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MATTERS CONCERNING INTERNET DOMAIN NAMES

Document prepared by the Secretariat

Introduction

1. The Internet Domain Name System (DNS) has given rise to a number of intellectual property problems, which, due to the global nature of the Internet, call for an international approach. Through the First¹ and Second² WIPO Internet Domain Name Processes, WIPO has identified challenges for the protection of intellectual property within the DNS and has recommended solutions for these challenges. Through its Arbitration and Mediation Center, WIPO has established a procedural framework that provides trademark owners with efficient remedies against the bad-faith registration and use of domain names corresponding to their trademark rights.

2. This document provides an update on the domain name-related activity of WIPO, including the status of the recommendations made by the Member States in the context of the Second WIPO Internet Domain Name Process.

Domain Names and Trademarks

3. The WIPO Arbitration and Mediation Center (Center) administers dispute resolution procedures under the Uniform Domain Name Dispute Resolution Policy (UDRP), which was adopted by the Internet Corporation for Assigned Names and Numbers (ICANN) on the basis of the recommendations made by WIPO in the First WIPO Internet Domain Name Process. The UDRP is without prejudice to parties' right to submit their disputes to competent courts of justice and is limited to clear cases of bad faith, abusive registration and use of domain names.

4. The Center was the first domain name dispute resolution service provider under the UDRP and has created a framework for its successful operation. Since December 1999, the Center has processed over 6,000 cases covering more than 10,000 separate domain names and involving parties from 116 countries. Currently, the Center receives on average approximately three new cases per calendar day. In function of the language of the applicable registration agreement of the domain name at issue, WIPO UDRP proceedings have been conducted in 11 different languages, namely, Chinese, English, French, German, Italian, Japanese, Korean, Norwegian, Portuguese, Russian and Spanish. The WIPO List of Domain Name Panelists who decide UDRP cases includes trademark experts from 50 countries in all continents.³

5. WIPO has made numerous contributions to help ensure fair and transparent UDRP procedures, notably a searchable legal index that provides parties and panelists with

¹ *The Management of Internet Names and Addresses – Final Report of the WIPO Internet Domain Name Process*, WIPO publication No. 439, also available at <http://wipo2.wipo.int/process1/report>.

² *The Recognition of Rights and the Use of Names in the Internet Domain Name System – Report of the Second WIPO Internet Domain Name Process*, WIPO Publication No. 843, also available at <http://wipo2.wipo.int/process2/report>.

³ See the WIPO List of Domain Name Panelists at <http://arbiter.wipo.int/domains/panel/panelists.html>.

categorized access to all UDRP decisions rendered by WIPO panels.⁴ This often consulted database offers extensive insight in the practices and principles being applied to the interface between domain names and trademarks.

6. While the mandatory application of the UDRP is limited to domain names registered in the generic Top Level Domains (gTLDs), such as .biz, .com, .info, .net and .org, the Center also assists many country-code top level domain (ccTLD) registries in their establishment of registration conditions and dispute resolution procedures that conform with international standards of intellectual property protection. These procedures are mostly modeled after the UDRP, but may take account of the particular circumstances and needs of individual ccTLDs. As at June 2004, the Center provides domain name dispute resolution services to 42 ccTLD registries.⁵

7. It's expertise in the area of domain name dispute resolution has also enabled the Center to administer more than 15,000 cases filed under different dispute resolution policies developed by the operators of several new gTLDs to prevent the abuse of trademark rights during the introductory phase of the gTLD. The Center has published reports on its experience with the Afilias Sunrise Registration Challenge Policy for .info and the Start-Up Trademark Opposition Policy for .biz, in order to assist in the establishment of safeguards that should accompany any further introduction of new gTLDs.⁶ In recognition of WIPO's earlier recommendations, ICANN has, with letter of April 27, 2004, requested the expert advice of WIPO on intellectual property issues involved in the introduction of new gTLDs more generally. The Secretariat is preparing a report on the basis of its experience gained thus far.

Domain Names and Other Identifiers

8. The Second WIPO Internet Domain Name Process concerned the relationship between domain names and five types of identifiers other than trademarks, namely, International Nonproprietary Names for pharmaceutical substances (INNs), the names and acronyms of international intergovernmental organizations (IGOs), personal names, geographical identifiers and trade names.

Recommendations by WIPO Member States

9. The Report of the Second WIPO Internet Domain Name Process⁷ was discussed by two special sessions of the WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) which were held in 2001 and 2002 and resulted

⁴ The index is available at the Center's website at <http://arbiter.wipo.int/domains/search/index.html>.

⁵ The full list of ccTLDs which have retained the Center as domain name dispute resolution provider is available at <http://arbiter.wipo.int/domains/ccTld/index.html>.

⁶ *WIPO End Report on Case Administration under the Afilias Sunrise Registration Challenge Policy for .info* available at <http://arbiter.wipo.int/domains/reports/info-sunrise/index.html>; and *WIPO End Report on Case Administration under the Start-Up Trademark Opposition Policy for .biz* available at <http://arbiter.wipo.int/domains/reports/biz-stop/index.html>.

