

*A MISAPPLICATION OF FREE SPEECH RIGHTS IN THE ICANN'S UNIFORM
DISPUTE RESOLUTION POLICY*

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ABSTRACT: The purpose of this study is to gain a better understanding of how the application of the UDRP, a mechanism for resolving disputes between domain name registrants and trademark owners, has become an instrument to restrict freedom of expression over the Internet.

Key words: freedom of speech, UDRP, the ICANN.

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1. INTRODUCTION

Contemporary debates on the Internet are framed in the economic, political and social context, which highlights three areas of preference: national security, freedom of expression and the protection of industrial property rights. Lately, these controversies have focused on the importance of free expression online, as well as the risks of censorship and surveillance by governments, leaving citizens defenseless.¹

While these discussions are important, instead of normatively evaluating the different Internet policies enacted by the States, this paper addresses the issue of the sudden increase in threats to freedom of expression from a different perspective, establishing the link between trademarks and freedom of expression.

Prima facie it would seem that there is no direct relationship between industrial property and freedom of expression that can have profound consequences, since brands have traditionally played a more commercial than social role.

As is common knowledge, a trademark owner has *ius excludendi omnes alios*, having the exclusive, although limited, rights to use its brand, as well as the right to prevent others from using it. The purpose of industrial property is the protection of the product, service, commercial or industrial establishment specifically protected by the trademark registration and for similar or related products or services. Although the historical origin of the trademark law implied the protection of producers from illegitimate deviations of their trade by competitors, the subsequent development has also led to consumer protection and fair market competition.² Contemporary doctrine recognizes that the purpose of industrial property is to avoid confusion among consumers regarding the origin of certain products or services by providing reliable indicators of the sources of products and services in the market.³ Likewise, it has been pointed out that trademark law must protect the producers of those products and services from the misappropriation of the goodwill of a trademark, thus allowing companies to benefit from a well-earned quality reputation.⁴ In general, modern doctrine emphasizes that these goals must work in harmony.⁵

Therefore, the trademarks have a significant importance for society since they allow safeguarding the scope of production of a company and fair market competition. Likewise, its economic function helps to reduce the consumer search costs and helps maintain a competitive market without major distortions.⁶

On the other hand, the right to free expression is a fundamental right of every individual. The Universal Declaration of Human Rights states that “Everyone has the right to freedom of opinion and expression; this right includes freedom to hold opinions without interference and to seek, receive and impart information and ideas through any media and regardless of frontiers..”⁷ International treaties adopted subsequent to the Universal Declaration also consecrate the right to freedom of thought and expression. The International Covenant on Civil and Political Rights in article 19 states that “everyone shall have the right to hold opinions without interference.” Also, keep in mind that, apart from

¹ POWERS AND JABLONSKI (2015).

² MCKENNA (2007).

³ MCCARTHY (1996).

⁴ JOHNSON (2012) p.626.

⁵ BONE (2006).

⁶ DINWOODIE AND JANIS (2008).

⁷ UNIVERSAL DECLARATION OF HUMAN RIGHTS (1948), Art. 19.

participation in the universal human rights treaty system of the United Nations, States are also part of the regional human rights systems, which can increase the level of protection for people under their jurisdiction.

It seems pertinent to highlight three functions of the right to freedom of expression that allow us to highlight its impact on a democratic society. First, the individual and collective dimension of this right should be noted. The individual aspect protects each person to think for themselves and autonomously express their own thinking, while the collective dimension implies the right “to receive any information and to know the expression of the thoughts of others” in a group.⁸ Secondly, the jurisprudence emphasizes the instrumental dimension of this right, since it serves as a guarantee of the full enjoyment and exercise of other fundamental rights.⁹ Finally, freedom of expression is imposed as a *conditio sine qua non* to guarantee the functioning and preservation of the democratic regime.¹⁰

It should be noted that before being an attribute protected by national legal systems, freedom of expression is also an ethical category that must be taken into account. As such, this fundamental right is clearly subject to the limitations and exceptions fostered by religious, cultural, historical, and political concepts, among others. For this reason, although it is a universal right, the contents and limits of this right vary in this order from one State to another.

Implicitly, we can understand that the full implementation of the provisions of the Universal Declaration of Human Rights is only possible on the Internet since only this platform makes it possible to disseminate opinions without an intermediary, regardless of state borders and the possible restrictions that these imply. Its development can benefit the exercise of fundamental rights, participatory and democratic processes, as well as social and commercial activities. In the same way, “as the Internet is becoming ever more essential for individuals' everyday activities, the technological architecture and design choices embedded in them have ever greater consequences for human rights and shared values.”¹¹

As will be explained below, internet governance lacks an agency or regime established by a global treaty. Instead, management is carried out by private sector technical agencies that are simply dedicated to keeping the system running. The governance of these technical bodies is conceived as a process of decision-making driven by multiple actors, such as governments, engineers, companies, and civil society. Bearing this in mind, until recently, no international body had ruled to establish the requirements that should be demanded with respect to freedom of expression on the Internet. A first step in this direction represents the resolution of the Human Rights Council of the United Nations,

⁸ THE COMPULSORY ASSOCIATION OF JOURNALISTS (articles 13 and 29 of the American Convention on Human Rights), Advisory Opinion OC-5/85, November 13, 1985, Series A, N° 5, para.31).

⁹ CLAUDE REYES AND OTHERS VS. CHILE, (FUND, REPARATIONS AND COSTS). Inter-American Court of Human Rights. Judgment of September 19, 2006, Series C No. 151, para. 75.

¹⁰ ADVISORY OPINION THE COMPULSORY ASSOCIATION OF JOURNALISTS (articles 13 and 29 of the American Convention on Human Rights), supra note 8, para. 70; I / A Court HR, CASE OF CLAUDE REYES ET AL., Supra note 9, para. 85; USÓN RAMÍREZ VS. VENEZUELA, (PRELIMINARY OBJECTION, FUND, REPARATIONS AND COSTS). C Inter-American Court of Human Rights. Judgment of November 20, 2009, Series C No. 207, para 47; RICARDO CANESE V. PARAGUAY. FUND, REPARATIONS AND COSTS. Inter-American Court of Human Rights. Judgment of August 31, 2004. Series C No. 111, para. 87

¹¹ ZALNIERIUTE AND SCHNEIDER (2014) p. 5.

which states that “the same rights that people have offline must also be protected online, in particular freedom of expression, which is applicable regardless of frontiers and through any media of one’s choice, in accordance with articles 19 of the Universal Declaration of Human Rights and the International Covenant on Civil and Political Rights.” This document recognizes the global and open nature of the Internet and encourages States to promote and facilitate access to the Internet and international cooperation.¹²

The European Court of Human Rights has recognized that the set of general guarantees dedicated to freedom of expression constitutes an adequate basis to also recognize these guarantees in terms of freedom of expression without hindrance by the Internet. In this order of ideas, it has been highlighted that “the internet is currently the main means of people to exercise their right to freedom of expression and information: it offers essential tools for participation in activities and debates related to political issues or of public interest.”¹³

Undoubtedly, the emergence of the internet has led to a convergence in the formation of a new regulatory context: the resolution of conflicts over Internet domain names. This, given that, in recent years, industrial property has been disrupted by the development of new technologies and the use of trademarks through the Internet. The use of widely used means of communication has enabled opportunities to damage trademarks, facilitating the dissemination of misleading information in a way that may lead to confusion regarding the brand owner's affiliation, or through the external commercialization of products and services protected by a brand, which is known as *cybersquatting*.

