all gTLDs (.air, .asia, .business, .feline, .com, .coop, .information, .occupations, .mobi, .gallery, .name, .net, .organization, .genius, .tel and .travel), the UDRP has become an acceptable approach to dispute resolution by ICANN-licensed registrars.⁶¹ The UDRP is, therefore, a policy between a registrar and its client and is incorporated into registration agreements for all ICANN-licensed registrars, which makes it possible for a trademark right holder to initiate dispute proceedings arising from asserted abusive registrations of domain names (for example, cybersquatting).⁶²

Cybersquatting (also known as domain squatting), according to the United States' Anti-cybersquatting Consumer Protection Act, is registering, trafficking in, or using an Internet domain name with bad faith intent to profit from the goodwill of a trademark belonging to someone else.⁶³ The cyber-squatter then offers to sell the domain name to the person or company who owns a trademark contained within the name at an inflated price.⁶⁴ Cybersquatting is an old practice that arose at a time when the Internet's commercial value was unknown to most entrepreneurs, affording some individuals the opportunity to register the names of high-profile organisations with the sole purpose of offering the names back to the organizations when they realized their value.⁶⁵ Panasonic, Fry's Electronics, Hertz and Avon were some of the prominent "victims" of cybersquatting.⁶⁶ Such opportunities are now diminishing, as most organizations currently realize the importance of acquiring and registering domain names.

Another possible point of dispute, which is also a security issue, is domain hijacking or domain theft. Domain hijacking or domain theft refers to the act of changing the access and registration of a domain name without the authorization of its original registrant.⁶⁷ Most hijackers utilize the domain name to

less expensive than court proceedings.").

⁶¹ Dominik S. Fuchs, *Alternative Dispute Resolution According to the WIPO Uniform Domain Name Dispute Resolution Policy (UDRP)*, 1 Y.B. ON INT'L ARB. 305, 307-08 (2010).

⁶² *Id.* at 307, 310.

⁶³ Anahid Chalikian, *Cybersquatting*, 3 J. LEGAL ADVOC. & PRAC. 106, 110 (2001).

⁶⁴ Christopher G. Clark, *The Truth in Domain Names Act of 2003 and a Preventative Measure to Combat Typosquatting*, 89 CORNELL L. REV. 1476, 1479 (2004).

⁶⁵ Searing, *supra* note 49, at 117.

⁶⁶ Vaibhav Priyadarshi & Sujesh Somanathan, *Global Analysis of Laws Related to Cyber Squatting – Opening a New Front in War Against Infringement Done on Internet*, 22 SRI LANKA J. INT'L L. 107, 110 (2010).

⁶⁷ See Borchert, *supra* note 25, at 522 n. 96.

encourage unlawful activities, such as phishing, where a website is supplanted by an indistinguishable website that records private data, for example, sign-in passwords.⁶⁸ Such issues can be monetarily overwhelming to the original domain name holder, who may have established income from a website hosted under such domain or conducted business through that domain's email accounts.

Another way in which trademark owners forcefully or illegally gain domain ownership is through "reverse domain hijacking", where a trademark owner endeavours to anchor a domain name by making false cybersquatting claims against its legitimate owner, who is typically a small organisation or an individual.⁶⁹ This action is synonymous with cybersquatting, however, in a reverse order.⁷⁰

Originally, cybersquatting claims started as a defensive method for trademark owners to battle cybersquatting. However, as time went on trademark owners saw that registrants (i.e., the 'apparent' cyber-squatter) would rather settle their cases as opposed to subjecting itself to a dispute.⁷¹ Such claims were additionally utilized as a method for strongarming powerless domain name registrants into surrendering domain names that the trademark owner does not rightfully own.⁷² This act is usually perpetrated by large companies and corporations, who achieve such aim by intimidating these powerless but legitimate domain names' owners.

