

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

**Forty-First Session**  
**Geneva, November 4 to 7, 2019**

### **UPDATE ON TRADEMARK-RELATED ASPECTS OF THE DOMAIN NAME SYSTEM**

*Document prepared by the Secretariat*

1. At the forty-first 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/41/5 (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/41/10). 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, 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>1</sup> and Second<sup>2</sup> WIPO Internet Domain Name Processes. Through the Arbitration and 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

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<sup>1</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: [www.wipo.int/amc/en/processes/process1/report](http://www.wipo.int/amc/en/processes/process1/report).

<sup>2</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: [www.wipo.int/amc/en/processes/process2/report](http://www.wipo.int/amc/en/processes/process2/report).

their trademark rights. The principal mechanism administered by the Center, the Uniform Domain Name Dispute Resolution Policy (UDRP) was adopted by 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 owners<sup>3</sup>. Since December 1999, the Center has administered over 45,000 UDRP-based cases<sup>4</sup>. Trademark holders in 2018 filed 3,452 UDRP-based complaints with the Center, an increase over 2017 filing (already a record at the time), and the third consecutive year that annual WIPO domain name case filings have surpassed 3,000. By August 2019, the total number of domain names in WIPO UDRP-based cases brought by brand owners surpassed 82,000.

4. A diverse mixture of enterprises, institutions, and individuals used the Center's domain name dispute resolution procedures in 2018. The top sectors for complainant business activity were Banking and Finance, Biotechnology and Pharmaceuticals, Internet and Information Technology, and Fashion. Nowadays, the 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 2018 represented 179 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 26 languages<sup>5</sup>.

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)<sup>6</sup> has been widely embraced by parties to the proceedings and broadly applied by panelists in thousands of cases already. 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 subject matter, the Center also offers an online searchable Legal Index of WIPO UDRP Decisions<sup>7</sup>. These WIPO resources are accessible free of charge.

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 regularly organizes Domain Name Dispute Resolution Workshops to update interested parties<sup>8</sup>, as well as meetings of its Domain Name Panelists. In 2019, the UDRP turns 20 and the Center recently hosted a conference in Geneva to commemorate this milestone. The event has both taken stock and

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<sup>3</sup> 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](http://www.wipo.int/amc/en/domains/challenged).

<sup>4</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 [www.wipo.int/amc/en/domains/statistics](http://www.wipo.int/amc/en/domains/statistics).

<sup>5</sup> In alphabetical order, 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, and Vietnamese.

<sup>6</sup> See [www.wipo.int/amc/en/domains/search/overview3.0/](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>7</sup> See [www.wipo.int/amc/en/domains/search/legalindex/](http://www.wipo.int/amc/en/domains/search/legalindex/).

<sup>8</sup> Such workshops organized by the Center are listed at: [www.wipo.int/amc/en/events](http://www.wipo.int/amc/en/events).

looked ahead in terms of ADR system design, UDRP jurisprudence, relevant Internet developments, and a range of other topical items.

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

7. The mandatory application of the UDRP is limited to 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 particular circumstances and needs of individual ccTLDs. The Center provides domain name dispute resolution services to over 70 ccTLD registries, having commenced such services for .CN and .中国 (China) and .UA (Ukraine) in 2019, and with further additions expected<sup>9</sup>.

8. For all ccTLDs concerned, the Center in 2018 significantly expanded its posted party resources, including eligibility criteria for registration, supported (IDN) characters, and multilingual model pleadings and filing information<sup>10</sup>, as well as summaries of relevant differences between the respective UDRP-based ccTLD policies and the UDRP itself<sup>11</sup>. Building on these resources, a side event will be held at the Fifty-Ninth Series of Meetings of the WIPO Assemblies in 2019 where, *inter alia*, the “Guide to WIPO’s services for country code Top-Level Domain registries” will be launched.

## II. POLICY DEVELOPMENTS IN THE DOMAIN NAME SYSTEM

9. A number of policy developments in relation to ICANN present both opportunities and challenges for owners and users of intellectual property rights rights. One is ICANN’s introduction of a significant number of New gTLDs. Such New gTLDs may be of an “open” nature (similar to .com), or may take on more specific or restrictive characteristics, for example taking the form of .[brand], .[city], .[community], .[culture], .[industry], or .[language]. A noteworthy 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.