It is important to understand that, in general terms, a domain name represents the address of the network that owns a web page, customizing the existence online. It should be noted that through the intervention of the US government, the Internet Corporation for Assigned Names and Numbers (ICANN), a non-profit organization located in California, has been established to govern the coordination of links between IP addresses and domain names across the internet. This means that the main purpose of the ICANN is to coordinate the domain name system (DNS), which allows translating the IP addresses (numbers that identify a device in a network) of each active node in the network, to easy to memorize terms and so they can communicate with each other.¹⁴ The ICANN is based on the unique “multi-stakeholder” model, based on the belief that the parties directly involved in the management of the technical systems are the most capable of implementing the system, making decisions based on the cooperation between all the interested actors. As exemplified by the ICANN itself, this principle is based on the principle of “approximate consensus and code of execution.” Instead of a formal vote, an approximate consensus means that a “large majority of those who care must agree,” but the exact method of determining consensus may vary from one working group to another. Code execution is based on test protocols to see if they work.¹⁵

Since its inception, the ICANN has embarked on a series of movements designed to consolidate its authority, expanding its areas of operation. In recent years, the ICANN has

¹² UNITED NATIONS, GENERAL ASSEMBLY, Human Rights Council. Resolution on the promotion, protection and enjoyment of human rights on the Internet. UN Doc. A / HRC / 20 / L.13 (June 29, 2012).

¹³ AHMET YILDIRIM C. TURKEY, of December 18, 2012, § 31 and 54.

¹⁴ MUELLER (2002).

¹⁵ HOFFMAN (2012).

increased in size, mainly due to the introduction of new generic top-level domains (gTLD).¹⁶

Also, its presence has inspired a series of publications that, from a critical and multidisciplinary perspective, expose various issues associated with the existence of this entity.

Mueller has described the process of creating the ICANN in detail, as well as procedures related to its operation.¹⁷ Numerous academics have pointed out that the development of the ICANN represents an example of institutional innovation, establishing a new type of international regulatory mechanism.¹⁸ Also, the establishment of the ICANN as a deficient effort or an unprecedented audacious experiment has been commented on in a diverse way.¹⁹ Several academics have examined the question of who actually controls the ICANN.²⁰ Many have questioned the legitimacy of the ICANN model in terms of democracy, consensus, the inability to shake US domination over the internet and its legal basis.²¹ The contractual basis to govern the critical infrastructure of the internet has been criticized,²² as well as the key position of the ICANN in terms of international regulations.²³

Other doctrinal opinions address the problems caused in relation to intellectual property²⁴ and human rights issues.²⁵ Finally, some doctrinal sources have examined the ICANN *multi-stakeholder* model.²⁶

To make sense of the aforementioned references, we maintain that, by exercising control over access to critical elements of the Internet's technical infrastructure, such as the system that includes the routing, naming and addressing protocols, together with the technical standards, the ICANN does not abstain from the enactment of policies, whose most notable example is the enactment of the UDRP, which challenges freedom of expression. This article deepens the idea that trademark law is being distorted through this Policy, causing serious inconveniences for free expression: expanding the rights of the trademark owners based on dilution, incorporating the controversial US doctrine of initial interest confusion, discarding the doctrine of fair use, simplifying the confusion test and ignoring the phenomenon of reverse domain name hijacking. In addition, the ICANN's policies on the approval of applications for new generic top-level domain names extend the scope of trademark protection beyond what is provided by national laws.

¹⁶ A generic top-level domain (gTLD) is an extension of domain names with three or more characters and is not associated with countries.

¹⁷ MUELLER (2002).

¹⁸ FROMKIN (2002); MUELLER (2002).

¹⁹ KLEINWÄCHTER (2000); WEINBERG; (2000); FROMKIN (2002).

²⁰ See in particular FROMKIN (2002); WEINBERG (2000); MUELLER (2002).

²¹ MUELLER (2002); FROMKIN (2002); FROMKIN AND LEMLEY (2003); WEINBERG (2000); SIMON (2012).

²² BYGRAVE (2015).

²³ MUELLER (2010).

²⁴ FROMKIN (2002); DINWOODIE AND JANIS (2008); GEIST (2002); LIPTON (2005, 2010); WOODARD (2009).

²⁵ MUELLER (2010); ZALNIURUTE AND SCHNEIDER (2014); LIPTON (2012); NUNZIATO (2003).

²⁶ HOFMANN (2016); HOFMANN et al. (2017).

2. FREEDOM OF EXPRESSION UNDER THE UDRP

The creators of the UDRP have always promoted this mechanism as a balanced approach to dispute resolution, based on an extremely limited mandate, since it is designed to deal exclusively with cybersquatting cases. Regarding applicable disputes, the UDRP is based on three cumulative circumstances:

- a) in the case of an identical or similar domain name to the extent of creating confusion with respect to a trademark of products or services over which the complainant has rights;
- b) when the registrant does not have legitimate rights or interests with respect to the domain name;
- c) when the domain name has been registered and is being used in bad faith.²⁷

The drafting of this mechanism also clarifies that the double burden of proof falls on the complainant, since it is required to demonstrate both the registration and the bad faith use with respect to the domain name in dispute.

Under Article 4 (c), three circumstances that may serve to demonstrate legitimate rights or interests over the respondent's domain name are listed:

1. before having received any notice of the dispute, the respondent has used the domain name, or has made demonstrable preparations for its use, or a name corresponding to the domain name in connection with a good faith offer of products or services;

2. the respondent (as a private individual, company or other organization) has been commonly known by the domain name, even if it has not acquired rights to trademark or service mark;

3. *the respondent makes a legitimate non-commercial use or fair use of the domain name, without intending to mislead consumers in an equivocal manner or to tarnish the good name of the trademark or service mark in question for profit.*

This last clause represents the only point of relevance to be able to protect freedom of expression, although, in practice, it has given rise to inconsistencies as we will see in more detail. Since the UDRP's entry into force, it has been argued that no attention has been paid to this requirement. In 2001, Froomkin had argued that this category represents a strange mixture of incompatible concepts. This, because it is difficult to determine the legitimate commercial use in these cases since the lack of intention to obtain commercial benefit can only refer to the trademark blurring in this case.²⁸

However, not all jurisdictions apply the doctrine of infringement through the trademark dilution, which is frequently applied in US law. Therefore, even within the ICANN itself, concerns have been expressed that the concept of trademark tarnishment in the Article 4 (c) (iii) of the UDRP needs further clarification, as this legal institution could be misinterpreted by those who are not familiar with US law and could be inappropriately applied for non-commercial uses of domain names.²⁹

In US law, dilution is the diminution of the ability of a famous brand to identify and distinguish goods or services, regardless of the presence or absence of:

- a) competition between the owner of the famous brand and other parties,

²⁷ See Article 4 (a) of the Uniform Domain Dispute Resolution Policy.

²⁸ FROOMKIN (2002) p. 662.

²⁹ See SECOND STAFF REPORT ON THE IMPLEMENTATION DOCUMENTS OF THE UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY (October 24, 1999).

b) risk of confusion, error or deception.

Dilution actions fall into one of the two categories. The first is dilution by blurring, which manifests as the weakening of the power of sale and the value of a trademark through the unauthorized use of a trademark or service mark of a different nature, but can weaken associations between a trademark and its product category and other distinctive aspects, which then ceases to function as a unique identifier.³⁰ The second is the dilution by tarnishment and occurs when a famous brand is linked with harmful or poor quality products or services, creating unwanted associations, or causing a reduction in the level of preference of the famous brand.³¹

As can be seen, dilution is an expansive notion because it recognizes the damage to the owner of a brand regardless of consumer confusion, which is not compatible with the principles of trademark law that is based on protecting consumers from the confusion in terms of the source of particular products or services. Actually, any kind of criticism can dilute a brand.

However, with respect to Article 4 (c) (iii) of the UDRP, some Panels have attempted to establish a more detailed explanation of circumstances that will serve as evidence of the rights or legitimate interests of the respondent over the domain name in dispute. These are the following: (i) the domain name has been registered and is used only for expressive purposes; (ii) the domain name registrant believes that the criticisms are well founded and has no intention of obtaining commercial profits; (iii) it is evident to Internet users who visit the website that the domain name is not operated by the owner of the brand; (iv) the respondent has abstained from registering all or most of the domain names reasonably suitable for the owner of the brand; (v) a prominent and appropriate link is provided to the website of the owner of the corresponding trademark; (vi) when the emails addressed to the complainant use the domain name in question, an alert is sent to the senders in an appropriate way so that their emails have been misdirected.³²

With respect to this, two lines of practice have emerged. One, where the right of free expression does not necessarily extend to the registration and use of a domain name that is identical or confusingly similar to the trademark.³³ The other, which protects the legitimate interest of the respondent in using the trademark as part of the domain name for expressive purposes, always when said use is fair and not traded.³⁴ Curiously, in the cases where Panelists of American nationality are assigned to resolve the dispute, one tends to adopt this reasoning.³⁵

³⁰ 15 USC § 1125 (c) (2) (B).

