

SCT/S2/INF/4 ORIGINAL:English DATE: May3,2002

WORLD INTELLECTUAL PROPERTY ORGANIZATION GENEVA

WIPO

STANDINGCOMMITTEEO NTHELAWOFTRADEMA RKS, INDUSTRIALDESIGNSA NDGEOGRAPHICALINDI CATIONS

SecondSpecialSession ontheReportoftheSeco ndWIPOInternetDomainNameProcess

Geneva, May 21 to 24, 2002

PAPERONTHEREPORT OFTHESECONDWIPO INTERNETDOMAINNAME PROCESS

Prepared, onbehalf of the Legal Advisers of the United Nations System, by Mr. Corell, Under -Secretary-General for Legal Affairs, The Legal Counsel of the United Nations and Submitted by the Secretariat

1. OnMay1,2002,Mr.Corell,Under -Secretary-GeneralforLegalAffairs,theLegalCounsel of theUnitedNations,presentedtheSecretariatwithaletterand apaperrepresenting the collective views of the LegalAdvisers of the UnitedNationsSystemon the problem of the unauthorized registration of Internet domain names incorporating the names or acronyms of international organizations. As the members of the eStandingCommittee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) had requested, at the first Special Session of the SCT, further evidence of the extent of the problem of the abusive registration, as domain names, of the names and acronyms of international organizations, the letter and paper of Mr. Corellis submitted by the Secretariat for the information of the second Special Session of the SCT.

2. TheletterandpaperofMr.CorellisreproducedintheAnnex.

[Annexfollows]

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POSTAL ADDRESS-ADRESSE POSTALE: UNITED NATIONS, N.Y. 10017 CABLE ADDRESS-ADRESSE TELEGRAPHIQUE: UNATIONS NEWYORK

REFERENCE.

1 May 2002

Dear Dr. Gurry,

RE: Paper submitted on behalf of the Legal Advisers of the United Nations System to the WIPO 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

I enclose a paper for submission, on behalf of the Legal Advisers of the United Nations System, to the Second Special Session of the WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographic Indications regarding the Report of the Second WIPO Internet Domain Name Process, to be held in Geneva, 21 through 24 May 2002.

The enclosed paper is the result of extensive collaboration among the Legal Advisers of the United Nations System and, accordingly, represents the collective views of the Legal Advisers on the problem of the unauthorized registration of Internet domain names incorporating the names, or abbreviations thereof, of international intergovernmental organizations. The paper also addresses the concerns of the Legal Advisers that the Internet Domain Name System presently has no viable process, including the UDRP, for resolving disputes concerning such unauthorized domain name registrations in which the status and the privileges and immunities of international intergovernmental organizations is fully respected. While recognizing the equally important concerns that any effective dispute resolution process respect international legal norms regarding fairness and due process, the paper submits, for consideration by the Standing Committee, the proposed outline of an appropriate dispute resolution process in these circumstances.

As I indicated at the meeting of the Legal Advisers in March, in addition to the submission of the enclosed paper, I plan to be in Geneva in order to address the Standing Committee on this important matter.

acerely.

Hans Corell Under-Secretary-General for Legal Affairs The Legal Counsel

Dr. Francis Gurry Assistant Director General Legal Counsel World Intellectual Property Organization 34, chemin des Colombettes 1211 GENÈVE 20 Switzerland (Suisse)

[Appendixfollows]

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APPENDIX

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PAPER

Submitted by Mr. Hans Corell Under-Secretary-General for Legal Affairs The Legal Counsel of the United Nations

On behalf of the Legal Advisers of the United Nations System

WIPO 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

1. The Legal Advisers of the United Nations system (hereinafter, "the Legal Advisers"), who include the Legal Advisers of the Organizations and Programmes that are listed in Annex I to this document, meet annually at the invitation of the Legal Counsel of the United Nations for the purposes of discussing matters of common interest, formulating common positions and approaches, where desirable or appropriate, and providing advice or recommendations in particular instances to various bodies within the United Nations. Between such annual meetings, the Legal Advisers maintain regular contact in order to facilitate coordinated approaches to common problems or issues.

