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**Via Email: [Halloran@icann.org](mailto:Halloran@icann.org) and [John.Jeffrey@icann.org](mailto:John.Jeffrey@icann.org)**

Mr. Dan Halloran and Mr. John Jeffrey  
ICANN  
4676 Admiralty Way, Suite 330  
Marina del Ray, CA 90292-6601

**Re: Changes to National Arbitration Forum UDRP Supplemental Rules**

Dear Mr. Halloran and Mr. Jeffrey:

As recently posted among ICANN's correspondence, ICANN has received notification of changes which the National Arbitration Forum intends to make in its UDRP Supplemental Rules.

In the proposed changes to the National Arbitration Forum UDRP Supplemental Rules, the National Arbitration Forum continues to purport to provide a mechanism for parties to submit additional written statements other than the complaint and the response, and to charge a fee for this service. In contrast to this procedure for which the National Arbitration collects regular income, Rule 12 of the UDRP itself states:

"in addition to the Complaint and the Response the Panel may request,  
**in its sole discretion**, further statements or documents from either of the parties."

We gather from the National Arbitration Forum's correspondence that it is their intention to continue to convey the false impression that its supplemental filing procedure comports with the UDRP rules.

As noted in correspondence you received from Mr. Francis Gurry of WIPO in connection with the Czech Arbitration Court implication, there is a significant concern that UDRP providers may attempt, through their supplemental rules, to amend or alter rules established in both the UDRP policies and the rules therefor. Accordingly, in the course of ICANN's oversight and maintenance of accreditation for dispute resolution providers, ICANN should exercise vigilance to determine whether the dispute resolution providers are in fact adhering to the policy and to the rules, or are attempting to substantially alter or subvert the UDRP Rules in their supplemental rules.

Another historic practice of the National Arbitration Forum, now made explicit in the National Arbitration Forum proposal, is to disregard UDRP Rule 2(f), which states:

"Except as otherwise provided in these Rules, or decided by a Panel, all communications provided for under these Rules shall be deemed to have been made:

(i) if delivered by telecopy or facsimile transmission, on the date shown **on the confirmation of transmission**; or

(ii) if by postal or courier service, **on the date marked on the receipt**; or

(iii) if via the Internet, **on the date that the communication was transmitted**, provided that the date of transmission is verifiable."

Referring to Ms. Dorrain's letter, the NAF proposes to define the word "submit" in a manner that is directly contrary to the UDRP Rule 2(f).

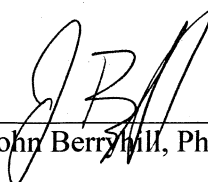
It may not immediately be recognized that Rule 2(f) has a substantial effect upon respondents, in view of the international nature of the UDRP. Depending upon the time zone of a respondent, the effective period during which a respondent has notice of the proceedings can vary. At the close of the business day in Minneapolis, when a notice may be sent, it may already be well into the succeeding day from Europe to the Pacific Islands. Hence, while the UDRP prescribes a twenty day response period, this period is effectively shortened for entities in those time zones, who should be able to rely upon UDRP Rule 2(f) relative to the time of submission. A further complicating factor is that the UDRP does not require electronic provision of all of the exhibits accompanying a UDRP complaint, and the National Arbitration Forum does not, upon notifying a respondent of a UDRP complaint provide these documents. It is a common practice for UDRP complainants to file the minimum amount of documentation necessary electronically, and then to send exhibits and other materials to the respondent, if at all, by surface mail. Furthermore, complainants utilize a practice of sending materials via private courier services to Post Office box addresses, and then claim non-delivery of such materials, knowing full well that private courier services do not deliver to P.O. boxes. Hence this notion that UDRP respondents are, in all instances provided with adequate notice of a proceeding at the time that a dispute resolution provider commences the response period, is largely a fiction. Among attorneys who regularly defend domain registrants in UDRP proceedings, these practices by complainants are well known and are the norm rather than the exception.

Finally, the National Arbitration Forum proposes to retain a portion of fees paid by the Respondent for a three member panel in circumstances where a Complainant has filed and then withdrawn a UDRP complaint. Under the UDRP, when a Respondent requests a three member panel, the Respondent is required to pay one half of the panelist fee. There have been several proceedings under the UDRP in which a complaint had been frivolously filed, and then the Complainant withdrew the complaint upon finding that its assertions would be challenged. One

such example was during a proceeding that the National Arbitration Forum had commenced concerning the domain name tobacco.com. In that instance, the Respondent had paid one half of the panelist fee, and then the Complainant withdrew the matter. The National Arbitration Forum, under its rules at that time, refused to refund the Respondent's payment. This action amounts to false advertising by the National Arbitration Forum that the purported fee was to pay for the appointment of a panel. No such panel had been appointed. Under the relevant practice at WIPO, an indefinite period of time will be given to Complainants along several reminders to the Complainant to pay its share of the panelist fee. WIPO extends such courtesy only to Complainants and will not dismiss a case when the Complainant does not pay the fee within a fixed period. The retention of unused Respondent fees by the National Arbitration Forum, however, is particularly unfair, in view of the fact that Respondents do not voluntarily select the dispute resolution provider engaged to administer a UDRP proceeding. The consequences of that basic observation were also clearly pointed out to you by Mr. Gurry of WIPO.

Accordingly, I must request that the proposed Supplemental Rules promulgated by the National Arbitration Forum receive due consideration by ICANN as to whether the supplemental rules embody the type of attempt about which Mr. Gurry had warned, to subvert operation of the UDRP and of the UDRP rules established by ICANN as a consensus policy. The UDRP has been extremely effective in addressing domain name and trademark disputes, and although not free from problematic issues, is a tremendously efficient alternative to litigation for both trademark owners and legitimate domain registrants. As you may know the National Arbitration Forum is a known violator of intellectual property rights itself, having been found liable of patent infringement in 2006. Accordingly, I expect that ICANN will conduct appropriate scrutiny into these proposed rule changes by the National Arbitration Forum.

Sincerely,



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John Berryhill, Ph.D., Esq.

JB:cnd