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WIPO ARBITRATION AND MEDIATION CENTER, INCLUDING DOMAIN NAMES

Document prepared by the Secretariat

1. This document provides an update on the WIPO Arbitration and Mediation Center's ("Center") activities as an international resource for time- and cost-efficient alternatives to court litigation of intellectual property (IP) disputes, acting as an administrator of cases as well as a provider of legal and organizational expertise in alternative dispute resolution (ADR).
2. This document also provides an update on the domain name-related activities of WIPO, as previously reported in WO/GA/46/8.¹ It covers the Center's administration of domain name disputes under different policies and various related aspects of the Internet Domain Name System (DNS), as well as selected policy developments, including rights protection mechanisms (RPMs) for the introduction of new generic top-level domains (gTLDs), the planned future revision by the Internet Corporation for Assigned Names and Numbers (ICANN) of the Uniform Domain Name Dispute Resolution Policy (UDRP), and the status of the recommendations made by the Member States of WIPO in the context of the Second WIPO Internet Domain Name Process.

I. ARBITRATION AND MEDIATION OF IP DISPUTES

A. ARBITRATION AND MEDIATION CASE ADMINISTRATION

3. The Center has continued to optimize the potential of its mediation and arbitration procedures to meet the needs of IP right holders for time- and cost-effectiveness in the

¹ See http://www.wipo.int/edocs/mdocs/govbody/en/wo_ga_46/wo_ga_46_8.pdf.

resolution of disputes in relation to those rights. The principal component of this effort is quality management and resolution of cases conducted under those procedures, which entails training,² appointing, and supporting qualified arbitrators and mediators, and maintaining up-to-date case administration infrastructure, including through the use of information technology such as the WIPO Electronic Case Facility (ECAF).³ WIPO cases in the past year included those related to patents, trademarks, software, research and development (R&D), and franchising, and were filed with the Center by parties on the basis of prior contract clauses as well as submission agreements. Cases filed after June 1, 2014 were administered under the new WIPO Mediation and Arbitration Rules that came into effect on that date.⁴

B. ADR SERVICES FOR SPECIFIC SECTORS

(a) Collaboration with Intellectual Property Offices (IPOs)

4. In a recent development, the Center offers services to IPOs in their establishment of optional ADR frameworks. Such collaboration, which may also include training programs, promotional activities and case administration, aims to provide cost-effective and flexible options for parties to resolve their disputes before IPOs in relation to pending applications or granted rights.

5. Following the establishment in 2011 of a joint dispute resolution procedure to facilitate the mediation of trademark oppositions at the Intellectual Property Office of Singapore (IPOS), IPOS and the Center, with effect from April 1, 2014, established an optional dispute resolution procedure to facilitate the resolution of patent disputes pending before IPOS through expert determination. The Center also has been collaborating in the development of a mediation option for trademark proceedings before the Brazilian National Institute of Industrial Property (INPI-BR), which has designated the Center as the administrator of mediation cases where one or both parties are domiciled outside Brazil. As of May 4, 2015, the Intellectual Property Office of the Philippines (IPOP HL) designated the Center at the option of parties as administrator of mediation cases submitted with IPOP HL involving one or more parties domiciled outside the Philippines.

6. Further to the conclusion of an agreement with the Mexican Institute of Industrial Property (IMPI), the Center is collaborating with IMPI in the development of ADR processes and services for disputes pending before IMPI. Following agreements with the National Copyright Directorate of the Republic of Colombia and the Directorate General of Intellectual Property Rights of Indonesia (DGIPR), the Center is also collaborating on the development of ADR processes and services for disputes regarding certain rights in those jurisdictions.

7. Following conclusion of agreements, the Korea Copyright Commission (KCC) and the Korea Creative Content Agency (KOCCA) have been offering a WIPO mediation option to potential parties in cases involving an international party since February and May 2015, respectively.

(b) Fast-Track Procedure

8. The Center continued contact with trade fair organizers and associations to explore options for the use of ADR mechanisms to resolve IP disputes arising at trade fairs. In 2015,

² All workshops and other events organized by the Center are listed at <http://www.wipo.int/amc/en/events>.

³ ECAF offers online case communication and storage of documents facilitating time- and cost-efficient mediation and arbitration proceedings. See <http://www.wipo.int/amc/en/ecaf/index.html>.

