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International Dispute Settlement at the Trademark-Domain Name Interface

Laurence R. Helfer*

I. INTRODUCTION

The rapid development of digital technologies is having a profound effect on shaping international law in general, and international dispute settlement in particular.

A defining characteristic of digital technologies is their ability to transcend territorial boundaries. Legal disputes implicating these technologies thus challenge the unfettered jurisdictional competence of any single nation state, and complicate the application and enforcement of existing legal rules. Whenever national laws are not entirely harmonized, or conflicts of law principles do not invariably lead to the choice of a single jurisdiction's law, national governments and private parties come under pressure to develop new international mechanisms to cut through the complex, cross-border legal disputes that digital technologies engender.

Nowhere have these dispute settlement pressures created more controversy than in intellectual property law. Intellectual property rights are at the heart of cyberspace. They protect the computer code that forms the architecture of cyberspace—the text, images, and sounds that comprise the bulk of content online, and the symbols that guide consumers through the maze of e-businesses.¹ But the very same technologies that make intellectual property rights an increasingly pervasive part of a digitally networked world

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1. *See generally* WORKING GROUP ON INTELLECTUAL PROPERTY RIGHTS, U.S. DEP'T OF COMMERCE, REPORT: INTELLECTUAL PROPERTY AND THE NATIONAL INFORMATION INFRASTRUCTURE (1995); American Bar Association Global Cyberspace Jurisdiction Project, Achieving Legal and Business Order in Cyberspace: A Report on Global Jurisdiction Issues Created by the Internet 120-31 (July 11, 2000) (copy on file with author); LAWRENCE LESSIG, CODE AND OTHER LAWS OF CYBERSPACE (1999).

also enable infringements of those rights on a massive scale, generating new tensions between intellectual property owners and users over the allocation of legal entitlements and the proper definition of legitimate, non-infringing on-line activities.²

At the center of this growing controversy is the Uniform Domain Name Dispute Resolution Policy (“UDRP”),³ a new non-national⁴ procedure governing a narrow class of conflicts between the owners of internet domain names⁵ and the owners of trademarks.⁶ The UDRP was established by a private, non-profit corporation, the Internet Corporation for Assigned Names and Numbers (“ICANN”) in late 1999. It creates a fast and inexpensive online dispute settlement system that allows trademark owners to recapture domain names held by persons who, in bad faith, register and use domain names that are confusingly similar to their marks.⁷

2. See generally Graeme B. Dinwoodie, *(National) Trademark Laws And The (Non-National) Domain Name System*, 21 U. PA. J. INT’L ECON. L. 495 (2000) (discussing the expanding series of conflicts between national trademark system and non-national domain name system); Neil W. Netanel, *The Next Round: The Impact of the WIPO Copyright Treaty on TRIPS Dispute Settlement*, 37 VA. J. INT’L L. 441 (1997) (discussing the impact of international treaties on scope of copyright protection required to be adopted by national governments); Shira Perlmutter, *Future Directions in International Copyright Law*, 16 CARDOZO ARTS & ENT. L.J. 369 (1998) (discussing the flexibility national legislators enjoy in creating exceptions to exclusive rights enjoyed by copyright owners).

3. See Uniform Domain Name Dispute Resolution Policy (August 26, 1999), at <http://www.icann.org/udrp/udrp-policy-24oct99.htm> (last visited Dec. 7, 2001) [hereinafter Policy].

4. This essay uses the term “non-national” to refer to lawmaking and dispute settlement structures that arise outside the sphere in which the nation state operates (both internally and in its relations with other states). Such non-national structures can have several institutional components, including hybridized rules drawn from different legal systems and the use of privatized technological controls to enforce rules. For a more detailed discussion, see Laurence R. Helfer & Graeme B. Dinwoodie, *Designing Non-National Systems: The Case of the Uniform Domain Name Dispute Resolution Policy*, 43 Wm. & Mary L. Rev. 141 (2001).

5. The UDRP applies principally to domain names registered in three generic top level domain names (“gTLDs”), “.com,” “.net,” and “.org.” See Uniform Domain Name Dispute Resolution Policy, General Information, at <http://www.icann.org/udrp/udrp.htm> (last visited Jan. 11, 2001). In addition, registrars for a few country code top level domains (“ccTLDs”) have agreed to apply the UDRP to trademark-domain name disputes. See <http://arbiter.wipo.int/domains/ccld/index.html> (last visited Sept. 30, 2001) (listing 22 ccTLDs applying UDRP).