The UDRP in contrast with other arbitration processes publishes its opinions and conclusions on the internet as a means of public disclosure. With this disclosure method, most cases have been concluded by citing back to previous panel decisions, using them as concluding authoritative remarks in the current case. In some other cases, previous panel decisions are merely used as references.

B. UDRP Principles

Network Solutions, Inc. (NSI), during the pre-1999 era dispute resolution method, created a system under which a third-party could challenge the privilege of a domain name owner to use a specific domain name.⁷³ With this

⁶⁸ See generally Wang, *supra* note 27, at 256-57.

⁶⁹ Andrew Murray & Colin Scott, Controlling the New Media: Hybrid Responses to New Forms of Power, 65 MOD. L. REV. 491, 507 (2002).

⁷⁰ See Theodore H. Davis Jr., Trademark Infringement and Unfair Competition in the Courts of General Jurisdiction, 103 TRADEMARK REP. 94, 222 (2013).

⁷¹ Jeffrey M. Gitchel, *Domain Name Dispute Policy Provides Hope to Parties Confronting Cybersquatters*, 82 J. PAT. & TRADEMARK OFF. SOC'Y 611, 611 (2000).

⁷² See generally David J. Cook, *Post-Judgment Remedies in Reaching Patents, Copyrights and Trademarks in the Enforcement of a Money Judgment*, 9 NW. J. TECH. & INTELL. PROP. 128, 159 (2010).

⁷³ Minqin Wang, *supra* note 27, at 255.

method, the trademark owner, who is not the actual domain name registrant, takes legal action against the actual registrant to gain control of the domain⁷⁴ when the following conditions are met: 1) either of both parties should have a nationally registered trademark which is identical to the second level domain name; 2) the registered trademark should be similar or identical to the registered domain name; and 3) in the event the trademark was registered before the domain name registration, the domain name owner needs to supply their own particular trademark registration for the second-level domain name.⁷⁵ If the domain name registrar could not provide such trademark information, NSI would suspend all use of the domain name.⁷⁶ This policy stands regardless of whether the complainant could legitimately demonstrate a claim of trademark infringement.

The current domain name dispute resolution policy created by ICANN is the UDRP, which completely replaces the pre-1999 strategy.⁷⁷ A trademark owner can initiate a reasonable authoritative methodology to challenge the current domain name, at a moderate cost.⁷⁸ The UDRP proceeding has no predefined duration of resolution for any particular case. However, most cases are resolved within 60 days,⁷⁹ although the instituted panel handling a case reserves the discretion to extend the timing when necessary.⁸⁰ Box 1 summarizes the timeline of a typical UDRP proceeding.

Box 1 UDRP proceeding Timeline

Day 0: The complainant files a complaint with the provider of his choice and sends a copy to the respondent (holder of the domain name) at the address shown on the registrar's database. At this point, the provider reviews the complaint for compliance with the UDRP rules and the provider's own supplemental rules. If the complaint is in compliance, the proceeding continues; if the complaint is deficient, the complainant has 5 days to remedy the deficiencies or the complaint will be deemed withdrawn.

⁷⁴ See generally Alice A. Wang, *Diversifying the Domain Name Governance Framework*, 32 BERKELEY TECH. L.J. 137, 146 (2017).

⁷⁵ See Diane Cabell, *Domain Names*, 6 DISP. RESOL. MAG. 12, 13 (2000).

⁷⁶ Silbert, *supra* note 36, at 320.

⁷⁷ *Is ICANN's New Generation of Internet Domain Name Selection Process Thwarting Competition?: Hearing Before the Subcomm. on Telecomm. & the Internet of the Comm. on Energy & Commerce*, 107th Cong. 17 (2001) (statement of Vinton G. Cerg, Chairman of the Board, Internet Corporation for Assigned Names and Numbers).

⁷⁸ *Id.*

⁷⁹ WIPO Guide to the Uniform Domain Name Dispute Resolution Policy (UDRP), WORLD INTELL. PROP. ORG. [<https://perma.cc/J4NC-NYBX>].

