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Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications

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UPDATE ON TRADEMARK-RELATED ASPECTS OF THE DOMAIN NAME SYSTEM

Document prepared by the Secretariat

1.   At the thirty-third session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT), the Chair stated that the SCT had taken note of document SCT/33/4 (Update on Trademark-related Aspects of the Domain Name System) and that the Secretariat was requested to keep Member States informed on future developments in the Domain Name System (DNS) (see document SCT/33/6, paragraph 78). Accordingly, the Secretariat has prepared the present document which offers the requested update.

I.   DOMAIN NAME CASE ADMINISTRATION

A.   UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY

2.   The DNS raises a number of challenges for the protection of Intellectual Property (IP), 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

First[1] and Second[2] WIPO Internet Domain Name Processes. Through the Arbitration and Mediation Center (Center), WIPO provides trademark owners with efficient international mechanisms to deal with the bad-faith registration and use of domain names corresponding to their trademark rights. The principal mechanism administered by the Center, the Uniform Domain Name Dispute Resolution Policy (UDRP) was adopted by ICANN on the basis of recommendations made by WIPO in the First WIPO Internet Domain Name Process.

3.   The UDRP is limited to clear cases of bad-faith, abusive registration and use of domain names and has proven highly popular among trademark owners[3]. Since December 1999, the Center has administered over 32,000 UDRP-based cases[4]. Trademark holders in 2014 filed 2,634 UDRP-based complaints with the Center, an increase of two per cent over 2013 filing. As of September 2015, the total number of domain names in WIPO UDRP-based cases passed 60,000.

4.   A diverse mixture of enterprises, institutions, and individuals used the Center's dispute resolution procedures in 2014. The top five sectors for complainant business activity were Retail, Banking and Finance, Fashion, Internet and Information Technology, and Heavy Industry and Machinery. Especially the filings related to fashion and luxury brands include those by rights owners alleging counterfeiting via the web pages offered under the disputed domain name. Reflecting the global scope of this dispute mechanism, named parties to WIPO cases through 2014 have represented 177 countries. In function of the language of the applicable registration agreement of the domain name at issue, WIPO UDRP proceedings have so far been conducted in 21 languages[5].

5.   All WIPO UDRP panel decisions are posted on the Center's website. The Center offers a unique online overview of broad decision trends on important case issues via the WIPO Overview of WIPO Panel Views on Selected UDRP Questions (WIPO Overview 2.0). Distilling thousands of UDRP cases handled by the Center, this globally relied-upon instrument was created to help identify and stimulate consistency of WIPO UDRP jurisprudence[6]. To facilitate access to decisions according to subject matter, the Center also offers a widely used online searchable Legal Index of WIPO UDRP Decisions[7]. These WIPO resources are accessible globally free of charge.

6.   Mindful of WIPO's foundational role in the UDRP, the Center monitors developments in the DNS with a view to adjusting its resources and practices[8]. The Center regularly organizes Domain Name Dispute Resolution Workshops to update interested parties[9] as well as meetings of its Domain Name Panelists.

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[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]   The UDRP does not prevent either party from submitting a dispute to a competent court of justice; but very few cases that have been decided under the UDRP have been brought before a national court of justice. See Selected UDRP-related Court Cases at http://www.wipo.int/amc/en/domains/challenged.
[4]   The Center makes available online real-time statistics to assist WIPO UDRP case parties and neutrals, trademark attorneys, domain name registrants, domain name policy makers, the media, and academics. Available statistics cover many categories, such as "areas of complainant activity", "domain name script", and "25 most cited decisions in complaint". See http://www.wipo.int/amc/en/domains/statistics.
[5]   In alphabetical order, Chinese, Czech, Danish, Dutch, English, French, German, Hebrew, Italian, Japanese, Korean, Norwegian, Polish, Portuguese, Romanian, Russian, Slovak, Spanish, Swedish, Turkish, and Vietnamese.
[6]   The Overview is available at: http://www.wipo.int/amc/en/domains/search/overview2.0.
[7]   This professional resource is available at: http://www.wipo.int/cgi-bin/domains/search/legalindex.
[8]   See, e.g., WO/GA/41/17 Rev. 2, paragraphs 14 to 16.
[9]   All workshops and other events organized by the Center are listed at: http://www.wipo.int/amc/en/events.