6. The UDRP was deliberately designed to address only a limited set of controversies between trademark owners and domain name registrants, notably “deliberate, bad faith, abusive, domain name registrations or ‘cybersquatting,’” and to exclude “disputes between parties with competing rights acting in good faith.” World Intellectual Property Organization, Final Report of the WIPO Internet Domain Name Process ¶ 135 (Apr. 30, 1999), at <http://wipo2.wipo.int/process1/report/index.html> (last visited Dec. 7, 2001) [hereinafter WIPO Final Report]; see also Second Staff Report on Implementation Documents for the Uniform Dispute Resolution Policy, 8 (Oct. 24, 1999), at <http://www.icann.org/udrp/udrp-second-staff-report-24oct99.htm> (last visited Dec. 7, 2001) (stressing that UDRP was limited to “‘abusive registrations’ made with bad-faith intent to profit commercially from others’ trademarks (e.g., cybersquatting and cyberpiracy)”; J. THOMAS MCCARTHY, TRADEMARKS AND UNFAIR COMPETITION §§ 25.69.1, 25.77 (1999) (defining cybersquatting as “the conduct of one who reserves with a network information center a domain name consisting of the mark or name of a company for the purpose of relinquishing the right to that domain name back to the legitimate owner for a price.”).

7. In brief, the UDRP requires a domain name registrant to submit to an on-line dispute

There are at least two important reasons why this new dispute settlement mechanism is worthy of serious study. First and foremost, the process by which the UDRP was created, and the way in which it is structured, departs significantly from preexisting approaches to international dispute settlement, not only for intellectual property rights but also for international law generally. These differences in creation and structure raise questions about the UDRP's legitimacy and, as a result, the legitimacy of the case law it produces.⁸

However, these differences also raise a second and larger concern. The UDRP has been operating for a short time, but national and international lawmakers are already heralding it as a model for resolving a much broader set of transnational legal problems.⁹ Although certain aspects of the UDRP are worthy of emulation, in this essay I sound a note of caution and ask some hard questions about how such non-national dispute settlement systems ought to be structured. In particular, I focus on the mechanisms used to control the limited power granted to non-national dispute settlement decision makers.

settlement proceeding whenever a complaining trademark owner asserts that: (a) the registrant's domain name is identical or confusingly similar to the complainant's trademark or service mark; (b) the registrant has no rights or legitimate interests in the domain name; and (c) the domain name has been registered and is being used in bad faith. The UDRP provides a non-exclusive list of instances of bad faith registration and use, as well as a list of the potential grounds for the registrant to establish its rights or legitimate interests in the domain name. For discussions of how UDRP panels have interpreted these key provisions, see Diane Cabell, *Overview of Domain Name Policy Development*, at <http://eon.law.harvard.edu/udrp/overview.html> (last visited Jan. 8, 2001); Dori Kornfeld, *Evaluating the Uniform Domain Name Dispute Resolution Policy*, at <http://cyber.law.harvard.edu/icann/pressingissues2000/briefingbook/udrp-review.html> (last visited Jan. 8, 2001).

8. See Daniel Bodansky, *The Legitimacy of International Governance: A Coming Challenge for International Environmental Law?*, 93 AM. J. INT'L L. 596, 600, 601 n.29 (1999) (defining legitimacy as "a quality that leads people (or states) to accept authority—independent of coercion, self-interest, or rational persuasion—because of a general sense that the authority is justified" and citing other definitions); see also Joseph P. Liu, *Legitimacy and Authority in Internet Coordination: A Domain Name Case Study*, 74 IND. L.J. 587, 603 (1999) (arguing that informal and participatory consensus model used to adopt Internet's technical standards is ill suited to public policy questions such as the structure and ownership of the domain name system).

9. See, e.g., Victoria Carrington, *Internet Needs Fast, Fair Dispute Resolution Process*, THE LAW. WKLY., Nov. 17, 2000 (asking "whether the UDRP system that is now confined to bad faith registrations ought to be and/or is capable of being expanded to include a broader range of intellectual property disputes that take place on the Internet"); *Subcommittee Tackles Jurisdiction Issues on Internet*, 60 PAT. TRAD. COPR. J. (BNA) 214, 215 (July 14, 2000) (reporting testimony before House Judiciary Committee's Subcommittee on Courts and Intellectual Property which "debated the usefulness of the [UDRP] . . . as a possible model for resolving complex jurisdictional issues"); Global Cyberspace Jurisdiction Project, *supra* note 1, at ¶ 1.4.7 (describing UDRP as a "promising example" for creating "new forms of dispute resolution" by private parties and governmental bodies for Internet disputes that cross national borders).

II. THE TENSIONS OF TECHNOLOGY, TERRITORY, AND INTELLECTUAL PROPERTY RIGHTS

To appreciate why the UDRP is both novel and also potentially problematic requires an understanding of how the Internet's seemingly borderless world¹⁰ challenges the territorial nature of national intellectual property laws, and trademark laws in particular.

First, the words and phrases designating Internet computer servers function as both names and as addresses—that is, they both locate and identify Internet resources. This duality has caused simple, easy-to-remember domain names to acquire significant commercial value as source identifiers for goods and services.¹¹ Yet the first-come-first-served system for registering domain names means that trademark owners frequently do not own names that parallel, to greater or lesser degrees, their preexisting marks.

