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

*Document prepared by the Secretariat*

1. This document provides an update on the WIPO Arbitration and Mediation Center's ("Center") activities as an international resource for time- and cost-efficient alternatives to court litigation of intellectual property (IP) disputes, acting as an administrator of cases as well as a provider of legal and organizational expertise in alternative dispute resolution (ADR).

2. This document also provides an update on the domain name-related activities of WIPO, as previously reported in WO/GA/49/14.<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 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.

#### **I. ARBITRATION AND MEDIATION OF IP DISPUTES**

##### **A. ARBITRATION AND MEDIATION CASE ADMINISTRATION**

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

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<sup>1</sup> See [http://www.wipo.int/edocs/mdocs/govbody/en/wo\\_ga\\_49/wo\\_ga\\_49\\_14.pdf](http://www.wipo.int/edocs/mdocs/govbody/en/wo_ga_49/wo_ga_49_14.pdf).

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

4. The Center continued to undertake initiatives to further facilitate access for potential users to WIPO ADR. These include an updated Guide to WIPO Mediation<sup>4</sup> that reflects recent developments in the WIPO Mediation Rules and in Center practice and offers additional guidance to parties. The Center's online clause generator allows parties to build core clauses and submission agreements, with the possibility of selecting additional considerations to suit particular needs.<sup>5</sup>

## B. ADR SERVICES FOR SPECIFIC SECTORS

### (a) Collaboration with Intellectual Property Offices

5. Additional to its described more regular services, the Center assists a growing number of IP and Copyright Offices (IPOs) in their establishment of optional ADR frameworks, the organization of training programs and promotional activities, as well as case administration. Since the 2017 Assemblies, the Center has entered into collaborations with IP authorities in a number of further Member States.<sup>6</sup> Following expressed Member State needs, this engagement includes the following types of activities.

6. Raising Awareness of ADR Options: the Center collaborates with IPOs<sup>7</sup> to raise awareness of the advantages of ADR options to prevent and resolve IP and technology

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

<sup>3</sup> ECAF offers online case communication and storage of documents facilitating time- and cost-efficient mediation and arbitration proceedings. In 2018, the Center added several new features to ECAF, including advanced search and bulk-uploading capabilities. See <http://www.wipo.int/amc/en/ecaf/index.html>.

<sup>4</sup> See <http://www.wipo.int/amc/en/publications/>.

<sup>5</sup> The WIPO Clause Generator is available at <http://www.wipo.int/amc-apps/clause-generator/>.

<sup>6</sup> These include the National Institute of Industrial Property (INPI) of Argentina, the State Intellectual Property Office of the People's Republic of China (SIPO), the National Register of Costa Rica, the Dominican Republic National Copyright Office (ONDA), the Kenya Copyright Board (KECOBO), the Korea Intellectual Property Office (KIPO), the Ministry of Culture of the Republic of Lithuania, the Patent Office of the Republic of Poland (UPRP), the Romanian Copyright Office (ORDA), the Federal Service for Intellectual Property of the Russian Federation (ROSPATENT), the Intellectual Property Office of the Republic of Serbia, and the Swiss Federal Institute of Intellectual Property (IPI). A full list of the Center's collaborations with IPOs is available at <http://www.wipo.int/amc/en/center/specific-sectors/ipoffices/>.

<sup>7</sup> These include the National Institute of Industrial Property (INPI) in Argentina, IP Australia, the Brazilian National Institute of Industrial Property (INPI-BR), the State Intellectual Property Office of the People's Republic of China (SIPO), the National Copyright Directorate of Colombia (DNDA), the National Register of Costa Rica, the Cuban Industrial Property Office (OCPI), the Dominican Republic National Copyright Office (ONDA), the El Salvador National Center of Registries (CNR), the Indonesia Directorate General of Intellectual Property (DGIP), the Israel Patent Office (ILPO), the Kenya Copyright Board (KECOBO), the Ministry of Culture, Sports and Tourism of the Republic of Korea (MCST), the Korea Intellectual Property Office (KIPO), the Ministry of Culture of the Republic of Lithuania, the Mexican Institute of Industrial Property (IMPI Mexico), the Paraguay National Directorate of Intellectual

disputes outside the courts or other adjudicative bodies. In the period, such contact consisted of the development of country-tailored information materials for interested parties concerning ADR options, including on online case administration;<sup>8</sup> training and joint events for stakeholders to inform them of the benefits of mediation and arbitration for resolving IP and related disputes;<sup>9</sup> and referring party inquiries received by an IPO to the Center for further assistance (notably in infringement cases).