³¹ 15 USC § 1125 (c) (2) (C).

³² WIPO OVERVIEW OF DOMAIN NAME DECISIONS, <http://www.wipo.int/amc/en/domains/search/overview2.0/> (last visited October 30, 2018).

³³ For example, see the cases THE ROYAL BANK OF SCOTLAND GROUP PLC, NATIONAL WESTMINSTER BANK PLC A/K/A NATWEST BANK V. PERSONAL AND PEDRO LOPEZ, WIPO Case No. D2003-0166; THE FIRST BAPTIST CHURCH OF GLENARDEN V. MELVIN JONES, WIPO Case No. D2009-0022; FUTBOL CLUB BARCELONA C. BP, WIPO Case No. D2014-1189.

³⁴ See the cases HOWARD JARVIS TAXPAYERS ASSOCIATION V. PAUL MCCAULEY, WIPO Case No. D2004-0014; SUTHERLAND INSTITUTE V. CONTINUATIVE LLC, WIPO Case No. D2009-0693; OSUNASPORT SL C. WHOISGUARD PROTECTED / PEDRO L. GONZALEZ SILVA, WIPO Case No. D2014-0367; HELENA REVOREDO DELVECCHIO, PROSEGUR COMPAÑÍA DE SEGURIDAD, SA C. RAQUEL NIETO MENA, WIPO Case No. D2018-0026.

³⁵ SIMON (2012).

These opposing tendencies threaten the main objective of the UDRP as they are incompatible with the overall uniformity that it intends to achieve.

3. CYBERSQUATTING VERSUS CRITICISM

Given that the UDRP does not always strike a balance between the commercial interests of industrial property and the rights of free expression, it should be noted that domain names are not registered solely for speculative purposes.

Actually, within the sites, for expressive purposes, it is possible to distinguish the discussion sites, the score-settling sites and review sites (*suck sites*).³⁶ It is worth saying that the term "*suck*" is not decisive³⁷ and can vary depending on the language used (for example, *jeboycotte* in French or *scheisse* in German).³⁸

Since review sites are growing in number, especially those English speaking ones, in literature, a standard of calling these "suck sites" is already established.³⁹

Although the ICANN's Policy should not be used to shut down debate and criticism, most Panelists find that domain names that consist of a combination of the trademark with some negative or pejorative words are confusingly similar. Therefore, for Panelists, a domain name that contains the name of one trademark is *prima facie* evidence that the domain name was registered in bad faith.

The most frequent arguments to defend such a position are the following: a) that people who do not speak English will not understand the pejorative sense of the word, they will only notice the distinctive sign in the domain name;⁴⁰ b) that users will not understand that it is a web page with which the owner of the brand is not linked;⁴¹ c) when a user writes only the name of the brand, the web browser will also insert this type of page in the results, which will lead to confusion;⁴² that the addition of a domain name to a trademark makes it automatically confusingly similar, independent of other terms present in the domain name;⁴³ that on certain particular occasions the word "*suck*" may not have a pejorative sense but rather a very descriptive purpose;⁴⁴ that the word "*suck*" is simply a generic addition to the distinctive brand.⁴⁵

³⁶ POPOVIĆ, BESAROVIĆ (2005) p. 44

³⁷ In English speaking there are other examples such as "fail," "flu," "fuck," "wtf."

³⁸ MARZETTI (2005) p.16.

³⁹ In this sense see DINWOODIE (2000) pp. 519-520; FROMKIN (200 2) pp.614 et seq.; LIPTON (2005) pp. 21 et seq.; LIPTON (2010) pp.459 et seq.; NORTON (2012) pp. 149 et seq.; SHARROCK (2001) pp.834 et seq. SORKIN (200 2) pp. 48-50; WOODARD (2009) pp. 1198-1199.

⁴⁰ *ADT Services AG v. ADT Sucks.com*, WIPO Case No. D2001-0213.

⁴¹ *Direct Line Group Ltd, Direct Line Insurance Services Ltd, Direct Line Financial Services Ltd, Direct Line Life Insurance Company Ltd, Direct Line Unit Trusts Ltd, Direct Line Group Services Ltd. Purge IT, Purge IT Ltd*, WIPO Case, No. D 2000-0583.

⁴² *Wal-Mart Stores, Inc. v. Walsucks and Walmarket Puerto Rico*, WIPO Case No. D20000477.

⁴³ *Wal-Mart Stores, Inc. v. Richard MacLeod d / b / a For Sale*, WIPO Case No. D2000-0662.

⁴⁴ *Vivendi Universal v. Jay David Sallen and GO247.com, Inc.*, WIPO Case No. D2001-1121.

⁴⁵ *Red Bull GmbH v. Carl Gamel*, WIPO Case No. D2008-0253; *Streamtel Corporation SRL v. Ton Kamminga*, WIPO Case No. D2010-0423; *HM Publishers Holdings Ltd v. Marcus Costa Camargo Peres*, WIPO Case No. D2013-1597; *Philip Morris USA Inc. v. Computer Services, Inc.* WIPO Case No. D2017-0847.

In some cases, the ease with which the Panelist transfers the domain name to the complainant, without a proper inquiry to demonstrate that the activities of the respondents match the requirements provided by the UDRP, is alarming.

With regard to this problem, in certain cases, it can be observed that the confusion test under the ICANN Policy requires only the lowest degree of confusion, compared to the doctrine developed by the US courts, known as *initial interest confusion*, which applies even in cases when there is a tenuous temporary confusion, which is extending the limits of traditional trademark law.⁴⁶

Under US law, initial confusion interest is defined as “the person's intent to divert consumers from the brand owner's online location to a site accessible under the domain name that could harm the goodwill represented by the brand, either for commercial gain or with the intent to tarnish or disparage the brand, by creating a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the site.”⁴⁷ This doctrine is applicable even “despite no current sale being made because of confusion.”⁴⁸ Recognizing the initial interest confusion, the Administrative Panels have changed the emphasis of the trademark procedures from whether registration and use confuse to whether they attract initial interest. As Goldman points out, given that such a doctrine lacks a rigorous definition, a clear justification and a uniform standard for analyzing claims, its doctrinal flexibility leads to pernicious consequences.⁴⁹

On the other hand, it should not be ruled out that there are opposing opinions where it is considered that a domain name is not automatically identical, nor is it confusingly similar to a trademark just by being accompanied by a pejorative term.

In one case, the Panelist highlighted the following: “The UDRP has a narrow scope. It is meant to protect against trademark infringement, not to provide a general remedy for all misconduct involving domain names. Posting defamatory material on a Web site would not justify revocation of a domain name under the UDRP.”⁵⁰

Also, in practice, the question of whether the content of the web page should be taken into account in the determination of the similarity of the domain name and the brand was raised from the beginning. The prevailing opinion is that it is not necessary and that it is enough to make a comparison. However, it is important to note that domain names may also reflect different interests that are not related to commercial interests, so not all domain names can perform trademark functions. Although the function of the UDRP is to respect existing trademark law,⁵¹ it happens that the Panels only review the similarity between the

⁴⁶ ESTÉE LAUDER INC. v. ESTELAUDER.COM, ESTELAUDER.NET AND JEFF HANNA, WIPO Case No. D2000-0869; AARC INC. v. JAYASHANKAR BALARAMAN, WIPO Case No. D2007-0578; BROAN-NUTONE, LLC v. READY SET SALES, WIPO Case No. D2010-0920; PHILIP MORRIS USA INC. v. KY LE, WIPO Case No. D2017-0598.

⁴⁷ LANHAM ACT, 15 USC, ch 12§1125 (d) (1) (B) (i) (V).

