

# WIPO



WO/GA/38/12

ORIGINAL: English

DATE: July 24, 2009

WORLD INTELLECTUAL PROPERTY ORGANIZATION  
GENEVA

E

## WIPO GENERAL ASSEMBLY

Thirty-Eighth (19<sup>th</sup> Ordinary) Session  
Geneva, September 22 to October 1, 2009

### INTERNET DOMAIN NAMES

*prepared by the Secretariat*

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 (WIPO 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. It covers the WIPO Center's administration of domain name disputes under different policies and various related aspects of the DNS, as well as selected policy developments, in particular the introduction of new generic top-level domains (gTLDs), internationalized domain names (IDNs), and the status of the recommendations made by the Member States of WIPO in the context of the Second WIPO Internet Domain Name Process.

---

<sup>1</sup> 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>.

<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>.

I. Domain Names and Trademarks

A. *Uniform Domain Name Dispute Resolution Policy*

3. The WIPO 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 WIPO Center has administered more than 15,500 UDRP and UDRP-based cases. In 2008, the WIPO Center witnessed an 8% increase over the previous year, administering a total of 2,329 cases covering 3,958 domain names registered in 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.

5. A diverse mixture of individuals and enterprises, foundations and institutions used the WIPO Center's dispute resolution procedures in 2008. The top five sectors for complainant business activity were Biotechnology and Pharmaceuticals, Banking and Finance, Internet and IT, Retail, and Food, Beverage and Restaurants. Pharmaceutical manufacturers remained the top filers due to numerous permutations of protected names registered for web sites offering or linking to online sales of medications and drugs. WIPO UDRP proceedings have so far involved parties from 143 countries. Reflecting the truly global scope of this dispute mechanism, in 2008 alone, named parties to WIPO cases represented over 100 countries. WIPO UDRP proceedings have so far been conducted in 16 different languages, namely (in alphabetical order), Chinese, Danish, Dutch, English, French, German, Hebrew, Italian, Japanese, Korean, Norwegian, Portuguese, Romanian, Russian, Spanish, and Swedish, 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 from all continents.<sup>4</sup>

6. Since the year 2000 all panel decisions are posted on the WIPO Center's website. To facilitate access to these decisions according to subject matter the WIPO Center also offers an online Legal Index.<sup>5</sup> This Index has become a highly-frequented professional resource, allowing panelists, parties, academics or any interested person to familiarize themselves with WIPO case precedent, and is one of the Organization's most visited web pages. The Index is updated periodically to include new search categories that primarily reflect developments in

---

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

<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>.

the Domain Name System itself.<sup>6</sup> In addition to its Legal Index, the WIPO Center also offers an overview of broad decision trends on important case issues, via the WIPO Overview of WIPO Panel Views on Selected UDRP Questions which distills thousands of UDRP cases handled by the WIPO Center. The Overview is an important instrument to help maintain the consistency of WIPO UDRP jurisprudence, and is planned to be updated later this year to reflect case developments until then.<sup>7</sup>

7. The WIPO Center also maintains on its web pages an extended statistics search facility in relation to WIPO domain name dispute resolution, intended to assist WIPO case parties and neutrals, trademark attorneys, domain name policy makers, the media and academics. Available statistics cover many categories, such as “areas of complainant activity”, “named respondents”, “domain name script” and “25 most cited decisions in complaint”.<sup>8</sup>

8. In addition, the WIPO Center regularly organizes Domain Name Dispute Resolution Workshops for interested parties<sup>9</sup> and meetings of its Domain Name Panelists. This coming year marks the tenth anniversary of the introduction of the UDRP and in recognition of this milestone the WIPO Center will turn its annual Panelists Meeting into an open Conference, “10 Years UDRP – What’s Next?”. This Conference will seek to draw lessons from the UDRP experience of the WIPO Center, panelists, parties, and other stakeholders, with a view to informing similar or other processes in the future of the Domain Name System and in the broader context of intellectual property, and exemplifies the WIPO Center’s commitment to monitoring and guiding developments in the DNS.

