THE RECOGNITION OF RIGHTS AND THE USE OF NAMES IN THE INTERNET DOMAIN NAME SYSTEM

Interim Report
of the
Second WIPO Internet Domain Name Process
http://wipo2.wipo.int

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World Intellectual Property Organization (WIPO)
34, chemin des Colombettes
P.O. Box 18
1211 Geneva 20
Switzerland

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For information concerning the Second WIPO Internet Domain Name Process:

Office of Legal and Organization Affairs
Telephone: (41 22) 338 8138
Fax: (41 22) 733 31 68
Internet: http://wipo2.wipo.int
e-mail: ecommerce@wipo.int

SUMMARY OF CONTENTS

Executive Summary

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Annexes

EXECUTIVE SUMMARY

1 Between July 1998 and April 1999, the World Intellectual Property Organization (WIPO) undertook an extensive international process of consultations with the public and private sectors to develop recommendations on ways to deal with certain predatory and parasitical practices that had developed in the registration of domain names. The central recommendation of the final Report published at the conclusion of this first WIPO Internet Domain Name Process was that a simple and cost-effective dispute resolution procedure should be established to deal with cases of deliberate and bad faith registration and use of domain names in violation of trademarks, a practice commonly known as "cybersquatting."

2 Following WIPO's recommendation, the Internet Corporation for Assigned Names and Numbers (ICANN), the body responsible for the technical management of the domain name system, adopted the Uniform Domain Name Dispute Resolution Policy (UDRP). The UDRP entered into force in December 1999. In the 15 months since its commencement, more than 4,000 cases have been filed under it.

3 The UDRP is limited to the abusive registration of domain names in violation of *trademark* rights. In the course of the first WIPO Process, it became apparent that other forms of real-world identifiers were also being targeted and made the subject of predatory practices in the domain name system. The identification of these other areas of abusive registrations led to a request to WIPO to undertake a further international process to develop recommendations on whether and, if so, how such practices in respect of other identifiers might be dealt with. In response to this request, the Second WIPO Internet Domain Name Process was commenced in July 2000.

4 The present Report constitutes the Interim Report of the Second WIPO Process. It deals with the abusive registration of domain names in relation to the following identifiers:

- International Nonproprietary Names for pharmaceutical substances (INNs). INNs are used within the health sector as a system managed by the World Health Organisation to maintain generic names for pharmaceutical substances free from proprietary rights and available for use by all;

- The names and acronyms of international intergovernmental organizations, such as the United Nations (UN) or the World Intellectual Property Organization (WIPO);

- Personal names;

- Geographical indications, which are terms recognized in law as designations applied to products which originate in a certain area and which bear characteristics that are particular to that area. Geographical indications are well-known in respect of, for example, wine. In addition to geographical indications, the Interim Report addresses the putatively abusive registration of geographical terms, such as the names of countries and peoples;

- Trade names, which are the names applied to distinguish an enterprise (as opposed to the products or services of the enterprise).

5 The Interim Report sets out considerable evidence of the registration of the above-mentioned identifiers as domain names when no connection exists between the holder of the domain name registration and the person, entity or group with which the identifier is authentically associated. It also sets out possible solutions to predatory practices in respect of these identifiers. Those solutions or recommendations are advanced for the purpose of promoting further discussion within the international community before developing positions for the final report of the Second WIPO Process, which is expected to be published in July 2001.

6 WIPO will conduct a series of meetings throughout the world over the coming months to promote discussion and to develop ideas in relation to the questions dealt with in the Interim Report. All interested parties are invited to attend those meetings, or to submit written comments for consideration through WIPO's website for this Second Process at *http://wipo2.wipo.int*.

REAL AND VIRTUAL IDENTIFIERS

1. In July 1998, upon the proposal of the Government of the United States of America, and with the approval of its member States, WIPO commenced an extensive international process of consultations, which became known as the WIPO Internet Domain Name Process ("the first WIPO Process"). The purpose of the first WIPO Process was to develop, through public and private sector consultations, recommendations on certain questions arising out of the interface between Internet domain names, on the one hand, and trademarks on the other hand. The central recommendation contained in the final Report of the first WIPO Process, which was published in April 1999,[1] was that an administrative dispute settlement procedure should be adopted with effect throughout the generic top-level domains which were open for registration of domain names without restriction. It was proposed that this dispute resolution procedure should be available to deal with complaints in which it was alleged that a domain name had been registered and was being used deliberately and in bad faith in violation of a complainant's trademark rights.

2. The recommendation for the establishment of such an administrative dispute resolution procedure was, in due course, adopted by the body that had been established to take responsibility for the technical management of the domain name system (DNS), the Internet Corporation for Assigned Names and Numbers (ICANN), a not-for-profit corporation established under the laws of the State of California, in the United States of America.[2]

3. The dispute resolution procedure, known as the Uniform Domain Name Dispute Resolution Policy (UDRP), entered into operation on December 1, 1999. Four dispute-resolution service providers have been accredited to administer disputes under the procedure. The WIPO Arbitration and Mediation Center was the first dispute-resolution service provider to be accredited and the first with which a dispute was filed.

4. Since the entry into force of the UDRP, over 3640 decisions have been rendered, of which 2316 have been administered by the WIPO Arbitration and Mediation Center. The UDRP has attracted a widespread geographical participation, reflecting the international nature of the Internet. Within the calendar year 2000, for example, parties to complaints filed with the WIPO Arbitration and Mediation Center came from 74 countries. The UDRP has also proven itself to be an efficient and cost-effective means of resolving disputes. Of the 1,841 cases filed with the WIPO Center in the year 2000, 69.9% of the cases were resolved. Filing such a case with the WIPO Center costs US$1,500 and a decision is normally given within 50 days of the commencement of the procedure.

5. The UDRP was deliberately limited in scope. It deals only with the class of disputes that concern conflicts between domain names and trademarks and, within that class, it deals only with deliberate, bad faith violations of trademarks in which the domain name holder has no rights or legitimate interests in the domain name. Such deliberate, bad faith violation of

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1 *The Management of Internet Names and Addresses: Intellectual Property Issues*, available at *http://wipo2.wipo.int/process1/report/finalreport.html*.

2 For details on the organization and activities of ICANN, see *http://www.icann.org*.

trademark rights through the registration and use of domain names is popularly known as 'cybersquatting.'

6. The limited scope of the UDRP was a natural outcome of the first WIPO Process for which the mandate was formulated as the development of "recommendations for a uniform approach to resolving trademark/domain name disputes involving cyberpiracy (as opposed to conflicts between trademark holders with legitimate competing rights)."[3] Not only was the mandate for the first WIPO Process limited, but the environment in which the recommendations of the first WIPO Process were made was one in which many elements were new and untried. ICANN was established only in the course of the first WIPO Process and had only recently commenced operations by the time that the final Report of the first WIPO Process was published. In addition, the notion of an administrative dispute resolution procedure with a quasi-international competence within the DNS was untried. Furthermore, the concept of implementing policy through rules established by a technical and private body was new. All these elements signaled the need to proceed cautiously and gradually. Thus, when it became apparent in the course of the first WIPO Process that the practice of cybersquatting went well beyond the violation of trademark rights and encompassed the putatively unfair abuse of other forms of identifiers, the final Report of the first WIPO Process did not recommend immediate solutions for these other areas, but rather identified them as issues that would require careful attention in the future.

THE SECOND WIPO PROCESS: DOMAIN NAMES AND OTHER IDENTIFIERS

7. Since the publication of the final Report of the first WIPO Process, the DNS has continued to attract increasing interest as the system for identification, navigation and location on the Internet, with the demand for domain names seeming to increase endlessly. More than 35 million registrations are reported in the generic and country code top-level domains (gTLDs and ccTLDs, respectively).[4] At the same time, the introduction by ICANN of competition between domain name registration authorities has resulted in greater complexity in the technical infrastucture, operation and management of the DNS. ICANN's approval of proposals for seven new gTLDs in November 2000, while opening new space for domain name registrations, has further extended the complexity of the DNS.[5]

8. As the DNS has evolved, and as demand for domain name registrations has increased, a greater awareness has arisen of the profundity of the tension between domain names, as the identifiers in the virtual world, on the one hand, and naming systems used in the physical

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3 Department of Commerce of the United States of America, *Statement of Policy on the Management of Internet Names and Addresses*, June 5, 1998. See *http://www.ntia.doc.gov/ntia/home/domainname/6_5_98DNS.htm.*

4 As of the date of this Interim Report, the number of registrations in .com alone is reported to exceed 21 million.

5 As its meeting on November 16, 2000, the ICANN Board selected seven new top-level domains. The new gTLDS, which are not expected to be operational before the middle of 2001, are .aero, .biz, .coop, .info, .info, .museum, .name and .pro. For further information, see *http://www.icann.org/tlds/.*

world, on the other hand. Trademarks are but one example of the latter class of naming systems. Their commercial value and the attention focussed on them through advertising and branding naturally caused them to be prominent at the first stages of consideration of the intersection between domain names and real-world identifiers. There are many other real-world identifiers, however, that play vital roles in the areas of government (for example, the names of countries, government departments or international organizations), health (for example, International Nonproprietary Names for pharmaceutical substances (INNs)), science (for example, naming systems used for the plant and animal kingdoms) and almost any other sphere of human endeavor or activity. Wherever one looks in the physical world, there is a naming system to assist the regard, whether it be on a banal but important level, such as street names, or on a metaphysical level, such as the names in the pantheon of gods.

9. Most real world naming systems are territorially bound. Most real world systems are also usually deployed in a specific context, whether commerce, physical science, geography or religion. In contrast, domain names exist in a global space and are used within that space for all manner of purpose, whether commercial, cultural, political or otherwise.

10. The Second WIPO Process is essentially concerned with the questions that arise out of the intersection of domain names with certain of these other real-world naming systems. It does not purport to cover all real-world naming systems other than trademarks, but only those specified in the mandate addressed to WIPO by its Member States.

MANDATE FOR THE SECOND WIPO PROCESS

11. On June 28, 2000, the Director General of WIPO received a request from 19 of WIPO's Member States to initiate a new consultation process similar to the first WIPO Process. The purpose of the Second WIPO Process was to be the development of recommendations on means of dealing with the "bad faith, abusive, misleading or unfair use of:

- personal names;
- International Nonproprietary Names (INNs) for pharmaceutical substances;
- names of international intergovernmental organizations;
- geographical indications, geographical terms or indications of source; and
- trade names.[6]

12. The request specified that "this activity should take full advantage of WIPO's prior work and build on existing and ongoing discussions while allowing for a process of consultation with WIPO Members and all interested stakeholders." Further, it directed that "in undertaking this process, it would be beneficial if any information received or collected concerning technical solutions to domain name collision control was collated for the

[6] The request was set forth in a letter from the Minister for Communications, Information Technology and the Arts of the Government of Australia. An attachment to the letter indicated that the following States endorsed the request: Argentina, Australia, Canada, Denmark, France, United States of America and the European Union. A copy of the letter is available at *http://wipo2.wipo.int/process2/rfc/letter.html.*

information of WIPO Members and the Internet community." The request recommends that the "findings and recommendations should be submitted to the Members of WIPO and for consideration by the Internet community (including the Internet Corporation for Assigned Names and Numbers)."

13. WIPO formally commenced the Second WIPO Process on July 10, 2000. The Second WIPO Process is being conducted in a manner similar to the consultative process that was employed in the first WIPO Process. Three Requests for Comments (RFCs), of which this Interim Report is the third, have been published to seek comments from all interested parties and stakeholders on the issues addressed in the Second WIPO Process. The first Request for Comments, published on July 10, 2000, requested comment on the proper scope of the Process, including the principal issues to be addressed therein and the suggested procedures and timetable for the Process (WIPO2 RFC-1). More than 200 comments were received on this RFC, many of which expressed views on the merits of issues in the Second WIPO Process. WIPO published the second Request for Comments (WIPO2 RFC-2) on October 13, 2000, this time expressly seeking comment on the substance of the issues to be addressed in the Second WIPO Process. Approximately 60 comments were received on the second RFC, providing detailed views on the issues that had been presented for the five categories of identifiers. All of the written comments that have been received are posted on WIPO's Process web site at *http:// wipo2.wipo.int*.

14. A series of regional consultations have also been organized, so that interested parties throughout the world can participate to present their views in person and discuss the issues in the Second WIPO Process. A number of meetings were held during the year 2000, in conjunction with WIPO's Regional Ecommerce meetings,[7] in which the issues addressed in the Second WIPO Process were introduced and discussed. A further series of five consultations have been planned to be held during this year, at which the proposals in this Interim Report will be discussed. The location and dates of these meetings are listed for information below:

DATE	MEETING
April 23, 2001	Brussels
April 26, 2001	Accra
May 10, 2001	Buenos Aires
May 24, 2001	Melbourne
May 29, 2001	Washington D.C.
May 30, 2001	Valencia

15. The comments received at the consultations, as well as those submitted via WIPO's web site, will be taken into account in the recommendations to be made in WIPO's Final Report, which is expected to be published in mid-2001. The Final Report will be submitted to WIPO's Member States and provided to the Internet community, including the Internet Corporation for Assigned Names and Numbers (ICANN).

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[7] Further information concerning these prior meetings can be found on WIPO's web site at *http://wipo2.wipo.int/process2/consultations/series1/*.

GUIDING PRINCIPLES IN THE FORMULATION OF RECOMMENDATIONS

16. In the final Report of the first WIPO Process, five guiding principles were set out which formed the methodological principles guiding the formulation of the recommendations contained in that Report.[8] Those five principles are repeated in the following paragraphs and their applicability in the context of the Second WIPO Process is reviewed.

17. The first principle was respect for the diversity of purposes for which the Internet was used and, consequently, the diversity of interests that need to be taken into account in developing sectoral recommendations. We see no reason to diverge from this principle in the context of the Second WIPO Process. On the contrary, the nature of the Second WIPO Process underlines the diversity of uses of the Internet and the diversity of interests that need to be taken into account, since it concerns identifiers that have special significance beyond the purely commercial sphere. The identifiers whose potential misuse is considered in the Second WIPO Process are of fundamental importance to the health sector, agriculture, consumers, and collective, personal and corporate identity. Such diverse fields require accommodation, rather than exclusion.

18. The second guiding principle in the initial WIPO Process was respect for the limitations of the existing law and for the fundamental proposition that the legislation of new law should only be effected through a representative and legitimate authority. Thus, the goal of the first WIPO Process was not to create new rights in intellectual property, nor to accord greater protection to intellectual property in cyberspace than that which existed elsewhere. Rather, the goal was to give proper and adequate expression to the existing, multilaterally agreed standards of intellectual property protection in the context of the multijurisdictional medium of the Internet. It is clear that the discipline expressed in this particular principle will be deliberately tested in the context of the Second WIPO Process, since the mandate for the Second WIPO Process encompasses also interests that lie on the periphery of established principles in the multilateral systems, for example, rights to personal or collective cultural identity. The application of this guiding principle in the context of the Second WIPO Process therefore requires some adjustment. It is not applied so as to avoid discussion of all areas which fall outside existing established principles. Rather, the approach has been adopted of seeking to identify clearly where the existing legal framework is insufficient to cover any proposed interest under consideration. It is then a question for the appropriate authorities to decide whether and how they may wish to create new principles to deal with such new interests.

19. The third guiding principle in the first WIPO Process was to accord proper and adequate respect to agreed rights outside the intellectual property system by ensuring that any recommendations did not result in a diminution in, or otherwise adversely effect, the enjoyment of such other agreed rights. We believe this principle to be fully applicable in the context of the Second WIPO Process.

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[8] See *The Management of Internet Names and Addresses: Intellectual Property Issues*, paras. 32-37.

20. The fourth principle in the original WIPO Process was respect for the functionality of the Internet by ensuring that any recommendations were practical in nature and would not impose unreasonable burdens on the high-volume and highly automated operations of domain name registration authorities. Again, we believe this principle to be fully applicable without modification in the context of the Second WIPO Process.

21. A final principle in the first WIPO Process was respect for the underlying dynamic nature of the technologies that underlie the development and expansion of the Internet. Thus it was intended that no recommendation should in any way condition or affect the future technological development of the Internet. The further dynamic expansion of the Internet throughout the world since the first WIPO Process underlines the immense importance of continuing to apply this guiding principle in the context of the Second WIPO Process.

THE INTERIM NATURE OF THE PRESENT REPORT

22. It should be emphasized that the present Report represents only a mid-point view of the issues that are in consideration in the Second WIPO Process. One of the essential aims of the present Report has been to seek greater clarity in the identification and definition of issues. Where it is considered that clarity is lacking, explicit requests are made in the Report for further information and further submissions to assist in developing appropriate positions in the Final Report. Where recommendations are already made in the Report, they are decidedly provisional in nature and are intended to provoke further discussion and to challenge all interested parties to review and comment upon them.

IMPLEMENTATION OF FUTURE RECOMMENDATIONS

23. As mentioned above, WIPO has been asked to address in this Second Process a number of issues that lie on the perimeter of the established multilateral system of norms and standards. A question that may arise for future decision as a consequence of any recommendations for action that may be made in the Final Report concerning such issues will be the manner in which the policy expressed in those recommendations should be implemented. In this respect, two options are available that will require careful consideration.

24. The first option for policy implementation is adoption of the policy by ICANN. This method of proceeding has the obvious advantage of the possibility of deploying the technical infrastructure of the DNS in support of policy preferences. For example, the UDRP can function only because accredited registrars agree to implement the results of individual cases under the UDRP by canceling or transferring domain name registrations when such a result is ordered in a case. Similarly, if a blocking mechanism were to be contemplated in respect of any class of names, it could be implemented technically as a condition of the accreditation arrangements between ICANN and registration authorities.

25. The foregoing approach has the obvious advantages of automaticity in effect and total coverage. Since the technical infrastructure is deployed in favor of the policy, the policy can

effectively be implemented throughout the whole of that technical infrastructure, namely, the DNS.

26. The efficiency with which policy can be implemented through the deployment of the technical infrastructure, however, also inspires caution. New law has, in the past, been created in democracies by representative legislatures. It is one thing to give expression to existing law in an effective manner through the deployment of a powerful technical infrastructure. It is quite another thing to use the technical infrastructure not merely for the implementation, but also for the formulation, of new laws.

27. The second option remains the classical option of the international system, the treaty. The disadvantages of the treaty in the context of a medium that changes rapidly and radically like the Internet are apparent. Multilateral treaties take years to negotiate, and years to bring into effect across any widespread geographical area. The machinery for revising them is also usually equally as cumbersome. On the other hand, treaties are negotiated by legitimately empowered representatives of elected governments and are given effect usually only after ratification by the elected government.

28. The limitations of the two existing options are apparent. Those limitations call for a concerted effort to find the means of allowing social processes to be as innovative, subtle and beneficial as the technological processes that have provoked the challenges which the social processes are called upon to address.

INTERNATIONAL NONPROPRIETARY NAMES FOR PHARMACEUTICAL SUBSTANCES (INNs)

29. In common with all other areas of human activity, the health sector has been affected in a variety of fundamental ways by the Internet. Vast amounts of health-related information are available through the Internet to a global audience which can retrieve and use it with unprecedented ease and efficiency.[9] The accuracy and reliability of that information are matters of primary interest to public health and safety.

30. Identifiers play an important role with respect to health products, services and information. In particular:

(i) on the Internet, identifiers enable health-related information to be located;

(ii) both in the physical world and on the Internet, they constitute means of signaling the source of products, services and information; and

(iii) both in the physical and virtual worlds, they constitute connectors between producers or suppliers, on the one hand, and consumers, on the other hand, enabling consumers to associate certain consistent characteristics or attributes of products or information with the identifiers used for those products or information.

31. In recognition of the importance of the role of identifiers, prior to the arrival of the Internet, the health sector had developed a system for ensuring that a certain class of identifiers would be free from appropriation through private rights and available for public use. This system, developed and managed by the World Health Organization (WHO), attributed such public status to those identifiers that were classified as "International Nonproprietary Names" (INNs).

32. With the arrival of the Internet and the domain name system, a new opportunity arose for tainting the public status of an INN. By registering an INN as a domain name, the functional capacity of the INN to serve as an address locator and identifier on the Internet could be appropriated and controlled by the domain name holder.

33. The appropriation of INNs through domain name registrations came to light in the course of the first WIPO Internet Domain Name Process. The Report of that Process recognized that the issue was outside the scope of the mandate of the first Process, but recommended that serious consideration be given in future to the exclusion of INNs from registration in the open generic top-level domains (gTLDs).[10] This recommendation led to the request to WIPO to explore, in the second WIPO Internet Domain Name Process, the issues

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[9] Google search engine lists more than 46 million health related sites, and Yahoo! Shopping offers more than 50,000 listings for sales and purchase of health products. The proposal submitted by the World Health Organization (WHO) for a .health gTLD noted the existence of more than 10,000 health-related sites.

[10] WIPO, *The Management of Internet Names and Addresses: Intellectual Property Issues* (April 30, 1999) at paras. 295-303.

raised in the domain name space by the bad faith, abusive, misleading or unfair use of INNs. In addressing this request, the present Chapter describes the operation and policy of the INN system and explores ways in which the policy of that system might best be expressed within the domain name space.

THE INN SYSTEM

34. An International Nonproprietary Name (INN) is a unique name used to identify a pharmaceutical substance or active pharmaceutical ingredient. Some examples of INNs are amoxicillin, ampicillin, nandrolone, temazepam, phenobarbital, amfetamine, ibuprofen, chloroquine and retinol.[11] INNs are selected by WHO, in coordination with national authorities worldwide. WHO maintains a list of recommended INNs, now numbering more than 8,000, to which between 120 and 150 new names are added each year.

35. WHO is a specialized agency of the United Nations with 191 Member States and a constitutional responsibility to "develop, establish and promote international standards with respect to biological, pharmaceutical and similar products."[12] WHO has the international mandate to offer recommendations to its Member States on any matter within its competence, including setting norms and standards for pharmaceutical products in international commerce.

THE SELECTION OF INNs

36. The international nomenclature system for INNs was established by a World Health Assembly resolution in 1950,[13] which also provided for the development of a selection procedure for recommended INNs.

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11 See "The use of common stems in the selection of International Nonproprietary Names (INN) for pharmaceutical substances," April 2000, Programme on International Nonproprietary Names, Quality Assurance and Safety: Medicines, Essential Drugs and Medicines Policy, WHO, Geneva (WHO/EDM/QSM/99.6). See also Daniel L. Boring "The Regulation and Development of Proprietary Names for Pharmaceuticals in the United States" *Trademark World* (November/ December, 1997) at 40.

12 *Basic Documents*, 39th edition, Geneva, World Health Organization, 1992. See also "Guidelines on the Use of International Nonproprietary Names (INNs) for Pharmaceutical Substances," 1997, Report of the Programme on International Nonproprietary Names (INN), Division of Drug Management & Policies, WHO, Geneva (WHO/PHARM S/NOM 1570).

13 Annex V sets out the World Health Assembly resolutions pursuant to which the INN system was established. Usually, an INN consists of a randomly chosen prefix and a common 'stem': substances belonging to a group of pharmacologically related substances denote this relationship by using a common stem or suffix. For a description of the use of stems and a list of common stems in the INNs system, see "Guidelines on the Use of International Nonproprietary Names (INNs) for Pharmaceutical Substances", 1997, Report of the Programme on International Nonproprietary Names (INN), Division of Drug Management & Policies, WHO, Geneva (WHO/PHARM S/NOM 1570) at Section 3 and Annex 3.

37. The current selection process for INNs begins with a request, often by a national nomenclature authority or a pharmaceutical company, that is submitted for examination and name selection by the WHO Expert Panel on the International Pharmacopoeia and Pharmaceutical Preparations ('WHO Expert Panel'), made up of representatives of all the major national nomenclature committees. The proposed INN is published in the *WHO Chronicle* for comment or objection by any interested person over a four-month period. If no objection is raised during that period, the name is published as a recommended INN.

38. To qualify for selection, INNs must be succinct, distinctive in sound and spelling, so as to avoid confusion with other commonly used names, and must be in the public domain and therefore freely available for the sole purpose of identifying the pharmaceutical substance in question. To enable INNs to be used around the world, various linguistic conventions are harmonized by rules that specify, for example, which letters should be avoided ('h' and 'k'), that 'e' should be used in lieu of 'ae' and 'oe', 'i' instead of 'y' and 't', and 'f' instead of 'th' and 'ph'. The WHO Procedure for Selection of INNs is set out at Annex IV hereto.

39. Recommended INNs are notified by WHO to its Member States, with a request that their national authorities take the necessary steps to prevent the acquisition of proprietary rights in the name, including prohibiting registration of the name as a trademark.

THE POLICIES UNDERLYING THE INN SYSTEM

40. The prohibition on the acquisition of proprietary rights in INNs is intended to implement three main policies:

(i) The first policy is the establishment of INNs as generic or common names which are public property and, thus, available for use by all.

(ii) The second policy is the promotion of the veracity and reliability of health information, which, it is considered, might be endangered if INNs were able to be controlled through private property rights by a single person or entity.

(iii) The third policy is the prevention of dilution in the meaning or semantic associations established with respect to INNs, which again, it is considered, might occur if INNs were legally controlled by private interests.

INNS AND TRADEMARKS

41. The prohibition on the acquisition of proprietary rights in INNs is not expressed in formal law but, rather, is adopted as a policy by consensus of the public and private sectors concerned with health. The policy extends only to the appropriation of the exact INN itself and of the stem of the INN.

42. In line with the intended status of INNs as generic or common names, manufacturers of pharmaceutical substances are encouraged to use their corporate names together with INNs in

marketing products. Thus the use of "[INN] [name of manufacturer]" in the promotion and marketing of products is not considered to offend the policy against acquisition of proprietary rights in INNs.

QUESTIONS FOR DECISION

43. In addressing the possible implementation of protection for INNs in the domain name space, three major questions arise:

(i) As a matter of principle, should INNs be protected against registration as domain names?

(ii) If it is decided that INNs should receive protection against domain name registration, what is the extent of the protection that should be conferred?

(iii) Again assuming that it is decided that INNs should receive protection against domain name registration, how (that is, by what mechanism) should that protection be implemented?

SHOULD INNs BE PROTECTED AGAINST REGISTRATION AS DOMAIN NAMES?

44. Unlike a trademark, a domain name is not a legal title which confers upon its holder the right to exclude others from using it. Thus, the mere registration of an INN as a domain name does not preclude anyone from using the INN as part of the marketing or promotional information of a product or in content on a website. However, a domain name is a unique address and thus anyone who registers an INN as a domain name occupies a unique space and acquires a unique advantage in associating the website that is accessed through the domain name with the INN. This monopoly of association would seem to be precisely that which is sought to be avoided through the INN system's policy against the acquisition of proprietary rights in an INN. It may lead to the danger of undue influence over the control of information relating to the INN, with consequent risks for the veracity and reliability of that information. As one commentator remarked: "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."[14]

45. While evidence of actual damage resulting from the registration and use of INNs as domain names is lacking,[15] it is clear that a number of INNs have been registered by individuals or pharmaceutical businesses (e.g., sildenafenil.com, also known as 'viagra', also ampicillin.com, amoxicillin.com, tagamet.com, tetracycline.com, diclofenac.com,

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14 Comment of Asóciacion Interamericana de la Propiedad Industrial (RFC2 – December 26, 2000).

15 One commentator stated that, to its knowledge, there was no reported case of a domain name containing an INN that had threatened patient safety. See Comment of Anakena.com (RFC2 – December 28, 2000).

diazepam.com and lorazepam.com).[16] These domain names are used for various purposes; some are purely informational, providing generic information about the pharmaceutical substance, but the majority are proprietary sites registered and used to advertise or sell pharmaceuticals.[17]

46. On balance, it is suggested, at this stage, that the integrity of the INN system and the preservation of the policies underlying the INN system require that INNs be protected against registration as domain names. Further evidence of the extent of registrations of INNs as domain names, and of the inconveniences caused by such registrations, would be useful in deciding whether this preliminary recommendation should be confirmed in the Final Report of the Second WIPO Process.

47. It is recommended that, in the interests of public health and safety, INNs should be protected against registration as domain names.

48. Further submissions are requested on the extent of registrations of INNs as domain names and on the inconveniences caused by such registrations.

THE EXTENT OF PROTECTION TO BE CONFERRED

49. In giving expression to the protection of INNs in the domain name space, the following issues need to be considered:

- Whether protection should be applied only against registration of domain names that consist solely of INNs, or should extend to domain names that consist of INNs together with additional words (e.g., "[INN][name of manufacturer]" or "[INN][info]");
- Whether protection should cover only domain names that contain exact INNs or should extend also to names that are misleadingly similar (e.g., misspellings);

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16 WHO provided the following examples of INNs registered as domain names: tegaserod.com, diclofenac.com, valsartan.com, estradiol.com, octreotide.com, clozapine.com, paroxetine.com, ranitide.com, sumatriptan.com, lamivudine.com, salmeterol.com, salbutamol.com, fluticasone.com, ondansetron.com, acyclovir.com, cefuroximeaxetil.com, ziduvudine.com, lamotrigine.com, albuterol.com, busulfan.com, amlodipine.com, azithromicin.com, doxazosin.com, fluconazole.com, setraline.com, trovafloxacin.com, darifenacin.com, voricanazole.com, zopolrestat.com, droloxifene.com, risperidone.com, cisapride.com, ketoconazole.com, omeprazole.com and saquinavir.com.

17 For example: "amoxicillin.com" resolves to a web page offering a basic description of the drug and its applications, as well as two advertisements linking to pharmaceutical companies offering commercial services; phentermine.com resolves to a web page offering an entire lifestyle option for those interested in the diet-related drug.

- ♣ Whether protection should be extended to domain names that contain INNs in different languages and scripts;
- ♣ Whether protection should address existing registrations of INNs; and
- ♣ Whether protection for INNs in the DNS should apply to all gTLDs and whether it could appropriately be adopted by the administrators of ccTLDs.

50. On the first of the abovementioned issues (whether the protection of INNs in the domain names space should restrict the registration of domain names that consist solely of INNs or should also restrict registration of domain names that incorporate INNs together with additional words) the views expressed in the comments submitted to WIPO were divided. On the one hand, WHO noted that, with respect to the existing INN system in the physical world, the use of an INN is permitted together with the name of a manufacturer of the INN. WHO favored the continuation of this possibility within the domain name space by allowing the registration of an INN together with the name of its manufacturer as a domain name.[18] In contrast, one individual commentator argued that to exclude INNs from domain name registration, while allowing only an exception for the use of the INN together with the name of the manufacturer, would result in the trademark-owner pharmaceutical company dominating the domain name space in respect of that INN.[19]

51. The views expressed in comments were similarly unclear as to whether the registration of an INN as a domain name should be permitted with other words such as "info" or "usergroup". It was pointed out that such domain names might serve important informational roles for patients using drugs corresponding to the pharmaceutical substance covered by the INN.

52. Further submissions are invited on whether the protection of INNs within the domain name space:

(i) should be limited to the prohibition only of the registration of a domain name that is identical to an INN;

(ii) should allow the registration as a domain name of an INN together with the name of the manufacturer of the INN;

(iii) should allow the registration of an INN together with any other word, such as "info" or "usergroup", as a domain name.

53. The second issue in relation to the extent of protection concerns whether protection should apply to the prohibition of the registration of domain names that are misleadingly

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18 See Comment of World Health Organization (WHO) (RFC2 – December 21, 2000).

19 See Comment of Anakena.com (RFC2 – December 28, 2000).

similar to INNs. In this respect, it may be recalled that the Uniform Dispute Resolution Policy (UDRP) that applies at present in the open gTLDs extends the protection conferred upon trademarks to the prohibition of the registration and use in bad faith of domain names that are misleadingly similar to trademarks.[20]

54. Unlike the situation relating to trademarks, there is no evidence, at present, of deliberate attempts to mislead consumers through the registration of domain names that are confusingly similar to INNs.

55. In addition, it may noted that the policies underlying INNs and trademarks are different and call for different means of implementation. In the case of INNs, as mentioned above, the objective of the system is to allow the INN to be used freely by all. In the case of trademarks, the objective of the system is to restrict the use of the trademark in commerce to the single person or entity that owns the trademark. In the former case, it may be argued that misleadingly similar variations of an INN registered as domain name do not necessarily interfere with the free availability of the INN itself, whereas, in the latter case, a misleadingly similar variation of a trademark can create confusion as to the source of a product or service.

56. It should also be pointed out that the adoption of protection against domain names that are misleadingly similar to INNs would have efficiency consequences in respect of the mechanism by which protection is implemented. A prohibition of misleadingly similar domain names would require the exercise of judgement as to whether a given domain name could be considered to be misleadingly similar. Such an exercise of judgement usually would require a quasi-judicial procedure with an opportunity for submissions in respect of the exercise of the judgement. This question of the means by which protection might be implemented is further discussed below.

57. It is not recommended that the protection of INNs should extend to a prohibition of the registration of domain names that are misleadingly similar to INNs.

58. The third of the issues related to the extent of protection concerns different languages and language scripts. It is noted, in this respect, that various developments are occurring within the domain name space with respect to the registration of non-Roman script or non-ASCII domain names.[21]

59. The Cumulative list of recommended INNs published by WHO exists in five languages: Latin, English, French, Russian and Spanish. The limitation of the official list to these languages suggests that, as a practical matter, protection should extend only to these languages. The extension of protection to other languages would raise difficult, if not

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20 Uniform Domain Name Dispute Resolution Policy, Paragraph 4(a)(i).

21 See, for example, i-DNS.net (at *http://www.i-DNS.net*), and VeriSign/ NSI's Multilingual Domain Name testbed (at *http://global.networksolutions.com/en US/purchasing/welcome.jhtml?requestid=132*).

insurmountable, practical questions of enforcement flowing from the lack of an authentic translated version of the Cumulative list in other languages.[22]

60. It is recommended that protection of INNs extend to the Cumulative list of INNs in Latin, English, French, Russian and Spanish.

61. The fourth question relating to the extent of protection concerns the treatment of any existing registrations of INNs in the event that protection for INNs is introduced in the domain name space. In this respect, it may be noted that the INN system is well known and well publicized within the health sector. Anyone who has registered an INN as a domain name, therefore, may be reasonably expected to have been aware of the underlying policy of the INN system against the establishment of private rights in INNs. It does not seem unfair, therefore, that any policy adopted for the implementation of the protection of INNs within the domain name space should apply with respect to all past and future registrations of domain names. Furthermore, the allowance of any grandfather clauses for existing registrations would greatly undermine the efficacy of the public policy underlying the INN system.

62. It is recommended that the protection of INNs in the domain name space should apply to all past and future domain name registrations.

63. The final question relating to the extent of protection concerns the coverage of protection within the top-level domains. Should protection apply in all gTLDs, and should it apply in the ccTLDs?

64. With respect to the gTLDs, it has been noted above that the Internet Corporation for Assigned Names and Numbers (ICANN) has decided to introduce seven new gTLDs, namely, .aero, .biz, .coop, .info, .museum, .name and .pro. The introduction of these new gTLDs will create a more differentiated generic top-level domain space. Should the prohibition of the registration of INNs as domain names apply in all such gTLDs?

65. At the time of the publication of this Interim Report, it appears likely that certain of the new gTLDs will be operated in an open manner, that is, it will not be necessary to establish any particular qualification to be a registrant or with respect to any name to be registered in the gTLDs. In contrast, it is expected that others of the new gTLDs will be "closed" or chartered in the sense that it will be possible to register domain names in them only upon satisfaction of certain criteria relating either to the registrant (such as credentials in a certain

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22 One commentator, referring to the global availability and use of INNs, suggested that protection should not be limited to the list of INNs maintained by WHO, but should extend to cover translations of the names identifying each pharmaceutical substance or ingredient, to ensure global consumer protection – for example, the Portuguese translation of 'ampicillin', 'ampicilina', is not included on the WHO list and, if misused in the DNS, could result in harm to Portuguese patients unless it too is protected from registration. See Comment of Brazilian Intellectual Property Association (ABPI) (RFC1 – September 15, 2000).

industrial sector) or with respect to the domain name (such as the requirement that a domain name correspond to a personal name).

66. While any final recommendation must await knowledge of the exact condition that might apply in any "closed" or chartered gTLDs, it would seem that the nature of conditions to be imposed with respect to such intended "closed" gTLDs would be a sufficient safeguard against the registration of INNs as domain names in those gTLDs. It would, thus, at this stage, appear to be sufficient to apply the protection of INNs in all open gTLDs.

67. It is recommended that the protection of INNs apply in all open gTLDs.

68. With respect to ccTLDs, while any decision on the sorts of protection to be adopted within a ccTLD is a decision for the administrator and national law, it is suggested that the efficiency of the INN system would best be promoted through the application of the protection of INNs in all ccTLDs (except, perhaps, where the conditions of registration make it clear that the registration of an INN as a domain name is impossible for a non-related reason, such as registrations being restricted to personal or company names). It should be noted, however, that national name systems, equivalent to INNs, exist in a number of countries, such as British Approved Names (BAN), Dénominations Communes Françaises (DCF), Japanese Adopted Names (JAN) and United States Accepted Names (USAN). Such national name systems are, for the most part, harmonized with the INN Cumulative list. Nevertheless, it is recommended that, in considering the application of the protection of INNs, the ccTLD administrator do so in consultation with the national health authorities in order to ensure appropriate implementation of the policy.

69. It is recommended that ccTLD administrators consider, in consultation with their national health authorities, the adoption of protection for INNs within the ccTLDs.

