

Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications

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UPDATE ON TRADEMARK-RELATED ASPECTS OF THE DOMAIN NAME SYSTEM (DNS)

Document prepared by the Secretariat

1. At the forty-third session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT), the Chair stated that the SCT had taken note of document SCT/43/4 (Update on Trademark-related Aspects of the Domain Name System) and that the Secretariat was requested to keep Member States informed on future developments in the Domain Name System (DNS) (see document SCT/43/11). Accordingly, the Secretariat has prepared the present document which offers the requested update.

I. DOMAIN NAME CASE ADMINISTRATION

A. UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY

2. The DNS raises a number of challenges for the protection of Intellectual Property (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 First¹ and Second² WIPO Internet Domain Name Processes. Through the Arbitration and

¹ 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: www.wipo.int/amc/en/processes/process1/report.

² 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: www.wipo.int/amc/en/processes/process2/report.

Mediation Center (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 Uniform Domain Name Dispute Resolution Policy (UDRP) was adopted by the Internet Corporation for Assigned Names and Numbers (ICANN) on the basis of recommendations made by WIPO in the First WIPO Internet Domain Name Process.

3. The UDRP is limited to clear cases of bad-faith, abusive registration and use of domain names and remains in high demand for trademark owners³. Since December 1999, the Center has administered over 51,000 UDRP-based cases⁴. Trademark holders in 2020 filed 4,204 UDRP-based complaints with the Center, a 14 per cent increase over 2019 filing (already a record at the time), and the first year that WIPO domain name case filings have surpassed 4,000. The total number of domain names in WIPO UDRP-based cases brought by brand owners has surpassed 93,000.

4. A diverse mixture of enterprises, institutions, and individuals used the Center's domain name dispute resolution procedures in 2020. The top sectors for complainant business activity were Biotechnology and Pharmaceuticals, Banking and Finance, Internet and Information Technology, and Fashion. Nowadays, filings from rights owners include alleged fraudulent email or phishing schemes, impersonation, and other illicit uses of consumer-facing websites (e.g., counterfeits) associated with the disputed domain names. More recently, cases have involved so-called homographic variations of trademarks with cybersquatters registering internationalized domain names (IDNs) which appear to be in "standard" Latin ASCII Script but employ IDN variations to trick users (i.e., profiting from visual similarity between different characters). Reflecting the global scope of this dispute mechanism, named parties to WIPO cases from UDRP inception through 2020 represented 181 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 nearly 30 languages⁵.

5. All WIPO UDRP panel decisions are posted on the Center's website. Published in 2017, the Center's Third Edition of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions (WIPO Overview 3.0)⁶ has been widely embraced by parties to proceedings and is applied by panelists across cases. This globally-consulted online overview of decision trends on important case issues covers over 100 topics, including citations to almost 1,000 representative decisions from over 265 WIPO Panelists. To facilitate access to these decisions according to party business sector and dispute subject matter, the Center also offers an online searchable Legal Index of WIPO UDRP Decisions⁷. These WIPO resources are accessible free of charge.

³ The UDRP does not prevent either party from submitting a dispute to a competent court of justice; but very few cases that have been decided under the UDRP have been brought before a court. See Selected UDRP-related Court Cases at www.wipo.int/amc/en/domains/challenged.

⁴ See https://www.wipo.int/pressroom/en/articles/2020/article_0026.html. 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 www.wipo.int/amc/en/domains/statistics.

⁵ In alphabetical order, Bulgarian, Chinese, Czech, Danish, Dutch, English, Estonian, Finnish, French, German, Greek, Hebrew, Hungarian, Indonesian, Italian, Japanese, Korean, Norwegian, Polish, Portuguese, Romanian, Russian, Slovak, Spanish, Swedish, Turkish, Ukrainian, and Vietnamese.

⁶ See www.wipo.int/amc/en/domains/search/overview3.0/. 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.

⁷ See www.wipo.int/amc/en/domains/search/legalindex/.

6. 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. The Center organizes Domain Name Dispute Resolution Workshops to update interested parties⁸, as well as meetings of its Domain Name Panelists. In 2019, the UDRP passed 20 years of successful operation and the Center hosted a conference in Geneva to commemorate this milestone. The event both took stock and looked ahead in terms of UDRP jurisprudence, relevant Internet developments, and a range of other topical items such as platform ADR models⁹.