2. For the past several years, at their annual meeting, the Legal Advisers have discussed the general question of the protection of the names and acronyms of the various organizations which they represent and the particular question of such protection in the context of the Internet Domain Name System. In this respect, they have followed closely developments within the World Intellectual Property Organization (WIPO) in relation to the protection of trademarks and other identifiers against abusive registration as domain names. A number of the organizations represented by the Legal Advisers, including the United Nations, participated in the Second WIPO Internet Domain Name Process by contributing comments detailing their experience as victims of abusive domain name registrations and expressing views on the way in which they considered that such abusive practices could best be sanctioned and discouraged.¹

¹ See the Report of the Second WIPO Internet Domain Name Process, *The Recognition of Rights and the Use of Names in the Internet Domain Name System*, Annex 1.

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At their annual meeting in March 2002, the Legal Advisers considered carefully the Report of the Second WIPO Internet Domain Name Process, The Recognition of Rights and the Use of Names in the Internet Domain Name System, ("the Second WIPO Report") and the developments within WIPO that have followed the publication of that Report. Following that consideration, and conscious that the time is drawing near for the WIPO Member States to form a position in relation to the various issues dealt with in the Report, including, in particular, the protection of the names and acronyms of international intergovernmental organizations against abusive domain name registrations, the Legal Advisers wish to offer, for the consideration of the WIPO Member States, their views on the question of the protection of one of the most fundamental attributes of the identity of the organizations which they represent, notably the names and acronyms of those organizations.

The Legal Advisers are of the view that the names of international 4. intergovernmental organizations, and well-known and non-confusing abbreviations thereof (e.g., "UNICEF"), are protected from abusive domain name registrations, at least in a commercial context, pursuant to Article 6ter of the Paris Convention for the Protection of Industrial Property, done at Stockholm in July, 1967 ("Paris Convention"), to Article 16 of the Trademark Law Treaty ("TLT"), done at Geneva 27 October 1994 (extending the protection afforded by the Paris Convention against registration of names and abbreviations of intergovernmental organizations as trademarks to protection against their registration as service marks), and to Article 2 of the Agreement on Trade-Related Aspects of Intellectual Property Rights ("TRIPS"), Annex 1C of the Marrakesh Agreement Establishing the World Trade Organization, done in Marrakesh, 15 April 1994 (incorporating the protections afforded under the Paris Convention). In particular, the Legal Advisers believe that the legal protections afforded to the organizations regarding abusive domain name registrations are and should be enforced by Member States on behalf of the organizations.

The Legal Advisers note that the registration of the names and acronyms of 5. international intergovernmental organizations as domain names by unauthorised parties, including registration and use of such domain names for misleading purposes, continues unabated. Annex II to this document sets out examples of registrations, which use the same name or acronym of international intergovernmental organizations without authorization. Two such examples may be repeated here as particularly egregious examples of abuse: unifem.org, referring to the acronym of the United Nations Development Fund for Women (UNIFEM) has been registered and has been used for a pornography site, as is caribredcross.org, referring to the Caribbean National Society of the Red Cross.²

² The International Federation of Red Cross and Red Crescent Societies (IFRC) is not represented in the meetings of the Legal Advisers. However, the Legal Advisers thought it appropriate to include this information for illustrative purposes. It may be noted that Article 53 of the First Geneva Convention contains a prohibition of the use of the designation "Red Cross".

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6. The Legal Advisers consider that, in the longer term, the issues of the deliberate, bad faith misrepresentation of identity and identifiers through domain name registrations raise significant questions of law and policy. Moreover, the Legal Advisers recognize the complexity of the issues involved.

