

J. Cohen & SubproCohen Co.

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- Possible meeting required before Rome.

Meeting/Issue Area topics:

- Exclusionary Lists
- Amending UDRP
- Independent UDRP
- Sunset Provisions
- Treaty

Submissions in Response to Request for Comments on WIPO-2 Process

1. American Intellectual Property Law Association

Michael Kirk, Executive Director

A. International Nonproprietary Names (INNs)

They do not support exclusion lists at this time for INNs as it might interfere with existing rights and legitimate interests.

B. International Intergovernmental Organizations (IGOs)

They do not support an exclusion list for IGOs as it may preclude legitimate trade-mark usage. They do not oppose, however, extending UDRP protection to IGO names and acronyms.

C. Personal Names

They feel that the UDRP already provides enough protection, although they would not be opposed to the limited personality right claim described in WIPO's interim report.

D. Geographic Indications

i) IP-related geographic indications

They favour the use of the UDRP for these situations over exclusion lists because the UDRP protects legitimate interests and non-infringing users. Standing should fall under the country's laws to determine.

ii) non-IP related geographic indications

They oppose the adoption of an exclusion list for non-IP related geographic indications. The use of an exclusion list presumably would prohibit use of place name trade-marks as domain names, thereby conflicting with findings of the 1st WIPO Process.

2. Argentine Chamber of Databases and On Line Services (CABASE)

Juan Carlos Aquerreta

Vice President of Electronic Business and Contents

For most proposed changes, they advocate maintaining a 1st come 1st served basis, reflecting freedoms of speech and expression. Domain names are not trademarks and imposing a trade-marks regime fixes unacceptable limitations on domain name usage.

They also believe similarity should be allowed for with respect to domain names.

IGO and INN protection should be limited to the .int TLD (or perhaps a new .inn TLD should be created for INNs).

They do support Whois expansion..

6. International Association for the Protection of Industrial Property (AIPPI)

Vincenzo M. Pedrazzini

Secretary General

Care must be taken to ensure that the new 'rights' do not grant greater 'virtual' rights than exist in the 'real world' equivalent.

INNs:

There is no need to expand protection until there is proof of abuse

IIGs:

They would favour giving IGOs the standing to bring UDRP-type actions in the same way as trade-mark owners have, rather than creating exclusion lists.

Personal Names:

Current protection is adequate.

Geographical IP:

They support broadening UDRP to cover these. They favour the option that standing should be based on proof of the geographical indication or indication of source of their country of origin

Geographical non-IP:

Should be analogous to IP law - ie. afford protection where IP does.

Country codes:

They recommend excluding the two-letter codes from new TLDs, with no retroactive effect on TLDs that have already accepted registration for two-letter codes.

Trade Names:

They agree with WIPO recommendations.

WHOIS:

They agree with WIPO recommendations.

7. International Chamber of Commerce (ICC)

They generally acknowledge the system is adequate as is. They only support extending any rights to the extent that they become analogous to IP laws.

8. International Trademark Association (INTA)

Nils Victor Montan

President

They recommend the UDRP be left alone in most cases. They assert that the system is designed to be quick, efficient, and limited, and has performed its duties to this point.

Trade Names:

It may be possible to amend UDRP to protect them, but it really isn't necessary at this point.

INNs, IGOs

It may be possible to create an exclusion mechanism for names, but the list should not include acronyms, as they can often be applicable to and recognized for many entities.

Whois:

They strongly recommend a "one-stop-shop" WHOIS.

They recommend encouraging ccTLD administrators to adopt WHOIS "one-stop-shop" policies. They feel privacy is a concern, and infractions should be prosecuted, but a "black-out" of WHOIS data is not a good option in light of the value it provides to intellectual property owners, law enforcement, consumers, and parents.

9. Motion Picture Association of America

Troy Dow

Counsel, Technology & New Media

The basis of the UDRP and its international support is that it is agreeable to all member countries. It will be difficult to create uniform policies to address personal names, etc, that are consistent with all member-countries' laws. Any new protections must be narrowly crafted and rooted in commonly held principles of national law and public policy. They also encourage a "one-stop-shop" WHOIS service.

10. Government of Canada

Concerned with maintaining analogous rights in virtual and real worlds.

It is premature to try to further regulate on geographical indications. They do not support an exclusion mechanism, nor a broadening of the UDRP to cover such abusive registrations.

11. The Patent Office of the United Kingdom

Jeff Watson

Senior Policy Advisor

They do not support extension of the UDRP to cover most areas discussed.

They do support expanding it to cover geographical indications and indications of source where there are explicit IP rights.

They do not support exclusion lists.

For new gTLDs, each relevant authority should be able to decide whether it wishes its ISO 3166 code element to be used in the second level of domain name registrations.

They support introducing an action of some kind into the UDRP to deal with protection of names

of countries and places within countries.

They support extending UDRP coverage to trade names.

They support a WHOIS data search facility, that is balanced with local data protection principles

12. United States Office of Advocacy: U.S. Small Business Administration

Eric E. Menge

Assistant Chief Counsel

Several of the proposals in the interim report would have the effect of limiting and inhibiting the use and growth of the Internet by small businesses and other users.

Interim Report does not present a compelling case of problems in need of being fixed.

They question ICANN's authority to regulate INNs.

They believe an international TLD (.int) is perfectly capable of protecting IGOs.

They believe most of the WIPO2 process to be threatening to small businesses.

13. United States Patent and Trademark Office

Robert L. Stoll

Administrator, Office of Legislative and International Affairs

They have concentrated their comments on geographical indications and indications of source

-Concerned that the UDRP would be creating binding international law based perhaps on a biased perspective from the laws of one country, that do not exist in others.

-concern over who has standing in geographical indications - could be more than one entity, who gets to choose who will be granted standing? Is it the complainant as the first come first served?

-Supports Whois policies.

-concerned UDRP addressing geo. inds. Will adversely affect the legitimacy of the UDRP as it has evolved for trademarks.

14. European Commission

They support exclusion mechanisms and see them as the best solution for protection of INNs.

They feel personal names are adequately covered under UDRP - any further protection might be too complicated for the UDRP.

Names and acronyms of IGOs should be excluded from registration, regardless of the level at which they are used.

They endorse broadening the scope of the current UDRP to cover geographical indicators and indicators of source as domain names.

They support revising UDRP to cover trade names (following WIPO suggestions).

They emphasize that the right to privacy supercedes consumer protection and law enforcement interests vis a vis WHOIS registration.

15. United Nations, Office of Legal Affairs

Hans Corell

Under-Secretary-General for Legal Affairs

They endorse WIPO's recommendations that the names and acronyms of IGOs should be protected in the DNS.

They strongly agree that such protection is required under applicable international agreements and that any protection must be more than merely reserving the generic top-level domain name ".int" for such organizations.

They prefer exclusion lists, as UDRP would compromise the immunities of UN and subsidiary organizations. Appeals would go to an independent administrative panel.

16. Japan Network Information Center (JPNIC)

Toshi Tsubo

Trustee of the Board

They do not think there are sufficient reasons to exclude INNs from DNS.

They think it is unrealistic to cancel existing registrations.

There is a potential for abuse of INNs, so UDRP might be expanded for protection, but this would also raise issues of standing.

IGOs - should be protected, the names could be through exclusion lists, but acronyms should only be through an expanded UDRP.

They endorse protection of geographic names in UDRP. Standing could be determined by a panel.

17. Nominet UK

Emily Taylor

Solicitor

They recommend that the rights required to bring a claim under the UDRP be relaxed - they should be broadened to encompass those who are unable to assert trade mark rights.

They appreciate concerns that UDRP should not create new law, but contends that it has already done so in various ways (bad faith domain name registrations not directly reflected in UK trade-mark law).

They oppose the recommendations made in relation to INNs - upsets the first come first served system, which they feel is successful. Cancelling current ones violates terms of their contracts.

To deal with INNs, if it is absolutely necessary, basis of complaint could be expanded under UDRP

IGOs - oppose their exclusion from registration, claiming that '.int' is sufficient to establish successful sites.

To protect IGOs in other top level domains, UDRP should relax the restriction that complaints be founded on trade-mark rights.

Personal names: should amend UDRP to include safeguards which ensure that names which retained their fundamentally descriptive or generic character, not having distinctiveness, be excluded from protection.

Geographical indications - these should not be part of an exclusion list. It would upset the 1st come 1st served and would be unduly onerous for registries to administer.

UDRP should be expanded to cover trade names.

WHOIS data should be codified.

18. Michael Froomkin

University of Miami School of Law

It is premature to propose expanding the UDRP until a host of very substantial problems with the current system have been solved. (One-sided, consistently favours trademark holders against innocent registrants).


It is also wrong to propose 'exclusions' that would remove words from the namespace on the basis of an arbitrary set of criteria. Will lead to other arbitrary lists.

In many cases, WIPO is proposing solutions to 'problems' which it is unable to prove exist, and which do not exist, or are so minor as to fail to justify the highly intrusive proposals advanced by WIPO - especially when one considers the precedential effect these proposals could have.

WIPO is proposing regulations which vastly exceed the current international consensus of the protection due to intellectual property. In so doing it seeks to make de facto law in an undemocratic, illegitimate way. WIPO's proposals amount to little more than an attempt to impose European IP rules on the US, without the consent of the US Congress and the US political process. To the extent that WIPO's proposals reflect a central planning concept of the 'optimal' use of some domain names, or the idea that domain name uses should be curtailed to serve particular social policies, this reflects an orientation antithetical to free market values.

WIPO 2 Process

Process on the Recognition of Rights and Use of Names in the DNS



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The Recognition of Rights and the Use of Names in the Internet Domain Name System

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The [Second WIPO Internet Domain Name Process](#) was initiated at the request of the Member States of WIPO. It follows the [first such WIPO Process](#), which investigated the interface between trademarks and Internet domain names, and recommended the establishment of a uniform dispute-resolution procedure to deal with disputes concerning the bad faith registration and use of trademarks as domain names, or "cybersquatting." The Uniform Domain Name Dispute Resolution Policy (UDRP), which was adopted by the Internet Corporation for Assigned Names and Numbers (ICANN) as a consequence of the first WIPO Process, has proven to be an efficient and cost-effective international mechanism, responsive to the particular circumstances of the domain name system (DNS) as a global addressing system. The [WIPO Arbitration and Mediation Center](#), as a leading provider of services under the UDRP, has received, at the date of publication of this Report, over 3000 complaints under it, of which well over 80% have been resolved.

The Second WIPO Process concerns a range of identifiers other than trademarks and is directed at examining the bad faith and misleading registration and use of those identifiers as domain names. These other identifiers, which form the basis of naming systems used in the real or physical world, are:

- 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.

The international legal framework for the protection of these other identifiers is not as developed as it is for the protection of trademarks. In some cases, for example, geographical indications and trade names, elements of international protection exist, but they do not constitute a complete system that is uniformly applied throughout the world. In other cases, for example, personal names and the names of geographical localities, such as cities, used outside the context of trade in goods, there are no clear elements of an international framework.

The Report finds that there is considerable evidence of the registration and use of the identifiers examined in the Report as domain names by persons who might be considered not to be properly entitled to use the identifiers in question. Moreover, it is clear from the comments received by WIPO in the process leading to the Report that the registration of these identifiers as domain names by such persons offends many sensitivities. For example, many commentators considered that the registration as domain names of the names of eminent political, scientific or religious persons, or the names of countries, cities or indigenous peoples, by parties without any association with the persons, places or peoples concerned, was unacceptable.

The possibility of registering these identifiers as domain names is a consequence of the first-come, first-served, highly automated and efficient nature of the system used for domain name registration, which does not involve any screening of domain name applications. That same system has also allowed the tremendous growth that has taken place in the use of the Internet, while acting as the means of preserving universal connectivity on the Internet.

While the sensitivities offended by the registration and use of the identifiers considered in this Report by unconnected parties must be acknowledged, the insufficiencies of the current international legal framework must also be recognized. It is for the international community to decide whether it wishes to address any of these insufficiencies in order to establish an adequate legal basis to deal with the practices that might be considered to be unacceptable. Chapter Two of the Report outlines the instruments at the disposal of international community for this purpose. These instruments include self-regulation, the deployment of the contractual system within the DNS that allows ICANN to ensure certain uniform rules with respect to domain name registries, registrars and registrants, and the more traditional instrument of the treaty. These instruments are not exclusive, but can be used in combination. Thus, the UDRP represents a deployment, through the contractual relations that make up the ICANN system, of established rules relating to trademark protection that have been developed in widely accepted treaties. It will be for the international community to choose not only whether it wishes to make new rules to deal with any of the identifiers examined in this Report, but also how it may wish to develop such rules and implement them.

The specific findings and recommendations made with respect to the various identifiers examined in this Report are:

- (i) For *INNs*, which are examined in Chapter Three of the Report, it is recommended that a simple mechanism be established which would protect *INNs* against identical domain name registrations. The mechanism would allow any interested party to notify WIPO that a domain name registration is identical to an *INN*, whereupon WIPO would, in conjunction with the World Health

Organization (WHO), verify the exact similarity between the domain name and the INN and notify this to ICANN, which would, in turn, notify the registrar with which the registration was made that the domain name registration should be cancelled.

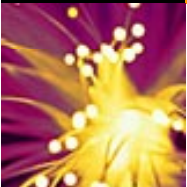
(ii) For the *names and acronyms of IGOs*, which are examined in Chapter Four of the Report, it is recommended that States, as the constituents of IGOs, should work towards the establishment of an administrative dispute-resolution procedure, akin to the UDRP, where an IGO could bring a complaint that a domain name was the same or confusingly similar to the name or acronym of the IGO, that it has been registered without legal justification and that it likely to create a misleading association between the holder of the domain name registration and the IGO in question.

(iii) For *personal names*, which are the subject of Chapter Five of the Report, it was found that there no existing international norms dealing with their protection and that national legal systems provide for a wide diversity of legal approaches to their protection. The sensitivities offended by the registration of personal names as domain names by parties unconnected with the persons in question is recognized, and it is suggested that the international community needs to decide whether it wishes to work towards some means of protection of personal names against abuse of domain name registrations.

(iv) For *geographical identifiers*, which are dealt with in Chapter Six, it is recognized that certain norms exist at the international level which prohibit false and deceptive indications of geographical source on goods and which protect geographical indications, or the names of geographical localities with which goods having particular characteristics derived from that locality are associated. However, these rules apply to trade in goods and may require some adaptation to deal with the perceived range of problems with the misuse of geographical indications in the DNS. Furthermore, the lack of an international agreed list of geographical indications would pose significant problems for the application of the UDRP in this area because of the need to make difficult choices of applicable law. It is suggested that the international framework in this area needs to be further advanced before an adequate solution is available to the misuse of geographical indications in the DNS. As far as other geographical terms are concerned, the Report produces considerable evidence of the widespread registration of the names of countries, places within countries and indigenous peoples as domain names by persons unassociated with the countries, places or peoples. However, these areas are not covered by existing international laws and a decision needs to be taken as to whether such laws ought to be developed.

(v) For *trade names*, which are the subject of Chapter Seven, the situation is similar to that of geographical indications, insofar as certain international norms exist for the protection of trade names, but fundamental problems exist in identifying across differing national approaches what constitutes a protectable trade name, and consequently, in avoiding highly complex choices of applicable law on a global medium. It is recommended that no action be taken in this area.

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THE RECOGNITION OF RIGHTS AND THE USE OF NAMES IN THE INTERNET DOMAIN NAME SYSTEM

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Report of the

Second WIPO Internet Domain Name Process

<http://wipo2.wipo.int>

September 3, 2001



The World Intellectual Property Organization (WIPO) is an international intergovernmental organization, which has 177 States as members. The Member States established the Organization as the vehicle for promoting the protection of intellectual property throughout the world. The Organization provides services both to its Member States and to the individuals and enterprises that are constituents of those States. The services provided by WIPO to its Member States include the provision of a forum for the development and implementation of intellectual property policies internationally through treaties and other policy instruments. The services provided to the private sector by WIPO include the administration of procedures for the settlement of intellectual property disputes through the WIPO Arbitration and Mediation Center, and the administration of systems that make it possible to obtain protection for patents, trademarks, industrial designs and geographical indications in different countries through a single international procedure.

The operations of WIPO are financed as to 90 per cent by fees generated by the Organization for the services it renders to the private sector, and as to the remaining 10 per cent by contributions made by the Member States.

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EXECUTIVE SUMMARY

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concerned, was unacceptable.

The possibility of registering these identifiers as domain names is a consequence of the first-come, first-served, highly automated and efficient nature of the system used for domain name registration, which does not involve any screening of domain name applications. That same system has also allowed the tremendous growth that has taken place in the use of the Internet, while acting as the means of preserving universal connectivity on the Internet.

While the sensitivities offended by the registration and use of the identifiers considered in this Report by unconnected parties must be acknowledged, the insufficiencies of the current international legal framework must also be recognized. It is for the international community to decide whether it wishes to address any of these insufficiencies in order to establish an adequate legal basis to deal with the practices that might be considered to be unacceptable. Chapter Two of the Report outlines the instruments at the disposal of the international community for this purpose. These instruments include self-regulation, the deployment of the contractual system within the DNS that allows ICANN to ensure certain uniform rules with respect to domain name registries, registrars and registrants, and the more traditional instrument of the treaty. These instruments are not exclusive, but can be used in combination. Thus, the UDRP represents a deployment, through the contractual relations that make up the ICANN system, of established rules relating to trademark protection that have been developed in widely accepted treaties. It will be for the international community to choose not only whether it wishes to make new rules to deal with any of the identifiers examined in this Report, but also how it may wish to develop such rules and implement them.

The specific findings and recommendations made with respect to the various identifiers examined in this Report are:

(i) For *INNs*, which are examined in Chapter Three of the Report, it is recommended that a simple mechanism be established which would protect INNs against identical domain name registrations. The mechanism would allow any interested party to notify WIPO that a domain name registration is identical to an INN, whereupon WIPO would, in conjunction with the World Health Organization (WHO), verify the exact similarity between the domain name and the INN and notify this to ICANN, which would, in turn, notify the registrar with which the registration was made that the domain name registration should be cancelled.

(ii) For the *names and acronyms of IGOs*, which are examined in Chapter Four of the Report, it is recommended that States, as the constituents of IGOs, should work towards the establishment of an administrative dispute-resolution procedure, akin to the UDRP, where an IGO could bring a complaint that a domain name was the same or confusingly similar to the name or acronym of the IGO, that it has been registered without legal justification and that it is likely to create a misleading association between the holder of the domain name registration and the IGO in question.

(iii) For *personal names*, which are the subject of Chapter Five of the Report, it was found that there are no existing international norms dealing with their protection and that national legal systems provide for a wide diversity of legal approaches to their protection.

The sensitivities offended by the registration of personal names as domain names by parties unconnected with the persons in question is recognized, and it is suggested that the international community needs to decide whether it wishes to work towards some means of protection of personal names against their abusive registration as domain names.

(iv) For *geographical identifiers*, which are dealt with in Chapter Six, it is recognized that certain norms exist at the international level which prohibit false and deceptive indications of geographical source on goods and which protect geographical indications, or the names of geographical localities with which goods having particular characteristics derived from that locality are associated. However, these rules apply to trade in goods and may require some adaptation to deal with the perceived range of problems with the misuse of geographical

indications in the DNS. Furthermore, the lack of an international agreed list of geographical indications would pose significant problems for the application of the UDRP in this area because of the need to make difficult choices of applicable law. It is suggested that the international framework in this area needs to be further advanced before an adequate solution is available to the misuse of geographical indications in the DNS. As far as other geographical terms are concerned, the Report produces considerable evidence of the widespread registration of the names of countries, places within countries and indigenous peoples as domain names by persons unassociated with the countries, places or peoples. However, these areas are not covered by existing international laws and a decision needs to be taken as to whether such laws ought to be developed.

(v) For *trade names*, which are the subject of Chapter Seven, the situation is similar to that of geographical indications, insofar as certain international norms exist for the protection of trade names, but fundamental problems exist in identifying across differing national approaches what constitutes a protectable trade name, and consequently, in avoiding highly complex choices of applicable law on a global medium. It is recommended that no action be taken in this area.

1. THE MANDATE AND ITS CONTEXT

1. On June 28, 2000, the Director General of WIPO received a request from 19 of WIPO's Member States to develop, through a consultative process, recommendations on means of dealing with the "bad faith, abusive, misleading or unfair use," within the Internet domain name system (DNS), of identifiers that form the basis of certain naming systems used in the real or non-virtual world.^[1] The identifiers specified were:

- personal names;
- International Nonproprietary Names (INNs) for pharmaceutical substances;
- the names of international intergovernmental organizations;
- geographical indications, geographical terms, or indications of source; and
- trade names.

The Request was subsequently endorsed by the WIPO General Assembly, the constituent organ of the Member States of WIPO.^[2]

2. The Request established three process criteria for WIPO's work:

- (i) first, it was specified that "this activity should take full advantage of WIPO's prior work";
- (ii) secondly, the activity should "build on existing and ongoing discussions"; and
- (iii) thirdly, the Request indicated that the activity should "allow...for a process of consultation with WIPO Members and all interested stakeholders."

WIPO'S PRIOR WORK

3. In June 1998, the National Telecommunications and Information Administration (NTIA), an agency of the United States Department of Commerce, issued a *Statement of Policy on the Management of Internet Names and Addresses* (the "White Paper").^[3] The White Paper called for the creation of a new, private, not-for-profit corporation which would be responsible for coordinating certain DNS functions for the benefit of the Internet as a whole. Following the publication of the White Paper, a process occurred which resulted in the formation of the Internet Corporation for Assigned Names and Numbers (ICANN), a not-for-profit corporation established under the laws of the State of California of the United States of America. The by-laws of ICANN and documentation on the various meetings that it has organized and activities that it has carried out are available on ICANN's web site, www.icann.org.

4. In response to growing publicity and concern over the interface between domain names and trademarks, and the lack of definition of the relation between these two species of identifiers, the White Paper also addressed certain intellectual property questions. In particular, the White Paper stated that the United States Government would "seek international support to call upon the World Intellectual Property Organization (WIPO) to initiate a balanced and transparent process, which includes the participation of trademark holders and members of the Internet community who are not trademark holders," to develop recommendations on certain aspects of the interface between domain names and trademarks, including "a uniform approach to resolving trademark/domain name disputes involving cyberspiracy."

5. Following the publication of the White Paper, and with the subsequent approval of its Member States,^[4] WIPO carried out between July 1998 and April 1999 an extensive and intensive process of consultations directed at developing recommendations on the issues which it was requested to address.

6. The WIPO Process, known as the WIPO Internet Domain Name Process, was conducted using a combination of Internet-based consultations, paper-based consultations and 17 physical meetings held in 14 countries. Participation was solicited from governments, intergovernmental organizations, professional and industry associations, corporations and individuals through three Requests for Comments. Responses were received to those Requests for Comments from 40 States, 6 intergovernmental organizations, 72 non-governmental organizations representing professional, industry and other special interests, 181 corporations and law firms and 182 individuals.

7. The Report of the WIPO Internet Domain Name Process, *The Management of Internet Names and Addresses: Intellectual Property Issues*,^[5] was published on April 30, 1999. The Report contained a series of recommendations. Chief amongst those recommendations was the establishment of a uniform dispute-resolution policy and procedure for resolving disputes over the alleged bad faith and deliberate misuse of trademarks through the registration of domain names in the generic top-level domains (gTLDs) .com, .net and .org.

The Uniform Domain Name Dispute Resolution Policy for gTLDs

8. Following the publication of the Report of the WIPO Internet Domain Name Process and certain consultation procedures in conformity with the by-laws of ICANN, ICANN adopted, in August 1999, a Uniform Domain Name Dispute Resolution Policy (UDRP), which entered into force for the gTLDs .com, .net and .org on December 1, 1999, and January 1, 2000 (the policy was phased-in for registrars over the two dates).

9. The UDRP establishes a dispute-resolution procedure under which a complainant can seek the transfer or cancellation of a domain name registration in .com, .net or .org on the basis that (i) the domain name is identical or confusingly similar to a trademark in which the

complainant has rights; (ii) the domain name holder has no rights or legitimate interests in respect of the domain name; and (iii) the domain name has been registered and is being used in bad faith. The UDRP is a mandatory procedure to which each applicant for a domain name registration in .com, .net or .org is required to submit, in the event that a complaint is lodged in respect of the applicant's registration.

10. ICANN has accredited four dispute-resolution service providers to administer disputes brought under the UDRP: the WIPO Arbitration and Mediation Center, the National Arbitration Forum, e-Resolution and the CPR Institute for Dispute Resolution. Registrars accredited by ICANN to accept registrations in .com, .net or .org are obligated to implement the results of panel decisions under the dispute resolution procedure.

11. Between the date of commencement of the UDRP on December 1, 1999, and the end of July 2001, some 4,155 cases had been initiated under the UDRP. Of these, 2821 were filed with the WIPO Arbitration and Mediation Center.

12. The UDRP has proven itself to be an efficient and cost-effective means of resolving disputes over the bad faith and deliberate misuse of trademarks through the registration and use of domain names in the gTLDs. Of the 2821 cases filed the WIPO Arbitration and Mediation Center since the commencement of the UDRP, 88% have been resolved. Filing a case with the WIPO Center costs US\$1500 and a decision is normally given within 50 days of the commencement of the procedure.^[6] The procedure has attracted widespread international participation, with cases being filed with the WIPO Center by parties from 85 countries.

EXISTING AND ONGOING DISCUSSIONS

13. There are several "existing and ongoing discussions" or developments which may have an impact, directly or indirectly, on the UDRP and on the various issues that WIPO has been requested to address in respect of the interface between domain names and certain identifiers other than trademarks.

UDRP Review

14. The by-laws of ICANN^[7] provide for three advisory bodies known as "Supporting Organizations" (Article VI, Section 1(a)). The Supporting Organizations "serve as advisory bodies to the Board [of Directors], with the primary responsibility for developing and recommending substantive policies regarding those matters falling within their respective responsibilities" (Article VI, Section 2(b)). The three Supporting Organizations are the Address Supporting Organization, the Domain Name Supporting Organization and the Protocol Supporting Organization.

15. The Domain Name Supporting Organization (DNSO) has the responsibility of advising the Board "with respect to policy issues relating to the Domain Name System" (Article VI-B, Section 1 (a)). The scope of such policy issues is presumably not open, but is circumscribed by the Articles of Incorporation of ICANN,^[8] which set out the purposes and functions of ICANN (thus, for example, the policy issues would not include taxation or criminal law). The DNSO has two organs, a Names Council, consisting of representatives of various "constituencies," and a General Assembly, consisting of "all interested individuals and entities" (Article VI-B, Section 1(b)).

16. The constituencies of the DNSO Names Council "self-organize" and "determine [their] own criteria for participation" (Article VI-B, Section 3(a)). There are seven constituencies of

the DNSO Names Council, namely ccTLD registries; commercial and business entities; gTLD registries; ISP and connectivity providers; non-commercial domain name holders; registrars; and trademark, other intellectual property and anti-counterfeiting interests (Article VI-B, Section 3(b)).

17. The Business Plan for the DNSO Names Council 2001-2002^[9] includes two items concerning the UDRP amongst its proposed objectives for the Names Council 2001-2002:

“UDRP.

- a. *Review and evaluate the Uniform Dispute Resolution Policy and propose changes for consideration by the ICANN Board.*
- b. *Consider need for further revisions in the light of the 2000-2001 Second WIPO Domain Name Process WIPO2 RFC-2 looking at issues involving domain names and property other than trademarks.”*

Work on the abovementioned items is only in its initial stages, but, obviously, that work may have an impact both on the existing operation of the UDRP and on any future modification of the UDRP in the light of the present WIPO Report.

ccTLDs

18. In parallel to the Request to WIPO, referred in paragraph 1, above, which led to the publication of this present WIPO Report, WIPO also received from the same 19 Member States a Request “to develop, for the assistance of the administrators in ccTLDs, voluntary guidelines for the development of practices and policies to curb abusive and bad faith registration of protected names, and to resolve related disputes.”^[10] This second Request was also endorsed by the WIPO General Assembly.^[11]

19. The ccTLDs are those top-level domains which bear two letter codes essentially derived from the International Organization for Standardization’s (ISO) Standard 3166. In accordance with the second Request addressed to it, WIPO initiated a ccTLD program, which included consultations and an international conference held in Geneva on February 20, 2001. The program led to the publication of the *WIPO ccTLD Best Practices for the Prevention and Resolution of Intellectual Property Disputes*.^[12]

20. Twenty-two ccTLDs have now adopted the UDRP within their domains. Those 22 ccTLDs are: .AC (Ascension Island), .AG (Antigua and Barbuda), .AS (American Samoa), .BS (Bahamas), .BZ (Belize), .CY (Cyprus), .EC (Ecuador), .FJ (Fiji), .GT (Guatemala), .LA (Lao People’s Democratic Republic), .MX (Mexico), .NA (Namibia), .NU (Nuie), .PA (Panama), .PH (Philippines), .PN (Pitcairn Island), .RO (Romania), .SH (Saint-Helena), .TT (Trinidad and Tobago), .TV (Tuvalu), .VE (Venezuela), and .WS (Western Samoa). To date, 46 cases relating to domain name registrations in the abovementioned ccTLDs have been filed under the UDRP with the WIPO Arbitration and Mediation Center.

21. WIPO continues to work with administrators of ccTLDs to provide advice on the protection of intellectual property within the ccTLDs. This advisory activity will, in the future, take into account the recommendations contained in the present WIPO Report and the responses to those recommendations from the Member States of WIPO and the Internet community.

“Internationalized” Domain Names

22. Various efforts are under way in the Internet community to make domain names available in non-Roman or non-ASCII scripts, such as Arabic, Chinese, Cyrillic, Japanese or Korean.

23. The Internet Engineering Task Force (IETF) has established an Internationalized Domain Name (IDN) Working Group, whose goal is “to specify the requirements for internationalized access to domain names and to specify a standards track protocol based on the requirements.”^[13] According to the charter of the Working Group, a “fundamental requirement in this work is to not disturb the current use and operation of the domain name system, and for the DNS to continue to allow any system anywhere to resolve any domain names.” The Working Group has not yet completed its work.

24. VeriSign Global Registry Services (VeriSign GRS), a leading provider of domain name registry services and DNS support to the Internet, has introduced an Internationalized Domain Name Testbed.^[14] According to the VeriSign GRS “General Information Paper on Internationalized Domain Name Resolution,”^[15] the “VeriSign GRS approach in implementing its testbed is to insure adherence to the Internet Architecture Board (IAB) principle of a single DNS route and continued compliance with the evolving standards under development by the Internationalized Domain Name (IDN) Working Group of the Internet Engineering Task Force (IETF).” The VeriSign GRS Internationalized Domain Name Testbed has commenced the phase of resolution of non-Roman script registrations that have been made under the Testbed.

25. On September 25, 2000, the ICANN Board passed a resolution which recognized “that it is important that the Internet evolve to be more accessible to those who do not use the ASCII character set,” and which stresses that “the internationalization of the Internet domain name system must be accomplished through standards that are open, non-proprietary, and fully compatible with the Internet’s existing end-to-end model and that preserve globally unique naming in a universally resolvable public name space”.^[16] At its meeting on March 13, 2001, the ICANN Board adopted a resolution establishing an internal working group “to identify the various internationalization efforts and the issues they raise, to engage in dialogue with technical experts and other participants in these efforts, and to make appropriate recommendations to the Board.”^[17] The ICANN IDN Internal Working Group has not completed its work.

26. The UDRP applies to all domain name registrations in the gTLDs .com, .net and .org. If those registrations are effected in non-Roman or non-ASCII script, the UDRP thus applies. The WIPO Arbitration and Mediation Center has already received 15 cases under the UDRP concerning internationalized domain name registrations effected under the VeriSign GRS Internationalized Domain Name Testbed. The cases concerned internationalized domain names in Chinese, Japanese, Norwegian (æ), German (ö) and French (é). Decisions have been given in 7 of the 15 cases filed.

27. The internationalization of domain names is manifestly an immensely important development in the DNS and one which will, inevitably, have intellectual property implications. The problem of conflicting trademarks across different languages and different language scripts is a problem that is already well known to the trademark community, which has a long experience with trademark registrations being effected in the various languages and language scripts used around the world. It may be expected, however, that the introduction of internationalized domain names will introduce certain dimensions to the problem of conflicting identifiers across different languages and language scripts which are additional to those already experienced in respect of conflicting trademark registrations. Those new dimensions are likely to include the evaluation of the importance of phonetic similarity in the context of a largely visual or textual medium, the speed and relatively low cost with which a domain name registration can be obtained compared to the time and cost associated with obtaining trademark registrations and the automaticity of domain name registrations in contrast to the examination procedure that precedes the registration of trademarks.

New gTLDs

28. At its meeting on November 16, 2000,[\[18\]](#) the ICANN Board selected the following seven new top-level domains for introduction: .aero, .biz, .coop, .info, .museum, .name and .pro. The selection followed a process conducted by ICANN which included the publication of criteria for assessing new TLD proposals, a call for applications, the publication of the non-confidential portions of the 47 applications received, a public comment period and the publication of a report evaluating the applications received.

29. The seven new gTLDs fall into two categories: (i) “unsponsored” TLDs, which are intended to be relatively large and to operate under policies established by “the global Internet Community directly through the ICANN process,”[\[19\]](#) and (ii) “sponsored” TLDs, each of which is intended to be “a specialized TLD that has a sponsoring organization representing the narrower community that is most affected by the TLD.”[\[20\]](#) The following table gives details of the name, nature, intended purpose and registry operator of each of the seven new gTLDs.

Table 1 - New gTLDs

TLD	Nature	Intended Purpose	Registry Operator
.aero	Sponsored	Air-transport industry	Société internationale de télécommunications aéronautiques, SC (SITA)
.biz	Unsponsored	Businesses	NeuLevel, Inc.
.coop	Sponsored	Cooperatives	National Cooperative Business Association (NCBA)
.info	Unsponsored	Unrestricted use	Afilias, LLC
.museum	Sponsored	Museums	Museum Domain Management Association (MuseDoma)
.name	Unsponsored	Individuals	Global Name Registry Ltd.
.pro	Unsponsored	Accountants, lawyers and physicians	RegistryPro Ltd.

30. The unsponsored TLDs will operate under “Registry Agreements” with ICANN. A common form of basic agreement has been negotiated with each of the four selected unsponsored TLD registry operators. Negotiations for agreements with sponsoring organizations for the three sponsored TLDs are in process.

31. The timetable for the introduction of the new gTLDs has not yet been completed. Two of the new gTLDs have announced dates for the commencement of operations open to the public, namely .info, which will commence on September 19, 2001,^[21] and .biz, which will commence on October 1, 2001.^[22] The dates for the commencement of operations of the other new gTLDs will be announced in due course. WIPO has been working with the Registries of the new gTLDs to provide advice and assistance concerning appropriate dispute-resolution policies.^[23]

32. *Intellectual Property Considerations.* One of the terms of reference of the first WIPO Internet Domain Name Process was to evaluate the effects of adding new gTLDs and related dispute-resolution procedures on trademark and intellectual property holders.^[24] The Report of that process concluded that, subject to the implementation of recommendations made in the Report, new gTLDs could be introduced "provided that they are introduced in a slow and controlled manner which takes account of the efficacy of the proposed new practices and procedures in reducing existing problems."^[25]

33. All four new unsponsored gTLDs are expected to apply the UDRP. In addition, three of them, .biz, .name and .pro are expected to apply a dispute-resolution procedure as a means of enforcing the limitation of purpose governing them (registration by businesses for .biz, registration by individuals for .name and registration by accountants, lawyers and physicians for .pro). The intended dispute-resolution policies to be applied by the new sponsored gTLDs are in the process of development, but they are expected to address potential questions of bad faith abuse of intellectual property rights and enforcement of restriction conditions governing the purpose of the new gTLDs.

34. In addition to the UDRP and other dispute-resolution policies that will govern open registry operations, the first two new gTLDs to come online have established procedures aimed at minimizing bad faith abuse of trademark rights during the initial start-up phase of registry operations. .info is implementing a "sunrise" period (from July 25, 2001 to August 28, 2001) during which trademark holders may register their exact trademarks as domain names in .info. The sunrise period will be followed by a period during which a Sunrise Challenge Policy will apply under which a person may challenge a registration made during the sunrise period on the ground that the registration does not conform to the requirements for registration during the sunrise period (for example, the domain name is not identical to the trademark claimed in support of it).^[26] Afilias, the Registry operator of .info, has also announced that it will itself initiate challenges in respect of manifestly false registrations of names during the sunrise period.^[27] In the case of .biz, the Registry operator, Neulevel, is implementing a procedure whereby a trademark owner may register a claim with respect to the trademarks that it owns. If a domain name registration is made by a third party in respect of the trademarks claimed, the trademark owner which has registered the claim will be notified of the registration. The trademark owner will then have the opportunity to initiate a challenge in respect of the domain name on the ground that the domain name has been registered or is used in bad faith.

35. It is too early in the process of the introduction of the new gTLDs to assess what impact, if any, they will have on intellectual property. The introduction of the new gTLDs will be closely monitored by all and, in particular, from the perspective of intellectual property, with respect to the following issues:

- (i) the effectiveness of sunrise and other procedures for reducing the bad faith violation of trademark rights during the start-up phase of new gTLDs;
- (ii) the impact of increased differentiation in the DNS upon the interface between domain names and intellectual property rights and whether increased segmentation in the DNS will create greater space for brand differentiation or increase the number of problems experienced with respect to the bad faith violation of intellectual property rights through domain name registrations;

- (iii) the response to greater differentiation in the DNS on the part of Internet users, search engines and directory services; and
- (iv) the design and inter-relationship between WHOIS services across an extended DNS.

A Unique, Authoritative Root

36. The DNS relies upon a single authoritative root to ensure reliable universal connectivity on the Internet. As stated by the Internet Architecture Board (IAB):

“To remain a global network, the Internet requires the existence of a globally unique public name space. The DNS name space is a hierarchical name space derived from a single, globally unique root. This is a technical constraint inherent in the design of the DNS. Therefore it is not technically feasible for there to be more than one root in the public DNS. That one root must be supported by a set of coordinated root servers administered by a unique naming authority.”[\[28\]](#)

37. Various attempts have been made by operators to establish alternate roots. Certain of these attempts are considered to be benign insofar as they are either purely private, and thus insulated from the public DNS, or experimental and intended not to interfere with the operation of the DNS. Others have been commercially established to support top-level domains to compete with the single root managed by ICANN and may be considered to pose potential threats to the stability and reliability of the DNS.

38. On May 28, 2001, ICANN published a “Discussion Draft: A Unique, Authoritative Root for the DNS” for comments.[\[29\]](#) On July 9, 2001, ICANN published Internet Coordination Policy 3 (ICP-3) “A Unique, Authoritative Root for the DNS.”[\[30\]](#) In this latter instrument, ICANN affirms its “commitment to a single, authoritative public root for the Internet Domain Name System (DNS) and to the management of that unique root in the public interest according to policies developed through community processes.”

39. From the intellectual property perspective, alternate roots present the possibility of a loss of cohesion in the application of the UDRP. As described in paragraphs 9 and 10 above, and in Chapter 2 below, the UDRP represents a contractually based system for the implementation of intellectual property policy in the DNS. Intellectual property policy, as expressed in the UDRP, is implemented through registrar accreditation agreements with ICANN and through the contract between the applicant for a domain name registration and the registrar under which the holder of the domain name registration agrees to submit to the uniform dispute-resolution procedure if challenged by a third party. Insofar as alternate roots lie outside the contractual system established by ICANN, the application of the UDRP by operators of alternate roots is not ensured and depends upon their voluntary adoption of the UDRP or a similar policy.[\[31\]](#)

Internet Keywords

40. Internet keywords offer a natural language Web addressing system or a navigational system based on the use of words, without technical prefixes, such as *http://* or *www.*, and without top-level domain suffixes, such as *.com*, *.net* or *.org*. Keywords resolve to URLs and, in some cases, e-mail addresses, usually through the use of the keyword in the browser location bar. While being navigational tools, keywords can also be regarded as virtual identifiers and, as such, have intellectual property implications.

41. Keywords do not constitute a competing rooting system to the DNS, but rather an application layer super-imposed upon the DNS.
42. Keywords are available from several services, including CommonName Ltd.,[\[32\]](#) Netscape[\[33\]](#) and RealNames Corporation.[\[34\]](#) Keywords are also available in non-Roman script.
43. Keyword providers offer dispute-resolution services in respect of bad faith and deliberate misuse of trademarks through keywords.[\[35\]](#) These dispute-resolution policies are largely compatible with the UDRP, but are adopted on a voluntary basis since providers are not obligated through the ICANN system to apply the UDRP or a compatible policy.
44. As keywords systems become increasingly used in web browsers and search engines, the possibility of conflicts between keywords and intellectual property rights is likely to increase. Depending on their evolution, user uptake and the effectiveness of voluntary dispute-resolution procedures applied by providers, the intellectual property dimensions of keywords and other addressing systems super-imposed on the DNS could warrant further study.

THE PROCESS OF CONSULTATIONS IN THE SECOND WIPO INTERNET DOMAIN NAME PROCESS

45. As mentioned in paragraph 2, above, the Request addressed to WIPO, which initiated the process leading to the present Report, called for “a process of consultation with WIPO Members and all interested stakeholders.”
46. In order to undertake the requested process of consultation, WIPO adopted procedures modeled on those followed in the first WIPO Internet Domain Name Process. The Second Process thus also comprises three stages and was conducted in English, French and Spanish.
47. The first stage sought greater definition in the issues that were to be addressed in the course of the process, the procedures that were to be used and the timetable that would be followed. To this end, a Request for Comments (WIPO2 RFC-1) was issued on July 10, 2000, with a deadline for receipt of comments by August 15, 2000.
48. The second stage of the process consisted of seeking comments and consulting on the issues defined after consideration of the comments received on WIPO2 RFC-1. To this end, a second Request for Comments (WIPO2 RFC-2) was issued on October 13, 2000, with a deadline for receipt of comments of December 29, 2000.
49. The third and final stage of the process consisted of the publication, on April 12, 2001, of an Interim Report, *The Recognition of Rights and the Use of Names in the Internet Domain Name System*.[\[36\]](#) The Interim Report was issued in the form of a third Request for Comments (WIPO2 RFC-3), with a deadline for the submission of comments of June 15, 2001.
50. Each of the above-mentioned Requests for Comments was published on the web site established for the Second WIPO Internet Domain Name Process (<http://wipo2.wipo.int/process2/index.html>), as well as in paper form. The paper version was also sent to the governments and industrial property offices of each of the 177 Member States of WIPO, and to intergovernmental organizations and non-governmental organizations accredited with observer status at WIPO.

51. In addition to the Internet-based and written consultations, WIPO also organized, throughout the latter part of 2000 and the first of part of 2001, physical meetings in 10 cities throughout the world. Details of the location of those meetings and participation in the meetings are given in Table 2, below.

Table 2 - Consultation Meetings Organized

Location	Date(s)	Participation (approx.)
São Paulo, Brazil	August 2 and 3, 2000	41
Chiang Mai, Thailand	August 3 and 4, 2000	58
Amman, Jordan	September 18 to 20, 2000	100
Krakow, Poland	October 25 and 26, 2000	63
Brussels, Belgium	April 23, 2001	34
Accra, Ghana	April 26, 2001	98
Buenos Aires, Argentina	May 10, 2001	46
Melbourne, Australia	May 24, 2001	40
Washington, D.C., United States of America	May 29, 2001	31
Valencia, Spain	May 30, 2001	19

52. In all, throughout this Second WIPO Internet Domain Name Process, written comments on the three Requests for Comments and physical participation at the meetings held were engaged from 51 government agencies of 28 countries, 18 intergovernmental organizations and agencies, 44 non-governmental organizations, 201 corporations and professional firms and 184 individuals. 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 this Report.

THE SUBMISSION OF THE PRESENT REPORT

53. The Request initiating the Second WIPO Internet Domain Name Process indicated that

the “findings and the recommendations [of the Process] should be submitted to the Members of WIPO and for consideration by the Internet Community (including the Internet Corporation for Assigned Names and Numbers).”^[37] Accordingly, the present Report will be submitted to the Assemblies of Member States of WIPO at their meeting from September 24 to October 3, 2001, and will be submitted to the Board of ICANN. In addition, the Report will be published on the WIPO web site and distributed widely in paper form.

2. POLICY OPTIONS FOR A GLOBAL MEDIUM

54. The Domain Name System (DNS) has presented a set of problems for intellectual property policy, as well as a set of opportunities, that are perhaps unique in the historical development of the intellectual property system. The problems arise from the spontaneous adaptation of a technical addressing system to functions and purposes beyond those for which it was originally designed. In addition to providing a human friendly, reliable and stable routing system, the DNS has given rise to identifiers that are used for commercial, cultural, governmental, political and social purposes, both on the Internet itself and in similar contexts beyond the Internet. The opportunities arise from the hierarchical design of the DNS and the set of contractual relations that bind ICANN, registries, registrars and domain name holders in various relationships, thereby providing a means for implementing common terms of policy in those relationships.

55. The Uniform Domain Name Dispute Resolution Policy (UDRP) can be seen as a largely successful use of the opportunities provided by the hierarchical design of the DNS, although it is not without critics. The Second WIPO Internet Domain Name Process involves a series of far-reaching questions, which ultimately relate to the interface between the virtual identifiers that domain names are and identifiers that have a basis in naming systems that have been deployed historically throughout the real or non-virtual world. Some of those naming systems are circumscribed by legal rules and principles (for example, geographical indications or trade names), and some operate within social, cultural and spiritual contexts that contain their own, not necessarily legally binding, rules and principles (such as the names of countries, peoples or geopolitical entities). For the Internet to play its role as a global medium, or for the DNS to be a global addressing system, the diversity that accounts for the richness of the world must be taken into account.

56. Before examining, in the ensuing chapters of this Report, the current state of law, policy and practice in relation to these questions and the desirability of taking action upon any of them, it may be opportune first to review the options for intellectual property policy development and implementation that are available to the international community should it choose to take action in respect of any possible solutions.

57. In examining the available options for policy development and implementation, it is useful to commence by recalling first, the special features of the environment in which intellectual property policy with respect to domain names applies, and, secondly, the distinction between the application of existing policy and the creation of new policy.

SPECIAL FEATURES OF THE ENVIRONMENT

58. It is widely recognized that the Internet presents special challenges for policy development and implementation. There are four features that are particularly pertinent in the present context.

A Global Medium

59. The Internet is global in several senses. It is accessible from any place in which the appropriate telecommunication facilities exist, with the consequence that the users of the Internet reflect, or potentially reflect, the diversity of the world's population. A domain name registration, whether in a gTLD or a ccTLD, gives a global presence which makes the corresponding online address accessible from anywhere. There are advantages for all in this universal connectivity, which allows the Internet to be a medium for international commerce, cultural exchange, political expression and social communication. Less often recognized than the advantages are the responsibilities that flow from having a global presence and a globally accessible web site, since virtual contact is a far less hazardous experience than physical contact.

A Global Space

60. The Internet makes possible a global space for activity. It is true that activity on the Internet will have a series of territorial connections: the location of the computer from which the activity emanates, the location of the server, the location of the computer on which the activity is perceived, the locality of the target audience, the locality of the accidental audience that may perceive or be able to perceive the activity, the territory over which messages travel, and so forth. Sorting out the territorial connections to activity on the Internet is, however, a difficult exercise and the reality is that activity on the Internet is not susceptible to territorial localization in the way in which activity in the non-virtual world is. The absence of territorial localization in this way stands in contrast to the historical basis of political and legal systems in which policy is formulated by governments and parliaments for the territory over which they exercise authority and the ensuing legal rights are limited to, and enforced within, the same territories. Who has authority to make policy for a global space and who has authority to enforce that policy are complicated questions to which there are no easy answers.

Speed of Penetration and of Change

61. The Internet has been characterized by extremely rapid acceptance and adoption. Estimates indicate that the number of users of the Internet has risen from several thousand in August 1981 to 460 million in 2001.^[38] This rate of adoption is much quicker than the rate of adoption of the telephone or television.^[39]

62. Not only has the rate of adoption of the Internet been exceptionally quick, but also the technologies that it deploys and policies governing the DNS have been in rapid evolution, as Chapter 1 indicates. The distinction between gTLDs and ccTLDs is not as clear as the descriptions of those categories of top-level domains suggest. Language within the DNS is in dynamic evolution. The generic top-level domain space is being expanded and new forms of virtual identifiers are being deployed.

63. In this context of rapid growth and change, understandably, there is a certain anxiety about the potentially negative effects that heavy handed regulation might have.

Multifunctionality

64. As noted above, the Internet is used by a diverse range of people for a diverse range of purposes. Every adjective that can be used to describe a branch of human activity finds its corresponding noun in activity on the Internet: research, science, technology, commerce, culture, entertainment, leisure, communication, religion, politics, pornography, lunacy and so forth. Making policy for one area so as not to damage the legitimate interests of another area is also a complicated issue.

CREATING - V - APPLYING LAW

65. It is not inappropriate to recall some old distinctions in political and legal theory. In particular, there is a well accepted distinction in theory, even if not always so easily applied in practice, between creating law, a legislative activity, and applying it, an executive activity. Legislation, at least in liberal democracies, is the activity of elected representatives of the constituency to which the legislation applies. The executive function is performed by duly appointed or constituted agencies.

66. The recommendation in the first WIPO Internet Domain Name Process to establish a uniform domain name dispute resolution procedure (UDRP) was essentially an exercise in finding a means to express, in an economically rational and effective way, principles that were widely accepted in national and international laws. There has been history of nearly 120 years of international cooperation in trademarks, the Paris Convention for the Protection of Industrial Property (the Paris Convention) having been concluded in 1883. The result of that history of cooperation is a relative convergence in national trademark laws, as well as a clear international legal regime governing trademarks in the Paris Convention and the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS). The UDRP does not seek to regulate the whole universe of the interface between trademarks and domain names, but only to implement the lowest common denominator of internationally agreed and accepted principles concerning the abuse of trademarks. The exercise was less about legislation than about the efficient application of existing law in a multijurisdictional and cross-territorial space.

67. The Second WIPO Internet Domain Name Process involves more difficult questions where it is as well to remember the distinction between positive law, or what the law is, and normative law, or what the law should be according to opinion gauged to be more or less widespread. From the point of view of positive law, as will be seen in the ensuing chapters, the questions to be addressed in the present Report fall into three categories:

(i) questions on which there is a clear international norm requiring protection of a certain subject matter, but under-developed modalities for the international recognition of the subject matter that is to be protected (with the consequence, that the appreciation of the subject matter to be respected often is left to national law). Into this category fall geographical indications and trade names.

(ii) questions where there are elements of an international framework for the protection of the subject matter, but those elements are incomplete or insufficiently precise. Into this category fall the names and acronyms of international intergovernmental organizations and International Non-proprietary Names (INNs) for pharmaceutical substances.

(iii) questions in respect of which there are no existing international norms, however unjust the absence of such norms might be. Into this category fall personal names, the names of countries and other geographic, geo-political and geo-ethnic terms.

OPTIONS FOR INTELLECTUAL PROPERTY POLICY

68. There are three main models which are available to the international community for the further development and implementation of intellectual property with respect to domain names. Each of these models is described below, together with their principal advantages and limitations. The models are not alternatives but can be used in cumulation so as to take advantage of the positive features of each, as well as to take into account their limitations. If the international community should wish to establish rules with respect to the questions examined in the ensuing chapters of this Report, it would need also to decide on the optimal way in which those rules can be developed and implemented.

Self-Regulation

69. The first model for adopting and implementing intellectual property policy is the self-regulatory model, under which, in the context of the DNS, registries, in cooperation with any supervisory body that may exercise authority over them, develop and adopt rules governing intellectual property protection within the domains for which they are responsible. Those policies can then be implemented through terms in the contractual relationships that govern registrations made in the domains in question. Naturally, the rules in question must conform to applicable law.

70. To a certain extent, self-regulation is already practiced in certain areas of the interface between domain names and intellectual property. The administrators of ccTLDs are not obligated to apply the UDRP. As indicated above (paragraphs 18 to 21), 22 ccTLDs have voluntarily adopted the UDRP. A number of others have, however, chosen to develop their own dispute-resolution mechanisms and charters with respect to the bad faith and deliberate violation of intellectual property rights through domain name registrations, for example, .uk.^[40] While the policy that they may adopt may bear a great similarity to the UDRP, it constitutes a self-contained system, which does not permit consolidation of cases concerning similar registrations held by the same person across different domains in the way that the UDRP permits consolidation across domains which apply the UDRP where the parties to a dispute are the same.^[41] In addition, as also indicated above (paragraphs 28 to 31), the registries of the new gTLDs are developing dispute resolution mechanisms with respect to intellectual property that differ from the UDRP, such as the sunrise or start-up policies applied in .info and .biz. Furthermore, providers of domain name services in alternate roots, as well as providers of Internet keywords, practice self-regulation.

71. The *advantages* of self-regulation are relatively swift development and implementation of rules, as well as relatively flexible procedures for modification of rules, where necessary, a particularly desirable feature in the context of a rapidly evolving medium. In addition, rules backed by a dispute-resolution procedure have the great benefit of rapid and effective enforcement through the registry adopting the rules. In the case of ccTLDs, there is also the advantage of greater possibility of adopting specific rules to accommodate local circumstances.

72. The *disadvantages* of self-regulation are the risks of incoherence in policy across a global medium and a global space, with the resultant possibility of conflicting rules, increased compliance costs for users, who may have to conform to a variety of differing rules and systems, and an increased possibility of confusion on the part of users in knowing what is and what is not permissible. Self-regulation also depends for its effect on legislative discipline to restrain the possibility of an increasing number and diversity of national laws applying to regulate various facets of the interface between domain names and intellectual property rights. Legislation relating to aspects of domain names and intellectual property

rights exists in the United States of America,^[42] is under consideration within the European Union in the form of a proposed Regulation of the European Parliament and of the Council with respect to the proposed top-level domain .eu^[43] and has been considered in a number of countries, including Belgium^[44] and Italy.^[45]

The ICANN Contractual Model

73. The second main model is the one predominantly applied at present through the Internet Corporation for Assigned Names and Numbers (ICANN). It consists of the use of a hierarchical design of the DNS to implement, through contractual arrangements, common rules governing the interface (or part of the interface) between intellectual property and domain names. The UDRP has been adopted and is applied in this manner.

74. The *advantages* of the ICANN model are relatively swift adoption and implementation of rules, together with a relatively flexible possibility for modifying such rules. In addition, through the required adoption of the UDRP (or cognate rules) on the part of registrars and the approval of standard terms for contracts between registrars and domain name applicants, the system has the beauty of rapid and effective enforcement (since remedies under the UDRP are limited to what may be technically achieved in the DNS, such as the transfer or cancellation of registration). The model has also the advantage of ensuring coherence in policy application across the generic top-level domain name space. In addition, it makes use of ICANN's specialist expertise in the management of the technical functioning of the DNS, as well as its decision-making processes and instances which have been designed to encourage participation on the part of all interested stakeholders.

75. The *disadvantages* of this model are that ICANN's mandate and focus of activity are the technical coordination, technical management and operational stability of the Internet. ICANN's Articles of Incorporation state, in Article 3, that it shall pursue "the charitable and public purposes of lessening burdens of government and promoting the global public interest in the operational stability of the Internet by (i) coordinating the assignment of Internet technical parameters as needed to maintain universal connectivity on the Internet; (ii) performing and overseeing functions related to the coordination of the Internet Protocol ("IP") address space; (iii) performing and overseeing functions related to the coordination of the Internet Domain Name System ("DNS"), including the development of policies for determining the circumstances under which top-level domains are added to the DNS root server system; (iv) overseeing operation of the authoritative Internet DNS root server system; and (v) engaging in any other related lawful activity in furtherance items (i) through (iv)." In view of these functions and focus, ICANN may see the development of new rules of intellectual property policy, as opposed to the use of the contractual basis of the ICANN system to implement existing rules, as a burden that it might usefully do without.

76. In addition, certain areas remain outside the ICANN contractual model, notably in respect of the UDRP or cognate rules, ccTLDs, alternate roots and, to the extent relevant, other virtual identifiers. It relies also, like self-regulation, on legislative restraint on the part of national parliaments to avoid the possibility of conflicting national laws and to avoid consequential increases in compliance costs and the risk of a confusing diversity of approaches.

The Treaty

77. The third model is the instrument traditionally used by the international community to create binding rules that limit the inconsistent exercise of national legislative competence, namely the treaty. The treaty is the international equivalent of a national law and the process

leading to its adoption is the international equivalent to the national legislative process.

78. The *advantages* of the treaty are the representative nature of the process leading to the treaty's conclusion, which typically includes consultations on the part of national delegations with interested circles in formulating national positions, extensive international negotiations by duly authorized representatives, adoption of the treaty by duly empowered representatives specialized in the subject matter of the treaty and accession to or ratification of the treaty through national consultative and parliamentary or congressional processes. The treaty also has, of course, binding force amongst contracting parties and remains the instrument used by the international community for achieving the uniform application of the rules.

79. The *disadvantages* of the treaty are the length and slowness of the multilateral process for the negotiation of the instrument, which typically requires a number of years that is often incompatible with the speed of response required by the Internet, and the length of time required for the subsequent ratification of the treaty in order to bring it into force across a geographically effective and pertinent area. In addition, once concluded, a treaty is often a relatively inflexible instrument for dealing with areas subject to rapid and radical change, since amendment usually requires time-consuming procedures of consultation and negotiation akin to those required for the adoption of the treaty.

80. It is clear that, if the treaty process were to be used with respect to intellectual property questions relating to domain names, great care would need to be exercised to ensure that its provisions were technology-neutral and did not condition the future development of the DNS or the Internet. In addition, great reflection would be needed to develop appropriate mechanisms for ensuring that the multilateral negotiation process took place within a relevant timeframe, and that mechanisms were envisaged to allow flexibility for any necessary changes or adaptations, while at the same time not depriving national parliaments and congresses of their sovereign rights to consent to the content of an instrument which may become binding on their constituents.

3. INTERNATIONAL NONPROPRIETARY NAMES FOR PHARMACEUTICAL SUBSTANCES (INNs)

81. In common with other areas, the health sector has been affected in a variety of new and fundamental ways by the Internet. Vast amounts of health-related information and products are available through the Internet to a global audience which can retrieve and use them with unprecedented ease and efficiency.^[46] The accuracy, reliability and safety of the information and products retrieved are matters of primary interest to public health and safety.

82. Identifiers play an important role with respect to health products, services and information, both on the Internet and in the physical world. In particular, identifiers:

- (i) enable health-related information to be located online;
- (ii) signal the source of products, services and information; and

(iii) connect producers or suppliers, on the one hand, and consumers, on the other hand, enabling consumers to associate certain consistent characteristics of products or information with the identifiers.

83. The pharmaceutical industry, the medical profession and associated suppliers of medical equipment and services use a variety of identifiers, including trademarks for branded pharmaceutical products, service marks for suppliers of medical services, personal names for physicians and surgeons, traditional names for tradition-based products and remedies and trade names for enterprises providing products and services or for associations grouping professional persons or trade interests. The domain name system (DNS) imposes a new layer of identifiers for the on-line environment in which all these products, services and associations operate. The interaction between domain names and the series of identifiers used specifically in the health sector, and the impact of domain names on the latter set of identifiers, are matters of significant concern.

84. In recognition of the importance of identifiers and of the fact that most of those used for health products and services are the subject of private (intellectual property) rights and thus, privately controlled, more than 50 years ago the health sector developed a system for ensuring that, in the interests of public safety, a class of identifiers would be established that would be free from appropriation through private rights and available for public use. This system, developed and managed by the World Health Organization (WHO), attributed such public status to a class of identifiers known as "International Nonproprietary Names (INNs)." The system operates on the basis of consensus on the part of public authorities and the private sector.

85. With the arrival of the Internet and DNS, a new opportunity arose for tainting the public status of INNs. By registering an INN as a domain name, the functional capacity of the INN to serve as an address locator and identifier on the Internet could be appropriated and controlled by the domain name holder. No screening system exists to prevent anyone from doing this.

86. The registration of INNs as domain names came to light in the course of the first WIPO Process. The Report of that Process recognized that the issue was outside the scope of the mandate of the first Process, but recommended that serious consideration be given in future to the protection of INNs against registration in the open top-level domains (gTLDs).^[47] This recommendation led to the request to WIPO to explore, in the Second WIPO Process, the issues raised in the DNS by the bad faith, abusive, misleading or unfair use of INNs. In addressing this request, the present Chapter describes the operation and policy of the INN system, analyses the comments received in the course of the Second WIPO Process and evaluates the evidence of current problems experienced in the DNS relating to the registration of INNs. It explores policy options for protecting INNs within the DNS and recommends consideration of a simple mechanism for maintaining the public availability and status of INNs within the DNS.

THE INN SYSTEM

87. An International Nonproprietary Name (INN) is a unique name used to identify a pharmaceutical substance or active pharmaceutical ingredient. Some examples of INNs are amoxicillin, ampicillin, nandrolone, temazepam, phenobarbital, amphetamine, ibuprofen, chloroquine and retinol.^[48] INNs are selected by WHO, in coordination with national authorities worldwide, and maintained on a Cumulative List of recommended INNs, now numbering more than 8,000, to which between 120 and 150 new names are added each year.^[49]

88. WHO is a specialized agency of the United Nations with 191 Member States and a constitutional responsibility to "develop, establish and promote international standards with

respect to biological, pharmaceutical and similar products.”[\[50\]](#) WHO has the international mandate to offer recommendations to its Member States on any matter within its competence, including setting norms and standards for pharmaceutical products in international commerce.

89. The INN system was established by a World Health Assembly resolution in 1950,[\[51\]](#) which also provided for the development of a selection procedure for recommended INNs. The procedure for selection of INNs begins with a request, often by a national nomenclature authority or a pharmaceutical company, which is submitted for examination and name selection by the WHO Expert Panel on the International Pharmacopoeia and Pharmaceutical Preparations (‘WHO Expert Panel’), made up of representatives of the major national nomenclature committees. The proposed INN is published in *WHO Drug Information* for comment or objection by any interested person over a four-month period. If no objection is raised during that period, the name is published as a recommended INN.

90. To qualify for selection, INNs must be succinct, distinctive in sound and spelling, so as to avoid confusion with other commonly used names, and must be in the public domain and therefore freely available for the sole purpose of identifying the pharmaceutical substance in question. To enable INNs to be used around the world, various linguistic conventions are harmonized by rules that specify, for example, which letters should be avoided (‘h’ and ‘k’), that ‘e’ should be used in lieu of ‘ae’ and ‘oe’, ‘i’ instead of ‘y’ and ‘t’, and ‘f’ instead of ‘th’ and ‘ph’. The WHO Procedure for Selection of INNs is set out at Annex IV to this Report.

91. Recommended INNs are notified by WHO to its Member States, with a request that their national authorities take the necessary steps to prevent the acquisition of proprietary rights in the name, including prohibiting registration of the name as a trademark.

92. As a result, there now exists an international consensus among relevant public and private circles on the public policy against the acquisition of proprietary rights in INNs. The policy extends to trademarks and calls for restraints on the part of private health enterprises and public trademark registration authorities not to allow trademark rights to be acquired over INNs. The exact INN itself and the stem of the INN may not be registered as a trademark. In line with the intended status of INNs as generic or common names, manufacturers of pharmaceutical substances are encouraged to use their corporate names together with INNs in marketing products. Thus the use of “[INN] [name of manufacturer]” in the promotion and marketing of products is not considered to offend the policy against acquisition of proprietary rights in INNs.

THE POLICIES UNDERLYING THE INN SYSTEM

93. The prohibition of the acquisition of proprietary rights in INNs is intended to implement three main policy objectives:[\[52\]](#)

(i) The establishment of INNs as unique, globally available, generic names which are free of proprietary rights and, thus, available for use by all for the purpose of identifying pharmaceutical substances. The public status of such names is intended to ensure that no confusion can arise about drugs or their pharmacological activity and properties in international dispensing practice and in communication and exchange of information among health professionals and scientists worldwide.

(ii) The promotion of the veracity and reliability of health information, which could be endangered if INNs were able to be controlled by a single person or entity.

(iii) The prevention of dilution in the meaning or semantic associations established with respect to INNs, with consequent risk to patient safety, which could occur if INNs were legally

controlled by private interests.

EVIDENCE OF REGISTRATIONS OF INNs IN THE DNS

94. The registration of an INN as a domain name creates a monopoly of association with that unique address in the domain concerned. While a domain name is not a legal title which confers upon its holder the right to exclude others from using it in other contexts, it is a unique address. As a result, anyone who registers an INN as a domain name occupies a unique space and acquires a singular advantage in associating the website that is accessed through the domain name with the INN. Without any external control over the veracity and reliability of the information relating to the INN, there are risks of confusion posed to health professionals and consumers.^[53] As one commentator remarked: “Any use or registration of INNs which would lead the public to confusion as to a pharmaceutical substance or active pharmaceutical ingredient should be restricted.”^[54]

95. In response to the call for evidence of abusive registrations of domain names, WHO and the European Federation of Pharmaceutical Industries and Associations (EFPIA) have submitted studies of INNs that have been registered as domain names by individuals or pharmaceutical businesses. The studies, set out at Annex V, demonstrate that numerous INNs have already been appropriated in the DNS (e.g., sildenafil.com, also known as ‘viagra’, also ampicillin.com, amoxicillin.com, tagamet.com, tetracycline.com, diclofenac.com, diazepam.com and lorazepam.com). These domain names are used for various purposes: some merely provide information about the pharmaceutical substance, but the majority are proprietary sites registered and used to advertise or sell pharmaceuticals.^[55] The WHO comments that such purposes are antithetical to the policy of the INN system, which reserves INNs for mere identification purposes.^[56] No evidence has been provided through the Second WIPO Process of actual harm resulting from the registration of INNs as domain names, beyond the damage done to the integrity of the INN system. Several commentators point to the insufficiency of such evidence to argue against the need for protection of INNs.^[57]

ANALYSIS OF COMMENTS AND VIEWS EXPRESSED IN RESPONSE TO THE INTERIM REPORT

96. The Interim Report posed the question whether INNs should be protected in the DNS. A significant majority of commentators to the Second WIPO Process were in favor, or strongly in favor, of the protection of INNs in the DNS.^[58] It was largely agreed, in principle, that the integrity of the INN system and the preservation of its underlying policies require that INNs be protected against registration as domain names. Some commentators, however, opposed such protection of INNs on the grounds of free speech, competition policy, health and consumer protection.^[59] Certain argued that, for generic words such as INNs, the only fair means of apportionment may be first-come, first-served.^[60] A minority of commentators referred to the insufficient evidence of abuse to conclude that INNs did not require protection at this stage.^[61] It was also noted that abuse, and consequent risk to patient safety, is most critical in the bad faith use of the domain name and not its registration *per se*.^[62] However, these comments do not recognize the damage which is occasioned to the integrity of the INN system, which depends upon consensus compliance, as a consequence of the registration of INNs as domain names. It was for these reasons that the majority of commentators to the Second WIPO Process favored the implementation of some means to protect INNs in the DNS.

97. The Interim Report put forward five issues that required consideration in giving expression to any protection of INNs in the DNS. Each issue is discussed below, with

reference to the comments received.

- First, whether protection should be applied only against registration of domain names that consist solely of INNs, or should extend to domain names that consist of INNs together with additional words (e.g., “[INN][name of manufacturer]” or “[INN][info]”).

98. On this issue, the comments submitted to WIPO were largely in favor of permitting the registration as a domain name of an INN together with the name of a manufacturer, as permitted in the physical world.^[63] As noted by WHO, with respect to the existing INN system, the use of an INN is permitted together with the name of a manufacturer of the INN. This possibility was also favored as enabling consumers to locate INNs via their manufacturer.^[64] Against this proposal, it was argued that allowing an exception only for the use of the INN together with the name of the manufacturer would enable large pharmaceutical companies to monopolize the flow of information and trade on those drugs.^[65] In this respect, however, it is noted that there remain many alternate possibilities for exchange of information and sale of pharmaceuticals online and off, including through use of the INN on a web site itself, that are not precluded by restriction of the registration of an INN as a domain name, with or without the name of the manufacturer.

99. On the issue whether it should be permitted to register INNs together with additional words, such as ‘info’ or ‘usergroup’, comments were divided. Several commentators, emphasizing the need for free speech and public information, favored permitting registration of composite names for these purposes.^[66] By contrast, WHO remains firmly opposed to permitting the registration of domain names derived from an INN, including the registration of an INN plus any other word, if such registration is misleading or otherwise in ‘bad faith’, defined by WHO to mean any registration not strictly limited to providing information relating to the pharmaceutical substance, but used for advertising or promotional purposes.^[67] This view was supported by other commentators, who identified the potential risk to consumers of confusion caused by such registrations,^[68] prompting the European Commission to comment that if composite names including INNs were permitted, then the website should be required to display a standard disclaimer, informing the public that the information on the site was not approved by WHO.^[69]

- Secondly, whether protection should cover only domain names that contain exact INNs or should extend also to names that are misleadingly similar (e.g., misspellings).

100. This question concerns whether protection should apply to the prohibition of the registration of domain names that are misleadingly similar to INNs. In this respect, it may be recalled that the UDRP that applies at present in the open gTLDs extends the protection conferred upon trademarks to the prohibition of the registration and use in bad faith of domain names that are misleadingly similar to trademarks.^[70] It should be noted that the policies underlying INNs and trademarks are different: in the case of INNs, the objective of the system is to ensure that the INN can be used freely by all, as well as to preserve a clear identification mechanism for the global health system, whereas in the case of trademarks, the objective of the system is to restrict the use in commerce of the trademark, on similar goods and services, to the single person or entity that owns the trademark. Nevertheless, misleadingly similar variations of either identifier can, in each case and in different ways, interfere with the underlying policy objectives and create confusion as to the nature of the identifier or its source.

101. As discussed above, and in relation to this issue, WHO was firmly opposed to a system of protection that would allow the registration of misleadingly similar, or otherwise bad faith, versions of INNs.^[71] It is apparent that such registrations could be effected precisely in order to mislead and confuse consumers and users, or to circumvent any restriction on registration of exact INNs, in contravention of the policies underlying the INN system. A comment, from Mexico, noted that protection of INNs against misleadingly similar domain name registrations was consistent with their national legal system, which prohibits the

registration as trademarks of words within a three-letter difference to an INN so as to avoid consumer confusion.[\[72\]](#)

102. A number of commentators opposed the restriction of domain names similar to INNs, noting that there was no evidence to date of deliberate attempts by domain name registrants to mislead consumers.[\[73\]](#) Most of the opposition to any wider protection (beyond protection of the exact INN as a domain name) stemmed from some commentators' apprehension at the administrative burden that would be borne by registration authorities if an exclusion process were recommended and the authorities were then required to exercise quasi-legal judgment to determine whether a given domain name constituted a 'misleadingly similar' version of an INN.[\[74\]](#)

- Thirdly, whether protection should be extended to domain names that contain INNs in different languages and scripts.

103. The majority of commentators were in favor of extending any protection to INNs in the DNS to cover all the different languages and scripts that are used in the DNS.[\[75\]](#) As noted by WHO, the Cumulative List of INNs is published in seven official languages: Arabic, Chinese, English, French, Latin, Russian and Spanish. A number of commentators remarked that, as the policy objectives of the INN system apply irrespective of language or script, protection should extend beyond such languages, particularly at a ccTLD level, so as to protect INNs in all languages.[\[76\]](#)

- Fourthly, whether protection should address existing registrations of INNs.

104. This question relates to the treatment of existing registrations of INNs in the event that protection for INNs is introduced in the DNS. The retrospective application of any protective mechanism for INNs raised concerns among some commentators, who questioned whether domain names acquired in good faith could simply be cancelled. Under United States law at least, it was argued that this could amount to a regulatory action requiring reimbursement in accordance with national law.[\[77\]](#) Other commentators noted that cancellation of a registration contract entered into in good faith could amount to a breach of contract that could create problems between registrars and registrants.[\[78\]](#)

105. On the other hand, numerous commentators were in favor of the application of protection for INNs against past, as well as future, domain name registrations.[\[79\]](#) One commentator supported such retrospectivity, provided that protection applied only against bad faith registrations of INNs in the DNS, and did not prejudice rights acquired in good faith.[\[80\]](#) In this respect, it may be noted that the INN system is well known and well publicized within the health sector. Anyone who has registered an INN as a domain name, therefore, may be reasonably expected to have been aware of the underlying policy of the INN system against the establishment of private rights in INNs. Furthermore, the potential incompatibility of registering INNs as domain names with the policy of the INN system has been signaled by the custodian of that system, WHO, since the time of the first WIPO Internet Domain Name Process, which commenced in July 1998. It does not seem unfair, therefore, that any policy adopted for the implementation of the protection of INNs within the DNS should apply with respect to all past and future registrations of domain names. Furthermore, the allowance of any grandfather clauses for existing registrations would undermine the integrity of the INN system.

- Fifthly, whether protection for INNs in the DNS should apply to all gTLDs and whether it could appropriately be adopted by the administrators of ccTLDs.

106. The final question relates to the coverage of protection for INNs within the top-level domains. The majority of commentators were in favor of protection of INNs in gTLDs, including those that are open and restricted, existing and future.[\[81\]](#) Although the risk of abusive registrations in restricted gTLDs (.int, .mil., .edu and .gov) is very low, the extension

of protection to these domains does not seem to be problematic. With respect to new gTLDs, as noted in paragraph 28 to 31, above, ICANN has approved the introduction of seven new generic top-level domains, four of which (.biz, .info, .name and .pro) are “unsponsored,” meaning that they are intended to operate under policies established by “the global Internet Community directly through the ICANN process,” and three of which (.aero, .coop and .museum) are “sponsored,” meaning that they are each intended to be “a specialized TLD that has a sponsoring organization representing the narrower community that is most affected by the TLD.” In respect of the unsponsored new gTLDs, at least two of these will be opened to a large and essentially undifferentiated public. For these, any decision to protect INNs against registrations of domain names should clearly apply. For the other new gTLDs, it may well be that restrictions on persons who may register domain names within them may preclude the registration of INNs as domain names. In that case, there should not be any difficulty in the acceptance by such gTLDs of the extension to them of any decision to protect INNs against registration as domain names.

107. It was queried whether any protection of INNs could appropriately be adopted by administrators of ccTLDs. On this question, the majority of commentators were in favor of the protection of INNs at a country-code level.^[82] While any decision on the sorts of protection to be adopted within a ccTLD is a decision for the administrator and the competent national authorities, it is suggested that the efficacy of the INN system would best be promoted through the application of the protection of INNs in all ccTLDs. It should be noted, however, that national name systems, equivalent to the INN system, exist in a number of countries, such as British Approved Names (BAN), Dénominations communes françaises (DCF), Japanese Adopted Names (JAN) and United States Accepted Names (USAN). Such national name systems are, for the most part, harmonized with the INN Cumulative List. Nevertheless, it is recommended that, in considering the application of the protection of INNs, the ccTLD administrator do so in consultation with the national health authorities in order to ensure appropriate implementation of the policy.

ANALYSIS OF VIEWS EXPRESSED ON MEANS OF IMPLEMENTING PROTECTION

108. The Interim Report proposed for comment three alternate means to give expression to the protection of INNs within the DNS:

- (i) an exclusion or blocking mechanism;
- (ii) a modified Uniform Dispute Resolution Procedure (UDRP); and
- (iii) a notice and take-down procedure.

Exclusion Mechanism

109. The Interim Report proposed consideration of an exclusion mechanism to cancel registrations in all open gTLDs of domain names that exactly matched the INNs on the WHO Cumulative List, and to block any future registrations of such INNs. The exclusion mechanism gained the support of numerous commentators to the Second WIPO Process, including WHO,^[83] as an appropriate means to reflect in the DNS the established international principles for protection of INNs in the physical world, while preventing damage to the INN system and risk to consumers.^[84] The concept of an exclusion mechanism also received support from representatives of the pharmaceutical industries, as well as industry associations.^[85]

110. It is noted that a system for exclusions currently operates effectively in various trademark office practices around the world in the process of their examination of trademark applications for possible conflict with INNs.^[86] It was suggested in the Interim Report that an exclusion mechanism could operate through reference to WHO's existing MEDNET service – a publicly available, free, searchable database that allows access and queries to the INN database.^[87] The MEDNET database lists INNs with recommended, proposed and alternative medicinal names that, it was suggested, could be utilized by the domain name registration authorities administering an exclusion mechanism.^[88]

111. However, despite a general opinion in favor of protection of INNs, the concept of an exclusion met with significant opposition from numerous commentators, suggesting that it could not feasibly be implemented with the consensus of the Internet community. An exclusion mechanism was criticized by one commentator as over-inclusive, because it cancels names that do not threaten public health and safety, and under-inclusive because it does not purge the Web of misinformation about pharmaceuticals.^[89] The blunt method of an exclusion mechanism was also criticized as being inconsistent with the policy underlying generic drug names, in that it would result in limitation of free speech and open discussion concerning INNs both in the physical world and online. It was also noted that cancellation of existing domain names through an exclusion process would result in loss without due process for domain name holders.^[90] These views reflect a widely prevalent attitude among the Internet community against the implementation of blocking mechanisms within the DNS with respect to any identifiers. Commentators urged WIPO to recommend an alternate means of expressing the protection of INNs in the DNS.

Modified UDRP

112. Commentators to the Second WIPO Process were generally opposed to modification of the existing UDRP to address new identifiers that were outside the scope of the intellectual property legal system.^[91] Although the current UDRP does not cover INNs, at least one published UDRP decision touches upon this issue.^[92] Commentators expressed concern that the UDRP, as it stands, may be inappropriate to resolve disputes involving intergovernmental organizations, such as WHO, and private individuals.^[93] The UDRP and its requirement that complainants submit to the jurisdiction of national courts in respect of challenges to administrative decisions, would require a compromise in the customary immunity granted to international intergovernmental organizations, which is also problematic.^[94] Most commentators who supported the UDRP option for protection of INNs primarily supported the administrative nature of the process, as opposed to an exclusion mechanism. Others, while supporting the principle of protection for INNs, opposed both the UDRP and the exclusion mechanism: "While INNs should be protected against commercial use by one party, this should be effected through some means other than the UDRP, whether it be by treaty process or direct intervention on the part of ICANN."^[95]

Notice and Take-down Procedure

113. As noted above, the majority of comments to the Second WIPO Process were strongly in favor of some means to protect INNs in the DNS. Commentators favored a system that would efficiently prevent INNs from being registered as domain names in the gTLDs, if those registrations would have the effect of undermining the INN system and potentially confusing users and health professionals. Any mechanism for protection should not overburden domain name registration authorities, nor require an international intergovernmental organization (WHO) to be unduly subject to a costly dispute-resolution procedure to protect such identifiers in the public interest.

114. Under the proposed notice and take-down procedure, it was suggested that upon notification to WIPO by any interested party, (including, *inter alia*, individuals, consumer groups, manufacturers, medical associations, international organizations and governments), WIPO would verify that the domain name registration matches an entry on the Cumulative List of INNs in any official language, and notify ICANN of this fact. ICANN would then certify to the appropriate registrar that an exact INN has been registered as a domain name. The registrar would then be required, in conformity with its Registrar Accreditation Agreement, to cancel the registration forthwith.

115. The remedy of cancellation in such circumstances was supported by WHO as an effective remedy, despite the subsequent availability of such domain names for re-registration, as the possibility of cancellation through notice and take-down remains available in the event of any future re-registration.^[96]

RECOMMENDATION

116. A clear majority of commentators were in favor of the protection of INNs in the DNS. There were, however, differing views about the means of implementing that protection and, especially, about the extent of protection.

117. In these circumstances, we consider it to be appropriate to recommend the implementation, at this stage, of a very simple mechanism of protection that requires no judgements of similarity or good or bad faith use, but mere clerical verification. We recommend that there should be a prohibition against the registration of exact INNs in any of the official languages of the Cumulative List in the gTLDs, and that any exact INN registered in violation of this prohibition should be subject to cancellation, upon notification by any interested party to WIPO, verification by WIPO, in conjunction with WHO, of the exact similarity of the domain name registration and the INN, notice to ICANN by WIPO, and certification by ICANN to the registrar concerned (with notification to the domain name holder). Consideration could be given to allowing a reasonable transition period for the holder of the registration that is subject to cancellation to migrate to another domain name registration.

118. The world health community, through consensus among relevant public authorities and private circles, have considered it to be appropriate to establish the INN system for the protection of public safety and the promotion of a reliable system of identifiers that can be used by the world at large for health-related information. It has also invested considerable resources in the maintenance and further development of that system. A reliable and accurate database exists whereby anyone can obtain appropriate information about the status of an INN. It does not seem appropriate that a technical addressing system for the Internet should carry within it the possibility of flouting a system that has been carefully constructed by appropriately specialized public authorities and private industry, especially if a remedy is simply and efficiently available.

119. It is accordingly recommended that:

(i) ICANN's agreements with registries for gTLDs should require the prohibition of the registration of

exact INNs in any of the official languages of the Cumulative List as domain names;

(ii) a similar prohibition should be reflected in registration agreements for domain names in the gTLDs;

(iii) any interested party should have the right to serve notice that a domain name registration in a gTLD is identical to an INN and that, upon verification of the exact similarity between the domain name registration and the corresponding INN by WIPO, in conjunction with WHO, notice to ICANN, and certification by ICANN to the registrar concerned, the domain name registration should be cancelled.

120. It is also recommended that the prohibition should apply to all existing and future registrations of domain names. INNs are not common words, but fictitious, invented words, and their registration as a domain name is hardly likely to have been accidental. The INN system has been well publicized amongst all those operating in health-related professions and businesses. The registration of an INN as a domain name creates an exclusive control of that INN as an address in the corresponding domain, in contravention of the underlying policy of the INN system.

121. It is further recommended that administrators of ccTLDs adopt a corresponding policy, in conjunction with their national health authorities.

122. In making the abovementioned recommendations, it is pointed out that the INN system is not supported by an international treaty, but by a resolution of the competent treaty organ of the World Health Organization and by consensus between public authorities and private

industry. The effect of our recommendation is, therefore, to encourage ICANN to join the consensus established by the competent public and private authorities whose concern it is to promote public health and safety.

123. We do not recommend, at this stage, any further protection for INNs in the DNS, and, in particular, do not recommend an administrative dispute-resolution procedure in respect of misleading variations of INNs, for the following reasons:

(i) We believe that it is appropriate to commence with the certain and to review the application of the policy in the light of experience.

(ii) There is no convincing evidence of the damaging misuse of INNs through the registration of misleading variations of INNs as domain names. Since the existing policy of the INN system allows the use of the name of a manufacturer with an INN, difficult judgements might be involved in determining what is and what is not misleading in variations of INNs. Reliance upon the content of a web site addressed through a domain name may similarly involve difficult judgements, since content changes constantly.

(iii) Extending protection beyond domain names that are exactly similar to INNs would risk significantly increasing the administrative and transaction costs associated with the DNS. The UDRP, as it operates at present, is simple and the addition of more layers risks adding complexity that may be difficult for users of the DNS to apprehend.

(iv) The implementation of a simple procedure involving a clerical verification of exact similarity between a domain name registration and an INN does not require the development of policies on the extent of protection by ICANN, but simply the recognition by ICANN of the value of the naming system that has already been established by competent authorities in the health sector. Insofar as the Domain Name Supporting Organization (DNSO) has a responsibility of advising the Board of ICANN "with respect to policy issues relating to the Domain Name System" (see paragraph 15, above), those policy issues presumably are circumscribed by the definition of functions of ICANN set out in its Articles of Incorporation (see paragraph 75, above), which relate to the technical functioning and stability of the DNS. The Names Council of the DNSO has no constituency representing health interests.

124. In recommending that no further measures than the prohibition against the registration of exact INNs as domain names be taken at this stage, the possibility is left open to re-visit the question of such further measures at a later stage in the light of the experience gained with respect to the recommendation made (assuming that it is adopted) and of further evidence to suggest that the integrity of the INN system is damaged through the registration of misleading variations of INNs.

4. NAMES OF INTERNATIONAL INTERGOVERNMENTAL ORGANIZATIONS

125. One of the consequences of increased personal mobility, the networked society, open trading and financial systems and the power of technology has been that issues requiring public sector intervention are increasingly international in character. As a result, international intergovernmental organizations (IGOs) – such as the United Nations Organization (UNO),

the Food and Agricultural Organization (FAO), the International Labour Organization (ILO), the International Monetary Fund (IMF), the International Telecommunications Union (ITU), the World Health Organization (WHO), the World Meteorological Organization (WMO) and the World Trade Organization (WTO) – are called upon to play a progressively more important role in multilateral affairs among States and their citizens. The ability of these IGOs to fulfil their respective missions depends on effective communication and dissemination of information about their activities and services.

126. The Internet provides a powerful means for IGOs to present information about and encourage participation in their programs. At the same time, however, the Internet poses a risk that individuals and entities might attempt to capitalize, through unauthorized association, imitation, deception or fraudulent activity, on the standing of these organizations. If an IGO's name or acronym is used on the Internet by unauthorized parties, it may lose its distinctive power of identification, while the public, by virtue of the false associations, may be misled as to the information or products or services offered by the unauthorized party.

127. The Request addressed to WIPO to initiate the Second WIPO Process sought recommendations on whether and, if so, in what manner, protection should be accorded to the names and acronyms of IGOs against abusive registration as domain names in the DNS. This Chapter describes the existing international legal basis for the protection of the names and acronyms of IGOs; explains the operation and potential of the existing .int top-level domain; presents the evidence of existing abuses in the DNS; analyses the comments received on this issue in response to the Interim Report; and makes a recommendation on how the names and acronyms of IGOs might be protected within the DNS.

EXISTING INTERNATIONAL PROTECTION

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^[97] of IGOs.

129. Article 6*ter* of the Paris Convention for the Protection of Industrial Property (the Paris Convention), to which 162 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.”^[98]

130. Article 6*ter* was introduced into the Paris Convention by the Revision Conference of The Hague in 1925, with the purpose of protecting the armorial bearings, flags, official signs or emblems of the States party to the Convention, as well as other signs or hallmarks indicating control and warranty by them. This protection was extended in order to ensure that such designations are clearly attributed to the State concerned, and not misused by any third party. It was then recognized that the public interest in favor of such protection at the national level applied equally to the public sector at the international level, and protection was extended to IGOs by the Revision Conference of Lisbon in 1958. ^[99]

131. The Paris Convention, (Article 6*ter* (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.[\[100\]](#)

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.[\[101\]](#) The protection available to IGOs under the Paris Convention thus depends entirely upon their submission of a request for communication to WIPO.[\[102\]](#) WIPO maintains a notification list and performs the functions of determining the admissibility of such requests for communication under Article 6*ter* and of forwarding the admissible communications to the States party to the Paris Convention.

133. To date, a total of 91 IGOs have requested protection under Article 6*ter*. Each organization has not requested protection of all of the possible signs or emblems enumerated under Article 6*ter* (e.g., armorial bearings or flags). As a general rule, however, most IGOs that have requested protection have notified their name and abbreviation (in several languages), as well as their principal emblem.[\[103\]](#)

134. In 1992, the Paris Union Assembly (the competent treaty organ of the Paris Convention) adopted a set of "Guidelines for the Interpretation of Article 6*ter*(1)(b) and (3)(b) of the Paris Convention"[\[104\]](#) designed to clarify which IGOs may qualify for protection under the Paris Convention. This clarification was in response to the increasing number of 'programs' within international organizations that are autonomous and publicly recognized, such as UNAIDs. The Guidelines provide that, in addition to IGOs as such, any program or institution established by an IGO, or any convention constituting an international treaty between one or more States party to the Paris Convention, may seek protection under Article 6*ter*(3)(b), provided such program, institution or convention is "a permanent entity hav[ing] specified aims and its own rights and obligations."

135. The Guidelines define a "permanent entity" as one that has been established "for an indefinite period of time."[\[105\]](#) The "specified aims" and "rights and obligations" of such a permanent entity are defined by reference, respectively, to subject matters, rights and obligations "which are clearly defined in [the permanent entity's] enabling statutes or charter or in the resolutions or decisions by which it has been established."[\[106\]](#)

136. The Paris Convention foresees that the use of IGOs' insignia may be authorized,[\[107\]](#) 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."[\[108\]](#)

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.[\[109\]](#)

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 6*ter* of the Paris Convention and imposes these obligations on the (at present, 142) States party to the Agreement, specifically referring to the “notifications pursuant to the obligations under this Agreement stemming from the provisions of Article 6*ter* of the Paris Convention.”^[110] The Agreement Between the World Intellectual Property Organization and the World Trade Organization (WIPO-WTO Agreement) of 1995, clarified that:

“The procedures relating to communication of emblems and transmittal of objections under the TRIPS Agreement shall be administered by the International Bureau [of WIPO] in accordance with the procedures applicable under Article 6*ter* of the Paris Convention (1967).”^[111]

SCOPE OF EXISTING INTERNATIONAL PROTECTION

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.^[112] The clear purpose is to ensure that these names and abbreviations remain free of the private proprietary rights. 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.”^[113] 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 6*ter* (1)(c).^[114]

THE *.INT* TOP-LEVEL DOMAIN

139. The .int - for “international” - top-level domain was among the seven initial generic domains established by the Internet Assigned Numbers Authority (IANA), and its use remains restricted to “organizations established by international treaties, or international databases.”^[115] IANA states that .int is reserved for “organizations established by international treaties between or among national governments” and, in particular, that:

“We recognize as organizations qualified for domain names under the .int top-level domain the “specialized agencies” of the UN (currently there are 14 of these) and the organizations having “observer status” at the UN (currently 16).” ^[116]

Only one registration is allowed for each organization. IANA makes no reference to the Paris Convention procedures under Article 6*ter* which provide protection for IGOs.^[117]

140. It is notable that, from the beginning, special status was accorded within the DNS to international organizations. The restricted .int gTLD serves the dual purposes of (i) designating a space in the DNS for the registration of IGOs’ chosen identifiers, and (ii) providing a measure of protection through registration requirements which restrict that space only to those international organizations that qualify (i.e., those that are established by treaty).

141. The .int top-level domain provides some measure of assistance to IGOs within the DNS. Because of the restricted nature of this top-level domain, no individuals, companies or other entities can obtain a domain name registration in .int, let alone register the name or abbreviation of an IGO in that domain. As long as the registration procedures of .int are properly enforced, the .int top-level domain provides a space where Internet users can have confidence that registrations in the domain are genuinely connected with the corresponding organizations. This restricted domain for IGOs has the added advantage of having already been established, and the assistance it offers to IGOs in protecting the authenticity of their virtual identities cannot interfere with any existing rights or interests of domain name registrants in other TLDs. For these reasons, the question was raised in the Second WIPO Process whether adequate protection may already exist in the DNS for international organizations by virtue of the restricted .int gTLD.^[118]

142. Commentators throughout the Second WIPO Process revealed a lack of confidence that the existence of the .int domain, of itself, can provide sufficient protection to IGOs against the abuse of their names and acronyms in the DNS, and prevent any consequent deception of users of those sites.^[119] The .int domain has several shortcomings. The limitation to one registration for each organization is overly restrictive and does not meet these organizations’ needs. Consideration should be given to amending or eliminating this restriction – without altering the qualification procedures for registration – so that IGOs have the ability to register domain names corresponding both to their name and acronym and to their integral programs, activities or initiatives.

143. In addition, the .int domain is not universally adopted by all IGOs, and numerous organizations that qualify to register in .int have elected to register in other top-level domains, such as .org.^[120] The potential for abuse in these open gTLDs is illustrated by the fact that the United Nations Organization has registered ‘un.org’, whereas ‘unitednations.org’ has been registered by a private California-based company. As an alternative solution, the World Health Organization has its official site at ‘who.int’, and users visiting ‘who.org’ are automatically forwarded to the .int site. It is clear that many users are unaware of the existence or purpose of the .int domain, and considerable promotional work is needed to enhance its recognition. Nevertheless, most commentators strongly supported the enhancement of the visibility and profile of .int, and favored its use consistently and universally by all IGOs.^[121]

144. Critically, the protection provided to the names and acronyms of IGOs in the .int top-level domain has a serious deficiency. While restrictions apply to it, they do not apply to other gTLDs. The lack of restrictions in these other domains undermines the efficacy of .int.^[122] It is the risk of predatory and parasitical practices in these domains (as well as in the ccTLDs), which raises most concern for IGOs and Internet users in general.^[123] The .int domain space assists in determining when a domain name registration is legitimate, but it does not assist in determining when other registrations in the broader gTLD space are fraudulent. For this reason, at this stage, it is recommended that reliance alone upon the .int domain is insufficient. The question thus remains, in the context of the global DNS, how the names and abbreviations of IGOs can most effectively be protected.

ANALYSIS OF COMMENTS AND VIEWS EXPRESSED IN RESPONSE TO THE INTERIM REPORT

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.^[124] As discussed below, the comments were divided as to the scope and form of this protection.

146. Without exception, the international organizations that submitted comments to the Second WIPO Process took the strong position that their names and abbreviations should not be subject to abusive registrations in the DNS, and viewed such registrations as contravening the purpose of the protection granted under existing international law. These organizations, including the United Nations (UN), World Health Organization (WHO), World Trade Organization (WTO), Organization for the Prohibition of Chemical Weapons (OPCW) and International Labour Office (ILO), each voiced an unequivocal need for protection in the DNS, and gave evidence of having been “plagued by such infringing or abusive registrations.”^[125] The IGOs noted that such protection would benefit not just the organizations themselves, but advance the global public interest by protecting Internet users and consumers from deceptive conduct.^[126] Some IGOs stated that their names and abbreviations should not be available for registration as domain names by unauthorized third parties, even if the domain name registration is not in bad faith, as such registrations can nevertheless be confusing and misleading to the public, raising questions of authenticity and accuracy as to the source of information provided, and giving rise to the perception that an IGO endorses or approves of the information, service or product being offered through an unrelated web site.^[127]

147. The organizations which should qualify for protection was also the subject of comments. Many commentators suggested, in this regard, that at least the names or acronyms of those IGOs that have followed the treaty procedures under the Paris Convention and TRIPS Agreement - and notified accordingly - should be considered for protection in the DNS.^[128] These commentators expressed the view that the scope of legal protection which already exists in the physical world for the names and abbreviations of IGOs should be reflected in the DNS. The United Nations (UN) put forward the view that protection should also be extended to the names and acronyms of subsidiary bodies of the UN organizations, such as peacekeeping missions, that are an integral and significant part of the Organization, although they do not qualify as ‘permanent entities’ in accordance with the Guidelines adopted for the interpretation of Article 6*ter* of the Paris Convention.^[129] The World Trade Organization (WTO) also recommended that protection should extend to prominent units or parts within an IGO.^[130] The WTO described the problems experienced with the registration of ‘gatt.org’, corresponding to the acronym for the General Agreement on Tariffs and Trade, which is used to provide misleading information to the public via a site that is deceptively similar to the official WTO site.

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.^[131] 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.^[132] 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.^[133]

149. A small minority of commentators felt that the existing protection granted to IGOs through the UDRP procedures, insofar as their names and acronyms may function as trademarks, is adequate.^[134] It is notable, however, that no intergovernmental organization has yet filed a claim under the UDRP in respect of its name and acronym, nor can such a procedure accommodate the organizations' privileges and immunities.

150. With regard to the scope of protection to be granted to the names and acronyms of IGOs, most commentators favored protection in all gTLDs and, to the greatest extent possible, in the ccTLDs.^[135] One commentator also noted that protection should extend to all levels of the domain name (e.g., to protect equally 'oami.com' and 'oami.uk.com').^[136] A number of commentators noted that a directory or listing service of IGOs, especially of those which are protected under the Paris Convention and through the TRIPS Agreement, would be useful.^[137]

ANALYSIS OF VIEWS EXPRESSED ON MEANS OF IMPLEMENTING PROTECTION

151. Commentators were most concerned with discussion of the means of implementation of protection. The Interim Report put forward three options in this regard:

- (i) Maintenance of the status quo, and reliance on the existing top-level domain, .int, reserved for treaty organizations;
- (ii) Establishment of an exclusion mechanism in some or all of the gTLDs for the names only, or for the names and acronyms, of IGOs; and
- (iii) Modification of the UDRP to extend to the names and acronyms of IGOs.

In relation to the first option, as discussed above, commentators did not favor maintaining the status quo, as the .int domain, while useful, is not considered sufficient to provide the necessary protection for IGOs in the DNS, nor to reflect the existing protection accorded by international law. Comments were divided on the remaining two options.

Exclusion Mechanism

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.[\[138\]](#) 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.[\[139\]](#)

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.[\[140\]](#) 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'.[\[141\]](#) There exists a German medical company at 'ilo.com', as well as a Canadian Internet company at 'ilos.net'.[\[142\]](#) 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.

154. Despite the apparent shortcomings of an exclusion mechanism, many commentators, including IGOs, were in favor of this form of protection, as seemingly the most effective way to recognize the existing legal protection for IGOs in the DNS, without requiring these entities to submit to inappropriate dispute-resolution proceedings.[\[143\]](#) Some commented that such an exclusion should apply to all gTLDs, while others suggested it should be considered only in relation to each particular gTLD.[\[144\]](#) For the reasons mentioned above, numerous commentators favored an exclusion of only the exact names of IGOs,[\[145\]](#) or supported limiting the exclusions to exempt those acronyms that pose no risk of confusion or deception.[\[146\]](#)

Modification 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.[\[147\]](#) 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.[\[148\]](#) Even those commentators in favor of protection for IGOs' names and acronyms noted that, in considering any new measures of protection, adequate consideration needed to be given to the rights of existing, legitimate domain name registrants.[\[149\]](#) A minority of comments were in favor of broader protection for IGOs, such that any unauthorized registration and use of the name or acronym of an IGO should be presumed to be misleading and in bad faith.[\[150\]](#) One commentator proposed a

detailed definition of 'bad faith', specifying that the registration of the name or acronym, in whole or in part, must have been unauthorized and intentional, and must be (i) likely to create an impression that the domain name is that of the IGO concerned, or (ii) in relation to a site that contains material or information prejudicial to the interests of the IGO.[\[151\]](#)

156. In opposition to any modification of the UDRP in this context, some commentators stated that the UDRP should apply only to the extent that such names or acronyms of IGOs function as trademarks or service marks.[\[152\]](#) Others opposed any broadening in the scope of disputes that could be decided under the UDRP, arguing that the UDRP is a relatively new process that should be allowed to develop and stabilize before addressing new categories of disputes. [\[153\]](#) Still other commentators raised free speech concerns and contended that the names or acronyms of IGOs should be allowed to be registered as domain names if there is no confusing similarity or misleading content on the site.[\[154\]](#) Finally, there was expressed a general concern with a perceived over-regulation of the DNS and insufficient regard for existing domain name holders' rights, that led some commentators to oppose any new form of protection in the DNS for IGOs' names or acronyms.[\[155\]](#)

157. Any proposal to implement an administrative dispute resolution system for the protection of the names and abbreviations of IGOs would need to take account of the privileges and immunities of the United Nations and Specialized Agencies under international law, as discussed above. For this reason, any direct modification of the UDRP would be untenable. 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. [\[156\]](#) 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.[\[157\]](#) 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.[\[158\]](#) Any administrative process to which the IGOs could agree would need to omit such a reference.

RECOMMENDATION

158. The clear majority of commentators favors some form of protection of the names and acronyms of IGOs within the DNS.

159. There is also abundant evidence that abuses of the names and acronyms of IGOs through domain name registrations exist that constitute harmful practices.

160. The protection of the *names* of IGOs raises less complicated and more straightforward questions than the protection of the *acronyms* of IGOs, where necessarily there is far greater scope for the concurrent, good faith use of the same letters as the acronyms of some IGOs in various different contexts and in various different naming systems.

161. There is clearly *an* existing basis in international law for the protection of the names and the acronyms of IGOs, but this basis is not adequate to deal with the whole problem of the bad faith registration and use of the names and acronyms of IGOs as domain names. Commercial malpractice is an important part, but only a part, of the harmful practices associated with the bad faith registration and use of the names and acronyms of IGOs. The registration and use of domain names to create misleading associations with the duly constituted international authorities for public health, labor practices, peace-keeping operations, nuclear test bans, the containment of the proliferation of chemical weapons, trade disciplines, children's rights, refugees, AIDS and so forth is unacceptable, offensive to numerous public policies established by the international community and conducive to undermining the credibility and reliability of the DNS.

162. The existing situation with respect to the names and acronyms of IGOs in the DNS is unbalanced. Any person, without any qualification whatsoever, may register the name or acronym of an IGO in an unrestricted gTLD. Furthermore, they can do so immediately and at an insignificant cost. In contrast, the potential damage that can be inflicted with the use of such a registration is of a different order. The pursuit of protection against such harm not only is distractful to the central missions of IGOs and wasteful of their limited resources, but also may involve questionably unnecessary deviation from the standard principle of immunity of IGOs from jurisdiction.

163. We recommend that the current unsatisfactory situation be redressed through balanced action on the part of the international community. The choices of instruments for implementing such action are limited and consist principally of the following:

- (i) A system of notification by any interested party of the registration as a domain name of the name or acronym of an IGO benefiting from protection under Article 6^{ter} of the Paris Convention, the verification of the exact similarity between the name or acronym of the IGO and the domain name by WIPO (as custodian of the authorized list of notifications under Article 6^{ter} of the Paris Convention), notification to ICANN or, directly, to the registrar concerned, and the cancellation of the domain name registration. Such a procedure would, however, appear to be unsatisfactory because (a) its automacity may result in the cancellation of good faith domain name registrations, particularly of the acronyms of IGOs which are not misleading; and (b) it is insufficient to deal with misleading, but not exactly similar, domain name registrations.
- (ii) An exclusion or blocking mechanism for the names and acronyms of IGOs, which suffers from the same limitations as the notification procedure mentioned in (i), in that it would be apt to prevent a certain class of good faith registrations and insufficient to deal with misleadingly similar registrations.
- (iii) A modification of the existing UDRP, specifically designed for the bad faith misuse of the names or acronyms of IGOs through domain name registrations. This option, however, is unacceptable because (a) insofar as ICANN, acting on the basis of recommendations from the Domain Name Supporting Organization (DNSO) or the DNSO Names Council, might be considered to be responsible for the introduction of modifications to the UDRP, it and its subsidiary bodies do not have any constituency pertinent to international intergovernmental organizations; and (b) the UDRP contains within its design an unacceptable deviation from the established principle of immunity of IGOs from the jurisdiction of national courts.
- (iv) An administrative procedure, similar to the UDRP, but independently developed and managed within the framework of international administrative tribunals. Such an administrative procedure could be available to any IGO to file a complaint that a domain name registration is the same as or misleadingly similar to the name or acronym of the IGO concerned, has been registered in bad faith without legal justification, and is likely to mislead users into believing that there is an association between the holder of the domain name registration and the IGO in question. Like the UDRP, the remedies that might be awarded by a panel under the special administrative procedure should be limited to cancellation or transfer of the domain name registration and should be implemented through the ICANN system (or ccTLD administrators) within the DNS.

164. It is recommended that the names and acronyms of IGOs benefiting from protection under Article 6^{ter} of the Paris

Convention be protected from abusive registrations of domain names within the DNS.

165. It is recommended that this protection be implemented through a special administrative procedure developed and supervised by the constituent members of IGOs, namely, States. The procedure should be available to qualifying IGOs to file a complaint that a domain name registration is the same as, or misleadingly similar to, the name or acronym of the IGO, that the registration has been made without legal justification, and that the registration is likely to mislead users into believing that there is an association between the holder of the domain name registration and the IGO in question.

166. It is recommended that remedies under the special administrative procedure be limited to the cancellation or transfer of the domain name

registration and that the results of the procedure be enforced within the DNS through the ICANN system.

167. It is recommended that the special administrative procedure should apply to domain name registrations in all gTLDs and in all ccTLDs. It is recognized that the enforcement of the results of such a procedure within the ccTLDs would require the cooperation of the corresponding national authorities.

168. 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 6^{ter} of the Paris Convention, the Trademark Law Treaty and the TRIPS Agreement. While it is believed that such an extension is desirable, it would require a legitimate source in international law. It would be for States to determine the appropriate basis for such an extension of law, either in the form of a resolution of a competent treaty organ, a memorandum of understanding duly accepted by national authorities or a treaty.

5. PERSONAL NAMES

169. Identity is a fundamental attribute of “the inherent dignity of the human person.”^[159] Many things are important in constituting a person’s identity. The personal name is foremost amongst them and assists in creating distinctiveness or individuality, as well as serves as a succinct symbol pregnant with the associations that others have with that person. The importance of personal names to dignity is evident from the dark days of totalitarianism and nazism, when names were only numbers.

170. It has been often pointed out that the power and ubiquity of the technologies of

communication and telecommunication have created greater opportunity for invasion of personal space and the use of attributes of personal identity in ways which are not approved by the person concerned. At the same time, these technologies have, in enhancing the visibility of public figures and leading business, sports and entertainment personalities, established the celebrity as a mundane feature of society.

171. The personal name is a difficult subject to treat. There is considerable diversity around the world in the way in which it is formulated and presented. These formulations and presentations (for example, which name, family or given, comes first, or whether the name consists of these two elements at all) are usually the result of the historical and cultural traditions of particular societies. Many sensitivities, including religious, political, historical, cultural and psychological, are touched by the subject of personal names.

THE LEGAL PROTECTION ACCORDED TO PERSONAL NAMES

172. Personal names are rarely protected *as such* by the law. Their protection is usually a part of a broader legal principle or policy of which the misuse of personal names constitutes only one means of violation. Other means of violation include misuse of a person's likeness, image or voice.

173. Because of the diversity of interests affected by the treatment of personal names, the legal principles and policies that can be deployed to protect personal names are similarly diverse and vary, as might be expected, from country to country. These legal principles and policies include the right to publicity or the right to control the commercial use of one's identity, recognized in many States of the United States of America; the tort of unfair competition; the tort of passing-off (conceptually treated, in many cases, as part of the law of unfair competition), recognized generally in common-law countries; and the right to privacy.

174. It has not been possible to review in detail all the legal principles and policies that can be used for the protection of personal names in all of the countries of the world. Nevertheless, it is possible to identify two main interests that underlie particular approaches adopted in a number of countries to the protection of personal names against misuse:

(i) A commonly expressed public policy for the protection of personal names against misuse is economic. This economic policy, in turn, has two bases. The first of those bases is the prevention of unjust enrichment through the unauthorized commercial use of another's identity. As stated by Kalven and quoted by the Supreme Court of the United States of America, "The rationale for [protecting the right of publicity] is the straight-forward one of preventing unjust enrichment by the theft of good will. No social purpose is served by having the defendant get free some aspect of the plaintiff that would have market value and for which he would normally pay."^[160] The second basis of the economic interest underlying the protection of personal names against misuse is the prevention of deception and confusion on the part of consumers.

(ii) A social interest is also expressed as underlying legal principles protecting personal names against misuse. This interest is apparent in the right to privacy, or the qualified right to control exposure of oneself, where personal distress and anxiety are recognized as valid reasons to accord protection.

In a number of cases, both the economic and the social interests are recognized in the protection that law accords. Thus, in Switzerland, Article 29.2 of the Civil Code states that "Where a person assumes the name of another to the latter's prejudice, the latter can apply for an injunction to restrain the continuation of this assumption, and can in addition claim damages if the act is proved to be wrongful, and moral compensation if this is justified by the nature of the wrong suffered." And in Spain, Section 7.6 of the Law of May 5, 1982,^[161]

provides that the unpermitted use of one's name, voice or likeness for *advertising or trade* purposes is an invasion of one's *personal* life.

175. The notoriety that attaches to certain persons can, in some countries, establish a basis for protection which is not available to ordinary persons.^[162] In other instances, notoriety can be a factor which can influence the extent of damages granted as a result of the wrongful use of the person's name, rather than a ground for establishing a separate form of protection from that available to non-famous persons.

176. In commerce, the protection that is recognized for personal names and other attributes of the personality is usually exploited through the vehicle of contract. Thus, by permitting, under contract (or license), another to use a person's name in association with products or services, the personal name becomes an asset.

177. The status of the personal name as a potential asset may be secured through the registration of a trademark (or service mark). Most national laws, and the Agreement on Trade-Related Aspects of Intellectual Property Rights (the TRIPS Agreement),^[163] explicitly recognize that personal names are eligible for registration as trademarks. While personal names are eligible for registration as trademarks, however, like any sign for which trademark registration is sought, they must be distinctive in order to be valid trademarks. Distinctiveness can be inherent, or can be acquired through use which causes consumers to identify the name with a particular source of goods or services.

178. While there are, as indicated in the preceding paragraphs, several different legal doctrines that apply on a widespread basis at the national level to protect personal names against misuse, there is no specific norm established at the international level for the protection of personal names. The absence of any such norm reflects the fact that there is a diversity of legal approaches to the protection of personal names at the national level.

PROTECTION OF PERSONAL NAMES UNDER THE UDRP

179. As mentioned above, personal names may, in appropriate circumstances, be registered as trademarks and, in practice, many are. The protection of personal names as trademarks has provided a basis for the application of the Uniform Domain Name Dispute Resolution Policy (UDRP) to the protection of personal names against deliberate, bad faith registration as domain names in the gTLDs. While a few oppose this application of the UDRP,^[164] the clear weight of authority of many decisions is in favor of the application of the UDRP to the protection of personal names when they constitute trademarks. The present section of this Chapter outlines the main trends in this authority. Annex VI to this Report contains an indicative list of UDRP cases involving personal names that have been filed with the WIPO Arbitration and Mediation Center.

180. It is recalled that the UDRP provides that three conditions must be satisfied in order to establish that a domain name registration is abusive and that the complainant is entitled to relief:

- (i) the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights;
- (ii) the registrant of the domain name has no rights or legitimate interests in respect of the domain name; and
- (iii) the domain name has been registered and is being used in bad faith.^[165]

The application of each of these conditions in the context of the protection of personal names is described in the ensuing paragraphs.

Trademark or Service Mark Rights

181. The first condition requires that in each case the complainant must demonstrate that the personal name in question is protected as a trademark or service mark, in which that complainant has rights.

182. There have been a number of cases in which a complainant has demonstrated that it meets this requirement by submitting evidence that the personal name in question is registered as a trademark.^[166] The UDRP, however, does not require that a complainant must hold rights specifically in a *registered* trademark or service mark. Instead, it provides only that there must be “a trademark or service mark in which the complainant has *rights*,” without specifying how these rights are acquired.^[167] With this distinction in mind, many decisions under the UDRP have therefore determined that common law or unregistered trademark rights may be asserted by a complainant and will satisfy the first condition of the UDRP.^[168] In relation to personal names, in particular, numerous UDRP decisions have relied upon a complainant’s demonstration that it holds such common law rights in the disputed name.^[169] In making these decisions, panels have given attention to a number of factors, including: (i) the distinctive character or notoriety of the name and the requirement that the domain name must be “identical or confusingly similar” to it, (ii) the relationship between this distinctive character and use of the name in connection with goods or services in commerce, and (iii) the location of the parties and the bearing that this may have on the acquisition of unregistered trademark rights.

183. Regarding the distinctiveness of the name, panels have emphasized in many cases that the particular complainant’s personal name, in the relevant field of commerce, enjoys widespread notoriety and fame.^[170] “A claim based on an unregistered mark, including a personal name, requires that the claimant establish the distinctive character of the mark or name on which the claim is based.”^[171] Panels have also focused this analysis of distinctive character in relation to the second element mentioned above, “whether or not the person in question is sufficiently famous in connection with the services offered by that complainant” in commerce.^[172] Using a personal name in association with certain goods or services can create distinctiveness and a secondary meaning in the name. With respect to similarity between the personal name in which trademark rights are held and the domain name registration, panels have found that small variations between the two (e.g., such as removing the space between the first and last names), just as in cases involving words or terms other than personal names, are legally insignificant, so long as the registered domain name is “confusingly similar” to the personal name.^[173]

184. The location of the parties can be significant for determining whether the complainant has trademark rights.^[174] Rule 15(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules of Procedure”) provides that the panel shall decide a complaint on the basis, *inter alia*, of “...any rules and principles of law that it deems applicable.” The applicable law will depend on the facts of the case, including the location of the parties. This Rule has allowed panels the flexibility to deal with disputes between parties with different national affiliations and concerning activity on a global medium. It is also a feature that has enabled complainants to seek protection for their names under trademark law, although they have not registered their names as a trademark or service mark in every country of the world.

The Registrant Has No Rights or Legitimate Interests in the Domain Name

185. The second condition of the UDRP requires that there be no evidence that the domain name registrant has any rights or legitimate interests in the domain name that it has registered. Panels normally review the full record in a case to assess whether a respondent has any rights or interests in the domain name. Based on the distinctiveness of the personal name in question and certain facts indicating that (i) the domain name does not correspond to the respondent's own name, and (ii) the respondent has registered the names of many other celebrities, this determination in a number of cases has been almost self-evident^[175]. In other cases, however, a more probing analysis has been called for. For example, the panel in one case found that, while the respondent's use of the name in question, "sting," as a nickname on the Internet was *not* substantial enough to show any rights or legitimate interests in the domain name *sting.com*, the respondent's proven use was in fact relevant to the separate issue of bad faith. In another case, the panel disagreed with the respondent's argument that the domain name in question, *sade.com*, was being offered merely as a legitimate email service. Instead, the panel found that, by placing the domain name in the music section of its web site and having registered it under the contact, "The Sade Internet Fan Club," the respondent "has set out to deliberately associate this service with the Complainant."^[176] In a further case, the panel acknowledged that the respondent's contention was a serious one and that use of the domain name in question, *montyroberts.net*, was for legitimate non-commercial or fair use purposes.^[177] In balancing the rights of the complainant in its mark and the rights of the respondent to freely express its views about the complainant, however, the panel determined that:

"the rights to express one's views is not the same as the right to use another's name to identify one's self as the source of those views. One may be perfectly free to express his or her views about the quality or characteristics of the reporting of the New York Times or Time Magazine. That does not, however, translate into a right to identify one's self as the New York Times or Time Magazine."^[178]

186. The panel found that, while the respondent's primary motive for establishing the web site might have been to criticize the complainant, this did "not insulate Respondent from the fact that it is directly and indirectly offering products for sale on its website, or at websites hyperlinked to its site."^[179]

The Domain Name Has Been Registered and Is Being Used in Bad Faith

187. The third condition that must be satisfied is evidence of bad faith. The UDRP sets forth four non-exhaustive examples of what may be considered "evidence of the registration and use of a domain name in bad faith."^[180] A review of the decisions concerning personal names indicates that each of these circumstances has been relied upon in one or more cases to support a determination that the registration and use of the domain name in dispute was in bad faith. Given the distinctive character of a number of the names in question and a consideration of other relevant facts, an underlying and consistent perception has been that the respondent, through the domain name registration, has clearly targeted the complainant's unique personal or professional name.^[181] Panels, however, have exercised caution in confirming that such parasitic practices relate to one of the illustrative bad faith factors listed in the UDRP or to a similar bad faith *commercial* exploitation of the complainant's name. Thus, in one case the panel ruled that, where the domain name was identical to the complainant's professional name but was connected to a *non-commercial* web site expressing criticism of the complainant (operated by a brother-in-law), the case involved alleged defamation and not infringement of a trademark right.^[182] Defamation, which goes to the reputation of an individual, does not have any necessary relationship to the commercial and infringing exploitation of a personal name used as a mark.

188. The UDRP has proven to be a useful tool for giving expression to the protection of personal names where trademark rights exist in those personal names, where the domain

name holder has no right or legitimate interest and where there is evidence of bad faith in the registration and use of the domain name. However, it by no means affords comprehensive protection to personal names. For a start, the names of many persons, particularly ordinary persons, may have no distinctiveness attached to them, either inherently or as a result of use. Secondly, the names of political figures, religious leaders, scientists and historical persons may never have been used in commerce and, thus, are unlikely to have trademarks associated with them. Nevertheless, many sensitivities may attach to their use.

ANALYSIS OF COMMENTS AND VIEWS EXPRESSED IN RESPONSE TO THE INTERIM REPORT

189. The Interim Report formulated three options with respect to the protection of personal names in the DNS and sought further comment on them. These options were:

- (i) The scope of the UDRP should not be broadened to cover personal names beyond those which are already protected under the current UDRP as trade or service marks.
- (ii) The scope of the UDRP should be amended to encompass a new and narrow category of claims brought on the basis of a personality right in order to offer additional protection for personal names which do not qualify as trade or service marks under the current UDRP.
- (iii) The amended UDRP, as proposed in (ii) above, should be introduced only in the forthcoming new gTLD .name, which is intended to serve individuals and allow them to create their own global digital identity.[\[183\]](#)

190. Since the publication of the Interim Report, the registry of .name has developed an extensive rights protection scheme, including dispute resolution, the essential characteristics of which are reflected in the Appendices to the Registry Agreement which it has entered into with ICANN.[\[184\]](#) Although the procedural and operational details of this scheme remain to be clarified at the time of the publication of this Report, it would appear from those Appendices that the .name protection mechanisms at least are intended to achieve the principal policy objectives underlying the third option proposed in the Interim Report. While only practical experience will demonstrate the effectiveness of those mechanisms, their application in .name will practically implement the third option mentioned above. The comments received on it in response to the Interim Report will not therefore be considered below.

191. The comments received were divided on whether the scope of the UDRP should be broadened to cover personal names that do not qualify as trade or service marks. While a significant number of commentators favored broadening the scope of the UDRP for purposes of protecting personal names,[\[185\]](#) the majority believed that the protection offered by the UDRP in its present form is sufficient and that it should not be expanded to cover personality rights at this time. [\[186\]](#)

192. Those who favor the inclusion of a form of personality right as a basis for formulating a complaint under the UDRP advance essentially two arguments in support of their position. First, they argue that, while the victims of abusive domain name registrations of personal names generally are famous persons, their celebrity status does not necessarily derive from any commercial activity.[\[187\]](#) According to these commentators, there is no valid reason why famous persons whose reputation results from non-commercial activities, and who therefore would not normally qualify for protection under the current UDRP as holders of trade or service marks, should remain unprotected. They conclude that the UDRP should be amended in order to close what they perceive to be an unwarranted gap in the scope of protection that it offers to well-known individuals.

193. A second argument advanced in support of broadening the scope of the UDRP finds its origin in the discrepancies that exist between national laws of countries relating to unregistered trade or service marks. As is apparent from a review of the case law under the UDRP, many celebrities have not registered their personal names as marks, but have been found by panelists to be owners of unregistered marks, which equally qualify for protection under the UDRP. However, not all countries in the world offer protection to unregistered marks. Persons whose activities, even though clearly commercial in nature, are restricted to countries which protect only registered marks (e.g., China, France or Switzerland, amongst others), and who have not obtained any mark registrations corresponding to their personal names in those countries, would normally not benefit from the UDRP's protection. According to certain commentators, this reveals a bias, built into the UDRP, favoring parties from countries with legal systems protecting unregistered marks, typically (but not exclusively) countries with a common-law tradition. They argue that introducing the personality right as an additional basis for formulating a complaint under the UDRP would be an appropriate and reasonable means of rectifying what they perceive to be a form of discrimination between legal systems which has crept into the current procedure.[\[188\]](#)

194. Those who favor broadening the scope of the UDRP to some form of personality right generally agree that protection should nonetheless be limited to abusive behavior on the part of registrants.[\[189\]](#) Certain of these commentators believe that protection should be offered not only in relation to official personal names, but also to pseudonyms of famous persons (for instance, Kirk Douglas being the pseudonym of Issur Danielovitch Demsky).[\[190\]](#)

195. Commentators who are opposed to broadening the scope of the UDRP to cover personality rights set out various reasons for their reluctance in this regard. Most importantly, they point out that there currently exist no internationally harmonized norms covering personality rights as such. While various forms of personality rights are recognized and protected in many jurisdictions throughout the world, this is achieved by relying on differing legal foundations, including common law principles, civil law provisions, statutory rights of publicity, privacy law and criminal law. In light of these various approaches to the problem, the nature and scope of protection granted to what is conveniently referred to as "the personality right" varies from one jurisdiction to another. Commentators who resist expanding the scope of the UDRP to personality rights believe that any attempts to create additional protection under these circumstances will have substantial negative effects. They claim that panelists, faced with a void of harmonized international rules, will be tempted to create new law offering greater protection to personality rights through the UDRP than that which is currently available under national laws. They warn that the UDRP thus would run the risk of developing into an illegitimate source of new and undesired regulation in the personality right arena. Furthermore, they believe that, in light of discrepancies between national laws, decisions granted under the UDRP would often be perceived as unfair, contested and ultimately invalidated at the national level. According to these commentators, this would be detrimental to the long-term credibility and viability of the UDRP as a consensus-based dispute resolution mechanism.[\[191\]](#)

196. Most other arguments advanced against including some form of personality right as a basis for a complaint under the UDRP directly or indirectly flow from the fundamental difficulty set out in the previous paragraph. These arguments often are based on concerns that protecting personality rights under the UDRP would have a chilling effect on free speech and would unlawfully restrict the availability of names in the DNS.[\[192\]](#) Furthermore, several commentators state that it would be exceedingly difficult to devise a uniform standard for determining who is sufficiently famous to benefit from protection and who is not,[\[193\]](#) although other commentators argue that, to the extent the system would focus on abusive behavior, there would not be a need to limit the protection it offers to famous persons.[\[194\]](#) Still others argue that it would be wholly inappropriate to expand the scope of the UDRP, be it the area of personality rights or in any other area, precisely at the time when preparations are being made to evaluate its operation.[\[195\]](#)

197. Finally, those opposed to the expansion of the UDRP also argue that, as a practical

matter, most persons whose personal names run the risk of being cybersquatted derive their celebrity status from commercial activities and therefore can claim the existence of at least an unregistered mark to benefit from the UDRP's protection. In other words, incorporating a personality right into the UDRP, according to this view, would introduce a host of complications for parties, ICANN, dispute resolution providers, and all others involved in the procedure which are unlikely to be in proportion to the magnitude of the problem that is to be addressed.

198. A few commentators have suggested that, if additional protection for personal names is to be incorporated into the UDRP, it should in any event be more narrowly drafted than the proposal reflected in the second option of the Interim Report. These commentators refer to a provision of the United States Anticybersquatting Consumer Protection Act, passed into law in November 1999, as a possible model in this connection.^[196] The provision in question provides for a cause of action against "[a]ny person who registers a domain name that consists of the name of another living person, or a name substantially and confusingly similar thereto, without that person's consent, with the specific intent to profit from such name by selling the domain name for financial gain to that person or any third party...".^[197]

RECOMMENDATION

199. It is clear that many sensitivities are offended by the unauthorized registration of personal names as domain names. It is clear also that UDRP does not provide solace for all those offended sensitivities, nor was it intended to do so, as originally designed. The result is that there are some perceived injustices. Persons who have gained eminence and respect, but who have not profited from their reputation in commerce, may not avail themselves of the UDRP to protect their personal names against parasitic registrations. The UDRP is thus perceived by some as implementing an excessively materialistic conception of contribution to society. Furthermore, persons whose names have become distinctive in countries that do not recognize unregistered trademark rights are unlikely to find consolation in the UDRP in respect of bad faith registration and use of their personal names as domain names in those countries.

200. Nevertheless, we believe that the views expressed by the majority of commentators against the modification of the UDRP to meet these perceived injustices are convincing at this stage of the evolution of the DNS and the UDRP.

201. The most cogent of the arguments against modification of the UDRP is, we believe, the lack of an international norm protecting personal names and the consequent diversity of legal approaches deployed to protect personal names at the national level. We consider that this diversity would place parties and panelists in an international procedure in an untenable position and would jeopardize the credibility and efficiency of the UDRP.

202. It is recommended that no modification be made to the UDRP to accommodate broader protection for personal names than that which currently exists in the UDRP.

203. In making this recommendation, we are conscious of the strength of feeling that the unauthorized, bad faith registration and use of personal names as domain names engenders. We believe, however, that the most appropriate way in which the strength of this feeling should be expressed is through the development of international norms that can provide clear guidance on the intentions and will of the international community.

204. Insofar as ccTLDs are concerned, the lack of international norms is less significant. Clear law at the national level for the protection of personal names against abusive domain name registrations, if it exists, can be applied to registrations in the corresponding ccTLD.

6. GEOGRAPHICAL IDENTIFIERS

205. Geographical designations, like many other forms of identifier, also touch a wide variety of interests and sensitivities that range from our most basic territorial instincts to more sophisticated conceptions of market and cultural justice. While the misuse of geographical attributions may offend many feelings, only certain types of such misuse are sanctioned by the law. The present Chapter examines the legal framework that has been developed internationally to regulate the misuse of geographical identifiers; describes the evidence produced in the course of the Second WIPO Internet Domain Name Process on the misuse of geographical identifiers in the domain name system (DNS); analyses the comments submitted in response to the Interim Report; and formulates recommendations on the question which, in the Request initiating the Second WIPO Process, WIPO was asked to address, namely, the “bad faith, abusive, misleading or unfair use” of “geographical indications, geographical terms, or indications of sources.”

THE LEGAL PROTECTION OF GEOGRAPHICAL IDENTIFIERS

206. A well-established framework for the prohibition of the misuse of geographical identifiers exists at the international, regional and national levels.

207. The international framework is established in four multilateral treaties: the Paris Convention for the Protection of Industrial Property (the Paris Convention), to which 162 States are party;[\[198\]](#) the Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods (the Madrid (Indications of Source) Agreement), to which 33 States are party;[\[199\]](#) the Lisbon Agreement for the Protection of Appellations of Origin (the Lisbon Agreement), to which 20 States are party;[\[200\]](#) and the Agreement on Trade-Related Aspects of Intellectual Property Rights (the TRIPS Agreement), which has 142 Contracting Parties.[\[201\]](#)

208. At the regional level, examples of legal instruments that include treatment of the misuse of geographical identifiers include, in Africa, the Bangui Agreement;[\[202\]](#) in the Americas, the North American Free Trade Agreement, between Canada, Mexico and the United States of America, Decision 486 of the Cartagena Agreement between Bolivia, Columbia, Ecuador, Peru and Venezuela, and the Protocol for the Harmonization of Intellectual Property Provisions in Mercosur, between Argentina, Brazil, Paraguay and

Uruguay;^[203] and in the European Union, the Council Regulation on the Protection of Geographical Indications and Designations of Origin for Agricultural Products and Foodstuffs and the Council Regulation on the Common Organization of the Market in Wine.

209. At the national level, the foregoing international and regional norms are implemented through a variety of legal approaches, which include *sui generis* or specific legislation, sometimes establishing registration systems, for certain classes of geographical identifiers; protection through collective or certification marks; laws against unfair competition; passing-off; and laws on consumer protection. In many cases, these different legal approaches can be applied cumulatively.

THE MAIN ELEMENTS OF THE INTERNATIONAL FRAMEWORK OF PROTECTION

210. The international framework for the protection of geographical identifiers consists of two elements: (i) a prohibition of false descriptions of the geographical source of goods; and (ii) a more extensive set of rules prohibiting the misuse of one class of geographical source indicators, known as geographical indications.

The Prohibition of False Indications of Source

211. The international law on the prohibition of the use of false indications of geographical source on goods is established in three treaties: the Paris Convention, the Madrid (Indications of Source) Agreement, and the TRIPS Agreement.

212. The basic rule is contained in Article 10 of the Paris Convention. Article 10 subjects to seizure, or prohibition of importation, goods “in cases of direct or indirect use of a false indication of the source of a good or the identity of the producer, manufacturer or merchant.”^[204] The seizure should take place at the request of any competent authority or any interested party.^[205] Since the name of a geographical place or region is not usually the subject of private rights controlled by a particular party, any “producer, manufacturer, or merchant, whether a natural person or a legal entity, engaged in the production or manufacture of or trade in ... goods and established either in the locality falsely indicated as the source, or in the region where such locality is situated, or in the country falsely indicated, or in the country where the false indication of source is used,”^[206] is deemed to be an “interested party” given standing to request seizure of the goods in respect of which a false indication of source is directly or indirectly used.

213. Three features of the rule prohibiting the use of false indications of source in Article 10 of the Paris Convention may be noted. First, the rule applies to goods and does not extend to services. Secondly, any *direct* or *indirect* use of the false indication of the source is proscribed. An indirect use could be, for example, the use of an image uniquely associated with one country (such as a picture of the Matterhorn, a well-known Swiss mountain with a particular and easily recognized shape), as opposed to the use of the name for the country. Thirdly, any geographical identifier may form the basis of the use which creates the false indication of source. Article 10(2), in creating standing to request seizure, mentions “locality,” “region” and “country.” Thus, for example, the indication “made in [locality],” “made in [region]” or “made in [country]” would engage the operation of Article 10, if false.

214. The provisions in the Paris Convention prohibiting false indications of source are incorporated into the TRIPS Agreement.^[207]

215. The provisions in the Paris Convention are extended by the Madrid (Indications of

Source) Agreement in two ways. First, under the Madrid (Indications of Source) Agreement, the prohibition applies not only to *false* (that is, factually wrong) indications of source, but also to *deceptive* (that is, misleading) indications.^[208] Secondly, the Madrid (Indications of Source) Agreement extends the proscribed range of conduct from goods bearing false or deceptive indications to the publicity and commercial communications used in connection with the sale, display or offering for sale of goods. Article 3*bis* of the Madrid (Indications of Source) Agreement provides as follows:

“the countries to which this Agreement applies also undertake to prohibit the use, in connection with the sale or display or offering for sale of any goods, of all indications in the nature of publicity capable of deceiving the public as to the source of the goods and appearing on signs, advertisements, invoices, wine lists, business letters or papers, or any other commercial communications.”

Geographical Indications

216. The foregoing provisions governing the misuse of false (and deceptive) indications of the geographical source of goods constitute rules of conduct in the trade of goods. They focus on falseness of indication, rather than on the geographical term itself, which is the means by which falseness is indicated.

217. A separate element in the international system governs a particular class of geographical terms, known as geographical indications, which are defined in Article 22.1 of the TRIPS Agreement as:

“... indications which identify a good as originating in the territory of a Member, or a region or locality in that territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin.”

In respect of this class of geographical terms, particular rules apply to govern their use. The main such rule requires Members of the World Trade Organization (WTO) to provide the legal means for interested parties to prevent:

“the use of any means in the designation or presentation of a good that indicates or suggests that the good in question originates in a geographical area other than the true place of origin in a manner which mislead the public as to the geographical origin of the good.”^[209]

218. Further rules prevent unfair competition in respect of geographical indications^[210] and provide enhanced protection for geographical indications identifying wines and spirits.^[211]

219. The essential difference between the rules relating to geographical indications and those relating to false indications of geographical source is that the former place emphasis on a certain quality attached to a limited class of geographical terms, rather than establishing a rule of market behaviors which may be violated through the false use of any geographical term.

220. It follows that the first question for the application of the framework of rules that apply to geographical indications is the identification of whether a term constitutes a geographical indication. At the national level, this is solved, as mentioned above, in a variety of ways. In some cases, identification is achieved through a registration system, in others preference is given to the registration of the trademark (collective or certification), and in others identification is achieved through recognition in the market or custom sanctioned by legislation or court decisions. At the international level, the question is how these various

systems interact. When will one system recognize the geographical indications protected in another? The question is complicated because of custom and use and the foundation of systems of protection for geographical indications in times when international trade, telecommunications and personal mobility were less prevalent. What one system traditionally considers to be specific and distinctive, another system may claim to be generic or descriptive.

221. Various methods are at the disposal of the international community to resolve the interaction of national systems and for the mutual recognition of geographical indications recognized within national systems. One method is the establishment of a multilateral register of geographical indications. Such a multilateral register is established and maintained under the Lisbon Agreement. An appellation of origin under the Lisbon Agreement is closely similar, but not identical, to a geographical indication under the TRIPS Agreement.^[212] For historical reasons, however, the Lisbon Agreement enjoys a limited participation of only 20 States, so that the multinational register established under it cannot claim to be truly international in effect.

222. The TRIPS Agreement provides for negotiations to be undertaken in the TRIPS Council concerning the establishment of a multilateral system of notification and registration of geographical indications *for wines* eligible for protection in those Members participating in the system.^[213] These negotiations have not yet, however, resulted in the establishment of such a system.

EVIDENCE OF THE MISUSE OF GEOGRAPHICAL INDICATIONS IN THE DNS

223. Illustrations of problems experienced in the DNS concerning geographical indications were submitted in response to WIPO2 RFC-2 by entities whose interests, or whose interests they represent, are most affected by the subject matter. These entities include the *Office internationale de la vigne et du vin* (OIV), an international intergovernmental organization, and the *Institut national des appellations d'origine* (INAO), a French governmental organization charged with the protection of appellations of origin and geographical indications for food and agricultural products.

224. The OIV is an intergovernmental organization with a scientific and technical character, competent in the field of the vine and its derived products. It was created by the International Agreement for the Creation of the *Office internationale du vin* of November 29, 1924. The Organization has 45 Member States which, together, represent the vast majority of the world's vine planting areas and of the world's wine production and consumption.^[214] Already within the framework of the first WIPO Process, the OIV had protested against the "appropriation and the reservation for private purposes of names that benefit from intellectual property protection" and sought "a level of protection for geographical indications that is equal to that available for trademarks."^[215] The OIV has reiterated its position in the Second WIPO Process and draws attention to a Resolution adopted by its Member States concerning the use of geographical indications on the Internet. This resolution, in its pertinent part, reads as follows:

"... a very large number of Internet domain names consist of geographical indications of recognized traditional denominations that are regulated by the Member States of the OIV and have been communicated to the OIV by them..."

... among these domain names, there are a number which are particularly confusing for Internet users and constitute commercial piracy or a misappropriation of notoriety... certain registrations are offered for sale to the highest bidder or are linked to inactive sites, evidencing bad faith..."

225. In addition to this Resolution, the OIV has submitted a study conducted by the *Fédération des syndicats de producteurs de Châteauneuf du Pape* (the Federation of Producers' Associations of Châteauneuf du Pape) covering numerous domain names corresponding to claimed geographical indications and wine varieties. According to the OIV, this study establishes that "a large number of domain names have been registered which correspond to appellations of origin and geographical indications of wine-derived growing products, as well as wine varieties, without there being any relationship between the domain name registrants and the persons who hold rights in these distinctive signs."[\[216\]](#) A representative selection of domain names covered by this study, together with relevant registration data concerning these registrations, has been reproduced in Annex VIII.[\[217\]](#) Similar examples of claimed appellations of origin that have been registered as domain names have been presented by the INAO (see Annex IX).[\[218\]](#)

226. As a complement to the studies presented by the OIV and INAO, we have performed two similar exercises. The first relates to a number of examples of appellations of origin, including those for products other than wine, that have been registered by the International Bureau of WIPO under the Lisbon Agreement. The results are reproduced in Annex X. The second relates to a number of examples of other possible geographical indications and is reproduced in Annex XI.

227. The comments received, in particular the studies submitted by the OIV and INAO, reveal the existence of practices concerning the registration of geographical indications as domain names, which are similar, if not identical, to those that were observed in relation to trademarks and service marks, and which ultimately led to the adoption of the UDRP. As described by OIV and INAO, those practices are the following:

- (1) The registration of a domain name corresponding to a claimed geographical indication primarily for the purpose of selling, renting or otherwise transferring the domain name to a third party at a premium.[\[219\]](#)
- (2) The use of a domain name corresponding to a claimed geographical indication in connection with a product which does not benefit from the geographical indication, thereby creating a likelihood of confusion as to the quality, other characteristics or reputation of the product.
- (3) The use of a domain name corresponding to a claimed geographical indication with a view to attracting Internet users to a website or other on-line location, the contents of which bears no relationship with the geographical indication.[\[220\]](#)
- (4) The registration of a domain name corresponding to a claimed geographical indication with a view to preventing others from registering the same name.[\[221\]](#)

228. In light of these practices and their strong resemblance to those that have been observed previously in relation to trademarks and service marks, and taking into account the need to safeguard the interests of legitimate users of geographical indications in the DNS, as well as the interests of consumers, the Interim Report recommended that measures be adopted to protect geographical indications and indications of source in the open gTLDs, and proposed that these measures take the form of a broadening of the scope of the UDRP to cover the identifiers in question. The comments received on these preliminary recommendations are discussed in the next section of this Report.

ANALYSIS OF COMMENTS AND VIEWS EXPRESSED IN RESPONSE TO THE INTERIM REPORT

229. In recognition of the significant divergence in views throughout the world on what is to be regarded as a protectable geographical indication, the Interim Report's recommendations focused on attempting to curb only clear-cut cases of abuse of these identifiers, assuming that everyone might agree that manifestly bad faith behavior should be tolerated under no circumstances. The Interim Report proposed that this could be accomplished by broadening the scope of the UDRP to cover geographical indications and indications of source through a revision of the three-pronged test of subparagraph 4(a) of the Policy ("Applicable Disputes"). In view of the essentially collective nature of the rights represented by geographical indications and indications of source, the Interim Report also identified, discussed and proposed options for further reflection on the question of which persons or entities should be deemed to have standing to file a complaint under the proposed revised UDRP and which remedies (transfer or cancellation) should be available under the procedure.

