

## **WIPO General Assembly**

### **Forty-Eighth (26<sup>th</sup> Extraordinary) Session Geneva, October 3 to 11, 2016**

#### **WIPO ARBITRATION AND MEDIATION CENTER, INCLUDING DOMAIN NAMES**

*Document prepared by the Secretariat*

1. This document provides an update on the WIPO Arbitration and Mediation Center's ("Center") activities as an international resource for time- and cost-efficient alternatives to court litigation of intellectual property (IP) disputes, acting as an administrator of cases as well as a provider of legal and organizational expertise in alternative dispute resolution (ADR).
2. This document also provides an update on the domain name-related activities of WIPO, as previously reported in WO/GA/47/14.<sup>1</sup> It covers the Center's administration of domain name disputes under different policies and various related aspects of the Internet Domain Name System (DNS), as well as selected policy developments, including rights protection mechanisms (RPMs) for the introduction of new generic top-level domains (gTLDs), the planned revision by the Internet Corporation for Assigned Names and Numbers (ICANN) of the Uniform Domain Name Dispute Resolution Policy (UDRP), and the status of the recommendations made by the Member States of WIPO in the context of the Second WIPO Internet Domain Name Process.

#### **I. ARBITRATION AND MEDIATION OF IP DISPUTES**

##### **A. ARBITRATION AND MEDIATION CASE ADMINISTRATION**

3. The mediation and arbitration procedures offered by the Center aim to meet parties' needs for time- and cost-effectiveness in the resolution of disputes in relation to IP rights. The Center is engaged in the management and resolution of cases conducted under those

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<sup>1</sup> See [http://www.wipo.int/edocs/mdocs/govbody/en/wo\\_ga\\_47/wo\\_ga\\_47\\_14.pdf](http://www.wipo.int/edocs/mdocs/govbody/en/wo_ga_47/wo_ga_47_14.pdf).

procedures, which entails training,<sup>2</sup> appointing, and supporting qualified arbitrators and mediators, and maintaining up-to-date case administration infrastructure, including through the use of information technology such as the WIPO Electronic Case Facility (ECAF).<sup>3</sup> WIPO cases in the past year included those related to patents, trademarks, software, research and development (R&D), film and media, and franchising, and were filed with the Center by parties on the basis of prior contract clauses as well as submission agreements. More than half of the parties to such cases are users of WIPO's PCT and Madrid services. Some 70 per cent of WIPO mediations achieve settlement, and at a settlement rate of 40 per cent, even referral to WIPO arbitration can stimulate agreement between the parties.

4. In order to lower barriers to potential users of WIPO ADR, effective from January 1, 2016, updated WIPO Mediation Rules make available to parties the option to submit, in the absence of a prior mediation agreement, a unilateral Request for Mediation to the Center.<sup>4</sup> Upon receipt of such Request, the Center may assist the parties in considering submission to WIPO mediation, including by providing information concerning the WIPO procedure. Also, a newly developed WIPO Clause Generator allows parties to build clauses and submission agreements by selecting WIPO ADR procedures and choosing elements such as place and language of proceedings and qualifications of neutrals.<sup>5</sup>

## B. ADR SERVICES FOR SPECIFIC SECTORS

### (a) Collaboration with Intellectual Property Offices (IPOs)

5. In a recent development, the Center offers services to IPOs in their establishment of optional ADR frameworks. Such collaboration, which may also include training programs, promotional activities and case administration, aims to provide cost-effective and flexible options for parties to resolve their disputes before IPOs in relation to pending applications or granted rights<sup>6</sup>.

6. Following the establishment in 2011 of a joint dispute resolution procedure to facilitate the mediation of trademark oppositions at the Intellectual Property Office of Singapore (IPOS), the Center participated in the development of a mediation option for trademark proceedings before the Brazilian National Institute of Industrial Property (INPI-BR), which has designated the Center as the administrator of mediation cases where one or both parties are domiciled outside Brazil. Also, as of May 2015, the Intellectual Property Office of the Philippines (IPOP HL) designated the Center at the option of parties as administrator of mediation cases submitted with IPOP HL involving one or more parties domiciled outside the Philippines. Following conclusion of agreements, the Korea Copyright Commission (KCC) and the Korea Creative Content Agency (KOCCA) have been offering a WIPO mediation option to potential parties in cases involving an international party since February and May 2015, respectively.

7. Further to the conclusion of an agreement with the Mexican Institute of Industrial Property (IMPI), the Center will work with IMPI to promote the use of ADR for IP disputes. Following agreements with the National Copyright Directorate of the Republic of Colombia and the Directorate General of Intellectual Property Rights of Indonesia (DGIPR), the Center is also collaborating on the development of ADR processes and services for disputes regarding certain rights in those jurisdictions.

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<sup>2</sup> All workshops and other events organized by the Center are listed at <http://www.wipo.int/amc/en/events>.

<sup>3</sup> ECAF offers online case communication and storage of documents facilitating time- and cost-efficient mediation and arbitration proceedings. See <http://www.wipo.int/amc/en/ecaf/index.html>.

<sup>4</sup> See new Article 4 of the WIPO Mediation Rules, available at <http://www.wipo.int/amc/en/rules/>. A similar option is available under new Article 6 of the 2016 WIPO Expert Determination Rules.

<sup>5</sup> See <http://www.wipo.int/amc-apps/clause-generator/>.

<sup>6</sup> See <http://www.wipo.int/amc/en/center/specific-sectors/ipos/>.

8. The Trademark Trial and Appeal Board (TTAB) and the Patent Trial and Appeal Board (PTAB) of the United States Patent and Trademark Office (USPTO) encourage parties to consider ADR as a means of settling issues raised in Board proceedings. Since January 2016, the Center is listed as one of the available dispute resolution service providers for TTAB and PTAB proceedings.

