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WIPO ARBITRATION AND MEDIATION CENTER, INCLUDING DOMAIN NAMES

Document prepared by the Secretariat

1. This document provides an update on the WIPO Arbitration and Mediation Center's ("Center") activities as an international resource for time- and cost-efficient alternatives to court litigation of intellectual property (IP) disputes, acting both as a provider of legal and organizational expertise and as an administrator of cases.¹
2. This document also provides an update on the domain name-related activities of WIPO, as previously reported in WO/GA/41/17 Rev.2. It covers the Center's administration of domain name disputes under different policies and various related aspects of the Internet Domain Name System (DNS), as well as selected policy developments, in particular rights protection mechanisms (RPMs) for the introduction of new generic top-level domains (gTLDs), the emergence of internationalized domain names (IDNs) as gTLDs, the planned future revision by the Internet Corporation for Assigned Names and Numbers (ICANN) of the Uniform Domain Name Dispute Resolution Policy (UDRP), and the status of the recommendations made by the Member States of WIPO in the context of the Second WIPO Internet Domain Name Process.

I. ARBITRATION AND MEDIATION OF INTELLECTUAL PROPERTY DISPUTES

A. ARBITRATION AND MEDIATION CASE ADMINISTRATION

3. In 2012, the Center worked to optimize the potential of its mediation and arbitration procedures to meet the needs of IP right holders for timeliness and cost-effectiveness in the

¹ The Center's previous report to the WIPO General Assembly (WO/GA/41/17 Rev.2) can be found at http://www.wipo.int/edocs/mdocs/govbody/en/wo_ga_41/wo_ga_41_17_rev_2.pdf.

resolution of disputes in relation to those rights. The principal component of this effort is quality management and resolution of cases conducted under those procedures, which entails training² and appointing qualified arbitrators and mediators, maintaining up-to-date case administration infrastructure, including through the use of information technology such as the WIPO Electronic Case Facility (ECAF),³ and active management of WIPO cases, including support to appointed neutrals. Cases under WIPO Rules in 2012 included those related to patent, trademark, software, and franchising contracts, and were submitted to the Center by parties on the basis of prior contract clauses as well as submission agreements.

B. ALTERNATIVE DISPUTE RESOLUTION (ADR) SERVICES FOR SPECIFIC SECTORS

(i) Collaboration with Intellectual Property Offices (IPO)

4. In a recent development, the Center offers services to IPOs in their establishment of optional dispute resolution frameworks. Such collaboration, which also includes training programs and case administration, aims to provide cost-effective and flexible options for parties to resolve their disputes before IPOs in relation to pending applications or granted rights.

5. Following the establishment of a joint dispute resolution procedure to facilitate the mediation of trademark oppositions at the Intellectual Property Office of Singapore (IPOS), the Center administered the first such mediation cases. This experience is being evaluated for possible use also in patent and design proceedings before IPOS. The Center is also collaborating in the development of mediation and arbitration options for trademark and patent proceedings before the Brazilian National Institute of Industrial Property (INPI-BR). INPI-BR has designated the Center as the administrator of such mediation and arbitration cases where one or both parties are domiciled outside Brazil.

(ii) Research and Development (R&D) Dispute Resolution

6. Another area of Center activity is the provision of advice and case administration services to help parties resolve disputes arising in R&D and in technology transfer. Parties involved in R&D collaboration often use model agreements as a basis for drafting and negotiating their research contracts. One such example involves multi-party collaborations funded under the European Union's Seventh Framework Programme EC (FP7), where entities use the "DESCA" model consortium agreement, which since 2011 recommends WIPO mediation and expedited arbitration.⁴ The DESCAs model agreement covers many industries internationally and is also open for participation of non-European entities in research consortia. Users of the DESCAs model agreement are changing their internal dispute resolution policies in order to ensure consistent use of WIPO dispute resolution clauses. Also, as part of a broader effort under a Memorandum of Understanding (MoU) between WIPO and the Association of University Technology Managers (AUTM), the Center continued its collaboration with AUTM to support efficient and effective dispute resolution to university technology transfer offices around the world.

² All workshops and other events organized by the Center are listed at <http://www.wipo.int/amc/en/events>.

³ ECAF offers online case communication and storage of documents facilitating time- and cost-efficient mediation and arbitration proceedings. See <http://www.wipo.int/amc/en/ecaf/index.html>.

