

# WIPO



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**WORLD INTELLECTUAL PROPERTY ORGANIZATION**  
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## **WIPO GENERAL ASSEMBLY**

**Thirty-Fourth (18<sup>th</sup> Ordinary) Session**  
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**MATTERS CONCERNING INTERNET DOMAIN NAMES**

*Document prepared by the Secretariat*

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1. The Internet Domain Name System (DNS) raises a number of challenges for the protection of intellectual property, 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<sup>1</sup> and Second<sup>2</sup> WIPO Internet Domain Name Processes. In particular, the WIPO Arbitration and Mediation Center (Center) provides trademark owners with an efficient international mechanism to deal with 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 activities 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. WIPO's domain name dispute resolution activities are taking place within the context of a number of developments in the DNS that may call for further WIPO action for the protection of identifiers, in particular trademarks, on the Internet. These developments are also addressed in this document.

### 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, the UDRP has proven highly popular among trademark owners, and very few cases that were decided under the UDRP were also brought before a national court of justice.<sup>3</sup>

4. Since December 1999, the Center has administered more than 11,000 cases covering over 29,500 separate domain names. In 2006, the Center witnessed a 25% increase over the previous year, administering a total of 1,823 cases covering domain names registered in generic Top-Level Domains (gTLDs) and country code Top-Level Domains (ccTLDs). This represents the highest number of UDRP cases handled by WIPO since the year 2000, being the first full year after the UDRP took effect. WIPO's caseload has continued to increase in 2007.

5. WIPO UDRP proceedings have so far involved parties from 143 countries and been conducted in 13 different languages, namely (in alphabetical order), Chinese, Danish, Dutch, English, French, German, Italian, Japanese, Korean, Norwegian, Portuguese, Russian and

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<sup>1</sup> *The Management of Internet Names and Addresses: Intellectual Property Issues – Final Report of the WIPO Internet Domain Name Process*, WIPO publication No. 439, also available at <http://www.wipo.int/amc/en/processes/process1/report>.

<sup>2</sup> *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>.

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

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 some 400 trademark experts from 55 countries in all continents.<sup>4</sup>

6. WIPO continues to make 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,<sup>5</sup> and an Overview of WIPO Panel Views on Selected UDRP Questions.<sup>6</sup> These popular online tools enhance the consistency and reasoning of decisions taken under the UDRP and help parties assess their chances in UDRP proceedings. Earlier this year, WIPO introduced an extended search facility in relation to WIPO domain name dispute resolution,<sup>7</sup> covering 32 searchable categories, such as “areas of complainant activity”, “named respondents”, “domain name script” and “25 most cited decisions in complaint.”

7. In addition, the Center regularly organizes Domain Name Dispute Resolution Workshops for interested parties<sup>8</sup> and meetings of its Domain Name Panelists.

#### *Country Code Top-Level Domains*

8. While the mandatory application of the UDRP is limited to domain names registered in gTLDs, such as .biz, .com, .info, .net and .org, the Center also assists many 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 2007, the Center provides domain name dispute resolution services to 48 ccTLD registries and is in consultation with a number of additional ccTLDs.<sup>9</sup> The Center expects the proportion of such ccTLD cases to grow.

#### *New Generic Top-Level Domains*

9. The Center also works towards enhancing the protection of trademark rights during the introduction of new gTLDs. Especially where such gTLDs attribute domain names through a randomized assignment procedure, the creation of new domains presents 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 2005 report submitted to ICANN,<sup>10</sup> recommended a uniform preventive IP protection mechanism that would be

<sup>4</sup> See the List of WIPO Domain Name Panelists at <http://www.wipo.int/amc/en/domains/panel/panelists.html>.

<sup>5</sup> The Index is available at the Center’s web site at <http://www.wipo.int/cgi-bin/domains/search/legalindex>.

<sup>6</sup> The Overview is available at the Center’s web site at <http://www.wipo.int/amc/en/domains/search/overview>.

