

WIPO General Assembly

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WIPO ARBITRATION AND MEDIATION CENTER, INCLUDING DOMAIN NAMES

Document prepared by the Secretariat

1. The WIPO Arbitration and Mediation Center (“Center”) forms part of the IP and Innovation Ecosystems Sector (IES). In coordination with other WIPO Sectors, IES is responsible for helping Member States develop their intellectual property (IP) and innovation ecosystems to drive enterprise and economic growth. Among other activities, IES provides support for enterprises in IP commercialization and otherwise using IP for business growth.
2. Within this framework, the present document provides an update on the Center’s activities as an international resource for time- and cost-efficient alternatives to court litigation of IP disputes, acting as an administrator of cases as well as a provider of legal and organizational expertise in alternative dispute resolution (ADR).
3. This document also provides an update on the domain name-related activities of WIPO, as previously reported in WO/GA/53/8.¹ 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, including rights protection mechanisms (RPMs) for the introduction of new generic top-level domains (gTLDs), the planned review by the Internet Corporation for Assigned Names and Numbers (ICANN) of the Uniform Domain Name Dispute Resolution Policy (UDRP) and other RPMs, and the status of the recommendations made by the Member States of WIPO in the context of the Second WIPO Internet Domain Name Process.

¹ See https://www.wipo.int/meetings/en/doc_details.jsp?doc_id=507114.

I. ARBITRATION AND MEDIATION OF IP DISPUTES

A. CASE ADMINISTRATION

4. The mediation and arbitration procedures offered by the Center aim to meet parties' needs for time- and cost-effectiveness in the resolution of disputes in relation to IP rights. The Center is engaged in the management of cases under those procedures, which includes training,² appointing, and supporting qualified mediators and arbitrators, and maintaining up-to-date case infrastructure. Cases are normally filed with the Center on the basis of a prior contract clause or, less frequently, post-dispute submission agreement (including court referrals), and also by unilateral request under Article 4 of the WIPO Mediation Rules.³

5. During the period, a range of large companies (including biotech/pharma and online platforms), small- and medium-sized enterprises (SME),⁴ universities and research organizations, and individuals, from 40 countries used the Center's procedures,⁵ including Good Offices.⁶ The Center noted a 24 per cent increase in its mediation and arbitration caseload in 2020, and further growth in the first half of 2021. New cases under the WIPO Mediation, Arbitration, and Expedited Arbitration Rules (WIPO Rules) involved Research and Development (R&D) agreements including consortium agreements, patent, trademark, and copyright licensing, copyright collective management, and software development and licensing.⁷

6. The Center continued to undertake initiatives to facilitate access for potential users to WIPO ADR. The Center enhanced the WIPO eADR electronic case facility,⁸ which many parties use to add efficiency to their arbitration proceedings.⁹ In addition, during the period, the large majority of mediation meetings and arbitration hearings were conducted remotely using WIPO-hosted facilities. To assist parties and neutrals in the preparation of such remote meetings and hearings, the Center developed the WIPO Checklist for the Online Conduct of Mediation and Arbitration Proceedings.¹⁰ In 2020 the settlement rate in WIPO mediation cases increased from 70 per cent to 78 per cent. These resources as well as the Center initiatives covered in paragraphs 14 to 18 have been meeting with increased demand in the recent global health conditions.¹¹

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

³ The Center makes available an online clause generator that allows parties to build core clauses and submission agreements. See <https://amc.wipo.int/clause-generator/>.

⁴ As of June 2021, SMEs represent 37 per cent of users. See furthermore WIPO Schedule of Fees and Costs at <https://www.wipo.int/amc/en/calculator/adr.jsp>.

⁵ Over 25 per cent of cases involved more than two parties. Some 30 per cent of cases involved parties that also use WIPO's Patent Cooperation Treaty (PCT), Madrid, or Hague services.

⁶ The Center provides procedural assistance (Good Offices) to parties involved in an IP or technology dispute, in order to facilitate direct settlement between them or the submission of their dispute to WIPO mediation or arbitration, as alternatives to court litigation.

⁷ The issues involved included patent, trademark, and copyright infringement, patent exhaustion, co-ownership of a patent, patent pools, the determination of appropriate patent licensing terms, breach of contract, royalty payments, determination of copyright licensing terms, re-inclusion in a R&D consortium, removal of content from online platforms, specific performance including withdrawal of a legal action, and trademark oppositions pending before an Intellectual Property Office.

⁸ WIPO eADR offers online case communication and storage of documents facilitating time- and cost-efficient mediation and arbitration proceedings. See <https://www.wipo.int/amc/en/eadr/>.

⁹ In the period, the America's Cup Arbitration Panel (ACAP) concluded its arbitrations and mediations arising from the 36th edition of the America's Cup sailing race series using a customized version of eADR provided to ACAP by the Center.

¹⁰ Available at <https://www.wipo.int/amc/en/eadr/checklist/index.html>.

¹¹ WIPO mediation, arbitration, and domain name dispute resolution services remained up and running notwithstanding the consequences brought by COVID-19. For parties and representatives, the Center posted logistical information to facilitate efficient proceedings under the circumstances. See <https://www.wipo.int/amc/en/center/wipoupdate.html>, and <https://www.wipo.int/amc/en/center/wipocenterupdate.html>.

