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INTERNET DOMAIN NAMES

Document prepared by the Secretariat

1. The WIPO General Assembly at its meeting in September 2001 decided (document WO/GA/27/8) that the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) was to hold two special sessions on the Report of the Second WIPO Internet Domain Name Process (the "Second Process Report"). At the same time it was decided that "[a] report of the two special sessions of the SCT should be prepared which presents the options for the treatment of the issues dealt with in the Second Process Report... [and which] should be transmitted to the meetings of the WIPO General Assembly in September 2002 for consideration and decision."
2. The first Special Session of the SCT was held from November 29 to December 4, 2001, and the second Special Session from May 21 to May 24, 2002. The reports of the first and second Special Sessions are contained in documents SCT/S1/6 and SCT/S2/8.
3. The present document constitutes the Report to the WIPO General Assembly on the work of the Special Sessions, as mandated by the General Assembly's decision of September, 2001.

Background

4. Following the approval of its Member States (documents A/33/4 and A/33/8), WIPO conducted the first WIPO Internet Domain Name Process (the "First WIPO Process") from

July 1998 until April 1999, which culminated in the publication of a Report dated April 30, 1999, entitled “The Management of Internet Names and Addresses: Intellectual Property Issues” (WIPO Publication No. 439; the “First Process Report”). The purpose of the First WIPO Process was to recommend measures aimed at reducing the friction which exists between the intellectual property system and the Domain Name System (DNS), with a particular focus on preventing and resolving conflicts between domain names and trademarks. The First Process Report contained a broad set of recommendations on how this could be achieved, the most important of which concerned the creation of a uniform procedure for the resolution of domain name disputes based on the allegation that the registration and use of a domain name constituted an abuse of a corresponding trademark. This recommendation, as well as several other recommendations contained in the First Process Report, were adopted by the Internet Corporation for Assigned Names and Numbers (ICANN) in August 1999 and constituted the basis for the Uniform Domain Name Dispute Resolution Policy (UDRP). The UDRP, which came into effect in December 1999, is now widely regarded as the primary means of combatting trademark cybersquatting in the generic Top-Level-Domains (gTLDs), with more than 6000 cases filed under it. Of those, more than 4000 have been filed with the WIPO Arbitration and Mediation Center, the leading dispute resolution service provider for the UDRP. The procedure also has increasingly gained ground in the country code Top-Level-Domains (ccTLDs), as many ccTLD administrators have adopted it, or a variation thereof, on a voluntary basis. To date, 25 administrators of ccTLDs have retained the WIPO Arbitration and Mediation Center as the dispute resolution service provider on the basis of the UDRP or a variation of the procedure. The ccTLDs in question are .AC (Ascension Island), .AE (United Arab Emirates), .AG (Antigua & Barbuda), .AS (American Samoa), .BS (Bahamas), .BZ (Belize), .CC (Cocos Islands), .CY (Cyprus), .EC (Ecuador), .FJ (Fiji), .GT (Guatemala), .LA (Lao People’s Democratic Republic), .MX (Mexico), .NA (Namibia), .NU (Niue), .PA (Panama), .PH (Philippines), .PN (Pitcairn Island), .RO (Romania), .SC (Seychelles), .SH (St. Helena), .TT (Trinidad and Tobago), .TV (Tuvalu), .VE (Venezuela) and .WS (Western Samoa). The WIPO Arbitration and Mediation Center has received more than eight hundred cases concerning registrations in the ccTLDs.

5. While the focus of the First WIPO Process was on the protection of trademarks in the DNS, it became apparent during the course of its conduct that a range of identifiers other than trademarks also were the subject of abuse in the DNS. Particular reference in this regard was made in the First Process Report to tradenames, geographical indications and personal names.¹

6. In June 2000, WIPO received a letter of request from the Government of Australia and 19 of its other member Governments to initiate a Second WIPO Process to address those intellectual property issues relating to Internet domain names that remained to be considered after the First WIPO Process. This initial request was later endorsed by the WIPO General Assembly (documents WIPO/GA/26/3 and WIPO/GA/26/10). In response to this request, in July 2000, WIPO commenced the Second WIPO Process. The issues covered by this Process concerned the bad faith, abusive, misleading or unfair registration, as domain names, of: (1) international nonproprietary names (INNs) for pharmaceutical substances, (2) trade names, (3) personal names, (4) names and acronyms of international intergovernmental organizations (IGOs) and (5) geographical identifiers, including geographical indications and country names. The Second WIPO Process also discussed the role of technical measures in alleviating intellectual property concerns in the DNS and focused in particular on WHOIS

¹ See paragraphs 167 and 168 of the First Process Report.

databases in this connection. The WHOIS system of databases is the collection of information concerning domain name registrants' contact details, as well as nominated technical and administrative contacts and associated technical data, which, in most cases, is publicly available online, for real-time searching by all enquirers.

7. The Second WIPO Process addressed the above issues through a process of consultations – conducted online and through in-person regional meetings – resulting in the Second Process Report, entitled “The Recognition of Rights and the Use of Names in the Internet Domain Name System” that was published on September 3, 2001 (WIPO Publication No. 843). The Report makes practical recommendations based on the consultation process, aimed at preventing and resolving domain name conflicts in relation to the identifiers covered by the Second WIPO Process. The Report was presented to WIPO's Member States and the Internet community, including ICANN. As mentioned in paragraph 1, above, at their meeting held from September 24 to October 3, 2001, the WIPO Member States decided subject the Second Process Report to a comprehensive analysis by the SCT, meeting in two Special Sessions for this purpose.

8. The remainder of this document summarizes the findings of the Second Process Report, as well as the discussions held at the first and second Special Session of the SCT, and sets out the recommendations made by the SCT on each of the topics concerned. It also discusses, where necessary, any issues in relation to those recommendations that remained outstanding after the two Special Sessions and require further consideration by the General Assembly.