230. A review of the comments submitted in response to the recommendations formulated in the Interim Report reveals continuing disagreement regarding the principle of providing protection in the DNS for geographical indications and indications of source, as well as regarding the form which such protection should take. Several commentators are in favor of the specific proposals contained in the Interim Report.^[222] Others, including some representing intellectual property interests,^[223] either oppose them, or, at best, consider them premature.^[224]

231. Commentators who are in favor of the protection proposed in the Interim Report note that geographical indications have been the victims of abuse in the DNS and that there exist international norms protecting this class of identifiers. That being the case, they see no reason why geographical indications should be afforded less protection in the DNS than trade or service marks. Some of these commentators are of the view that protection should not be restricted to cases of bad faith abuse, but that alternative dispute resolution procedures also should be available to resolve conflicts between parties each of which may have rights in the identifiers concerned, in light of the special nature of geographical indications representing collective, rather than individual, rights.^[225] The same commentators, as well as others, are of the opinion that an exclusion mechanism for geographical indications would be appropriate, or at least should be given further consideration, in light of ongoing negotiations in the framework of Article 23.4 of the TRIPS Agreement.^[226] If protection were to be provided through a revised UDRP, some commentators felt that panels with particular expertise in the subject matter would be needed, in view of its specialized nature and complexity.^[227]

232. On the question of who should be deemed to have standing to file complaints under the proposed revised UDRP, the Interim Report presented three options for further consideration: (i) the persons or entities who have standing to enforce these rights in accordance with the law of the country of origin, (ii) governments only, or (iii) the persons or entities who are found to have standing based on the law determined to be applicable to that issue by the panel, in accordance with the ordinary rules of private international law. Most commentators were of the view that the second option would be overly restrictive and favored either the first or last option.^[228] As a solution to the standing problem, one commentator proposed that a complainant wishing to avail itself of the proposed revised UDRP could be required to produce a declaration by either the courts or the government of its jurisdiction confirming that it has standing to pursue the complaint in question.^[229]

233. In light of the collective nature of the rights concerned, certain commentators proposed the creation of a new remedy for purposes of the proposed revised UDRP which would take the form of a "cancellation + exclusion". Such a new remedy would serve a dual purpose. On the one hand, it would prevent a prevailing complainant from arrogating to itself a collective right, and, on the other, it would avoid cancelled domain names from being re-registered in bad faith (potentially by the same registrant).^[230] Recognizing that multiple persons or entities may have a legitimate claim to the use of the same geographical indication or indication of source, certain commentators advocated the use of gateway systems and the creation of new chartered gTLDs to stimulate coexistence among these

competing legitimate interests.[\[231\]](#)

234. Commentators who oppose the introduction of protection for geographical indications in the DNS recognize that there exist uniform rules governing the subject matter, but believe that the level of harmonization achieved by those rules is insufficient to constitute an adequate basis for the protection proposed in the Interim Report. In particular, they highlight three specific areas where sufficient uniformity is lacking. First, they argue that the harmonized rules at issue (in particular the TRIPS Agreement) incorporate several qualifications and exceptions to the protection for geographical indications, striking a delicate balance of interests, which would be difficult, if not impossible, to reflect faithfully in the UDRP.[\[232\]](#) Secondly, they state that the legal and administrative mechanisms giving effect at the national level to the internationally harmonized norms vary widely, ranging, as noted above, from *sui generis* registration systems, certification or collective marks, the law on passing-off, unfair competition law and consumer protection legislation.[\[233\]](#) Thirdly, and perhaps most importantly, they claim that there exists no uniform view at the international level of what is to be deemed a protectable geographical indication, and that, consequently, terms which are protectable in some jurisdictions, are freely available in others.[\[234\]](#)

235. The commentators in question conclude that providing protection to geographical indications through the UDRP under this state of incomplete harmonization of the law is doomed to fail. They believe panels would be put in the awkward position of having to take decisions with insufficient guidance available to them, which would lead inevitably to the undesired creation of new law. For the same reasons that are set out in the section of this Report concerning personal names,[\[235\]](#) these commentators are of the view that this would jeopardize the UDRP's long-term viability as an effective dispute resolution system. This risk is considered particularly acute in the area of geographical indications because there has been, for many years now, continuing intense debate internationally between governments on the subject matter.

236. Next to insufficient harmonization of the applicable norms, the same commentators advance also other reasons for their reluctance to protect geographical indications through a revision of the UDRP. Some argue that there is not enough evidence of widespread abuse to justify such additional protection.[\[236\]](#) Others believe that the law governing the subject matter is so complex that it could not be enforced properly through a simple mechanism such as the UDRP, which is intended to deal with clear-cut cases not requiring extensive deliberation.[\[237\]](#) Still others are of the view that none of the proposals formulated in the Interim Report for solving the standing problem are satisfactory.[\[238\]](#)

RECOMMENDATION

237. This is a difficult area on which views are not only divided, but also ardently held. This alone is a cause for reflection about the desirability of introducing a modification dealing with this area to a consensus-based dispute-resolution procedure that is functioning efficiently and cost effectively.

238. It is undeniable that there is widespread evidence of the registration and use of geographical indications and other geographical source identifiers by persons who have no connection whatsoever with the locality to which the identifiers refer. These practices are misleading and harm, first, the integrity of the naming systems in which those geographical identifiers operate and, secondly, the credibility and reliability of the DNS. The question for decision, however, is whether there is a solid and clear basis in existing international law which can be applied so as to prevent erosion of the integrity of geographical indications and enhance the credibility of the DNS.

239. We believe that there are two fundamental problems in endeavoring to apply the

existing international legal framework to prevent the bad faith misuse of geographical indications in the DNS.

240. The first problem is that the existing international legal framework for the prohibition of false and deceptive indications of geographical source and the protection of geographical indications was developed for, and applies to, trade in *goods*. The Paris Convention, the Madrid (Indications of Source) Agreement and the TRIPS Agreement all deal with the misuse of geographical identifiers in relation to goods. There is, thus, not a ready and easy fit between these rules and the predatory and parasitic practices of the misuse of geographical indications in the DNS. The mere registration of a geographical indication as a domain name by someone with no connection whatsoever with the geographical locality in question, however cheap and tawdry a practice, does not appear to be, on its own, a violation of existing international legal rules with respect to false indications of source and geographical indications. Such a registration may violate existing standards if it is associated with conduct relating to goods. For example, a domain name registration that is used in relation to an offer of sale of goods may be considered to be a “commercial communication” under Article 3*bis* of the Madrid (Indications of Source) Agreement. If the domain name registration is a geographical identifier and it is false or deceptive, it may, in these circumstances, be considered to violate the prohibition against the use of false indications set out in Article 3*bis* of the Madrid (Indications of Source) Agreement. Additionally, for example, one can imagine various hypothetical uses of domain name registrations with respect to goods which might be considered to constitute violations of the provisions on the protection of geographical indications in the TRIPS Agreement. However, there are many circumstances in which a domain name registration, even though constituting a false or unauthorized use of a geographical indication, may not constitute a violation of existing international rules because there is no relationship between the domain name and goods. Existing rules, therefore, would offer only a partial solution to the problem of what is perceived to be the misuse of geographical indications in the DNS.

241. Secondly, there is a major problem in respect of applicable law because of the different systems that are used, at the national level, to protect geographical indications. For example, suppose that there is a geographical indication recognized and protected as such under the law of country A, but considered to be generic and descriptive under the law of country B. A resident carrying on business in country B registers, with a registrar based in country B, the geographical indication as a domain name and sells, from the website accessed through that domain name, goods that are available for purchase only by residents in country B. The person has no connection whatsoever with the locality covered by the geographical indication. What law applies to determine whether the registration and use of the domain name constitutes a violation of the protection of the geographical indication?

242. The problem of applicable law highlights the lack of a multilateral system for the recognition of geographical indications. The hypothetical problem referred to in the previous paragraph would not arise if there were a multilaterally agreed list of geographical indications. If such a list existed and were accepted by both country A and country B in the example given, it is a simple matter to determine whether there exists a protectable geographical indication.

243. We believe, therefore, that the existing international framework would provide only a partial answer to the perceived problems of false indications of source and geographical indications within the DNS. Furthermore, because of the need to resort to a choice of applicable law to resolve the question of the recognition of the existence of a geographical indication, very complicated questions would be involved in the application of the UDRP in this area. On these questions, international opinion is far from settled, as can be seen from the history of the negotiations with respect to a future Hague Convention on International Jurisdiction and Foreign Judgement in Civil and Commercial Matters.[\[239\]](#) These problems of applicable law could be avoided if a multilaterally agreed list of geographical indications were to be established.

recommended that no modification be made to the UDRP, at this stage, to permit complaints to be made concerning the registration and use of domain names in violation of the prohibition against false indications of source or the rules relating to the protection of geographical indications.

245. In making this recommendation, it is recognized that there is widespread dissatisfaction with the use of geographical indications as domain names by persons unconnected to the locality to which the geographical indications relate. We consider that, in order to deal with this problem, new law would need to be created in view of the inadequate reach of existing law. The dissatisfaction that exists about certain practices in the DNS in this area is, we believe, best expressed in a will on the part of the international community to advance multilateral discussions on (i) the definition of the circumstances in which the registration and use of geographical indications as domain names should be proscribed; and (ii) the establishment of a multilaterally agreed list of geographical indications or other means of satisfactorily dealing with the interaction of differing systems and levels of protection at the national level and the mutual recognition of geographical indications within those systems.

PREFERENCES AND PROTECTION FOR GEOGRAPHICAL TERMS *PER SE*

246. The foregoing sections of this Chapter discussed the existing international rules with respect to geographical identifiers which relate to the use of geographical terms in connection with goods. A separate issue that has surfaced is the claim for protection for geographical terms *per se* within the DNS, without reference to the use of the domain name in connection with goods or services. The issue centers on entitlement to register and the first-come first-served, automatic and unscreened nature of domain name registration systems. On the one hand, it is argued that the duly constituted authorities with respect to a geographical area, whether a country, state, city or town, should be entitled to register the name of that locality, as well as to prevent any party unassociated with the duly constituted authorities from registering the name. It is argued that the first-come, first-served nature of domain name registration systems exploit the digital divide and disadvantage authorities in countries with less developed infrastructures for the Internet in establishing their own identity in the DNS. Furthermore, it is argued, the fact that domain name registrations can be held by persons unconnected with the geographical locality is misleading to users and may give rise to the unjust enrichment of those persons on the basis of the reputation established by the geographical localities. On the other hand, it is argued that rights have already been acquired within the DNS on the basis of the existing operation of the system and that regulation of this area would risk disrupting the efficiency of the DNS.

247. An initial complication in dealing with this area is the range and diversity of geographical naming systems. They include the names of countries, regions, cities, towns, villages, communes, suburbs, streets, rivers and mountains, geo-political terms for groupings

of countries and geo-ethnic terms for indigenous peoples.

248. The remaining part of this Chapter provides evidence of the registration of geographical terms within the DNS; analyses the comments received in response to the consideration of these issues in the Interim Report; and formulates recommendations. Because of the range and diversity of geographical naming systems, consideration has been limited to only some such systems.

ILLUSTRATIONS OF THE REGISTRATION OF GEOGRAPHICAL TERMS WITHIN THE DNS

249. The illustrations of the registration of geographical terms that follow are grouped into four categories representing names of (i) countries, (ii) ISO 3166 country code elements, (iii) places within countries, and (iv) indigenous peoples. It is recognized that these illustrations are not exhaustive. Furthermore, they are not presented to advocate the position that the registrations at issue are necessarily abusive. The aim is merely to advance discussion in this area by providing some background material and concrete examples of domain registrations incorporating such terms in the currently existing gTLDs.

Country Names

250. There exists an official linguistic publication of the United Nations providing a list of the names of its Member States.^[240] The entry for each State includes its usual or “short” name (for example, “Rwanda”), as well as its full or formal name (for example, “the Rwandese Republic”). The usual name is used for all ordinary purposes in the United Nations. The full name, which may also be the same, is used in formal documents such as treaties and formal communications.

251. Annex XII contains a selection of the usual names of a number of countries and details of corresponding domain name registrations existing in some of the gTLDs, as well as the registrants, the country in which the registrants are located, and the type of activity that is conducted under the domain name.

252. The results in Annex XII suggest the following observations:

(i) The overall majority of country names in Annex XII have been registered by persons or entities that are residing or located in a country that is different from the country whose name is the subject of registration.

(ii) In almost all cases in Annex XII, the registrant is a private person or entity. Only rarely is it a public body or an entity officially recognized by the government of the country whose name has been registered.

(iii) The following activities are conducted under the domain names in Annex XII:

a) No activity (DNS lookup error, under construction, ...);

b) The offering for sale of the domain name in question;

c) The provision of information, products or services that bear no or little relationship with the country in question; and

- d) The provision of information regarding the country in question, often on a commercial basis.

253. There are relatively few reports of court decisions or decisions emanating from alternative dispute resolution procedures concerning disputes over the registration of country names as domain names. A complaint regarding the domain name *caymanislands.com* was filed by the Cayman Islands Government with the WIPO Arbitration and Mediation Center under the UDRP, but the case was terminated before a decision was taken on it.^[241] There also have been reports regarding the potential filing of a complaint under the UDRP with the WIPO Center by the Government of South Africa concerning the domain name *southafrica.com*, but to date the case has not been submitted.^[242] In a case involving the registration of a country name in a ccTLD, the Landsgericht of Berlin (Germany), by decision of August 10, 2000, has found that the domain name *deutschland.de* infringed the Government of Germany's "right in its name."^[243] This last case is currently the subject of an appeal.

ISO 3166 Country Code Elements

254. The origin of the codes reflecting country top-level domains is the International Organization for Standardization (ISO). ISO, which was established in 1947 as a non-governmental organization, is a worldwide federation of national standards bodies from 137 countries. Its mission is to promote the development of standardization and related activities in the world with a view to facilitating the international exchange of goods and services, and to developing cooperation in the spheres of intellectual, scientific, technological and economic activity.^[244] One of ISO's most famous standards is Part 1 of ISO 3166 concerning codes for the representation of names of countries and their subdivisions. Part 1 of ISO 3166 contains two letter country codes (alpha-2 codes; for example, au for Australia) and three letter country codes (alpha-3 codes, for example, aus for Australia). It is on the basis of the alpha-2 codes that the country code top-level domains (ccTLDs) were created by the Internet Authority for Assigned Names and Numbers (IANA) during the late eighties and early nineties.^[245] Since the creation of the ccTLDs, registrations in the country domains have flourished, as the use of the Internet has spread throughout the world. It is expected that the importance of the ccTLDs will continue to grow in the future.

255. A phenomenon concerning ccTLDs that merits attention is the registration at the second level in the gTLDs of the country code elements (for example, *uk.com*). Often these domain names are registered by persons or entities in order to make them available to the public for the registration of names at the third level (for example, *company.uk.com*).^[246] The implications of such practices are discussed below.

Names of Places Within Countries

256. As the list of names of places in the world that may have been registered as domain names is virtually limitless, an appropriate starting basis for the analysis must be found. The Convention concerning the Protection of the World Cultural and Natural Heritage is a useful instrument for this purpose. The Convention was adopted on November 23, 1972, under the auspices of the United Nations Educational, Scientific and Cultural Organization (UNESCO) and 188 States are party to it. Article 11 of the Convention provides for the establishment by the World Heritage Committee of a list of sites forming part of the cultural and natural heritage falling under the scope of the Convention (the "World Heritage List").^[247] Featured on the List are a number of cities that are famous for their cultural or historical importance. Annex XIII contains details of searches of domain name registrations with respect to some of the cities appearing on the World Heritage List.

257. The following observations can be made with respect to the information contained in Annex XIII:

(i) The majority of city names in Annex XIII have been registered by persons or entities that are residing or located in a country that is different from the country in which the city whose name is the subject of registration is located.

(ii) In several cases, the domain name is used as the address of a website providing information concerning the city whose name corresponds to the domain name. Often these sites appear to be operated by private entities on a commercial basis.

(iii) In several cases, the domain name is used as the address of a website providing general information (often in the form of a portal) that bears either no, or no significant relationship, to the cities whose names correspond to the domain name.

(iv) In one case, the domain name is offered for sale.

(v) In some cases, the domain name is used as the address of a website of a company whose name, or whose trademarks or service marks, correspond to the domain name.

258. A number of cases concerning the registration of cities or regions within countries have been reported in several European courts. In France, the Tribunal de Grande Instance of Draguignan, in its decision of August 21, 1997, found that the registration of the domain name *saint-tropez.com* constituted an infringement of the rights of the Commune of Saint-Tropez, the well-known beach resort located in the south of France.^[248] The Tribunal de Grande Instance of Paris, by preliminary injunction of April 3, 2001, ordered that the registration of the domain name *laplagne.com* for purposes of selling it to the holder of the trademark La Plagne (Association Office du Tourisme de La Plagne) constituted a tort.^[249] In its decision of March 8, 1996, the Landgericht of Munich (Germany) found that the registration of the domain name *heidelberg.de* constituted an infringement of the rights of the City of Heidelberg. Subsequent to this decision, several court cases have been filed in Germany regarding German city names. Most of the cases in question were decided in favor of the cities.^[250] By decision of May 2, 2000, the Federal Court of Switzerland upheld a complaint filed by a semi-official tourist organization regarding the registration of the domain name *berner-oberland.ch*, a region of Switzerland with a reputation for its picturesque landscapes. By decision of May 23, 2000, the Obergericht Luzern upheld a decision of a lower court ordering the holder of the domain name *luzern.ch* to refrain from offering e-mail services under this name, pending resolution of a complaint brought by the City of Lucerne seeking the transfer to it of that domain name by the registrant.

259. Several cases regarding place names within countries also have been filed with the WIPO Arbitration and Mediation Center under the UDRP.^[251] Two of these cases that involved city names have received much attention. These two cases concerned the domain names *barcelona.com* and *stmoritz.com*. By decision of August 4, 2000, the complaint regarding *barcelona.com* was upheld and, by decision of August 17, 2000, the complaint regarding *stmoritz.com* was denied.^[252] Other more recent such cases filed with WIPO concerned the domain names *laponia.org/laponia.net* (complaint granted),^[253] *portofhelsinki.com* (complaint denied),^[254] *portofhamina.com* (complaint denied),^[255] *brisbanecity.com* (complaint denied),^[256] *brisbane.com* (complaint denied),^[257] *olkiluoto.com/olkiluoto.net* (complaint denied),^[258] *rouen.com/rouen.net* (complaint denied)^[259] and *arena-verona.com* (complaint denied).^[260]

260. It should be noted that the complaints in many of the court and UDRP cases referred to above were based on the alleged abuse of a trademark registered in the name of the complainant and incorporating the place name subject to the dispute. Furthermore, usually

the domain names were deemed infringing in light of the nature of the activity conducted under the domain name and the motivation of the registrants. The cases therefore do not necessarily stand for the proposition that the registration of a city name or the name of a region, as such, is to be deemed abusive.

261. Finally in connection with place names, it may also be noted that several ccTLD administrators have adopted the policy of excluding the names of places in their countries from registration as domain names, at least under certain conditions. This is the case, for instance, for .AU (Australia),[\[261\]](#) .CA (Canada),[\[262\]](#) .CH (Switzerland), .DZ (Algeria),[\[263\]](#) .ES (Spain),[\[264\]](#) .FR (France),[\[265\]](#) .PE (Peru),[\[266\]](#) and .SE (Sweden).[\[267\]](#) Often these exclusions are based on official lists of place names compiled by the Government of the country concerned.[\[268\]](#)

Names of Indigenous Peoples

262. The question of the protection of the intellectual property rights of the world's indigenous peoples has received increasing attention over the last several years.[\[269\]](#) While global trade in the creations and knowledge of indigenous peoples has yielded important returns for some, it is felt by others that such commercial exploitation has not always been in harmony with the rights or expectations of the peoples concerned. In light of this ongoing policy debate, it seems appropriate to consider the incidence of the registration of the names of indigenous peoples as domain names. Annex XIV sets out details concerning domain name registrations of a number of well-known indigenous peoples.

263. The following remarks may be made with respect to the information contained in Annex XIV:

- (i) Hardly any of the names in Annex XIV have been registered by persons or entities that are recognized as representing the people denoted by the domain name.
- (ii) Except for those domain names corresponding to the names of peoples from the North American region, most domain names in Annex XIV have been registered in the names of persons or entities that are residing or located in countries that are different from the countries of the peoples concerned.
- (iii) The activities conducted under the domain names in Annex XIV only rarely are aimed at providing information about the peoples concerned.
- (iv) Most activities that are conducted under the domain names in Annex XIV fall under one of the following categories: no activity (DNS lookup error or holding page), general information or portal sites (of widely differing varieties) of a person or entity which does not appear to represent the people, website of company with a (product) name corresponding to the name of the people, and personal website of an individual whose first name corresponds to the name of a people.
- (v) In one case in Annex XIV, the domain name is offered for sale.

ANALYSIS OF COMMENTS AND VIEWS EXPRESSED IN RESPONSE TO THE INTERIM REPORT

Country Names and Names of Places Within Countries

264. On these names, the Interim Report presented two options for further consideration. The first option was to maintain the status quo (i.e., not introduce any protective measures), in recognition of the novelty of the subject matter, as well as the tenuous legal grounds for introducing protective measures in this area. The second option attempted to balance the competing interests of countries, domain name registrants and Internet users, by proposing a new cause of action under the UDRP aimed at curbing the abusive registration of the designations concerned as domain names in the gTLDs. To further clarify the type of conduct which this proposed cause of action was intended to cover, the Interim Report included a number of illustrations of what would be deemed good and bad faith conduct on the part of domain name registrants. Among the illustrations establishing good faith featured “[t]he use of the domain name as the address of a web site or other on-line location devoted to the provision of information concerning the country, region or municipality corresponding to the domain name ..., whether or not such information is provided for financial gain.”

265. A review of the comments received on the Interim Report reveals that it has failed to bridge the gap between those who oppose establishing protection for the designations in question^[270] and those who favor such protection.^[271] While the specific formulation of the proposed new cause of action was well received by some commentators, it is strongly opposed by the most ardent advocates of protection in this area, because it would legitimize conduct which they deem totally unacceptable: the commercial exploitation in the DNS by private parties of country names, assets which they consider the inherent property of sovereign States. The latter view is advocated in particular by one Government which is of the view that all full (or formal) names, as well as all short (or usual names) of countries, should be excluded from registration as domain names.^[272] The same Government also advocates the creation of a challenge procedure permitting governments to recuperate such names in all circumstances and irrespective of the use which is being made of them by their registrants, without any possibility of recourse to national courts to obtain the reversal of the decisions emanating from the procedure. According to the Government in question, this protection is particularly important for developing countries, in light of the difficulties they are facing in attempting to bridge the digital divide. The same Government also believes that the protection of country names in the DNS is fully supported by existing international intellectual property law.

266. Those who oppose the protection of country names (as well as the names of places within countries) in the gTLDs advance several arguments in support of their position. Most importantly, they state that there exist no international intellectual property norms protecting country names and names of places within countries and that, in the absence of such norms, no protection should be provided through the ICANN system.^[273] Furthermore, they argue that the terms in question are inherently generic in nature and that any restrictions on their use in the DNS would not be consistent with their free availability in the physical world.^[274] They also claim that different parties often will have competing legitimate interests in the terms concerned (e.g., Paris in France and Paris in Texas; Virginia as a state of the United States of America and the first name of a person) and that any protection mechanism would have to cater for this.^[275] One commentator raises the question how to deal with the names of countries and the names of places in countries registered in foreign languages, if protection were to be introduced.^[276]

267. Specifically with regard to the protection of country names, some commentators appear not to oppose continued consideration of the issue, but suggest that the ICANN system may not be the appropriate venue for this purpose, because of the likely need to create new rules of law, should protection be desired. References are made by these commentators to treaty processes or other forms of agreement between sovereign States and, in particular, to the Assembly of the Paris Union for the Protection of Industrial Property, the competent organ for the Paris Convention.^[277]

268. The Interim Report recommended the exclusion of the ISO 3166 alpha-2 country code elements from registration as domain names in the new gTLDs, in the absence of an agreement to the contrary from the relevant competent authorities. Furthermore, the Interim Report recommended that persons or entities who have registered such codes at the second level in the existing gTLDs and who accept registrations of names under them should take measures to render the UDRP applicable to such lower level registrations.

269. Several commentators favored the exclusion mechanism proposed in the Interim Report for the ISO 3166 alpha-2 country code elements,[\[278\]](#) while others opposed it.[\[279\]](#) Some of the entities offering the possibility of registrations under the codes in the existing gTLDs have expressed a willingness to adopt the UDRP or a similar procedure, as recommended in the Interim Report.[\[280\]](#) Few administrators of ccTLDs submitted comments on the Interim Report's recommendations in this area. Trademark owners have expressed concerns that the exclusion mechanism proposed in the Interim Report would prevent the legitimate registration of two-letter trademarks or acronyms of trademarks.[\[281\]](#)

Names of Indigenous Peoples

270. Apart from noting certain domain name registration practices in relation to the names of indigenous peoples, the Interim Report did not propose any specific recommendations in this area. While few comments were received on this particular topic, some commentators urged further study and assessment of the question, because they believe the practices observed in the Interim Report correspond to similar intellectual property issues relating to traditional knowledge, folklore and symbols in the physical world.[\[282\]](#)

RECOMMENDATION

Country Names and Names of Places Within Countries

271. Prior to considering which protective measures (if any) might be in order in relation to this class of geographical terms, it is necessary first to determine with more precision which concepts are intended to benefit from such protection. As far as countries are concerned, no particular difficulties arise as, apart from a few exceptional cases, it is clear which countries exist and what their names are.[\[283\]](#) However, the term "places within countries" is more vague and therefore requires further elucidation.

272. As the protection of place names within the gTLDs is a novel concept, it is proposed to take a conservative approach and interpret the term, at least at this stage, narrowly. It is therefore recommended that its scope be restricted to those items that are most closely associated with the territorial integrity of the State, namely regions that have received administrative recognition from the State (for example, provinces, departments...) and municipalities (cities, towns, communes...). This interpretation excludes from consideration other items which also might qualify as "places," such as streets, squares, natural, historical or cultural sites, mountains, rivers, lakes and waterways, buildings and edifices, monuments, and so forth. Limiting protection to administratively recognized regions and municipalities has the added advantage that the existence and the names of such entities are usually well documented within the constitutional and public law frameworks of countries.

273. It is recommended that the

consideration of any measures to protect the names of places in the gTLD should be restricted, at this stage, to the names of:

(i) countries; and

(ii) administratively recognized regions and municipalities within countries.

274. The comments received on the Interim Report's preliminary recommendations on the protection in the gTLDs of country names and the names of administratively recognized regions and municipalities within countries reveal that the concerns of those who are in favor of such protection relate in particular to the names of countries. While many of the arguments that are advanced in support of the protection of country names also can find application in relation to other place names, the present analysis will focus primarily (but not exclusively) on the protection of country names, in light of the concerns and expectations of the commentators. Whether it would be opportune at this stage to create this protection must be considered from both a policy, as well as a legal perspective.

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.[\[284\]](#) 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 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) .

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.^[285] The Convention does not, however, expressly mention country names, but some have argued that they nonetheless should be deemed to fall within its scope.^[286] While a number of innovative arguments can be advanced in support of this position,^[287] 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.

279. Article 6*ter* (1)(a) reads as follows:

"The countries of the Union agree to refuse or 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."

280. Article 6*ter* (1)(b) reads as follows:

"The provisions of subparagraph (a), above, shall apply equally to armorial bearings, flags, other emblems, abbreviations, *and names*, of international intergovernmental organizations of which one or more countries of the Union are members... ." *(Emphasis added)*

281. The fact that subparagraph 1(b) refers explicitly to names of international intergovernmental organizations, while subparagraph 1(a) does not refer to names of countries supports the view that the latter provision does not provide an existing legal basis for the protection of country names in the DNS (*expressio unius exclusio alterius*).

282. Furthermore, during the Second Session of the Working Group on Conflicts Between An Appellation of Origin and a Trademark of the Preparatory Intergovernmental Committee on the Revision of the Paris Convention (Geneva, June 18 to 29, 1979), a proposal was made by the Group of Developing Countries to add the "official names" of States to the items to be protected under subparagraph 1(a) of Article 6*ter*.^[288] This proposal was reflected in the Basic Proposals for the Diplomatic Conference.^[289] At the end of the Third Session of the Diplomatic Conference (October 4 to 30, 1982 and November 23 to 27, 1982), Main Committee I adopted the following proposed change:

“As regards Article 6*ter*, after a full discussion, agreement was reached on October 22, 1982, on the text which is reproduced in Annex I to this report and which extends the protection under Article 6*ter* to official names of States. Main Committee I unanimously adopted this text and transmitted it to the Drafting Committee”.[\[290\]](#)

283. However, for other reasons, the Diplomatic Conference did not result in a revision of the Paris Convention and Article 6*ter* therefore remained unchanged.

284. In light of the above, the following observations seem in order:

(i) Considering that the States party to the Paris Convention were of the view that Article 6*ter* would need to be amended to offer protection for the official names of countries, the position that Article 6*ter*, in its current unrevised form, covers country names seems difficult to maintain.

(ii) At the time of the Diplomatic Conference, developing countries only sought to obtain protection under Article 6*ter* for the official names of countries (for example, the Republic of South Africa) and not for their usual names (for example, South Africa). However, this statement must be qualified in two respects. First, it may have been possible for countries to notify also their usual names as official names to the International Bureau under the notification procedures foreseen in Article 6*ter*. Secondly, discussions were held at the Diplomatic Conference on the need to offer protection also for the usual names of countries under a new proposed Article 10*quater*, but only if these names were used in a manner that misleads the public.

285. In view of these observations and without prejudice to the relative merits of any policy considerations in this connection, it is submitted that any protection offered in the gTLDs to country names (as well as any other place names), as such, would amount to the creation of new law, at least from the international intellectual property perspective. A recommendation to adopt such measures consequently would be a departure from one of the fundamental principles underlying the Report of the first WIPO Process, namely, the avoidance of the creation of new intellectual property rights or of enhanced protection of rights in cyberspace compared to the protection that exists in the real world.[\[291\]](#) Furthermore, in considering whether it would be opportune, under these circumstances, to introduce any protective measures for these names and what the nature of those measures might be, account should be taken of the fact that terms in this area are protected in certain jurisdictions but are freely available in others. Due to this lack of harmonization and the resultant differing treatment of the issues at the national level, any protective measures that might be adopted for the gTLDs, and the results that they might produce, run a greater risk of being invalidated, if contested at the national level.

286. Notwithstanding the considerations expressed in the preceding paragraph, we strongly believe that, as a matter of policy, country names and the names of administratively recognized regions and municipalities within countries should be protected against abuse in the gTLDs and the Interim Report set out a proposal intended to achieve that goal. That proposal, which was centered on a definition of abuse aimed at striking a reasonable balance of competing interests between countries, domain name registrants and general Internet users, did not receive sufficient support to be put forward as a final recommendation in the present Report. An important reason for this is that those commentators who are most ardently in favor of the protection of country names are of the view that the mere registration of these names as domain names by private parties constitutes in and of itself an abusive misappropriation of a national asset, irrespective of the use (if any) which may be made of the domain names. Rather than expressing agreement or disagreement with this position, we draw attention to the following fundamental characteristics of the debate, as they have emerged from the Second WIPO Process:

(i) The question of the appropriateness of the registration of country names in the gTLDs is inextricably linked by some governments to what they perceive to be their national sovereign

interest.

(ii) Protecting country names in the gTLDs would require or amount to the creation of new law, a function traditionally reserved for States.

287. Both points lead us to conclude that we have reached the limits of what can be achieved legitimately through consultation processes, such as the WIPO Internet Domain Name Processes or any similar ICANN processes. In other words, we agree with those commentators who are of the view that this particular question is more appropriately dealt with by governments.

288. It is recommended that the question of the protection in the gTLDs of country names and the names of administratively recognized regions and municipalities be further considered in the appropriate intergovernmental fora, in particular with a view to a discussion on the need for new international rules for the protection of country names.

289. Our reluctance to recommend the introduction of new protective measures for country names in the gTLDs principally stems from the view that the international intellectual property framework offers insufficient basis therefor at the present time. This finding, however, is without prejudice to the situation in the ccTLDs. As explained above, the administrators of many ccTLDs have already foreseen mechanisms to safeguard interests in place names within their domains. In line with the policy objectives outlined above, we generally encourage the introduction of such safeguards, in particular, if they are aimed at curbing abusive registrations practices and provided, of course, this is consistent with local law.

ISO 3166 Alpha-2 Country Code Elements

290. The Interim Report formulated two recommendations in relation to ISO 3166 country code elements. First, it proposed that these codes be excluded from registration in the new gTLDs, unless the relevant authorities grant permission for their registration. Secondly, it recommended that persons or entities who have registered such codes at the second level in the existing gTLDs and who accept registrations of names under them take measures to ensure that the UDRP applies to such lower level registrations.

291. In connection with the first recommendation, we note that the current version of Appendix K to the Registry Agreements between ICANN and the sponsors and operators of the new gTLDs states that “[a]ll two-character labels shall be initially reserved. The reservation of a two-character label string shall be released to the extent that the Registry Operator reaches agreement with the government and country-code manager, or the ISO 3166 maintenance agency, whichever appropriate. The Registry Operator may also propose

release of these reservations based on its implementation of measures to avoid confusion with the corresponding country codes.”[\[292\]](#)

Exclusions for ISO 3166 Country Code Elements. A number of factors, highlighted in the comments and reactions received on the Interim Report, have lead us to re-consider our recommendation that the ISO 3166 alpha-2 country code elements should be excluded from registration as domain names in the gTLDs. These factors are as follows:

(i) While, on the Internet, the ISO 3166 codes have been associated in particular with country code top-level domains, in the physical world they find broad application and use throughout a wide variety of industries. This is consistent with the nature and purpose of the standard, which itself states that “[it] provides *universally applicable* coded representations of names of countries ...” and that “[it] is intended for use *in any application* requiring the expression of current country names in coded form.” (*Emphasis added*)[\[293\]](#) We observe that some of the industries which traditionally have used the ISO 3166 codes to structure themselves in the physical world are migrating some aspects of their operations to the online world, and that this trend may intensify in the future. As they move to the Internet, these industries may wish to rely on the same codes to replicate their structures in the networked environment, including the DNS. Excluding the registration of the ISO 3166 codes as domain names may, under certain circumstances, unfairly hamper those industries in their on-line activities, by establishing an overly exclusive linkage between the codes in question and the country domains.

(ii) Certain ISO 3166 country codes correspond to the acronyms of other identifiers, in particular trademarks. Excluding the codes from registration in the DNS would prevent such other identifiers from being registered as domain names without seeming justification.

292. In light of the above considerations, we no longer subscribe to the view that the ISO 3166 country code elements should be excluded from registration in the new gTLDs under all circumstances. Nonetheless, we remain concerned that, depending on the manner in which these codes are registered and used in the DNS, confusion may be created with the ccTLDs. That being the case, we believe that the proper focus should be on the avoidance of confusion with regard to those codes, rather than on an absolute prohibition of their registration and use.

293. If ISO 3166 alpha-2 country code elements are to be registered as domain names in the gTLDs, it is recommended that this be done in a manner that minimizes the potential for confusion with the ccTLDs.

294. The practice of registering ISO 3166 country code elements at the second level in the gTLDs in order to offer to the public the opportunity to register names under them raises questions regarding the application of the UDRP.[\[294\]](#) The current version of the UDRP essentially is aimed at ensuring that names registered at the second level under the gTLDs to which the UDRP applies are not abusive. If they are found to be abusive, the UDRP foresees that the names can be cancelled or transferred to the complainant. However, if a country code is registered at the second level in one of these gTLDs and names are allowed to be registered under it, the level where the abuse most likely will occur is not only, or

necessarily, the second level, but the third level (for example, *famousmark.uk.com* registered by a cybersquatter). This raises questions in terms of the applicability and enforcement of the UDRP. First, while it is clear that the registrant of the country code at the second level is bound to the UDRP (through its registration agreement with an ICANN-accredited registrar), it is not clear whether the registrant of the name at the third level would also be (indirectly) bound to the UDRP (as its agreement is with the registrant of the name at the second level, who may not have included a submission to the UDRP as a condition for accepting the registration of the name at the third level). Secondly, even if it were found that the UDRP indirectly applies to the third level, enforcement issues nonetheless would persist. The UDRP foresees that the ICANN-accredited registrars must cancel or transfer the name registered at the second level in case a violation of the Policy is found to exist. However, numerous names may be registered under the country code at the third level, only some of which might be abusive. Canceling or transferring the registration at the second level (i.e., the country code) might then be a disproportionate measure, because all the names at the third level (as well as those at any lower levels) would be adversely affected, irrespective of whether they were abusive or not. In view of these considerations, the persons or entities who have registered ISO 3166 country code elements and accept registrations of names under them should take measures to render the UDRP applicable to these registrations and to ensure the proper and prompt implementation of decisions transferring or canceling the registrations resulting from the UDRP. We are encouraged by the fact that certain such entities through comments submitted on the Interim Report have expressed a desire to work toward this goal.[\[295\]](#)

295. With regard to the ISO 3166 alpha-2 code elements, it is recommended that the persons or entities in whose name such codes are registered at the second level in the existing gTLDs and who accept registrations of names under them be encouraged to take measures to render the UDRP applicable to these registrations, as well as to registrations at lower levels, and to ensure the proper and prompt implementation of decisions transferring or canceling these registrations resulting from the UDRP.

Names of Indigenous Peoples

296. While the Interim Report provided illustrations of certain domain name registration practices regarding the names of indigenous peoples, it did not propose any specific recommendations in relation to those practices. Few comments were received regarding this topic, but those commentators that addressed the issue, urged further consideration of the matter.[\[296\]](#)

297. We believe that it is too early, at this stage, to formulate any recommendations regarding the protection of the names in question in the DNS. An important reason for this is that the communities who are most affected by the topic (indigenous peoples) have not yet had the opportunity to participate fully in the debate. It is therefore proposed that, for the time being, efforts in this area be focused on sensitizing indigenous peoples to the phenomenon and encouraging them to make their voices heard. This could be achieved through a variety of channels, including WIPO's program of work on intellectual property and genetic resources, traditional knowledge, and folklore.[\[297\]](#)

7. TRADE NAMES

298. A trade name is the designation adopted by a commercial enterprise to describe itself and to distinguish it from other businesses and enterprises. Trade names are also referred to variously as company, corporate, business or firm names, although each of these identifiers may sometimes attract slightly different legal or regulatory conditions. Common examples of familiar trade names are Ericsson, General Motors, Holiday Inn, Lego, Microsoft, Nestlé, Philips, Procter & Gamble and Sony. A trade name may also be registered and separately protected as a trademark, as most of the foregoing examples are.

299. The present Chapter reviews the legal protection of trade names at the international and national levels; analyses the comments received in response to the proposals contained in the Interim Report concerning the protection of trade names against abusive registration and use as domain names; and formulates a recommendation on the treatment of trade names within the DNS.

THE INTERNATIONAL PROTECTION OF TRADE NAMES

300. The Paris Convention for the Protection of Industrial Property (the Paris Convention) establishes a norm requiring the protection of trade names in all States party to the Convention. Article 8 provides as follows:

“A trade name shall be protected in all the countries of the Union without the obligation of filing or registration, whether or not it forms part of a trademark.”

301. Article 8 of the Paris Convention is a broadly formulated rule, which leaves a great deal

to national implementation. It comprises three elements that restrict national implementation, but otherwise leaves freedom at the national level. Those three elements are:

- (i) A State party to the Paris Convention must provide protection for trade names;
- (ii) Protection must be extended without the condition of registration; and
- (iii) The protection must be independent of the protection accorded to trademarks, even if the trade name is also registered as a trademark.

302. The freedom left to States to implement trade name protection at the national level includes, notably, two important areas. The first of those is the definition of what constitutes a trade name and, thus, the conditions that must be satisfied by a designation in order to qualify as a trade name. Various conditions are applied, including the requirement of inherent or acquired distinctiveness, the requirement of use and the requirement of the establishment of reputation or goodwill in the trade name. The second area left to national law is the scope of protection accorded to trade names. Protection is not absolute and is usually defined by reference to one or both of two factors, namely, the field of trade activity in which the trade name is used (thus, for example, the trade name of an enterprise in the field of information technology may only enjoy protection in that particular field); and the geographical area over which the trade name enjoys a reputation (thus, for example, the trade name of a baker's shop may be protected only in the village and commune in which it is found, whereas the trade name of a transnational enterprise may enjoy protection that is commensurate with the geographical area in which that enterprise operates).

NATIONAL PROTECTION OF TRADE NAMES

303. In view of the large scope left to national implementation by Article 8 of the Paris Convention, WIPO conducted, in the course of the Second WIPO Process, a survey of its Member States to gather information about the manner in which different countries have implemented trade name protection. The questionnaire and analysis of the responses received from 72 countries are set out at Annex XV hereto. It is evident that the protection of trade names at the national level is variously implemented through a single law or a combination of civil and criminal law, commercial law, trade practices, trade name and trademark legislation and common law principles of unfair competition^[298] or 'passing-off'.^[299]

304. There are clearly wide variations in countries' approaches to the protection of trade names. In view of the absence of internationally harmonized protection, some commentators to the Second WIPO Process opposed the extension of protection of trade names from the physical world to the DNS.^[300] Others, however, took the view that a means of protection for trade names could be established which would recognize the diversity of approaches and still provide protection for this important and valuable form of industrial property.^[301] One commentator remarked that, indeed, a failure to protect trade names in the DNS would contravene the international law established by the Paris Convention.^[302]

305. As an illustration of the differing treatment accorded to trade names, one commentator noted that in the Scandinavian countries of Denmark, Finland, Norway and Sweden, businesses are protected more commonly through registered trade name protection than through trademark law, and trade names may receive stronger protection than trademarks. This commentator suggested that decisions on disputes between entities that originate from such countries should be determined in light of their local law. ^[303]

PROTECTION OF TRADE NAMES IN THE DNS

306. National legal systems have developed to accommodate the co-existence of trade names, and enable many businesses to trade in different jurisdictions or in different fields of industry using identical or similar trade names, without conflict. The DNS, at least in the present gTLD space, cannot reflect this plurality, as each domain name is unique and global. Problems may arise for businesses that use their trade names in commerce, and find that the corresponding domain name has been registered by another. In the case of competing claims to a trade name among legitimate users, the first-come, first-served principle of domain name registration applies. However, conflict arises when a trade name has been registered or used in bad faith as a domain name by a third party with no rights to the name, resulting in potential damage to the trade name owner's business reputation, or limiting its capacity to establish a trading presence on the Internet.

307. Some national courts have recognized the rights of trade name owners to prevent others from registering and using their trade names as domain names. In the United States of America, for example, the Federal Lanham Act^[304] gives trade name owners a civil cause of action against any use of a trade name that misrepresents the source of the goods or services, or is likely to cause confusion regarding their source. This protection has been extended to the unlawful use of trade names as domain names in the decision *U.S. v. Washington Mint, LLC*.^[305] In Germany, the courts have found in favor of owners of 'name rights' in cases where the domain name registrant was unable to establish any legitimate interests in the name, in the Düsseldorf Court of Appeal's decision with respect to the domain name "ufa.de", for example.^[306] The German courts have readily found against domain name registrants where their use of a commercial name in the DNS is liable to cause confusion or mislead the public,^[307] at the same time upholding the rights of domain name registrants who have legitimate rights in the underlying trade name.^[308]

308. In the DNS at the level of country-code top-level domains (ccTLDs), many registration authorities impose restrictions on the commercial entities that may register names in their domain, particularly in any second-level domains chartered for commercial use. Many ccTLD administrators require applicants to warrant that their domain name does not infringe the legal or other rights of third parties. However, among respondents to the WIPO trade names questionnaire, a minority of ccTLD administrators require applicants to assert or prove their legitimate right to register a commercial or trade name as a domain name.^[309]

309. Evidently there exists no uniform or robust protection for trade names in the DNS. As a result, in the event of abuse, business owners are required either to concede the right to use their trade name online when confronted with its abusive or bad faith registration as a domain name, or else attempt to defend their legal rights through national judicial systems.

ANALYSIS OF COMMENTS AND VIEWS EXPRESSED IN RESPONSE TO THE INTERIM REPORT

310. The Interim Report requested further submissions of evidence of the extent of abusive registrations of trade names as domain names. While few comments were received from trade name owners subject to such abuse, a majority of comments were nevertheless in favor of protection of trade names, as discussed below. Some commentators pointed to the lack of evidence of significant abuse of trade names to argue that protection was therefore unnecessary.^[310] However one comment from the administrator of .UK estimated that half of the 1,400 disputes handled to date by its Dispute Resolution Service concerned trade names, rather than trademarks or personal names, typically involving small localized businesses and that a "relatively high proportion of those cases show evidence of abusive registration, often as a result of 'board room fall-out', competitors in a narrow geographical area, or an individual warehousing names of businesses in the local area."^[311]

311. The majority of commentators to the Second WIPO Process favored the protection of trade names in the DNS through an administrative dispute resolution process that would enable trade name owners to protect the good will and reputation associated with their name against bad faith, abusive, misleading or unfair use as a domain name.^[312] Commentators widely recognized that trade names perform the same 'origin function' as trademarks, indicating the source or nature of the business entity they represent, and perform the same investment or advertising function. To the extent that trade names serve an identifying function, like trademarks, there was support for their protection in the DNS, equivalent to that accorded to trademarks.

312. The means of protection favored by most commentators to the Second WIPO Process was the extension of the UDRP, which at present applies only to trademarks and service marks, to cover trade names.^[313] It was noted that to the extent that most trade names also function as trademarks, as such, they are already protectable under the UDRP.^[314] One commentator noted that extending the UDRP to cover trade names would overcome the current discrepancy and unfairness that results in the situation that personal names that also function as unregistered trademarks can be protected under the UDRP only in those jurisdictions where such unregistered rights are recognized, but not in jurisdictions such as Switzerland or France, where unregistered rights are not accorded protection.^[315]

313. A significant minority of commentators were opposed to any protection being extended to trade names, principally because of the difficulty of harmonizing the various national approaches into a cohesive policy to apply in the DNS.^[316] In this context, it was suggested that protection for trade names in the DNS should be applied on a country-by-country basis, depending on local application of the Paris Convention under national law. ^[317] This approach could be accommodated, in the context of UDRP, where panelists determine cases in relation to the circumstances of each case and the applicable principles of national law. Some commentators noted that trade names, unlike trademarks, are broadly defined, unregistered and unregulated and that, as a result, their protection in the DNS could compromise individual rights^[318] and impact upon small businesses.^[319] Commentators also noted that numerous identical trade names may legitimately co-exist in different jurisdictions, in contrast to the unique global presence offered by a domain name.^[320] It is noted that, by way of analogy, the co-existence of trademarks in various jurisdictions is currently accommodated under the UDRP by the requirement of a showing of bad faith registration and use of the domain name by the respondent. If a respondent is able to demonstrate a co-existing legitimate use of the name, the complainant's case is not made out, and the respondent retains its use of the domain name.

314. As with other identifiers addressed in this Report, commentators expressed some concern at the retrospective application of any mechanism of protection for trade names, noting that some business owners could be injured as a result.^[321] In addition, some commentators remarked that any system instituted to protect trade names in the DNS could be used to hijack names from individuals and smaller enterprises.^[322]

315. Most commentators supported the protection of trade names in all existing and new gTLDs, and particularly in ccTLDs, where the national relevance of trade names lends support to their protection.^[323] Some commentators noted the potential for differentiation in the DNS, and suggested that trade names should only receive protection in gTLDs with a commercial charter,^[324] or that remedies should take into account the nature of the gTLD in question.^[325] Others remarked upon the potential for differentiation between TLDs to lessen the risk of confusion resulting from registration of trade names in the DNS.^[326]

316. There was general support for the multifactor analysis proposed in the Interim Report, concerning the constituent factors to be considered in determining whether a trade name warrants protection in any given case. ^[327] In highlighting those factors considered most

relevant for such determinations, commentators focused upon evidence of company name registration (if applicable), evidence of use and established reputation in a particular field of business, use of the domain name in a same or similar field of interest to the trade name, and whether the trade name had acquired secondary meaning.^[328] One commentator stated that complainants should be required to prove that their trade name has become distinctive as an indication of source,^[329] and to prove their trade name's inherent or acquired distinctiveness by 'clear and convincing evidence'.^[330] Some commentators stated that any protection of trade names in the DNS should not extend to generic words,^[331] whether or not they had acquired distinctiveness through use.

317. It was also suggested that the current UDRP definition of 'bad faith abusive, misleading or unfair registration and use' in respect of trademarks could simply be adjusted to apply to trade names.^[332] As noted by one commentator, the real issue is to determine what constitutes 'abuse' of a trade name: "Any *abuse* of a sign in the scope of the Domain Name System should – as well as in the 'real world' – not be tolerated and therefore be prevented".^[333] Proof of bad faith was seen as critical by commentators, in order to prevent reverse domain name hijacking.^[334] In this regard, it was also stated that commercial entities should not automatically take precedence over non-commercial entities in relation to the use of trade names as domain names.^[335] In any conflict between two entities with legitimate rights in the name, it was noted by one commentator that the matter should be left to a court of competent jurisdiction to decide.^[336]

RECOMMENDATION

318. Despite the majority opinion that protection should be extended to trade names within the DNS, we do not consider that it is appropriate to modify the UDRP so as to allow complaints for the bad faith and misleading registration and use of trade names as domain names for the following reasons:

- (i) The international legal principle for the protection of trade names leaves extensive scope to differing national implementations, which is reflected in the diversity of national approaches that was found to exist with respect to the protection of trade names. This national diversity inevitably creates a problem for the choice of applicable law on a global medium. The situation of trade names is, in this respect, akin to that of geographical indications insofar as it would be necessary for a dispute-resolution panel, in the absence of convergent national approaches, to identify the national law that should be applied to determine the existence of a protectable trade name. We do not believe that the law is sufficiently clear on this question, with the consequence that there would be a risk of lack of coherence in decisions, which might engender dissatisfaction and lack of understanding of the procedure.
- (ii) The practice in the use of trade names covers a very large range of commercial activity, including very small one-person enterprises operating in very limited geographical areas, as well as very large enterprises operating in global markets. It is certainly the case that very small enterprises operating in limited geographical areas deserve protection for their trade names when the conditions of eligibility for the protection are satisfied. Whether those conditions of eligibility can be identified with precision for disputes in gTLDs on a global medium, however, is problematic. Where a trade name is used in widespread markets, it is often also the subject of trademark protection or satisfies the conditions for protection as an unregistered trademark so as to qualify, in appropriate circumstances, for protection against bad faith, deliberate misuse under the UDRP.
- (iii) The UDRP was designed for, and applies to, straight-forward disputes, where there are rights on one side and no rights or legitimate interests on the other side. It was not designed to accommodate disputes involving interests on both sides, which requires a more extensive

procedure, perhaps involving the hearing of evidence and oral arguments. Many trade name disputes, because of the relatively light burden imposed to establish eligibility for trade name protection, will involve interests on both sides.

(iv) We are not convinced that sufficient evidence was produced of widespread abuse of trade names through domain name registrations and use.

319. It is not recommended that the UDRP be modified to permit complaints to be made on the basis of abusive registrations and use of trade names per se.

320. In the case of ccTLDs, we believe that much greater scope exists for allowing complaints under a dispute-resolution procedure for abusive registrations of trade names. Within the ccTLD, the problem of diversity does not exist in the same way and there is greater scope for applying the relevant national implementation of protection of trade names.

8. THE ROLE OF TECHNICAL MEASURES

321. As described in the first Chapter of this report, the Domain Name System (DNS) is undergoing rapid evolution, as millions of new domain names are registered, currently numbering over 35 million and forecast to exceed 75 million domain names by 2002,^[337] new top level domains are added, and new language scripts are sought to be accommodated. In this context, the request addressed to WIPO to initiate the Second WIPO Process also noted that “in undertaking the process, it would be beneficial if any information received or collected concerning technical solutions to domain name collision control was collated for the information of WIPO Members and the Internet community.” This Chapter provides a collation of the material received during the course of these consultations, and points to areas of current need, as well as future possibilities in ameliorating conflict in the evolving DNS.

322. At various points in this Report, suggestions had been made about the appropriate fora for the development of new intellectual property law or policy, if such new law or policy is considered to be desirable by the international community. Just as the creation of new law has appropriate fora, the oversight of technical measures and operational questions has an appropriate forum. The management of the operational stability of the DNS falls squarely within the Articles of Incorporation of the Internet Corporation for Assigned Names and Numbers (ICANN). The ensuing analysis of the role of technical measures, therefore, must be understood as a contribution, from the perspective of intellectual property, to questions for which ICANN has responsibility of oversight.

THE WHOIS DATA SEARCH FACILITIES

323. The Whois system of databases is the collection of information concerning domain name registrants' contact details that are required to be gathered by domain name registrars. The Whois databases, of which there are increasing numbers separately in respect of gTLDs and ccTLDs, contain data provided by domain name registrants in the course of entering a contract for a domain name registration. The Whois information, including the contact details of the registrant, as well as nominated technical and administrative contacts and associated technical data, is not routinely checked for veracity or completeness at the initial stage, and is automatically included in the applicable Whois database. Nor are checks made as a matter of course to ensure that the information is kept up-to-date. Most Whois databases are publicly available online, for real-time searching by all enquirers.

324. The Whois search facilities are used principally by members of the public to determine the identity of domain name registrants and the technical and administrative contacts for the web site hosts. The searches are employed by many users for various legitimate purposes – including by rightsholders to identify and locate possible infringers of their rights in order to enforce those rights, to allow consumers to identify online merchants, to source unsolicited e-mail and to enable law enforcement authorities to investigate illegal activity, including consumer fraud. [338] As first intended, the Whois also provides a crucial resource for network administrators who may need to correct network problems or determine the perpetrators of spam or hacking attacks. In a dispute-resolution context, the availability of accurate Whois data is also vital to ensure that registrants are notified of any legal or administrative UDRP proceedings against them, and thereby to ensure due process. Similarly, rightsholders employing 'notice and takedown' provisions under national laws, such as the United States Digital Millennium Copyright Act, depend upon Whois resources to match infringing sites with affiliated service providers for notification purposes. [339] In its multiple capacities, the Whois plays a critical role in the prevention and resolution of conflict in the DNS. At a time when the inscrutability of the Internet is increasingly a cause for concern among consumers, users and their advocates, one commentator remarked that:

“Public accessibility to such data provides much needed transparency in the DNS and accountability for those who hold themselves out to the public over the Internet. ... This transparency and accountability serves to both facilitate the redress of abusive and unlawful conduct in the DNS and to deter such conduct in the first place.” [340]

325. It is also recognized that the data in Whois databases could be accessed for invalid purposes, with the potential for invasion of personal privacy, and appropriate consideration must be given to means to prevent such injurious conduct, while maintaining an effective and accessible search facility for legitimate users.

COMPREHENSIVE WHOIS SEARCH FACILITIES

326. The Interim Report asked whether the Whois system, as it currently operates, is adequate to fulfil its dispute-prevention function, or whether it should be extended in any of three ways:

- (i) to enable Whois searches across any new open gTLDs;
- (ii) to enable searches across the Whois databases of all registrars; and
- (iii) to enable searches across the Whois databases of all registrars for more than just the exact domain name.

327. Of all the technical issues raised for discussion, the Whois search facilities excited the most forceful comment. The vast majority of commentators were strongly in favor of promoting the integrity of Whois information. [341] To the intellectual property community of rightsholders and consumers, Whois databases are essential for evaluating and protecting intellectual property rights, for combating online copyright piracy and for facilitating the licensed use of copyright materials online.[342]

328. The issue of Whois search capacity is not new – it has been the focus of fierce debate in the course of the first WIPO Process and is now the subject of a survey being conducted by the Domain Names Supporting Organization (DNSO) of ICANN.[343] The first WIPO Process Report recommended that the contact details of all holders of domain names in all open gTLDs should be made publicly available in real time.[344] The Report recommended that, at least for so long as the gTLDs remain undifferentiated, the public availability of these details is essential, and reflects the well established principle of open availability of contact details of business enterprises operating in the commercial sphere. It was also recommended that the domain name registration agreement should contain a requirement that the applicant provide certain accurate and reliable contact details. [345] It was also noted that the nature of such searchable databases was an issue of technical coordination, outside the scope of the WIPO Process, and that it remained for ICANN to establish via its relationships with registry administrators and registrars.[346]

329. ICANN's current Registrar Accreditation Agreement requires registrars to make available at least the following information: the domain name, the Internet Protocol address of the primary and secondary nameservers, the corresponding names of those nameservers, the identity of the Registrar involved, the dates of registration and expiry, the name and postal address of the domain name holder, the name, postal address, email address, telephone and fax numbers of the technical and administrative contacts. [347] This information is required to be searchable by simple logical and combined methods, updated promptly, presented in a consistent format, and linked to the registrar or registry's site with nominated contact points to receive any complaints concerning incorrect contact data. [348]

330. Commentators to the WIPO Processes have continued to reiterate the importance of reliable Whois information that is accurate and up-to-date.[349] The Report of the first WIPO Process recommended that domain name registration agreements should contain a term making the provision of inaccurate or unreliable information by the domain name holder, or the failure to update information, a material breach of the registration agreement and a basis for cancellation of the registration by the registration authority, and this has been supported by commentators to the WIPO Processes. [350] In fact, ICANN's Registrar Accreditation Agreement states that the willful provision of false or inaccurate contact data constitutes a material breach of the registration agreement and a basis for its cancellation. [351] ICANN's Statement of Registrar Accreditation Policy requires accredited registrars to provide public access on a real-time basis, such as by way of a Whois service, to the contact details that are required to be provided by a domain name registrant, and to keep such information updated. [352] It is noted that there exist means by which registrars can improve the validity of Whois data, through random sampling or by acting upon notifications by third parties of the discovery of inaccurate details.

331. It is recommended that registration authorities should be encouraged to take measures to ensure that Whois data is accurate, reliable, up-to-date and

332. It is considered essential that the current requirements for free public access to a Whois service should be extended to any new gTLDs.[\[353\]](#) The majority of commentators expressed strong support for such a comprehensive search facility, especially pressing in light of the introduction of new gTLDs.[\[354\]](#) The Intellectual Property Constituency (IPC) of ICANN's Domain Name Supporting Organization (DNSO) proposed criteria that should be required of new gTLD's Whois services, and the methods by which this information could be searched. [\[355\]](#) The IPC recommended that the database information should be searchable by domain name, registrant's name or postal address, contacts' names, NIC handles and Internet Protocol address, and should be required to be kept current and comprehensive. Further, it was stated that searches should not be arbitrarily limited, either in number or in type (e.g., limited only to matches with exact domain names).

333. It is also considered essential that a Whois data facility should be comprehensive, enabling searches across all registrars' databases, including all gTLDs and to the greatest extent possible, as discussed below, the ccTLDs. This need is a consequence of the Shared Registration System introduced by ICANN in early 1999, that has resulted in the accreditation of numerous gTLD registrars, each of which is required to maintain its own Whois database.[\[356\]](#) This distributed Whois system has proven less functional for intellectual property consumers and rightsholders. Critically, there is no single site from which all registrars' Whois data can be comprehensively searched for more than just the exact domain name. It is notable, however, that one service at Uwhois.com enables searches using multiple search terms across significant numbers, if not all, gTLDs and ccTLDs.[\[357\]](#)

334. One commentator to the Second WIPO Process noted that, as a result of the introduction of competition among gTLD registrars and the resulting decentralization of responsibility for Whois services, "public access to gTLD Whois data is more fragmented, less consistent and less robust today than it was when the Final Report of the first WIPO Process was issued."[\[358\]](#) One Internet Service Provider expressed its concern at the deterioration in Whois functionality, due to commercial factors and to privacy concerns, that has led to a decline in cooperation and the quality of information provided by various Whois lookup services. It was noted that this could impair the ability of the Internet service providers themselves to assist in preventing infringements of intellectual property rights and cooperation with law enforcement officials on other legal issues.[\[359\]](#) In this circumstance, the ICANN Registrar Accreditation Agreement foresees the development of a centralized Whois database to ensure comprehensive searches capability, as follows:

"Registrar shall abide by any ICANN-adopted Policy that requires registrars to cooperatively implement a distributed capability that provides query-based Whois search functionality across all registrars. If the Whois service implemented by registrars does not in a reasonable time provide reasonably robust, reliable, and convenient access to accurate and up-to-date data, the Registrar shall abide by any ICANN-adopted Policy requiring Registrar, if reasonably determined by ICANN to be necessary (considering such possibilities as remedial action by specific registrars), to supply data from Registrar's database to facilitate the development of a centralized Whois database for the purpose of providing comprehensive Registrar Whois search capability."[\[360\]](#)

335. It is recommended that comprehensive Whois search facilities should be enabled, and that a centralized

Whois database be developed to provide these search facilities across data from all accredited registrars.

336. It is also proposed that Whois facilities should enable comprehensive searches across all registrars' databases using search terms other than the exact domain name. It is not currently possible for a user to conduct a comprehensive search by name of registrant, for example, and thereby to ascertain a pattern of abusive bad faith registrations. Commentators to the WIPO Processes have identified the ability to search on the basis of Whois data elements other than domain names as a key functionality, and an essential tool for investigation and for resolving cases of cybersquatting, piracy and other rights violations. It is noted that enhanced searchability is already a requirement of ICANN's Registrar Accreditation Agreement, and should be enforced.^[361] Further, not all registrars' Whois sites have comparable facilities. Only VeriSign Global Registry Services (Verisign GRS), for example, allows a user to search by exact domain name, domain name owner, contact name owner, handle and IP address. It is also notable that VeriSign GRS have committed a portion of their US\$200 million research and development fund to address the technical challenges of a 'Universal Whois'.^[362] Commentators have also identified a need for enhanced oversight of the Whois databases.^[363] In its comment to the Second WIPO Process, the International Trademark Association (INTA) requested that WIPO study and evaluate the potential for improvement of the Whois database, and develop a set of best practices for those operating Whois databases.^[364]

337. It is recommended that centralized comprehensive Whois search facilities be developed that enable searches across all available registrar databases on the basis of search criteria in addition to the exact domain name.

WHOIS SEARCH FACILITIES ACROSS ccTLDs

338. The demand for development of robust Whois search facilities at the gTLD level is felt also at the ccTLD level, where registration activity and, hence, focus is heightening. Each ccTLD administration authority currently maintains its own Whois database and within each ccTLD there may be multiple Whois databases that correspond to second-level domains that are separately administered. To add to the complexity, Whois databases are currently inaccessible in numerous ccTLDs that have closed off, or propose to close off, access to their Whois service.^[365] Commentators have suggested that administrators of ccTLDs should also be encouraged to adopt policies for the collection, verification and public availability of contact details of registrants.^[366]

339. The *WIPO ccTLD Best Practices for the Prevention and Resolution of Intellectual*

Property Disputes identify minimum standards for the collection and availability of contact details, largely in line with requirements at a gTLD level, but subject to the application of mandatory local privacy laws. [367] These guidelines were produced in response to a request from WIPO's Member States to develop a cooperation program for the administrators of ccTLDs, designed to advise them on intellectual property protection in their domains, including dispute prevention and resolution. Developed through a public consultation process, the ccTLD Best Practices recommend that the following terms and conditions be included in any domain name registration agreement:

- A representation on the part of the registrant that the information provided by the registrant at the time of the initial registration of the domain name, in particular the registrant contact details, are true and accurate, as well as an agreement that such contact details will be kept updated by the registrant in order to ensure that they remain true and accurate throughout the period during which the domain name is registered.
- A provision stipulating that the provision of inaccurate or unreliable registrant contact details, or the registrant's failure to keep such contact details up to date, constitutes a material breach of the registration agreement and a basis for the cancellation of the domain name registration by the ccTLD administrator.
- An agreement on the part of the registrant that all registrant contact details will be made publicly available in real time through a Whois or similar service, subject to any contrary mandatory provisions of applicable privacy regulations.
- A clear notice on the part of the ccTLD administrator of the purposes of the collection and public availability of registrant contact details.

The WIPO ccTLD Best Practices received support from many commentators to the Second WIPO Process, as a concrete step forward in ensuring accurate and up-to-date Whois data at the ccTLD level. [368]

340. It is recommended that administrators of ccTLDs be encouraged to adopt policies for the collection, verification and public availability of Whois data via online databases, that are uniform, to the greatest extent possible, with the Whois system at a gTLD level.

PRIVACY IMPLICATIONS OF EXTENDED WHOIS SERVICES

341. At the same time as commentators to the Second WIPO Process favored robust Whois search facilities, most acknowledged that provision and availability of registrant data must take into account the protection of personal freedoms and privacy established by data protection rules and applicable legislation. [369] Commentators to the first WIPO Process had also expressed their concern at the possible erosion of personal liberties through the continued public availability of contact details of domain name holders.[370] It is evident that

a balance needs to be struck between the need to enforce the current contractual requirement of domain name owners to provide contact information for many valid purposes, and the need to protect the privacy of individuals from unwarranted intrusion. As remarked by one commentator, “no country has enacted a law making privacy of registrant contact data an absolute value that necessarily prevails over countervailing considerations of consent, contract or public interest.” [\[371\]](#)

342. The proposal of a comprehensive Whois search facility raised serious concerns relating to privacy protection among numerous commentators in different jurisdictions.[\[372\]](#) The American Civil Liberties Union (ACLU), for example, opposed the expansion of the Whois database functionality, and any standardization of Whois database operations, as constituting a threat to the privacy of users. [\[373\]](#) The European Commission expressed concerns that a comprehensive search facility could turn registrars’ databases and online search facilities into tools for policing the Internet, jeopardizing individuals’ control over the use of their personal data and compromising their freedom of speech.[\[374\]](#) The European Commission stated that, in accordance with EU data privacy standards,[\[375\]](#) the right to privacy is a fundamental right, that cannot be waived by consumer protection or law enforcement interests. Further, it was stated that the disclosure of each personal detail must be evaluated in respect of the purpose for which it was proposed to be disclosed, that secondary uses must be prohibited, filters used to limit database access, and that the search criterion should continue to be limited to the exact domain name. It was discussed that the publication of personal registration data is still the cause of complaints filed with the European Parliament and Commission.

343. There exist numerous mechanisms that can be implemented to minimize the risk of violation of personal privacy, in the context of Whois search facilities. These include filtered access to databases, limiting availability of reverse look-ups to trusted third parties,[\[376\]](#) allowing post office boxes or details of trusted third parties as valid addresses, and implementing ‘unlisted’ Whois services maintained by registrars for a fee. [\[377\]](#) In addition, some commentators support the imposition of severe penalties, both civil and criminal, by national governments as well as by registration authorities on those who misuse publicly available Whois information.[\[378\]](#) It is noted that the ICANN Accreditation Agreement provides that a registrar or third party can list its own contact details in lieu of an anonymous registrant, provided that it accepts liability for any harm caused by wrongful use, unless it promptly discloses the identity of the true holder upon reasonable evidence of actionable harm. In this way, bona fide registrants can remain anonymous and intellectual property rightsholders are able to identify infringing registrants.

344. Numerous programs have been established to develop online guidelines and principles for data protection.[\[379\]](#) The Report of the first WIPO Process recommended that domain name registrants’ contact details should be collected and made available for limited purposes, and that registrants should be clearly notified in their registration agreement of the purposes of the collection and their informed consent obtained for the public availability of contact details. It was also recommended that registrars should adopt reasonable measures to prevent predatory use of data beyond the stated purposes in the registration agreement, such as mining of a database for domain name holders’ contact details for use in advertising and sales. These recommendations are here repeated.

345. At the same time, it is acknowledged that the majority of commentators representing intellectual property rightsholders remain strongly opposed to any restrictions upon the availability of data, and firmly opposed filtered access to data designed to protect users’ privacy, arguing that filters would impose an administrative burden on registration authorities without any real gains in privacy protection. Concerns about privacy implications of the Whois system have focused on the possibility of misuse of such information, including by the registration authorities whose duty it is to collect and maintain it. In addressing this concern, it appears that a distinction can be drawn between privacy implications of individual queries and access to the Whois, and concerns regarding bulk access and transfer of mass data to compilers and resellers of registration information.[\[380\]](#) It is necessary to find a balance

between personal privacy, users' rights, commercial competition and functional DNS management requirements. It is proposed that users' privacy and security should be protected and registrants should be clearly informed of what data will be collected, the purposes for which it is collected, and the uses to which it may be put. In each case, users should be required to give informed consent to the collection, storage and use of personal data within these parameters. Within each national territory, different cultural perspectives are found and varying legal standards apply under the relevant data protection laws. [381] It is noted that most national laws designed to protect privacy do not restrict the making available of contact data pursuant to contractual agreement, or on the basis of a competing public interest of higher priority, such as consumer protection or law enforcement. [382]

DIRECTORY AND GATEWAY SERVICES

346. Throughout the WIPO Processes, commentators have noted the importance of technical mechanisms for preventing and resolving conflicts in the DNS. [383] The necessity for considering such mechanisms arises from the fact that a domain name is a unique technical address, whereas the exclusivity of trademarks is limited by reference to territory and to the class of goods or services with respect to which it is used. [384] The consequence of the qualifications on the exclusivity of the trademarks is that the same or similar mark may be owned by different persons in different jurisdictions throughout the world, and the same or similar mark may be owned by different persons with respect to different classes of goods. Domain names do not have the same capacity for promiscuity. However, many different domain names can share a common feature, such as a generic word like "federal", "united", or "rajah." This capacity to share a common feature can cause confusion, especially as the number of gTLDs increases. Directory and listing services provide the possibility for similar names to be listed on a common portal or gateway page so as to give the user a convenient means of locating which of the similar domain names he or she wishes to find. One example of such a service is offered by INternet One, which offers directory services for companies, trademarks and business names. [385]

347. Directory and listing services are supported by many as a useful means to reduce tension between numerous legitimate users of the same sign. [386] One commentator suggested that such a service could be offered by the registry or a neutral third party, following an objection by one legitimate user of a sign to its registration by another legitimate user. It was suggested that such directory services would be appropriate for use with names that, by their nature, may not be able to be used exclusively by a single entity, for example, for geographical indications, where a directory service could be run by the public authority with competence to administer the geographic region. [387]

348. The Report of the first WIPO Process stated that these measures were optional and offered parties a good solution to settling a conflict, at the same time noting considerable resistance by commentators to their mandatory application. For this reason, the Report recommended that the use of portals, gateways, or similar measures should be encouraged, but should not be compulsory. The same resistance to any compulsory measures for coexistence is noted by commentators to the Second WIPO Process, [388] while the same benefits remain for those who choose to avail themselves of these developing technical measures.

[Annexes follow]

Footnotes:

- [1] The Request was contained in a letter from the Minister for Communications, Information Technology and the Arts of the Government of Australia transmitted with the endorsement of Argentina, Australia, Canada, Denmark, France, United States of America and the European Union. A copy of the letter is available at <http://wipo2.wipo.int/process2/rfc/letter.html>.
- [2] See WIPO documents WIPO/GA/26/3 and WIPO/GA/26/10, paragraph 26.
- [3] See http://www.ntia.doc.gov/ntiahome/domainname/6_5_98dns.htm.
- [4] See WIPO documents A/33/4 and A/33/8.
- [5] The Report is available at <http://wipo2.wipo.int/process1/report/finalreport.html> or, in bound paper form, upon request from WIPO.
- [6] A statistical analysis of the cases filed with the WIPO Arbitration and Mediation Center under the UDRP is available on Center's web site at <http://www.arbiter.wipo.int/domains/statistics/index.html>.
- [7] As amended through July 16, 2000; see <http://www.icann.org/general/bylaws.htm>.
- [8] See <http://www.icann.org/general/articles.html>.
- [9] See <http://www.dnso.org/dnso/notes/2001/02.NCbusinessplan.html>.
- [10] The request is available at <http://wipo2.wipo.int/process2/rfc/letter1.html>.
- [11] See WIPO documents WIPO/GA/26/3 and WIPO/GA/26/10, paragraph 26.
- [12] Available at <http://ecommerce.wipo.int/domains/cctlds/bestpractices/index.html>, or in bound paper form, upon request, from WIPO.
- [13] See the IETF IDN Working Group Web Site at <http://www.i-d-n.net>.
- [14] See <http://www.verisign-grs.com/idn/index.html>.
- [15] See http://www.verisign-grs.com/idn/Gen_Info_Paper.pdf.
- [16] See <http://www.icann.org/minutes/minutes-25sep00.htm>.
- [17] See <http://www.icann.org/committees/idn/>.
- [18] See [http://www.icann.org/minutes/prelim-report-16nov00.htm#Second Annual Meeting](http://www.icann.org/minutes/prelim-report-16nov00.htm#Second%20Annual%20Meeting).
- [19] See ICANN, "New TLD Program" at <http://www.icann.org/tlds/>.
- [20] *Ibid.*

- [21] See <http://www.afilias.info>.
- [22] See <http://www.neulevel.biz>.
- [23] For detailed information, see <http://arbitrator.wipo.int/domains/gtld/newgtld.html>.
- [24] See WIPO, *The Management of Internet Names and Addresses: Intellectual Property Issues*, Chapter 5, <http://wipo2.wipo.int/process1/report/finalreport.html>.
- [25] *Ibid*, paragraph 343.
- [26] See, for details, <http://www.afilias.info/faq/sunrise.html> and <http://www.afilias.info/faq/sunrise-challenge-policy.html>.
- [27] See <http://www.icann.org/announcements/icann-pr14aug01.htm>.
- [28] See RFC 2826 "IAB Technical Comment on the Unique DNS Root," <http://www.rfc-editor.org/rfc/rfc2826.txt>.
- [29] See <http://www.icann.org/stockholm/unique-root-draft.htm>.
- [30] See <http://www.icann.org/icp/icp-3.htm>.
- [31] For example, new.net which operates 20 gTLDs outside the ICANN system applies a Model Domain Name Dispute Policy which largely corresponds to the UDRP.
- [32] See <http://www.commonname.com>.
- [33] See <http://home.netscape.com/escapes/keywords/faq.html>.
- [34] See http://web.realnames.com/Virtual.asp?page=Eng_Corporate_Product_Faq.
- [35] See <http://www.commonname.com/English/master.asp?asp=/English/LegalDocs/CommonNameDisputeResolutionPolicy.html> and http://web.realnames.com/Virtual.asp?page=Eng_Policy_DisputeResolution.
- [36] See <http://wipo2.wipo.int/process2/rfc/rfc3/index.html>.
- [37] See <http://wipo2.wipo.int/process2/rfc/letter2.html>.
- [38] See Nielsen/Net Ratings' Global Internet Trends Report, released August 28, 2001, at http://www.nielsen-netratings.com/hot_of_the_net_i.htm.
- [39] See Report of the International Telecommunication Union (ITU), *Challenges to the Network: Internet for Development (1999)* available at <http://www.itu.int/itu-d/ict/publications/inet/1999/index.html>.
- [40] See <http://www.nic.uk/ref/drs.html>.
- [41] Of all cases filed with the WIPO Arbitration and Mediation Center that concern more

than one domain name, over 50% cover two or more different top-level domains.

[42] Anticybersquatting Consumer Protection Act, see <http://www.gigalaw.com/library/anticybersquattingact-1999-11-29-p1.html>.

[43] See <http://www2.europarl.eu.int/omk/OM-Europarl?PROG=REPORT&L=EN&PUBREF=-//EP//TEXT+REPORT+A5-2001-0226+0+NOT+SGML+V0//EN&LEVEL=2>.

[44] See <http://www.lachambre.be/documents/1069/1.pdf>.

[45] See <http://www.interlex.it/nomiadom/testo.htm>.

[46] Google search engine lists more than 46 million health-related sites, and Yahoo! Shopping offers more than 50,000 listings for sales and purchase of health products. The proposal submitted by the World Health Organization (WHO) for a .health gTLD noted the existence of more than 10,000 health-related sites.

[47] WIPO, *The Management of Internet Names and Addresses: Intellectual Property Issues* (April 30, 1999) at paras. 295-303.

[48] See “The use of common stems in the selection of International Nonproprietary Names (INN) for pharmaceutical substances,” April 2000, Programme on International Nonproprietary Names, Quality Assurance and Safety: Medicines, Essential Drugs and Medicines Policy, WHO, Geneva (WHO/EDM/QSM/99.6). See also Daniel L. Boring “The Regulation and Development of Proprietary Names for Pharmaceuticals in the United States” *Trademark World* (November/ December, 1997) at 40.

[49] The WHO publishes bi-annual lists of Proposed and Recommended INNs that are taken into the Cumulative List every seven years. The Cumulative List is disseminated by WHO in electronic form in seven official languages: Arabic, Chinese, English, French, Latin, Russian and Spanish. See Comment of World Health Organization (RFC-3 – June 7, 2001), Comment of European Federation of Pharmaceutical Industries and Associations (EFPIA) (RFC-3 – June 5, 2001).

[50] *Basic Documents*, 39th edition, Geneva, World Health Organization, 1992. See also “Guidelines on the Use of International Nonproprietary Names (INNs) for Pharmaceutical Substances,” 1997, Report of the Programme on International Nonproprietary Names (INN), Division of Drug Management & Policies, WHO, Geneva (WHO/PHARM S/NOM 1570).

[51] Annex III sets out the World Health Assembly resolutions pursuant to which the INN system was established. Usually, an INN consists of a randomly chosen prefix and a common ‘stem’: substances belonging to a group of pharmacologically related substances denote this relationship by using a common stem or suffix. For a description of the use of stems and a list of common stems in the INNs system, see “Guidelines on the Use of International Nonproprietary Names (INNs) for Pharmaceutical Substances”, 1997, Report of the Programme on International Nonproprietary Names (INN), Division of Drug Management & Policies, WHO, Geneva (WHO/PHARM S/NOM 1570) at Section 3 and Annex 3.

[52] See Comment of World Health Organization (WHO) (RFC-3 – June 7, 2001).

[53] See Comment of World Health Organization (WHO) (RFC-3 – June 7, 2001).

[54] See Comment of Asociación Interamericana de la Propiedad Industrial (RFC-2 –

December 26, 2000).

[55] For example: “amoxicillin.com” resolves to a web page offering a basic description of the drug and its applications, as well as two advertisements linking to pharmaceutical companies offering commercial services; phentermine.com resolves to a web page offering an entire lifestyle option for those interested in the diet-related drug.

[56] See Comment of World Health Organization (WHO) (RFC-3 – June 7, 2001).

[57] One commentator stated that, to its knowledge, there was no reported case of a domain name containing an INN that had threatened patient safety. See Comment of Anakena.com (RFC-2 – December 28, 2000). See also Comment of United States of America, Office of Advocacy, U.S. Small Business Administration (RFC-3 – June 15, 2001), Comment of International Association for the Protection of Industrial Property (AIPPI) (RFC-3 – June 18, 2001), Comment of NIC Chile (RFC-3 – May 10, 2001), Comment of Anakena.com (RFC-3 – June 15, 2001), Comment of Nominet UK (RFC-3 – June 14, 2001), Comment of Pharma Consulting International (RFC-3 – June 14, 2001).

[58] See Comment of Canada (RFC-3 – July 5, 2001), Comment of Hungary, Hungarian Patent Office (RFC-3 – June 13, 2001), Comment of Japan, Ministry of Economy, Trade and Industry (METI) (RFC-3 – July 5, 2001), Comment of Mexico, Mexican Institute of Industrial Property (IMPI) (RFC-3 – June 5, 2001), Comment of Mexico, National Institute of Copyright (RFC-3 – May 30, 2001), Comment of Switzerland, Swiss Federal Institute of Intellectual Property (RFC-3 – June 15, 2001), Comment of European Commission (RFC-3 – June 25, 2001), Comment of World Health Organization (WHO) (RFC-3 – June 7, 2001), Comment of Brazilian Association of Intellectual Property (ABPI) (RFC-3 – June 8, 2001), Comment of European Brands Association (AIM) (RFC-3 – May 16, 2001), Comment of European Federation of Pharmaceutical Industries and Associations (EFPIA) (RFC-3 – June 5, 2001), Comment of Law and Technology Committee, Auckland District Law Society (RFC-3 – June 22, 2001), Comment of UAEnic (RFC-3 – June 6, 2001), Comment of Martin Cibula (RFC-3 – June 15, 2001).

[59] See Comment of Anakena.com (RFC-3 – June 15, 2001), Comment of Elizaburu (Luis H. De Larramendi) (RFC-3 – June 14, 2001), Comment of Michael Froomkin (RFC-3 – June 4, 2001), Comment of Jesper Juhl (RFC-3 – June 14, 2001), Comment of Christian Mogensen (RFC-3 – April 16, 2001), Comment of Muirinn Ruadh (RFC-3 – May 1, 2001). See also Comment of International Trademark Association (INTA) (RFC-2 – January 4, 2001).

[60] See Comment of Daniel R. Tobias (RFC-3 – April 15, 2001), Comment of World Intellectual Piracy Organization (RFC-3 – June 15, 2001).

[61] See Comment of United States of America, Office of Advocacy, U.S. Small Business Administration (RFC-3 – June 15, 2001), Comment of International Association for the Protection of Industrial Property (AIPPI) (RFC-3 – June 18, 2001), Comment of NIC Chile (RFC-3 – May 10, 2001), Comment of Anakena.com (RFC-3 – June 15, 2001), Comment of Nominet UK (RFC-3 – June 14, 2001), Comment of Pharma Consulting International (RFC-3 – June 14, 2001).

[62] It was noted that INNs may be registered as domain names by pharmaceutical companies or individuals related to the healthcare industry and used in good faith to provide information to users (e.g. tamoxifencitrate.com – registered by Barr Laboratires to provide information about a generic medication used in breast cancer treatment). See Comment of Anakena.com (RFC-3 – June 15, 2001), Comment of Pharma Consulting International (RFC-3 – June 14, 2001).

[63] See Comment of Hungary, Hungarian Patent Office (RFC-3 – June 13, 2001), Comment of European Federation of Pharmaceutical Industries and Associations (EFPIA) (RFC-3 – June 5, 2001), Comment of Law and Technology Committee, Auckland District Law Society (RFC-3 – June 22, 2001). See also Comment of World Health Organization (WHO) (RFC-2 – December 21, 2000).

[64] See Comment of Mexico, Mexican Institute of Industrial Property (IMPI) (RFC-3 – June 5, 2001). One commentator added that, in this event, some means of protection would be needed to ensure that other intellectual property rights were not violated in the use of the manufacturers' names. See Comment of European Commission (RFC-3 – June 25, 2001).

[65] See Comment of Pharma Consulting International (RFC-3 – June 14, 2001), Comment of Anakena.com (RFC-2 – December 28, 2000).

[66] See Comment of European Federation of Pharmaceutical Industries and Associations (EFPIA) (RFC-3 – June 5, 2001), Comment of International Association for the Protection of Industrial Property (AIPPI) (RFC-3 – June 18, 2001).

[67] See Comment of World Health Organization (WHO) (RFC-3 – June 7, 2001).

[68] See Comment of Mexico, Mexican Institute of Industrial Property (IMPI) (RFC-3 – June 5, 2001).

[69] See Comment of European Commission (RFC-3 – June 25, 2001).

[70] Uniform Domain Name Dispute Resolution Policy, Paragraph 4(a)(i).

[71] See Comment of World Health Organization (WHO) (RFC-3 – June 7, 2001).

[72] See Comment of Mexico, Mexican Institute of Industrial Property (IMPI) (RFC-3 – June 5, 2001).

[73] See Comment of European Federation of Pharmaceutical Industries and Associations (EFPIA) (RFC-3 – June 5, 2001), Comment of Pharma Consulting International (RFC-3 – June 14, 2001).

[74] See Comment of Nominet UK (RFC-3 – June 14, 2001), Comment of Michael Fromkin (RFC-3 – June 4, 2001), Comment of Daniel R. Tobias (RFC-3 – April 15, 2001).

[75] One commentator, for example, referred to the global availability and use of INNs to suggest that protection should not be limited to the list of INNs maintained by WHO, but should extend to cover translations of the names identifying each pharmaceutical substance or ingredient, to ensure global consumer protection – for example, the Portuguese translation of 'ampicillin', 'ampicilina', is not included on the WHO list and, if misused in the DNS, could result in harm to Portuguese patients unless it too is protected from registration. See Comment of Brazilian Intellectual Property Association (ABPI) (RFC-1 – September 15, 2000).

[76] See Comment of Mexico, Mexican Institute of Industrial Property (IMPI) (RFC-3 – June 5, 2001), Comment of Elizaburu (Luis H. De Larramendi) (RFC-3 – June 14, 2001), Comment of UAEnic (RFC-3 – June 6, 2001).

[77] See Comment of United States of America, Office of Advocacy, U.S. Small Business Administration (RFC-3 – June 15, 2001).

[78] See Comment of Anakena.com (RFC-3 – June 15, 2001), Comment of Japan Network Information Centre (JPNIC) (RFC-3 – June 8, 2001), Comment of Nominet UK (RFC-3 – June 14, 2001), Comment of Pharma Consulting International (RFC-3 – June 14, 2001).

[79] See Comment of European Federation of Pharmaceutical Industries and Associations (EFPIA) (RFC-3 – June 5, 2001), Comment of Law and Technology Committee, Auckland District Law Society (RFC-3 – June 22, 2001), Comment of UAEnic (RFC-3 – June 6, 2001).

[80] See Comment of Hungary, Hungarian Patent Office (RFC-3 – June 13, 2001).

[81] See Comment of Japan, Ministry of Economy, Trade and Industry (METI) (RFC-3 – July 5, 2001), Comment of World Health Organization (WHO) (RFC-3 – June 7, 2001), Comment of American Intellectual Property Law Association (AIPLA) (RFC-3 – June 7, 2001), Comment of European Federation of Pharmaceutical Industries and Associations (EFPIA) (RFC-3 – June 5, 2001), Comment of Law and Technology Committee, Auckland District Law Society (RFC-3 – June 22, 2001).

[82] See Comment of Japan, Ministry of Economy, Trade and Industry (METI) (RFC-3 – July 5, 2001), See Comment of World Health Organization (WHO) (RFC-3 – June 7, 2001), Comment of American Intellectual Property Law Association (AIPLA) (RFC-3 – June 7, 2001), Comment of European Federation of Pharmaceutical Industries and Associations (EFPIA) (RFC-3 – June 5, 2001), Comment of Law and Technology Committee, Auckland District Law Society (RFC-3 – June 22, 2001).

[83] See Comments of World Health Organization (WHO) (RFC-3 – June 7, 2001) and (RFC-2 – December 21, 2000).

[84] See Comment of Hungary, Hungarian Patent Office (RFC-3 – June 13, 2001), Comment of Japan, Ministry of Economy, Trade and Industry (METI) (RFC-3 – July 5, 2001), Republic of Korea, Korean Intellectual Property Office (KIPO) (RFC-3 – June 7, 2001), Comment of Switzerland, Swiss Federal Institute of Intellectual Property (RFC-3 – June 15, 2001), Comment of European Commission (RFC-3 – June 25, 2001), Comment of World Health Organization (WHO) (RFC-3 – June 7, 2001), Comment of International Chamber of Commerce (ICC) (RFC-3 – June 18, 2001), Comment of Martin Cibula (RFC-3 – June 15, 2001). See also Comment of the European Commission (RFC-2 – January 16, 2001), Comment of Asociación Interamericana de la Propiedad Industrial (RFC-2 – December 26, 2000). One commentator noted that “[i]n contrast to personal names, these are names that should be protected to the greatest extent possible, since confusion could cause immense damage. These names should be incorporated into a register and completely excluded from all TLDs and ccTLDs.” See Comment of MARQUES, Association of European Trade Mark Owners (RFC-2 – December 22, 2000).

[85] See Comment of European Federation of Pharmaceutical Industries Associations (EFPIA) (RFC-2 – December 15, 2000), Comment of European Brands Association (AIM) (RFC-2 – December 20, 2000).

[86] The Austrian Patent Office, for example, examines trademark applications and, where a trademark is identical with a recommended INN on the basis of descriptiveness, registration is refused. Where the conflict is with a proposed INN, the application is accepted, but the applicant is informed of a potential future conflict. The lists of proposed and recommended INNs are constantly updated in the database of the Austrian Patent Office. The Canadian Intellectual Property Office examines trademarks and refuses those that conflict with INNs on the basis of descriptiveness and deceptive misdescriptiveness. The French INPI examines trademark applications manually using a directory, and refuses those that conflict with INNs on the basis of descriptiveness. The Japanese Patent Office

examines trademark applications using an automated system, and applications are refused on the basis of descriptiveness, if a mark is identical or closely similar to an INN. The Swiss Office examines trademark applications manually using a directory and refuses only those applications where a mark is identical with a recommended INN. The UK Office examines trademark applications using an automated system and applications are refused on the basis of descriptiveness, if a mark is identical or closely similar with a recommended INN.

[87] See <http://mednet.who.int>.

[88] Currently, the MEDNET is available only to WHO 'INN partners', with authorization given through an automated administration process, that ensures privacy using password and authentication systems. However, it is envisaged that different layers of access will be provided in future to authorized users.

[89] See Comment of United States of America, Office of Advocacy, U.S. Small Business Administration (RFC-3 – June 15, 2001). The opposition to an exclusion mechanism was confirmed by numerous other commentators: see Comment of Japan Network Information Centre (JPNIC) (RFC-3 – June 8, 2001), Comment of Pharma Consulting International (RFC-3 – June 14, 2001), Comment of Luis de Barros (RFC-3- June 14, 2001), Comment of Chris Brand (RFC-3 – April 16, 2001), Comment of Michael Froomkin (RFC-3 – June 4, 2001), Comment of Jason Presley (RFC-3 – April 18, 2001), Comment of George Reese (RFC-3 – April 15, 2001).

[90] It was noted that scientific, regulatory, and consumer communities use the generic names to discuss pharmaceuticals' benefits, side effects, testing and regulatory review and progress. (e.g., consumers understand that NutraSweet® is a trademark but 'aspartame' is open for all use). See Comment of Association for Computing Machinery's Internet Governance Project, Electronic Privacy Information Center (RFC-3 – June 15, 2001).

[91] See Comment of International Trademark Association (INTA) (RFC-3 – May 24, 2001), Comment of Nominet UK (RFC-3 – June 14, 2001), Comment of Pharma Consulting International (RFC-3 – June 14, 2001). See also Comment of Fédération internationale des conseils en propriété industrielle (FICPI) (RFC-2 – December 29, 2000), Comment of United States Council for International Business (USCIB) (RFC-2 – December 29, 2000), Comment of Verizon Communications (RFC-2 – December 26, 2000).

[92] The case of *Boehringer Ingelheim Corporation v. Kumar Bhatt*, involved the domain names <micardis.com>, <telmisartan.com> and <meloxicam.com>, of which the first reflects a registered trademark of the Complainant pharmaceutical company, and the latter are recommended INNs used by the Complainant to market pharmaceutical products in which they are active ingredients. The Administrative Panel transferred all three names to the Complainant on the basis of its status as trademark owner, as well as patentee and exclusive licensee of products marketed under the INNs. The Respondent, a physician and Internet consultant, argued that his registration of the names was to assist patients and the general public by providing centralized reference sites for medical information, and that 'telmisartan' and 'meloxicam' were generic terms in the public domain. Telmisartan is an active ingredient under the Micardis trademark, and meloxicam is an active ingredient under the Mobic trademark, also registered by the Complainant. Meloxicam is INN Request No. 5615; WHO recommended INN published April 1987. The Administrative Panel accepted the Complainant's argument that the domain names reflecting the INNs were identical or confusingly similar to product identification marketed under its trademarks, and that the registration of these names prevented consumers from finding information from the only source of the products. See National Arbitration Forum, *Claim Number FA0006000095011*, (August 11, 2000).

[93] See Comment of Mexico, Mexican Institute of Industrial Property (IMPI) (RFC-3 – June 5, 2001).

[94] The Convention on the Privileges and Immunities of the United Nations (adopted by the General Assembly of the United Nations on 13 February 1946) and the Convention on the Privileges and Immunities of the Specialized Agencies (adopted by resolution of the General Assembly on 21 November 1947) provide for the special legal status of these international intergovernmental organizations. They provide that such entities shall have the capacity to, *inter alia*, institute legal proceedings (Article I and Article II respectively) but shall enjoy immunity from every form of legal process, except insofar as the organization expressly waives such immunity (Article II and Article III respectively).

[95] See Comment of Fédération internationale des conseils en propriété industrielle (FICPI) (RFC-3 – June 14, 2001).

[96] See Comment of World Health Organization (WHO) (RFC-3 – June 7, 2001). An alternative remedy that was favored by some commentators was the transfer of any domain name replicating an INN to WHO, while costs of registration maintenance could be minimized by agreement between the registrars and ICANN. One commentator also suggested that WHO could maintain informational sites at the INN domains; see Comment of Christian Mogensen (RFC-3 – April 16, 2001).

[97] The terms “abbreviation” and “acronym” are used interchangeably in this Chapter. An acronym is defined as “a word formed from the initial letters of other words,” such as “WIPO” for the World Intellectual Property Organization. See Concise Oxford Dictionary (10th ed. 1999). An “abbreviation,” the term used in Article 6*ter* of the Paris Convention, is a more inclusive term, which can refer to an acronym or any other means of abridging a word or series of words, such as “int” for international.

[98] 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. See Stephen P. Ladas, *Patents, Trademarks, and Related Rights: National and International Protection*, vol. II, at 1244 (1975); Prof. J.H.C. Bodenhausen, *Guide to the Application of the Paris Convention for the Protection of Industrial Property*, Article 6*ter*, paragraphs (1) and (2), at 97-98 (BIRPI, 1969).

[99] See Stephen P. Ladas, *Patents, Trademarks, and Related Rights: National and International Protection*, vol. II, at 1244 (1975).

[100] Article 16 of the Trademark Law Treaty (TLT) provides: “Any contracting party shall register service marks and apply to such marks the provisions of the Paris Convention which concern trademarks.”

[101] Article 6*ter* (3)(b). Each State is obligated under Article 6*ter* (1)(3)(a) to “make available to the public the lists so communicated” by WIPO. Any State receiving the communication of a name, emblem or other official sign of an IGO may, within a period of 12 months from the receipt of that communication, transmit its objections, if any, through the intermediary of the International Bureau of WIPO, to the IGO at the request of which the communication was made. (Article 6*ter* (4)).

[102] Article 6*ter* (3)(b) provides:

“The provisions of subparagraph (b) of paragraph (1) of this Article *shall apply only* to such ... abbreviations, and names of international intergovernmental organizations as the

latter have communicated to the countries of the Union through the intermediary of the International Bureau.” (Italics added).

See Bodenhausen, *Guide to the Application of the Paris Convention*, Article 6ter, paragraphs (3) and (4), at 100 (“As has already been observed, the protection of emblems, names and abbreviations of *intergovernmental organizations* is *dependent upon their communication*.”). (Italics in original).

[103] WIPO maintains a list of approximately 1150 signs (consisting of armorial bearings, flags, names, abbreviations and other emblems) that have been communicated by States and IGOs, which have, in turn, been notified to the States party to the Paris Convention.

[104] See “Report Adopted by the Assembly,” International Union for the Protection of Industrial Property (Paris Union), Nineteenth Session (9th Extraordinary), document P/A/XIX/4, paras. 20-25 (September 29, 1992).

[105] *Id.*, para. 24.B.

[106] *Id.*

[107] By implication, Article 6ter (1)(a) refers to “use, without authorization by the competent authorities.”

[108] Article 6ter (1)(b).

[109] The European Patent Office noted that the national legal provisions enacting Article 6ter of the Paris Convention “are sometimes highly divergent in the scope of protection.” See Comment of European Patent Office (EPO) (RFC-2 – December 28, 2000).

[110] TRIPS Agreement, Article 63 (2).

[111] WIPO-WTO Agreement, Article 3.

[112] Paris Convention, Article 6ter (1)(a).

[113] Paris Convention, Article 6ter (1)(c).

[114] See Comment of Asociación Interamericana de la Propiedad Industrial (ASIP) (RFC-2 - December 26, 2000).

[115] See J. Postel, Request for Comments (RFC) 1591, Network Working Group (March 1994). The six other generic domains are .com, .net, .org, which are unrestricted domains, and .edu, .gov and .mil, which restrict registrations to certain entities, as with .int.

[116] See “The .int Domain: Current Registration Policies,” at <http://www.iana.org/int-dom/int.htm> (page last updated April 16, 2000).

[117] The IANA site further indicates that “discussions are underway with a number of organizations regarding the future of the .int domain, including a plan of the International Telecommunications Union (ITU) to assume management of the .int domain. *Id.*, referencing the ITU’s plan to assume management of the .int domain, at <http://www.itu.int/net/int>.

[118] See Comment of Alexander Svensson (RFC-2 - December 21, 2000). See also

Comment of Matthias Haeuptli (RFC-1 – September 15, 2000), Comment of J.R. Stogrin (RFC-1 – September 14, 2000), Comment of Christopher Zaborsky (RFC-1 – August 11, 2000).

[119] See Comment of Hungary, Hungarian Patent Office (RFC-3 – June 13, 2001), Comment of Mexico, Mexican Institute of Industrial Property (IMPI) (RFC-3 – June 5, 2001), Comment of International Civil Aviation Organization (ICAO) (RFC-3 – June 12, 2001), Comment of United Nations, Office of Legal Affairs, (RFC-3 – June 15, 2001), Comment of Brazilian Association of Intellectual Property (ABPI) (RFC-3 – June 8, 2001), Comment of International Association for the Protection of Industrial Property (AIPPI) (RFC-3 – June 18, 2001), Comment of Law and Technology Committee, Auckland District Law Society (RFC-3 – June 22, 2001).

[120] IGOs registering in .org include the United Nations Organization, Food and Agriculture Organization, International Civil Aviation Organization, International Maritime Organization, United Nations Economic Social and Cultural Organization, United Nations Development Programme and World Trade Organization. The United Nations High Commissioner for Refugees is registered under the ccTLD for Switzerland, .ch. See also Comment of the International Fund for Agricultural Development (IFAD) (RFC-2 – January 4, 2000), suggesting that IGOs change their domain name registrations from the .org top-level domain to .int, in order to take advantage of this restricted and protected domain space.

[121] See Comment of United States of America, Office of Advocacy, U.S. Small Business Administration (RFC-3 – June 15, 2001), Comment of European Commission (RFC-3 – June 25, 2001), Comment of International Civil Aviation Organization (ICAO) (RFC-3 – June 12, 2001), Comment of Argentine Chamber of Databases and On Line Services (CABASE) (RFC-3 – June 6, 2001), Comment of Association for Computing Machinery's Internet Governance Project, Electronic Privacy Information Center (RFC-3 – June 15, 2001), Comment of Icannchannel.de (Alexander Svennson) (RFC-3 – June 15, 2001), Comment of Nominet UK (RFC-3 – June 14, 2001), Comment of Chris Brand (RFC-3 – April 16, 2001), Comment of Michael Froomkin (RFC-3 – June 4, 2001), Comment of Christian Mogensen (RFC-3 – April 16, 2001), Comment of Daniel R. Tobias (RFC-3 – April 15, 2001).

[122] The top-level domain, .org, is a domain space that might especially be prone to risks of misleading domain name registrations corresponding to the names or abbreviations of IGOs, since “org” is intended to be the abbreviation for “organization.”

[123] See Comment of Hungary, Hungarian Patent Office (RFC-3 – June 13, 2001), Comment of Mexico, National Institute of Copyright (RFC-3 – May 30, 2001), Comment of Mexico, Mexican Institute of Industrial Property (IMPI) (RFC-3 – June 5, 2001), Comment of Switzerland, Swiss Federal Institute of Intellectual Property (RFC-3 – June 15, 2001), Comment of United Nations, Office of Legal Affairs, (RFC-3 – June 15, 2001), Comment of European Commission (RFC-3 – June 25, 2001), Comment of Brazilian Association of Intellectual Property (ABPI) (RFC-3 – June 8, 2001), Comment of European Brands Association (AIM) (RFC-3 – May 16, 2001), Comment of Law and Technology Committee, Auckland District Law Society (RFC-3 – June 22, 2001), Comment of UAEnic (RFC-3 – June 6, 2001). See also Comment of the Brazil Association of Intellectual Property (ABPI) (RFC-2 – January 4, 2001).

[124] See, for example, Comment of Hungary, Hungarian Patent Office (RFC-3 – June 13, 2001), Comment of Mexico, Mexican Institute of Industrial Property (IMPI) (RFC-3 – June 5, 2001), Comment of International Civil Aviation Organization (ICAO) (RFC-3 – June 12, 2001), Comment of United Nations, Office of Legal Affairs (RFC-3 – June 15, 2001), Comment of Brazilian Association of Intellectual Property (ABPI) (RFC-3 – June 8, 2001), Comment of International Association for the Protection of Industrial Property (AIPPI) (RFC-3 – June 18, 2001), Comment of Law and Technology Committee, Auckland District Law Society (RFC-3 – June 22, 2001).

[125] See Comment of United Nations, Office of Legal Affairs (RFC-3 – June 15, 2001). See also Comment of European Commission (RFC-3 – June 25, 2001), Comment of International Civil Aviation Organization (ICAO) (RFC-3 – June 12, 2001), Comment of International Labour Office (ILO) (RFC-3 – June 8, 2001), Comment of World Health Organization (WHO) (RFC-3 – June 7, 2001), Comment of European Patent Office (EPO) (RFC-2 – December 28, 2000), Comment of International Organization for Migration (IOM) (RFC-2 – February 1, 2001), Comment of International Monetary Fund (IMF) (RFC-2 – December 28, 2001), Comment of Organization for the Prohibition of Chemical Weapons (OPCW) (RFC-2 – January 17, 2001), Comment of the Preparatory Commission for the Comprehensive Nuclear-Test-Ban Treaty Organization (CTBTO) (RFC-2 – January 17, 2001), Comment of United Nations Framework Convention on Climate Change (UNFCCC) (RFC-2 – January 17, 2001), Comment of World Trade Organization (WTO) (RFC-2 – January 17, 2001).

[126] See, for example, Comment of International Monetary Fund (IMF) (RFC-2 – December 28, 2001).

[127] See Comment of International Monetary Fund (IMF) (RFC-2 - December 28, 2000), Comment of The Law Society of Scotland (RFC-2 – January 4, 2001), Comment of Preparatory Commission for the Comprehensive Nuclear-Test-Ban Treaty Organization (CTBTO) (RFC-2 – December 22, 2000), indicating that it is;

“important to have only one, authentic, source of information in the Internet and to prevent the establishment of competing unofficial Internet sites that may contain misleading, inaccurate or prejudicial information, or that may lead the viewer to believe that he or she is using the official web site of the organization.”

[128] See Comment of the European Commission (RFC-2 – January 16, 2001) (stating that a “consistent system of protection for the names of International Intergovernmental Organizations should be established,” measured by “similar standards” as those under the Paris Convention and TRIPS Agreement), Comment of Republic of Moldova, State Agency on Industrial Property Protection of the Republic of Moldova (RFC-2 - December 29, 2000), Comment of the European Patent Office (EPO) (RFC-2 - December 28, 2000), Comment of International Maritime Organization (IMO) (RFC-2 – December 13, 2000), Comment of United Nations Framework Convention on Climate Change (UNFCCC) (RFC-2 - December 7, 2000), Comment of World Health Organization (WHO) (RFC-2 – December 21, 2000), Comment of Asociación Interamericana de la Propiedad Industrial (ASIPI) (RFC-2 - December 26, 2000), Comment of The Association of European Trade Mark Owners (MARQUES) (RFC-2 - December 22, 2000), Comment of European Brands Association (AIM) (RFC-2 - December 20, 2000), indicating for IGOs that the “level of protection on the Internet should be NO LESS than the Paris Convention/TRIPS protection today.” (Emphasis in original), Comment of The Law Society of Scotland (RFC-2 – January 4, 2001). See also Comment of Organization for the Prohibition of Chemical Weapons (OPCW) (RFC-2 – December 28, 2000), Comment of the Preparatory Commission for the Comprehensive Nuclear-Test-Ban Treaty Organization (CTBTO) (RFC-2 – December 22, 2000), Comment of World Trade Organization (WTO) (RFC-2 – December 6, 2000).

[129] See Comment of United Nations, Office of Legal Affairs (RFC-3 – June 15, 2001). See also Comment of Hungary, Hungarian Patent Office (RFC-3 – June 13, 2001).

[130] See Comment of World Trade Organization (WTO) (RFC-2 – January 19, 2001).

[131] The International Labour Office described the abusive registration by an individual of internationallabour.org, internationallabour.com and internationallabour.net. See Comment of International Labour Office (ILO) (RFC-3 – June 8, 2001). Similarly, the International Monetary Fund indicated that its name and acronym had been registered by third parties in a manner that is misleading fraudulent and abusive. See Comment of

International Monetary Fund (IMF) (RFC-2 - December 28, 2000). See also Comment of Preparatory Commission for the Comprehensive Nuclear-Test-Ban Treaty Organization (CTBTO) (RFC-2 – December 22, 2000), Comment of United Nations Framework Convention on Climate Change (UNFCCC) (RFC-2 - December 7, 2000), Comment of World Health Organization (WHO) (RFC-2 – December 21, 2000), Comment of World Trade Organization (WTO) (RFC-2 – December 6, 2000).

[132] The Convention on the Privileges and Immunities of the United Nations (adopted by the General Assembly of the United Nations on 13 February 1946) and the Convention on the Privileges and Immunities of the Specialized Agencies (adopted by resolution of the General Assembly on 21 November 1947) provide for the special legal status of the IGOs. They provide that such entities shall have the capacity to, *inter alia*, institute legal proceedings (Article I and Article II respectively) but shall enjoy immunity from every form of legal process, except insofar as the organization expressly waives such immunity (Article II and Article III respectively). The Conventions do require the IGOs to make provisions for “appropriate modes of settlement” of disputes arising out of contracts or disputes of a private law character to which the IGO is a party (Article VIII and Article IX respectively).

[133] See, for example, Comment of International Civil Aviation Organization (ICAO) (RFC-3 – June 12, 2001), Comment of International Labour Office (ILO) (RFC-3 – June 8, 2001), Comment of United Nations, Office of Legal Affairs (RFC-3 – June 15, 2001), Comment of Organization for the Prohibition of Chemical Weapons (OPCW) (RFC-2 – December 28, 2000).

[134] See Comment of American Intellectual Property Law Association (AIPLA) (RFC-3 – June 7, 2001).

[135] See Comment of Hungary, Hungarian Patent Office (RFC-3 – June 13, 2001), Comment of Japan, Ministry of Economy, Trade and Industry (METI) (RFC-3 – July 5, 2001), Comment of Mexico, Mexican Institute of Industrial Property (IMPI) (RFC-3 – June 5, 2001), Comment of European Commission (RFC-3 – June 25, 2001), Comment of United Nations, Office of Legal Affairs (RFC-3 – June 15, 2001), Comment of World Health Organization (WHO) (RFC-3 – June 7, 2001), Comment of Law and Technology Committee, Auckland District Law Society (RFC-3 – June 22, 2001).

[136] See Comment of European Commission (RFC-3 – June 25, 2001).

[137] See Comment of International Maritime Organization (IMO) (RFC-2 – December 13, 2000), Comment of Organization for the Prohibition of Chemical Weapons (OPCW) (RFC-2 – December 28, 2000), Comment of Preparatory Commission for the Comprehensive Nuclear-Test-Ban Treaty Organization (CTBTO) (RFC-2 – December 22, 2000), Comment of the United Nations Framework Convention on Climate Change (UNFCCC) (RFC-2 – December 7, 2000), Comment of World Health Organization (WHO) (RFC-2 – December 21, 2000), Comment of Asociación Interamericana de la Propiedad Industrial (ASIPI) (RFC-2 – December 26, 2000), Comment of European Brands Association (AIM) (RFC-2 – December 20, 2000), Comment of Elzaburu (Luis H. De Larramendi) (RFC-1 – September 19, 2000).

[138] See Comment of Law and Technology Committee, Auckland District Law Society (RFC-3 – June 22, 2001), Comment of Elzaburu (Luis H. De Larramendi) (RFC-3 – June 14, 2001), Comment of Nominet UK (RFC-3 – June 14, 2001).

[139] See also Comment of the American Intellectual Property Law Association (AIPLA) (RFC-2 - December 29, 2000).

[140] U.S. Trademark Registration #2209103.

[141] See Comment of United States of America, Office of Advocacy, U.S. Small Business Administration (Washington consultation – May 29, 2001), Comment of World Health Organization (WHO) (RFC-3 – June 7, 2001), Comment of Argentine Chamber of Databases and On Line Services (CABASE) (RFC-3 – June 6, 2001), Comment of Association for Computing Machinery's Internet Governance Project, Electronic Privacy Information Center (RFC-3 – June 15, 2001), Comment of European Brands Association (AIM) (RFC-3 – May 16, 2001), Comment of *Fédération internationale des conseils en propriété industrielle* (FICPI) (RFC-3 – June 14, 2001), Comment of International Trademark Association (INTA) (RFC-3 – May 24, 2001), Comment of Japan Network Information Centre (JPNIC) (RFC-3 – June 8, 2001), Comment of Christian Mogensen (RFC-3 – April 16, 2001).

[142] See Comment of International Labour Office (ILO) (RFC-3 – June 8, 2001).

[143] See Comment of Japan, Ministry of Economy, Trade and Industry (METI) (RFC-3 – July 5, 2001), Comment of Republic of Korea, Korean Intellectual Property Office (KIPO) (RFC-3 – June 7, 2001), Comment of Switzerland, Swiss Federal Institute of Intellectual Property (RFC-3 – June 15, 2001), Comment of European Commission (RFC-3 – June 25, 2001), Comment of International Civil Aviation Organization (ICAO) (RFC-3 – June 12, 2001), Comment of International Labour Office (ILO) (RFC-3 – June 8, 2001), Comment of World Health Organization (WHO) (RFC-3 – June 7, 2001), Comment of Brazilian Association of Intellectual Property (ABPI) (RFC-3 – June 8, 2001), Comment of International Chamber of Commerce (ICC) (RFC-3 – June 18, 2001), Comment of Law and Technology Committee, Auckland District Law Society (RFC-3 – June 22, 2001). See also Comment of Asociación Interamericana de la Propiedad Industrial (ASIPI) (RFC-2 - December 26, 2000), Comment of The Association of European Trade Mark Owners (MARQUES) (RFC-2 - December 22, 2000), Comment of European Brands Association (AIM) (RFC-2 - December 20, 2000), Comment of Cuatrecasas Abogados (RFC-1 – September, 2000), Comment of Elizaburu (Luis H. De Larramendi) (RFC-1 – September 19, 2000).

[144] See Comment of the European Patent Office (EPO) (RFC-2 - December 28, 2000), Comment of Organization for the Prohibition of Chemical Weapons (OPCW) (RFC-2 – December 28, 2000), Comment of Preparatory Commission for the Comprehensive Nuclear-Test-Ban Treaty Organization (CTBTO) (RFC-2 – December 22, 2000), Comment of World Health Organization (WHO) (RFC-2 – December 21, 2000), Comment of Asociación Interamericana de la Propiedad Industrial (ASIPI) (RFC-2 - December 26, 2000), Comment of The Association of European Trade Mark Owners (MARQUES) (RFC-2 - December 22, 2000); cf. Comment of International Maritime Organization (IMO) (RFC-2 – December 13, 2000), Comment of J. R. Stogrum (RFC-1 – September 14, 2000).

[145] See Comment of Asociación Interamericana de la Propiedad Industrial (ASIPI) (RFC-2 - December 26, 2000).

[146] See Comment of International Labour Office (ILO) (RFC-3 – June 8, 2001), Comment of American Intellectual Property Law Association (AIPLA) (RFC-3 – June 7, 2001).

[147] See Comment of the European Commission (RFC-2 – January 16, 2001), Comment of Preparatory Commission for the Comprehensive Nuclear-Test-Ban Treaty Organization (CTBTO) (RFC-2 – December 22, 2000), Comment of the United Nations Framework Convention on Climate Change (UNFCCC) (RFC-2 – December 7, 2000), Comment of World Health Organization (WHO) (RFC-2 – December 21, 2000), Comment of the Comment of Asociación Interamericana de la Propiedad Industrial (ASIPI) (RFC-2 - December 26, 2000), Comment of European Brands Association (AIM) (RFC-2 - December 20, 2000), Comment of British Telecommunications, Plc. (RFC-2 - December 19, 2000), Comment of Elizaburu (Luis H. De Larramendi) (RFC-1 – September 19, 2000).

[148] See Comment of Japan, Ministry of Economy, Trade and Industry (METI) (RFC-3 –

July 5, 2001), Comment of Switzerland, Swiss Federal Institute of Intellectual Property (RFC-3 – June 15, 2001).

[149] See Comment of American Intellectual Property Law Association (AIPLA) (RFC-3 – June 7, 2001), Comment of Brazilian Association of Intellectual Property (ABPI) (RFC-3 – June 8, 2001). See also Comment of International Maritime Organization (IMO) (RFC-2 – December 13, 2000), Comment of Organization for the Prohibition of Chemical Weapons (OPCW) (RFC-2 – December 28, 2000).

[150] See Comment of Asociación Interamericana de la Propiedad Industrial (ASIFI) (RFC-2 – December 26, 2000), Comment of European Brands Association (AIM) (RFC-2 – December 20, 2000), Comment of British Telecommunications, Plc. (RFC-2 – December 19, 2000).

[151] See Comment of the Preparatory Commission for the Comprehensive Nuclear-Test-Ban Treaty Organization (CTBTO) (RFC-2 – December 22, 2000). See also Comment of World Health Organization (WHO) (RFC-2 – December 21, 2000), providing that the challenge should be allowed if the acronym of the IGO was in use *before* the domain name registration and there is a risk of confusion as to the identity of the domain name holder or the registration or use is otherwise in bad faith.

[152] See Comment of United Kingdom, The Patent Office (RFC-3 - June 1, 2001), Comment of American Intellectual Property Law Association (AIPLA) (RFC-3 – June 7, 2001). See also Comment of the American Intellectual Property Law Association (AIPLA) (RFC-2 – December 29, 2000), Comment of International Trademark Association (INTA) (RFC-2 – January 4, 2001).

[153] See Comment of Fédération internationale des conseils en propriété industrielle (FICPI) (RFC-2 – December 29, 2000), Comment of International Trademark Association (INTA) (RFC-2 – January 4, 2001), Comment of United States Council for International Business (USCIB) (RFC-2 – December 29, 2000), Comment of Verizon (RFC-2 – December 26, 2000).

[154] See Comment of Christopher Zaborsky (RFC-1 – August 11, 2000), Comment of Ashutosh C. Pradham (RFC-2 - December 16, 2000).

[155] See Comment of Association for Computing Machinery's Internet Governance Project (RFC-3 – June 15, 2001), Comment of Alexander Svensson (RFC-2 – December 21, 2000), Comment of PTI Networks, Inc. (Frank Schilling) (RFC-1 – August 13, 2000), Comment of VerandaGlobal.com, Inc. (William Blackwood) (RFC-1 – August 15, 2000), Comment of Solid State Design, Inc. (Charles Linart) (RFC-1 – August 15, 2000), Comment of harrycanada (RFC-1 – August 14, 2000), Comment of Garry Anderson (RFC-1 – August 12, 2000), Comment of Mark Moshkowitz (RFC-1 – August 12, 2000), Comment of Daniel Deephanphongs (RFC-1 – August 12, 2000).

[156] See, for example, Comment of International Civil Aviation Organization (ICAO) (RFC-3 – June 12, 2001), Comment of International Labour Office (ILO) (RFC-3 – June 8, 2001), Comment of United Nations, Office of Legal Affairs (RFC-3 – June 15, 2001), Comment of Organization for the Prohibition of Chemical Weapons (OPCW) (RFC-2 – December 28, 2000).

[157] See Comment of United Nations, Office of Legal Affairs (RFC-3 – June 15, 2001).

[158] The UDRP Rules, paragraph 3 (xiii), provide that the complaint shall:

“State that Complainant will submit, with respect to any challenges to a decision in the

administrative proceeding canceling or transferring the domain name, to the jurisdiction of the courts in at least one specified Mutual Jurisdiction.”

See <http://www.icann.org/udrp/udrp-rules-24oct99.htm#3bxiii>

[159] International Covenant on Civil and Political Rights, Article 10.1.

[160] Kalven, “Privacy in Tort Law—Were Warren and Brandeis Wrong?” (1966) 61 *Law and Contemporary Problems* 326, 331, quoted in *Zacchini v. Scripps-Howard Broadcasting Company* 433 U.S. 562, at 576 (1976).

[161] Ley Organica de 5 de mayo de 1982, “Derecho al honor, a la intimidad personal y familiar, y a la propia imagen.”

[162] For example, in Japan, on the basis of Article 709 of the Civil Code.

[163] See Article 15(1).

[164] See Comment of Michael Froomkin (RFC3 – June 4, 2001).

[165] See UDRP, para. 4(a).

[166] See e.g., *Harrods Ltd. v. Robert Boyd*, WIPO Case D2000-0060 (March 16, 2000) (the domain name *dodialfayed.com* was determined to be registered and used in bad faith, as it was confusingly similar to the personal name, “Dodi Fayed,” which had been registered as a European Community Trademark); *Madonna Ciccone, p/k/a Madonna v. Dan Parisi and “Madonna.com”*, WIPO Case D2000-0847 (October 12, 2000) (the domain name was held to have been registered and used in bad faith and was identical or confusingly similar to the personal name, Madonna, for which the Complainant held a United States Trademark Registration); *Drs Foster & Smith, Inc. v. Jaspreet Lalli*, NAF FA0007000095284 (August 21, 2000) (same); *Helen Fielding v. Anthony Corbet a/k/a Anthony Corbett*, WIPO Case D2000-1000 (Sept. 25, 2000) (Complainant had registered trademark in fictional character “Bridget Jones”); *Alain Delon Diffusion S.A. v. Unimetal Sanayi ve Tic A.S.*, WIPO Case D2000-0989 (October 26, 2000) (the domain name *alaindelon.com* was held to have been registered and used in bad faith and was identical to the personal name, Alain Delon, for which the Complainant held International Trademark Registration); *Laurence Fontaine v. Visiotex S.A.*, WIPO Case D2001-0071 (March 26, 2001) (the Panelist found that the domain name *lauresainclair.com* was confusingly similar to the personal name of Complainant which had registered as a trademark LAURE SAINCLAIR); *Isabel Preysler Arrastia v. Ediciones Delfín, S.L.*, WIPO Case D2001-0298 (May 31, 2001) (Panel found that the domain name *preysler.com* was confusingly similar to the personal name, Isabel Preysler, for which Complainant held a Spanish Trademark Registration).

[167] See J. T. McCarthy, *McCarthy on Trademarks and Unfair Competition*, Vol. 4, ch. 25, §25:74.2 (2000), indicating that “the reference to a trademark or service mark ‘in which the complainant has rights’ means that ownership of a *registered* mark is not required – unregistered or common law trademark or service mark rights will suffice” to support a complaint under the UDRP. (Emphasis in original).

[168] One of the earliest decisions to rely on unregistered rights in a trademark was handed down in the consolidated cases of *Bennett Coleman & Co. v. Steven S. Lalwani*, WIPO Cases D2000-0014 and D2000-0015 (March 11, 2000). The cases involved a Complainant located in India and a respondent located in the United States of America. The Respondent challenged that there were no trademark registrations for the relevant words in the domain names, *theeconomictimes.com* and *the timesofindia.com*, in the United States

and that, in any event, any trademark registrations in India had expired. The Panelist, Professor W.R. Cornish, found first that, given the Internet provides worldwide access, the assessment of the propriety of a domain name registration cannot be confined only to comparisons with trademark registrations and other rights in the country where the web site may be hosted. Secondly, the Panelist relied on the “reputation from actual use” of the words in question to determine that, whether or not the Indian trademarks were registered, the Complainant had trademark rights.

[169] See e.g., *Julia Fiona Roberts v. Russell Boyd*, WIPO Case D2000-0210 (May 29, 2000) (holding that the Complainant has common law trademark rights in her name: “The Policy does not require that the Complainant should have rights in a registered trademark or service mark. It is sufficient that the Complainant should satisfy the Administrative Panel that she has rights in common law trademark or sufficient rights to ground action for passing off”); *Jeanette Winterson v. Mark Hogarth*, WIPO Case D2000-0235 (May 22, 2000) (Panel held that Complainant has trademark rights in the mark JEANETTE WINTERSON, emphasizing that paragraph 4(a)(i) of the UDRP “refers to **rights** not registered trademark rights of a third party”); *Mick Jagger v. Denny Hammerton*, NAF Case FA0007000095261 (September 11, 2000) (“Complainant held a common law trademark in his famous name, “Mick Jagger,” even without registration at the United States Patent and Trademark Office.”); *Helen Folsade Adu p/k/a Sade v. Quantum Computer Services, Inc.*, WIPO Case D2000-0794 (September 26, 2000) (Panel held that Complainant has established common law trademark and service mark rights in the word “SADE,” which has been used in connection with sales of records, CDs, CD-ROMS, tickets for concerts and merchandising in many jurisdictions around the world); *CMG Worldwide, Inc. v. Naughtya Page*, NAF Case FA0009000095641 (November 8, 2000) (Diana, Princess of Wales, before her death had common law trademark rights in her name); *Cho Yong Pil v. ImageLand, Inc.*, WIPO Case D2000-0229 (May 10, 2000) (Complainant demonstrated that the fame in his name, as a famous Korean pop music artist for 30 years, was sufficient to give him trademark or service mark rights for the purpose of the rules); *Rosa Montero Gallo v. Galileo Asesores S.L.*, WIPO Case D2001-1649 (January 27, 2001) (Panel found that Complainant was sufficiently famous in association with the services offered in connection with Complainant’s personal name to establish the requisite common law trademark right); *José Luis Sampedro Sáez v. Galileo Asesores S.L.*, WIPO Case D2000-1650 (January 27, 2001) (same); *Lorenzo Silva Amador v. Galileo Asesores S.L.*, WIPO Case D2000-1697 (January 27, 2001) (same); *Julian Barnes v. Old Barn Studios Limited*, WIPO Case D2001-0121 (March 26, 2001) (Panel found that Complainant has common law trademark holding that “Complainant has established that he uses his name in the creation and promotion of his work from which he makes his living. His name identifies his work. His work is ordered and called for under and by reference to his name.”); *Louis De Bernieres v. Old Barn Studios Limited*, WIPO Case D2001-0122 (March 26, 2001) (same); *Anthony Beevor v. Old Barn Studios Limited*, WIPO Case D2001-0123 (March 26, 2001) (same); *Margaret Drabble v. Old Barn Studios Limited*, WIPO Case D2001-0209 (March 26, 2001) (same); *George-Marie Glover and George-Marie Glover, LLC v. Cherie Pogue*, WIPO Case D2001-0600 (June 11, 2001) (Panel held that Complainant has common law trademark in the name “George-Marie” which has been used in connection with complainant’s artistic services for 15 years); See also Report of first WIPO Process, paras. 149-50, at 42-43 (allow “consideration of all legitimate rights and interests of the parties (which are not necessarily reflected in a trademark certificate)”).

[170] See e.g., *Julia Fiona Roberts v. Russell Boyd*, WIPO Case D2000-0210 (May 29, 2000) (the Complainant “is a famous motion picture actress”); *Jeanette Winterson v. Mark Hogarth*, WIPO Case D2000-0235 (May 22, 2000) (Complainant is an author who has “achieved international recognition and critical acclaim,” writing books and screen plays that have been published in over 21 countries in 18 languages); *Mick Jagger v. Denny Hammerton*, NAF Case FA0007000095261 (September 11, 2000) (Complainant has a “famous personal name, ‘Mick Jagger,’”); *Helen Folsade Adu p/k/a Sade v. Quantum Computer Services, Inc.*, WIPO Case D2000-0794 (September 26, 2000) (Complainant is a world famous singer, songwriter and recording artist known under the stage name “SADE”); *Isabelle Adjani v. Second Orbit Communications, Inc.*, WIPO Case D2000-0867 (October 4, 2000) (Panel notes that Complainant has achieved “international recognition and acclaim” as

a well-known film actress using her real name, Isabelle Adjani); *CMG Worldwide, Inc. v. Naughty Page*, NAF Case FA0009000095641 (Nov. 8, 2000) (finding that, in relation to the domain names *princessdi.com* and *princessdiana.com*, that Princess Diana, during her life time, was well known as Princess Diana or Princess Di); but cf., *Gordon Sumner, p/k/a Sting v. Michael Urvan*, WIPO Case D2000-0596 (July 20, 2000) (held that the personal name Sting was not distinctive, as it “is also a common word in the English language, with a number of different meanings”); *Alain Delon Diffusion S.A. v. Unimetal Sanayi ve Tic A.S.*, WIPO Case D2000-0989 (October 26, 2000) (“the Panel is satisfied that the ALAIN DELON name and mark is well-known internationally”).

[171] See *Monty and Pat Roberts, Inc. v. Bill Keith*, WIPO Case D2000-0299 (June 9, 2000).

[172] See *Steven Rattner v. BuyThisDomainName (John Pepin)*, WIPO Case D2000-0402 (July 3, 2000) (holding Complainant is well-known and has a common law mark in connection with investment banking and corporate advisory services); *Monty and Pat Roberts, Inc. v. Bill Keith*, WIPO Case D2000-0299 (June 9, 2000) (held that Complainant's name, Monty Roberts, is a famous mark in connection with the service of horse training); *Nic Carter v. The Afternoon Fiasco*, WIPO Case D2000-0658 (October 17, 2000) (Complainant's “name, Nic Carter is distinctive, has received a high degree of recognition and has come to be associated in the minds of the public with Complainant and his radio broadcasting services”); *Isabelle Adjani v. Second Orbit Communications, Inc.*, WIPO Case D2000-0867 (October 4, 2000) (use of Complainant's name has come to be recognized by the general public as indicating an association with the Complainant and her activities as an actress); *Mick Jagger v. Denny Hammerton*, NAF Case FA0007000095261 (September 11, 2000) (“Complainant presented evidence “of the continuous commercial use ... for more than thirty-five (35) years” of “his famous personal name, ‘Mick Jagger,’”); *Helen Folsade Adu p/k/a Sade v. Quantum Computer Services, Inc.*, WIPO Case D2000-0794 (September 26, 2000) (“SADE,” has been used in connection with sales of records, CDs, CD-ROMS, tickets for concerts and merchandising in many jurisdictions around the world); but cf., *Anne McLellan v. Smartcanuk.com*, eResolution Case AF-0303a & AF-0303b (September 25, 2000) (held that Complainant, the most senior Government of Canada official in the Province of Alberta, where both Complainant and Respondent reside, has common law trademark rights in her name, although the decision does not indicate that she has used her name as a mark in commerce).

[173] See e.g., *Harrods Ltd. v. Robert Boyd*, WIPO Case D2000-0060 (March 16, 2000) (domain name *dodialfayed.com* was determined to be confusingly similar to the personal name, “Dodi Fayed.”); *Steven Rattner v. BuyThisDomainName (John Pepin)*, WIPO Case D2000-0402 (July 3, 2000) (Complainant not limited to claiming rights in his full name - small variations in the name are not material).

[174] See *Bennett Coleman & Co. v. Steven S. Lalwani*, WIPO Cases D2000-0014 and D2000-0015 (March 11, 2000) (given the Internet provides worldwide access, the assessment of the propriety of a domain name registration cannot be confined only to comparisons with trademark registrations and other rights in the country where the web site may be hosted); see also *Jeanette Winterson v. Mark Hogarth*, WIPO Case D2000-0235 (May 22, 2000) (“Since both the Complainant and the Respondent are domiciled in the United Kingdom, ... the Panel can look at applicable decisions of English courts”); *Pierre van Hooijdonk v. S.B. Tait*, WIPO Case D2000-1068 (Nov. 4, 2000) (Complainant was resident in the Netherlands and the Respondent in the United Kingdom. The Panel makes reference to (i) Complainant's Benelux registered trademark and service mark, (ii) the common law of the United Kingdom, and (iii) the decision of the President of the Amsterdam District Court in *Albert Heijn and 159 other plaintiffs v. Name Space* (July 13, 2000), holding that Defendant's registration of 300 “proper names” was unlawful); *Isabelle Adjani v. Second Orbit Communications, Inc.*, WIPO Case D2000-0867 (October 4, 2000) (“The Complainant is resident in Switzerland and the Respondents give an address in the United States of America. To the extent that it assists in determining whether the Complainant has met her burden under paragraph 4a(i) of the Policy to establish that she has trademark rights in her

name *Isabelle Adjani*, the Panel can look at applicable decision and laws in both countries”); *Estate of Stanley Getz a/k/a Stan Getz v. Peter Vogel*, WIPO Case D2000-0773 (October 10, 2000) (“Since Getz was a resident of the State of California at the time of his death and since his estate is being probated in the courts of the State of California under California law, to the extent that it would assist the Panel, the Panel shall also look to the law of the State of California.”).

[175] See *Experience Hendrix. LLC v. Denny Hammerton and the Jimi Hendrix Fan Club*, WIPO Case D2000-0364 (August 15, 2000); *MPL Communications Ltd. v. Denny Hammerton*, NAF Case FA0009000095633 (October 25, 2000) (Respondent, who had registered *paulmccartney.com* and *lindamccartney.com*, has also registered the names of other celebrities such as Mick Jagger, Rod Stewart and Sean Lennon. He has not made use of the domain names in connection with a bona fide offering of goods or services); *Madonna Ciccone, p/k/a Madonna v. Dan Parisi and “Madonna.com,”* WIPO Case D2000-0847 (October 12, 2000) (use which intentionally trades on the fame of another can not constitute a “bona fide” offering of goods or services”); *Alain Delon Diffusion S.A. v. Unimetal Sanayi ve Tic A.S.*, WIPO Case D2000-0989 (October 26, 2000) (the Panel found that, among other factors, the registration by the Respondent of a number of other well known trademarks as domain names, there was no basis for finding that the Respondent have had any good faith basis for registering the disputed domain name).

[176] See *Helen Folsade Adu p/k/a Sade v. Quantum Computer Services, Inc.*, WIPO Case D2000-0794 (September 26, 2000).

[177] See *Monty and Pat Roberts, Inc. v. Bill Keith*, WIPO Case D2000-0299 (June 9, 2000).

[178] *Id.*; see also; *Nic Carter v. The Afternoon Fiasco*, WIPO Case D2000-0658 (October 17, 2000) (same); *Jeanette Winterson v. Mark Hogarth*, Case D2000-0235 (May 22, 2000), quoting *British Telecommunications plc v. One in a Million* (1999) FSR 1, at 23 (C.A.) (Aldous L.J.):

“The placing on a register of a distinctive name such as *marksandspencer* makes a representation to persons who consult the register that the registrant is connected or associated with the name registered and thus the owner of the goodwill in the name.”

[179] *Id.*

[180] See UDRP, para. 4(b):

“For the purposes of Paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location."

[181] See e.g., *Experience Hendrix. LLC v. Denny Hammerton and the Jimi Hendrix Fan Club*, WIPO Case D2000-0364 (August 15, 2000) (*jimihendrixs.com*); *MPL Communications Ltd. v. Denny Hammerton*, NAF Case FA0009000095633 (October 25, 2000) (*paulmccartney.com* and *lindamccartney.com*); *Madonna Ciccone, p/k/a Madonna v. Dan Parisi and "Madonna.com,"* WIPO Case D2000-0847 (October 12, 2000) (*madonna.com*).

[182] See *Jules I. Kendall v. Donald Mayer re skipkendall.com*, WIPO Case D2000-0868 (October 26, 2000).

[183] See <http://www.theglobalname.org>.

[184] See <http://www.icann.org/tlds>.

[185] See Comment of Hungary, Hungarian Patent Office (RFC-3 – June 13, 2001), Comment of Mexico, Mexican Institute of Industrial Property (IMPI) (RFC-3 – June 5, 2001), Comment of Switzerland, Swiss Federal Institute of Intellectual Property (RFC-3 – June 15, 2001), Comment of Association des Praticiens en droit des Marques et des Modèles (APRAM) (RFC-3 – June 7, 2001), Comment of Brazilian Association of Intellectual Property (ABPI) (RFC-3 – June 8, 2001) and (RFC-2 – January 4, 2001), Comment of Japan Network Information Center (JPNIC) (RFC-3 – June 8, 2001), Comment of Nominet UK (RFC-3 – June 14, 2001). For similar views expressed in response to RFC-2, see also Comment of Australia, Government of Australia (RFC-2 – January 23, 2001), Comment of Asociación Interamericana de la Propiedad Industrial (ASIPI) (RFC-2 – December 26, 2001), Comment of European Brands Association (AIM) (RFC-2 – December 20, 2000), Comment of British Telecommunications plc (RFC-2 – December 28, 2000), Comment of Ian Kaufman (RFC-2 – December 20, 2000).

[186] See Comment of United Kingdom, The Patent Office (RFC-3 – June 1, 2001), Comment of United States of America, Office of Advocacy: United States Small Business Administration (RFC-3 – June 15, 2001), Comment of European Commission (RFC-3 – June 25, 2001), Comment of American Intellectual Property Law Association (AIPLA) (RFC-3 – June 7, 2001), Comment of Association for Computing Machinery's Internet Governance Project (RFC-3 – June 15, 2001), Comment of Copyright Coalition on Domain Names (CCDN) (RFC-3 – June 7, 2001) and (RFC-2 – December 28, 2000), Comment of Fédération internationale des conseils en propriété industrielle (FICPI) (RFC-3 – June 14, 2001) and (RFC-2 – January 18, 2001), Comment of International Association for the Protection of Industrial Property (AIPPI) (RFC-3 – June 18, 2001), Comment of International Chamber of Commerce (ICC) (RFC-3 – June 18, 2001), Comment of International Trademark Association (INTA) (RFC-3 – May 24, 2001), Comment of Motion Picture Association of America (MPAA) (RFC-3 – June 6, 2001), Comment of Icannchannel.de (RFC-3 – June 15, 2001) and (RFC-2 – December 21, 2000), Comment of Rod Dixon (RFC-3 – May 15, 2001), Comment of Michael Froomkin (RFC-3 – June 4, 2001). For similar views expressed in response to RFC-2, see also Comment of European Commission (RFC-2 – January 16, 2001).

[187] See Comment of Japan Network Information Center (JPNIC) (RFC-3 – June 8, 2001), Comment of Nominet UK (RFC-3 – June 14, 2001).

[188] See Comment of Switzerland, Swiss Federal Institute of Intellectual Property (RFC-3 – June 15, 2001).

[189] See Comment of Switzerland, Swiss Federal Institute of Intellectual Property (RFC-3 – June 15, 2001), Comment of Association des Praticiens en droit des Marques et des Modèles (APRAM) (RFC-3 – June 7, 2001), Comment of Brazilian Association of Intellectual Property (ABPI) (RFC-3 – June 8, 2001), Comment of Japan Network Information Center (JPNIC) (RFC-3 – June 8, 2001), Comment of Nominet UK (RFC-3 – June 14, 2001).

[190] See Comment of Brazilian Association of Intellectual Property (ABPI) (RFC-3 – June 8, 2001).

[191] See Comment of Fédération Internationale des Conseils en Propriété Industrielle (FICPI) (RFC-3 – June 14, 2001), Comment of International Association for the Protection of Industrial Property (AIPPI) (RFC-3 – June 18, 2001), Comment of Motion Picture Association of America (MPAA) (RFC-3 – June 6, 2001).

[192] See Comment of United States of America, Office of Advocacy: United States Small Business Administration (RFC-3 – June 15, 2001), Comment of Association for Computing Machinery's Internet Governance Project (RFC-3 – June 15, 2001), Comment of Icannchannel.de (RFC-3 – June 15, 2001), Comment of Rod Dixon (RFC-3 – May 15, 2001).

[193] See Comment of United Kingdom, The Patent Office (RFC-3 – June 1, 2001), Comment of Fédération Internationale des Conseils en Propriété Industrielle (FICPI) (RFC-3 – June 14, 2001), Comment of International Trademark Association (INTA) (RFC-3 – May 24, 2001), Comment of Rod Dixon (RFC-3 – May 15, 2001).

[194] See Comment of Association des Praticiens en droit des Marques et des Modèles (APRAM) (RFC-3 – June 7, 2001), Comment of Motion Picture Association of America (MPAA) (RFC-3 – June 6, 2001).

[195] See Comment of Rod Dixon (RFC-3 – May 15, 2001), Comment of Michael Froomkin (RFC-3 – June 4, 2001).

[196] Comment of Motion Picture Association of America (MPAA) (RFC-3 – June 6, 2001).

[197] A comparable provision has been enacted by the State of California as part of legislation similar to the ACPA. See Section 17525 (a) of the Cal. Business and Professional Code (August 22, 2000).

[198] See Annex II.

[199] See Annex II.

[200] See Annex II.

[201] See Annex II.

[202] Agreement Relating to the Creation of an African Intellectual Property Organization Constituting a Revision of the Agreement Relating to the Creation of an African and Malagasy Office of Industrial Property (Bangui (Central African Republic), March 2, 1977). See <http://www.oapi.cm>.

[203] The Protocol is not yet in force.

