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MATTERS CONCERNING INTERNET DOMAIN NAMES

Document prepared by the Secretariat

Domain Names and Trademarks

1. Over the past five years, WIPO has played a leading role in making recommendations and developing solutions for the problems arising out of the interface between Internet domain names and intellectual property rights, most notably in the framework of the First and Second WIPO Internet Domain Name Processes.
2. The First WIPO Internet Domain Name Process¹ addressed the tension between domain names and trademarks. Its most important result was the adoption, on December 1, 1999, of the Uniform Domain Name Dispute Resolution Policy (UDRP) by the Internet Corporation for Assigned Names and Numbers (ICANN). The UDRP provides holders of trademark rights with an administrative mechanism for the efficient resolution of disputes arising out of the bad-faith registration and use by third parties of Internet domain names, in the generic top-level domains (gTLDs), such as .com, .net and .org, corresponding to those trademark rights.

¹ *The Management of Internet Names and Addresses - Final Report of the WIPO Internet Domain Name Process*, WIPO publication No. 439, also available at <http://wipo2.wipo.int/process1/report/index.html>.

3. The WIPO Arbitration and Mediation Center was the first domain name dispute resolution service provider to be accredited by ICANN. Since receiving the first UDRP case in December 1999, the Center has processed over 5,000 UDRP cases thus establishing itself as the leading provider. The geographical distribution of parties involved in UDRP cases filed with the Center to date spans 110 countries.

4. The Center's contributions to the system have been vital in ensuring that procedures under the UDRP can be conducted in a fair, transparent and efficient manner. The Center has, for example, made available a searchable legal index that provides categorized access to all UDRP decisions rendered by WIPO panels.² As an illustration of the significant public attention to this WIPO service, the Center's website, which includes the index and where all decisions rendered by WIPO-appointed panels are published, regularly receives one million hits per month.

5. In addition to the UDRP cases mentioned earlier, the Center has administered more than 15,000 cases filed under different policies developed by the operators of several new gTLDs. These policies were aimed at preventing the abuse of trademark rights during the introductory phase of a gTLD. The Center has published reports on its experience with the Afilias Sunrise Registration Challenge Policy for .info and the Start-Up Trademark Opposition Policy for .biz, in order to assist in the establishment of safeguards that should accompany any further introduction of new gTLDs. It is recalled that one of ICANN's selection criteria for new gTLDs was their potential for providing "proof of concept" concerning possible additions to the domain name space and the options for implementing such additions, including appropriate intellectual property protection. These WIPO reports therefore include a comparative evaluation of various options for providing trademark protection during the introductory phase of a new gTLD.³

Domain Names and Other Identifiers

6. The Second WIPO Internet Domain Name Process concerned the relationship between domain names and five types of identifiers, namely, International Nonproprietary Names for pharmaceutical substances (INNs), the names and acronyms of international intergovernmental organizations (IGOs), personal names, geographical identifiers and trade names.

7. Following consideration of the final Report of the Second WIPO Internet Domain Name Process⁴ by two Special Sessions of the WIPO Standing Committee on the Law of

² The index is available at the Center's website at <http://arbiter.wipo.int/domains/search/index.html>.

³ *WIPO End Report on Case Administration under the Afilias Sunrise Registration Challenge Policy for .info* available at <http://arbiter.wipo.int/domains/reports/info-sunrise/index.html>; and *WIPO End Report on Case Administration under the Start-Up Trademark Opposition Policy for .biz* available at <http://arbiter.wipo.int/domains/reports/biz-stop/index.html>.

⁴ *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://wipo2.wipo.int/process2/report/index.html>.

Trademarks, Industrial Designs and Geographical Indications (SCT) held in 2001 and 2002,⁵ the WIPO General Assembly at its meeting from September 23 to October 1, 2002 took a number of decisions, which were based on recommendations made by the SCT at its second Special Session in May 2002. The next section of the present document provides an overview of these decisions and recommendations. The two following sections of this document summarize the discussions at the ninth and tenth sessions of the SCT, and the last section reports on recent developments at ICANN.