B.   COUNTRY CODE TOP-LEVEL DOMAINS (ccTLDs)

7.   While the mandatory application of the UDRP is limited to domain names registered in generic Top Level Domains (gTLDs), such as .com and more recently introduced new gTLDs, the Center also assists ccTLD registries in their establishment of registration conditions and dispute resolution procedures that conform with best practices in registry management and IP protection. These procedures are mostly modeled after the UDRP, but may take account of the particular circumstances and needs of individual ccTLDs. The Center currently provides domain name dispute resolution services to 71 ccTLD registries, most recently including the domain space .GQ (Equatorial Guinea)[10].

II.   POLICY DEVELOPMENTS IN THE DOMAIN NAME SYSTEM

8.   A number of policy developments in relation to ICANN present both opportunities and challenges for owners and users of IP rights. One is ICANN's introduction of up to 1,400 new gTLDs. Such new gTLDs may be of an "open" nature (similar to .com), or may take on more specific or restrictive characteristics, for example taking the form of .[brand], .[city], .[community], .[culture], .[industry], or .[language]. An important related development concerns the introduction of Internationalized Domain Names (IDNs) at the top level. Also, ICANN's envisaged expansion of the DNS raises rights protection questions in connection with the Second WIPO Internet Domain Name Process.

A.   NEW GENERIC TOP-LEVEL DOMAINS

9.   ICANN implementation of its New gTLD Program was formally approved in June 2011[11]. Information has been published in ICANN's much-revised "Applicant Guidebook"[12]. Delegation of the first new gTLDs into the Internet's Root Zone took place in October 2013 with over 700 more by September 2015. Together, these new gTLDs appear to have attracted over 6.5 million second-level registrations[13].

10.   A number of new Rights Protection Mechanisms (RPMs) have emerged from a series of ICANN committees and processes for new gTLDs[14].   Set out below is a broad description of these ICANN RPMs, for the top level and the second level, respectively.

    (i)   Top Level Rights Protection Mechanisms

        −   Pre-(TLD) Delegation Dispute Resolution Procedure

11.   This mechanism allowed trademark owners to lodge Legal Rights Objections (LRO) to new gTLD applications at the top level where certain substantive criteria were met[15]. The Center assisted ICANN in the establishment of these criteria on the basis of the "WIPO Joint

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[10]   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.

[11]   See http://www.icann.org/en/minutes/resolutions-20jun11-en.htm. For further background including references, see document WO/GA/39/10, in particular paragraph 14.

[12]   ICANN's Applicant Guidebook is available at: http://newgtlds.icann.org/en/applicants/agb.

[13]   Delegated new gTLDs are listed at: http://newgtlds.icann.org/en/program-status/delegated-strings.

[14]   For further background including references, see WO/GA/39/10, in particular paragraphs 23 to 30. It is noted here that ICANN summarily rejected a proposal for a "Globally Protected Marks List".

[15]   Other objection grounds recognized by ICANN were: "String Confusion Objections", "Community Objections", and "Limited Public Interest Objections"). The Applicant Guidebook further includes a number of other procedures which governments may avail themselves of following ICANN announcement of new gTLD applications. Notably, section 1.1.2.4 provides for "GAC Early Warning," and section 1.1.2.7 provides for "Receipt of GAC Advice on New gTLDs" for the ICANN Board's consideration.

Recommendation Concerning Provisions on the Protection of Marks, and Other Industrial Property Rights in Signs, on the Internet"[16].

12.   Appointed by ICANN as the exclusive provider of LRO dispute resolution services[17], the Center received 69 compliant LRO filings, which it completed processing by September 2013[18]. All WIPO LRO expert panel determinations are available on the Center's website[19], as is a Center report on the LRO process[20].

