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Internet Domain Names

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 (WIPO 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, as previously reported in WO/GA/38/12.³ It covers the WIPO Center's administration of domain name disputes under different policies and various related aspects of the DNS, as well as selected policy developments, in particular the introduction of new generic top-level domains (gTLDs), internationalized domain names (IDNs), and the status of the

¹ *The Management of Internet Names and Addresses: Intellectual Property Issues – Final Report of the First WIPO Internet Domain Name Process*, WIPO publication No. 439, also available at

<http://www.wipo.int/amc/en/processes/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://www.wipo.int/amc/en/processes/process2/report>.

³ http://www.wipo.int/edocs/mdocs/govbody/en/wo_ga_38/wo_ga_38_12.pdf.

recommendations made by the Member States of WIPO in the context of the Second WIPO Internet Domain Name Process.

I. DOMAIN NAME CASE ADMINISTRATION

A. Uniform Domain Name Dispute Resolution Policy

3. The WIPO Center administers dispute resolution procedures principally 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.⁴
4. Since December 1999, the WIPO Center has administered more than 17,500 UDRP and UDRP-based cases. Demand for WIPO's domain name dispute resolution services continued in 2009 with trademark holders filing 2,107 complaints. While this caseload represents a 9.5% decrease over 2008, it covers the highest number of individual domain names in a given year (4,688) since the UDRP was launched ten years ago. Following the introduction by WIPO of its paperless UDRP procedure in December 2009, the first five months of 2010 have seen an increase of some 20% in cases filed compared to the same period in 2009.
5. A diverse mixture of individuals and enterprises, foundations and institutions used the WIPO Center's dispute resolution procedures in 2009. The top five sectors for complainant business activity were Biotechnology and Pharmaceuticals, Banking and Finance, Internet and IT, Retail, and Food, Beverage and Restaurants. Pharmaceutical manufacturers remained the top filers due to numerous permutations of protected names registered for web sites offering or linking to online sales of medications and drugs. WIPO UDRP proceedings have so far involved parties from 155 countries. Reflecting the truly global scope of this dispute mechanism, in 2009 alone, named parties to WIPO cases represented over 110 countries. WIPO UDRP proceedings have so far been conducted in 18 different languages, namely (in alphabetical order), Chinese, Danish, Dutch, English, French, German, Hebrew, Italian, Japanese, Korean, Norwegian, Polish, Portuguese, Romanian, Russian, Spanish, Swedish, Turkish in function of the language of the applicable registration agreement of the domain name at issue.
6. Since the year 2000 all panel decisions are posted on the WIPO Center's website. To facilitate access to these decisions according to subject matter the WIPO Center also offers an online searchable Legal Index.⁵ This Index has become a highly-frequented professional resource, allowing panelists, parties, academics or any interested person to familiarize themselves with WIPO case precedent, and is one of the Organization's most visited web pages. The Index is updated periodically to include new search categories

⁴ See Selected UDRP-related Court Cases at <http://www.wipo.int/amc/en/domains/challenged>.

⁵ The WIPO Legal Index is available at the Center's web site at <http://www.wipo.int/cgi-bin/domains/search/legalindex>.

that primarily reflect developments in the Domain Name System itself.⁶ In addition to its Legal Index, the WIPO Center also offers an overview of broad decision trends on important case issues, via the WIPO Overview of WIPO Panel Views on Selected UDRP Questions which distills thousands of UDRP cases handled by the WIPO Center. The Overview is a globally used instrument to help maintain the consistency of WIPO UDRP jurisprudence.⁷

7. The WIPO Center also maintains on its web pages an extended statistics search facility in relation to WIPO domain name dispute resolution, intended to assist WIPO case parties and neutrals, trademark attorneys, domain name policy makers, the media and academics. Available statistics cover many categories, such as “areas of complainant activity”, “named respondents”, “domain name script” and “25 most cited decisions in complaint”.⁸
8. In addition, the WIPO Center regularly organizes Domain Name Dispute Resolution Workshops for interested parties⁹ and meetings of its Domain Name Panelists. The year 2009 marked the tenth anniversary of the introduction of the UDRP and in recognition of this milestone the WIPO Center turned its annual Panelists Meeting into an open Conference, “10 Years UDRP – What’s Next?”. This Conference drew lessons from the UDRP experience of the WIPO Center, panelists, parties, and other stakeholders, with a view to informing similar or other processes in the future of the DNS and in the broader context of intellectual property, and exemplifies the WIPO Center’s commitment to monitoring and guiding developments in the DNS.¹⁰

