

The Adjudicator's Decision

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Johannesburg

14 April 2014

Session Outline

- my approach to the role
- the operation of 3 member panels
- absence/inadequacy of pleadings
- court proceedings
- settlements
- precedent

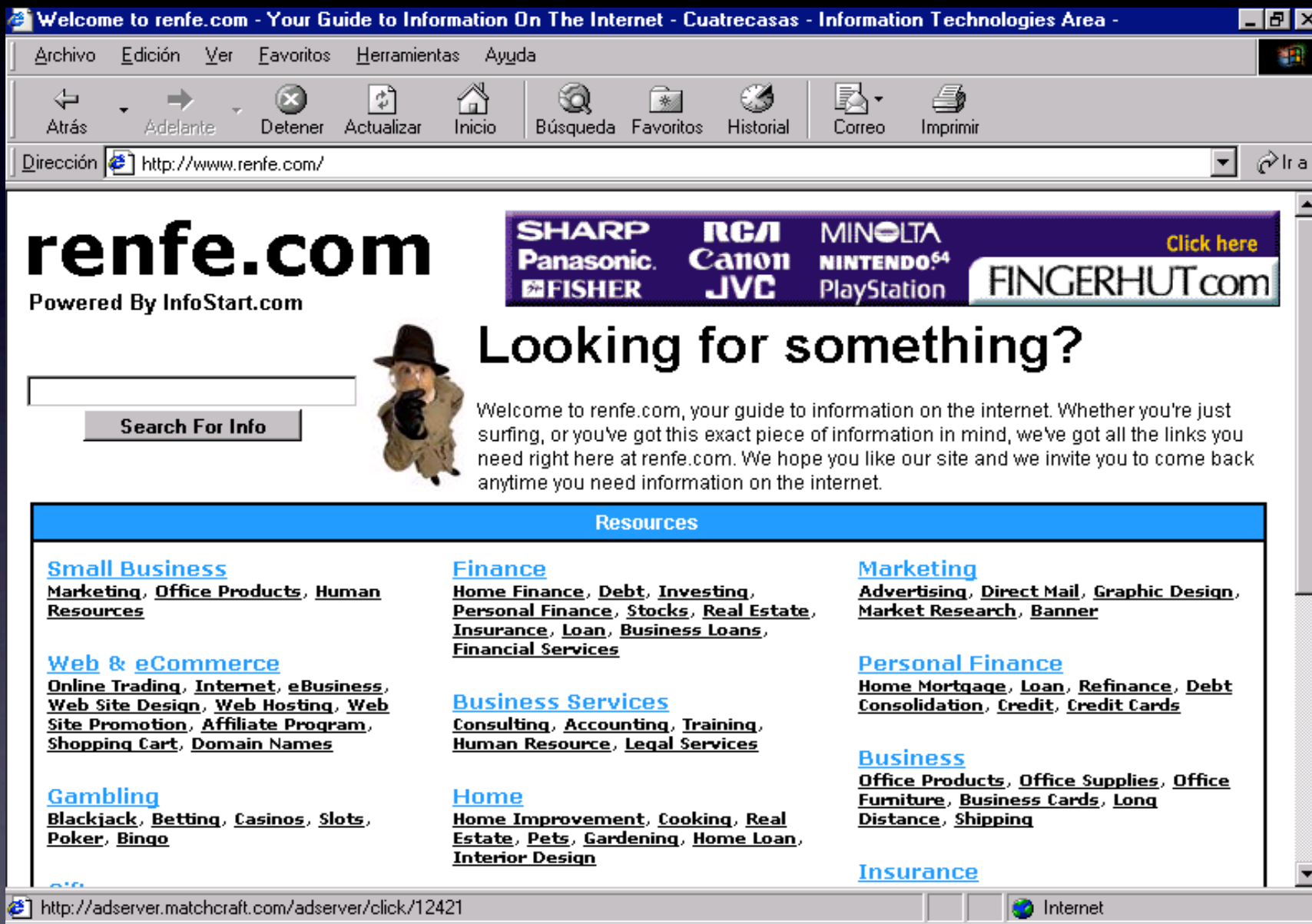
my approach

- am I conflicted?
- can I meet the time limit?
- speed read the case file as soon as it arrives
- create a chronology
- never cut corners
- aim to produce a readable, reasoned decision