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

9. While the mandatory application of the UDRP is limited to domain names registered in gTLDs, such as .biz, .com, .info, .net and .org, the WIPO 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. Following further additions in recent months, the WIPO Center provides domain name dispute resolution services to 58 ccTLD registries.<sup>10</sup> In line with a global increase in the share of ccTLD registrations in recent years, the collective percentage of disputed ccTLD domain names in WIPO cases has been increasing, from less than 1% in the year 2000, to 7% in 2007, and 13% in 2008. The growth in demand for dispute resolution services among the ccTLD registries reflects the expansion of the Internet across regions.

---

<sup>6</sup> Most recently added Index categories include: Parking/landing pages; Tarnishment; Use of robots.txt; Addition of domain names; On-line archives; and, Consent to transfer.

<sup>7</sup> The Overview is available at the Center’s web site at <http://www.wipo.int/amc/en/domains/search/overview>.

<sup>8</sup> The portal page of this new facility is located at <http://www.wipo.int/amc/en/domains/statistics>.

<sup>9</sup> See the list of events organized by the Center at <http://www.wipo.int/amc/en/events>.

<sup>10</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/cctld>.

### C. *WIPO “eUDRP” Initiative*

10. Following extensive research and consideration, the WIPO Center submitted a proposal to ICANN, in December 2008, to remove the requirement to submit and distribute paper copies of pleadings relating to the UDRP process, primarily through the use of email.<sup>11</sup>

This forward-looking proposal emanates from awareness of environmental challenges and the recognition that Internet-based communication has become ubiquitous. WIPO’s “eUDRP Initiative” seeks to benefit all parties by eliminating the use of vast quantities of paper and the associated production and shipping costs, as well as improving the timeliness of UDRP proceedings without prejudicing either complainants or respondents. The WIPO Center expects implementation of this objective in the course of this year through changes to the WIPO Supplemental (UDRP) Rules, in the event that implementation by ICANN through the UDRP Rules does not prove expeditiously feasible.

## II. UDRP-Related Developments in the Domain Name System

11. Significant developments in the DNS pose continuing challenges for intellectual property rights owners, in particular trademark owners, in policing and enforcing their rights. Such developments include the growth in the number of professional domain name dealers and the volume of their activity, and the use of computer software to automatically register expired domain names and their “parking” on pay-per-click portal sites. 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.

### A. *Privacy or Proxy Registration Services*

12. In addition to the above developments, WIPO domain name panels have continued to address “Who Is” privacy services for registrations and the behavior of some domain name registrars, and their respective potential to complicate or disrupt the effective operation of the UDRP. The WIPO Center faces an increasing number of UDRP cases where respondents are making use of privacy or proxy registration services. Recent WIPO panel decisions have pointed out that while such services were not in contemplation at the time that the UDRP was first introduced, a privacy shield should not be used to protect cybersquatting practices. Panels have recognized legitimate uses of such services, but also noted that the shielding of information can create difficulties for panelists, parties and providers in determining the identity of the domain name registrant and proper respondent for cases brought under the UDRP. Panels have found that registrants cannot use privacy services to evade proceedings to which they may be a party as a result of their own conduct, and have recommended that ICANN provide uniform guidance on how such services should be considered under the UDRP.

---

<sup>11</sup> Full details of WIPO’s eUDRP Initiative, which is currently under consideration by ICANN, are available at <http://www.wipo.int/export/sites/www/amc/en/docs/icann301208.pdf>.

## B. Registrar Issues

13. Close to 1,000 companies have been accredited by ICANN to act as registrars for one or more gTLDs. This increase from only a handful of registrars in the year 2000 raises concerns, for example where certain registrars appear to engage in or collude with cybersquatting practices. This situation can blur the distinction between the ICANN-mandated obligations of a registrar and speculative behavior in the domain name marketplace, often at the expense of trademark holders. The WIPO Center actively engages with ICANN to bring to its attention circumstances that may frustrate the intended functioning of the UDRP with a view to preventing and resolving these issues.<sup>12</sup> These circumstances include non-compliant domain name registration provisions, the failure by a registrar to provide complete or correct registration information for a filed UDRP case, simple uncontactability of the registrar, “cyberflight”-related or other modifications to registrant data after a complaint is filed, and in some instances, failure to properly implement transfer decisions. The WIPO Center has also brought to the attention of ICANN, as the entity responsible for enforcing compliance in the contractual framework of the DNS, the activities of certain registrars that would seem to undermine the spirit if not the letter of the UDRP.<sup>13</sup>

## III. Policy Developments in the Domain Name System

14. Two policy developments pending implementation at ICANN will in particular present not only opportunities but also serious legal and practical challenges for intellectual property rights owners and users, namely the introduction of further new gTLDs and of IDNs at the top level.

