

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

Forty-Third Session
Geneva, March 23 to 26, 2020

UPDATE ON TRADEMARK-RELATED ASPECTS OF THE DOMAIN NAME SYSTEM

Document prepared by the Secretariat

1. At the forty-second 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/42/3 (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/42/8). Accordingly, the Secretariat has prepared the present document which offers the requested update.

I. DOMAIN NAME CASE ADMINISTRATION

A. Uniform Domain Name Dispute Resolution Policy

2. The DNS raises a number of challenges for the protection of Intellectual Property (IP), which, due to the global nature of the Internet, call for an international approach. WIPO has addressed these challenges since 1998 by developing specific solutions, most notably in the First¹ and Second² WIPO Internet Domain Name Processes. Through the Arbitration and

¹ The Management of Internet Names and Addresses: Intellectual Property Issues – Final Report of the First WIPO Internet Domain Name Process, WIPO publication No. 439, also available at: www.wipo.int/amc/en/processes/process1/report.

² The Recognition of Rights and the Use of Names in the Internet Domain Name System – Report of the Second WIPO Internet Domain Name Process, WIPO Publication No. 843, also available at: www.wipo.int/amc/en/processes/process2/report.

Mediation Center (Center), WIPO provides trademark owners with efficient international mechanisms to deal with the bad-faith registration and use of domain names corresponding to their trademark rights. The principal mechanism administered by the Center, the Uniform Domain Name Dispute Resolution Policy (UDRP) was adopted by ICANN on the basis of recommendations made by WIPO in the First WIPO Internet Domain Name Process.

3. The UDRP is limited to clear cases of bad-faith, abusive registration and use of domain names and remains in high demand for trademark owners³. Since December 1999, the Center has administered over 46,000 UDRP-based cases⁴. Trademark holders in 2019 filed 3,693 UDRP-based complaints with the Center, an increase over 2018 filing (already a record at the time), and the fourth consecutive year that WIPO domain name case filings have surpassed 3,000. By January 2020, the total number of domain names in WIPO UDRP-based cases brought by brand owners surpassed 85,000.

4. A diverse mixture of enterprises, institutions, and individuals used the Center's domain name dispute resolution procedures in 2019. The top sectors for complainant business activity were Biotechnology and Pharmaceuticals, Internet and Information Technology, Banking and Finance, and Fashion. Nowadays, filings from rights owners include alleged fraudulent email or phishing schemes, impersonation, and other illicit uses of consumer-facing websites (e.g., counterfeits) associated with the disputed domain names. More recently, cases have involved so-called homographic variations of trademarks with cybersquatters registering internationalized domain names (IDNs) which appear to be in "standard" Latin ASCII Script but employ IDN variations to trick users (*i.e.*, profiting from visual similarity between different characters). Reflecting the global scope of this dispute mechanism, named parties to WIPO cases from UDRP inception through 2019 represented 180 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 28 languages⁵.

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

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 parties⁸, as well as meetings

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

⁴ The Center makes available online real-time statistics to assist WIPO UDRP case parties and neutrals, trademark attorneys, domain name registrants, domain name policy makers, the media, and academics. Available statistics cover many categories, such as "areas of complainant activity", "domain name script", and "25 most cited decisions in complaint". See www.wipo.int/amc/en/domains/statistics.

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

⁶ See www.wipo.int/amc/en/domains/search/overview3.0/. The increased scope of WIPO Overview 3.0 since publication of version 2.0 in 2011 reflects a range of DNS and UDRP case evolutions in the near doubling of cases managed by the Center since then. The WIPO Overview is instrumental in developing and maintaining consistency of WIPO UDRP jurisprudence.

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

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

of its Domain Name Panelists. In 2019, the UDRP turned 20 and the Center hosted a conference in Geneva to commemorate this milestone. The event both took stock and looked ahead in terms of UDRP jurisprudence, relevant Internet developments, and a range of other topical items such as platform ADR models⁹.

B. Country Code Top-Level Domains (ccTLDs)

7. The application of the UDRP is mandated for domain names registered in generic Top Level Domains (gTLDs) (such as .com) and more recently introduced New gTLDs. The Center however also assists ccTLD registries in their establishment of registration conditions and dispute resolution procedures that conform with international best practices in registry management and IP protection. Some ccTLD registries adopt the UDRP directly, while others have adopted UDRP-based procedures which take account of relevant national considerations. The Center provides domain name dispute resolution services to nearly 80 ccTLD registries, having commenced such services for .CN and .中国 (China) as well as for .UA and .COM.UA (Ukraine) in 2019, and with further additions expected¹⁰.

