

## **WIPO General Assembly**

### **Fifty-Sixth (26<sup>th</sup> Ordinary) Session** **Geneva, July 6 to 14, 2023**

#### **WIPO ARBITRATION AND MEDIATION CENTER, INCLUDING DOMAIN NAMES**

*Document prepared by the Secretariat*

1. The WIPO Arbitration and Mediation Center (“Center”) forms part of the IP and Innovation Ecosystems Sector (IES). In coordination with other WIPO Sectors, IES is responsible for helping Member States develop their intellectual property (IP) and innovation ecosystems to drive enterprise and economic growth.
2. Within this framework, the present document provides an update on the Center’s activities as an international resource for time- and cost-efficient alternatives to court litigation of IP and technology disputes, acting as an administrator of cases as well as a provider of legal and organizational expertise in alternative dispute resolution (ADR).
3. This document also provides an update on the domain name-related activities of WIPO, as previously reported in *WO/GA/55/10*.<sup>1</sup> 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 impending review 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.

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<sup>1</sup> See [https://www.wipo.int/about-wipo/en/assemblies/2022/a-63/doc\\_details.jsp?doc\\_id=572909](https://www.wipo.int/about-wipo/en/assemblies/2022/a-63/doc_details.jsp?doc_id=572909).

## I. MEDIATION AND ARBITRATION OF IP DISPUTES

### A. CASE ADMINISTRATION

4. The mediation and arbitration procedures offered by the Center aim to meet parties' needs for time- and cost-effectiveness in the resolution of IP and technology disputes. The Center is engaged in the management of cases under those procedures, which includes procedural guidance<sup>2</sup>, training,<sup>3</sup> appointing and supporting qualified mediators and arbitrators, and maintaining up-to-date case infrastructure. Cases are filed with the Center on the basis of a prior contract clause or, increasingly, a post-dispute submission agreement (including court referrals), and also by unilateral request under Article 4 of the WIPO Mediation Rules.<sup>4</sup>

5. During the period, large companies, small- and medium-sized enterprises (SMEs),<sup>5</sup> universities and research organizations, collective management organizations (CMOs), and innovators and creators, from 51 countries used the Center's mediation, arbitration and Good Offices services. The Center noted a 105 per cent increase in its caseload in 2022, corresponding to a total of 548 requests, and further growth in the first quarter of 2023. New cases under the WIPO Mediation, Arbitration, and Expedited Arbitration Rules (WIPO Rules) involved Research and Development (R&D) agreements including consortium agreements, patent, trademark and copyright licensing, geographical indications, copyright collective management, software development and licensing, sponsorship and advertisement agreements, as well as infringement and unfair competition cases, including cases pending before national courts.<sup>6</sup> The main business sectors were creative industries, information and telecommunications technology (ICT), life sciences, and mechanical processes/equipment.

6. Mindful of the parties' needs for time- and cost-efficiency, the Center undertook initiatives to further streamline the conduct of WIPO ADR proceedings. To add efficiency to their arbitration proceedings, many parties used the Center's enhanced WIPO eADR electronic case facility.<sup>7</sup> In addition, most arbitration hearings and mediation meetings continued to be conducted remotely or in hybrid format using WIPO-hosted facilities.<sup>8</sup>

7. The Center also provides tailored ADR services for specific sectors.<sup>9</sup> One example is the Center's services for disputes concerning FRAND terms for standard-essential patents

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<sup>2</sup> The Center provides procedural assistance (Good Offices) to parties involved in an IP or technology dispute, in order to facilitate direct settlement between them or the submission of their dispute to WIPO mediation or arbitration, as alternatives to court litigation. See <https://www.wipo.int/amc/en/goodoffices/index.html>.

<sup>3</sup> All workshops and other events organized by the Center are listed at <https://www.wipo.int/amc/en/events>.

<sup>4</sup> The Center makes available recommended model clauses and submission agreements, as well as an online clause generator that allows parties to build core clauses and submission agreements. See <https://www.wipo.int/amc/en/clauses/index.html> and <https://amc.wipo.int/clause-generator/>.

<sup>5</sup> SMEs, including start-ups, creators and innovators, overall represent about half of the parties involved in WIPO mediations and arbitrations. The Center offers reduced administration and registration fees in cases involving SMEs. See <https://www.wipo.int/amc/en/center/specific-sectors/smes/>.

<sup>6</sup> Specific legal issues included patent, trademark, and copyright infringement, patent exhaustion, patent co-ownership, patent pools, appropriate patent licensing terms, including the determination of fair, reasonable and non-discriminatory (FRAND) terms, breach of contract, royalty adjustments and payments, trademark co-existence agreements, copyright licensing terms, removal of content from online platforms, specific performance including withdrawal of a legal action, damage claims, and trademark oppositions pending before IP Offices.

<sup>7</sup> WIPO eADR enables parties and neutrals to share and access all case-related submissions through a single and secure portal. See <https://www.wipo.int/amc/en/eadr/>. In the period, WIPO's eADR facility is also used by the America's Cup Arbitration Panel in the course of the 37<sup>th</sup> edition of the America's Cup sailing race series. See <https://www.wipo.int/amc/en/center/background.html>.

<sup>8</sup> To assist parties and neutrals in the preparation of such remote meetings and hearings, the Center continued to update the WIPO Checklist for the Online Conduct of Mediation and Arbitration Proceedings. See <https://www.wipo.int/amc/en/eadr/checklist/index.html>.

<sup>9</sup> The Center's website provides a full overview of the range of these services. See <https://www.wipo.int/amc/en/center/specific-sectors/>.

(SEPs).<sup>10</sup> To date, the Center has administered some 70 SEP-related mediations involving SMEs, patent pools and large companies, with parties from over 20 jurisdictions. Reflecting this growing case experience, including cases pending before multiple courts, the Center published in 2022 updated guidance to further facilitate referral to WIPO mediation and arbitration.<sup>11</sup> During the period, WIPO and the United States Patent and Trademark Office (USPTO) agreed to partner on stakeholder outreach to further raise awareness of WIPO ADR services relating to SEPs.

