

## **WIPO General Assembly**

### **Forty-First (21<sup>st</sup> Extraordinary) Session Geneva, October 1 to 9, 2012**

#### **WIPO ARBITRATION AND MEDIATION CENTER, INCLUDING DOMAIN NAMES**

*Document prepared by the Secretariat*

1. This document provides an update on the WIPO Arbitration and Mediation Center's ("Center") activities as an international resource for time- and cost-efficient alternatives to court litigation of intellectual property disputes, acting both as a provider of legal and organizational expertise and as an administrator of cases.<sup>1</sup>

2. This document also provides an update on the domain name-related activities of WIPO, as previously reported in WO/GA/40/9. It covers the Center's administration of domain name disputes under different policies and various related aspects of the Internet Domain Name System (DNS), as well as selected policy developments, in particular rights protection mechanisms (RPMs) for the introduction of new generic top-level domains (gTLDs), the emergence of internationalized domain names (IDNs) as gTLDs, the planned future revision by the Internet Corporation for Assigned Names and Numbers (ICANN) of the Uniform Domain Name Dispute Resolution Policy (UDRP), and the status of the recommendations made by the Member States of WIPO in the context of the Second WIPO Internet Domain Name Process.

#### **I. ARBITRATION AND MEDIATION OF INTELLECTUAL PROPERTY DISPUTES AND RELATED INITIATIVES**

3. In 2011, the Center worked to optimize the potential of its mediation and arbitration procedures to meet the needs of intellectual property right (IPR) holders for timeliness and cost-effectiveness in the resolution of disputes in relation to those rights. The principal component of this effort is quality management and resolution of cases conducted under those

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<sup>1</sup> The Center's previous report to the WIPO General Assembly (WO/GA/40/9) can be found at [http://www.wipo.int/edocs/mdocs/govbody/en/wo\\_ga\\_40/wo\\_ga\\_40\\_9.pdf](http://www.wipo.int/edocs/mdocs/govbody/en/wo_ga_40/wo_ga_40_9.pdf).

procedures, which entails training<sup>2</sup> and appointing qualified arbitrators and mediators, maintaining up-to-date case administration infrastructure, including through the use of information technology such as the WIPO Electronic Case Facility (ECAF),<sup>3</sup> and active management of WIPO cases, including support to appointed neutrals. Cases under WIPO Rules in 2011 included those related to international patent, trademark and software arrangements, and were submitted to the Center by parties on the basis of contract clauses as well as submission agreements.

4. The Center organized tailor-made mediation and arbitration programs for intellectual property (IP) institutions and practitioners, and assisted IP Offices in establishing optional dispute resolution frameworks for disputes pending before them. Notably, following the signing of a Memorandum of Understanding (MoU) between WIPO and the IP Office of Singapore (IPOS) in late 2011, the Center implemented a joint dispute resolution procedure to facilitate the mediation of trademark rights disputes filed with IPOS.<sup>4</sup> Since then the Center has organized training programs for prospective mediators under the program and the first cases have been received. This experience is being evaluated for possible use also in patent and design proceedings before IPOS. Following the Center's assistance provided to the IP Office of the Philippines in its establishment of specialized arbitration procedures under the laws of the Philippines, the Center with WIPO neutrals provided a training program in Manila in support of this initiative.

5. In 2011 the International Council of Museums (ICOM) and WIPO collaborated in the development and organization of a special mediation process for art and cultural heritage disputes.<sup>5</sup> The ICOM-WIPO Mediation Rules now provide a specialized dispute resolution option for parties involved in this type of dispute.<sup>6</sup> The Center with ICOM has organized and participated in a seminar and two workshops for the purpose of informing relevant stakeholders and providing training in the mediation program.

6. A Center growth area is in the provision of advice and case administration services to help parties resolve disputes arising in research and development (R&D) and in technology transfer. Parties involved in R&D collaboration often use model agreements as a basis for drafting and negotiating their research contracts. One such example involves multi-party collaborations funded under the European Union's Seventh Framework Programme EC (FP7), where entities use the "DESCA" model consortium agreement, which since 2011 recommends WIPO mediation and expedited arbitration.<sup>7</sup> The DESCAs model agreement covers many industries internationally and is also open for participation of non-European entities in research consortia. As part of a broader effort recently culminating in an MOU between WIPO and the Association of University Technology Managers (AUTM), the Center continued its collaboration with AUTM for efficient and effective dispute resolution to university technology transfer offices around the world.

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<sup>2</sup> All workshops and other events organized by the Center are listed at <http://www.wipo.int/amc/en/events>.

