

WIPO General Assembly

Forty-Ninth (23rd Ordinary) Session
Geneva, October 2 to 11, 2017

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 as an administrator of cases as well as a provider of legal and organizational expertise in alternative dispute resolution (ADR).
2. This document also provides an update on the domain name-related activities of WIPO, as previously reported in WO/GA/48/12 Rev.¹ 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, including rights protection mechanisms (RPMs) for the introduction of new generic top-level domains (gTLDs), the planned revision by the Internet Corporation for Assigned Names and Numbers (ICANN) of the Uniform Domain Name Dispute Resolution Policy (UDRP) and other RPMs, 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 IP DISPUTES

A. ARBITRATION AND MEDIATION CASE ADMINISTRATION

3. The mediation and arbitration procedures offered by the Center aim to meet parties' needs for time- and cost-effectiveness in the resolution of disputes in relation to IP rights. The Center is engaged in the management and resolution of cases conducted under those

¹ See http://www.wipo.int/edocs/mdocs/govbody/en/wo_ga_48/wo_ga_48_12_rev.pdf.

procedures, which entails training,² appointing, and supporting qualified arbitrators and mediators, and maintaining up-to-date case administration infrastructure, including through the use of information technology such as the WIPO Electronic Case Facility (ECAF).³ WIPO cases in the past year included those related to patents, trademarks, copyright (including collecting societies), ICT, research and development (R&D), life sciences, film and media (including television format-related disputes), and distribution and franchising, and were filed with the Center by parties on the basis of prior contract clauses, submission agreements (including court referrals), and also by unilateral request under Article 4 of the WIPO Mediation Rules. More than half of the parties to such cases are users of WIPO's PCT and Madrid services. Some 70 per cent of WIPO mediations result in settlement, and at a settlement rate of 40 per cent, even referral to WIPO arbitration can stimulate agreement between the parties.

4. The Center has recently undertaken several initiatives to further facilitate access to potential users of WIPO ADR. These include publication of an article-by-article Commentary on the WIPO Arbitration Rules, and an updated online clause generator that allows parties to build core clauses and submission agreements, with the possibility of selecting additional considerations to suit particular needs.⁴ The Center has also produced an online fee calculator, which enables current and prospective parties to estimate fees and costs for mediation, arbitration, expedited arbitration or expert determination cases filed with WIPO.⁵ Parties with experience in IP disputes named the Center (55%) as their second most used institution behind the International Court of Arbitration (ICC) (59%) in a 2016 survey carried out by the School of International Arbitration (SIA), Queen Mary University of London, on resolving international technology, media and telecoms disputes. Where survey respondents expressed a preference for an institution, the Center ranked first.⁶

B. ADR SERVICES FOR SPECIFIC SECTORS

(a) Collaboration with Intellectual Property Offices (IPOs)

5. Additional to its more traditional services, the Center assists IPOs in their establishment of optional ADR frameworks, the organization of training programs and promotional activities, as well as case administration. These collaborations highlight cost-effective and flexible options for parties to resolve IP disputes, which may include disputes before IPOs in relation to pending applications or granted rights.⁷

6. In the past year, the Center administered several cases arising from the establishment in 2011 of a joint dispute resolution procedure to facilitate the mediation of trademark oppositions at the Intellectual Property Office of Singapore (IPOS). The Center also started administering cases following its designation by the Intellectual Property Office of the Philippines (IPOP HL) in 2015 as an administrator for parties to mediation cases submitted with IPOP HL involving one or more parties domiciled outside the Philippines. Further to the conclusion of an agreement with the Mexican Institute of Industrial Property (IMPI), the Center and IMPI organized an event promoting the use of ADR for IP disputes.

7. The Trademark Trial and Appeal Board (TTAB) and the Patent Trial and Appeal Board (PTAB) of the United States Patent and Trademark Office (USPTO) encourage parties to consider ADR as a means of settling issues raised in Board proceedings. Since January 2016,

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 See <http://www.wipo.int/amc-apps/clause-generator/>.

⁵ See <http://www.wipo.int/amc/en/calculator/adr.jsp>.

⁶ See http://www.wipo.int/amc/en/new/2016_qmsurvey.html.

⁷ See <http://www.wipo.int/amc/en/center/specific-sectors/ipos/>.

the Center is listed as one of the available dispute resolution service providers for TTAB and PTAB proceedings.