7. Reflecting international developments in mediation and arbitration, the Center updated the WIPO Rules per July 1, 2021.¹² Notably, confirming the described online practices, the updated WIPO Rules expressly permit, and foresee as a default option, the electronic filing of all new WIPO ADR cases, as well as the electronic submission of any case communications.¹³

8. The Center also provides tailored ADR services for specific sectors.¹⁴ One example is the Center's services for disputes concerning fair, reasonable and non-discriminatory (FRAND) terms for standard-essential patents (SEPs).¹⁵ Noting the growing number of Requests for WIPO Mediation of FRAND-related disputes, including cases pending before courts, the Center recently updated the Guidance on WIPO FRAND ADR.¹⁶ In the life sciences sector, the Center offers tailored WIPO ADR options to facilitate contract negotiation and dispute resolution.¹⁷

B. COLLABORATION WITH INTELLECTUAL PROPERTY OFFICES

9. Another core area of Center activity is collaboration with IP and Copyright Offices (IPOs) and Courts. Since the 2020 Assemblies, the Center has entered into new collaborations with IP authorities in four Member States.¹⁸ The purpose of such collaborations¹⁹ is to promote and help introduce ADR options to prevent and resolve IP and technology disputes outside the courts or other adjudicative bodies. In the period, such contact consisted of the development of country-tailored information materials for interested parties concerning ADR options, including on online case administration; training and joint events for stakeholders to inform them of the benefits of mediation and arbitration for resolving IP and related disputes;²⁰ and the referral of party inquiries received by an IPO to the Center for further assistance (notably in infringement cases).

¹² See <https://www.wipo.int/amc/en/rules/>.

¹³ Likewise, remote WIPO ADR meetings and hearings (e.g., by videoconference or using online tools) are expressly permitted and encouraged by the updated Rules. The updated WIPO Rules further introduce disclosure requirements concerning the identity of third-party funders at an early stage of WIPO arbitration proceedings, in the interest of neutrality and impartiality of the arbitral tribunal.

¹⁴ The Center's website provides a full overview of the range of these services. See <https://www.wipo.int/amc/en/center/specific-sectors/>.

¹⁵ See <https://www.wipo.int/amc/en/center/specific-sectors/ict/frand/>.

¹⁶ See <https://www.wipo.int/export/sites/www/amc/en/docs/wipofrandadrguidance.pdf>. First published in 2017 and updated in 2021, the Center developed the Guidance on WIPO FRAND ADR in collaboration with telecom stakeholders and patent arbitration experts. The document seeks to assist parties and neutrals to better understand and make use of available dispute resolution options when negotiating or drafting FRAND licensing agreements. The document covers key elements that parties may wish to consider to shape the ADR process, notably to address large SEP portfolios in the telecom, Internet of Things, and Connected Mobility sectors, and to manage time and cost of proceedings. Tailored model submission agreements assisting parties to refer a FRAND-related dispute to WIPO mediation, arbitration or expert determination are also included.

¹⁷ See <https://www.wipo.int/amc/en/center/specific-sectors/lifesciences/>.

¹⁸ The Algerian National Institute of Industrial Property (INAPI), the Industrial Property Office of the Czech Republic (IPO CZ), the Nigerian Copyright Commission (NCC), and the Ministry of Culture and Sports of Spain. A full list of Center collaborations with IPOs is available at <http://www.wipo.int/amc/en/center/specific-sectors/ipoffices/>.

¹⁹ This includes IPOs and Courts in Algeria, Argentina, Australia, Belarus, Brazil, Chile, China, Colombia, Costa Rica, Cuba, the Czech Republic, the Dominican Republic, Ecuador, El Salvador, the Eurasian Patent Organization, Hungary, Indonesia, Israel, Italy, Kazakhstan, Kenya, the Republic of Korea, the Kyrgyz Republic, Lithuania, Mexico, Morocco, Nigeria, Paraguay, the Philippines, Poland, Romania, Russian Federation, Serbia, Singapore, Spain, Switzerland, Tanzania, Trinidad and Tobago, Ukraine, the United Kingdom, and the United States of America.

²⁰ For examples of events organized by the Center in collaboration with IPOs see <http://www.wipo.int/amc/en/center/specific-sectors/ipoffices/>. ADR also is included in the programs of WIPO Roving Seminars and Webinars and online consultation meetings organized in collaboration with IPOs. See http://www.wipo.int/dcea/en/roving_seminars/.

10. Some IPOs have developed ADR options or encourage parties to use such options,²¹ in the context of proceedings pending before them, notably trademark or patent opposition proceedings. The Center worked with IPOs in the development of mediation and expert determination options for such ADR proceedings. The Center also collaborated with IPOs in the administration of cases submitted by parties under such schemes.²² In the area of copyright, some IPOs administer ADR proceedings in domestic disputes and designate the Center as administrator of cases where one or both parties are domiciled outside the country.²³

11. Additionally, the Center collaborated with IPOs in the development of R&D model agreements, the dispute resolution provisions of which include WIPO mediation followed by WIPO expedited arbitration options.²⁴

12. The Center also collaborates with a growing number of courts to facilitate the referral to WIPO Mediation of cases where parties are willing to explore settlement.²⁵

13. Reflecting this growing experience, the updated WIPO Guide on Alternative Dispute Resolution for IPOs and Courts provides a broad overview of ADR for IP disputes and presents options for interested IPOs and Courts to integrate ADR into their processes.²⁶ The Guide also outlines the Center's collaborations and provides examples of related model documents.

C. ADR INFORMATION RESOURCES

14. During the period, to meet with increased demand for online ADR resources and training, the Center has continued with existing outreach channels, such as its quarterly ADR Highlights newsletter,²⁷ while expanding or opening new social and other media for users or potential

²¹ For example, to further encourage the use of mediation during COVID-19, the Center and the Ministry of Culture, Sports and Tourism (MCST) of the Republic of Korea offered to cover partially the cost of WIPO Mediation procedures for parties involved in international copyright and content-related disputes. In addition, the Center and the National Institute of Copyright of Mexico (INDAUTOR) collaborate to provide virtual conciliation meetings to resolve copyright disputes in Mexico. The Center also collaborates with the Superintendence of Industry and Commerce of Colombia's (SIC) jurisdictional authority to offer mediation as an alternative to the judicial route.