<sup>3</sup> ECAF offers online case communication and storage of documents facilitating time- and cost-efficient mediation and arbitration proceedings. See <http://www.wipo.int/amc/en/ecaf/index.html>.

<sup>4</sup> See

<http://www.ipos.gov.sg/topNav/svc/MEDIATION+OPTION+IN+TRADE+MARK+PROCEEDINGS+BEFORE+IPOS.htm>.

<sup>5</sup> This collaboration was formalized in a Memorandum of Understanding on May 3, 2011. See also <http://www.wipo.int/amc/en/center/specific-sectors/art/icom/>.

<sup>6</sup> See <http://www.wipo.int/amc/en/center/specific-sectors/art/icom/>.

<sup>7</sup> DESCAs, which stands for "Development of a Simplified Consortium Agreement", is a model consortium agreement initially developed for research projects funded by the European Commission under the Seventh Framework Programme (FP7) under the auspices of the DESCAs Core Group. The DESCAs model agreement is estimated to be used by some 75 per cent of companies, research organizations, universities and individuals involved in cross-border research projects funded by FP7. This program covers all research-related EU initiatives including in the areas of health, food, agriculture, fisheries, biotechnology, ICT, nano-technologies, materials and new production technologies, energy, environment, transport (including aeronautics), socio-economic sciences, space and security. See <http://www.desca-fp7.eu/>.

7. Upon analysis of the numerous responses to its International Survey of Dispute Resolution in International Technology Transactions, the Center expects to announce the results in the course of 2012.<sup>8</sup> This research has been undertaken to understand the expectations and experiences of intellectual property stakeholders globally, in particular as they relate to alternative dispute resolution.

## II. DOMAIN NAME CASE ADMINISTRATION

### A. UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY

8. The DNS raises a number of challenges for the protection of IP, which, due to the global nature of the Internet, call for an international approach. WIPO has addressed these challenges since 1998 by developing specific solutions, most notably in the First<sup>9</sup> and Second<sup>10</sup> WIPO Internet Domain Name Processes. In particular, the Center provides trademark owners with efficient international mechanisms to deal with the bad-faith registration and use of domain names corresponding to their trademark rights.

9. The Center administers dispute resolution procedures principally under the UDRP. The UDRP was adopted by ICANN on the basis of recommendations made by WIPO in the First WIPO Internet Domain Name Process. The UDRP is limited to clear cases of bad-faith, abusive registration and use of domain names and has proven highly popular among trademark owners. It does not prevent either party from submitting a dispute to a competent court of justice; but very few cases that have been decided under the UDRP have been brought before a national court of justice.<sup>11</sup>

10. Since December 1999, the Center has administered more than 23,000 UDRP and UDRP-based cases. Demand for this WIPO service continued in 2011 with trademark holders filing 2,764 complaints, an increase of 2.5 per cent over the 2010 level.<sup>12</sup> The Center makes available online extended real-time statistics to assist WIPO case parties and neutrals, trademark attorneys, domain name policy makers, the media and academics.<sup>13</sup>

11. A diverse mixture of individuals and enterprises, foundations, and institutions used the Center's dispute resolution procedures in 2011. The top five sectors for complainant business activity were Retail, Internet and IT, Biotechnology and Pharmaceuticals, Fashion, and Banking and Finance. WIPO UDRP proceedings have so far involved parties from 169 countries. Reflecting the truly global scope of this dispute mechanism, in 2011 alone, named parties to WIPO cases represented over 110 countries. In function of the language of the applicable registration agreement of the domain name at issue, WIPO UDRP proceedings have so far been conducted in 19 different languages.<sup>14</sup>

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<sup>8</sup> See <http://www.wipo.int/amc/en/center/survey/>.

<sup>9</sup> The Management of Internet Names and Addresses: Intellectual Property Issues – Final Report of the First WIPO Internet Domain Name Process, WIPO publication No. 439, also available at <http://www.wipo.int/amc/en/processes/process1/report>.

<sup>10</sup> The Recognition of Rights and the Use of Names in the Internet Domain Name System – Report of the Second WIPO Internet Domain Name Process, WIPO Publication No. 843, also available at <http://www.wipo.int/amc/en/processes/process2/report>.

<sup>11</sup> See Selected UDRP-related Court Cases at <http://www.wipo.int/amc/en/domains/challenged>.

<sup>12</sup> Demand in 2010 for this WIPO service in turn increased 28 per cent over 2009.