The second challenge relates to the overlapping legislative and judicial competencies fostered by cyberspace. Although domain name owners create web sites with a global online presence, that presence creates significant offline spillover effects in many national jurisdictions. The result has been a clash of dueling lawmaking and adjudicatory competencies, both *horizontally* between different national legislatures and courts, and *vertically* between national and international bodies.¹²

Dealing with the domestic effects of transborder conduct is hardly a new phenomenon, however. In fact, it dates back to the founding of intellectual property treaties in the late nineteenth century.¹³ Under that system, now incorporated into the World Trade Organization,¹⁴ governments dealt with

10. I use the word seemingly because efforts are underway to develop technologies that will "re-territorialize" the Internet by differentiating among users, online data, and online resources according to their country of origin. See, e.g., Steve Bonisteel, *JumpTV Aims To Be Next iCraveTV—Without Lawsuits*, NEWSBYTES, Sept. 15, 2000 (discussing proposal of Canadian company to retransmit off-the-air television signals via the Internet, an act that is legal in Canada but amounts to copyright infringement in the United States, by "sealing off access to Web surfers from countries such as the U.S."); Digital Island, at http://www.digisle.net/services/app_serv/traceware.shtml (last visited Sept. 30, 2001) (discussing a commercial service called TraceWhere that purports to map web traffic to country of origin with 96% accuracy).

11. See Dan L. Burk, *Trademarks Along the Infobahn: A First Look at the Emerging Law of Cybermarks*, 1 RICH. J.L. & TECH. 1, ¶ 30 (1995); Marshall Leaffer, *Domain Names, Globalization and Internet Governance*, 6 IND. J. GLOBAL LEGAL STUD. 139, 145 (1998-99) (finding that domain names "serve a useful purpose by designating where information is to be sent [as well as] . . . they often indicate origin, and [are] view[ed] . . . as trademarks.").

12. See Dinwoodie, *supra* note 2, at 495-96.

13. See generally G.H.C. BODENHAUSEN, *GUIDE TO THE APPLICATION OF THE PARIS CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY* (1968); SAM RICKETSON, *THE BERNE CONVENTION FOR THE PROTECTION OF LITERARY AND ARTISTIC WORKS: 1886-1986* (1987).

14. Final Act Embodying the Results of the Uruguay Round of Multilateral Trade Negotiations, Apr. 15, 1994, 33 I.L.M. 1125.

transborder problems not by developing a global intellectual property code or court, but instead by adopting a more decentralized approach. They consigned the day-to-day enforcement of intellectual property rights to private party actions before national courts applying domestic laws and conflicts rules, and reserved more serious, systemic problems for treaty-based state-to-state dispute settlement.¹⁵ This approach functioned rather well when the key acts of intellectual property infringement could be localized within national borders, but it has proved a cumbersome way to address the rapid-paced, multi-jurisdictional conflicts that digital technologies engender.

In part, the UDRP was developed in response to this inadequacy, and in that sense it does reflect an advance over the existing system. The UDRP has four principal virtues: it is simple, cheap, quick, and easily accessible by parties located anywhere in the world.¹⁶ Digital filings of pleadings are the norm. The total cost of a proceeding ranges between \$750 and \$2,500 per domain name. And most decisions are published on the Internet forty-five days after a complaint is filed.¹⁷ These are significant improvements over the expenses and delays of litigating trans-national intellectual property claims in domestic courts.

15. See Laurence R. Helfer, *Adjudicating Copyright Claims Under the TRIPS Agreement: The Case for a European Human Rights Analogy*, 39 HARV. INT'L L.J. 357, 367 (1998).

16. See WIPO Arbitration and Mediation Center, *Geographical Distribution of Parties 2000*, at <http://arbiter.wipo.int/domains/statistics/2000/countries.html> (last visited Jan. 9, 2001) (identifying nationality of all complainants and respondents to UDRP proceedings conducted by WIPO). On matters of substance, issues are significantly more complex. The UDRP contains an autonomous set of rules for determining when trademark owners can recapture domain names from their registered owners. These rules are distinct from any single national trademark statute, although they do not preclude UDRP panels from consulting and applying one or more national trademark laws if they so choose. See Uniform Domain Name Dispute Resolution Policy 15(a), at <http://www.icann.org/udrp/udrp-rules-24oct99.htm> (last visited Jan. 9, 2001) [hereinafter UDRP Rules]. The overlap between the UDRP and national trademark laws is also an unsettled question. See, e.g., Barbara Solomon, *Two New Tools to Combat Cyberpiracy - A Comparison*, 90 TRADEMARK REP. 679 (2000) (comparing substantive and remedial aspects of the UDRP with the United States Anticybersquatting Consumer Protection Act, 15 U.S.C. § 1125(d)).