²² For example, under its collaboration with IPOS, the Center has participated in the development of a mediation option for trademark and other proceedings, and an expert determination option for patent proceedings pending before IPOS, and it administers such proceedings. This mediation option is also the subject of a promotional scheme developed by IPOS with the Center. The Center also collaborates with IOPHL concerning the administration of mediation proceedings involving IP rights in the Philippines. The Trademark Trial and Appeal Board (TTAB) and the Patent Trial and Appeal Board (PTAB) of the United States Patent and Trademark Office (USPTO) encourage parties to consider ADR as a means of settling issues raised in those proceedings; the Center is one of the listed dispute resolution service providers. Under its PPO collaboration, the Center participated in the development of a WIPO mediation option that has become available for pending trademark opposition proceedings, and is to administer such proceedings.

²³ This notably concerns the collaborations between the Center and the National Copyright Directorate of Colombia (DNDA), the Korea Copyright Commission (KCC), and the Korea Creative Content Agency (KOCCA). See <http://www.wipo.int/amc/en/center/specific-sectors/ipoffices/>.

²⁴ For example, the Center produced such models with the Spanish Patent and Trademark Office (OEPM). Other model R&D agreements that recommend WIPO Mediation followed by [Expedited] Arbitration include the EU DESCA 2020 Model Consortium Agreement; the Intellectual Property Agreement Guide (IPAG) Model Agreements in Austria; and the Sample Agreements for Research and Development Cooperation in Germany. For further information see <http://www.wipo.int/amc/en/center/specific-sectors/rd/>.

²⁵ See https://www.wipo.int/amc/en/clauses/national_court.html. For example, under the framework collaboration between the Supreme People's Court of China (SPC) and WIPO, the SPC and the Center, in coordination with the WIPO Office in China, collaborate in the area of mediation to help resolve international IP and technology disputes in China. In the period, cooperation has commenced concerning a WIPO mediation option for international IP cases pending before courts in Shanghai (see <https://www.wipo.int/amc/en/center/specific-sectors/national-courts/china/spc.html>), under which the Center administered a number of cases.

²⁶ The second edition of the Guide is available at https://www.wipo.int/edocs/pubdocs/en/wipo_pub_guide_adr.pdf.

²⁷ Subscribers to WIPO ADR Highlights increased to over 7,500 during the period; all editions are available at https://www.wipo.int/newsletters-archive/en/adr_highlights.html.

users of WIPO ADR services. The Center's LinkedIn page acts as a platform for the IP, technology, and ADR community to keep current with WIPO ADR developments, events, and publications; with over 8,000 followers, this page is already an active IP ADR resource.²⁸

15. The Center is increasingly working with webinars, which it makes available to stakeholders with content tailored to their area of interest in a range of languages.²⁹ Since the 2020 Assemblies, the Center has organized or co-organized over 80 webinars, with more than 17,000 registrants from 155 countries.

16. Noting the increase in digital copyright disputes in its cases, the Center conducted the WIPO-MCST Survey on the Use of ADR Mechanisms for Business to Business (B2B) Digital Copyright- and Content-related Disputes, which attracted over 1,000 participants. The Center's survey report provides insight into such disputes across industries internationally, including current use of mediation and arbitration instead of court litigation to resolve such disputes. The report should inform the potential development of adapted ADR procedures for such disputes.³⁰

17. In March 2021, the WIPO Center launched WIPO ADR Young, a networking and training forum for young professionals in the IP and dispute resolution communities. This initiative has so far attracted over 350 members from some 70 countries.³¹

18. Under the WIPO Mediation Pledge for IP and Technology Disputes, signatories and collaborating entities agree to promote mediation as an alternative to court litigation in order to reduce the impact of disputes in innovation and creative processes. Participants now number over 630, including some 20 Member State IPOs and 10 IP and ADR industry associations.³²

II. DOMAIN NAME CASE ADMINISTRATION

A. UDRP

19. The DNS raises 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 solutions, notably in the First³³ and Second³⁴ WIPO Internet Domain Name Processes. Through the Center, WIPO provides trademark owners with efficient international mechanisms to deal with the bad-faith registration and use of domain names corresponding to their trademark rights. The main mechanism administered by the Center, the UDRP, was adopted by ICANN on the basis of recommendations made by WIPO in the First WIPO Process.

20. With a greater number of people spending more time online during the pandemic, infringers have been finding an increasingly target-rich environment. Trademark owners stepped up their brand enforcement on the Internet as they further shift to providing their goods and services through online means. Limited in scope to clear cases of bad faith, the UDRP has

²⁸ See <https://www.linkedin.com/showcase/wipo-arbitration-and-mediation-center/?viewAsMember=true>.

²⁹ To date, Center webinars have been delivered in Chinese, Dutch, English, French, German, Italian, Japanese, Russian, and Spanish. Information on upcoming webinars (and past recordings) is available at <https://www.wipo.int/amc/en/events/webinar.html>.

³⁰ See <https://www.wipo.int/amc/en/center/copyright>.

³¹ See <https://www.wipo.int/amc/en/center/wipoadryoung>.

³² See <https://www.wipo.int/amc/en/mediation/pledge.html>.

³³ 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>.

