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SERBIAN EXPERIENCE IN DOMAIN NAME DISPUTE RESOLUTION

*prepared by Prof. Dušan Popović, Ph.D, Associate Professor, University of Belgrade Faculty of Law; President, Serbian Domain Name Dispute Resolution Body, Member, ICANN Intellectual Property Constituency**

ABSTRACT

The Serbian Rules on National Domain Names Dispute Resolution were developed under the auspices of RNIDS – the Serbian Internet Domain Name Registry. RNIDS is a private not-for-profit organization established to manage country-code top level domains in Serbia - .rs (latin alphabet domain name) and .cpб (cyrillic alphabet domain name). RNIDS is governed through the multi-stakeholder model, similarly to the Internet Corporation for Assigned Names and Numbers (ICANN). All interested parties, other than Government entities, may become co-founders of RNIDS. RNIDS established an independent commission for the resolution of domain name disputes – the Serbian Domain Name Dispute Resolution Body. The Dispute Resolution Body operates under the umbrella of the Serbian Chamber of Commerce, but it is independent from both the Chamber and RNIDS. The Serbian Rules on National Domain Names Dispute Resolution were drafted following the Uniform Domain Name Dispute Resolution Policy (UDRP) model. Whereas the Serbian Rules are not identical to the UDRP, the UDRP model was followed as closely as possible, while taking into consideration the specificities of the national legal regime.

* The views expressed in this document are those of the author and not necessarily those of the Secretariat or of the Member States of WIPO.

1. Domain name disputes arise between trademark owners, or more generally IP owners, on the one hand, and domain name registrants, on the other hand. This type of disputes may be addressed before an ordinary court. However, trademark infringement proceedings normally last for several months or even years, while Internet businesses need a more efficient method of terminating the infringement. Hence, it was more suitable to establish an out-of-court dispute resolution procedure. Based on recommendations contained in the Report of the World Intellectual Property Organization (WIPO) First Internet Domain Name Process, the Internet Corporation for Assigned Names and Numbers (ICANN) adopted the Uniform Domain Name Dispute Resolution Policy (UDRP), which has become a “model policy” for the national legislators. The UDRP applies to second-level domain name registrations in gTLDs (.com, .asia, .net ...) and to second-level domain name registrations in certain ccTLDs (.me, .ph ...). Unlike certain countries that decided to apply the UDRP for the resolution of disputes related to national domain name registrations, the Republic of Serbia opted for the adoption of its national domain name dispute resolution rules, which were UDRP-inspired.

2. Serbian domain name dispute resolution rules were developed under the auspices of RNIDS – Serbian Internet Domain Name Registry. RNIDS is a private not-for-profit organization established to manage country-code top level domains in Serbia - .rs (latin alphabet domain name) and .cpб (cyrillic alphabet domain name). RNIDS is governed through the multi-stakeholder model, similarly to ICANN. All interested parties, other than Government entities, may become co-founders of RNIDS and participate in the decision-making process. For example, the Faculty of Law of the University of Belgrade is one of the RNIDS co-founders. Further to this, all policy decisions are open to public comments and final decisions are published on the Internet. The RNIDS Founding Assembly was held on the July 8, 2006. RNIDS operated as a fund until May 28, 2011 when it became a foundation in accordance with the law. The corporate structure of RNIDS comprises the Conference of Co-founders, the Board of Governors and the Director. RNIDS manages the register for the country code top-level Internet domains of the Republic of Serbia, in accordance with the decision of ICANN.

3. RNIDS established an independent commission for the resolution of domain name disputes – Serbian Domain Name Dispute Resolution Body (in Serbian, *Komisija za rešavanje sporova povodom registracije naziva nacionalnih internet domena Srbije*). The Dispute Resolution Body operates under the umbrella of the Serbian Chamber of Commerce, but it is independent from both the Chamber and RNIDS. The Serbian Chamber of Commerce only provides for technical assistance. The Serbian Domain Name Dispute Resolution Body was established under Article 2 of the Cooperation Agreement signed between RNIDS and the Chamber of Commerce in late 2010.¹

4. In the Republic of Serbia, domain name dispute proceedings are regulated by the Rules on National Domain Names Dispute Resolution, adopted on April 19, 2011, and further amended in 2012 and 2014.² Prior to the adoption of the mentioned Rules, the domain name dispute proceedings were regulated by the Arbitration Rules on domain name disputes, adopted on October 26, 2007. As it may already be concluded from the very title of these Rules, the dispute resolution proceedings were first wrongfully qualified as arbitration. This was corrected in 2011, when the current Rules were adopted and the proceedings are now qualified as an alternative dispute resolution method (ADR).

¹ The Cooperation Agreement is available at:
<http://www.rnids.rs/data/DOKUMENTI/Ostali%20dokumenti/sporazum20110421.pdf>.

² *Official Journal of the Republic of Serbia*, no. 31/2011, 24/2012 and 67/2014. The consolidated version is available at:
<http://www.rnids.rs/data/DOKUMENTI/Opsti%20akti/Pravilnik%20o%20postupku%20za%20rešavanje%20sporova%20povodom%20registracije%20nacionalnih%20internet%20domena-interno%20prečišćen%20tekst.pdf>.

5. Substantive rules on national domain names dispute resolution were drafted following the UDRP model. Under Art. 22 of the Rules, a panel may order transfer or termination of a domain name registration if:

1. a domain name is identical or confusingly similar to a trademark in which the complainant has rights; and
2. a registrant has no rights or legitimate interests in respect of the domain name; and
3. a domain name has been registered and is being used in bad faith.