⁷ *The Recognition of Rights and the Use of Names in the Internet Domain Name System – Report of the Second WIPO Internet Domain Name Process*, WIPO Publication No. 843, also available at <http://wipo2.wipo.int/process2/report/index.html>.

in recommendations to the WIPO General Assembly.⁸ At its meeting from September 23 to October 1, 2002, the WIPO General Assembly recommended amending the UDRP to provide protection for country names and for the names and acronyms of IGOs. The recommendations were supplemented by the SCT at its ninth session in November 2002.⁹ These recommendations (the “WIPO-2 Recommendations”) were transmitted to ICANN in February 2003. They are reproduced in the Annex to this document.

Developments at ICANN

10. Following consideration by the consultative bodies and supporting organizations of ICANN, including the Governmental Advisory Committee which unanimously supported the WIPO-2 Recommendations,¹⁰ the ICANN Board decided, in June 2003, to form a working group composed of representatives of the various ICANN supporting organizations and consultative bodies “for the purpose of analyzing the practical and technical aspects of implementing the WIPO recommendations, and notably the implications for the UDRP.”¹¹ This working group, which includes a representative of the Secretariat, was established on October 6, 2003.¹² The working group has conducted consultations by e-mail and over the telephone with a view to rendering a final report to the Board of ICANN at the ICANN meeting in July 2004. The Secretariat will continue to monitor any further action on the part of ICANN.

Further Discussions in the SCT

11. In parallel to its above-mentioned recommendations, the WIPO General Assembly had, in September 2002, decided that the following three issues concerning country names required further discussion:

- (i) Whether protection of country names in the DNS should be extended to names by which countries are familiarly or commonly known;
- (ii) Whether protection should be granted retroactively to existing registrations of domain names, and in which alleged rights may have been acquired; and
- (iii) How to address the question of sovereign immunity of States before the courts of other countries in relation to proceedings relating to protection of country names in the DNS.

12. The SCT considered these issues at its tenth (April 28 to May 2, 2003) and eleventh (November 10 to 14, 2003) sessions. After a full discussion, the SCT decided not to

⁸ All working documents of the special sessions of the SCT are available at <http://ecommerce.wipo.int/domains/sct/documents/index.html>.

⁹ Document SCT/9/8, paragraphs 6 to 11. Same decision recorded in document SCT/9/9, paragraph 149.

¹⁰ Posted at <http://www.icann.org/committees/gac/communique-25mar03.htm#4>.

¹¹ See <http://www.icann.org/minutes/prelim-report-02jun03.htm>.

¹² See <http://www.icann.org/announcements/announcement-06oct03.htm>.

supplement the WIPO-2 Recommendations with further recommendations on the above issues.¹³

13. The SCT also continued to discuss the protection of geographical indications against their abusive registration as domain names at its eleventh and twelfth sessions.¹⁴ The issue remains on the agenda of the SCT.

14. The WIPO General Assembly is invited to take note of the contents of this document.

[Annex follows]

¹³ Documents SCT/10/9, paragraph 5 and SCT/11/8, paragraphs 254 and 262. The discussion was based on documents SCT/10/5, SCT/10/7 Corr. and SCT/11/5.

¹⁴ Documents SCT/11/7, paragraphs 8 and 12; SCT/12/7, paragraph 201. The discussion was based on document SCT/10/6.

ANNEX

WIPO Recommendation on the Names and Acronyms of International Intergovernmental Organizations

“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.”

(See documents *SCT/S2/8*, paragraph 88 and *WO/GA/28/7*, paragraph 79)

WIPO Recommendation on Country Names

“6. Recalling the decision reached by the General Assembly at its meeting in September 2002, the majority of delegations favored amending the Uniform Domain Name Dispute Resolution Policy (UDRP) to provide protection for country names in the DNS.

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

(i) protection should be extended to the long and short names of countries, as provided by the United Nations Terminology Bulletin;

(ii) 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;

(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; and

(iv) the protection should be extended to all future registrations of domain names in generic top-level domains (gTLDs).

“8. The delegations supported continued discussion on:

(i) extension of protection to the names by which countries are familiarly or commonly known, and agreed that any additional such names be notified to the Secretariat before December 31, 2002;

(ii) retrospective application of the protection to existing registrations of domain names, and in which alleged rights may have been acquired; and

(iii) the question of sovereign immunity of States before the courts of other countries in relation to proceedings relating to protection of country names in the DNS.

“9. The delegations requested the Secretariat to transmit the said recommendation to the Internet Corporation for Assigned Names and Numbers (ICANN).

“10. The Delegations of Australia, Canada and the United States of America dissociated themselves from this decision.

“11. The Delegation of Japan stated that, while it did not oppose the decision to extend protection to country names in the DNS, further discussion was required concerning the legal basis for such protection, and stated its reservation to paragraph 7 herein, except for subparagraph (iv).”

(See documents *WO/GA/28/7*, paragraphs 80 to 81 and *SCT/9/8*, paragraphs 6 to 11)

[End of Annex and of document]