B. Country Code Top-Level Domains

9. While the mandatory application of the UDRP is limited to domain names registered in gTLDs, such as .biz, .com, .info, .net, and .org, the WIPO Center also assists many 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. Following further additions during the past 12 months, the WIPO Center provides domain name dispute resolution services to 62 ccTLD registries.¹¹ In line with a global increase in the share of ccTLD registrations in recent years, the collective percentage of disputed ccTLD domain names in WIPO cases has been increasing, from less than 1% in the year 2000, to 7% in 2007, and 14% in 2009. The growth in demand for dispute resolution services among the ccTLD registries reflects the expansion of the Internet across regions.

⁶ Most recently added Index categories include: Timing of Rights; Pay-per-click and other landing pages; Prior knowledge/Notice of Mark; Willful blindness; Constructive notice; Knew of should have known; Registrant search obligation; and, Consent to transfer.

⁷ The Overview is available at the Center’s web site at <http://www.wipo.int/amc/en/domains/search/overview>.

⁸ The portal page of this facility is located at <http://www.wipo.int/amc/en/domains/statistics>.

⁹ See the list of events organized by the Center at <http://www.wipo.int/amc/en/events>.

¹⁰ Program and presentations for this Conference are located at <http://www.wipo.int/amc/en/events/workshops/2009/10yrs-udrp/index.html>.

¹¹ The full list of ccTLDs which have retained the Center as domain name dispute resolution provider is available at <http://www.wipo.int/amc/en/domains/ccTld>.

C. WIPO “eUDRP” Implementation

10. Following extensive research, the WIPO Center submitted a proposal to ICANN, in December 2008, to remove the requirement to submit and distribute paper copies of pleadings relating to the UDRP process, primarily through the use of email.¹² This forward-looking proposal emanated from awareness of environmental challenges and the recognition that Internet-based communication has become ubiquitous. Following ICANN acceptance in October 2009, the WIPO Center became the first UDRP provider to offer this electronic filing option from December 14, 2009, when amended WIPO practice took effect. WIPO’s eUDRP procedure benefits all stakeholders by eliminating the use of vast quantities of paper and the associated production and shipping costs, as well as improving the timeliness of UDRP proceedings without prejudicing either complainants or respondents.

D. UDRP Policy Development

11. Significant developments in the DNS pose continuing challenges for intellectual property rights owners, in particular trademark owners, in policing and enforcing their rights. Such developments include the growth in the number of professional domain name dealers and the volume of their activity, and the use of computer software to automatically register expired domain names and their “parking” on pay-per-click portal sites. Domain names used to be primarily identifiers for businesses and other Internet users, but are increasingly taking on aspects of commodities for speculative gain. Whereas traditionally domain name abuse involved the registration of domain names by individuals seeking to sell the “squatted” names, nowadays a growing number of “domainers” are deriving income from the large-scale automated registration of domain names corresponding to third-party identifiers.
12. As the leading provider of case administration services under the UDRP, WIPO must monitor these developments with a view to continually adjusting its practices. One such area of attention is the widespread use of privacy and proxy registration, which according to some ICANN estimates involves 25% of domain name registrations. In combination with the reliability of “Whois” registrant contact data, this poses significant challenges for filing parties, providers, and panels in ascertaining respondent identity in UDRP proceedings. A broader UDRP-related development which may present new concerns for trademark owners is described in paragraph 31 herein.

II. POLICY DEVELOPMENTS IN THE DOMAIN NAME SYSTEM

13. Two policy developments in relation to ICANN will in particular present not only opportunities but also serious legal and practical challenges for intellectual property rights owners and users, namely the introduction of further new gTLDs and of IDNs at the top level.

¹² Full details of WIPO’s eUDRP implementation are available at <http://www.wipo.int/amc/en/domains/rules/eudrp/>.
<http://www.wipo.int/export/sites/www/amc/en/docs/icann301208.pdf>.