⁸⁰ *Id.*

Day 3: By this time the provider must send a copy of the complaint to the registrar of the domain name in question and a copy to the respondent.

Day 23: Within 20 calendar days of the formal commencement of the administrative proceeding, the respondent must respond specifically to the allegations in the complaint and offer any bases for the retention of the domain name. The respondent will be deemed to have defaulted if no response is filed within this 20-day window.

Day 28: After the receipt of the respondent's response to the complaint, the provider has 5 days to appoint a panel.

Day 42: A decision will be rendered within 14 days of the panel's appointment.

Day 45: The panel has 3 days to notify the parties of the decision.

10 business days later: Unless the adversely affected domain name holder has filed suit in a court of mutual jurisdiction by this date, the registrar will implement the decision of the panel, canceling or transferring the domain name according to the remedy sought in the complaint.

Paragraph 15(a) of the Rules for UDRP (the "Rules") instructs the panel to "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."⁸¹ Complainants are required under Paragraph 4(a) of the policy to provide substantial proof under the following three conditions so as to obtain a domain transfer or cancellation order: (1) the domain name and the registered trademark must share confusing similarity or an indistinguishable identity; (2) the domain registrant, or the respondent, does not have any legal standing in respect to ownership of the domain; and (3) the registered domain name is being used illegally.⁸²

Given the specified conditions, above trademark holders typically win exclusively on their rights or legal interests in the name. However, in principle, a domain name registrant can win by nullifying any of the three required conditions, either by demonstrating that the domain name isn't "indistinguishable or confusingly comparative" to the trademark, that the registrant has "rights or authentic interests" in the domain name, or that the space name was not registered and isn't being used illegally or in dishonesty.⁸³

⁸¹ *Rules for Uniform Domain Name Dispute Resolution Policy*, ICANN, [<https://perma.cc/FZH8-9C88>].

⁸² *Id.*

⁸³ Manheim & Solum, *supra* note 20, at 365 n.203.

The provision does allow a trademark holder to raise a suit over a domain name unless there is the least proof of similarity to their mark, regardless of whether it failed to meet the “indistinguishable or confusingly comparable” edge.⁸⁴ On the other hand, the bad faith registration and use condition is often of a non-specific nature in relation to the presence or absence of rights or legal interest in the registered domain name, such that the only defence option available to the respondent is to prove his right to, or legitimate interest in, the domain name in order to override the complainants’ allegations.⁸⁵

According to the WIPO Guide to UDRP, Paragraph 4(b) of the UDRP policy sets out the following examples of circumstances that will be considered by an Administrative Panel to be evidence of the bad faith registration and use of a domain name: (1) by registering the domain name, the registrant is intentionally posing as an affiliate, a source or a subsidiary of the registered trademark in order to attract users for commercial gain; (2) the registrant intends to disrupt or obstruct the business of a competitor; (3) the primary goal of the registrant is to sell the domain name back to the legal right owner at a higher profit, which would be much more than the original documented price of the domain; or (4) the domain name was registered to prevent the legal rights owner from registering and using it when the need arises.⁸⁶

Some of the ways that a domain name owner can prove a legitimate right or interest in a domain name are by showing the following⁸⁷:

- use or preparations to use the domain name in connection with a bona fide offering of goods or services prior to any notice of the dispute;
- that the domain name owner has been commonly known by the second level domain name; or
- that the domain name owner is making legitimate non-commercial or fair use of the domain name, without the intent of (i) commercial gain, (ii) misleadingly diverting consumers, or (iii) tarnishing the trademark at issue.

In terms of domain name disputes, the main legal question is how arbitration work. The key provisions are found in Paragraphs 1 and 4 (Box 2) which can be conceptualized as the ‘transnational regime’ for domain names disputes resolution.