⁴⁸ BROOKFIELD COMMUNICATIONS, INC. v. WEST COAST ENTERTAINMENT CORPORATION, 174 F.3d 1036 (9th Cir. 1999).

⁴⁹ GOLDMAN (2005) p. 507

⁵⁰ Wal-Mart STORES, INC. v. WALLMARTCANADASUCKS.COM AND KENNETH J. HARVEY, WIPO D2000-1104.

⁵¹ FINAL REPORT OF THE WIPO INTERNET DOMAIN NAME PROCESS, § 34. “It is further recognized that the goal of this WIPO Process is not to create new rights of intellectual property, nor to accord greater protection to intellectual property in cyberspace than that which exists elsewhere. Rather, the goal is to give proper and adequate expression to the existing, multilaterally agreed upon standards of intellectual property protection in the context of the new, multijurisdictional and vitally important medium of the Internet and the DNS that is responsible for directing traffic on the Internet. The WIPO Process seeks to find procedures that

textual elements of the trademark and the domain name, discarding the traditional factors of brand protection, such as the concept of goodwill.

In many cases where the rights of free expression are harmed, the Panelists interpret the terms that establish the confusing similarity requirement with a trademark in a much broader way than the ordinary justice system. Such positions tend to be justified by stating that the right of free expression does not apply in these cases simply because the owners of the domain names could have exercised their freedom of expression by selecting a different domain name.⁵²

An illustrative example is the *Chubb Security Australia Pty case Ltd v Mr. Shahim Tahmasebi*, where the Panelist ruled against the respondent, stressing that the respondent's intention to criticize is legitimate, but "...it is not in this Panel's view to use the claimant's own trademark as a platform for criticizing the Claimant itself."⁵³

Accordingly, it becomes apparent that the complexity of the position of registrants on the rights of free expression is well reflected in the fact that opposing processes are carried out at the same time. As stated above, the requirement discusses confusion in cases including the issues inherent to freedom of expression that are difficult to discern. This is evident even in situations where the same provider of the resolution of the dispute is deciding on the request of the same respondent, without achieving consensus on the issue, which implies opposing results.⁵⁴

4. THE UDRP IS DISCARDING FAIR USE DOCTRINE

By virtue of the ICANN Policy, freedom of expression does not represent the legitimate use *per se*.⁵⁵ However, existing legal regimes and national regulations, at a comparative level, generally protect purely expressive acts, including cases involving the use of trademarks.

Even in cases of well-known trademarks, which enjoy supplementary protection, "nominative fair uses" are allowed, as long as the term of the trademark is the only way to identify what is being discussed.⁵⁶ This doctrine is not known only in American theory. The manifestation of this can be seen in the decision of the *Tribunal de Grande Instance* in Paris, which stated that "to be reprehensible, the use of a trademark must be done for commercial or advertising purposes. On the other hand, use for information purposes does not constitute an infringement."⁵⁷

will avoid the unwitting diminution or frustration of agreed policies and rules for intellectual property protection."

⁵² See by example the case *THE ROYAL BANK OF SCOTLAND GROUP AND NATIONAL WESTMINSTER BANK V. PEDRO LOPEZ AND A & A SYSTEM SOLUTIONS AND ALBERTO RODRIGUEZ*, WIPO Case No. D 2002-0823.

⁵³ *CHUBB SECURITY AUSTRALIA PTY LTD V MR. SHAHIM TAHMASEBI*, WIPO Case No. D2007-0769.

⁵⁴ For example, compare the cases *WAL-MART STORES, INC. V. WALLMARTCANADASUCKS.COM* (WIPO Case No. 2000-1104) where the Administrative Panel reasoned that a domain name accompanied by the word "suck" could never be confusingly similar under the Uniform Policy, with the case *WAL-MART STORES, INC V. WALSUCKS* (WIPO Case No. D2000-047) where the Administrative Panel appointed by the same provider, the same year, considered this type of registration as an example of bad faith registration that can be decided by applying the Uniform Policy.

⁵⁵ Recall that the only relevant point represents Article 4 (a) (iii).

⁵⁶ On topic, see FROMKIN (2002) p. 615.

⁵⁷ TGI Paris (Feb. 22,1995).

Although the UDRP is composed of both statutory and procedural regulations, one of the main shortcomings of this mechanism is that not all the aspects related to its application are precisely indicated. Mainly, the reluctance to define what a domain is has had a significant impact on the development of trademark law and its prioritization within this mechanism.

The application of those terms that can establish defenses, for which a registrant can demonstrate that it has a legitimate interest in the domain name, may be inadequate in some cases because it offers short lists of behaviors that may fall within a category, but does not make other attempts to expressly define it. Therefore, these lists do not provide adequate guidance.

Although the rules are overly broad, the ICANN never responded to requests to provide additional clarifications requested by both domain name registrants and the representatives of the trademark lobby, continually insisting that the resolution of disputes will depend on the circumstances of each case.⁵⁸

Therefore, to date, the only relevant item with regards to the selection and application of legal principles in this procedure is found in Article 15 (a) of the Rules for Uniform Domain Name Dispute Resolution Policy, which establish that an administrative Panel “shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.”

Said article is too broad. In this context, the rules encourage a wide discretion of the Panel when evaluating the rules and legal principles that can be applied in a given case. In addition, Article 10 of said Regulation allows the Panels to formulate their own rules on “the admissibility, relevance, materiality and weight of the evidence.” This is of crucial importance, given that the standards and legal principles that the Panelists deem pertinent will be applied when evaluating the three substantial requirements and their meritorious conditions provided under Article 4 (a) of the UDRP. On this basis, the vague terminology contributes to plurivalent interpretations which result in contradictory approaches adopted by the Panels. Also, the absence of safeguards against abuse of the discretion or against the inconsistent decisions,⁵⁹ increases legal insecurity.

Many of the inconsistencies occur in practice because Panelists, mostly lawyers, are influenced by national legislation. This circumstance can indicate an important bias, given that it is estimated that the complainants may be tempted to choose the dispute resolution provider based on the application of the rules that it will apply. This concept is known as *forum shopping* and means that the complainants are trying to get favorable results with the provider that suits them best.⁶⁰

⁵⁸ See *SECOND STAFF REPORT ON IMPLEMENTATION DOCUMENTS FOR THE UNIFORM DISPUTE RESOLUTION POLICY* “Staff believes that the issue of whether a pattern is present will depend on the fact pattern presented in each case and that, until experience is accumulated with the policy, prescribing a more detailed definition is not warranted.”

⁵⁹ It should be noted that the UDRP has no internal appeal, so any possibility of challenging decisions internally and correcting erroneous decisions is excluded. Likewise, there is no sanction for Panelists who are applying this Policy incorrectly or when they are extending the scope of the Policy itself.

⁶⁰ According to the Uniform Policy Regulation, the choice of the institution where the administrative procedure will be carried out is decided by the party filing the complaint (owner of the trademark). This fact has generated questions about the bias in favor of the complainants, which may call into question the impartiality of the Panels. On this subject consult FROMKIN (2002) pp. 641 et seq.; GEIST (2002), KESAN, GALLO (2003) pp. 8 et seq.; SIMON (2012) pp. 69 and ss.

In this context, in practice, concerns have emerged on bias in cases related to freedom of expression in which the Panelists and American parties participate. In fact, some studies have shown that the American respondents have a higher level of protection in cases involving the fair use of domain names compared to respondents from other countries.⁶¹

When prioritizing Americans, we must bear in mind that “laws protecting and sensitivities surrounding freedom of speech are not unique to the United States.”⁶² However, the defense of fair use tends to be ignored by Panelists from other countries.

Also, as already mentioned, Panelists from countries that ignore the dilution may interpret this institution much more broadly than it has been interpreted by American courts. In some cases, the Panels omitted determining whether the disputed trademark is a famous one, not meeting an essential requirement when it comes to dilution.⁶³

These decisions expand the theoretical scope of disputes that should be resolved exclusively by ordinary justice. Although aware of this, certain Panelists are justified by the need to uniformly apply the UDRP in all jurisdictions.