A. New Generic Top-Level Domains

14. In September 2007, ICANN's policy formulating body, the Generic Names Supporting Organization (GNSO), issued a set of recommendations (GNSO New gTLD Report)¹³ to ICANN to implement a process that allows for the introduction of further new gTLDs, potentially broadly expanding their currently limited number.¹⁴ These GNSO recommendations were approved by ICANN's Board in June 2008 (ICANN's New gTLD Program).¹⁵ Subsequently, ICANN published Versions I, II, III, and, on May 31, 2010, IV of a Draft Applicant Guidebook for New gTLDs, containing information in relation to the application process and conditions for New gTLDs.¹⁶ Informal communications as of June 2010 suggest that a final Applicant Guidebook is expected to be published by early 2011, in which case applications for new gTLDs could be received still in 2011 with registrations of individual domain names following.¹⁷

15. The GNSO New gTLD Report includes the following recommendation, of particular relevance for trademark owners:

"Recommendation 3: Strings must not infringe the existing legal rights of others that are recognized or enforceable under generally accepted and internationally recognized principles of law.

Examples of these legal rights that are internationally recognized include, but are not limited to, rights defined in the Paris Convention for the Protection of [Industrial] Property (in particular trademark rights), the Universal Declaration of Human Rights (UDHR) and the International Covenant on Civil and Political Rights (ICCPR) (in particular freedom of expression rights)."

16. On its part, ICANN's Governmental Advisory Committee (GAC) issued in 2007 the "GAC Principles regarding New gTLDs," which state *inter alia*:

"2.3 The process for introducing new gTLDs must make proper allowance for prior third party rights, in particular trademark rights as well as rights in the names and acronyms of inter-governmental organizations (IGOs)."¹⁸

17. In its Press Release of March 23, 2010, providing an annual overview of the activities of the WIPO Center, WIPO noted that ICANN's New gTLD Program, forecasting an unprecedented expansion of the DNS, is a source of concern for brand owners and consumers.¹⁹ In this connection, the Final Report of the First WIPO Internet Domain Name Process had recommended, *inter alia*, that new gTLDs be introduced in a controlled manner. Intellectual property stakeholders generally fear that in the absence

¹³ ICANN GNSO Final Report on the Introduction of New Generic Top Level Domains, at <http://gns0.icann.org/issues/new-gtlds/pdp-dec05-fr-parta-08aug07.htm>.

¹⁴ There are currently 21 gTLDs, such as .com, .biz, and .net.

¹⁵ <http://www.icann.org/en/announcements/announcement-4-26jun08-en.htm>.

¹⁶ <http://www.icann.org/en/topics/new-gtlds/draft-rfp-redline-28may10-en.pdf>.

(Previous drafts were published respectively on October 24, 2008: <http://www.icann.org/en/topics/new-gtlds/draft-rfp-24oct08-en.pdf>, February 18, 2009: <http://www.icann.org/en/topics/new-gtlds/draft-rfp-clean-18feb09-en.pdf>, and, October 4, 2009: <http://www.icann.org/en/topics/new-gtlds/draft-rfp-redline-04oct09-en.pdf>.)

¹⁷ See generally, <http://www.icann.org/en/topics/new-gtld-program.htm>.

¹⁸ http://gac.icann.org/web/home/gTLD_principles.pdf.

¹⁹ http://www.wipo.int/pressroom/en/articles/2010/article_0007.html.

of adequate safeguards, ICANN's planned expansion will give rise to trademark abuse, consumer confusion, and a general undermining of public trust in the DNS, with a heavier enforcement burden on trademark owners.