³⁴ 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>.

proven in high demand.³⁵ Since December 1999, the Center has administered over 53,000 UDRP-based cases.³⁶ Right holders in 2020 filed a record 4,204 UDRP-based complaints with the Center, as businesses reacted to the proliferation of websites used for counterfeit sales, fraud, phishing, and other forms of online trademark abuse. In June 2020, the total number of domain names in WIPO UDRP-based cases passed 96,000. The scope of the risks for consumers can also be seen in the top sectors for complainant business activity, including Banking and Finance, Biotechnology and Pharmaceuticals, Internet and Information Technology, Retail, Fashion, and Entertainment.

21. Cybersquatting – the abusive inclusion of a trademark in a domain name – is a global problem. Named parties to WIPO cases in 2020 covered 128 countries, for a total of 181 since the UDRP’s inception. In function of the language of the registration agreement of the domain name at issue, WIPO so far has conducted UDRP proceedings in 23 languages.³⁷

22. All WIPO UDRP panel decisions are posted on the Center’s website. The Center’s free, online “WIPO Overview of WIPO Panel Views on Selected UDRP Questions” remains a vital and globally-consulted jurisprudential overview of decision trends on important case issues covering 100 topics, including reference to almost 1,000 representative decisions from over 265 WIPO Panelists.³⁸ To facilitate access to decisions according to subject matter, the Center also offers an online searchable Legal Index of WIPO UDRP Decisions.³⁹

23. Mindful of WIPO’s foundational role in the UDRP, the Center actively monitors developments in the DNS with a view to adjusting its resources and practices.⁴⁰ The Center organizes Domain Name Dispute Resolution Workshops to update interested parties,⁴¹ as well as important meetings of its Domain Name Panelists.

B. COUNTRY CODE TOP-LEVEL DOMAINS (CCTLDS)

24. While the mandatory application of the UDRP is limited to domain names registered in gTLDs (such as .com), the Center also assists ccTLD registries in their establishment of registration conditions and dispute resolution procedures that conform with best practices in registry management and IP protection.⁴² Some ccTLD registries adopt the UDRP directly, while others have adopted UDRP-based procedures that take account of particular circumstances and needs of individual ccTLDs. The Center provides dispute resolution services to over 75 ccTLD registries, including the .SA and السعودية (Saudi Arabia) domains added in April 2021.⁴³

³⁵ The UDRP does not prevent either party from submitting a dispute to a competent court of justice; however, very few cases that have been decided under the UDRP have been brought before a court. See Selected UDRP-related Court Cases at <http://www.wipo.int/amc/en/domains/challenged>.

³⁶ The Center makes available a wide range of online real-time statistics to assist WIPO UDRP case parties and neutrals, trademark attorneys, domain name registrants, domain name policy makers, media, and academics. See <http://www.wipo.int/amc/en/domains/statistics>.

³⁷ In alphabetical order, Chinese, Czech, Danish, Dutch, English, Estonian, French, German, Hebrew, Italian, Japanese, Korean, Norwegian, Polish, Portuguese, Romanian, Russian, Slovak, Spanish, Swedish, Turkish, Ukrainian, and Vietnamese.

³⁸ See <http://www.wipo.int/amc/en/domains/search/overview3.0/>. The increased scope of WIPO Overview 3.0 reflects a wide range of DNS and UDRP case evolutions. The WIPO Overview is instrumental in developing and maintaining consistency of WIPO UDRP jurisprudence.

³⁹ See <http://www.wipo.int/amc/en/domains/search/legalindex/>.

⁴⁰ In 2018, the Center published informal WIPO guidance for parties on the practical impact of the European Union’s General Data Protection Regulation (GDPR) on UDRP proceedings. See paragraphs 35 to 37, *infra*. See also, WO/GA/47/14, paragraph 30, and WO/GA/41/17 Rev.2, paragraphs 14 to 16.

⁴¹ See footnote 2, *supra*.

⁴² See <http://www.wipo.int/amc/en/new/eu.html>.

⁴³ Other ccTLDs that have joined in the last five years include .AI (Anguilla), .CN and .中国 (China), .EU (European Union), .GE (Georgia), .PY (Paraguay), .SE Sweden, and .UA (Ukraine); the .AC, .IO, and .SH registries

25. For all ccTLDs concerned, the Center offers significantly expanded online party resources, including eligibility criteria for registration, supported characters, and multilingual model pleadings and filing information,⁴⁴ as well as summaries of relevant differences between the respective UDRP-based ccTLD policies and the UDRP.⁴⁵ This information is summarized in the Guide to WIPO's services for country code top-level domain registries.⁴⁶

III. POLICY DEVELOPMENTS IN THE DNS

26. A number of policy developments in relation to ICANN present both opportunities and challenges for owners and users of IP rights. One is ICANN's introduction of a significant number of new gTLDs. Such new gTLDs may be of an "open" nature (similar to .com), or may take on more specific or restrictive characteristics, for example taking the form of .[brand], .[city], .[community], .[culture], .[industry], or .[language]. A noteworthy element of this growth of the DNS concerns the introduction of Internationalized Domain Names (IDNs) at the top level – expanding the DNS' linguistic availability. Also, ICANN's expansion of the DNS raises rights protection questions in connection with the Second WIPO Process.

A. NEW GTLDS

27. ICANN implementation of its New gTLD Program, formally approved in June 2011,⁴⁷ is detailed in its much-revised "Applicant Guidebook".⁴⁸ Delegation of the first new gTLDs into the Internet's Root Zone took place in October 2013, with nearly all of the unique over 1,200 gTLDs delegated by June 2019.⁴⁹ Its further policy work on this topic being substantially concluded, ICANN is planning on another round of "new gTLDs" likely in the next few years.⁵⁰

28. The Center remains committed to working with stakeholders to attempt to safeguard the observance of general principles of IP protection in new gTLDs. A number of the RPMs emerged from a series of ICANN committees and processes for new gTLDs.⁵¹ Set out below is a broad description of these ICANN RPMs, for the top level and the second level respectively.