⁸⁴ See generally Jasmine Abdel-Khalik, *Is a Rose by any Other Image Still a Rose - Disconnecting Dilution’s Similarity Test from Traditional Trademark Concepts*, 39 U. TOL. L. REV. 591, 616-17 (2008).

⁸⁵ Vasiu & Vasiu, *supra* note 10, at 18.

⁸⁶ WIPO Guide to the Uniform Domain Name Dispute Resolution Policy, *supra* note 86.

⁸⁷ See Jonathan S. Jennings, *Developing Domain Name Enforcement Options*, 34 FRANCHISE L.J. 521, 524-25, 543 (2015).

Box 2: Uniform Domain Name Dispute Resolution Policy

1. Purpose. This Uniform Domain Name Dispute Resolution Policy (the “Policy”) has been adopted by the Internet Corporation for Assigned Names and Numbers (“ICANN”), is incorporated by reference into your Registration Agreement, and sets forth the terms and conditions in connection with a dispute between you and any party other than us (the registrar) over the registration and use of an Internet domain name registered by you. Proceedings under Paragraph 4 of this Policy will be conducted according to the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules of Procedure”), which are available at (<http://www.icann.org/en/dndr/udrp/uniform-rules.htm>), and the selected administrative-dispute-resolution service provider’s supplemental rules.

[. . .]

4. Mandatory Administrative Proceeding. This Paragraph sets forth the type of disputes for which you are required to submit to a mandatory administrative proceeding. These proceedings will be conducted before one of the administrative-dispute-resolution service providers listed at (www.icann.org/en/dndr/udrp/approved-providers.htm) (each, a “Provider”).

a. Applicable Disputes. You are required to submit to a mandatory administrative proceeding in the event that a third party (a “complainant”) asserts to the applicable Provider, in compliance with the Rules of Procedure, that (i) your domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and (ii) you have no rights or legitimate interests in respect of the domain name; and (iii) your domain name has been registered and is being used in bad faith. In the administrative proceeding, the complainant must prove that each of these three elements are present.

b. Evidence of Registration and Use in Bad Faith. For the purposes of Paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith: (i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or (ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or (iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion

with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.

c. How to Demonstrate Your Rights to and Legitimate Interests in the Domain Name in Responding to a Complaint. When you receive a complaint, you should refer to Paragraph 5 of the Rules of Procedure in determining how your response should be prepared. Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of Paragraph 4(a)(ii): (i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or (ii) you (as an individual, business, or other organisation) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or (iii) you are 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.

d. Selection of Provider. The complainant shall select the Provider from among those approved by ICANN by submitting the complaint to that Provider. The selected Provider will administer the proceeding, except in cases of consolidation as described in Paragraph 4(f). e. Initiation of Proceeding and Process and Appointment of Administrative Panel. The Rules of Procedure state the process for initiating and conducting a proceeding and for appointing the panel that will decide the dispute (the "Administrative Panel").

At the end of a UDRP proceeding over a domain name, the domain name is either transferred to the complainant or the protest is denied and the respondent keeps the domain name.⁸⁸ The administrative panel of such proceeding will terminate or transfer the domain name to the trademark owner, in the event that the trademark proprietor effectively proves each of the three points.⁸⁹ However, the reverse will be the case if he is unable to prove one of the three highlighted points.⁹⁰ It is in any case possible to request an outright cancellation of such domain name.⁹¹ When a UDRP resolution panel decides on a case, it is mandatory for accredited registrars to enforce the panel's decision after a ten day period, unless the decision is appealed in a court within

⁸⁸ Wayne Brooks, *Wrestling over the World Wide Web: ICANN's Uniform Dispute Resolution Policy for Domain Name Disputes*, 22 *HAMLIN J. PUB. L. & POL'Y* 297, 324, 328 (2001).

⁸⁹ Sganga, *supra* note 54, at 309.

⁹⁰ See Brooks, *supra* note 88, at 328.