−   Post-(TLD) Delegation Dispute Resolution Procedure (PDDRP)

13.   In early 2009, the Center communicated to ICANN a concrete substantive proposal for a permanent administrative option that would allow for the filing of a complaint with respect to an approved new gTLD registry operator whose manner of operation or use of its registry is alleged to cause or materially contribute to trademark abuse[21]. The proposal's intent was to offer standardized assistance to ICANN's own compliance oversight responsibilities, by providing an administrative alternative to court litigation, encouraging responsible conduct by relevant actors and including appropriate safe-harbors[22].

14.   Following various ICANN committee processes and consultations with registry operators, the effectiveness of this PDDRP in the form adopted by ICANN remains uncertain, in particular given the addition of overlapping procedural layers, and issues concerning the intended substantive scope of this mechanism. In light of broader policy interests, the Center in 2013 agreed with ICANN to become a provider for the trademark PDDRP[23].

(ii)   Second Level Rights Protection Mechanisms

−   Trademark Clearinghouse

15.   ICANN's New gTLD Program includes a "Trademark Clearinghouse" as a centralized repository of authenticated trademark data which could be invoked as the basis for filing under new gTLD RPMs[24]. The Center has commented that any such Clearinghouse should not

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[16]   Adopted by the WIPO General Assembly in September 2001; see http://www.wipo.int/about-ip/en/development_iplaw/pub845-toc.htm.
[17]   See section 3.2 of the ICANN Applicant Guidebook at http://newgtlds.icann.org/en/applicants/agb/objection-procedures-04jun12-en.pdf.
[18]   See WIPO Rules for New gTLD Dispute Resolution, and Schedule of Fees and Costs, respectively at http://www.wipo.int/amc/en/docs/wipolrorules.pdf and http://www.wipo.int/amc/en/domains/lro/fees/; see WIPO-registered LRO cases at http://www.wipo.int/amc/en/domains/lro/cases/.
[19]   See http://www.wipo.int/amc/en/domains/lro/cases/.
[20]   The WIPO LRO report notes that an overwhelming majority of LROs were filed against applications for gTLD strings with descriptive or dictionary meaning. Many expert panels concluded that where a trademark owner has adopted a common dictionary term as a trademark, a gTLD application intended solely to take advantage of such common dictionary meaning would not as such violate the decision standards for LROs. In certain cases panels addressed trademark registrations that were primarily obtained for the purpose of supporting an application for a new gTLD and/or LRO, with little or no demonstrable prior use. See http://www.wipo.int/amc/en/docs/lroreport.pdf.
[21]   See http://www.wipo.int/amc/en/docs/icann130309.pdf.
[22]   Given the perceived convergence of registry, registrar, and registrant roles within the DNS, the Center has further recommended, *inter alia* taking account of its UDRP-based experiences, and ICANN's decision to allow for cross-ownership between registries and registrars (see http://www.icann.org/en/minutes/resolutions-05nov10-en.htm), that ICANN consider extending the PDDRP for registries also to registrar conduct (see, *inter alia*, http://www.wipo.int/amc/en/docs/icann260310rap.pdf).
[23]   No cases have been filed under this mechanism as yet.
[24]   The Clearinghouse allows for inclusion of registered word marks, word marks protected by statute or treaty or validated by court, and "[o]ther marks that constitute intellectual property" (the latter being undefined). With respect to RPMs utilizing Clearinghouse data, the availability of "Sunrise" services (i.e., an opportunity for a trademark owner, for a fee, to preemptively register an exact match of its mark as a domain name) is limited to those trademarks for which current use can be demonstrated. Whether or not substantiated by demonstration of current use, trademark owners would also be eligible to participate in a time limited "Claims" service (i.e., notice to a potential domain name registrant of the existence of a potentially conflicting trademark right, and notice to the relevant trademark owner(s) in the event that the registrant nevertheless proceeds with domain name registration). As mandated by ICANN, the

unfairly burden rights holders in the treatment of trademark registrations legitimately obtained through examination and registration systems as applied in many global jurisdictions, and that, if and where relevant, practical measures may be envisaged to identify any allegedly inappropriate invocation of rights in specific contexts. As of August 2015, the Clearinghouse contained over 37,000 entries[25].