17. For details concerning the costs and procedural rules of each of the four UDRP dispute settlement providers, see WIPO Arbitration and Mediation Center, at <http://arbiter.wipo.int/domains/rules/supplemental.html> (last visited Dec. 7, 2001); National Arbitration Forum, at <http://www.arbforum.com/domains/domain-rules020101.asp> (last visited Dec. 7, 2001); eResolution Online Dispute Resolution Services, at http://www.eresolution.ca/services/dnd/p_r/supprules.htm (last visited Dec. 7, 2001); and Center for Public Resources, at http://www.cpradr.org/ICANN_RulesAndFees.htm (last visited Dec. 7, 2001).

III. SITUATING DOMAIN NAME CONTROVERSIES IN CONTEXT OF INTERNATIONAL DISPUTE SETTLEMENT: IDENTIFYING THE UDRP'S PROBLEMS

Although the UDRP's procedural advantages are considerable, it is also essential to understand its problematic aspects. These include the manner in which this new dispute settlement system was created, as well as certain ways in which the system's structure differs from preexisting models of international dispute settlement.

Consider first the process by which international dispute settlement bodies are created and why that process exists. Whether we are speaking of international tribunals or arbitral centers, these bodies are formed through a process of deliberative construction.¹⁸ That is, they are slowly and carefully built, often over years, by negotiators haggling over such issues as the subject matter of disputes, the procedures for adjudicating them, the parties who can bring claims, and the decision makers who will rule on those claims.

One important explanation for this slow pace is the link between legitimacy and the consensualist nature of international legal obligations. Treaties bind governments only if they choose to be bound; and private parties negotiating arbitration agreements freely select from different arbitral institutions or ad hoc rules to resolve their future disputes. Fine-tuning obligations and the mechanisms for their enforcement takes time and allows for the airing of diverse viewpoints. But the very fact that those affected by a dispute settlement regime have a choice about its structure (or indeed whether they are bound by it at all) serves a crucial legitimating function. If international authority is largely self-imposed, then it is also largely uncontroversial.¹⁹ This is particularly true in countries like the United States, in which international treaties become effective only after democratically-elected legislative bodies ratify them.²⁰

Yet any time authority is delegated to a dispute settlement institution, there is a risk that that authority will be misapplied or abused in specific cases. So a second reason for deliberative construction is that governments

18. See Kal Raustiala, *Democracy, Sovereignty, and the Slow Pace of International Negotiations*, 8 INT'L ENVTL. AFF. 3, 3-4 (1996) (noting the slow pace of international negotiation and lawmaking); see also Henry H. Perritt, Jr., *The Internet is Changing the Public International Legal System*, 88 KY. L.J. 885, 896 (1999-2000) ("The actual process of treaty negotiation begins with months or even years of preparatory work.").

19. See Paul B. Stephan III, *International Governance and American Democracy*, 1 CHI. J. INT'L L. 237, 245 (2000) (distinguishing on democratic accountability grounds between customary international rules created by courts and "institutional international law" whose rules and institutions are shaped by popularly elected legislative and executive bodies).

20. See U.S. CONST. art. II, § 2, cl. 2 (requiring consent of two thirds of Senate to ratify treaties).

and private parties spend significant time adopting checking mechanisms to control the power of dispute settlement decision makers.²¹

These checking mechanisms vary in different dispute settlement systems. In international arbitration, checks are imposed both *ex ante*, through the parties' selection of the arbitral panel and the rules it will apply, and more narrowly *ex post*, through review by national courts asked to enforce arbitral awards.²² International adjudication is somewhat different because of its effect on state actors, but here too national governments use both formal and informal mechanisms to thwart the effect of problematic rulings. Appeals to higher tribunals, procedures that permit losing parties to "block" decisions from becoming binding, and delays, or even outright refusals to implement a decision, are just a few examples.²³

Compare this account of established forms of international dispute settlement to both the creation and the structure of the UDRP. With respect to creation issues, the UDRP was constructed in just under two years from an embryonic proposal by the United States Commerce Department, to a study by the UN-based World Intellectual Property Organization ("WIPO"), with final revisions and implementation by ICANN.²⁴

Of course, a faster pace of international lawmaking is not necessarily problematic, particularly where rapidly evolving digital technologies are concerned. But the UDRP's adoption was more than just speedy. Unlike prior intellectual property regimes, the UDRP emerged from a semi-private rulemaking process which avoided many of the safeguards that have accompanied such rulemaking in the past.²⁵

Specifically, WIPO acted upon a request from one national government agency to develop a dispute settlement proposal that was submitted not to

21. See W. MICHAEL REISMAN, *SYSTEMS OF CONTROL IN INTERNATIONAL ADJUDICATION AND ARBITRATION* 1-7 (1992).

22. See generally ALAN REDFERN & MARTIN HUNTER, *LAW AND PRACTICE OF INTERNATIONAL COMMERCIAL ARBITRATION* (1999).

23. See, e.g., David Palmetier, *National Sovereignty and the World Trade Organization*, 2 J. WORLD INTELL. PROP. 77, 80-81 (1999) (discussing WTO dispute settlement procedures); REISMAN, *supra* note 21, at 15 (discussing International Court of Justice). For recent examples of delaying tactics with respect to intellectual property norms, see Ravi Kanth, *WTO Arbitrator Gives Canada Until Oct. 7 to Comply With Drug Stockpiling Decision*, 17 INT'L TRADE REP. (BNA) 1313, 1314 (Aug. 24, 2000) (outlining WTO arbitrator's rejection of Canada's request for fifteen-month period to implement TRIP's panel's pharmaceutical patent ruling and imposing six-month period instead).

