

The Recognition of Rights
and the Use of Names
in the Internet Domain Name System

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STRUCTURE

1 Background

- Current system governing the interface between domain names and intellectual property rights
- Special features of the environment

2 Principal Findings and Recommendations of the Report

3 Particular Findings concerning Identifiers Examined

Background: Current System

Composed of three elements:

1 International Treaties

- Paris Convention & TRIPs Agreement
- Non-specific

2 National laws

- Generally non-specific
 - cf.* US Anti-Cybersquatting Law, EC Draft Council Regulation for .eu
- Territorial

3 Uniform Domain Name Dispute Resolution Policy (UDRP) for gTLDs (.com, .net, .org, plus new gTLDs)

Uniform Domain Name Dispute Resolution Policy (UDRP)

- Adopted by ICANN following first WIPO Internet Domain Name Process
- Applies in gTLDs
 - .com, .net, .org (original)
 - .aero, .biz, .coop, .info, .museum, .name, .pro (new)
- Contractual system relying on hierarchical nature of DNS to implement treaty-based norms

WIPO Case Filings

	gTLDs	ccTLDs	Total
1999	1		1
2000	1,841	16	1,857
2001 (Jan to August)	1,085	36	1,121
Total	2,926	52	2,978

Uniform Dispute Resolution Policy

Geographical Distribution of Parties (WIPO)

- Parties from 86 countries
- USA: 48.5% (1,451) of complainants
- EU: 39.9% (1,144) of complainants
 - United Kingdom: 9.2% (274)
 - France: 5.4% (160)
 - Spain: 5% (148)
 - Germany: 4.2% (125)
- Switzerland: 2.9% (83)
- Australia: 2.4% (68)
- Japan: 2.1% (61)
- India: 1.9% (54)
- Brazil: 1.6% (46)

Background:

Special Characteristics of the Environment

- Economic and technological conditions of a single space -v-
legal concepts and systems based on component territorial units
 - global presence and access for both gTLDs and ccTLDs
 - uncertainty and cost of identifying applicable law
 - opportunity for law evasion
- Speed of penetration and change
 - hesitation to legislate
- Multifunctionality
 - commerce, culture, politics, social communication, scientific research
- Disjunction between ease of creating a legal relation and difficulty and expense of dealing with its violation

Principal Findings and Recommendations of the Report

- 1 Evidence of widespread registration and use, as domain names in gTLDs, of identifiers examined by unconnected persons
 - see the Annexes of the Report

- 2 Present international legal framework is insufficient or incomplete
 - elements of legal principles exist for most of the identifiers

- 3 It is for the international community to decide:
 - A whether it wishes to complete the present framework
 - B if so, how (Chapter 2 of the Report)
 - self-regulation
 - ICANN contractual system
 - treaty

International Nonproprietary Names for Pharmaceutical Substances (INNs)

- Consensus-based system for attributing names to new pharmaceutical substance managed by World Health Organization
 - names intended to have generic status, be available for use by all and free from private rights
 - some 8,000 INNs, increasing by c.150 each year
 - system supported by WHO Assembly resolution

Recommendation

- ICANN consider joining consensus on prohibition of proprietary rights of control over INNs
- cancellation policy where exact INN registered as domain name in a gTLD
- not implemented through UDRP

Some Examples of Registrations of INNs

(Annex VI)

ampicillin.com

sildenafil.com (*viagra*)

tagamet.com

tetracycline.com

Names and Acronyms of IGOs

- Protected, following notification, under Article 6ter of the Paris Convention and TRIPs Agreement against misleading registration or use as trademark
 - 91 notifications
- Limitations of current framework applied to the DNS
 - rights limited to misleading commercial use (*cf.* multifunctionality of domain names)
 - absence of enforcement agencies in DNS (*cf.* IP Offices for trademarks)
 - resources of IGOs to protect names (*cf.* commercial assets)

Recommendation

- States, as constituents of IGOs, should examine desirability of special administrative procedure, modelled on UDRP, to protect names and acronyms of IGOs against misleading registration as domain names
- respect of immunity from jurisdiction of IGOs

Some Examples of Registrations of IGO Names

internationallabour.com, .net and .org

wipo.com

wiposucks.com

wipo.co.uk (world Intellectual Piracy Organization)

Personal Names

- Wide variety of legal theories and practices at the national level
- Protected, where used as common law trademarks, under the UDRP (see Annex V of the Report)
- Limitations of current framework applied to the DNS
 - UDRP extends only to commercial misuse and only where common law trademarks are recognized under the applicable law
 - no protection for historical, political, religious, scientific figures

Recommendation

- international community needs to decide if it wishes to establish any protection beyond the scope of the present UDRP

Some Examples of WIPO UDRP Cases
Involving Personal Names
(Annex V)

juliaroberts.com

madonna.com

isabelle-adjani.com

bridgetjones.com

venusandserenawilliams.com

dustinhoffman.com

celinedion.com

nicholekidman.com

nicolekidmannude.com

tom-cruise.com

Geographical Identifiers

Indications of Source & Geographical Indications

- Existing international norms
 - prohibit misleading use of indications of geographical source
 - Paris Convention, TRIPs Agreement, Madrid (Indications of Source) Agreement
 - prohibit misuse of geographical indications
 - Paris Convention, TRIPs Agreement, Lisbon Agreement
- Limitations of current framework applied to the DNS
 - limited to trade in goods
 - different national approaches to implementation of international norms create highly complicated questions of applicable law

Recommendation

- international community needs to decide whether and how to create rules for harmonizing national appreciation of geographical indications (eg, an agreed list)

Some Examples of Geographical Indications Registered as
Domain Names
(Annexes VII to XII)

bourgogne.com

chianti.com

cognac.net

bohemia-glass.com

jaffa.com

pommard.org

tequila.com

valpolicella.com

Geographical Identifiers

Names of Countries, Peoples and Places

- Country insignia protected, following notification, under Paris Convention and TRIPs agreement
 - No further existing international norms
- Limitations of existing framework perceived to work to disadvantage of less digitally advanced countries (LDACs)

Recommendation

- international community needs to decide whether and, if so, how it wishes to deal with this situation
- multifunctionality works in more than one way

Some Examples of Country People and Place Names
Registered as Domain Names
(Annexes XII to XIV)

cameroon.com

france.com

india.com

italy.com

cairo.com

prague.com

ashanti.com

maasai.com

somali.org

Trade Names

- Protected under Article 8 of the Paris Convention and TRIPs Agreement
 - diversity of national approaches to implementation of international norm
 - protection under UDRP insofar as a trade name may qualify as a common law trademark
- Limitations of current framework applied to the DNS
 - lack of protection most evident for SMEs
 - UDRP applies unevenly
 - problem of applicable law in recognition of protectable trade names

Recommendation

- little evidence of widespread abuse
- again decision needed as to whether existing framework should be supplemented to deal with misuse of this form of identifier within the DNS

A General Principle??

Authenticity of identity on the Internet?

URLs

- <http://www.wipo.int>
(general)
- <http://wipo2.wipo.int>
(WIPO Internet Domain Name Processes)
- <http://arbiter.wipo.int>
(WIPO Arbitration and Mediation Center/domain name disputes)