–   Uniform Rapid Suspension (URS) System

16.   While importantly the UDRP remains available as a curative tool for new gTLD disputes involving the considered transfer of a disputed domain name to the trademark owner, ICANN has introduced what is intended to be a lighter second-level RPM for appropriate cases[26].

17.   Having evolved from a sequence of ICANN processes and committees, the URS continues to raise a number of questions, including on its relationship to the UDRP[27]. ICANN invited tenders from prospective URS providers, to which after careful consideration of the ICANN URS model and related resources, the Center was not in a position to apply[28]. The Center continues to closely monitor developments.

B.   ICANN'S PLANNED REVISION OF THE WIPO-INITIATED UDRP; THE UDRP LOCK WORKING GROUP

18.   Accommodating the dynamic development of the DNS, the UDRP has been offering an effective alternative to court litigation for trademark owners, domain name registrants, and registration authorities. Nevertheless, following discussions at which the clear majority of participants were of the opinion that more harm than good could result from any review of the UDRP by ICANN as a registration-driven body[29], a decision was taken by ICANN's Generic Names Supporting Organization (GNSO) to review the UDRP. ICANN's Preliminary Issue Report on this topic is expected in October 2015. Separately, the Center has participated in an ICANN policy process that has reviewed and codified effective July 31, 2015 the practice of "locking" domain names to prevent so-called "cyberflight", as well as settlement procedures in UDRP proceedings. The Center continues to closely follow ICANN stakeholders' intentions with regard to the UDRP.

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availability of the Claims service is for a period of 90 days after a new gTLD is opened for general public registration, but users of the Clearinghouse can opt-in to receive notifications indefinitely. The demonstration of use required for Sunrise services similarly applies to the invocation of trademarks as a basis for a complaint filed under the "Uniform Rapid Suspension" RPM described below.

[25]   See http://www.trademark-clearinghouse.com/content/stats-0.

[26]   The Center for its part communicated to ICANN in April 2009 a discussion draft of an "Expedited (Domain Name) Suspension Mechanism" (see http://www.wipo.int/amc/en/docs/icann030409.pdf) and has made subsequent proposals for a streamlined mechanism based on this model at ICANN Meetings (see http://prague44.icann.org/node/31773 and http://toronto45.icann.org/node/34325). Such proposals took account of the need to strike a balance between the protection of trademark rights recognized by law, the practical interests of good-faith registration authorities to minimize operational burdens, and the legitimate expectations of *bona fide* domain name registrants.

[27]   An extensive inventory of these issues is provided *inter alia* in the Center's letter to ICANN of December 2, 2010, available at: http://www.wipo.int/amc/en/docs/icann021210.pdf.

[28]   The question of accreditation of providers gives rise to concerns as to the stability of RPMs; WIPO raised concerns about this as early as 2007 in the context of the UDRP (see http://www.wipo.int/amc/en/docs/icann040707.pdf).

[29]   See https://community.icann.org/display/gnsoudrpdt/Webinar+on+the+Current+State+of+the+UDRP; see also more generally document WO/GA/39/10, paragraph 31.

C.   INTERNATIONALIZED DOMAIN NAMES

19.   As noted in paragraph 8, another significant policy development in the DNS is the introduction of IDNs (non-Latin script) at the top level[30]. Many of these were among the first new gTLDs announced by ICANN for delegation into the DNS root zone.

D.   OTHER IDENTIFIERS

20.   In addition to and in connection with the above, there are further developments taking place at ICANN in relation to the protection of non-trademark identifiers.

        (i)   International Governmental Organizations (IGOs)

21.   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 other types of identifiers that had not been addressed, including country names and IGO names and acronyms.

22.   The 2002 WIPO General Assembly recommended amending the UDRP in order to provide protection for country names and for the names and acronyms of IGOs[31]. The WIPO Secretariat transmitted these recommendations to ICANN in February 2003[32].