3-member panels

- the role of the presiding panelist
- interplay between panelists
- dealing with dissent

Dissent



WIPO Case No.
D2001-0981
<renfe.com>

Dissent



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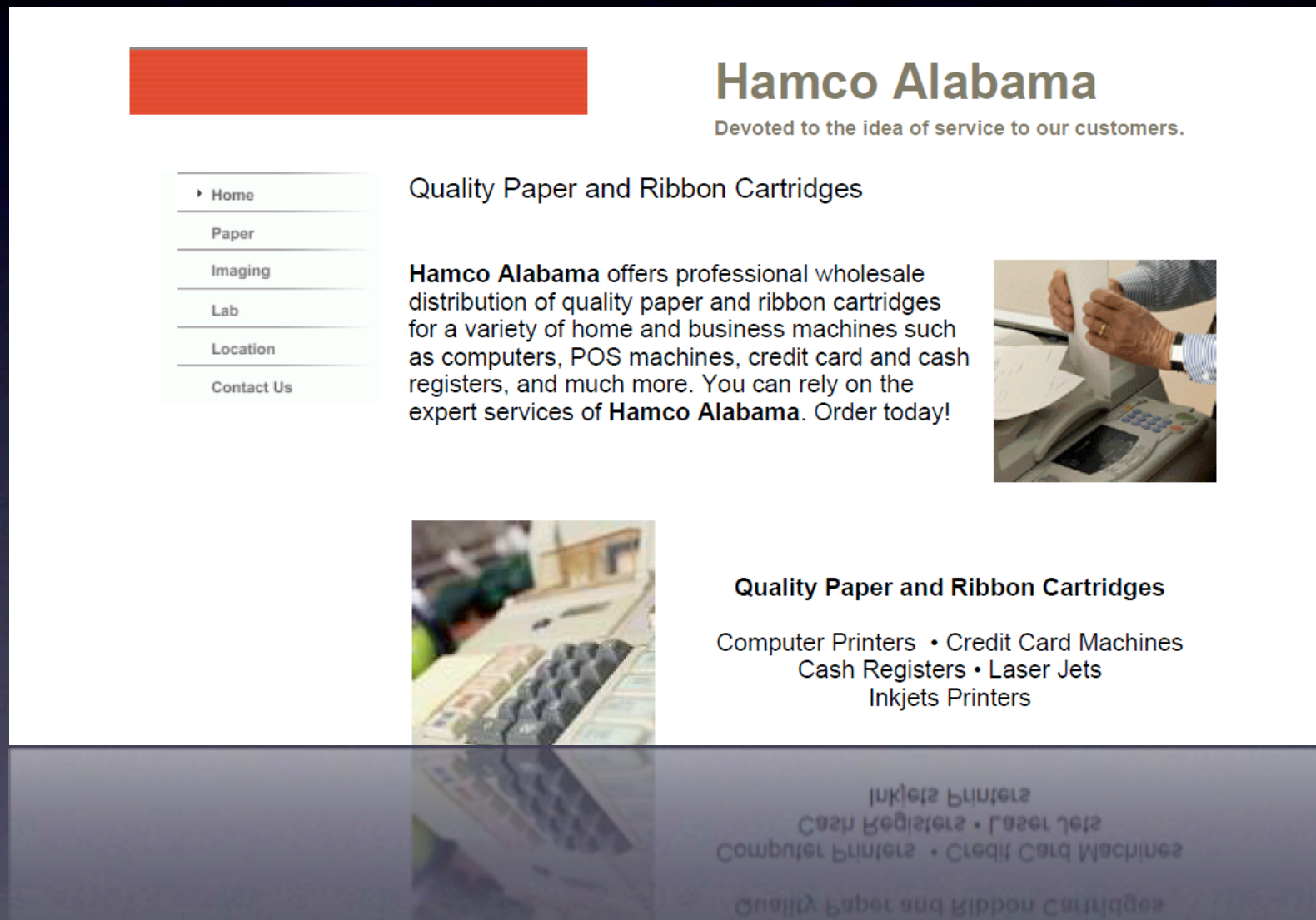
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DRS 02201 <VikingDirect.co.uk>

