

WIPO Briefing Note: The Second WIPO Internet Domain Name Process

Introduction

1. This note has been prepared by the World Intellectual Property Organization (WIPO) at the request of staff of the Internet Corporation for Assigned Names and Numbers (ICANN). It provides an informal summary of the recommendations made in the Second WIPO Internet Domain Name Process (“WIPO II Recommendations”) and as such is not intended to replace the Final Report of the Second WIPO Internet Domain Name Process¹ (“WIPO II Report”) or any of the documents of the meetings of WIPO Member States at which the findings of the WIPO II Report were discussed.

Background

2. The Second WIPO Internet Domain Name Process was initiated in July 2000 at the request of the Member States of WIPO.² It followed the first such WIPO Process, which investigated the interface between trademarks and Internet domain names and provided the basis for the Uniform Domain Name Dispute Resolution Policy (UDRP). The Second WIPO Internet Domain Name Process examined the bad faith and misleading registration and use by third parties of a range of identifiers other than trademarks, namely:

- International Nonproprietary Names (INNs) for pharmaceutical substances, a consensus-based naming system used in the health sector to establish generic names for pharmaceutical substances that are free from private rights of property or control;
- The names and acronyms of international intergovernmental organizations (IGOs);
- Personal names;
- Geographical identifiers, such as indications of geographical source used on goods, geographical indications, and other geographical terms;
- Trade names, which are the names used by enterprises to identify themselves.

3. Between July 2000 and May 2001, WIPO organized open and transparent online consultations on the basis of three Requests for Comments as well as physical meetings in 10 cities throughout the world.³ Written comments received and physical participation at the meetings involved 51 government agencies of 28 countries, 18 intergovernmental organizations and agencies, 44 non-governmental organizations, 201 corporations and professional firms and 184 individuals.⁴

4. The WIPO II Report was published on September 3, 2001. At the meeting of the WIPO General Assembly on September 24 to October 3, 2001, the Member States of WIPO decided to subject the WIPO II Report to a comprehensive analysis by the WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT), meeting in two Special Sessions for this purpose. The first Special Session was held from

¹ The Final Report is available at <http://arbiter.wipo.int/processes/process2/report/index.html>.

² See <http://arbiter.wipo.int/processes/process2/index.html>.

³ The process timetable is available at <http://arbiter.wipo.int/processes/process2/timetable/index.html>.

⁴ Details of the names of these entities and persons and of their participation in the various stages of the process are set out in Annex I to the WIPO II Report.

November 29 to December 4, 2001, the second from May 21 to 24, 2002. All working documents of the Special Sessions are available to the public.⁵

5. On the basis of recommendations made by the SCT, the Member States of WIPO passed the WIPO II Recommendations at the 2002 meeting of the WIPO General Assembly. In light of the present status of international law, the WIPO II Recommendations propose specific measures with regard to two types of identifiers only, namely the names and acronyms of IGOs and country names (being a special type of geographical identifiers).⁶ The text of these recommendations is set out in Annex I to this note. The following paragraphs summarize the background and the discussion leading up to the WIPO II Recommendations.

Names and Acronyms of International Intergovernmental Organizations

Existing International Protection

6. The existing basis for protecting the names and acronyms of IGOs in international intellectual property law is summarized in paragraphs 128 to 137 of the WIPO II Report:

“128. The existing international legal framework contains clearly expressed and widely accepted (through applicable constitutional processes) principles prohibiting the unauthorized commercial use, as trademarks, of the names and acronyms of IGOs.

“129. Article 6*ter* of the Paris Convention for the Protection of Industrial Property (the Paris Convention), to which 162 States [now: 168 States] are party, provides, *inter alia*:

‘(1)(a) The countries of the Union agree to refuse or to invalidate the registration, and to prohibit by appropriate measures the use, without authorization by the competent authorities, either as trademarks or as elements of trademarks, of armorial bearings, flags, and other State emblems, of the countries of the Union, official signs and hallmarks indicating control and warranty adopted by them, and any imitation from a heraldic point of view.

‘(b) The provisions of subparagraph (a), above, shall apply equally to . . . abbreviations, and names, of international intergovernmental organizations of which one or more countries of the Union are members, with the exception of . . . abbreviations, and names, that are already the subject of international agreements in force, intended to ensure their protection.’⁷

(...)

