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Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications

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UPDATE ON TRADEMARK-RELATED ASPECTS OF THE DOMAIN NAME SYSTEM

Document prepared by the Secretariat

1.   At the thirty-first session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT), the Chair stated that the SCT had taken note of document SCT/31/6 (Update on Trademark-related Aspects of the Domain Name System) and that the Secretariat was requested to keep Member States informed on future developments in the Domain Name System (DNS) (see document SCT/30/8, paragraph 16). Accordingly, the Secretariat has prepared the present document which offers the requested update.

I.   DOMAIN NAME CASE ADMINISTRATION

A.   UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY

2.   The DNS raises a number of challenges for the protection of Intellectual Property (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[1] and Second[2] 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.

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[1]   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.
[2]   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.

3.   The Center administers dispute resolution procedures principally under the Uniform Domain Name Dispute Resolution Policy (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[3].

4.   Since December 1999, the Center has administered some 30,000 UDRP and UDRP-based cases. The Center makes available online real-time statistics to assist WIPO UDRP case parties and neutrals, trademark attorneys, domain name registrants, domain name policy makers, the media, and academics[4]. Faced with uncertainties in the current expansion of the DNS, and in many instances working on reduced enforcement budgets, trademark owners in 2013 filed 2,585 UDRP-based complaints with the Center, a 10 per cent decrease from the 2012 filing level. At the same time, the Center maintained its market share as the leading UDRP provider internationally. In 2013 the total number of domain names in WIPO UDRP cases passed 50,000.

5.   A diverse mixture of individuals and enterprises, foundations, and institutions used the Center's dispute resolution procedures in 2013. The top five sectors for complainant business activity were Retail, Banking and Finance, Fashion, Biotechnology and Pharmaceuticals, and Internet and Information Technology. The increased filings related to fashion and luxury brands reflect in part a growth in the number of cases filed by brand owners alleging counterfeiting via the web pages offered under the disputed domain name. Reflecting the truly global scope of this dispute mechanism, named parties to WIPO UDRP cases represented 176 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 20 different languages[5].

6.   All WIPO UDRP panel decisions are posted on the Center's website. The Center offers an online overview of broad decision trends on important case issues via the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition (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[6]. To facilitate access to these decisions according to subject matter, the Center also offers a widely used online searchable Legal Index of WIPO UDRP Decisions[7]. These WIPO resources are made available globally free of charge.

7.   Mindful of WIPO's foundational role in the UDRP, the Center monitors developments in the DNS with a view to continually adjusting its resources and practices[8]. The Center regularly organizes Domain Name Dispute Resolution Workshops providing updates on precedents and practices for interested parties[9] as well as meetings of its Domain Name Panelists.

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[3]   See Selected UDRP-related Court Cases at http://www.wipo.int/amc/en/domains/challenged.
[4]   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.
[5]   In alphabetical order, Chinese, Czech, Danish, Dutch, English, French, German, Hebrew, Italian, Japanese, Korean, Norwegian, Polish, Portuguese, Romanian, Russian, Slovak, Spanish, Swedish, Turkish.
[6]   The Overview is available at http://www.wipo.int/amc/en/domains/search/overview.
[7]   The WIPO 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 and is available at http://www.wipo.int/cgi-bin/domains/search/legalindex.
[8]   See, e.g., WO/GA/41/17 Rev.2, paragraphs 14-16.
[9]   All workshops and other events organized by the Center are listed at http://www.wipo.int/amc/en/events.

B.   COUNTRY CODE TOP-LEVEL DOMAINS (ccTLDs)

8.   While the mandatory application of the UDRP is limited to domain names registered in generic Top Level Domains (gTLDs), such as .com and more recently introduced new gTLDs, 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. 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 72 ccTLD registries, most recently including the domain spaces .GD (Grenada), .GQ (Equatorial Guinea), .ML (Mali), and .VG (British Virgin Islands)[10].

