



# **HKI Arb International Arbitration and Mediation Training Programme for Intellectual Property Disputes**

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Module 5**

## **Domain Name Dispute Resolution Conduct of Proceedings**

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# A. General Considerations

- 1A. UDRP: Nature – a mandatory administrative proceeding to deal with a special type of dispute, not mutually exclusive with other court proceedings and may not be conclusive. [UDRP 4(k)]
  
- 1B. DNDRP (for .hk and .香港):  
Nature: Arbitration Proceedings – governed by DNDRP Rules, Provider Supplemental Rules and Arbitration Ordinance (Cap. 609) [DNDRP: Preamble]
  
2. The Panel has a wide discretion [UDRP Rule 15(a)] [DNDRP Rule 15(a)].

3. Follows general principles of established dispute resolution rules - independence and impartiality of the Tribunal, equality and fairness to the parties, disposal of the dispute without unnecessary delay [Rules 7, 10].
4. A quick fix with worldwide success.

# B. Pleadings

## 1. Complaint

- (a) Give me your best shot [Rules 3-5, 12, 13 & 15]
- (b) Form: no standard format prescribed but there is a WIPO model complaint available (<https://www.wipo.int/amc/en/domains/complainant/>)

- c) Language of Proceedings: same as that in the registration agreement subject to the panel's determination otherwise [Rule 11]. [c.f. HKDRP Rule 11(a): English for English .hk domain name and Chinese for Chinese .香港 domain name]
  
- d) The Panel has a wide discretion [Rule 15(a)].

## i) Procedural and other formal parts

- Submission to the Policy, Rules and Supplemental Rules [Rule 3(b)(i)]
- Identification of parties, contact particulars and preferred method of communications [Rules 3(b)(ii)(iii)(v)]
- Identification of the domain name(s) and the registrar(s) [Rules 3(b)(vi)(vii)]
- [DNDRP Rule 3(c) - only one Domain Name except for Domain Name in pair .hk & .香港, shall be dealt with together]

Registration information obtainable by  
“lookup” search at <https://lookup.icann.org/>

- Remedies requested limited to transfer or cancellation [Rules 3(b)(x)]
- Choice of one or three-member(s) [Rules 3(b)(iv) and 6]

- Agreement to waive all claims and remedies against the Provider, Panelists, Registrars, Registry Administrators, ICANN and their staff [Rule 3(b)(xiii)].
- Submission to Mutual Jurisdiction in either the location of the registrar or the location of the registrant [Rule 3(b)(xii)]



## (ii) Substance

- The Complainant's right in the relevant trade mark or service mark(s) and the goods/services on which the mark(s) is used or intended to be used [UDRP 4(a)(i), Rule 3(b)(viii)(ix)(1)(2)(3)].
- Other particulars required under UDRP4(a)(i)(ii)(iii)

- (i) Domain name being identical or confusingly similar to the Complainant's Mark. [for .hk & .香港, Complainant's Mark must be in Hong Kong DNDRP 4(a)(i)]
- (ii) Registrant has no rights or legitimate interests in the domain name.
- (iii) The domain name has been registered and is being used in bad faith.
- (iv) [For DNDRP 4(a)(iv): Individual domain name does not meet the registration requirement for that individual category] [DNDRP 4(c)(d)(v)]

Presumptions in aid to prove bad faith

Anticipate defences under UDRP 4(c)

WIPO trademark database portal

<https://www.wipo.int/amc/en/trademark/output.html> may be useful

Limited to 5,000 words [Rule 3(b)(ix) & WIPO Supplementary Rule 11(a)]

Rule 3(b)(xiv): annexure of documentary or other evidence

- (iii) Identification of other relevant legal proceedings [Rule 3(b)(xi) & 18] [UDRP 4(k)].

## (c) Payment of fees, filing with Provider and Lock of domain

- (i) Complaint is filed by electronic means [Rule 3(b)]
- (ii) Commencement [Rules 2(a) & 4(f)]
- (iii) Domain name will be locked within 2 business days after Registrar received Provider's verification request [UDRP 8(a) and Rules 4(a)(b)].

## 2. The Response

(a) One shot

(b) Form

- no standard form

- model form available at

(<https://www.wipo.int/amc/en/domains/respondent/>)

## (c) Timing

- (i) within 20 days [Rule 5(a)]
- (ii) 4 days automatic extension [Rules 5(b)]
- (iii) extension only in exceptional cases [Rule 5(e)]

## (d) Main Contents

- (i) Procedural and other administrative matters
- (ii) Substance



- Response to statements and allegations made in the Complaint limited to 5,000 words [UDRP 4(a)(b)(c) and Rule 5(c) and WIPO Supplemental Rule 11]
- Documentary or other evidence should be annexed
- Identification of any other relevant proceedings relating to the domain name

## (e) Default of Response

- (i) Panel proceed to a decision based on the Complaint  
[Rule 5(f)]
- (ii) Panel shall draw inferences as it considers appropriate  
[Rule 14(b)]

## C. Decision

1. Basis – wide discretion [Rule 15(a)]
  
2. Default of Response
  - does not automatically result in favourable decision

The Vanguard Group, Inc. v. Lorna Kang [WIPO Case No. 2002-1064]

Berlitz Investment Corp. v. Stefan Tinculescu [WIPO Case No. 2003-0465]

3. Decision within 14 days [Rule 15(b)]
4. Decision by a majority [Rule 15(c)]
5. A reasoned decision is required [Rule 15(d)]

6. No limit to its length [Rule 15(e) & WIPO Supplemental Rule 11(c)]
  
7. Dissenting opinion accompany majority decision [Rule 15(e)]
  
8. Possible Decisions
  - Transfer the domain name to the Complainant
  - Cancel the domain name

- Deny the Complaint
- Declare reverse domain name hijacking [Rule 15(e)]

## 9. Implementation

- Decision to the parties [Rule 16]
- Published
- Registrar will implement decision unless Respondent commences a law suit within 10 days [UDRP 4(k)]



**THANK YOU**