8. In 2017, IP Australia and the Center launched an initiative to provide ADR options for resolving IP and technology disputes in Australia. To this end, the Center now makes available to interested parties online communication options, including ECAF and videoconferencing facilities. The Center also established collaboration with the Israel Patent Office (ILPO) to promote the use of ADR options for IP and technology disputes in Israel.

9. The Center is currently updating the WIPO Guide on Alternative Dispute Resolution for IPOs and Courts to reflect recent developments in this field.⁸ Informed by WIPO experience in this area, this Guide provides a broad overview of ADR for IP disputes and presents options for interested IPOs and courts to integrate ADR into their existing processes. The Guide includes an overview of the Center's collaborations with IPOs and related model documents.

(b) R&D Dispute Resolution

10. Following prior engagement with European R&D stakeholders,⁹ German institutions,¹⁰ and Austrian entities,¹¹ the Center continued to provide assistance in the development of Model Agreements that seek to facilitate an efficient transfer of knowledge and technology. This includes further collaboration with the Spanish Patent and Trademark Office (OEPM) in the development of Model R&D Agreements that offer WIPO Mediation and WIPO Expedited Arbitration options, as well as related user guides.¹² During the period, the Federal Ministry for Economy and Energy, Germany, issued an updated edition of its "Sample agreements for research and development cooperation – Guidelines for cooperation between the academic sector and industry" which recommend WIPO Mediation followed, in the absence of a settlement, by WIPO Arbitration.

11. In late 2016, the WIPO Technology and Innovation Support Center (TISC) program and the Center began cooperation in bringing procedural and practical information on IP ADR services to the attention of participating innovators in developing countries. In mid-2017, the International Federation of Inventors' Associations (IFIA) commenced informing its members about WIPO ADR options to settle disputes arising from collaborations established with other parties.¹³

(c) Franchising Dispute Resolution

12. As part of WIPO ADR Services for Specific Sectors, and noting a growing caseload relating to disputes in the area of franchising and distribution agreements, the Center provides tailored advice and case administration services to help parties resolve such disputes. Notably, the Center cooperates with the Brazilian Franchising Association (ABF), Franchising and Licensing Association Singapore (FLA), the Spanish Franchisors Association (AEF), and the Swiss Franchise Association (SFA) to raise awareness of ADR options available to stakeholders.

⁸ The current Guide is available at <http://www.wipo.int/export/sites/www/amc/en/docs/adrguidejuly2015.pdf>.

⁹ One such example involves multi-party collaborations funded under the European Union's research funding program Horizon 2020, where entities use the DESCA 2020 model consortium agreement, which recommends WIPO Mediation followed, in the absence of settlement, by WIPO Expedited Arbitration. See <http://www.desca-2020.eu/>.

¹⁰ See <http://www.bmw.de/English/Redaktion/Pdf/sample-agreements-for-research-and-development-cooperation,property=pdf,bereich=bmwi,sprache=en,rwb=true.pdf>.

¹¹ See <http://www.wipo.int/amc/en/center/specific-sectors/rd/ipag/>.

¹² The Model Agreements are available at

http://www.oepm.es/es/propiedad_industrial/transferecia_de_tecnologia/Modelos_de_Contratos/index.html.

¹³ See <https://www.ifia.com/news/alternative-dispute-resolution/>.

II. DOMAIN NAME CASE ADMINISTRATION

A. UDRP

13. 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 First¹⁴ and Second¹⁵ WIPO Internet Domain Name Processes. Through the Center, WIPO provides trademark owners with efficient international mechanisms to deal with the bad-faith registration and use of domain names corresponding to their trademark rights. The principal mechanism administered by the Center, the UDRP, was adopted by ICANN on the basis of recommendations made by WIPO in the First WIPO Process.

14. Limited to clear cases of bad faith, the UDRP has proven in high demand for trademark owners.¹⁶ Since December 1999, the Center has administered over 38,000 UDRP-based cases.¹⁷ Trademark holders in 2016 filed 3,036 UDRP-based complaints with the Center, an increase of 10 per cent over 2015 filing, and the first time that WIPO domain name case filings have surpassed 3,000 in one year. As of June 2017, the total number of domain names in WIPO UDRP-based cases surpassed 70,000.