B. Country Code Top-Level Domains (ccTLDs)

7. The application of the UDRP is mandated for domain names registered in generic Top Level Domains (gTLDs) (such as .com) and more recently introduced New gTLDs. The Center however also assists ccTLD registries in their establishment of registration conditions and dispute resolution procedures that conform with international best practices in registry management and IP protection. Some ccTLD registries adopt the UDRP directly, while others have adopted UDRP-based procedures which take account of relevant national considerations. The Center provides domain name dispute resolution services to nearly 80 ccTLD registries, having commenced such services for .CN and .中国 (China) as well as for .UA and .COM.UA (Ukraine) in 2019, and with further additions expected in 2021¹⁰.

8. With further reference to WIPO's ccTLD assistance, in 2020 the Center provided policy support to a number of ccTLD registries. Following their request to WIPO, this included collaborating with relevant authorities to promote efficiency and harmonization of domain name dispute resolution mechanisms by updating the Policies, Rules, and WIPO Supplemental Rules for .AC (Ascension Island), .IO (British Indian Ocean Territory), .SH (Saint Helena), that resulted in the adoption of UDRP-based mechanisms.

9. In 2020, the Center hosted numerous virtual events including webinars to inform prospective and interested parties of the dispute resolution services for .CN and .中国 (China), .EU (European Union), .MX, (Mexico), and .SE (Sweden) country code Top-Level Domains¹¹, with further webinars being held in 2021.

II. POLICY DEVELOPMENTS IN THE DOMAIN NAME SYSTEM

10. 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 hundreds 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 related development concerns the introduction of Internationalized Domain Names (IDNs) at the top level, such as .网店 (webshop/e-shop) and .شبكة (web/network). ICANN's expansion of the DNS also raises rights protection questions in connection with the Second WIPO Process.

⁸ Such workshops organized by the Center are listed at: www.wipo.int/amc/en/events.

⁹ See https://www.wipo.int/portal/en/news/2019/article_0050.html.

¹⁰ The full list of ccTLDs which have retained the Center as domain name dispute resolution provider is available at www.wipo.int/amc/en/domains/cctld.

¹¹ See <https://www.wipo.int/amc/en/events/webinar.html>

A. NEW GTLDS

11. ICANN implementation of its New gTLD Program, formally approved in June 2011¹², was detailed in its iterative “Applicant Guidebook”¹³. 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 2020¹⁴ only a few (e.g., “.music”) remain to launch. Together, these New gTLDs appear to have so far attracted some 27 million second-level registrations (owing e.g., to non-renewals, this figure is down from a prior 32 million)¹⁵. ICANN concluded its “New gTLD Subsequent Procedures Policy Development Process” (PDP) in 2020¹⁶. While topics such as “Mitigating DNS Abuse”, “Closed Generics”, and “Public Interest Commitments / Registry Voluntary Commitments” were flagged for potential additional consideration, further ICANN processes include GNSO Council and ICANN Board consideration and presumably approval, followed by implementation to launch another New gTLD application round in the future.

12. 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 RPMs specifically created for New gTLDs had emerged from a series of ICANN processes¹⁷. 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

13. This mechanism allowed trademark owners to lodge Legal Rights Objections (LRO) to New gTLD applications at the top level where certain substantive criteria were met¹⁸. 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”¹⁹.

¹² See www.icann.org/en/minutes/resolutions-20jun11-en.htm. For further background including references, see document WO/GA/39/10, in particular paragraph 14.

¹³ ICANN’s Applicant Guidebook is available at newgtlds.icann.org/en/applicants/agb.

¹⁴ Delegated New gTLDs are listed at newgtlds.icann.org/en/program-status/delegated-strings.

¹⁵ See ntldstats.com.

¹⁶ See the New gTLD Subsequent Procedures PDP January 2021 Newsletter at: <https://myemail.constantcontact.com/Read-the-SubPro-PDP-Newsletter---January-2021-Edition.html?soid=1122025845763&aid=qJxZ65sQtok>. For the Working Group Final Report submitted on January 18, 2021, see <https://gnso.icann.org/sites/default/files/file/field-file-attach/final-report-newgtld-subsequent-procedures-pdp-02feb21-en.pdf>.

¹⁷ 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”.

¹⁸ 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.

¹⁹ Adopted by the WIPO General Assembly in September 2001; see www.wipo.int/edocs/pubdocs/en/marks/845/pub845.pdf.