7. Case Administration: some IPOs have developed ADR options or encourage parties to use such options, in the context of proceedings pending before them, notably trademark or patent opposition proceedings. The Center worked with IPOs in the development of mediation and expert determination options for such ADR proceedings. The Center also collaborated with IPOs in the administration of cases submitted by parties under such schemes.<sup>10</sup> In the area of copyright, some IPOs administer ADR proceedings in domestic disputes and designate the Center as administrator of cases where one or both parties are domiciled outside the country.<sup>11</sup>

8. ADR options in Research and Development (R&D) Model Agreements: the Center also collaborated with IPOs in the development of R&D model agreements, the dispute resolution provisions of which include WIPO Mediation followed by WIPO Expedited Arbitration options.<sup>12</sup>

9. Reflecting this growing experience, the Center in 2018 published a second edition of the WIPO Guide on Alternative Dispute Resolution for IPOs and Courts.<sup>13</sup> The Guide provides a broad overview of ADR for IP disputes and presents options for interested IPOs and courts to integrate ADR into their existing processes. The Guide also outlines the Center's collaborations and provides examples of related model documents.

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Property (DINAPI), the Intellectual Property Office of the Philippines (IPOP HL), the Patent Office of the Republic of Poland (UPRP), the Romanian Copyright Office (ORDA), the Federal Service for Intellectual Property of the Russian Federation (ROSPATENT), the Intellectual Property Office of the Republic of Serbia, the Intellectual Property Office of Singapore (IPOS), the Spanish Patent and Trademark Office (OEPM), the Swiss Federal Institute of Intellectual Property (IPI), the United Kingdom Intellectual Property Office (UKIPO), and the United States Patent and Trademark Office (USPTO).

<sup>8</sup> The Center makes available ECAF and videoconferencing facilities for parties. See <http://www.wipo.int/amc/en/ecaf/index.html>.

<sup>9</sup> For examples of events organized by the Center in collaboration with IPOs see <http://www.wipo.int/amc/en/center/specific-sectors/ipoffices/>. ADR also is included in the programs of WIPO Roving Seminars organized in collaboration with IPOs. See [http://www.wipo.int/dcea/en/roving\\_seminars/](http://www.wipo.int/dcea/en/roving_seminars/).

<sup>10</sup> For example, under its collaboration with the Intellectual Property Office of Singapore (IPOS), the Center has participated in the development of a mediation option for trademark and patent proceedings, and an expert determination option for patent proceedings pending before IPOS, and administers such proceedings. The Center also collaborates with the Intellectual Property Office of the Philippines (IPOP HL) concerning the administration of mediation proceedings involving IP rights in the Philippines. The Trademark Trial and Appeal Board (TTAB) and the Patent Trial and Appeal Board (PTAB) of the United States Patent and Trademark Office (USPTO) encourage parties to consider ADR as a means of settling issues raised in those proceedings. The Center is one of the listed dispute resolution service providers for TTAB and PTAB proceedings. Under its collaboration with the Patent Office of the Republic of Poland (UPRP), the Center participated in the development of a mediation option for pending trademark opposition proceedings, and is to administer such proceedings.

<sup>11</sup> This notably concerns the collaborations between the Center and the National Copyright Directorate of Colombia (DNDA), the Korea Copyright Commission (KCC), and the Korea Creative Content Agency (KOCCA). See <http://www.wipo.int/amc/en/center/specific-sectors/ipoffices/>.

<sup>12</sup> For example, the Center produced such models with the Spanish Patent and Trademark Office (OEPM). Other model R&D agreements that recommend WIPO Mediation followed by Expedited Arbitration include the EU DESCA 2020 Model Consortium Agreement; the Intellectual Property Agreement Guide (IPAG) Model Agreements in Austria; and the Sample Agreements for Research and Development Cooperation in Germany. For further information see <http://www.wipo.int/amc/en/center/specific-sectors/rd/>.

<sup>13</sup> The second edition of the Guide is available at <http://www.wipo.int/export/sites/www/amc/en/docs/adrguidejuly2015.pdf>.

