

Who Could Have Imagined It Would Turn Out to Be This ‘Sublime’*? Twenty-Five Years of the UDRP, The Initial WIPO-ICA UDRP Review and How Domain Name Dispute Resolution in the ‘.za’ Domain Compares

Eddie Hurter

<https://orcid.org/0000-0002-2894-8771>

University of South Africa

hurteel@unisa.ac.za

Abstract

The Uniform Dispute Resolution Policy (UDRP) was developed in response to the need for the timely and effective resolution of disputes where protected trade marks were registered as domain names. Since its inception in 1999, it has proven to be a largely fair and effective remedy against ‘cybersquatting’, the bad-faith registration of domain names in violation of trade mark rights. Twenty-five years later, experts are reviewing the policy through the World Intellectual Property Organization-Internet Commerce Association (WIPO-ICA) UDRP Review Process to consider possible amendments to the global domain name dispute resolution system. The Initial Report of the WIPO-ICA UDRP Review Project Team, intended to inform the future Internet Corporation for Assigned Names and Numbers Policy Development Process, is analysed to identify recent UDRP trends, reasoning and best practice and to compare them with South Africa’s ‘.za’ domain name dispute resolution system.

Keywords: Uniform Dispute Resolution Policy (UDRP); Initial WIPO/ICA UDRP Review; ICANN Phase 2 UDRP Review; South African Domain Name Dispute Resolution Regulations; WIPO Arbitration and Mediation Center

* ‘From the Sublime to the Ridiculous’ points out that in life, things that are noble and magnificent are never far from things that are trivial and laughable <<https://www.dictionary.com/browse/from-the-sublime-to-the-ridiculous-is-but-a-step>> accessed 25 September 2025. The saying was first used in a domain name dispute resolution context by Tony Willoughby, ‘Domain Name DRS Policies: From the Sublime to the Ridiculous’ (2006) 8 *Journal of Intellectual Property Law and Practice* 539.

Introduction

Modern-day society and human interaction are inextricably linked to the digital environment, in essence, the interconnected global, multipurpose system colloquially called the ‘internet’. The internet essentially operates on the foundational system called the domain name system (DNS). Since the registration of the first domain name, which is reputed to be ‘symbolics.com’ in 1985,¹ or when the McDonald’s Corporation was not interested in registering the domain name ‘McDonalds.com’ in 1994,² to the exponential growth of the DNS during the middle to late 1990s,³ and the decades thereafter, when as early as 2025, global domain name registrations reached a total of 368 million registrations,⁴ the DNS has morphed into the skeleton on which the modern digital society hangs.⁵ Although there is some uncertainty about whether the first commercial domain name was indeed registered in 1985 and how that occurred, it is widely accepted that, until at least the mid-1990s, the internet was viewed as a ‘free space’ largely beyond the reach of real-world laws and regulations.⁶ This unregulated

- 1 C Flinders, ‘The First Ever 20 Domain Names Registered’ *Computer Weekly* (3 September 2009) <<https://www.computerweekly.com/news/1280090622/The-first-ever-20-domain-names-registered>> accessed 14 September 2025; J Abell, ‘Dot-Com Revolution Starts With a Whimper’ *WIRED* (15 March 2010) <<https://www.wired.com/2010/03/0315-symbolics-first-dotcom/>> accessed 14 September 2025.
- 2 See J Quittner, ‘Billions Registered: Right Now, there are No Rules to Keep you from Owning a Bitchin’ Corporate Name as your Own Internet Address’ *WIRED* (1 October 1994) <<https://www.wired.com/1994/10/mcdonalds/>> accessed 28 August 2025.
- 3 For an exposition of domain name registration practices from 1994 to 1998, see J Chaisse and D Friedmann, ‘Law of the Digital Domain: Trademarks, Domain Names and the AI Frontier’ (2024) 64 *IDEA The Law Review of the Franklin Pierce Center for IP* 399, 415–416.
- 4 L Dharma and K Januitis, ‘25 Domain Name Statistics and Trends to Know in 2025’ *Hostinger* (26 August 2025) <25 Domain name statistics and trends to know in 2025> accessed 23 September 2025. See also S Catania, ‘Domain Name Industry 2025: Current Landscape and Key Market Data’ *CircleID Magazine* (25 March 2025) <<https://circleid.com/%20posts/domain-industry-2025-current-landscape-and-key-market-data>> accessed 25 August 2025. For up-to-date domain name registration statistics, see the website ‘Domain Name Stat’ <<https://domainnamestat.com/>> accessed 25 September 2025.
- 5 For a history of the DNS, see M Pope and others, ‘The Domain Name System—Past, Present and Future’ (2012) 30 *Communications of the Association for Information Systems* 329–346 <<https://www.unm.edu/~xinluo/papers/CAIS2012.pdf>> accessed 24 August 2025; Berkman Klein Center for Internet and Society, ‘Brief History of the Domain Name System’ (2000) <<https://cyber.harvard.edu/icann/pressingissues2000/briefingbook/dnshistory.html>> [<https://perma.cc/8L9T-LWAN>] accessed 15 September 2025; see also ICANN, ‘The History of ICANN, ICANN History Project’ (ICANN History Project, 24 August 2025) <<https://www.icann.org/history>> accessed 24 August 2025.
- 6 See the writings of John Perry Barlow proclaiming that traditional governments have no jurisdiction over ‘cyberspace’ whilst also claiming the independence of ‘cyberspace’, for example, JP Barlow, ‘The Economy of Ideas: A Framework for Rethinking Patents and Copyrights in the Digital Age’ *WIRED* (3 March 1994) reprint <<https://groups.csail.mit.edu/mac/classes/6.805/articles/int-prop/barlow-economy-of-ideas.html>> accessed 14 September 2025; JP Barlow, ‘A Declaration of the Independence of Cyberspace’ (2019) 18 *Duke Law and Technology Review* 5 (Reprinted from JP Barlow, ‘A Declaration of the Independence of Cyberspace’ *Electronic Frontier Foundation* (8 February 1996) <<https://scholarship.law.duke.edu/cgi/viewcontent.cgi?article=1337&context=dltr>>

‘free space’, or what came to be known as ‘cyberspace’, inevitably collided⁷ with the ‘real space’ reality of regulation and law, and in the context of this article specifically, traditional trade mark law. The problem of ‘cybersquatting’, which involved the registration of domain names reflecting protected trade marks, made it necessary to develop an appropriate and effective remedy to safeguard trade mark holders against cybersquatting.⁸ The novel concept of domain name dispute resolution was devised through the World Intellectual Property Organization (WIPO) Domain Name Processes during the late 1990s⁹ and ultimately resulted in the adoption of the Uniform Dispute Resolution Policy (UDRP) by the Internet Corporation for Assigned Names and Numbers (ICANN) on 24 October 1999.¹⁰ ICANN is the international multistakeholder organisation tasked with the responsibility of ensuring the stability and management of the international DNS.¹¹

The year 2025 sees the historic twenty-fifth anniversary of the UDRP, which has contributed significantly to the international enforcement of trade mark rights as the fundamental instrument enabling the fair and effective international resolution of domain name disputes.¹² The twenty-fifth anniversary coincides with the release of the

accessed 14 September 2025; see also D Bernstein, ‘The Levin Lecture’ (21 July 2025) <https://www.youtube.com/watch?v=TN_ATdFStDY> accessed 15 September 2025; WIPO-ICA, ‘Initial Report of the WIPO-ICA UDRP Review Project Team Webinar’ (28 May 2025) <<https://www.youtube.com/watch?v=lsJt81ryzrA>> accessed 25 August 2025.

- 7 J Litman has characterised the emergence of the UDRP as a collision of trade mark law and culture with the DNS; see J Litman, ‘The DNS Wars: Trademarks and the Internet Domain Name System’ (2000) 4 *Journal of Small and Emerging Business Law* 149, 152.
- 8 See WIPO, ‘The Management of Internet Names and Addresses—Final Report of the WIPO Internet Domain Name Process’ (WIPO Final Report) WIPO Publication No 439 (30 April 1999) <<https://www.wipo.int/amc/en/processes/process1/report/index.html>> accessed 14 September 2025. The WIPO Final Report states at para 170 that, in lay person’s language, ‘cybersquatting’ is ‘the term most frequently used to describe the deliberate, bad faith and abusive registration of a domain name in violation of rights in trademarks or service marks.’
- 9 WIPO, ‘Internet Domain Name Processes’ <<https://www.wipo.int/amc/en/processes/>> accessed 14 September 2025.
- 10 ICANN, ‘Uniform Dispute Resolution Policy’ <<https://www.icann.org/resources/pages/policy-2024-02-21-en>> accessed 14 September 2025; see also ICANN, ‘Timeline for the Formulation and Implementation of the Uniform Domain Name Dispute Resolution Policy’ <<https://www.icann.org/en/contracted-parties/consensus-policies/uniform-domain-name-dispute-resolution-policy/timeline-for-the-formulation-and-implementation-of-the-uniform-domain-name-dispute-resolution-policy-25-02-2012-en>> accessed 14 September 2025.
- 11 For ICANN’s ‘mission, commitments and core values’, see ICANN, ‘Bylaws for the Internet Corporation for Assigned Names and Numbers’ Art 1, s 1 <<https://www.icann.org/en/governance/bylaws#article1>> accessed 14 September 2024; see also the ICANN website for detailed information regarding ICANN <<https://www.icann.org/>> accessed 14 September 2025; ICANN, ‘ICANN for Beginners’ <<https://www.icann.org/en/beginners>> accessed 14 September 2025.
- 12 The WIPO Arbitration and Mediation Center, as custodian of the UDRP, hosted an event celebrating twenty-five years of the UDRP, WIPO, ‘WIPO Conference—25th UDRP Anniversary: Commemorating 25 Years of Protecting Brands and Consumers Online: A Retrospective and Look Ahead’ (23 April 2025, Geneva, Switzerland) <<https://www.wipo.int/amc/en/events/workshops/2025/domainname>> accessed 14 September 2025; T Little, ‘WIPO Celebrates 25 Years

pathfinding ‘Initial Report of the WIPO/ICA UDRP Review Project Team’ (WIPO-ICA Initial Report) resulting from the WIPO-ICA UDRP Review Process, which is the first fundamental review process of the UDRP undertaken in twenty-five years.¹³ The WIPO-ICA UDRP Review Process was initiated to inform a policy review process for an independent expert group to review the UDRP to maintain it as an efficient and predictable out-of-court dispute resolution mechanism for true trade mark-based disputes, and which would inform and provide much-needed impetus to the ICANN Phase 2 Review of the UDRP.¹⁴

The aim of this article is to provide an overview of the UDRP as both an enabler of justice and a unique stand-alone form of justice that has provided a concrete solution to the global challenge of cybersquatting during the past twenty-five years. For the purposes of this article, justice is understood in a functional sense, namely as the structured and effective enforcement of trade mark rights through accessible dispute resolution mechanisms. It does so by examining the jurisprudential evolution of the UDRP through selected and notable aspects of the current WIPO-ICA UDRP Review Process, with a view to possible policy refinement and a comparison of the historical influence of the UDRP on South African domain name dispute resolution with the issues addressed in the WIPO-ICA Initial Report.

