

THE RECOGNITION OF RIGHTS AND THE USE OF NAMES
IN THE INTERNET DOMAIN NAME SYSTEM

Report
of the
Second WIPO Internet Domain Name Process
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EXECUTIVE SUMMARY

The Second WIPO Internet Domain Name Process was initiated at the request of the Member States of WIPO. It follows the first such WIPO Process, which investigated the interface between trademarks and Internet domain names, and recommended the establishment of a uniform dispute-resolution procedure to deal with disputes concerning the bad faith registration and use of trademarks as domain names, or “cybersquatting.” The Uniform Domain Name Dispute Resolution Policy (UDRP), which was adopted by the Internet Corporation for Assigned Names and Numbers (ICANN) as a consequence of the first WIPO Process, has proven to be an efficient and cost-effective international mechanism, responsive to the particular circumstances of the domain name system (DNS) as a global addressing system. The WIPO Arbitration and Mediation Center, as a leading provider of services under the UDRP, has received, at the date of publication of this Report, over 3000 complaints under it, of which well over 80% have been resolved.

The Second WIPO Process concerns a range of identifiers other than trademarks and is directed at examining the bad faith and misleading registration and use of those identifiers as domain names. These other identifiers, which form the basis of naming systems used in the real or physical world, are:

- International Nonproprietary Names (INNs) for pharmaceutical substances, a consensus-based naming system used in the health sector to establish generic names for pharmaceutical substances that are free from private rights of property or control;
- The names and acronyms of international intergovernmental organizations (IGOs);
- Personal names;
- Geographical identifiers, such as indications of geographical source used on goods, geographical indications, and other geographical terms;
- Trade names, which are the names used by enterprises to identify themselves.

The international legal framework for the protection of these other identifiers is not as developed as it is for the protection of trademarks. In some cases, for example, geographical indications and trade names, elements of international protection exist, but they do not constitute a complete system that is uniformly applied throughout the world. In other cases, for example, personal names and the names of geographical localities, such as cities, used outside the context of trade in goods, there are no clear elements of an international framework.

The Report finds that there is considerable evidence of the registration and use of the identifiers examined in the Report as domain names by persons who might be considered not to be properly entitled to use the identifiers in question. Moreover, it is clear from the comments received by WIPO in the process leading to the Report that the registration of these identifiers as domain names by such persons offends many sensitivities. For example, many commentators considered that the registration as domain names of the names of eminent political, scientific or religious persons, or the names of countries, cities or indigenous peoples, by parties without any association with the persons, places or peoples concerned, was unacceptable.

The possibility of registering these identifiers as domain names is a consequence of the first-come, first-served, highly automated and efficient nature of the system used for domain name registration, which does not involve any screening of domain name applications. That same system has also allowed the tremendous growth that has taken place in the use of the Internet, while acting as the means of preserving universal connectivity on the Internet.

While the sensitivities offended by the registration and use of the identifiers considered in this Report by unconnected parties must be acknowledged, the insufficiencies of the current international legal framework must also be recognized. It is for the international community to decide whether it wishes to address any of these insufficiencies in order to establish an adequate legal basis to deal with the practices that might be considered to be unacceptable. Chapter Two of the Report outlines the instruments at the disposal of the international community for this purpose. These instruments include self-regulation, the deployment of the contractual system within the DNS that allows ICANN to ensure certain uniform rules with

respect to domain name registries, registrars and registrants, and the more traditional instrument of the treaty. These instruments are not exclusive, but can be used in combination. Thus, the UDRP represents a deployment, through the contractual relations that make up the ICANN system, of established rules relating to trademark protection that have been developed in widely accepted treaties. It will be for the international community to choose not only whether it wishes to make new rules to deal with any of the identifiers examined in this Report, but also how it may wish to develop such rules and implement them.

The specific findings and recommendations made with respect to the various identifiers examined in this Report are:

(i) For *INNs*, which are examined in Chapter Three of the Report, it is recommended that a simple mechanism be established which would protect INNs against identical domain name registrations. The mechanism would allow any interested party to notify WIPO that a domain name registration is identical to an INN, whereupon WIPO would, in conjunction with the World Health Organization (WHO), verify the exact similarity between the domain name and the INN and notify this to ICANN, which would, in turn, notify the registrar with which the registration was made that the domain name registration should be cancelled.

(ii) For the *names and acronyms of IGOs*, which are examined in Chapter Four of the Report, it is recommended that States, as the constituents of IGOs, should work towards the establishment of an administrative dispute-resolution procedure, akin to the UDRP, where an IGO could bring a complaint that a domain name was the same or confusingly similar to the name or acronym of the IGO, that it has been registered without legal justification and that it is likely to create a misleading association between the holder of the domain name registration and the IGO in question.

(iii) For *personal names*, which are the subject of Chapter Five of the Report, it was found that there are no existing international norms dealing with their protection and that national legal systems provide for a wide diversity of legal approaches to their protection.

The sensitivities offended by the registration of personal names as domain names by parties unconnected with the persons in question is recognized, and it is suggested that the international community needs to decide whether it wishes to work towards some means of protection of personal names against their abusive registration as domain names.

(iv) For *geographical identifiers*, which are dealt with in Chapter Six, it is recognized that certain norms exist at the international level which prohibit false and deceptive indications of geographical source on goods and which protect geographical indications, or the names of geographical localities with which goods having particular characteristics derived from that locality are associated. However, these rules apply to trade in goods and may require some adaptation to deal with the perceived range of problems with the misuse of geographical indications in the DNS. Furthermore, the lack of an international agreed list of geographical indications would pose significant problems for the application of the UDRP in this area because of the need to make difficult choices of applicable law. It is suggested that the international framework in this area needs to be further advanced before an adequate solution is available to the misuse of geographical indications in the DNS. As far as other geographical terms are concerned, the Report produces considerable evidence of the widespread registration of the names of countries, places within countries and indigenous peoples as domain names by persons unassociated with the countries, places or peoples. However, these areas are not covered by existing international laws and a decision needs to be taken as to whether such laws ought to be developed.

(v) For *trade names*, which are the subject of Chapter Seven, the situation is similar to that of geographical indications, insofar as certain international norms exist for the protection of trade names, but fundamental problems exist in identifying across differing national approaches what constitutes a protectable trade name, and consequently, in avoiding highly complex choices of applicable law on a global medium. It is recommended that no action be taken in this area.

1. THE MANDATE AND ITS CONTEXT

1. On June 28, 2000, the Director General of WIPO received a request from 19 of WIPO's Member States to develop, through a consultative process, recommendations on means of dealing with the “bad faith, abusive, misleading or unfair use,” within the Internet domain name system (DNS), of identifiers that form the basis of certain naming systems used in the real or non-virtual world.¹ The identifiers specified were:

- personal names;
- International Nonproprietary Names (INNs) for pharmaceutical substances;
- the names of international intergovernmental organizations;
- geographical indications, geographical terms, or indications of source; and
- trade names.

The Request was subsequently endorsed by the WIPO General Assembly, the constituent organ of the Member States of WIPO.²

2. The Request established three process criteria for WIPO's work:

- (i) first, it was specified that “this activity should take full advantage of WIPO's prior work”;
- (ii) secondly, the activity should “build on existing and ongoing discussions”; and
- (iii) thirdly, the Request indicated that the activity should “allow...for a process of consultation with WIPO Members and all interested stakeholders.”

WIPO'S PRIOR WORK

3. In June 1998, the National Telecommunications and Information Administration (NTIA), an agency of the United States Department of Commerce, issued a *Statement of Policy on the Management of Internet Names and Addresses* (the “White Paper”).³ The White

Paper called for the creation of a new, private, not-for-profit corporation which would be responsible for coordinating certain DNS functions for the benefit of the Internet as a whole. Following the publication of the White Paper, a process occurred which resulted in the formation of the Internet Corporation for Assigned Names and Numbers (ICANN), a not-for-profit corporation established under the laws of the State of California of the United States of America. The by-laws of ICANN and documentation on the various meetings that it has organized and activities that it has carried out are available on ICANN's web site, *www.icann.org*.

4. In response to growing publicity and concern over the interface between domain names and trademarks, and the lack of definition of the relation between these two species of identifiers, the White Paper also addressed certain intellectual property questions. In particular, the White Paper stated that the United States Government would “seek international support to call upon the World Intellectual Property Organization (WIPO) to initiate a balanced and transparent process, which includes the participation of trademark holders and members of the Internet community who are not trademark holders,” to develop recommendations on certain aspects of the interface between domain names and trademarks, including “a uniform approach to resolving trademark/domain name disputes involving cyberpiracy.”

5. Following the publication of the White Paper, and with the subsequent approval of its Member States,⁴ WIPO carried out between July 1998 and April 1999 an extensive and intensive process of consultations directed at developing recommendations on the issues which it was requested to address.

6. The WIPO Process, known as the WIPO Internet Domain Name Process, was conducted using a combination of Internet-based consultations, paper-based consultations and 17 physical meetings held in 14 countries. Participation was solicited from governments, intergovernmental organizations, professional and industry associations, corporations and individuals through three Requests for Comments. Responses were received to those Requests for Comments from 40 States, 6 intergovernmental organizations,

72 non-governmental organizations representing professional, industry and other special interests, 181 corporations and law firms and 182 individuals.

7. The Report of the WIPO Internet Domain Name Process, *The Management of Internet Names and Addresses: Intellectual Property Issues*,⁵ was published on April 30, 1999. The Report contained a series of recommendations. Chief amongst those recommendations was the establishment of a uniform dispute-resolution policy and procedure for resolving disputes over the alleged bad faith and deliberate misuse of trademarks through the registration of domain names in the generic top-level domains (gTLDs) .com, .net and .org.

The Uniform Domain Name Dispute Resolution Policy for gTLDs

8. Following the publication of the Report of the WIPO Internet Domain Name Process and certain consultation procedures in conformity with the by-laws of ICANN, ICANN adopted, in August 1999, a Uniform Domain Name Dispute Resolution Policy (UDRP), which entered into force for the gTLDs .com, .net and .org on December 1, 1999, and January 1, 2000 (the policy was phased-in for registrars over the two dates).

9. The UDRP establishes a dispute-resolution procedure under which a complainant can seek the transfer or cancellation of a domain name registration in .com, .net or .org on the basis that (i) the domain name is identical or confusingly similar to a trademark in which the complainant has rights; (ii) the domain name holder has no rights or legitimate interests in respect of the domain name; and (iii) the domain name has been registered and is being used in bad faith. The UDRP is a mandatory procedure to which each applicant for a domain name registration in .com, .net or .org is required to submit, in the event that a complaint is lodged in respect of the applicant's registration.

10. ICANN has accredited four dispute-resolution service providers to administer disputes brought under the UDRP: the WIPO Arbitration and Mediation Center, the National Arbitration Forum, e-Resolution and the CPR Institute for Dispute Resolution. Registrars accredited by ICANN to accept registrations in .com, .net or .org are obligated to implement the results of panel decisions under the dispute resolution procedure.

11. Between the date of commencement of the UDRP on December 1, 1999, and the end of July 2001, some 4,155 cases had been initiated under the UDRP. Of these, 2821 were filed with the WIPO Arbitration and Mediation Center.

12. The UDRP has proven itself to be an efficient and cost-effective means of resolving disputes over the bad faith and deliberate misuse of trademarks through the registration and use of domain names in the gTLDs. Of the 2821 cases filed the WIPO Arbitration and Mediation Center since the commencement of the UDRP, 88% have been resolved. Filing a case with the WIPO Center costs US\$1500 and a decision is normally given within 50 days of the commencement of the procedure.⁶ The procedure has attracted widespread international participation, with cases being filed with the WIPO Center by parties from 85 countries.

EXISTING AND ONGOING DISCUSSIONS

13. There are several “existing and ongoing discussions” or developments which may have an impact, directly or indirectly, on the UDRP and on the various issues that WIPO has been requested to address in respect of the interface between domain names and certain identifiers other than trademarks.

UDRP Review

14. The by-laws of ICANN⁷ provide for three advisory bodies known as “Supporting Organizations” (Article VI, Section 1(a)). The Supporting Organizations “serve as advisory bodies to the Board [of Directors], with the primary responsibility for developing and recommending substantive policies regarding those matters falling within their respective responsibilities” (Article VI, Section 2(b)). The three Supporting Organizations are the Address Supporting Organization, the Domain Name Supporting Organization and the Protocol Supporting Organization.

15. The Domain Name Supporting Organization (DNSO) has the responsibility of advising the Board “with respect to policy issues relating to the Domain Name System” (Article VI-B, Section 1 (a)). The scope of such policy issues is presumably not open, but is circumscribed by the Articles of Incorporation of ICANN,⁸ which set out the purposes and functions of ICANN (thus, for example, the policy issues would not include taxation or criminal law). The DNSO has two organs, a Names Council, consisting of representatives of various “constituencies,” and a General Assembly, consisting of “all interested individuals and entities” (Article VI-B, Section 1(b)).

16. The constituencies of the DNSO Names Council “self-organize” and “determine [their] own criteria for participation” (Article VI-B, Section 3(a)). There are seven constituencies of the DNSO Names Council, namely ccTLD registries; commercial and business entities; gTLD registries; ISP and connectivity providers; non-commercial domain name holders; registrars; and trademark, other intellectual property and anti-counterfeiting interests (Article VI-B, Section 3(b)).

17. The Business Plan for the DNSO Names Council 2001-2002⁹ includes two items concerning the UDRP amongst its proposed objectives for the Names Council 2001-2002:

“UDRP.

a. Review and evaluate the Uniform Dispute Resolution Policy and propose changes for consideration by the ICANN Board.

b. Consider need for further revisions in the light of the 2000-2001 Second WIPO Domain Name Process WIPO2 RFC-2 looking at issues involving domain names and property other than trademarks.”

Work on the abovementioned items is only in its initial stages, but, obviously, that work may have an impact both on the existing operation of the UDRP and on any future modification of the UDRP in the light of the present WIPO Report.

ccTLDs

18. In parallel to the Request to WIPO, referred in paragraph 1, above, which led to the publication of this present WIPO Report, WIPO also received from the same 19 Member States a Request “to develop, for the assistance of the administrators in ccTLDs, voluntary guidelines for the development of practices and policies to curb abusive and bad faith registration of protected names, and to resolve related disputes.”¹⁰ This second Request was also endorsed by the WIPO General Assembly.¹¹

19. The ccTLDs are those top-level domains which bear two letter codes essentially derived from the International Organization for Standardization’s (ISO) Standard 3166. In accordance with the second Request addressed to it, WIPO initiated a ccTLD program, which included consultations and an international conference held in Geneva on February 20, 2001. The program led to the publication of the *WIPO ccTLD Best Practices for the Prevention and Resolution of Intellectual Property Disputes*.¹²

20. Twenty-two ccTLDs have now adopted the UDRP within their domains. Those 22 ccTLDs are: .AC (Ascension Island), .AG (Antigua and Barbuda), .AS (American Samoa), .BS (Bahamas), .BZ (Belize), .CY (Cyprus), .EC (Ecuador), .FJ (Fiji), .GT (Guatemala), .LA (Lao People’s Democratic Republic), .MX (Mexico), .NA (Namibia), .NU (Nuie), .PA (Panama), .PH (Philippines), .PN (Pitcairn Island), .RO (Romania), .SH (Saint-Helena), .TT (Trinidad and Tobago), .TV (Tuvalu), .VE (Venezuela), and .WS (Western Samoa). To date, 46 cases relating to domain name registrations in the abovementioned ccTLDs have been filed under the UDRP with the WIPO Arbitration and Mediation Center.

21. WIPO continues to work with administrators of ccTLDs to provide advice on the protection of intellectual property within the ccTLDs. This advisory activity will, in the future, take into account the recommendations contained in the present WIPO Report and the responses to those recommendations from the Member States of WIPO and the Internet community.

“Internationalized” Domain Names

22. Various efforts are under way in the Internet community to make domain names available in non-Roman or non-ASCII scripts, such as Arabic, Chinese, Cyrillic, Japanese or Korean.

23. The Internet Engineering Task Force (IETF) has established an Internationalized Domain Name (IDN) Working Group, whose goal is “to specify the requirements for internationalized access to domain names and to specify a standards track protocol based on the requirements.”¹³ According to the charter of the Working Group, a “fundamental requirement in this work is to not disturb the current use and operation of the domain name system, and for the DNS to continue to allow any system anywhere to resolve any domain names.” The Working Group has not yet completed its work.

24. VeriSign Global Registry Services (VeriSign GRS), a leading provider of domain name registry services and DNS support to the Internet, has introduced an Internationalized Domain Name Testbed.¹⁴ According to the VeriSign GRS “General Information Paper on Internationalized Domain Name Resolution,”¹⁵ the “VeriSign GRS approach in implementing its testbed is to insure adherence to the Internet Architecture Board (IAB) principle of a single DNS route and continued compliance with the evolving standards under development by the Internationalized Domain Name (IDN) Working Group of the Internet Engineering Task Force (IETF).” The VeriSign GRS Internationalized Domain Name Testbed has commenced the phase of resolution of non-Roman script registrations that have been made under the Testbed.

25. On September 25, 2000, the ICANN Board passed a resolution which recognized “that it is important that the Internet evolve to be more accessible to those who do not use the ASCII character set,” and which stresses that “the internationalization of the Internet domain name system must be accomplished through standards that are open, non-proprietary, and fully compatible with the Internet’s existing end-to-end model and that preserve globally unique naming in a universally resolvable public name space”.¹⁶ At its meeting on March 13, 2001, the ICANN Board adopted a resolution establishing an internal working

group “to identify the various internationalization efforts and the issues they raise, to engage in dialogue with technical experts and other participants in these efforts, and to make appropriate recommendations to the Board.”¹⁷ The ICANN IDN Internal Working Group has not completed its work.

26. The UDRP applies to all domain name registrations in the gTLDs .com, .net and .org. If those registrations are effected in non-Roman or non-ASCII script, the UDRP thus applies. The WIPO Arbitration and Mediation Center has already received 15 cases under the UDRP concerning internationalized domain name registrations effected under the VeriSign GRS Internationalized Domain Name Testbed. The cases concerned internationalized domain names in Chinese, Japanese, Norwegian (æ), German (ö) and French (é). Decisions have been given in 7 of the 15 cases filed.

27. The internationalization of domain names is manifestly an immensely important development in the DNS and one which will, inevitably, have intellectual property implications. The problem of conflicting trademarks across different languages and different language scripts is a problem that is already well known to the trademark community, which has a long experience with trademark registrations being effected in the various languages and language scripts used around the world. It may be expected, however, that the introduction of internationalized domain names will introduce certain dimensions to the problem of conflicting identifiers across different languages and language scripts which are additional to those already experienced in respect of conflicting trademark registrations. Those new dimensions are likely to include the evaluation of the importance of phonetic similarity in the context of a largely visual or textual medium, the speed and relatively low cost with which a domain name registration can be obtained compared to the time and cost associated with obtaining trademark registrations and the automaticity of domain name registrations in contrast to the examination procedure that precedes the registration of trademarks.

New gTLDs

28. At its meeting on November 16, 2000,¹⁸ the ICANN Board selected the following seven new top-level domains for introduction: .aero, .biz, .coop, .info, .museum, .name and .pro.

The selection followed a process conducted by ICANN which included the publication of criteria for assessing new TLD proposals, a call for applications, the publication of the non-confidential portions of the 47 applications received, a public comment period and the publication of a report evaluating the applications received.

29. The seven new gTLDs fall into two categories: (i) “unsponsored” TLDs, which are intended to be relatively large and to operate under policies established by “the global Internet Community directly through the ICANN process,”¹⁹ and (ii) “sponsored” TLDs, each of which is intended to be “a specialized TLD that has a sponsoring organization representing the narrower community that is most affected by the TLD.”²⁰ The following table gives details of the name, nature, intended purpose and registry operator of each of the seven new gTLDs.

Table 1
New gTLDs

TLD	Nature	Intended Purpose	Registry Operator
.aero	Sponsored	Air-transport industry	Société internationale de télécommunications aéronautiques, SC (SITA)
.biz	Unsponsored	Businesses	NeuLevel, Inc.
.coop	Sponsored	Cooperatives	National Cooperative Business Association (NCBA)
.info	Unsponsored	Unrestricted use	Afilias, LLC
.museum	Sponsored	Museums	Museum Domain Management Association (MuseDoma)
.name	Unsponsored	Individuals	Global Name Registry Ltd.
.pro	Unsponsored	Accountants, lawyers and physicians	RegistryPro Ltd.

30. The unsponsored TLDs will operate under “Registry Agreements” with ICANN. A common form of basic agreement has been negotiated with each of the four selected unsponsored TLD registry operators. Negotiations for agreements with sponsoring organizations for the three sponsored TLDs are in process.

31. The timetable for the introduction of the new gTLDs has not yet been completed. Two of the new gTLDs have announced dates for the commencement of operations open to the public, namely .info, which will commence on September 19, 2001,²¹ and .biz, which will commence on October 1, 2001.²² The dates for the commencement of operations of the other new gTLDs will be announced in due course. WIPO has been working with the Registries of the new gTLDs to provide advice and assistance concerning appropriate dispute-resolution policies.²³

32. *Intellectual Property Considerations.* One of the terms of reference of the first WIPO Internet Domain Name Process was to evaluate the effects of adding new gTLDs and related dispute-resolution procedures on trademark and intellectual property holders.²⁴ The Report of that process concluded that, subject to the implementation of recommendations made in the Report, new gTLDs could be introduced “provided that they are introduced in a slow and controlled manner which takes account of the efficacy of the proposed new practices and procedures in reducing existing problems.”²⁵

33. All four new unsponsored gTLDs are expected to apply the UDRP. In addition, three of them, .biz, .name and .pro are expected to apply a dispute-resolution procedure as a means of enforcing the limitation of purpose governing them (registration by businesses for .biz, registration by individuals for .name and registration by accountants, lawyers and physicians for .pro). The intended dispute-resolution policies to be applied by the new sponsored gTLDs are in the process of development, but they are expected to address potential questions of bad faith abuse of intellectual property rights and enforcement of restriction conditions governing the purpose of the new gTLDs.

34. In addition to the UDRP and other dispute-resolution policies that will govern open registry operations, the first two new gTLDs to come online have established procedures aimed at minimizing bad faith abuse of trademark rights during the initial start-up phase of registry operations. .info is implementing a “sunrise” period (from July 25, 2001 to August 28, 2001) during which trademark holders may register their exact trademarks as domain names in .info. The sunrise period will be followed by a period during which a Sunrise Challenge Policy will apply under which a person may challenge a registration made during the sunrise period on the ground that the registration does not conform to the requirements for registration during the sunrise period (for example, the domain name is not identical to the trademark claimed in support of it).²⁶ Afilias, the Registry operator of .info, has also announced that it will itself initiate challenges in respect of manifestly false registrations of names during the sunrise period.²⁷ In the case of .biz, the Registry operator, Neulevel, is implementing a procedure whereby a trademark owner may register a claim with respect to the trademarks that it owns. If a domain name registration is made by a third party in respect of the trademarks claimed, the trademark owner which has registered the claim will be notified of the registration. The trademark owner will then have the opportunity to initiate a challenge in respect of the domain name on the ground that the domain name has been registered or is used in bad faith.

35. It is too early in the process of the introduction of the new gTLDs to assess what impact, if any, they will have on intellectual property. The introduction of the new gTLDs will be closely monitored by all and, in particular, from the perspective of intellectual property, with respect to the following issues:

(i) the effectiveness of sunrise and other procedures for reducing the bad faith violation of trademark rights during the start-up phase of new gTLDs;

(ii) the impact of increased differentiation in the DNS upon the interface between domain names and intellectual property rights and whether increased segmentation in the DNS will create greater space for brand differentiation or increase the number of problems experienced with respect to the bad faith violation of intellectual property rights through domain name registrations;

- (iii) the response to greater differentiation in the DNS on the part of Internet users, search engines and directory services; and
- (iv) the design and inter-relationship between WHOIS services across an extended DNS.

A Unique, Authoritative Root

36. The DNS relies upon a single authoritative root to ensure reliable universal connectivity on the Internet. As stated by the Internet Architecture Board (IAB):

“To remain a global network, the Internet requires the existence of a globally unique public name space. The DNS name space is a hierarchical name space derived from a single, globally unique root. This is a technical constraint inherent in the design of the DNS. Therefore it is not technically feasible for there to be more than one root in the public DNS. That one root must be supported by a set of coordinated root servers administered by a unique naming authority.”²⁸

37. Various attempts have been made by operators to establish alternate roots. Certain of these attempts are considered to be benign insofar as they are either purely private, and thus insulated from the public DNS, or experimental and intended not to interfere with the operation of the DNS. Others have been commercially established to support top-level domains to compete with the single root managed by ICANN and may be considered to pose potential threats to the stability and reliability of the DNS.

38. On May 28, 2001, ICANN published a “Discussion Draft: A Unique, Authoritative Root for the DNS” for comments.²⁹ On July 9, 2001, ICANN published Internet Coordination Policy 3 (ICP-3) “A Unique, Authoritative Root for the DNS.”³⁰ In this latter instrument, ICANN affirms its “commitment to a single, authoritative public root for the Internet Domain Name System (DNS) and to the management of that unique root in the public interest according to policies developed through community processes.”

39. From the intellectual property perspective, alternate roots present the possibility of a loss of cohesion in the application of the UDRP. As described in paragraphs 9 and 10 above, and in Chapter 2 below, the UDRP represents a contractually based system for the implementation of intellectual property policy in the DNS. Intellectual property policy, as expressed in the UDRP, is implemented through registrar accreditation agreements with ICANN and through the contract between the applicant for a domain name registration and the registrar under which the holder of the domain name registration agrees to submit to the uniform dispute-resolution procedure if challenged by a third party. Insofar as alternate roots lie outside the contractual system established by ICANN, the application of the UDRP by operators of alternate roots is not ensured and depends upon their voluntary adoption of the UDRP or a similar policy.³¹

Internet Keywords

40. Internet keywords offer a natural language Web addressing system or a navigational system based on the use of words, without technical prefixes, such as *http://* or *www.*, and without top-level domain suffixes, such as *.com*, *.net* or *.org*. Keywords resolve to URLs and, in some cases, e-mail addresses, usually through the use of the keyword in the browser location bar. While being navigational tools, keywords can also be regarded as virtual identifiers and, as such, have intellectual property implications.

41. Keywords do not constitute a competing rooting system to the DNS, but rather an application layer super-imposed upon the DNS.

42. Keywords are available from several services, including CommonName Ltd.,³² Netscape³³ and RealNames Corporation.³⁴ Keywords are also available in non-Roman script.

43. Keyword providers offer dispute-resolution services in respect of bad faith and deliberate misuse of trademarks through keywords.³⁵ These dispute-resolution policies are largely compatible with the UDRP, but are adopted on a voluntary basis since providers are not obligated through the ICANN system to apply the UDRP or a compatible policy.

44. As keywords systems become increasingly used in web browsers and search engines, the possibility of conflicts between keywords and intellectual property rights is likely to increase. Depending on their evolution, user uptake and the effectiveness of voluntary dispute-resolution procedures applied by providers, the intellectual property dimensions of keywords and other addressing systems super-imposed on the DNS could warrant further study.

THE PROCESS OF CONSULTATIONS IN THE SECOND WIPO INTERNET DOMAIN NAME PROCESS

45. As mentioned in paragraph 2, above, the Request addressed to WIPO, which initiated the process leading to the present Report, called for “a process of consultation with WIPO Members and all interested stakeholders.”

46. In order to undertake the requested process of consultation, WIPO adopted procedures modeled on those followed in the first WIPO Internet Domain Name Process. The Second Process thus also comprises three stages and was conducted in English, French and Spanish.

47. The first stage sought greater definition in the issues that were to be addressed in the course of the process, the procedures that were to be used and the timetable that would be followed. To this end, a Request for Comments (WIPO2 RFC-1) was issued on July 10, 2000, with a deadline for receipt of comments by August 15, 2000.

48. The second stage of the process consisted of seeking comments and consulting on the issues defined after consideration of the comments received on WIPO2 RFC-1. To this end, a second Request for Comments (WIPO2 RFC-2) was issued on October 13, 2000, with a deadline for receipt of comments of December 29, 2000.

49. The third and final stage of the process consisted of the publication, on April 12, 2001, of an Interim Report, *The Recognition of Rights and the Use of Names in the Internet Domain Name System*.³⁶ The Interim Report was issued in the form of a third Request for Comments (WIPO2 RFC-3), with a deadline for the submission of comments of June 15, 2001.

50. Each of the above-mentioned Requests for Comments was published on the web site established for the Second WIPO Internet Domain Name Process (<http://wipo2.wipo.int/process2/index.html>), as well as in paper form. The paper version was also sent to the governments and industrial property offices of each of the 177 Member States of WIPO, and to intergovernmental organizations and non-governmental organizations accredited with observer status at WIPO.

51. In addition to the Internet-based and written consultations, WIPO also organized, throughout the latter part of 2000 and the first of part of 2001, physical meetings in 10 cities throughout the world. Details of the location of those meetings and participation in the meetings are given in Table 2, below.

Table 2
Consultation Meetings Organized

Location	Date(s)	Participation (approx.)
São Paulo, Brazil	August 2 and 3, 2000	41
Chiang Mai, Thailand	August 3 and 4, 2000	58
Amman, Jordan	September 18 to 20, 2000	100
Krakow, Poland	October 25 and 26, 2000	63
Brussels, Belgium	April 23, 2001	34
Accra, Ghana	April 26, 2001	98
Buenos Aires, Argentina	May 10, 2001	46
Melbourne, Australia	May 24, 2001	40
Washington, D.C., United States of America	May 29, 2001	31
Valencia, Spain	May 30, 2001	19

52. In all, throughout this Second WIPO Internet Domain Name Process, written comments on the three Requests for Comments and physical participation at the meetings held were engaged from 51 government agencies of 28 countries, 18 intergovernmental organizations and agencies, 44 non-governmental organizations, 201 corporations and professional firms and 184 individuals. Details of the names of these entities and persons and of their participation in the various stages of the process are set out in Annex I to this Report.

THE SUBMISSION OF THE PRESENT REPORT

53. The Request initiating the Second WIPO Internet Domain Name Process indicated that the “findings and the recommendations [of the Process] should be submitted to the Members of WIPO and for consideration by the Internet Community (including the Internet Corporation for Assigned Names and Numbers).”³⁷ Accordingly, the present Report will be submitted to the Assemblies of Member States of WIPO at their meeting from September 24 to October 3, 2001, and will be submitted to the Board of ICANN. In addition, the Report will be published on the WIPO web site and distributed widely in paper form.

¹ The Request was contained in a letter from the Minister for Communications, Information Technology and the Arts of the Government of Australia transmitted with the endorsement of Argentina, Australia, Canada, Denmark, France, United States of America and the European Union. A copy of the letter is available at <http://wipo2.wipo.int/process2/rfc/letter.html>.

² See WIPO documents WIPO/GA/26/3 and WIPO/GA/26/10, paragraph 26.

³ See http://www.ntia.doc.gov/ntiahome/domainname/6_5_98dns.htm.

⁴ See WIPO documents A/33/4 and A/33/8.

⁵ The Report is available at <http://wipo2.wipo.int/process1/report/finalreport.html> or, in bound paper form, upon request from WIPO.

⁶ A statistical analysis of the cases filed with the WIPO Arbitration and Mediation Center under the UDRP is available on Center’s web site at <http://www.arbiter.wipo.int/domains/statistics/index.html>.

⁷ As amended through July 16, 2000; see <http://www.icann.org/general/bylaws.htm>.

⁸ See <http://www.icann.org/general/articles.html>.

⁹ See <http://www.dnso.org/dnso/notes/2001/02.NCbusinessplan.html>.

¹⁰ The request is available at <http://wipo2.wipo.int/process2/rfc/letter1.html>.

¹¹ See WIPO documents WIPO/GA/26/3 and WIPO/GA/26/10, paragraph 26.

[Endnote continued from previous page]

- 12 Available at <http://ecommerce.wipo.int/domains/cctlds/bestpractices/index.html>, or in bound paper form, upon request, from WIPO.
- 13 See the IETF IDN Working Group Web Site at <http://www.i-d-n.net>.
- 14 See <http://www.verisign-grs.com/idn/index.html>.
- 15 See http://www.verisign-grs.com/idn/Gen_Info_Paper.pdf.
- 16 See <http://www.icann.org/minutes/minutes-25sep00.htm>.
- 17 See <http://www.icann.org/committees/idn/>.
- 18 See <http://www.icann.org/minutes/prelim-report-16nov00.htm#Second Annual Meeting>.
- 19 See ICANN, “New TLD Program” at <http://www.icann.org/tlds/>.
- 20 *Ibid.*
- 21 See <http://www.afilias.info>.
- 22 See <http://www.neulevel.biz>.
- 23 For detailed information, see <http://arbiter.wipo.int/domains/gtld/newgtld.html>.
- 24 See WIPO, *The Management of Internet Names and Addresses: Intellectual Property Issues*, Chapter 5, <http://wipo2.wipo.int/process1/report/finalreport.html>.
- 25 *Ibid.*, paragraph 343.
- 26 See, for details, <http://www.afilias.info/faq/sunrise.html> and <http://www.afilias.info/faq/sunrise-challenge-policy.html>.
- 27 See <http://www.icann.org/announcements/icann-pr14aug01.htm>.
- 28 See RFC 2826 “IAB Technical Comment on the Unique DNS Root,” <http://www.rfc-editor.org/rfc/rfc2826.txt>.
- 29 See <http://www.icann.org/stockholm/unique-root-draft.htm>.
- 30 See <http://www.icann.org/icp/icp-3.htm>.
- 31 For example, new.net which operates 20 gTLDs outside the ICANN system applies a Model Domain Name Dispute Policy which largely corresponds to the UDRP.
- 32 See <http://www.commonname.com>.
- 33 See <http://home.netscape.com/escapes/keywords/faq.html>.
- 34 See http://web.realnames.com/Virtual.asp?page=Eng_Corporate_Product_Faq.
- 35 See <http://www.commonname.com/English/master.asp?asp=/English/LegalDocs/CommonNameDisputeResolutionPolicy.html> and http://web.realnames.com/Virtual.asp?page=Eng_Policy_DisputeResolution.
- 36 See <http://wipo2.wipo.int/process2/rfc/rfc3/index.html>.
- 37 See <http://wipo2.wipo.int/process2/rfc/letter2.html>.

2. POLICY OPTIONS FOR A GLOBAL MEDIUM

54. The Domain Name System (DNS) has presented a set of problems for intellectual property policy, as well as a set of opportunities, that are perhaps unique in the historical development of the intellectual property system. The problems arise from the spontaneous adaptation of a technical addressing system to functions and purposes beyond those for which it was originally designed. In addition to providing a human friendly, reliable and stable routing system, the DNS has given rise to identifiers that are used for commercial, cultural, governmental, political and social purposes, both on the Internet itself and in similar contexts beyond the Internet. The opportunities arise from the hierarchical design of the DNS and the set of contractual relations that bind ICANN, registries, registrars and domain name holders in various relationships, thereby providing a means for implementing common terms of policy in those relationships.

55. The Uniform Domain Name Dispute Resolution Policy (UDRP) can be seen as a largely successful use of the opportunities provided by the hierarchical design of the DNS, although it is not without critics. The Second WIPO Internet Domain Name Process involves a series of far-reaching questions, which ultimately relate to the interface between the virtual identifiers that domain names are and identifiers that have a basis in naming systems that have been deployed historically throughout the real or non-virtual world. Some of those naming systems are circumscribed by legal rules and principles (for example, geographical indications or trade names), and some operate within social, cultural and spiritual contexts that contain their own, not necessarily legally binding, rules and principles (such as the names of countries, peoples or geopolitical entities). For the Internet to play its role as a global medium, or for the DNS to be a global addressing system, the diversity that accounts for the richness of the world must be taken into account.

56. Before examining, in the ensuing chapters of this Report, the current state of law, policy and practice in relation to these questions and the desirability of taking action upon any of them, it may be opportune first to review the options for intellectual property policy

development and implementation that are available to the international community should it choose to take action in respect of any possible solutions.

57. In examining the available options for policy development and implementation, it is useful to commence by recalling first, the special features of the environment in which intellectual property policy with respect to domain names applies, and, secondly, the distinction between the application of existing policy and the creation of new policy.

SPECIAL FEATURES OF THE ENVIRONMENT

58. It is widely recognized that the Internet presents special challenges for policy development and implementation. There are four features that are particularly pertinent in the present context.

A Global Medium

59. The Internet is global in several senses. It is accessible from any place in which the appropriate telecommunication facilities exist, with the consequence that the users of the Internet reflect, or potentially reflect, the diversity of the world's population. A domain name registration, whether in a gTLD or a ccTLD, gives a global presence which makes the corresponding online address accessible from anywhere. There are advantages for all in this universal connectivity, which allows the Internet to be a medium for international commerce, cultural exchange, political expression and social communication. Less often recognized than the advantages are the responsibilities that flow from having a global presence and a globally accessible web site, since virtual contact is a far less hazardous experience than physical contact.

A Global Space

60. The Internet makes possible a global space for activity. It is true that activity on the Internet will have a series of territorial connections: the location of the computer from which

the activity emanates, the location of the server, the location of the computer on which the activity is perceived, the locality of the target audience, the locality of the accidental audience that may perceive or be able to perceive the activity, the territory over which messages travel, and so forth. Sorting out the territorial connections to activity on the Internet is, however, a difficult exercise and the reality is that activity on the Internet is not susceptible to territorial localization in the way in which activity in the non-virtual world is. The absence of territorial localization in this way stands in contrast to the historical basis of political and legal systems in which policy is formulated by governments and parliaments for the territory over which they exercise authority and the ensuing legal rights are limited to, and enforced within, the same territories. Who has authority to make policy for a global space and who has authority to enforce that policy are complicated questions to which there are no easy answers.

Speed of Penetration and of Change

61. The Internet has been characterized by extremely rapid acceptance and adoption. Estimates indicate that the number of users of the Internet has risen from several thousand in August 1981 to 460 million in 2001.¹ This rate of adoption is much quicker than the rate of adoption of the telephone or television.²

62. Not only has the rate of adoption of the Internet been exceptionally quick, but also the technologies that it deploys and policies governing the DNS have been in rapid evolution, as Chapter 1 indicates. The distinction between gTLDs and ccTLDs is not as clear as the descriptions of those categories of top-level domains suggest. Language within the DNS is in dynamic evolution. The generic top-level domain space is being expanded and new forms of virtual identifiers are being deployed.

63. In this context of rapid growth and change, understandably, there is a certain anxiety about the potentially negative effects that heavy handed regulation might have.

Multifunctionality

64. As noted above, the Internet is used by a diverse range of people for a diverse range of purposes. Every adjective that can be used to describe a branch of human activity finds its corresponding noun in activity on the Internet: research, science, technology, commerce, culture, entertainment, leisure, communication, religion, politics, pornography, lunacy and so forth. Making policy for one area so as not to damage the legitimate interests of another area is also a complicated issue.

CREATING -V- APPLYING LAW

65. It is not inappropriate to recall some old distinctions in political and legal theory. In particular, there is a well accepted distinction in theory, even if not always so easily applied in practice, between creating law, a legislative activity, and applying it, an executive activity. Legislation, at least in liberal democracies, is the activity of elected representatives of the constituency to which the legislation applies. The executive function is performed by duly appointed or constituted agencies.

66. The recommendation in the first WIPO Internet Domain Name Process to establish a uniform domain name dispute resolution procedure (UDRP) was essentially an exercise in finding a means to express, in an economically rational and effective way, principles that were widely accepted in national and international laws. There has been history of nearly 120 years of international cooperation in trademarks, the Paris Convention for the Protection of Industrial Property (the Paris Convention) having been concluded in 1883. The result of that history of cooperation is a relative convergence in national trademark laws, as well as a clear international legal regime governing trademarks in the Paris Convention and the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS). The UDRP does not seek to regulate the whole universe of the interface between trademarks and domain names, but only to implement the lowest common denominator of internationally agreed and accepted principles concerning the abuse of trademarks. The exercise was less about

legislation than about the efficient application of existing law in a multijurisdictional and cross-territorial space.