⁴ DESCAs, which stands for "Development of a Simplified Consortium Agreement", is a model consortium agreement initially developed for research projects funded by the European Commission under the Seventh Framework Programme (FP7) under the auspices of the DESCAs Core Group. The DESCAs model agreement is estimated to be used by some 75 per cent of companies, research organizations, universities and individuals involved in cross-border research projects funded by FP7. This program covers all research-related EU initiatives including in the areas of health, food, agriculture, fisheries, biotechnology, information and communication technology, nano-technologies, materials and new production technologies, energy, environment, transport (including aeronautics), socio-economic sciences, space and security. See <http://www.desca-fp7.eu/>.

(iii) Film and Media Dispute Resolution

7. In the area of film and media dispute resolution, MoUs were signed in 2012 between WIPO and the Korea Creative Content Agency (KOCCA) and the Ministry of Culture, Sports and Tourism (MCST) of the Republic of Korea, aiming to promote ADR services in sectors covered by their respective activities.

(iv) International Survey on Dispute Resolution in Technology Transactions

8. Having concluded in 2012 its International Survey on Dispute Resolution in Technology Transactions, the Center in 2013 made available a Survey Report which presents the practices and motivation of almost 400 Survey respondents from over 60 countries, and assesses the current use and comparative merits of ADR methods for resolving technology-related disputes.⁵ The Survey results provide a statistical basis to identify trends in the resolution of technology related disputes. They also reveal best practices which may help guide IP stakeholders in their dispute resolution strategies and the Report concludes with a number of observations relevant to such strategies.

II. DOMAIN NAME CASE ADMINISTRATION

A. UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY

9. The DNS raises a number of challenges for the protection of IP, 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 First⁶ and Second⁷ WIPO Internet Domain Name Processes. In particular, the Center provides trademark owners with efficient international mechanisms to deal with the bad-faith registration and use of domain names corresponding to their trademark rights.

10. The Center administers dispute resolution procedures principally under the UDRP. The UDRP was adopted by 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 and has proven highly popular among trademark owners. It does not prevent either party from submitting a dispute to a competent court of justice; but very few cases that have been decided under the UDRP have been brought before a national court of justice.⁸

11. Since December 1999, the Center has administered more than 26,000 UDRP and UDRP-based cases. Demand for this WIPO service continued in 2012 with trademark holders filing 2,884 complaints, an increase of 4.5 per cent over the 2011 level. The Center makes available online real-time statistics to assist WIPO case parties and neutrals, trademark attorneys, domain name policy makers, the media and academics.⁹

⁵ Survey Report and Executive Summary: <http://www.wipo.int/amc/en/center/survey/results.html>.

⁶ 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>.

⁷ 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>.

⁸ See Selected UDRP-related Court Cases at <http://www.wipo.int/amc/en/domains/challenged>.

⁹ Available statistics cover many categories, such as “areas of complainant activity”, “named respondents”, “domain name script”, and “25 most cited decisions in complaint”. See <http://www.wipo.int/amc/en/domains/statistics>.

12. A diverse mixture of individuals and enterprises, foundations, and institutions used the Center's dispute resolution procedures in 2012. The top five sectors for complainant business activity were Retail, Fashion, Banking and Finance, Biotechnology and Pharmaceuticals, and Internet and Information Technology. The increased filings related to fashion and luxury brands reflect in part a growth in the number of cases filed by brand owners alleging counterfeiting *via* the web pages offered under the disputed domain name. WIPO UDRP proceedings have so far involved parties from 173 countries. Reflecting the truly global scope of this dispute mechanism, in 2012 alone, named parties to WIPO cases represented over 120 countries. In function of the language of the applicable registration agreement of the domain name at issue, WIPO UDRP proceedings have so far been conducted in 20 different languages.¹⁰

13. All WIPO panel decisions are posted on the Center's website. The Center offers a unique online overview of broad decision trends on important case issues *via* the WIPO Overview of WIPO Panel Views on Selected UDRP Questions (WIPO Overview 2.0) which distills thousands of UDRP cases handled by the Center. This globally relied-upon instrument was created in recognition of the need that has been expressed to identify, as much as possible, consensus among UDRP decisions so as to help maintain the consistency of WIPO UDRP jurisprudence.¹¹ To facilitate access to these decisions according to subject matter, the Center also offers a widely popular online searchable Legal Index of WIPO UDRP Decisions.¹²

14. As the leading provider of case administration services under the UDRP, the Center monitors developments in the DNS with a view to continually adjusting its resources and practices.¹³ The Center regularly organizes Domain Name Dispute Resolution Workshops on updates to precedents and practices for interested parties¹⁴ and meetings of its Domain Name Panelists.

