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MATTERS CONCERNING INTERNET DOMAIN NAMES

Document prepared by the Secretariat

1. Since 1998, WIPO has addressed challenges for the protection of intellectual property in the Internet Domain Name System (DNS), which, due to the global nature of the Internet, call for an international approach. In the First¹ and Second² WIPO Internet Domain Name Processes, WIPO has developed specific solutions to a number of such challenges. In particular, the WIPO Arbitration and Mediation Center (Center) provides trademark owners with an efficient international mechanism against the bad-faith registration and use of domain names corresponding to their trademark rights.
2. This document provides an update on the domain name-related activity of WIPO, including the status of the recommendations made by the Member States of WIPO in the context of the Second WIPO Internet Domain Name Process.

Domain Names and Trademarks

Uniform Domain Name Dispute Resolution Policy

3. The Center administers dispute resolution procedures under the Uniform Domain Name Dispute Resolution Policy (UDRP). The UDRP was adopted by the Internet Corporation for Assigned Names and Numbers (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. It does not prevent either party from submitting a dispute to a competent court of justice. However, very few cases decided under the UDRP have also been brought before a national court of justice.³
4. Having established an extensive case-processing infrastructure, the Center, since December 1999, has administered more than 7,500 cases covering some 14,000 domain names. Following an initial peak in 2000, the filing rate has stabilized at around 3 cases per calendar day until 2004, when the WIPO Center witnessed a 5% increase over the previous year. This trend has continued into 2005 with a current average filing rate of some 4 new cases per calendar day.
5. WIPO UDRP proceedings have involved parties from 122 countries and been conducted in 11 different languages, namely, English, Chinese, French, German, Italian, Japanese, Korean, Norwegian, Portuguese, Russian and Spanish, in function of the language of the applicable registration agreement of the domain name at issue. The List of WIPO Domain Name Panelists who decide UDRP cases includes trademark experts from 56 countries in all continents.⁴

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>.

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://wipo2.wipo.int/process2/report>.

³ See the Selection of UDRP-related Court Cases at <http://arbiter.wipo.int/domains/challenged>.

⁴ See the List of WIPO Domain Name Panelists at <http://arbiter.wipo.int/domains/panel/panelists>.

6. WIPO has made numerous contributions to help ensure fair and transparent UDRP procedures. These include a searchable Legal Index providing parties and panelists with categorized online access to all UDRP decisions rendered by WIPO panels.⁵ Recently, the Center has also published an Overview of WIPO Panel Views on Selected UDRP Questions,⁶ a concise description of UDRP decision trends on important substantive and procedural questions. This online tool should further enhance the consistency and reasoning of decisions taken under the UDRP and help parties to assess their chances in UDRP proceedings. In addition, the Center regularly organizes Domain Name Dispute Resolution Workshops for interested parties⁷ and meetings of its Domain Name Panelists.

Country Code Top-Level Domains

7. While the mandatory application of the UDRP is limited to domain names registered in the generic Top-Level Domains (gTLDs), such as .biz, .com, .info, .net and .org, the Center also assists many country code Top-Level Domain (ccTLD) registries in their establishment of registration conditions and dispute resolution procedures that conform with international standards of intellectual property protection. These procedures are mostly modeled after the UDRP, but may take account of the particular circumstances and needs of individual ccTLDs. As at June 2005, the Center provides domain name dispute resolution services to 43 ccTLD registries and is in consultation with a number of additional ccTLDs.⁸

New Generic Top-Level Domains

8. The Center has also worked towards enhancing the protection of trademark rights during the introduction of new gTLDs. Especially where such newly opening gTLDs attribute domain names through a randomized assignment procedure ("Land Rush"), this may cause serious challenges for trademark owners who are concerned about protecting their identifiers against abusive registration by others. To address such issues, the Center has, in a recent report,⁹ recommended a uniform preventive IP protection mechanism that would be applicable during the introduction of any new gTLD. Such preventive mechanism would be in addition to the curative relief option provided by the UDRP.

9. The report is in response to ICANN's request for WIPO's expert advice on these issues. After a first introduction of seven new gTLDs which started in 2000 (.aero, .biz, .coop, .info, .museum, .name, .pro), ICANN is currently developing a comprehensive strategy for further expansions of the DNS. WIPO's new report, which draws on the Center's experience under the UDRP and in the administration of various IP protection mechanisms developed by some of these new gTLDs, will help inform that strategy from an IP and dispute resolution perspective.

⁵ The Index is available at the Center's web site at <http://arbiter.wipo.int/domains/search/legalindex>.

