



American Intellectual Property Law Association

Comments of the  
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on the  
Request for Comments  
In the  
Second WIPO Internet Domain Name Process

The American Intellectual Property Law Association (AIPLA) is pleased to present the following comments with respect to the World Intellectual Property Organization (WIPO) document entitled the “Request for Comments on Issues Addressed in the Second WIPO Internet Domain Name Process,” (WIPO2 RFC-2) dated 13 October 2000.

The AIPLA is an 11,000 member bar association whose membership primarily consists of lawyers in private and corporate practice, in government service, and in the academic community. AIPLA members comprise a wide and diverse spectrum of individuals involved directly or indirectly in the practice of patent, trademark, copyright, trade secret and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property, including many large and small businesses that make commercial use of the Internet via web sites or otherwise provide services over the Internet.

I. Introduction

Preliminarily, the AIPLA congratulates WIPO on having undertaken this task. WIPO's undertaking will necessarily require it to consider many issues that transcend national boundaries and affect a wide variety of interests in the intellectual property and business communities, as well as among members of the public at large.

The AIPLA has been actively involved with the issues raised by the registration and use of Internet domain names for a considerable period of time, and has addressed these issues in a number of forums. Its involvement has included presenting testimony at various Congressional hearings on domain names, participating in special meetings of WIPO on domain names in Geneva, Switzerland, participation in the first Domain Name Process, and responding to various inquiries from the United States Commerce Department and international intergovernmental organizations. In addition, the Executive Director of AIPLA served as President of the Intellectual Property Constituency of the Domain Name Supporting Organization of ICANN.

The AIPLA remains eager to continue to assist WIPO in any way we can, and we hope that our comments below will be helpful to WIPO as it conducts its work in connection with this undertaking.

## II. Comments

### A. Personal names

UDRP decisions have already provided protection to personal names that serve as common law trade or service marks. AIPLA agrees that this is appropriate. It may be useful, however, to revise the UDRP to make this explicit and to promote uniform application of the Policy.

We do not advocate providing additional protection for personal names under the UDRP beyond that available under existing trademark law. We doubt that the UDRP is an appropriate forum for addressing disputes involving personal names that do not function as marks. For example, issues involving individual privacy will depend on the content of the web site and are better addressed through the courts. To the extent that a claim of right of publicity is involved, it will normally be the case that the complainant can establish common law trade or service mark rights that can be protected under the UDRP. It should also be clear that registration of a trademark as a domain name is not an abusive practice just because the trademark is also someone's personal name.

### B. International Nonproprietary Names (INN)

An INN is a non-proprietary name for a pharmaceutical substance. Misuse of an INN creates substantial concern about consumer fraud, patient safety and deception, however, we question whether the UDRP is appropriate for resolving disputes over competing legitimate interests regarding the use of INNs.

On the other hand, various entities do have legitimate interests in the use of INNs so that this is an important matter to address. We therefore encourage WIPO to consider a mechanism for commercial entities affected by such misuse to take swift action to protect consumers.

### C. Names and Acronyms of International Intergovernmental Organizations (IIO)

AIPLA believes that such designations should be afforded protection under the UDRP to the extent that they function as marks. We do not favor exclusions that might prevent legitimate use of a designation that happens to be the same as the name or acronym of an IIO.

#### D. Geographic Indications

A geographic term may be used as a generic term, a trademark or an indication of geographic origin, depending on the context. As with the names and acronyms of an IIO, AIPLA does not favor an exclusion that might prevent legitimate use of a designation that happens to be a geographic term. Nevertheless, there are circumstances where the misuse of a geographic term may create fraud on consumers. As with INNs, we believe it is appropriate to consider a mechanism that would permit appropriate entities to take swift action to protect consumers.

#### E. Trade names

As with personal names, the UDRP has provided protection to trade names that serve as common law trade or service marks. We agree that this is appropriate and believe that it would be helpful to revise the UDRP to make this protection explicit. In such situations, as with other common law marks, it is appropriate to require a showing that the trade name has become distinctive as an indication of source.

### III. Other Issues

AIPLA favors consideration of the technical solutions to some of the challenges presented by the domain name system, particularly those issues arising from the fact that each domain name must be unique and cannot be shared among persons or entities with legitimate interests in the use of a domain name. For example, directory systems or gateway pages may be useful to permit legitimate users of personal names, INNs or geographic indications to share in the use of the domain name.