14. Appointed by ICANN as the exclusive provider of LRO dispute resolution services²⁰, the Center received 69 compliant LRO filings, which it completed processing by September 2013²¹. All WIPO LRO expert panel determinations are available on the Center's website²² as is a Center report on the LRO process²³. It is expected that a similar procedure would be available for subsequent New gTLD rounds.

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

15. In early 2009, the Center communicated to ICANN a specific 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 abuse²⁴. 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-harbors²⁵.

16. 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 (notably by ICANN having excluded the legal concept of "wilful blindness"). In light of broader policy interests however, the Center in 2013 agreed with ICANN to become a provider for the trademark PDDRP²⁶.

(b) Second Level RPMs

(i) Trademark Clearinghouse (TMCH)

17. ICANN's New gTLD Program includes a Trademark Clearinghouse (TMCH) as a centralized repository of authenticated trademark data which may be invoked as the basis for using New gTLD RPMs²⁷. The Center commented that the TMCH should not unfairly burden

²⁰ See section 3.2 of the ICANN Applicant Guidebook at newgtlds.icann.org/en/applicants/agnb/objection-procedures-04jun12-en.pdf.

²¹ See WIPO Rules for New gTLD Dispute Resolution, and Schedule of Fees and Costs, respectively at www.wipo.int/amc/en/docs/wipolrrules.pdf and www.wipo.int/amc/en/domains/lro/fees/; see WIPO-registered LRO cases at www.wipo.int/amc/en/domains/lro/cases/.

²² See www.wipo.int/amc/en/domains/lro/cases/.

²³ 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 www.wipo.int/amc/en/docs/lroreport.pdf.

²⁴ See www.wipo.int/amc/en/docs/icann130309.pdf.

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

²⁶ To date no cases appear to have been filed under the PDDRP.

²⁷ 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

rights holders in the treatment of trademark registrations legitimately obtained through varied 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 the latest available information, it appears that the TMCH has received some 45,000 entries²⁸.

(ii) Uniform Rapid Suspension (URS) System

18. 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 cases²⁹.

19. Having evolved from a sequence of ICANN processes and committees, the URS continues to raise a number of questions, including its relationship to the UDRP³⁰. ICANN invited tenders from prospective URS providers, to which after careful consideration of the ICANN URS model, the Center has not been in a position to apply³¹. The Center continues to closely monitor developments, including as to any evolution of the remedy offered by the URS procedure and, whether by contractual amendment or policy process, its potential applicability to incumbent TLDs such as “.com”. In December 2019, ICANN upheld a request for reconsideration regarding its determination to include the URS procedure in the renegotiated .org Registry Agreement³².

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

20. 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 body³³, 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 questions³⁴. 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 PDP to review all RPMS in two phases. The now-concluded initial phase focused on RPMS developed for the New gTLD Program, notably the TMCH (including “Sunrise” and

services similarly applies to the invocation of trademarks as a basis for a complaint filed under the “Uniform Rapid Suspension” RPM described herein. Some registry operators have introduced a provision in their Registry-Registrar Agreement for an extended Claims service of indefinite length, as for example Charleston Road Registry (part of Google) for “.app” (see gtldresult.icann.org/applicationstatus/applicationdetails:downloadapplication/1343?t:ac=1343).

²⁸ See www.trademark-clearinghouse.com/content/tmch-stats.

²⁹ The Center for its part communicated to ICANN in April 2009 a discussion draft of an “Expedited (Domain Name) Suspension Mechanism”, (see 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 prague44.icann.org/node/31773 and 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.

³⁰ An extensive inventory of these issues is provided *inter alia* in the Center’s letter to ICANN of December 2, 2010, available at www.wipo.int/amc/en/docs/icann021210.pdf.

³¹ The question of accreditation of providers gives rise to concerns as to the stability of RPMS; WIPO raised these concerns as early as 2007 in the context of the UDRP (see www.wipo.int/amc/en/docs/icann040707.pdf).

³² See <https://www.icann.org/resources/board-material/resolutions-2019-12-12-en#1.b>.

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

³⁴ See [gnso.icann.org/en/issues/new-gtlds/rpm-prelim-issue-09oct15-en.pdf](https://www.gnso.icann.org/en/issues/new-gtlds/rpm-prelim-issue-09oct15-en.pdf).