The Legal Advisers also recognize the many benefits and advantages of the 7. Uniform Dispute Resolution Procedure (UDRP) for domain name disputes that was recommended by WIPO and adopted by the Internet Corporation for Assigned Names and Numbers (ICANN) for dealing with the abusive registration of trademarks as domain names by various entities, particularly private individuals and commercial entities. In particular, the Legal Advisers recognize that UDRP offers an effective, rapid and simple means of dealing with abusive domain name registrations at a relatively modest cost for most users of domain names. The Legal Advisers recall that, if a trademark owner elects to utilize the UDRP to resolve a claim of infringement by a domain name registrant, the registrant must submit to an administrative process - essentially arbitration - conducted by an ICANN-approved dispute resolution services provider, one of which is WIPO. Pursuant to such an administrative process, either party may file suit in a court of competent jurisdiction, either before the administrative process is commenced or after it has been concluded. Indeed, the U.S. courts have concluded that the courts are not bound by the results of an ICANN arbitration proceeding. Thus, any arbitral award under the UDRP, including one rendered by a WIPO arbitral tribunal, could be appealed to a competent national court by either party to the arbitration.

8 The Legal Advisers, therefore, do not believe that the UDRP provides appropriate protection for the names and acronyms of international intergovernmental organizations with regard to abusive domain name registrations. In the view of the Legal Advisers, it is necessary to modify UDRP in order to provide an immediate, fair and practical solution to the misleading, deceptive, dishonest or scandalous uses of domain names with which international intergovernmental organizations are confronted. In this respect, the Legal Advisers note that the UDRP at present requires a complainant to waive the immunity it is accorded under international law and submit to jurisdiction in respect of any national court action relating to a domain name registration, which is the subject of a complaint. Such immunity is an essential attribute of international intergovernmental organizations in international law, an attribute that, under international law, states have a responsibility to respect and protect. The Legal Advisers consider that, in order to respect the unique status of the organizations, the UDRP should be modified to cover abusive registrations of the names and acronyms of international intergovernmental organizations in a manner that would respect the immunity of such organizations and would not require an intergovernmental organization which is a party to a UDRP proceeding to submit to the jurisdiction of national courts following a UDRP arbitral proceeding.

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The Legal Advisers recognize, however, that with respect to the determination of civil rights and obligations, Article 14 of the International Covenant on Civil and Political Rights, as well as Article 6 of the European Convention on Human Rights, provide that everyone is entitled to a fair hearing by a competent, independent and impartial tribunal established by law and that respect for the privileges and immunities of international intergovernmental organizations should not deprive a losing party of the right to such a hearing. In this respect, the Legal Advisers propose the establishment of a special panel of appeal within the UDRP for the purposes of reviewing decisions rendered by UDRP arbitral tribunals in cases in which a party is an international intergovernmental organization. Thus, it is proposed that the UDRP should be amended to provide that such a panel be organized so as to provide an independent and impartial tribunal that would respect the status and privileges and immunities of international intergovernmental organizations that are parties to UDPR arbitral proceedings and would serve as a final and binding tribunal for the de novo review of decisions of UDRP arbitral tribunals in cases in which a party is an international intergovernmental organization. Such de novo review is warranted in order to ensure the full respect for the rights of the parties in such cases, in view of the summary nature of UDRP proceedings generally.

Hans Corell

Under-Secretary-General for Legal Affairs The Legal Counsel of the United Nations

Dated: 1 May 2002

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ANNEX I

List of Organizations and Programmes represented in the Meetings of the Legal Advisers of the United Nations System

The United Nations³

Food and Agriculture Organization of the United Nations (FAO)

International Bank for Reconstruction and Development International Development Association (IBRD/IDA)

International Civil Aviation Organization (ICAO)

International Finance Corporation (IFC)

International Fund for Agricultural Development (IFAD)

International Labour Organisation (ILO)

International Maritime Organization (IMO)

International Monetary Fund (IMF)

International Telecommunication Union (ITU)

United Nations Educational, Scientific and Cultural Organization (UNESCO)

United Nations Industrial Development Organization (UNIDO)

Universal Postal Union (UPU)

World Health Organization (WHO)

World Intellectual Property Organization (WIPO)

³ The United Nations is represented by the Under-Secretary-General for Legal Affairs, the Legal Counsel of the United Nations, located at the Headquarters of the United Nations in New York. A number of United Nations offices and subsidiary bodies of the Organization which have legal advisers or legal liaison offices are invited by the Legal Counsel to participate in the meetings, including specifically the United Nations Office at Geneva (UNOG), the United Nations Office at Vienna (UNOV), the International Trade Centre (UNCTAD/GATT), the United Nations Compensation Commission, the United Nations Conference on Trade and Development (UNCTAD), the United Nations Environment Programme (UNEP), the United Nations High Commissioner for Refugees (UNHCR), the United Nations Relief and Works Agency for Palestine Refugees in the Near East (UNRWA) and the United Nations University (UNU).