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

15. In September 2007, ICANN’s policy-formulating body, the Generic Names Supporting Organization (GNSO), issued a set of recommendations (GNSO New gTLD Report)<sup>14</sup> to ICANN to implement a process that allows the introduction of further new gTLDs, broadly expanding their currently limited number.<sup>15</sup> These GNSO recommendations were approved by the Board of ICANN in June 2008.<sup>16</sup> Subsequently, ICANN published Versions I and II of a Draft Applicant Guidebook for New gTLDs, containing information for potential TLD applicants on October 23, 2008 and February 18, 2009, respectively.<sup>17</sup> According to recent ICANN announcements, Version III of the Draft Applicant Guidebook is scheduled to be published in September 2009, and applications for new gTLDs will be received from early 2010 (ICANN’s New gTLD Program).<sup>18</sup>

---

<sup>12</sup> An extensive overview of areas of non-compliant registrar behavior encountered by the Center is contained in a WIPO communication to ICANN of April 16, 2008. Other WIPO Center correspondence with ICANN related to registrar behavior includes a letter of November 27, 2008 concerning draft registrar best practices. See <http://www.wipo.int/amc/en/domains/resources/icann>.

<sup>13</sup> <http://www.wipo.int/export/sites/www/amc/en/docs/icann090409.pdf>.

<sup>14</sup> *ICANN GNSO Final Report on the Introduction of New Generic Top Level Domains* is available at <http://gnso.icann.org/issues/new-gtlds/pdp-dec05-fr-parta-08aug07.htm>.

<sup>15</sup> There are currently 21 gTLDs, such as .com, .mobi, .net.

<sup>16</sup> <http://www.icann.org/en/announcements/announcement-4-26jun08-en.htm>.

<sup>17</sup> <http://www.icann.org/en/topics/new-gtlds/draft-rfp-24oct08-en.pdf>.

<sup>18</sup> <http://www.icann.org/en/topics/new-gtlds/draft-rfp-clean-18feb09-en.pdf>.

<sup>18</sup> <http://www.icann.org/en/topics/new-gtld-program.htm>.

16. The GNSO New gTLD Report includes the following recommendation, of particular relevance for trademark owners:

“Recommendation 3: Strings must not infringe the existing legal rights of others that are recognized or enforceable under generally accepted and internationally recognized principles of law.

Examples of these legal rights that are internationally recognized include, but are not limited to, rights defined in the Paris Convention for the Protection of Industry [sic] Property (in particular trademark rights), the Universal Declaration of Human Rights (UDHR) and the International Covenant on Civil and Political Rights (ICCPR) (in particular freedom of expression rights).”

17. On its part, ICANN’s Governmental Advisory Committee (GAC) issued in 2007 the “GAC Principles regarding New gTLDs,” which states *inter alia*:

“2.3 The process for introducing new gTLDs must make proper allowance for prior third party rights, in particular trademark rights as well as rights in the names and acronyms of inter-governmental organizations (IGOs).”<sup>19</sup>

18. In its Press Release of March 16, 2009, WIPO noted that ICANN’s New gTLD Program, forecasting a large-scale expansion of the DNS, represents a watershed moment in the development of the DNS with significant trademark ramifications.<sup>20</sup> In this connection, the Final Report of the First WIPO Internet Domain Name Process had recommended, *inter alia*, that new gTLDs be introduced in a controlled manner. In the absence of adequate safeguards, ICANN’s planned expansion may give rise to trademark abuse, consumer confusion, and a general undermining of public trust in the DNS, with a heavier enforcement burden for trademark owners.

19. The WIPO Center expressed these concerns to ICANN and has been working closely with ICANN to attempt to safeguard the observance of general principles of intellectual property protection, in the event that the introduction of new gTLDs will proceed as intended by ICANN. The proposals made by the WIPO Center as outlined below are intended to provide a framework for addressing trademark abuse in connection with ICANN’s New gTLD Program.