WIPO General Assembly, September 23 to October 1, 2002

INTERNATIONAL NON-PROPRIETARY NAMES (INNS) FOR PHARMACEUTICAL SUBSTANCES

8. At its second Special Session, the SCT had decided not to recommend a specific form of protection of INNs. Instead it had requested the Secretariat to continue monitoring the situation in cooperation with the World Health Organization and, if necessary, to bring to the attention of the Member States any material change in the situation.⁶ The WIPO General Assembly adopted this recommendation in October 2002.⁷

Trade Names

9. The WIPO General Assembly adopted⁸ the recommendation of the SCT⁹ that Member States should keep the protection of trade names in the Domain Name System (DNS) under review and raise it for further discussion if the situation so demanded.

PERSONAL NAMES

10. The General Assembly also adopted¹⁰ the recommendation made by the SCT¹¹ not to take any action regarding the protection of personal names in the DNS.

Geographical Indications

11. At its second Special Session, the SCT had not taken any definitive decisions with respect to the protection of geographical indications in the DNS. Instead it was recommended that the WIPO General Assembly refer this issue to the regular session of the SCT for further consideration.¹² The General Assembly adopted this recommendation in October 2002 and requested the SCT to continue the discussion on this topic.¹³

⁵ All working documents of the Special Sessions of the SCT are available at <http://ecommerce.wipo.int/domains/sct/documents/index.html>.

⁶ Document SCT/S2/8, paragraph 26.

⁷ Document WIPO/GA/28/7, paragraph 75.

⁸ Document WIPO/GA/28/7, paragraph 76.

⁹ Document SCT/S2/8, paragraph 55.

¹⁰ Document WIPO/GA/28/7, paragraph 77.

¹¹ Document SCT/S2/8, paragraph 59.

¹² Document SCT/S2/8, paragraph 229.

¹³ Document WIPO/GA/28/7, paragraph 78.

Names and Acronyms of International Intergovernmental Organizations (IGOs)

12. The relevant recommendation made by the SCT at its second Special Session reads as follows.¹⁴

“88. Noting, in particular, Article 6 *ter* of the Paris Convention, to which 163 States are party,

“1. The Special Session recommends that the UDRP be modified to provide for complaints to be filed by an international intergovernmental organization (IGO)

A. on the ground that the registration or use, as a domain name, of the name or abbreviation of the IGO that has been communicated under Article 6 *ter* of the Paris Convention is of a nature

(i) to suggest to the public that a connection exists between the domain name holder and the IGO; or

(ii) to mislead the public as to the existence of a connection between the domain name holder and the IGO; or

B. on the ground that the registration or use, as a domain name, of a name or abbreviation protected under an international treaty violates the terms of that treaty.

“2. The Special Session further recommends that the UDRP should also be modified, for the purposes of complaints mentioned in paragraph 1, to take account of and respect the privileges and immunities of IGOs in international law. In this respect, IGOs should not be required, in using the UDRP, to submit to the jurisdiction of national courts. However, it should be provided that decisions given in a complaint filed under the modified UDRP by an IGO should be subject, at the request of either party to the dispute, to *denovo* review through binding arbitration.

“3. The Delegation of the United States of America dissociated itself from this recommendation.”

13. The General Assembly in October 2002, adopted this recommendation and instructed the Secretariat to transmit it to ICANN. The Delegation of the United States of America dissociated itself from this decision.¹⁵

¹⁴ Document SCT/S2/8, paragraph 88.

¹⁵ Document WIPO/GA/28/7, paragraph 79.

CountryNames

14. At the second Special Session of the SCT in May 2002: ¹⁶

“210. The Chair concluded that:

“1. Most delegations favored some form of protection for country names against registration or use by persons unconnected with the constitutional authorities of the country in question.

“2. As regards the details of the protection, delegations supported the following:

(i) A new list of the names of countries should be drawn up using the UN Bulletin and, as necessary, the ISO Standard (it being noted that the latter list includes the names of territories and entities that are not considered to be States in international law and practice). Both the long or formal names and the short names of countries should be included, as well as any additional names by which countries are commonly known and which they notify to the Secretariat before June 30, 2002.

(ii) Protections should cover both the exact names and misleading variations thereof.

(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.

(iv) The protections should be extended to all top-level domains, both gTLDs and ccTLDs.