67. The Second WIPO Internet Domain Name Process involves more difficult questions where it is as well to remember the distinction between positive law, or what the law is, and normative law, or what the law should be according to opinion gauged to be more or less widespread. From the point of view of positive law, as will be seen in the ensuing chapters, the questions to be addressed in the present Report fall into three categories:

(i) questions on which there is a clear international norm requiring protection of a certain subject matter, but under-developed modalities for the international recognition of the subject matter that is to be protected (with the consequence, that the appreciation of the subject matter to be respected often is left to national law). Into this category fall geographical indications and trade names.

(ii) questions where there are elements of an international framework for the protection of the subject matter, but those elements are incomplete or insufficiently precise. Into this category fall the names and acronyms of international intergovernmental organizations and International Non-proprietary Names (INNs) for pharmaceutical substances.

(iii) questions in respect of which there are no existing international norms, however unjust the absence of such norms might be. Into this category fall personal names, the names of countries and other geographic, geo-political and geo-ethnic terms.

OPTIONS FOR INTELLECTUAL PROPERTY POLICY

68. There are three main models which are available to the international community for the further development and implementation of intellectual property with respect to domain names. Each of these models is described below, together with their principal advantages and limitations. The models are not alternatives but can be used in cumulation so as to take

advantage of the positive features of each, as well as to take into account their limitations. If the international community should wish to establish rules with respect to the questions examined in the ensuing chapters of this Report, it would need also to decide on the optimal way in which those rules can be developed and implemented.

Self-Regulation

69. The first model for adopting and implementing intellectual property policy is the self-regulatory model, under which, in the context of the DNS, registries, in cooperation with any supervisory body that may exercise authority over them, develop and adopt rules governing intellectual property protection within the domains for which they are responsible. Those policies can then be implemented through terms in the contractual relationships that govern registrations made in the domains in question. Naturally, the rules in question must conform to applicable law.

70. To a certain extent, self-regulation is already practiced in certain areas of the interface between domain names and intellectual property. The administrators of ccTLDs are not obligated to apply the UDRP. As indicated above (paragraphs 18 to 21), 22 ccTLDs have voluntarily adopted the UDRP. A number of others have, however, chosen to develop their own dispute-resolution mechanisms and charters with respect to the bad faith and deliberate violation of intellectual property rights through domain name registrations, for example, .uk.³ While the policy that they may adopt may bear a great similarity to the UDRP, it constitutes a self-contained system, which does not permit consolidation of cases concerning similar registrations held by the same person across different domains in the way that the UDRP permits consolidation across domains which apply the UDRP where the parties to a dispute are the same.⁴ In addition, as also indicated above (paragraphs 28 to 31), the registries of the new gTLDs are developing dispute resolution mechanisms with respect to intellectual property that differ from the UDRP, such as the sunrise or start-up policies applied in .info and .biz. Furthermore, providers of domain name services in alternate roots, as well as providers of Internet keywords, practice self-regulation.

71. The *advantages* of self-regulation are relatively swift development and implementation of rules, as well as relatively flexible procedures for modification of rules, where necessary, a particularly desirable feature in the context of a rapidly evolving medium. In addition, rules backed by a dispute-resolution procedure have the great benefit of rapid and effective enforcement through the registry adopting the rules. In the case of ccTLDs, there is also the advantage of greater possibility of adopting specific rules to accommodate local circumstances.

72. The *disadvantages* of self-regulation are the risks of incoherence in policy across a global medium and a global space, with the resultant possibility of conflicting rules, increased compliance costs for users, who may have to conform to a variety of differing rules and systems, and an increased possibility of confusion on the part of users in knowing what is and what is not permissible. Self-regulation also depends for its effect on legislative discipline to restrain the possibility of an increasing number and diversity of national laws applying to regulate various facets of the interface between domain names and intellectual property rights. Legislation relating to aspects of domain names and intellectual property rights exists in the United States of America,⁵ is under consideration within the European Union in the form of a proposed Regulation of the European Parliament and of the Council with respect to the proposed top-level domain .eu⁶ and has been considered in a number of countries, including Belgium⁷ and Italy.⁸

The ICANN Contractual Model

73. The second main model is the one predominantly applied at present through the Internet Corporation for Assigned Names and Numbers (ICANN). It consists of the use of a hierarchical design of the DNS to implement, through contractual arrangements, common rules governing the interface (or part of the interface) between intellectual property and domain names. The UDRP has been adopted and is applied in this manner.

74. The *advantages* of the ICANN model are relatively swift adoption and implementation of rules, together with a relatively flexible possibility for modifying such rules. In addition, through the required adoption of the UDRP (or cognate rules) on the part of registrars and the

approval of standard terms for contracts between registrars and domain name applicants, the system has the beauty of rapid and effective enforcement (since remedies under the UDRP are limited to what may be technically achieved in the DNS, such as the transfer or cancellation of registration). The model has also the advantage of ensuring coherence in policy application across the generic top-level domain name space. In addition, it makes use of ICANN's specialist expertise in the management of the technical functioning of the DNS, as well as its decision-making processes and instances which have been designed to encourage participation on the part of all interested stakeholders.

75. The *disadvantages* of this model are that ICANN's mandate and focus of activity are the technical coordination, technical management and operational stability of the Internet. ICANN's Articles of Incorporation state, in Article 3, that it shall pursue "the charitable and public purposes of lessening burdens of government and promoting the global public interest in the operational stability of the Internet by (i) coordinating the assignment of Internet technical parameters as needed to maintain universal connectivity on the Internet; (ii) performing and overseeing functions related to the coordination of the Internet Protocol ("IP") address space; (iii) performing and overseeing functions related to the coordination of the Internet Domain Name System ("DNS"), including the development of policies for determining the circumstances under which top-level domains are added to the DNS root server system; (iv) overseeing operation of the authoritative Internet DNS root server system; and (v) engaging in any other related lawful activity in furtherance items (i) through (iv)." In view of these functions and focus, ICANN may see the development of new rules of intellectual property policy, as opposed to the use of the contractual basis of the ICANN system to implement existing rules, as a burden that it might usefully do without.

76. In addition, certain areas remain outside the ICANN contractual model, notably in respect of the UDRP or cognate rules, ccTLDs, alternate roots and, to the extent relevant, other virtual identifiers. It relies also, like self-regulation, on legislative restraint on the part of national parliaments to avoid the possibility of conflicting national laws and to avoid consequential increases in compliance costs and the risk of a confusing diversity of approaches.

The Treaty

77. The third model is the instrument traditionally used by the international community to create binding rules that limit the inconsistent exercise of national legislative competence, namely the treaty. The treaty is the international equivalent of a national law and the process leading to its adoption is the international equivalent to the national legislative process.

78. The *advantages* of the treaty are the representative nature of the process leading to the treaty's conclusion, which typically includes consultations on the part of national delegations with interested circles in formulating national positions, extensive international negotiations by duly authorized representatives, adoption of the treaty by duly empowered representatives specialized in the subject matter of the treaty and accession to or ratification of the treaty through national consultative and parliamentary or congressional processes. The treaty also has, of course, binding force amongst contracting parties and remains the instrument used by the international community for achieving the uniform application of the rules.

79. The *disadvantages* of the treaty are the length and slowness of the multilateral process for the negotiation of the instrument, which typically requires a number of years that is often incompatible with the speed of response required by the Internet, and the length of time required for the subsequent ratification of the treaty in order to bring it into force across a geographically effective and pertinent area. In addition, once concluded, a treaty is often a relatively inflexible instrument for dealing with areas subject to rapid and radical change, since amendment usually requires time-consuming procedures of consultation and negotiation akin to those required for the adoption of the treaty.

80. It is clear that, if the treaty process were to be used with respect to intellectual property questions relating to domain names, great care would need to be exercised to ensure that its provisions were technology-neutral and did not condition the future development of the DNS or the Internet. In addition, great reflection would be needed to develop appropriate mechanisms for ensuring that the multilateral negotiation process took place within a relevant timeframe, and that mechanisms were envisaged to allow flexibility for any necessary changes or adaptations, while at the same time not depriving national parliaments and

congresses of their sovereign rights to consent to the content of an instrument which may become binding on their constituents.

¹ See Nielsen/Net Ratings' Global Internet Trends Report, released August 28, 2001, at http://www.nielsen-netratings.com/hot_of_the_net_i.htm.

² See Report of the International Telecommunication Union (ITU), *Challenges to the Network: Internet for Development (1999)* available at <http://www.itu.int/itu-ict/publications/inet/1999/index.html>.

³ See <http://www.nic.uk/ref/drs.html>.

⁴ Of all cases filed with the WIPO Arbitration and Mediation Center that concern more than one domain name, over 50% cover two or more different top-level domains.

⁵ Anticybersquatting Consumer Protection Act, see <http://www.gigalaw.com/library/anticybersquattingact-1999-11-29-p1.html>.

⁶ See <http://www2.europarl.eu.int/omk/OM-Europarl?PROG=REPORT&L=EN&PUBREF=-//EP//TEXT+REPORT+A5-2001-0226+0+NOT+SGML+V0//EN&LEVEL=2>.

⁷ See <http://www.lachambre.be/documents/1069/1.pdf>.

⁸ See <http://www.interlex.it/nomiadom/testo.htm>.

3. INTERNATIONAL NONPROPRIETARY NAMES FOR PHARMACEUTICAL SUBSTANCES (INNs)

81. In common with other areas, the health sector has been affected in a variety of new and fundamental ways by the Internet. Vast amounts of health-related information and products are available through the Internet to a global audience which can retrieve and use them with unprecedented ease and efficiency.¹ The accuracy, reliability and safety of the information and products retrieved are matters of primary interest to public health and safety.

82. Identifiers play an important role with respect to health products, services and information, both on the Internet and in the physical world. In particular, identifiers:

- (i) enable health-related information to be located online;
- (ii) signal the source of products, services and information; and
- (iii) connect producers or suppliers, on the one hand, and consumers, on the other hand, enabling consumers to associate certain consistent characteristics of products or information with the identifiers.

83. The pharmaceutical industry, the medical profession and associated suppliers of medical equipment and services use a variety of identifiers, including trademarks for branded pharmaceutical products, service marks for suppliers of medical services, personal names for physicians and surgeons, traditional names for tradition-based products and remedies and trade names for enterprises providing products and services or for associations grouping professional persons or trade interests. The domain name system (DNS) imposes a new layer of identifiers for the on-line environment in which all these products, services and associations operate. The interaction between domain names and the series of identifiers used specifically in the health sector, and the impact of domain names on the latter set of identifiers, are matters of significant concern.

84. In recognition of the importance of identifiers and of the fact that most of those used for health products and services are the subject of private (intellectual property) rights and thus, privately controlled, more than 50 years ago the health sector developed a system for ensuring

that, in the interests of public safety, a class of identifiers would be established that would be free from appropriation through private rights and available for public use. This system, developed and managed by the World Health Organization (WHO), attributed such public status to a class of identifiers known as “International Nonproprietary Names (INNs).” The system operates on the basis of consensus on the part of public authorities and the private sector.

85. With the arrival of the Internet and DNS, a new opportunity arose for tainting the public status of INNs. By registering an INN as a domain name, the functional capacity of the INN to serve as an address locator and identifier on the Internet could be appropriated and controlled by the domain name holder. No screening system exists to prevent anyone from doing this.

86. The registration of INNs as domain names came to light in the course of the first WIPO Process. The Report of that Process recognized that the issue was outside the scope of the mandate of the first Process, but recommended that serious consideration be given in future to the protection of INNs against registration in the open top-level domains (gTLDs).² This recommendation led to the request to WIPO to explore, in the Second WIPO Process, the issues raised in the DNS by the bad faith, abusive, misleading or unfair use of INNs. In addressing this request, the present Chapter describes the operation and policy of the INN system, analyses the comments received in the course of the Second WIPO Process and evaluates the evidence of current problems experienced in the DNS relating to the registration of INNs. It explores policy options for protecting INNs within the DNS and recommends consideration of a simple mechanism for maintaining the public availability and status of INNs within the DNS.

THE INN SYSTEM

87. An International Nonproprietary Name (INN) is a unique name used to identify a pharmaceutical substance or active pharmaceutical ingredient. Some examples of INNs are amoxicillin, ampicillin, nandrolone, temazepam, phenobarbital, amphetamine, ibuprofen,

chloroquine and retinol.³ INNs are selected by WHO, in coordination with national authorities worldwide, and maintained on a Cumulative List of recommended INNs, now numbering more than 8,000, to which between 120 and 150 new names are added each year.⁴

88. WHO is a specialized agency of the United Nations with 191 Member States and a constitutional responsibility to “develop, establish and promote international standards with respect to biological, pharmaceutical and similar products.”⁵ WHO has the international mandate to offer recommendations to its Member States on any matter within its competence, including setting norms and standards for pharmaceutical products in international commerce.

89. The INN system was established by a World Health Assembly resolution in 1950,⁶ which also provided for the development of a selection procedure for recommended INNs. The procedure for selection of INNs begins with a request, often by a national nomenclature authority or a pharmaceutical company, which is submitted for examination and name selection by the WHO Expert Panel on the International Pharmacopoeia and Pharmaceutical Preparations (‘WHO Expert Panel’), made up of representatives of the major national nomenclature committees. The proposed INN is published in *WHO Drug Information* for comment or objection by any interested person over a four-month period. If no objection is raised during that period, the name is published as a recommended INN.

90. To qualify for selection, INNs must be succinct, distinctive in sound and spelling, so as to avoid confusion with other commonly used names, and must be in the public domain and therefore freely available for the sole purpose of identifying the pharmaceutical substance in question. To enable INNs to be used around the world, various linguistic conventions are harmonized by rules that specify, for example, which letters should be avoided (‘h’ and ‘k’), that ‘e’ should be used in lieu of ‘ae’ and ‘oe’, ‘i’ instead of ‘y’ and ‘t’, and ‘f’ instead of ‘th’ and ‘ph’. The WHO Procedure for Selection of INNs is set out at Annex IV to this Report.

91. Recommended INNs are notified by WHO to its Member States, with a request that their national authorities take the necessary steps to prevent the acquisition of proprietary rights in the name, including prohibiting registration of the name as a trademark.

92. As a result, there now exists an international consensus among relevant public and private circles on the public policy against the acquisition of proprietary rights in INNs. The policy extends to trademarks and calls for restraints on the part of private health enterprises and public trademark registration authorities not to allow trademark rights to be acquired over INNs. The exact INN itself and the stem of the INN may not be registered as a trademark. In line with the intended status of INNs as generic or common names, manufacturers of pharmaceutical substances are encouraged to use their corporate names together with INNs in marketing products. Thus the use of “[INN] [name of manufacturer]” in the promotion and marketing of products is not considered to offend the policy against acquisition of proprietary rights in INNs.

THE POLICIES UNDERLYING THE INN SYSTEM

93. The prohibition of the acquisition of proprietary rights in INNs is intended to implement three main policy objectives:⁷

(i) The establishment of INNs as unique, globally available, generic names which are free of proprietary rights and, thus, available for use by all for the purpose of identifying pharmaceutical substances. The public status of such names is intended to ensure that no confusion can arise about drugs or their pharmacological activity and properties in international dispensing practice and in communication and exchange of information among health professionals and scientists worldwide.

(ii) The promotion of the veracity and reliability of health information, which could be endangered if INNs were able to be controlled by a single person or entity.

(iii) The prevention of dilution in the meaning or semantic associations established with respect to INNs, with consequent risk to patient safety, which could occur if INNs were legally controlled by private interests.

EVIDENCE OF REGISTRATIONS OF INN_s IN THE DNS

94. The registration of an INN as a domain name creates a monopoly of association with that unique address in the domain concerned. While a domain name is not a legal title which confers upon its holder the right to exclude others from using it in other contexts, it is a unique address. As a result, anyone who registers an INN as a domain name occupies a unique space and acquires a singular advantage in associating the website that is accessed through the domain name with the INN. Without any external control over the veracity and reliability of the information relating to the INN, there are risks of confusion posed to health professionals and consumers.⁸ As one commentator remarked: “Any use or registration of INNs which would lead the public to confusion as to a pharmaceutical substance or active pharmaceutical ingredient should be restricted.”⁹

95. In response to the call for evidence of abusive registrations of domain names, WHO and the European Federation of Pharmaceutical Industries and Associations (EFPIA) have submitted studies of INNs that have been registered as domain names by individuals or pharmaceutical businesses. The studies, set out at Annex V, demonstrate that numerous INNs have already been appropriated in the DNS (e.g., sildenafil.com, also known as ‘viagra’, also ampicillin.com, amoxicillin.com, tagamet.com, tetracycline.com, diclofenac.com, diazepam.com and lorazepam.com). These domain names are used for various purposes: some merely provide information about the pharmaceutical substance, but the majority are proprietary sites registered and used to advertise or sell pharmaceuticals.¹⁰ The WHO comments that such purposes are antithetical to the policy of the INN system, which reserves INNs for mere identification purposes.¹¹ No evidence has been provided through the Second WIPO Process of actual harm resulting from the registration of INNs as domain names, beyond the damage done to the integrity of the INN system. Several commentators point to the insufficiency of such evidence to argue against the need for protection of INNs.¹²

ANALYSIS OF COMMENTS AND VIEWS EXPRESSED IN RESPONSE TO THE INTERIM REPORT

96. The Interim Report posed the question whether INNs should be protected in the DNS. A significant majority of commentators to the Second WIPO Process were in favor, or strongly in favor, of the protection of INNs in the DNS.¹³ It was largely agreed, in principle, that the integrity of the INN system and the preservation of its underlying policies require that INNs be protected against registration as domain names. Some commentators, however, opposed such protection of INNs on the grounds of free speech, competition policy, health and consumer protection.¹⁴ Certain argued that, for generic words such as INNs, the only fair means of apportionment may be first-come, first-served.¹⁵ A minority of commentators referred to the insufficient evidence of abuse to conclude that INNs did not require protection at this stage.¹⁶ It was also noted that abuse, and consequent risk to patient safety, is most critical in the bad faith use of the domain name and not its registration *per se*.¹⁷ However, these comments do not recognize the damage which is occasioned to the integrity of the INN system, which depends upon consensus compliance, as a consequence of the registration of INNs as domain names. It was for these reasons that the majority of commentators to the Second WIPO Process favored the implementation of some means to protect INNs in the DNS.

97. The Interim Report put forward five issues that required consideration in giving expression to any protection of INNs in the DNS. Each issue is discussed below, with reference to the comments received.

- ♣ First, whether protection should be applied only against registration of domain names that consist solely of INNs, or should extend to domain names that consist of INNs together with additional words (e.g., “[INN][name of manufacturer]” or “[INN][info]”).

98. On this issue, the comments submitted to WIPO were largely in favor of permitting the registration as a domain name of an INN together with the name of a manufacturer, as permitted in the physical world.¹⁸ As noted by WHO, with respect to the existing INN

system, the use of an INN is permitted together with the name of a manufacturer of the INN. This possibility was also favored as enabling consumers to locate INNs via their manufacturer.¹⁹ Against this proposal, it was argued that allowing an exception only for the use of the INN together with the name of the manufacturer would enable large pharmaceutical companies to monopolize the flow of information and trade on those drugs.²⁰ In this respect, however, it is noted that there remain many alternate possibilities for exchange of information and sale of pharmaceuticals online and off, including through use of the INN on a web site itself, that are not precluded by restriction of the registration of an INN as a domain name, with or without the name of the manufacturer.

99. On the issue whether it should be permitted to register INNs together with additional words, such as ‘info’ or ‘usergroup’, comments were divided. Several commentators, emphasizing the need for free speech and public information, favored permitting registration of composite names for these purposes.²¹ By contrast, WHO remains firmly opposed to permitting the registration of domain names derived from an INN, including the registration of an INN plus any other word, if such registration is misleading or otherwise in ‘bad faith’, defined by WHO to mean any registration not strictly limited to providing information relating to the pharmaceutical substance, but used for advertising or promotional purposes.²² This view was supported by other commentators, who identified the potential risk to consumers of confusion caused by such registrations,²³ prompting the European Commission to comment that if composite names including INNs were permitted, then the website should be required to display a standard disclaimer, informing the public that the information on the site was not approved by WHO.²⁴

- ♣ Secondly, whether protection should cover only domain names that contain exact INNs or should extend also to names that are misleadingly similar (e.g., misspellings).

100. This question concerns whether protection should apply to the prohibition of the registration of domain names that are misleadingly similar to INNs. In this respect, it may be recalled that the UDRP that applies at present in the open gTLDs extends the protection conferred upon trademarks to the prohibition of the registration and use in bad faith of domain

names that are misleadingly similar to trademarks.²⁵ It should be noted that the policies underlying INNs and trademarks are different: in the case of INNs, the objective of the system is to ensure that the INN can be used freely by all, as well as to preserve a clear identification mechanism for the global health system, whereas in the case of trademarks, the objective of the system is to restrict the use in commerce of the trademark, on similar goods and services, to the single person or entity that owns the trademark. Nevertheless, misleadingly similar variations of either identifier can, in each case and in different ways, interfere with the underlying policy objectives and create confusion as to the nature of the identifier or its source.

101. As discussed above, and in relation to this issue, WHO was firmly opposed to a system of protection that would allow the registration of misleadingly similar, or otherwise bad faith, versions of INNs.²⁶ It is apparent that such registrations could be effected precisely in order to mislead and confuse consumers and users, or to circumvent any restriction on registration of exact INNs, in contravention of the policies underlying the INN system. A comment, from Mexico, noted that protection of INNs against misleadingly similar domain name registrations was consistent with their national legal system, which prohibits the registration as trademarks of words within a three-letter difference to an INN so as to avoid consumer confusion.²⁷

102. A number of commentators opposed the restriction of domain names similar to INNs, noting that there was no evidence to date of deliberate attempts by domain name registrants to mislead consumers.²⁸ Most of the opposition to any wider protection (beyond protection of the exact INN as a domain name) stemmed from some commentators' apprehension at the administrative burden that would be borne by registration authorities if an exclusion process were recommended and the authorities were then required to exercise quasi-legal judgment to determine whether a given domain name constituted a 'misleadingly similar' version of an INN.²⁹

- ♣ Thirdly, whether protection should be extended to domain names that contain INNs in different languages and scripts.

103. The majority of commentators were in favor of extending any protection to INNs in the DNS to cover all the different languages and scripts that are used in the DNS.³⁰ As noted by WHO, the Cumulative List of INNs is published in seven official languages: Arabic, Chinese, English, French, Latin, Russian and Spanish. A number of commentators remarked that, as the policy objectives of the INN system apply irrespective of language or script, protection should extend beyond such languages, particularly at a ccTLD level, so as to protect INNs in all languages.³¹

- ♣ Fourthly, whether protection should address existing registrations of INNs.

104. This question relates to the treatment of existing registrations of INNs in the event that protection for INNs is introduced in the DNS. The retrospective application of any protective mechanism for INNs raised concerns among some commentators, who questioned whether domain names acquired in good faith could simply be cancelled. Under United States law at least, it was argued that this could amount to a regulatory action requiring reimbursement in accordance with national law.³² Other commentators noted that cancellation of a registration contract entered into in good faith could amount to a breach of contract that could create problems between registrars and registrants.³³

105. On the other hand, numerous commentators were in favor of the application of protection for INNs against past, as well as future, domain name registrations.³⁴ One commentator supported such retrospectivity, provided that protection applied only against bad faith registrations of INNs in the DNS, and did not prejudice rights acquired in good faith.³⁵ In this respect, it may be noted that the INN system is well known and well publicized within the health sector. Anyone who has registered an INN as a domain name, therefore, may be reasonably expected to have been aware of the underlying policy of the INN system against the establishment of private rights in INNs. Furthermore, the potential incompatibility of registering INNs as domain names with the policy of the INN system has been signaled by the custodian of that system, WHO, since the time of the first WIPO Internet Domain Name Process, which commenced in July 1998. It does not seem unfair, therefore, that any policy adopted for the implementation of the protection of INNs within the DNS should apply with respect to all past and future registrations of domain names. Furthermore, the allowance of

any grandfather clauses for existing registrations would undermine the integrity of the INN system.

- ♣ Fifthly, whether protection for INNs in the DNS should apply to all gTLDs and whether it could appropriately be adopted by the administrators of ccTLDs.

106. The final question relates to the coverage of protection for INNs within the top-level domains. The majority of commentators were in favor of protection of INNs in gTLDs, including those that are open and restricted, existing and future.³⁶ Although the risk of abusive registrations in restricted gTLDs (.int, .mil., .edu and .gov) is very low, the extension of protection to these domains does not seem to be problematic. With respect to new gTLDs, as noted in paragraph 28 to 31, above, ICANN has approved the introduction of seven new generic top-level domains, four of which (.biz, .info, .name and .pro) are “unsponsored,” meaning that they are intended to operate under policies established by “the global Internet Community directly through the ICANN process,” and three of which (.aero, .coop and .museum) are “sponsored,” meaning that they are each intended to be “a specialized TLD that has a sponsoring organization representing the narrower community that is most affected by the TLD.” In respect of the unsponsored new gTLDs, at least two of these will be opened to a large and essentially undifferentiated public. For these, any decision to protect INNs against registrations of domain names should clearly apply. For the other new gTLDs, it may well be that restrictions on persons who may register domain names within them may preclude the registration of INNs as domain names. In that case, there should not be any difficulty in the acceptance by such gTLDs of the extension to them of any decision to protect INNs against registration as domain names.

107. It was queried whether any protection of INNs could appropriately be adopted by administrators of ccTLDs. On this question, the majority of commentators were in favor of the protection of INNs at a country-code level.³⁷ While any decision on the sorts of protection to be adopted within a ccTLD is a decision for the administrator and the competent national authorities, it is suggested that the efficacy of the INN system would best be promoted through the application of the protection of INNs in all ccTLDs. It should be noted, however, that national name systems, equivalent to the INN system, exist in a number of countries, such

as British Approved Names (BAN), Dénominations communes françaises (DCF), Japanese Adopted Names (JAN) and United States Accepted Names (USAN). Such national name systems are, for the most part, harmonized with the INN Cumulative List. Nevertheless, it is recommended that, in considering the application of the protection of INNs, the ccTLD administrator do so in consultation with the national health authorities in order to ensure appropriate implementation of the policy.

ANALYSIS OF VIEWS EXPRESSED ON MEANS OF IMPLEMENTING PROTECTION

108. The Interim Report proposed for comment three alternate means to give expression to the protection of INNs within the DNS:

- (i) an exclusion or blocking mechanism;
- (ii) a modified Uniform Dispute Resolution Procedure (UDRP); and
- (iii) a notice and take-down procedure.

Exclusion Mechanism

109. The Interim Report proposed consideration of an exclusion mechanism to cancel registrations in all open gTLDs of domain names that exactly matched the INNs on the WHO Cumulative List, and to block any future registrations of such INNs. The exclusion mechanism gained the support of numerous commentators to the Second WIPO Process, including WHO,³⁸ as an appropriate means to reflect in the DNS the established international principles for protection of INNs in the physical world, while preventing damage to the INN system and risk to consumers.³⁹ The concept of an exclusion mechanism also received support from representatives of the pharmaceutical industries, as well as industry associations.⁴⁰

110. It is noted that a system for exclusions currently operates effectively in various trademark office practices around the world in the process of their examination of trademark applications for possible conflict with INNs.⁴¹ It was suggested in the Interim Report that an

exclusion mechanism could operate through reference to WHO's existing MEDNET service – a publicly available, free, searchable database that allows access and queries to the INN database.⁴² The MEDNET database lists INNs with recommended, proposed and alternative medicinal names that, it was suggested, could be utilized by the domain name registration authorities administering an exclusion mechanism.⁴³

111. However, despite a general opinion in favor of protection of INNs, the concept of an exclusion met with significant opposition from numerous commentators, suggesting that it could not feasibly be implemented with the consensus of the Internet community. An exclusion mechanism was criticized by one commentator as over-inclusive, because it cancels names that do not threaten public health and safety, and under-inclusive because it does not purge the Web of misinformation about pharmaceuticals.⁴⁴ The blunt method of an exclusion mechanism was also criticized as being inconsistent with the policy underlying generic drug names, in that it would result in limitation of free speech and open discussion concerning INNs both in the physical world and online. It was also noted that cancellation of existing domain names through an exclusion process would result in loss without due process for domain name holders.⁴⁵ These views reflect a widely prevalent attitude among the Internet community against the implementation of blocking mechanisms within the DNS with respect to any identifiers. Commentators urged WIPO to recommend an alternate means of expressing the protection of INNs in the DNS.

Modified UDRP

112. Commentators to the Second WIPO Process were generally opposed to modification of the existing UDRP to address new identifiers that were outside the scope of the intellectual property legal system.⁴⁶ Although the current UDRP does not cover INNs, at least one published UDRP decision touches upon this issue.⁴⁷ Commentators expressed concern that the UDRP, as it stands, may be inappropriate to resolve disputes involving intergovernmental organizations, such as WHO, and private individuals.⁴⁸ The UDRP and its requirement that complainants submit to the jurisdiction of national courts in respect of challenges to administrative decisions, would require a compromise in the customary immunity granted to international intergovernmental organizations, which is also problematic.⁴⁹ Most

commentators who supported the UDRP option for protection of INNs primarily supported the administrative nature of the process, as opposed to an exclusion mechanism. Others, while supporting the principle of protection for INNs, opposed both the UDRP and the exclusion mechanism: “While INNs should be protected against commercial use by one party, this should be effected through some means other than the UDRP, whether it be by treaty process or direct intervention on the part of ICANN.”⁵⁰

Notice and Take-down Procedure

113. As noted above, the majority of comments to the Second WIPO Process were strongly in favor of some means to protect INNs in the DNS. Commentators favored a system that would efficiently prevent INNs from being registered as domain names in the gTLDs, if those registrations would have the effect of undermining the INN system and potentially confusing users and health professionals. Any mechanism for protection should not overburden domain name registration authorities, nor require an international intergovernmental organization (WHO) to be unduly subject to a costly dispute-resolution procedure to protect such identifiers in the public interest.

114. Under the proposed notice and take-down procedure, it was suggested that upon notification to WIPO by any interested party, (including, *inter alia*, individuals, consumer groups, manufacturers, medical associations, international organizations and governments), WIPO would verify that the domain name registration matches an entry on the Cumulative List of INNs in any official language, and notify ICANN of this fact. ICANN would then certify to the appropriate registrar that an exact INN has been registered as a domain name. The registrar would then be required, in conformity with its Registrar Accreditation Agreement, to cancel the registration forthwith.

115. The remedy of cancellation in such circumstances was supported by WHO as an effective remedy, despite the subsequent availability of such domain names for re-registration, as the possibility of cancellation through notice and take-down remains available in the event of any future re-registration.⁵¹

RECOMMENDATION

116. A clear majority of commentators were in favor of the protection of INNs in the DNS. There were, however, differing views about the means of implementing that protection and, especially, about the extent of protection.

117. In these circumstances, we consider it to be appropriate to recommend the implementation, at this stage, of a very simple mechanism of protection that requires no judgements of similarity or good or bad faith use, but mere clerical verification. We recommend that there should be a prohibition against the registration of exact INNs in any of the official languages of the Cumulative List in the gTLDs, and that any exact INN registered in violation of this prohibition should be subject to cancellation, upon notification by any interested party to WIPO, verification by WIPO, in conjunction with WHO, of the exact similarity of the domain name registration and the INN, notice to ICANN by WIPO, and certification by ICANN to the registrar concerned (with notification to the domain name holder). Consideration could be given to allowing a reasonable transition period for the holder of the registration that is subject to cancellation to migrate to another domain name registration.

118. The world health community, through consensus among relevant public authorities and private circles, have considered it to be appropriate to establish the INN system for the protection of public safety and the promotion of a reliable system of identifiers that can be used by the world at large for health-related information. It has also invested considerable resources in the maintenance and further development of that system. A reliable and accurate database exists whereby anyone can obtain appropriate information about the status of an INN. It does not seem appropriate that a technical addressing system for the Internet should carry within it the possibility of flouting a system that has been carefully constructed by appropriately specialized public authorities and private industry, especially if a remedy is simply and efficiently available.

119. It is accordingly recommended that:

(i) ICANN's agreements with registries for gTLDs should require the prohibition of the registration of exact INNs in any of the official languages of the Cumulative List as domain names;

(ii) a similar prohibition should be reflected in registration agreements for domain names in the gTLDs;

(iii) any interested party should have the right to serve notice that a domain name registration in a gTLD is identical to an INN and that, upon verification of the exact similarity between the domain name registration and the corresponding INN by WIPO, in conjunction with WHO, notice to ICANN, and certification by ICANN to the registrar concerned, the domain name registration should be cancelled.

120. It is also recommended that the prohibition should apply to all existing and future registrations of domain names. INNs are not common words, but fictitious, invented words, and their registration as a domain name is hardly likely to have been accidental. The INN system has been well publicized amongst all those operating in health-related professions and businesses. The registration of an INN as a domain name creates an exclusive control of that INN as an address in the corresponding domain, in contravention of the underlying policy of the INN system.

121. It is further recommended that administrators of ccTLDs adopt a corresponding policy, in conjunction with their national health authorities.

122. In making the abovementioned recommendations, it is pointed out that the INN system is not supported by an international treaty, but by a resolution of the competent treaty organ of the World Health Organization and by consensus between public authorities and private industry. The effect of our recommendation is, therefore, to encourage ICANN to join the consensus established by the competent public and private authorities whose concern it is to promote public health and safety.

123. We do not recommend, at this stage, any further protection for INNs in the DNS, and, in particular, do not recommend an administrative dispute-resolution procedure in respect of misleading variations of INNs, for the following reasons:

(i) We believe that it is appropriate to commence with the certain and to review the application of the policy in the light of experience.

(ii) There is no convincing evidence of the damaging misuse of INNs through the registration of misleading variations of INNs as domain names. Since the existing policy of the INN system allows the use of the name of a manufacturer with an INN, difficult judgements might be involved in determining what is and what is not misleading in variations of INNs. Reliance upon the content of a web site addressed through a domain name may similarly involve difficult judgements, since content changes constantly.

(iii) Extending protection beyond domain names that are exactly similar to INNs would risk significantly increasing the administrative and transaction costs associated with the DNS. The UDRP, as it operates at present, is simple and the addition of more layers risks adding complexity that may be difficult for users of the DNS to apprehend.

(iv) The implementation of a simple procedure involving a clerical verification of exact similarity between a domain name registration and an INN does not require the development of policies on the extent of protection by ICANN, but simply the recognition by

ICANN of the value of the naming system that has already been established by competent authorities in the health sector. Insofar as the Domain Name Supporting Organization (DNSO) has a responsibility of advising the Board of ICANN “with respect to policy issues relating to the Domain Name System” (see paragraph 15, above), those policy issues presumably are circumscribed by the definition of functions of ICANN set out in its Articles of Incorporation (see paragraph 75, above), which relate to the technical functioning and stability of the DNS. The Names Council of the DNSO has no constituency representing health interests.

124. In recommending that no further measures than the prohibition against the registration of exact INNs as domain names be taken at this stage, the possibility is left open to re-visit the question of such further measures at a later stage in the light of the experience gained with respect to the recommendation made (assuming that it is adopted) and of further evidence to suggest that the integrity of the INN system is damaged through the registration of misleading variations of INNs.

¹ Google search engine lists more than 46 million health-related sites, and Yahoo! Shopping offers more than 50,000 listings for sales and purchase of health products. The proposal submitted by the World Health Organization (WHO) for a .health gTLD noted the existence of more than 10,000 health-related sites.

² WIPO, *The Management of Internet Names and Addresses: Intellectual Property Issues* (April 30, 1999) at paras. 295-303.

³ See “The use of common stems in the selection of International Nonproprietary Names (INN) for pharmaceutical substances,” April 2000, Programme on International Nonproprietary Names, Quality Assurance and Safety: Medicines, Essential Drugs and Medicines Policy, WHO, Geneva (WHO/EDM/QSM/99.6). See also Daniel L. Boring “The Regulation and Development of Proprietary Names for Pharmaceuticals in the United States” *Trademark World* (November/ December, 1997) at 40.

⁴ The WHO publishes bi-annual lists of Proposed and Recommended INNs that are taken into the Cumulative List every seven years. The Cumulative List is disseminated by WHO in electronic form in seven official languages: Arabic, Chinese, English, French, Latin, Russian and Spanish. See Comment of World Health Organization (RFC-3 – June 7, 2001), Comment of European Federation of Pharmaceutical Industries and Associations (EFPIA) (RFC-3 – June 5, 2001).

⁵ *Basic Documents*, 39th edition, Geneva, World Health Organization, 1992. See also “Guidelines on the Use of International Nonproprietary Names (INNs) for Pharmaceutical Substances,” 1997, Report of the Programme on International Nonproprietary Names (INN), Division of Drug Management & Policies, WHO, Geneva (WHO/PHARM S/NOM 1570).

⁶ Annex III sets out the World Health Assembly resolutions pursuant to which the INN system was established. Usually, an INN consists of a randomly chosen prefix and a common ‘stem’: substances belonging to a group of pharmacologically related substances denote this

[Endnote continued from previous page]

- relationship by using a common stem or suffix. For a description of the use of stems and a list of common stems in the INNs system, see “Guidelines on the Use of International Nonproprietary Names (INNs) for Pharmaceutical Substances”, 1997, Report of the Programme on International Nonproprietary Names (INN), Division of Drug Management & Policies, WHO, Geneva (WHO/PHARM S/NOM 1570) at Section 3 and Annex 3.
- 7 See Comment of World Health Organization (WHO) (RFC-3 – June 7, 2001).
- 8 See Comment of World Health Organization (WHO) (RFC-3 – June 7, 2001).
- 9 See Comment of Asociación Interamericana de la Propiedad Industrial (RFC-2 – December 26, 2000).
- 10 For example: amoxicillin.com resolves to a web page offering a basic description of the drug and its applications, as well as two advertisements linking to pharmaceutical companies offering commercial services; phentermine.com resolves to a web page offering an entire lifestyle option for those interested in the diet-related drug.
- 11 See Comment of World Health Organization (WHO) (RFC-3 – June 7, 2001).
- 12 One commentator stated that, to its knowledge, there was no reported case of a domain name containing an INN that had threatened patient safety. See Comment of Anakena.com (RFC-2 – December 28, 2000). See also Comment of United States of America, Office of Advocacy, U.S. Small Business Administration (RFC-3 – June 15, 2001), Comment of International Association for the Protection of Industrial Property (AIPPI) (RFC-3 – June 18, 2001), Comment of NIC Chile (RFC-3 – May 10, 2001), Comment of Anakena.com (RFC-3 – June 15, 2001), Comment of Nominet UK (RFC-3 – June 14, 2001), Comment of Pharma Consulting International (RFC-3 – June 14, 2001).
- 13 See Comment of Canada (RFC-3 – July 5, 2001), Comment of Hungary, Hungarian Patent Office (RFC-3 – June 13, 2001), Comment of Japan, Ministry of Economy, Trade and Industry (METI) (RFC-3 – July 5, 2001), Comment of Mexico, Mexican Institute of Industrial Property (IMPI) (RFC-3 – June 5, 2001), Comment of Mexico, National Institute of Copyright (RFC-3 – May 30, 2001), Comment of Switzerland, Swiss Federal Institute of Intellectual Property (RFC-3 – June 15, 2001), Comment of European Commission (RFC-3 – June 25, 2001), Comment of World Health Organization (WHO) (RFC-3 – June 7, 2001), Comment of Brazilian Association of Intellectual Property (ABPI) (RFC-3 – June 8, 2001), Comment of European Brands Association (AIM) (RFC-3 – May 16, 2001), Comment of European Federation of Pharmaceutical Industries and Associations (EFPIA) (RFC-3 – June 5, 2001), Comment of Law and Technology Committee, Auckland District Law Society (RFC-3 – June 22, 2001), Comment of UAEnic (RFC-3 – June 6, 2001), Comment of Martin Cibula (RFC-3 – June 15, 2001).
- 14 See Comment of Anakena.com (RFC-3 – June 15, 2001), Comment of Elzaburu (Luis H. De Larramendi) (RFC-3 – June 14, 2001), Comment of Michael Froomkin (RFC-3 – June 4, 2001), Comment of Jesper Juhl (RFC-3 – June 14, 2001), Comment of Christian Mogensen (RFC-3 – April 16, 2001), Comment of Muirinn Ruadh (RFC-3 – May 1, 2001). See also Comment of International Trademark Association (INTA) (RFC-2 – January 4, 2001).
- 15 See Comment of Daniel R. Tobias (RFC-3 – April 15, 2001), Comment of World Intellectual Piracy Organization (RFC-3 – June 15, 2001).
- 16 See Comment of United States of America, Office of Advocacy, U.S. Small Business Administration (RFC-3 – June 15, 2001), Comment of International Association for the Protection of Industrial Property (AIPPI) (RFC-3 – June 18, 2001), Comment of NIC Chile (RFC-3 – May 10, 2001), Comment of Anakena.com (RFC-3 – June 15, 2001), Comment of Nominet UK (RFC-3 – June 14, 2001), Comment of Pharma Consulting International (RFC-3 – June 14, 2001).