### A. NEW GTLDS

10. ICANN implementation of its New gTLD Program, formally approved in June 2011<sup>12</sup>, is detailed in its iterative “Applicant Guidebook”<sup>13</sup>. 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 2018<sup>14</sup> only a few (e.g., “.music”) remain to launch. Together, these New gTLDs appear to have so far attracted some 26 million second-level registrations<sup>15</sup>. ICANN is expected to conclude its “New gTLD Subsequent Procedures Policy Development Process” (PDP) in 2019,

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<sup>9</sup> 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](http://www.wipo.int/amc/en/domains/cctld). Since mid-2017, the Center provides services for .eu and .euo (cyrillic script) registrations, in all 24 official EU languages, and also for the .SE (Sweden) registry. 2018 showed the addition of the ccTLD registries of .AI (Anguilla), .GE (Georgia), and .PY (Paraguay).

<sup>10</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. See [www.wipo.int/amc/en/domains/cctld/cctldnews.html](http://www.wipo.int/amc/en/domains/cctld/cctldnews.html).

<sup>11</sup> See [www.wipo.int/amc/en/domains/cctld/](http://www.wipo.int/amc/en/domains/cctld/).

<sup>12</sup> See [www.icann.org/en/minutes/resolutions-20jun11-en.htm](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>13</sup> ICANN’s Applicant Guidebook is available at [newgtlds.icann.org/en/applicants/agg](http://newgtlds.icann.org/en/applicants/agg).

<sup>14</sup> Delegated New gTLDs are listed at [newgtlds.icann.org/en/program-status/delegated-strings](http://newgtlds.icann.org/en/program-status/delegated-strings).

<sup>15</sup> See [ntldstats.com](http://ntldstats.com).

and following Board approval, it plans to launch another New gTLD application process.

11. 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 processes<sup>16</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

12. 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>17</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>18</sup>.

13. Appointed by ICANN as the exclusive provider of LRO dispute resolution services<sup>19</sup>, the Center received 69 compliant LRO filings, which it completed processing by September 2013<sup>20</sup>. All WIPO LRO expert panel determinations are available on the Center’s website<sup>21</sup> as is a Center report on the LRO process<sup>22</sup>. It is expected that a similar procedure would be available for subsequent New gTLD rounds.

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

14. 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 abuse<sup>23</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>24</sup>.

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<sup>16</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>17</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>18</sup> Adopted by the WIPO General Assembly in September 2001; see [www.wipo.int/edocs/pubdocs/en/marks/845/pub845.pdf](http://www.wipo.int/edocs/pubdocs/en/marks/845/pub845.pdf).

<sup>19</sup> See section 3.2 of the ICANN Applicant Guidebook at [newgtlds.icann.org/en/applicants/agb/objection-procedures-04jun12-en.pdf](http://newgtlds.icann.org/en/applicants/agb/objection-procedures-04jun12-en.pdf).

<sup>20</sup> See WIPO Rules for New gTLD Dispute Resolution, and Schedule of Fees and Costs, respectively at [www.wipo.int/amc/en/docs/wipolrules.pdf](http://www.wipo.int/amc/en/docs/wipolrules.pdf) and [www.wipo.int/amc/en/domains/lro/fees/](http://www.wipo.int/amc/en/domains/lro/fees/); see WIPO-registered LRO cases at [www.wipo.int/amc/en/domains/lro/cases/](http://www.wipo.int/amc/en/domains/lro/cases/).

<sup>21</sup> See [www.wipo.int/amc/en/domains/lro/cases/](http://www.wipo.int/amc/en/domains/lro/cases/).

<sup>22</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 [www.wipo.int/amc/en/docs/lroreport.pdf](http://www.wipo.int/amc/en/docs/lroreport.pdf).

<sup>23</sup> See [www.wipo.int/amc/en/docs/icann130309.pdf](http://www.wipo.int/amc/en/docs/icann130309.pdf).