15. A diverse mixture of enterprises, institutions, and individuals used the Center's dispute resolution procedures in 2016. The top sectors for complainant business activity were Banking and Finance, Fashion, Heavy Industry and Machinery, Internet and Information Technology, Biotechnology and Pharmaceuticals and Retail. Especially the filings related to consumer-facing brands include those by rights owners alleging counterfeiting *via* the web pages offered under the disputed domain name. Reflecting the global scope of this dispute mechanism, named parties to WIPO cases through 2016 represented 178 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 21 languages.¹⁸

16. All WIPO UDRP panel decisions are posted on the Center's website. In 2017, the Center published the Third Edition of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions (WIPO Overview 3.0),¹⁹ a globally-consulted online overview of broad decision trends on important case issues. Now covering over 100 topics, the present overhaul includes reference to almost 1,000 representative decisions from over 265 WIPO Panelists. The increased scope of WIPO Overview 3.0 since publication of version 2.0 in 2011 reflects a range of DNS and UDRP case evolutions in the near doubling of cases managed by the Center since then. The WIPO Overview is instrumental in developing and maintaining consistency of WIPO UDRP jurisprudence. To facilitate access to these decisions according to subject matter, the

¹⁴ 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>.

¹⁵ 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>.

¹⁶ The UDRP does not prevent either party from submitting a dispute to a competent court of justice; however, very few cases that have been decided under the UDRP have been brought before a national court of justice. See Selected UDRP-related Court Cases at <http://www.wipo.int/amc/en/domains/challenged>.

¹⁷ The Center makes available online real-time statistics to assist WIPO UDRP case parties and neutrals, trademark attorneys, domain name registrants, domain name policy makers, the media, and academics. Available statistics cover many categories, such as “areas of complainant activity”, “domain name script”, and “25 most cited decisions in complaint”. See <http://www.wipo.int/amc/en/domains/statistics>.

¹⁸ In alphabetical order, Chinese, Czech, Danish, Dutch, English, French, German, Hebrew, Italian, Japanese, Korean, Norwegian, Polish, Portuguese, Romanian, Russian, Slovak, Spanish, Swedish, Turkish, and Vietnamese.

¹⁹ See <http://www.wipo.int/amc/en/domains/search/overview3.0/>.

Center also offers an online searchable Legal Index of WIPO UDRP Decisions.²⁰ These WIPO resources are accessible globally free of charge.

17. Mindful of WIPO's foundational role in the UDRP, the Center monitors developments in the DNS with a view to adjusting its resources and practices.²¹ The Center regularly organizes Domain Name Dispute Resolution Workshops to update interested parties,²² as well as meetings of its Domain Name Panelists.

B. COUNTRY CODE TOP-LEVEL DOMAINS (ccTLD)

18. While the mandatory application of the UDRP is limited to domain names registered in gTLDs (such as .com) and more recently introduced new gTLDs, the Center also assists ccTLD registries in their establishment of registration conditions and dispute resolution procedures that conform with best practices in registry management and IP protection. These procedures are mostly modeled after the UDRP, but may take account of the particular circumstances and needs of individual ccTLDs. Following discussions with European registry manager EURid, from June 2017 the Center provides services for .eu and .eu (cyrillic script) registrations, in all 24 official EU languages.²³ With the addition of this regional registry, the Center currently provides domain name dispute resolution services to 75 ccTLD registries.²⁴

III. POLICY DEVELOPMENTS IN THE DNS

19. 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 introduction of up to 1,400 new gTLDs. Such new gTLDs may be of an "open" nature (similar to .com), or may take on more specific or restrictive characteristics, for example taking the form of .[brand], .[city], .[community], .[culture], .[industry], or .[language]. An important related development concerns the introduction of Internationalized Domain Names (IDNs) at the top level. Also, ICANN's envisaged expansion of the DNS raises rights protection questions in connection with the Second WIPO Process.

A. NEW GTLDS

20. ICANN implementation of its New gTLD Program formally approved in June 2011²⁵ is detailed in its much-revised "Applicant Guidebook".²⁶ Delegation of the first new gTLDs into the Internet's Root Zone took place in October 2013, with over 1,200 more gTLDs delegated by June 2017.²⁷

²⁰ See <http://www.wipo.int/amc/en/domains/search/legalindex/>.

²¹ See, e.g., WO/GA/41/17 Rev.2, paragraphs 14 to 16. In 2015, the Center implemented a new practice concerning the "locking" of domain names to prevent so-called "cyberflight" in UDRP proceedings.

²² See footnote 2, *supra*.