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- ¹⁷ It was noted that INNs may be registered as domain names by pharmaceutical companies or individuals related to the healthcare industry and used in good faith to provide information to users (e.g. tamoxifencitrate.com – registered by Barr Laboratires to provide information about a generic medication used in breast cancer treatment). See Comment of Anakena.com (RFC-3 – June 15, 2001), Comment of Pharma Consulting International (RFC-3 – June 14, 2001).
- ¹⁸ See Comment of Hungary, Hungarian Patent Office (RFC-3 – June 13, 2001), Comment of European Federation of Pharmaceutical Industries and Associations (EFPIA) (RFC-3 – June 5, 2001), Comment of Law and Technology Committee, Auckland District Law Society (RFC-3 – June 22, 2001). See also Comment of World Health Organization (WHO) (RFC-2 – December 21, 2000).
- ¹⁹ See Comment of Mexico, Mexican Institute of Industrial Property (IMPI) (RFC-3 – June 5, 2001). One commentator added that, in this event, some means of protection would be needed to ensure that other intellectual property rights were not violated in the use of the manufacturers’ names. See Comment of European Commission (RFC-3 – June 25, 2001).
- ²⁰ See Comment of Pharma Consulting International (RFC-3 – June 14, 2001), Comment of Anakena.com (RFC-2 – December 28, 2000).
- ²¹ See Comment of European Federation of Pharmaceutical Industries and Associations (EFPIA) (RFC-3 – June 5, 2001), Comment of International Association for the Protection of Industrial Property (AIPPI) (RFC-3 – June 18, 2001).
- ²² See Comment of World Health Organization (WHO) (RFC-3 – June 7, 2001).
- ²³ See Comment of Mexico, Mexican Institute of Industrial Property (IMPI) (RFC-3 – June 5, 2001).
- ²⁴ See Comment of European Commission (RFC-3 – June 25, 2001).
- ²⁵ Uniform Domain Name Dispute Resolution Policy, Paragraph 4(a)(i).
- ²⁶ See Comment of World Health Organization (WHO) (RFC-3 – June 7, 2001).
- ²⁷ See Comment of Mexico, Mexican Institute of Industrial Property (IMPI) (RFC-3 – June 5, 2001).
- ²⁸ See Comment of European Federation of Pharmaceutical Industries and Associations (EFPIA) (RFC-3 – June 5, 2001), Comment of Pharma Consulting International (RFC-3 – June 14, 2001).
- ²⁹ See Comment of Nominet UK (RFC-3 – June 14, 2001), Comment of Michael Froomkin (RFC-3 – June 4, 2001), Comment of Daniel R. Tobias (RFC-3 – April 15, 2001).
- ³⁰ One commentator, for example, referred to the global availability and use of INNs to suggest that protection should not be limited to the list of INNs maintained by WHO, but should extend to cover translations of the names identifying each pharmaceutical substance or ingredient, to ensure global consumer protection – for example, the Portuguese translation of ‘ampicillin’, ‘ampicilina’, is not included on the WHO list and, if misused in the DNS, could result in harm to Portuguese patients unless it too is protected from registration. See Comment of Brazilian Intellectual Property Association (ABPI) (RFC-1 – September 15, 2000).
- ³¹ See Comment of Mexico, Mexican Institute of Industrial Property (IMPI) (RFC-3 – June 5, 2001), Comment of Elzaburu (Luis H. De Larramendi) (RFC-3 – June 14, 2001), Comment of UAEnic (RFC-3 – June 6, 2001).
- ³² See Comment of United States of America, Office of Advocacy, U.S. Small Business Administration (RFC-3 – June 15, 2001).
- ³³ See Comment of Anakena.com (RFC-3 – June 15, 2001), Comment of Japan Network Information Centre (JPNIC) (RFC-3 – June 8, 2001), Comment of Nominet UK (RFC-3 – June 14, 2001), Comment of Pharma Consulting International (RFC-3 – June 14, 2001).

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- ³⁴ See Comment of European Federation of Pharmaceutical Industries and Associations (EFPIA) (RFC-3 – June 5, 2001), Comment of Law and Technology Committee, Auckland District Law Society (RFC-3 – June 22, 2001), Comment of UAEnic (RFC-3 – June 6, 2001).
- ³⁵ See Comment of Hungary, Hungarian Patent Office (RFC-3 – June 13, 2001).
- ³⁶ See Comment of Japan, Ministry of Economy, Trade and Industry (METI) (RFC-3 – July 5, 2001), Comment of World Health Organization (WHO) (RFC-3 – June 7, 2001), Comment of American Intellectual Property Law Association (AIPLA) (RFC-3 – June 7, 2001), Comment of European Federation of Pharmaceutical Industries and Associations (EFPIA) (RFC-3 – June 5, 2001), Comment of Law and Technology Committee, Auckland District Law Society (RFC-3 – June 22, 2001).
- ³⁷ See Comment of Japan, Ministry of Economy, Trade and Industry (METI) (RFC-3 – July 5, 2001), See Comment of World Health Organization (WHO) (RFC-3 – June 7, 2001), Comment of American Intellectual Property Law Association (AIPLA) (RFC-3 – June 7, 2001), Comment of European Federation of Pharmaceutical Industries and Associations (EFPIA) (RFC-3 – June 5, 2001), Comment of Law and Technology Committee, Auckland District Law Society (RFC-3 – June 22, 2001).
- ³⁸ See Comments of World Health Organization (WHO) (RFC-3 – June 7, 2001) and (RFC-2 – December 21, 2000).
- ³⁹ See Comment of Hungary, Hungarian Patent Office (RFC-3 – June 13, 2001), Comment of Japan, Ministry of Economy, Trade and Industry (METI) (RFC-3 – July 5, 2001), Republic of Korea, Korean Intellectual Property Office (KIPO) (RFC-3 – June 7, 2001), Comment of Switzerland, Swiss Federal Institute of Intellectual Property (RFC-3 – June 15, 2001), Comment of European Commission (RFC-3 – June 25, 2001), Comment of World Health Organization (WHO) (RFC-3 – June 7, 2001), Comment of International Chamber of Commerce (ICC) (RFC-3 – June 18, 2001), Comment of Martin Cibula (RFC-3 – June 15, 2001). See also Comment of the European Commission (RFC-2 – January 16, 2001), Comment of Asociación Interamericana de la Propiedad Industrial (RFC-2 – December 26, 2000). One commentator noted that “[i]n contrast to personal names, these are names that should be protected to the greatest extent possible, since confusion could cause immense damage. These names should be incorporated into a register and completely excluded from all TLDs and ccTLDs.” See Comment of MARQUES, Association of European Trade Mark Owners (RFC-2 – December 22, 2000).
- ⁴⁰ See Comment of European Federation of Pharmaceutical Industries Associations (EFPIA) (RFC-2 – December 15, 2000), Comment of European Brands Association (AIM) (RFC-2 – December 20, 2000).
- ⁴¹ The Austrian Patent Office, for example, examines trademark applications and, where a trademark is identical with a recommended INN on the basis of descriptiveness, registration is refused. Where the conflict is with a proposed INN, the application is accepted, but the applicant is informed of a potential future conflict. The lists of proposed and recommended INNs are constantly updated in the database of the Austrian Patent Office. The Canadian Intellectual Property Office examines trademarks and refuses those that conflict with INNs on the basis of descriptiveness and deceptive misdescriptiveness. The French INPI examines trademark applications manually using a directory, and refuses those that conflict with INNs on the basis of descriptiveness. The Japanese Patent Office examines trademark applications using an automated system, and applications are refused on the basis of descriptiveness, if a mark is identical or closely similar to an INN. The Swiss Office examines trademark applications manually using a directory and refuses only those applications where a mark is identical with a recommended INN. The UK Office examines trademark applications using an automated

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system and applications are refused on the basis of descriptiveness, if a mark is identical or closely similar with a recommended INN.

42 See <http://mednet.who.int>.

43 Currently, the MEDNET is available only to WHO ‘INN partners’, with authorization given through an automated administration process, that ensures privacy using password and authentication systems. However, it is envisaged that different layers of access will be provided in future to authorized users.

44 See Comment of United States of America, Office of Advocacy, U.S. Small Business Administration (RFC-3 – June 15, 2001). The opposition to an exclusion mechanism was confirmed by numerous other commentators: see Comment of Japan Network Information Centre (JPNIC) (RFC-3 – June 8, 2001), Comment of Pharma Consulting International (RFC-3 – June 14, 2001), Comment of Luis de Barros (RFC-3- June 14, 2001), Comment of Chris Brand (RFC-3 – April 16, 2001), Comment of Michael Froomkin (RFC-3 – June 4, 2001), Comment of Jason Presley (RFC-3 – April 18, 2001), Comment of George Reese (RFC-3 – April 15, 2001).

45 It was noted that scientific, regulatory, and consumer communities use the generic names to discuss pharmaceuticals’ benefits, side effects, testing and regulatory review and progress. (e.g., consumers understand that NutraSweet® is a trademark but ‘aspartame’ is open for all use). See Comment of Association for Computing Machinery’s Internet Governance Project, Electronic Privacy Information Center (RFC-3 – June 15, 2001).

46 See Comment of International Trademark Association (INTA) (RFC-3 – May 24, 2001), Comment of Nominet UK (RFC-3 – June 14, 2001), Comment of Pharma Consulting International (RFC-3 – June 14, 2001). See also Comment of Fédération internationale des conseils en propriété industrielle (FICPI) (RFC-2 – December 29, 2000), Comment of United States Council for International Business (USCIB) (RFC-2 – December 29, 2000), Comment of Verizon Communications (RFC-2 – December 26, 2000).

47 The case of *Boehringer Ingelheim Corporation v. Kumar Bhatt*, involved the domain names micardis.com, telmisartan.com and meloxicam.com, of which the first reflects a registered trademark of the Complainant pharmaceutical company, and the latter are recommended INNs used by the Complainant to market pharmaceutical products in which they are active ingredients. The Administrative Panel transferred all three names to the Complainant on the basis of its status as trademark owner, as well as patentee and exclusive licensee of products marketed under the INNs. The Respondent, a physician and Internet consultant, argued that his registration of the names was to assist patients and the general public by providing centralized reference sites for medical information, and that ‘telmisartan’ and ‘meloxicam’ were generic terms in the public domain. Telmisartan is an active ingredient under the Micardis trademark, and meloxicam is an active ingredient under the Mobic trademark, also registered by the Complainant. Meloxicam is INN Request No. 5615; WHO recommended INN published April 1987. The Administrative Panel accepted the Complainant’s argument that the domain names reflecting the INNs were identical or confusingly similar to product identification marketed under its trademarks, and that the registration of these names prevented consumers from finding information from the only source of the products. See National Arbitration Forum, *Claim Number FA0006000095011*, (August 11, 2000).

48 See Comment of Mexico, Mexican Institute of Industrial Property (IMPI) (RFC-3 – June 5, 2001).

49 The Convention on the Privileges and Immunities of the United Nations (adopted by the General Assembly of the United Nations on 13 February 1946) and the Convention on the Privileges and Immunities of the Specialized Agencies (adopted by resolution of the General Assembly on 21 November 1947) provide for the special legal status of these international

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intergovernmental organizations. They provide that such entities shall have the capacity to, *inter alia*, institute legal proceedings (Article I and Article II respectively) but shall enjoy immunity from every form of legal process, except insofar as the organization expressly waives such immunity (Article II and Article III respectively).

⁵⁰ See Comment of Fédération internationale des conseils en propriété industrielle (FICPI) (RFC-3 – June 14, 2001).

⁵¹ See Comment of World Health Organization (WHO) (RFC-3 – June 7, 2001). An alternative remedy that was favored by some commentators was the transfer of any domain name replicating an INN to WHO, while costs of registration maintenance could be minimized by agreement between the registrars and ICANN. One commentator also suggested that WHO could maintain informational sites at the INN domains; see Comment of Christian Mogensen (RFC-3 – April 16, 2001).

4. NAMES OF INTERNATIONAL INTERGOVERNMENTAL ORGANIZATIONS

125. One of the consequences of increased personal mobility, the networked society, open trading and financial systems and the power of technology has been that issues requiring public sector intervention are increasingly international in character. As a result, international intergovernmental organizations (IGOs) – such as the United Nations Organization (UNO), the Food and Agricultural Organization (FAO), the International Labour Organization (ILO), the International Monetary Fund (IMF), the International Telecommunications Union (ITU), the World Health Organization (WHO), the World Meteorological Organization (WMO) and the World Trade Organization (WTO) – are called upon to play a progressively more important role in multilateral affairs among States and their citizens. The ability of these IGOs to fulfil their respective missions depends on effective communication and dissemination of information about their activities and services.

126. The Internet provides a powerful means for IGOs to present information about and encourage participation in their programs. At the same time, however, the Internet poses a risk that individuals and entities might attempt to capitalize, through unauthorized association, imitation, deception or fraudulent activity, on the standing of these organizations. If an IGO's name or acronym is used on the Internet by unauthorized parties, it may lose its distinctive power of identification, while the public, by virtue of the false associations, may be misled as to the information or products or services offered by the unauthorized party.

127. The Request addressed to WIPO to initiate the Second WIPO Process sought recommendations on whether and, if so, in what manner, protection should be accorded to the names and acronyms of IGOs against abusive registration as domain names in the DNS. This Chapter describes the existing international legal basis for the protection of the names and acronyms of IGOs; explains the operation and potential of the existing .int top-level domain; presents the evidence of existing abuses in the DNS; analyses the comments received on this issue in response to the Interim Report; and makes a recommendation on how the names and acronyms of IGOs might be protected within the DNS.

EXISTING INTERNATIONAL PROTECTION

128. The existing international legal framework contains clearly expressed and widely accepted (through applicable constitutional processes) principles prohibiting the unauthorized commercial use, as trademarks, of the names and acronyms¹ of IGOs.

129. Article 6*ter* of the Paris Convention for the Protection of Industrial Property (the Paris Convention), to which 162 States are party, provides, *inter alia*:

“(1)(a) The countries of the Union agree to refuse or to invalidate the registration, and to prohibit by appropriate measures the use, without authorization by the competent authorities, either as trademarks or as elements of trademarks, of armorial bearings, flags, and other State emblems, of the countries of the Union, official signs and hallmarks indicating control and warranty adopted by them, and any imitation from a heraldic point of view.

“(b) The provisions of subparagraph (a), above, shall apply equally to . . . abbreviations, and names, of international intergovernmental organizations of which one or more countries of the Union are members, with the exception of . . . abbreviations, and names, that are already the subject of international agreements in force, intended to ensure their protection.”²

130. Article 6*ter* was introduced into the Paris Convention by the Revision Conference of The Hague in 1925, with the purpose of protecting the armorial bearings, flags, official signs or emblems of the States party to the Convention, as well as other signs or hallmarks indicating control and warranty by them. This protection was extended in order to ensure that such designations are clearly attributed to the State concerned, and not misused by any third party. It was then recognized that the public interest in favor of such protection at the national level applied equally to the public sector at the international level, and protection was extended to IGOs by the Revision Conference of Lisbon in 1958.³

131. The Paris Convention, (Article *6ter* (1)(b)), accordingly prohibits the registration and use of, *inter alia*, the names or abbreviations of IGOs as trademarks or elements of trademarks. The Trademark Law Treaty of 1994 (Article 16) extends the same protection against registration and use with respect to service marks.⁴

132. The entitlement of an IGO to receive protection under these treaties is not automatic. Any name or abbreviation for which an IGO wishes to obtain protection must be communicated to the International Bureau (Secretariat) of WIPO, which will then transmit the communication to the States party to the Paris Convention.⁵ The protection available to IGOs under the Paris Convention thus depends entirely upon their submission of a request for communication to WIPO.⁶ WIPO maintains a notification list and performs the functions of determining the admissibility of such requests for communication under Article *6ter* and of forwarding the admissible communications to the States party to the Paris Convention.

133. To date, a total of 91 IGOs have requested protection under Article *6ter*. Each organization has not requested protection of all of the possible signs or emblems enumerated under Article *6ter* (e.g., armorial bearings or flags). As a general rule, however, most IGOs that have requested protection have notified their name and abbreviation (in several languages), as well as their principal emblem.⁷

134. In 1992, the Paris Union Assembly (the competent treaty organ of the Paris Convention) adopted a set of “Guidelines for the Interpretation of Article *6ter*(1)(b) and (3)(b) of the Paris Convention”⁸ designed to clarify which IGOs may qualify for protection under the Paris Convention. This clarification was in response to the increasing number of ‘programs’ within international organizations that are autonomous and publicly recognized, such as UNAIDs. The Guidelines provide that, in addition to IGOs as such, any program or institution established by an IGO, or any convention constituting an international treaty between one or more States party to the Paris Convention, may seek protection under Article *6ter*(3)(b), provided such program, institution or convention is “a permanent entity hav[ing] specified aims and its own rights and obligations.”

135. The Guidelines define a “permanent entity” as one that has been established “for an indefinite period of time.”⁹ The “specified aims” and “rights and obligations” of such a permanent entity are defined by reference, respectively, to subject matters, rights and obligations “which are clearly defined in [the permanent entity’s] enabling statutes or charter or in the resolutions or decisions by which it has been established.”¹⁰

136. The Paris Convention foresees that the use of IGOs’ insignia may be authorized,¹¹ and permits States the choice whether to apply a further non-mandatory exception to its prohibitions against trademark registration and use, specifically in respect of the names, abbreviations and other emblems of IGOs. States are not required to apply such prohibitions when the registration or use of the trademark in question:

- (i) “is not of such a nature as to suggest to the public that a connection exists between the organization concerned and the . . . abbreviations, and names,” or
- (ii) “is probably not of such a nature as to mislead the public as to the existence of a connection between the user and the organization.”¹²

Many, but not all, States party to the Convention have enacted the exception in national legislation and, to this extent, there is divergence at the national level in the scope of protection granted to IGOs.¹³

137. The Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement) of the World Trade Organization (WTO) (Article 2), fully incorporates the protection provided under Article 6*ter* of the Paris Convention and imposes these obligations on the (at present, 142) States party to the Agreement, specifically referring to the “notifications pursuant to the obligations under this Agreement stemming from the provisions of Article 6*ter* of the Paris Convention.”¹⁴ The Agreement Between the World Intellectual Property Organization and the World Trade Organization (WIPO-WTO Agreement) of 1995, clarified that:

“The procedures relating to communication of emblems and transmittal of objections under the TRIPS Agreement shall be administered by the International Bureau [of WIPO] in accordance with the procedures applicable under Article 6*ter* of the Paris Convention (1967).”¹⁵

SCOPE OF EXISTING INTERNATIONAL PROTECTION

138. The scope of existing international protection established by the treaty provisions discussed above may be summarized as follows:

(i) The *registration* and *use*, as trademarks, service marks or elements thereof, of the names and abbreviations of IGOs is prohibited, except where such registration and use is authorized or falls within a permitted exception. Contracting Parties agree to refuse or invalidate any such registration of the names or acronyms of IGOs, and to prohibit their use by appropriate measures.¹⁶ The clear purpose is to ensure that these names and abbreviations remain free of the private proprietary rights. These provisions reflect the public status of IGOs, and seek to avoid any potential for confusion or deception that would interfere with that public status.

(ii) The protection afforded by the treaties is directed against the registration and use of the names and abbreviations of IGOs as *trademarks* or *service marks*. It follows that, to the extent that a domain is the same as the name or acronym of an IGO and *is used as a trademark or service mark* (by, for example, constituting an identifier used for commercial purposes), the registration and use of the domain name is contrary to the provisions of the Paris Convention and the TRIPS Agreement (unless allowed under a permitted exception).

(iii) The class of IGOs that may receive protection for their names and acronyms under the international treaties is strictly limited. Protection is granted only to those IGOs that have sent an admissible request for communication to WIPO, have not received an objection from any of the applicable Contracting States, and have had their names or

acronyms notified accordingly. As noted above, only 91 such organizations received such protection since 1958, when this system was established.

(iv) The protection granted to IGOs under the international treaties is subject to exception, when the registration or use of an IGO's name or abbreviation as a trademark or service mark is not of such a nature to suggest to the public that a connection exists with the organization concerned, or is "probably not of such a nature as to mislead the public as to the existence of a connection between the user and the organization."¹⁷ By analogy, the registration and use by third parties of the names or acronyms of IGOs as domain names might, in countries that recognize this exception, be considered permissible, if the registration and use of the domain name is unlikely to suggest to, or to mislead, the public that a connection with the IGO exists. One commentator noted, for example, that existing domain name registrants should be given the opportunity to defend their registration through the UDRP, on the same grounds set forth in Article 6*ter* (1)(c).¹⁸

THE .INT TOP-LEVEL DOMAIN

139. The .int - for "international" - top-level domain was among the seven initial generic domains established by the Internet Assigned Numbers Authority (IANA), and its use remains restricted to "organizations established by international treaties, or international databases."¹⁹ IANA states that .int is reserved for "organizations established by international treaties between or among national governments" and, in particular, that:

"We recognize as organizations qualified for domain names under the .int top-level domain the "specialized agencies" of the UN (currently there are 14 of these) and the organizations having "observer status" at the UN (currently 16)."²⁰

Only one registration is allowed for each organization. IANA makes no reference to the Paris Convention procedures under Article 6*ter* which provide protection for IGOs.²¹

140. It is notable that, from the beginning, special status was accorded within the DNS to international organizations. The restricted .int gTLD serves the dual purposes of (i) designating a space in the DNS for the registration of IGOs' chosen identifiers, and (ii) providing a measure of protection through registration requirements which restrict that space only to those international organizations that qualify (i.e., those that are established by treaty).

141. The .int top-level domain provides some measure of assistance to IGOs within the DNS. Because of the restricted nature of this top-level domain, no individuals, companies or other entities can obtain a domain name registration in .int, let alone register the name or abbreviation of an IGO in that domain. As long as the registration procedures of .int are properly enforced, the .int top-level domain provides a space where Internet users can have confidence that registrations in the domain are genuinely connected with the corresponding organizations. This restricted domain for IGOs has the added advantage of having already been established, and the assistance it offers to IGOs in protecting the authenticity of their virtual identities cannot interfere with any existing rights or interests of domain name registrants in other TLDs. For these reasons, the question was raised in the Second WIPO Process whether adequate protection may already exist in the DNS for international organizations by virtue of the restricted .int gTLD.²²

142. Commentators throughout the Second WIPO Process revealed a lack of confidence that the existence of the .int domain, of itself, can provide sufficient protection to IGOs against the abuse of their names and acronyms in the DNS, and prevent any consequent deception of users of those sites.²³ The .int domain has several shortcomings. The limitation to one registration for each organization is overly restrictive and does not meet these organizations' needs. Consideration should be given to amending or eliminating this restriction – without altering the qualification procedures for registration – so that IGOs have the ability to register domain names corresponding both to their name and acronym and to their integral programs, activities or initiatives.

143. In addition, the .int domain is not universally adopted by all IGOs, and numerous organizations that qualify to register in .int have elected to register in other top-level domains,

such as .org.²⁴ The potential for abuse in these open gTLDs is illustrated by the fact that the United Nations Organization has registered ‘un.org’, whereas ‘unitednations.org’ has been registered by a private California-based company. As an alternative solution, the World Health Organization has its official site at ‘who.int’, and users visiting ‘who.org’ are automatically forwarded to the .int site. It is clear that many users are unaware of the existence or purpose of the .int domain, and considerable promotional work is needed to enhance its recognition. Nevertheless, most commentators strongly supported the enhancement of the visibility and profile of .int, and favored its use consistently and universally by all IGOs.²⁵

144. Critically, the protection provided to the names and acronyms of IGOs in the .int top-level domain has a serious deficiency. While restrictions apply to it, they do not apply to other gTLDs. The lack of restrictions in these other domains undermines the efficacy of .int.²⁶ It is the risk of predatory and parasitical practices in these domains (as well as in the ccTLDs), which raises most concern for IGOs and Internet users in general.²⁷ The .int domain space assists in determining when a domain name registration is legitimate, but it does not assist in determining when other registrations in the broader gTLD space are fraudulent. For this reason, at this stage, it is recommended that reliance alone upon the .int domain is insufficient. The question thus remains, in the context of the global DNS, how the names and abbreviations of IGOs can most effectively be protected.

ANALYSIS OF COMMENTS AND VIEWS EXPRESSED IN RESPONSE TO THE INTERIM REPORT

145. The significant majority of commentators to the Second WIPO Process were in favor of the recognition in the DNS of legal protection for the names and acronyms of IGOs.²⁸ As discussed below, the comments were divided as to the scope and form of this protection.

146. Without exception, the international organizations that submitted comments to the Second WIPO Process took the strong position that their names and abbreviations should not be subject to abusive registrations in the DNS, and viewed such registrations as contravening the purpose of the protection granted under existing international law. These organizations,

including the United Nations (UN), World Health Organization (WHO), World Trade Organization (WTO), Organization for the Prohibition of Chemical Weapons (OPCW) and International Labour Office (ILO), each voiced an unequivocal need for protection in the DNS, and gave evidence of having been “plagued by such infringing or abusive registrations.”²⁹ The IGOs noted that such protection would benefit not just the organizations themselves, but advance the global public interest by protecting Internet users and consumers from deceptive conduct.³⁰ Some IGOs stated that their names and abbreviations should not be available for registration as domain names by unauthorized third parties, even if the domain name registration is not in bad faith, as such registrations can nevertheless be confusing and misleading to the public, raising questions of authenticity and accuracy as to the source of information provided, and giving rise to the perception that an IGO endorses or approves of the information, service or product being offered through an unrelated web site.³¹

147. The organizations which should qualify for protection was also the subject of comments. Many commentators suggested, in this regard, that at least the names or acronyms of those IGOs that have followed the treaty procedures under the Paris Convention and TRIPS Agreement - and notified accordingly - should be considered for protection in the DNS.³² These commentators expressed the view that the scope of legal protection which already exists in the physical world for the names and abbreviations of IGOs should be reflected in the DNS. The United Nations (UN) put forward the view that protection should also be extended to the names and acronyms of subsidiary bodies of the UN organizations, such as peacekeeping missions, that are an integral and significant part of the Organization, although they do not qualify as ‘permanent entities’ in accordance with the Guidelines adopted for the interpretation of Article 6*ter* of the Paris Convention.³³ The World Trade Organization (WTO) also recommended that protection should extend to prominent units or parts within an IGO.³⁴ The WTO described the problems experienced with the registration of ‘gatt.org’, corresponding to the acronym for the General Agreement on Tariffs and Trade, which is used to provide misleading information to the public via a site that is deceptively similar to the official WTO site.

148. Evidence was provided throughout the Second WIPO Process of a sizeable problem of abuse of the names and acronyms of IGOs in the DNS. Commentators described instances of

abuse in the registration of their names or acronyms that had resulted in deception or confusion to the public, and that required constant and resource-wasting vigilance.³⁵ These organizations expressed concern that unofficial web sites using a domain name that is identical or similar to their name or acronym may contain misleading, inaccurate or prejudicial information about the IGO, while leading the viewer to believe that he or she is visiting the organization's official web site. The UN stated that, in dealing with such instances of abusive registrations, it has been required to constantly monitor the DNS and confront offending registrants one by one, committing substantial time and resources from various sectors of the Organization. The UN described the added complication in resolving these cases through available legal or administrative processes, because these procedures would inappropriately require the waiver of the privileges and immunities that are accorded to IGOs under international law.³⁶ In this respect, a number of commentators noted the importance of taking into account the customary immunity from legal process and execution that is accorded to IGOs, when implementing any system of protection for identifiers in the DNS.³⁷

149. A small minority of commentators felt that the existing protection granted to IGOs through the UDRP procedures, insofar as their names and acronyms may function as trademarks, is adequate.³⁸ It is notable, however, that no intergovernmental organization has yet filed a claim under the UDRP in respect of its name and acronym, nor can such a procedure accommodate the organizations' privileges and immunities.

150. With regard to the scope of protection to be granted to the names and acronyms of IGOs, most commentators favored protection in all gTLDs and, to the greatest extent possible, in the ccTLDs.³⁹ One commentator also noted that protection should extend to all levels of the domain name (e.g., to protect equally 'oami.com' and 'oami.uk.com').⁴⁰ A number of commentators noted that a directory or listing service of IGOs, especially of those which are protected under the Paris Convention and through the TRIPS Agreement, would be useful.⁴¹

ANALYSIS OF VIEWS EXPRESSED ON MEANS OF IMPLEMENTING PROTECTION

151. Commentators were most concerned with discussion of the means of implementation of protection. The Interim Report put forward three options in this regard:

- (i) Maintenance of the status quo, and reliance on the existing top-level domain, .int, reserved for treaty organizations;
- (ii) Establishment of an exclusion mechanism in some or all of the gTLDs for the names only, or for the names and acronyms, of IGOs; and
- (iii) Modification of the UDRP to extend to the names and acronyms of IGOs.

In relation to the first option, as discussed above, commentators did not favor maintaining the status quo, as the .int domain, while useful, is not considered sufficient to provide the necessary protection for IGOs in the DNS, nor to reflect the existing protection accorded by international law. Comments were divided on the remaining two options.

Exclusion Mechanism

152. The exclusion mechanism has proven a contentious option with respect to the protection of any identifier in the DNS, including the names and acronyms of IGOs. As discussed in relation to the protection of INNs, the Internet community has strong reservations about the efficacy and desirability of blocking or exclusion mechanisms, and the overreaching effect they may have on users' rights. Some commentators were opposed to any protection by way of exclusion of names or acronyms.⁴² Most commentators opposed the implementation of an exclusion mechanism that would automatically block the names, and especially acronyms, of IGOs, without accommodating the existence of legitimate users whose names or acronyms correspond with that of an IGO.⁴³

153. Whereas the full names of IGOs are unlikely, if ever, to be shared in good faith by another entity in the DNS, the situation is not the same with respect to their acronyms. Numerous examples were provided of acronyms that were registered or used by legitimate enterprises, in coincidence with IGOs' names: for example, 'UNO' stands for the United

Nations Organization, but is also ‘one’ in Italian, a Fiat car model and a Swiss card game. ‘ICC’ is both the International Chamber of Commerce and the International Computing Centre. The ‘WHO’ refers to the World Health Organization, a rock group, and the science fiction character Dr. Who. WIPO itself is registered as a United States trademark in respect of tissues for personal and industrial use.⁴⁴ Across the differentiated domain name space, these different entities may coexist: ‘SBA’ is shared by the United States Small Business Association at ‘sba.gov’, the Southern Bakers Association at ‘sba.org’ and the American law firm Smith, Bucklin and Associates at ‘sba.com’.⁴⁵ There exists a German medical company at ‘ilo.com’, as well as a Canadian Internet company at ‘ilos.net’.⁴⁶ An exclusion mechanism that automatically blocked both the names and acronyms of IGOs could jeopardize the existing rights of numerous other users. In this context, it should be noted that the international law protecting the names and acronyms of IGOs is aimed at preventing the registration or use of such identifiers as trademarks, especially in any circumstance where such use could mislead the public as to the source or connection of the user with the IGO. An analogy could usefully be drawn to the DNS, where the objective is not necessarily to deny all uses of acronyms that correspond to IGOs, but to ensure the prohibition of any use that is likely to mislead or otherwise confuse the public.

154. Despite the apparent shortcomings of an exclusion mechanism, many commentators, including IGOs, were in favor of this form of protection, as seemingly the most effective way to recognize the existing legal protection for IGOs in the DNS, without requiring these entities to submit to inappropriate dispute-resolution proceedings.⁴⁷ Some commented that such an exclusion should apply to all gTLDs, while others suggested it should be considered only in relation to each particular gTLD.⁴⁸ For the reasons mentioned above, numerous commentators favored an exclusion of only the exact names of IGOs,⁴⁹ or supported limiting the exclusions to exempt those acronyms that pose no risk of confusion or deception.⁵⁰

Modification of the UDRP

155. The proposal to modify the UDRP to enable the resolution of disputes relating to IGOs’ names and acronyms met with considerable support. Various commentators proposed that such an administrative dispute-resolution mechanism be implemented either as an alternative

or in addition to an exclusion mechanism.⁵¹ Extending the UDRP to protect the identifiers of IGOs would not require the creation of new law, but merely the reflection in the DNS of existing international legal principles for their protection. The key benefit perceived in the UDRP is that it can be used to target only those names and acronyms of IGOs that are used in bad faith, so as to mislead or confuse the public.⁵² Even those commentators in favor of protection for IGOs' names and acronyms noted that, in considering any new measures of protection, adequate consideration needed to be given to the rights of existing, legitimate domain name registrants.⁵³ A minority of comments were in favor of broader protection for IGOs, such that any unauthorized registration and use of the name or acronym of an IGO should be presumed to be misleading and in bad faith.⁵⁴ One commentator proposed a detailed definition of 'bad faith', specifying that the registration of the name or acronym, in whole or in part, must have been unauthorized and intentional, and must be (i) likely to create an impression that the domain name is that of the IGO concerned, or (ii) in relation to a site that contains material or information prejudicial to the interests of the IGO.⁵⁵

156. In opposition to any modification of the UDRP in this context, some commentators stated that the UDRP should apply only to the extent that such names or acronyms of IGOs function as trademarks or service marks.⁵⁶ Others opposed any broadening in the scope of disputes that could be decided under the UDRP, arguing that the UDRP is a relatively new process that should be allowed to develop and stabilize before addressing new categories of disputes.⁵⁷ Still other commentators raised free speech concerns and contended that the names or acronyms of IGOs should be allowed to be registered as domain names if there is no confusing similarity or misleading content on the site.⁵⁸ Finally, there was expressed a general concern with a perceived over-regulation of the DNS and insufficient regard for existing domain name holders' rights, that led some commentators to oppose any new form of protection in the DNS for IGOs' names or acronyms.⁵⁹

157. Any proposal to implement an administrative dispute resolution system for the protection of the names and abbreviations of IGOs would need to take account of the privileges and immunities of the United Nations and Specialized Agencies under international law, as discussed above. For this reason, any direct modification of the UDRP would be untenable. Most international organizations will not readily waive their immunity and would

consider submission to the UDRP as an inappropriate compromise of their privileges and immunities.⁶⁰ In fact, the UN has stated that it will not submit to a dispute resolution process such as the UDRP, which would subject the Organization to the jurisdiction of national courts.⁶¹ It is recalled, in this respect, that the UDRP as it currently applies to trademarks contains a mutual jurisdiction clause that requires complainants to submit to the compulsory jurisdiction of a designated court of law for the purpose of any challenge to the decision of the administrative decision-maker.⁶² Any administrative process to which the IGOs could agree would need to omit such a reference.

RECOMMENDATION

158. The clear majority of commentators favors some form of protection of the names and acronyms of IGOs within the DNS.

159. There is also abundant evidence that abuses of the names and acronyms of IGOs through domain name registrations exist that constitute harmful practices.

160. The protection of the *names* of IGOs raises less complicated and more straightforward questions than the protection of the *acronyms* of IGOs, where necessarily there is far greater scope for the concurrent, good faith use of the same letters as the acronyms of some IGOs in various different contexts and in various different naming systems.

161. There is clearly *an* existing basis in international law for the protection of the names and the acronyms of IGOs, but this basis is not adequate to deal with the whole problem of the bad faith registration and use of the names and acronyms of IGOs as domain names. Commercial malpractice is an important part, but only a part, of the harmful practices associated with the bad faith registration and use of the names and acronyms of IGOs. The registration and use of domain names to create misleading associations with the duly constituted international authorities for public health, labor practices, peace-keeping operations, nuclear test bans, the containment of the proliferation of chemical weapons, trade disciplines, children's rights, refugees, AIDS and so forth is unacceptable, offensive to

numerous public policies established by the international community and conducive to undermining the credibility and reliability of the DNS.

162. The existing situation with respect to the names and acronyms of IGOs in the DNS is unbalanced. Any person, without any qualification whatsoever, may register the name or acronym of an IGO in an unrestricted gTLD. Furthermore, they can do so immediately and at an insignificant cost. In contrast, the potential damage that can be inflicted with the use of such a registration is of a different order. The pursuit of protection against such harm not only is distractful to the central missions of IGOs and wasteful of their limited resources, but also may involve questionably unnecessary deviation from the standard principle of immunity of IGOs from jurisdiction.

163. We recommend that the current unsatisfactory situation be redressed through balanced action on the part of the international community. The choices of instruments for implementing such action are limited and consist principally of the following:

(i) A system of notification by any interested party of the registration as a domain name of the name or acronym of an IGO benefiting from protection under Article 6*ter* of the Paris Convention, the verification of the exact similarity between the name or acronym of the IGO and the domain name by WIPO (as custodian of the authorized list of notifications under Article 6*ter* of the Paris Convention), notification to ICANN or, directly, to the registrar concerned, and the cancellation of the domain name registration. Such a procedure would, however, appear to be unsatisfactory because (a) its automacity may result in the cancellation of good faith domain name registrations, particularly of the acronyms of IGOs which are not misleading; and (b) it is insufficient to deal with misleading, but not exactly similar, domain name registrations.

(ii) An exclusion or blocking mechanism for the names and acronyms of IGOs, which suffers from the same limitations as the notification procedure mentioned in (i), in that it would be apt to prevent a certain class of good faith registrations and insufficient to deal with misleadingly similar registrations.

(iii) A modification of the existing UDRP, specifically designed for the bad faith misuse of the names or acronyms of IGOs through domain name registrations. This option, however, is unacceptable because (a) insofar as ICANN, acting on the basis of recommendations from the Domain Name Supporting Organization (DNSO) or the DNSO Names Council, might be considered to be responsible for the introduction of modifications to the UDRP, it and its subsidiary bodies do not have any constituency pertinent to international intergovernmental organizations; and (b) the UDRP contains within its design an unacceptable deviation from the established principle of immunity of IGOs from the jurisdiction of national courts.

(iv) An administrative procedure, similar to the UDRP, but independently developed and managed within the framework of international administrative tribunals. Such an administrative procedure could be available to any IGO to file a complaint that a domain name registration is the same as or misleadingly similar to the name or acronym of the IGO concerned, has been registered in bad faith without legal justification, and is likely to mislead users into believing that there is an association between the holder of the domain name registration and the IGO in question. Like the UDRP, the remedies that might be awarded by a panel under the special administrative procedure should be limited to cancellation or transfer of the domain name registration and should be implemented through the ICANN system (or ccTLD administrators) within the DNS.