⁵ Available at http://www.wipo.int/documents/en/document/sct/index_s1.htm and http://www.wipo.int/documents/en/document/sct/index_s2.htm.

⁶ With regard to the other identifiers, the WIPO General Assembly decided to continue monitoring the situation (INNs, trade names), to continue the discussion in the SCT (geographical indications), or not to take any further action (personal names), see <http://arbitr.wipo.int/processes/sct/decision/index.html> as well as the summary in document WO/GA/30/2, available at http://www.wipo.int/documents/en/document/govbody/wo_gb_ga/index_30.htm.

⁷ The protection under Article 6*ter* does not extend to names, abbreviations and other emblems of intergovernmental organizations that are already the subject of international agreements intended to ensure their protection, such as the Geneva Convention (1949) for the amelioration of the condition of the wounded and sick in armed forces, Article 44 of which protects the emblems of the Red Cross, the words “Red Cross” or “Geneva Cross, and analogous emblems.” The object of this exception is to avoid possible overlap with provisions in other conventions that regulate on this subject.

“131. The Paris Convention, (Article *6ter* (1)(b)), accordingly prohibits the registration and use of, *inter alia*, the names or abbreviations of IGOs as trademarks or elements of trademarks. The Trademark Law Treaty of 1994 (Article 16) extends the same protection against registration and use with respect to service marks.

“132. The entitlement of an IGO to receive protection under these treaties is not automatic. Any name or abbreviation for which an IGO wishes to obtain protection must be communicated to the International Bureau (Secretariat) of WIPO, which will then transmit the communication to the States party to the Paris Convention. The protection available to IGOs under the Paris Convention thus depends entirely upon their submission of a request for communication to WIPO. WIPO maintains a notification list⁸ and performs the functions of determining the admissibility of such requests for communication under Article *6ter* and of forwarding the admissible communications to the States party to the Paris Convention.”

(...)

“136. The Paris Convention foresees that the use of IGOs’ insignia may be authorized, and permits States the choice whether to apply a further non-mandatory exception to its prohibitions against trademark registration and use, specifically in respect of the names, abbreviations and other emblems of IGOs. States are not required to apply such prohibitions when the registration or use of the trademark in question:

‘(i) is not of such a nature as to suggest to the public that a connection exists between the organization concerned and the . . . abbreviations, and names,’ or

‘(ii) is probably not of such a nature as to mislead the public as to the existence of a connection between the user and the organization.’

Many, but not all, States party to the Convention have enacted the exception in national legislation and, to this extent, there is divergence at the national level in the scope of protection granted to IGOs.

“137. The Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement) of the World Trade Organization (WTO) (Article 2), fully incorporates the protection provided under Article *6ter* of the Paris Convention and imposes these obligations on the (at present, 142 [now: 148]) States party to the Agreement, specifically referring to the ‘notifications pursuant to the obligations under this Agreement stemming from the provisions of Article *6ter* of the Paris Convention.’ ...

“138. The scope of existing international protection established by the treaty provisions discussed above may be summarized as follows:

- (i) The *registration* and *use*, as trademarks, service marks or elements thereof, of the names and abbreviations of IGOs is prohibited, except where such registration and use is authorized or falls within a permitted exception. Contracting Parties agree to refuse or invalidate any such registration of the names or acronyms of IGOs, and to prohibit their use by appropriate measures. The clear purpose is to ensure that these names and abbreviations remain free of the private proprietary rights.

⁸ A searchable database of all notifications received by countries and IGOs under Article *6ter* is available at <http://www.wipo.int/ipdl/en/search/6ter/search-struct.jsp>.

These provisions reflect the public status of IGOs, and seek to avoid any potential for confusion or deception that would interfere with that public status.

