

WIPO



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WORLD INTELLECTUAL PROPERTY ORGANIZATION
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STANDING COMMITTEE ON THE LAW OF TRADE MARKS, INDUSTRIAL DESIGNS AND GEOGRAPHICAL INDICATIONS

Tenth Session
Geneva, April 28 to May 2, 2003

THE PROTECTION OF COUNTRY NAMES IN THE DOMAIN NAME SYSTEM

Document prepared by the Secretariat

Background

1. At the meeting of the WIPO General Assembly in September 2002, a majority of delegations recommended that the Uniform Domain Name Dispute Resolution Policy (UDRP) be amended to provide protection for country names in the Domain Name System (DNS). It was noted, however, that the following issues in particular warranted further discussion: (1) the list to be relied upon to identify the names of countries which would benefit from the protection envisaged; (2) the extension of the deadline for the notification to the Secretariat of names by which countries are commonly or familiarly known; and (3) how to deal with acquired rights. The General Assembly decided that discussions should be continued in the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) with a view to reaching a final position (see paragraph 81 of the WIPO General Assembly Report, document WO/GA/28/7).

2. The SCT continued discussion of these issues at its ninth session. At this session, delegations supported the following (see paragraph 7 of the Summary by the Chair, document SCT/9/8):

(i) protection should be extended to the long and short names of countries, as provided by the United Nations Terminology Bulletin;

(ii) the protection should be operative against the registration or use of a domain name which is identical or misleadingly similar to a country name, where the domain name holder has no right or legitimate interest in the name and the domain name is of a nature that is likely to mislead users into believing that there is an association between the domain name holder and the constitutional authorities of the country in question;

(iii) each country name should be protected in the official language(s) of the country concerned and in the six official languages of the United Nations; and

(iv) the protection should be extended to all future registrations of domain names in generic top-level domains (gTLDs).

3. The Delegations of Australia, Canada and the United States of America dissociated themselves from this decision. The Delegation of Japan stated that, while it did not oppose the decision to extend protection to country names in the DNS, further discussion was required concerning the legal basis for such protection, and stated its reservation to paragraph 7 therein, except for subparagraph (iv).

4. As reported in Circular No. 107 INT. of March 20, 2003, the International Bureau has transmitted the above recommendation on the protection of country names, together with the recommendation made by the WIPO General Assembly with regard to the protection of names and acronyms of international intergovernmental organizations (IGOs), to the Internet Corporation for Assigned Names and Numbers (ICANN). In the transmittal letter, the International Bureau has also informed ICANN of the continued discussion on three outstanding issues in the area of country names. At its meeting on March 12, 2003, the Board of Directors of ICANN requested the President of ICANN to inform the Governmental Advisory Committee, the Supporting Organizations, and the other Advisory Committees of ICANN of the WIPO recommendations and to invite them to provide comments by May 12, 2003.

5. At its meeting from March 23 to 25, 2003, the Governmental Advisory Committee (GAC) of ICANN adopted the following decision on the WIPO recommendations:

“4.1 GAC considered the WIPO communication to ICANN of February 21, 2003, and the ICANN request for Advice, March 12, 2003. GAC took note that the WIPO II recommendation to ICANN was based on a formal decision by Member States, resulting from more than two years' work in the official WIPO instances.

4.2 GAC's Advice to ICANN is as below:

1. GAC endorses the WIPO II recommendations that the names and acronyms of IGOs and country names should be protected against abusive registrations as domain names.

2. GAC advises the ICANN Board to implement the WIPO II recommendations regarding the protection of the names of International Governmental Organisations (IGO) and the protection of Country Names in the Domain Name System.

3. As the practical and technical aspects of extending this protection, and notably the implications for the UDRP, need to be fully understood, GAC proposes that a joint working group should be established in conjunction with other interested ICANN constituencies, in particular the gTLD and ccTLD communities.”

Outstanding Issues

6. At its ninth session in November 2002, the SCT supported continued discussion on the following issues (see paragraph 8 of the Summary by the Chair, document SCT/9/8):

- (i) extension of protection to the names by which countries are familiarly or commonly known;
- (ii) retrospective application of the protection to existing registrations of domain names, and in which alleged rights may have been acquired; and
- (iii) the question of sovereign immunity of States before the courts of other countries in relation to proceedings relating to protection of country names in the DNS.

Extension of Protection to Names by Which Countries Are Commonly or Familiarly Known

7. A number of Member States have, throughout the discussion of this issue, supported extending protection also to names by which countries are commonly or familiarly known. At the second special session of the SCT in May 2002, it was agreed that countries should notify any such names to the Secretariat before September 30, 2002, (see paragraph 210 of document SCT/S 2/8). After the WIPO General Assembly referred the question as to whether this deadline was to be extended to the SCT, the SCT agreed, at its ninth session, that any such additional names be notified to the Secretariat before December 31, 2002, (see paragraph 8 of the Summary by the Chair, document SCT/9/8). A cumulative list of all notifications received by the Secretariat to date is contained in the Annex.

8. The implementation of such protection may, however, give rise to a number of issues.

9. It will have to be determined whether the list of names should be finite, or whether it should be possible to notify additional names, or make amendments to existing notifications, at a later stage. Member States will note in this context that some of the notifications listed in the Annex were received after December 31, 2002. It will have to be decided whether names notified after this deadline should also benefit from protection.

10. Member States may also have to consider whether it should be left entirely to each country to determine, for the purpose of the protection at issue, by which names it is “commonly or familiarly known,” or whether a mechanism should be established

that would allow other countries to object to individual notifications. In the latter case, the details of such mechanisms as well as the effect of any objections will have to be determined.