International Nonproprietary Names (INNs) for Pharmaceutical Substances

9. The INN system is a naming system established pursuant to a Resolution of the World Health Organization (WHO) which operates to create a unique name for a new pharmaceutical substance. This unique name is intended to be generic, meaning that no proprietary rights should be attached to it, and that it should be free for use by all, as a means of enhancing the quality of medical services and the capacity of medical practitioners and patients around the world to be able to identify a new drug by reference to one specific generic name. Under the INN system, there is a consensus on the part of public health authorities and of the private sector that the names in question should not be registered or used as trademarks. The Second Process Report analyzed the evidence of bad faith registrations of INNs as domain names and found that there had been a number of INNs, particularly those with respect to very widely used drugs, that had been registered as domain names by various parties. It concluded that the registration of an INN as a domain name brings with it the consequence that that particular unique space in the DNS is controlled by one particular party, which may be considered to be inconsistent with the policy objectives underlying the INN system. The Second Process Report thus recommended that action be taken to protect INNs against their abusive registration as domain names. In particular, it recommended that any interested party should have the right to serve notice that a domain name registration in a gTLD is identical to an INN and that, upon verification of the exact similarity between the domain name registration and the corresponding INN by WIPO, in conjunction with WHO, notice to ICANN, and certification by ICANN to the registrar concerned, the domain name registrations should be cancelled.

10. While many delegations at the first Special Sessions supported the protection proposed for INNs in the First Process Report, several others remarked that insufficient problems had been experienced with INNs in the DNS to warrant the establishment of any protective

measures. After discussions, the Chair concluded that “[t]he majority of delegations considered that, in view of insufficient evidence of the abusive registration of INNs as domain names and of the harm resulting from the registration of INNs as domain names, no immediate action was necessary.”

11. At the second Special Session, a representative of the World Health Organization offered an extensive explanation of the background to and purpose of the protection of INNs, as well as why, in his Organization’s view, it would be appropriate to protect INNs against their registration as domain names. Several delegations reiterated their position that insufficient evidence had been presented of problems encountered. Others maintained the view that it would be opportune to provide protection for INNs in the DNS at this stage to safeguard against their potential abuse in the future. Certain delegations proposed that the situation continued to be monitored. After debate, the Chair concluded as follows:

“...[M]any delegations favored the protection of INNs in the Domain Name System against registration as domain names in order to protect the integrity of the INN system. While it was decided not to recommend a specific form of protection at this stage, it was agreed that the Secretariat should, in cooperation with the World Health Organization, continue to monitor the situation and, if necessary, bring to the attention of the Member States any material change in the situation.”

12. The Assemblies of the Member States of WIPO are invited to take a decision on the recommendation of the Special Session as contained in paragraph 11, above.

Trade Names

13. The Second Process Report investigated whether it would be opportune to expand the scope of the UDRP to cover also trade names. Although trade names benefit from protection at the international level under Article 8 of the Paris Convention, the Second Process Report did not recommend that the UDRP be modified to permit complaints to be made on the basis of abusive registrations and use of trade names *per se*. Reasons advanced in the Report in support of this recommendation included the diversity of national approaches in the protection of trade names, the lack of evidence of problems experienced in the DNS with respect to trade names *per se*, the fact that several registrants may have a legitimate interest in a trade name (as the burden for establishing the existence of a trade name is relatively light in many jurisdictions), and the fact that the principal users of trade names, small enterprises with often a local sphere of activities, might have difficulties establishing the conditions required to be met for receiving protection at the global level through the UDRP.

14. Several delegations at the first Special Session favored the extension of the UDRP to trade names. Several arguments were advanced in support of this position. First, it was observed that, while the UDRP applies to unregistered trademarks, it currently does not apply to trade names, although the international legal framework for the latter is more fully developed, taking into account Article 8 of the Paris Convention. Second, it was argued that not including trade names under the scope of the UDRP favors those countries which protect unregistered marks, to the detriment of those that do not. Third, it was also stated that including trade names as a basis for filing a complaint under the UDRP would make the procedure more accessible to small and medium-sized enterprises. Other delegations opposed

broadening the scope of the UDRP to tradenames. According to those delegations, such identifiers are already indirectly covered by the procedure, as they often also qualify as unregistered trademarks. The same delegations also were of the view that there is insufficient common understanding at the international level of the definition of tradenames to warrant their inclusion in the UDRP. After the discussions, the Chair noted that “[a] majority of delegations considered that tradenames should be protected against abusive domain name registrations through the UDRP. Certain delegations, however, opposed such an extension of the UDRP. It was decided to continue discussions on this question at the Second Special Session to see if an agreed position would be reached.”

15. The discussions at the second Special Session essentially reflected the same views as those expressed at the first Special Session, highlighting again the different legal traditions among countries with respect to the protection of tradenames and their relationship with (unregistered) trademarks. After the debate, the Chair observed that

“...[V]iews were divided as to whether the UDRP should be modified to accommodate tradenames. One group of countries wished to treat tradenames in the same manner as trademarks; others felt that there was no international accepted legal basis to underpin the extension.

“It was decided that Member States should keep the matter under review and raise the matter for further discussion if the situation so demanded.”

16. The Assemblies of the Member States of WIPO have reinvented to take a decision on the recommendation of the Special Session as contained in paragraph 15, above.

Personal Names

17. The cases that have been filed and determined under the UDRP have interpreted the meaning of trademark to extend, not only to registered trademarks, but also to unregistered or common law trademarks. In consequence, many individuals have used the UDRP in order to file cases for the abusive registration as domain names of their personal names. However, the Second Process Report noted two limitations to the use of the UDRP as a means of protecting personal names against abusive registration as domain names. The first limitation concerns those countries in which common law or unregistered trademark rights are not recognized. For these countries, the UDRP cannot be used to protect personal names against abusive registration as domain names, except insofar as the fame or reputation in commerce of the person in question may extend also to a country where unregistered or common law trademark rights are recognized, and which may therefore establish a trademark basis for protection. The second limitation is that personal names are only protected when they are used in commerce because this is the essential basis for a trademark right. The UDRP thus does not provide any protection for personal names that may have a certain reputation but which are not in any way commercialized, such as those of politicians or historical figures. In addition, the Second Process Report noted that there was, outside the trademark area, no international norms protecting personal names, and that, at the national level, there was a diversity of legal theories used in order to establish any legal protection that may exist for personal names. The Second Process Report concluded that, because of this diversity and because of the absence of any international norms outside the trademark area for the

protection of personal names, there should not be any modification of the UDRP in order to create specific protection for personal names.