<sup>7</sup> The portal page of this new facility is located at <http://www.wipo.int/amc/en/domains/statistics>.

<sup>8</sup> See the list of events organized by the Center at <http://www.wipo.int/amc/en/events>.

<sup>9</sup> 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/ccld>.

<sup>10</sup> *New Generic Top-Level Domains: Intellectual Property Considerations*, available at <http://www.wipo.int/amc/en/domains/reports/newgtld-ip>.

applicable during the introduction of any new gTLD. Such preventive mechanism would be in addition to the curative relief option provided by the UDRP.

10. In addition to policy work addressing new gTLDs, the Center also administers cases under their start-up policies. In the past, this has in particular concerned some 15,000 cases processed under the .biz Start-Up Trademark Opposition Policy and the .info Sunrise Registration Challenge Policy.<sup>11</sup>

11. More recently, between August 2006 and March 2007, the Center administered pre-registration trademark protection mechanisms concerning the new gTLD <.mobi>, which was launched in May 2006 by its registry, Mobile Top Level Domain Ltd. (mTLD).<sup>12</sup> mTLD adopted, in addition to the UDRP which applies to all gTLDs, two separate domain-specific procedures created and administered by the Center. The first special procedure applicable to .mobi consisted of the .MOBI Premium Name Trademark Application Rules. This mechanism enabled trademark owners to reclaim so-called Premium Names, the generic value of which had led the registry to reserve these for auction or other commercial allocation. During the Premium Name application period, which lasted from September 15 to October 13, 2006, the Center received 105 applications, all of which were decided by March 2007 by WIPO panelists under special conditions relating to the registration and use of corresponding trademarks.

12. The second special procedure applicable to .mobi consisted of the .MOBI Sunrise Challenge Policy, which allowed interested parties to challenge .mobi names inappropriately registered during a special registration period that had been reserved for trademark owners. During the challenge period, which lasted from August 28 to December 15, 2006, the Center received 18 challenges, all of which were processed by March 2007.

13. So as to help safeguard the observance of general principles of intellectual property protection, WIPO is continuously in contact with registries of other prospective new gTLDs for the possible provision of policy drafting assistance and fee-based dispute resolution services.

#### Domain Names and Other Identifiers

14. 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, namely, International Nonproprietary Names for pharmaceutical substances (INNs), the names and acronyms of international intergovernmental organizations (IGOs), personal names, geographical identifiers and trade names.

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<sup>11</sup> The Center's Reports on its experience under these policies are available at <http://www.wipo.int/amc/en/domains/reports/biz-stop> and at <http://www.wipo.int/amc/en/domains/reports/info-sunrise>.

<sup>12</sup> Information on the Center's activities that relate to .mobi is available at <http://www.wipo.int/amc/en/domains/gtld/mobi>.

*Recommendations by WIPO Member States*

15. The Report of the Second WIPO Internet Domain Name Process<sup>13</sup> 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.<sup>14</sup> 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. No such recommendation was made for other identifiers. The recommendations were supplemented by the SCT at its ninth session in November 2002.<sup>15</sup> The WIPO Secretariat transmitted these recommendations (the “WIPO-2 Recommendations”) to ICANN in February 2003.<sup>16</sup>

*Developments at ICANN*

16. Following consideration by the consultative bodies and supporting organizations of ICANN, including the Governmental Advisory Committee (GAC) which unanimously supported the WIPO-2 Recommendations, the ICANN Board of Directors decided, in June 2003, to form a working group “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<sup>17</sup> delivered in July 2004 a final report<sup>18</sup> to the Board of ICANN without, however, being able to make consensus recommendations.

17. In July 2004, the ICANN Board requested the President of ICANN to analyze the report for the Board so that the latter could take a decision at its meeting in December 2004.<sup>19</sup> 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, 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.<sup>20</sup>

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.<sup>21</sup> In November 2005, the Secretariat sent a letter to ICANN inquiring again about the status of the WIPO-2 Recommendations.