164. It is recommended that the names and acronyms of IGOs benefiting from protection under Article 6ter of the Paris Convention be protected from abusive registrations of domain names within the DNS.

165. It is recommended that this protection be implemented through a special administrative procedure developed and supervised by the constituent members of IGOs, namely, States. The procedure should be available to

qualifying IGOs to file a complaint that a domain name registration is the same as, or misleadingly similar to, the name or acronym of the IGO, that the registration has been made without legal justification, and that the registration is likely to mislead users into believing that there is an association between the holder of the domain name registration and the IGO in question.

166. It is recommended that remedies under the special administrative procedure be limited to the cancellation or transfer of the domain name registration and that the results of the procedure be enforced within the DNS through the ICANN system.

167. It is recommended that the special administrative procedure should apply to domain name registrations in all gTLDs and in all ccTLDs. It is recognized that the enforcement of the results of such a procedure within the ccTLDs would require the cooperation of the corresponding national authorities.

168. It is recognized that the procedure recommended in the preceding paragraphs would involve, at least in cases not involving the use of domain names as trademarks, the creation of new international law. It would represent an extension of the principles in Article 6^{ter} of the Paris Convention, the Trademark Law Treaty and the TRIPS Agreement. While it is believed that such an extension is desirable, it would require a legitimate source in international law. It would be for States to determine the appropriate basis for such an extension of law, either in

the form of a resolution of a competent treaty organ, a memorandum of understanding duly accepted by national authorities or a treaty.

¹ The terms “abbreviation” and “acronym” are used interchangeably in this Chapter. An acronym is defined as “a word formed from the initial letters of other words,” such as “WIPO” for the World Intellectual Property Organization. See Concise Oxford Dictionary (10th ed. 1999). An “abbreviation,” the term used in Article 6*ter* of the Paris Convention, is a more inclusive term, which can refer to an acronym or any other means of abridging a word or series of words, such as “int” for international.

² The protection under Article 6*ter* does not extend to names, abbreviations and other emblems of intergovernmental organizations that are already the subject of international agreements intended to ensure their protection, such as the Geneva Convention (1949) for the amelioration of the condition of the wounded and sick in armed forces, Article 44 of which protects the emblems of the Red Cross, the words “Red Cross” or “Geneva Cross, and analogous emblems.” The object of this exception is to avoid possible overlap with provisions in other conventions that regulate on this subject. See Stephen P. Ladas, *Patents, Trademarks, and Related Rights: National and International Protection*, vol. II, at 1244 (1975); Prof. J.H.C. Bodenhausen, *Guide to the Application of the Paris Convention for the Protection of Industrial Property*, Article 6*ter*, paragraphs (1) and (2), at 97-98 (BIRPI, 1969).

³ See Stephen P. Ladas, *Patents, Trademarks, and Related Rights: National and International Protection*, vol. II, at 1244 (1975).

⁴ Article 16 of the Trademark Law Treaty (TLT) provides: “Any contracting party shall register service marks and apply to such marks the provisions of the Paris Convention which concern trademarks.”

⁵ Article 6*ter* (3)(b). Each State is obligated under Article 6*ter* (1)(3)(a) to “make available to the public the lists so communicated” by WIPO. Any State receiving the communication of a name, emblem or other official sign of an IGO may, within a period of 12 months from the receipt of that communication, transmit its objections, if any, through the intermediary of the International Bureau of WIPO, to the IGO at the request of which the communication was made. (Article 6*ter* (4)).

⁶ Article 6*ter* (3)(b) provides:

“The provisions of subparagraph (b) of paragraph (1) of this Article *shall apply only* to such ... abbreviations, and names of international intergovernmental organizations as the latter have communicated to the countries of the Union through the intermediary of the International Bureau.” (Italics added).

See Bodenhausen, *Guide to the Application of the Paris Convention*, Article 6*ter*, paragraphs (3) and (4), at 100 (“As has already been observed, the protection of emblems, names and abbreviations of *intergovernmental organizations* is *dependent upon their communication*.”). (Italics in original).

⁷ WIPO maintains a list of approximately 1150 signs (consisting of armorial bearings, flags, names, abbreviations and other emblems) that have been communicated by States and IGOs, which have, in turn, been notified to the States party to the Paris Convention.

⁸ See “Report Adopted by the Assembly,” International Union for the Protection of Industrial Property (Paris Union), Nineteenth Session (9th Extraordinary), document P/A/XIX/4, paras. 20-25 (September 29, 1992).

⁹ *Id.*, para. 24.B.

¹⁰ *Id.*

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- ¹¹ By implication, Article *6ter* (1)(a) refers to “use, without authorization by the competent authorities.”
- ¹² Article *6ter* (1)(b).
- ¹³ The European Patent Office noted that the national legal provisions enacting Article *6ter* of the Paris Convention “are sometimes highly divergent in the scope of protection.” See Comment of European Patent Office (EPO) (RFC-2 – December 28, 2000).
TRIPS Agreement, Article 63 (2).
WIPO-WTO Agreement, Article 3.
Paris Convention, Article *6ter* (1)(a).
Paris Convention, Article *6ter* (1)(c).
- ¹⁸ See Comment of Asociación Interamericana de la Propiedad Industrial (ASIFI) (RFC-2 - December 26, 2000).
- ¹⁹ See J. Postel, Request for Comments (RFC) 1591, Network Working Group (March 1994). The six other generic domains are .com, .net, .org, which are unrestricted domains, and .edu, .gov and .mil, which restrict registrations to certain entities, as with .int.
- ²⁰ See “The .int Domain: Current Registration Policies,” at <http://www.iana.org/int-dom/int.htm> (page last updated April 16, 2000).
- ²¹ The IANA site further indicates that “discussions are underway with a number of organizations regarding the future of the .int domain, including a plan of the International Telecommunications Union (ITU) to assume management of the .int domain. *Id.*, referencing the ITU’s plan to assume management of the .int domain, at <http://www.itu.int/net/int>.
- ²² See Comment of Alexander Svensson (RFC-2 - December 21, 2000). See also Comment of Matthias Haeuptli (RFC-1 – September 15, 2000), Comment of J.R. Stogrin (RFC-1 – September 14, 2000), Comment of Christopher Zaborsky (RFC-1 – August 11, 2000).
- ²³ See Comment of Hungary, Hungarian Patent Office (RFC-3 – June 13, 2001), Comment of Mexico, Mexican Institute of Industrial Property (IMPI) (RFC-3 – June 5, 2001), Comment of International Civil Aviation Organization (ICAO) (RFC-3 – June 12, 2001), Comment of United Nations, Office of Legal Affairs, (RFC-3 – June 15, 2001), Comment of Brazilian Association of Intellectual Property (ABPI) (RFC-3 – June 8, 2001), Comment of International Association for the Protection of Industrial Property (AIPPI) (RFC-3 – June 18, 2001), Comment of Law and Technology Committee, Auckland District Law Society (RFC-3 – June 22, 2001).
- ²⁴ IGOs registering in .org include the United Nations Organization, Food and Agriculture Organization, International Civil Aviation Organization, International Maritime Organization, United Nations Economic Social and Cultural Organization, United Nations Development Programme and World Trade Organization. The United Nations High Commissioner for Refugees is registered under the ccTLD for Switzerland, .ch. See also Comment of the International Fund for Agricultural Development (IFAD) (RFC-2 – January 4, 2000), suggesting that IGOs change their domain name registrations from the .org top-level domain to .int, in order to take advantage of this restricted and protected domain space.
- ²⁵ See Comment of United States of America, Office of Advocacy, U.S. Small Business Administration (RFC-3 – June 15, 2001), Comment of European Commission (RFC-3 – June 25, 2001), Comment of International Civil Aviation Organization (ICAO) (RFC-3 – June 12, 2001), Comment of Argentine Chamber of Databases and On Line Services (CABASE) (RFC-3 – June 6, 2001), Comment of Association for Computing Machinery's Internet Governance Project, Electronic Privacy Information Center (RFC-3 – June 15, 2001), Comment of Icanchannel.de (Alexander Svensson) (RFC-3 – June 15, 2001), Comment of Nominet UK (RFC-3 – June 14, 2001), Comment of Chris Brand (RFC-3 – April 16, 2001),

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- Comment of Michael Froomkin (RFC-3 – June 4, 2001), Comment of Christian Mogensen (RFC-3 – April 16, 2001), Comment of Daniel R. Tobias (RFC-3 – April 15, 2001).
- 26 The top-level domain, .org, is a domain space that might especially be prone to risks of misleading domain name registrations corresponding to the names or abbreviations of IGOs, since “org” is intended to be the abbreviation for “organization.”
- 27 See Comment of Hungary, Hungarian Patent Office (RFC-3 – June 13, 2001), Comment of Mexico, National Institute of Copyright (RFC-3 – May 30, 2001), Comment of Mexico, Mexican Institute of Industrial Property (IMPI) (RFC-3 – June 5, 2001), Comment of Switzerland, Swiss Federal Institute of Intellectual Property (RFC-3 – June 15, 2001), Comment of United Nations, Office of Legal Affairs, (RFC-3 – June 15, 2001), Comment of European Commission (RFC-3 – June 25, 2001), Comment of Brazilian Association of Intellectual Property (ABPI) (RFC-3 – June 8, 2001), Comment of European Brands Association (AIM) (RFC-3 – May 16, 2001), Comment of Law and Technology Committee, Auckland District Law Society (RFC-3 – June 22, 2001), Comment of UAEnic (RFC-3 – June 6, 2001). See also Comment of the Brazil Association of Intellectual Property (ABPI) (RFC-2 – January 4, 2001).
- 28 See, for example, Comment of Hungary, Hungarian Patent Office (RFC-3 – June 13, 2001), Comment of Mexico, Mexican Institute of Industrial Property (IMPI) (RFC-3 – June 5, 2001), Comment of International Civil Aviation Organization (ICAO) (RFC-3 – June 12, 2001), Comment of United Nations, Office of Legal Affairs (RFC-3 – June 15, 2001), Comment of Brazilian Association of Intellectual Property (ABPI) (RFC-3 – June 8, 2001), Comment of International Association for the Protection of Industrial Property (AIPPI) (RFC-3 – June 18, 2001), Comment of Law and Technology Committee, Auckland District Law Society (RFC-3 – June 22, 2001).
- 29 See Comment of United Nations, Office of Legal Affairs (RFC-3 – June 15, 2001). See also Comment of European Commission (RFC-3 – June 25, 2001), Comment of International Civil Aviation Organization (ICAO) (RFC-3 – June 12, 2001), Comment of International Labour Office (ILO) (RFC-3 – June 8, 2001), Comment of World Health Organization (WHO) (RFC-3 – June 7, 2001), Comment of European Patent Office (EPO) (RFC-2 – December 28, 2000), Comment of International Organization for Migration (IOM) (RFC-2 – February 1, 2001), Comment of International Monetary Fund (IMF) (RFC-2 – December 28, 2001), Comment of Organization for the Prohibition of Chemical Weapons (OPCW) (RFC-2 – January 17, 2001), Comment of the Preparatory Commission for the Comprehensive Nuclear-Test-Ban Treaty Organization (CTBTO) (RFC-2 – January 17, 2001), Comment of United Nations Framework Convention on Climate Change (UNFCCC) (RFC-2 – January 17, 2001), Comment of World Trade Organization (WTO) (RFC-2 – January 17, 2001).
- 30 See, for example, Comment of International Monetary Fund (IMF) (RFC-2 – December 28, 2001).
- 31 See Comment of International Monetary Fund (IMF) (RFC-2 - December 28, 2000), Comment of The Law Society of Scotland (RFC-2 – January 4, 2001), Comment of Preparatory Commission for the Comprehensive Nuclear-Test-Ban Treaty Organization (CTBTO) (RFC-2 – December 22, 2000), indicating that it is;
“important to have only one, authentic, source of information in the Internet and to prevent the establishment of competing unofficial Internet sites that may contain misleading, inaccurate or prejudicial information, or that may lead the viewer to believe that he or she is using the official web site of the organization.”
- 32 See Comment of the European Commission (RFC-2 – January 16, 2001) (stating that a “consistent system of protection for the names of International Intergovernmental Organizations should be established,” measured by “similar standards” as those under the Paris Convention and TRIPS Agreement), Comment of Republic of Moldova, State Agency on Industrial

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Property Protection of the Republic of Moldova (RFC-2 - December 29, 2000), Comment of the European Patent Office (EPO) (RFC-2 - December 28, 2000), Comment of International Maritime Organization (IMO) (RFC-2 - December 13, 2000), Comment of United Nations Framework Convention on Climate Change (UNFCCC) (RFC-2 - December 7, 2000), Comment of World Health Organization (WHO) (RFC-2 - December 21, 2000), Comment of Asociación Interamericana de la Propiedad Industrial (ASIFI) (RFC-2 - December 26, 2000), Comment of The Association of European Trade Mark Owners (MARQUES) (RFC-2 - December 22, 2000), Comment of European Brands Association (AIM) (RFC-2 - December 20, 2000), indicating for IGOs that the “level of protection on the Internet should be NO LESS than the Paris Convention/TRIPS protection today.” (Emphasis in original), Comment of The Law Society of Scotland (RFC-2 - January 4, 2001). See also Comment of Organization for the Prohibition of Chemical Weapons (OPCW) (RFC-2 - December 28, 2000), Comment of the Preparatory Commission for the Comprehensive Nuclear-Test-Ban Treaty Organization (CTBTO) (RFC-2 - December 22, 2000), Comment of World Trade Organization (WTO) (RFC-2 - December 6, 2000).

³³ See Comment of United Nations, Office of Legal Affairs (RFC-3 - June 15, 2001). See also Comment of Hungary, Hungarian Patent Office (RFC-3 - June 13, 2001).

³⁴ See Comment of World Trade Organization (WTO) (RFC-2 - January 19, 2001).

³⁵ The International Labour Office described the abusive registration by an individual of internationallabour.org, internationallabour.com and internationallabour.net. See Comment of International Labour Office (ILO) (RFC-3 - June 8, 2001). Similarly, the International Monetary Fund indicated that its name and acronym had been registered by third parties in a manner that is misleading fraudulent and abusive. See Comment of International Monetary Fund (IMF) (RFC-2 - December 28, 2000). See also Comment of Preparatory Commission for the Comprehensive Nuclear-Test-Ban Treaty Organization (CTBTO) (RFC-2 - December 22, 2000), Comment of United Nations Framework Convention on Climate Change (UNFCCC) (RFC-2 - December 7, 2000), Comment of World Health Organization (WHO) (RFC-2 - December 21, 2000), Comment of World Trade Organization (WTO) (RFC-2 - December 6, 2000).

³⁶ The Convention on the Privileges and Immunities of the United Nations (adopted by the General Assembly of the United Nations on 13 February 1946) and the Convention on the Privileges and Immunities of the Specialized Agencies (adopted by resolution of the General Assembly on 21 November 1947) provide for the special legal status of the IGOs. They provide that such entities shall have the capacity to, *inter alia*, institute legal proceedings (Article I and Article II respectively) but shall enjoy immunity from every form of legal process, except insofar as the organization expressly waives such immunity (Article II and Article III respectively). The Conventions do require the IGOs to make provisions for “appropriate modes of settlement” of disputes arising out of contracts or disputes of a private law character to which the IGO is a party (Article VIII and Article IX respectively).

³⁷ See, for example, Comment of International Civil Aviation Organization (ICAO) (RFC-3 - June 12, 2001), Comment of International Labour Office (ILO) (RFC-3 - June 8, 2001), Comment of United Nations, Office of Legal Affairs (RFC-3 - June 15, 2001), Comment of Organization for the Prohibition of Chemical Weapons (OPCW) (RFC-2 - December 28, 2000).

³⁸ See Comment of American Intellectual Property Law Association (AIPLA) (RFC-3 - June 7, 2001).

³⁹ See Comment of Hungary, Hungarian Patent Office (RFC-3 - June 13, 2001), Comment of Japan, Ministry of Economy, Trade and Industry (METI) (RFC-3 - July 5, 2001), Comment of Mexico, Mexican Institute of Industrial Property (IMPI) (RFC-3 - June 5, 2001), Comment of European Commission (RFC-3 - June 25, 2001), Comment of United Nations, Office of Legal

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- Affairs (RFC-3 – June 15, 2001), Comment of World Health Organization (WHO) (RFC-3 – June 7, 2001), Comment of Law and Technology Committee, Auckland District Law Society (RFC-3 – June 22, 2001).
- 40 See Comment of European Commission (RFC-3 – June 25, 2001).
- 41 See Comment of International Maritime Organization (IMO) (RFC-2 – December 13, 2000), Comment of Organization for the Prohibition of Chemical Weapons (OPCW) (RFC-2 – December 28, 2000), Comment of Preparatory Commission for the Comprehensive Nuclear-Test-Ban Treaty Organization (CTBTO) (RFC-2 – December 22, 2000), Comment of the United Nations Framework Convention on Climate Change (UNFCCC) (RFC-2 – December 7, 2000), Comment of World Health Organization (WHO) (RFC-2 – December 21, 2000), Comment of Asociación Interamericana de la Propiedad Industrial (ASIPI) (RFC-2 – December 26, 2000), Comment of European Brands Association (AIM) (RFC-2 – December 20, 2000), Comment of Elzaburu (Luis H. De Larramendi) (RFC-1 – September 19, 2000).
- 42 See Comment of Law and Technology Committee, Auckland District Law Society (RFC-3 – June 22, 2001), Comment of Elzaburu (Luis H. De Larramendi) (RFC-3 – June 14, 2001), Comment of Nominet UK (RFC-3 – June 14, 2001).
- 43 See also Comment of the American Intellectual Property Law Association (AIPLA) (RFC-2 - December 29, 2000).
- 44 U.S. Trademark Registration #2209103.
- 45 See Comment of United States of America, Office of Advocacy, U.S. Small Business Administration (Washington consultation – May 29, 2001), Comment of World Health Organization (WHO) (RFC-3 – June 7, 2001), Comment of Argentine Chamber of Databases and On Line Services (CABASE) (RFC-3 – June 6, 2001), Comment of Association for Computing Machinery's Internet Governance Project, Electronic Privacy Information Center (RFC-3 – June 15, 2001), Comment of European Brands Association (AIM) (RFC-3 – May 16, 2001), Comment of *Fédération internationale des conseils en propriété industrielle* (FICPI) (RFC-3 – June 14, 2001), Comment of International Trademark Association (INTA) (RFC-3 – May 24, 2001), Comment of Japan Network Information Centre (JPNIC) (RFC-3 – June 8, 2001), Comment of Christian Mogensen (RFC-3 – April 16, 2001).
- 46 See Comment of International Labour Office (ILO) (RFC-3 – June 8, 2001).
- 47 See Comment of Japan, Ministry of Economy, Trade and Industry (METI) (RFC-3 – July 5, 2001), Comment of Republic of Korea, Korean Intellectual Property Office (KIPO) (RFC-3 – June 7, 2001), Comment of Switzerland, Swiss Federal Institute of Intellectual Property (RFC-3 – June 15, 2001), Comment of European Commission (RFC-3 – June 25, 2001), Comment of International Civil Aviation Organization (ICAO) (RFC-3 – June 12, 2001), Comment of International Labour Office (ILO) (RFC-3 – June 8, 2001), Comment of World Health Organization (WHO) (RFC-3 – June 7, 2001), Comment of Brazilian Association of Intellectual Property (ABPI) (RFC-3 – June 8, 2001), Comment of International Chamber of Commerce (ICC) (RFC-3 – June 18, 2001), Comment of Law and Technology Committee, Auckland District Law Society (RFC-3 – June 22, 2001). See also Comment of Asociación Interamericana de la Propiedad Industrial (ASIPI) (RFC-2 - December 26, 2000), Comment of The Association of European Trade Mark Owners (MARQUES) (RFC-2 - December 22, 2000), Comment of European Brands Association (AIM) (RFC-2 - December 20, 2000), Comment of Cuatrecasas Abogados (RFC-1 – September, 2000), Comment of Elzaburu (Luis H. de Larramendi) (RFC-1 – September 19, 2000).
- 48 See Comment of the European Patent Office (EPO) (RFC-2 - December 28, 2000), Comment of Organization for the Prohibition of Chemical Weapons (OPCW) (RFC-2 – December 28, 2000), Comment of Preparatory Commission for the Comprehensive Nuclear-Test-Ban Treaty Organization (CTBTO) (RFC-2 – December 22, 2000), Comment of World Health Organization

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- (WHO) (RFC-2 – December 21, 2000), Comment of Asociación Interamericana de la Propiedad Industrial (ASIFI) (RFC-2 - December 26, 2000), Comment of The Association of European Trade Mark Owners (MARQUES) (RFC-2 - December 22, 2000); *cf.* Comment of International Maritime Organization (IMO) (RFC-2 – December 13, 2000), Comment of J. R. Stogrum (RFC-1 – September 14, 2000).
- ⁴⁹ See Comment of Asociación Interamericana de la Propiedad Industrial (ASIFI) (RFC-2 - December 26, 2000).
- ⁵⁰ See Comment of International Labour Office (ILO) (RFC-3 – June 8, 2001), Comment of American Intellectual Property Law Association (AIPLA) (RFC-3 – June 7, 2001).
- ⁵¹ See Comment of the European Commission (RFC-2 – January 16, 2001), Comment of Preparatory Commission for the Comprehensive Nuclear-Test-Ban Treaty Organization (CTBTO) (RFC-2 – December 22, 2000), Comment of the United Nations Framework Convention on Climate Change (UNFCCC) (RFC-2 – December 7, 2000), Comment of World Health Organization (WHO) (RFC-2 – December 21, 2000), Comment of the Comment of Asociación Interamericana de la Propiedad Industrial (ASIFI) (RFC-2 - December 26, 2000), Comment of European Brands Association (AIM) (RFC-2 - December 20, 2000), Comment of British Telecommunications, Plc. (RFC-2 - December 19, 2000), Comment of Elzaburu (Luis H. De Larramendi) (RFC-1 – September 19, 2000).
- ⁵² See Comment of Japan, Ministry of Economy, Trade and Industry (METI) (RFC-3 – July 5, 2001), Comment of Switzerland, Swiss Federal Institute of Intellectual Property (RFC-3 – June 15, 2001).
- ⁵³ See Comment of American Intellectual Property Law Association (AIPLA) (RFC-3 – June 7, 2001), Comment of Brazilian Association of Intellectual Property (ABPI) (RFC-3 – June 8, 2001). See also Comment of International Maritime Organization (IMO) (RFC-2 – December 13, 2000), Comment of Organization for the Prohibition of Chemical Weapons (OPCW) (RFC-2 – December 28, 2000).
- ⁵⁴ See Comment of Asociación Interamericana de la Propiedad Industrial (ASIFI) (RFC-2 – December 26, 2000), Comment of European Brands Association (AIM) (RFC-2 – December 20, 2000), Comment of British Telecommunications, Plc. (RFC-2 – December 19, 2000).
- ⁵⁵ See Comment of the Preparatory Commission for the Comprehensive Nuclear-Test-Ban Treaty Organization (CTBTO) (RFC-2 – December 22, 2000). See also Comment of World Health Organization (WHO) (RFC-2 – December 21, 2000), providing that the challenge should be allowed if the acronym of the IGO was in use *before* the domain name registration and there is a risk of confusion as to the identity of the domain name holder or the registration or use is otherwise in bad faith.
- ⁵⁶ See Comment of United Kingdom, The Patent Office (RFC-3 - June 1, 2001), Comment of American Intellectual Property Law Association (AIPLA) (RFC-3 – June 7, 2001). See also Comment of the American Intellectual Property Law Association (AIPLA) (RFC-2 – December 29, 2000), Comment of International Trademark Association (INTA) (RFC-2 – January 4, 2001).
- ⁵⁷ See Comment of Fédération internationale des conseils en propriété industrielle (FICPI) (RFC-2 – December 29, 2000), Comment of International Trademark Association (INTA) (RFC-2 – January 4, 2001), Comment of United States Council for International Business (USCIB) (RFC-2 – December 29, 2000), Comment of Verizon (RFC-2 – December 26, 2000).
- ⁵⁸ See Comment of Christopher Zaborsky (RFC-1 – August 11, 2000), Comment of Ashutosh C. Pradham (RFC-2 - December 16, 2000).
- ⁵⁹ See Comment of Association for Computing Machinery's Internet Governance Project (RFC-3 – June 15, 2001), Comment of Alexander Svensson (RFC-2 – December 21, 2000), Comment of PTI Networks, Inc. (Frank Schilling) (RFC-1 – August 13, 2000), Comment of

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VerandaGlobal.com, Inc. (William Blackwood) (RFC-1 – August 15, 2000), Comment of Solid State Design, Inc. (Charles Linart) (RFC-1 – August 15, 2000), Comment of harrycanada (RFC-1 – August 14, 2000), Comment of Garry Anderson (RFC-1 – August 12, 2000), Comment of Mark Moshkowitz (RFC-1 – August 12, 2000), Comment of Daniel Deephanphongs (RFC-1 – August 12, 2000).

⁶⁰ See, for example, Comment of International Civil Aviation Organization (ICAO) (RFC-3 – June 12, 2001), Comment of International Labour Office (ILO) (RFC-3 – June 8, 2001), Comment of United Nations, Office of Legal Affairs (RFC-3 – June 15, 2001), Comment of Organization for the Prohibition of Chemical Weapons (OPCW) (RFC-2 – December 28, 2000).

⁶¹ See Comment of United Nations, Office of Legal Affairs (RFC-3 – June 15, 2001).

⁶² The UDRP Rules, paragraph 3 (xiii), provide that the complaint shall:

“State that Complainant will submit, with respect to any challenges to a decision in the administrative proceeding canceling or transferring the domain name, to the jurisdiction of the courts in at least one specified Mutual Jurisdiction.”

See <http://www.icann.org/udrp/udrp-rules-24oct99.htm#3bxiii>

5. PERSONAL NAMES

169. Identity is a fundamental attribute of “the inherent dignity of the human person.”¹ Many things are important in constituting a person’s identity. The personal name is foremost amongst them and assists in creating distinctiveness or individuality, as well as serves as a succinct symbol pregnant with the associations that others have with that person. The importance of personal names to dignity is evident from the dark days of totalitarianism and nazism, when names were only numbers.

170. It has been often pointed out that the power and ubiquity of the technologies of communication and telecommunication have created greater opportunity for invasion of personal space and the use of attributes of personal identity in ways which are not approved by the person concerned. At the same time, these technologies have, in enhancing the visibility of public figures and leading business, sports and entertainment personalities, established the celebrity as a mundane feature of society.

171. The personal name is a difficult subject to treat. There is considerable diversity around the world in the way in which it is formulated and presented. These formulations and presentations (for example, which name, family or given, comes first, or whether the name consists of these two elements at all) are usually the result of the historical and cultural traditions of particular societies. Many sensitivities, including religious, political, historical, cultural and psychological, are touched by the subject of personal names.

THE LEGAL PROTECTION ACCORDED TO PERSONAL NAMES

172. Personal names are rarely protected *as such* by the law. Their protection is usually a part of a broader legal principle or policy of which the misuse of personal names constitutes only one means of violation. Other means of violation include misuse of a person’s likeness, image or voice.

173. Because of the diversity of interests affected by the treatment of personal names, the legal principles and policies that can be deployed to protect personal names are similarly diverse and vary, as might be expected, from country to country. These legal principles and policies include the right to publicity or the right to control the commercial use of one's identity, recognized in many States of the United States of America; the tort of unfair competition; the tort of passing-off (conceptually treated, in many cases, as part of the law of unfair competition), recognized generally in common-law countries; and the right to privacy.

174. It has not been possible to review in detail all the legal principles and policies that can be used for the protection of personal names in all of the countries of the world. Nevertheless, it is possible to identify two main interests that underlie particular approaches adopted in a number of countries to the protection of personal names against misuse:

(i) A commonly expressed public policy for the protection of personal names against misuse is economic. This economic policy, in turn, has two bases. The first of those bases is the prevention of unjust enrichment through the unauthorized commercial use of another's identity. As stated by Kalven and quoted by the Supreme Court of the United States of America, "The rationale for [protecting the right of publicity] is the straight-forward one of preventing unjust enrichment by the theft of good will. No social purpose is served by having the defendant get free some aspect of the plaintiff that would have market value and for which he would normally pay."² The second basis of the economic interest underlying the protection of personal names against misuse is the prevention of deception and confusion on the part of consumers.

(ii) A social interest is also expressed as underlying legal principles protecting personal names against misuse. This interest is apparent in the right to privacy, or the qualified right to control exposure of oneself, where personal distress and anxiety are recognized as valid reasons to accord protection.

In a number of cases, both the economic and the social interests are recognized in the protection that law accords. Thus, in Switzerland, Article 29.2 of the Civil Code states that "Where a person assumes the name of another to the latter's prejudice, the latter can apply for

an injunction to restrain the continuation of this assumption, and can in addition claim damages if the act is proved to be wrongful, and moral compensation if this is justified by the nature of the wrong suffered.” And in Spain, Section 7.6 of the Law of May 5, 1982,³ provides that the unpermitted use of one’s name, voice or likeness for *advertising or trade* purposes is an invasion of one’s *personal* life.

175. The notoriety that attaches to certain persons can, in some countries, establish a basis for protection which is not available to ordinary persons.⁴ In other instances, notoriety can be a factor which can influence the extent of damages granted as a result of the wrongful use of the person’s name, rather than a ground for establishing a separate form of protection from that available to non-famous persons.

176. In commerce, the protection that is recognized for personal names and other attributes of the personality is usually exploited through the vehicle of contract. Thus, by permitting, under contract (or license), another to use a person’s name in association with products or services, the personal name becomes an asset.

177. The status of the personal name as a potential asset may be secured through the registration of a trademark (or service mark). Most national laws, and the Agreement on Trade-Related Aspects of Intellectual Property Rights (the TRIPS Agreement),⁵ explicitly recognize that personal names are eligible for registration as trademarks. While personal names are eligible for registration as trademarks, however, like any sign for which trademark registration is sought, they must be distinctive in order to be valid trademarks.

Distinctiveness can be inherent, or can be acquired through use which causes consumers to identify the name with a particular source of goods or services.

178. While there are, as indicated in the preceding paragraphs, several different legal doctrines that apply on a widespread basis at the national level to protect personal names against misuse, there is no specific norm established at the international level for the protection of personal names. The absence of any such norm reflects the fact that there is a diversity of legal approaches to the protection of personal names at the national level.

PROTECTION OF PERSONAL NAMES UNDER THE UDRP

179. As mentioned above, personal names may, in appropriate circumstances, be registered as trademarks and, in practice, many are. The protection of personal names as trademarks has provided a basis for the application of the Uniform Domain Name Dispute Resolution Policy (UDRP) to the protection of personal names against deliberate, bad faith registration as domain names in the gTLDs. While a few oppose this application of the UDRP,⁶ the clear weight of authority of many decisions is in favor of the application of the UDRP to the protection of personal names when they constitute trademarks. The present section of this Chapter outlines the main trends in this authority. Annex VI to this Report contains an indicative list of UDRP cases involving personal names that have been filed with the WIPO Arbitration and Mediation Center.

180. It is recalled that the UDRP provides that three conditions must be satisfied in order to establish that a domain name registration is abusive and that the complainant is entitled to relief:

- (i) the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights;
- (ii) the registrant of the domain name has no rights or legitimate interests in respect of the domain name; and
- (iii) the domain name has been registered and is being used in bad faith.⁷

The application of each of these conditions in the context of the protection of personal names is described in the ensuing paragraphs.

Trademark or Service Mark Rights

181. The first condition requires that in each case the complainant must demonstrate that the personal name in question is protected as a trademark or service mark, in which that complainant has rights.

182. There have been a number of cases in which a complainant has demonstrated that it meets this requirement by submitting evidence that the personal name in question is registered as a trademark.⁸ The UDRP, however, does not require that a complainant must hold rights specifically in a *registered* trademark or service mark. Instead, it provides only that there must be “a trademark or service mark in which the complainant has *rights*,” without specifying how these rights are acquired.⁹ With this distinction in mind, many decisions under the UDRP have therefore determined that common law or unregistered trademark rights may be asserted by a complainant and will satisfy the first condition of the UDRP.¹⁰ In relation to personal names, in particular, numerous UDRP decisions have relied upon a complainant’s demonstration that it holds such common law rights in the disputed name.¹¹ In making these decisions, panels have given attention to a number of factors, including: (i) the distinctive character or notoriety of the name and the requirement that the domain name must be “identical or confusingly similar” to it, (ii) the relationship between this distinctive character and use of the name in connection with goods or services in commerce, and (iii) the location of the parties and the bearing that this may have on the acquisition of unregistered trademark rights.

183. Regarding the distinctiveness of the name, panels have emphasized in many cases that the particular complainant’s personal name, in the relevant field of commerce, enjoys widespread notoriety and fame.¹² “A claim based on an unregistered mark, including a personal name, requires that the claimant establish the distinctive character of the mark or name on which the claim is based.”¹³ Panels have also focused this analysis of distinctive character in relation to the second element mentioned above, “whether or not the person in question is sufficiently famous in connection with the services offered by that complainant” in commerce.¹⁴ Using a personal name in association with certain goods or services can create distinctiveness and a secondary meaning in the name. With respect to similarity between the

personal name in which trademark rights are held and the domain name registration, panels have found that small variations between the two (e.g., such as removing the space between the first and last names), just as in cases involving words or terms other than personal names, are legally insignificant, so long as the registered domain name is “confusingly similar” to the personal name.¹⁵

184. The location of the parties can be significant for determining whether the complainant has trademark rights.¹⁶ Rule 15(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules of Procedure”) provides that the panel shall decide a complaint on the basis, *inter alia*, of “...any rules and principles of law that it deems applicable.” The applicable law will depend on the facts of the case, including the location of the parties. This Rule has allowed panels the flexibility to deal with disputes between parties with different national affiliations and concerning activity on a global medium. It is also a feature that has enabled complainants to seek protection for their names under trademark law, although they have not registered their names as a trademark or service mark in every country of the world.

The Registrant Has No Rights or Legitimate Interests in the Domain Name

185. The second condition of the UDRP requires that there be no evidence that the domain name registrant has any rights or legitimate interests in the domain name that it has registered. Panels normally review the full record in a case to assess whether a respondent has any rights or interests in the domain name. Based on the distinctiveness of the personal name in question and certain facts indicating that (i) the domain name does not correspond to the respondent’s own name, and (ii) the respondent has registered the names of many other celebrities, this determination in a number of cases has been almost self-evident¹⁷. In other cases, however, a more probing analysis has been called for. For example, the panel in one case found that, while the respondent’s use of the name in question, “sting,” as a nickname on the Internet was *not* substantial enough to show any rights or legitimate interests in the domain name *sting.com*, the respondent’s proven use was in fact relevant to the separate issue of bad faith. In another case, the panel disagreed with the respondent’s argument that the domain name in question, *sade.com*, was being offered merely as a legitimate email service. Instead, the panel found that, by placing the domain name in the music section of its web site

and having registered it under the contact, “The Sade Internet Fan Club,” the respondent “has set out to deliberately associate this service with the Complainant.”¹⁸ In a further case, the panel acknowledged that the respondent’s contention was a serious one and that use of the domain name in question, *montyroberts.net*, was for legitimate non-commercial or fair use purposes.¹⁹ In balancing the rights of the complainant in its mark and the rights of the respondent to freely express its views about the complainant, however, the panel determined that:

“the rights to express one’s views is not the same as the right to use another’s name to identify one’s self as the source of those views. One may be perfectly free to express his or her views about the quality or characteristics of the reporting of the New York Times or Time Magazine. That does not, however, translate into a right to identify one’s self as the New York Times or Time Magazine.”²⁰

186. The panel found that, while the respondent’s primary motive for establishing the web site might have been to criticize the complainant, this did “not insulate Respondent from the fact that it is directly and indirectly offering products for sale on its website, or at websites hyperlinked to its site.”²¹

The Domain Name Has Been Registered and Is Being Used in Bad Faith

187. The third condition that must be satisfied is evidence of bad faith. The UDRP sets forth four non-exhaustive examples of what may be considered “evidence of the registration and use of a domain name in bad faith.”²² A review of the decisions concerning personal names indicates that each of these circumstances has been relied upon in one or more cases to support a determination that the registration and use of the domain name in dispute was in bad faith. Given the distinctive character of a number of the names in question and a consideration of other relevant facts, an underlying and consistent perception has been that the respondent, through the domain name registration, has clearly targeted the complainant’s unique personal or professional name.²³ Panels, however, have exercised caution in confirming that such parasitic practices relate to one of the illustrative bad faith factors listed in the UDRP or to a similar bad faith *commercial* exploitation of the complainant’s name.

Thus, in one case the panel ruled that, where the domain name was identical to the complainant's professional name but was connected to a *non-commercial* web site expressing criticism of the complainant (operated by a brother-in-law), the case involved alleged defamation and not infringement of a trademark right.²⁴ Defamation, which goes to the reputation of an individual, does not have any necessary relationship to the commercial and infringing exploitation of a personal name used as a mark.

188. The UDRP has proven to be a useful tool for giving expression to the protection of personal names where trademark rights exist in those personal names, where the domain name holder has no right or legitimate interest and where there is evidence of bad faith in the registration and use of the domain name. However, it by no means affords comprehensive protection to personal names. For a start, the names of many persons, particularly ordinary persons, may have no distinctiveness attached to them, either inherently or as a result of use. Secondly, the names of political figures, religious leaders, scientists and historical persons may never have been used in commerce and, thus, are unlikely to have trademarks associated with them. Nevertheless, many sensitivities may attach to their use.

ANALYSIS OF COMMENTS AND VIEWS EXPRESSED IN RESPONSE TO THE INTERIM REPORT

189. The Interim Report formulated three options with respect to the protection of personal names in the DNS and sought further comment on them. These options were:

(i) The scope of the UDRP should not be broadened to cover personal names beyond those which are already protected under the current UDRP as trade or service marks.

(ii) The scope of the UDRP should be amended to encompass a new and narrow category of claims brought on the basis of a personality right in order to offer additional protection for personal names which do not qualify as trade or service marks under the current UDRP.

(iii) The amended UDRP, as proposed in (ii) above, should be introduced only in the forthcoming new gTLD .name, which is intended to serve individuals and allow them to create their own global digital identity.²⁵

190. Since the publication of the Interim Report, the registry of .name has developed an extensive rights protection scheme, including dispute resolution, the essential characteristics of which are reflected in the Appendices to the Registry Agreement which it has entered into with ICANN.²⁶ Although the procedural and operational details of this scheme remain to be clarified at the time of the publication of this Report, it would appear from those Appendices that the .name protection mechanisms at least are intended to achieve the principal policy objectives underlying the third option proposed in the Interim Report. While only practical experience will demonstrate the effectiveness of those mechanisms, their application in .name will practically implement the third option mentioned above. The comments received on it in response to the Interim Report will not therefore be considered below.

191. The comments received were divided on whether the scope of the UDRP should be broadened to cover personal names that do not qualify as trade or service marks. While a significant number of commentators favored broadening the scope of the UDRP for purposes of protecting personal names,²⁷ the majority believed that the protection offered by the UDRP in its present form is sufficient and that it should not be expanded to cover personality rights at this time.²⁸

192. Those who favor the inclusion of a form of personality right as a basis for formulating a complaint under the UDRP advance essentially two arguments in support of their position. First, they argue that, while the victims of abusive domain name registrations of personal names generally are famous persons, their celebrity status does not necessarily derive from any commercial activity.²⁹ According to these commentators, there is no valid reason why famous persons whose reputation results from non-commercial activities, and who therefore would not normally qualify for protection under the current UDRP as holders of trade or service marks, should remain unprotected. They conclude that the UDRP should be amended in order to close what they perceive to be an unwarranted gap in the scope of protection that it offers to well-known individuals.

