

ASIPI COMMENTS ON THE SECOND WIPO INTERNET DOMAIN NAME PROCESS (WIPO2 RFC-2)

As a not-for-profit Association, ASIPI seeks to: Bring together concerned professionals to study, disseminate and develop Intellectual Property laws and to coordinate and harmonize such laws in the Americas.

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Personal Names

20. Protection against abusive registration as a domain name in the gTLDs should be accorded to personal names.

It is important to bear in mind that in some cases personal names are used and registered as trademarks and/or service marks and as such a protection against abusive registration of these personal names has been accorded through the First WIPO Internet Domain Name Process (WIPO1).

1. Personal names should be protected against bad faith, abusive, misleading and unfair registration and use as domain names in the DNS. Personal names should also be protected against predatory and parasitical practices.
2. Registration of personal names as domain names by cybersquatters.
3. All personal names should be protected, including first and last name, surnames, nicknames, fictitious (character) names, or any combination of the above, as long as they are names of famous persons, either living or deceased. The degree of knowledge or recognition of the person in a particular sector of the public should be taken into account in determining whether a personal name is famous.
 1. Any use or registration of personal names which would lead the public to confusion should be regarded as a case of bad faith, abusive, misleading or unfair registration or use.
 2. Multiple incidences of the same name should be dealt with the principle of first come first served, finding creative solutions based on the particular cases, and as long as good faith is involved.
 3. The same provisions used for dispute resolutions with respect to disputes concerning trademarks registered as domain names, in order to maintain uniformity.

4. UDRP should be revised in order to adequately resolve problems and abuses within the DNS related to personal names.
5. Protection for personal names of famous persons should be granted in connection with all types of gTLDs.
6. Existing domain name registrants must be given the opportunity to defend their registration vis-à-vis the personal name holder, through an enhanced UDRP system.
7. Since only personal names of famous persons should be accorded protection, directory, listing or other similar services should not be useful as valid criteria for protection.
8. Personal name protection should be accorded only for names of famous persons, in order to limit the restriction and permit the development of the Internet as a medium for communication and electronic commerce.

International Nonproprietary Names (INNs) for Pharmaceutical Substances

21. Protection against abusive registration as a domain name in the gTLDs should be accorded to INNs.

1. INNs should be protected against bad faith, abusive, misleading or unfair registration and use as domain names in the DNS.
2. Any use or registration of INNs which would lead the public to confusion as to a pharmaceutical substance or active pharmaceutical ingredient should be restricted.
3. Any unauthorized use or registration of INNs made by other than WHO should be regarded as a case of bad faith, abusive, misleading or unfair registration or use.
4. It depends on how the WHO intends to use the INNs in the Internet.
5. All INN's listed by the WHO should be excluded from the possibility of registration as a domain name and should be directly registered by the WHO.
6. Ex-officio.

7. The same provisions used for dispute resolutions with respect to disputes concerning trademarks registered as domain names, in order to maintain uniformity.
8. Protection for INN's should be granted in connection with all types of gTLDs.
9. Existing domain name registrants must be given the opportunity to modify their registration if they are manufacturers producing the pharmaceutical substance. They might amend their domain name registration by adding their tradename or corporate name, as allowed by the WHO.
10. All INNs listed by the WHO should be excluded from registration as domain names and should be directly registered by the WHO.

Names of International Intergovernmental Organizations

22. Protection against abusive registration as a domain name in the gTLDs should be accorded to names and acronyms of international intergovernmental organizations.

National legislations and international conventions grant protection to names and acronyms of international and intergovernmental organizations.

1. Yes, they should be protected against bad faith, abusive, misleading or unfair registration and use in the DNS.
2. Protection should be accorded to all organizations that have comply with the provisions of the Paris Convention.
3. Registration of names and acronyms of international intergovernmental organizations by cybersquatters.
4. Any unauthorized use or registration of names and acronyms of international intergovernmental organizations made by other than the international intergovernmental organization should be regarded as a case of bad faith, abusive, misleading or unfair registration or use.
5. Protection for names and acronyms of international intergovernmental organizations should be accorded in connection with all types of gTLDs.
6. The same provisions used for dispute resolutions with respect to disputes concerning trademarks registered as domain names, in order to maintain uniformity.

7. All names and acronyms of international intergovernmental organizations that comply with the provisions of the Paris Convention should be excluded from the possibility of registration as a domain name, unless an authorization from the corresponding organization is granted.
8. The exclusion should block the registration. It should be executed ex-officio.
9. Existing domain name registrants should be given the opportunity to defend their registration through UDRP, on the same grounds of article 6ter-c of the Paris Convention.
10. The list of names and acronyms of international intergovernmental organizations that comply with the provisions of the Paris Convention should be used to exclude the registration of these names and acronyms as domain names.
11. Only identical names and acronyms should be excluded, in order to limit the restriction and permit the development of the Internet as a medium for communication and electronic commerce.

Geographical Indications, Indications of Source or Geographical Terms

23. Geographical indications, indications of source and geographical terms are complex issues. Geographical indications should be granted protection in accordance with the TRIPS.