ICANN Review of All Rights Protection Mechanisms in All Generic Top-Level Domains Policy Development Process: Phase 1 and Phase 2

Introduction

ICANN community and stakeholder feedback that expressed the need to review the application and scope of all the ICANN Rights Protection Mechanisms (RPMs) that had not been reviewed for a period of four years is cited by the ICANN Board as the primary motivation for initiating a Policy Development Process (PDP) in 2016 to review all of

of the UDRP’ World Trademark Review (28 April) <<https://www.worldtrademarkreview.com/article/wipo-celebrates-25-years-of-the-udrp>> accessed 14 September 2025. The WIPO Arbitration and Mediation Center is one of the ICANN-approved UDRP dispute resolution service providers <<https://www.icann.org/en/contracted-parties/consensus-policies/uniform-domain-name-dispute-resolution-policy/list-of-approved-dispute-resolution-service-providers-25-02-2012-en>> accessed 14 September 2025. The WIPO Arbitration and Mediation Center is the most prolific UDRP dispute resolution service provider and has, since the adoption of the UDRP, resolved 78 409 UDRP cases up to the end of August 2025. For up-to-date WIPO Arbitration and Mediation Center UDRP decision statistics, see WIPO, ‘WIPO Domain Name Dispute Resolution Statistics’ <<https://www.wipo.int/amc/en/domains/statistics/>> accessed 14 September 2025.

13 WIPO/ICA, ‘Initial Report of the WIPO-ICA UDRP Review Project Team’ (17 April 2025) <wipoicareportapril2025.pdf> accessed 25 April 2025; see also WIPO-ICA, ‘Initial Report of the WIPO-ICA UDRP Review Project Team Webinar’ (28 May 2025) <<https://www.youtube.com/watch?v=lsJt8IryzrA>> accessed 25 August 2025.

14 WIPO/ICA Initial Report (n 13) 2.

the rights protection mechanisms in all generic Top Level Domains (gTLDs).¹⁵ The ICANN community and stakeholder feedback expressed the view that such a review was especially needed should there be a further future expansion of the gTLD name space, such as another new gTLD application round.¹⁶ On 18 February 2016, ICANN's Generic Names Supporting Organization (GNSO) Council¹⁷ resolved to initiate a two-phased PDP to review the existing trade mark-related rights protection mechanisms in all gTLDs.¹⁸ The GNSO Council proceeded to approve the Policy Development Process Charter (PDP Charter)¹⁹ on 15 March 2016, which officially initiated the PDP to conduct a review of all the Rights Protection Mechanisms (RPMs) developed for the 'New gTLD Program' that took place in 2012.²⁰ The GNSO Council directed the Policy Development Process Working Group established to review all RPMs to conduct the process in two phases.²¹

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- 15 Approved Board Resolutions/Special Meeting ICANN Board (16 January 2022) <<https://www.icann.org/en/board-activities-and-meetings/materials/approved-board-resolutions-special-meeting-of-the-icann-board-16-01-2022-en>> accessed 8 August 2025.
 - 16 *ibid.* ICANN launched its first New gTLD Program in January 2012; see ICANN, 'History of the New gTLD Program' <<https://www.icann.org/resources/pages/newgtlds-history-2023-04-05-en>> accessed 14 September 2025. See also (n 20) below. The second ICANN New gTLD Program application round is expected to open during April 2026 <<https://newgtldprogram.icann.org/en/application-rounds/round2>> accessed 25 August 2025.
 - 17 The GNSO is considered the most significant ICANN supporting organisation from a trade mark perspective and is tasked with the development, promotion and review of policies relating to gTLDs; see ICANN, 'GNSO' <<https://gnso.icann.org/en>> accessed 8 August 2025. ICANN's agreements with accredited registrars and with gTLD registry operators require compliance with various specifically stated procedures and 'consensus policies' which include the UDRP; see <<https://www.icann.org/en/contracted-parties/consensus-policies>> accessed 21 August 2025.
 - 18 ICANN GNSO Council Resolutions 1999–2019 Resolution 20160218-3 <<https://gnso.icann.org/en/council/resolutions/1999-2019#20160218-3>> accessed 21 August 2025.
 - 19 ICANN, Charter for Proposed PDP to Review All Rights Protection Mechanisms in All gTLDs <https://gnso.icann.org/sites/default/files/filefield_48755/rpm-charter-15mar16-en.pdf> accessed 21 August 2025.
 - 20 ICANN GNSO Council Resolutions 1999–2019 Resolution 201603309-2 <<https://gnso.icann.org/en/council/resolutions/1999-2019#201603309-2>> accessed 21 August 2025. See ICANN, 'History of the New gTLD Program' (n 16). See E Hurter and T Pistorius, 'The New .Africa Top Level Domain: An African Initiative in Ensuring Africa's Rightful Place on the Global Network' (2014) 17 PER 1071–1108; also E Hurter, 'Selected Aspects of Domain Name Dispute Resolution and Rights Protection Within the New .Africa Top-Level Domain and the .za Country Code Top-Level Domain' (2019) Research Papers from the WIPO-WTO Colloquium for Teachers of Intellectual Property Law 2017 (2019) 115–122 for detailed discussions of the rights protection mechanisms that were developed in anticipation of the New gTLD Program application round in 2012. The first New gTLD Program application round, launched in January 2012, resulted in more than 1 240 new gTLDs being delegated into the internet's Root Zone, the pinnacle of the Domain Name System hierarchy. Some of the successful gTLD applications that were added to the 'Root zone' included, for example, .music, .grocery, .rugby, .hotels, .duck, .booking, .games, .shop, .guru, .beer, .smile, .law and also .africa, .joburg, .durban, and .capetown <<https://newgtlds.icann.org/en/program-status>> accessed 22 August 2025.
 - 21 ICANN GNSO Council Resolutions 1999–2019 Resolution 20160309-2 (n 20).

The PDP Charter, initiating the two-phased PDP process to review all the RPMs, reiterates as background that the question of who legally has rights to, or is the legitimate holder, of a domain name registration is often disputed.²² These disputes mostly centre around the fact that legally protected trade marks are registered and used as domain names or versions of domain names and that the UDRP has been the most prominent and longest-serving procedure employed in resolving these contentious domain name disputes.²³ In anticipation of the New gTLD Program of 2012, numerous additional rights protection mechanisms were developed to ‘mitigate potential risks and costs to trade mark rights holders that could arise in the expansion of the gTLD namespace, which included certain safeguards to protect registrants who engage in legitimate uses of domain names.’²⁴ Importantly, the PDP Charter points to the fact that all the RPMs developed by ICANN, including the UDRP, have not been subjected to comprehensive and full review in order mainly to consider whether or not they are individually and collectively still achieving the objectives they were created to achieve.²⁵

Phase 1 of the Policy Development Process: the ‘new’ rights protection mechanisms²⁶

The numerous new RPMs developed to mitigate potential risks for trade mark rights holders and legitimate interest holders associated with the New gTLD Program,²⁷ would form the focus and be the subject matter in Phase 1 of the ICANN Review of All New Rights Protection Mechanisms Policy Development Process (Phase 1 PDP).²⁸ These RPMs include the Uniform Rapid Suspension System (URS),²⁹ the Trademark Clearinghouse (TMCH),³⁰ and the associated availability through the TMCH of the

22 ICANN Charter (n 19) 2.

23 *ibid.*

24 *ibid.*

25 *ibid.*

26 Phase 1 of the ICANN Policy Development Process for the ‘Review of All Rights Protection Mechanisms in All gTLDs’ is not the focus of this article and will not be discussed here in detail.

27 See New gTLD Program (n 16) and (n 20).

28 ICANN Charter (n 19) 2–4.

29 The URS was developed as a rights protection mechanism aimed at complementing the essential function already served by the UDRP, in providing a shorter time-framed, lower cost solution to trademark rights and legitimate interest holders in the most clear-cut cases of infringing domain name registrations. It should be noted that the URS only applies to the ‘new gTLDs’ delegated as part of ICANN’s New gTLD Program application round in 2012, and does not apply to the gTLDs that were in operation before the New gTLD Program application round in 2012, for example the ‘.com’, ‘.net’, or ‘.org’ gTLDs <<https://www.icann.org/en/contracted-parties/registry-operators/services/rights-protection-mechanisms-and-dispute-resolution-procedures/urs>> accessed 21 August 2025.