II.   **POLICY DEVELOPMENTS IN THE DOMAIN NAME SYSTEM**

9.   A number of policy developments in relation to ICANN present both opportunities and challenges for owners and users of IP rights. One significant challenge is ICANN's introduction of up to 1,400 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], or .[industry]. A second development concerns the introduction of IDNs at the top level. 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

10.   ICANN implementation of its New gTLD Program was formally approved in a Board vote at ICANN's Meeting in Singapore on June 20, 2011[11]. Information has been published in ICANN's much-revised "Applicant Guidebook[12]". Delegation of the first new gTLDs into the Internet's Root Zone took place in October 2013 and as of October 2014 some 400 new gTLDs had been delegated[13].

11.   While 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 which have emerged from a series of ICANN committees and processes for new gTLDs are seen to have been diluted in their intended effectiveness, both in operational and in substantive terms[14]. 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.

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[10]   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.

[11]   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.

[12]   ICANN's Applicant Guidebook is available at http://newgtlds.icann.org/en/applicants/agb.

[13]   Delegated new gTLDs are listed at http://newgtlds.icann.org/en/program-status/delegated-strings.

[14]   For further background including references, see 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".

(i)   Top Level Rights Protection Mechanisms

−   Pre-(TLD) Delegation Dispute Resolution Procedure

12.   This mechanism allows trademark owners to lodge Legal Rights Objections (LRO) to new gTLD applications at the top level where certain substantive criteria are met[15]. The Center assisted ICANN in the establishment of the substantive criteria for the LRO procedure which is rooted in the "WIPO Joint Recommendation Concerning Provisions on the Protection of Marks, and Other Industrial Property Rights in Signs, on the Internet[16]" (Joint Recommendation) adopted by the WIPO General Assembly in September 2001.

13.   The Center was appointed by ICANN as the exclusive provider of LRO dispute resolution services[17]. The window for filing LRO objections closed in March 2013, with the Center receiving 69 LRO filings found to be procedurally compliant[18]. The first LRO determinations were notified to the parties and published by the Center in July 2013, and the Center's LRO processing was essentially completed by early September 2013. All WIPO LRO expert panel determinations are available on the Center's website[19]. The Center has produced a report on the LRO process which is available on the Center's website[20].

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

14.   From early 2008, the Center has raised with ICANN the potential usefulness of 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. In early 2009, the Center communicated to ICANN a concrete substantive proposal for such a trademark-based post-delegation dispute resolution procedure[21]. 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 safe-harbors[22].

15.   Following various ICANN committee processes and 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. Notwithstanding this uncertainty, in light of broader policy interests, on September 18, 2013, the Center agreed with ICANN to become a provider for the

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[15]   Other objection grounds recognized by ICANN are: "String Confusion Objections", "Community Objections", and "Limited Public Interest Objections"). The Applicant Guidebook further includes 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.

[16]   See http://www.wipo.int/about-ip/en/development_iplaw/pub845-toc.htm.

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

[18]   See WIPO Rules for New gTLD Dispute Resolution, and Schedule of Fees and Costs, respectively at http://www.wipo.int/amc/en/docs/wipolrorules.pdf and http://www.wipo.int/amc/en/domains/lro/fees.

[19]   See http://www.wipo.int/amc/en/domains/lro/cases.

[20]   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.

[21]   See http://www.wipo.int/amc/en/docs/icann130309.pdf.

[22]   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).

trademark PDDRP. As of October 2014, there have been no PDDRP cases received by the WIPO Center.

(ii)   Second Level Rights Protection Mechanisms

–   Trademark Clearinghouse

16.   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[23]. 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 relevant, practical measures may be envisaged to identify any allegedly inappropriate invocation of rights in specific contexts.

17.   The Clearinghouse has been open for trademark submission and validation since March 2013[24], and the Center continues to monitor developments regarding this mechanism.

–   Uniform Rapid Suspension (URS) System

18.   While importantly 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. The Center for its part communicated to ICANN in April 2009 a discussion draft of an "Expedited (Domain Name) Suspension Mechanism[25]", and has made subsequent proposals for a streamlined mechanism based on this model at the ICANN Prague and Toronto Meetings in 2012[26]. Such proposals 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.