18. Virtually all delegations at the first and second Special Sessions agreed with the findings of the Second Process Report and there was little, if any, support for providing protection to personal names in the eDNS, although certain delegations, particularly those from countries which do not recognize unregistered marks, were of the view that the issue was linked to the question of whether the UDRP would be expanded to cover trade names *per se*. At the end of the first Special Session, the Chair noted that “[T]he majority of delegations considered that no action was necessary on the protection of personal names, outside the existing UDRP, at this stage.” Likewise, the Report of the second Special Session concludes as follows:

“The Chair noted that the Special Session’s decision was that no action is recommended in this area .”

19. The Assemblies of the Member States of WIPO are invited to take a decision on the recommendation as contained in paragraph 18, above.

Names and Acronyms of International Intergovernmental Organizations (IGOs)

20. Names and acronyms of IGOs are protected by Article 6 *ter* of the Paris Convention and the Agreement on Trade -Related Aspects of Intellectual Property Rights (TRIPS Agreement), as well as by certain provisions in other international conventions which give specific protection to particular names of IGOs or names used internationally, such as Article 53 of the Geneva Convention prohibiting the use of the name “Red Cross.” Article 6 *ter* of the Paris Convention does not confer any automatic protection for the names and acronyms of IGOs, but requires a notification of the identifier for which protection is sought on the part of the IGO in question to WIPO, which notification is then communicated to the WIPO Member States. So far, 102 organizations have made such notifications, and therefore benefit from the protection under Article 6 *ter*. The protection under this provision extends to protection against any registration or use of a name and acronym of an IGO as a trademark, subject to the limitation that a Member State may impose the requirement that such use or registration be misleading or create a misleading association between the trademark in question and the name or acronym of the IGO. Considering that IGOs, under international law, benefit from immunity from national jurisdiction, the provisions of Article 6 *ter* of the Paris Convention are enforced mainly through the industrial property offices around the world to whom the notifications of registration under Article 6 *ter* are sent and it is those offices which ensure that no misleading registrations or uses of those protected names or acronyms as trademarks are permitted. In view of the well established international legal protection for the names and acronyms of IGOs, the Second Process Report recommended that there should be a special administrative procedure, similar to the UDRP, under which it would be possible for an IGO to file a complaint in order to have transferred or cancelled a domain name registration which constitutes a misleading use of a name or acronym of an IGO. The Second Process Report noted, however, that the recommended procedures should be different from the UDRP in light of the immunity of jurisdiction of IGOs. Noting that under the UDRP, any party to a proceeding may commence legal proceedings nationally either before, during or after a complaint has been filed, and that the complainant is required to submit to the jurisdiction of

national courts in certain designated localities, the Second Process Report recommended that those provisions should not apply in respect of complaints that might be brought by IGOs. In this connection, since the publication of the Second Process Report, there have been some further developments as to the possibility of creating an alternative right of recourse for domain name registrants, as explained further below.

21. Discussions at the first Special Session revealed that there was general support among many delegations for the principle of protecting the names and acronyms of IGOs in the DNS, although questions were raised whether the extent of problems encountered was sufficient to warrant the creation of such protection at this stage. The view was also expressed that establishing such special protection would amount to the creation of new international law and that safeguarding the immunities of IGOs, for reasons of due process, should not compromise the right of appeal of a domain name registrant. The Chair concluded as follows: “The majority of delegations expressed interest in accordingsome protection to the names and acronyms of IGOs against abusive registration as domain names, but considered that further work was needed to identify the way in which any such protection might function. The Special Session asked the Secretariat to consult with other IGOs to provide evidence of the extent of problems encountered with the abusive registration of names and acronyms of IGOs as domain names. Such evidence should be presented to the Second Special Session. In addition, the Special Session asked the Secretariat to provide a paper giving details of how any proposed protection of names and acronyms of IGOs would function in practice.”

22. After the first Special Session, the Secretariat liaised, in particular, with the Legal Advisers of the United Nations System, the International Federation of Red Cross and Red Crescent Societies, the International Committee of the Red Cross and the Organisation for Economic Cooperation and Development with a view to the collection of further evidence of the abusive registration of the names and acronyms of IGOs as domain names and the resulting harm for users and the organizations affected. As a result of these initiatives, the Secretariat received three papers from the organizations in question concerning their experience with abusive domain name registrations. The first paper (document SCT/S2/INF/4) by Mr. Hans Corell, Under-Secretary-General for Legal Affairs and Legal Counsel of the United Nations was submitted on behalf of the Legal Advisers of the following Organizations and Programs of the United Nations System: the United Nations Organization, the Food and Agricultural Organization of the United Nations, the International Bank for Reconstruction and Development/International Development Association, the International Civil Aviation Organization, the International Finance Corporation, the International Fund for Agricultural Development, the International Labour Organisation, the International Maritime Organization, the International Monetary Fund, the International Telecommunications Union, the United Nations Educational, Scientific and Cultural Organization, the United Nations Industrial Development Organization, the Universal Postal Union, the World Health Organization, the World Intellectual Property Organization, the World Meteorological Organization, the International Atomic Energy Agency, the World Trade Organization, the Organization for the Prohibition of Chemical Weapons, the Preparatory Commission for the Comprehensive Nuclear-Test-Ban Treaty Organization, the Bank for International Settlements, the International Organization for Migration, and the Secretariat of the Convention for Climate Change. The second paper (SCT/S2/INF/3) was a joint submission by the International Federation of Red Cross and Red Crescent Societies and the International Committee of the Red Cross on their experience with abusive domain name registrations. The third paper (SCT/S2/INF/2) was submitted by the Organisation for Economic Cooperation and Development (OECD).