POLICY INSTRUMENTS FOR THE IMPLEMENTATION OF PROTECTION FOR INNs IN THE DOMAIN NAME SPACE

70. Three instruments would appear to be potentially available to give expression to the protection of INNs within the domain name system:

(i) a modified Uniform Dispute Resolution Procedure (UDRP);
(ii) a notice and take-down procedure; or
(iii) an exclusion or blocking mechanism.

Modified Form of UDRP

71. The existing UDRP could be modified in order to allow a complaint to be filed in respect of any registration of an INN as a domain name or, if protection were extended to the

prohibition of misleadingly similar domain names or domain names incorporating an INN as an element, in respect of any registrations offending the extended form of protection. Unlike the application of the UDRP to trademarks, however, a complaint in respect of the registration of an INN would not require the showing of bad faith in the registration, nor any bad faith use of the registration. The showing of bad faith is considered to be unnecessary since the policy underlying INNs would be offended through the mere registration of an INN as a domain name, as such a registration would have the effect of creating a monopoly association of the INN with one Internet address for navigation purposes on the Internet.

72. There would seem to be, however, three reasons which suggest that a modified form of UDRP would not be appropriate as a policy instrument for giving expression to the protection of INNs in the domain space.

73. The first of those reasons is that the UDRP contemplates an adjuticative procedure involving the exercise of judgement (for example, the judgement as to whether the respondent has registered and used the domain name in bad faith). Such an exercise of judgement would not seem to be necessary in implementing a prohibition on the registration of INNs, since it is a simple question of observation as to whether an INN has been registered as a domain name.

74. A second reason concerns the nature of an INN as a public interest, as opposed to a private right, such a trademark. In the case of a private right, the owner of that right is clearly the person who may exercise the right to bring a complaint with respect to its violation. In the case of a public interest, such as an INN, the interest exists for the benefit of the public as a whole and not any particular person or entity. There does not appear to be any appropriate entity to file a complaint in respect of an INN, unless that entity were to be the manager of the INN system, WHO. If WHO were to be considered the appropriate party to file a complaint, however, it would be necessary for it to assume the administrative and financial burden of prosecuting such complaints.

75. A third reason suggesting the inappropriateness of a modified form of the UDRP concerns the ineffectiveness of its remedies or the lack of correspondence between those remedies and the policy aim of INNs. The two remedies available under the UDRP are cancellation of a domain name registration, which would have the effect of resuscitating the availability of the INN for registration by some other party, or transfer of the registration, which would have the effect of continuing a monopoly association of the INN with a particular party. Even if the transferee were WHO, acceptance of the transfer would require a commitment to the maintenance of the registration.

76. It is not recommended that protection of the INNs in the domain name space be implemented through a modification of the UDRP.

Notice and Take-down Procedure

77. It is also possible to envisage the implementation of the protection of INNs in the domain name space through a procedure whereby, upon notification by any interested party,

WHO could certify to the appropriate registrar that an INN had been registered as a domain name, with the consequence that the registrar would be required to cancel the registration. The ineffectiveness of the remedy of cancellation, however, has been noted above. As a variation on that remedy, therefore, it might be envisaged that the certification by WHO would lead to the cancellation the domain name registration together with an exclusion or blocking of the INN from any further registration by any other parties. It would seem, however, to be simpler administratively and more efficient to implement such an exclusion or blocking mechanism system-wide with respect to all INNs, which possibility is discussed in the next section.

78. It is not recommended that the protection of INNs be implemented through a procedure for notice and take-down.

Exclusion or Blocking Mechanism

79. A third means of giving expression to the protection of INNs within the domain name space would be to block access uniformly across all open gTLDs to the possibility of registering any INNs. Such an exclusion mechanism was recommended by WHO[23] and was broadly supported by commentators to the Second WIPO Process as an appropriate means to reflect in the DNS established international principles for protection of INNs in the physical world.[24] One commentator noted that "[i]n contrast to personal names, these are names that should be protected to the greatest extent possible, since confusion could cause immense damage. These names should be incorporated into a register and completely excluded from all TLDs and ccTLDs."[25] The concept of an exclusion mechanism has also received support from representatives of the pharmaceutical industries, as well as industry associations.[26]

80. It is notable that a system for exclusions similar to that proposed for the DNS operates effectively in various trademark office practices around the world, in the course of their examination of trademark applications for possible conflict with INNs.[27] It is acknowledged

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23 See Comment of World Health Organization (WHO) (RFC2 – December 21, 2000).

24 See, for example, Comment of the Services of the European Commission (RFC2 – January 16, 2001), and Comment of Asóciacion Interamericana de la Propiedad Industrial (RFC2 – December 26, 2000).

25 See Comment of MARQUES, Association of European Trade Mark Owners (RFC2 – December 22, 2000).

26 See Comment of European Federation of Pharmaceutical Industries Associations (EFPIA) (RFC2 – December 15, 2000) and comment of European Brands Association (AIM) (RFC2 – December 20, 2000).

27 The Austrian Patent Office, for example, examines trademark applications and, where a trademark is identical with a recommended INN on the basis of descriptiveness, registration is refused. Where the conflict is with a proposed INN, the application is accepted, but the applicant is informed of a potential future conflict. The lists of proposed and recommended INNs are constantly updated in the database of the Austrian Patent Office. The Canadian Intellectual Property Office examines trademarks and refuses those that conflict with INNs on the basis of descriptiveness and deceptive misdescriptiveness. The French INPI examines trademark applications manually using a directory, and refuses those that conflict with INNs on

[Footnote continued on next page]

that domain name registrars process, on average, far greater numbers of applications for domain names, at greater speed, and with less acceptance of delay, than is the case with many trademark offices. However, it is suggested that an exclusion mechanism could operate through reference to a database of INN names during the domain name registration process, so as to block registration of such listed names, without any significant administrative burden or cost to domain name registration authorities.

81. It is proposed that the exclusion mechanism function by means of registrar and public access to a freely searchable online database of proposed and recommended INNs. Notably, WHO provides a MEDNET service – a publicly available, free, searchable database that allows access to the INN database, where queries can also be raised, directly via *http://mednet.who.int.* The database lists INNs with recommended, proposed and alternative medicinal names that could be utilized by the domain name registration authorities administering an exclusion mechanism.[28] WHO has confirmed that it is technically feasible for WHO INN Program to make available to domain name registrars a database of INN names online, via a publisher/subscriber mechanism, to enable them to automatically block applications for domain names constituted by such INN-strings.

82. It should be noted that the exclusion mechanism would be useful only in respect of the protection of INNs as such from registration as domain names, and not in respect of any prohibition of domain names that were misleadingly similar to INNs or of the registration of INNs plus another word (as discussed above). Should it later be decided that such extended protection ought to be granted in respect of INNs, it would be necessary to review the recommended application of the exclusion mechanism or to suggest a means of supplementing the exclusion to deal with the cases of extended protection.

83. It is recommended the Cumulative list of INNs in Latin, English, French, Russian and Spanish be excluded automatically from the possibility of registration as domain names in the open gTLDs.

[Footnote continued from previous page]

the basis of descriptiveness. The Japanese Patent Office examines trademark applications using an automated system, and applications are refused on the basis of descriptiveness, if a mark is identical or closely similar to an INN. The Swiss Office examines trademark applications manually using a directory and refuses only those applications where a mark is identical with a recommended INN. The UK Office examines trademark applications using an automated system and applications are refused on the basis of descriptiveness, if a mark is identical or closely similar with a recommended INN.

[28] Currently, the MedNet is available only to WHO 'INN partners', with authorization given through an automated administration process, that ensures privacy using password and authentication systems. However, it is envisaged that different layers of access will be provided in future to authorized users.

84. It is further recommended that any existing registrations of INNs as domain names be cancelled and that, following such cancellation, such INNs be excluded from any further registration.

NAMES OF INTERNATIONAL INTERGOVERNMENTAL ORGANIZATIONS AND THEIR PROTECTION IN THE DNS

85. An inevitable consequence of increased personal mobility, the networked society, open trading systems and the power of technology has been that issues requiring public sector intervention are increasingly international in character. As a result, international intergovernmental organizations (IGOs) – such as the United Nations Organization (UNO), the World Health Organization (WHO), the World Meteorological Organization (WMO), the Food and Agricultural Organization (FAO) or the International Telecommunications Union (ITU) – are called upon to play a progressively more vital role in the multilateral affairs among States and their citizens. The ability of these IGOs to fulfil their respective missions has become ever more dependent on effective communication and dissemination of information about their activities and resources.

86. The Internet provides a powerful new means for IGOs to present information about and permit access to their programs, resources and activities, just as it does for commercial enterprises or other non-commercial organizations and individuals. Not surprisingly, numerous IGOs have come to recognize the opportunity and significance of the Internet as a communications mechanism for furthering their work.[29] At the same time, however, the Internet poses a risk that individuals and entities might attempt to capitalize, through unauthorized association, imitation, deception or fraudulent activity, on the prestige and importance of these organizations, which grows naturally out of the essential responsibilities vested in them. If an IGO's name, acronym or logo is used on the Internet by particular individuals or companies in respect of unauthorized activities or transactions, the IGO concerned faces the possibility that those signs will, to its detriment, lose their distinctive power of identification, while the public, by virtue of such associations, may be misled as to the nature of the IGO's mandate and functions.

87. WIPO2 RFC-2 requested interested parties to comment on whether any protection against abusive registration as a domain name in the gTLDs should be accorded to the names and acronyms of IGOs and, if so, in what circumstances and how. The various comments submitted on this subject, discussed below, were divided in their response as to whether some protection was advisable, and those favoring protection raised a number of relevant alternatives and issues to be considered. This Chapter addresses this question, focusing in particular on (i) existing international legal protection for the names, abbreviations or other emblems of IGOs; (ii) the comments received and their discussion of the nature and extent of any problems or abuses within the DNS related to the names or abbreviations of IGOs; and (iii) what mechanism, if any, is appropriate to provide protection for such names or acronyms of IGOs in the DNS. As with the suggestions noted in the other chapters of this Interim

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[29] See e.g., Official Web Site Locator for the United Nations System of Organizations, which serves as a portal for the numerous web sites of the United Nations, its specialized agencies, funds and programmes (*http://www.unsystem.org/*); see also WIPO's web sites at *http://www.wipo.int* and *http://ecommerce.wipo.int*.

Report, the several alternative proposals raised here are for interim consideration, intended to provide a basis for further discussion and consultation.

INTERNATIONAL PROTECTION FOR NAMES AND ACRONYMS OF INTERNATIONAL INTERGOVERNMENTAL ORGANIZATIONS (IGOS)

88. The names and abbreviations[30] of international intergovernmental organizations receive established international protection against registration and use as trademarks under the Paris Convention and through the TRIPS Agreement. Article 6*ter* of the Paris Convention provides in relevant part:

> "(1)(a) The countries of the Union agree to refuse or to invalidate the registration, and to prohibit by appropriate measures the use, without authorization by the competent authorities, either as trademarks or as elements of trademarks, of armorial bearings, flags, and other State emblems, of the countries of the Union, official signs and hallmarks indicating control and warranty adopted by them, and any imitation from a heraldic point of view.
>
> (b) The provisions of subparagraph (a), above, shall apply equally to . . . abbreviations, and names, of international intergovernmental organizations of which one or more countries of the Union are members, with the exception of . . . abbreviations, and names, that are already the subject of international agreements in force, intended to ensure their protection."[31]

89. Article 6*ter* was introduced into the Paris Convention by the Revision Conference of The Hague in 1925, with the purpose of protecting the armorial bearings, flags, official signs or emblems of the States party to the Convention, as well as other signs or hallmarks indicating control and warranty by them. This protection was extended to such designations in order to ensure that they are clearly attributed to the State concerned, and not misused by

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30 The terms "abbreviation" and "acronym" are used interchangeably in this chapter. An acronym is defined as "a word formed from the initial letters of other words," such as "WIPO" for the World Intellectual Property Organization. See Concise Oxford Dictionary (10th ed. 1999). An "abbreviation," the term used in Article 6*ter* of the Paris Convention, is a more embracing word, which can refer to an acronym or any other means of abridging a word or series of words, such as "int" for international.

31 The protection under Article 6*ter* does not extend to names, abbreviations and other emblems of intergovernmental organizations that *are already the subject of international agreements intended to ensure their protection*, such as the Geneva Convention (1949) for the amelioration of the condition of the wounded and sick in armed forces, Article 44 of which protects the emblems of the Red Cross, the words "Red Cross" or "Geneva Cross, and analogous emblems." The object of this exception is to avoid possible overlap with provisions in other conventions that regulate on this subject. See S. P. Ladas, *Patents, Trademarks, and Related Rights: National and International Protection*, vol. II, at 1244 (1975); Prof. J.H.C. Bodenhausen, *Guide to the Application of the Paris Convention for the Protection of Industrial Property*, Article 6*ter*, paragraphs (1) and (2), at 97-98 (BIRPI, 1969).

other persons or entities. As it became recognized that the public interest in favor of this protection for the public sector at the national level applied equally to the public sector at the international level, this protection was extended to IGOs by the Revision Conference of Lisbon in 1958. [32] This protection, in particular, was expressly stipulated with respect to the *names* and *abbreviations* of such IGOs.

90. Article 6*ter* of the Paris Convention, paragraph (1)(b), accordingly prohibits the registration and use of, among other things, the names or abbreviations of IGOs as *trademarks* or elements of trademarks. Article 16 of the Trademark Law Treaty (TLT) of 1994 extends the same protection against registration and use with respect to *service marks.*[33]

91. The entitlement of an IGO to receive protection under these treaties is not automatic. Under paragraph (3)(b) of Article 6*ter*, any name, abbreviation or other emblem for which an IGO wishes to obtain protection *must* be communicated to the International Bureau of WIPO, which will then transmit the communication to the member States of the Paris Convention. [34] The protection available to IGOs under Article 6*ter* thus depends entirely upon their submission of a request for communication to WIPO.[35] WIPO accordingly maintains a notification list and performs its functions of determining the admissibility of such requests for communication under Article 6*ter* and of forwarding the admissible communications to the States party to the Paris Convention.

92. The total number of IGOs that have requested protection under Article 6*ter* is 91. Not every organization has requested protection of all of the possible signs or emblems enumerated under Article 6*ter* (e.g., amorial bearings or flags). As a general rule, however,

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[32] See S. P. Ladas, *Patents, Trademarks, and Related Rights: National and International Protection*, vol. II, at 1244 (1975).

[33] Article 16 of the Trademark Law Treaty (TLT) provides as follows:
"Any contracting party shall register service marks and apply to such marks the provisions of the Paris Convention which concern trademarks."

[34] Each State is obligated under Article 6*ter* (1)(3)(a) to "make available to the public the lists so communicated" by WIPO. Any State receiving the communication of a name, emblem or other official sign of an IGO may, within a period of twelve months from the receipt of that communication, transmit its objections, if any, through the intermediary of the International Bureau of WIPO, to the IGO at the request of which the communication was made. (Article 6*ter*, paragraph (4)).

[35] Article 6*ter*, (3)(b) provides:
"The provisions of subparagraph (b) of paragraph (1) of this Article *shall apply only* to such … abbreviations, and names of international intergovernmental organizations as the latter have communicated to the countries of the Union through the intermediary of the International Bureau." (Italics added).
See Bodenhausen, *Guide to the Application of the Paris Convention*, Article 6*ter*, paragraphs (3) and (4), at 100 ("As has already been observed, the protection of emblems, names and abbreviations of *intergovernmental organizations* is *dependent upon their communication.*"). (Italics in original).

most IGOs that have requested protection have at least notified their name and abbreviation (in several languages) and principal emblem.[36]

93. In response to the increasing number of programs of international organizations that have high public visibility and a degree of autonomy in program execution (such as, for example, UNAIDs), in 1992 the Paris Union Assembly (the competent treaty organ of the Paris Convention) adopted a set of "Guidelines for the Interpretation of Article 6*ter*(1)(b) and (3)(b) of the Paris Convention"[37] in order to clarify *which* IGOs may qualify to receive protection through the communication procedures under the Paris Convention. The Guidelines provide, in short, that, in addition to international intergovernmental organizations as such, any (i) program or (ii) institution established by an IGO, or any (iii) convention constituting an international treaty between one or more member States of the Paris Convention, may communicate its name or abbreviation or other emblems under Article 6*ter*(3)(b), provided such program, institution or convention is;

> "a permanent entity hav[ing] specified aims and its own rights and obligations."

94. The Guidelines define a "permanent entity" as one that has been established "for an indefinite period of time."[38] The "specified aims" and "rights and obligations" of such a permanent entity are defined by reference, respectively, to subject matters, rights and obligations "which are clearly defined in [the permanent entity's] enabling statutes or charter or in the resolutions or decisions by which it has been established."[39]

95. While the possibility of an authorized use of an IGO's name, abbreviation or other emblems is recognized under Article 6*ter* of the Paris Convention,[40] the provision also sets forth a non-mandatory exception (that is, States need not apply it) to its prohibitions against trademark registration and use, specifically in respect of the names, abbreviations and other emblems of *IGOs*. Paragraph (1)(b) provides that States shall not required to apply such prohibitions when the registration or use of a trademark against which the protection is invoked (i) "is not of such a nature as to suggest to the public that a connection exists between the organization concerned and the . . . abbreviations, and names," or (ii) "is probably not of such a nature as to mislead the public as to the existence of a connection between the user and the organization." The exception has been enacted in national legislation, along with the other provisions of the treaty, by many of the States party to the Paris Convention. However,

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36 WIPO maintains a list of approximately 1150 signs (consisting of armorial bearings, flags, names, abbreviations and other emblems) that have been communicated by States *and* IGOs, which have, in turn, been notified to the States party to the Paris Convention. As noted, 91 IGOs have submitted requests for communications to take advantage of the protection under the Paris Convention.

37 See "Report Adopted by the Assembly," International Union for the Protection of Industrial Property (Paris Union), Nineteenth Session (9th Extraordinary), document P/A/XIX/4, paras. 20 to 25 (September 29, 1992).

38 *Id.*, para. 24.B.

39 *Id.*

40 Paragraph (1)(a) of Article 6*ter* refers to "use, without authorization by the competent authorities."

to the extent that some States and not others have enacted it, there is divergence at the national level in the scope of protection.[41]

96. The TRIPS Agreement, through Article 2, fully incorporates the protection provided under Article 6*ter* of the Paris Convention and imposes the obligations contained in this provision on the States party to the Agreement. In this regard, Article 63(2) of the TRIPS Agreement refers to the "notifications pursuant to the obligations under this Agreement stemming from the provisions of Article 6*ter* of the Paris Convention." In the Agreement Between the World Intellectual Property Organization and the World Trade Organization (WIPO-WTO Agreement) of 1995, it was clarified that:

> "The procedures relating to communication of emblems and transmittal of objections under the TRIPS Agreement shall be administered by the International Bureau [of WIPO] in accordance with the procedures applicable under Article 6*ter* of the Paris Convention (1967)." (Article 3, WIPO-WTO Agreement).

97. Four aspects of the protection that is provided under the Paris Convention, TLT and TRIPS Agreement and that is discussed above may be noted, which are relevant to a discussion of any protection for the names or acronyms of IGOs in the DNS:

(i) The terms of these instruments are directed to prohibit the *registration* and *use*, as trademarks, service marks or elements of such marks, of the names, abbreviations or other emblems of IGOs, except where there is authorization or an applicable exception. The States "agree to refuse or to invalidate" any such registration of the name, abbreviation or other emblems of IGOs, and the "use" of the same is to be "prohibit[ed] by appropriate measures."[42] The purpose is thus clear that the names, abbreviations or other emblems of IGOs are intended to remain entirely outside the industrial property system of private proprietary rights. Rather than regulate their potential use within that system, these treaties, by prohibiting registration or use, mandate that such names, abbreviations or other emblems of IGOs are to be excluded from it and therefore to be excluded from the proprietary and commercial uses contemplated by that system. The intention behind these provisions reflects not only the important role of IGOs, but also the importance of allowing a clear identification of them, by avoiding any potential for confusion or deception that would interfere with their public and intergovernmental mandates. It reflects further a concern that various entities or individuals might, without authorization, attempt to unjustifiably exploit, for commercial or non-commercial ends, the distinctive reputation and public trust associated with these organizations.[43]

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41 The European Patent Office, in its Comment on WIPO2 RFC-2, noted that the national legal provisions enacting Article 6*ter* of the Paris Convention "are sometimes highly divergent in the scope of protection."

42 Paris Convention, Article 6*ter*, paragraph (1)(a).

43 See e.g., Comment of International Monetary Fund (IMF) (RFC-2 - December 28, 2000) (indicating that it has faced situations in which its name or acronym has been registered by third parties as, or as part of, domain names "used in connection with, or to lend credibility to, a financial scheme that has no connection whatsoever to the IMF and is often fraudulent.");

[Footnote continued on next page]

Extending this line of reasoning to the DNS may suggest that, to the extent that the registration or use of the names or abbreviations of IGOs as domain names has proprietary associations and would generate similar risks of confusion or deception, comparable protection in the form of an *exclusion* against such registrations (discussed below) could be considered as an appropriate means of protection. A significant number of commentators supported such a prohibition, including a number of the IGOs that submitted comments.[44] They indicated that the names or abbreviations of IGOs should not be available for registration as domain names by unauthorized third parties, even if the domain name registration is not in bad faith, since it nevertheless can be confusing and misleading to the public, raise questions of authenticity and accuracy as to the source of information, and give rise to the perception that an IGO endorses or approves of the information, service or product being offered through a particular unrelated web site.[45] Weighing against protection in the form of an exclusion, however, is the fact that domain names can be used for many different purposes, and some of these uses might not raise the sorts of concerns noted above.

(ii) The treaties serve to protect the names, abbreviations or other emblems of IGOs from their registration or use as *trademarks* or *service marks* (or elements of such marks). The protection afforded is thus directed only at their potential registration and use as trademarks or service marks in the industrial property system. The registration and use of the name or acronym of an IGO by a third party as a trademark, which that party also registers as a domain name, would clearly contravene the prohibitions of the

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Comment of Preparatory Commission for the Comprehensive Nuclear-Test-Ban Treaty Organization (CTBTO) (RFC-2 – December 22, 2000) (noting the confusion raised by several non-commercial entities using domain names that incorporate, at least in part, the Commission's name or acronym).

44 See *infra* note [31]. See e.g., Comment of International Monetary Fund (IMF) (RFC-2 - December 28, 2000), stating that it would be in the interest not only of the IGOs but also of the general public to accord protection in the form of an exclusion to the names and acronyms of IGOs, such as the IMF. See also Comment of Asociación Interamericana de la Propiedad Industrial (ASIPI) (RFC-2 - December 26, 2000); Comment of The Association of European Trade Mark Owners (MARQUES) (RFC-2 - December 22, 2000); Comment of European Brands Association (AIM) (RFC-2 - December 20, 2000), indicating that a notification process similar to that under the Paris Convention could be used to establish an exclusions list of IGOs names or acronyms.

45 See Comment of International Monetary Fund (IMF) (RFC-2 - December 28, 2000); Comment of the Law Society of Scotland (RFC-2 – January 4, 2001); Comment of Preparatory Commission for the Comprehensive Nuclear-Test-Ban Treaty Organization (CTBTO) (RFC-2 – December 22, 2000), indicating that it is;

> "important to have only one, authentic source of information in the Internet and to prevent the establishment of competing unofficial Internet sites that may contain misleading, inaccurate or prejudicial information, or that may lead the viewer to believe that he or she is using the official web site of the organization."

treaties, unless authorized or subject to an applicable exception.[46] However, while a domain name may function as a trademark, to identify the source of goods or services, it may also serve other purposes noted above, such as communicating non-commercial identifying or address information. Thus, it might be considered whether the risk associated with the misuse of the names or abbreviations of IGOs is so great as to justify their total exclusion from registration within the DNS, or whether a less stringent form of protection is more appropriate. In this respect, a distinction between an IGO's exact name and its abbreviation may be made, to the extent that the former may find legitimate use only in the hands of the IGO (or an authorized third party), while the latter might be used by any number of entities whose names would resolve reasonably to the same abbreviation.

(iii) There is not an unlimited universe of IGOs, whose names, abbreviations or other emblems receive protection pursuant to these treaties. Only those IGOs which have sent an admissible request for communication to WIPO, have not received an objection from any of the member States, and have consequently had their names or acronyms notified accordingly, will receive protection. As noted above, the number of IGOs which have requested and received protection for their names, abbreviations or other emblems, since the establishment of Article 6*ter*(1)(b) in 1958, totals 91. A number of commentators have suggested, in this regard, that at least the names or acronyms of those IGOs that have followed the treaty procedures and receive protection should be considered for any protection in the DNS.[47]

(iv) As stated in the Paris Convention in Article 6*ter*(1)(c), the protection under these instruments may be subject to exception when such registration or use of an IGO's name or abbreviation as a trademark or service mark is not of such a nature as to suggest to the public that a connection exists with the organization concerned, or is "probably not of such a nature as to mislead the public as to the existence of a connection between the user and the organization." Drawing a parallel from this exception, the registration and use by third parties of the names or acronyms of IGOs as domain names might, in countries applying this exception, be considered permissible, if a domain name registration and use is unlikely to suggest to, or to mislead, the public that a connection with the IGO exists. One commentator noted, for example, that existing domain name registrants should be given the opportunity to defend their registration through the UDRP, on the same grounds set forth in Article 6*ter*(1)(c).[48] Again, a reasonable distinction may be made between the actual name of the IGO and its abbreviation, with it being far less likely that a third party can show a legitimate registration and use, without permission, of an IGO's name. In view of this exception, also, an absolute exclusion from registration as a domain name, at least of the

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46 A number of commentators suggested that, to the extent such designations functioning as a mark, they deserve protection. See e.g., Comment of the American Intellectual Property Law Association (AIPLA) (RFC-2 – December 29, 2000), indicating that "such designations should be afforded protection under the UDRP to the extent that they function as marks."

47 See *infra* note [34].

48 See Comment of Asociación Interamericana de la Propiedad Industrial (ASIPI) (RFC-2 - December 26, 2000).

abbreviation of the IGO's name (if not also of the name itself), might be considered an overly stringent means of protection in the DNS.

THE .INT TOP-LEVEL DOMAIN RESERVED FOR ORGANIZATIONS ESTABLISHED BY INTERNATIONAL TREATIES

98. One of the commentators on WIPO2 RFC-2 put forward the view that IGOs should be entitled to receive protection for their names and acronyms in the DNS, but that adequate protection already exists in the form of the restricted top-level domain, .int[49] – the abbreviation for "international."

99. The .int top-level domain was among the seven initial generic domains established by the Internet Assigned Numbers Authority (IANA) to correspond to seven general categories of organizations.[50] As indicated in the Request for Comments (RFC) 1591, published by Jon Postel of IANA in 1994, "[t]his domain is for organizations established by international treaties, or international databases."[51] Further definition for the registration requirements of .int is provided by IANA on its web site. IANA states that .int is reserved for "organizations established by international treaties between or among national governments."[52] IANA further indicates that "[w]e should be able to look up the international treaty in the UN online database of treaties, or you should provide us with a copy." IANA points out, in particular, that:

> "We recognize as organizations qualified for domain names under the .int top-level domain the "specialized agencies" of the UN (currently there are 14 of these) and the organizations having "observer status" at the UN (currently 16)."[53]

100. The IANA site instructs that "[i]f you believe you meet these qualification and want to apply for a domain name under .int, please send IANA a description of your organization, including a copy of the treaty that established your organization."[54] The site specifies that only *one* registration is allowed for each organization. IANA makes no mention of the Paris Convention procedures under Article 6*ter*, discussed above, which provide protection for IGOs in the industrial property system.[55]

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49 See Comment of Alexander Svensson (RFC-2 - December 21, 2000); see also Comment of Matthias Haeuptli (RFC-1 – September 15, 2000); Comment of J. R. Stogrin (RFC-1 – September 14, 2000); Comment of Christopher Zaborsky (RFC-1 – August 11, 2000).

50 See J. Postel, Request for Comments (RFC) 1591, Network Working Group (March 1994). The six other generic domains are .com, .net, .org, which are unrestricted domains, and .edu, .gov and .mil, which restrict registrations to certain entities, just as .int does. *Id.*

51 *Id.*

52 See "The .int Domain: Current Registration Policies," at *http//www.iana.org/int-dom/int.htm* (page last updated April 16, 2000).

53 *Id.*

54 *Id.*

55 The IANA site further indicates that "discussions are underway with a number of organizations regarding the future of the .int domain, including a plan of the International

[Footnote continued on next page]

101. *Existing protection for IGOs in the DNS.* It is notable that, from the early establishment of the DNS, a recognition of the special role of international intergovernmental organizations was apparent and was built into the design of the system. The restricted .int top-level domain serves the dual purposes of (i) designating a space in the DNS for the registration of the preferred identifiers for international intergovernmental organizations, and (ii) providing a measure of protection through registration requirements which restrict that space only to those international organizations which demonstrate that they qualify (i.e., those that can point to a treaty as the basis of their establishment).

102. The .int top-level domain provides an *existing* basis for protection of IGOs within the DNS. Because of the restricted nature of this top-level domain, no individuals, companies or other entities can obtain a domain name registration in .int, let alone register the name or abbreviation of an IGO in that domain.[56] So long as the registration procedures of .int are properly applied and enforced, the .int top-level domain is a space where Internet users can have reasonable confidence and trust as to the genuine identity of the organizations registered there under their respective names or acronyms, and of the validity of the information provided by those organizations.

103. The protection provided in the .int top-level domain, however, does not address bad faith or abusive registrations that can take place in the other generic top-level domains, particularly in .org, .com or .net, which are open and largely undifferentiated gTLDs with unrestricted practices for registration.[57] As reflected in the submissions of a number of commentators, discussed below, it is the risk of predatory and parasitical practices in these domains (as well as in the ccTLDs), which raises concern for IGOs and Internet users in general.[58] The question thus remains, in the context of the global DNS which includes not only the restricted .int domain, but also other unrestricted domains, whether any protection against abusive registrations of IGOs names or abbreviations in these other domains is needed, and, if so, in what circumstances and how.

[Footnote continued from previous page]

Telecommunications Union (ITU) to assume management of the .int domain. *Id.*, referencing the ITU's plan to assume management of the .int domain, at *http://www.itu.int/net/int.*

56 See Comment of the International Fund for Agricultural Development (IFAD) (RFC-2 – January 4, 2000), suggesting that IGOs change their domain name registrations from the .org top-level domain to .int, in order to take advantage of this restricted domain space.

57 The top-level domain, .org, is a domain space that might especially be prone to risks of misleading domain name registrations corresponding to the names or abbreviations of IGOs, since "org" is intended to be the abbreviation for "organization."

58 See e.g., Comment of the Brazil Association of Intellectual Property (ABPI) (RFC-2 – January 4, 2001), indicating that although the .int top-level domain provides an established space, protection is needed against bad faith registrations in the other gTLDs and the ccTLDs.

REVIEW OF COMMENTS AND NATURE AND EXTENT OF ABUSES

104. A significant number of comments were submitted which addressed the question of protection for the names or acronyms of IGOs in the DNS. Among these comments, there was a clear divide in views as to whether any protection was considered advantageous or necessary. As discussed below, aside from the numerous comments that generally opposed any new measures of protection for any of the categories of identifiers addressed in the Second WIPO Process, those commentators which considered, in particular, the names and acronyms of IGOs favored, on balance, some form of protection.

105. Virtually all of the IGOs submitting comments indicated that some form of protection was needed, and many of them supported the mechanism of an exclusion as the proper means to achieve such protection.[59] A number of the comments of IGOs noted instances of abuse or other problems in the registration of their names or acronyms, which resulted in deception or confusion to the public.[60] These organizations expressed concern that unofficial web sites using a domain name that is identical or similar to their name or acronym may contain misleading, inaccurate or prejudicial information about the IGO, while leading the viewer to believe that he or she is visiting the organization's official web site. Still other IGOs noted that, in considering any new measures of protection, adequate consideration should be given to the rights of existing, legitimate domain name registrants.[61]

106. A significant number of the commentators suggested that, at the very least, the names and acronyms of IGOs protected under Article 6*ter* of the Paris Convention and through the TRIPS Agreement – and notified accordingly – should be protected from abusive registration

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59 See Comment of the Services of the European Commission (EC) (RFC-2 – January 16, 2001); Comment of International Civil Aviation Organization (ICAO) (RFC-2 – December 20, 2000); Comment of International Maritime Organization (IMO) (RFC-2 – December 13, 2000); Comment of International Monetary Fund (IMF) (RFC-2 - December 28, 2000), stating that "it would be in the interest not only of the IGOs but also of the general public to accord protection to the names and acronyms of IGOs such as the IMF; Comment of Organization for the Prohibition of Chemical Weapons (RFC-2 – December 28, 2000); Comment of Preparatory Commission for the Comprehensive Nuclear-Test-Ban Treaty Organization (CTBTO) (RFC-2 – December 22, 2000); Comment of the United Nations Framework Convention on Climate Change (RFC-2 - December 7, 2000); Comment of World Health Organization (WHO) (RFC-2 – December 21, 2000).

60 See Comment of International Monetary Fund (IMF) (RFC-2 - December 28, 2000) (indicating that its name and acronym had been registered by third parties "as, or as part of, an Internet domain name, in a manner which is misleading, fraudulent or abusive"); see also Comment of Preparatory Commission for the Comprehensive Nuclear-Test-Ban Treaty Organization (CTBTO) (RFC-2 – December 22, 2000); Comment of the United Nations Framework Convention on Climate Change (RFC-2 - December 7, 2000); Comment of World Health Organization (WHO) (RFC-2 – December 21, 2000); Comment of World Trade Organization (WTO) (RFC-2 – December 6, 2000).

61 See Comment of International Maritime Organization (IMO) (RFC-2 – December 13, 2000); Comment of Organization for the Prohibition of Chemical Weapons (RFC-2 – December 28, 2000).

and use as domain names by appropriate protective mechanisms.[62] These commentators reflected the view that the protection, which already exists in the physical and off-line world for the names and abbreviations of IGOs, should be equally available for them in the DNS.

107. The view in favor of some form of protection was advanced in many, but not all, of the comments received from the commercial and intellectual property communities. A number of such comments suggested that protection in the form of an exclusion should be applied.[63] Some of these commentators indicated that such an exclusion should apply only to the exact name of the IGO[64], in order to limit restriction and permit the development of the Internet as a medium for communication and electronic commerce. Other commentators opposed an exclusion to the extent that it would prevent the legitimate use of a designation that happens to be the same as the name or acronym of an IGO.[65] A number of commentators, including

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62 See Comment of the Services of the European Commission (EC) (RFC-2 – January 16, 2001) (stating that a "consistent system of protection for the names of International Intergovernmental Organizations should be established," measured by "similar standards" as those under the Paris Convention and TRIPS Agreement); Comment of the State Agency on Industrial Property Protection of the Republic of Moldova (RFC-2 - December 29, 2000); Comment of the European Patent Office (EPO) (RFC-2 - December 28, 2000); Comment of International Maritime Organization (IMO) (RFC-2 – December 13, 2000); Comment of the United Nations Framework Convention on Climate Change (RFC-2 - December 7, 2000); Comment of World Health Organization (WHO) (RFC-2 – December 21, 2000); Comment of Asociación Interamericana de la Propiedad Industrial (ASIPI) (RFC-2 - December 26, 2000); Comment of The Association of European Trade Mark Owners (MARQUES) (RFC-2 - December 22, 2000); Comment of European Brands Association (AIM) (RFC-2 - December 20, 2000), indicating for IGOs that the "level of protection on the Internet should be NO LESS than the Paris Convention/TRIPS protection today." (Emphasis in original); Comment of the Law Society of Scotland (RFC-2 – January 4, 2001). But c*f.*, IGO noting the delays that can occur in the treaty ratification process and under the Paris Convention notification process, and that protection should ensue from the date the treaty is open for signature. See also Comment of Organization for the Prohibition of Chemical Weapons (RFC-2 – December 28, 2000); Comment of the Preparatory Commission for the Comprehensive Nuclear-Test-Ban Treaty Organization (CTBTO) (RFC-2 – December 22, 2000); Comment of World Trade Organization (WTO) (RFC-2 – December 6, 2000) (protect the names of treaties as well, such as the TRIPS Agreement).

63 See Comment of Asociación Interamericana de la Propiedad Industrial (ASIPI) (RFC-2 - December 26, 2000); Comment of The Association of European Trade Mark Owners (MARQUES) (RFC-2 - December 22, 2000); Comment of European Brands Association (AIM) (RFC-2 - December 20, 2000); Comment of Cuatrecasas Abogados (RFC-1 – September, 2000); Comment of Luis H. de Larramendi, Elzaburu (RFC-1 – September 19, 2000). But *cf.* Comment of the Brazilian Intellectual Property Association (ABPI) (RFC-2 – January 3, 2001), indicating that a broader scope of protection is favored, but "the exclusion of such domains may not be the most useful option."