8. With further reference to WIPO's ccTLD assistance, in 2019 the Center collaborated with the Registry .MX to promote efficiency and reduce environmental waste by updating the dispute resolution regulations applicable to .MX¹¹ to allow for paperless submissions¹². With the same aim, the Center assisted SWITCH (the registry for .CH and .LI domain names) with updating the Rules of Procedure for Dispute Resolution Procedure for .CH and .LI Domain Names.

9. For all WIPO-serviced ccTLDs, the Center in 2019 significantly expanded its posted party resources, including by producing information on eligibility criteria for registration and multilingual model pleadings and filing information¹³, as well as summaries of relevant differences between the respective ccTLD policies and the UDRP¹⁴. Building on these resources, a side event was held at the 59th WIPO Assemblies in 2019 where inter alia the new "Guide to WIPO's services for country code Top-Level Domain registries" was launched¹⁵.

II. POLICY DEVELOPMENTS IN THE DOMAIN NAME SYSTEM

10. A number of policy developments in relation to ICANN present both opportunities and challenges for owners and users of IP rights. One is ICANN's introduction of 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.

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

¹⁰ The full list of ccTLDs which have retained the Center as domain name dispute resolution provider is available at www.wipo.int/amc/en/domains/cctld. Since mid-2017, the Center provides services for .eu and .eю (cyrillic script) registrations, in all 24 official EU languages, and also for the .SE (Sweden) registry. 2018 saw the addition of the ccTLD registries of .AI (Anguilla), .GE (Georgia), and .PY (Paraguay).

¹¹ Reglamento and Reglamento Adicional de la OMPI

¹² See <https://www.wipo.int/amc/en/new/mx.html>.

¹³ 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.

¹⁴ See www.wipo.int/amc/en/domains/cctld/.

¹⁵ See <https://www.wipo.int/publications/en/details.jsp?id=4458>.

A. NEW GTLDS

11. ICANN implementation of its New gTLD Program, formally approved in June 2011¹⁶, was detailed in its iterative “Applicant Guidebook”¹⁷. 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 2019¹⁸ only a few (e.g., “.music”) remain to launch. Together, these New gTLDs appear to have so far attracted some 32 million second-level registrations¹⁹. ICANN is expected to conclude its “New gTLD Subsequent Procedures Policy Development Process” (PDP) possibly in 2020, and following several layers of approval, it plans to launch another New gTLD application round.

12. The Center remains committed to working with stakeholders to attempt to safeguard the observance of general principles of IP protection in New gTLDs. A number of RPMs specifically created for New gTLDs had emerged from a series of ICANN processes²⁰. Set out below is a broad description of these ICANN RPMs, for the top level and the second level respectively.

(a) Top Level RPMs

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

13. This mechanism allowed trademark owners to lodge Legal Rights Objections (LRO) to New gTLD applications at the top level where certain substantive criteria were met²¹. 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”²².

14. Appointed by ICANN as the exclusive provider of LRO dispute resolution services²³, the Center received 69 compliant LRO filings, which it completed processing by September 2013²⁴. All WIPO LRO expert panel determinations are available on the Center’s website²⁵ as is a Center report on the LRO process²⁶. It is expected that a similar procedure would be available for subsequent New gTLD rounds.

¹⁶ See www.icann.org/en/minutes/resolutions-20jun11-en.htm. For further background including references, see document WO/GA/39/10, in particular paragraph 14.

¹⁷ ICANN’s Applicant Guidebook is available at newgtlds.icann.org/en/applicants/agb.

¹⁸ Delegated New gTLDs are listed at newgtlds.icann.org/en/program-status/delegated-strings.

¹⁹ See ntldstats.com.

²⁰ 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”.

²¹ 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.

²² Adopted by the WIPO General Assembly in September 2001; see www.wipo.int/edocs/pubdocs/en/marks/845/pub845.pdf.

²³ See section 3.2 of the ICANN Applicant Guidebook at newgtlds.icann.org/en/applicants/agb/objection-procedures-04jun12-en.pdf.