Referring to famous trademarks, unlike trademark infringement claims, dilution actions do not depend on a risk of confusion, but rather address conduct that weakens the distinctiveness or prestige associated with a famous brand.⁶⁴ It is important to note that the infringement of the trademark based on dilution is not within the provisions of the UDRP, that is, it is limited to acts carried out with the intention of obtaining a profit in the market, as established in the Report of the Second WIPO Process on Internet Domain Names. However, the ICANN has not employed any concrete measures to promote this position.

These considerations are of particular relevance considering that the UDRP lacks an effective mechanism to hinder the phenomenon of reverse cybersquatting (*reverse domain name hijacking*), which occurs when the owner of a brand affirms the rights of the trademark over the domain name of another legitimate user. In the case of reverse domain name hijacking, the only measures planned against the trademark owner imply that the Panel should refuse to transfer the domain name to the complainant, and that the bad faith claim should be published.⁶⁵ In other words, the ICANN toned down the disuasive value within the Regulation, as trademark owners cannot be punished even in situations where there is clear evidence of its *mala fides*.

⁶¹ On the subject see SIMON (2012).

⁶² *MATTHEW HARRIS, 1066 HOUSING ASSOCIATION LTD. V. MR. D. MORGAN*, WIPO Case No. D2007-1461.

⁶³ *INGERSOLL-RAND CO. V. GULLY*, WIPO Case No. D2000-0021.

⁶⁴ In the United States of America trademark owners are able to sue under the *FEDERAL TRADEMARK DILUTION ACT* (FTDA) -15 USC § 1125 (c) (2001) which provides for the following: "... the owner of a famous trademark that is distinctive... will be entitled to a court order against another person who, in the beginning of the use of a trademark or commercial name that is likely to cause dilution by dilution or dilution by degradation of the famous brand, regardless of the presence or absence of real or probable confusion, of competition, or of actual economic damage."

"Subject to the principles of equity, the owner of a famous brand that is distinctive, inherently or through acquired distinctiveness, shall be entitled to injunction against another person who, at any time after the owner's brand has become famous, commences use of a brand or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous brand, regardless of the presence or absence of actual or probable confusion, of competition, or of actual economic injury."

⁶⁵ See Article 15 (e) and 16 (b) of the Rules for Uniform Domain Name Dispute Resolution Policy.

In fact, in the case *Glimcher Univ. Mall v. GNO, Inc.*, the Administrative Panel held that the remedies available under the UDRP serve only for the benefit of trademark owners.⁶⁶

The decision of the ICANN to ignore this phenomenon has created a significant source of insecurity, given that, on this issue, Panelists act *motu proprio*, so that the position of the respondent in the proceedings conducted in accordance with the UDRP is disadvantageous. In some cases, these determinations are reaching constitutional proportions, given that issues on exclusive jurisdiction of the courts are being decided.

5. THE NEW GENERIC TOP-LEVEL DOMAIN PROGRAM (gTLD)

As Zalnieriute and Schneider point out, politically speaking, one of the most important functions of the ICANN is to decide on the introduction of new gTLDs in the domain name system.⁶⁷

For years, the ICANN has been accused of causing artificial shortages of available domain names and thus increasing the demand on already replete registration options. Finally, and on June 20, 2011, the ICANN approved a resolution authorizing the Executive Director to introduce a host of new generic top-level domain names (gTLDs) into the DNS system.⁶⁸ This authorization was unprecedented, given that, as of January 2012, there were only twenty-two gTLDs approved.

The launch of new immanent domains involves the expansion of the DNS system. However, as new domain names are incorporated, the possibilities of conflicts between domain names and trademarks increase.

In order to safeguard the rights of intellectual property, the ICANN has developed mechanisms that allow protecting trademark rights during expansion of the system through the *Trademark Clearinghouse* (TMCH).

The TMCH represents a global database whose purpose is for owners of trademarks anywhere in the world to include their trademark data on a centralized basis, even before the launch of the new gTLDs, as well as, during the same, to be able to have a protection mechanism against every third person who registers a domain name in the new gTLDs that match their trademark.

This mechanism has a double purpose. One is to allow trademark owners registered in the TMCH to choose to register a certain domain during the *sunrise* period,⁶⁹ which gives priority access to domain names in a new gTLD. The second purpose is in the power of the trademark owner to receive a notice in the case a third party requests a gTLD corresponding to its trademark, which allows the trademark owner to decide if he wants to proceed with the blocking of this domain.

From the above, it follows that the new system relative to the gTLDs includes a set of procedures by which trademark owners can not only protect their trademarks against the incursion at the top level without necessarily having to apply for a gTLD, but also allows

⁶⁶ *GLIMCHER UNIV. MALL V. GNO, INC.*, No. FA0107000098010.

⁶⁷ ZALNIERIUTE AND SCHNEIDER (2014) p. 15.

⁶⁸ Information available at: <https://www.icann.org/resources/board-material/resolutions-2011-06-20-en>.

⁶⁹ A *Sunrise* or preferential registration period refers to the launch of a new top-level domain (TLD) before its public registration begins, which allows trademark owners to register the names of domains of interest to them.

them to indicate when they believe there is something wrong with the application of a gTLD.⁷⁰

This means that the internet domain name space tends to not only expand, but also shrink. For that reason, it is imperative to remember that each time the ICANN introduces new available generic domain names, at the same time it restricts the conditions for requesting them. Limiting the chances of users to use the new domain name spaces, scarcity of available domains is inevitably generated.

While trademark owners retain the legitimate rights to protect their valuable resources within the new gTLDs, the new possibilities provided by the ICANN, like the registration or request for blockage, suppose the probability of damaging free expression. The ICANN's policies on the approval of applications for new gTLDs have a significant impact on who can use these new domains, in what form and, therefore, the accessibility of the information on the internet.⁷¹

These mechanisms extend the scope of trademark protection beyond what is provided by national legislation. There is even a debate that these mechanisms have encouraged intergovernmental organizations to request special protection for their acronyms, which has no legal basis.⁷² Of particular concern is that within the new process relative to the new gTLDs, the new registration programs have been promoted in parallel, which go beyond the provisions of the safeguard mechanisms incorporated into the same program of the ICANN's new gTLDs.⁷³

As is well known, under national legislation, trademark law is based on the principle of trademark specialty, which means that the trademark is only protected for products or services for which it was registered or for one certain class of products or services with the fulfillment of certain administrative formalities.⁷⁴

In addition, trademark rights are based on the principle of territoriality. The most significant effect of this principle is that it allows different people to be owners of identical or similar trademarks for identical or similar products or services in different jurisdictions.

In the same way, the defense of fair use allows third parties to use a brand for the purposes of criticism, parody, reference in the literature, as well as in other relevant uses as long as no attempt is made to confuse consumers. These limitations of trademark law are ignored by the mechanisms established by the ICANN.

Likewise, it can be said that the TMCH system related to the new gTLDs means that the selected applicants can choose to carry out their registration in an open or closed

⁷⁰ LIPTON AND WONG (2012) p. 27.

⁷¹ *Contracting and the Registry Agreement*, available at: <https://newgtlds.icann.org/en/applicants/agb/base-agreement-contracting#stats>.

⁷² Information available at: <https://www.icann.org/en/system/files/correspondence/crocker-to-austin-et-al-04oct16-en.pdf>.

⁷³ One of them, Donut Inc., has provided brand owners with a unique opportunity to block misspellings of their brands through the DPML (*Domains Protected Marks List*) Plus. Check here: <http://www.donuts.domains/services/dpml-plus/dpml-plus-overview>.

⁷⁴ It is important to bear in mind that in comparative law there are two forms of acquisition of the trademark depending on whether it is formal or informal procedures within different legal systems. In the registry-based system, the creation and termination of trademark rights depends on registration in a relevant national or regional registry maintained by the competent authority. In the common law system, the registered trademark and the common law trademark are differentiated, which may include commercial and personal names. When it comes to a common law trademark, the claimant must show that it has complied with the conditions for the acquisition of the trademark through use.

manner. Closed records are available only for a specific types of internet users. In this environment, the ICANN has undertaken initiatives that may harm the right to freedom of expression.