18. Based on these concerns, the WIPO Center has been working with stakeholders to attempt to safeguard the observance of general principles of intellectual property protection in the event that the introduction of new gTLDs will proceed as intended by ICANN. Within the framework of existing international trademark norms, the input of the WIPO Center aims to help prevent disputes, and where such disputes arise, to create administrative mechanisms as low-threshold alternatives to court litigation, in foreign jurisdictions or otherwise.
 - (i) Pre- (TLD) Delegation Dispute Resolution Procedure
19. In reply to ICANN's request for "Expressions of Interest from Potential Dispute Resolution Service Providers for New gTLD Program," of December 21, 2007, the WIPO Center communicated to ICANN in a letter dated January 18, 2008 its readiness to assist ICANN in devising and applying dispute resolution procedures in relation to the introduction of new gTLDs to the extent these involve disputes based on intellectual property rights. Since then, the WIPO Center has worked with ICANN in the confirmation of the substantive criteria of the pre-delegation procedure, which are rooted in the "WIPO Joint Recommendation Concerning Provisions on the Protection of Marks, and Other Industrial Property Rights in Signs, on the Internet,"²⁰ adopted by the WIPO General Assembly in September 2001, and the development of procedural rules for "Legal Rights Objections" as integrated in ICANN's Draft Applicant Guidebook.²¹ This proposal appears to have met with broad support, and the WIPO Center has accepted to administer disputes under these procedural rules.²²
 - (ii) WIPO-Proposed Post- (TLD) Delegation Dispute Resolution Procedure
20. From early 2008 the WIPO Center has advocated to ICANN the usefulness of a permanent administrative option, additional to the procedure described in the preceding paragraph, that would allow for the filing of a complaint with respect to an approved new gTLD registry operator whose actual manner of operation or use of its registry is alleged to cause or materially contribute to trademark abuse. On February 5, 2009, the WIPO Center communicated to ICANN a concrete substantive proposal for a trademark-based post-delegation dispute resolution procedure addressing such potential gTLD registry behavior. This proposal, which was published in a letter from the WIPO Center to ICANN dated March 13, 2009,²³ is intended to act as a form of standardized assistance to ICANN's own compliance oversight responsibilities, provide an administrative alternative to court litigation, encourage responsible conduct by relevant actors including through the provision of safe harbors for good-faith registry operators, and enhance the security and stability of the DNS. The WIPO Center's suggestion recognizes the opportunity which ICANN and its registration stakeholders have, at this stage of planning, to incorporate

²⁰ http://www.wipo.int/about-ip/en/development_iplaw/pub845-toc.htm.

²¹ See section 3.2 of the Draft Applicant Guidebook Versions I, II, III, and IV.

²² See WIPO Rules for New gTLD Dispute Resolution and Schedule of Fees and Costs, respectively at <http://www.icann.org/en/topics/new-gtlds/draft-wipo-rules-28may10-en.pdf>, and <http://www.icann.org/en/topics/new-gtlds/draft-wipo-fees-28may10-en.pdf>.

²³ <http://www.wipo.int/amc/en/docs/icann130309.pdf>.

such a mechanism within their contractual framework, in a positive, pro-active manner designed to minimize burdens associated with anticipated levels of infringement.

21. Given the perceived convergence of registry, registrar, and registrant roles within the DNS, the WIPO Center has further recommended, taking account of its UDRP-based experiences, that ICANN consider extending the concept behind this post-delegation proposal for registries also to registrar conduct.²⁴
 - (iii) Complementary Rights Protection Mechanisms
22. While the UDRP will remain an important curative tool for particular disputes involving the considered transfer of a disputed domain name to the trademark owner, the WIPO Center has also advocated the additional availability of other appropriate second-level Rights Protection Mechanisms (RPMs) to safeguard legitimate trademark interests in the DNS. Here again, the WIPO Center noted the need to strike a reasonable balance between the protection of trademark rights recognized by law, the practical interests of good-faith registration authorities to encounter minimal operational burdens, and the legitimate expectations of *bona fide* domain name registrants. With these interests in mind, the WIPO Center on April 13, 2009, communicated to ICANN a discussion draft of an Expedited (Domain Name) Suspension Mechanism (ESM).²⁵ This RPM would succinctly address domain name disputes at the second (and lower) level, expanding the present UDRP option for brand owners to combat cybersquatting in a cost and time effective manner.
 - (iv) ICANN Implementation Recommendation Team; ICANN Special Trademarks Issues Review Team
23. In response to public comments made on ICANN's Draft Applicant Guidebook, ICANN defined trademark protection as an "overarching" issue requiring further consideration by relevant parties, and ICANN's Board resolved in March 6, 2009 to request the ICANN Intellectual Property Constituency to convene an "Implementation Recommendation Team" (IRT) to develop and propose solutions to the issue of trademark protection vis-à-vis new gTLDs.²⁶
24. The IRT published its Draft²⁷ and Final²⁸ Reports respectively on April 24, and May 29, 2009; these Reports distill and adapt a range of differing concepts and proposals including the WIPO Center's above-mentioned Post-Delegation and ESM proposals. The IRT recommendations included the creation of a central "Clearinghouse" to collect and validate certain intellectual property rights and other data, and a "Globally Protected Marks List" to reflect conditions deemed appropriate in the context of the DNS. It appears that ICANN may be dropping this IRT concept of a formal "Globally Protected marks List" from consideration.
25. The WIPO Center provided targeted comments on the Draft and Final IRT Reports through in-person discussions and letters to ICANN and the IRT of May 10,²⁹ and

²⁴ <http://www.wipo.int/amc/en/docs/icann260310rap.pdf>, see also letters referenced at footnotes 29 and 30.

