

ADNDRC Decision Drafting Guidelines for UDRP Proceedings



ADNDRC

PREPARED BY

ADNDRC Standards and Practice Committee

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I. Introduction

a. Reason for the guidelines

The Uniform Dispute Resolution Policy (“**UDRP**”) sets out a unique roadmap for an efficient dispute resolution proceeding in which a final administrative panel decision (“**decision**”) is produced by a panel comprising one or three panelists (“**panel**”). The decision is enforceable by the domain name registrar and can result in the transfer or cancellation of the disputed domain name. This makes UDRP a powerful tool for trademark right owners. The role of a panelist in producing a persuasive high-quality decision is crucial to the effectiveness of the proceeding.

These guidelines aim to provide practical advice to panelists to render effective decisions. These guidelines are intended to be used as guidance only and do not replace any applicable laws, policies, or rules. The guidelines are also not intended to replace a thorough review of submissions and full consideration of the issues specific to each proceeding.

b. Intended reader

These guidelines have been prepared for those who are drafting decisions for the first time or have drafted a limited number of decisions to date. The guidelines may also be useful for those who have had substantial periods of time pass between drafting decisions and for those who wish to refresh their knowledge of decision drafting.

II. Role of ADNDRC

From the perspective of case management, the ADNDRC serves as the guardian of the UDRP, the Rules for UDRP (“**UDRP Rules**”) and the ADNDRC Supplemental Rules to the UDRP (“**Supplemental Rules**”). Its duties are carried out by one of its four offices throughout each case.

The ADNDRC facilitates the verification of the registrant’s information with the registrars; and appoints independent and impartial panelists. It takes steps to ensure the standard and level of decisions and oversees the enforcement of decisions.

III. Formality of decision

a. Structure

Panelists are recommended to use the decision template provided by the ADNDRC for drafting a decision.

Panelists should follow the six-part structure, as can be found in the decision template.

1. The first part – **The parties and contested domain name(s)**
 - details of the parties such as name, address, and authorized representatives (where available and disclosure permitted)
 - domain name(s) at issue
 - details of the concerned registrar
2. The second part – **Procedural history**
 - a chronological description of the history of the proceeding
3. The third part – **Factual background (optional)**

- a brief summary of the parties such as incorporation of the companies involved in the dispute
- a brief summary of the trademarks at issue and their respective registration dates (if provided by the parties)

Please note, the panel may incorporate this part in the section entitled “Findings of the decision” instead of in a separate section under “Factual background” if considered necessary and desirable.

4. The fourth part – **Parties’ contentions**
 - a summary of the contentions of the complainant and the respondent
5. The fifth part – **Findings**
 - set out the applicable jurisdiction of the ADNDRC and verify whether the complaint is filed pursuant to the UDRP
 - address any preliminary issues followed by an analysis of each criterion in the UDRP
6. The sixth part – **Decision**
 - the panel’s decision
 - the signature of the panelist and the date of decision

b. Format

The decision shall be produced such that it is ready for printing in letter quality.

For a decision delivered in English, the main text shall be made in the Arial or Times New Roman font style and in 12-point font size. One line spacing shall be adopted between paragraphs.

Headings shall be made in Boldface for emphasis and may be in uppercase letters.

Footnotes and citations in the decision shall be made in the Arial or Times New Roman font style and in 10-point font size.

Legal citations (precedent cases) may be italicised.

The suggested citation format shall be “case ID <domain name>” in italic, e.g. *AIAC/ADNDRC-584-2018 < bawah.com>*, *CN -1100475 <microsoftword2011.com & others>*, *HK-2101573 <bitmain.forsale>*, and *KR-2100233 <korean-airline.com>*.

c. Language

A decision should be drafted cogently. The panel’s order and reasoning should be clear and unequivocal to the parties. The panel’s reasoning should be set out in the decision in a deliberate and thoughtful manner for the parties’ benefit. The panel should ensure the consistent use of abbreviations and/or terminology throughout the decision.

IV. Content of the decision

a. Parties and contested domain names

In the first part of a decision, the available details of the parties, authorized representatives of the parties, the contested domain name(s) and the registrar must be reproduced in their entirety.