19.   Although the URS as evolved from a sequence of ICANN processes and committees is viewed by many as having become an overburdened procedure for a limited remedy, the mechanism has now, with the introduction of new gTLDs, taken effect. Questions remain as to how effective the URS will be as an efficient and enforceable complement to the court-alternative UDRP, and a range of issues remain to be addressed, including its relationship

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[23]   The Clearinghouse 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 Clearinghouse 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 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 Clearinghouse 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 below.
[24]   According to http://www.trademark-clearinghouse.com/content/updated-stats-page, as of October 2014, the number of trademarks submitted to the Trademark Clearinghouse numbered around 30,000.
[25]   See http://www.wipo.int/amc/en/docs/icann030409.pdf.
[26]   See http://prague44.icann.org/node/31773 and http://toronto45.icann.org/node/34325.

with the UDRP[27]. ICANN invited tenders in late 2012 from prospective URS providers, to which after careful consideration of the ICANN URS model and related resources the Center was not in a position to apply[28]. The Center continues to closely monitor developments.

B.   ICANN'S PLANNED FUTURE REVISION OF THE WIPO-INITIATED UDRP AND THE UDRP LOCK WORKING GROUP

20.   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 as a registration-driven body[29], a decision was taken by ICANN's Generic Names Supporting Organization (GNSO) to review the UDRP through a process envisaged to commence within some 18 months following the delegation of the first new gTLDs[30]. In any such review process, the Center will be an active participant with the best interests of the UDRP in mind.

21.   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 stakeholders hold a mere minority vote, it appears likely that any wide-ranging review could end up weakening the foundation and functioning of the UDRP. In the meantime, ICANN's GNSO has commenced a "Policy Development Process" (PDP) with a more limited technical mandate of examining the mechanism for locking domain names subject to UDRP proceedings. The Center remains involved in this process, which is currently in its implementation phase, and will more generally continue to closely follow ICANN stakeholders' intentions with regard to the UDRP.

C.   INTERNATIONALIZED DOMAIN NAMES

22.   As noted in paragraph 9, another significant policy development in the DNS is the introduction of IDNs (non-Latin script) at the top level. A total of 116 applications under ICANN's New gTLD Program were for IDNs. Because of the high priority afforded to IDN applications in the ICANN new gTLD application approval process, a number of these have been among the first new gTLDs announced by ICANN for delegation in the DNS root zone[31].

23.   Separately, and prior to new gTLD development, ICANN's Final Implementation Plan for IDN ccTLD Fast Track Process was published on November 16, 2009[32]. Since then, this has allowed for the introduction of several IDN ccTLDs, associated with the two-letter codes in the ISO 3166-1 standard[33]. Approved requests continue to be delegated into the DNS root zone[34].

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[27]   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.

[28]   The question of accreditation of providers gives rise to concerns as to the stability of RPMs; WIPO raised concerns about this as early as 2007 in the context of the UDRP (see http://www.wipo.int/amc/en/docs/icann040707.pdf).

[29]   See https://community.icann.org/display/gnsoudrpdt/Webinar+on+the+Current+State+of+the+UDRP; see also more generally document WO/GA/39/10, paragraph 31.

[30]   See http://gnso.icann.org/meetings/minutes-council-15dec11-en.htm.

[31]   These include for example: شبكة. (Arabic for 'web/network'), . 公司 (Chinese for 'company'), and .онлайн (Russian for 'online').

[32]   See http://www.icann.org/en/topics/idn/fast-track/idn-cctld-implementation-plan-16nov09-en.pdf.

[33]   See http://www.iso.org/iso/english_country_names_and_code_elements.

[34]   See http://www.icann.org/en/topics/idn/fast-track.

D.   OTHER IDENTIFIERS

24.   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.

(i)   International Governmental Organizations (IGOs)

25.   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, including country names and IGO names and acronyms.

26.   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[35]. The WIPO Secretariat transmitted these recommendations (WIPO-2 Recommendations) to ICANN in February 2003[36].