- (ii) The protection afforded by the treaties is directed against the registration and use of the names and abbreviations of IGOs as *trademarks* or *service marks*. It follows that, to the extent that a domain is the same as the name or acronym of an IGO and *is used as a trademark or service mark* (by, for example, constituting an identifier used for commercial purposes), the registration and use of the domain name is contrary to the provisions of the Paris Convention and the TRIPS Agreement (unless allowed under a permitted exception).
- (iii) The class of IGOs that may receive protection for their names and acronyms under the international treaties is strictly limited. Protection is granted only to those IGOs that have sent an admissible request for communication to WIPO, have not received an objection from any of the applicable Contracting States, and have had their names or acronyms notified accordingly. As noted above, only 91 such organizations received such protection since 1958, when this system was established.
- (iv) The protection granted to IGOs under the international treaties is subject to exception, when the registration or use of an IGO's name or abbreviation as a trademark or service mark is not of such a nature to suggest to the public that a connection exists with the organization concerned, or is "probably not of such a nature as to mislead the public as to the existence of a connection between the user and the organization." By analogy, the registration and use by third parties of the names or acronyms of IGOs as domain names might, in countries that recognize this exception, be considered permissible, if the registration and use of the domain name is unlikely to suggest to, or to mislead, the public that a connection with the IGO exists. One commentator noted, for example, that existing domain name registrants should be given the opportunity to defend their registration through the UDRP, on the same grounds set forth in Article 6ter (1)(c)."

7. The basis in international intellectual property law for protecting the names and acronyms of IGOs against the abusive registration as domain names is comparable to the basis for protecting trademarks against such abuses which is also largely based on norms of the Paris Convention and the TRIPS Agreement. In a strict sense, the WIPO II Recommendations may be regarded as going beyond Article 6ter of the Paris Convention which protects these identifiers against the registration or use as trademarks by recommending protection against the abusive registration or use as domain names.⁹ However, this is a necessary adaptation of legal norms that were created for the physical world to the special characteristics of the DNS.¹⁰

⁹ This explains the statement in paragraph 168 of the WIPO II Report: "It is recognized that the procedure recommended in the preceding paragraphs would involve, at least in cases not involving the use of domain names as trademarks, the creation of new international law. It would represent an extension of the principles in Article 6ter of the Paris Convention, the Trademark Law Treaty and the TRIPS Agreement."

¹⁰ The WIPO II Report therefore states in paragraph 155: "Extending the UDRP to protect the identifiers of IGOs would not require the creation of new law, but merely the reflection in the DNS of existing international legal principles for their protection."

8. The WIPO II Report summarizes the need for protection of the names and acronyms of IGOs against their abusive registration as domain names as follows:

“145. The significant majority of commentators to the Second WIPO Process were in favor of the recognition in the DNS of legal protection for the names and acronyms of IGOs.”

(...)

“148. Evidence was provided throughout the Second WIPO Process of a sizeable problem of abuse of the names and acronyms of IGOs in the DNS. Commentators described instances of abuse in the registration of their names or acronyms that had resulted in deception or confusion to the public, and that required constant and resource-wasting vigilance. These organizations expressed concern that unofficial web sites using a domain name that is identical or similar to their name or acronym may contain misleading, inaccurate or prejudicial information about the IGO, while leading the viewer to believe that he or she is visiting the organization’s official web site. The UN stated that, in dealing with such instances of abusive registrations, it has been required to constantly monitor the DNS and confront offending registrants one by one, committing substantial time and resources from various sectors of the Organization. The UN described the added complication in resolving these cases through available legal or administrative processes, because these procedures would inappropriately require the waiver of the privileges and immunities that are accorded to IGOs under international law. In this respect, a number of commentators noted the importance of taking into account the customary immunity from legal process and execution that is accorded to IGOs, when implementing any system of protection for identifiers in the DNS.”

9. The legal advisors of the United Nations System¹¹ as well as other international organizations, including the Organization for Economic Cooperation and Development (OECD),¹² and the International Federation of Red Cross and Red Crescent Societies and the International Committee of the Red Cross¹³ subsequently submitted additional statements providing further evidence of abusive domain name registrations directed at their names and acronyms.

¹¹ SCT/S2/INF/4 available at http://www.wipo.int/sct/en/documents/special_session/pdf/sct_s2_inf4.pdf. The submission was made on behalf of the following Organizations and programs of the United Nations System: the United Nations Organization, the Food and Agricultural Organization of the United Nations, the International Bank for Reconstruction and Development/International Development Association, the International Civil Aviation Organization, the International Finance Corporation, the International Fund for Agricultural Development, the International Labour Organisation, the International Maritime Organization, the International Monetary Fund, the International Telecommunications Union, the United Nations Educational, Scientific and Cultural Organization, the United Nations Industrial Development Organization, the Universal Postal Union, the World Health Organization, the World Intellectual Property Organization, the World Meteorological Organization, the International Atomic Energy Agency, the World Trade Organization, the Organization for the Prohibition of Chemical Weapons, the Preparatory Commission for the Comprehensive Nuclear-Test-Ban Treaty Organization, the Bank for International Settlements, the International Organization for Migration, and the Secretariat of the Convention for Climate Change.