8. The Center regularly administers life sciences mediation and arbitration cases, with parties across the sector including pharmaceutical, biotech, diagnostics and medical devices companies, as well as R&D institutions. The caseload includes high-value pharma patent and licensing cases, recently also relating to COVID-19 vaccines.<sup>12</sup> In 2022, as part of the WIPO COVID-19 Response Package, the Center developed and launched, in consultation with leading international life sciences and ADR experts, the publication WIPO ADR for Life Sciences Disputes Management and Resolution.<sup>13</sup> It presents new WIPO ADR options and model clauses tailored to life sciences disputes, notably WIPO Mediation to facilitate contract negotiation (deal mediation), which may be particularly useful in the context of medical innovation and collaborations across regions and types of entities.<sup>14</sup>

9. The Center has observed a significant increase in copyright dispute filings over the past year. This trend is notably connected to the Center's co-administration of cases filed with the National Directorate of Copyright of Colombia (DNDA) and the National Institute of Copyright of Mexico (INDAUTOR). During the period, the Center has co-administered over 280 cases under these two schemes. The referral of copyright disputes in the digital environment to WIPO ADR is also rapidly increasing. This has included disputes relating to audiovisual content, music, publishing, software, mobile apps, and video games. The WIPO-MCST Survey Report on the Use of ADR Mechanisms for Business to Business (B2B) Digital Copyright- and Content-related Disputes<sup>15</sup> has been instrumental in informing the Center's efforts to develop best practices for digital copyright- and content-related disputes, while considering relevant legislation and existing contractual practices. The Center's approach aims to promote efficient and effective resolution of disputes in the digital environment, which is critical to maintaining the integrity of online content-sharing services and protecting the rights of content creators and users alike.<sup>16</sup>

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<sup>10</sup> See <https://www.wipo.int/amc/en/center/specific-sectors/ict/frand/>.

<sup>11</sup> See

[https://www.wipo.int/export/sites/www/amc/en/docs/2022/wipo\\_adr\\_options\\_for\\_frاند\\_disputes\\_management\\_resolution.pdf](https://www.wipo.int/export/sites/www/amc/en/docs/2022/wipo_adr_options_for_frاند_disputes_management_resolution.pdf). The publication seeks to assist parties and neutrals to better understand and make use of available dispute resolution options when negotiating or drafting FRAND licensing agreements. It covers key elements that parties may wish to consider to shape the ADR process, notably to address large SEP portfolios in the telecom, Internet of Things, and connected mobility sectors, and to manage time and cost of proceedings. Tailored model submission agreements are also included.

<sup>12</sup> In the period, the Center published an anonymized summary of WIPO life sciences mediation and arbitration case examples, see <https://www.wipo.int/amc/en/center/specific-sectors/lifesciences/>.

<sup>13</sup> See <https://www.wipo.int/publications/en/details.jsp?id=4639>. The publication was launched at the WIPO Seminar of ADR for Life Sciences Dispute Management and Resolution on November 29, 2022, with speakers representing industry, tech transfer offices, public health partnerships and WIPO Neutrals, from Africa, Asia, Europe and North America. See [https://webcast.wipo.int/video/OTHER\\_WIPO\\_SEMINAR\\_1\\_2022-11-29\\_PM\\_117643](https://webcast.wipo.int/video/OTHER_WIPO_SEMINAR_1_2022-11-29_PM_117643).

<sup>14</sup> The Center notes a growing use of WIPO mediation and arbitration clauses by life sciences stakeholders. For example, WIPO mediation and arbitration options are included in more than 70 licensing and sub-licensing agreements concluded by the Medicines Patent Pool (MPP), including agreements for specific COVID-19 treatments. See <https://medicinespatentpool.org/progress-achievements/licences>.

<sup>15</sup> See <https://www.wipo.int/amc/en/center/copyright/digitalcopyright/index.html>.

<sup>16</sup> To address this trend, the Center has collaborated with relevant stakeholders to develop best practices for the resolution of user-uploaded content disputes by online content-sharing service providers (OCSSPs). This includes the adaptation of the WIPO Expert Determination Rules as a global procedure and the provision of WIPO model ADR submission agreements tailored to digital copyright- and content-related disputes. See <https://www.wipo.int/amc/en/center/copyright/digitalcopyright>.

## B. COLLABORATION WITH INTELLECTUAL PROPERTY OFFICES AND COURTS

10. Another core area of the Center's activity is the collaboration with IP and Copyright Offices (IPOs) and courts globally.<sup>17</sup> Since the 2022 Assemblies, the Center has entered into 14 new initiatives with IP and judicial authorities in Member States to promote and help introduce time and cost-efficient ADR options for IP and technology disputes outside the courts or other adjudicative bodies.<sup>18</sup> In the period, this included the development of country-tailored information materials for interested parties concerning ADR options, such as on online case administration, assistance in the drafting of ADR clauses in connection with model R&D Agreements, and training and joint events for stakeholders.<sup>19</sup>

11. Some IPOs have developed ADR options, or encourage parties to use such options, in the context of proceedings pending before them, notably trademark opposition proceedings. The Center worked with IPOs in the development of mediation options for such proceedings, and collaborated with IPOs in the administration of cases submitted by parties under such schemes.<sup>20</sup> In the area of copyright, some IPOs now resort to the Center as administrator or co-administrator of pending cases, often involving CMOs or other copyright owners, and users.<sup>21</sup>

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<sup>17</sup> To date, the Center collaborates with 75 IPOs and courts in Algeria, Argentina, Australia, Belarus, Botswana, Brazil, Bulgaria, Canada, Chile, China, Colombia, Costa Rica, Cuba, the Czech Republic, the Dominican Republic, Ecuador, Egypt, El Salvador, the Eurasian Patent Organization (EAPO), France, Georgia, Greece, Guatemala, Hungary, Indonesia, Israel, Italy, Kazakhstan, Kenya, the Republic of Korea, Kyrgyzstan, Lithuania, Mexico, Morocco, New Zealand, Nigeria, Paraguay, the Patent Office of the Cooperation Council for the Arab States of the Gulf (GCC Patent Office), the Philippines, Poland, Qatar, Romania, the Russian Federation, Serbia, Singapore, Slovakia, Spain, Switzerland, United Republic of Tanzania, Thailand, Trinidad and Tobago, Ukraine, the United Kingdom, and the United States of America. See <http://www.wipo.int/amc/en/center/specific-sectors/ipoffices/>.