These details can be found in sections 1 and 3 of the complaint form. If there is a request to redact a party's name or particulars from the decision, the panel shall exercise its discretion when considering the request.

b. Procedural history

The second part of a decision should contain the procedural history of the case. The procedural history should include but not be limited to the following:

- a) the date the complaint was filed
- b) the Policy, Rules and Supplemental Rules applicable to the complaint
- c) the date of the ADNDRC's email to the registrar requesting confirmation of the WHOIS record and other related information
- d) the date the ADNDRC receives a reply from the registrar, containing the registration details, the language of the registration agreement as well as other relevant information
- e) the date of commencement of the proceeding (i.e., the date the complaint is transmitted to the respondent) and the deadline for the respondent to file a response
- f) the date of receipt of the respondent's response or the date the ADNDRC notifies the parties that the respondent is in default
- g) the date of appointment of the panel and the submission of a statement of acceptance and declaration of impartiality and independence

In the event the panel is unsure of any of the dates or information pertaining to the procedural history, it is advisable for the panel to contact the ADNDRC case manager.

c. Factual background (Optional)

The next part of a decision is a summary of the factual background of the dispute (i.e., an explanation of the facts as provided by the complainant in paragraph 8 of the complaint form and paragraph 7 of the response form (if submitted)).

There is no need for the panel to reproduce the factual explanations in their entirety. However, it is advisable to reproduce the salient background of facts that the panel considers relevant in making its decision.

At this stage, there is no need for the panel to address any inconsistencies between the complainant and the respondent's allegations.

Please note, the panel may incorporate this part in the section entitled "Findings of the decision" instead of in a separate section under "Factual background" if considered necessary and desirable.

d. Parties' contentions

In this part of a decision, the panel should summarise the parties' contentions, which are essentially the legal grounds provided in section 8 of the complaint form and section 7 of the response form (if submitted).

Panels are encouraged to provide a concise summary instead of a verbatim report of the parties' contentions and include the remedies sought by the parties.

i. Complainant

The legal contentions will be based on the elements required under the UDRP, specifically, paragraphs 4(a), (b) and (c) of the UDRP. The panel may reproduce the complainant's contentions in respect of the elements listed under paragraph 4(a), which provides as follows:

- a) that the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights;
- b) that the respondent has no rights or legitimate interests in respect of the domain name; and
- c) that the domain name has been registered and is being used in bad faith.

ii. Respondent

Apart from responses to the complainant's contentions, the respondent's contentions may also be based on paragraph 4(c) of the UDRP, which provides as follows:

- a) That the respondent's use of, or demonstrable preparation to use the domain name or a name corresponding to the domain name is in connection with a bona fide offering of goods or services; or
- b) that the respondent has been commonly known by the domain name, even if the respondent has not acquired a trademark or service mark rights; or
- c) that the respondent is making a legitimate non-commercial 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.

If the respondent has not submitted a response to the complaint, it is advisable for the panel to state the same in this section. The panel should confirm that the respondent's failure and/or neglect to file a response to the complaint and the complainant's contentions does not automatically result in a decision in favour of the complainant.

e. Findings

This part of a decision contains the panel's discussion and findings in respect of the elements listed in paragraph 4(a), (b) and (c) of the UDRP.

i. Preliminary

Before delving into the substantive issues, the panel should first address any preliminary issues that exist. Preliminary findings are the issues that are addressed prior to the examination of the substantive issues. Some common preliminary issues are:

(a) Request to change the language of proceeding

When exercising its authority with respect to a request to change the language of proceeding, the panelist should make the decision in the spirit of fairness and justice to both parties, while considering the time and cost involved.

Examples of the factors that the panel can consider include: (i) the parties' understanding of the subject languages, (ii) evidence of the parties' real location which might relate to the language used locally, and (iii) the language(s) of the correspondence and communications between the parties and the ADNDRC.

A panel might take one of a number of approaches as follows:

- Accept the request to change the language of the proceeding
 - Reject the request to change the language of proceeding, while ordering documents submitted in languages other than the language of the proceeding to be accompanied by a translation in whole or in part into the language of the proceeding
- Reject the request to change the language of the proceeding, while not ordering any additional translations of documents. This is only feasible when the panelist is proficient in both the language of the proceeding and the language of documents submitted by the party making such request

(b) Unsolicited submission of additional materials

Most commonly, the panel faces two questions in this regard:

- (i) whether the additional materials are necessary; and
- (ii) whether it would cause prejudice to one party by accepting the other party's unsolicited submission of additional materials.