(b) WIPO ADR for FRAND Disputes

10. To facilitate the submission to WIPO ADR of disputes concerning fair, reasonable and non-discriminatory (FRAND) terms for standard-essential patents (SEPs), the Center in collaboration with telecom stakeholders and patent arbitration experts developed the Guidance on WIPO FRAND ADR.<sup>14</sup> Published in late 2017, the Guidance on WIPO FRAND ADR is intended to assist parties and neutrals to better understand and make use of available dispute resolution options when negotiating or drafting FRAND licensing agreements. The document covers key elements that parties may wish to consider to shape the ADR process, notably to address large SEP portfolios, and to manage the time and cost of proceedings. Tailored model submission agreements assisting parties to refer a FRAND-related dispute to WIPO mediation or arbitration are also included.

(c) Resolving Trade Fair Disputes

11. In collaboration with trade fair organizers, the Center provides dispute resolution advice and case administration services to help parties resolve IP disputes arising at trade fairs without the need to go to court during the fair.<sup>15</sup> Since the 2017 Assemblies, the Center administered cases under the WIPO Fast-Track Intellectual Property Dispute Resolution Procedure for Palexpo Trade Fairs in Geneva.<sup>16</sup> The Center also collaborated with the Singapore trade fair organizer SingEx in the development of a tailored WIPO Fast-Track Procedure for SingEx Trade Fairs to become available for a fair later in 2018.

## II. DOMAIN NAME CASE ADMINISTRATION

### A. UDRP

12. The DNS raises a number of challenges for the protection of IP, which, due to the global nature of the Internet, call for an international approach. WIPO has addressed these challenges since 1998 by developing specific solutions, most notably in the First<sup>17</sup> and Second<sup>18</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 principal mechanism administered by the Center, the UDRP, was adopted by ICANN on the basis of recommendations made by WIPO in the First WIPO Process.

13. Limited to clear cases of bad faith, the UDRP has proven in high demand by trademark owners.<sup>19</sup> Since December 1999, the Center has administered over 41,000 UDRP-based cases.<sup>20</sup> Trademark holders in 2017 filed 3,074 UDRP-based complaints with the Center, the second consecutive year that WIPO domain name case filings have surpassed 3,000. By the

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<sup>14</sup> See <http://www.wipo.int/export/sites/www/amc/en/docs/wipofrandadrguidance.pdf>.

<sup>15</sup> See <http://www.wipo.int/amc/en/center/specific-sectors/tradefairs/>.

<sup>16</sup> These include cases at the 87<sup>th</sup> Geneva International Motor Show held in March 2018.

<sup>17</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>18</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>19</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>.

<sup>20</sup> The Center makes available online real-time statistics to assist WIPO UDRP case parties and neutrals, trademark attorneys, domain name registrants, domain name policy makers, the media, and academics. Available statistics cover many categories, such as “areas of complainant activity”, “domain name script”, and “25 most cited decisions in complaint”. See <http://www.wipo.int/amc/en/domains/statistics>.

end of June 2018, the total number of domain names in WIPO UDRP-based cases brought by brand owners neared 76,000.

14. A diverse mixture of enterprises, institutions, and individuals used the Center's dispute resolution procedures in 2017. The top sectors for complainant business activity were Banking and Finance, Fashion, Internet and Information Technology, Heavy Industry and Machinery, Food, Beverages and Restaurants, Retail, and Biotechnology and Pharmaceuticals. Notably, the filings from rights owners in the banking and finance sector include alleged fraudulent email or phishing schemes, impersonation, and other illicit uses of consumer-facing websites associated with the disputed domain names.

15. Reflecting the global scope of this dispute mechanism, named parties to WIPO cases from UDRP inception through 2017 covered 178 countries. In function of the language of the applicable registration agreement of the domain name at issue, WIPO UDRP proceedings have so far been conducted in 21 languages.<sup>21</sup>

16. 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) has been the subject of a range of publications and events.<sup>22</sup> This globally-consulted online overview of broad decision trends on important case issues covers over 100 topics, including reference to almost 1,000 representative decisions from over 265 WIPO Panelists. To facilitate access to these decisions according to subject matter, the Center also offers an online searchable Legal Index of WIPO UDRP Decisions.<sup>23</sup> These WIPO resources are globally accessible free of charge.