64 See Comment of Asociación Interamericana de la Propiedad Industrial (ASIPI) (RFC-2 - December 26, 2000).

65 See Comment of the American Intellectual Property Law Association (AIPLA) (WIPO2 RFC-2 - December 29, 2000).

IGOs, contended that such an exclusion should apply to all gTLDs, while others suggested it should be considered only in relation to each particular gTLD.[66]

108. Various commentators proposed, either as an alternative or in addition to the exclusion, that such designations should be generally protected through the dispute resolution procedures of the UDRP.[67] Several of these comments suggested that there should be broader protection for IGOs under the UDRP, such that, as a starting point, *any* unauthorized registration and use of the name or acronym of an IGO should be presumed to be misleading and in bad faith.[68] One comment of an IGO provided a more detailed definition of bad faith, specifying that the registration of the name or acronym, in whole or in part, must have been unauthorized and *intentional*, and must be (i) likely to create an impression that the domain name is that of the IGO concerned, or (ii) in relation to a site that contains material or information prejudicial to the interests of the IGO.[69] A further comment from an IGO noted that any dispute resolution procedures should take into account "the customary immunity of intergovernmental organizations from legal process and execution."[70] Still other commentators contended that the UDRP should apply only to the extent that such names or acronyms of IGOs function as

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66 See Comment of the European Patent Office (EPO) (RFC-2 - December 28, 2000); Comment of Organization for the Prohibition of Chemical Weapons (RFC-2 – December 28, 2000); Preparatory Commission for the Comprehensive Nuclear-Test-Ban Treaty Organization (CTBTO) (RFC-2 – December 22, 2000); Comment of World Health Organization (WHO) (RFC-2 – December 21, 2000); Comment of Asociación Interamericana de la Propiedad Industrial (ASIPI) (RFC-2 - December 26, 2000); Comment of The Association of European Trade Mark Owners (MARQUES) (RFC-2 - December 22, 2000); *cf.* Comment of International Maritime Organization (IMO) (RFC-2 – December 13, 2000); Comment of J. R. Stogrum (RFC-1 – September 14, 2000).

67 See Comment of the Services of the European Commission (EC) (RFC-2 – January 16, 2001); Preparatory Commission for the Comprehensive Nuclear-Test-Ban Treaty Organization (CTBTO) (RFC-2 – December 22, 2000); Comment of the United Nations Framework Convention on Climate Change (RFC-2 – December 7, 2000); Comment of World Health Organization (WHO) (RFC-2 – December 21, 2000); Comment of the Comment of Asociación Interamericana de la Propiedad Industrial (ASIPI) (RFC-2 - December 26, 2000); Comment of European Brands Association (AIM) (RFC-2 - December 20, 2000); Comment of British Telecommunications, Plc. (RFC-2 - December 19, 2000); Comment of Luis H. de Larramendi, Elzaburu (RFC-1 – September 19, 2000).

68 See Comment of Asociación Interamericana de la Propiedad Industrial (ASIPI) (RFC-2 – December 26, 2000); Comment of European Brands Association (AIM) (RFC-2 – December 20, 2000); Comment of British Telecommunications, Plc. (RFC-2 – December 19, 2000).

69 See Comment of the Preparatory Commission for the Comprehensive Nuclear-Test-Ban Treaty Organization (CTBTO) (RFC-2 – December 22, 2000); see also Comment of World Health Organization (WHO) (RFC-2 – December 21, 2000), providing that the challenge should be allowed if the acronym of the IGO was in use *before* the domain name registration and there is a risk of confusion as to the identity of the domain name holder or the registration or use is otherwise in bad faith.

70 Comment of Organization for the Prohibition of Chemical Weapons (RFC-2 – December 28, 2000).

trademarks or service marks.[71] In line with this view, several comments from intellectual property or business associations indicated that, although there may be concern with respect to abusive registration of IGO's names or acronyms, no new protection is favored, particularly if such protection were to take the form of a broadening in the scope of the disputes that could be decided under the UDRP.[72] These comments recommended that the UDRP should be allowed to continue to develop and stabilize, and be available for trademark disputes arising in the ccTLDs and the new gTLDs that may be introduced into the DNS, before addressing disputes arising from conflicts with the categories of identifiers considered in the Second WIPO Process.

109. Several commentators noted that different legitimate uses can be made, in particular, of the acronyms that reasonably correspond to the IGO's name[73], and that such abbreviations, if registered by a third party as a domain name for other legitimate purposes (e.g., if the acronym corresponds also to the abbreviation of the third party's name), should not be subject to an absolute exclusion, but might be open to challenge through dispute resolution.[74] A number of commentators noted that a directory or listing service of IGOs, especially of those, which are protected under the Paris Convention and through the TRIPS Agreement, would be useful.[75] Still other commentators raised free speech concerns and contended that the names or acronyms of IGOs should be allowed to be registered as domain names if the names contain some other words and the registrant has indicated on its web site that it is not associated with the particular IGO (and provides a link to the IGO's site).[76]

110. Finally, as noted at the outset, a significant number of commentators were generally concerned with what they viewed as excessive regulation of the DNS, potential bias and other developments with respect to the UDRP, and insufficient regard for existing domain name

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71 See Comment of the American Intellectual Property Law Association (AIPLA) (RFC-2 – December 29, 2000); Comment of International Trademark Association (INTA) (RFC-2 – January 4, 2001).

72 See Comment of Fédération Internationale Des Conseils en Propriété Industrielle (FICPI) (RFC-2 – December 29, 2000); Comment of International Trademark Association (INTA) (RFC-2 – January 4, 2001); Comment of United States Council for International Business (USCIB) (RFC-2 – December 29, 2000); Comment of Verizon (RFC-2 – December 26, 2000).

73 See Comment of Leah Gallego, TLD Lobby (RFC-1 – August 16, 2000); Comment of J. R. Stogrin (RFC-1 — September 14, 2000).

74 See Comment of World Health Organization (WHO) (RFC-2 – December 21, 2000); Comment of the American Intellectual Property Law Association (AIPLA) (RFC-2 – December 29, 2000)

75 See Comment of International Maritime Organization (IMO) (RFC-2 – December 13, 2000); Comment of Organization for the Prohibition of Chemical Weapons (RFC-2 – December 28, 2000); Comment of Preparatory Commission for the Comprehensive Nuclear-Test-Ban Treaty Organization (CTBTO) (RFC-2 – December 22, 2000); Comment of the United Nations Framework Convention on Climate Change (RFC-2 - December 7, 2000); Comment of World Health Organization (WHO) (RFC-2 – December 21, 2000); Comment of Asociación Interamericana de la Propiedad Industrial (ASIPI) (RFC-2 – December 26, 2000); Comment of European Brands Association (AIM) (RFC-2 – December 20, 2000); Comment of Luis H. de Larramendi, Elzaburu (RFC-1 – September 19, 2000).

76 See Comment of Christopher Zaborsky (RFC-1 – August 11, 2000); Comment of Dr. Ashutosh C. Pradham (RFC-2 - December 16, 2000).

holders rights, and therefore were against any new form of protection in the DNS for IGO's names or acronyms.[77]

ALTERNATIVES FOR PROTECTION OF THE NAMES AND ACRONYMS OF IGOs

111. In view of the analysis and discussion above, it is considered that three options for protection of the names and acronyms of IGOs in the DNS should be raised for further comment in the Second WIPO Process:

- ♣ The status quo, that is, reliance on the existing protection in the form of the top-level domain, .int, which is reserved for treaty organizations.
- ♣ The establishment of an exclusion mechanism in some or all of the gTLDs for the names only, or for the names and acronyms, of IGOs; and
- ♣ The modification of the UDRP to extend it to the names or acronyms of IGOs.

Protection Through the .int gTLD

112. The .int top-level domain, discussed above, provides protection to qualified intergovernmental organizations through its restricted procedures for registration. In reviewing this alternative, a significant and perhaps central issue to be considered is whether this existing protection, limited and imperfect in the sense that it does not extend to all gTLDs (or ccTLDs), should nevertheless be considered appropriate and sufficient. As noted above, a number of commentators advanced this view.[78] It may be argued that all IGOs, even those that have not requested or received protection under the Paris Convention and TRIPS Agreement, are able to register their name or acronym in this TLD, so long as they have been established by treaty. The general public could be reasonably assured as to the authenticity of the IGOs and the validity of the information provided by them under the names or acronyms registered in this domain. Further, this alternative for protection carries the important benefit of having already been established, such that there is no potential interference with any rights or interests of existing domain name registrants in other TLDs.

113. In order for this alternative for protection of IGOs to be considered adequate, however, it is important that the .int top-level domain be widely known to IGOs and well recognized by the public in general, so that IGOs will take advantage of the protected space if offers and Internet users will be aware that they can find relevant and accurate information in this TLD

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[77] See e.g., Comment of ACM Internet Governance Project (RFC-2 – September 15, 2000); Comment of Alexander Svensson (RFC-2 – December 21, 2000); Comment of Frank Schilling, PTI Networks, Inc. (RFC-1 – August 13, 2000); Comment of William Blackwood, VerandaGlobal.com, Inc. (RFC-1 – August 15, 2000); Comment of Charles Linart, Solid State Design, Inc., (RFC-1 – August 15, 2000); Comment of harrycanada (RFC-1 – August 14, 2000); Comment of Garry Anderson (RFC-1 – August 12, 2000); Comment of Mark Moshkowitz (RFC-1 – August 12, 2000); Comment of Daniel Deephanphongs (RFC-1 – August 12, 2000).

[78] See *supra* note [21] and accompanying text.

about IGOs and their activities.[79] The domain does not seem to enjoy widespread recognition at present and considerable promotional work would seem to be needed to enhance its public visibility and profile. In addition, the restriction to *one* registration for each organization might be considered insufficient for the needs of IGOs and could be amended or eliminated – without altering the procedures to verify that each organization qualifies for registration in .int – so that IGOs have the ability to register domain names corresponding to their name and acronym, as well as to their various programs, activities or initiatives.

114. The biggest disadvantage of reliance solely upon use of the .int domain name is that it deals with only one half of the problem of authenticity of identity on-line. It assists in determining when a domain name registration is legitimate, but it does not assist in determining when domain name registrations are fraudulent. In other words, it would create credibility and reliability within the .int space, but not within the broader generic top-level domains space where predatory practices could continue in respect of the names and acronyms of IGOs. For this reason, at this stage, it is recommended that reliance alone upon the .int domain is insufficient.

115. It is considered that mere reliance upon the .int top-level domain for the protection of the names and acronyms of IGOs is insufficient and it is recommended that additional protection for those names and acronyms be established.

Protection through Exclusions of the Names or Acronyms of IGOs

116. A significant number of commentators, including nearly all of the IGOs that submitted comments, supported the establishment of an exclusion mechanism to protect the names or acronyms of IGOs. Similar to the exclusion for INNs, described above, such a protective mechanism could operate to block the registration of the name or acronym of an IGO as a domain name in the gTLDs to which the exclusion applies. The comments discussed above in this Chapter raised several points that require careful consideration in the review of this alternative, and how it might be implemented.

117. *Scope of exclusion limited to IGOs' names, but not acronyms?* An exclusion could be implemented, which operates to block the registration only of the exact name of an IGO (as it may exist in the official international languages), but does not extend to block registration of an acronym corresponding to that name. While an acronym (such as WHO) may be derived reasonably from the name of any number of commercial or non-commercial entities, it is much more difficult to justify how the name of a particular IGO, in an open gTLD such as .org or .com, could legitimately be held without authorization by an individual or entity other than the IGO concerned. An exception to this general approach could be made if the acronym

[79] *Cf.* Comment of Assistant Prof. Stephen Turnbull, University of Tsukaba (RFC-1 – August 29, 2000) (indicating that "there should be a gTLD created for [IGO] names and abbreviations, and otherwise they should be unregulated").

of a particular IGO is especially distinctive, for example, because it includes a large number of characters (e.g., UNHCR for United Nations High Commission on Refugees).

118. Limiting exclusions in this way to the names of IGOs, while leaving open for registration their acronyms, would not prevent the possibility of granting additional protection by way of an administrative procedure for any abusive domain name registration by a third party of (i) an IGO's acronym, or (ii) a name that is considered to be confusingly similar to an IGO's name. Under such a procedure, for example, once an IGO became aware of an existing domain name registration that is alleged to be abusive, the IGO in question could submit a complaint to a specially constituted administrative panel of experts (not associated with the UDRP) which would make an evidentiary determination whether the domain name registration should be transferred to the IGO, or cancelled and thereafter excluded from registration. Such an exclusion, which would have effect to enforce the transfer or cancellation and exclusion of an existing abusive domain name registration, could be granted only in relation to a string that is identical or confusingly similar to the name or acronym of an IGO, and could operate only in the gTLD in which the domain name in dispute was registered.

119. The panel for consideration of complaints from IGOs could be centralized and appropriately qualified to consider such complaints. The costs of the procedure could be borne by the IGO in question. Domain name registrants would be permitted to make submissions to the administrative panel, to defend their domain name registration against the allegation that it is abusive. Such a defense could be based on the exception set forth in Article 6*ter* (1)(b) of the Paris Convention, that the domain name registration or use, against which the protection is invoked, (i) "is not of such a nature as to suggest to the public that a connection exists between the organization concerned and the . . . abbreviations, and names," or (ii) "is probably not of such a nature as to mislead the public as to the existence of a connection between the user and the organization."

120. The reason for preferring an administrative panel procedure such as that described in the preceding paragraphs over a modification of the UDRP is the traditional immunity from jurisdiction enjoyed by international intergovernmental organizations. A central feature of the public international law system is such immunity from process and it would seem more in consonance with this principle to deal with complaints from international intergovernmental organizations within an administrative system set up for the organizations themselves and outside the scope of application of any national laws.

121. *Application of exclusion to all gTLDs?* A second issue to be considered is whether such an exclusion should operate and be enforced in all gTLDs, or only in the open gTLDs? The existing open gTLDs – .com, .net and .org – as noted above, present the demonstrated risk that the bad faith and abusive registration of an IGO's name or acronym can occur. As one IGO commented, problems can arise in any of the open gTLDs, because many users of the Internet consider the particular gTLD in which a name is registered to be of secondary importance, whereas the domain name itself is of primary importance.[80] Moreover, this

[80] See Comment of the Preparatory Commission for the Comprehensive Nuclear-Test-Ban Treaty Organization (CTBTO) (RFC-2 – December 22, 2000).

problem is compounded by the use of search engines which, in response to a query, produce all sites containing a name, regardless of the gTLD in which the name is registered.[81] The existing restricted gTLDs – .edu, .gov and .mil – on the other hand, pose little or no risk that an abusive registration of an IGO's name or acronym can occur. However, several of the newly approved gTLDs, so-called 'charter' domains which are said to carry certain restrictions on registration (for instance, .aero, .coop, and .museum), may raise greater concern regarding potential misleading or abusive registrations, if their registration procedures are not carefully and consistently applied. It therefore should be considered that any exclusion mechanism be implemented in all open gTLDs, as well as potentially in the new charter gTLDs, and that exclusions be granted in these domains indefinitely.

122. *Restricted to IGOs Notified under the Paris Convention/TRIPS Agreement.* A significant number of commentators suggested that any protection for IGOs' names or acronyms in the DNS should be limited to those organizations which have requested and received protection under the notification procedures of the Paris Convention and the TRIPS Agreement. As indicated above, since 1958 when the protection for IGOs' names, abbreviations or other emblems was first established, less than 100 IGOs have been notified for protection under these treaties, with respect to their names, acronyms or other emblems. Therefore, limiting any exclusions to the names or acronyms of IGOs that are protected under these treaties would substantially diminish any concern, such as was raised in the first WIPO Process, that such protection would result in an erosion of the domain name space. This concern is further alleviated in light of the recent approval of the seven new gTLDs. A listing of the IGOs whose names or acronyms receive protection under these treaties would need to be made available to registration authorities, to implement an exclusion mechanism on this basis.

123. It is recommended that the names of IGOs protected under the Paris Convention and the TRIPS Agreement should be excluded from registration in all existing open gTLDs, as well as in all new gTLDs.

124. Further comments are requested on the desirability of adding to the exclusion mechanism mentioned in the preceding paragraph an administrative adjudication procedure for complaints by IGOs in respect of the misleading registration and use of their acronyms as domain names or of domain names that are misleadingly similar to their names.

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81 *Id.*

Protection through the UDRP of the Names or Acronyms of IGOs

125. The third alternative for consideration is to accord protection for the names or acronyms of IGOs through a broadening in the scope of the UDRP so as to allow claims to be submitted by IGOs. As discussed above, this alternative was favored by a number of the commentators, while others considered that it would be unwise to make changes to the UDRP during a period in which it is still developing and facing increasing use in the ccTLDs and, most probably, in the newly approved gTLDs.

126. Such an alternative, to accommodate IGOs, would require that three amendments be considered for implementation. First, an adaptation of the UDRP to extend protection to IGOs would require a change to the first of the three central elements of the Policy, set forth in Paragraph 4(a), as to who may submit claims.[82] Rather than specifying that the complainant must have rights in a trademark or service mark, the term would also have to encompass claims submitted by an IGO for the registration of a domain name that is identical or confusingly similar to its name or acronym. The procedure could be limited to those IGOs which are protected under the Paris Convention and through the TRIPS Agreement.

127. Second, the definition of bad faith could be amended, at least with respect to registrations that correspond to the *name* of an IGO (and perhaps *not* to its acronym). A number of commentators supported this approach. It may be considered that the registration, without authorization, of a domain name that is identical or confusingly similar to the name of an IGO could presumptively be viewed to be in bad faith. The burden would then be on the respondent to justify – in accordance with the factors set forth in the existing UDRP (see UDRP, paragraph 4(c)), as well as in the exception established in Article 6*ter* (b)(1) of the Paris Convention (i.e., the registration and use of the name or acronym of the IGO is unlikely to suggest to, or mislead, the public that a connection with the IGO exists) – why this is not so.

128. The third change, mentioned in the preceding paragraph, would be to introduce, as a possible *mandatory* element of a defense for a domain name registrant (in addition to the existing factors under the UDRP), that the domain name registration and use, in accordance with the exception of Article 6*ter* (1)(b) of the Paris Convention, does not suggest to, or mislead, the public that a connection with the IGO exists.

129. While the alternative of amending the scope of the UDRP is raised here for consideration, several factors, some of which are noted above, weigh against it. Mixing the claims of IGOs with claims submitted by other parties, before a UDRP administrative panel that does not have specific expertise with respect to public international law could generate complexity, inconsistency and unsatisfactory determinations. For example, a different standard, at least with respect to the names of IGOs, might apply as to what constitutes bad faith, and a different defense on the part of the respondent might also be required. Further, the customary immunity of IGOs from legal process might suggest that any claims they would have should be handled in a separate procedure, which they have specifically endorsed.

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82 Paragraph 4(a) of the UDRP defines the scope of applicable disputes through three required elements:

130. On balance, it is not recommended at this stage that the UDRP should be modified in order to allow for claims by IGOs in respect of the registration of the names and acronyms of IGOs as domain names in a misleading manner.

APPLICABILITY TO ccTLDs

131. A number of commentators noted that the concerns with respect to the names or acronyms of IGOs extend equally to the ccTLDs. For this reason, and because the registration of a domain name in a ccTLD gives rise to a globally accessible presence on the Internet, the administrators of ccTLDs are encouraged to adopt any recommendations made for the protection of the names or acronyms of IGOs in the gTLDs.

PERSONAL NAMES

132. Personal identity, expressed through a person's name, voice or appearance, is fundamental to a recognition of the inherent dignity and individuality of each human being. The Universal Declaration of Human Rights recalls that each individual is entitled to liberty and the development of the human personality, to recognition as a person before the law, and to the protection of his or her moral and material interests resulting from any scientific, literary or artistic endeavors.[83]

133. As an element of identity, the personal name is a vitally important, if not the most important, means for designating a specific human being. Personal names are used daily in communications among people to identify one another and, as one might expect, the identity characteristics of each person become closely associated with his or her name. Strong associations, which might not be facially apparent, commonly attach to an individual's name. Consider, for a moment, the name "Mohandas Gandhi", and various qualities associated with the individual who bore that name immediately spring to mind.

134. There is abundant evidence that the names of at least certain well-known individuals have been the subject of parasitical practices in the domain name space. Similar practices exist in respect of personal names, particularly those of famous people, in various contexts in the non-virtual world. The Internet adds, however, a new dimension to those practices because of the immediacy and low cost with which a domain name registration may be obtained and because of the global presence to which it gives rise.

135. The law in numerous jurisdictions accords specific legal protection to the intimate aspects of the human identity, such as the personal name or personal likeness. The right to protect one's own identity, often referred to as a "personality right," focuses on an individual's right to control the commercial use of his or her identity. While the law of defamation, which includes the twin torts of libel and slander, exists to protect one's reputation and good name, the personality right serves to prohibit the unauthorized commercial use of a person's name, likeness or other personal characteristics closely associated with him or her. The term 'persona' has been used in this context to indicate the cluster of individual traits embodied in a personal identity, such as a name, nickname, voice, image, signature or other recognizable indicia of a specific human being.[84]

136. The present Chapter focuses on one elemental aspect of the personality right, the personal name, which in the DNS context may be registered as a unique domain name. WIPO2 RFC-2 requested comments on whether any protection against abusive registration as a domain name in the gTLDs should be accorded to personal names and, if so, in what

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83 Universal Declaration of Human Rights, Preamble and Articles 1, 6, 26, 27 and 29.

84 See J. T. McCarthy, *McCarthy on Trademarks and Unfair Competition*, Vol. 4, ch. 28, §28:7, at p.28-10 (4th ed., 2000). One commentator has suggested that the term "right in persona" should be used to refer to the intellectual property right of every person to control the commercial exploitation of his or her identity. See J.C.S. Pinckaers, *From Privacy Toward a New Intellectual Property Right in Persona*, Information Law Series 5 §6.2[C] (1996).

circumstances and how. This Chapter reviews the state of the law on protection of personal names, including an analysis under personality rights, trademark law and emerging anti-cybersquatting legislation. Perhaps the most visible and important recent developments in this area have occurred in connection with cases decided under the UDRP: numerous Panels have determined, under the auspices of trademark law and bad faith registration, that protection should be extended to the names of certain individuals whose names were registered without permission by third parties. The Chapter discusses these decisions and the many comments in response to WIPO2 RFC-2 that have also referred to them. There is also a review of pertinent aspects of a proposal recently approved by ICANN for a new TLD to be designated ".name", and its potential bearing on these issues in the evolving DNS. Finally, on the basis of this analysis, several alternative recommendations are raised for interim consideration, which are intended to provide a basis for further discussion and consultation before any recommendations are finalized.

137. WIPO2 RFC-2 raises two significant issues that should be borne in mind throughout this assessment on personal names, namely, (i) what are the types and extent of any problems or abuses within the DNS related to personal names, and (ii) is existing protection under national law or the UDRP capable of adequately resolving any such problems or abuses. In this respect, it is important to observe that a majority of the commentators on WIPO2 RFC—2 expressed the view that, aside from existing protection under national law, the UDRP, as it currently exists, is a sufficient mechanism for dealing with the problem of abusive registration of personal names in the DNS. It is further important to note, as the discussion below illustrates, that the subject of protection for personal names is a dynamic area, both within the DNS (under the UDRP) and in national legislation around the world.

WHAT'S IN A NAME: PERSONAL NAMES AND TECHNOLOGY

138. Although commercial exploitation of 'persona,' including the personal name, is not a new phenomenon[85], advances in technology, especially over the last 100 years, have made possible the novel and widespread use of a person's name, likeness, voice or other attributes to boost the marketing of products or services, by attracting the consumer's attention or inspiring his or her confidence through endorsement. The development of modern

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85 See J.C.S. Pinckaers, *From Privacy Toward a New Intellectual Property Right in Persona*, Information Law Series 5 §1.1, at p.3 (citing Battersby and Grimes, *The Law of Merchandising and Character Licensing* § 1.02 (1991)). The author indicates that from the Middle Ages, Popes and certain European nobility have consented to the use of their names in connection with merchandise, in return for a tax or royalty on the revenue from sales. In the 17th century, John Locke wrote:

> "Though the Earth, and all inferior Creatures be common to all Men, yet every Man has a Property in his own Person. This no Body has any Right to But himself."

Id., §7.1, at p.239 (citing Locke, *Two Treatises of Government (1690): A Critical Edition with an Introduction and Apparatus Criticus* by P. Laslett, Cambridge Univ. Press (rev. ed. 1964), Second Treatise of Government, Ch. V, 27). From this premise, Locke argued that a person's labor justifies a property right in his works. *Id.* In quoting Locke in this Report, we are borrowing on one feature of his identity, his reputation as a powerful thinker, to emphasize a particular point.

photographic, print, audio and broadcast technologies, along with the commercial rise of mass media channels, especially television, have raised the celebrity of the individual to a level unheard of in the past, perhaps with the exception of Popes, Emperors, Kings or Presidents. These developments have given rise to the economic reality that merchandising of persona and endorsement are thriving sectors of commerce.[86]

139. The Internet, viewed in this context, is merely the most recent, powerful medium offering profuse opportunities to use persona as a means of advancing commercial marketing and merchandising ends. While names, images and voice can be presented through multimedia web pages, the DNS, in particular, as a text-based naming and navigational system,[87] intrinsically emphasizes the importance of the names or labels selected by those using the network. These names and labels are used by consumers and individuals around the world to promote and locate web sites or to act as stems for email addresses. The personal name therefore becomes a logical and attractive attribute for registration, and a potential target for abuse by third parties who would wish to benefit from the associations generated by certain personal names. Perhaps in light of these considerations, it is not surprising that one prevailing view, discussed in the section below addressing UDRP decisions, is that the placing on the domain name register of a distinctive name, such as *gretagarbo.com*, makes a representation to persons who consult the register that the registrant actually is, or is associated with, the person whose name is registered and thus is entitled to use the goodwill in the name.

140. The question is thus particularly apposite whether, in the context of the DNS, personal names should be entitled to any protection, and if so, in what context and under what circumstances.

THE EVOLVING INTERNATIONAL PROTECTION OF PERSONAL NAMES

Personality Rights Discussed in the Final Report of the First WIPO Process

141. As noted above, the final Report of the first WIPO Process discussed the subject of personality rights, indicating that the issues in this area of intellectual property would require further reflection and consultation.[88] Personality rights were also briefly touched upon in Chapter Three of the final Report, in connection with the recommendation of a uniform and

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86 See *Id.*, §1.1; see also M. Abell, *"Protecting Personalities: Time for a New Form of Copyright,"* Copyright World, at p. 1 (Aug., 1998). This area is also known as "personality merchandising, in which the name, voice, image and other personality features of mainly famous persons are used in marketing and advertising. "[I]t is not so much the product which is of principal importance to the consumer, but rather the name or image that it bears is the main marketing and advertising vehicle. *WIPO Intellectual Property Reading Materials*, ch. 2, §2.600 (1998).

87 As explained in the final Report of the first WIPO Process, each domain name is mapped to a unique underlying Internet Protocol (IP) numeric address for the purpose of identifying a particular computer and facilitating requests to connect computers to each other on the Internet. Ch. 1, para. 4.

88 Final Report, Executive Summary, at pp. 8-9.

mandatory administrative dispute resolution procedure. In particular, based on the analysis and comments received during the first WIPO Process, the Report proposed a narrow scope for this procedure, specifying that it should be confined to cases of deliberate, bad faith abusive domain name registrations,[89] and also restricted to those complainants who could assert that the domain name in question infringes on a *trademark* or *service* mark in which they have rights.[90]

142. The Report acknowledged that by defining abusive registration with reference only to trademarks and service marks,

> *"registrations that violate . . . personality rights would not be considered to fall within the definition of abusive registration* ***for the purposes of the administrative procedure****."*[91]

143. The Report observed, in this regard, that commentators in favor of this limitation had indicated that the law with respect to personality rights, among other rights, is less evenly harmonized throughout the world. The final Report therefore concluded, with respect to the administrative procedure, that while there is evidence that the abusive registration of domain names

> "extends to the abuse of intellectual property rights other than trademarks and service marks, . . . we consider that it is premature to extend the notion of abusive registration beyond the violation of trademarks and service marks at this stage. After experience has been gained with the operation of the administrative procedure and time has allowed for an assessment of its efficiency and of the problems, if any, which remain outstanding, the question of extending the notion of abusive registration to other intellectual property rights can always be re-visited."[92]

144. This section now turns to address the question of protection, under the law, of personal names, reviewing relevant aspects of the law of personality rights and trademark law, as well as several new legislative enactments specifically addressing the tension between domain names and other protected identifiers. One of the aims of this Interim Report is to explore the suitability of seeking relief for abusive registrations of personal names under the existing UDRP, as well as to inquire whether the law and the comments received would suggest that any changes or other protection is needed. In so doing, it is important to focus not only on whether protection should be accorded, but if so, what the proper legal basis and scope of that protection should be.

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89 Final Report, Ch. 3, para. 165-66; see also Uniform Domain Name Dispute Resolution Policy (UDRP), para. 4(a)(iii).

90 Final Report, Ch. 3, para. 167; see also UDRP, para. 4(a)(i).

91 Final Report, Ch. 3, para. 167 (emphasis in original).

92 *Id.*, para. 168.

The Emerging Law of Personality Rights

145. The personality right, also known as the "right of publicity" in certain jurisdictions, has been defined as "the inherent right of every human being to control the commercial use of his or her identity."[93] According to the modern view, the legal right is said to be infringed by an unauthorized use of a person's identity which is likely to damage the commercial value of the identity and which is not immunized by principles of free speech or free press.[94] The legal right reflects a view that human identity, in certain instances, constitutes an intellectual property right with measurable commercial value. One needs only to consider, for example, a certain young golfer who has emerged to dominate the professional golf tour in recent years to understand the potential value that can be assigned to one's personal identity by the forces of supply and demand in the marketplace.

146. The development of this personality right, however, has not been without international discussion and scrutiny, in particular with respect to its legal basis, scope and dimensions. Nor can it be said that such protection as exists in various jurisdictions is well harmonized in its approach, application or enforcement. No international instrument, as in the case of trademarks, exists to establish uniform norms of protection for personality rights. Thus, even today, as questions concerning fairness in the use of personal identity continue to be raised in a number of different jurisdictions and contexts – including registration as a domain name – different legal theories, such as privacy, passing off, unfair competition, the right of publicity, or violation of certain civil code provisions,[95] are relied upon by the courts to determine whether any relief is appropriate.

147. The personality right has its antecedents in the concept of privacy, but now also finds increasing intellectual support in the law of unfair competition. Under the theory of privacy, courts especially in Europe and the United States, beginning more than a century ago, started granting protection against unauthorized advertising and other intrusive forms of commercial use of a person's identity (in particular, a person's name or picture), on the ground that such use, without permission, is an affront to the person's human dignity and state of mind.[96] By the end of the 1950s, this theory of protection for one's personal identity was well established in numerous jurisdictions. The privacy theory, however, did not recognize as a basis of relief that an individual might have a *financial* interest in his or her own identity. Thus, certain "celebrity" plaintiffs, whose identity was widely exposed in the media, were not able to

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93 J. T. McCarthy, *McCarthy on Trademarks and Unfair Competition*, Vol. 4, ch. 28, §28:1, at p. 28-3.

94 *Id.*

95 In Switzerland, for example, the civil code provides:
"Where a person assumes the name of another to the latter's prejudice, the latter can apply for an injunction to restrain the continuation of this assumption, and can in addition claim damages if the act is proved to be wrongful, and moral compensation if this is justified by the nature of the wrong suffered." Swiss Civil Code, Article 29.2.

96 J. T. McCarthy, *McCarthy on Trademarks and Unfair Competition*, §28:3 at p. 28-3; see also J.C.S. Pinckaers, *From Privacy Toward a New Intellectual Property Right in Persona*, Information Law Series 5 §1.2[A], at p.4 (the author cites cases in France, Germany and the United States, dating from 1892 through 1910, in which protection was accorded in connection with the use of a person's photograph in the advertising of various products or services).

demonstrate the requisite "mental distress" under a theory that was premised on "the right to be left alone."[97]

148. The development of mass media, however, has brought with it a growing recognition that especially well-known individuals, in certain circumstances, may be entitled to legal protection against, or financial compensation for, the commercial use of their personal identity as a means of facilitating an enterprise's marketing ends. This legal protection, as noted above, still expresses itself in various forms in different jurisdictions. In certain jurisdictions, relief may be granted only when a third party's use of another's identity is considered to constitute libel or passing off, such that the use involves a misrepresentation or causes confusion among consumers as to the person's sponsorship or endorsement of a product or service.[98] In other jurisdictions, it is the misappropriation of the persona of the individual, without more, that is sufficient to give rise to relief under a right of privacy or personality right. A number of the countries of continental Europe, such as France, Germany, Italy, the Netherlands and Spain, as well as countries such as Canada and Japan, adhere to this legal approach.[99] Finally, in certain other jurisdictions, such as many of the states of the

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97 J. T. McCarthy, *McCarthy on Trademarks and Unfair Competition*, *id.*

98 This is the case in the United Kingdom and Australia. In the United Kingdom, it may be possible to use a person's identity for advertising purposes, so long as such use does not defame the person or constitute passing off (i.e., activity that would confuse the public as to whether the person is actually sponsoring or endorsing the commercial product or service). Advertisers in the United Kingdom voluntarily abide by The British Code of Advertising Practice, which provides in relevant part that "advertisements should not portray or refer to any living persons in whatever form or by whatever means, unless their express prior permission has been obtained." (Section 17.1). Section 17.2, however, provides a significant exception if the product in question is not "inconsistent with the celebrity's position" and does not interfere with the individual's "right to enjoy a reasonable degree of privacy." If unauthorized exploitation does not fall within the scope of this Code, or if the Code is ignored, then relief will be granted by the courts only for instances of libel or passing off.

99 See generally, J.C.S. Pinckaers, *From Privacy Toward a New Intellectual Property Right in Persona*, Information Law Series 5 §1.2[C], at pp.6-14. For example, in Germany, since 1954, such protection exists through a general personality right against the unauthorized use of a person's name. See Civil Code §823(1). In France, a personality right exists in one's image (*droit `a l'image*), which is viewed as a right protecting both privacy and property aspects. See Logeais, *The French Right to One's Image: A Legal lure*, 5 Ent. L. Rev. 163, at 164 (1994). In Canada, the right to protection of one's person name has been recognized under the tort of misappropriation of one's personality. See *Athens v. Canadian Adventure Camps Lts.*, 34 C.P.R.2d 126, at 136 ("it is clear that Mr. Athens has a proprietary right in the exclusive marketing for gain of his personality, image and name, and that the law entitles him to protect that right if it is invaded). In Spain, section 7 no.6 of the Act of May 5, 1982, declares the unpermitted use of one's name, voice or likeness for advertising or trade purposes an invasion of one's personal life. The Act protects the property interest of the individual to control the commercial use of his or her identity, based on the concept of a non-assignable personality right. In Italy, the courts have recognized a celebrity's right to receive protection against the misappropriation of the commercial value of his or her persona, including likeness, name and other distinctive characteristics capable of recalling the celebrity immediately. *Id.* In Japan, the courts have found that well-known celebrities have a protectable economic interest in their

[Footnote continued on next page]

United States of America, the contours of the right are well established in a right of publicity, such that it is considered to be a property right, premised on the right of each person to control the publicity values that he or she has created, which can be assigned or passed on to descendants.[100]

149. In common among these different legal approaches is an underlying concern that, in a number of situations, fairness requires that one's personal identity should be protected against unauthorized and unfair commercial exploitation by a third party. The requirement of *commercial* exploitation is another common element among the approaches. What is to be considered *unfair* commercial exploitation, however, may vary depending on whether a falsity or misrepresentation is required under the law (i.e., in cases of libel or passing off), or whether even an accurate use of a personal identity, without more, can give rise to a claim for protection and compensation.[101] The person must be clearly identifiable from the third party's unauthorized use of the personality trait. For example, mere use of a name that is identical to the name of a celebrity, if that name is not highly distinctive, may not be sufficient to establish identification. Moreover, the question of distinctiveness in an international medium such as the DNS is a difficult one. Significant limits to the personality right arise from concerns of freedom of speech and the press in certain jurisdictions. Thus, the use of attributes of personal identity in news reporting, commentary, certain entertainment or works of fiction or nonfiction, as opposed to in connection with advertising or merchandising, is

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name and portrait, which ordinary persons do not possess, and which is entitled to protection under the law of torts (Japanese Civil Code Article 709).

100 More than half of the states in the United States of America recognize a right of publicity. In states that do not recognize a right of publicity, actions exist for the tort of misappropriation or for a wrongful attempt to pass off the product or service as endorsed by the individual in question. The United States Supreme Court, in the seminal case of *Zacchini v. Scripps-Howard Broadcasting Company*, 433 U.S. 562, at 576 ((1976), stated as follows:
"The rationale for (protecting the right of publicity) is the straightforward one of preventing unjust enrichment by the theft of good will. No social purpose is served by having the defendant get free some aspect of the plaintiff that would have market value and for which he would normally pay."
The State of California has a comprehensive statutory right of publicity, providing protection for the use of a name, voice, signature, photograph or likeness "in any manner, or in products, merchandise, goods or services." Cal. Civil Code §§3344 and 990. In order to ensure freedom of speech, such features of an individual are permitted to be used in newspapers, magazines and other forms of written media and on film, radio or television without the consent of the individual (except in the form of advertisements or commercial announcements). Thus, an individual can control merchandising and endorsements that are associated with him, but cannot use this right to control commentary about him in the media.

101 See e.g., *Albert Heijn and 159 other plaintiffs v. Name Space,* Decision of the President of the Amsterdam District Court (July 13, 2000), holding;
"the contested use of the proper names of various plaintiffs must, in respect of these plaintiffs, be considered to be unlawful as they are now unable to register their proper names (or have their proper names registered) as domain names and are therefore unable to exploit these, causing them to suffer losses."

usually not considered to be infringement. Finally, the personality right as it exists in many jurisdictions is not assignable or descendible.