9. In 2015, the Center published the WIPO Guide on Alternative Dispute Resolution for IPOs and Courts<sup>7</sup>. Informed by early WIPO experience in this area, this Guide provides a broad overview of ADR for IP disputes and presents options for interested IPOs and courts to integrate ADR into their existing processes. The Guide includes an overview of the Center's collaborations with IPOs and related model documents.

(b) Fast-Track Procedure

10. The Center continued contact with trade fair organizers and associations to explore options for the use of ADR mechanisms to resolve IP disputes arising at trade fairs. In 2015, the Center drafted the WIPO Fast-Track Intellectual Property Dispute Resolution Procedure for Palexpo Trade Fairs. This Procedure aims to protect exhibitors' and non-exhibitors' IP rights in a cost- and time-efficient manner against infringement of copyright, trademarks, design rights or breach of law on unfair competition under Swiss law at Palexpo trade fairs held in Geneva. Decisions under the Procedure are rendered by a sole expert within 24 hours after the request, and are enforceable with immediate effect at the trade fair. Each party may appeal the expert's decision in a WIPO Expedited Arbitration or in court. The Fast-Track Procedure was used at the Geneva International Motor Show in 2015 and 2016.

(c) Patents in Standards Dispute Resolution

11. The Center continued collaboration with the European Telecommunication Standards Institute (ETSI) in the development and promotion of tailored arbitration model submission agreements that offer a framework for the efficient resolution of disputes involving the determination of fair, reasonable and non-discriminatory (FRAND) licensing terms.<sup>8</sup> Under an agreement concluded in 2015, WIPO also collaborates in this area with the Institute of Electrical and Electronics Engineers (IEEE). The use of ADR for such disputes has been encouraged by competition authorities in some countries, and a number of standard-setting organizations include ADR procedures in their IP policies. The WIPO FRAND model agreements build on the Center's experience in complex patent arbitrations and propose a set of FRAND-specific features.<sup>9</sup>

(d) R&D Dispute Resolution

12. Following prior engagement with European R&D stakeholders,<sup>10</sup> German institutions,<sup>11</sup> and Austrian entities,<sup>12</sup> the Center continued to provide assistance in the development of Model Agreements that seek to facilitate an efficient transfer of knowledge and technology. This includes further collaboration with the Spanish Patent and Trademark Office (OEPM) in the

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<sup>7</sup> The Guide is available at <http://www.wipo.int/export/sites/www/amc/en/docs/adrguidejuly2015.pdf>.

<sup>8</sup> See <http://www.wipo.int/amc/en/center/specific-sectors/ict/frand/>.

<sup>9</sup> Two different models are offered, namely (i) WIPO FRAND Arbitration, and (ii), for less complex cases, notably where the number of standard-essential patents that will be referred to arbitration is limited, WIPO FRAND Expedited Arbitration; either procedure can be preceded by WIPO Mediation.

<sup>10</sup> One such example involves multi-party collaborations funded under the European Union's research funding program Horizon 2020, where entities use the DESCA 2020 model consortium agreement, which recommends WIPO Mediation followed, in the absence of settlement, by WIPO Expedited Arbitration. See <http://www.desca-2020.eu/>.

<sup>11</sup> See <http://www.bmw.de/English/Redaktion/Pdf/sample-agreements-for-research-and-development-cooperation,property=pdf,bereich=bmwi,sprache=en,rwb=true.pdf>.

<sup>12</sup> See <http://www.wipo.int/amc/en/center/specific-sectors/rd/ipag/>.

development of additional Model R&D Agreements that offer WIPO Mediation and WIPO Expedited Arbitration options, as well as related user guides.<sup>13</sup>

13. Also, as part of a broader effort under a Memorandum of Understanding, the Center provided further guidance to the Association of University Technology Managers (AUTM) to support efficient dispute resolution for university technology transfer offices around the world. Following the earlier conclusion of an MoU regarding green technology between WIPO and the Korea Technology Finance Corporation (KOTEC), a non-profit financial institution providing technology development guarantees to small and medium-sized enterprises (SMEs) in the Republic of Korea, the Center and KOTEC agreed in 2015 to promote the use by KOTEC clients of WIPO ADR options.

(e) Franchising Dispute Resolution

14. As part of the WIPO ADR Services for Specific Sectors, and noting a growing caseload relating to disputes in the area of franchising and distribution agreements, the Center provides tailored advice and case administration services to help parties resolve such disputes. Notably, the Center cooperates with the Franchising and Licensing Association Singapore (FLA), the Swiss Franchise Association (SFA), and the Spanish Franchisors Association (AEF) to raise awareness of ADR options available to stakeholders in these areas. In 2015, the Center and the Brazilian Franchising Association (ABF) concluded an agreement to work together in the development of WIPO ADR processes and services for disputes involving ABF members.<sup>14</sup>

(f) Film and Media

15. The Center continued its cooperation with the Format Recognition and Protection Association (FRAPA) concerning ADR in the area of TV program format disputes. The Center handled TV format-related disputes filed under the WIPO Mediation and Expedited Arbitration Rules for Film and Media. Since 2015, the Center also collaborates with the *Arbeitsgemeinschaft Dokumentarfilm* (AGDOK) in Germany concerning documentary-related disputes, and has administered documentary-related disputes under the WIPO Mediation Rules.<sup>15</sup>

## II. DOMAIN NAME CASE ADMINISTRATION

### A. UDRP

16. The DNS raises a number of challenges for the protection of IP, which, due to the global nature of the Internet, call for an international approach. WIPO has addressed these challenges since 1998 by developing specific solutions, most notably in the First<sup>16</sup> and Second<sup>17</sup> WIPO Internet Domain Name Processes. Through the Center, WIPO provides trademark owners with efficient international mechanisms to deal with the bad-faith registration and use of domain names corresponding to their trademark rights. The principal mechanism administered by the

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<sup>13</sup> The Model Agreements are available at [http://www.oepm.es/es/propiedad\\_industrial/transferencia\\_de\\_tecnologia/Modelos\\_de\\_Contratos/index.html](http://www.oepm.es/es/propiedad_industrial/transferencia_de_tecnologia/Modelos_de_Contratos/index.html).