If the answer to the first question is yes while the answer to the second question is no, then the panelist should issue an administrative order to give the other party an opportunity to comment on the additional submission.

The panel should address this matter at relevant time in the proceeding when it is first made aware of the unsolicited submission of the additional materials.

(c) Petition of consolidation of complaints

Where a party requests two or more complaints to be consolidated into a single proceeding, the panel should consider issues including (but not limited to) the evidence regarding the respondent's identity, the parties' comments on this issue, the benefits of consolidation before deciding whether to approve a request.

ii. Substantive

Paragraph 4(a) of the UDRP provides that each of the following three findings must be made in order for a complaint to prevail:

- i. the respondent's domain name is identical or confusingly similar to a trademark or service mark in which complainant has rights; and
- ii. the respondent has no rights or legitimate interests in respect of the domain name; and
- iii. the respondent's domain name has been registered and is being used in bad faith.

In elaborating its findings, the panel can be guided by paragraph 10(c) of the UDRP Rules, which provides that the panel shall determine the admissibility, relevance, materiality and weight of the evidence.

Further, paragraph 12 of the UDRP Rules provides that, as and when necessary, the panel has the discretion to request further statements or documents from either of the parties (in addition to the complaint and the response).

In general, the applicable standard of proof in UDRP cases is the "balance of probabilities" or "preponderance of the evidence", where a party should demonstrate to a panel's satisfaction that it is more likely than not that a claimed fact is true.

In dealing with statements or allegations unsupported by evidence that will otherwise be insufficient to prove a party's case, the panel must be prepared to draw certain inferences in light of the particular facts and circumstances of the case.

As a complainant must successfully prove all three elements to succeed, in appropriate cases where a panel finds that one of the elements is clearly not met, the panel may consider it unnecessary to address the other elements.

(a) Identical / Confusingly similar

To satisfy paragraph 4(a)(i) of the UDRP, that the respondent's domain name is identical or confusingly similar to a trademark or service mark in which complainant has rights, the complainant needs to prove its rights in mark(s), such as the trademark or service mark.

Through examining the use and acquisition of the relevant trademark, service mark, or unregistered mark put forward by the complainant, the panel should determine whether the complainant has established the necessary rights to meet the first requirement under paragraph 4(a)(i) of the UDRP.

In relation to the domain level at issue, which is the second level in most of cases, the panel should distinguish the constituting elements of the disputed domain name. The panel should ascertain the presence of the complainant's mark(s) by comparing the elements with the relevant mark(s) that the panel finds the complainant has rights in.

The panel can consider a number of factors when conducting the threshold test including but not limited to the following:

- Abbreviation of mark or transliteration
- Addition of geographical identifiers
- Addition of suggestive or generic terms
- Combination of two or more marks
- Misspelling or typo-squatting
- Phonetic similarity
- Translation or transliteration

The panel should also address the rebuttal of the complainant's contentions made by the respondent, if any, and conclude whether the complainant has satisfied paragraph 4(a)(i) of the UDRP.

(b) Rights and legitimate interests

Under the second element provided in paragraph 4(a)(ii) of the UDRP, the panel must discuss and determine whether the respondent does in fact have no rights or legitimate interests in respect of the disputed domain name.

Pursuant to paragraph 4(c) of the UDRP, the respondent may establish rights or legitimate interests in the disputed domain name by demonstrating any of the following:

- (1) before any notice of the dispute to the respondent, the respondent's use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name was in connection with a bona fide offering of goods or services; or
- (2) the respondent has been commonly known by the disputed domain name, even if the respondent has acquired no trademark or service mark rights; or
- (3) the respondent is making legitimate non-commercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The complainant shall be deemed to have satisfied paragraph 4(a)(ii) of the UDRP where the respondent fails to rebut the complainant's assertions and evidence, or in cases where the respondent is in default, the panel is unable to draw from available evidence any reasonable inferences that the respondent has rights or legitimate interests in the disputed domain name.