- [204] Article 10(1), Paris Convention.
- [205] Article 9(3), Paris Convention.
- [206] Article 10(2), Paris Convention.
- [207] Article 2.1, TRIPS Agreement.
- [208] Article 1(1), Madrid (Indications of Source) Agreement.
- [209] Article 22.2(a), TRIPS Agreement.
- [210] Article 22.2(b), TRIPS Agreement.
- [211] Article 23, TRIPS Agreement.
- [212] The definition in the TRIPS Agreement is broader insofar as it attributes status to geographical localities from which products derive a reputation. There are certain other differences.
- [213] Article 23.4, TRIPS Agreement.
- [214] More information on the *Office international de la vigne et du vin* (OIV) is available at www.oiv.int.
- [215] See Comment of *Office international de la vigne et du vin* (OIV) (RFC-3 of first WIPO Process - April 30, 1999).
- [216] “*Une étude menée en 1999 a constaté le dépôt d’un grand nombre de noms de domaine (.com) qui correspondent aux noms d’appellations d’origines et d’indications géographiques de produits vitivinicoles et de noms de cépages sans que les dépositaires aient un lien quelconque avec les titulaires réels des droits liés à ces signes distinctifs.*” in Comment of *Office international de la vigne et du vin* (OIV) (RFC-1 - August 14, 2000).
- [217] As the study was conducted in 1999, and as registration data often change, all information regarding the domain name holder as well as the web site’s activity has been verified as at January 26, 2001, as reflected in the Annex.
- [218] See Comment of *Institut national des appellations d’origine* (INAO) (RFC-2 – January 31, 2001).
- [219] See Annex IX, INAO: *fitou.com*.
- [220] See Annex VIII, Châteauneuf du Pape: *bade.com, barsac.com, rhodes.net*; Annex IX, INAO: *bourgueil.com, corton.com, gigondas.com, vacqueyras.com*; Annex X, Lisbon: *champagne.org, chinon.org, frascati.com*.
- [221] See Annex VI, OIV: *bourgogne.com, eiswein.com, lambrusco.com, medoc.com*; Annex VIII Lisbon: *armagnac.com, hoyo-de-monterrey.com, tequila.com*.
- [222] See Comment of France, *Institut national des appellations d’origine* (INAO) (RFC-3 – June 13, 2001), Comment of Hungary, Hungarian Patent Office (RFC-3 – June 13, 2001),

Comment of Switzerland, Swiss Federal Institute of Intellectual Property (RFC-3 – June 15, 2001), Comment of United Kingdom, The Patent Office (RFC-3 – June 1, 2001), Comment of European Commission (RFC-3 – June 25, 2001), Comment of American Intellectual Property Law Association (AIPLA) (RFC-3 – June 7, 2001), Comment of Auckland District Law Society, Law & Technology Committee (RFC-3 – June 22, 2001), Comment of Brazilian Association of Intellectual Property (ABPI) (RFC-3 – June 8, 2001), Comment of European Brands Association (AIM) (RFC-3 – May 16, 2001), Comment of International Association for the Protection of Industrial Property (AIPPI) (RFC-3 - June 18, 2001), Comment of International Chamber of Commerce (ICC) (RFC-3 – June 18, 2001), Comment of Japan Network Information Center (JPNIC) (RFC-3 – June 8, 2001), Comment of Nominet UK (RFC-3 – June 14, 2001), Comment of UAEnic (RFC-3 – June 6, 2001), Comment of Elizaburu (Luis H. De Larramendi) (RFC-3 – June 14, 2001). For similar views expressed in response to RFC-2, see also Comment of Government of Australia (RFC-2 – January 23, 2001), Comment of Government of The Netherlands, Ministry of Transport, Public Works and Water Management (RFC-2 – December 20, 2000), Comment of Republic of Moldova State Agency on Industrial Property Protection (RFC-2 – December 29, 2000); Comment of *Asociación Interamericana de la Propiedad Industrial* (ASIPI) (RFC-2 – December 26, 2000); Comment of Brazilian Association of Intellectual Property (ABPI) (RFC-2 - December 28, 2000), Comment of Association of European Trade Mark Owners (MARQUES) (RFC-2 - December 22, 2000), Comment of ES-NIC (RFC-2 – December 29, 2000), Comment of Verizon (RFC-2 December 26, 2000).

[\[223\]](#) See Comment of *Fédération internationale des conseils en propriété industrielle* (FICPI) (RFC-3 – June 14, 2001); see also (RFC-2 - December 29, 2000) and Comment of International Trademark Association (INTA) (RFC-3 – May 24, 2001).

[\[224\]](#) See Comment of Canada, Government of Canada (RFC-3 – July 5, 2001), Comment of Japan, Ministry of Economy, Trade and Industry (METI) (RFC-3 – July 5, 2001), Comment of United States of America, U.S. Patent and Trademark Office (USPTO) (RFC-3 – June 14, 2001), Comment of Association for Computing Machinery's Internet Governance Project, Electronic Privacy Information Center (RFC-3 – June 15, 2001), Comment of EasyLink Services Corporation (RFC-3 – January 1, 2001), Comment of International Trademark Association (INTA) (RFC-3 – May 24, 2001), Comment of Icanchannel.de (RFC-3 – June 15, 2001), Comment of Andy Eastman (RFC-3 – June 16, 2001), Comment of Christine Haight Farley (RFC-3 – June 11, 2001), Comment of Michael Froomkin (RFC-3 – June 4, 2001). For similar views expressed in response to RFC-2, see also Comment of Tim Heffley, Z-Drive Computer Service (RFC-2 – December 19, 2000), Comment of Christa Worley (RFC-2 December 19, 2000), Comment of Alexander Svenssen (RFC-2 – December 21, 2000).

[\[225\]](#) See Comment of France, *Institut national des appellations d'origine* (INAO) (RFC-3 – June 13, 2001).

[\[226\]](#) See Comment of France, *Institut national des appellations d'origine* (INAO) (RFC-3 – June 13, 2001) and Comment of European Commission (RFC-3 – June 25, 2001).

[\[227\]](#) See Comment of Elizaburu (Luis H. De Larramendi) (RFC-3 – June 14, 2001).

[\[228\]](#) See Comment of European Commission (RFC-3 – June 25, 2001), Comment of Hungary, Hungarian Patent Office (RFC-3 – June 13, 2001), Comment of United Kingdom, The Patent Office (RFC-3 – June 1, 2001), Comment of American Intellectual Property Law Association (AIPLA) (RFC-3 – June 7, 2001), Comment of Auckland District Law Society, Law & Technology Committee (RFC-3 – June 22, 2001), Comment of International Association for the Protection of Industrial Property (AIPPI) (RFC-3 – June 18, 2001).

[\[229\]](#) See Comment of Elizaburu (Luis H. De Larramendi) (RFC-3 – June 14, 2001).

- [230] See Comment of Japan Network Information Center (JPNIC) (RFC-3 – June 8, 2001).
- [231] See Comment of France, *Institut national des appellations d'origine* (INAO) (RFC-3 – June 13, 2001).
- [232] See Comment of Christine Haight Farley (RFC-3 – June 11, 2001).
- [233] See Comment of United States of America, U.S. Patent and Trademark Office (USPTO) (RFC-3 – June 14, 2001) and Comment of Christine Haight Farley (RFC-3 – June 11, 2001).
- [234] See Comment of United States of America, U.S. Patent and Trademark Office (USPTO) (RFC-3 – June 14, 2001), Comment of *Fédération internationale des conseils en propriété industrielle* (FICPI) (RFC-3 – June 14, 2001), Comment of International Trademark Association (INTA) (RFC-3 – May 24, 2001), Comment of Christine Haight Farley (RFC-3 – June 11, 2001).
- [235] See paragraph 195, above.
- [236] See Comment of Michael Fromkin (RFC-3 – June 4, 2001).
- [237] See Comment of Association for Computing Machinery's Internet Governance Project, Electronic Privacy Information Center (RFC-3 – June 15, 2001), Comment of International Trademark Association (INTA) (RFC-3 – May 24, 2001), Comment of Icannchannel.de (RFC-3 – June 15, 2001).
- [238] See Comment of United States of America, U.S. Patent and Trademark Office (USPTO) (RFC-3 – June 14, 2001).
- [239] See <http://www.hcch.net/e/workprog/jdgm.html>.
- [240] Terminology Bulletin No. 347/Rev.1, States Members of the United Nations, Members of the Specialized Agencies or Parties to the Statute of the International Court of Justice, ST/CS/SER.F/347/Rev.1.
- [241] See WIPO Case D2000-1664 (*caymanislands.com*) available at <http://arbiter.wipo.int/domains/decisions/html/2000/d2000-1664.html>.
- [242] Business Day (Johannesburg), June 21, 2001.
- [243] Docket number 16 O 101/00, Computerrecht (CR) 2000, page 700-701.
- [244] For more information, see <http://www.iso.ch>.
- [245] The list of currently existing ccTLDs is available at <http://www.iana.org/cctld/cctld-whois.htm>.
- [246] See, for instance, the services of CentralNic offering the possibility of registering names under the following: *br.com, cn.com, eu.com, gb.com, gb.net, hu.com, no.com, qc.com, ru.com, sa.com, se.com, se.net, uk.com, uk.net, us.com, uy.com, and za.com*. For more information, see <http://www.centralnic.com/>.

[247] The World Heritage List is available at <http://www.unesco.org/whc/nwhc/pages/doc/mainf3.htm>.

[248] See http://www.legalis.net/jnet/decisions/marques/tgi_sttropez.htm.

[249] This case is available at <http://www.legalis.net>.

[250] Next to heidelberg.de, these cases concerned the following cities: *kerpen.de*, *pullheim.de*, *celle.de*, *herzogenrath.de*, *bad-wildbad.com*. They are all available at http://www.bettinger.de/datenbank/domains_ge.html.

[251] See, for instance, WIPO Case D2000-0064 (*1800rockport.com*); WIPO Case D2000-0505 (*barcelona.com*); WIPO Case D2000-0617 (*stmoritz.com*); WIPO Case D2000-0629 (*parmaham.com*); WIPO Case D2000-0638 (*manchesterairport.com*); D2000-0699 (*paris-lasvegas.com*); WIPO Case D2000-1017 (*xuntadegalicia.net/xuntadegalicia.org*); WIPO Case D2000-1218 (*wembleystadiumonline.com*); WIPO Case D2000-1224 (*sydneyoperahouse.net*); WIPO Case D2000-1377 (*axachinaregion.com*); WIPO Case D2000-1435 (*capeharbour.com/capeharbor.com*). These cases are available at <http://arbiter.wipo.int/domains/decisions/index-gtld.html>.

[252] WIPO Case D2000-0505, available at <http://arbiter.wipo.int/domains/decisions/html/2000/d2000-0505.html> and WIPO Case D2000-0617, available at <http://arbiter.wipo.int/domains/decisions/html/d2000-0617.html>.

[253] WIPO Case D2000-1728, available at <http://arbiter.wipo.int/domains/decisions/html/2000/d2000-1728.html>.

[254] WIPO Case D2001-0001, available at <http://arbiter.wipo.int/domains/decisions/html/2001/d2001-0001.html>.

[255] WIPO Case D2001-0002, available at <http://arbiter.wipo.int/domains/decisions/html/2001/d2000-0002.html>.

[256] WIPO Case D2001-0047, available at <http://arbiter.wipo.int/domains/decisions/html/2001/d2001-0047.html>.

[257] WIPO Case D2001-0069, available at <http://arbiter.wipo.int/domains/decisions/html/2001/d2001-0069.html>.

[258] WIPO Case D2001-0321, available at <http://arbiter.wipo.int/domains/decisions/html/2001/d2001-0321.html>.

[259] WIPO Case D2001-0348, available at <http://arbiter.wipo.int/domains/decisions/html/2001/d2001-0348.html>.

[260] WIPO Case D2001-0566, available at <http://arbiter.wipo.int/domains/decisions/html/2001/d2001-0566.html>.

[261] The policy of .AU on this question is currently under review. For more information, see Section 4.2 of Review of Policies in .AU Second Level Domains, Public Consultation Report, auDA Name Policy Advisory Panel (November 2000), available at <http://www.auda.org.au/panel/name/papers/publicreport.html>. Until November 15, 2000, .NL also restricted the registration of domain names corresponding to city and province names. Since that date, these restrictions have been removed. However, in its comments on WIPO2

RFC-2, the Dutch Ministry of Transport, Public Works and Water Management stated that it is advisable to protect geographical terms against their bad faith, abusive, misleading or unfair registration and use in the DNS.

[262] See .CA registration policy at http://www.cira.ca/en/cat_Registration.html.

[263] See .DZ registration policy at <http://www.nic.dz/francais/precision.htm>.

[264] See .ES registration policy at <http://www.nic.es/normas/index.html>.

[265] See .FR registration policy at <http://www.nic.fr/enregistrement/fondamentaux.html>.

[266] See .PE registration policy at <http://www.nic.pe/interna/normas.htm>.

[267] See .SE registration policy at <http://www.iis.se/regulations.shtml>.

[268] For instance, for .AU, this is Australian Surveying and Land Information Group's database of Australian place names.

[269] See, for instance, the work conducted since 1982 by the United Nations Commission on Human Rights, its Sub-Commission on Prevention of Discrimination and Protection of Minorities, and the Sub-Commission's Working Group on Indigenous Populations. More particularly in the area of intellectual property, see WIPO's work on traditional knowledge, innovations and creativity, information about which is available at <http://wipo.int/traditionalknowledge/introduction/index.html>.

[270] See Comment of United States of America, U.S. Patent and Trademark Office (USPTO) (RFC-3 - June 14, 2001), Comment of United States of America, Office of Advocacy: U.S. Small Business Administration (RFC-3 – June 15, 2001), Comment of Association for Computing Machinery's Internet Governance Project, Electronic Privacy Information Center (RFC-3 - June 15, 2001), Comment of *Fédération internationale des conseils en propriété industrielle* (FICPI) (RFC-3 – June 14, 2001), Comment of International Association for the Protection of Industrial Property (AIPPI), (RFC-3 – June 18, 2001), Comment of the International Chamber of Commerce (ICC) (RFC-3 – June 18, 2001), Comment of International Trademark Association (INTA) (RFC-3 – May 24, 2001), Comment of EasyLink Services Corporation (RFC-3 – January 1, 2001), Comment of Icannchannel.de (RFC-3 – June 15, 2001), Comment of Michael Froomkin (RFC-3 – June 4, 2001). For similar views expressed in response to RFC-2, see also Comment of Tim Heffley, Z-Drive Computer Service (RFC-2 – December 19, 2000), Comment of Alexander Svenssen (RFC-2 – December 21, 2000), Comment of Christa Worley (RFC-2 – December 29, 2000).

[271] See Comment of Cyprus, Government of Cyprus (RFC-3 – June 7, 2001), Comment of South Africa, Ministry of Telecommunications (RFC-3 – June 7, 2001), Comment of United Kingdom, The Patent Office (RFC-3 – June 1, 2001), Comment of European Commission (RFC-3 – June 25, 2001), Comment of American Intellectual Property Law Association (AIPLA) (RFC-3 – June 7, 2001), Comment of Auckland District Law Society, Law & Technology Committee (RFC-3 – June 22, 2001), Comment of Brazilian Association of Intellectual Property (ABPI) (RFC-3 – June 8, 2001), Comment of Japan Network Information Center (JPNIC) (RFC-3 – June 8, 2001), Comment of UAEnic (RFC-3 – June 6, 2001), Comment of Elzaburu (Luis H. De Larramendi) (RFC-3 – June 14, 2001). For similar views expressed in response to RFC-2, see also Comment of Netherlands, Ministry of Transport, Public Works and Water Management (RFC-2 – December 20, 2000), Comment of South Africa, Government of South Africa (RFC-2 – March 2, 2001), Comment of European Commission (RFC-2 – January 16, 2001).

[\[272\]](#) See Comment of South Africa, Ministry of Telecommunications (RFC-3 – June 7, 2001).

[\[273\]](#) See Comment of United States of America, U.S. Patent and Trademark Office (USPTO) (RFC-3 – June 14, 2001), Comment of United States of America, Office of Advocacy: U.S. Small Business Administration (RFC-3 – June 15, 2001), Comment of Association for Computing Machinery's Internet Governance Project, Electronic Privacy Information Center (RFC-3 - June 15, 2001), Comment of International Association for the Protection of Industrial Property (AIPPI), (RFC-3 – June 18, 2001). For similar views expressed in response to RFC-2, see also Comment of Australia, Government of Australia (RFC-2 – January 2001), Comment of Brazilian Association of Intellectual Property (ABPI) (RFC-2 – December 28, 2000), Comment of Christa Worley (RFC-2 - January 4, 2001).

[\[274\]](#) See Comment of United States of America, Office of Advocacy: U.S. Small Business Administration (RFC-3 – June 15, 2001), Comment of Association for Computing Machinery's Internet Governance Project, Electronic Privacy Information Center (RFC-3 – June 15, 2001), Comment of EasyLink Services Corporation (RFC-3 – January 1, 2001).

[\[275\]](#) See Comment of United States of America, Office of Advocacy: U.S. Small Business Administration (RFC-3 – June 15, 2001), Comment of International Trademark Association (INTA) (RFC-3 – May 24, 2001), Comment of EasyLink Services Corporation (RFC-3 - January 1, 2001).

[\[276\]](#) See Comment of EasyLink Services Corporation (RFC-3 – January 1, 2001).

[\[277\]](#) See Comment of United States of America, U.S. Patent and Trademark Office (USPTO) (RFC-3 – June 14, 2001), Comment of *Fédération internationale des conseils en propriété industrielle* (FICPI) (RFC-3 – June 14, 2001).

[\[278\]](#) See Comment of United Kingdom, The Patent Office (RFC-3 – June 1, 2001), Comment of European Commission (RFC-3 – June 25, 2001), Comment of Auckland District Law Society, Law & Technology Committee (RFC-3 – June 22, 2001), Comment of International Association for the Protection of Industrial Property (AIPPI), (RFC-3 – June 18, 2001), Comment of Japan Network Information Center (JPNIC) (RFC-3 – June 8, 2001).

[\[279\]](#) See Comment of Association for Computing Machinery's Internet Governance Project, Electronic Privacy Information Center (RFC-3 – June 15, 2001), Comment of CentralNic (RFC-3 – May 25, 2001), Comment of Fish & Richardson P.C. (RFC-3 – June 14, 2001).

[\[280\]](#) See Comment of CentralNic (RFC-3 – May 25, 2001).

[\[281\]](#) See Comment of International Trademark Association (INTA) (RFC-3 – May 24, 2001).

[\[282\]](#) See Comment of Canada, Government of Canada (RFC-3 – July 5, 2001), Comment of Auckland District Law Society, Law & Technology Committee (RFC-3 – June 22, 2001), Comment of Christine Haight Farley (RFC-3 – June 11, 2001).

[\[283\]](#) See, in this respect, United Nations Terminology Bulletin No. 347/Rev.1, States Members of the United Nations, Members of the Specialized Agencies or Parties to the Statute of the International Court of Justice, ST/CS/SER.F/347/Rev.1.

[\[284\]](#) See Comment of European Brands Association (AIM) (RFC-2 - December 20,

2000).

[285] See also the discussion of Article 6^{ter} in the preceding chapters of this Report.

[286] See Comment of South Africa, Ministry of Communications (RFC-3 – June 7, 2001).

[287] See paragraph 264 of the Interim Report.

[288] See WIPO Document PR/WGAO/II/6.

[289] See Basic Proposals for the Diplomatic Conference on the Revision of the Paris Convention for the Protection of Industrial Property (Geneva, February 4 to March 4, 1980).

[290] See WIPO Document PR/SM/9.

[291] See paragraph 34 of the Report of the first WIPO Process where it is stated that “[t]he goal of this WIPO Process is not to create new rights of intellectual property, nor to accord greater protection to intellectual property in cyberspace than that which exists elsewhere. Rather, the goal is to give proper and adequate expression to the existing, multilaterally agreed standards of intellectual property protection in the context of the new, multijurisdictional and vitally important medium of the Internet and the DNS that is responsible for directing traffic on the Internet.”

[292] Appendix K is available at <http://www.icann.org/tlds/agreements/un-sponsored/registry-agmt-appk-26apr01.htm>.

[293] See pages VIII and 1 of International Standard ISO 3166-1 (Ref. no.: ISO 3166-1:1997 (E/F)).

[294] The same questions arise irrespective of whether the term registered at the second level is an ISO 3166 code or another term. While the problem therefore is of a general nature affecting all registrations at levels below the second level, it is discussed here in the context of the registration of country codes at the second level.

[295] See Comment of CentralNic (RFC-3 – May 25, 2001).

[296] See Comment of Canada, Government of Canada (RFC-3 – July 5, 2001), Comment of Auckland District Law Society, Law & Technology Committee (RFC-3 – June 22, 2001), Comment of Christine Haight Farley (RFC-3 – June 11, 2001).

[297] For more information on this Program, see www.wipo.int/globalissues/index-en.html.

[298] See Comment of Switzerland, Swiss Federal Institute of Intellectual Property (RFC-3 – June 1, 2001).

[299] Refer generally to the analysis of the passing-off action in W.R. Cornish, *Intellectual Property: Patents, Copyright, Trade Marks and Allied Rights*, (4th ed.) (Sweet & Maxwell, 1999) at Chapter 16, and in T.A. Blanco White and Robin Jacob, *Kerly's Law of Trade Marks and Trade Names*, (12th ed.) (Sweet & Maxwell, 1986) at Chapter 16.

[300] See Comment of Hungary, Hungarian Patent Office (RFC-3 – June 13, 2001), Comment of *Fédération internationale des conseils en propriété industrielle* (FICPI) (RFC-3 – June 14, 2001), Comment of International Chamber of Commerce (ICC) (RFC-3 – June 18,

2001), Comment of European Brands Association (AIM) (RFC-2 – December 20, 2000), Comment of ACM Internet Governance Project (RFC-1 – September 15, 2000).

[301] See Comment of Brazilian Association of Intellectual Property (ABPI) (RFC-2 – December 28, 2000), Comment of Steven Turnbull, University of Tsukuba (RFC-1 – August 29, 2000).

[302] See Comment of Mexico, National Institute of Copyright (RFC-3 – May 30, 2001).

[303] See Comment of Dipcon – Domain Name and Intellectual Property Consultants AB (RFC-2 – December 22, 2000).

[304] See 15 U.S.C., § 1125(a).

[305] See 15 F. Supp.2d 1089 (D.Minn, 2000).

[306] Decision of September 30, 1997 – 4 O 179/97, finding in favor of the UFA-Film-und Fernseh GmbH & Co KG, which had rights in the designation 'UFA'. Similarly, the Munich District Court, in a decision of October 21, 1998 – 1 HK O 167 16/98, found against the domain name registrant of "muenchner-rueck.de", as an unauthorized use of the commercial designation 'Münchner Rückversicherung'.

[307] See, for example, the decision of the Stuttgart Court of Appeal in a decision of February 3, 1998 – 2 W 77/97, finding that "steiff.com" infringed the name rights of the soft toy manufacturer, Steiff.

[308] The Bonn District Court, in a decision of September 22, 1997 – 1 O 374/97, found that the domain name registrant for "dtag.de" had a legitimate interest in his domain and, applying the principle that any person may participate in business under his own name, found that Section 12 of the Civil Code did not apply.

[309] The following ccTLD registration authorities restrict the registration of trade names as domain names: .AD (Andorra), .AM (Armenia), .AT, (Austria), .AU (Australia), .BB (Barbados), .CH (Switzerland), .CO (Colombia), .CY (Cyprus), .ES (Spain), .FI (Finland), .FR (France), .HU (Hungary), .IE (Ireland), .KH (Cambodia), .LT (Lithuania), .NO (Norway), .SA (Saudi Arabia), .SE (Sweden), .SI (Slovenia), .SM (San Marino), .TH (Thailand), .TR (Turkey) and .UK (United Kingdom). The majority of ccTLD administrators impose no restrictions on domain name applications based on trade names as follows: .AR (Argentina), .BE (Belgium), .BF (Burkina Faso), .BG (Bulgaria), .BH (Bahrain), .BN (Benin), .BY (Belarus), .CA (Canada), .CR (Costa Rica), .DE (Germany), .DK (Denmark), .EC (Ecuador), .GE (Georgia), .GT (Guatemala), .HN (Honduras), .HU (Hungary), .KG (Kyrgyzstan), .KH (Cambodia), .KR (Republic of Korea), .LT (Lithuania), .MA (Morocco), .MD (Moldova), .MK (the Former Yugoslav Republic of Macedonia), .MN (Mongolia), .MU (Mauritius), .MX (Mexico), .PT (Portugal), .RO (Romania), .RU (Russian Federation), .SG (Singapore), .UA (Ukraine), .US (United States of America) and .UZ (Uzbekistan).

[310] See Comment of Japan, Ministry of Economy, Trade and Industry (METI) (RFC-3 – July 5, 2001), Comment of Michael Froomkin (RFC-3 – June 4, 2001).

[311] See Comment of Nominet UK (RFC-3 – June 14, 2001).

[312] See Comment of United Kingdom, The Patent Office (RFC-3 – June 1, 2001), Comment of European Commission (RFC-3 – June 25, 2001), Comment of Associations des Praticiens en droit des Marques et des Modèles (RFC-3 – June 7, 2001), Comment of American Intellectual Property Law Association (AIPLA) (RFC-3 – June 7, 2001), Comment

of Brazilian Association of Intellectual Property (ABPI) (RFC-3 – June 8, 2001), Comment of European Broadcasting Union (EBU) (RFC-3 – June 8, 2001), Comment of International Association for the Protection of Industrial Property (AIPPI) (RFC-3 – June 18, 2001), Comment of Law and Technology Committee, Auckland District Law Society (RFC-3 – June 22, 2001), Comment of Nominet UK (RFC-3 – June 14, 2001), Comment of Christian Mogensen (RFC-3 – April 16, 2001), Comment of Daniel R. Tobias (RFC-3 – April 15, 2001). See also Comment of Australia, Government of Australia (RFC-2 – January 23, 2001), Comment of Republic of Moldova State Agency on Industrial Property Protection (RFC-2 – December 29, 2000), Comment of Asociación Interamericana de la Propiedad Industrial (ASIPI) (RFC-2 – December 26, 2000), Comment of the Association of European Trade Mark Owners (MARQUES) (RFC-2 – December 22, 2000), Comment of European Brands Association (AIM) (RFC-2 – December 20, 2000), Comment of rexco.com (RFC-1 – August 5, 2000), Comment of Matthias Haeuptli (RFC-2 – September 15, 2000).

[313] Indeed, the Administrative Panel in WIPO Case D2000-0025 *SGS Société générale de surveillance S.A. v. Inspectorate* (March 17, 2000) stated: “The Panel considers that the Policy and Rules refer only to identity or similarity to trademarks and service marks in which a complainant has rights. No reference is made in the Policy and Rules to *trade names* in which a complainant has rights.” In another WIPO Case D2000-0638 *Manchester Airport PLC v. Club Club Limited* (August 22, 2000), the three-member Administrative Panel found against a Complainant who had asserted that the domain name registered by the Respondent was identical to a name under which it traded, and that the respondent was passing off of the complainant's unregistered rights in its corporate name. The majority of the Panel found that there was insufficient evidence of corresponding trademark rights in the name and that the UDRP did not address passing-off.

[314] See Comment of *Fédération internationale des conseils en propriété industrielle* (FICPI) (RFC-3 – June 14, 2001), Comment of International Trademark Association (INTA) (RFC-3 – May 24, 2001), Comment of Chris Brand (RFC-3 – April 16, 2001), Comment of Michael Froomkin (RFC-3 – June 4, 2001).

[315] See Comment of Switzerland, Swiss Federal Institute of Intellectual Property (RFC-3 – June 15, 2001).

[316] See Comment of Hungary, Hungarian Patent Office (RFC-3 – June 13, 2001), Comment of *Fédération internationale des conseils en propriété industrielle* (FICPI) (RFC-3 – June 14, 2001), Comment of International Chamber of Commerce (ICC) (RFC-3 – June 18, 2001). See also Comment of United States of America, United States Council for International Business (RFC-2 – December 29, 2000), Comment of European Brands Association (AIM) (RFC-2 – December 20, 2000), Comment of 14us2.com (RFC-1 – August 15, 2000), Comment of Ben Hwang (RFC-1 – August 11, 2000), Comment of Edwin Philogene (RFC-1 – August 11, 2000).

[317] See Comment of Brazilian Association of Intellectual Property (ABPI) (RFC-2 – December 28, 2000).

[318] See Comment of Bernard H.P. Gilroy (RFC-1 – August 11, 2000), Comment of Jay Orr (RFC-1 – August 14, 2000).

[319] See Comment of United States of America, Office of Advocacy, U.S. Small Business Administration (RFC-3 – June 15, 2001).

[320] See Comment of Gregory Rippel, U.S. Realty Corp. (RFC-1 – August 19, 2000), Comment of John Apolloni (RFC-1 – August 14, 2000), Comment of Alexander Svensson (RFC-2 – December 21, 2000).

[321] See Comment of United Kingdom, The Patent Office (RFC-3 – June 1, 2001), Comment of Frank Azzurro (RFC-1 – August 15, 2000).

[322] See Comment of American Civil Liberties Union (ACLU) (RFC-2 – December 29, 2000), Comment of Leah Gallegos, TLD Lobby (RFC-1 – August 16, 2000), Comment of NewsBank, Inc. (RFC-1 – August 12, 2000), Comment of Edwin Philogene (RFC-1 – August 11, 2000), Comment of Joseph Fowler (RFC-1 – August 11, 2000), Comment of Atilda Alvarido (RFC-1 – August 12, 2000).

[323] See Comment of Hungary, Hungarian Patent Office (RFC-3 – June 13, 2001), Comment of Mexico, Mexican Institute of Industrial Property (IMPI) (RFC-3 – June 5, 2001), Comment of European Commission (RFC-3 – June 25, 2001), Comment of Law and Technology Committee, Auckland District Law Society (RFC-3 – June 22, 2001).

[324] See Comment of Forrester Rupp (RFC-1 – August 14, 2000), Comment of Security Privacy and Internet Equity Symposium of 16/12/00 of the Key West Institute S6/Consortium Board (RFC-2 – December 22, 2000).

[325] See Comment of Australia, Government of Australia (RFC-2 – January 23, 2001).

[326] See Comment of American Civil Liberties Union (ACLU) (RFC-2 – December 29, 2000).

[327] See, for example, Comment of American Intellectual Property Law Association (AIPLA) (RFC-3 – June 7, 2001).

[328] See Comment of Australia, Government of Australia (RFC-2 – January 23, 2001).

[329] See Comment of American Intellectual Property Law Association (AIPLA) (RFC-2 – December 29, 2000).

[330] See Comment of Weikers & Co., Attorneys at Law (RFC-1 – August 11, 2000).

[331] See Comment of Security Privacy and Internet Equity Symposium of 16/12/00 of the Key West Institute S6/Consortium Board (RFC-2 – December 22, 2000), Comment of Mark James Adams, Raysend (RFC-1 – August 11, 2000).

[332] See UDRP Rule 4.b. See Comment of Australia, Government of Australia (RFC-2 – January 23, 2001).

[333] See Comment of Switzerland, Swiss Federal Institute of Intellectual Property (RFC-2 – December 29, 2000).

[334] See Comment of Security Privacy and Internet Equity Symposium of 16/12/00 of the Key West Institute S6/Consortium Board (RFC-2 – December 22, 2000), Comment of Raysend (RFC-1 – August 11, 2000).

[335] See Comment of The Law Society of Scotland (RFC-2 – January 4, 2001).

[336] See Comment of International Trademark Association (INTA) (RFC-2 – January 4, 2001).

[337] Statistics by NetNames at <http://www.netnames.com>

[338] The Chairman of the U.S. House Judiciary Subcommittee on Courts, the Internet and Intellectual Property set forth the issues at an oversight hearing on the Whois database 'Privacy and Intellectual Property Issues' as follows: "The policies controlling the access and use of this information imply many things, including privacy issues, the ability to enforce intellectual property rights, empowering parents and consumers, aiding law enforcement in public safety activities, and important First Amendment Rights." (See the proceedings of the Subcommittee on Courts, the Internet and Intellectual Property Committee on the Judiciary, U.S. House of Representatives, Washington, D.C., July 12, 2001 at <http://www.house.gov/judiciary/4.htm>). See also presentation of Mr. Paul Hughes, Public Policy Advisor, Adobe Systems USA, on 'Domain name registrant contact details', at the WIPO Conference on Intellectual Property Questions Relating to ccTLDs (February 20, 2001) at <http://ecommerce.wipo.int/meetings/2001/cctlds/presentations/hughes.pdf>.

[339] See testimony of Stevan D. Mitchell, Vice President, Intellectual Property Policy, Interactive Digital Software Association, before the Subcommittee on Courts, the Internet and Intellectual Property Committee on the Judiciary, U.S. House of Representatives, Washington, D.C., July 12, 2001 (at http://www.house.gov/judiciary/mitchell_071201.htm).

[340] See Comment of Motion Picture Association of America, Inc. (MPAA) (RFC-3 – June 6, 2001). See also Comment of the United States Council for International Business (USCIB) (RFC-2- December 29, 2000).

[341] See Comment of Australia, Australian Competition & Consumer Commission (ACCC) (RFC-3- June 15, 2001), Comment of Hungary, Hungarian Patent Office (RFC-3 – June 13, 2001), Comment of United Kingdom, The Patent Office (RFC-3 – June 1, 2001), Comment of United States of America, U.S. Patent and Trademark Office (RFC-3 – June 14, 2001), Comment of American Intellectual Property Law Association (AIPLA) (RFC-3 – June 7, 2001), Comment of Brazilian Association of Intellectual Property (ABPI) (RFC-3 – June 8, 2001), Comment of Copyright Coalition on Domain Names (CCDN) (RFC-3 – June 7, 2001), Comment of International Association for the Protection of Industrial Property (AIPPI) (RFC-3 – June 18, 2001), Comment of International Trademark Association (INTA) (RFC-3 – May 24, 2001), Comment of Law and Technology Committee, Auckland District Law Society (RFC-3 – June 22, 2001), Comment of Motion Picture Association of America, Inc. (MPAA) (RFC-3 – June 6, 2001). See also Comment of Verizon (RFC-2 – December 26, 2000).

[342] The Copyright Coalition on Domain Names submitted that these services are also important for advancing law enforcement, consumer protection, parental control and other social policies in the online environment. See Comment of the Copyright Coalition on Domain Names (CCDN) (RFC-2 – December 28, 2000).

[343] At the time of writing, the ICANN Names Council Whois Committee has received over 1900 comments as part of its consultation process on this issue. See <http://www.icann.org/dns/whois-survey-en-10jun01.htm>.

[344] See Report of the first WIPO Internet Domain Name Process, paras 74-81.

[345] WIPO recommended that domain name applicants should be required to provide the following information: full name of the applicant; applicant's postal address, including street address or post office box, city, State or Province, postal code and country; applicant's e-mail address; applicant's voice telephone number; applicant's facsimile number, if available; and where the applicant is an organization, association or corporation, the name of an authorized person (or office) for administrative or legal contact purposes. See Report of the first WIPO Process, para. 73.

[346] See Report of the first WIPO Process, paras. 74 -81.

[347] See ICANN Registrar Accreditation Agreement, Art. II.F(1).

[348] The President of the International Anticounterfeiting Coalition (IACC), Timothy P. Trainer, testified before the U.S. House of Representatives Subcommittee oversight hearing on the Whois database 'Privacy and Intellectual Property Issues', and encouraged the United States Government to urge ICANN to "pay more attention to the implementation and enforcement of the registrars' [Registrar Accreditation Agreements] obligations and to increase its efforts to restore WHOIS at least to the level of usability that the public enjoyed up until the advent of registrar competition in 1999. Since the gTLD WHOIS environment provides a template for these services in other parts of the DNS, increased attention here could improve accountability and transparency throughout the Internet." (Testimony before the Subcommittee on Courts, Internet and Intellectual Property Committee on the Judiciary, U.S. House of Representatives, Washington, D.C., July 12, 2001, at the oversight hearing on the Whois database 'Privacy and Intellectual Property Issues' at http://www.house.gov/judiciary/trainer_071201.htm).

[349] See, for example, Comment of Hungary, Hungarian Patent Office (RFC-3 – June 13, 2001).

[350] See Report of the first WIPO Process, paras. 117-119.

[351] See ICANN Statement of Registrar Accreditation Policy, Art II.J (7)a. (approved November 4, 1999) at <http://www.icann.org/nsi/icann-raa-04nov99.htm>.

[352] See ICANN Statement of Registrar Accreditation Policy, Art II.F (approved November 4, 1999) at <http://www.icann.org/nsi/icann-raa-04nov99.htm>.

[353] See Comment of the Copyright Coalition on Domain Names (CCDN) (RFC-2 – December 28, 2000). The ICANN policy for allocation of new gTLDs asks: "Does the proposal make adequate provision for Whois service that strikes an appropriate balance between providing information to the public regarding domain-name registrations in a convenient manner and offering mechanisms to preserve personal privacy?" See ICANN Criteria for Assessing TLD Proposals, August 15, 2000, para.8 (d) at <http://www.icann.org/tlds/tld-criteria-15aug00.htm>.

[354] See Comment of Hungary, Hungarian Patent Office (RFC-3 – June 13, 2001), Comment of United States of America, Office of Advocacy, U.S. Small Business Administration (RFC-3 – June 15, 2001), Comment of American Intellectual Property Law Association (AIPLA) (RFC-3 – June 7, 2001), Comment of Brazilian Association of Intellectual Property (ABPI) (RFC-3 – June 8, 2001), Comment of International Trademark Association (INTA) (RFC-3 – May 24, 2001), Comment of Motion Picture Association of America, Inc. (MPAA) (RFC-3 – June 6, 2001).

[355] See 'Intellectual Property Protection in the New TLDs', *Intellectual Property Constituency (IPC) of the DNSO*, August 24, 2000, at http://ipc.songbird.com/New_TLD_Safeguards.htm.

[356] The list of accredited registrars is updated regularly at <http://www.icann.org/registrars/accredited-list.html>

[357] See <http://www.uwhois.com>.

[358] See Comment of Copyright Coalition on Domain Names (CCDN) (RFC-2 – December 28, 2000).

[359] See Comment of Commercial Internet eXchange Association (CIX) (RFC-2 – December 29, 2000), stating that “CIX urges that particular attention be given to the fissures that have appeared in WHOIS database lookup services and that priority be given to restoring their integrity.”

[360] See ICANN’s Registrar Accreditation Agreement, approved November 4, 1999, (Section II.F(4)) at <http://www.icann.org/nsi/icann-raa-04nov99.htm#IIF>.

[361] See Comment of Copyright Coalition on Domain Names (CCDN) (RFC-2 – December 28, 2000).

[362] See Comment of Copyright Coalition on Domain Names (CCDN) (RFC-3 – June 8, 2001).

[363] See Comment of Brazilian Association of Intellectual Property (ABPI) (RFC-3 – June 8, 2001).

[364] “INTA has been an active advocate in ICANN, Europe and the U.S. Congress, on the need for a fully searchable, open and freely available Whois database that works across a variety of platforms despite the growing number of registration authorities inputting data into such databases. The trademark community has faced numerous problems in accessing information and obtaining accurate information from the Whois database over the past several years.” See Comment of International Trademark Association (INTA) (RFC-1 – September 11, 2000).

[365] See Comment of the United States Council for International Business (USCIB) (RFC-2 – December 29, 2000). See generally ‘Matters Related to WHOIS’ *DNSO Intellectual Property Constituency*, March 3, 2000 – paper prepared for the ICANN meeting in Cairo, Egypt - at http://ipc.songbird.com/whois_paper.html.

[366] See Comment of Brazilian Association of Intellectual Property (ABPI) (RFC-3 – June 8, 2001). See also Comment of Copyright Coalition on Domain Names (CCDN) (RFC-2 – December 28, 2000).

[367] The WIPO ccTLD Best Practices document (Version 1) was posted on June 20, 2001 at <http://ecommerce.wipo.int/domains/cctlds/bestpractices/bestpractices.html>.

[368] See Comment of United States of America, U.S. Patent and Trademark Office (RFC-3 – June 14, 2001), Comment of Copyright Coalition on Domain Names (CCDN) (RFC-3 – June 7, 2001), Comment of Motion Picture Association of America, Inc. (MPAA) (RFC-3 – June 6, 2001).

[369] See Comment of United Kingdom, The Patent Office (RFC-3 – June 1, 2001), Comment of European Commission (RFC-3 – June 25, 2001), Comment of Law and Technology Committee, Auckland District Law Society (RFC-3 – June 22, 2001), Comment of Nominet UK (RFC-3 – June 14, 2001).

[370] See Report of the first WIPO Process at paras. 87-90.

[371] See Comment of Copyright Coalition on Domain Names (CCDN) (RFC-3 – June 7, 2001). See also Comment of American Intellectual Property Law Association (AIPLA) (RFC-3 – June 7, 2001), Comment of Motion Picture Association of America, Inc. (MPAA) (RFC-3 – June 6, 2001).

[372] For general information concerning national and international developments in privacy and data protection law and principles, see <http://www.privacyexchange.org/>.

[373] The ACLU also noted that the collection and free availability of personal data of registrants could stifle free speech by removing anonymity, and may expose users to unwanted commercial mail. See Comment of the American Civil Liberties Union (ACLU) (RFC-2 – December 29, 2000).

[374] See Comment of European Commission (RFC-3 – June 25, 2001). See also the International Working Group on Data Protection in Telecommunications, Common Position, adopted May 2000 at <http://www.datenschutz-berlin.de>.

[375] European Parliament Directives dealing with privacy and data protection issues include; Directive 97/66/EC of the European Parliament and Council of 15 December 1997, concerning the processing of personal data and the protection of privacy in the telecommunications sector; Directive 97/7/EC of the European Parliament and of the Council of 20 May 1997, on the protection of consumers in respect to distance contracts Directive 95/46/EC of the European Parliament and of the Council of 24 October 1995, on the protection of individuals with regard to the processing of personal data and on the free movement of such data.

[376] See Comment of Nominet UK (RFC-3 – June 14, 2001).

[377] See Comment of United States of America, Office of Advocacy, U.S. Small Business Administration (RFC-3 – June 15, 2001), Comment of United Kingdom, The Patent Office (RFC-3 – June 1, 2001), Comment of Law and Technology Committee, Auckland District Law Society (RFC-3 – June 22, 2001), Comment of Nominet UK (RFC-3 – June 14, 2001).

[378] See Comment of International Trademark Association (INTA) (RFC-3 – May 24, 2001).

[379] See the collection of such activities listed at 'Online and Internet Principles, Guidelines and Statements' at <http://www.privacyexchange.org/>.

[380] See Comment of Copyright Coalition on Domain Names (CCDN) (RFC-3 – June 7, 2001).

[381] For a collection of national laws on privacy, see the PrivacyExchange omnibus and sectoral Legal Library collection at <http://www.privacyexchange.org/>.

[382] See 'Matters Related to WHOIS' DNSO Intellectual Property Constituency, March 3, 2000 – paper prepared for the ICANN meeting in Cairo, Egypt - at http://ipc.songbird.com/whois_paper.html.

[383] For example, see Comment of Hungary, Hungarian Patent Office (RFC-3 – June 13, 2001), Comment of Switzerland, Swiss Federal Institute of Intellectual Property (RFC-1 – September 15, 2000).

[384] The situation is otherwise for famous and well-known marks; see Chapter 4 of the Report of the first WIPO Process.

[385] See <http://www.io.io>.

[\[386\]](#) See, for example, Comment of Hungary, Hungarian Patent Office (RFC-3 – June 13, 2001), Comment of Susan Isiko (RFC-1 – September 15, 2000). See also comments by Vinton Cerf that “[i]t may become essential to have a table look-up and directory service to decouple the web and trade marks” in J. Nurton and R. Cunningham ‘Can technology tame the net? Profile : Vinton Cerf, MCI Worldcom’, *International Internet Law Review*, July-August 2000, at 14.

[\[387\]](#) See Comment of Switzerland, Swiss Federal Institute of Intellectual Property (RFC-2 – December 12, 2000).

[\[388\]](#) See Comment of International Association for the Protection of Industrial Property (AIPPI) (RFC-3 – June 18, 2001).

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The Recognition of Rights and the Use of Names in the Internet Domain Name System

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WIPO 2 Process

Comments Received by WIPO

[process2-comments] WIPO-2 RFC-3

To: process.mail@wipo.int

From: "American Intellectual Property Law Association" <mkirk@aipla.org>

Subject: RFC-3

Date: Thu, 7 Jun 2001 23:03:04 +0200

Name: Michael Kirk

Organization: American Intellectual Property Law Association

Position: Executive Director

I am pleased to submit the comments of the American Intellectual Property Law Association on the Second WIPO Internet Domain Name Process.

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AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION

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Comments of the
American Intellectual Property Law Association
on the Request for Comments in the
Second WIPO Internet Domain Name Process

The American Intellectual Property Law Association (AIPLA) is pleased to present the following comments with respect to the World Intellectual Property Organization (WIPO) document entitled the “Interim Report of the Second WIPO Internet Domain Name Process” (WIPO2 RFC-3) dated 12 April 2001.

The AIPLA is a bar association whose more than 12,000 members are primarily lawyers in private and corporate practice, in government service, and in the academic community. AIPLA members comprise a wide and diverse spectrum of individuals involved directly or indirectly in the practice of patent, trademark, copyright, trade secret and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property, including many large and small businesses that make commercial use of the Internet via web sites or otherwise provide services over the Internet.

I. Introduction

AIPLA submitted a prior comment as part of the Second WIPO Internet Domain Name Process. We now provide additional comments in response to some of the more specific points in WIPO’s Interim Report. The primary concern of AIPLA is that WIPO not make any proposals or recommendations that deviate from established rules or norms of intellectual property law.

II. Comments

A. International Nonproprietary Names (INNs)

The exclusion list approach might be suitable, because there appears to be an inherent conflict between Internet domain names (only one entity may own and use each domain name) and INNs (everyone is entitled to use these generic identifiers). AIPLA, however, remains concerned that an exclusion list might interfere with existing rights and legitimate interests.

An exclusion list for INNs presumably would prohibit public interest health organizations or governmental organizations from using INNs as domain names. This could lead to consumer confusion if existing sites operated by such entities use certain INNs as domain names. It is well-known that many Internet consumers begin looking for information on certain topics by typing in the topic name followed by .com or some other gTLD.

For these reasons, AIPLA believes the exclusion list approach is an idea that warrants further consideration. We do not support the adoption of an exclusion list for INNs at this time. More information is needed and other alternatives should be more fully considered.

In addition, AIPLA does not believe that limiting an exclusion list (if such an approach is adopted) to “open gTLDs” will be entirely effective. Some of the newly approved gTLDs are ostensibly restricted, but may be open to many of the same entities that currently use INNs as domain names. For example, the .biz gTLD will be limited to “businesses,” a limitation that presumably would not exclude any pharmaceutical companies, drug store companies, or health care providers. For this reason, we believe the exclusion list approach, if ultimately adopted, should be applied to restricted gTLDs, as well.

B. International Intergovernmental Organizations (IIOs)

AIPLA believes that most IIOs receive adequate protection under the UDRP. That process protects IIO names or acronyms that are also trademarks.

Our association also recognizes, however, that some IIO names are not used as trademarks and, for that reason, would be denied protection under the UDRP. We do not oppose extending protection to IIO names that are distinctive. If such protection is afforded, AIPLA believes the UDRP is the best way to provide that protection. IIOs that are trademarks may use the current UDRP, and so expanding the UDRP to cover IIO names that are distinctive seems to make sense.

AIPLA opposes the use of an exclusion list for IIO names. Such an approach may sweep too broadly here. The UDRP is preferred because it protects existing rights and legitimate interests. An exclusion list would preclude legitimate trademarks or trade names that also happen to be IIO names. AIPLA believes that such an infringement upon legitimate business interests is unwarranted and inappropriate.

AIPLA believes that IIO names and acronyms should be protected under the UDRP. We are concerned, however, by the fact that some IIO acronyms are the same as acronyms, trademarks, or trade names used by other organizations. If protection for IIO acronyms is provided (i.e., beyond the protection currently provided to such acronyms that also function as trademarks), we believe such protection should be limited by existing legitimate rights and the IIO should establish that the acronym is distinctive and actually used by the IIO as an identifier.

If the UDRP is expanded to protect IIO names and acronyms, that protection also should extend to domain names that are confusingly similar to IIO names or acronyms. The UDRP currently is used to protect trademarks against identical or confusingly similar domain names and there has been no apparent problem with such coverage. We believe IIO names and acronyms should be afforded the same scope of protection, subject, of course, to the UDRP’s express protection of existing rights and legitimate interests.

C. Personal Names

From an intellectual property perspective, AIPLA continues to believe the UDRP provides enough protection against abusive registration and use of personal names as domain names. In many instances, personal names are abused because of the fame of the name and the commercial

value of the name. In such instances, the personal name may be a trademark and, if so, would be protected under the UDRP. As we noted in our previous comment, several UDRP decisions have protected personal names that also function as trademarks. It may, however, be useful to amend the UDRP to specifically note that the definition of trademarks can include personal names that serve as common law trademarks.

We also recognize the legitimate concerns over the misuse of personal names generally. Therefore, we do not oppose the limited personality right claim described in WIPO's Interim Report. That personality right is defined by the proposed UDRP cause of action set forth in the Interim Report and is provided below.¹

D. Geographic Indications

1. IP-related geographic indications

WIPO defined indications of source as designations of the geographic origin of goods at a national or regional level (e.g., made in U.S.A.). Geographical indicators were defined as a sub-category of indications of source and identify a region within the source area from which particular goods originate (e.g., Napa Valley). These geographic identifiers have received IP protection under many national laws and several international treaties and agreements.

WIPO concluded that the current UDRP provides inadequate protection to these two types of geographic identifiers. While many indications of source and geographical indications are treated as trademarks in some countries, that is not universally the case. If such an identifier is legally protected in the country in which the identifier is used, but is not regarded as a trademark (i.e., the identifier is protected under some other law), the UDRP is unavailable for protecting the identifier. WIPO viewed this result as anomalous and, therefore, recommended modifying the UDRP to protect all geographical indications and indications of source.

To remedy this apparent imbalance, WIPO recommended an expansion of the UDRP to cover all abusive registrations of geographical indications and indications of source as domain names in all open gTLDs. We favor the use of the UDRP for these situations, rather than the use of an exclusion list, because the UDRP protects legitimate interests and non-infringing users. The recommended expansion would broaden the definition of "Applicable Disputes" to include

¹ The proposed new cause of action follows:

- (i) The personal name must be shown to be sufficiently *distinctive* in the eyes of the relevant public, such that it clearly identifies the complainant in question;
- (ii) There must be a *commercial* exploitation of the personal name through its registration and use as a domain name;
- (iii) The commercial exploitation must be *unauthorized*;
- (iv) *Bad faith* must be demonstrated, which can be shown through the illustrative and non-exhaustive factors currently listed under the UDRP, with an additional factor as follows:
 - facts that indicate an intentional effort to take advantage of the reputation or goodwill in the personal identity of the person; and
- (v) The interests of freedom of speech and the press need to be taken into account, such that application of this personality right in the DNS should only prohibit use of the personal name for commercial purposes (i.e., cases of alleged libel and slander would not fall within the scope of the procedure).

disputes involving these two types of geographic identifiers. In addition, the UDRP's illustrative lists of circumstances evidencing abusive registration and use of trademarks as domain names may need modification to include examples of typical abusive practices involving geographical indications and indications of source. Little change may be needed here, however, as the evidence evaluated by WIPO suggests that these geographical identifiers have been abused in much the same way as trademarks.

WIPO also recognized that an expansion of the UDRP to cover geographical indications and indications of source will create a standing issue. In many cases, no single entity "owns" the geographic identifier, which raises serious questions about what entity or entities should be allowed to bring actions under the UDRP to protect such identifiers.

WIPO made no recommendation on the standing issue. Instead, the following three possible approaches were identified:

- The standing issue would be tied to the law of the country of origin of the geographical indication or indication of source (i.e., only persons authorized under such laws to enforce restrictions concerning the use of these identifiers would be allowed to bring actions under the expanded provisions of the UDRP);
- Only the government of the country of origin would have standing; or,
- Each panel could resolve this issue based on the ordinary rules of private international law (i.e., the complainant would assert standing and the panel would decide if that assertion is correct based on the law the panel decides is applicable to the issue).

The first and second approaches provide greater certainty and predictability. The ad hoc nature of the third approach may result in more inconsistent decisions and may require panelists to evaluate unfamiliar legal issues. Many current UDRP panelists were selected based on their experience and expertise in trademark law. Those qualifications may not adequately prepare a panelist to conduct the type of evaluation contemplated by the third approach. On the other hand, the third approach is the most flexible and may allow UDRP panelists to resolve certain domain name disputes that otherwise would remain unaddressed.

The second approach seems overly limited. While governments should be given standing, it is not clear that national governments have the time or resources to address these types of disputes. The UDRP's success is due, in large part, to its self-policing approach. Allowing trademark owners to bring actions to stop cybersquatting is a sort of private attorneys-general approach that shifts enforcement power to the affected private interest holders. Given the volume of Internet domain name disputes, a failure to give such enforcement power to private entities may effectively cripple the intended reform.

The first approach, therefore, seems better than the second, provided it is interpreted to allow action by governmental entities as well as individuals and corporations. Difficult standing issues may arise under this approach, but the burden would fall to the complainant to clearly demonstrate standing under the country of origin's laws. This type of standing analysis should be easier for panelists to resolve than the ad hoc analysis contemplated by the third approach.

2. Non-IP-related geographic indications

AIPLA does not approve of the abusive registration and use of non-IP geographic indications, such as place names. Perhaps some steps are needed to combat such practices, but AIPLA is unable to formally endorse any specific measure at this time.

We oppose the adoption of an exclusion list for non-IP-related geographic indications because such an approach would not protect existing rights and legitimate interests. The use of place names as trademarks is common and an exclusion list presumably would prohibit use of such trademarks as domain names. Such a result is inappropriate and conflicts with the central findings of the First WIPO Internet Domain Name Process (i.e., that trademark owners have the legal right to use their trademarks as domain names and that such uses should be protected, not prohibited).

AIPLA is concerned that protecting non-IP-related geographic indications might go beyond the scope of existing law. With this point in mind, AIPLA cautiously endorses the new UDRP cause of action for place names identified in the Interim Report. We believe that limiting standing to national authorities effectively brings the new cause of action within the scope of existing law. We also believe that the elements of the cause of action should protect entities using such place names as valid trademarks or trade names.

E. Trade Names

Many trade names are also trademarks and, therefore, are already protected under the UDRP. Our association also favors appropriate protection of trade names against unfair competition. To the extent that protection of trade names under the UDRP is based on existing intellectual property law, AIPLA supports such protection.

In our view, the new UDRP cause of action for trade names is consistent with existing law. The proposed trade name cause of action closely tracks the provisions of the current UDRP, provisions that are based on established principles of trademark law. AIPLA believes that current unfair competition law would provide essentially the same scope of protection to trade names.

We recognize that trade names are defined and used differently around the world. This fact creates difficulty in applying the new trade name cause of action because in some instances it will be difficult to determine whether the asserted name is actually a trade name. AIPLA approves of the multi-factor analysis proposed by WIPO to determine if a particular name is a trade name.

F. Technical Issues

AIPLA strongly supports all efforts to ensure that full and accurate WHOIS data is provided via a publicly searchable gateway. The existing domain name registration agreement and the registrar agreement require that domain name owners submit certain contact information and that the registrars make such information available. Unfortunately, not all domain name owners provide accurate information and not all registrars provide the information in a user friendly manner.

We believe it is important to have a tool to search WHOIS data across the databases of all registrars. This need will soon become acute when the seven new gTLDs come online, because each of these new domains will exist in a new registry database. It should be possible to conduct a single search and obtain WHOIS data held by any registrar or registry. Obtaining such information is crucial to proper enforcement of intellectual property rights.

This approach is not an invasion of domain name owners' privacy. The registration agreement already requires that domain name owners provide such information. The approach advanced here simply calls for enforcing the existing requirements and making the existing data reasonably accessible. Moreover, the contact information is provided only by persons who register and own domain names, which is clearly a voluntary activity that carries with it certain costs.

AIPLA remains interested in technical measures designed to prevent, minimize, or resolve Internet intellectual property disputes. We are wary, however, about such measures. Often, such measures simply shift the dispute from one context to another.

We appreciate the transparency and inclusiveness of the process by which WIPO has sought to obtain comments on the "Interim Report of the Second WIPO Internet Domain Name Process" as well as the opportunity to submit our views on the identified topics. We look forward to receiving the final report.

[process2-comments] WIPO-2 RFC-3

To: process.mail@wipo.int

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Please read attached document (Spanish version), English version available in
<http://www.cabase.org.ar/wipo/wipo.html>

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[cabase_wipo_2_rfc_3.doc](#)

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Versión original en español disponible en: <http://www.cabase.org.ar/wipo/wipo.html>

Formal comments to the Interim Report:

WIPO-2 / RFC-3

The recognition of rights and the use of names in the Internet Domain Name System

By:

Cámara Argentina de Bases de Datos y Servicios en Línea (CABASE)

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June 2001

About CABASE :

The Argentine Chamber of Databases and Online Services (CABASE) was created in 1989 to bring together companies working on the Internet, Electronic Commerce, Contents, and Online Services. CABASE hosts the first private NAP (Network Access Point) in Latin America, providing connection to over 40 ISPs and academic and government institutions. At the international level, it is founding partner of eCOM-LAC and LACNIC.

INTRODUCTION

CABASE is thankful for the opportunity of issuing its opinions in this consulting process that directly affects those of us working on the Internet as well as consumers.

Our associates include ISPs, carriers, ASPs, news agencies, information companies, retailers, banks, authors, scholars, etc., so the scope of our concern is broad and the concepts below consider previous consultation among our various members.

These recommendations arise from a previous analysis, so we shall further the concept as we participate in the processes to come.

Nevertheless, we unanimously share the following essential principles, not necessarily in order of importance:

1. Internet development must be supported.
2. All deceptive, harmful, opportunistic, or morally reproachable behavior must be discouraged.
3. A system of rights favoring particular sectors over the rights of others, especially the rights of persons, should not be established.
4. Freedom of expression, pluralism, equality, and privacy should be furthered and in no way hindered or limited.
5. No measure should limit "connectivity" or "interactivity", which are essential functions of the Internet, making it what it is.

Given the dissimilar interests, legislation, uses and practices of different regions or communities, and, especially, because of the novelty of implementation, we suggest a thorough consulting process.

The characteristics of globalization and automaticity in the register and UDRP systems require a substantial harmonization, and any norm that may prove restrictive should affect only those simple and harmonized aspects among different jurisdictions and sectors.

On the other hand, care should be taken on what is regulated, in order to avoid an excessive load on procedures that should be automatic and swift, as bureaucratization would stunt the development of the Internet or hinder its potential.

The Internet has given rise to a "new way of perceiving facts", of conducting business and carrying out activities, of interacting with and interpreting or using its various components.

The concept of abundance has prevailed over scarcity and this has been its main fertilizer, so this special feature should be preserved promoting policies that further abundance instead of restriction. The creation of new gTLDs pertains to this point and should be strongly upheld.

We congratulate WIPO for its leadership in this field, but we believe that, given the diversity of actors and the complexity of the issues involved, other institutions holding different points of view should participate, as consumer's associations, telecommunications bodies, and specially international ISPs forums.

GENERAL OBSERVATIONS

On the process in general.

Maintaining original criteria on domain name generation system:

Internet is a means of communications and, fundamentally, of individual free speech, besides a commercial platform.

The name system was not created with strict commercial criteria, so requiring restrictive laws of this kind reduce its comprehensive nature.

The name system was created to locate computers or destinations on the Internet and should not be used for anything else, especially to limit connectivity.

Domain names are not trademarks, trademark's regime fixes unacceptable limitations on domain name usage.

Internet founders and registrars have seriously considered these concepts and have always acknowledged freedom of expression and of personal privacy; this was one of the cornerstones of its extraordinary development.

First In First Served

It should be maintained for all those conflicts where two or more participants hold rights, whatever the nature of these rights may be.

Uniformity and coherence in the results of UDRP processes:

The results of UDRP processes should be uniform as it is an automatic procedure, and there should not be different results over similar issues.

Those who provide dispute resolutions should apply objective and coherent standards in order to avoid diverse interpretations regarding national legal standards, or worse yet, to avoid individual interpretations that, however well-intentioned, may result improper at this early stage.

The limits or scope of UDRP should conform to uniformity of possible and previously agreed results.

What should be avoided is a "resolution mall" where one kind of resolution may be obtained from one provider and other kinds from other providers, for the sake of the providers' credibility and reputation, and that of the whole system as well.

We therefore recommend that:

1. Providers should be assigned by lot to prevent this from take place
2. Fees and procedures provided should be uniform and unique
3. The process among administrators of ccTLDs should be harmonized in order have a unique UDRP for all.

Contents count:

Abusive registration is usually an incomplete and thereby dangerous definition, as it not only the name counts but also the use given to it.

Contents complete the name, as it does not imply everything in or by itself.

Similarity:

We consider that similarity should be allowed, unlike existing limitations in trademarks, because:

1. The use given to a name through content completes the name
2. There is a limited amount of "practical" names available for register that are easy to understand, or type, or recall.
3. Mandatory assignment of absurd names for the sake of differentiation deteriorates a site's accessibility
4. All obstacles on operations to access a site go against connectivity, which is the Internet's raison d'être.

That humans interacting with computers are as much part of the net as any other piece of equipment should also be considered.

To limit the register of other names by similarity, the more names a register holder has, the more limits the system shall have, and the more names the register may claim for itself.

This vicious circle would favor a few while hindering the development of the web and freedom of expression.

Acquired rights:

The deadline to carry out an action against a DN registrant should not exceed one month, after which the right to challenge its property should expire.

A trademark holder may wait for a DN to gain fame and prestige and then blackmail the DN holder, threatening to claim the DN or, even worse, develop the business started by the DN holder.

Trademark laws grant one month for objections and a period not exceeding a year for invalidation requests.

One year in the digital economy is like ten for the traditional economy, so the period should not exceed one month in any case.

Whoever holds a domain name beyond the period allowed for objection or has not received objections until the present must be considered as holding "acquired rights".

This principle also applies to other matters in all civilized laws and should also apply to DNs.

There are many trade and domain name monitoring services, some of them with free options that help fulfill these requirements.

Squatting:

Squatting is not a new occurrence, as it has existed since the creation of trademarks; a trademark by itself does not necessarily imply good faith.

The fact that similarity among names is a limiting factor for registering trademarks encourages squatting. Just one trademark hinders the registration of many others that are similar and the same occurs with domains.

This should not be allowed to prosper in domain name registration; similarity should be allowed.

"Squatting by similarity" might be an unwilling consequence, but it shall in fact operate as if it were intentional, which would damage Internet development and obstruct the rights of many people.

Equal rights of parties:

1- Trademarks.

The rights of those who do not hold trademarks should not be considered as below those of who do hold them. Trademark registration should not be allowed to overpower domain name registration. Otherwise, we would be admitting rights of class.

The need to hold a trademark to sustain or defend a domain name shall restrict the amount of participants and, therefore, Internet expansion.

Moreover, nobody can be required to register any name as a trademark, whatever the use it may be given, as long as the registrant is honest. Trademark registration does not guarantee honesty.

Those who do not hold a trademark should have the same rights as a trademark holder when claiming a domain name.

2- Limitation of resources.

Mediation and arbitration instances should be free of charge for the defendant, even in the case of choosing three panelists, or any other option to be implemented.

It should be like traditional law that provides free of charge defense with the same capabilities as those that are paid for.

These instances are costly for both parties, but an individual is in a weaker position when facing a corporation, as he/she is required to pay for charges that may be faced with greater ease by the corporation.

The result of creating "VIP" clients who possess rights in accordance to what they pay would be a concentration of domain names in few participants with great power.

Pre-emption:

A trademark may have some right over a domain as long as its registration was carried out before the registration of the domain, otherwise, squatting results from trademarks to domains.

If a domain gains recognition before its name is registered as a trademark, use of this trademark should be reassigned to the domain's owner.

Preventive measures against superficial or ungrounded claims:

This kind of claim should be avoided in any process, if bad faith were involved it should be proved during the process.

Otherwise, the challenger without valid reason should be fined.

This will promote the strict foundation of each position and avoid unnecessary procedures.

Definition of terms:

Terms such as "sufficiently" (distinctive), or "celebrity", or "confusingly similar" should not be used without defining its scope.

What has already been defined needs more work and those terms should be employed only within certain limits.

At least, explicit and unique boundaries for each of these terms should always be preserved and there should be no rulings using terms with no established limitations.

Functionality or other features:

Traditionally, trademark law does not allow the expression of properties or the description of a product or service, but this premise should be avoided in the domain name system.

Using a domain name to describe the functionality of a service is adequate, enables identification, and there are numerous cases currently in use, such as www.iptelephony.com, or www.ipvoice.com.

This concept was widely adopted by the Internet community.

The names that include descriptions improve human interface and ease of access depends on understanding the domain name.

Caution:

Expansion of UDRP first requires reviewing its effectiveness and the accuracy and coherence of its decisions, considering complaints or remarks, as well as an assessment of the degree of acceptance within the community it is affecting.

Any modification in the domain name registration system should be treated likewise.

SPECIFIC OBSERVATIONS

Commercial rights should not take over the rights of persons.

Limitations admitted for disputes over denominations or commercial names are applicable to personal names.

Personal Names

These cases should differentiate between the use of a name and the use of a celebrity's attributes. Those are different things.

It is incorrect to misuse certain conditions or features achieved by a celebrity, but the use of an identical name does not necessarily imply this.

Regarding the use of a name, the celebrity has no more rights than any individual.

The case should not be influenced were it to produce material gain, although this benefit would be welcome because of its ability to create progress.

Celebrities:

1- Identical names:

When a person's name becomes a commercial form of identification, it may be considered a trademark, but not necessarily.

This would imply the creation of "celebrity rights" to the detriment of the rights of those who are not "celebrities".

At least in the cases of identical names, if the registrant has a name that is identical, similar, or easily associated to the domain name, the rights to its possession should be acknowledged, whether commercial ventures are taking place or not.

But "contents count", obviously not to design a deceptive "official site" of a celebrity and appropriate its status.

Fan and news sites related with a celebrity must necessarily have a domain name associated to the celebrity in order to be recalled and placed.

In case it refers explicitly to the celebrity and to nobody else, it should be made clear that it is not the official site and have an evident link to it.

This simple procedure prevents misinterpretation.

2- Similarity:

Any domain name that contains any other element besides the name of the celebrity should be allowed.

The case of www.kubrick2001.com is an excellent example of a site devoted to this film. It is impeccably accomplished and well intentioned and provides all of us who were influenced by the film a deeper understanding and delight.

We do not consider it bad faith if commercial gain is obtained from this site, as it is inherent to this site.

For all these cases, it could be explained that it is not the author's or the film's official site and include an evident link to the official site at the top of the first page.

This simple procedure prevents misinterpretation.

Nicknames:

A nickname is not equal to a name, as it may have various meanings or uses. Besides a person's nickname, it may also signify several other things.

Different jurisdictions:

In some jurisdictions no individual may obtain exclusive rights over his or her name (all those with the same name have equal rights), while in others it is the opposite.

In the former, celebrities have the same right as anyone - even having a trademark on their names - and their demands are rejected, while in the latter demands may succeed.

UDRP should only consider harmonized cases.

First in first served should be sustained exclusively for all cases of personal names.

In case of dishonest use, the demand should be sustained on dishonest use alone, not on possession of other rights such as trademarks.

Trade Names

There is no uniform international protection of trade names. Similarities with legitimate rights are frequent.

Similarity among domain names should be allowed without restrictions to entitle access to practical and similar domain names to owners of identical trade names.

First in first served should be sustained exclusively for all these cases.

International Intergovernmental Organizations (IGO)

IGOs should register their names only within the **.int** gTLD, as it was created for their exclusive use.

Abbreviations:

There are numerous identical name cases in acronyms and many persons, associations, or companies have their acronyms as trade names or identifiers, all with legitimate rights.

All real IGOs may be unmistakably identified by the **.int** gTLD, given its exclusiveness, so there is no doubt that when entering a **.int** site, the appropriate IGO is reached.

Furthering IGOs over other institutions or companies shall limit legitimate private activities, hindering freedom of expression and development.

Similarity among domain names should be allowed without restrictions when dealing with acronyms.

First in first served should be sustained exclusively for all these cases.

Consider the case of FTAA (**F**ree **T**rade **A**rea of the **A**mericas and **F**ederation of **T**urkish **A**merican **A**ssociation).

The Turkish organization was formed in 1956, has legitimate rights and should not lose its domain name www.ftaa.org.

Full Names:

The case of full names (without abbreviations) may lend itself to misinterpretation or misuse.

The "contents count" principle should be considered.

These sites may have a link to the official site.

This will allow the creation of sites with opinions on the organization considered, without raising doubts about its nature.

First in first served should be sustained exclusively for all these cases.

There should be identical considerations for government organizations, which were assigned **.gov**.

International Nonproprietary Names (INNs)

Cases of Identical Names:

Conditioning the use of these denominations would limit the right of expression, but it is also true that unlimited use may lead to misinterpretation.

The World Health Organization should be **able to make exclusive use** of domain names based on these names, but within a specific gTLD.

We therefore propose the same treatment as for previous cases: these names should be registered under the **.int** gTLD, and if this is considered inadequate, a new **.inn** gTLD could be created to define these substances.

This would permit the inclusion of pharmaceutical substances and also any other substance that in the future may be considered sensitive.

The same restrictions should be observed for cases of identical names but within other gTLDs, such as explaining it is not the substance's official site.

Moreover, there should be a link to the official site at the top of the first page, as long as its contents refer to the substance only.

Once again, "contents count" and the use given to the name determines it.

First in first served should be sustained exclusively for all these cases.

Cases of similarity:

The use of similar names should not be restricted when the name of the substance is part of the domain name, for example: **inn.pharmaceutical_company.com**, or **inn.name_of_organization.org**, or **inn.name_of_institution.edu**, including subdirectories.

First in first served should be sustained exclusively for all these cases.

Geographical Names or Terms

Governments, municipalities, regions, cities, and others, should register within **.gov** gTLDs or **.gov.country** ccTLDs and leave other gTLDs to persons, companies or organizations.

Preventing a private portal, a tourist or news agency from registering, for example, www.toledo.com would restrict valid commercial activity, or journalistic, artistic, or whatever.

What if a person's name is identical to a city name?

Or if several cities have the same name?

Or if one or several persons have trademarks with that name?

The case of www.toledo.com is typical of a name which can be rightfully claimed by Juan Toledo, María Toledo, Toledo City in Ohio, USA (<http://www.ci.toledo.oh.us>), the city of Toledo in Spain, Toledo Restaurant in Buenos Aires, and any other who may own a site with that name.

First in first served should be sustained exclusively for all these cases, even in ccTLDs, except when local laws consider specific procedures.

Appellations of Origin and Geographical Indications

They have traditionally been referred or applied to products, but in the case of domain names, they may apply to anything, so limiting or conditioning would be irrational from this point of view.

For both cases, regulations shall depend on or be controlled by governmental or international bodies and these names should be available under **.gov** or **.int**.

Also, **.gov** ccTLDs shall have greater restrictions, so the correspondence between the name and the Appellation of Origin and Geographical Name will be unique, while valid identical names shall be restricted.

If the range were not sufficient or inadequate, a new **.geo** or similar TLD should be created.

First in first served should be sustained exclusively for all these cases, even in ccTLDs, except when local laws consider specific procedures.

The Role of Technical Measures

Cross linking databases:

It is a useful service and there are already private companies that supply it. Registrars should not be required to do anything they consider unsuitable.

It is a service provided in a competing market, so the market shall solve it. For example, the Nameprotect service (<http://www.nameprotect.com>). We think that these services will expand the range of the bases currently covered.

The profusion of registrars is a very recent fact and the solution may take some time.

Information contained in WHOIS:

We consider that the data available in WHOIS is adequate and sufficient to identify any contact or holder, and its display is also satisfactory.

The Whois database provides a fair balance between publicity and privacy.

1- Accurate and full data.

The necessary elements to ascertain a holder's identity are provided.

Claims as to "tolerance of inaccurate data provided by holders to avoid legal implications" are incorrect, as supplying false data results in automatic cancellation.

ICANN's Registrar Accreditation Agreement states that *"the willful provision of false or inaccurate contact data constitutes a material breach of the registration agreement and a basis for its cancellation"*.

There could be improvement, for example, with the **voluntary** supply of the following information:

- a) Possession of trademarks, their jurisdiction, etc.
- b) If the site is listed in the stock exchange (this is widely used in many sites), corporate capital, strategic partners, etc.
- c) Tax registration status, export listings, etc.
- d) Any message from the holder to anyone seeking information.
- e) Information on other contacts, office branches, etc.

f) Other relevant material.

But these developments are not essential to the purpose of registration. Registrars should be asked about the convenience of introducing them.

2- Search by name of holder, contact, address, etc.

This instrument allows the public in general to find out how many and which domain names a holder has registered.

We consider that it trespasses personal privacy and that nobody can be required to make this information public.

An individual or a company may be required to release that information only for taxation or legal purposes to the official authorities.

The rights of persons should be preserved and the information currently available in Whois is sufficient for someone who desires to claim a domain name.

Compatibility of Whois database access:

It would be more comfortable if bases and query and publication formats were alike in order to make searches easier.

Anyway, the final outcome on database management should be agreed with registrars, as they operate in a competitive market and are entitled to their individual ideas on how to provide or improve their services. Requiring uniformity should imply restricting registrar's industry development.

Searching among several databases is not that difficult and as there is great demand for matching reports containing data from various registers, some providers are already making them available and improving their original features.

See <http://www.nameprotect.com> and for wider vigilance <http://www.vigilactive.com>, that also includes a content alert system for preventing copyright violations.

Having many registers is a recent event, so the industry cannot be required to solve these problems immediately. There will soon be many new services supplying special - even personalized - results, based on Whois.

Another consideration is that ccTLDs, administered by nics from multiple countries, have different national laws that regulate the availability of personal data. This results in diverse management and availability of data.

Gateway domain names:

This is the idea of making several holders of a domain name share it through a gateway page with links to different addresses.

This should not be a mandatory process and will be used if considered adequate, by means of technical procedures that do not require the participation of others outside those directly involved.

"All roads seem to lead to Rome"

Bear in mind that nobody looks for a domain name, but for the content within a domain name.

As new gTLDs become more numerous, the search for a particular site will be carried out from traditional engines (for instance, Yahoo! and Altavista), because one seeks contents in a site, not its name.

This effect shall increase with identical names in gTLDs operating under parallel root servers, such as www.new.net, www.pacificroot.com, and others.

Most ignore the existence of "parallel domain servers" with **.com**, **.org**, **.whatever**, like those of ICANN. Soon, everyone will be using them.

As a consequence, there will be more than one www.something.com, one under the traditional root server and others under "new" alternative root servers.

There will be www.something.com under ICANN, another www.something.com under New Net, still another www.something.com under Pacific Root, and so on.

This will require a gateway page - such as Yahoo! or Altavista - to locate a content, a company, or anything, since all these sites will have the same name.

What is the reason for creating the instruments that finally lead us to requiring a gateway page? Avoiding scarcity, making everything available to everyone, adding instead of subtracting.

As we see, those involved in trademark law as well as those related with the technical world of the Internet have explored this idea in one way or another.

As it seems that the market's response is to propagate root servers and, therefore, identical domain names, we recommend that:

1. Sharing a domain name should not be mandatory.
2. These new root servers should not be regulated.

Meta-tags shall gain greater importance and so shall each site's contents, since they will provide the identification for the requested page.

Thus, in order to prevent future problems, we recommend that meta-tags remain unregulated. Rules would spoil any intelligent search system.

Buenos Aires, June 7, 2001

We thank Agueda Veronica Takacs for her collaboration and translation of the English version.

Versión original en español disponible en: <http://www.cabase.org.ar/wipo/wipo.html>

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[process2-comments] WIPO-2 RFC-3

To: process.mail@wipo.int

From: "Copyright Coalition on Domain Names" <metalitz@iipa.com>

Subject: RFC-3

Date: Thu, 7 Jun 2001 15:06:22 +0200

Name: Steven J. Metalitz

Organization: Copyright Coalition on Domain Names (CCDN)

Position: Counsel

Attached please find comments of the Copyright Coalition on Domain Names (CCDN) on the Interim Report in the WIPO-2 process. Thank you for this opportunity to present our views.

Steven J. Metalitz

Counsel to CCDN

[CCDN FINAL WIPO-2 RFC-3 comments 060701.doc](#)

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COMMENTS OF COPYRIGHT COALITION ON DOMAIN NAMES on Interim Report of the Second WIPO Internet Domain Name Process

June 7, 2001

The Copyright Coalition on Domain Names (CCDN) appreciates this opportunity to comment on the Interim Report of the Second WIPO Internet Domain Name Process (the “Interim Report”).

CCDN brings together ten major associations of copyright owners (listed at the end of this submission) with a common goal of preserving and enhancing free, unfettered, real-time public access to Whois and other directory services. These tools of the Domain Name System (DNS) are essential for combating online copyright piracy, and for facilitating the licensed use of copyrighted materials online. Robust and publicly available Whois services are also critical for advancing law enforcement, consumer protection, parental control, and other vital social goals in the online environment. All these objectives depend upon accountability and transparency in the DNS: the ability of Internet users to know with whom they are dealing when they visit a particular site. Whois provides this accountability and transparency and is thus a crucial tool for all Internet users.

Of course, many copyright owners are also trademark proprietors. CCDN participating associations and their members have been active advocates for the creation of a Uniform Dispute Resolution Procedure (UDRP) to deal with cybersquatting problems, and have been active users of the UDRP system since its inception.

These comments are directed primarily to chapter 7 of the Interim Report, entitled “The Role of Technical Measures.” We also offer some brief comments on the issue of expansion of the UDRP.

I. Whois Issues

CCDN commends WIPO for its continued recognition of the central importance of unrestricted public access to the most comprehensive, accurate and current registrant contact data possible. Not only is this access essential for the prevention and efficient resolution of intellectual property disputes, it is also vital to the transparency and accountability that are needed to build increased consumer confidence in the Internet and electronic commerce.

In paragraph 335, the Interim Report asks –

“whether the Whois system, as it currently operates, is adequate to fulfil its dispute-prevention function, or whether it should be extended in any of three ways:

- (i) to enable Whois searches across any new open gTLDs;
- (ii) to enable searches across the Whois databases of all registrars; and

(iii) to enable searches across the Whois databases of all registrars for more than just the exact domain name.”

CCDN strongly believes that the existing Whois system should be extended in all three dimensions identified. We are pleased that the two new gTLDs with which ICANN has entered into agreements to date (.biz and .info) both provide for public access to Whois that is at least equal to what is available in the .com/net/org environment, and we are cautiously optimistic that the same will be true for the other five newly recognized gTLDs by the time their agreements with ICANN are concluded. The rapid growth of registrations in the ccTLD environment underscores the importance of establishing the same principle in that portion of the domain name universe, and of enabling members of the public (including but not limited to intellectual property owners) to obtain convenient and efficient access to Whois data across as many registries as possible via a single portal. In this regard, the recent public and binding commitment by Verisign to devote a portion of its US\$200 million research and development fund to dealing with the technical challenges in so-called “Universal Whois” is potentially an exceptionally positive development. Finally, the ability to search on the basis of Whois data elements other than the exact domain name is a key functionality which needs to be restored to Whois as broadly as possible, in order to enhance its effectiveness as a tool for investigating and resolving instances of cybersquatting, piracy and other intellectual property problems.

We now turn to the specific Whois-related recommendations of the Interim Report on which WIPO seeks comment.

(341) It is recommended that the obligation to provide accurate, reliable and publicly accessible Whois data should be required of each registration authority in all gTLDs, existing and future.

CCDN strongly supports this recommendation. As noted above, it appears to reflect the practice so far in the expansion of the gTLD name space, and should be spelled out in any future expansion rounds that ICANN undertakes.

(345) Comments are sought as to whether it is practical or appropriate to enhance the functionality of the existing Whois, to enable searches across all relevant registrar databases on the basis of search criteria in addition to the exact domain name.

CCDN believes it is both practical and appropriate to enhance existing Whois functionality in the ways noted, and indeed that it is essential to do so if Whois is to achieve its full potential as a dispute prevention and resolution tool. We do not underestimate the technical obstacles that may need to be overcome to achieve this objective, however, and for that reason commend Verisign for its public commitment to devote significant R&D resources to this problem over the next 18 months.

With regard to the ability to search Whois on the basis of data elements other than the exact domain name, CCDN notes the previously stated views of ICANN staff that all registrars subject to the Registrar Accreditation Agreement are already required by the terms of that document to provide such enhanced searchability for gTLD registrations which they have sponsored. Enforcing this obligation is one of several significant implementation challenges ICANN faces in this sphere.

(347) It is recommended that administrators of ccTLDs be encouraged to adopt policies for the collection, verification and public availability of Whois data via online databases, that are uniform, to the greatest extent possible, with the Whois system at a gTLD level.

This is another recommendation that CCDN strongly supports. In this regard, we note that the work WIPO is already undertaking in its ccTLD program is highly relevant and constructive here. The WIPO ccTLD Best Practices for the Prevention and Resolution of Intellectual Property Disputes represent a concrete step forward toward the implementation of this recommendation. We urge WIPO to continue and step up its efforts to encourage ccTLDs to implement Whois policies that are consistent with these Best Practices.

(352) It is recommended that principles of access to and use of Whois data should be codified, to take into account issues of data protection and privacy. Submissions are sought on this issue.

CCDN generally agrees with the discussion in the Interim Report of the sometimes controversial and often misunderstood topic of the compatibility of unrestricted public access to Whois with privacy and data protection laws. We believe that paragraph 351 of the Interim Report adequately capsulizes the key points, which we would restate as follows:

- (1) Protection of privacy and security of registrant contact data are key responsibilities of domain name registration authorities (registries and registrars);
- (2) Registrants should be clearly informed about how their contact data will be used, including about public disclosure of this data via Whois, before or at the time they are asked to submit it;
- (3) Registrant contact data collected pursuant to such informed consent procedures should continue to be made publicly available through Whois;
- (4) Public access to registrant contact data through Whois, and bulk commercial access to registrant contact data for the purpose of re-use, are conceptually distinct issues with markedly different implications for privacy protection.

Data protection and privacy laws on the national level vary dramatically around the world, and WIPO should be careful to resist any temptation to recognize the particular legal approach taken by any one nation or group of nations as dispositive or even exemplary. In such an

environment, in which no international legal instrument exists that can be said to impose any binding discipline on national laws, it is somewhat difficult to speak of “codification.” However, to our knowledge the Interim Report is entirely correct in its assertion that “most national laws designed to protect privacy do not restrict the making available of contact data pursuant to contractual agreement, or on the basis of a competing public interest of higher priority, such as consumer protection or law enforcement.” Indeed, we know of no example to the contrary; it appears that no country or group of countries has enacted a law making privacy of registrant contact data an absolute value that necessarily prevails over countervailing considerations of consent, contract, or public interest. It may be useful for WIPO to underscore these points in its final report, and, building on its recommendations in the ccTLD Best Practices document, to recommend that the well-established principles of unrestricted public access to registrant contact data through Whois should apply across all registries, absent an explicit, mandatory and public legal directive to the contrary that is (1) based upon a specific national legal provision and (2) arrived at in an appropriately transparent manner comporting with due process.

353) Comments are sought on whether a comprehensive Whois search facility raises particular privacy implications that need to be taken into account.

We do not believe that such a facility (the so-called “universal” or cross-registry Whois) raises any privacy issues distinct or different from those already addressed in our response to the previous recommendation.

II. Expansion of the UDRP

CCDN reiterates its view, expressed in its comments to the WIPO2 RFC-2, that the issue of expanding the Uniform Dispute Resolution Process (UDRP) to deal with new subject matters should be approached with care. In our view, the existing UDRP has worked well for the narrow purpose for which it was created. The smooth functioning of that system is likely to be stressed by the increased demands arising from extension of the UDRP to new global Top Level Domains. These demands will include an expansion of dispute resolution services to cover adjudication (1) of claims that registrations in some of the new gTLDs violate the publicly stated restrictions on who may register, and for what purpose; and (2) of claims of entitlement to pre-register during an established “sunrise” period. The gradual (and commendable) extension of the UDRP to cover disputes arising in some of the ccTLDs could also tax the resources of dispute resolution providers.

These new demands must be taken into account in deciding whether to expand the UDRP to address other subject matters, and if so, when best to do so. However, CCDN does not believe that these developments necessarily foreclose the desirability of a measured and carefully planned expansion that is supported by a clear consensus of opinion. In this regard, we commend to you the observations of the Motion Picture Association of America, a CCDN member organization, as presented in the May 29 consultation in Washington, DC. In particular, CCDN supports MPAA’s conclusions that (1) existing mechanisms (including but not limited to

UDRP) have, for the most part, proven effective in remedying abusive domain names registrations involving personal names; and (2) any new or expanded UDRP mechanisms for dealing with such abusive registrations should be narrowly crafted and consensus-based.

Finally, with regard to the “third alternative recommendation” set forth in paragraph 185 of the Interim Report, CCDN reserves judgment at this time. Because neither the eligibility restrictions for registration in the new .name TLD, nor the .name-specific mechanisms for enforcing those restrictions, have yet been finalized, we are not able to offer a final opinion on whether a UDRP-like mechanism, specific to that TLD, to prevent the abusive registrations of domain names corresponding to personal names, would be justified or desirable. We are prepared, however, to reiterate the view we expressed in our preceding comments, that “there is no justification for diminishing the role of Whois in providing transparency and accountability, or for hobbling its dispute prevention function, in the .name environment.”

Thank you for this opportunity to express the views of the Copyright Coalition on Domain Names. Please do not hesitate to contact me if I can provide further information or answer any questions.

Respectfully submitted,

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On behalf of
CCDN PARTICIPANTS:
American Film Marketing Association
American Society of Composers, Authors and Publishers
Association of American Publishers
Broadcast Music, Inc.
Business Software Alliance
Interactive Digital Software Association
Motion Picture Association of America
National Music Publishers' Association
Recording Industry Association of America
Software and Information Industry Association

[process2-comments] WIPO-2 RFC-3

To: process.mail@wipo.int

From: "European Communities Trade Mark Organisation"

Subject: RFC-3

Date: June 20, 2001

Name: David H Tatham

Organization: European Communities Trade Mark Organisation

Position: Chairman, ECTA Internet Committee

ecta.doc

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COMMENTS THE INTERIM REPORT OF THE SECOND WIPO INTERNET DOMAIN NAME PROCESS

The European Communities Trade Mark Association (ECTA) is the premier trademark association in Europe. It was formed in 1980 with the aim of bringing together all those persons practising professionally in the Member States of the European Community in the field of trademarks, and this was later extended to designs. It now has some 1250 members consisting of trade mark agents, trade mark attorneys, lawyers and other trade mark specialists practising in industry or in private practice.

ECTA has welcomed the Uniform Dispute Resolution Policy (UDRP) as it is currently operated by ICANN, and in doing so ECTA acknowledges the fine work done by WIPO, which helped to bring this about. This high standard of excellence is now reflected in the Interim Report of the Second WIPO Internet Domain Name Process (WIPO2) and we commend WIPO on it.

We shall not comment on any specific aspects of the Report, but we should like to put forward some general ideas which, we believe, could successfully address many of the problems faced by the abusive registration of any of the 5 identifiers which are the subject of this Interim Report by WIPO. We do so by reference to the situation in the European Union.

When discussing a new regime for trademarks in the European Community, the European Commission was faced with a problem of how to deal with trademarks that were similar to earlier rights but which were not necessarily protected for similar goods or services. It solved it by adopting some specific wording, which we believe could be adapted to suit the current proposals to extend the remit of the UDRP. We refer to the following wording in Article 4.4 of the First Council Directive of 89/104 of December 21, 1988 –

“Any Member State may furthermore provide that that a trade mark shall not be registered or, if registered, shall be liable to be declared invalid where, and to the extent that:
(a) the trade mark is identical with, or similar to, an earlier national trade mark where the earlier trade mark has a reputation in the Member State concerned and where the use of the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark;”

Wording such as this was subsequently adopted by every EU Member State and also appears in Article 8.5 of the Council Regulation of 40/94 of December 20, 1993 by which the Community Trade Mark was created.

If the UDRP is to be extended to include any of the 5 identifiers which form the subject of WIPO 2, then it is our submission that any abusive registration of domain names which are identical or similar to any of them could be countered if the

definition of what constitutes an 'Applicable Dispute' under Paragraph 4(a) of the UDRP were to be amended in line with the latter part of the above extract, namely:

- That the domain name is identical or confusingly similar to a name, mark or sign in which a complainant has proven rights; and
- Where the use of the domain name without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the complainant's name, mark or sign.

Submitted on the behalf of the European Communities Trade Mark Association

20 June 2001

[process2-comments] WIPO-2 RFC-3

To: process.mail@wipo.int

From: Fédération Internationale des Conseils en Propriété Industrielle

Subject: RFC-3

Date: Thu, 14 Jun 2001 09:48:39 +0200

Name: Michele Mannucci

Organization: Fédération Internationale des Conseils en Propriété Industrielle

Position: Secrétaire Général Adjoint

see attached paper containing FICPI's comment on the Interim Report.

[wiporf3.doc](#)

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FICPI

COMMENTS ON THE INTERIM REPORT OF THE SECOND WIPO INTERNET DOMAIN NAME PROCESS

FICPI, a world wide organization comprising Intellectual Property professionals engaged in private practice, wishes to formally submit the following remarks in response to the Request for Comments on the Issues Addressed in the Second WIPO Internet Domain Name Process (WIPO RFC-3). The FICPI membership includes intellectual property practitioners from 70 countries and as might be anticipated individual members hold a diverse range of views in respect of many of the topics of substance outlined in the Interim Report. Provided below is the general consensus of a number of Intellectual Property Attorneys from a variety of countries who participate in the FICPI CET Trademark Working Group.

FICPI representatives attended the consultative meetings in Brussels, Washington and Melbourne and reported back to the committee regarding these meetings. The committee participants carefully considered the information contained in the Interim Report and submitted comments, a synthesis of which has been provided below.

Personal Names

All committee members appreciated the need to protect personal names in instances wherein the individual is able to assert sufficient distinctiveness in respect of his or her name. Members were however of the view that current UDRP adequately protects personal names insofar as the UDRP extends to personal names which qualify or function as trademarks. It is believed that since the UDRP remains a new and relatively untested procedure it was best to adopt a wait and see approach before extending protection to other indicators which are characterized as having little uniformity when considered on a world wide level.

Efforts to revise the UDRP to cover a broader category of personality rights, as opposed to limiting the application of the UDRP to personal names functioning as trademarks, were viewed as untenable insofar as there is little consistency amongst countries in the application of laws relating to personality rights. It was felt that it would be impossible to introduce a standard for judging whether the requisite degree of notoriety existed because of the wide variance in national laws and jurisprudence relating to personality rights. The committee therefor favours the first approach suggested in the Interim Report, namely that no changes should be made to the UDRP in respect of personal names.

INNs

It was recognized that INNs, because of their generic nature, require some form of protection against use as marketing or promotional devices. It was however considered inappropriate to introduce the significant modification to the existing UDRP which would be required to accommodate disputes involving INNs. The UDRP contemplates an adjudicative process

however problems associated with INNs would require something more in the nature of an absolute restriction. The retroactive aspect of the INN restrictions as well as the large number of involved INNs, in multiple languages, were of concern to some committee members.

While INNs should be protected against commercial use by one party this should be effected through some means other than the UDRP, whether it be a treaty process or direct intervention on the part of ICANN. The committee is of the view that organizations such as the World Health Organization should play a leading role in the establishment of a system which would prevent abusive registrations of INNs. We do not consider this to be a trademark or trademark related matter and are of the view that the UDRP is not the appropriate vehicle for implementing changes to the current system.

Geographical Indications, Indications of Source and Other Geographical Terms

It is appreciated that abusive registrations containing a variety of geographic terms have occurred in the past and will undoubtedly continue. The vast majority of committee members do not believe that a modified UDRP is a viable option for dealing with disputes involving geographic indications, terms and indications of source. A tremendous degree of diversity exists in the various criteria applied by different countries to determine whether a geographic term is deserving of enhanced protection. In view of the decided lack of international uniformity it was felt that geographic terms, indications of source and geographical indications are not suitable for consideration under the UDRP. Since uniform definable standards do not exist it would be difficult to effect equitable resolution of disputes between parties with legitimate competing rights. It was also felt that any effort to derive and apply a standard would have the effect of affording geographical terms more protection in the virtual world than currently exists in the physical world.

A number of Committee Members considered the specific question of protection for geographic names of sovereign states. The consideration was instigated by a presentation made during the Washington consultative meeting on behalf of South Africa regarding the domain name southafrica.com. All members felt that this was an issue rife with complex assertions of public and private rights along with the conflicts therein. Aside from the obvious question of contract law it was considered that to allow such protection would effectively create sui generis protection which would impact on a variety of national laws. The committee members noted that in any number of jurisdictions entities have acquired legal rights through the use of what may be considered geographic terms.

It was the view of committee members that any protection specifically accorded the various categories of geographic terms must, because of the potential conflict with national laws and pre-existing rights, be implemented only upon agreement between countries. It is considered that these are issues which are properly considered under a treaty process or through other forms of agreement between sovereign states.

Trade names

Trade names were the only identifiers that the Committee would possibly be prepared to endorse as subject matter for UDRP revisions. It must however be noted that a majority of committee members felt adequate protection existed since trade names functioning as trademarks were currently afforded protection. There was however a strong minority view which held that it was important to extend the UDRP to specifically include trade names. The foregoing was rationalized on the basis that many trade names are used in a manner such that they cannot be afforded protection as trademarks and as such are not properly considered under the UDRP. Most committee members felt that there was a lack of international consistency in respect of the treatment of trade names which do not function as trademarks. Since an international standard could not be applied in instances of disputes the proposed amendments to the UDRP, covering trade names separate and apart from trademarks, were not supported by the majority of the committee at this time. We do, however support future consideration of the issues surrounding the inclusion of trade names in the UDRP process.

IGOs

Virtually all committee members felt that a valid rationale did not exist for the inclusion of the names and acronyms of IGOs under the UDRP. It was felt that the immunity from legal process enjoyed by international governmental organizations rendered them unsuitable for participation under the UDRP. It was also of concern that protection might extend to acronyms, which in some instances are legitimately used as identifiers or as generic terms.

Summary

The general view held by committee members was that the UDRP is workable because there is some semblance of consistency in respect of the treatment of trademarks by various nations. Certain basic international standards might be discernable and it is therefore possible to apply these basic principles in the context of abusive registrations involving trademarks. As there is no consistency in national treatments of geographic terms (of any definition), personal names and trade names not functioning as trademarks, the committee recommends that WIPO refrain from including these indicators under the current UDRP and to refrain from establishing separate dispute resolution processes relating to these indicators. We wish to note however that a minority of committee members felt that trade names should be afforded specific protection under the UDRP. While committee members were concerned about abuses involving INNs, it was felt that the UDRP was clearly not the appropriate vehicle for dealing with these types of disputes. The factor of immunity of IGOs from legal actions resulted in virtually no support for the inclusion of names and abbreviations of IGOs under the UDRP.

The committee is supportive of the development of technical measures which might facilitate top-level domain name searches across all domains and technical measures which might facilitate the provision of adequate and timely contact information.

[process2-comments] WIPO-2 RFC-3

To: process.mail@wipo.int

From: "Vincenzo M. Pedrazzini" <mail@aippi.org>

Subject: RFC-3

Date: Mon, 18 Jun 2001 18:38:16 +0200

Name: Vincenzo M. Pedrazzini

Organization: AIPPI

Position: Secretary General

Please find enclosed AIPPI Comment on WIPO2/RFC3

[aippi.doc](#)

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AIPPI COMMENTS ON WIPO2/RFC3

1. AIPPI is one of the world's leading non-governmental, politically neutral international organisations for research into and the formulation of policy for the law relating to the protection of intellectual property. Established in 1897, AIPPI has become a non-profit international organisation with more than 8,300 practitioners, academics and owners of intellectual property in more than 100 countries. General information on AIPPI can be found at www.aippi.org. Before commenting on The Interim Report of the Second WIPO Internet Domain Name Process, AIPPI wishes to acknowledge the excellent and comprehensive nature of the work carried out by WIPO in its review and recommendations as the recognition of rights and the use of names in the internet domain name system.

2. General Considerations

2.1 The 1st WIPO Report resulted in the Internet Corporation for Assigned Names and Numbers (ICANN) adopting the Uniform Dispute Resolution Policy (UDRP). The adoption of the UDRP was a success mainly because of:

- its limitation to cases of bad faith (even the most critical, who refer to the many decisions that favour complainants, do not deny that the wording of the UDRP if followed results in fair decisions against cybersquatters) and
- the simplicity of its rules.

2.2 The success of the WIPO2 report depends on its being adopted by ICANN given that its aim of further regulation of the generic top level domains cannot be achieved by any other process. Therefore, in this case too, it will be necessary to:

- limit it to cases where it is clear that a stand against abuse must be taken and
- retain the simplicity of the system by avoiding the adoption of numerous rules and different systems.

2.3 In order for the proposals to be acceptable to the internet community as a whole, care must be taken to ensure that the owners of the rights which are proposed to be protected, are not given any more rights on the internet than they already have in the "real world". Regulation of the domain name system to help avoid abusive registrations which could mislead the public is something which most people, AIPPI included, can support. However, it is not appropriate to use regulation of the domain name system to amend or change intellectual property laws around the globe or to extend the rights of intellectual property owners beyond that which they already have.

3. Specific Considerations

3.1 **INNs**

WIPO recommends that INNs be protected in the interest of public health and safety and it requests information on cases and damage. With respect to this point, AIPPI believes that a proposal to extend protection should be made only when a sufficient number of cases have been reported to make clear the existence of a serious situation requiring a remedy.

In the absence of evidence of abusive registration and use we would not support any restriction in the adoption of domain names corresponding to INNs. The problem raised by INNs is similar to the problem of adopting as a domain name any generic or descriptive word in commerce. If the problem of adopting generic words as domain names needs to be studied, it should be done as a whole, but not restricted to INNs. There is no evidence that consumers wishing to find out more about their medicine would type in the INN of the drug as the domain name. It seems more likely that they would type in the brand name or INN of their medicine into a search engine and choose from the list of results. If there is a case for preventing registration of INNs as domain names, there must equally be a case for regulating against the use of INNs as keywords, metatags and even their use in text on the Internet, as this will be picked up and listed by search engines. Domain names are just one, albeit currently important way that words can be used on the Internet. However, as the number of TLDs increases, domain names are likely to become less important. Therefore, in the absence of real evidence of abuse, we would not support WIPO's proposals.

On the assumption that protection is shown to be necessary, WIPO request comments on whether it should be limited to identical words and whether the following types of domain names should be allowed, which include the INN together with

- the name of the manufacturer of the pharmaceutical substance and
- an added element or word, such as INFO or USER GROUP.

AIPPI is of the opinion that, should protection be extended to INNs, it should be limited to identical terms only, and in view of the difficulties recognised by WIPO in paragraph 60 of the Interim Report, we would favour protection in the five currently recognised languages on the Cumulative List, although efforts should be made to include other languages when practicable.

3.2 **International Intergovernmental Organisations**

AIPPI recognises that IGOs can face bad faith registration of their name or acronyms as domain names and the fact that they are protected within their own “.int” top level domain does not prevent users from being misled.

We do not favour a total restriction on registration of IGOs from registration in all existing and new TLDs. A future TLD may be a “discussion” or “criticism” TLD such as “.discuss” and therefore a total exclusion of registration would be too restrictive to deal with the limited abuse which occurs. We would favour giving IGOs the standing to bring UDRP-type actions in the same way as trademark owners to

prevent the abusive registration of their names, acronyms or confusingly similar names or acronyms as domain names. If this presents political difficulties of the type envisaged by WIPO in paragraph 129 of the Interim Report, the amount of effort which would be required to set up a separate endorsed procedure would need to be weighed against the level of abuse currently being experienced by the IGOs.

If the UDRP cannot be appropriately amended and the parallel system is too complex to establish, AIPPI would favour a compromise on the basis that the full names of IGOs protected under the Paris Convention and TRIPS Agreement be excluded from the existing and the seven new TLDs, but specifically leaving open the question of further TLDs, so as to ensure that any public comment type TLD can be handled differently.

3.3 Personal names

The WIPO report, having analysed the development of personality rights in various jurisdictions, including the UDRP as it stands, proposes three possibilities in relation to the protection of personal names:

1. Making no changes to the UDRP on the basis that it is currently working to give protection to those who can establish that their name has trademark rights.
2. Extend the UDRP to protect against abusive registrations of personal names, where the person could establish that their name was distinctive in the eyes of the relevant public (ie not necessarily that it could be considered as a trademark) and where there had been commercial exploitation of the name through its registration and use as a domain name.
3. Modify the scope of the UDRP in relation to .name only. This recommendation has now been overtaken by events as eligibility criteria and use of .name has developed from the original application. Although .name will have eligibility criteria for registration, there will be no restriction on the use made of a domain name once properly registered.

AIPPI would favour leaving the UDRP as it currently stands, ie only allowing individuals to bring actions based on their name if they can establish that their name is also a trademark. To extend the UDRP beyond this simple formula, creates the strong possibility that rights will be granted under the UDRP which do not exist in the complainant's country of origin. The success of the UDRP is that it embodies a uniform principle against cybersquatting of trademarks. It is not meant to be a system for the creation of de facto new international laws.

3.4 Geographical Designations

3.4.1 Geographical Designations Recognised by the intellectual property system

AIPPI supports the proposal that the UDRP be broadened to cover abusive registration of geographical indication and indications of source. We would favour the first option

as to whom would be entitled to bring the complaint ie that the complainant would have to show that they would have standing to bring an action based on the geographical indication or indication of source in their country of origin. This is akin to the rights currently demonstrated under the UDRP by complainants who rely on their common law (unregistered) rights.

3.4.2 Geographical Indications not recognised by the intellectual property system

In this group, WIPO places all terms of a geographical nature or with geographical connotations that do not enjoy specific protection under any law or treaty on industrial property.

Among others, it lists:

- the names of countries and places within countries
- ISO 3166 country codes

3.4.3 Names of countries and places within countries

With respect to the names of countries, there is no international protection system which prevents or restricts their use. Therefore, AIPPI does not favour the introduction of protective measures for the names of countries or of regions and municipalities within countries. In the event that intellectual property-type protection is given to country names and regions, at that stage we would favour allowing such rights to be claimed in UDRP actions.

3.4.4 ISO 3166 country codes

WIPO proposes

- excluding the two-letter ISO 3166 codes from new TLDs,
- with no retroactive affect on TLDs that have already accepted registration for two-letter codes
- adopting measures so that third-level registrants will be affected by the UDRP.

AIPPI understands that country codes are to be excluded from second level registration in the new TLDs in the contracts which are currently being signed with ICANN.

In relation to second level domains which already exist which reproduce ISO 3166 country codes, a solution may be to change the ICANN Registrar Accreditation Agreement to provide that:

- the registrars' agreements with domain name applicants include a clause whereby the applicants would undertake not only to accept the UDRP but also to make it obligatory for those to whom the right to use third level domains isb granted,
- to make it compulsory for the agreement to include a clause whereby the owners of third level domain names were obliged to do the same in the event that they granted fourth level domain names.

This would assist in ensuring that the UDRP could be used against bad faith cybersquatters on the third or fourth level, but would be dependent on the second level domain name holder revealing the details of the third level registrant. There is then the problem of what the arbitrator can order, although it may be possible to give an order along the lines of “unless the third level domain complained of is assigned to the complainant within x days, the second level domain will be cancelled”.

For second level domain names that have already been registered with an ISO 3166 country code and that have assigned third level domain names, the system would be introduced in a manner similar to that used to introduce the UDRP: the registrars would adopt it and would oblige proprietors to accept the policy.

3.5 Trade Names

AIPPI finds it suitable to extend the UDRP to protect trade names and, so as not to create rights in cyberspace that do not exist in the real world, it agrees with WIPO's proposal that the panellist determine, in view of applicable legislation and in line with the requirements for unregistered trade marks, whether the owner holds rights in the trade name.

4. ISO 3166 country codes

4.1 Whois

We agree with the proposals for an extended Whois database in which:

- Current information would remain on record;
- A single search would cover the databases of all registrars; and
- Additional search criteria would exist.

Accurate and readily available Whois data is important to the intellectual property community and whilst registrants should be protected from unsolicited mail, the need for intellectual property owners, along with law enforcement agencies to have access to the data, needs to be weighed against any attempt to restrict the legitimate access to this information.

4.2 **Directory and Gateway Services**

The problems inherent in imposing a system to enable legitimate users to “share” domain names are enormous, given the established rights in domain names which others could argue they should also be entitled to use. To attempt to impose such a system after many years of a “first come, first served” basis is unlikely to achieve consensus.

AIPPI believes that the introduction of new TLDs and the development of keyword systems and other identifiers (which too will be faced with balancing competing rights) should alleviate the pressure currently faced by the domain name system.

Respectfully submitted on behalf of AIPPI by
Vincenzo M. Pedrazzini, Secretary General

Comment prepared by Committee Q160 (Luis H. de Larramendi, Guillermo Carey, Jane Mutimear)

[process2-comments] WIPO-2 RFC-3

To: process.mail@wipo.int

From: "International Chamber of Commerce (ICC)"

Subject: RFC-3

Date: June 18, 2001

International Chamber of Commerce

The world business organization

Department of Policy and Business Practices

ICC Response to Request for Comments 3 of the WIPO Second Domain Names Process

ICC is the world business organization. Grouping together thousands of member companies and associations from over 130 countries, it is the only representative body that speaks with authority on behalf of enterprises of all sizes and sectors in every part of the world.

ICC appreciates the opportunity to present the views of the international business community on the interim report resulting from WIPO's second domain name process concerning the abusive use of real-world identifiers, other than trademarks, in the Domain Names System. WIPO is to be congratulated on issuing recommendations that are balanced and sensible, reflecting the extensive consultation undertaken to develop them.

It is important that the implementation of any recommendations do not unduly disrupt the domain names system and that any proposals will not prove overly burdensome to business or hinder the continuing development of internet commerce. ICC urges WIPO to continue to consult with all interested parties as this exercise develops and stand ready to further assist WIPO in its efforts.

ICC therefore generally supports the interim report, but believes that due consideration must always be given to potential problems raised by differences in national rules, and practices relating to IP rights. A few specific comments are set out below:

- ICC Supports WIPO's recommendation to exclude the cumulative list in Latin, English, French, Russian and Spanish of International Non-proprietary Names for pharmaceuticals (INNs) from possible registration as domain names in the open gTLDs and to cancel existing registrations of such INNs.
- The recommendation that names of International Intergovernmental Organisations (IGOs)

protected under the Paris Convention and the TRIPS agreement should be excluded from registration gTLDs is supported by ICC. However, ICC questions the need for granting additional protection to IGOs by way of an administrative procedure for abusive domain name registrations by third parties.

- With respect to Personal Names, ICC supports that the existing Uniform Dispute Resolution Policy should allow (and actually does allow) complainants who can assert distinctiveness in their name (meeting certain criteria) to protect these Personal Names against bad faith applications. The current UDRP system already allows such protection and therefore it is not necessary to extend its scope, as suggested in the second and third options presented in paragraph 185 of the interim report.
- ICC believes that it would be desirable to extend the UDRP to protect Geographical Indications and Indications of Source against abusive registration in all open gTLDs, provided that further consideration is given to differences of interpretation of current definitions as to what constitutes a geographical indication and to who should have the right to file complaints of abuse. ICC believes that it is premature to extend the UDRP to cover other geographical terms not included in the intellectual property system.
- In view of the absence of an internationally agreed definition of what constitutes a trade name and taking into account the diversity of the national approaches to the implementation of international protection of domain names, ICC supports WIPO's recommendation not to modify the UDRP in order to establish a special procedure for the protection of trade names against abusive registration and use as domain names.

ICC hopes that these comments prove useful to WIPO in its deliberations and looks forward to continuing participation in the process.

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[process2-comments] WIPO-2 RFC-3

To: process.mail@wipo.int

Subject: RFC-3

From: "International Trademark Association" <mheltzer@inta.org>

Date: Thu, 24 May 2001 17:06:29 +0200

Name: Nils Victor Montan

Organization: International Trademark Association

Position: President

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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 24, 2001

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

Dear Mr. Gurry:

The International Trademark Association (INTA) is pleased to provide a response to the Request for Comments (RFC) contained in the *Interim Report of the Second WIPO Internet Domain Name Process*, which is dated April 13, 2001. INTA is a 123-year-old 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 (IPC), and has been a respondent to previous WIPO RFCs on the intersection of intellectual property and domain names, including the October 13, 2000 RFC, which is the document that immediately preceded the April 13 *Interim Report*.

Amending the UDRP

In our January 4, 2001 response to the October 13 RFC, we noted that our comments would “focus primarily on the applicability of the ICANN Uniform Dispute Resolution Policy (UDRP) to disputes concerning domain names and the five topics identified in the RFC.” We added, “While issues raised in the RFC should be resolved, we believe that they generally tend to evoke complex questions, which cannot be effectively addressed by the UDRP, a system that has a narrow focus and limited resources.” We maintain that opinion.

INNs and IGOs

INTA is pleased to see that the *Interim Report* follows our recommendation that the UDRP not be amended in the case of International Non-Proprietary Names (INNs) (paragraph 76) and Intergovernmental Organizations (IGOs) (paragraph 130). We urge WIPO to make these recommendations part of the final report.

Mr. Francis Gurry

Personal Names

With respect to personal names, as was noted in our January 4 submission, personal name disputes are likely to involve complicated legal issues that would make it difficult to establish bad-faith under the UDRP. In addition, as we previously noted by way of example, it would be “exceedingly difficult” to promulgate a standard for distinguishing famous names from others. We continue to believe, however, from a trademark owner’s perspective, that the existing UDRP has “been effective in dealing with bad-faith registrations of personal names that serve a trademark function – as indicators of a source of goods or services.” INTA therefore recommends, in response to paragraph 186 of the *Interim Report*, that WIPO select the first option listed under paragraph 185, which states that no changes should be made to the UDRP to specifically address personal names.

GIs and Geographic Designations Beyond IP

On the matter of geographic indications (GIs), INTA strongly urges WIPO to reconsider the recommendation in the *Interim Report*, which calls for the UDRP to be expanded to cover GIs and indications of source in all open gTLDs (paragraph 227). We oppose this recommendation.

Determining rights in a GI is an extremely delicate and complex investigation, requiring dispute providers and panelists to have specific knowledge of, among other things, what constitutes a GI, as well as the variety of disparate national approaches to protecting GIs (see paragraph 197). For example, what is a GI in one country can easily be a generic word in another country and even a trademark in a third country. Often, historic and political factors play a role as well. It would take a UDRP panelist considerable time to wade through the particulars of a GI case, since he or she would not have any definitive list of GIs and indications of source to serve as a reference (see paragraph 218).

Moreover, the adjustments required to make the UDRP capable of handling GI disputes would be extensive (paragraphs 228 to 232). In our opinion, they would be too extensive. The number of required amendments would transform the UDRP from a relatively easy-to-understand process to a more complex legal regimen that may not be readily understandable, especially to respondents who are presented with a cause of action against them.

In short, expanding the UDRP to cover GIs would defeat the purpose of the UDRP as a quick, efficient, and cost effective means of dispute resolution. We therefore oppose the recommendation contained in paragraph 227.

For the reasons stated above, INTA also opposes an adjunct to the UDRP to handle cases concerning administratively recognized regions and municipalities (paragraph 285(b)).

Trade Names

With respect to dispute resolution for trade names *per se* (paragraphs 318, 322, 327 and 329), INTA believes that amendments to the UDRP may be possible along the lines suggested in the *Interim Report* (paragraph 325). They appear to cause little disruption to the policy, as it now exists, something that INTA very much favors. The similarities between trademarks and trade names makes this so. We wish to add that in trade name cases, as in trademark cases, where both the complainant and respondent claim rights in a domain name based on trade name ownership, an amended UDRP should direct panelists to decline to hear the case, as these matters should be handled by a court of competent jurisdiction.

Notwithstanding, INTA has no information that suggests that abusive domain registrations of trade names *per se* have risen to a level that would necessitate an amendment to the UDRP (responding to paragraph 318). Indeed, our review shows that there are very few instances in which a trade name does not also function as a trademark, thereby qualifying for protection under the existing UDRP. Accordingly, we are not in favor of a recommendation in the final report that calls for an immediate amendment to the UDRP. Rather, in our opinion, WIPO should recommend that instances of trade name *per se* cybersquatting should continue to be monitored for any dramatic increase and amendments recommended only after such an increase has been demonstrated.

Use of Exclusion Mechanisms

INTA notes that the *Interim Report* recommends exclusion mechanisms for both INNs (paragraph 83), IGOs (paragraphs 123 and 124) and ISO 3166 alpha-2 code elements (paragraph 275(i)). INTA does not necessarily object to the use of such mechanisms. We do believe, however, that the exclusion mechanism for IGOs should only cover the complete name of the IGO and not the acronym, since the acronym “may be derived reasonably from any number of commercial or non-commercial entities,” (paragraph 117). For example, a quick check of the U.S. Patent and Trademark Office (USPTO) online database shows that “WIPO” is a registered trademark for “tissues for personal and industrial use,” (U.S. Trademark Registration # 2209103). “WCO” is a registered trademark for “precious metal jewelry with diamonds, previous and semiprecious gem stones,” (U.S. Trademark Registration # 1675810).

The same situation seems to hold true for the ISO 3166 alpha-2 code elements. They can also be trademarks. Take CA. It is the ISO 3166 alpha-2 code for Canada, but there are currently a number of live intent-to-use applications at the USPTO for CA, including as a trademark for online sports instruction (Serial # 78005979) and for clothing and accessories (Serial # 76119432). Another example is IL, the ISO 3166 alpha-2 code for Israel. IL also happens to be

a U.S. registered trademark for veterinary preparations (U.S. Trademark Registration # 2303774). IE is the ISO 3166 alpha-2 code for Ireland, but it is also a registered U.S. trademark for technical support services (Registration #2447399). INTA recognizes the level of abuse that has taken place with respect to ISO 3166 alpha-2 codes. In light of the preceding examples, however, we suggest that WIPO consider what effect an exclusion mechanism would have on owners of trademarks that correspond to ISO 3166 alpha-2 codes.

Since “a system for exclusions similar to that proposed for the DNS operates effectively in various trademark office practices around the world, in the course of their examination for trademark applications for possible conflict with INNs,” (paragraph 80), INTA does not foresee a conflict similar to that of trademarks and an exclusion mechanism for IGOs and ISO 3166 alpha-2 codes.

WHOIS

WHOIS is an essential tool that provides not only trademark and copyright owners with valuable contact data concerning alleged infringers, but is also used by law enforcement, consumers, and even parents of young Internet users to obtain the information they need to contact owners of a particular website. INTA therefore fully endorses the recommendation contained in the *Interim Report* that calls for each registration authority, “existing and in the future,” “to provide accurate, reliable and publicly accessible WHOIS data,” (paragraph 341).

Because of the extreme importance of WHOIS, and especially in light of the fact that ICANN is preparing to expand the domain name space with the addition of seven new global top-level domains, INTA strongly believes that it is entirely “practical” and “appropriate” “to enhance the functionality of the existing WHOIS, to enable searches across all relevant registrar databases on the basis of search criteria in addition to the exact domain name,” (paragraph 345). INTA was an early advocate of a searchable database across all registries (see INTA Response to U.S. Department of Commerce Request for Comment on the “Improvement of Technical Management of Internet Names and Addresses,” March 18, 1998). As recently as March 2001, through our participation in the IPC, INTA urged that amendments specifying the development of a “one-stop-shop” WHOIS be made to the revised ICANN - VeriSign Agreement. This “one-stop-shop” WHOIS, which would be particularly helpful in demonstrating that an alleged cybersquatter has engaged in a pattern of bad-faith activity, should be searchable using the criteria advocated by the IPC: domain name, registrant’s name or postal address, contacts’ names, NIC handles and Internet Protocol address,” (paragraph 340).

With respect to WHOIS and country code top-level domains (ccTLDs), INTA strongly endorses the development of a “one-stop-shop” WHOIS recommendation contained in paragraph 347, which calls for ccTLD administrators to be encouraged to adopt sound WHOIS policies that include verification and public availability. It is our sincere hope that, eventually, ccTLD

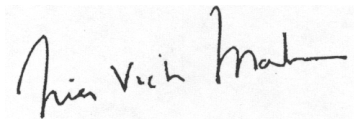
WHOIS databases will feed into the cross-registry WHOIS referred to above. INTA urges WIPO to recommend to ICANN that references to public availability of registrant contact data be made part of any future ICANN - ccTLD agreements, and that ICANN work towards including the ccTLDs in a cross-registry WHOIS.

On the matter of WHOIS and privacy (paragraphs 352 and 353), INTA is aware that misuse of the publicly available WHOIS system has taken place. INTA condemns such activity. We strongly advocate the imposition of increased penalties (both civil and criminal) by national governments, as well as penalties that might be imposed by registration authorities, against those who would misuse and abuse the publicly available WHOIS system either through an individual WHOIS query or via a bulk access service. We also endorse the proposition contained in paragraph 351 of the *Interim Report* that states that domain registrants should be “clearly informed what data will be collected, the purposes for which it is collected, and the uses to which it may be put.” INTA does not believe, however, that a “black out” of WHOIS data is an option in light of the value it provides to intellectual property owners, law enforcement, consumers, and parents.

Conclusion

Thank you for considering INTA’s comments on the *Interim Report*. INTA looks forward to continuing to work with WIPO on matters concerning the protection of intellectual property on the Internet.

Sincerely,

A handwritten signature in black ink, appearing to read "Nils Victor Montan". The signature is written in a cursive style with a horizontal line at the end.

Nils Victor Montan
President

[process2-comments] WIPO-2 RFC-3

To: process.mail@wipo.int
From: "Dow, Troy" <DowT@mpaa.org>
Subject: MPA Comments
Date: Wed, 6 Jun 2001 06:32:51 -0700

Please find attached an electronic copy of my comments.

Best Regards,
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TECHNOLOGY & NEW MEDIA

May 29, 2001

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

Dear Mr. Gurry:

I am pleased to provide comments on behalf of the Motion Picture Association of America (MPAA) on the substance of the issues to be addressed by the World Intellectual Property Organization (WIPO) in the Second WIPO Internet Domain Name Process, as set forth in the October 13, 2000 Request for Comments (RFC-2). MPAA is a trade association representing major producers and distributors of theatrical motion pictures, home video material and television programs. MPAA members include: Buena Vista Pictures Distribution, Inc. (Disney); Metro-Goldwyn-Mayer Studios, Inc., Paramount Pictures Corporation; Sony Pictures Entertainment, Inc.; Twentieth Century Fox Film Corporation; Universal Studios, Inc.; and Warner Bros.

As you know, MPAA participated in the first round of comments on the terms of reference, procedures, and timetable for the Second WIPO Internet Domain Name Process (RFC-1). We appreciate your consideration of our earlier RFC-1 submission, as reflected in the final terms of the RFC-2. MPAA also provided comments in response to the RFC-2 as a member of the Copyright Coalition on Domain Names (CCDN), and we look forward to a continued dialog on these issues through regional consultations as WIPO formulates its recommendations.

As indicated in our earlier submissions, MPAA appreciates WIPO's continued efforts to encourage appropriate protections for intellectual property and consumers in the evolving world of electronic commerce. We appreciate, in particular, your work in the First WIPO Internet Domain Name Process and your recommendations that led to the establishment of the ICANN Uniform Dispute Resolution Policy (UDRP) and the best practice requirements now reflected in the ICANN Registrar Accreditation Agreement.

In our earlier RFC-1 submission, we identified several key issues to be addressed in this Second WIPO Domain Name Process. First, we recommended that WIPO begin its process by identifying the problem to be addressed, namely by examining the evidence of the types and extent of abuses within the DNS that relate to intellectual property rights other than trademarks and service marks. Second, we recommended that WIPO consider the extent to which such abuses – where they exist – are or are capable of being addressed by national law or within the existing framework of the UDRP. Third, if WIPO determines that there exist significant problems involving abusive domain name registrations relating to intellectual property rights other than trademarks, and that such problems are not sufficiently addressed by national law or the existing UDRP, we recommended that WIPO consider whether such abuses are capable of being resolved in a uniform manner through some other mechanism, including through an extension of the existing UDRP. Central to this inquiry is the degree of uniformity of national laws with respect to these forms of intellectual property and whether such uniformity as may exist is sufficient to form the basis for a consensus-based international dispute resolution mechanism. Finally, we urged that any mechanism for addressing abusive registrations in the areas identified in the RFC-2 – whether through national law, the existing UDRP, or some other mechanism – take into account legitimate registrations and uses, such as those involving creative expression and protected speech.

While these recommendations apply to each of the areas to be explored by the Second WIPO Internet Domain Name Process – personal names, International Nonproprietary Names for Pharmaceutical Substances, names and acronyms of international intergovernmental organizations, geographical indications, indications of source, or geographical terms, and tradenames – our comments here focus primarily on the abusive registration of personal names as domain names. MPAA generally supports policies aimed at deterring abusive conduct in the DNS, whether it involves intellectual property infringements or other types of abusive conduct. For the most part, existing mechanisms – including the ICANN UDRP, national trademark laws and other causes of action – have proven effective in remedying abusive registrations involving personal names. Nonetheless, to the extent that there are cases of abusive conduct in this area that the UDRP fails to reach, MPAA is open to considering new or expanded mechanisms to deal with those problems. We believe, however, that any new or expanded mechanisms aimed at abuses outside the trademark sphere should be narrowly crafted and consensus-based in order to preserve the integrity of and international support that is necessary for the continued success of the UDRP. Such mechanisms must not in any way undercut existing protections or add undue burdens on dispute resolution providers. Any such mechanisms must also accommodate legitimate, non-abusive domain name registrations and uses of personal names, and specifically those undertaken in connection with creative works and other forms of expression protected by the First Amendment of the U.S. Constitution. Recent enactments in the United States at the Federal level and in California offer possible models of such measures. Finally, MPAA supports WIPO’s efforts to review the potential of technical measures as tools for domain name dispute avoidance, including the utility of uniform standards and implementation of a centralized “Whois” database of registrant contact data in the existing gTLDs, new TLDs, and ccTLDs.

1. DEFINING THE PROBLEM

The RFC-2 begins by asking “[s]hould personal names be protected against bad faith, abusive, misleading or unfair registration and use as domain names in the DNS?” As a general matter, MPAA supports DNS policies and procedures aimed at deterring abusive registrations and bad faith, misleading, or unfair conduct, whether involving intellectual property, consumer fraud, or any other form of abuse. The task is to identify the specific abuses to be deterred and the extent to which DNS policies and procedures can be crafted and implemented to address these problems in a uniform, global, and consensus-oriented manner.

As you know, names that serve as identifiers of source or sponsorship with respect to goods or services – including personal names – are now protected within the DNS through a broad array of national laws governing the recognition and protection of trademarks and service marks and through the UDRP. MPAA has been pleased to work with WIPO and ICANN in the development and implementation of these policies. The question is whether there is a need for additional or expanded protections for personal names outside the scope of these protections, and if so, what those protections should look like?

2. EXISTING REMEDIES

a. National trademark law and the ICANN UDRP have proven to be effective in addressing many cases of abusive personal name registrations

Of the cases MPAA is aware of involving abusive registrations of personal names, most involve names that are protected under national trademark law and the UDRP. Presumably this results from the fact that most cybersquatters target individuals who enjoy a certain degree of notoriety, including actors and actresses, recording artists, performers, athletes, authors, celebrities, and other notable figures, whose names are widely eligible for protection as trademarks or service marks.

In the United States and abroad, national law allows for registration and protection of personal names as marks to the extent they distinguish the goods or services of one person from the goods or services of another.¹ The International Classification of Goods and Services for the Purposes of the Registration of Marks – published by WIPO and utilized by the United States and other nations for classifying registrations of trademarks and service marks – includes in class 41 a specific class for “education and entertainment,” dedicated to “services rendered by persons or institutions in the development of the mental faculties of persons or animals, as well as services intended to entertain or to engage the attention.”² Under the U.S. Patent and Trademark Office’s Trademark Acceptable Identification of Goods and Services Manual, registrations may be entered under international class 41 for “Entertainment services, namely, personal appearances by a [INDICATE type to individual, e.g., movie star, sports celebrity, etc.]” Thus, NFL quarterback Brett Favre has registered his name as a service mark for “Entertainment services in the nature of personal appearances by a football player.” Actor, comedian, and recording artist Will Smith has registered his name as a service mark for “entertainment services – namely live entertainment comprising musical performances, dramatic performances and

¹ See 15 U.S.C. §§ 1052-1053.

² See Trademark Manual of Examining Procedure, 2d ed., Revision 1.1, § 1401.02(a).

comedic performances.” Howard Stern has a registered service mark for “entertainment services, namely, radio talk shows featuring performances by a radio personality.” Similar registrations have been granted to Jesse “The Body” Ventura, Madonna, Barbara Streisand, and many others.

Personal names are also generally eligible for protection as common law marks. In the United States, such names are protected at the Federal level through Section 43(a) of the Lanham Act.³ Section 43(a) provides broad protections against false advertising and unfair competition through a Federal cause of action against any person who, on or in connection with goods or services, uses in commerce any word, term, name, symbol, or device (among other things) that is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person. This would include the registration and use in commerce of a personal name as a domain name in connection with goods or services in a manner that is likely to cause confusion or to deceive the public as to the affiliation, connection, or association of the person whose name is registered with such goods, services, or commercial activities. The Anticybersquatting Consumer Protection Act,⁴ enacted in the United States in 1999, notes that

“[p]rotection under section 43 of the Lanham Act has been applied by the courts to personal names which function as marks, such as service marks, when such marks are infringed. Infringement may occur when the endorsement of products or services in interstate commerce is falsely implied through the use of a personal name, or otherwise, without regard to the goods or services of the parties. This protection also applies to domain names on the Internet, where falsely implied endorsements and other types of infringement can cause greater harm to the owner and confusion to a consumer in a shorter amount of time than is the case with traditional media.”⁵

Similar protection for personal names that serve as marks is afforded at the state level through state deceptive trade practices statutes and similar legislation. These statutes similarly prohibit deceptive commercial conduct, including misleading advertising, disparagement, trade symbol infringement, passing off, misrepresentation of source, affiliation and sponsorship, etc.⁶

Trademark protection is also extended to certain personal names in the United States under state and Federal dilution statutes. The Federal Trademark Dilution Act,⁷ for example, provides protection for a the owner of a famous mark – whether it is a Federally registered or common law mark – against the commercial use in commerce of that mark in a manner that dilutes the mark’s distinctive quality.⁸ Under the Act, a use dilutes the mark’s distinctive quality

³ 15 U.S.C. § 1125(a).

⁴ P.L. 106-113, app. I, tit. III, 113 Stat. 1501A-545 (1999).

⁵ S. Rep. No. 479, 106th Cong., 1st Sess. 103 (Comm. Excerpt 2000).

⁶ See McCarthy on Trademarks and Unfair Competition, § 28:7 (1999).

⁷ Pub. L. No. 104-98, 109 Stat. 985 (codified at 15 U.S.C. §§ 1125, 1127).

⁸ 15 U.S.C. § 1125(c).

when it “lessen[s] the capacity of a famous mark to identify and distinguish goods or services, regardless of the presence or absence of (1) competition between the owner of the famous mark and other parties, or (2) likelihood of confusion, mistake, or deception.”⁹ Dilution in this context may occur from “uses that blur the distinctiveness of the mark or tarnish or disparage it, even in the absence of a likelihood of confusion.”¹⁰ Thus, the owner of a personal name mark that is “famous” may be able to bring a Federal trademark dilution action against someone who registers and uses that name as a domain name in a manner that blurs its distinctiveness or otherwise tarnishes or disparages it, provided the requirements of the Act – including those related to commercial use in commerce – are met. Similar protections are available under state dilution statutes and internationally in countries that recognize the trademark dilution theory.

These broadly recognized principles of trademark law are reflected in – and, in fact, form the basis for – the UDRP, which was adopted by ICANN on December 1, 1999, and is mandated for use in dispute resolution by domain name registrars as a condition of ICANN accreditation.¹¹ The UDRP offers a timely and cost-effective means of dispute resolution for cases involving bad faith registrations of domain names that are identical or confusingly similar to a trademark or service mark in which the domain name registrant has no rights or legitimate interests.¹² WIPO is, of course, the leading dispute resolution service provider under the UDRP, and in 2000 rendered decisions in 1,007 of 1,841 cases filed (279 cases were settled or otherwise terminated). Of those decisions, roughly three in five resulted in a transfer of the offending domain name.

A significant number of the cases heard by WIPO arbitrators have involved bad faith, abusive registrations of personal names. In most of the cases decided, the UDRP has proved sufficient to remedy such abuses. Some of the complainants who succeeded in having domain names containing their names transferred to them pursuant to UDRP proceedings include actresses Julia Roberts, Isabelle Adjani, and Nicole Kidman, author Jeanette Winterson, recording artists Jimi Hendrix, Madonna, Sade, Celine Dion, and Bill Withers, comedians Billy Connelly and Rita Rudner, model Patricia Ford, radio personality Nick Carter, NFL football star Dan Marino, soccer star Pierre van Hooijdonk, tennis stars Venus and Serena Williams, businessmen Dodi Fayed, Barry Diller, Philip Berber, and Steven Rattner, and horse trainer Monty Roberts. Pending cases include those involving the domain names Mariah-Carey.com and rayharper.com. Only in a small handful of WIPO-arbitrated cases has the complainant failed to prevail in a personal name dispute. It is important to note that in cases such as those brought by recording artists Sting and Edward Van Halen, the failure to prevail does not reflect a lack of personal name protection, but rather the failure to prove bad faith associated with a registration as required by the UDRP.

The fact is that cybersquatters most often target personal names to which notoriety, commercial value, or goodwill are attached in the minds of the public. This associative value is at the core of trademark protection. MPAA expects that a careful review of actual domain name

⁹ 15 U.S.C. § 1127.

¹⁰ See H.R. Rep. No. 104-374, at 2 (1995).

¹¹ See ICANN Registrar Accreditation Agreement (approved Nov. 4, 1999), available at <http://www.icann.org/nsi/icann-raa-04nov99.htm>.

¹² See *id.*, at 2, paragraph 4(a).

disputes involving bad faith registrations of personal names will reveal that most involve names that are eligible for protection under existing principles of trademark law, and that national law, as implemented through the UDRP, is well equipped to address these disputes. This view appears to be reflected by the majority of comments filed on this topic in the RFC-2 process.

b. For abusive registrations involving names that do not function as marks, there exist a growing number of remedies under national law

For those cases where trademark law does not provide adequate protection, there do exist a number of other avenues under national law to address abusive registrations of personal names. The following list provides examples of causes of action – many of which are referred to in the WIPO Interim Report – that now may be available in the United States to remedy such abusive registrations, often regardless of whether the personal name is used in a commercial setting or to indicate the source of goods or services. Related causes of action are available internationally in varying forms under the national laws of individual countries.

- Common Law Right of Publicity: In almost all states in the U.S., the common law right of publicity provides relief where an individual can demonstrate that a defendant has, without permission, used some aspect of that individual's identity or persona in such a way that the individual is identifiable from defendant's use, and that defendant's use is likely to cause damage to the commercial value of that persona.¹³ Unauthorized use of a personal name in a domain name could, depending on the given facts, give rise to a claim of violation of this common law right.
- State Statutory Rights of Publicity: State statutes like California Civil Code section 3344 provide remedies against the knowing use of another's name or likeness in a commercial manner without such person's authorization. Again, depending on the facts, the unauthorized registration and use by a person of a domain name that includes the personal name of another person could give rise to such a claim.
- Defamation (Libel or Slander): Generally, these causes of action, which are available in every state in the United States, provide a remedy against false publication by written or printed words, causing injury to a person's reputation, or exposing her to public hatred, contempt, ridicule, shame, or disgrace, or affecting her adversely in her trade or business. While certainly not available in every case involving the registration or use of a personal name in a domain name, depending on the content provided on a website accessed under the domain name, these causes of action may be available.
- False Light Invasion of Privacy: This cause of action is available when a plaintiff can show a material falsehood and (in most instances) that the falsehood in question was published or disseminated with constitutional "actual malice" consisting of knowledge of that falsity or a reckless disregard for whether the statement or impression is true or false. Such statement or impression need not be defamatory in a technical sense in order to be

¹³ See McCarthy, supra note 6, at § 28:7 (1999).

actionable, so long as it is “highly offensive” to a reasonable person. As with defamation, depending on the content provided on a website using or employing a personal name in the domain name, these causes of action might be brought.

- Intentional Infliction of Emotional Distress: This cause of action is available by proving (1) outrageous conduct by the defendant and (2) the defendant’s intentional causing, or reckless disregard of the probability of causing, emotional distress. While the mere registration or use of a personal name in a domain name may not rise to the level of outrageousness needed for liability under this tort, depending on the context and content of the website involved, a plaintiff whose personal name is registered or used as a second level domain may be able to avail herself of this cause of action.

In addition, statutes are just now beginning to be enacted to address abusive registrations of personal names in domain names directly. For example, in the United States, section 3002(b) of the Anticybersquatting Consumer Protection Act of 1999 provides for a Federal cause of action against “any person who registers a domain name that consists of the name of another living person, or a name substantially and confusingly similar thereto, without that person’s consent, with the specific intent to profit from such name by selling the domain name for financial gain to that person or any third party.”¹⁴ Under this statute, courts may grant appropriate injunctive relief, including ordering the forfeiture or cancellation of the domain name or its transfer to the plaintiff, as well as costs and attorneys’ fees to the prevailing party in appropriate cases.

Last year California enacted similar legislation at the state level. Section 17525 of the California Business and Professions Code now provides that “[i]t is unlawful for a person, with a bad faith intent to register, traffic in, or use a domain name, that is identical or confusingly similar to the personal name of another living person or deceased personality, without regard to the goods or services of the parties.”¹⁵ Similar bills are currently being considered in Louisiana and Hawaii. These are the first of what will likely be many state statutes, and similar legislation may very well be under consideration by individual WIPO member states.

c. Existing protections may still fall short in some cases

Notwithstanding the broad and varied protections of national law, the celebrity-oriented nature of personal name cybersquatting disputes, and the successful track record of the UDRP in remedying such disputes, there will undoubtedly remain some cases that these protections will fail reach. High school athletes whose names are registered by domain name speculators, or public officials whose names are registered by others, may fall into this category (although such cases might still be adequately addressed through any number of the mechanisms outlined above in certain circumstances). As stated above, MPAA generally supports DNS policies that deter abuses of all types, including policies to deter abuses that fall outside the traditional scope of trademark law and the UDRP. As will be more fully explored below, however, such policies should be consensus-based, they should be rooted in widely accepted principles of national law

¹⁴ P.L. 106-113, app. I, tit. III, § 3002(b)(1), 113 Stat. 1501A-545 (1999) (codified at 15 U.S.C. § 1129).

¹⁵ Cal. Bus. & Prof. Code § 17525(a).

and public policy, and they should contribute to stability and confidence in the DNS, including in particular the stability and public confidence that exists in the current UDRP as a dispute resolution mechanism.

3. ANY NEW OR EXTENDED MECHANISMS TO REMEDY ABUSIVE PERSONAL NAME REGISTRATIONS MUST BE CONSENSUS-BASED AND MUST NOT DETRACT FROM THE INTEGRITY OF AND INTERNATIONAL SUPPORT FOR THE UDRP

The existing UDRP has gained legitimacy and widespread support in large part because it is premised on a framework of national trademark laws that are sufficiently uniform to provide the basis for a consensus-based administrative mechanism for international dispute resolution. As noted in the WIPO Interim Report, 160 countries are party to the Paris Convention for the Protection of Industrial Property, which dates back as far as 1883 and forms the basis for international standards of protection for famous and well-known marks. Similarly, more than 130 countries are party to the World Trade Organization (WTO) and are thereby bound by the Trade-Related Aspects of Intellectual Property Rights (TRIPs) Agreement, which provides similar uniform protections and stiff enforcement mechanisms. In addition, the 1994 Trademark Law Treaty aims to provide even greater uniformity between national trademark systems, and the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to the Madrid Agreement (collectively “the Madrid System”) provide a widely recognized system for the international registration of trademarks. Collectively, these international instruments and a well-developed body of generally harmonized national trademark laws serve as a coherent foundation for the establishment of a broad, consensus-based international dispute mechanism, like the UDRP.

Commentators in the First Internet Domain Name Process noted that similar uniformity is lacking with respect to the trademark-related intellectual property rights that are the focus of this Second WIPO Internet Domain Name Process. It was on this basis, coupled with the untested nature of the proposed uniform dispute resolution policy, that WIPO determined it was “premature to extend the notion of abusive registration beyond the violation of trademarks and service marks at this time.”¹⁶ MPAA believes that such considerations remain relevant as WIPO considers new or expanded protections with respect to the registration of personal names in domain names.

WIPO noted in its final report on the First Internet Domain Name Process that some international norms do exist concerning the protection of trade names and geographical indications – which are in part the focus of this Second WIPO Internet Domain Name Process – although such norms are less evenly harmonized than national trademark laws. There was no suggestion, however, that any real uniformity exists with respect to the publicity rights, privacy rights, or other causes of action that form the bases of protection for personal names not subject to trademark or service mark protection. Indeed, as noted in the Interim Report of the Second Internet Domain Name Process:

¹⁶ *The Management of the Internet Names and Addresses: Intellectual Property Issues: Report of the WIPO Internet Domain Name Process*, at 45, WIPO Publication No. 439(E) (April 30, 1999) (hereinafter WIPO Final Report).