²⁴ See WIPO Rules for New gTLD Dispute Resolution, and Schedule of Fees and Costs, respectively at www.wipo.int/amc/en/docs/wipolrorules.pdf and www.wipo.int/amc/en/domains/lro/fees/; see WIPO-registered LRO cases at www.wipo.int/amc/en/domains/lro/cases/.

²⁵ See www.wipo.int/amc/en/domains/lro/cases/.

²⁶ 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.

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

15. In early 2009, the Center communicated to ICANN a specific substantive proposal for a permanent administrative option that would allow for the filing of a complaint with respect to an approved New gTLD registry operator whose manner of operation or use of its registry is alleged to cause or materially contribute to trademark abuse²⁷. 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-harbors²⁸.

16. Following various ICANN processes, including consultations with registry operators, the effectiveness of this PDDRP in the form adopted by ICANN remains uncertain, in particular given the addition of overlapping procedural layers, and issues concerning the intended substantive scope of this mechanism (notably by ICANN having excluded the legal concept of "wilfull blindness"). In light of broader policy interests however, the Center in 2013 agreed with ICANN to become a provider for the trademark PDDRP²⁹.

(b) Second Level RPMs

(i) Trademark Clearinghouse (TMCH)

17. 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 RPMs³⁰. 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 the latest available information, it appears that the TMCH has received some 45,000 entries³¹.

²⁷ See www.wipo.int/amc/en/docs/icann130309.pdf.

²⁸ Given the perceived convergence of registry, registrar, and registrant roles within the DNS, the Center has further recommended, *inter alia* taking account of its UDRP-based experiences, and of ICANN's decision to allow for cross-ownership between registries and registrars (see www.icann.org/en/minutes/resolutions-05nov10-en.htm), that ICANN consider extending the PDDRP for registries also to registrar conduct (see, *inter alia*, www.wipo.int/amc/en/docs/icann260310rap.pdf).

²⁹ To date no cases appear to have been filed under the PDDRP.

³⁰ 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 gtdresult.icann.org/applicationstatus/applicationdetails:downloadapplication/1343?t:ac=1343).

³¹ See www.trademark-clearinghouse.com/content/tmch-stats.

(ii) Uniform Rapid Suspension (URS) System

18. While importantly the UDRP remains available as a curative tool for New gTLD disputes involving the considered transfer of a disputed domain name to the trademark owner, ICANN has introduced what is intended to be a lighter second-level RPM for appropriate cases³².

19. Having evolved from a sequence of ICANN processes and committees, the URS continues to raise a number of questions, including its relationship to the UDRP³³. 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 apply³⁴. The Center continues to closely monitor developments, including as to any evolution of the remedy offered by the URS procedure and, whether by contractual amendment or policy process, its potential applicability to incumbent TLDs such as “.com”. In December 2019, ICANN upheld its determination to include the URS procedure in the renegotiated .org Registry Agreement³⁵.

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

20. Accommodating the dynamic development of the DNS, the UDRP has been offering an effective alternative to court litigation for trademark owners, domain name registrants, and registration authorities. Nevertheless, following discussions in 2011 at which the clear majority of participants were of the opinion that more harm than good could result from any review of the UDRP by ICANN as a registration-driven body³⁶, 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 questions³⁷. 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 early 2020) is focused on RPMS developed for the New gTLD Program, notably the TMCH (including “Sunrise” and “Claims” RPMS)³⁸ and URS, whereas Phase II (possibly to begin in early 2020) will focus on the UDRP³⁹. This is a matter of serious concern, noting also the accreditation by ICANN of yet another new UDRP provider and the uncertainty of how the UDRP may evolve in this ICANN process. The Center continues to closely follow ICANN stakeholders’ intentions with regard to the UDRP and trademark RPMS generally. In this effort, the Center where relevant is in contact with trademark stakeholders such as ECTA, INTA, and MARQUES, in addition to ICANN.

³² The Center for its part communicated to ICANN in April 2009 a discussion draft of an “Expedited (Domain Name) Suspension Mechanism”, (see www.wipo.int/amc/en/docs/icann030409.pdf) and has made subsequent proposals for a streamlined mechanism based on this model at ICANN Meetings (see prague44.icann.org/node/31773 and toronto45.icann.org/node/34325). Such proposals took account of the need to strike a balance between the protection of trademark rights recognized by law, the practical interests of good-faith registration authorities to minimize operational burdens, and the legitimate expectations of *bona fide* domain name registrants.

³³ 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.