(i) *Pre- (TLD) Delegation Dispute Resolution Procedure*

20. In reply to ICANN’s request for “Expressions of Interest from Potential Dispute Resolution Service Providers for New gTLD Program,” of December 21, 2007, the WIPO Center communicated to ICANN in a letter dated January 18, 2008 its readiness to assist ICANN in devising and applying dispute resolution procedures in relation to the introduction of new gTLDs to the extent these involve disputes based on intellectual property rights. Since then, the WIPO Center has worked with ICANN in the development of the substantive criteria of the pre-delegation procedure, which take into account the “WIPO Joint Recommendation Concerning Provisions on the Protection of Marks, and Other Industrial Property Rights in Signs, on the Internet,”<sup>21</sup> adopted by the WIPO General Assembly in September 2001, and

---

<sup>19</sup> [http://gac.icann.org/web/home/gTLD\\_principles.pdf](http://gac.icann.org/web/home/gTLD_principles.pdf).

<sup>20</sup> [http://www.wipo.int/pressroom/en/articles/2009/article\\_0005.html](http://www.wipo.int/pressroom/en/articles/2009/article_0005.html).

<sup>21</sup> [http://www.wipo.int/about-ip/en/development\\_iplaw/pub845-toc.htm](http://www.wipo.int/about-ip/en/development_iplaw/pub845-toc.htm).

the development of procedural rules for “Legal Rights Objections” (LRO) as integrated in ICANN’s Draft Applicant Guidebook. The WIPO Center has accepted to administer disputes under the LRO Procedure.<sup>22</sup>

(ii) *WIPO-Proposed Post- (TLD) Delegation Dispute Resolution Procedure*

21. From early 2008 the WIPO Center has advocated to ICANN the need for a permanent administrative option, additional to the procedure described in the preceding paragraph, that would allow for the filing of complaints with respect to an approved new gTLD, the registry’s actual manner of operation or use of which is alleged to cause or materially contribute to trademark abuse. On February 5, 2009, the WIPO Center communicated to ICANN a concrete substantive proposal for a trademark-based post-delegation dispute resolution procedure aimed at addressing such potential gTLD registry behavior. This proposal was published in a letter from the WIPO Center to ICANN dated March 13, 2009,<sup>23</sup> and is intended to act as a form of standardized assistance to ICANN’s own compliance oversight responsibilities, provide an administrative alternative to court litigation, encourage responsible conduct by relevant actors, and enhance the security and stability of the DNS.

22. Given the perceived convergence of registry, registrar, and registrant roles within the DNS, the WIPO Center further recommends to extend the concept behind this post-delegation proposal for registries also to address registrar conduct through ICANN registrar contracts.

(iii) *Complementary Rights Protection Mechanisms*

23. While the UDRP will remain an important curative tool for particular disputes involving the considered transfer of a disputed domain name to the trademark owner, the WIPO Center has also advocated the additional availability of a range of appropriate Rights Protection Mechanisms (RPMs) to safeguard legitimate trademark interests in the DNS. In so doing, the WIPO Center noted the need to strike a reasonable balance between the protection of trademark rights recognized by law, the practical interests of compliant registry operators to minimize operational burdens, and the legitimate expectations of good-faith domain name registrants. With these interests in mind, the WIPO Center on April 13, 2009, communicated to ICANN a discussion draft of an Expedited (Domain Name) Suspension Mechanism (ESM).<sup>24</sup> This RPM would succinctly address domain name disputes at the second (and lower) level, expanding present options for brand owners to combat cybersquatting in a cost and time effective manner. In this respect, it would be a narrowly tailored complement to the existing UDRP option.

(iv) *ICANN Implementation Recommendation Team*

24. In response to public comments made to ICANN’s Draft Applicant Guidebook, ICANN defined trademark protection as an overarching issue requiring further consideration with relevant parties, and the ICANN Board resolved in March 6, 2009 to request the ICANN Intellectual Property Constituency to convene an “Implementation Recommendation Team” (IRT) to develop and propose solutions to the overarching issue of trademark protection vis-à-vis new gTLDs.<sup>25</sup>

---

<sup>22</sup> See section 3.2 of the Draft Applicant Guidebook Versions I and II.