⁹¹ Shiveh Roxana Reed, *Sensible Agnosticism: An Updated Approach to Domain-Name Trademark Infringement*, 61 *DUKE L.J.* 211, 231 (2011).

the ten days frame.⁹² Although it is rarely embarked upon, the UDRP policy allows both parties the option of taking the dispute to a court of competent authority for an independent judgement.⁹³ The UDRP domain name dispute resolution process does not award any form of court injunction or monetary damage.⁹⁴

IV. LINKING FTAS TO THE DISPUTE RESOLUTION SERVICE PROVIDERS

UDRP providers do have an essential interest to preserve one of the strategies that is most vital to rights protection inside gTLDs: namely, the UDRP. UDRP providers are also responsible for maintaining a public list of panelists.⁹⁵ As of June 2015, ICANN endorsed five UDRP suppliers: the Asian Domain Name Dispute Resolution Center (ADNDRC), the National Arbitration Forum (NAF), the World Intellectual Property Organization (WIPO), the Czech Arbitration Court Arbitration Center for Internet Disputes, and the Arab Center for Domain Name Dispute Resolution (ACDR).⁹⁶

As a mean of enhancing the general UDRP rules, each approved UDRP provider is required to supply its own supplemental rules. Both the complainant and respondent should be aware of these rules.⁹⁷ These supplemental rules are defined as

“the rules adopted by the Provider administering a proceeding to supplement these rules. Supplemental Rules shall not be inconsistent with the Policy or these Rules and shall cover such topics as fees, word and page limits and guidelines, file size and format modalities, the means for communicating with the Provider and the Panel, and the form of cover sheets.”⁹⁸

A. *The WIPO Domain Name Dispute Resolution*

WIPO is a specialized agency of the United Nations which was established by the WIPO Convention, signed in 1967 with reference from its Member States and became fully functional in 1970.⁹⁹ WIPO is committed to building

⁹² Woodard, *supra* note 50, at 1183.

⁹³ A. Michael Froomkin, *Icann's Uniform Dispute Resolution Policy—Causes and (Partial) Cures*, 67 BROOK. L. REV. 605, 671 (2002).

⁹⁴ Sganga, *supra* note 54, at 311.

⁹⁵ Woodard, *supra* note 50, at 1182 n.69.

⁹⁶ Jae-Kyoung Lee, *Suitability of Alternative Dispute Resolution for the Fashion Industry Focused on Arbitration for the Fashion Industry*, 25 J. ARB. STUD. 87, 100 n.48 (2015).

⁹⁷ See Jay P. Kesan & Andres A. Gallo, *The Market for Private Dispute Resolution Services - An Empirical Re-Assessment of ICANN-UDRP Performance*, 11 MICH. TELECOMM. & TECH. L. REV. 285, 302, 314-16 (2005).

⁹⁸ Rules for Uniform Domain Name Dispute Resolution Policy, *supra* note 81.

⁹⁹ See Paul Salmon, *Cooperation between the World Intellectual Property Organization*

a regulated and effective IP framework to encourage inventiveness and advancement so as to help propel the economic, cultural and social improvement of all nations around the globe.¹⁰⁰ WIPO officially became part of the United Nations in 1974 and signed an agreement with the World Trade Organisation in 1996 in order to enlarge its trade capacity.¹⁰¹ The major aim of establishing the WIPO was to improve the protection of intellectual properties across the globe.¹⁰²

WIPO maintains an Arbitration and Mediation Centre that works with the UDRP in creating a balanced IP system across the globe.¹⁰³ As a result of the frequency of cross-border disputes, ICANN urgently faced the need for a solution to the dispute resolution issue.¹⁰⁴ In consideration of available means, a new international treaty negotiation was considered too slow and the provision of new national legal provisions would in all probability be too conflicting.¹⁰⁵ Since the best method of managing such disputes is to create universally uniform and mandatory techniques, WIPO, with the help of its member states conducted an extensive survey with the global internet community. This resulted in a publication containing various recommendations for dealing with domain name related disputes, on the basis of which the ICANN created the UDRP, which came into force on December 1, 1999, affecting all ICANN-accredited Internet domain names registrars.¹⁰⁶