For example, in February 2015, the ICANN's new gTLD Program Committee determined that the .doctor extension is a restricted space for health professionals. This decision to exclude a number of possible uses of the .doctor domain name, including a wide range of individuals who hold a professional doctorate or even the owners of trademarks such as "Lawn Doctor," "Screen Doctor" or "Rug Doctor" has been considered as a measure against the legitimate users of freedom of expression. Also, it seemed strange that the ICANN suddenly decided to limit the .doctor domain, while at the same time analogous terms, such as .clinic, were openly registered.

Regarding this, we must bear in mind that the GNSO community⁷⁵ tried to protect the rights of free expression in the new gTLD domains program by including the principles and recommendations regarding freedom of expression in its Final Policy approved in 2007.⁷⁶ In this framework, we cite the following principles and recommendations that demonstrate the explicit intention to protect free expression in the new ICANN program:

Principle G: "The string evaluation process must not infringe the applicant's freedom of expression rights that are protected under the recognized principles of law."

Similarly, Recommendation 3 provides the following: "Strings must not infringe the existing legal rights of others that are recognized or enforceable under generally accepted and recognized principles of law. Examples of these legal rights that are internationally recognized include, but are not defined in, the Paris Convention for the Protection of Industrial Property (in particular trademark rights), the Universal Declaration of Human Rights (UDHR) and the International Covenant on Civil and Political Rights (ICCPR) (in particular freedom of expression rights)."

However, although the Final Policy of the GNSO was the result of years of hard work and commitments made by all the members, it has subsequently been infringed by the same ICANN staff.

Not only were the final recommendations to protect freedom of expression quickly ignored, but instead, the Board of Directors Meeting of the ICANN added a new requirement to the policy, known as Public Interest Commitments or "PICs" which represent the contractual terms that the ICANN imposes on registers of the new gTLDs that contradict the clauses intended to preserve the rights of freedom of expression of Internet users. By adopting the PICs, the ICANN sets a dangerous precedent in complete disregard for free expression protections that the community of the GNSO tried to incorporate in the new policy of the gTLDs.

⁷⁵ The GNSO (*Generic Names Supporting Organization*) is a subgroup of the ICANN that acts as a support organization for policy development, advising the ICANN Board on policy related to the DNS, specifically on the incorporation of new top-level domains. This body was previously known as the *Domain Name Supporting Organization* (DNSO) that was replaced in 2003.

⁷⁶ *The ICANN Generic Supporting Organization, FINAL REPORT OF THE INTRODUCTION OF NEW GENERIC TOP-LEVEL DOMAINS* (2007).

6. POLICIES RELATING TO THE ADMINISTRATION OF THE DNS SYSTEM IGNORE THE ISSUES RELATED TO FREEDOM OF EXPRESSION

In the process of protecting trademark interests on the Internet, little interest in issues related to free expression has been the historical consequence. Since the first draft of the UDRP was developed by WIPO (World Intellectual Property Organization), the unequal position among the parties within this mechanism was established from the beginning. Primarily, this is due to the fact that, faced with threats from cybersquatters, the fundamental concern of WIPO was the protection of trademarks, not protection against eventual abuse by the owners of the trademarks.

In consequence, the WIPO Final Report submitted on April 30, 1999, suggests that the UDRP is not only limited to cases of registrations and uses in bad faith, but also applies exclusively to cases related to the infringement of trademark rights, excluding the rest of the distinctive signs.⁷⁷

Following this line, issues relating to rights and the use of domain names were established in the Report of the Second WIPO Process on Internet Domain Names, which describes the types of disputes to which this mechanism of dispute resolution can apply, expressly discarding the interaction in free expression. It was highlighted that “the policy relegates all “legitimate” disputes - such as those where both disputants had long-standing trademark rights in the name when it was registered as a domain name - to the courts; only cases of abusive registrations are intended to be subject to the streamlined administrative dispute-resolution procedure.”⁷⁸

As we can see, from the beginning, the designers of the UDRP planned to establish a dispute resolution mechanism of limited scope, exclusively to combat cases of cybersquatting.

Despite this, in the overwhelming majority of cases involving the right to free expression, this idea is not reflected.

However, these results indicate a more serious problem since they are contrary to the general principles of law, as well as to the constitutionality of national legal systems. Generally, the constitutions *ex jure* recognize and protect the rights to express and freely disseminate thoughts, ideas and opinions.

It should be noted that the recent transition from custody of functions of IANA to the ICANN does not seem to alleviate this problem.⁷⁹ Despite being formally considered, the right of free expression hides deep internal issues within the process.

The transition process includes the adoption of a statute that affirms the ICANN's commitment to respect human rights, including the establishment of an adequate framework for the implementation of this commitment in its policies and procedures.⁸⁰

⁷⁷ FINAL REPORT OF THE WIPO INTERNET DOMAIN NAME PROCESS (1999).

⁷⁸ See SECOND STAFF REPORT ON IMPLEMENTATION DOCUMENTS FOR THE UNIFORM DISPUTE RESOLUTION POLICY 4.1. c) The Recommended Policy is Minimalist in its Resort to Mandatory Resolution. Text available at: <http://archive.icann.org/en/udrp/udrp-second-staff-report-24oct99.htm>.

⁷⁹ The full discussion of this transition is beyond the scope of this article. However, it is important to understand that these functions are key to managing the Internet and are usually divided into three areas: a) protocol assignments (IP), b) numerical resources of the Internet and c) management of the root zone. For more details LAKETIĆ (2016) can be consulted.

⁸⁰ BYLAWS FOR INTERNET CORPORATION FOR ASSIGNED NAMES (2016).

Moreover, within Section 1.2 (b) (viii) on fundamental values that should guide the decisions and actions of the ICANN it is expected that this should be “subject to the limitations set forth in Section 27.2, within the scope of its Mission and other Core Values, respecting accepted human rights as required by applicable law. This Core Value does not create, and shall not be interpreted to create, any obligation on the ICANN outside its Mission, or beyond that found in applicable law. This Core Value does not require the ICANN to enforce its human rights, or the human rights of other parties, against other parties.”⁸¹

In accordance with Section 27.2 (a), the proposed regulation will not enter into force or produce effects: “unless and until a framework of interpretation for human rights (“FOI-HR”) is:

(I) approved for submission to the Board by the CCWG-Accountability [working group] as to a consensus recommendation in Work Stream 2, with the CCWG Chartering Organizations having the role described in the CCWG-Accountability Charter, and

(II) approved by the Board, in each case, using the same process and criteria as for Work Stream 1 Recommendations.”⁸²

This ambiguous regulation defines the ICANN's commitment to human rights is left for some time in the future and will not take effect until the ICANN Board approves the content and scope of that commitment.

For now, it seems clear that the ICANN will have no obligation to respond to human rights violations, including any party it has delegated one of its tasks to, such as its managers, registries, registrars, registrants, among others.

7. CONCLUSION

Throughout this work we have observed several problems in the recognition of the normative status of international standards related to free expression, as well as obstacles to their integral implementation in sentences under the UDRP, which shows that the growing international importance of the Internet and the decreasing role of the State obliges us to reconsider the responsibility that belongs to the private sector regarding the violation of human rights on the network. By prioritizing the problems caused by the fact that the system of Internet domain names was not planned to deal with issues related to industrial property, the alternative dispute resolution mechanisms, which take precedence in this matter, are the reflection of the exclusive fight against cybersquatting.

Therefore, the lack of attention to issues of domain names that cover the issues beyond their correlation with cybersquatting, that is, with trademarks, has become a general rule. This perspective represents a narrow view of the legal correlations coming from the internet application.

We argue that, by prioritizing the needs of the market, you cannot lose sight that current domain names often reflect interests that are not in relation to the trademark interests, or commercial, but with the freedom of expression.

⁸¹ Section 1.2 (b) (viii). *Bylaws for Internet Corporation For Assigned Names And Numbers, To California Nonprofit Public-Benefit Corporation* (draft dated May 26, 2016), p. 5.

⁸² *Ibid.*, p. 137.