193. A second argument advanced in support of broadening the scope of the UDRP finds its origin in the discrepancies that exist between national laws of countries relating to unregistered trade or service marks. As is apparent from a review of the case law under the UDRP, many celebrities have not registered their personal names as marks, but have been found by panelists to be owners of unregistered marks, which equally qualify for protection under the UDRP. However, not all countries in the world offer protection to unregistered marks. Persons whose activities, even though clearly commercial in nature, are restricted to countries which protect only registered marks (e.g., China, France or Switzerland, amongst others), and who have not obtained any mark registrations corresponding to their personal names in those countries, would normally not benefit from the UDRP's protection. According to certain commentators, this reveals a bias, built into the UDRP, favoring parties from countries with legal systems protecting unregistered marks, typically (but not exclusively) countries with a common-law tradition. They argue that introducing the personality right as an additional basis for formulating a complaint under the UDRP would be an appropriate and reasonable means of rectifying what they perceive to be a form of discrimination between legal systems which has crept into the current procedure.³⁰

194. Those who favor broadening the scope of the UDRP to some form of personality right generally agree that protection should nonetheless be limited to abusive behavior on the part of registrants.³¹ Certain of these commentators believe that protection should be offered not only in relation to official personal names, but also to pseudonyms of famous persons (for instance, Kirk Douglas being the pseudonym of Issur Danielovitch Demsky).³²

195. Commentators who are opposed to broadening the scope of the UDRP to cover personality rights set out various reasons for their reluctance in this regard. Most importantly, they point out that there currently exist no internationally harmonized norms covering personality rights as such. While various forms of personality rights are recognized and protected in many jurisdictions throughout the world, this is achieved by relying on differing legal foundations, including common law principles, civil law provisions, statutory rights of publicity, privacy law and criminal law. In light of these various approaches to the problem, the nature and scope of protection granted to what is conveniently referred to as “the

personality right” varies from one jurisdiction to another. Commentators who resist expanding the scope of the UDRP to personality rights believe that any attempts to create additional protection under these circumstances will have substantial negative effects. They claim that panelists, faced with a void of harmonized international rules, will be tempted to create new law offering greater protection to personality rights through the UDRP than that which is currently available under national laws. They warn that the UDRP thus would run the risk of developing into an illegitimate source of new and undesired regulation in the personality right arena. Furthermore, they believe that, in light of discrepancies between national laws, decisions granted under the UDRP would often be perceived as unfair, contested and ultimately invalidated at the national level. According to these commentators, this would be detrimental to the long-term credibility and viability of the UDRP as a consensus-based dispute resolution mechanism.³³

196. Most other arguments advanced against including some form of personality right as a basis for a complaint under the UDRP directly or indirectly flow from the fundamental difficulty set out in the previous paragraph. These arguments often are based on concerns that protecting personality rights under the UDRP would have a chilling effect on free speech and would unlawfully restrict the availability of names in the DNS.³⁴ Furthermore, several commentators state that it would be exceedingly difficult to devise a uniform standard for determining who is sufficiently famous to benefit from protection and who is not,³⁵ although other commentators argue that, to the extent the system would focus on abusive behavior, there would not be a need to limit the protection it offers to famous persons.³⁶ Still others argue that it would be wholly inappropriate to expand the scope of the UDRP, be it the area of personality rights or in any other area, precisely at the time when preparations are being made to evaluate its operation.³⁷

197. Finally, those opposed to the expansion of the UDRP also argue that, as a practical matter, most persons whose personal names run the risk of being cybersquatted derive their celebrity status from commercial activities and therefore can claim the existence of at least an unregistered mark to benefit from the UDRP’s protection. In other words, incorporating a personality right into the UDRP, according to this view, would introduce a host of complications for parties, ICANN, dispute resolution providers, and all others involved in the

procedure which are unlikely to be in proportion to the magnitude of the problem that is to be addressed.

198. A few commentators have suggested that, if additional protection for personal names is to be incorporated into the UDRP, it should in any event be more narrowly drafted than the proposal reflected in the second option of the Interim Report. These commentators refer to a provision of the United States Anticybersquatting Consumer Protection Act, passed into law in November 1999, as a possible model in this connection.³⁸ The provision in question provides for a cause of action against “[a]ny person who registers a domain name that consists of the name of another living person, or a name substantially and confusingly similar thereto, without that person’s consent, with the specific intent to profit from such name by selling the domain name for financial gain to that person or any third party...”.³⁹

RECOMMENDATION

199. It is clear that many sensitivities are offended by the unauthorized registration of personal names as domain names. It is clear also that UDRP does not provide solace for all those offended sensitivities, nor was it intended to do so, as originally designed. The result is that there are some perceived injustices. Persons who have gained eminence and respect, but who have not profited from their reputation in commerce, may not avail themselves of the UDRP to protect their personal names against parasitic registrations. The UDRP is thus perceived by some as implementing an excessively materialistic conception of contribution to society. Furthermore, persons whose names have become distinctive in countries that do not recognize unregistered trademark rights are unlikely to find consolation in the UDRP in respect of bad faith registration and use of their personal names as domain names in those countries.

200. Nevertheless, we believe that the views expressed by the majority of commentators against the modification of the UDRP to meet these perceived injustices are convincing at this stage of the evolution of the DNS and the UDRP.

201. The most cogent of the arguments against modification of the UDRP is, we believe, the lack of an international norm protecting personal names and the consequent diversity of legal approaches deployed to protect personal names at the national level. We consider that this diversity would place parties and panelists in an international procedure in an untenable position and would jeopardize the credibility and efficiency of the UDRP.

202. It is recommended that no modification be made to the UDRP to accommodate broader protection for personal names than that which currently exists in the UDRP.

203. In making this recommendation, we are conscious of the strength of feeling that the unauthorized, bad faith registration and use of personal names as domain names engenders. We believe, however, that the most appropriate way in which the strength of this feeling should be expressed is through the development of international norms that can provide clear guidance on the intentions and will of the international community.

204. Insofar as ccTLDs are concerned, the lack of international norms is less significant. Clear law at the national level for the protection of personal names against abusive domain name registrations, if it exists, can be applied to registrations in the corresponding ccTLD.

¹ International Covenant on Civil and Political Rights, Article 10.1.

² Kalven, “Privacy in Tort Law—Were Warren and Brandeis Wrong?” (1966) 61 *Law and Contemporary Problems* 326, 331, quoted in *Zacchini v. Scripps-Howard Broadcasting Company* 433 U.S. 562, at 576 (1976).

³ Ley Organica de 5 de mayo de 1982, “Derecho al honor, a la intimidad personal y familiar, y a la propia imagen.”

⁴ For example, in Japan, on the basis of Article 709 of the Civil Code.

⁵ See Article 15(1).

⁶ See Comment of Michael Froomkin (RFC3 – June 4, 2001).

⁷ See UDRP, para. 4(a).

⁸ See e.g., *Harrods Ltd. v. Robert Boyd*, WIPO Case D2000-0060 (March 16, 2000) (the domain name *dodialfayed.com* was determined to be registered and used in bad faith, as it was confusingly similar to the personal name, “Dodi Fayed,” which had been registered as a European Community Trademark); *Madonna Ciccone, p/k/a Madonna v. Dan Parisi and “Madonna.com”*, WIPO Case D2000-0847 (October 12, 2000) (the domain name was held to have been registered and used in bad faith and was identical or confusingly similar to the personal name, Madonna, for which the Complainant held a United States Trademark

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Registration); *Drs Foster & Smith, Inc. v. Jaspreet Lalli*, NAF FA0007000095284 (August 21, 2000) (same); *Helen Fielding v. Anthony Corbet a/k/a Anthony Corbett*, WIPO Case D2000-1000 (Sept. 25, 2000) (Complainant had registered trademark in fictional character “Bridget Jones”); *Alain Delon Diffusion S.A. v. Unimetal Sanayi ve Tic A.S.*, WIPO Case D2000-0989 (October 26, 2000) (the domain name *alaindelon.com* was held to have been registered and used in bad faith and was identical to the personal name, Alain Delon, for which the Complainant held International Trademark Registration); *Laurence Fontaine v. Visiotex S.A.*, WIPO Case D2001-0071 (March 26, 2001) (the Panelist found that the domain name *lauresainclair.com* was confusingly similar to the personal name of Complainant which had registered as a trademark LAURE SAINCLAIR); *Isabel Preysler Arrastia v. Ediciones Delfin, S.L.*, WIPO Case D2001-0298 (May 31, 2001) (Panel found that the domain name *preysler.com* was confusingly similar to the personal name, Isabel Preysler, for which Complainant held a Spanish Trademark Registration).

⁹ See J. T. McCarthy, *McCarthy on Trademarks and Unfair Competition*, Vol. 4, ch. 25, §25:74.2 (2000), indicating that “the reference to a trademark or service mark ‘in which the complainant has rights’ means that ownership of a *registered* mark is not required – unregistered or common law trademark or service mark rights will suffice” to support a complaint under the UDRP. (Emphasis in original).

¹⁰ One of the earliest decisions to rely on unregistered rights in a trademark was handed down in the consolidated cases of *Bennett Coleman & Co. v. Steven S. Lalwani*, WIPO Cases D2000-0014 and D2000-0015 (March 11, 2000). The cases involved a Complainant located in India and a respondent located in the United States of America. The Respondent challenged that there were no trademark registrations for the relevant words in the domain names, *theeconomictimes.com* and *thetimesofindia.com*, in the United States and that, in any event, any trademark registrations in India had expired. The Panelist, Professor W.R. Cornish, found first that, given the Internet provides worldwide access, the assessment of the propriety of a domain name registration cannot be confined only to comparisons with trademark registrations and other rights in the country where the web site may be hosted. Secondly, the Panelist relied on the “reputation from actual use” of the words in question to determine that, whether or not the Indian trademarks were registered, the Complainant had trademark rights.

¹¹ See e.g., *Julia Fiona Roberts v. Russell Boyd*, WIPO Case D2000-0210 (May 29, 2000) (holding that the Complainant has common law trademark rights in her name: “The Policy does not require that the Complainant should have rights in a registered trademark or service mark. It is sufficient that the Complainant should satisfy the Administrative Panel that she has rights in common law trademark or sufficient rights to ground action for passing off”); *Jeanette Winterson v. Mark Hogarth*, WIPO Case D2000-0235 (May 22, 2000) (Panel held that Complainant has trademark rights in the mark JEANETTE WINTERSON, emphasizing that paragraph 4(a)(i) of the UDRP “refers to **rights** not registered trademark rights of a third party”); *Mick Jagger v. Denny Hammerton*, NAF Case FA0007000095261 (September 11, 2000) (“Complainant held a common law trademark in his famous name, “Mick Jagger,” even without registration at the United States Patent and Trademark Office.”); *Helen Folsade Adu p/k/a Sade v. Quantum Computer Services, Inc.*, WIPO Case D2000-0794 (September 26, 2000) (Panel held that Complainant has established common law trademark and service mark rights in the word “SADE,” which has been used in connection with sales of records, CDs, CD-ROMS, tickets for concerts and merchandising in many jurisdictions around the world); *CMG Worldwide, Inc. v. Naughtya Page*, NAF Case FA0009000095641 (November 8, 2000) (Diana, Princess of Wales, before her death had common law trademark rights in her name); *Cho Yong Pil v. ImageLand, Inc.*, WIPO Case D2000-0229 (May 10, 2000) (Complainant demonstrated that the fame in his name, as a famous Korean pop music artist for 30 years, was sufficient to

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give him trademark or service mark rights for the purpose of the rules); *Rosa Montero Gallo v. Galileo Asesores S.L.*, WIPO Case D2001-1649 (January 27, 2001) (Panel found that Complainant was sufficiently famous in association with the services offered in connection with Complainant's personal name to establish the requisite common law trademark right); *José Luis Sampedro Sáez v. Galileo Asesores S.L.*, WIPO Case D2000-1650 (January 27, 2001) (same); *Lorenzo Silva Amador v. Galileo Asesores S.L.*, WIPO Case D2000-1697 (January 27, 2001) (same); *Julian Barnes v. Old Barn Studios Limited*, WIPO Case D2001-0121 (March 26, 2001) (Panel found that Complainant has common law trademark holding that "Complainant has established that he uses his name in the creation and promotion of his work from which he makes his living. His name identifies his work. His work is ordered and called for under and by reference to his name."); *Louis De Bernieres v. Old Barn Studios Limited*, WIPO Case D2001-0122 (March 26, 2001) (same); *Anthony Beevor v. Old Barn Studios Limited*, WIPO Case D2001-0123 (March 26, 2001) (same); *Margaret Drabble v. Old Barn Studios Limited*, WIPO Case D2001-0209 (March 26, 2001) (same); *George-Marie Glover and George-Marie Glover, LLC v. Cherie Pogue*, WIPO Case D2001-0600 (June 11, 2001) (Panel held that Complainant has common law trademark in the name "George-Marie" which has been used in connection with complainant's artistic services for 15 years); See also Report of first WIPO Process, paras. 149-50, at 42-43 (allow "consideration of all legitimate rights and interests of the parties (which are not necessarily reflected in a trademark certificate)").

¹² See e.g., *Julia Fiona Roberts v. Russell Boyd*, WIPO Case D2000-0210 (May 29, 2000) (the complainant "is a famous motion picture actress"); *Jeanette Winterson v. Mark Hogarth*, WIPO Case D2000-0235 (May 22, 2000) (Complainant is an author who has "achieved international recognition and critical acclaim," writing books and screen plays that have been published in over 21 countries in 18 languages); *Mick Jagger v. Denny Hammerton*, NAF Case FA0007000095261 (September 11, 2000) (Complainant has a "famous personal name, 'Mick Jagger,"); *Helen Folsade Adu p/k/a Sade v. Quantum Computer Services, Inc.*, WIPO Case D2000-0794 (September 26, 2000) (Complainant is a world famous singer, songwriter and recording artist known under the stage name "SADE"); *Isabelle Adjani v. Second Orbit Communications, Inc.*, WIPO Case D2000-0867 (October 4, 2000) (Panel notes that Complainant has achieved "international recognition and acclaim" as a well-known film actress using her real name, Isabelle Adjani); *CMG Worldwide, Inc. v. Naughty Page*, NAF Case FA0009000095641 (Nov. 8, 2000) (finding that, in relation to the domain names *princessdi.com* and *princessdiana.com*, that Princess Diana, during her life time, was well known as Princess Diana or Princess Di); but cf., *Gordon Sumner, p/k/a Sting v. Michael Urvan*, WIPO Case D2000-0596 (July 20, 2000) (held that the personal name Sting was not distinctive, as it "is also a common word in the English language, with a number of different meanings"); *Alain Delon Diffusion S.A. v. Unimetal Sanayi ve Tic A.S.*, WIPO Case D2000-0989 (October 26, 2000) ("the Panel is satisfied that the ALAIN DELON name and mark is well-known internationally").

¹³ See *Monty and Pat Roberts, Inc. v. Bill Keith*, WIPO Case D2000-0299 (June 9, 2000).

¹⁴ See *Steven Rattner v. BuyThisDomainName (John Pepin)*, WIPO Case D2000-0402 (July 3, 2000) (holding Complainant is well-known and has a common law mark in connection with investment banking and corporate advisory services); *Monty and Pat Roberts, Inc. v. Bill Keith*, WIPO Case D2000-0299 (June 9, 2000) (held that Complainant's name, Monty Roberts, is a famous mark in connection with the service of horse training); *Nic Carter v. The Afternoon Fiasco* WIPO Case D2000-0658 (October 17, 2000) (Complainant's "name, Nic Carter is distinctive, has received a high degree of recognition and has come to be associated in the minds of the public with Complainant and his radio broadcasting services"); *Isabelle Adjani v. Second Orbit Communications, Inc.*, WIPO Case D2000-0867 (October 4, 2000) (use of Complainant's

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- name has come to be recognized by the general public as indicating an association with the Complainant and her activities as an actress); *Mick Jagger v. Denny Hammerton*, NAF Case FA0007000095261 (September 11, 2000) (“Complainant presented evidence “of the continuous commercial use ... for more than thirty-five (35) years” of “his famous personal name, ‘Mick Jagger,’”); *Helen Folsade Adu p/k/a Sade v. Quantum Computer Services, Inc.*, WIPO Case D2000-0794 (September 26, 2000) (“SADE,” has been used in connection with sales of records, CDs, CD-ROMS, tickets for concerts and merchandising in many jurisdictions around the world); but cf., *Anne McLellan v. Smartcanuk.com*, eResolution Case AF-0303a & AF-0303b (September 25, 2000) (held that Complainant, the most senior Government of Canada official in the Province of Alberta, where both Complainant and Respondent reside, has common law trademark rights in her name, although the decision does not indicate that she has used her name as a mark in commerce).
- ¹⁵ See e.g., *Harrods Ltd. v. Robert Boyd*, WIPO Case D2000-0060 (March 16, 2000) (domain name *dodialfayed.com* was determined to be confusingly similar to the personal name, “Dodi Fayed.”); *Steven Rattner v. BuyThisDomainName (John Pepin)*, WIPO Case D2000-0402 (July 3, 2000) (Complainant not limited to claiming rights in his full name - small variations in the name are not material).
- ¹⁶ See *Bennett Coleman & Co. v. Steven S. Lalwani*, WIPO Cases D2000-0014 and D2000-0015 (March 11, 2000) (given the Internet provides worldwide access, the assessment of the propriety of a domain name registration cannot be confined only to comparisons with trademark registrations and other rights in the country where the web site may be hosted); see also *Jeanette Winterson v. Mark Hogarth*, WIPO Case D2000-0235 (May 22, 2000) (“Since both the Complainant and the Respondent are domiciled in the United Kingdom, ... the Panel can look at applicable decisions of English courts”); *Pierre van Hooijdonk v. S.B. Tait*, WIPO Case D2000-1068 (Nov. 4, 2000) (Complainant was resident in the Netherlands and the Respondent in the United Kingdom. The Panel makes reference to (i) Complainant’s Benelux registered trademark and service mark, (ii) the common law of the United Kingdom, and (iii) the decision of the President of the Amsterdam District Court in *Albert Heijn and 159 other plaintiffs v. Name Space* (July 13, 2000), holding that Defendant’s registration of 300 “proper names” was unlawful); *Isabelle Adjani v. Second Orbit Communications, Inc.*, WIPO Case D2000-0867 (October 4, 2000) (“The Complainant is resident in Switzerland and the Respondents give an address in the United States of America. To the extent that it assists in determining whether the Complainant has met her burden under paragraph 4a(i) of the Policy to establish that she has trademark rights in her name *Isabelle Adjani*, the Panel can look at applicable decision and laws in both countries”); *Estate of Stanley Getz a/k/a Stan Getz v. Peter Vogel*, WIPO Case D2000-0773 (October 10, 2000) (“Since Getz was a resident of the State of California at the time of his death and since his estate is being probated in the courts of the State of California under California law, to the extent that it would assist the Panel, the Panel shall also look to the law of the State of California.”).
- ¹⁷ See *Experience Hendrix. LLC v. Denny Hammerton and the Jimi Hendrix Fan Club*, WIPO Case D2000-0364 (August 15, 2000); *MPL Communications Ltd. v. Denny Hammerton*, NAF Case FA0009000095633 (October 25, 2000) (Respondent, who had registered *paulmccartney.com* and *lindamccartney.com*, has also registered the names of other celebrities such as Mick Jagger, Rod Stewart and Sean Lennon. He has not made use of the domain names in connection with a bona fide offering of goods or services); *Madonna Ciccone, p/k/a Madonna v. Dan Parisi and “Madonna.com,”* WIPO Case D2000-0847 (October 12, 2000) (use which intentionally trades on the fame of another can not constitute a “bona fide” offering of goods or services”); *Alain Delon Diffusion S.A. v. Unimetal Sanayi ve Tic A.S.*, WIPO Case D2000-0989 (October 26, 2000) (the Panel found that, among other factors, the registration by

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the Respondent of a number of other well known trademarks as domain names, there was no basis for finding that the Respondent have had any good faith basis for registering the disputed domain name).

18 See *Helen Folsade Adu p/k/a Sade v. Quantum Computer Services, Inc.*, WIPO Case D2000-0794 (September 26, 2000).

19 See *Monty and Pat Roberts, Inc. v. Bill Keith*, WIPO Case D2000-0299 (June 9, 2000).

20 *Id.*; see also; *Nic Carter v. The Afternoon Fiasco* WIPO Case D2000-0658 (October 17, 2000) (same); *Jeanette Winterson v. Mark Hogarth*, Case D2000-0235 (May 22, 2000), quoting *British Telecommunications plc v. One in a Million* (1999) FSR 1, at 23 (C.A.) (Aldous L.J.): “The placing on a register of a distinctive name such as *marksandspencer* makes a representation to persons who consult the register that the registrant is connected or associated with the name registered and thus the owner of the goodwill in the name.”

21 *Id.*

22 See UDRP, para. 4(b):

“For the purposes of Paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.”

23 See e.g., *Experience Hendrix. LLC v. Denny Hammerton and the Jimi Hendrix Fan Club*, WIPO Case D2000-0364 (August 15, 2000) (*jimihendrixs.com*); *MPL Communications Ltd. v. Denny Hammerton*, NAF Case FA0009000095633 (October 25, 2000) (*paulmccartney.com* and *lindamccartney.com*); *Madonna Ciccone, p/k/a Madonna v. Dan Parisi and “Madonna.com,”* WIPO Case D2000-0847 (October 12, 2000) (*madonna.com*).

24 See *Jules I. Kendall v. Donald Mayer re skipkendall.com*, WIPO Case D2000-0868 (October 26, 2000).

25 See <http://www.theglobalname.org>.

26 See <http://www.icann.org/tlds>.

27 See Comment of Hungary, Hungarian Patent Office (RFC-3 – June 13, 2001), Comment of Mexico, Mexican Institute of Industrial Property (IMPI) (RFC-3 – June 5, 2001), Comment of Switzerland, Swiss Federal Institute of Intellectual Property (RFC-3 – June 15, 2001), Comment of Association des Praticiens en droit des Marques et des Modèles (APRAM) (RFC-3 – June 7, 2001), Comment of Brazilian Association of Intellectual Property (ABPI) (RFC-3 – June 8, 2001) and (RFC-2 – January 4, 2001), Comment of Japan Network Information Center (JPNIC) (RFC-3 – June 8, 2001), Comment of Nominet UK (RFC-3 – June 14, 2001). For similar views expressed in response to RFC-2, see also Comment of Australia, Government of Australia (RFC-2 – January 23, 2001), Comment of Asociación Interamericana de la Propiedad

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- Industrial (ASIFI) (RFC-2 – December 26, 2001), Comment of European Brands Association (AIM) (RFC-2 – December 20, 2000), Comment of British Telecommunications plc (RFC-2 – December 28, 2000), Comment of Ian Kaufman (RFC-2 – December 20, 2000).
- 28 See Comment of United Kingdom, The Patent Office (RFC-3 – June 1, 2001), Comment of United States of America, Office of Advocacy: United States Small Business Administration (RFC-3 – June 15, 2001), Comment of European Commission (RFC-3 – June 25, 2001), Comment of American Intellectual Property Law Association (AIPLA) (RFC-3 – June 7, 2001), Comment of Association for Computing Machinery’s Internet Governance Project (RFC-3 – June 15, 2001), Comment of Copyright Coalition on Domain Names (CCDN) (RFC-3 – June 7, 2001) and (RFC-2 – December 28, 2000), Comment of Fédération internationale des conseils en propriété industrielle (FICPI) (RFC-3 – June 14, 2001) and (RFC-2 – January 18, 2001), Comment of International Association for the Protection of Industrial Property (AIPPI) (RFC-3 – June 18, 2001), Comment of International Chamber of Commerce (ICC) (RFC-3 – June 18, 2001), Comment of International Trademark Association (INTA) (RFC-3 – May 24, 2001), Comment of Motion Picture Association of America (MPAA) (RFC-3 – June 6, 2001), Comment of Icanchannel.de (RFC-3 – June 15, 2001) and (RFC-2 – December 21, 2000), Comment of Rod Dixon (RFC-3 – May 15, 2001), Comment of Michael Froomkin (RFC-3 – June 4, 2001). For similar views expressed in response to RFC-2, see also Comment of European Commission (RFC-2 – January 16, 2001).
- 29 See Comment of Japan Network Information Center (JPNIC) (RFC-3 – June 8, 2001), Comment of Nominet UK (RFC-3 – June 14, 2001).
- 30 See Comment of Switzerland, Swiss Federal Institute of Intellectual Property (RFC-3 – June 15, 2001).
- 31 See Comment of Switzerland, Swiss Federal Institute of Intellectual Property (RFC-3 – June 15, 2001), Comment of Association des Praticiens en droit des Marques et des Modèles (APRAM) (RFC-3 – June 7, 2001), Comment of Brazilian Association of Intellectual Property (ABPI) (RFC-3 – June 8, 2001), Comment of Japan Network Information Center (JPNIC) (RFC-3 – June 8, 2001), Comment of Nominet UK (RFC-3 – June 14, 2001).
- 32 See Comment of Brazilian Association of Intellectual Property (ABPI) (RFC-3 – June 8, 2001).
- 33 See Comment of Fédération Internationale des Conseils en Propriété Industrielle (FICPI) (RFC-3 – June 14, 2001), Comment of International Association for the Protection of Industrial Property (AIPPI) (RFC-3 – June 18, 2001), Comment of Motion Picture Association of America (MPAA) (RFC-3 – June 6, 2001).
- 34 See Comment of United States of America, Office of Advocacy: United States Small Business Administration (RFC-3 – June 15, 2001), Comment of Association for Computing Machinery’s Internet Governance Project (RFC-3 – June 15, 2001), Comment of Icanchannel.de (RFC-3 – June 15, 2001), Comment of Rod Dixon (RFC-3 – May 15, 2001).
- 35 See Comment of United Kingdom, The Patent Office (RFC-3 – June 1, 2001), Comment of Fédération Internationale des Conseils en Propriété Industrielle (FICPI) (RFC-3 – June 14, 2001), Comment of International Trademark Association (INTA) (RFC-3 – May 24, 2001), Comment of Rod Dixon (RFC-3 – May 15, 2001).
- 36 See Comment of Association des Praticiens en droit des Marques et des Modèles (APRAM) (RFC-3 – June 7, 2001), Comment of Motion Picture Association of America (MPAA) (RFC-3 – June 6, 2001).
- 37 See Comment of Rod Dixon (RFC-3 – May 15, 2001), Comment of Michael Froomkin (RFC-3 – June 4, 2001).
- 38 Comment of Motion Picture Association of America (MPAA) (RFC-3 – June 6, 2001).

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³⁹ A comparable provision has been enacted by the State of California as part of legislation similar to the ACPA. See Section 17525 (a) of the Cal. Business and Professional Code (August 22, 2000).

6. GEOGRAPHICAL IDENTIFIERS

205. Geographical designations, like many other forms of identifier, also touch a wide variety of interests and sensitivities that range from our most basic territorial instincts to more sophisticated conceptions of market and cultural justice. While the misuse of geographical attributions may offend many feelings, only certain types of such misuse are sanctioned by the law. The present Chapter examines the legal framework that has been developed internationally to regulate the misuse of geographical identifiers; describes the evidence produced in the course of the Second WIPO Internet Domain Name Process on the misuse of geographical identifiers in the domain name system (DNS); analyses the comments submitted in response to the Interim Report; and formulates recommendations on the question which, in the Request initiating the Second WIPO Process, WIPO was asked to address, namely, the “bad faith, abusive, misleading or unfair use” of “geographical indications, geographical terms, or indications of sources.”

THE LEGAL PROTECTION OF GEOGRAPHICAL IDENTIFIERS

206. A well-established framework for the prohibition of the misuse of geographical identifiers exists at the international, regional and national levels.

207. The international framework is established in four multilateral treaties: the Paris Convention for the Protection of Industrial Property (the Paris Convention), to which 162 States are party;¹ the Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods (the Madrid (Indications of Source) Agreement), to which 33 States are party;² the Lisbon Agreement for the Protection of Appellations of Origin (the Lisbon Agreement), to which 20 States are party;³ and the Agreement on Trade-Related Aspects of Intellectual Property Rights (the TRIPS Agreement), which has 142 Contracting Parties.⁴

208. At the regional level, examples of legal instruments that include treatment of the misuse of geographical identifiers include, in Africa, the Bangui Agreement;⁵ in the Americas, the

North American Free Trade Agreement, between Canada, Mexico and the United States of America, Decision 486 of the Cartagena Agreement between Bolivia, Columbia, Ecuador, Peru and Venezuela, and the Protocol for the Harmonization of Intellectual Property Provisions in Mercosur, between Argentina, Brazil, Paraguay and Uruguay;⁶ and in the European Union, the Council Regulation on the Protection of Geographical Indications and Designations of Origin for Agricultural Products and Foodstuffs and the Council Regulation on the Common Organization of the Market in Wine.

209. At the national level, the foregoing international and regional norms are implemented through a variety of legal approaches, which include *sui generis* or specific legislation, sometimes establishing registration systems, for certain classes of geographical identifiers; protection through collective or certification marks; laws against unfair competition; passing-off; and laws on consumer protection. In many cases, these different legal approaches can be applied cumulatively.

THE MAIN ELEMENTS OF THE INTERNATIONAL FRAMEWORK OF PROTECTION

210. The international framework for the protection of geographical identifiers consists of two elements: (i) a prohibition of false descriptions of the geographical source of goods; and (ii) a more extensive set of rules prohibiting the misuse of one class of geographical source indicators, known as geographical indications.

The Prohibition of False Indications of Source

211. The international law on the prohibition of the use of false indications of geographical source on goods is established in three treaties: the Paris Convention, the Madrid (Indications of Source) Agreement, and the TRIPS Agreement.

212. The basic rule is contained in Article 10 of the Paris Convention. Article 10 subjects to seizure, or prohibition of importation, goods “in cases of direct or indirect use of a false indication of the source of a good or the identity of the producer, manufacturer or merchant.”⁷

The seizure should take place at the request of any competent authority or any interested party.⁸ Since the name of a geographical place or region is not usually the subject of private rights controlled by a particular party, any “producer, manufacturer, or merchant, whether a natural person or a legal entity, engaged in the production or manufacture of or trade in ... goods and established either in the locality falsely indicated as the source, or in the region where such locality is situated, or in the country falsely indicated, or in the country where the false indication of source is used,”⁹ is deemed to be an “interested party” given standing to request seizure of the goods in respect of which a false indication of source is directly or indirectly used.

213. Three features of the rule prohibiting the use of false indications of source in Article 10 of the Paris Convention may be noted. First, the rule applies to goods and does not extend to services. Secondly, any *direct* or *indirect* use of the false indication of the source is proscribed. An indirect use could be, for example, the use of an image uniquely associated with one country (such as a picture of the Matterhorn, a well-known Swiss mountain with a particular and easily recognized shape), as opposed to the use of the name for the country. Thirdly, any geographical identifier may form the basis of the use which creates the false indication of source. Article 10(2), in creating standing to request seizure, mentions “locality,” “region” and “country.” Thus, for example, the indication “made in [locality],” “made in [region]” or “made in [country]” would engage the operation of Article 10, if false.

214. The provisions in the Paris Convention prohibiting false indications of source are incorporated into the TRIPS Agreement.¹⁰

215. The provisions in the Paris Convention are extended by the Madrid (Indications of Source) Agreement in two ways. First, under the Madrid (Indications of Source) Agreement, the prohibition applies not only to *false* (that is, factually wrong) indications of source, but also to *deceptive* (that is, misleading) indications.¹¹ Secondly, the Madrid (Indications of Source) Agreement extends the proscribed range of conduct from goods bearing false or deceptive indications to the publicity and commercial communications used in connection with the sale, display or offering for sale of goods. Article 3*bis* of the Madrid (Indications of Source) Agreement provides as follows:

“the countries to which this Agreement applies also undertake to prohibit the use, in connection with the sale or display or offering for sale of any goods, of all indications in the nature of publicity capable of deceiving the public as to the source of the goods and appearing on signs, advertisements, invoices, wine lists, business letters or papers, or any other commercial communications.”

Geographical Indications

216. The foregoing provisions governing the misuse of false (and deceptive) indications of the geographical source of goods constitute rules of conduct in the trade of goods. They focus on falseness of indication, rather than on the geographical term itself, which is the means by which falseness is indicated.

217. A separate element in the international system governs a particular class of geographical terms, known as geographical indications, which are defined in Article 22.1 of the TRIPS Agreement as:

“... indications which identify a good as originating in the territory of a Member, or a region or locality in that territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin.”

In respect of this class of geographical terms, particular rules apply to govern their use. The main such rule requires Members of the World Trade Organization (WTO) to provide the legal means for interested parties to prevent:

“the use of any means in the designation or presentation of a good that indicates or suggests that the good in question originates in a geographical area other than the true place of origin in a manner which mislead the public as to the geographical origin of the good.”¹²

218. Further rules prevent unfair competition in respect of geographical indications¹³ and provide enhanced protection for geographical indications identifying wines and spirits.¹⁴

219. The essential difference between the rules relating to geographical indications and those relating to false indications of geographical source is that the former place emphasis on a certain quality attached to a limited class of geographical terms, rather than establishing a rule of market behaviors which may be violated through the false use of any geographical term.

220. It follows that the first question for the application of the framework of rules that apply to geographical indications is the identification of whether a term constitutes a geographical indication. At the national level, this is solved, as mentioned above, in a variety of ways. In some cases, identification is achieved through a registration system, in others preference is given to the registration of the trademark (collective or certification), and in others identification is achieved through recognition in the market or custom sanctioned by legislation or court decisions. At the international level, the question is how these various systems interact. When will one system recognize the geographical indications protected in another? The question is complicated because of custom and use and the foundation of systems of protection for geographical indications in times when international trade, telecommunications and personal mobility were less prevalent. What one system traditionally considers to be specific and distinctive, another system may claim to be generic or descriptive.

221. Various methods are at the disposal of the international community to resolve the interaction of national systems and for the mutual recognition of geographical indications recognized within national systems. One method is the establishment of a multilateral register of geographical indications. Such a multilateral register is established and maintained under the Lisbon Agreement. An appellation of origin under the Lisbon Agreement is closely similar, but not identical, to a geographical indication under the TRIPS Agreement.¹⁵ For historical reasons, however, the Lisbon Agreement enjoys a limited participation of only 20 States, so that the multinational register established under it cannot claim to be truly international in effect.

222. The TRIPS Agreement provides for negotiations to be undertaken in the TRIPS Council concerning the establishment of a multilateral system of notification and registration of geographical indications *for wines* eligible for protection in those Members participating in the system.¹⁶ These negotiations have not yet, however, resulted in the establishment of such a system.

EVIDENCE OF THE MISUSE OF GEOGRAPHICAL INDICATIONS IN THE DNS

223. Illustrations of problems experienced in the DNS concerning geographical indications were submitted in response to WIPO2 RFC-2 by entities whose interests, or whose interests they represent, are most affected by the subject matter. These entities include the *Office international de la vigne et du vin* (OIV), an international intergovernmental organization, and the *Institut national des appellations d'origine* (INAO), a French governmental organization charged with the protection of appellations of origin and geographical indications for food and agricultural products.

224. The OIV is an intergovernmental organization with a scientific and technical character, competent in the field of the vine and its derived products. It was created by the International Agreement for the Creation of the *Office international du vin* of November 29, 1924. The Organization has 45 Member States which, together, represent the vast majority of the world's vine planting areas and of the world's wine production and consumption.¹⁷ Already within the framework of the first WIPO Process, the OIV had protested against the "appropriation and the reservation for private purposes of names that benefit from intellectual property protection" and sought "a level of protection for geographical indications that is equal to that available for trademarks."¹⁸ The OIV has reiterated its position in the Second WIPO Process and draws attention to a Resolution adopted by its Member States concerning the use of geographical indications on the Internet. This resolution, in its pertinent part, reads as follows:

“... a very large number of Internet domain names consist of
geographical indications of recognized traditional denominations that

are regulated by the Member States of the OIV and have been communicated to the OIV by them...

... among these domain names, there are a number which are particularly confusing for Internet users and constitute commercial piracy or a misappropriation of notoriety... certain registrations are offered for sale to the highest bidder or are linked to inactive sites, evidencing bad faith...”

225. In addition to this Resolution, the OIV has submitted a study conducted by the *Fédération des syndicats de producteurs de Châteauneuf du Pape* (the Federation of Producers’ Associations of Châteauneuf du Pape) covering numerous domain names corresponding to claimed geographical indications and wine varieties. According to the OIV, this study establishes that “a large number of domain names have been registered which correspond to appellations of origin and geographical indications of wine-derived growing products, as well as wine varieties, without there being any relationship between the domain name registrants and the persons who hold rights in these distinctive signs.”¹⁹ A representative selection of domain names covered by this study, together with relevant registration data concerning these registrations, has been reproduced in Annex VIII.²⁰ Similar examples of claimed appellations of origin that have been registered as domain names have been presented by the INAO (see Annex IX).²¹

226. As a complement to the studies presented by the OIV and INAO, we have performed two similar exercises. The first relates to a number of examples of appellations of origin, including those for products other than wine, that have been registered by the International Bureau of WIPO under the Lisbon Agreement. The results are reproduced in Annex X. The second relates to a number of examples of other possible geographical indications and is reproduced in Annex XI.

227. The comments received, in particular the studies submitted by the OIV and INAO, reveal the existence of practices concerning the registration of geographical indications as domain names, which are similar, if not identical, to those that were observed in relation to

trademarks and service marks, and which ultimately led to the adoption of the UDRP. As described by OIV and INAO, those practices are the following:

- (1) The registration of a domain name corresponding to a claimed geographical indication primarily for the purpose of selling, renting or otherwise transferring the domain name to a third party at a premium.²²
- (2) The use of a domain name corresponding to a claimed geographical indication in connection with a product which does not benefit from the geographical indication, thereby creating a likelihood of confusion as to the quality, other characteristics or reputation of the product.
- (3) The use of a domain name corresponding to a claimed geographical indication with a view to attracting Internet users to a website or other on-line location, the contents of which bears no relationship with the geographical indication.²³
- (4) The registration of a domain name corresponding to a claimed geographical indication with a view to preventing others from registering the same name.²⁴

228. In light of these practices and their strong resemblance to those that have been observed previously in relation to trademarks and service marks, and taking into account the need to safeguard the interests of legitimate users of geographical indications in the DNS, as well as the interests of consumers, the Interim Report recommended that measures be adopted to protect geographical indications and indications of source in the open gTLDs, and proposed that these measures take the form of a broadening of the scope of the UDRP to cover the identifiers in question. The comments received on these preliminary recommendations are discussed in the next section of this Report.

ANALYSIS OF COMMENTS AND VIEWS EXPRESSED IN RESPONSE TO THE INTERIM REPORT

229. In recognition of the significant divergence in views throughout the world on what is to be regarded as a protectable geographical indication, the Interim Report's recommendations focused on attempting to curb only clear-cut cases of abuse of these identifiers, assuming that everyone might agree that manifestly bad faith behavior should be tolerated under no circumstances. The Interim Report proposed that this could be accomplished by broadening the scope of the UDRP to cover geographical indications and indications of source through a revision of the three-pronged test of subparagraph 4(a) of the Policy ("Applicable Disputes"). In view of the essentially collective nature of the rights represented by geographical indications and indications of source, the Interim Report also identified, discussed and proposed options for further reflection on the question of which persons or entities should be deemed to have standing to file a complaint under the proposed revised UDRP and which remedies (transfer or cancellation) should be available under the procedure.

