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WIPO

SCT/S2/6
ORIGINAL: English
DATE: May 17, 2002

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

STANDING COMMITTEE ON THE LAW OF TRADEMARKS, INDUSTRIAL DESIGNS AND GEOGRAPHICAL INDICATIONS

Second Special Session on the Report of the Second WIPO Internet Domain Name Process

Geneva, May 21 to 24, 2002

THE PROTECTION OF COUNTRY NAMES IN THE DOMAIN NAME SYSTEM

Comments submitted by the Government of the Republic of South Africa

1. Further to document SCT/S2/3 entitled "The Protection of Country Names in the Domain Name System," the Secretariat received a submission from the Government of the Republic of South Africa on the topic concerned.

2. The submission of the Government of the Republic of South Africa is reproduced in the Annex.

3. The SCT is invited to note the contents of the Annex.

[Annex follows]

ANNEX

DEPARTMENT OF COMMUNICATIONS
REPUBLIC OF SOUTH AFRICA

Via Electronic Mail

May 17, 2002

Mr. Francis Gurry
WIPO Internet Domain Name Process
World Intellectual Property Organization
34 chemin des Colombettes, P.O. Box 18
1211 Geneva 20 Switzerland

RE: PROTECTION OF COUNTRY NAME DOMAIN NAMES

Dear Mr. Gurry:

The Special Session of the Standing Committee on the Law of Trademarks, Industrial Designs, and Geographic Indications (SCT), held on November 29 to December 4, 2001, discussed the issue of what protection, if any, should be given to domain names that are the same or similar to the names of sovereign states ("Country Names"). In the Report from that discussion, SCT/SI/6, several questions were posed to Member States concerning the scope of any such protection. The Republic of South Africa provides this response to the request in the Report.

During the WIPO Second Domain Name Process, the Republic of South Africa proposed that WIPO recommend the adoption of a policy and procedure that would fully protect domain names in the gTLDs that are the same as the names of sovereign states, by prohibiting registration of any such domain names except by or on behalf of the respective sovereign nations, and by providing a procedure to cancel any such domain names already registered. South Africa's comments are posted at
http://wipo2.wipo.int/process2/rfc/rfc2-comments/2000/msg00059.html and at
http://wipo2.wipo.int/process2/rfc/rfc3/comments/msg00099.html.

It is the position of the Republic of South Africa, as it stated in its WIPO2 comments, that second level domain names in all gTLDs that are the same as Country Names are valuable national assets belonging to the respective sovereign nations. The Country Names in the gTLDs, particularly the dot-com TLD, have the potential to be of substantial political and economic value, particularly to developing nations. When the original registration authorities began permitting registration of second level domain names on a first-come, first-served basis, primarily to private western corporations and individuals, the registrants participating in this "gold rush" appropriated these valuable assets of the sovereign nations, to which the registrants had no preexisting rights. Furthermore, the registrars of gTLDs had no right to give away the names of sovereign nations in the second level domain names to private entities acting without permission or authority of the nations whose names were registered. Therefore, registrants of second level domain names the

same as Country Names do not have and never had any legitimate claim to property rights in those domain names.

It is important to recognise that, largely due to the digital divide, this "gold rush" by entities in developed nations occurred at a time when many developing nations were unaware of the activities of these entities and how these activities would affect them. The governments of developing nations need to harness the power of the internet to promote a positive image of their country and to provide information on national resources and history, as well as to focus global attention on national and local businesses and resources for purposes of trade, tourism and investment, in an increasingly competitive global environment. It cannot be disputed that the primary internet sites utilised by individuals seeking information about particular countries would be domain names which are the same as the Country Names themselves, particularly at the dot-com gTLD. In developing countries, many nationals need the assistance of their governments to reach out into the global internet economy, since individually they lack the resources to create significant web site portals on their own. In contrast, in developed nations, there generally is a far lesser need for the sovereign to establish one national internet site that supports domestic businesses and the domestic economy and attracts global attention to the nation.

The Republic of South Africa notes that some Member States from developed countries, in their submissions on the SCT/SI/6 Questions on Geographic Terms, have stated that they do not see the need for protection of Country Name domain names, suggesting that the "existing owners" of Country Name domain names have property rights in these domain names since they were the first to register them. As noted above, the Republic of South Africa's position is that Country Name domain names are an inherent attribute of the respective sovereign nations. Therefore, the "land rush" registration of such domain names by entities not associated with the sovereign nations could grant no property right to the registrants.