150. In the context of the DNS and, in particular, the gTLDs, as the cases of the UDRP have indicated, misappropriation of a distinctive personal name – often the name of a well-known celebrity – through the registration of that name as a domain name, raises substantial concerns. As discussed further below, however, extending uniform protection for such names, under a theory of personality rights, is a complex endeavor, as the law on this subject is itself not well-harmonized with respect to the legal basis and the constituent elements that must be established for infringement.

Trademarks and Personal Names

151. As discussed in the final Report of the first WIPO Process, trademarks and service marks find established international protection under the Paris Convention for the Protection of Industrial Property (the "Paris Convention),[102] the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement)[103] and the Trademark Law Treaty (TLT).[104] A vast majority of States around the world have enacted the protection under the Paris Convention and TRIPS Agreement into their national legislation,[105] while an increasing number have also become party to, or indicated their interest in becoming party to, the TLT.[106] Courts around the world routinely review allegations of infringement and grant relief where appropriate, based upon the protection of trademarks established in accordance with these treaties.

152. These instruments place no limit on the nature of the goods or services to which a trademark or service mark may be applied.[107] Similarly, they place no restriction on the nature of the identifying sign that may be used as the trademark or service mark. To the contrary, in respect of personal names, the TRIPS Agreement expressly provides in Article 15(1) that:

> "Any sign, or combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark. Such signs, in particular words including personal names, . . . shall be eligible for registration as trademarks. Where signs are not inherently capable of

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102 See Paris Convention for the Protection of Industrial Property, Articles 6, 6*bis*, 6*quarter*, 6*quinquies*, 6*sexies*, 6*septies*, 7, 9, 10, 10*bis* and 10*ter* (1883, as amended).

103 See TRIPS Agreement, in particular Articles 15-21 and Part III on Enforcement of Intellectual Property Rights (1994).

104 See Trademark Law Treaty (1994), in which the provisions of the Paris Convention relating to trademarks were extended to service marks.

105 Annex I lists the States party to the Paris Convention and States party to the World Trade Organization and Bound by the TRIPS Agreement.

106 As of the date of this Interim Report, 26 States are party to the TLT.

107 See Paris Convention, Art. 7, and TRIPS Agreement, Art. 15.

distinguishing the relevant goods or services, Members may make registrability depend on distinctiveness acquired through use."[108]

Two aspects of Article 15(1), in particular, may be noted:

(i) Article 15(1) indicates that the proper focus is not on the nature of the sign itself (e.g., personal name, figurative elements, combination of colors) as a rationale for determining whether trademark protection is appropriate. Instead, the analysis should center on whether the sign is sufficiently distinctive.

(ii) In a point with direct relevance to the use of personal names as trademarks or service marks, Article 15(1) provides that when a sign is not inherently capable of distinguishing goods or services, registration for trademark protection may be conditioned "on distinctiveness acquired through use." Thus, a personal name can receive protection as a trademark or service mark under the law, so long as the use of such name meets the test for the establishment of trademark rights – that is, to identify and distinguish the goods or services of one undertaking from those of other undertakings. In order to meet this test, it is generally understood that the personal name in question must be distinctive or have acquired "secondary" meaning, such that the consumer public has come to recognize the personal name as a symbol that identifies and distinguishes the goods or services of a particular enterprise.[109] Once such secondary meaning is established in the personal name, there is no impediment to that name becoming a strong and well-known mark, entitled to full protection under the international framework of trademark laws. Well-known personal names, such as Arthur Anderson, Cartier, Alfred Dunhill, Calvin Klein and Johnnie Walker have achieved just such a status in international commerce.

153. The extent of protection for personal names, in particular, faces certain limits not only in terms of sufficient distinctiveness, but also in cases of fair use, such as where a third party of the same name seeks to use his or her name in business. In this situation, the exclusive right of the trademark holder may be limited, since other persons bearing the same name may, under certain conditions, continue to use their names. Even in this situation, however, it should be noted that courts have found that bad faith or parasitic practices may be involved in using one's personal name as a trademark.[110] For example, persons who happen to have a name similar to a popular trademark may be tempted to enter into a similar line of business in

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108 TRIPS Agreement, Art. 15(1) (italics added).

109 See J. T. McCarthy, *McCarthy on Trademarks and Unfair Competition*, Vol. 2, ch. 13, §§13:2 and 13:3, at pp. 13-3 through 13-6. Prior to acquisition of secondary meaning, the personal name is descriptive only of a particular person, and has not come to be associated with the goodwill in a particular business or its products and services. *Id.* At common law, personal names used in the context of a business have received protection from the courts, but such protection is determined on a case by case basis, and depends greatly on the factual basis of each individual case. Key questions include whether there is confusion in the mind of the consumer, the distinctiveness of the mark, and the territory within which the mark is used.

110 See *WIPO Intellectual Property Reading Materials*, ch. 2, §2.620, at p.105.

order to benefit from the goodwill and reputation of their prospective rival. In such cases, it might be shown that the claim to use of one's personal name is not made in good faith. Finally, in certain jurisdictions, the registration of a trademark by a third party, which consists of the personal name of another living individual, except with his or her consent, may be refused or can result in a later challenge of infringement.[111]

154. Four important aspects, including certain commonalties and differences, may be noted with respect to the protection afforded under trademark law and under the law of personality rights, which may be relevant to the discussion of protection of personal names in the DNS:

(i) Both are concerned with the protection of an identifier, such as a personal name, that may serve to designate something else, such as a person or a business or its goods or services. However, the object of protection under trademark law is the mark itself, which serves as a symbol to the consumer public of a particular company or its products or services. The object of protection of the personality right, on the other hand, is the personal identity of a particular human being, including those closely connected traits of persona, such as likeness, personal name or voice.[112]

(ii) Both require distinctiveness, which in the case of a personal name would normally be acquired through use, in order for protection to arise under the law. Distinctiveness, in the trademark context, must be inherent or arise through the acquisition of means the name must have acquired a secondary meaning, such that it comes to be seen as a symbol identifying and distinguishing a business or its goods or services from other commercial undertakings. The distinctiveness required under the personality right, however, is not concerned with any association with goods or services, but goes to the ability of the relevant public to clearly identify the individual in question from that individual's characteristics of persona.

(iii) Infringement of both a trademark or personality right occurs through unauthorized use by a third party. However, under trademark law the right is infringed only if a third party's use of the mark is likely to cause a likelihood of confusion among consumers as to the source of goods or services. The personality right, on the other hand, does not require the demonstration of any confusion; instead, it is infringed when the public can identify the person in question from the third party's unauthorized commercial use.

(iv) Both are concerned with a commercial exploitation by a third party that infringes upon the right. However, under trademark law, the mark itself for which protection is sought must be *used in commerce* as a precondition to relief, whereas the personality right may protect a person who does not commercially exploit his or her own identity, but nevertheless desires to prevent others from doing so.

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111 See The Lanham Act §§2(a) and 2(c), 15 U.S.C. §1502.

112 See J.C.S. Pinckaers, *From Privacy Toward a New Intellectual Property Right in Persona*, Information Law Series 5, §3.5 at pp.106-07, §5.5 at pp.220-21, and §9.3[B][2] at pp. 310-14 (the author makes several detailed comparisons between trademark law and personality rights).

155. The commonalties noted above show that in certain situations, the protection under trademark law may possibly overlap with that afforded under the law of personality rights. At the same time, the distinctions noted above serve to highlight that there may be circumstances, especially in the DNS, in which the protection afforded by trademark law is not sufficient to protect the distinctive personal name of a particular individual against the unfair and abusive registration of that name as a domain name. A particular person's name may be quite distinctive, such that it clearly serves to identify that person to the public, yet the person may have no claim of protection under trademark law because the name has not been used as a mark in commerce. The names of well-known political figures, scientists or other well-known public figures may fall within this category. It would be implausible to suggest that such names have acquired the secondary meaning required by trademark law. Nevertheless, these names may be targeted by third parties, for registration as domain names in order to capitalize in an unauthorized and commercial manner on the widespread notoriety of the individual.

Legislation addressing domain names and other protected identifiers

156. Recent legislation in several countries, regulating domain names and their relationship to other protected identifiers, appears to reflect a concern, in particular with respect to personal names, that trademark law alone may not afford adequate protection in all cases.

157. *United States of America*. In the United States of America, the Anticybersquatting Consumer Protection Act (ACPA), which was passed into law in November 1999, contains three distinct provisions addressing personal names.[113] First, the Act creates a new civil cause of action against persons who – with a bad faith intent to profit from a *mark* ("including a personal name which is protected as a mark under this section") – register, traffic in, or use a domain name that is identical or confusingly similar to (or in the case of famous marks, dilative of) that mark. The section specifically recognizes that the new action may be brought "by the owner of a mark, including a personal name which is protected as a mark under this section."[114] The section reflects the established international position, enumerated in Article 15(1) of the TRIPS Agreement, that personal names may qualify as trademarks and thus are entitled to protection under trademark law, even in the DNS.

158. The ACPA also provides, in a separate section entitled "Cyberpiracy Protections for Individuals," that:

> "Any person who registers a domain name that consists of the name of another living person, or a name substantially and confusingly similar thereto, without that person's consent, with the specific intent to profit from such name by selling the domain name for financial gain to that person or any third party, shall be liable in a civil action by such person."[115]

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113 The Anticybersquatting Consumer Protection Act amends Section 43 of the Trademark Act of 1946, 15 U.S.C. 1125.

114 *Id.*, Section 3002(a) (amending Section 43 of the 1946 Trademark Act by inserting new section (d)(1)(A) at the end).

115 *Id.*, Section 3002 (b)(1)(A).

159. This provision reflects an intention to grant specific protection to personal names in their own right, and not on the basis that the person bearing the name may have acquired trademark rights in it under the law. The section, however, carefully delimits the scope of the protection that it grants in several ways. First, infringement can occur only in respect of the names of living persons, and therefore the registration by a third party of the personal name of a deceased person, even if that name is famous, is not covered. The domain name registration by the third party must be without the named person's consent. Next, the domain name in question must "consist of the name . . . or a name substantially or confusingly similar thereto." Finally, the section indicates there must be a "specific intent to profit from such name by *selling it* for financial gain." Thus, other possible abusive uses of a domain name consisting of a personal name are apparently excluded. The section provides an exception for personal names registered as domain names in good faith, which are to be "used in, affiliated with, or related to a work" protected under United States copyright laws.[116]

160. The ACPA also addresses personal names in a third distinct area. In Section 3006, a "Study on Abusive Domain Name Registrations Involving Personal Names" is authorized. In particular, the Study is intended to produce recommendations on "guidelines and procedures for resolving disputes involving the registration or use by a person of a domain name that includes the personal name of another person." The Section indicates that the United States Government, through the Secretary of Commerce, shall, under its Memorandum of Understanding with ICANN;

> "collaborate to develop guidelines and procedures for resolving disputes involving the registration or use by a person of a domain name that includes the personal name of another person, in whole or in part, or a name confusingly similar thereto."

161. In January 2001 the "Report to Congress: The Anticybersquatting Consumer Protection Act of 1999, section 3006 concerning the abusive registration of domain names" was released.[117] The conclusion of the Report stated:

> "We conclude that the time is not ripe for further federal legislation to protect personal names from abusive registration as domain names."

162. The Report did note, however, that the Second WIPO Process should contribute to further informing discussions of this issue and possibly developing globally functional recommendations regarding the resolution of related disputes.

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116 This exception applies, so long as the person registering the domain name meets several further requirements, including that he or she is the copyright owner or licensee of the protected work, intends to sell the domain name in conjunction with the lawful exploitation of that work, and the domain name registration is not prohibited by a contract between the registrant and the named person.

117 The Report is available at *http://www2.uspto.gov/web/officers/dcom/olia/tmcybpirscy/introduction.html*.

163. Recently, in August 2000, the State of California passed similar legislation to the ACPA to protect personal names. In particular, Article 1.6, entitled "Cyber Piracy," provides:

> "It is unlawful for a person, with a bad faith intent to register, traffic in, or use a domain name, that is identical or confusingly similar to a personal name of another living person or deceased personality, without regard to the goods or services of the parties."[118]

164. This law, in comparison to the ACPA, provides protection against bad faith registration not only in respect of living persons, but also in respect of the name of a "deceased personality." In determining "bad faith intent," a court may consider a list of nine non-exclusive factors enumerated in the law. These factors go beyond the narrow focus found in the ACPA on a "specific intent to profit from such name by selling the domain name."

165. *European Union*. The European Commission, in April 2000, circulated a Commission Working Paper for Public Consultation entitled "Speculative and Abusive Registration of Internet Domain Names."[119] The Working Paper introduces a Code of Conduct "that would be implemented in the first instance by all TLD Registries Operating in the EU, including the proposed Dot EU Registry."[120] The Code of Conduct proposes a number of rules, including a prohibition against "speculative registration of domain names in expectation that the names can be sold-on." The draft Code specifies that the rules would apply to "all categories of domain names," including, among others, "personal names." Finally, the Working Paper indicates that the Commission will continue to be closely associated with the on-going work of the WIPO in this area. Comments on the draft Code of Conduct were to be submitted to the Commission by the end of November 2000.

166. The foregoing legislative and rule-making initiatives at the national and regional levels indicate that the area of domain names and their relationship to other protected identifiers, including personal names, is a dynamic one. It might be expected that other related developments at the national or regional level could occur in the near future. There is a risk, however, which is greatly accentuated by the international nature of the Internet and the DNS, that any uncoordinated initiatives could create a more complex and uncertain environment for individuals and commercial enterprises using the networked medium.

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118 See Section 17525(a) of the Cal. Business and Professions Code (August 22, 2000).

119 Commission Working Paper for Public Consultation, "*Speculative and Abusive Registration of Internet Domain Names, Draft Principles for a Code of Conduct,*" COM(2000)202 of 7 April 2000.

120 *Id.*, at p.2.

PROTECTION OF PERSONAL NAMES UNDER THE UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY (UDRP)

167. As noted above, perhaps no recent development has been more significant in the area of domain names and their relationship to personal names than the establishment of the Uniform Domain Name Dispute Resolution Policy (UDRP) in December 1999. In the first year in which the UDRP has been in effect, more than 3640 disputes, including many involving personal names, have been resolved through the procedure.

168. A number of the key holdings under the UDRP concerning personal names are elaborated below. In considering these decisions, there are two important points that have been raised – the first by a number of commentators and the second both by commentators and WIPO2 RFC-2 – that need to be borne in mind. First, some commentators have questioned whether the UDRP, particularly in the decisions concerning personal names, has been properly applied to these disputes. However, both the analysis of trademark law above (in particular, with respect to Article 15(1) of the TRIPS Agreement) and the discussion of the cases below would suggest that the UDRP can and should be applied to protect personal names, so long as the name in question is properly determined to be a trademark or service mark. Second, and assuming that the UDRP does find proper application to personal names, is the question whether the UDRP, along with any existing legal protection under national law, is adequately capable of resolving abuses within the DNS related to personal names.

169. At the outset, it may be noted that the UDRP sets forth, as the focus of the dispute resolution policy, three criteria, each of which a complainant must prove, in order to establish that a domain name registration is abusive and the complainant is entitled to relief:

(i) the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights;
(ii) the registrant of the domain name has no rights or legitimate interests in respect of the domain name; and
(iii) the domain name has been registered and is being used in bad faith.[121]

(i) Trademark or service mark rights. With respect to personal names, the threshold issue that must receive careful attention under the UDRP is raised in the first required element: the complainant must assert, in accordance with the procedural rules, that the domain name "is identical or confusingly similar *to a trademark or service mark in which the complainant has rights*."[122] This limitation to trademarks requires, therefore, that in each case the complainant must demonstrate that the personal name in question is protected as a trademark or service mark, in which that complainant has rights.

170. There have been a number of cases in which a complainant has demonstrated that it meets this requirement by submitting evidence that the personal name in question is registered

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121 See UDRP, para. 4(a).
122 *Id.*, UDRP, para. 4(a)(i) (italics added).

as a trademark.[123] As discussed above, the TRIPS Agreement sets forth the established international norm on this point, providing expressly that, among other signs, "personal names . . . shall be eligible for registration as trademarks." The UDRP, however, does not require that a complainant must hold rights specifically in a *registered* trademark or service mark. Instead, it provides only that there must be "a trademark or service mark in which the complainant has *rights*," without specifying how these rights are acquired.[124] With this distinction in mind, many decisions under the UDRP have therefore determined that common law trademark rights may be asserted by a complainant and will meet the burden under the first element of the Policy.[125] Regarding personal names, in particular, numerous UDRP decisions have relied upon a complainant's demonstration that it holds such common law rights in the disputed name.[126]

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123 See e.g., *Harrods Ltd. v. Robert Boyd*, WIPO Case D2000-0060 (March 16, 2000) (the domain name *dodialfayed.com* was determined to be registered and used in bad faith, as it was confusingly similar to the personal name, "Dodi Fayed," which had been registered as a European Community Trademark); *Madonna Ciccone, p/k/a Madonna v. Dan Parisi and "Madonna.com,"* WIPO Case D2000-0847 (Oct. 12, 2000) (the domain name was held to have been registered and used in bad faith and was identical or confusingly similar to the personal name, Madonna, for which the complainant held a United States Trademark Registration); *Drs Foster & Smith, Inc.* v. *Jaspreet Lalli*, NAF FA0007000095284 (Aug. 21, 2000) (same); see also *Helen Fielding v. Anthony Corbet a/k/a Anthong Corbett*, WIPO Case D2000-1000 (Sept. 25, 2000) (complainant had registered trademark in fictional character "Bridget Jones").

124 See J. T. McCarthy, *McCarthy on Trademarks and Unfair Competition*, Vol. 4, ch. 25, §25:74.2 (2000), indicating that "the reference to a trademark or service mark 'in which the complainant has rights' means that ownership of a *registered* mark is not required – unregistered or common law trademark or service mark rights will suffice" to support a complaint under the UDRP. (Emphasis in original).

125 One of the earliest decisions to rely on unregistered rights in a trademark was in handed down in the consolidated cases of *Bennett Coleman & Co.* v. *Steven S. Lalwani*, WIPO Cases D2000-0014 and D2000-0015 (March 11, 2000). The cases involved a complainant located in India and a respondent located in the United States of America. The respondent challenged that there were no trademark registrations for the relevant words in the domain names, *theeconomictimes.com* and *the timesofindia.com*, in the United States and that, in any event, any trademark registrations in India had expired. The Panelist, Professor W.R. Cornish, found first that, given the Internet provides worldwide access, the assessment of the propriety of a domain name registration cannot be confined only to comparisons with trademark registrations and other rights in the country where the web site may be hosted. Secondly, the panelist relied on the "reputation from actual use" of the words in question to determine that, whether or not the Indian trademarks were registered, the complainant had trademark rights.

126 See e.g., *Julia Fiona Roberts v. Russell Boyd*, WIPO Case D2000-0210 (May 29, 2000) (holding that the complainant has common law trademark rights in her name: "The Policy does not require that the Complainant should have rights in a registered trademark or service mark. It is sufficient that the Complainant should satisfy the Administrative Panel that she has rights in common law trademark or sufficient rights to ground action for passing off"); *Jeanette Winterson* v. *Mark Hogarth*, Case D2000-0235 (May 22, 2000) (Panel held that complainant has trademark rights in the mark JEANETTE WINTERSON, emphasizing that paragraph 4(a)(i) of the UDRP "refers to **rights** not registered trademark rights of a third party"); *Mick Jagger* v. *Denny Hammerton*, NAF FA0007000095261 (Sept. 11, 2000) ("Complainant held a common law trademark in his famous name, "Mick Jagger," even without registration at the United States Patent and Trademark Office."); *Helen Folsade Adu p/k/a Sade v. Quantum Computer*

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171. In light of a number of the comments received, these decisions concerning common law trademark rights in personal names are a crucial point of focus in determining whether the UDRP has been properly applied in granting protection for personal names. In making these determinations, the panels have given attention to a number of factors, including: (i) the distinctive character or notoriety of the name and the requirement that the domain name must be "identical or confusingly similar" to it, (ii) the relationship between this distinctive character and use of the name in connection with goods or services in commerce, and (iii) the location of the parties and the bearing that this may have on the acquisition of unregistered trademark rights.

172. Regarding the distinctiveness of the name, panels have emphasized in many cases that the particular complainant's personal name, in the relevant field of commerce, enjoys widespread notoriety and fame.[127] "A claim based on an unregistered mark, including a personal name, requires that the claimant establish the distinctive character of the mark or name on which the claim is based."[128] Further, the panels have focused this analysis of

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Services, Inc., WIPO Case D2000-0794 (Sept. 26, 2000) (Panel held that complainant has established common law trademark and service mark rights in the word "SADE," which has been used in connection with sales of records, CDs, CD-ROMS, tickets for concerts and merchandising in many jurisdictions around the world); *CMG Worldwide, Inc. v. Naughtya Page*, NAF Case FA0009000095641 (Nov. 8, 2000) (Diana, Princess of Wales, before her death had common law trademark rights in her name); *Cho Yong Pil v. ImageLand. Inc.*, WIPO Case D2000-0229 (May 10, 2000) (complainant demonstrated that the fame in his name, as famous Korean pop music artist for 30 years, was sufficient to give him trademark or service mark rights for the purpose of the rules"). See also final Report of first WIPO Process, paras. 149-50, at 42-43 (allow "consideration of all legitimate rights and interests of the parties (which are not necessarily reflected in a trademark certificate)").

127 See e.g., *Julia Fiona Roberts v. Russell Boyd*, WIPO Case D2000-0210 (May 29, 2000) (the complainant "is a famous motion picture actress"); *Jeanette Winterson* v. *Mark Hogarth*, WIPO Case D2000-0235 (May 22, 2000) (Complainant is an author who has "achieved international recognition and critical acclaim," writing books and screen plays that have been published in over 21 countries in 18 languages); *Mick Jagger* v. *Denny Hammerton*, NAF FA0007000095261 (September 11, 2000) (Complainant has a "famous personal name, 'Mick Jagger,'"); *Helen Folsade Adu p/k/a Sade v. Quantum Computer Services, Inc.*, WIPO Case D2000-0794 (September 26, 2000) (complainant is a world famous singer, songwriter and recording artist known under the stage name "SADE"); *Isabelle Adjani v. Second Orbit Communications, Inc.*, WIPO Case D2000-0867 (October 4, 2000) (Panel notes that complainant has achieved "international recognition and acclaim" as a well-known film actress using her real name, Isabelle Adjani); *CMG Worldwide, Inc. v. Naughtya Page*, NAF Case FA0009000095641 (Nov. 8, 2000) (finding that, in relation to the domain names *princessdi.com* and *princessdiana.com*, that Princess Diana, during her life time, was well known as Princess Diana or Princess Di); but cf., *Gordon Sumner, p/k/a Sting* v. *Michael Urvan*, WIPO Case D2000-0596 (July 20, 2000) (held that the personal name Sting was not distinctive, as it "is also a common word in the English language, with a number of different meanings").

128 See *Monty and Pat Roberts, Inc. v. Bill Keith*, WIPO Case D2000-0299 (June 9, 2000).

distinctive character in relation to the second element mentioned above, "whether or not the person in question is sufficiently famous in connection with the services offered by that complainant" in commerce.[129] Using a personal name in association with certain goods or services creates the secondary meaning in the name discussed above. With respect to similarity, Panels have found that small variations between the personal name and the registered domain name (e.g., such as removing the space between the first and last names), just as in other cases involving words or terms other than personal names, are legally insignificant, so long as the registered domain name is "confusingly similar" to the personal name.[130]

173. In this analysis of common law trademark rights, Panels have also been attentive to the location of the parties, finding that the complainant has acquired such rights under the law where he or she resides or has been legally present for purposes of establishing such rights.[131]

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129 See *Steven Rattner v. BuyThisDomainName (John Pepin)*, WIPO Case D2000-0402 (July 3, 2000) (holding Complainant is well-known and has a common law mark in connection with investment banking and corporate advisory services); *Monty and Pat Roberts, Inc.* v. *Bill Keith*, WIPO Case D2000-0299 (June 9, 2000) (held that complainant's name, Monty Roberts, is a famous mark in connection with the service of horse training); *Nic Carter* v. *The Afternoon Fiasco*¸WIPO Case D2000-0658 (October 17, 2000) (complainant's "name, Nic Carter is distinctive, has received a high degree of recognition and has come to be associated in the minds of the public with Complainant and his radio broadcasting services"); *Isabelle Adjani* v. *Second Orbit Communications, Inc.*, WIPO Case D2000-0867 (October 4, 2000) (use of complainant's ame has come to be recognized by the general public as indicating an association with the complainant and her activities as an actress); *Mick Jagger v. Denny Hammerton*, NAF FA0007000095261 (September 11, 2000) ("Complainant presented evidence "of the continuous commercial use ... for more than thirty-five (35) years" of "his famous personal name, 'Mick Jagger,'"); *Helen Folsade Adu p/k/a Sade v. Quantum Computer Services, Inc.*, WIPO Case D2000-0794 (September 26, 2000) ("SADE," has been used in connection with sales of records, CDs, CD-ROMS, tickets for concerts and merchandising in many jurisdictions around the world); but cf., *Anne Mclellan v. Smartcanuk.com*, eResolution Case AF-0303a & AF0303b (September 25, 2000) (held that complainant, the most senior Government of Canada official in the Province of Alberta, where both complainant and respondent reside, has common law trademark rights in her name, although the decision does not indicate that she has used her name as a mark in commerce).

130 See e.g., *Harrods Ltd. v. Robert Boyd*, WIPO Case D2000-0060 (March 16, 2000) (domain name *dodialfayed.com* was determined to be confusingly similar to the personal name, "Dodi Fayed."); *Steven Rattner* v. *BuyThisDomainName (John Pepin)*, WIPO Case D2000-0402 (July 3, 2000) (complainant not limited to claiming rights in his full name - small variations in the name are not material).

131 See *Bennett Coleman & Co. v. Steven S. Lalwani*, WIPO Cases D2000-0014 and D2000-0015 (March 11, 2000) (given the Internet provides worldwide access, the assessment of the propriety of a domain name registration cannot be confined only to comparisons with trademark registrations and other rights in the country where the web site may be hosted); see also *Jeanette Winterson v. Mark Hogarth*, Case D2000-0235 (May 22, 2000) ("Since both the Complainant and the Respondent are domiciled in the United Kingdom, … the Panel can look at applicable decisions of English courts"); *Pierre van Hooijdonk v. S.B. Tait*, WIPO Case D2000-1068 (Nov. 4, 2000) (complainant was resident in the Netherlands and the Respondent in the United Kingdom. The Panel makes reference to (i) complainant's Benelux registered trademark and

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Rule 15(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules of Procedure") provides that the Panel shall decide a complaint on the basis, *inter alia*, of "…any rules and principles of law that it deems applicable."[132] Pursuant to this provision, panels may take into account the applicable law that may be relevant, based on the facts of the case including the location of the parties. This Rule has permitted panels, based on the law of a relevant jurisdiction, to determine that the complainant has established common law trademark rights in his or her personal name. In this respect, Rule 15(a) provides the UDRP with built-in flexibility, a key feature that permits the procedure to comport with areas in trademark law where differences still exist (e.g., recognition of common law trademark right *versus* a requirement of registration in certain jurisdictions). It is a feature that has enabled complainants to seek protection for their names under trademark law, although they have not registered their names as a trademark or service mark.

(ii) The registrant has no rights or legitimate interests in the domain name. There must be no evidence that the domain name registrant has any rights or legitimate interests in the domain name that it has registered. Panels normally review the full record in a case to assess whether a respondent has any rights or interests in the domain name. Based on the distinctiveness of the personal name in question and certain facts indicating that: (i) the domain name does not correspond to the respondent's own name, and (ii) the respondent has registered the names of many other well-known celebrities, this determination in a number of cases has been almost self-evident[133]. In other cases, however, a more probing analysis has been called for. For example, the panel in one case found that, while the respondent's use of

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service mark, (ii) the common law of the United Kingdom, and (iii) the decision of the President of the Amsterdam District Court in *Albert Heijn and 159 other plaintiffs v. Name Space* (July 13, 2000), holding that defendant's registration of 300 "proper names" was unlawful); *Isabelle Adjani* v. *Second Orbit Communications, Inc.*, WIPO Case D2000-0867 (Oct. 4, 2000) ("The Complainant is resident in Switzerland and the Respondents give an address in the United States of America. To the extent that it assists in determining whether the Complainant has met her burden under paragraph 4a(i) of the Policy to establish that she has trademark rights in her name *Isabelle Adjani*, the Panel can look at applicable decision and laws in both countries"); *Estate of Stanley Getz a/k/a Stan Getz* v. *Peter Vogel*, WIPO Case D2000-0773 (Oct. 10, 2000) ("Since Getz was a resident of the State of California at the time of his death and since his estate is being probated in the courts of the State of California under California law, to the extent that it would assist the Panel, the Panel shall also look to the law of the State of California.").

132 See Rules for Uniform Domain Name Dispute Resolution Policy, Rule 15(a)

133 See *Experience Hendrix. LLC v. Denny Hammerton and the Jimi Hendrix Fan Club,* WIPO Case D2000-0364 (August 15, 2000); *MPL Communications Ltd.* v. *Denny Hammerton*, NAF Case FA0009000095633 (October 25, 2000) (respondent, who had registered *paulmccartney.com* and *lindamccartney.com*, has also registered the names of other celebrities such as Mick Jagger, Rod Stewart and Sean Lennon. He has not made use of the domain names in connection with a bona fide offering of goods or services); *Madonna Ciccone, p/k/a Madonna v. Dan Parisi and "Madona.com,"* WIPO Case D2000-0847 (October 12, 2000) (use which intentionally trades on the fame of another can not constitute a "bona fide" offering of goods or services").

the name in question, "sting," as a nickname on the Internet was *not* substantial enough to show any rights or legitimate interests in the domain name *sting.com*, the respondent's proven use was in fact relevant to the separate issue of bad faith. In another case, the panel disagreed with the respondent's argument that the domain name in question, *sade.com*, was being offered merely as a legitimate email service. Instead, the panel found that, by placing the domain name in the music section of its web site and having registered it under the contact, "The Sade Internet Fan Club," the respondent "has set out to deliberately associate this service with the Complainant."[134] Finally, in another case, the panel acknowledged that the respondent's contention was a serious one, that use of the domain name in question, *montyroberts.net*, was for legitimate non-commercial or fair use purposes.[135] In balancing the rights of the complainant in its mark and the rights of the respondent to freely express its views about the complainant, however, the panel determined that:

> "the rights to express one's views is not the same as the right to use another's name to identify one's self as the source of those views. One may be perfectly free to express his or her views about the quality or characteristics of the reporting of the New York Times or Time Magazine. That does not, however, translate into a right to identify one's self as the New York Times or Time Magazine."[136]

174. Further, the panel found that although the respondent's primary motive for establishing web site might have been to criticize the complainant, this did "not insulate Respondent from the fact that it is directly and indirectly offering products for sale on its website, or at websites hyperlinked to its site."[137]

(iii) The domain name has been registered and is being used in bad faith. A pivotal and necessary finding in the numerous cases concerning personal names is that there is evidence of bad faith. The UDRP sets forth four non-exhaustive examples of what may be considered "evidence of the registration and use of a domain name in bad faith."[138] A review

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134 *Helen Folsade Adu p/k/a Sade* v. *Quantum Computer Services, Inc.*, WIPO Case D2000-0794 (September 26, 2000).

135 See *Monty and Pat Roberts, Inc.* v. *Bill Keith*, WIPO Case D 2000-0299 (June 9, 2000).

136 *Id.*; see also; *Nic Carter v. The Afternoon Fiasco*¸WIPO Case D2000-0658 (October 17, 2000) (same); *Jeanette Winterson v. Mark Hogarth*, Case D2000-0235 (May 22, 2000), quoting *British Telecommunications plc v. One in a Million* (1999) FSR 1, at p.23 (C.A.) (Aldous L.J.): "The placing on a register of a distinctive name such as *marksandspencer* makes a representation to persons who consult the register that the registrant is connected or associated with the name registered and thus the owner of the goodwill in the name."

137 *Id.*

138 See UDRP, para. 4(b):
"For the purposes of Paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the panel to be present, shall be evidence of the registration and use of a domain name in bad faith:
(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a

[Footnote continued on next page]

of the decisions concerning personal names indicates that each of these circumstances has been relied upon in one or more cases to support a determination that the registration and use of the domain name in dispute was in bad faith. Given the distinctive character of a number of the names in question and a consideration of other relevant facts, an underlying and consistent perception has been that the respondent, through the domain name registration, has clearly targeted the complainant's unique personal or professional name.[139] Panels, however, have exercised caution in confirming that such parasitic practices relate to one of the illustrative bad faith factors listed in the UDRP or to a similar bad faith commercial exploitation of the complainant's name. Accordingly, the panel in one case ruled that, where the domain name was identical to the complainant's professional name but was connected to a *non-commercial* web site expressing criticism of the complainant (operated by a brother-in-law), the case involved alleged defamation and not infringement of a trademark right.[140] Defamation, which goes to the reputation of an individual, does not have any necessary relationship to the commercial and infringing exploitation of a personal name used as a mark.

175. The jurisprudence under the UDRP indicates that it can and should be applied to protect personal names against bad faith domain name registrations, provided that the criteria of the Policy are carefully and properly applied. For cases involving personal names that have not been registered as a trademark or service mark, a particular focus must be devoted to ascertaining that the name in question, under relevant law, has acquired the requisite common law trademark rights. This scrutiny, as the many thoughtfully reasoned UDRP decisions demonstrate, has been applied seriously and consistently by the panels.

176. The UDRP, in many cases, provides protection to those individuals, especially well known individuals, whose names are most highly likely to be the target of abusive domain name registrations. Indeed, even in cases where the personal name has acquired

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competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location."

139 See e.g., *Experience Hendrix. LLC v. Denny Hammerton and the Jimi Hendrix Fan Club*, WIPO Case D2000-0364 (Aug. 15, 2000) (*jimihendrixs.com*); *MPL Communications Ltd. V. Denny Hammerton*, NAF Case FA0009000095633 (Oct. 25, 2000) (*paulmccartney.com* and *lindamccartney.com*); *Madonna Ciccone, p/k/a Madonna v. Dan Parisi and "Madona.com,"* WIPO Case D2000-0847 (Oct. 12, 2000) (*madonna.com*).

140 See *Jules I. Kendall v. Donald Mayer re skipkendall.com*, WIPO Case D2000-0868 (Oct. 26, 2000).

distinctiveness only in relation to a particular field of commerce, the Policy has been applied for protection.[141] Some of these persons will have registered their personal or professional names as marks. Others may be located in jurisdictions that would recognize a personal name as an unregistered common law mark, provided that the name has been used in commerce and has acquired distinctiveness. However, for those persons who do not live in such jurisdictions and have not registered their names as a mark, they will not necessarily be able to seek relief under the Policy.[142] A number of commentators have expressed the view that persons seeking to protect their personal or professional names should be required, just as other enterprises are required with respect to their brands, to have them registered as marks. These commentators have also urged that it is enough that the UDRP protects the names of complainants whose names qualify as trademarks, and therefore the scope of the Policy should not be changed.

177. There are still other categories of individuals, such as well known public figures or others who are not so well known, who would not be entitled to protection under the UDRP even if their name is quite distinctive, because they have not used it in commerce. Perhaps it is due to a perceived injustice with respect to persons in this position that, in one or two cases, Panels have arguably stretched their interpretation of the Policy to find common law trademark rights in a name, even though there was little or no evidence, despite the notoriety of the name, that it had been used as a mark in commerce. As the comparison above between trademark law and the law of personality rights pointed out, there are cases in which an individual might receive protection under a personality rights policy - so long as the personal name in question is distinctive and is being commercially exploited by a third party without consent - but would not receive protection under the UDRP, whose scope is limited to trademarks (e.g., because the person has not used his or her name in commerce).

PERSONAL NAMES AND THE EVOLVING DNS: THE PROPOSED .NAME TOP-LEVEL DOMAIN

178. The question of considering protection for personal names within the DNS arguably becomes more complicated as the DNS becomes more differentiated. Of immediate relevance to this assessment is the recent selection by ICANN of the proposed registry operators for seven new TLDs that are intended to be introduced during this year. Included on this list is the .name TLD.

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141 See e.g., *Steven Rattner v. BuyThisDomainName (John Pepin)*, WIPO Case D2000-0402 (July 3, 2000) (complainant is well-known and has a common law mark in connection with investment banking and corporate advisory services); *Monty and Pat Roberts, Inc. v. Bill Keith*, WIPO Case D2000-0299 (June 9, 2000) (complainant's name, Monty Roberts, is a famous mark in connection with the service of horse training); *Nic Carter v. The Afternoon Fiasco*¸WIPO Case D2000-0658 (October 17, 2000) (complainant's name, Nic Carter is distinctive and has come to be associated in the minds of the public with complainant and his radio broadcasting services).

142 Pursuant to the Paris Convention (Article 6*bis*) and the TRIPS Agreement (Articles 16(2) and 16(3), such persons may still be able to demonstrate that their names would qualify as a "well-known" mark in particular common law jurisdictions and therefore qualify for protection.