19. In December 2005, the President and CEO of ICANN suggested that ICANN’s Intellectual Property Constituency (IPC) reconsider the WIPO-2 Recommendations. The IPC

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<sup>13</sup> See footnote 2 above.

<sup>14</sup> All working documents of the special sessions of the SCT are available at <http://www.wipo.int/amc/en/processes/process2>.

<sup>15</sup> Document SCT/9/8, paragraphs 6 to 11. Same decision recorded in document SCT/9/9, paragraph 149.

<sup>16</sup> <http://www.wipo.int/amc/en/docs/wipo.doc>.

<sup>17</sup> <http://www.icann.org/announcements/announcement-06oct03.htm>.

<sup>18</sup> This report is posted at <http://www.icann.org/committees/JWGW2/final-report>.

<sup>19</sup> <http://www.icann.org/minutes/kl-resolutions-23jul04.htm>.

<sup>20</sup> The Briefing Note is posted on ICANN’s web site at <http://www.icann.org/committees/JWGW2>.

<sup>21</sup> The letter is posted on the Center’s web site at <http://www.wipo.int/amc/en/docs/letter.pdf>.

addressed this matter in a position paper on the introduction of new gTLDs.<sup>22</sup> The relevant part of the IPC statement reads as follows:

“After consideration of the WIPO 2 recommendations and the background material, including the report of the ICANN presidential task force, it is the opinion of the IPC that there is potential for a consensus-based solution to disputes involving names of IGOs, but not disputes involving country names. In sum, in line with WIPO’s own comments, the IPC finds that there is insufficient international law on which to base a dispute resolution procedure for country names. It is the IPC’s belief that the matter of the legal status of country names is not yet ripe for consideration by ICANN and requires more discussion and consensus within the confines of governments and appropriate international accords. It is the IPC’s recommendation that ICANN make an effort to proceed with a new, community accepted IGO dispute resolution policy (DRP) and refer the matter of country names back to governments and other appropriate parties for further discussion.”

20. In a letter dated March 13, 2006,<sup>23</sup> the President and CEO of ICANN informed the Secretariat that it had not been possible to achieve a consensus among the various constituencies of ICANN. Since, by virtue of its Bylaws, ICANN was dependent on its “bottom-up consensus-seeking procedures” to introduce new policies or modify existing ones, the President and CEO of ICANN expressed doubts as to whether a re-launch of such a consensus-seeking procedure would result in a basis for moving forward with the WIPO-2 Recommendations as a whole. Referring to the IPC position paper, the letter however indicated that progress might be possible with regard to the protection of the names and acronyms of IGOs for which an established basis exists in international law.

21. In view of the statement made by the President and CEO of ICANN, it appears unlikely that ICANN will move to implement the part of the WIPO-2 Recommendations that concerns the protection of country names. As to the WIPO-2 Recommendations on IGO names and acronyms, on April 5, 2007, the IPC submitted the following recommendation to the ICANN’s relevant policy-formulating body, the Generic Names Supporting Organization (GNSO):<sup>24</sup>

“The GNSO Council should request an Issues Report from ICANN staff to further explore the issues involved in introducing a separate dispute resolution procedure (DRP) specifically for addressing disputes involving IGO names and abbreviations. Based on this Issues Report, the GNSO Council may then consider launching a PDP [Policy Development Process] on the topic.”

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<sup>22</sup> *Comments of the Intellectual Property Constituency, Terms of Reference for New gTLDs, January 31, 2006*, posted on ICANN’s web site at <http://gnso.icann.org/issues/new-gtlds/ipc-01feb06.pdf>.

<sup>23</sup> A similar letter was sent to the then Chairman of the GAC, Mr. Sharil Tarmizi. It is posted on ICANN’s web site at <http://www.icann.org/correspondence/twomey-to-tarmizi-13mar06.pdf>.