²³ See <http://www.wipo.int/amc/en/new/eu.html>.

²⁴ 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>.

²⁵ 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.

²⁶ ICANN's Applicant Guidebook is available at <http://newgtlds.icann.org/en/applicants/agb>.

²⁷ Delegated new gTLDs are listed at <http://newgtlds.icann.org/en/program-status/delegated-strings>.

21. The Center remains committed to working with stakeholders to attempt to safeguard the observance of general principles of IP protection in new gTLDs. A number of the RPMs have emerged from a series of ICANN committees and processes for new gTLDs.²⁸ Set out below is a broad description of these ICANN RPMs, for the top level and the second level respectively.

(a) Top Level RPMs

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

22. This mechanism allowed trademark owners to lodge Legal Rights Objections (LRO) to new gTLD applications at the top level where certain substantive criteria were met.²⁹ The Center assisted ICANN in the establishment of these criteria on the basis of the “WIPO Joint Recommendation Concerning Provisions on the Protection of Marks, and Other Industrial Property Rights in Signs, on the Internet”.³⁰

23. Appointed by ICANN as the exclusive provider of LRO dispute resolution services,³¹ the Center received 69 compliant LRO filings, which it completed processing by September 2013.³² All WIPO LRO expert panel determinations are available on the Center’s website,³³ as is a Center report on the LRO process.³⁴

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

24. In early 2009, the Center communicated to ICANN a concrete substantive proposal for 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.³⁵ 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.³⁶

²⁸ For further background including references, see WO/GA/39/10, in particular paragraphs 23 to 30. It is noted here that ICANN rejected a proposal for a “Globally Protected Marks List”.

²⁹ Other objection grounds recognized by ICANN were: “String Confusion Objections”, “Community Objections”, and “Limited Public Interest Objections”. The Applicant Guidebook further includes a number of other procedures which governments could 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.

³⁰ Adopted by the WIPO General Assembly in September 2001; see

<http://www.wipo.int/edocs/pubdocs/en/marks/845/pub845.pdf>.

³¹ See section 3.2 of the ICANN Applicant Guidebook at

<http://newgtlds.icann.org/en/applicants/agb/objection-procedures-04jun12-en.pdf>.

³² See WIPO Rules for New gTLD Dispute Resolution, and Schedule of Fees and Costs, respectively at

<http://www.wipo.int/amc/en/docs/wipolrules.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/>.

³³ See <http://www.wipo.int/amc/en/domains/lro/cases/>.

³⁴ The WIPO LRO report notes that an overwhelming majority of LROs were filed against applications for gTLD strings with descriptive or dictionary meaning. Many expert panels concluded that where a trademark owner has adopted a common dictionary term as a trademark, a gTLD application intended solely to take advantage of such common dictionary meaning would not as such violate the decision standards for LROs. In certain cases panels addressed trademark registrations that were primarily obtained for the purpose of supporting an application for a new gTLD and/or LRO, with little or no demonstrable prior use. See <http://www.wipo.int/amc/en/docs/lroreport.pdf>.

³⁵ See <http://www.wipo.int/amc/en/docs/icann130309.pdf>.

³⁶ 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>).

25. Following various ICANN processes, including 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. In light of broader policy interests, the Center in 2013 agreed with ICANN to become a provider for the trademark PDDRP.

(b) Second Level RPMs

(i) Trademark Clearinghouse (TMCH)

26. ICANN's New gTLD Program includes a TMCH as a centralized repository of authenticated trademark data which could be invoked as the basis for filing under new gTLD RPMs.³⁷ The Center has commented that the TMCH 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 relevant, practical measures may be envisaged to identify any allegedly inappropriate invocation of rights in specific contexts. According to available information, it appears that through March 2017, the TMCH had received over 42,000 entries.³⁸

(ii) Uniform Rapid Suspension (URS) System

27. 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.³⁹

28. Having evolved from a sequence of ICANN processes and committees, the URS continues to raise a number of questions, including its relationship to the UDRP.⁴⁰ ICANN invited tenders from prospective URS providers, to which after careful consideration of the ICANN URS model and related resources, the Center has not been in a position to apply.⁴¹ The Center continues to closely monitor developments.

³⁷ The TMCH 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 TMCH 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 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). As mandated by ICANN, the availability of the Claims service is for a period of 90 days after a new gTLD is opened for general public registration, but users of the TMCH can opt-in to receive notifications indefinitely. 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 herein.