WIPO is the leading ICANN-accredited domain name dispute resolution service provider, having handled about 60 percent of all UDRP cases filed as

(WIPO) and the World Trade Organization (WTO), 17 ST. JOHN'S J. LEGAL COMMENT. 429, 430 (2003); Julien Chaisse & Mitsuo Matsushita, *Maintaining the WTO's Supremacy in the International Trade Order: A Proposal to Refine and Revise the Role of the Trade Policy Review Mechanism*, 16 J. INT'L ECON. L. 9 (2013).

¹⁰⁰ See Hannibal Travis, *WIPO and the American Constitution: Thoughts on a New Treaty Relating to Actors and Musicians*, 16 VAND. J. ENT. & TECH. L. 45, 47 (2013).

¹⁰¹ WORLD INTELL. PROP. ORG., WIPO INTELLECTUAL PROPERTY HANDBOOK: POLICY, LAW, AND USE, 5, 345-46 (2nd ed. 2004).

¹⁰² Christopher Boog & James Menz, *Arbitrating IP Disputes: The 2014 WIPO Arbitration Rules*, 24 J. ARB. STUD. 105, 108 (2014). See also Aman K. Gebru, *International Intellectual Property Law and the Protection of Traditional Knowledge: From Cultural Conservation to Knowledge Codification*, 15 Asper Rev. Int'l Bus. & Trade L. 293 (2015) (explaining the leading role of WIPO in promoting the protection of all intellectual property rights throughout the world).

¹⁰³ See Boog & Menz, *supra* note 102, at 108.

¹⁰⁴ See generally Borchert, *supra* note 25, at 531, 544 (explaining that the decisive reason for the establishment of UDRP by the ICANN was the perceived risk of rapid increase in internet domain disputes).

¹⁰⁵ 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, 146-48 (2001).

¹⁰⁶ See *id.* at 149, 165, 230, 238.

of the end of 2014.¹⁰⁷ Additionally, a developing number of registrars of ccTLDs have assigned WIPO as dispute resolution specialist organization.¹⁰⁸

WIPO utilizes on-line procedures when conducting dispute resolution proceedings, normally taking two months to conclude a domain name case, which is relatively faster than normal court litigations.¹⁰⁹ Charges are likewise much lower than ordinary court cases.¹¹⁰ There are no face to face hearings except in uncommon cases.¹¹¹ Negligible filing necessities likewise help to diminish costs. For the resolution of a case including one to five domain names, with a single panelist, the present cost is US\$ 1,500; for three panelists, the aggregate cost is US\$ 4,000. For six to ten domain names, the present cost is US\$ 2,000 for a case including a single panelist and US\$ 5,000 for a case including three panelist.¹¹²

B. The Asian Domain Name Dispute Resolution Centre

Due to the successful administration of the UDRP over the years, numerous ccTLDs registrars have additionally set up dispute resolution policies for their own domains using the UDRP as a foundation. This was the case of the Hong Kong Domain Name Registration Company Limited (“HKDNR”), which in 2001 set up a UDRP-based policy for resolving .hk domain name disputes.¹¹³

Table 1: HKIAC Domain Name Statistics (2001 - 2017)¹¹⁴

	ADNDRC (Hong Kong Office)			HKIAC			Total
	UDRP	URS	TDRP	CNDRP	HKDRP	IKDRP	
2017	131	1	Nil	75	13	Nil	220
2016	117	2	Nil	52	12	Nil	183
2015	148	11	Nil	59	9	Nil	227

¹⁰⁷ See Ilhyung Lee, *The Fifty-Eight Proceedings: Domain Name Disputes, Korean Parties, and WIPO Three-Member Panels*, 23 U. MIAMI INT'L & COMP. L. REV. 429, 436 n.21, 438 (2016).