As we have explained, the ICANN's domain name protection mechanisms exceed the rights conferred by the trademark and have worrisome implications. Exorbitant decisions have been transformed into means to suppress freedom of expression and disintegrate the rights of domain name registrants. A too narrow view regarding the requirement of similar confusion threatens the defense of the fair use of domain name registrants, which leads to the breach of the protection conceived by national legislations. As registrants are subject to different treatments, which is reflected in the heterogeneity of the decisions in which different Panels consider claims of freedom of expression, inconsistency has occurred in a field of law that is becoming increasingly sensitive in the environment of a new forum of criticism, as is the case of the internet.

Similarly, the ICANN as an institution of global internet governance should act in the public interest. In fact, the Articles of Incorporation of the ICANN stated that: “The Corporation shall operate for the benefit of the Internet community as a whole, carrying out its activities in accordance with the principles of international law and applicable international conventions and local law, and for the extent appropriate and consistent with these Articles and its Bylaws, through open and transparent processes that enable competition and open entry in Internet-related markets. To this effect, the Corporation shall cooperate as appropriate with relevant international organizations.”⁸³

However, the ICANN has reformed Constitutive Acts and no longer operates within the framework of the international legal system.⁸⁴ As we have discussed, the current Statute of the ICANN attributes a different scope of competencies.⁸⁵

Even before these reforms, the growing demands of protecting rights on the Internet, particularly freedom of expression, have not paid off. When NTIA still managed the contract with the ICANN, meaning that it was subject to the same restrictions and legal obligations to protect freedom of expression as the US government, some of the most influential stakeholders were reluctant to engage the ICANN with any obligation to protect human rights. The GNSO Final Policy on the protection of free expression was infringed by the ICANN staff itself.

Legally speaking, there is no support to decide on the basis of commercial reasons to put the rights of industrial property before the demands of freedom of expression.

We are facing the risk of attenuating what is not attenuated, the severity of the basic standard of human rights. If we accept diminishing the responsibility of the private sector, tolerating the application of voluntary patterns regarding free expression, we are losing sight of the fact that “intellectual property itself is just a small lake in that larger continent; it is a set of limited and tentative exceptions to much larger and more fundamental rights like the right to free speech.”⁸⁶

⁸³ ARTICLES OF THE CONSTITUENT ACTS OF THE ICANN (2012): article 4.

⁸⁴ The information is available at: <https://pti.icann.org/articles-of-incorporation>.

⁸⁵ Consider *BYLAWS FOR INTERNET CORPORATION FOR ASSIGNED NAMES AND NUMBERS* (2016).

⁸⁶ BREAKEY (2016) p. 2.

CITED BIBLIOGRAPHY

- BONE, Robert (2006): "Hunting goodwill: a history of the concept of goodwill in trademark law," *Boston University Law Review*, vol. 86: pp. 547-622.
- BREAKEY, Hugh (2016): *Intellectual liberty: Natural rights and intellectual property* (Abingdon and New York, Routledge, primera edición).
- BYGRAVE, Lee (2015): *Internet governance by contract* (Oxford, Oxford University Press, primera edición).
- DINWOODIE, Graeme (2000): "(National) Trademark Laws and the (Non-National) Domain Name System," *University of Pennsylvania Journal of International Economic Law*, vol. 21, N°3: pp. 495-521.
- DINWOODIE, Graeme Y JANIS Mark (2008): *Trademark law and Theory: A handbook of contemporary research* (Cheltenham, Edward Elgar Publishing, primera edición).
- FROOMKIN, Michael (2002): "Icann's Uniform Dispute Resolution Policy-Causes and (Partial) Cures," *Brooklyn Law Review*, vol. 67, N°3: pp. 605-718.
- FROOMKIN, Michael Y LEMLEY Mark (2003): "ICANN and anti-trust," *University of Illinois Law Review*, vol. 1: pp.1-76.
- GEIST, Michael (2002): "Fair. Com: An examination of the allegations of systemic unfairness in the ICANN UDRP," *Brooklyn Journal of International Law*, vol. 27, N°3: pp. 903-938.
- GOLDMAN, Eric (2005): "Deregulating relevancy in Internet trademark law," *Emory Law Journal*, vol. 54, N°1: pp. 507-596.
- HOFFMAN, Paul (2012): "The tao of IETF: A novice's guide to the Internet Engineering Task Force. Disponible en: <https://www.ietf.org/about/participate/tao/> . Fecha de consulta: 09 de septiembre de 2018.
- HOFMANN, Jeanette (2016): "Multi-stakeholderism in Internet governance: putting a fiction into practice," *Journal of Cyber Policy*, vol. 1, N°1: pp. 29-49.
- HOFMANN, Jeanette; KATZENBACH, Christian Y GOLLATZ, Kirsten (2017): "Between coordination and regulation: Finding the governance in Internet governance," *New Media & Society*, vol. 19, N° 9: pp. 1406-1423.
- JOHNSON, Eric (2012): "Intellectual property and the incentive fallacy," *Florida State University Law Review*, vol. 39, N°3, pp.623-679.
- KESAN, Jay Y GALLO, Andres (2003): "ICANN / UDRP Performance-An Empirical Analysis," Working Papers 03-08, NET Institute. Disponible en: <http://www.netinst.org/KesanGallo.pdf> . Fecha de consulta: 07 de diciembre de 2018.
- KLEINWÄCHTER, Wolfgang (2000): "Icann as the United Nations of the global information society? The long road towards self-regulation of the Internet," *International Communication Gazette*, vol. 62, N°6: pp. 451-476.
- LAKETIĆ, Jelena (2016): "Control de Internet: Las implicaciones políticas de las funciones de la IANA," *Revista Chilena de Derecho y Tecnología*, vol. 5, N°2: pp.127-151.
- LIPTON, Jacqueline (2005): "Beyond Cybersquatting: Taking Domain Name Disputes Past Trademark Policy," *Wake Forest Law Review*, vol. 40, N°4: pp. 1361-1425.
- LIPTON, Jacqueline (2010): "Bad Faith in Cyberspace: Grounding Domain Name Theory in Trademark, Property, and Restitution." *Harvard Journal of Law and Technology*, vol. 23, N°2: pp. 447-481.
- LIPTON, Jacqueline y WONG, Mary (2012): "Trademarks and freedom of expression in ICANN's new gTLD process," *Monash University Law Review*, vol. 38, N°1: pp. 188-228.

MARZETTI, Maximiliano (2005): "Speechless Trademarks? Dilution Theory Meets Freedom of Speech," WIPO Collection Paper.

MCCARTHY, Thomas (1996): *McCarthy on trademarks and unfair competition* (Deerfield, IL, Clark Boardman Callaghan, cuarta edición).

MCKENNA, Mark (2007) "The normative foundations of trademark law," *Notre Dame Law Review*, vol. 82, N°5: pp.1839-1916.

MUELLER, Milton (2002): *Ruling the root: Internet governance and the taming of cyberspace* (Cambridge, Massachusetts and London, MIT Press, primera edición).

MUELLER, Milton (2010): *Networks and states: The global politics of Internet Governance* (Cambridge, Massachusetts and London, MIT Press, primera edición).

NORTON, Ben (2012): "Constitutional Internationalization of ICAAN's UDRAP," *Arizona Journal of International and Comparative Law*, vol. 29, N°1: pp. 137-173.

NUNZIATO, Dawn (2003): "Freedom of Expression, Democratic Norms, and Internet Governance," *Emory Law Journal*, vol. 52, N°1: pp. 187-306.

POPOVIĆ, Dušan y BESAROVIC, Vesna (2005): *Imena internet domena i pravo intelektualne svojine* (Belgrado, Institut za uporedno pravo, primera edición).

POWERS, Shawn Y JABLONSKI, Michael (2015): *The real cyber war: The political economy of internet freedom* (Urbana, Chicago and Springfield, University of Illinois Press, primera edición).

SHARROCK, Lisa (2001): "The future of domain name dispute resolution: crafting practical international legal solutions from within the UDRP framework," *Duke Law Journal*, vol. 51, N°2: pp. 817-849.

SIMON, David (2012): "An Empirical Analysis of Fair Use Decisions under the Uniform Domain-Name Dispute-Resolution Policy," *Boston College Law Review*, vol. 53, N°1: pp.64-129.