6. As the UDRP, the Serbian Rules on National Domain Names Dispute Resolution also provide for example of uses of domain names in bad faith. Under Art. 23 of the Rules, bad faith is indicated where:

1. there are circumstances indicating that a registrant has registered or has acquired the 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 to a competitor of that complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name; or
2. a registrant has registered the domain name in order to prevent the owner of the trademark from reflecting the mark in a corresponding domain name, provided that he has engaged in a pattern of such conduct; or
3. a registrant has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
4. by using the domain name, a registrant has intentionally attempted to attract, for commercial gain, Internet users to his web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of complainant's web site or location or of a product or service on complainant's web site or location.

7. Under Art. 24 of the Rules, a registrant may demonstrate its rights or legitimate interest to the domain name if one of the following circumstances is proven:

1. before any notice of the dispute, the documented use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
2. a registrant (as an individual, business, or other organization) has been commonly known by the domain name, even if a registrant has acquired no trademark rights; or
3. a registrant is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark at issue.

8. The Rules of Procedure before the Serbian Domain Name Dispute Resolution Body are not identical to the UDRP; however, the model was followed as closely as possible, while taking into consideration the specificities of the national legal regime. One of the main distinctions between the UDRP and the Serbian Rules consists in the provisions regulating the appointment of the panel. In Serbia, a national domain name dispute always has to be decided by a three-member panel. Disputes may not be resolved by a single panelist.

9. A panel is independent from the Dispute Resolution Body, the registrar or the parties. Panelists are selected from among trademark law attorneys, professors of Intellectual Property Law or Internet Law experts. The list of persons qualified to serve as panelists currently has 23 names and was adopted jointly by RNIDS and the Serbian Chamber of Commerce in 2011. A new list of panelists is adopted every four years, following a public call for interest.
10. Each party proposes one panelist from the list, and the two jointly appoint the third one from the list. In case one of the parties does not select a panelist, the appointment is made by the Managing Board of the Dispute Resolution Body.³ Before accepting their appointment, selected panelists must notify the Dispute Resolution Body of any circumstances that are capable of giving rise to doubt as to their impartiality. The same applies if any new circumstance occurs during the proceedings.
11. The parties to the proceedings need not be represented by an attorney. However, the assistance of an attorney may prove to be helpful in view of short deadlines for submissions.
12. Although initially communication between parties and the panel had to be made both in electronic and paper form, following the 2014 amendments to the Rules, only electronic submissions are allowed. Still, a complaint initializing the proceedings needs to be submitted in both forms. This exception is being justified by the importance of this initial act. The language of the procedure is Serbian.
13. If the complaint satisfies the formal requirements, the Dispute Resolution Body forwards the complaint to the respondent after receipt of the fee paid by the complainant. The fees are to be paid by the complainant in total and are to be paid to the Dispute Resolution Body when the complaint is filed. A natural person pays a fee of approximately EUR 670 (RSD 80,000) in case the number of disputed domain names does not exceed two. A legal person pays a fee of approximately EUR 1,500 (RSD 180,000) in case the number of disputed domains does not exceed five, or if the number of disputed domain names is between 6 and 10 – a fee of approximately EUR 1,800 (RSD 215,000).
14. In case the complaint does not satisfy the formal requirements, the complainant has to correct any deficiencies, or the complaint will be considered withdrawn. The respondent must file its response within 15 days of the receipt of complaint. If the respondent does not file its response by the deadline, the Dispute Resolution Body will proceed to appoint the panel. In such a case, the complainant's claims remain uncontradicted. However, the complainant still has to prove all three elements of Art. 22 in order to succeed.
15. The panel makes its decision within 60 days of its appointment, on the basis of the statements and documents submitted and in accordance with the Rules. In-person hearings are carried out in exceptional cases, upon decision by the panel.

³ The Managing Board is formed by the President, the Vice-President and the Secretary-General of the Dispute Resolution Body.

16. A panel adopts its decisions by a majority. Decisions are made in writing and must contain reasoning. The administrative panel can adopt one of the following three types of decision:

1. decide in favor of the complainant and order that the disputed domain name be transferred to the complainant;
2. decide in favor of the complainant and order that the disputed domain name be cancelled; and
3. decide in favor of the registrant (respondent).

17. The Dispute Resolution Body communicates a decision to the parties and the registrar. Decisions are published on its website.

18. The panel decision is definitive, therefore no appeal can be made, but either party may initiate court proceedings. The panel decision is implemented by the registrar unless court proceedings have been initiated in which case the implementation of the panel decision is suspended. Indeed, both complainant and respondent may conduct litigation before ordinary courts simultaneously with ADR proceedings or following conclusion of ADR proceedings. If legal proceedings before ordinary courts have been initiated prior to or during ADR proceedings in respect of an identical domain name, the administrative panel shall have the discretion to decide whether to suspend or terminate the administrative proceedings or to proceed to a decision. As already mentioned, in case the registrant initiates court proceedings after the panel decision has been reached, the registrar concerned shall not implement the decision if it receives, within the period of 10 business days following the receipt of the panel decision, any official documentation proving that the registrant has commenced a lawsuit against the complainant.

19. Since 2009, the panels established within the Serbian Domain Name Dispute Resolution Body resolved 19 disputes in total, while three proceedings are pending (as of July 3, 2015). Although the statistics may seem modest, it should be taken into consideration that very frequently disputes are settled by the parties directly. Therefore, certain cases are never brought before the Dispute Resolution Body. Throughout the years, this alternative dispute resolution method has acquired certain recognition, so it is expected that the number of cases brought before the Serbian Domain Name Dispute Resolution Body will continue to increase.

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