absence/inadequacy of pleadings

- Respondent default
- holes in the evidence and conflicts of evidence
- procedural orders
- adjudicator independent research

procedural orders



WIPO Case No. D2011-1451 <HamcoAlabama.com>

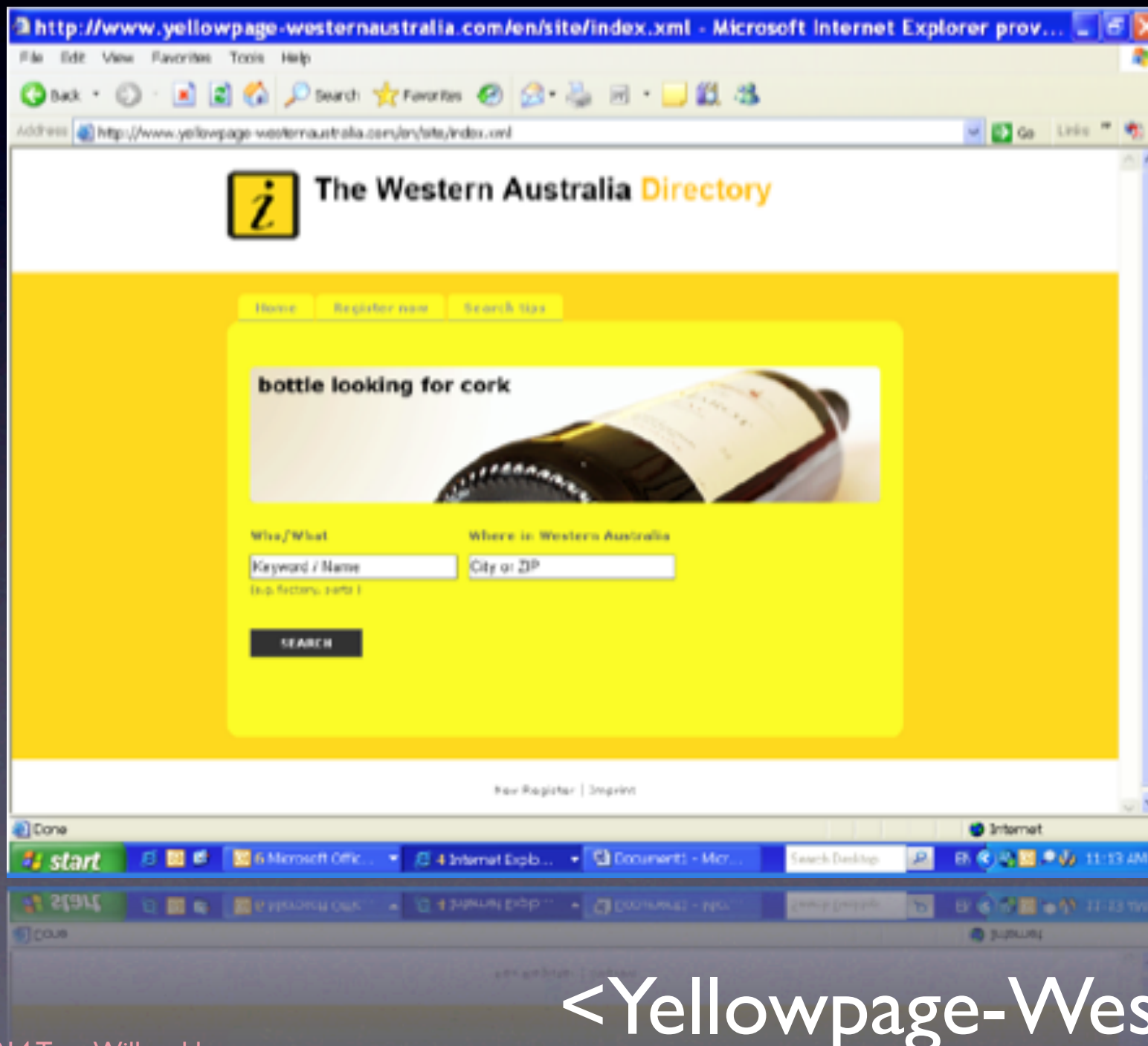
panel investigations

Paragraph 4.5 of the WIPO Decision Overview

Can a panel perform independent research when reaching the decision?