17. Mindful of WIPO's foundational role in the UDRP, the Center monitors developments in the DNS with a view to adjusting its resources and practices.<sup>24</sup> The Center regularly organizes Domain Name Dispute Resolution Workshops to update interested parties,<sup>25</sup> as well as meetings of its Domain Name Panelists.

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

18. While the mandatory application of the UDRP is limited to domain names registered in gTLDs (such as .com) and more recently introduced new gTLDs, the Center also assists ccTLD registries in their establishment of registration conditions and dispute resolution procedures that conform with best practices in registry management and IP protection.<sup>26</sup> Some ccTLD registries adopt the UDRP directly, while others have adopted UDRP-based procedures which take account of the particular circumstances and needs of individual ccTLDs. The Center provides domain name dispute resolution services to over 70 ccTLD registries, including the .GE (Georgia) domain added in 2018.<sup>27</sup>

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<sup>21</sup> In alphabetical order, Chinese, Czech, Danish, Dutch, English, French, German, Hebrew, Italian, Japanese, Korean, Norwegian, Polish, Portuguese, Romanian, Russian, Slovak, Spanish, Swedish, Turkish, and Vietnamese.

<sup>22</sup> See <http://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.

<sup>23</sup> See <http://www.wipo.int/amc/en/domains/search/legalindex/>.

<sup>24</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 31 to 33, *infra*. See also, WO/GA/47/14, paragraph 30, and WO/GA/41/17 Rev.2, paragraphs 14 to 16.

<sup>25</sup> See footnote 2, *supra*.

<sup>26</sup> See <http://www.wipo.int/amc/en/new/eu.html>.

<sup>27</sup> The full list of ccTLDs which have retained the Center as domain name dispute resolution provider is available at <http://www.wipo.int/amc/en/domains/cctld>. Since mid-2017, the Center provides services for .eu and .ю (cyrillic script) registrations, in all 24 official EU languages, and also for the .SE (Sweden) registry.

19. For all ccTLDs concerned, the Center in 2018 significantly expanded its posted party resources, including eligibility criteria for registration, supported characters, and multilingual model pleadings and filing information,<sup>28</sup> as well as summaries of relevant differences between the respective UDRP-based ccTLD policies and the UDRP.<sup>29</sup>

### III. POLICY DEVELOPMENTS IN THE DNS

20. 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]. An important related development concerns the introduction of Internationalized Domain Names (IDNs) at the top level. Also, ICANN's expansion of the DNS raises rights protection questions in connection with the Second WIPO Process.

#### A. NEW GTLDS

21. ICANN implementation of its New gTLD Program formally approved in June 2011<sup>30</sup> is detailed in its much-revised "Applicant Guidebook".<sup>31</sup> Delegation of the first new gTLDs into the Internet's Root Zone took place in October 2013, with over 1,200 gTLDs delegated by June 2018.<sup>32</sup>

22. The Center remains committed to working with stakeholders to attempt to safeguard the observance of general principles of IP protection in new gTLDs. A number of the RPMs have emerged from a series of ICANN committees and processes for new gTLDs.<sup>33</sup> 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

23. 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>34</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>35</sup>

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<sup>28</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>29</sup> See <http://www.wipo.int/amc/en/domains/cctld/>.

<sup>30</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>31</sup> ICANN's Applicant Guidebook is available at <http://newgtlds.icann.org/en/applicants/agb>.

<sup>32</sup> Delegated new gTLDs are listed at <http://newgtlds.icann.org/en/program-status/delegated-strings>.

<sup>33</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".

<sup>34</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>35</sup> Adopted by the WIPO General Assembly in September 2001; see <http://www.wipo.int/edocs/pubdocs/en/marks/845/pub845.pdf>.

24. Appointed by ICANN as the exclusive provider of LRO dispute resolution services,<sup>36</sup> the Center received 69 compliant LRO filings, which it completed processing by September 2013.<sup>37</sup> All WIPO LRO expert panel determinations are available on the Center's website,<sup>38</sup> as is a Center report on the LRO process.<sup>39</sup>

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

25. 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>40</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 safe-harbors.<sup>41</sup>

26. Following various ICANN processes, including consultations with registry operators, the effectiveness of this PDDRP in the form adopted by ICANN remains uncertain, in particular given the addition of overlapping procedural layers, and issues concerning the intended substantive scope of this mechanism. In light of broader policy interests, the Center in 2013 agreed with ICANN to become a provider for the trademark PDDRP.