23. Discussions on the topic of the protection of the names and acronyms of IGOs at the second Special Session were based on document SCT/S2/2, prepared by the Secretariat, and the papers of the IGOs referred to above. Discussions were opened by a statement by Mr. Corell on behalf of the Legal Advisers of the United Nations System, the text of which is reproduced in Annex I to the Report of the second Special Session (document SCT/S2/8).

24. Particularly in light of the evidence of problems revealed in the papers prepared by the IGOs and the statement of Mr. Corell, all delegations at the second Special Session, except one, agreed that an administrative mechanism should be established aimed at protecting the names and acronyms of IGOs against their abuse in the DNS. In terms of which conduct would be deemed abusive, discussions centered on the language of Article 6 *ter* of the Paris Convention. On the question of how to safeguard the immunities of IGOs, document SCT/S2/2 proposed that the *de*-consideration of any cases brought under the procedure should be achieved through an agreed recourse to binding arbitration, incorporated into the administrative procedure, it being noted that this was the normal procedure used with respect to disputes involving IGOs. Delegations discussed this proposal and generally found it to be an appropriate solution to the immunities problem, notably because the recourse procedure would take the form of binding arbitration and therefore would benefit from the due progress safeguards provided by the New York Convention on the Recognition and Enforcement of Foreign Arbitral Awards (1958). The Special Session concluded as follows on the topic of the protection of the names and acronyms of IGOs in the DNS:

“Noting, in particular, Article 6 *ter* of the Paris Convention, to which 163 States are party,

“1. The Special Session recommends that the UDRP be modified to provide for complaints to be filed by an international intergovernmental organization (IGO)

“A. on the ground that the registration or use, as a domain name, of the name or abbreviation of the IGO that has been communicated under Article 6 *ter* of the Paris Convention is of a nature

(i) to suggest to the public that a connection exists between the domain name holder and the IGO; or

(ii) to mislead the public as to the existence of a connection between the domain name holder and the IGO; or

“B. on the ground that the registration or use, as a domain name, of a name or abbreviation protected under an international treaty violates the terms of that treaty.

“2. The Special Session further recommends that the UDRP should also be modified, for the purposes of complaints mentioned in paragraph 1, to take account of and respect the privileges and immunities of IGOs in international law. In this respect, IGOs should not be required, in using the UDRP, to submit to the jurisdiction of national courts. However, it should be provided that decisions given in a complaint filed under the modified UDRP by an IGO should be subject, at the request of either party to the dispute, to *de novo* review through binding arbitration.

“3. The Delegation of the United States of America dissociated itself from this recommendation.”

25. An example of a treaty referred to in paragraph 1, B of the above recommendation is the Geneva Convention for the amelioration of the condition of the wounded and sick in armed forces, of August 12, 1949.²

26. *The Assemblies of the Member States of WIPO are invited to take a decision on the recommendation as contained in paragraph 24, above.*

Country Names

27. The Second Process Report noted that a large number of country names 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 and that, in most such cases, the registrant is a private person or entity that is unconnected to the government of the country whose name has been registered. The Report further observed that the question of the appropriateness of the registration of country names as domain names is inextricably linked by some governments to what they perceive to be their national sovereign interest. After an examination of both the text and the negotiating history of Article 6 *ter* of the Paris Convention, the Second Process Report concluded that there exists no statutory legal protection at an international level for country names. That being the case, the Report recommended that the question of the protection in the gTLDs of country names be further considered in the appropriate intergovernmental fora, in particular with a view to a discussion on the need for new international rules for the protection of country names.

28. Although it was generally recognized that country names should not be imbued with intellectual property status, most delegations at the first Special Session were of the view that some protection against their abuse in the DNS should be created, while a number of other delegations opposed the creation of such protection. In terms of the modalities of any protection that could be granted, discussions centered on the question of how to determine the correct designation of a country's name. Reference was made in this regard in particular to two instruments, namely the United Nations Terminology Bulletin No. 347/Rev. 1 (the “UN Bulletin”) and the International Standard ISO 3166-1 on Country Codes (the “ISO Standard”). The question also was discussed of whether protection should be granted only in relation to domain names that replicate exactly country names or also in relation to those that constitute misleading variations of such names. At the end of the discussions, the Chair noted that “[m]ost delegations favoured some form of protection for country names against registration by parties unconnected with the constitutional authorities of the country in question. However, it was recognized that many details of any such protection were unclear. It was decided that delegations should be invited to submit comments on [a number of specific

² The first paragraph of Article 53 of this Convention, to which 189 States are party, stipulates as follows: “The use by individuals, societies, firms or companies either public or private, other than those entitled thereto under the present Convention, of the emblem or the designation ‘Red Cross’ or ‘Geneva Cross,’ or any sign or designation constituting an imitation thereof, whatever the object of such use, and irrespective of the date of its adoption, shall be prohibited at all times.”

issues concerning the modalities of the possible protection of country names] to the Secretariat... and that the Secretariat should prepare a paper on the basis of comments received for distribution before the second Special Session and for consideration by that Session.³”

29. On December 19, 2001, the Secretariat transmitted to the 178 Member States of WIPO, the Member States of the Paris Union, the Member States of the United Nations agencies, as well as to the intergovernmental and non-governmental organizations accredited with observer status at WIPO the specific issues referred to above. Thirty governments and six organizations submitted comments to the Secretariat. A large majority of these commentators were in favor of protecting country names in the DNS, some arguing that “[t]here is a need to afford protection against the use of domain names which might imply official use or endorsement where no such use or endorsement exists.” A minority of commentators, however, opposed such protection. A detailed overview of the comments received by the Secretariat is contained in document SCT/S2/3.