B. COUNTRY CODE TOP-LEVEL DOMAINS (ccTLD)

15. While the mandatory application of the UDRP is limited to domain names registered in gTLDs, such as .com, .net, and .org, the Center also assists ccTLD registries in their establishment of registration conditions and dispute resolution procedures that conform with best practices in IP protection. These procedures are mostly modeled after the UDRP, but may take account of the particular circumstances and needs of individual ccTLDs. The Center currently provides domain name dispute resolution services to 68 ccTLD registries, most recently including the domain spaces .FM (Micronesia (Federated States of)), .PW (Palau), and .TZ (Tanzania (United Republic of)).¹⁵

III. POLICY DEVELOPMENTS IN THE DOMAIN NAME SYSTEM

16. A number of policy developments in relation to ICANN present both opportunities and challenges for owners and users of IP rights. One is ICANN's planned introduction of up to 1,400 new gTLDs. Such new gTLDs may be of an "open" nature (similar to .com), or may take

¹⁰ In alphabetical order, Chinese, Czech, Danish, Dutch, English, French, German, Hebrew, Italian, Japanese, Korean, Norwegian, Polish, Portuguese, Romanian, Russian, Slovak, Spanish, Swedish, Turkish.

¹¹ The Overview is available at <http://www.wipo.int/amc/en/domains/search/overview>.

¹² The WIPO Legal Index has become an essential professional resource, allowing panelists, parties, academics or any interested person to familiarize themselves with WIPO case precedent. The Index is updated periodically to include new search categories that primarily reflect developments in the DNS itself and is available at <http://www.wipo.int/cgi-bin/domains/search/legalindex>.

¹³ See, e.g., WO/GA/41/17 Rev.2, paragraphs 14-16.

¹⁴ See footnote 2, *supra*.

¹⁵ 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>.

on more specific or restrictive characteristics, for example taking the form of .[brand], .[city], .[community], .[culture], .[industry], or .[language]. A second development concerns the introduction of IDNs at the top level. Also, ICANN's envisaged expansion of the DNS raises rights protection questions in connection with the Second WIPO Internet Domain Name Process.

A. NEW GENERIC TOP-LEVEL DOMAINS

17. ICANN implementation of its New gTLD Program was formally approved in a Board vote at ICANN's Meeting in Singapore on June 20, 2011.¹⁶ Information has been published in ICANN's much-revised "Applicant Guidebook".¹⁷ Delegation of the first new gTLDs in 2013 is expected to be followed, where applicable, by registrations of individual domain names (further application rounds are expected in due course).¹⁸

18. While the Center remains committed to working with stakeholders to attempt to safeguard the observance of general principles of IP protection in any new gTLDs ultimately approved by ICANN, a number of the RPMs which have emerged from a series of ICANN committees and processes for new gTLDs are seen to have been diluted in their intended effectiveness, both in operational and in substantive terms.¹⁹ Set out below is a broad description of the RPMs adapted and adopted by ICANN, in relation to the top level and the second level respectively.

(i) Top Level Rights Protection Mechanisms

- Pre- (TLD) Delegation Dispute Resolution Procedure

19. This mechanism allows trademark owners to lodge Legal Rights Objections (LRO) to new gTLD applications at the top level where certain substantive criteria are met (other objection grounds recognized by ICANN are: "String Confusion Objections", "Community Objections", and "Limited Public Interest Objections"²⁰). The Center has assisted ICANN in the establishment of the substantive criteria for the LRO procedures which are rooted in the "WIPO Joint Recommendation Concerning Provisions on the Protection of Marks, and Other Industrial Property Rights in Signs, on the Internet"²¹ (Joint Recommendation) adopted by the WIPO General Assembly in September 2001.

20. The Center has been appointed by ICANN as the exclusive provider of LRO dispute resolution services.²² With the LRO objection window having closed in March 2013, processing by the Center of the 69 LRO Objections found to be procedurally compliant is currently underway.²³

¹⁶ See <http://www.icann.org/en/minutes/resolutions-20jun11-en.htm>. For further background including references, see document WO/GA/39/10, in particular paragraph 14.

