

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

**Forty-First Session
Geneva, April 8 to 11, 2019**

**PROPOSAL BY THE DELEGATIONS OF BRAZIL, GEORGIA, ICELAND, INDONESIA,
JAMAICA, LIECHTENSTEIN, MALAYSIA, MEXICO, MONACO, PERU, SENEGAL,
SWITZERLAND AND THE UNITED ARAB EMIRATES**

Document prepared by the Secretariat

In a communication dated February 8, 2019, the Delegations of Georgia, Iceland, Indonesia, Jamaica, Liechtenstein, Malaysia, Mexico, Monaco, Peru, Senegal, Switzerland and the United Arab Emirates transmitted to the International Bureau of the World Intellectual Property Organization (WIPO) the proposal contained in the Annex to the present document.

In a communication dated November 1, 2019, the Delegation of Brazil requested to be added to the list of co-sponsors of the proposal.

[Annex follows]

THE DELEGATIONS OF BRAZIL, GEORGIA, ICELAND, INDONESIA, JAMAICA,
LIECHTENSTEIN, MALAYSIA, MEXICO, MONACO, PERU, SENEGAL, SWITZERLAND
AND THE UNITED ARAB EMIRATES

REQUEST

the SCT to invite the WIPO General Assembly to adopt the following

PROPOSAL

CONCERNING THE PROTECTION OF COUNTRY NAMES AND GEOGRAPHICAL
NAMES OF NATIONAL SIGNIFICANCE IN THE DNS

A. OBJECTIVES AND RATIONALE

In the Domain Name System (DNS), once assigned, a top-level domain is unique. Allowing private companies to register geographic names as a top-level domain results in the monopolisation of these names, thereby depriving the concerned community from the possibility of using such names.

Country names and geographical names of national significance shall be protected against their delegation as top-level domain names in the DNS if the sign consists exclusively of such names.

At the second level, geographical names do not benefit adequately from the current rights protection mechanisms. In particular, the UDRP applies only to trademarks, whereas the geographical names protected by an IP title should also benefit from this protection mechanism.

B. PROTECTION OF COUNTRY NAMES AND GEOGRAPHICAL NAMES OF NATIONAL SIGNIFICANCE

The Internet Corporation for Assigned Names and Numbers (ICANN) is planning to open a second round of registration for new generic top-level domains (gTLDs)¹ which is expected to take place in 2020.

Two working groups were set up at ICANN to evaluate the conditions of protection for country names and geographical names within the scope of this second round of top-level domains registration².

Within the ICANN's decision-making process, the interests of the countries are expressed through the Governmental Advisory Committee (GAC). The GAC's role is to provide advice and recommendations to ICANN's board. The board, however, is not bound by the GAC's recommendations. Therefore states have very limited means to safeguard their legitimate interests at ICANN.

In March 2007, the GAC issued advice intended to inform ICANN's board of the views of the GAC regarding public policy issues. This advice concerned new gTLDs and recommended that the inherently sensitive nature of terms with national, cultural, geographic and religious significance be respected. It also recommended that country, territory or place names, and in addition country, territory or regional language groups or descriptions of peoples, unless otherwise agreed upon by the relevant governments or public authorities, should not be allowed in the gTLD space³. The GAC has consistently reiterated these principles⁴, with limited effect, given its purely advisory role.

The adoption of the present proposal by the WIPO General Assembly would safeguard, at the top level within the DNS, countries' sovereign rights to protect their identities and reputations as well as their legitimate public policy interests.

C. PROPOSED SOLUTION: PROTECTING NAMES ON EXISTING LISTS

In the early 2000s, at the request of several member states, WIPO launched a consultation process on internet domain names, in particular, the issue of registration of domain names that infringe upon indications of source and geographical names. Within this framework, the SCT held two special sessions in December 2001 and May 2002 and adopted the *Second Special Sessions Report* ("Report", SCT/S2/8) that recommends some form of protection for country names against registration or use by persons unconnected with the constitutional authorities of the country in question⁵. The Report also gave concrete guidance and established principles for the recommended protection⁶. A large majority of delegations approved these recommendations⁷. This strong support has also been noted at the WIPO General Assembly during its autumn session in 2002⁸. This recommendation was transmitted to the ICANN in 2003⁹.