¹⁰⁸ See, e.g., Suzanne Van Arsdale, *User Protection in Online Dispute Resolution*, 21 HARV. NEGOT. L. REV. 107 (2015) (explaining that, historically, many registrars of ccTLDs have opted for WIPO as dispute resolution specialist organization).

¹⁰⁹ See Heike Wollgast & Ignacio De Castro, *WIPO Arbitration and Mediation Center: New 2014 WIPO Rules; WIPO FRAND Arbitration*, 32 ASA BULL. 286, 294-95 (2014).

¹¹⁰ *Id.* at 296.

¹¹¹ *Id.* at 290.

¹¹² Schedule of Fees under the UDRP, WORLD INTELL. PROP. ORG. (Dec. 1, 2002), <http://www.wipo.int/amc/en/domains/fees/> (last visited Oct. 23, 2018).

¹¹³ Dennis Cai, *How to Win Back Your Domain in China*, MANAGING INTELL. PROP. 26, 26 (2008).

¹¹⁴ *Domain Name Statistics*, HONG KONG INT. ARB. CTR., <http://www.hkiac.org/en> [<https://perma.cc/X89E-QPT5>] (accessed Sept. 8, 2018).

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2014	121	19	Nil	47	14	Nil	201
2013	94	Nil	Nil	58	17	1	170
2012	56	Nil	Nil	44	15	Nil	115
2011	88	Nil	3	26	8	2	127
2010	50	Nil	Nil	47	10	Nil	107
2009	42	Nil	1	85	12	Nil	140
2008	84	Nil	Nil	128	14	3	229
2007	39	Nil	Nil	76	17	3	135
2006	23	Nil	Nil	67	3	Nil	93
2005	16	Nil	Nil	8	7	Nil	31
2004	20	Nil	Nil	13	8	Nil	41
2003	17	Nil	Nil	10	5	Nil	32
2002	12	Nil	Nil	Nil	3	Nil	15
2001	Nil	Nil	Nil	Nil	2	Nil	2
Total	1058	33	4	795	169	9	2068

Source: HKIAC website (<http://www.hkiac.org/en>) accessed on September 8, 2018

Against the backdrop of the Hong Kong domain name dispute resolution history, June 1, 2001, marked the appointment of the Hong Kong International Arbitration Centre (“HKIAC”) as the sole dispute resolution service provider for .hk domain names by the HKDNR.¹¹⁵ The HKIAC was established in 1985 as an independent, non-profit dispute resolution organisation, meant to solve domain name disputes by means of arbitration or alternative dispute resolution methods.¹¹⁶ One of its principal targets is to help turn Hong Kong into a major Asian international dispute resolution center.¹¹⁷ It has a co-task agreement with 18 arbitral and ADR bodies across the globe, including, but not limited to, the International Court of Arbitration, the American Arbitration Association and the International Chamber of Commerce.¹¹⁸

Shortly after the stated agreement, HKIAC became a key player in providing domain name-related dispute resolution. Later it joined forces with the China International Economic and Trade Arbitration Commission (“CIETAC”) to establish the ADNDRC, which is as yet the sole dispute resolution services provider in Asia approved by ICANN to deal with gTLD

¹¹⁵ See Cai, *supra* note 113, at 26.

¹¹⁶ See David Howell, *An Overview of Arbitration in Asia*, 4 ASIAN DISP. REV. 131, 131 (2002).

¹¹⁷ Phillip Yang, *A Brief History of Hong Kong International Arbitration Centre*, 8 ASIAN DISP. REV. 47, 47 (2006).