³⁴ 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).

³⁵ See <https://www.icann.org/resources/board-material/resolutions-2019-12-12-en#1.b>.

³⁶ See community.icann.org/display/gnsoudrpdtd/Webinar+on+the+Current+State+of+the+UDRP; see also more generally document WO/GA/39/10, paragraph 31.

³⁷ See gnso.icann.org/en/issues/new-gtlds/rpm-prelim-issue-09oct15-en.pdf.

³⁸ See footnote 25.

³⁹ See gnso.icann.org/en/issues/new-gtlds/rpm-final-issue-11jan16-en.pdf.

C. PRIVACY REGULATION AND THE WHOIS DATABASE

21. There is an increased focus on privacy and data regulation, for example the European Union's General Data Protection Regulation (GDPR)⁴⁰ which came into force on May 25, 2018. As stated by the European Commission, the overarching aim of the GDPR is to address privacy and data concerns, whereby these aims must be measured against legitimate third-party interests such as those relating to contracts and legal disputes.

22. After May 25, 2018, publicly-available Whois data 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. In addition to these limited options, 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. An ICANN "Temporary [contract] Specification" for gTLD Registration Data expressly acknowledges that registrars must provide full "Registration Data" to UDRP providers⁴¹. 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" criteria⁴², such that registrars have been required to provide Whois data to UDRP providers.

23. The Center continues to closely monitor the impact of the GDPR on UDRP proceedings. Separate from the Center's UDRP function, with a view to addressing broader IP enforcement concerns occasioned by GDPR implementation, 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 access⁴³.

D. IDNS

24. As observed in paragraph 21, another noteworthy policy development in the DNS is the introduction of IDNs (non-Latin script) at the top level⁴⁴. Many of these were among the first new gTLDs announced by ICANN for delegation in the DNS root zone.

E. OTHER IDENTIFIERS

25. In addition to and in connection with the above, there are further developments taking place at ICANN in relation to the protection of non-trademark identifiers.

⁴⁰ 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).

⁴¹ See www.icann.org/resources/pages/gtld-registration-data-specs-en, at Annex F.

⁴² 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/.

⁴³ 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

⁴⁴ See also ICANN's Final Implementation Plan for IDN ccTLD Fast Track Process published in November 2009 (see www.icann.org/en/system/files/files/idn-ccTLD-implementation-plan-16nov09-en.pdf). Since then, this has allowed for the introduction of IDN ccTLDs, associated with the two-letter codes in the ISO 3166-1 standard (see www.iso.org/iso/english_country_names_and_code_elements).

(a) International Governmental Organizations (IGOs)

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

27. The 2002 WIPO General Assembly recommended amending the UDRP in order to provide protection for country names and for the names and acronyms of IGOs⁴⁵. The WIPO Secretariat transmitted these recommendations to ICANN in February 2003⁴⁶.

28. Following ICANN deliberations⁴⁷, 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 gTLDs⁴⁸. The GAC further advised the ICANN Board that, building on existing criteria for ".int" second-level registrations, it would collaborate with IGOs to develop a list of IGO names and acronyms to be protected against registration for at least the current round of new gTLDs. The GAC also advised the ICANN Board that pending implementation work, interim protection for IGO names and acronyms should be provided through a moratorium on third-party registration; while progress is being made on implementation, this moratorium remains in place.

29. The ICANN Board responded to the GAC indicating that it had adopted a resolution for interim protection at the second level based on the existing .int criteria, *via* an ICANN reserve list of IGO identifiers, to be withheld from third-party registration through the new gTLD Registry Agreement. ICANN invited qualifying IGOs to identify themselves to ICANN, while also seeking provision by the GAC (with IGOs) of a consolidated IGO package comprising the criteria and list of IGO names and acronyms for which the GAC advised protection⁴⁹. 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 criteria⁵⁰, together with a list of protectable IGO names and acronyms⁵¹.

30. On April 1, 2013, the Board expressed concerns to the GAC on how to reconcile protection of IGO acronyms with certain potentially legitimate third-party attempts to register corresponding domain names and asked how cases of potentially legitimate co-existent use of such acronym could be managed in practice⁵². 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

⁴⁵ See www.wipo.int/edocs/mdocs/govbody/en/wo_ga_28/wo_ga_28_3.pdf; see also documents SCT/9/8, paragraphs 6 to 11; and, SCT/9/9, paragraph 149.