“[It cannot] be said that such protection as exists in various jurisdictions is well harmonized in its approach, application or enforcement. No international instrument, as in the case of trademarks, exists to establish uniform norms of protection for personality rights. Thus, even today, as questions concerning fairness in the use of personal identity continue to be raised in a number of different jurisdictions and contexts – including registration as a domain name – different legal theories, such as privacy, passing off, unfair competition, the right of publicity, or violation of certain civil code provisions, are relied upon by the courts to determine whether any relief is appropriate.”¹⁷

Even within the United States there is a lack of uniformity in the varying state common law and statutory protections relating to publicity rights. Other rights, such as privacy rights and certain common law torts, like defamation, are tied closely in the United States to First Amendment principles that are not uniformly recognized internationally.

All of this is not to say that additional protections for personal names may not be desirable, or even needed, in the DNS. The same principles that underlie policies for deterring abusive registrations of trademarked names also support mechanisms to deter similar abuses with respect to personal names and the other areas that are the subject of the Second WIPO Internet Domain Name Process. Again, MPAA generally supports policies that deter abusive conduct in the DNS, and we are open to new or expanded mechanisms where necessary to address such abuses. However, the disparities in national law in this area are likely to complicate any effort to formulate a global, consensus-based mechanism for resolving personal name disputes in the DNS beyond those that currently exist. Nonetheless, MPAA believes that such a consensus-based approach is indispensable to maintain the integrity of the UDRP and the international support necessary for its continued success.

If new or extended protections are to be established, MPAA believes that such protections should be narrowly crafted and rooted in commonly held principles of national law and public policy. Given difference in substantive national law and the varying bases of protection for individuals against the misuse of their names, the best possible approach might be to craft a narrow mechanism patterned after the provisions in section 3002 of the U.S. Anticybersquatting Consumer Protection Act or the California cyber-piracy statute. As pointed out in the Interim Report, even a review of those statutes will reveal substantive differences in the protections afforded. For example, the California statute requires a general showing of “bad faith intent to register, traffic in, or use an Internet domain name”, while the Federal statute requires a more restrictive showing of “specific intent to profit from such name by selling the domain name for financial gain.” The California statute provides protection for personal names of both living and deceased individuals, while the Federal statute provides protection only for the personal names of living persons. These disparities flow in large part from the fact that there has been little debate (domestically or internationally) regarding such statutes. Moreover, those that have been enacted remain to be tested. Nevertheless, if additional protections are to be

¹⁷ *The Recognition of Rights and the Use of Names in the Internet Domain Name System: Interim Report of the Second WIPO Internet Domain Name Process*, at 44 (April 12, 2001) (hereinafter WIPO Interim Report).

developed, a narrowly targeted approach along the lines of those embodied in these statutes is most like to garner the necessary consensus.

4. TO THE EXTENT WIPO CONSIDERS ADDITIONAL PROTECTIONS ARE NEEDED, SUCH PROTECTIONS MUST ACCOMMODATE LEGITIMATE AND PROTECTED USES OF PERSONAL NAMES

Should WIPO conclude that additional protections are needed to protect against abusive registrations of personal names and that there does exist sufficient uniformity of national law to support an international mechanism for addressing such abuses – whether through the UDRP or some other mechanism – MPAA submits that any such mechanism must be crafted so as to accommodate legitimate, non-abusive registrations and uses of personal names in domain names. The questions posed by the RFC-2 in paragraph 20.4 as to how to define “bad faith, abusive, misleading or unfair registration and use in respect of personal names” and in paragraph 20.5 as to how to “deal with multiple incidences of the same name” both reflect the fact that there will clearly be circumstances in which the registration of personal names is not abusive and the ability of registrants to maintain rights in such registrations should be preserved. Included among those are certain registrations and uses of domain names undertaken in connection with creative works and other forms of expression, which are protected by the First Amendment.

At common law and in statute, the balance between publicity rights and certain forms of protected expression is struck by operation of exceptions and limitations under which the publicity rights of the individual must give way to the overriding policy concerns of free expression. For example, the California right of publicity statute exempts from its scope uses of a deceased person’s name, voice, signature, photograph, or likeness in connection with certain fictional or non-fictional entertainment, or a dramatic, literary, or musical work.¹⁸ Similarly, other causes of action tied to expressive conduct, such as defamation or invasion of privacy, are strictly limited by First Amendment considerations. Similar considerations must be reflected in any mechanism crafted to address abusive registrations of personal names as domain names.

The U.S. Congress addressed this issue in the context of the DNS when it enacted section 3002(b) of the Anticybersquatting Consumer Protection Act, which as indicated above prohibits the registration of a personal name as a domain name with the specific intent to profit from such name by selling the domain name for financial gain. As enacted, the statute specifically excepts the registration in good faith of a personal name in a domain name “if such name is used in, affiliated with, or related to a work of authorship protected under [the U.S. Copyright Act].”¹⁹ According to the legislative history, this exception seeks to “recognize the First Amendment issues that may arise in such cases and defer[s] to existing bodies of law that have developed

¹⁸ Cal. Civ. Code § 3341.1(a)(2).

¹⁹ P.L. 106-113, app. I, tit. III, § 3002(b)(1)(B), 113 Stat. 1501A-545 (1999) (codified at 15 U.S.C. § 1129(1)(B)). This exception provides, in full, that “[a] person who in good faith registers a domain name consisting of the name of another living person, or a name substantially and confusingly similar thereto, shall not be liable under this paragraph if such a name is used in, affiliated with, or related to a work of authorship protected under title 17, United States Code, including a work made for hire as defined in section 101 of title 17, United States Code, and if the person registering the domain name is the copyright owner or licensee of the work, the person intends to sell the domain name in conjunction with the lawful exploitation of the work, and such registration is not prohibited by a contract between the registrant and the named person.”

under State and Federal law to address such uses of personal names in conjunction with works of expression.”²⁰ The California cyber piracy statute contains a similar exclusion, stating that the prohibition against bad faith registration, trafficking in, or use of a personal name as a domain name does not apply “if the name registered as a domain name is connected to a work of authorship, including, but not limited to, fictional or nonfictional entertainment, and dramatic, literary, audiovisual, or musical works.”²¹ The pending legislation in Louisiana and Hawaii also contain equivalent provisions.

To the extent new or extended mechanisms for dispute resolution are considered to address abusive registrations of personal names as domain names, those mechanisms must accommodate such legitimate uses of personal names in connection with creative expression and free speech. Specifically, any such mechanism should make clear that the definition of “bad faith, abusive, misleading, or unfair registration and use” in respect of personal names does not reach such conduct and that personal names that are registered as domain names in connection with a work of authorship are specifically exempted.

5. OPTIONS PUT FORWARD FOR FURTHER COMMENT BY THE INTERIM REPORT

MPAA appreciates WIPO’s efforts to put forward a number of options for discussion with respect to personal name protection. Because of the difficulties described above, and because the existing UDRP is working well in most cases, MPAA believes it would not be unreasonable to adopt an approach along the lines of the first option set forth in the Interim Report (i.e., “wait-and-see”). At the same time, as already indicated, MPAA is not opposed to new or expanded protections for individuals that are consistent with the principles outlined above. While the second option set forth in the Interim Report is generally consistent with this approach, we wish to offer some specific comments with respect to the details of that proposal.

As set forth in the Interim Report, the second option would provide for amendments to the UDRP to add a new and narrow category of claims for individuals whose names are the subject of bad faith and abusive domain name registrations. Individuals who can assert sufficient distinctiveness in their names would given added protections where they can demonstrate the existence of the following elements:²²

- (i) The personal name must be shown to be sufficiently distinctive in the eyes of the relevant public, such that it clearly identifies the complainant in question;
- (ii) There must be a commercial exploitation of the personal name through its registration and use as a domain name;
- (iii) The commercial exploitation must be unauthorized;
- (iv) Bad faith must be demonstrated, which can be shown through the illustrative and non-exhaustive factors currently listed under the UDRP, with an additional factor as follows:

²⁰ S. Rep. No. 479, *supra* note 5, at 109.

²¹ Cal. Bus. & Prof. Code § 17525(b).

²² Interim Report at 63.

- facts that indicate an intentional effort to take advantage of the reputation or goodwill in the personal identity of the person; and
- (v) The interests of freedom of speech and the press need to be taken into account, such that application of this personality right in the DNS should only prohibit use of the personal name for commercial purposes (i.e., cases of alleged libel and slander would not fall within the scope of the procedure).

MPAA believes that the bad faith intent requirement is an essential component of any successful dispute resolution policy. Indeed, it is because the UDRP is narrowly tailored to address only bad-faith registrations that it is able to provide timely and consistent results and enjoy such broad international support. It is unclear, however, why the requirement of distinctiveness is needed, or desirable, if a demonstration of bad-faith is required as a condition of relief. If a complainant is able to establish the registrant's bad faith intent to take advantage of the reputation or goodwill in the personal identity of the complainant, it would seem that a policy aimed at curbing abusive registrations of personal names should apply whether or not the person whose name is taken is famous or "distinctive." If an individual is the target of a cybersquatter who, in bad faith, registers that individual's name in an effort to gain some unfair advantage, any policy designed specifically for the protection of individuals against cybersquatting should apply whether that person was targeted because they were famous or because the cybersquatter picked their name out of a phone book.

It is also slightly unclear whether the "commercial exploitation" required by clause (ii) anticipates some commercial exploitation other than the act of registration and use of the name as a domain name. Again, with a demonstration of bad faith as a prerequisite to relief, registration and use of the domain name in bad faith should be sufficient to meet the commercial exploitation requirement.

Finally, while MPAA strongly supports WIPO's recommendation that the interests of freedom of speech and the press need to be taken into account, we are concerned that such interests are not fully accounted for by a limitation that shields only noncommercial registrations from the definition of bad faith and abusive conduct. As recognized in the U.S. Anticybersquatting Consumer Protection Act, the California cyber-piracy statute, and the pending bills in Louisiana and Hawaii, there will also be uses of personal names in conjunction with works of authorship – many of which are commercial in nature – that are protected in the interests of freedom of expression. For example, the registration of forestgump.com or jerrymaguire.com for a web site promoting those movies would not be abusive or in bad faith, and would be protected by the First Amendment, notwithstanding their commercial nature. Such interests are not limited to the motion picture industry, but extend to all those engaged in creative and expressive activity. MPAA believes it is essential that if new or expanded protections are crafted for the protection of individuals that they clearly exclude from the definition of bad faith and abusive conduct registrations that are related to works of authorship. Once again, the U.S. Anticybersquatting Consumer Protection Act and the California cyber-piracy statute serve as appropriate models.

6. “WHOIS” SERVICES ARE KEY TO ANY MEANINGFUL EFFORT AT “DOMAIN NAME COLLISION CONTROL”

The RFC-2 solicits comments on technical solutions “to reduce the tension between rightholders and domain name registrants.” This inquiry follows on the First WIPO Internet Domain Name Process, which sought comments on, among other things:

The requirements of any domain name databases (including the type of information to be stored therein) that may be developed to allow domain name applicants, holders of intellectual property rights, and other interested parties to search for and obtain information for purposes of evaluating and protecting any potentially related intellectual property rights. These requirements may include, in particular, the need to make the information accessible through a common interface and to interlink databases that may be maintained by various registries and/or registrars in order to permit single comprehensive searches.”

Reflecting the findings from that inquiry, the final report in the First WIPO Internet Domain Name Process recommended that contact details of all domain name registrants in the gTLDs be made publicly available in real time as a means of ensuring a “straightforward means of applying the developed body of law concerning commercial practices” in the online environment.²³ These recommendations were in turn reflected in the ICANN Registrar Accreditation Agreement now in effect, which requires all ICANN-accredited registrars to provide free, real-time public access to registrant contact data (Whois data).

Unfettered real-time access to current and accurate Whois data is key to any meaningful effort at “domain name collision control”. Public accessibility to such data provides much-needed transparency in the DNS and accountability for those who hold themselves out to the public over the Internet. As such, it is an important tool not only for intellectual property owners – who rely on Whois data to combat cybersquatting and all forms of online infringement – but also for parents, consumers, Internet service providers, network engineers, law enforcement, and others. This transparency and accountability serves to both facilitate the redress of abusive and unlawful conduct in the DNS and to deter such conduct in the first place.

As a participant in the Copyright Coalition on Domain Names (CCDN) of the ICANN Intellectual Property Constituency, MPAA endorses, and wishes to underscore here, the comments submitted by the CCDN in response to the RFC-2 on this particular issue. First, the ccTLD operators should be encouraged to adopt policies for the collection, verification, and public availability of Whois data that, at a minimum, reflect the policies embodied in the current ICANN Registrar Accreditation Agreement. WIPO is in a unique position to have an impact on this question as it endeavors, in response to the request of several of its member states (including the United States), to assist ccTLD administrators in developing best practice guidelines to address intellectual property concerns in the administration of the ccTLD registries. MPAA applauds WIPO for its efforts in this area, and in particular supports the recommendations with respect to the collection and availability of registrant contact details in the recently unveiled

²³ WIPO Final Report, *supra* note 16 at 25.

“ccTLDs Best Practices for the Prevention and Resolution of Intellectual Property Disputes.” Second, WIPO should recommend to ICAAN that the Whois obligations reflected in the current ICANN Registrar Accreditation Agreement be extended as a baseline requirement in any new TLDs that are introduced. Third, WIPO should pursue recommendations to ICANN that it adopt a policy, explicitly anticipated by the current Registrar Accreditation Agreement but so far not realized, for the implementation of a comprehensive cross-registry, fully-searchable Whois service that, in the words of the RFC-2, “would operate on a variety of platforms and be compatible with all relevant DNS registration authorities.” As indicated in our CCDN comments, the failure to adopt and implement such a policy concurrently with the introduction of competition at the registrar level and the delegation of responsibility for providing Whois services to the various registrars has resulted in a system where public access to Whois data is even more fragmented, less consistent, and less robust today than it was when WIPO issued its final report in the First WIPO Internet Domain Name Process. This situation must be addressed now, particularly with threat of further fragmentation of Whois services that is posed by an increasing number of unrestricted ccTLDs and with the introduction of new TLDs that is now under way at ICANN. Again, WIPO is in a unique position to an impact in this area, and we encourage you to continue to take a leadership role.

7. CONCLUSION

MPAA appreciates the efforts of WIPO in this Second Internet Domain Name Process, and particularly its efforts to promote policies and procedures to deter abusive registrations and bad faith, misleading, or unfair conduct in the DNS. While MPAA supports such policies, and while we do not object to new policies or procedures for resolving personal name domain name disputes, we believe that any such policies must be narrowly crafted, they must be based on broad consensus and widely shared principles of national law and public policy, and they must not undermine the integrity of or support for existing dispute resolution mechanisms in the DNS. Any such policies or procedures must also be carefully crafted so as to accommodate legitimate, non-abusive registrations of personal names, including good-faith registrations in connection with creative expression and protected speech. Such considerations are reflected in the U.S. Anticybersquatting Consumer Protection Act and the California cyber piracy statute, both of which provide exemptions for domain name registrations related to or connected with a work of authorship. Finally, MPAA supports the further inquiry as a part of this Second Process into technical solutions for “domain name collision control”. We urge WIPO to recommend to ICANN that it adopt a policy and uniform standards for a single, comprehensive, fully-searchable cross-registry Whois service and that such a service be implemented by all TLD registries in the gTLDs, new TLDs, and ccTLDs.

Thank you again for the opportunity to share the perspectives of the MPAA with respect to the substance of these issues. Please feel free to contact me if you have additional questions.

Sincerely,

/S/

Troy Dow
Counsel
Technology & New Media

[process2-comments] WIPO-2 RFC-3

To: process.mail@wipo.int

From: "Government of Canada"

Subject: GOVERNMENT OF CANADA SUBMISSION FOR THE SECOND WIPO INTERNET DOMAIN NAME PROCESS

Date: July 5, 2001

GOVERNMENT OF CANADA SUBMISSION FOR THE SECOND WIPO INTERNET DOMAIN NAME PROCESS

Canada would like to thank the World Intellectual Property Organization (WIPO) for its thorough research in preparing the comprehensive Interim Report of the Second WIPO Internet Domain Name Process ('Second Process') and is pleased to make a submission in response to the request for comments.

The issues raised in the Second Process are complex. Canada believes in the importance of an efficient and inexpensive system for granting domain names that facilitates both growth of the Internet and broader participation. Similarly, Canada supports policies which serve to reduce and resolve conflicts between domain name and other right holders in an expeditious and affordable manner. Canada favours a consensus-based approach in moving forward on these issues because of their newness and dynamism, and the difficulty in determining the consequences of expanding the scope of the Uniform Domain Name Dispute Resolution Policy (UDRP), independent of principles embodied in national laws, and international treaties and agreements.

The further evolution of the domain name system (DNS) and demand for new domain names will likely compound the tension between the use of identifiers in the virtual world, and those same identifiers in the physical world. As a general principle, Canada believes that framework rules ought to be the same for both the physical and virtual worlds.

The current practice of allowing the registration of International Nonproprietary Names for Pharmaceutical Substances (INNs) as domain names may suggest a proprietary right in INNs on-line, to which holders would not be entitled in the off-line environment. As such, some form of protection within the DNS for INNs may therefore be appropriate.

Issues related to geographical indications are significant and far from settled. The vigorous debates that have taken place within the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) and in other fora such as TRIPS Council clearly demonstrate the ongoing difficulties in international harmonization. As a result,

it is premature to move forward in developing new legal principles for geographical indications in relation to domain names in isolation of such ongoing work. Canada supports the recommendation not to introduce an exclusion mechanism for geographical indications, but does not support the recommendation that the scope of the UDRP be broadened to cover abusive registrations of these terms. We believe that this issue is worthy of further consideration in a timely manner in the context of ongoing WIPO work.

The issues pertaining to geographical names, which are currently not subject to protection under intellectual property laws, give rise to a number of questions. There is no international consensus on the answers. The registration of the names of the world's indigenous peoples as domain names also merits further study as part of WIPO's ongoing work in the Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore.

Should WIPO make recommendations with respect to the DNS for identifiers not governed by existing international agreements, it should also advise how those recommendations could be implemented without creating new legal rights or obligations.

Canada appreciates the significant advances WIPO has made in gaining a better understanding of such complex issues. We look forward to receiving WIPO's Report on the Second Process and to working together with the international community in promoting improved use of the Internet.

Thank you.

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[process2-comments] WIPO-2 RFC-3

To: process.mail@wipo.int

Name: Jeff Watson

Organization: The Patent Office

Position: Senior Policy Advisor

Date: Fri, 1 Jun 2001 12:32:04 +0200

Please attach comments

[wiposec.doc](#)

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THE RECOGNITION OF RIGHTS AND THE USE OF NAMES IN THE INTERNET DOMAIN NAME SYSTEM - COMMENTS ON THE WIPO INTERIM REPORT (PUBLISHED 12 APRIL 2001)

We recognise the success of the ICANN Uniform Dispute Resolution Policy (UDRP) in dealing with disputes concerning domain names, and conversely recognise the complex issues raised by the five topics examined in the WIPO report. Taking account of this complexity and the broad interests involved, further comments on the final report may well be useful and appropriate before implementing the report's recommendations.

International Nonproprietary Names for Pharmaceutical Substances (INNs)

We agree with the recommendations with regard to INNs:

- they should be protected against bad faith, abusive, misleading or unfair registration;
- no need to extend the UDRP to deal with them specifically;
- they should be automatically excluded from domain registration.

However we doubt the practicality of applied such a recommendation retrospectively.

International Protection for Names and Acronyms of International Intergovernmental Organisations (IGOs)

We note that IGOs are protected under TRIPS and the Paris Convention, and that this protection could provide a sound basis for protection of IGOs on the Internet and for dealing with disputes. However we agree that there does not seem to be a specific need to extend the UDRP to deal with IGOs. Where an IGO does function as a trade mark then the existing UDRP should be relevant.

Personal Names

Personal name disputes involve complex legal issues. We note that the existing UDRP has dealt effectively with a number of bad faith registrations of personal names. However where it is not possible to establish bad faith use easily, we doubt that the UDRP can be applied effectively to personal name disputes. One particular problem is distinguishing famous names from others. We see no clear need to extend the UDRP at the moment to deal with personal name disputes, especially as ICANN is about to introduce new gTLDs,- one of which is specifically for personal names. We should instead wait and see how the introduction of dot names and the other gTLDs affects the registration of personal names and learn any lessons from "dot names" use of the UDRP. In particular do not support the option to modify the UDRP specifically for applications in the dot name gTLD. No reason why a personal name dispute in the dot name domain should be handled any differently from a personal name dispute in say the dot com or dot net domains.

Geographical Indications, Indications of Source and other Geographical Terms

Agree that the UDRP should be extended to cover geographical indications and indications of source where there are explicit IP rights. (support recommendation 227). Do not support the idea of developing an exclusion list of restricted registrations because it is extremely difficult to draw up a comprehensive list in advance. It is also difficult to retrospectively deal with

existing registrations that are included on any exclusion list. Instead registrations should be dealt with on a case by case basis through a dispute procedure. On who should stand a complaint, UK preference is for this to be determined on the basis of the law designated applicable to this question by the panel in accordance with the rules of private international law (ie option iii on page 78_).

On geographical indicators which are beyond IP (ie country names, municipal names etc), support recommend 274 and 275. In particular strongly support recommendation that we should not make retrospective recommendations affecting use of ISO 3166 code elements in current existing gTLDs. For new gTLDs, each relevant authority should be able to decide whether it wishes its ISO 3166 code element to be used in the second level of domain name registrations.

On protecting names of countries and names of places within countries in gTLDs, support option 2 of recommendation 285 i.e. introducing some sort of action into the UDRP to deal with protection of such names. Also agree that in the first instance, this should be limited to protection of countries and administratively recognised regions and municipalities within countries, but WIPO should look at extending the scope of protection if the modification to UDRP is deemed successful. Such an extension will need to be crafted with care and, in particular, we support the "bad faith" test as set out in para 283

Trade Names

We agree that the UDRP should be extended to cover trade names. This extension should be limited to allow a trade name holder to protect the reputation or good will associated with his name against bad faith, abusive, misleading or unfair use of his name as a domain name.

The Role of Technical Measures

We would like to endorse recommendations 341, 345, 347, 352, and 353 relating to WHOIS data search facilities. We recognise the importance of comprehensive, up-to-date and accurate WHOIS data for intellectual property rights owners. Such data is key to allowing them to identify and locate a potential infringer. WHOIS is also an extremely useful tool for tracking illegal content or activities on the internet such as fraud or child pornography. However the provision of such data needs to take account of the data protection rules or legislation applicable in the territory where the gTLD or ccTLD is located and a balance needs to be found between providing a comprehensive WHOIS service and respecting these data protection principles. In particular abiding by local data protection principles should not prevent any territory from being able to run a ccTLD or gTLD . Instead alternative methods to satisfy the WHOIS requirements of IP owners and others should be developed, for example allowing the WHOIS database to display the contact details of a trusted third party, rather than the registrant's details.

Jeff Watson
Senior Policy Advisor
on behalf of The Patent Office and the Department of Trade & Industry

[process2-comments] WIPO-2 RFC-3

To: process.mail@wipo.int

From: "Eric E. Menge" <eric.menge@sba.gov>

Subject: RFC-3

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Name: Eric E. Menge

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[testimony.doc](#)

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Sent via e-mail.

**Before the
World Intellectual Property Organization
Geneva, Switzerland**

In the Matter of

Second WIPO)	
Internet Domain Name Process)	RFC-3
)	
)	

**Comments on the Interim Report
of the Second World Intellectual Property Organization
Internet Domain Name Process
by the Office of Advocacy
U.S. Small Business Administration**

The Office of Advocacy of the United States Small Business Administration (“Advocacy”) is responding to the World Intellectual Property Organization’s (“WIPO”) Request for Comments (“RFC-3”) on its Interim Report of the Second WIPO Internet Domain Name Process. The WIPO has issued a general request to all interested parties to review the issues presented in the Interim Report and submit comments on the issues and recommendations. Advocacy has reviewed the Interim Report and submits the comments below.

The United States Congress established the Office of Advocacy in 1976 by Pub. L. No. 94-305, codified as amended at 15 U.S.C. §§ 634(a)-(g), 637, to represent the views and interests of small business before policy-making bodies. Advocacy’s statutory duties include serving as a focal point for concerns regarding policies as they affect small business, developing proposals for changes in policies, and communicating these proposals to the decision makers, 15 U.S.C. § 634(c)(1)-(4). It is in this capacity that Advocacy is pleased to submit the following comments to the Interim Report on behalf of U.S. small businesses.

1. Small Businesses Play an Important Role on the Internet.

Before Advocacy addresses the issues raised in the Interim Report, it is important to provide some statistical information on U.S. small businesses and the impact that the WIPO’s recommendations will have on them. The Office of Advocacy has used U.S. Census data and other data independently collected to produce studies that yielded the following statistics. These studies can be found on Advocacy’s Web page at <http://www.sba.gov/stats>.

- Small businesses represent more than 99 percent of all U.S. employers.
- They employ 52 percent of U.S. private-sector workers.
- They employ 38 percent of U.S. workers in high-tech occupations.

- They provide about 75 percent of the net new jobs in the United States.
- They provide 51 percent of the private sector output in the United States.
- They provide 55 percent of innovations as measured by U.S. patent registrations.
- Important innovations by small businesses include the airplane, the audio tape recorder, the heart valve, the optical scanner, the zipper, the personal computer, and speech recognition technology.
- 35 percent of U.S. small businesses have a Web site – which is approximately 5.6 million to 8.4 million businesses.
- According to Verisign, 80 percent of the “dot com” Internet domain names were registered to small businesses of 500 employees or less in December 2000.

The foregoing statistics demonstrate that small businesses are a dominant part of the United States economy and are the predominant creators of Web sites and users of the Internet. The Internet has become an extremely important mechanism for many small businesses to conduct business transactions electronically. Small businesses in many other nations also play an important role in their nations’ economies and are becoming increasingly major users of the Internet, including for electronic commerce. Information about small business and electronic commerce is the subject of several of our economic studies which can be found on our Web page (<http://www.sba.gov/advo>). Consequently, any proposals involving the registration of domain names and their use on the Internet need to take into account the impacts such proposals could have on small businesses, both in the United States and internationally.

2. Fundamental Concepts Underlying Advocacy’s Comments.

Our observations and comments on the Interim Report which follow are based on certain fundamental concepts applicable to some or all of the issues raised in the Interim Report. Most importantly, “words” are the building blocks of our languages, and are meant to be *in* circulation for general use by society. Removing or restricting the use of words in our languages restricts our ability to communicate freely, both domestically and internationally. Small businesses are very creative in using the words of our languages in describing themselves on the Internet and commonly use, among other things, acronyms, abbreviations, personal names, geographical terms, trade names, generic or descriptive terms, and suggestive, arbitrary, or catchy terms. Removing or restricting the use of words would severely impact the ability of small businesses and other entities to use the Internet effectively and competitively, and would place small businesses at a particular disadvantage. Several of the proposals in the Interim Report would have the effect of taking out of circulation, entire groups of words or terms. This would have the effect of limiting and inhibiting the use and growth of the Internet by small businesses and other users.

Furthermore, the Interim Report does not present a compelling case of problems in need of being fixed. For example, the Interim Report has *not* indicated or documented any widespread problems associated with the use of International Non-proprietary Names,

International Intergovernmental Organizations, personal names, geographical terms, or trade names. Hence, Advocacy questions the need for establishing a complicated process aimed at fixing an alleged problem that has not even been demonstrated to exist to any significant extent. Rather, a “wait-and-see” approach should be taken to determine whether there is any reason for concern.

3. Whois Data Searches.

Advocacy has no objections to global, searchable Whois services. Whois services are used to determine the name and contact information for domain name registrants. Whois services can be utilized remotely over the Internet. Privacy issues inherent in a global, searchable Whois are not as severe for small businesses as they are for individuals and non-profit organizations. Small businesses hold themselves out to the public in the course of doing business. In addition, U.S. small businesses must register with a variety of governmental authorities so their contact information is a matter of public record. Nonetheless, we believe that WIPO should be commended for considering data protection and privacy because of the enormous public interest involved. Advocacy has two proposals on how to protect privacy while preserving an efficient Whois.

First, the Whois service should permit post office boxes (P.O. boxes) as valid addresses. Several million U.S. small businesses are home-based businesses. With advances in technology, we only expect this number to grow. A P.O. box offers a measure of privacy while still providing a contact address. The P.O. box should be checked regularly so that time-sensitive material sent to the P.O. box is received in time. Invalid P.O. boxes would be grounds for domain name revocation just as if the registrant had provided a false street address.

Second, the WIPO should explore the possibility of allowing registrants to be "unlisted" on Whois services to the casual viewer. Similar to the U.S. phone system, the registrant could pay an additional fee to the registrar or registry to have portions of their contact information blocked. This information would be revealed to an inquiring party that has a bona fide reason to know the information – such as an intellectual property owner who is pursuing a trademark infringement claim. Advocacy recognizes that the proposal would have to undergo significant development before it becomes an acceptable solution. Advocacy recommends that the WIPO consider a future proceeding to work out the details of this proposal.

4. International Non-Proprietary Names for Pharmaceutical Substances.

The Interim Report recommends preventing registration of International Non-proprietary Names (INNs) as domain names and canceling the registration of existing domain names that correspond to INNs. INNs are unique names used to identify a pharmaceutical substance or active pharmaceutical ingredient. INNs are selected by the World Health Organization (WHO), who maintains a list of recommended INNs, which numbers more than 8,000.

The Office of Advocacy does not support an exclusion granted to INNs. We believe that it is both overinclusive and underinclusive. It is underinclusive because it does not purge the Web of misinformation about the substances. It is overinclusive because it cancels the domain names for sites that are not a threat to public health and safety. Furthermore, Advocacy is unsure if ICANN has the authority to prohibit future registration of INNs and cancel existing domain name registrations. If it does have the authority, Advocacy inquires whether cancellation of currently registered domain names amounts to a regulatory taking which could trigger a requirement for reimbursement for parties subject to U.S. law.

Instead of restricting registration of domain names, Advocacy recommends that the WIPO consider the establishment of a new top level domain (TLD) such as .INN or .drug, which would be administered by the WHO. The WHO could use this TLD to provide factual and objective information about the drug. Advocacy believes that this option will preserve public health and safety and the generic nature of INNs without restricting registration or canceling domain name registrations.

5. International Intergovernmental Organizations.

The Interim Report states that the .int TLD is insufficient to protect International Intergovernmental Organizations (IGOs) in the rapidly evolving on-line world. It proposes that the names and acronyms of IGOs protected under treaty should be excluded from registration in all existing and future generic TLDs (gTLDs), including the cancellation of existing domain name registrations.

The Office of Advocacy does not agree with this conclusion. We believe that the .int TLD is perfectly capable of protecting IGOs. We liken the challenge that IGOs face to that which is faced by the U.S. Small Business Administration (SBA). The SBA has registered the second-level domain “*sba*” on the .gov registry. The .gov registry is used to denote a U.S. government Web site. We have found that the specialty TLD of .gov protects our interests admirably. The second level domain name “*sba*” is registered on several of the other existing TLDs and there has been little confusion. For example:

- *sba.net* = SBA Automatisering (dutch high tech firm)
- *sba.org* = Southern Bakers Association
- *sba.com* = Smith, Bucklin & Associates

If the WIPO recommends excluding domain names that correspond to IGO names and abbreviations and ICANN enforces this recommendation, many small business Web sites will be taken down (*e.g.*, uno.com, ida.com, wto.com, and ucc.com). It will prevent numerous three and four letter domain names from being utilized in any gTLD, which are very popular names for small businesses. Moreover, it will take out common words or terms, such as “who,” “imo” – a

popular Internet chat expression (“in my opinion”), and “uno.” This number gets exponentially larger if the restriction is extended to include misleading registrations.

Advocacy recommends that the .int gTLD be strengthened and that all IGOs receive the domain name appropriate in this gTLD. IGOs that currently use domain names outside the .int gTLD (*e.g.*, imo.org and wto.org) should maintain their existing names but also have the equivalent domain names in the .int gTLD resolve to their IP address as well. If the .int gTLD is used consistently and universally by all IGOs, users will recognize the importance and meaning of the .int gTLD. This distinction will become even more apparent as more gTLDs are added to the Web and the TLD becomes a means of identifying the broad categories of Web pages on the Internet.

6. Personal Names.

Advocacy reviewed the Interim Report’s discussion and proposals for restricting the registration and use of personal names and is concerned that such proposals would interfere with the ability of small businesses to use effectively the Internet in support of their business activities. The use of “personal” names, including first names, surnames, and full names, is very common and important to *many* small businesses. Most of these names are neither famous nor distinctive. Small businesses often use their *own* personal names, either alone or in conjunction with other terms, in their business (trade) names.

Personal names are an important means for many small businesses to identify themselves and to add a “personal” connection with the local community they serve. As a result, these small businesses typically use their business names containing their personal names in their domain name registrations. Restriction, or complete removal from use, of personal names in domain name registrations would limit many small businesses from being able to identify themselves to and connect their businesses with their community. U. S. law, particularly at the Federal level, provides only limited protection for personal names, thereby allowing essentially unrestricted use of personal names by small businesses and others.

In addition, there are many personal names that also have *dual* or *secondary* (*i.e.*, both personal name and non-name or general) meanings, such as: “smith,” “ford,” “potter,” “carpenter,” “farmer”; “john,” “art,” “frank,” “patty,” “dick,” “bob,” “terry.” Any proposal aimed at precluding or restricting the registration of personal names would end up unacceptably removing many general or generic words of our languages from use. General words, by their nature, are the building blocks of our languages and, as already discussed, are meant to be in circulation for general use by society. Consequently, any proposal that would remove general words from use in domain name registrations, including personal names with secondary meanings, cannot be supported by Advocacy.

Furthermore, Advocacy is concerned that there is not, and there cannot be, a definitive list of personal names. While many personal names are commonly used, many others are not. A set of personal names could not be defined which is neither underinclusive nor overinclusive. An overinclusive proposal would end up removing from use names that also have secondary meanings, thereby unacceptably removing many words of our languages from use. On the other hand, an underinclusive proposal would inequitably restrict some names while leaving other names in the public domain.

Small business people should have an equal opportunity to use their names in domain names as others do. Consequently, Advocacy does not support any approach that would restrict the use of personal names. To do so would severely and disproportionately impact small businesses. Rather, Advocacy recommends that a “wait-and-see” approach be taken to determine whether there is any reason for concern, and delay amending the Uniform Dispute Resolution Policy (UDRP) to see if there are disputes or questions in need of resolution.

7. Geographical Terms.

The Interim Report contains discussion and proposals for restricting the registration and use of geographical terms. Advocacy is concerned about such proposals because many small businesses use geographical terms, either alone, or in conjunction with other (non-geographic) terms, in their business (trade) names. Many small businesses associate themselves with their local communities by adding a personal connection with the geographical areas they serve through the use of geographical terms in their business names and registered domain names. Restricting or completely removing geographical terms in domain name registrations from use would limit the ability of small business people to identify themselves to and connect with their geographical area.

Additionally, in many instances, it is unclear whether a term is “geographical” or not. In other instances, a geographical term may have *dual* or *secondary* (i.e., both geographical and non-geographical, or general) meanings. *For example:* “Bend,” Oregon. Advocacy is concerned that any proposal that would restrict or prohibit the registration of geographical terms would unacceptably remove many general words of our language from circulation for general use by society. Hence, Advocacy cannot support any proposal that would eliminate from use general words in domain name registrations, including geographic terms with secondary meanings.

Advocacy also is concerned that many geographical names are duplicated throughout the world. There is no fair and rational basis for one jurisdiction to have standing, such as under the Uniform Dispute Resolution Process, over another jurisdiction, or to have priority to use a name over another jurisdiction with the same name. *For example:* “Athens,” Georgia *versus* “Athens,” Greece; “Lebanon,” Pennsylvania *versus* “Lebanon,” New Jersey *versus* the country of “Lebanon.” Conflicts like this have not been, but need to be, adequately evaluated before any

attempts to proceed ahead. Advocacy is very concerned about potentially giving nations or other governmental units extraterritorial powers and effect over domain name registrations.

Moreover, there is no definitive list of geographical terms, and it would be impossible to define a set of geographical terms that is not underinclusive or overinclusive. Advocacy is concerned that an overinclusive proposal would end up removing from use geographical terms that also have secondary meanings (see discussion above), while an underinclusive proposal would inequitably restrict some geographical terms while leaving other names in the public domain. Furthermore, many geographical terms are also personal names. *For example:* “Washington,” D.C. *versus* George “Washington”; “Madison,” Wisconsin *versus* James “Madison”; the Commonwealth of “Virginia” *versus* “Virginia” Dare. The proposals have not adequately considered how terms that are both geographic and personal (and possibly also generic) would be handled.

For the foregoing reasons, restricting the registration and use of geographical terms would severely impact many small businesses and their ability to use the Internet effectively and competitively. Small businesses should have an equal opportunity to use geographical terms in domain names. Therefore, Advocacy does not support an approach that would restrict the use of geographical terms. Advocacy encourages a “wait-and-see” approach with geographical terms to determine whether there is any reason for concern. Advocacy also encourages that any amendments to the UDRP be postponed to determine whether disputes or questions are arising which need to be resolved.

8. Trade Names.

The Interim Report discussed proposals for restricting the registration and use of trade names. Advocacy is concerned about proposals to restrict the registration and use of trade names because trade names are the fundamental way that businesses, whether small or large, identify themselves on the Internet and in other avenues of commerce. Many trade names are neither famous nor distinctive, and many are also used as trademarks.

Trade names encompass a very broad and ill-defined area. Small businesses use a wide variety of terms to identify themselves, for example, acronyms, abbreviations, letter sequences, generic or descriptive terms, suggestive, arbitrary, or catchy terms, and, as already noted, personal names and geographical terms. Any proposal aimed at precluding the registration of trade names will end up unacceptably removing many such terms from circulation for general use. Moreover, there never will be a definitive list of trade names, as the universe of trade names is constantly evolving over time, with the addition and removal of trade names daily as businesses start up and cease operating.

Consequently, Advocacy does not support any approach that would restrict the use of trade names. Advocacy does not see a need to address protection of trade names, and *agrees*

with the Interim Report recommendation that no special procedure is needed at this time, through the UDRP or otherwise, to protect trade names against abusive registration and use practices.

Restricting the registration and use of trade names would greatly impact and place at a severe disadvantage, many small businesses and their ability to use the Internet effectively and competitively.

9. Conclusions.

The Interim Report does not present a compelling case of problems in need of being fixed. Hence, Advocacy questions the need for establishing a complicated process aimed at fixing an alleged problem that has not even been demonstrated to exist to any significant extent. Rather, a “wait-and-see” approach should be taken to determine whether there is any reason for concern.

Aside from having not been demonstrated to be necessary, Advocacy is concerned that the Interim Report’s proposals pertaining to INNs, IGOs, personal names, geographical terms, and trade names would severely and disproportionately impact small businesses. Any proposals involving the registration of domain names and use on the Internet need to take into account the impacts such proposals could have on small businesses.

Advocacy wishes to thank the WIPO for this opportunity to submit comments. We are happy to work with the WIPO staff on small business issues in this and other proceedings.

Sincerely,

/s/ _____
Eric E. Menge
Assistant Chief Counsel for Telecommunications

/s/ _____
Jonathan R Pawlow
Assistant Chief Counsel for Intellectual Property

June 14, 2001

[process2-comments] WIPO-2 RFC-3

To: process.mail@wipo.int
From: "Robert L. Stoll" <robert.stoll@uspto.gov>
Subject: RFC-3
Date: Thu, 14 Jun 2001 21:07:15 +0200

Name: Robert L. Stoll
Organization: U.S. Patent and Trademark Office
Position: Administrator, Office of Legislative and International Affairs

The United States Patent and Trademark Office is pleased to submit its comment on the World Intellectual Property Organization's Interim Report on the Second Domain Name Process.

[wipo2-comments.doc](#)

Back to [Browse Comments](#) for WIPO-2 RFC-3

June 14, 2001

The United States Patent and Trademark Office (USPTO) appreciates the opportunity to comment on the World Intellectual Property Organization's Interim Report on the Second Domain Name Process (WIPO Report).

The WIPO Interim Report suggests a variety of solutions to perceived cybersquatting problems in the domain name space as regards personal names, trade names, intergovernmental organizations (IGOs), pharmaceutical non-proprietary terms (INNs), and geographical indications, indications of source, and other geographical terms. The USPTO would like to commend WIPO for this thoroughly researched, well-reasoned, and useful exploration of cybersquatting problems, either anticipated or experienced, in the areas that are the subject of the Report. The Report does, in fact, achieve the objective noted in paragraph 22 by providing "greater clarity in the identification and definition of issues." The issues addressed in the Report are difficult ones. Thus, WIPO's contribution to the Internet Domain Name System debate is particularly noteworthy for the complexity of the analysis and the clarity of the language used to describe the options available.

The USPTO particularly appreciates the Report's comments in paragraph 18 that the approach of the Second Domain Name Process is to seek "to identify clearly where the existing legal framework is insufficient to cover any proposed interest under consideration." Certainly, the WIPO Report serves as an invaluable reference work as it identifies the limitations of existing law and points out situations where authorities might consider creating new principles to deal with these emerging interests.

In the area of geographic terms, the issue of concern about creating new law is particularly apparent. Therefore, the USPTO will focus specifically on the discussion of geographical indications and indications of source, and less specifically, geographic terms.

I. Geographical Indications, Indications of Source, and Other Geographical Terms

The Interim Report of the Second WIPO Internet Domain Name Process recommends against an exclusion mechanism for domain names containing geographical indications and indications of source. The USPTO concurs with the WIPO Report's opposition to any exclusion mechanism for geographical indications.

Additionally, the Report recommends expanding the Internet Corporation for Assigned Names and Numbers (ICANN) Uniform Dispute Resolution Policy (UDRP) to include rights in "geographical indications" or "indications of source," along with rights in trademarks or service marks, as a basis for challenging ownership of a domain name.

Based on the Report's recommendation, it is presumed that the definition for UDRP 4(a)(i) would be amended to provide that domain name holders would be subject to a proceeding under the UDRP if the "domain name is identical or confusingly similar to a trademark, service mark, geographical indication, or indication of source in which the complainant has rights."

With respect to the Report's recommendation that the UDRP be expanded to include challenges by holders of geographical indications or indications of source, the USPTO finds several outstanding questions that raise concerns regarding the usefulness and timing of such an amendment to the UDRP.

A. Geographical Indications are not Uniformly Recognized nor Protected Worldwide

The UDRP has proved useful because there exists a fairly sophisticated international understanding of trademark rights. Even if the procedures for obtaining trademark registration vary throughout the world, there is core agreement regarding the subject matter eligible for protection as a registered trademark (*e.g.*, words and phrases)

As noted in paragraph 197 of the Report, unlike for trademark rights, geographical indications are not defined nor protected similarly around the world. The Report outlines the four major international agreements that refer to geographical indications, appellations of origin, and indications of source (paragraph 195): all of the agreements contain differing definitions and scopes of protection. Thus, geographical indications are treated and protected very differently in countries all over the world.

Given the different systems of protection for geographical indications and the evolving world thought on what constitutes a geographical indication, UDRP cases involving geographical indications will not be obvious cybersquatting cases. While the concept of "bad faith" may be a constant, proof of "bad faith" runs the continuum from obvious and easy to subtle and complex. The USPTO believes that evidence of "bad faith" will fall into the "subtle and complex" end of the continuum. This belief is supported by the fact that some terms (*e.g.* "CHEDDAR") considered protected terms in one country are equally considered obvious generic (unprotectable) terms in other countries. Quite clearly, the UDRP was not designed for long, drawn-out, fact-based determinations of intent: such determinations are for courts.

Without a clear international understanding of what is a geographical indication or an indication of source, the USPTO is convinced that UDRP panels will, in fact, be given the responsibility of creating new, internationally binding law. Against this possibility the WIPO Report itself cautions, stating that, "new law should only be effected through a representative and legitimate authority." (paragraph 18) In the most troublesome instance, one person (a single panelist) will be given the authority to define a geographical indication and to determine whether a complainant has "legitimate rights" in that geographical indication. Of course, by choosing the definition, the panelist chooses the applicable law. Since those laws and therefore, those property rights, differ so dramatically from country to country, the definition used would determine the outcome of the dispute. The USPTO notes that the panel would thus be in a position of giving extraterritorial effect to the laws of one country, at the expense of the laws of a

competing sovereign. The USPTO questions whether world thought on issues of jurisdiction, choice of law, and extraterritorial effect has yet evolved to the point where sovereigns will be comfortable with accepting the opinion of a one or three person panel in rendering decisions with universal effect.

Since, as a matter of fact, current systems for the protection of geographical indications – to the degree they even yet exist – are decidedly different, the expansion of the UDRP to geographical indications and indications of source would appear to favor countries with formal registration systems to the detriment of those countries with common law (use-based) systems. Because defining a geographical indication and therefore, determining legitimate rights to a geographic term is difficult, it will be much easier for panels to award domain names transfers to those holding geographical indication registrations than for those geographical indications which are not registered. Those common law holders of geographical indications are bound to lose more often because their rights are not so easily determined. Rights holders in those countries where geographical indications may be protected under a trademark regime would also be favored since they could proffer their registration certificate as evidence of a legitimate right to the geographical indication.

As indicated in the submission of the International Trademark Association, the complex nature of the issue and the unfamiliarity of many of the panelists with this type of intellectual property, the proceedings will undoubtedly take longer to resolve, contravening one of the integral features of the UDRP: resolving disputes quickly.

B. Standing Options for UDRP Proceedings for Geographical Indications and Indications of Source

The WIPO Report solicits comments on options as to who should have standing to file a complaint under the UDRP based on the alleged abusive registration of a geographical indication or indication of source. (paragraphs 233 and 234). Once again, the USPTO commends WIPO for succinctly identifying the relevant issues and providing specific proposals for comment from the public. The USPTO has a few concerns about each option proposed and would like to share those thoughts with the Internet community for consideration.

Option 1) The proposal to determine a complainant's standing by the laws of the country where the geographic term originated (the country of origin) is problematic because geographic terms can be common to more than one country. Furthermore, as indicated in the Report, it would be unfair to determine standing by reference to the law of the country of the complainant when there may be no relation to that country in the website. (paragraph 233) Finally, there is no country of origin for a geographic term that has become generic. Thus, the domain name holder of a generic term would be subjected to the law of a country that has no rights in the term in the domain name holder's country.

Option 2) The proposal to allow only the government of the country of origin to assert standing for the UDRP is also problematic because GI holders in countries where geographical indications

are considered “private rights” and therefore not enforced by the government, would be severely prejudiced.¹

Option 3) The proposal to allow the complainant to assert standing and to permit the panel to determine the legitimacy of the claim raises concerns as well. To determine whether a complainant has standing is to determine whether the complainant has rights in a geographical indication. To determine whether a complainant has rights in a geographical indication, the panel would have to define the geographical indication. The arbitration panel would be essentially creating an international body of law governing geographical indications. It is questioned whether countries will be comfortable with accepting the opinion of one person (the panelist) in decisions with universal effect.

C. Remedies for Bad Faith Registrations of Geographical Indications and Indications of Source

As noted in paragraph 231 of the Report, transfer or cancellation of a domain name are the two potential outcomes in a UDRP proceeding. However, because there is often more than one legitimate user of a geographical indication, it is unclear to whom a domain name should be transferred if bad faith is determined. (paragraph 232) The USPTO would like to point out that to have the UDRP panel decide whether the domain name containing a geographical indication or indication of source should be transferred to the complainant in a particular case gives the panel the ability to create rights for the complainant. In fact, even if the complainant could establish standing to bring a case, the complainant might not be the only entity with rights in the geographical indication contained in the domain name.

Thus the USPTO identifies at least two significant drawbacks associated with the current remedies available in UDRP cases: 1) the panel would be creating international law by granting international rights in a geographical indication to a complainant through the transfer of the domain name, and 2) the panel would be choosing the particular complainant to receive the right through the transfer of the domain name.

Cancellation, of course, is not a meaningful option as any other bad faith user would remain free to register the domain.

II. Geographical Designation Beyond Intellectual Property - Geographic Terms as Domain Names

The USPTO would like to underscore WIPO Report’s observations regarding the possible protection of country names in the DNS contained in paragraph 265: “any protection offered in the DNS to geographical terms as such may amount to the creation of new laws, at least from the international intellectual property perspective....any protective measures that may be adopted for

¹ It is also questioned whether this approach would be entirely consistent with the TRIPs obligations of WTO Members, as the preamble to the TRIPs Agreement clearly states that WTO Members recognize that “intellectual property rights are private rights.” Article 1(2) of the TRIPs Agreement states that, “[f]or purposes of this Agreement, the term ‘intellectual property’ refers to all categories of intellectual property that are the subject of Sections 1 through 7 of Part II” of the Agreement. “Geographical Indications” are addressed in Section 3 of Part II (Articles 22 –24) of the TRIPs Agreement.

the gTLDs and the results that they may produce run a greater risk of being invalidated, if contested at the national level.”

At present, Article 6ter of the Paris Convention does not contain protection for the names of countries. While the USPTO appreciates the analysis in paragraph 264 of the Report regarding the proposed interpretation of Article 6ter, it must be reiterated that protection for names of countries, *per se*, is not part of the text. The USPTO would like to suggest that the issue of expanding the UDRP to cover country names is premature without a full discussion of this issue by the Assembly of the Paris Union for the Protection of Industrial Property.

The USPTO does not advocate a position either way on the amendment of Article 6ter; it merely cautions, as the Report cautions, against the expansion of intellectual property rights through the ICANN process. As has been stated by others, the legitimacy of the UDRP for trademarks could easily be threatened by its expansion to areas where there are no international norms.

III. The Role of Technical Measures – WHOIS Data Search Facilities

Since the inception of the domain name system on the Internet, contact information has been available through a series of WHOIS databases. Public availability of contact details of domain name holders is vital, *inter alia*, for:

- Intellectual property owners to determine the identity of those conducting piracy operations online and the identify cybersquatters;
- Law enforcement officials who need contact data to investigate illegal activities online;
- ISP’s, hosting companies, and network operators to maintain and investigate problems concerning the technical operation of networks and network services and tracking down sources of spam;
- Consumers who need information on who they are dealing with online and who to hold accountable for problems; and
- Parents who need contact information to protect their children on the Internet.

The USPTO agrees with the WIPO recommendation in paragraph 341 that “the obligation to provide accurate, reliable and publicly accessible WHOIS data should be required of each registration authority in all gTLDs, existing and future.” Also, the USPTO agrees with the recommendation in paragraph 347 that “administrators of ccTLDs be encouraged to adopt policies for the collection, verification and public availability of WHOIS data via online databases, that are uniform, to the greatest extent possible, with the WHOIS system at a gTLD level.”

IV. Conclusion

Currently, there are many discussions on the issue of geographical indications, indications of source, and geographic names at various intellectual property and some non-intellectual property international fora. The laws covering these terms have not yet reached the level of harmonization already achieved with trademarks. This is not surprising. The Paris Convention was first drafted in 1880, following preparatory work that began in 1873. Thus, the world community has had over 100 years of substantive discussion and experience with trademark issues. The term “geographical indications” was first incorporated in the TRIPs Agreement, which is not even a decade old. The domain name system is not the appropriate place to develop, or to force development, of laws regarding geographical indications.

Certainly, it is appropriate to discuss many of these issues in the context of domain names and to suggest changes that should be considered to the protection regimes, but the UDRP it is not the place to implement any changes before consensus is achieved.

The USPTO believes that an acceptable definition of “bad faith” as it applies to domain names containing geographical indications would be difficult to achieve, thus stretching the role of the arbitrator to that of a jury – a role not intended in the creation of the UDRP. Furthermore, to allow an arbitration panel to preside over disputes involving geographic terms that are considered intellectual property in some countries but not in others opens the door to creating an international body of law that infringes on the sovereign’s prerogative without the consent of the world’s governments.

The USPTO is similarly concerned that the expansion of the UDRP to include geographical indications, indications of source, and other geographical terms will adversely affect the legitimacy of the UDRP for trademarks. Geographical indications are not uniformly defined or protected around the world and do not fit neatly into the UDRP as it has evolved for trademarks. However, the argument for not expanding the UDRP to avoid threatening its stability does not fully answer the question as to what should be done about these rights that exist on the “fringe” of intellectual property.

The USPTO appreciates the dialogue that WIPO has initiated and commends the labor and thought that are manifest in the Interim Report. We are pleased to be able to add to the debate on these issues and hope that we can help further to define the issues that face the Internet community and work towards the future solutions for the domain name system.

[process2-comments] WIPO-2 RFC-3

To: process.mail@wipo.int

From: "European Commission"

Subject: Commission's answer to WIPO RFC2

Date: June 25, 2001

[eu.doc](#)

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EUROPEAN COMMISSION

Internal Market DG

FREE MOVEMENT OF INFORMATION, INTELLECTUAL PROPERTY, THE MEDIA, DATA
PROTECTION

Industrial property

Second WIPO Internet Domain Name Process

CONTRIBUTION FROM THE EUROPEAN COMMISSION TO THE INTERIM REPORT

GENERAL REMARKS

- (1) From 31 January - 1 February 2000, an informal working group of representatives from a number of Members of the WIPO met in Sidney to discuss issues relating to cybersquatting. The services of the Commission took part in this meeting along with others. As a result of this meeting, WIPO received on 28 June 2000 two letters requesting the initiation of a Second WIPO Process in order to address certain intellectual property issues relating to Internet domain names which remained unsolved after the first WIPO Internet Domain Name Process. The services of the Commission supported this initiative by a letter addressed to Mr. Idris by Mr. Mogg (General Director for Internal Market) and Mr. Verrue (General Director for Information Society) on May 24, 2000.
- (2) The Services of the Commission fully appreciate the efforts made by WIPO in ensuring the protection of industrial property rights and its fight against the abusive registration of domain names. It is in this light that the Services of the Commission would like to express their gratitude to WIPO for agreeing to the request made by the Internet Community and for opening this second Internet Domain Name Process.
- (3) It should be noted that the European Union is currently working on legislation dealing with the rights and uses of names for that part of the Domain Names System to be operated by the future dot.EU registry¹. We would therefore like to note that our comments to the WIPO's interim report may be subject of further work as part of the legislative procedures related to the adoption of EU regulatory on the future dot.EU TLD.

¹ Commission Communication COM(2000)827 of 12 December 2000

WIPO INTERIM REPORT - COMMENTS

INTERNATIONAL NONPROPRIETARY NAMES (INNs) FOR PHARMACEUTICAL SUBSTANCES:

- (4) The Services of the Commission is of the view that, as stated in our comments to the RFC - 2², INNs should be protected against bad faith, abusive, misleading or unfair registration and use as domain names, in the interests of public health and safety.
- (5) The protection of INNs within the domain name space should allow the registration as a domain name of an INN together with the name of the manufacturer of the INN. However, the standard rules on abusive registration of trade marks as domain names, including if necessary the UDRP, should apply to those parts of the domain name not related to the INNs, i.e. the name of the manufacturer. The existing UDRP for trade marks should apply if deemed necessary to cover these cases.
- (6) The registration of an INN together with any other word, such as “info” or “usergroup” as a domain name should only be possible together with a standard and unequivocal disclaimer, to be agreed by the WHO, informing the public that the information contained in that site is not necessarily exact and that it may not count with the approval of the WHO itself.
- (7) As regards the registration of INNs in the ccTLDs, it is recommended that ccTLD administrators consider, in consultation with their national health authorities, the adoption of protection for INNs within the ccTLDs, in the official language/s of the ccTLD administrator.
- (8) The Services of the Commission consider the exclusion or blocking mechanism proposed by WIPO³ as the best solution to ensure protection of INNs within the domain name space.

PERSONAL NAMES:

- (9) The Services of the Commission are of the view that the right to protect one's own identity should be facilitated as much as possible within the DNS.
- (10) As regards current conflicts involving personal names and trade marks, they may find solution under the existing UDRP. However, it does not seem feasible, at this stage, to implement practical solutions under the existing UDRP to deal with conflicts involving known public figures or other persons who are not so well known and who, not having any trade mark right over their names, would not be entitled to protection under the current UDRP.

² Paragraph 17 of the contribution from the Services of the Commission to the RFC- 2 (16 January 2001)
<http://wipo2.wipo.int/process2/rfc/rfc2-comments/2000/msg00040.html>

³ WIPO Interim Report - Paragraph 83

- (11) In this light, we would like to mention the need to clearly differentiate between "name" and "identity". The use of a name cannot be regarded as unfair as far as that use does not imply confusion as to the identity on "who" is making use of that name. In those cases where confusion as to the identity is proved, the person whose "identity" is being abused should be able to find a relief. However, disputes over these matters usually involve complicated legal issues which might not be able to be resolved under the present UDRP.

NAMES OF INTERNATIONAL INTERGOVERNMENTAL ORGANISATIONS

- (12) The Services of the Commission agree in the need to enhance the public visibility and profile of the .int top-level domain, reserved for treaty organisations.
- (13) Moreover, it is suggested that the names of IGOs protected under Article 6ter of the Paris Convention should be excluded from registration in all existing open gTLDs, as well as in all new gTLDs. This should apply to all past and future domain name registrations in all open gTLDs. In this regard, we would like to add that:
- Protection should also extend as much as possible to acronyms, since on the Internet it is frequent to use the acronyms (ie, UNESCO, OAMI, OHIM) rather than the whole actual name of the IGO.
 - Names and acronyms of IGOs should be excluded from registration, regardless of the level at which they are used: Oami.UK.com should be as “illegal” as is Oami.com.
- (14) The Services of the Commission estimate that an administrative adjudication procedure for complaints by IGOs in respect of the misleading registration and use of their acronyms as domain names or of domain names that are misleadingly similar to their names, appear to be a balanced solution to be applied to all existing and new gTLDs and, if possible, to ccTLDs.
- (15) Furthermore, we would like to add that:
- In obvious cases, registries should agree to cancel upon complaint. The previous registrant should then have the possibility to use the administrative procedure in order to try to recover its domain name.
 - Prohibition upon complaint should extend to domain name elements similar to protected names, abbreviations and acronyms.
 - In order to find legitimate reasons to maintain a previous registration of a name conflicting with the name of an IGO, inspiration could be drawn from Paragraph (1)(b) of Article 6ter of the Paris Convention (ie, when the name is not of such a nature as to mislead the public as to the existence of a connection between the user and the organisation).

GEOGRAPHICAL INDICATIONS, INDICATIONS OF SOURCE OR GEOGRAPHICAL TERMS

- (16) The Services of the Commission agree with the need to safeguard the interest of the legitimate users of geographical indications and indications of source in the DNS, as well as the interests of consumers. The adoption of measures aimed at protecting these indications in the open gTLDs is considered more than appropriate at this stage⁴. In this light, we would like to recall that geographical indications (or indications of source or appellations of origin, as they appear in Article 1 of the Paris Convention) are industrial property rights covered by the TRIPs agreement and, as such, they should be protected according to section 3 of that agreement by, at least, all the Members of the WTO.
- (17) Notwithstanding the difficulties associated with the introduction of an exclusion mechanism for geographical indications, the Services of the Commission consider that further work on this is necessary. In particular, it is recommended to study the development of solutions linked to the establishment of a multilateral system of notification and registration of geographical indications as proposed in Article 23(4) TRIPs.
- (18) Concerning the possible modification of the UDRP, as proposed by WIPO, the Services of the Commission fully endorse the recommendation of broadening the scope of the current UDRP to cover abusive registrations of geographical indications and indications of source as domain names in all open gTLDs⁵. We should recall that domain names are not industrial property rights, therefore any arbitration over a geographical name within the UDRP does not create any new right, at national or international level, but merely put remedy to the abusive and bad faith use of that name. The same rationale applies to the UDRP currently in use for trade marks
- (19) As stated in our previous submission⁶, the Services of the Commission agree on the need to consider the definition of cybersquatting as established by paragraph 4 of the ICANN UDRP Policy as a general principle.
- (20) The person or entities having standing under the laws of their country of origin to bring an enforcement action should also have standing before the UDRP. This should not prevent the Government of the country of origin to joint that procedure or, when the person or entities having standing under the national laws do not take any action, to file a complaint under the UDRP based on the alleged abusive registration of a domain name corresponding to a geographical indication or an indication of source.
- (21) With regard to the use of the ISO 3166 code elements and the ISO 3166 alpha-2 code elements, the services of the Commission share the views expressed by WIPO in paragraphs 274 and 275 of the Interim Report.

⁴ WIPO Interim Report - Paragraph 214

⁵ WIPO Interim Report - Paragraph 227

⁶ Paragraph 6 of the contribution from the Services of the Commission to the RFC- 2 (16 January 2001)
<http://wipo2.wipo.int/process2/rfc/rfc2-comments/2000/msg00040.html>

- (22) Finally, the services of the Commission consider that the cause of action proposed in paragraph 283 of the Interim report, would constitute a suitable basis for the introduction of protection in the new gTLDs for the names of countries and of administratively recognised regions and municipalities, as an adjunct to the UDRP.

TRADE NAMES

- (23) The Services of the Commission agree with WIPO on the difficulty in extending the current UDRP to cover trade name issues. However trade names are industrial property rights and, therefore, a trade name holder should have the right to defend itself against the bad faith, abusive, misleading or unfair use of his name as a domain name when such use results in an infringement of his/her trade name right.
- (24) In this context, it would be desirable to revise the UDRP along the lines suggested by WIPO in paragraph 327 of the interim report.
- (25) The Services of the Commission also agree on the need to encourage administrators of ccTLDs that apply the UDRP to adopt any revision of the UDRP to protect trade names, within their respective ccTLDs.

PRIVACY AND DATA PROTECTION

- (26) The Services of the Commission welcome that the WIPO report clearly points to the privacy and data protection issues raised by the online search facilities about registrants' domain name registration details, commonly called Whois. However, with a view to recommending a balanced approach, WIPO should start from the principle that individuals enjoy the right to privacy and personal data as a fundamental right, at least in the EU. It follows that consumer protection and law enforcement interests are not interests of "higher priority" as mentioned in the WIPO report (point 351) so to waive the right to privacy and data protection. All interests at stake have to be described clearly and weighted respectively.

As already stated in the Commission Communication on the Organisation of the Internet Domain Name System, it has to be evaluated for each personal data whether it should be accessible to the public, only to specific interest groups or not published at all. The answer depends on the purpose which is in the first place the managing of the domain name system and trade mark protection. For each new purposes, it has to be evaluated if this purpose should be pursued, if so, with which data and which of the data should be publicly accessible. For each purpose, secondary uses must be prohibited. At the technical level, this has to be ensured by means of filters (incorporated into the interfaces for accessing the databases) and a clear search criterion. Given these considerations, the search criterion should remain the exact domain name without additional search criteria.

A comprehensive Whois search facility, understood in the sense that searches are possible on the basis of several criteria and through the data bases at the various levels (not only gTLD), raises particular privacy implications. It would turn registrars' databases and online search into tools for policing the Internet for

everybody, be it a private person, company or public body. From the data protection point of view, the purpose limitation principle would not be respected anymore and the individual would lose control about the use of his/her personal data. In addition, such search facility would raise concerns from a freedom of speech angle.

- (27) Another important point that still causes complaints to the European Parliament and to the European Commission is the publication of personal data of private persons who have registered domain names. It may not be necessary to give public access to all their personal information such as physical address, private phone and fax numbers, but instead use the details of the service provider.

The Services of the European Commission draw WIPO's attention also to the relevant recommendations of the International Working Group on Data Protection in Telecommunications, such as its Common position adopted in May 2000 (see <http://datenschutz-berlin.de>).

[process2-comments] WIPO-2 RFC-3

To: process.mail@wipo.int

From: "United Nations, Office of Legal Affairs"

Subject: Commission's answer to WIPO RFC2

Date: June 25, 2001

[un.doc](#)

Back to [Browse Comments](#) for WIPO-2 RFC-3

25 June 2001

Dear Dr. Gurry,

**RE: *Comments on the Interim Report of the Second WIPO
Internet Domain Name Process***

This is in response to your letter of 26 April 2001, by which you transmitted a copy of the Interim Report of the Second WIPO Internet Domain Name Process (“Interim Report”). You indicated that the Interim Report is the subject of a public Request for Comments, as a result of which WIPO desires to build consensus on recommendations that are to be published in July in a Final Report concerning the Second WIPO Internet Domain Name Process.

The United Nations appreciates the significant contributions already made by WIPO concerning the Internet domain name system, particularly the recommendations made in the First WIPO Internet Domain Name Process. We understand that many of WIPO’s recommendations resulting from that first process have been adopted and are being implemented by the Internet Corporation for Assigned Names and Numbers (“ICANN”), which, we note, is a California not-for-profit corporation under contract with the United States Government to administer the Internet domain name system, rather than an intergovernmental organization.

In reviewing the Interim Report, we noted that many of recommendations proposed by WIPO concern the protection of commercial or other private interests in the

Via Telefacsimile (41) 22 733-5428

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Dr. Francis Gurry

15 June 2001

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Internet domain name system, including protection of nonproprietary names for pharmaceutical substances, as well as protection of trade names, personal names, and geographic indications. We have no doubt that many of the recommendations of the Interim Report concerning such matters would be of interest to Member States and other actors in the relevant sectors, such as pharmaceutical companies. We note that the Members States or the relevant actors have the ability to make their concerns about the proposals in the Interim Report known through ICANN or otherwise.

The focus of our comments concerns Chapter 3 of the Interim Report, which deals with the question of the names of international intergovernmental organizations and their protection in the Internet domain name system. As you will recall, in addition to the discussion at the last meeting of the Legal Advisers of the United Nations System in March, our offices have been consulting for some time on the problems faced by the United Nations with unauthorized Internet domain name registrations that incorporate the name, or an abbreviation thereof, of the Organization or one of its subsidiary bodies. During these consultations, various methods to resolve such problems under the Internet domain name system were discussed.

Our comments on Chapter 3 of the Interim Report are set out in the enclosed paper. In summary, these comments endorse WIPO's recommendations that the names and acronyms of international intergovernmental organizations should be protected in the Internet domain name system. We strongly agree that such protection is required under applicable international agreements and that any protection must be more than merely reserving the generic top-level domain name, ".int," for such organizations. Moreover, we strongly concur with WIPO's observations that existing dispute resolution mechanisms under the Internet domain name system are inappropriate for intergovernmental organizations. We further consider that unauthorized registrants should be prohibited from registering the names of such intergovernmental organizations as Internet domain names under any top-level domain. In addition, we would appreciate WIPO's views as to whether it is practicable to develop a process to prevent the unauthorized registration of acronyms of intergovernmental organizations that would impose on potential registrants of domain names that are similar to such acronyms the burden of showing the reasonableness of their proposed domain name registration. Finally, we would appreciate WIPO's views as to possible avenues for dealing with existing registrations that infringe the names or acronyms of intergovernmental organizations, such as a process for canceling such registrations.

Dr. Francis Gurry

15 June 2001

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I would like to extend my appreciation to you for collaborating with your colleagues in the UN system regarding the recommendations to ICANN arising out of the Second WIPO Internet Domain Name Process. I trust that the enclosed comments will prove useful to WIPO in finalizing the Interim Report. It is my hope that WIPO's recommendations, taking into account the comments of the United Nations and other intergovernmental organizations, will result in significant added protections for the names of such international intergovernmental organizations in the Internet domain name system. We would be grateful if WIPO could continue to keep us apprised about developments in this regard.

Yours sincerely,

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

**Comments by the United Nations Office of Legal Affairs
on the Interim Report of the
Second WIPO Internet Domain Name Process.
Chapter 3: Names of IGO's and their Protection in the DNS**

The Problem

The United Nations and its subsidiary organs are being confronted with infringing or abusive Internet domain name registrations involving the name of the Organization, its subsidiary organs, or an abbreviation thereof (*e.g.*, www.unitednations.com, www.unicef.com, etc.). In certain cases in which such an infringing or abusive domain name registration was actually being used to operate a site on the World Wide Web, we have requested the registrant to de-activate the site and to relinquish the registration. Thus far, the concerned registrants have cooperated with the Organization. However, in other cases in which a registrant of such an infringing or abusive domain name is not actively using the domain name, but rather is merely holding the infringing or abusive domain name registration, we have not been as successful. As noted in the Interim Report (*see* para. 105 and notes 43 and 60), the United Nations is not the only intergovernmental organization plagued by such infringing or abusive registrations.

In dealing with this problem, the Organization has had to monitor instances of infringing domain name registrations and confront the offending registrants one at a time. Such efforts have involved the commitment of substantial time and resources by this Office and other parts of the Organization. Moreover, the Organization has been reluctant to resolve these cases through the established procedures for disputing infringing domain name registrations since these procedures require the Organization to waive the privileges and immunities to be accorded the Organization.

Those procedures are provided in the Uniform Domain Name Dispute Resolution Policy (“UDRP”), which is administered by the Internet Corporation for Assigned Names and Numbers (“ICANN”), a California not-for-profit corporation, and which became effective on 1 December 1999. 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. 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, at least one U.S. court has concluded that courts are not bound by the results of

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an ICANN arbitration proceeding (*see Weber-Stephen Products Co. v. Armitage Hardware and Building Supply, Inc.*, 54 U.S.P.Q.2d (BNA) 1766 (N.D. Ill. 2000)). Thus, despite the fact that WIPO is an approved dispute resolution provider, any decision by WIPO could be appealed to a competent national court by either party to the arbitration.

Thus, while the United Nations continues to confront the problem of infringing domain name registrations, it is not clear that the Organization has an effective method to prevent unauthorized domain name registrations incorporating the name or the acronyms of the United Nations and its subsidiary organs since the Organization, inappropriately in our view, would be required to waive the privileges and immunities it is to be accorded. For this reason, we strongly endorse the proposals for dealing with the problem in the Interim Report.

WIPO's Proposals

Legal Regime Affording Protection to Names of IGO's

As an initial matter, we strongly concur with the aspects of the Interim Report (*see paras. 88-97*) restating the law conferring protection to the emblems and names, including the abbreviations thereof, of intergovernmental organizations. We note, in particular, the reference to Article 6*ter* 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 to trademarks of intergovernmental organizations under the Paris Convention to the service marks of such organizations), 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 and the TLT). We note from the Interim Report (*see paras. 93 and 94*) that in 1992, the Paris Union Assembly adopted a set of Guidelines for the interpretation of Article 6*ter* of the Paris Convention, which make clear that the protection afforded to the emblems and names of intergovernmental organizations under Article 6*ter* of the Paris Convention should likewise extend to any program or institution of such intergovernmental organization (such as, UNICEF or UNDP) as well as to any treaty-based organization, provided it is a permanent entity having specified aims and its own rights and obligations.

In the case of subsidiary bodies of the United Nations such as UNICEF or UNDP the question of permanence is not generally an issue. In the view of the United Nations, for the purpose of protections to be afforded under the Internet domain name system, the United Nations would urge that consideration be given to the protection of

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the names and acronyms of subsidiary bodies, such as peacekeeping missions, which, while an integral and important part of the Organization, are not necessarily permanent entities.

We note WIPO's observations in the Interim Report (*see* para. 97) that certain aspects concerning the protection of the names, emblems and acronyms of intergovernmental organizations, and their permanent subsidiary bodies, provided under the Paris Convention, the TLT, and TRIPS are relevant to the protections to be accorded to such intergovernmental organizations in the Internet domain name system.

We agree with the first aspect mentioned in the Interim Report (*see* para. 97(i)) that the protections afforded by such Conventions require that the names, abbreviations and emblems of intergovernmental organizations must be prohibited from being registered or used in the Internet domain name system by unauthorized entities or persons. Thus, we strongly agree that unauthorized uses of names or abbreviations of intergovernmental organization should be excluded entirely from the Internet domain name system, at all generic top level domains, such as “.com,” “.org,” “.gov,” etc. Therefore, for example, no person or entity should be able to register or use the domain name “www.unitednations.com” without authorization by the Organization.

We take note of the second aspect mentioned in the Interim Report (*see* para. 97(ii)) that abbreviations of intergovernmental organizations likewise enjoy protection under such Conventions and that some form of protection for such acronyms should likewise be extended to the Internet domain name system. While we understand the view that a distinction can be drawn between the exact names of intergovernmental organizations and the abbreviations thereof for purposes of avoiding infringement within the Internet domain name system, we are concerned that such a distinction could lead to abuse. Thus, the Organization is already faced with situations where registrants usurp the acronyms of the Organization or its subsidiary bodies, such as “www.un.net,” and “www.unicef.com.” Many of the Organization's subsidiary bodies, such as UNICEF and UNDP, and its peacekeeping missions, such as UNMIK, are best known by their acronyms. In the view of the Organization, any protection afforded to the names of intergovernmental organizations under the Internet domain name system should equally apply to established and perhaps well-known acronyms of intergovernmental organizations and their subsidiary bodies.

In general, we note that the comments concerning the extension of established legal regimes to the protection of the names of intergovernmental organizations under the Internet domain name system mainly revolve about the question of whether an absolute exclusion should exist to bar potential unauthorized registrations of the names or abbreviations of such organizations or whether some form of procedure, such as the

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UDRP, should be relied upon to resolve disputes over such registrations. In the case of abbreviations of the names of such organizations, some commentators suggest that persons or entities could make legitimate uses of such acronyms so that they should not be automatically excluded from registering such acronyms in the Internet domain name system for such uses (*see* para. 109). Such commentators suggest that a procedure, such as the UDRP, is sufficient to resolve conflicts in such cases. (*See* para. 97(iv).)

As previously noted, the United Nations considers that a dispute resolution procedure, such as the UDRP, which would subject the Organization to jurisdiction of national courts and which, therefore, would compromise the privileges and immunities enjoyed by the Organization, is not an appropriate means for resolving these questions. We believe that a regime of exclusion from Internet domain name registration should apply to both the names and acronyms of intergovernmental organizations. In order to accommodate the possibility that a registrant in a particularly compelling case has a legitimate use for the acronym, we would propose that such a potential registrant seek an exception to such exclusion. In such a case, the relevant intergovernmental organization would be consulted before registration occurs, thereby placing the procedural burden for such an exception on the potential registrant and not on the intergovernmental organization.

In this connection, we note that the Interim Report offers a potential compromise regime for dealing with acronyms of intergovernmental organizations (*see* paras. 117 – 120). Thus, the Interim Report proposes that registrants could be authorized to register acronyms under existing or new top-level domains, even if they corresponded to the acronyms of intergovernmental organizations, provided the registrant had a legitimate basis for doing so. The proposal would make an exception to such general approach in the case of particularly distinctive or lengthy acronyms of intergovernmental organization, citing the example of UNHCR, a subsidiary body of the United Nations (*see* para. 117). The Interim Report further proposes that, in a case in which an intergovernmental organization became aware of a potentially misleading or abusive registration involving its acronym, it could submit the matter to a new administrative panel, not associated with the UDRP, which would decide whether to allow the registration, cancel it or transfer it to the intergovernmental organization concerned (*see* paras. 118 – 119). The Interim Report notes that such a new administrative panel would be preferable, given the privileges and immunities enjoyed by intergovernmental organizations (*see* para. 119).

We consider that such a compromise generally takes into consideration the concerns of the United Nations. However, we would reserve final comments on the merits of such a proposed regime for dealing with the registrations of acronyms of intergovernmental organizations until the details of the proposed regime were made

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clearer. In particular, we strongly agree that some exclusion must be given for distinctive and well-known acronyms, such as UNICEF, UNDP and UNMIK. In addition, we would propose that any such proposed administrative panel that would be constituted to resolve disputes regarding acronyms of intergovernmental organizations should be organized under the auspices of a relevant international intergovernmental organization, such as WIPO itself, and not under ICANN or a similar body. Finally, as previously discussed, we would further take the position that such an administrative body should exist as a corollary procedural measure to a general rule excluding domain name registrations for the acronyms of intergovernmental organizations, thus shifting the burden to potential registrants of such acronyms to make the case why such a registration should be granted in the first place.

Adequacy of the Protection Afforded by the “.int” Top Level Domain Name

The Interim Report reviews the history of the establishment of the “.int” top level domain name for, *inter alia*, organizations established by international treaties (*see* paras. 98 – 103). The Interim Report further notes that various commentators suggest that the exclusivity afforded by such a reserved top-level domain name is sufficient to protect the interests of international organizations in the Internet domain name system (*see* para. 98). We agree with the position taken by WIPO that the reserved top-level domain name, “.int,” does not address the problem of bad-faith or abusive registrations of the names of intergovernmental organizations under other top-level domain names, such as “.com” or “.net.” In particular, we endorse the comment set forth in paragraph 115 of the Interim Report that, “mere reliance upon the .int top-level domain for the protection of the names and acronyms of IGOs is insufficient and it is recommended that additional protection for those names and acronyms be established.”

Protection through Exclusions of the Names or Acronyms of IGOs

The Interim Report sets out a recommendation that names of intergovernmental organizations protected under the Paris Convention and the TRIPS should be excluded from registration in all existing and new generic top-level domain names (*see* para. 123), and also invites further comments on the desirability of extending such exclusion to the acronyms of intergovernmental organizations (*see* para. 124). Based on our foregoing comments, the United Nations considers that protection should be given to both the names and acronyms of intergovernmental organizations. With regard to acronyms, we understand that there may be a need to come up with a regime that accommodates possible legitimate uses of acronyms that are the same as or similar to acronyms of intergovernmental organizations. Nevertheless, as discussed above, any

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procedure for such accommodation should be carefully crafted, taking into consideration the status and privileges and immunities of intergovernmental organizations.

As a final comment, we note that, other than with respect to the proposal to establish an administrative panel to resolve acronym disputes (paras. 118-119), the Interim Report does not generally deal with the question of resolving existing registrations of Internet domain names incorporating the names or acronyms of intergovernmental organizations. Given the emphasis in the Interim Report on excluding such registrations generally, we would propose that such exclusion should extend to existing registrations, whereby existing registrations that infringe the name or acronym of an intergovernmental organization would be cancelled and, if appropriate, transferred to the intergovernmental organization concerned. As described above, it is existing registrations that have created significant problems for the Organization.

Dated: 12 November 2003

[process2-comments] WIPO-2 RFC-3

To: process.mail@wipo.int

From: "Japan Network Information Center (JPNIC)" <tsubo@nic.ad.jp>

Subject: RFC-3

Date: Fri, 8 Jun 2001 19:09:58 +0200

Name: Toshi Tsubo

Organization: JPNIC

Position: Trustee of the Board

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Comments on the WIPO RFC-3

o International Nonproprietary Names for Pharmaceutical Substances (INNs)

It's said that the reason why INNs should be protected in the DNS is because they are a set of identifiers that have been developed to be free from appropriation through private rights and available for public use in the real world. And it is recommended in the RFC-3 that the INNs be excluded from the possibility of registration as domain names in the open gTLDs and that any existing registrations of INNs as domain names be cancelled.

My comments on this are as follows.

- We should note that INNs are not protected by any law and that they are allowed to use in the form of [INN][name of manufacture]. I think there should be more strong reasons if INNs are decided to be excluded from the possibility of registration as domain names. Any possible problems should be presented more clearly that are thought to arise when we would not exclude INNs.
- I don't think it's realistic to cancel existing registrations because it may bring another problems between registrars and registrants. And we should know the fact that between 120 and 150 new INNs are added every year. If these additions should lead to cancellation of many existing registrations of domain names, it would not be acceptable by public.
- However, it could happen that INNs are registered as domain names and used in bad faith. For this reason the UDRP might be modified to extend the protection to cover INNs. But we should note that INNs are different from trademarks in that they (INNs) do not belong to a specific individual or company. Who is the right complainant would be a question and my answer is WHO, which should be noticed by any interested person who finds abuse of domain names.
- If the protection of INNs is limited to the form of UDRP, the protection may be extended to other languages than English such as Latin, French, Russian and Spanish as well as the names that are misleadingly similar. And this might be applied to all open gTLDs that adopt the UDRP.

o Names of International Intergovernmental Organizations (IGOs)

It is recommended in the RFC-3 that the names of IGOs be protected by the form of exclusion but not the modification of the UDRP.

My comments on this are as follows.

- I think the basic approach should be the modification of the UDRP to extend the protection to cover the names and acronyms of the IGOs, which are protected under the Paris Convention and the TRIPS Agreement.
- The names of IGOs may be protected in the form of exclusion. But the acronyms should not be protected in the form of exclusion but by the modified UDRP. If there is a registration of the name or acronym of an IGO as domain name that assumed to be a registration and use in bad faith, it should be resolved by the UDRP.

o Personal Names

As for the protection of Personal Names, there are three options recommended in the RFC-3.

- (1) No changes to the UDRP.
- (2) Amending the scope of the UDRP to encompass claims brought on the basis of a personality right.
- (3) Modification of the scope of the UDRP only in the application to the new gTLD, .name.

My comments on this are as follows.

- The current UDRP is considered sufficient as for the protection of the names that qualify as trademarks or service marks. However, I think the scope should be modified so as to cover other names than those that qualify as trademarks or service marks because those names have possibilities to be abused and such abuses should be resolved by the UDRP.
- Evidence of registration and use in bad faith that should be applied to the cases of Personal Names as domain names should be more discussed but I think basically the circumstances shown in the Paragraph 4(b) in the UDRP can be applied. Notability may be one of the points to be discussed. I think notability could be involved in the abuse of Personal Name but that only the name is notable should not constitute abuse of Personal Name.

o Geographical Indications, Indications of Source and Geographical Terms

It is recommended in the RFC-3 that geographical indications and indications of source be protected by the UDRP. As for geographical terms, it is recommended that ISO3166 codes be protected by the UDRP and be excluded in the new gTLDs. It is also recommended that the names of countries and administratively recognized regions and

municipalities within countries be protected.

My comments on this are as follows.

- Concerning the indications of source, they seem to be near to trademarks in terms of character and I think they might be protected by modifying the scope of the UDRP. In this particular case, a complainant could be any interested person and the eligibility of complainant might be judged by the panel. As the indications of source do not belong to any specific individual or organization, new type of remedy should be added, that is, "cancellation and exclusion".
- Concerning the geographical indications, it can be assumed that a certain place can be disgraced by the abuse of the place name as a domain name. I think the geographical indications should be included in the scope of the UDRP by its modification. As for eligibility and remedy, my comment is the same as the previous item.
- It is desirable that ISO3166 codes be excluded in the new gTLDs.
- The names of countries and administratively recognized regions and municipalities within countries should be protected by modifying the scope of the UDRP.

o Trade Names

I have no specific comments.

Toshi Tsubo
Trustee of the Board
Japan Network Information Center

[process2-comments] WIPO-2 RFC-3

To: process.mail@wipo.int
From: "Emily Taylor" <emily@nominet.org.uk>
Subject: RFC-3
Date: Thu, 14 Jun 2001 12:03:16 +0200

Name: Emily Taylor
Organization: Nominet UK
Position: Solicitor

Thank you for the opportunity to respond to WIPO's interim report.

Nominet UK's response is attached as a Word document.

[nominet-uk.doc](#)

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Nominet UK's response to the WIPO draft Second Report, RFC-3

1. Introduction to Nominet

Nominet UK ("Nominet") is the Registry for .uk Internet Domain Names. Nominet is a not-for-profit company, limited by guarantee. Nominet commenced operation in August 1996 and now has over 100 staff. The .uk top level domain is the second largest country code top level domain ("ccTLD") in the world, with just under 3,000,000 registrations. The .uk ccTLD is divided into a number of second level domains ("SLDs"), including .co.uk, .org.uk, .net.uk, .ltd.uk and .plc.uk. The .co.uk and .org.uk SLDs are operated on a first come, first served basis.

Since 1997, Nominet has operated an alternative domain name dispute resolution service for .uk, and to date has handled over 1,400 cases. Nominet currently makes no charge to disputants in providing its service. Through Nominet's dispute resolution service, the parties are encouraged to resolve their dispute through mediation. Nominet has found mediation to be successful in around one-third of disputes. Where mediation is not successful, the matter is referred for a decision under Nominet's Rules. Nominet is planning to launch a revised dispute resolution service in September 2001.

2. General Points

Nominet welcomes the opportunity to comment on Interim Report of the Second WIPO Internet Domain Name Process ("the Report"). The Report is a thorough examination of the issues which WIPO was requested to address, and provides a useful resource to those interested or involved in promoting the resolution of domain name disputes.

However, Nominet strongly opposes the recommendations made in relation to International Non-proprietary Names for Pharmaceutical Substances and the names of International Intergovernmental Organisations. Nominet comments in relation to these issues are set out below.

As a general point, Nominet recommends that the rights required to bring a claim under ICANN's Uniform Domain Name Dispute Resolution Policy (UDRP) be relaxed. It is understandable that the WIPO first Report focussed on the protection of trade mark rights: that is what WIPO was originally requested to do by the trade mark community. However, WIPO now has an opportunity with its Second Report to expand the availability of the UDRP to encompass those who are unable to assert trade mark rights.

Whilst Nominet accepts WIPO's concern that it should not create new law, it is submitted that in many ways the UDRP has already done just that. The concept of bad faith domain name registrations is not directly reflected in UK trade mark law, neither is the non-exhaustive list of

factors indicating bad faith. Moreover, the creation of an online, paper-based administrative procedure is also new and has revolutionised the resolution of domain name disputes since its inception in December 1999.

Throughout the draft Second Report, it is recognised that entities other than trade mark holders are targets of abusive domain name registrations (for example famous individuals, International Intergovernmental Organisations and holders of trade names). In Nominet's view the key objective of any domain name dispute resolution service ought to be to combat abusive practices, rather than dwell too closely on the type of rights asserted by complainants, so long as the complainant has a bona fide reason for bringing a complaint.

As a provider of an alternative dispute resolution service for .uk domain names since 1997, Nominet has never restricted the rights asserted by complainant (and does not intend to do so under its revised service), and as a result has dealt with cases involving trade names and personal names as well as trade marks.

Nominet's detailed comments on the proposals are set out below.

International Non-proprietary Names for Pharmaceutical Substances (INNs).

Nominet notes that whilst the draft report recognises that "evidence of actual damage is lacking" with regard to the registration of INNs as internet domain names, WIPO nevertheless recommends that INNs be excluded from registration by domain name Registries. The exclusion is intended only to cover identical names, and not names similar to INNs. The draft Report suggests that such an exclusion could be set in place relatively easily by linking automated registration systems with the World Health Organisation's database.

As WIPO is aware the generic Top Level Domains .com, .net and .org are operated on a first-come, first-served basis. Nominet operates the .co.uk and .org.uk second level domains on a first-come first served basis. Nominet opposes WIPO's recommendation to exclude from registration names identical to INNs for the following reasons:

1. First come, first served is a successful system, primarily aimed at allowing the level of domain name registrations to grow at an organic rate, without unnecessarily restricting the rights or choices of registrants. Disputes account for a tiny fraction of overall registrations. Disputes in the .uk Top Level Domain account for approximately 1/2000 registrations, and it is Nominet's understanding that disputes in the generic Top Level Domains account for around 1/3000 of total registrations. The UDRP as well as Nominet's mediation driven DRS show how effectively the minority of registrations which result in a dispute can be resolved after registration. It seems perverse to propose the erosion of the first come, first served principle in the context of an issue which WIPO itself accepts is not currently presenting a problem on the internet.

2. The proposed exclusion imposes an administrative burden on registries (to put in place and to maintain the technical solution, to ensure that the list of excluded INNs is up to date and accurate, to determine how to deal with proposed INNs), which is out of proportion to the perceived problem.
3. Nominet confirms that (to the best of our knowledge) we have had no disputes regarding INNs under our Dispute Resolution Service, which has been in operation since April 1997.
4. Excluding names of INNs from registration as domain names would not resolve the problem of names confusingly similar to INNs, for example aspirins.com, which have equivalent potential to cause damage to public health.
5. Excluding names from registration is a blunt instrument. It is foreseeable that non-abusive uses of INN domain names could exist: for example genuine information sites.
6. Excluding names from registration does not deal with existing registrations of INNs. To cancel such registrations may contravene the terms of the registries' registration agreements, and expose registries to legal liability.
7. Nominet proposes that the issue of INNs be dealt with, if at all, with a broadening of the rights which form the basis of making a complaint under the UDRP, and if necessary in expressly giving standing to representative organisations (such as the World Health Organisation) to bring complaints about INNs registered as domain names.

International Intergovernmental Organisations (IGOs)

Nominet opposes the exclusion from registration of the names or acronyms of IGOs which is recommended at paragraph 123, for the following reasons:

1. It is noted that there exists a generic Top Level Domain, .int, in which only IGOs may register.
2. WIPO's assertion in paragraph 113 that the .int Top Level Domain does not appear to enjoy widespread recognition is at odds with the patent success of WIPO's own web site at <http://www.wipo.int>, which according to Erik Wilbers' presentation at WIPO's conference on 20 February 2001 has around 1,000,000 monthly online hits. This shows that it is possible to create a highly successful internet presence within the .int Top Level Domain.
3. As the .int Top Level Domain is restricted to IGOs, internet users can be assured of the provenance of the web sites found in that Top Level Domain.

Nominet accepts that the .int Top Level Domain does not protect IGOs from abusive registrations in other Top Level Domains. To that end, Nominet supports the proposal of various

commentators set out in paragraph 108 of the draft report, to relax the restriction that complaints be founded on trade mark rights which is currently found in the UDRP, for the following reasons:

1. Nominet agrees that such an expansion would take account of the treaty based authority and protection afforded to IGOs, whilst respecting the rights of existing holders of domain names.
2. As noted in paragraph 109, it is conceivable that domain names including the acronyms of IGOs could be put to different legitimate uses by third parties, and also that the proposed exclusion raises free speech concerns.
3. In paragraph 129, WIPO expresses a concern that if experts lack appropriate qualifications to deal with disputes involving IGOs, this may lead to inconsistency in published decisions. Nominet does not agree that panellists in disputes involving IGOs would require a background in public international law. It is submitted that an IGO could satisfy the requirement to demonstrate rights in the name or acronym comprised in a domain name by setting out the treaty based authority and protection of its name. The issues posed by the second and third stages of the test set out at paragraph 4(a) of the UDRP would remain to be determined by a panellist on the same criteria as are currently applied with regard to trade mark based disputes.
4. An appeals process could adequately deal with any concerns over inconsistent decision.

Personal Names

Nominet supports the second of the three options put forward in paragraph 185 of the draft Report that the UDRP be expanded to deal with abusive registrations involving personal names. This would be possible provided that the UDRP be amended as follows:

1. to include safeguards to ensure that names which retained their fundamentally descriptive or generic character, not having acquired distinctiveness, be excluded from protection; and
2. to include safeguards to ensure that sites operated solely in tribute to or criticism of an individual are not regarded as prima facie evidence of bad faith.

In Nominet's view, to expand the UDRP in this way would avoid the present anomaly described at paragraph 155. That is, at present, well known individuals who use their name as a mark in commerce can and have successfully used the UDRP against abusive registrations, whilst well known individuals who cannot claim protection for their name under trade mark laws because they have not used their name as a mark in commerce cannot.

Such an expansion would also avoid the situation noted in paragraph 177, namely that “panels have arguably stretched their interpretation of the Policy to find common law trademark rights in a name, even though there was little or no evidence, despite the notoriety of the name, that it had been used as a mark in commerce.”

Geographical indications

Nominet agrees with the conclusion expressed in paragraphs 221-222, that an exclusion on the registration of geographical indications is not to be recommended, in that such an exclusion is likely to raise significant problems. Not only would it represent a significant erosion of the principle of first come, first served, it would be unduly onerous for registries to administer. It is also doubtful whether it would succeed in its objective of curbing abuse.

Nominet agrees that the appropriate method of dealing with domain names incorporating geographical indications is by an expansion of the UDRP, as expressed in paragraph 227.

However, Nominet notes the distinction between geographical indications as an appellation of origin (which enjoy broad protection in intellectual property law) and other geographical terms which do not. It is submitted that were WIPO to expand the scope of rights which could enjoy protection under the UDRP, then it would also be necessary to introduce safeguards to prevent claims aimed at securing generic or descriptive [geographical] names.

Trade Names

In paragraph 318, WIPO requests submissions on the extent of abusive registrations of trade names per se and on the nature of the harm being occasioned by such registrations.

As mentioned above, since 1997 when it introduced its Dispute Resolution Service, Nominet has not limited the type of rights asserted by complainants in domain name disputes. As a result we estimate that roughly ½ of the 1,400 disputes handled by Nominet involve trade names rather than trade marks or personal names.

Typically, such disputes involve smaller, more localised businesses than disputes involving registered trade marks.

Although many disputes are brought in relation to purely descriptive terms, where there is little or no evidence of bad faith, a relatively high proportion do provide evidence of abusive registrations. Typically such disputes involve small businesses where there has been a “board room fall-out”, in which the registrant is alleged to have registered the trade name of his or her previous employer. Other examples involve competitors located within a narrow geographical area, one of whom registers the other’s name in an attempt to gain unfair competitive advantage, or an individual who registers the trading names of businesses located near to him or her geographically in an attempt to demand a high price in return for the transfer of each domain name registration.

As WIPO is well aware, trade mark owners have in recent years successfully obtained protection of their rights through the UDRP by establishing well organised, well funded and articulate lobbyists. It is submitted that the lack of evidence of harm referred to in paragraph 317 does not necessarily indicate the lack of a problem. On the contrary, in our experience the problem exists, but the potential complainants may not have been able to organise as coherent or powerful a lobby as larger businesses.

Nominet urges WIPO not to discount the abuse which is occurring in relation to trade names, and would be happy to provide further assistance on this point if requested.

Nominet recommends that the UDRP be expanded to cover rights in trade names.

Role of Technical Measures

Nominet recognises the tension between an individual registrant's rights to privacy on the one hand and the requirements of intellectual property holders and law enforcement agencies on the other. Nominet welcomes WIPO's draft recommendation (in paragraph 353) that principles of access to and use of WHOIS data be codified, to take into account this tension.

In Nominet's view, it is possible to safeguard individuals from spam and cold-calls by publishing only their name and address as part of the WHOIS, whilst the ability to perform reverse look ups can be provided on a subscription basis to trusted third parties.

Conclusion

Nominet welcomes the opportunity to comment on WIPO's draft Second Report.

Nominet strongly opposes the recommendation to exclude from registration names identical to INNs and IGOs, but supports proposals to expand the scope of the UDRP to include personal names, geographical indications and trade names.

**Comments of A. Michael Froomkin
Professor of Law, University of Miami School of Law
Member of WIPO "Panel of Experts" in First WIPO Domain Name
Process**

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June 4, 2001

Washington, D.C

EXECUTIVE SUMMARY

1. WIPO's proposed expansion of the UDRP is

- premature;
- procedurally illegitimate and
- substantively wrong.

It is premature to propose expanding the UDRP until a host of very substantial problems with the current system have been solved.

2. It also is wrong to propose 'exclusions' that would remove words from the namespace on the basis of an arbitrary set of criteria. If this arbitrary list of factors is adopted, we can expect many others to follow.

3. In many cases WIPO is proposing solutions to "problems" which it is unable to prove exist, and which do not exist, or are so minor as to fail to justify the highly intrusive proposals advanced by WIPO -- especially when one considers the precedential effect these proposals could have.

4. WIPO is proposing regulations which vastly exceed the current international consensus of the protection due to intellectual property. In so doing it seeks to make de facto law in an undemocratic and illegitimate way. It is striking that the nation whose laws would most frequently be undermined, overruled, or ignored by the current WIPO proposals is the United States. WIPO's proposals amount to little more than an attempt to impose European intellectual property rules on the United States without the consent of the US Congress and the US political process. To the extent that WIPO's proposals reflect a central planning concept of the 'optimal' use of some domain names, or the idea that domain name uses should be curtailed to serve particular social policies, this reflects an orientation antithetical to free market values.

WIPO's PROPOSALS ARE PREMATURE

5. It is premature to be talking about expanding the UDRP until we have had a review of the functioning of the UDRP we already have.

1. The review was due last year, but is only now getting (slowly) under way.
2. There are a large number of legitimate questions about the UDRP which suggest rather strongly that the UDRP is not a fair and legitimate way of resolving domain name disputes.

PROBLEMS WITH CURRENT UDRP SYSTEM

6. The RFC proceeds under the quite mistaken assumption that the UDRP is functioning well. Even if it may be true that "the UDRP has proven itself to be an effective system for eradicating bad faith cybersquatting in respect of trademarks" (para 225), WIPO fails to consider the extent to which this result has been achieved at the expense of the legitimate rights of non-trademark holders. It is striking that the decisions generally accepted to be erroneous under the UDRP are almost uniformly drawn from those in favor of trademark holders and against innocent registrants. The UDRP's errors are indeed one-sided. Until and unless these are corrected, the UDRP should not be expanded. Indeed, one might more reasonably ask whether it should be abolished if these serious inequities cannot be corrected.

7. The UDRP's problems begin with lack of adequate notice for respondents - the policy fails to require actual notice, or even reasonable attempts to achieve actual notice. Time for response starts to run when notice is SENT, not received. Study is required to determine to what extent the high rate of defaults by respondents is due to lack of timely notice.

8. Some of the arbitral bodies have written rules that are manifestly unfair to respondents.

- Example: the NAF "sandbag rule" by which parties (i.e. complainants) can pay extra and submit a supplemental pleading after the close of regular pleadings -- including factual allegations to which the respondent then has no opportunity to reply.
- Example: the NAF policy by which if the respondent pays for a 3-member panel, and the complainant then withdraws a complaint without prejudice before panel action, the respondent's money is not refunded.

9. There is insufficient transparency about how arbitral bodies select arbitrators for particular cases, and a lack of variety among the arbitrators, too many of whom are chosen from the corporate trademark bar, and too few from backgrounds that would tend, on average, to make them more sensitive to the legitimate rights of individuals and non-commercial users.

10. Since complainants choose the arbitral body, the current system creates a financial incentive for arbitral bodies to compete to be 'complainant friendly'. [How many press releases do arbitral bodies issue saying 'complainant loses?' compared to 'complainant wins?'] This reasonable suspicion of partiality, whether or not it actually exists, provides a reason why the impartiality of the arbitral bodies might reasonably be questioned; as such it taints the entire system.

11. Equally seriously, the UDRP was sold to the Internet community on the premise that there would be at least a limited 'parity of appeal'. In fact, this term was a double misnomer, in that even at its best there was a subsequent judicial proceeding which was neither an "appeal" (being as a legal matter a separate and original lawsuit rather than a true appeal of the mere 'administrative process' in the UDRP) nor one with true parity--and a recent court decision suggests the law is moving away from even that rather low 'best'.

- It was originally foreseen that the UDRP would allow a losing domain name registrant ten days to file a transfer-blocking action in a court of competent jurisdiction. By contrast, a losing trademark owner would of course have had a much longer time to file; there was thus no real 'parity' at all. And ten days is a ridiculously short time for an unrepresented party to secure counsel and to file a complaint, especially if the relevant courthouse is far from home.
- It now transpires, however, that in the United States, even a losing domain name registrant who surmounts this hurdle may not be able to secure a judicial determination of his rights. The U.S. District Court in Massachusetts recently held, in the *Corinthians.com* case, that a trademark holder who prevailed in a UDRP case could prevent the court from ruling on the merits of a domain name holder's attempt to overturn this outcome via a declaratory judgment action by the simple stratagem of promising not to bring Lanham Act claims against the original registrant. Upon this stipulation, the District Judge dismissed the action for failing to state a claim - a result which (if upheld by the 1st Circuit court of appeals) would allow the UDRP domain name transfer to go forward automatically without a judicial hearing on the merits of the parties' claims.
- This should come as no surprise. I warned against the problem of a potential lack of a cause of action in my commentary on the report in the first WIPO process. See http://www.law.miami.edu/~amf/commentary.htm#_1_27.

PROBLEMS WITH WIPO'S CURRENT PROPOSALS

12. The first WIPO domain name process correctly relied on an important principle: that WIPO's goal in this non-treaty, non-governmental, non-representative, process should be to avoid attempting to create some species of new regulations, unsanctioned by any democratic or legitimate representative process. It would be a grave error to abandon this wise view. In particular, WIPO is unwise to suggest in its second process that this bedrock principle could be allowed to suffer "some adjustment"

(paragraph 18). There can be and should be no "adjustment" to the principles of democracy and legitimacy.

13. In contrast, it is heartening to see that WIPO continues to recognize the importance of giving proper respect to "agreed rights outside the intellectual property system" (paragraph 19). It is unfortunate, however, that WIPO did not in fact give due weight to the importance of the democratic process. Had it done so, it would not be entertaining suggestions that ICANN impose preferences for various categories of businesses that conflict with the delicately balanced intellectual property regime in force in the US, and no doubt other countries as well.

INNs

14. We begin with the critical fact that WIPO has yet to make out even a minimal case for the regulation of INNs: "Evidence of actual damage resulting from the registration and use of INNs is lacking". (Paras 45, 55). Despite this, WIPO argues for regulation! WIPO's approach amounts to the Alice in Wonderland principle of "sentence first, verdict later". To which one can only respond, "If it ain't broke, don't fix it."

15. It would be very unfortunate to embark on a policy of regulating access to domain names via an exclusion mechanism based on their purported content or on the consequences of presumed 'misuse' of a name. There are currently a large number of potential non-commercial legitimate uses of a domain name of the form 'medicine.tld' where 'medicine' is an INN and 'tld' is a TLD. For example, patients concerned about the side-effects of a drug might band together to exchange information on a web-based discussion board. (See, for example, caffeine.com.) This exercise of communicative and associative freedoms would be completely legal in the United States and no doubt elsewhere. WIPO should not impose limits on it.

16. This rule would set a dangerous precedent. It is difficult to understand why INNs are more deserving of preferential treatment than the names of, say, major religions or churches, political movements, names of deities, or a myriad other examples. To overlay the DNS with the regulatory agendas of various interests would be to limit the simplicity and utility of the DNS system for no substantial gain, and indeed much future wrangling and pain.

17. Even if there were evidence of a problem, WIPO's entire approach to the issue of the registration of domain names carrying character strings leaves out the simple solution of creating more TLDs: Contrary to what WIPO implies, registration of a name in one TLD by one party does not prevent others from registering the same string, so long as they do so in another TLD. As a result, no domain name registrant need have a monopoly on the use of an INN (or any other string) in a second-level domain name. To the extent that WIPO's concerns are that one party may secure an unfair commercial or other advantage by having an attractive SLD comprising an INN, the proper responses are

1. The case for why this sector should be exempt from first-come-first serve rules that apply to everyone else is woefully unproven
2. The solution to this (and other similar problems) is to rapidly expand the supply of attractive TLDs so that many SLDs in a given string become available. Indeed, the more SLDs there are in a given string, the less likely it becomes that anyone would erroneously impute semantic significance to a given string. This solution also allows market forces rather than regulation to determine registrations.

NAMES of INTERNATIONAL INTERGOVERNMENTAL ORGANIZATIONS

18. International intergovernmental organizations occupy a privileged position in the DNS: they have their own TLD, .int. It is the height of special and self-interested pleading for WIPO, an .int registrant, to demand additional protections. This is nothing less than a transparent attempt by thin-skinned international bodies unaccustomed to the rough and tumble of the democratic process and popular debate to prevent aptly-named criticism sites from being operated by protest groups. It is ignoble to suggest that these bodies -- all of whom could and should be accommodated in their own bespoke TLD, .int -- should have a greater protection against critical web sites than anyone else.

PERSONAL NAMES

19. WIPO's analysis of the so-called jurisprudence relating to personal names under the UDRP completely misses a key point. It was a commonplace among all those who drafted the UDRP that personal names other than those which were clearly trademarks were excluded from the UDRP. WIPO staff believed this, as did all member of the WIPO Advisory Panel of Experts on which I served. Yet, somehow, some arbitrators have managed to find that some personal names are protected. The conclusion one reasonably draws from this is not that personal names should therefore receive protection above that already provided by the legal systems of the world, but rather that either the UDRP is badly drafted, or the arbitration process is flawed, or the arbitrators are badly selected, or all three.

20. In particular, panels have been sloppy in their acceptance of allegations of claims of common law rights in names. It is not an exaggeration to term this area an abuse of the UDRP.

21. United States law is quite clear at the federal level on the very limited protection available to personal names, and in particular in the requirement that a cybersquatter be seeking to sell a domain name in order for the rights of the named person to be infringed.

22. It follows from the above that, first, WIPO should not propose rules that contradict or exceed US federal law, and second, that the existing UDRP process needs to be studied and reformed before it can be expanded.

GEOGRAPHIC DESIGNATIONS

23. The paucity of 'abuses' of the type that are commonly understood to constitute cybersquatting in relation to geographic designations underscores the extent to which the regulatory impulse here is not one designed to combat bad faith (e.g. of someone using nation.net for a web site pretending to be the official web site of the government of that nation), but rather a desire to subject the name space in certain TLDs to a centrally directed concept of optimization. This dirigiste conception is antithetical to the free-market orientation that produced the Internet. It is particularly upsetting to see a United Nations body opining that some supra-national body should be empowered to decide when a web site is using a domain name in a "worthwhile" way (paragraph 268). This is not a judgment that should be left to governments, and still less to the unelected mandarins at WIPO, or to arbitrators selected via a process equally lacking in democratic legitimacy.

24. Indeed, it is striking that WIPO has been able to find only one instance of a name in Annex XIII offered for sale.

25. To the extent that there are interests that seek to promote or express themselves under a geographically identifying domain name but find that they are blocked by someone else first in time, the solution is clear: create more TLDs in order to broaden this opportunity. In particular, a measured, consistent, predictable roll-out of new TLDs addresses the legitimate 'digital divide' issue noted in paragraph 267.

26. It is important to recall that the DNS, and especially the gTLDs, is a private network. Names are registered by individuals who transact with private registration bodies. It is antithetical to the free market system to impose some externally generated requirement of optimum use on these private arrangements. It is appropriate to police them for mis-use (e.g. 'passing off'), but this is in all cases a judgment which can only be made AFTER the registrant has made some use of a domain name -- it can NEVER be made ex ante. Yet, this is precisely what WIPO seeks to establish.

27. Given that every country has a ccTLD which is fully subject to its national law and regulation, it is hard to see what legitimate national interests are served by giving nations or national administrative units extra-territorial rights over registrations in gTLDs. The country's needs for authoritative and reliable names on which its citizens and other can justifiably rely should be fully served by the ccTLD.

TRADE NAMES

28. While as an abstract matter the case for protecting trade names in the DNS shares many similarities with the case for protecting trademarks, there are practical difficulties which suggest that achieving such protection without great and undesirable side-effects might be very difficult. Indeed, one of the chief lessons of the UDRP is that the lightweight rapid online arbitral system does a poor job of sifting contested facts, and this is rarely more evident than in the very poor job that panels have often done with respects to assertions of unregistered (common law) trademark rights. Lacking the ability and incentive to cross-examine parties or indeed seek further and better particulars (it takes longer, the rules all but prohibit it, and it doesn't pay extra), panels have tended to shoot from the hip, with very uneven results.

29. In formulating any scheme for the protection of trade names, three considerations should remain paramount. First, the extent to which additional protection would solve an actual problem as opposed to merely providing an attractive intellectual symmetry. The case here remains unproven. Second, given that tradenames are frequently unregistered, by what means one might avoid replicating and furthering abuses similar to those occasioned by the assertion of alleged unregistered common law tradenames under the existing UDRP. And, third, how to avoid breaching the principle of respecting national law rather than supplanting it..

WHOIS

30. WIPO's discussion of privacy issues in the WHOIS fails to meet the standard of thoroughness set by much of the rest of the report. In particular, the report's very cursory treatment of existing privacy law fails to discuss the relevant privacy laws of major legal systems (most notably the EU member states and Canada), and the extent to which the current WHOIS policy currently in use likely breaches them. This issue needs to be addressed before even opening the issue of whether the WHOIS should be expanded.

WIPO 2 Process

**Letter from WIPO to ICANN
(with attachments)**



Letter from Francis Gurry,
WIPO, to Vint Cerf and Stuart
Lynn

21 February 2003

WIPO



**WORLD INTELLECTUAL PROPERTY
ORGANIZATION**

GENEVA

February 21, 2003

Dr. Vinton G. Cerf
Chairman
Dr. M. Stuart Lynn
President and Chief Executive Officer
Internet Corporation for Assigned Names and Numbers (ICANN)
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By fax: +1 310 823 8649
Number of pages: 7

Dear Dr. Cerf,
Dear Dr. Lynn,

I write to inform you of two decisions taken by the competent organs of the World Intellectual Property Organization (WIPO), which the Member States of WIPO have requested be transmitted to the Board of the Internet Corporation for Assigned Names and Numbers (ICANN).

The two decisions in question arise out of the [Second WIPO Internet Domain Name Process](#). You will recall that this Second WIPO Process concerned the relationship between domain names and five types of identifier, namely, International Nonproprietary Names for pharmaceutical substances (INNs), the names and acronyms of international intergovernmental organizations (IGOs), personal names, geographical identifiers and trade names. The Member States of WIPO recommended that two such identifiers should be protected against abusive registration as domain names, namely, the names and acronyms of IGOs and country names (being one particular type of geographical identifier). Details of the two recommendations of the Member States are set out in the ensuing paragraphs.

The Names and Acronyms of International Intergovernmental Organizations (IGOs)

Following consideration of 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*) by [two special sessions of the WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications](#) (SCT) held in [2001](#) and [2002](#), the WIPO General Assembly (the highest organ of WIPO) [decided, in October 2002](#), that the Uniform Domain Name Dispute Resolution Policy (UDRP) should be modified to allow IGOs to file complaints in respect of the abusive registration of their protected names and acronyms. The decision was supported by all Member States of WIPO, with the exception of the United States of America, which dissociated itself from the decision. The foundation in international law for this recommendation is [Article 6ter of the Paris Convention for the Protection of Industrial Property](#).

The types of names and acronyms in respect of which a complaint should be able to be filed and the grounds on which such a complaint should be able to be filed are set out in the decision of the WIPO General Assembly, which is reproduced in [Annex 1 to this letter](#). You will note also that the Member States decided that the privileges and immunities enjoyed by international intergovernmental organizations in international law should be respected in the implementation of this recommendation in the UDRP. To this end, it is recommended that IGOs should not be required to submit to the jurisdiction of national courts, but that a special appeal procedure by way of de novo arbitration should be available to any party wishing to contest a decision made under a UDRP complaint.

Country Names

Following consideration of the question of the protection of country names against abusive registrations by the [two special sessions of the SCT](#) mentioned above, the WIPO General Assembly, [in October 2002, remitted the question for further consideration by the SCT](#). The SCT met for this purpose in November 2002 and [adopted a decision](#) that the short and long names of States, as set out in the United Nations Terminology Bulletin, should be protected against identical and misleadingly similar registrations as domain names by persons unconnected with the constitutional authorities of the States concerned. It was recommended that this protection should be implemented through an amendment of the UDRP and should apply to all future registrations of domain names in the gTLDs. Further details of the protection are set out in the text of the decision, which is set out in [Annex 2 to this letter](#).

The decision on the protection of country names was supported by all Member States of WIPO, with the exception of Australia, Canada and the United States of America, which dissociated themselves from the decision. Japan also expressed certain reservations, which are recorded in the text of the decision.

The SCT also decided to continue discussions on three related issues concerning the protection of country names in the domain name system, namely, the extension of protection to a limited number of familiar or common names for certain countries (such as Holland for the Netherlands), the retrospective application of the protection of country names to existing registrations and the question of the sovereign immunity of States party to proceedings relating to the protection of country names in the domain name system. We shall keep you informed of the evolution of discussions on these related issues.

Other Identifiers

The other types of identifier that were the subject of the Second WIPO Process were also considered by the WIPO General Assembly. The WIPO General Assembly decided, in this regard, not to recommend any action in relation to INNs, personal names and trade names. It referred the question of geographical indications (in the accepted sense of that term in international law) to the SCT for further consideration. Full details of the decisions of the WIPO General Assembly and of the subsequent discussions in the SCT are contained in the supporting documentation which is referred to below, and which is attached to the original of this letter.

Supporting Documentation

For your information and reference, I am enclosing, with the original of this letter, the following supporting documentation:

- 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*);
- a [document entitled "Internet Domain Names"](#) (document WO/GA/28/3), which formed the basis of the WIPO General Assembly's consideration of the issues covered in this letter, together with the [Report of the WIPO General Assembly's meeting](#) (document WO/GA/28/7, see paragraphs 57 to 81);
- the Reports of the sessions of the WIPO SCT held in [November/December 2001](#) (document SCT/S1/6), [May 2002](#) (document SCT/S2/8) and [November 2002](#) (document SCT/9/8).

My colleagues and I are at your disposal, and at the disposal of your staff, to discuss the WIPO recommendations concerning the names and acronyms of IGOs and country names and to provide whatever assistance you may wish to have in relation to them.

Yours sincerely,

Francis Gurry
Assistant Director General
Legal Counsel

cc: Mr. Alejandro Pisanty, Vice-Chairman Mr. Hans Kraaijenbrink
Mr. Amadeu Abril i Abril Mr. Sang-Hyon Kyong
Mr. Karl Auerbach Mr. Andy Mueller-Maguhn
Mr. Ivan Moura Campos Mr. Jun Murai
Mr. Lyman Chapin Mr. Nii Quaynor
Mr. Jonathan Cohen Mr. Helmut Schink
Mr. Mouhamet Diop Mr. Francisco A. Jesus Silva
Mr. Masanobu Katoh Ms. Linda S. Wilson

Mr. Sharil Tarmizi, Chairman,
Governmental Advisory Committee
Mr. Louis Touton, Vice-President,
Secretary and General Counsel
Ms. Theresa Swinehart, Counsel for
International Legal Affairs

ANNEX 1

WIPO Recommendation on the Names and Acronyms of International Intergovernmental Organizations

"Noting, in particular, Article 6^{ter} of the Paris Convention, to which 163 States are party,

"1. The Special Session recommends that the UDRP be modified to provide for complaints to be filed by an international intergovernmental organization (IGO)

A. on the ground that the registration or use, as a domain name, of the name or abbreviation of the IGO that has been communicated under Article 6^{ter} of the Paris Convention is of a nature

(i) to suggest to the public that a connection exists between the domain name holder and the IGO; or

(ii) to mislead the public as to the existence of a connection between the domain name holder and the IGO; or

B. on the ground that the registration or use, as a domain name, of a name or abbreviation protected under an international treaty violates the terms of that treaty.

"2. The Special Session further recommends that the UDRP should also be modified, for the purposes of complaints mentioned in paragraph 1, to take account of and respect the privileges and immunities of IGOs in international law. In this respect, IGOs should not be required, in using the UDRP, to submit to the jurisdiction of national courts. However, it should be provided that decisions given in a complaint filed under the modified UDRP by an IGO should be subject, at the request of either party to the dispute, to *de novo* review through binding arbitration.

"3. The Delegation of the United States of America dissociated itself from

this recommendation."

(See documents [SCT/S2/8](#), paragraph 88 and [WO/GA/28/7](#), paragraph 79)

[End of Annex 1]

ANNEX 2

WIPO Recommendation on Country Names

"6. Recalling the decision reached by the General Assembly at its meeting in September 2002, the majority of delegations favored amending the Uniform Domain Name Dispute Resolution Policy (UDRP) to provide protection for country names in the DNS.

"7. As regards the details of such protection, the delegations supported the following:

(i) protection should be extended to the long and short names of countries, as provided by the United Nations Terminology Bulletin;

(ii) the protection should be operative against the registration or use of a domain name which is identical or misleadingly similar to a country name, 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;

(iii) each country name should be protected in the official language(s) of the country concerned and in the six official languages of the United Nations; and

(iv) the protection should be extended to all future registrations of domain names in generic top-level domains (gTLDs).

"8. The delegations supported continued discussion on:

(i) extension of protection to the names by which countries are familiarly or commonly known, and agreed that any additional such names be notified to the Secretariat before December 31, 2002;

(ii) retrospective application of the protection to existing registrations of domain names, and in which alleged rights may have been acquired; and

(iii) the question of sovereign immunity of States before the courts of other countries in relation to proceedings relating to protection of country names in the DNS.

"9. The delegations requested the Secretariat to transmit the said recommendation to the Internet Corporation for Assigned Names and Numbers (ICANN).

"10. The Delegations of Australia, Canada and the United States of America dissociated themselves from this decision.

"11. The Delegation of Japan stated that, while it did not oppose the decision to extend protection to country names in the DNS, further discussion was required concerning the legal basis for such protection, and stated its reservation to paragraph 7 herein, except for subparagraph (iv)."

(See documents [WO/GA/28/7](#), paragraphs 80 to 81 and [SCT/9/8](#), paragraphs 6 to 11)

[End of Annex 2]

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WIPO



WO/GA/28/3
ORIGINAL:English
DATE:June24,2002

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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

WIPO GENERAL ASSEMBLY

**Twenty-Eighth (13th Extraordinary) Session
Geneva, September 23 to October 1, 2002**

INTERNET DOMAIN NAMES

Document prepared by the Secretariat

1. The WIPO General Assembly at its meeting in September 2001 decided (document WO/GA/27/8) that the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) was to hold two special sessions on the Report of the Second WIPO Internet Domain Name Process (the "Second Process Report"). At the same time it was decided that "[a] report of the two special sessions of the SCT should be prepared which presents the options for the treatment of the issues dealt with in the Second Process Report... [and which] should be transmitted to the meetings of the WIPO General Assembly in September 2002 for consideration and decision."
2. The first Special Session of the SCT was held from November 29 to December 4, 2001, and the second Special Session from May 21 to May 24, 2002. The reports of the first and second Special Sessions are contained in documents SCT/S1/6 and SCT/S2/8.
3. The present document constitutes the Report to the WIPO General Assembly on the work of the Special Sessions, as mandated by the General Assembly's decision of September, 2001.

Background

4. Following the approval of its Member States (documents A/33/4 and A/33/8), WIPO conducted the first WIPO Internet Domain Name Process (the "First WIPO Process") from

July 1998 until April 1999, which culminated in the publication of a Report dated April 30, 1999, entitled "The Management of Internet Names and Addresses: Intellectual Property Issues" (WIPO Publication No. 439; the "First Process Report"). The purpose of the First WIPO Process was to recommend measures aimed at reducing the friction which exists between the intellectual property system and the Domain Name System (DNS), with a particular focus on preventing and resolving conflicts between domain names and trademarks. The First Process Report contained a broad set of recommendations on how this could be achieved, the most important of which concerned the creation of a uniform procedure for the resolution of domain name disputes based on the allegation that the registration and use of a domain name constituted an abuse of a corresponding trademark. This recommendation, as well as several other recommendations contained in the First Process Report, were adopted by the Internet Corporation for Assigned Names and Numbers (ICANN) in August 1999 and constituted the basis for the Uniform Domain Name Dispute Resolution Policy (UDRP). The UDRP, which came into effect in December 1999, is now widely regarded as the primary means of combatting trademark cybersquatting in the generic Top-Level-Domains (gTLDs), with more than 6000 cases filed under it. Of those, more than 4000 have been filed with the WIPO Arbitration and Mediation Center, the leading dispute resolution service provider for the UDRP. The procedure also has increasingly gained ground in the country code Top-Level-Domains (ccTLDs), as many ccTLD administrators have adopted it, or a variation thereof, on a voluntary basis. To date, 25 administrators of ccTLDs have retained the WIPO Arbitration and Mediation Center as the dispute resolution service provider on the basis of the UDRP or a variation of the procedure. The ccTLDs in question are .AC (Ascension Island), .AE (United Arab Emirates), .AG (Antigua & Barbuda), .AS (American Samoa), .BS (Bahamas), .BZ (Belize), .CC (Cocos Islands), .CY (Cyprus), .EC (Ecuador), .FJ (Fiji), .GT (Guatemala), .LA (Lao People's Democratic Republic), .MX (Mexico), .NA (Namibia), .NU (Niue), .PA (Panama), .PH (Philippines), .PN (Pitcairn Island), .RO (Romania), .SC (Seychelles), .SH (St. Helena), .TT (Trinidad and Tobago), .TV (Tuvalu), .VE (Venezuela) and .WS (Western Samoa). The WIPO Arbitration and Mediation Center has received more than eight years of cases concerning registrations in the ccTLDs.

5. While the focus of the First WIPO Process was on the protection of trademarks in the DNS, it became apparent during the course of its conduct that a range of identifiers other than trademarks also were the subject of abuse in the DNS. Particular reference in this regard was made in the First Process Report to tradenames, geographical indications and personal names.¹

6. In June 2000, WIPO received a letter of request from the Government of Australia and 19 of its other member Governments to initiate a Second WIPO Process to address those intellectual property issues relating to Internet domain names that remained to be considered after the First WIPO Process. This initial request was later endorsed by the WIPO General Assembly (documents WIPO/GA/26/3 and WIPO/GA/26/10). In response to this request, in July 2000, WIPO commenced the Second WIPO Process. The issues covered by this Process concerned the bad faith, abusive, misleading or unfair registration, as domain names, of: (1) international nonproprietary names (INNs) for pharmaceutical substances, (2) trade names, (3) personal names, (4) names and acronyms of international intergovernmental organizations (IGOs) and (5) geographical identifiers, including geographical indications and country names. The Second WIPO Process also discussed the role of technical measures in alleviating intellectual property concerns in the DNS and focused in particular on WHOIS

¹ See paragraphs 167 and 168 of the First Process Report.

databases in this connection. The WHOIS system of databases is the collection of information concerning domain name registrants' contact details, as well as nominated technical and administrative contacts and associated technical data, which, in most cases, is publicly available online, for real-time searching by all enquirers.

7. The Second WIPO Process addressed the above issues through a process of consultations – conducted online and through in-person regional meetings – resulting in the Second Process Report, entitled “The Recognition of Rights and the Use of Names in the Internet Domain Name System” that was published on September 3, 2001 (WIPO Publication No. 843). The Report makes practical recommendations based on the consultation process, aimed at preventing and resolving domain name conflicts in relation to the identifiers covered by the Second WIPO Process. The Report was presented to WIPO's Member States and the Internet community, including ICANN. As mentioned in paragraph 1, above, at their meeting held from September 24 to October 3, 2001, the WIPO Member States decided subject the Second Process Report to a comprehensive analysis by the SCT, meeting in two Special Sessions for this purpose.

8. The remainder of this document summarizes the findings of the Second Process Report, as well as the discussions held at the first and second Special Session of the SCT, and sets out the recommendations made by the SCT on each of the topics concerned. It also discusses, where necessary, any issues in relation to those recommendations that remained outstanding after the two Special Sessions and require further consideration by the General Assembly.

International Nonproprietary Names (INNs) for Pharmaceutical Substances

9. The INN system is a naming system established pursuant to a Resolution of the World Health Organization (WHO) which operates to create a unique name for a new pharmaceutical substance. This unique name is intended to be generic, meaning that no proprietary rights should be attached to it, and that it should be free for use by all, as a means of enhancing the quality of medical services and the capacity of medical practitioners and patients around the world to be able to identify a new drug by reference to one specific generic name. Under the INN system, there is a consensus on the part of public health authorities and of the private sector that the names in question should not be registered or used as trademarks. The Second Process Report analyzed the evidence of bad faith registrations of INNs as domain names and found that there had been a number of INNs, particularly those with respect to very widely used drugs, that had been registered as domain names by various parties. It concluded that the registration of an INN as a domain name brings with it the consequence that that particular unique space in the DNS is controlled by one particular party, which may be considered to be inconsistent with the policy objectives underlying the INN system. The Second Process Report thus recommended that action be taken to protect INNs against their abusive registration as domain names. In particular, it recommended that any interested party should have the right to serve notice that a domain name registration in a gTLD is identical to an INN and that, upon verification of the exact similarity between the domain name registration and the corresponding INN by WIPO, in conjunction with WHO, notice to ICANN, and certification by ICANN to the registrar concerned, the domain name registrations should be cancelled.

10. While many delegations at the first Special Sessions supported the protection proposed for INNs in the First Process Report, several others remarked that insufficient problems had been experienced with INNs in the DNS to warrant the establishment of any protective

measures. After discussions, the Chair concluded that “[t]he majority of delegations considered that, in view of insufficient evidence of the abusive registration of INNs as domain names and of the harm resulting from the registration of INNs as domain names, no immediate action was necessary.”

11. At the second Special Session, a representative of the World Health Organization offered an extensive explanation of the background to and purpose of the protection of INNs, as well as why, in his Organization’s view, it would be appropriate to protect INNs against their registration as domain names. Several delegations reiterated their position that insufficient evidence had been presented of problems encountered. Others maintained the view that it would be opportune to provide protection for INNs in the DNS at this stage to safeguard against their potential abuse in the future. Certain delegations proposed that the situation continued to be monitored. After debate, the Chair concluded as follows:

“...[M]any delegations favored the protection of INNs in the Domain Name System against registration as domain names in order to protect the integrity of the INN system. While it was decided not to recommend a specific form of protection at this stage, it was agreed that the Secretariat should, in cooperation with the World Health Organization, continue to monitor the situation and, if necessary, bring to the attention of the Member States any material change in the situation.”

12. The Assemblies of the Member States of WIPO are invited to take a decision on the recommendation of the Special Session as contained in paragraph 11, above.

Trade Names

13. The Second Process Report investigated whether it would be opportune to expand the scope of the UDRP to cover also trade names. Although trade names benefit from protection at the international level under Article 8 of the Paris Convention, the Second Process Report did not recommend that the UDRP be modified to permit complaints to be made on the basis of abusive registrations and use of trade names *per se*. Reasons advanced in the Report in support of this recommendation included the diversity of national approaches in the protection of trade names, the lack of evidence of problems experienced in the DNS with respect to trade names *per se*, the fact that several registrants may have a legitimate interest in a trade name (as the burden for establishing the existence of a trade name is relatively light in many jurisdictions), and the fact that the principal users of trade names, small enterprises with often a local sphere of activities, might have difficulties establishing the conditions required to be met for receiving protection at the global level through the UDRP.

14. Several delegations at the first Special Session favored the extension of the UDRP to trade names. Several arguments were advanced in support of this position. First, it was observed that, while the UDRP applies to unregistered trademarks, it currently does not apply to trade names, although the international legal framework for the latter is more fully developed, taking into account Article 8 of the Paris Convention. Second, it was argued that not including trade names under the scope of the UDRP favors those countries which protect unregistered marks, to the detriment of those that do not. Third, it was also stated that including trade names as a basis for filing a complaint under the UDRP would make the procedure more accessible to small and medium-sized enterprises. Other delegations opposed

broadening the scope of the UDRP to tradenames. According to those delegations, such identifiers are already indirectly covered by the procedure, as they often also qualify as unregistered trademarks. These same delegations also were of the view that there is insufficient common understanding at the international level of the definition of tradenames to warrant their inclusion in the UDRP. After the discussions, the Chair noted that “[a] majority of delegations considered that tradenames should be protected against abusive domain name registrations through the UDRP. Certain delegations, however, opposed such an extension of the UDRP. It was decided to continue discussions on this question at the Second Special Session to see if an agreed position would be reached.”

15. The discussions at the second Special Session essentially reflected the same views as those expressed at the first Special Session, highlighting again the different legal traditions among countries with respect to the protection of tradenames and their relationship with (unregistered) trademarks. After the debate, the Chair observed that

“...[V]iews were divided as to whether the UDRP should be modified to accommodate tradenames. One group of countries wished to treat tradenames in the same manner as trademarks; others felt that there was no international accepted legal basis to underpin the extension.

“It was decided that Member States should keep the matter under review and raise the matter for further discussion if the situation so demanded.”

16. The Assemblies of the Member States of WIPO have reinvented to take a decision on the recommendation of the Special Session as contained in paragraph 15, above.

Personal Names

17. The cases that have been filed and determined under the UDRP have interpreted the meaning of trademark to extend, not only to registered trademarks, but also to unregistered or common law trademarks. In consequence, many individuals have used the UDRP in order to file cases for the abusive registration as domain names of their personal names. However, the Second Process Report noted two limitations to the use of the UDRP as a means of protecting personal names against abusive registration as domain names. The first limitation concerns those countries in which common law or unregistered trademark rights are not recognized. For these countries, the UDRP cannot be used to protect personal names against abusive registration as domain names, except insofar as the fame or reputation in commerce of the person in question may extend also to a country where unregistered or common law trademark rights are recognized, and which may therefore establish a trademark basis for protection. The second limitation is that personal names are only protected when they are used in commerce because this is the essential basis for a trademark right. The UDRP thus does not provide any protection for personal names that may have a certain reputation but which are not in any way commercialized, such as those of politicians or historical figures. In addition, the Second Process Report noted that there was, outside the trademark area, no international norms protecting personal names, and that, at the national level, there was a diversity of legal theories used in order to establish any legal protection that may exist for personal names. The Second Process Report concluded that, because of this diversity and because of the absence of any international norms outside the trademark area for the

protection of personal names, there should not be any modification of the UDRP in order to create specific protection for personal names.

18. Virtually all delegations at the first and second Special Sessions agreed with the findings of the Second Process Report and there was little, if any, support for providing protection to personal names in the eDNS, although certain delegations, particularly those from countries which do not recognize unregistered marks, were of the view that the issue was linked to the question of whether the UDRP would be expanded to cover trade names *per se*. At the end of the first Special Session, the Chair noted that “[T]he majority of delegations considered that no action was necessary on the protection of personal names, outside the existing UDRP, at this stage.” Likewise, the Report of the second Special Session concludes as follows:

“The Chair noted that the Special Session’s decision was that no action is recommended in this area .”

19. The Assemblies of the Member States of WIPO are invited to take a decision on the recommendation as contained in paragraph 18, above.

Names and Acronyms of International Intergovernmental Organizations (IGOs)

20. Names and acronyms of IGOs are protected by Article 6 *ter* of the Paris Convention and the Agreement on Trade -Related Aspects of Intellectual Property Rights (TRIPS Agreement), as well as by certain provisions in other international conventions which give specific protection to particular names of IGOs or names used internationally, such as Article 53 of the Geneva Convention prohibiting the use of the name “Red Cross.” Article 6 *ter* of the Paris Convention does not confer any automatic protection for the names and acronyms of IGOs, but requires a notification of the identifier for which protection is sought on the part of the IGO in question to WIPO, which notification is then communicated to the WIPO Member States. So far, 102 organizations have made such notifications, and therefore benefit from the protection under Article 6 *ter*. The protection under this provision extends to protection against any registration or use of a name and acronym of an IGO as a trademark, subject to the limitation that a Member State may impose the requirement that such use or registration be misleading or create a misleading association between the trademark in question and the name or acronym of the IGO. Considering that IGOs, under international law, benefit from immunity from national jurisdiction, the provisions of Article 6 *ter* of the Paris Convention are enforced mainly through the industrial property offices around the world to whom the notifications of registration under Article 6 *ter* are sent and it is those offices which ensure that no misleading registrations or uses of those protected names or acronyms as trademarks are permitted. In view of the well established international legal protection for the names and acronyms of IGOs, the Second Process Report recommended that there should be a special administrative procedure, similar to the UDRP, under which it would be possible for an IGO to file a complaint in order to have transferred or cancelled a domain name registration which constitutes a misleading use of a name or acronym of an IGO. The Second Process Report noted, however, that the recommended procedures should be different from the UDRP in light of the immunity of jurisdiction of IGOs. Noting that under the UDRP, any party to a proceeding may commence legal proceedings nationally either before, during or after a complaint has been filed, and that the complainant is required to submit to the jurisdiction of

national courts in certain designated localities, the Second Process Report recommended that those provisions should not apply in respect of complaints that might be brought by IGOs. In this connection, since the publication of the Second Process Report, there have been some further developments as to the possibility of creating an alternative right of recourse for domain name registrants, as explained further below.

21. Discussions at the first Special Session revealed that there was general support among many delegations for the principle of protecting the names and acronyms of IGOs in the DNS, although questions were raised whether the extent of problems encountered was sufficient to warrant the creation of such protection at this stage. The view was also expressed that establishing such special protection would amount to the creation of new international law and that safeguarding the immunities of IGOs, for reasons of due process, should not compromise the right of appeal of a domain name registrant. The Chair concluded as follows: “The majority of delegations expressed interest in accordingsome protection to the names and acronyms of IGOs against abusive registration as domain names, but considered that further work was needed to identify the way in which any such protection might function. The Special Session asked the Secretariat to consult with other IGOs to provide evidence of the extent of problems encountered with the abusive registration of names and acronyms of IGOs as domain names. Such evidence should be presented to the Second Special Session. In addition, the Special Session asked the Secretariat to provide a paper giving details of how any proposed protection of names and acronyms of IGOs would function in practice.”

22. After the first Special Session, the Secretariat liaised, in particular, with the Legal Advisers of the United Nations System, the International Federation of Red Cross and Red Crescent Societies, the International Committee of the Red Cross and the Organisation for Economic Cooperation and Development with a view to the collection of further evidence of the abusive registration of the names and acronyms of IGOs as domain names and the resulting harm for users and the organizations affected. As a result of these initiatives, the Secretariat received three papers from the organizations in question concerning their experience with abusive domain name registrations. The first paper (document SCT/S2/INF/4) by Mr. Hans Corell, Under-Secretary-General for Legal Affairs and Legal Counsel of the United Nations was submitted on behalf of the Legal Advisers 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. The second paper (SCT/S2/INF/3) was a joint submission by the International Federation of Red Cross and Red Crescent Societies and the International Committee of the Red Cross on their experience with abusive domain name registrations. The third paper (SCT/S2/INF/2) was submitted by the Organisation for Economic Cooperation and Development (OECD).

23. Discussions on the topic of the protection of the names and acronyms of IGOs at the second Special Session were based on document SCT/S2/2, prepared by the Secretariat, and the papers of the IGOs referred to above. Discussions were opened by a statement by Mr. Corell on behalf of the Legal Advisers of the United Nations System, the text of which is reproduced in Annex I to the Report of the second Special Session (document SCT/S2/8).

24. Particularly in light of the evidence of problems revealed in the papers prepared by the IGOs and the statement of Mr. Corell, all delegations at the second Special Session, except one, agreed that an administrative mechanism should be established aimed at protecting the names and acronyms of IGOs against their abuse in the DNS. In terms of which conduct would be deemed abusive, discussions centered on the language of Article 6 *ter* of the Paris Convention. On the question of how to safeguard the immunities of IGOs, document SCT/S2/2 proposed that the *de*-consideration of any cases brought under the procedure should be achieved through an agreed recourse to binding arbitration, incorporated into the administrative procedure, it being noted that this was the normal procedure used with respect to disputes involving IGOs. Delegations discussed this proposal and generally found it to be an appropriate solution to the immunities problem, notably because the recourse procedure would take the form of binding arbitration and therefore would benefit from the due progress safeguards provided by the New York Convention on the Recognition and Enforcement of Foreign Arbitral Awards (1958). The Special Session concluded as follows on the topic of the protection of the names and acronyms of IGOs in the DNS:

“Noting, in particular, Article 6 *ter* of the Paris Convention, to which 163 States are party,

“1. The Special Session recommends that the UDRP be modified to provide for complaints to be filed by an international intergovernmental organization (IGO)

“A. on the ground that the registration or use, as a domain name, of the name or abbreviation of the IGO that has been communicated under Article 6 *ter* of the Paris Convention is of a nature

(i) to suggest to the public that a connection exists between the domain name holder and the IGO; or

(ii) to mislead the public as to the existence of a connection between the domain name holder and the IGO; or

“B. on the ground that the registration or use, as a domain name, of a name or abbreviation protected under an international treaty violates the terms of that treaty.

“2. The Special Session further recommends that the UDRP should also be modified, for the purposes of complaints mentioned in paragraph 1, to take account of and respect the privileges and immunities of IGOs in international law. In this respect, IGOs should not be required, in using the UDRP, to submit to the jurisdiction of national courts. However, it should be provided that decisions given in a complaint filed under the modified UDRP by an IGO should be subject, at the request of either party to the dispute, to *de novo* review through binding arbitration.

“3. The Delegation of the United States of America dissociated itself from this recommendation.”

25. An example of a treaty referred to in paragraph 1, B of the above recommendation is the Geneva Convention for the amelioration of the condition of the wounded and sick in armed forces, of August 12, 1949.²

26. *The Assemblies of the Member States of WIPO are invited to take a decision on the recommendation as contained in paragraph 24, above.*

Country Names

27. The Second Process Report noted that a large number of country names have been registered by persons or entities that are residing or located in a country that is different from the country whose name is the subject of registration and that, in most such cases, the registrant is a private person or entity that is unconnected to the government of the country whose name has been registered. The Report further observed that the question of the appropriateness of the registration of country names as domain names is inextricably linked by some governments to what they perceive to be their national sovereign interest. After an examination of both the text and the negotiating history of Article 6 *ter* of the Paris Convention, the Second Process Report concluded that there exists no statutory legal protection at an international level for country names. That being the case, the Report recommended that the question of the protection in the gTLDs of country names be further considered in the appropriate intergovernmental fora, in particular with a view to a discussion on the need for new international rules for the protection of country names.