<sup>18</sup> The National Directorate of Author's Right Office of Argentina (DNDA), the Canadian Intellectual Property Office (CIPO), the National Institute of Industrial Property of Chile (INAPI), the Hainan High People's Court (China), the Ministry of Justice of Egypt, the GCC Patent Office, the National Intellectual Property Center of Georgia (SAKPATENTI), the Hellenic Copyright Organization of Greece (HCO), the Registry of Intellectual Property of Guatemala (RPI), the Intellectual Property Office of New Zealand (IPONZ), the National Institute for the Defense of Competition and Protection of Intellectual Property of Peru (INDECOP), the Ministry of Commerce and Industry of Qatar, the Industrial Property Office of the Slovak Republic (IPO SK), and the USPTO.

<sup>19</sup> For examples of events organized by the Center in collaboration with IPOs see <http://www.wipo.int/amc/en/center/specific-sectors/ipoffices/>.

<sup>20</sup> For example, under its collaboration with the Intellectual Property Office of Singapore (IPOS), the Center has participated in the development of mediation options for IPOS trademark and other proceedings, and an expert determination option for IPOS patent proceedings, and it administers such proceedings, including online case administration tools. Summaries of case examples are available at [https://www.ipos.gov.sg/docs/default-source/protecting-your-ideas/hearings-mediation/mediation-at-ipos-\(emps\).pdf](https://www.ipos.gov.sg/docs/default-source/protecting-your-ideas/hearings-mediation/mediation-at-ipos-(emps).pdf). The Center also collaborates with the Intellectual Property Office of the Philippines (IPOPFL) concerning the administration of mediation proceedings involving IP rights in the Philippines, including recently under the IPOPFL Mediation Outside Litigation scheme, and administers cases referred to WIPO Mediation under these arrangements. The Trademark Trial and Appeal Board (TTAB) and the Patent Trial and Appeal Board (PTAB) of the USPTO encourage parties to consider ADR as a means of settling issues raised in those proceedings; the Center is one of the listed dispute resolution service providers. Under its collaboration with the Polish Patent Office (PPO), the Center participated in the development of a WIPO mediation option that has become available for pending trademark opposition proceedings. Most recently, under the collaboration between the Center and the Moroccan Office of Industrial and Commercial Property (OMPIC), the Center and OMPIC developed a mediation option for IP and technology cases, co-administered by the Center and OMPIC.

<sup>21</sup> For example, the Center has further developed online case administration tools such as videoconferencing and tracking tools to co-administer conciliation proceedings before DNDA Colombia and INDAUTOR Mexico respectively (see <https://www.wipo.int/amc/en/center/specific-sectors/ipoffices/mexico/indautor>). The Center is currently working with additional Member State IPOs, including the Registry of Intellectual Property of Guatemala (RPI), the National Directorate of Intellectual Property of Paraguay (DINAPI), and the Copyright Society of Tanzania (COSOTA) to provide similar services. The Center also collaborates in the promotion and provision of mediation services with the Companies and Intellectual Property Authority of Botswana (CIPA), the HCO, the Kenya Copyright Board (KECOBO), the Nigerian Copyright Commission (NCC), the Ministry of Culture, Sports and Tourism of the

12. Additionally, the Center collaborated with IPOs in the development of R&D model agreements that include options for WIPO mediation and WIPO arbitration.<sup>22</sup>

13. The Center also collaborates with a growing number of courts to facilitate the referral to WIPO mediation of cases where parties are willing to explore settlement, including training for members of the judiciaries and mediators.<sup>23</sup> For example, under the framework collaboration between the Supreme People's Court of China (SPC) and WIPO, the SPC and the Center, in coordination with the WIPO Office in China, collaborate in the area of mediation to help resolve international IP and technology disputes in China.<sup>24</sup> So far, more than 60 international cases pending before courts in Shanghai and Fujian have been referred to the WIPO Arbitration and Mediation Shanghai Service, including trademark, patent, copyright, ICT and other commercial cases, with parties from 13 jurisdictions.<sup>25</sup> Since 2023, the Center also collaborates with the *Tribunal judiciaire de Paris* to facilitate referral to WIPO Mediation of suitable cases pending before the court, and the Center has administered the first cases referred under this scheme.

14. Reflecting the growing scope and nature of these collaborative efforts, the Center published in 2022 an updated version of the WIPO Guide on Alternative Dispute Resolution for IPOs and Courts.<sup>26</sup> The new edition covers tailored public ADR programs developed in collaboration with the Center, involving innovative elements such as administration and co-administration schemes, online case management tools, training and outreach, as well as R&D model agreements including ADR clauses. The Guide also presents options for interested IPOs and courts to integrate ADR, especially mediation, into their processes.

### C. ADR INFORMATION RESOURCES

15. During the reporting period, to meet with increased demand for online ADR resources and training, the Center continued with existing outreach channels, such as its ADR Highlights newsletter and the Center's LinkedIn page,<sup>27</sup> while expanding or opening social and other online avenues for users or potential users of WIPO ADR services.<sup>28</sup> For example, the Center's WIPO ADR Young, launched in 2021, is a networking and training forum for young professionals in the IP and dispute resolution communities, which has so far attracted some 980 members from over 95 countries.<sup>29</sup> The Center also organized activities and participated in events around World IP Day.

