

23 December 2005

Mr Rick Shera  
Domain Name Dispute Resolution Group  
PO Box 11-881  
WELLINGTON

Dear Mr Shera

### **Internet NZ – Domain Name Dispute Resolution**

Thank you for your letter dated 9 November, inviting me to comment on the draft policy for resolution of domain name disputes in New Zealand.

You will probably be aware that I have been a WIPO Domain Name panellist for the last 4 years. I was invited to serve as a panellist for the Hong Kong Centre (HKIAC), but in the event I declined to take up that invitation.

I have had the advantage of reading Sir Ian Barker's letter to you dated 22 December, and I have conferred with Sir Ian on the various issues raised by him. Generally, I concur with the views expressed in Sir Ian's letter, and wish to add only a few additional comments.

#### **1. Arbitration or Expert Determination**

This is of fundamental importance, both to the parties and to the expert (or arbitrator, as he or she may be held to be). I think we need to be very clear in exactly how the proposed system is intended to fit in with the Arbitration Act 1996. At this stage, I note that it is proposed to have a "first instance" determination by an expert, with a right of appeal from the expert's determination to an appellate panel. It may be that both expert and appellate panel will be regarded as arbitrators under the 1996 Act, in which case it will presumably be possible (at least where all parties to the procedure are New Zealand parties) to seek leave to appeal to the High Court under the Second Schedule to the Arbitration Act on a point of law? Is that what was intended? I would have thought that if there is to be a right of appeal to an appellate panel, the parties would at least want to know that the matter would be resolved once and for all by the appellate panel.

#### **2. Generic Trademarks**

Like Sir Ian, I have always taken the view in WIPO decisions that it is not for the Panel to second guess a decision of a national trademark authority that a particular mark should be registered. I think most WIPO panellists have taken the view that if someone considers that a registered mark is generic, descriptive, or otherwise not entitled to registration, their proper recourse is to apply to the Court (or other appropriate body) in the relevant jurisdiction to have the mark removed from the register.

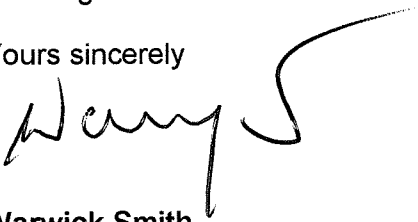
### 3. Hate Sites

I agree with Sir Ian that the proposed paragraph 6.2 of the Policy is asking for trouble. Does it mean, for example, that someone wanting to run a hate site directed at some commercial entity (e.g. Telecom) would be perfectly free to register, say, telecom.co.nz (assuming that name were somehow available)? (A prominent American WIPO panellist went so far as to support that theoretical proposition at a WIPO domain name workshop I recently attended in Geneva. His view, which seems to be shared by a number of American WIPO panellists, appears to be that freedom of speech considerations trump almost all other considerations.) I doubt that we would wish to follow that path in New Zealand. A domain name is really just an address in cyberspace, and, like an address in the physical world, one expects to find a person living, or business operating, at the address. If the domain name consists of or incorporates someone's trademark, I think one reasonably expects that it will be the trademark owner who resides or operates at that address. If the site has no connection with the trademark owner, it must at very least be arguable that the domain name registrant has misled those who come to the website expecting to find a site operated by the trademark owner. If that is right, it is difficult to see why we would want to include a provision in the policy itself, effectively declaring such conduct to be fair.

Those are the only comments I have time to make at this stage. Thank you for the opportunity to express my views.

Kind regards

Yours sincerely

A handwritten signature in black ink, appearing to read 'Warwick Smith', with a long, sweeping flourish extending to the right.

Warwick Smith