<sup>13</sup> Available statistics cover many categories, such as “areas of complainant activity”, “named respondents”, “domain name script”, and “25 most cited decisions in complaint”. See <http://www.wipo.int/amc/en/domains/statistics>.

<sup>14</sup> In alphabetical order, Chinese, Danish, Dutch, English, French, German, Hebrew, Italian, Japanese, Korean, Norwegian, Polish, Portuguese, Romanian, Russian, Slovak, Spanish, Swedish, Turkish.

12. All WIPO panel decisions are posted on the Center's website. The Center offers a unique online overview of broad decision trends on important case issues via the WIPO Overview of WIPO Panel Views on Selected UDRP Questions (WIPO Overview 2.0) which distills thousands of UDRP cases handled by the Center. This globally relied-upon instrument was created in recognition of the need that has been expressed to identify, as much as possible, consensus among UDRP decisions so as to help maintain the consistency of WIPO UDRP jurisprudence.<sup>15</sup>

13. To facilitate access to these decisions according to subject matter, the Center also offers an online searchable Legal Index of WIPO UDRP Decisions.<sup>16</sup> Another of the Organization's most visited web pages, the Legal Index has become an essential professional resource, allowing panelists, parties, academics or any interested person to familiarize themselves with WIPO case precedent. The Index is updated periodically to include new search categories that primarily reflect developments in the DNS itself.

14. One such development concerns the growth in the number of professional domain name investors and the volume of their activity, and the use of computer software to automatically register (sometimes expired) domain names and their "parking" of often competing advertisements on pay-per-click portal sites. In addition to their value as commercial identifiers, domain names have increasingly taken on aspects of commodities for speculative gain. Whereas traditional domain name abuse involved the registration of domain names by individuals seeking to turn a profit on the "squatted" names, nowadays a growing number of "domainers" are deriving income from the large-scale automated registration of domain names corresponding not only to dictionary terms but also to third-party identifiers.

15. As the leading provider of case administration services under the UDRP, WIPO must monitor such developments with a view to continually adjusting its practices. One such area of attention is the widespread use of privacy and proxy registration services, which according to ICANN estimates involves some 25 per cent of domain name registrations. In combination with varying reliability of "WHOIS" registrant contact data, this poses significant challenges for filing parties, providers, and panels in ascertaining appropriate respondent identity in UDRP proceedings.

16. Following ICANN's acceptance of a WIPO proposal, from December 2009 the Center became the first UDRP provider to remove the requirement to submit and distribute paper copies of pleadings in the UDRP process, primarily through the exclusive use of email.<sup>17</sup> WIPO's eUDRP procedure benefits all stakeholders by eliminating the use of vast quantities of paper and the associated production and shipping costs, as well as improving the timeliness of UDRP proceedings without prejudicing either complainants or respondents.<sup>18</sup>

17. The Center regularly organizes Domain Name Dispute Resolution Workshops for interested parties<sup>19</sup> and meetings of its Domain Name Panelists.

18. A broader UDRP-related development which may present significant concerns for trademark owners is described in paragraphs 33 and 34 herein.

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<sup>15</sup> The Overview is available at <http://www.wipo.int/amc/en/domains/search/overview>.

<sup>16</sup> The WIPO Legal Index is available at <http://www.wipo.int/cgi-bin/domains/search/legalindex>.

<sup>17</sup> Full details of WIPO's eUDRP implementation are available at <http://www.wipo.int/amc/en/domains/rules/eudrp/> and <http://www.wipo.int/export/sites/www/amc/en/docs/icann301208.pdf>.

<sup>18</sup> The Center has also assisted numerous ccTLD operators in their implementation of similar efficiencies.

<sup>19</sup> See footnote 2, *supra*.

## B. COUNTRY CODE TOP-LEVEL DOMAINS

19. While the mandatory application of the UDRP is limited to domain names registered in gTLDs, such as .com, .net, and .org, the Center also assists ccTLD registries in their establishment of registration conditions and dispute resolution procedures that conform with best practices in IP protection. These procedures are mostly modeled after the UDRP, but may take account of the particular circumstances and needs of individual ccTLDs. The Center currently provides domain name dispute resolution services to 65 ccTLD registries.<sup>20</sup> In line with a global increase in the share of ccTLD registrations in recent years, the collective percentage of disputed ccTLD domain names in WIPO cases rose to 16 per cent of all cases in 2011 from just 1 per cent in 2000.