<sup>24</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 [www.icann.org/en/minutes/resolutions-05nov10-en.htm](http://www.icann.org/en/minutes/resolutions-05nov10-en.htm)), that

15. 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 “wilfull blindness”). In light of broader policy interests however, the Center in 2013 agreed with ICANN to become a provider for the trademark PDDRP.

(b) Second Level RPMs

(i) Trademark Clearinghouse (TMCH)

16. ICANN’s New gTLD Program includes a TMCH as a centralized repository of authenticated trademark data which may be invoked as the basis for using New gTLD RPMs<sup>25</sup>. The Center commented that the TMCH should not unfairly burden 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 available information, it appears that through August 2019, the TMCH had received some 45,000 entries<sup>26</sup>.

(ii) Uniform Rapid Suspension (URS) System

17. 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>27</sup>.

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ICANN consider extending the PDDRP for registries also to registrar conduct (see, *inter alia*, [www.wipo.int/amc/en/docs/icann260310rap.pdf](http://www.wipo.int/amc/en/docs/icann260310rap.pdf)).

<sup>25</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. 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](http://gtldresult.icann.org/applicationstatus/applicationdetails:downloadapplication/1343?t:ac=1343)).

<sup>26</sup> See [www.trademark-clearinghouse.com/content/tmch-stats](http://www.trademark-clearinghouse.com/content/tmch-stats).

<sup>27</sup> 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](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 [prague44.icann.org/node/31773](http://prague44.icann.org/node/31773) and [toronto45.icann.org/node/34325](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.

18. 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>28</sup>. 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 apply<sup>29</sup>. The Center continues to closely monitor developments, including as to any evolution of the remedy offered by the URS procedure and its potential applicability to incumbent TLDs such as “.com”.

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

19. 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>30</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>31</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 PDP to review all RPMS in two phases; the initial phase (envisaged to produce an “Initial Report” for public comment in late 2019) is focused on RPMS developed for the New gTLD Program, notably the TMCH (including “Sunrise” and “Claims” RPMS)<sup>32</sup> and URS, whereas Phase II (possibly to begin in late 2019 even while comments are being sought on Phase I) will focus on the UDRP<sup>33</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, in addition to ICANN.

#### C. GDPR AND THE WHOIS DATABASE

20. The European Union's General Data Protection Regulation (GDPR)<sup>34</sup> 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.

21. After May 25, 2018, publicly-available Whois data no longer includes full contact details of domain name registrants. 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 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

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<sup>28</sup> 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](http://www.wipo.int/amc/en/docs/icann021210.pdf).

<sup>29</sup> 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](http://www.wipo.int/amc/en/docs/icann040707.pdf)).

<sup>30</sup> See [community.icann.org/display/gnsoudrpd/Webinar+on+the+Current+State+of+the+UDRP](http://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>31</sup> See [gnso.icann.org/en/issues/new-gtlds/rpm-prelim-issue-09oct15-en.pdf](http://gnso.icann.org/en/issues/new-gtlds/rpm-prelim-issue-09oct15-en.pdf).

<sup>32</sup> See footnote 25.

<sup>33</sup> See [gnso.icann.org/en/issues/new-gtlds/rpm-final-issue-11jan16-en.pdf](http://gnso.icann.org/en/issues/new-gtlds/rpm-final-issue-11jan16-en.pdf).

<sup>34</sup> 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).

Rules. An ICANN “Temporary [contract] Specification” for gTLD Registration Data expressly acknowledges that registrars must provide full “Registration Data” to UDRP providers<sup>35</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<sup>36</sup>, such that registrars have been required to provide Whois data to UDRP providers.

22. 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 intellectual property 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 intellectual property owners’ rights for such access<sup>37</sup>.

#### D. IDNS

23. As observed in paragraph 21, another noteworthy policy development in the DNS is the introduction of IDNs (non-Latin script) at the top level<sup>38</sup>. Many of these were among the first new gTLDs announced by ICANN for delegation in the DNS root zone.

#### E. OTHER IDENTIFIERS

24. 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)

25. 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.

26. 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>39</sup>. The WIPO Secretariat transmitted these recommendations to ICANN in February 2003<sup>40</sup>.

27. Following ICANN deliberations<sup>41</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 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 new

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<sup>35</sup> See [www.icann.org/resources/pages/gtld-registration-data-specs-en](http://www.icann.org/resources/pages/gtld-registration-data-specs-en), at Annex F.