¹⁷ ICANN's Applicant Guidebook is available at <http://newgtlds.icann.org/en/applicants/agb>.

¹⁸ For background on ICANN's New gTLD Program and Center monitoring, see WO/GA/41/17 Rev.2, in particular paragraphs 22 and 23.

¹⁹ For further background including references, see WO/GA/39/10, in particular paragraphs 23-30. It is noted here that ICANN summarily rejected a proposal for a "Globally Protected Marks List".

²⁰ The Applicant Guidebook further foresees a number of other procedures which governments may avail themselves of following ICANN announcement of new gTLD applications. Notably, section 1.1.2.4 provides for "GAC Early Warning," and section 1.1.2.7 provides for "Receipt of GAC Advice on New gTLDs" for the ICANN Board's consideration.

²¹ See http://www.wipo.int/about-ip/en/development_iplaw/pub845-toc.htm.

²² For the procedural LRO Rules, see section 3.2 of the ICANN Applicant Guidebook.

²³ See WIPO Rules for New gTLD Dispute Resolution, and Schedule of Fees and Costs, respectively at <http://www.wipo.int/amc/en/docs/wipolorules.pdf> and <http://www.wipo.int/amc/en/domains/lro/fees/>; see WIPO-registered LRO cases at <http://www.wipo.int/amc/en/domains/lro/cases/>.

- Post- (TLD) Delegation Dispute Resolution Procedure (PDDRP)

21. From early 2008, the Center has raised with ICANN the potential usefulness of a permanent administrative option that would allow for the filing of a complaint with respect to an approved new gTLD registry operator whose manner of operation or use of its registry is alleged to cause or materially contribute to trademark abuse. In early 2009, the Center communicated to ICANN a concrete substantive proposal for such a trademark-based post-delegation dispute resolution procedure.²⁴ The proposal's intent was to offer standardized assistance to ICANN's own compliance oversight responsibilities, by providing an administrative alternative to court litigation, encouraging responsible conduct by relevant actors and including appropriate safe-harbors.²⁵

22. Following various ICANN committee processes and consultations with registry operators, the effectiveness of this PDDRP in the form adopted by ICANN remains uncertain, in particular given the addition of overlapping procedural layers, and issues concerning the intended substantive scope of this mechanism.²⁶

(ii) Second Level Rights Protection Mechanisms

- Trademark Clearinghouse

23. ICANN's New gTLD Program includes a "Trademark Clearinghouse" as a centralized repository of authenticated trademark data which could be invoked as the basis for filing under new gTLD RPMs.²⁷ The adoption of this concept involved extensive ICANN discussions *inter alia* concerning the relation to trademark office determinations. The Center has commented that any such Clearinghouse should not unfairly burden rights holders in the treatment of trademark registrations legitimately obtained through examination and registration systems as applied in many global jurisdictions, and that, if and where appropriate, practical measures may be envisaged to identify any allegedly inappropriate invocation of rights in specific contexts.

24. The Clearinghouse has been open for trademark submission and validation since March 2013,²⁸ and the Center continues to monitor developments regarding this mechanism.

²⁴ See <http://www.wipo.int/amc/en/docs/icann130309.pdf>.

²⁵ Given the perceived convergence of registry, registrar, and registrant roles within the DNS, the Center has further recommended, *inter alia* taking account of its UDRP-based experiences, and ICANN's decision to allow for cross-ownership between registries and registrars (see <http://www.icann.org/en/minutes/resolutions-05nov10-en.htm>), that ICANN consider extending the PDDRP for registries also to registrar conduct (see, *inter alia*, <http://www.wipo.int/amc/en/docs/icann260310rap.pdf>).

²⁶ The Center in June 2013 submitted a proposal to provide dispute resolution services under the ICANN Trade Mark PDDRP, in response to an ICANN request.