## III. POLICY DEVELOPMENTS IN THE DOMAIN NAME SYSTEM

20. Two policy developments in relation to ICANN will in particular present not only opportunities but also serious legal and practical challenges for IPR owners and users. One of these is the exponential introduction of over one thousand new gTLDs, for which preparations are presently underway. Such new gTLDs may be of an “open” nature (similar to .com), or may take on more specific or restrictive characteristics, for example taking the form of .[city], .[community], .[brand], .[language], .[culture], or .[industry]. A second development of importance concerns the introduction of IDNs at the top level. In terms of DNS policy, another subject of note consists of an ICANN plan for a largely registration-business driven effort to revise the UDRP. Also, ICANN’s envisaged expansion of the DNS raises rights protection questions in connection with the Second WIPO Internet Domain Name Process.

### A. NEW GENERIC TOP-LEVEL DOMAINS

21. ICANN implementation of its New gTLD Program was formally approved in a Board vote at ICANN’s Meeting in Singapore on June 20, 2011.<sup>21</sup> Information about the adopted application process and conditions for new gTLDs has been published in ICANN’s “Applicant Guidebook”, which has gone through a series of drafts over the past few years.<sup>22</sup> ICANN received applications for new gTLDs (including IDNs; see discussion in paragraphs 35 and 36 herein) from January to May 2012. The first ICANN-approved new gTLDs are expected to become operational in the course of 2013, followed, where applicable, by registrations of individual domain names (further application rounds are expected in due course).

22. By way of background on ICANN’s New gTLD Program, ICANN’s policy-making body, the Generic Names Supporting Organization (GNSO) in September 2007 issued a set of recommendations (approved by ICANN’s Board in June 2008) to implement a process to allow for the introduction of further new gTLDs. These GNSO recommendations include *inter alia* a recommendation that new gTLD strings must not infringe existing legal rights of others that are recognized or enforceable under internationally recognized principles of law, e.g., trademark and freedom of expression rights.<sup>23</sup> On its part, ICANN’s Governmental Advisory Committee (GAC) issued in 2007 a set of “GAC Principles regarding New gTLDs” which state *inter alia* that

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<sup>20</sup> Against the background of the global emergence of domain names in local language scripts, in 2011 the Center commenced the provision of domain name dispute resolution services for قطر (dotQatar), in addition to .QA. Qatar now not only utilizes its existing .QA two-letter country code in Latin characters, but also the قطر (dotQatar) Internationalized ccTLD in Arabic script. The full list of ccTLDs which have retained the Center as domain name dispute resolution provider is available at <http://www.wipo.int/amc/en/domains/ccTld>.

<sup>21</sup> See <http://www.icann.org/en/minutes/resolutions-20jun11-en.htm>. For further background including references, see document WO/GA/39/10, in particular paragraph 14.

<sup>22</sup> ICANN’s current Applicant Guidebook is available at <http://newgtlds.icann.org/en/applicants/agb>.

<sup>23</sup> See <http://gns0.icann.org/issues/new-gtlds/pdp-dec05-fr-part08aug07.htm>.

“[the] process for introducing new gTLDs must make proper allowance for prior third party rights, in particular trademark rights as well as rights in the names and acronyms of inter-governmental organizations (IGOs).”<sup>24</sup>

23. Subsequent discussions of ICANN’s New gTLD Program, and within that, trademark RPMs, have been contentious. The Center has been actively monitoring the development of the various RPMs resulting from such ICANN discussions,<sup>25</sup> consistently providing targeted input to ICANN in an attempt to help it develop workable solutions to the issue of trademark protection in new gTLDs. Ultimately though, after a series of ICANN committees and processes, the RPMs available for approved new gTLDs are seen to have been diluted in their intended effectiveness, both in operational and substantive terms.<sup>26</sup>

24. Based on its DNS experience, in particular in the design and implementation of trademark-based RPMs, the Center’s contributions to ICANN have focused on enhancing the overall workability of such mechanisms – for all stakeholders.<sup>27</sup> Such contributions take account of the fact that the current design of ICANN’s new gTLD RPMs substantially reflects the input of ICANN’s own contracting parties, namely registries and registrars. The Center remains committed to working with stakeholders to attempt to safeguard the observance of general principles of IP protection in any new gTLDs ultimately approved by ICANN. Set out below is a broad description of the RPMs adapted and adopted by ICANN, in relation to the top level and the second level respectively.