¹² SCT/S2/INF/2 available at http://www.wipo.int/sct/en/documents/special_session/pdf/sct_s2_inf2.pdf.

¹³ SCT/S2/INF/3 available at http://www.wipo.int/sct/en/documents/special_session/pdf/sct_s2_inf3.pdf.

Means of Protection

The WIPO II Report discussed various means of implementing protection for the names and acronyms of IGOs in the DNS, such as exclusion mechanisms and modifications of the UDRP. With regard to exclusion mechanisms, the WIPO II Report expressed some reservations:

“152. The exclusion mechanism has proven a contentious option with respect to the protection of any identifier in the DNS, including the names and acronyms of IGOs. As discussed in relation to the protection of INNs, the Internet community has strong reservations about the efficacy and desirability of blocking or exclusion mechanisms, and the overreaching effect they may have on users’ rights. Some commentators were opposed to any protection by way of exclusion of names or acronyms. Most commentators opposed the implementation of an exclusion mechanism that would automatically block the names, and especially acronyms, of IGOs, without accommodating the existence of legitimate users whose names or acronyms correspond with that of an IGO.

“153. Whereas the full names of IGOs are unlikely, if ever, to be shared in good faith by another entity in the DNS, the situation is not the same with respect to their acronyms. Numerous examples were provided of acronyms that were registered or used by legitimate enterprises, in coincidence with IGOs’ names: for example, ‘UNO’ stands for the United Nations Organization, but is also ‘one’ in Italian, a Fiat car model and a Swiss card game. ‘ICC’ is both the International Chamber of Commerce and the International Computing Centre. The ‘WHO’ refers to the World Health Organization, a rock group, and the science fiction character Dr. Who. WIPO itself is registered as a United States trademark in respect of tissues for personal and industrial use. Across the differentiated domain name space, these different entities may coexist: ‘SBA’ is shared by the United States Small Business Association at ‘sba.gov’, the Southern Bakers Association at ‘sba.org’ and the American law firm Smith, Bucklin and Associates at ‘sba.com’. There exists a German medical company at ‘ilo.com’, as well as a Canadian Internet company at ‘ilos.net’. An exclusion mechanism that automatically blocked both the names and acronyms of IGOs could jeopardize the existing rights of numerous other users. In this context, it should be noted that the international law protecting the names and acronyms of IGOs is aimed at preventing the registration or use of such identifiers as trademarks, especially in any circumstance where such use could mislead the public as to the source or connection of the user with the IGO. An analogy could usefully be drawn to the DNS, where the objective is not necessarily to deny all uses of acronyms that correspond to IGOs, but to ensure the prohibition of any use that is likely to mislead or otherwise confuse the public.”

10. The WIPO II Report took a more positive approach with regard to modifications of the UDRP:

“155. The proposal to modify the UDRP to enable the resolution of disputes relating to IGOs’ names and acronyms met with considerable support. Various commentators proposed that such an administrative dispute-resolution mechanism be implemented either as an alternative or in addition to an exclusion mechanism. Extending the UDRP to protect the identifiers of IGOs would not require the creation of new law, but merely the reflection in the DNS of existing international legal principles for their protection. The key benefit perceived in the UDRP is that it can be used to target only those names and acronyms of IGOs that are used in bad faith, so as to mislead or confuse the public.”

11. The WIPO II Report noted that any means directed at protecting the names and acronyms of IGOs would need to accommodate the immunities from national jurisdiction which IGOs enjoy under international law:¹⁴

“157 ... Most international organizations will not readily waive their immunity and would consider submission to the UDRP as an inappropriate compromise of their privileges and immunities. In fact, the UN has stated that it will not submit to a dispute resolution process such as the UDRP, which would subject the Organization to the jurisdiction of national courts. It is recalled, in this respect, that the UDRP as it currently applies to trademarks contains a mutual jurisdiction clause that requires complainants to submit to the compulsory jurisdiction of a designated court of law for the purpose of any challenge to the decision of the administrative decision-maker. Any administrative process to which the IGOs could agree would need to omit such a reference.”