<sup>14</sup> See <http://www.wipo.int/amc/en/center/specific-sectors/franchising/>.

<sup>15</sup> See <http://www.wipo.int/amc/en/film/>.

<sup>16</sup> The Management of Internet Names and Addresses: Intellectual Property Issues – Final Report of the First WIPO Internet Domain Name Process, WIPO publication No. 439, also available at <http://www.wipo.int/amc/en/processes/process1/report>.

<sup>17</sup> The Recognition of Rights and the Use of Names in the Internet Domain Name System – Report of the Second WIPO Internet Domain Name Process, WIPO Publication No. 843, also available at <http://www.wipo.int/amc/en/processes/process2/report>.

Center, the UDRP, was adopted by ICANN on the basis of recommendations made by WIPO in the First WIPO Internet Domain Name Process.

17. Limited to clear cases of bad-faith, abusive registration and use of domain names, the UDRP has proven highly useful for trademark owners.<sup>18</sup> Since December 1999, the Center has administered over 35,000 UDRP-based cases.<sup>19</sup> Trademark holders in 2015 filed 2,754 UDRP-based complaints with the Center, an increase of 4.6 per cent over 2014 filing. As of August 2016, the total number of domain names in WIPO UDRP-based cases surpassed 65,000.

18. A diverse mixture of enterprises, institutions, and individuals used the Center's dispute resolution procedures in 2015. The top five sectors for complainant business activity were Fashion, Banking and Finance, Internet and Information Technology, Retail, and Biotechnology and Pharmaceuticals. Especially the filings related to consumer-facing brands include those by rights owners alleging counterfeiting *via* the web pages offered under the disputed domain name. Reflecting the global scope of this dispute mechanism, named parties to WIPO cases through 2015 represented 177 countries. In function of the language of the applicable registration agreement of the domain name at issue, WIPO UDRP proceedings have so far been conducted in 21 languages.<sup>20</sup>

19. All WIPO UDRP panel decisions are posted on the Center's website. The Center offers a unique online overview of broad decision trends on important case issues *via* the WIPO Overview of WIPO Panel Views on Selected UDRP Questions (WIPO Overview 2.0). Distilling thousands of UDRP cases handled by the Center, this globally relied-upon instrument was created to help identify and stimulate consistency of WIPO UDRP jurisprudence.<sup>21</sup> To facilitate access to these decisions according to subject matter, the Center also offers a widely used online searchable Legal Index of WIPO UDRP Decisions.<sup>22</sup> These WIPO resources are accessible globally free of charge.

20. Mindful of WIPO's foundational role in the UDRP, the Center monitors developments in the DNS with a view to adjusting its resources and practices.<sup>23</sup> The Center regularly organizes Domain Name Dispute Resolution Workshops to update interested parties,<sup>24</sup> as well as meetings of its Domain Name Panelists.

## B. COUNTRY CODE TOP-LEVEL DOMAINS (ccTLD)

21. While the mandatory application of the UDRP is limited to domain names registered in gTLDs, such as .com and more recently introduced new gTLDs, the Center also assists ccTLD registries in their establishment of registration conditions and dispute resolution procedures that conform with best practices in registry management and IP protection. These procedures are mostly modeled after the UDRP, but may take account of the particular circumstances and needs of individual ccTLDs. The Center currently provides domain name

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<sup>18</sup> The UDRP does not prevent either party from submitting a dispute to a competent court of justice; however, very few cases that have been decided under the UDRP have been brought before a national court of justice. See Selected UDRP-related Court Cases at <http://www.wipo.int/amc/en/domains/challenged>.

<sup>19</sup> The Center makes available online real-time statistics to assist WIPO UDRP case parties and neutrals, trademark attorneys, domain name registrants, domain name policy makers, the media, and academics. Available statistics cover many categories, such as "areas of complainant activity", "domain name script", and "25 most cited decisions in complaint". See <http://www.wipo.int/amc/en/domains/statistics>.

<sup>20</sup> In alphabetical order, Chinese, Czech, Danish, Dutch, English, French, German, Hebrew, Italian, Japanese, Korean, Norwegian, Polish, Portuguese, Romanian, Russian, Slovak, Spanish, Swedish, Turkish, and Vietnamese.

<sup>21</sup> The Overview is available at <http://www.wipo.int/amc/en/domains/search/overview2.0>.

<sup>22</sup> This professional resource is available at <http://www.wipo.int/cgi-bin/domains/search/legalindex>.

<sup>23</sup> See, e.g., WO/GA/41/17 Rev.2, paragraphs 14 to 16. In 2015, the Center implemented a new practice concerning the "locking" of domain names to prevent so-called "cyberflight" in UDRP proceedings.