(i) Top Level Rights Protection Mechanisms

- Pre- (TLD) Delegation Dispute Resolution Procedure

25. The Center replied to ICANN’s December 2007 request for “Expressions of Interest from Potential Dispute Resolution Service Providers for New gTLD Program” in relation to a number of RPMs, including a pre-delegation procedure for “Legal Rights Objections” (other objection grounds recognized by ICANN are: “String Confusion Objections”, “Community Objections”, and “Limited Public Interest Objections”<sup>28</sup>). The substantive criteria for this Legal Rights Objections procedure are rooted in the “WIPO Joint Recommendation Concerning Provisions on the Protection of Marks, and Other Industrial Property Rights in Signs, on the Internet”<sup>29</sup> (Joint Recommendation) adopted by the WIPO General Assembly in September 2001.

26. In addition to the adoption of these criteria, the Center has also assisted ICANN in its development of procedural rules for Legal Rights Objections as integrated in ICANN’s Applicant Guidebook.<sup>30</sup> The pre-delegation proposal has met with broad support, and the Center will exclusively administer such disputes, at least for the first application round.<sup>31</sup> While, consistent with the Joint Recommendation, the prime focus of pre-delegation Legal Rights Objections

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<sup>24</sup> See [https://gacweb.icann.org/download/attachments/1540128/gTLD\\_principles\\_0.pdf?version=1&modificationDate=1312358178000](https://gacweb.icann.org/download/attachments/1540128/gTLD_principles_0.pdf?version=1&modificationDate=1312358178000).

<sup>25</sup> See <http://www.wipo.int/amc/en/domains/newgtld/>.

<sup>26</sup> For further background including references, see document WO/GA/39/10, in particular paragraphs 23-30. It is noted here that ICANN summarily rejected a proposal for a “Globally Protected Marks List”.

<sup>27</sup> A full record of the Center’s public communications with ICANN in this regard is available at <http://www.wipo.int/amc/en/domains/resources/icann/>.

<sup>28</sup> The Applicant Guidebook further foresees a number of other procedures which governments may avail themselves of following ICANN announcement of new gTLD applications. Notably, section 1.1.2.4 provides for “GAC Early Warning,” and section 1.1.2.7 provides for “Receipt of GAC Advice on New gTLDs” for the ICANN Board’s consideration.

<sup>29</sup> See [http://www.wipo.int/about-ip/en/development\\_iplaw/pub845-toc.htm](http://www.wipo.int/about-ip/en/development_iplaw/pub845-toc.htm).

<sup>30</sup> See section 3.2 of the ICANN Applicant Guidebook.

<sup>31</sup> See WIPO Rules for New gTLD Dispute Resolution, and Schedule of Fees and Costs, respectively at <http://www.wipo.int/amc/en/docs/wipolrrules.pdf>, and <http://www.wipo.int/amc/en/domains/lro/fees/>. The Center furthermore makes available a practical user guide at <http://www.wipo.int/amc/en/domains/lro/>.

concerns trademarks, following Center communications on the subject, ICANN also foresees an option for IGOs to object to an applied-for gTLD which they believe may infringe their rights (see paragraphs 39 to 42 herein). The Center has been working with ICANN towards the implementation of the pre-delegation procedure in 2012.

- Post- (TLD) Delegation Dispute Resolution Procedure

27. From early 2008, the Center has raised with ICANN the potential usefulness of a permanent administrative option, additional to the pre-delegation procedure described in the preceding paragraph, that would allow for the filing of a complaint with respect to an approved new gTLD registry operator whose manner of operation or use of its registry is alleged to cause or materially contribute to trademark abuse. In early 2009, the Center communicated to ICANN a concrete substantive proposal for such a trademark-based post-delegation dispute resolution procedure. The proposal also seeks to reduce burdens associated with anticipated levels of trademark infringement by facilitating additional registry-adopted enforcement options.<sup>32</sup> The intent behind this proposal was to offer standardized assistance to ICANN's own compliance oversight responsibilities, by providing an administrative alternative to court litigation, encouraging responsible conduct by relevant actors. This includes the provision of safe harbors for *bona fide* registry operators in a *quasi* public-private partnership.<sup>33</sup>

28. Following various ICANN committee processes and consultations with registry operators, the effectiveness of this Post-Delegation Dispute Resolution Procedure (PDDRP) in the form adopted by ICANN remains uncertain, in particular given the addition of overlapping procedural layers, and issues concerning the intended substantive scope of this mechanism.

(ii) Second Level Rights Protection Mechanisms

- Trademark Clearinghouse

29. ICANN's New gTLD Program includes a "Trademark Clearinghouse" as a centralized repository of authenticated trademark data which could be invoked as the basis for filing under new gTLD RPMs.<sup>34</sup> The adoption of this concept involved extensive ICANN discussions *inter alia* concerning the relation to trademark office determinations. The Center has commented that any such Clearinghouse should not unfairly burden rights holders in the treatment of trademark registrations legitimately obtained through examination and registration systems as applied in many global jurisdictions, and that, if and where appropriate, practical measures may be envisaged to identify any allegedly inappropriate invocation of rights in specific contexts.