Consensus view: A panel may undertake limited factual research into matters of public record if it deems this necessary to reach the right decision. This may include visiting the website linked to the disputed domain name in order to obtain more information about the respondent and the use of the domain name, consulting a repository such as the Internet Archive (at www.archive.org) in order to obtain an indication of how a domain name may have been used in the relevant past, reviewing dictionaries or encyclopedias to determine any common meaning, or discretionary referencing of trademark online databases. A panel may also rely on personal knowledge. If a panel intends to rely on information from these or other sources outside the pleadings, especially where such information is not regarded as obvious, it will normally consider issuing a procedural order to the parties to give them an opportunity to comment. Alternatively or additionally, if the panel feels that it requires supplemental information to make a decision in a proceeding, it can issue a procedural order to the parties requesting the submission of such information.

panel investigations



WIPO Case No.
D2011-0057

<Yellowpage-WesternAustralia.com>

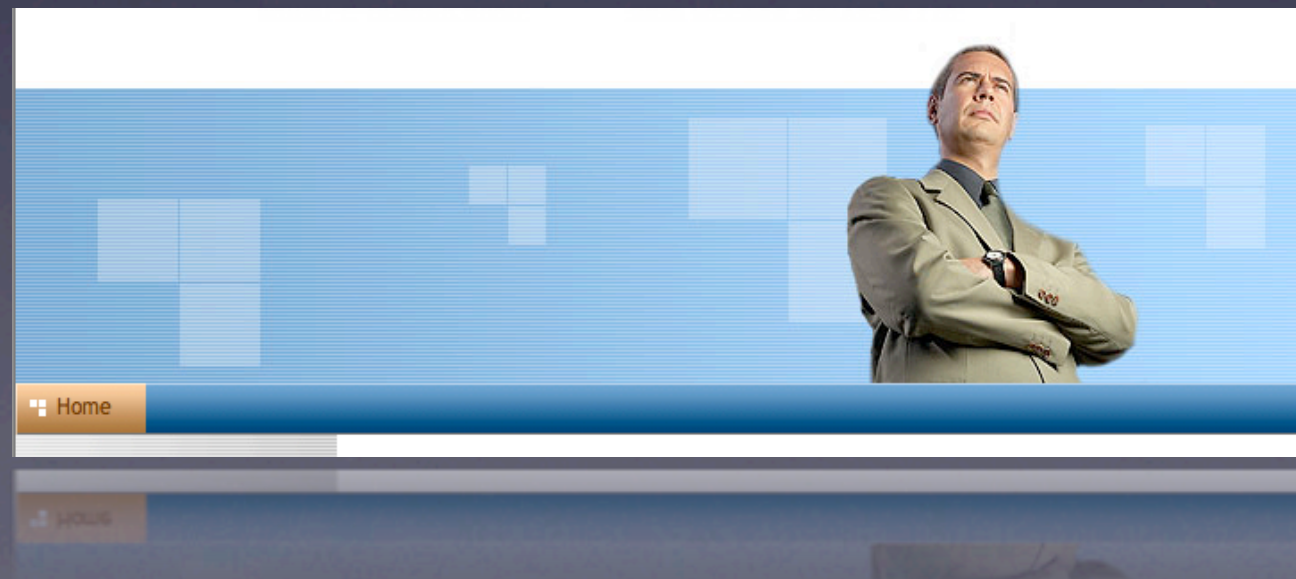
panel investigations



registrant-firstname: Martin
registrant-lastname: Peoples
registrant-street1: 53 Sunnyside Street
registrant-pcode: BT7 3EX
registrant-city: Belfast
registrant-ccode: GB
registrant-phone: +44.2078707605
registrant-fax: +44.1324742400
registrant-email: martin_peoples@hotmail.com

admin-c-firstname: Sean
admin-c-lastname: McAndrew
admin-c-organization: Safe Access Services Ltd.
admin-c-street1: 10 Elizabeth Road
admin-c-pcode: B13 8QJ
admin-c-city: Birmingham
admin-c-ccode: GB
admin-c-phone: +44.7720840779
admin-c-email: martin_peoples@hotmail.com