(a) Top Level RPMs

(i) Pre- (TLD) Delegation Dispute Resolution Procedure

29. This mechanism allowed trademark owners to lodge Legal Rights Objections (LRO) to new gTLD applications at the top level where certain substantive criteria were met.⁵² The Center assisted ICANN in the establishment of these criteria on the basis of the "WIPO Joint

adopted a slightly modified version of the UDRP. The full list of ccTLDs that have retained the Center as domain name dispute resolution provider is available at <http://www.wipo.int/amc/en/domains/cctld/>.

⁴⁴ For example, the Center's page dedicated to .CH (Switzerland) is now also available in German and Italian, in addition to English, French, and Spanish.

⁴⁵ See <http://www.wipo.int/amc/en/domains/cctld/>.

⁴⁶ See https://www.wipo.int/edocs/pubdocs/en/wipo_pub_1069.pdf.

⁴⁷ 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.

⁴⁸ ICANN's Applicant Guidebook is available at <http://newgtlds.icann.org/en/applicants/agb>.

⁴⁹ Delegated new gTLDs are listed at <http://newgtlds.icann.org/en/program-status/delegated-strings>.

⁵⁰ See <https://gnso.icann.org/sites/default/files/file/field-file-attach/final-report-newgtld-subsequent-procedures-pdp-02feb21-en.pdf>.

⁵¹ For further background including references, see WO/GA/39/10, in particular paragraphs 23 to 30. It is noted here that ICANN rejected a proposal for a "Globally Protected Marks List".

⁵² Other objection grounds recognized by ICANN were: "String Confusion Objections", "Community Objections", and "Limited Public Interest Objections". The Applicant Guidebook further includes a number of other procedures which governments could avail themselves of following ICANN announcement of new gTLD applications. Notably, section 1.1.2.4 provides for "GAC Early Warning," and section 1.1.2.7 provides for "Receipt of GAC Advice on New gTLDs" for the ICANN Board's consideration.

Recommendation Concerning Provisions on the Protection of Marks, and Other Industrial Property Rights in Signs, on the Internet".⁵³ Appointed by ICANN as the exclusive provider of LRO dispute resolution services,⁵⁴ the Center processed 69 compliant LRO filings in 2013.⁵⁵

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

30. In early 2009, the Center communicated to ICANN a concrete substantive proposal for a permanent administrative option that would allow for the filing of a complaint with respect to an approved new gTLD registry operator whose manner of operation or use of its registry is alleged to cause or materially contribute to trademark abuse.⁵⁶ The proposal's intent was to offer standardized assistance to ICANN's own compliance oversight responsibilities, by providing an administrative alternative to court litigation, encouraging responsible conduct by relevant actors and including appropriate registry safe-harbors.⁵⁷

31. Following various ICANN processes, including consultations with registry operators, the effectiveness of this PDDRP in the form adopted by ICANN remains uncertain, in particular given the addition of overlapping procedural layers, and issues concerning the intended substantive scope of this mechanism, such as its exclusion of the legal concept of "willful blindness" from the applicable criteria.⁵⁸

(b) Second Level RPMs

(i) Trademark Clearinghouse (TMCH)

32. ICANN's New gTLD Program includes a TMCH as a centralized repository of authenticated trademark data which could be invoked as the basis for filing under new gTLD RPMs.⁵⁹ The Center commented that the TMCH should not unfairly burden rights holders in the

⁵³ Adopted by the WIPO General Assembly in September 2001; see <http://www.wipo.int/edocs/pubdocs/en/marks/845/pub845.pdf>.

⁵⁴ See section 3.2 of the ICANN Applicant Guidebook at <http://newgtlds.icann.org/en/applicants/agb/objection-procedures-04jun12-en.pdf>.

⁵⁵ 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/>; see WIPO-registered LRO cases at <http://www.wipo.int/amc/en/domains/lro/cases/>. All WIPO LRO expert panel determinations are available on the Center's website, as is a Center report on the LRO process. The WIPO LRO report notes that an overwhelming majority of LROs were filed against applications for gTLD strings with descriptive or dictionary meaning. Many expert panels concluded that where a trademark owner has adopted a common dictionary term as a trademark, a gTLD application intended solely to take advantage of such common dictionary meaning would not as such violate the decision standards for LROs. In certain cases panels addressed trademark registrations that were primarily obtained for the purpose of supporting an application for a new gTLD and/or LRO, with little or no demonstrable prior use. See <http://www.wipo.int/amc/en/docs/lroreport.pdf>.

⁵⁶ See <http://www.wipo.int/amc/en/docs/icann130309.pdf>.

⁵⁷ 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 of 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>).

⁵⁸ Notably in late 2016, a group of brand owners opted to file a Public Interest Commitment Dispute Resolution Procedure (PICDRP) instead of using the available PDDRP. In light of broader policy interests, the Center in 2013 agreed with ICANN to become a provider for the trademark PDDRP. <https://www.icann.org/en/system/files/files/feedback-picdrp-panel-report-14mar17-en.pdf>.