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ANNEX I – Page 2 List of Organizations and Programmes represented in the Meetings of the Legal Advisers of the United Nations System

World Meteorological Organization (WMO)

International Atomic Energy Agency (IAEA)

World Trade Organization (WTO)

Organization for the Prohibition of Chemical Weapons

Preparatory Commission for the Comprehensive Nuclear-Test-Ban Treaty Organization (CTBTO)

Bank for International Settlements (BIS/BRI/BIZ)

International Organization for Migration (IOM)

Secretariat of the Convention for Climate Change (UNFCCC)

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ANNEX II

Examples of Unauthorized Registrations of the Names and Acronyms of Intergovernmental Organizations as Domain Names

International Organization/Program	Domain Name	Use	Domain Name Holder
Food and Agriculture Organization of the United Nations (FAO)	http://www.fao.com/	Toy retailer	FAO Schwarz (USA)
Food and Agriculture Organization of the United Nations (FAO)	http://www.fao.lv/	TV, Design Gallery, E- cards	Latvian Portal
Food and Agriculture Organization of the United Nations (FAO)	http://www.fao.it/	Promotion of SMEs	ItaWeb
Food and Agriculture Organization of the United Nations (FAO)	http://www.fao.uci.edu/	Office of Financial Aid and Scholarships	University of California, Irvine
Food and Agriculture Organization of the United Nations (FAO)	http://www.fao.kiev.ua/	Fiscal Analysis Office	Ukraine
Food and Agriculture Organization of the United Nations (FAO)	http://www.fao.army.mil/	Foreign Arca Officer Program	US Army
Food and Agriculture Organization of the United Nations (FAO)	http://www.fao.ucla.edu/	Financial Aid Office	University of California, Los Angeles
Food and Agriculture Organization of the United Nations (FAO)	http://www.fao.com.au/	Rock Band	For Amusement Only
Food and Agriculture Organization of the United Nations (FAO)	http://www- fao.ucsd.edu/fao/fao.cfm	Financial Analysis Office	University of California, San Diego
Food and Agriculture Organization of the United Nations (FAQ)	http://www.faoindustrial.com	Industrial First Aid Supplies	First Aid Only (Industrial)
Food and Agriculture Organization of the United Nations (FAO)	http://www.fao.sc/	On hold	Sweden
International Civil Aviation Organization (ICAO)	icao.com	On Hold	Morochove & Associates Inc. (Canada)
International Civil Aviation Organization (ICAO)	icao.net	Informatique Conseil Assistance Opérations	ICAO (France)
International Labor Office (ILO)	ilo.com	ILO Electronic (commercial)	ILO electronic GmbH (Germany)
International Labor Office (ILO)	ilos.net	Interlink (commercial)	Interlink Online Services, Inc. (Canada)
International Labor Office (ILO)	internationallabour.net	On Hold	Michael J. Workman (USA)
International Labor Office (ILO)	internationallabour.org	On Hold	Michael Workman (USA)

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ANNEX II – Page 2 Examples of Unauthorized Registrations of the Names and Acronyms of Intergovernmental Organizations as Domain Names