179. The sponsors of the .name TLD state in their application that they "seek to create a clear and unambiguous label that is semantically different from all other TLDs."[143] They indicate that the fundamental tenet of the .name proposal is "that there exists a significant worldwide market for the creation of a personal domain space that reflects the needs of an individual and not those of commerce." The application specifies, in this regard, that the ".NAME TLD is intended for individuals and for personal use," and that the registry "will operate exclusively in the Personal Domain Name Space and registering Personal Domain Names for individuals with no commercial connotations." Among the policies to be enforced by accredited registrars is that:

> "All registrants will be required to certify their bona fide interest in registering a domain name for personal use and that there exists a relationship between the name being applied for and the registrant, and they may be required to produce evidence of this interest in the event of a dispute."[144]

180. In addition, definitions contained in the .name application specify that the word "personal" "is intended to mean an individual and not a legally incorporated entity," and that the words "personal use" are "intended to mean that there is no commercial intention or activity."[145]

181. While the application points out that "screening processes or TM issues are virtually impossible to implement," it also states that "[w]e are, however, committed to protecting the rights of trademark and service mark holders and are proposing to introduce a system by which holders of these marks can be notified of potential infringements." In particular, during a "sunrise period," holders of national trademarks and service marks would be invited to submit strings for inclusion in a trademark list. Such trademark holders would then be automatically advised, via the relevant registrar, when domain names are registered that match the string(s) supplied. The .name proposal further indicates that it will:

> "fully implement the tried and tested UDRP to deal with any issues of dispute. The rules in this area are clear and it discourages deliberate breaches of the guidelines. Whilst this is not a perfect answer, it is the fairest."

182. Importantly, registrations are open only for third-level domains – no registrations will be accepted for the second level: that is, the second level of "***lastname***.name" will be reserved, while the registrant will only be able to register the third level as in "***firstname***.lastname.name." Because names will be held only at the third level, it is stated that the advantage to "squat" or "warehouse" names will be greatly reduced. No specific limitation, however, is stated to be imposed on the number of domain names that an

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143 See *The Global Name Registry Application to ICANN*¸ at §E0.1, at *http://www.icann.org/tlds/name1/links/Exec_summary.htm.*

144 Id., at §E4. In particular, the application notes that the registrant must state: (i) that name being sought has a correlation to registrant; (ii) that it accepts the obligation to refrain from all illegal activities using the domain name; (iii) that all registration data will be kept current and accurate; (iv) the domain name will be used only for personal use. Id., §E10.

145 *Id.*, at §E1 (Description of TLD Policies – General)

individual can register. Finally, the .name proposal indicates that there will be no pre-registration period and a pre-payment will be required before a registration is actived in each case.

183. The .name proposal, if faithfully implemented in accordance with the stated terms of its application, would seem to offer the potential of a useful expansion of, and differentiation in, the DNS. A non-commercial space for personal name registrations might reduce pressure in other top-level domains, such as .com, .org or .net, where commercial or other organizational and networking purposes are implied. Even in a properly implemented .name TLD, however, abuses could easily take place. Personal names of distinctive personalities could be registered through a combination of the second and third levels, and might be used for unauthorized commercial or other predatory purposes. Contact details will still need to be required, should copyright infringements appear.

184. The .name TLD may contribute to authenticity in personal identity in the DNS. It will not, however, solve the problem of abusive registrations of personal names in other gTLDs.

ANALYSIS AND OPTIONS

185. From the above discussion and analysis, a number of possibilities arise to be considered with respect to protection of personal names in the DNS.

- First, it could be recommended that no changes should be made to the UDRP. This position is founded on the view that the protection afforded under the UDRP for personal names, with the Policy restricted to names that qualify as trademarks or service marks, should be considered sufficient, at least for the present, along with any protection under relevant national law. Given the developments with respect to personal names that are discussed above under the UDRP and in the laws or rules of certain countries and regions, this view would counsel that it is best to continue to wait and to see how these emerging developments have settled. Many commentators, who view the UDRP as a new and still relatively untested procedure, would support this view.

- Against this recommendation, one could alternatively suggest that there is an immediate need for new measures of protection against abusive registrations of personal names, particularly as the DNS is set to continue to expand and Internet usage continues to rise. Thus, a second possibility is to recommend an amended scope for the UDRP, to encompass a new and narrow category of claims brought on the basis of a personality right. This approach would allow those complainants who can assert sufficient distinctiveness in their name to take advantage of a dispute-resolution procedure in cases where they would meet the required elements. Those elements could include:

(i) The personal name must be shown to be sufficiently *distinctive* in the eyes of the relevant public, such that it clearly identifies the complainant in question;
(ii) There must be a *commercial* exploitation of the personal name through its registration and use as a domain name;
(iii) The commercial exploitation must be *unauthorized*;

(iv) *Bad faith* must be demonstrated, which can be shown through the illustrative and non-exhaustive factors currently listed under the UDRP, with an additional factor as follows:

facts that indicate an intentional effort to take advantage of the reputation or goodwill in the personal identity of the person; and

(v) The interests of freedom of speech and the press need to be taken into account, such that application of this personality right in the DNS should only prohibit use of the personal name for commercial purposes (i.e., cases of alleged libel and slander would not fall within the scope of the procedure).

♣ Finally, a third alternative recommendation is to modify the scope of the UDRP only in its application to the new TLD, .name. Introduction of a claim on the basis of a personality right rather than a trademark, as described above, could be applied to registrations in this TLD. This option would not address potential abuse in other the TLDs. However, it would assist in the regulation of the .name namespace, so that it can be implemented in accordance with the stated intentions of its sponsors.

186. Further comments and, in particular, expressions of preferences are invited on the options set out in the preceding paragraphs.

GEOGRAPHICAL INDICATIONS, INDICATIONS OF SOURCE AND OTHER GEOGRAPHICAL TERMS

187. In addition to the issues discussed in the previous chapters of this Interim Report, the Final Report of the first WIPO Process highlighted one other question that was deemed to merit further attention at a later stage, once adequate experience had been gained with the UDRP. The origin of this question were comments received in the course of the first WIPO Process indicating that a class of intellectual property identifiers other than trade or service marks were also frequently the target of abusive cybersquatting practices.[146] This class of identifiers was geographical indications, a concept which, while perhaps less well-known among the general public than trademarks, nonetheless also has a long pedigree in the intellectual property system.

188. Geographical indications were discussed in the final Report of the first WIPO Process in the context of the debate on the proper scope of the UDRP.[147] In light of emerging evidence suggesting that geographical indications were the target of abusive domain name registrations, the question was raised whether the UDRP should also cover this category of intellectual property. While there were conflicting views on the matter and a number of commentators had expressed a preference for a procedure covering the full range of intellectual property disputes,[148] the final Report recommended that geographical indications should not be included within the scope of the UDRP, at least not in the initial phase of the existence of the UDRP. This recommendation was made essentially for two reasons. First, it was felt that it would be more prudent to adopt, in the initial stage, a restricted procedure, while retaining the possibility of broadening its scope in the future, once more experience has been gained and some confidence had been established in the procedure. Second, a conservative approach was recommended in light of the need to alleviate the concerns of certain commentators who feared that a broadly scoped UDRP covering also geographical indications would be too powerful a tool in the hands of intellectual property holders.

189. After approximately one year of operational experience with the UDRP and in light of further consideration given in various policy fora to the appropriate long-term development of the DNS, WIPO was requested by its Member States to address the still outstanding question

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146 See Comment of the *Fédération des syndicats de producteurs de Châteauneuf du Pape* (March 24, 1999 – WIPO1-RFC-3).

147 See paragraphs 167-168 of the Report of the first WIPO Process.

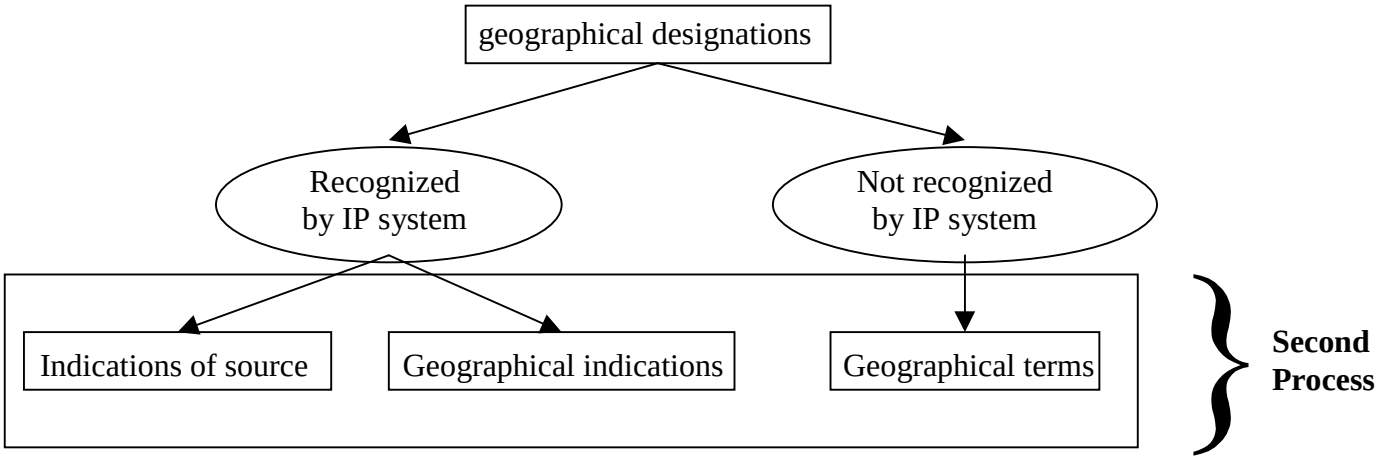
148 See Comment of European Community and its Member States (WIPO1-RFC-2 - November 3, 1998); Comment of the Government of the Republic of Korea, Korean Industrial Property Office: Ministry of Trade, Industry and Energy (WIPO1-RFC-2 - November 16, 1998); Comment of the Government of the Russian Federation, Russian Agency for Patents and Trademarks (Rospatent) (WIPO1-RFC-2 - November 2, 1998); Comment of American Intellectual Property Law Association (AIPLA) (WIPO1 – RFC-2 - November 6, 1998); Comment of *Fédération Internationale des Conseils en Propriété Industrielle* (FICPI) (WIPO1-RFC-2 - November 9, 1998); Comment of Institute of Trade Mark Agents (WIPO1-RFC-2 - November 3, 1998); Comment of Internet Industry Association of Australia (WIPO1-RFC-2 - November 6, 1998); Comment of Association of European Trade Mark Owners (MARQUES) (WIPO1-RFC-2 - November 6, 1998).

of geographical indications in the Second Process. Accordingly, WIPO2 RFC-1 and RFC-2 requested comments on whether and by which means geographical indications (in the broad sense) should be protected against their bad faith, abusive, misleading or unfair registration or use as domain names.

190. In this Second WIPO Process, the term 'geographical indication' (in the broad sense) covers three distinct concepts: 'geographical indications' (in the strict sense), 'indications of source' and 'geographical terms'. While the precise definition of geographical indications and indications of source often is the source of considerable confusion, principally because of the subtle differences in meaning attributed to these concepts in the various legal instruments governing them (at the global, regional, as well as national levels), they clearly have one characteristic in common, namely that they form part and parcel of the system of identifiers traditionally recognized by the intellectual property system.

191. The class of identifiers intended to be covered by the concept 'geographical term' is of an entirely different nature, in as much as this concept has not traditionally been recognized by the intellectual property system. For the purposes of this Process, the term is meant to refer to place names (for example, the names of cities or regions in a country), as well as geopolitical (for example, country names) and geo-ethnic terms (for example, peoples' names).

The relationship between these terms can be represented graphically as follows:



192. In this graphical representation, 'geographical designation' is the most general term and encompasses all underlying concepts. More precise definitions, in particular of geographical indications and indications of source, are provided in the ensuing sections of this Interim Report.

GEOGRAPHICAL DESIGNATIONS RECOGNIZED BY THE INTELLECTUAL PROPERTY SYSTEM

Terminology, Purpose and Legal Framework

193. *Terminology and purpose*. Indications of source are designations of the geographic place of origin of a product (for example, 'made in …'), whereas geographical indications are a sub-category of the former used with respect to products where the product originates in a territory, or region or locality within a territory, and where a given quality, other characteristic or reputation of that product is attributable to its geographic origin (for example, 'champagne').

194. The policy basis underlying geographical indications and indications of source is fundamentally the same as the policy basis of trademarks, namely, the orderly functioning of the market through the avoidance of confusion and deception.[149] Nonetheless, there is an important difference. Whereas a trademark links a particular *manufacturer* to a product (for example, 'Coca-Cola'), geographical indications and indications of source link a particular *region or location* with a class of product and their producers.

195. *Legal framework*. There exists an extensive body of intellectual property law at the global, regional and national levels governing geographical indications and indications of source. At the global level, the relevant multilateral treaties are the Paris Convention for the Protection of Industrial Property, to which 162 States are party,[150] the Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods, to which 31 States are party,[151] the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration, to which 20 States are party,[152] and the Agreement on Trade-Related Aspects of Intellectual Property Rights of April 15, 1994 (the TRIPS Agreement), to which 134 States are party.[153]

196. Some of the legal instruments at the regional level include, for the European Union, the Council Regulation on the Protection of Geographical Indications and Designations of Origin for Agricultural Products and Foodstuffs of July 14, 1992, and the Council Regulation on the Common Organisation of the Market in Wine of 17 May 1999. In the Americas, relevant agreements include the North American Free Trade Agreement signed on December 17, 1992, between Canada, the United States of America and Mexico; Decision 486 of September 14, 2000, of the Cartagena Agreement between Bolivia, Colombia, Ecuador, Peru and Venezuela;

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149 As explained in the final Report of the first WIPO Process (paragraph 11), "[a] trademark enables consumers to identify the source of a product, to link the product with its manufacturer in widely distributed markets. The exclusive right to the use of the mark, which may be of indefinite duration, enables the owner to prevent others from misleading consumers into wrongly associating products with an enterprise from which they do not originate."

150 See Annex II.

151 See Annex II.

152 See Annex II.

153 See Annex II.

and the Protocol for the Harmonization of Intellectual Property Provisions in Mercosur signed on August 1, 1996, between Argentina, Brazil, Paraguay and Uruguay.[154]

197. While uniform international norms exist requiring the protection of geographical indications and indications of source, the systems adopted by States to give effect to those norms within their national legal systems is less harmonized for geographical indications and indications of source than for trademarks. Most countries in the world protect trademarks through publicly administered registration systems. However, international obligations with respect to geographical indications and indications of source are implemented in national legal systems through a variety of approaches, ranging from the adoption of *sui generis* legislation (often creating registration systems for geographical identifiers, comparable to trademark registers)[155] to the application of the laws on unfair competition, passing off, consumer protection, or on collective and certification marks.[156] Frequently, these different approaches are applied cumulatively.

198. In view of their importance, universal reach and their consequent relevance for assessing the legality of the use of geographical indications and indications of source in the gTLDs, some of the key provisions of the Paris Convention, the Madrid (Indications of Source) Agreement, the Lisbon Agreement, and the TRIPS Agreement are explained in the ensuing paragraphs.

199. *The Paris Convention.* Article 10(1) of the Paris Convention states that its provisions on seizure of goods (contained in Article 9) "shall apply in cases of direct or indirect use of a false indication of the source of the goods or the identity of the producer, manufacturer, or merchant." The Convention does not offer any definition of an 'indication of source', but the term is understood to refer to a geographic place of origin of a product, without the product necessarily having a quality, characteristic or reputation that is derived specifically from this origin. An indication of source is deemed false under the Convention if it is factually untrue (i.e., the goods in fact did not originate from the source indicated) and understood as such by the public in the country where the indication is used.[157] The term 'indirect use' is intended to cover situations where the indication of source is not expressed through a word (for example, 'Switzerland'), but by other means, often an image (for example, a picture of the Matterhorn, a well-known Swiss mountain with a particular and easily recognizable shape).

200. *The Madrid (Indications of Source) Agreement.* The Madrid (Indications of Source) Agreement broadens the scope of protection for indications of source to those that are "deceptive." Deceptive indications of source are those that are factually true, but nevertheless mislead the public as to the origin of the goods. [158]

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154 The Protocol is not yet in force.

155 For example, France.

156 For example, the United States of America.

157 In other words, the provision does not apply if, in a certain country, a term denoting a region of another country is generic, in the sense that the public in the first country does not perceive it to be a reference to that particular region in the second country.

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201. *The Lisbon Agreement.* The Lisbon Agreement offers enhanced protection for the sub-category of indications of source, known as 'appellations of origin'. Under the Lisbon Agreement, an 'appellation of origin' is "the geographical name of a country, region, or locality, which serves to designate a product originating therein, the quality and characteristics of which are due exclusively or essentially to the geographical environment, including natural and human factors." The enhanced protection available under the Lisbon Agreement is obtained through a system of international registration administered by the International Bureau of WIPO. According to Article 3 of the Agreement, States party to the Agreement are required to ensure protection for appellations of origin registered under the Agreement against "any usurpation or imitation, even if the true origin of the product is indicated or if the appellation is used in translated form or accompanied by terms such as 'kind', 'type', 'make', 'imitation', or the like." Currently, the International Bureau of WIPO has registered more than 800 appellations of origin under the Lisbon Agreement from 12 countries identified in Annex V.

202. *The TRIPS Agreement.* Geographical indications also are the subject of Section 3 of the TRIPS Agreement, which contains three Articles: Article 22 on protection of geographical indications, Article 23 on additional protection for geographical indications for wines and spirits, and Article 24 on International Negotiations and Exceptions. Article 22 defines, for purposes of the TRIPS Agreement, geographical indications as "indications which identify a good as originating in the territory of a Member, or a region or locality in that territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin." While the concept of geographical indication under the TRIPS Agreement thus is close to the concept of appellation of origin in the Lisbon Agreement, it is not identical.[159]

203. Under Article 22 of the TRIPS Agreement, the obligation of Member States in respect of geographical indications is to provide the legal means for interested parties to prevent:

[Footnote continued from previous page]

158 This could occur, for instance, if two regions in different countries have the same name and if the name of the region in the first country has been used extensively as an indication of source for products originating from that region. If manufacturers would adopt the use of an indication of source reflecting the name of the region in the second country for their products in a manner that leads the public to believe mistakenly that these products originated from the region of the other country, this would be misleading and contrary to the Madrid (Indications of Source) Agreement (but not to Article 10 of the Paris Convention, as the indication would not be false).

159 In one respect, the definition in the TRIPS Agreement is broader as it covers geographical indications for products that do not have any particular quality or characteristic, but merely a reputation, attributable to their origin. There are also other differences. For the purposes of this Interim Report, however, the concepts of "geographical indication" under the TRIPS Agreement and "appellation of origin" under the Lisbon Agreement can be considered synonymous.

"(a) the use of any means in the designation or presentation of a good that indicates or suggests that the good in question originates in a geographical area other than the true place of origin in a manner which misleads the public as to the geographical origin of the good;

(b) any use which constitutes an act of unfair competition within the meaning of Article 10*bis* of the Paris Convention."

204. Article 22 of the TRIPS Agreement also foresees that Member States shall refuse or invalidate the registration of a trademark containing or consisting of a geographical indication, if such trademark would mislead the public as to the true origin of the goods covered by it.

205. Article 23 of the TRIPS Agreement offers additional protection for a special category of geographical indications, namely those for wines and spirits, which are deemed, by certain member States of the World Trade Organization (WTO), to be among the most economically and culturally significant. The protection for wines and spirits is broader as the use of a geographical indication for these products is to be prevented when the products do not originate in the place indicated by the geographical indication, even in circumstances where this might not mislead the public or constitute an act of unfair competition. This prohibition applies notwithstanding the fact that the true origin of the goods is indicated or the geographical indication is used in translation or accompanied by expressions such as 'kind', 'type', 'style', 'limitation', or the like. In effect, this Article foresees a level of protection similar to that which can be obtained through an international registration under the Lisbon Agreement, but is limited to wines and spirits, and does not require an international registration.[160]

206. The negotiations between the TRIPS member States that culminated in the adoption of Section 3 of the Agreement were difficult. In large part, this was caused by the fact that some geographical indications which are recognized and protected as such in certain countries of the world are not protected and are freely available for use in other countries. The aim of the first group of countries was to render illegal, as far as possible, the use in the second group of countries of terms that were protected as geographical indications in the first group. The goal of the second group was to safeguard, as far as possible, what they considered to be their "acquired rights" in relation to these terms. A delicate balance was struck between these conflicting points of view by, on the one hand, adopting a robust system for the protection of geographical indications in Articles 22 and 23, but, on the other, carving out a number of important exceptions to this protection in Article 24. Essentially, these exceptions permit, under certain circumstances, that terms customary in the common language of a country for

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[160] While the TRIPS Agreement does not foresee any registration system as a condition for obtaining protection, it does provide in Article 23 that negotiations are to be undertaken "concerning the establishment of a multilateral system of notification and registration of geographical indications for wines eligible for protection in those Members participating in the system." Discussions on this issue currently are ongoing with the WTO.

certain goods or services, trademarks which had been used in good faith prior to the TRIPS Agreement and personal names, if they are not misleading, can continue to be used as such, even though they might correspond to geographical indications protected in certain member States. Finally, Article 24 required the WTO member States "to enter into negotiations aimed at increasing the protection of individual geographical indications under Article 23."

The Desirability of Protecting Geographical Indications and Indications of Source in the Open gTLDs

207. In response to WIPO2 RFC-1 and RFC-2, numerous comments were received on the desirability of instating protection for geographical indications and indications of source in the open gTLDs. A review of the comments reveals, however, that there is no unanimity on the question. Certain commentators are in favor of protecting geographical indications and indications of source in the open gTLDs,[161] while others, including some representing intellectual property interests,[162] either oppose such a course of action, or, at best, consider it premature.[163] Many commentators fail to make the distinction between, on the one hand, geographical indications and indications of source and, on the other hand, geographical terms.

208. In assessing the weight to be given to the comments submitted, it is appropriate to consider in particular those that have been submitted by persons or entities whose interests, or whose interests they represent, are most affected by the issue concerned. Comments received from the *Office International de la Vigne et du Vin (*OIV), an international intergovernmental organization, and from the *Institut National des Appellations d'Origine* (INAO), a national governmental organization in France charged with the protection of appellations of origin and geographical indications for French food and agricultural products, fall into this category.

209. The OIV is an intergovernmental organization with a scientific and technical character, competent in the field of the vine and its derived products. It was created by the International Agreement for the Creation of the Office International du Vin of November 29, 1924. The organization has 45 Member States which, together, represent 85% of the world's vine planting areas and 95% of the world's wine production and consumption.[164] Already within

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161 See Comment of Government of Australia (RFC-2 – January 23, 2001); Comment of Government of The Netherlands, Ministry of Transport, Public Works and Water Management (RFC-2 – December 20, 2000); Comment of State Agency on Industrial Property Protection of the Republic of Moldova (RFC-2 - December 29, 2000); Comment of *Associación Interamericana de la Propiedad Industrial* (ASIPI) (RFC-2 - December 26, 2000); Comment of Brazilian Association of Intellectual Property (ABPI) (RFC-2 - December 28, 2000); Comment of Association of European Trade Mark Owners (MARQUES) (RFC-2 - December 22, 2000); Comment of ES-NIC (RFC-2 - December 29, 2000); Comment of Sarah Deutsch, Verizon (RFC-2 December 26, 2000).

162 See Comment of *Fédération Internationale des Conseils en Propriété Industrielle* (FICPI) (RFC-2 -December 29, 2000).

163 See Comment of Tim Heffley, Z-Drive Computer Service (RFC-2 - December 19, 2000); Comment of Christa Worley (RFC-2 December 19, 2000); Comment of Alexander Svenssen (RFC-2 December 21, 2000).

164 More information on the Office International de la Vigne et du Vin (OIV) is available at *www.oiv.org*.

the framework of the first WIPO Process, the OIV had protested against the "appropriation and the reservation for private purposes of names that benefit from intellectual property protection" and demanded "a level of protection for geographical indications that is equal to that available for trademarks."[165] The OIV has reiterated its position in the Second WIPO Process and draws attention to a Resolution adopted by its Member States concerning the use of geographical indications on the Internet. This resolution, in its pertinent part, reads as follows:

> "… a very large number of Internet domain names consist of geographical indications of recognized traditional denominations that are regulated by the member States of the OIV and have been communicated to the OIV by them…
>
> … among these domain names, there are a number which are particularly confusing for Internet users and constitute commercial piracy or a misappropriation of notoriety… certain registrations are offered for sale to the highest bidder or are linked to inactive sites, evidencing bad faith…"

210. In addition to this Resolution, the OIV has submitted a study conducted by the *Fédération des Syndicats de Producteurs de Châteauneuf du Pape* (the Federation of Producers Associations of Châteauneuf de Pape) covering numerous domain names corresponding to claimed geographical indications. According to the OIV, this study establishes that "a large number of domain names have been registered which correspond to appellations of origin and geographical indications of wine-derived growing products, as well as wine varieties, without there being any relationship between the domain name registrants and the persons who hold rights in these distinctive signs."[166] A representative selection of domain names covered by this study, together with relevant registration data concerning these registrations, has been reproduced in Annex VI[167]. Similar examples of claimed appellations of origin that have been registered as domain names have been presented by the INAO (see Annex VII).[168]

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165 See Comment of Office International de la Vigne et du Vin (OIV) (WIPO1 -RFC-3 - April 30, 1999).

166 "*Une étude menée en 1999 a constaté le dépôt d'un grand nombre de noms de domaine (.com) qui correspondent aux noms d'appellations d'origines et d'indications géographiques de produits vitivinicoles et de noms de cépages sans que les dépositaires aient un lien quelconque avec les titulaires réels des droits liés à ces signes distinctifs*." in Comment of Office International de la Vigne et du Vin (OIV) (RFC-1 - August 14, 2000).

167 As the study was conducted in 1999, and as registration data often change, all information regarding domain name holder as well as the web site's activity have been checked as at January 26, 2001, as reflected in the Annex.

168 See Comment of *Institut national des appellations d'origine* (INAO*),* (RFC-2 - January 31, 2001).

211. As a complement to the studies presented by the OIV and INAO, we have performed two similar exercises. The first relates to a number of examples of appellations of origin, including those for products other than wine, that have been registered by the International Bureau of WIPO under the Lisbon Agreement. It is reproduced in Annex VIII. The second relates to a number of examples of other possible geographical indications and is reproduced in Annex IX.

212. The comments received, in particular the studies submitted by the OIV and INAO, reveal the existence of practices concerning the registration of geographical indications as domain names, which are similar, if not identical, to those that were observed in relation to trademarks and service marks, and which ultimately led to the adoption of the UDRP. As described by the OIV and INAO, those practices are the following:

1. The registration of a domain name corresponding to a geographical indication primarily for the purpose of selling, renting or otherwise transferring the domain name to a third party at a premium.[169]

2. The use of a domain name corresponding to a geographical indication in connection with a product which does not benefit from the geographical indication, thereby creating a likelihood of confusion as to the quality, other characteristics or reputation of the product.

3. The use of a domain name corresponding to a geographical indication with a view to attracting Internet users to a website or other on-line location, the contents of which bears no relationship with the geographical indication.[170]

4. The registration of a domain name corresponding to a claimed geographical indication with a view to preventing others from registering the same name.[171]

213. In light of these practices and their strong resemblance to those that have been observed previously in relation to trademarks and service marks, and taking into account the need to safeguard the interests of the legitimate users of geographical indications and indications of source in the DNS, as well as the interests of consumers, the adoption of measures aimed at protecting these indications in the open gTLDs is considered appropriate at this stage. The form that such protection should take is discussed in the following sections of this Interim Report.

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169 See Annex VII, INAO: *fitou.com*.

170 See Annex VII, INAO: *bourgueil.com, corton.com, gigondas.com, vacqueyras.com;* Annex VI Châteauneuf du Pape: *bade.com*, *barsac.com, rhodes.net*; Annex VIII Lisbon: *champagne.org*, *chinon.org*, *frascati.com*.

171 See Annex VI, OIV: *bourgogne.com, eiswein.com, lambrusco.com, medoc.com*; Annex VIII Lisbon: *armagnac.com, hoyo-de-monterrey.com, tequila.com.*

214. It is recommended that measures be adopted to protect geographical indications and indications of source in the open gTLDs.

The Use of Exclusions to Protect Geographical Indications and Indications of Source In The Open gTLDs

215. WIPO2 RFC-2 asked whether the establishment of exclusions for geographical indications and indications of source would be an appropriate means of ensuring their protection in the open gTLDs. The exclusion mechanism would require the establishment of a list of geographical indications and indications of source that were to be excluded from registration as domain names in the open gTLDs. The use of such a mechanism for geographical indications and indications of source was supported by some commentators.[172]

216. *Advantages of an exclusion mechanism*. An exclusion mechanism for geographical indications of source would offer a number of advantages. First, it is a measure that is essentially dispute-preventive in nature, as any geographical indication or indication of source that is excluded from registration would no longer possibly be the subject of a dispute. Second, from the point of view of the registration authorities, the exclusions would be relatively simple to implement, requiring only an automated cross check at the stage of the application for the domain name against an authoritative list of excluded geographical indications and indications of source. Any domain name applied for which would be found to appear on this list would automatically be rejected from registration.

217. *Difficulties associated with an exclusion mechanism.* Notwithstanding these advantages, an exclusion mechanism for geographical indications and indications of source also presents several fundamental conceptual, as well as practical, difficulties.

218. In the first place, a definitive list of geographical indications and indications of source that merit protection does not exist. Up until now, the establishment of any such list on a generally accepted basis on the international level has proven controversial.

219. An exclusion mechanism involves the risk of extending the protection of rights beyond that which is available under existing law. This risk arises because an exclusion operates absolutely and without regard to (a) the circumstances and manner in which the terms that it covers might be used (for example, in good faith, or in bad faith, or in a commercial context or a non-commercial context), and (b) the jurisdiction in which they are used (because of the territorial nature of the intellectual property system, use might be lawful in some jurisdictions, but not in others). As a safeguard against this risk of over-extension of rights, the Report of the first Process limited the application of the proposed exclusion mechanism for famous and well-known marks to those that are famous or well-known across a widespread geographical

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172 See Comment of the Services of the European Commission (RFC-2 - January 16, 2001); Comment of Government of The Netherlands, Ministry of Transport, Public Works and Water Management (RFC-2 - December 20, 2000); Comment of Associación Interamericana de la Propiedad Industrial (ASIPI) (RFC-2 – December 26, 2000); Comment of ES-NIC (RFC-2 - December 29, 2000).

area and across different classes of goods and services. As noted above, however, one of the acute sensitivities in international discussions concerning the protection of geographical indications and indications of source is differences in perception between the country of origin of geographical indications and other countries where the indications may be considered to be generic or, at least, less worthy of strong protection. Several commentators expressed this concern.[173]

220. An exclusion mechanism would be effective for geographical indications and indications of source in the new open gTLDs in which no registrations have yet been made. Unless applied retroactively to the currently existing open gTLDs (which would be difficult to achieve), any difficulties experienced with geographical indications and indications of source in those gTLDs would need to be resolved through other means.

221. A further limitation of an exclusion mechanism for geographical indications and indications of source is that it would offer protection only against the registration of a domain name that is identical to a geographical indication or indication of source. It would not offer any protection against any phonetic or spelling variations, although infringements often are in the form of such variations.

222. It is considered that the difficulties associated with the introduction of an exclusion mechanism for geographical indications and indications of source outweigh any advantages of such a mechanism and it is not recommended that exclusions be introduced.

223. It is not recommended that an exclusion mechanism for geographical indications and indications of source be introduced.

The Possible Modification of the UDRP

224. An alternative approach to securing an appropriate level of protection of geographical indications and indications of source in the open gTLDs could consist of broadening the scope of the UDRP for it to cover not only complaints brought on the basis of trademarks or service marks, but also on the basis of geographical indications and indications of source.

225. *Advantages of approach.* Broadening the scope of the URDP to cover also geographical indications and indications of source would have the following advantages compared to the introduction of an entirely new protection scheme, such as an exclusion mechanism:

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173 Comment of American Intellectual Property Law Association (AIPLA) (RFC-2 - December 29, 2000); Comment of International Trademark Association (INTA) (RFC-2 - January 4, 2001); Comment of European Brands Association (AIM) (RFC-2 - December 20, 2000).

(i) The scope of the UDRP is restricted to cases of manifest bad faith abuse. As such, the UDRP is directed at situations in which the domain name holder has no right or legitimate interest in the domain name. By focusing on clear-cut cases of abuse, the UDRP avoids the need to address, in the context of a global procedure, issues on which positions vary from one jurisdiction to another. A similar focus on clear cases of abuse would seem particularly appropriate in the context of geographical indications and indications of source, an area of the law in which there is considerable divergence of views on which terms are to be protected as intellectual property and which not.[174] Several commentators who are in favor of the protection of geographical indications and indications of source highlighted the desirability of such a focus on curbing abusive registration practices affecting such indications.[175]

(ii) Extensive experience has been gained under the UDRP as the system has been in operation since December 1999 and a total of more than 3000 cases have been filed under it. The UDRP has proven itself to be an effective system for eradicating bad faith cybersquatting in respect of trademarks.

(iii) Protecting geographical indications and indications of source through an already operational system would yield many efficiencies, in particular because the various entities and persons involved in the administration of the UDRP (i.e., ICANN, registration authorities, dispute resolution service providers and parties) are now thoroughly familiar with all aspects of the procedure.

(iv) Broadening the scope of the UDRP to geographical indications and indications of source would be neutral from the point of view of the registration authorities, as they would be required only to take the same actions that are currently required from them under the UDRP, but in relation to a new category of complaints based on geographical indications and indications of source.

(v) Geographical indications and indications of source that are protected in certain jurisdictions as collective or certification marks already qualify for protection under the current version of the UDRP.[176] However, geographical indications and indications of source which are protected by other means in other jurisdictions do not fall within the current scope of the UDRP (because they are not necessarily regarded as trademarks in the country of origin). This creates an imbalance in the UDRP's operation to the detriment of the latter jurisdictions, without apparent

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174 See above.

175 Comment of Swiss Federal Institute of Intellectual Property (RFC-2 - January 4, 2001); Comment of American Intellectual Property Law Association (AIPLA) (RFC-2 - December 29, 2000); Comment of Association of European Trade Mark Owners (MARQUES) (RFC2 - December 22, 2000); Comment of British Telecommunications plc (RFC-2 - December 28, 2000).

176 See WIPO Case No. D2000-0629 (*parmaham.com)*, available at *http://arbiter.wipo.int/domains/decisions/html/2000/d2000-0629.html*.

justification. This imbalance would be rectified by broadening the scope of the UDRP to cover also geographical indications and indications of source that are protected in law by means other than trademarks.

(vi) Protecting geographical indications and indications of source in the open gTLDs through the UDRP would permit action in respect of abusive registrations that have already occurred in the existing open gTLDs, as well as those that might occur in the newly announced gTLDs.[177]

226. In light of the above considerations, it is considered that the extension of the UDRP to deal with abusive registration of geographical indications and indications of source as domain names is an attractive alternative.

227. It is recommended that the scope of the UDRP be broadened to cover abusive registrations of geographical indications and indications of source as domain names in all open gTLDs.

228. *Required Adjustments to the UDRP*. Broadening the scope of the UDRP to cover geographical indications and indications of source would require the adjustment of a number of aspects of the procedure. The most important questions that arise in this connection concern: (i) the definition of "cybersquatting" embodied in paragraph 4 of the ICANN Policy; (ii) the persons or entities who have standing to file a complaint; and (iii) the remedies available under the procedure. As these questions are inter-related, they are dealt with together in the following paragraphs of this Interim Report.

229. The definition of cybersquatting embodied in paragraph 4 of the ICANN Policy reflects a careful balance between the interests of intellectual property owners and those of the general public in domain names. This balance was achieved after broad and thorough international consultation conducted through the first WIPO Process and ICANN's own review mechanisms. Following the entry into effect of the UDRP in December 1999, hundreds of decisions have been issued by panels further interpreting the precise meaning of this definition. Taking into account its legislative history and the growing body of case law surrounding it, any protection of geographical indications and indications of source under the UDRP must take this definition as a starting point and must endeavor to strike the same balance of interests reflected in it. To allow for such protection, the three-pronged test of subparagraph 4(a) of the ICANN Policy ("Applicable Disputes"), would need to be broadened to cover also geographical indications and indications of source. In addition, subparagraph 4(b) and (c) which contain the illustrative lists of circumstances evidencing registration and use in bad faith and circumstances demonstrating rights or legitimate interests to the domain name would also need to be adjusted.

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[177] The application of a new version of the UDRP to all registrations in the currently existing gTLDs assumes, of course, that any changes in the UDRP can be made contractually enforceable in relation to domain names that have been registered prior to the entry into effect of these changes.

230. As geographical indications and indications of source, save in exceptional cases,[178] do not designate individualized goods produced by specific manufacturers, normally no single person or entity has exclusive use of a geographical indication or an indication of source (although it is possible that the indication is technically registered in the name of a particular entity). This has important consequences in relation to the question of standing to file a complaint under the UDRP. If a complaint is based on a trademark, it is obvious that the trademark holder has standing. However, when a dispute involves a geographical indication or an indication of source, it is more difficult to identify who should be allowed to file and pursue a complaint, as multiple parties are entitled to benefit from the use of the indication.

231. The question of standing cannot be considered in isolation from the remedies that are available under the UDRP. Two such remedies are currently foreseen; the cancellation or the transfer of the domain name registration. In the vast majority of cases, complainants seek a transfer rather than a cancellation. This is due to the fact that a cancelled domain name becomes available for re-registration (potentially by the same respondent). A transfer offers a much more secure result from the point of view of a complainant, as it ensures control over the domain name indefinitely (provided the registration is renewed). However, in the context of geographical indications and indications of origin, a transfer of a domain name may be problematic, depending on the person or entity who filed the complaint. As geographical indications and indications of source are intended to be used non-exclusively by a plurality of persons and entities, it would not be appropriate to allow the UDRP to develop into a means for users to arrogate to themselves the exclusive use of domain names corresponding to geographical indications or indications of source.