30 The Trademark Clearinghouse allows trade mark holders to submit valid trade mark right records, such as trade mark registration certificates and other relevant data from multiple international regions, for verification by ICANN-approved trade mark verification agents and service providers. The Trademark Clearinghouse subsequently maintains a database of the verified trade mark records. Should an attempt be made to register a domain name matching a trade mark recorded in the Trademark Clearinghouse database, the domain name registrant attempting the domain name registration will receive a notification displaying the relevant trade mark information. In the event

sunrise periods,³¹ and the Trademark Claims Notification Service,³² as well as the Post-Delegation Dispute Resolution Procedures (PDDRs).³³ Representing the culmination of more than four years of information gathering, data collection, comprehensive research and diligent work, the Phase 1 Initial Report of the Review of All Rights Protection Mechanisms in All gTLDs Policy Development Process ('Phase 1 Initial Report') was published on 18 March 2020,³⁴ and posted for 'public comment' by stakeholders and the ICANN community.³⁵ The PDP Working Group proceeded to

that the potential domain name registrant should proceed with registering the domain name, the Trademark Clearinghouse will send a notice to the trade mark holder with matching records in the Clearinghouse database, informing trade mark rights holders that the domain name has been registered. If the notified party goes ahead and registers the domain name, the Trademark Clearinghouse will send a notice to those trade mark holders with matching records in the Clearinghouse database, informing them that the domain name has been registered <<https://newgtlds.icann.org/en/about/trademark-clearinghouse>> accessed 21 August 2025.

- 31 Trade mark rights holders are allowed an advanced opportunity to register domain names, corresponding to the trade mark rights holder's trade mark rights validated by the Trademark Clearinghouse process, during the 'sunrise periods' before domain names are available for general registration by the public. New gTLD registries are required to offer a sunrise period of at least thirty days during which the 'general registration' of a domain name within a new gTLD is allowed, 1.3 <<https://newgtlds.icann.org/en/about/trademark-clearinghouse/faqs>> accessed 21 August 2025.
- 32 Within the so-called 'Trademark Claims' period, a person attempting to register a domain name that matches a recorded trade mark record in the Trademark Clearinghouse will be notified of the record and will be provided with the relevant trade mark information. Should the person proceed with the registration of the domain name, the Trademark Clearinghouse will notify the recorded trade mark holders informing them that someone has registered the domain name. The Trademark Claims period follows the sunrise period, and runs for at least the first ninety days of an initial operating period of general registration within a new gTLD, 3.4 <<https://newgtlds.icann.org/en/about/trademark-clearinghouse/faqs#processes>> accessed 21 August 2025.
- 33 The Post-Delegation Dispute Resolution Procedures were developed as part of the New gTLD Program 2012 application round to provide parties whose rights or legitimate interests might have been infringed upon by a new gTLD Registry Operator's conduct as an additional recourse avenue for complaints regarding the conduct of the new gTLD Registry Operator. These Post-Delegation Dispute Resolution Procedures are the Trademark Post-Delegation Dispute Resolution Procedure (Trademark PDDRP), the Registry Restriction Dispute Resolution Procedure (RRDRP) and the Public Interest Commitments Dispute Resolution Procedure (PICDRP). The Post-Delegation Dispute Resolution Procedures developed in anticipation of the New gTLD Program application round in 2012 are handled by external ICANN dispute resolution providers, where expert panels determine if a Registry Operator was at fault and would recommend appropriate remedies to ICANN. For more detailed information regarding the Post-Delegation Dispute Resolution Procedures, see <<https://newgtlds.icann.org/en/program-status/pddrp>> accessed 21 August 2025. Also see ICANN Charter (n 19) 2-4.
- 34 ICANN, 'Phase 1 Initial Report of the Review of All Rights Protection Mechanisms in All gTLDs Policy Development Process' (18 March 2020) ICANN <<https://www.icann.org/en/public-comment/proceeding/phase-1-initial-report-of-the-review-of-all-rights-protection-mechanisms-in-all-gtlds-policy-development-process-18-03-2020>> accessed 25 August 2025. See also Chaisse and Friedmann (n 3) 443.
- 35 Public comment is regarded as playing a vital role within the ICANN multi-stakeholder model. The public comment period provides an important mechanism and opportunity for the ICANN community and other stakeholders to have their opinions and recommendations publicly and formally

complete its chartered review of the RPMs developed in anticipation of the 2012 New gTLD Program application round after the public comment period and submitted its Phase 1 Final Report on the Review of All Rights Protection Mechanisms in All gTLDs Policy Development Process (Phase 1 Final Report)³⁶ to the GNSO Council for review and approval in November 2020.³⁷ The GNSO Council voted to approve the thirty-five recommendations made by the PDP Working Group within the Phase 1 Final Report on 21 January 2021,³⁸ after which the GNSO Council submitted its Final GNSO Recommendations Report (Final GNSO Report) to the ICANN Board with its recommendation that the Board adopt the thirty-five recommendations made in the Phase 1 Final Report.³⁹ The ICANN Board approved the Final GNSO Report on 16 January 2022.⁴⁰

Even though the thirty-five recommendations of the Final GNSO Report are not discussed in detail here, because the WIPO/ICA UDRP Review forms the main focus of this article, it should be unequivocally stated that an initial analysis indicates that the Phase 1 PDP had overall made substantial and noteworthy progress in addressing the concerns expressed by the ICANN community and stakeholders by significantly enhancing the ‘new’ RPMs developed for the New gTLD Program application round in 2012 through the recommendations made in the Final GNSO Report as approved by the ICANN Board. Phase 1 of the PDP has achieved several important goals: (a) it determined clearly the current state of the ‘new’ gTLD RPMs developed for the New gTLD Program application in 2012, and whether they effectively achieved the goals for

noted, and to effect changes and improve ICANN policies and operations. See ICANN <<https://www.icann.org/en/public-comment>> accessed 25 August 2025.

- 36 ICANN GNSO, Phase 1 Final Report on the Review of All Rights Protection Mechanisms in All gTLDs Policy Development Process <<https://gns0.icann.org/sites/default/files/file/field-file-attach/rpm-phase-1-proposed-24nov20-en.pdf>> accessed 25 August 2025. See, for additional information, ICANN, ‘GNSO Council Webinar on the RPM PDP WG Final Report’ (11 January 2021) <https://icann.zoom.us/rec/play/B8Bcpn73Tkva3gqsJL4cmH8U7dwLXrgakLTCyZMxTqGsPuFy9IQNhkYGIpXQ53QJF3zfv8SzKDymwJv.VHKOTuN1hNTTi1JJ?startTime=1610398867000&_x_zm_rtaid=ieD00Q8IRwCx0Lk0ClclvQ.1615197482347.a029014174ef3bab6959b42feef5dd&_x_zm_rhtaid=658> accessed 25 August 2025.
- 37 Approved Board Resolutions/Special Meeting (n 15).
- 38 ICANN, GNSO Council Resolutions 2020–Current, Resolution 202101-3 <<https://gns0.icann.org/en/council/resolutions/2020-current#202101-3>> accessed 25 August 2025.
- 39 ICANN, GNSO Council Recommendations Report to the ICANN Board—Regarding Adoption of the Phase 1 Final Recommendations from the Review of All Rights Protection Mechanisms in All gTLDs Policy Development Process <<https://gns0.icann.org/sites/default/files/file/field-file-attach/council-recommendations-rpm-pdp-phase-1-report-10feb21-en.pdf>> accessed 25 August 2025.
- 40 ICANN, Approved Board Resolutions/Special Meeting (n 15). The approved recommendations were also posted for public comment in compliance with Art 3, s 6(a)(iii) of the ICANN Bylaws, to inform Board action on the final recommendations; ICANN, GNSO Review of All Rights Protection Mechanisms in All gTLDs Policy Development Process Phase 1 Final Recommendations for ICANN Board Consideration (7 April 2025) <<https://www.icann.org/en/public-comment/proceeding/gns0-review-of-all-rights-protection-mechanisms-in-all-gtlds-policy-development-process-phase-1-final-recommendations-for-icann-board-consideration-07-04-2021>> accessed 25 August 2025.

which they were developed; (b) it provided for a proper evaluation of the new RPMs which importantly included not only the impact of the RPMs on trade mark protection, but also on access to information and freedom of expression; (c) it investigated possible improvements to the RPMs that could enhance their effectiveness and made recommendations to this effect; (d) it provided a detailed potential cost and benefit analysis if the recommended changes were to be made to the RPMs; and, finally, it diligently and thoroughly engaged and consulted with the ICANN community and other stakeholders to ensure the recommended changes reflected the feedback regarding the needs and concerns of the ICANN community and external stakeholders.⁴¹

The expectation, as succinctly expressed by the ICANN Governmental Advisory Committee (GAC),⁴² that the Phase 1 PDP was meant to determine whether the RPMs reviewed during the Phase 1 PDP should continue for future rounds of new gTLDs and, if so, which possible ‘changes, improvements, and/or enhancements need to be made to fulfil the intended objectives of these RPMs’, namely, ‘to provide trademark holders with either preventive or curative protections against cybersquatting and other abusive uses of their legally-recognized trademarks,’⁴³ seems to have been satisfactorily met.

Background to the WIPO-ICA Uniform Dispute Resolution Policy Review Process

Introduction

A review of the UDRP considered by the ICANN GNSO as early as 2011 was put on the back burner because of the development at the time of the New Rights Protection Mechanisms in line with ICANN’s first New gTLD Application Round in 2012.⁴⁴ The

41 Chaisse and Friedmann (n 3) 443.

42 The ICANN Governmental Advisory Committee is an ICANN advisory committee to the ICANN Board, and was established to consider and provide advice on ICANN activities and policies that relate to the concerns of national governments, specifically matters where there could possibly be an intersection between ICANN activities and policies, and various laws and international agreements or where ICANN activities or policies could possibly affect public policy issues. See ICANN ‘Government Advisory Committee (GAC)’ <<https://gac.icann.org/>> accessed 14 September 2025.

43 ICANN, GAC ICANN70 Virtual Community Forum, GAC Session 7—Rights Protection Mechanisms (16 March 2021) <https://gac.icann.org/briefing-materials/public/icann70-gac-briefing-7-rights-protection-mechanisms-v2-en.pdf?language_id=1> accessed 25 August 2025.

