

## A RESPONSE TO INTA'S "REBUTTAL" OF FAIR.COM

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I wish to thank Professor Michael Fromkin for the invitation to respond to the International Trademark Association's recent paper, *The UDRP By All Accounts Works Effectively – Rebuttal to Analysis and Conclusions of Professor Michael Geist*,<sup>1</sup> that claims to rebut the findings of my ICANN UDRP studies -- *Fair.com?: An Examination of the Allegations of Systemic Unfairness in the ICANN UDRP*<sup>2</sup> and its brief update, *Fundamentally Fair.com? An Update on Bias Allegations and the ICANN UDRP*.<sup>3</sup> The UDRP raises important issues and generating further discussion about it is unquestionably beneficial.

After a review of the INTA response, I felt that it would be useful to provide further background for those who are new to the issue. In particular, I provide further context on several INTA claims that may leave readers with a mistaken impression of my study along with my perspective on case allocation, provider bias, three member panels, and forum shopping.

### **Context on INTA Claims**

The INTA response includes several claims that may leave readers with a mistaken impression of my study. These include:

- The response claims that I suggest that complainants should not win more than 50% of the time in order for a dispute resolution system to be fair.<sup>4</sup> I do no such thing. The Update does note that all WIPO panelists with five or more single panel cases have ruled in favor of complainants at least 50% of the time,<sup>5</sup> but nowhere do I say or infer that 50% is a benchmark for fairness.
- The response claims that I fail to sufficiently consider the effect of default cases on the complainants' winning percentage.<sup>6</sup> This too is incorrect as the response later acknowledges that the February 2002 Update accounted for all default cases.<sup>7</sup>

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<sup>1</sup> INTA Internet Committee, *The UDRP By All Accounts Works Effectively – Rebuttal to Analysis and Conclusions of Professor Michael Geist*, online at [http://www.inta.org/downloads/tap\\_udrp\\_2paper2002.pdf](http://www.inta.org/downloads/tap_udrp_2paper2002.pdf) (hereinafter "INTA").

<sup>2</sup> Michael Geist, *Fair.com? An Examination of the Allegations of Systemic Unfairness in the ICANN UDRP*, online at <<http://aix1.uottawa.ca/~geist/geistudrp.pdf>> (hereinafter "Fair.com").

<sup>3</sup> Michael Geist, *Fundamentally Fair.com? An Update on Bias Allegations and the ICANN UDRP*, online at <http://aix1.uottawa.ca/~geist/fairupdate.pdf>> (hereinafter "Update").

<sup>4</sup> INTA, *supra*, note 1 at 2.

<sup>5</sup> Fair.com, *supra*, note 2 at 26.

<sup>6</sup> INTA, *supra*, note 1 at 2.

<sup>7</sup> *Ibid.* at 5.

- The response notes that I focus almost exclusively on complainant win percentages for three of five ICANN accredited UDRP providers, inferring that I may have used a select group of decisions.<sup>8</sup> In fact, my sample covers 99.3% of all ICANN UDRP decisions released as of February 18, 2002.<sup>9</sup>
- The response claims that I make “bald assertions that there have been a ‘plethora of inconsistent and clearly incorrect decisions’” but provide no footnote or other supporting reference.<sup>10</sup> This too is incorrect as footnotes 84, 85, 86 of Fair.com provide support for these statements.<sup>11</sup>
- The response claims that I could “only come up with three or four cases where there is believed to be an incorrect or inconsistent decision.”<sup>12</sup> While it is true that the study only lists a small sample of cases, as INTA itself acknowledges, the study did not seek to review the merits of each case.<sup>13</sup> The three or four cases were clearly meant to be illustrative, not exhaustive.
- The response claims that I “touted inflated complainant winning percentages” in order to support my allegations of bias against respondents.<sup>14</sup> This is absolutely incorrect. INTA has provided no support for any claims that any data was inflated. In fact, not only was all data presented as collected, but I have taken the unusual step of posting all data to the Internet for anyone to review.<sup>15</sup>
- The response claims that my conclusion that three-member panels are fairer than single-member panels is based on an incorrect inference that one-member panels are biased.<sup>16</sup> I believe this mischaracterizes my findings. Nowhere in the study do I argue that single member panels are biased. In the case of three-member panels, I argue that they provide a fairer approach since they “would remove most provider influence over panelist selection and ensure better quality decisions by forcing panelists to justify their reasoning to their colleagues on the panel.”<sup>17</sup>

## Case Allocation

In addition to potentially leaving readers with a mistaken impression of my studies’ findings, the INTA response fails to fully appreciate several of its conclusions. For example, the response claims that I find it “inappropriate that panelist selection is not random and that all panelists are not sharing the caseload equally.”<sup>18</sup> I do indeed express concern that the caseload allocation is not random since, as noted in Fair.com, the providers claim that it is. However, nowhere in either study do I advocate an equal allocation of cases. Rather, I note the discrepancy between the caseloads at the National

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<sup>8</sup> Ibid. at 1.

<sup>9</sup> Update, *supra*, note 3 at 5.

<sup>10</sup> Ibid. at 3.

<sup>11</sup> Fair.com, *supra*, note 2 at 20-21.

<sup>12</sup> Ibid. at 4.

<sup>13</sup> Ibid. at 3.

<sup>14</sup> Ibid. at 5.

<sup>15</sup> <http://www.udrpinfo.com>.