230. A review of the comments submitted in response to the recommendations formulated in the Interim Report reveals continuing disagreement regarding the principle of providing protection in the DNS for geographical indications and indications of source, as well as regarding the form which such protection should take. Several commentators are in favor of the specific proposals contained in the Interim Report.²⁵ Others, including some representing intellectual property interests,²⁶ either oppose them, or, at best, consider them premature.²⁷

231. Commentators who are in favor of the protection proposed in the Interim Report note that geographical indications have been the victims of abuse in the DNS and that there exist international norms protecting this class of identifiers. That being the case, they see no reason why geographical indications should be afforded less protection in the DNS than trade or service marks. Some of these commentators are of the view that protection should not be restricted to cases of bad faith abuse, but that alternative dispute resolution procedures also should be available to resolve conflicts between parties each of which may have rights in the identifiers concerned, in light of the special nature of geographical indications representing collective, rather than individual, rights.²⁸ The same commentators, as well as others, are of

the opinion that an exclusion mechanism for geographical indications would be appropriate, or at least should be given further consideration, in light of ongoing negotiations in the framework of Article 23.4 of the TRIPS Agreement.²⁹ If protection were to be provided through a revised UDRP, some commentators felt that panels with particular expertise in the subject matter would be needed, in view of its specialized nature and complexity.³⁰

232. On the question of who should be deemed to have standing to file complaints under the proposed revised UDRP, the Interim Report presented three options for further consideration: (i) the persons or entities who have standing to enforce these rights in accordance with the law of the country of origin, (ii) governments only, or (iii) the persons or entities who are found to have standing based on the law determined to be applicable to that issue by the panel, in accordance with the ordinary rules of private international law. Most commentators were of the view that the second option would be overly restrictive and favored either the first or last option.³¹ As a solution to the standing problem, one commentator proposed that a complainant wishing to avail itself of the proposed revised UDRP could be required to produce a declaration by either the courts or the government of its jurisdiction confirming that it has standing to pursue the complaint in question.³²

233. In light of the collective nature of the rights concerned, certain commentators proposed the creation of a new remedy for purposes of the proposed revised UDRP which would take the form of a “cancellation + exclusion”. Such a new remedy would serve a dual purpose. On the one hand, it would prevent a prevailing complainant from arrogating to itself a collective right, and, on the other, it would avoid cancelled domain names from being re-registered in bad faith (potentially by the same registrant).³³ Recognizing that multiple persons or entities may have a legitimate claim to the use of the same geographical indication or indication of source, certain commentators advocated the use of gateway systems and the creation of new chartered gTLDs to stimulate coexistence among these competing legitimate interests.³⁴

234. Commentators who oppose the introduction of protection for geographical indications in the DNS recognize that there exist uniform rules governing the subject matter, but believe that the level of harmonization achieved by those rules is insufficient to constitute an adequate

basis for the protection proposed in the Interim Report. In particular, they highlight three specific areas where sufficient uniformity is lacking. First, they argue that the harmonized rules at issue (in particular the TRIPS Agreement) incorporate several qualifications and exceptions to the protection for geographical indications, striking a delicate balance of interests, which would be difficult, if not impossible, to reflect faithfully in the UDRP.³⁵ Secondly, they state that the legal and administrative mechanisms giving effect at the national level to the internationally harmonized norms vary widely, ranging, as noted above, from *sui generis* registration systems, certification or collective marks, the law on passing-off, unfair competition law and consumer protection legislation.³⁶ Thirdly, and perhaps most importantly, they claim that there exists no uniform view at the international level of what is to be deemed a protectable geographical indication, and that, consequently, terms which are protectable in some jurisdictions, are freely available in others.³⁷

235. The commentators in question conclude that providing protection to geographical indications through the UDRP under this state of incomplete harmonization of the law is doomed to fail. They believe panels would be put in the awkward position of having to take decisions with insufficient guidance available to them, which would lead inevitably to the undesired creation of new law. For the same reasons that are set out in the section of this Report concerning personal names,³⁸ these commentators are of the view that this would jeopardize the UDRP's long-term viability as an effective dispute resolution system. This risk is considered particularly acute in the area of geographical indications because there has been, for many years now, continuing intense debate internationally between governments on the subject matter.

236. Next to insufficient harmonization of the applicable norms, the same commentators advance also other reasons for their reluctance to protect geographical indications through a revision of the UDRP. Some argue that there is not enough evidence of widespread abuse to justify such additional protection.³⁹ Others believe that the law governing the subject matter is so complex that it could not be enforced properly through a simple mechanism such as the UDRP, which is intended to deal with clear-cut cases not requiring extensive deliberation.⁴⁰ Still others are of the view that none of the proposals formulated in the Interim Report for solving the standing problem are satisfactory.⁴¹

RECOMMENDATION

237. This is a difficult area on which views are not only divided, but also ardently held. This alone is a cause for reflection about the desirability of introducing a modification dealing with this area to a consensus-based dispute-resolution procedure that is functioning efficiently and cost effectively.

238. It is undeniable that there is widespread evidence of the registration and use of geographical indications and other geographical source identifiers by persons who have no connection whatsoever with the locality to which the identifiers refer. These practices are misleading and harm, first, the integrity of the naming systems in which those geographical identifiers operate and, secondly, the credibility and reliability of the DNS. The question for decision, however, is whether there is a solid and clear basis in existing international law which can be applied so as to prevent erosion of the integrity of geographical indications and enhance the credibility of the DNS.

239. We believe that there are two fundamental problems in endeavoring to apply the existing international legal framework to prevent the bad faith misuse of geographical indications in the DNS.

240. The first problem is that the existing international legal framework for the prohibition of false and deceptive indications of geographical source and the protection of geographical indications was developed for, and applies to, trade in *goods*. The Paris Convention, the Madrid (Indications of Source) Agreement and the TRIPS Agreement all deal with the misuse of geographical identifiers in relation to goods. There is, thus, not a ready and easy fit between these rules and the predatory and parasitic practices of the misuse of geographical indications in the DNS. The mere registration of a geographical indication as a domain name by someone with no connection whatsoever with the geographical locality in question, however cheap and tawdry a practice, does not appear to be, on its own, a violation of existing international legal rules with respect to false indications of source and geographical

indications. Such a registration may violate existing standards if it is associated with conduct relating to goods. For example, a domain name registration that is used in relation to an offer of sale of goods may be considered to be a “commercial communication” under Article 3*bis* of the Madrid (Indications of Source) Agreement. If the domain name registration is a geographical identifier and it is false or deceptive, it may, in these circumstances, be considered to violate the prohibition against the use of false indications set out in Article 3*bis* of the Madrid (Indications of Source) Agreement. Additionally, for example, one can imagine various hypothetical uses of domain name registrations with respect to goods which might be considered to constitute violations of the provisions on the protection of geographical indications in the TRIPS Agreement. However, there are many circumstances in which a domain name registration, even though constituting a false or unauthorized use of a geographical indication, may not constitute a violation of existing international rules because there is no relationship between the domain name and goods. Existing rules, therefore, would offer only a partial solution to the problem of what is perceived to be the misuse of geographical indications in the DNS.

241. Secondly, there is a major problem in respect of applicable law because of the different systems that are used, at the national level, to protect geographical indications. For example, suppose that there is a geographical indication recognized and protected as such under the law of country A, but considered to be generic and descriptive under the law of country B. A resident carrying on business in country B registers, with a registrar based in country B, the geographical indication as a domain name and sells, from the website accessed through that domain name, goods that are available for purchase only by residents in country B. The person has no connection whatsoever with the locality covered by the geographical indication. What law applies to determine whether the registration and use of the domain name constitutes a violation of the protection of the geographical indication?

242. The problem of applicable law highlights the lack of a multilateral system for the recognition of geographical indications. The hypothetical problem referred to in the previous paragraph would not arise if there were a multilaterally agreed list of geographical indications. If such a list existed and were accepted by both country A and country B in the

example given, it is a simple matter to determine whether there exists a protectable geographical indication.

243. We believe, therefore, that the existing international framework would provide only a partial answer to the perceived problems of false indications of source and geographical indications within the DNS. Furthermore, because of the need to resort to a choice of applicable law to resolve the question of the recognition of the existence of a geographical indication, very complicated questions would be involved in the application of the UDRP in this area. On these questions, international opinion is far from settled, as can be seen from the history of the negotiations with respect to a future Hague Convention on International Jurisdiction and Foreign Judgement in Civil and Commercial Matters.⁴² These problems of applicable law could be avoided if a multilaterally agreed list of geographical indications were to be established.

244. It is recommended that no modification be made to the UDRP, at this stage, to permit complaints to be made concerning the registration and use of domain names in violation of the prohibition against false indications of source or the rules relating to the protection of geographical indications.

245. In making this recommendation, it is recognized that there is widespread dissatisfaction with the use of geographical indications as domain names by persons unconnected to the locality to which the geographical indications relate. We consider that, in order to deal with this problem, new law would need to be created in view of the inadequate reach of existing law. The dissatisfaction that exists about certain practices in the DNS in this area is, we believe, best expressed in a will on the part of the international community to advance multilateral discussions on (i) the definition of the circumstances in which the registration and use of geographical indications as domain names should be proscribed; and (ii) the establishment of a multilaterally agreed list of geographical indications or other means of

satisfactorily dealing with the interaction of differing systems and levels of protection at the national level and the mutual recognition of geographical indications within those systems.

PREFERENCES AND PROTECTION FOR GEOGRAPHICAL TERMS *PER SE*

246. The foregoing sections of this Chapter discussed the existing international rules with respect to geographical identifiers which relate to the use of geographical terms in connection with goods. A separate issue that has surfaced is the claim for protection for geographical terms *per se* within the DNS, without reference to the use of the domain name in connection with goods or services. The issue centers on entitlement to register and the first-come first-served, automatic and unscreened nature of domain name registration systems. On the one hand, it is argued that the duly constituted authorities with respect to a geographical area, whether a country, state, city or town, should be entitled to register the name of that locality, as well as to prevent any party unassociated with the duly constituted authorities from registering the name. It is argued that the first-come, first-served nature of domain name registration systems exploit the digital divide and disadvantage authorities in countries with less developed infrastructures for the Internet in establishing their own identity in the DNS. Furthermore, it is argued, the fact that domain name registrations can be held by persons unconnected with the geographical locality is misleading to users and may give rise to the unjust enrichment of those persons on the basis of the reputation established by the geographical localities. On the other hand, it is argued that rights have already been acquired within the DNS on the basis of the existing operation of the system and that regulation of this area would risk disrupting the efficiency of the DNS.

247. An initial complication in dealing with this area is the range and diversity of geographical naming systems. They include the names of countries, regions, cities, towns, villages, communes, suburbs, streets, rivers and mountains, geo-political terms for groupings of countries and geo-ethnic terms for indigenous peoples.

248. The remaining part of this Chapter provides evidence of the registration of geographical terms within the DNS; analyses the comments received in response to the consideration of

these issues in the Interim Report; and formulates recommendations. Because of the range and diversity of geographical naming systems, consideration has been limited to only some such systems.

ILLUSTRATIONS OF THE REGISTRATION OF GEOGRAPHICAL TERMS WITHIN THE DNS

249. The illustrations of the registration of geographical terms that follow are grouped into four categories representing names of (i) countries, (ii) ISO 3166 country code elements, (iii) places within countries, and (iv) indigenous peoples. It is recognized that these illustrations are not exhaustive. Furthermore, they are not presented to advocate the position that the registrations at issue are necessarily abusive. The aim is merely to advance discussion in this area by providing some background material and concrete examples of domain registrations incorporating such terms in the currently existing gTLDs.

Country Names

250. There exists an official linguistic publication of the United Nations providing a list of the names of its Member States.⁴³ The entry for each State includes its usual or “short” name (for example, “Rwanda”), as well as its full or formal name (for example, “the Rwandese Republic”). The usual name is used for all ordinary purposes in the United Nations. The full name, which may also be the same, is used in formal documents such as treaties and formal communications.

251. Annex XII contains a selection of the usual names of a number of countries and details of corresponding domain name registrations existing in some of the gTLDs, as well as the registrants, the country in which the registrants are located, and the type of activity that is conducted under the domain name.

252. The results in Annex XII suggest the following observations:

(i) The overall majority of country names in Annex XII have been registered by persons or entities that are residing or located in a country that is different from the country whose name is the subject of registration.

(ii) In almost all cases in Annex XII, the registrant is a private person or entity. Only rarely is it a public body or an entity officially recognized by the government of the country whose name has been registered.

(iii) The following activities are conducted under the domain names in Annex XII:

- a) No activity (DNS lookup error, under construction, ...);
- b) The offering for sale of the domain name in question;
- c) The provision of information, products or services that bear no or little relationship with the country in question; and
- d) The provision of information regarding the country in question, often on a commercial basis.

253. There are relatively few reports of court decisions or decisions emanating from alternative dispute resolution procedures concerning disputes over the registration of country names as domain names. A complaint regarding the domain name *caymanislands.com* was filed by the Cayman Islands Government with the WIPO Arbitration and Mediation Center under the UDRP, but the case was terminated before a decision was taken on it.⁴⁴ There also have been reports regarding the potential filing of a complaint under the UDRP with the WIPO Center by the Government of South Africa concerning the domain name *southafrica.com*, but to date the case has not been submitted.⁴⁵ In a case involving the registration of a country name in a ccTLD, the Landsgericht of Berlin (Germany), by decision of August 10, 2000, has found that the domain name *deutschland.de* infringed the Government of Germany's "right in its name."⁴⁶ This last case is currently the subject of an appeal.

ISO 3166 Country Code Elements

254. The origin of the codes reflecting country top-level domains is the International Organization for Standardization (ISO). ISO, which was established in 1947 as a non-governmental organization, is a worldwide federation of national standards bodies from 137 countries. Its mission is to promote the development of standardization and related activities in the world with a view to facilitating the international exchange of goods and services, and to developing cooperation in the spheres of intellectual, scientific, technological and economic activity.⁴⁷ One of ISO's most famous standards is Part 1 of ISO 3166 concerning codes for the representation of names of countries and their subdivisions. Part 1 of ISO 3166 contains two letter country codes (alpha-2 codes; for example, au for Australia) and three letter country codes (alpha-3 codes, for example, aus for Australia). It is on the basis of the alpha-2 codes that the country code top-level domains (ccTLDs) were created by the Internet Authority for Assigned Names and Numbers (IANA) during the late eighties and early nineties.⁴⁸ Since the creation of the ccTLDs, registrations in the country domains have flourished, as the use of the Internet has spread throughout the world. It is expected that the importance of the ccTLDs will continue to grow in the future.

255. A phenomenon concerning ccTLDs that merits attention is the registration at the second level in the gTLDs of the country code elements (for example, *uk.com*). Often these domain names are registered by persons or entities in order to make them available to the public for the registration of names at the third level (for example, *company.uk.com*).⁴⁹ The implications of such practices are discussed below.

Names of Places Within Countries

256. As the list of names of places in the world that may have been registered as domain names is virtually limitless, an appropriate starting basis for the analysis must be found. The Convention concerning the Protection of the World Cultural and Natural Heritage is a useful instrument for this purpose. The Convention was adopted on November 23, 1972, under the auspices of the United Nations Educational, Scientific and Cultural Organization (UNESCO) and 188 States are party to it. Article 11 of the Convention provides for the establishment by

the World Heritage Committee of a list of sites forming part of the cultural and natural heritage falling under the scope of the Convention (the “World Heritage List”).⁵⁰ Featured on the List are a number of cities that are famous for their cultural or historical importance. Annex XIII contains details of searches of domain name registrations with respect to some of the cities appearing on the World Heritage List.

257. The following observations can be made with respect to the information contained in Annex XIII:

(i) The majority of city names in Annex XIII have been registered by persons or entities that are residing or located in a country that is different from the country in which the city whose name is the subject of registration is located.

(ii) In several cases, the domain name is used as the address of a website providing information concerning the city whose name corresponds to the domain name. Often these sites appear to be operated by private entities on a commercial basis.

(iii) In several cases, the domain name is used as the address of a website providing general information (often in the form of a portal) that bears either no, or no significant relationship, to the cities whose names correspond to the domain name.

(iv) In one case, the domain name is offered for sale.

(v) In some cases, the domain name is used as the address of a website of a company whose name, or whose trademarks or service marks, correspond to the domain name.

258. A number of cases concerning the registration of cities or regions within countries have been reported in several European courts. In France, the Tribunal de Grande Instance of Draguignan, in its decision of August 21, 1997, found that the registration of the domain name *saint-tropez.com* constituted an infringement of the rights of the Commune of Saint-Tropez, the well-known beach resort located in the south of France.⁵¹ The Tribunal de

Grande Instance of Paris, by preliminary injunction of April 3, 2001, ordered that the registration of the domain name *laplagne.com* for purposes of selling it to the holder of the trademark La Plagne (Association Office du Tourisme de La Plagne) constituted a tort.⁵² In its decision of March 8, 1996, the Landgericht of Munich (Germany) found that the registration of the domain name *heidelberg.de* constituted an infringement of the rights of the City of Heidelberg. Subsequent to this decision, several court cases have been filed in Germany regarding German city names. Most of the cases in question were decided in favor of the cities.⁵³ By decision of May 2, 2000, the Federal Court of Switzerland upheld a complaint filed by a semi-official tourist organization regarding the registration of the domain name *berner-oberland.ch*, a region of Switzerland with a reputation for its picturesque landscapes. By decision of May 23, 2000, the Obergericht Luzern upheld a decision of a lower court ordering the holder of the domain name *luzern.ch* to refrain from offering e-mail services under this name, pending resolution of a complaint brought by the City of Lucerne seeking the transfer to it of that domain name by the registrant.

259. Several cases regarding place names within countries also have been filed with the WIPO Arbitration and Mediation Center under the UDRP.⁵⁴ Two of these cases that involved city names have received much attention. These two cases concerned the domain names *barcelona.com* and *stmoritz.com*. By decision of August 4, 2000, the complaint regarding *barcelona.com* was upheld and, by decision of August 17, 2000, the complaint regarding *stmoritz.com* was denied.⁵⁵ Other more recent such cases filed with WIPO concerned the domain names *lapponia.org/lapponia.net* (complaint granted),⁵⁶ *portofhelsinki.com* (complaint denied),⁵⁷ *portofhamina.com* (complaint denied),⁵⁸ *brisbanecity.com* (complaint denied),⁵⁹ *brisbane.com* (complaint denied),⁶⁰ *olkiluoto.com/olkiluoto.net* (complaint denied),⁶¹ *rouen.com/rouen.net* (complaint denied)⁶² and *arena-verona.com* (complaint denied).⁶³

260. It should be noted that the complaints in many of the court and UDRP cases referred to above were based on the alleged abuse of a trademark registered in the name of the complainant and incorporating the place name subject to the dispute. Furthermore, usually the domain names were deemed infringing in light of the nature of the activity conducted under the domain name and the motivation of the registrants. The cases therefore do not

necessarily stand for the proposition that the registration of a city name or the name of a region, as such, is to be deemed abusive.

261. Finally in connection with place names, it may also be noted that several ccTLD administrators have adopted the policy of excluding the names of places in their countries from registration as domain names, at least under certain conditions. This is the case, for instance, for .AU (Australia),⁶⁴ .CA (Canada),⁶⁵ .CH (Switzerland), .DZ (Algeria),⁶⁶ .ES (Spain),⁶⁷ .FR (France),⁶⁸ .PE (Peru),⁶⁹ and .SE (Sweden).⁷⁰ Often these exclusions are based on official lists of place names compiled by the Government of the country concerned.⁷¹

Names of Indigenous Peoples

262. The question of the protection of the intellectual property rights of the world's indigenous peoples has received increasing attention over the last several years.⁷² While global trade in the creations and knowledge of indigenous peoples has yielded important returns for some, it is felt by others that such commercial exploitation has not always been in harmony with the rights or expectations of the peoples concerned. In light of this ongoing policy debate, it seems appropriate to consider the incidence of the registration of the names of indigenous peoples as domain names. Annex XIV sets out details concerning domain name registrations of a number of well-known indigenous peoples.

263. The following remarks may be made with respect to the information contained in Annex XIV:

- (i) Hardly any of the names in Annex XIV have been registered by persons or entities that are recognized as representing the people denoted by the domain name.
- (ii) Except for those domain names corresponding to the names of peoples from the North American region, most domain names in Annex XIV have been registered in the names of persons or entities that are residing or located in countries that are different from the countries of the peoples concerned.

(iii) The activities conducted under the domain names in Annex XIV only rarely are aimed at providing information about the peoples concerned.

(iv) Most activities that are conducted under the domain names in Annex XIV fall under one of the following categories: no activity (DNS lookup error or holding page), general information or portal sites (of widely differing varieties) of a person or entity which does not appear to represent the people, website of company with a (product) name corresponding to the name of the people, and personal website of an individual whose first name corresponds to the name of a people.

(v) In one case in Annex XIV, the domain name is offered for sale.

ANALYSIS OF COMMENTS AND VIEWS EXPRESSED IN RESPONSE TO THE INTERIM REPORT

Country Names and Names of Places Within Countries

264. On these names, the Interim Report presented two options for further consideration. The first option was to maintain the status quo (i.e., not introduce any protective measures), in recognition of the novelty of the subject matter, as well as the tenuous legal grounds for introducing protective measures in this area. The second option attempted to balance the competing interests of countries, domain name registrants and Internet users, by proposing a new cause of action under the UDRP aimed at curbing the abusive registration of the designations concerned as domain names in the gTLDs. To further clarify the type of conduct which this proposed cause of action was intended to cover, the Interim Report included a number of illustrations of what would be deemed good and bad faith conduct on the part of domain name registrants. Among the illustrations establishing good faith featured “[t]he use of the domain name as the address of a web site or other on-line location devoted to the provision of information concerning the country, region or municipality corresponding to the domain name ..., whether or not such information is provided for financial gain.”

265. A review of the comments received on the Interim Report reveals that it has failed to bridge the gap between those who oppose establishing protection for the designations in question⁷³ and those who favor such protection.⁷⁴ While the specific formulation of the proposed new cause of action was well received by some commentators, it is strongly opposed by the most ardent advocates of protection in this area, because it would legitimize conduct which they deem totally unacceptable: the commercial exploitation in the DNS by private parties of country names, assets which they consider the inherent property of sovereign States. The latter view is advocated in particular by one Government which is of the view that all full (or formal) names, as well as all short (or usual names) of countries, should be excluded from registration as domain names.⁷⁵ The same Government also advocates the creation of a challenge procedure permitting governments to recuperate such names in all circumstances and irrespective of the use which is being made of them by their registrants, without any possibility of recourse to national courts to obtain the reversal of the decisions emanating from the procedure. According to the Government in question, this protection is particularly important for developing countries, in light of the difficulties they are facing in attempting to bridge the digital divide. The same Government also believes that the protection of country names in the DNS is fully supported by existing international intellectual property law.

266. Those who oppose the protection of country names (as well as the names of places within countries) in the gTLDs advance several arguments in support of their position. Most importantly, they state that there exist no international intellectual property norms protecting country names and names of places within countries and that, in the absence of such norms, no protection should be provided through the ICANN system.⁷⁶ Furthermore, they argue that the terms in question are inherently generic in nature and that any restrictions on their use in the DNS would not be consistent with their free availability in the physical world.⁷⁷ They also claim that different parties often will have competing legitimate interests in the terms concerned (e.g., Paris in France and Paris in Texas; Virginia as a state of the United States of America and the first name of a person) and that any protection mechanism would have to cater for this.⁷⁸ One commentator raises the question how to deal with the names of countries and the names of places in countries registered in foreign languages, if protection were to be introduced.⁷⁹

267. Specifically with regard to the protection of country names, some commentators appear not to oppose continued consideration of the issue, but suggest that the ICANN system may not be the appropriate venue for this purpose, because of the likely need to create new rules of law, should protection be desired. References are made by these commentators to treaty processes or other forms of agreement between sovereign States and, in particular, to the Assembly of the Paris Union for the Protection of Industrial Property, the competent organ for the Paris Convention.⁸⁰

ISO 3166 Country Code Elements

268. The Interim Report recommended the exclusion of the ISO 3166 alpha-2 country code elements from registration as domain names in the new gTLDs, in the absence of an agreement to the contrary from the relevant competent authorities. Furthermore, the Interim Report recommended that persons or entities who have registered such codes at the second level in the existing gTLDs and who accept registrations of names under them should take measures to render the UDRP applicable to such lower level registrations.

269. Several commentators favored the exclusion mechanism proposed in the Interim Report for the ISO 3166 alpha-2 country code elements,⁸¹ while others opposed it.⁸² Some of the entities offering the possibility of registrations under the codes in the existing gTLDs have expressed a willingness to adopt the UDRP or a similar procedure, as recommended in the Interim Report.⁸³ Few administrators of ccTLDs submitted comments on the Interim Report's recommendations in this area. Trademark owners have expressed concerns that the exclusion mechanism proposed in the Interim Report would prevent the legitimate registration of two-letter trademarks or acronyms of trademarks.⁸⁴

Names of Indigenous Peoples

270. Apart from noting certain domain name registration practices in relation to the names of indigenous peoples, the Interim Report did not propose any specific recommendations in this area. While few comments were received on this particular topic, some commentators urged further study and assessment of the question, because they believe the practices observed in

the Interim Report correspond to similar intellectual property issues relating to traditional knowledge, folklore and symbols in the physical world.⁸⁵

RECOMMENDATION

Country Names and Names of Places Within Countries

271. Prior to considering which protective measures (if any) might be in order in relation to this class of geographical terms, it is necessary first to determine with more precision which concepts are intended to benefit from such protection. As far as countries are concerned, no particular difficulties arise as, apart from a few exceptional cases, it is clear which countries exist and what their names are.⁸⁶ However, the term “places within countries” is more vague and therefore requires further elucidation.

272. As the protection of place names within the gTLDs is a novel concept, it is proposed to take a conservative approach and interpret the term, at least at this stage, narrowly. It is therefore recommended that its scope be restricted to those items that are most closely associated with the territorial integrity of the State, namely regions that have received administrative recognition from the State (for example, provinces, departments...) and municipalities (cities, towns, communes...). This interpretation excludes from consideration other items which also might qualify as “places,” such as streets, squares, natural, historical or cultural sites, mountains, rivers, lakes and waterways, buildings and edifices, monuments, and so forth. Limiting protection to administratively recognized regions and municipalities has the added advantage that the existence and the names of such entities are usually well documented within the constitutional and public law frameworks of countries.

273. It is recommended that the consideration of any measures to protect the names of places in the gTLD should be restricted, at this stage, to the names of:

(i) countries; and

(ii) *administratively recognized regions
and municipalities within countries.*

274. The comments received on the Interim Report’s preliminary recommendations on the protection in the gTLDs of country names and the names of administratively recognized regions and municipalities within countries reveal that the concerns of those who are in favor of such protection relate in particular to the names of countries. While many of the arguments that are advanced in support of the protection of country names also can find application in relation to other place names, the present analysis will focus primarily (but not exclusively) on the protection of country names, in light of the concerns and expectations of the commentators. Whether it would be opportune at this stage to create this protection must be considered from both a policy, as well as a legal perspective.

275. *Policy Perspective.* Current registration policies in the open gTLDs allow persons or entities to appropriate for themselves, as domain names, terms with which they otherwise have no, or only a loose, connection, to the exclusion of countries and peoples whose history and culture are deeply and inextricably linked to the terms in question. It should come as no surprise that such registrations are a source of concern for these countries and peoples, particularly if the domain names are exploited commercially or used in a manner that is deemed inappropriate or disrespectful. As the number of gTLDs expand, the value of a registration in any one of them may correspondingly decrease, and it is possible that the problem will become less acute.⁸⁷ However, as long as domain names are used as a de facto Internet directory, it is unlikely that the problem will disappear completely, particularly in relation to the more visible and popular TLDs.

276. Some will argue that the solution should lie in the application of the “first-come, first-served” principle. It is our view, however, that this argument is somewhat facile, at least in relation to the matter under consideration. The principle assumes an equal playing field between potential domain name registrants, in terms of awareness of the Internet and the DNS in particular, and the ability to access it and register domain names. However, it is now currently well accepted that such an equal playing field does not exist throughout the world. Persons residing in countries where the Internet is broadly known and used are therefore in a

much more advantageous position in terms of securing their interests in the DNS than those in countries where the Internet has made little or no penetration. This point of view is underscored by the fact that many of the names of countries whose populations have benefited less from exposure to the Internet appear to have been registered as domain names by parties from countries that are at the forefront of Internet developments.

277. The consideration of the interest of a country or a people in a term with which it has a strong historical and cultural link is one way to approach the problem of the registration of geographical terms as domain names. Another possible approach is to consider whether the manner in which the term is used as a domain name adds value by permitting users to retrieve more efficiently the information that they are seeking on the Internet. Under this approach, any geographical term that is registered as a domain name in order to function as the address of a website that provides information on the territory or location corresponding to the domain name may be deemed to add value, as users generally rely on domain names as a primary means of accessing information on the Internet. However, if a domain name corresponding to a geographical term does not resolve to any site or to a site which does not contain any meaningful information regarding the territory or region concerned, it may be argued that there is no added value, only a waste of resources and a cause of consumer confusion. Taking into account the use to which the domain name is put and the nature of the gTLD in which it is registered in assessing the appropriateness of the registration of a geographical term may be worthwhile also because such use, or the lack thereof, can be an indicator of the true purpose for which the name was registered (for example, speculative intent) .

278. *Legal Perspective.* The international intellectual property instrument that is most relevant to the discussion of the protection of country names in the DNS is the Paris Convention. Article 6*ter* of the Convention provides for the protection of certain State-related symbols against their registration and use as trademarks.⁸⁸ The Convention does not, however, expressly mention country names, but some have argued that they nonetheless should be deemed to fall within its scope.⁸⁹ While a number of innovative arguments can be advanced in support of this position,⁹⁰ we believe that a plain reading of the relevant provisions and the negotiating history of the Convention leads to the conclusion that it does not offer protection to the names of countries. Our finding results from, on the one hand, a

textual comparison between subparagraphs 1(a) and 1(b) of Article *6ter* and, on the other hand, the preparatory work for the Geneva Diplomatic Conference on the Revision of the Paris Convention.

279. Article *6ter* (1)(a) reads as follows:

“The countries of the Union agree to refuse or invalidate the registration, and to prohibit by appropriate measures the use, without authorization by the competent authorities, either as trademarks or as elements of trademarks, of armorial bearings, flags, and other State emblems, of the countries of the Union, official signs and hallmarks indicating control and warranty adopted by them, and any imitation from a heraldic point of view.”

280. Article *6ter* (1)(b) reads as follows:

“The provisions of subparagraph (a), above, shall apply equally to armorial bearings, flags, other emblems, abbreviations, *and names*, of international intergovernmental organizations of which one or more countries of the Union are members... .”

(Emphasis added)

281. The fact that subparagraph 1(b) refers explicitly to names of international intergovernmental organizations, while subparagraph 1(a) does not refer to names of countries supports the view that the latter provision does not provide an existing legal basis for the protection of country names in the DNS (*expressio unius exclusio alterius*).

282. Furthermore, during the Second Session of the Working Group on Conflicts Between An Appellation of Origin and a Trademark of the Preparatory Intergovernmental Committee on the Revision of the Paris Convention (Geneva, June 18 to 29, 1979), a proposal was made by the Group of Developing Countries to add the “official names” of States to the items to be protected under subparagraph 1(a) of Article *6ter*.⁹¹ This proposal was reflected in the Basic Proposals for the Diplomatic Conference.⁹² At the end of the Third Session of the Diplomatic Conference (October 4 to 30, 1982 and November 23 to 27, 1982), Main Committee I adopted the following proposed change:

“As regards Article 6*ter*, after a full discussion, agreement was reached on October 22, 1982, on the text which is reproduced in Annex I to this report and which extends the protection under Article 6*ter* to official names of States. Main Committee I unanimously adopted this text and transmitted it to the Drafting Committee”.⁹³

283. However, for other reasons, the Diplomatic Conference did not result in a revision of the Paris Convention and Article 6*ter* therefore remained unchanged.

284. In light of the above, the following observations seem in order:

(i) Considering that the States party to the Paris Convention were of the view that Article 6*ter* would need to be amended to offer protection for the official names of countries, the position that Article 6*ter*, in its current unrevised form, covers country names seems difficult to maintain.

(ii) At the time of the Diplomatic Conference, developing countries only sought to obtain protection under Article 6*ter* for the official names of countries (for example, the Republic of South Africa) and not for their usual names (for example, South Africa). However, this statement must be qualified in two respects. First, it may have been possible for countries to notify also their usual names as official names to the International Bureau under the notification procedures foreseen in Article 6*ter*. Secondly, discussions were held at the Diplomatic Conference on the need to offer protection also for the usual names of countries under a new proposed Article 10*quater*, but only if these names were used in a manner that misleads the public.

285. In view of these observations and without prejudice to the relative merits of any policy considerations in this connection, it is submitted that any protection offered in the gTLDs to country names (as well as any other place names), as such, would amount to the creation of new law, at least from the international intellectual property perspective. A recommendation to adopt such measures consequently would be a departure from one of the fundamental principles underlying the Report of the first WIPO Process, namely, the avoidance of the

creation of new intellectual property rights or of enhanced protection of rights in cyberspace compared to the protection that exists in the real world.⁹⁴ Furthermore, in considering whether it would be opportune, under these circumstances, to introduce any protective measures for these names and what the nature of those measures might be, account should be taken of the fact that terms in this area are protected in certain jurisdictions but are freely available in others. Due to this lack of harmonization and the resultant differing treatment of the issues at the national level, any protective measures that might be adopted for the gTLDs, and the results that they might produce, run a greater risk of being invalidated, if contested at the national level.

286. Notwithstanding the considerations expressed in the preceding paragraph, we strongly believe that, as a matter of policy, country names and the names of administratively recognized regions and municipalities within countries should be protected against abuse in the gTLDs and the Interim Report set out a proposal intended to achieve that goal. That proposal, which was centered on a definition of abuse aimed at striking a reasonable balance of competing interests between countries, domain name registrants and general Internet users, did not receive sufficient support to be put forward as a final recommendation in the present Report. An important reason for this is that those commentators who are most ardently in favor of the protection of country names are of the view that the mere registration of these names as domain names by private parties constitutes in and of itself an abusive misappropriation of a national asset, irrespective of the use (if any) which may be made of the domain names. Rather than expressing agreement or disagreement with this position, we draw attention to the following fundamental characteristics of the debate, as they have emerged from the Second WIPO Process:

(i) The question of the appropriateness of the registration of country names in the gTLDs is inextricably linked by some governments to what they perceive to be their national sovereign interest.

(ii) Protecting country names in the gTLDs would require or amount to the creation of new law, a function traditionally reserved for States.

287. Both points lead us to conclude that we have reached the limits of what can be achieved legitimately through consultation processes, such as the WIPO Internet Domain Name Processes or any similar ICANN processes. In other words, we agree with those commentators who are of the view that this particular question is more appropriately dealt with by governments.

288. It is recommended that the question of the protection in the gTLDs of country names and the names of administratively recognized regions and municipalities be further considered in the appropriate intergovernmental fora, in particular with a view to a discussion on the need for new international rules for the protection of country names.

289. Our reluctance to recommend the introduction of new protective measures for country names in the gTLDs principally stems from the view that the international intellectual property framework offers insufficient basis therefor at the present time. This finding, however, is without prejudice to the situation in the ccTLDs. As explained above, the administrators of many ccTLDs have already foreseen mechanisms to safeguard interests in place names within their domains. In line with the policy objectives outlined above, we generally encourage the introduction of such safeguards, in particular, if they are aimed at curbing abusive registrations practices and provided, of course, this is consistent with local law.

ISO 3166 Alpha-2 Country Code Elements

290. The Interim Report formulated two recommendations in relation to ISO 3166 country code elements. First, it proposed that these codes be excluded from registration in the new gTLDs, unless the relevant authorities grant permission for their registration. Secondly, it recommended that persons or entities who have registered such codes at the second level in

the existing gTLDs and who accept registrations of names under them take measures to ensure that the UDRP applies to such lower level registrations.

291. In connection with the first recommendation, we note that the current version of Appendix K to the Registry Agreements between ICANN and the sponsors and operators of the new gTLDs states that “[a]ll two-character labels shall be initially reserved. The reservation of a two-character label string shall be released to the extent that the Registry Operator reaches agreement with the government and country-code manager, or the ISO 3166 maintenance agency, whichever appropriate. The Registry Operator may also propose release of these reservations based on its implementation of measures to avoid confusion with the corresponding country codes.”⁹⁵

Exclusions for ISO 3166 Country Code Elements. A number of factors, highlighted in the comments and reactions received on the Interim Report, have lead us to re-consider our recommendation that the ISO 3166 alpha-2 country code elements should be excluded from registration as domain names in the gTLDs. These factors are as follows:

(i) While, on the Internet, the ISO 3166 codes have been associated in particular with country code top-level domains, in the physical world they find broad application and use throughout a wide variety of industries. This is consistent with the nature and purpose of the standard, which itself states that “[it] provides *universally applicable* coded representations of names of countries ...” and that “[it] is intended for use *in any application* requiring the expression of current country names in coded form.” (*Emphasis added*)⁹⁶ We observe that some of the industries which traditionally have used the ISO 3166 codes to structure themselves in the physical world are migrating some aspects of their operations to the online world, and that this trend may intensify in the future. As they move to the Internet, these industries may wish to rely on the same codes to replicate their structures in the networked environment, including the DNS. Excluding the registration of the ISO 3166 codes as domain names may, under certain circumstances, unfairly hamper those industries in their on-line activities, by establishing an overly exclusive linkage between the codes in question and the country domains.

(ii) Certain ISO 3166 country codes correspond to the acronyms of other identifiers, in particular trademarks. Excluding the codes from registration in the DNS would prevent such other identifiers from being registered as domain names without seeming justification.

292. In light of the above considerations, we no longer subscribe to the view that the ISO 3166 country code elements should be excluded from registration in the new gTLDs under all circumstances. Nonetheless, we remain concerned that, depending on the manner in which these codes are registered and used in the DNS, confusion may be created with the ccTLDs. That being the case, we believe that the proper focus should be on the avoidance of confusion with regard to those codes, rather than on an absolute prohibition of their registration and use.

293. If ISO 3166 alpha-2 country code elements are to be registered as domain names in the gTLDs, it is recommended that this be done in a manner that minimizes the potential for confusion with the ccTLDs.

294. The practice of registering ISO 3166 country code elements at the second level in the gTLDs in order to offer to the public the opportunity to register names under them raises questions regarding the application of the UDRP.⁹⁷ The current version of the UDRP essentially is aimed at ensuring that names registered at the second level under the gTLDs to which the UDRP applies are not abusive. If they are found to be abusive, the UDRP foresees that the names can be cancelled or transferred to the complainant. However, if a country code is registered at the second level in one of these gTLDs and names are allowed to be registered under it, the level where the abuse most likely will occur is not only, or necessarily, the second level, but the third level (for example, *famousmark.uk.com* registered by a cybersquatter). This raises questions in terms of the applicability and enforcement of the UDRP. First, while it is clear that the registrant of the country code at the second level is bound to the UDRP (through its registration agreement with an ICANN-accredited registrar), it is not clear whether the registrant of the name at the third level would also be (indirectly) bound to the UDRP (as its agreement is with the registrant of the name at the second level,

who may not have included a submission to the UDRP as a condition for accepting the registration of the name at the third level). Secondly, even if it were found that the UDRP indirectly applies to the third level, enforcement issues nonetheless would persist. The UDRP foresees that the ICANN-accredited registrars must cancel or transfer the name registered at the second level in case a violation of the Policy is found to exist. However, numerous names may be registered under the country code at the third level, only some of which might be abusive. Canceling or transferring the registration at the second level (i.e., the country code) might then be a disproportionate measure, because all the names at the third level (as well as those at any lower levels) would be adversely affected, irrespective of whether they were abusive or not. In view of these considerations, the persons or entities who have registered ISO 3166 country code elements and accept registrations of names under them should take measures to render the UDRP applicable to these registrations and to ensure the proper and prompt implementation of decisions transferring or canceling the registrations resulting from the UDRP. We are encouraged by the fact that certain such entities through comments submitted on the Interim Report have expressed a desire to work toward this goal.⁹⁸

295. With regard to the ISO 3166 alpha-2 code elements, it is recommended that the persons or entities in whose name such codes are registered at the second level in the existing gTLDs and who accept registrations of names under them be encouraged to take measures to render the UDRP applicable to these registrations, as well as to registrations at lower levels, and to ensure the proper and prompt implementation of decisions transferring or canceling these registrations resulting from the UDRP.