⁴⁶ See www.wipo.int/amc/en/docs/wipo.doc.

⁴⁷ For background, see WO/GA/41/17 Rev.2, in particular paragraphs 40 and 41.

⁴⁸ See

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

⁴⁹ See www.icann.org/en/system/files/correspondence/crocker-to-dryden-16jan13-en.pdf.

⁵⁰ Such criteria comprise treaty-based IGOs with international legal personality, or which are UN Observers, or which are funds or programs of the UN.

⁵¹ See www.icann.org/en/news/correspondence/dryden-to-crocker-chalaby-22mar13-en.

⁵² 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.

DNS⁵³. 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 meeting⁵⁴.

31. In October 2013 the NGPC made a proposal for protection of IGO acronyms at the second level that fell short of providing IGO acronyms with the permanent preventative protection envisaged in previous GAC Communiqués⁵⁵.

32. In parallel to the policy efforts undertaken by the NGPC, the GAC, and IGOs⁵⁶, the GNSO had launched a PDP concerning IGO protection, in which process the Center with other IGO representatives participated. Over IGO objections, this GNSO process largely rejected calls for preventative protection for IGO acronyms at the second level. Instead, it recommended a curative protection mechanism for IGO acronyms, coupled with the removal of the temporary protections for IGO acronyms in place. These recommendations were adopted unanimously by the GNSO Council in November 2013. In April 2014, the ICANN Board resolved to adopt the GNSO Council recommendations not in conflict with GAC advice, namely reserving from registration the full names of IGOs at the top and second levels in two languages.

33. Despite GAC advice and IGO positions, in June 2014, the GNSO Council voted to initiate a second PDP on the desirability and modalities of giving IGOs access to curative RPMs (such as the UDRP or URS) to address abusive registration of IGO acronyms, or of IGO full names not covered by the aforementioned exclusion. The majority of the resulting final Working Group recommendations, approved by the GNSO Council on a non-unanimous basis and sent to ICANN's Board for consideration, have caused concerns for IGOs and the GAC. With respect to a recommendation concerning IGO immunities, owing to a number of factors, the GNSO Council, in consultation with the GAC and IGOs, has meanwhile expressed an intention to re-charter a new Working Group to resolve the key outstanding policy question of IGO access to a curative RPM⁵⁷. 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 DNS⁵⁸. Together with other involved IGOs, the Center continues to closely monitor developments in this longstanding ICANN file. Ultimately, the current intention to initiate a further PDP aims to avoid the ICANN Board needing to reconcile differences between GAC Advice and GNSO recommendations as to IGO-related RPMs.⁵⁹

⁵³ 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](https://www.icann.org/meetings/durban2013/presentation-gac-communique-18jul13-en.pdf).

⁵⁴ See www.icann.org/resources/board-material/resolutions-new-gtld-2013-07-17-en#1.a.

⁵⁵ The GAC and the NGPC had cancelled their participation in a September 30 meeting proposed by IGOs.

⁵⁶ For a more complete summary see document WO/GA/48/12 Rev., paragraphs 42 to 45.

⁵⁷ See <https://gac.icann.org/contentMigrated/icann66-montreal-communique>.

⁵⁸ See www.icann.org/en/system/files/files/resolutions-abudhabi60-gac-advice-scorecard-04feb18-en.pdf.

⁵⁹ See www.icann.org/resources/pages/igo-ingo-protection-policy-2018-01-16-en,

www.icann.org/resources/board-material/resolutions-2018-02-04-en#2.d, and

www.icann.org/en/system/files/files/resolutions-abudhabi60-gac-advice-scorecard-04feb18-en.pdf. The Assistant Secretary General of the United Nations in charge of the Office of Legal Affairs on behalf of several IGOs (including WIPO) sent a letter in July 2018 to the ICANN Board stating its concerns after the final report of the PDP process (see www.icann.org/en/system/files/correspondence/mathias-to-board-27jul18-en.pdf). In response, members of the PDP Working Group defended the outcome of the report in a letter sent in August 2018 to the ICANN Board (see www.icann.org/en/system/files/correspondence/igo-ingo-wg-to-icann-board-16aug18-en.pdf). See further discussion at ICANN's October 2018 meeting, at gac.icann.org/sessions/icann63-agenda-item-3-curative-rights-protection-mechanisms.