<sup>16</sup> INTA, *supra*, note 1 at 5.

<sup>17</sup> Fair.com, *supra*, note 2 at 28.

<sup>18</sup> INTA, *supra*, note 1 at 6.

Arbitration Forum, at which 56.4% of single panel cases have been decided by just six panelists,<sup>19</sup> and at the other providers (17.2% of WIPO single panel cases decided by its six busiest panelists)<sup>20</sup> and express concern about this data.

### **Provider Bias vs. Panelist Bias**

The INTA response also fails to distinguish between provider bias and panelist bias. The response expresses particular concern that I reference specific panelists and claims that I suggest that these panelists are biased toward trademark holders.<sup>21</sup> This is simply untrue. I do not make any claims that individual panelists are biased. Rather, I believe that there are two types of panelists. The first type, perceived to be pro-respondent, adopts a strict interpretation of the UDRP. This panelist requires complainants to prove each element of their case according to the precise wording of the rules, otherwise the respondent keeps their domain name. The second type, perceived to be pro-complainant, takes a more liberal, interpretative approach to the UDRP. This panelist looks to the spirit of the rules in occasionally finding for complainants even though each element of the UDRP requirements may not be met.

A good example of this difference in approach comes with the requirement that the complainant prove that the respondent registered and used the domain name in bad faith. Bad faith registration is often easy to prove – registering a domain name that is identical to a trademark will usually do it. Bad faith use is more difficult to prove, however. If the registrant just sits on the domain and does nothing, is that bad faith use? Those who adopt a strict interpretation of the UDRP say no; those who adopt a more interpretative approach argue that “non-use” can constitute use.

The problem with bias in the UDRP rests not with these differing views. The problem lies instead with knowing how a panelist is likely to interpret the UDRP and thus how they are likely to rule on a particular case. If providers assign panelists to cases in a non-random manner based on that information, the issue of bias is very real indeed.

### **Three Member Panels**

As noted above, the INTA response leaves a mistaken impression on my reasoning for advocating a mandatory three-member panel approach. INTA also posits that three-member panel data can be explained by reference to substantively stronger respondent cases. Under this line of thinking, respondents win more three-member panel cases because they have a stronger defense and thus are willing to incur the expense associated with three-member panels.<sup>22</sup>

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<sup>19</sup> Update, *supra*, note 3 at 5.

<sup>20</sup> Fair.com, *supra*, note 2 at 24.

<sup>21</sup> INTA, *supra*, note 1 at 6.

<sup>22</sup> *Ibid.*

The INTA explanation is rather puzzling since I directly addressed it in Fair.com.<sup>23</sup> I noted that contrary to expectations, complainants actually request three-member panels more frequently than do respondents. Given that complainants are responsible for the majority of three-member panel cases, respondent strength of case is surely not a viable explanation.<sup>24</sup>

## Forum Shopping

The INTA response raises the possibility that forum shopping may be explained by factors other than bias in the system, such as quality and reputation of panelists, familiarity with dispute resolution provider, quality, cost, and timeliness of decisions.<sup>25</sup> This discussion is surprising since I do not claim that forum shopping exists because the system is biased, but rather because complainants, who are provided with the right to select the provider, rationally select the provider that is most likely to result in a positive outcome from their perspective.<sup>26</sup>

In fact, it is important to note that my charges of bias do not arise from the finding of forum shopping at all. Rather, the study examines the case allocation practices of the three largest providers to determine whether their practices might influence case outcome and thus encourage forum shopping. I believed that if there were irregularities in case allocation that might indicate a bias in the system.

Moreover, even INTA's alternative explanations for forum shopping ring hollow. As Fair.com notes, price competition is rather limited under the ICANN UDRP, particularly when legal costs associated with a UDRP action are factored into the equation.<sup>27</sup> Furthermore, with a growing number of panelists cross-listed with multiple providers, it is difficult to distinguish between provider panelist rosters leaving many providers with panels of equal reputation and quality.<sup>28</sup>

One possible alternative that INTA chooses to ignore is the marketing techniques of the respective providers. As Fair.com notes, at least one provider regularly issued press releases touting complainant wins with headlines such as "Arbitrator Delivers Internet Order for Fingerhut" or "May the Registrant of magiceightball.com Keep the Domain...Not Likely."<sup>29</sup> Perhaps it was that marketing campaign, which was subsequently abandoned following the release of Fair.com, that persuaded complainants to choose one provider over another.

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<sup>23</sup> Fair.com, *supra*, note 2 at 19-20.

<sup>24</sup> *Ibid.*

<sup>25</sup> INTA, *supra*, note 1 at 2.

<sup>26</sup> Fair.com, *supra*, note 1 at 6.

<sup>27</sup> *Ibid.* at 4.

<sup>28</sup> *Ibid.*

<sup>29</sup> *Ibid.* at 4 –5 .

## Conclusion

The INTA response claims that its review of the UDRP indicates the process works efficiently and is essentially fair to both complainants and respondents.<sup>30</sup> It later argues that the merits of individual cases must be examined in order to determine fairness.<sup>31</sup> To my knowledge, INTA has not released any study that examines the merits of individual cases. To continue a meaningful and useful analysis of the UDRP, I hope that INTA might publicly disclose that information to better support its conclusions.

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<sup>30</sup> INTA, *supra*, note 1, at 1.

<sup>31</sup> *Ibid.* at 3.