<sup>24</sup> See footnote 2, *supra*.

dispute resolution services to 75 ccTLD registries; based on an updated procedure to resolve domain name disputes under the .FR (France) and .RE (Reunion Island) ccTLDs, most recently this includes the addition of the .PM (St. Pierre and Miquelon), .TF (French Southern Territories), .WF (Wallis and Futuna Islands), and .YT (Mayotte) ccTLDs.<sup>25</sup>

### III. POLICY DEVELOPMENTS IN THE DNS

22. A number of policy developments in relation to ICANN present both opportunities and challenges for owners and users of IP rights. One is ICANN's introduction of up to 1,400 new gTLDs. Such new gTLDs may be of an "open" nature (similar to .com), or may take on more specific or restrictive characteristics, for example taking the form of .[brand], .[city], .[community], .[culture], .[industry], or .[language]. An important related development concerns the introduction of Internationalized Domain Names (IDNs) at the top level. Also, ICANN's envisaged expansion of the DNS raises rights protection questions in connection with the Second WIPO Internet Domain Name Process.

#### A. NEW GTLDS

23. ICANN implementation of its New gTLD Program was formally approved in June 2011.<sup>26</sup> Information has been published in ICANN's much-revised "Applicant Guidebook".<sup>27</sup> Delegation of the first new gTLDs into the Internet's Root Zone took place in October 2013, with over 1,100 more gTLDs delegated by August 2016.<sup>28</sup>

24. The Center remains committed to working with stakeholders to attempt to safeguard the observance of general principles of IP protection in new gTLDs. A number of the RPMs have emerged from a series of ICANN committees and processes for new gTLDs.<sup>29</sup> Set out below is a broad description of these ICANN RPMs, for the top level and the second level respectively.

##### (a) Top Level RPMs

###### (i) Pre- (TLD) Delegation Dispute Resolution Procedure

25. This mechanism allowed trademark owners to lodge Legal Rights Objections (LRO) to new gTLD applications at the top level where certain substantive criteria were met.<sup>30</sup> The Center assisted ICANN in the establishment of these criteria on the basis of the "WIPO Joint Recommendation Concerning Provisions on the Protection of Marks, and Other Industrial Property Rights in Signs, on the Internet".<sup>31</sup>

26. Appointed by ICANN as the exclusive provider of LRO dispute resolution services,<sup>32</sup> the Center received 69 compliant LRO filings, which it completed processing by September 2013.<sup>33</sup>

<sup>25</sup> The full list of ccTLDs which have retained the Center as domain name dispute resolution provider is available at <http://www.wipo.int/amc/en/domains/cctld>.

<sup>26</sup> See <http://www.icann.org/en/minutes/resolutions-20jun11-en.htm>. For further background including references, see document WO/GA/39/10, in particular paragraph 14.

<sup>27</sup> ICANN's Applicant Guidebook is available at <http://newgtlds.icann.org/en/applicants/agb>.

<sup>28</sup> Delegated new gTLDs are listed at <http://newgtlds.icann.org/en/program-status/delegated-strings>.

<sup>29</sup> For further background including references, see WO/GA/39/10, in particular paragraphs 23 to 30. It is noted here that ICANN rejected a proposal for a "Globally Protected Marks List".

<sup>30</sup> Other objection grounds recognized by ICANN were: "String Confusion Objections", "Community Objections", and "Limited Public Interest Objections". The Applicant Guidebook further includes a number of other procedures which governments may avail themselves of following ICANN announcement of new gTLD applications. Notably, section 1.1.2.4 provides for "GAC Early Warning," and section 1.1.2.7 provides for "Receipt of GAC Advice on New gTLDs" for the ICANN Board's consideration.

<sup>31</sup> Adopted by the WIPO General Assembly in September 2001; see [http://www.wipo.int/about-ip/en/development\\_iplaw/pub845-toc.htm](http://www.wipo.int/about-ip/en/development_iplaw/pub845-toc.htm).

<sup>32</sup> See section 3.2 of the ICANN Applicant Guidebook at <http://newgtlds.icann.org/en/applicants/agb/objection-procedures-04jun12-en.pdf>.

All WIPO LRO expert panel determinations are available on the Center's website,<sup>34</sup> as is a Center report on the LRO process.<sup>35</sup>

(ii) Post- (TLD) Delegation Dispute Resolution Procedure (PDDRP)

27. In early 2009, the Center communicated to ICANN a concrete substantive proposal for a permanent administrative option that would allow for the filing of a complaint with respect to an approved new gTLD registry operator whose manner of operation or use of its registry is alleged to cause or materially contribute to trademark abuse.<sup>36</sup> The proposal's intent was to offer standardized assistance to ICANN's own compliance oversight responsibilities, by providing an administrative alternative to court litigation, encouraging responsible conduct by relevant actors and including appropriate safe-harbors.<sup>37</sup>

28. Following various ICANN processes, including consultations with registry operators, the effectiveness of this PDDRP in the form adopted by ICANN remains uncertain, in particular given the addition of overlapping procedural layers, and issues concerning the intended substantive scope of this mechanism. In light of broader policy interests, the Center in 2013 agreed with ICANN to become a provider for the trademark PDDRP.

(b) Second Level RPMs

(i) Trademark Clearinghouse

29. ICANN's New gTLD Program includes a "Trademark Clearinghouse" as a centralized repository of authenticated trademark data which could be invoked as the basis for filing under new gTLD RPMs.<sup>38</sup> The Center has commented that such Clearinghouse should not unfairly burden rights holders in the treatment of trademark registrations legitimately obtained through examination and registration systems as applied in many global jurisdictions, and that, if and where relevant, practical measures may be envisaged to identify any allegedly inappropriate

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[Footnote continued from previous page]

<sup>33</sup> See WIPO Rules for New gTLD Dispute Resolution, and Schedule of Fees and Costs, respectively at <http://www.wipo.int/amc/en/docs/wipolrrules.pdf> and <http://www.wipo.int/amc/en/domains/lro/fees/>; see WIPO-registered LRO cases at <http://www.wipo.int/amc/en/domains/lro/cases/>.

<sup>34</sup> See <http://www.wipo.int/amc/en/domains/lro/cases/>.