30. Special protective measures for country names in relation to the .INFO top level domain have in the meantime also been taken by ICANN. Those measures are described in document SCT/S2/4.

31. Discussions on the topic of the protection of country names at the second Special Session were based on document SCT/S2/3. With regard to the principle of introducing protection for country names in the DNS, discussions reflected the balance of views expressed in the written comments received by the Secretariat, with a majority in favor of such protection and a minority against. The delegations which opposed the protection in question, argued that the terms in question are generic and should therefore remain free for use, also as (part of) trademarks, and that any special protection for these terms in the DNS would amount to the creation of new law. The same delegations were of the view that other means were available to redress any abuse that may exist in the DNS in relation to these terms, for instance, through reliance on certain provisions contained in TLD domain name registration agreements, the special protective measure taken by ICANN in relation to .INFO, and the creation of a new official top-level domain for government use. With regard to the modalities of any protection that might be envisaged, discussions at the second Special Session focused on whether the protection should be instituted through an administrative challenge procedure similar to the UDRP or an exclusion mechanism (or a combination of both), whether country names should be identified by reference to the UN Bulletin or the ISO Standard (and whether any names, which do not appear on either of these lists, but by which countries are commonly known, also should be protected), whether protection should be aimed at curbing abusive behavior or whether conflicts between parties acting in good faith also should be covered, the languages in which the protection should be offered, and whether the protection should be granted only in relation to domain names that replicate exactly country names or also to those that are misleadingly similar. In case the protection that might be created was to focus in particular on bad faith behavior, it was also discussed what the appropriate definition of such bad faith conduct might be. The discussion in this connection centered on the proposed language contained in paragraph 35 of document SCT/S2/3. After extensive discussion, the Chair concluded as follows:

³ Paragraph 132 of document SCT/S1/6 lists the questions concerned.

“1. Most delegations favored some form of protection for country names against registration or use by persons unconnected with the constitutional authorities of the country in question.

“2. As regards the details of the protection, delegations supported the following:

(i) A new list of the names of countries should be drawn up using the UN Bulletin and, as necessary, the ISO Standard (it being noted that the latter list includes the names of territories and entities that are not considered to be States in international law and practice). Both the long or formal names and the short names of countries should be included, as well as any additional names by which countries are commonly known and which they notify to the Secretariat before June 30, 2002.

(ii) Protection should cover both the exact names and misleading variations thereof.

(iii) Each country name should be protected in the official language(s) of the country concerned and in the six official languages of the United Nations.

(iv) The protection should be extended to all top-level domains, both gTLDs and ccTLDs.

(v) The protection should be operative against the registration or use of a domain name which is identical or misleadingly similar to a country name, where the domain name holder has no right or legitimate interest in the name and the domain name is of a nature that is likely to mislead users into believing that there is an association between the domain name holder and the constitutional authorities of the country in question.

“3. The Delegations of Australia, Canada and the United States of America dissociated themselves from this recommendation.”

32. Two questions regarding the above recommendation warrant further clarification: (1) which list of country names is to be relied upon for the purpose of providing protection, and (2) how are acquired rights to be dealt with?

Which list of country names is to be relied upon for the purpose of providing protection?

33. With respect to the basis for identifying the country names which would benefit from the protection envisaged, the recommendation of the second Special Session states as follows: “A new list of the names of countries should be drawn up using the UN Bulletin and, as necessary, the ISO Standard (it being noted that the latter list includes the names of territories and entities that are not considered to be States in international law and practice). Both the long or formal names and the short names of countries should be included, as well as any additional names by which countries are commonly known and which they notify to the Secretariat before June 30, 2002.”

34. This language and, in particular the terms “as necessary,” are the result of extensive discussion among delegations at the second Special Session regarding the question of whether the UN Bulletin or the ISO Standard would constitute the appropriate instrument for

identifying country names. It appeared, at this session, that a majority of delegations favored relying solely on the UN Bulletin, while a minority also wished to make use of the ISO Standard. The latter group comprised a number of delegations from countries certain territorial subdivisions of which are listed separately in the ISO Standard, but not in the UN Bulletin. Reliance on the ISO Standard would have the advantage for those countries of achieving protection also for the names of these territorial subdivisions, in addition to the names of the countries themselves.

35. If the General Assembly were to decide to adopt the recommendation of the Special Session regarding country names, it would be important, from the point of view of the practical implementation of such a recommendation, that the General Assembly specify its preference with regard to the exact scope of the protection envisaged. In this regard, a distinction need to be made between two separate, but interrelated issues: on the one hand, the question of which territorial entities should receive protection and, on the other, how the names of the entities which are to receive protection should be identified.

36. On the question of which territorial entities are to be protected, the choice is whether protection should extend only to States or should cover also territorial entities which are not considered States. If the General Assembly were to decide that protection should be restricted to States, it is proposed that membership of the United Nations be regarded as determinative in this connection. If the General Assembly were to decide that protection should extend also to other territorial entities, it would be important that it also decide which of these entities should be covered.

37. If the General Assembly were to decide that the protection envisaged should only extend to States, the question remains which instruments should be relied upon to identify the names of the States in question. Discussions at the first and second Special Sessions have centered on two possible instruments in this connection: the UN Bulletin and the ISO Standard. Considering the various points of view advanced by delegations at these second Special Sessions, the Secretariat, while recognizing that the ISO Standard has a long tradition of use in the Internet community, has come to the view that the more appropriate approach would be to rely on the UN Bulletin. The UN Bulletin is the generally accepted reference document for terminology on country names in the international political and legal arena. Several delegations at these second Special Sessions have emphasized that this was an extremely delicate matter within their country and that it would befit WIPO, as a specialized agency of the United Nations, to comply with the UN Bulletin. If the General Assembly were to decide that the protection should extend to States only, but nonetheless would prefer to rely on the ISO Standard for this purpose, only the names of those entities appearing on the ISO Standard which correspond to States that are members of the United Nations would be retained. If the General Assembly were to decide that the protection envisaged should extend to territorial entities other than States and reliance on the ISO Standard would be considered in this connection, it would be important to note that the ISO Standard lists a number of territorial subdivisions of certain States, while it does not list similar territorial subdivisions of other States. Reliance on the ISO Standard therefore would lead to unequal treatment of States, as some would receive protection for certain of their territorial subdivisions, while others would not.