³⁸ See <http://trademark-clearinghouse.com/content/tmch-stats>.

³⁹ The Center for its part communicated to ICANN in April 2009 a discussion draft of an "Expedited (Domain Name) Suspension Mechanism", (See <http://www.wipo.int/amc/en/docs/icann030409.pdf>) and has made subsequent proposals for a streamlined mechanism based on this model at ICANN Meetings (see <http://prague44.icann.org/node/31773> and <http://toronto45.icann.org/node/34325>). Such proposals took account of the need to strike a 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.

⁴⁰ An extensive inventory of these issues is provided *inter alia* in the Center's letter to ICANN of December 2, 2010, available at <http://www.wipo.int/amc/en/docs/icann021210.pdf>.

⁴¹ The question of accreditation of providers gives rise to concerns as to the stability of RPMs; WIPO raised concerns about this as early as 2007 in the context of the UDRP (see <http://www.wipo.int/amc/en/docs/icann040707.pdf>).

B. ICANN'S PLANNED REVISION OF THE WIPO-INITIATED UDRP AND OTHER RPMS

29. 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 in 2011 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 as a registration-driven body,⁴² a decision was taken by ICANN's Generic Names Supporting Organization (GNSO) to review the UDRP following the launch of new gTLDs. ICANN's Preliminary Issue Report on this topic was issued in October 2015 describing a range of complex substantive and process-related questions.⁴³ In this regard, the Center provided observations highlighting both the UDRP's long-proven success and the risks associated with any attempted ICANN revision of the UDRP. Following a public comment period, ICANN issued its Final Issue Report in January 2016 recommending that the GNSO launch a Policy Development Process (PDP) to review all RPMS in two phases; the initial phase is now focusing on RPMS developed for the New gTLD Program, notably the TMCH (including "Sunrise" and "Claims" RPMS) and URS, whereas the second phase will focus on the UDRP.⁴⁴ This is a matter of serious concern, and the Center continues to closely follow ICANN stakeholders' intentions with regard to the UDRP and trademark RPMS generally. In this effort, the Center where relevant is in contact with trademark stakeholders such as INTA and MARQUES.

C. IDNS

30. As noted in paragraph 22, another significant policy development in the DNS is the introduction of IDNs (non-Latin script) at the top level.⁴⁵ Many of these were among the first new gTLDs announced by ICANN for delegation in the DNS root zone.

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.

(a) International Governmental Organizations (IGOs)

32. It is recalled that the First WIPO Process addressed the relationship between domain names and trademarks. The Second WIPO Process concerned the relationship between domain names and other types of identifiers that had not been addressed, including country names and IGO names and acronyms.

33. The 2002 WIPO General Assembly recommended amending the UDRP in order to provide protection for country names and for the names and acronyms of IGOs.⁴⁶ The WIPO Secretariat transmitted these recommendations to ICANN in February 2003.⁴⁷

⁴² See <https://community.icann.org/display/gnsoudrpd/Webinar+on+the+Current+State+of+the+UDRP>; see also more generally document WO/GA/39/10, paragraph 31.

⁴³ See <http://gnso.icann.org/en/issues/new-gtlds/rpm-prelim-issue-09oct15-en.pdf>.

⁴⁴ See <https://gnso.icann.org/en/issues/new-gtlds/rpm-final-issue-11jan16-en.pdf>.

⁴⁵ See also ICANN's Final Implementation Plan for IDN ccTLD Fast Track Process published in November 2009 (see <https://www.icann.org/en/system/files/files/idn-ccTld-implementation-plan-16nov09-en.pdf>). Since then, this has allowed for the introduction of IDN ccTLDs, associated with the two-letter codes in the ISO 3166-1 standard (see http://www.iso.org/iso/english_country_names_and_code_elements).

⁴⁶ 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.

⁴⁷ See <http://www.wipo.int/amc/en/docs/wipo.doc>.