44 ICANN GNSO Final Issue Report on the Policy Development Process to Review All Rights Protection Mechanisms in All Generic Top Level Domains (11 January 2016) 4 <https://gns0.icann.org/sites/default/files/filefield_48411/rpm-final-issue-11jan16-en.pdf> accessed 14 August 2025, referring to ICANN GNSO Council Resolution 201112 of 2011 <<http://gns0.icann.org/en/council/resolutions#201112>> accessed 14 August 2025; see also ICANN, GAC Letter to GNSO Council Regarding UDRP PDP Issues Report (14 September 2011) in which the GAC stated: ‘While the GAC is not opposed in principle to a review of the UDRP at an appropriate time, the GAC considers that a review at this time would not be appropriate.’ <https://gns0.icann.org/sites/default/files/filefield_26633/dryden-to-van-gelder-udrp-14sep11-en.pdf> accessed 25 August 2025.

subsequent Phase 2 Review of the ICANN Review of All New Rights Protection Mechanisms Policy Development Process (Phase 2 PDP), which is yet to be undertaken,⁴⁵ and which will almost certainly be a far more flawed and fragmented process, involves a future review of the UDRP by ICANN. ICANN's policy review processes are notoriously slow-paced, time-consuming and often ineffective due largely to ICANN's multistakeholder model of governance⁴⁶ and involved consultation, policy development⁴⁷ and decision-making processes.⁴⁸

In April 2025, WIPO and the Internet Commerce Association (ICA)⁴⁹ published their Initial Report.⁵⁰ The executive summary of the WIPO/ICA Initial Report states that the purpose of the Review Project is aimed at assisting ICANN in finding a more 'efficient, focused, and practical way forward by providing crucial background information that can help direct the Phase 2 PDP.'⁵¹ The executive summary of the WIPO/ICA Initial Report continues that it is hoped that, by providing this crucial information garnered through extensive consultation and deliberation from experts with hands-on experience with the UDRP, ICANN will be able to:

- (a) Commence a Phase 2 Review with a clear sense of what may reasonably be accomplished and thereby better direct the review (both in terms of scope and duration) and ICANN's resources;

45 ICANN GNSO Council Resolutions 1999–2019 Resolution 20160309-2 (n 20).

46 'ICANN follows a multistakeholder model in which governments, businesses, the technical community, academia, civil society and end users play important roles in its community-based, consensus-driven, policy development approach for issues relevant to the global coordination of the Domain Name System (DNS).' See ICANN, *The Multistakeholder Model of Internet Governance* <<https://itp.cdn.icann.org/en/files/government-engagement/ge/multistakeholder-model-internet-governance-fact-sheet-05-09-2024-en.pdf>> accessed 14 September 2025; see also D Lindsay, 'What do the .XXX Disputes Tell Us About Internet Governance? ICANN's Legitimacy Deficit in Context' (2013) 63 *Telecommunications Journal of Australia* 33.1–33.15; see also K Kleiman, 'Crash Goes ICANN's Multistakeholder Model' (2020) 11 *American University Intellectual Property Brief* 1–18 for detailed discussions regarding ICANN's multistakeholder model.

47 See ICANN, 'Developing Policy at ICANN' <<https://www.icann.org/policy>> accessed 25 August 2025.

48 ICANN, 'Process Documentation' <<https://www.icann.org/processdocumentation/>> accessed 14 September 2025.

49 The ICA is an organisation that is aimed at promoting and disseminating best practice information and resources among participants in the domain name environment and that informs policy makers, law makers, the media and consumers regarding the various aspects relevant to the value and benefits of the domain name industry. One of the main focus areas of the ICA is fair practice within the domain name industry, which includes the fair and balanced application of the UDRP for all stakeholders within the domain name industry <<https://www.internetcommerce.org/>> accessed 2 September 2025.

50 WIPO/ICA Initial Report (n 13). See also L Newstead, 'WIPO and ICA Share Initial Recommendations for UDRP Review' *World Trademark Review* (22 April 2025) <<https://www.worldtrademarkreview.com/article/wipo-and-ica-share-initial-recommendations-udrp-review>> accessed 15 August 2025.

51 WIPO/ICA Initial Report (n 13) 2.

- (b) Charter the Phase 2 Review in a manner which prioritizes areas where consensus appears likely;
- (c) Appropriately manage and direct certain topics for which consensus may require specific additional work (eg, a dedicated work stream); and
- (d) Consider leaving topics which appear very unlikely to reach consensus out of the Phase 2 Review ICANN work charter and/or defer them to a specialized track.

We believe that this Project affords ICANN with a unique opportunity to make the Phase 2 Review as efficient and productive as possible by focusing on the achievable, as identified collectively by a generally representative group of experts with hands-on UDRP experience. We further believe that by appropriately harnessing the information and recommendations in this Draft Report, ICANN can confidently embark on a focused Phase 2 Review that achieves positive results with substantially less effort than would otherwise have to be expended by many stakeholders over many years.⁵²

The WIPO-ICA UDRP Review is therefore aimed at providing much-needed impetus to what would most certainly be a challenging and most ambitious review of the UDRP, ICANN's first 'Consensus Policy'.⁵³ The UDRP has not only been in operation since 1999, therefore for more than twenty-five years, but has been applied for the resolution of which in August 2025 were over 126 000 domain name dispute resolution cases,⁵⁴ and which to this day is used by trade mark holders from around the globe to curb the abusive ills of 'cybersquatting'⁵⁵ and 'reverse domain name hijacking'.⁵⁶ The WIPO-

52 *ibid.*

53 ICANN, 'Consensus Policies' <<https://www.icann.org/en/contracted-parties/consensus-policies>> accessed 14 September 2025.

54 WIPO/ICA Initial Report (n 13) 2. More than seven hundred cases have been dismissed in favour of registrants. The first case resolved in terms of UDRP by the WIPO Arbitration and Mediation Center in which the domain name at issue, *worldwrestlingfederation.com*, was *World Wrestling Federation Entertainment Inc v Bosman* WIPO Case No D99-0001 (14 January 2000) <<https://perma.cc/WR95-4XAN>> accessed 25 August 2025. This first 'decision' that encapsulates the by now enshrined terminology employed in UDRP decision making reads: '[T]he Panel decides that the domain name registered by the respondent is identical or confusingly similar to the trademark and service mark in which the complainant has rights, and that the respondent has no rights or legitimate interests in respect of the domain name, and that the respondent's domain name has been registered and is being used in bad faith. Accordingly, pursuant to Paragraph 4(i) of the Policy, the Panel requires that the registration of the domain name <*worldwrestlingfederation.com*> be transferred to the complainant.'

55 See 'WIPO Final Report' (n 8) for a layperson's definition of 'cybersquatting.'

56 In terms of the ICANN, 'UDRP Rules for the Uniform Domain Name Dispute Resolution Policy' (UDRP Rules), 'Reverse Domain Name Hijacking' means 'using the Policy in bad faith to attempt to deprive a registered domain-name holder of a domain name' <<https://www.icann.org/en/contracted-parties/consensus-policies/uniform-domain-name-dispute-resolution-policy/rules-for-uniform-domain-name-dispute-resolution-policy-the-rules-11-03-2015-en>> accessed 14 September 2025. The UDRP Rules are applied by all accredited UDRP dispute resolution service providers, supplemented by each service provider's supplemental rules. Also see RDNH.com for updated information and UDRP case information and statistics on reverse domain name hijacking <<https://www.rdnh.com/rdnh-provision-udrp/>> accessed 14 September 2025. More than 600 findings

ICA UDRP Review is a timely and needed arrow in ICANN’s bow when the proclaimed and much-anticipated Phase 2 PDP commences. The ICANN Bylaws specifically provide in section 13.1 for the ICANN Board and ICANN’s other constituent bodies to seek external expert advice residing in the private and/or public sectors that do not formally form part of ICANN, and to take advantage of the external expertise for its policy development processes.⁵⁷ The ICANN GAC, in its ICANN GAC Hague Communiqué of 20 June 2022, specifically notes reference to section 13.1 of the ICANN Bylaws in the update it received on the status of a planned Phase 2 PDP and specifically mentions WIPO as ‘author and steward’ of the UDRP, as a body with existing expertise from which advice should be sought in informing the Phase 2 PDP.⁵⁸

The WIPO/ICA UDRP Review Project Methodology, Project Team Composition and Overarching Guiding Principles

In anticipation of Phase 2 of the ICANN PDP, it was believed that on drawing on WIPO’s knowledge and experience as originator of the UDRP through the WIPO Domain Name Processes,⁵⁹ and drawing on the ICA expertise on the policy could assist ICANN and other DNS stakeholders by producing a report to guide the Phase 2 PDP processes that may unfold.⁶⁰ The approach to be undertaken would, in essence, be to identify ‘high consensus’ issues that may be more amenable to substantive policy or practice amendment while simultaneously identifying potentially low or no consensus-based issues that would appear to be less likely, or unlikely, to lead to consensus policy amendment and would therefore require further interrogation. The WIPO-ICA Initial Report was therefore aimed at the future Phase 2 PDP to benefit from the enhanced focus and efficiency brought about by the WIPO/ICA Initial Report in identifying the possible consensus-based and non-consensus-based issues of stakeholder agreement and disagreement.⁶¹ It is believed that by effectively and proactively drawing from the information and recommendations in the WIPO/ICA Initial Report, ICANN could more

of Reverse Domain Name Hijacking have been made against complainants in UDRP cases up to August 2025; see E Hurter, ‘Not the Lesser Evil: Amending the Regulations for the Resolution of Domain Name Disputes in the ‘.za’ Domain to Combat Reverse Domain Name Hijacking’ (2012) 24 SA Merc LJ 417–418. See also C Schultz and C Hofflander, ‘Reverse Domain Name Hijacking and the Uniform Domain Name Dispute Resolution Policy: Systematic Weaknesses, Strategies for the Respondent, and Proposed Policy Reforms’ (2013) 4(2) ‘Cybaris®’ 218–249 <<https://open.mitchellhamline.edu/cgi/viewcontent.cgi?article=1018&context=cybaris>> accessed 6 September 2025.

57 ICANN, ‘Bylaws for the Internet Corporation for Assigned Names and Numbers’ s 13.1 <<https://www.icann.org/en/governance/bylaws#article13>> accessed 25 August 2025; WIPO-ICA Initial Report (n 13) 4.

58 ICANN GAC, ‘Hague Communiqué’ (20 June 2022) 8 <<https://gac.icann.org/advice/communiques/ICANN74%20The%20Hague%20Communique.pdf>> accessed 21 August 2025.