How to deal with acquired rights?

38. The recommendation of the Special Session states that the protection for country names “should be extended to all top-level domains, both gTLDs and ccTLDs,” implying that existing registrations also could be affected. This raises the question of how acquired rights in those registrations should be treated. As there was relatively little discussion of this issue at the second Special Session, it may be useful to recall certain observations in this connection with a view to facilitating the decision of the General Assembly on the recommendation of the Special Session.

39. Many comments were made by governments on the question of acquired rights as part of the submissions received by the Secretariat in response to its questionnaire referred to in paragraph 29 above. As reflected in document SCT/S2/3, a majority of commentators was of the view that the solution to this problem resides in restricting the application of any protection measures that may be adopted to bad faith registrations. According to this view, no rights could be acquired in a domain name which was registered in bad faith, and, consequently, there would be no injustice if such domain names were to be taken away from the registrant. In the case of good faith registrations, certain commentators proposed the introduction of transition periods during which existing domain name holders could promote alternative web addresses before the transfer of the domain name to the relevant country, or the payment of compensation.

40. Bad faith conduct with respect to country names in the DNS is defined by the recommendation of the second Special Session as “the registration or use of a domain name which is identical or misleadingly similar to a country name, where the domain name holder has no right or legitimate interest in the name and the domain name is of a nature that is likely to mislead users into believing that there is an association between the domain name holder and the constitutional authorities of the country in question.”

41. The Assemblies of the Member States of WIPO are invited to take a decision on the recommendation as contained in paragraph 31, above.

As part of that decision, the Assemblies of the Member States of WIPO also are invited to decide:

(i) whether the protection envisaged should extend to States that are members of the United Nations only or also to other territorial entities and, if the latter, to which such entities; and

(ii) whether the UN Bulletin or the eISO Standard is to be used as the basis for identifying the names to be protected; and

(iii) whether the names by which countries are commonly known and which

have been notified to the Secretariat before June 30, 2002, also should receive protection; and

(iv) whether or not registrants who are found to have acted in bad faith, in accordance with the standard set out in paragraph 40 above, should be allowed to maintain their registrations.

Geographical Indications

42. A number of norms are contained in international treaties, in particular the Paris Convention and the TRIPS Agreement, which protect geographical indications. The Second Process Report pointed to the difficulties perceived with respect to the modification of the UDRP to accommodate the abuse of geographical indications through domain name registrations. These difficulties concern, in particular, the lack of an international mechanism for recognition of what constitutes a geographical indication and the fact that the existing international norms relate to trade and goods, whereas domain name registrations have a greater scope than simply trade and goods. In light of those difficulties, the Second Process Report recommended that no modification be made to the UDRP, at this stage, to permit complaints to be made concerning the registration and use of domain names in violation of the rules relating to the protection of geographical indications.

43. Discussions at the first Special Session reflected a division of views on the appropriateness of creating protection for geographical indications in the DNS. On the one hand, a group of countries noted that there exists a practice of abusing geographical indications in the DNS and was of the view that the international legal framework regarding geographical indications is sufficiently well developed to constitute a legal basis for establishing the protection in question. On the other hand, a group of countries believed that this legal framework is not sufficiently well developed and that subjecting geographical indications to the UDRP would lead panelists to develop undesired new law. Despite extensive discussions at the first Special Session, no progress was made in bridging this divergence of opinion. At the end of the first Special Session, the Chair consequently noted that “[v]iews on the question were divided. Whilst more delegations favored the modification of the UDRP to allow protection for geographical indications than those who opposed such a modification, no agreement had been reached. Accordingly, it was decided to continue discussions on the issue at the second Special Session to examine the many useful questions raised. Any delegation would be free to submit comments or papers for consideration before the second Special Session.”

44. At the second Special Session, delegations essentially reiterated their positions as reflected above. Those delegations in favor of protecting geographical indications in the DNS noted the urgency of the matter and requested that discussions continue in order to find a solution to the problems that are being encountered. Those that did not favor such protection stated that, while they agreed to continue discussing the matter, those discussions should focus first on a number of fundamental issues concerning geographical indications, before turning attention to their protection in the DNS. Finally, the Special Session:

“(i) Decided that it was not timely to take definitive decisions with respect to the protection of geographical indications in the Domain Name System.

“(ii) Noted that some delegations considered that the issue needed urgent attention, while others considered that a number of fundamental questions concerning the protection of geographical indications needed to be resolved before the question of their protection in the Domain Name System could be discussed.

“(iii) Recommend[ed] that the WIPO General Assembly revert this issue to the regular session of the SCT to decide how the issue of the protection of geographical indications in the Domain Name System be dealt with.”

45. The Assemblies of the Member States of WIPO are invited to take a decision on the recommendation as contained in paragraph 44, above.

Other Matters

46. The First Process Report emphasized the importance of the accuracy of registrant contact information contained in the WHOIS databases for the purpose of enforcing intellectual property rights in the Domain Name System.⁴ In particular, the Report recommended that “that the domain name registration agreement 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.”⁵ The same Report further recommended that “a take-down procedure be implemented whereby, upon service of a notification by an interested third party . . . , and upon independent verification of the unreliability of the contact details in question, the registrar would be required to cancel the corresponding domain name registration.”⁶ The importance of WHOIS databases for protecting intellectual property in the DNS was again emphasized in the Second Process Report.⁷

47. While the registration agreements which ICANN has required registrars to adopt in the gTLDs contain provisions obliging domain name registrants to provide accurate contact details for WHOIS purposes, it appears that insufficient attention has been devoted to compliance with such provisions. The problems which such lack of compliance entail are illustrated in the paper which was prepared by the OECD for consideration of the second Special Session (document SCT/S2/INF/2). Delegations at the second Special Session generally expressed concern regarding this situation and adopted the following statement in connection therewith:

⁴ See paragraphs 58 through 90 of the First Process Report.