34. Following ICANN deliberations,⁴⁸ ICANN's New gTLD Applicant Guidebook limited its consideration of the protection of IGO names and acronyms to providing recourse through the pre-delegation objection procedure concerning the top level (*i.e.*, an applied-for TLD), discussed in paragraphs 22 and 23. However, following sustained IGO efforts, ICANN's Governmental Advisory Committee (GAC) advised the ICANN Board that IGO identifiers should be granted protection against inappropriate third-party registration prior to the delegation of any new gTLDs.⁴⁹ The GAC further advised the ICANN Board that, building on existing criteria for ".int" second-level registrations, it would collaborate with IGOs to develop a list of IGO names and acronyms to be protected against registration for at least the current round of new gTLDs. The GAC also advised the Board that pending implementation work, interim protection for IGO names and acronyms should be provided through a moratorium on third-party registration; while progress has been made on implementation, this moratorium remains in place.

35. The ICANN Board responded to the GAC indicating that it had adopted a resolution for interim protection at the second level based on the existing .int criteria, *via* an ICANN reserve list of IGO identifiers, to be withheld from third-party registration through the new gTLD Registry Agreement. ICANN invited qualifying IGOs to identify themselves to ICANN, 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 advised protection.⁵⁰ 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 in February 2013. This was followed by a GAC communication to the ICANN Board concerning IGO protection eligibility criteria,⁵¹ together with a list of protectable IGO names and acronyms.⁵²

36. On April 1, 2013, the Board expressed concerns to the GAC on how to reconcile protection of IGO acronyms with certain potentially legitimate third-party attempts to register corresponding domain names and asked how cases of potentially legitimate co-existent use of such acronym could be managed in practice.⁵³ In July 2013, following further discussions with ICANN and sustained efforts from IGOs, the GAC issued advice to the ICANN Board that highlighted the need for special preventative protection for IGO names and acronyms in the DNS.⁵⁴ Following this advice, the ICANN Board issued a resolution extending interim protection for IGOs until the first meeting of the ICANN Board's New gTLD Program Committee (NGPC) after the November 2013 ICANN meeting.⁵⁵

37. In October 2013 the NGPC made a proposal for protection of IGO acronyms at the second level that fell short of providing IGO acronyms with the permanent preventative protection envisaged in previous GAC Communiqués.⁵⁶

⁴⁸ For background, see WO/GA/41/17 Rev.2, in particular paragraphs 40 and 41.

⁴⁹ See

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

⁵⁰ See <https://www.icann.org/en/system/files/correspondence/crocker-to-dryden-16jan13-en.pdf>.

⁵¹ Such criteria comprise treaty-based IGOs with international legal personality, or which are UN Observers, or which are funds or programs of the UN.

⁵² See <http://www.icann.org/en/news/correspondence/dryden-to-crocker-chalaby-22mar13-en>.

⁵³ The Board also sought further specifics on means for periodic review of the list, along with clarification of any additional languages in which protection of IGO names and acronyms is sought. See <http://www.icann.org/en/news/correspondence/crocker-to-dryden-01apr13-en>.

⁵⁴ The GAC further advised that it expressly assumed that the ICANN Board was prepared to fully implement the GAC advice and focus on practical and effective implementation of preventative protection at the second level in new gTLDs, and that the interim protections for IGO names and acronyms should remain in place until the dialogue between the GAC, ICANN and IGOs was completed. See

<http://durban47.icann.org/meetings/durban2013/presentation-gac-communique-18jul13-en.pdf>.

⁵⁵ See <https://www.icann.org/resources/board-material/resolutions-new-gtld-2013-07-17-en#1.a>.

⁵⁶ The GAC and the NGPC had cancelled their participation in a September 30 meeting proposed by IGOs.

38. In parallel to the policy efforts undertaken by the NGPC, the GAC, and IGOs,⁵⁷ the GNSO had launched a PDP concerning IGO protection, in which process the Center with other IGO representatives participated. Over IGO objections, this GNSO process largely rejected preventative protection for IGO acronyms at the second level. Instead, it recommended curative protection mechanisms for IGO acronyms, coupled with the removal of the temporary protections for IGO acronyms in place. These recommendations were adopted unanimously by the GNSO Council in November 2013. In April 2014, the ICANN Board resolved to adopt the GNSO Council recommendations not in conflict with GAC advice, namely reserving from registration the full names of IGOs at the top and second levels in two languages.

39. Despite GAC advice and IGO positions, in June 2014, the GNSO Council voted to initiate a second PDP on the desirability and modalities of giving IGOs access to curative RPMs (such as the UDRP or URS) to address abusive registration of IGO acronyms, or of IGO full names not covered by the aforementioned exclusion. Notwithstanding continuing discussions, including at ICANN's June and November 2016 meetings, questions remain as to the specifics of such RPMs; it has again been affirmed by the GAC however that any IGO-specific RPM should not amend the existing UDRP. Together with other involved IGOs, the Center continues to closely monitor developments in this longstanding ICANN file, with the Board now facilitating further dialogue on the differences between GAC Advice and GNSO recommendations as to IGO-related RPMs.