27.   Following further ICANN deliberations[37], ICANN's New gTLD Program Applicant Guidebook limited its 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 12 and 13 above. However, following an open letter from IGO legal counsels to ICANN in December 2011, and sustained IGO efforts, ICANN's Governmental Advisory Committee (GAC) issued advice to the ICANN Board that the names and acronyms of IGOs be granted protection against inappropriate third-party registration in the DNS prior to the delegation of any new gTLDs[38]. The GAC further advised the ICANN Board that, building on existing ".int" criteria for second-level registrations in that space, it would collaborate with IGOs to develop a list of IGO names and acronyms that should be protected. Such protection would be at the second level for the current round of new gTLDs, and at both the second and top level in any future new gTLD rounds. The GAC also advised the Board that, pending work on further implementation, interim protection for IGO names and acronyms should be provided through a moratorium on third-party registration prior to the delegation of any new gTLDs.

28.   The ICANN Board responded to the GAC indicating that it had adopted a resolution laying the groundwork for such interim protection at the second level based on the existing .int criteria, via an ICANN reserve list of identified IGO names and acronyms, to be withheld from third-party registration through the new gTLD Registry Agreement. ICANN specified a deadline for provision of relevant qualifying IGO names and acronyms of February 28, 2013, inviting qualifying IGOs to identify themselves to ICANN by that date, while also seeking provision by the GAC (with IGOs) of a consolidated IGO package comprising the criteria and list of IGO names and acronyms for which the GAC advised protection[39]. In response, an IGO coalition developed .int-based criteria for IGO protection and an accompanying list of IGOs, which the IGO coalition forwarded to the ICANN Board on February 28, 2013. This was followed by a GAC communication to the ICANN Board of the GAC's preferred advice on IGO protection

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[35]   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.
[36]   See http://www.wipo.int/amc/en/docs/wipo.doc.
[37]   For background, see WO/GA/41/17 Rev.2, in particular paragraphs 40 and 41.
[38]   See https://gacweb.icann.org/download/attachments/27132070/FINAL_Toronto_Communique_20121017.pdf?version=1&modificationDate=1354149148000&api=v2.
[39]   See https://gacweb.icann.org/download/attachments/27132070/Board%20Response%20to%20GAC%20Toronto%20Communique.pdf?version=1&modificationDate=1361909146000&api=v2.

eligibility criteria (comprising treaty-based IGOs with international legal personality, or which are UN Observers, or which are funds or programs of the UN), together with a list of protectable IGO names and acronyms[40].

29.   On April 1, 2013, the Board responded to the GAC with a letter raising certain concerns about how the protection of IGO acronyms would be reconciled with certain potentially legitimate third-party attempts to register domain names corresponding to a protected IGO acronym, and sought further particulars about the possible means by which cases of potentially legitimate co-existent use of such acronym could be managed in practice[41]. The GAC's response stressed the important global public mission of IGOs, committed to actively working to find a way forward, and reiterated its advice to the ICANN Board that appropriate preventative initial protection for listed IGO names and acronyms be in place before any new gTLDs would launch[42].

30.   In July 2013, following further discussions with ICANN and sustained efforts from IGOs, the GAC issued advice to the ICANN Board that highlighted the need for special preventative protection for IGO names and acronyms in the DNS[43]. Following this advice, the ICANN Board issued a resolution extending interim protection for IGOs until the first meeting of the ICANN New gTLD Program Committee (NGPC) after the November 2013 ICANN meeting[44].

31.   In October 2013 the NGPC made a proposal for protection of IGO acronyms at the second level that fell well short of providing IGO acronyms with the permanent preventative protection envisaged in previous GAC *Communiqués*[45]. The IGO coalition responded to the NGPC indicating disappointment with the proposal as it was strictly curative in nature and did nothing to prevent harm from occurring in the first place, and also conveyed its concerns to the GAC.

32.   The NGPC, the GAC, and IGOs conducted discussions around ICANN's November 2013 Buenos Aires meeting. The NGPC indicated that although specific technical points of its October 2013 proposal could be worked on, full preventative protection of IGO acronyms was intentionally excluded. The GAC advised the ICANN Board that interim protections for IGO acronyms should remain in place until the dialogue between the GAC, the NGPC and IGOs ensuring implementation of protection was completed, but without reiterating the GAC's previous position about the need for preventative protection[46]. On January 9, 2014, the NGPC passed a resolution extending temporary protections for IGO acronyms until the NGPC made a final determination[47].