International Organization/Program	Domain Name	Use	Domain Name Holder
International Labor Office (ILQ)	internationallabour.com	On Hold	Michael Workman (USA)
Office internationale de la vigne et du vin (OIV)	oiv.com	Outstanding Investor Digest (commercial)	Outstanding Investor Digest (USA)
Office internationale de la vigne et du vin (OIV)	oiv.net	Ultimate Search, Inc. (commercial)	Ultimate Search (Hong Kong)
Oficina de la Unión Europea (OAMI)	oami.com	Bad Gateway (host not found)	Hyun Bang (USA)
Preparatory Commission for the Comprehensive Nuclear-Test- Ban Treaty Organization (CTBTO)	clw.org/coalition/ctbindex.htm	Comprehensive Testban Treaty Site - Coalition to Reduce Nuclear Dangers	Council for a Liveable World (USA)
Preparatory Commission for the Comprehensive Nuclear-Test- Ban Treaty Organization (CTBTO)	ctbtcommission.org	Independent Commission on the Verifiability of the Comprehensive Nuclear- Test-Ban Treaty (CTBT)	Vertic (UK)
United Nations Childrens' Fund (UNICEF)	unicef.net	For Sale – Forwards.com diverts to InvestorsUniverse.com (commercial)	COMn.com (KR)
United Nations Childrens' Fund (UNICEF)	unicef.com	On Hold	Domain registered to Swiss entity – Swiss Govt. has commenced infringement action.
United Nations Organization (UN)	unitednations.com	Gateway Timeout (server not reachable)	John Black (Canada)
United Nations Organization (UN)	un.net	Non-authorized access	Paradise Productions Ltd (UK)
United Nations Organization (UN)	un-travel.com	Travel agency	U.N. Travel & Tours, Inc. (USA)
United Nations Organization (UN)	unitednations.net	On Hold	USA.Net, Inc. (USA)
United Nations Organization (UN)	un.com	On Hold	Simon Lee & Co. (USA)
United Nations Development Fund for Women (UNIFEM)	unifem.org	Adult City (sex site)	Triple Zero Networks (Estonia)
United Nations International Research and Training Institute for the Advancement of Women (INSTRAW)	instraw.com instraw.net instraw.org	On Hold	Potomac Hudson Engineering (USA)
United Nations Framework Convention on Climate Change (UNFCCC) – 5 th Conference of Parties (COP)	cop5.com	On Hold	Highland International Investment Limited – For Sale at DomainCollection.com (USA)
World Bank (International Bank for Reconstruction and Development)	Worldbank.net	On-Hold	Yoo Jin Sohn (individua located in Saipan)

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ANNEX II – Page 3 Examples of Unauthorized Registrations of the Names and Acronyms of Intergovernmental Organizations as Domain Names

International Organization/Program	Domain Name	Use	Domain Name Holder
World Bank (International Bank for Reconstruction and Development)	Worldbank.it	Redirects user to personal address	Mr. Francesco Basile (individual located in Italy)
World Health Organization (WHO)	who.com	Who Weekly (online magazine)	Information Service/ Time Inc. (USA)
World Health Organization (WHO)	worldhealthorganization.com	Gerovital Direct (commercial)	Gerovital Direct LLC (UK)
World Health Organization (WHO)	worldhealthorganization.org	Sigma 7 Search Engine	DNS Research, Inc. (USA)
World Health Organization (WHO)	healthwho.com	Healthwho.com (online healthcare portal)	Healthwho.com, Pte Ltd (Singapore)
World Health Organization (WHO)	oms.org	Bad Gateway (host not found)	Oklahoma Metaphysical Society (USA)
World Trade Organization (WTO)	wto.com	Server Error	Acceleratelt.com, Inc. (USA)
World Trade Organization (WTO) – General Agreement on Tarrifs and Trade (GATT)	gatt.org	'World Trade Organization' (critical parody site)	Prince and Associates, Inc. (USA)
Caribredcross ⁴ (International Federation of Red Cross and Red Crescent Societies (IFRC) – Caribbean National Society)	caribredcross.org	Adult City (sex site)	'Domain for Sale' (Russian Federation)

⁴ The IFRC is an international organization whose name and insignia are protected, not under the Paris Convention, but under Article 53 of the Convention (I) for the Amelioration of the Condition of the Wounded and Sick in Armed Forces in the Field. Geneva, 12 August 1949 ('the First Geneva Convention').

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