²⁷ The Clearinghouse allows for inclusion of registered word marks, word marks protected by statute or treaty or validated by court, and "[o]ther marks that constitute intellectual property" (the latter being undefined). With respect to RPMs utilizing Clearinghouse data, the availability of "Sunrise" services (i.e., an opportunity for a trademark owner, for a fee, to preemptively register an exact match of its mark as a domain name) is presently limited to those trademarks for which current use can be demonstrated. Whether or not substantiated by demonstration of current use, trademark owners would also be eligible to participate in a time limited "Claims" service (i.e., notice to a potential domain name registrant of the existence of a potentially conflicting trademark right, and notice to the relevant trademark owner(s) in the event that the registrant nevertheless proceeds with domain name registration). The availability of the Claims service is limited to a maximum duration of 90 days after a new gTLD is opened for general public registration. Among trademark owners, it is anticipated that such limitations may give rise to gaming, with attendant financial and enforcement burdens for trademark owners and increased potential for consumer confusion. The demonstration of use required for Sunrise services similarly applies to the invocation of trademarks as a basis for a complaint filed under the "Uniform Rapid Suspension" RPM described below.

²⁸ In June 2012, ICANN announced its selection of Trademark Clearinghouse Service Providers, see <http://www.icann.org/en/news/announcements/announcement-3-01jun12-en.htm>.

- Uniform Rapid Suspension (URS) System

25. While importantly the UDRP remains available as a curative tool for new gTLD disputes involving the considered transfer of a disputed domain name to the trademark owner, ICANN has introduced what is intended to be a lighter second-level RPM for appropriate cases. The Center for its part communicated to ICANN in April 2009 a discussion draft of an “Expedited (Domain Name) Suspension Mechanism”,²⁹ and has made subsequent proposals for a streamlined mechanism based on this model at the ICANN Prague and Toronto Meetings in 2012.³⁰ Such proposals took account of the need to strike a reasonable balance between the protection of trademark rights recognized by law, the practical interests of good-faith registration authorities to minimize operational burdens, and the legitimate expectations of *bona fide* domain name registrants.

26. The URS adopted by ICANN has evolved from a sequence of ICANN processes and committees, and is viewed by many as having become an overburdened procedure for a limited remedy. Questions remain as to how effective the URS will be as an efficient and enforceable complement to the court-alternative UDRP, and a range of issues remain to be addressed, including its relationship with the UDRP.³¹ ICANN invited tenders in late 2012 from prospective URS providers, to which after careful consideration of the ICANN URS model and related resources the Center was not in a position to apply.³² The Center continues to closely monitor developments.

B. ICANN’S PLANNED FUTURE REVISION OF THE WIPO-INITIATED UDRP AND THE UDRP LOCK WORKING GROUP

27. Accommodating the dynamic development of the DNS, the UDRP has been offering an effective alternative to court litigation for trademark owners, domain name registrants, and registration authorities. Nevertheless, following discussions at which the clear majority of participants were of the opinion that more harm than good could result from any review of the UDRP by ICANN,³³ a decision was taken by ICANN’s Generic Names Supporting Organization (GNSO) to review the UDRP through a process envisaged to commence within some 18 months following the delegation of the first new gTLDs.³⁴

28. The UDRP functions today as the remarkable result of care invested by many stakeholders over a dozen years, for public and private benefit. By accommodating evolving norms and practices, the UDRP has proven to be a flexible and fair dispute resolution system. Given ICANN’s institutional structure, where IP stakeholders hold a mere minority vote, it appears likely that any wide-ranging review could end up weakening the foundation and functioning of the UDRP. In the meantime, ICANN’s GNSO has commenced a “Policy Development Process” (PDP) with a more limited technical mandate of examining the mechanism for locking domain names subject to UDRP proceedings, in which the Center is actively participating. The Center will continue to closely follow ICANN stakeholders’ intentions with regard to the UDRP.

²⁹ See <http://www.wipo.int/amc/en/docs/icann030409.pdf>.

³⁰ See <http://prague44.icann.org/node/31773> and <http://toronto45.icann.org/node/34325>.

³¹ An extensive inventory of these issues is provided *inter alia* in the Center’s letter of December 2, 2010, available at <http://www.wipo.int/amc/en/docs/icann021210.pdf>. A number of these have been on the agenda of ICANN’s June 2012 Prague Meeting.

³² ICANN has announced the National Arbitration Forum and the Asian Domain Name Dispute Resolution Center as the first two URS providers in early 2013.

³³ See <https://community.icann.org/display/gnsoudrpdtd/Webinar+on+the+Current+State+of+the+UDRP>; see also more generally document WO/GA/39/10, paragraph 31.

³⁴ See <http://gnso.icann.org/meetings/minutes-council-15dec11-en.htm>.