⁴ See <http://www.wipo.int/amc/en/rules/newrules.html>.

the Center drafted the WIPO Fast-Track Intellectual Property Dispute Resolution Procedure for Palexpo Trade Fairs. This Palexpo Fast-Track Procedure aims to protect exhibitors' and non-exhibitors' IP rights in a cost- and time-efficient manner against infringement of copyright, trademarks, design rights or breach of law on unfair competition under Swiss law at Palexpo trade fairs held in Geneva, Switzerland. Decisions under the Palexpo Fast-Track Procedure are rendered by a sole expert within 24 hours after the request, and are enforceable with immediate effect at the trade fair. Each party may appeal the expert's decision in a WIPO Expedited Arbitration or in court. The Fast-Track Procedure was used for the first time at the 85th Geneva International Motor Show that took place at Palexpo from March 5 to 15, 2015.

(c) Trademarks Dispute Resolution

9. To stimulate the use of mediation by parties and reduce the negative impact of disputes in the productive use of trademark rights, the Center and the International Trademark Association (INTA) agreed in February 2015 on a collaboration that should raise the profile of mediation among INTA members.

(d) Patents in Standards Dispute Resolution

10. The Center continued collaborated with the European Telecommunication Standards Institute (ETSI) in the development and promotion of tailored arbitration model submission agreements that offer a framework for time- and cost-efficient resolution of disputes involving the determination of fair, reasonable and non-discriminatory (FRAND) licensing terms.⁵ The use of ADR for such disputes has been encouraged by competition authorities in some countries, and a number of standard-setting organizations include ADR procedures in their IP policies. The WIPO FRAND model agreements build on the Center's experience in complex patent arbitrations and propose a set of FRAND-specific features.⁶ WIPO FRAND Arbitration can be preceded by WIPO Mediation if parties so wish. Bearing in mind the settlement rates in WIPO mediations (70%) and WIPO arbitrations (40%), referral to the proposed WIPO procedures may stimulate positive opportunities for settlement of FRAND negotiations.

(e) R&D Dispute Resolution

11. Following collaboration with European R&D stakeholders,⁷ with German institutions,⁸ and with Austrian entities,⁹ the Center collaborated in the development of Model Agreements that seek to facilitate an efficient transfer of knowledge and technology. This includes collaboration with the Spanish Patent and Trademark Office (OEPM) in the development of Model R&D Agreements that offer WIPO Mediation and WIPO Expedited Arbitration options.

⁵ See <http://www.wipo.int/amc/en/center/specific-sectors/ict/frand/>.

⁶ Two different models are offered, namely (i) WIPO FRAND Arbitration, and (ii), for less complex cases, notably where the number of standard-essential patents that will be referred to arbitration is limited, WIPO FRAND Expedited Arbitration.

⁷ One such example involves multi-party collaborations funded under the European Union's Seventh Framework Programme EC (FP7), where entities use the "DESCA" model consortium agreement, which recommends WIPO mediation and expedited arbitration. DESCA, which stands for "Development of a Simplified Consortium Agreement", is a model consortium agreement initially developed for research projects funded by the European Commission under the Seventh Framework Programme (FP7). The DESCA model agreement is estimated to be used by some 75 per cent of companies, research organizations, universities and individuals involved in cross-border research projects funded by FP7. See <http://www.desca-fp7.eu/>.

⁸ See <http://www.bmwi.de/English/Redaktion/Pdf/sample-agreements-for-research-and-development-cooperation,property=pdf,bereich=bmwi,sprache=en,rwb=true.pdf>.

⁹ See <http://www.wipo.int/amc/en/center/specific-sectors/rd/ipag/>.

12. Also, as part of a broader effort under an MoU, the Center continued its collaboration with the Association of University Technology Managers (AUTM) to support efficient dispute resolution for university technology transfer offices around the world. Following the earlier conclusion of an MoU regarding green technology between WIPO and the Korea Technology Finance Corporation (KOTEC), a non-profit financial institution providing technology development guarantees to small and medium sized enterprises in the Republic of Korea, the Center and KOTEC agreed on May 14, 2015 to collaborate in the promotion of the use by KOTEC clients of WIPO ADR options.