30. ICANN's current formulation of the Clearinghouse would purport to allow for inclusion of all nationally or regionally registered word marks, any word marks protected by statute or treaty or validated by court, and "[o]ther marks that constitute intellectual property" (the latter being undefined). With respect to RPMs utilizing Clearinghouse data, ICANN currently proposes to limit the availability of "Sunrise" services (*i.e.*, an opportunity for a trademark owner, for a fee, to preemptively register an exact match of its mark as a domain name) to those trademarks for which current use can be demonstrated. On the other hand, owners of trademarks not substantiated by demonstration of current use would still be eligible to participate in a

<sup>32</sup> See <http://www.wipo.int/amc/en/docs/icann130309.pdf>.

<sup>33</sup> Given the perceived convergence of registry, registrar, and registrant roles within the DNS, the Center has further recommended, *inter alia* taking account of its UDRP-based experiences, and ICANN's decision to allow for cross-ownership between registries and registrars (see <http://www.icann.org/en/minutes/resolutions-05nov10-en.htm>), that ICANN consider extending the PDDRP for registries also to registrar conduct (see, *inter alia*, <http://www.wipo.int/amc/en/docs/icann260310rap.pdf>).

<sup>34</sup> In June 2012, ICANN announced its selection of Trademark Clearinghouse Service Providers, see <http://www.icann.org/en/news/announcements/announcement-3-01jun12-en.htm>

time-limited 60-day “Claims” service (*i.e.*, notice to a potential domain name registrant of the existence of a potentially conflicting trademark right). Both Sunrise and Claims services are presently limited to exact matches of a word mark to a domain name. It is anticipated that such limitations may give rise to gaming, with attendant financial and enforcement burdens for trademark owners and increased potential for consumer confusion. The demonstration of use required for Sunrise services similarly applies to the invocation of trademarks as a basis for a complaint filed under the “Uniform Rapid Suspension” RPM described below.

- Uniform Rapid Suspension System

31. While the UDRP is to remain an important curative tool for disputes involving the considered transfer of a disputed domain name to the trademark owner, the Center has advocated the introduction of a lighter second-level RPM for appropriate cases. To this end, the Center in April 2009 communicated to ICANN a discussion draft of an “Expedited (Domain Name) Suspension Mechanism”.<sup>35</sup> Such draft took account of the need to strike a reasonable balance between the protection of trademark rights recognized by law, the practical interests of good-faith registration authorities to minimize operational burdens, and the legitimate expectations of *bona fide* domain name registrants.

32. ICANN’s New gTLD Program now includes such a UDRP-complementary mechanism. However, as evolved from a sequence of ICANN processes and committees, this Uniform Rapid Suspension (URS) system is viewed by many as having become an overburdened procedure for a limited remedy. For the URS to function as an efficient and enforceable complement to the court-alternative UDRP, a range of issues remain to be addressed.<sup>36</sup>

B. ICANN’S PLANNED FUTURE REVISION OF THE WIPO-INITIATED UDRP

33. Accommodating the dynamic development of the DNS, the UDRP has been offering an effective alternative to court litigation for trademark owners, domain name registrants, and registration authorities. Nevertheless, following discussions at which the clear majority of participants were of the opinion that more harm than good could result from any review of the UDRP by ICANN,<sup>37</sup> a decision has been taken by ICANN’s GNSO to review the UDRP through a process envisaged to commence within some 18 months following the delegation of the first new gTLDs.<sup>38</sup>

34. The UDRP functions today as the remarkable result of care invested by many stakeholders over a dozen years, for public and private benefit. By accommodating evolving norms and practices, the UDRP has proven to be a flexible and fair dispute resolution system. Given ICANN’s institutional structure, where IP holds a mere minority vote, it appears likely that such a review would end up weakening the foundation and functioning of the UDRP. The Center actively follows ICANN stakeholders’ intentions with regard to the UDRP.

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<sup>35</sup> See <http://www.wipo.int/amc/en/docs/icann030409.pdf>.

<sup>36</sup> An extensive inventory of these issues is provided *inter alia* in the Center’s letter of December 2, 2010, available at <http://www.wipo.int/amc/en/docs/icann021210.pdf>. A number of these have been on the agenda of ICANN’s June 2012 Prague Meeting.

