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WORLD INTELLECTUAL PROPERTY ORGANIZATION
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**STANDING COMMITTEE ON THE LAW OF TRADE MARKS,
INDUSTRIAL DESIGN 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 Presented by the International Trademark Association (INTA) and
Submitted by the Secretariat*

1. On May 8, 2002, the International Trademark Association (INTA) provided the Secretariat with its comments on document SCT/S2/3 entitled "The Protection of Country Names in the Domain Name System." The comments of INTA are submitted by the Secretariat for the information of the second Special Session of the SCT.
2. The letter and comments of INTA are reproduced in the Annex.

[Annex follows]

ANNEX



International Trademark Association

1133 Avenue of the Americas, New York, NY 10036-6710 USA

Telephone: 212-768-9887 Fax: 212-768-7796

Via Electronic Mail

May 8, 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: "The Protection of Country Names in the Domain Name System"

Attention: David Muls

Dear Mr. Gurry:

The International Trademark Association ("INTA") takes this opportunity to provide comment to WIPO on the March 29, 2002 report prepared by the Secretariat on "The Protection of Country Names in the Domain Name System" ("the Report"). INTA's comments are limited to two specific areas: (1) our strong agreement with the Secretariat's recommendation that a dispute resolution procedure for country names be restricted to cases of bad faith and that its scope not be expanded to cases where both parties have a bona fide claim to a name and (2) the Association's continued belief that disputes concerning country names should not be added to the existing Uniform Dispute Resolution Policy ("UDRP") for trademarks and that a separate dispute resolution policy be established.

Founded in 1878, INTA is a not-for-profit organization consisting of over 4,000 members in 150 countries. The membership of INTA, which crosses all industry lines and includes both manufacturers and retailers, values the essential role trademarks play in promoting effective commerce, protecting the interests of consumers, and encouraging free and fair competition. INTA has been a participant in the deliberations of the Internet Corporation for Assigned Names and Numbers ("ICANN"), is a founding member of the ICANN Intellectual Property Constituency, and has been a respondent to previous WIPO RFCs on the intersection of intellectual property and domain names, including all of the requests in the Second WIPO Domain Name Process.

Scope of Procedure Limited to Bad Faith

INTA strongly agrees with the commendation of the Secretariat, that a dispute resolution procedure for country names be restricted to cases of bad faith and that its scope not be expanded to cases where both parties have a bona fide claim to a name, as set forth in paragraph 34 of the Report. The bad faith element and limited scope serve as cornerstones for the success of the existing trademark UDRP and dispute resolution procedures for country -code top -level domains around the world. These dispute resolution mechanisms act as a quick and inexpensive means for resolving only the most straightforward cases of domain name disputes. Attempting to resolve competing legitimate claims on names on the other hand requires a more in -depth analysis and presentation of claims. Resolving these types of disputes requires interviews, depositions, and surveys, just to name a few of the lengthy and costly elements that are involved. All of these combined ultimately defeat the purpose of an online dispute resolution procedure (whether it be for country names or trademarks) as a quick and inexpensive procedure.

INTA also strongly agrees with the Secretariat's recommendation in paragraph 38 of the Report that the scope of a dispute resolution procedure for country names should be limited in order to avoid the taking of acquired rights by national governments. There are many instances where domain name registrants have registered in good faith a name that includes the name of a country. For example, a country name could serve as part of a registered trademark (e.g. ISRAEL TODAY, U.S. Reg. No. 2486796; CANADA LIFE, U.S. Reg. No. 2526479; CANADA DRY, U.K. Reg. No. 1414534; AGENCE FRANCE PRESS, Canadian Trademark Reg. No. 170038; and CGS ITALIA & DESIGN, International Registration No. 135766). Surely, the intent is not to disrupt such uses -uses that have been examined by the governments themselves and deemed worthy of government sanctioned protection.

To further ensure that good faith uses are protected against unfair taking, INTA renews its suggestion that the following be deemed as legitimate rights or defenses to a cause of action initiated by a national government for the bad faith registration or use of the country name as a domain name: (1) being the first in time to register a country name so long as registrant is using the domain name or has the intent to use it in good faith for a legitimate purpose; (2) being the owner of a trademark that is also the name of a country; or (3) being an entity associated with that country. (See paragraph 11 of the Report.)

Establish a Separate Dispute Resolution Policy for Country Names

INTA strongly recommends against amending the scope of existing UDRP procedures to cover country names. INTA disagrees that adding country names to the existing UDRP is but a mere "technical adjustment" (paragraph 40.2). As acknowledged elsewhere in the Report, "legal entitlement of a country to its corresponding name, at the international level, is not firmly established..." (paragraph 34). This is a dramatic understatement. The re is no national or international consensus either on the nature or scope of such rights, and as a result, no jurisprudence to guide and inform the UDRP. In contrast, trademark rights are well established, with a highly developed jurisprudence and network of national laws and international treaties dating back over 100 years.

INTA recognizes the harm that can be suffered by countries when certain domain names incorporating their country names are registered or used in bad faith by others. However, INTA believes that the UDRP is a poor choice to burden with the pioneering mission of defining the nature and scope of rights in country names within the Internet addressing scheme. The UDRP

functions well now because its panelists are trained in trademark law and can draw upon a rich body of directly applicable jurisprudence to adjudicate disputes. In contrast, the UDRP and its panelists are ill-equipped to perform the global legislative function that adjudicating country name disputes would require. Assigning country named disputes to the UDRP could well result in an unintended disruption of the UDRP structure. It will certainly result in an unfortunate loss of focus on the UDRP's current narrow mission and would likely open the door to other types of domain name disputes (trade names, international nonproprietary names, or names of intergovernmental organizations), eventually becoming a dangerous slippery slope.

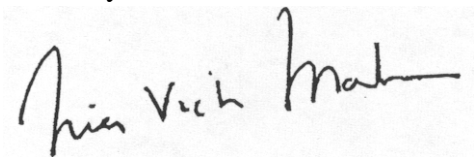
Agiven country's entitlement to register corresponding domain names, and prevent others from doing so (with, or absent bad faith), is an extension of that country's sovereignty into the Internet addressing scheme. Clearly, the UDRP is not equipped to decide issues of sovereignty. Which governmental agent or representative has proper standing on behalf of a given country to maintain a UDRP action (or register) with respect to a given name? If more than one complainant contests the same name, which has the greater right? What happens if the complainant and the respondent are both governmental entities, from the same, or different countries? At a fundamental level, any UDRP decision regarding a country defines an aspect of the sovereign rights of the subject country.

Accordingly, as was noted in INTA's February 26, 2002 response to the Secretariat, the Association endorses consideration of the tandem adoption of a dispute resolution mechanism to be used only to resolve matters concerning the bad faith registration or use of a country name as a domain name. The burden of establishing bad faith registration or use of a country name should rest with the government of the country claiming such bad faith, and because "legal entitlement of a country to its corresponding name, at the international level, is not firmly established," the level of bad faith that a national government must demonstrate to succeed in a dispute should at a minimum be equal to and, likely greater than, the level required under the trademark UDRP. The country named dispute resolution policy must also include legitimate rights or defenses to a cause of action initiated by a national government (see above).

Conclusion

Thank you for considering INTA's comments on matter of country names and domain names. INTA looks forward to continuing to work with WIPO, as well as within the ICANN process to address this topic.

Sincerely,



Nils Victor Montan
President

cc: National Trademark Offices of WIPO Member States

[End of Annex and of document]