(b) Geographical Terms

40. Concerning geographical terms, the GAC in particular has expressed concerns about their use and protection in the new gTLDs.⁵⁸ Concerning the top level,⁵⁹ ICANN's Applicant Guidebook provides that "applications for strings that are country or territory names will not be approved, as they are not available under the New gTLD Program in this application round."⁶⁰ Applied-for strings which are considered by ICANN to be certain other geographical names, e.g., capital city names, should be accompanied by documentation of support or non-objection from the relevant governments or public authorities.⁶¹

41. GAC members have expressed further reservations regarding a number of new gTLD applications on grounds of correspondence to geographical or other "sensitive" terms, advising the ICANN Board not to proceed beyond initial evaluation, and seeking Board clarification on scope for applicants to modify their new gTLD applications to address specific GAC concerns.⁶²

⁵⁷ For a more complete summary see document WO/GA/48/12 Rev., paragraphs 42 to 45.

⁵⁸ In 2007, the GAC issued the "GAC Principles regarding New gTLDs", 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. See <https://archive.icann.org/en/topics/new-gtlds/gac-principles-regarding-new-gtlds-28mar07-en.pdf>.

⁵⁹ 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. See <http://newgtlds.icann.org/en/applicants/agb/base-agreement-specs-04jun12-en.pdf> at Specification 5.

⁶⁰ See <http://newgtlds.icann.org/en/applicants/agb/evaluation-procedures-04jun12-en.pdf>, from section 2.2.1.4.1 "Treatment of Country or Territory Names".

⁶¹ See <http://newgtlds.icann.org/en/applicants/agb/evaluation-procedures-04jun12-en.pdf>, from section 2.2.1.4.2 "Geographic Names Requiring Government Support".

⁶² See <https://www.icann.org/en/system/files/correspondence/gac-to-board-27mar14-en.pdf>, at "4. Specific Strings". 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, on a range of additional safeguards sought by the GAC concerning several broad categories of new gTLD applications such as for those new gTLDs which correspond to regulated industries or dictionary terms. See <https://www.icann.org/en/system/files/correspondence/gac-to-board-11apr13-en.pdf>. A GAC Sub-group on Geographic Names (a Sub-group of the GAC Working Group on Future New gTLDs) has developed a draft document for future New gTLD rounds outlining several public policy aspects related to

42. In December 2016, ICANN authorized the release of all previously-reserved 2-character domain names at the second level in new gTLDs provided that registry operators first allow respective governments a thirty-day period to acquire such domain names; require registrants to represent that they would not falsely imply government affiliation in connection with the use of such 2-character domain name; and provide a means for post-registration complaints.⁶³ In this context, the Center submitted comments to ICANN noting that the Second WIPO Process considered the possibility of exploring measures for the UDRP to apply to third-level registrations in order to mitigate the potential for trademark abuse.⁶⁴

43. On these and other DNS-related issues, the Center has endeavored to apprise relevant sectors within the Secretariat, including in support of the work of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT).⁶⁵ The Secretariat will continue to monitor these developments and provide input where possible.

44. The WIPO General Assembly is invited to take note of the document "WIPO Arbitration and Mediation Center, Including Domain Names" (document WO/GA/49/14).

[End of document]

[Footnote continued from previous page]

geographic names which is currently subject to further ICANN discussions. See <https://gacweb.icann.org/download/attachments/27132037/Geo%20names%20in%20new%20gTLDs%20Updated%20%20V3%20%2029%20august%202014%5B4%5D.pdf?version=1&modificationDate=1411549935000&api=v2>.

⁶³ Together these comprise ICANN's so-called "confusion mitigation" plans. See

<https://www.icann.org/en/system/files/files/two-character-ltr-ltr-authorization-release-13dec16-en.pdf>.

⁶⁴ See <https://forum.icann.org/lists/comments-proposed-measures-two-char-08jul16/pdfECmcS9knuk.pdf>.

⁶⁵ See e.g., documents SCT/24/4, SCT 25/3, SCT 26/6 and 27/8. See also meeting SCT/IS/GEO/GE/17.