<sup>36</sup> 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/](http://www.wipo.int/amc/en/domains/gdpr/).

<sup>37</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/>. See also [www.ipconstituency.org/assets/Outreach/DRAFT%20-%20WHOIS%20Accreditation%20and%20Access%20Model%20v1.7.pdf](http://www.ipconstituency.org/assets/Outreach/DRAFT%20-%20WHOIS%20Accreditation%20and%20Access%20Model%20v1.7.pdf)

<sup>38</sup> 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](http://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](http://www.iso.org/iso/english_country_names_and_code_elements)).

<sup>39</sup> See [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>40</sup> See [www.wipo.int/amc/en/docs/wipo.doc](http://www.wipo.int/amc/en/docs/wipo.doc).

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

gTLDs<sup>42</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 is being made on implementation, this moratorium remains in place.

28. 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>43</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>44</sup>, together with a list of protectable IGO names and acronyms<sup>45</sup>.

29. 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>46</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>47</sup>. Following this advice, the ICANN Board issued a resolution extending interim protection for IGOs until the first meeting of the ICANN Board’s New gTLD Program Committee (NGPC) after the November 2013 ICANN meeting<sup>48</sup>.

30. 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>49</sup>.

31. In parallel to the policy efforts undertaken by the NGPC, the GAC, and IGOs<sup>50</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 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

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<sup>42</sup> See

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

<sup>43</sup> See [www.icann.org/en/system/files/correspondence/crocker-to-dryden-16jan13-en.pdf](http://www.icann.org/en/system/files/correspondence/crocker-to-dryden-16jan13-en.pdf).

<sup>44</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>45</sup> See [www.icann.org/en/news/correspondence/dryden-to-crocker-chalaby-22mar13-en](http://www.icann.org/en/news/correspondence/dryden-to-crocker-chalaby-22mar13-en).

<sup>46</sup> 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](http://www.icann.org/en/news/correspondence/crocker-to-dryden-01apr13-en).

<sup>47</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 [durban47.icann.org/meetings/durban2013/presentation-gac-communique-18jul13-en.pdf](http://durban47.icann.org/meetings/durban2013/presentation-gac-communique-18jul13-en.pdf).

<sup>48</sup> See [www.icann.org/resources/board-material/resolutions-new-gtld-2013-07-17-en#1.a](http://www.icann.org/resources/board-material/resolutions-new-gtld-2013-07-17-en#1.a).

<sup>49</sup> The GAC and the NGPC had cancelled their participation in a September 30 meeting proposed by IGOs.

<sup>50</sup> For a more complete summary see document WO/GA/48/12 Rev., paragraphs 42 to 45.

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.

32. 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 has expressed an intention to re-charter a new Working Group. 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>51</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.<sup>52</sup>

(b) Geographical Terms

33. Concerning geographical terms, the GAC in particular has expressed concerns about their use and protection in the new gTLDs<sup>53</sup>. Concerning the top level<sup>54</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>55</sup>." Applied-for strings which are considered by ICANN to be certain other geographical names, e.g., capital city names, should be accompanied by documentation of support or non-objection from the relevant governments or public authorities<sup>56</sup>.

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<sup>51</sup> See [www.icann.org/en/system/files/files/resolutions-abudhabi60-gac-advice-scorecard-04feb18-en.pdf](http://www.icann.org/en/system/files/files/resolutions-abudhabi60-gac-advice-scorecard-04feb18-en.pdf).

<sup>52</sup> See [www.icann.org/resources/pages/igo-ingo-protection-policy-2018-01-16-en](http://www.icann.org/resources/pages/igo-ingo-protection-policy-2018-01-16-en), [www.icann.org/resources/board-material/resolutions-2018-02-04-en#2.d](http://www.icann.org/resources/board-material/resolutions-2018-02-04-en#2.d), and [www.icann.org/en/system/files/files/resolutions-abudhabi60-gac-advice-scorecard-04feb18-en.pdf](http://www.icann.org/en/system/files/files/resolutions-abudhabi60-gac-advice-scorecard-04feb18-en.pdf). The Assistant Secretary General of the United Nations in charge of the Office of Legal Affairs on behalf of several IGOs (including WIPO) sent a letter in July 2018 to the ICANN Board stating its concerns after the final report of the PDP process (see [www.icann.org/en/system/files/correspondence/mathias-to-board-27jul18-en.pdf](http://www.icann.org/en/system/files/correspondence/mathias-to-board-27jul18-en.pdf)). 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](http://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](http://gac.icann.org/sessions/icann63-agenda-item-3-curative-rights-protection-mechanisms).