WIPO Case
No.
D2010-1255
<mansafe.com>



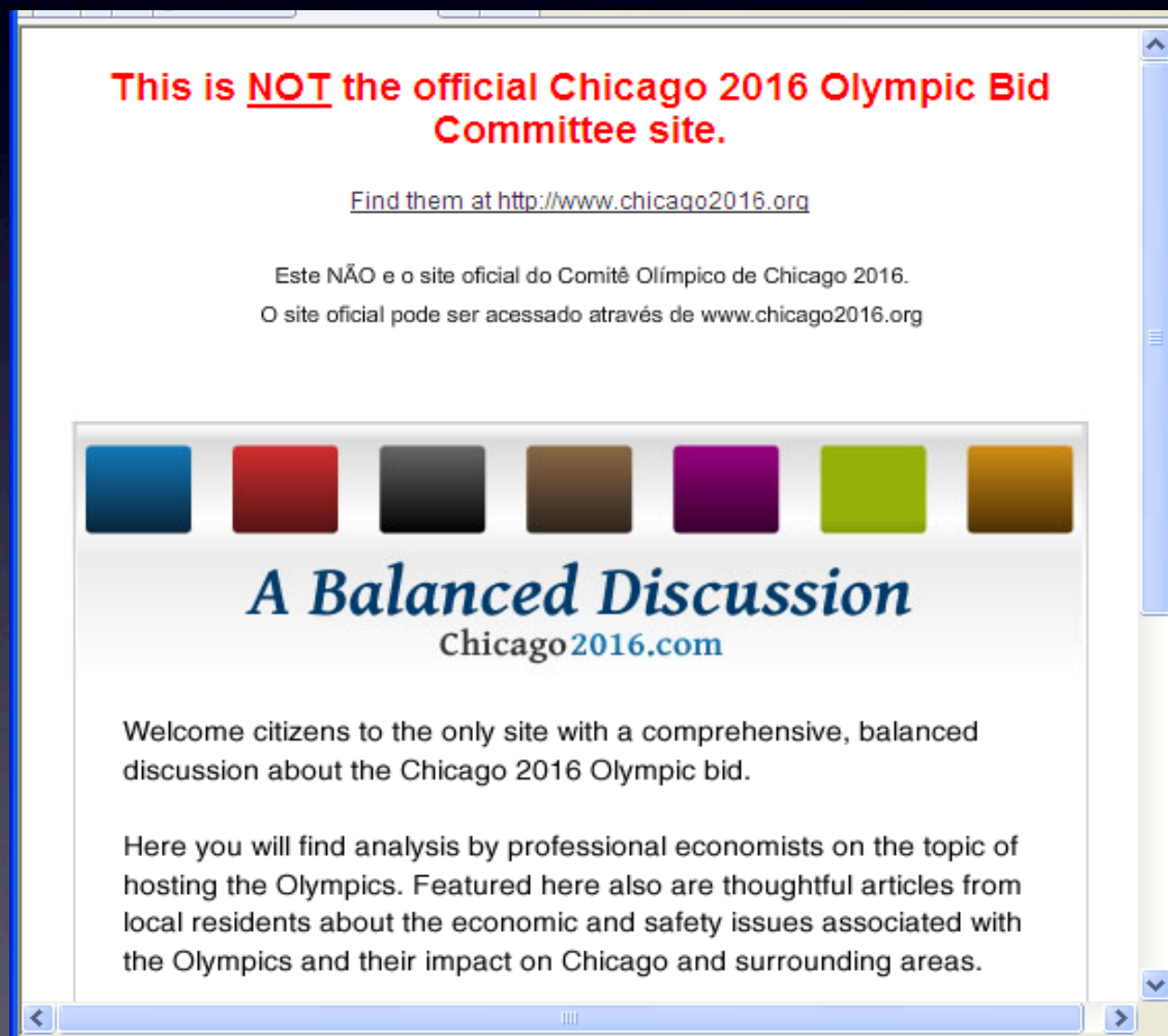
court proceedings

- suspension may be mandatory (Nominet) or discretionary (UDRP)
- how to exercise one's discretion under the UDRP (para 18 of the UDRP Rules)
- concurrent court proceedings
- post-decision court proceedings