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Republic of Korea (MCST), the Korea Copyright Commission (KCC), the Korea Creative Content Agency (KOCCA), the Romanian Copyright Office (ORDA), and the Ministry of Culture and Sports of Spain.

<sup>22</sup> For example, the EU DESCA 2020 Model Consortium Agreement, the Intellectual Property Agreement Guide (IPAG) Model Agreements in Austria, the Sample Agreements for Research and Development Cooperation in Germany, and the model R&D agreements with the Spanish Patent and Trademark Office (OEPM). Most recently, the Baltic Technology Transfer Offices Network Cooperation Agreement, concluded in 2022 in collaboration with WIPO, recommends WIPO Mediation followed, in the absence of a settlement, by court litigation. Also adopted in 2022, the Australia's Higher Education Research Commercialization (HERC) IP Framework Model License and Research Agreements recommend mediation followed, in the absence of a settlement, by court proceedings or WIPO Arbitration. For further information see <https://www.wipo.int/amc/en/center/specific-sectors/rd/>.

<sup>23</sup> See [https://www.wipo.int/amc/en/clauses/national\\_court.html](https://www.wipo.int/amc/en/clauses/national_court.html).

<sup>24</sup> Additional collaboration was commenced following the signing of a Memorandum of Understanding between WIPO and the Shanghai High People's Court in 2021, as well as under cooperation Agreements between the Center and the Fujian High People's Court in December 2022, and the Hainan High People's Court in March 2023.

<sup>25</sup> See caseload summary at <https://www.wipo.int/amc/en/center/specific-sectors/national-courts/china/spc.html>.

<sup>26</sup> The third edition of the Guide is available at [https://www.wipo.int/edocs/pubdocs/en/wipo\\_pub\\_guide\\_adr.pdf](https://www.wipo.int/edocs/pubdocs/en/wipo_pub_guide_adr.pdf).

<sup>27</sup> Subscribers to WIPO ADR Highlights increased to over 8,500; all editions are available at [https://www.wipo.int/newsletters-archive/en/adr\\_highlights.html](https://www.wipo.int/newsletters-archive/en/adr_highlights.html).

<sup>28</sup> For example, in 2022 the Center promoted WIPO ADR services in China using WeChat and in Korean using KakaoTalk.

<sup>29</sup> See <https://www.wipo.int/amc/en/center/wipoadryoung>.

16. Now with over 15,500 followers, the Center's LinkedIn page acts as a platform for the IP, technology, and ADR community to keep current with WIPO ADR developments, events, and publications.<sup>30</sup> The Center also continued its WIPOD – Arbitration and Mediation Matters podcast program, featuring interviews with IP and ADR practitioners.<sup>31</sup>

17. The Center continued to organize and participate in events, including webinars and online WIPO Mediation and Arbitration for IP Disputes Workshops, which are made available to stakeholders with content tailored to their area of interest in a range of languages.<sup>32</sup> Focused topics included digital copyright (including eSports and video games, as well as NFTs and the Metaverse<sup>33</sup>), FRAND disputes, life sciences, and R&D; events also targeted specific audiences, such as SMEs, youth and women. Since the 2022 Assemblies, the Center has organized or participated in over 70 events, with more than 10,200 registrants from 159 countries.

18. Under the WIPO Mediation Pledge for IP and Technology Disputes, signatories and collaborating entities agree to promote mediation as an alternative to court litigation in order to reduce the impact of disputes in innovation and creative processes. Participants now number over 880, including 37 Member State IPOs and ADR industry associations.<sup>34</sup>

## II. DOMAIN NAME CASE ADMINISTRATION

### A. UDRP

19. The DNS raises 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 solutions, notably in the First<sup>35</sup> and Second<sup>36</sup> 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 main mechanism administered by the Center, the UDRP, was adopted by ICANN on the basis of recommendations made by WIPO in the First WIPO Process.

20. With a greater number of people spending more time online during and following the COVID-19 pandemic, infringers have been finding an increasingly target-rich environment. Trademark owners stepped up their brand enforcement on the Internet as they further shift to providing their goods and services through online means. Limited in scope to cases of bad faith, the UDRP has proved in higher demand than ever before.<sup>37</sup> Since

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<sup>30</sup> See <https://www.linkedin.com/showcase/wipo-arbitration-and-mediation-center/?viewAsMember=true>.

<sup>31</sup> See <https://www.wipo.int/podcasts/en/amc>.

<sup>32</sup> To date, Center webinars have been delivered in Chinese, Dutch, English, French, German, Italian, Japanese, Korean, Russian, Spanish, and Swedish. Information on upcoming webinars (and past recordings) is available at <https://www.wipo.int/amc/en/events/webinar.html>.

<sup>33</sup> See the Seventh Session of the WIPO Conversation – Intellectual Property and the Metaverse. [https://www.wipo.int/meetings/en/details.jsp?meeting\\_id=74608](https://www.wipo.int/meetings/en/details.jsp?meeting_id=74608)

<sup>34</sup> See <https://www.wipo.int/amc/en/mediation/pledge.html>.

<sup>35</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>36</sup> The Recognition of Rights and the Use of Names in the Internet Domain Name System – Report of the Second WIPO Internet Domain Name Process, WIPO Publication No. 843, also available at <http://www.wipo.int/amc/en/processes/process2/report>.

<sup>37</sup> 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 court. See Selected UDRP-related Court Cases at <http://www.wipo.int/amc/en/domains/challenged>.

December 1999, the Center has administered over 63,000 UDRP-based cases.<sup>38</sup> Right holders in 2022 filed a record 5,764 UDRP-based complaints with the Center, as businesses reacted to the proliferation of websites used for counterfeit sales, fraud, phishing, and other forms of online trademark abuse. The total number of domain names in WIPO UDRP-based cases passed 113,000. The scope of the risks for consumers can also be seen in the top sectors for complainant business activity, including Banking and Finance, Internet and Information Technology, Retail, Biotechnology and Pharmaceuticals, Fashion, Heavy Industry and Machinery, Food, Beverages and Restaurants, and Entertainment.