<sup>23</sup> <http://www.wipo.int/amc/en/docs/icann130309.pdf>.

<sup>24</sup> <http://www.wipo.int/amc/en/docs/icann030409.pdf>.

<sup>25</sup> <http://www.icann.org/en/minutes/resolutions-06mar09.htm#08>.

25. The IRT published its Draft Report on April 24, 2009, which distills a range of differing concepts and proposals including the WIPO Center's above-mentioned Post-Delegation and ESM proposals.<sup>26</sup> The IRT recommendations include the creation of a central "Clearinghouse" to collect and validate certain intellectual property rights and other data, and of a possible "Globally Protected Marks List" to reflect mostly quantitative conditions deemed appropriate in the context of the DNS.

26. The WIPO Center provided targeted comments to the Draft IRT Report through its letter of May 10, 2009, and through in-person discussions, commending the IRT for considerable progress and a sustainable foundation for further deliberation, while at the same time expressing concerns regarding the Draft IRT Report's adaptation of the WIPO Center's Post-Delegation and ESM proposals in a manner that risks undercutting their intended effectiveness.<sup>27</sup> The IRT published its Final Report on May 29, 2009.<sup>28</sup> While the IRT's Final Report accounts for several of the key trademark protection-based points raised by the WIPO Center, areas of concern remain outstanding in particular as to independent and effective system design, both in operational and in substantive terms. The WIPO Center expressed these concerns in a comment letter which it submitted to ICANN, and the IRT, on June 18, 2009.<sup>29</sup>

(v) *Continuing DNS Policy Discussions*

27. ICANN organized a round of public consultations in June and July 2009, regarding the overarching issue of trademark protection in regard to ICANN's New gTLD Program, including the IRT's recommendations, at which the WIPO Center was represented. The outcome of these consultations are expected to be reflected in Version III of ICANN's Draft Applicant Guidebook for New gTLDs, scheduled to be published in September 2009. The WIPO Center continues to contribute to discussions aimed at addressing trademark abuses in the DNS at multiple levels.

B. *Internationalized Domain Names (IDNs)*

28. Another significant policy development in the DNS currently being addressed by ICANN is the introduction of IDNs (non-Latin script) at the top level. IDN gTLDs are being discussed as part of the above-mentioned ICANN New gTLD Program, where potential new gTLD applications are expected to be made for IDNs. Separately, discussions on the introduction of IDN ccTLDs, associated with the two-letter codes in the ISO 3166-1 standard<sup>30</sup>, are taking place. These were led by the ICANN IDN Working Group (IDNC WG), formed jointly by the ICANN Country Code Names Supporting Organization (ccNSO) and the ICANN GAC, which in its Final Report, dated June 25, 2008, "IDNC Working Group Board Proposal,"<sup>31</sup> recommended *inter alia* the creation of an interim, fast

---

<sup>26</sup> <http://www.icann.org/en/topics/new-gtlds/irt-draft-report-trademark-protection-24apr09-en.pdf>.

<sup>27</sup> <http://www.wipo.int/amc/en/docs/icann100509.pdf>.

<sup>28</sup> <http://www.icann.org/en/topics/new-gtlds/irt-final-report-trademark-protection-29may09-en.pdf>.

<sup>29</sup> <http://www.wipo.int/export/sites/www/amc/en/docs/icann190609.pdf>.

<sup>30</sup> [http://www.iso.org/iso/english\\_country\\_names\\_and\\_code\\_elements](http://www.iso.org/iso/english_country_names_and_code_elements).

<sup>31</sup> IDNC Working Group Board Proposal is available at <http://ccnso.icann.org/workinggroups/idnc-wg-board-proposal-25jun08.pdf>.



track approach to introduce a limited number of IDN ccTLDs for countries and territories seeking an IDN ccTLD in their local language or script (IDN ccTLD Fast Track). On June 26, 2008, the ICANN Board directed ICANN to commence work on the implementation of IDN ccTLDs. ICANN's Final Implementation Plan for IDN ccTLD Fast Track is currently expected to be provided for ICANN Board consideration by October 2009.<sup>32</sup>

### C. *Domain Names and Other Identifiers*

29. In addition to and in connection with the above developments, there are further developments taking place at ICANN in relation to the protection of non-trademark identifiers.