Concurrent court proceedings

- Panels very rarely suspend UDRP proceedings due to concurrent court proceedings
- More commonly panels will either proceed to a UDRP decision (non-binding on court)
- . . . or terminate the UDRP proceeding (generally “without prejudice to the filing of a new complaint depending upon the outcome of the court proceedings”)

Concurrent court proceedings



- After receipt of Complaint, Respondent filed suit seeking a declaratory judgment on free speech grounds.
- Panel terminated the UDRP proceeding without prejudice to the filing of a new complaint pending resolution of the court proceeding.

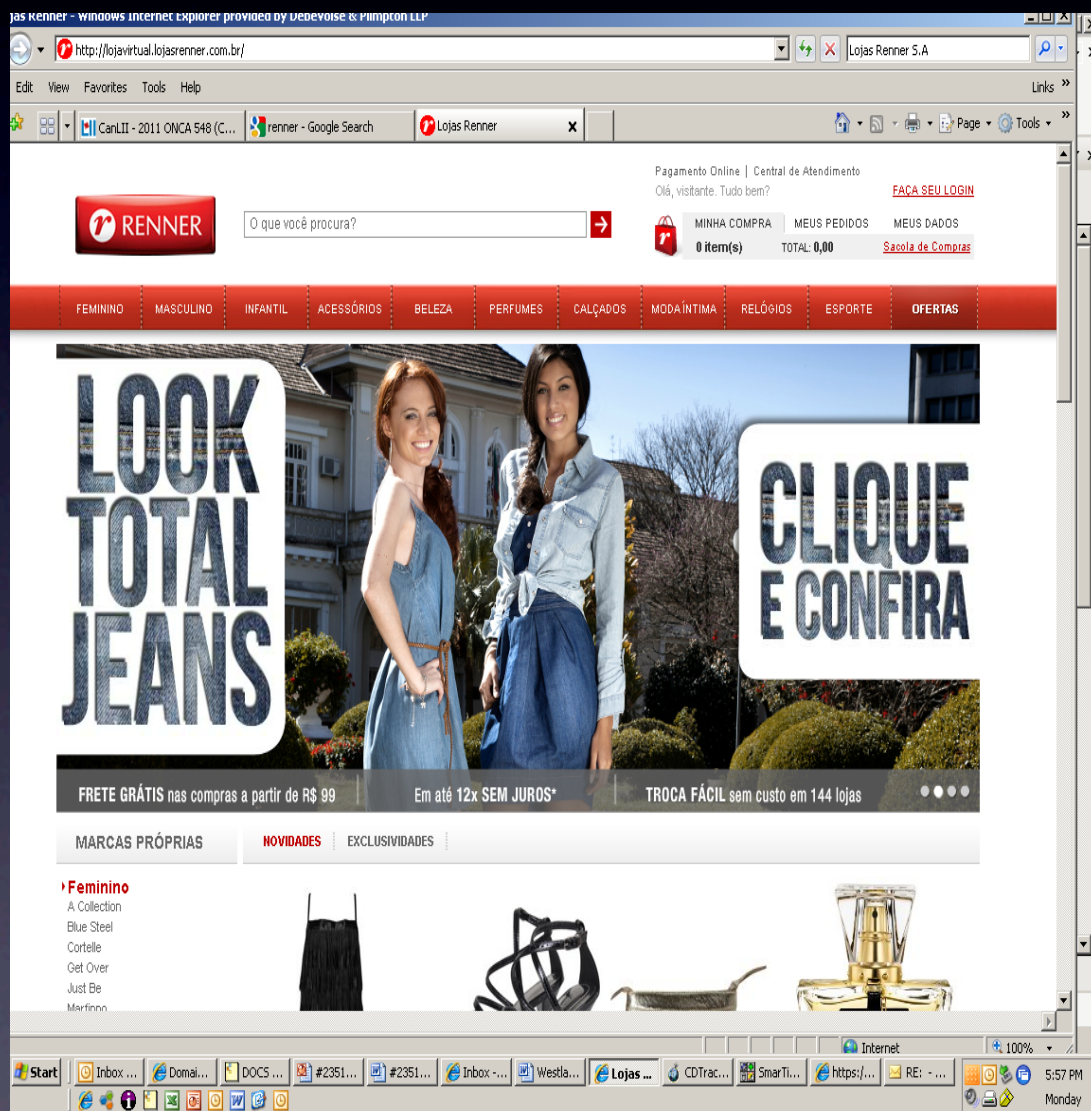
Concurrent court proceedings



- Case filed in German court after complaint filed
- Panel declined to suspend or terminate and proceeded to a decision