11. As to the language of names, it is recalled that Member States have decided to restrict protection to the official language(s) of the country concerned as well as the six official languages of the United Nations. Delegations may wish to consider whether this limitation should also apply to names by which a country is commonly or familiarly known, or whether such names should also be protected in additional languages.

12. Some of the names that have been notified would, already under the current recommendation, enjoy protection as “misleadingly similar” variations of their official country name. The protection of such names would, therefore, not require an extension to names by which countries are commonly or familiarly known.

13. *The SCT is invited to decide*

(i) *whether protection should be extended to names by which countries are familiarly or commonly known; and, if so,*

(ii) *whether it should be possible to notify additions or amendments at a later stage, and whether any notifications received after December 31, 2002, should benefit from such protection;*

(iii) *whether it should be left entirely to each country to determine, for the purpose of the protection at issue, by which names it is “commonly or familiarly known,” or whether there should be a mechanism allowing other countries to object to individual notifications .*

Retrospective Application and Acquired Rights

14. The SCT has, so far, recommended protecting country names against abusive domain name registrations occurring after the recommended protection has been implemented. Extending protection retroactively might give rise to the question of how acquired rights should be treated. It should be noted, however, that the protection recommended by the SCT is limited to cases where the domain name holder has no right or legitimate interest in the disputed name. To that extent, acquired rights of domain name registrants would not seem to be affected.

15. *The SCT is invited to decide whether protection of country names should be extended retroactively and, if so, whether there is a need to take specific account of acquired rights even though such protection would only apply where the domain name holder has no right or legitimate interest in the disputed name.*

Relevance of Sovereign Immunity of States

16. Paragraph 4(k) of the UDRP recognizes that losing domain name registrant can bring the dispute before a competent national court of justice. To this end, the complainant is required to submit, in the complaint, to the jurisdiction of the national court either at the principal office of the registrar or at the domain name holder's address as shown in the relevant WHOIS database. A certain number of States, including Australia, Germany, New Zealand, Norway and Turkey, have already filed complaints under the UDRP and, in that context, submitted to the relevant UDRP provisions.

17. It is recalled that the SCT has recommended to respect the privileges and immunities enjoyed by IGOs in the implementation of protection for the names and acronym of IGOs. Instead of submitting to the jurisdiction of national courts of justice, IGOs would therefore submit to a special appeal procedure by way of *denovo* arbitration. Some delegations have expressed a preference for establishing a similar mechanism for country names arguing that this would provide an efficient appeal mechanism for domain name registrants and at the same time respect the immunity of sovereign States. Other delegations were, however, in favor of retaining the procedure as currently provided under the UDRP.

18. *The SCT is invited to decide whether to recommend, in view of the immunities enjoyed by sovereign States, a special appeal mechanism by way of *denovo* arbitration.*

[Annex follows]

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ANNEX

List of commonly known country names
for which protection is sought in the Domain Name System
as notified to the Secretariat

AS OF MARCH 30, 2003

Country	Names	Date on which the notification was received
Czech Republic	Česká republika Česko Czech Republic/The/ Czech/The/ Czechlands/The/ la République tchèque La Tchèque República Checa Chequia Tschechische Republik/Die/ Tschechien Bohemia CZ	January 8, 2003
Estonia	Eesti Vabariik	January 7, 2003
Holy See	Holy See (the) Santa Sede (la) Saint-Siège (le) Stato della Città del Vaticano (lo) Vatican City State (the) État de la Cité du Vatican (l') Estado de la Ciudad del Vaticano (el) Vatican (the) le Vatican VAT VA	June 28, 2002
Hungary	Magyar Köztársaság Magyarország Hungária Republic of Hungary (the) Hungary Ungarische Republik (die) Ungarn République hongroise (la) Hongrie República Hungara (la) Hungria	December 19, 2002
Mexico	Estados Unidos Mexicanos República Mexicana México	July 12, 2002

Netherlands	Nederland Netherlands(the) Pays-bas(les) Paisesbajos(los) Holland Hollande Holanda Niederlande(die)	July15,2002
NewZealand	Aotearoa Aoteoroa NewZealand NewZeeland NewZealand New-Zealand New_Zealand New.Zealand	August28,2002
Portugal	Portugal RepúblicaPortuguesa RepúblicadePortugal	July1,2002
Republicof Korea	Korea SouthKorea S-Korea,S_Korea,SKorea ROK,KOR Hankook,Daehanminko ok Corée Corea 韓 大 國	January7,2003
Russian Federation	RussianFederation(the) Russia	August6,2002

Switzerland	Schweiz Suisse Svizzera Svizra Switzerland Suiza Helvetien Helvétie Elvezia Helvetia Helvecia SchweizerischeEidgenossenschaft SchweizerEidgenossenschaft Confédérationsuisse Confederazionevizzera Confederaziunsvizra SwissConfederation ConfederaciónSuiza HelvetischeEidgenossenschaft Confédérationhelvétique Confederazioneelvetica Confederaziunhelvetica Confoederatiohelvetica ElveticConfederation HelvetianConfederation Confederaciónhelvecia Bund Confédération Confederazione Confederaziun Confederation Confederación CH CHE	November6,2002
Thailand	SIAM	July11,2002
Theformer Yugoslav Republicof Macedonia	Република Македонија RepublikaMakedonija Македонија МК RepublicofMacedonia RépubliquedeMacédoine RepublicadeMacedonia Република Македонија	January6,2003

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