1. Yes, all should be protected against bad faith, abusive, misleading and unfair registration and use in the DNS.
2. Registration of geographical indications, indications of source and geographical terms may lead to confusions, errors and unfair competition.
3. Any unauthorized use or registration of geographical indications and indications of source should be regarded as a case of bad faith, abusive, misleading or unfair registration or use. In the case of geographical terms, the situation may vary depending on the importance and knowledge of the geographical term. Some trademark legislations permit registration of geographical terms which may contradict the idea of giving additional protection to these terms.
4. Mainly those receiving protection under the TRIPS Agreement.

5. Protection for geographical indications, indications of source and geographical terms should be accorded in connection with all types of gTLDs. Special protection should be granted in the ccTLDs to indications of source or geographical terms corresponding to name of a country.
6. The same provisions used for dispute resolutions with respect to disputes concerning trademarks registered as domain names, in order to maintain uniformity.
7. Any interested party, including the consumers and public in general.
8. Yes.
9. Registration of names of countries in the ccTLDs should be blocked for others than the corresponding governments.
10. Existing domain name registrants must be given the opportunity to defend their registration through UDRP.
11. No.
12. Mainly those geographical indications protected by the TRIPS Agreement should be granted protection, in order to limit the restrictions to the development of the Internet as a medium for communication and electronic commerce.

Tradenames

24. Protection against abusive registration as domain names in the gTLDs should be accorded to tradenames.

1. Yes, tradenames should be protected against bad faith, abusive, misleading and unfair registration and use in the DNS.
2. All tradenames protected under the Paris Convention.
3. Registration of tradenames as domain names by cybersquatters.
4. Any use or registration of tradenames which would lead the public to confusion should be restricted.
5. The same provisions used for dispute resolutions with respect to disputes concerning trademarks registered as domain names, in order to maintain uniformity.

6. The legitimate tradename owner.
7. Protection for tradenames should be granted in connection with all types of gTLDs.
8. Existing domain name registrants must be given the opportunity to defend their registration vis-à-vis the tradename holder or owner, through UDRP.
9. No.
10. Only identical or confusingly similar tradenames should be restricted, in order to permit the development of the Internet as a medium for communication and electronic commerce.

Technical Solutions for Domain Name Collision Control

25. Harmonization should prevail when policing domain names and trademarks. New commercial gTLDs should reflect a commercial classification more or less similar to the trademark classification. It is not necessary to distinguish between goods and services, but to clearly identify different areas of interest from the Internet user perspective. Some attempts have been made in this connection without much acceptance from ICANN members.

Assigning Key Words to the New gTLDs

The new commercial gTLDs should consist of some “Key gTLDs” which identify specific activities. The following proposed table shows how the “Key gTLDs” could identify these activities.

The “Key gTLDs” descriptions can fluctuate from time to time to better reflect the kind of commerce they intend to categorize.

The following “Key gTLDs” are only examples that can be substituted by some better key words in order to reduce their amount. One “Key gTLD” may correspond to two or more trademark classes. At the same time, one trademark class may have more than one “Key gTLD”.

TM CLASS	gTLD	TM CLASS	gTLD	TM CLASS	gTLD
1	Key gTLD: “.chem”	18	Key gTLD: “.lea”	35	Key gTLD: “.com”; and “.biz”

2	Key gTLD: “.paint”	19	Key gTLD: “.build”	36	Key gTLD: “.com”; and “.biz”
3	Key gTLD: “.care”	20	Key gTLD: “.fur”	37	Key gTLD: “.build”
4	Key gTLD: “.fuel”	21	Key gTLD: “.house”	38	Key gTLD: “.tel”
5	Key gTLD: “.care”	22	Key gTLD: “.tex”	39	Key gTLD: “.aero”
6	Key gTLD: “.met”	23	Key gTLD: “.tex”	40	Key gTLD: “.treat”
7	Key gTLD: “.dev”	24	Key gTLD: “.tex”	41	Key gTLD: “.rec” ; and “.museum”
8	Key gTLD: “.dev”	25	Key gTLD: “.tex”	42	Key gTLD: “.pro”
9	Key gTLD: “.elec”	26	Key gTLD: “.tex”	43	
10	Key gTLD: “.care”	27	Key gTLD: “.coat”	44	
11	Key gTLD: “.basic”	28	Key gTLD: “.game”	45	
12	Key gTLD: “.car”	29	Key gTLD: “.food”	46	
13	Key gTLD: “.arm”	30	Key gTLD: “.food”	47	
14	Key gTLD: “.gem”	31	Key gTLD: “.food”	48	
15	Key gTLD: “.mus”	32	Key gTLD: “.drink”	49	
16	Key gTLD: “.font”	33	Key gTLD: “.drink”	50	
17	Key gTLD: “.rub”	34	Key gTLD: “.tob”	51	

The adoption of the proposed system shall decrease the gap existing between commercial domain names and trademarks and shall bring cohesion to the future classification of the gTLDs.

Respectfully Submitted By:
Internet Committee
ASIPI

ASOCIACION INTERAMERICANA DE LA PROPIEDAD INDUSTRIAL

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