- Court might find UDRP decision helpful; No knowing what may happen to the court proceeding; panel decision may lead to settlement; suspect timing of the court filing

WIPO Case No. D2009-0041
<essque.com>

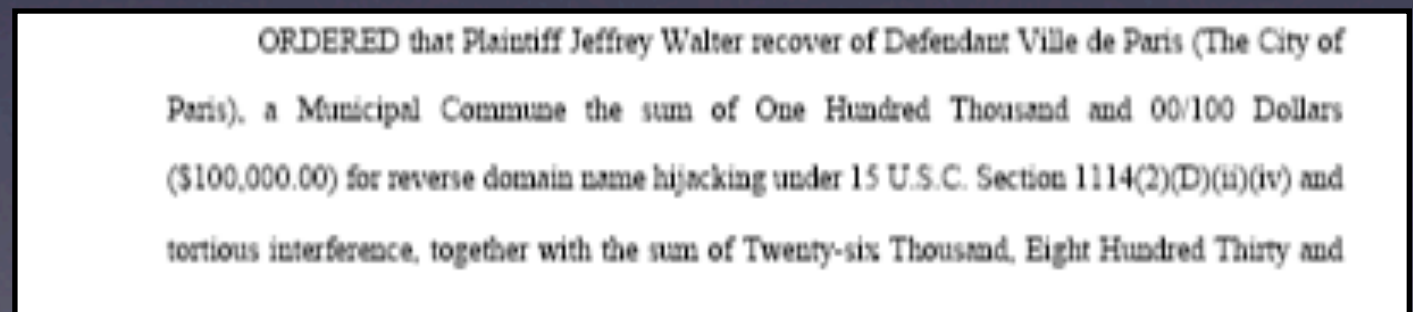
Concurrent court proceedings



- Renner filed a UDRP complaint
- Tucows filed suit in the Ontario Superior Court of Justice
- Panel terminated the proceeding

WIPO Case No. D2009-0637
<renner.com>

Post-UDRP court proceedings



Post-UDRP court proceedings

In Canada, one court has reviewed a UDRP decision on the merits and considered whether decision was correct under the UDRP standards (rather than applying national law)



Black v. Molson Canada (2002) –
Reviewed the UDRP decision in detail,
applied the three 4(a) factors *de novo*, and
came to the opposite conclusion on domain
name <canadian.biz>.