(v) The protections 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.

“3. The Delegations of Australia, Canada and the United States of America dissociated themselves from this recommendation.”

15. In the General Assembly in October 2002, all delegations supported the above recommendations of the SCT, except those of Australia, Canada and the United States of America. The General Assembly noted that a number of issues warranted further discussion, namely (i) the list to be relied upon to identify the names of countries which would benefit from the protection envisaged, (ii) the extension of the deadline for the notification to the Secretariat of names by which countries are commonly known, and (iii) how to deal with

¹⁶ Document SCT/S2/8, paragraph 210.

acquired rights. The General Assembly decided that discussions should be continued in the SCT with a view to reaching a final position.¹⁷

Ninth Session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT), November 2002

Country Names

16. At its ninth session from November 11 to 15, 2002, the SCT discussed the issues identified as outstanding by the General Assembly in October 2002 and took the following decision:¹⁸

“6. Recalling the decision reached by the General Assembly at its meeting in September 2002, the majority of delegations favored amending the Uniform Domain Name Dispute Resolution Policy (UDRP) to provide protection for country names in the DNS.

“7. As regards the details of such protection, the delegations supported the following:

(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).

“8. The delegations supported continued discussion on:

(i) extension of protection to the names by which countries are familiarly or commonly known, and agreed that any additional such names be notified to the Secretariat before December 31, 2002;

(ii) retrospective application of the protection to existing registrations of domain names, and in which alleged rights may have been acquired; and

¹⁷ Document WIPO/GA/28/7, paragraph 80.

¹⁸ Document SCT/9/8, paragraphs 6 to 11. Same decision recorded in document SCT/9/9, paragraph 149.

(iii) the question of sovereign immunity of States before the court of other countries in relation to proceedings relating to protection of country names in the DNS.

“9. The delegations requested the Secretariat to transmit the said recommendation to the Internet Corporation for Assigned Names and Numbers (ICANN).

“10. The Delegations of Australia, Canada and the United States of America dissociated themselves from this decision.

“11. 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).”

GEOGRAPHICAL INDICATIONS

17. At its ninth session, the SCT also addressed the protection of geographical indications in the DNS. The SCT decided to continue discussions on this issue and requested the Secretariat to prepare a paper summarizing the state of the positions, drawing together work already done by the Secretariat and including the comments made by several delegations at the SCT.¹⁹

Tenth Session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT), May 2003

COUNTRY NAMES

18. At its tenth session from April 28 to May 2, 2003, the SCT continued discussion on the following three issues:

(i) Whether protection of country names in the DNS should be extended to names by which countries are familiarly or commonly known;

(ii) Whether protection should be granted retroactively to existing registrations of domain names, and in which alleged rights may have been acquired; and

(iii) How to address the question of sovereign immunity of States before the court of other countries in relation to proceedings relating to protection of country names in the DNS.

19. At its tenth session, the SCT decided to continue discussion on issues (i) and (iii) above. In respect of the question of sovereign immunity, the SCT requested the Secretariat to prepare

¹⁹ See documents SCT/9/8, paragraph 5, and SCT/9/9, paragraphs 116 and 117. The paper was made available to the tenth session of the SCT as document SCT/10/6.

ashortdescriptionofhowa *denovo* arbitrationmechanismmightwork.Withrespecttoissue (ii)above,itwasagreedthatnofurtheraction shouldbetaken.²⁰

GEOGRAPHICAL INDICATIONS

20. TheSCTalsocontinueditsdiscussiononthe protectionofgeographicalindicationsin theDNS.

DevelopmentsattheInternetCorporationforAssignedNamesandNumbers(ICANN)

21. AsreportedinCircularNo.107INT.ofMarch20,2003,theSecretariat transmittedtherecommendationsmadebytheGeneralAssemblyin October2002 concerningtheprotectionofnamesandacronymsofIGOsandcountrynamesto ICANN.OnMarch 12,2003,theICANNBoardofDirectorsrequestedthePresident ofICANNtoinformtheGovernmentalAdvisoryCommittee(GAC),theSupporting Organizations,andtheotherAdvisoryCommitteesofICANNoftheWIPO recommendationsandtoinvitehemtoprovidecommentsbyMay 12,2003.