21. Cybersquatting – the abusive inclusion of a trademark in a domain name – is a global problem. Named parties to WIPO cases in 2022 covered 132 countries, for a total of 185 since the UDRP's inception. In function of the language of the registration agreement of the domain name at issue, WIPO so far has conducted UDRP proceedings in 23 languages.<sup>39</sup>

22. All WIPO UDRP panel decisions are posted on the Center's website. The Center's free, online WIPO Overview of WIPO Panel Views on Selected UDRP Questions remains a vital and globally-consulted jurisprudential overview of decision trends on important case issues covering 100 topics, including reference to almost 1,000 representative decisions from over 265 WIPO Panelists.<sup>40</sup> To facilitate access to decisions according to subject matter, the Center also offers an online searchable Legal Index of WIPO UDRP Decisions.<sup>41</sup>

23. Mindful of WIPO's foundational role in the UDRP, the Center actively monitors developments in the DNS with a view to adjusting its resources and practices.<sup>42</sup> The Center organizes Domain Name Dispute Resolution Workshops to update interested parties,<sup>43</sup> as well as important meetings of its Domain Name Panelists.

## B. COUNTRY CODE TOP-LEVEL DOMAINS (CCTLDS)

24. While the mandatory application of the UDRP is limited to domain names registered in gTLDs (such as .com), 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.<sup>44</sup> Some ccTLD registries adopt the UDRP directly, while others have adopted UDRP-based procedures that take account of particular circumstances and needs of individual ccTLDs. The Center provides dispute resolution services to over 80 ccTLD registries, most recently having added the .BH and البحرين (Bahrain) and .SN (Senegal) domains.<sup>45</sup>

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<sup>38</sup> The Center makes available a wide range of online real-time statistics to assist WIPO UDRP case parties and neutrals, trademark attorneys, domain name registrants, domain name policy makers, media, and academics. See <http://www.wipo.int/amc/en/domains/statistics>.

<sup>39</sup> In alphabetical order, Chinese, Czech, Danish, Dutch, English, Estonian, French, German, Hebrew, Italian, Japanese, Korean, Norwegian, Polish, Portuguese, Romanian, Russian, Slovak, Spanish, Swedish, Turkish, Ukrainian, and Vietnamese.

<sup>40</sup> See <http://www.wipo.int/amc/en/domains/search/overview3.0/>. The increased scope of WIPO Overview 3.0 reflects a wide range of DNS and UDRP case evolutions. The WIPO Overview is instrumental in developing and maintaining consistency of WIPO UDRP jurisprudence.

<sup>41</sup> See <http://www.wipo.int/amc/en/domains/search/legalindex/>.

<sup>42</sup> In 2018, the Center published informal WIPO guidance for parties on the practical impact of the European Union's General Data Protection Regulation (GDPR) on UDRP proceedings. See paragraphs 35 to 37, *infra*. See also, WO/GA/47/14, paragraph 30, and WO/GA/41/17 Rev.2, paragraphs 14 to 16.

<sup>43</sup> See <https://www.wipo.int/amc/en/events/workshops/2023/domainname.html>.

<sup>44</sup> See <https://www.wipo.int/amc/en/domains/ccTld/>.

<sup>45</sup> Other ccTLDs that have joined in recent years include .AI (Anguilla), .CN and .中国 (China), .EU (European Union), .GE (Georgia), .PY (Paraguay), .SA and السعودية (Saudi Arabia), .SE Sweden, and .UA (Ukraine); the .AC, .IO, and .SH registries adopted a slightly modified version of the UDRP. The full list of ccTLDs that have retained the Center as domain name dispute resolution provider is available at <http://www.wipo.int/amc/en/domains/ccTld/>.

25. For all ccTLDs concerned, the Center offers significantly expanded online party resources, including eligibility criteria for registration, supported characters, and multilingual model pleadings and filing information,<sup>46</sup> as well as summaries of relevant differences between the respective UDRP-based ccTLD policies and the UDRP.<sup>47</sup> This information is summarized in the Guide to WIPO's services for country code top-level domain registries.<sup>48</sup>

### III. POLICY DEVELOPMENTS IN THE DNS

26. 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 a significant number of 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]. A noteworthy element of this growth of the DNS concerns Internationalized Domain Names (IDNs) at the top level – expanding the DNS' linguistic availability. Also, ICANN's expansion of the DNS raises rights protection questions in connection with the Second WIPO Process.

#### A. NEW GTLDS

27. ICANN's implementation of its New gTLD Program, first approved in June 2011,<sup>49</sup> is detailed in its much-revised Applicant Guidebook.<sup>50</sup> Delegation of the first new gTLDs into the Internet's Root Zone took place in October 2013, with nearly all of the unique over 1,200 gTLDs delegated by June 2019.<sup>51</sup> Its further policy work on this topic being substantially concluded, ICANN is commencing the process for another round of new gTLDs.<sup>52</sup>

28. The Center remains committed to working with stakeholders with a view to safeguarding the observance of general principles of IP protection in new gTLDs. A number of the RPMs emerged from a series of ICANN committees and processes for new gTLDs.<sup>53</sup> Set out below is a broad description of these ICANN RPMs, for the top level and the second level respectively.

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<sup>46</sup> For example, the Center's page dedicated to .CH (Switzerland) is now also available in German and Italian, in addition to English, French, and Spanish.

<sup>47</sup> See <http://www.wipo.int/amc/en/domains/cctld/>.

<sup>48</sup> See [https://www.wipo.int/edocs/pubdocs/en/wipo\\_pub\\_1069.pdf](https://www.wipo.int/edocs/pubdocs/en/wipo_pub_1069.pdf).