“Claims Notice” RPMs)³⁵ and URS resulting in a range of operational and procedural suggestions for changes to the RPMs covered in Phase I³⁶. The Phase I Final Report contained 35 consensus recommendations³⁷ and is set to be considered for approval by the GNSO Council following which the ICANN Board will consider the GNSO recommendations and if approved by the Board, implemented by ICANN. Phase II (possibly to begin in early 2021) will focus on the UDRP³⁸. This is a matter of serious concern, noting also the accreditation by ICANN of yet another new UDRP provider in 2019 and the uncertainty of how the UDRP may evolve in this ICANN process. 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 the European Communities Trade Mark Association (ECTA), the International Trademark Association (INTA), and MARQUES – The Association of European Trade Mark Owners, in addition to ICANN.

C. PRIVACY REGULATION AND THE “WHOIS DATABASE”

21. There is nowadays an increased focus on privacy and data regulation, for example the European Union’s General Data Protection Regulation (GDPR)³⁹ which 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 those relating to contracts and legal disputes.

22. After May 25, 2018, publicly-available Whois data generally no longer includes full contact details of domain name registrants. Instead, publicly-available Whois data is largely redacted, or if available, is generally limited to the “registrant organization” (for legal persons) and country. 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. In addition to these limited options, where a UDRP complaint has been submitted to a UDRP provider, ICANN-compliant registrars are instructed to provide Whois information on 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. An ICANN “Temporary [contract] Specification” for gTLD Registration Data expressly acknowledges that registrars must provide full “Registration Data” to UDRP providers⁴⁰. This appears 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” criteria⁴¹, such that registrars have been required to provide Whois data to UDRP providers. In July 2018, the GNSO initiated the Expedited PDP (EPDP) to review the “Temporary [contract] Specification” and discuss a standardized access model to nonpublic registration data⁴²; a Final Report was submitted to the GNSO Council in July 2020 including the EPDP Team’s recommendations for a System for Standardized Access/Disclosure (SSAD)⁴³ on which a number of concerns were raised by governments and IP stakeholders and for which

³⁵ See footnote 20.

³⁶ See Final Report at <https://gnso.icann.org/sites/default/files/file/field-file-attach/council-recommendations-rpm-pdp-phase-1-report-10feb21-en.pdf>
See also presentation to the GNSO Council at

<https://gnso.icann.org/sites/default/files/policy/2021/presentation/presentation-gnso-rpm-final-report-11Jan21-en.pdf>.

³⁷ These comprised the following four categories of recommendations: to Maintain Status Quo (9), to Modify Operational Practice (10), to Create New Policies and Procedures (15), and for Overarching Data Collection (1).

³⁸ See gnso.icann.org/en/issues/new-gtlds/rpm-final-issue-11jan16-en.pdf.

³⁹ Regulation (EU) 2016/679 of the European Parliament and of the Council of 27 April 2016 on the protection of natural persons with regard to the processing of personal data and on the free movement of such data, and repealing Directive 95/46/EC (General Data Protection Regulation).

⁴⁰ See www.icann.org/resources/pages/gtld-registration-data-specs-en, at Annex F. See also <https://www.icann.org/en/announcements/details/icann-board-reaffirms-temporary-specification-for-gtld-registration-data-29-1-2019-en>.

⁴¹ In 2018, the Center published informal WIPO guidance for parties on the practical impact of the GDPR on UDRP proceedings. See www.wipo.int/amc/en/domains/gdpr/.

⁴² See <https://gnso.icann.org/en/group-activities/active/gtld-registration-data-epdp>.

⁴³ See <https://gnso.icann.org/en/group-activities/active/gtld-registration-data-epdp-phase-2>.

consultations are still underway. The Center continues to monitor the EPDP review, which is ongoing⁴⁴. Further to such registration data matters, the European Commission has adopted a proposal for a revised Directive on Security of Network and Information Systems (NIS 2 Directive)⁴⁵.

23. The Center continues to closely monitor the impact of the GDPR on UDRP proceedings. Separate from the Center's UDRP function, with a view to addressing broader IP enforcement concerns occasioned by GDPR implementation, as noted above with respect to the proposed SSAD for Whois queries, a range of discussions continue on a possible Whois "accreditation and access" model, including as to a potential WIPO role to certify IP owners' rights for such access⁴⁶.

D. IDNS

24. As observed in paragraph 10, another noteworthy policy development in the DNS is the introduction of IDNs (non-Latin script) at the top level⁴⁷. Many of these were among the first new gTLDs announced by ICANN for delegation in the DNS root zone.

E. OTHER IDENTIFIERS

25. 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) Intergovernmental Organizations (IGOs)

26. 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.

