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MATTERS CONCERNING INTERNET DOMAIN NAMES

Document prepared by the Secretariat

1. The Internet Domain Name System (DNS) raises a number of challenges for the protection of intellectual property, which, due to the global nature of the Internet, call for an international approach. WIPO has addressed these challenges since 1998 by developing specific solutions, most notably in the First¹ and Second² WIPO Internet Domain Name Processes. In particular, the WIPO Arbitration and Mediation Center (Center) provides trademark owners with an efficient international mechanism to deal with 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 activities of WIPO, including the status of the recommendations made by the Member States of WIPO in the context of the Second WIPO Internet Domain Name Process.

Domain Names and Trademarks

Uniform Domain Name Dispute Resolution Policy

3. The Center administers dispute resolution procedures under the Uniform Domain Name Dispute Resolution Policy (UDRP). The UDRP was adopted by the Internet Corporation for Assigned Names and Numbers (ICANN) on the basis of recommendations made by WIPO in the First WIPO Internet Domain Name Process. The UDRP is limited to clear cases of bad-faith, abusive registration and use of domain names. It does not prevent either party from submitting a dispute to a competent court of justice. However, the UDRP has proven highly popular among trademark owners, and very few cases that were decided under the UDRP were also brought before a national court of justice.³
4. Since December 1999, the Center has administered more than 9,000 cases covering over 17,000 domain names. In 2005, the WIPO Center witnessed a 20% increase over the previous year, after the filing rate had stabilized at around 3 cases per calendar day until 2004. This increase has continued into the first half of 2006 with a current average filing rate of some 4.5 new cases per calendar day.
5. WIPO UDRP proceedings have so far involved parties from 131 countries and been conducted in 12 different languages, namely (in alphabetical order), Chinese, Dutch, English, French, German, Italian, Japanese, Korean, Norwegian, Portuguese, Russian and Spanish, in function of the language of the applicable registration agreement of the domain name at issue. The List of WIPO Domain Name Panelists who decide UDRP cases includes trademark experts from 55 countries in all continents.⁴

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 Selection of UDRP-related Court Cases at <http://arbiter.wipo.int/domains/challenged>.

⁴ See the List of WIPO Domain Name Panelists at <http://arbiter.wipo.int/domains/panel/panelists>.

6. WIPO has made numerous contributions to help ensure fair and transparent UDRP procedures. These include a searchable Legal Index providing parties and panelists with categorized online access to all UDRP decisions rendered by WIPO panels⁵, and an Overview of WIPO Panel Views on Selected UDRP Questions.⁶ These popular online tools have enhanced the consistency and reasoning of decisions taken under the UDRP and help parties assess their chances in UDRP proceedings. In addition, the Center regularly organizes Domain Name Dispute Resolution Workshops for interested parties⁷ and meetings of its Domain Name Panelists.

7. On a policy level, the Center has used its domain name dispute resolution experience in a report on the IP aspects of introducing generic Top-Level Domains (gTLDs).⁸ This report, which had been prepared at the request of ICANN, recommends the establishment of a uniform mechanism designed to prevent the abusive registration of domain names during the introduction of new gTLDs. Such a preventive mechanism would be in addition to the curative relief option provided by the UDRP.

Country Code Top-Level Domains

8. While the mandatory application of the UDRP is limited to domain names registered in 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 2006, the Center provides domain name dispute resolution services to 47 ccTLD registries and is in consultation with a number of additional ccTLDs.⁹

Domain Names and Other Identifiers

9. The Second WIPO Internet Domain Name Process concerned the relationship between domain names and five types of identifiers other than trademarks that had not been addressed in the First WIPO Internet Domain Name Process, namely, International Nonproprietary Names for pharmaceutical substances (INNs), the names and acronyms of international intergovernmental organizations (IGOs), personal names, geographical identifiers and trade names.

⁵ The Index is available at the Center's web site at <http://arbiter.wipo.int/domains/search/legalindex>.

⁶ The Overview is available at the Center's web site at <http://arbiter.wipo.int/domains/search/overview>.

⁷ See the list of events organized by the Center at <http://arbiter.wipo.int/events>.

⁸ *New Generic Top-Level Domains: Intellectual Property Considerations*, available at <http://arbiter.wipo.int/domains/reports/newgtld-ip>.

⁹ 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>.

Recommendations by WIPO Member States

10. The Report of the Second WIPO Internet Domain Name Process¹⁰ was discussed by two special sessions of the WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) held in 2001 and 2002 resulting in recommendations to the WIPO General Assembly.¹¹ At its meeting from September 23 to October 1, 2002, the WIPO General Assembly recommended amending the UDRP in order to provide protection, at this stage, for country names and for the names and acronyms of IGOs. The recommendations were supplemented by the SCT at its ninth session in November 2002.¹² The WIPO Secretariat transmitted these recommendations (the “WIPO-2 Recommendations”) to ICANN in February 2003. They are reproduced in the Annex to this document.

Developments at ICANN

11. Following consideration by the consultative bodies and supporting organizations of ICANN, including the Governmental Advisory Committee (GAC) which unanimously supported the WIPO-2 Recommendations, the ICANN Board of Directors 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.” This working group was established on October 6, 2003¹³ and, in July 2004, delivered a final report¹⁴ to the Board of ICANN without, however, being able to make consensus recommendations.

