



April 19, 2022

Sub: Comments on the Uniform Domain Name Dispute Resolution Policy Status Report

ALG India Law Offices LLP (“ALG”) submits these comments in response to the invitation for feedback on the Policy Status Report: Uniform Domain Name Dispute Resolution Policy (UDRP) prepared by the Generic Names Supporting Organization.

Our key comments and suggestions, discussed in detail in the enclosed Note, are summarized below –

1. Proving the domain registrant’s bad faith should not be a mandatory requirement for a complaint under the UDRP.
2. Paragraph 4(c)(ii) of the UDRP should be revised to better safeguard the trademark owners’ rights.
3. The procedure pertaining to consolidation of complaints against multiple domain names under the UDRP should be further clarified.

We appreciate the considerable effort that has gone into the Policy Status Report. We thank you for your time and consideration of these comments.

ALG India Law Offices LLP

Through

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NOTE CONTAINING ALG'S COMMENTS AND SUGGESTIONS ON UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY STATUS REPORT

1. Proving the domain registrant's bad faith should not be a mandatory requirement for a complaint under the UDRP.

1.1. *ALG's Observations*

- 1.1.1. Paragraph 4.a. of the Uniform Domain Name Dispute Resolution Policy (UDRP), which defines the "Applicable Disputes" under the Policy, lists three elements, each of which needs to be mandatorily proved by the Complainant. The first element, listed under Paragraph 4(a)(i) of the Policy, is that the domain name "*is identical or confusingly similar to a trademark or service mark in which the complainant has rights*". Another essential element, listed under Paragraph 4(a)(iii), is that the domain name "*has been registered and is being used in bad faith*".
- 1.1.2. Accordingly, the Policy mandates that a complaint must be based on the complainant's trademark rights, but also requires the complainant to prove bad faith on the part of the domain registrant. The requirement to prove bad faith is inconsistent with the internationally established principles of trademark law, as per which bad faith is not a requirement for the offences of trademark infringement and passing off. Requiring trademark owners to prove bad faith as an additional element is likely to prejudice their legitimate trademark rights, particularly in cases where the domain name is found to be confusingly similar but evidence of bad faith is not available. In view of the above, proving bad faith should not be a mandatory requirement for a UDRP complaint.
- 1.1.3. Further, as per Paragraph 4(a)(iii), the complainant needs to prove that both the registration as well as use of the domain name are in bad faith. This dual requirement places an unfairly high burden upon the complainant.

1.2. *ALG's Recommendations*

- 1.2.1. Bad Faith should be removed as a mandatory requirement for UDRP complaints, and Paragraph 4(a)(iii) should accordingly be deleted.
- 1.2.2. The below should be inserted as a separate paragraph to provide for bad faith to be taken into consideration by the Administrative Panel –

"In the administrative proceeding, the Panel shall take into consideration the bad faith, if any, in registration or use of your domain name, if sufficiently proved by the complainant".

The above insertion also provides for consideration of bad faith in “*registration or use*” of the domain name, and should accordingly address the issue of the complainant having to prove bad faith in both registration and use.

2. Paragraph 4(c)(ii) of the UDRP should be revised to better safeguard the trademark owners’ rights

2.1. ALG’s Observations

2.1.1. Paragraph 4(c) of the UDRP lists circumstances which demonstrate the domain registrant’s rights to and legitimate interests in a domain name. One of the circumstances, listed in Paragraph 4(c)(ii), is that the domain registrant has been “*commonly known by the domain name*” even if the domain registrant has “*acquired no trademark or service mark rights*”.

2.1.2. Paragraph 4(c)(ii) provides an overly broad and unqualified criterion for the domain registrant to demonstrate its rights in the domain name. It enables domain registrants to demonstrate their rights simply on the basis that they are “*commonly known by the domain name*”, without factoring in whether such domain name or its use are causing trademark infringement, passing off, customer confusion, dilution or tarnishment of a third-party trademark. This leaves open the scope of prejudicing the rights of trademark owners.

2.2. ALG’s Recommendation

2.2.1. Paragraph 4(c)(ii) should be revised and further clarified to safeguard the interests of trademark owners. The language underlined below is proposed to be inserted –

“you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights, provided that your domain and its use do not cause any consumer confusion or tarnishment of the trademark or service mark at issue”

3. The procedure pertaining to consolidation of complaints against multiple domain names under the UDRP should be further clarified

3.1. ALG’s Observations

3.1.1. Paragraph 4(f) of the UDRP deals with consolidation of multiple domains in a single complaint. It provides that “*In the event of multiple disputes between you and a complainant, either you or the complainant may petition to consolidate the disputes before a single Administrative Panel...This Administrative Panel may consolidate before it any or all such disputes in its sole discretion, provided that the disputes being*

consolidated are governed by this Policy or a later version of this Policy adopted by ICANN.”

- 3.1.2. Different domain name dispute resolution providers under the UDRP have different rules for consolidation, making it a complicated procedure. The UDRP requires further clarifications in respect of various aspects of consolidation, including - the recourse available to a complainant in case of rejection of its consolidation request; the complainant’s rights to file a fresh complaint against domains whose consolidation has been rejected; whether such fresh proceedings should qualify as ‘pending’ proceedings under Paragraph 8(a) of UDRP; and refund of fee to the complainant in case of rejection of consolidation. These clarifications are especially important in consideration of the fact that UDRP is meant to be a cost-effective dispute resolution mechanism.

3.2. *ALG’s Recommendations*

- 3.2.1. The UDRP should be amended to clarify the following aspects regarding consolidation

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- i. In case the request for consolidation of complaints is rejected, the complainant should be provided an opportunity to file fresh complaints against the relevant domain names.
 - ii. A strict time limit of 30 days should be imposed on the complainants for filing fresh complaints, so that domain name registrants’ rights are not prejudiced.
 - iii. Fresh complaints should qualify as ‘pending’ proceedings under the UDRP, so that the complainant’s rights are not prejudiced.
 - iv. Further, there should be a refund of fee to the complainant after rejection of the request for consolidation, so that proceedings under the UDRP are economical.
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