²⁵ <http://www.wipo.int/amc/en/docs/icann030409.pdf>.

²⁶ <http://www.icann.org/en/minutes/resolutions-06mar09.htm#08>.

²⁷ <http://www.icann.org/en/topics/new-gtlds/irt-draft-report-trademark-protection-24apr09-en.pdf>.

²⁸ <http://www.icann.org/en/topics/new-gtlds/irt-final-report-trademark-protection-29may09-en.pdf>.

²⁹ <http://www.wipo.int/amc/en/docs/icann100509.pdf>.

June 18, 2009.³⁰ These letters identified a number of aspects in which adaptations of the WIPO Center's Post-Delegation and ESM proposals may have the effect of limiting their intended effectiveness. While the IRT's Final Report accounts for several of the key trademark protection-based points raised by the WIPO Center, areas of concern remained outstanding in particular as to independent and effective system design, both in operational and in substantive terms.

26. Subsequent to the Final IRT Report, ICANN through its staff further adapted the concept of a Post-Delegation mechanism in Version III of its Draft Applicant Guidebook. In a letter of November 20, 2009,³¹ the WIPO Center reiterated that, in such form, the Post-Delegation Dispute Resolution Procedure (PDDRP) would be of more limited effect, as it would not encompass registry conduct in relation to widespread trademark abuse undertaken by domain name registrants. The WIPO Center further noted that an alternative, broader scope of the PDDRP would involve the identification of realistic safe harbors for registries, who on that basis could responsibly partner with intellectual property stakeholders toward DNS credibility and integrity.
27. Following the work of the IRT, ICANN's Board requested that the GNSO provide input on whether it would approve the proposed ICANN staff Clearinghouse and Uniform Rapid Suspension procedure (URS) (the URS adopts the concept but not the design of the WIPO Center's ESM proposal), or alternatively whether the GNSO would propose other equivalent or indeed more effective and implementable RPMs. The GNSO created a Special Trademarks Issues Review Team (STI) which in its Report³² analyzed and proposed further adaptations to the URS and the Clearinghouse. In a letter of January 26, 2010,³³ the WIPO Center submitted comments on the STI Report noting that unworkable compromise detracts from the fundamental goal of minimizing rights abuse in the DNS without excessive need for court intervention. In specific reply to an ICANN STI proposal which would impact trademark owners in jurisdictions that do not conduct "substantive review" of applications, the WIPO Center further cautioned that ICANN policies should respect trademark law.
28. On February 15, 2010, ICANN released another round of documents proposing further adaptations to RPMs including the PDDRP, URS, and Clearinghouse.
29. Noting ICANN's proposed limitation of the PDDRP to registry operator "affirmative conduct," in a letter of March 26, 2010,³⁴ the WIPO Center proposed that ICANN registration authorities give consideration to a mechanism which would address willful blindness on their part – without involving a sweeping policing duty for such authorities, who should benefit from realistic safe harbors.
30. Concerning the URS and Clearinghouse, in separate letters of March 30, 2010,³⁵ the WIPO Center submitted comments emphasizing the need for the URS to complement and interoperate with the existing UDRP so as to offer a time and cost effective additional enforcement option. The WIPO Center further cautioned that RPMs should respect

³⁰ <http://www.wipo.int/amc/en/docs/icann180609.pdf>.

³¹ <http://www.wipo.int/amc/en/docs/icann201109.pdf>.

³² <http://gnso.icann.org/issues/sti/sti-wt-recommendations-11dec09-en.pdf>.

³³ <http://www.wipo.int/amc/en/docs/icann260110.pdf>.

³⁴ <http://www.wipo.int/amc/en/docs/icann260310pddrp.pdf>.

³⁵ <http://www.wipo.int/amc/en/docs/icann300310urs.pdf>, and <http://www.wipo.int/amc/en/docs/icann300310tmch.pdf>.

national and international trademark registration and protection norms, in particular with respect to the Clearinghouse.