SORKIN, David (2002): "Judicial review of ICANN domain name dispute decisions," *Santa Clara Computer & High Technology Law Journal*, vol. 18, N°1: pp. 35-55.

WEINBERG, Jonathan (2000): "ICANN and the problem of legitimacy," *Duke Law Journal*, vol. 50, N°1: pp.187-260.

WOODARD, Elizabeth (2009): "The UDRP, ADR, and arbitration: Using proven solutions to address perceived problems with the UDRP," *Fordham Intellectual Property, Media & Entertainment Law Journal*, vol. 19, N°4: pp. 1169-1213.

ZALNIERIUTE, Monika Y SCHNEIDER, Thomas (2014): "ICANN's Procedures and Policies in the Light of Human Rights, Fundamental Freedoms and Democratic Values." Consejo de Europa. Disponible en: https://papers.ssrn.com/sol3/papers.cfm?abstract_id=2667478.

INTERNATIONAL TREATIES, INSTRUMENTS AND REPORTS:

ARTÍCULOS DE ACTAS CONSTITUTIVAS DE LA ICANN, disponible en: <https://www.icann.org/resources/pages/articles-2012-02-25-en>. Fecha de consulta: 23 de mayo de 2017.

BYLAWS FOR INTERNET CORPORATION FOR ASSIGNED NAMES AND NUMBERS, A CALIFORNIA NONPROFIT PUBLIC-BENEFIT CORPORATION (May 27, 2016). Disponible en: <https://www.icann.org/en/system/files/files/adopted-bylaws-27may16-en.pdf>. Fecha de consulta: 15 de diciembre de 2016.

DECLARACIÓN UNIVERSAL DE LOS DERECHOS HUMANOS. Resolución 217 A (III) de la Organización de las Naciones Unidas, París, Francia, 10 de diciembre de 1948.

FINAL REPORT OF THE WIPO INTERNET DOMAIN NAME PROCESS. (April 30, 1999).
ICANN GENERIC SUPPORTING ORGANISATION, FINAL REPORT OF THE INTRODUCTION OF
NEW GENERIC TOP-LEVEL DOMAINS (August 8, 2007). Disponible en:
<https://gnso.icann.org/en/issues/new-gtlds/pdp-dec05-fr-part-a-08aug07.htm>. Fecha de
consulta: 24 de marzo de 2017.

POLÍTICA UNIFORME PARA LA RESOLUCIÓN DE CONFLICTOS EN MATERIA DE NOMBRES DE
DOMINIO, aprobada por la Corporación de Asignación de Nombres y Números de Internet
(ICANN) el 24 de octubre de 1999.

REGLAMENTO PARA UNA POLÍTICA UNIFORME DE RESOLUCIÓN DE DISPUTAS SOBRE NOMBRES
DE DOMINIO, aprobado por la Junta directiva de la ICANN el 30 de octubre de 1999.

SECOND STAFF REPORT ON IMPLEMENTATION DOCUMENTS FOR THE UNIFORM DISPUTE
RESOLUTION POLICY (October 24, 1999).

U.N. SPECIAL RAPPORTEUR ON THE PROMOTION AND PROTECTION OF THE RIGHT TO
FREEDOM OF OPINION AND EXPRESSION, Report to the Human Rights Council, Seventeenth
Session Agenda Item 3, United Nations General Assembly, U.N. Doc. A/HRC/17/27 (May
16, 2011) (by Frank La Rue). Disponible en:

http://www2.ohchr.org/english/bodies/hrcouncil/docs/17session/A.HRC.17.27_en.pdf.

Fecha de consulta: 12 de marzo de 2017.

U.S. DEPARTMENT OF COMMERCE, MANAGEMENT OF INTERNET NAMES AND ADDRESSES, 63
Fed. Reg. 31,741 (10 de junio de 1998). Disponible en:

<https://www.icann.org/resources/unthemed-pages/white-paper-2012-02-25-en>. Fecha de
consulta: 12 de diciembre de 2016.

CITED LEGAL STANDARDS:

TRADEMARK DILUTION REVISION ACT OF 2006, Pub. L. No. 109-312, 120 Stat. 1730
(codified as amended at 15 U.S.C.A. § 1125(c) (West Supp. 2007)) (Estados Unidos de
América).

CITED JURISPRUDENCE:

BROOKFIELD COMMUNICATIONS, INC. v. WEST COAST ENTERTAINMENT CORPORATION, 174
F.3d 1036 (9th Cir. 1999).

TGI PARIS, 22 FÉVRIER 1995: PIBD 1995, III, p. 257 (Francia).

TRIBUNAL EUROPEO DE DERECHOS HUMANOS: AHMET YILDIRIM v. TURKEY, sentencia de 18
de diciembre de 2012, demanda n° 3111/10.

JURISPRUDENCIA ADMINISTRATIVA CITADA:

AARC INC. v. JAYASHANKAR BALARAMAN, WIPO Case No. D2007-0578.

ADT Services AG v. ADT Sucks.com, WIPO Case No. D2001-0213.

Chubb Security Australia Pty Ltd v Mr. Shahim Tahmasebi, WIPO Case No. D2007-0769

DIRECT LINE UNIT TRUSTS LTD, DIRECT LINE GROUP SERVICES LTD v. PURGE I.T., PURGE I.T.
LTD, WIPO Case, No. D 2000-0583.

FOX NEWS NETWORK, L.L.C. v. C&D INTERNATIONAL LTD. AND WHOIS PRIVACY PROTECTION
SERVICE, WIPO Case No. D2004-0108.

GLIMCHER UNIV. MALL v. GNO, INC., No. FA0107000098010.

INGERSOLL-RAND Co. v. GULLY, WIPO Case D2000-0021 (9 de marzo de 2000).

HM Publishers Holdings Ltd v. Marcus Costa Camargo eres, WIPO Case No. D2013-1597.

HELENA REVOREDO DELVECCHIO, PROSEGUR COMPAÑÍA DE SEGURIDAD, S.A. c. RAQUEL NIETO MENA, WIPO Case No. D2018-0026.

VIVENDI UNIVERSAL v. JAY DAVID SALLEN AND GO247.COM, INC., WIPO Case No. D2001-1121.

MATTHEW HARRIS, 1066 HOUSING ASSOCIATION LTD. v. MR. D. MORGAN, WIPO Case No. D2007-1461.

OSUNASPORT S.L c. WHOISGUARD PROTECTED / PEDRO L. GONZÁLEZ SILVA, WIPO Case No. D2014-0367.

PHILIP MORRIS USA INC. v. COMPUTER SERVICES, INC., WIPO Case No. D2017-0847.

PHILIP MORRIS USA INC. v. KY LE, WIPO Case No. D2017-0598.

SUTHERLAND INSTITUTE v. CONTINUATIVE LLC, WIPO Case No. D2009-0693.

RED BULL GMBH v. CARL GAMEL, WIPO Case No. D2008-0253; Streamtel Corporation SRL v. Ton Kamminga, WIPO Case No. D2010-0423.

THE FIRST BAPTIST CHURCH OF GLENARDEN v. MELVIN JONES, WIPO Case No. D2009-0022.

FUTBOL CLUB BARCELONA c. B.P, WIPO Case No. D2014-1189.

THE ROYAL BANK OF SCOTLAND GROUP AND NATIONAL WESTMINSTER BANK v. PEDRO LOPEZ AND A&A SYSTEM SOLUTIONS AND ALBERTO RODRIGUEZ, WIPO Case No. D 2002-0823.

WAL-MART STORES, INC. v. RICHARD MACLEOD D/B/A FOR SALE, WIPO Case No. D2000-0662.

WAL-MART STORES, INC. v. WALSUCKS, WIPO Case No. D2000-047.

WAL-MART STORES, INC. v. WALSUCKS AND WALMARKET PUERTO RICO, WIPO Case No. D20000477.

WAL-MART STORES, INC. v. WALLMARTCANADASUCKS.COM AND KENNETH J. HARVEY, WIPO D2000-1104.