28. Although it was generally recognized that country names should not be imbued with intellectual property status, most delegations at the first Special Session were of the view that some protection against their abuse in the DNS should be created, while a number of other delegations opposed the creation of such protection. In terms of the modalities of any protection that could be granted, discussions centered on the question of how to determine the correct designation of a country's name. Reference was made in this regard in particular to two instruments, namely the United Nations Terminology Bulletin No. 347/Rev. 1 (the “UN Bulletin”) and the International Standard ISO 3166-1 on Country Codes (the “ISO Standard”). The question also was discussed of whether protection should be granted only in relation to domain names that replicate exactly country names or also in relation to those that constitute misleading variations of such names. At the end of the discussions, the Chair noted that “[m]ost delegations favoured some form of protection for country names against registration by parties unconnected with the constitutional authorities of the country in question. However, it was recognized that many details of any such protection were unclear. It was decided that delegations should be invited to submit comments on [a number of specific

² The first paragraph of Article 53 of this Convention, to which 189 States are party, stipulates as follows: “The use by individuals, societies, firms or companies either public or private, other than those entitled thereto under the present Convention, of the emblem or the designation ‘Red Cross’ or ‘Geneva Cross,’ or any sign or designation constituting an imitation thereof, whatever the object of such use, and irrespective of the date of its adoption, shall be prohibited at all times.”

issues concerning the modalities of the possible protection of country names] to the Secretariat... and that the Secretariat should prepare a paper on the basis of comments received for distribution before the second Special Session and for consideration by that Session.³”

29. On December 19, 2001, the Secretariat transmitted 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 specific issues referred to above. Thirty governments and six organizations submitted comments to the Secretariat. A large majority of these commentators were in favor of protecting country names in the DNS, some arguing that “[t]here is a need to afford protection against the use of domain names which might imply official use or endorsement where no such use or endorsement exists.” A minority of commentators, however, opposed such protection. A detailed overview of the comments received by the Secretariat is contained in document SCT/S2/3.

30. Special protective measures for country names in relation to the .INFO top level domain have in the meantime also been taken by ICANN. Those measures are described in document SCT/S2/4.

31. Discussions on the topic of the protection of country names at the second Special Session were based on document SCT/S2/3. With regard to the principle of introducing protection for country names in the DNS, discussions reflected the balance of views expressed in the written comments received by the Secretariat, with a majority in favor of such protection and a minority against. The delegations which opposed the protection in question, argued that the terms in question are generic and should therefore remain free for use, also as (part of) trademarks, and that any special protection for these terms in the DNS would amount to the creation of new law. The same delegations were of the view that other means were available to redress any abuse that may exist in the DNS in relation to these terms, for instance, through reliance on certain provisions contained in TLD domain name registration agreements, the special protective measure taken by ICANN in relation to .INFO, and the creation of a new official top-level domain for government use. With regard to the modalities of any protection that might be envisaged, discussions at the second Special Session focused on whether the protection should be instituted through an administrative challenge procedure similar to the UDRP or an exclusion mechanism (or a combination of both), whether country names should be identified by reference to the UN Bulletin or the ISO Standard (and whether any names, which do not appear on either of these lists, but by which countries are commonly known, also should be protected), whether protection should be aimed at curbing abusive behavior or whether conflicts between parties acting in good faith also should be covered, the languages in which the protection should be offered, and whether the protection should be granted only in relation to domain names that replicate exactly country names or also to those that are misleadingly similar. In case the protection that might be created was to focus in particular on bad faith behavior, it was also discussed what the appropriate definition of such bad faith conduct might be. The discussion in this connection centered on the proposed language contained in paragraph 35 of document SCT/S2/3. After extensive discussion, the Chair concluded as follows:

³ Paragraph 132 of document SCT/S1/6 lists the questions concerned.

“1. Most delegations favored some form of protection for country names against registration or use by persons unconnected with the constitutional authorities of the country in question.

“2. As regards the details of the protection, delegations supported the following:

(i) A new list of the names of countries should be drawn up using the UN Bulletin and, as necessary, the ISO Standard (it being noted that the latter list includes the names of territories and entities that are not considered to be States in international law and practice). Both the long or formal names and the short names of countries should be included, as well as any additional names by which countries are commonly known and which they notify to the Secretariat before June 30, 2002.

(ii) Protection should cover both the exact names and misleading variations thereof.

(iii) Each country name should be protected in the official language(s) of the country concerned and in the six official languages of the United Nations.

(iv) The protection should be extended to all top-level domains, both gTLDs and ccTLDs.

(v) The protection should be operative against the registration or use of a domain name which is identical or misleadingly similar to a country name, 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.

“3. The Delegations of Australia, Canada and the United States of America dissociated themselves from this recommendation.”

32. Two questions regarding the above recommendation warrant further clarification: (1) which list of country names is to be relied upon for the purpose of providing protection, and (2) how are acquired rights to be dealt with?

Which list of country names is to be relied upon for the purpose of providing protection?

33. With respect to the basis for identifying the country names which would benefit from the protection envisaged, the recommendation of the second Special Session states as follows: “A new list of the names of countries should be drawn up using the UN Bulletin and, as necessary, the ISO Standard (it being noted that the latter list includes the names of territories and entities that are not considered to be States in international law and practice). Both the long or formal names and the short names of countries should be included, as well as any additional names by which countries are commonly known and which they notify to the Secretariat before June 30, 2002.”

34. This language and, in particular the terms “as necessary,” are the result of extensive discussion among delegations at the second Special Session regarding the question of whether the UN Bulletin or the ISO Standard would constitute the appropriate instrument for

identifying country names. It appeared, at this session, that a majority of delegations favored relying solely on the UN Bulletin, while a minority also wished to make use of the ISO Standard. The latter group comprised a number of delegations from countries certain territorial subdivisions of which are listed separately in the ISO Standard, but not in the UN Bulletin. Reliance on the ISO Standard would have the advantage for those countries of achieving protection also for the names of these territorial subdivisions, in addition to the names of the countries themselves.

35. If the General Assembly were to decide to adopt the recommendation of the Special Session regarding country names, it would be important, from the point of view of the practical implementation of such a recommendation, that the General Assembly specify its preference with regard to the exact scope of the protection envisaged. In this regard, a distinction need to be made between two separate, but interrelated issues: on the one hand, the question of which territorial entities should receive protection and, on the other, how the names of the entities which are to receive protection should be identified.

36. On the question of which territorial entities are to be protected, the choice is whether protection should extend only to States or should cover also territorial entities which are not considered States. If the General Assembly were to decide that protection should be restricted to States, it is proposed that membership of the United Nations be regarded as determinative in this connection. If the General Assembly were to decide that protection should extend also to other territorial entities, it would be important that it also decide which of these entities should be covered.

37. If the General Assembly were to decide that the protection envisaged should only extend to States, the question remains which instruments should be relied upon to identify the names of the States in question. Discussions at the first and second Special Sessions have centered on two possible instruments in this connection: the UN Bulletin and the ISO Standard. Considering the various points of view advanced by delegations at these second Special Sessions, the Secretariat, while recognizing that the ISO Standard has a long tradition of use in the Internet community, has come to the view that the more appropriate approach would be to rely on the UN Bulletin. The UN Bulletin is the generally accepted reference document for terminology on country names in the international political and legal arena. Several delegations at these second Special Sessions have emphasized that this was an extremely delicate matter within their country and that it would befit WIPO, as a specialized agency of the United Nations, to comply with the UN Bulletin. If the General Assembly were to decide that the protection should extend to States only, but nonetheless would prefer to rely on the ISO Standard for this purpose, only the names of those entities appearing on the ISO Standard which correspond to States that are members of the United Nations would be retained. If the General Assembly were to decide that the protection envisaged should extend to territorial entities other than States and reliance on the ISO Standard would be considered in this connection, it would be important to note that the ISO Standard lists a number of territorial subdivisions of certain States, while it does not list similar territorial subdivisions of other States. Reliance on the ISO Standard therefore would lead to unequal treatment of States, as some would receive protection for certain of their territorial subdivisions, while others would not.

How to deal with acquired rights?

38. The recommendation of the Special Session states that the protection for country names “should be extended to all top-level domains, both gTLDs and ccTLDs,” implying that existing registrations also could be affected. This raises the question of how acquired rights in those registrations should be treated. As there was relatively little discussion of this issue at the second Special Session, it may be useful to recall certain observations in this connection with a view to facilitating the decision of the General Assembly on the recommendation of the Special Session.

39. Many comments were made by governments on the question of acquired rights as part of the submissions received by the Secretariat in response to its questionnaire referred to in paragraph 29 above. As reflected in document SCT/S2/3, a majority of commentators was of the view that the solution to this problem resides in restricting the application of any protection measures that may be adopted to bad faith registrations. According to this view, no rights could be acquired in a domain name which was registered in bad faith, and, consequently, there would be no injustice if such domain names were to be taken away from the registrant. In the case of good faith registrations, certain commentators proposed the introduction of transition periods during which existing domain name holders could promote alternative web addresses before the transfer of the domain name to the relevant country, or the payment of compensation.

40. Bad faith conduct with respect to country names in the DNS is defined by the recommendation of the second Special Session as “the registration or use of a domain name which is identical or misleadingly similar to a country name, 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.”

41. The Assemblies of the Member States of WIPO are invited to take a decision on the recommendation as contained in paragraph 31, above.

As part of that decision, the Assemblies of the Member States of WIPO also are invited to decide:

(i) whether the protection envisaged should extend to States that are members of the United Nations only or also to other territorial entities and, if the latter, to which such entities; and

(ii) whether the UN Bulletin or the eISO Standard is to be used as the basis for identifying the names to be protected; and

(iii) whether the names by which countries are commonly known and which

have been notified to the Secretariat before June 30, 2002, also should receive protection; and

(iv) whether or not registrants who are found to have acted in bad faith, in accordance with the standard set out in paragraph 40 above, should be allowed to maintain their registrations.

Geographical Indications

42. A number of norms are contained in international treaties, in particular the Paris Convention and the TRIPS Agreement, which protect geographical indications. The Second Process Report pointed to the difficulties perceived with respect to the modification of the UDRP to accommodate the abuse of geographical indications through domain name registrations. These difficulties concern, in particular, the lack of an international mechanism for recognition of what constitutes a geographical indication and the fact that the existing international norms relate to trade and goods, whereas domain name registrations have a greater scope than simply trade and goods. In light of those difficulties, the Second Process Report recommended that no modification be made to the UDRP, at this stage, to permit complaints to be made concerning the registration and use of domain names in violation of the rules relating to the protection of geographical indications.

43. Discussions at the first Special Session reflected a division of views on the appropriateness of creating protection for geographical indications in the DNS. On the one hand, a group of countries noted that there exists a practice of abusing geographical indications in the DNS and was of the view that the international legal framework regarding geographical indications is sufficiently well developed to constitute a legal basis for establishing the protection in question. On the other hand, a group of countries believed that this legal framework is not sufficiently well developed and that subjecting geographical indications to the UDRP would lead panelists to develop undesired new law. Despite extensive discussions at the first Special Session, no progress was made in bridging this divergence of opinion. At the end of the first Special Session, the Chair consequently noted that “[v]iews on the question were divided. Whilst more delegations favored the modification of the UDRP to allow protection for geographical indications than those who opposed such a modification, no agreement had been reached. Accordingly, it was decided to continue discussions on the issue at the second Special Session to examine the many useful questions raised. Any delegation would be free to submit comments or papers for consideration before the second Special Session.”

44. At the second Special Session, delegations essentially reiterated their positions as reflected above. Those delegations in favor of protecting geographical indications in the DNS noted the urgency of the matter and requested that discussions continue in order to find a solution to the problems that are being encountered. Those that did not favor such protection stated that, while they agreed to continue discussing the matter, those discussions should focus first on a number of fundamental issues concerning geographical indications, before turning attention to their protection in the DNS. Finally, the Special Session:

“(i) Decided that it was not timely to take definitive decisions with respect to the protection of geographical indications in the Domain Name System.

“(ii) Noted that some delegations considered that the issue needed urgent attention, while others considered that a number of fundamental questions concerning the protection of geographical indications needed to be resolved before the question of their protection in the Domain Name System could be discussed.

“(iii) Recommend[ed] that the WIPO General Assembly revert this issue to the regular session of the SCT to decide how the issue of the protection of geographical indications in the Domain Name System be dealt with.”

45. The Assemblies of the Member States of WIPO are invited to take a decision on the recommendation as contained in paragraph 44, above.

Other Matters

46. The First Process Report emphasized the importance of the accuracy of registrant contact information contained in the WHOIS databases for the purpose of enforcing intellectual property rights in the Domain Name System.⁴ In particular, the Report recommended that “that the domain name registration agreement contain a term making the provision of inaccurate or unreliable information by the domain name holder, or the failure to update information, a material breach of the registration agreement and a basis for cancellation of the registration by the registration authority.”⁵ The same Report further recommended that “a take-down procedure be implemented whereby, upon service of a notification by an interested third party . . . , and upon independent verification of the unreliability of the contact details in question, the registrar would be required to cancel the corresponding domain name registration.”⁶ The importance of WHOIS databases for protecting intellectual property in the DNS was again emphasized in the Second Process Report.⁷

47. While the registration agreements which ICANN has required registrars to adopt in the gTLDs contain provisions obliging domain name registrants to provide accurate contact details for WHOIS purposes, it appears that insufficient attention has been devoted to compliance with such provisions. The problems which such lack of compliance entail are illustrated in the paper which was prepared by the OECD for consideration of the second Special Session (document SCT/S2/INF/2). Delegations at the second Special Session generally expressed concern regarding this situation and adopted the following statement in connection therewith:

⁴ See paragraphs 58 through 90 of the First Process Report.

⁵ See paragraph 119 of the First Process Report.

⁶ See paragraph 123 of the First Process Report.

⁷ See paragraphs 321 through 345 of the Second Process Report.

“With respect to other available means of addressing abusive domain name registrations, the Meeting supported the remarks made by the OECD..., and made by other delegations, in relation to the accuracy and integrity of WHOIS databases.”

48. The Assemblies of the Member States of WIPO are invited to take a decision on whether to support the statement as contained in paragraph 47, above.

A Possible Amendment of the UDRP

49. To illustrate the principal changes that would be required to broaden the scope of the UDRP in order that it may function as a vehicle for the protection of the names and acronyms of IGOs and the names of countries, as recommended by the Special Session, the Secretariat attaches to this document, as an Annex, are -draft of the UDRP incorporating a number of new provisions aimed at providing the protection in question (changes compared to the original version are underlined).

50. The Assemblies of the Member States of WIPO are invited to note and comment on the proposed possible amendment to the UDRP, as reflected in the Annex.

[Annex follows]

ANNEX

Uniform Domain Name Dispute Resolution Policy

(As Approved by ICANN on October 24, 1999)

1. *Purpose.* This Uniform Domain Name Dispute Resolution Policy (the "Policy") has been adopted by the Internet Corporation for Assigned Names and Numbers ("ICANN"), is incorporated by reference into your Registration Agreement, and sets forth the terms and conditions in connection with a dispute between you and any party other than us (the registrar) over the registration and use of an Internet domain name registered by you. Proceedings under Paragraph 4 of this Policy will be conducted according to the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules of Procedure"), which are available at www.icann.org/udrp/udrp-rules-24oct99.htm, and these selected administrative-dispute-resolution service provider's supplemental rules.

2. *Your Representations.* By applying to register a domain name, or by asking us to maintain or renew a domain name registration, you hereby represent and warrant to us that (a) the statements that you made in your Registration Agreement are complete and accurate; (b) to your knowledge, the registration of the domain name will not infringe upon or otherwise violate the rights of any third party; (c) you are not registering the domain name for an unlawful purpose; and (d) you will not knowingly use the domain name in violation of any applicable laws or regulations. It is your responsibility to determine whether your domain name registration infringes or violates someone else's rights.

3. *Cancellations, Transfers, and Changes.* We will cancel, transfer or otherwise make changes to domain name registrations under the following circumstances:

- (a) subject to the provisions of Paragraph 8, our receipt of written or appropriate electronic instructions from you or your authorized agent to take such action;
- (b) our receipt of an order from a court or arbitral tribunal, in each case of competent jurisdiction, requiring such action; and/or
- (c) our receipt of a decision of an Administrative Panel requiring such action in any administrative proceeding to which you were a party and which was conducted under this Policy or a later version of this Policy adopted by ICANN. (See Paragraph 4(i) and (k) below).

We may also cancel, transfer or otherwise make changes to a domain name registration in accordance with the terms of your Registration Agreement or other legal requirements.

4. *Mandatory Administrative Proceeding*

This Paragraph sets forth the type of disputes for which you are required to submit to a mandatory administrative proceeding. These proceedings will be conducted before one of the administrative-dispute-resolution service providers listed at www.icann.org/udrp/approved-providers.htm (each, a "Provider").

(a) *Applicable Disputes* You are required to submit to a mandatory administrative proceeding in the event that a third party (a "complainant") asserts to the applicable Provider, in compliance with the Rules of Procedure,

1. that

(i) your domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and

(ii) you have no rights or legitimate interests in respect of the domain name; and

(iii) your domain name has been registered and is being used in bad faith;

or

2. that your registration or use, as a domain name

(i) of the name or abbreviation of the complainant, which is an international intergovernmental organization that has communicated its name or abbreviation under Article 6ter of the Paris Convention, is of a nature to suggest to the public that a connection exists between you and the complainant, or to mislead the public as to the existence of a connection between you and the complainant; or

(ii) of the name or abbreviation of the complainant, which is protected under an international treaty, violates the terms of that treaty;

or

3. that

(i) your domain name is identical or confusingly similar to a name of a country appearing on [pre-determined list of country names in the official languages of the countries concerned and in the six official languages of the United Nations] of which the complainant is the Government; and

(ii) you have no rights or legitimate interests in respect of the domain name; and

(iii) the domain name is of a nature that is likely to mislead users into believing that there is an association between you and the constitutional authorities of the country in question.

In the administrative proceeding, the complainant must prove that each of the elements identified in Paragraph 4(a)(1), (2) or (3) a represent.

(b) *Evidence of Registration and Use in Bad Faith*. For the purposes of Paragraph 4(a)(1)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other on-line location, by creating a likelihood of confusion with the complainant's mark to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location.

(c) *How to Demonstrate Your Rights and Legitimate Interests in the Domain Name in Responding to a Complaint*. When you receive a complaint, you should refer to Paragraph 5 of the Rules of Procedure in determining how your response should be prepared. Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of Paragraph 4(a)(1)(ii) and 4(a)(3)(ii):

(i) before any notice to you of the dispute, your use of, or demonstrable preparation to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or

(ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

(d) *Selection of Provider*. The complainant shall select the Provider from among those approved by ICANN by submitting the complaint to that Provider. The selected Provider will administer the proceeding, except in cases of consolidation as described in Paragraph 4(f).

(e) *Initiation of Proceeding and Process and Appointment of Administrative Panel*. The Rules of Procedure state the process for initiating and conducting a proceeding and for appointing the panel that will decide the dispute (the "Administrative Panel").

(f) *Consolidation*. In the event of multiple disputes between you and a complainant, either you or the complainant may petition to consolidate the disputes before a single Administrative Panel. This petition shall be made to the first Administrative Panel appointed to hear a pending dispute between the parties. This Administrative Panel may consolidate before it any or all such disputes in its sole discretion, provided that the disputes being consolidated are governed by this Policy or a later version of this Policy adopted by ICANN.

(g) *Fees*. All fees charged by a Provider in connection with any dispute before an Administrative Panel pursuant to this Policy shall be paid by the complainant, except in cases where you elect to expand the Administrative Panel from one to three panelists as provided in Paragraph 5(b)(iv) of the Rules of Procedure, in which case all fees will be split evenly by you and the complainant.

(h) *Our Involvement in Administrative Proceedings*. We do not, and will not, participate in the administration or conduct of any proceeding before an Administrative Panel. In addition, we will not be liable as a result of any decisions rendered by the Administrative Panel.

(i) *Remedies*. The remedies available to a complainant pursuant to any proceeding before an Administrative Panel shall be limited to requiring the cancellation of your domain name or the transfer of your domain name registration to the complainant.

(j) *Notification and Publication*. The Provider shall notify you of any decision made by an Administrative Panel with respect to a domain name you have registered with us. All decisions under this Policy will be published in full over the Internet, except when an Administrative Panel determines in an exceptional case to redact portions of its decision.

(k) *Availability of Court Proceedings*. Except in the case of a complainant which is an international intergovernmental organization benefiting from immunity from

jurisdiction under international law, the mandatory administrative proceeding requirements set forth in Paragraph 4 shall not prevent either you or the complainant from submitting the dispute to a court of competent jurisdiction for independent resolution before such mandatory administrative proceeding is commenced or after such proceeding is concluded. If an Administrative Panel decides that your domain name registration should be canceled or transferred, we will wait ten (10) business days (as observed in the location of our principal office) after we are informed by the applicable Provider of the Administrative Panel's decision before implementing that decision. We will then implement the decision unless we have received from you during that ten (10) business day period official documentation (such as a copy of a complaint, file-stamped by the clerk of the court) that you have commenced a lawsuit against the complainant in a jurisdiction to which the complainant has submitted under Paragraph 3(b)(xiii) of the Rules of Procedure, or, in the case of a complainant which is an international intergovernmental organization benefiting from immunity from jurisdiction under international law, that you have commenced arbitration proceedings against the complainant in accordance with [relevant paragraph of the Rules of Procedure]. (In general, the jurisdiction to which the complainant has submitted under Paragraph 3(b)(xiii) of the Rules of Procedure is either the location of our principal office or of your address as shown in our WHOIS database. See Paragraphs 1 and 3(b)(xiii) of the Rules of Procedure for details). If we receive such documentation within the ten (10) business day period, we will not implement the Administrative Panel's decision, and we will take no further action, until we receive (i) evidence satisfactory to us of a resolution between the parties; (ii) evidence satisfactory to us that your lawsuit or the arbitration has been dismissed or withdrawn; or (iii) a copy of a court order or arbitration decision dismissing your complaint or ordering that you do not have the right to continue to use your domain name.

5. *All Other Disputes and Litigation*. All other disputes between you and any party other than us regarding your domain name registration that are not brought pursuant to the mandatory administrative proceeding provisions of Paragraph 4 shall be resolved between you and such other party through any court, arbitration or other proceeding that may be available.

6. *Our Involvement in Disputes*. We will not participate in any way in any dispute between you and any party other than us regarding the registration and use of your domain name. You shall not name us as a party or otherwise include us in any such proceeding. In the event that we are named as a party in any such proceeding, we reserve the right to raise any and all defenses deemed appropriate, and to take any other action necessary to defend ourselves.

7. *Maintaining the Status Quo*. We will not cancel, transfer, activate, deactivate, or otherwise change the status of any domain name registration under this Policy except as provided in Paragraph 3 above.

8. *Transfers During a Dispute*

(a) *Transfers of a Domain Name to a New Holder*. You may not transfer your domain name registration to another holder (i) during a pending administrative proceeding brought pursuant to Paragraph 4 or for a period of fifteen (15)

business days (as observed in the location of your principal place of business) after such proceeding is concluded; or (ii) during a pending court proceeding or arbitration commenced regarding your domain name unless the party to whom the domain name registration is being transferred agrees, in writing, to be bound by the decision of the court or arbitrator. We reserve the right to cancel any transfer of a domain name registration to another holder that is made in violation of this subparagraph.

(b) *Changing Registrars*. You may not transfer your domain name registration to another registrar during a pending administrative proceeding brought pursuant to Paragraph 4 or for a period of fifteen (15) business days (as observed in the location of your principal place of business) after such proceeding is concluded. You may transfer administration of your domain name registration to another registrar during a pending court action or arbitration, provided that the domain name you have registered with us shall continue to be subject to the proceedings commenced against you in accordance with the terms of this Policy. In the event that you transfer a domain name registration to us during the pendency of a court action or arbitration, such dispute shall remain subject to the domain name dispute policy of the registrar from which the domain name registration was transferred.

9. *Policy Modifications*. We reserve the right to modify this Policy at any time with the permission of ICANN. We will post our revised Policy at <URL> at least thirty (30) calendar days before it becomes effective. Unless this Policy has already been invoked by the submission of a complaint to a Provider, in which event the version of the Policy in effect at the time it was invoked will apply to you until the dispute is over, all such changes will be binding upon you with respect to any domain name registration dispute, whether the dispute arose before, on or after the effective date of our change. In the event that you object to a change in this Policy, your sole remedy is to cancel your domain name registration with us, provided that you will not be entitled to a refund of any fees you paid to us. There is no appeal. This Policy will apply to you until you cancel your domain name registration.

[End of Annex and of document]

WIPO



WO/GA/28/7

ORIGINAL: English

DATE: October 1, 2002

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

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WIPO GENERAL ASSEMBLY

Twenty-Eighth (13th Extraordinary) Session
Geneva, September 23 to October 1, 2002

REPORT

adopted by the Assembly

1. The General Assembly was concerned with the following items of the Consolidated Agenda (document A/37/1 Prov.3): 1, 2, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 23 and 24.
2. The report on the said items, with the exception of items 6, 10, 11, 13 and 14, is contained in the General Report (document A/37/14).
3. The reports on items 6, 10, 11, 13 and 14, are contained in the present document.
4. Mr. Bernard Kessedjian (France) was elected Chair of the General Assembly, and presided over the meeting of the General Assembly.

ITEM 6 OF THE CONSOLIDATED AGENDA:

COMPOSITION OF THE PROGRAM AND BUDGET COMMITTEE

5. Discussions were based on document WO/GA/28/1.
6. The Chair of the General Assembly noted that further to informal consultations among the regional groups and taking into consideration the need expressed by a number of delegations to improve the geographical representation in the Program and Budget Committee, the following proposal on the composition of the Committee was made to the WIPO General Assembly: Algeria, Argentina, Brazil, Bulgaria, Canada, Chile, China, Czech Republic, Ecuador, Egypt, France, Germany, Hungary, India, Japan, Mexico, Morocco, Netherlands, Nigeria, Oman, Pakistan, Philippines, Republic of Korea, Russian Federation, Senegal, Slovakia, South Africa, Spain, Sri Lanka, Switzerland (*ex-officio*), Ukraine, United Kingdom, United States of America, Venezuela and Yugoslavia (35).
7. The Delegation of Mexico noted the increase in the Committee membership from 33 to 35 Member States and enquired as to which regional groups received the additional two seats.
8. The Chair indicated that the additional seats were given to the Asian Group and the Group of Central European and Baltic States following consultations among regional groups.
9. The Delegation of Mexico, while acknowledging a possible geographical imbalance in the Committee, requested for an opportunity to have additional consultations on the composition of the Committee before the next Assemblies, or at the latest during the next Assemblies.
10. The Delegation of Barbados associated itself with the statement made by the Delegation of Mexico and wished to see the matter resolved as soon as possible to the satisfaction of all parties. Speaking on behalf of GRULAC, the Delegation of Barbados stressed the importance it attaches to decisions within WIPO being reached in an open and transparent manner. In this regard, GRULAC wished to emphasize the role of the General Assembly as WIPO's supreme decision-making authority, and to point out that the right of individual Member States to participate fully in decisions on matters under consideration at the General Assembly should in no way be considered to be pre-empted by prior consultations. GRULAC had joined in the consensus on this matter in a spirit of compromise and with a view to ensuring a successful conclusion to this year's Assemblies and looks forward to a full and balanced discussion of the matter at next year's Assemblies. GRULAC trusts that Member States will be able to agree on a more equitable distribution of seats within the Program and Budget Committee.
11. The Delegation of Belarus, on behalf of the Group of Central Asian, Caucasus and Eastern European Countries, stated that they were deeply concerned not only by the redistribution of seats on the Program and Budget Committee, as a result of which, for example, one group of 15 countries received five seats and another, of 12 countries, only two, but also by the self-evident fact that the distribution had been done without the requisite transparency and consultations with interested regional groups, which was contrary to the previous common practice of WIPO. The Group noted that the principle of equitable geographical distribution was and remains one of the foundations of the formation of United Nations bodies, and that principle should not be neglected. They were, however, ready to join the consensus regarding the proposed composition of the Program and Budget Committee, but

only on the understanding that the consensus is of a temporary nature, relates to the composition of the Committee only for 2002-2003, and will be reviewed next year.

12. In response to a question from the Delegation of Argentina, the Chair elaborated on the number of seats by regional groups under the current proposal as follows: African Group (6), Asian Group (6), Group of Central European and Baltic States (5), Group of Central Asian, Caucasus and Eastern European Countries (2), Group B countries, including Switzerland (*ex-officio*) (9), GRULAC (6), China (1).

13. The Chair noted the concerns expressed by some members of the regional Groups with regards to the need to have adequate geographical representation in the Program and Budget Committee. He recalled the statements made during the 1998 and the 2001 Assemblies meetings on the matter. The Chair also recalled the current requests of the African Group as well as the Group of Central European and Baltic States to have one additional representation each in the Committee in view of the size of their country members. Given that these were not taken into consideration, the Chair, while emphasizing that this proposed arrangement was provisional, noted the following: first, that there were concerns expressed by some regional groups with regards to geographical representation, second that consultations would continue to be made and finally, that this matter would be included as part of the Agenda for the 2003 meetings of the Assemblies.

14. The General Assembly approved the composition of the Program and Budget Committee, as described in paragraph 6 above, for the period September 2002 to September 2003, and decided that the membership and composition of the Program and Budget Committee would be reviewed again in September 2003.

ITEM 10 OF THE CONSOLIDATED AGENDA:

DIPLOMATIC CONFERENCE ON THE PROTECTION OF AUDIOVISUAL PERFORMANCES

15. Discussion on the item was based on document WO/GA/28/5.

16. In introducing the subject matter, the Secretariat recalled that the document WO/GA/28/5 contained a proposal of the Director General to resume international discussions on the protection of audiovisual performances. In view of the importance of the issue and the need to ensure full transparency, an *ad hoc* informal meeting, which would be open to all Member States and interested intergovernmental and non-governmental organizations would be called. Because of the time which had passed since December 2000, that meeting was envisaged to take place in the first half of 2003. Such a meeting would be convened after a further assessment of the situation by the International Bureau. There would also be consultations with the regional group coordinators based in Geneva as to organizational, procedural and other matters. It was also proposed that the issue of the Diplomatic Conference on the Protection of Audiovisual Performances remain on the agenda of the WIPO General Assembly in its session of September 2003.

17. The Chair recalled that, at its meeting in September 2001, the General Assembly had decided that the item remain on the agenda of the meeting of the Assembly in 2002. Now, the calling of an informal *ad hoc* meeting was proposed, aiming at the resumption of international

discussions, with due regard to transparency. If it was decided to proceed further, a concrete agenda could be identified with the eventual possibility of reconvening the Diplomatic Conference.

18. The Delegation of Denmark, speaking on behalf of the European Community and its Member States, reiterated its continued commitment to a meaningful updating of the Rome Convention as regards the protection of audiovisual performances, to providing audiovisual performers with the international protection they deserve, and to settling finally the unfinished business from the 1996 Diplomatic Conference. Some progress had been made on that issue during the Diplomatic Conference in December 2000. It should be recognized, however, that the Conference had faced a rather difficult challenge in view of the different concepts at stake. Those differences could not be bridged in the run-up to the Diplomatic Conference of 2000, nor during the intensive negotiations at the latter Conference, or during other contacts over the last two years. Because of those circumstances, and their strong commitment, the European Community and its Member States welcomed the proposal of the Director General as a useful basis for assessing the future prospects of work and for giving a new impetus to the international discussions on that important issue. The European Community and its Member States had noted with interest that the Director General, in paragraph 4 of document WO/GA/28/5, proposed that the International Bureau assess the situation in the coming months with a view to possibly calling an *ad hoc* informal meeting in the first half of 2003. That appeared to be a timely initiative and worthwhile exploring further. The European Community and its Member States, like other delegations, had seen the document and the suggestions contained therein only very recently. In order to do it full justice and to explore its potential further, opportunities should be given to consult thoroughly with other delegations and with the International Bureau on, in particular, the appropriateness, timing, duration and agenda of such a meeting. They were determined to contribute in the most constructive manner to those consultations. Consequently, the Delegation was of the view that it would be premature to take any final decision at the present Assembly. Whatever the outcome of the consultations, it would be important to stress two considerations. First, given the complexity of the issues and keeping in mind the need to safeguard transparency, the European Community and its Member States shared the conclusion of the Director General that any informal meeting should, in any event, be open to all Member States and interested intergovernmental and non-governmental organizations. Second, the European Community and its Member States took note of the proposal in paragraph 5 of document WO/GA/28/5 that the issue of the Diplomatic Conference on the Protection of Audiovisual Performances remained on the agenda of the WIPO General Assembly for its session in September 2003.

19. The Delegation of Japan stated that, during the two years since the Diplomatic Conference of 2000, relevant parties, including the International Bureau of WIPO, had tried to find ways for the possible adoption of a treaty on audiovisual performances. There seemed to be, however, little progress on that issue and it was concerned that the momentum for the conclusion of a treaty could be lost, if the situation remained unchanged. In that respect, the proposal made by the Director General to hold an *ad hoc* informal meeting would be useful to maintain the momentum. Its Government fully supported the proposal and the procedure as suggested by the Director General, and hoped that that informal meeting would be the first international step towards the early reconvening of the Diplomatic Conference. It further stated that it would be important to reaffirm agreement on the articles on which consensus had been reached at the 2000 Diplomatic Conference, and discussions should not be reopened on those issues. In addition, the Delegation was of the view that attention should be paid to the balance among the related rights holders, namely, phonogram producers, performers and broadcasting organizations, which had been maintained since the establishment of the Rome

Convention. If the treaty on audiovisual performances was not adopted, that balance could be jeopardized.

20. The Delegation of Barbados, speaking on behalf of the Group of Latin American and Caribbean Countries (GRULAC), recalled that the group had participated actively in the proceedings of the Diplomatic Conference in 2000 and that significant progress had been made then towards the adoption of an international instrument. It simply remained to complete the work of that Diplomatic Conference on the one outstanding Article. In that regard, the group supported the suggestion that informal consultations on the reconvening of the Diplomatic Conference continue and that the matter be retained on the agenda of the next Assembly.

21. The Delegation of Algeria, speaking on behalf of the Group of African Countries, supported the proposed consultations on audiovisual performances with the strategic objective of preparing for the reconvening of the Diplomatic Conference. Such consultations should follow a work program that reaffirmed the issues on which agreement had already been reached in the Diplomatic Conference of 2000. The consultations should aim at protecting the economic and moral rights of performers at national and international levels, taking into account the evolution of current technologies.

22. The Delegation of Algeria, speaking on behalf of its own country, reiterated the importance its country attached to the reconvening of the Diplomatic Conference. It recalled that interest in such an international treaty had been shown at the regional consultation meeting held in Algiers before the Diplomatic Conference of 2000, as well as at the Conference itself. The Delegation fully supported the proposal by the Director General that an informal meeting be called so that, eventually, the Diplomatic Conference could be reconvened to adopt an international instrument on the issue.

23. The Delegation of Ghana congratulated the Chair for working so diligently, as well as the Vice-Chairs. The Delegation paid tribute to Dr. Kamil Idris for working so tirelessly with his excellent team to achieve so much within so short a time. Its country considered the protection of audiovisual performances a very important issue. Ghana was grateful for paragraphs 4 and 5 of the document under discussion, which were also welcome. The Delegation said that its Government was ready to participate in the meeting convened for the resolution of outstanding issues on the international protection of audiovisual performances.

24. The Delegation of Kyrgyzstan supported the proposals of the Director General that an informal meeting be convened in the first half of 2003 and that the issue be discussed in the next Assembly. It also agreed that the Diplomatic Conference should be reconvened. The issue of audiovisual performances was important in the development of the information society. The 2000 Diplomatic Conference, despite its heavily charged agenda, had reached agreement on a number of issues. The Delegation stated that it was prepared to participate in resolving the remaining issues.

25. The Delegation of Mexico supported the statement made by the Delegation of Barbados on behalf of GRULAC. The Delegation recalled that since 1992, when discussions started on that item, its country had accorded great priority to the protection of performers. Consequently, it supported the consultations leading to an *ad hoc* informal meeting, with a view to overcoming the remaining differences. Moreover, it was also of the view that the issue should remain on the agenda of the 2003 session of the General Assembly. The

Delegation would be an active participant in all such consultations in order to achieve a satisfactory solution.

26. The Delegation of Belarus, speaking on behalf of the Group of Eastern European, Caucasus and Central Asian Countries, expressed its full support to the proposals of the Director General, contained in document WO/GA/28/5, given the great importance of the matter for all countries, and in particular for the countries of its own group, and the fact that a great deal of work had already been done by all delegations that participated in the Diplomatic Conference of December 2000, with only a few issues remaining unsolved.

27. The Delegation of Norway expressed its commitment to updating the international protection of broadcasters and exploring new items for discussion in the Standing Committee on Copyright and Related Rights. However, it was most concerned by the lack of an appropriate basis for the protection of audiovisual performances. Performers were an important part of the cultural environment and the use of performances had become more international and of greater economic relevance. The justification for the protection of audiovisual performers was as strong and undeniable, as was that for protection of authors and musical performers. It was therefore necessary to continue working to find solutions, in order to reconvene the Diplomatic Conference as soon as possible. The Delegation fully supported the proposals made by the Director General.

28. The Delegation of South Africa supported the proposals of the Director General. However there were other important issues, such as the protection of traditional knowledge and folklore, which also merited the attention of the General Assembly, noting that the Intergovernmental Committee had not submitted an interim report on its work to the General Assembly. The Delegation was of the view that, as an interrelated subject it should not be treated in isolation. The work in the said Committee and that on the audiovisual question should be intertwined.

29. The Director General, in response to the concern expressed by the Delegation of South Africa, stated that the issue of audiovisual performances had been the subject of a Diplomatic Conference. The work of that Diplomatic Conference had to be completed. The issue of traditional knowledge, folklore and genetic resources had received a tremendous amount of attention from Member States and the International Bureau, and it was for that reason, an Intergovernmental Committee had been established. That Committee would meet next December and it would decide on whether or not to submit a progress report to the General Assembly, which the International Bureau would be glad to prepare.

30. The Delegation of South Africa, while agreeing with the points made by the Director General, reiterated that one should not overlook issues which were intertwined.

31. The Delegation of the Republic of Armenia stated that the issue of audiovisual performances had great importance and it, therefore, encouraged that informal consultations be held so that an informal meeting could take place as soon as possible. It also supported the need to retain the issue of the Diplomatic Conference on the Protection of Audiovisual Performances on the agenda of the WIPO General Assembly in its session in September 2003.

32. The Delegation of the United States of America recalled, and appreciated, the hard work of delegations, the Director General and the International Bureau in December 2000 for the purpose of concluding a Treaty for the Protection of Audiovisual Performances. That treaty continued to be of great importance to its Government as well as to performers and producers.

It found the proposal for consultations to be interesting and potentially very important, but having only just received the document, it needed to reflect on the process outlined therein. The Delegation called attention to subsequent events reflected in document IAVP/DC/39 of the Diplomatic Conference, regarding the declaration of the Chairman of Main Committee I which was reflected in paragraph 423 of document IAVP/DC/37, concerning royalties collected for performances, and stated its concern that the information reflected in those documents might cast some doubt on the continuing solidity of the consensus regarding the articles that had been agreed to. The Delegation was interested in participating in consultations with others delegations and with the International Bureau, and remained committed to participating in any process that might move the debate forward to ensure protection for that important group of related rights holders and copyright owners.

33. The Delegation of Latvia, speaking on behalf of the Group of Central European and Baltic States, stated that it considered the proposal of the Director General to hold an informal meeting in the first half of 2003 as reasonable. The 2000 Diplomatic Conference had been close to reaching an agreement, but as much time had since passed, it was necessary to exchange views on how to proceed. The Delegation also supported the proposal contained in paragraph 5 of the document. It expressed its hope that the present initiative would prevent the loss of momentum and help resolve the remaining differences.

34. The Delegation of Sudan endorsed the statement made by the Delegation of Algeria on behalf of the African Group. It recalled the progress made during the 2000 Diplomatic Conference, when a provisional agreement was reached on 19 articles, with only one outstanding article left unresolved. The Delegation supported the proposals contained in paragraphs 4 and 5 of the document. The informal meeting in the first half of 2003 should include all countries and all interested parties.

35. The Delegation of Canada joined the delegations that had previously supported the proposals made by the Director General. Ideally, it was of the opinion that the *ad hoc* meeting should take place adjacent to a session of the Standing Committee of Copyright and Related Rights.

36. The Delegation of India, speaking on behalf of the Asian Group, noted that the Diplomatic Conference on the Protection of Audiovisual Performances convened in December 2000 had not reached an agreement on outstanding issues. At its last session in September 2001, the Assembly had decided that contacts and discussions should continue to overcome the differences. The International Bureau, in paragraph 3 of document WO/GA/28/5, had stated that there had been no significant change in the positions since last year, in spite of some contacts between interested parties. In view of the importance of the issue, it requested the International Bureau to assess the situation in the coming months with a view to possibly holding *ad hoc* informal consultations in the first half of 2003, and report to the General Assembly at its next session.

37. On behalf of its own country, the Delegation of India reiterated that, in view of the complexity of the issue, there was a need to hold wide-scale consultations at the informal level, both regional and inter-regional. It therefore supported the proposal of the Director General that consultations should continue at the informal level towards evolving consensus on the unresolved issues.

38. The Delegation of Peru endorsed the statement made by the Delegation of Barbados on behalf of GRULAC. It expressed its full support for reconvening the Diplomatic Conference as soon as possible.

39. The Delegation of Kenya expressed its full support for the statement made by the Delegation of Algeria on behalf of the African Group. The protection of audiovisual performances was of outmost importance for its country and it was necessary to quickly overcome the current stalemate. It gave full support to the proposals contained in paragraphs 4 and 5 of the document.

40. The Delegation of Denmark, speaking on behalf of the European Community and its Member States, referred to the declaration contained in document IAVP/DC/39, to which the Delegation of the United States of America had made reference. It had been submitted in reaction to a declaration by the Chairman of Main Committee I of the Diplomatic Conference. The Delegation recalled that, during that particular meeting of Main Committee I of the Diplomatic Conference on December 20, 2000, the floor had not been opened for substantive discussions, and that the Chairman's declaration represented only his personal views in connection with a proposal by the Delegation of the United States of America on Article 4 of the draft treaty. Consequently, there had been no other possibility but to submit a declaration in writing which reiterated that the declaration of the Chairman of Main Committee I was of a unilateral nature and in no way implied a commitment for the members of Main Committee I or for the future contracting parties to the treaty.

41. The Chair concluded that there had been a practically unanimous support for the process proposed by the Director General to resume the work that could lead to the reconvening of the Diplomatic Conference. Everyone had underlined the importance of the subject and the importance of arriving, to the extent possible, at an international agreement on the matter. All delegations had expressed the will to see progress on the issue. The proposal set forth in document WO/GA/28/5 was a working method and procedure rather than of formal structures. He therefore proposed the following be decided upon:

(i) the Director General and the International Bureau would conduct informal consultations in the first quarter of 2003 with all interested parties to explore the possibilities of convening the informal meeting;

(ii) if those consultations proved to be successful, that an *ad hoc* informal meeting working group would be convened with the participation of all interested Member States and intergovernmental and non-governmental organizations to discuss exhaustively and in full transparency the renewal of the dialogue on protection of audiovisual performances;

(iii) a report would be made to the next session of the General Assembly. Furthermore, the issue would remain on the agenda of the General Assembly.

42. The General Assembly unanimously adopted the decision set forth by the Chair in paragraph 41, above.

ITEM 11 OF THE CONSOLIDATED AGENDA:

REPORT ON THE POLICY ADVISORY COMMISSION (PAC)

43. Discussion was based on document WO/GA/28/2.
44. At the invitation of the Chair Mr. Henry Olsson, Special Government Adviser, Ministry of Justice, Sweden, (member of the Policy Advisory Commission (PAC)) delivered the Report of the third meeting of the PAC.
45. Mr. Olsson recalled that the PAC had been initiated and introduced in the Program and Budget of WIPO for two main purposes; one was to advise the Director General on intellectual property policy issues, without prejudice to the Member States' policy-making authority, and the other was to raise awareness about intellectual property among political leaders and persons with political responsibilities. The Commission is composed of intellectual property experts, political leaders, ambassadors and high officials from Member States. The first Chairman of the Commission had been His Royal Highness, Prince Hassan bin Talal of Jordan.
46. The PAC held its most recent plenary meeting in Geneva, on October 11, 2001. The Chairman of that Meeting was His Excellency Guido de Marco, President of the Republic of Malta. Also participating in the meeting were several high level personalities, including the President (of Romania) and former Presidents (of Bulgaria, Moldova and the Philippines), and one former Secretary General of the United Nations. In addition, several ministers, ambassadors and other high-level officials took part.
47. There were two substantive issues on the agenda, namely the Agenda for Development of the International Patent System, and Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore.
48. In an in-depth discussion on the first topic, it was stated that the Commission supported and praised the initiative to present the issues for public discussion, with regard to both the substance and the timeliness of the project. The Commission had taken note that the patent system was in what might be termed a "crisis" in terms of the ever-increasing workload caused by, among other things, duplication of work.
49. The Commission also discussed general concerns, such as how much harmonization was possible, how the interests of the various stakeholders involved could be reconciled, and how the intellectual property system could be made affordable to all creative persons and entities. Emphasis was placed on the need to ensure that the system would operate to the maximum benefit of all participants, and especially that developing countries could effectively use it in their development efforts. At the end of its deliberations on this issue, the Commission expressed its strong support for the WIPO Patent Agenda and WIPO's efforts to create the political momentum worldwide so as to achieve its objectives.
50. In the discussion on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore, Mr. Olsson said that members of the Commission had stressed that this was a field of huge economic, social and cultural impact. This implied a critical need to enlarge the general debate and find solutions, and in this respect WIPO's initiative to create the Intergovernmental Committee (IGC) was highly acknowledged. Members discussed such issues as the respective advantages of taking a step-by-step approach or, alternatively, trying

to seek a rapid yet comprehensive solution. Overall, it was felt that WIPO should not attempt to force a one-size-fits-all solution, and it was suggested on the one hand that WIPO should help raise awareness of the importance of the matter, and on the other that the Intergovernmental Committee might wish to explore the soft-law approach.

51. At the October 11, 2001, meeting, a general discussion about WIPO and its role in a changing world also took place, and in the course of this it was affirmed that WIPO has the mandate, expertise, public acceptability, credibility and competence to play a leading role in the development of the intellectual property system in the new environment. The Commission particularly recognized and commended the considerable achievements of the Director General, Dr. Idris, in this respect.

52. Finally, the Commission had recommended that the WIPO Patent Agenda should be presented to political leaders at the highest possible level, and that in the genetic resources, traditional knowledge and folklore field, where the political will to move ahead already existed, emphasis should be placed on mobilizing the relevant technical expertise.

53. It was suggested that future discussions within the Policy Advisory Commission could explore the topics of enforcement of IPRs, WIPO's role in helping its Member States to meet the challenges of globalization, and the possible role of WIPO in the valuation of IPRs in the process of privatization.

54. The Chairman thanked Mr. Olsson for his detailed and precise presentation.

55. The representative of Latvia, speaking on behalf of the Regional Group of the Central European and Baltic States, stated that the Group had followed the work of the PAC with interest. The Group believed that the Commission had produced important output, including the World Intellectual Property Declaration, and it looked forward to the contribution of the PAC in the fields of enforcement, development of the intellectual property system in the context of globalization, and other emerging issues. The Group hoped that the Commission would continue to provide substantive input in the future, and further hoped that it would receive more information about the activities of the Task Force of the PAC, and also about the contributions of other high-level consultative bodies in WIPO.

56. The WIPO General Assembly noted the contents of document WO/GA/28/2 and the contents of the annex to that document.

ITEM 13 OF THE CONSOLIDATED AGENDA:

INTERNET DOMAIN NAMES

57. Discussions were based on documents WO/GA/28/3, WO/GA/28/3 Add. and WO/GA/28/3 Add.2.

58. The Secretariat stated that the background to the issues discussed in the above documents was the Uniform Domain Name Dispute Resolution Policy, a procedure which offers protection to trademarks against their abusive registration as domain names. The Secretariat explained that experience has shown that identifiers other than trademarks also were the subject of abuse in the Domain Name System (DNS). It recalled that the WIPO

Member States had requested that a process be undertaken to examine how to deal with the problems encountered in relation to those other identifiers. The Report of this process, known as the Second WIPO Internet Domain Name Process, was published on September 3, 2001, prior to the WIPO General Assembly of that year. At its meeting in September 2001, the WIPO General Assembly decided (document WO/GA/27/8) that the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) was to hold two special sessions on the Report of the Second WIPO Internet Domain Name Process. At the same time it was decided that “[a] report of the two special sessions of the SCT should be prepared which presents the options for the treatment of the issues dealt with in the Second Process Report ... [and which] should be transmitted to the meetings of the WIPO General Assembly in September 2002 for consideration and decision.” The Secretariat stated that the options for the treatment of the issues were reflected in document WO/GA/28/3 and referred specifically in this respect to the recommendations of the SCT (SCT recommendations) contained in paragraphs 11 (International Nonproprietary Names (INNs) for Pharmaceutical Substances), 15 (trade names), 18 (personal names), 24 (names and acronyms of international intergovernmental organizations (IGOs)), 31 (country names) and 45 (geographical indications). With respect to country names, the Secretariat clarified that a number of outstanding issues required further deliberation, including whether any protection envisaged should extend only to the official names of countries or also their short names, as well as the names by which they are commonly known. The Secretariat referred in this respect to documents WO/GA/28/3 Add. and WO/GA/28/3 Add.2.

59. Speaking on behalf of the Group of Latin American and Caribbean Countries (GRULAC), the Delegation of Barbados expressed its support for the SCT recommendations regarding INNs and trade names. The Delegation also took note of the SCT recommendations regarding personal names and geographical indications. The Delegation requested that the deadline, previously scheduled at June 30, 2002, to notify a country name for which protection would be sought, be extended. On its own behalf, the Delegation endorsed the statement made by GRULAC and added that it had a special interest in the work related to the protection of country names in the DNS, as the Government of Barbados had found itself unable to use or authorize several domain names which could have provided the country with valuable portals for promoting the country’s goods and services on the Internet, due to the registration as domain names of the country’s official name by unauthorized persons. Although the Delegation recognized that country names were not imbued with intellectual property status, it considered that it was highly undesirable for private persons unconnected to the Government of Barbados and to whom no official endorsement had been given to hold the registration to such domain names. The Delegation therefore expressed its support for the SCT recommendation regarding protection of country names in the DNS. On the modalities of the protection, the delegation favored the use of the UN Bulletin as a basis for identifying the names to be protected and was of the view that protection should be extended to names by which countries were commonly known. The Delegation concluded that it was in favor of the introduction of an appropriate mechanism for obtaining the cancellation or transfer of the registrations of country names as domain names by registrants who are found to have acted in bad faith in accordance with the standard set out in paragraph 40 of document WO/GA/28/3.

60. The Delegation of Argentina had no objection to the recommendations formulated at the Special Session, contained in paragraph 11 for International Nonproprietary Names for Pharmaceutical Substances, in paragraph 15 for trade names and in paragraph 18 for personal names. It pointed out that the names and acronyms of international intergovernmental organizations (IGOs) were protected under Article 6^{ter} of the Paris Convention, by the TRIPS Agreement and also in accordance with various provisions appearing in other international

treaties, and that there was therefore a well-established legal framework for their protection. Accordingly, the Delegation considered itself able to support the recommendation contained in paragraph 24 of the report. With regard to the country names, it wished to point out that, while it considered that such names should not qualify for intellectual property rights, it saw a need for protection against their abuse in the domain names system by persons unconnected with the constitutional authorities of the country concerned. As for the list of countries, it maintained that it should include the exact names but also any variations on them that might mislead, including the names of the same countries in other languages, as indicated in the paragraph 2(iii) quoted in paragraph 31. With regard to possible lists of names, the Delegation considered it more suitable for the lists to be based on the United Nations Terminology Bulletin, or failing that on the list contained in ISO Standard 3166. It asked for the list to contain only the names corresponding to States members of the United Nations in addition those notified to the Secretariat of WIPO. With regard to geographical indications, the Delegation considered that the recommendation contained in paragraph 44 of document WO/GA/28/3 was the result of consensus on a compromise reached at the second Special Session, to which it had no objections.

61. On behalf of the European Union and its Member States, the Delegation of Denmark proposed that the General Assembly request the Secretariat to prepare a document for discussion at the SCT concerning the protection of geographical indications in the DNS.

62. The Delegation of the Former Yugoslav Republic of Macedonia expressed its support for the protection of country names in the DNS. The Delegation also expressed interest in having its constitutional name "Republic of Macedonia" protected in the DNS. The Delegation favored the use of the ISO-3166 Standard as a basis for the protection of country names in the DNS.

63. The Delegation of Mexico acknowledged the amount of work done by the International Bureau in connection with Internet domain names. With reference to the recommendations made by the Special Session of the Standing Committee on Trademarks on the Second WIPO Process, the Delegation suggested that WIPO should work hand in hand with the World Health Organization (WHO) in order to reach agreements that would favor the protection of International Nonproprietary Names for Pharmaceutical Substances, and proposed that the subject continue to be dealt with in the ordinary sessions of the SCT. It also reaffirmed its support for a broadening of the uniform policy in order to provide for the possibility of an intergovernmental organization submitting complaints in the cases described in the recommendation made by the Special Session, contained in paragraph 24 of document WO/GA/28/3. With reference to country names, the Delegation favored the broadening of the uniform policy to accommodate them in cases in where a domain name was registered with the characteristics described in paragraph 40 of the same document, namely where the registration was made in bad faith and was liable to mislead or confuse. It preferred the use of the United Nations Bulletin as a basis for determining what names had to be protected, as the protection of the names of States was thereby promoted; the list should not however be confined to countries members of the United Nations, but rather encompass all States. It recalled that Mexico would be seeking protection for the names "*Estados Unidos Mexicanos*," "*República Mexicana*" and "*México*," as mentioned in the addenda to the document referred to. With regard to the matter of trade names and geographical indications on which no agreement had been reached, the Delegation considered wise the Special Sessions's recommendation that they be considered within the ordinary sessions of the SCT.

64. The Delegation of Australia expressed its support for all SCT recommendations with the exception of the one related to country names. The Delegation stated that, for reasons that have been well debated, it was not administratively practical to provide protection for country names, as set out in paragraph 40 of document WO/GA/28/3.

65. The Delegation of Canada opposed the protection of country names within the DNS stating there was no basis for such protection in international law and that such protection is contrary to the basic principle of Internet regulation, which should be non-burdensome from a regulatory and administrative standpoint. The Delegation expressed the view that it was premature at this time to make a recommendation on country names until there had been an opportunity to build a common understanding of the issue.

66. The Delegation of South Africa noted that the issue of domain names and intellectual property has been much debated and that South Africa has actively participated in the discussions. The Delegation supported the creation of protection for country names and the names and acronyms of IGO in the DNS. It was in favor of such protection for both official and commonly known names of countries (e.g., for South Africa: SA, RSA, ZA, and for the United States of America: US and USA). The Delegation explained that its laws had been amended to protect country names and the names and acronyms of IGOs (e.g., UN and UNAIDS) in accordance with Article 6^{ter} of the Paris Convention. The Delegation was of the view that the question of bad faith was immaterial, as these identifiers were to be regarded as the property of the countries or organizations concerned. It pointed out that as South Africa has many official languages, they would like to submit other identifiers by which the country's acronyms may be known in future. The Delegation also believed that the SCT recommendation with respect to country names and the names and acronyms of IGOs should be applied retrospectively. Furthermore, the Delegation of South Africa submitted the following statement:

“The Republic of South Africa submits its proposal regarding the rights of sovereign nations to their own names (‘Country Names’) as Internet domain names to the WIPO General Assembly for its consideration at its meeting in September 2002. The proposal of the Republic of South Africa agrees with the substance of the proposal set forth in the report of the Second Special Session of the Standing Committee on the Law of Trademarks, Internet Domain Name Process, dated 24 May 2002 (SCT/S2/8), available at http://www.wipo.int/sct/en/documents/special_session/doc/sct_s2_8.doc.

“The Republic of South Africa, however, proposes two modifications to the Second Special Session report, which it believes are necessary to make the proposal an effective means of protecting the rights of sovereign nations to their own names as domain names in the gTLDs. As discussed more fully below, the Republic of South Africa proposes: 1) The dispute resolution procedure should be identical to the binding arbitration procedure that the Second Special Report has proposed for intergovernmental organizations (“IGOs”), in order to protect sovereign nations from the jurisdiction of national courts to the same extent as IGOs, and 2) The Second Special Session proposal should be clarified to make clear that any Country Name domain name registration that is unauthorised by the sovereign nation of that name should be subject to cancellation.

“BACKGROUND

“The vast majority of the names of sovereign nations have been registered as internet domain names in the gTLDs particularly in the dot-com gTLD, by individuals or entities with no association or affiliation with that sovereign nation. For example, the domain name <southafrica.com> was registered by a corporation in Seattle in the United States. Throughout the Second WIPO Internet Domain Name Process (“WIPO-2”), the Republic of South Africa has contended that sovereign nations have an inherent sovereign right to their own names as domain names in the gTLDs, and to prevent other from obtaining the exclusive world wide monopoly to use such names as internet domain names in the gTLDs. During the WIPO-2 Process, the Republic of South Africa proposed that WIPO recommend the adoption of a policy and procedure that would fully protect Country Name domain names in the gTLDs, by prohibiting registration of any such domain names except by or on behalf of the respective sovereign nations, and by providing a binding arbitration 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/wipo2-submission.doc>; <http://wipo2.wipo.int/process2/rfc/rfc3/comments/msg00099.html> and at http://www.wipo.int/sct/en/documents/special_session/doc/sct_s2_6.doc

“As set forth in greater detail in the above-referenced submissions, the Republic of South Africa has contended that second level domain names in all gTLDs that are the same as Country Names are valuable national assets that belong to the respective sovereign nations, and that control of the necessarily exclusive and monopolistic rights to such domain names must rest with the sovereign nations. Therefore, those unauthorized persons or entities that have registered Country Names do not have and never had any legitimate claim to the exclusive monopoly rights to such Country Names in that gTLD. 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.

“The Report of the Second WIPO Internet Domain Name Process (“WIPO-2 Report”) gave extensive consideration to the scope of protection that should be given to Country Name domain names in the gTLDs (WIPO-2 Report, Paragraphs 264-261, 264-269, 271-289, available at <http://wipo2.wipo.int/process2/report/word/report.doc>). The WIPO-2 Report “recommended that the question of the protection in the gTLDs of country names and of administratively recognised regions and municipalities be further considered in the appropriate intergovernmental fora, in particular with a view to a discussion on the need for new international rules for the protection of country names.” WIPO-2 Report, Paragraph 288.

“In September 2001, the WIPO General Assembly instructed the SCT to hold two special sessions on the WIPO-2 Report. At both Sessions, the issue of the protection of Country Names was extensively discussed, numerous Member States also filed written submissions on the issues. See <http://ecommerce.wipo.int/domains/sct/documents/index.html>

“Following these discussions and submissions, the Second Special Session Report recognized that “[m]ost delegations favored some form of protection for country names against registration or use by persons unconnected with the constitutional authorities of the country in question.” Second Special Session Report, para 210.

“The Report then recommended the following protection for Country Name domain names:

“(1) A list of Country Names should be made, using both the United Nations Terminology Bulletin 347/Rev. 1 and, as necessary, ISO Standard 3166, including both formal names and the short names of countries and any additional names by which countries are commonly known; (2) protection should cover both the exact names and misleading variations; (3) the Country Names should be protected in the official language (s) of the country concerned and in the six official languages of the United Nations; (4) the protection should be extended to all top-level domains, both gTLDs and ccTLDs; and (5) the protection should be operative against the registration or use of a domain name which is identical or misleadingly similar to a country name, 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.”
Second Special Sessions Report, Para 210.

“The Second Special Session Report did not include recommendations on the nature of the dispute resolution mechanism, or whether it would be binding or non-binding. However, in the same Report, the SCT recommended that names of IGOs be protected through a special arbitration procedure that did not permit a losing registrant to file suit in a national court, in order to protect the privileges and immunities of IGOs from the jurisdiction of national courts. Second Special Session Report, Para 88(2).

“The Republic of South Africa concurs with the Second Special Session Report on the protection of Country Names, but believes that two modifications are essential in order to make the proposed protection of Country Names meaningful and effective.

“1. Ensuring that sovereign nations do not waive sovereign immunity

“It is imperative that the mechanism for protection of Country Names be designed to prevent a subsequent suit against the sovereign State in a foreign national court, on the same terms and for the same reasons as the recommendation for IGOs. Under the existing Uniform Dispute Resolution Procedure (“UDRP”), any registrants that is named as a respondent in an arbitration can file an action in a national court before, during or after the arbitration, and the challenging sovereign state is required to agree to submit to the jurisdiction of that national court. Thus, a sovereign nation, by instituting an arbitration against a registrant of a Country Name domain name, would almost certainly be found to have waived its sovereign immunity from jurisdiction by national court of another State, and would be forced to litigate its rights to its own name in a foreign court. Moreover, the laws that will most likely be applied in any such lawsuit will be the national laws of that court, not international law or the law of the challenging sovereign State. Thus, the existing UDRP, even if it is modified to provide protection for Country Names, likely will force sovereign States to submit to the jurisdiction of foreign courts, but any protections provided by the UDRP for Country Names will likely be nullified by actions of the national courts of the current registrants. Thus, South Africa recommends that WIPO General Assembly adopt the identical proposal as that recommended for the protection of the names of IGOs, in Paragraph 88 of the Second Special Session Report as follows:

“The UDRP should also be modified, for the purposes of complaints regarding Country Names, to take account of and respect the immunities of sovereign states in international law. In the respect, sovereign States should not be required, in using the UDRP, to submit to the jurisdiction of national courts. However, it should be provided that decisions given in a complaint filed under the modified UDRP by a sovereign State should be subject at the request of either party to the dispute, to *de novo* review through binding arbitration.”

“2. Any Country Name domain name registration in which the registrant is not authorized by the sovereign nation should be subject to cancellation

“The Second Process Report recommended that a Country name domain name be subject to cancellation “where the domain name holder has no right of 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.” This recommendation does not elaborate on the meaning of the terms “no right or legitimate interest in the name” and when a domain name will be sufficiently misleading. The Republic of South Africa is concerned that this ambiguous language may be construed to suggest that an unauthorized, unaffiliated private registrant may have a claim of right to a Country Name that is superior to the sovereign State, which would allow the private party to continue to monopolize and to expropriate of itself the value of the Country Name. The Republic of South Africa believes that an interpretation would be contrary to the views expressed at the Second Special Sessions and would be contrary to the rationale underlying the protection of Country Names, in which the attempt by a private party, unaffiliated with a sovereign, to appropriate to its own benefit the economic value of that sovereign’s name is *per se improper*. Furthermore, such an interpretation could result in numerous protracted disputes and could be sued to prevent numerous sovereigns from recovering the rights to their own names.

“Therefore, the Republic of South Africa recommends that the WIPO General Assembly modify the Second Special Session Report to clarify that a Country Name domain name is subject to cancellation when the registrant is not authorized by the respective sovereign nation to use its Country Name.

“The Republic of South Africa recognizes that some existing registrants may have, in good faith, invested money in the Country Name domain names that they have registered. Therefore, the Republic of South Africa further proposes that the arbitrator be granted the authority and discretion to award to an existing registrant reasonable compensation, up to \$10,000, upon a finding that the registrant acted in good faith in its registration and use of the domain name.”

67. The Delegation of the United States of America stated that it agreed with the recommendations of the SCT concerning INNs, trade names and personal names. However, the Delegation expressed strong disagreement with the SCT recommendations concerning the names and acronyms of IGOs and country names. The Delegation was of the view that the trademark law concerning these identifiers was far from settled and that disputes concerning them therefore would not be suitable for resolution through the UDRP. The Delegation joined the point of view of the Delegation of Canada to the effect that the UDRP is intended to be a quick, simple and cheap means of dispute settlement, but that these characteristics do

not obtain for the names and acronyms of IGOs and country names. With respect to geographical indications, the Delegation agreed with the SCT recommendation that further discussion on the issue should take place in the SCT.

68. The Delegation of Kenya recalled that it has been actively participating in the ongoing debate on the protection of identifiers in the DNS by attending the Special Sessions of the SCT and also by making submissions to the Secretariat on the various issues being discussed. The Delegation stated that INNs should be protected against their registration as domain names. The Delegation also expressed the view that it would be helpful if the World Health Organization (WHO) could send the latest list of INNs to the various industrial property offices of the Member States in a timely manner. The Delegation also noted that the UDRP should be extended to trade names. The Delegation expressed its support for the SCT recommendation regarding the names and acronyms of IGOs. The Delegation also expressed its support for the SCT recommendation concerning the protection of country names against their registration or use as domain names by persons unconnected with the constitutional authorities of the country in question. The Delegation stated, in addition, that a new list of country names should be drawn up on the basis of the UN Bulletin and, as necessary, the ISO Standard. The Delegation also stated that both the long and short names of countries should be protected, as well as any additional names by which countries are commonly known and which have been notified to the Secretariat. The Delegation expressed the view that each country name should be protected in the official language(s) of the country concerned and in the UN languages, both in gTLDs and in ccTLDs. The Delegation observed that protection should be operative against the registration or use of a domain name which was identical or misleadingly similar to a country name, where the domain name holder had no right or legitimate interest in the name, and the domain name was of a nature that was likely to mislead users into believing that there was an association between the domain name holder and the constitutional authorities of the country in question. On the issue of acquired rights, the Delegation concluded that no right could be acquired in a domain name which was registered in bad faith, and that, consequently, such registration should be cancelled. The Delegation supported the SCT recommendation regarding geographical indications.

69. The Delegation of Antigua and Barbuda endorsed the statement made by the Delegation of Barbados on behalf of GRULAC and associated itself with the statement of Barbados and South Africa.

70. The Delegation of the Kingdom of Morocco endorsed the findings of the Second Special Session of the SCT on Internet Domain Names, but it did wish to express reservations regarding the list to be used for identifying the names of countries entitled to protection under the domain name system: the names of countries should be identified according to the list in the United Nations Terminology Bulletin, and the Delegation added that any change in the list should be notified to WIPO, and be subject to prior acceptance by the Organization's Member States within the body mandated for the purpose.

71. The Delegation of Egypt expressed explicit support for the SCT recommendation concerning INNs, urged the Secretariat to continue its cooperation with the WHO in this connection and suggested that it prepare a report on the issue in the future. With respect to the identification of country names, the Delegation supported reliance on the UN Bulletin or the ISO Standard, in accordance with what has been agreed upon by the Members of the United Nations.

72. The Delegation of Germany supported all the SCT recommendations, with due regard to the observations made by the Delegation of Denmark on behalf of the European Union and its Member States. With respect to the identification of country names, the Delegation favored reliance on the UN Bulletin, but complemented by names by which countries are commonly known, as notified to the Secretariat.

73. The Delegation of France spoke of the importance that it attached to the establishment of principles for Internet use that placed such a formidable medium of progress at everyone's disposal while at the same time protecting the interests of the owners of rights, whether private or public. The Delegation of France pointed out that WIPO had advanced in its work on Internet domain name disputes. It pointed out moreover that important recommendations had been made regarding the protection of names and acronyms of intergovernmental organizations in the domain name system (DNS) and the compilation of a list of country names to be protected. The Delegation also mentioned that other subjects had been deferred, such as that of the protection of geographical indications and indications of source in the DNS. It noted that the question was still outstanding, which did not alter the fact that it was the most complex and the most important to France in particular, and that it should be monitored carefully. The Delegation said that it supported the recommendations of the Special Sessions of the SCT concerning the names and acronyms of intergovernmental organizations and the protection of country names against registration as domain names. The Delegation concluded by expressing the hope that specific action would be taken in order to implement the recommendations already adopted, and that if necessary WIPO could engage in consultations to that end.

74. The Chair noted the following with respect to the recommendations of the SCT, as reflected in document WO/GA/28/3.

75. The General Assembly adopted the recommendation of the SCT with respect to INNs.

76. The General Assembly adopted the recommendation of the SCT with respect to trade names.

77. The General Assembly adopted the recommendation of the SCT with respect to personal names.

78. The General Assembly adopted the recommendation of the SCT with respect to geographical indications, it being understood that the SCT is to continue the discussions on this topic.

79. The General Assembly adopted the recommendation of the SCT with respect to the names and acronyms of IGOs and instructs the Secretariat to transmit the said recommendation to the Internet Corporation for Assigned Names and Numbers (ICANN). The Delegation of the United States of America dissociated itself from this decision.

80. The General Assembly noted that all Delegations support the recommendations of the SCT with respect to country names, except those of Australia, Canada and the United States of America.

81. The General Assembly further noted that a number of issues with respect to the protection of country names in the DNS warrant further discussion. These issues concern, in particular, the list to be relied upon to identify the names of countries which would benefit from the protection envisaged, (2) the extension of the deadline for the notification to the Secretariat of names by which countries are commonly known, and (3) how to deal with acquired rights. The General Assembly decided that discussions should be continued in the SCT with a view to reaching a final position.

ITEM 14 OF THE CONSOLIDATED AGENDA:

MATTERS CONCERNING THE STATUS OF THE ADVISORY COMMITTEE(S) ON ENFORCEMENT

82. Discussions were based on documents WO/GA/28/4 and WO/GA/28/6.

83. Upon introducing the documents, the Secretariat recalled that following the discussions of Member States and observers at the Joint Meeting of the Advisory Committee on Enforcement of Industrial Property Rights and the Advisory Committee on Management and Enforcement of Copyright and Related Rights in Global Information Networks, held in December 2001, it had been decided that a decision would be taken, during the next session of the WIPO Assemblies, on the status that would be granted to the future advisory committee on enforcement. Furthermore, Member States were requested to consider, as to the structure of such a committee, the options contained in paragraph 5 of document WO/GA/28/4, with regard to the structure of the future Advisory Committee(s) on Enforcement, namely:

(a) to establish a single Committee covering both industrial property rights and copyright and related rights;

(b) to establish two separate Committees, one for industrial property rights and one for copyright and related rights, which would meet concurrently with a possible joint session at the end; or

(c) to establish two separate Committees.

The Secretariat also noted that pending the decision by the General Assembly on the above, a decision had to be taken on the applicable rules of procedure and the issue of participation by Member States and observers and the participation of non-governmental organizations without observer status in WIPO.

84. With reference to the Consultation Meeting on Enforcement, held from September 11 to 13, 2002, the Chair invited Mr. Henry Olsson, Chair of the Consultation Meeting on Enforcement, to present the "Conclusions by the Chair," attached to document WO/GA/28/6.

85. Mr. Olsson thanked the Chair and referred, in particular, to paragraph 7 of the adopted "Conclusions by the Chair" of the Consultation Meeting on Enforcement, annexed to document WO/GA/28/6, and informed the General Assembly that, during the Consultation Meeting on Enforcement, strong preference was expressed that an intergovernmental structure for enforcement, to be set up within WIPO, would include one single committee, covering both industrial property rights and copyright and related rights, in charge of global

enforcement issues. The objectives or tasks of the single committee would be to serve as a forum for exchange of information and appropriate coordination of activities in the field of enforcement and cooperation in the fight against counterfeiting and piracy. Some delegations suggested that the committee could consider the elaboration of good or best practices in the field of enforcement. In addition, some delegations suggested that a Model Law on Enforcement should be elaborated. One delegation suggested that the issue of enforcement could also be drawn to the attention of the Policy Advisory Commission (PAC). Mr. Olsson further indicated that, as regards the form of the single committee, different views were expressed. Whereas certain delegations supported the proposed structure presented by the International Bureau, certain other delegations supported the setting up of a permanent committee as proposed by the Delegation of the United States of America. A number of delegations also expressed the view that there should be a focal point in the International Bureau responsible for the coordination of the enforcement activities which would also serve to ensure contact with the committee on enforcement. With regard to the conclusions contained in paragraph 1 to 6 of the "Conclusions by the Chair" Mr. Olsson mentioned that strong appreciation was expressed for the work conducted by the Regional Bureaus and the WIPO Worldwide Academy, but that efforts could be made to improve these activities.

86. The Delegation of Barbados, on behalf of the Group of Latin American and Caribbean Countries (GRULAC), was in favor of the creation of a single consultative committee with two separate and distinct programs on copyright and industrial property, respectively. It stated that this consultative committee would be intended to enhance cooperation and technical assistance in the area of enforcement among WIPO Member States, especially developing countries. It would help to ensure that the needs of developing countries in the specific area of enforcement are met, and address the problems many WIPO Members States face in implementing their enforcement obligations under the WTO (Trade-Related Aspects of Intellectual Property Rights (TRIPS) Agreement. The Delegation stated that GRULAC felt strongly that an agenda which was too ambitious would only prove detrimental in the long run and it would not support any initiative that would result in the creation of higher levels of enforcement obligations than those which currently exist under the TRIPS Agreement.

87. The Delegation of Denmark stated that enforcement was an extremely important issue and that the legal protection of copyright and industrial property rights could not stand alone and must be accompanied by enforcement measures. The Delegation, therefore, fully supported the efforts of WIPO in the field of enforcement and pointed out that it was indispensable to have a forum where Member States, intergovernmental organizations and non-governmental organizations could discuss these matters in order to strengthen the WIPO enforcement activities and to provide inspiration to enforcement activities on a regional and national level. The delegation further pointed out that although there were many overlapping enforcement issues regarding copyright and industrial property rights and enforcement activities in various areas vary to a large extent, but the issues to be discussed in a committee were very much the same. Against this background, the Delegation supported the establishment of one single committee covering both copyright and industrial property rights to deal with enforcement issues in WIPO. The Delegation also found the International Bureau's proposals regarding the committee's purpose, organization and procedures satisfactory. The Delegation noted that paragraph 12 of document WO/GA/28/4 did not seem to allow the European Community, as such, to become a member of the committee. Although the Delegation did not propose an amendment to the proposal made by the International Bureau, it would like the question concerning membership of the European Community to be taken up as an issue in the forthcoming committee. The Delegation then pointed out that it considered it most appropriate for the committee itself to decide whether to establish working

groups in future. Regarding the proposition to establish a focal point within the International Bureau to deal with coordination of the enforcement activities of WIPO, the delegation was of the view that the internal organization in the International Bureau should be left, to the widest possible extent, to the management of WIPO. It was, in any event, premature to discuss the question at the Assembly. The Delegation suggested that the proposal should be dealt with at the new committee's first meeting.

88. The Delegation of the United States of America reaffirmed its opinion that one single committee should be established in order to have a coherent and integrated approach on training and related activities. However, the Delegation held the view that a standing committee could provide the preferred framework for the enforcement activities as this would ensure a greater sense of continuity to carry out its objectives and specific activities and to render assistance to all Member States of WIPO as no Member State was immune to the problems faced under these activities and that it was a global, international issue. The Delegation agreed that it was not necessary to delineate all the tasks of this committee but the proposals outlined in paragraph 7 of document WO/GA/28/4 should be decided by the Assembly as the general parameters of such a standing committee. Such a single structure would also ensure that maximum use be made of the currently authorized resources dedicated to these activities.

89. The Delegation of Egypt thanked the Secretariat for their excellent presentation and pointed out that intellectual property enforcement was the basis of intellectual property protection and, accordingly, supported the establishment of a single advisory committee on enforcement to promote cooperation among Member States through the exchange of information, data and experience in a positive spirit of cooperation. The committee should place the emphasis on enforcement activities relevant to developing countries in order to assist them in their efforts to protect intellectual property rights. It was also important that WIPO review its enforcement activities, like all other activities. The Delegation agreed with the mandate of the committee as outlined in paragraph 7 of document WO/GA/28/4 on the understanding that it had been agreed to by all countries and not only some countries.

90. The Delegation of Japan thanked Mr. Olsson for his detailed explanation on this issue and mentioned that it regarded the activities of WIPO in the area of enforcement as extremely important and underscored the strengthening of enforcement related activities in the framework of WIPO. The Delegation strongly supported the establishment of a single committee on enforcement having a permanent nature.

91. The Delegation of Algeria warmly thanked Mr. Olsson for his excellent report on this very crucial issue and supported the establishment of such a committee. However, it felt it necessary to emphasize that such a committee should be merely advisory. Careful attention should thus be given to the terms of reference for the committee and its structure. In order to do so, there was a need for further deliberations by the committee.

92. The Delegation of Germany expressed its support for the establishment of a single committee to continue work in this very important area of enforcement with a positive focus. Concerning the internal organization of the International Bureau, the Delegation associated itself with the views expressed by the Danish Delegation and expressed its confidence that the Secretariat would organize itself in the most efficient way to carry out this task.

93. The Delegation of Brazil thanked the Secretariat for the documents and Mr. Olsson for the excellent way in which he conducted the Consultation Meeting on Enforcement. The

Delegation stated that its government attached great importance to the enforcement of intellectual property rights and had established an Inter-ministerial Committee on Combating Piracy, bringing together the main stakeholders dealing with copyright and devising a plan of action to combat piracy. The Delegation pointed out that most developing countries lacked adequate resources to implement international obligations, particularly those under the TRIPS Agreement. WIPO could, therefore, play an important role in the exchange of experiences and information regarding intellectual property enforcement, capacity building and training. For the Delegation of Brazil, the realistic approach to handle this matter in WIPO would be to establish a single advisory committee, dealing with both industrial property rights and copyright and related rights. The Delegation did not support the establishment of a permanent committee dealing with enforcement issues. Concerning the establishment of a focal point in the International Bureau to coordinate with enforcement activities, the Delegation was of the view that it had insufficient information and that there was a lack of agreement between delegations regarding the details of the proposal, and was concerned that it might lead to an overlap in the use of resources in WIPO. Accordingly, it fully supported the intervention by the Delegation of Barbados on behalf of GRULAC.

94. The Director General then observed that the majority of delegations who had spoken so far were in favor of the establishment of one single committee on enforcement, the mandate of which had been very clearly established in paragraph 7 of document WO/GA/28/4. The objectives of the said committee were the coordination with certain organizations and the private sector to combat counterfeiting and piracy activities; public education; assistance; coordination to undertake national and regional training programs for all relevant stakeholders and the exchange of information on enforcement issues through the establishment of an Electronic Forum. Within the broad mandate of this committee, possible scenarios could include the elaboration of best practices and a Model Law. Once agreement was reached on the objectives of such a committee, the naming thereof was of lesser importance, since the General Assembly always had the power to change the name of the committee in future. The logical way forward was to create a single committee and to facilitate the task of the Secretariat with the limited resources available. The Director General urged the Member States to take a decision on establishing one single committee; to approve the objectives as established in paragraph 7 of document WO/GA/28/4; and to leave the precise naming thereof to the responsibility of the International Bureau which would, prior to the first meeting of the committee, consult with the various Group Coordinators to clarify the precise naming of the said body. The Director General indicated that there would be opportunities in future to review the work of the committee and to make comments and also to change the naming should the General Assembly find the naming of that body to be inappropriate or irrelevant.

95. The Republic of Korea supported the establishment of a single committee due to the overlapping nature of intellectual property rights and took note of the fact that specialized working groups may be established thereunder to consider specific issues to be addressed by the committee, as proposed in document WO/GA/28/4.

96. The Delegation of Sudan also supported the establishment of a single advisory committee. It pointed out that the work of the committee should maintain a balance between all disciplines of intellectual property including legal aspects and protection, and that the focus should not exclusively be limited to legal aspects.

97. The Delegation of France agreed with the summary and proposal made by the Director General. The Delegation mentioned that the establishment of a single committee would

simplify matters, but that WIPO ensures enforcement. As far as the mandate or terms of reference were concerned, the main issue was the results that could be achieved through the committee. Regarding the internal coordination in WIPO, the Delegation reiterated that that was a matter to be decided upon by the Director General.

98. The Delegation of Sri Lanka stated that it was interested in establishing an expeditious and cost effective enforcement environment. Accordingly, it supported the establishment of one single committee. It was of the view that the elaboration of a Model Law could be very useful, particularly for developing countries.

99. The Delegation of Peru agreed entirely with the position of GRULAC, as expressed by the Delegation of Barbados, and supported the establishment of one advisory or consultative committee on the enforcement of intellectual property rights, which should not be a permanent committee. The terms of reference of the committee should be limited to the exchange of information and appropriate coordination of work that remained to be done in this respect. The Committee could also deal with cooperation, which was extremely important for developing countries if they were to combat counterfeiting and piracy effectively. The Delegation stated that it could not support the development of best practices on enforcement and would certainly not like to see a Model Law becoming an issue for the Committee.

100. The Delegation of Morocco thanked Mr. Olsson for the summary of the Consultation Meeting on Enforcement. The enforcement of rights is clearly an effective tool for protection of intellectual property rights. This was a crosscutting issue, which affected all aspects of intellectual property, and therefore the Delegation supported the establishment of a single committee on enforcement, which should ensure the exchange of information and experience on fighting counterfeiting and piracy. Therefore, the Delegation would gladly participate in future discussions defining the mandate and structure of this committee. The Delegation also pointed out that it was flexible and interested in the consultation that would soon be held on this subject in the hope that a mutual acceptable solution may be agreed upon.

101. The Delegation of Uruguay agreed with the mandate of the committee outlined in paragraph 7 of document WO/GA/28/4, with the following suggestion: "In no case should the committee have a standard setting or normative functions and the information it handles should not be used anywhere to enable commercial or trade related measures to be used or taken against any country."

102. The Delegation of Brazil in response to the observations made by the Director General, stated that if it were merely a problem of name, the discussions would have been much easier. Instead, some delegations had expressed concerns regarding the normative or standard setting nature of a committee on enforcement. That being the case, the establishment of an advisory committee would be an effective way of achieving the objectives that had been set out in paragraph 7 of the Secretariat's document. The Delegation, therefore, felt that the suggestion that a committee be created without any reference to its actual characteristics, that is whether it was a standing committee, an advisory committee or a consultative committee, would not be sufficient to overcome certain continuing concerns on the part of some countries. The Delegation was, accordingly, of the view that the establishment of an advisory committee would be a better way to meet the concerns of all members of the Assembly. The Delegation thus regretted to say that the establishment of a committee without providing the necessary adjectives to indicate the nature of the committee would not comply with the instructions that they had received from their capital. Extensive discussions had taken place in their capital

and there was a very clear and serious concern about the mandate of the committee. The Delegation therefore reiterated its preference for an advisory committee as a committee that could meet the concerns of the majority members of the Assembly and fully agreed with the proposals made by the Delegation of Uruguay, with respect to the characteristics of such a committee.

103. The Delegation of the United States of America mentioned that it had listened attentively to the various Delegations and also to the summary made by Mr. Olsson followed by the reassurance by the Director General that the work of this single committee was already shaped by the general terms of reference decided in document WO/GA/28/4. It would concur with, and support, the recommendations made by the Director General, in finding it the most acceptable way to proceed with the important work of this committee.

104. The Delegation of Venezuela also favored the establishment of an advisory committee without a normative activity and with clearly defined criteria and mandate as mentioned by the Delegation of Uruguay. It agreed, entirely, with those Delegations who had made similar comments.

105. The Delegation of Argentina supported the intervention made by Barbados on behalf of GRULAC. It also supported the interventions made by the Delegations of Brazil, Peru and Venezuela.

106. The Chair proposed the following conclusion based on the consensus reached, namely:

(1) That the General Assembly should confirm the establishment of a single committee on enforcement of rights;

(2) That the objectives of that committee would, at this stage, be the same as they are defined and outlined according to the terms of paragraph 7 of document WO/GA/28/4; and

(3) That the Director General of WIPO be requested to convene this single committee on the understanding that all Member States who wished to participate therein could participate. Furthermore, that the committee would report to the next General Assembly, on, firstly, the progress achieved in terms of the setting of objectives for the Committee and, secondly, the Assembly should have a fresh discussion at its next session, to define the scope of the committee, its role and its procedures.

107. The Delegation of Brazil supported the proposed conclusion made by the Chair, as provisional, but to be acceptable, it would like to see the suggestion by the Delegation of Uruguay incorporated into the understanding of the Assembly.

108. The Delegation of Uruguay agreed with the intervention made by the Delegation of Brazil but requested to add expressly to the conclusions that in no case would the committee have standard setting or normative responsibilities, and the information handled by the committee should not be used, in any circumstances, for the adoption of commercial or trade related measures against any country.

109. The Delegation of Peru echoed the statement made by the Delegations of Brazil and Uruguay and stated that it would also have concerns in accepting the conclusions by the Chair unless the scope of the remit of the committee were clearly defined.

110. The Delegation of Cameroon shared the concerns raised by the Delegation of Brazil and wanted to be ensured that the new committee would have no mandate to review the TRIPS Agreement nor have any normative mandate and that the objective of the committee should hinge around the educational and information components.

111. The Delegation of Kazakhstan shared the intervention made by the Delegation of Uruguay and those supporting that intervention. The Delegation further supported the establishment of one single advisory committee.

112. The Delegation of the United States of America was of the view that the Director General had found the appropriate solution in providing the necessary flexibility as outlined in paragraph 7, which could be developed in consultation with Member States and then to come back with a program of action for consideration by the Assembly next year. The Delegation had the impression that the time was ripe to improve the work of WIPO in a positive way and to strengthen the enforcement of intellectual property rights. As set out in the summary made by Mr. Olsson, the Consultation Meeting on Enforcement had underscored the need for improved training and technical assistance. The Delegation stated that the amendments offered by the Delegation of Uruguay did not comport with the language of paragraph 7 of the document under discussion.

113. The Delegation of the Republic of Cuba wished to express its support for the GRULAC declaration and of the declarations of Brazil, Venezuela, Uruguay and Peru. Furthermore the Delegation supported the proposal of the Director General on the establishment of a single Advisory Committee on Enforcement, covering both industrial property and copyright and related rights.

114. The Chair proposed the conclusions for adoption, which were agreed upon after extensive consultation and the following solution was proposed, namely:

The General Assembly took note of the contents of documents WO/GA/28/4 and WO/GA/28/6, prepared by the Secretariat.

(i) The General Assembly decided to establish one single Advisory Committee on Enforcement, in charge of global enforcement issues, covering both industrial property and copyright and related rights.

(ii) The mandate of the Committee in the field of enforcement, which excludes norm setting, was limited to technical assistance and coordination. The Committee should focus on the following objectives: coordinating with certain organizations and the private sector to combat counterfeiting and piracy activities; public education; assistance; coordination to undertake national and regional training programs for all relevant stakeholders and exchange of information on enforcement issues through the establishment of an Electronic Forum.

(iii) The proposed membership and rules of procedure were those contained in paragraphs 8 to 14 of document WO/GA/28/4.

(iv) The Director General to convene a meeting of the said Committee, as soon as possible in the year 2003, and should report to the next ordinary session of the General Assembly.

115. The Delegation of Barbados, in the interest of transparency and clarity, stated on behalf of GRULAC, that it understood that in no case would the Committee have normative attributions and the information generated by that Committee would not be used in any forum to adopt commercial measures against any country.

116. The Chair stated that the statement made by GRULAC had been noted and would be reflected in the records of the discussion.

117. The Delegation of Algeria, on behalf of the African Group, expressed its desire for a purely advisory committee to be established that would deal with cooperation, exchange of information, expertise and awareness raising which, as the Delegation observed, had all been incorporated in the agreed conclusions to be adopted by the General Assembly.

118. The Delegation of Belarus made a statement on behalf of the Group of Central Asian, Caucasus and Eastern Europe, emphasizing three points to be reflected in the record of the Assembly, namely, that it supported the idea of a single Committee, but it would not like the remit of the Committee to include any kind of normative or standard setting activity.

119. The Chair confirmed that it was a single Committee, which was advisory and it would have no power to set standards.

120. The General Assembly agreed with the conclusions made by the Chair as outlined in paragraph 114 above.

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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

**STANDING COMMITTEE ON THE LAW OF TRADE MARKS,
INDUSTRIAL DESIGNS AND GEOGRAPHICAL INDICATIONS**

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

Geneva, November 29 to December 4, 2001

REPORT

adopted by the Special Session of the Standing Committee

Introduction

1. In accordance with the decision of the WIPO General Assembly at its meeting in September 2001 (document WO/GA/27/8) that the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) hold two special sessions on the Report of the Second WIPO Internet Domain Name Process (the "Special Sessions"), the first such Special Session was held in Geneva from November 29, 2001, to December 4, 2001.

2. The following 69 States participated: Albania, Algeria, Australia, Austria, Belarus, Belgium, Brazil, Bulgaria, Burundi, Cambodia, Canada, Central African Republic, Chad, Chile, China, Côte d'Ivoire, Croatia, Cuba, Czech Republic, Denmark, Estonia, France, Germany, Ghana, Guatemala, Honduras, Hungary, India, Indonesia, Ireland, Italy, Japan, Jordan, Kenya, Kyrgyzstan, Latvia, Lebanon, Lithuania, Malaysia, Mexico, Morocco, Netherlands, New Zealand, Nigeria, Norway, Panama, Paraguay, Philippines, Portugal,

Republic of Korea, Romania, Russian Federation, Senegal, Singapore, Slovakia, Spain, Sudan, Sweden, Switzerland, Thailand, Tunisia, Turkey, Ukraine, United Kingdom, United States of America, Uruguay, Venezuela, Yugoslavia, Zimbabwe. The European Community was also represented in the capacity of a member of the SCT.

3. The list of participants is contained in the Annex to this report.
4. The Session was opened by Mr. Francis Gurry, Assistant Director General, who welcomed the participants on behalf of Dr. Kamil Idris, Director General of WIPO.

Election of a Chair and two Vice-Chairs

5. Mr. S. Tiwari (Singapore) was elected as Chair, and Mrs. Valentina Orlova (Russian Federation) and Ms. Ana Paredes Prieto (Spain) as Vice-Chairs. Mr. David Muls (WIPO) acted as Secretary.

Adoption of the Draft Agenda

6. The Draft Agenda (SCT/SI/1) was adopted without modification.

Accreditation of Certain Organizations

7. As set out in document SCT/SI/5, three organizations had expressed to the Secretariat their wish to obtain ad hoc observer status for the Special Sessions: the *Agence pour la protection des programmes*, the Internet Society and the International Federation of Red Cross and Red Crescent Societies. The accreditation of the organizations in question as ad hoc observers for the Special Sessions was approved unanimously.
8. The Representative of the International Federation of Red Cross and Red Crescent Societies informed the Secretariat that his organization was incorrectly referred to in document SCT/SI/5 as a non-governmental organization, and requested that it be referred to as an intergovernmental organization in further documents.
9. The Secretariat noted the statement and confirmed that the necessary correction would be made in future documents.

Report of the Second WIPO Internet Domain Name Process and its Context

10. In terms of the structure for the discussions on this agenda item, the Chair proposed that the Secretariat first provide a general overview of the Report of the Second WIPO Internet Domain Name Process and its recommendations (the Report), after which delegations would be invited to make opening statements. After such opening statements, it was suggested to deal successively with each of the topics covered by the Report, namely: (1) international non-proprietary names (INNs) for pharmaceutical substances, (2) names of international intergovernmental organizations (IGOs), (3) personal names, (4) geographical identifiers and

(5) tradenames. For the debate on each separate topic, the Chair proposed first to discuss the extent of problems encountered in the domain names system (DNS) and, only if the extent of problems was deemed significant, to proceed with a debate on possible methods for rectifying those problems and what the nature of those methods might be.

11. On the basis of document SCT/SI/2, the Secretariat provided a brief historical overview of the main developments affecting the domain names system (DNS) since the middle of the last decade, including the creation of the Internet Corporation for Assigned Names and Numbers (ICANN), the entity responsible for the technical management of the DNS, and the adoption by the latter, in December 1999, of the Uniform Domain Name Dispute Resolution Policy (UDRP), based on the recommendations formulated in the Report of the first WIPO Internet Domain Name Process. The Secretariat observed that the UDRP, which offers protection for trade and service marks only, was now widely used to combat cybersquatting in the DNS. More than 3400 UDRP disputes had been filed with the WIPO Arbitration and Mediation Center (one of four ICANN-accredited dispute resolution service providers), representing approximately 70% of the total number of cases filed under the procedure. The Secretariat remarked, however, that, already at the stage of the first WIPO Internet Domain Name Process, it had become apparent that a number of identifiers other than trademarks, some of which were recognized in the intellectual property system, also are the subject of abusive domain name registrations. It was those other identifiers that WIPO had been requested by its member States to address in the Second WIPO Internet Domain Name Process, which culminated in the publication of the Report on September 3, 2001. Essentially the Report reached three general conclusions: (1) there was wide spread evidence, as reflected in the Annex to the Report, that many of the identifiers in question are registered by persons or entities who have no connection with them; (2) the existing international intellectual property framework was not sufficiently comprehensive to deal with all the problems encountered; (3) whereas the protection that was created for trade and service marks through the UDRP was an exercise which consisted of reflecting existing law in a new medium (the Internet), the establishment of protection in the DNS for the identifiers covered by the Report would amount to the creation of new law. That being the case, the Report recommended that the Member States should decide whether to complete the legal framework and, if so, how to do so.

12. On behalf of the Group of Central European and Baltic States, the Delegation of Latvia shared the view that the existing legal framework was insufficiently comprehensive to deal with all problems encountered in relation to the topics covered by the Report and observed that such framework should be updated. With regard to the methods by which this could occur, the Delegation proposed a combination of the three policy options described in Chapter 2 of the Report: self-regulation, the ICANN contractual model and the treaty. The Delegation expressed the view that, for each topic of the Report, these three approaches might be combined differently in order to reach the desired result. The Delegation expressed general support for the recommendations in the Report concerning INNs, the names of international intergovernmental organizations, personal names, geographical identifiers and tradenames. With regard to geographical identifiers, the Delegation proposed that a distinction be made between those that were recognized by the intellectual property system and those that were not.

13. The Delegation of the United States of America observed that the Report was extensive and that some time should be devoted at this meeting to the study of its recommendations, in

order to determine areas of the Report that might benefit from clarification. However, given the deadline mandated by the General Assembly of WIPO, the Delegations suggested that primary attention at this Special Session be given to the areas in which the Report recommends specific action: namely, on INNs and IGOs. The Delegation noted that there were many layers of analysis and many far-reaching implications in the Report for the future of intellectual property and the future of the domain names system. While debate on these issues had already occurred through the regional consultations, the Delegation remarked that the governments represented at the meeting were obligated to consider those matters that were unique to governments. For example, the Delegation noted that the recommendations on INNs and IGOs might create new government obligations and thus must be considered carefully. It was possible that a complete understanding of such obligations and their impact might require delegation to undertake consultations with their own government experts in such areas as information technology and telecommunications, constitutional law, and public health. Once that review had taken place, the Delegation expressed interest in exploring the Report's specific recommendations in the areas discussed and hoped to help move the debate regarding the internet domain names system towards an acceptable international consensus which took into account both the principles of intellectual property and the concerns of all IP constituents.

14. The Representative of the International Federation of the Red Cross (IFRC) thanked the Committee for having accredited the IFRC as an observer to the meeting. The Representative noted that the IFRC was attending the meeting in order to express its concern about the character of the Red Cross and the Red Crescent and the nature of the obligations that States had undertaken through their ratification of and accession to the first Geneva Convention of 1864 to protect the name and the emblem of the Red Cross and the Red Crescent. The Representative referred to Article 53 of the Geneva Convention, to which 199 States were party, which required States to prohibit the unauthorized use of the name "Red Cross" or "Red Crescent" or their emblems. The Representative also stated that the Geneva Convention created a process under which States, commonly through legislation, create their own national Red Cross or Red Crescent societies. The Representative stressed that those societies were founded by legislation and stood as auxiliary to their Government in support of the work enforced by medical units and in dialogue with their Government as partners in a range of humanitarian activities within each country. The Representative raised the point that, as those societies were not NGOs, their names were protected by national legislation. He also noted a significant degree of abuse of such names at the level of country code top-level domains (ccTLDs), but that most abuse occurred at a global level (in the gTLDs). The Representative gave examples of abuse by third parties purporting to be Red Cross Organizations and defrauding the public by seeking donations for causes. The Representative requested the Special Session take into consideration this concern, which might relate to a treaty-protected name, or that of an IGO. The Representative finally stressed that the IFRC would be ready to work further with the other Delegations and noted that a report on the meeting as well as a communication would be addressed respectively to the ICRC and to all National Red Cross Societies. The Representative also proposed that the IFRC could request all National Red Cross Societies to link with Delegationsto consider the issue.

15. The Delegation of Japan commented that careful considerations should be given to issues not only by governments, but also by the private sector, international organizations, and non-governmental organizations related to the Internet society. The Delegation expressed doubt as to the possibility of the creation of a new law in the field of intellectual property,

which would enable documents to be modified year by year by international agreement, as through the annual report of the Organization. The Delegation also stressed that two sessions might not be sufficient to examine the issues raised by the Report. The Delegation added that at the same time as solutions should be reached as soon as possible, without prejudging that a joint recommendation would be adopted at the next Assemblies of the Member States, and that sufficient time for discussions should be given.

16. The Representative of the International Association for the Protection of Industrial Property (AIPPI) stated that the problems which would arise from extending the UDRP to tradenames, as described by the Report and expressed by certain delegations, were exaggerated. This was so, in the view of the Representative, because panelists appointed to resolve disputes under the UDRP frequently were required to decide whether a complainant has succeeded in demonstrating that it is the holder of an unregistered mark. In the view of the Representative, reaching similar conclusions regarding the existence of a tradename would not be significantly more complicated for panelists in most cases.

17. The Representative of the International Trademark Association (INTA) expressed broad satisfaction with the UDRP, as it currently exists. That being the case, the Representative stated that, at least in the short-term, adjustments to the UDRP to broaden its scope would not be desirable, although he welcomed further study of the matter in the longer term.

International Non-proprietary Names for Pharmaceutical Substances (INNs)

18. The Delegation of the United Kingdom remarked that, to date, no problems had been encountered in relation to INNs in the UK top-level domain. If it were found, however, that a significant level of problems did exist, the Delegation proposed to deal with them through alternative dispute resolution procedures, such as an extension of the UDRP, rather than exclusion mechanisms.

19. The Delegation of the European Commission expressed support for the recommendations formulated on this topic in the Report, in particular with a view to preventing abuse in the future.

20. The Delegation of the United States of America stated that, notwithstanding the instances of the registration of INNs as domain names reflected in the Annex to the Report, it was not convinced that it was adequately demonstrated that those registrations were harmful. In the absence of evidence of harm, the Delegation proposed to adopt a wait-and-see approach rather than to take action.

21. The Delegation of France expressed support for the views expressed by the European Commission and urged that the topic not be set aside, but that action be taken to establish measures aimed at preventing abuse in the future.

22. The Delegation of Australia inquired how the suggestion of the Delegation of the United Kingdom to extend the UDRP can be reconciled with the Report's recommendation to establish a more simple notice and takedown procedure.

23. The Delegation of the United Kingdom explained that it had no fixed views of what the most appropriate method of dealing with the problem might be. Its main concern was to

avoid the establishment of exclusion mechanisms for INNs which, in its view, would unduly interfere with the domain name registration process, which, in many cases, is based on the first-come, first-served principle.

24. In response to the enquiry made by the Delegation of Australia with regard to who would have the burden of ensuring at the registration stage that no INNs were unduly registered as domain names: the registrar or the registrant, the Secretariat explained that this would be an obligation on the part of the registrant resulting from the domain name registration agreement. The Secretariat stated that, while it would also be possible to adopt a treaty imposing upon States the obligation to render illegal the registration of INNs as domain names, this might not be an effective means of dealing with the problem, particularly if only a limited number of countries were to ratify the instrument. The Secretariat remarked that the elegance of the contractual approach was that it at least has the potential of offering a truly global solution.

25. The Delegation of the United States of America stated that INNs were generic terms and had no source-identifying capacity. They should be free for use by anyone. Only if there were compelling policy reasons should deviations be made from this principle. In light of the lack of demonstrable harm resulting from the registration of INNs as domain names, the Delegation was of the view that such compelling reasons do not exist. While attempting to prevent harm from arising in the future was a commendable approach, the Delegation expressed concern about the spill-over effects which the establishment of protection for INNs might have in other areas. For instance, plant variety names were established in a similar manner as INNs. The Delegation raised the question whether establishing protection for INNs in the DNS would therefore not also lead to pressure for creating special protection for plant variety names. This raised the question where the limit would be drawn in terms of which real-world identifiers to protect and which not.

26. The Representative of the World Health Organization (WHO) stated that the problem of INNs was often not well understood. The Representative explained that INNs were unique identifiers aimed at patients' safety. The Representative observed that industry itself had requested that measures be taken to protect INNs in the DNS, because several companies had been approached with offers to purchase domain names corresponding to INNs. The Representative remarked that INNs were registered as domain names for a variety of purposes. Sometimes they were registered as a preventive measure, in order to ensure that the name could not be abused. Many domain names corresponding to INNs did not have a website associated with them, suggesting that registrants were taking a wait-and-see approach, but might use them in the future. Others were used for purposes of promoting particular commercial products. Still others were used for informational purposes, but there was no control over the quality of the information provided. The Representative was of the view that registration of an INN as a domain name provided a de facto monopoly over the term, which was contrary to the fundamental policy objectives underlying the INN system.

Names of International Intergovernmental Organizations (IGOs)

27. The Delegation of the European Community expressed support for the Report's recommendations on this issue.

28. The Delegation of the United States of America stated that, according to its understanding of the record, many problems encountered by IGOs seem capable of being resolved through informal discussions with domain name registrants, who often appeared to be willing to deactivate websites that were the subject of complaints on the part of IGOs. The Delegation recognized, however, that even if such websites were deactivated, the domain names at issue remained registered in the name of the offending registrant. Nonetheless, the Delegation was of the view that this raised the question whether the problem is of such magnitude that it required to be addressed. If the problem were found to be significant, the Delegation proposed that a study be made on how a subset to the UDRP could be created to solve the problem.
29. Following a question by the Delegation of Chile concerning the application of the Report's recommendations to the ccTLDs, a discussion followed on the relationship between ICANN, the administrators of ccTLDs and the governments of the countries and territories corresponding to the ccTLDs.
30. The Secretariat explained that this was a sensitive subject matter, which went beyond the scope of intellectual property, and that there was a wide variety in the nature of the relationships between governments and ccTLDs. It proposed that the manner in which the recommendations of the Report might be implemented in any particular ccTLD would need to take due account of the nature of the relationship and that different implementation models were possible in this connection.
31. The Delegation of France expressed support for the Report's recommendations on the topic concerned and proposed to discuss the modalities of how the recommended protection might be established.
32. The Delegation of the United Kingdom stated that it had no strong views on whether or not the extent of problems encountered warranted action, but suggested that, if action were to be taken, the modalities of protection would require further clarification.
33. The Delegation of Mexico stated that Mexico afforded protection to the names, acronyms and emblems of IGOs under Article 6 *ter* of the Paris Convention and therefore supported the Secretariat's recommendations. It expressed agreement with the view of the Delegation of France that the means of implementing the recommended protections should be investigated.
34. The Delegation of Australia shared the view of the Delegation of the United Kingdom on this topic. However, to the extent protection were to be established, it inquired what the legal basis for such action might be.
35. The Representative of the International Federation of the Red Cross and Red Crescent Societies inquired what action ICANN might be expected to take in relation to any decision of this body or any other WIPO body to establish protection for the identifiers at issue.
36. The Secretariat stated that these last two questions were among the central issues facing the SCT. Normally, at the international level, the legal basis for the action under consideration would take the form of a treaty. However, there was a widely held view that the treaty process was too lengthy and inflexible to offer adequate solutions for the problems

covered by the Report. For instance, if only a few countries were to ratify the treaty, it would be relatively simple for a user to avoid its application by locating its activity (for instance, the server) in a country where the treaty was not in force. The advantage of a contractually based system, such as the UDRP, was that it is globally enforceable without the need to resort to national courts and could avoid complex questions of applicable law. The essential question was how to reflect, within the ICANN system, a policy which falls beyond the scope of ICANN's mandate (which is the technical management of the DNS) and therefore was to be established by competent fora other than ICANN. In this respect, an alternative approach might take the form of a resolution by the General Assembly of WIPO or the Assembly of the Paris Union, which could be implemented in the DNS through the ICANN contractual system. This approach would require the cooperation of ICANN and more discussions would be required with member States on how best to ensure such cooperation. For further consideration, the Secretariat stated that one possible way of securing ICANN cooperation might take the form of a memorandum of understanding, as such a vehicle was now frequently used to record private/public sector arrangements at the international level (by, for instance, the International Telecommunication Union).

37. The Delegation of the United Kingdom was of the view that the contractual approach might be the most efficient means of achieving the desired result in the gTLDs, and, in due course, also in the ccTLDs. A contractual approach was also more consistent with current practices in the Internet in general and the DNS in particular.

38. The Delegation of Australia asked the Secretariat whether it would be possible to elaborate on the actual harm caused by the registration of the names and acronyms of IGOs as domain names.

39. The Secretariat explained that there was significant participation by international intergovernmental organizations in the Second WIPO Internet Domain Name Process. As part of the Process, the Office of Legal Affairs of the United Nations had expressed frustration about the situation, because the only available avenue for action to redress the abusive practices consisted of reverting to court action, which was hard to reconcile with the principle of immunity of IGOs. The Secretariat also referred to several concrete examples of the abusive registration of names and acronyms of IGOs as domain names, as documented in the Report.

40. The Delegation of Sweden stated that it was unsure of the true extent of the problem, but recognized that there might be good reasons why the issue was of concern to governments. The Delegation urged that an appropriate distinction be made between gTLDs and ccTLDs and stated that it would be preferable that any action that might be taken be confined to the gTLDs, at least as a start. The Delegation also expressed a preference for a contractual approach for dealing with the problem, which would more adequately reflect current practice for the management of the DNS.

41. The Delegation of Australia stated that, if the purpose was to eradicate bad faith practices, it would be desirable to do so both at the level of the gTLDs and the ccTLDs, although the specific modalities through which this could be achieved might have to differ from one ccTLD to another. The Secretariat clarified that the recommendations contained in the Report were aimed primarily at the gTLDs, but that they were also offered for

consideration to the administrators of ccTLDs, whomight wish to apply them on a voluntary basis.

42. The Delegation of the United States of America noted that IGOs would prefer absolute protection of their names and acronyms in the DNS, for which there currently would be no basis under Article 6 *ter* of the Paris Convention. Instead of such absolute protection, the Report recommended a more moderate form of protection in cases where the names and acronyms of IGOs were registered in bad faith and in a manner that was misleading to consumers. The Report recommended that a new administrative procedure be created for these cases, because certain aspects of the UDRP (the requirement that a complainant submit to the jurisdiction of certain national courts in relation to the dispute) would require IGOs to waive their immunity. The Delegation expressed several concerns with regard to the Report's recommendations. First, it was of the view that the creation of an administrative challenge procedure for exclusive use by IGOs would go beyond the protection currently offered by Article 6 *ter* of the Paris Convention. The Delegation illustrated this point by explaining that, under United States law, IGOs are required to resort to court litigation to enforce their rights under Article 6 *ter* of the Paris Convention. Secondly, if the IGOs were not required to submit to the jurisdiction of any court in relation to the dispute, there would be no opportunity for a registrant to appeal a decision emanating from the administrative procedure. Thirdly, the question would need to be addressed how the operation of the administrative procedure would be funded. Notwithstanding the above concerns, the delegation expressed a willingness to examine the possibility of creating a subset to the UDRP to address any perceived problems regarding this topic.

43. The Representative of the International Federation of the Red Cross and Red Crescent Societies (IFRC) explained that the name and emblem of the Red Cross were protected by specific provisions of the Geneva Conventions. The Representative inquired whether any other international organizations benefited from such strong form of protection for their names in their constituent instruments.

44. The Secretariat replied that it was not aware of any other organizations benefiting from such protection, but stated that, for instance, the Bank of International Settlements in Basel benefited from a provision protecting its name which was implemented in the national laws of certain jurisdictions.

45. The Delegation of Japan noted that, under certain circumstances, the registration or use of a domain name corresponding to the name or acronym of an IGO might constitute an infringement of the Paris Convention or the TRIPS Agreement. The Delegation identified the legal nature of the protection offered under those international instruments as the core issue to be addressed, which merits further study and discussion.

Personal Names

46. The Delegation of Australia noted that the Report recommended no action on the issue of personal names and expressed support for that recommendation.

47. The Delegation of the Republic of Korea shared the view of the Delegation of Australia, but added that a study on the protection of personal names in the real and virtual worlds would be desirable.

48. The Delegation of Switzerland stated that persons, who are commercially active and who have acquired a reputation in their personal names in one or more jurisdictions protecting unregistered marks, could find relief for the abuse of their names in the DNS under the UDRP. However, to the extent the activities of the persons in question were confined to countries in which unregistered trademarks were not protected, the UDRP would not offer them any protection. There was therefore a problem of unequal access to the UDRP which should be redressed. However, the Delegation recognized that such redress also could be achieved through the expansion of the scope of the UDRP to trade names and therefore wished to reserve its position on this question until that portion of the Report has been discussed in the Special Session.

49. The Delegation of France supported the view of the Delegation of Switzerland and stated that it would like to see the matter studied further.

Indications of Source and Geographical Indications

50. The Delegation of the European Community expressed concerns about the recommendations in the Report regarding geographical indications, in particular because they did not sufficiently take into account the problems encountered in connection with their registration in the DNS. Considering the provisions of the TRIPS Agreement, the Delegation disagreed with the position that the international legal framework was not sufficiently advanced to deal with the problem. The Delegation observed that marks also were protected differently from one jurisdiction to another and referred in this respect to the differing treatment of unregistered marks in Member States. The Delegation expressed the view that at the recommendations of the Interim Report were more appropriate and requested additional explanations why geographical indications would not warrant the same protection in the DNS as marks. The Delegation also recalled that panelists were primarily asked to rule upon the existence of abuse, rather than the validity of rights.

51. The Delegation of France emphasized the need to protect geographical indications and said that such indications constituted intellectual property rights long recognized as such, and should be protected irrespective of the medium, including on the Internet. The Delegation added that geographical indications represented a vital source of economic value for all countries with a heritage to be protected. The Delegation also noted the increasing number of instances of bad faith and, in line with the Delegation of the European Community, said that the UDRP offered a satisfactory method of protecting geographical indications on the Internet and that it should therefore be extended to such indications.

52. The Delegations of Chile, Hungary, Switzerland and Turkey expressed their support for the position of the European Community.

53. The Delegation of the United States of America observed that the UDRP had proved useful because there existed a sophisticated international understanding of trademark rights. Even if the procedures for obtaining trademark registration varied throughout the world, the Delegation believed that there was core agreement regarding the subject matter eligible for protection as a registered trademark (e.g., words and phrases). The Delegation noted that the Report itself stated that, unlike for trademark rights, geographical indications were not defined nor protected similarly around the world. Given the different systems of protection

for geographical indications and the evolving world thought on what constituted a geographical indication, the Delegation stated that UDRP cases involving geographical indications would not be obviously bad faith squatting cases. The Delegation explained that, while the concept of "bad faith" might be a constant, proof of "bad faith" would run the continuum from obvious and easy to subtle and complex. The Delegation believed that evidence of "bad faith" would fall into the "subtle and complex" end of the continuum and supported this point of view by the fact that some terms (e.g., "CHEDDAR") considered protected terms in one country were equally considered obvious generic (unprotectable) terms in other countries. Without a clear international understanding of what were geographical indications, the Delegation was convinced that UDRP panels would, in fact, be given the responsibility of creating new, internationally binding law. The Delegation recalled that the Panel Report itself cautioned against such a result, stating that, "new laws should only be effected through a representative and legitimate authority." The Delegation further stated that panelists would be in a position of giving extra-territorial effect to the laws of one country, at the expense of the laws of a competing sovereign. The Delegation questioned whether world thought on issues of jurisdiction, choice of law, and extra-territorial effect had yet evolved to the point where sovereigns would be comfortable with accepting the opinion of a one or three person panel in rendering decisions with universal effect.

54. The Delegation of the European Community expressed disagreement with the position of the Delegation of the United States of America and stated that, in light of the fact that there existed international norms and definitions of geographical indications, in particular in the TRIPS Agreement, it would be inconsistent to protect marks through the UDRP and not geographical indications. The Delegation recognized that certain terms might be considered generic in a number of jurisdictions, but explained that this could also be the case in relation to marks and was therefore not a problem that arises solely in connection with geographical indications. The Delegation stated that an assessment would need to be made by competent panelists of whether a geographical indication had been abused in the domain name registration process, in a manner similar to how the UDRP operated with regard to marks.

55. The Delegation of Australia expressed support for the position of the Delegation of the United States of America. While the Delegation agreed that there was a uniform definition of geographical indications at the international level in the TRIPS Agreement, there remained important differences between jurisdictions on how to acquire, maintain and protect rights in geographical indications. According to the Delegation, in light of the latter differences, providing protection through a single procedure, such as the UDRP, would result in the creation of new law, cutting across various differing domestic laws.

56. The Delegation of Guatemala stated that, in its view, the international legal framework for geographical indications was not sufficiently developed to allow, at this stage, panels constituted under the UDRP to solve conflict between geographical indications and domain names.

57. The Delegation of the Ukraine supported the positions of the European Community, France and other Delegations, favoring the protection of geographical indications in the DNS, because abuse and confusion to the public should not be permitted in any circumstances.

58. The Delegation of Romania also expressed support for the point of view of the European Community.

59. The Delegation of Venezuela, while expressing support for the position of the European Community, requested that the matter be studied further.

60. The Delegation of Algeria emphasized the need to protect geographical indications using the most appropriate legal means. Referring to the current dispute involving South Africa, whose name had been registered as a domain name, the Delegation wondered how such a matter could be resolved and what means of protection could be envisaged, either on the assumption that the UDRP would be extended to geographical indications, or in the opposite case.

61. The Delegation of Switzerland referred to the concern expressed by the Delegation of Australia and recognized that extending the UDRP to geographical indications would likely result in panelists having to deal with delicate questions of application of national law and scope of protection to be granted. However, the Delegation noted that such questions were not new, for panelists had to address questions of unregistered marks under the UDRP. The questions that needed to be examined were first, what was the national law that applied to the claimed unregistered trademark, second, what were the conditions under which that law granted protection, and third, whether those conditions were met. The Delegation stated that this examination took place on a case-by-case basis, as there were no harmonized rules. The Delegation also commented on the situation where a defendant might claim that its registration and use of the domain name was legitimate and in good faith, because the term at issue was deemed generic in the registrant's jurisdiction. The Delegation remarked that such situations could arise in relation to trade or service marks. The Delegation therefore concluded that no special or different conditions attached to the consideration of geographical indications under the UDRP than those attached to trade and service marks.

62. The Delegation of France emphasized that the object of the debate was to protect existing rights on the Internet and not to attempt to harmonize national rights. The Delegation also noted that it was not a matter of granting jurisdictional authority to the arbitrators. Moreover, the Delegation observed that numerous States were currently adopting legislation designed to protect geographical indications and, in this regard, it would be a pity if the efforts of those States were reduced to nothing by individuals registering domain names that usurped geographical indications.

63. The Delegation of Panama noted that the legal instruments of the Paris Convention and the TRIPS Agreement created rights concerning geographical indications. The Delegation noted that the Report had given evidence of cases where geographical indications had been registered as domain names by persons without any connection to the geographical place, that the Report had found international law inadequate to protect geographical indications in the DNS, and that new instruments were necessary to solve this problem. For this reason, the Delegation supported the recommendations in the Report.

64. The Delegation of Senegal recalled the existence of an organization that grouped together 16 countries, in accordance with the Bangui Agreement. The Delegation mentioned that as part of the entry into force of the TRIPS Agreement, the Bangui Agreement had been revised and, when the latter Agreement came into force, it would enable countries to put in place measures aimed at protecting geographical indications. The Delegation underlined that as part of this subregional agreement, a single geographical indication could be extended to

several countries and, in that connection, the question of determining the right that could be held by each State arose. The Delegation noted the usefulness of the Bangui Agreement in the face of such a difficulty, insofar as the Agreement constituted a uniform law for all States. Finally, the Delegation highlighted Senegal's concern regarding the protection of geographical indications on the Internet, and noted the transfer of practices considered to be unlawful in developed countries to developing countries where national laws preventing such practices did not exist.

65. The Delegation of the Russian Federation noted that, in the Russian Federation, protection was provided only for one type of geographical indication, namely appellations of origin. The Delegation noted that the question of protection of geographical indications on the Internet was difficult because protection was differently granted in different countries and would be difficult to harmonize. The Delegation expressed the view that the precise form of protection was not critical. The important point, according to the Delegation, was that there was a right in a mark and that confusion to the public should be avoided. The Delegation expressed the view that the same principles should be upheld in relation to geographical indications, irrespective of the form of protection they were granted in different jurisdictions. The Delegation therefore agreed with the position put forward by the Delegation of the European Community.

66. The Delegation of Chile, referring to the intervention by the Delegation of France, noted that this meeting was not aiming for an agreement on one system of protection, but sought to provide opinion about whether geographical indications should be protected under the UDRP. The Delegation drew a distinction between false indications of origin and geographical indications, and noted the remarks of the Delegation of Australia with regard to the sui generis protection of such identifiers. The Delegation noted that false indications of source did not require protection, but that a framework for protection of geographical indications was established by the TRIPS Agreement, which also defined geographical indications and required States to grant them protection. The Delegation noted that the principles relating to geographical indications under the TRIPS Agreement could apply to any form of protection of that category of industrial property, and therefore did not standardize the way in which countries could grant protection, whereas they did provide a collective framework for such protection.

67. The Delegation of the United States of America raised a point for consideration of the meeting by noting that most delegations had indicated that there existed a well-understood definition of geographical indications in the TRIPS Agreement, which might apply directly to the DNS and could be enforced under the UDRP. The Delegation hypothetically put itself in a domain name case panelist's position, deciding a dispute concerning a geographical indication, and noted that the panelist would have to ask first, looking at Article 22(1) of the TRIPS Agreement (which applies only to goods, and not services), what the legal situation would be if the domain name corresponding to a geographical indication was used in relation to services, for example, tourism. Second, the panelist would have to enquire if the domain name was functioning as a geographical indication and therefore eligible for protection (i.e., identifying goods originating in a territory where a given quality or character of the goods was attributable to their geographical origin). The Delegation gave the example of <americantourism.com> and asked whether a domain name used in the context of a tourism service would be eligible for protection as a geographical indication, raising questions whether the United States was known for its tourism services and whether an essential

characteristic of the good was derived from the United States. From this, the Delegation concluded that Article 22(1) did not provide a clear definition of geographical indications. The Delegation noted that, in respect of trademarks, although Article 15(1) of the TRIPS Agreement detailed eligible subject matter, this issue still required further clarification, despite 100 years of legal development. The Delegation concluded that the international community was now only at the preparatory stage of discussing the definition of a geographical indication and that a lot of debate was still necessary before such identifier could be protected by a procedure such as the UDRP.

68. The Delegation of the European Community expressed the view that the distinction between goods and services in relation to geographical indications was beyond the scope of the present discussion and did not pose any particular difficulties in relation to the UDRP. The Delegation noted that the Report of the first WIPO Internet Domain Name Process had established that the questions to be resolved by a panelist were confined merely to whether the domain name was identical or misleadingly similar to the protected identifier, whether the registrant had any rights or legitimate interests in the domain name and whether the domain name had been registered and used in bad faith. The Delegation recognized that domain names corresponding to geographical indications could be used in relation to services (e.g., <tequila.com> could be used to promote party services) in which case, even though protection of the geographical indication 'tequila' could be claimed, no rights would be infringed. In this respect, the Delegation noted that the central question was whether the name was abused in a manner contemplated by the UDRP.

69. The Delegation of Australia expressed its support for the Report's recommendations on geographical indications and noted that it did not share the views expressed by the Delegation of the European Community. The Delegation noted that the international framework for protection of geographical indications was at a preparatory stage and the fundamental framework for the protection of geographical indications remained to be agreed by the international community. Referring to document SCT/6/3, the Delegation stated that there was a lack of common understanding surrounding this protection, and that it would therefore be premature to attempt to reflect the current state of international law in a global dispute resolution process for geographical indications in the DNS. The Delegation noted that there was no clear consensus on what is the definition of a geographical indication in accordance with the TRIPS Agreement and that there remain considerable differences in recognition of rights in geographical indications at national levels. The Delegation also noted the difficulty in addressing the application of exceptions and the unresolved question of treatment of homonymous geographical indications. The Delegation emphasized that it was not appropriate for domain name panelists to decide questions of applicable law and thereby create international law, which was legitimately created via intergovernmental processes that took into account the broader context of geographical indications in the physical world. The Delegation stated that these questions, addressing the use and misuse of geographical indications online, warranted discussion in the SCT, which was the appropriate forum for such discussions. Further, the Delegation noted that such SCT discussions need not interfere, but would complement, this Special Session's consideration of the Report and the Delegation anticipated the critical work that would take place on the issue of geographical indications in the ordinary sessions of the SCT.

70. The Delegation of the European Community clarified that it had not supported the extension of legal protection of geographical indications, but proposed that the existing

protection established under the TRIPS Agreement should be recognized to the DNS. The Delegation noted that the Member States had endorsed this approach at their Assemblies on October 3, 2001.

71. The Delegation of the United States of America expressed its willingness to participate in the substantive work that remained to be done in the area of geographical indications, and recalled its intervention to this effect at the September 2000 and March 2001 meetings of the SCT. The Delegation remarked that the international community was on the threshold of agreement on the issue of geographical indications, but that there was at present no clear fundamental understanding of what may constitute a geographical indication and no agreement on protectable subject matter: for example, the Delegation noted that Members were not in agreement as to whether a country name could be a geographical indication. Further, the Delegation noted a lack of agreement on whom may own a geographical indication and remarked that this was a fundamental issue yet to be addressed. The Delegation stated that trademarks and geographical indications raised different considerations: for example, the international community shared a clear understanding that individuals might own and assert rights in trademarks, whereas there was no consensus on whether individuals might own or assert rights in geographical indications. The Delegation also remarked that there was no consensus on how geographical indications might be created, and whether natural or legal persons might set standards for geographical indications. Further, the Delegation noted that, in the absence of agreement on the term of a geographical indication, this important question had to be debated, together with the issue of how geographical indications might be challenged, cancelled or de-authorized. Finally, the Delegation stated that these questions should be addressed by the SCT in its ordinary sessions, so that an international consensus and guidance could be gained.

72. The Delegation of Canada noted, referring to the Report, that considerations of domain names and geographical indications were difficult and raised strong and divided views among Members. The Delegation noted that the UDRP was functioning inefficiently at this time and supported the recommendations made in the Report that, in order to maintain the integrity of the UDRP, more considerations should be given to the issues before extending its application to geographical indications. In this respect, issues to be considered included questions of applicable law, the lack of harmonization in the international legal system for geographical indications and the appropriate mechanisms for the creation of new law. The Delegation noted that the scope of protection for geographical indications was currently limited to goods only, whereas a domain name registration incorporating the unauthorized use of a geographical indication might not violate international rules as there might be use of the domain name in connection with goods. The Delegation expressed its concern that the UDRP was not the appropriate mechanism for extending the protection granted to geographical indications and noted that these issues should be considered in a broader context. Finally, the Delegation stated that the ordinary SCT meetings provided the appropriate forum for considerations of these questions.

73. In response to the statement made by the Delegation of the United States of America, the Delegation of France emphasized that the distinction between the question of geographical indications on the one hand, and the protection of such indications against their registration in bad faith as domain names on the other, had been the subject of a decision by the Assemblies of the Member States. The Delegation said that it was therefore difficult to renege on a decision taken by a higher authority. The Delegation added that, although the question of

geographical indications was referred back to the ordinary session of the SCT, it intended to formulate a number of clarifications relating to the matters raised by the Delegation of the United States of America. As regards the question of whether a country name could constitute a geographical indication, the Delegation stated that under the TRIPS Agreement such a hypothetical situation could be envisaged. The Delegation underlined, however, that the features or reputation of a product were generally linked to a more restricted area than that of the whole of the territory of a country. As to who could own a geographical indication, the Delegation said that since such indications were collective user rights, only producers in the area of the geographical indication could use the name and concluded that the indication did not belong to a single person. As to whether a natural person could contest a domain name, the Delegation said that this was possible, and considered that it was in the interest of a producer located in a geographical area benefiting from a geographical indication to act against the registration in bad faith of a domain name corresponding to said geographical indication. As to the duration of protection for the geographical indication, the Delegation emphasized that such a period was unlimited. As regards whether a geographical indication could be revoked, the Delegation stated that such a hypothetical situation, which was extremely rare, could be envisaged only in cases where all the features of the product were no longer present or also if the State concerned considered that the geographical indication should no longer exist and made appropriate provision for that purpose. Finally, the Delegation confirmed that it was essential to protect geographical indications on the Internet and emphasized that, in line with the Delegation of the European Community, it was not a matter of discussing such protection in general terms throughout the world but in relation to domain names.

74. The Delegation of Guatemala stated that, in view of the lack of international consensus on the issue of geographical indications, it did not support the extension of the UDRP to include geographical indications. The Delegation noted that such an extension of the UDRP without international consensus on the underlying issues would raise significant questions of applicable law, and that such issues would be appropriately raised in the SCT.

75. The Delegation of Australia expressed its understanding that the issue under consideration was whether existing protection for geographical indications could be enforced in the DNS under the UDRP. The Delegation noted that, given the lack of consensus among the international community as to the treatment of geographical indications, such an extension of the UDRP would force domain name panelists to address questions of how and whether a geographical indication was established, who owned the geographical indication and therefore who had standing to bring a claim. In the process, panelists would be required to create international law and thereby extend the system for protection for geographical indications. The Delegation stated that these issues are properly addressed in the regular meetings of the SCT. The Delegation emphasized the need for an international consensus to provide an adequate basis to protect existing rights in geographical indications.

76. The Delegation of Japan, summarizing the discussions, noted that with INNs and IGOs, a form of international legislative system already existed: INNs under a number of Resolutions of WHO, and IGOs under the auspices of the Paris Convention. The Delegation noted that, so far as protection of country names was concerned, reference could be made to the ISO 3166 list of country codes. The Delegation drew a distinction in the case of geographical indications, which were complex and whose protection in the DNS was difficult. The Delegation noted the related discussion taking place in other fora, such as the WTO in

the context of the TRIPS Agreement, and remarked that steps in this area should be carefully taken.

77. The Delegation of the European Community, referring to the definition of geographical indications in Article 22(1) of the TRIPS Agreement, expressed the view that there existed agreement at the international level as to what a geographical indication was, while discussions focus on the distinct question of how to develop their protection. The Delegation noted that the outcome of the WTO Ministerial meeting in Doha had included the establishment of a multilateral registry of geographical indications for wines and spirits (under TRIPS Agreement, Article 23(4)) to come into force by Spring 2003 and the extension of the protection provided in Article 23 to products other than wines and spirits. The Delegation described the concern expressed by the Delegations of the United States of America, Canada and Australia, as relating to the principle of protection, which, in the Delegation's view, had already been agreed at the international level. The Delegation noted that the question of who could register a geographical indication in the DNS and the rightsholder whom might bring a claim under the UDRP (whether a government, association, individual, etc.) would be decided under each legal system and was not required to be harmonized in order to include geographical indications in the UDRP. The Delegation noted that the harmonization of the term of protection of geographical indications also was not a precondition to their inclusion in the UDRP, because the UDRP would protect a rightsholder so long as their right in the geographical indication was valid. The Delegation remarked that panelists applying existing law relating to geographical indications, similarly to those applying trademark law to cybersquatting cases, were not creating new law despite the lack of harmonization, but simply recognizing existing agreed rights at the international level. Noting the WTO's proposed multilateral register for geographical indications, the Delegation remarked that it would be wise for this meeting to recognize the existing foundation for protection of geographical indications at the international level by extending that protection to the DNS. The Delegation remarked that the mandate to address the issue of geographical indications in the DNS had been given to the Secretariat at a meeting in Sydney in 2000 and it was the Special Session's responsibility to address this.

78. The Delegation of Australia noted that, rather than advocating harmonization of law, what was required was an international consensus on the underlying principles for protection of geographical indications. The Delegation stated its view that the Delegation of the European Community had mischaracterized the degree of consensus on the work to be carried out in the WTO and TRIPS Council.

79. The Delegation of the United States of America noted that the question of who is a rightsholder is a fundamental question of direct application to discuss issues relating to the UDRP. The Delegation stated that the UDRP was designed to efficiently resolve clear cases of trademark cybersquatting involving an owner with a right and another party without ownership rights who was acting in bad faith. By contrast, the Delegation noted that complaints involving geographical indications would involve conflicts with competing claims of legitimacy that would commonly result in protracted UDRP disputes, often involving claims of generic use (e.g., <champagne.com> might be deemed a generic term, and therefore free for registration and use as a domain name, in certain jurisdictions, but might be protected in others). The Delegation concluded that at this stage, given that many UDRP cases involving geographical indications would not be clearcut, it was premature for this meeting to extend protection of geographical indications to the DNS.

80. The Delegation of the European Community, referring to the example of <champagne.com>, noted that persons other than the owner of the geographical indication would have the right to use that identifier in the DNS under the UDRP, if such use was legitimate under their national legal system. The Delegation noted that an analogous situation existed under trademark law, where protected trademarks in one jurisdiction may be generic words in other jurisdictions, but that the requirement of bad faith under the UDRP meant that such situations were not difficult to resolve. The Delegation noted that whether in any one case the use of an identifier was legitimate depended on whether the use being made of the domain name was determined by the panel to be in bad faith, not the mere act of its registration as a domain name. The Delegation noted that if there was no bad faith use being made of the geographical indication, then no grounds would exist to prevail on a complaint brought under the UDRP.

81. The Delegation of Italy supported the view of the Delegation of the European Community and stated that it saw an equivalence between trademarks and geographical indications in the context of the DNS. The Delegation drew a parallel with the United States Digital Millennium Copyright Act which provided for a simple notice and takedown procedure in cases of manifest copyright piracy on the Internet, despite the fact that questions of copyright ownership and exceptions and limitations also were most complex. The Delegation noted that there were several norms regarding geographical indications at the international level, including those in the Lisbon Agreement and the TRIPS Agreement, and stated that what was sought was not the creation of new norms, but the enforcement of those that already existed in the context of the DNS.

82. The Representative of the International Wine Law Association (AIDV) stated that the members of his Organization relied on the DNS to conduct their businesses and, in doing so, made use of rights accorded to them by the industrial property system. The Representative observed that there appeared to be consensus on the fact that there existed problems in relation to geographical indications on the Internet, but that there was no consensus on whether any actions should be taken to redress these problems. As a possible solution, the Representative referred to the Joint Recommendation Concerning Provisions on the Protection of Marks, and Other Industrial Property Rights in Signs, on the Internet, as adopted by the WIPO General Assembly and the Assembly of the Paris Union. The Representative noted that the Joint Recommendation applied also to "other industrial property rights" and proposed that this language be integrated into the UDRP to broaden its scope to all industrial property rights.

83. The Representative of the International Federation of Industrial Property Attorneys (FICPI) stated that it had no objections in principle against the extension of the UDRP to geographical indications, but noted that numerous issues were unclear, which would render the task of panels constituted to rule upon conflicts between geographical indications and domain names under the UDRP difficult. Furthermore, the Representative stated that it would be difficult for ICANN to implement an extension of the UDRP to geographical indications through its contractual system because it was unlikely that a consensus would emerge on this issue within the relevant ICANN bodies. The Representative recalled that the purpose of the UDRP was to solve manifest problems quickly and observed that introducing the complex area of geographic indications into the UDRP would not be consistent with that goal.

84. The Delegation of the United States of America stated that it did not believe the problem encountered in relation to geographical indications in the DNS was of such a nature that it warranted an intellectual property solution through the UDRP. Furthermore, the Delegation expressed its understanding that the Joint Recommendation Concerning Provisions on the Protection of Marks, and Other Industrial Property Rights in Signs, on the Internet did not apply to domain names.

85. The Delegation of France spoke in response to the previous statement made by the Delegation of the United States of America, according to whom no problems currently existed to justify the extension of the UDRP to geographical indications. The Delegation referred to the numerous examples of registrations in bad faith of geographical indications as domain names appearing in Annexes 8 and 9 of the Report. The Delegation emphasized that these examples represented only an illustration of a more widespread problem, and therefore concluded that an urgent problem existed which called for protection of geographical indications that were legally recognized, had significant economic value and were used in bad faith.

86. The Delegation of Australia recognized that geographical indications had been registered as domain names, but questioned whether all such registrations were necessarily inappropriate or in bad faith, particularly because the terms at issue might be deemed generic in certain jurisdictions.

87. In response to the statement made by the Delegation of Australia, the Delegation of France emphasized that it endorsed the position of Australia insofar as an assessment of bad faith was necessary in order to ascertain how the problem was to be solved. The Delegation made it clear that France's position was to favor extension of the UDRP in cases of improper registration of geographical indications as domain names.

Geographical Terms

88. The Chair requested the Secretariat to provide clarifications on the Report's treatment of ISO 3166 country codes, Annex 12 of the Report and the relationship between ICANN, the Government Advisory Committee of ICANN (GAC) and the SCT process.

89. The Secretariat noted that the GAC was the body recognized by the By-Laws of ICANN (a not-for-profit corporation established under the laws of California) as a consultative policy body with advisory powers only. The Secretariat explained that the GAC normally met immediately before ICANN's public meetings and was composed mainly of officials from telecommunications ministries with officials from industrial property offices also attending some meetings. The Secretariat explained that Annex 12 of the Report, containing a list of domain names corresponding to country names registered by persons mostly unconnected with the countries in question, was not an exhaustive list, but merely illustrative. The Secretariat noted that in some cases, such as <australia.com>, which is registered by an official tourist authority, the domain name was not unconnected with the Government concerned. Finally, the Secretariat explained that the recommendations in the Report concerning ISO 3166 country codes were in response to a GAC advice calling for protection of these codes in the gTLDs because, in certain instances, they had been used in a manner which caused confusion with the ccTLDs.

90. The Delegation of France considered that the use of a country name as a domain name, a number of examples of which were included in Annex 12 of the Report, could not continue and that, given the importance of country names, a way of protecting those names should be found.

91. The Delegation of Chile noted that the registration of country names as domain names was a great problem and of serious concern to States. The Delegation gave the example of <chile.com>, which was not registered by the Government of Chile.

92. The Delegation of Sweden commented that it would be difficult to take action on all areas raised by the Report, and that a list of priorities would be helpful in this respect. The Delegation noted its view that protection of names of places, such as cities, was a difficult issue because multiple cities may share the same name and the decision as to which place could legitimately claim the name would be problematic. The Delegation expressed its agreement with the Report's recommendation on ISO 3166 country codes, as this would minimize potential confusion to users. The Delegation noted that, in an initial phase, country names could be protected, as their misuse in the DNS was an area of concern to Member States and their names were limited in number. Nonetheless, the Delegation noted that at further discussion was necessary on the questions of how to determine the name of a country and in what languages protection ought to be granted.

93. The Delegation of Netherlands stated that, until recently, limited protection was granted to names of cities, towns and provinces in the .NL ccTLD and that similar protection could be provided generally at the ccTLD level. The Delegation also noted its concern, as evidenced in Annex 12, that <amsterdam.com> had been registered in connection with disreputable services, and remarked that the names of countries, cities, towns and provinces did need some form of protection, particularly in the ccTLDs.

94. The Delegation of Kenya noted that the registration of country names and indigenous names by unconnected individuals was a serious concern that requested attention in an international forum. The Delegation noted with concern that the names Kenya (country name) and Maasai (an indigenous group in Kenya) had already been registered in such manner.

95. The Delegation of the United Kingdom endorsed the comments of the Delegation of Sweden, and noted that priority areas for action needed to be identified. The Delegation noted that the ISO 3166 standard does not provide a precise list of country names. However, the ISO 3166 standard could provide a good starting point for such a list. The Delegation emphasized that any mechanism for protection had to be simple and easily understood.

96. The Delegation of France supported the recommendation contained in the Report whereby the question of protection for the names of countries, regions and municipalities should be considered within an appropriate intergovernmental authority and the need to create new international rules for the protection of those names determined. Furthermore, the Delegation emphasized the importance of extending such protection both to gTLDs and ccTLDs, since acts of bad faith occurred in both cases.

97. The Chair remarked that the interventions indicated the Member States' concern that actions should be taken to protect, in particular, country names in the DNS, but posed the

question how such protection could be granted. The Chair noted that only two Special Sessions were scheduled before a report was to be provided to the WIPO General Assembly. The Chair therefore called for proposals to concretely address the concerns that had been expressed by delegations, including France, Chile, Sweden, the Netherlands, Kenya and the United Kingdom.

98. Assuming that protection was favored and that steps were required to concretize this desire, the Secretariat raised a number of questions for consideration by delegations. First, which terms should be protected? In this respect, it was noted that delegations had expressed a view that protection be granted to country names as a priority (and perhaps also ISO 3166 country code elements). Second, which mechanism could be employed to identify the name of the country to be protected? Would this be a system of self-nomination or would it be based on the United Nations Terminology Bulletin (ST/CSSER.F/347/Rev.1), as utilized by the Secretariat in drafting the Report. Third, in which domains should protection be granted? In this respect, the Bureau noted that the question of protection of geographical terms was urgent, as there are signs that the current introduction of seven new gTLDs, if successful in ICANN's estimation, might be followed by further new domains which would provide more scope for registration of such terms by persons unconnected with them. Fourth, should protection be granted prospectively or also retrospectively? In the latter case, the Secretariat observed that this might entail the cancellation of existing domain name registrations and possibly also of acquired rights. Fifth, which mechanisms should be employed to grant protection: the UDRP or some other, more absolute, form of protection (e.g., an exclusion mechanism)? Sixth, should protection be granted for the exact name only or also for misleading variations of the name (e.g., in respect of <unitedkingdom.com> or also <united kingdom.com>)? The Bureau noted that these complex questions would need to be addressed if protection were recommended.