(v) Calls for review of the WIPO-initiated UDRP

31. Separately, on February 12, 2010, an ICANN-convened Registration Abuse Policies Working Group (RAP WG) produced an Initial Report³⁶ which recommended *inter alia*, the initiation of an ICANN Policy Development Process to assess the current state of the UDRP. In a letter of March 26, 2010,³⁷ the WIPO Center submitted comments noting that the apparently envisaged ICANN committee process risks compromising or destabilizing the (WIPO-initiated) UDRP, which is universally acknowledged to be an internationally effective enforcement tool in the interests of all parties. Any such ICANN process could increase enforcement burdens on trademark owners and compliance exposure for registration authorities. Also, against the backdrop of the ICANN New gTLD Program, the WIPO Center suggested that rather than seeking to amend the time-tested UDRP, as actively maintained primarily by the WIPO Center,³⁸ attention logically should focus on the complementary qualities of new mechanisms under consideration.

(vi) Continuing DNS Policy Discussions

32. Following participation at a meeting of the ICANN Intellectual Property Constituency (IPC) and at the ICANN Meetings in Nairobi, Kenya, and Brussels, Belgium, the WIPO Center continues to advocate, as outlined above, balanced RPMs vis-à-vis ICANN's plans to allow for a potentially limitless expansion of the DNS. The WIPO Center has been contributing to discussions aimed at addressing trademark abuse in the DNS, and monitors ICANN's development of decisions that remain outstanding in its New gTLD Program. These issues are also subject to monitoring by the ICANN GAC.

B. Internationalized Domain Names (IDNs)

33. As noted, another significant policy development in the DNS currently being addressed by ICANN is the introduction of IDNs (non-Latin script) at the top level. IDN gTLDs are being discussed in part in connection with the ICANN New gTLD Program where potential new gTLD applications are expected to be made for IDNs.
34. Separately, ICANN's Final Implementation Plan for IDN ccTLD Fast Track Process was published on November 16, 2009.³⁹ This has already allowed for the introduction of several IDN ccTLDs, associated with the two-letter codes in the ISO 3166-1 standard.⁴⁰ As of June 2010, ICANN has received a total of 21 requests for IDN ccTLD(s) representing 11 languages. Approved requests continue to be delegated into the DNS root zone.

C. Domain Names and Other Identifiers

³⁶ <http://www.icann.org/en/announcements/announcement-12feb10-en.htm>.

³⁷ <http://www.wipo.int/amc/en/docs/icann260310rap.pdf>.

³⁸ Examples of such stewardship include the provision on a non-profit basis for the benefit of parties globally: Legal Index of WIPO UDRP Panel Decisions; WIPO Overview of WIPO Panel Views on Selected UDRP Questions; WIPO Advanced Workshop on Domain Name Dispute Resolution; WIPO Conference: 10 Years UDRP – What's Next?; and, WIPO Panelists Meetings.

³⁹ <http://www.icann.org/en/topics/idn/fast-track/idn-cctld-implementation-plan-16nov09-en.pdf>.

⁴⁰ http://www.iso.org/iso/english_country_names_and_code_elements.

35. In addition to and in connection with the above developments, there are further developments taking place at ICANN in relation to the protection of non-trademark identifiers.
36. It is recalled that the First WIPO Internet Domain Name Process addressed the relationship between domain names and trademarks. The Second WIPO Internet Domain Name Process concerned the relationship between domain names and five other types of identifiers that had not been addressed, namely, International Nonproprietary Names for pharmaceutical substances (INNs), the names and acronyms of international intergovernmental organizations (IGOs), personal names, geographical identifiers, including country names, and trade names.
37. At its meeting from September 23 to October 1, 2002, the WIPO General Assembly recommended amending the UDRP in order to provide protection for country names and for the names and acronyms of IGOs.⁴¹ The WIPO Secretariat transmitted these recommendations (WIPO-2 Recommendations) to ICANN in February 2003.⁴²
38. Following further WIPO communications, in a letter dated March 13, 2006,⁴³ the then President and CEO of ICANN 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, the then President and CEO of ICANN 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. The letter however indicated that progress might be possible with regard to the protection of names and acronyms of IGOs for which an established basis exists in international law.
39. In view of the statement made by the President and CEO of ICANN, it then appeared unlikely that ICANN would move to implement the part of the WIPO-2 Recommendations that concerns the protection of country names at second level of existing gTLDs. As to the WIPO-2 Recommendations on IGO names and acronyms, upon the request of the GNSO Council, ICANN staff produced on June 15, 2007, an Issues Report on Dispute Handling for IGO Names and Abbreviations,⁴⁴ recommending as follows:

“Staff does not recommend a PDP [Policy Development Process] on the protection of IGO names and abbreviations at this time. If staff was recommending a PDP, it would be within the scope of the GNSO;

“Staff recommends that new gTLD agreements may provide for protection of IGO names and abbreviations as a contractual condition for new gTLDs;

“Staff recommends that a separate Dispute Resolution Procedure [DRP] be developed for IGO names and abbreviations as domain names at the second or third level in new

⁴¹ http://www.wipo.int/edocs/mdocs/govbody/en/wo_ga_28/wo_ga_28_3.pdf; see also documents SCT/9/8, paragraphs 6 to 11; and, SCT/9/9, paragraph 149.