27. The 2002 WIPO General Assembly recommended amending the UDRP in order to provide protection for country names and for the names and acronyms of IGOs⁴⁸. The WIPO Secretariat transmitted these recommendations to ICANN in February 2003⁴⁹.

28. Following ICANN deliberations⁵⁰, 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 24 and 25. 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

⁴⁴ See <https://gnso.icann.org/sites/default/files/file/field-file-attach/policy-briefing-icann70-03mar21-en.pdf>. See also the Governmental Advisory Committee Minority Statement on the Final Report of Phase 2 of the EPDP on gTLD Registration Data at: <https://mm.icann.org/pipermail/gnso-epdp-team/attachments/20200824/aeab8dd/gac-minority-statement-epdp-phase2-24aug20-0001.pdf>.

⁴⁵ See <https://ec.europa.eu/digital-single-market/en/news/proposal-directive-measures-high-common-level-cybersecurity-across-union>.

⁴⁶ See <https://www.icann.org/en/system/files/files/framework-elements-unified-access-model-for-discussion-18jun18-en.pdf>. See further the agenda of ICANN's June 2018 meeting at <https://62.schedule.icann.org/>. See also www.ipconstituency.org/assets/Outreach/DRAFT%20-%20WHOIS%20Accreditation%20and%20Access%20Model%20v1.7.pdf.

⁴⁷ See also ICANN's Final Implementation Plan for IDN ccTLD Fast Track Process published in November 2009 (see 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 www.iso.org/iso/english_country_names_and_code_elements).

⁴⁸ See 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.

⁴⁹ See www.wipo.int/amc/en/docs/wipo.doc.

⁵⁰ For background, see WO/GA/41/17 Rev.2, in particular paragraphs 40 and 41.

new gTLDs⁵¹. 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 ICANN Board that pending implementation work, interim protection for IGO names and acronyms should be provided through a moratorium on third-party registration; while progress is being made on implementation, this moratorium remains in place.

29. 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 protection⁵². 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 criteria⁵³, together with a list of protectable IGO names and acronyms⁵⁴.

30. 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 practice⁵⁵. 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 DNS⁵⁶. 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 meeting⁵⁷.

31. 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 Communiqués⁵⁸.

32. In parallel to the policy efforts undertaken by the NGPC, the GAC, and IGOs⁵⁹, 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 calls for preventative protection for IGO acronyms at the second level. Instead, it recommended a curative protection mechanism 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

⁵¹ See gacweb.icann.org/download/attachments/27132070/FINAL_Toronto_Communique_20121017.pdf?version=1&modificationDate=1354149148000&api=v2.

⁵² See www.icann.org/en/system/files/correspondence/crocker-to-dryden-16jan13-en.pdf.

⁵³ Such criteria comprise treaty-based IGOs with international legal personality, or which are UN Observers, or which are funds or programs of the UN.

⁵⁴ See www.icann.org/en/news/correspondence/dryden-to-crocker-chalaby-22mar13-en.

⁵⁵ The ICANN 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 www.icann.org/en/news/correspondence/crocker-to-dryden-01apr13-en.

⁵⁶ 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 durban47.icann.org/meetings/durban2013/presentation-gac-communicue-18jul13-en.pdf.

⁵⁷ See www.icann.org/resources/board-material/resolutions-new-gtld-2013-07-17-en#1.a.

⁵⁸ The GAC and the NGPC had cancelled their participation in a September 30 meeting proposed by IGOs.

⁵⁹ For a more complete summary see document WO/GA/48/12 Rev., paragraphs 42 to 45.

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.

33. 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. The majority of the resulting final Working Group recommendations, approved by the GNSO Council on a non-unanimous basis and sent to ICANN's Board for consideration, have caused concerns for IGOs and the GAC. With respect to a recommendation concerning IGO immunities, owing to a number of factors, the GNSO Council, in consultation with the GAC and IGOs, has meanwhile re-chartered a new Work Track within the RPM Working Group to resolve the key outstanding policy question of IGO access to a curative RPM⁶⁰. It has again been affirmed by the GAC that any IGO-specific RPM modeled on the existing UDRP should respect IGOs' status under international law, but should not amend the existing UDRP. The ICANN Board has also acknowledged the GAC's previous advice on the need to protect IGO acronyms in the DNS⁶¹. Together with other involved IGOs, the Center continues to closely monitor developments in this longstanding ICANN file. Ultimately, the re-initiated Work Track aims to avoid the ICANN Board needing to reconcile differences between GAC Advice and GNSO recommendations as to IGO-related RPMs⁶².