The present proposal builds on the recommendations of the Report that were already supported by the SCT in 2002 and puts forward the following principles for the protection of country names:

- (i) The names of countries protected are those listed on the list established by the United Nations Group of Experts on Geographical Names (UNGEGN)¹⁰, as well as on the standard ISO 3166-1¹¹ (alpha 2 codes and alpha 3 codes).
- (ii) Both the long or formal names and the short names of countries are protected.
- (iii) Protection covers the exact names and, in order to include misleading variations, the former name of a country, its common name, the translation and transliteration of that name, as well as the name in a short or adjectival form.
- (iv) 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.

As regards the geographical names of national significance, the present proposal also protects them based mainly on existing lists, namely:

- (i) The ISO 3166-2 list concerning regions.
- (ii) The list of sites forming part of the cultural and natural heritage ("World Heritage List") which fall under the scope of the Convention concerning the Protection of the World Cultural and Natural Heritage¹².
- (iii) The names of capitals as listed in the UNGEGN Geographical Names Database shall also be protected as names of national significance.

In order to give each state the possibility to obtain protection for geographical names that are not capitals, nor listed on the ISO 3166-2 list or on the World Heritage List, the present proposition suggests that each country can, within a timeframe of 18 months, notify to the WIPO Secretariat a list of geographical names with national significance according to its relevant public policy or applicable national law. This list will be published on the WIPO website.

D. RELATIONSHIP TO OTHER ONGOING WORK ON GEOGRAPHICAL NAMES IN THE DNS

During the SCT's thirty-first session, the delegations of the Czech Republic, Germany, Hungary, Italy, Republic of Moldova and Switzerland tabled the Proposal SCT31/8 Rev. 8 ("Joint Proposal") on the protection of geographical indications and country names in the DNS. The delegations of Bulgaria, France, Iceland, Poland, Portugal, Romania and Spain subsequently signed up as co-sponsors of the proposal.

The Joint Proposal addresses the necessity to re-examine and extend to geographical indications and country names the Uniform Domain-Name Dispute Resolution Policy (UDRP) principles, which are currently limited to trademarks.

In 2011 a decision was taken by ICANN's Generic Names Supporting Organization (GNSO) to review the rights protection mechanisms¹. The revision process regarding the UDRP has not started yet. It would therefore be appropriate from a time point of view to share with ICANN the concerns of WIPO members so that participants in these review mechanisms can take these claims into account during the UDRP review process.

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¹ See SCT/40/4 (September 17, 2018), Update on Trademark Related Aspects of the Domain Name System, Document prepared by the Secretariat

On the basis of the above

Acknowledging the importance of country names and geographical names of national significance and the potential of misappropriation of these names by private entities.

Recognizing that in the Domain Name System (DNS), once assigned, a top-level domain is unique.

Recognizing that the registration by private entities of geographical names as a top-level domain results in the monopolisation of these names, thereby depriving the concerned community from the possibility of using such names.

Noting that the United Nations Group of Experts on Geographical Names (UNGEGN) establishes regularly a list of formal and short country names, that the alpha 2 codes and alpha 3 country codes are listed in the standard ISO 3166-1 and that the names of regions such as states in federal countries, provinces and departments are listed in the standard ISO 3166-2.

Noting that the Internet Corporation for Assigned Names and Numbers (ICANN) is planning to open new rounds of registration for new generic top-level domains (gTLD), the first being expected to take place in 2020.

Recalling that the SCT held two special sessions in December 2001 and May 2002 and adopted the *Second Special Sessions Report* (SCT/S2/8) in which most of the delegations recommended to protect country names against registration as top-level domain.

Noting that ICANN's Generic Names Supporting Organization (GNSO) is about to start a review of the Uniform Domain-Name Dispute Resolution Policy (UDRP) principles and that it is timely appropriate to transmit members concerns regarding the protection of geographical indications and country names before or during this review.

Recalling the Proposal SCT31/8 Rev.8, supported by several member states, on the protection of geographical indications and country names in the DNS at the second level.

The WIPO General Assembly recommends:

- I. to protect the country names and geographical names of national significance against their delegation as top-level domain names in the DNS, except if the delegation application counts with the explicit support or non-objection of the relevant public authority concerned.
- II. The list of country names and geographical names of national significance includes:
 1. the formal and short country names as well as their capital cities in all language versions contained in the most recent United Nations Group of Experts on Geographical Names (UNGEGN), including translations and transliterations into the national language(s) of the country where a distinctive sign is registered, and for top-level domains, into national languages of all countries, as well as in adjectival form in the six official languages of the United Nations and the concerned country's national language(s);
 2. the former or alternative name of a country names listed under III.1. in the six official languages of the United Nations and the concerned country's national language(s);
 3. the names of regions such as states in federal countries, provinces and departments as listed in the standard ISO 3166-2;

4. the alpha 2 codes and alpha 3 codes as listed in the standard ISO 3166-1;
5. the geographical names of national significance, inter alia the names of the UNESCO regions listed as World Heritage Sites; other geographical names with national significance according to the concerned country's relevant public policy or applicable national law. WIPO member states may notify a list of such names to the WIPO Secretariat within a deadline of 18 months following the adoption of this proposal. The list will be published by the WIPO.