C. INTERNATIONALIZED DOMAIN NAMES

29. As noted in paragraph 2, another significant policy development in the DNS is the introduction of IDNs (non-Latin script) at the top level. Because of the high priority drawn by IDN applications in the ICANN New gTLD approval process, it is expected that a number of these will be among the first of any new gTLDs announced by ICANN for delegation in the DNS root zone.

30. Separately, and prior to new gTLD development, ICANN's Final Implementation Plan for IDN ccTLD Fast Track Process was published on November 16, 2009.³⁵ Since then, this has allowed for the introduction of several IDN ccTLDs, associated with the two-letter codes in the ISO 3166-1 standard.³⁶ Approved requests continue to be delegated into the DNS root zone.³⁷

D. OTHER IDENTIFIERS

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

32. 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, including country names and the names and acronyms of inter-governmental organizations (IGOs).

33. 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.³⁸ The WIPO Secretariat transmitted these recommendations (WIPO-2 Recommendations) to ICANN in February 2003.³⁹

34. Following further ICANN deliberations,⁴⁰ ICANN's New gTLD Program Applicant Guidebook limited its consideration of the protection of the names and acronyms of IGOs to providing potential recourse through the pre-delegation objection procedure concerning the top level (i.e., an applied-for TLD), discussed in paragraphs 19 and 20 above. However, following an open letter from IGO legal counsel to ICANN in December 2011, and sustained IGO efforts, ICANN's Governmental Advisory Committee (GAC) issued advice to the ICANN Board that the names and acronyms of IGOs be granted protection against inappropriate third-party registration in the DNS prior to the delegation of any new gTLDs.⁴¹ The GAC further advised the ICANN Board that, building on existing .int criteria for second-level registrations in that space, it would collaborate with IGOs to develop a list of IGO names and acronyms that should be protected. Such protection would be at the second level for the current round of new gTLDs, and at both the second and top level in any future new gTLD rounds. The GAC also advised the Board that, pending work on further implementation, interim protection for IGO names and acronyms should be provided through a moratorium on third-party registration prior to the delegation of any new gTLDs.

³⁵ See <http://www.icann.org/en/topics/idn/fast-track/idn-ccTLD-implementation-plan-16nov09-en.pdf>.

³⁶ See http://www.iso.org/iso/english_country_names_and_code_elements.

³⁷ See <http://www.icann.org/en/topics/idn/fast-track/>.

³⁸ See http://www.wipo.int/edocs/mdocs/govbody/en/wo_ga_28/wo_ga_28_3.pdf; see also documents SCT/9/8, paragraphs 6 to 11; and, SCT/9/9, paragraph 149.

³⁹ See <http://www.wipo.int/amc/en/docs/wipo.doc>.

⁴⁰ For background, see WO/GA/41/17 Rev.2, in particular paragraphs 40 and 41.

⁴¹ See

https://gacweb.icann.org/download/attachments/27132070/FINAL_Toronto_Communique_20121017.pdf?version=1&modificationDate=1354149148000&api=v2.

35. The ICANN Board responded to the GAC indicating that it had adopted a resolution laying the groundwork for such interim protection at the second level based on the existing .int criteria, via an ICANN reserve list of identified IGO names and acronyms, to be withheld from third-party registration through the new gTLD registry agreement. ICANN specified a deadline for provision of relevant qualifying IGO names and acronyms of February 28, 2013, inviting qualifying IGOs to identify themselves to ICANN by that date, while also seeking provision by the GAC (with IGOs) of a consolidated IGO package comprising the criteria and list of IGO names and acronyms for which the GAC advises protection.⁴² In response, an IGO coalition developed .int-based criteria for IGO protection and an accompanying list of IGOs, which the IGO coalition forwarded to the ICANN Board on February 28, 2013. This was followed by a GAC communication to the ICANN Board of the GAC's preferred advice on IGO protection eligibility criteria (comprising treaty-based IGOs with international legal personality, or which are UN Observers, or which are funds or programs of the UN), together with a list of protectable IGO names and acronyms.⁴³

36. On April 1, 2013, the Board responded to the GAC with a letter raising certain issues regarding its advice. In particular, the Board sought further specifics on a possible means for periodic review of the list, along with clarification of any additional languages in which protection of IGO names and acronyms is sought. The third issue, rather more fundamentally, raised certain concerns about how the protection of IGO acronyms would be reconciled with certain potentially legitimate third-party attempts to register domain names corresponding to a protected IGO acronym, and sought further particulars about the possible means by which cases of potentially legitimate co-existent use could be managed in practice.⁴⁴ The GAC's response stressed the important global public mission of IGOs, committed to actively working to find a way forward, and reiterated its advice to the ICANN Board that appropriate preventative initial protection for listed IGO names and acronyms be in place before any new gTLDs would launch.