12. At its meeting in Kuala Lumpur, Malaysia in July 2004, the ICANN Board requested the President of ICANN to analyze the report for the Board so that the latter could take a decision at its meeting in Cape Town, South Africa, in December 2004.¹⁵ In this context, ICANN requested the WIPO Secretariat to provide an informal Briefing Note on the WIPO-2 Recommendations. The WIPO Briefing Note summarizes the main arguments motivating the WIPO-2 Recommendations and, in an annex, provides a draft showing the amendments to the UDRP and the UDRP Rules that would be required in order to implement the WIPO-2 Recommendations. The Briefing Note has been posted on ICANN’s web site.¹⁶

13. At the ICANN meeting in Cape Town in December 2004, the President of ICANN informed the ICANN Board that he considered “further consultations with the community” to be appropriate. The ICANN Board, in turn, asked ICANN staff to analyze any comments to be received during a public comment period, and requested to be informed of the results,

¹⁰ See footnote 2 above.

¹¹ All working documents of the special sessions of the SCT are available at <http://arbiter.wipo.int/processes/process2>.

¹² Document SCT/9/8, paragraphs 6 to 11. Same decision recorded in document SCT/9/9, paragraph 149.

¹³ <http://www.icann.org/announcements/announcement-06oct03.htm>.

¹⁴ This report is posted at <http://www.icann.org/committees/JWGW2/final-report>.

¹⁵ <http://www.icann.org/minutes/kl-resolutions-23jul04.htm>.

¹⁶ <http://www.icann.org/committees/JWGW2>.

including if appropriate a recommendation, at its meeting in Mar del Plata, Argentina, in April 2005.¹⁷ No comments of substance were received during the public comment period.¹⁸

14. On March 23, 2005, the UN Legal Advisers sent a letter to ICANN confirming their support for the WIPO-2 Recommendations regarding the protection of the names and acronyms of IGOs.¹⁹

15. The issue was not discussed at the ICANN meetings in Mar del Plata, Argentina, in April 2005 and Luxembourg in July 2005. At the 2005 meeting of the WIPO General Assembly, a number of delegations expressed concern with regard to the apparent lack of progress in the implementation of the WIPO-2 Recommendations. These delegations also requested the WIPO Secretariat to transmit this concern to ICANN.

16. In November 2005, the Secretariat sent a letter to ICANN inquiring again about the status of the WIPO-2 Recommendations. During the ICANN meeting in Vancouver, Canada, in December 2005, the President and CEO of ICANN, Mr. Paul Twomey, suggested that ICANN's Intellectual Property Constituency (IPC) reconsider the WIPO-2 Recommendations. The IPC addressed this matter in a position paper on the introduction of new gTLDs.²⁰ The relevant part of the IPC statement reads as follows:

“After consideration of the WIPO 2 recommendations and the background material, including the report of the ICANN presidential task force, it is the opinion of the IPC that there is potential for a consensus-based solution to disputes involving names of IGOs, but not disputes involving country names. In sum, in line with WIPO's own comments, the IPC finds that there is insufficient international law on which to base a dispute resolution procedure for country names. It is the IPC's belief that the matter of the legal status of country names is not yet ripe for consideration by ICANN and requires more discussion and consensus within the confines of governments and appropriate international accords. It is the IPC's recommendation that ICANN make an effort to proceed with a new, community accepted IGO dispute resolution policy (DRP) and refer the matter of country names back to governments and other appropriate parties for further discussion.”

17. In a letter dated March 13, 2006²¹, the President and CEO of ICANN, Mr. Paul Twomey, informed the Secretariat that it had not been possible to achieve a consensus among the various constituencies of ICANN. Since, by virtue of its Bylaws, ICANN was dependent on its “bottom-up consensus-seeking procedures” to introduce new policies or modify existing ones, Mr. Twomey expressed doubts as to whether a re-launch of such a consensus-seeking procedure would result in a basis for moving forward with the WIPO-2 Recommendations as a whole. Referring to the IPC position paper, the letter however indicated that progress might be

¹⁷ <http://www.icann.org/minutes/capetown-resolutions-1-05dec04.htm>.

¹⁸ <http://forum.icann.org/lists/wipo2-comments>.

¹⁹ The letter is posted on the Center's web site at <http://arbiter.wipo.int/processes/process2/letter.pdf>.

²⁰ *Comments of the Intellectual Property Constituency, Terms of Reference for New gTLDs, 31 January 2006*, posted on ICANN's web site at <http://gns0.icann.org/issues/new-gtlds/ipc-01feb06.pdf>

²¹ A similar letter was sent to the Chairman of the GAC, Mr. Sharil Tarmizi and is posted on ICANN's web site at <http://www.icann.org/correspondence/twomey-to-tarmizi-13mar06.pdf>.

possible with regard to the protection of the names and acronyms of IGOs for which an established basis exists in international law.

18. In view of the statement made by the President and CEO of ICANN, it currently appears unlikely that ICANN will move to implement the part of the WIPO-2 Recommendations that concerns the protection of country names. As to the WIPO-2 Recommendations on IGO names and acronyms, their implementation has recently been considered by a task force of ICANN's relevant policy-formulating body, the Generic Names Supporting Organization (GNSO), further to the IPC statement referred to above. The Secretariat is not a member of the GNSO but has been following these discussions. While this matter was not addressed at ICANN's March 2006 meeting in Wellington, New Zealand, further progress might be made at the next ICANN meeting in Marrakech, Morocco, from June 26 to 30, 2006. While the Secretariat is not represented at every single ICANN meeting, it will continue to monitor ICANN developments and provide input where possible.

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

[Annex follows]