99. The Delegation of the Republic of Korea noted that, even though names of countries and cities might not be regarded as forms of intellectual property, the Delegation would still support their protection in the DNS. The Delegation suggested that protection should be extended to names of countries (the full name, as well as the short name) and their capitals, as recognized by all other nations, and noted that extending protection to regions and municipalities would raise complex questions. The Delegation expressed a preference that such protection be granted retrospectively and that reasonable remunerations should be paid to the domain name registrants should it lose its registration. The Delegation noted that protection should be extended to the exact name first and that the question of protection of variations of names could be considered at a later stage.

100. The Delegation of the United States of America suggested that the problems expressed in relation to country names and other geographical names may not require a solution in international law. The Delegation stated that the forced development of international law in the context of the DNS was not, in its view, a proper approach, and preferred the development of international law by a treaty process through which national governments would have time to consider the implications and outcomes of any agreement. The Delegation remarked that there were numerous problems that could follow from the creation of international law to protect country names. For instance, if country names were protected as intellectual property through Article 6 *ter* of the Paris Convention, in the United States, thousands of valid trademark registrations containing variations of country names could be affected. The owners of such marks might be required to prove that they obtained permission to use the name of

their own country in relation to their goods, even if this use was incidental. The Delegation noted that, in view of the different standards applied to geographical names and then a nature of the problem, such names could be protected most appropriately at the ccTLD level.

101. The Delegation of the United Kingdom noted that a problem lay in the fact that no acceptable list of country names existed as a standard. The Delegation noted that the absence of such a list posed a significant barrier to solving the problem of protection of country names.

102. The Secretariat confirmed that no standard list of country names existed in international law and that the determination of such names was a question of some controversy in a small minority of cases. The Secretariat noted that the United Nations Terminology Bulletin contained the most widely accepted list of country names, both in their full and short form.

103. The Delegation of Chile expressed its disagreement with the Delegation of the United States of America and noted that the problem of country names could not be solved solely at the level of the ccTLDs. The Delegation questioned why the mechanisms proposed in the Report for the protection of country names differed and were less detailed than the mechanisms proposed for INNs and IGOs, emphasizing that the protection of countries names was equally important.

104. The Delegation of the United States of America clarified its earlier statement, noting that, while country names might deserve protection, the Delegation did not believe that this issue required the development of new international law. The Delegation noted that country names were currently not protected as intellectual property, as opposed to the names of IGOs under Article 6 *ter* of the Paris Convention. The Delegation stated that, if Member States were of the view that country names required protection, it preferred that such protection were granted at the ccTLD level, as opposed to using Article 6 *ter* as the vehicle for protection. The Delegation noted that such protection, in the context of the DNS, might be best discussed in the GAC at ICANN, which was better positioned to take business-related, as opposed to intellectual property-related, decisions. The Delegation stressed that it was not in the interests of the countries to develop ad hoc solutions for the protection of country names, which would apply only on the Internet. The Delegation noted its preference for a principled intellectual property approach, and stated that, in its view at this time, country names should not be protected as intellectual property.

105. The Delegation of the European Community expressed its agreement with the comments of the Delegation of the United States of America as to whether country names were intellectual property, and noted that such names were not originally included for protection in Article 6 *ter* of the Paris Convention. However, the Delegation observed that, simply because country names were not considered to be intellectual property, their protection should not be overlooked. The Delegation noted that WIPO had a mandate from its Member States to study these issues and, even if not strictly within the realm of intellectual property, the work reflected a problem that affected Member States. The Delegation stated that, if an agreement was reached by the Member States to protect such names, then ICANN should also be directed as to the best way to implement such protection. The Delegation noted it did not favor any one particular method of dealing with the problem, but that the solution could consist of a combination of various measures, including protection at the ccTLD level, use of the ICANN contractual system, or an agreement between States and the GAC.

106. The Delegation of the United Kingdom reiterated that the problem of how to convert the ISO 3166 standard into a standard list for protection of country names posed a barrier to progress.

107. The Secretariat clarified that the ISO 3166 standard includes territories not recognized as States in the international context and also included entities or parts of States. The Secretariat noted that the International Organization for Standardization (ISO) was not an intergovernmental organization, but was a non-governmental organization with a mission to promote standards. The Secretariat stated that a name of a country could be determined through self-nomination, but that the results of such a method might not be universally accepted in all cases. The Secretariat noted that this problem had been resolved by the United Nations Terminology Bulletin, which functions primarily as a translation device and has no formal status in law. The Secretariat observed that the United Nations Terminology Bulletin, which is used by WIPO for treaty depositary notifications, might constitute a more appropriate basis for protection of country names than the ISO 3166 list.

108. The Delegation of Turkey expressed its support for the protection of country names, but asked in which languages such protections should be granted and whether protections should be extended to all languages or only to those most commonly used. The Delegation noted that the protection of city names was a more difficult issue, as more than one person or entity could share those names. For example, the Delegation noted that the name of the city of Aydin in Turkey, was also used as a personal name and as a company name. The Delegation noted that the names of municipalities, cities and other geographic names therefore would be problematic to protect, unless they also qualified as geographical indications.

109. The Delegation of Australia stated that it did not share the same enthusiasm for protecting country names as other delegations, but noted that it was clear from the debate, the Report and the comments submitted by participants to the Second WIPO Process, that there existed widespread concern about this issue, which needed to be resolved. The Delegation agreed with the Delegation of the United States of America that it was important not to imbue the names of countries with status as forms of intellectual property. The Delegation stated that it was not clear whether this issue should be addressed only at the second level of domain names or also at the third level, whether by a contractual arrangement with ICANN or otherwise, whether in the gTLDs or also in the ccTLDs, whether solely in relation to the abusive registration and use of domain names or in all cases, whether only in relation to identical domain names or also domain names that are variations of country names. The Delegation observed that, while it considered it important not to imbue country names with the status of intellectual property so as not to distort the intellectual property system, it was also important to recognize the role of WIPO in developing any mechanism of protection.

110. The Delegation of Guatemala noted that protection of country names was an important issue, whether such names were protected as intellectual property or not. The Delegation asked whether, if such names were not considered to be intellectual property, the meeting had the competence to consider the issue of their protection, and posed the question whether this might more appropriately be dealt with at the level of the ccTLDs.

111. The Delegation of Honduras endorsed the concerns of other delegations and expressed its interest in further discussion on this matter in order to find a solution to the problem which confronted numerous countries.

112. The Delegation of China expressed the view that the issues should be treated in accordance with international law. It noted that, as far as geographical indications and trademarks were concerned, Chinese law provided that geographical indications could be registered as collective and certification marks. The Delegation noted that the use of country names in some commercial circumstances was valid, and remarked that each situation would need to be analyzed on a case-by-case basis.

113. The Delegation of Australia endorsed the suggestion made by the Delegation of China that any protection for country names in the DNS should allow for the legitimate use by trademark and business name owners (e.g., China Bicycle Co.). The Delegation referred to the intervention of the Delegation of Guatemala, as to whether this meeting was the appropriate forum, or whether the GAC was the appropriate forum, and emphasized that delegations should not allow this issue to bounce indefinitely from one forum to another. The Delegation noted that, if the GAC was determined to be the most appropriate forum, then strong input in any event would be required from the intellectual property perspective. The Delegation also referred to the Delegation of Guatemala's suggestion that protection of country names in the ccTLDs may be adequate, and asked whether such protection would be considered satisfactory if the name of Guatemala were registered at the gTLD level as <guatemala.com>. Finally, the Delegation noted that in the case of Australia, as <australia.com> was registered by a tourist authority, the Government did not find this objectionable.

Trade Names

114. The Delegation of Norway stated that trade names represented an important category of rights which were protected by the Paris Convention and should also be protected against abusive domain name registrations through the UDRP.

115. The Delegation of the United States of America supported the Report's recommendations regarding trade names.

116. The Delegation of Sweden explained that trade names functioned in the same way as trademarks and that many companies only relied on trade names. For these reasons, the Delegation favored an extension of the UDRP to trade names.

117. The Delegation of Australia stated that, while it was open to being persuaded otherwise, it was inclined to support the recommendations of the Report on trade names. The Delegation failed to see widespread abuse of trade names in the DNS and believed that, in any event, those companies that were most likely to be the victims of cybersquatting would have obtained trademarks corresponding to their trade names, particularly in jurisdictions, such as Australia, where trademarks could be acquired through use.

118. The Delegation of Denmark expressed the view that the UDRP should be broadened to cover trade names.

119. The Delegation of Sudan also favored the extension of the UDRP to tradenames.
120. The Delegation of the United States of America set out several reasons why it believed that the UDRP should not be broadened to cover tradenames. First, the Delegation believed that there were few instances where tradenames did not also function as trademarks and, rather than taking action at this stage, suggested to monitor the situation in order to determine whether the number of such instances might increase in the future. Second, the Delegation explained that there was no uniform definition of what constituted a tradename under international law and that, under such circumstances, conflicts between tradenames and domain names were best left to courts to resolve. The Delegation also was of the view that the question of tradenames is more appropriately dealt with at the level of the ccTLDs.
121. The Delegation of France stated that the extension of the UDRP to tradenames was of interest, *inter alia*, for small and medium-sized enterprises, and in particular in countries where no system of protection existed for unregistered marks. The Delegation added that it hoped the discussions would continue on this subject which remained, however, secondary to that of geographical indications.
122. The Delegation of Senegal said that the provisions on the protection of tradenames in Senegal were the result of the 1977 Bangui Agreement. The Delegation also referred to the existence of the Organization for Harmonization of Business Law in Africa (OHADA). The Delegation explained that this Organization was designed to harmonize business law in Member States. The Delegation pointed out that the rights linked to tradenames originated in the trade registers of these States, at least in all the French-speaking States in Africa.
123. The Representative of the International Wine Law Association (AIDV) stated that its prior statement also applied to tradenames, as they also form part of the industrial property system. The Representative reiterated that the Joint Recommendation Concerning Provisions on the Protection of Marks, and Other Industrial Property Rights in Signs on the Internet applied, in his view, to domain names.
124. The Representative of the International Association for the Protection of Industrial Property (AIPPI) observed that no international treaty obliged States to protect unregistered marks, which explained why many countries did not protect such marks in their jurisdiction. The Representative noted that, nonetheless, unregistered marks fell under the scope of the UDRP. The Representative remarked that the Paris Convention imposed an obligation on States to protect tradenames. According to the Representative, it would not be logical for the UDRP to apply to identifiers which were not protected by international law (unregistered marks) and not apply to those that were protected by the Paris Convention (tradenames). Furthermore, the Representative stated that, as a practical matter, it would not be more difficult for a panel constituted under the UDRP to find the existence of a tradename than the existence of an unregistered mark. The Representative added that not extending the UDRP to tradenames created a bias in favor of those jurisdictions that protect unregistered marks. The Representative also stated that the testimony of the administrator of the UK ccTLD referred to in the Report suggested that many of the problems it encountered in the DNS concerned tradenames. The Representative was of the view that broadening the scope of the UDRP to tradenames would permit small and medium-sized enterprises better to defend their rights in the DNS. The Representative did not share the Report's concern that very small enterprises with a reputation only in a very limited geographical area might inappropriately

obtaining global protection for their tradenames through the UDRP, because it would be unlikely that many such small businesses would revert to the UDRP.

125. The Delegation of Switzerland expressed support for the extension of the UDRP to tradenames. The Delegation stated that the Report set out essentially two reasons why it refrained from recommending to do so, but found those reasons unconvincing. First, the Report stated that there was no internationally recognized definition of a tradename. The Delegation did not consider this to be a significant obstacle, because there existed no uniform definition of unregistered marks either and, nonetheless, the UDRP had successfully been applied to this class of identifiers by deciding on the existence of such mark on the basis of national law. The Delegation observed that, in light of the Paris Convention, the international legal framework for tradenames was more developed than for unregistered marks. Second, the Report stated that there was insufficient harmonization of the scope of protection offered to tradenames. In the view of the Delegation, this did not constitute a problem either, as the UDRP defines its own scope of protection, namely the abusive registration and use of a domain name. The Delegation considered that the UDRP's scope of protection could be simply applied to tradenames, without the need for further harmonization of international law.

126. The Delegation of the European Community expressed its skepticism regarding the wisdom of taking a wait-and-see approach in the context of the DNS, because past experience had demonstrated that this could lead to irreversible problems.

Conclusions and Future Work

127. The debate on all topics of the Report having concluded, the Chair drew the following conclusions:

1. INNs

128. The majority of delegations considered that, in view of insufficient evidence of the abusive registration of INNs as domain names and of the harm resulting from the registration of INNs as domain names, no immediate action was necessary.

2. Names and Acronyms of International Intergovernmental Organizations (IGOs)

129. The majority of delegations expressed interest in according some protection to the names and acronyms of IGOs against abusive registration as domain names, but considered that further work was needed to identify the way in which any such protection might function. The Special Session asked the Secretariat to consult with other IGOs to provide evidence of the extent of problems encountered with the abusive registration of names and acronyms of IGOs as domain names. Such evidence should be presented to the Second Special Session. In addition, the Special Session asked the Secretariat to provide a paper giving details of how any proposed protection of names and acronyms of IGOs would function in practice.

3. Personal Names

130. The majority of delegations considered that no action was necessary on the protection of personal names, outside the existing UDRP, at this stage.

4. Geographical Identifiers

(a) Indications of Source and Geographical Indications

131. Views on the question were divided. Whilst more delegations favored the modification of the UDRP to allow protection for geographical indications than those who opposed such a modification, no agreement had been reached. Accordingly, it was decided to continue discussions on the issue at the Second Special Session to examine the many useful questions raised. Any delegation would be free to submit comments or papers for consideration before the Second Special Session.

(b) Geographical Terms

132. Most delegations favored some form of protection for country names against registration by parties unconnected with the constitutional authorities of the country in question. However, it was recognized that many details of any such protection were unclear. It was decided that delegations should be invited to submit comments on the following questions to the Secretariat before the end of February 2002 and that the Secretariat should prepare a paper on the basis of comments received for distribution before the Second Special Session and for consideration by that Session. The questions were:

- (i) How should the name of a country be identified (for example, by reference to the United Nations Terminology Bulletin, ISO Standard 3166, or by some other method) and should both the long and short names of countries be protected?
- (ii) In what languages should country names be protected?
- (iii) To what domains should any protection be extended (for example, to all, both existing and future, gTLDs, only to future gTLDs, also to ccTLDs, etc.)?
- (iv) How should any alleged acquired rights be treated?
- (v) What mechanisms should be used to implement protection (for example, the UDRP or some other mechanism)?
- (vi) Should any protection extend to the exact country name only or also to misleading variations?
- (vii) Should protection be absolute or should it be dependent upon showing of bad faith?

5. Trade Names

133. A majority of delegations considered that trade names should be protected against abusive domain name registrations through the UDRP. Certain delegations, however, opposed such an extension of the UDRP. It was decided to continue discussions on this question at the Second Special Session to see if an agreed position would be reached.

Policy Options for Treatment of Issues

134. The Chair noted that insufficient progress had been made at the First Special Session on the substance of the issues concerned to be able to address this item of the agenda. The Chair proposed that this topic therefore be considered at the Second Special Session. In this connection, the Chair remarked that it would be useful for delegations if the Secretariat were to provide further explanations on the relationship between the Special Sessions and ICANN.

135. The Secretariat stated that the relationship between the Special Session and ICANN was uncharted territory. The Secretariat recalled in this connection that the UDRP itself was the result of the recommendations formulated by the first WIPO Internet Domain Name Process, which were adopted by ICANN with some adjustments following its own review processes. With regard to the means available for the implementation of any decisions that might be taken by the Special Sessions, the Secretariat referred to the explanation of the options for intellectual property policy contained in Chapter 2 of the Report.

136. This report was unanimously adopted by the Special Session of the Standing Committee on December 7, 2001.

[Annex follows]

WIPO



SCT/9/8
ORIGINAL:English
DATE:November15,2002

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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

STANDING COMMITTEE ON THE LAW OF TRADE MARKS, INDUSTRIAL DESIGN AND GEOGRAPHICAL INDICATIONS

Ninth Session
Geneva, November 11 to 15, 2002

SUMMARY BY THE CHAIR

Agenda Item 1: Opening of the Session

1. The Chair opened the meeting and Mr. Shozo Uemura, Deputy Director General, welcomed the delegates on behalf of the Director General.

Agenda Item 2: Adoption of the Draft Agenda

2. The SCT adopted the Draft Agenda (document SCT/9/1 Rev.2) with modifications relating to the order of discussion of the issues on Domain Names.

Agenda Item 3: Adoption of the Draft Report of the Eighth Session

3. The SCT adopted the Draft Report (document SCT/8/7 Prov.2) with some minor modifications.

Agenda Item 4: Geographical Indications

4. The SCT decided to request the International Bureau to prepare a study setting out the issues generally considered with regard to the protection of geographical indications, taking into account the elements contained in the definition of the TRIPS Agreement, in particular, the elements supporting a claim for quality, reputation or other characteristics, and what is

considered in evaluating a claim that these elements are “essentially attributable” to the geographical origin. The list of factors would be illustrative and not exhaustive and the purpose of the study itself would be to provide members with a general overview of issues considered by different systems of protection. In no case should this exercise be used to appreciate whether a particular system is in conformity with the TRIPS Agreement, nor would it provide a vehicle for examining whether a given geographical indication complies with the definition of Article 22.1 of the TRIPS Agreement. The study would only constitute a basis for discussion, and it would promote a better understanding of the definition in a more concrete way and provide information, especially for those members in the process of establishing their own systems. As such, it would not be an attempt to harmonize law on geographical indications, and it would not be an exercise in norm-setting or lead to a negotiation. It would simply constitute the basis for an exchange of information in a general manner without analyzing specific cases.

Internet Domain Names and Geographical Indications

5. The SCT decided to continue discussions on this issue and requested the International Bureau to prepare papers summarizing the state of the positions, drawing together work already done by the International Bureau and including the comments made by several delegations at the SCT.

Internet Domain Names and Country Names

The Chair concluded that:

6. Recalling the decision reached by the General Assembly at its meeting in September 2002, the majority of delegations favored amending the Uniform Domain Name Dispute Resolution Policy (UDRP) to provide protection for country names in the DNS.

7. As regards the details of such protection, * the delegations supported the following:

(i) protection should be extended to the long and short names of countries, as provided by the United Nations Terminology Bulletin;

(ii) the protection should be operative against the registration or use of a domain name which is identical or misleadingly similar to a country name, 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;

(iii) each country name should be protected in the official language(s) of the country concerned and in the six official languages of the United Nations; and

(iv) the protection should be extended to all future registrations of domain names in generic top-level domains (gTLDs).

* See WIPO Document (“Internet Domain Names”), WO/GA/28/3 (June 24, 2002).

8. The delegations supported continued discussion on:

(i) extension of protection to the names by which countries are familiarly or commonly known, and agreed that any additional such names be notified to the Secretariat before December 31, 2002;

(ii) retrospective application of the protection to existing registrations of domain names, and in which alleged rights may have been acquired; and

(iii) the question of sovereign immunity of States before the courts of other countries in relation to proceedings relating to protection of country names in the DNS.

9. The delegations requested the Secretariat to transmit the said recommendation to the Internet Corporation for Assigned Names and Numbers (ICANN).

10. The Delegations of Australia, Canada and the United States of America dissociated themselves from this decision.

11. The Delegation of Japan stated that, while it did not oppose the decision to extend protection to country names in the DNS, further discussion was required concerning the legal basis for such protection, and stated its reservation to paragraph 7 herein, except for subparagraph (iv).

Trademarks

Proposals for further harmonization of formalities and procedures in the field of marks

12. The SCT decided that the International Bureau should revise document SCT/9/2 according to the comments made by the SCT members at the ninth session on Article 8 and Article 13 *bis*, 13 *ter* and 13 *quater* and related rules.

Further development of international trademark law and convergence of trademark practices

13. The SCT decided that the International Bureau should circulate the questionnaire contained in document SCT/9/3 on the SCT Electronic Forum, inviting for comments by the end of January 2003. On the basis of these comments, the International Bureau shall finalize the questionnaire and circulate it for reply.

Industrial Designs

The Committee welcomed discussion on industrial designs at the SCT and expressed the wish to continue such discussion at future meetings.

Agenda Item 5: Future Work

14. The SCT discussed the need to establish priorities for its future work and decided that first priority should be given to work on trademarks, specifically the revision of the TLT, as well as the continuation of the discussions on the questionnaire on substantive trademark law.

Second priority would be given to work on geographical indications. The SCT further agreed that its tenth session would last five full working days and that the agenda of that session would devote three full days to trademarks, half a day to geographical indications in general, and half a day to geographical indications and domain names, leaving one day flexible for other issues including the adoption of the draft report of the previous session and preparation and adoption of the summary by the Chair. The tenth session of the SCT would tentatively be scheduled for April 28 to May 2, 2003, in Geneva.

[End of document]

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SCT/S2/8

ORIGINAL: English

DATE: May 24, 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

REPORT

adopted by the Special Session of the Standing Committee

Introduction

1. In accordance with the decision of the WIPO General Assembly at its meeting in September 2001 (document WO/GA/27/8) that the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) hold two special sessions on the Report of the Second WIPO Internet Domain Name Process (the "Special Sessions"), the second such Special Session was held in Geneva from May 21 to May 24, 2002.

2. The following 76 States participated: Algeria, Argentina, Australia, Austria, Azerbaijan, Bangladesh, Barbados, Belarus, Bolivia, Brazil, Canada, China, Colombia, Côte d'Ivoire, Croatia, Democratic Republic of the Congo, Denmark, Ecuador, Egypt, France, Germany, Ghana, Greece, Guatemala, Honduras, Hungary, India, Indonesia, Iran (Islamic Republic of), Iraq, Italy, Jamaica, Japan, Jordan, Kenya, Latvia, Lebanon, Lithuania, Luxembourg, Mauritius, Mexico, Morocco, Netherlands, Niger, Nigeria, Norway, Pakistan, Papua New Guinea, Paraguay, Philippines, Portugal, Qatar, Republic of Korea, Republic of Moldova, Romania, Russian Federation, Rwanda, Singapore, Slovakia, South Africa, Spain, Sri Lanka, Sudan, Sweden, Switzerland, Thailand, The former Yugoslav Republic of Macedonia, Tunisia, Turkey, Ukraine, United Kingdom, United States of America, Uruguay, Venezuela, Yemen, Yugoslavia. The European Community was also represented in its capacity as member of the SCT.

3. The list of participants is contained in the Annex II to this report.
4. The Session was opened by Dr. Francis Gurry, Assistant Director General, who welcomed the participants on behalf of Dr. Kamil Idris, Director General of WIPO.

Election of a Chair and two Vice-Chairs

5. In accordance with the decision of the first Special Session, Mr. S. Tiwari (Singapore) acted as Chair, and Mrs. Valentina Orlova (Russian Federation) and Ms. Ana Paredes Prieto (Spain) as Vice-Chairs. Mr. David Muls (WIPO) acted as Secretary.

Adoption of the Draft Agenda

6. To allow for the presentation by Mr. Corell, Under-Secretary-General for Legal Affairs, The Legal Counsel of the United Nations, to be made on the morning of May 22, 2002, the order of discussion of the topics under item 4 of the Draft Agenda (SCT/S2/1) was modified as follows: (a) international nonproprietary names (INNs) for pharmaceutical substances, (b) trade names, (c) personal names, (d) names and acronyms of international intergovernmental organizations (IGOs), (e) geographical terms (country names) and (f) geographical indications and indications of source.

Accreditation of Certain Organizations

7. As set out in documents SCT/S2/5 and SCT/S2/5 Add., the following nine intergovernmental and non-governmental organizations had expressed to the Secretariat their wish to obtain ad hoc observer status for the Special Sessions: International Organization for Migration (IOM), International Trade Centre (ITC), Preparatory Commission for the Comprehensive Nuclear-Test-Ban Treaty Organization (Preparatory Commission for the CTBTO), Secretariat of the United Nations Framework Convention on Climate Change (UNFCCC) and the Kyoto Protocol, International Committee of the Red Cross (ICRC), Organisation for Economic Co-operation and Development (OECD), Cognac National Interdisciplinary Office (BNIC), Internet Corporation for Assigned Names and Numbers (ICANN) and Research and Academic Computer Network (NASK). The accreditation of the organizations in question as ad hoc observers for the Second Special Session was approved unanimously.

International Nonproprietary Names (INNs) for Pharmaceutical Substances

8. After the Secretariat's summary of the findings of the Report of the Second WIPO Internet Domain Names Process (the "Second WIPO Process Report") on the issue of INNs, the Chair recalled the conclusions reached on this topic at the first Special Session, as reflected in its Report (document SCT/S1/6).
9. The Delegation of Germany inquired whether the World Health Organization (WHO) had the opportunity to raise the question of the protection of INNs in the Domain Name System (DNS) directly with the Internet Corporation for Assigned Names and Numbers (ICANN).

10. The Delegation of Japan expressed the view that no serious problems had been encountered with respect to INNs in the DNS and that there was no urgent need to take any action in the generic Top-Level Domains (gTLDs) or in the country code Top-Level Domains (ccTLDs) with regard to this issue.

11. The Representative of WHO offered an extensive explanation of the background to and purpose of the protection of INNs. The Representative explained that INNs were unique, globally available names, free from proprietary rights and available for use by all, for the sole purpose of identifying pharmaceutical substances (mostly active pharmaceutical ingredients, used in medicines or for scientific research). A pharmaceutical substance was called an active pharmaceutical ingredient when it was responsible for therapeutic effects in man (or animal, in the case of veterinary drugs). Thus, INNs were widely used to identify medicines containing a specific active pharmaceutical ingredient, regardless of whether the medicine was protected by patents or generic. This system was mainly established to provide health professionals with a clear global identification mechanism for the safe prescription and dispensing of medicines to patients. There were more than 7,000 INNs; 100-150 new INNs per year were issued. INNs were used for communication amongst health professionals so as to avoid confusion about the active ingredients in medicines, which could endanger the safety of patients. They were also used in the marketing authorization process of medicines, as a generic name for each medicine containing the pharmaceutical substance in question (i.e., on labels and package inserts of medicines), in prescription and dispensing of medicines to patients, and in scientific publications. World Health Assembly resolutions (e.g., WHA46.19 of 1993) endorsed the development by WHO Member States of policy guidelines on the use and protection of INNs, and the adoption of measures to discourage the use of trademarks derived from INNs, as well as common stems in trademarks. The Representative reminded that WHO had proposed to exclude INNs (in all official UN languages) from registration as domain names, including INNs used as an element of the domain name (e.g. "*ampicillin plus*"). WHO was of the opinion that INNs were unique identifiers for pharmaceutical substances only, aimed at patient safety, and should thus, in the interest of public health, only be used for their intended purpose. Registration and use of INNs in the DNS created rights akin to proprietary rights, which was contrary to the free availability of INNs and constituted a use of INNs beyond their intended purpose. Such use could, in WHO's opinion, easily result in a disruption in the consistent association of an INN with scientifically established characteristics and properties, and misinformation as well as miscommunication world-wide, including in the prescription and dispensing of medicines. The Representative further stated that WHO noted, but remained concerned about, the conclusion reached by the SCT in its Report of the first Special Session (document SCT/1/6). The Representative also stated that WHO had provided a list of examples of INNs registered as domain names and intended to continue its consultations with all major stakeholders in the INN process: member associations of pharmaceutical industries of the International Federation of Pharmaceutical Manufacturers Association (IFPMA), the Pharmaceutical Research and Manufacturers of America Association (PhRMA), the European Federation of Pharmaceutical Industries and Associations (EFPIA) and the Japan Pharmaceutical Manufacturers Association (JPMA), major national and regional pharmacopoeias, all national regulatory authorities, as well as professional (World Medical Association (WMA), International Pharmaceutical Federation (FIP)) and consumer associations. The aim of these consultations was to collect additional evidence of abusive registrations of INNs as domain names and their potential harmful effect on public health. The detailed report of these consultations would be made available to WIPO as soon as possible. In light of the above, the Representative urged that the issue of the protection of INNs on the Internet be retained for further monitoring and be revisited in the near future.

12. The Delegation of the United States of America expressed support for the position of Japan. The Delegation was of the view that INNs were generic terms and that they therefore, by definition, could not be the subject of abuse. The Delegation stated that any domain name registration created *de facto* exclusivity in the domain name concerned and that therefore, in the case of generic terms (such as, for instance, food.com), no persuasive argument in favor of establishing protection could be based on such exclusivity. The Delegation further stated that, if any website associated with an INN contained fraudulent information, this could be dealt with by relying on national laws aimed at curbing such practices. In particular, the Delegation opposed the creation of any prospective protection in these circumstances.

13. The Delegation of Mexico expressed the need to protect INNs in the DNS in so far as the denomination in question could not be the subject of exclusive rights. It emphasized that proof of the harm caused by the registration of the INN as a domain name should be provided. It noted, however, that this issue should not necessarily be discussed immediately. The Delegation also noted that, having adopted World Health Assembly Resolution 46.19 on Nonproprietary Names for Pharmaceutical Substances, all WHO Member States that were also members of WIPO were bound to comply with this Resolution and therefore to protect INNs.

14. The Delegation of the European Community expressed support for the position of Mexico and favored the establishment of protection for INNs in the DNS. According to the Delegation, the public policy reasons for the existing protection of INNs in the real world also applied in the virtual world.

15. The Delegation of Australia noted the conclusions reached on INNs at the first Special Session and observed that no evidence had been submitted which would warrant departing from those conclusions at this stage. The Delegation proposed to continue monitoring the situation, but, in the face of the lack of evidence of real problems, urged that no action be taken presently. The Delegation furthermore stated that the protection afforded to INNs through the WHO system was against their registration as trademarks. The Delegation stressed that the DNS was not a trademark system and that a domain name registration, as such, did not provide any trademark rights.

16. The Delegation of Germany reminded that INNs should be used exclusively for the purposes for which they had been created and therefore cautioned against a general finding that no action would be required in relation to them, based on a perceived lack of evidence of their abuse in the DNS. The Delegation proposed that any decision by the Special Session that no action be taken with respect to INNs be crafted narrowly, so as not to prejudice any future consideration of the issue.

17. The Delegation of Spain approved the statements made by the Delegations of the European Community, Germany and Mexico, and emphasized that a degree of protection for INNs in the DNS might be necessary and that the mere fact of no infringement of INNs having been noted in the DNS could not justify the complete lack of protection measures. The Delegation proposed that this question should be re-examined at future meetings.

18. The Delegation of Uruguay expressed its support for the statement made by the Delegation of Mexico and said that lack of evidence of infringement of INNs in the DNS did not mean, however, that there was no potential damage. In conclusion, it emphasized its willingness to protect INNs in the DNS.

19. The Representative of the European Federation of Pharmaceutical Industries and Associations (EFPIA) explained that EFPIA was the representative voice of the pharmaceutical industry in Europe, representing the common views and interests of over 3,350 companies undertaking R&D and manufacturing of medicinal products in Europe. The Representative stated that EFPIA agreed in general with the Second WIPO Process Report. The Representative indicated however that the “notice and take down” mechanism would only be helpful if the blocking mechanism was not available. It was recalled that EFPIA favored an exclusion/blocking mechanism for the registration of any domain name identical to an INN with any registration body. The Representative stated that the Cumulative List of INNs should be excluded automatically from registration as domain names in the open gTLDs. The Representative indicated that this mechanism should apply to all past and future registrations. The Representative stated that before any efficient blocking mechanism is implemented, pharmaceutical industries should have the option to register identical INNs as domain names. The Representative proposed that a blocking mechanism be implemented, incorporating periodically new approved INNs by WHO notified directly to ICANN, to block future registrations, and that this mechanism be combined with the “notice and take down” procedure for the existing registered names. The Representative also suggested that WHO in conjunction with WIPO ask companies to withdraw voluntarily their registrations within a given time, and registrars who have registered INNs to contact the owners of these registrations and not to accept requests for renewals when they become due. The Representative emphasized that not all INNs (in all about 10,000 as mentioned by WHO) were registered as domain names, but only a few hundred. Finally, the Representative observed that the notice and take down procedure would only function when an interested party notified WIPO. The Representative expressed EFPIA’s concern about the risk underlined by WHO (paragraph 115 of Second WIPO Process Report) of re-registration of the INN as domain name following cancellation when the INN name becomes available again. The Representative indicated that it would be therefore difficult to prevent the large number of burdensome complaints and procedures.
20. The Delegation of Mexico clarified that rather than concluding that no action should be taken regarding the protection of INNs in the DNS, it should be said that the action to be taken was to continue to examine this issue.
21. Raising a procedural issue, the Delegation of the United Kingdom inquired whether there would be an opportunity for the Special Session to review any draft conclusions, as its work progressed through the various topics on the Agenda.
22. In reply to the inquiry by the Delegation of the United Kingdom, the Secretariat proposed that the Chair summarize the discussions on each separate topic and that it commit those findings to paper, so that they could be considered by delegates prior to the adoption of the Report.
23. The Delegation of Australia expressed appreciation for the proposal of the Delegation of Mexico and noted with approval the suggestion made by the Secretariat on the procedural question raised by the United Kingdom. The Delegation subsequently inquired to which body any findings resulting from the continued monitoring of the position of INNs in the DNS could be submitted, considering that only two Special Sessions of the SCT have been scheduled and that their work is to finish after the present Session.
24. In response to the inquiry from the Delegation of Australia, the Secretariat proposed that it, jointly with the WHO, could monitor the position of INNs in the DNS and that it could report on the evolving situation to either the WIPO General Assembly or the ordinary sessions of the SCT,

depending on when the issue might be deemed ripe for further consideration by the WIPO Member States.

25. The Delegation of the European Community expressed support for the proposal made by the Delegation of Mexico and the procedural suggestion made by the Secretariat.

26. The Chair concluded that many delegations favored the protection of INNs in the Domain Name System against registration as domain names in order to protect the integrity of the INN system. While it was decided not to recommend a specific form of protection at this stage, it was agreed that the Secretariat should, in cooperation with the World Health Organization continue to monitor the situation and, if necessary, bring to the attention of the Member States any material change in the situation.

Trade Names

27. After the Secretariat's summary of the findings of the Second WIPO Process Report on the issue of trade names, the Chair recalled the conclusions reached on this topic at the first Special Session, as reflected in its Report (document SCT/S1/6).

28. The Delegation of Japan stated its view that there was no urgent need to protect trade names in the DNS, at gTLD or ccTLD level. The Delegation supported paragraph 319 of the Second WIPO Process Report, against the modification or extension of the Uniform Dispute Resolution Policy (UDRP) to cover trade names.

29. The Delegation of Germany supported the views of the Delegation of Japan, and the recommendation in paragraph 319 of the Second WIPO Process Report against overstressing the capacity of the UDRP, by including trade names within this administrative dispute resolution system.

30. The Representative of the International Association for the Protection of Intellectual Property (AIPPI), speaking also from his experience as a panelist under the UDRP, noted that the UDRP currently covered both registered and unregistered trademarks, in those countries where unregistered marks were recognized by law and that, as many of the same considerations apply, it was artificial to exclude trade names from the UDRP while including unregistered trademarks. The Representative noted that, in reality, the real issue in many UDRP cases was the protection of an often famous trade name, whether through registration as a trademark or as an unregistered trademark. It was also noted that the European Community Trademark system allowed opposition proceedings based on trade names, and that trade names were specifically protected under the Paris Convention.

31. The Delegation of Norway stated that trade names were an important and established part of the intellectual property system, by virtue of the Paris Convention. It was noted that in Norway, trade names also can be used for similar purposes as trademarks, for the identification of the source of goods and services, and that there appeared no reason to treat the two identifiers differently. The Delegation remarked that trade names were of particular importance for small and medium sized enterprises, who may only choose to protect their identifiers as registered trade names. For these reasons, the Delegation supported the extension of the UDRP to trade names.

32. The Delegation of the United States of America supported the Secretariat's recommendations in the Second WIPO Process Report, and opposed the extension of the UDRP to include trade names. The Delegation noted that the application of the UDRP to unregistered

trademarks did not require the application of different standards to those that apply to registered trademarks, in contrast to the situation as applies to trade names. The Delegation also remarked upon the lack of an internationally agreed definition of trade names, with many conflicting positions under national laws, with the result that panelists would be required to make determinations without the benefit of such uniform standards, with the result that findings could be made of bad faith registration of trade names as domain names where such identifiers were not recognized as trade names in the country of the registrant's origin. In this circumstance, the Delegation expressed its view that the national courts were the better forum to decide such disputes, in the small number of cases where trade names did not also function as trademarks. The Delegation supported the monitoring of possible cases of abusive registrations of trade names in future.

33. The Delegation of Sweden supported the protection of trade names against abusive registration in the DNS, and supported the views of the Delegation of Norway and the Representative of AIPPI. The Delegation noted that trade names functioned as trademarks in the marketplace and that many enterprises only used trade names in the conduct of their business.

34. The Delegation of Germany noted that trade names were protected within the intellectual property framework by virtue of the Paris Convention, Articles 8 and 9. However, the Delegation cautioned against requiring ICANN to act as a *de facto* trademark office, and recommended careful progress in this area. The Delegation noted that any recommendation made to ICANN would need to be acceptable to the Internet community. The Delegation observed that the UDRP had been utilized by the Government of Germany, including by the Ministry of Justice, to defend its names on the basis of the argument that they qualified as trademarks. In this way, the procedure had been shown to be flexible as a mechanism for protecting various identifiers. The Delegation therefore noted that there was no pressing need to extend the UDRP, and supported the recommendations made in this context in the Second WIPO Process Report.

35. The Delegation of France underlined its support for the Delegations of Norway, Sweden and the International Association for the Protection of Intellectual Property (AIPPI), and stated that, despite the diversity of the national legislation of different countries, it was still important to protect trade names against their abusive use in the DNS.

36. The Delegation of Switzerland, responding to the intervention of the Delegation of Germany, noted that the availability of the UDRP to resolve conflicts by characterization of the identifier as an unregistered trademark depended on where the entity was located, as many countries did not protect unregistered trademarks. The Delegation supported the extension of the UDRP to protection of trade names.

37. The Delegation of the United Kingdom expressed its support for the extension of the UDRP to include trade names, as a logical and practical means to solve this problem and possibly also progress consideration of the protection of personal names.

38. The Representative of the American Intellectual Property Law Association (AIPLA) concurred with the intervention of the Representative of the AIPPI. The Representative noted that trade names were already to some degree protected under the UDRP as unregistered trademarks and supported the explicit recognition of this protection, reflecting the established protection under intellectual property law. The Representative noted that, as with unregistered trademarks, complainants would need to demonstrate that their trade name was distinctive as an indication of source and that, while there did exist differences in national treatment of trade names, the UDRP panelists have been able to handle such issues.

39. The Delegation of Denmark supported the extension of the UDRP to protection of trade names.

40. The Delegation of Mexico said that it currently had difficulty in accepting the broadening of the protection provided by the UDRP to trade names. It emphasized that in Mexico trade names were used by commercial institutions. It cited as an example the trade name “Michoacana” which belonged to a large number of institutions that sold exactly the same product. In that regard, it would be difficult to determine who would have priority over a trade name registered as a domain name.

41. The Delegation of Canada stated that the UDRP should not be extended to protection of trade names, in light of the lack of international consensus on the manner of their protection and the availability of other existing remedies, including protection as registered or unregistered trademarks and technical measures, such as shared web pages or portals, to accommodate the existence of coinciding trade names in the DNS.

42. The Delegation of the European Community reiterated the stance it had taken at the first Special Session, according to which the UDRP should not be extended to trade names. It underlined, however, that the question of abusive use of domain names should be examined, and referred to the example cited by the Delegation of Mexico. The Delegation stated that in such a case the rule of “first come, first served” applied even without there being any abuse. In conclusion, the Delegation noted that it would be worth continuing to examine this issue so that trade names were protected within the DNS.

43. The Delegation of Australia strongly endorsed the first half of the comments made by the Delegation of the European Community, and stated that it was critical to focus on the abusive registration of names in the DNS. On the issue of trade names, the Delegation emphasized the guiding principle of mirroring the existing consensus in international law within the DNS, and avoidance of the creation of new international law or discontinuity between the state of law in the real and virtual worlds. The Delegation noted that in many countries trade names function as trademarks, acting as indications of source of origin and, as such, may already be covered by the UDRP. Where such protection was not granted under national law, as in Scandinavia, the Delegation noted that it was unclear what could be protected under the UDRP. The Delegation referred to the Second WIPO Process Report and noted that the differences in national law would raise complex questions of applicable law, which could lead to a lack of coherence in decisions under the UDRP. The Delegation also noted that many disputes concerning trade names would likely involve two legitimately interested holders and, in accordance with the intervention of the Delegation of the European Community, it would be unwise to allow the UDRP to be weighed down by decisions involving such complex questions. In this respect, the Delegation noted that the success of the current UDRP was due to its limited application to questions of clear abuse. In the absence of clear evidence of abusive registration of trade names in the DNS, extension of protection to other identifiers such as trade names could inhibit the development of international trade and, therefore, the Delegation supported the recommendation made in paragraph 319 of the Second WIPO Process Report, against protection of trade names in the DNS.

44. The Representative of the International Association for the Protection of Intellectual Property (AIPPI) noted that all delegations that had spoken against protection of trade names under the UDRP did not have a problem in this respect, because such identifiers could be protected as unregistered trademarks in their respective jurisdictions, and therefore qualify for protection under the UDRP. The Representative noted that in many civil law countries, including the Nordic

countries, Switzerland and France (with the notable exception of Germany, which had recently enacted a law protecting unregistered trademarks), unregistered trademarks were not protected, and therefore trade name owners within these countries were at a disadvantage in terms of resort to the UDRP. The Representative distinguished trade names, which were protected without requirement of registration by virtue of Article 8 of the Paris Convention, from registered company names, which were sometimes totally descriptive. It was noted that, whereas trademarks functioned to distinguish the origin of goods and services, trade names performed the different function of distinguishing enterprises. Both trademarks and trade names were distinctive as to origin, which was not necessarily the case for registered company names. The Representative noted that the term “business identifier”, which includes trade names has been used in the Joint Recommendation concerning provisions on the protection of well known marks and that this concept thus had been accepted without dissent at the international level to be applied in relation to the Internet.

45. The Representative of the International Federation of Industrial Property Attorneys (FICPI) expressed its support for the recommendation made in the Second WIPO Process Report, and the intervention of the European Community. It was noted that the discussions on this issue within FICPI had demonstrated a dichotomy of views for and against protection of trade names in the DNS along the lines of respective legal traditions and various jurisdictions and that, since it is essential to prevent abusive use of trade names, further discussion on this area was needed.

46. The Representative of the Internet Corporation for Assigned Names and Numbers (ICANN) noted that on issues of international law, ICANN can only rely on existing international law and, in this respect, takes guidance from the international community, including WIPO. Earlier made observations are correct. ICANN cannot function as a *de facto* trademark office. The Representative noted that developments in the DNS, and specifically applications above the DNS, were rapid and not possible to predict, and that it was important to take account only of accepted international law and not risk the creation of new law, with possibly unforeseen results in the future.

47. The Delegation of Australia emphasized that no new international law should be created in the DNS, by establishing *de facto* rights that apply only to the DNS. However, the Delegation noted the views expressed by certain delegations and representatives, notably Switzerland and AIPPI, that countries where unregistered trademark rights were not recognized had a different perspective on the need for protection. The Delegation noted that no evidence had yet been presented as to the scale of the problem as concerns abuse of trade names, and invited those delegations which supported the extension of protection in this regard to provide such further evidence.

48. The Representative of the International Association for the Protection of Intellectual Property (AIPPI) stated that it was difficult to give concrete cases of abuse of trade names but that, in his capacity as a UDRP panelist, he had seen many instances where cases were brought for the protection of trade names, relying upon incidental protection as trademarks.

49. The Delegation of Switzerland, in response to the remarks by the Delegation of Australia and the Representative of ICANN, noted that the concerns against the creation of new law should take account of the fact that the approaches taken to resolving cases under the UDRP in reality was more often based on an unfair competition analysis, rather than a classic trademark law analysis. The Delegation remarked that trade names were already protected under the Paris Convention, that the international community should not accept the bad faith registration of trade names in the DNS, and that this would not amount to the creation of new law.

50. The Secretariat sought to clarify certain remarks concerning the role of ICANN acting as a *de facto* trademark office. It was noted that in these discussions, it was not necessarily sought to establish a treaty, only to discuss the possible modification of a dispute resolution mechanism to implement more efficiently existing international law. The Secretariat noted that disputes relating to the Internet raised the prospect of multijurisdictional litigation, whereas an administrative system such as the UDRP had been shown to resolve disputes involving trademarks more efficiently and cost-effectively. The recommendations were not aimed at causing ICANN to act in the manner of a trademark office but, to the contrary, were aimed at removing such legal considerations from the ambit of the domain name registration system. The Secretariat, noting the comments of the Delegation of the European Community, remarked that the UDRP applies only to egregious cases of abuse, which can be resolved simply in such an administrative dispute resolution system. The real question, it was stated, was whether national and international law was sufficiently clear as pertains to trade names to enable the UDRP to be utilized to solve the problem of law enforcement through this medium.

51. The Delegation of the United Kingdom expressed its lack of a strong position for or against protection of trade names in the DNS, and noted that most small and medium sized enterprises relied upon trade names in their business, without wishing to utilize the trademark system.

52. The Delegation of Germany expressed its flexibility on the issue of protection of trade names in the DNS, and was open to joining a consensus on this issue, provided that its scope was limited in the manner described by the Secretariat and some delegations.

53. The Delegation of the Republic of Korea recognized the logic in various delegations' positions for and against protection of trade names in the DNS, depending upon their national legal situation, and remarked that in this absence of consensus, now was not the proper time to extend protection to trade names under the UDRP. The Delegation described the protection of trade names under the Korean national law through three means: first, protection through registration as a trademark or service mark; second, famous unregistered trademarks or trade names may be protected under unfair competition law against misappropriation, and; third, protection locally under the Trade Name Law.

54. The Chair noted that views were divided as to whether the UDRP should be modified to accommodate trade names. One group of countries wished to treat trade names in the same manner as trademarks; others felt that there was no internationally accepted legal basis to underpin the extension.

55. It was decided that Member States should keep the matter under review and raise the matter for further discussion if the situation so demanded.

Personal Names

56. After the Secretariat's summary of the findings of the Second WIPO Process Report on the issue of personal names, the Chair recalled the conclusions reached on this topic at the first Special Session, as reflected in its Report (document SCT/S1/6).

57. The Delegation of Japan stated that there was insufficient need for protection of personal names in the DNS either at the gTLD or ccTLD level, and expressed its support for paragraph 202 of the Second WIPO Process Report, against modification of the UDRP to encompass personal names.

58. The Delegation of Germany highlighted the fact that protection of personal names is linked to consideration of trade names, and noted that there was no international consensus on this issue. The Delegation noted that in Germany, a local court decision had been handed down that involved a dispute between two legitimate claimants to registration of the Krupp name in the DNS, and that found in favor of the large trademark holder on the basis that its reputation gave it a priority of use for the name in the DNS, given that most Internet users would have the expectation that the Krupp domain name would link to the well-known manufacturer, rather than to another less well-known person. The Delegation supported the recommendation of the Second WIPO Process Report against the protection of personal names in the DNS.

59. The Chair noted that the Special Session's decision was that no action is recommended in this area.

Names and Acronyms of International Intergovernmental Organizations (IGOs)

60. The Secretariat summarized the findings of the Second WIPO Process Report on the issue of the names and acronyms of international organizations (IGOs). The Secretariat referred to four documents relevant to this discussion – namely, SCT/S2/2, SCT/S2/INF/2, SCT/S2/INF/3 and SCT/S2/INF/4.

61. The Chair summarized the position on the issue of IGOs at the conclusion of the first Special Session, as reflected in its Report (document SCT/S1/6).

62. Mr. Hans Corell, Under-Secretary-General for Legal Affairs, The Legal Counsel of the United Nations made a statement on behalf of the Legal Advisers of the United Nations System ('Statement of UN Legal Advisers') which is reproduced in Annex I.

63. The Representative of the American Intellectual Property Law Association (AIPLA) thanked the United Nations Legal Advisers for their comments, and requested that the meeting focus on clarification of the meaning of certain words used to characterize domain name registrations, such as 'bad faith', 'unauthorized', 'misleading' and 'abusive'. Referring to the Annex to the Legal Adviser's Paper on the Report of the Second WIPO Internet Domain Name Process (SCT/S2/INF/4), the Representative gave the example of the Food and Agriculture Organization (FAO), and the registrations of domain names <fao.com> (registered by the toy company, FAO Schwartz, which had used the name "FAO" since 1862, well before the establishment of the United Nations Organization), <fao.kiev.ua> (registered by the Fiscal Analysis Office of the Ukraine) and <fao.mil> (registered by a constituent body of the United States Military). The Representative asked why such domain name registrations should be characterized as unauthorized, when the registrants were using them for legitimate purposes.

64. The Secretariat noted that two questions were raised in this context: first, whether a domain name registrant was authorized to register the name that referred to an IGO; and second, whether such registration was misleading. The Secretariat noted that the Annex referred to by the Representative of the AIPLA referred to both the above cases, that not all such registrations were illegitimate, and that this illustrated the complexity of the questions raised by such registrations

and use of the names and acronyms of IGOs in the DNS. The Secretariat further noted that the Paris Convention, Article 6*ter*, establishes guidelines as to what constituted misleading use of such names and acronyms of IGOs, and indicated that the protection to be granted to them was qualified in two ways, namely that States were not required to protect such identifiers if their use did not suggest to the public a connection or authorization by the concerned organization, or if such use was probably not of such a nature to mislead the public as to such a connection.

65. The Delegation of Australia agreed with the remarks of the Representative of the AIPLA, and expressed its gratitude to the Legal Counsel of the United Nations for his advice. The Delegation noted that it withdrew its earlier reservations, expressed at the first Special Session of the SCT, to the provision of protection for names and acronyms of IGOs in the DNS. The Delegation stated its strong support for such protection, and explained that its earlier reservations had related to the question of how real was the problem confronting IGOs in protecting their names and acronyms in the DNS, and the issue of how the privileges and immunities enjoyed by the IGOs could be preserved in any such system. The Delegation noted that Australia retained some reservations about the question of immunity, but recognized that the scale of the problem confronting IGOs was sufficient to warrant a system of protection being established in relation to the registration of domain names that incorporated or were identical to the names of IGOs, that was based on a finding of bad faith or abusive use, and that was modeled on the UDRP, with a mechanism for appeal to a special tribunal that would preserve the immunity of the IGOs.

66. The Delegation of Egypt expressed its appreciation to the Legal Counsel of the United Nations, and noted its support in principle for the protection of the names and acronyms of IGOs in the DNS. The Delegation stated that the specific nature of such organizations required protection against misuse in the DNS, and that a special system should be established in order to preserve their privileges and immunities. The Delegation noted the question of governance of the DNS, as raised by the Legal Counsel of the United Nations, and agreed that these issues needed to be discussed in a precise manner and framework.

67. The Delegation of the United States of America expressed its appreciation to the Secretariat for its work on framing the issues related to IGOs, but stated that the Special Session of the SCT should not force any solution on the DNS, which is primarily regulated by private contractual agreements between ICANN, the registry operators, registrars and registrants. The Delegation noted that any additional obligations or liabilities must be agreed upon by ICANN and contractual in nature in order to be effective. The Delegation noted that the outcome of this Special Session would be a recommendation to ICANN and that it remained for the ICANN Board to decide upon any action after consultation with its constituent bodies. The Delegation stated that the Special Session of the SCT should not act as a government for the Internet, but that issues of governance should be handled by each government for its own community, applying national laws and policies and enforcing rights specific to each country. While noting the jurisdictional issues raised by the Internet, the Delegation stated that this did not obviate the role of national systems in regulating conduct in this context. The Delegation expressed its view that the solution could not be found in creating new systems to apply to each interest group involved in the Internet, but through resort to the ICANN processes and in reliance upon contractual agreement, or through the ccTLDs which are subject to national law. The Delegation noted that the creation of a new dispute resolution procedure for IGOs would create new rights and obligations beyond those established by Article 6*ter* of the Paris Convention. It was noted that, in the United States of America, IGOs already have protection through the opportunity to challenge in court the unauthorized use of their names and acronyms, or to oppose the registration of such identifiers on trademarks where such registration would amount to misuse. The Delegation stated that a *sui generis* system of protection for IGOs would establish a right not offered to other entities, and that the absence of a right to

appeal to the courts would not meet domestic due process requirements, which are not satisfied by the proposed system of appeal to an appeal panel. In this respect, the Delegation noted that the availability of a *de novo* appeal to the courts provided the only real check on the power of UDRP panelists and safeguard against abuse of the system, and should not be removed in function of the type of entity that brought the complaint. The Delegation remarked that certain sovereign States had waived their immunity to bring UDRP challenges, and stated that IGOs should not receive better treatment than such States.

68. The Delegation of Algeria thanked the Legal Counsel of the United Nations for his statement on the names and acronyms of international organizations. The Delegation said that this issue was of particular interest since, in the case of unlawful registrations, it could generate negative effects, not only for international organizations but also for their member States. The Delegation underlined that the question of the management of domain names by the private sector was also worthy of interest. Noting the absence of international legislation and given the transnational character of information technologies, the Delegation cited the need to consider a universal legislative instrument. The Delegation stated that it intended to support the establishment of an agreement on this matter, designed to provide appropriate protection against the unlawful registration of domain names. In conclusion, it said that the efforts of member States at the Special Session could prove to be important in view of the forthcoming World Information Summit in 2003.

69. The Delegation of Mexico expressed its support for the protection of the names and acronyms of international intergovernmental organizations and welcomed the statement made by the Legal Counsel of the United Nations. The Delegation requested that members should be given more time to study the proposals relating to this matter.

70. The Delegation of Canada thanked the Legal Counsel of the United Nations for his statement and highlighted the first principles of the organization of the Internet, namely that measures needed to be efficient, cost effective and administratively non-burdensome. The Delegation raised the question whether the creation of a separate administrative dispute resolution procedure for IGOs would lead to the creation of similar system with respect to all identifiers, consequently not respecting the first principles mentioned.

71. The Secretariat noted two special features of the proposed new administrative dispute resolution procedure, namely: it would apply only to 'abusive registrations' defined, not by trademark law, but by reference to Article 6*ter* of the Paris Convention, and further, it would include an appeal mechanism taking the form of arbitration that would respect due process and enable efficient enforcement under the New York Convention on the Recognition and Enforcement of Foreign Arbitral Awards (1958). It was noted that such an arbitral procedure and system of enforcement was a widely respected alternative to litigation. Apart from these two special features, the Secretariat noted that the proposed procedure followed the lines of the UDRP.

72. The Delegation of Japan recognized the need for discussion or review of adequate protection for the name or acronym of IGOs in the DNS. At the same time, the Delegation stressed the importance of the need for discussion or analysis as to the legal basis or nature of the protection, especially the relation to the existing international rules such as Paris Convention before discussions on how the name or acronyms in connection with internet domain names should be treated. The delegation recalled that in the first Special Session of the SCT, it had pointed out that the use or registration of the name of IGOs would constitute infringement of Article 6*ter* of Paris Convention and TRIPS Agreement. The Delegation concluded saying that legal ground or nature

of protection of names of IGOs was essentially important even in the case of public law rather than private law.

73. The Delegation of Denmark expressed its support for the protection in the DNS of the names and acronyms of IGOs and other organizations identified in international treaties. The Delegation stated that its preferred method for such protection was a modification of the UDRP.

74. The Delegation of Sweden stated that there was a clear need for protection of the names and acronyms of IGOs in the DNS, and supported a recommendation to establish a mechanism to protect at least the names and acronyms recognized by Article 6*ter* of the Paris Convention. The Delegation emphasized that any mechanism for this protection should resemble the UDRP so far as possible, taking into account the privileges and immunities of such organizations by way of a special panel of appeal. The Delegation requested further discussions on this issue.

75. The Delegation of the European Community expressed its support for the remarks of the Delegation of Denmark, in favor of extending protection in the DNS to the names and acronyms of organizations covered by Article 6*ter* of the Paris Convention or by other given treaties. In this respect, the Delegation requested the Secretariat to provide the Special Session with a list of such names and relevant treaties which it was proposed to include in any such mechanism of protection.

76. The Delegation of Germany thanked the Legal Counsel of the United Nations for his statement on behalf of the United Nations Legal Advisers. The Delegation noted in particular the issues relating to Internet governance raised in the second portion of the statement. The Delegation did not consider these were appropriate issues to be discussed in this forum, but were rather issues for discussion in the Governmental Advisory Committee of ICANN. The Delegation expressed its support for a procedure based on the UDRP to protect the names and acronyms of IGOs in the DNS, and emphasized that the details of such procedure would require careful consideration. Noting the need to preserve the privileges and immunities of IGOs, the Delegation supported the implementation of an arbitral appeal procedure with ensuing awards enforceable under the New York Convention on the Recognition and Enforcement of Foreign Arbitral Awards (1958). Finally, the Delegation noted that the immunity of IGOs should not be regulated by the alternative dispute resolution procedure itself but should be grounded on existing principles of public international law.

77. The Secretariat noted that the UDRP included a requirement that complainants agree to submit to the jurisdiction of either the location of the registrar or the location of the respondent, as a means to overcome the uncertainty raised for respondents by the distributed nature of the Internet and the locale of potential complaints. The Secretariat observed that this requirement was the cause of the problem of immunities for IGOs.

78. The Delegation of Norway expressed its support for the remarks of the Delegation of Denmark.

79. The Representative of the International Federation of Red Cross and Red Crescent Societies (IFRC) expressed its appreciation for the accreditation of representatives of the International Red Cross and Red Crescent Movement as observers to both Special Sessions of the SCT. The Representative referred to its paper submitted to this Special Session (SCT/S2/INF/3), and noted that the International Federation of Red Cross and Red Crescent Societies was the international organization which groups together a world-wide membership of, currently, 178 National Red Cross and Red Crescent Societies. The Representative noted that these National Societies derived their status from the 1949 Geneva Conventions and owed their existence to legislation in most

countries. The Representative emphasized the importance of the existing obligation accepted by all States party to the Geneva Conventions, to protect the name and the emblem of the Red Cross and the Red Crescent from any misuse by any unauthorised person, including any imitation of these. The Representative noted, for example, that it was prohibited to use a shape and a colour close to a red cross or even using an acronym which raised an association for a viewer that this person belonged to the Red Cross/Red Crescent Movement. The Representative stressed that this was a critical point in Internet usage, as misuses of emblems, designs and names could easily distract or mislead people all around the world. Consequently, the Representative stated that adequate methodology for the protection of emblems and names should be accessible to National Red Cross and Red Crescent Societies, as well as to the Movement's international organizations, so as to enable them to effectively fulfil their responsibilities as "guardians of the names and emblems" in their respective areas of competence. The Representative expressed its support for the Special Session to establish a mechanism for the protection of the names and acronyms of international organizations enjoying protection under Article 6*ter* of the Paris Convention and to those other names and acronyms that were subject of specific protection under identified treaties such as the Geneva Conventions. The Representative stated its view that the first alternative offered in paragraph 11 of the Secretariat's paper (document SCT/S2/2), which would limit the scope of the mechanism to only those international organizations protected under Article 6*ter* of the Paris Convention would provide insufficient protection to the components of the International Red Cross and Red Crescent Movement. Instead, the Representative noted that such organizations fitted into the wider categorization in the second alternative, which also had the effect of helping States to fulfil their obligations under the Geneva Conventions by providing an additional effective and quick procedure for the misuses in the DNS. In this respect, the Representative noted that the protection of the Red Cross and Red Crescent name and emblem was distinguished in the Second WIPO Process Report (Chapter 4, footnote 2). The Representative requested that, in this context, the Special Session agree to extend protection under the UDRP to enable the International Federation of the Red Cross and their member National Red Cross and Red Crescent Societies, in accordance with Article 53 of the First Geneva Convention, to protect their names and emblems and enable them to discharge their humanitarian missions without hindrance or abuse.

80. The Representative of the Organisation for Economic Cooperation and Development (OECD) noted that, in the pursuit of protection of its own names and acronyms, the OECD had considered to institute legal proceedings in the United States of America under the United States Anticybersquatting Consumer Protection Act. The Representative noted that the OECD would welcome the implementation of a modified UDRP to clarify the protection granted to the names and acronyms of IGOs in the DNS. The Representative noted that its paper submitted to the Special Session (document SCT/S2/INF/2), gave examples of some but not all cases of abuse of OECD names registered in bad faith in various top level domains, remarking that where such registrations were passive they were not pursued. Citing one such example, the Representative noted that the Italian acronym for the OECD had been abused in connection with the Organisation's activities in Italy, and had been fraudulently used to mislead users by emulating the look and feel of the OECD's official site. In that case, the domain name was retrieved ex-judicially by means of pressure on the Internet service provider. The Representative stated the need to adjust the dispute resolution system to accommodate IGOs, who represented a special case for protection because they were conducting activities on behalf of governments, were universal and were special targets for abusive practices because of their high level public policy functions. The Representative stated that it did not share some Members' concerns regarding arbitral appeal procedures, and noted that the OECD regularly used such procedures in its investment activities and had found them to be well accepted and in conformity with due process requirements. The Representative stressed that consideration of protection in this context should extend beyond organizations covered by Article 6*ter* of the Paris Convention, and include other international

organizations. The Representative noted that it was in the interest of governments to implement a system of protection for the names and acronyms of IGOs in the DNS, as well as to ensure that the present system based on contractual agreements under ICANN auspices also worked well. In this respect, the Representative endorsed the comments of the Delegation of the United States of America, stating that abusive registrations should also be addressed by ICANN being encouraged to enforce registrants' contractual obligation to provide accurate and up-to-date contact details to the Whois databases, as well as by insisting on registration authorities contractual duty to investigate and require the provision of such information. The Representative noted that, while the question of an appeal mechanism in any dispute resolution procedure was important, it was rendered less important by the fact that most bad faith domain name registrants would not avail themselves of such appeals, but would prefer to remain unknown. The Representative stated that IGOs should be protected by the rule of law, but that any system should not be burdensome in operation. Once such regulation of the DNS was implemented, the Representative noted that national systems would be better able to protect their consumers and other interested parties. Finally, the Representative stated its support for a system of protection of names and acronyms of IGOs in the DNS, but noted that such a system could not cover all circumstances of abuse and would not replace the need to ensure the proper functioning of the contractual system of agreements currently in place in the DNS.

81. The Representative of the International Committee of the Red Cross (ICRC) thanked the Committee for its accreditation as an observer to the meeting, and referred to its previously submitted joint ICRC/IFRC report outlining its experience with abuse of its names in the DNS, acronyms and designations (document SCT/S2/INF/3). The Representative noted that the ICRC is mandated by the international community to protect and assist the victims of armed conflict, under a mandate conferred by the Geneva Conventions of 1949, their Additional Protocols of 1977 and the Statutes of the Red Cross and Red Crescent Movement, which were promulgated, in part, by the States party to the Geneva Conventions, and noted that the Conventions, with 189 States party, were among the most widely ratified of international treaties. The Representative stated that the ICRC had a unique status in international law and, while not a non-governmental organization, enjoyed international legal personality, as evidenced by the jurisprudence and rules of international tribunals and by the international treaties it had negotiated with nearly 80 States. These treaties recognized the ICRC's status, and privileges and immunities as being akin to those enjoyed by intergovernmental organizations, including Permanent Observer Status in the United Nations General Assembly, as well as in numerous other intergovernmental organizations. The Representative clarified, however, that the ICRC was not an intergovernmental organization, as it was not comprised of government members, but was based on a guiding principle of independence from States. The Representative reiterated that the mandate, the international legal status and the independence of the ICRC were all essential to the performance of its function. It was also noted that another essential attribute was the right of the Red Cross and Red Crescent Movement to the exclusive use of its names, designations and emblems, which were among the most widely recognized brands in the world, and connotated protection and assistance, neutrality and independence. The Representative stated that misuse of its name, whether or not in good faith, bred dilution of respect for these intended meanings which, because the ICRC's activities were often performed in the crossfire between warring parties, may have life and death consequences for the ICRC's staff, as well as for the population it seeks to protect and assist. It was noted that it was for these reasons that the Geneva Conventions and their Additional Protocols prohibited unauthorized use of the Red Cross names and designations and they, along with the Statute of the International Criminal Court which enters into force on July 1 of this year, rendered such use a war crime under certain conditions in times of conflict. The Representative noted, therefore, that the basis for the protection sought was well established in international law and that the practical need for such protection was compelling. The Representative also respectfully reminded the Special

Session that States were obliged not only to respect, but to ensure respect for the provisions of the Geneva Conventions, including provisions concerning the protection of the emblems and designations of the Red Cross. The Representative stated its position that this obligation of States may best be fulfilled by working toward the creation of a new administrative procedure to remedy the misuse of names and designations that were the subject of international treaties, but that did not already enjoy protection under UDRP. In this context, the Representative requested that any new remedy not be limited to rights already protected under Article 6^{ter} of the Paris Convention, where the Red Cross was arguably not covered, and further, that it not be limited to bad faith misuse. The Representative also agreed with the recommendation of the Legal Counsel of the United Nations that the UDRP should be modified to provide protection in a manner that respects the immunity of the organizations making use of the procedure. Finally, the Representative requested, given the unique international legal status of the ICRC, that any new regime should not be limited to intergovernmental organizations, but should also include the components of the Red Cross and Red Crescent Movement by name, or alternatively, should include any entity that enjoys relevant protections in international law.

82. The Representative of the American Intellectual Property Law Association (AIPLA) expressed its affinity with colleagues in the OECD, ICRC and IFRC, stating that the AIPLA and its members had faced similar problems. The Representative thanked the Secretariat for clarifying the meaning of 'abusive registrations' in the current discussions, and confirmed that the AIPLA is opposed to the registration and use of the names and distinctive acronyms of IGOs in the DNS where such activity is abusive. The Delegation noted that it was not briefed to address the issue raised by the Representative of the ICRC, concerning the harmful effects of registration of the names and acronyms of the Red Cross and Red Crescent Movements in the absence of bad faith.

83. The Representative of the International Federation of Industrial Property Attorneys (FICPI), expressed its support for the remarks of the Delegation of Australia, noting its concern with the proposal that an arbitral forum would replace recourse to appeal to the national courts, and establish a framework that would override sovereign national law. The Representative remarked that any system which removed the right to challenge or defend in a national court was better dealt with through the treaty process. The Representative also referred to the intervention of the Representative of the OECD suggesting it was no answer to suggest that reticence on the part of domain name holders to appear in legal proceedings, meant no recourse to national courts was necessary. The Representative noted that due process must be ensured.

84. The Delegation of Australia made a number of remarks regarding the general issue of the Internet's governance. First, the Delegation stated that the governance of the Internet was not an appropriate subject for consideration by the SCT and that WIPO, in general, had no mandate for Internet governance issues, except if such issues impacted on intellectual property. Second, the Delegation noted that a reform of ICANN was underway and encouraged countries to contribute to such reform through ICANN's Governmental Advisory Committee. Thirdly, the Delegation noted that intellectual property administrations generally had not sufficiently established links with other entities whose sphere of authority impacted upon intellectual property. The Delegation appreciated the Statement of the UN Legal Advisers and encouraged that it be brought to the attention of the appropriate entities in countries. The Delegation reiterated that it withdrew its opposition to the creation of protection for the names and acronyms of IGOs in the DNS and noted that there was an overwhelming majority in favor of such protection. The Delegation believed that the mechanism for protection should be based on the UDRP, which is most suited to deal with abusive behavior in the context of domain name registration and use. The Delegation stated that it would be abusive for such mechanism to cover cases where respondents had legitimate interests in the contested domain names, such as would be the case of a domain name corresponding to a

trademark. The Delegation noted that, apart from the two modifications to the UDRP set forth by the Secretariat, a third modification might be required, namely the incorporation of eligibility criteria (either in the form of a list or of a more general standard) to determine which organizations would have standing to file a complaint under the system. While the Delegation did not oppose to dealing with the question of the immunities of IGOs by not requiring them to waive such immunities when utilizing the procedure, but, instead, by requiring them to submit to an appeal mechanism in the form of arbitration, it nonetheless continued to have reservations regarding this proposal. First, it would place IGOs in a better position than States, as the latter were required to waive their immunities for purposes of filing a complaint under the UDRP. The Delegation, however, recognized the observations made by other delegations to the effect that IGOs were in a unique situation, as they could potentially be subjected to the jurisdiction of multiple countries in light of the international nature of their activities and that various international instruments involving IGOs routinely incorporated arbitration procedures for the purpose of dispute settlement. At the same time, the Delegation remarked that the concerns expressed by the Delegation of the United States of America regarding due process exigencies applicable within its jurisdiction should be weighed carefully, as the entities (ICANN, and the domain name registries and registrars) which would be tasked with enforcing any mechanism that might be proposed would be subject to the law of the United States of America. The Delegation opined that ultimately this may be a question that would need to be addressed by the organizations in question, although there was a risk that such bodies might not accept the recommendations for this reason. The Delegation also proposed that, whatever recommendation might result from the discussions, it include a specific recommendation that ICANN work toward ensuring compliance with the contractual provisions which were already in place within its system and which bear on intellectual property protection.

85. The Delegation of the United States of America strongly supported the Delegation of Australia's comment on the need for closer cooperation between intellectual property bodies and entities responsible for matters of telecommunication, as well as other relevant bodies. The Delegation reiterated its position that creating a protection mechanism for the names and acronyms of IGOs without recourse to national courts would constitute the creation of a new right. The Delegation reaffirmed that ensuring compliance with provisions currently incorporated in domain name registration agreements would go a very long way in solving the problems that exist, as the experience of the OECD has demonstrated.

86. The Secretariat clarified that, in accordance with the decision of the WIPO General Assembly at its meeting in September 2001 (document WO/GA/27/8), the Special Session of the SCT was to report to the WIPO General Assembly and to no other body. The Secretariat added that it would be to the General Assembly to decide how to deal with the recommendations of the Special Session. The Secretariat recalled in this connection that the letter of request submitted to it by twenty WIPO Member States (and later endorsed by the WIPO General Assembly) to initiate the Second WIPO Process had indicated that "the findings and the recommendations [of the Process] should be submitted to the Members of WIPO and for consideration by the Internet Community (including the Internet Corporation for Assigned Names and Numbers)." The Secretariat further explained that the purpose of the UDRP was to provide an efficient means for enforcing existing international norms. The Secretariat remarked that the UDRP was created to avoid the costs usually associated with litigation before national courts and the jurisdictional problems that would have arisen if only court systems had been relied upon to resolve disputes that arose on a global medium, such as the Internet. According to the Secretariat, the UDRP's ability to achieve its goal was depended on two factors, tied to the ICANN contractual system, namely (1) respect for the existing norms and (2) the agreement of domain name registrars to implement UDRP decisions within the DNS. The Secretariat observed that the core issue that was to be addressed by the Special Session was whether this procedure, which currently operates to enforce

existing international norms in the trademark area, should not also be relied upon to enforce other existing international norms concerning the names and acronyms of IGOs.

87. The Legal Counsel of the United Nations stated that it was not intended to oversimplify what was clearly a complex issue, which also involved questions concerning non-Latin scripts. The essential question was how to deal with situations where users, relying on domain names, expected to reach websites of IGOs, but in fact reached unrelated websites, sometimes containing pornography. The Legal Counsel believed that this question should be considered by the most learned body in the subject matter, which in the case of intellectual property, is WIPO. The Legal Counsel urged the Delegation of the United States of America to consider the issue from a broader perspective than just trademark law. If users were misled because they connected to different sites than those which they expected, this was a serious issue and it should be resolved before greater problems arise from it. The Legal Counsel further remarked that, in his view, it would not be burdensome to create the protection sought, as the United Nations routinely incorporates arbitration clauses in many of its contracts with private parties, as a means of settling disputes in a manner that is consistent with the immunities of IGOs. The Legal Counsel also stated that the United Nations was often implicated in litigation in certain jurisdictions, but that those cases were dismissed, in light of the immunities from which the Organization benefits under international law. The Legal Counsel remarked that such practice was consistent with an Advisory Opinion of the International Court of Justice to the effect that the United Nations cannot be brought before a national judicial system. It was further observed by the Legal Counsel that any dispute settlement mechanism ultimately relied on national law for its enforcement and legitimacy. Finally, the Legal Counsel stated that it was clear that WIPO's mandate would not allow it to deal with all aspects of Internet governance, but that the observations in question were made to the Special Session, because its members were well placed to bring the matter to the attention of appropriate instances at the national level.

88. Noting, in particular, Article 6*ter* of the Paris Convention, to which 163 States are party,

1. The Special Session recommends that the UDRP be modified to provide for complaints to be filed by an international intergovernmental organization (IGO)

A. on the ground that the registration or use, as a domain name, of the name or abbreviation of the IGO that has been communicated under Article 6*ter* of the Paris Convention is of a nature

(i) to suggest to the public that a connection exists between the domain name holder and the IGO; or

(ii) to mislead the public as to the existence of a connection between the domain name holder and the IGO; or

B. on the ground that the registration or use, as a domain name, of a name or abbreviation protected under an international treaty violates the terms of that treaty.

2. The Special Session further recommends that the UDRP should also be modified, for the purposes of complaints mentioned in paragraph 1, to take account of and respect the privileges and immunities of IGOs in international law. In this respect, IGOs should not be required, in using the UDRP, to submit to the jurisdiction of national courts. However, it should be provided that decisions given in a complaint

filed under the modified UDRP by an IGO should be subject, at the request of either party to the dispute, to de novo review through binding arbitration.

3. The Delegation of the United States of America dissociated itself from this recommendation.

Country Names

89. After the Secretariat's summary of the findings of the Second WIPO Process Report on the issue of country names, the Chair recalled the conclusions reached on this topic at the first Special Session, as reflected in its Report (document SCT/S1/6).

90. After the Chair recalled the questions regarding the protection of country names on which the Secretariat had sought comments by delegations, the Secretariat summarised the comments which it had received on such questions, as reflected in the document SCT/S2/3.

91. The Chair proposed that delegations recall their position on the principle of protection for country names in the DNS, after which a discussion could start on the specific questions on which submissions were sought by the Secretariat.

The Principle of Protection of Country Names

92. The Delegation of Germany expressed its support for the position taken in the first Special Session, in favor of protection of country names, such as deutschland.com, in the DNS. The Delegation referred to the protection granted through the .INFO exclusion scheme, and noted its preference for an exclusion mechanism over a UDRP-type challenge procedure, provided the list of country names to be protected was not too extensive.

93. The Delegation of the United States of America stated that it was not in favor of protection of country names in the DNS. The Delegation thanked the Secretariat for its work on the suggested challenge mechanism, but emphasized that any such system of protection should be based on a preexisting property right and, as in the current system country names may be freely used, any such dispute resolution mechanism would be overreaching. The Delegation noted that any forceful taking of domain names from existing owners was neither desirable nor necessary in the absence of evidence of harm caused by the registration of country names as domain names that could outweigh the potential harm which could result from implementation of a dispute resolution system in this context. The Delegation noted that country names could legitimately be used on the basis of fair use and trademark rights, and could therefore be registered in good faith as domain names in accordance with national law. In the absence of an illegal act, the Delegation noted that any remedy of cancellation or transfer of such domain names would amount to an expropriation. Further, the Delegation stated that any transfer of such domain names to a government could create a *de facto* property right in the country name, suggesting that any use of the country name could be prohibited without government consent. The Delegation noted that, despite the lack of international consensus on whether a property right existed in a country name, a dispute resolution mechanism such as that proposed could create an absolute right in the country name. The Delegation expressed the view that any misleading use of country names in the DNS would in any event fall within the ambit of national laws regulating fraud, and noted that countries could safeguard their national interests through the ccTLDs. The Delegation noted the existence of alternate solutions for the protection of country names in the DNS, in particular the protection of

such names in .INFO recently established at ICANN, and the possibility of the creation of a new top level domain devoted to official use by governments. In this context, the Delegation noted that Whois databases could be used to discover incidence of bad faith registrations of country names as domain names, and that such bad faith activities could be regulated via action based on each registrant's contractual agreement to provide accurate and up to date contact information upon registration of each domain name. Finally, the Delegation noted that reliance upon such contractual obligations could overcome the difficulty posed by the absence of international standards for the protection of country names under international law.

94. The Delegation of the European Community referred to its written submission on the topic of country names and requested that it be added to the list of commentators which were in agreement on the principle of protecting country names in the DNS, as reflected in the first footnote of document SCT/S2/3.

95. The Delegation of Germany shared the view expressed by the Delegation of the United States of America according to which country names were not intellectual property and stated that such terms had no commercial purpose, but were grounded on public international law. The Delegation specified that the cases which its Government had brought under the UDRP in relation to the names of certain of its ministries, to which it had referred earlier during the Session, concerned nazi web sites operated by persons located in the United States of America. The Delegation explained that it had been necessary for its Government to revert to trademark law in an attempt to redress this egregious situation through the UDRP. The Delegation stated that it would be very doubtful if its Government were ever to claim unregistered trademark rights in the name of its country. Consequently, its Government would not be able to rely on the UDRP for the purpose of combatting abusive conduct in relation to the name of its country. The Delegation noted that it would be preferable to dispose of a straightforward avenue for redress, similar to the UDRP, in such cases of abuse, rather than having to revert to the traditional judicial mechanisms.

96. The Representative of the European Community Trademark Association (ECTA) expressed a lack of conviction that the time was ripe for the introduction of an international dispute resolution process with regard to geographical indications and terms. Noting that a similar situation existed at the time of the first Special Session, the Representative stated that the problem was a lack of international consensus on the scope of protection to be granted, and that therefore the implementation of a dispute resolution mechanism for such identifiers was premature. The Representative noted, if it was decided that protection should be granted to a restricted list of country names, it would be important to ensure that this would not open the door to protection for other geographical terms.

97. The Representative of the American Intellectual Property Law Association (AIPLA) raised the question of bad faith with reference to the examples listed in Annex 12 of the Second WIPO Process Report, and noted that clarification was required as to what constitutes 'misuse' of such country names in the DNS. The Representative informed the meeting of the results of a search that had been conducted for registrations corresponding to the names included in the International Standard ISO 3166-1 on Country Codes (the "ISO Standard") names in English that had already been registered as domain names, and noted that 459,896 such domain names already existed. The Representative posed the question whether all such registrations were in 'bad faith', by virtue of their mere existence. The Representative noted that exceptions may be made for prior rights existing in relation to country names registered as domain names, but that if protection was granted against registration of names beyond identical country names, then this may inhibit the future development of trademarks and affect the intellectual property system in a manner that was

not warranted under trademark law, which currently permits the incorporation of country names in trademarks and domain names.

98. The Delegation of South Africa made a comprehensive presentation of its position in favor of the protection of country names in the DNS, which position is reflected in document SCT/S2/6.

99. The Delegation of China stated that country names were part of the sovereign attributes of States and that each country should decide whether it wished to protect its country name. The Delegation explained that, in its view, there should be a list of country names to be protected and that names which did not appear on such list, should not benefit from protection. The Delegation noted that the United Nations Terminology Bulletin No. 347/Rev. 1 (the "UN Bulletin") or the ISO Standard could be relied upon for this purpose. The Delegation observed that no problems would arise with regard to the UN Bulletin and the ISO Standard, but according to the ISO Standard, the territories of Hong Kong and Macao should be followed by "SAR" respectively.

100. The Delegation of Sweden stated that, consistent with its position at the first Special Session, it remained in favor of the principle of protection for country names in the DNS.

101. The Secretariat noted that a further written submission had been received from the Delegation of Mauritius expressing support for the principle of protection for country names in the DNS and stated that such submission would be made available to the Special Session as document SCT/S2/7.

102. The Delegation of Canada reaffirmed its position that it did not favor the creation of protection for country names in the DNS and that this matter should be left for governments to decide at the international level. The Delegation added that this did not imply that it opposed all forms of such protection. It referred in this connection to the measures taken in .INFO and the possibility of a new official gTLD for governments, as examples of alternative forms of protection, which merit further attention.

103. The Delegation of Japan expressed the view that it did not support an expansion of the scope of the UDRP in order to protect country names in the DNS and stated that other forms of protection, such as those adopted in relation to .INFO, should be further considered. The Delegation further stated that the names of the ISO Standard should be protected in the official languages of the relevant countries, based on a declaration by the government of the country, or authority of the territory concerned.

104. The Delegation of Mexico reiterated the position it had adopted at the first Special Session, whereby country names should be protected against use in bad faith within the DNS.

Discussions Regarding Secretariat Questionnaire

Question 1: How should the name of a country be identified (for example, by reference to the United Nations Terminology Bulletin, ISO Standard 3166, or by some other method) and should both the long and short names of countries be protected?

105. The Delegation of Germany expressed agreement with the proposition advanced by the Delegation of South Africa to the effect that the issue of country name protection in the DNS was not purely a commercial matter, but also implicated questions of state sovereignty. The Delegation noted that territories such as Guadeloupe and Martinique appeared on the ISO

Standard, but that other territories such as Bavaria did not. Reliance on the ISO Standard would therefore favor certain countries in comparison to others, which result would be hard to accept. That being the case, the Delegation expressed a tentative preference for relying on the UN Bulletin or the creation of a new list, although it would be hoped that the latter could be avoided. The Delegation generally favored a limited list and proposed that protection be granted only in relation to identical domain names and in the official language(s) of the country concerned.

106. The Secretariat clarified that a distinction should be made between two questions. First, which territorial entities should be protected (country names, or also other territorial entities, such as provinces, etc...)? Second, once the first question was answered, how does one proceed to identify the term denoting the territorial entity whose name was decided to merit protection? Consequently, it would be possible to decide that the names of all countries which are Members of the United Nations should be protected (answer to the first question) and that such names should be identified by reference to the UN Bulletin (answer to the second question). Alternatively, it could be decided that the names of the countries that are WIPO Member States should be protected, but this would lead to a lesser number of countries benefitting from the protection envisaged, as there are more members of the United Nations, than there are of WIPO.

107. The Delegation of Mexico said that country names should be identified by referring to the UN Bulletin, and emphasized that the names of a number of independent States which were not United Nations members should also enjoy protection. The Delegation therefore proposed that a new list, based on the UN Bulletin and protecting the long and short forms of the country names, should be drawn up so as to apply also to the countries that were not members of the United Nations.

108. The Delegation of the Netherlands expressed the view that protection should be based on the UN Bulletin as well as the ISO Standard and that countries should be allowed to add a limited number of names which are not on those lists, but by which the country was commonly known (such as "Holland" for the Netherlands).

109. The Delegation of the European Community stated that the ISO Standard should primarily be relied upon (perhaps with certain modifications as suggested by the Delegation of the Netherlands) for historical reasons and because the Internet community is more familiar with this instrument. The same approach could be taken in respect of the UN Bulletin in order to construct an ad hoc list.

110. The Delegation of South Africa expressed support for the position of the Delegation of the Netherlands. It remarked that protection should be based on the UN Bulletin, as well as the ISO Standard, that protection should be granted to both the long and short names, and that variations of country names also should receive protection.

111. The Delegation of the United Kingdom expressed unease with the idea of adding names to the UN Bulletin or the ISO Standard, as those lists are clearly agreed upon and any proposed changes to them might be controversial.

112. The Delegation of Uruguay said that it was in favor of identifying country names by referring to the ISO Standard. In the same way as the Delegation of the European Community, the Delegation also stressed that this list could be complemented by the UN Bulletin so as to benefit from the advantages indicated by the Secretariat on page nine of document SCT/S2/3.

113. The Delegation of Egypt preferred to rely on the UN Bulletin, as this is the most authoritative document on the subject matter, and therefore would avoid to the maximum extent any controversy.

114. The Delegation of Sri Lanka agreed that the UN Bulletin would be an appropriate starting basis, but noted that, in certain instances, countries were commonly known by names that did not appear on this list, as was the case for the name of its country which was in use during the colonial era. The Delegation therefore suggested an open, rather than a closed approach to the issue.

115. The Delegation of Australia reiterated that, in principle, it did not favor protection for country names, but recognized that there seemed to be consensus on the question, except among a few delegations. The Delegation repeated its view that the central issue appeared to be against what type of conduct any protective measures might be aimed. In the Delegation's view, if the focus would be on combatting abusive registrations, a finite list of country names probably would not be effective, because abuse likely would take the form of variations of the names appearing on the list in question.

116. The Delegation of Spain said that, even though the UN Bulletin or the ISO Standard both constituted appropriate means of identifying country names, it would prefer to refer to the ISO Standard for both the long and the short forms of country names.

117. The Delegation of the Russian Federation was of the view that country names should be protected against their registration by persons unconnected to the official authorities of the countries in question. The Delegation stated that the UN Bulletin and/or the ISO Standard could be used as the starting basis for providing the protection in question, but that such lists could be supplemented, as long as any supplementation would be communicated to all States and an organ, possibly WIPO itself, would function as the custodian of the new list.

118. The Delegation of China expressed agreement with the Delegation of the Federation of Russia. It stated that protection should preferably be based on the UN Bulletin and be granted to both the full and short names of countries. The Delegation observed that, if names were to be added to the list, this should occur with the confirmation of all countries and that an appropriate organ should administer the new list.

119. The Delegation of Honduras said that it wished to identify country names by referring to the UN Bulletin.

120. The Delegation of the Republic of Korea requested clarification as to the difference between the ISO Standard and the UN Bulletin, as to the difference between long and short country names, and asked whether such lists included the names of parts of countries, such as England and Scotland, as well as the United Kingdom.

121. The Secretariat noted that the UN Bulletin contained both long and short names of countries (for example, it listed both the French Republic and France, and both the People's Republic of China and China), based on the official position adopted by each country, so as to avoid confusion. The Secretariat clarified that the ISO Standard also contained both short and long country names.

122. The Delegation of Denmark expressed its support for creating a new list of country names incorporating both the UN Bulletin and the ISO Standard and, in support of the positions of the Delegations of the Netherlands and South Africa, granting countries an opportunity to add terms to

the list as they saw fit. However, the Delegation expressed its concern, shared with the Delegation of Germany, that problems could arise if regions within a country requested such protection.

Question 2: In what languages should country names be protected?

123. The Delegations of China, France, Morocco, the Republic of Korea, South Africa and Uruguay expressed the view that country names should be protected in the official language(s) of the country in question, as well as in the six official languages of the United Nations.

124. The Delegation of Germany supported protection in the official language(s) of the country concerned, but was also open to the suggestion of establishing additional protection in the six official languages of the United Nations.

125. The Delegations of Germany and Morocco emphasized that transliteration issues likely would arise in respect of non-Latin scripts.

126. The Representative of ICANN noted that the identification of country names is a complex matter which had been dealt with also by the ICANN .INFO Country Names Discussion Group, as reported in document SCT/S2/4. The matter was complicated, according to the Representative, because one had to be mindful not to create new rights in names and because there is an infinite variety of country names. The Representative further observed that the same Discussion Group noted that the solution has limited utility and therefore recommended that the Board refer to the GAC, which WIPO is a member of, whether there was an interest on the part of governments in exploring the potential utility of a new Top Level Domain (TLD) specifically for use by governments of countries and distinct economies.

127. The Delegation of Japan noted that, with respect to the question of language, each country's name should be protected in that country's language and script (based on a declaration of the country) plus English, based on the ISO Standard. The Delegation cautioned that protection in the six official languages of the United Nations would amount to over-regulation of the Internet which would prevent and distort future developments of the medium.

128. The Delegation of Australia reiterated that, as a basic proposition, Australia did not support a system of protection for country names in the DNS, but that its comments were offered in recognition of the widespread support for such a system. The Delegation noted that the questions posed in document SCT/S2/3 were interrelated, such that the question as to in which languages names should be protected would depend in part upon which mechanism was chosen for protection, and whether protection was given absolutely or only against bad faith registrations. The Delegation noted that, if an exclusion mechanism were recommended, then the list of country names to be excluded should be very tight, whereas if an administrative dispute resolution procedure were recommended, based on a finding of bad faith, then the question as to languages was of less significance and could be addressed by the panelist in the course of the dispute procedure.

Question 3: To what domains should any protection be extended (for example, to all, both existing and future, gTLDs, only to future gTLDs, also to ccTLDs, etc.)?

129. The Delegation of South Africa expressed its support for protection in all gTLDs, new and existing.

130. In view of the limited interventions on this question, the Chair assumed that the summary of views contained in SCT/S2/3 in favor of protection of country names in all existing and future domains reflected accurately the positions of delegations.

Question 4: How should any alleged acquired rights be treated?

131. The Delegation of Morocco said that attention should be focused initially on question 5, i.e. what mechanism should be used to protect country names within the DNS, before determining how the rights that had been acquired should be dealt with.

132. The Delegation of Japan stated that any registrant of a country name already registered should be permitted to maintain such registration. With respect to Question 3, the Delegation noted that protection should apply only to future gTLDs.

Question 5: What mechanism should be used to implement protection (for example, the UDRP or some other mechanism)?

133. The Delegation of the European Community stated that protection should extend to future as well as present domains, applying a system of exclusions in relation to future gTLDs and an administrative dispute resolution system for existing gTLDs. With respect to any system of exclusions, the Delegation noted that either the ISO Standard or the UN Bulletin could be used, but that only exact country names should be excluded from registration.

134. The Delegation of South Africa, addressing Questions 4 and 5, noted that registration of any country name as a second level domain name is *per se* bad faith, because no other person had the right to appropriate such names, which are valuable national assets of sovereign nation States. The Delegation emphasized that this was an issue of particular importance to developing countries, whose names had often been abusively registered by entities with no connection to the State, where the registration was misleading as to source and a false designation of origin. The Delegation stated that it was indisputable that such registrations were intended to trade on the economic value of nations and to profit from diversion of Internet traffic. The Delegation therefore supported the cancellation of all such existing domain names. With respect to Question 5, the Delegation supported the modification of the UDRP to enable States to bring proceedings before an ICANN-accredited dispute resolution service provider in cases where the domain name was identical to the official or commonly known name of the State, to result in a binding arbitral award which was enforceable in court. In cases where the domain name was identical to the country name and was not used for bona fide purposes, the Delegation stated that such name should be transferred to the State. However, in cases where the domain name was used for the bona fide provision of significant information about the country, the Delegation recommended that the panelist be given discretion to award first, a small and reasonable monetary payment, and second, to require the State to provide a link on its site to the new site of the registrant, provided that site was used for appropriate purposes. Finally, the Delegation stated that Article 6ter of the Paris Convention should be clarified or amended to explicitly protect country names for use only with the authorization of the State.

135. The Delegation of Japan stated that country names should be restricted for use in accordance with the registration policy of each registry operator.

136. In response to question 5, the Delegation of Morocco proposed that use should be made of the UDRP so as to allow countries, on the basis of the UN Bulletin, to recover their names which had been registered as domain names.

137. The Delegation of South Africa emphasized the distinction in treatment of registrants who were bona fide providers of information, and those who were bad faith misleading registrants of country names.

138. The Delegation of Australia expressed concern at the language used by some delegations implying that a 'name belongs to a country', and emphasized that a State had no right to its name under international law. Referring to the intervention of the Delegation of the Republic of South Africa, the Delegation of Australia noted that amendment of Article 6*ter* of the Paris Convention was not currently under consideration by the Special Session, and noted that any change to confer protection on country names would require a substantive amendment to the Convention, and not simply a clarification. The Delegation noted that in the substantial debates during the drafting of Article 6*ter*, the international community had deliberately not conferred rights to a country name on each country. While acknowledging the general consensus of the Special Session towards protection of country names, the Delegation did not recognize a country's right in its name and therefore opposed the reservation of identical country names as domain names for use only by the authorized representative of the State. For the same reasons, the Delegation opposed the transfer of a domain name reflecting a country name to the State, or its reservation, because this remedy would confer an automatic right in the name upon the State. The Delegation was not in favor of exclusion of country names, because this mechanism was not effective to prevent the worst forms of abuse in the DNS, and stated that the only effective system of protection is a modified UDRP process.

139. The Delegation of the European Community expressed its agreement with the intervention of the Delegation of Australia, insofar as there was no explicit right of a country to its name under international law. Following this logic, the Delegation noted that a domain name registrant also acquired no rights in the domain name, but merely a capacity to use or license the name by virtue of first use, in the same manner as a telephone number.

140. The Delegation of the United States of America expressed support for the intervention of the Delegation of Australia, and stated that it did not support the protection of country names in the DNS either via an exclusion mechanism or a dispute resolution procedure. The Delegation raised two issues of concern, namely: the treatment of trademarks incorporating country names and the treatment of generic terms including country names, for example the use of 'Turkey' for carpets and 'Japan' for lacquer. The Delegation noted that any system of protection which would restrict industries from using generic terms would have harmful effects.

141. The Delegation of Canada expressed its support for the comments of the Delegations of Australia and the United States of America and, in view of the need for consistency with Canada's domestic trademark law, did not support protection for country names in the whole DNS. The Delegation of Canada does support protection of country names in the .INFO Top Level Domain.

142. The Delegation of the United Kingdom noted that the use of an exclusion list to protect country names was impractical and that the most effective system appeared to be a modified UDRP.

143. The Delegation of South Africa emphasized the importance of the protection of country names in the DNS to developing countries, noting that the digital divide existed both between the first and third worlds, but also within the first world countries. The Delegation reiterated that where country names were permitted to be registered as second level domain names on a first-come, first-served basis, this resulted in a gold rush primarily by western private entities seeking to appropriate developing countries' sovereign assets. The Delegation expressed

disagreement with the interventions of the Delegations of Australia and the European Community and stated that, even if not explicit in international law, States had an implied right in their names.

144. The Delegation of Algeria said that it supported the protection of country names within the DNS for different reasons. It put forward reasons linked to sovereignty and also observed that international law was not static and that SCT members were able to develop international standards so as to protect country names within the DNS. Finally, the Delegation put forward commercial reasons and explained that in Algeria, since the registration of a country name as a trademark could give rise to unlawful practices, it was prohibited.

145. The Delegation of Germany stated that domain names were merely alphanumeric addresses that had gained value as assets, but could not be possessed by right. The Delegation noted that, although originally in favor of an exclusion mechanism, it now supported a modified UDRP for protection of country names in the DNS in order to fight abuse of such identifiers.

146. The Delegation of the Netherlands supported the position of the Delegation of the European Community and stated that an appropriate way forward would be the establishment of an exclusion mechanism (possibly effectuated through a sunrise registration system) in relation to new gTLDs with a public character. In relation to existing gTLDs, the Delegation believed that a challenge procedure based on the UDRP would be sufficient.

147. The Delegation of China stated that the name of a country was an expression of its sovereignty and that, consequently, nobody other than the country should be allowed to register such name, irrespective of which system might be used to achieve this goal. The Delegation remarked that the identification of the name should be based on the UN Bulletin and the ISO Standard.

148. The Representative of the American Intellectual Property Law Association (AIPLA) stated that it did not approve of the abusive registration of country names as domain names. However, the Representative observed that an exclusion mechanism would not be an appropriate form of protection. The Representative explained that it had performed a search on the Internet which revealed that more than 450,000 domain names incorporate country names, as those appear on the ISO Standard. The Representative remarked that most of these registrations are probably not in use and that the overall majority took the form of variations of country names. According to the Representative, an exclusion mechanism would be doubly flawed, in the sense that it could not offer protection in relation to variations of country names that are clearly abusive and that it would not permit registrants with legitimate interests in the names to obtain or maintain good faith domain name registrations corresponding to country names.

149. The Delegation of the Russian Federation considered that the mechanism for protecting country names against their registration as domain names could consist of two parts: (1) a modified UDRP and (2) an exclusion procedure. In that regard, the Delegation stated that the UDRP could be used in relation to all registered domain names which resemble country names. A request within the UDRP to cancel or to transfer domain names could be submitted on behalf of a national government. The list of country names should not be used for the purpose of this modified UDRP. A request should contain evidence that a domain name is similar to a country name, and also that the domain name registrant is not acting on behalf of a national government. As regards the exclusion mechanism, it should be used to prevent the registration of an exact country name. In this case, the mechanism would be based on the application of a list of countries, which would be compiled according to the UN Bulletin (using, where necessary, the ISO

Standard). Thus, the work of the Special Session on the list of countries would not be in vain and would be utilized when describing the exclusion mechanism.”

150. The Delegation of Sweden supported the protection of country names in the DNS, but expressed concerns about the creation of different protection systems for different identifiers, as this would complicate matters. The Delegation believed that it would be preferable to rely as far as possible on the UDRP framework with a view to uniformity. The Delegation concluded that broadening the scope of the UDRP to cover country names was the most appropriate way forward.

Question 6 and 7: Should any protection extend to the exact country name only or also to misleading variations?/ Should protection be absolute or should it be dependent upon a showing of bad faith?

151. The Delegation of Japan expressed the view that only exact country names should be protected in the new gTLDs, because otherwise too many names would benefit from protection. The Delegation stated that protection should be absolute and not dependent on a showing of bad faith.

152. The Delegation of China supported the position of the Delegation of Japan on both issues.

153. The Delegation of Australia was of the view that an exclusion system would be either unworkable or ineffective. If the system were to apply also to variations of country names, it would be unworkable, because registration authorities would not be capable of putting it into effect. If it were to apply only to exact country names, it would be ineffective, because most abusive practices concern variations of country names.

154. The Delegation of Germany expressed agreement with the Delegation of Australia and modified its earlier position on the question of the most appropriate means of establishing protection for country names in the DNS. The Delegation reiterated that, after considering the interventions by other delegations and further reflection on the matter, it had concluded that a challenge procedure based on the UDRP would be the most appropriate way forward. The Delegation reviewed the definition of what might be deemed an abusive registration of a country name, as proposed in paragraph 35 of document SCT/S2/3, and expressed the view that this standard was perhaps too narrowly crafted, as it would seem to permit certain conduct which would normally be deemed abusive. The Delegation referred in this connection to the case it had previously mentioned concerning the nazi websites. The Delegation, however, recognized that it would not be simple to devise a broader standard.

155. The Delegation of the United Kingdom expressed support for the points of view of the Delegations of Australia and Germany. The Delegation stated that a challenge procedure would be more appropriate than an exclusion mechanism.

156. The Delegation of South Africa took the view that misleading variations of country names should be covered and that protection should be absolute.

157. The Delegation of the Russian Federation observed that its country was well known by the name Russia, although this name did not appear in the UN Bulletin or the ISO Standard. The Delegation believed that the name Russia nonetheless also should receive protection. The Delegation expressed the view that there should not be a requirement of bad faith, as only a government should be allowed to register the name of a country.

158. The Secretariat clarified that, in considering the number of abusive registrations as referred to by the Representative of the AIPLA, a distinction should be borne in mind between, on the one hand, a right and, on the other, the exercise of such right. The Secretariat remarked that also in the trademark arena, not all domain names that corresponded to trademarks were challenged under the UDRP by rights owners. Furthermore, practices differed from one country to another and, in certain countries, the use of a name corresponding to a mark might be permitted (for instance, the mark “Canada Dry”). The Secretariat considered that this needed to be borne in mind when anticipating the total number of potential disputes.

159. The Representative of the American Intellectual Property Law Association (AIPLA) clarified that the some 450,000 domain names which it had discovered to incorporate the names of countries included domain names where figures or letters were placed before or after the term corresponding to the country name. For instance, the domain name ottoman.com was part of the list, because the country name “Oman” was embedded in the string, although the domain name ostensibly bears no relationship with the country in question. Furthermore, the list contained domain names corresponding to country names, which were also generic in the English language, such as, for instance, the word “china” for baked and glazed fine white clay.

160. The Delegation of Australia noted that the standard proposed in paragraph 35 of document SCT/S2/3 finds its origin in the avoidance of consumer confusion, but that discussions were more centered on sovereignty. However, the Delegation nonetheless recognized that no other viable alternative might be available and therefore considered the proposal as adequate. The Delegation further illustrated the practical difficulties that would be encountered in applying an exclusion mechanism to variations of country names by reference to a number of examples appearing on the list of 450,000 domain names presented by the Representative of the AIPLA.

161. The Secretariat clarified that the term “consumer confusion” contained in paragraph 34 of document SCT/S2/3 should be read to mean “user confusion” and that it was not aimed specifically at the economic consumer in the market.

162. The Delegation of Australia remarked that it would be useful to consider whether any abusive registration of a country name could be imagined which would not be covered by the standard proposed in paragraph 35 of document SCT/S2/3.

163. The Delegation of the European Communities Trade Mark Association reiterated its scepticism regarding the wisdom of creating protection in the DNS for geographical terms, including country names. However, the Delegation stated that, if such protection were decided to be created, it could support the standard proposed in paragraph 35 of document SCT/S2/3.

Further Discussions on Modalities of Protection

164. The Chair drew attention to the fact that the Secretariat had distributed three informal documents for consideration of the Special Session: (a) the relevant pages of the UN Bulletin, (b) the relevant pages of the ISO Standard, and (c) a table listing differences between the UN Bulletin and the ISO Standard. With a view to advancing the debate, the Chair suggested that Delegations focus their comments on the following three principal questions: Should the protection apply only in relation to domain names that are identical to country names, or also to those that are misleadingly similar? Should protection be based on the UN Bulletin, the ISO Standard or both? Would the wording proposed in paragraph 35 of document SCT/S2/3 be an appropriate means of defining domain name abuse of country names?

165. The Secretariat provided further explanations regarding the various lists of country names that had been informally made available to the Special Session. The Secretariat stated that, if it were decided that both the UN Bulletin and the ISO Standard should be used as a basis for protection, it would be important to clarify whether that would imply that territories and entities contained in the ISO Standard that would not be considered to be “countries” also should be taken into consideration, or that the combination of the UN Bulletin and the ISO Standard would only apply to countries that are members of the United Nations or WIPO.

166. The Delegation of Denmark made a distinction between the objective of achieving protection for exact matches of country names and for variations. The Delegation of Denmark was of the view that the goal was not to create rights, but to grant access to domain names usually associated with countries to the appropriate instances. In cases of domain names which were identical to country names, the Delegation proposed that there be an assumption of bad faith for purposes of the challenge procedure. In cases of variations of country names, the Delegation believed the standard proposed in paragraph 35 of document SCT/S2/3 could be applied. With regard to which list of country names would be preferable, the Delegation opted for the ISO Standard.

167. The Delegation of Germany queried whether an exclusion mechanism for country names would prevent governments themselves from registering the names in question.

168. The Delegation of the United States of America expressed serious concerns about creating a new list of names, based on a combination of the UN Bulletin and the ISO Standard, as this would amount to trade negotiations and could have the unintended consequence of elevating a geographical place or entity to “State” status.

169. The Delegation of Spain underlined that if the ISO Standard and the UN Bulletin were used, it might be useful to specify the difference between territories and countries. The Delegation said that taking into account the explanations given by the President, it might be appropriate to use the UN Bulletin.

170. The Secretariat pointed out that the question of the Delegation of Germany illustrated the difficulties associated with an exclusion mechanism.

171. The Delegation of the United Kingdom supported the statement made by the Secretariat concerning an exclusion mechanism. It also remarked that it would be required to consider more carefully the proper meaning of the concept of bad faith in relation to country names.

172. The Delegation of South Africa expressed the view that domain name registrars had no right to grant second-level domain name registrations corresponding to country names to private parties, without the agreement of the relevant government. It proposed that registrars exercise reasonable care during the registration process to ensure that country names were not granted to inappropriate parties.

173. The Delegation of Australia explained that in its country the domain name registration process was entirely automatic and that it would oppose any recommendation to the effect that registrars would be obliged to verify applications for domain names, as this would cause significant delays and additional costs in the registration process. Furthermore, the Delegation believed such recommendation would have a negative effect on the intellectual property community’s ability to influence the DNS.

174. The Secretariat explained that one of the goals of the UDRP was to remove the burden of verification prior to registration from registrars, by creating a flexible dispute resolution procedure to deal with any problems that may arise as a result of the lack of such verification. The Secretariat stated that introducing verification of country names in advance of registration would be a radical departure from that approach. Furthermore, the Secretariat believed that it might be impossible for registrars to perform the verification in relation to country names in scripts with which they are not familiar.

175. The Delegation of South Africa reiterated that registrars should have a duty of care and that the problems were created because there currently was no such duty. The Delegation believed that if this situation would not be improved upon in the future, at one point the entire DNS risked falling into disrepute. The Delegation submitted that only a few hundred names were at stake and that it could not be imagined how verification of such a limited number of names prior to registration could be deemed unreasonable or overly burdensome.

176. The Delegation of Morocco reiterated its position on the need to settle the question of the mechanism to be set up, i.e. either a mechanism *a priori* or a mechanism *a posteriori*. In that regard, the Delegation said that it considered a mechanism *a posteriori*, based on the UDRP, to constitute a satisfactory mechanism.

177. The Delegation of the United States of America, in response to the intervention made by the Delegation of Denmark, stated that ICANN could not force domain name registrars to adopt a procedure which had no clear legal basis, as there would be a serious risk that the organizations in question might be sued in court for taking such action.

178. The Delegation of ICANN stated that any solution should have a firm basis in international law and that other tangential problems, such as increased operating costs, also should be considered. The Delegation reminded that suggestions had been made to create a new gTLD for official use by governments, which may be an attractive and realistic alternative. The Chair of the Names Council of the Domain Name Supporting Organization (DNSO) of ICANN, the body responsible for advising the Board on policy issues relating to the Domain Name System, added that an appropriate balance would need to be found between functionality and protection, and that it would be more likely that a challenge procedure succeeds in meeting that balance, rather than requiring registrars to verify in advance domain name applications, particularly in light of increasingly automated registration processes.

179. With regard to the proposal for a new gTLD for official use by governments, the Secretariat noted that such proposal had also been made in the past for trademarks, but that it had not been found satisfactory, because it did not address abuse in other domains. The Secretariat added that the Second WIPO Internet Domain Name Process had reached the same conclusions in relation to the .INT domain.

180. The Delegation of the United Kingdom noted that its Government used second and third level domains to avoid user confusion in reaching its web sites, for example, patent.gov.uk, in the .UK ccTLD. The Delegation stated that action was only taken with regard to particularly egregious conduct.

181. The Delegation of Sweden remarked upon the issue of prevention of misleading conduct as regards registration of country name domain names, raised in paragraph 35 of document SCT/S2/3, and noted that this activity may be characterized as giving such registrants unfair

advantage over their competitors, which could be classed, in terms of legal basis, as unfair competition, as defined by Article 10*bis* of the Paris Convention.

182. The Delegation of the Republic of Korea referred to the statement of the Delegation of Germany and stated that the establishment of a new top level domain exclusively for government use was not an acceptable solution, as it would not prevent abusive registration of country names in other domains. The Delegation noted that the commonly known name for its country, Korea, was neither on the ISO Standard or the UN Bulletin, and queried how the essential parts of each countries' names such as Korea of the Republic of Korea and America of the United States of America could be protected. In addition, the Delegation asked whether States confederations and their acronyms such as CIS would be included. The Delegation stated that the commonly known acronym for the Republic of Korea was not KOR nor KR as in the ISO Standard or the UN Bulletin but ROK, and inquired whether it would be included in the scope of protection. Finally, the Delegation stated that Korean script called Hangul which is a phonetic symbol could describe any country's name, and questioned whether the abusive uses of other country's names in the DNS in Korean script would not be problematic.

183. The Secretariat clarified that any system that gave protection to misleading variations of names would cover the essential part of any name.

184. The Representative of the American Intellectual Property Law Association (AIPLA) stated its position as against abusive practices, and noted that there was agreement in the Special Session as to what constitutes 'abusive' use. The Representative noted that with regard to a possible exclusion list, those Members in favor had intended that this list should be applied to protect only against registration of domain names identical to country names, and not misleadingly similar versions, and noted the question that had been raised whether such an exclusion list may preclude even governments from registering their country's name. The Representative stated that a top level domain reserved exclusively for government use would solve the problem of enabling the presence of such entities in the DNS. The Representative noted, however, that the use of an exclusion list was not favored, because it was overbroad, given that some countries did not oppose the registration of their country's name in the DNS. The Representative, noting the research that had revealed more than 450,000 domain names containing letter strings of country names, stated that any exclusion of names would only be practical if it operated only on identical names which as previously noted is not effective to prevent abusive practices. The Representative stated that, in any event, the initial predatory landrush of registrations by speculators was slowing down, and that many such registrations were not renewed. The Representative stated that a system for preventing all country name domain name registrations was perhaps not required, and that efforts should focus on use, depending on where such use fell on a scale of less to more abusive conduct, including pornography and fraud on one end of the scale, to unauthorized or improper association and consumer confusion in the middle, to use of intellectual property or other legal use at the other end. The Representative noted that each country may hold differing views on what conduct rose to the level of abuse, depending on their national policies, for example towards free speech, and that therefore any automatic exclusion would be improper. The Representative stressed that in this context, an expedited efficient dispute resolution procedure might be helpful to deal with clear cases of abuse, possibly with an adjusted fee structure. It was asked whether some norm or international agreement against such abuse, for example pornography, would provide the legal basis for action. The Representative informed the meeting of the efficient 'notice and takedown' procedure that operated under United States law, to enable copyright owners whose rights were infringed to notify the service provider and have the site taken offline, thereby also protecting the service provider from legal liability for the infringing content. The Representative asked how it might be possible to enable States to act against abusive use of their name, without creating a legal

right in the name which AIPLA does not support, and put forward the option of relying on the concept of “standing”, rather than rights, to enable States to bring dispute resolution proceedings against abusive uses of their country names. The Representative noted that discourse about ‘rights’ was problematic because of the ease with which language and terminology can shift to suggest that rights exist, such as by characterizing unopposed use of a country name in a domain name as being like a licence by the country to permit such use.

185. The Delegation of the United States of America thanked the Delegation of Sweden for its intervention concerning Article 10*bis* of the Paris Convention, and noted that in its own consideration of this approach, it had found that there were wide variations in the manner in which States recognized the principle of unfair competition and therefore this was a question best left for consideration of national courts. For this reason, the Delegation noted that any international framework based on principles of unfair competition would be in effect creating new international law by decisions of the UDRP panelists, contrary to the principles of the Second WIPO Process.

186. The Chair presented a proposal for a recommendation on country names, as reflected in paragraph 209, and delegations made a number of observations regarding such proposal.

187. The Delegation of South Africa expressed its support for the Chair’s proposal.

188. The Delegation of Australia noted that the Chair’s summary provided a useful way forward for views expressed at the Meeting, however the Delegation noted that it did not support the Chair’s proposal.

189. The Delegation of the United States of America concurred that the Chair’s proposal summarized the view of the Meeting, but noted that it did not support the Chair’s proposal.

190. The Delegation of Canada concurred with the Delegations of Australia and the United States of America, and noted that it did not support the Chair’s proposal.

191. The Secretariat clarified that with regard to the list of country names that would be based on both the ISO Standard and the UN Bulletin, any State that wished to include on such list additional names by which countries are commonly known should notify the Secretariat of such names before the end of June 2002.

192. The Delegation of the Republic of Korea noted its support for the Chair’s proposal. The Delegation stated that it had also raised a query as to protection of country names in different scripts, and sought clarification of the concept of ‘misleading variation’ of a country name.

193. The Delegation of the United Kingdom sought clarification on whether Members could also comment upon the draft Chair’s report by the end of June.

194. The Secretariat confirmed that Members would be able to comment on the draft during the second Special Session, and then prepare their further comments for the WIPO General Assembly in September.

195. The Delegation of Indonesia noted its support for the Chair’s proposal, and for the protection of variations of country names.

196. The Delegation of China sought clarification that it could give suggestions on its country name(s) by the end of June, and upon confirmation by the Secretariat, noted that the list of country

names prepared should, with respect to Hong Kong and Macao, be amended to add 'SAR' (Special Administrative Region) to both.

197. The Delegation of Australia clarified its understanding that after the second Special Session, the only part of the Chair's report open to submissions were names by which countries are commonly known.

198. The Delegation of the Netherlands queried whether the Chair's proposal referred to a dispute resolution process based on the UDRP, and the Secretariat clarified that this reference was made in paragraph 35 of document SCT/S2/3, which formed part of the Chair's proposal.

199. The Delegation of Mexico said that, as regards the recommendation on country names, it wanted only the States to be included in the list.

200. The Delegation of Argentina questioned the recommendation on country names and pointed out that the proposed list lacked clarity. The Delegation wondered whether SCT members should examine the list and, if so, within what framework. In conclusion, the Delegation stated that it wished to reserve its country's position on the recommendation in question.

201. The Chair clarified that Members had been requested to submit any names by which countries were commonly known to the Secretariat by June 30, 2002, for inclusion in a new list of country names recommended to be protected in the DNS, and that it was foreseen that this would be a limited additional list, including names such as Ceylon, Myanmar, Holland, and Russia.

202. The Delegation of Morocco confirmed that it wanted country names to be protected within the DNS. It pointed out, however, that the proposed recommendation did not contain any clarification as regards the protection mechanism referred to. The Delegation added that country names should be identified by means of the UN Bulletin, given that the list in question had already been accepted by the national authorities of the member States of WIPO, which was itself a specialized agency of the UN system. The Delegation said that if it proved useful to amend the UN Bulletin, this could be done following adoption by the appropriate body.

203. The Delegation of Germany noted that the Special Session had favored reference to both the ISO Standard and the UN Bulletin, but asked whether this reference was intended to mean that all the names in both lists would be included in the new list of countries to be protected, including those entities that were not States, or whether the new list would include only States.

204. The Secretariat noted that the term 'country' had been chosen to reflect the Internet's historical use of the term, such as, for instance, in country-code top level domains. It was noted that there were only six minor variations in the names of States between the ISO Standard and the UN Bulletin, and that these variations would be protected by means of the 'misleading variation' provision foreseen in contemplated dispute resolution mechanism. The Secretariat noted that the Special Session had not decided specifically whether entities that were not States, but were included on the ISO Standard, should receive protection as 'country names' under such procedure.

205. The Delegation of Germany stated that it favored use only of the UN Bulletin to compile the list of country names for protection in the DNS, such that only States would be included.

206. The Delegation of Australia favored compilation of a list that would only protect names of States in the DNS, but did not hold a strong view on this issue, and noted that misleading variations of such names would in any event be protected under the recommendation. The

Delegation considered that Members may wish to inform the Secretariat of the names which should apply to themselves.

207. The Delegation of Denmark stressed that it favored use of both the ISO Standard and the UN Terminology Bulletin, including names of entities that were not States, because it was considered important that the names of two self-governing geographic regions within Denmark, namely Greenland and the Faroe Islands, which only appeared on the ISO Standard but were not States, should receive protection of their names in the DNS.

208. In view of the discussions held during the meeting, as well as the statements made by various delegations and, contrary to what was stated in previous paragraphs of this report, the Delegation of Spain said that, in principle, it would support the use only of the UN Bulletin so as to compile the list of country names protected within the DNS; it emphasized that only sovereign States could obtain such protection. Whatever the case may be, the Delegation of Spain noted the possibility of submitting comments on this report, prior to submission to the next session of the Assembly of Member States.

209. The Delegation of the Republic of Korea emphasized the importance it placed on inclusion of the essential parts of country names, such as Korea, in the list of names to be protected in the DNS, and noted that incidental protection by characterization as a misleading variation was insufficient. The Delegation remarked that, in its view, the sentence in paragraph 209, 2, (ii) did not accurately reflect the balance of opinions among delegations on the issue concerned. That being the case, the Delegation believed it would be appropriate to either delete item (ii) or replace the terms “misleading variations” by the terms “essential parts”.

210. The Chair concluded that:

1. Most delegations favored some form of protection for country names against registration or use by persons unconnected with the constitutional authorities of the country in question.
2. As regards the details of the protection, delegations supported the following:
 - (i) A new list of the names of countries should be drawn up using the UN Bulletin and, as necessary, the ISO Standard (it being noted that the latter list includes the names of territories and entities that are not considered to be States in international law and practice). Both the long or formal names and the short names of countries should be included, as well as any additional names by which countries are commonly known and which they notify to the Secretariat before June 30, 2002.
 - (ii) Protection should cover both the exact names and misleading variations thereof.
 - (iii) Each country name should be protected in the official language(s) of the country concerned and in the six official languages of the United Nations.
 - (iv) The protection should be extended to all top-level domains, both gTLDs and ccTLDs.

(v) The protection should be operative against the registration or use of a domain name which is identical or misleadingly similar to a country name, 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.

3. The Delegations of Australia, Canada and the United States of America dissociated themselves from this recommendation.

Geographical Indications

211. After the Secretariat's summary of the findings of the Report of the Second WIPO Process Report on the issue of geographical indications (GIs), the Chair recalled the conclusions reached on this topic at the first Special Session, as reflected in its Report (document SCT/S1/6).

212. The Delegation of France said that the first Special Session had demonstrated the need to discuss geographical indications, and regretted that little time was devoted to this issue during the second Session. The Delegation said that the UDRP should, as a matter of urgency, be extended to geographical indications given the harm caused and which was still unresolved. In conclusion, the Delegation noted that it was desirable to devote the necessary time to protecting geographical indications within the DNS.

213. The Delegation of Japan noted that the question of protection of GIs in the DNS was a complex one and, as distinct from consideration of country names which could rely upon the ISO Standard and the UN Bulletin, no such list of agreed names was available for GIs. The Delegation noted that this issue was closely related to questions raised in other fora, including the WTO TRIPS Council and urged caution and attention to these other discussions.

214. The Delegation of the European Community noted its disagreement with the recommendations made in the Second WIPO Process Report and stated that, as GIs were as important an intellectual property right as trademarks, and of significant economic importance to some Members, this should be reflected in their protection using the UDRP in the DNS. The Delegation concluded that the Special Session should recommend continued debate on the issue of inclusion of GIs in the UDRP. Finally, the Delegation noted that future meetings should commence with discussion of GIs as the time allotted in this Special Session was too short, and requested that the Secretariat compile a list of questions for future discussion on this issue. The Delegation further clarified that it was for the WIPO General Assembly to decide on the appropriate body for the continued discussion of this topic.

215. The Delegation of Australia reiterated the concerns it had raised in the first Special Session and emphasized that it was premature to include GIs under the UDRP. While it was considered that further discussions would be unlikely to reach a conclusion on this issue, the Delegation stated that it would participate in such discussions. The Delegation noted that this Special Session had been constituted for two meetings only, and put forward its view that further discussions would be most appropriately held in the SCT, where the issue of GIs was already on the standing agenda. The Delegation stated that it was for the WIPO General Assembly to decide in which forum further discussions should be held and, while it supported the preparation by the Secretariat of a discussion paper, noted that Members could also submit papers on this issue.

216. The Delegation of Mexico stressed that the question of protection for geographical indications within the DNS should be broached but that it did not consider this to be the right moment to deal with the issue. The Delegation noted, however, that given the uncertainty which persisted as regards the definition of geographical indications, it could not currently express an opinion as to the need to protect geographical indications within the DNS.

217. The Delegation of Uruguay also underlined the importance of geographical indications and said in particular that in Uruguayan legislation on marks a chapter was devoted to geographical indications. Notwithstanding, the Delegation observed that it was premature to examine the issue of protection for geographical indications within the DNS, taking into account the diversity observed in the various forms of national legislation as regards the concept in question.

218. Joining the Delegations of Australia, Japan, Mexico and Uruguay, the Delegation of Argentina said that the UDRP should not be extended to cover geographical indications, taking into account the lack of relevant specific international standards. The Delegation emphasized, however, that it was necessary to move ahead in the debate on geographical indications and that said debate could be conducted within the regular sessions of the SCT.

219. The Delegation of the Republic of Korea concurred with the interventions of Mexico, Uruguay and Australia and noted that, though the issue of GIs in the DNS was an important one, there was not yet sufficient international agreement on the relevant questions and the time was not yet appropriate for decision. The Delegation noted that discussions were ongoing in the WTO, and left open the question of future discussions in WIPO.

220. The Delegation of the United States of America stated that the regular SCT was engaged in discussions towards international norm setting on the issue of GIs and that no common understanding had yet been reached on many issues including definition, terms, ownership, use, creation, cancellation and other relevant fundamental issues. The Delegation emphasized that both the SCT and the TRIPS Council of WTO should address such questions relating to GIs before consideration could be given to adding such protection to the UDRP.

221. Associating itself with the comments made by the Delegations of Argentina, Japan, Republic of Korea, United States of America and Uruguay, the Delegation of Guatemala stated that it was premature to tackle the subject of protection for geographical indications as part of the Special Session of the SCT. The Delegation said that it intended to continue the debate on this issue as part of the regular sessions of the SCT.

222. The Chair put forward a proposal for discussion, stating that it was not timely to take a decision on this issue, that the Special Session recommended that discussion on the issue of protection of GIs in the DNS should continue in a forum and time frame to be decided by the WIPO General Assembly, that delegates were invited to submit proposals to the WIPO General Assembly and that the Secretariat should prepare a brief paper on these issues as discussed to date.

223. The Delegation of Argentina reiterated its point of view as regards examining the issue of protection for geographical indications within the regular sessions of the SCT and emphasized that it was premature to consider the protection of geographical indications within the DNS, taking into account the fact that various fundamental issues relating to geographical indications were still to be discussed at the sessions in question.

224. The Delegation of Australia, referring to the Chair's proposal, stated that there could be no meaningful discussion on GIs in the context of the DNS before progress was made in discussions on GIs in the SCT, and noted that questions specific to GIs in the DNS could always be addressed within the SCT's standing mandate. The Delegation further noted that it did not support the inclusion of wording implying that future discussions were recommended to take place. The Delegation emphasized that a clearer understanding was required of the issue of GIs in the physical world, before any agreement in international law on this issue could be reflected in the DNS.

225. The Delegation of the European Community expressed its support for the Chair's proposal, and stated its view that the aim should not be to harmonize the international position on GIs before any discussion could take place on protection of GIs in the DNS. The Delegation noted that divergent views still existed with regard to other forms of intellectual property, such as patents, but that discussions could still continue on them. The Delegation remarked that GIs were already defined in the TRIPS Agreement, and this could form the basis for further discussion, which it was emphasized should take place in the appropriate body to be decided by the WIPO General Assembly.

226. The Delegation of Uruguay observed that existing national legislation on geographical indications should be studied before its protection at the international level was debated. The Delegation emphasized that this study should be conducted within the regular sessions of the SCT.

227. The Delegation of the United States of America expressed its support for the interventions of Argentina and Australia, and agreed that it was premature to recommend to the WIPO General Assembly that additional meetings or discussion should be held on the issue of GIs in the DNS. The Delegation noted that the norm-setting discussions taking place in the SCT must continue before productive discussions could take place on the question of inclusion of GIs in the UDRP. In this respect, it was stated that the Paris Convention dealing with trademarks and patent law had been drafted in 1880, such that Members had enjoyed more than 100 years of time to develop international consensus on the issues it raised. The Delegation noted that GIs had been incorporated in the TRIPS Agreement for less than 10 years, and that more time was therefore required before discussion on them in relation to the DNS could sensibly take place.

228. The Delegation of France said that the issue of geographical indications was better understood than was to be believed, and highlighted the urgency of dealing with the matter. The Delegation said that there were numerous cases of registration of appellations of origin and geographical indications as domain names. In that regard, the Delegation referred to a recent example concerning a domain name relating to an appellation of origin from the Bordeaux region, which was based on a site with no connection to said appellation and whose owner resided outside French territory. The Delegation pointed out that, following the statement made by the Delegation of the United States of America, the 1883 Paris Union Convention already referred to appellations of origin and that it would be surprising, more than one hundred years later, if such appellations which formed part of the intellectual property system were still not the subject of protection on the Internet, as was the case for marks. In conclusion, the Delegation said that, in line with the European Community, France supported the proposal made by the President.

229. The Special Session:

- (i) Decided that it was not timely to take definitive decisions with respect to the protection of geographical indications in the Domain Name System.

(ii) Noted that some delegations considered that the issue needed urgent attention, while others considered that a number of fundamental questions concerning the protection of geographical indications needed to be resolved before the question of their protection in the Domain Name System could be discussed.

(iii) Recommends that the WIPO General Assembly revert this issue to the regular session of the SCT to decide how the issue of the protection of geographical indications in the Domain Name System be dealt with.

Other Matters

230. With respect to other available means of addressing abusive domain name registrations, the Meeting supported the remarks made by the OECD in paragraph 22 and subsequent paragraphs of document SCT/S2/INF/2, and made by other delegations, in relation to the accuracy and integrity of WHOIS databases.

231. This Report was adopted by the Second Special Session of the Standing Committee on May 24, 2002.

[Annex I follows]

ANNEX I

STATEMENT

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

Distinguished members of the Standing Committee, it is a great pleasure for me to be here to address you on behalf of the Legal Advisers of the United Nations System. Thank you also for agreeing to receive the paper that I submitted on behalf of the Legal Advisers concerning domain name registrations using the names or abbreviations of international intergovernmental organizations without authorization. Our paper summarizes the problem and provides the Standing Committee with examples of such abusive registrations, including some of the more egregious cases.

In presenting the views of the Legal Advisers of the United Nations System today, I would like to emphasize that the expertise of the Legal Advisers covers a diversity of fields. Among those I could mention are: peace-keeping, development, trade, the environment, refugees, food security, civil aviation, culture, labor relations, maritime transportation, health, banking, atomic energy, meteorology, the prohibition of chemical weapons and the comprehensive nuclear test ban. The development of international cooperation in each of these disparate areas has shown that principled legal solutions developed by States have provided the most secure, fair and coherent outcomes to international problems and issues.

Pursuant to the First and, now, the Second WIPO Internet Domain Name Process, your organization has been called upon to lend its perspective and expertise to ICANN with regard to proposals concerning governance of the Domain Name System. To that extent, States are in a limited position through your organization to contribute solutions to a myriad of problems regarding Internet governance. We believe that the diversity of perspectives of the Legal Advisers of the United Nations System can assist WIPO in making such a contribution.

The Legal Advisers recognize that international intergovernmental organizations are not alone in facing the problem of abusive domain name registrations. Nevertheless, we are concerned that the Uniform Dispute Resolution Procedure, the UDRP [“the OO-DRUP”], does not provide an effective means for such organizations to resolve disputes regarding such abusive registrations. Of course, international intergovernmental organizations, including those within the United Nations System, are accorded privileges and immunities that prevent national courts throughout the world from subjecting the organizations to their jurisdiction. The purpose of such privileges and immunities is to ensure that international intergovernmental organizations can effectively and efficiently carry out their important functions. It is important to stress that enjoying immunity from the jurisdiction of national courts does not mean that such organizations are above the law. Indeed, many regimes imparting such immunity, such as the Convention on the Privileges and Immunities of the United Nations, provide that whenever international intergovernmental organizations maintain their immunity from suit in respect of a private law claim, such organizations shall provide an appropriate mode of settlement for the claim. Thus, the immunities of international intergovernmental organizations are jurisdictional in nature.

With respect to UDRP proceedings, as you know, any party who might be dissatisfied with either the process or the outcome of such proceedings may file suit in a court of competent jurisdiction for a *de novo* review of the dispute. Consequently, the United Nations and other international intergovernmental organizations are concerned that their submission to an UDRP proceeding could subject them to the jurisdiction of national courts. Accordingly, such organizations have been unwilling to submit their disputes concerning abusive domain name registrations to an UDRP proceeding.

The Legal Advisers of the United Nations System recognize that the UDRP provides a necessary means for efficiently resolving domain name disputes. All we seek is an appropriate procedure that would supplement the UDRP in a manner that would respect the status and privileges and immunities of international intergovernmental organizations while at the same time providing effective redress for dealing with abusive domain name registrations. We are concerned that this problem will only grow worse with the proliferation of additional generic top-level domain names. We also certainly recognize that any procedure that would provide effective redress to international intergovernmental organizations should also respect the equally important international norms regarding fairness and due process for any other party involved.

Through the report on the Second WIPO Internet Domain Name Process, your organization is now preparing to make its recommendations to ICANN regarding proposals to improve the Domain Name System. The recommendations will, among other things, include proposals for protecting the names of international intergovernmental organizations. The Legal Advisers of the United Nations System respectfully request that your recommendations include both a proposal for a procedure for fast-tracking disputes involving domain name registrations incorporating the names or abbreviations of international intergovernmental organizations without authorization and for an appropriate amendment to the UDRP providing for an independent and impartial arbitral tribunal that would respect the status and privileges and immunities of international intergovernmental organizations that are parties to UDRP arbitral proceedings. The purpose of such a tribunal would be to provide final and binding rulings following a *de novo* review of decisions of UDRP arbitral tribunals in cases in which a party to such UDRP proceeding is an international intergovernmental organization.

On a more general note, I would like to share with you a concern raised by many of the Legal Advisers of the United Nations System – based on our limited discussions thus far on this matter –

that the Internet, which has evolved into a global forum for the exchange of ideas, information, and commerce, operates on a basis that is not regulated by treaty. Yet, as you more than anyone else are aware, international legal regimes and norms cannot be ignored in the operation of the Internet. Thus, the operation of the Domain Name System – which, at least for generic top-level domains, is governed by a California not-for-profit corporation under contract with the United States Department of Commerce – has already come up against the interests of trademark holders, who have traditionally relied, at least in part, on international legal regimes and international bodies, such as WIPO, to regulate and protect such interests.

We find it remarkable that the governing of the Domain Name System, an essential element of the Internet, should be entrusted solely to a private entity operating on a private-law basis rather than under the authority of an international representative body operating on the basis of public law. Surely, in the past this would not have been considered an appropriate means of regulating phenomena with such international impact. Some have argued that the pace and dynamics of the evolution of the Internet preclude its being governed and operated by one or more international intergovernmental organizations. But the fact that WIPO, including this Committee, has been called upon to gather views on and provide recommendations regarding a range of complicated and multifaceted questions confronting the Domain Name System undermines that contention. And yet, the Domain Name System is only one of many aspects of the Internet requiring regulation and standardization.

As a global forum that is evolving and that promises to play an increasingly important role in the Information Age, the Internet will continue to require international cooperation for both its operation and its regulation. International bodies, such as WIPO, that are representative of the international community are uniquely suited to foster such cooperation. As recent events have reminded us, international cooperation is an inescapable requirement in today's world; it need not – and it should not – be viewed as posing obstacles to progress.

We are fully aware that WIPO may not feel that it is within its mandate to deal with this overriding issue. However, the Members of WIPO, and, in particular, of this Committee, are better placed than most to understand the problems and the need for proper regulations for the future. We, therefore, urge you to raise these questions with your Governments: What is the appropriate forum for Internet governance including, in particular, the operation of the Domain Name System? Should such matters really continue to be entrusted to private-law regulation by a non-governmental body operating under the auspices of one State? Should it not, rather, be entrusted to the international community based on a proper treaty mechanism? This does not mean that the practical work of managing the Domain Name System, including as it is currently managed by ICANN, or other aspects of the Internet, including current processes for resolving technical issues, would differ much. Such activities, as has been the case with the public and private cooperation through the International Telecommunication Union, can continue to be overseen by private bodies or processes under principles established by the international community.

We realize that the solution to these complex questions will require time and careful reflection. Meanwhile, the current system of Internet governance must address the problem of abusive registrations of domain names using the names or abbreviations of international intergovernmental organizations. I again thank you for providing the Legal Advisers of the United Nations System with the opportunity to share our concerns and to present you with our views and proposals on this matter. In providing input to ICANN regarding the Second WIPO Internet

Domain Name Process, we strongly urge you to include a proposal for preventing abusive domain name registrations using the names or abbreviations of international intergovernmental organizations. In addition, we respectfully request that such organizations be given an effective means of redress when such abusive registrations occur.

Thank you.

[Annex II follows]

ANNEXE II/ANNEX II/ANEXO II

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* Sur une décision du Comité permanent, les Communautés européennes ont obtenu le statut de membre sans droit de vote.

* Based on a decision of the Standing Committee, the European Communities were accorded Member status without a right to vote.

III. ORGANISATIONS INTERGOUVERNEMENTALES/
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Ulrich von BLUMENTHAL, Senior Legal Liaison Officer, Geneva

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Didier ADDA, membre du Comité exécutif, Paris

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Association internationale des juristes du droit de la vigne et du vin (AIDV)/International Wine Law Association (AIDV)

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ICANN's Briefing RE:

**WIPO2 Policy
Development Process
(with attachments)**



General Counsel's Briefing Concerning Policy- Development Process on WIPO-2 Recommendations

1 June 2003

General Counsel's Briefing Concerning Policy- Development Process on WIPO-2 Recommendations

To the Board:

Background

In late-February 2003, ICANN received [a letter from Francis Gurry, Assistant Director General of WIPO, concerning the results of the WIPO Second Internet Domain Name Process \(WIPO-2 Process\)](#). In [my 7 March 2003 Briefing Concerning Letter Received from WIPO Concerning Second Internet Domain Name Process](#), I very briefly summarized the WIPO-2 Process, reviewed the provisions of the relevant ICANN bylaws concerning the process ICANN should follow, and recommended that the Board invite the ICANN supporting organizations and advisory committees to make preliminary comments on the letter.

At its 12 March 2003 meeting, [the Board adopted resolution 03.22](#) requesting "the President to inform the Governmental Advisory Committee, the Supporting Organizations, and the other Advisory Committees of the 21 February 2003 letter from WIPO; to provide those bodies with a copy of the text of the letter; and to invite them to provide, no later than 12 May 2003, any comments they may formulate, according to their processes, concerning the matters discussed in the WIPO letter." This was done, and comments were received from the GAC, the GNSO Council, and the At-Large Advisory Committee (ALAC):

- [Communiqué of the Governmental Advisory Committee, item 4](#) (25 March 2003)

(GAC comments)

- [Message from Bruce Tonkin to Louis Touton](#) (7 May 2003) (GNSO Council comments)
- [Message from Vittorio Bertola to Louis Touton](#) (12 May 2003) (ALAC comments)

In addition, comments were received from the Intellectual Property Interests Constituency and the Commercial and Business Users Constituency of the GNSO:

- [Message from Michael Heltzer, Secretary of GNSO Intellectual Property Interests Constituency, to Louis Touton](#) (15 May 2003)
- [Message from GNSO Commercial and Business Users Constituency to Paul Twomey and Vint Cerf](#) (21 May 2003)

Now that these comments have been received, it is appropriate for the Board to consider what steps should be taken next in responding to the WIPO letter and the recommendations it makes.

Discussion of Comments Received

The various comments received concern both the substance of the WIPO-2 recommendations and the process ICANN should follow in responding to those recommendations. The comments received are detailed and thoughtful, and merit careful and reflective consideration. (See the links above.)

The Governmental Advisory Committee, [in its Rio de Janeiro Communiqué](#), endorses the WIPO-2 recommendations that the names and acronyms of intergovernmental organizations (IGOs) and the names of countries be protected against abusive registration as domain names. The Communiqué advises the ICANN Board to implement WIPO's recommendations that protections be provided from such abusive registrations. At the same time, however, the GAC notes that "the practical and technical aspects of extending this protection, and notably the implications for the UDRP, need to be fully understood". The GAC therefore proposes "that a joint working group should be established in conjunction with other interested ICANN constituencies, in particular the gTLD and ccTLD communities."¹

The GNSO Council, as the ICANN body [assigned the responsibility under ICANN's bylaws](#) for developing and recommending to the ICANN Board substantive policies relating to gTLDs, [makes the following recommendations](#):

(1) consider the WIPO recommendations separately from the review of the

existing Universal Dispute Resolution Policy (UDRP) which is aimed at trademarks.

(2) consider that the WIPO recommendations associated with Names and Acronyms of International Intergovernmental Organisations and Country Names should be subject to a policy development process to look at how they can be implemented taking into account a thorough examination of the issues surrounding the recommendations.

The [ALAC's comments](#) set forth significant concerns regarding whether the WIPO-2 recommendations are within the scope of ICANN's mission. In its comments, the ALAC states that ICANN is not intended to be an international law-making body, and that implementation of the WIPO-2 recommendations would extend the UDRP in a way that eliminates two key features currently embodied in the UDRP that avoid placing ICANN in a law-making role:

First, the UDRP addresses only situations where a complainant has rights under existing trademark laws. Decisions are specifically required to be made in accordance with the rules and principles of law that the panel finds applicable. The UDRP implements existing law which has been developed by well-established governmental law-making mechanisms. It does not create new trademark law.

Second, parties dissatisfied with UDRP procedure or rulings can obtain judicial review in an appropriate court. This helps to ensure that the UDRP does not supersede applicable national law.

On the first point, the ALAC comments bring to light the conclusions reached in a September 2001 WIPO report that extensively analyzed the legal basis for protection of the names and acronyms of IGOs and the names of countries. In that analysis, WIPO concluded that extending the UDRP to protect IGO names and acronyms would involve "creation of new international law" ([paragraph 168](#)). Similarly, WIPO concluded that "[p]rotecting country names in the gTLDs would require or amount to the creation of new law, a function traditionally reserved for States" ([paragraph 286](#)).

On the second point, the ALAC points out that the WIPO-2 recommendations (in the case of IGO names and acronyms and possibly country names as well) would preclude the ultimate recourse to the competent national courts (i.e. those with which the registrant has a connection) on questions of national law, instead requiring that challenges to decisions (under an extended UDRP) to transfer names to IGOs and countries be addressed through binding arbitration.