<sup>49</sup> 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.

<sup>50</sup> ICANN's Applicant Guidebook is available at <http://newgtlds.icann.org/en/applicants/agb>.

<sup>51</sup> Delegated new gTLDs are listed at <http://newgtlds.icann.org/en/program-status/delegated-strings>.

<sup>52</sup> See section 2.a at <https://www.icann.org/en/board-activities-and-meetings/materials/approved-resolutions-regular-meeting-of-the-icann-board-16-03-2023-en>, and also <https://www.icann.org/en/announcements/details/icann-board-moves-to-begin-preparations-for-the-next-round-of-new-gtlds-16-03-2023-en>.

<sup>53</sup> 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".



(a) Top Level RPMs

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

29. 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.<sup>54</sup> 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”.<sup>55</sup> Appointed by ICANN as the exclusive provider of LRO dispute resolution services,<sup>56</sup> the Center processed 69 LRO filings in 2013.<sup>57</sup>

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

30. 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.<sup>58</sup> 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 registry safe-harbors.<sup>59</sup>

31. 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, such as its exclusion of the legal concept of “willful blindness” from the applicable criteria.<sup>60</sup>

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<sup>54</sup> 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.

<sup>55</sup> Adopted by the WIPO General Assembly in September 2001; see <http://www.wipo.int/edocs/pubdocs/en/marks/845/pub845.pdf>.

<sup>56</sup> See section 3.2 of the ICANN Applicant Guidebook at <http://newgtlds.icann.org/en/applicants/agb/objection-procedures-04jun12-en.pdf>.

<sup>57</sup> See WIPO Rules for New gTLD Dispute Resolution, and Schedule of Fees and Costs, respectively at <http://www.wipo.int/amc/en/docs/wipolrorules.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/>. All WIPO LRO expert panel determinations are available on the Center’s website, as is a Center report on the LRO process. 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>.

<sup>58</sup> See <http://www.wipo.int/amc/en/docs/icann130309.pdf>.

<sup>59</sup> 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 of 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>).

<sup>60</sup> Notably in late 2016, a group of brand owners opted to file a Public Interest Commitment Dispute Resolution Procedure (PICDRP) instead of using the available PDDRP. In light of broader policy interests, the Center in 2013 agreed with ICANN to become a provider for the trademark PDDRP. <https://www.icann.org/en/system/files/files/feedback-picdrp-panel-report-14mar17-en.pdf>.

(b) Second Level RPMs(i) Trademark Clearinghouse (TMCH)

32. 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.<sup>61</sup> The Center 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 jurisdictions, and that, if and where relevant, practical measures may be envisaged to identify any allegedly inappropriate invocation of rights in specific contexts. The TMCH has received some 47,000 entries.<sup>62</sup>

(ii) Uniform Rapid Suspension (URS) System

33. While 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.<sup>63</sup> Evolved from a sequence of ICANN processes and committees, the URS continues to raise questions, including its relationship to the UDRP.<sup>64</sup> 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.<sup>65</sup> The Center continues to monitor developments.

## B. ICANN'S REVIEW OF THE WIPO-INITIATED UDRP AND OTHER RPMS

34. Accommodating the dynamic development of the DNS, the UDRP has been offering a highly effective alternative to court litigation for trademark owners, domain name registrants, and registration authorities. ICANN's Generic Names Supporting Organization (GNSO) decided to review the UDRP following the launch of new gTLDs.<sup>66</sup> ICANN's 2015 Preliminary Issue Report describes a range of complex substantive and process questions.<sup>67</sup> The Center provided

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<sup>61</sup> 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.

<sup>62</sup> See <http://trademark-clearinghouse.com/content/tmch-stats>.

<sup>63</sup> 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.

<sup>64</sup> 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>.

<sup>65</sup> The question of accreditation of providers gives rise to concerns as to the stability of RPMs; WIPO raised this issue as early as 2007 in the context of the UDRP (see <http://www.wipo.int/amc/en/docs/icann040707.pdf>).

<sup>66</sup> Despite discussions in 2011 in 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. 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.

<sup>67</sup> See <http://gns0.icann.org/en/issues/new-gtlds/rpm-prelim-issue-09oct15-en.pdf>.

observations highlighting the UDRP's long-proven success and the risks associated with any attempted ICANN revision of the UDRP. Following a public comment period, ICANN published 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 now-concluded initial phase issued a Final Report<sup>68</sup> focused on RPMs developed for the New gTLD Program, notably the TMCH (including "Sunrise" and "Claims" RPMs) and URS and proposing minor changes to such RPMs,<sup>69</sup> and is now in its implementation phase,<sup>70</sup> whereas the second phase is to focus on the UDRP.<sup>71</sup> This latter UDRP phase is in particular 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 stakeholders such as ECTA, INTA, and MARQUES. It is moreover noted that in the June 2022 Communiqué from ICANN 74, the ICANN Governmental Advisory Committee (GAC) recalled that "The GAC received an update on the status of a planned review of the UDRP, and in particular notes reference to section 13.1 of the ICANN Bylaws which calls on and indeed encourages, the Board and constituent bodies to seek advice from relevant public bodies with existing expertise that resides outside of ICANN (notably the World Intellectual Property Organization—WIPO, as author and steward of the UDRP) to inform discussions, and looks forward to further exploring this provision in connection with the UDRP review process."<sup>72</sup>

### C. GDPR AND THE WHOIS DATABASE

35. The European Union's General Data Protection Regulation (GDPR) came into force on May 25, 2018. As stated by the European Commission, the overarching aim of the GDPR is to address privacy and data concerns, whereby these aims must be measured against legitimate third-party interests such as contracts and legal disputes.