⁵⁹ The TMCH allows for inclusion of registered word marks, word marks protected by statute or treaty or validated by court, and "[o]ther marks that constitute intellectual property" (the latter being undefined). With respect to RPMs utilizing TMCH data, the availability of "Sunrise" services (*i.e.*, an opportunity for a trademark owner, for a fee, to preemptively register an exact match of its mark as a domain name) is limited to those trademarks for which current use can be demonstrated. Whether or not substantiated by demonstration of current use, trademark owners would also be eligible to participate in a time-limited "Claims" service (*i.e.*, notice to a potential domain name registrant of the existence of a potentially conflicting trademark right, and notice to the relevant trademark owner(s) in the event that the registrant nevertheless proceeds with domain name registration). As mandated by ICANN, the

treatment of trademark registrations legitimately obtained through examination and registration systems as applied in many jurisdictions, and that, if and where relevant, practical measures may be envisaged to identify any allegedly inappropriate invocation of rights in specific contexts. Through May 2021, the TMCH received some 46,500 entries.⁶⁰

(ii) Uniform Rapid Suspension (URS) System

33. While the UDRP remains available as a curative tool for new-gTLD disputes involving the considered transfer of a disputed domain name to the trademark owner, ICANN has introduced what is intended to be a “lighter” second-level RPM for appropriate cases.⁶¹ Evolved from a sequence of ICANN processes and committees, the URS continues to raise questions, including its relationship to the UDRP.⁶² ICANN invited tenders from prospective URS providers, to which after careful consideration of the ICANN URS model and related resources, the Center has not been in a position to apply.⁶³ The Center continues to monitor developments.

B. ICANN’S PLANNED REVISION OF THE WIPO-INITIATED UDRP AND OTHER RPMS

34. Accommodating the dynamic development of the DNS, the UDRP has been offering a highly effective alternative to court litigation for trademark owners, domain name registrants, and registration authorities. ICANN’s Generic Names Supporting Organization (GNSO) decided to review the UDRP following the launch of new gTLDs.⁶⁴ ICANN’s 2015 Preliminary Issue Report describes a range of complex substantive and process questions.⁶⁵ The Center provided observations highlighting the UDRP’s long-proven success and the risks associated with any attempted ICANN revision of the UDRP. Following a public comment period, ICANN published its Final Issue Report in January 2016 recommending that the GNSO launch a Policy Development Process (PDP) to review all RPMS in two phases; the now-concluded initial phase issued a Final Report⁶⁶ focused on RPMS developed for the New gTLD Program, notably the TMCH (including “Sunrise” and “Claims” RPMS) and URS and proposing minor changes to such RPMS,⁶⁷ whereas the second planned phase will focus on the UDRP.⁶⁸ This latter UDRP phase is in particular a matter of serious concern, and the Center continues to closely follow ICANN stakeholders’ intentions with regard to the UDRP and trademark RPMS generally. In this effort,

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

⁶⁰ See <http://trademark-clearinghouse.com/content/tmch-stats>.

⁶¹ The Center for its part communicated to ICANN in April 2009 a discussion draft of an “Expedited (Domain Name) Suspension Mechanism” (see <http://www.wipo.int/amc/en/docs/icann030409.pdf>) and has made subsequent proposals for a streamlined mechanism based on this model at ICANN Meetings (see <http://prague44.icann.org/node/31773> and <http://toronto45.icann.org/node/34325>). Such proposals took account of the need to strike a balance between the protection of trademark rights recognized by law, the practical interests of good-faith registration authorities to minimize operational burdens, and the legitimate expectations of *bona fide* domain name registrants.

⁶² An extensive inventory of these issues is provided *inter alia* in the Center’s letter to ICANN of December 2, 2010, available at <http://www.wipo.int/amc/en/docs/icann021210.pdf>.

⁶³ The question of accreditation of providers gives rise to concerns as to the stability of RPMS; WIPO raised this issue as early as 2007 in the context of the UDRP (see <http://www.wipo.int/amc/en/docs/icann040707.pdf>).

⁶⁴ Despite discussions in 2011 in which the clear majority of participants were of the opinion that more harm than good could result from any review of the UDRP by ICANN as a registration-driven body. See <https://community.icann.org/display/gnsoudrpd/ Webinar+on+the+Current+State+of+the+UDRP>; see also more generally document WO/GA/39/10, paragraph 31.

⁶⁵ See <http://gnso.icann.org/en/issues/new-gtlds/rpm-prelim-issue-09oct15-en.pdf>.

⁶⁶ See <https://gnso.icann.org/sites/default/files/file/field-file-attach/rpm-phase-1-proposed-24nov20-en.pdf>.

⁶⁷ See in particular “Section I: Description and Explanation” including three categories of proposed changes to RPMS at <https://www.icann.org/public-comments/gnso-rpm-pdp-phase-1-final-recommendations-2021-04-07-en>.

⁶⁸ See <https://gnso.icann.org/en/issues/new-gtlds/rpm-final-issue-11jan16-en.pdf>.

the Center where relevant is in contact with stakeholders such as the European Communities Trademark Association (ECTA), the International Trademark Association (INTA), and MARQUES.

C. GDPR AND THE WHOIS DATABASE

35. The European Union's General Data Protection Regulation (GDPR) came into force on May 25, 2018. As stated by the European Commission, the overarching aim of the GDPR is to address privacy and data concerns, whereby these aims must be measured against legitimate third-party interests such as contracts and legal disputes.

36. After May 25, 2018, publicly-available Whois data no longer includes full contact details for the domain name registrant. Such data is generally limited to the "registrant organization" and country.⁶⁹ Despite these public limitations, where a UDRP provider has received a UDRP complaint, ICANN-compliant registrars will normally provide Whois information on request from such provider (and at the same time "lock" the domain name's registration and registrar details), further to due process requirements codified in the UDRP Rules.⁷⁰

37. The Center continues to closely monitor the impact of data protection regulations on UDRP proceedings. Separate from the Center's UDRP function, with a view to addressing broader IP enforcement concerns occasioned by privacy regulation, there are significant ongoing stakeholder discussions on a possible Whois "accreditation and access" model, including as to a potential WIPO role to certify IP owners' rights for such access.⁷¹ ICANN debate continues as to the specifics of what has also been called a System for Standardized Access/Disclosure to non-public gTLD registration data ("SSAD"), including at a policy level through ICANN's Expedited Policy Development Process (or EPDP).⁷²

D. IDNS

38. As observed in paragraph 26, another noteworthy policy development in the DNS is the introduction of IDNs (non-Latin script) at the top level.⁷³ Many of these were among the first new gTLDs announced by ICANN for delegation in the DNS root zone.