22. AtitsmeetingfromMarch23to25,2003,theGAC,inwhichtheSecretariat is represented,adoptedthefollowingdecisionontheWIPOrecommendations.²¹

“4.1 GACconsideredtheWIPOcommunicationtoICANNofFebruary 21,2003,and theICANNrequestforAdvice,March12,2003.GACTooknotethattheWIPOII recommendationtoICANNwasbasedonaformaldecisionbyMemberStates, resultingfrommorethantwoyears’workintheofficialWIPOinstances.

“4.2 GAC’sadvicetoICANNisas followsbelow:

- 1.GACendorses theWIPOIIrecommendationsthatthenamesandacronymsof IGOsandcountrynames shouldbeprotectedagainstabusive registrations as domainnames.
- 2.GACadvisestheICANNBoardtoimplementtheWIPOIIrecommendations regardingtheprotectionofthenamesofInter -GovernmentalOrganizations (IGO)andtheprotectionofCountryNamesintheDomainNameSystem.
- 3.As thepracticalandtechnicalaspectsofextendingthisprotection,andnotablythe implicationsfortheUDRP,needtobefully understood,GACproposes thata jointworkinggroupshouldbeestablishedinconjunctionwithotherinterested ICANNconstituencies,inparticularthegTLDandccTLDcommunities.”

23. Inaddition,theAt -LargeAdvisoryCommittee(ALAC),²²theCounciloftheGeneric NamesSupportingOrganization(GNSO)²³aswellasthelatter’sIntellectualProperty

²⁰ DocumentSCT/10/9,paragraph 5.

²¹ Postedat <http://www.icann.org/committees/gac/communique-25mar03.htm#4>.

²² <http://www.icann.org/correspondence/bertola-to-touton-12may03.htm>.

²³ <http://www.icann.org/correspondence/tonkin-to-touton-07may03.htm>.

Constituency²⁴ and its Commercial and Business Users Constituency²⁵ provided comments on the recommendations.

24. At its meeting on June 2, 2003, the ICANN Board of Directors took the following decision:²⁶

“Resolved [03.83] that the President is directed to form, in consultation with the chairs of the GNSO Council, the ALAC, and the GAC, a working group including participants in the GNSO, the ALAC, and the GAC as well as Board members, for the purpose of analyzing the practical and technical aspects of implementing the WIPO recommendations, and notably the implications for the UDRP; and

“Further resolved [03.84] that the President and General Counsel are directed to investigate and analyze legal aspects of the relationship between ICANN’s mission and the recommendations conveyed by the 12 February letter from WIPO, and to report to the Board and to the working group formed under resolution 03.83 on the result of that investigation and analysis. Amongst topics to be considered should be whether implementation of the WIPO recommendations would require ICANN to prescribe adherence to normative rules, not based on established laws, for the resolution of competing third-party claims to rights to registered names.”

25. At its meeting in Montreal on June 22 to 24, 2003, the GAC stated in its Communiqué:²⁷

“6. Regarding the implementation of WIPO I, GAC recalls its Advice from the Rio de Janeiro meeting on the ‘WIPO recommendations on names of countries and inter-governmental organisations (IGO).’ GAC welcomed ICANN’s decision of June 2, 2003 (Resolution 03.83), to set up the joint working group at Montreal. GAC requests that the working group should present an outline and timetable for its work to the ICANN and GAC meetings at Carthage. The GAC encourages the group to complete its work by the Cape Town meeting, December 2004.”

26. The Secretariat will continue to monitor the deliberations at ICANN and will participate in the discussions as far as possible.

27. The Assemblies of the Member States of WIPO are invited to take note of the contents of this document and, in particular, of the status of the recommendations of the Member States before ICANN.

[End of document]

²⁴ <http://www.icann.org/correspondence/heltzer-to-touton-15may03.htm>.

²⁵ <http://www.icann.org/correspondence/cbuc-to-twomey-cerf-21may03.htm>.

²⁶ <http://www.icann.org/minutes/prelim-report-02jun03.htm>.

²⁷ Available at <http://www.icann.org/committees/gac/communique-24jun03.htm>.