24. See Timeline for the Formulation and Implementation of the Uniform Domain-Name Dispute-Resolution Policy, at <http://www.icann.org/udrp/udrp-schedule.htm> (last visited Jan. 10, 2001).

25. A. Michael Froomkin, *Semi-Private International Rulemaking: Lessons Learned from the WIPO Domain Name Process* (Aug. 26, 1999), at <http://www.law.miami.edu/~froomkin/articles/TPRC99.pdf> (last visited Dec. 7, 2001).

other national governments as a model for voluntary adoption, nor to a governmental conference negotiating a new intellectual property treaty to be ratified by elected legislatures, but rather to a new private corporation with its own rulemaking powers. This was an act of collaboration between public and private entities quite unlike WIPO's historical role. And it was an approach that avoided many of the political buffers that slow down public international negotiations and implementation and permit diverse perspectives to be aired. It is not surprising, then, notwithstanding efforts by WIPO and ICANN to create a transparent rulemaking and comment process,²⁶ that the UDRP's formation was unduly rushed and heavily dominated by intellectual property interests.²⁷ The result, some observers charge, is a UDRP that is structurally biased in favor of trademark owners.²⁸

This result should not suggest that a private, non-national dispute settlement system can never supplement state-based systems of adjudication. But for such a system to function legitimately, at least two features must be satisfied. First, the private parties affected by the system must have significant involvement in developing the regime's mandatory rules, or at least a meaningful ability to challenge the results in particular cases. Second, national governments, whose trademark and unfair competition laws are very much affected by non-national domain name adjudication, must have opportunities to contribute to the system's substantive outcomes.

However, the UDRP is deficient in both of these areas. First, the UDRP eliminates the negotiations and party autonomy of international arbitration and substitutes for it a mandatory system for domain name owners. When an individual registers a generic top-level domain name anywhere in the world, she is contractually bound to accept the jurisdiction of UDRP panels when any trademark owner invokes it. She cannot alter the subject matter of disputes, she cannot select the dispute settlement provider that will hear her case, and she has only limited avenues to challenge panel excesses or

26. See WIPO Final Report, *supra* note 6, ¶¶ 26-31 & Annexes II & III; ICANN Public Comment Forum, at <http://www.icann.org/comments-mail/comment-udrp/current/maillist.html> (last visited April 12, 2001).

27. See, e.g., A. Michael Froomkin, *A Commentary on WIPO's The Management of Internet Names and Addresses: Intellectual Property Issues* (May 19, 1999), at <http://www.law.miami.edu/~amf/commentary.htm>; Milton Mueller, *Technology and Institutional Innovation: Internet Domain Names*, 5 INT'L J. COMM. L. & POL'Y 1, 16-22 (2000); see also William New, *WIPO on Defensive For Domain-name Dispute Decisions*, NAT'L J. TECH. DAILY (Dec. 11, 2000).

28. The outcome of panel decisions in the first year of the UDRP's operation appears to confirm this result. See Milton Mueller, *Rough Justice: An Analysis of ICANN's Uniform Dispute Resolution Policy*, at <http://dcc.syr.edu/roughjustice.pdf> at 12 (last visited Jan. 9, 2001) (noting that trademark owners have prevailed in 80% of UDRP panel decisions); see also *id.* at 2-31 (using statistical analysis of first 621 UDRP decisions to demonstrate that the rule permitting trademark owners to choose which dispute settlement provider will hear their complaint allows complainants to forum shop for providers more likely to rule in their favor).

errors.²⁹ This eliminates the autonomy of traditional international arbitration, in which the parties control arbitral power by painstakingly negotiating the terms of their arbitration agreement. Of course, ICANN's rulemaking process itself might function as a reasonable proxy for such individualized negotiation. But if the rules that result from that process are skewed, or if the process itself is open to challenge on legitimacy grounds, then the global arbitral bargain struck by ICANN is itself questionable.³⁰