23.   Following ICANN deliberations[33], ICANN's New gTLD Applicant Guidebook limited its consideration of the protection of the names and acronyms of IGOs to providing recourse through the pre-delegation objection procedure concerning the top level (i.e., an applied-for TLD), discussed in paragraphs 11 and 12 above. However, following sustained IGO efforts, ICANN's Governmental Advisory Committee (GAC) advised the ICANN Board that IGO identifiers be granted protection against inappropriate third-party registration in the DNS prior to the delegation of any new gTLDs[34]. The GAC further advised the ICANN Board that, building on existing criteria for ".int" second-level registrations, it would collaborate with IGOs to develop a list of IGO names and acronyms that should be protected. Such protection would be at the second level for the current round of new gTLDs, and at both the second and top level in any future new gTLD rounds. The GAC also advised the Board that, pending work on further implementation, interim protection for IGO names and acronyms should be provided through a moratorium on third-party registration prior to the delegation of any new gTLDs.

24.   The ICANN Board responded to the GAC indicating that it had adopted a resolution laying the groundwork for such interim protection at the second level based on the existing .int criteria, via an ICANN reserve list of IGO identifiers, to be withheld from third-party registration through the new gTLD Registry Agreement. ICANN invited qualifying IGOs to identify themselves to ICANN, while also seeking provision by the GAC (with IGOs) of a consolidated IGO package comprising the criteria and list of IGO names and acronyms for which the GAC advised protection[35]. In response, an IGO coalition developed .int-based criteria for IGO protection and

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[30]   See also ICANN's Final Implementation Plan for IDN ccTLD Fast Track Process published in November 2009 (see http://www.icann.org/en/topics/idn/fast-track/idn-cctld-implementation-plan-16nov09-en.pdf). Since then, this has allowed for the introduction of IDN ccTLDs, associated with the two-letter codes in the ISO 3166-1 standard (see http://www.iso.org/iso/english_country_names_and_code_elements).

[31]   See 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.

[32]   See http://www.wipo.int/amc/en/docs/wipo.doc.

[33]   For background, see WO/GA/41/17 Rev.2, in particular paragraphs 40 and 41.

[34]   See https://gacweb.icann.org/download/attachments/27132070/FINAL_Toronto_Communique_20121017.pdf?version=1&modificationDate=1354149148000&api=v2.

[35]   See https://gacweb.icann.org/download/attachments/27132070/Board%20Response%20to%20GAC%20Toronto%20Communique.pdf?version=1&modificationDate=1361909146000&api=v2.

an accompanying list of IGOs, which the IGO coalition forwarded to the ICANN Board in February 2013. This was followed by a GAC communication to the ICANN Board of the GAC's preferred advice on IGO protection eligibility criteria[36], together with a list of protectable IGO names and acronyms[37].

25.   On April 1, 2013, the Board wrote to the GAC with concerns as to how the protection of IGO acronyms would be reconciled with certain potentially legitimate third-party attempts to register domain names corresponding to a protected IGO acronym, and sought further particulars about the means by which cases of potentially legitimate co-existent use of such acronym could be managed in practice[38]. The GAC's response stressed the important global public mission of IGOs, committed to actively working to find a way forward, and reiterated its advice to the ICANN Board that preventative initial protection for listed IGO names and acronyms be in place before any new gTLDs would launch[39].

26.   In July 2013, following further discussions with ICANN and sustained efforts from IGOs, the GAC issued advice to the ICANN Board that highlighted the need for special preventative protection for IGO names and acronyms in the DNS[40]. Following this advice, the ICANN Board issued a resolution extending interim protection for IGOs until the first meeting of the ICANN Board's New gTLD Program Committee (NGPC) after the November 2013 ICANN meeting[41].

27.   In October 2013, the NGPC made a proposal for protection of IGO acronyms at the second level that fell well short of providing IGO acronyms with the permanent preventative protection envisaged in previous GAC Communiqués[42]. The IGO coalition responded to the NGPC indicating disappointment that the proposal was strictly curative in nature and did nothing to prevent harm from occurring in the first place, and also conveyed its concerns to the GAC.