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

31. 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.<sup>33</sup> The WIPO Secretariat transmitted these recommendations (WIPO-2 Recommendations) to ICANN in February 2003.<sup>34</sup>

32. Following further WIPO communications, in a letter dated March 13, 2006,<sup>35</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. The letter however indicated that progress might be possible with regard to the protection of names and acronyms of IGOs for which an established basis exists in international law.

33. In view of the statement made by the President and CEO of ICANN, it appeared unlikely that ICANN would move to implement the part of the WIPO-2 Recommendations that concerns the protection of country names at second level of existing gTLDs. As to the WIPO-2 Recommendations on IGO names and acronyms, upon the request of the GNSO

---

<sup>32</sup> ICANN's Draft Implementation Plan for the IDN ccTLD Fast Track Process of May 29, 2009, is available at <http://www.icann.org/en/topics/idn/fast-track/draft-implementation-plan-cctld-clean-29may09-en.pdf>.

<sup>33</sup> Document SCT/9/8, paragraphs 6 to 11. Same decision recorded in document SCT/9/9, paragraph 149.

<sup>34</sup> <http://www.wipo.int/amc/en/docs/wipo.doc>.

<sup>35</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>.

Council, ICANN staff produced on June 15, 2007, an Issues Report on Dispute Handling for IGO Names and Abbreviations,<sup>36</sup> recommending as follows:

“Staff does not recommend a PDP [Policy Development Process] 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.”

34. On June 27, 2007, the GNSO Council requested ICANN staff to provide a report on a draft IGO Domain Name Dispute Resolution Procedure, primarily foreseen for new gTLDs. Such Report was produced by ICANN Staff on September 28, 2007,<sup>37</sup> but to date has not been adopted by the GNSO Council.

35. While the WIPO-2 Recommendations were made in the context of the DNS at that time, *i.e.*, prior to ICANN’s plans for a broad expansion of the DNS, protection of geographical names and names and acronyms of IGOs is being reconsidered under ICANN’s New gTLD Program.

(i) *Protection of Geographical Names in New gTLDs*

36. ICANN’s GAC, in particular, has expressed concerns about the protection of geographical terms in the new gTLDs. In 2007 it issued the “GAC Principles regarding New gTLDs,”<sup>38</sup> which states *inter alia*:

“2.2 ICANN should avoid [in the introduction of new gTLDs] country, territory or place names, and country, territory or regional language or people descriptions, unless in agreement with the relevant governments or public authorities.

---

<sup>36</sup> GNSO Issues Report on Dispute Handling for IGO Names and Abbreviations is posted on ICANN’s web site at <http://gns0.icann.org/issues/igo-names/issues-report-igo-drp-15jun07.pdf>.

<sup>37</sup> <http://gns0.icann.org/drafts/gns0-igo-drp-report-v2-28sep07.pdf>.

<sup>38</sup> [http://gac.icann.org/web/home/gTLD\\_principles.pdf](http://gac.icann.org/web/home/gTLD_principles.pdf).

[...]

2.7 Applicant registries for new gTLDs should pledge to:

- a) Adopt, before the new gTLD is introduced, appropriate procedures for blocking, at no cost and upon demand of governments, public authorities or IGOs, names with national or geographic significance at the second level of any new gTLD.
- b) Ensure procedures to allow governments, public authorities or IGOs to challenge abuses of names with national or geographic significance at the second level of any new gTLD.”

37. The GAC submitted, upon the ICANN Board’s request, letters dated April 24 and May 26, 2009 to ICANN recommending *inter alia*, specific measures to protect geographic names in new gTLDs, including reserving names. These GAC recommendations will be subject to further discussion with the ICANN GNSO and ICANN Board approval.

*(ii) Protection of IGO Names and Acronyms in New gTLDs*

38. With regard to the protection of IGO names and acronyms in the new gTLDs, an ICANN staff document circulated to the GAC reports that the GAC principle on the protection of “prior third party rights [...] in the names and acronyms of inter-governmental organizations,” is addressed by the GNSO recommendations and that rights in IGO names and acronyms would be a ground for objections from third parties to strings proposed by applicants. It remains to be seen whether ICANN’s implementation of the introduction of the new gTLDs will indeed include such a protection mechanism.

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

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

[End of document]