<sup>35</sup> The WIPO LRO report notes that an overwhelming majority of LROs were filed against applications for gTLD strings with descriptive or dictionary meaning. Many expert panels concluded that where a trademark owner has adopted a common dictionary term as a trademark, a gTLD application intended solely to take advantage of such common dictionary meaning would not as such violate the decision standards for LROs. In certain cases panels addressed trademark registrations that were primarily obtained for the purpose of supporting an application for a new gTLD and/or LRO, with little or no demonstrable prior use. See <http://www.wipo.int/amc/en/docs/lroreport.pdf>.

<sup>36</sup> See <http://www.wipo.int/amc/en/docs/icann130309.pdf>.

<sup>37</sup> Given the perceived convergence of registry, registrar, and registrant roles within the DNS, the Center has further recommended, *inter alia* taking account of its UDRP-based experiences, and ICANN's decision to allow for cross-ownership between registries and registrars (see <http://www.icann.org/en/minutes/resolutions-05nov10-en.htm>), that ICANN consider extending the PDDRP for registries also to registrar conduct (see, *inter alia*, <http://www.wipo.int/amc/en/docs/icann260310rap.pdf>).

<sup>38</sup> The Clearinghouse allows for inclusion of registered word marks, word marks protected by statute or treaty or validated by court, and "[o]ther marks that constitute intellectual property" (the latter being undefined). With respect to RPMs utilizing Clearinghouse data, the availability of "Sunrise" services (*i.e.*, an opportunity for a trademark owner, for a fee, to preemptively register an exact match of its mark as a domain name) is limited to those trademarks for which current use can be demonstrated. Whether or not substantiated by demonstration of current use, trademark owners would also be eligible to participate in a time-limited "Claims" service (*i.e.*, notice to a potential domain name registrant of the existence of a potentially conflicting trademark right, and notice to the relevant trademark owner(s) in the event that the registrant nevertheless proceeds with domain name registration). As mandated by ICANN, the availability of the Claims service is for a period of 90 days after a new gTLD is opened for general public registration, but users of the Clearinghouse can opt-in to receive notifications indefinitely. The demonstration of use required for Sunrise services similarly applies to the invocation of trademarks as a basis for a complaint filed under the "Uniform Rapid Suspension" RPM described herein.

invocation of rights in specific contexts. It appears that through April 2016, the Clearinghouse had received over 40,500 entries.<sup>39</sup>

(ii) Uniform Rapid Suspension (URS) System

30. While importantly the UDRP remains available as a curative tool for new gTLD disputes involving the considered transfer of a disputed domain name to the trademark owner, ICANN has introduced what is intended to be a lighter second-level RPM for appropriate cases.<sup>40</sup>

31. Having evolved from a sequence of ICANN processes and committees, the URS continues to raise a number of questions, including its relationship to the UDRP.<sup>41</sup> ICANN invited tenders from prospective URS providers, to which after careful consideration of the ICANN URS model and related resources, the Center has not been in a position to apply.<sup>42</sup> The Center continues to closely monitor developments.

B. ICANN'S PLANNED REVISION OF THE WIPO-INITIATED UDRP

32. Accommodating the dynamic development of the DNS, the UDRP has been offering an effective alternative to court litigation for trademark owners, domain name registrants, and registration authorities. Nevertheless, following discussions at which the clear majority of participants were of the opinion that more harm than good could result from any review of the UDRP by ICANN as a registration-driven body,<sup>43</sup> a decision was taken by ICANN's Generic Names Supporting Organization (GNSO) to review the UDRP following the launch of new gTLDs. ICANN's Preliminary Issue Report on this topic was issued in October 2015 describing a range of complex substantive and process-related questions.<sup>44</sup> In this regard, the Center provided observations highlighting both the UDRP's long-proven success and the risks associated with any attempted ICANN revision of the UDRP. Following a public comment period, ICANN issued its Final Issue Report in January 2016 recommending that the GNSO launch a Policy Development Process (PDP) to review all RPMs in two phases; the initial phase is now focusing on RPMs developed for the New gTLD Program, and the second phase will focus on the UDRP.<sup>45</sup> This is a matter of serious concern, and the Center continues to closely follow ICANN stakeholders' intentions with regard to the UDRP and trademark RPMs generally.

C. IDNS

33. As noted in paragraph 22, another significant policy development in the DNS is the introduction of IDNs (non-Latin script) at the top level.<sup>46</sup> Many of these were among the first

<sup>39</sup> See <http://trademark-clearinghouse.com/content/tmch-stats>.

<sup>40</sup> The Center for its part communicated to ICANN in April 2009 a discussion draft of an "Expedited (Domain Name) Suspension Mechanism", (See <http://www.wipo.int/amc/en/docs/icann030409.pdf>) and has made subsequent proposals for a streamlined mechanism based on this model at ICANN Meetings (see <http://prague44.icann.org/node/31773> and <http://toronto45.icann.org/node/34325>). Such proposals took account of the need to strike a balance between the protection of trademark rights recognized by law, the practical interests of good-faith registration authorities to minimize operational burdens, and the legitimate expectations of *bona fide* domain name registrants.

<sup>41</sup> An extensive inventory of these issues is provided *inter alia* in the Center's letter to ICANN of December 2, 2010, available at <http://www.wipo.int/amc/en/docs/icann021210.pdf>.

<sup>42</sup> The question of accreditation of providers gives rise to concerns as to the stability of RPMs; WIPO raised concerns about this as early as 2007 in the context of the UDRP (see <http://www.wipo.int/amc/en/docs/icann040707.pdf>).

<sup>43</sup> See <https://community.icann.org/display/gnsoudrpdtd/Webinar+on+the+Current+State+of+the+UDRP>; see also more generally document WO/GA/39/10, paragraph 31.