(b) Geographical Terms

34. Concerning geographical terms, the GAC in particular has expressed concerns about their use and protection in the new gTLDs⁶³. Concerning the top level⁶⁴, 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 round⁶⁵." 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 authorities⁶⁶.

⁶⁰ See <https://gnso.icann.org/en/group-activities/active/igo-ingo-crp-access>.

⁶¹ See e.g., www.icann.org/en/system/files/files/resolutions-abudhabi60-gac-advice-scorecard-04feb18-en.pdf.

⁶² See 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, and 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 its concerns after the final report of the PDP process (see www.icann.org/en/system/files/correspondence/mathias-to-board-27jul18-en.pdf). In response, members of the PDP Working Group defended the outcome of the report in a letter sent in August 2018 to the ICANN Board (see www.icann.org/en/system/files/correspondence/igo-ingo-wg-to-icann-board-16aug18-en.pdf). See further discussion at ICANN's October 2018 meeting, at gac.icann.org/sessions/icann63-agenda-item-3-curative-rights-protection-mechanisms.

⁶³ 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 archive.icann.org/en/topics/new-gtlds/gac-principles-regarding-new-gtlds-28mar07-en.pdf. See also gac.icann.org/contentMigrated/icann63-barcelona-communicue.

⁶⁴ 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 newgtlds.icann.org/en/applicants/agn/base-agreement-specs-04jun12-en.pdf at Specification 5.

⁶⁵ See newgtlds.icann.org/en/applicants/agn/evaluation-procedures-04jun12-en.pdf, from section 2.2.1.4.1 "Treatment of Country or Territory Names".

⁶⁶ See newgtlds.icann.org/en/applicants/agn/evaluation-procedures-04jun12-en.pdf, from section 2.2.1.4.2 "Geographic Names Requiring Government Support".

35. 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 concerns⁶⁷.

36. Concerning possible future New gTLD rounds, a so-called Work Track 5 “cross community” working group has submitted a Final Report to the New gTLD Subsequent Procedures PDP Working Group on the subject of geographic names at the top level⁶⁸. While overall ICANN’s next application round appears likely to maintain the status of the 2014 round, the broader subject of geographical names remains a topic of interest to a number of ICANN stakeholders, including governments and potential applicants.

37. 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 complaints⁶⁹. 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 abuse⁷⁰. Since ICANN’s release, including in recent discussions, a number of GAC members have expressed concerns and further requested that ICANN provide coordinated information on related requests and delegations⁷¹. It is anticipated that a similar process may be used for country names at the second level (currently still blocked).

38. 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)⁷². The Secretariat will continue to monitor these developments and provide input where appropriate.

39. *The SCT is invited to take note of the contents of this document.*

[End of document]

⁶⁷ See www.icann.org/en/system/files/correspondence/gac-to-board-27mar14-en.pdf, at “4. Specific Strings”. While the Board accepted the GAC’s advice against proceeding with certain applications, it had 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 www.icann.org/en/system/files/correspondence/gac-to-board-11apr13-en.pdf. Concerning the “.amazon” application, ICANN entered into a Registry Agreement in December 2019 granting Amazon EU S.à r.l. the authority to operate the .amazon new gTLD. See <https://www.icann.org/resources/agreement/amazon-2019-12-19-en>. 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 currently subject to further ICANN discussions.

⁶⁸ See <http://mm.icann.org/pipermail/gnso-newgtld-wg-wt5/attachments/20191022/c47fb9cf/WorkTrack5FinalReporttotheNewgTLDSubProPDPWG-22October2019-0001.pdf>.

⁶⁹ Together these comprise ICANN’s so-called “confusion mitigation” plans. See www.icann.org/en/system/files/files/two-character-ltr-ltr-authorization-release-13dec16-en.pdf.

⁷⁰ See forum.icann.org/lists/comments-proposed-measures-two-char-08jul16/pdfECmcS9knuk.pdf.

⁷¹ See the Survey of the existing state of play of geographical indications, country names, and other geographical terms in the domain name system prepared by the Center with the SCT Secretariat on March 12, 2018 that was submitted to the SCT/39/7, available at: www.wipo.int/edocs/mdocs/sct/en/sct_39/sct_39_7.pdf.

⁷² See e.g., documents SCT/37/4, SCT37/5, SCT38/3, SCT39/5, SCT40/4, SCT41/5, SCT/42/3, and SCT/43/4. See also meeting SCT/IS/GEO/GE/17.