(b) Geographical Terms

34. Concerning geographical terms, the GAC in particular has expressed concerns about their use and protection in the new gTLDs⁶⁰. Concerning the top level⁶¹, 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 round⁶²." 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 authorities⁶³.

35. GAC members have expressed further reservations regarding a number of new gTLD applications on grounds of correspondence to geographical or other "sensitive" terms, advising the ICANN Board not to proceed beyond initial evaluation, and seeking Board clarification on scope for applicants to modify their new gTLD applications to address specific GAC concerns⁶⁴.

36. Concerning possible future New gTLD rounds, a so-called Work Track 5 "cross community" working group has submitted a Final Report to the New gTLD Subsequent Procedures PDP Working Group on the subject of geographic names at the top level⁶⁵. While overall ICANN's next application round appears likely to maintain the status of the 2014 round, the broader subject of geographical names remains a topic of interest to a number of ICANN stakeholders, including governments and potential applicants.

37. In December 2016, ICANN authorized the release of all previously-reserved 2-character domain names at the second level in new gTLDs provided that registry operators first allow respective governments a thirty-day period to acquire such domain names; require registrants to represent that they would not falsely imply government affiliation in connection with the use of such 2-character domain name; and provide a means for post-registration complaints⁶⁶. 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

⁶⁰ In 2007, the GAC issued the "GAC Principles regarding New gTLDs", which states *inter alia* that ICANN should avoid delegation of New gTLDs concerning country, territory or place names, and regional language or people descriptions, unless in agreement with the relevant governments or public authorities. Those GAC Principles further stated that new registries should adopt procedures for blocking/challenge of names with national or geographical significance at the second level upon demand of governments. See archive.icann.org/en/topics/new-gtlds/gac-principles-regarding-new-gtlds-28mar07-en.pdf. See also gac.icann.org/contentMigrated/icann63-barcelona-communicue.

⁶¹ 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 at Specification 5.

⁶² See newgtlds.icann.org/en/applicants/agb/evaluation-procedures-04jun12-en.pdf, from section 2.2.1.4.1 "Treatment of Country or Territory Names".

⁶³ See newgtlds.icann.org/en/applicants/agb/evaluation-procedures-04jun12-en.pdf, from section 2.2.1.4.2 "Geographic Names Requiring Government Support".

⁶⁴ See www.icann.org/en/system/files/correspondence/gac-to-board-27mar14-en.pdf, at "4. Specific Strings". While the Board accepted the GAC's advice against proceeding with certain applications, it had sought further information from the GAC, as well as public comments, on a range of additional safeguards sought by the GAC concerning several broad categories of new gTLD applications such as for those new gTLDs which correspond to regulated industries or dictionary terms. See www.icann.org/en/system/files/correspondence/gac-to-board-11apr13-en.pdf. Concerning the ".amazon" application, ICANN entered into a Registry Agreement in December 2019 granting Amazon EU S.à r.l. the authority to operate the .amazon new gTLD. See <https://www.icann.org/resources/agreement/amazon-2019-12-19-en>. A GAC Sub-group on Geographic Names (a Sub-group of the GAC Working Group on Future New gTLDs) has developed a draft document for future New gTLD rounds outlining several public policy aspects related to geographic names which is currently subject to further ICANN discussions.

⁶⁵ See <http://mm.icann.org/pipermail/gnso-newgtld-wg-wt5/attachments/20191022/c47fb9cf/WorkTrack5FinalReporttotheNewgTLDSubProPDPWG-22October2019-0001.pdf>.

⁶⁶ 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.

registrations in order to mitigate the potential for trademark abuse⁶⁷. 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 delegations⁶⁸. It is anticipated that a similar process may be used for country names at the second level (currently still blocked).

38. On these and other DNS-related issues, the Center has endeavored to apprise relevant sectors within the Secretariat, including in support of the work of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT)⁶⁹. The Secretariat will continue to monitor these developments and provide input where appropriate.

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

[End of document]

⁶⁷ See forum.icann.org/lists/comments-proposed-measures-two-char-08jul16/pdfECmcS9knuk.pdf.

⁶⁸ See the Survey of the existing state of play of geographical indications, country names, and other geographical terms in the domain name system prepared by the Center with the SCT Secretariat on March 12, 2018 that was submitted to the SCT/39/7, available at: www.wipo.int/edocs/mdocs/sct/en/sct_39/sct_39_7.pdf.

⁶⁹ 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.