UDRP in Court - UK

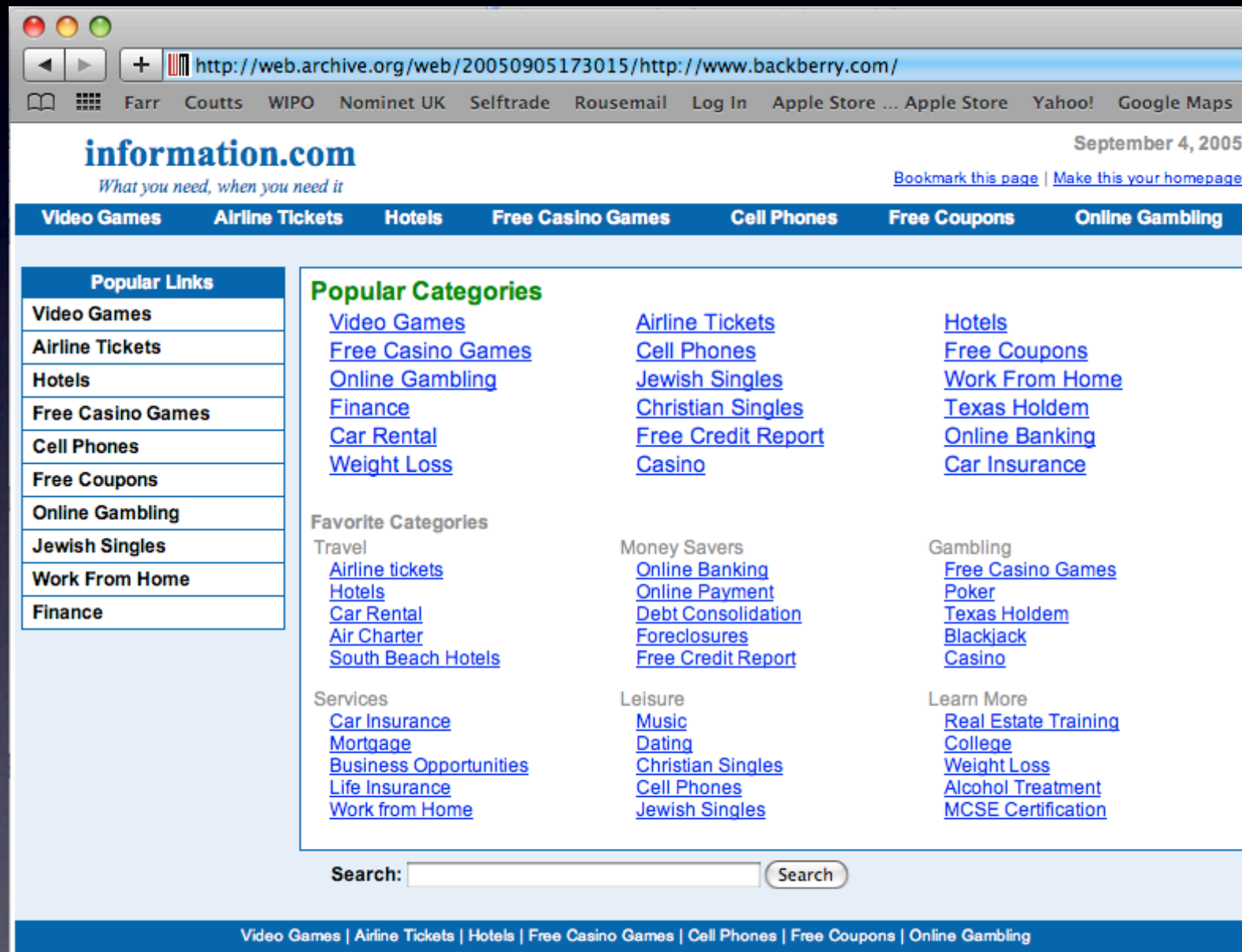
- F Hoffman-La Roche v. Stock DRS 01798 <xenical.co.uk>
 - F Hoffman-La Roche v. Stock (High Court 2004)
- Endo Pharmaceuticals v. Kumar Patel NAF Case FA642131 <endo-pharmaceuticals.com>
 - Patel v. Endo Pharmaceuticals (English High Court 30.11.06)
- Allos Therapeutics v. Kumar Patel WIPO Case No. D2007-0521 <allostherapeutics.com>
 - Patel v. Allos Therapeutics Inc. (English High Court 13.6.08)
- Emirates v. Toth DRS 08634(Appeal) <emirates.co.uk>
 - Toth v. Emirates (English High Court 7.3.12)



settlements

- mediation (Nominet)
- para 19 DRS Procedure
- para. 17 UDRP Rules
- consent to transfer (UDRP)

Consent to Transfer



WIPO Case No.
D2009-0320
<backberry.com>

precedent

- general
- cited ‘authority’ (court decisions, ADR decisions)

thank you