<sup>44</sup> See <http://gns0.icann.org/en/issues/new-gtlds/rpm-prelim-issue-09oct15-en.pdf>.

<sup>45</sup> See <https://gns0.icann.org/en/issues/new-gtlds/rpm-final-issue-11jan16-en.pdf>.

<sup>46</sup> See also ICANN's Final Implementation Plan for IDN ccTLD Fast Track Process published in November 2009 (see <http://www.icann.org/en/topics/idn/fast-track/idn-ccTld-implementation-plan-16nov09-en.pdf>). Since then, this



new gTLDs announced by ICANN for delegation in the DNS root zone.

#### D. OTHER IDENTIFIERS

34. In addition to and in connection with the above, there are further developments taking place at ICANN in relation to the protection of non-trademark identifiers.

##### (a) International Governmental Organizations (IGOs)

35. It is recalled that the First WIPO Internet Domain Name Process addressed the relationship between domain names and trademarks. The Second WIPO Internet Domain Name Process concerned the relationship between domain names and other types of identifiers that had not been addressed, including country names and IGO names and acronyms.

36. The 2002 WIPO General Assembly recommended amending the UDRP in order to provide protection for country names and for the names and acronyms of IGOs.<sup>47</sup> The WIPO Secretariat transmitted these recommendations to ICANN in February 2003.<sup>48</sup>

37. Following ICANN deliberations,<sup>49</sup> ICANN's New gTLD Applicant Guidebook limited its consideration of the protection of IGO names and acronyms to providing recourse through the pre-delegation objection procedure concerning the top level (*i.e.*, an applied-for TLD), discussed in paragraphs 25 and 26 above. However, following sustained IGO efforts, ICANN's Governmental Advisory Committee (GAC) advised the ICANN Board that IGO identifiers be granted protection against inappropriate third-party registration in the DNS prior to the delegation of any new gTLDs.<sup>50</sup> The GAC further advised the ICANN Board that, building on existing criteria for ".int" second-level registrations, it would collaborate with IGOs to develop a list of IGO names and acronyms that should be protected for at least the current round of new gTLDs. The GAC also advised the Board that, pending work on further implementation, interim protection for IGO names and acronyms should be provided through a moratorium on third-party registration until resolution of the issue.

38. The ICANN Board responded to the GAC indicating that it had adopted a resolution laying the groundwork for such interim protection at the second level based on the existing .int criteria, *via* an ICANN reserve list of IGO identifiers, to be withheld from third-party registration through the new gTLD Registry Agreement. ICANN invited qualifying IGOs to identify themselves to ICANN, while also seeking provision by the GAC (with IGOs) of a consolidated IGO package comprising the criteria and list of IGO names and acronyms for which the GAC advised protection.<sup>51</sup> In response, an IGO coalition developed .int-based criteria for IGO protection and an accompanying list of IGOs, which the IGO coalition forwarded to the ICANN Board in February 2013. This was followed by a GAC communication to the ICANN Board of the GAC's

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[Footnote continued from previous page]

has allowed for the introduction of IDN ccTLDs, associated with the two-letter codes in the ISO 3166-1 standard (see [http://www.iso.org/iso/english\\_country\\_names\\_and\\_code\\_elements](http://www.iso.org/iso/english_country_names_and_code_elements)).

<sup>47</sup> See [http://www.wipo.int/edocs/mdocs/govbody/en/wo\\_ga\\_28/wo\\_ga\\_28\\_3.pdf](http://www.wipo.int/edocs/mdocs/govbody/en/wo_ga_28/wo_ga_28_3.pdf); see also documents SCT/9/8, paragraphs 6 to 11; and, SCT/9/9, paragraph 149.

<sup>48</sup> See <http://www.wipo.int/amc/en/docs/wipo.doc>.

<sup>49</sup> For background, see WO/GA/41/17 Rev.2, in particular paragraphs 40 and 41.

<sup>50</sup> See

[https://gacweb.icann.org/download/attachments/27132070/FINAL\\_Toronto\\_Communique\\_20121017.pdf?version=1&modificationDate=1354149148000&api=v2](https://gacweb.icann.org/download/attachments/27132070/FINAL_Toronto_Communique_20121017.pdf?version=1&modificationDate=1354149148000&api=v2).

<sup>51</sup> See

<https://gacweb.icann.org/download/attachments/27132070/Board%20Response%20to%20GAC%20Toronto%20Com%20munique.pdf?version=1&modificationDate=1361909146000&api=v2>.

preferred advice on IGO protection eligibility criteria,<sup>52</sup> together with a list of protectable IGO names and acronyms.<sup>53</sup>

39. On April 1, 2013, the Board wrote to the GAC with concerns as to how the protection of IGO acronyms would be reconciled with certain potentially legitimate third-party attempts to register domain names corresponding to a protected IGO acronym, and sought further particulars about the means by which cases of potentially legitimate co-existent use of such acronym could be managed in practice.<sup>54</sup> The GAC's response stressed the important global public mission of IGOs, committed to actively working to find a way forward, and reiterated its advice to the ICANN Board that preventative initial protection for listed IGO names and acronyms be in place before any new gTLDs would launch.<sup>55</sup>

40. In July 2013, following further discussions with ICANN and sustained efforts from IGOs, the GAC issued advice to the ICANN Board that highlighted the need for special preventative protection for IGO names and acronyms in the DNS.<sup>56</sup> Following this advice, the ICANN Board issued a resolution extending interim protection for IGOs until the first meeting of the ICANN Board's New gTLD Program Committee (NGPC) after the November 2013 ICANN meeting.<sup>57</sup>

41. In October 2013 the NGPC made a proposal for protection of IGO acronyms at the second level that fell short of providing IGO acronyms with the permanent preventative protection envisaged in previous GAC Communiqués.<sup>58</sup> The IGO coalition responded to the NGPC indicating disappointment that the proposal was strictly curative in nature and did nothing to prevent harm from occurring in the first place, and also conveyed its concerns to the GAC.