28.   The NGPC, the GAC, and IGOs met around ICANN's November 2013 Buenos Aires meeting. The NGPC indicated that although specific technical points of its October 2013 proposal could be worked on, full preventative protection of IGO acronyms was intentionally excluded. The GAC advised the ICANN Board that interim protections for IGO acronyms should remain in place until the dialogue between the GAC, the NGPC and IGOs ensuring implementation of protection was completed, but without reiterating the GAC's previous position about the need for preventative protection[43]. In January 2014, the NGPC resolved to extend temporary protections for IGO acronyms until the NGPC made a final determination[44].

29.   In parallel to these efforts, the GNSO had launched a Policy Development Process (PDP) concerning IGO protection, in which process the Center with other IGO representatives participated. Over IGO objections, in November 2013 this GNSO process rejected preventative protection for IGO acronyms on the second level. Instead, it recommended curative protection mechanisms for IGO acronyms, coupled with the removal of the temporary protections for IGO acronyms in place. These recommendations were adopted unanimously by the GNSO Council

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[36]   Such criteria comprise treaty-based IGOs with international legal personality, or which are UN Observers, or which are funds or programs of the UN.

[37]   See http://www.icann.org/en/news/correspondence/dryden-to-crocker-chalaby-22mar13-en.

[38]   The Board also sought further specifics on means for periodic review of the list, along with clarification of any additional languages in which protection of IGO names and acronyms is sought. See http://www.icann.org/en/news/correspondence/crocker-to-dryden-01apr13-en.

[39]   See https://www.icann.org/en/system/files/correspondence/gac-to-board-18apr13-en.pdf.

[40]   The GAC further advised that it expressly assumed that the ICANN Board was prepared to fully implement the GAC advice and focus on practical and effective implementation of preventative protection at the second level in new gTLDs, and that the interim protections for IGO names and acronyms should remain in place until the dialogue between the GAC, ICANN and IGOs was completed. See http://durban47.icann.org/meetings/durban2013/presentation-gac-communique-18jul13-en.pdf.

[41]   See http://www.icann.org/en/groups/board/documents/resolutions-new-gtld-17jul13-en.htm.

[42]   The GAC and the NGPC had cancelled their participation in a September 30 meeting proposed by IGOs.

[43]   See http://www.icann.org/en/news/correspondence/gac-to-board-20nov13-en.pdf.

[44]   See http://www.icann.org/en/groups/board/documents/resolutions-new-gtld-09jan14-en.htm#2.d.i.

in November 2013. In response to this development, IGOs wrote to express concern noting that the mechanisms now foreseen would miss an important opportunity to curtail abuse of IGO acronyms in the DNS before harm could occur[45].

30. In February 2014, IGOs met with the ICANN NGPC representative to discuss the NGPC's October 2013 proposal. Following this, in March 2014, the NGPC provided a draft proposal for curative rights protection for IGO acronyms. Further discussions were held between IGOs and the NGPC in ICANN's March 2014 meeting, where the GAC also advised the ICANN Board that it was awaiting the Board's response regarding the implementation of previous GAC advice.

31. In April 2014, the ICANN Board resolved to adopt the GNSO Council recommendations not in conflict with GAC advice (reserving from registration the full names of IGOs at the top and second levels, in two languages) while requesting more time to consider the recommendations that then differed from GAC advice (duration of "claims notices"[46] and a potential curative RPM). Notwithstanding this GAC advice and IGO positions, in June 2014, the GNSO Council voted to initiate a second PDP on the desirability and modalities of giving IGOs access to curative RPMs (such as the UDRP or URS). In October 2014, the GAC affirmed its prior advice seeking a solution for IGO identifier protection at the second level, whereby such protection should not require amending the existing UDRP[47]. In January 2015, the NGPC again sought information from the GAC concerning the latter's understanding of "the nature and extent of the rights of international governmental organizations with respect to curative rights protections for IGO names and acronyms"[48].