232. The questions of standing and remedies are further complicated by the fact that the laws governing geographical indications and indications of source are less evenly harmonized throughout the world. Depending on the applicable legal provisions of the country in question, any number of persons or entities may have standing to bring legal or administrative enforcement actions in relation to geographical indications and indications of source. These may include public sector organizations (for example, ministries, governmental agencies specifically charged with the protection of geographical indications or criminal authorities), as well as private parties (for example, trade associations, competitors or consumers). The solutions that may be devised for purposes of the UDRP must therefore be sufficiently flexible and take due account of these differing national approaches.

233. In light of the above complications, this Interim Report proposes, for further reflection and comment, a number of options on the question of who should have standing to file a complaint under the UDRP based on the alleged abusive registration of a geographical indication or indication of source. The main options appear to be the following:

(i) *The persons or entities who have standing to file a complaint under the UDRP based on the alleged abusive registration of a domain name corresponding to a geographical indication or an indication of source is to be determined in accordance with the law of the country of origin of the geographical indication or*

[178] For instance, for mineral water where only one producer controls the source.

indication of source. In other words, anyone who has standing under the laws of the country of origin to bring an enforcement action (irrespective of the legal basis for this action, be it a regulation specifically aimed at the protection of geographical indications or indications of source, trademark law, the law of unfair competition or consumer protection laws) also should have standing before the UDRP. The advantage of this approach is its flexibility and its recognition of the differing treatment of the issue at the national level. Its disadvantage lies in the possible unfairness of determining standing by reference to the law of the country of the complainant when the complaint may relate to a domain name that has been registered in an entirely different country and be associated with a website whose target audience in no way concerns the country of the complainant.

(ii) *Only the Government of the country of origin has standing to file a complaint under the UDRP based on the alleged abusive registration of a domain name corresponding to a geographical indication or an indication of source.* The advantage of this approach would be that a Government which has succeeded in obtaining the transfer of a domain name corresponding to a geographical indication or an indication of source through the UDRP might be expected to dispose of it in compliance with its own laws (for example, by further transferring it to the entitled entity or association within its jurisdiction). This approach also reflects the tradition in certain countries to grant to governmental agencies the power to enforce geographical indications and indications of source. The disadvantage would be the unfairness again associated with possibly ignoring the circumstances of the place of registration and use of a domain name and its associated Internet presence in determining who should have standing. In addition, the approach assumes that governments might be prepared to accept the jurisdiction of the largely privately-administered UDRP.

(iii) *Standing could be determined on the basis of the law designated applicable to this question by the panel, in accordance with the ordinary rules of private international law. In other words, it would be for a complainant to assert standing and for the panel to determine whether that assertion was correct according to the law which the panel decides, in the light of all the circumstances of the dispute, to be applicable to this issue.* This approach would have the advantage of fairness and the application of existing rules. Its disadvantage would lie in the uncertainty that potential complainants would face in deciding whether to assert standing in a particular dispute.

234. Further comments are sought on who should have standing under the UDRP to file a complaint based on the alleged abusive registration of geographical indications and indications of source as domain names, assuming that it is decided to broaden the scope of the UDRP to extend to such complaints.

The Protection of Geographical Indications and Indications of Source in the ccTLDs

235. As explained above, certain countries of the world have a strong tradition concerning the recognition and protection of geographical indications and indications of source. It would therefore appear particularly appropriate for the administrators of the ccTLDs of these countries to consider measures for the protection of geographical indications and indications of source within their domains.[179] These measures could find their origin in the recommendations formulated in the preceding sections of this Interim Report, with the understanding that certain adjustments may be necessary to reflect local law and practices.

GEOGRAPHICAL DESIGNATIONS BEYOND INTELLECTUAL PROPERTY

236. The preceding section of this Chapter discussed the protection, in the context of the DNS, of those geographical designations that have been traditionally recognized by the intellectual property system, namely, geographical indications and indications of source. The present section deals with geographical terms outside the traditional intellectual property system, particularly place names (for example, the names of cities or regions within a country), geopolitical terms (for example, country names), and geo-ethnic concepts (for example, peoples' names). While these terms involve issues beyond classical intellectual property, a number of factors suggest that a discussion of them is appropriate.

237. The first factor is the widespread practice of registering domain names corresponding to geographical terms in the gTLDs and ccTLDs by registrants who appear not to have any connection, or only a loose connection, with the geographical region, locality or concept denoted by the domain name. The second factor is the impending entry into operation of the new gTLDs, raising the question whether the registration practices affecting geographical terms currently observed in the existing gTLDs should be allowed to continue in the new gTLDs. The third element is the fact that certain countries and peoples which, until quite recently, have only been tangentially involved in the elaboration of policy for the Internet, in general, and the DNS, in particular, are now rapidly becoming more fully engaged in the debate, as a result of the growing use of the Internet in the regions concerned and the consequent "internationalization" of the medium.[180] The fourth factor, which is in part a reflection of the second, are the discussions currently held in various policy fora at the national and international level, including ICANN's Governmental Advisory Committee (GAC), regarding the role of geographical terms in the DNS. In its Opinion of

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179 See Comment of Government of The Netherlands, Ministry of Transport, Public Works and Water Management (RFC-2 - December 20, 2000); Comment of United States Council for International Business (RFC-2 - December 29, 2000), Comment of Brazilian Association of Intellectual Property (ABPI) (RFC-2 - December 28, 2000); Comment of Asociación Interamericana de la Propiedad Industrial (ASIPI) (RFC-2 - December 26, 2000) ; Comment of Ian Kaufman (RFC-2 - December 20, 2000).

180 An example of this "internationalization" of the DNS and the controversies that it may generate is the recent development of systems permitting the registration of domain names in foreign non-ASCII script (for example, Arabic, Chinese, Japanese, Korean and Russian).

November 16, 2000, the GAC reported that it had "discussed geographical, geopolitical, and ethnic concepts in relation to new gTLDs" and that "[t]hese discussions will continue in subsequent meetings of the GAC."[181]

238. This section of the Chapter includes illustrations of registrations of geographical terms that can be observed in the currently existing open gTLDs, and of disputes that have arisen regarding such registrations. Following these illustrations, some general considerations on the subject matter are proposed, on the basis of which a number of recommendations are then formulated in the areas that have emerged as being of immediate concern.

Examples of the Registration of Geographical Terms as Domain Names

239. The illustrations proposed in this section of the Chapter are grouped under four categories reflecting names of (1) countries, (2) ISO 3166 country code elements, (3) places within countries, and (4) indigenous peoples. It is recognized that these illustrations are not exhaustive. It is emphasized that these illustrations are not presented to advocate the position that the registrations at issue are abusive or, more generally, that there exists a wide and pervasive practice of abusing geographical terms in the DNS. The goal is merely to facilitate the debate on how to deal with geographical terms in the new gTLDs by providing some background material and concrete examples of domain registrations incorporating such terms in the currently existing gTLDs.

240. *Country Names*. There exists an official linguistic publication of the United Nations providing a list of the names of its member States.[182] The entry for each State includes its usual or "short" name (for example, "Rwanda") as well as its full or formal name (for example, "the Rwandese Republic"). The usual name is used for all ordinary purposes in the United Nations. The full name, which may be the same, is used in formal documents such as treaties and formal communications.

241. Annex X contains a selection of the usual names of a number of countries and details of corresponding domain name registrations existing in some of the gTLDs, as well as the registrants, the country in which the registrants are located, and the type of activity that is conducted under the domain name.

242. The results in Annex X suggest the following observations:

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181 See paragraph 3.5 of the Opinion of the ICANN-GAC of November 16, 2000, available at *http://www.noie.gov.au/projects/international/DNS/gac/index.htm#Publications*. For an example of the same discussion at the national level, see Section 4.2 of Review of Policies in .AU Second Level Domains, Public Consultation Report, auDA Name Policy Advisory Panel (November 2000), available at *http://www.auda.org.au/panel/name/papers/publicreport.html*.

182 Terminology Bulletin No. 347/Rev.1, States Members of the United Nations, Members of the Specialized Agencies or Parties to the Statute of the International Court of Justice, ST/CS/SER.F/347/Rev.1.

(i) The overall majority of country names in Annex X have been registered by persons or entities that are residing or located in a country that is different from the country whose name is the subject of registration.

(ii) In almost all cases in Annex X, the registrant is a private person or entity. Only rarely is it a public body or an entity officially recognized by the Government of the country whose name has been registered.

(iii) The following activities are conducted under the domain names in Annex X:

a. No activity (DNS lookup error, under construction, ...);
b. The offering for sale of the domain name in question;
c. The provision of information, products or services that bear no or little relationship with the country in question; and
d. The provision of information regarding the country in question, often on a commercial basis.

243. There are relatively few reports of court decisions or decisions emanating from alternative dispute resolution procedures concerning disputes over the registration of country names as domain names. A complaint regarding the domain name *caymanislands.com* has been filed by the Cayman Islands Government before the WIPO Arbitration and Mediation Center under the UDRP, but the case was terminated before a decision was taken on it.[183] There also have been reports regarding the potential filing of a complaint under the UDRP with the WIPO Center by the Government of South Africa concerning the domain name *southafrica.com*, but to date the case has not been submitted.[184] In a case involving the registration of a country name in a ccTLD, the Landsgericht of Berlin (Germany), by decision of August 10, 2000, has found that the domain name *deutschland.de* infringed the Government of Germany's "right in its name".[185] This last case is currently the subject of an appeal.

244. *ISO 3166 Country Code Elements*. The origin of the codes reflecting country top-level domains is the International Organization for Standardization (ISO). ISO, which was established in 1947 as a non-governmental organization, is a worldwide federation of national standards bodies from 130 countries. Its mission is to promote the development of standardization and related activities in the world with a view to facilitating the international exchange of goods and services, and to developing cooperation in the spheres of intellectual, scientific, technological and economic activity.[186] One of ISO's most famous standards is Part 1 of ISO 3166 concerning codes for the representation of names of countries and their subdivisions. Part 1 of ISO 3166 contains two letter country codes (alpha-2 codes; for example, au) and three-letter country codes (alpha-3 codes, for example, aus). It is on the basis of the alpha-2 codes that the country code top-level domains (ccTLDs) were created by

183 See WIPO Case No. D2000-1664 *caymanislands.com.*

184 See SAPA Domestic News Wire of October 30, 2000, and article in the New York Times on the Web of March 3, 2001.

185 Docket number 16 O 101/00, Computerrecht (CR) 2000, page 700-701.

186 For more information, see *http://www.iso.ch*.

the Internet Authority for Assigned Names and Numbers (IANA) under the leadership of Jon Postel during the late eighties and early nineties.[187] Since the creation of the ccTLDs, registrations in the country domains have proliferated, as the use of the Internet has spread throughout the world. It is expected that the importance of the ccTLDs will continue to grow in the future.

245. A phenomenon concerning ccTLDs that merits attention is the registration at the second level in the gTLDs of the country code elements (for example, *uk.com*). Often these domain names are registered by persons or entities in order to make them available to the public for the registration of names at the third level (for example, *company.uk.com*).[188] The appropriateness of such practices is discussed below.

246. *Names of Places Within Countries*. The list of names of places in the world that may have been registered as domain names is virtually limitless. That being the case, an appropriate starting basis for the analysis must be found. The Convention concerning the Protection of the World Cultural and Natural Heritage is a useful instrument for this purpose. The Convention was adopted on November 23, 1972, under the auspices of the United Nations Educational, Scientific and Cultural Organization (UNESCO) and 161 member States are party to it. Article 11 of the Convention provides for the establishment by the World Heritage Committee of a list of sites forming part of the cultural and natural heritage falling under the scope of the Convention (the "World Heritage List").[189] Featured on the List are a number of cities that are famous for their cultural or historical importance. Annex XI contains details of searches of domain name registrations with respect to some of the cities appearing on the World Heritage List.

247. The following observations can be made with respect to the information contained in Annex XI:

(i) The majority of city names in Annex XI have been registered by persons or entities that are residing or located in a country that is different from the country in which the city whose name is the subject of registration is located.

(ii) In several cases, the domain name is used as the address of a website providing information concerning the city whose name corresponds to the domain name. Often these sites appear to be operated by private entities on a commercial basis.

(iii) In several cases, the domain name is used as the address of a website providing general information (often in the form of a portal) that bears either no, or no significant relationship, to the cities whose names correspond to the domain name.

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187 The list of currently existing ccTLDs is available at *http://www.iana.org/cctld/cctld-whois.htm.*

188 See, for instance, the services of CentralNic offering the possibility of registering names under the following: *br.com, cn.com, eu.com, gb.com, gb.net, hu.com, no.com, qc.com, ru.com, sa.com, se.com, se.net, uk.com, uk.net, us.com, uy.com,* and *za.com.* For more information, see *http:*//www.centralnic.com/.

189 The World Heritage List is available at *http://www.unesco.org/whc/nwhc/pages/doc/mainf3.htm.*

(iv) In one case, the domain name is offered for sale.

(v) In some cases, the domain name is used as the address of a website of a company whose name, or whose trademarks or service marks, correspond to the domain name.

248. A number of cases concerning the registration of cities or regions within countries have been reported in several European courts. In France, the Tribunal de Grande Instance of Draguignan, in its decision of August 21, 1997, found that the registration of the domain name *saint-tropez.com* constituted an infringement of the rights of the Commune of Saint-Tropez, the well-known beach resort located in the south of France.[190] In its decision of March 8, 1996, the Landgericht of Munich (Germany) found that the registration of the domain name *heidelberg.de* constituted an infringement of the rights of the City of Heidelberg. Subsequent to this decision, several court cases have been filed in Germany regarding German city names. Most of the cases in question were decided in favor of the cities.[191] By decision of May 2, 2000, the Federal Court of Switzerland upheld a complaint filed by a semi-official tourist organization regarding the registration of the domain name *berner-oberland.ch,* a region of Switzerland with a reputation for its picturesque landscapes. By decision of May 23, 2000, the Obergericht Luzern upheld a decision of a lower court ordering the holder of the domain name *luzern.ch* to refrain from offering e-mail services under this name, pending resolution of a complaint brought by the City of Lucerne seeking the transfer to it of that domain name by the registrant.

249. Several cases regarding place names within countries also have been filed with the WIPO Center under the UDRP.[192] Two of these cases that involved city names have received much attention. These two cases concerned the domain names *barcelona.com* and *stmoritz.com*. By decision of August 4, 2000, the complaint regarding *barcelona.com* was granted and, by decision of August 17, 2000, the complaint regarding *stmoritz.com* was denied.[193] Other more recent such cases filed with WIPO concerned the domain names

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190 See *http://www.legalis.net/jnet/decisions/marques/tgi_sttropez.htm.*

191 Next to heidelberg.de, these cases concerned the following cities: *kerpen.de, pullheim.de, celle.de, herzogenrath.de, bad-wildbad.com*. They are all available at *http://www.bettinger.de/datenbank/domains_ge.html*.

192 See, for instance, WIPO Case No. D2000-0064 (*1800rockport.com*); WIPO Case No. D2000-0505 (*barcelona.com*); WIPO Case No. D2000-0617 (*stmoritz.com*); WIPO Case No. D2000-0629 (*parmaham.com*; WIPO Case No. D2000-0638 (*manchesterairport.com*); D2000-0699 (*paris-lasvegas.comi*; WIPO Case No. D2000-1017 (*xuntadegalicia.net/xuntadegalicia.org*); WIPO Case No. D2000-1218 (*wembleystadiumonline.com*); WIPO Case No. D2000-1224 (*sydneyoperahouse.net*); WIPO Case No. D2000-1377 (*axachinaregion.com*); WIPO Case No. D2000-1435 (*capeharbour.com/capeharbor.com*); WIPO Case No. D2000-01617 (*chiquipark.com*). These cases are available at *http://arbiter.wipo.int/domains/decisions/index-gtld.html*.

193 See WIPO Case No. D2000-0505, available at *http://arbiter.wipo.int/domains/decisions/html/2000/d2000-0505.html* and WIPO Case No. D2000-0617, available at *http://arbiter.wipo.int/domains/decisions/html/d2000-0617.html*.

portofhelsinki.com and *portofhamina.com*. The complaints in the latter two cases also were denied, respectively by decisions of February 12 and March 12, 2001.[194]

250. It should be noted that the complaints in many of the court and UDRP cases referred to above were based on the alleged abuse of a trademark registered in the name of the complainant and incorporating the place name subject to the dispute. Furthermore, usually the domain names were deemed infringing in light of the nature of the activity conducted under the domain name and the motivation of the registrants. The cases therefore do not necessarily stand for the proposition that the registration of a city name or the name of a region, as such, is to be deemed abusive.

251. Finally in connection with place names, it may also be noted that several ccTLD administrators have adopted the policy of excluding the names of places in their countries from registration as domain names, at least under certain conditions. This is the case, for instance, for .AU (Australia),[195] .CA (Canada),[196] .CH (Switzerland), .DZ (Algeria),[197] .ES (Spain),[198] .FR (France),[199] .PE (Peru),[200] and .SE (Sweden).[201] Often these exclusions are based on official lists of place names compiled by the Government of the country concerned.[202]

252. *Names of Indigenous Peoples*. The question of the protection of the intellectual property rights of the world's indigenous peoples has received increasing attention over the last several years.[203] While global trade in the creations and knowledge of indigenous peoples

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194 See WIPO Case No. D2001-0001, available at *http://arbiter.wipo.int/domains/decisions/html/2001/d2001-0001.html* and WIPO Case No. D2001-0002, available at *http://arbiter.wipo.int/domains/decisions/html/2001/d2001-0002.html*.

195 The policy of .AU on this question is currently under review. For more information, see Section 4.2 of Review of Policies in .AU Second Level Domains, Public Consultation Report, auDA Name Policy Advisory Panel (November 2000), available at *http://www.auda.org.au/panel/name/papers/publicreport.html*. Until November 15, 2000, .NL also restricted the registration of domain names corresponding to city and province names. Since that date, these restrictions have been removed. However, in its comments on WIPO2 RFC-2, the Dutch Ministry of Transport, Public Works and Water Management stated that it is advisable to protect geographical terms against their bad faith, abusive, misleading or unfair registration and use in the DNS.

196 See .CA registration policy at *http://www.cira.ca/fr/docs_regis.html*.

197 See .DZ registration policy at *http://www.nic.dz/francais/precision.htm*.

198 See .ES registration policy at *http://www.nic.es/normas/index.html*.

199 See .FR registration policy at *http://www.nic.fr/enregistrement/fondamentaux.html*.

200 See .PE registration policy at *http://www.nic.pe/interna/normas.htm*.

201 See .SE registration policy at *http://www.iis.se/regulations.shtml*.

202 For instance, for .AU, this is Australian Surveying and Land Information Group's database of Australian place names.

203 See, for instance, the work conducted since 1982 by the United Nations Commission on Human Rights, its Sub-Commission on Prevention of Discrimination and Protection of Minorities, and the Sub-Commission's Working Group on Indigenous Populations. More particularly in the area of intellectual property, see WIPO's work on traditional knowledge, innovations and creativity, information about which is available at *http://wipo.int/traditionalknowledge/introduction/index.html*.

has yielded important returns for some, it is felt by others that such commercial exploitation has not always been in harmony with the rights or expectations of the peoples concerned. In light of this ongoing policy debate and the GAC's discussions concerning ethnic concepts, it seems appropriate to consider the incidence of the registration of the names of the world's indigenous peoples as domain names. Annex XII sets out details concerning domain name registrations of a number of well-known indigenous peoples which result from an analysis similar to the one described above for country and city names.

253. The following remarks may be made with respect to the information contained in Annex XIII:

(i) Hardly any of the names in Annex XIII have been registered by organizations that are recognized as representing the people denoted by the domain name.

(ii) Except for those domain names corresponding to the names of peoples from the North American region, most domain names in Annex XII have been registered in the names of persons or entities that are residing or located in countries that are different from the countries of the peoples concerned.

(iii) The activities conducted under the domain names in Annex XII only rarely are aimed at providing information about the peoples concerned.

(iv) Most activities that are conducted under the domain names in Annex XII fall under one of the following categories: no activity (DNS lookup error or holding page), general information or portal sites (of widely differing varieties) of a person or entity which does not appear to represent the people, website of company with a (product) name corresponding to the name of the people, and personal website of an individual whose first name corresponds to the name of a people.

(v) In one case in Annex XII, the domain name is offered for sale.

General Considerations Relating to the Protection of Geographical Terms Against Abusive Registration as Domain Names

254. Current registration policies in the open gTLDs allow persons or entities to appropriate for themselves, as domain names, terms with which they otherwise have no, or only a loose, connection, to the exclusion of countries and peoples whose history and culture are deeply and inextricably linked to the terms in question. It should come as no surprise that such registrations are a source of concern for these countries and peoples, particularly if the domain names are exploited commercially or used in a manner that is deemed inappropriate or disrespectful. As the number of gTLDs expand and the value of a registration in any one of them may correspondingly decrease, and it is possible that the problem will become less acute.[204] However, as long as domain names are used as a de facto Internet directory, it is unlikely that the problem will disappear completely, particularly in relation to the more visible and popular TLDs.

255. Several commentators have called for the protection in the context of the DNS of some or all of the geographical terms discussed above (i.e., terms that do not enjoy trademark rights and do not qualify as geographical indications or indications of source),[205] while others have opposed such course of action.[206] Next to the question of whether, as a matter of policy, the establishment of such protection in the gTLDs would be appropriate at this stage, it is at least equally important to consider whether it can be grounded on a sound legal basis. Here, it must be recognized that the international intellectual property system, at least in its current state of development, might be hard pressed to offer a solution.

256. While the Paris Convention protects certain State-related symbols against their registration and use as trademarks,[207] it is unclear whether it can be said to offer such protection for the names of countries or the names of places within countries, or any of the other concepts described in the preceding paragraphs. There are two possible interpretations of the Convention in this connection, particularly with regard to its application to the names of countries. The first consists of a more conservative interpretation of the text of Article 6*ter* and its negotiating history. The other approach consists of a broader interpretation of the same Article and its history, pointing out that the text of Article 6*ter* was written in the early 20th century when domain names were unknown, and taking more into account its spirit and recent technological evolutions.

257. *Strict interpretation of the Paris Convention*. The conservative interpretation of the Article focuses, on the one hand, on a textual comparison between subparagraphs 1(a) and

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204 Comment of European Brands Association (AIM) (RFC-2 - December 20, 2000).

205 Comment of the Government of the Netherlands, Ministry of Transport, Public Works and Water Management (RFC-2 - December 20, 2000); Comment of the Services of the European Commission (RFC-2 - January 16, 2001); Comment of the Government of the Republic of South Africa (RFC-2 - March 2, 2001).

206 See Comment of Tim Heffley, Z-Drive Computer Service (RFC-2 - December 19, 2000); Comment of Alexander Svenssen (RFC-2 - December 21, 2000) ; Comment of Christa Worley (RFC-2 – December 29, 2000).

207 See also the discussion of Article 6*ter* in the proceeding chapters of this Interim Report.

1(b) of Article 6*ter* and, on the other hand, the preparatory work for and negotiating history of the Geneva Diplomatic Conference on the Revision of the Paris Convention.

258. Subparagraph 1(a) of Article 6*ter* reads as follows: "The countries of the Union agree to refuse or invalidate the registration, and to prohibit by appropriate measures the use, without authorization by the competent authorities, either as trademarks or as elements of trademarks, of armorial bearings, flags, and other State emblems, of the countries of the Union, official signs and hallmarks indicating control and warranty adopted by them, and any imitation from a heraldic point of view."

259. Subparagraph 1(b) of Article 6*ter* reads as follows: "The provisions of subparagraph (a), above, shall apply equally to armorial bearings, flags, other emblems, abbreviations, *and names*, of international intergovernmental organizations of which one or more countries of the Union are members... ."

260. The fact that subparagraph 1(b) refers explicitly to names of international intergovernmental organizations, while subparagraph 1(a) does not refer to names of countries arguably supports the view that there is no legal basis for the exclusion of country names as domain names (*expressio unius exclusio alterius*).

261. Furthermore, during the Second Session of the Working Group on Conflicts Between An Appellation of Origin and a Trademark of the Preparatory Intergovernmental Committee on the Revision of the Paris Convention (Geneva, June 18 to 29, 1979), a proposal was made by the Group of Developing Countries to add the "official names" of States to the items to be protected under subparagraph 1(a) of Article 6*ter*.[208] This proposal was reflected in the Basic Proposals for the Diplomatic Conference.[209] At the end of the Third Session of the Diplomatic Conference (October 4 to 30, 1982 and November 23 to 27, 1982), Main Committee I adopted the proposed change:

> "As regards Article 6*ter*, after a full discussion, agreement was reached on October 22, 1982, on the text which is reproduced in Annex I to this report and which extends the protection under Article 6*ter* to official names of States. Main Committee I unanimously adopted this text and transmitted it to the Drafting Committee".[210]

262. However, the Diplomatic Conference did not result in any revision of the Paris Convention and Article 6*ter* therefore remained unchanged.

263. In light of the above, the following observations seem in order:

(i) Considering that the States party to the Paris Convention were of the view that Article 6*ter* would need to be amended to offer protection for the official names of

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208 See WIPO Document PR/WGAO/II/6.

209 See Basic Proposals for the Diplomatic Conference on the Revision of the Paris Convention for the Protection of Industrial Property (Geneva, February 4 to March 4, 1980).

210 See WIPO Document PR/SM/9.

countries, the position that Article 6*ter*, in its current unrevised form, covers country names seems difficult to maintain.

(ii) At the time of the Diplomatic Conference, developing countries only sought to obtain protection under Article 6*ter* for the official names of countries (for example, the Republic of South Africa) and not for their usual names (for example, South Africa). However, this statement must be nuanced in two respects. First, it perhaps would have been possible for countries to notify also their usual names as official names to the International Bureau under the notification procedures foreseen in Article 6*ter*. Second, discussions were held at the Diplomatic Conference on the need to offer protection also for the usual names of countries under a new proposed Article 10*quater*, but only if these names were used in a manner that misleads the public.

264. *Broad interpretation of the Paris Convention.* According to this view, a broader interpretation of Article 6ter is justified, on the one hand, in light of its spirit and underlying objectives, and, on the other hand, in view of recent technological evolutions, in particular the emergence of the Internet as a commercial medium and the importance of domain names as valuable signposts in this context. Under this broader interpretation, Article 6ter provides legal argument for the protection of country names in the DNS, as follows:

(i) The world has evolved since the negotiation of the Paris Convention (including since the Geneva Diplomatic Conference) and account must be taken of this fact for the purposes of properly interpreting Article 6*ter*.

(ii) The fact that Main Committee I adopted the proposed amendment to Article 6ter suggests that there was broad support for the protection of official country names in the context of the Paris Convention. The Diplomatic Conference did not produce a result for reasons unrelated to the proposed revision of Article 6*ter*.

(iii) In light of their uniqueness and function as primary signposts on the Internet, domain names are more appropriately viewed as "emblems" for purposes of Article 6*ter*, rather than regular names.

(iv) Probably names of countries are not referred to as such in Article 6ter because the States party to the Paris Convention did not wish to restrict their use as descriptive elements of trademarks (for example, Agence France-Presse). Country names used as domain names arguably have less of a descriptive function, but are more distinctive, in particular in light of the uniqueness of domain names.

265. In light of the above, it must be recognized that any protection offered in the DNS to geographical terms as such may amount to the creation of new law, at least from the international intellectual property perspective. A recommendation to adopt such measures consequently would be a departure from one of the fundamental principles underlying the Report of the first WIPO Process, namely, the avoidance of the creation of new intellectual

property rights or of enhanced protection of rights in cyberspace compared to the protection that exists in the real world.[211] Furthermore, in considering whether it would be opportune, under these circumstances, to introduce any protective measures for geographical terms and what the nature of those measures might be, account should be taken of a previously highlighted aspect of the problem, namely, that terms which are protected in certain jurisdictions may be freely available in others.[212] Due to this lack of harmonization and the resultant differing treatment of the issues at the national level, any protective measures that may be adopted for the gTLDs and the results that they may produce run a greater risk of being invalidated, if contested at the national level.

266. Notwithstanding these words of caution, it is equally true that, if there are any areas in which the adoption of protective measures would clearly be to the benefit of the overall majority of interested parties, their adoption should be seriously considered, notwithstanding the current absence of applicable international standards.

267. *The "First-Come, First-Served" Principle and the Digital Divide.* Some will argue that in areas where there are no harmonized international rules, the solution should lie in the application of the "first-come, first-served" principle. It is our view, however, that this argument is somewhat facile, at least in relation to the matter under consideration. The principle assumes an equal playing field between potential domain name registrants, in terms of awareness of the Internet and the DNS in particular, and the ability to access it and register domain names. However, it is now currently well accepted that such equal playing field does not exist throughout the world but, rather, that there exists a digital divide between countries. Persons residing in countries where the Internet is broadly known and used throughout all layers of society are therefore in a much more advantageous position in terms of securing their interests in the DNS than those in countries where the Internet has hardly made any penetration. This point of view is underscored by the fact that many of the names of countries whose populations have benefited less from exposure to the Internet appear to have been registered as domain names by parties from countries that are at the forefront of Internet developments.

268. *The Interest of Internet Users*. The consideration of the interest of a country or a people in a term with which it has a strong historical and cultural link is one way to approach the problem of the registration of geographical terms as domain names. Another possible approach is to consider whether the manner in which the term is used as a domain name adds value by permitting users to retrieve more efficiently the information that they are seeking on

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211 See paragraph 34 of the Report of the first WIPO Process where it is stated that "[t]he goal of this WIPO Process is not to create new rights of intellectual property, nor to accord greater protection to intellectual property in cyberspace than that which exists elsewhere. Rather, the goal is to give proper and adequate expression to the existing, multilaterally agreed standards of intellectual property protection in the context of the new, multijurisdictional and vitally important medium of the Internet and the DNS that is responsible for directing traffic on the Internet."

212 Comment of the Government of Australia (RFC-2 - January 2001); Comment of Brazilian Association of Intellectual Property (ABPI) (RFC-2 - December 28, 2000); Comment of Christa Worley (RFC-2 - January 4, 2001).

the Internet. Under this approach, any geographical term that is registered as a domain name in order to function as the address of a website that provides information on the territory or location corresponding to the domain name may be deemed to add value, as users generally rely on domain names as a primary means of accessing information on the Internet. However, if a domain name corresponding to a geographical term does not resolve to any site or to a site which does not contain any meaningful information regarding the territory or region concerned, it may be argued that there is no added value, only a waste of resources and a cause of consumer confusion. Taking into account the use to which the domain name is put and the nature of the gTLD in which it is registered in assessing the appropriateness of the registration of a geographical term may be worthwhile also because such use, or the lack thereof, can be an indicator of the true purpose for which the name was registered (for example, speculative intent) .

269. *The Need for Additional Definitional Rigor*. Finally, the introduction of any protective measures for geographical terms presupposes more rigor in the determination of what precisely is to be protected. The terms used by the GAC ("geographical, geopolitical and ethnic concepts") are a useful starting point for the analysis, but must be more clearly defined if they are to form the basis for any concrete recommendations. In some areas, it will be simple to determine what the exact scope of the protection should be (for example, for the ISO 3166 code elements), but in other areas this will be more complicated (for example, for place names).

270. With these general considerations in mind, the remainder of this Section of the Interim Report is devoted to the formulation of provisional recommendations for discussion regarding the protection of geographical terms in the gTLDs. In view of the relative novelty of the discussion, the complexity of the issues which it involves and the controversies which it inevitably will generate, these recommendations will be restricted to those areas which have emerged in the discussions as being of immediate concern to the new gTLDs: (1) ISO 3166 code elements and (2) names of countries and place names within countries.

The Protection of ISO 3166 Code Elements in the gTLDs

271. As noted above, there has developed a practice of registering the ISO 3166 alpha-2 code elements as domain names at the second level in the gTLDs in order to make them available to the public for the registration of names at the third level (for example, *company.uk.com*). This practice is a source of concern for several reasons:

(i) The practice causes confusion as to whether a name has been registered in a ccTLD or in a gTLD. This is particularly true in those cases where the ccTLDs have created sub-structures for their domains using codes which are reminiscent of certain gTLD codes (for example, in *co.uk*, the code *co* is similar to *com*). An Internet user who is not very familiar with the structure of the DNS will find it hard to distinguish *company.co.uk* from *company.uk.com* and may be confused as to whether the name is registered in a ccTLD rather than a gTLD.

(ii) The administrators of the ccTLDs have no control over the policies and practices that may be adopted by the persons or entities who have registered country codes at the second level in a gTLD and who allow the public to register names at the third level under such codes. Considering that many users will be wrongly led to believe that the latter registrations occurred in a ccTLD, this practice may end up tarnishing the reputation of the ccTLDs in question if the policies and the practices of the persons or entities who control the ISO 3166 codes at the second level in the gTLD do not meet minimum standards.

(iii) The practice of offering to the public the opportunity to register names at the third level under country codes registered at the second level in a gTLD where the UDRP is in force raises questions regarding the application of the UDRP.[213] The current version of the UDRP essentially is aimed at ensuring that names registered at the second level under the gTLDs to which the UDRP applies are not abusive. If they are found to be abusive, the UDRP foresees that the names can be cancelled or transferred to the complaining party. However, if a country code is registered at the second level in one of these gTLDs and names are allowed to be registered under it, the level where the abuse most likely will occur is not only, or necessarily, the second level, but the third level (for example, *famousmark.uk.com* registered by a cybersquatter). This raises questions in terms of the applicability and enforcement of the UDRP. First, while it is clear that the registrant of the country code at the second level is bound to the UDRP (through its registration agreement with an ICANN-accredited registrar), it is not clear whether the registrant of the name at the third level would also be (indirectly) bound to the UDRP (as its agreement is with the registrant of the name at the second level who may not have included a submission to the UDRP as a condition for accepting the registration of the name at the third level). Second, even if it were found that the UDRP indirectly applies to the third level, enforcement issues nonetheless would persist. The UDRP foresees that the ICANN-accredited registrars must cancel or transfer the name registered at the second level in case a violation of the Policy is found to exist. However, numerous names may be registered under the country code at the third level, only some of which might be abusive. Canceling or transferring the registration at the second level (i.e., the country code) might then be a disproportionate measure, because all the names at the third level (as well as those at any lower levels) would be adversely affected, irrespective of whether they were abusive or not.

272. Prudence with regard to the use of ISO 3166 in relation to the new gTLDs has been advocated also in other policy fora. In a letter of December 1, 2000, addressed to Mr. Mike Roberts, former CEO and President of ICANN, Mr. Robert Verrue, Director General of Directorate-General XIII for the Information Society of the European Commission, echoing some of the concerns expressed above, stated that "[n]ew gTLDs

213 The same questions arise irrespective of whether the term registered at the second level is an ISO 3166 alpha-2 code or another term. While the problem therefore is of a general nature affecting all registrations at levels below the second level, it is discussed here in the context of the registration of country codes at the second level.

should not create confusion for internet users and in particular new gTLDs should not be significantly similar to a ccTLD so as to be confusing. Where a gTLD proposes to include an ISO alpha-2 or alpha-3 letter code, it may be appropriate to get agreement from the relevant authority or region for its use. In this case, the corresponding governments and public authorities should also be given an appropriate opportunity to register or assign in advance the registration of ISO alpha-2 and 3 letter country codes as second level domains within the new gTLDs."[214]

273. In light of the above concerns, it is proposed that a mechanism be established for the exclusion of the registration of ISO alpha-2 code elements at the second-level in the new gTLDs. It is believed that such an exclusion mechanism is justified essentially for two reasons. First, it would avoid in the new gTLDs the problems currently encountered in connection with the registration of ccTLD codes in the existing gTLDs. Second, the impact of the exclusion of such codes on the ability of Internet users to register meaningful names in the new gTLDs likely would be minimal, because the codes are not particularly descriptive and they exist only in limited numbers.[215] Of course, as indicated in the letter of Mr. Verrue, once an exclusion is obtained for any given code, the relevant authority or region could nonetheless agree to its use in the new gTLDs, if it considered such use appropriate.

274. With regard to the use of the ISO 3166 code elements in the currently existing gTLDs, we do not express any opinion on the question of whether use should be forbidden retroactively. However, the persons or entities who have registered these codes and accept registrations of names under them should be encouraged to take measures to render the UDRP applicable to these registrations and to ensure the proper and prompt implementation of decisions transferring or canceling the registrations resulting from the UDRP.

275. With regard to the ISO 3166 alpha-2 code elements, it is recommended that:

(i) a mechanism be established to exclude such elements from registration in the new gTLDs, absent an agreement to the contrary from the relevant authorities; and

(ii) the persons or entities in whose name such codes are registered at the second level in the existing gTLDs and who accept registrations of names under them be

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214 A copy of this letter is available at *http://www.icann.org/correspondence/verrue-letter-01dec00.htm*.

215 Although minimal, there will, however, be an impact. For instance, persons or entities who, in order to identify themselves or their products, use a two-letter combination coinciding with a country code would be excluded from registering such combination in the new gTLDs, unless the relevant authorities agree thereto.

encouraged to take measures to render the UDRP applicable to these registrations, as well as to registrations at lower levels, and to ensure the proper and prompt implementation of decisions transferring or canceling these registrations resulting from the UDRP.