Second, unlike international arbitration and adjudication, the UDRP contains its own built-in compliance scheme that effectively side-steps state-based enforcement mechanisms. For example, if a UDRP panel decides in favor of a trademark owner, its ruling is directly enforced by a domain name registrar who cancels the respondent's domain name or transfers ownership of it to the complainant.³¹ Nominally, the respondent can stay enforcement by commencing an action in a national court of so-called "mutual jurisdiction" within ten business days.³² But this brief ten-day window, the difficulty and expense of filing a complaint in what is often a foreign jurisdiction, and the uncertain subject matter basis for such a proceeding is likely to make national court review a rarity.³³

What are the consequences of infrequent national court review? One interpretation is that UDRP panelists are deciding cases correctly, obviating the need for such review. This is likely to be true in cases of core domain

29. See Policy, *supra* note 3, ¶ 4a; Cabell, *supra* note 7; Kornfeld, *supra* note 7; see also Second Staff Report on Implementation Documents for the Uniform Dispute Resolution Policy (The Internet Corporation for Assigned Names and Numbers), ¶ 4.15, (Oct. 24, 1999) ("The provider . . . for each dispute would be determined by the complainant, which would submit its complaint to the selected provider."), at <http://www.icann.org/udrp/udrp-second-staff-report-24oct99.htm> (last visited Dec. 7, 2001).

30. See Draft Yokohama Statement on Civil Society and ICANN Elections (The Internet Corporation for Assigned Names and Numbers), ¶¶ 1, 4, (July 1, 2001), at http://www.icannwatch.org/archive/civil_society_and_icann_elections.htm (last visited Dec. 7, 2001); Jonathan Weinberg, *ICANN and the Problem of Legitimacy*, 50 DUKE L.J. 187 (2000).

31. Policy, *supra* note 3, ¶¶ 3(c), 4(i).

32. *Id.* at ¶ 4(k). In addition, the UDRP does not preclude either of the contesting parties from filing a complaint in a national court before a UDRP complaint is filed, during a UDRP proceeding, or after a UDRP panel has issued its decision. See *BroadBridge Media LLC v. Hypercd.com*, 168 F. Supp. 2d 505 (S.D.N.Y. 2000); see also *Weber-Stephen Prods. Co. v. Armitage Hardware & Bldg. Supply Inc.*, 54 U.S.P.Q.2d 1766, 1768 (N.D. Ill. 2000) (recognizing that trademark owner filed complaint in United States district court one day after filing UDRP complaint—court stayed its decision pending ruling of UDRP panel).

33. See *Hearing on Internet Domain Names Before the House Committee on Energy and Commerce Subcommittee on Telecommunications and the Internet*, (Feb. 8, 2001) (testimony by Dr. Vinton G. Cerf, Chairman of ICANN), available at 2001 WL 2005949 ("Even though the UDRP is non-binding . . . it appears that [court challenges] ha[ve] happened in only a few dozen out of over 2,000 decisions to date.").

name abuses. However, in other decisions panels have construed the UDRP expansively in favor of trademark owners, even when that requires a strained reading (or even a misreading) of the Policy's text.³⁴ As one panel recently cautioned, "distasteful conduct [by domain name owners] should not stampede UDRP decision makers into an unwarranted expansion of the . . . dispute process."³⁵ These expansive (and unreviewed) decisions are especially troubling when they address issues that WIPO and ICANN are only now reviewing as potential legislative expansions of the UDRP.

IV. TOWARD SOME FIRST STEPS FORWARD

So where do we go from here, given the problems just identified? I see two ways of proceeding. The first involves making incremental changes to the UDRP in light of the experience generated during its first two years. But the second and more important question concerns whether even an appropriately revised UDRP can serve as a model to be applied to the many other trans-border legal problems that cyberspace is generating.

As to tinkering with the UDRP, the ball is now in ICANN's court. In the coming months, a panel of stakeholders and experts appointed by ICANN will review the UDRP's performance and will consider if reforms of the dispute settlement system are warranted.³⁶ ICANN will also address whether to expand the UDRP in light of the report and recommendations of the Second WIPO Domain Name Process.³⁷

I believe that reform and expansion must go hand in hand. The system is too new and its legitimacy too fragile to burden it with a broader jurisdiction without also conducting a thorough review of issues that critics have identified as problematic.³⁸ These issues include eliminating the forum shopping incentives created by the current method of selecting dispute

34. See Mueller, *supra* note 28, at 23 (containing a list of some of the most problematic panel rulings in the UDRP's first year, and discussing seven "really bad decisions"); see also Springsteen v. Bugar, WIPO Case No. D2000-1532, at 5 (Jan. 25, 2001) ("This Panel believes that previous Panels have all too readily concluded that the mere registration of the mark [as a domain name] . . . is evidence of an attempt to prevent the legitimate owner of registered or common law trade mark rights from obtaining a 'corresponding domain name.'").

35. Wal-Mart Stores, Inc. v. walmartcanadasucks.com, WIPO Case No. D2000-1104, ¶ 6A (Nov. 23, 2000) (stating that "[t]he UDRP has a narrow scope [and is not meant] . . . to provide a general remedy for all misconduct involving domain names.").