32. In June 2015, the IGOs, GAC, and ICANN Board representatives met at the ICANN Buenos Aires meeting. The ICANN Board took note of progress towards a possible ADR and rapid-takedown mechanisms for protection of IGO identifiers and called for a "small group" to meet intersessionally with a view towards developing a concrete proposal for such mechanisms[49]. Notwithstanding continuing discussions, several questions remain as to the specifics of such mechanisms; it has again been affirmed however that any IGO-specific mechanism should not as such amend the existing UDRP. Together with other involved IGOs, the Center will continue to closely monitor developments in this longstanding ICANN file.

    (ii)   Geographical Terms

33. Concerning geographical terms, the GAC in particular has expressed concerns about their use and protection in the new gTLDs[50]. Concerning the top level[51], ICANN's Applicant Guidebook provides that "applications for strings that are country or territory names will not be

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[45] By way of example, the IGO letter cited illicit profiteering from UNICEF funding campaigns in the wake of humanitarian emergencies.

[46] See footnote 23.

[47] See https://gacweb.icann.org/download/attachments/27132037/Los%20Angeles_GAC%20Communique_Final.pdf?version=1&modificationDate=1413479079000&api=v2.

[48] See https://www.icann.org/en/system/files/correspondence/chalaby-to-schneider-22jan15-en.pdf.

[49] See https://gacweb.icann.org/display/gacweb/Governmental+Advisory+Committee?preview=/27132037/39256324/BA%20MinutesFINAL.pdf.

[50] In 2007 the GAC issued the "GAC Principles regarding New gTLDs", which states *inter alia* that ICANN should avoid delegation of new gTLDs concerning country, territory or place names, and regional language or people descriptions, unless in agreement with the relevant governments or public authorities. Those GAC Principles further stated that new registries should adopt procedures for blocking/challenge of names with national or geographical significance at the second level upon demand of governments. See http://gac.icann.org/web/home/gTLD_principles.pdf.

[51] Concerning second-level registrations, ICANN's base registry agreement includes a "Schedule of Reserved Names at the Second Level in gTLD Registries" which makes provision for certain country and territory names. See http://newgtlds.icann.org/en/applicants/agb/base-agreement-specs-04jun12-en.pdf at Specification 5.

approved, as they are not available under the New gTLD Program in this application round[52]".
Applied-for strings which are considered by ICANN to be certain other geographical names, e.g., capital city names, need to be accompanied by documentation of support or non-objection from the relevant governments or public authorities[53].

34.   GAC members have expressed further reservations regarding a number of new gTLD applications on grounds of correspondence to geographical or other "sensitive" terms, advising the ICANN Board not to proceed beyond initial evaluation, and seeking Board clarification on scope for applicants to modify their new gTLD applications to address specific GAC concerns[54].

35.   The Secretariat will continue to monitor developments and provide input where possible.

36.   The SCT is invited to take note of the contents of this document.

[End of document]

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[52]   See http://newgtlds.icann.org/en/applicants/agb/evaluation-procedures-04jun12-en.pdf, from section 2.2.1.4.1 "Treatment of Country or Territory Names".

[53]   See http://newgtlds.icann.org/en/applicants/agb/evaluation-procedures-04jun12-en.pdf, from section 2.2.1.4.2 "Geographic Names Requiring Government Support".

[54]   See https://www.icann.org/en/system/files/correspondence/gac-to-board-27mar14-en.pdf, at "4. Specific Strings". While the Board has accepted the GAC's advice against proceeding with certain applications, it has sought further information from the GAC, as well as public comments, on a range of additional safeguards sought by the GAC concerning several broad categories of new gTLD applications such as for those new gTLDs which correspond to regulated industries or dictionary terms. See https://gacweb.icann.org/download/attachments/27132037/Beijing%20Communique%20april2013_Final.pdf. A GAC Sub-group on Geographic Names (a Sub-group of the GAC Working Group on Future New gTLDs) has developed a draft document for future New gTLD rounds outlining several public policy aspects related to geographic names which is currently subject to further ICANN discussions. See https://gacweb.icann.org/download/attachments/27132037/Geo%20names%20in%20new%20gTLDs%20Updated%20%20V3%20%2029%20august%202014%5B4%5D.pdf?version=1&modificationDate=1411549935000&api=v2. At the GAC, and ICANN generally, discussions continue on this topic.