Recommendation

12. The Member States of WIPO have recommended to modify the UDRP in a way that translates the existing international protection of the names and acronyms of IGOs into the UDRP, with all limitations and exceptions to such protection. In the context of a modified UDRP, these limitations and exceptions make it possible to take account of rights and legitimate interests of owners of domain names that are identical or confusingly similar to names or acronyms of IGOs. It is recalled that a similar approach was adopted when the UDRP was originally created since the existing international protection of trademarks was adapted to the special situation of abusive domain name registrations.

13. The WIPO II Recommendations are limited in several respects:

- They only apply to the limited number of names and acronyms of IGOs that were notified to WIPO in accordance with Article 6*ter* of the Paris Convention;
- They only apply in cases where registration or use of a domain name is of a nature to suggest to the public that a connection exists between the domain name holder and the IGO; or to mislead the public as to the existence of a connection between the domain name holder and the IGO; or where (as is the case for the Red Cross) such registration or use violates the terms of a treaty protecting the name and/or acronym of an international organization.

14. In order to strike a balance between the immunities of IGOs on the one hand (which may cause a national court of justice to refuse to hear a case brought against an IGO), and the right of a losing UDRP respondent to have the dispute reconsidered in a neutral forum on the other, WIPO Member States have further recommended to require IGOs to submit to a

¹⁴ In their earlier mentioned submission, the UN Legal Advisers emphasized that “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“, SCT/S2/INF/4 paragraph 8. Since the names and acronyms of IGOs are essential for their proper functioning, measures to protect these essential assets are part of an organization’s core activity and should therefore not require it to waive its immunity.

special appeal procedure by way of *de novo* arbitration rather than to the jurisdiction of certain national courts of justice.¹⁵

Country Names

Existing International Protection

15. On the international legal framework relevant for the protection of country names, the WIPO II Report made the following observations:

“278. *Legal Perspective.* The international intellectual property instrument that is most relevant to the discussion of the protection of country names in the DNS is the Paris Convention. Article 6*ter* of the Convention provides for the protection of certain State-related symbols against their registration and use as trademarks. The Convention does not, however, expressly mention country names, but some have argued that they nonetheless should be deemed to fall within its scope. While a number of innovative arguments can be advanced in support of this position, we believe that a plain reading of the relevant provisions and the negotiating history of the Convention leads to the conclusion that it does not offer protection to the names of countries. Our finding results from, on the one hand, a textual comparison between subparagraphs 1(a) and 1(b) of Article 6*ter* and, on the other hand, the preparatory work for the Geneva Diplomatic Conference on the Revision of the Paris Convention.”

Need for Protection in the DNS

16. While the WIPO II Report recognized the current lack of statutory legal protection for country names under international law, it also summarized policy arguments for protecting country names in the DNS:

“275. *Policy Perspective.* Current registration policies in the open gTLDs allow persons or entities to appropriate for themselves, as domain names, terms with which they otherwise have no, or only a loose, connection, to the exclusion of countries and peoples whose history and culture are deeply and inextricably linked to the terms in question. It should come as no surprise that such registrations are a source of concern for these countries and peoples, particularly if the domain names are exploited commercially or used in a manner that is deemed inappropriate or disrespectful. As the number of gTLDs expand, the value of a registration in any one of them may correspondingly decrease, and it is possible that the problem will become less acute. However, as long as domain names are used as a *de facto* Internet directory, it is unlikely that the problem will disappear completely, particularly in relation to the more visible and popular TLDs.

“276. Some will argue that the solution should lie in the application of the “first-come, first-served” principle. It is our view, however, that this argument is somewhat facile, at least in relation to the matter under consideration. The principle assumes an equal

¹⁵ Document WO/GA/28/7, paragraph 79. This recommendation is in line with the general legal practice of IGOs which routinely include arbitration clauses in their commercial contracts. Arbitration is a widely accepted legal process which offers substantial due process safeguards. On the international level, arbitration is regulated by the New York Convention on the Recognition and Enforcement of Foreign Arbitral Awards of 1958 which has 134 Member States. The text of the Convention and a list of its Member States is available on the web site of the United Nations Commission on International Trade Law (UNCITRAL) at <http://www.uncitral.org/english/texts/arbitration/NY-conv.htm>.

playing field between potential domain name registrants, in terms of awareness of the Internet and the DNS in particular, and the ability to access it and register domain names. However, it is now currently well accepted that such an equal playing field does not exist throughout the world. Persons residing in countries where the Internet is broadly known and used are therefore in a much more advantageous position in terms of securing their interests in the DNS than those in countries where the Internet has made little or no penetration. This point of view is underscored by the fact that many of the names of countries whose populations have benefited less from exposure to the Internet appear to have been registered as domain names by parties from countries that are at the forefront of Internet developments.