⁴² <http://www.wipo.int/amc/en/docs/wipo.doc>.

⁴³ A similar letter was sent to the then Chairman of the GAC, Mr. Sharil Tarmizi. It is posted on ICANN's web site at: <http://www.icann.org/correspondence/twomey-to-tarmizi-13mar06.pdf>.

⁴⁴ *GNSO Issues Report on Dispute Handling for IGO Names and Abbreviations* is posted on ICANN's web site at: <http://gns0.icann.org/issues/igo-names/issues-report-igo-drp-15jun07.pdf>.

gTLDs and that a framework be developed for handling objections or challenges related to IGO names and abbreviations in the upcoming application round for new gTLDs. Staff believes that this action will be more efficient than launching a PDP at this time;

“Once the DRP has been developed, staff recommends that the GNSO Council consider launching a PDP to investigate its application to existing gTLDs;

“In the alternative, the GNSO Council may consider forming a Working Group or assistance group to collaborate on a DRP for IGO names and abbreviations and conduct a PDP for application of the DRP to existing gTLDs;

“The GNSO Council may also consider extending the work of the Protections of Rights of Others (PRO) Working Group to develop a DRP for IGO names and abbreviations.”

40. On June 27, 2007, the GNSO Council requested ICANN staff to provide a report on a draft IGO Domain Name Dispute Resolution Procedure, primarily foreseen for new gTLDs. Such Report was produced by ICANN Staff on September 28, 2007,⁴⁵ but to date has not been adopted by the GNSO Council.
41. While the WIPO-2 Recommendations were made in the context of the DNS at that time, *i.e.*, prior to ICANN's plans for a broad expansion of the DNS, protection of geographical names and names and acronyms of IGOs is being reconsidered under ICANN's New gTLD Program, without ICANN as yet having articulated a formal position in the Draft Applicant Guidebook.
42. As to geographical terms, ICANN's GAC, in particular, has expressed concerns about their protection in the new gTLDs. In 2007 it issued the “GAC Principles regarding New gTLDs,”⁴⁶ which states *inter alia*:

“2.2 ICANN should avoid [in the introduction of new gTLDs] country, territory or place names, and country, territory or regional language or people descriptions, unless in agreement with the relevant governments or public authorities.

[...]

2.7 Applicant registries for new gTLDs should pledge to:

- (a) Adopt, before the new gTLD is introduced, appropriate procedures for blocking, at no cost and upon demand of governments, public authorities or IGOs, names with national or geographic significance at the second level of any new gTLD.
- (b) Ensure procedures to allow governments, public authorities or IGOs to challenge abuses of names with national or geographic significance at the second level of any new gTLD.”

⁴⁵ <http://gnsso.icann.org/drafts/gnsso-igo-drp-report-v2-28sep07.pdf>.

⁴⁶ http://gac.icann.org/web/home/gTLD_principles.pdf.

43. The GAC submitted, upon the ICANN Board's request, letters dated April 24, May 26, and August 18, 2009 to ICANN recommending *inter alia*, specific measures to protect geographic names in new gTLDs, including reserving names. Version IV of ICANN's Draft Applicant Guidebook would require an applicant for a geographic name-based gTLD string to submit a statement of support for or non-objection from the relevant governments or public authorities. The GAC in its Nairobi Communiqué⁴⁷ has called for a mechanism to address derivation from conditions of approval, and also inclusion of commonly used abbreviations or regions not listed in ISO 3166-2. These GAC recommendations will be subject to further ICANN GNSO discussion and ICANN Board approval.
44. The Secretariat will continue to monitor these developments and provide input where possible.

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

[End of document]

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<http://nbo.icann.org/meetings/nairobi2010/presentation-gac-soac-reports-12mar10-en.pdf>.