36. See Names Council Selects UDRP Task Force Members, ICANN Watch Aug. 27, 2001, available at <http://www.icannwatch.org/article.php?sid=317> (last visited December 28, 2001).

37. See World Intellectual Property Organization, *The Recognition of Rights and the Use of Names in the Internet Domain Name System*, Report of the Second WIPO Internet Domain Name Process, (Sept. 3, 2001), <http://wipo2.wipo.int> (last visited December 28, 2001).

38. At a minimum, ICANN should not extend the UDRP's subject matter to anything other than core cybersquatting and other abusive registration disputes until it conducts a thorough review of the UDRP's performance.

settlement providers;³⁹ reviewing the system's choice of law rule to clarify the relationship between the UDRP, national intellectual property laws, and treaty rules;⁴⁰ and considering whether the costs and delays involved in creating a UDRP appellate tribunal are outweighed by the need to resolve the growing number of inconsistent decisions.⁴¹

39. Milton Mueller's study of the first 621 UDRP decisions concludes that "forum shopping and bias" have resulted from the UDRP rule allowing the trademark owner to choose the dispute settlement provider:

There is statistical evidence that selection of dispute resolution service providers by challengers leads to forum shopping that biases the results. There are major differences among arbitration providers in the ratio of successful to unsuccessful challenges. . . . Both NAF and WIPO tend to interpret the UDRP in ways that favor trademark holders over other Internet users, whereas eResolutions decisions tend to adhere more closely to the strict language of the policy.

Mueller, *supra* note 28, at 2; *see also* Comments of David Post to ICANN Staff & Council Regarding UDRP, 3 (Oct. 11, 1999) (predicting that granting trademark owners the right to choose ICANN-accredited dispute settlement provider creates incentives for providers to rule in favor of trademark owners). Mueller's proposed solution to this problem is to allow domain name registrars to select the dispute settlement provider to hear disputes over the names they register. *See* Mueller, *supra* note 28, at 21. *But see* ICANN Staff Report: Uniform Dispute Resolution Policy for gTLD Registrars (Aug. 14, 1999) (rejecting this option prior to adoption of UDRP on the ground that it "creates a (perhaps irresistible) potential for registrars to seek to differentiate themselves in the marketplace by the outcomes under Providers they select, thereby undercutting uniformity among registrars" and "severely impair[ing] the principle that the dispute resolution policy should be uniform among registrars . . ."), available at <http://www.icann.org/udrp/staff-report-29sept99.htm> (last visited Dec. 7, 2001).

40. Under UDRP Rule 15(a), a panel is directed to "decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy [and] Rules . . ." However, each panel is also permitted to consult "any rules and principles of law that it deems applicable." UDRP Rules, *supra* note 16, at 15(a). Thus, the situations in which panels should consult and apply one or more (unspecified) national trademark, unfair competition, or cybersquatting laws in addition to the UDRP's autonomous rules is an important and unsettled issue.

41. *See* M. Scott Donahey, *Adding Appeals Procedure to Dispute Resolution Might Satisfy ICANN Critics*, 6 ELEC. COMM. & L. REP. 33 (2001) (proposing UDRP appellate panel and discussing its structure and jurisdiction); *Experts Call For Right of Appeal in Domain Name Dispute Resolution*, 14 WIPO REP. 402 (2000) (discussing comments by experts participating in meeting convened by WIPO). Conflicts (or at least tensions) among panel decisions have emerged in some of the most controversial areas of UDRP practice, including cybergripping, domain names containing personal names, and domains referring to geographic locations. *Compare* Wal-Mart Stores, Inc. v. walmartcanadasucks.com, WIPO Case No. D2000-1104 (Nov. 23, 2000) (refusing to order transfer of domain name walmartcanadasucks.com) with Wal-Mart Stores, Inc. v. Walsucks and Walmarket Puerto Rico, WIPO Case No. D2000-0477 (July 20, 2000) (ordering transfer of virtually identical domain name "walmartcanadasucks.com" owned by same respondent). *See also* Excelentísimo Ayuntamiento de Barcelona v. Barcelona.com Inc., WIPO Case No. D2000-0505 (Aug. 4, 2000) (transferring geographic name); Roberts v. Boyd, WIPO Case No. D2000-0210 (May 29, 2000) (transferring personal name); Winterson v. Hogarth, WIPO Case No. D2000-0235 (May 22, 2000) (transferring personal name). *But see* Kur-und Verkehrsverein St. Moritz v. StMoritz.com, WIPO Case No. D2000-0617 (Aug. 17, 2000) (refusing to transfer trademarked geographic name of Swiss city to official organization representing that city where respondent provided information services about such city); Gordon Sumner p/k/a Sting v. Urvan, WIPO Case No. D2000-596 (July 24, 2000)

As to the broader issue of whether to treat the UDRP as a new model for non-national cyberspace dispute settlement, answering that question turns on whether the UDRP contains any innovations that make it worthy of emulation. In addition to the procedural advantages identified earlier, I see three such innovations.