(b) Second Level RPMs

(i) Trademark Clearinghouse (TMCH)

27. 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>42</sup> The Center has commented that the TMCH should not unfairly burden rights holders in

<sup>36</sup> See section 3.2 of the ICANN Applicant Guidebook at <http://newgtlds.icann.org/en/applicants/agb/objection-procedures-04jun12-en.pdf>.

<sup>37</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/>.

<sup>38</sup> See <http://www.wipo.int/amc/en/domains/lro/cases/>.

<sup>39</sup> 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>40</sup> See <http://www.wipo.int/amc/en/docs/icann130309.pdf>.

<sup>41</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>42</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.

the treatment of trademark registrations legitimately obtained through examination and registration systems as applied in many global jurisdictions, and that, if and where relevant, practical measures may be envisaged to identify any allegedly inappropriate invocation of rights in specific contexts. According to available information, it appears that through May 2018, the TMCH had received over 44,000 entries.<sup>43</sup>

(ii) Uniform Rapid Suspension (URS) System

28. While importantly the UDRP remains available as a curative tool for new gTLD disputes involving the considered transfer of a disputed domain name to the trademark owner, ICANN has introduced what is intended to be a lighter second-level RPM for appropriate cases.<sup>44</sup>

29. Having evolved from a sequence of ICANN processes and committees, the URS continues to raise a number of questions, including its relationship to the UDRP.<sup>45</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>46</sup> The Center continues to closely monitor developments.

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

30. Accommodating the dynamic development of the DNS, the UDRP has been offering an effective alternative to court litigation for trademark owners, domain name registrants, and registration authorities. Nevertheless, following discussions in 2011 at which the clear majority of participants were of the opinion that more harm than good could result from any review of the UDRP by ICANN as a registration-driven body,<sup>47</sup> a decision was taken by ICANN's Generic Names Supporting Organization (GNSO) to review the UDRP following the launch of new gTLDs. ICANN's Preliminary Issue Report on this topic was issued in October 2015 describing a range of complex substantive and process-related questions.<sup>48</sup> In this regard, the Center provided observations highlighting both the UDRP's long-proven success and the risks associated with any attempted ICANN revision of the UDRP. Following a public comment period, ICANN issued its Final Issue Report in January 2016 recommending that the GNSO launch a Policy Development Process (PDP) to review all RPMs in two phases; the initial phase is still focusing on RPMs developed for the New gTLD Program, notably the TMCH (including "Sunrise" and "Claims" RPMs) and URS, whereas the second phase will focus on the UDRP.<sup>49</sup> This is a matter of serious concern, and the Center continues to closely follow ICANN stakeholders' intentions with regard to the UDRP and trademark RPMs generally. In this effort, the Center where relevant is in contact with trademark stakeholders such as ECTA, INTA, and MARQUES.

<sup>43</sup> See <http://trademark-clearinghouse.com/content/tmch-stats>.

<sup>44</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>45</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>46</sup> The question of accreditation of providers gives rise to concerns as to the stability of RPMs; WIPO raised concerns about this as early as 2007 in the context of the UDRP (see <http://www.wipo.int/amc/en/docs/icann040707.pdf>).

<sup>47</sup> See <https://community.icann.org/display/gnsoudrpd/Webinar+on+the+Current+State+of+the+UDRP>; see also more generally document WO/GA/39/10, paragraph 31.

<sup>48</sup> See <http://gnso.icann.org/en/issues/new-gtlds/rpm-prelim-issue-09oct15-en.pdf>.

<sup>49</sup> See <https://gnso.icann.org/en/issues/new-gtlds/rpm-final-issue-11jan16-en.pdf>.



### C. GDPR AND THE WHOIS DATABASE

31. 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.

32. After May 25, 2018, publicly-available Whois data significantly no longer includes full contact details for the domain name registrant. Instead, publicly-available Whois data is generally limited to the "registrant organization" 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. Despite these public limitations, where a UDRP complaint has been submitted to a UDRP provider, ICANN-compliant registrars will normally 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. The ICANN "Temporary [contract] Specification" for gTLD Registration Data expressly acknowledges that registrars must provide full "Registration Data" to UDRP providers.<sup>50</sup> 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" criteria, such that registrars can and should provide Whois data to UDRP providers.