The ALAC comments raise very substantial questions regarding whether extending the UDRP in the recommended manner would exceed the scope of ICANN's mission. The recommendations seek the extension of the UDRP, which currently provides a procedural mechanism for resolving cases of abusive registrations based on existing legal principles established by governments, to situations where it appears that normative rules for resolving disputes among third parties with competing claims have not been created by governments.²

In conclusion, the ALAC gives the following advice:

[1] In view of these new difficulties – which are less evident in the trademark-centric review of the UDRP currently underway – the Committee supports the GNSO Council's recommendation to separate the UDRP's review from discussions about implementation of WIPO's recommendations, and to address the additional WIPO requests in a separate policy-making process.

[2] The Committee also recommends to the Board that any separate policy-making process begin with a careful review of the legal basis for rights that are proposed to be created or implemented. The September 2001 WIPO Report strongly indicates that the current WIPO recommendations propose to implement "rights" that are not supported by existing law. The Board, in common with other ICANN bodies, has a responsibility to take care that ICANN adhere to its limited mission. The Committee urges the Board to ensure that ICANN's policy development proceed only where there is a solid legal foundation and a full understanding of the limits of existing legal consensus.

In an [annex to its comments](#), the ALAC also expresses various concerns with the substance of the WIPO-2 recommendations.

The [GNSO Intellectual Property Interests Constituency comments express opposition](#) to amending the UDRP to accommodate the WIPO-2 recommendation that disputes relating to IGOs should not be required to submit to the jurisdiction of national courts. Echoing the concerns of the ALAC, the IPC comments note that the availability of national court review "properly ensures that the courts are the ones who are ultimately responsible for interpreting the law – both national and international alike."

In [its comments](#), the GNSO Commercial and Business Users Constituency makes the following recommendations:

1. The existing UDRP relating to trademarks and domain names must remain entirely unaffected by the WIPO2 proposals.
2. The new WIPO proposals on disputes relevant to international organisations and country names should be evaluated for both the merit of the need and the merit of the proposed solutions.

In this evaluation it should be remembered that both proposals are political compromises. In the case of IGOs, certain countries had specific disputes but WIPO did not agree to the more courageous solution of a new treaty. In the case of country names, WIPO has plucked this one item out of an on-going debate on other geographical names, and has not yet addressed the relevant complications.

3. If any action is determined necessary a separate dispute system should be established for international organisations and country names.

Options for Proceeding

There are at least three options now available for progressing the evaluation of the WIPO-2 recommendations:

A. Initiation of a Formal Policy-Development Process. One option is to initiate a formal policy-development process. Because the WIPO-2 recommendations concern extension of the UDRP, which applies in gTLDs, [Article X, Section 1 of the bylaws](#) makes the GNSO the relevant body to carry out the policy-development process:

Section 1. DESCRIPTION

There shall be a policy-development body known as the Generic Names Supporting Organization (GNSO), which shall be responsible for developing and recommending to the ICANN Board substantive policies relating to generic top-level domains.

To initiate a policy-development process on whether to adopt the WIPO-2 recommendations, the Board should adopt a resolution under [item 1\(a\) of the GNSO Policy-Development Process](#):

- a. Issue Raised by the Board. If the Board directs the Council

to initiate the PDP, then the Council shall meet and do so within fifteen (15) calendar days after receipt of the Issue Report, with no intermediate vote of the Council.

This approach has the advantage of proceeding to consideration of the WIPO-2 recommendations without delay. It has the disadvantages of (a) proceeding without a full understanding of whether the WIPO-2 recommendations are within the scope of ICANN's mission (see Alternative B below) and (b) focusing the discussion of the WIPO-2 recommendations in the GNSO at this stage, when the GAC has expressed an interest in participating in a joint working group with other ICANN constituencies. While the GAC has a liaison to the GNSO Council, and the GNSO Council can consult with the GAC at various points of the policy-development process, the opportunity for GAC input at this stage would be less in a formal policy-development process than that entailed by a joint working group as suggested by the GAC.

B. Clarification of Relationship of WIPO-2 Recommendations to ICANN's Mission. Alternatively, it may be appropriate, particularly in view of the [September 2001 WIPO analysis](#), to investigate whether the WIPO-2 recommendations would involve ICANN in what the ALAC calls "law-making" activities. If the WIPO analysis is correct, the WIPO-2 recommendations would appear to require that ICANN prescribe adherence to normative rules, not based on established laws enacted by governments and without relation to technical considerations, for the definition of rights as between third parties to register names.

Clarification of these concerns as an initial step has the advantage of clearly delineating the limitations inherent in ICANN's mission before devoting considerable resources toward the development of a policy that may exceed that mission. While it is true that the GNSO Policy-Development Process requires [early consideration of whether an issue is properly within the scope of the ICANN policy process](#), that determination must be made in a very short time-frame (15 days) that is unlikely to allow proper consultation with legal experts on the correctness of the September 2001 WIPO analysis. Moreover, as the ALAC observed in its comments, "[t]he Board, in common with other ICANN bodies, has a responsibility to take care that ICANN adhere to its limited mission." A disadvantage of this approach is that it would delay the commencement of a formal policy-development process on the WIPO recommendations.

C. Establishment of a Joint Working Group for Initial Analysis. As

noted above, the GAC recommended the establishment of a joint working group including both the GAC and affected constituencies to evaluate the practical and technical implications of the WIPO-2 recommendations. This approach would result in a delay in the initiation of formal policy-development activities (Alternative A above), but could be pursued in parallel with clarification of legal issues pertinent to ICANN's mission, as described in Alternative B above.

Best regards,

Louis Touton
General Counsel

Notes:

1. Since the WIPO-2 recommendations appear, like the UDRP itself, to concern only gTLDs, the basis for including "ccTLD communities" as interested is unclear.
2. In [resolution 02.43](#), the ICANN Board agreed to reserve 329 country names in .info for the purpose of making them available for registration by governments. This reservation was made based in part on the willingness of Afilias, the operator of the .info top-level domain, to address concerns raised by the Governmental Advisory Committee. The reservation was specifically limited to .info, and not applicable to other gTLDs, then existing or later established.

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Page Updated 02-Jun-2003

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General Counsel's Briefing Concerning Letter Received from WIPO Concerning Second Internet Domain Name Process

7 March 2003

General Counsel's Briefing Concerning Letter Received from WIPO Concerning Second Internet Domain Name Process

To the Board:

We recently received a letter (dated 21 February 2003) from Francis Gurry, Assistant Director General of WIPO, concerning the results of the WIPO Second Internet Domain Name Process. The [text of the letter has been posted](#).

The Second Internet Domain Names Process was initiated by WIPO at the request of 20 governments in June 2000. It follows on from WIPO's First Internet Domain Names Process, which concerned procedures regarding domain names (including the UDRP) that addressed issues raised by trademark principles.

The Second Internet Domain Name Process evaluated whether procedures should be instituted to address domain-name issues arising in connection with personal names; International Nonproprietary Names for Pharmaceutical Substances; names of international intergovernmental organizations (IGOs); geographical indications; indications of source or geographical terms; and tradenames. After various consultative processes within WIPO, the WIPO member states recommended that two categories of identifiers should be protected against abusive registration as domain names, namely, the names and acronyms of IGOs and country names (being one particular type of geographical identifier). Some member states disassociated themselves from one or both of these recommendations.

Under the New Bylaws, the WIPO recommendations would be treated as external

advice subject to the provisions of [Article XI-A, Section 1](#). Because the WIPO process began long before the New Bylaws were adopted, the relevant provisions concerning ICANN's request for such advice were not followed. Nonetheless, the New Bylaws provisions concerning the receipt and consideration of expert advice are relevant. As stated in [Article XI-A, Section 1\(5\) and \(6\)](#):

5. Receipt of Expert Advice and its Effect. External advice pursuant to this Section shall be provided in written form. Such advice is advisory and not binding, and is intended to augment the information available to the Board or other ICANN body in carrying out its responsibilities.

6. Opportunity to Comment. The Governmental Advisory Committee, in addition to the Supporting Organizations and other Advisory Committees, shall have an opportunity to comment upon any external advice received prior to any decision by the Board.

In view of these provisions the WIPO letter should be referred to the directly responsible supporting organization and advisory bodies for their analysis and recommendations; and the other supporting organizations and advisory committees should be notified of the letter and invited to provide any comments they may have.

Best regards,

Louis Touton
General Counsel

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Communiqué of the Governmental Advisory Committee

(25 March 2003)

Communiqué of the Governmental Advisory Committee 25 March 2003 Rio de Janeiro, Brazil

The Governmental Advisory Committee (GAC) of the Internet Corporation for Assigned Names and Numbers (ICANN) met in Rio de Janeiro, Brazil on 23, 24, and 25 March 2003. The participating GAC Members, included representatives from 30 national governments, distinct economies as recognised in international fora, and multilateral governmental and treaty organisations. They had useful discussions concerning ICANN and related Internet naming and addressing issues.

The Governmental Advisory Committee expressed warm thanks to Brazil for hosting and organising the meeting in Rio de Janeiro.

GAC confirmed the results of the election in December 2002 of the new Chair, Mohamed Sharil Tarmizi and three Vice Chairs, Lena Carlsson, Vanda Scartezini and Michael Katundu.

GAC welcomed the presence of two new Members participating for the first time: Greece and Trinidad and Tobago.

GAC continues to focus on the implementation of ICANN Reform and in the light of the decisions taken in the Shanghai meeting, on the reform of GAC itself and its contribution to the policy development process.

On this occasion, Members addressed several aspects of GAC's role in the new ICANN structure, including:

- the appointment of Liaisons between GAC and ICANN's constituent entities,
- the constitution of Working Groups in several policy areas, and
- responding to recent requests from ICANN for Advice from the GAC.

GAC continued and intensified its dialogue with ICANN and with the ICANN operator and user communities.

1. Outreach

1.1 Several of the countries in the Americas organised a workshop prior to the GAC meeting in Rio, in order to discuss outreach strategies for the region. This meeting saw a meaningful exchange of views, as the participants in the workshop proposed steps to further the outreach work in the region.

1.2 These steps included the following:

- Prepare a standard presentation or template in the regional languages, on the workings of the GAC and ICANN for use by any GAC member in outreach activities;
- Consider liaising with other fora that have an interest in the Internet naming and addressing systems
- Encourage GAC members to co-ordinate with their representatives in relevant fora to better acquaint them with the GAC and relevant ICANN activities; and
- Establish a mentoring system, such as the EU member countries have established with their new member countries, to encourage wider participation.

1.3 The GAC noted that these steps would be relevant to its outreach activities in all ICANN regions.

2. GAC-ICANN Liaisons

2.1 GAC decided to appoint several Liaisons to various ICANN constituents. The list of Liaison appointments is in [Annex 1 to this Communiqué](#). With the exception of the GAC Chair, whose appointment is ex-officio, these appointments are for a one year term. GAC will review its experience with Liaisons at the Montreal and Tunisia meetings.

2.2 The GAC Liaisons will facilitate two-way communications with the

aforementioned ICANN constituents, and address policy matters only if these have already been agreed by the GAC.

2.3 GAC encourages ICANN Board and its constituent entities to work closely with the GAC Liaisons to optimise the possible synergies between GAC and ICANN constituents, consistent with the public-private partnership embodied in the ICANN Reform.

3. GAC Working Groups

3.1 Following preparatory discussions in Shanghai, GAC has constituted six Working Groups to address several areas of public policy. The Working Groups will engage, as appropriate, in a dialogue with the ICANN Supporting Organisations and Committees concerned. The Working Groups will provide GAC with the analytical resources to facilitate GAC Advice in the respective policy areas.

3.2 The initial list of agreed Working Groups is in [Annex 2 to this Communiqué](#). GAC encouraged in particular the working groups dealing with Whois, ccTLD and Root Server Security issues to take up their work as soon as possible.

3.3 The ccTLD Working Group should examine as a priority the recommendations of the ccNSO Assistance Group. It should also examine the appropriateness of an updating or the ccTLD principles of the GAC.

4. WIPO II recommendations on names of countries and Inter Governmental Organisations (IGO)

4.1 GAC considered the WIPO communication to ICANN of 21 February 2003 and the ICANN request for Advice, 12 March 2003. GAC took note that the WIPO II recommendation to ICANN was based on a formal decision by Member States, resulting from more than two years' work in the official WIPO instances.

4.2 GAC's Advice to ICANN is as below:

1. GAC endorses the WIPO II recommendations that the names and acronyms of IGOs and country names should be protected against abusive registration as domain names.

2. GAC advises the ICANN Board to implement the WIPO II recommendations regarding the protection of the names of Inter-Governmental Organisations (IGO) and the protection of Country Names in the Domain Name System.

3. As the practical and technical aspects of extending this protection, and notably the implications for the UDRP, need to be fully understood, GAC proposes that a joint working group should be established in conjunction with other interested ICANN constituencies, in particular the gTLD and ccTLD communities.

5. Trademarking of ISO 3166 alpha 2 codes

5.1 GAC took note of the request of 10 February 2003 from ICANN for Advice on this matter and considered the analysis of the issue that had been provided by the International Bureau of WIPO. GAC also recalled that the GAC ccTLD Principles state that:

Clause 4.2:

"No private intellectual or other property rights should inhere in the ccTLD itself, nor accrue to the delegee as the result of delegation or to any entity as a result of the management, administration or marketing of the ccTLD."

Thus GAC, in reaffirming the above principle, noted that issuing a trademark in the ISO country code to the Registry would not be consistent with the letter or the spirit of the GAC ccTLD Principles. The question of whether or not trademark rights may be acquired in a ccTLD code is ultimately determined by national or regional law.

6. ICANN Country Code Supporting Organisation (CCNSO) Proposal

6.1 GAC consulted with representatives of the ccTLD community, ICANN Board and the ERC about the structure, organisation and responsibilities of the proposed Country Code Names Supporting Organisation. GAC requested the newly constituted ccTLD Working Group to examine these issues as a matter of priority.

6.2 GAC appreciates the efforts of the ccNSO Assistance Group in making

these recommendations that provide a basis for further discussions of any new provisions that will be included in the ICANN By-laws.

6.3 GAC recalls that its role in providing advice on public policy, as described in the ICANN By-laws, includes policy issues to be addressed by the proposed ccNSO. To this effect, GAC has already issued policy advice in the form of the Principles for the Delegation and Administration of ccTLDs.

6.4 GAC stresses the importance of active dialogue with the GAC as part of the proposed ccNSO's policy development process and before corresponding ICANN Board decisions are taken. GAC looks forward to being appropriately consulted before any ccNSO-related By-law provisions are adopted by the ICANN Board.

6.5 GAC recalled the terms of the Shanghai Communiqué regarding ICANN Reform calling on

" ... all parties concerned including in particular ICANN, but also the RIRs and the ccTLD constituency, to co-operate in good faith in order to ensure a relationship conducive to efficiency and mutual confidence."

7. Consultations with Internet DNS Operator and User communities

7.1 GAC consulted with the Root Server Operators, the Regional Internet Registries, the ccTLD community, GNSO and ALAC. GAC welcomed the exchange of information and opinion. It was agreed to continue and deepen these relationships through the Liaisons and Working Groups.

8. Internationalised Domain Names

8.1 GAC consulted with ICANN Board Members regarding the current status of work in the IDN area and the tasks of the ICANN Committees concerned. GAC will return to this question at its next meeting and meanwhile the newly constituted GAC IDN working group will monitor developments and report back to the GAC Membership.

8.2 The ITU reported on its activities related to Resolution 102 "Management of Internet names and addresses" and Resolution 133 "Role of administrations of Member States in the management of

internationalised (multilingual) domain names" as well as its current and planned related activities.

9. Co-operation with International Organisations

9.1 GAC received presentations from ITU and WIPO. GAC welcomed this exchange of information and noted with appreciation the contribution from WIPO to the present meeting.

9.2 GAC received a presentation from ITU giving an overview of the ITU and its activities, particularly with respect to IP based networks, the Internet, next generation networks, and Resolutions 102 and 133. GAC members expressed appreciation for this presentation.

9.3 GAC received a report on the recent ITU ccTLD workshop implemented under the aegis of ITU Resolution 102, organised by ITU TSB. GAC members appreciated the opportunity to contribute to the workshop and to reach out to ITU Members about ICANN and related activities and looked forward to further dialogue and co-operation.

It was agreed that the workshop was timely, useful and resulted in a productive exchange of information.

10. GAC Secretariat

10.1 GAC took note of the report from the Secretariat and welcomed completion of the transfer of the Secretariat from Australia to the European Commission. The Secretariat will continue to give high priority to assisting Members in outreach and new GAC membership.

The new GAC web page is at: <http://www.gac.icann.org>

11. Next Meeting

The next GAC face-to-face meeting will be in Montreal, June 2003. Meanwhile, GAC will continue its work on-line, and through the new Working Groups and ICANN Liaisons.

Annexes (2)

Annex 1 GAC - ICANN Liaisons

1. ICANN Board - GAC Chair
 2. Generic Names Supporting Organisation (GNSO) - Audri Mukhopadhyay, Canada (Accr. Rep.)
 3. ccTLD Names Supporting Organisation - Gema Campillos, Spain (Accr. Rep.)
 4. Root Server Advisory Committee RSSAC - Thomas de Haan, Netherlands (Accr. Rep.)
 5. Security and Stability Advisory Committee - Tom Dale, Australia (Accr. Rep.)
 6. Addressing Supporting Organisation (ASO) - Robert Shaw, ITU (Accr. Rep.)
 7. Technical Liaison Group (TLG) - Richard Hill, ITU (Adviser)
 8. At Large Advisory Committee (ALAC) - Carlos Valdez, Peru (Accr. Rep.)
 9. Nominating Committee - Provisional liaison: GAC Secretariat
-

Annex 2 GAC - Working Groups

1. Generic Top Level Domains (gTLDs)
 2. International Domain Names (IDN)
 3. Whois
 4. Country Code Top Level Domains (ccTLDs)
 5. Root Server Operation and DNS Security
 6. Internet Protocol Version 6 (IPv6)
-

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Message from Bruce Tonkin, GNSO Chair, to Louis Touton

7 May 2003

Subject: GNSO Council response to ICANN Board on WIPO letter
Date: Wednesday, 7 May 2003
From: Bruce Tonkin
To: Louis Touton
Cc: Vint Cerf, Paul Twomey

To: ICANN Secretary
From: Chair, GNSO Council

Dear Louis,

The GNSO Council in its meeting on 17 April 2003, resolved to provide the following comments to the ICANN Board with respect to the WIPO letter referred to in the ICANN Board minutes of 12 March 2003 (<http://www.icann.org/minutes/prelim-report-12mar03.htm>):

The GNSO Council recommends that the ICANN Board

- (1) consider the WIPO recommendations separately from the review of the existing Universal Dispute Resolution Policy (UDRP) which is aimed at trademarks.
- (2) consider that the WIPO recommendations associated with Names and Acronymns of International Intergovernmental Organisations and Country Names should be subject to a policy development process to look at how they can be implemented taking into account a thorough examination of the issues surrounding the recommendations.

Regards,

Bruce Tonkin

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Message from Vittorio
Bertola, At-Large Advisory
Committee Chair, to Louis
Touton
12 May 2003

Subject: ALAC comment on WIPO2 recommendations
Date: Mon, 12 May 2003
From: Vittorio Bertola
To: Louis Touton
Cc: At-Large Advisory Committee

Louis,

Please find attached the ALAC's comments on WIPO2 recommendations to ICANN.

Regards,

vb

ALAC Comments on WIPO 2 Recommendations to ICANN

Introduction

The [Interim At-Large Advisory Committee](#) thanks the Board for the [opportunity to comment](#) on the [recommendations](#) concerning the protection of the [names and acronyms of intergovernmental organizations](#) (IGOs) and of [country names](#) in the DNS, communicated to ICANN by the World Intellectual Property Organization (WIPO) on February 21, 2003.

The present comments focus on the ALAC's basic concerns with the subject matter of these recommendations, which appears to be out of scope of ICANN's limited mission.

We therefore provide only a preliminary analysis of the recommendations proper (see Annex I below), and would submit a more detailed analysis of the recommendations if and when WIPO's recommendations are subject to policy-development processes.

Subject Matter Concerns

ICANN's [mission and core values](#) have a clear focus on the organization's technical coordination function – ICANN is clearly not intended to be an international law-making body. Rather, ICANN acts within a framework of national and international laws. It serves to provide architectural support for existing laws, not to make new laws.

Both ICANN and WIPO have followed this principle relatively successfully in the past, when establishing the [UDRP](#) as an inexpensive method to address the bad faith registration of others' trademarks as domain names, while deferring to the courts in situations in which several parties may have legitimate claims to a domain name. Underlying the UDRP is a body of law which is reasonably uniform, internationally.

In the Committee's view, two key features of the UDRP help to keep ICANN out of a lawmaking role:

First, the UDRP addresses only situations where a complainant has rights under existing trademark laws. Decisions are specifically required to be made in accordance with the rules and principles of law that the panel finds applicable. The UDRP implements existing law which has been developed by well-established governmental law-making mechanisms. It does not create new trademark law.

Second, parties dissatisfied with UDRP procedure or rulings can obtain judicial review in an appropriate court. This helps to ensure that the UDRP does not supersede applicable national law.

The Committee is concerned to observe that WIPO's recommendations on the protection of the names of IGOs and countries seem to contemplate creation of rights in names without support in existing law. Indeed, WIPO's September 2001 Report of the Second WIPO Internet Domain Name Process ([The Recognition of Rights and the Use of Names in the Internet Domain Name System](#), September 3, 2001, "WIPO Report") recognizes that there is no basis in existing law for the special rights that the current recommendations would implement through forced cancellation or transfer of domain names.

In the case of the [WIPO recommendations on IGOs](#), paragraph 138 of the WIPO

Report describes the limited nature of rights of IGOs in their names and abbreviations under Article 6^{ter} of the Paris Convention. In paragraph 168, the WIPO Report recognizes that cancellation or transfer of domain names through an ICANN-mandated administrative procedure:

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 6^{ter} of the Paris Convention, the Trademark Law Treaty and the TRIPS Agreement. While it is believed that such an extension is desirable, it would require a legitimate source in international law. It would be for States to determine the appropriate basis for such an extension of law, either in the form of a resolution of a competent treaty organ, a memorandum of understanding duly accepted by national authorities or a treaty.

Despite these observations, WIPO has now transmitted recommendations calling for creation of a mandatory administrative procedure, disregarding existing law's limitations on rights in IGO names and abbreviations. The recommendations would also remove the current UDRP's assurance that existing legal principles will be observed. Instead, the recommendations replace the right to review in a national court applying national law with only a binding arbitration mechanism applying an "extension of principles" of established law, as described in the WIPO Report.

In the case of the [WIPO recommendations on country names](#), the WIPO Report is even more direct about the lack of basis in existing law. It states in paragraphs 286 and 287:

286 . . . Rather than expressing agreement or disagreement with this position [favoring exclusive rights in country names], we draw attention to the following fundamental characteristics of the debate, as they have emerged from the Second WIPO Process:

- (i) The question of the appropriateness of the registration of country names in the gTLDs is inextricably linked by some governments to what they perceive to be their national sovereign interest.
- (ii) Protecting country names in the gTLDs would require or amount to the creation of new law, a function traditionally reserved for States.

287. Both points lead us to conclude that we have reached the limits of

what can be achieved legitimately through consultation processes, such as the WIPO Internet Domain Name Processes or any similar ICANN processes. In other words, we agree with those commentators who are of the view that this particular question is more appropriately dealt with by governments.

Despite this clear recognition that there is no basis in current law for recognition exclusive rights to country names, the current WIPO recommendations propose amendment of the UDRP to implement those "rights."

We believe that it would be inappropriate for ICANN to assume the role of an international legislator, and to try to establish such new law through its contracts and policy processes. For this reason, any policy-making processes which are based upon WIPO's recommendations in the areas of the protection of IGOs' and countries' names must pay close attention to staying within the confines of supporting existing, internationally uniform law.

In view of these new difficulties – which are less evident in the trademark-centric review of the UDRP currently underway – the Committee supports the [GNSO Council's recommendation](#) to separate the UDRP's review from discussions about implementation of WIPO's recommendations, and to address the additional WIPO requests in a separate policy-making process.

The Committee also recommends to the Board that any separate policy-making process begin with a careful review of the legal basis for rights that are proposed to be created or implemented. The September 2001 WIPO Report strongly indicates that the current WIPO recommendations propose to implement "rights" that are not supported by existing law. The Board, in common with other ICANN bodies, has a responsibility to take care that ICANN adhere to its limited mission. The Committee urges the Board to ensure that ICANN's policy development proceed only where there is a solid legal foundation and a full understanding of the limits of existing legal consensus.

Annex I: Preliminary Analysis of the Recommendations

We note that a more precise analysis will be necessary for a final assessment of the extent to which an implementation of WIPO's recommendations would indeed be possible without leading to the creation of new international law. We do not provide that analysis in this document, but will focus on a number of remarks on the merits of the individual recommendations.

We would ask in the first instance whether there is any real problem of mis-registration of names of IGOs and Countries, or whether perceived problems can be solved without new ICANN intervention, for example through use of the existing restricted .int TLD and countries' own ccTLDs. Where such a minimally disruptive alternative is available, that should be examined thoroughly before more extensive regulation is proposed.

Names and Acronyms of IGOs

- The committee notes that the WIPO Report disparages the .int top-level domain for its internal limitations and because there is a general lack of public awareness of the TLD. Rather than reshaping the rest of the domain name system to solve those deficiencies, the Committee proposes that the .int TLD be re-examined and restructured, if necessary, as a dedicated TLD for IGOs.
- The language proposed by WIPO seems to apply to past and future registrations. The committee notes that, given that most IGOs' acronyms are short, there is a high likelihood that these might in good-faith be used as acronyms for other entities, and may have been registered in good faith. The settled expectations of existing domain name holders should not be upset.
- Recommendation 1.A suggests a complaint system based on "registration or use" of a domain name which need to be of a certain "nature" in order to justify a complaint. This wording, and the subjectivity of the determination it entails, bears a considerable risk of extending policy-based dispute resolution mechanisms to areas touching upon the regulation of Internet content. We recommend that such disputes be left to regular courts.
- Recommendation 1.B's wording is rather comprehensive — as presented, this recommendation would not be limited to IGOs' names and acronyms as registered according to Paris Convention art. 6ter, but may cover any names and acronyms covered by any international contract. The right to complain would be given to any IGO. This recommendation may be misread as an attempt to use ICANN policies as an instrument for the enforcement of arbitrary international contracts. The Committee suggests that ICANN should seek clarification of this recommendation from WIPO.

Country Names

- The language on country names once again relies upon criteria applied to the "registration or use" of domain names. The same concerns as above apply.

- Once again, it seems more appropriate for each country to control its name (and related strings as it chooses) in its unique ccTLD, where the matter can be addressed on a national level according to national law, not to grant it monopoly rights in character strings across all TLDs.

Annex II: Comments received

The ALAC solicited public comments on a [draft version](#) of the present advice. A single comment was submitted, [by Alexander Svensson](#). In this comment, Mr. Svensson supports the draft statement, and points out: *"ICANN already had to deal with the request by its Governmental Advisory Committee (GAC) to reserve country names under the .INFO top level domain. Interestingly, it seems that only a small group of governments has put the reserved domain names to use."*

Additional Statement

From: Erick Iriarte Ahon
Sent: Tuesday, May 13, 2003
To: Denise Michel
Subject: WIPO2 comments to ICANN

As a member of the Interim At-Large Advisory Committee, I would like expand upon the "ALAC Comments on WIPO 2" and provide an additional, personal perspective. In considering the recommendations concerning the protection of the names and acronyms of country names in the DNS, communicated to ICANN by the World Intellectual Property Organization (WIPO) on February 21, 2003, I recommend that the Board give careful consideration to ICANN's role in the treatment of country-name strings across top level domains.

Specifically, the use of a country's name (and other character strings it chooses) in multiple languages (at a minimum the six languages used in the United Nations), should be subject to the "first come, first serve" rule. ICANN and/or WIPO should consider the establishment of clear parameters for the use of domain names that are the same [equal] to a country's name.

Erick Iriarte Ahon
Member, Interim At-Large Advisory Committee

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Message from Michael
Heltzer, Secretary of GNSO
Intellectual Property
Constituency, to Louis Touton
15 May 2003

Subject: IPC Position on WIPO IGO Recommendation
Date: Thursday, 15 May 2003
From: Michael Heltzer
To: Louis Touton

Louis:

Given that we only just recently returned from Amsterdam, the IPC was unable until now to develop a written position on the above topic. Please accept our apologies for the lateness of the submission.

Regards,

Mike Heltzer
IPC Secretary

At the IPC Meeting on May 7 in Amsterdam, it was the consensus of the members present that the IPC oppose amending the UDRP to accommodate the recommendation that disputes relating to International Intergovernmental Organizations (IGOs) should not be required to submit to the jurisdiction of national courts. This recommendation is contained in the [February 21, 2003 letter from WIPO Assistant Director General Francis Gurry to ICANN Board Chairman Dr. Vint Cerf and then-ICANN President Dr. Stuart Lynn](#).

When the UDRP was in its initial drafting stages, the ICANN Board pointed out several areas of concern, including the need for general parity between the appeal rights of complainants and domain name holders. ([ICANN Resolution No. 99.83](#), paragraph 4-Santiago, Chile August 26, 1999). In particular, it was noted that as drafted at that time,

there would be some cases in which the domain-name holder would have no clear mechanism for seeking judicial review of a decision of an administrative panel canceling or transferring the domain name. As a result, the initial documents were revised to require that the complainant include in its complaint a statement submitting to jurisdiction for purposes of court review of administrative panel decisions in its favor.

Like ICANN, the IPC views the accessibility to a national court as one of the UDRP's basic underpinnings and a reason for its acceptance as a fair and reasonable dispute resolution procedure. The fact that parties can turn to a court of law serves as a safety valve on the authority of dispute resolution panelists, provides equity, safeguards essential rights of both parties, and properly ensures that the courts are the ones who are ultimately responsible for interpreting the law – both national and international alike.

The IPC appreciates consideration of its views.

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Message from GNSO Commercial and Business Users Constituency to Paul Twomey and Vint Cerf

21 May 2003

Date: Wednesday, 21 May 2003
From: Philip Sheppard
Subject: BC position on new WIPO recommendations
To: Paul Twomey, Vint Cerf
Cc: Louis Touton

Business Constituency position on the proposals for dispute resolution for international organisations and country names

Paul, Vint, Louis,

Please find attached the BC position paper concerning new recommendations from the World Intellectual Property Organisation. We would be grateful if you would share this with the Board and other parties engaged on this issue.

Philip Sheppard
Marilyn Cade
Grant Forsyth

Business Constituency Position Paper

Proposals for dispute resolution for international organisations and country names

Executive summary of recommendations

1. The existing UDRP relating to trademarks and domain names must remain entirely

unaffected by the new World Intellectual Property Organisation (WIPO) proposals.

2. The new WIPO proposals on disputes relevant to international organisations and country names should be evaluated for both the merit of the need and the merit of the proposed solutions.

3. If any action is determined necessary a separate dispute system should be established for international organisations and country names.

Background

The Business Constituency supports ICANN's existing uniform dispute resolution policy (UDRP) which has a primary function for the resolution of trade mark and domain name disputes. The policy was originally proposed in a set of recommendations from UN-agency the World Intellectual Property Organisation (WIPO). The recommendations are known colloquially as WIPO1. The recommendations came from the WIPO standing committee on trademarks – a committee comprising representatives of national trademark registration offices. The UDRP has certain characteristics:

- it is fast: a resolution is given in weeks not years.
- it is non-binding on the parties to the dispute: either party can subsequently go to Court.
- it is administered by panelists who are typically experts in trade mark law.

In February 2003 WIPO wrote to ICANN¹ with new recommendations (WIPO2):

to *modify* the UDRP to allow international organisations (91) to file complaints;
to *amend* the UDRP to set up a reserve-list of country names (~329) for which registration as a future top-level domain name would be exclusive to the country itself.

These recommendations, not on trademark matters, also have their origin in WIPO's standing committee on trademarks. They were not universally supported within WIPO: the US, Canada, Australia and Japan expressed opposition to one or both proposals. ICANN's Government Advisory Committee has asked the Board to act. The ICANN Board has asked the GNSO Council to advise on the matter.

The issues

There are two separate issues. Firstly, is there merit in the proposals themselves? Is there a problem that needs a solution?

Secondly, if yes, then is the proposed solution of modifying or amending the existing UDRP a good solution?

Has WIPO identified a real problem?

– International Organisations (IGOs)

WIPO identifies the problem as the claim of a false association with an IGO and/or the possibility of user deception as a result: i.e. bad faith confusion.

How many actual problems of bad faith confusion have there been?

- The BC understands there have been very few. There are only 91 registered IGOs in the world. The target problem is often free-speech sites set-up by entities with a political message related to the IGO: while this is irritating, confusion as to ownership is unlikely to be lasting. Moreover, content regulation is not within ICANN's mission.
- If there is a real need the correct solution, as recognised in §168 of the WIPO report² should be a new WIPO treaty because the solution would create new international law: but WIPO was not prepared to go that far. This implies that the need for any change is uncertain.

What existing protection is there?

- IGOs already have a privileged domain space .int. If a bona fide registrant sets up in say .com with an identical name, would there really be confusion?
- Certain IGOs have trademark registration: the existing UDRP works for them already.

Is the solution proportional to the problem?

- WIPO seeks protection not only for the names but the acronyms of IGOs. The protection would not require the UDRP's cumulative tests for bad faith: the fact of registration could be enough for a successful challenge. This goes too far and, as the WIPO report showed, may involve unnecessary disputes over names such as *who*. Is this the World Health Organisation, the pop group or the cult sci-fi figure Dr. Who? The off-line world differentiates by being context specific. These proposals are context neutral.

Is there a better solution?

- IGOs can only register once in .int. ICANN should allow IGOs to have multiple registrations (such as the name and the initials) in the .int space.

– Country names

WIPO identifies the problem as the claim of a false association with a country and/or the possibility of user deception as a result: i.e. bad faith confusion.

How many actual problems of bad faith confusion have there been?

- The BC understands there have been very few.

What existing protection is there?

- This protection already exists for the .info domain name: is this not sufficient?

Is the solution proportional to the problem?

- For countries to do on-line what they do not do off-line is inconsistent. Country names are used in areas such as trade, tourism and education by trademarks, and by company and organisation names. Insisting on potential exclusivity for *all* future domain names is disproportional to the perceived problem.
- The solution is short-sighted. It was conceived in a world where .com is the dominant gTLD: the abuses cited often related to .com. In the future there will be many more gTLDs where adequate differentiation will be achieved so reducing the likelihood of confusion.

Is there a better solution?

- Creating a new gTLD with registration exclusively for governments is a more elegant way to reduce consumer confusion.

It makes no sense to change the existing UDRP

The existing trademark UDRP is quite different to the new types of dispute resolution proposed.

- In relation to IGOs, UDRP panelists would in effect be setting new international law. They are not qualified to do this.
- In relation to country names, §234 of the WIPO report³ recognizes that the legal entitlement of a country to its corresponding name at the international level is not firmly established. There is no jurisprudence, similar to the century of trademark jurisprudence, to guide a dispute resolution panelist in this field.
- The current proposals are flawed and may result in contested resolutions. This would bring the existing UDRP for trademarks into disrepute.
- A separate system is needed because the characteristics of the solution proposed by WIPO differ significantly from the characteristics of the existing UDRP.

Characteristic	Trademark UDRP	IGOs	Country names
Non-binding nature: resource to Court possible	Yes	No	No
Panelists expertise in trademark law relevant	Yes	No	No
Protection based on reserve-list	No	No	Yes
History of relevant jurisprudence	Yes	No	No

Recommendations

1. The existing UDRP relating to trademarks and domain names must remain entirely unaffected by the WIPO² proposals.
2. The new WIPO proposals on disputes relevant to international organisations and country names should be evaluated for both the merit of the need and the merit of the proposed solutions.

In this evaluation it should be remembered that both proposals are political compromises. In the case of IGOs, certain countries had specific disputes but WIPO did not agree to the more courageous solution of a new treaty. In the case of country names, WIPO has plucked this one item out of an on-going debate on other geographical names, and has not yet addressed the relevant complications.

3. If any action is determined necessary a separate dispute system should be established for international organisations and country names.

Notes:

1. <http://www.icann.org/correspondence/gurry-letter-to-cerf-lynn-21feb03.htm>
2. <http://wipo2.wipo.int/process2/report/html/report.html>
3. <http://wipo2.wipo.int/process2/report/html/report.html>

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ARTICLES

ICANN'S "UNIFORM DISPUTE RESOLUTION POLICY"—CAUSES AND (PARTIAL) CURES*

A. Michael Froomkin†

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† A. Michael Froomkin is Professor of Law at the University of Miami. E-mail: froomkin@law.tn. Please see the Notes, Credits, and Disclosures at the end of this Article. Special thanks to Caroline Bradley, John Berryhill, Bret Fausett, David Post, and Jonathan Weinberg, each of whom made valuable comments on earlier drafts, to Ethan Katsh and Michael Geist for sharing UDRP data, and to Jessica Litman for being an invaluable trademark law guide.

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INTRODUCTION

Trademark law is organized around a set of objectives and assumptions that map badly onto the Internet. Trademark law is predominantly ordered around sectoral, geographic, and national principles. In contrast, the Internet is defiantly ignorant of national borders.¹ This tension has spawned a number of legislative and quasi-public responses designed in some cases to attempt to harmonize the two regimes, but more often to bring the Internet into conformity with trademark law. Of these, probably the most ambitious—and surely one of the most flawed and unfair—is the Uniform Dispute Resolution Policy² (“UDRP”) adopted by the Internet Corporation for Assigned Names and Numbers³ (“ICANN”) to provide a mandatory arbitration-like process to regulate disputes over domain name registrations by alleged “cybersquatters,”⁴ that is, people who register domain names in order to resell them at a profit to an owner of a corresponding trademark.

The UDRP is worth examining in detail because it is being touted as a model for e-commerce dispute settlement by industry spokespersons and policy entrepreneurs⁵ and soon

¹ See, e.g., A. Michael Froomkin, *The Internet as a Source of Regulatory Arbitrage*, in BORDERS IN CYBERSPACE 129 (Brian Kahin & Charles Nesson eds., 1997), available at <http://www.law.miami.edu/~froomkin/articles/arbitr.htm>.

² Internet Corporation for Assigned Names and Numbers, Uniform Domain Name Dispute Resolution Policy, available at <http://www.icann.org/udrp-udrp-policy-24oct99.htm> (Oct. 24, 1999) [hereinafter UDRP].

³ Arguably, ICANN itself could be said to be a by-product of this collision. For discussions of ICANN see A. Michael Froomkin, *Wrong Turn in Cyberspace: Using ICANN to Route around the APA and the Constitution*, 50 DUKE L.J. 17 (2000) (critiquing formation and use of ICANN as a means to avoid public rulemaking), available at <http://www.law.miami.edu/~froomkin/articles/icann.htm>; Jonathan Weinberg, *ICANN and the Problem of Legitimacy*, 50 DUKE L.J. 187 (2000), available at <http://www.law.duke.edu/shell/cite.pl?50+Duke+L.+J.+187>.

⁴ Articles discussing related issues include Froomkin, *supra* note 3; A. Michael Froomkin, *Semi-Private International Rulemaking: Lessons Learned from the WIPO Domain Name Process*, in REGULATING THE GLOBAL INFORMATION SOCIETY 211 (Christopher T. Marsden ed., 2000) (critiquing procedures used by World Intellectual Property Organization to contribute to private lawmaking), available at <http://www.law.miami.edu/~froomkin/articles/tprc99.pdf>.

⁵ See, e.g., Juliana Guenwald, *Intellectual Property Organization Stumped*, INTERACTIVE WEEK, Feb. 1, 2001, at <http://www.zdnet.com/intweek/stories/news/0,4164,2681274,00.html> (noting speech by WIPO Assistant Director General Francis Gurry praising UDRP as model); Brian Krebs, *Regulators Would Do Well to Mimic*

may be required by treaty. The U.S. Department of Commerce recently lauded the UDRP as “an efficient, inexpensive procedure for the resolution of disputes.”⁶ Other governments also have endorsed the UDRP in principle,⁷ and at least twenty-one apply the UDRP to registrations in their domestic country-code top-level domains.⁸ Many academic commentators also have praised the UDRP,⁹ although some have been more

ICANN—White House, at <http://www.newsbytes.com/news/00/148011.html> (Apr. 25, 2000) (summarizing a speech by Department of Commerce General Counsel Andrew Pincus arguing that “[t]he federal government could put an end to its numerous Internet regulatory headaches if it approached industry with the same type of cooperation shown . . . under the aegis of ICANN”); Masanobu Katoh, *ICANN—A Model for International Organizations in the 21st Century*, at http://www.mkatoh.net/speech/icann_katoh072000-e.ppt (July 2000) (archiving PowerPoint slides from a speech made by ICANN board member-elect arguing that ICANN could be a model for global rulemaking in the twenty-first century).

⁶ U.S. Dep’t of Commerce, National Telecommunications and Information Administration Annual Report 2000, available at <http://www.ntia.doc.gov/ntia-home/annualrpt/2001/2000annrpt.htm> (last visited Nov. 28, 2001).

⁷ See WIPO, *ccTLD Best Practices for the Prevention and Resolution of Intellectual Property Disputes*, at <http://ecommerce.wipo.int/domains/cctlds/best-practices/bestpractices.html> (Version 1: June 20, 2001) (endorsing UDRP as “an excellent reference model and a valuable starting basis” for design of online dispute resolution).

⁸ See UDRPlaw.net, *ccTLDs and International Domain Name Dispute Resolution*, at <http://www.udrplaw.net/cctldDisputes.htm> (last visited Nov. 28, 2001).

⁹ Most of this work is either frankly results-oriented, focuses on an idealized version of the UDRP, or limits itself to the substance of the rules rather than confronting the UDRP’s serious procedural failures. Examples include Shamnad Basheer, *Establishing Rights/Legitimate Interests in a Domain Name: Cyber Squatters Get Creative*, 7 *COMPUTER AND TELECOMM. L. REV.* 1 (2001); Leah Phillips Falzone, *Playing the Hollywood Name Game in Cybercourt: The Battle over Domain Names in the Age of Celebrity-Squatting*, 21 *LOYOLA L.A. ENT. L. REV.* 289 (2001) (praising UDRP as tool for celebrities to wrest “their” names from cybersquatters); Patrick L. Jones, *Protecting Your ‘SportsEvent.com’: Athletic Organizations and the Uniform Domain Name Dispute Resolution Policy*, 5 *W.VA. J. L. & TECH.* 2.1 (2001), available at <http://www.wvu.edu/~wvjolt/Arch/Jones/Jones.htm>; Jason M. Osborn, *Effective and Complementary Solutions to Domain Name Disputes: ICANN’s Uniform Domain Name Dispute Resolution Policy and the Federal Anticybersquatting Consumer Protection Act of 1999*, 76 *NOTRE DAME L. REV.* 209 (2000); John G. White, *ICANN’s Uniform Domain Name Dispute Resolution Policy In Action*, 16 *BERKELEY TECH. L.J.* 229 (2001); Yun Zhao, *A Dispute Resolution Mechanism for Cybersquatting*, 3 *J. WORLD INTELL. PROP.* 849 (2000); Donna L. Howard, Comment, *Trademarks and Service Marks and Internet Domain Names: Giving ICANN Deference*, 33 *ARIZ. ST. L.J.* 637, 664 (2001) (“[M]ost of ICANN’s [sic] decisions so far have been slam-dunks . . . ICANN’s dispute resolution policy . . . is working and the public is satisfied.”).

critical.¹⁰ Most worryingly, the latest draft of the intellectual property section of the draft Free Trade Area of the Americas (“FTAA”) agreement includes a proposal that signatory states mandate the UDRP for the resolution of domain-name disputes.¹¹

¹⁰ See Elizabeth G. Thornburg, *Going Private: Technology, Due Process, and Internet Dispute Resolution*, 34 U.C. DAVIS L. REV. 151 (2000); Ian L. Stewart, *The Best Laid Plans: How Unrestrained Arbitration Decisions Have Corrupted the Uniform Domain Name Dispute Resolution Policy*, 53 FED. COMM. L.J. 509 (2001). A more mixed view appears in Laurence R. Helfer & Graeme B. Dinwoodie, *Designing Non-National Systems: The Case of the Uniform Domain Name Dispute Resolution Policy*, 43 WM. & MARY L. REV. 141 (2001), where after noting some of the UDRP’s flaws the authors optimistically suggest that once they are cured, and especially once a more legitimate process is found to enact it, the UDRP should serve as a model for future adjudicatory processes.

¹¹ See FTAA—Free Trade Area of the Americas, Draft Agreement, at http://www.ftaa-alca.org/ftaadraft/eng/ngip_e.doc (July 3, 2001). The relevant text, bracketed to indicate it is still subject to negotiation, is:

Article XX. [Domain names on the Internet

1. Parties shall participate in the Government Advisory Committee (GAC) of the Internet Corporation for Assigned Names and Numbers (ICANN) to promote appropriate country code Top Level Domain (ccTLD) administration and delegation practices and appropriate contractual relationships for the administration of the ccTLDs in the Hemisphere.

2. Parties shall have their domestic Network Information Centers (NICs) participate in the ICANN Uniform Dispute Resolution Procedure (UDRP) to address the problem of cyber-piracy of trademarks.]

Article XX. [Cancellation and transfer of domain name

In the event that a well known distinctive sign has been inappropriately registered in the country of the Party, as part of a domain name or electronic mail address of an unauthorized third party, on request by the owner or legitimate rightholder of that sign, the competent authority shall consider the matter and, where appropriate, shall order cancellation or amendment of the registration of such domain name or electronic mail address, in accordance with the respective national law, provided that use thereof would be liable to have one of the following effects:

1. Risk confusion or association with the owner or legitimate rightholder of the sign, or with his or her establishments, activities, products or services;

2. Cause unfair economic or commercial injury to the owner or lawful rightholder of the sign, arising from a dilution of its distinctive force or commercial or publicity value;

The UDRP was controversial even before its birth. On the one hand, trademark owners originally objected that it was too weak and narrow, and would not serve to adequately protect their rights; opponents objected that the courts already adequately protected legitimate trademark interests, and UDRP gave trademark holders de facto rights in excess of those provided by law. With about 4,300 decisions rendered between December 1999 and February 2002, covering more than 7,500 domain names, plus almost 400 additional cases pending,¹² it is time to apply some hindsight to this debate. Analysis of the original World Intellectual Property Organization ("WIPO") proposals and of the UDRP's procedures is particularly timely now as WIPO is releasing a second round of potentially sweeping recommendations for further restrictions on domain name registrations¹³ and

3. Make unfair use of the prestige of the sign, or of the good name of its owner or lawful rightholder.

The action of cancellation or amendment shall prescribe, for a period of five (5) years from the date on which the disputed domain name or electronic mail address was registered, or from the date on which electronic media, whichever period expires later, except where the registration was made in bad faith, in which case the action shall not be prescribed. This action shall not affect any other action that might be available with respect to injuries and damages under common law.]

Id.

¹² See <http://www.icann.org/udrp/proceedings-stat.htm> (last visited Feb. 14, 2002).

¹³ WIPO described the objectives of the second round process as seeking to combat the

- I. the bad faith, abusive, misleading or unfair use of personal names,
- II. International Nonproprietary Names (INNs) for Pharmaceutical Substances, recommended by the World Health Organization in order to protect patient safety worldwide
- III. names of international intergovernmental organizations (such as the United Nations or WIPO itself)
- IV. geographical indications, indications of source or geographical terms
- V. tradenames

See generally WIPO, *Second WIPO Internet Domain Process*, at <http://wipo2.wipo.int/process2/> (last visited Mar. 27, 2002). The last category in particular is rather broad.

Subsequent to the submission of this Article for publication, WIPO published the final report of its second-round process. See WIPO, *The Recognition of Rights and the Use of Names in the Internet Domain Name System*, at <http://wipo2.wipo.int/process2/report/html/report.html> (Sept. 3, 2001). WIPO recommended that the UDRP or a similar mechanism be adopted to protect INNs, names of international intergovernmental organizations, but not personal names, geographic indications, or

ICANN's review of the UDRP is under way.¹⁴

The UDRP derives its force from ICANN's de facto control of a critical Internet resource.¹⁵ Anyone who wishes to have a domain name visible to the Internet at large must acquire it from a registrar who has the right to inscribe names in an ICANN-approved domain name registry. ICANN determines which registries are authoritative. This power to make and break registries allows ICANN to require registries (and also registrars) to promise to subject all registrants to a mandatory third-party beneficiary clause in which every registrant agrees to submit to ICANN's UDRP upon the request of aggrieved third parties who believe they have a superior claim to the registrant's domain name. In so doing, the UDRP has, to some extent, privatized and internationalized trademark law, although it co-exists with national law. In the United States, for example, abusive registration of domain names is regulated by the Anti-Cybersquatting Consumer Protection Act¹⁶ ("ACPA"), enacted almost simultaneously with ICANN's adoption of the UDRP.

Part I of this Article introduces the political and technical background that produced the UDRP and discusses the main precursor to the UDRP, the WIPO Report entitled *The Management of Internet Names and Addresses: Intellectual Property Issues*¹⁷ which proposed a new global domain name regulatory regime optimized for trademark protection. Part II sets out the main features of the UDRP and ICANN's accompanying rules of procedure and compares them to

trade names on the grounds that international consensus law on these three subjects was not insufficiently uniform at present, making a single global rule impracticable unless the law develops further. *Id.*

¹⁴ ICANN originally announced the review would take place in 2000, see <http://www.icann.org/minutes/minutes-06jun00.htm> (June 6, 2000) (referring to review "later this year") but inexplicably delayed it. Currently, the domain name supporting organization ("DNSO"), a subsidiary body of ICANN, has established a study "task force" of which I am a member. See ICANNWatch, *Names Council Selects UDRP Task Force Members*, at <http://www.icannwatch.org/article.php?sid=317> (last visited Mar. 27, 2002). As of mid-February 2002, the Task Force had yet to make or formulate draft recommendations or even discuss them.

¹⁵ See generally Froomkin, *supra* note 3.

¹⁶ Pub. L. No. 106-43 §§ 3(a)(2), 5, 113 Stat. 218, 220 (1999).

¹⁷ World Intellectual Property Organization, *The Management of Internet Names and Addresses: Intellectual Property Issues—Final Report of the WIPO Internet Domain Name Process*, at <http://wipo2.wipo.int/process1/report/finalreport.html> (last visited Mar. 18, 2002) [hereinafter WIPO Final Report].

WIPO's proposals.¹⁸ Part III offers a number of practical suggestions for reform of the procedural aspects of the UDRP.

I. PRE-HISTORY OF THE UDRP

While trademark law's assumptions about the local and sectoral use of trademarks work badly on the Internet because content in one location can be viewed anywhere, those assumptions work especially badly with the Internet addressing system known as the Domain Name System ("DNS"). Trademarks and service marks¹⁹ are intended to be a user-friendly shorthand for an expected level of product attributes, including quality. Trademark law seeks to protect consumers from fraud, counterfeiting, and confusion, and to protect the goodwill that businesses build up in their trademarks. If someone passes off inferior goods by affixing a competitor's trademark, or something that looks confusingly similar to it, both consumer expectations and supplier goodwill suffer.

Traditionally, however, a trademark does not give a trademark holder exclusive rights over every possible commercial use of a trademarked word or term, especially if the word or term is not coined or famous; even the holders of the strongest marks must accept that others will use them for legitimate non-commercial purposes. Indeed, trademark law allows multiple, concurrent, uses of the same word or name by different people in the same business in different places, or by substantially different businesses in the same place, so long as they are not in competition and there is no danger of significant consumer confusion. Reflecting its origins in the domestic law of multiple nations, trademark law has been organized predominantly on sectoral, geographic, and national principles. With the exception of a small class of "famous" names (e.g., "Coca-Cola") where the assumption is that consumers in the region where the mark is famous would

¹⁸ ICANN, *Rules for Uniform Domain Name Dispute Resolution Policy*, at <http://www.icann.org/udrp/udrp-rules-24oct99.htm> (Oct. 24, 1999) [hereinafter UDRP Rules].

¹⁹ For the purposes of this Article I will use "trademark" to mean "trade or service mark" unless otherwise specified. There are some differences, but none that affect a discussion at this level of generality.

reasonably associate the name with any type of goods on which it might appear, the guiding principle behind much of trademark law is that it best achieves its purposes by limiting the reservation of rights in a name²⁰ to the type of goods and location where those goods are sold. “Joe’s Pizza” can get a trademark in the town where it sells pizza, but not in the whole state or the whole country, and different Joe’s Pizzas can dot the landscape so long as they do not serve overlapping territories. If one Joe’s Pizza becomes a national business, it cannot undermine the pre-existing rights of the Joe’s Pizzas already extant, but it can more or less prevent them from expanding their markets. Similarly, Apple Computer coexists internationally with Apple Records because those businesses offer different classes of goods and services.

With the exception of some treaty-based registration systems that allow multiple registration in a unified process, trademarks are issued by national governments, one country at a time, and for one or only a few categories of goods or services at a time. Thus, a firm can trademark the word “United” for air transport, but this will not extend to moving vans unless the firm is in that business also. Trademark registrations generally require use to remain effective. While they are in effect, they give the holder important rights against others who would unfairly capitalize on the mark’s goodwill by confusing consumers. Equally important, trademarks protect consumers against sellers who might seek to pass off their goods as produced by the mark holder. As a general matter, however, in the United States at least, trademark infringement requires commercial use by the infringer. Absent commercial use, some type of unfair competition, or a very small number of other specialized offenses (e.g., “tarnishment” of a mark by associating it with obscenity), trademark law does not make the use of the mark an offense. Thus, for example, in the United States as in most other countries, there are many permitted commercial and non-commercial uses of a basic dictionary word such as “united,” including parody, criticism, names of pets, and references in literature, despite the existence of a plethora of trademarks including the word.

²⁰ Or symbol or other identifier, but as there is no way to express these directly in a domain name we can ignore them for present purposes.

Unless the mark falls into the small category of “famous” marks, it is generally permissible to make commercial use of a name trademarked by another so long as it is not likely to cause customer confusion.²¹ Even if a mark is famous, some types of commercial use remain available, including accurate comparative advertising, news reporting, news commentary, and other “nominative fair uses” where the trademarked term is the only way to identify the thing being discussed.²²

In contrast to trademark law's ability to tolerate multiple users of the same mark, the Internet enforces a greater degree of uniqueness. Every resource attached to the Internet must have a unique Internet Protocol (“IP”) number. Without an identifying number no one can find the resource, and without a unique number correspondents would have no way of controlling which identified resource received a communication. IP numbers are a thirty-two bit number consisting of four octets (sets of eight binary digits) that specify a network address and a host ID on a TCP/IP network.²³ These “dotted quads”—four numbers separated by three periods—are hard to remember and hard to type, so the Internet also relies on optional but ubiquitous human-friendly names to help people identify the resources with which they wish to communicate.²⁴ These are domain names.²⁵

Domain names are the alphanumeric text strings to the right of an “@” symbol in an e-mail address, or immediately following the two slashes in a World Wide Web address. Thanks to a massively distributed hierarchical system for

²¹ For a recent reaffirmation of this principle, see *Playboy Enters., v. Welles*, 279 F.3d 796 (9th Cir. 2002).

²² See *New Kids on the Block v. News Am. Publ'g, Inc.*, 971 F.2d 302 (9th Cir. 1992).

²³ The text describes IPv4 which is the most commonly used standard. IPv6 will expand the IP numbers to a dotted sextet, thus easing the current shortage of IP numbers. See generally STEVE KING ET AL., *THE CASE FOR IPv6 at 4* (1999), available at <http://www.ietf.org/internet-drafts/draft-ietf-iab-case-for-ipv6-05.txt> (touting IPv6's “enhanced features, such as a larger address space and improved packet formats”); *IPv6: Networking for the 21st Century*, available at <http://www.ipv6.org> (last visited Mar. 18, 2002).

²⁴ See P. Mockapetris, Internet Engineering Task Force, Request for Comments (“RFC”) 1034, *Domain Names—Concepts and Facilities* 29, at <http://www.ietf.org/rfc/rfc1034.txt> (Nov. 1987).

²⁵ The next few paragraphs are drawn from previously published articles by myself.

resolving domain names to IP numbers, the DNS Internet software can rapidly and invisibly convert a domain name to its IP number.²⁶ Thus, for example, a properly designed Internet browser presented with a domain name in a uniform resource locator (“URL”) such as <http://www.law.miami.edu> will contact a DNS server, request the corresponding IP number, <http://129.171.187.10>, and then direct a request to that resource.²⁷ Domain naming conventions treat a domain name as having three parts: in the address www.miami.edu, for example, “edu,” the rightmost part, is the top-level domain (“TLD”), while “miami” is the second-level domain (“SLD”), and any other parts are lumped together as third or higher-level domains. Domain names are just conventions, and the names of the current TLDs are, from a technical point of view, purely arbitrary.

Users cannot claim a TLD of their own.²⁸ For a fee, however, a user can acquire exclusive rights²⁹ to a SLD in any

²⁶ See generally ELLEN RONY & PETER RONY, *THE DOMAIN NAME HANDBOOK* 26, 31-32 (1998).

²⁷ See Neil Randall, *How DNS Servers Work*, PC MAG., Sept. 24, 1996, at 217; Neil Randall, *What Happens When You Click*, PC MAG., Oct. 22, 1996, at 245.

²⁸ At least, not in the legacy root; almost anything is possible in the independent roots but these are ignored by the large majority of Internet users, and are inaccessible to the growing number of users who cannot choose their DNS provider because it is set by an upstream service provider.

²⁹ The precise nature of the right one acquires by entering into a domain registration contract with a registrar or registry is a subject of both debate and strong-arm tactics. Registries have an interest in minimizing the rights that accrue to their customers, and in particular in ensuring that whatever the nature of the right it does not sound in “property”; their preferred characterization of the relationship is that a registrant enters into a service contract. For a particularly striking example of this see Bret Fausett’s markup of the changes in Great Domain’s terms of service after their acquisition by Verio, <http://www.lextext.com/GDUser.pdf> (last visited Mar. 18, 2002).

In *Network Solutions, Inc. v. Umbro Int’l, Inc.*, 529 S.E.2d 80 (Va. 2000), the Supreme Court of Virginia held that a registrant’s interest in a domain name was merely contractual and hence could not be garnished. See *id.* at 80. On the other hand, Congress recently passed the ACPA, §§ 3(a)(2), 5, which authorizes in rem actions against domain names. Since in rem proceedings are traditionally used to attach property, this argues that domain names are property. The *Umbro* court, however, was completely unpersuaded by this reasoning, see 529 S.E.2d at 86 n.12, as it was by Network Solutions, Inc.’s concession at trial that domain names are a form of intangible personal property. See *id.* at 86. If that is correct, then ACPA creates a statutory in rem proceeding for non-property, which is novel and might in some cases have due process/minimum contacts problems. See, e.g., Veronica M. Sanchez, *Taking a Byte out of Minimum Contacts: a Reasonable Exercise of Personal Jurisdiction in Cyberspace Trademark Disputes*, 46 UCLA L. REV. 1671 (1999).

TLD that will accept her registration. The registrant may then create as many third or higher-level domains as she wishes under that SLD. The number and names of TLDs are set by the maintainer of the authoritative "root" file from which, by convention (not law), all other participants in the DNS copy their data.³⁰ Although there is no technical obstacle to creating new TLDs, there have been numerous political obstacles to new TLDs, not least the concerns of trademark holders that new TLDs would dilute their brands, provide new opportunities for customer confusion, or subject the holders to ransom demands from cybersquatters.

Internet czar Jon Postel fixed the original list of top-level domains in 1984.³¹ Although new country codes were and are added routinely,³² there was a long-standing freeze on the creation of new generic TLDs ("gTLDs") that ended only in late 2001.³³ Thus, during the 1990s, registrants focused heavily on the three gTLDs then open to them, and especially on .com. Today, the DNS system used by the vast majority of Internet users³⁴ is made up of 244 two-letter country code TLDs

³⁰ A root file is the data file containing the addresses of the machines that carry the authoritative registries for each TLD. See Froomkin, *supra* note 3, at 43-44. To be more precise, the root file is copied to the "A" root server. The B-L root servers copy their data from "A"; everyone else copies from one of the root servers or from someone who has a cached downstream copy of the original data. There can be many intermediaries in the chain.

³¹ J. Postel & J. Reynolds, Internet Engineering Task Force, RFC 920, *Domain Requirements*, at <http://www.ietf.org/rfc/rfc0920.txt> (Oct. 1984).

³² For example, the U.S. Department of Commerce created ps for Palestine upon a recommendation from the so-called Internet Assigned Numbers Authority ("IANA"), a subsidiary of ICANN, in 2000. See *IANA Report on Request for Delegation of the ps Top-Level Domain*, at <http://www.icann.org/general/ps-report-22mar00.htm> (Mar. 22, 2000).

³³ In a long, expensive, and convoluted process, ICANN chose a list, sometimes called the not-so-magnificent seven, of new gTLDs it would recommend be added to the root: .aero, .biz, .coop, .info, .museum, .name, and .pro. For the go-live dates, starting with .info on Sept. 23, 2001, see Netcraft, *Netcraft Web Server Survey*, (Feb. 2002), <http://www.netcraft.com/survey/>. Of these seven new TLDs, ICANN intended .biz, .info, and .name, "to be relatively large, unsponsored TLDs" and generally open to most or all registrants, but intended .aero, .coop, and .museum to be smaller, "sponsored," TLDs with much more restrictive registration criteria. If and when it goes live, .pro will be a type of "unsponsored" TLD. See ICANN, *New TLD program*, <http://www.icann.org/tlds/> (last visited Mar. 12, 2002).

³⁴ In addition to the "legacy root" TLDs discussed in this Article, there are a large number of "alternate" TLDs that are not acknowledged by the majority of domain name servers. See RONY & RONY, *supra* note 26, at 513-72 (describing the "Alterweb"). There is no technical bar to their existence, and anyone who knows how to tell his

("ccTLDs"), fourteen three-letter gTLDs, and one four-letter TLD (.arpa).³⁵ Domains registered in ccTLDs and gTLDs are equally accessible from any computer on the Internet.

Until last year, there were only three gTLDs open to anyone who could afford to pay for a registration: .com, .org and .net. Other gTLDs in existence since 1984 impose additional criteria for registration: .mil (U.S. military),³⁶ .gov (U.S. government),³⁷ .int (international organizations), .edu (institutions of higher education, mostly U.S.-based), and .arpa.³⁸ In November 2000, following a complex and convoluted process, ICANN approved in principle the creation of seven new gTLDs.³⁹ Before each of these new TLDs could become active, the ICANN-approved registry had to negotiate a contract with ICANN and then receive the approval of the U.S. Department of Commerce, which currently has the final say on whether a new gTLD is created.⁴⁰ As of mid-February 2002, six of the seven new TLDs had run this year-long gauntlet and

software to use an alternate domain name server can access both the "legacy root" and whatever alternate TLDs are supported by that name server. Thus, for example, choosing to get domain name services from 205.189.73.102 and 24.226.37.241 makes it possible to resolve <http://lighting.faq>, where a legacy DNS would only return an error message.

³⁵ A list of the ccTLDs, gTLDs, and their registries (NICs) appears at World Internetworking Alliance, *TLD Registries*, at http://www.wia.org/database/DNS_registries.htm (Aug. 19, 2000).

³⁶ Delegation of the .mil domain is under the authority of the DDN NIC. See D. Engbretson & R. Plzak, Internet Engineering Task Force, RFC 1956, *Registration in the MIL Domain 1*, at <http://www.isi.edu/in-notes/rfc1956.txt> (June 1996).

³⁷ Delegation of the .gov TLD is under the authority of the U.S. Federal Networking Council ("FNC"). See FNC, Internet Engineering Task Force, RFC 1816, *U.S. Government Internet Domain Names 1*, at <http://www.isi.edu/in-notes/rfc1816.txt> (Aug. 1995).

³⁸ The arpa domain is used for all reverse IP lookups and is about to be expanded to include other infrastructure functions. See, e.g., P. Faltstrom, Internet Engineering Task Force, *E.164 Number and DNS draft-ietf-enum-e164-dns-03*, at <http://www.ietf.org/internet-drafts/draft-ietf-enum-e164-dns-03.txt> (Aug. 18, 2000) (proposing a method of using the DNS for storage of telephone numbers, relying on domain e164.arpa) (on file with author).

³⁹ For ICANN's description of the process see ICANN, *New TLD Program*, at <http://www.icann.org/tlds/> (last visited Mar. 27, 2002). For a more realistic view see JONATHAN WEINBERG, ICANN AS REGULATOR (forthcoming 2002).

⁴⁰ The Department of Commerce reserved this right in Cooperative Agreement No. NCR-9218742, Amendment 11, <http://www.ntia.doc.gov/ntiahome/domainname/-proposals/docnsi100698.htm> (Oct. 6, 1998).

were active,⁴¹ although they had not registered huge numbers of names.⁴²

The 244 ccTLDs are almost all derived from the International Organization for Standardization's ISO Standard 3166.⁴³ The ccTLDs sometimes have rules that make registration difficult or even next to impossible⁴⁴ or semantically unattractive; as a result, the gTLDs, especially .com, have the lion's share of the registrations. However, an increasing number of ccTLDs, such as .tv or .to, began acting as gTLDs and accepted registrations from anywhere, albeit at a price.

Domain names, or at least short ones,⁴⁵ are easy to use. But under the current system they must be unique, or DNS servers as currently designed will not know which IP address to return when confronted with a domain name.⁴⁶ As businesses stampeded onto the Internet in the late 1990s, they

⁴¹ See <http://www.icann.org/tlds/> (last visited Apr. 17, 2002).

⁴² Both .info and .name claim over 500,000 active names, see .info, *500,000 .INFO Registrations in Less Than 90 Days*, at http://www.nic.info/news/press_releases/pr_articles/2001-10-23-01 (Oct. 23, 2001); NeuLevel, *.Biz Exceeds a Half Million Registrations in First Month*, at http://www.nic.biz/press/press_release/pr_archive_2000_2001/2001.12.13.html (Dec. 13, 2001), but these numbers pale in comparison to the millions of registrations in .com.

⁴³ See ISO 3166-1:1997, Codes for the Representation of Names of Countries and Their Subdivisions—Part I: Country Codes, Deutsches Institut für Normung, at http://www.din.de/gremien/nas/nabd/iso3166ma/codlstp1/en_listpl.html (last modified June 12, 2001). The ISO, a private standards body, has created these codes for computer information systems processing purposes. It is not a treaty organization. See International Organization for Standardization, *Frequently Asked Questions*, at <http://www.iso.ch/info/faq.htm> (last modified Nov. 29, 1999).

Not every ccTLD is necessarily controlled by the government that has sovereignty over the territory associated with that country code, however. This is likely to be an area of increasing controversy, as (some) governments argue that the ccTLD associated with "their" two-letter ISO 3166 country code is somehow an appurtenance of sovereignty. See Berkman Center for Internet and Society, *Communiqué of the Government Advisory Committee*, at <http://cyber.law.harvard.edu/icann/santiago/archive/GAC-Communique-mtg3.html> (last modified Aug. 24, 1999) (asserting that "delegation of a ccTLD Registry is subject to the ultimate authority of the relevant public authority or government").

⁴⁴ Many ccTLDs have far more restrictive rules, including limits on the number of registrations per person or firm, the type of domain name available, and on its relationship to nationally protected intellectual property.

⁴⁵ *But see* <http://llanfairpwllgwyngyllgogerychwyrndrobwlllantysiliogogoch.com>, the domain name incorporating the name of the Welsh village, which is *not* easy to type.

⁴⁶ See Brian Carpenter, *IAB Technical Comment on the Unique DNS Root*, available at <http://www.iab.org/selected-iab-documents.html> (May 2000).

quickly came to view domain names as an important identifier, or even as a brand name. Once domain names were thought of as a brand, it quickly led businesses to the conclusion that trademarks might or should imply rights to corresponding domain names. Of course it is possible for multiple different parties to register the same second-level domain in different TLDs. Law.com, law.org, law.net, and law.tm all point to very different web sites. But especially before ccTLDs sensed a market opportunity and began accepting foreign registrations, the number of TLDs open to businesses in Europe and North America was small. And even as the number of options grew slightly, businesses were convinced that one piece of Internet real estate—.com—was the prime place to be.

Unfortunately for these businesses, registration of SLDs in the three existing gTLDs (.com, .org, and .net) and in the ccTLDs which emulate them, is on a first-come, first-served basis. No questions are asked about the proposed use, or about possible trademark conflicts. Registrants are asked only to identify themselves, give administrative and technical contacts,⁴⁷ and list two name servers prepared to resolve the domain name. Today, both ccTLDs and gTLDs require payment at the time of registration, but until July, 1999, the dominant gTLD registrar waited thirty days before sending a bill and then gave additional time to pay, thus creating a long float.⁴⁸ As there was no limit to the number of names a person could register, name speculators quickly understood that they could register names and seek buyers for them without risking any capital.⁴⁹ While some speculators sought common words with multiple possible uses, a few others—who became known as cybersquatters—registered thousands of names that corresponded to the trademarks of companies that had not yet found the Internet and then sought to resell (or, some would say, ransom) the name to those companies.

⁴⁷ All three can be the same person at the same address.

⁴⁸ See Todd Spangler, *NSI Adopts Prepayment Model*, ZDNET INTER@CTIVE WEEK ONLINE (July 22, 1999) (noting the change from the thirty-day policy to payment in advance), at <http://www.zdnet.com/intweek/stories/news/0,4164,2298737,00.htm>.

⁴⁹ For a survey of the law and equities of name speculation, see generally Jessica Litman, *The DNS Wars: Trademarks and the Internet Domain Name System*, 4 J. SMALL & EMERGING BUS. L. 149 (2000).

Because the Lanham Act requires commercial use before a court will find trademark infringement,⁵⁰ it seemed arguable that mere registration without use was legal, and that the brokers/cybersquatters had found a costless way to profit.⁵¹ Even persons who were engaged in organized large-scale cybersquatting, which became clear trademark infringement after *Panavision Int'l v. Toeppen*,⁵² could reasonably expect that the settlement value of their essentially meritless defenses to a claim of trademark infringement might run into thousands of dollars, since even a simple federal trademark action would cost that much or more in lawyers' fees and management time.

At the other extreme, some trademark holders suggested that ownership of a trademark in a word should confer a preemptive right on a corresponding domain name in .com, or perhaps in all TLDs with open registration. The absurdity of this position is demonstrated by the fact that given the sectoral and geographic nature of trademark law, it is common to find multiple holders of rights in the same word in the same place, not to mention the same country or planet. Attempting to shoehorn all the different firms called "acme" into one TLD, or even three, ensures that conflicts will arise between multiple owners of a trademark in the same string of characters. As Mr. Justice Neuberger stated, the owners may be

sectorally separate (same country, but different use or different category of goods and services), e.g., United Airlines and United Parcel Service may both want united.com; or

geographically separate (same business, but different countries or regions within a country), e.g., Joe's Pizza in the two college towns of your choice; or

both sectorally and geographically separate, e.g., Prince Tennis rackets and Prince consultants.⁵³

⁵⁰ 15 U.S.C. § 1114(1) (2001).

⁵¹ See Litman, *supra* note 49, at 154-55.

⁵² 141 F.3d 1316 (9th Cir. 1998) (holding that pattern of offering domain names for sale to mark holders was "use in commerce" of the mark sufficient to violate Lanham Act).

⁵³ *Prince plc v. Prince Sports Group, Inc.* [1998] F.S.R. 21 (Ch. Div.).

Not every string conflict, however, necessarily involves a claim of misuse of a domain and not all warehousing is necessarily a misuse. For example, firms sometimes acquire domains with the same name as a trademark they have registered even though they do not intend to use the domain. This warehousing prevents someone else from using the same name and potentially causing customer confusion.⁵⁴ Similarly, firms and others sometime acquire domains for future use. A firm may register a domain name before trademarking a term as part of the often-secret process of preparing a new product or campaign. These practices gave rise to the concern that without new gTLDs, large amounts of the namespace might become unavailable to new and even established users with new projects, a concern that later proved justified.

A. *The White Paper*

Faced with a first-come first-served domain name registration system in which those who were first wanted money from the latecomers, trademark owners and others naturally felt aggrieved, even extorted. Their distress blocked the addition of new TLDs, which they thought would aggravate their problems (although in fact it would have solved the shortage problem⁵⁵ at the price of aggravating the potential confusion and dilution problems), and got the attention of the White House and the Commerce Department's inter-agency task force charged with imposing some order on the increasing controversy over domain name policy.

In the White Paper that emerged from the convoluted U.S. government policy process—formally known as the U.S. Department of Commerce's *Statement of Policy on Management*

⁵⁴ It is interesting to note, however, that trademark law has a strong policy against the warehousing of names. If a name is not in actual use, or about to be used in a very short period, the trademark law offers no protection. See *La Société Anonyme des Pafums Le Galion v. Jean Patou, Inc.*, 495 F.2d 1265, 1274 (2d Cir. 1974) (holding that token, sporadic, or nominal use of a name intended only for trademark maintenance is insufficient to establish or maintain trademark rights).

⁵⁵ It might also have solved the cybersquatting problem, if foreseeable supply increased to the point where speculation seemed pointless.

of *Internet Names and Addresses*⁵⁶—the government took something of a middle-of-the-road position. It agreed that trademark owners were being victimized by so-called cyber-pirates who registered domain names to sell them to the corresponding trademark holder. But rather than proposing direct action, the White Paper called on WIPO to conduct a study and make recommendations for what would become ICANN. WIPO, it said, should:

[I]nitiate a balanced and transparent process, which includes the participation of trademark holders and members of the Internet community who are not trademark holders, to (1) develop recommendations for a uniform approach to resolving trademark/domain name disputes involving cyberpiracy (as opposed to conflicts between trademark holders with legitimate competing rights), (2) recommend a process for protecting famous trademarks in the generic top level domains, and (3) evaluate the effects, based on studies conducted by independent organizations, such as the National Research Council of the National Academy of Sciences, of adding new gTLDs and related dispute resolution procedures on trademark and intellectual property holders. These findings and recommendations could be submitted to the board of the new corporation⁵⁷ for its consideration in conjunction with its development of registry and registrar policy and the creation and introduction of new gTLDs.”⁵⁸

Thus, while certainly feeling the pain of the trademark owners, the White Paper also acknowledged the existence of countervailing legitimate rights. Notably, the White Paper's recommendations distinguished between, on the one hand, domain name disputes between two trademark holders which would not be covered by the proposed recommendations and, on the other hand, domain name disputes between a trademark holder and someone without a trademark, which would be the new system's sole focus.⁵⁹ This distinction was incorporated

⁵⁶ Management of Internet Names and Addresses, 63 FED. REG. 31,741 (June 10, 1998), available at http://www.ntia.doc.gov/ntiahome/domainname/6_5_98dns.htm [hereinafter White Paper].

⁵⁷ The Department of Commerce later recognized ICANN as this “new corporation.”

⁵⁸ White Paper, *supra* note 56, at 31,747.

⁵⁹ A similar distinction pre-dated the White Paper. NSI's draconian dispute policy “froze” (rendered inoperative) any domain name that was challenged by the holder of an identical trademark, regardless of the defenses that the registrant might offer—unless the registrant could produce a trademark of his own. This caused some

into WIPO's proposals and the UDRP itself. Perhaps because it punted the key question for later action, or perhaps because it was exquisitely ambiguous at key points, the White Paper came closer to being a consensus document than any other previous or subsequent policy pronouncement during the domain name wars.

B. *The WIPO Process*

The publication of the White Paper created an opportunity for WIPO to launch its Domain Name Process.⁶⁰ Rather than limit itself to the fairly modest project defined in the White Paper, however, WIPO chose to conduct its study on its own, more ambitious, terms. WIPO is an organ of the United Nations with specific duties defined by a series of treaties. Signatory nations send delegates to WIPO, and meet occasionally in plenary to make decisions. Being responsible to all its member states rather than just the United States, the WIPO staff felt empowered to define its own terms of reference, and proposed to make recommendations concerning: (1) dispute prevention; (2) dispute resolution; (3) a process to protect famous and well-known marks in the gTLDs; and (4) the effects on intellectual property rights of new gTLDs.⁶¹ Pleading the need for speed, and noting the wholly advisory nature of a report which would have to be sent to ICANN for any action, WIPO did not rely on a plenary to adopt its policy proposals. Indeed, WIPO limited the direct involvement of member states to the occasional status report and to opening its public

enterprising registrants to rush off and acquire Tunisian trademarks, which were apparently the quickest and cheapest in the world. NSI eventually stopped accepting Tunisian trademarks. See Sally M. Abel, *Trademark Issues in Cyberspace: the Brave New Frontier*, at http://www.fenwick.com/pub/ip_pubs/Trademark%20in%20Cyberspace%2098/Trademark%20issues.htm (July 21, 1998).

⁶⁰ On the flawed mechanics of the WIPO process, see generally Froomkin, *supra* note 4.

⁶¹ WIPO Request for Comments on Issues Addressed in the WIPO Internet Domain Name Process, RFC 2, at ¶ 12, at <http://wipo2.wipo.int/process1/rfc/2/-index.html>. The staff at WIPO were clearly eager to attack the domain name problem, indeed some suggested that WIPO had lobbied to be asked to undertake the study. In part this was, no doubt, because they saw it as an important issue. But there were other bureaucratic agendas operating at the same time, involving the relationship between the WIPO Secretariate and its member states, and regarding the status of the newly-launched but under utilized WIPO arbitration center.

consultation sessions to government speakers. WIPO's staff met with intellectual property stakeholders and a few others to acquire information and advice, and then basically drafted proposals on their own.

As part of its consultations leading up to the development of its recommendations,⁶² WIPO sought testimony about the extent of the domain name/trademark conflicts. Although this consultation exercise consumed a great deal of time and money,⁶³ the factual record produced by it was sparse. This was partly due to the relatively short time allowed. Nevertheless, it remains the case that neither WIPO nor any of the persons who testified before it sought to conduct or commission independent quantitative research on the extent of domain name "piracy." Although WIPO requested data from existing registration authorities, the testimony gathered by WIPO remained basically anecdotal.⁶⁴

The evidence submitted to WIPO or available from other sources suggested that domain name disputes involved only a tiny fraction of the number of domains registered in the open gTLDs (.com, .org., and .net). One measure of the problem was the number of times that trademark holders had invoked the NSI dispute policy.⁶⁵ Data provided by NSI, the monopoly

⁶² The records of WIPO's consultations are archived at <http://wipo2.wipo.int/-process1/consultations/index.html> (last visited Apr. 22, 2002).

⁶³ See Froomkin, *supra* note 4.

⁶⁴ See WIPO, RFC 3, Interim Report of the WIPO Internet Domain Name Process, ¶¶ 254-60, at <http://wipo2.wipo.int/process1/rfc/3/index.html> (Dec. 23, 1998) (providing a summary of some of the testimony) [hereinafter WIPO RFC 3]. WIPO relied heavily on a report produced by Marques, a trademark association. See WIPO Final Report, *supra* note 17, ¶ 313. This study suggested that the domain name problem was substantial, but it had a very small sample size, and there was some reason to doubt whether the companies surveyed were representative or likely to be particular targets.

⁶⁵ In order to minimize its exposure to suit, NSI crafted a dispute policy that strongly favored complaining trademark holders over its clients, the registrants. In brief, NSI would turn off ("freeze") a registrant's domain name upon request by a holder of a trademark in the same character string whose registration date preceded the domain name's registration unless the registrant also had a valid trademark in that character string. On the NSI dispute policies, see generally Carl Oppedahl, *Remedies in Domain Name Lawsuits: How is a Domain Name Like a Cow?*, 15 J. MARSHALL J. COMPUTER & INFO. L. 437 (1997) (critiquing the NSI dispute policy). The policy is obsolete, having been replaced by the UDRP, and is no longer on the NSI web site. It is, however, reproduced at a web site maintained by the Communications Media Center at New York Law School, <http://www.cmcnyls.edu/Misc/NSIDNRP3.HTM> (last visited Mar. 27, 2002).

registry, suggested that there were fewer than 1,000 complaints per year, and that the number of complaints had decreased by ten percent from 1997 to 1998, although the number of registrations had doubled to almost two million in the same period.⁶⁶ This measure suggested a dispute rate of under .045%; this number, however, both over- and understated the problem. It overstated the problem in that not every invocation of the NSI dispute procedure was necessarily meritorious. Conversely, it understated the problem in at least two ways. First, many disputes might never be reported to NSI, although complainants certainly had full incentive to avail themselves of it, given that the policy presumed that the registrant was guilty and froze the name unless the registrant could produce a trademark. Second, and potentially more serious, trademark holders argued that because NSI's policy only applied to domain names that were identical to trademarks, it failed to account for the large number of registrations of domain names that were confusingly similar to trademarks.

Indeed, the suggestion that the number of domain name disputes might have reached a plateau, or even peaked, was belied by some of the anecdotal evidence presented to WIPO. For example, witnesses testified that "typosquatters"—who were immune from the NSI policy since their registrations were not identical to a trademarked term—were counting on common misspellings to attract web traffic.⁶⁷ A representative

⁶⁶ According to Mr. Chuck Gomes of NSI on the IFWP mailing list,

During the slightly more than 5 months between the end of July 1995 and the end of the year, we invoked the [NSI Dispute] Policy 166 times. During 1996 we invoked the Policy 745 times. During 1997 we invoked the Policy 905 times. During 1998 we invoked the Policy 838 times.

Chuck Gomes, message dated Feb. 1, 1999 to IFWP Discussion List, list@ifwp.org, Subject: [ifwp] NSI Domain Name Dispute Stats., *reprinted in* Comments of Carl Oppedahl in Response to the WIPO Interim Report dated December 23, 1998 (WIPO RFC 3), note 4, at http://wipo2.wipo.int/dns_attachments/rfc3/attach9211911-40.html (Mar. 11, 1999).

⁶⁷ Motives for registering these "oops" names and creating web sites appeared to vary and included:

- I. Using the domains to host web sites that parody or criticize the individual (often a politician) or company;
- II. Taking advantage of the accidental traffic for relatively harmless commercial gain, e.g., to show the user an advertisement before redirecting the user to the site the user was probably looking for.

of AT&T, which had registered att.com, stated that they were getting complaints every week from customers offended by attt.com, a porn site.⁶⁸ There seemed no obvious way to derive a ratio that might be used to correct the .045% conflict rate suggested by the NSI dispute baseline. At one of the hearings, Sarah Deutsch, the senior intellectual property counsel at Bell Atlantic, and one of the most forceful and effective advocates for the case that trademark owners were being systematically victimized, stated that during a single year her office identified 784 domain names that it considered infringed one of Bell Atlantic's trademarks, but that only ten of these cases could be resolved through NSI's dispute resolution policy.⁶⁹ Using that approximately 80:1 ratio to inflate the NSI data suggested that of the 1.9 million new domain name registrations in 1999, about 67,000⁷⁰ allegedly infringed a trademark. While not in any way a trivial number, it was still only about 3.5% of all registrations. In any case, this estimate almost certainly overstated the size of the problem, since those who were most affected by the cybersquatters had the most incentive to participate in the WIPO process. Indeed, Bell Atlantic took a very aggressive (even unreasonable) view of what constituted a similarity to one of its marks.

Whether the actual magnitude of the overall "cyber-piracy" problem was .045% or 3.5% of new registrations, or more likely somewhere in between, and whether the problem was growing or shrinking in absolute terms, it clearly existed. There seemed to be no reason why people engaged in clear trademark infringement should enjoy a windfall of the settlement value of basically worthless defenses (although, of course, opinions varied as to how broadly this set of worthless defenses should be defined). It also seemed clear that an

III. Taking advantage of the traffic for commercial gain that would arguably tarnish the reputation of the company, usually pornography;

IV. Taking advantage of poor typists who were seeking a competitor's web site.

⁶⁸ In this case, however, the problem was solved well before the final WIPO report: the registration of attt.com was somehow transferred to AT&T, and the pornography vanished.

⁶⁹ WIPO, Second D.C. Consultation Transcript, at <http://wipo2.wipo.int/process/eng/dc2-transcript-toc.html> (last visited Mar. 27, 2002).

⁷⁰ The number is the 838 disputes reported by NSI in the most recent period, see *supra* note 66, inflated by the 80:1 ratio and rounded to two significant digits.

important fraction of the problem could be traced to a relatively small number of people. These “cyber-pirates” appeared to be engaged in systematic registration of domain names identical to trademarked terms. Trademark holders agreed that these cases represented a considerable percentage, albeit not all, of the problems they believed that they faced.⁷¹ The remainder was what might be termed amateur domain name speculation, in which individuals not engaged in the wholesale registration of domains containing trademarked character strings registered one or more domains that later excited the interest of trademark holders. In both cases the speculation was made easy by registration rules that did not require pre-payment.

Underlying the “cyber-pirate” question was the legal issue of whether registration of a domain name that is identical to a trademarked term was in and of itself a trademark violation. Generally speaking, in the United States at least, one does not violate a trademark right without commercial use (and, absent a finding that the mark is famous, likelihood of confusion). Therefore, unless registration is itself a commercial use, mere registration without use of a domain name cannot violate a trademark right. This is particularly clear in the case of trademarks of common words and in terms trademarked by more than one party. However, by the time of the WIPO process two courts, one in the United States and one in the United Kingdom, had held that a person who routinely registered others’ trademarks for potential resale was making commercial use of those trademarks and hence was an infringer.⁷² Thus, although there was inevitably little directly relevant decisional law, what little there was tended to support the proposition that registering a domain name for the purpose of resale amounted to trademark infringement.⁷³ Furthermore, the laws of other countries, although lacking actual decisions relating to domain names, did not necessarily require

⁷¹ WIPO also heard testimony that some firms were warehousing domain names corresponding to their trademarks in order to prevent their competitors from registering.

⁷² *Toeppen*, 141 F.3d at 1325-26; *British Telecomm. plc v. One in a Million Ltd.*, (C.A.) [1999] E.T.M.R. 61. (England).

⁷³ *Toeppen*, 141 F.3d 1316; *One in a Million Ltd.*, (C.A.) [1999] E.T.M.R. 61

commercial use as a prerequisite to finding a trademark violation.

The overwhelming majority of the reported cases that had actually gone to trial in the United States and elsewhere resulted in victory for a trademark holder over a non-trademark holder. Indeed, so far as one could tell, every organized cybersquatter who had been taken to court had lost.⁷⁴ Trademark owners, however, did not take great comfort from these facts. Instead, they argued that these victories simply proved the justice of their cause, and demonstrated why new means had to be found to prevent cybersquatters from holding them ransom for the settlement value of meritless defenses. Trials can be expensive, and trademark holders testified that they frequently found it cheaper or more expedient to offer out-of-court settlement to registrants of a domain names that they believed was theirs by right.⁷⁵

Notwithstanding the size of the individual settlements, firms managing large numbers of brands argued that the cumulative costs imposed an unfair burden and amounted to a windfall to the undeserving. Worse, aggrieved trademark holders in countries with dysfunctional court systems stated that their national court systems were so slow as to make the wait for meaningful relief against improper domain name registrations an eternity in Internet time, or even in ordinary time.⁷⁶ Other trademark holders complained of the difficulty of locating cybersquatters who falsified their contact information at the time of registration, or who were located in jurisdictions where the law was uncertain, the courts unreliable, or service was difficult.⁷⁷

Conversely, there was also evidence of attempted "reverse domain name hijacking" ("RDNH"). In these cases, trademark holders improperly threatened to sue the holders of domains that used the same string as their trademark even though the registrant was acting legally. A few of these cases involved commercial, but most involved non-commercial, uses

⁷⁴ *Toeppen*, 141 F.3d 1316; *One in a Million Ltd.*, (C.A.) [1999] E.T.M.R. 61; *Toys "R" Us, Inc. v. Abir*, 45 U.S.P.Q.2d 1944 (S.D.N.Y. 1997); *Green Prods. Co. v. Independence Corn By-Prods. Co.*, 992 F. Supp. 1070 (N.D. Iowa 1997).

⁷⁵ See, e.g., WIPO Final Report, *supra* note 17, ¶ 314.

⁷⁶ See, e.g., *id.* ¶ 148.

⁷⁷ *Id.* ¶¶ 59, 82, 148.

of the domain name; the key elements in making the would-be plaintiff drop the claim seem to have been bad publicity for the mark holder, combined with limited likelihood of success in the U.S. courts. Indeed, an appreciable but also unquantifiable fraction of the cases alleged by trademark holders to be infringements or amateur speculator cases in fact appeared to be cases where the registrant had at least a colorable, and perhaps a very legitimate, claim to the domain name. In some cases this arose from a competing trademark, and in other cases it arose from some other legitimate commercial or non-commercial purpose, use, or competing intellectual property right or name. The leading example of a non-trademark right was surely the “pokey” case in which the Prima Toy Company, owners of the Gumby and Pokey trademarks, threatened a twelve-year-old boy because of his personal web site at pokey.org. The web site had nothing to do with the toys, and had been registered by the boy’s father because “pokey” was his son’s nickname.⁷⁸ Other notorious examples included epix.com,⁷⁹ cds.com,⁸⁰ ajax.com,⁸¹ dci.com,⁸² ty.com,⁸³ roadrunner.com,⁸⁴ and veronica.org.⁸⁵

The trademark lawyers’ excessive zeal in policing their clients’ marks was almost inevitable given the trademark owners’ understandable fear that they must aggressively assert their rights to their marks in every medium or risk the diminution of their rights.⁸⁶ Even making allowances for a

⁷⁸ On pokey see *The Domain Name Handbook*, at <http://www.domainhandbook.com/dd2.html#pokey> (last visited Apr. 22, 2002) and the links collected there.

⁷⁹ *Interstellar Starship Servs., Ltd. v. Epix Inc.*, 184 F.3d 1107 (9th Cir. 1999).

⁸⁰ *CD Solutions, Inc. v. Tooker*, 15 F. Supp. 2d 986 (D.Or. 1998).

⁸¹ See <http://www.ajax.org>, *The Colgate-Palmolive Story*, at <http://www.ajax.org/colpal/> (on file with author).

⁸² *Data Concepts, Inc. v. Digital Consulting, Inc.*, 150 F.3d 620 (6th Cir. 1998).

⁸³ *Giocalone v. Network Solutions, Inc.*, 1996 WL 887734 (N.D. Cal., June 14, 1996).

⁸⁴ *Roadrunner Computer Sys., Inc. v. Network Solutions, Inc.*, Civil Action No. 96-413 (E.D. Va. complaint filed Mar. 26, 1996), available at <http://www.patents.com/nsicpt.sht>, dismissed (June 21, 1996).

⁸⁵ See Beth Lipton Krigel, CNET News, *Archie Comics Fights Parent for Domain* (Jan. 15, 1999), at <http://news.com/2100-1023-220240.html?tag=mainstry>.

⁸⁶ Without question, distinctiveness can be lost by failing to take action against infringers. If there are numerous products in the marketplace bearing the alleged mark, purchasers may learn to ignore the ‘mark’ as a source identification. When that occurs, the conduct of the former owner,

hair-trigger approach to the issuance of demand letters, some of these RDNH cases were remarkably clumsy PR, and, frankly, lacking in sense. Consumer advocates thus argued that any process that aimed to make bringing complaints against large-scale cybersquatters easier and less expensive also risked unleashing a flood of unmerited attempts to grab attractive names from unsophisticated and often unrepresented domain name registrants who held legitimate registrations.

C. WIPO's Final Report

Against this background, and after a considerable and involved process of its own,⁸⁷ WIPO issued its Final Report on April 30, 1999—a somewhat scaled back document from the maximalist intellectual property agenda set out in its earlier Interim Report.⁸⁸

WIPO stated that its design goal was to preserve “the right to litigate a domain name dispute.”⁸⁹ In addition to amassing and summarizing much of the available data on the contours of the cybersquatting problem, the Report contained a number of innovative suggestions which shaped the UDRP, ACPA (the US anti-cybersquatting legislation),⁹⁰ and indeed the entire domain name debate to this day. WIPO's most notable proposals, some of which echoed the White Paper, were:

- Leveraging ICANN's control over the DNS to impose contractual mandatory dispute resolution clauses on all registrants in the open gTLDs;

by failing to police its mark, can be said to have caused the mark to lose its significance as a mark.

Wallpaper Mfrs., Ltd. v. Crown Wallcovering Corp., 680 F.2d 755 (C.C.P.A. 1982).

⁸⁷ For a critique of the procedural aspects of WIPO's first domain name process, see Froomkin, *supra* note 4.

⁸⁸ Compare WIPO, RFC 3, *supra* note 64. I would like to think that my publication of a critical and dissenting report, A. Michael Froomkin, *A Critique of WIPO's RFC 3 available at*, <http://www.law.miami.edu/~amf/critique.pdf> (Mar. 14, 1999), may have had something to do with this outcome.

⁸⁹ WIPO Final Report, *supra* note 17, ¶ 148.

⁹⁰ ACPA, 15 U.S.C. §1114(2)(D) (2001).

- Limiting the scope of the proposed dispute-resolution process to disputes between a trademark holder and a non-trademark holder;
- Substantive rules to be followed in the dispute resolutions;
- A set of somewhat confused procedures to administer those dispute resolution processes;
- Proposing special pre-emptive protections for famous and well-known trademarks; and
- Basically ignoring the RDNH problem.

ICANN adopted each of these features of the WIPO proposal verbatim or with modifications, except for preemptive protection for famous and well-known marks, which ICANN rejected.⁹¹ Each accepted proposal is discussed below.

1. Leveraging the DNS

Undoubtedly, the most important suggestion in WIPO's Final Report was that ICANN leverage its control over the DNS to impose a contract of adhesion that created a world-wide third-party beneficiary right allowing aggrieved parties to invoke an arbitration-like procedure.⁹² ICANN's control over the DNS allows it to impose contractual terms on all domain name registrants because so long as the U.S. Department of Commerce delegates to ICANN the control over the "root file," ICANN has the power to determine which domain name registries are considered authoritative.

⁹¹ ICANN subsequently adopted peculiar "sunrise" provisions that gave all trademark holders preemptive registration rights in the .biz and .info TLDs, although there is no such cognate right at law. It also created a new, utterly undefined, parallel arbitration system called the CEDRP for some of the smaller, limited-registration, new gTLDs. See A. Michael Froomkin, *Another View of the .museum Contract*, ICANNWatch, at <http://www.icannwatch.org/article.php?sid=355>. (last visited Mar. 18, 2002).

⁹² See WIPO Final Report, *supra* note 17, ¶¶ 120-23, 158-62.

People who register Internet domain names do so in hopes that anyone in the worldwide network will be able to reach them. They may wish their websites to be visible around the world, or they may want to get e-mail or engage in two-way chats. Whatever the application, a domain name that cannot be resolved into an IP number by the vast majority of users is of very limited value on the Internet. Similarly, registrars selling domain name registrations understand that only domain names that “work” in the sense of being part of the global network carry much value. The ability to list a registration in a registry that is part of the “legacy” root is thus of paramount importance to a registrar. Furthermore, every registry knows that its database of domain-name-to-IP-mappings is of limited value if no one can find it. Registries thus need to be listed in the legacy root or they (and all the domains they list) become effectively invisible.

Only a listing in the legacy root currently provides visibility for a TLD and the domains listed in it. Control of the root creates powerful leverage, and WIPO's proposal, subsequently adopted by ICANN, took advantage of this technical reality to impose contractual conditions on registrants. What WIPO did not remark on was that the same technical features which ensured compliance with this contract of adhesion also undercut the legal justification for it: The standard policy argument in favor of enforcing adhesive contracts is that consumers have a choice in the marketplace and can always switch suppliers; if it happens that all the suppliers use the same term, this is considered to be evidence that the term is efficient or, at least, that there is insufficient consumer demand for an alternate term.⁹³ These justifications for enforcement do not fit well when the party offering the adhesive contract, the registrar, is doing so because of an adhesive contract it signed with the registry. If the justification for enforcing adhesive contracts turns on the fundamentally competitive nature of the market and the idea of sovereign consumers choosing among alternatives, then it makes little sense to apply it to a system in which ICANN requires that *all* suppliers (gTLD registries/registrars) force the *identical* terms

⁹³ Some courts in the United States consider online contracts of adhesion to be as enforceable as printed ones. See, e.g., *Hill v. Gateway 2000, Inc.*, 105 F.3d 1147 (7th Cir. 1997).

on *all* their customers. In this circumstance, unlike the ordinary contract of adhesion, one simply cannot sustain the legal fiction that the terms are or will be bargained-for (since the registrar cannot bargain on this issue, being contractually required to use the arbitration clause), nor can one argue that suppliers are even potentially subject to competition.

2. Scope

WIPO suggested limiting the proposed dispute-resolution process to disputes between a trademark holder and a registrant. WIPO had at one point explored a more encompassing proposal that would have included both non-trademark claims and even disputes between competing trademarks, but representatives of domain name holders objected as did many of the rights holders involved in the process.⁹⁴ Non-trademark holders were suspicious of the entire process and sought to make it as narrow as possible. Interestingly, many trademark holders also lacked sufficient faith in it to risk being on the defending end of the “administrative procedure,” preferring to ensure that they would only be complainants.

Similarly, both groups found common cause in their desire to make the dispute-resolution procedure non-binding. A substantial fraction of the trademark owners who testified, including representatives of some of the larger firms, stated that they were unwilling to waive their right to go to court in order to take advantage of the dispute resolution procedure, since they were certain they would win in court, even if at a price. Representatives of domain registrants participating in the WIPO process were both fewer in number and heterogeneous but they tended to have doubts about the fundamental fairness of the rules, the ability of WIPO to act as an honest broker, and the potential for selection bias by dispute resolution service providers who might tend to stack their arbitral panels with corporate and trademark lawyers untrained in and perhaps unsympathetic to the niceties of civil liberties law. As we will see, however, even though the dispute resolution was formally equally non-binding on both

⁹⁴ See WIPO Final Report, *supra* note 17, ¶¶ 159-60, 165.

complainants and defendants, as a practical matter plaintiff trademark owners were far more likely than a domain name registrant to benefit from a second bite at the apple.

Because they doubted the fundamental fairness of the process and the panels, registrants and their partisans were particularly anxious to limit the remedies available under the proposed procedure to transfer the domain name from registrant to complainant. Some trademark holders suggested that the arbitrators should have the power to award money damages, or at least attorneys' fees, but WIPO ultimately did not adopt this suggestion for two reasons. The primary reason was that WIPO concluded that the sums likely to be awarded in most cases would be small, and that it would be difficult to collect them especially if the registrant had provided false contact details.⁹⁵ A secondary reason may have been that if arbitrators were empowered to seek money damages then equity would require that they be entitled to levy charges against abusive filers, and the trademark bar would resist that. WIPO did, however, propose that while the complainant should have to pay the arbitrator's fees at the commencement of the process, the arbitrator could award fees and costs (other than attorneys' fees) to the victor.⁹⁶ This represented a substantial change from the more ambitious fee-shifting proposal in WIPO's interim report, which would have used the English Rule on attorney's fees,⁹⁷ but still presented a potential source of intimidation to registrants. Even if the arbitration costs were relatively modest, the prospect of having to pay \$1,000 or more might make some unwilling to take the risk required to protect a \$70 to \$100 investment.

An important consequence of limiting the scope of the proceeding to trade and service marks was that it excluded several types of cases. In the face of opposition to the trial balloon in the Interim Report, WIPO consciously, if reluctantly, excluded claims based on personal names, place names,

⁹⁵ WIPO Final Report, *supra* note 17, ¶ 226.

⁹⁶ WIPO Final Report, *supra* note 17, ¶ 226.

⁹⁷ See WIPO RFC 3, *supra* note 64, at ¶ 157 (referring to costs without specifying whether lawyer's fees are included among them).

International Nonproprietary Names (“INNs”) for Pharmaceutical Substances,⁹⁸ and names of international intergovernmental organizations. Personal names were excluded because national laws differed substantially as to the extent names and other rights of personality⁹⁹ are protected. WIPO was unable to craft a proposal consistent with its promise to remain consistent with national law.¹⁰⁰ A similar problem blocked protection of INNs and place names, to the great disgust of French wine makers whose appellations were protected under French law, and who sought similar protection for the corresponding domain names.¹⁰¹ In a subsequent report, however, WIPO did recommend the protection of INNs and country names.¹⁰²

3. “Administrative” Process

WIPO proposed an entirely online dispute resolution procedure.¹⁰³ The process aimed for high speed and low costs, and was to be the first business to consumer (“B2C”) online trans-national arbitration—or rather, near-arbitration. Briefing and decisions would take place online, without any face-to-face meetings of the parties or even the arbitrators.

The desire for speed and for minimum cost similarly militated against building an appeals process into the dispute resolution process. Here again, although opinions in both

⁹⁸ INNs are a naming system by which generic names for pharmaceutical substances are agreed and protected at an international level. While an inventor or patent-holder can acquire rights to a trade name for a substance, no one is allowed to establish intellectual property rights over the generic name. *See generally* WIPO, *supra* note 13, at ¶¶ 87-93.

⁹⁹ The “right of personality” is a controversial doctrine—not accepted by all states in the United States—by which some systems give persons, including politicians, actors, and other famous people, special rights over the use of their names. In some other countries the right includes elements of privacy, reputation, protection against defamation, and even “a right of informational self-determination,” i.e., a right exclusively to determine whether and to what extent others might be permitted to portray one’s life story in general, or certain events from one’s life. *See, e.g.*, Edward J. Eberle, *Human Dignity, Privacy, And Personality In German And American Constitutional Law*, 1997 UTAH L. REV. 963 (describing broad reach of these concepts in German law).

¹⁰⁰ *See* WIPO Final Report, *supra* note 17, ¶ 166.

¹⁰¹ *Id.* ¶ 167, n.134.

¹⁰² *See* WIPO, *supra* note 13.

¹⁰³ *See* WIPO Final Report, *supra* note 17, ¶¶ 215-20.

camps differed, the two sides generally found common cause. Trademark interests feared that adding an appeals process would provide opportunities for unscrupulous cybersquatters to create additional expense and delay. Some of the more suspicious registrants imagined that any appeals body could be stacked against them; many argued that the interests of individual registrants, who would tend to be less wealthy than trademark owners, were best served by minimal and least expensive procedures, especially if there was any danger that they might be assessed for costs.

One perhaps unintended—or perhaps intended¹⁰⁴—consequence of WIPO's proposal, was that although it was formally non-binding, some dispute resolution decisions might escape judicial review—especially those where the registrant lost. The process was formally “administrative” rather than a true arbitration. As a result it was unlikely to be subject to laws regarding the public duties of arbitrators, or to appeals under arbitration statutes such as the U.K. Arbitration Act.¹⁰⁵ Indeed, it was unclear whether in the United States, and perhaps in most other legal systems, a losing registrant would have a cause of action that a court could be persuaded to hear.

4. Substantive rules

Many observers had criticized WIPO's Interim Report for failing to define cybersquatting, and for proposing to give WIPO the ongoing power to make new substantive rules that the dispute resolution service providers would be required to apply. In contrast, the Final Report sought to provide a definition of cybersquatting, and gave more than lip service to the overriding principle that the dispute resolution procedure should, as much as possible, seek to apply the appropriate national law.

WIPO offered three clauses which together defined a domain name registration as “abusive”:

¹⁰⁴ I say perhaps intended because I personally warned of this problem on numerous occasions, but WIPO staff shrugged it off.

¹⁰⁵ See UK Arbitration Act 1996 at § 6(1) (limiting application to “an agreement to submit to arbitration present or future disputes”).

- (i) the domain name is identical or misleadingly similar to a trade or service mark in which the complainant has rights; **and**
- (ii) the holder of the domain name has no rights or legitimate interests in respect of the domain name; **and**
- (iii) the domain name has been registered and is used in bad faith.¹⁰⁶

Each of these three clauses raised interesting issues.

a. *Similarity*

The first clause ensured that only trade and service mark holders could bring complaints. It did not explicitly state that owners of common law marks should be able to bring actions under the proposed policy, but this was understood by participants in the drafting to be the intention.¹⁰⁷ This remained unchanged in the UDRP.

The first clause also broadened coverage from the NSI dispute policy's requirement that a domain name be "identical" to a mark, replacing it with a looser standard that included "misleadingly similar." This was not a bright line test. More fundamentally, the use of the "misleadingly similar" standard seemed likely to create rights for mark holders that they would not have had under U.S. trademark law. Indeed, the entire idea of trying to figure out whether a domain name registration was a per se violation of a trademark right seemed founded on a misconception. A domain name is not a trademark nor is it a good or a source identifier of a good. It is an address. Therefore, what determines whether the registrant of a domain name is infringing the rights of any mark holder, whether or not the mark is famous, is *how the domain name is being used*.¹⁰⁸ The issue therefore should not be whether the domain is the same as, close to, or even very close to a trademarked term, but

¹⁰⁶ WIPO Final Report, *supra* note 17, ¶ 171(1) (emphasis added).

¹⁰⁷ The WIPO proposal used the phrase "trade or service mark in which the complainant has rights"; since one of the ways in which a person acquires rights to a trademark in the United States and in other common law countries is by use without registration, it followed naturally that so-called common law marks were covered. As an international body, WIPO was in any case sensitive to claims that it might be favoring rights acquired in one legal system as opposed to another.

¹⁰⁸ See, e.g., *Toeppen*, 141 F.3d at 1325-26 (noting requirement of *commercial* use for ordinary infringement claim); *Avery Dennison Corp. v. Sumpton*, 189 F.3d 868, 877-78 (9th Cir. 1999) (noting relevance of use to dilution claim).

rather whether the name plus the uses for that name cause confusion or even dilute the mark.¹⁰⁹ The word “shall” is not misleadingly similar to “shell,” but it might be infringing if used on a gas station. But that argument did not prevail before WIPO, or indeed before ICANN.

As those of us on WIPO's advisory Panel of Experts understood it at the time, the “misleadingly similar” test would have included many if not all “typosquatters” as well as sites that used a zero instead of an “o.” Thus, for example, the then-notorious Microsoft parody site, *micros0ft.com*, would have been “misleadingly similar” to the software company's trademark, but nevertheless would have been permitted under the UDRP unless the software company could have shown that “the domain name has been registered and is used in bad faith.” And, as we understood, Microsoft could not have made that showing because non-commercial parody is not a “bad faith” use but is in fact quite legal (at least in the United States).¹¹⁰

Some submissions to WIPO had proposed that every domain name which included a sub-string identical to a

¹⁰⁹ Infringement can be based upon confusion that creates initial customer interest, even though no actual sale is finally completed as a result of the confusion. 3 THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23:6 (1996). In regards to domain names, so-called “initial interest confusion” is said to happen when a user who was in search of one site is drawn to another site, because the domain name is either the same or substantially similar to a trademark. The user quickly, perhaps immediately, discovers that the site accessed is not the one intended, but may decide to use the site accessed anyway. See generally Bryce J. Maynard, Note, *The Initial Interest Confusion Doctrine and Trademark Infringement on the Internet*, 57 WASH. & LEE L. REV. 1303 (2000). For a court that accepts the theory to find that “initial interest confusion” caused a dilution of a trademark, however, would require more than a domain name that resembled a trademark. Courts typically require that the site be put to a commercial use, offering the same or similar products or services as the trademark owner, or that the site will likely confuse the user into the belief that it is affiliated with the trademark holder. See *TCPIP Holding Co., Inc. v. Haar Communications, Inc.*, 244 F.3d 88 (2d Cir. 2001) (enjoining use of some allegedly infringing domain names but allowing defendant to continue to use others); *Trans Union LLC v. Credit Research, Inc.*, 142 F. Supp. 2d 1029 (N.D. Ill. 2001) (motion for preliminary injunction between companies that offer similar services court granted for “transunioncredit” domain name and denied for credit “creditbureautransunion”).

¹¹⁰ See, e.g., *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ'g Group, Inc.*, 886 F.2d 490 (2d Cir. 1989); *Mattel v. MCA*, 28 F. Supp. 2d 1120 (C.D. Cal. 1998); cf. *Hustler Magazine v. Falwell*, 485 U.S. 46 (1988) (stating that First Amendment considerations should generally outweigh consideration of tort of intentional infliction of emotional distress); but see *People for Ethical Treatment of Animals v. Doughney*, 263 F.3d 359 (4th Cir. 2001).

trademark should be subject to challenge for cause. However, it was clear to all participants that this was a non-starter, since short names appeared in vastly different longer names. It also seemed to be the clear understanding at the time that criticism websites, such as *companysucks.com*, could not possibly be “misleadingly similar” to a mark in “company” and that such sites would be outside the policy,¹¹¹ although a criticism website’s use of intellectual property on a web page would remain subject to the ordinary constraints of trademark, copyright, unfair competition, and trade dress protections.

b. “*Rights or Legitimate Interests*”

The second clause in WIPO’s definition of an “abusive registration” was superficially simple. In stating that a complainant could prevail only if a registrant had “no rights or legitimate interests in respect of the domain name” it seemed to me that the policy was importing a large number of traditional concepts in a way that outside observers sometimes seemed to miss. I believe that these few words imported traditional choice of law principles to the dispute resolution procedure. In so doing, they also imported laws protecting fair use and free expression when these were part of the applicable law. The consequence of this would be that people in countries with strong protection for freedom of expression would have greater protection in the WIPO alternative dispute resolution (“ADR”) than would people from, for example, North Korea. Although the same case might have different outcomes depending on the residence of the parties, this would be consistent with WIPO’s expressed goal of reflecting rather than overriding existing law.

¹¹¹ This seemingly obvious point is lost a surprising number of arbitrators today. See *infra* notes 172-76 and accompanying text. Contrary to the understanding of participants in the WIPO process, who assumed that non-commercial “sucks” sites would be protected, some arbitrators have come up with creative grounds under which *all* sucks sites are presumptively in violation of the UDRP. The *Vivendi Universal* case is a leading example of this twist: there the majority opined that because not all “members of the public in general and ‘Internauts’ in particular” speak English, a non-native speaker might mistakenly believe that *vivendiuniversalsucks.com* was connected to Vivendi Universal. *Vivendi Universal v. Sallen and GO247.COM, INC.*, Case No. D2001-1121, (WIPO Dec. 7, 2001), <http://arbitrator.wipo.int/domains/decisions/html/2001/d2001-1121.html>.

The choice of law issue had been very controversial in the wake of WIPO's Interim Report. The Interim Report's guiding principles had, in my view at least, sought to allow dispute resolution panels far too much leeway to make up whatever law they thought should apply to a given situation.¹¹²

There was no sign of the "guiding principles" in WIPO's Final Report. The Final Report sounded something of a welcome retreat on this issue:

In applying the definition of abusive registration . . . in the administrative procedure, the panel of decision-makers appointed in the procedure shall, to the extent necessary, make reference to the law or rules of law that it determines to be applicable in view of the circumstances of the case. Thus, for example, if the parties to the procedure were resident in one country, the domain name was registered through a registrar in that country and the evidence of the bad faith registration and use of the domain name related to activity in the same country, it would be appropriate for the decision-maker to refer to the law of the country concerned in applying the definition.¹¹³

Although not as transparent as it might have been, this was a fairly clear invitation to the arbitrators to use traditional choice of law principles—without which, I thought, the policy would invite massive forum shopping.

Unfortunately, and in what was something of a pattern,¹¹⁴ WIPO's Final Report was clearer in its main text than in the operative part, Annex IV, which contained the actual text of WIPO's proposed policy. It may not have been a coincidence that the members of the WIPO staff who drafted the Final Report and Annexes chose to share the draft report text with the advisory Panel of Experts of which I was a member, but never showed us the Annexes before finalizing them. Thus, Annex IV, the proposed policy document, phrased

¹¹² The Interim Report set out fairly arbitrary "guiding principles," drafted by WIPO, which would have applied to all cases regardless of the nationality of the parties, and would have trumped national law. See WIPO RFC 3, *supra* note 64, ¶¶ 199-200.

WIPO also proposed that these "principles" should be "subject to regular review and appropriate adjustment over time, on the basis of experience gained in the administrative dispute-resolution system," with the clear implication that WIPO itself would do the "adjustment." *Id.* at ¶ 200.

¹¹³ WIPO Final Report, *supra* note 17, ¶ 176.

¹¹⁴ See Froomkin, *supra* note 4.

the choice of law term much less clearly by stating: “To the extent that the Panel makes reference to any applicable law to reach a determination, it shall apply the law or rules of law that it determines to be appropriate in light of all the relevant circumstances.”¹¹⁵ This language risked inviting the arbitrators to make their own determination as to what law would be best, rather than attempting to replicate what a court of competent jurisdiction would do. And, indeed, some arbitrators have held that the exercise of First Amendment rights cannot be asserted to show an absence of bad faith.¹¹⁶

The choice of law issue is especially important because choice of law in effect determines what constitutes “rights and legitimate interests”¹¹⁷—the defenses to a claim of “abusive registration.” Rights and legitimate interests are creatures of law and custom. Solicitude for the rights of free expression of citizens differs considerably around the globe, and choice of law thus was likely to be significant in a multi-jurisdictional case. The legal interests one may have in a name differ from country to country.¹¹⁸ Which law and which customs apply may be a complex question if a party from South Korea registers a domain with a registrar in Japan that deposits the data in a registry located in the United States, only to have a Brazilian claim that the registration infringes a trademark. Many had argued, with some justification, that the WIPO’s Interim Report failed to protect fundamental free-speech interests including parody and criticism of famous persons and corporations. So long as it was understood that these expressive activities were “rights and legitimate interests” in a registration—and the choice of law provision of the Final Report text, if not necessarily the Annex, seemed to make that

¹¹⁵ WIPO Final Report, *supra* note 17, at Annex IV, 4.

¹¹⁶ See, e.g., *Kelson Physician Partners, Inc. v. Mason*, No. CPR003, <http://www.cpradr.org/ICANNDecisionCPR003-000905.htm> (July 24, 2000) (“deciding a First Amendment Constitutional issue is outside the scope of this arbitration”); *Home Props. v. SMS Online*, FA0009000095639 (NAF Nov. 2, 2000), <http://www.arbforum.com/domains/decisions/95639.htm> (“Deciding a First Amendment Constitutional issue is outside the scope of this proceeding”). *The Regents of the Univ. of New Mexico vs. Am. Info. Servs.*, FA0002000094306 (NAF Apr. 26, 2000), <http://www.arbforum.com/domains/decisions/94306.htm> (“First and Eleventh Amendment Constitutional issues are not within the scope of this arbitration.”).

¹¹⁷ The test set out in WIPO Final Report, *supra* note 17, ¶ 171(1)(ii).

¹¹⁸ Countries differ, for example, in the latitude given to startup companies and the nature of interests one can have in ones’ own name.

clear—then the Final Report appeared to me to be a substantial improvement over its predecessor. However, although the UDRP uses similar language, the subtlety of the choice of law issue has either been lost on some arbitrators, or they have chosen to avert their eyes from it. Perhaps the arbitrators have concluded that “UDRP law” should, after all, be some free-standing body of rules deracinated from any legislature and made up largely by trademark lawyers.

Indeed, a number of arbitrators clearly believe that the “rights and legitimate interests” language invokes some free-standing *sui generis* UDRP-specific set of considerations. The arguments that tend to be deployed in support of this view are, I believe, misguided.

First, some argue that the point of the UDRP is to differ from local law. As noted above, this was indeed WIPO’s goal in its Interim Report, but was abandoned by the Final Report. The UDRP does differ from local law in that it covers only a subset of the matters that would constitute trademark infringement, but this underscores the importance of fully representing the local ideas of a defendant’s rights and privileges in the process.

A more persuasive argument rests on administrative necessity. It is claimed with some justification that panelists cannot be experts on the laws of all the jurisdictions relevant to cases they may hear. Short submissions, some of which will be *pro se*, cannot possibly hope to tell panelists all they would need to know. As a result, panelists—whether they want to or not—must rely on a fairly uniform understanding of free speech and other rights. While it has the force of practicality, I do not agree with this argument. There is a substantial difference of opinion around the world as to where to strike the balance between trademark rights on the one hand, and fair use and free speech on the other. Nations vary enormously, for example, as to whether they allow a competitor’s marks to be used in comparative advertising. If German law forbids this use, there seems no reason why the UDRP should necessarily be closed to a German mark-holder proceeding against a German defendant just because the United States allows the use of such marks in comparative advertising.

Even if the argument for administrative necessity is fundamentally practical, it can also be defeated by the practical observation that, were arbitrators left to create their own idea of a common default set of defendant “rights and legitimate interests,” current practice suggests that they would end up with something considerably more constrained than what current United States law allows. Nor could this problem be solved by inviting UDRP re-drafters to produce an authoritative list of defendants’ rights. The drafters have no authority to do this. Plus, as the drafting project will be international, it will at best result in a compromise that gives some parties more defenses than their legislators chose, and gives other parties less. Neither result could be justified, given the summary nature of the UDRP, especially not the failure to recognize legitimate rights.

c. *Bad Faith*

Probably the most critical issue was the definition of “bad faith” in the third clause of the definition constituting an abusive domain name registration. WIPO stated that “the following, in particular, shall be evidence of the registration and use of a domain name in bad faith”:

- (a) an offer to sell, rent or otherwise transfer the domain name to the owner of the trade or service mark, or to a competitor of the owner of the trade or service mark, for valuable consideration; **or**
- (b) an attempt to attract, for financial gain, Internet users to the domain name holder’s website or other on-line location, by creating confusion with the trade or service mark of the complainant; **or**
- (c) the registration of the domain name in order to prevent the owner of the trade or service mark from reflecting the mark in a corresponding domain name, provided that a pattern of such conduct has been established on the part of the domain name holder; **or**
- (d) the registration of the domain name in order to disrupt the business of a competitor.¹¹⁹

¹¹⁹ WIPO Final Report, *supra* note 17, ¶ 171(2) (emphasis added).

However, the Final Report also cautioned that,

[T]he behavior of innocent or good faith domain name registrants is not to be considered abusive. For example, a small business that had registered a domain name could show, through business plans, correspondence, reports, or other forms of evidence, that it had a bona fide intention to use the name in good faith. Domain name registrations that are justified by legitimate free speech rights or by legitimate non-commercial considerations would likewise not be considered to be abusive.¹²⁰

Following the pattern in which the operative part of the Final Report was more pro-mark-owning complainant than the Report itself, this caution—which appeared in ¶ 172 of the Final Report immediately following the definition of cybersquatting—was omitted from Annex IV, leaving some doubt as to how seriously WIPO intended to encourage arbitrators to find for defendants.

WIPO's four categories of bad faith registration were non-exclusive, which invited arbitrators to expand the list. Each of the four responded to a category of grievance expressed by mark holders, yet each also raised questions of its own.

(i) Offers to Sell

The first category, “an offer to sell, rent or otherwise transfer the domain name to the owner of the trade or service mark, or to a competitor of the owner of the trade or service mark, for valuable consideration,” appeared to be the most straightforward, as it simply reflected the *Toeppen*¹²¹ and *One In A Million*¹²² facts. In both cases, the offer to sell the domain name to the trademark holder constituted commercial use. Even here, however, there were ambiguities. The greatest ambiguity was that not all offers to sell domain names for which the intellectual property rights are legitimately disputed are evidence of bad faith on the part of the registrant. For example, it is hard to see how it could be bad faith to respond

¹²⁰ *Id.* ¶ 172.

¹²¹ *Toeppen*, 141 F.3d at 1325.

¹²² *British Telecomm. plc v. One in a Million Ltd* [1999] F.S.R. 1, (Court of Appeal, England) (July 23, 1998), available at <http://www.nic.uk/news/legal/oiam-appeal-judgement.html>.

to a solicitation of a bid unless one was in the business of registering masses of domain names and waiting for bids. Or, if the parties are enmeshed in a dispute, an offer to sell may be a legitimate part of a search for settlement. Indeed, in some legal systems “without prejudice” offers in the context of a dispute are protected from disclosure to a tribunal by rule of court.¹²³ The ambiguity regarding offers to sell persisted into the UDRP and caused problems: Some arbitrators appear to believe that “without prejudice” letters—which are inadmissible evidence in England—“should” be admitted in UDRP proceedings.¹²⁴ If the parties are strangers, it would be perverse to have a rule that would allow a wily mark holder to entrap a naive registrant by asking whether the domain was for sale. The seemingly absolute wording of WIPO’s first category, echoed in the UDRP, nonetheless appears to create just such a trap for the unwary.

(ii) Commercial Confusion

WIPO’s second category targeted “an attempt to attract, for financial gain, Internet users to the domain name holder’s website or other online location, by creating confusion with the trade or service mark of the complainant” as an indicia of bad faith. Since this closely tracked the test in the Lanham Act and other similar statutes in Paris Convention states,¹²⁵ and it required commercial activity, in one sense it was the least controversial category.

¹²³ *E.g.*, FED. R. EVID. 408; UK, Civil Procedure (White Book), c.36.19 (1999).

¹²⁴ *See, e.g.*, Spirit Airlines Inc v. Spirit Airlines Pty Ltd, Case No. D2001-0748, (WIPO July 25, 2001), <http://arbiter.wipo.int/domains/decisions/html/2001/d2001-0748-.html>.

¹²⁵ Lanham Act § 32, codified at 15 U.S.C. § 1114(1)(a) (providing remedies for use of registered mark in commerce, without consent of the registrant, when “the use is likely to cause confusion”); *see also* Paris Convention for the Protection of Industrial Property Article 6bis, July 14, 1967, 21 U.S.T. 1583, 823 U.N.T.S. 305 (requiring signatory states “to refuse or to cancel the registration, and to prohibit the use, of a trademark which constitutes a reproduction, an imitation, or a translation, liable to create confusion” of a well-known mark).

(iii) Repeat Players

WIPO's third category took aim at "the registration of the domain name in order to prevent the owner of the trade or service mark from reflecting the mark in a corresponding domain name, provided that a pattern of such conduct has been established on the part of the domain name holder." Here again, WIPO was reacting to the *Toeppen* facts, and the worries of mark holders. Mark holders had argued that the wiliest cybersquatters would react to WIPO's first category, offers to sell, by adopting a studied passivity and simply waiting for the mark holders to make an offer. This third category was primarily aimed at heading off that eventuality.

(iv) Unfair Competition

WIPO's fourth category was not strictly concerned with a trademark violation, but was instead directed at a rarified form of unfair competition. Any firm that registered a competitor's name as a domain and set up a website that sought to capture the competitor's customers would fall under the second and perhaps the third of WIPO's categories. Why, then, should there be an additional clause to prevent "[t]he registration of the domain name in order to disrupt the business of a competitor"? Some mark holders feared that a firm which was first in its industry to understand the Internet's importance might warehouse its competitors' names to deny them the use of their mark as a domain. Since the name was being warehoused, rather than used, there would be no use, much less commercial confusion. And since there was no chance that the name would be offered for sale, the first WIPO category would not apply either. This fourth category closed that loophole. One might have questioned the inclusion of a non-trademark issue in a process ostensibly designed to protect trademark rights. Since, however, this sort of sly, even malicious, warehousing appeared to be a form of unfair competition that was likely to be prohibited worldwide, I though there was no harm in including this category—and the people who thought it necessary wanted it badly.¹²⁶

¹²⁶ At the time we referred to this as the kaplan.com problem, being under the

5. Meta questions

The WIPO proposal left several major issues either unanswered or answered implicitly. One such issue was who carried the burden of proof. Although complainants usually have the burden of proof, and in the absence of anything to the contrary, it seems plausible to assume that WIPO intended this to be the case,¹²⁷ one might nevertheless have wished that WIPO had spelled it out.

A related and more difficult question was whether the complainant would be required to affirmatively allege each of the three elements of an abusive registration, and in particular whether the complainant would have to affirmatively allege and prove that the registrant had no legitimate rights or interests in the name at issue. It is easy to allege a negative, but hard to prove it. In the U.S. system one might deal with this situation by having the allegation shift the burden of production to the respondent while leaving the ultimate burden of persuasion on the complainant. This type of procedural differentiation is, however, not universally practiced, and seemed ill-suited for a transnational procedure. The uncertainty as to this issue persists into the UDRP, and has resulted in inconsistent practice between cases.

An even more difficult question was whether the complainant would meet his burden of proof of bad faith by simply making allegations in a complaint or, if not, what sort of supporting evidence would or should be required. It was unclear how little would suffice to meet the complainant's burden in a default judgment, and how much would be enough to overcome the registrant's bare denial in a contested matter. Similarly, it was unclear what type of evidence might suffice to rebut an allegation. Again, the UDRP suffers from similar

impression that the Princeton Review had warehoused the kaplan.com domain. In fact, it appears that Princeton Review actually made use of it to advertise itself and to disparage Kaplan Education Centers. See RONY & RONY, *supra* note 26, § 8.1 (discussing dispute between Kaplan Educational Center, Ltd. and Princeton Review Management Corp).

¹²⁷ Indeed, given that WIPO's proposal for a special right for famous marks suggested that the owner of a mark that WIPO certified as globally famous would be entitled to an "evidentiary presumption" that places a "burden of justifying the registration" on the registrant, WIPO Final Report, *supra* note 17, ¶ 291, no other conclusion seemed possible regarding the ordinary case.

uncertainties and this has led to inconsistent results in practice. WIPO also made no attempt to address how an arbitrator assesses credibility in an entirely online proceeding where each side only gets to submit one short pleading; the UDRP is equally agnostic.

6. The RDNH Problem

WIPO's Interim Report had set out proposals that would have invited a flood of reverse domain name hijacking. Chief among these was a cost-shifting proposal that could potentially subject a registrant to fees many times the value of the original registration. The Final Report retained a considerably limited version of the cost-shifting, thus reducing but not eliminating the danger that parties with legitimate registrations, especially unsophisticated and unrepresented parties, could be intimidated into surrendering them for fear of losing. As WIPO's prime concern was the protection of trademarks, not protection against trademark abuse, it made no recommendations to address this problem.

7. Deeply Flawed Procedures

Many of the ideas and proposals in the Final Report grew out of the Interim Report. One set of wholly new proposals, however, which had never been submitted for public comment or even discussed with WIPO's own advisory panel, surfaced at the last moment in what became Annex V.¹²⁸ This document set out proposed procedures for the dispute resolution process. These procedures were, quite simply, unjust. Regrettably, as we shall see, some of these unjust features were included in the UDRP.

WIPO's proposed procedures imposed several unfair time limits on registrants and invited various forms of abuse. Under WIPO's proposal, the date of commencement of a proceeding would be the date that complaint is received by the *Dispute Resolution Service Provider*, not the date that the registrant has actual (or even constructive) notice of the

¹²⁸ WIPO Final Report, *supra* note 17, at Annex V.

complaint. The respondent's ten days to reply would thus begin to run before he was even notified of the action.¹²⁹ This method of computing time violated established notions of due process, and was contrary to civil practice throughout the civilized world.

Admittedly, there were genuine and difficult issues regarding what constitutes sufficient notice in an online proceeding. Given the different ways in which e-mail could be used, WIPO nonetheless proposed the most unfair and easily-abused rule available: e-mailed notice by the Dispute Resolution Service Provider to the registrant. Time starts to run when this notice is e-mailed, not when it is read: "a notice or other communication shall be deemed to have been received on the day it is delivered or, in the case of telecommunications or Internet modalities, transmitted."¹³⁰ Nothing in the rules required that the complainant make any effort to contact the registrant prior to filing the request for arbitration. Registrants might have no reason at all to expect to be subject to an arbitration, and would not be on notice that they should check their e-mail.

Thus, under WIPO's procedures, anyone who failed to check his e-mail for ten days could lose by default. The ten-day period to reply was in any event ridiculously short. A complainant would have as much time as he wishes to prepare a complaint, but in the ten days allotted to the registrant, the registrant would not only have to receive the notice, but prepare his entire defense. For a person who may be an unrepresented consumer, with no familiarity with the relevant arbitral or legal rules, this is not a very long time. And yet, in that period WIPO expected him to:

- (1) Decide whether to seek representation;
- (2) Write and submit his sole statement in his defense;¹³¹
- (3) Collect and submit any relevant documents and a schedule of such documents;¹³² and

¹²⁹ *Id.* at Annex V, § 8.

¹³⁰ *Id.* at Annex V, art. 3(c).

¹³¹ *Id.* at Annex V, art. 8.

¹³² *Id.* at Annex V, art. 8.

- (4) Have the defense, and possibly the documents translated into the language of the ADR procedure, which will ordinarily be the language of the registration agreement.¹³³

Ten days (minus the time it takes to get actual notice!) is simply inadequate, especially in the absence of any warning that the ADR is imminent. Unfortunately, ICANN's version of the procedures adopted to accompany the UDRP did only a little to ameliorate this serious problem.

II. ICANN's UDRP

After WIPO forwarded its Final Report to ICANN, that body began its own complex process to consider whether to adopt it.¹³⁴ ICANN did not incorporate WIPO's proposals regarding preferential WIPO-administered treatment of a new special class of globally famous names into the UDRP,¹³⁵ but ICANN adopted the bulk of WIPO's other proposals, albeit with some amendments.¹³⁶ ICANN adopted in principle its UDRP and the accompanying UDRP Rules, in August 26, 1999, but wrangles over details of the implementing language delayed the final documents until October 24, 1999.

ICANN had already relied on its de facto control over which registries are in the root to demand that the monopoly registry, and all registrars, sign contracts with it. ICANN's agreement with NSI requires that registry to only accept registrations from registrars who have accepted ICANN's standard form Registrar Agreement.¹³⁷ This ensures that any

¹³³ WIPO Final Report, *supra* note 17, at Annex V, Art 22.

¹³⁴ As the White Paper instructed ICANN to do something about cyber-squatting, see *supra* text accompanying note 58, it seemed a somewhat forgone conclusion that ICANN would in fact "do something" about the issue. And so it proved.

¹³⁵ ICANN later did incorporate a broadened "sunrise" protection for trademark owners in the roll-out of new gTLDs. See *supra* note 91.

¹³⁶ In fact, at the instigation of its Vice President and General Counsel, Louis Touton, ICANN threw out the work product of its internal deliberative committee, Working Group A, and substituted a draft written in secret by a lawyer hired by a group of registrars. See A. Michael Froomkin & Mark Lemley, *ICANN and Anti-Trust*, available at <http://personal.law.miami.edu/~froomkin/articles/-icann-antitrust.pdf> (forthcoming 2002).

¹³⁷ See ICANN, *ICANN-NSI Registry Agreement*, available at

registrar who hopes to sell registrations in the legacy root will comply with ICANN's requirement that registrars impose the UDRP on their customers.¹³⁸

An analysis of the key substantive parts of the UDRP follows in Part II.A. There were reasons to doubt whether ICANN had complied with its own rules in enacting the UDRP,¹³⁹ but on the whole the substantive product seemed to be an improvement over WIPO's proposals—if only because of the rejection of WIPO's proposals regarding globally famous trademarks. Unfortunately, as discussed in Part II.B, the procedures accompanying the UDRP were seriously flawed in design. Some of these flaws, notably the lack of parity as to the parties' ability to get a court to hear their dispute if the UDRP goes against them, had originated in WIPO's last-minute proposals,¹⁴⁰ while others were introduced in the UDRP itself.

One important additional source of difficulty for the

<http://www.icann.org/nsi/nsi-registry-agreement-04nov99.htm> (Nov. 4, 1999). ICANN has also imposed similar requirements on the registries for the seven new TLDs it recently approved.

¹³⁸ ICANN, *Registrar Accreditation Agreement*, available at <http://www.icann.org/nsi/icann-raa-04nov99.htm> § II.K (last visited Dec. 5, 2001).

¹³⁹ See A. Michael Froomkin, *A Catalog of Critical Process Failures; Progress on Substance; More Work Needed*, available at <http://www.law.miami.edu/~amf/icann-udp.htm> (Oct. 13, 1999). In order to be validly adopted, the UDRP would have had to be discussed by a working group composed of representatives of each of ICANN's seven domain name supporting organization ("DNSO") constituencies. In fact, the working group lacked this representation and, contrary to a policy that anyone could join a working group, the chair—a Canadian trademark lawyer—excluded certain opponents of WIPO's policies (including me) from voting membership. In order to further dilute opposition in a group dominated by trademark lawyers, he divided the group into subcommittees, and prohibited people from serving on more than one. By excluding and marginalizing opponents, and doing most of the drafting himself at the last moment, the chair was able to claim a rough consensus for his work.

The next step in the ICANN process required the DNSO Names Council to assess whether there was a consensus in favor of the Working Group's proposal. It did no such thing, perhaps because this risked finding an answer it would not like. Instead, the Names Council forwarded the Working Group report to the ICANN Board for action, appending its own substantive comments.

Faced with screams of outrage by non-trademark groups, the ICANN Board accepted the UDRP in principle, but instructed its staff to consider drafting changes to key elements. The staff, in the person of counsel Louis Touton, convened a "small drafting committee" of U.S.-trained lawyers to advise it, composed of representatives of the warring factions. I was eventually added to this group. When the group was unable to agree, rather than reporting a lack of community consensus, Mr. Touton simply decided matters on his own.

¹⁴⁰ See *supra* text following note 128 (discussing last-minute addition of Annexes containing procedural provisions of WIPO's proposals).

UDRP stems from ICANN's decision to allow the complainant to choose among ADR service providers accredited by ICANN. While this policy potentially has the healthy effect of promoting price competition, there is suggestive if not conclusive evidence that it may have promoted pernicious non-price competition also. Dispute providers have an incentive to encourage complainants to vote with their checkbooks, by competing to appear the most "plaintiff friendly" provider.¹⁴¹

A. *Criteria for Transfer*

The critical substantive part of the UDRP is the definition of grounds for the transfer of a domain name from a registrant to a complainant. Although based on WIPO's proposals, the UDRP contained a substantial number of substantive changes. Changes to the grounds for a transfer generally benefitted mark holders, the potential complainants. The specification of affirmative defenses had mixed results. Conversely, the removal of WIPO's fee-shifting proposal, and especially the attempt to address the problem of asymmetrical access to judicial review, worked to help registrants.

1. Definition of Offense

According to the UDRP, to secure a name transfer a complainant must prove each of these three elements:¹⁴²

- (i) your domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
- (ii) you have no rights or legitimate interests in respect of the domain name; and
- (iii) your domain name has been registered and is being used in bad faith.¹⁴³

¹⁴¹ See Michael Geist, *Fair.com?: An Examination of the Allegations of Systemic Unfairness in the ICANN UDRP*, <http://aix1.uottawa.ca/~geist/geistudrp.pdf> (Aug. 2001); Milton Mueller, *Rough Justice: A statistical assessment of ICANN's Uniform Dispute Resolution Policy*, <http://dcc.syr.edu/roughjustice.htm> (last visited Mar. 18, 2002).

¹⁴² UDRP, *supra* note 2, § 4(a).

¹⁴³ *Id.*

So far, this language precisely tracked WIPO's proposal, except that ICANN spelled out the burden of proof which had only been implied in WIPO's proposal. ICANN also substituted the slightly broader, but more Lanham-Act-like word "confusingly" for "misleadingly" in sub-section (i).¹⁴⁴

Thus, like WIPO, ICANN limited the class of potential UDRP complainants to trademark and service mark holders. Despite this explicit limitation, however, a number of UDRP decisions have found that the policy protects famous people's personal names, on the theory that they are common law trademarks or some sort of source identifiers.¹⁴⁵ Other UDRP decisions have found that the policy protects geographic identifiers,¹⁴⁶ a category excluded under the WIPO proposal.¹⁴⁷

Following WIPO, ICANN limited its definition of cybersquatting to a small subset of trademark infringement. Rather than attempt to craft ADR for all domain name-based trademark infringement actions, ICANN limited the new remedy to the clearest cases where the registrant obviously had no "rights or legitimate interests" in the term at issue. In so doing, like WIPO before it, ICANN imported traditional choice of law principles, and thus whatever rights of free expression might apply under that selected law. Unfortunately, this point proved somewhat subtle for certain arbitrators, who

¹⁴⁴ The Lanham Act includes the word "confusion" rather than "mislead" although it certainly prohibits deception. 15 U.S.C. § 1114 (1994) prohibits "use in commerce [of] any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive." *Id.*

¹⁴⁵ See, e.g., *Roberts v. Boyd*, No. D2000-0210 (WIPO May 29, 2000), <http://arbiter.wipo.int/domains/decisions/html/d2000-0210.html>; *Sade v. Quantum Computer Servs. Inc.*, No. D2000-0794 (WIPO Sept. 26, 2000) <http://arbiter.wipo.int/domains/decisions/html/2000/d2000-0794.html>; *Madonna v. Parisi and "Madonna.com,"* No. D2000-0847 (WIPO Oct. 12, 2000), <http://arbiter.wipo.int/domains/decisions/html/2000/d2000-0847.html>; but see *Sting v. Urvan*, No. D2000-0596 (WIPO July 20, 2000), <http://arbiter.wipo.int/domains/decisions/html/d2000-0596.html> (finding that "Sting" is a common word and that entertainer was not entitled to name transfer).

¹⁴⁶ See *Excelentísimo Ayuntamiento de Barcelona v. Barcelona.com Inc.*, No. D2000-0505 (WIPO Aug. 4, 2000), <http://arbiter.wipo.int/domains/decisions/html/2000/d2000-0505.html>. But see *Kur- und Verkehrsverein St. Moritz v. StMoritz.com*, No. D2000-0617 (WIPO Aug. 17, 2000), <http://arbiter.wipo.int/domains/decisions/html/2000/d2000-0617.html> (finding that *stmoritz.com* should not be transferred).