36. After May 25, 2018, publicly-available Whois data no longer includes full contact details for the domain name registrant. Such data is generally limited to the "registrant organization" and country.<sup>73</sup> Despite these public limitations, where a UDRP provider has received a UDRP complaint, ICANN-compliant registrars will normally provide Whois information on the request from such provider (and at the same time "lock" the domain name's registration and registrar details), further to due process requirements codified in the UDRP Rules.<sup>74</sup>

37. The Center continues to closely monitor the impact of data protection regulations on UDRP proceedings. Separate from the Center's UDRP function, with a view to addressing broader IP enforcement concerns occasioned by privacy regulation, there are significant ongoing stakeholder discussions on a possible Whois "accreditation and access" model, including as to a potential WIPO role to certify IP owners' rights for such access.<sup>75</sup> ICANN

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<sup>68</sup> See <https://gnso.icann.org/sites/default/files/file/field-file-attach/rpm-phase-1-proposed-24nov20-en.pdf>.

<sup>69</sup> See in particular "Section I: Description and Explanation" including three categories of proposed changes to RPMs at <https://www.icann.org/public-comments/gnso-rpm-pdp-phase-1-final-recommendations-2021-04-07-en>.

<sup>70</sup> See <https://community.icann.org/display/RPMIRT>.

<sup>71</sup> See <https://gnso.icann.org/en/issues/new-gtlds/rpm-final-issue-11jan16-en.pdf>, and more recently, an ICANN Staff-produced "Policy Status Report" (<https://www.icann.org/en/public-comment/proceeding/policy-status-report-uniform-domain-name-dispute-resolution-policy-udrp-03-03-2022>) on which the Center has provided input. See [www.wipo.int/amc/en/docs/icannletter190422.pdf](http://www.wipo.int/amc/en/docs/icannletter190422.pdf).

<sup>72</sup> See <https://gac.icann.org/contentMigrated/icann74-gac-communication>.

<sup>73</sup> Notably, the registrant's name and email address will in most instances not be visible. However, in order to facilitate contact with the domain name registrant, the concerned registrar is required to provide an "anonymized" email address or web-based contact form.

<sup>74</sup> The ICANN "Temporary [contract] Specification" for gTLD Registration Data expressly acknowledged that registrars must provide full "Registration Data" to UDRP providers.<sup>74</sup> This appeared to be on the recognition that UDRP providers meet the GDPR's Article 6(1)(f) "legitimate purposes" and Article 6(1)(b) "performance of a contract" criteria, such that registrars can and should provide Whois data to UDRP providers.

<sup>75</sup> See <https://www.icann.org/en/system/files/files/framework-elements-unified-access-model-for-discussion-18jun18-en.pdf>.

debate continues as to the specifics of what has also been called a System for Standardized Access/Disclosure to non-public gTLD registration data (“SSAD”), including at a policy level through ICANN’s Expedited Policy Development Process (or EPDP).<sup>76</sup> Most recently, ICANN has approved the development and launch of a WHOIS Disclosure System pilot program to be run for up to two years to inform any further policy action in this regard.<sup>77</sup> Notably, the ICANN Board’s decision to leave registrar (and registry) participation in such pilot program as voluntary has raised significant concerns; discussions on this continue.

#### D. IDNS

38. As observed in paragraph 26, another noteworthy policy development in the DNS is the introduction of IDNs (non-Latin script) at the top level.<sup>78</sup> Many of these were among the first new gTLDs announced by ICANN for delegation in the DNS root zone.

#### E. OTHER IDENTIFIERS

39. 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)

40. 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, including country names and IGO names and acronyms. The 2002 WIPO General Assembly recommended amending the UDRP in order to provide protection for country names and the names and acronyms of IGOs.<sup>79</sup>

41. These recommendations were part of protracted and complex deliberations within ICANN’s multi-layered policy development framework, as relevant especially to the application conditions for new gTLDs. Previous WIPO General Assembly documents track in more detail the process and substance of these continuing deliberations, which in the ICANN ecosystem notably involve the GAC, the Board, the Board’s New gTLD Program Committee (NGPC), and the GNSO Council.<sup>80</sup>

42. In terms of the present status of the issue of protection in the DNS of the names and acronyms of IGOs, on GAC advice the ICANN Board has provisionally reserved from third-party registration in new GTLDs the full names of IGOs at the top and second levels in two

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<sup>76</sup> See GNSO Council adoption of the Phase 1 Final Report of the Expedited Policy Development Process (EPDP) on the Temporary Specification for gTLD Registration Data Team at <https://www.icann.org/en/announcements/details/gnsocounciladopts-epdp-final-report-on-the-temporary-specification-for-gtld-registration-data-4-3-2019-en> and Phase 2 Final Report at <https://www.icann.org/en/blogs/details/epdp-phase-2-team-publishes-final-report-10-8-2020-en>. Several specific questions that remained unanswered were moved to a “Phase 2a”, see e.g., <https://www.icann.org/en/announcements/details/call-for-expressions-of-interest-chair-of-phase-2a-gnsocounciladopts-epdp-on-the-temporary-specification-for-gtld-registration-data-4-11-2020-en>.

<sup>77</sup> See <https://www.icann.org/en/board-activities-and-meetings/materials/approved-resolutions-special-meeting-of-the-icann-board-27-02-2023-en>.

<sup>78</sup> 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](http://www.iso.org/iso/english_country_names_and_code_elements)).

<sup>79</sup> See [http://www.wipo.int/edocs/mdocs/govbody/en/wo\\_ga\\_28/wo\\_ga\\_28\\_3.pdf](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. The WIPO Secretariat transmitted these recommendations to ICANN. See <http://www.wipo.int/amc/en/docs/wipo.doc>.