“277. The consideration of the interest of a country or a people in a term with which it has a strong historical and cultural link is one way to approach the problem of the registration of geographical terms as domain names. Another possible approach is to consider whether the manner in which the term is used as a domain name adds value by permitting users to retrieve more efficiently the information that they are seeking on the Internet. Under this approach, any geographical term that is registered as a domain name in order to function as the address of a website that provides information on the territory or location corresponding to the domain name may be deemed to add value, as users generally rely on domain names as a primary means of accessing information on the Internet. However, if a domain name corresponding to a geographical term does not resolve to any site or to a site which does not contain any meaningful information regarding the territory or region concerned, it may be argued that there is no added value, only a waste of resources and a cause of consumer confusion. Taking into account the use to which the domain name is put and the nature of the gTLD in which it is registered in assessing the appropriateness of the registration of a geographical term may be worthwhile also because such use, or the lack thereof, can be an indicator of the true purpose for which the name was registered (for example, speculative intent).”

17. Following a first round of discussions in the SCT, the WIPO Secretariat transmitted a questionnaire on the protection of country names in the DNS to the 178 Member States of WIPO, the Member States of the Paris Union, the Member States of the United Nations agencies, as well as to the intergovernmental and non-governmental organizations accredited with observer status at WIPO. The responses received are generally summarized as follows in document SCT/S2/3:¹⁶

“4. As a general matter, a large majority of commentators¹⁷ were in favor of protecting country names in the DNS, some arguing that ‘[t]here is a need to afford

¹⁶ Available at http://www.wipo.int/sct/en/documents/special_session/doc/sct_s2_3.doc.

¹⁷ See Comment of China (Trademark Office), Comment of Colombia (Department of Multilateral Economic, Social and Environmental Affairs), Comment of Croatia (State Intellectual Property Office), Comment of Denmark (Danish Patent and Trademark Office), Comment of Estonia (Estonian Patent Office), Comment of Government of France, Comment of Hungary (Hungarian Patent Office), Comment of Kyrgyzstan (State Agency of Science and Intellectual Property), Comment of Ireland (Intellectual Property Unit), Comment of Kenya (Kenya Industrial Property Office), Comment of Latvia (Patent Office), Comment of Lithuania (State Patent Bureau), Comment of Mexico (Mexican Industrial Property Institute), Comment of Netherlands (Directorate-General for Telecommunications and Post), Comment of Portugal (National Institute of Industrial Property), Comment of Republic of Moldova (State Agency on Industrial Property Protection), Comment of Spain (Spanish Patent and Trademark Office), Comment of Turkey (Turkish Patent Institute), Comment of United Kingdom (Patent Office), Comment of Uruguay (National Directorate of Industrial Property), Comment of International Trademark Association, Comment of Japan Trademark Association, Comment of Japan Patent Attorneys Association, Comment of Arbitration Center for Industrial Property, Japan, Comment of Network Information Center, Mexico.

protection against the use of domain names which might imply official use or endorsement where no such use or endorsement exists.’¹⁸ A minority of commentators, however, opposed such protection¹⁹ on a variety of grounds, including insufficient evidence of abuse, sufficiency of existing national laws prohibiting the misleading use of country names, the potential impact of the protection under consideration on fair use of geographical terms and established trademark rights, freedom of expression and the lack of direct impact of SCT decisions on the mechanisms to be implemented in the DNS.²⁰ One commentator expressed the view that it was not ‘[i]n the interests of member States to develop ad hoc solutions for the protection of country names, which would apply only on the Internet.’²¹

18. ICANN has found the matter to be sufficiently pressing to take corrective measures in the .INFO gTLD. At its meeting in Accra, Ghana on March 14, 2002, the ICANN Board adopted the following resolution:²²

“Resolved [02.43] that the Board adopts the ICNG recommendation that the 329 country names reserved under resolution 01.92 should be made available for registration by the governments and public authorities of the areas associated with the names and directs the General Counsel to cause those names to be made available to those governments and public authorities according to procedures established by the GAC.”