¹¹⁸ ICANN Announces New Dispute Resolution Provider in the Asia Pacific Region, ICANN (Dec. 3, 2001), <https://www.icann.org/news/announcement-2001-12-03-en> [<https://perma.cc/W2GN-KUL8>].

disputes.¹¹⁹

V. CONCLUSION

Various theories have been posited as to the demise of the TPP trade agreement when the United States withdrew from the agreement in 2017. In response, the remaining 11 countries (New Zealand, Australia, Brunei Darussalam, Canada, Chile, Japan, Malaysia, Mexico, Peru, Singapore and Vietnam), with a resolve to conquer and attain a conclusive deal even without the United States jointly created a revised agreement in March 2018, the CPTPP.¹²⁰ The present status of the CPTPP is that the agreement has been signed by the member countries, but has not yet been confirmed by the individual members nor brought into domestic law.¹²¹ From an IP viewpoint, the CPTPP is a vigorously less-effective rendition of the TPP in connection to proprietors' rights and government implementation obligations.

Cybersquatting has recently seen a tremendous increase with the ascent of new extensions (new gTLDs). Every week numerous organizations are casualties of their image being registered in domain names on "first come, first served" basis, without profiting any control from registries on names registration.¹²²

The CPTPP is considered one of the major FTAs to reinforce one of the rules created by ICANN, in that the CPTPP article 18:28 mandated eleven nations to set up techniques and remedial procedures that will better secure trademarks owners and organizations operating on the digital market.¹²³

Before the adoption of the UDRP, disputes were resolved with court litigation as the only available means, which is very costly.¹²⁴ The UDRP was adopted as a faster and less costly alternative to court litigation to deal exclusively with issues that surround the determination of a trademark rights violation with regards to a contested domain name, while eliminating irrelevant requests for remuneration in favor of prevailing complainants.¹²⁵ In spite of

¹¹⁹ *Id.*

¹²⁰ *Comprehensive and Progressive Agreement for Trans-Pacific Partnership (CPTPP)*, <https://www.international.gc.ca/trade-commerce/trade-agreements-accords-commerciaux/agr-acc/cptpp-ptpgp/index.aspx?lang=eng> [https://perma.cc/9G29-AA5G].

¹²¹ *From TPP to CPTPP*, CTR. FOR STRATEGIC AND INT'L STUD. (Mar. 8, 2018), <https://www.csis.org/analysis/tpp-cptpp> [https://perma.cc/4YCA-TV6V].

¹²² Elisa Cooper, *New gTLDs - Understanding and Mitigating the Risks of the Super Six*, 243 MANAGING INTELL. PROP. 19, 20 (2014).

¹²³ *Comprehensive and Progressive Agreement for Trans-Pacific Partnership (CPTPP): National Interest Analysis*, N.Z. FOREIGN AFF. & TRADE 162-63 (2018).

¹²⁴ See generally Edward C. Anderson & Timothy S. Cole, *The UDRP - A Model for Dispute Resolution in E-Commerce*, 6 J. SMALL & EMERGING BUS. L. 235, 236-37, 249, 253 (2002).

¹²⁵ Gerard L. Chan, *Getting to Yes/False Online: A Look at the History, Concepts, Issues*

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the narrow window available to discharge its duties, the UDPR has successfully decided over 50,000 cases in the presence of hundreds of panelists in about 180 countries.¹²⁶ This has made a broad arrangement of generally acknowledged standards (however, not acceptable “points of reference”) which are currently being used by the CPTPP. These will probably result in more cases, therefore increasing the case-law controlled by the Panels created in the eleven CPTPP nations and by doing as such the CPTPP sets a milestone for all future Asian FTAs.¹²⁷

and Prospects of Online Dispute Resolution Systems (ODRS), 83 PHIL. L.J. 528, 545-46 (2009).

¹²⁶ T. Lee et al., *Cohesion and Coherence in the UDRP*, J. OF XINGTAI POLYTECHNIC C. 1, 2 (2008).

¹²⁷ See Diane A. Desierto, *ASEAN Investment Treaties, RCEP, and CPTPP: Regional Strategies, Norms, Institutions, and Politics*, 27 WASH. INT’L L.J. 349, 372, 405 (2017).