<sup>37</sup> See <https://community.icann.org/display/gnsoudrpdtd/Webinar+on+the+Current+State+of+the+UDRP>; see also more generally document WO/GA/39/10, paragraph 31.

<sup>38</sup> See <http://gns0.icann.org/meetings/minutes-council-15dec11-en.htm>.



### C. INTERNATIONALIZED DOMAIN NAMES (IDNs)

35. As noted in paragraphs 2 and 20,<sup>39</sup> another significant policy development in the DNS is the introduction of IDNs (non-Latin script) at the top level. Such introduction connects with ICANN's New gTLD Program where potential new gTLD applications are expected to be made for IDNs.

36. Separately, ICANN's Final Implementation Plan for IDN ccTLD Fast Track Process was published on November 16, 2009.<sup>40</sup> Since then, this has allowed for the introduction of several IDN ccTLDs, associated with the two-letter codes in the ISO 3166-1 standard.<sup>41</sup> Approved requests continue to be delegated into the DNS root zone.<sup>42</sup>

### D. OTHER IDENTIFIERS

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

38. It is recalled that the First WIPO Internet Domain Name Process addressed the relationship between domain names and trademarks. The Second WIPO Internet Domain Name Process concerned the relationship between domain names and five other types of identifiers that had not been addressed, namely, International Nonproprietary Names for pharmaceutical substances (INNs), the names and acronyms of IGOs, personal names, geographical identifiers, including country names, and trade names.

39. At its meeting from September 23 to October 1, 2002, the WIPO General Assembly recommended amending the UDRP in order to provide protection for country names and for the names and acronyms of IGOs.<sup>43</sup> The WIPO Secretariat transmitted these recommendations (WIPO-2 Recommendations) to ICANN in February 2003.<sup>44</sup>

40. Following further WIPO communications, in a letter of March 2006,<sup>45</sup> the then President and CEO of ICANN informed the Secretariat that it had not been possible to achieve a consensus among the various constituencies of ICANN. However, while expressing doubts about the options for moving forward with the WIPO-2 Recommendations as a whole, the letter indicated that progress might be possible with regard to the protection of names and acronyms of IGOs for which an established basis exists in international law.

41. In June 2007, ICANN Staff produced an Issues Report on Dispute Handling for IGO Names and Abbreviations,<sup>46</sup> recommending not to initiate a process on the issue of the protection of IGO names and acronyms, but rather, to consider a dispute resolution policy covering such identifiers at the second level in any new gTLDs. In June 2007, the GNSO requested ICANN Staff to provide a report on a draft IGO Domain Name Dispute Resolution Procedure, primarily foreseen for new gTLDs. Such Report was produced by ICANN Staff in September 2007,<sup>47</sup> but has not been adopted by the GNSO.

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<sup>39</sup> See also footnote 20, *supra*.

<sup>40</sup> See <http://www.icann.org/en/topics/idn/fast-track/idn-ccTLD-implementation-plan-16nov09-en.pdf>.

<sup>41</sup> See [http://www.iso.org/iso/english\\_country\\_names\\_and\\_code\\_elements](http://www.iso.org/iso/english_country_names_and_code_elements).

<sup>42</sup> See <http://www.icann.org/en/topics/idn/fast-track/>.

<sup>43</sup> See [http://www.wipo.int/edocs/mdocs/govbody/en/wo\\_ga\\_28/wo\\_ga\\_28\\_3.pdf](http://www.wipo.int/edocs/mdocs/govbody/en/wo_ga_28/wo_ga_28_3.pdf); see also documents SCT/9/8, paragraphs 6 to 11; and, SCT/9/9, paragraph 149.

<sup>44</sup> See <http://www.wipo.int/amc/en/docs/wipo.doc>.

<sup>45</sup> A similar letter was sent to the then Chairman of the GAC. It is posted on ICANN's web site at <http://www.icann.org/correspondence/twomey-to-tarmizi-13mar06.pdf>.

<sup>46</sup> GNSO Issues Report on Dispute Handling for IGO Names and Abbreviations is posted on ICANN's web site at <http://gns0.icann.org/issues/igo-names/issues-report-igo-drp-15jun07.pdf>.

<sup>47</sup> See <http://gns0.icann.org/drafts/gns0-igo-drp-report-v2-28sep07.pdf>.