Means of Protection

19. In the course of the discussions in the SCT, several options for protecting country names in the DNS were discussed, including sunrise systems, a separate administrative challenge procedure, and amendments to the UDRP.

20. On sunrise registration systems for country names, document SCT/S2/3 provides the following analysis:

“25. (...) [T]he Secretariat is of the view that the introduction of sunrise registration systems for such names would not be an optimal solution for several reasons:

(i) The effect of sunrise registrations is to grant a name, on a preferential basis, to a particular user, to the exclusion of any other potential legitimate applicant. Because, at the international level, a country does not have a right to its name, it would be difficult to justify, from a legal perspective, a sunrise registration system for country names in the gTLDs. Reference is made to the discussion of this question in paragraphs 278 through 289 of the Report of the Second WIPO Internet Domain Name Process.

(ii) Rights in names (including trademark rights) are rarely absolute and there are many instances where a person or entity other than the rights holder may have a legitimate interest in a name and therefore be entitled to use or refer to it. Sunrise

¹⁸ See Comment of Ireland (Intellectual Property Unit).

¹⁹ See Comment of Government of Canada, Comment of New Zealand (Ministry of Economic Development), Comment of United States of America (Patent and Trademark Office).

²⁰ See Comment of Government of Canada, Comment of United States of America (Patent and Trademark Office).

²¹ See Comment of New Zealand (Ministry of Economic Development).

²² Available at <http://www.icann.org/minutes/prelim-report-14mar02.htm>.

registration systems, however, are unable to reflect this careful balance of competing legitimate interests, because they do not take into consideration the legal and factual circumstances in which different parties may find themselves in relation to any given name.

(iii) Sunrise registration systems are not able to offer protection against variations of the names that are meant to be protected. As stated in the ICNG report, 'ICNG participants expressed a concern that the reserving of names in .INFO would have limited effectiveness because of the enormous numbers of variations in country names.'"

21. Document SCT/S2/3 therefore suggests an administrative challenge procedure as a means for protecting for country names. In this context, the document states:

"34. While several commentators are of the view that the procedure should not be restricted to cases of bad faith, the Secretariat nonetheless counsels against expanding its scope to cases where both parties have a bona fide claim to a name. As the legal entitlement of a country to its corresponding name, at the international level, is not firmly established, a broadly scoped procedure would significantly increase the likelihood that the decisions will be controversial and contested at the national level.

"35. Considering that, at the international level, countries do not have a right in their names, the protection which the procedure offers could usefully be centered, not so much on safeguarding a country's interest in the name concerned, but rather on the avoidance of consumer confusion. Bad faith conduct for purposes of the procedure could therefore be defined as the registration or use of a domain name which is identical or misleadingly similar to a country name appearing on the pre-determined list, without any right or legitimate interest on the part of the registrant in the name and where users are likely to be misled into believing that there is an association between the registrant and the constitutional authorities of the country in question."

22. Document SCT/S2/3 also analyzed the question as to whether such an administrative challenge procedure should take the form of a modification of the UDRP or of a separate procedure:

"40. Broadening the scope of the UDRP to cover also country names would have several advantages:

- (1) It would contribute to maintaining uniformity in domain name dispute resolution procedures, as the UDRP's existing procedural framework would be relied upon as a protection mechanism.
- (2) Rendering the UDRP applicable to country names only would require a technical adjustment to the procedure (essentially taking the form of an amendment of the grounds on which a complaint can be brought), without the need for a complete overhaul of the entire procedural framework.
- (3) The UDRP provides protection for the identifiers to which it applies in relation to identical, as well as misleadingly similar, domain names.

(4) Safeguards are incorporated into the UDRP that are intended to ensure that a registrant who has a legitimate interest in a domain name will be able to keep the registration, notwithstanding the filing of a complaint by a rightsholder.

(5) The UDRP allows a registrant, against whom a complainant prevails under the procedure, to have its case reconsidered by national courts.”

(...)

“42. As an alternative to modifying the UDRP, country names also could be protected by means of an administrative challenge procedure specially designed for this purpose. The advantages of such special administrative procedure would be the following:

(1) It could be designed to incorporate many of the features of the UDRP which are appropriate in the context of the protection of country names (for instance, applicability to identical, as well as misleadingly similar, domain names; safeguards to protect registrants with legitimate interests in their domain names,

(...).