¹⁴⁷ WIPO returned to the issue of geographic identifiers in its second domain name process precisely because the issue was excluded from the first round. See *supra* note 13.

either did not consider the choice of law issue, or felt more comfortable applying sub-sets of the law¹⁴⁸ or just making it up.¹⁴⁹

In leaving WIPO's language in this section basically unchanged, ICANN resisted a forceful call by the International Trademark Association ("INTA"), among others, to change the "and" in sub-section (iii) ("your domain name has been registered *and* is being used in bad faith") to an "or." Both sides of this debate had some valid points. Trademark partisans argued that it would be difficult to prove the motive for a registration after the fact. Furthermore, since trademark violations turn on use, it should suffice to show bad-faith use to establish a violation; a hypothetical pure-hearted registrant gone bad should not escape the policy. In addition, trademark partisans worried that wily cybersquatters would register domains in bad faith, fully intending to ransom to mark holders, but would not actually use them to forestall any finding of bad-faith use or might hatch complex schemes in which one person registers a name but leases or transfers to another who actually uses it.

Registrant partisans countered that current trademark law, at least in the United States, was quite clear that mere registration of a domain, without some kind of commercial use, did not constitute trademark infringement. Although courts had held that offering a domain for sale was commercial use, it could not follow that a plaintiff's psychic conclusion that warehousing was in bad faith could substitute for actual conduct. They also argued that, large-scale cybersquatters excepted, the only way to tell that a registration was in bad faith was to look at subsequent conduct, i.e., use, and that the two therefore should not be separated. Furthermore, as noted below, ICANN has greatly broadened the evidence that would suffice to find an intent to profit by selling to the complainant. The small drafting committee empaneled by ICANN deadlocked on this issue, and ICANN Counsel Louis Touton

¹⁴⁸ See *supra* note 111 (citing arbitral decisions).

¹⁴⁹ The barcelona.com decision, No. D2000-0505, is particularly outrageous, as the Spanish arbitrator ordered the transfer not because the registrant lacked rights to the name—he was operating a travel business that offered tours to Barcelona—but because the arbitrator found that the city had "better rights or more legitimate interests as in this case." One can only wonder what dispute policy the arbitrator was reading, if any.

single-handedly decided it in favor of “and.” In practice, however, this distinction appears to have been completely lost on numerous arbitrators, who have read “and” as if it meant “or.”¹⁵⁰

Like WIPO before it, ICANN also spelled out a non-exclusive list of “circumstances, in particular but without limitation, [which] if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.”¹⁵¹ Three of the four clauses of ICANN’s policy diverged materially from WIPO’s text, and more often than not in ways that benefitted potential complainants.

Only ICANN’s second category of bad faith, § 4(b)(ii), relating to *Toeppen*-style mass cybersquatters hewed precisely to WIPO’s recommendations.¹⁵²

<p>Evidence of bad faith ICANN UDRP § 4(b)(ii)</p> <p>[Y]ou have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct;</p>
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<p>Evidence of bad faith WIPO ¶ 171(2)(c)</p> <p>[T]he registration of the domain name in order to prevent the owner of the trade or service mark from reflecting the mark in a corresponding domain name, provided that a pattern of such conduct has been established on the part of the domain name holder;</p>
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¹⁵⁰ See, e.g., *Hewlett-Packard Co. v. Burgar*, No. FA 0002000093564 (NAF April 10, 2000), <http://www.arbforum.com/domains/decisions/93564.htm>.

¹⁵¹ UDRP, *supra* note 2, § 4(b).

¹⁵² Compare UDRP, *supra* note 2, § 4(b)(ii) with WIPO Final Report, *supra* note 17, § 171(2)(c).

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Compared to WIPO's earlier proposal, ICANN's classic cybersquatting definition, § 4(b)(i), had one big change that favored mark holders, and a small change that favored registrants. The big change greatly expanded the arbitrators' ability to rely on circumstantial evidence to find intent to resell a domain name to a trademark holder. Where WIPO had required an actual concrete offer to "sell, rent or otherwise transfer" a domain name, ICANN required only a finding of "circumstances indicating" acquisition of the domain name "primarily for the purpose" of such a transaction.¹⁵³

Evidence of bad faith
ICANN UDRP § 4(b)(i)

[C]ircumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name;

Evidence of bad faith
WIPO ¶ 171(2)(a)

[A]n offer to sell, rent or otherwise transfer the domain name to the owner of the trade or service mark, or to a competitor of the owner of the trade or service mark, for valuable consideration;

¹⁵³ Compare UDRP, *supra* note 2, § 4(b)(i) with WIPO Final Report, *supra* note 17, § 171(2)(a).

On the other hand, albeit of lesser import, where WIPO considered the registrant's request for any "valuable consideration" to be the mark of a cybersquatter, in § 4(b)(i) ICANN accepted the argument that requests for actual expenses, such as the cost of the registration, cost of stationary incorporating the domain name, and other costs associated with changing a name, did not make a registrant a cybersquatter so long as the costs were reasonable and documented.¹⁵⁴ Trademark partisans complained that this could easily be abused, but experience suggests that this sort of abuse is rare.

Like it had done with the basic cybersquatting clause, ICANN's version of the unfair competition clause, § 4(b)(iii), also loosened the evidentiary requirement. Where WIPO required a finding that the domain had been registered "in order" to disrupt a competitor, ICANN accepted the argument that mixed motives should not save an otherwise unfairly competitive domain name registration. It relaxed the "in order" language to require only a finding that the domain name was registered "primarily for the purpose of disrupting a competitor."¹⁵⁵

Evidence of bad faith
ICANN UDRP § 4(b)(iii)

[Y]ou have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

Evidence of bad faith
WIPO ¶ 171(2)(d)

the registration of the domain name in order to disrupt the business of a competitor.

¹⁵⁴ *Id.*

¹⁵⁵ Compare UDRP, *supra* note 2, § 4(b)(iii) with WIPO Final Report, *supra* note 17, § 171(2)(d).

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As its tortured syntax suggests, bearing all the earmarks of a committee wrangle, § 4(b)(iv) was very controversial. WIPO's cognate text sounded like a fairly standard trademark prohibition against using a mark in domain name in a way that caused commercial confusion. In their arguments to ICANN, however, trademark representatives protested vehemently that the proposed standard was underinclusive and too difficult to meet. ICANN accepted their arguments.¹⁵⁶

Evidence of bad faith
ICANN UDRP § 4(b)(iv)

[B]y using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.

Evidence of bad faith
WIPO ¶ 171(2)(b)

[A]n attempt to attract, for financial gain, Internet users to the domain name holder's website or other on-line location, by creating confusion with the trade or service mark of the complainant;

¹⁵⁶ Compare UDRP, *supra* note 2, § 4(b)(iv) with WIPO Final Report, *supra* note 17, § 171(2)(b).

Among the most significant changes were the loosening of the standard from “creating confusion” to the more Lanham-Act-like “creating a likelihood of confusion,” and the change from a requirement of attempted “financial gain” by the registrant to attempted “commercial gain”—the idea being that some “financial” gains might be non-commercial (e.g., a church asking for donations). Most confusingly, ICANN substituted WIPO’s straightforward statement that it prohibited confusion with a trade or service mark, with a prohibition on a likelihood of confusion with marks “as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.”¹⁵⁷ As one might expect given its convoluted nature, this paragraph has spawned inconsistent and idiosyncratic decisions.¹⁵⁸

2. Affirmative Defenses

Unlike WIPO, ICANN specified three non-exclusive affirmative defenses which would demonstrate the registrant’s rights or legitimate interests to the domain name.¹⁵⁹ Some objected to specifying defenses in the policy on the grounds that it would just give cybersquatters an instructional guide, but this objection was not pressed hard, and it did not carry the day. UDRP § 4(c) stated that:

Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of Paragraph 4(a)(ii):

- (i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
- (ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

¹⁵⁷ UDRP, *supra* note 2, § 4(b)(iv).

¹⁵⁸ For a survey see Amy Bender, *Bad Faith*, ch. 3.2.4., at <http://web.law.harvard.edu/udrp/opinion/btext.html#3.2.4> (last modified Jan. 2002).

¹⁵⁹ UDRP, *supra* note 2, § 4(c).

(iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.¹⁶⁰

The first affirmative defense protects persons who could demonstrate their “use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services” at a time prior to any notice to them of the dispute.¹⁶¹ Trademark partisans objected to including “demonstrable preparations to use” on the grounds that this would be too easy to fake. The counterargument was that such fakery was fraud and punishable as such. The second counterargument was that the rule was needed to reflect the reality of e-commerce in which the domain name was often a critical and early part of a startup’s business plan. As such, the name might be registered legitimately some months before the firm started active trading, during a period in which everything about the firm was intentionally secret.

The second affirmative defense was sometimes called the “pokey” clause after the notorious attempted hijack of the pokey.org website.¹⁶² This defense protects those who “(as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights.”¹⁶³ While having a personal name or nickname does not entitle one to trade under it if that would create confusion with another’s pre-existing trademark in that name, it seemed likely that such cases would be rare, and would be more correctly characterized as garden variety trademark infringement rather than cybersquatting. In any event, any policy that could have been characterized as a threat to children’s websites would have been a public relations disaster.

¹⁶⁰ *Id.*

¹⁶¹ *Id.* § 4(c)(i).

¹⁶² See RONY & RONY, *supra* note 26.

¹⁶³ UDRP, *supra* note 2, § 4(c)(ii).

The final affirmative defense category is a weird mix of incompatible concepts. It states that a domain name is being used legitimately if the registrant is “making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.”¹⁶⁴ Under U.S. trademark law at the time the UDRP was being debated, commercial use was a clear prerequisite to a claim of federal trademark infringement. Both the Lanham Act and the Anti-Dilution Act require commercial use by the defendant for a court to find for the plaintiff.¹⁶⁵ Thus, in the United States, absent very strange facts alleging actionable non-commercial tarnishment not protected by the First Amendment, a category that may well be limited to linking a mark to obscenity,¹⁶⁶ a purely non-commercial use was pretty much an iron-clad defense against a claim of trademark infringement.¹⁶⁷ ICANN’s

¹⁶⁴ *Id.*

¹⁶⁵ Lanham Act § 32, codified at 15 U.S.C. § 1114(a)(1) (protecting registered mark against “use in commerce” of “any reproduction, counterfeit, copy, or colorable imitation . . . in connection with the sale, offering for sale, distribution, or advertising of any goods or services or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive”); see also *id.* § 1114(1)(b) (prohibiting application of copies of registered mark to advertisements and packaging “intended to be used in commerce”); Federal Trademark Dilution Act of 1995, codified at 15 U.S.C. § 1125(c)(4) (stating that “noncommercial use” of a famous mark “shall not be actionable under this section”); cf. *Friedman v. Rogers*, 440 U.S. 1, 11 (1979) (stating that Lanham Act protections extend to “strictly business” matters and involve “a form of commercial speech and nothing more”).

¹⁶⁶ *Hasbro, Inc. v. Internet Entm’t Group, Ltd.* 40 U.S.P.Q.2d 1479, 1479 (W.D. Wash. 1996) is suggestive, although the case involved commercial use. More on point is *Archdiocese of St. Louis v. Internet Entm’t Group*, 34 F. Supp. 2d 1145 (E.D. Mo. 1999) (granting preliminary injunction against the use of *papalvisit1999.com* and *papalvisit.com*), although the decision seems plainly erroneous on First Amendment grounds.

¹⁶⁷ Arguably the passage of ACPA, which echos some of the language of the UDRP, may have created another avenue by which non-commercial tarnishment could be actionable. For an argument that ACPA, 15 U.S.C.A. § 1125(d)(1)(B)(i)(IV), might have this effect, see Jason M. Osborn, *Effective and Complementary Solutions to Domain Name Disputes: Icann’s Uniform Domain Name Dispute Resolution Policy and the Federal Anticybersquatting Consumer Protection Act of 1999*, 76 NOTRE DAME L. REV. 209, 251 (2000).

I think this argument is wrong for First Amendment reasons. Cf. 4 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 24:105 (4th ed. 2000) (noting that “tarnishment caused merely by editorial or artistic parody which satirizes plaintiff’s product or its image is not actionable under an anti-dilution statute because of the free speech protections of the First Amendment” and that otherwise “a corporation could shield itself from criticism by forbidding the use of its name in

third defense, however, fails to reflect this. Having noted the non-commercial use defense as applying to any “legitimate noncommercial or fair use of the domain name, without intent for commercial gain,” at the eleventh hour—well after most of the public comment period had passed—ICANN added the limiting clause, “to misleadingly divert consumers or to tarnish the trademark or service mark at issue.”

As a drafting matter, it seems odd to have a potentially major ground for transferring non-commercial domain name registration appear as a purported affirmative defense. Substantively, this importation of the tarnishment concept as a limit on non-commercial uses of domain names seems wholly inappropriate, because it undermines a substantial part of the free-speech value of the non-commercial and fair use defenses. In particular, this language easily could be used to deny protection to legitimate criticism sites. A site designed to attack a company’s labor practices or its environmental record (“MegaCo kills the earth”) might be considered to have the requisite intent to tarnish a mark. This would go far beyond U.S. law in protecting trademark holders. The picture is even more disturbing if one considers the various meanings of tarnishment in other legal systems. At various times and places, even gentle criticism of corporations such as comparative price and quality advertisement have been held to be tarnishment.¹⁶⁸

As many observers noted at the time, the natural effect of this language blunts the protection of free speech that noncommercial users are entitled to. ICANN was sufficiently concerned about the appearance of restricting free speech that its Second Staff Report included a footnote stating:

In view of the comments, one detail of the policy’s language should be emphasized. Several commentators indicated that the concept of “tarnishment” in paragraph 4(c)(iii) might be misunderstood by those not familiar with United States law or might otherwise be

commentaries critical of its conduct.”); *Mattel, Inc. v. MCA Records, Inc.*, 28 F. Supp. 2d 1120, 1156 (C.D. Cal. 1998); *Bally Total Fitness Holding Corp. v. Faber*, 29 F. Supp. 2d 1161, 1165 (C.D. Cal. 1998); Oscar S. Cisneros, *Bally Total Fitness Holding Corp. v. Faber*, 15 BERKELEY TECH. L.J. 229 (2000).

¹⁶⁸ See Mathias Strasser, *The Rational Basis of Trademark Protection Revisited: Putting the Dilution Doctrine Into Context*, 10 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 375 (2000).

applied inappropriately to noncommercial uses of parody names and the like. Staff is not convinced this is the case, but in any event wishes to point out that “tarnishment” in paragraph 4(c)(iii) is limited to acts done with intent to commercially gain. Staff intends to take steps to publicize this point.¹⁶⁹

In the two years since that statement was penned, however, the only visible publicity has been the posting of the Second Staff Report on ICANN’s web site. And indeed—although this clause is not inevitably cited as the reason—a surprisingly large number of UDRP decisions have found that non-commercial so-called “sucks” sites violate the UDRP and have ordered domain name transfers.¹⁷⁰ Arbitrators under the UDRP have been willing to find names such as *directlinesucks*, *dixonssucks*, *freeservesucks*, *guinness-beer-really-really-sucks*, *guinness-really-really-sucks.com*,¹⁷¹ *natwestsucks*, *standard-charteredsucks*,¹⁷² and *walmartcanadasucks* are “identical or confusingly similar” to a trademarked term without the “sucks.” For example, the arbitrator in the *standardcharteredsucks.com* case concluded that it “is by no means necessarily” the case that the name “would be recognized as an address plainly dissociated from ‘Standard Chartered.’”¹⁷³ Although the arbitrator allowed that “[s]ome will treat the additional ‘sucks’ as a pejorative exclamation and therefore dissociate it after all from the Complainant” he seemed to think that some people were not clever enough to make this distinction and would be “confused.”¹⁷⁴ However, under standard trademark principles it is very unlikely that a court would find that consumers would believe the company

¹⁶⁹ ICANN, *Second Staff Report on Implementation Documents for the Uniform Dispute Resolution Policy*, n.2, at <http://www.icann.org/udrp/udrp-second-staff-report-24oct99.htm> (Oct. 25, 1999).

¹⁷⁰ Not all, however. See, e.g., *Lockheed Martin Corp. v. Parisi*, No. 2000-1015 (WIPO Jan. 26, 2000), <http://www.arbiter.wipo.int/domains/decisions/html/2000/d2000-1015.htm>. (“Both common sense and a reading of the plain language of the Policy support the view that a domain name combining a trademark with the word ‘sucks’ or other language clearly indicating that the domain name is not affiliated with the trademark owner cannot be considered confusingly similar to the trademark.”).

¹⁷¹ *Diageo plc v. Zuccarini*, No. D2000-0996, (WIPO Oct. 22, 2000), <http://www.arbiter.wipo.int/domains/-decisions/html/d2000-0996.html>.

¹⁷² *Standard Chartered PLC v. Purge I.T.*, No. D2000-0681 (WIPO Aug. 13, 2000), <http://www.arbiter.wipo.int/domains/decisions/html/2000/d2000-06-81.html>.

¹⁷³ *Id.* § 5.

¹⁷⁴ *Id.*

being mocked would sponsor a site describing it in these pejorative terms. Such a finding would require extensive survey evidence, and even then First Amendment principles would likely allow the use for criticism by a non-competing party.

3. Costs

ICANN made a very significant decision about the assessment of costs that benefitted registrants, and reduced somewhat the danger of reverse domain name hijacking. The WIPO proposal had contemplated having the complainant pay fees to the dispute resolution provider to initiate the process, but would have allowed the arbitrator to require a losing registrant to pay arbitral fees and costs. To the trademark bar this was a just strategy aimed at lowering settlement values and creating incentives for cybersquatters to throw in the towel, but to advocates of registrants' rights it was a recipe for intimidating individual registrants. At the time, the administrative costs of the proceedings were estimated to be between \$1000 and \$3000.¹⁷⁵ While this is not a large number for a big corporation, and is manageable for many small businesses in the developed world, it could be prohibitive for others and for individuals—especially those located in less wealthy countries. Add in the cost of a lawyer, and the difficulty of finding competent counsel on very short notice, and the prospect becomes daunting for small and even medium-

¹⁷⁵ This was not in fact a bad guess as things turned out, although it ignores the issue of attorney's fees. Actual costs vary among the providers and also depend on whether the ADR uses a one-person or three-person panel. Costs run between \$750 and \$4500 for one disputed domain name. See CPR Institute for Dispute Resolution ("CPR"), *CPR Supplemental Rules to ICANN's Rules for Uniform Domain Name Dispute Resolution Policy*, § 12, at http://www.cpradr.org/ICANN_RulesAndFees.htm (last modified Sept. 15, 2000) (noting that the fee for one panelist is \$2000 and the fee for three panelists is \$4500); eResolution Consortium, *Schedule of Fees*, § 1, at <http://www.eresolution.ca/services/dnd/schedule.htm> (Oct. 2, 2000) (noting that the fee for one panelist is \$750 and the fee for three panelists is \$2200); National Arbitration Forum Dispute Resolution for Domain Names, *Schedule of Fees*, at <http://www.arbforum.com/domains/domain-fees.html> (Dec. 23, 1999) (noting that the fee for one panelist is \$750 and the fee for three panelists is \$2250); World Intellectual Property Organization, *Schedule of Fees Under the ICANN Policy*, at <http://arbitrator.wipo.int/domains/fees/index.html> (Aug. 15, 2000) (noting that the fee for one panelist is \$1500 and that the fee for three panelists is \$3000).

sized enterprises. Given that a domain name could be registered for under \$100, the prospect of having to risk thirty or more times the value of one's investment to protect it was likely to have an intimidating effect in many cases. While trademark representatives grumbled about the loss of fee-shifting, some admitted that collecting those fees would be nearly impossible in most cases, given that the cost of enforcement would have exceeded the amount that could be recovered—even if one could find the defendant.

4. Reverse Domain Name Hijacking (“RDNH”)

The UDRP continues WIPO's tradition of providing no meaningful punishment for RDNH. UDRP § 15(e) does, however, provide for the potential slap on the wrist in an adverse decision:

If after considering the submissions the Panel finds that the complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking or was brought primarily to harass the domain-name holder, the Panel shall declare in its decision that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding.¹⁷⁶

Although the failure to find a more forceful solution to RDNH is not a small problem, most of the direct remedies might be worse than the disease. The UDRP does not give the arbitrators authority to levy fines against registrants or complainants. If the policy were amended to allow fines for RDNH, it is likely that fines against losing registrants would be the next step. Other than fines, there appears to be no sanction which could be applied against reverse domain name hijackers except perhaps excluding them from any further access to the UDRP. ICANN did not consider the exclusion option because implementing it contractually might be difficult. By far the best solution would be to ensure that arbitrators do not make zany decisions ignoring the plain words of the UDRP. The more zany decisions there are, the more mark holders will be tempted to “have a go” at the quick and inexpensive UDRP.

¹⁷⁶ UDRP Rules, *supra* note 18, § 15(e).

Section 15(e) of the UDRP has no deterrence value. Its irrelevance is best demonstrated by noting that despite the many odd complaints filed under the UDRP, the first case actually to find RDNH was not decided until June 19, 2000,¹⁷⁷ about six months into the life of the UDRP. By the time the UDRP was a year old, there were only two UDRP cases finding RDNH.¹⁷⁸ By February 2002, there were at most a handful of RDNH decisions.¹⁷⁹ Of course the absence of RDNH findings is not itself proof that there is a problem with policy, as this fact is also consistent with the hypothesis that the overwhelming majority of claims filed are either meritorious or at least arguable. However, when one combines the many debatable or

¹⁷⁷ See *Qtrade Canada, Inc. v. Bank of Hydro*, No. AF-0169 (eResolution June 19, 2000), available at <http://www.eresolution.ca/services/dnd/decisions/0169.htm>.

¹⁷⁸ In addition to the *Qtrade* case, there was *K2r Produkte AG v. Trigano*, No. D2000-0622 (WIPO Aug. 23, 2000), <http://arbiter.wipo.int/domains/decisions/html/2000/d2000-0622.html>, in which only two of the three panelists were willing to find RDNH despite fairly clear facts.

¹⁷⁹ There is no authoritative list of UDRP decisions finding RDNH. A fairly complete list is as follows:

Torres, S.A. v. The Torres Group, No. D2001-1200 (WIPO Dec. 19, 2001), <http://arbiter.wipo.int/domains/decisions/html/2001/d2001-1200.html>; *Société des Produits Nestlé S.A. v. Pro Fiducia Treuhand AG*, No. D2001-0916 (WIPO Oct. 12, 2001), <http://arbiter.wipo.int/domains/decisions/html/2001/d2001-0916.html>; *Aspen Grove, Inc. v. Aspen Grove*, No. D2001-0798 (WIPO Oct. 5, 2001), <http://arbiter.wipo.int/domains/decisions/html/2001/d2001-0798.html>; *Maine Bait Co. v. Brooks a/k/a Maine Bait*, No. FA0107000098246 (NAF Aug. 28, 2001), <http://www.arbforum.com/domains/decisions/98246.htm>; *G. A. Modefine, S.A. v. A.R. Mani*, No. D2001-0537 (WIPO July 20, 2001), <http://arbiter.wipo.int/domains/decisions/html/2001/d2001-0537.html>; *Koninklijke KPN N.V. v. Telepathy Inc.*, No. D2001-0217 (WIPO May 7, 2001), <http://arbiter.wipo.int/domains/decisions/html/2001/d2001-0217.html>; *ODE and ODE—Optimum Digital Enter. v. Internship Ltd.*, No. D2001-0074 (WIPO May 1, 2001), <http://arbiter.wipo.int/domains/decisions/html/2001/d2001-0074.html>; *ONU s.r.l. v. Online Sales, LLC*, No. AF-0672 (eResolution Feb. 16, 2001), <http://www.disputes.org/eresolution/decisions/0672.htm>; *Goldline Int'l, Inc. v. Gold Line*, No. D2000-1151 (WIPO Jan. 4, 2001), <http://arbiter.wipo.int/domains/decisions/html/2000/d2000-1151.html>; *Deutsche Welle v. DiamondWare Ltd.*, No. D2000-1202 (WIPO Jan. 2, 2001), <http://arbiter.wipo.int/domains/decisions/html/2000/d2000-1202.html>; *Foresight Corp. v. Servos*, No. AF-0473 (eResolution Dec. 15, 2000), <http://www.disputes.org/eresolution/decisions/0473.htm>; *Foresight Corp. v. Servos*, No. AF-0473 (eResolution Dec. 15, 2000), <http://www.disputes.org/eresolution/decisions/0473.htm>; *Safari Casino A.G. v. Global Interactive Ltd.*, No. AF-0288 (eResolution Oct. 4, 2000), <http://www.disputes.org/eresolution/decisions/0288.htm>; *Smart Design LLC v. Hughes*, No. D2000-0993 (WIPO Oct. 18, 2000), <http://arbiter.wipo.int/domains/decisions/html/2000/d2000-0993.html>; *K2r Produkte AG v. Trigano*, No. D2000-0622 (WIPO Aug. 23, 2000), <http://arbiter.wipo.int/domains/decisions/html/2000/d2000-0622.html>; *Qtrade Canada Inc. v. Bank of Hydro*, No. AF-0169 (eResolution June 19, 2000), <http://www.disputes.org/eresolution/decisions/0169.htm>.

frankly abusive decisions against respondents, indeed the cases where one would expect a RDNH finding yet there is none, and the absence of any RDNH decisions that are even arguably wrong, one begins to see a tilt in a particular direction.

Deutsche Welle v. DiamondWare,¹⁸⁰ one of the first cases to find RDNH, exemplifies the lengths to which complainants have to go before a panel will find them guilty of abusing the process. Indeed, in the *DiamondWare* matter, despite the obviously abusive nature of the complaint based on trademarks more recent than the domain name registration, only two of the three arbitrators were willing to say the complaint was brought in bad faith.¹⁸¹ The complainant was a German television and radio network, the respondent a software development company based in the United States which had traded under the acronym “DW” since as early as 1994. The respondent registered dw.com in 1994. Deutsche Welle had German trademarks dating to the 1980s, but none in the United States with priority before 1995. When Deutsche Welle sent a demand letter¹⁸² to DiamondWare in July 2000, it responded (on dw.com letterhead), as follows:

Thank you for your interest in our domain name, dw.com. We are not currently offering this property for sale on the open market, however it has recently been attracting enquiries. Therefore, we would consider an offer above \$3,750,000 (three million, seven hundred fifty thousand US Dollars) from an accredited buyer.¹⁸³

Deutsche Welle responded by bringing a proceeding under the UDRP. According to the judgment, this was the entire argument it presented:

¹⁸⁰ No. D 2000-1202, (WIPO Jan. 2, 2001), <http://arbiter.wipo.int/domains/-decisions/html/2000/d2000-1202.html>.

¹⁸¹ *Id.*

¹⁸² The letter said:

It has come to our attention that you are in possession of the domain www.dw.com. As shown in the enclosed certification Deutsche Welle has a registered trade mark concerning “dw.”

Therefore you shall transfer this domain name over to us. Nevertheless we would be very grateful for your co-operation in resolving this matter and find an amicable solution.

I look forward to hearing from you soon.

Id.

¹⁸³ *Id.*

The complainant is operating a public television and radio program worldwide under the denomination "DW." The trade marks of the complainant cover goods and services directly related to media, data transfer, and internet services. Furthermore, it has become very common that broadcasting channels offer internet services under their program (which is "DW" in this case).

The respondent has been approached by fax of July 13, 2000 by the complainant. The respondent has answered by fax of August 10, 2000 and was offering the domain "DW" for the offer of U.S. \$ 3,750,000. The fact that the respondent is offering the domain for sale shows that the respondent has no personal or other legitimate interest in holding the domain, which is obvious taking into consideration the amount of money they are asking. Furthermore, from the letter of the respondent one can see that the respondent acquired the domain and holds the domain primarily for the purpose of selling it.¹⁸⁴

The two arbitrators in the majority held that the complaint was abusive because the complainant knew that the dw.com registration pre-dated its U.S. trademarks (which were, in any case not for the letters "dw," an acronym of the complainant, but rather for the letters plus a graphic design element), and since it also knew or should have known (from even a cursory examination of the dw.com website) that the respondents were and had been operating a bona-fide business from it.¹⁸⁵ Indeed, the complainant had completely failed to allege, much less offer any evidence, that the domain was registered "primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant" or to explain why, if this was the case, DiamondWare waited six years to make its request for payment, and then only in response to a demand letter.¹⁸⁶

For the two arbitrators in the majority, this conduct demonstrated an abuse of the UDRP. Even the dissenter on the RDNH finding agreed that "the Complaint was misconceived and should not have been filed" because the complainant had failed to make even "a minimal effort to establish plausible grounds for bringing the Complaint under the Policy."

¹⁸⁴ *Id.*

¹⁸⁵ *Deutsche Welle v. DiamondWare, Ltd.*, No. D2000-1202, (WIPO Jan. 2, 2001), <http://arbiter.wipo.int/domains/decisions/html/2000/d2000-1202.html>.

¹⁸⁶ *Id.*

Nevertheless, the dissenter was unwilling to join the RDNH¹⁸⁷ finding because, upon receipt of Deutsche Welle's demand letter, DiamondWare had failed to explain it was a bona fide user of the domain name and failed to explain "the basis for the price it was quoting for the Domain Name."¹⁸⁸ Despite Deutsche Welle's apparent failure to do minimal investigation of DiamondWare's web site or history, this dissenter stated that the respondent's failures to educate the party threatening it would make it "unduly harsh to characterize the Complaint as reverse domain name hijacking."¹⁸⁹ Where the UDRP imposes a duty to educate people who negligently send you threatening letters was never explained.

Perhaps DiamondWare was lucky. In *NetLearning, Inc. v. Parisi*¹⁹⁰ a different panel faced a complaint bought by a trademark holder whose first use of its trademark was more than a year *after* the respondent first registered the contested domain name. The majority of the *NetLearning* panel rejected the suggestion that because there was no way that a registration made before the trademark right existed could ever be in bad faith under UDRP § 4(a)(iii), the complaint must therefore be abusive. In fact, it went one better and transferred the domain name to the complainant.¹⁹¹

B. *Procedural Problems*

Except for the small matter of attorneys' fees, the UDRP is certainly quick and relatively cheap when compared to litigation in a U.S. court.¹⁹² The proceeding can cost under \$1,500 for one panelist, depending on the complainant's choice

¹⁸⁷ *Id.*

¹⁸⁸ *Id.* (referring to the views of arbitrator Torsten Bettinger).

¹⁸⁹ *Id.*

¹⁹⁰ No. FA0008000095471 (NAF Oct. 16, 2000), <http://www.arbforum.com/-domains/decisions/95471.htm>.

¹⁹¹ *Id.* The panel majority's decision seemed to turn on two facts: that Parisi used the domain to display pornography, and that the parties had discussed selling the domain name for several thousand dollars. The respondent then took the matter to court, producing a reported decision holding that the court would hear the case *de novo* and that Federal Arbitration Act does not apply to UDRP matters, *Parisi v. Netlearning, Inc.*, 139 F. Supp. 2d 745 (E.D. Va. 2001), but, so far at least, no decision on the merits.

¹⁹² For a summary of the costs see *supra* note 175.

of dispute resolution provider. The arbitration runs on a very fast track, with each side entering only exhibits and one short pleading. Save in the most exceptional case (which has yet to occur¹⁹³), there is neither a live hearing nor online argument. Proceedings normally take forty-five days or less from complaint to conclusion. If the respondent loses, he has ten more days to file a challenge in a competent court, or the domain name is transferred to the complainant.¹⁹⁴ It is no surprise, therefore that so many cases have been filed under the policy since it began. Of the cases that have proceeded to a decision, more than seventy-five percent have been decided for the complainant.¹⁹⁵

The UDRP's advantages to complainants come, however, at the price of a substantial reduction in registrants' legal rights. Many of the worst effects on registrants' rights are artifacts of the UDRP rules rather than the policy itself. Four of the most unfair aspects of the UDRP rules are: (1) the selection and composition of the arbitral panel; (2) the failure to provide a registrant with adequate time to reply to a complaint—or even to ensure that the respondent has actual notice; (3) a very crabbed and limited opportunity for complainants who lose a UDRP action to get their cases into court; and (4) the absence of any meaningful check on the providers' creation of supplemental rules that effectively tilt the playing field.

1. Selection and Composition of the Tribunal

Rather than both sides having equal input into who will decide the case, the complainant chooses the arbitral tribunal from a small list of approved providers maintained by ICANN. Unlike standard arbitration clauses where the provider is

¹⁹³ In *Columbine JDS Systems, Inc. v. Jin Lu* (adserve.com), No. AF-0137 (eResolution Apr. 28, 2000), <http://www.disputes.org/eresolution/decisions/0137.htm>, the arbitrator said that he would have "preferred" more evidence from the respondent. In *Ebuilder, Inc. v. Building Online* (ebuilder.com), No. CPR008, <http://www.cpr-adr.org/ICANNDecisionCPR008-001205.htm> (Dec. 5, 2000), the Panel said that the relationship between the Complainant and the TM owner was not clear. Neither panel apparently thought to invoke this procedure.

¹⁹⁴ UDRP, *supra* note 2, § 4(k).

¹⁹⁵ Mueller, *supra* note 141.

specified in the presumably bargained-for contract or negotiated by the parties at the time of the dispute, the respondent has no say in which provider will manage her case, and no peremptory challenges to arbitrators she may fear are biased. The respondent can, however, pick one member of a three-person panel at her own expense if the complainant opted for a single panelist and the respondent decides three are needed.¹⁹⁶ Overall, the system gives dispute resolution providers an economic incentive to compete by being complainant-friendly.¹⁹⁷

Different strategies were proposed for deciding how a given case would be assigned to a dispute services provider. The discussions took place at a time when it was unclear how many providers there might be, how they would be accredited and by whom, and how, if at all, they would be monitored. WIPO would have been happy to be the sole dispute-services provider,¹⁹⁸ but not everyone was comfortable with this idea. WIPO's defined mission of encouraging the protection of intellectual property, and the views put forward in its Interim Report and Final Report, created some doubts about its neutral status. Having multiple providers might also encourage price competition, while a monopoly provider could either charge what it liked, or would require some form of price control by an ICANN dedicated to promoting competition.

Proposals for assigning cases included the suggestion that the registrant would pick the dispute-services provider either at the time of registration or at the time of dispute, or that plaintiff would pick one at the time of complaint, or that

¹⁹⁶ UDRP Rules, *supra* note 18, §§ 6(c), 6(e).

¹⁹⁷ See Mueller, *supra* note 141.

¹⁹⁸ By February 2002, WIPO had captured the lion's share of the market, with National Arbitration Forum ("NAF") in a distant second place, and the other providers having only negligible shares. Cumulative data up through mid-February 2002 showed this breakdown for a total of 4388 cases:

WIPO: 2565 cases (58.46 % of total caseload)

NAF: 1548 cases (35.28 % of total caseload)

ERES: 244 cases (5.56 % of total caseload)

CPR: 31 cases (0.70 % of total caseload)

E-mail from Michael Geist to Michael Froomkin, (Feb. 19, 2002) (on file with author). This cumulative data, however, does not show how WIPO's share grew over time. Ethan Katsh has assembled data showing that on February 2000, WIPO's share of the total caseload was about 43%; by February 2001 it was almost 60%, with NAF having almost all the remaining cases. E-mail from Ethan Katsh to Michael Froomkin, (Sept. 12, 2001) (on file with author).

registrars would pick, or that the service-provider would be randomly selected. Once the trademark bar had conceded on the issue of who would pay for the process (plaintiff, unless plaintiff wanted one arbitrator and respondent wanted three, in which case the cost was split), it insisted that allowing the defendant to pick, even at the time of registration, was unfair. The trademark bar also argued that if anyone other than the complainant were allowed to select the provider, it might encourage the existence of an arbitration service provider biased toward registrants. If that happened, all registrants would select it, and even registrars might be forced for competitive reasons to elect this service to arbitrate domains they administered. ICANN therefore allowed the complainant to select the provider, but made no effort to put in place any mechanism to monitor the system for pro-complainant bias, a prospect that seemed at least as likely as pro-registrant bias. In exchange for paying the piper a pittance, the trademark bar got to call the tune. It turned out to be a good bargain for their clients.

This was a serious error, and urgently needs repair. There were other options available, but they were discarded. The registrar could choose the provider, or a provider could be selected at random. Random choice was in some ways fairest, but it had the real disadvantage of introducing no incentive for dispute services providers to keep down their prices, which seemed risky.¹⁹⁹

Whatever procedure replaces the current one, ICANN should have no role in the selection of arbitration providers. The selection and vetting of arbitrators is in no conceivable form a technical issue relating to either names, numbers, or the functioning of the Internet and is thus outside ICANN's proper jurisdiction. There is nothing in the structural composition of ICANN, nor in the composition of the current or any imaginable future ICANN Board, which suggests any special competence in this area. If, despite this, ICANN takes on as it has the function of accrediting dispute services providers, it must put in place mechanisms to ensure that the providers are competent, and must monitor them for partiality.

¹⁹⁹ As a later participant in the creation of a dispute services provider, I still stand by that conclusion. We would have been happy to charge more—and would still be in business.

Without some monitoring, one gets the system we have today—which is a recipe for forum shopping.

Second, any system that replaces the current one must allow arbitrators to be selected from lists that do not only include trademark lawyers, but people with other backgrounds, including civil liberties lawyers. As registrations and trademarks are both global, the system must also take account of national and linguistic differences of the participants.²⁰⁰

2. Issues of Notice and Computation of Time

Adopting one of the worst features of WIPO's proposal, the UDRP does not require actual notice to respondents, only attempted notice for a relatively short period of time. The mere *sending* of the complaint to postal-mail, fax, and email addresses found via whois,²⁰¹ and by email to postmaster@ plus any email address shown or e-mail links on www.domainname suffices to start the twenty day clock for the respondent's only chance to reply.²⁰² The decision to forgo requiring actual notice in absolutely all cases is understandable, given the efforts that the sleaziest registrants go to hide their contact details in shady registrations. The short deadlines, on the other hand,

²⁰⁰ Issues of composition of panels from the lists maintained by individual arbitration service providers are discussed *infra* at Part III.F.

²⁰¹ Whois is a program that queries one or more registry or registrar databases to see if a second-level domain name has been registered. If the name has been registered the program returns information about the registrant, typically including name, address, email and telephone number. See RONY & RONY, *supra* note 26, § 6.3.2.

²⁰² We begin with UDRP Rules § 4(c) which states, "The date of commencement of the administrative proceeding shall be the date on which the complaint is forwarded by the Provider to the Respondent," UDRP Rules, *supra* note 18, § 4(c), and Rule 2(f) which states that "All time periods calculated under these Rules shall begin to run on the earliest date that the communication is deemed to have been made in accordance with Paragraph 2(e)." *Id.* § 2(e). The key parts of Rule 2(e) state that "Except as otherwise provided in these Rules . . . all communications provided for under these Rules shall be deemed to have been made . . . if via the Internet, on the date that the communication was transmitted, provided that the date of transmission is verifiable." *Id.* Note that this refers only to transmittal, not receipt. Rule 2(a) does not appear to be a rule "otherwise" providing in terms of rule 2(e) because it does not speak of computation of time (this may be a drafting error?). It speaks only of a duty to achieve actual notice . . . eventually. Thus, if email to a defendant bounces, time starts to run anyway while the Provider continues to attempt to achieve actual notice by some other means. Similarly if an email is sent but not read (e.g., if the recipient is on vacation or in the hospital), time starts to run anyway.

are completely unfair, even if ICANN's twenty days is up from the ten days in the WIPO proposal.²⁰³ Respondents who happen to take a three-week vacation, or find themselves in intensive care without e-mail, can lose their chance to explain why they should keep their domain name without ever knowing it was endangered.

Merely initiating communications via email is not adequate notice.²⁰⁴ Running a procedure of this sort without actual notice or a method reasonably calculated to achieve notice prior to the commencement of the proceedings must be contrary to the public policy of all civilized nations. It risks producing results that are, or at least should be, unenforceable in the courts of all civilized nations.

The time problem is especially acute for consumers and small or medium enterprises ("SMEs") that do not have an Internet-savvy intellectual property lawyer on retainer, or indeed any lawyer at all. Although not as rare as they once were, lawyers who understand the issues in a domain name case are still something of an exception, and are not found in every community. The response period needs to be long enough for parties to find a lawyer they are comfortable with, and for that person to get up to speed on the issues and to organize and write the response. While twenty days (minus time to actually get the notice) is plenty of time for a large corporation with lawyers on call to do all this, it is not very long for smaller organizations and ordinary individuals who have the misfortune to register a name that someone else covets.

The current rules for computing time also suffer from two technical defects, both of which contribute to the overall atmosphere of unfairness. Contrary to expectations, it has become routine for complainants to attach a large number of paper exhibits to their complaints. Although the actual complaint itself is an electronic document, the exhibits frequently are not digitized (and in the case of products exhibiting a trademark exhibit are often not digitizable!). Since the twenty-day clock for the registrants' time to respond begins when the first email is sent, but the paper exhibits sometimes

²⁰³ See *supra* text accompanying note 129-33.

²⁰⁴ For a discussion of the issues, see generally Rachel Cantor, Comment, *Internet Service of Process: A Constitutionally Adequate Alternative?*, 66 U. CHI. L. REV. 943 (1999).

contain crucial parts of the case, the registrant is not informed of the case which he must answer until some time later. In the developed world, parties are rarely more than two days away from the dispute services provider by express mail, but there is no requirement that the documents be sent by express mail, and some providers choose not to express mail documents to respondents as a matter of policy. In the less developed world, even express packages can take much longer to arrive, and ordinary mail is unreliable.²⁰⁵ Even what constitutes “receipt” is problematic as some courier services may use file signatures for unattended deliveries.

A second problem is more egregious. Until shortly after the web publication of an early draft of this paper,²⁰⁶ one of the competing providers—the National Arbitration Forum (“NAF”)—used its supplemental rules to offer parties a chance to file an extra brief five days after the ordinary close of pleadings for \$150.²⁰⁷ Since the ordinary close of pleadings is the registrant’s response, this opportunity was primarily of value to complainants. Furthermore, the right is not cumulative: filing such a paper did not trigger another five day window for the other side. Not only did this rule tend to favor one side, but it invites sandbagging—leaving a key point for the unanswerable supplemental filing.²⁰⁸ The opportunity for abuse is especially large since the supplemental pleading,

²⁰⁵ John Berryhill informs me that the African registrant in the *lycalovers.com* case, *E.I. du Pont de Nemours and Co. v. ITC*, FA0012000096219 (NAF Feb. 20, 2001), <http://www.arbforum.com/domains/decisions/96219.htm>, received the complaint on the day his response was due. I have also heard from a source I trust of a NAF case in which the complaint and exhibits were stopped by customs for the entire twenty-day response period.

²⁰⁶ The NAF changed the rule on October 15, 2001. Compare <http://www.arbforum.com/domains/udrp/rules020101.asp> (last visited Mar. 13, 2002) with <http://www.arbforum.com/domains/udrp/rules101501.asp> (last visited Mar. 13, 2002).

²⁰⁷ See National Arbitration Forum Dispute Resolution for Domain Names, *Supplemental Rules*, Rule 7, available at <http://www.arbforum.com/domains/domain-rules.html> (Oct. 24, 1999) (“A party may submit additional written statements and documents to The Forum and the opposing party(s) not later than five (5) calendar days after the date the Response is submitted or the last date the Response was due to be submitted to the Forum, whichever occurs first.”). Although couched in neutral terms allowing either party to avail itself of the supplemental brief, it is obvious that a provision allowing either party to file a supplemental brief five days after the defendant’s response is designed to favor plaintiffs.

²⁰⁸ I am indebted to John Berryhill for this suggestion, which he tells me is not hypothetical.

unlike the complaint and the response, has no length limit. This sandbagging opportunity looks suspiciously like a dispute services provider's attempt to be as plaintiff-friendly as possible. Indeed, one commentator described the "sandbag" rule, and a number of other NAF supplemental rules, as "extremely biased toward Complainants."²⁰⁹

NAF's decision to revise the sandbag rule removes one problem but creates another. The new rule allows the non-filing party five more days from the date on which a supplemental filing was made to make its own responsive supplemental filing. As Jonathan Weinberg noted:

[F]ive days isn't much time to receive and respond to anything in a UDRP proceeding. The new rule also opens the door to an endless stream of replies and sur-replies, since each new filing opens another five-day window. At the same time, NAF has eliminated the blatant "last shot" for complainants, potentially side-stepping the question of whether supplemental filings are permitted under the UDRP in the first place.²¹⁰

As some complainants are using their "supplemental" filing to make their case in chief, the net effect of this rule undercuts the respondent's right of reply. Faced with a supplemental complaint, the complainant must not only rush to reply, but she must pay \$250 for the privilege.²¹¹

The sandbag rule saga reveals a more general problem: in the absence of supervision, providers are able to use their supplemental rules to seek a competitive advantage in ways that undermine the UDRP. ICANN, which purportedly supervises the dispute services providers, allowed the sandbag rule to take effect, and took no action to repeal it or to remove NAF's accreditation. Since both the original sandbag rule and

²⁰⁹ Stacey H. King, *The "Law That it Deems Applicable": ICANN, Dispute Resolution, and the Problem of Cybersquatting*, 22 HASTINGS COMM. & ENT. L.J. 453, 498 (2000). In addition to the rule noted in the text, Ms. King identified the NAF's draconian policy on extensions of time, its requirement that a respondent's requests for an extension be accompanied by a \$100 fee, and its rule allowing complainants to convert a three-member panel to a (cheaper) one-member panel if the respondent does not file a reply. *Id.* at 498-500.

²¹⁰ Jonathan Weinberg, *NAF to End the Last Shot Rule*, at <http://www.icannwatch.org/article.php?sid=409> (Oct. 11, 2001).

²¹¹ See NAF Supplemental Rules § 7, at <http://www.arb-forum.com/domains/-UDRP/rules.asp> (last visited Mar. 13, 2002).

its revision are fairly clear violations of the UDRP,²¹² ICANN's failure to react suggests that ICANN is not willing or able to police the dispute services providers.

3. Asymmetric Access to Courts to "Review" UDRP

The UDRP attempted to ameliorate a fundamental imbalance in WIPO's proposal regarding the parties' access to courts after the dispute resolution provider rendered a decision. Like WIPO's plan, the UDRP is meant to be non-binding in that either party can seek a judicial determination of their rights at any time before, during, or after the ADR. Under the WIPO proposal, the consequences of the ADR procedure were very severe, and completely asymmetrical: losing a WIPO ADR would not affect the rights of a complainant mark holder in any significant way and there was no reason to believe that the losing registrant would be able to find a court willing to hear his claim that he should keep the domain. ICANN ameliorated this by creating a small—very small—window for losing registrants to get to court. Despite this, the fundamental asymmetry remains.

An example will make this clear. Imagine that Alice, a complainant, has a trademark in "companyname," but Bob has registered "companyname.com" which Alice believes is rightfully hers. If Alice wished to avoid the WIPO ADR, she can bring the action in any court that has jurisdiction over the registrant. Suppose that Alice, the complainant, lives in New York, and Bob, the registrant, lives in Prague. If Alice can persuade a New York court to assert jurisdiction over Bob because he is using the domain in an infringing manner with effects in New York, then she can bring suit where she lives. On the other hand, if Bob has merely registered the domain but made no internationally infringing use of it, Alice probably must go to Prague to bring the action.²¹³ The WIPO ADR

²¹² The UDRP defines the allowed pleadings as a "complaint" and a "response." The UDRP leaves it to the arbitral panel's discretion whether to allow additional filings in exceptional cases. Indeed, one NAF panel refused to accept a supplemental paid filing for this reason.

²¹³ For the first part of this example, we ignore ACPA, which includes the possibility of an in rem remedy in the U.S. courts, as it did not exist when WIPO made its proposal.

offered Alice a potentially attractive means of avoiding the expense and uncertainty of hiring foreign counsel and risking the vagaries of a foreign legal system.

Suppose, however, that Alice lost before WIPO's proposed tribunal, and she wishes to bring suit anyway. At this point, since the ADR is non-binding, she has the same options she had before the WIPO ADR, minus whatever damage caused by the persuasive power of the arbitral decision. She has as long as she wants to file her complaint, subject only to considerations of laches and statutes of limitations, and the fear that Bob might establish some secondary trademark rights of his own over time.

Now suppose, on the other hand, that the WIPO-ADR rules that Bob, the registrant, should surrender his domain name. Bob wishes to challenge this outcome, perhaps because he believes that under Czech law he has a valid right to the name that the arbitrators failed to recognize. Under the WIPO policy the decision goes into effect within seven days,²¹⁴ so Bob has a week to find a court with jurisdiction over Alice to hear his request for an injunction.

Without the WIPO ADR Bob probably would have defended the action in a court in Prague, giving him the benefits traditionally accorded defendants, particularly defendants who are ordinary individuals and small businesses: a convenient venue, familiar law, local language, local counsel, and local choice of law principles. Instead, unless Alice has sufficient contacts with Prague for the court there to assert jurisdiction over her, Bob must now shoulder the burden of being the plaintiff in a New York court, with potentially unfamiliar and more expensive procedures, a different local language, and foreign counsel. The New York court may use different choice of law and different substantive principles than the Czech court. And, Bob will now be the plaintiff instead of the defendant and must shoulder the burden of proof. Indeed, if Bob seeks injunctive relief to prevent the WIPO ADR decision from going into effect immediately, Bob will have to shoulder a heavy burden of proof indeed. Without an injunction, however, Bob was probably doomed.

²¹⁴ WIPO Final Report, *supra* note 17, ¶ 216.

Recall that WIPO stated that its design goal was that “the right to litigate a domain name dispute should be preserved.”²¹⁵ It also stated that

the availability of the administrative procedure should not preclude resort to court litigation by a party. In particular, a party should be free to initiate litigation by filing a claim in a competent national court instead of initiating the administrative procedure, if this is the preferred course of action, and should be able to seek a *de novo* review of a dispute that has been the subject of the administrative procedure.²¹⁶

The question remains: What exactly was Bob supposed to tell the court if he loses the WIPO ADR? If Bob failed to secure an injunction, the “administrative” decision goes into effect in seven days; the domain name is transferred and remains in effect until countermanded by a competent court. That order would never come however, because at the moment the domain name is transferred, Bob loses his cause of action.²¹⁷ One might think that Bob could seek a declaration that the ADR was mistaken, on the grounds that he would then would get his domain name back. Unfortunately for Bob, this comes too close to a wager on a court decision. While one can get a court to adjudicate a bet that turns on some question external to the court, especially if a debt is disputed, one cannot manufacture subject matter jurisdiction for a court to adjudicate a legal question by placing a bet on what it will decide.

U.S. law does not provide for general review of alternate dispute resolution procedures. Certainly, the Federal Arbitration Act does not provide a means of review, since that act limits the court’s review to arbitrations, and only those arbitrations:

- (1) Where the award was procured by corruption, fraud, or undue means.
- (2) Where there was evident partiality or corruption in the arbitrators, or either of them.

²¹⁵ *Id.* ¶ 148.

²¹⁶ *Id.* ¶ 150(iii).

²¹⁷ I believe this to be true in most legal systems, but I have illustrated the point with U.S. law, which is the only system I know at all well. As a very large fraction of all domain name registrations are by U.S. persons and firms, U.S. law obviously matters in this context.

(3) Where the arbitrators were guilty of misconduct in refusing to postpone the hearing, upon sufficient cause shown, or in refusing to hear evidence pertinent and material to the controversy; or of any other misbehavior by which the rights of any party have been prejudiced.

(4) Where the arbitrators exceeded their powers, or so imperfectly executed them that a mutual, final, and definite award upon the subject matter submitted was not made.²¹⁸

Even if the WIPO ADR were an “arbitration” under U.S. law, one hopes that none of these four factors, which are aimed at cases where the arbitration is tainted by fraud, incompetence, or the like, would ordinarily apply. (Other nations provide procedures for more searching review of “arbitration,”²¹⁹ but this “administrative” procedure would be unlikely to qualify—in part because it is not binding, in part because of the limited nature of the right being adjudicated).

Indeed, if the proceeding is not an “arbitration” then Bob has a problem. U.S. courts do not ordinarily review “administrative” decisions of private parties (as opposed to government agencies), unless there is some claim of tort, breach of contract, or violation of some other legal right. Having lost the domain name, Bob must now frame a cause of action that will get a court’s attention, and in a context where he no longer has the domain name because he agreed to a contractual “administrative” procedure in which he promised not to sue the arbitrator, the registrar, or the registry. If he can do so, the courts will consider his claim *de novo*, without deferring to the UDRP decision.²²⁰

Suppose Bob thinks the arbitrators improperly ignored a legal basis for his claim of right to the name, or incorrectly decided that Bob was a liar. Several potential claims are probably hopeless. For instance, Bob might wish to frame some

²¹⁸ 9 U.S.C. § 10 (1990).

²¹⁹ See, e.g., Arbitration Act, 1996, c.23 (Eng.).

²²⁰ See, e.g., *Strick Corp. v. Strickland*, 162 F. Supp. 2d 372, 374 n.5 (E.D. Pa. 2001), available at <http://www.strick.com/aug27.pdf>; *Parisi*, 139 F. Supp. 2d at 752; see also *Weber-Stephen Products Co. v. Armitage Hardware and Bldg. Supply, Inc.*, 54 U.S.P.Q.2d 1766 (N.D. Ill. May 03, 2000) (denying stay of UDRP proceeding; holding court not bound by UDRP decision but declining to decide “what weight should be given to a panel’s decision”); *Broadbridge Media, L.L.C. v. HperCd.com*, 106 F. Supp. 2d 505 (S.D.N.Y. 2000). See generally <http://www.udrplaw.net/UDRPappeals.htm> (last modified Mar. 27, 2001) (listing UDRP cases challenged in court).

sort of claim of “tortious interference with contractual relations” against Alice, based on his contract with his registrar, but that seems a poor bet when he specifically agreed to the ADR procedure in his contract. Indeed, there is no contract between Bob and Alice for the court to adjudicate, and Bob has no claim against Alice under his contract with the registry. If Bob is a non-commercial user and there is no claim of bad faith or fraud on the part of the arbitrator, then Bob will not be able to claim a violation of his right of free expression because the damage was caused by a private party, not the government.²²¹ While Bob might try that argument, it is untested waters—and likely therefore to be a high-cost, high-risk strategy. He has little actual damages, and it is in any case unclear who has been negligent or behaved tortiously. In addition, there is no statutory right at issue.

Without a trademark of his own, Bob is unlikely to have a claim against Alice under Alice’s subsequent contract with her registry. Of course, if Bob has a trademark identical to his domain name, and the arbitrators just ignored it for some strange reason, he can claim that Alice is violating his trademark. But the strength of that claim will turn in substantial part on how Alice is using the mark, not on what Bob was doing, which would have been the subject of the case but for the WIPO ADR. It is easy to imagine a case where the two parties are not in fact infringing each other, and a court applying national law would have found for Bob if he were the defendant. But as Alice is no more guilty of trademark infringement under the relevant national law than is Bob, she will win the court case and keep the domain Bob would have had but for the WIPO ADR.

A slightly less hopeless argument for Bob would be “tortious interference with a prospective business advantage” against Alice. The *Restatement Second of Torts* instructs that,

²²¹ Bob might try to argue that ICANN and/or the arbitrators are state actors. See generally Froomkin, *supra* note 3. He would find comfort in *Sullivan v. Barnett*, 526 U.S. 40 (1999), where the Chief Justice suggested that the decision of a heavily regulated arbitration procedure, “like that of any judicial official, may properly be considered state action.” *Id.* at 54. As ICANN, acting in conformity with the policy set out in the White Paper, has written both the substantive rules applied in the UDRP, and the bulk of the procedural rules that arbitration providers must observe, see UDRP Rules, *supra* note 18, it follows that if ICANN is a state actor then arguably dispute providers are state actors also.

One who intentionally and improperly interferes with another's prospective contractual relation (except a contract to marry) is subject to liability to the other for the pecuniary harm resulting from loss of the benefits of the relation, whether the interference consists of (a) inducing or otherwise causing a third person not to enter into or continue the prospective relation or (b) preventing the other from acquiring or continuing the prospective relation.²²²

However, U.S. courts have frequently imposed more stringent limiting conditions on this tort than the *Restatement* formulation might suggest. For example, in order to prevail on a claim of tortious interference with prospective economic advantage, a plaintiff must show "the defendant's interference with business relations existing between the plaintiff and a third party, *either* with the sole purpose of harming the plaintiff or by means that are dishonest, unfair, or in any other way improper."²²³ Similarly,

In order to state a claim for tortious interference with prospective economic advantage, a plaintiff must show (1) business relations with a third party; (2) defendants' interference with those business relations; (3) defendants acted with the sole purpose of harming the plaintiff or used dishonest, unfair, or improper means; and (4) injury to the relationship.²²⁴

This will usually be difficult to prove, or even to allege in good faith: most people in Alice's position will be able to argue convincingly that harm to Bob was not the sole purpose of the ADR in that Alice sincerely wanted the domain name for herself. Furthermore, assuming that it was the arbitrators who erred, and there was no fraud by Alice, Bob cannot in good faith claim that she used "dishonest, unfair, or improper means" to win the proceeding.

If the above analysis is correct, then under WIPO's plan for many--perhaps most or all--registrants who lost an ADR, their dispossession would have been the whole of the law. On the other hand, challengers who lost an ADR would have lost nothing more than their costs and some bragging rights, as they would have retained their previous right to litigate.

²²² RESTATEMENT (SECOND) OF TORTS § 766B (1979).

²²³ PPX Enter. v. Audiofidelity Enters., 818 F.2d 266, 269 (2d Cir. 1987).

²²⁴ Purgess v. Sharrock, 33 F.3d 134, 141 (2d Cir. 1994).

ICANN attempted to ameliorate this by introducing two new ideas in the UDRP. First, ICANN required that the complainant, Alice in our example, waive a defense of lack of personal jurisdiction in a “mutual jurisdiction”—Alice’s choice of either the location of the registrar, or the place where the registrant, Bob, said he was located when he filled out his application for the domain name.²²⁵ If Bob loses, the domain name transfer is stayed for ten business days. In that two-week period if Bob files a complaint in the “mutual jurisdiction,” or any other court of competent jurisdiction, then the transfer is halted²²⁶ without any need for Bob to seek an injunction.

By allowing Bob to halt the transfer in this manner, ICANN attempted to ensure that Bob would retain a sufficient connection to the domain name to motivate a declaratory judgment action, thus making it possible for Bob to challenge an adverse decision so long as he could mobilize his lawyer to file a complaint within ten business days of the decision. The ten working-day filing period may be longer than WIPO’s seven-day proposal, but it is not long at all. Exactly how onerous it is depends where the parties are located. The United States and many European jurisdictions have relatively liberal rules of pleading. In the United States, for example, an initial complaint (in federal court at least) can be very skimpy, even mildly inaccurate in places, and can be amended once as of right with no or minimal consequences to the plaintiff. A rule that says, rush to the courthouse, file in a hurry, and amend at leisure is not unjust in such a regime. Pleading rules were not always so liberal, however; the filing of an inaccurate complaint (and any complaint that needed amendment potentially was “inaccurate”!) was once considered fraud on the court. Similar pleading rules persist in some legal systems, and the ICANN rule will be particularly onerous for parties residing in, or registered with a non-U.S. registrar, in those jurisdictions. In systems where pleadings cannot be amended, but must instead be withdrawn and re-filed, the UDRP policy will treat the withdrawal of the original complaint as grounds

²²⁵ See UDRP Rules, *supra* note 18, § 1 (defining “mutual jurisdiction”). Given that NSI was the monopoly registrar for most of the Internet’s recent history, this meant that in practice a complainant could choose the Eastern District of Virginia. However, NSI’s market share is now down considerably, which adds some variety.

²²⁶ UDRP, *supra* note 2, § 4k.

for enforcement of the arbitrator's decision, even if the complaint were re-filed the same day. Worse, from the losing registrant's viewpoint, some legal systems do not even allow the withdrawal of a complaint without prejudice.²²⁷

Even in the United States the ability of a losing registrant to mount a meaningful court challenge has been subject to doubt. A recent ruling by a Massachusetts district court, subsequently reversed by the First Circuit, well illustrates the problem. Jay D. Sallen, a U.S. citizen, registered *corinthians.com*; the Brazilian soccer team *Corinthiao* (Portugese for "Corinthians") subsequently initiated and won a claim for the domain name under the UDRP.²²⁸ Within the ten-day period after losing the UDRP decision, Sallen sought a declaratory judgment that his registration of the domain name did not violate the ACPA.²²⁹ Sallen relied on an ACPA provision contemplating just such an action:

A domain name registrant whose domain name has been suspended, disabled, or transferred under [the UDRP] may, upon notice to the mark owner, file a civil action to establish that the registration or use of the domain name by such registrant is not unlawful under this chapter. The court may grant injunctive relief to the domain name registrant, including the reactivation of the domain name or transfer of the domain name to the domain name registrant.²³⁰

At this point, *Corinthiao* applied procedural jujitsu by appearing before the court and disclaiming any intention of bringing an ACPA claim against Sallen. This promise not to bring a future trademark claim was made secure in the

²²⁷ Not every jurisdiction has liberal pleading rules. See, e.g., JORGE A. VARGAS, *MEXICAN LAW: A TREATISE FOR LEGAL PRACTITIONERS AND INTERNATIONAL INVESTORS* § 20.2 (1998) (stating that in Mexico, "Once drafted, a complaint cannot be refiled"). The UDRP puts all nationals of such countries to an unreasonable choice: they must either give up their home forum by registering with a foreign registrar, or do a great deal of advance legal work before they even know the result of the arbitration if they want to have a meaningful chance of appeal. (Note that the same does not apply to a losing challenger, who can wait as long as he likes before trying for a second bite at the legal apple, subject only to laches or the statute of limitations.) This matter requires a degree of study it simply has not received.

²²⁸ *Corinthians Licenciamentos LTDA v. Sallen, Sallen Enters., and J. D. Sallen Enters.*, No. D2000-0461, (WIPO July 17, 2000) <http://arbiter.wipo.int/domains/decisions/html/2000/-d2000-0461.html>.

²²⁹ *J.D.S. Enters. v. Corinthians Licenciamentos LTDA*, No. 00-CV-11555, 2000 U.S. Dist. Lexis 19976 (D. Mass. Dec. 19, 2000).

²³⁰ ACPA, 15 U.S.C. § 1114 (2)(D)(v) (West 2001).

knowledge that if the federal case were dismissed the domain name transfer would take effect *and Sallen, the original registrant, would therefore no longer have a cause of action.*²³¹ As a result of the transfer, there would be no possible ACPA claim. Judge Young agreed that this concession disposed of the case:

Based on the representations made by Defendant, Corinthians Licenciamentos ("CL") that it "has no intent to sue Plaintiff under the ACPA for his past activities in connection with corinthians.com" the Motion to Dismiss is GRANTED. . . . Jurisdiction under 28 U.S.C. § 2201 is proper only if there exists an actual controversy between the parties. . . . Absent the threat of suit there is no controversy and jurisdiction is lacking. CL's representation is bolstered by the fact that a suit under the ACPA provides no additional relief. Because the disputed domain name was registered prior to the enactment of the ACPA, damages are unavailable.²³²

In one sense, Judge Young's conclusion was quite understandable. By making this tactical concession, the victorious mark holder transformed the post-UDRP judicial proceedings into something with a procedural posture akin to the one that seemed to make judicial review of a WIPO ADR a nullity in cases where the registrant lost. The court's conclusion follows all too naturally, although one wonders if the court could not, for example, have denied the motion to dismiss and instead treated the concession as reason to grant the declaration on summary judgment since there was no fact in dispute.

Fortunately for the UDRP, the First Circuit took a broader view of the matter, holding that the ACPA language quoted above²³³ creates a cause of action for a party who loses an action under the UDRP.²³⁴ In this view, the ACPA supplies the claim, and thus both the subject matter jurisdiction and the standing that Judge Young had found to be absent. This result is surely correct, as simply dismissing the complaint would undermine the fundamentally equitable object of the

²³¹ See *supra* text accompanying notes 213-20.

²³² *J.D.S. Enters. v. Corinthians Licenciamentos LTDA*, No. 00-CV-11555 (D. Mass. filed Aug. 3, 2000) (internal citations omitted), *reversed sub nom*, *Sallen v. Corinthians Licenciamentos LTDA*, 273 F.3d 14 (1st Cir. 2001).

²³³ 15 U.S.C. § 1114 (2)(D)(v).

²³⁴ *Sallen*, 273 F.3d at 24-29.

declaratory judgment statute,²³⁵ the purpose of the ACPA right of action, and would require the court to turn a needlessly blind eye to the realities of the relationship between the parties. Indeed, until an ACPA suit seeking to prevent a UDRP decision from going into effect is dismissed and the mark holder gains possession of the domain name, there remains a genuine *contractual* dispute between the parties as to who has the right to have the registry list them as the holder of the domain name.²³⁶

Even if other circuits follow the First Circuit's lead, the United States is not the only jurisdiction whose laws need to be taken into account. Since the UDRP is not an "arbitration" but merely an "administrative proceeding," losing parties whose right to sue inures in non-U.S. legal systems will not, in general, be able to bring cases under laws providing for the appeal of an arbitration award. The problem of framing an appropriate cause of action may thus be replicated world wide. It may be that there are simple answers to this problem in the major legal systems of the world, but as far as I know no one has yet come forward to say what they are.

As if that were not enough, the *Corinthians.com* case exposed yet another weakness in the UDRP framework. Although the registrant took a timely appeal of the district court's decision, the registrar transferred the domain name upon receipt of Judge Young's decision. Arguably, that act destroyed the registrant's standing to pursue the appeal; had a business relied on the domain name it would undoubtedly have damaged it. The First Circuit dealt with this issue in a cursory footnote, stating,

²³⁵ The Declaratory Judgment Act, 28 U.S.C. § 2201(a) states, "[i]n a case of actual controversy within its jurisdiction, . . . any court of the United States, upon the filing of an appropriate pleading, may declare the rights and other legal relations of any interested party seeking such declaration, whether or not further relief is or could be sought. . . ."

²³⁶ A further issue, perhaps, is whether even if the court conducts de novo legal review, findings of fact by the UDRP panel should be given preclusive effect. Given the absence of any serious testing of the factual submissions, I think there is no reason why facts found by the arbitration could have preclusive effect consistent with due process.

After the district court dismissed Sallen's suit, however, the domain name was transferred to CL, possibly wrongfully in light of the pendency of this appeal. If the complaint were reinstated, the logic of Sallen's position is that Sallen would seek leave to amend his complaint to request an injunction returning the domain name.²³⁷

While this does not amount to a reasoned decision that leave should be granted, or even that standing exists so long as there is a claim for the injunction, it is a pretty strong hint. Even so, this aspect of the *corinthians.com* experience suggests that making provisions for timely appeals is one of the many things that could usefully be fixed in the UDRP.

III. FIXING THE UDRP'S PROCEDURAL SHORTCOMINGS

The UDRP's *procedural* shortcomings can be summarized under five headings: (1) issues of fairness; (2) issues of proof and evidence; (3) issues relating to the timetable; (4) ensuring the availability of equal access to court for subsequent proceedings; and (5) improving the auditability and transparency of the process. Notably absent from this list is the *substance* of the UDRP, including its definition of cybersquatting, the affirmative defenses, the murky choice of law clause, and the strange ways in which those definitions have been interpreted by some arbitrators. A comprehensive repair of the UDRP would address not only its procedural shortcomings, but also the problem of existing arbitral decisions that clearly flout the rules yet are continually cited as "precedent." No amount of substantive repair, however, is likely to be effective unless the UDRP's procedural problems are rectified.

A. *Basic Fairness*

Fairness requires fundamental reforms. First, the UDRP's built-in tendency to reward arbitration service providers for being "complainant friendly" must be redressed. The system must be, and must be seen to be, even-handed between both complainants and respondents. Second, would-be

²³⁷ *Sallen*, 273 F.3d at 16 n.1.

abusers of the system need a greater disincentive to bring frivolous claims. Otherwise there is almost no reason not to bring "try-on" cases, especially if arbitrators are perceived to be rendering unpredictable, even random, decisions.

1. Removing Potentially Biased Arbitrators

The UDRP lacks an effective mechanism to allow parties to challenge the appointment of an arbitrator whom they believe to be biased or to have a conflict of interest. Peremptory challenges might be one way to address this, but they might also become another occasion for delay and strategic behavior on both sides. Current procedures rely on arbitrators to disclose potential conflicts, but this is clearly insufficient since the truly biased person will tend to downplay the extent of conflicts. Therefore, there is a need to develop some means by which parties can raise for-cause challenges with the provider and some agreed criteria for what constitutes an impermissible conflict of interest. For example, if an arbitrator is a member of a firm, and the firm has taken a position on a disputed question of law in a pending arbitration or lawsuit for a client, should the arbitrator be allowed to decide a case raising a similar question? Or, if a partner previously has represented or sued one of the parties, should that count as a conflict of interest? What if the matter is current? Since there is no common practice on these issues, and national standards of what constitutes a potential conflict of interest vary, it is essential to craft written standards or, better yet, import them from an external, experienced body.

2. Removing Cases from Potentially Biased Providers

In a recent case in which I sat as a respondent-appointed arbitrator, the respondent alleged that the provider itself was biased in favor of the complainant because the complainant was a member of the body sponsoring the arbitration service provider and had a long-standing relationship with it. The arbitration service provider refused to recuse itself, and the respondent again raised the issue before the panel. The arbitrators agreed unanimously that whatever

the merits of this claim might be, and despite the theoretical possibility that a service provider might use its power to control the appointment of one or more of the arbitrators, the UDRP “does not give panels the authority to order recusal of a provider.”²³⁸ I believe this decision was correct in that the current UDRP clearly does not give a panel that authority. But that does not mean that the possibility of provider bias, or even of the reasonable appearance of bias, is an issue that should be ignored.

The risk of a reasonable appearance of provider bias due to a preexisting relationship with a party is probably greatest with WIPO because it has a unique relationship with its members, and especially with member states. They are, quite simply, its masters. Under the circumstances, there is at least an appearance of impropriety, one fed by the obscurity of the WIPO arbitrator assignment policy and the existence of certain odd decisions.²³⁹ Rules should be in place to avoid even the appearance of this sort of impropriety, and WIPO itself should not be asked to be the final judge in its own case.²⁴⁰

3. Leveling the Playing Field

No one can be expected to trust an arbitration provider whose long-term income depends on satisfying one side in disputes but not the other. The problem is not that complainants choose the forum, for that after all is no worse than ordinary forum shopping. Rather the problem is that the income of the arbitral institutions, and through them the arbitrators, is affected by plaintiffs’ lawyers’ views of the extent to which the dispute services provider tilts towards complainants. A judge’s pay remains the same however long the line at the courthouse; the same is in no way true of arbitrators and especially the arbitration service providers.

²³⁸ AFMA, Inc. v. Globemedia, No. D2001-0558 (WIPO Aug. 23, 2001), <http://arbiter.wipo.int/domains/decisions/html/2001/d2001-0558.html>.

²³⁹ The leading example is the barcelona.com decision, see *supra* note 149, in which WIPO appointed a former high-ranking WIPO official to hear a matter involving his hometown.

²⁴⁰ The issues with NAF are more systemic, and probably more serious. See *supra* text accompanying notes 207-12 (discussing NAF’s use of supplemental rules to become more complainant-friendly).

Fortunately, there are many simple and fair ways to reduce or even eliminate this source of real or apparent bias, although it is not as easy to find one that also creates some incentive for the arbitration service providers to compete on price. One easily implemented solution, which I nonetheless do not advocate, would be to assign all cases by lot. While simple to implement, this solution carries great disadvantages. For example, if one or more accredited providers is doing substandard work or charging unreasonably high prices, that provider would continue to get the same share of the randomly assigned cases. This seems unfair to everyone, albeit equally unfair to everyone.

Perhaps the best solution would be to ask the parties to agree to a provider, with the decision to be taken by lot if they cannot agree. Each party would be asked to list the providers it would be willing to accept, in order of priority. Since both parties would have equal say in the matter, the providers' incentive to please only one side would be greatly reduced. But even this solution has three problems. First, in order to prevent competition for the substantial number of default judgements, the choice of provider would be made by lot when the respondent failed to reply to the complaint. As noted above, lottery selection is far from ideal. Second, a priority list system would work better if there were more providers, but it works fairly badly in a system with only four providers. Suppose, for example, that it were the case that informed participants believed Providers A and B to be very biased for complainants and Providers C and D to be very biased for respondents. Informed complainants propose A, B, C, D; informed respondents propose D, C, B, A. The result is a stalemate, leading to random selection. Alternately, if parties are required to rank only the providers they approve of, A, B vs. C, D is also a stalemate. In such a world, in the short run at least, the system collapses to a pure lottery. A third problem is that since the providers currently handle the service of the complaint on the respondent, the respondent is not available to express an opinion as to who the provider should be until after the dispute service provider has already been chosen.

Alternately, the choice of a dispute services provider could be lodged in some third party. The ideal third party would be one that has a desire to respect the interests of both

parties, and the incentive and ability to stay informed about the relative capabilities, fees, and possible biases of the competing dispute providers. Such a paragon may not exist, but the registrars may be the closest thing to it. The registrar is well placed to promote price and service competition since it is the registrar's customers who will have to deal with the provider and who may be paying half the provider's fees. Registrars could either select a single provider who would be chosen for any disputes regarding domains they register, or they could present complainants with a list to select from.

Lodging the choice in the registry seems the best solution. It is not, however, without its critics. It might reasonably be objected that the registrars have an obvious interest in serving their customers, the registrants, but no particular incentive to consider the interests of potential complainants. Indeed, at the time the UDRP was being drafted, representatives of mark holders hypothesized that a rogue registry in some hypothetical unfriendly jurisdiction might join with a hypothetical rogue dispute provider and advertise itself as the pirate-friendly registry in order to attract business. In principle, this objection seems weak: given that ICANN has to accredit dispute providers, all it has to do is refuse to accredit a rogue provider, or remove its accreditation if it proves itself unworthy. Given current practice, however, the objection seems to have more force. ICANN has so far demonstrated a complete failure to monitor the activities of the dispute providers, and has taken no action when they write rules that are biased for plaintiffs. The most likely reason for that disinterest is that ICANN, which heavily represents trademark and other business interests, is not troubled by those rules, just as it was not troubled by the UDRP. The lobbies that dominate ICANN would be much quicker to demand action if the bias ran the other way, and were a rogue provider to materialize, one can reasonably expect that ICANN would be quick to take action against it.

4. Finding a RDNH Prohibition with Teeth

The UDRP drafters were well aware that the document dismally failed to address the problem of frivolous claims brought to intimidate a legally untutored or resource-poor

registrant into surrendering a domain name, a tactic dubbed reverse domain name hijacking (“RDNH”). Representatives of mark holders considered the UDRP’s failure to do anything meaningful about RDNH to be a selling point; representatives of registrants were divided. Some said such a one-sided policy was too unfair, and that something should be done for victims of frivolous complaints. At the time, I argued that a slap on the wrist was preferable to awarding damages or costs for frivolous complaints because I wanted to preserve the principle that panels would only have the power to award a domain name. Since I suspected that the system would favor mark holders, if only because the bulk of arbitrators would be drawn from the trademark bar and would thus have a natural empathy for parties resembling their clients (which proved to be an accurate prognosis), I feared that any power to award costs would tend to fall most heavily on registrants. Furthermore, complainants almost always would be represented by counsel, while registrants might represent themselves because the short time limits would make it very difficult for them to locate Internet-competent attorneys. Moreover, since costs are always higher when you pay someone else, a fee-shifting rule would tend to favor the represented parties, i.e. the complainants. Most of all, however, I was worried that while the fees of \$1000 or so were trivial to large corporate complainants, even the threat of costs of this magnitude would intimidate many legitimate respondents who were unable or unwilling to risk thousands to defend a domain registered for under \$100.

The UDRP’s capriciousness has made RDNH even more attractive than I expected, and I now believe that something more must be done to reduce the incentive to bring frivolous claims. I still believe, however, that arbitrators should not have jurisdiction to award costs because the threat of costs would intimidate legitimate registrants. Furthermore, as the UDRP supposedly seeks to mirror existing rights for registrants rather than create new ones for complainants, imposing the “English rule” for costs on registrants from jurisdictions that use the “American rule” would violate that principle, at least as applied in the United States. The best solution I can envisage is to require some sort of surety bond from complainants, say \$5,000, to be awarded to the registrant only if the panel makes a finding of RDNH. Admittedly, a

disadvantage of this proposal is that it would impose a temporary capital cost on complainants and thus might make them less willing to file meritorious cases. The cost might fall particularly hard on complainants from less developed countries for whom \$5,000 might be a very large sum even for a small business. However, given that so many of the complainants are major corporations from Organization for Economic Cooperation and Development ("OECD") member nations who can part with \$5,000 during the pendency of the UDRP action, I do not think that this is currently a major concern.²⁴¹ Another alternative is to forgo having the money paid into a fund, and instead have the complainant agree to pay if the arbitrators require it. The difficulty here, of course, is that an unscrupulous complainant will not pay, and the sum may be too small for an effective transnational collection action.

An additional, but more easily solved, problem with § 15(e) as currently administered is that it allows complainants to bring abusive claims and yet escape the mild consequences of being branded with a finding of RDNH. Suppose Alice files an abusive complaint against Bob, in the hopes that he may surrender or default. Bob responds by paying for a three-member tribunal and making a RDNH claim under § 15(e). Upon receipt of the counter claim, Alice drops her case. If the withdrawal is without prejudice, Alice can do it again and subject Bob to more non-refundable arbitration fees. (NAF provides refunds to complainants who request three-member panels if the respondent defaults. However, if the respondent requests a three-member panel and the complainant drops the case there is no refund to the respondent.²⁴² The net effect of

²⁴¹ Conceivably, at the cost of substantial administrative complexity, some sort of sliding scale could be worked out that took account of the assets of the complainant.

²⁴² NAF Supplemental Rule 16(c) provides that "Fees to be paid to the Forum as provided in these Supplemental Rules must be paid in U.S. Dollars and are non-refundable." However, Supplemental Rule 9 states:

(c) In cases where the Complainant requested a three-member Panel and no Response was submitted as required by Rule 5(a), the Complainant may be given the option of converting the three-member Panel to a single-member Panel:

[. . .]

(iv) If a single-member Panel conducts the administrative hearing, the Complainant will be reimbursed \$1,000 of its hearing fee.

<http://www.arb-forum.com/domains/udrp/rules.asp> (last visited Mar. 27, 2002).

these two rules is to provide refunds to complainants for excess three-member panel fees but never to respondents.) Even assuming the withdrawal is with prejudice,²⁴³ it still denies Bob his chance to make the RDNH claim, or indeed to get some vindication for the sums billed by his lawyer.

A recent NAF arbitration panel, faced with this exact scenario in *Glimcher University Mall v. GNO*, held that it lacked jurisdiction to act on the RDNH claim after the complaint was withdrawn, because “[a] decision on reverse domain name hijacking is to be made in conjunction with a decision on the merits of a complaint.”²⁴⁴ As the panel very forthrightly put it, “[t]he only remedies available under the Policy are for the benefit of a complainant.”²⁴⁵ Proceeding on the basis of this rather one-sided, if perhaps accurate, assumption, the panel rejected the idea that a respondent’s request for a finding of RDNH is in the nature of a counterclaim since “the Rules place these issues before the panels in all cases.”²⁴⁶ Oddly, the panel treated the RDNH finding as something a panel might do *sua sponte*, although the decision does not cite any examples of a panel doing so, and I know of none. Indeed, if the UDRP is “for the benefit of a complainant” *sua sponte* findings of RDNH are very unlikely.

One could be forgiven for thinking that UDRP Rule § 17(b) gives the panel all the authority it needs to make a RDNH finding even after a complainant attempts to withdraw a complaint. That rule states: “If, before the Panel’s decision is made, it becomes unnecessary or impossible to continue the administrative proceeding for any reason, the Panel shall terminate the administrative proceeding, unless a Party raises justifiable grounds for objection within a period of time to be determined by the Panel.”²⁴⁷ Surely the respondent’s assertion that the claim was brought in bad faith “raises justifiable grounds for objection”? Indeed, it is hard to imagine what other “justifiable grounds for objection” a respondent might have.

²⁴³ *But see infra* text accompanying note 253.

²⁴⁴ *Glimcher Univ. Mall v. GNO, Inc.*, No. FA0107000098010, (NAF Aug. 23, 2001), <http://www.arb-forum.com/domains/decisions/98010.htm>.

²⁴⁵ *Id.*

²⁴⁶ *Id.*

²⁴⁷ UDRP Rules, *supra* note 18, § 17(b).

Unless the *Glimcher University Mall* decision can be dismissed as a fluke, the UDRP rules should be amended to close this loophole.

B. *Proof and Decisions*

The drafters of the UDRP, myself included, did not think carefully enough about questions and mechanics of proof. This deficiency has become increasingly evident from practice under the UDRP. Furthermore, different views of what it means to carry a burden of proof in different legal systems have added an additional level of misunderstanding and confusion.

1. Allocating the Burden of Proof

The UDRP places on the complainant the entire burden of proof for the case in chief,²⁴⁸ that is, the burden of showing that both the registration and use were in bad faith. Yet the UDRP fails to explain how a complainant meets this burden, what quantum of proof suffices to prove malicious intent, and to what extent respondents must carry the burden of proof, production, or persuasion to make out affirmative defenses.

a. *Meeting the burden*

A particularly contentious issue has been how a complainant meets the burden of showing that the respondent registered a name in bad faith.²⁴⁹ In the paradigmatic cybersquatting case, where the name is offered for sale to the trademark owner, it is plausible to infer the bad intent from subsequent conduct. Some arbitrators, however, have succumbed to the temptation to cut corners and have found bad intent from mere registration without subsequent conduct, which unquestionably is not what the drafters of the UDRP

²⁴⁸ UDRP, *supra* note 2, § 4(a).

²⁴⁹ See, e.g., Mitchell J. Matorin & Michael Boudett, *Domain Name Disputes: Cases Illustrate Limitations of ICANN Policy*, 45 BOSTON BAR J. 4 (2001) (complaining that burden is too great).

agreed upon, and runs counter to U.S. law, which holds clearly that mere registration, without more, is not cybersquatting.²⁵⁰ Other arbitrators have found that the registration of some names is ipso facto proof of bad intent since there are some names that the arbitrator believed could never be registered in good faith by anyone other than the trademark holder—a view that is clearly incorrect as a matter of U.S. law, which frowns on rights in gross in any word.²⁵¹ It may be that the burden of proof needs to be clarified to explain that each element of the complaint must be proved separately, and to explain what qualifies as proof, although given the underdeveloped state of mind-reading technology, it would be reasonable to explicitly allow circumstantial evidence other than the nature of the name itself to prove intent at time of registration.

2. The Problem of Settlement Negotiations and Solicited Offers of Sale

Since the paradigmatic case of cybersquatting remains a domain offered for sale to a trademark holder, wily mark holders have developed new strategies for tricking domain name holders into actions that can then be cited as “evidence” of bad faith. The classic case is the solicited offer. The mark holder or her agent writes to the registrant, asking whether a domain is for sale, and how much it would cost. Registrant replies by saying “I’d sell for \$X.” This communication is then introduced as evidence of cybersquatting. A variant on this strategy is for mark holder to send a demand letter to

²⁵⁰ As the district court found, Toeppen traded on the value of Panavision’s marks. So long “as he held the Internet registrations, he curtailed Panavision’s exploitation of the value of its trademarks on the Internet, a value which Toeppen then used when he attempted to sell the Panavision.com domain name to Panavision.” *Toeppen*, 141 F.3d at 1325. And, “Toeppen made a commercial use of Panavision’s trademarks. It does not matter that he did not attach the marks to a product. Toeppen’s commercial use was his attempt to sell the trademarks themselves. Under the Federal Trademark Dilution Act and the California Anti-dilution statute, this was sufficient commercial use.” *Id.* at 1325-26. “Thus, while the mere reservation of a domain name per se does not constitute a commercial use sufficient to trigger the Lanham Act, the courts in the *Toeppen* case have stretched the law in order to reach the cybersquatter.” MCCARTHY, *supra* note 109, § 25:77; *see also* K.C.P.L., Inc. v. Nash, 49 U.S.P.Q.2d 1584 (S.D.N.Y. 1998).

²⁵¹ *See* David J. Franklyn, *Owning Words In Cyberspace: The Accidental Trademark Regime*, 2001 WIS. L. REV. 1251.

registrant in a case where there are genuine, perhaps complex, issues of concurrent use. The demand letter sparks settlement negotiations. mark holder, being unwilling to pay the possibly legitimate or possibly excessive price requested by registrant, chooses to invoke the UDRP and introduces the settlement correspondence as evidence.

At a minimum, the UDRP should be modified to include an evidentiary privilege for settlement negotiations after the receipt of a lawyer's demand letter. A party who seeks to introduce evidence of solicited offers that do not involve a demand letter (e.g., in response to a non-threatening email) should also be required to disclose any solicitation that triggered the offer in the same pleading. The rules should make clear that the full context of the correspondence is relevant to whether the offer to sell is a sign of bad faith. Barring all evidence of solicited offers although preferable, is probably politically infeasible, because mark holder representatives maintain they are concerned that the canniest cybersquatters will register names and then sit tight waiting for offers.

3. Special Rules Needed for Allegations of Common Law Marks

As a matter of principle, there is no reason to favor registered marks over common law marks when allowing mark holders to avail themselves of the UDRP. Both types of marks have similar rights and are equally harmed if subjected to cybersquatting. Experience has proved, however, that the light and quick procedures used in the UDRP are unsuited to determining whether a complainant has a common law mark in a term.²⁵² Without cross examination, expert testimony, and a greater inquiry into the facts than the current system allows, arbitrators have little choice but to shoot from the hip, and this increases the odds that they will miss. One simple solution would be to revise the UDRP to apply only to registered marks. Failing that, new procedures and rules of evidence (and

²⁵² See, e.g., *Roberts v. Boyd*, No. D2000-0210; *Sade v. Quantum Computer Servs. Inc.*, No. D2000-0794; *Madonna v. Parisi and "Madonna.com."* No. D2000-0847; *Sting v. Urvan*, Case No. D2000-0596.

probably a new fee schedule to match them) need to be crafted to deal with the preliminary issue of whether the plaintiff has a common law mark at all.

Of course, the right to allege a common law mark should be limited to complainants trading in jurisdictions which recognize such marks. To give complainants from civil law jurisdictions that do not recognize common law marks a right to bring a UDRP case based on common law concepts would violate the basic precept that should always inform the UDRP. Its function is to mimic a subset of existing trademark law, not to create a new set of global trademark rights unsanctioned by the relevant legislatures.

4. UDRP Decisions Should Be Final Within the System

At least one panel has invented, apparently out of whole cloth, the concept of a “dismissal without prejudice” under the UDRP in response to a respondent’s RDNH claim.²⁵³ This idea, which finds no support in the UDRP itself, invites parties to keep on filing complaints until they either get it right, strike it lucky, find a compliant dispute services provider, or wear down their opponent. The UDRP is intended for truly clear cases of cybersquatting. If a party cannot make its case clearly enough or if the facts are complex, the matter belongs in court. It is bad enough that trademark owners get two bites at the apple—one in the UDRP and one in court. They do not need a whole barrel of bites before having to face a real judge. The rules should be amended to make it clear that complainants get only one try, before one provider.

5. Avoidance of Joinder; Need for Joinder

The UDRP assumes that all proceedings will be one plaintiff against one defendant. Nevertheless, some providers have allowed cases to go forward against multiple defendants, notably in cases in which it was unclear which of the defendants had the domain name. Certainly if there is going to be joinder of this sort, the structure of the UDRP needs to be

²⁵³ See, e.g., *Kee Byrd Prods., Inc v. robinbyrd-men-for-men.com*, No. AF-0898 (eResolution Aug. 3, 2001), <http://www.disputes.org/eresolution/decisions/-0898.htm>.

reworked to provide for complex joinder questions. It would probably be better to avoid the effort, but only if a means could be found to make arbitration service providers follow the rules as they currently exist.

Worse, however, are the cases where two different complainants with arguable claims to a domain name bring actions before separate arbitration service providers, or even the same one, claiming the same domain name.²⁵⁴ The UDRP needs a mechanism to recognize that such multiple claims exist, and to avoid giving a domain name to the first to reach the virtual courthouse either by consolidating the proceedings, or by aborting them all. Most multiple claimant cases are likely to be sufficiently complicated to be beyond the ability of as lightweight a process as the UDRP; those cases belong in court. This may be somewhat unfair to the claimants, especially if it results in a cybersquatter holding onto the name longer than he otherwise would, but the UDRP contains no principles that would allow an arbitrator to choose among two legitimate trademark holders, and the attempt to draft any such principles would be a nightmare.

6. Complainants Should Take Their Two Bites In the Right Order

Whatever the merits of letting people unhappy with UDRP outcomes go to court, it is clearly undesirable to have parties dissatisfied with court decisions attempt to reverse them by filing a subsequent UDRP action. Astonishingly, this is what happened in the *Cello.com* case.²⁵⁵ The holder of the “cello” trademark for high-end stereo equipment filed an action in federal district court against Storey, the holder of the *cello.com* domain name. After a published decision denying cross motions for summary judgment,²⁵⁶ the parties reached a settlement and the district court dismissed the matter *with*

²⁵⁴ This alas is not a hypothetical case. The *ipx.com* domain name was the subject of simultaneous challenges from two different complainants, one of whom filed with WIPO, and the other with CPR. Compare WIPO D2002-0116 (*ipx.com* “Compliance Review Pending”) with CPR 0205 (*ipx.com* “Pending”).

²⁵⁵ See *Storey v. Cello Holdings, L.L.C.*, 182 F. Supp. 2d 355 (S.D.N.Y. 2002).

²⁵⁶ *Cello Holdings, L.L.C. v. Lawrence-Dahl Co.*, 89 F. Supp. 2d 464 (S.D.N.Y.2000).

prejudice. The trademark holder then invoked the UDRP and filed a complaint against Storey on the same facts. The (Canadian) arbitrator refused to recognize the U.S. federal court's dismissal "with prejudice" as *res judicata*.²⁵⁷ He not only entertained the case, but *found for the complainant*, thus in effect reversing the district court.²⁵⁸ Storey was forced to bring a new federal action, this time as plaintiff. Ultimately, however, the court not only found for Storey, but imposed Rule 11 sanctions against the trademark holder, finding that it "acted to harass Storey and to cause both unnecessary delay and needless increase in the cost of litigation." The district court judge stated, "Based on my familiarity with and supervision of the proceedings in this case as well as the first action, I have no doubt that Cello, with substantially greater resources than Storey, sought to wear Storey down."²⁵⁹

Allowing matters to go to the UDRP after they have gone to court almost ensures inconsistent outcomes of benefit to no one. The UDRP needs to be modified to make this impossible unless both sides explicitly consent.

²⁵⁷ The only possible defense for the arbitrator's conduct is that the trademark holder appears to have at least negligently and perhaps fraudulently mis-stated the procedural history of the case in its submissions. In the portion of the complaint form that asked for a description of "any other legal proceedings that have been commenced or terminated in connection with or relating to the contested domain name(s)," it stated:

This issue began with a Complaint filed 16 Oct. 1997 in the United States District Court for the Southern District of New York, 97 Civ. 7677. The case has dragged on for almost three years without resolution and with significant expense. Cello Holdings LLC voluntarily dismissed the case last month so as to avail itself of this dispute resolution policy which was not available at the time of the 1997 filing, thereby saving significant time and expense over the continued litigation.

Storey, 182 F. Supp. 2d at _____. This left out the key fact of the dismissal with prejudice.

²⁵⁸ *Cello Holdings v. Storey*, Case No. Af-056, (e Resolution Dec. 21, 2000), <http://www.eresolution.com/services/dnd/decisions/0506.htm>.

²⁵⁹ *Id.*

C. *Time and Computation of Time*

1. Notice and Attachments

As noted above, the UDRP not only fails to require actual notice, or even reasonable efforts calculated to achieve timely notice, but it unfairly starts the ridiculously short clock for a response when a complaint is sent, not when it is received.

The solution is simple. The period for responding should be at least tripled, and the clock should not start to run until the entire complaint has been received, or proof is made of efforts reasonably calculated to achieve actual notice of the entire complaint.²⁶⁰ Furthermore, complainants should be penalized for using attachments to get around the word limits on complaints and doubly penalized for using paper attachments. A suitable penalty would be to extend the registrant's period to reply by five days for the first five pages of attachments—except for evidence of registration of the mark—and one day for each additional page, with double penalties for paper rather than digitized attachments.

Opponents to this solution might argue that, at least once there is actual notice, the current twenty-day period is sufficient for a response. After all, the *Federal Rules of Civil Procedure* offer a defendant in a civil case only twenty days to file a defense.²⁶¹ If this time period is good enough for the *Federal Rules*, it should be good enough for the UDRP. This argument is mistaken. First, as any practitioner knows, a substantive answer to a federal complaint is almost never made within the twenty days specified in the *Federal Rules*. In some courts, extensions of time are given liberally or agreed between the parties.²⁶² The UDRP does not allow this; indeed,

²⁶⁰ Since there is a genuine problem with false contact details provided for some infringing uses of domain names, itself circumstantial evidence of bad faith, it would be an over-reaction to require actual notice in all cases.

²⁶¹ See FED. R. CIV. PROC. 12(a).

²⁶² Indeed, there are incentives for the voluntary extension of time, among them the thought that time is a two-way street, and both sides may need extensions at one point or another in a long trial, and the desire not to give the judge the idea that one is deploying "scorched earth" litigation tactics.

it gives complainants every incentive to hope for a default. Second, as a practical matter, even without an extension of time, no federal court will grant a default judgment in twenty days.²⁶³ Most importantly, the initial answer to a civil complaint in federal court ordinarily is more a matter of form than substance. A typical first reply will admit the most obvious facts not in dispute, and submit a general denial to everything else. A first reply is far from the last word, and ordinarily will be supplemented by various motions, amended pleadings, and the like. Indeed, the defendant's first reply frequently comes at a time when the party has yet to marshal the evidence and work out a theory of the case, much less plead it. In contrast, a respondent in a UDRP has to find counsel, gather evidence (some of which may be located in a foreign country and language if the validity of the complainant's trademark is uncertain), marshal his arguments, and file. The UDRP effectively gives a respondent only twenty days to do what would take several months in an ordinary federal lawsuit, even though the complainant has had as long to prepare as he wanted. Given this, even sixty days is quite a short period for the average respondent to mount a competent defense, and may be one factor that explains the current very high rate of respondent defaults.²⁶⁴

2. Removal of the NAF "Sandbag" Rule and Its ilk

The NAF "sandbag" rule²⁶⁵ is one of the most pernicious examples of a provider's attempt to distinguish itself as plaintiff-friendly. A rule that allows a party to pay to put in a surprise pleading, perhaps with new factual allegations or even a new case in chief, is not a rule calculated to achieve justice. Allowing the other party to respond at additional cost is not much help. Either ICANN needs to decide that the rule violates the existing rules of procedure, or the rules of procedure need to be rewritten to ensure that if a party

²⁶³ Also, a default can be set aside for lack of notice. FED. R. CIV. PROC. 55(c), 60(b).

²⁶⁴ On UDRP default rates and their causes, see Michael Geist, *Fundamentally Fair.com? An Update on Bias Allegations and the ICANN UDRP*, at <http://www.udrpinfo.com/resc/fairupdt.pdf> (last visited Apr. 22, 2002).

²⁶⁵ See *supra* notes 202-05 and accompanying text.

introduces a supplemental brief of any kind, the other party, automatically and without extra payment, shall have an equal right to respond. More generally, ICANN needs to set up some continuing procedure by which someone can quickly hear complaints that a provider's supplemental rules violate the UDRP. Who that someone should be is a vexing question, however, as there is no reason to believe that ICANN itself has the energy or competence to do this.

3. Helping Respondents Find an Arbitrator

Respondents who have the opportunity to appoint an arbitrator need a better means to locate persons whose schedules permit them to accept the appointment. Otherwise the chance to appoint a member of the panel will be wasted. Ideally this appointment would be centralized in some manner to avoid the danger that litigants would "pollute" the pool of possible arbitrators by making improper *ex parte* communications as part of their inquiries.

4. Special Rules for Default Judgments?

Although the cause behind the high rate of respondent defaults is unclear, it may be that in some cases the respondent defaults are truly cybersquatted domains with false contact details, or hopeless facts. Thus, the default rate is a sign that the UDRP is working well. On the other hand, the constrained time limits and UDRP's poor service provisions may be preventing registrants with meritorious cases from mounting an effective defense. If fixing the time and notice problems noted above causes the default rate to fall substantially, we will have a good indication as to what originally caused that high default rate.²⁶⁶ In any case, without more data it may be premature to advocate any special rules for default judgments other than to amend the rules to reiterate the complainant's burden of establishing a case whether or not there is a reply. I thought this burden was

²⁶⁶ It will not be absolute proof, since it is always possible that the clearest cases were litigated first.

obvious from UDRP ¶ 4(a), but in practice, this has not been clear to all arbitrators.²⁶⁷

The suggestive fact regarding defaults is that the default rate for cases filed with arbitration service provider eResolution before its demise was between ten and twenty percent lower than cases filed with competing providers. eResolution was also the only provider that delivers all the complainant's documents, including attachments, online. Respondents were also allowed to file all responsive pleadings and documents online.²⁶⁸ eResolution's online filing system may have been sufficiently faster or more user-friendly than the substantially paper-driven systems used by competitors, facts that may have contributed to the complainants' bar's decision to shun it. Perhaps the UDRP should be changed to require all providers to migrate to fully online systems.

D. *Court Review*

1. Ensuring Even Unequal Access to Court

Ensuring that registrants would have some sort of access to a judge after losing an arbitration was a critical element of the original compromise that produced the UDRP. As described above, WIPO's draft did a poor job of this; one of the major advances of the ICANN draft was that because it required only a filed complaint in a court of competent jurisdiction rather than an actual emergency injunction, it seemed to do better. Better, but not well: The UDRP timetable allows the mark holder to take as long as he wishes to file a complaint, then puts the respondent on a short timetable to respond. If the markholder loses the arbitration, he again has as long as he wishes to file in court; if the registrant loses, he has only ten days to block the name transfer. Meanwhile, the

²⁶⁷ I have had personal correspondence with UDRP arbitrators who expressed greatly varying views on this issue.

²⁶⁸ See M. Scott Donahey, *The UDRP-Fundamentally Fair But Far From Perfect*, (2001), http://www.brownwelsh.com/Archive/Donahey_UDRP.pdf (last visited Apr. 22, 2002).

struggle in the *Corinthians.com* matter²⁶⁹ illustrates a problem that may reappear in other circuits and especially in other nations that do not create a specific right of action similar to that found in §1114 (2)(D)(v) of the ACPA. If a national court in a jurisdiction with an active population of domain name registrants were to follow the district court in the *Corinthians.com* case and hold that registrants have no way to bring a case after losing, it would break the fundamental fairness of the UDRP beyond repair.

2. Technical Amendments

As the drafters of the UDRP worked entirely in a private-law paradigm, we failed to consider what might happen if a sovereign party brought a claim. In particular, we failed to consider whether the consent to jurisdiction in the UDRP suffices to effect a waiver of sovereign immunity. I think it does, but this issue needs clarification.²⁷⁰

Another problem is how to head off the following procedural double feint by a determined and unscrupulous complainant.²⁷¹ Suppose a mark holder files a UDRP complaint, including the required admission of jurisdiction at, say, the registrar's location.²⁷² The mark holder then files a Lanham Act claim in federal court in his favorite jurisdiction. If the respondent loses the UDRP and chooses to file a declaratory judgment action within the ten-day period to stop the domain name transfer, the mark holder can force a dismissal of this action by informing the court of the previously-filed suit. After the ten days have lapsed, the mark holder can also dismiss the original UDRP action. Since both dismissals were without prejudice, the registrant can refile his action, but doing so will be too late to prevent the domain name transfer. Indeed, even if the registrant ultimately secured a declaration that the name was lawfully registered, the declaration would be meaningless because it provides no cause

²⁶⁹ See *supra* notes 224-25 and accompanying text.

²⁷⁰ Cf. *Virtual Countries, Inc. v. South Africa*, 148 F. Supp. 2d 256 (S.D.N.Y. 2001).

²⁷¹ Again, I am indebted to John Berryhill for this hypothetical.

²⁷² See UDRP Rules, *supra* note 18, §§ 3(b)(xiii), 1 (defining "mutual jurisdiction").

for the return of the domain name now registered by the mark holder. (Since the original registrant lacks a trademark, there would also be no grounds for a UDRP action.) Section 18 of the UDRP rules currently provides that:

In the event of any legal proceedings initiated prior to or during an administrative proceeding in respect of a domain-name dispute that is the subject of the complaint, the Panel shall have the discretion to decide whether to suspend or terminate the administrative proceeding, or to proceed to a decision.²⁷³

Revising this provision to *require* that the UDRP be halted if there are legal proceedings initiated prior to the UDRP should head off the procedural double feint.

Another amendment must address the problem of timely appeals from a judgment in a court of first instance. To allow a registrar to transfer a domain away from a registrant who loses an initial decision but makes a timely appeal risks making the appeal moot. If a party is prepared to file an appeal, perhaps within some deadline of the initial decision, that too should toll the name transfer for the same reasons as the filing of the initial complaint.

E. *The Language of the Agreement*

Holger Paul Hestermeyer has identified a fundamental problem with the UDRP that had previously escaped commentators.²⁷⁴ An official text of the UDRP exists only in English. Many countries, however, have consumer protection laws that require all consumer contracts concluded within the jurisdiction to be in the local language in order to be valid and enforceable. This condition is not satisfied by the UDRP's requirement that the proceedings be conducted in the language of the registration agreement.²⁷⁵ While this may not affect domain name registrations conducted across national boundaries, there are an increasing number of registrars around the world, and today consumers registering domain

²⁷³ UDRP Rules, *supra* note 18, § 18.

²⁷⁴ Holger P. Hestermeyer, *The Invalidity of ICANN's UDRP Under National Law*, 3 MINN. INTELL. PROP. REV. 1 (2002).

²⁷⁵ UDRP Rules, *supra* note 18, § 11(a).

names often have a local option. The absence of authorized and accepted translations of the UDRP means that registrars must either refer to the official English text or translate the UDRP into their native language. If they refer to the English text, they may make the agreement unenforceable against consumers in Germany, France, and other countries with similar language-related consumer protection laws.²⁷⁶ If, on the other hand, the registrars do their own translation, they run the risk of introducing material variations from the English text. Any material variations open the registrars to accusations of breach of contract when the arbitrators use the English text, which arbitrators are required to do, since the contract specified the materially different text in the local language. The issue of translation is far from trivial, since there are a lot of languages, and ICANN presumably lacks both the funds and the skill to do the translations. Meanwhile, the parties with the money and the skill, such as WIPO, may lack the trust of important segments of the affected communities given WIPO's mandate to further the protection of intellectual property.²⁷⁷

F. *Auditing for Quality and Fairness*

ICANN has created a "task force" to review the UDRP.²⁷⁸ This review is likely to prove difficult because key data are not easily available. One thing the task force should do therefore is take steps to ensure that the necessary data will be available in the future. Indeed, basic steps need to be taken to enhance the ability of outsiders to audit the performance of the UDRP. Without more data it is hard to monitor either the dispute providers or the arbitrators.

For example, one would like to be able to say something systematic rather than anecdotal about the quality (or lack thereof) of the decisions of the competing arbitration service providers. The decisions themselves do bear varying indicia of quality: clear decisions that follow from premises appear better

²⁷⁶ See Hestermeyer, *supra* note 274.

²⁷⁷ See *supra* text following note 198.

²⁷⁸ See ICANNWatch.org, *Names Council Selects UDRP Task Force Members*, at <http://www.icannwatch.org/article.php?sid=317> (Aug. 27, 2001). I am the representative of the non-commercial domain name holders' constituency on this Task Force.

than those that ramble, or appear to have been cut and pasted from earlier irrelevant cases.²⁷⁹ But overt indicia of quality are not sufficient to prove that the decisions are right, especially if there are reasons to fear bias. Unfortunately, the current UDRP makes it difficult to attempt to measure bias in any systematic way because decisions are published without the parties' submissions; unlike courts, in which briefs are ordinarily open public records, the parties' UDRP submissions are private. Indeed, there is not even a requirement that the dispute service providers keep archive copies, not to mention any provision for what happens when providers go out of business. Not only does this make independent judgments difficult, but it makes any review by ICANN unlikely to be

meaningful.²⁸⁰ Complaints and replies should be published online along with decisions, subject to redaction of confidential business information. Providers should be required to archive all briefs and exhibits for several years, and to make them available to researchers and others who want to study them.

²⁷⁹ See Kieren McCarthy, *The Register*, *WIPO Disgraces Itself Over CelineDion.com*, (Feb. 23, 2001), <http://www.theregister.co.uk/content/6/17161.html>.

²⁸⁰ The recent UDRP study by The Max Planck Institute, <http://www.intellecprop.mpg.de/Online-Publikationen/2002/UDRP-study-final-02.pdf>, falls into this trap: the evaluators looked at the decisions but without seeing the parties contentions it is impossible to make an informed decision as to whether the outcome is fair or not. Consider, for example, *Out2.com, Inc. v Rustom Corp.*, No. FA0010000095896 (NAF Dec. 20, 2000), <http://www.arbforum.com/domains/decisions/-95896.htm>. The entire discussion of the merits of the respondent's case is as follows: "Moreover, even if Respondent's late-filed Response were considered, the Panel finds that Respondent failed to show in that Response that Complainant would not be entitled to the requested relief." And the discussion of the reasons for denying a late filing are almost as conclusory:

Although Respondent contacted the Forum, after the deadline for filing a response, and asserted lack of notice, Complainant replied with documents showing such notice. . . . The record permits inferences that appropriate effort was made to give notice to Respondent at the addresses provided by Respondent. Respondent is required to provide correct addresses to the Registrar and if Respondent failed to do so, that does not place a higher burden on those dealing with Respondent to find it where it really is rather than where Respondent notified those dealing with it that it was located

Id. I defy anyone reading the above to make an informed judgment as to whether the arbitrator was right or not. There is more exposition in the decision regarding what complainant alleged on the merits, but even then the opinion mostly refers to it being supported by "evidence on the record" without telling what the evidence might be. See *id.*

Bias can manifest itself in very subtle ways. Suppose an arbitral body has 100 arbitrators in its stable. If the provider believes that some of them have a good-faith leaning in a particular direction, the provider can influence results by giving them a disproportionate number of cases, be it more or less than the average. Even if none of the arbitrators are biased, a provider can still subtly manipulate outcomes. Suppose there is a controversial issue of law where courts themselves are divided. An example might be what rights franchisees have to use trademarks belonging to franchisors in the absence of any explicit agreement covering the Internet or domain names.²⁸¹ Suppose a case raising this issue comes before a tribunal and an arbitrator rules for the franchisor, considering this to be the better view of the law. UDRP decisions are not precedent; a subsequent panel has no duty to follow it. However, a competent arbitrator is very likely to take a consistent view of contested legal questions from case to case. If the provider continues to select this arbitrator for cases involving franchisor/franchisee controversies, perhaps on the grounds of “experience with such matters,” the result is to lock in one view of a contested legal issue in a way that favors one side.

There is no question that a small number of arbitrators have heard a disproportionate number of cases and that others have heard very few.²⁸² The UDRP should require that arbitration service providers use neutral, documented, and transparent criteria to select the arbitrator for any given case.

²⁸¹ Cf. Gaylen L. Knack & Ann K. Bloodhart, *Do Franchisors Need To Rechart The Course To Internet Success?*, 20 WTR FRANCHISE L.J. 101 (2001).

²⁸² See Geist, *supra* note 141. Speaking as an UDRP arbitrator, I have to say that I find one part of NAF’s response to the Geist article to be specious at best. NAF argued that the reason a small number of arbitrators decided the overwhelming majority of its uncontested cases (almost invariable for the complainant) and that certain other arbitrators had never been selected (those who had some history that suggested they might not be as deferential to complainants), is that uncontested cases are duller, and those arbitrators were generously taking on the extra burden. See Reuters, *Domain Disputes Don’t Get Fair Hearing, Study Says*, Aug. 20, 2001, <http://www.siliconvalley.com/docs/news/tech/073106.htm> (quoting Edward Anderson, managing director of the NAF, as saying, “A lot of people don’t want to do default cases. Not everybody wants to do uninteresting stuff.”). This is largely nonsense: uncontested cases are almost always much less work than contested ones, if only because there’s half as much to read, but they pay no less. Furthermore, I have it on the authority of a NAF panelist who has never had an uncontested case that he was never asked if he was willing to shoulder this “burden.”

Indeed, subject to the necessary limitations imposed by the need to select arbitrators fluent in the language of the proceedings and familiar with the relevant law, arbitrators in the qualified pool should be selected randomly. WIPO, for example, has never selected Dr. Milton Mueller, one of its arbitrators who happens to be the author of a report suggesting pro-complainant bias in the UDRP,²⁸³ as the panelist in a sole-arbitrator case.²⁸⁴ It is hard to imagine why this might be other than a fear it would be bad for business. One sees no such preference applied against arbitrators whose background or track record suggests they are happy to find for complainants.²⁸⁵

Finally, much greater thought needs to be given to how arbitrators are selected in the first place—and what it takes to get an arbitrator removed from a provider's list. No amount of random selection will suffice if a provider's entire list is drawn from a like-minded community of trademark lawyers with large institutional clients.

CONCLUSION

The UDRP had a strange genesis. ICANN, supposedly a technical coordination body for a key part of the Internet, and undoubtedly a body without much legal expertise, based the UDRP on recommendations by WIPO, but made a considerable number of changes of its own. While the substantive parts of the UDRP received considerable attention before WIPO and ICANN, and may reflect as much consensus as could be achieved given the very rapid timeframe ICANN imposed, the procedural parts received far less scrutiny at all stages of the UDRP's evolution, and are not of high quality.

The UDRP can be seen as the latest part of a general move to shift dispute resolution towards ADR and away from traditional adjudication.²⁸⁶ Online arbitration is relatively new,

²⁸³ See Mueller, *supra* note 141.

²⁸⁴ Personal communication from Dr. Milton Mueller, February 12, 2002.

²⁸⁵ The decision records of arbitrators can be examined at [UDRPinfo.com](http://www.udrpinfo.com), <http://www.udrpinfo.com> (last visited Mar. 27, 2002).

²⁸⁶ See, e.g., European Commission, Commission Recommendation of Apr. 4, 2001 on the principles for out-of-court bodies involved in the consensual resolution of consumer disputes, (2000/310/EC) L 109/56; Gillian K. Hadfield, *Privatizing*

and new processes inevitably experience teething pains; for online ADR, it appears that these pains have been severe. As a recent study by Consumers International of thirty online arbitration providers put it, “consumers at present cannot and should not trust that alternative dispute resolution systems available online can offer adequate redress.”²⁸⁷ Indeed, more traditional ADR, without the online component, has attracted much blame²⁸⁸ as well as praise.²⁸⁹

Even viewed in this most generous context, however, the procedural design of ICANN’s UDRP has a number of special features that resulted in an especially unjust set of outcomes. Key decisions were made by unrepresentative groups or persons who were not subject to any democratic control, and the rules went into effect because of ICANN’s monopoly over technical aspects of the Internet, not because any legislature approved them.²⁹⁰ Perhaps because the drafters, both in WIPO and in ICANN, attempted to model the substantive parts of the UDRP on an emerging international

Commercial Law, REGULATION 40 (Spring 2001) (“By privatizing . . . we could gain the benefits of decentralized innovation and cost-reduction in the design of legal rules Privatization holds out the promise of reducing the cost and increasing the effectiveness of commercial law.”); Mark Seidenfeld, *An Apology for Administrative Law in “The Contracting State,”* 28 FLA. ST. U. L. REV. 215 (2000); see also ICC Electronic Commerce Project, Task Force on Jurisdiction and Applicable law in Electronic commerce, *ICC draft discussion paper on jurisdiction and applicable law in electronic commerce* (Apr. 12, 2001) (advocating increased e-ADR for B2C disputes).

²⁸⁷ Consumers International, *Disputes In Cyberspace* 5), at http://www.consumersinternational.org/campaigns/electronic/adr_web.pdf (2000) (on file with author).

²⁸⁸ See, e.g., Chris A. Carr & Michael R. Jencks, *The Privatization of Business and Commercial Dispute Resolution: A Misguided Policy Decision*, 88 KY. L.J. 183 (1999-2000) (arguing that development of common law is threatened if too many business disputes are removed from court system); Paul D. Carrington & Paul H. Haagen, *Contract and Jurisdiction*, 1996 SUP. CT. REV. 331; Ronald J. Krotoszynski, Jr., *The New Legal Process: Games People Play and the Quest for Legitimate Judicial Decision Making*, 77 WASH. U. L.Q. 993 (1999); Jean R. Sternlight, *Panacea or Corporate Tool? Debunking the Supreme Court’s Preference for Binding Arbitration*, 74 WASH. U. L.Q. 637 (1996); Johanna Harrington, Comment, *To Litigate or Arbitrate? No Matter—The Credit Card Industry is Deciding for You*, 2001 J. DISP. RESOL. 101 (“consumers lose their legal protections in the credit industry when arbitration policies are favored over consumer credit protection policies”).

²⁸⁹ See, e.g., Steven J. Ware, *Default Rules from Mandatory Rules: Privatizing Law Through Arbitration*, 83 MINN. L. REV. 703 (1999).

²⁹⁰ Alternately, one might view the UDRP experience as tending to support Prof. Drahozal’s observation that “[a]rbitration clauses are most problematic when market constraints on opportunistic behavior are least effective.” Christopher R. Drahozal, “Unfair” Arbitration Clauses, 2001 U. ILL. L. REV. 695, 771.

consensus against cybersquatting, and especially on an emerging U.S. consensus exemplified by the *Toeppen* decision and later by the ACPA, the greatest flaws emerged in the newest parts of the UDRP—the procedural provisions. That these parts also received the least attention and open debate only exacerbated the problem.

The UDRP's procedural component needs reform. These reforms, at a minimum should include the following:

A. *Basic Fairness Issues*

The UDRP must be changed to remove any incentive for arbitration providers to be “plaintiff-friendly,” and to equalize both sides’ influence on the selection of the arbitrators, specifically:

- Plausible claims of arbitration-provider bias need an appropriate forum.
- Parties need an enhanced means to get information about arbitrators’ possible conflicts of interest and to act on that information.
- Complainants should be required to post a small bond that would be forfeited in the event of a finding that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding.
- Consumers should have access to an authoritative copy of the UDRP in their national language.
- Providers’ methods of recruiting and assigning arbitrators should be open and auditable. Some thought should be given to the issues of panelist training, qualification, and selection, especially with an eye towards ensuring a broad pool of arbitrators, and removing opportunities for provider manipulation of panelist selection.
- Complaints and replies should be published online along with decisions in order to increase confidence in the justice of outcomes, subject to redaction of confidential business information which should be segregated in limited exhibits. Providers should be required to archive all briefs and exhibits for several years, and to make

them available after a reasonable time to researchers and others who want to study them, with some provision for redaction of the most sensitive personal and financial data.

B. *Practice and Procedure Under the UDRP*

Arbitrators should be instructed even more explicitly as to what constitutes meeting the complainant's burden of proof.

- The UDRP should specify that neither settlement negotiations nor solicited offers of sale constitute evidence of registrant bad faith.
- Either the UDRP should spell out in some detail what sort of evidence will be considered proof of the existence of a common law mark, or the UDRP should be limited to registered marks.
- UDRP decisions should be final within the system—any complaint that elicits a reply should not be subject to a “dismissal without prejudice” that invites complainants to try and try again.
- The UDRP should not allow parties even to attempt to undermine a final decision on the merits by a court of competent jurisdiction.
- The rules should require actual notice or greater efforts reasonably calculated to achieve actual notice, especially in countries with inferior postal systems.
- Given that many respondents are consumers or small businesses, the minimum time to respond to a complaint should be increased to sixty days to reflect the amount of time it takes to locate and brief counsel, collect facts, and write a brief to which no amendments are permitted.
- Complainants should be penalized for filing lengthy attachments and exhibits in an attempt to evade word limits, and for submitting most non-digitized material. Either behavior should entitle complainants to extra time on a graduated scale depending on the severity of the offense.

- Providers need to be prevented from writing supplemental rules that violate the UDRP or unfairly favor either party. Parties need a means to challenge supplemental rules, and ICANN or some other party needs to be ready to decide these challenges quickly.
- Procedures need to be created to help unrepresented parties represent themselves more effectively, and especially to help them select an arbitrator for three-member panels.
- More investigation is needed into the causes of the high rate of default judgments and the extent to which these cases are being decided fairly.

C. *Ensuring Equal Access to Courts*

One of the critical parts of the compromise that produced the UDRP was an assurance that if, as has proved too often to be the case, the arbitrators rendered an irrational judgment then either party would have the option of taking the matter to a court for de novo consideration. One of the major advances of the UDRP over the WIPO draft was that it attempted to create conditions in which a losing registrant had a chance—however cramped and rushed that ten-day window might be—to take the matter to court. If, for reasons akin to those set out in the *Corinthians.com* decision,²⁹¹ U.S. courts (or those of another major jurisdiction) were to close off access to the courts for de novo “appeals” of UDRP decisions, then the fundamental “parity of review” that underwrites whatever legitimacy current system has would be eliminated. Were this to happen, the UDRP would have to be completely revised, or even eliminated.

In addition to the more fundamental structural problems, the time line of the current system is already biased towards mark holders, who have as long as they want to prepare their UDRP claim, and as long as they want to bring their claim in court, subject only to the weak constraint of possible laches. In contrast, in the current system registrants

²⁹¹ See *supra* notes 202-05.

have twenty days to respond to a UDRP claim, and only ten days to challenge an adverse UDRP decision. Telling registrants that they have twenty days to respond to a UDRP claim, and if they lose that's it (but if they win the other side can go to court) is so unfair that even the UDRP could not countenance it.

Or, at least, so one might hope. The UDRP is as bad as it is because primary drafting authority was in the hands of groups dominated by trademark partisans who were very, perhaps overly, concerned about cybersquatting. The initial drafter, WIPO, exists to promote intellectual property rights. The subsequent ICANN process was, and remains, captured by a coalition of trademark interests and other businesses who believed that they needed to appease the trademark interests to achieve their goal of getting clearance to create additional top-level domains. The conditions that caused the UDRP are still present today in the ICANN domain name servicing organization and the ICANN Board, so substantial reform from within the ICANN process is far from obvious. It remains the case that if you put a committee of foxes in charge of a chicken coop, you tend to get a lot of happy foxes and dead chickens.

D. *Lessons From the UDRP*

The UDRP experience has a few things to teach us more generally about the promise and perils of privatized law making and about law's relation to the Internet. ICANN requires all registrants in gTLDs such as .com to agree to a mandatory online dispute resolution process. It is often said, with some justice, that "code is law."²⁹² In the case of ICANN's UDRP, however, the code itself did not determine any particular outcome. Rather than code being law here, the code (or rather the Internet standards and practices that made control of the root critical), simply provided an opportunity for private lawmaking. Thus, the code or standard was more properly characterized as constitutional, or more precisely, a source of power akin to H.L.A. Hart's second order rules.²⁹³

²⁹² See LAWRENCE LESSIG, CODE AND OTHER LAWS OF CYBERSPACE (1999).

²⁹³ H.L.A. HART, THE CONCEPT OF LAW (1961).

Indeed, because ICANN imposed its rules on domain name registrants by contract, in the case of the UDRP “law is law” rather than “code is law.” The critical issue is who makes that law—who drafts the UDRP and who administers it. The key effect of the DNS code here is that it allows the law that controls to be private law—contract terms imposed by ICANN, ostensibly a private corporation, albeit with the advice of an international body and a government. Were it not for the chokepoint, the single point of failure, created by the hierarchy underlying the DNS, then the law would have been public law, imposed either by statute or by an international agreement, which would have required a very different adoption process, and likely would have had a different outcome. Due process, for starters.

NOTES, CREDITS, DISCLOSURES

The ICANN process is noteworthy for the ease with which people toss around accusations of personal bias. Lengthy disclosures are thus essential. Here are mine: I participated in both the first WIPO Domain Name Process and in many of the ICANN deliberations that created the UDRP, giving me personal experience of the origins of the UDRP but also risking a skewed and partisan perspective. I served as a member of the purely advisory Panel of Experts empaneled by WIPO to assist it with its report. I disagreed with substantial portions of that final report and said so in A. Michael Froomkin, *A Commentary on WIPO's The Management of Internet Names and Addresses: Intellectual Property Issues*, at <http://www.law.miami.edu/~amf/commentary.pdf> from which portions of this paper are derived. I was also a member of the so-called "small drafting committee" that advised ICANN on the UDRP, see *Second Staff Report on Implementation Documents for the Uniform Dispute Resolution Policy*, § 2.4, at <http://www.icann.org/udrp/udrp-second-staff-report-4oct99.htm> (Oct. 24, 1999), although I have my differences with it as well. See A. Michael Froomkin, *Comments on ICANN Uniform Dispute Policy: A Catalog of Critical Process Failures; Progress on Substance; More Work Needed*, at <http://www.law.miami.edu/~amf/icannudp.htm> (Oct. 13, 1999). I was also director of disputes.org, which, in partnership with eResolution.ca, was until its demise one of the dispute resolution providers accredited by ICANN. Between the original submission of this Article and its going to press, [eResolution](http://eResolution.ca) folded, cited shrinking market share due to the complainants' bar's preference for providers they though would enhance their chances of winning. See David Post, *eResolution out of UDRP business*, <http://www.icannwatch.org/article.php?sid=484> (Nov. 30, 2001).

Currently, I am a representative to ICANN's UDRP Review Task Force. I am also a co-founder of ICANNWatch.org, a group founded to increase awareness of ICANN's activities. The views expressed in this Article are my own and should not be attributed to the Task Force or to ICANNWatch.org, or indeed anyone who does not affirmatively associate himself or herself with them.

WIPO



SCT/11/7

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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

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

Eleventh Session
Geneva, November 10 to 14, 2003

SUMMARY BY THE CHAIR

Agenda Item 1: Opening of the Session

1. Mr. Shozo Uemura, Deputy Director General of the World Intellectual Property Organization (WIPO), opened the session and welcomed the delegates on behalf of the Director General of WIPO.

Agenda Item 2: Adoption of the Draft Agenda

2. The SCT adopted the Draft Agenda (document SCT/11/1 Prov.) without modifications.

Agenda Item 3: Adoption of the Draft Report of the Tenth Session

3. The SCT adopted the Draft Report (document SCT/10/9 Prov.2) with minor modifications.

Agenda Item 4: Revision of the Trademark Law Treaty

4. The Standing Committee discussed the documents concerning the Draft Revised Trademark Law Treaty (TLT) (document SCT/11/2), Draft Revised Regulations under the Draft Revised Trademark Law Treaty (document SCT/11/3) and Notes (document SCT/11/4) and agreed, as follows:

Draft Article 8

Paragraph (1). There was consensus on this provision.

Paragraph (2), subparagraphs (a), (b) and (c). There was consensus on this provision.

Paragraph (3). Following discussion, consensus was reached on this provision as redrafted.

Paragraph (4), subparagraphs (a), (b) and (c). There was consensus on this provision as modified in Informal Document 2 prepared by the International Bureau.

Paragraph (5). There was consensus on this provision as redrafted.

Paragraph (6). There was consensus on this provision.

Paragraph (7). There was consensus on this provision.

Paragraph (8). There was consensus on this provision as redrafted. However, the inclusion of a reference to paragraph (2) was referred to the International Bureau for further study.

Draft Article 13*bis*

Paragraph (1). There was consensus on this provision as redrafted. However, some parts were referred to the SCT for further discussion concerning time limits.

Paragraph (2). There was consensus on this provision.

Paragraph (3). There was consensus on this provision.

Paragraph (4). There was consensus on this provision as redrafted.

Paragraph (5). There was consensus on the deletion of this provision. However, the inclusion of a reference to Article 13*bis* in Article 14 was referred to the International Bureau for further study and to the SCT for further discussion.

Draft Rule 6

Paragraph (1). There was consensus on this provision.

Paragraph (2). There was consensus on this provision.

Paragraph (3). There was consensus on this provision.

Paragraph (4). There was consensus on this provision as redrafted. However, one delegation was not able to join the consensus at this stage of the discussion.

Paragraph (5). There was consensus on this provision.

Paragraph (6). There was consensus on this provision.

Draft Rule 7

Paragraph (1). There was consensus on this provision.

Paragraph (2). There was consensus on this provision.

Paragraph (3). There was consensus on this provision.

Paragraph (4). There was consensus on this provision.

Paragraph (5)(a). There was consensus on this provision.

Paragraph (5)(b). There was consensus on this provision as redrafted.

Draft Rule 10

Paragraph (1). There was consensus on this provision as redrafted.

Paragraph (2). There was consensus on this provision as redrafted.

Paragraph (3). There was consensus on this provision as redrafted.

Paragraph (4). There was consensus on this provision as redrafted. However, the inclusion of a time limit was referred to the International Bureau for further study.

Paragraph (5). There was consensus on this provision as redrafted. However, item (iii) was referred to the International Bureau for further study and to the SCT for further discussion.

The text reflecting the results of the deliberations on Articles 8 and 13*bis* and Rules 6, 7 and 10 is contained in the Annex.

Chapter II: Trademark Licenses

After a general exchange of views which showed a difference of opinions as to whether this chapter should be included in the revised TLT, the Committee decided to pursue the examination of the provisions contained in Articles 17 to 21 at the next meeting of the SCT.

Agenda Item 5: Internet Domain Names

5. With regard to the issues considered in paragraph 13 of document SCT/10/5 (“The Protection of Country Names in the Domain Name System”), the SCT decided to inform ICANN that no recommendation would be made to extend protection to names by which countries are familiarly or commonly known.

6. In respect of the question of sovereign immunity of States, referred to in paragraph 18 of document SCT/10/5, the SCT decided to inform ICANN that no recommendation would be made to establish a special appeal mechanism by way of *de novo* arbitration.

7. With regard to the issue of domain names and geographical indications, further discussion was requested.

Agenda Item 6: Geographical Indications

8. With regard to the issue of geographical indications, further discussion was requested.

Agenda Item 7: Other Matters

9. The Committee was reminded that replies to the Questionnaire on Trademark Law and Practice (document SCT/11/6) should be sent to the International Bureau before the end of the year.

10. It was suggested that the registration of well-known marks in national registries deserves consideration by the Committee.

11. It was suggested that the protection provided under Article 6*ter* of the Paris Convention deserves consideration by the Committee.

Agenda Item 8: Future Work

12. The SCT decided that priority should be given to the revision of the TLT. The SCT further agreed that its twelfth session would last five full working days and that the agenda of that session would devote at least four full days to work on the TLT, leaving the last day flexible for consideration of other issues including the WIPO Questionnaire on Trademark Law and Practice, Geographical Indications, Domain Names and Geographical Indications, Article 6*ter* of the Paris Convention and the registration of well-known marks.

13. The provisional date of the twelfth session of the SCT will be April 26 to 30, 2004.

[Annex follows]

Article 8
Communications

(1) [*Means of Transmittal of Communications*] Any Contracting Party may choose the means of transmittal of communications.

(2) [*Language of Communications*]

(a) Any Contracting Party may require that any communication be in a language admitted by the Office. Where the Office admits more than one language, the applicant, holder or other interested person may be required to comply with any other language requirement applicable with respect to the Office, provided that no indication or element of the communication may be required to be in more than one language.

(b) No Contracting Party may require the attestation, notarization, authentication, legalization or any other certification of any translation of a communication other than as provided under this Treaty.

(c) Where an Office does not require a communication to be in a language admitted by the Office, it may require that a translation of that communication by an official translator or a representative, into a language admitted by the Office, be supplied within a reasonable time limit.

(3) [*Presentation of a Communication*] Subject to paragraph (2), any Contracting Party shall accept the presentation of a communication, the content of which corresponds to the relevant Model International Form, if any, provided for in the Regulations.

(4) [*Signature of Communications*]

(a) Where a Contracting Party requires a communication to be signed, that Contracting Party shall accept any signature that complies with the requirements prescribed in the Regulations.

(b) No Contracting Party may require the attestation, notarization, authentication, legalization or other certification of any signature except,

(i) where the law of the Contracting Party so provides, if the signature concerns the surrender of a registration, or,

(ii) in the case of a signature in electronic form, as prescribed in the Regulations.

(c) Notwithstanding subparagraph (b), a Contracting Party may require that evidence be filed with the Office only where the Office may reasonably doubt the authenticity of any signature.

(5) [*Prohibition of Other Requirements*] No Contracting Party may require that a communication comply with requirements other than those prescribed in this Article or in the Regulations.

(6) [*Address for Correspondence, Address for Legal Service*] Any Contracting Party may, subject to any provision prescribed in the Regulations, require that an applicant, holder or other interested person indicate in any communication an address for correspondence and/or an address for legal service.

(7) [*Original of a Communication Filed in Electronic Form or by Electronic Means of Transmittal*] Where a Contracting Party permits the filing of communications in electronic form or by electronic means of transmittal, it may require that the original of any such communication, accompanied by a letter identifying that earlier transmission, be filed on paper with the Office within a reasonable time limit.

(8) [*Notification*] Where one or more of the requirements under paragraphs [(2), and (4) to (7)][(4) to (7)] are not complied with in respect of a communication [in a language admitted by the Office], the Office shall notify the applicant, holder or other interested person, giving the opportunity to comply with any such requirement, and to make observations, within a reasonable time limit.

Article 13bis
Measures in Case of Failure to Comply with Time Limits

(1) [*Measures*] A Contracting Party shall provide for at least one of the following procedures, in accordance with the requirements prescribed in the Regulations, for the case where an applicant, holder or other interested person fails [,or is about to fail,] to comply with a time limit for an action in a procedure before the Office in respect of an application or a registration, and that time limit is [less than][not more than][six months][three months]:

- (i) an extension of the time limit for a reasonable period of time,
- (ii) continued processing with respect to the application or registration, or
- (iii) reinstatement of the rights of the applicant or holder with respect to the application or registration, subject to a finding by the Office that the failure occurred in spite of due care required by the circumstances or, at the option of the Contracting Party, that the failure was unintentional.

(2) [*Exceptions*] No Contracting Party shall be required to provide for any of the procedures referred to in paragraph (1) with respect to exceptions prescribed in the Regulations.

(3) [*Fees*] Any Contracting Party may require that a fee be paid in respect of a request under paragraph (1).

(4) [*Prohibition of Other Requirements*] No Contracting Party may demand that requirements other than those referred to in this Treaty or in the Regulations be complied with in respect of the procedures provided for under paragraph (1).

Article 14
Opportunity to Make Observations in Case of Intended Refusal

An application or a request under Articles 10 to 13[*bis*] may not be refused totally or in part by an Office without giving the applicant or the requesting party, as the case may be, an opportunity to make observations on the intended refusal within a reasonable time limit.

Rule 6
Details Concerning the Signature Under Article 8(4)

(1) [*Indications Accompanying Signature*] Any Contracting Party may require that the signature of the natural person who signs be accompanied by

(i) an indication in letters of the family or principal name and the given or secondary name or names of that person or, at the option of that person, of the name or names customarily used by the said person;

(ii) an indication of the capacity in which that person signed, where such capacity is not obvious from reading the communication.

(2) [*Date of Signing*] Any Contracting Party may require that a signature be accompanied by an indication of the date on which the signing was effected. Where that indication is required but is not supplied, the date on which the signing is deemed to have been effected shall be the date on which the communication bearing the signature was received by the Office or, if the Contracting Party so allows, a date earlier than the latter date.

(3) [*Signature of Communications on Paper*] Where a communication to the Office of a Contracting Party is on paper and a signature is required, that Contracting Party

(i) shall, subject to item (iii), accept a handwritten signature;

(ii) may permit, instead of a handwritten signature, the use of other forms of signature, such as a printed or stamped signature, or the use of a seal or of a bar-coded label;

(iii) may, where the natural person who signs the communication is a national of the Contracting Party and such person's address is on its territory, or where the legal entity on behalf of which the communication is signed is organized under its law and has either a domicile or a real and effective industrial or commercial establishment on its territory, require that a seal be used instead of a handwritten signature.

(4) [*Signature of Communications Filed in Electronic Form or by Electronic Means of Transmittal Resulting in Graphic Representation*] Where a Contracting Party allows the transmittal of communications in electronic form or by electronic means of transmittal, it may consider such a communication signed if a graphic representation of a signature accepted by that Contracting Party under paragraph (3) appears on that communication as received by the Office of that Contracting Party.

(5) [*Signature of Communications Filed in Electronic Form Not Resulting in Graphic Representation of Signature*] Where a Contracting Party allows the transmittal of communications in electronic form, and a graphic representation of a signature accepted by that Contracting Party under paragraph (3) does not appear on such a communication as received by the Office of that Contracting Party, the Contracting Party may require that the communication be signed using a signature in electronic form as prescribed by that Contracting Party.

(6) [*Exception to Certification of Signature Under Article 8(4)(b)*] Any Contracting Party may require that any signature referred to in paragraph (5) be confirmed by a process for certifying signatures in electronic form specified by that Contracting Party.

Rule 7

Details Concerning Indications Under Article 8(5), (6) and (8)

(1) [*Details Concerning Indications Under Article 8(5)*]

(a) Any Contracting Party may require that any communication

(i) indicate the name and address of the applicant, holder or other interested person;

(ii) indicate the number of the application or registration of the mark to which it relates;

(iii) contain, where the applicant, holder or other interested person is registered with the Office, the number or other indication under which he is so registered.

(b) Any Contracting Party may require that any communication by a representative for the purposes of a procedure before the Office contain

(i) the name and address of the representative;

(ii) a reference to the power of attorney, or other communication in which the appointment of that representative is or was effected, on the basis of which the said representative acts;

(iii) where the representative is registered with the Office, the number or other indication under which he is so registered.

(2) [*Address for Correspondence and Address for Legal Service*] Any Contracting Party may require that the address for correspondence and the address for legal service, referred to in Article 8(6), be on a territory prescribed by that Contracting Party.

(3) [*Address Where No Representative Is Appointed*] Where no representative is appointed and an applicant, holder or other interested person has provided, as his address, an address on a territory prescribed by the Contracting Party under paragraph (2), that Contracting Party shall consider that address to be the address for correspondence or the address for legal service, referred to in Article 8(6), as required by the Contracting Party.

(4) [*Address Where a Representative Is Appointed*] Where a representative is appointed, a Contracting Party shall consider the address of that representative to be the address for correspondence or the address for legal service, referred to in Article 8(6), as required by the Contracting Party.

(5) [*Sanctions for Non-Compliance with Requirements*]

(a) No Contracting Party may provide for the refusal of an application on grounds of failure to comply with any requirement to file a registration number or other indication under paragraphs (1)(a)(iii) and (b)(iii).

(b) Where a notification has not been made because indications allowing the applicant, holder or other interested person to be contacted by the Office have not been filed, a reasonable time limit shall be granted before the Contracting Party applies such sanctions as is provided for in its law.

Rule 10

Requirements Relating to Measures in Case of Failure to Comply with Time Limits

(1) [*Request for an Extension of a Time Limit*] Where a Contracting Party provides for an extension of a time limit, it may require that the request

(i) be filed with the Office prior to the expiration of that time limit,

(ii) be signed by the applicant or holder or the representative of the applicant or holder,

(iii) contain an identification of the time limit in question.

(2) [*Request for Continued Processing*] Where a Contracting Party provides for continued processing it may require that the request

(i) be filed with the Office prior or after the expiration of that time limit,

(ii) be signed by the applicant or holder or the representative of the applicant or holder,

(iii) contain an identification of the time limit in question,

and that the omitted act be completed.

(3) [*Request for Reinstatement of Rights*] Where a Contracting Party provides for the reinstatement of the rights of the applicant or holder, it may require that the request

(i) be filed with the Office,

(ii) be signed by the applicant or holder or the representative of the applicant or holder,

(iii) contain an identification of the time limit in question,

(iv) set out the facts and evidence in support of the reasons for the failure to comply with the time limit,

and that the omitted act be completed.

(4) [*Time Limit for Filing a Request for Reinstatement of Rights Under Paragraph (3)*] A request for reinstatement of rights shall be filed within a reasonable time limit from the date of the removal of the cause of failure to comply with the time limit in question or, not less than [] months from the date of expiration of the time limit in question, whichever is the earlier.

(5) [*Exceptions Under Article 13bis(2)*] The exceptions referred to in Article 13bis(2) are the cases of failure to comply with a time limit:

(i) for which relief has already been granted under Article 13bis(1)(i) or (ii);

(ii) for making a request for relief under Article 13bis(1)(i) or (ii) or a request for reinstatement under Article 13bis(1)(iii);

[(iii) for payment of a renewal fee];

(iv) for an action before a board of appeal or other review body constituted in the framework of the Office;

(v) for an action in *inter partes* proceedings;

(vi) for the correction or addition of a priority claim;

(vii) for filing the declaration referred to in Article 3(1)(a)(vii).

[End of Annex and of document]