Names of Indigenous Peoples

296. While the Interim Report provided illustrations of certain domain name registration practices regarding the names of indigenous peoples, it did not propose any specific recommendations in relation to those practices. Few comments were received regarding this topic, but those commentators that addressed the issue, urged further consideration of the matter.⁹⁹

297. We believe that it is too early, at this stage, to formulate any recommendations regarding the protection of the names in question in the DNS. An important reason for this is that the communities who are most affected by the topic (indigenous peoples) have not yet had the opportunity to participate fully in the debate. It is therefore proposed that, for the time being, efforts in this area be focused on sensitizing indigenous peoples to the phenomenon and encouraging them to make their voices heard. This could be achieved through a variety of channels, including WIPO's program of work on intellectual property and genetic resources, traditional knowledge, and folklore.¹⁰⁰

¹ See Annex II.

² See Annex II.

³ See Annex II.

⁴ See Annex II.

⁵ Agreement Relating to the Creation of an African Intellectual Property Organization Constituting a Revision of the Agreement Relating to the Creation of an African and Malagasy Office of Industrial Property (Bangui (Central African Republic), March 2, 1977). See <http://www.oapi.cm>.

⁶ The Protocol is not yet in force.

⁷ Article 10(1), Paris Convention.

⁸ Article 9(3), Paris Convention.

⁹ Article 10(2), Paris Convention.

¹⁰ Article 2.1, TRIPS Agreement.

¹¹ Article 1(1), Madrid (Indications of Source) Agreement.

¹² Article 22.2(a), TRIPS Agreement.

¹³ Article 22.2(b), TRIPS Agreement.

¹⁴ Article 23, TRIPS Agreement.

¹⁵ The definition in the TRIPS Agreement is broader insofar as it attributes status to geographical localities from which products derive a reputation. There are certain other differences.

¹⁶ Article 23.4, TRIPS Agreement.

¹⁷ More information on the *Office internationale de la vigne et du vin* (OIV) is available at www.oiv.int.

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¹⁸ See Comment of *Office internationale de la vigne et du vin* (OIV) (RFC-3 of first WIPO Process - April 30, 1999).

¹⁹ “*Une étude menée en 1999 a constaté le dépôt d’un grand nombre de noms de domaine (.com) qui correspondent aux noms d’appellations d’origines et d’indications géographiques de produits vitivinicoles et de noms de cépages sans que les dépositaires aient un lien quelconque avec les titulaires réels des droits liés à ces signes distinctifs.*” in Comment of *Office internationale de la vigne et du vin* (OIV) (RFC-1 - August 14, 2000).

²⁰ As the study was conducted in 1999, and as registration data often change, all information regarding the domain name holder as well as the web site’s activity has been verified as at January 26, 2001, as reflected in the Annex.

²¹ See Comment of *Institut national des appellations d’origine* (INAO) (RFC-2 – January 31, 2001).

²² See Annex IX, INAO: *fitou.com*.

²³ See Annex VIII, Châteauneuf du Pape: *bade.com, barsac.com, rhodes.net*; Annex IX, INAO: *bourgueil.com, corton.com, gigondas.com, vacqueyras.com*; Annex X, Lisbon: *champagne.org, chinon.org, frascati.com*.

²⁴ See Annex VIII, Châteauneuf du Pape: *bourgogne.com, eiswein.com, lambrusco.com, medoc.com*; Annex X, Lisbon: *armagnac.com, hoyo-de-monterrey.com, tequila.com*.

²⁵ See Comment of France, *Institut national des appellations d’origine* (INAO) (RFC-3 – June 13, 2001), Comment of Hungary, Hungarian Patent Office (RFC-3 – June 13, 2001), Comment of Switzerland, Swiss Federal Institute of Intellectual Property (RFC-3 – June 15, 2001), Comment of United Kingdom, The Patent Office (RFC-3 – June 1, 2001), Comment of European Commission (RFC-3 – June 25, 2001), Comment of American Intellectual Property Law Association (AIPLA) (RFC-3 – June 7, 2001), Comment of Auckland District Law Society, Law & Technology Committee (RFC-3 – June 22, 2001), Comment of Brazilian Association of Intellectual Property (ABPI) (RFC-3 – June 8, 2001), Comment of European Brands Association (AIM) (RFC-3 – May 16, 2001), Comment of International Association for the Protection of Industrial Property (AIPPI) (RFC-3 - June 18, 2001), Comment of International Chamber of Commerce (ICC) (RFC-3 – June 18, 2001), Comment of Japan Network Information Center (JPNIC) (RFC-3 – June 8, 2001), Comment of Nominet UK (RFC-3 – June 14, 2001), Comment of UAEnic (RFC-3 – June 6, 2001), Comment of Elzaburu (Luis H. De Larramendi) (RFC-3 – June 14, 2001). For similar views expressed in response to RFC-2, see also Comment of Government of Australia (RFC-2 – January 23, 2001), Comment of Government of The Netherlands, Ministry of Transport, Public Works and Water Management (RFC-2 – December 20, 2000), Comment of Republic of Moldova, State Agency on Industrial Property Protection (RFC-2 – December 29, 2000); Comment of *Asociación Interamericana de la Propiedad Industrial* (ASIPI) (RFC-2 – December 26, 2000); Comment of Brazilian Association of Intellectual Property (ABPI) (RFC-2 - December 28, 2000), Comment of Association of European Trade Mark Owners (MARQUES) (RFC-2 - December 22, 2000), Comment of ES-NIC (RFC-2 – December 29, 2000), Comment of Verizon (RFC-2 December 26, 2000).

²⁶ See Comment of *Fédération internationale des conseils en propriété industrielle* (FICPI) (RFC-3 – June 14, 2001); see also (RFC-2 - December 29, 2000) and Comment of International Trademark Association (INTA) (RFC-3 – May 24, 2001).

²⁷ See Comment of Canada, Government of Canada (RFC-3 – July 5, 2001), Comment of Japan, Ministry of Economy, Trade and Industry (METI) (RFC-3 – July 5, 2001), Comment of United States of America, U.S. Patent and Trademark Office (USPTO) (RFC-3 – June 14, 2001), Comment of Association for Computing Machinery’s Internet Governance Project, Electronic Privacy Information Center (RFC-3 – June 15, 2001), Comment of EasyLink Services

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Corporation (RFC-3 – January 1, 2001), Comment of International Trademark Association (INTA) (RFC-3 – May 24, 2001), Comment of Icanchannel.de (RFC-3 – June 15, 2001), Comment of Andy Eastman (RFC-3 – June 16, 2001), Comment of Christine Haight Farley (RFC-3 – June 11, 2001), Comment of Michael Froomkin (RFC-3 – June 4, 2001). For similar views expressed in response to RFC-2, see also Comment of Tim Heffley, Z-Drive Computer Service (RFC-2 – December 19, 2000), Comment of Christa Worley (RFC-2 December 19, 2000), Comment of Alexander Svenssen (RFC-2 – December 21, 2000).

28 See Comment of France, *Institut national des appellations d'origine* (INAO) (RFC-3 – June 13, 2001).

29 See Comment of France, *Institut national des appellations d'origine* (INAO) (RFC-3 – June 13, 2001) and Comment of European Commission (RFC-3 – June 25, 2001).

30 See Comment of Elzaburu (Luis H. De Larramendi) (RFC-3 – June 14, 2001).

31 See Comment of European Commission (RFC-3 – June 25, 2001), Comment of Hungary, Hungarian Patent Office (RFC-3 – June 13, 2001), Comment of United Kingdom, The Patent Office (RFC-3 – June 1, 2001), Comment of American Intellectual Property Law Association (AIPLA) (RFC-3 – June 7, 2001), Comment of Auckland District Law Society, Law & Technology Committee (RFC-3 – June 22, 2001), Comment of International Association for the Protection of Industrial Property (AIPPI) (RFC-3 – June 18, 2001).

32 See Comment of Elzaburu (Luis H. De Larramendi) (RFC-3 – June 14, 2001).

33 See Comment of Japan Network Information Center (JPNIC) (RFC-3 – June 8, 2001).

34 See Comment of France, *Institut national des appellations d'origine* (INAO) (RFC-3 – June 13, 2001).

35 See Comment of Christine Haight Farley (RFC-3 – June 11, 2001).

36 See Comment of United States of America, U.S. Patent and Trademark Office (USPTO) (RFC-3 – June 14, 2001) and Comment of Christine Haight Farley (RFC-3 – June 11, 2001).

37 See Comment of United States of America, U.S. Patent and Trademark Office (USPTO) (RFC-3 – June 14, 2001), Comment of *Fédération internationale des conseils en propriété industrielle* (FICPI) (RFC-3 – June 14, 2001), Comment of International Trademark Association (INTA) (RFC-3 – May 24, 2001), Comment of Christine Haight Farley (RFC-3 – June 11, 2001).

38 See paragraph 195, above.

39 See Comment of Michael Froomkin (RFC-3 – June 4, 2001).

40 See Comment of Association for Computing Machinery's Internet Governance Project, Electronic Privacy Information Center (RFC-3 – June 15, 2001), Comment of International Trademark Association (INTA) (RFC-3 – May 24, 2001), Comment of Icanchannel.de (RFC-3 – June 15, 2001).

41 See Comment of United States of America, U.S. Patent and Trademark Office (USPTO) (RFC-3 – June 14, 2001).

42 See <http://www.hcch.net/e/workprog/jdgm.html>.

43 Terminology Bulletin No. 347/Rev.1, States Members of the United Nations, Members of the Specialized Agencies or Parties to the Statute of the International Court of Justice, ST/CS/SER.F/347/Rev.1.

44 See WIPO Case D2000-1664 (*caymanislands.com*) available at <http://arbiter.wipo.int/domains/decisions/html/2000/d2000-1664.html>.

45 Business Day (Johannesburg), June 21, 2001.

46 Docket number 16 O 101/00, Computerrecht (CR) 2000, page 700-701.

47 For more information, see <http://www.iso.ch>.

48 The list of currently existing ccTLDs is available at <http://www.iana.org/cctld/cctld-whois.htm>.

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- ⁴⁹ See, for instance, the services of CentralNic offering the possibility of registering names under the following: *br.com*, *cn.com*, *eu.com*, *gb.com*, *gb.net*, *hu.com*, *no.com*, *qc.com*, *ru.com*, *sa.com*, *se.com*, *se.net*, *uk.com*, *uk.net*, *us.com*, *uy.com*, and *za.com*. For more information, see <http://www.centralnic.com/>.
- ⁵⁰ The World Heritage List is available at <http://www.unesco.org/whc/nwhc/pages/doc/mainf3.htm>.
- ⁵¹ See http://www.legalis.net/jnet/decisions/marques/tgi_sttropez.htm.
- ⁵² This case is available at <http://www.legalis.net>.
- ⁵³ Next to *heidelberg.de*, these cases concerned the following cities: *kerpen.de*, *pullheim.de*, *celle.de*, *herzogenrath.de*, *bad-wilddbad.com*. They are all available at http://www.bettinger.de/datenbank/domains_ge.html.
- ⁵⁴ See, for instance, WIPO Case D2000-0064 (*1800rockport.com*); WIPO Case D2000-0505 (*barcelona.com*); WIPO Case D2000-0617 (*stmoritz.com*); WIPO Case D2000-0629 (*parmaham.com*); WIPO Case D2000-0638 (*manchesterairport.com*); D2000-0699 (*paris-lasvegas.com*); WIPO Case D2000-1017 (*xuntadegalicia.net/xuntadegalicia.org*); WIPO Case D2000-1218 (*wembleystadiumonline.com*); WIPO Case D2000-1224 (*sydneyoperahouse.net*); WIPO Case D2000-1377 (*axachinaregion.com*); WIPO Case D2000-1435 (*capeharbour.com/capeharbor.com*). These cases are available at <http://arbiter.wipo.int/domains/decisions/index-gtld.html>.
- ⁵⁵ WIPO Case D2000-0505, available at <http://arbiter.wipo.int/domains/decisions/html/2000/d2000-0505.html> and WIPO Case D2000-0617, available at <http://arbiter.wipo.int/domains/decisions/html/d2000-0617.html>.
- ⁵⁶ WIPO Case D2000-1728, available at <http://arbiter.wipo.int/domains/decisions/html/2000/d2000-1278.html>.
- ⁵⁷ WIPO Case D2001-0001, available at <http://arbiter.wipo.int/domains/decisions/html/2001/d2001-0001.html>.
- ⁵⁸ WIPO Case D2001-0002, available at <http://arbiter.wipo.int/domains/decisions/html/2001/d2000-0002.html>.
- ⁵⁹ WIPO Case D2001-0047, available at <http://arbiter.wipo.int/domains/decisions/html/2001/d2001-0047.html>.
- ⁶⁰ WIPO Case D2001-0069, available at <http://arbiter.wipo.int/domains/decisions/html/2001/d2001-0069.html>.
- ⁶¹ WIPO Case D2001-0321, available at <http://arbiter.wipo.int/domains/decisions/html/2001/d2001-0321.html>.
- ⁶² WIPO Case D2001-0348, available at <http://arbiter.wipo.int/domains/decisions/html/2001/d2001-0348.html>.
- ⁶³ WIPO Case D2001-0566, available at <http://arbiter.wipo.int/domains/decisions/html/2001/d2001-0566.html>.
- ⁶⁴ The policy of .AU on this question is currently under review. For more information, see Section 4.2 of Review of Policies in .AU Second Level Domains, Public Consultation Report, auDA Name Policy Advisory Panel (November 2000), available at <http://www.ada.org.au/panel/name/papers/publicreport.html>. Until November 15, 2000, .NL also restricted the registration of domain names corresponding to city and province names. Since that date, these restrictions have been removed. However, in its comments on WIPO2 RFC-2, the Dutch Ministry of Transport, Public Works and Water Management stated that it is advisable to protect geographical terms against their bad faith, abusive, misleading or unfair registration and use in the DNS.
- ⁶⁵ See .CA registration policy at http://www.cira.ca/en/cat_Registration.html.
- ⁶⁶ See .DZ registration policy at <http://www.nic.dz/francais/precision.htm>.
- ⁶⁷ See .ES registration policy at <http://www.nic.es/normas/index.html>.

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⁶⁸ See .FR registration policy at <http://www.nic.fr/enregistrement/fondamentaux.html>.

⁶⁹ See .PE registration policy at <http://www.nic.pe/interna/normas.htm>.

⁷⁰ See .SE registration policy at <http://www.iis.se/regulations.shtml>.

⁷¹ For instance, for .AU, this is Australian Surveying and Land Information Group's database of Australian place names.

⁷² See, for instance, the work conducted since 1982 by the United Nations Commission on Human Rights, its Sub-Commission on Prevention of Discrimination and Protection of Minorities, and the Sub-Commission's Working Group on Indigenous Populations. More particularly in the area of intellectual property, see WIPO's work on traditional knowledge, innovations and creativity, information about which is available at <http://wipo.int/traditionalknowledge/introduction/index.html>.

⁷³ See Comment of United States of America, U.S. Patent and Trademark Office (USPTO) (RFC-3 - June 14, 2001), Comment of United States of America, Office of Advocacy: U.S. Small Business Administration (RFC-3 - June 15, 2001), Comment of Association for Computing Machinery's Internet Governance Project, Electronic Privacy Information Center (RFC-3 - June 15, 2001), Comment of *Fédération internationale des conseils en propriété industrielle* (FICPI) (RFC-3 - June 14, 2001), Comment of International Association for the Protection of Industrial Property (AIPPI), (RFC-3 - June 18, 2001), Comment of the International Chamber of Commerce (ICC) (RFC-3 - June 18, 2001), Comment of International Trademark Association (INTA) (RFC-3 - May 24, 2001), Comment of EasyLink Services Corporation (RFC-3 - January 1, 2001), Comment of Icanchannel.de (RFC-3 - June 15, 2001), Comment of Michael Froomkin (RFC-3 - June 4, 2001). For similar views expressed in response to RFC-2, see also Comment of Tim Heffley, Z-Drive Computer Service (RFC-2 - December 19, 2000), Comment of Alexander Svenssen (RFC-2 - December 21, 2000), Comment of Christa Worley (RFC-2 - December 29, 2000).

⁷⁴ See Comment of Cyprus, Government of Cyprus (RFC-3 - June 7, 2001), Comment of South Africa, Ministry of Telecommunications (RFC-3 - June 7, 2001), Comment of United Kingdom, The Patent Office (RFC-3 - June 1, 2001), Comment of European Commission (RFC-3 - June 25, 2001), Comment of American Intellectual Property Law Association (AIPLA) (RFC-3 - June 7, 2001), Comment of Auckland District Law Society, Law & Technology Committee (RFC-3 - June 22, 2001), Comment of Brazilian Association of Intellectual Property (ABPI) (RFC-3 - June 8, 2001), Comment of Japan Network Information Center (JPNIC) (RFC-3 - June 8, 2001), Comment of UAEnic (RFC-3 - June 6, 2001), Comment of Elzaburu (Luis H. De Larramendi) (RFC-3 - June 14, 2001). For similar views expressed in response to RFC-2, see also Comment of Netherlands, Ministry of Transport, Public Works and Water Management (RFC-2 - December 20, 2000), Comment of South Africa, Government of South Africa (RFC-2 - March 2, 2001) Comment of European Commission (RFC-2 - January 16, 2001).

⁷⁵ See Comment of South Africa, Ministry of Telecommunications (RFC-3 - June 7, 2001).

⁷⁶ See Comment of United States of America, U.S. Patent and Trademark Office (USPTO) (RFC-3 - June 14, 2001), Comment of United States of America, Office of Advocacy: U.S. Small Business Administration (RFC-3 - June 15, 2001), Comment of Association for Computing Machinery's Internet Governance Project, Electronic Privacy Information Center (RFC-3 - June 15, 2001), Comment of International Association for the Protection of Industrial Property (AIPPI), (RFC-3 - June 18, 2001). For similar views expressed in response to RFC-2, see also Comment of Australia, Government of Australia (RFC-2 - January 2001), Comment of Brazilian Association of Intellectual Property (ABPI) (RFC-2 - December 28, 2000), Comment of Christa Worley (RFC-2 - January 4, 2001).

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- 77 See Comment of United States of America, Office of Advocacy: U.S. Small Business Administration (RFC-3 – June 15, 2001), Comment of Association for Computing Machinery’s Internet Governance Project, Electronic Privacy Information Center (RFC-3 – June 15, 2001), Comment of EasyLink Services Corporation (RFC-3 – January 1, 2001).
- 78 See Comment of United States of America, Office of Advocacy: U.S. Small Business Administration (RFC-3 – June 15, 2001), Comment of International Trademark Association (INTA) (RFC-3 – May 24, 2001), Comment of EasyLink Services Corporation (RFC-3 - January 1, 2001).
- 79 See Comment of EasyLink Services Corporation (RFC-3 – January 1, 2001).
- 80 See Comment of United States of America, U.S. Patent and Trademark Office (USPTO) (RFC-3 – June 14, 2001), Comment of *Fédération internationale des conseils en propriété industrielle* (FICPI) (RFC-3 – June 14, 2001).
- 81 See Comment of United Kingdom, The Patent Office (RFC-3 – June 1, 2001), Comment of European Commission (RFC-3 – June 25, 2001), Comment of Auckland District Law Society, Law & Technology Committee (RFC-3 – June 22, 2001), Comment of International Association for the Protection of Industrial Property (AIPPI), (RFC-3 – June 18, 2001), Comment of Japan Network Information Center (JPNIC) (RFC-3 – June 8, 2001).
- 82 See Comment of Association for Computing Machinery’s Internet Governance Project, Electronic Privacy Information Center (RFC-3 – June 15, 2001), Comment of CentralNic (RFC-3 – May 25, 2001), Comment of Fish & Richardson P.C. (RFC-3 – June 14, 2001).
- 83 See Comment of CentralNic (RFC-3 – May 25, 2001).
- 84 See Comment of International Trademark Association (INTA) (RFC-3 – May 24, 2001).
- 85 See Comment of Canada, Government of Canada (RFC-3 – July 5, 2001), Comment of Auckland District Law Society, Law & Technology Committee (RFC-3 – June 22, 2001), Comment of Christine Haight Farley (RFC-3 – June 11, 2001).
- 86 See, in this respect, United Nations Terminology Bulletin No. 347/Rev.1, States Members of the United Nations, Members of the Specialized Agencies or Parties to the Statute of the International Court of Justice, ST/CS/SER.F/347/Rev.1.
- 87 See Comment of European Brands Association (AIM) (RFC-2 - December 20, 2000).
- 88 See also the discussion of Article 6*ter* in the preceding chapters of this Report.
- 89 See Comment of South Africa, Ministry of Communications (RFC-3 – June 7, 2001).
- 90 See paragraph 264 of the Interim Report.
- 91 See WIPO Document PR/WGAO/II/6.
- 92 See Basic Proposals for the Diplomatic Conference on the Revision of the Paris Convention for the Protection of Industrial Property (Geneva, February 4 to March 4, 1980).
- 93 See WIPO Document PR/SM/9.
- 94 See paragraph 34 of the Report of the first WIPO Process where it is stated that “[t]he goal of this WIPO Process is not to create new rights of intellectual property, nor to accord greater protection to intellectual property in cyberspace than that which exists elsewhere. Rather, the goal is to give proper and adequate expression to the existing, multilaterally agreed standards of intellectual property protection in the context of the new, multijurisdictional and vitally important medium of the Internet and the DNS that is responsible for directing traffic on the Internet.”
- 95 Appendix K is available at <http://www.icann.org/tlds/agreements/unsponsored/registry-agmt-appk-26apr01.htm>.
- 96 See pages VIII and 1 of International Standard ISO 3166-1 (Ref. no.: ISO 3166-1:1997 (E/F)).
- 97 The same questions arise irrespective of whether the term registered at the second level is an ISO 3166 code or another term. While the problem therefore is of a general nature affecting all

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registrations at levels below the second level, it is discussed here in the context of the registration of country codes at the second level.

⁹⁸ See Comment of CentralNic (RFC-3 – May 25, 2001).

⁹⁹ See Comment of Canada, Government of Canada (RFC-3 – July 5, 2001), Comment of Auckland District Law Society, Law & Technology Committee (RFC-3 – June 22, 2001), Comment of Christine Haight Farley (RFC-3 – June 11, 2001).

¹⁰⁰ For more information on this Program, see www.wipo.int/globalissues/index-en.html.

7. TRADE NAMES

298. A trade name is the designation adopted by a commercial enterprise to describe itself and to distinguish it from other businesses and enterprises. Trade names are also referred to variously as company, corporate, business or firm names, although each of these identifiers may sometimes attract slightly different legal or regulatory conditions. Common examples of familiar trade names are Ericsson, General Motors, Holiday Inn, Lego, Microsoft, Nestlé, Philips, Procter & Gamble and Sony. A trade name may also be registered and separately protected as a trademark, as most of the foregoing examples are.

299. The present Chapter reviews the legal protection of trade names at the international and national levels; analyses the comments received in response to the proposals contained in the Interim Report concerning the protection of trade names against abusive registration and use as domain names; and formulates a recommendation on the treatment of trade names within the DNS.

THE INTERNATIONAL PROTECTION OF TRADE NAMES

300. The Paris Convention for the Protection of Industrial Property (the Paris Convention) establishes a norm requiring the protection of trade names in all States party to the Convention. Article 8 provides as follows:

“A trade name shall be protected in all the countries of the Union without the obligation of filing or registration, whether or not it forms part of a trademark.”

301. Article 8 of the Paris Convention is a broadly formulated rule, which leaves a great deal to national implementation. It comprises three elements that restrict national implementation, but otherwise leaves freedom at the national level. Those three elements are:

- (i) A State party to the Paris Convention must provide protection for trade names;
- (ii) Protection must be extended without the condition of registration; and

(iii) The protection must be independent of the protection accorded to trademarks, even if the trade name is also registered as a trademark.

302. The freedom left to States to implement trade name protection at the national level includes, notably, two important areas. The first of those is the definition of what constitutes a trade name and, thus, the conditions that must be satisfied by a designation in order to qualify as a trade name. Various conditions are applied, including the requirement of inherent or acquired distinctiveness, the requirement of use and the requirement of the establishment of reputation or goodwill in the trade name. The second area left to national law is the scope of protection accorded to trade names. Protection is not absolute and is usually defined by reference to one or both of two factors, namely, the field of trade activity in which the trade name is used (thus, for example, the trade name of an enterprise in the field of information technology may only enjoy protection in that particular field); and the geographical area over which the trade name enjoys a reputation (thus, for example, the trade name of a baker's shop may be protected only in the village and commune in which it is found, whereas the trade name of a transnational enterprise may enjoy protection that is commensurate with the geographical area in which that enterprise operates).

NATIONAL PROTECTION OF TRADE NAMES

303. In view of the large scope left to national implementation by Article 8 of the Paris Convention, WIPO conducted, in the course of the Second WIPO Process, a survey of its Member States to gather information about the manner in which different countries have implemented trade name protection. The questionnaire and analysis of the responses received from 72 countries are set out at Annex XV hereto. It is evident that the protection of trade names at the national level is variously implemented through a single law or a combination of civil and criminal law, commercial law, trade practices, trade name and trademark legislation and common law principles of unfair competition¹ or 'passing-off'.²

304. There are clearly wide variations in countries' approaches to the protection of trade names. In view of the absence of internationally harmonized protection, some commentators

to the Second WIPO Process opposed the extension of protection of trade names from the physical world to the DNS.³ Others, however, took the view that a means of protection for trade names could be established which would recognize the diversity of approaches and still provide protection for this important and valuable form of industrial property.⁴ One commentator remarked that, indeed, a failure to protect trade names in the DNS would contravene the international law established by the Paris Convention.⁵

305. As an illustration of the differing treatment accorded to trade names, one commentator noted that in the Scandinavian countries of Denmark, Finland, Norway and Sweden, businesses are protected more commonly through registered trade name protection than through trademark law, and trade names may receive stronger protection than trademarks. This commentator suggested that decisions on disputes between entities that originate from such countries should be determined in light of their local law.⁶

PROTECTION OF TRADE NAMES IN THE DNS

306. National legal systems have developed to accommodate the co-existence of trade names, and enable many businesses to trade in different jurisdictions or in different fields of industry using identical or similar trade names, without conflict. The DNS, at least in the present gTLD space, cannot reflect this plurality, as each domain name is unique and global. Problems may arise for businesses that use their trade names in commerce, and find that the corresponding domain name has been registered by another. In the case of competing claims to a trade name among legitimate users, the first-come, first-served principle of domain name registration applies. However, conflict arises when a trade name has been registered or used in bad faith as a domain name by a third party with no rights to the name, resulting in potential damage to the trade name owner's business reputation, or limiting its capacity to establish a trading presence on the Internet.

307. Some national courts have recognized the rights of trade name owners to prevent others from registering and using their trade names as domain names. In the United States of America, for example, the Federal Lanham Act⁷ gives trade name owners a civil cause of

action against any use of a trade name that misrepresents the source of the goods or services, or is likely to cause confusion regarding their source. This protection has been extended to the unlawful use of trade names as domain names in the decision *U.S. v. Washington Mint, LLC*.⁸ In Germany, the courts have found in favor of owners of ‘name rights’ in cases where the domain name registrant was unable to establish any legitimate interests in the name, in the Düsseldorf Court of Appeal’s decision with respect to the domain name “ufa.de”, for example.⁹ The German courts have readily found against domain name registrants where their use of a commercial name in the DNS is liable to cause confusion or mislead the public,¹⁰ at the same time upholding the rights of domain name registrants who have legitimate rights in the underlying trade name.¹¹

308. In the DNS at the level of country-code top-level domains (ccTLDs), many registration authorities impose restrictions on the commercial entities that may register names in their domain, particularly in any second-level domains chartered for commercial use. Many ccTLD administrators require applicants to warrant that their domain name does not infringe the legal or other rights of third parties. However, among respondents to the WIPO trade names questionnaire, a minority of ccTLD administrators require applicants to assert or prove their legitimate right to register a commercial or trade name as a domain name.¹²

309. Evidently there exists no uniform or robust protection for trade names in the DNS. As a result, in the event of abuse, business owners are required either to concede the right to use their trade name online when confronted with its abusive or bad faith registration as a domain name, or else attempt to defend their legal rights through national judicial systems.

ANALYSIS OF COMMENTS AND VIEWS EXPRESSED IN RESPONSE TO THE INTERIM REPORT

310. The Interim Report requested further submissions of evidence of the extent of abusive registrations of trade names as domain names. While few comments were received from trade name owners subject to such abuse, a majority of comments were nevertheless in favor of protection of trade names, as discussed below. Some commentators pointed to the lack of

evidence of significant abuse of trade names to argue that protection was therefore unnecessary.¹³ However one comment from the administrator of .UK estimated that half of the 1,400 disputes handled to date by its Dispute Resolution Service concerned trade names, rather than trademarks or personal names, typically involving small localized businesses and that a “relatively high proportion of those cases show evidence of abusive registration, often as a result of ‘board room fall-out’, competitors in a narrow geographical area, or an individual warehousing names of businesses in the local area.”¹⁴

311. The majority of commentators to the Second WIPO Process favored the protection of trade names in the DNS through an administrative dispute resolution process that would enable trade name owners to protect the good will and reputation associated with their name against bad faith, abusive, misleading or unfair use as a domain name.¹⁵ Commentators widely recognized that trade names perform the same ‘origin function’ as trademarks, indicating the source or nature of the business entity they represent, and perform the same investment or advertising function. To the extent that trade names serve an identifying function, like trademarks, there was support for their protection in the DNS, equivalent to that accorded to trademarks.

312. The means of protection favored by most commentators to the Second WIPO Process was the extension of the UDRP, which at present applies only to trademarks and service marks, to cover trade names.¹⁶ It was noted that to the extent that most trade names also function as trademarks, as such, they are already protectable under the UDRP.¹⁷ One commentator noted that extending the UDRP to cover trade names would overcome the current discrepancy and unfairness that results in the situation that personal names that also function as unregistered trademarks can be protected under the UDRP only in those jurisdictions where such unregistered rights are recognized, but not in jurisdictions such as Switzerland or France, where unregistered rights are not accorded protection.¹⁸

313. A significant minority of commentators were opposed to any protection being extended to trade names, principally because of the difficulty of harmonizing the various national approaches into a cohesive policy to apply in the DNS.¹⁹ In this context, it was suggested that protection for trade names in the DNS should be applied on a country-by-country basis,

depending on local application of the Paris Convention under national law.²⁰ This approach could be accommodated, in the context of UDRP, where panelists determine cases in relation to the circumstances of each case and the applicable principles of national law. Some commentators noted that trade names, unlike trademarks, are broadly defined, unregistered and unregulated and that, as a result, their protection in the DNS could compromise individual rights²¹ and impact upon small businesses.²² Commentators also noted that numerous identical trade names may legitimately co-exist in different jurisdictions, in contrast to the unique global presence offered by a domain name.²³ It is noted that, by way of analogy, the co-existence of trademarks in various jurisdictions is currently accommodated under the UDRP by the requirement of a showing of bad faith registration and use of the domain name by the respondent. If a respondent is able to demonstrate a co-existing legitimate use of the name, the complainant's case is not made out, and the respondent retains its use of the domain name.

314. As with other identifiers addressed in this Report, commentators expressed some concern at the retrospective application of any mechanism of protection for trade names, noting that some business owners could be injured as a result.²⁴ In addition, some commentators remarked that any system instituted to protect trade names in the DNS could be used to hijack names from individuals and smaller enterprises.²⁵

315. Most commentators supported the protection of trade names in all existing and new gTLDs, and particularly in ccTLDs, where the national relevance of trade names lends support to their protection.²⁶ Some commentators noted the potential for differentiation in the DNS, and suggested that trade names should only receive protection in gTLDs with a commercial charter,²⁷ or that remedies should take into account the nature of the gTLD in question.²⁸ Others remarked upon the potential for differentiation between TLDs to lessen the risk of confusion resulting from registration of trade names in the DNS.²⁹

316. There was general support for the multifactor analysis proposed in the Interim Report, concerning the constituent factors to be considered in determining whether a trade name warrants protection in any given case.³⁰ In highlighting those factors considered most relevant for such determinations, commentators focused upon evidence of company name

registration (if applicable), evidence of use and established reputation in a particular field of business, use of the domain name in a same or similar field of interest to the trade name, and whether the trade name had acquired secondary meaning.³¹ One commentator stated that complainants should be required to prove that their trade name has become distinctive as an indication of source,³² and to prove their trade name's inherent or acquired distinctiveness by 'clear and convincing evidence'.³³ Some commentators stated that any protection of trade names in the DNS should not extend to generic words,³⁴ whether or not they had acquired distinctiveness through use.

317. It was also suggested that the current UDRP definition of 'bad faith abusive, misleading or unfair registration and use' in respect of trademarks could simply be adjusted to apply to trade names.³⁵ As noted by one commentator, the real issue is to determine what constitutes 'abuse' of a trade name: "Any *abuse* of a sign in the scope of the Domain Name System should – as well as in the 'real world' – not be tolerated and therefore be prevented".³⁶ Proof of bad faith was seen as critical by commentators, in order to prevent reverse domain name hijacking.³⁷ In this regard, it was also stated that commercial entities should not automatically take precedence over non-commercial entities in relation to the use of trade names as domain names.³⁸ In any conflict between two entities with legitimate rights in the name, it was noted by one commentator that the matter should be left to a court of competent jurisdiction to decide.³⁹

RECOMMENDATION

318. Despite the majority opinion that protection should be extended to trade names within the DNS, we do not consider that it is appropriate to modify the UDRP so as to allow complaints for the bad faith and misleading registration and use of trade names as domain names for the following reasons:

(i) The international legal principle for the protection of trade names leaves extensive scope to differing national implementations, which is reflected in the diversity of national approaches that was found to exist with respect to the protection of trade names.

This national diversity inevitably creates a problem for the choice of applicable law on a global medium. The situation of trade names is, in this respect, akin to that of geographical indications insofar as it would be necessary for a dispute-resolution panel, in the absence of convergent national approaches, to identify the national law that should be applied to determine the existence of a protectable trade name. We do not believe that the law is sufficiently clear on this question, with the consequence that there would be a risk of lack of coherence in decisions, which might engender dissatisfaction and lack of understanding of the procedure.

(ii) The practice in the use of trade names covers a very large range of commercial activity, including very small one-person enterprises operating in very limited geographical areas, as well as very large enterprises operating in global markets. It is certainly the case that very small enterprises operating in limited geographical areas deserve protection for their trade names when the conditions of eligibility for the protection are satisfied. Whether those conditions of eligibility can be identified with precision for disputes in gTLDs on a global medium, however, is problematic. Where a trade name is used in widespread markets, it is often also the subject of trademark protection or satisfies the conditions for protection as an unregistered trademark so as to qualify, in appropriate circumstances, for protection against bad faith, deliberate misuse under the UDRP.

(iii) The UDRP was designed for, and applies to, straight-forward disputes, where there are rights on one side and no rights or legitimate interests on the other side. It was not designed to accommodate disputes involving interests on both sides, which requires a more extensive procedure, perhaps involving the hearing of evidence and oral arguments. Many trade name disputes, because of the relatively light burden imposed to establish eligibility for trade name protection, will involve interests on both sides.

(iv) We are not convinced that sufficient evidence was produced of widespread abuse of trade names through domain name registrations and use.

319. It is not recommended that the UDRP be modified to permit complaints to be made on

*the basis of abusive registrations and use of
trade names per se.*

320. In the case of ccTLDs, we believe that much greater scope exists for allowing complaints under a dispute-resolution procedure for abusive registrations of trade names. Within the ccTLD, the problem of diversity does not exist in the same way and there is greater scope for applying the relevant national implementation of protection of trade names.

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- ¹ See Comment of Switzerland, Swiss Federal Institute of Intellectual Property (RFC-3 – June 1, 2001).
- ² Refer generally to the analysis of the passing-off action in W.R. Cornish, *Intellectual Property: Patents, Copyright, Trade Marks and Allied Rights*, (4th ed.) (Sweet & Maxwell, 1999) at Chapter 16, and in T.A. Blanco White and Robin Jacob, *Kerly's Law of Trade Marks and Trade Names*, (12th ed.) (Sweet & Maxwell, 1986) at Chapter 16.
- ³ See Comment of Hungary, Hungarian Patent Office (RFC-3 – June 13, 2001), Comment of *Fédération internationale des conseils en propriété industrielle* (FICPI) (RFC-3 – June 14, 2001), Comment of International Chamber of Commerce (ICC) (RFC-3 – June 18, 2001), Comment of European Brands Association (AIM) (RFC-2 – December 20, 2000), Comment of ACM Internet Governance Project (RFC-1 – September 15, 2000).
- ⁴ See Comment of Brazilian Association of Intellectual Property (ABPI) (RFC-2 – December 28, 2000), Comment of Steven Turnbull, University of Tsukuba (RFC-1 – August 29, 2000).
- ⁵ See Comment of Mexico, National Institute of Copyright (RFC-3 – May 30, 2001).
- ⁶ See Comment of Dipcon – Domain Name and Intellectual Property Consultants AB (RFC-2 – December 22, 2000).
- ⁷ See 15 U.S.C., § 1125(a).
- ⁸ See 15 *F. Supp.*2d 1089 (D.Minn, 2000).
- ⁹ Decision of September 30, 1997 – 4 O 179/97, finding in favor of the UFA-Film-und Fernseh GmbH & Co KG, which had rights in the designation 'UFA'. Similarly, the Munich District Court, in a decision of October 21, 1998 – 1 HK O 167 16/98, found against the domain name registrant of "muenchner-rueck.de", as an unauthorized use of the commercial designation 'Münchner Rückversicherung'.
- ¹⁰ See, for example, the decision of the Stuttgart Court of Appeal in a decision of February 3, 1998 – 2 W 77/97, finding that "steiff.com" infringed the name rights of the soft toy manufacturer, Steiff.
- ¹¹ The Bonn District Court, in a decision of September 22, 1997 – 1 O 374/97, found that the domain name registrant for "dtag.de" had a legitimate interest in his domain and, applying the principle that any person may participate in business under his own name, found that Section 12 of the Civil Code did not apply.
- ¹² The following ccTLD registration authorities restrict the registration of trade names as domain names: .AD (Andorra), .AM (Armenia), .AT, (Austria), .AU (Australia), .BB (Barbados), .CH (Switzerland), .CO (Colombia), .CY (Cyprus), .ES (Spain), .FI (Finland), .FR (France), .HU (Hungary), .IE (Ireland), .KH (Cambodia), .LT (Lithuania), .NO (Norway), .SA (Saudi Arabia), .SE (Sweden), .SI (Slovenia), .SM (San Marino), .TH (Thailand), .TR (Turkey) and .UK (United Kingdom). The majority of ccTLD administrators impose no restrictions on domain

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name applications based on trade names as follows: .AR (Argentina), .BE (Belgium), .BF (Burkina Faso), .BG (Bulgaria), .BH (Bahrain), .BN (Benin), .BY (Belarus), .CA (Canada), .CR (Costa Rica), .DE (Germany), .DK (Denmark), .EC (Ecuador), .GE (Georgia), .GT (Guatemala), .HN (Honduras), .HU (Hungary), .KG (Kyrgyzstan), .KH (Cambodia), .KR (Republic of Korea), .LT (Lithuania), .MA (Morocco), .MD (Moldova), .MK (the Former Yugoslav Republic of Macedonia), .MN (Mongolia), .MU (Mauritius), .MX (Mexico), .PT (Portugal), .RO (Romania), .RU (Russian Federation), .SG (Singapore), .UA (Ukraine), .US (United States of America) and .UZ (Uzbekistan).