⁵ See paragraph 119 of the First Process Report.

⁶ See paragraph 123 of the First Process Report.

⁷ See paragraphs 321 through 345 of the Second Process Report.

“With respect to other available means of addressing abusive domain name registrations, the Meeting supported the remarks made by the OECD..., and made by other delegations, in relation to the accuracy and integrity of WHOIS databases.”

48. The Assemblies of the Member States of WIPO are invited to take a decision on whether to support the statement as contained in paragraph 47, above.

A Possible Amendment of the UDRP

49. To illustrate the principal changes that would be required to broaden the scope of the UDRP in order that it may function as a vehicle for the protection of the names and acronyms of IGOs and the names of countries, as recommended by the Special Session, the Secretariat attaches to this document, as an Annex, are -draft of the UDRP incorporating a number of new provisions aimed at providing the protection in question (changes compared to the original version are underlined).

50. The Assemblies of the Member States of WIPO are invited to note and comment on the proposed possible amendment to the UDRP, as reflected in the Annex.

[Annex follows]

ANNEX

Uniform Domain Name Dispute Resolution Policy

(As Approved by ICANN on October 24, 1999)

1. *Purpose.* This Uniform Domain Name Dispute Resolution Policy (the "Policy") has been adopted by the Internet Corporation for Assigned Names and Numbers ("ICANN"), is incorporated by reference into your Registration Agreement, and sets forth the terms and conditions in connection with a dispute between you and any party other than us (the registrar) over the registration and use of an Internet domain name registered by you. Proceedings under Paragraph 4 of this Policy will be conducted according to the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules of Procedure"), which are available at www.icann.org/udrp/udrp-rules-24oct99.htm, and these selected administrative-dispute-resolution service provider's supplemental rules.

2. *Your Representations.* By applying to register a domain name, or by asking us to maintain or renew a domain name registration, you hereby represent and warrant to us that (a) the statements that you made in your Registration Agreement are complete and accurate; (b) to your knowledge, the registration of the domain name will not infringe upon or otherwise violate the rights of any third party; (c) you are not registering the domain name for an unlawful purpose; and (d) you will not knowingly use the domain name in violation of any applicable laws or regulations. It is your responsibility to determine whether your domain name registration infringes or violates someone else's rights.

3. *Cancellations, Transfers, and Changes.* We will cancel, transfer or otherwise make changes to domain name registrations under the following circumstances:

- (a) subject to the provisions of Paragraph 8, our receipt of written or appropriate electronic instructions from you or your authorized agent to take such action;
- (b) our receipt of an order from a court or arbitral tribunal, in each case of competent jurisdiction, requiring such action; and/or
- (c) our receipt of a decision of an Administrative Panel requiring such action in any administrative proceeding to which you were a party and which was conducted under this Policy or a later version of this Policy adopted by ICANN. (See Paragraph 4(i) and (k) below).

We may also cancel, transfer or otherwise make changes to a domain name registration in accordance with the terms of your Registration Agreement or other legal requirements.

4. *Mandatory Administrative Proceeding*

This Paragraph sets forth the type of disputes for which you are required to submit to a mandatory administrative proceeding. These proceedings will be conducted before one of the administrative-dispute-resolution service providers listed at www.icann.org/udrp/approved-providers.htm (each, a "Provider").

(a) *Applicable Disputes* You are required to submit to a mandatory administrative proceeding in the event that a third party (a "complainant") asserts to the applicable Provider, in compliance with the Rules of Procedure,

1. that

(i) your domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and

(ii) you have no rights or legitimate interests in respect of the domain name; and

(iii) your domain name has been registered and is being used in bad faith;

or

2. that your registration or use, as a domain name

(i) of the name or abbreviation of the complainant, which is an international intergovernmental organization that has communicated its name or abbreviation under Article 6ter of the Paris Convention, is of a nature to suggest to the public that a connection exists between you and the complainant, or to mislead the public as to the existence of a connection between you and the complainant; or

(ii) of the name or abbreviation of the complainant, which is protected under an international treaty, violates the terms of that treaty;

or

3. that

(i) your domain name is identical or confusingly similar to a name of a country appearing on [pre-determined list of country names in the official languages of the countries concerned and in the six official languages of the United Nations] of which the complainant is the Government; and

(ii) you have no rights or legitimate interests in respect of the domain name; and

(iii) the domain name is of a nature that is likely to mislead users into believing that there is an association between you and the constitutional authorities of the country in question.

In the administrative proceeding, the complainant must prove that each of the elements identified in Paragraph 4(a)(1),(2) or (3) a represent.

(b) *Evidence of Registration and Use in Bad Faith*. For the purposes of Paragraph 4(a)(1)(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 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 website or other on-line location, by creating a likelihood of confusion with the complainant's mark to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location.

(c) *How to Demonstrate Your Rights and Legitimate Interests in the Domain Name in Responding to a Complaint*. When you receive a complaint, you should refer to Paragraph 5 of the Rules of Procedure in determining how your response should be prepared. Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of Paragraph 4(a)(1)(ii) and 4(a)(3)(ii):

(i) before any notice to you of the dispute, your use of, or demonstrable preparation to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or

(ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

(d) *Selection of Provider*. The complainant shall select the Provider from among those approved by ICANN by submitting the complaint to that Provider. The selected Provider will administer the proceeding, except in cases of consolidation as described in Paragraph 4(f).

(e) *Initiation of Proceeding and Process and Appointment of Administrative Panel*. The Rules of Procedure state the process for initiating and conducting a proceeding and for appointing the panel that will decide the dispute (the "Administrative Panel").