⁶⁹ Notably, the registrant's name and email address will in most instances not be visible. However, in order to facilitate contact with the domain name registrant, the concerned registrar is required to provide an "anonymized" email address or web-based contact form.

⁷⁰ The ICANN "Temporary [contract] Specification" for gTLD Registration Data expressly acknowledged that registrars must provide full "Registration Data" to UDRP providers.⁷⁰ This appeared to be on the recognition that UDRP providers meet the GDPR's Article 6(1)(f) "legitimate purposes" and Article 6(1)(b) "performance of a contract" criteria, such that registrars can and should provide Whois data to UDRP providers.

⁷¹ See <https://www.icann.org/en/system/files/files/framework-elements-unified-access-model-for-discussion-18jun18-en.pdf>.

⁷² See GNSO Council adoption of the Phase 1 Final Report of the Expedited Policy Development Process (EPDP) on the Temporary Specification for gTLD Registration Data Team at <https://www.icann.org/en/announcements/details/gnsocounciladopts-epdp-final-report-on-the-temporary-specification-for-gtld-registration-data-4-3-2019-en> and Phase 2 Final Report at <https://www.icann.org/en/blogs/details/epdp-phase-2-team-publishes-final-report-10-8-2020-en>. Several specific questions that remained unanswered were moved to a "Phase 2a", see e.g., <https://www.icann.org/en/announcements/details/call-for-expressions-of-interest-chair-of-phase-2a-gnsocounciladopts-epdp-on-the-temporary-specification-for-gtld-registration-data-4-11-2020-en>.

⁷³ See also ICANN's Final Implementation Plan for IDN ccTLD Fast Track Process published in November 2009 (see <https://www.icann.org/en/system/files/files/idn-ccTLD-implementation-plan-16nov09-en.pdf>). Since then, this has allowed for the introduction of IDN ccTLDs, associated with the two-letter codes in the ISO 3166-1 standard (see http://www.iso.org/iso/english_country_names_and_code_elements).

E. OTHER IDENTIFIERS

39. 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.

(a) International Governmental Organizations (IGOs)

40. It is recalled that the First WIPO Process addressed the relationship between domain names and trademarks. The Second WIPO Process concerned the relationship between domain names and other types of identifiers, including country names and IGO names and acronyms. The 2002 WIPO General Assembly recommended amending the UDRP in order to provide protection for country names and the names and acronyms of IGOs.⁷⁴

41. These recommendations were part of protracted and complex deliberations within ICANN's multi-layered policy development framework, as relevant especially to the application conditions for new gTLDs. Previous WIPO General Assembly documents track in more detail the process and substance of these continuing deliberations, which in the ICANN ecosystem notably involve the Governmental Advisory Committee (GAC), the Board, the Board's New gTLD Program Committee (NGPC), and the GNSO Council.⁷⁵

42. In terms of the present status of the issue of protection in the DNS of the names and acronyms of IGOs, on GAC advice, the ICANN Board has provisionally reserved from third-party registration in new GTLDs the full names of IGOs at the top and second levels in two languages. Meanwhile, despite GAC advice and IGO positions favoring preventative protection, in June 2014, the GNSO Council voted to initiate a second PDP on the desirability and modalities of giving IGOs access to curative RPMs (such as the UDRP or URS) to address abusive registration of IGO acronyms, or of IGO full names not covered by the aforementioned reservation. The resulting final Working Group recommendation has caused concerns for IGOs and the GAC, requiring further policy work on a core recommendation which has since been the subject of GNSO Council rechartering and referral to Phase 1 of the PDP mentioned in paragraph 34.⁷⁶ The GAC has re-affirmed that any IGO-specific RPM should be modeled on but separate from the existing UDRP and should respect IGOs' status under international law; on its part, while the ICANN Board noted the GAC's advice on the need to protect IGO acronyms, it has subsequently signaled an intention to lift the above-mentioned reservation of IGO acronyms in new gTLDs on the basis of a system to notify IGOs of a third-party registration corresponding to their identifier;⁷⁷ the GAC thereupon affirmed its Advice to the ICANN Board "to maintain the current moratorium on the registration of IGO acronyms pending the conclusion of the IGO curative work track currently underway".⁷⁸

43. Together with other IGOs, the Center continues to closely monitor developments in this longstanding ICANN file. Ultimately, the ICANN Board may be called upon to reconcile differences between GAC Advice and GNSO recommendations as to IGO-related RPMs.⁷⁹

⁷⁴ See http://www.wipo.int/edocs/mdocs/govbody/en/wo_ga_28/wo_ga_28_3.pdf; see also documents SCT/9/8, paragraphs 6 to 11; and, SCT/9/9, paragraph 149. The WIPO Secretariat transmitted these recommendations to ICANN. See <https://www.wipo.int/amc/en/docs/wipo.doc>.

⁷⁵ See https://www.wipo.int/about-wipo/en/assemblies/2021/a_62/doc_details.jsp?doc_id=507114, paragraphs 44-51.

⁷⁶ See <https://gnso.icann.org/en/council/resolutions#201905>.

⁷⁷ See <https://www.icann.org/en/system/files/correspondence/botterman-to-ismail-23feb21-en.pdf>.