The Protection of Names of Countries and Place Names within Countries in The gTLDs

276. *Scope of Protected Subject Matter.* As noted earlier, prior to considering which protective measures might be in order (if any) in relation to this class of geographical terms, it is necessary first to determine with more precision which concepts are intended to benefit from such protection. As far as countries are concerned, no particular difficulties arise as, apart from a few exceptional cases, it is clear which countries exist in the world and what their names are.[216] However, the term "places within countries" is much vaguer and therefore requires further elucidation.

277. As the protection of place names within the gTLDs is a novel concept, it is proposed to take a conservative approach and interpret the term, at least at this stage, narrowly. It is therefore recommended that its scope be restricted to those items that are most closely associated with the territorial integrity of the State, namely regions that have received administrative recognition from the State (for example, provinces, departments…) and municipalities (cities, towns, communes, etc.). This interpretation excludes from consideration other items which also might qualify as "places," such as streets, squares, natural, historical or cultural sites, mountains, rivers, lakes and waterways, buildings and edifices, monuments, and so forth. Limiting protection to administratively recognized regions and municipalities has the added advantage of the existence and the names of such entities usually being well documented within the constitutional and public law frameworks of countries.

278. It is recommended that the consideration of any measures to protect the names of places in the gTLDs, at this stage, should be restricted to the names of:

(i) countries; and
(ii) administratively recognized regions and municipalities within countries.

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216 See, in this respect, United Nations Terminology Bulletin No. 347/Rev.1, States Members of the United Nations, Members of the Specialized Agencies or Parties to the Statute of the International Court of Justice, ST/CS/SER.F/347/Rev.1.

279. *Exclusions not desirable*. WIPO2–RFC2 raises the question of whether the establishment of a system of exclusions would be appropriate with a view to protecting geographical terms in the new gTLDs. Certain commentators are in favor of such exclusions.[217] Having considered all comments submitted, we favor the view that a system of exclusions would not be a desirable means of protecting names of countries and of administratively recognized regions and municipalities in the new gTLDs. Apart from the host of practical problems that such a system would entail, the greatest concern would be that such strong form of protection might be perceived to lack international legitimacy, in light of the absence of a universally accepted right of countries to the exclusive use of the terms in question in the context of the DNS.

280. *Options for further consideration*. For several reasons, we have decided to refrain in this Interim Report from formulating recommendations on the appropriateness of introducing protection for regions and municipalities in the new gTLDs and the form that such protection should take. Our reluctance to proceed further at this stage results from (a) the realization that any recommendations in favor of establishing such protection would be tantamount to proposing the creation of new law (at least from the international intellectual property perspective), (b) our desire at this stage to concentrate on a refinement of the issues and a more precise determination of the scope of the subject matter for discussion and (c) the failure on the part of many commentators to make a clear distinction in their submissions between, on the one hand, geographical indications that are recognized by the intellectual property system and, on the other hand, other geographical terms which, as such, do not benefit from the same recognition. Rather than recommendations, we propose a number of options on how to deal with the issue on which additional comments are sought. These further comments will constitute the basis for recommendations to be included in the Final Report of this Process.

281. *Option 1*. The first option would consist of maintenance of the status quo. In other words, no protective measures in the new gTLDs for the names of countries and of administratively recognized regions and municipalities would be established. Several commentators are in favor of this position, believing that any problems that may exist regarding such terms (if they exist at all) ultimately will be resolved through the addition of more gTLDs and the increased differentiation in the name space which this will bring about.[218]

282. *Option 2*. The second option, which has received backing from several other commentators, would consist of attempting to curb conduct which, despite the lack of any international rules on the matter, nonetheless receives widespread condemnation, namely the abuse of the names in question.[219] We believe this goal possibly could be achieved by

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217 Comment of the Government of the Republic of South Africa (RFC-2 - March 2, 2001).

218 See Comment of *Fédération Internationale des Conseils en Propriété Industrielle* (FICPI) (RFC-2 - December 29, 2000).

219 See, for example, Comment of Swiss Federal Institute of Intellectual Property (RFC-2 - January 4, 2001), which states as follows: “Despite all differences between personal names, INNs, names and acronyms of international intergovernmental organizations, geographical indications resp. terms, tradenames and the legal protection of these signs, there's one thing in common for all categories of distinctive signs: Any abuse of a sign in the scope of the Domain Name System should – as well as in the "real world" – not be tolerated and therefore be prevented resp. removed by appropriate measures. The real problems arise

[Footnote continued on next page]

incorporating into the UDRP, or creating as an adjunct to the UDRP, new grounds for a complaint on the basis of which the competent national authorities could seek to obtain the transfer or cancellation of a domain name corresponding to the name of a country or an administratively recognized region or municipality which is found to be abusive. Such an approach would require a revision of the UDRP, in the form of the incorporation into it of an additional cause of action allowing the national competent authorities to file a complaint in relation to the names concerned. This cause of action could be crafted along the lines of the one currently foreseen in paragraph 4(b) and (c). A draft of such cause of action is proposed below.

283. Possible New UDRP Cause of Action. A possible cause of action permitting competent national authorities to obtain the transfer or cancellation of abusive domain names corresponding to administratively recognized regions or municipalities could be as follows:

> "1. The registration of a domain name shall be considered to be abusive and the competent national authorities shall be entitled to its cancellation or transfer when all of the following conditions are met:
>
> (i) The domain name is identical or confusingly similar to the name of a country or of an administratively recognized region or municipality within a country; and
>
> (ii) The registrant of the domain name has no rights or legitimate interests in respect of the domain name; and
>
> (iii) The domain name has been registered and is used in bad faith.
>
> 2. For the purposes of paragraph (1) (iii), the following, in particular, shall be evidence of the registration and use of a domain name in bad faith:
>
> (a) Circumstances indicating that the registrant has registered or has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant for valuable consideration in excess of its documented out-of-pocket costs directly related to the domain name; or
>
> (b) The registrant has registered the domain name in order to prevent the competent national authority from reflecting the name of the region or municipality in a corresponding domain name, provided the registrant has engaged in a pattern of such conduct; or

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when it comes to define the "abuse" and the "appropriate measures" (including suitable proceedings) to find and remove such an abuse."

(c) The use of the domain name as the address of a website or other on-line location without there being a connection between the information provided on such website or location and the region or municipality corresponding to the domain name; or

(d) The use of the domain name as the address of a website or other on-line location in a manner that creates a likelihood of confusion as to the endorsement by the competent national authority of the information provided on such website or location.

3. For the purposes of paragraph (1) (ii), the following, in particular, shall be evidence of the registrant's rights and legitimate interests in the domain name:

(a) The use of the domain name as the address of a website or other on-line location devoted to the provision of information concerning the region or municipality corresponding to the domain name that does not fall under paragraph 2 (d) above, whether or not such information is provided for financial gain;[220] or

(b) The domain name corresponds to a trademark or service mark of the registrant; or

(c) The registrant (as an individual, business, or other organization) has been commonly known by the domain name; or

(d) The registrant is using the domain name for comment."

284. In the absence of any clear rules at the international level, a constructive approach to the problem of the registration of the names of regions and municipalities might consist of considering how the interests of all stakeholders can best be accommodated, or at least balanced. Three groups with differing interests in the subject matter can be distinguished: the countries whose names are affected by the registrations, the domain name registrants and Internet users in general. It is in the interest of the affected countries to have as much control over the domain names as possible (which includes the power to make them freely available for registration by any person, if this is deemed appropriate). Potential registrants' interests would appear to be best served by keeping to a minimum the restrictions on their ability to register domain names. Finally, the public's interests are best served if the names are used in a manner that facilitates reliable Internet navigation. The proposed cause of action and the accompanying illustrations are intended to strike a reasonable balance between these varying interests.

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220 This Interim Report does not express any opinion on the question of whether or not the sites listed in Annexes X and XI which provide information on countries and cities would satisfy this standard.

285. Further comments are sought on whether:

(a) it would be preferable, at this stage, not to introduce any protective measures in the new gTLDs for names of countries and of administratively recognized regions and municipalities within countries (option 1), or whether it would be desirable to introduce measures aimed at curbing abusive registrations of such names (option 2); and

(b) the cause of action proposed above would constitute a suitable basis for the introduction of protection in the new gTLDs for the names of countries and of administratively recognized regions and municipalities, as an adjunct to the UDRP.

286. *Existing gTLDs and ccTLDs*. To the extent the proposed cause of action meets with acceptance by commentators, we would encourage its consideration also in relation to the existing gTLDs. Furthermore, ccTLD administrators who are contemplating adopting or adjusting policies regarding the registration as domain names of place names within their countries may wish to draw inspiration from the above reflections and proposals.

TRADE NAMES

287. The Request addressed to WIPO to initiate the Second WIPO Internet Domain Name Process also called for an exploration of the issues raised, in the domain name space, by bad faith, abusive, misleading or unfair use of trade names.

WHAT IS A TRADE NAME?

288. A trade name is a name adopted, whether registered or not, by a person or business enterprise to distinguish itself, as a commercial entity, from other such enterprises. Trade names are also called company, corporate, business or firm names – although for each identifier, different legal considerations may apply in different jurisdictions. As distinct from trademarks and service marks, trade names distinguish an entire business on the basis of its character and reputation, independently of any goods or services that it may offer.[221] Trade names are frequently descriptive, or consist of the personal name or surnames of the proprietors[222] or of the original proprietors if the company ownership has been transferred.[223] Trade names, which are usually longer than trade marks, are more commonly used in business to business transactions, than in business to consumer transactions.[224] One example of a trade name is 'International Business Machines Corporation', the commercial entity that owns trademarks for information technology-related goods and services, including 'IBM'.[225] A trade name may also be registrable and separately protected as a trademark, and companies will often use their trade names as trademarks or service marks to market their goods and services; for example, Apple Computer Corporation uses the trade name 'Apple' as a trademark.[226]

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221 See generally, Stephen P. Ladas, *Patents, Trademarks, and Related Rights: National and International Protection*, Vol. III (Harvard University Press, 1975) at Chapter 42; D.M. Kerley, T.A. Blanco White, R. Jacob *Kerly's Law of Trade Marks and Trade Names*, (12th ed.) (Sweet & Maxwell, 1986, supplement 1994); *McCarthy on Trademarks and Unfair Competition*, (4th ed.) (West Group, 1998); The United States Trademark Association, *Protection of Corporate Names: A Country by Country Survey*, (INTA, looseleaf service); Adrian Room, *Dictionary of Trade Name Origins* (Routledge & Kegan Paul, 1982).

222 Such names include Woolworth, W.H. Smith, Marks & Spencer, Pears Soap, Wilkinson Sword and Black & Decker.

223 In such cases, the national courts may take steps to ensure that there is no risk of public confusion as to the source of the goods. See, for example, the decision under the German Unfair Competition Act (section 16) of the Reichsgericht, *Prop. Ind.* (1936) at p. 106, and according to principles of unfair competition law in the United States of America in *Hoyt Heater Co.* v. *Hoty*, (1945), 157 F.2d. 657 at 659; 65 *U.S.P.Q.* 294.

224 For a description of trade names and their role in designating and advertising a business entity, see Adrian Room, *Dictionary of Trade Name Origins*, (Routledge & Kegan Paul, 1982).

225 Further examples of famous trade names include Sony, Phillips, General Motors, Nestlé, Procter & Gamble, Holiday-Inn, Lego and Microsoft. See Frederick W. Mostert, *Famous and Well-Known Marks: An International Analysis*, (Butterworths, 1997) at Chapter 1 (IX).

226 See Stephen Elias, Lisa Goldoftas ed., *Patent, Copyright and Trademark*, (2nd ed.) (Nolo Press, 1997) at 398.

INTERNATIONAL PROTECTION OF TRADE NAMES

289. Trade names are protected internationally under the Paris Convention for the Protection of Industrial Property in Article 8 (Trade Names), Article 9 (Marks, Trade Names: Seizure, on Importation, etc. of Goods Unlawfully Bearing a Mark or Trade Name) and Article 10*bis* (Unfair Competition), and are classified as a form of industrial property.[227] The Paris Convention does not define trade names, and their definition and the manner in which they may be protected is left to each country to determine. As a result, national laws and mechanisms for trade name protection differ greatly, as described below and in more detail at Annex XIII.[228] In practice, the term 'trade name', as employed in the text of the Paris Convention, has been interpreted in a broad sense, with its object being to protect traders in the use of their names internationally, without forcing them to comply with any formalities or conditions imposed by foreign countries under their national laws, and to ensure that businesses are not impeded in carrying out international trade by the misappropriation of their names in foreign jurisdictions.[229]

290. Article 8 of the Paris Convention requires all countries party to the Convention[230] to protect trade names without requirement of registration and whether or not they form part of a

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227 The Paris Convention, Article 1(2) states that the protection of industrial property has as its object, inter alia, trade names (see, also, Article 2(viii) of the Convention Establishing the World Intellectual Property Organization). Article 8 of the Paris Convention provides: "A trade name shall be protected in all countries of the Union without the obligation of filing or registration, whether or not it forms part of a trademark."

228 The lack of uniformity of protection of trade names has historically been a subject of international concern. The United States Group of the International Association for the Protection of Industrial Property (AIPPI), at its Berlin Congress (1963) proposed a review of Article 8 and, as a consequence, reports were submitted to the Executive Committee at Salzburg (1964). After extensive discussions, a resolution was adopted at the Venice Congress (1969) establishing the following definition of a trade name and minimum requirements for protection (AIPPI, *Annuaire* (1964/II, N.S. No. 13), at 226):

"1. The trade name is a designation which distinguishes any enterprise engaged in the manufacture or sale of products or in providing services. The trade name may consist specifically of a surname, a fanciful denomination, a combination of generic words, a combination of letters, an identifying sign, and so on.

"2. The trade name is the object of an exclusive right entitled to protection. This right is acquired by use or by registration.

"3. (a) The trade name is protected against the use by a third party of the same designation or of a similar designation which could give rise to a risk of confusion between the enterprises or which could cause confusion of the public.

(b) The well-known trade name is protected against use to designate enterprises that have different objects, if damage is caused to the owner of the name."

229 See Stephen P. Ladas, *Patents, Trademarks, and Related Rights: National and International Protection*, Vol. III (Harvard University Press, 1975), Chapter 42 at §830.

230 The list of countries party to the Paris Convention is set out at Annex II.

trademark.[231] Subject to these two conditions, each national law on trade names applies.[232] While foreign trade names cannot be required to be registered in order to gain protection, countries may impose other conditions upon protection, such as the requirement of use, or inherent or acquired distinctiveness, and may require the registration of trade names of nationals. In practice, companies that establish branches and use their trade name in a foreign country are usually required to register the company and its name in that jurisdiction, and thereby enjoy the protection granted by national registration.[233]

291. The Paris Convention provides positive protection for trade names (Article 8) and requires countries to take effective measures to repress infringements of trade names (Article 9). In addition to such affirmative protection, Article 10*bis* grants protection against acts of unfair competition, including acts that create confusion within the establishment or with the industrial or commercial activities of a competitor.

292. A trade name, its acronym or a portion of it, may also be registrable as a trademark and may thereby be protected under national trademark laws. The Paris Convention provides, however, that trade names, although they may also enjoy protection as trademarks, must be protected independently of any trademark protection they enjoy.

293. One restriction commonly placed upon trade name protection at a national level is the requirement of prior use of the name in the country where protection is claimed.[234] Although the Paris Convention is silent as to use, this requirement may be imposed so as to protect local businesses from the onerous burden of having to search internationally for any conflicting names, before adopting a trade name locally. In some countries, it is sufficient to gain trade name protection if the name has become locally known or has acquired reputation, for example through advertising.[235] In common law countries, where protection may be derived

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231 The Chairman of the Paris Diplomatic Conference, Senator Bozérian, declared that the purpose of this provision was to address the decisions of the French Courts, which held that if a trade name forms one of the elements of a trademark and the other elements enter the public domain, then property in the trade name is also lost. See *Conférence de Paris* (1880), at 97.

232 Subject only to the national-treatment clause in Article 2, according to the decision of the Federal Tribunal of Switzerland in *Boulevard Actualités S.A.* v. *Cineac Lausanne S.A.* , 76 *A.T.F.* (1950).

233 The Paris Convention provision requiring the protection of trade names without the formalities of filing or registration is also found in the Cartagena Agreement (Andean Pact) (Article 128), and the Pan-American Convention for Trademark and Commercial Protection of Washington, 1929 (Article 14), whereas the Central American Convention for the Protection of Industrial Property (Article 50) affords protection to trade names upon registration.

234 Actual use is a pre-requisite for protection in France, as confirmed by a decision of the Court of Appeals of Paris, of June 13, 1961, *Annales* (1962) at 55. See Allan S. Pilson, *Introduction, Protection of Corporate Names: A Country by Country Survey*, (Clark Boardman, 1995).

235 Such knowledge is sufficient in Argentina, Belgium, Canada, Denmark, Hong Kong and the United States. In the Netherlands, Norway and Sweden, it is sufficient if the trade name owner has taken measures to extend his activity nationally. In Austria, reputation is sufficient if there are additional reasons for granting protection. Similarly, under the Korean Unfair Competition Prevention Act (Article 2, Item 1), any widely known trade name is protected from unauthorized use. The Japanese Unfair Competition Law (Section 2(2)(i)) provides similar protection to a

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from principles of unfair competition and misappropriation, prior use is not the key issue, and courts have focused on evidence of reputation and goodwill in a trade name.[236] In most countries where registration of trade names is allowed for foreign enterprises (often on the condition that they do business or be domicile in the jurisdiction), such registration would normally ensure protection whether or not the name is actually used locally. Applying principles of unfair competition, in order to gain protection, a trade name may need to have acquired a reputation or be well-known by at least a substantial part of the relevant public in the country in which protection is sought.[237]

294. A further issue is whether trade names will be protected only in relation to the particular field of trade activity in which the name is used, in which enterprises are likely to compete against each other, or more broadly in the absence of competition. There is no uniformity of national approach to this issue, although protection is usually conferred only in the field of activity in which the name is used.

295. Trade names are protected if they are inherently distinctive, and non-distinctive trade names may be protected if distinctiveness is acquired by use, such that the public can recognize the name as referring to a particular trade source. This is important, because trade names are often composed of common words,[238] describing the type of business activity,

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widely known trade name. The Indian courts also afford protection to well-known trade names, without requiring use, as confirmed by the decision of the High Court of Delhi in *Blue Cross & Blue Shield Association* v. *Blue Cross Health Clinic*, (September 5, 1989). By contrast, in Spain, under the Spanish Trademark Law (Article 77), a trade name owner must prove use in Spain in order to gain protection. The English courts have distinguished mere reputation of a business and the good will arising from local business activity and use, and afforded protection to good will, but not reputation in *Athlete's Foot Marketing Associates, Inc.* v. *Cobra Sports Ltd.*, [1980] *R.P.C.* 343. See Stephen P. Ladas, *Patents, Trademarks, and Related Rights: National and International Protection*, Vol. III (Harvard University Press, 1975), Chapter 42 at §835. See also the discussion of international or transborder protection of famous trade names in Frederick W. Mostert, *Famous and Well-Known Marks: An International Analysis*, (Butterworths, 1997) at Chapter 1 (IX) (i)-(ii).

236 In the United States of America, for example, reputation without use of a trade name was found sufficient to grant protection in the case of *Vaudable et al.* v. *Montmartre, Inc.* 49 *T.M Rep.* (1959), at 1212. In the United Kingdom, the courts held that international reputation of the 'Sheraton' name for hotels was sufficient grounds for protection of the trade name, in *Sheraton Corp. of America* v. *Sheraton Motels Ltd.*, *R.P.C.* (1964), at 202.

237 See G.H.C. Bodenhausen, Guide to the Application of the Paris Convention for the Protection of Industrial Property, Section II at 133-134; see also the discussion in Frederick W. Mostert, *Famous and Well-Known Marks: An International Analysis*, (Butterworths, 1997) at Chapter 1 (IX) (iv).

238 Such as, for example, Sunblest, Crunchie, Pricerite and Safeway. See generally, Adrian Room, *Dictionary of Trade Name Origins*, (Routledge & Kegan Paul, 1982).

which may nevertheless be protected against use of a similar name if the public has come to associate the name with a particular trader.[239]

NATIONAL PROTECTION OF TRADE NAMES

296. In the course of the Second WIPO Process, WIPO conducted a questionnaire of its Member States, to gather information about the manner in which different countries have implemented trade name protection. The questionnaire and an analysis of the results are set out at Annex XIII hereto.

297. The responses to the WIPO questionnaire demonstrate the wide variation in countries' approaches to national protection of trade names. Some commentators to the Second WIPO Process noted the difficulty in protecting trade names in the DNS for as long as their protection remains inconsistent throughout the world. In the circumstance that trade name protection is not uniformly applied in all countries, some commentators noted that legal recognition of trade names under the Paris Convention could not simply be reflected in the DNS.[240] It was remarked that, as national laws on protection of trade names diverge more widely than trademark laws, the current UDRP process could not simply be extended to apply to trade names.[241] Others suggested that the actual degree of protection accorded to trade names in the physical world should be extended to the DNS,[242] and should follow the legal protection provided by the Paris Convention as it is adopted by each member country.[243]

298. As an illustration of the differing treatment accorded to trade names, one commentator noted that in the Scandinavian countries of Denmark, Finland, Norway and Sweden, businesses are protected more commonly through registered trade name protection rather than through trademark law, and trade names may receive stronger protection than trademarks. This commentator suggested that decisions on disputes between entities that originate from such countries should be determined in light of their local law. [244]

299. The protection of trade names at a national level is achieved through a single law or a combination of civil law, commercial law, trade practices, trade name and trademark legislation, and in some cases through criminal penalties, in addition to common law principles of unfair competition or 'passing-off'.[245] As between countries, there are

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239 See, for example, *Music Corp. of America* v. *Music Corp. (Great Britain) Ltd.*, 64 *R..P.C.* (1947), at 41.

240 See Comment of European Brands Association (AIM) (RFC2 – December 20, 2000).

241 See Comment of ACM Internet Governance Project (RFC1 – September 15, 2000).

242 See Comment of Steven Turnbull, University of Tsukuba (RFC1 – August 29, 2000).

243 See Comment of Brazilian Association of Intellectual Property (ABPI) (RFC2 – December 28, 2000).

244 See Comment of Dipcon – Domain Name and Intellectual Property Consultants AB (RFC2 – December 22, 2000).

245 'Passing-off' refers to the common law action that protects the goodwill between a trader and his customers, against the carrying on of a business in such a manner as to mislead the public as to the source of the goods or ownership of the business. Under United Kingdom law, for example, passing-off actions may protect the goodwill or reputation attached to goods and

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significant differences in the definition of trade names, as well as the conditions and the scope of their protection.

300. As mentioned above, the Paris Convention provides that the registration of a trade name of a foreign business should not be a prerequisite to protection, although countries may impose such requirements upon their nationals. As illustrated at Annex XIII, many countries do maintain a register of trade names for businesses operating within the country, often maintaining a register of company or firm names, that is usually publicly available and may be nationally or regionally maintained. [246] Entries normally indicate the legal character of the enterprise and the purpose of the business. The majority of such databases are not yet publicly available online.[247]

301. The criteria that determine whether trade names are acceptable for registration are determined by each country, and apply nationally. Most countries impose some restriction on the type of name that can be registered, and usually require that the trade name not be identical or misleadingly similar to a name that has either been used or registered previously as a trade name, whether in a particular locality, or internationally.[248] Some countries impose this restriction against trade names found in all fields of commerce, or restrict the enquiry to trade names in the same field of trade.[249] Most countries expressly restrict trade names that infringe trademarks, and some also prohibit trade names that infringe copyright.[250] In

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services in the mind of the public, against misleading conduct in the course of trade that is calculated to injure the business or goodwill of the trader and which causes or is likely to cause such damage, (House of Lords decision in *Reckitt & Colman* v. *Borden* [1990] *R.P.C.* 340, at 499). Refer generally to the analysis of the passing-off action in W.R. Cornish, *Intellectual Property: Patents, Copyright, Trade Marks and Allied Rights*, (4th ed.) (Sweet & Maxwell, 1999) at Chapter 16, and in T.A. Blanco White and Robin Jacob, *Kerly's Law of Trade Marks and Trade Names*, (12th ed.), (Sweet & Maxwell, 1986) at Chapter 16.

246 The following sample of countries maintain databases of trade or company names that are publicly searchable: Andorra, Armenia, Australia, Austria, Bahrain, Belarus, Bulgaria, Canada, Cyprus, Denmark (limited companies), Eritrea, Estonia, Ethiopia, Finland, Germany (company names), Hungary, Ireland, Japan, Kyrgyzstan, Lithuania, Moldova, Monaco, Morocco, Norway (company names), Romania, Russian Federation, Singapore, Slovenia, Sweden, Switzerland, Tajikistan, the former Yugoslav Republic of Macedonia, Turkey, and United Kingdom (limited company names).

247 The following sample of countries maintain databases of trade or company names that are available online (some with restricted or paid access): Australia, Canada, Denmark (limited companies), Estonia, France, Hungary, Mexico, Norway, Romania, Singapore, Switzerland and the United Kingdom.

248 Various countries restrict use of identical or misleadingly similar trade names within the national territory or locality (e.g., France, Denmark, Estonia, Japan, Republic of Korea, Russian Federation), or internationally (e.g., Bahrain, Cyprus, Eritrea, Lithuania).

249 The following countries limit the enquiry as to identical or confusingly similar trade names to competitors or enterprises in the same field of trade: Denmark, Hungary, Netherlands, Peru, United Kingdom.

250 For example, Finland and Lithuania.

addition, countries may restrict trade names from use or registration that are generic or otherwise common,[251] or include geographic or place names,[252] personal names or the names of historical or political figures without authorization,[253] or words that imply a connection to the State, government, international organizations or to another business entity without appropriate authorization.[254] Many countries retain a discretion to proscribe use or registration of names that offend public morality or policy,[255] and limit use of trade names in foreign languages or scripts.[256] Restrictions are commonly placed on the names or titles of corporations or limited partnerships, as legal entities separate from the natural persons that own the enterprise, and these requirements may differ according to the type of the legal entity.[257]

PROTECTION OF TRADE NAMES IN THE DNS

302. International and national legal systems recognize the co-existence of trade names, and enable many businesses to trade in different jurisdictions or in different fields of industry using identical or similar trade names, without conflict. The domain name registration system, at least in the present gTLD space, cannot reflect this plurality, as each domain name is unique and global. Problems may arise for businesses that use their trade names in commerce, and find that the corresponding domain name has been registered by another. In the case of use of a trade name as a domain name by another entity with legitimate rights to the name, the first-come, first-served principles of domain name registration apply. Conflict arises when a trade name has been registered or used in bad faith as a domain name by a third party with no rights to the name, resulting in potential damage to the trade name owners' business reputation, or limiting its capacity to establish a trading presence on the Internet. Such abusive registration and use of a domain name is akin to the cybersquatting activity that has taken place with respect to trademarks.

303. Some national courts have recognized the rights of trade name owners to prevent the registration of their trade names as domain names. In the United States of America, for example, the Federal Lanham Act[258] gives trade name owners a civil cause of action against any use of a trade name that misrepresents the source of the goods or services, or is likely to cause confusion regarding their source. This protection has been extended to the unlawful use of trade names as domain names, pursuant to the United States District Court's decision in

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251 For example, Brunei Darussalam, Canada, Cyprus, Denmark, Georgia, Lithuania and Norway.

252 For example, Estonia, Slovenia and The Former Yugoslav Republic of Macedonia.

253 For example, Cyprus, Eritrea, Finland, Hungary, Norway, Slovenia and The Former Yugoslav Republic of Macedonia.

254 For example, Canada, Lithuania, Mauritius, Mongolia, Russian Federation and Slovenia.

255 For example, Andorra, Armenia, Australia, Benin, Brunei Darussalam, Canada, Costa Rica, Côte d'Ivoire, Cyprus, Eritrea, Estonia, Ethiopia, Honduras, Lithuania, Netherlands, Peru, Slovenia, Sweden and Viet Nam.

256 For example, Bulgaria, Estonia, Hungary, Mongolia and Viet Nam.

257 For example, Australia, Canada, Slovenia and Switzerland.

258 (15 *U.S.C.*, § 1125(a)).

U.S. v. *Washington Mint, LLC*.[259] In another jurisdiction, in Germany, the courts have found in favor of owners of 'name rights' in cases where the domain name registrant was unable to establish any legitimate interests in the name, in the Düsseldorf Court of Appeal's decision with respect to the domain name "ufa.de", for example.[260] The German courts have readily found against domain name registrants where their use of a commercial name in the DNS is liable to cause confusion or mislead the public,[261] at the same time upholding the rights of domain name registrants who have legitimate rights in the underlying trade name.[262]

304. Many registration authorities of country code top-level domains (ccTLDs) impose restrictions on the commercial entities that may register names in their domain, particularly in any second-level domain chartered for commercial use. Many ccTLD administrators require applicants to warrant that their domain name does not infringe the legal or other rights of third parties. However, among respondents to the WIPO trade names questionnaire, a minority of ccTLD administrators require applicants to assert or prove their legitimate right to register a commercial or trade name as a domain name, as follows: .AD (Andorra), .AM (Armenia), .AT, (Austria), .AU (Australia), .BB (Barbados), .CH (Switzerland), .CO (Colombia), .CY (Cyprus), .ES (Spain), .FI (Finland), .FR (France), .HU (Hungary), .IE (Ireland), .KH (Cambodia), .LT (Lithuania), .NO (Norway), .SA (Saudi Arabia), .SE (Sweden), .SI (Slovenia), .SM (San Marino), .TH (Thailand), .TR (Turkey) and .UK (United Kingdom). The majority of ccTLD administrators impose no restrictions on domain name applications based on trade names: .AR (Argentina), .BE (Belgium), .BF (Burkina Faso), .BG (Bulgaria), .BH (Bahrain), .BN (Benin), .BY (Belarus), .CA (Canada), .CR (Costa Rica), .DE (Germany), .DK (Denmark), .EC (Ecuador), .GE (Georgia), .GT (Guatemala), .HN (Honduras), .HU (Hungary), .KG (Kyrgyzstan), .KH (Cambodia), .KR (Republic of Korea), .LT (Lithuania), .MA (Morocco), .MD (Moldova), .MK (the Former Yugoslav Republic of Macedonia), .MN (Mongolia), .MU (Mauritius), .MX (Mexico), .PT (Portugal), .RO (Romania), .RU (Russian Federation), .SG (Singapore), .UA (Ukraine), .US (United States of America) and .UZ (Uzbekistan).

305. It is evident that there exists no uniform or robust protection for trade names in the DNS. As a result, trade name owners are required either to concede any right to use their trade name online when confronted with its abusive or bad faith registration as a domain name, or else attempt to defend their legal rights through national judicial systems. The question for consideration is whether trade names can and should be protected in the DNS

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259 (15 *F. Supp.*2d 1089 (D.Minn, 2000)).

260 Decision of September 30, 1997 – 4 O 179/97, finding in favor of the UFA-Film-und Fernseh GmbH & Co KG, which had rights in the designation 'UFA'. Similarly, the Munich District court, in a decision of October 21, 1998 – 1 HK O 167 16/98, found against the domain name registrant of "muenchner-rueck.de", as an unauthorized use of the commercial designation 'Münchner Rückversicherung'.

261 See, for example, the decision of the Stuttgart Court of Appeal in a decision of February 3, 1998 – 2 W 77/97, finding that "steiff.com" infringed the name rights of the soft toy manufacturer, Steiff.

262 The Bonn District Court, in a decision of September 22, 1997 – 1 O 374/97, found that the domain name registrant for "dtag.de" had a legitimate interest in his domain and, applying the principle that any person may participate in business under his own name, found that Section 12 of the Civil Code did not apply.

and, if so, how best this can be achieved from the perspective of the development of the Internet as a medium for communication and electronic commerce.

REVIEW OF COMMENTS RECEIVED

306. Many commentators to the Second WIPO Process were broadly in support of some form of protection for trade names in the DNS,[263] while a minority were opposed.[264] It was widely recognized that trade names perform the same 'origin function' as trademarks, indicating the source or nature of the business entity they represent, and perform the same investment or advertising function. To the extent that trade names serve an identifying function, like trademarks, there was support for their protection in the DNS, similarly to trademarks.

307. Some commentators noted that trade names, unlike trademarks, are broadly defined, unregistered and unregulated and that, as a result, their protection in the DNS could compromise individual rights.[265] Commentators noted the absence of any universally accepted or applied definition of a 'trade name',[266] and the lack of uniform protection granted worldwide pursuant to the Paris Convention.[267] However, many commentators did support protection for trade names in the DNS commensurate with their protection under the Paris Convention.[268] One commentator proposed granting protection only to those trade names that are registered by their relevant national authority,[269] although in this respect, it is notable that the Paris Convention provides that registration should not constitute a prerequisite for protection, and many countries do not require registration in order for trade names to enjoy protection.[270] Some commentators noted that numerous identical trade names may legitimately coexist in different jurisdictions, in contrast to the unique global presence offered by a domain name.[271] In this context, it was suggested that protection for trade names in the DNS should be devised on a country-by-country basis, depending on local application of the Paris Convention.[272]

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263 See, for example, Comment of State Agency on Industrial Property Protection of the Republic of Moldova (RFC2 – December 29, 2000), Comment of Des Donnelly, rexco.com (RFC1 – August 5, 2000).

264 See, for example, Comment of Billy Reynolds, 14us2.com (RFC1 – August 15, 2000), Comment of Ben Hwang (RFC1 – August 11, 2000).

265 See Comment of Bernard H.P. Gilroy (RFC1 – August 11, 2000), Comment of Jay Orr (RFC1 – August 14, 2000).

266 See Comment of Edwin Philogene (RFC1 – August 11, 2000).

267 See Comment of European Brands Association (AIM) (RFC2 – December 20, 2000).

268 See Comment of Asociación Interamericana de la Propiedad Industrial (ASIPI)(RFC2 – December 26, 2000).

269 See Comment of Des Donnelly, rexco.com (RFC1 – August 5, 2000).

270 Refer to the WIPO trade names questionnaire at Annex VII.

271 See Comment of Gregory Rippel, U.S. Realty Corp. (RFC1 – August 19, 2000), Comment of John Apolloni (RFC1 – August 14, 2000), Comment of Alexander Svensson (RFC2 – December 21, 2000).

272 See Comment of Brazilian Association of Intellectual Property (ABPI) (RFC2 – December 28, 2000).

308. Commentators also suggested that consideration be given to the definition of what properly constitutes a 'trade name,' and the appropriate status to be accorded to registered company names. In this context, it was suggested that national authorities could be tasked to determine which trade names merit protection.[273] The issue was also raised whether well-known trade names should be given special consideration, as accorded to well-known trademarks.[274]

309. One commentator expressed concern at the retrospective application of new principles for protection of trade names, noting that business livelihoods may be at stake.[275] In addition, some commentators remarked that any systems instituted to protect trade names in the DNS could be used to hijack names from individuals and smaller enterprises.[276] One commentator noted that business enterprises have the option to protect their names using trademark law and that, if they chose not to do so, the first-come, first-served rule should apply.[277]

310. Some commentators noted the potential for differentiation in the DNS, and suggested that trade names should only receive protection in gTLDs with a commercial charter,[278] or that remedies should take into account the nature of the gTLD in question.[279] Others remarked upon the potential for differentiation between TLDs to lessen the risk of confusion resulting from registration of trade names in the DNS.[280]

311. In considering options to grant protection to trade names in the DNS, numerous commentators were in support of the revision of the UDRP to extend protection to bona fide trade names, as well as trademarks.[281] The present UDRP applies only to trademarks and service marks, and does not apply to trade names unless they also constitute common law

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273 See Comment of Carlos Tabora, PrintDay.com, Inc. (RFC1 – August 15, 2000).

274 See Comment of Fédération Internationale des Conseils en Propriete Industrielle (FICPI) (RFC1 – September 15, 2000).

275 See Comment of Frank Azzurro (RFC1 – August 15, 2000).

276 See Comment of American Civil Liberties Union (ACLU) (RFC2 – December 29, 2000), Comment of Leah Gallegos, TLD Lobby (RFC1 – August 16, 2000), Comment of Katharine Audlin, NewsBank, Inc. newsbank.com (RFC1 – August 12, 2000), Comment of Edwin Philogene (RFC1 – August 11, 2000), Comment of Joseph Fowler (RFC1 – August 11, 2000), Comment of Atilda Alvarido (RFC1 – August 12, 2000).

277 See Comment of Des Donnelly, rexco.com (RFC1 – August 5, 2000), Comment of Santiago Mejia (RFC1 – August 11, 2000).

278 See Comment of Forrester Rupp (RFC1 – August 14, 2000), Comment of Security Privacy and Internet Equity Sypmposium of 16/12/00 of the Key West Institute S6/Consortium Board (RFC2 – December 22, 2000).