<sup>24</sup> *IPC’s Recommendation to the GNSO Council Regarding Policy Work on Protection of IGO Names and Abbreviations in line with WIPO 2* is posted on ICANN’s web site at <http://gnso.icann.org/mailing-lists/archives/council/msg03368.html>.

22. Upon the request of the GNSO Council, ICANN staff produced on June 15, 2007, an Issues Report on Dispute Handling for IGO Names and Abbreviations,<sup>25</sup> recommending as follows:

“Staff does not recommend a PDP on the protection of IGO names and abbreviations at this time. If staff was recommending a PDP, it would be within the scope of the GNSO;

“Staff recommends that new gTLD agreements may provide for protection of IGO names and abbreviations as a contractual condition for new gTLDs;

“Staff recommends that a separate Dispute Resolution Procedure [DRP] be developed for IGO names and abbreviations as domain names at the second or third level in new gTLDs and that a framework be developed for handling objections or challenges related to IGO names and abbreviations in the upcoming application round for new gTLDs. Staff believes that this action will be more efficient than launching a PDP at this time;

“Once the DRP has been developed, staff recommends that the GNSO Council consider launching a PDP to investigate its application to existing gTLDs;

“In the alternative, the GNSO Council may consider forming a Working Group or assistance group to collaborate on a DRP for IGO names and abbreviations and conduct a PDP for application of the DRP to existing gTLDs;

“The GNSO Council may also consider extending the work of the Protections of Rights of Others (PRO) Working Group to develop a DRP for IGO names and abbreviations.”

23. At the ICANN meeting in San Juan, Puerto Rico, United States of America, of June 25 to 29, 2007, the GNSO Council accepted ICANN staff’s recommendation not to initiate a PDP and requested ICANN staff to continue work as proposed in the Issues Report, reporting back to the GNSO Council within three months. The GNSO Council decided to reconsider whether to initiate a PDP at such time. The WIPO Secretariat will continue to monitor ICANN developments and provide input where possible.

#### Developments in the Domain Name System

24. The DNS has been undergoing significant developments that create greater opportunities for mass registration of domain names and hence present greater challenges for intellectual property rights owners, in particular trademark owners, in policing and enforcing their rights. Such developments include the use of “Whois” privacy services for registrations; the growth in the number of professional domain name dealers and the volume of their activity; the use of computer software to automatically register expired domain names and

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<sup>25</sup> *GNSO Issues Report on Dispute Handling for IGO Names and Abbreviations* is posted on ICANN’s web site at <http://gnso.icann.org/issues/igo-names/issues-report-igo-drp-15jun07.pdf>.

their “parking” on pay-per-click portal sites; the option to register names for free for a five-day “tasting” period; the growth in the number of ICANN-accredited registrars; and the establishment of new gTLDs. Domain names used to be primarily identifiers for businesses and other Internet users, but are increasingly taking on aspects of commodities for speculative gain. Whereas traditionally domain name abuse involved the registration of domain names by individuals seeking to sell the “squatted” names, nowadays a growing number of “domainers” are deriving income from the large-scale automated registration of domain names corresponding to third-party identifiers.

25. On March 12, 2007, the Secretariat issued a WIPO Press Release which, in addition to covering WIPO’s domain name-related activities over 2006, drew special attention to the above developments and the legal and practical challenges which these pose for trademark owners and Internet users.<sup>26</sup> The Secretariat is currently considering organizing a conference in early 2008, which would include representatives from both the public and the private sectors, in order to discuss such challenges and to consider action that may be taken, both in terms of the UDRP and other legal and policy instruments.

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

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<sup>26</sup> The Press Release, entitled *Cybersquatting Remains on the Rise with Further Risk to Trademarks from New Registration Practices*, is available at [http://www.wipo.int/edocs/prdocs/en/2007/wipo\\_pr\\_2007\\_479.html](http://www.wipo.int/edocs/prdocs/en/2007/wipo_pr_2007_479.html).