⁷⁸ See <https://www.icann.org/en/system/files/files/resolutions-abudhabi60-gac-advice-scorecard-04feb18-en.pdf> and <https://gac.icann.org/contentMigrated/icann71-gac-communique>.

⁷⁹ See www.icann.org/resources/pages/igo-ingo-protection-policy-2018-01-16-en, www.icann.org/resources/board-material/resolutions-2018-02-04-en#2.d, and www.icann.org/en/system/files/files/resolutions-abudhabi60-gac-advice-scorecard-04feb18-en.pdf. The Assistant

(b) Geographical Terms

44. Concerning geographical terms, the GAC in particular has expressed concerns about their use and protection in the new gTLDs.⁸⁰ In 2007, the GAC issued the “GAC Principles regarding New gTLDs”, which states *inter alia* that ICANN should avoid delegation of new gTLDs concerning country, territory or place names, and regional language or people descriptions, unless in agreement with the relevant governments or public authorities. Those GAC Principles further state that new registries should adopt procedures for blocking/challenge of names with national or geographical significance at the second level upon demand of governments. Concerning the top level,⁸¹ ICANN’s Applicant Guidebook provides 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.”⁸² Applied-for strings which are considered by ICANN to be certain other geographical names, e.g., capital city names, should be accompanied by documentation of support or non-objection from the relevant governments or public authorities.⁸³ GAC members have expressed further reservations regarding a number of New gTLD applications on grounds of correspondence to geographical or other “sensitive” terms, advising the ICANN Board not to proceed beyond initial evaluation, and seeking Board clarification on scope for applicants to modify their new gTLD applications to address specific GAC concerns.⁸⁴

45. In December 2016, ICANN authorized the release of all previously-reserved 2-character domain names at the second level in new gTLDs provided that registry operators first allow respective governments a thirty-day period to acquire such domain names; require registrants to represent that they would not falsely imply government affiliation in connection with the use of such 2-character domain name; and provide a means for post-registration complaints.⁸⁵ In this context, the Center submitted comments to ICANN noting that the Second WIPO Process considered the possibility of exploring measures for the UDRP to apply to third-level registrations in order to mitigate the potential for trademark abuse.⁸⁶ ICANN did not react to this Center submission. GAC members have asked ICANN to provide coordinated information on related requests and delegations.⁸⁷

Secretary General of the United Nations in charge of the Office of Legal Affairs on behalf of several IGOs (including WIPO) sent a letter in July 2018 to the ICANN Board stating concerns after the final report of the PDP process (see www.icann.org/en/system/files/correspondence/mathias-to-board-27jul18-en.pdf). See further discussion at ICANN’s November 2020 meeting, at <https://icann66.pathable.com/meetings/1116847>.

⁸⁰ See <https://archive.icann.org/en/topics/new-gtlds/gac-principles-regarding-new-gtlds-28mar07-en.pdf>.

⁸¹ Concerning second-level registrations, ICANN’s base registry agreement includes a “Schedule of Reserved Names at the Second Level in gTLD Registries” which makes provision for certain country and territory names. See <http://newgtlds.icann.org/en/applicants/agb/base-agreement-specs-04jun12-en.pdf> at Specification 5.

⁸² See <http://newgtlds.icann.org/en/applicants/agb/evaluation-procedures-04jun12-en.pdf>, from section 2.2.1.4.1 “Treatment of Country or Territory Names”.

⁸³ See <http://newgtlds.icann.org/en/applicants/agb/evaluation-procedures-04jun12-en.pdf>, from section 2.2.1.4.2 “Geographic Names Requiring Government Support”.

⁸⁴ See <https://www.icann.org/en/system/files/correspondence/gac-to-board-27mar14-en.pdf>, at “4. Specific Strings”. While the Board has accepted the GAC’s advice against proceeding with certain applications, it has sought further information from the GAC, as well as public comments, on a range of additional safeguards sought by the GAC concerning several broad categories of new gTLD applications such as for those new gTLDs which correspond to regulated industries or dictionary terms. See <https://www.icann.org/en/system/files/correspondence/gac-to-board-11apr13-en.pdf>. A GAC Sub-group on Geographic Names (a Sub-group of the GAC Working Group on Future New gTLDs) has developed a draft document for future new gTLD rounds outlining several public policy aspects related to geographic names, which is subject to further ICANN discussions. See <https://gacweb.icann.org/download/attachments/27132037/Geo%20names%20in%20new%20gTLDs%20Updated%200%20V3%20%2029%20august%202014%5B4%5D.pdf?version=1&modificationDate=1411549935000&api=v2>. See also <https://www.icann.org/resources/board-material/resolutions-2019-05-15-en#1.c>.

⁸⁵ Together these comprise ICANN’s so-called “confusion mitigation” plans. See e.g., <https://www.icann.org/en/system/files/implementation-memo-two-character-ascii-labels-22jan19-en.pdf>.

⁸⁶ See <https://forum.icann.org/lists/comments-proposed-measures-two-char-08jul16/pdfECmcS9knuk.pdf>.

⁸⁷ See <https://static.ptbl.co/static/attachments/169910/1521228229.pdf?1521228229>.

46. On these and other DNS-related issues, the Center has endeavored to apprise relevant sectors within the Secretariat, including in support of the work of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT).⁸⁸ The Secretariat will continue to monitor these developments and provide input where appropriate.

47. The WIPO General Assembly is invited to take note of the document "WIPO Arbitration and Mediation Center, Including Domain Names" (document WO/GA/54/13).

[End of document]

⁸⁸ See e.g., documents SCT/37/4, SCT37/5, SCT38/3, SCT39/5, SCT40/4, SCT41/5, SCT 42/3, SCT 43/4, and SCT 44/2. See also meeting SCT/IS/GEO/GE/17.