59 WIPO, ‘Internet Domain Name Processes’ (n 9).

60 WIPO-ICA Initial Report (n 13) 4.

61 *ibid.*

confidently embark on a focused Phase 2 PDP benefitting the entire ICANN community.⁶²

The small WIPO-ICA UDRP Review Project Team, together with additional invited experts, produced the WIPO-ICA Initial Report. It included, among others, previous ICANN Board members; UDRP dispute counsel; UDRP panellists; domain name registrants; brand owner representatives; academic scholars; domain name registrar representatives; non-commercial user representatives; UDRP service providers; brand enforcement representatives; and trade mark attorneys.⁶³ Although the project team was not an open-call group of individuals, it is clear from the composition of the team and the additionally invited subject matter experts that significant efforts were made to include representatives relevant to the entire UDRP process, covering both domain name industry and trade mark holder realities, as well as other representatives of the diverse group of overall participants and stakeholders within the domain name industry.⁶⁴ The process was conducted entirely independently of ICANN, as the Initial Project Team members were not active in formal ICANN circles, ensuring the WIPO-ICA UDRP Review would not hinder or overstep the formal Phase 2 PDP processes.⁶⁵

The overarching principles guiding the WIPO-ICA UDRP Review reflect the project team's recognition that, although divergent views may exist on certain limited issues and individual cases, the overall trade mark-based framework and its procedural rules⁶⁶ have functioned well and effectively for twenty-five years, and that, therefore, there currently is 'no pressing need or desire to undertake a wholesale revision' of the UDRP framework.⁶⁷

The WIPO/ICA Initial Report recognises and reiterates that the overarching principles that guided the WIPO-ICA UDRP Review may be summarised as follows: (a) that the UDRP has shown itself to be an effective and fit-for-purpose remedy for the resolution of clear cybersquatting-related disputes and that any perceived shortcomings of the UDRP do not currently necessitate an overall reworking or redrafting of the UDRP; (b) that it is of the utmost importance that the instances of consensus derived from twenty-five years of application and case law precedent regarding the interpretation and application of the UDRP, be identified and maintained, barring overwhelming support for amendment which does not in any manner destabilise the consensus support, and the UDRP itself, in order for the UDRP to continue to be employed to fairly, effectively and predictably resolve domain name disputes; (c) that the current WIPO-ICA UDRP Review initiative should not be unfurled for the UDRP to be reframed or amended beyond its originally intended and currently entrenched trade mark-centred

62 *ibid.*

63 WIPO-ICA Initial Report (n 13) 4–5.

64 *ibid.*

65 *ibid.*

66 UDRP Rules (n 56).

67 WIPO-ICA Initial Report (n 13) 5.

framework.⁶⁸ It is clear that the project team is mindful not to unnecessarily disturb the critical role of the UDRP in maintaining the delicate balance relied upon by trade mark holders, other rights and legitimate interest holders and DNS stakeholders generally. This balance currently characterises UDRP application and practice. At the same time, the team recognises that it must not avoid the very purpose of the anticipated Phase 2 PDP, namely, to explore possible and recommended improvements that twenty-five years of UDRP precedent and experience may suggest would be valuable.⁶⁹

Selected UDRP Issues Addressed by the WIPO/ICA Initial Report of UDRP Review and How the South African Domain Name Dispute Resolution Regulations or the .za Domain Compares

Introduction

The topics for consideration in the WIPO/ICA Initial Report were identified through a process of consultation, deliberation and, importantly, scrutiny of foregoing processes, documentation and discussions within ICANN, and the broader domain name community regarding potentially earmarked amendments to the UDRP.⁷⁰ The Project Team members were also requested to freely suggest further topics for potential consideration.⁷¹ They ultimately identified twenty-three topics that may assist ICANN in its future ‘Chartered’ Phase 2 PDP.⁷² The topics include: loser pays, costs and damages; fee payment deadlines; reviewing and reinforcing ICANN’s role in compliance; providing UDRP-related information for registrars; regulating complaint withdrawals; clarifying registrar verification procedures; identifying dissenting panellists; ICANN’s contribution to the UDRP; provision of educational materials to complainants and respondents; mediation; laches/statute of limitations; scope of UDRP; name redaction; whether registrars are to provide additional notice; the possibility of an appeals layer; changing ‘and’ to ‘or’ in paragraph 4(a)(iii) of the UDRP; whether supplemental filings should be allowed; the possibility of introducing expedited or summary procedures; introducing the remedy of ‘true cancellation’; issues regarding panellist appointment, accreditation and quality; the codification of case law; addressing issues of free speech; and, lastly the format of decisions.⁷³

These twenty-three topics were split into two ‘tiers’ in the WIPO-ICA Initial Report.⁷⁴ The topics discussed under Tier 1 represent the considered topics over which the Project Team reached ‘unanimous agreement’ and, therefore, represent the topics that should

68 WIPO-ICA Initial Report (n 13) 7–8.

69 *ibid* 7. See also ‘WIPO-ICA Initial Report of the WIPO-ICA UDRP Review Project Team Webinar’ (n 13).

70 WIPO-ICA Initial Report (n 13) 6.

71 WIPO-ICA Webinar (n 13).

72 WIPO-ICA Initial Report (n 13).

73 *ibid* 6.

74 *ibid*.

be included in the ICANN Phase 2 PDP, because consensus is likely to be reached regarding these topics during the ICANN Phase 2 PDP.⁷⁵ As opposed to the Tier 1 topics, the remaining topics discussed under Tier 2 represent the topics on which unanimous agreement could not be reached, and for which consensus will need to be sought through targeted ‘secondary work’ and focused processes during ICANN’s Phase 2 PDP.⁷⁶

Discussions in this article will be limited to selected topics regarded as relevant to the most critical substantive and procedural aspects of the UDRP Review covered in the WIPO-ICA Initial Report. Where appropriate, its recommendations will be compared with the current domain name dispute resolution regulations and practice applicable to the .za country code Top Level Domain (ccTLD).⁷⁷

Selected ‘Tier 1’ Topics of Recommendations Made in the Initial Report of the WIPO/ICA UDRP Review Project Team—‘Unanimous Agreement’

The WIPO-ICA Initial Report indicates that the Project Review Team reached ‘unanimous agreement’ on fourteen of the twenty-three recommendations.⁷⁸ The majority of these dealt with administrative matters regarding ICANN’s role in the UDRP process or financial and procedural issues, which will not be addressed here. Three of the fourteen unanimously agreed recommendations are relevant to the focus and context of this article.

First, in response to the question of whether a mandatory mediation process should be included in the UDRP process, the ‘unanimous agreement’ recommendation made in the WIPO-ICA Initial Report is that a mandatory mediation procedure should not be adopted.⁷⁹ There were concerns that a mandatory mediation process could increase costs

75 *ibid* 8.

76 *ibid* 17.

77 The South African government, through the Minister of Communications (at the time) and in consultation with the Minister of Trade and Industry, was mandated under section 69(1) of the South African Electronic Communications and Transactions Act 25 of 2002 (ECT Act) to make regulations for an ‘alternative mechanism for the resolution of disputes in respect of the ‘.za’ domain name space’. The final South African Regulations for the resolution of domain name disputes in the ‘.za’ domain were promulgated in November 2006; see GN R1166 (November 2006) GG 29405 [as amended by GN 1246 (10 November 2017) GG 41237]. See the South African Regulations at <<https://drive.google.com/file/d/18fNI7dS5EZG3H88wKH56zdJdN2yTQ1GA/view> accessed 6 September 2025>. The Regulations are largely similar to the Nominet ‘Dispute Resolution Service Policy’ used for domain name dispute resolution in the .uk domain, <<https://media.nominet.uk/wp-content/uploads/2017/10/17150434/final-proposed-DRS-policy.pdf>> accessed 6 September 2025. For a discussion of the early history of the ‘.za’ domain see, T Pistorius, ‘.za Alternative Dispute Resolution Regulations: The First Few SAIPL Decisions’ (2008) 2 *Journal of Information, Law and Technology* 1.

78 WIPO-ICA Initial Report (n 13) 8–17.

79 *ibid* 13.

and delays in the UDRP process without corresponding benefit, since few parties were interested in participating in an additional layer of participation.⁸⁰

Since the 2017 amendments, the South African Regulations provide for an informal mediation process conducted by the .za Domain Name Authority (ZADNA)⁸¹ if the registrant submits a reply to a complaint.⁸² Referral of opposed domain name disputes to ZADNA for the informal mediation process has, since the inception of the process in 2017, occurred on only twenty-nine occasions.⁸³ Two of these opposed domain name complaints filed in terms of the Regulations were settled by way of the informal mediation process, while the remaining twenty-seven proceeded to adjudication.⁸⁴ These numbers seem to indicate that, surprisingly, there is little interest in an informal mediation process in the .za domain name dispute resolution context.

Second, the WIPO-ICA Initial Report addresses ‘Laches/Statute of Limitations’—two distinct legal concepts—together, as they carry conceptually similar significance in the context of domain name dispute resolution.⁸⁵ Even though the Initial Report Project Team recognised delay as a factor for UDRP panellists to consider, it unanimously concluded that if ‘laches’ were adopted as a formal defence under the UDRP, it was unlikely to have any meaningful effect considering the rarity of the circumstances that would cause ‘lashes’ to be a relevant defence, and that it could be adequately addressed by codifying the existing case law principles.⁸⁶

In South African law, these legal constructs may be described as either prescription or estoppel.⁸⁷ The South African Regulations reflect the same sentiment and contain no provisions that deal with either prescription or estoppel as a defence to a complaint filed in terms of the Regulations. Adjudicators should, however, ideally consider an element of delay as part of the overall circumstances of the dispute in reaching their decisions.

Third, the issue was addressed of whether the scope of the UDRP should be expanded to include a broader range of rights and, therefore, additional types of disputes, such as those involving copyright, geographical indications or domain name disputes where

80 *ibid.*

81 Section 59 of the Electronic Communications and Transactions Act 25 of 2002 (ECT Act) established a juristic person known as the ZADNA as the legitimate custodian of the ‘.za’ domain. See <<https://www.zadna.org.za/>> accessed 14 September 2025.