42. The NGPC, the GAC, and IGOs met around ICANN's November 2013 Buenos Aires meeting. The NGPC indicated that although specific technical points of its October 2013 proposal could be worked on, full preventative protection of IGO acronyms was intentionally excluded. The GAC advised the ICANN Board that interim protections for IGO acronyms should remain in place until the dialogue between the GAC, the NGPC and IGOs ensuring implementation of protection was completed, but without reiterating the GAC's previous position about the need for preventative protection.<sup>59</sup> In January 2014, the NGPC resolved to extend temporary protections for IGO acronyms until the NGPC made a final determination.<sup>60</sup>

43. In parallel to these efforts, the GNSO had launched a PDP concerning IGO protection, in which process the Center with other IGO representatives participated. Over IGO objections, in November 2013 this GNSO process largely rejected preventative protection for IGO acronyms at the second level. Instead, it recommended curative protection mechanisms for IGO acronyms, coupled with the removal of the temporary protections for IGO acronyms in place. These recommendations were adopted unanimously by the GNSO Council in November 2013. In response to this development, IGOs wrote to express concern noting that the mechanisms

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<sup>52</sup> Such criteria comprise treaty-based IGOs with international legal personality, or which are UN Observers, or which are funds or programs of the UN.

<sup>53</sup> See <http://www.icann.org/en/news/correspondence/dryden-to-crocker-chalaby-22mar13-en>.

<sup>54</sup> The Board also sought further specifics on means for periodic review of the list, along with clarification of any additional languages in which protection of IGO names and acronyms is sought. See <http://www.icann.org/en/news/correspondence/crocker-to-dryden-01apr13-en>.

<sup>55</sup> See <https://www.icann.org/en/system/files/correspondence/gac-to-board-18apr13-en.pdf>.

<sup>56</sup> The GAC further advised that it expressly assumed that the ICANN Board was prepared to fully implement the GAC advice and focus on practical and effective implementation of preventative protection at the second level in new gTLDs, and that the interim protections for IGO names and acronyms should remain in place until the dialogue between the GAC, ICANN and IGOs was completed. See <http://durban47.icann.org/meetings/durban2013/presentation-gac-communique-18jul13-en.pdf>.

<sup>57</sup> See <http://www.icann.org/en/groups/board/documents/resolutions-new-gtld-17jul13-en.htm>.

<sup>58</sup> The GAC and the NGPC had cancelled their participation in a September 30 meeting proposed by IGOs.

<sup>59</sup> See <http://www.icann.org/en/news/correspondence/gac-to-board-20nov13-en.pdf>.

<sup>60</sup> See <http://www.icann.org/en/groups/board/documents/resolutions-new-gtld-09jan14-en.htm#2.d.i>.

now foreseen would miss an important opportunity to curtail abuse of IGO acronyms in the DNS before harm could occur.<sup>61</sup>

44. In February 2014, IGOs met with the ICANN NGPC representative to discuss the NGPC's October 2013 proposal. Following this, in March 2014, the NGPC provided a draft proposal for curative rights protection for IGO acronyms. Further discussions were held between IGOs and the NGPC in ICANN's March 2014 meeting, where the GAC also advised the ICANN Board that it was awaiting the Board's response regarding the implementation of previous GAC advice.

45. In April 2014, the ICANN Board resolved to adopt the GNSO Council recommendations not in conflict with GAC advice (reserving from registration the full names of IGOs at the top and second levels, in two languages) while requesting more time to consider the recommendations that then differed from GAC advice (duration of "claims notices"<sup>62</sup> and a potential curative RPM). Notwithstanding this GAC advice and IGO positions, in June 2014, the GNSO Council voted to initiate a second PDP on the desirability and modalities of giving IGOs access to curative RPMs (such as the UDRP or URS). In October 2014, the GAC affirmed its prior advice seeking a solution for IGO identifier protection at the second level, whereby such protection should not require amending the existing UDRP.<sup>63</sup> In January 2015, the NGPC again sought information from the GAC concerning the latter's understanding of "the nature and extent of the rights of international governmental organizations with respect to curative rights protections for IGO names and acronyms".<sup>64</sup> In parallel, the GAC clarified its position on IGO protection to the GNSO IGO Working Group.<sup>65</sup>

46. In June 2015, the IGOs, GAC, and ICANN Board representatives met at the ICANN Buenos Aires meeting. The ICANN Board took note of progress towards possible ADR and rapid-takedown mechanisms for protection of IGO identifiers and called for a "small group" to communicate intersessionally with a view towards developing a concrete proposal for such mechanisms<sup>66</sup>. Notwithstanding continuing discussions, including at the ICANN's June 2016 Helsinki meeting, several questions remain as to the specifics of such mechanisms; it has again been affirmed however that any IGO-specific mechanism should not as such amend the existing UDRP. Together with other involved IGOs, the Center continues to closely monitor developments in this longstanding ICANN file.

#### (b) Geographical Terms

47. Concerning geographical terms, the GAC in particular has expressed concerns about their use and protection in the new gTLDs.<sup>67</sup> Concerning the top level,<sup>68</sup> ICANN's Applicant

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<sup>61</sup> By way of example, the IGO letter cited illicit profiteering from UNICEF funding campaigns in the wake of humanitarian emergencies.

<sup>62</sup> See footnote 38.