42. In the context of its now adopted New gTLD Program, ICANN appears to have limited its current consideration of the protection of the names and acronyms of IGOs to providing potential recourse through the pre-delegation objection procedure concerning the top level (*i.e.*, an applied-for TLD), discussed in paragraphs 25 and 26 above.<sup>48</sup> ICANN and GAC consideration of the protection of such identifiers at the second level remains outstanding.

43. Concerning geographical terms, ICANN's GAC, in particular, has expressed concerns about their protection in the new gTLDs. In 2007 it issued the "GAC Principles regarding New gTLDs",<sup>49</sup> which states *inter alia* that ICANN should avoid delegation of new gTLDs concerning country, territory or place names, and regional language or people descriptions, unless in agreement with the relevant governments or public authorities. Those GAC Principles further stated that new registries should adopt procedures for blocking/challenge of names with national or geographic significance at the second level upon demand of governments.

44. Concerning the top level, ICANN's Applicant Guidebook foresees that "applications for strings that are country or territory names will not be approved, as they are not available under the New gTLD Program in this application round."<sup>50</sup> Applied-for strings which are considered by ICANN to be certain other geographic names, *e.g.*, capital city names, would need to be accompanied by documentation of support or non-objection from the relevant governments or public authorities.<sup>51</sup> Concerning second-level registrations, ICANN's base registry agreement includes a "Schedule of Reserved Names at the Second Level in gTLD Registries" which makes provision for certain country and territory names.<sup>52</sup>

45. Overall, the Center has endeavored to apprise relevant sectors within the Secretariat on the above-mentioned matters, including in support of the work of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT).<sup>53</sup> The agenda of the twenty-sixth session of the SCT includes an update on developments in the context of the expansion of the DNS planned by ICANN. The Center's consultation within the Secretariat also includes the substantive basis for the RPMs discussed in the present document. This notably includes the appropriate scope of the pre- and post-delegation dispute resolution mechanisms discussed in paragraphs 25 to 28, against the backdrop of broader developments in relation to Internet intermediaries.

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<sup>48</sup> Following interventions *inter alia* by the GAC, ICANN has agreed, at least for the first application round, not to admit third-party applications for new gTLDs that would match certain terms associated with the International Federation of Red Cross and Red Crescent Societies (Red Cross) and the International Olympic Committee (IOC), in a number of languages. The stated basis for such limitation to these two entities appears to be a GAC view that these entities uniquely enjoy "two-tiered" protection both at treaty level (*i.e.*, the Geneva Conventions and the Nairobi Treaty respectively) and through national statutes in multiple jurisdictions. (As to protection against second-level registrations of these terms in new gTLDs, discussions are ongoing amongst the GAC and GNSO.) This asserted distinction has been the subject of three communications submitted by IGO Legal Counsels in December 2011 and May and July 2012 to the GAC. At least for the first application round, ICANN appears not to foresee protection for IGO names/acronyms at the top level (for ICANN's most recently released communication on the issue see <http://www.icann.org/en/groups/board/documents/briefing-materials-unredacted-20jun11-en.pdf>), but discussion among ICANN stakeholders on this issue remains ongoing.

<sup>49</sup> See [http://gac.icann.org/web/home/gTLD\\_principles.pdf](http://gac.icann.org/web/home/gTLD_principles.pdf).

<sup>50</sup> See <http://www.icann.org/en/topics/new-gtlds/rfp-redline-30may11-en.pdf>, from section 2.2.1.4.1 "Treatment of Country or Territory Names".

<sup>51</sup> See <http://www.icann.org/en/topics/new-gtlds/rfp-redline-30may11-en.pdf>, from section 2.2.1.4.2 "Geographic Names Requiring Government Support". For objections by governments more generally, see footnote 28, *supra*.

<sup>52</sup> See <http://www.icann.org/en/topics/new-gtlds/agreement-specs-redline-30may11-en.pdf>, at Specification 5.

<sup>53</sup> See *e.g.*, documents SCT/24/4, SCT 25/3, and SCT 26/6 available at

[http://www.wipo.int/edocs/mdocs/sct/en/sct\\_24/sct\\_24\\_4.pdf](http://www.wipo.int/edocs/mdocs/sct/en/sct_24/sct_24_4.pdf),

[http://www.wipo.int/edocs/mdocs/sct/en/sct\\_25/sct\\_25\\_3.pdf](http://www.wipo.int/edocs/mdocs/sct/en/sct_25/sct_25_3.pdf), and

[http://www.wipo.int/edocs/mdocs/sct/en/sct\\_26/sct\\_26\\_6.pdf](http://www.wipo.int/edocs/mdocs/sct/en/sct_26/sct_26_6.pdf) respectively.

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

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

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