⁶ The Overview is available at the Center's web site at <http://arbiter.wipo.int/domains/search/overview>.

⁷ See the list of events organized by the Center at <http://arbiter.wipo.int/events>.

⁸ The full list of ccTLDs which have retained the Center as domain name dispute resolution provider is available at <http://arbiter.wipo.int/domains/cctld>.

⁹ *New Generic Top-Level Domains: Intellectual Property Considerations*, available at <http://arbiter.wipo.int/domains/reports/newgtld-ip>; WIPO Press Release at http://www.wipo.int/edocs/prdocs/en/2005/wipo_pr_2005_409.html.

Domain Names and Other Identifiers

10. The Second WIPO Internet Domain Name Process concerned the relationship between domain names and five types of identifiers other than trademarks, which had not been addressed in the First WIPO Internet Domain Name Process, namely, International Nonproprietary Names for pharmaceutical substances (INNs), the names and acronyms of international intergovernmental organizations (IGOs), personal names, geographical identifiers and trade names.

Recommendations by WIPO Member States

11. The Report of the Second WIPO Internet Domain Name Process¹⁰ was discussed by two special sessions of the WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) held in 2001 and 2002 resulting in recommendations to the WIPO General Assembly.¹¹ At its meeting from September 23 to October 1, 2002, the WIPO General Assembly recommended amending the UDRP to provide protection for country names and for the names and acronyms of IGOs. The recommendations were supplemented by the SCT at its ninth session in November 2002.¹² The WIPO Secretariat transmitted these recommendations (the “WIPO-2 Recommendations”) to ICANN in February 2003. They are reproduced in the Annex to this document.

Developments at ICANN

12. Following consideration by the consultative bodies and supporting organizations of ICANN, including the Governmental Advisory Committee which unanimously supported the WIPO-2 Recommendations, the ICANN Board of Directors decided, in June 2003, to form a working group composed of representatives of the various ICANN supporting organizations and consultative bodies “for the purpose of analyzing the practical and technical aspects of implementing the WIPO recommendations, and notably the implications for the UDRP.” This working group was established on October 6, 2003¹³ and, in July 2004, delivered a final report¹⁴ to the Board of ICANN without, however, being able to make consensus recommendations.

13. At its meeting in Kuala Lumpur, Malaysia on July 23, 2004, the ICANN Board requested the President of ICANN to analyze the report and to provide its analysis to the Board so that the latter could take a decision at its meeting in Cape Town, South Africa, in December 2004.¹⁵ In this context, ICANN requested the WIPO Secretariat to provide an informal Briefing Note on the WIPO-2 Recommendations. The WIPO Briefing Note summarizes the main arguments motivating the WIPO-2 Recommendations and, in an annex,

¹⁰ See footnote 2 above.

¹¹ All working documents of the special sessions of the SCT are available at <http://arbiter.wipo.int/processes/process2>.

¹² Document SCT/9/8, paragraphs 6 to 11. Same decision recorded in document SCT/9/9, paragraph 149.

¹³ <http://www.icann.org/announcements/announcement-06oct03.htm>.

¹⁴ This report is posted at <http://www.icann.org/committees/JWGW2/final-report>.

¹⁵ <http://www.icann.org/minutes/kl-resolutions-23jul04.htm>.

provides a draft showing the amendments to the UDRP and the UDRP Rules that would be required in order to implement the WIPO-2 Recommendations. The Briefing Note has been posted on ICANN's web site.¹⁶

14. At the ICANN meeting in Cape Town from December 1 to 5, 2004, the President of ICANN informed the ICANN Board that he considered "further consultations with the community" to be appropriate. The ICANN Board, in turn, asked ICANN staff to analyze any comments to be received during a public comment period, and requested to be informed of the results, including if appropriate a recommendation, at its meeting in Mar del Plata, Argentina, in April 2005.¹⁷ No comments of substance have been received during the public comment period.¹⁸ On March 23, 2005, the UN Legal Advisers sent a letter to ICANN confirming their support for the WIPO-2 Recommendations regarding the protection of the names and acronyms of IGOs.¹⁹ The matter has not been addressed at ICANN's Mar del Plata meeting and the Secretariat will continue to monitor any further action on the part of ICANN.

15. The WIPO General Assembly is invited to take note of the contents of this document.

[Annex follows]

¹⁶ <http://www.icann.org/committees/JWGW2>.

¹⁷ <http://www.icann.org/minutes/capetown-resolutions-1-05dec04.htm>.

¹⁸ <http://forum.icann.org/lists/wipo2-comments>.

¹⁹ <http://arbiter.wipo.int/processes/process2/letter.pdf>.