“43. An administrative dispute resolution procedure specifically designed for the protection of country names also would have disadvantages:

(1) From a dispute resolution policy perspective, the creation of distinct procedures for the protection of different interests in the DNS is to be avoided as a matter of principle, because such approach soon would result in a complex mesh of rules and regulations which users would find difficult to understand and would entail unnecessary transaction costs. The protection of intellectual property in the DNS is already a complicated affair, in particular following the entry into effect of various different dispute resolution procedures that apply to the seven new gTLDs which have recently been approved by ICANN. Creating yet another procedure for the benefit of countries would complicate the landscape even further, however worthy of protection the underlying interests might be.

(2) The relatively limited number of country names may not warrant the creation of an entirely new and separate dispute resolution procedure aimed exclusively at their protection.

(3) In light in particular of the previous point, ICANN may be hesitant to cooperate in the implementation of the new procedure and the results that would flow from it by imposing it as a requirement on domain name registration authorities through its contractual arrangements with them.”

Recommendation

23. Since the protection of country names in the DNS cannot rely on a pre-existing legal basis in international intellectual property law, the decision to provide such protection is a matter of policy. It should be noted, however, that such a decision is supported by the WIPO II Recommendations, which, under international law, constitute a resolution of the competent organ of an international treaty-based organization.²³

²³ It should be noted that the WIPO II Report, paragraph 168, mentioned “a resolution of a competent treaty organ” as one option for providing “a legitimate source in international law.”

24. It should also be noted that the WIPO II Recommendations on country names are limited in several respects:

- Acquired rights would not be affected since protection of country names would not apply retroactively but only to future registrations of domain names in generic top-level domains (gTLDs).²⁴ Hence, the protection will only become effective once it has become part of the domain name registration agreements so that new registrants will be on notice;
- Protection is limited to instances where the domain name holder has no right or legitimate interest in the name and the domain name is of a nature that is likely to mislead users into believing that there is an association between the domain name holder and the constitutional authorities of the country in question;
- Protection applies only to the official long and short names of countries, as provided by the United Nations Terminology Bulletin, in the official language(s) of the country concerned and in the six official languages of the United Nations;²⁵
- Following further discussion in the SCT, Member States decided not to recommend the establishment of an arbitral appeal mechanism.²⁶ Hence, the mutual jurisdiction requirement of the UDRP would remain applicable.

Conclusion

25. The WIPO II Recommendations are the result of an open and transparent consultation process which included relevant stakeholders. They have been adopted by the WIPO General Assembly, the competent organ of WIPO. At the request of the Member States of WIPO, the WIPO II Recommendations were transmitted to ICANN in February 2003.²⁷ At its meeting in March 2003, the Governmental Advisory Committee (GAC) unanimously endorsed the WIPO II Recommendations and advised the Board of ICANN to implement them.²⁸

26. The WIPO II Recommendations are limited to clear cases of abusive registration and use of domain names, and are balanced to take account of the rights or legitimate interests of domain name registrants. Implementing the WIPO II Recommendations would require limited modifications to the UDRP and the UDRP Rules. Draft amended versions of the UDRP and the UDRP Rules are attached as Annex II to illustrate the form these modifications could take.²⁹

²⁴ While the WIPO General Assembly had, in September-October 2002, decided that the issue of applying the protection retroactively to existing domain name registrations should be discussed further, the SCT decided, at its tenth session in April/May 2003, not to recommend such retroactive protection, see SCT/10/9, paragraph 47, available at http://www.wipo.int/sct/en/documents/session_10/index.htm.

²⁵ The WIPO General Assembly had also decided that the question as to whether protection should be extended to names by which countries are familiarly or commonly known should be further discussed by the SCT. At its eleventh session the SCT decided not recommend such extension, see SCT/11/8 paragraph 254, available at http://www.wipo.int/sct/en/documents/session_11/doc/sct_11_8.doc.

²⁶ See SCT/11/8, paragraph 262.

²⁷ Correspondence available at <http://www.icann.org/correspondence/gurry-letter-to-cerf-lynn-21feb03.htm>.

²⁸ GAC Communiqué available at <http://194.78.218.67/web/meetings/mtg15/CommuniqueRioDeJaneiro.htm>.

²⁹ The drafts are based on the draft amended UDRP which was attached to document WO/GA/28/3 available at http://www.wipo.int/documents/en/document/govbody/wo_gb_ga/index_28.htm.