III. to grant a rights protection mechanism at the second level of the DNS for geographical indications and country names.

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¹ A first round of registrations of new gTLDs took place in spring 2012. Within this framework, ICANN adopted allocation rules for its new gTLD names gathered in the gTLD Applicant Guidebook (AGB 2012).

AGB 2012 can be found here : <https://newgtlds.icann.org/en/applicants/agb>

² The "GNSO New gTLD Subsequent Procedures Policy Development Process (New gTLD Subsequent Procedures Policy PDP)" and the "Cross-Community Working Group on Use of Names of Countries and Territories as Top Level Domains (CWG-UCTN)".

³ GAC PRINCIPLES REGARDING NEW gTLDs, Presented by the Government al Advisory Committee in March 28, 2007. Can be consulted here: <https://archive.icann.org/en/topics/new-gtlds/gac-principles-regarding-new-gtlds-28mar07-en.pdf>

⁴ Nairobi Communique in 2010, Durban Communique in 2013, Helsinki Communique in 2016 and Johannesburg Communique in 2017.

⁵ Document SCT/S2/8, Para 210.

⁶ Document SCT/S2/8. The Report recommended the following protection for Country Name domain names: "(1) A list of Country Names should be made, using both the United Nations Terminology Bulletin 347/Rev. 1 and, as necessary, ISO Standard 3166, including both formal names and the short names of countries and any additional names by which countries are commonly know; (2) protection should cover both the exact names and misleading variations; (3) the Country Names should be protected in the official language (s) of the country concerned and in the six official languages of the United Nations; (4) the protection should be extended to all top-level domains, both gTLDs and ccTLDs; and (5) 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." Para 210.

⁷ Document SCT/S2/8: "The Chair concluded that most delegations favored some form of protection for country names against registration or use by persons unconnected with the constitutional authorities of the country in question." "The Delegations of Australia, Canada and the United States of America dissociated themselves from this recommendation". Para 210.

⁸ Document WO/GA/28/7, para. 80.

⁹ Letter to ICANN, dated February 21, 2003. "The SCT [...] adopted a decision that the short and long names of States, as set out in the United Nations Terminology Bulletin, should be protected against identical and misleadingly similar registrations as domain names by persons unconnected with the constitutional authorities of the States concerned. It was recommended that this protection should be implemented through an amendment of the UDRP and should apply to all future registrations of domain names in the gTLDs". "The decision on the protection of country names was supported by all Member States of WIPO, with the exception of Australia, Canada and the United States of America, which dissociated themselves from the decision. Japan also expressed certain reservations, which are recorded in the text of the decision."

¹⁰ In 2002, the SCT recommended to base the listing of countries or areas in the six official languages of the United Nations on the Terminology Bulletin No. 347/Rev.1, prepared by the Department of General Assembly Affairs and Conference Services of the United Nations Secretariat (available here: http://www.un.org/en/ga/search/view_doc.asp?symbol=ST/CS/SER.F/347/Rev.1). This document is no more accurate. This proposition is based on the most recent lists of country names established by the UNGEGN Working Group on Country Names as approved at the UN Conference on the Standardization of Geographical Names. This conference takes place every 5 years. The most recent list of country names has been approved at the Eleventh Conference in August 2017. It is available as E/CONF.105/13 here: https://unstats.un.org/unsd/geoinfo/UNGEgn/docs/11th-uncsgn-docs/E_Conf.105_13_CRP.13_15_UNGEgn%20WG%20Country%20Names%20Document.pdf.

[Endnote continued on next page]

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¹¹ ISO 3166 is the International Standard for country codes and codes for their subdivisions established by the International Organization for Standardization (available at <https://www.iso.org/iso-3166-country-codes.html>).

¹² Convention concerning the Protection of the World Cultural and Natural Heritage adopted on 23 November, 1972, under the auspices of the United Nations Educational, Scientific and Cultural Organization (UNESCO). The WIPO considered this list as a useful instrument in this regard in its Final Report of the Second WIPO Internet Name Process. The World Heritage List as well as the ISO list have served as the basis for the allocation of rules in the AGB2012.