<sup>63</sup> See

[https://gacweb.icann.org/download/attachments/27132037/Los%20Angeles\\_GAC%20Communique\\_Final.pdf?version=1&modificationDate=1413479079000&api=v2](https://gacweb.icann.org/download/attachments/27132037/Los%20Angeles_GAC%20Communique_Final.pdf?version=1&modificationDate=1413479079000&api=v2).

<sup>64</sup> See <https://www.icann.org/en/system/files/correspondence/chalaby-to-schneider-22jan15-en.pdf>.

<sup>65</sup> See <http://mm.icann.org/pipermail/gnso-igo-ingo-crp/2015-April/000345.html>.

<sup>66</sup> See

<https://gacweb.icann.org/display/gacweb/Governmental+Advisory+Committee?preview=/27132037/39256324/BA%20MinutesFINAL.pdf>.

<sup>67</sup> In 2007, the GAC issued the "GAC Principles regarding New gTLDs", which states *inter alia* that ICANN should avoid delegation of new gTLDs concerning country, territory or place names, and regional language or people descriptions, unless in agreement with the relevant governments or public authorities. Those GAC Principles further stated that new registries should adopt procedures for blocking/challenge of names with national or geographical significance at the second level upon demand of governments. See [http://gac.icann.org/web/home/gTLD\\_principles.pdf](http://gac.icann.org/web/home/gTLD_principles.pdf).

<sup>68</sup> Concerning second-level registrations, ICANN's base registry agreement includes a "Schedule of Reserved Names at the Second Level in gTLD Registries" which makes provision for certain country and territory names. See <http://newgtlds.icann.org/en/applicants/agb/base-agreement-specs-04jun12-en.pdf> at Specification 5.

Guidebook provides that “applications for strings that are country or territory names will not be approved, as they are not available under the New gTLD Program in this application round.”<sup>69</sup> Applied-for strings which are considered by ICANN to be certain other geographical names, e.g., capital city names, need to be accompanied by documentation of support or non-objection from the relevant governments or public authorities.<sup>70</sup>

48. GAC members have expressed further reservations regarding a number of new gTLD applications on grounds of correspondence to geographical or other “sensitive” terms, advising the ICANN Board not to proceed beyond initial evaluation, and seeking Board clarification on scope for applicants to modify their new gTLD applications to address specific GAC concerns.<sup>71</sup>

49. ICANN is also managing a process to allow for the possible registration of 2-character domain names at the second level in new gTLDs.<sup>72</sup> Under this process, when a registry operator requests ICANN to authorize the release of 2-character domain names corresponding to a country code at the second level in its particular TLD, ICANN alerts the relevant government and provides a 60-day comment opportunity. If the government raises no objection, ICANN authorizes the release of such 2-character code to the registry operator. However, where governments raise objections, ICANN requests the registry operator to submit a “confusion mitigation plan”. The Center submitted comments to ICANN noting that the Second WIPO Internet Domain Name Process considered the possibility of exploring measures for the UDRP to apply to third-level registrations in order to mitigate the potential for trademark abuse.<sup>73</sup>

50. Based on government objections and proposed registry operator mitigation plans received, all of which are published on ICANN’s website,<sup>74</sup> ICANN intends to publish confusion mitigation criteria following a public comment process.

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<sup>69</sup> See <http://newgtlds.icann.org/en/applicants/agb/evaluation-procedures-04jun12-en.pdf>, from section 2.2.1.4.1 “Treatment of Country or Territory Names”.

<sup>70</sup> See <http://newgtlds.icann.org/en/applicants/agb/evaluation-procedures-04jun12-en.pdf>, from section 2.2.1.4.2 “Geographic Names Requiring Government Support”.

<sup>71</sup> See <https://www.icann.org/en/system/files/correspondence/gac-to-board-27mar14-en.pdf>, at “4. Specific Strings”. While the Board has accepted the GAC’s advice against proceeding with certain applications, it has sought further information from the GAC, as well as public comments, on a range of additional safeguards sought by the GAC concerning several broad categories of new gTLD applications such as for those new gTLDs which correspond to regulated industries or dictionary terms. See

[https://gacweb.icann.org/download/attachments/27132037/Beijing%20Communique%20april2013\\_Final.pdf](https://gacweb.icann.org/download/attachments/27132037/Beijing%20Communique%20april2013_Final.pdf). A GAC Sub-group on Geographic Names (a Sub-group of the GAC Working Group on Future New gTLDs) has developed a draft document for future New gTLD rounds outlining several public policy aspects related to geographic names which is currently subject to further ICANN discussions. See <https://gacweb.icann.org/download/attachments/27132037/Geo%20names%20in%20new%20gTLDs%20Updated%200%20V3%20%2029%20august%202014%5B4%5D.pdf?version=1&modificationDate=1411549935000&api=v2>.

<sup>72</sup> ICANN Proposed Measures for Letter/Letter Two-Character ASCII Labels to Avoid Confusion with Corresponding Country Codes. See <https://www.icann.org/public-comments/proposed-measures-two-char-2016-07-08-en>.

<sup>73</sup> See <https://forum.icann.org/lists/comments-proposed-measures-two-char-08jul16/pdfvt13ZDkPrS.pdf>.

<sup>74</sup> See <https://www.icann.org/resources/two-character-comments>.

51. On these and other DNS-related issues, the Center has endeavored to apprise relevant sectors within the Secretariat, including in support of the work of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT).<sup>75</sup> The Secretariat will continue to monitor these developments and provide input where possible.

*52. The WIPO General Assembly is invited to take note of the document "WIPO Arbitration and Mediation Center, Including Domain Names" (document WO/GA/48/12).*

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<sup>75</sup> See e.g., documents SCT/24/4, SCT 25/3, SCT 26/6 and 27/8.