82 South African Regulations (n 77). Reg 19A inserted by GN 1246 (10 November 2017) GG 41237. Reg 19(A)(1) states that ‘[i]nformal mediation will be conducted in a manner which the Authority, in their sole discretion, considers appropriate. No informal mediation will occur if the Registrant does not file a response.’

83 N Dundas and T Mulaudzi, ‘Domain Name ADR Statistics 2007–June 2025’ DNS.Business (4 June 2025).

84 *ibid.*

85 WIPO-ICA Initial Report (n 13) 13.

86 WIPO-ICA Initial Report (n 13) 14.

87 In short, ‘[e]stoppel protects the reliance by a party on the existence of a state of affairs induced by another’; see G Lubbe, ‘Estoppel: South Africa’ (2006) 14 *European Review of Private Law* 747.

there is no trade mark right corresponding to the domain name in dispute.⁸⁸ While the Initial Report Project Team acknowledged that the overall success of the UDRP could serve as a clear motivation to expand its application beyond its originally intended trade mark-based domain name dispute resolution context, there was unanimous agreement that any consideration of expanding the scope should be avoided so as not to potentially add to the already cumbersome, fragile and complex future ICANN Phase 2 PDP.⁸⁹

The South African Regulations provide for a substantially more expansive definition of ‘rights’ that may form the basis for submitting a domain name complaint in terms of the Regulations, although the context of applicable ‘rights’ remains limited to the rights in ‘names and marks’. Regulation 3(1)(a), unlike the UDRP, makes the dispute resolution procedure available to a myriad of ‘rights’ holders in respect of a name or mark and not just trade mark or service mark holders.⁹⁰ The term ‘rights’ is defined extensively in the Regulations to include ‘intellectual property rights, commercial, cultural, linguistic, religious and personal rights protected under South African law, but is not limited thereto.’⁹¹ The definition of ‘rights’ more accurately reflects the reality of the evolution of the domain name system since the inception of the UDRP, particularly within the restricted context of a ccTLD such as the .za domain, in that not only trade mark or service mark holders should be deemed to have ‘rights’ or legitimate interests in a domain name.⁹² The ‘test’ of proving ‘rights’ in terms of the Regulations has been shown to have a ‘low threshold’⁹³ according to academic writing and authoritative adjudicator decision precedent to also protect complainants with a genuine or proper interest in the domain name.⁹⁴

88 *ibid* 14–15.

89 WIPO-ICA Initial Report (n 13) 15.

90 South African Regulations (n 77), Reg 3(1)(a).

91 South African Regulations (n 77), Reg 1.

92 For a comprehensive discussion of the concept of ‘rights’ from a South African domain name dispute resolution perspective, see E Hurter, ‘An Evaluation of the Concept of ‘Rights’ as applied in domain name dispute resolution adjudications in the ‘.za’ domain: Comments and Suggestions’ (2015) 27 SA Merc LJ 418–440.

93 *ibid* 440; T Pistorius, ‘Cyberbusters Versus Cybersquatters: Round II in the ZADNA Ring’ (2009) 21 SA Merc LJ 661–672.

94 Hurter (n 92) 440; Pistorius (n 93) 627; W Alberts, ‘The New Domain Name Dispute Resolution Structure: The Regulations and the First Decisions Considered’ (2008) 15 *Juta Business LJ* 66 at 69. See *Allstates Global Karate Do Inc dba World Seido Karate Organization v Said Karate* APZA2009-0030 para 7.4 (dissenting) and *Aqua Divers International (Pty) Ltd v Divetek (Pty) Ltd* ZA2008-0016 para 4(a)(iv) as two examples of early decisions reached in terms of the regulations that advocated a less restrictive threshold interpretation of the concept of rights for purposes of the Regulations. The SAIPL domain name dispute resolution decisions are available at <<https://www.domaindisputes.co.za/cases>> accessed 21 September 2025.

Selected ‘Tier 2’ Topics of Recommendations Made in the Initial Report of the WIPO/ICA UDRP Review Project Team—‘No Unanimity—But Consensus Potentially Achievable’

Four recommendations from the remaining nine made, originating from the twenty-three topics covered in the WIPO-ICA Initial Report, about which the Initial Report Project Team could not reach unanimity, but where consensus is potentially achievable during the ICANN Phase 2 PDP, were selected as being relevant to the aim of this article.

Addition of an Appeals Layer to the UDRP

The question of whether an appeals layer should have been added to the UDRP has, since its inception, been raised by numerous UDRP stakeholder groups and is a question that persists.⁹⁵ The WIPO-ICA Initial Report states that an appeals layer has primarily been considered a possible means of:

(a) providing recourse to parties whose national courts may not provide a cause of action following a UDRP case; (b) providing a means of allowing the parties to challenge what they believe may be an incorrect decision while also saving significant time and cost in comparison to courts (where available), in particular where the parties may come from different jurisdictions thus requiring use of foreign counsel; and (c) further enhancing the stability and predictability of the UDRP system as a jurisprudential system driven by consensus, in a more structured way.⁹⁶

It seems from the WIPO-ICA Initial Report that an additional appeals layer to be added to the UDRP was in principle unanimously supported by the Initial Report Project Team, but that the precise workings and integration details of how an appeals layer would operate and be implemented presented a variety of diverse opinions.⁹⁷

The Initial Report Project Team openly expressed their disappointment in being unable to reach a consensus opinion on the addition of an appeals layer, which on the whole, seems to be a preferred and workable addition to the UDRP, because of the complex procedural issues that needed to be unravelled.⁹⁸ The WIPO-ICA Initial Report consequently recommended that the addition of an appeals layer should be investigated in a ‘Secondary Track’ during the ICANN Phase 2 PDP, wherein the UDRP stakeholder groups, ICANN community or a selected UDRP specialist group may consider and deliberate the finer workings and procedural intricacies regarding the possible addition of an appeals layer within the UDRP.⁹⁹

95 WIPO-ICA Initial Report (n 13) 17. S Donahey, ‘Divergence in the UDRP and the Need for Appellate Review’ (2002) 5 *Journal of Internet Law* 10.

96 WIPO-ICA Initial Report (n 13) 17.

97 *ibid.*

98 WIPO-ICA Webinar (n 13).

99 WIPO-ICA Initial Report (n 13) 19–20.

The Regulations, as opposed to the UDRP, do provide either of the parties to a dispute with the right to appeal a decision of the original adjudicator.¹⁰⁰ The overall quality of reasoning and thought-provoking discourse by the senior adjudicators serving as part of the three-member appeal panels, though occasionally reaching dissenting decisions, from the outset greatly contributed to steering through uncertain territory during the early years of the implementation of the Regulations and continues to provide insightful direction in the ever-evolving South African domain name dispute resolution landscape. Even though only fifteen of the 434 decisions reached in terms of the Regulations from the inception of the system to June 2025 have to date been appealed, representing 3.5 per cent of decisions reached,¹⁰¹ the appeals process has played a critical role in shaping the South African domain name dispute resolution system to its current high standard of domain name dispute resolution jurisprudence and quality in decision making.

Changing the ‘and’ in Paragraph 4(a)(iii) of the UDRP to ‘or’

Paragraph 4(a)(iii) of the UDRP stipulates cumulative requirements for a finding of ‘bad faith’ in terms of the UDRP in that the domain name must have ‘been registered and is being used in bad faith’ to succeed under the UDRP.¹⁰² Subsection (iii) of paragraph 4(a) of the UDRP has been the subject of heated debate since the implementation of the UDRP.¹⁰³ The ‘registration’ and ‘use’ of the domain name is mostly intertwined, but cases do exist where the domain name was originally registered in ‘good faith’ (thereby not with the intent at the time of registration to target the trade mark holder in ‘bad faith’), for example, where the complainant had not existed at the time of the registration, but the domain name is then subsequently used in ‘bad faith’.¹⁰⁴ Although also uncommon, cases have existed where the complainant and registrant may have had a professional relationship leading to the domain name being registered by the registrant in ‘good faith’, but thereafter using the domain name in ‘bad faith’ after the relationship had soured.¹⁰⁵

Even after extensive deliberations and consultations, the Initial Report Project Team believed that although changing the ‘and’ to ‘or’ may address some of the uncertainty associated with instances of ‘good faith’ registration by, for example, former employees

100 South African Regulations (n 77) Reg 32.

101 Domain Name ADR Statistics 2007–June 2025 (n 83).

102 UDRP (n 10) para 4(a)(iii).

103 M Froomkin, ‘ICANN’s “Uniform Dispute Resolution Policy”—Causes and (Partial) Cures’ (2002) 67 Brooklyn LR (2002) 605 655; A Kur, ‘UDRP: A Study by the Max Planck Institute for Foreign and International Patent, Copyright and Competition Law’ (Max Planck Institute for Foreign and International Patent, Copyright and Competition Law, Munich 2002) 48.

104 WIPO-ICA Initial Report (n 13) 19.

105 See *Octogen Pharmacal Inc v Domains by Proxy Inc/Rich Sanders and Octogen e-Solutions* WIPO Case No D2009-0786 where the panel decided in favour of *Octogen Pharmacal Inc* (the complainant), where the registrant (respondent) was associated with *Octogen Pharmacal Inc* when the domain name was registered in good faith, but the respondent subsequently used the domain name in bad faith after the association with *Octogen Pharmacal Inc* had been terminated.

or licensees, followed by ‘bad faith’ use, these instances are infrequent enough as to raise the question as to the overall ‘utility of undertaking such a change given the nuanced effort involved.’¹⁰⁶

Admittedly, there are conflicting interests involved, with trade mark holders’ interests being better served if either registration or use in bad faith were sufficient to establish bad faith, whereas the interests of potential registrants may be better served if bad faith could only be found by considering both the bad faith registration and the subsequent bad faith use of the domain name. Strangely though, these conflicting interests seem to be entrenched on such a fundamental level that the Initial Report Project Team was unable to reach consensus on the changing of the ‘and’ to ‘or’ and suggested the ICANN community engage in what would appear to the Project Team to be ‘lengthy and complex deliberations’ in a ‘Secondary Track’ during the ICANN Phase 2 PDP.¹⁰⁷ In the author’s view, ‘bad faith’ in the context of a domain name dispute remains a finding of ‘bad faith’ irrespective of whether bad faith can be found at the registration of the domain name or its subsequent use.