(c) Bad faith

Under the third element provided in paragraph 4(a)(iii) of the UDRP, the panel must discuss and determine whether the respondent's domain name has been registered and is being used in bad faith.

Pursuant to paragraph 4(b) of the UDRP, the panel should take into consideration four circumstances in determining whether the respondent has registered and used the disputed domain name in bad faith.

It is worthwhile noting that both the registration and use of the disputed domain name should be examined by the panel.

If found by the panel to be present, the following circumstances, in particular but not limited to, shall be evidence of the registration and use of the disputed name in bad faith:

- (1) the respondent has registered, or the respondent has acquired the disputed 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 the complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the disputed domain name; or
- (2) the respondent has registered the disputed 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 the respondent has engaged in a pattern of such conduct; or
- (3) the respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or
- (4) by using the disputed domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to the respondent's website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on the respondent's website or location.

In addition to the circumstances listed in paragraph 4(b) of the UDRP, the following scenarios have been observed in past ADNDRC cases:

- Fraudulent transfer of the domain name
- Misuse of the domain name system which includes activities such as DDoS attack, phishing, and spreading of malware
- Passive holding or inactive website

The panel should specify which circumstance listed in paragraph 4(b) of the UDRP is present based on its findings. The panel should conclude whether the complainant has satisfied paragraph 4(a)(iii) of the Policy.

(d) Reverse domain name hijacking

This part should be included if the respondent provides in the response that the complaint was brought in bad faith and in an attempt at reverse domain name hijacking. The panel should examine the relevant contentions from the respondent and declare in its decision whether such claim is valid and accepted by it.

(e) Decision

This is the final and perhaps the most important part of the decision.

Paragraph 4(i) of the UDRP provides that the remedies available to a complainant shall be limited to:

- a. requiring the cancellation of the domain name; or
- b. the transfer of the domain name registration to the complainant.

If the panel finds that the complainant has not met its burden to establish all elements under paragraph 4(a) of the UDRP, the complaint should be denied.

The decision should be clearly indicated. The panelist(s) signature should follow accompanied with the date of the decision.

For cases that result in a transfer of the disputed domain name and involve multiple complainants, the panel shall specify which complainant the disputed domain name will be transferred to.

Also, it is advisable for the panel to specify the relevant paragraphs and articles in the UDRP and the Rules that the panel's decision is based on.

For cases handled by a three-member panel, any dissenting opinions may accompany the majority decision.

V. Practical considerations

a. Style & length

Panelists are encouraged to quote ADNDRC cases as references in its decision.

The length of each decision may vary on a case-by-case basis. Panelists should ensure sufficient analysis and legal reasoning is included in support of their findings in respect of each of the three elements of the UDRP in its decision.

b. Timing

Panelists should issue their decisions within the time limit prescribed (i.e., within 14 calendar days from the date of their appointment). Panelists may issue their decisions prior to the deadline, especially in cases where a party requests for the decision to be issued urgently. Panelists may issue a procedural order to set out a new timetable for the case if needed. When there is a need to do so, the panel should observe the rules of natural justice and consider the inherently fast-track nature of the UDRP.

c. Three-member panel

The presiding panelist is usually responsible for organizing the panel's discussion and preparing the draft decision. Any dissenting opinions may be included in the decision and signed accordingly by the relevant panel member.

d. Notifying the respondent of complaint by the provider

ADNDRC recommends that the panel review and confirm whether ADNDRC has discharged its responsibility to employ reasonably available means to achieve actual notice of a complaint to the respondent according to paragraph 2(a) of the UDRP Rules.

e. Re-filed complaint (Res Judicata)

Panelists shall rule on the issues of Res Judicata according to applicable laws and rules for re-filed complaints.

f. Settlement

If the parties have entered into a settlement agreement, the panel may terminate the proceeding according to paragraph 17(b) of the UDRP Rules.

If one party refuses the other party's settlement offer and insists on a decision, the panel shall proceed to render the decision. For example, if the respondent offers to transfer the disputed domain name to the complainant (even free of charge) but the complainant refuses to accept the offer, the panel should proceed to decide the dispute.

g. Proofreading

The panel shall proofread the decision before submitting it to the ADNDRC.

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