The first is that the UDRP may represent the leading edge of a non-national⁴² approach to intellectual property lawmaking and dispute settlement, an approach that operates outside of, although not necessarily in conflict with, the intellectual property treaty system and territorial national laws. I have highlighted in this essay some of the hazards of this non-national approach, but serving as a laboratory for experimenting with new ways to mediate conflicts among divergent national laws is one of its advantages. That governments see value in a non-national approach is demonstrated by their enthusiastic endorsement of the Second WIPO Domain Name Process, including support from the United States, which has deferred expanding its own cybersquatting statute pending the outcome of WIPO's efforts.⁴³

As for the UDRP's second innovation, I see privatized bodies such as ICANN as possessing the potential to more accurately reflect the preferences of cyberspace communities than territorial nation states, and thus ultimately having a genuine and competing claim to exercise rulemaking and dispute settlement powers. I should stress, however, that it is far too early to consider ICANN as anything even approaching a global cyberspace parliament, given the many challenges to its legitimacy in the United States and the European Union,⁴⁴ and the paucity of voters in recent elections to the ICANN Board.⁴⁵

(refusing to transfer domain name containing stage name of famous musician because musician's actual name was different and also generic); *Bruce Springsteen v. Jeff Burgar and Bruce Springsteen Fan Club*, WIPO Case No. D2000-1532 (Jan. 25, 2001) (refusing to transfer *brucepringsteen.com* to famous artist).

42. For a discussion of the term "non-national," see *supra* note 4.

43. *Report to Congress: The Anticybersquatting Consumer Protection Act of 1999* (Jan. 18, 2001) ("We believe that [the WIPO Process] will facilitate the development of important consensus across jurisdictions regarding the protection of personal name disputes that occur online, and, accordingly, we look forward to this process to shed light on these complex issues."), available at <http://www.uspto.gov/web/offices/dcom/olia/domainnamerep.html> (last visited Dec. 7, 2001).

44. *Senate to Scrutinize ICANN More Closely*, THE INDUSTRY STANDARD, (Feb. 14, 2001) (noting that chair of Senate Commerce and Science Communications Subcommittee would review ICANN more closely "after witnesses at a hearing called its legitimacy into question"), available at <http://www.thestandard.com/article/0,1902,22210,00.html>; see also Anthony Shadid, *The Name Game*, THE BOSTON GLOBE, April 9, 2001, at 2-3, available at http://www.boston.com/dailyglobe/2/099/business/The_name_game+.shtml (last visited April 12, 2001) (discussing increasing skepticism about ICANN's activities in the United States Congress as well as discussing New.net, a California start-up company offering domain names not authorized by ICANN and making it easy to reconfigure browsers to direct traffic to New.net sites).

45. Approximately 34,000 individuals voted for ICANN's at-large board of director slots, with the voting heaviest in the Asian-Pacific region and Europe, and lightest in Africa, Central America,

Finally, the UDRP was innovative in responding to cybersquatting not by forcing an existing model to fit the problem at hand, but by crafting a new, hybrid system that took some elements from international adjudication, some elements from arbitration, and some elements from administrative decisionmaking. It is that flexibility, and the rapidity with which it can adapt to technological change, that might be worthy of emulation in other cyberspace contexts. To take just one example, privatized dispute settlement could be used to supplement national court adjudication of the copyright infringement issues raised by the “notice and takedown” obligations imposed upon Internet Service Providers in the United States and Europe.⁴⁶

In each of these areas, the challenge will be finding ways that will be able to bolster the legitimacy of privatized systems like the UDRP without jettisoning their advantages. Too rapid an evolution away from established and accepted forms of lawmaking and dispute settlement may cause a backlash against non-national structures by governments with competing national interests. Indeed, it is only if those interests are accommodated somewhere in the system that it will be possible to “grow” nascent private institutions that might one day come to rival national or international ones.

and the Caribbean. See Marilyn Geewax, *Moving beyond '.com' Expanded Domains*, ATLANTA J. & ATLANTA CONST., Nov. 5, 2000, at A1, available at 2000 WL 5485070; Jason Norwood-Young, *Ghanaian Voted as Voice of Africa on Net*, AFR. NEWS SERV., Oct. 12, 2000.

46. See Digital Millennium Copyright Act, 17 U.S.C. § 512(c)(1)(C); Directive 2000/31/EC of the European Parliament and of the Council of 8 June 2000 on Certain Legal Aspects of Information Society Services, In Particular Electronic Commerce, in the Internal Market, arts. 12-14, and Recitals 40-46, O.J. (L 178) 1, 6, 12-13 (providing that member states should encourage the development of notice and takedown procedures by means of “voluntary agreement between all parties concerned.”).