The Regulations (and a significant number of other ccTLDs)¹⁰⁸ avoided the peculiar and troublesome nuances created by the cumulative ‘and’ requirement in the UDRP and simply state in Regulation 3(1)(a) that ‘in the hands of the registrant the domain name is an abusive registration.’¹⁰⁹ Resolving domain name disputes fairly and in a jurisprudentially sound and consistent manner in the limited context and scope of a ccTLD, such as the .za domain, admittedly differs greatly from resolving an international gTLD domain name dispute in terms of the UDRP. By doing away with the conjunctive requirement in the Regulations, the potential interpretational pitfalls regarding the ‘registration’ and/or ‘use’ of the domain name at issue have been minimised.¹¹⁰ The wording of the Regulations in this sense more accurately reflects the realities and current practices within the domain name system, thereby enabling the balancing of the divergent and often opposing interests of both trade mark rights holders and other domain name system role players, such as registrants with legitimate interests or instances where good faith third party use may be possible.

Expedited or Summary Procedures

Trade mark rights holders, which of course would be the most likely complainants in UDRP complaints, have regularly, since the inception of the UDRP, called for an

106 WIPO-ICA Initial Report (n 13) 21.

107 *ibid.*

108 *ibid.* The Nominet ‘Dispute Resolution Service Policy’ (n 77) applicable for the resolution of domain name disputes in .uk domain para 2.1.2 reads: ‘The domain name, in the hands of the respondent, is an abusive registration.’

109 South African Regulations (n 77) Reg 3(1)(a).

110 See E Hurter, ‘An Evaluation of Selected Aspects of the Alternative Dispute Resolution Regulations for the Resolution of Domain Name Disputes in the .za Domain Name Space’ (2007) 19 SA Merc LJ 165–172.

expedited procedural component to be added to the UDRP.¹¹¹ Considering not only the inordinate enforcement burdens trade mark rights holders have generally needed to contend with, but also the more recent escalation in fraud-based UDRP complaints, the Initial Report Project Team were in agreement that adding an expedited procedural component to the UDRP would be useful.¹¹² The Initial Report Project Team considered numerous different possible procedures including (a) a summary/default decision model for cases where no response to a complaint is received, as in the .uk and .za ccTLDs, which allows for expedited and more cost-effective decisions; (b) an expedited and more cost-effective summary/default decision procedure for trade mark rights holders who are repeatedly targeted; (c) temporary suspension of disputed domain names through summary/default type decisions when no response is filed (without appointing a panel), with the suspension lifted, potentially subject to conditions, if a response is filed before the domain registration lapses and the option to appoint a panel if the trade mark rights holder seeks transfer or cancellation of the disputed domain names; and/or (d) the addition of procedures specifically addressing fraud-related disputes when timeliness is critical.¹¹³

The WIPO-ICA Initial Report clearly states that the possible expedited procedures considered above were not necessarily designated as mutually exclusive, and that it could be possible for an expedited procedure or procedures to be sculpted by combining particular characteristics and facets of these possible expedited procedure/s to be incorporated in the UDRP.¹¹⁴ The recommendation made in the WIPO-ICA Initial Report is that it is ‘highly worthwhile’ to further consider an expedited procedure in a ‘Secondary Track’ during the ICANN Phase 2 PDP that deals with particular types of abusive registrations in an expedited manner, while at the time ensuring the rights and legitimate interests of registrants are not infringed, and that reaching consensus on such a procedure seems achievable.¹¹⁵

An expedited ‘Summary Decisions’ procedure was incorporated into the Regulations during the 2017 amendments to the Regulations.¹¹⁶ In terms of Regulation 18(3), the adjudicator must decide the matter based on the dispute contemplated if the registrant

111 WIPO-ICA Initial Report (n 13) 22. The Uniform Rapid Suspension (URS) created for the first New gTLD Programme in 2012 is an example of such an expedited procedure. See n 29 for a description of the URS. The URS, for several reasons—such as its limited remedy of merely suspending the disputed domain name rather than transferring it to the complainant, and the existence of various possible appeal processes—ultimately failed to achieve the objectives of an expedited procedure; WIPO-ICA Initial Report (n 13) 22.

112 WIPO-ICA Initial Report (n 13) 22.

113 *ibid.*

114 *ibid.*

115 WIPO-ICA Initial Report (n 13) 23.

116 GN 1246 (10 November 2017) GG 41237.

does not submit a response and issue a summary decision.¹¹⁷ Regulation 18(4) of the Regulations states:

A summary decision will, however, only be granted by the adjudicator if the following requirements are met –

- (a) that the registrant has been notified of the dispute in accordance with regulation 15(1);
- (b) that the complainant has to the reasonable satisfaction of the adjudicator shown that he or she has rights in a name or mark, which is identical or similar to the domain name and, in the hands of the registrant, the domain name is an abusive registration, or offensive registration; and
- (c) that there are no other factors or circumstances present in the dispute that would unfairly deprive the registrant of the domain name.¹¹⁸

Adjudicators are therefore still required to diligently consider the merits of the dispute before rendering their decisions. Since the introduction of the expedited summary decisions procedure to the Regulations in 2017, summary decisions have dominated the decision type rendered with 170 of the 198 decisions reached being summary decisions as opposed to twenty-eight opposed decisions,¹¹⁹ therefore, representing 86 per cent of the decisions reached in terms of the Regulations from 2017 until June 2025.¹²⁰ Providing well-reasoned and properly motivated decisions should ideally be the norm, where adjudicators consider summary decisions not only to guarantee the indispensable goals of fairness and consistency in decision making, but also to support the continued development of domain name dispute resolution jurisprudence within the .za domain.

‘Free Speech’

Terminology, such as ‘free speech’ or ‘freedom of expression’¹²¹ is not specifically encapsulated in the text of the UDRP itself. Paragraph 4(c)(iii) of the UDRP,¹²² however, creates a defence to a UDRP complaint in recognition of other non-commercial rights and interests that deserve protection, which undoubtedly include ‘freedom of speech’. Paragraph 4c(iii) of the UDRP states that a registrant may demonstrate rights to, and legitimate interests in, a domain name if the registrant is ‘making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.’¹²³

117 South African Regulations (n 77) Reg 18(3).

118 South African Regulations (n 77) Reg 18(4).

119 Domain Name ADR Statistics 2007–June 2025 (n 83).

120 *ibid.*

121 The right to freedom of expression is guaranteed under s 16 of the Constitution of the Republic of South Africa, 1996.

122 UDRP (n 10) para 4(c)(iii).

123 *ibid.*

It was quite clear from the WIPO Final Report of the First WIPO Internet Domain Name Process Report that this justification (defence against a UDRP complaint) would find its way into the wording of the UDRP, which states that '[d]omain name registrations that are justified by legitimate free speech rights or by legitimate non-commercial considerations would likewise not be considered to be abusive.'¹²⁴ Since the inception of the UDRP, the vexing question whether the use of a domain name, identical or confusingly similar to a trade mark holder's mark, for non-commercial criticism websites (so-called gripe-sites) or even laudatory websites (so-called fan-sites) can establish rights or legitimate interests in the disputed domain name has been the subject of profound disagreement among UDRP panellists.¹²⁵ The division points, first, to the divergent reasoning among panellists regarding the inherent tension between recognised trade mark rights, on the one hand, and the internationally recognised and jealously guarded right of freedom of speech or expression, on the other; and second, to the divergence in approaches to the interpretation and application of freedom of speech or expression across different national and jurisdictional lines.¹²⁶

The WIPO 'Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition' (WIPO Overview 2.0) released in 2011 indicated that an absence of a majority and minority view on the issues surrounding the application of 'freedom of speech' in UDRP decision making and, at the time, reflected two competing views that represent the differing approaches of UDRP panellists in the context of 'freedom of speech'.¹²⁷ These differing views will not be discussed in detail here since it is outside the focus of this article, apart from stating that the first view was mostly held by UDRP panellists from outside the United States, and which in essence held that '[t]he right to criticize does not extend to registering a domain name that is identical or confusingly similar to the owner's registered trademark or conveys an association with the mark,' while the second view, which generally prevails in decisions in which parties and panellists from the United States are involved held that '[i]rrespective of whether the domain name as such connotes criticism, the respondent has a legitimate interest in using the trademark as part of the domain name of a criticism site if such use is fair and non-commercial.'¹²⁸

There is a clear, yet steady process of evolution and refinement in UDRP decision making regarding the freedom of speech 'defence' since the first WIPO decisions

124 WIPO Final Report (n 8) para 172.

125 WIPO, 'Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition' (WIPO Overview 2.0) (2011) para 2.4 <<https://www.wipo.int/amc/en/domains/search/overview2.0/>> accessed 15 September 2025; WIPO, WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (WIPO Jurisprudential Overview 3.0) (2017) paras 2.6 and 2.7 <<https://www.wipo.int/amc/en/domains/search/overview3.0/#item26>> accessed 23 September 2025.

126 WIPO Overview 2.0 (n 125) para 2.4; WIPO Jurisprudential Overview 3.0 (n 125) paras 2.6–2.7, and E Hurter, 'Uncertainty "Sucks": An Analysis of Selected Panel Decisions Under the Uniform Dispute Resolution Policy Regarding Gripe Site Domain Names' (2006) 18 SA Merc LJ 436–449.