33.   In parallel to these efforts, the GNSO had launched a PDP on the issue of IGO protection, in which process the Center along with other IGO representatives participated. Over IGO objections, in November 2013 this GNSO process came out against preventative protection for IGO acronyms on the second level. Instead, it recommended curative protection mechanisms for IGO acronyms, coupled with the removal of the temporary protections for IGO acronyms already in place. These recommendations were adopted unanimously by the GNSO Council on

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[40]   See http://www.icann.org/en/news/correspondence/dryden-to-crocker-chalaby-22mar13-en.

[41]   The Board also sought further specifics on a possible means for periodic review of the list, along with clarification of any additional languages in which protection of IGO names and acronyms is sought. See http://www.icann.org/en/news/correspondence/crocker-to-dryden-01apr13-en.

[42]   See https://www.icann.org/en/system/files/correspondence/gac-to-board-18apr13-en.pdf.

[43]   The GAC further advised that it expressly assumed that the ICANN Board was prepared to fully implement the GAC advice and focus on practical and effective implementation of preventative protection at the second level in new gTLDs, and that the interim protections for IGO names and acronyms should remain in place until the dialogue between the GAC, ICANN and IGOs was completed. See http://durban47.icann.org/meetings/durban2013/presentation-gac-communique-18jul13-en.pdf.

[44]   See http://www.icann.org/en/groups/board/documents/resolutions-new-gtld-17jul13-en.htm.

[45]   The GAC and the NGPC had cancelled their participation in a September 30 meeting proposed by IGOs.

[46]   See http://www.icann.org/en/news/correspondence/gac-to-board-20nov13-en.pdf.

[47]   See http://www.icann.org/en/groups/board/documents/resolutions-new-gtld-09jan14-en.htm#2.d.i.

November 20, 2013. In response to this development, in a letter of January 24, 2014, IGOs expressed concern noting that the mechanisms now foreseen would miss an important opportunity to curtail abuse of IGO acronyms in the DNS before harm could occur[48].

34.   On February 25, 2014, IGOs met with the ICANN representative for the NGPC to discuss the NGPC's October 2013 proposal. Following this meeting, on March 10, 2014, the NGPC provided a draft proposal for curative rights protection mechanisms for IGO acronyms. Further discussions were held between IGOs and the NGPC during ICANN's March 2014 Singapore meeting, where furthermore the GAC advised the ICANN Board that it was awaiting the Board's response regarding the implementation of its advice from previous meetings.

35.   On April 30, 2014, the ICANN Board resolved to adopt the GNSO Council recommendations not in conflict with GAC advice while requesting more time to consider the recommendations that differed from GAC advice. While ICANN has expressed an intention to facilitate a consensus-seeking dialogue between the GAC (including IGOs) and the GNSO to conclude the remaining policy differences as to scope and duration (as between GAC Advice and GNSO recommendations), the outcome of any such dialogue remains outstanding. On June 5, 2014, the GNSO Council voted to initiate a second PDP to explore giving IGOs access to curative rights protection mechanisms such as the UDRP or URS. Together with other involved IGOs, the Center will continue to closely monitor these developments.

(ii)   Geographical Terms

36.   Concerning geographical terms, the GAC in particular has expressed concerns about their use and protection in the new gTLDs[49]. Concerning the top level[50], 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[51]." Applied-for strings which are considered by ICANN to be certain other geographical names, e.g., capital city names, need to be accompanied by documentation of support or non-objection from the relevant governments or public authorities[52].

37.   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[53].

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[48]   By way of example, the IGO letter cited illicit profiteering from UNICEF funding campaigns in the wake of humanitarian emergencies.
[49]   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 stated that new registries should adopt procedures for blocking/challenge of names with national or geographical significance at the second level upon demand of governments. See http://gac.icann.org/web/home/gTLD_principles.pdf.
[50]   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.
[51]   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".
[52]   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".
[53]   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://gacweb.icann.org/download/attachments/27132037/Beijing%20Communique%20april2013_Final.pdf.

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

39.   The SCT is invited to take note of the contents of this document.

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