37. A substantive ICANN Board response to this further GAC advice remains pending. Parallel to consideration by the GAC, the ICANN GNSO has launched a PDP on the issue of IGO protection. The Center is also participating along with certain other IGOs in this parallel GNSO process, in which the issue of possible means to address potential coexistence between any protected IGO acronyms in particular and potentially legitimate third-party users also features prominently. Prospects for positive consensus gains for IGOs within the GNSO process appear limited given the overall composition of the group, but continuing IGO engagement has allowed for the sharing of broader developments on IGO protection within ICANN via GAC advice to the Board.

38. Concerning geographical terms, the GAC in particular has expressed concerns about their use and protection in the new gTLDs. In 2007 it issued the "GAC Principles regarding New gTLDs",⁴⁵ which states *inter alia* that ICANN should avoid delegation of new gTLDs concerning country, territory or place names, and regional language or people descriptions, unless in agreement with the relevant governments or public authorities. Those GAC Principles further stated that new registries should adopt procedures for blocking/challenge of names with national or geographical significance at the second level upon demand of governments.

39. Concerning the top level, ICANN's Applicant Guidebook foresees that "applications for strings that are country or territory names will not be approved, as they are not available under

⁴² See <https://gacweb.icann.org/download/attachments/27132070/Board%20Response%20to%20GAC%20Toronto%20Comunique.pdf?version=1&modificationDate=1361909146000&api=v2>.

⁴³ See <http://www.icann.org/en/news/correspondence/dryden-to-crocker-chalaby-22mar13-en>.

⁴⁴ See <http://www.icann.org/en/news/correspondence/crocker-to-dryden-01apr13-en>.

⁴⁵ See http://gac.icann.org/web/home/gTLD_principles.pdf.

the New gTLD Program in this application round.”⁴⁶ Applied-for strings which are considered by ICANN to be certain other geographic names, e.g., capital city names, need to be accompanied by documentation of support or non-objection from the relevant governments or public authorities.⁴⁷ Concerning second-level registrations, ICANN’s base registry agreement includes a “Schedule of Reserved Names at the Second Level in gTLD Registries” which makes provision for certain country and territory names.⁴⁸

40. The GAC has expressed further reservations regarding a number of new gTLD applications on grounds of correspondence to geographical or other terms, advising the ICANN Board not to proceed beyond initial evaluation for these, and seeking further clarification from the Board on scope for applicants to modify their new gTLD applications to address specific GAC concerns. The GAC has further identified six broad categories of new gTLD applications as warranting further consideration in terms of additional safeguards.⁴⁹ While the Board has accepted the GAC’s advice against proceeding with certain applications, it has sought further information from the GAC, as well as public comments, notably on the additional safeguards sought by the GAC.

41. Overall, the Center has endeavored to apprise relevant sectors within the Secretariat on the above-mentioned matters, including in support of the work of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT).⁵⁰

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

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

[End of document]

⁴⁶ See <http://www.icann.org/en/topics/new-gtlds/rfp-redline-30may11-en.pdf>, from section 2.2.1.4.1 “Treatment of Country or Territory Names”.

⁴⁷ See <http://www.icann.org/en/topics/new-gtlds/rfp-redline-30may11-en.pdf>, from section 2.2.1.4.2 “Geographic Names Requiring Government Support”.

⁴⁸ See <http://www.icann.org/en/topics/new-gtlds/agreement-specs-redline-30may11-en.pdf>, at Specification 5.

⁴⁹ See

https://gacweb.icann.org/download/attachments/27132037/Beijing%20Communique%20april2013_Final.pdf.

⁵⁰ See e.g., documents SCT/24/4, SCT 25/3, SCT 26/6 and 27/8 available at

http://www.wipo.int/edocs/mdocs/sct/en/sct_24/sct_24_4.pdf,

http://www.wipo.int/edocs/mdocs/sct/en/sct_25/sct_25_3.pdf,

http://www.wipo.int/edocs/mdocs/sct/en/sct_26/sct_26_6.pdf, and

http://www.wipo.int/edocs/mdocs/sct/en/sct_27/sct_27_8-annex1.doc, respectively.