¹³ See Comment of Japan, Ministry of Economy, Trade and Industry (METI) (RFC-3 – July 5, 2001), Comment of Michael Froomkin (RFC-3 – June 4, 2001).

¹⁴ See Comment of Nominet UK (RFC-3 – June 14, 2001).

¹⁵ See Comment of United Kingdom, The Patent Office (RFC-3 – June 1, 2001), Comment of European Commission (RFC-3 – June 25, 2001), Comment of Associations des Praticiens en droit des Marques et des Modèles (RFC-3 – June 7, 2001), Comment of American Intellectual Property Law Association (AIPLA) (RFC-3 – June 7, 2001), Comment of Brazilian Association of Intellectual Property (ABPI) (RFC-3 – June 8, 2001), Comment of European Broadcasting Union (EBU) (RFC-3 – June 8, 2001), Comment of International Association for the Protection of Industrial Property (AIPPI) (RFC-3 – June 18, 2001), Comment of Law and Technology Committee, Auckland District Law Society (RFC-3 – June 22, 2001), Comment of Nominet UK (RFC-3 – June 14, 2001), Comment of Christian Mogensen (RFC-3 – April 16, 2001), Comment of Daniel R. Tobias (RFC-3 – April 15, 2001). See also Comment of Australia, Government of Australia (RFC-2 – January 23, 2001), Comment of Republic of Moldova, State Agency on Industrial Property Protection (RFC-2 – December 29, 2000), Comment of European Brands Association (AIM) (RFC-2 – December 20, 2000), Comment of Asociación Interamericana de la Propiedad Industrial (ASIFI) (RFC-2 – December 26, 2000), Comment of rexco.com (Des Donnelly) (RFC-1 – August 5, 2000), Comment of the Association of European Trade Mark Owners (MARQUES) (RFC-2 – December 22, 2000), Comment of Matthias Haeuptli (RFC-2 – September 15, 2000).

¹⁶ Indeed, the Administrative Panel in WIPO Case D2000-0025 *SGS Société générale de surveillance S.A. v. Inspectorate* (March 17, 2000) stated: “The Panel considers that the Policy and Rules refer only to identity or similarity to trademarks and service marks in which a complainant has rights. No reference is made in the Policy and Rules to *trade names* in which a complainant has rights.” In another WIPO Case D2000-0638 *Manchester Airport PLC v. Club Club Limited* (August 22, 2000), the three-member Administrative Panel found against a Complainant who had asserted that the domain name registered by the Respondent was identical to a name under which it traded, and that the respondent was passing off of the complainant’s unregistered rights in its corporate name. The majority of the Panel found that there was insufficient evidence of corresponding trademark rights in the name and that the UDRP did not address passing-off.

¹⁷ See Comment of *Fédération internationale des conseils en propriété industrielle* (FICPI) (RFC-3 – June 14, 2001), Comment of International Trademark Association (INTA) (RFC-3 – May 24, 2001), Comment of Chris Brand (RFC-3 – April 16, 2001), Comment of Michael Froomkin (RFC-3 – June 4, 2001).

¹⁸ See Comment of Switzerland, Swiss Federal Institute of Intellectual Property (RFC-3 – June 15, 2001).

¹⁹ See Comment of Hungary, Hungarian Patent Office (RFC-3 – June 13, 2001), Comment of *Fédération internationale des conseils en propriété industrielle* (FICPI) (RFC-3 – June 14, 2001), Comment of International Chamber of Commerce (ICC) (RFC-3 – June 18, 2001). See also Comment of United States of America, United States Council for International Business

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- (RFC-2 – December 29, 2000), Comment of European Brands Association (AIM) (RFC-2 – December 20, 2000), Comment of 14us2.com (Billy Reynolds) (RFC-1 – August 15, 2000), Comment of Ben Hwang (RFC-1 – August 11, 2000), Comment of Edwin Philogene (RFC-1 – August 11, 2000).
- 20 See Comment of Brazilian Association of Intellectual Property (ABPI) (RFC-2 – December 28, 2000).
- 21 See Comment of Bernard H.P. Gilroy (RFC-1 – August 11, 2000), Comment of Jay Orr (RFC-1 – August 14, 2000).
- 22 See Comment of United States of America, Office of Advocacy, U.S. Small Business Administration (RFC-3 – June 15, 2001).
- 23 See Comment of Gregory Rippel, U.S. Realty Corp. (RFC-1 – August 19, 2000), Comment of John Apolloni (RFC-1 – August 14, 2000), Comment of Alexander Svensson (RFC-2 – December 21, 2000).
- 24 See Comment of United Kingdom, The Patent Office (RFC-3 – June 1, 2001), Comment of Frank Azzurro (RFC-1 – August 15, 2000).
- 25 See Comment of American Civil Liberties Union (ACLU) (RFC-2 – December 29, 2000), Comment of Leah Gallegos, TLD Lobby (RFC-1 – August 16, 2000), Comment of NewsBank, Inc. (RFC-1 – August 12, 2000), Comment of Edwin Philogene (RFC-1 – August 11, 2000), Comment of Joseph Fowler (RFC-1 – August 11, 2000), Comment of Atilda Alvarido (RFC-1 – August 12, 2000).
- 26 See Comment of Hungary, Hungarian Patent Office (RFC-3 – June 13, 2001), Comment of Mexico, Mexican Institute of Industrial Property (IMPI) (RFC-3 – June 5, 2001), Comment of European Commission (RFC-3 – June 25, 2001), Comment of Law and Technology Committee, Auckland District Law Society (RFC-3 – June 22, 2001).
- 27 See Comment of Forrester Rupp (RFC-1 – August 14, 2000), Comment of Security Privacy and Internet Equity Symposium of 16/12/00 of the Key West Institute S6/Consortium Board (RFC-2 – December 22, 2000).
- 28 See Comment of Australia, Government of Australia (RFC-2 – January 23, 2001).
- 29 See Comment of American Civil Liberties Union (ACLU) (RFC-2 – December 29, 2000).
- 30 See, for example, Comment of American Intellectual Property Law Association (AIPLA) (RFC-3 – June 7, 2001).
- 31 See Comment of Australia, Government of Australia (RFC-2 – January 23, 2001).
- 32 See Comment of American Intellectual Property Law Association (AIPLA) (RFC-2 – December 29, 2000).
- 33 See Comment of Weikers & Co., Attorneys at Law (RFC-1 – August 11, 2000).
- 34 See Comment of Security Privacy and Internet Equity Symposium of 16/12/00 of the Key West Institute S6/Consortium Board (RFC-2 – December 22, 2000), Comment of Raysend (RFC-1 – August 11, 2000).
- 35 See UDRP Rule 4.b. See Comment of Australia, Government of Australia (RFC-2 – January 23, 2001).
- 36 See Comment of Switzerland, Swiss Federal Institute of Intellectual Property (RFC-2 – December 29, 2000).
- 37 See Comment of Security Privacy and Internet Equity Symposium of 16/12/00 of the Key West Institute S6/Consortium Board (RFC-2 – December 22, 2000), Comment of Raysend (Mark James Adams) (RFC-1 – August 11, 2000).
- 38 See Comment of The Law Society of Scotland (RFC-2 – January 4, 2001).
- 39 See Comment of International Trademark Association (INTA) (RFC-2 – January 4, 2001).

8. THE ROLE OF TECHNICAL MEASURES

321. As described in the first Chapter of this report, the Domain Name System (DNS) is undergoing rapid evolution, as millions of new domain names are registered, currently numbering over 35 million and forecast to exceed 75 million domain names by 2002,¹ new top level domains are added, and new language scripts are sought to be accommodated. In this context, the request addressed to WIPO to initiate the Second WIPO Process also noted that “in undertaking the process, it would be beneficial if any information received or collected concerning technical solutions to domain name collision control was collated for the information of WIPO Members and the Internet community.” This Chapter provides a collation of the material received during the course of these consultations, and points to areas of current need, as well as future possibilities in ameliorating conflict in the evolving DNS.

322. At various points in this Report, suggestions had been made about the appropriate fora for the development of new intellectual property law or policy, if such new law or policy is considered to be desirable by the international community. Just as the creation of new law has appropriate fora, the oversight of technical measures and operational questions has an appropriate forum. The management of the operational stability of the DNS falls squarely within the Articles of Incorporation of the Internet Corporation for Assigned Names and Numbers (ICANN). The ensuing analysis of the role of technical measures, therefore, must be understood as a contribution, from the perspective of intellectual property, to questions for which ICANN has responsibility of oversight.

THE WHOIS DATA SEARCH FACILITIES

323. The Whois system of databases is the collection of information concerning domain name registrants’ contact details that are required to be gathered by domain name registrars. The Whois databases, of which there are increasing numbers separately in respect of gTLDs and ccTLDs, contain data provided by domain name registrants in the course of entering a contract for a domain name registration. The Whois information, including the contact details of the registrant, as well as nominated technical and administrative contacts and associated

technical data, is not routinely checked for veracity or completeness at the initial stage, and is automatically included in the applicable Whois database. Nor are checks made as a matter of course to ensure that the information is kept up-to-date. Most Whois databases are publicly available online, for real-time searching by all enquirers.

324. The Whois search facilities are used principally by members of the public to determine the identity of domain name registrants and the technical and administrative contacts for the web site hosts. The searches are employed by many users for various legitimate purposes – including by rightsholders to identify and locate possible infringers of their rights in order to enforce those rights, to allow consumers to identify online merchants, to source unsolicited e-mail and to enable law enforcement authorities to investigate illegal activity, including consumer fraud.² As first intended, the Whois also provides a crucial resource for network administrators who may need to correct network problems or determine the perpetrators of spam or hacking attacks. In a dispute-resolution context, the availability of accurate Whois data is also vital to ensure that registrants are notified of any legal or administrative UDRP proceedings against them, and thereby to ensure due process. Similarly, rightsholders employing ‘notice and takedown’ provisions under national laws, such as the United States Digital Millennium Copyright Act, depend upon Whois resources to match infringing sites with affiliated service providers for notification purposes.³ In its multiple capacities, the Whois plays a critical role in the prevention and resolution of conflict in the DNS. At a time when the inscrutability of the Internet is increasingly a cause for concern among consumers, users and their advocates, one commentator remarked that:

“Public accessibility to such data provides much needed transparency in the DNS and accountability for those who hold themselves out to the public over the Internet. ... This transparency and accountability serves to both facilitate the redress of abusive and unlawful conduct in the DNS and to deter such conduct in the first place.”⁴

325. It is also recognized that the data in Whois databases could be accessed for invalid purposes, with the potential for invasion of personal privacy, and appropriate consideration must be given to means to prevent such injurious conduct, while maintaining an effective and accessible search facility for legitimate users.

COMPREHENSIVE WHOIS SEARCH FACILITIES

326. The Interim Report asked whether the Whois system, as it currently operates, is adequate to fulfil its dispute-prevention function, or whether it should be extended in any of three ways:

- (i) to enable Whois searches across any new open gTLDs;
- (ii) to enable searches across the Whois databases of all registrars; and
- (iii) to enable searches across the Whois databases of all registrars for more than just the exact domain name.

327. Of all the technical issues raised for discussion, the Whois search facilities excited the most forceful comment. The vast majority of commentators were strongly in favor of promoting the integrity of Whois information.⁵ To the intellectual property community of rightsholders and consumers, Whois databases are essential for evaluating and protecting intellectual property rights, for combating online copyright piracy and for facilitating the licensed use of copyright materials online.⁶

328. The issue of Whois search capacity is not new – it has been the focus of fierce debate in the course of the first WIPO Process and is now the subject of a survey being conducted by the Domain Names Supporting Organization (DNSO) of ICANN.⁷ The first WIPO Process Report recommended that the contact details of all holders of domain names in all open gTLDs should be made publicly available in real time.⁸ The Report recommended that, at least for so long as the gTLDs remain undifferentiated, the public availability of these details is essential, and reflects the well established principle of open availability of contact details of business enterprises operating in the commercial sphere. It was also recommended that the domain name registration agreement should contain a requirement that the applicant provide certain accurate and reliable contact details.⁹ It was also noted that the nature of such searchable databases was an issue of technical coordination, outside the scope of the WIPO Process, and that it remained for ICANN to establish via its relationships with registry administrators and registrars.¹⁰

329. ICANN's current Registrar Accreditation Agreement requires registrars to make available at least the following information: the domain name, the Internet Protocol address of the primary and secondary nameservers, the corresponding names of those nameservers, the identity of the Registrar involved, the dates of registration and expiry, the name and postal address of the domain name holder, the name, postal address, email address, telephone and fax numbers of the technical and administrative contacts.¹¹ This information is required to be searchable by simple logical and combined methods, updated promptly, presented in a consistent format, and linked to the registrar or registry's site with nominated contact points to receive any complaints concerning incorrect contact data.¹²

330. Commentators to the WIPO Processes have continued to reiterate the importance of reliable Whois information that is accurate and up-to-date.¹³ The Report of the first WIPO Process recommended that domain name registration agreements should contain a term making the provision of inaccurate or unreliable information by the domain name holder, or the failure to update information, a material breach of the registration agreement and a basis for cancellation of the registration by the registration authority, and this has been supported by commentators to the WIPO Processes.¹⁴ In fact, ICANN's Registrar Accreditation Agreement states that the willful provision of false or inaccurate contact data constitutes a material breach of the registration agreement and a basis for its cancellation.¹⁵ ICANN's Statement of Registrar Accreditation Policy requires accredited registrars to provide public access on a real-time basis, such as by way of a Whois service, to the contact details that are required to be provided by a domain name registrant, and to keep such information updated.¹⁶ It is noted that there exist means by which registrars can improve the validity of Whois data, through random sampling or by acting upon notifications by third parties of the discovery of inaccurate details.

331. It is recommended that registration authorities should be encouraged to take measures to ensure that Whois data is accurate, reliable, up-to-date and publicly accessible.

332. It is considered essential that the current requirements for free public access to a Whois service should be extended to any new gTLDs.¹⁷ The majority of commentators expressed strong support for such a comprehensive search facility, especially pressing in light of the introduction of new gTLDs.¹⁸ The Intellectual Property Constituency (IPC) of ICANN's Domain Name Supporting Organization (DNSO) proposed criteria that should be required of new gTLD's Whois services, and the methods by which this information could be searched.¹⁹ The IPC recommended that the database information should be searchable by domain name, registrant's name or postal address, contacts' names, NIC handles and Internet Protocol address, and should be required to be kept current and comprehensive. Further, it was stated that searches should not be arbitrarily limited, either in number or in type (e.g., limited only to matches with exact domain names).

333. It is also considered essential that a Whois data facility should be comprehensive, enabling searches across all registrars' databases, including all gTLDs and to the greatest extent possible, as discussed below, the ccTLDs. This need is a consequence of the Shared Registration System introduced by ICANN in early 1999, that has resulted in the accreditation of numerous gTLD registrars, each of which is required to maintain its own Whois database.²⁰ This distributed Whois system has proven less functional for intellectual property consumers and rightsholders. Critically, there is no single site from which all registrars' Whois data can be comprehensively searched for more than just the exact domain name. It is notable, however, that one service at Uwhois.com enables searches using multiple search terms across significant numbers, if not all, gTLDs and ccTLDs.²¹

334. One commentator to the Second WIPO Process noted that, as a result of the introduction of competition among gTLD registrars and the resulting decentralization of responsibility for Whois services, "public access to gTLD Whois data is more fragmented, less consistent and less robust today than it was when the Final Report of the first WIPO Process was issued."²² One Internet Service Provider expressed its concern at the deterioration in Whois functionality, due to commercial factors and to privacy concerns, that has led to a decline in cooperation and the quality of information provided by various Whois lookup services. It was noted that this could impair the ability of the Internet service providers themselves to assist in preventing infringements of intellectual property rights and cooperation with law enforcement

officials on other legal issues.²³ In this circumstance, the ICANN Registrar Accreditation Agreement foresees the development of a centralized Whois database to ensure comprehensive searches capability, as follows:

“Registrar shall abide by any ICANN-adopted Policy that requires registrars to cooperatively implement a distributed capability that provides query-based Whois search functionality across all registrars. If the Whois service implemented by registrars does not in a reasonable time provide reasonably robust, reliable, and convenient access to accurate and up-to-date data, the Registrar shall abide by any ICANN-adopted Policy requiring Registrar, if reasonably determined by ICANN to be necessary (considering such possibilities as remedial action by specific registrars), to supply data from Registrar’s database to facilitate the development of a centralized Whois database for the purpose of providing comprehensive Registrar Whois search capability.”²⁴

335. It is recommended that comprehensive Whois search facilities should be enabled, and that a centralized Whois database be developed to provide these search facilities across data from all accredited registrars.

336. It is also proposed that Whois facilities should enable comprehensive searches across all registrars’ databases using search terms other than the exact domain name. It is not currently possible for a user to conduct a comprehensive search by name of registrant, for example, and thereby to ascertain a pattern of abusive bad faith registrations. Commentators to the WIPO Processes have identified the ability to search on the basis of Whois data elements other than domain names as a key functionality, and an essential tool for investigation and for resolving cases of cybersquatting, piracy and other rights violations. It is noted that enhanced searchability is already a requirement of ICANN’s Registrar Accreditation Agreement, and should be enforced.²⁵ Further, not all registrars’ Whois sites have comparable facilities. Only VeriSign Global Registry Services (Verisign GRS), for example, allows a user to search by exact domain name, domain name owner, contact name owner, handle and IP address. It is also notable that VeriSign GRS have committed a portion of their US\$200 million research

and development fund to address the technical challenges of a ‘Universal Whois’.²⁶ Commentators have also identified a need for enhanced oversight of the Whois databases.²⁷ In its comment to the Second WIPO Process, the International Trademark Association (INTA) requested that WIPO study and evaluate the potential for improvement of the Whois database, and develop a set of best practices for those operating Whois databases.²⁸

337. It is recommended that centralized comprehensive Whois search facilities be developed that enable searches across all available registrar databases on the basis of search criteria in addition to the exact domain name.

WHOIS SEARCH FACILITIES ACROSS ccTLDs

338. The demand for development of robust Whois search facilities at the gTLD level is felt also at the ccTLD level, where registration activity and, hence, focus is heightening. Each ccTLD administration authority currently maintains its own Whois database and within each ccTLD there may be multiple Whois databases that correspond to second-level domains that are separately administered. To add to the complexity, Whois databases are currently inaccessible in numerous ccTLDs that have closed off, or propose to close off, access to their Whois service.²⁹ Commentators have suggested that administrators of ccTLDs should also be encouraged to adopt policies for the collection, verification and public availability of contact details of registrants.³⁰

339. The *WIPO ccTLD Best Practices for the Prevention and Resolution of Intellectual Property Disputes* identify minimum standards for the collection and availability of contact details, largely in line with requirements at a gTLD level, but subject to the application of mandatory local privacy laws.³¹ These guidelines were produced in response to a request from WIPO’s Member States to develop a cooperation program for the administrators of

ccTLDs, designed to advise them on intellectual property protection in their domains, including dispute prevention and resolution. Developed through a public consultation process, the ccTLD Best Practices recommend that the following terms and conditions be included in any domain name registration agreement:

- ♣ A representation on the part of the registrant that the information provided by the registrant at the time of the initial registration of the domain name, in particular the registrant contact details, are true and accurate, as well as an agreement that such contact details will be kept updated by the registrant in order to ensure that they remain true and accurate throughout the period during which the domain name is registered.
- ♣ A provision stipulating that the provision of inaccurate or unreliable registrant contact details, or the registrant's failure to keep such contact details up to date, constitutes a material breach of the registration agreement and a basis for the cancellation of the domain name registration by the ccTLD administrator.
- ♣ An agreement on the part of the registrant that all registrant contact details will be made publicly available in real time through a Whois or similar service, subject to any contrary mandatory provisions of applicable privacy regulations.
- ♣ A clear notice on the part of the ccTLD administrator of the purposes of the collection and public availability of registrant contact details.

The WIPO ccTLD Best Practices received support from many commentators to the Second WIPO Process, as a concrete step forward in ensuring accurate and up-to-date Whois data at the ccTLD level.³²

340. It is recommended that administrators of ccTLDs be encouraged to adopt policies for the collection, verification and public availability of Whois data via online

databases, that are uniform, to the greatest extent possible, with the Whois system at a gTLD level.

PRIVACY IMPLICATIONS OF EXTENDED WHOIS SERVICES

341. At the same time as commentators to the Second WIPO Process favored robust Whois search facilities, most acknowledged that provision and availability of registrant data must take into account the protection of personal freedoms and privacy established by data protection rules and applicable legislation.³³ Commentators to the first WIPO Process had also expressed their concern at the possible erosion of personal liberties through the continued public availability of contact details of domain name holders.³⁴ It is evident that a balance needs to be struck between the need to enforce the current contractual requirement of domain name owners to provide contact information for many valid purposes, and the need to protect the privacy of individuals from unwarranted intrusion. As remarked by one commentator, “no country has enacted a law making privacy of registrant contact data an absolute value that necessarily prevails over countervailing considerations of consent, contract or public interest.”³⁵

342. The proposal of a comprehensive Whois search facility raised serious concerns relating to privacy protection among numerous commentators in different jurisdictions.³⁶ The American Civil Liberties Union (ACLU), for example, opposed the expansion of the Whois database functionality, and any standardization of Whois database operations, as constituting a threat to the privacy of users.³⁷ The European Commission expressed concerns that a comprehensive search facility could turn registrars’ databases and online search facilities into tools for policing the Internet, jeopardizing individuals’ control over the use of their personal data and compromising their freedom of speech.³⁸ The European Commission stated that, in accordance with EU data privacy standards,³⁹ the right to privacy is a fundamental right, that cannot be waived by consumer protection or law enforcement interests. Further, it was stated that the disclosure of each personal detail must be evaluated in respect of the purpose for which it was proposed to be disclosed, that secondary uses must be prohibited, filters used to

limit database access, and that the search criterion should continue to be limited to the exact domain name. It was discussed that the publication of personal registration data is still the cause of complaints filed with the European Parliament and Commission.

343. There exist numerous mechanisms that can be implemented to minimize the risk of violation of personal privacy, in the context of Whois search facilities. These include filtered access to databases, limiting availability of reverse look-ups to trusted third parties,⁴⁰ allowing post office boxes or details of trusted third parties as valid addresses, and implementing ‘unlisted’ Whois services maintained by registrars for a fee.⁴¹ In addition, some commentators support the imposition of severe penalties, both civil and criminal, by national governments as well as by registration authorities on those who misuse publicly available Whois information.⁴² It is noted that the ICANN Accreditation Agreement provides that a registrar or third party can list its own contact details in lieu of an anonymous registrant, provided that it accepts liability for any harm caused by wrongful use, unless it promptly discloses the identity of the true holder upon reasonable evidence of actionable harm. In this way, bona fide registrants can remain anonymous and intellectual property rightsholders are able to identify infringing registrants.

344. Numerous programs have been established to develop online guidelines and principles for data protection.⁴³ The Report of the first WIPO Process recommended that domain name registrants’ contact details should be collected and made available for limited purposes, and that registrants should be clearly notified in their registration agreement of the purposes of the collection and their informed consent obtained for the public availability of contact details. It was also recommended that registrars should adopt reasonable measures to prevent predatory use of data beyond the stated purposes in the registration agreement, such as mining of a database for domain name holders’ contact details for use in advertising and sales. These recommendations are here repeated.

345. At the same time, it is acknowledged that the majority of commentators representing intellectual property rightsholders remain strongly opposed to any restrictions upon the availability of data, and firmly opposed filtered access to data designed to protect users’ privacy, arguing that filters would impose an administrative burden on registration authorities

without any real gains in privacy protection. Concerns about privacy implications of the Whois system have focused on the possibility of misuse of such information, including by the registration authorities whose duty it is to collect and maintain it. In addressing this concern, it appears that a distinction can be drawn between privacy implications of individual queries and access to the Whois, and concerns regarding bulk access and transfer of mass data to compilers and resellers of registration information.⁴⁴ It is necessary to find a balance between personal privacy, users' rights, commercial competition and functional DNS management requirements. It is proposed that users' privacy and security should be protected and registrants should be clearly informed of what data will be collected, the purposes for which it is collected, and the uses to which it may be put. In each case, users should be required to give informed consent to the collection, storage and use of personal data within these parameters. Within each national territory, different cultural perspectives are found and varying legal standards apply under the relevant data protection laws.⁴⁵ It is noted that most national laws designed to protect privacy do not restrict the making available of contact data pursuant to contractual agreement, or on the basis of a competing public interest of higher priority, such as consumer protection or law enforcement.⁴⁶

DIRECTORY AND GATEWAY SERVICES

346. Throughout the WIPO Processes, commentators have noted the importance of technical mechanisms for preventing and resolving conflicts in the DNS.⁴⁷ The necessity for considering such mechanisms arises from the fact that a domain name is a unique technical address, whereas the exclusivity of trademarks is limited by reference to territory and to the class of goods or services with respect to which it is used.⁴⁸ The consequence of the qualifications on the exclusivity of the trademarks is that the same or similar mark may be owned by different persons in different jurisdictions throughout the world, and the same or similar mark may be owned by different persons with respect to different classes of goods. Domain names do not have the same capacity for promiscuity. However, many different domain names can share a common feature, such as a generic word like "federal", "united", or "rajah." This capacity to share a common feature can cause confusion, especially as the number of gTLDs increases. Directory and listing services provide the possibility for similar

names to be listed on a common portal or gateway page so as to give the user a convenient means of locating which of the similar domain names he or she wishes to find. One example of such a service is offered by INternet One, which offers directory services for companies, trademarks and business names.⁴⁹

347. Directory and listing services are supported by many as a useful means to reduce tension between numerous legitimate users of the same sign.⁵⁰ One commentator suggested that such a service could be offered by the registry or a neutral third party, following an objection by one legitimate user of a sign to its registration by another legitimate user. It was suggested that such directory services would be appropriate for use with names that, by their nature, may not be able to be used exclusively by a single entity, for example, for geographical indications, where a directory service could be run by the public authority with competence to administer the geographic region.⁵¹

348. The Report of the first WIPO Process stated that these measures were optional and offered parties a good solution to settling a conflict, at the same time noting considerable resistance by commentators to their mandatory application. For this reason, the Report recommended that the use of portals, gateways, or similar measures should be encouraged, but should not be compulsory. The same resistance to any compulsory measures for coexistence is noted by commentators to the Second WIPO Process,⁵² while the same benefits remain for those who choose to avail themselves of these developing technical measures.

[Annexes follow]

¹ Statistics by NetNames at <http://www.netnames.com>

² The Chairman of the U.S. House Judiciary Subcommittee on Courts, the Internet and Intellectual Property set forth the issues at an oversight hearing on the Whois database ‘Privacy and Intellectual Property Issues’ as follows: “The policies controlling the access and use of this information imply many things, including privacy issues, the ability to enforce intellectual property rights, empowering parents and consumers, aiding law enforcement in public safety activities, and important First Amendment Rights.” (See the proceedings of the Subcommittee on Courts, the Internet and Intellectual Property Committee on the Judiciary, U.S. House of Representatives, Washington, D.C., July 12, 2001 at <http://www.house.gov/judiciary/4.htm>). See also presentation of Mr. Paul Hughes, Public Policy Advisor, Adobe Systems USA, on

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- ‘Domain name registrant contact details’, at the WIPO Conference on Intellectual Property Questions Relating to ccTLDs (February 20, 2001) at <http://ecommerce.wipo.int/meetings/2001/cclds/presentations/hughes.pdf>.
- ³ See testimony of Stevan D. Mitchell, Vice President, Intellectual Property Policy, Interactive Digital Software Association, before the Subcommittee on Courts, the Internet and Intellectual Property Committee on the Judiciary, U.S. House of Representatives, Washington, D.C., July 12, 2001 (at http://www.house.gov/judiciary/mitchell_071201.htm).
- ⁴ See Comment of Motion Picture Association of America, Inc. (MPAA) (RFC-3 – June 6, 2001). See also Comment of the United States Council for International Business (USCIB) (RFC-2-December 29, 2000).
- ⁵ See Comment of Australia, Australian Competition & Consumer Commission (ACCC) (RFC-3-June 15, 2001), Comment of Hungary, Hungarian Patent Office (RFC-3 – June 13, 2001), Comment of United Kingdom, The Patent Office (RFC-3 – June 1, 2001), Comment of United States of America, U.S. Patent and Trademark Office (RFC-3 – June 14, 2001), Comment of American Intellectual Property Law Association (AIPLA) (RFC-3 – June 7, 2001), Comment of Brazilian Association of Intellectual Property (ABPI) (RFC-3 – June 8, 2001), Comment of Copyright Coalition on Domain Names (CCDN) (RFC-3 – June 7, 2001), Comment of International Association for the Protection of Industrial Property (AIPPI) (RFC-3 – June 18, 2001), Comment of International Trademark Association (INTA) (RFC-3 – May 24, 2001), Comment of Law and Technology Committee, Auckland District Law Society (RFC-3 – June 22, 2001), Comment of Motion Picture Association of America, Inc. (MPAA) (RFC-3 – June 6, 2001). See also Comment of Verizon (RFC-2 – December 26, 2000).
- ⁶ The Copyright Coalition on Domain Names submitted that these services are also important for advancing law enforcement, consumer protection, parental control and other social policies in the online environment. See Comment of the Copyright Coalition on Domain Names (CCDN) (RFC-2 – December 28, 2000).
- ⁷ At the time of writing, the ICANN Names Council Whois Committee has received over 1900 comments as part of its consultation process on this issue. See <http://www.icann.org/dns/whois-survey-en-10jun01.htm>.
- ⁸ See Report of the first WIPO Internet Domain Name Process, paras 74-81.
- ⁹ WIPO recommended that domain name applicants should be required to provide the following information: full name of the applicant; applicant’s postal address, including street address or post office box, city, State or Province, postal code and country; applicant’s e-mail address; applicant’s voice telephone number; applicant’s facsimile number, if available; and where the applicant is an organization, association or corporation, the name of an authorized person (or office) for administrative or legal contact purposes. See Report of the first WIPO Process, para. 73.
- ¹⁰ See Report of the first WIPO Process, paras. 74 -81.
- ¹¹ See ICANN Registrar Accreditation Agreement, Art. II.F(1).
- ¹² The President of the International Anticounterfeiting Coalition (IACC), Timothy P. Trainer, testified before the U.S. House of Representatives Subcommittee oversight hearing on the Whois database ‘Privacy and Intellectual Property Issues’, and encouraged the United States Government to urge ICANN to “pay more attention to the implementation and enforcement of the registrars’ [Registrar Accreditation Agreements] obligations and to increase its efforts to restore WHOIS at least to the level of usability that the public enjoyed up until the advent of registrar competition in 1999. Since the gTLD WHOIS environment provides a template for these services in other parts of the DNS, increased attention here could improve accountability and transparency throughout the Internet.” (Testimony before the Subcommittee on Courts, Internet and Intellectual Property Committee on the Judiciary, U.S. House of Representatives,

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- Washington, D.C., July 12, 2001, at the oversight hearing on the Whois database ‘Privacy and Intellectual Property Issues’ at http://www.house.gov/judiciary/trainer_071201.htm.
- 13 See, for example, Comment of Hungary, Hungarian Patent Office (RFC-3 – June 13, 2001).
- 14 See Report of the first WIPO Process, paras. 117-119.
- 15 See ICANN Statement of Registrar Accreditation Policy, Art II.J (7)a. (approved November 4, 1999) at <http://www.icann.org/nsi/icann-raa-04nov99.htm>.
- 16 See ICANN Statement of Registrar Accreditation Policy, Art II.F (approved November 4, 1999) at <http://www.icann.org/nsi/icann-raa-04nov99.htm>.
- 17 See Comment of the Copyright Coalition on Domain Names (CCDN) (RFC-2 – December 28, 2000). The ICANN policy for allocation of new gTLDs asks: “Does the proposal make adequate provision for Whois service that strikes an appropriate balance between providing information to the public regarding domain-name registrations in a convenient manner and offering mechanisms to preserve personal privacy?” See ICANN Criteria for Assessing TLD Proposals, August 15, 2000, para.8 (d) at <http://www.icann.org/tlds/tld-criteria-15aug00.htm>.
- 18 See Comment of Hungary, Hungarian Patent Office (RFC-3 – June 13, 2001), Comment of United States of America, Office of Advocacy, U.S. Small Business Administration (RFC-3 – June 15, 2001), Comment of American Intellectual Property Law Association (AIPLA) (RFC-3 – June 7, 2001), Comment of Brazilian Association of Intellectual Property (ABPI) (RFC-3 – June 8, 2001), Comment of International Trademark Association (INTA) (RFC-3 – May 24, 2001), Comment of Motion Picture Association of America, Inc. (MPAA) (RFC-3 – June 6, 2001).
- 19 See ‘Intellectual Property Protection in the New TLDs’, *Intellectual Property Constituency (IPC) of the DNSO*, August 24, 2000, at http://ipc.songbird.com/New_TLD_Safeguards.htm.
- 20 The list of accredited registrars is updated regularly at <http://www.icann.org/registrars/accredited-list.html>
- 21 See <http://www.uwhois.com>.
- 22 See Comment of Copyright Coalition on Domain Names (CCDN) (RFC-2 – December 28, 2000).
- 23 See Comment of Commercial Internet eXchange Association (CIX) (RFC-2 – December 29, 2000), stating that “CIX urges that particular attention be given to the fissures that have appeared in WHOIS database lookup services and that priority be given to restoring their integrity.”
- 24 See ICANN’s Registrar Accreditation Agreement, approved November 4, 1999, (Section II.F(4)) at <http://www.icann.org/nsi/icann-raa-04nov99.htm#IIF>.
- 25 See Comment of Copyright Coalition on Domain Names (CCDN) (RFC-2 – December 28, 2000).
- 26 See Comment of Copyright Coalition on Domain Names (CCDN) (RFC-3 – June 8, 2001).
- 27 See Comment of Brazilian Association of Intellectual Property (ABPI) (RFC-3 – June 8, 2001).
- 28 “INTA has been an active advocate in ICANN, Europe and the U.S. Congress, on the need for a fully searchable, open and freely available Whois database that works across a variety of platforms despite the growing number of registration authorities inputting data into such databases. The trademark community has faced numerous problems in accessing information and obtaining accurate information from the Whois database over the past several years.” See Comment of International Trademark Association (INTA) (RFC-1 – September 11, 2000).
- 29 See Comment of the United States Council for International Business (USCIB) (RFC-2 – December 29, 2000). See generally ‘Matters Related to WHOIS’ *DNSO Intellectual Property Constituency*, March 3, 2000 – paper prepared for the ICANN meeting in Cairo, Egypt - at http://ipc.songbird.com/whois_paper.html.

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- ³⁰ See Comment of Brazilian Association of Intellectual Property (ABPI) (RFC-3 – June 8, 2001). See also Comment of Copyright Coalition on Domain Names (CCDN) (RFC-2 – December 28, 2000).
- ³¹ The WIPO ccTLD Best Practices document (Version 1) was posted on June 20, 2001 at <http://ecommerce.wipo.int/domains/cclds/bestpractices/bestpractices.html>.
- ³² See Comment of United States of America, U.S. Patent and Trademark Office (RFC-3 – June 14, 2001), Comment of Copyright Coalition on Domain Names (CCDN) (RFC-3 – June 7, 2001), Comment of Motion Picture Association of America, Inc. (MPAA) (RFC-3 – June 6, 2001).
- ³³ See Comment of United Kingdom, The Patent Office (RFC-3 – June 1, 2001), Comment of European Commission (RFC-3 – June 25, 2001), Comment of Law and Technology Committee, Auckland District Law Society (RFC-3 – June 22, 2001), Comment of Nominet UK (RFC-3 – June 14, 2001).
- ³⁴ See Report of the first WIPO Process at paras. 87-90.
- ³⁵ See Comment of Copyright Coalition on Domain Names (CCDN) (RFC-3 – June 7, 2001). See also Comment of American Intellectual Property Law Association (AIPLA) (RFC-3 – June 7, 2001), Comment of Motion Picture Association of America, Inc. (MPAA) (RFC-3 – June 6, 2001).
- ³⁶ For general information concerning national and international developments in privacy and data protection law and principles, see <http://www.privacyexchange.org/>.
- ³⁷ The ACLU also noted that the collection and free availability of personal data of registrants could stifle free speech by removing anonymity, and may expose users to unwanted commercial mail. See Comment of the American Civil Liberties Union (ACLU) (RFC-2 – December 29, 2000).
- ³⁸ See Comment of European Commission (RFC-3 – June 25, 2001). See also the International Working Group on Data Protection in Telecommunications, Common Position, adopted May 2000 at <http://www.datenschutz-berlin.de>.
- ³⁹ European Parliament Directives dealing with privacy and data protection issues include; Directive 97/66/EC of the European Parliament and Council of 15 December 1997, concerning the processing of personal data and the protection of privacy in the telecommunications sector; Directive 97/7/EC of the European Parliament and of the Council of 20 May 1997, on the protection of consumers in respect to distance contracts Directive 95/46/EC of the European Parliament and of the Council of 24 October 1995, on the protection of individuals with regard to the processing of personal data and on the free movement of such data.
- ⁴⁰ See Comment of Nominet UK (RFC-3 – June 14, 2001).
- ⁴¹ See Comment of United States of America, Office of Advocacy, U.S. Small Business Administration (RFC-3 – June 15, 2001), Comment of United Kingdom, The Patent Office (RFC-3 – June 1, 2001), Comment of Law and Technology Committee, Auckland District Law Society (RFC-3 – June 22, 2001), Comment of Nominet UK (RFC-3 – June 14, 2001).
- ⁴² See Comment of International Trademark Association (INTA) (RFC-3 – May 24, 2001).
- ⁴³ See the collection of such activities listed at ‘Online and Internet Principles, Guidelines and Statements’ at <http://www.privacyexchange.org/>.
- ⁴⁴ See Comment of Copyright Coalition on Domain Names (CCDN) (RFC-3 – June 7, 2001).
- ⁴⁵ For a collection of national laws on privacy, see the PrivacyExchange omnibus and sectoral Legal Library collection at <http://www.privacyexchange.org/>.
- ⁴⁶ See ‘Matters Related to WHOIS’ DNSO Intellectual Property Constituency, March 3, 2000 – paper prepared for the ICANN meeting in Cairo, Egypt - at http://ipc.songbird.com/whois_paper.html.

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- ⁴⁷ For example, see Comment of Hungary, Hungarian Patent Office (RFC-3 – June 13, 2001), Comment of Switzerland, Swiss Federal Institute of Intellectual Property (RFC-1 – September 15, 2000).
- ⁴⁸ The situation is otherwise for famous and well-known marks; see Chapter 4 of the Report of the first WIPO Process.
- ⁴⁹ See <http://www.io.io>.
- ⁵⁰ See, for example, Comment of Hungary, Hungarian Patent Office (RFC-3 – June 13, 2001), Comment of Susan Isiko (RFC-1 – September 15, 2000). See also comments by Vinton Cerf that “[i]t may become essential to have a table look-up and directory service to decouple the web and trade marks” in J. Nurton and R. Cunningham ‘Can technology tame the net? Profile : Vinton Cert, MCI Worldcom’, *International Internet Law Review*, July-August 2000, at 14.
- ⁵¹ See Comment of Switzerland, Swiss Federal Institute of Intellectual Property (RFC-2 – December 12, 2000).
- ⁵² See Comment of International Association for the Protection of Industrial Property (AIPPI) (RFC-3 – June 18, 2001).