(f) *Consolidation*. In the event of multiple disputes between you and a complainant, either you or the complainant may petition to consolidate the disputes before a single Administrative Panel. This petition shall be made to the first Administrative Panel appointed to hear a pending dispute between the parties. This Administrative Panel may consolidate before it any or all such disputes in its sole discretion, provided that the disputes being consolidated are governed by this Policy or a later version of this Policy adopted by ICANN.

(g) *Fees*. All fees charged by a Provider in connection with any dispute before an Administrative Panel pursuant to this Policy shall be paid by the complainant, except in cases where you elect to expand the Administrative Panel from one to three panelists as provided in Paragraph 5(b)(iv) of the Rules of Procedure, in which case all fees will be split evenly by you and the complainant.

(h) *Our Involvement in Administrative Proceedings*. We do not, and will not, participate in the administration or conduct of any proceeding before an Administrative Panel. In addition, we will not be liable as a result of any decisions rendered by the Administrative Panel.

(i) *Remedies*. The remedies available to a complainant pursuant to any proceeding before an Administrative Panel shall be limited to requiring the cancellation of your domain name or the transfer of your domain name registration to the complainant.

(j) *Notification and Publication*. The Provider shall notify you of any decision made by an Administrative Panel with respect to a domain name you have registered with us. All decisions under this Policy will be published in full over the Internet, except when an Administrative Panel determines in an exceptional case to redact portions of its decision.

(k) *Availability of Court Proceedings*. Except in the case of a complainant which is an international intergovernmental organization benefiting from immunity from

jurisdiction under international law, the mandatory administrative proceeding requirements set forth in Paragraph 4 shall not prevent either you or the complainant from submitting the dispute to a court of competent jurisdiction for independent resolution before such mandatory administrative proceeding is commenced or after such proceeding is concluded. If an Administrative Panel decides that your domain name registration should be canceled or transferred, we will wait ten (10) business days (as observed in the location of our principal office) after we are informed by the applicable Provider of the Administrative Panel's decision before implementing that decision. We will then implement the decision unless we have received from you during that ten (10) business day period official documentation (such as a copy of a complaint, file-stamped by the clerk of the court) that you have commenced a lawsuit against the complainant in a jurisdiction to which the complainant has submitted under Paragraph 3(b)(xiii) of the Rules of Procedure, or, in the case of a complainant which is an international intergovernmental organization benefiting from immunity from jurisdiction under international law, that you have commenced arbitration proceedings against the complainant in accordance with [relevant paragraph of the Rules of Procedure]. (In general, the jurisdiction to which the complainant has submitted under Paragraph 3(b)(xiii) of the Rules of Procedure is either the location of our principal office or of your address as shown in our WHOIS database. See Paragraphs 1 and 3(b)(xiii) of the Rules of Procedure for details). If we receive such documentation within the ten (10) business day period, we will not implement the Administrative Panel's decision, and we will take no further action, until we receive (i) evidence satisfactory to us of a resolution between the parties; (ii) evidence satisfactory to us that your lawsuit or the arbitration has been dismissed or withdrawn; or (iii) a copy of a court order or arbitration decision dismissing your complaint or ordering that you do not have the right to continue to use your domain name.

5. *All Other Disputes and Litigation*. All other disputes between you and any party other than us regarding your domain name registration that are not brought pursuant to the mandatory administrative proceeding provisions of Paragraph 4 shall be resolved between you and such other party through any court, arbitration or other proceeding that may be available.

6. *Our Involvement in Disputes*. We will not participate in any way in any dispute between you and any party other than us regarding the registration and use of your domain name. You shall not name us as a party or otherwise include us in any such proceeding. In the event that we are named as a party in any such proceeding, we reserve the right to raise any and all defenses deemed appropriate, and to take any other action necessary to defend ourselves.

7. *Maintaining the Status Quo*. We will not cancel, transfer, activate, deactivate, or otherwise change the status of any domain name registration under this Policy except as provided in Paragraph 3 above.

8. *Transfers During a Dispute*

(a) *Transfers of a Domain Name to a New Holder*. You may not transfer your domain name registration to another holder (i) during a pending administrative proceeding brought pursuant to Paragraph 4 or for a period of fifteen (15)

business days (as observed in the location of your principal place of business) after such proceeding is concluded; or (ii) during a pending court proceeding or arbitration commenced regarding your domain name unless the party to whom the domain name registration is being transferred agrees, in writing, to be bound by the decision of the court or arbitrator. We reserve the right to cancel any transfer of a domain name registration to another holder that is made in violation of this subparagraph.

(b) *Changing Registrars*. You may not transfer your domain name registration to another registrar during a pending administrative proceeding brought pursuant to Paragraph 4 or for a period of fifteen (15) business days (as observed in the location of your principal place of business) after such proceeding is concluded. You may transfer administration of your domain name registration to another registrar during a pending court action or arbitration, provided that the domain name you have registered with us shall continue to be subject to the proceedings commenced against you in accordance with the terms of this Policy. In the event that you transfer a domain name registration to us during the pendency of a court action or arbitration, such dispute shall remain subject to the domain name dispute policy of the registrar from which the domain name registration was transferred.

9. *Policy Modifications*. We reserve the right to modify this Policy at any time with the permission of ICANN. We will post our revised Policy at <URL> at least thirty (30) calendar days before it becomes effective. Unless this Policy has already been invoked by the submission of a complaint to a Provider, in which event the version of the Policy in effect at the time it was invoked will apply to you until the dispute is over, all such changes will be binding upon you with respect to any domain name registration dispute, whether the dispute arose before, on or after the effective date of our change. In the event that you object to a change in this Policy, your sole remedy is to cancel your domain name registration with us, provided that you will not be entitled to a refund of any fees you paid to us. There is no appeal. This Policy will apply to you until you cancel your domain name registration.

[End of Annex and of document]