279 See Comment of Government of Australia (RFC2 – January 23, 2001).

280 See Comment of American Civil Liberties Union (ACLU) (RFC2 – December 29, 2000).

281 See Comment of Government of Australia (RFC2 – January 23, 2001), Comment of European Brands Association (AIM) (RFC2 – December 20, 2000), Comment of Asociación Interamericana de la Propiedad Industrial (ASIPI) (RFC2 – December 26, 2000), Comment of the Association of European Trade Mark Owners (MARQUES) (RFC2 – December 22, 2000), Comment of Matthias Haeuptli (RFC2 – September 15, 2000).

trade or service marks.[282] One commentator suggested that this should be made explicit in the UDRP and Rules.[283]

312. It was noted by one commentator that, if the UDRP were revised to apply to trade names, given that trade name protection varies under different national laws, panelists would be required to decide disputes under widely differing laws and standards.[284]

313. Commentators also considered the criteria that should apply to establish rights in a trade name, and included evidence of company name registration (if applicable), and reference to the charter of the gTLD in which the name is registered. In many jurisdictions, an entity may acquire rights in a trade name through use, and some commentators stated that use should be the most important criteria for protection. Commentators suggested that additional criteria could include; an established reputation in a field of business, use of the domain name in a same or similar field of interest to the trade name, and whether or not the trade name is registered.[285] One commentator noted that mere registration of a trade name as a domain name may constitute 'use' sufficient to establish legitimate interests in the name, despite an absence of use before registration.[286] Some commentators argued that protection should be extended to trade names that were distinctive as well as those that, although not inherently distinctive, had acquired secondary meaning. One commentator stated that complainants should be required to prove that their trade name has become distinctive as an indication of source,[287] and to prove their trade name's inherent or acquired distinctiveness by 'clear and convincing evidence'.[288] Some commentators stated that any protection of trade names in the DNS should not extend to generic words,[289] whether or not they had acquired distinctiveness through use.

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282 Indeed, the Administrative Panel in WIPO Case No. D2000-0025 *SGS Société Générale de Surveillance S.A.* v. *Inspectorate* (March 17, 2000) stated: "The Panel considers that the Policy and Rules refer only to identity or similarity to trademarks and service marks in which a complainant has rights. No reference is made in the Policy and Rules to *tradenames* in which a complainant has rights." In another WIPO Case No. D2000-0638 *Manchester Airport PLC* v. *Club Club Limited* (August 22, 2000), the three-member Administrative Panel found against a complainant who had asserted that the domain name registered by the respondent was identical to a name under which it traded, and that the respondent was passing off of the complainant's unregistered rights in its corporate name. The majority of the Panel found that there was insufficient evidence of corresponding trademark rights in the name and that the UDRP did not address passing off.

283 See Comment of American Intellectual Property Law Association (AIPLA) (RFC2 – December 29, 2000).

284 See Comment of United States Council for International Business (RFC2 – December 29, 2000).

285 See Comment of Government of Australia (RFC2 – January 23, 2001).

286 See Comment of Swiss Federal Institute of Intellectual Property (RFC2 – December 29, 2000).

287 See Comment of American Intellectual Property Law Association (AIPLA) (RFC2 – December 29, 2000).

288 See Comment of Weikers & Co., Attorneys at Law (RFC1 – August 11, 2000).

289 See Comment of Security Privacy and Internet Equity Symposium of 16/12/00 of the Key West Institute S6/Consortium Board (RFC2 – December 22, 2000), Comment of Mark James Adams, Raysend (RFC1 – August 11, 2000).

314. It was also suggested that the current UDRP definition of 'bad faith abusive, misleading or unfair registration and use' in respect of trademarks (UDRP, Rule 4.b) could simply be adjusted to apply to trade names. [290] Some commentators suggested that the definition of bad faith should be based on minimizing the risk of public confusion,[291] and damage to a business' reputation.[292] As noted by one commentator, the real issue is to determine what constitutes 'abuse' of a trade name: "Any *abuse* of a sign in the scope of the Domain Name System should – as well as in the 'real world' – not be tolerated and therefore be prevented".[293] Proof of bad faith was seen as critical by commentators, in order to prevent reverse domain name hijacking. [294] One commentator stated that registration of trade names as domain names should be permitted, unless the domain name was used for commercial purposes and there was a reasonable likelihood of confusion. In this way, the protection of industrial property would not stifle genuine criticism, parody and legitimate competition.[295] In this regard, it was also stated that commercial entities should not automatically take precedence over non-commercial entities in relation to the use of trade names as domain names.[296] One commentator remarked that, in case of conflict between a trademark and trade name, the trademark should take precedence. [297] In any conflict between two entities with legitimate rights in the name, it was noted by one commentator that the matter should be left to a court of competent jurisdiction to decide.[298]

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290 See Comment of Government of Australia (RFC2 – January 23, 2001).

291 See Comment of Asociación Interamericana de la Propiedad Industrial (ASIPI) (RFC2 – December 26, 2000), Comment of American Civil Liberties Union (ACLU) (RFC2 – December 29, 2000).

292 See Comment of the Association of European Trade Mark Owners (MARQUES) (RFC2 – December 22, 2000).

293 See Comment of Swiss Federal Institute of Intellectual Property (RFC2 – December 29, 2000).

294 See Comment of Security Privacy and Internet Equity Symposium of 16/12/00 of the Key West Institute S6/Consortium Board (RFC2 – December 22, 2000), Comment of Mark James Adams, Raysend (RFC1 – August 11, 2000).

295 See Comment of American Civil Liberties Union (RFC2 – December 29, 2000).

296 See Comment of The Law Society of Scotland (RFC2 – January 4, 2001).

297 See Comment of European Brands Association (AIM) (RFC2 – December 20, 2000).

298 See Comment of International Trademark Association (INTA) (RFC2 – January 4, 2001).

POSSIBLE ACCOMMODATION OF TRADE NAME PROTECTION WITHIN THE UDRP

315. The foregoing survey of international and national protection of trade names makes it clear that trade names are at present protected against abusive registration as domain names. Such protection is accorded either (i) through the existing UDRP, where the trade name is supported by a trademark right, although it should be noted that, in these circumstances, the protection affixes as result of the trademark protection and not because of the trade name itself; and (ii) through national courts, when called upon to apply applicable international and national laws for the protection of trade names. The question that arises for consideration in the present Process is whether this protection ought to be supplemented by an additional means of enforcement of existing norms, such as might be established through the extension of the UDRP to the protection of trade names *per se* against abusive registration.

316. The extension of the UDRP to the protection of trade names *per se* against abusive registration would not involve the creation of new international law, since an ample basis for such protection already exists, as described above, in the Paris Convention. However, before any recommendation in favor of such an extension could be made, two issues call for attention.

317. The first of those issues concerns evidence of the harm that is being done through the abusive registration of trade names as domain names, both in respect of the public interest, through the deception of users of the Internet, and in respect of private interests, through unfair competition to the owners of trade names. The evidence that has so far been produced in the course of the Second WIPO Process is less than convincing in this regard. It does not at present reveal an urgent need to address a problem that is damaging public and private interests in a disproportionate and unmeasured way so as to require the establishment of a more efficient means of expressing the existing protection of trade names within the DNS. In this respect, it may recalled that, in the course of the first WIPO Process, considerable evidence was produced to demonstrate the extent of abusive registration of trademarks, and the damage caused by such abusive registrations. That evidence in respect of trademarks has been more than amply confirmed through the large number of cases filed under the existing UDRP in which the interests of the owners of trademarks have been vindicated against abusive registrants.

318. Further submissions are invited on the extent of abusive registrations of trade names per se and on the nature of the harm being occasioned by such registrations.

319. A second issue that needs to be addressed concerns the diversity of national implementations of the general international norms for the protection of trade names that are contained in the Paris Convention. Does this national diversity allow it to be envisaged that a ‘uniform’ dispute resolution policy could be adopted for the protection of trade names? In this respect, it is again recalled that, as a result of the greatest specificity of norms for the protection of trademarks at the international level in the Paris Convention and the Agreement on Trade-Related Aspects of Intellectual Property Rights (the TRIPS Agreement), the

establishment of a uniform dispute resolution procedure for the abusive registration of trademarks was considered to be entirely plausible. Trademarks are, for the most part, the subject of convergent definitions and scope of protection at the national level.

320. In the absence of an internationally agreed definition of what constitutes a trade name, the protection of trade names through an extension of the UDRP would require the panel in each trade name dispute to determine meticulously which law was applicable to establish whether a right existed in respect of a trade name, the scope of that right and whether the right has been violated through the abusive registration and use of a domain name. Where national laws are convergent and uniform, the determination of the applicable law is less significant, since the application of the law of each country will produce a similar result.

321. The diversity of national approaches to the implementation of international protection of domain names does not, in our view, allow a recommendation to be made at this stage in favor of a modification of the UDRP to protect trade names *per se* against abusive registration and use as domain names.

322. It is not recommended that a special procedure for the protection of trade names against abusive registration and use as domain names be established at this stage through the modification of the UDRP.

323. Since we are conscious that the recommendation in the preceding paragraph is not shared by many commentators, we shall nevertheless set out how the UDRP might be revised to include a cause of action to enable a complainant to challenge the registration of a trade name as a domain name in an administrative dispute resolution proceeding before an independent expert decision-maker. The available remedy would be restricted to cancellation of the domain name or its transfer to the legitimate trade name owner. This option would have the advantage that it would accommodate the coexistence of a multiplicity of users of the same or similar trade names in different fields of activity and different locations. A demonstration of bona fide registration and use on the part of the domain name holder would result in the complaint being dismissed, thereby protecting the interests of legitimate registrants against ‘reverse domain name hijacking’. This option received considerable support from commentators, and could be implemented along the lines of the UDRP now operating with respect to trademarks.

324. In any UDRP administrative dispute resolution procedure for trade names, it is suggested that the legal owner of a trade name, or his or her representative, should have standing to bring a complaint to challenge the registration of a trade name as a domain name. Legal rights to the trade name could be proven by evidence of use of the trade name (anterior to registration of the domain name), registration of the trade name (where registration is an option), or other evidence of earlier proprietary and commercial activity in relation to the trade name.

325. The extension of the UDRP to trade names would, given the absence of a uniform definition of a ‘trade name’, require the decision-maker to determine whether a trade name

would be eligible for protection. In deciding this, the decision-maker would need to determine the applicable law and apply it, and could, typically refer to the follow factors for guidance:

- ♣ use of the trade name prior to registration of the domain name;
- ♣ use of the domain name in a common field of activity with the trade name;
- ♣ whether or not the trade name was registered, depending upon whether registration was an option in the jurisdiction;
- ♣ whether the trade name was inherently distinctive or had acquired distinctiveness;
- ♣ whether the trade name contained common or generic words;
- ♣ evidence of goodwill or reputation in the trade name, nationally or internationally;
- ♣ whether the trade name had become famous or well-known; and
- ♣ the nature and type of the domain name space in which the domain name was registered.

326. The revised UDRP would require a cause of action based upon bad faith, abusive, misleading or unfair registration and use in respect of trade names. The proposed cause of action is as follows:

> "1. The registration of a domain name shall be considered to be abusive and the owner of a trade name shall be entitled to its cancellation or transfer when all of the following conditions are met:
>
> (i) The domain name is identical or confusingly similar to a trade name in which the complainant has rights, whether registered or unregistered;
>
> (ii) The registrant of the domain name has no rights or legitimate interests in respect of the domain name; and
>
> (iii) The domain name has been registered and is being used in bad faith.
>
> 2. For the purposes of paragraph (1)(iii), the following circumstances, in particular but without limitation, shall be evidence of the registration and use of a domain name in bad faith:
>
> (a) the registration of a domain name which is the trade name of another, primarily for the purpose of selling, renting or otherwise transferring the domain name to an owner of the trade name, at a cost which is in excess of the out-of-pocket expenses directly related to the domain name; or
>
> (b) the registration of a domain name to prevent an owner of a trade name from reflecting the name in a corresponding domain name, provided the registrant has engaged in a pattern of such conduct; or
>
> (c) the registration of the domain name primarily for the purpose of disrupting the business of a competitor; or
>
> (d) the registration of the domain name with the intention of attracting, for commercial gain, users to registrant's web site, by creating a likelihood of confusion with a trade name as to the source, sponsorship, affiliation, or endorsement of the registrant's web site or of a product, services or trading entity on the registrant's web site.

3. For the purposes of paragraph (1)(ii), the following, in particular but without limitation, shall be evidence of the registrant's rights and legitimate interests in the domain name:

(a) The use of, or preparations to use, the domain name or a name corresponding to the domain name, before any notice of the dispute, in connection with a bona fide establishment of a commercial operation or business; or

(b) The domain name corresponds to a trade name, trademark or service mark of the registrant; or

(c) The registrant (as an individual, business or other organization), has been commonly known by the domain name; or

(d) The registrant is using the domain name for legitimate noncommercial or fair use of the domain name, without intent for commercial gain, to misleadingly divert consumers or otherwise damage the goodwill in the trade name at issue."

327. *Comments are invited on the desirability of a revision of the UDRP to protect trade names from abusive, bad faith, misleading or unfair registration and use as domain names and on the appropriateness of the suggested revisions described above.*

SCOPE OF PROTECTION OF TRADE NAMES IN gTLDs AND ccTLDs

328. To the extent that any system of protection of trade names is implemented in the DNS, it is proposed that this protection should extend uniformly across the existing open gTLDs. It is also proposed that protection should extend to any new gTLDs. While it is acknowledged that differentiation among gTLDs has potential to lessen consumer confusion and disputes, it is suggested that the underlying reasons for protection of trade names (to prevent damage to goodwill and confusion of the public) apply equally in all gTLDs. In addition, many of the same considerations that support protection of trade names in the gTLDs apply equally in the ccTLDs. The argument for legal protection for trade names is, in fact, more coherent and persuasive at a national level than internationally (in view of the absence of uniformity between countries), and therefore more easily expressed in the DNS at a ccTLD level.

329. It is recommended that any revision of the UDRP to extend to trade names should apply to all existing open and all new gTLDs. The administrators of ccTLDs that apply the UDRP are encouraged to adopt any revision of it concerning trade names within their respective ccTLDs.

TECHNICAL MEANS FOR COEXISTENCE OF TRADE NAMES IN THE DNS

330. Trade names commonly do not function as unique identifiers in the physical world, and are not protected as such. Owners of trade names that are the same or similar do peacefully coexist and trade in different jurisdictions and fields of activity. In this context, it would appear that directory, listing or other services could usefully be employed to enable trade name owners to coexist online, and thereby avoid or resolve domain name conflicts. Commentators to the Second WIPO Process were not generally in favor of the obligatory use of these services for trade names, bearing in mind that the entity responsible for maintaining the directory would be responsible for making a preliminary determination whether the trade name had inherent or acquired distinctiveness – a task which one commentator described as logistically impossible, given the probable demand by companies seeking listing, and the lack of the due process of a case-by-case dispute resolution system.[299] On a voluntary basis, however, it is suggested that trade name owners may find such technical solutions offer a useful means to resolve disputes involving competing legitimate rights to a trade name, while still maintaining their presence online.

[299] See Comment of Weikers & Co., Attorneys at Law (RFC1 – August 11, 2000).

THE ROLE OF TECHNICAL MEASURES

331. The request addressed to WIPO to undertake the Second WIPO Process also noted that "in undertaking the process, it would be beneficial if any information received or collected concerning technical solutions to domain name collision control was collated for the information of WIPO Members and the Internet community." Numerous commentators noted the importance of these technical mechanisms in preventing and resolving conflicts in the DNS.[300] This Chapter collects information received to date on technical means to reduce conflict between domain names. Further material will be collated during the remainder of this Process.

332. Further submissions are sought on developments concerning technical measures to avoid conflicts between domain names, and to overcome the challenge of uniqueness of domain names.

THE WHOIS DATA SEARCH FACILITIES

333. WIPO's RFC-2 invited comments on "[t]he requirements of any domain names databases (including the type of information to be stored therein) that may be developed to allow domain name applicants, holders of intellectual property rights, and other interested parties to search for and obtain information for purposes of evaluating and protecting any potentially related intellectual property rights. These requirements may include, in particular, the need to make the information accessible through a common interface and to interlink databases that may be maintained by various registries and/or registrars in order to permit single comprehensive searches."

334. The Whois system comprises the databases of registrants' domain name registration details that are required to be maintained by each gTLD domain name registrar, and are publicly available for searching online. The Whois databases are used by members of the public to determine the identity of domain name registrants and the technical and administrative contacts for the web site hosts. The Whois search facility is used by various users for multiple purposes – including to identify online infringers for enforcement of intellectual property rights, to identify and verify online merchants, to source unsolicited email and to investigate illegal activity, including consumer fraud.[301] The development of robust and publicly available Whois databases and other directory services was described by one commentator to the Second WIPO Process as essential for combating online copyright

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300 For example, see Comment of the Institute Federal de la Propriété Intellectuelle (Suisse) (RFC1 – September 15, 2000).

301 See presentation of Mr. Paul Hughes, Public Policy Advisor, Adobe Systems USA, on 'Domain name registrant contact details', at the WIPO Conference on Intellectual Property Questions Relating to ccTLDs (February 20, 2001) at *http://ecommerce.wipo.int/meetings/2001/cctlds/presentations/hughes.pdf.*

piracy and for facilitating the licensed use of copyright materials online.[302] The availability of accurate Whois data is necessary to ensure that registrants are notified of any legal or administrative UDRP proceedings against them, and therefore to ensure due process. As first intended, the Whois also provides a crucial resource for network administrators who may need to correct network problems or determine the perpetrators of spam or hacking attacks. In its multiple capacities, the Whois plays a critical role in the prevention and resolution of conflict in the DNS.

335. It is now asked whether the Whois system, as it currently operates, is adequate to fulfil its dispute-prevention function, or whether it should be extended in any of three ways:

(i) to enable Whois searches across any new open gTLDs;
(ii) to enable searches across the Whois databases of all registrars; and
(iii) to enable searches across the Whois databases of all registrars for more than just the exact domain name.

336. The Report of the first WIPO Process recommended that the contact details of all holders of domain names in all open gTLDs should be made publicly available in real time.[303] The majority of commentators to the first WIPO Process submitted that public availability of contact details of domain name holders was key to the enforcement of intellectual property rights, and had strongly opposed any restrictions on the availability of data concerning those contact details. The Report recommended that, at least for so long as the gTLDs remain undifferentiated, the public availability of these details was essential, and reflects the well established principle of open availability of contact details of business enterprises operating in the commercial sphere. It was also noted that the nature of the searchable database in which contact details could be made available was an issue of technical coordination, outside the scope of the WIPO Process, and that it remained for ICANN to establish via its relationships with registry administrators and registrars.[304]

337. In its previous Report, WIPO recommended that the domain name registration agreement should contain a requirement that the applicant provide certain accurate and reliable contact details.[305] ICANN's Registrar Accreditation Agreement requires registrars to make available at least the following information: the domain name, the Internet Protocol

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302 The Copyright Coalition on Domain Names (CCDN) submitted that these services are also important for advancing law enforcement, consumer protection, parental control and other social policies in the online environment. See Comment of the Copyright Coalition on Domain Names (RFC2 – December 28, 2000).

303 See Report of the first WIPO Internet Domain Name Process, paras 74-81.

304 See Report of the first WIPO Process, paras. 74 -81.

305 WIPO recommended that domain name applicants should be required to provide the following information: full name of the applicant; applicant's postal address, including street address or post office box, city, State or Province, postal code and country; applicant's e-mail address; applicant's voice telephone number; applicant's facsimile number, if available; and where the applicant is an organization, association or corporation, the name of an authorized person (or office) for administrative or legal contact purposes. See Report of the first WIPO Process, para. 73).

address of the primary and secondary nameservers, the corresponding names of those nameservers, the identity of the Registrar involved, the dates of registration and expiry, the name and postal address of the domain name holder, the name, postal address, email address, telephone and fax numbers of the technical and administrative contacts.[306]

338. Many commentators to the Second WIPO Process reiterated the need for a fully open, searchable and freely available Whois database, that provides complete data for the DNS.[307] This information is required to be searchable by simple logical and combined methods, updated promptly, presented in a consistent format, and linked to the registrar or registry's site with nominated contact points to receive any complaints concerning incorrect contact data. It was stated that these policies are achieved by accountability and transparency in the DNS, and that the Whois database is a crucial tool to enable Internet users to know with whom they are dealing when visiting a particular site.[308]

339. The Whois information is only useful if registrants' contact details are accurate and up-to-date. The Report of the first WIPO Process recommended that domain name registration agreements should contain a term making the provision of inaccurate or unreliable information by the domain name holder, or the failure to update information, a material breach of the registration agreement and a basis for cancellation of the registration by the registration authority.[309] ICANN's Registrar Accreditation Agreement states that the willful provision of false or inaccurate contact data constitutes a material breach of the registration agreement and a basis for its cancellation.[310] ICANN's Statement of Registrar Accreditation Policy requires accredited registrars to provide public access on a real-time basis, such as by way of a Whois service, to the contact details that are required to be provided by a domain name registrant, and to keep such information updated. [311] It is noted that there exist means by which registrars can improve the validity of Whois data, through random sampling or by acting upon notifications by third parties of the discovery of inaccurate details.

340. Although there are clear obligations upon accredited registrars of open gTLDs to maintain full and accurate Whois data, the question is raised whether these requirements should apply to any new gTLDs. The ICANN policy for allocation of new gTLDs asks: "Does the proposal make adequate provision for Whois service that strikes an appropriate balance between providing information to the public regarding domain-name registrations in a convenient manner and offering mechanisms to preserve personal privacy?"[312] As noted by one commentator to the Second WIPO Process, it is essential that the current requirements for

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306 See ICANN Registrar Accreditation Agreement, Art. II.F(1).

307 See Comment of Verizon (RFC2 – December 26, 2000).

308 See also Comment of the United States Council for International Business (RFC2-December 29, 2000).

309 See Report of the first WIPO Process, paras. 117-119.

310 See ICANN Statement of Registrar Accreditation Policy, Art II.J (7)a. (approved November 4, 1999) at *http://www.icann.org/nsi/icann-raa-04nov99.htm*

311 See ICANN Statement of Registrar Accreditation Policy, Art II.F (approved November 4, 1999) at *http://www.icann.org/nsi/icann-raa-04nov99.htm.*

312 See ICANN Criteria for Assessing TLD Proposals, August 15, 2000, para.8(d) at *http://www.icann.org/tlds/tld-criteria-15aug00.htm.*

free public access to a Whois service should be extended to any new gTLDs.[313] The Intellectual Property Constituency (IPC) of ICANN's Domain Name Supporting Organization (DNSO) proposed criteria it considered should be required of new gTLD's Whois services, and the methods by which this information could be searched.[314] The IPC recommended that the database information should be searchable by domain name, registrant's name or postal address, contacts' names, NIC handles and Internet Protocol address, and should be required to be kept current and comprehensive. Further, it was stated that searches should not be arbitrarily limited, either in number (e.g., NSI's search is limited to 50 hits and does not provide the total number of hits) or in type (e.g., limited only to matches with exact domain names).

341. It is recommended that the obligation to provide accurate, reliable and publicly accessible Whois data should be required of each registration authority in all gTLDs, existing and future.

342. The Shared Registration System ("SRS") was introduced by ICANN in early 1999 to accredit competitive registrars in the .com, .net, and .org top-level domains. Prior to this, Network Solutions, Inc. (NSI) was the only registrar of gTLDs, and maintained a single Whois database for the open gTLDs. However, with the accreditation of more than 90 new gTLD registrars, each of whom are required to maintain their own Whois database, concerns have been expressed that the distributed Whois system is fractured, and less functional for consumers and intellectual property owners. Critically, there is no single site from which all registrars' Whois data can be comprehensively searched for more than just the exact domain name. This is despite the fact that the ICANN Registrar Accreditation Agreement mandates cross-registry Whois searches, as follows:

> "Registrar shall abide by any ICANN-adopted Policy that requires registrars to cooperatively implement a distributed capability that provides query-based Whois search functionality across all registrars. If the Whois service implemented by registrars does not in a reasonable time provide reasonably robust, reliable, and convenient access to accurate and up-to-date data, the Registrar shall abide by any ICANN-adopted Policy requiring Registrar, if reasonably determined by ICANN to be necessary (considering such possibilities as remedial action by specific registrars), to supply data from Registrar's database to facilitate the development of a centralized Whois database for the purpose of providing comprehensive Registrar Whois search capability."[315]

343. Currently, the Whois search facility allows users to search across all registrars' databases only by exact domain name. It is not currently possible for a user to conduct a cross-registry search by name of registrant, and thereby ascertain a pattern of abusive bad

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313 See Comment of the Copyright Coalition on Domain Names (RFC2 – December 28, 2000).

314 See 'Intellectual Property Protection in the New TLDs', *Intellectual Property Constituency (IPC) of the DNSO*, August 24, 2000, at *http://ipc.songbird.com/New_TLD_Safeguards.htm*.

315 See ICANN's Registrar Accreditation Agreement, approved November 4, 1999, (Section II.F(4)) at *http://www.icann.org/nsi/icann-raa-04nov99.htm#IIF*.

faith registrations. Furthermore, not all registrars' Whois sites have comparable facilities. Only Verisign/NSI, for example, allows a user to search by exact domain name, domain name owner, contact name owner, handle and IP address. In its comment to the Second WIPO Process, the International Trademark Association (INTA) requested that WIPO study and evaluate the potential for improvement of the Whois database, and develop a set of best practices for those operating Whois databases. "INTA has been an active advocate in ICANN, Europe and the U.S. Congress, on the need for a fully searchable, open and freely available Whois database that works across a variety of platforms despite the growing number of registration authorities inputting data into such databases. The trademark community has faced numerous problems in accessing information and obtaining accurate information from the Whois database over the past several years." [316]

344. One commentator to the Second WIPO Process noted that, as a result of the introduction of competition among gTLD registrars and the resulting decentralization of responsibility for Whois services, "public access to gTLD Whois data is more fragmented, less consistent and less robust today than it was when the Final Report of the first WIPO Process was issued."[317] One Internet Service Provider expressed its concern at the deterioration in Whois functionality, due to commercial factors and to privacy concerns, that had led to a decline in cooperation and the quality of information provided by various Whois lookup services. It was noted this could impair the ability of the Internet service providers themselves to assist in preventing infringements of intellectual property rights and cooperation with law enforcement officials on other legal issues.[318] These comments suggest that there is a need for a search facility that allows searches to be performed across a plurality of gTLDs and ccTLDs, enabling more than one search criteria (e.g., by domain name or registrant). One example of a system that goes towards meeting this requirement is the UWhois.com service.

345. Comments are sought as to whether it is practical or appropriate to enhance the functionality of the existing Whois, to enable searches across all relevant registrar databases on the basis of search criteria in addition to the exact domain name.

346. It is clear that, at least at the gTLD level, technical measures can be employed to improve rightsholders' ability to search the DNS architecture, and identify domain name holders who infringe third parties' intellectual property rights. While the Whois system offers a search facility for the open gTLDs, with the increase in registration activity at the ccTLD level, some commentators have suggested that administrators of ccTLDs should be encouraged to adopt policies for the collection, verification and public availability of contact

316 See Comment of International Trademark Association (INTA) (RFC1 – September 11, 2000).

317 See Comment of Copyright Coalition on Domain Names (RFC2 – December 28, 2000).

318 See Comment of Commercial Internet eXchange Association (CIX) (RFC2 – December 29, 2000), stating that "CIX urges that particular attention be given to the fissures that have appeared in WHOIS database lookup services and that priority be given to restoring their integrity."

details of registrants.[319] There is no coordination of Whois services across the ccTLDs, as each ccTLD administration authority may maintain its own Whois, and there may be multiple Whois databases that correspond to second-level domains administered by separate authorities within each ccTLD. To add to the difficulty, Whois databases are currently inaccessible in numerous ccTLDs that have closed off, or propose to close off, access to their Whois service.[320] The WIPO ccTLD Best Practices for the Prevention and Resolution of Intellectual Property Disputes identify minimum standards for the collection and availability of contact details, subject to the limitations required by local mandatory privacy laws. [321]

347. It is recommended that administrators of ccTLDs be encouraged to adopt policies for the collection, verification and public availability of Whois data via online databases, that are uniform, to the greatest extent possible, with the Whois system at a gTLD level.

PRIVACY IMPLICATIONS OF EXTENDED WHOIS SERVICES

348. The ready public availability of registrants' contact details through Whois services raises implications for privacy and data protection under the various data protection laws that apply in each country or region. Commentators to the first WIPO Process expressed their concern at the possible erosion of personal liberties through the continued public availability of contact details of domain name holders.[322] At the same time, the majority of commentators were strongly opposed to any restrictions upon the availability of data, and firmly opposed filtered access to data designed to protect users' privacy, arguing that filters would impose an administrative burden on registration authorities without any real gains in privacy protection. The Report of the first WIPO Process recommended that domain name registrants' contact details should be collected and made available for limited purposes, and that registrants should be clearly notified in their registration agreement of the purposes of the collection and their consent obtained for the public availability of contact details. It was also recommended that registrars should adopt reasonable measures to prevent predatory use of data beyond the stated purposes in the registration agreement, such as mining of a database for domain name holders' contact details for use in advertising and sales.

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319 See Comment of the Copyright Coalition on Domain Names (RFC2 – December 28, 2000).

320 See Comment of the United States Council for International Business (RFC2 – December 29, 2000). See generally 'Matters Related to WHOIS' *DNSO Intellectual Property Consituency*, March 3, 2000 – paper prepared for the ICANN meeting in Cairo, Egypt - at *http://ipc.songbird.com/Whois_paper.html*.

321 The draft WIPO ccTLD Best Practices document is posted for comment at *http://ecommerce.wipo.int/domains/cctlds/bestpractices/*, and will be finalized by April 30, 2001.

322 See Report of the first WIPO Process at paras. 87-90.

349. In order to accommodate privacy interests and the needs of some users to remain anonymous, the ICANN Accreditation Agreement provides that a registrar or third party can list its own contact details in lieu of an anonymous registrant, provided that it accepts liability for any harm caused by wrongful use, unless it promptly discloses the identity of the true holder upon reasonable evidence of actionable harm. In this way, bona fide registrants can remain anonymous and intellectual property rightsholders are able to identify infringing registrants.

350. Some commentators expressed concern at the privacy implications of a more comprehensive Whois search facility. The American Civil Liberties Union (ACLU), for example, opposed the expansion of the Whois database functionality, and any standardization of Whois database operations, as constituting a threat to the privacy of users.[323] The ACLU also noted that the collection and free availability of personal data of registrants could stifle free speech by removing anonymity, and may expose users to unwanted commercial mail.

351. Concerns about privacy implications of the Whois system have focused on the possibility of misuse of such information.[324] In addressing this concern, it appears that a distinction needs to be drawn between privacy implications of individual queries and access to the Whois, and concerns regarding bulk access and transfer of mass data to compilers and resellers of registration information. As with all such technologies, it is necessary to find a balance between personal privacy, users' rights, commercial competition and functional DNS management requirements. It is proposed that users' privacy and security should be protected and registrants should be clearly informed what data will be collected, the purposes for which it is collected, and the uses to which it may be put. In each case, users should be required to give informed consent to the collection, storage and use of personal data within these parameters. Within each national territory, different cultural perspectives are found and varying legal standards apply under the relevant data protection laws. It is noted that most national laws designed to protect privacy do not restrict the making available of contact data pursuant to contractual agreement, or on the basis of a competing public interest of higher priority, such as consumer protection or law enforcement.[325]

352. It is recommended that principles of access to and use of Whois data should be codified, to take into account issues of data protection and privacy. Submissions are sought on this issue.

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323 See Comment of the American Civil Liberties Union (ACLU) (RFC2 – December 29, 2000).

324 For example, concerns were expressed in February 2001, that Network Solutions, Inc. (NSI), the principal registrar for 15 million .com non-individual registrations, was promoting the availability of their domain registration database of 5 million discrete commercial users' registrations, as well as related tracking services, for direct marketing uses. See NSI's 'Winning with Data from Network Solutions', at *http://www.dotcom.com/services/index.html*.

325 See 'Matters Related to WHOIS' *DNSO Intellectual Property Consituency*, March 3, 2000 – paper prepared for the ICANN meeting in Cairo, Egypt - at *http://ipc.songbird.com/Whois_paper.html*.

353. Comments are sought on whether a comprehensive Whois search facility raises particular privacy implications that need to be taken into account.

DIRECTORY AND GATEWAY SERVICES - TECHNICAL MEASURES FOR COEXISTENCE OF NAMES

354. Directory and listing services were described in the Report of the first WIPO Process as technical means to overcome the fact that, for operational reasons, a domain name must function as a unique address.[326] For names that are coveted by many, including trade names in different jurisdictions and fields of commerce, personal names, geographic terms or place names, this uniqueness means that only the first to come is served in obtaining a corresponding domain name in the DNS. Directory and listing services enable multiple users to coexist on the Internet by their listing on a portal or gateway page that corresponds to one Internet Protocol address, or domain name. Under one gateway, the user would find a list of related names that link to various addresses, as well as brief information sufficient to distinguish the addresses and their owners from each other. One example of such a service is offered by INternet One, that offers directory services for companies, trademarks and business names.[327]

355. Directory and listing services may ensure that an interested user can locate the exact address they seek, and were broadly supported by commentators to the first WIPO Process. The Report of that Process stated that these measures were voluntary and offered parties a good solution to settling a conflict, and noted considerable resistance by commentators to their mandatory application. For this reason, the Report recommended that the use of portals, gateways, or similar measures should be encouraged, but should not be compulsory.

356. Numerous commentators to RFC-2 suggested that directory services or gateway pages that allow multiple users and enterprises to be accessed via one domain name, offer a useful means to reduce tension between numerous legitimate users of the same sign.[328] One commentator suggested that such a service could be offered by the registry or a neutral third party, following an objection by one legitimate user of a sign to its registration by another legitimate user. It was suggested that such directory services would be ideal for use with names that, by their nature, cannot be monopolized by one entity, for example, for geographic indications, where a directory service could be run by the public authority with competence to administer the geographic region.[329]

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326 See Report of the first WIPO Process at paras. 124-128.

327 Refer to *http://www.io.io.*

328 See, for example, Comment of Susan Isiko (RFC1 – September 15, 2000). See also comments by Vinton Cerf that "[i]t may become essential to have a table look-up and directory service to decouple the web and trade marks" in J. Nurton and R. Cunningham 'Can technology tame the net? Profile : Vinton Cert, MCI Worldcom', *International Internet Law Review*, July-August 2000, at 14.

329 See Comment of Swiss Federal Institute of Intellectual Property (RFC2 – December 12, 2000).

NEW TECHNOLOGICAL DEVELOPMENTS

357. As a result of recent technical developments in Internet addressing architecture, the use of Common Name Resolution Protocol (CNRP) services were described by one commentator as being of potential, although unproven, assistance in guiding users to relevant sites.[330] The CNRP refers to an Internet namespace based on identifiers that are absolute, but not globally unique, because each Uniform Resource Indicator (URI) depends on each associated fileserver or nameserver.[331] In addition, one commentator noted that there is currently in development an improved version of the existing Net protocol, called Internet Protocol version 6 (IPv6). The IPv6 is designed to allow greater numerical space in the DNS by increasing Internet Protocol address size from 32 to 128 bits, to support more levels of addressing hierarchy, more addressable nodes, and simpler auto-configuration or encoding of addresses.[332] Whereas the current 32-bit addresses in IPv4 allow for more than 4 billion addresses, the 128-bit header in IPv6 vastly expands the range of possible addresses. This is significant, because half of the total of available IP addresses have already been assigned, and capacity is limited for future allocations.

358. There may also be scope for the development of mechanisms that will allow users to refer to a trademark or service mark directly, by keywords, without referring to a specific domain name or URL. Examples of such services are those operated RealNames[333] and by CommonName,[334] that register common names instead of Uniform Resource Locators (URLs) that may correspond to trademark owners' brands, enabling intuitive navigation to email addresses or web sites. Like the domain name system, keyword systems have intellectual property implications, some of which were discussed in the final paragraphs of the final Report of the first WIPO Process (under the heading "The Impact of New Navigational Measures"). As explained in the Report, "the practices and procedures on the basis of which

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330 See Comment of Alexander Svensson, icannchannel.de (RFC2 – December 21, 2000).

331 The Common Name Resolution Protocol (CNRP) is an interoperative Web technology under development by the World Wide Web Consortium (W3C) at *http://www.w3.org/*. For discussion of the CNRP, see *http://lists.w3.org/Archives/Public/xml-uri/2000May/0621.html*. The URI is a locator, a name, or both, a sequence of characters with a restricted syntax that is described as a "simple and extensible means for identifying a resource", as discussed in the Internet Engineering Taskforce RFC2396 (August 1998) at *http://www.ietf.org/rfc/rfc2396.txt*.

332 For a description of IPv6 and its capabilities, see Nick Montfort, "Breaking Protocol," *Wired Magazine*, 7.12, December 1999, at *http://www.wired.com/wired/archive/7.12/ipv6.html*, and Roderick Simpson, "Following Protocol", Wired Magazine, 6.08 – August 1998, at *http://www.wired.com/wired/archive/6.08/crucialtech.html?pg=8*. For a description of the technical specifications of IPv6, refer to the Internet Engineering Task Force RFC 2460 (December 1998) (at http://www.ietf.org/rfc/rfc2460.txt?number=2460) and for a discussion of IPv6 addressing architecture, refer to RFC 2373 (July 1998) at *(http://www.ietf.org/rfc/rfc2373.txt?number=2373)*. See also comment by Vinton Cerf in J. Nurton and R. Cunningham "Can technology tame the net? Profile: Vint Cerf, MCI Worldcom," *International Internet Law Review*, July-August 2000, at 14.

333 See *http://www.releases.com*.

334 See *http://www.commonname.com*.

persons or organizations obtain keywords and the manner in which keyword systems operate may well cause difficulties similar to those now encountered in relation to domain names."[335]

359. Further submissions are sought on new developments in technologies and services, such as those offering directory or listing services, or keyword functionality, in the DNS.

[Annexes follow]

335 The WIPO Arbitration and Mediation Center offers a Keyword Dispute Resolution Service corresponding to such systems, at *http://arbiter.wipo.int/keywords/*.