127 WIPO Overview 2.0 (n 125) para 2.4.

128 *ibid.*

dealing with freedom of speech issues, to the WIPO Overview 2 in 2011¹²⁹ and, more recently, to the current WIPO Overview 3.0 released in 2017.¹³⁰ There is nevertheless still not uniformity on how panellists approach the issues surrounding ‘freedom of speech’ in their decision making. However, some form of mutual direction and understanding has emerged regarding the issues surrounding the application of ‘freedom of speech’ that may be gleaned from the WIPO Overview 3.0 and which are also reflected in the WIPO-ICA Initial Review Report. The WIPO Overview 3.0 indicates that the right to ‘freedom of speech’, specifically the legitimate right to criticise ‘does not necessarily extend to registering or using a domain name identical to a trademark.’¹³¹ Panels generally find in favour of complainants when critical domain names are registered that are identical to a complainant’s trade mark, although some panellists from the United States may take a different approach.¹³²

According to the WIPO-ICA Initial Report, relevant case law has indicated that panellists tended to focus on finding a ‘holistic test’ that examines whether the free speech relied upon as a defence indeed is legitimate (genuine non-commercial free speech) as opposed to being a pretext for cybersquatting.¹³³ The WIPO-ICA Initial Report Project Review Team admits the importance of the ‘free speech’ defence in UDRP jurisprudence and concedes that, although these disputes may be fact-specific and may therefore lead to reasonable differences of opinion among panellists, a coherent and consistent approach to the resolution of ‘freedom of speech’-related cases remains the most desirable outcome in UDRP decision making.¹³⁴ Not surprisingly, given the divergence in views and application regarding the complexities of ‘freedom of speech’ in UDRP decision making, the Project Review Team could not reach agreement on whether the terminology of the UDRP should be changed in the specific ‘free speech’ context, and consequently recommended that no such change be made. In the opinion of the WIPO-ICA Initial Report Project Review Team, the current UDRP language has proven to be ‘adequate to protect legitimate non-commercial free speech,’ but nevertheless expressed the need for further discussion to ensure future consistency in decision making. It therefore recommended further examination of the application of the ‘freedom of speech’ complexities in a deferred ‘Secondary Track’ during the ICANN Phase 2 PDP.¹³⁵

In the South African Regulations, Regulation 5, which lists factors that a registrant may indicate that a domain name is not an abusive registration, states in Regulation 5(c) that if:

129 WIPO Overview 2.0 (n 125) para 2.4.

130 WIPO Jurisprudential Overview 3.0 (n 125) paras 2.6–2.7.

131 WIPO Jurisprudential Overview 3.0 (n 125) para 2.6.2.

132 *ibid.*

133 *ibid*; WIPO-ICA Initial Report (n 13) 25–26.

134 WIPO-ICA Initial Report (n 13) 26.

135 *ibid.*

the registrant has demonstrated fair use, which use may include web sites operated solely in tribute to or fair criticism of a person or business: Provided that the burden of proof shifts to the registrant to show that the domain name is not an abusive registration if the domain name (not including the first and second level suffixes) is identical to the mark in which the complainant asserts rights, without any addition.¹³⁶

The Regulations, similarly to the UDRP, do not specifically include terminology such as ‘freedom of expression’¹³⁷ but, unlike the UDRP, do specifically include terminology pointing to the ‘fair use’ of disputed domain names for the purposes of ‘fan sites’ or ‘gripe sites’.¹³⁸ Admittedly, the international scope of the UDRP complicates the application of considerations such as ‘free speech’ in UDRP decision making, as opposed to the considerations applied in the context of the constitutionally protected rights of ‘freedom of expression’ within the limited scope of the .za domain.¹³⁹

Some uncertainty existed among South African Institute for Intellectual Property Law (SAIIPL) adjudicators regarding the reverse onus in Regulation 5(c) within the context of domain name disputes under the Regulations. In particular, the adjudicators questioned whether the reverse onus placed on the registrant (respondent) when the disputed domain name in dispute is identical to the mark in which the complainant asserts rights was limited to cases covered by Regulation 5(c), which addresses the ‘fair use’ of domain names that resolve to websites operated solely for tribute or fair criticism only, or whether it would apply more broadly to all factors listed in Regulation 5.¹⁴⁰ The view of senior adjudicators currently, with the benefit of almost twenty years of case law jurisprudence, and clearer insight into the drafters’ intentions, is that the reverse onus in the Regulations was intended to apply only to the specific scenario contemplated in Regulation 5(c).¹⁴¹ It was never intended as a general reversal of the onus applicable to all of Regulation 5.

The Alternative Dispute Resolution (ADR) Committee of the SAIPL, the main accredited dispute resolution service provider for resolving disputes in terms of the Regulations, proposed to ZADNA as recently as August 2025 that Regulation 5(c) be amended to remove the onus placed on the domain name registrant to prove that their

136 South African Regulations (n 77) Reg 5(c).

137 South African Constitution (n 121) s 16.

138 South African Regulations (n 77) Reg 5(c).

139 For discussions of the use of ‘gripe site’ domain names in context of the .za domain, see T Pistorius, ‘Trade-Mark Tarnishment: Should We “Laugh It Off” All the Way to “Telkomsuck” and “Hellcom”?’ (2004) 16 SA Merc LJ 727; Hurter (n 126) 446–448.

140 For examples of decisions reached in terms of the Regulations, where the reverse onus stated in Reg 5(c) was at issue and where domain names identical to the trade marks of the complainants were registered, see *Federation Internationale de Football Association (FIFA) v X Yin* ZA2007-0007 and *Automobiles Citroën v Mark Garrod* ZA2008-0023. The Reg 5(c) ‘reverse onus’ discussion does not form the focus of this article and, therefore, these cases will not be analysed here in detail. See also Pistorius (n 93) 661 at 674–676 and Hurter (n 126) 447–448.

141 SAIPL: Domain Name Dispute Resolution Workshop, Expert Panel Discussion on Regulation 5(c) Reverse Onus (4 June 2025, Spoor & Fisher, Centurion).

domain name is not an abusive registration where the complainant's trade mark is identical to the domain name.¹⁴² The Committee is not only of the opinion that placing a burden of proof on a respondent is highly unusual in law, but also that the reverse onus provision may be open to constitutional challenge because it interferes with the respondent's rights to fair administrative justice. The Committee further notes that such a reverse onus provision is unprecedented internationally, as no other domain name dispute resolution policies include a similar provision.¹⁴³ The risk foreseen by the Committee is that an innocent domain name registrant could be deprived of a domain name in circumstances where the registration is not abusive, simply because the domain name is identical to a trade mark. It is entirely possible that a domain name may be identical to a trade mark without being unlawful or abusive in the particular circumstances of a given case. There is, therefore, a risk that, if the reverse onus in Regulation 5(c) remains, a domain name registrant could be unfairly deprived of the domain name.¹⁴⁴

In the view of the author, the removal of the 'reverse onus' created by Regulation 5(c) would remove most of the uncertainty associated with its application and would instead require adjudicators to carefully consider the overall circumstances and merits of the dispute, rather than relying solely on the existence of the reverse onus. In striking the balance between the 'rights' a complainant may have in a name or mark and the right to freedom of expression, the use of a domain name identical to the complainant's name or mark may well, under certain circumstances, tip the balance in favour of the 'rights' a complainant has in its name or mark.

Importantly though, the use of an identical name should not automatically be regarded as unfair and therefore abusive. If the registrant impersonates the rights holder (complainant), the use could surely not be regarded as 'fair use' and, therefore, it would consequently be abusive. Circumstances may, however, exist in which such use can be regarded as fair and therefore not abusive. At the same time, a domain name that includes a derogatory or laudatory term, and which resolves to a website criticising or praising the complainant, may, in light of the right to freedom of expression, be considered 'fair use'. Yet, when all the circumstances of the dispute are considered, it may still be found to be abusive.

The key point remains that adjudicators must consider all relevant circumstances and facts of a domain name dispute, taking into account both the reasoned scope of protection of the broadly defined rights of complainants and the potential legitimate interests and rights of the registrant, such as freedom of expression. The crux of the matter is that adjudicators should vigorously guard against the temptation of reaching

142 Chairperson of the SAIPL ADR Committee, 'Letter to ZADNA: Proposed Amendments to .za Alternative Dispute Resolution Regulations' (7 August 2025).

143 *ibid.*

144 *ibid.*

decisions based on inappropriate legal principles or preconceived generalisations. False perceptions should ideally not be informed by inaccurate first impressions.

Conclusion

The establishment of ICANN with its initially contested multistakeholder governance model and the WIPO Domain Name Processes that novelly developed the UDRP, culminated in the adoption of the UDRP more than twenty-five years ago. The subsequent and unanticipated widespread use of the UDRP constitutes a compelling and fascinating example of innovative ‘law making’ and unconventional policy development necessitated by the challenges brought about by fast-paced technological advancement and societal change.

Over the past twenty-five years, the UDRP has successfully challenged the conceptual boundaries of intellectual property law, particularly trade mark law, through domain name dispute resolution jurisprudence. In doing so, it has played an essential role in balancing the interests of trade mark holders and other DNS stakeholders, thereby contributing significantly to the stability of the DNS, which forms the backbone of the contemporary digital landscape. The WIPO-ICA UDRP Review Process and its potential critical contribution within ICANN’s future Phase 2 PDP for Review of the UDRP seem to indicate the UDRP may be refined to deal with at least some of the pressing issues discussed in this article. It is safe to say that the UDRP is on the precipice of change. It is hoped, as directed in the WIPO-ICA Initial Report, that possible changes are made thoughtfully and circumspectly so as not to compromise the current stability of the UDRP system and to ensure that it maintains its core function.

It is clear from the limited comparative analysis between the proposals contained in the WIPO-ICA Initial Report and the South African Regulations that the Regulations already feature most of the critical aspects currently considered for refining the UDRP. How possible amendments to the UDRP may inform further amendments to the Regulations remains to be seen. For the moment, the holistic approach to balancing the interests of rights holders reflected in the Regulations, together with the quality of decision making and the sound application of domain name dispute resolution principles and best practice, indicate that the current ‘.za’ domain name dispute resolution system is world class.

At the inception of the UDRP, there were many loud, detracting voices and scepticism, generally with good reason. Admittedly, the UDRP is far from perfect. This has prompted the current WIPO-ICA UDRP Review Process and will likely inform the future Phase 2 ICANN PDP. Even most of its detractors must acknowledge that the UDRP has been overwhelmingly successful in fulfilling its mandate. Who could have

imagined—over twenty-five years ago, the author included a year later¹⁴⁵—that the UDRP, as a unique trade mark dispute resolution novelty, would turn out to be this ‘sublime’?

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