33. 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, 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>51</sup>

### D. IDNS

34. As noted in paragraph 20, another significant policy development in the DNS is the introduction of IDNs (non-Latin script) at the top level.<sup>52</sup> Many of these were among the first new gTLDs announced by ICANN for delegation in the DNS root zone.

### E. OTHER IDENTIFIERS

35. 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)

36. 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.

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<sup>50</sup> See <https://www.icann.org/resources/pages/gtld-registration-data-specs-en>, at Annex F.

<sup>51</sup> 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/>.

<sup>52</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)).

37. The 2002 WIPO General Assembly recommended amending the UDRP in order to provide protection for country names and for the names and acronyms of IGOs.<sup>53</sup> The WIPO Secretariat transmitted these recommendations to ICANN in February 2003.<sup>54</sup>

38. Following ICANN deliberations,<sup>55</sup> 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 23 and 24. However, following sustained IGO efforts, ICANN's Governmental Advisory Committee (GAC) advised the ICANN Board that IGO identifiers should be granted protection against inappropriate third-party registration prior to the delegation of any new gTLDs.<sup>56</sup> 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 has been made on implementation, this moratorium remains in place.

39. The ICANN Board responded to the GAC indicating that it had adopted a resolution for interim protection at the second level based on the existing .int criteria, *via* an ICANN reserve list of IGO identifiers, to be withheld from third-party registration through the new gTLD Registry Agreement. ICANN invited qualifying IGOs to identify themselves to ICANN, while also seeking provision by the GAC (with IGOs) of a consolidated IGO package comprising the criteria and list of IGO names and acronyms for which the GAC advised protection.<sup>57</sup> In response, an IGO coalition developed .int-based criteria for IGO protection and an accompanying list of IGOs, which the IGO coalition forwarded to the ICANN Board in February 2013. This was followed by a GAC communication to the ICANN Board concerning IGO protection eligibility criteria,<sup>58</sup> together with a list of protectable IGO names and acronyms.<sup>59</sup>

40. On April 1, 2013, the Board expressed concerns to the GAC on how to reconcile protection of IGO acronyms with certain potentially legitimate third-party attempts to register corresponding domain names and asked how cases of potentially legitimate co-existent use of such acronym could be managed in practice.<sup>60</sup> In July 2013, following further discussions with ICANN and sustained efforts from IGOs, the GAC issued advice to the ICANN Board that highlighted the need for special preventative protection for IGO names and acronyms in the DNS.<sup>61</sup> Following this advice, the ICANN Board issued a resolution extending interim protection

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<sup>53</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.

<sup>54</sup> See <http://www.wipo.int/amc/en/docs/wipo.doc>.

<sup>55</sup> For background, see WO/GA/41/17 Rev.2, in particular paragraphs 40 and 41.

<sup>56</sup> See

[https://gacweb.icann.org/download/attachments/27132070/FINAL\\_Toronto\\_Communique\\_20121017.pdf?version=1&modificationDate=1354149148000&api=v2](https://gacweb.icann.org/download/attachments/27132070/FINAL_Toronto_Communique_20121017.pdf?version=1&modificationDate=1354149148000&api=v2).

<sup>57</sup> See <https://www.icann.org/en/system/files/correspondence/crocker-to-dryden-16jan13-en.pdf>.

<sup>58</sup> Such criteria comprise treaty-based IGOs with international legal personality, or which are UN Observers, or which are funds or programs of the UN.

<sup>59</sup> See <http://www.icann.org/en/news/correspondence/dryden-to-crocker-chalaby-22mar13-en>.

<sup>60</sup> The Board also sought further specifics on means for periodic review of the list, along with clarification of any additional languages in which protection of IGO names and acronyms is sought. See <http://www.icann.org/en/news/correspondence/crocker-to-dryden-01apr13-en>.