<sup>53</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 [archive.icann.org/en/topics/new-gtlds/gac-principles-regarding-new-gtlds-28mar07-en.pdf](http://archive.icann.org/en/topics/new-gtlds/gac-principles-regarding-new-gtlds-28mar07-en.pdf). See also [gac.icann.org/contentMigrated/icann63-barcelona-communique](http://gac.icann.org/contentMigrated/icann63-barcelona-communique).

<sup>54</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 [newgtlds.icann.org/en/applicants/agb/base-agreement-specs-04jun12-en.pdf](http://newgtlds.icann.org/en/applicants/agb/base-agreement-specs-04jun12-en.pdf) at Specification 5.

<sup>55</sup> See [newgtlds.icann.org/en/applicants/agb/evaluation-procedures-04jun12-en.pdf](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".

<sup>56</sup> See [newgtlds.icann.org/en/applicants/agb/evaluation-procedures-04jun12-en.pdf](http://newgtlds.icann.org/en/applicants/agb/evaluation-procedures-04jun12-en.pdf), from section 2.2.1.4.2 "Geographic Names Requiring Government Support".

34. 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>57</sup>.

35. Concerning possible future New gTLD rounds, discussions on such topic are occurring in a so-called Work Track 5 “cross community” working group<sup>58</sup>.

36. 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>59</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>60</sup>. 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 delegations<sup>61</sup>. It is anticipated that a similar process may be used for country names at the second level (currently blocked).

37. 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>62</sup> The Secretariat will continue to monitor these developments and provide input where appropriate.

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

[End of document]

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<sup>57</sup> See [www.icann.org/en/system/files/correspondence/gac-to-board-27mar14-en.pdf](http://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 [www.icann.org/en/system/files/correspondence/gac-to-board-11apr13-en.pdf](http://www.icann.org/en/system/files/correspondence/gac-to-board-11apr13-en.pdf). Concerning the .amazon application, see [www.icann.org/resources/pages/irp-amazon-v-icann-2016-03-04-en](http://www.icann.org/resources/pages/irp-amazon-v-icann-2016-03-04-en), also on December 18, 2018 the Chair of the ICANN Board of Directors informed the Member States of the ACTO that their Reconsideration Request using ICANN’s Accountability Mechanisms is currently being processed (see [www.icann.org/en/system/files/correspondence/chalaby-to-mendoza-18dec18-en.pdf](http://www.icann.org/en/system/files/correspondence/chalaby-to-mendoza-18dec18-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 currently subject to further ICANN discussions. See [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](http://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>58</sup> See [gac.icann.org/activity/new-gtlds-geographic-names-as-tlds-wt5](http://gac.icann.org/activity/new-gtlds-geographic-names-as-tlds-wt5). See paragraph 10.

<sup>59</sup> 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](http://www.icann.org/en/system/files/files/two-character-ltr-ltr-authorization-release-13dec16-en.pdf).

<sup>60</sup> See [forum.icann.org/lists/comments-proposed-measures-two-char-08jul16/pdfECmcS9knuk.pdf](http://forum.icann.org/lists/comments-proposed-measures-two-char-08jul16/pdfECmcS9knuk.pdf).

<sup>61</sup> See [static.ptbl.co/static/attachments/193221/1541537228.pdf?1541537228](http://static.ptbl.co/static/attachments/193221/1541537228.pdf?1541537228). See also 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](http://www.wipo.int/edocs/mdocs/sct/en/sct_39/sct_39_7.pdf).

<sup>62</sup> See e.g., documents SCT/37/4, SCT37/5, SCT38/3, SCT39/5, SCT40/4, and SCT41/5. See also meeting SCT/IS/GEO/GE/17.