While some Member States have argued that sovereign countries do not have rights to control the use of the names of their countries, it is the position of the Republic of South Africa that this argument misses the primary point. Rather, permitting a private entity to register a Country Name as a domain name grants to that registrant a global exclusive monopoly over use of the Country Name in that gTLD, including the right to exclude all others – including the sovereign nation itself – from using the Country Name as a domain name. Thus, the primary question is not "does the sovereign presently have an enforceable intellectual property right to exclude others from using the Country Name as a domain name?" but rather, "does a private registrant have an enforceable intellectual property right to monopolize the use of the Country Name as a domain name, including the right to exclude the sovereign from the use of its own name?" The answer to that question will almost invariably be "no," and the only argument in favor of allowing current registrants to retain Country Name domain names is simply that they were the first to register such domain names. But there is no rule of international intellectual property law that states that "first-come, first-served" should grant any entity monopoly rights to utilize a Country Name as a domain name. Thus, the fact that some entities were the first to register Country Name domain names should not give them any entrenched property right to such a significant asset.

The Republic of South Africa also notes it does not seek new intellectual property protection in general for the names of sovereign nations. Rather, any protection sought is limited to domain names. The Republic of South Africa believes that Country Name domain names already have limited intellectual property protection under Article 6*ter* of the Paris Convention for the Protection of Industrial Property, since Country Name domain names are the equivalent of "armorial bearings," "other State emblems," "official signs and hallmarks indicating control and

warranty," or "heraldic" symbols. The Republic of South Africa recognizes that this view has not been universally and definitely accepted. Thus, the Republic of South Africa's position is that Article 6*ter* of the Paris Convention should be clarified or amended to make explicit that Country Name domain names are protected and can be utilized only under the authority of the various sovereign nations. The Republic of South Africa believes that such limited intellectual property protection is warranted – whether as a clarification of existing law or as an amendment to ensure that Country Name domain names will be protected. Unlike with trademark use, in which Country Names generally are not protected and thus many entities can use the same Country Name in various combinations, the same is not true with domain names, where allowing an entity not associated with a sovereign nation to register the domain name of that sovereign nation *excludes* all others from using that Country Name and thus grants a *monopoly* on the use of the Country Name to the registrant.

The Republic of South Africa provides the following comments in response to the Questionnaire on the Protection of Country Names in the Domain Name System:

i. *How should the name of a country be identified and should both the long and short names of the countries be protected?*

Both the long and the short name should be protected. The Republic of South Africa believes that both the United Nations Terminology Bulletin and the ISO Standard 3166 should be utilized, including names that use variations based on punctuation, such as dashes, and in addition other terms by which countries are generally known should also be protected.

ii. *In what languages should Country Names be protected?*

Country Names should be protected at least in the official language(s) of the particular country and in the six working languages of the United Nations.

iii. *To what domains should any protection be extended?*

The protection should extend to all gTLDs, both new and existing.

iv. *How should any alleged acquired rights be treated?*

It is the position of the Republic of South Africa that the registration of a second level domain name the same as a Country Name constitutes a bad faith, abusive, misleading or unfair registration, because the registrants have no right to appropriate a valuable national asset that belongs to a sovereign nation. Moreover, the registrations, particularly by Western entities of the domain names of Country Names of developing nations to which the registrants have no ties or affiliations are particularly abusive, misleading as to source, and unfair and deceptive as false designations of origin. It cannot reasonably be disputed that the only reason that these registrants appropriated these domain names is to trade on the economic value of the Country Names of the sovereign nations, intending to attract for their own profit internet traffic seeking information about these nations. Thus, all existing Country Name domain names should be subject to cancellation.

v. *What mechanism should be used to implement protection?*

The Republic of South Africa suggests the ICANN's UDRP be modified to state that any sovereign nation has the right to bring an arbitration before an ICANN-authorised dispute resolution service provider against any registrant in a gTLD of a domain name in which the second level domain name is the same as the official or common name of the sovereign nation; that such arbitration shall be mandatory and binding and any such arbitral award shall be enforceable in all courts, and that if it is determined that the registrant's second level domain name is the same as the official or common name of the sovereign nation, the domain name shall be ordered transferred to the sovereign nation. If the registrant did not utilize the Country Name domain name as a bona fide provider of significant information concerning the country, then no compensation or dispensation should be provided to the registrant. However, if the arbitrator finds that the registrant did utilize the Country Name domain name as a bona fide provider of significant information concerning the country, the arbitrator should have the discretion to award to the registrant the following: (1) a small, reasonable monetary payment; and (2) request the sovereign nation to provide, for a reasonable period, a link on the home page of its website at the domain name, which links to any new website of the original registrant, if the arbitrator finds that the linked website is used for an appropriate purpose.

The Republic of South Africa also suggests that Article 6*ter* of the Paris Convention should be clarified or amended to make explicit that Country Name domain names are protected and can be utilized only under the authority of the various sovereign nations.

vi. *Should any protection extend to the exact Country Name only or also to misleading variations?*

The Arbitrator should have discretion to protect against misleading variations as well.

vii. *Should protection be absolute or should it be dependent upon a showing of bad faith?*

The protection for Country Names should be absolute, recognizing that the attempt to appropriate to a private party, unaffiliated with the sovereign, the economic value of that sovereign's name is per se bad faith, and should be treated as such.

For further information, please contact

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[End of Annex and of document]