<sup>61</sup> The GAC further advised that it expressly assumed that the ICANN Board was prepared to fully implement the GAC advice and focus on practical and effective implementation of preventative protection at the second level in new gTLDs, and that the interim protections for IGO names and acronyms should remain in place until the dialogue between the GAC, ICANN and IGOs was completed. See <http://durban47.icann.org/meetings/durban2013/presentation-gac-communique-18jul13-en.pdf>.

for IGOs until the first meeting of the ICANN Board's New gTLD Program Committee (NGPC) after the November 2013 ICANN meeting.<sup>62</sup>

41. In October 2013 the NGPC made a proposal for protection of IGO acronyms at the second level that fell short of providing IGO acronyms with the permanent preventative protection envisaged in previous GAC Communiqués.<sup>63</sup>

42. In parallel to the policy efforts undertaken by the NGPC, the GAC, and IGOs,<sup>64</sup> the GNSO had launched a PDP concerning IGO protection, in which process the Center with other IGO representatives participated. Over IGO objections, this GNSO process largely rejected preventative protection for IGO acronyms at the second level. Instead, it recommended curative protection mechanisms for IGO acronyms, coupled with the removal of the temporary protections for IGO acronyms in place. These recommendations were adopted unanimously by the GNSO Council in November 2013. In April 2014, the ICANN Board resolved to adopt the GNSO Council recommendations not in conflict with GAC advice, namely reserving from registration the full names of IGOs at the top and second levels in two languages.

43. 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. This has been the subject of continuing policy discussions, including at all of ICANN's subsequent meetings; even so, the final GNSO recommendation remains to be seen. Meanwhile 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 DNS.<sup>65</sup> Together with other involved IGOs, the Center continues to closely monitor developments in this longstanding ICANN file. Ultimately, the ICANN Board may be called upon to reconcile differences between GAC Advice and GNSO recommendations as to IGO-related RPMs.

#### (b) Geographical Terms

44. Concerning geographical terms, the GAC in particular has expressed concerns about their use and protection in the new gTLDs.<sup>66</sup> Concerning the top level,<sup>67</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>68</sup> Applied-for strings which are considered by ICANN to be certain other geographical names, e.g., capital city

<sup>62</sup> See <https://www.icann.org/resources/board-material/resolutions-new-gtld-2013-07-17-en#1.a>.

<sup>63</sup> The GAC and the NGPC had cancelled their participation in a September 30 meeting proposed by IGOs.

<sup>64</sup> For a more complete summary see document WO/GA/48/12 Rev., paragraphs 42 to 45.

<sup>65</sup> See <https://www.icann.org/en/system/files/files/resolutions-abudhabi60-gac-advice-scorecard-04feb18-en.pdf>.

<sup>66</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 stated that new registries should adopt procedures for blocking/challenge of names with national or geographical significance at the second level upon demand of governments. See <https://archive.icann.org/en/topics/new-gtlds/gac-principles-regarding-new-gtlds-28mar07-en.pdf>.

<sup>67</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>68</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".

names, should be accompanied by documentation of support or non-objection from the relevant governments or public authorities.<sup>69</sup>

45. 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>70</sup>

46. 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>71</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>72</sup> In recent discussions, GAC members have requested that ICANN provide coordinated information on related requests and delegations.<sup>73</sup>

47. 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>74</sup> In this regard, for the 39<sup>th</sup> Session of the SCT in March 2018, in accordance with the Workplan on Geographical Indications and at the request of the Chair of the SCT, the Center with the SCT Secretariat compiled a well-received survey of the existing state of play of Geographical Indications, country names, and other geographical terms in the DNS.<sup>75</sup> The Secretariat will continue to monitor these developments and provide input where appropriate.

48. *The WIPO General Assembly is invited to take note of the document “WIPO Arbitration and Mediation Center, Including Domain Names” (document WO/GA/50/10).*

[End of document]

<sup>69</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>70</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%20%20V3%20%2029%20august%202014%5B4%5D.pdf?version=1&modificationDate=1411549935000&api=v2>.

<sup>71</sup> Together these comprise ICANN’s so-called “confusion mitigation” plans. See

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

<sup>72</sup> See <https://forum.icann.org/lists/comments-proposed-measures-two-char-08jul16/pdfECmcS9knuk.pdf>.

<sup>73</sup> See <https://static.ptbl.co/static/attachments/169910/1521228229.pdf?1521228229>.

<sup>74</sup> See e.g., documents SCT/37/4, SCT37/5, SCT38/3 and SCT39/5. See also meeting SCT/IS/GEO/GE/17.

<sup>75</sup> See document SCT39/7.