<sup>80</sup> See [https://www.wipo.int/about-wipo/en/assemblies/2021/a\\_62/doc\\_details.jsp?doc\\_id=507114](https://www.wipo.int/about-wipo/en/assemblies/2021/a_62/doc_details.jsp?doc_id=507114), paragraphs 44-51.

languages. Meanwhile, despite GAC advice and IGO positions favoring preventative protection, 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 reservation. The resulting final Working Group recommendation has caused concerns for IGOs and the GAC, requiring further policy work on a core recommendation that has since been the subject of GNSO Council re-chartering and referral to Phase 1 of the PDP mentioned in paragraph 34.<sup>81</sup> The GAC on its part has re-affirmed that any IGO-specific RPM should respect IGOs' status under international law; while the ICANN Board noted the GAC's advice on the need to protect IGO acronyms, it has subsequently signaled an intention to lift the above-mentioned reservation of IGO acronyms in new gTLDs on the basis of a system to notify IGOs of a third-party registration corresponding to their identifier;<sup>82</sup> the GAC thereupon affirmed its Advice to the ICANN Board "to maintain the current moratorium on the registration of IGO acronyms pending the conclusion of the IGO curative work track currently underway".<sup>83</sup> Since then, during the course of 2021 an expedited work track was convened to address the issue of IGO access to curative rights protection mechanisms such as the UDRP and URS. This work concluded in March 2022 with targeted proposals to ICANN to adapt the UDRP Rules to account for IGOs' status under international law, in terms of the Paris Convention and recognized privileges and immunities.<sup>84</sup>

43. Together with other IGOs, the Center continues to closely monitor ICANN implementation developments in this longstanding ICANN file.<sup>85</sup>

(b) Geographical Terms

44. Concerning geographical terms, the GAC in particular has expressed concerns about their use and protection in the new gTLDs.<sup>86</sup> 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 state that new registries should adopt procedures for blocking/challenge of names with national or geographical significance at the second level upon demand of governments. Concerning the top level,<sup>87</sup> 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."<sup>88</sup> Applied-for strings which are considered by ICANN to be certain other geographical names, e.g., capital city names, should be accompanied by

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<sup>81</sup> See <https://gnso.icann.org/en/council/resolutions#201905>.

<sup>82</sup> See <https://www.icann.org/en/system/files/correspondence/botterman-to-ismail-23feb21-en.pdf>.

<sup>83</sup> See <https://www.icann.org/en/system/files/files/resolutions-abudhabi60-gac-advice-scorecard-04feb18-en.pdf> and <https://gac.icann.org/contentMigrated/icann71-gac-communique>.

<sup>84</sup> See [gnso.icann.org/sites/default/files/file/field-file-attach/epdp-specific-cr-igo-final-report-02apr22-en.pdf](https://gnso.icann.org/sites/default/files/file/field-file-attach/epdp-specific-cr-igo-final-report-02apr22-en.pdf), and <https://gnso.icann.org/sites/default/files/policy/2022/draft/draft-epdp-specific-curative-rights-protections-for-igos-report-11jul22-en.pdf>.

<sup>85</sup> See generally [www.icann.org/resources/pages/igo-ingo-protection-policy-2018-01-16-en](http://www.icann.org/resources/pages/igo-ingo-protection-policy-2018-01-16-en), [www.icann.org/resources/board-material/resolutions-2018-02-04-en#2.d](http://www.icann.org/resources/board-material/resolutions-2018-02-04-en#2.d), and [www.icann.org/en/system/files/files/resolutions-abudhabi60-gac-advice-scorecard-04feb18-en.pdf](http://www.icann.org/en/system/files/files/resolutions-abudhabi60-gac-advice-scorecard-04feb18-en.pdf). The Assistant Secretary General of the United Nations in charge of the Office of Legal Affairs on behalf of several IGOs (including WIPO) sent a letter in July 2018 to the ICANN Board stating concerns after the final report of the PDP process (see [www.icann.org/en/system/files/correspondence/mathias-to-board-27jul18-en.pdf](http://www.icann.org/en/system/files/correspondence/mathias-to-board-27jul18-en.pdf)). See further discussion at ICANN's November 2020 meeting, at <https://icann66.pathable.com/meetings/1116847>.

<sup>86</sup> See <https://archive.icann.org/en/topics/new-gtlds/gac-principles-regarding-new-gtlds-28mar07-en.pdf>.

<sup>87</sup> 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.

<sup>88</sup> 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".

documentation of support or non-objection from the relevant governments or public authorities.<sup>89</sup> 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.<sup>90</sup>

45. 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.<sup>91</sup> 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.<sup>92</sup> ICANN did not react to this Center submission. GAC members have asked ICANN to provide coordinated information on related requests and delegated domain names.<sup>93</sup>

46. 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).<sup>94</sup> The Secretariat will continue to monitor these developments and provide input where appropriate.

*47. The WIPO General Assembly is invited to take note of the document “WIPO Arbitration and Mediation Center, Including Domain Names” (document WO/GA/56/13).*

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<sup>89</sup> 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”.

<sup>90</sup> 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 geographic names, which is subject to further ICANN discussions. See <https://gacweb.icann.org/download/attachments/27132037/Geo%20names%20in%20new%20gTLDs%20Updated%200%20V3%20%2029%20august%202014%5B4%5D.pdf?version=1&modificationDate=1411549935000&api=v2>. See also <https://www.icann.org/resources/board-material/resolutions-2019-05-15-en#1.c>.

<sup>91</sup> Together these comprise ICANN’s so-called “confusion mitigation” plans. See e.g., <https://www.icann.org/en/system/files/files/implementation-memo-two-character-ascii-labels-22jan19-en.pdf>.

<sup>92</sup> See <https://forum.icann.org/lists/comments-proposed-measures-two-char-08jul16/pdfECmcS9knuk.pdf>.

<sup>93</sup> See <https://static.ptbl.co/static/attachments/169910/1521228229.pdf?1521228229>.

<sup>94</sup> See e.g., documents SCT/37/4, SCT37/5, SCT38/3, SCT39/5, SCT40/4, SCT41/5, SCT 42/3, SCT 43/4, SCT 44/2, and SCT 45/3. See also meeting SCT/IS/GEO/GE/17.