(f) Franchising Dispute Resolution

13. As part of the WIPO ADR Services for Specific Sectors, the Center provides advice and case administration services to help parties resolve IP disputes arising in the area of franchising, without the need for court litigation. Notably, the Center collaborates with the Franchising and Licensing Association Singapore (FLA) and the Spanish Franchisors Association (AEF) to raise awareness of ADR options available to stakeholders in the franchising and licensing areas. Likewise, in May 2015, the Center and the Swiss Franchising Association (SFA) concluded an agreement to collaborate in the development of WIPO ADR processes and services for disputes involving SFA members.¹⁰

II. DOMAIN NAME CASE ADMINISTRATION

A. UDRP

14. The DNS raises a number of challenges for the protection of IP, which, due to the global nature of the Internet, call for an international approach. WIPO has addressed these challenges since 1998 by developing specific solutions, most notably in the First¹¹ and Second¹² WIPO Internet Domain Name Processes. Through the Center, WIPO provides trademark owners with efficient international mechanisms to deal with the bad-faith registration and use of domain names corresponding to their trademark rights. The principal mechanism administered by the Center, the UDRP, was adopted by ICANN on the basis of recommendations made by WIPO in the First WIPO Internet Domain Name Process.

15. The UDRP is limited to clear cases of bad-faith, abusive registration and use of domain names and has proven highly popular among trademark owners.¹³ Since December 1999, the Center has administered some 32,000 UDRP-based cases.¹⁴ Trademark holders in 2014 filed 2,634 UDRP-based complaints with the Center, an increase of 2% over 2013 filing. With the 2014 filing, the total number of domain names in WIPO UDRP cases approached 57,000.

¹⁰ See <http://www.wipo.int/amc/en/center/specific-sectors/franchising/>.

¹¹ The Management of Internet Names and Addresses: Intellectual Property Issues – Final Report of the First WIPO Internet Domain Name Process, WIPO publication No. 439, also available at <http://www.wipo.int/amc/en/processes/process1/report>.

¹² The Recognition of Rights and the Use of Names in the Internet Domain Name System – Report of the Second WIPO Internet Domain Name Process, WIPO Publication No. 843, also available at <http://www.wipo.int/amc/en/processes/process2/report>.

¹³ The UDRP does not prevent either party from submitting a dispute to a competent court of justice; but very few cases that have been decided under the UDRP have been brought before a national court of justice. See Selected UDRP-related Court Cases at <http://www.wipo.int/amc/en/domains/challenged>.

¹⁴ The Center makes available online real-time statistics to assist WIPO UDRP case parties and neutrals, trademark attorneys, domain name registrants, domain name policy makers, the media, and academics. Available statistics cover many categories, such as “areas of complainant activity”, “domain name script”, and “25 most cited decisions in complaint”. See <http://www.wipo.int/amc/en/domains/statistics>.

16. A diverse mixture of enterprises, institutions, and individuals used the Center's dispute resolution procedures in 2014. The top five sectors for complainant business activity were Retail, Banking and Finance, Fashion, Internet and Information Technology, and Heavy Industry and Machinery. Especially the filings related to fashion and luxury brands include those by rights owners alleging counterfeiting via the web pages offered under the disputed domain name. Reflecting the global scope of this dispute mechanism, named parties to WIPO cases through 2014 represented 177 countries. In function of the language of the applicable registration agreement of the domain name at issue, WIPO UDRP proceedings have so far been conducted in 21 languages.¹⁵

17. All WIPO UDRP panel decisions are posted on the Center's website. The Center offers a unique online overview of broad decision trends on important case issues via the WIPO Overview of WIPO Panel Views on Selected UDRP Questions (WIPO Overview 2.0). Distilling thousands of UDRP cases handled by the Center, this globally relied-upon instrument was created to help identify and stimulate consistency of WIPO UDRP jurisprudence.¹⁶ To facilitate access to these decisions according to subject matter, the Center also offers a widely used online searchable Legal Index of WIPO UDRP Decisions.¹⁷ These WIPO resources are made accessible globally free of charge.

18. Mindful of WIPO's foundational role in the UDRP, the Center monitors developments in the DNS with a view to adjusting its resources and practices.¹⁸ The Center regularly organizes Domain Name Dispute Resolution Workshops to update interested parties¹⁹ as well as meetings of its Domain Name Panelists.

B. COUNTRY CODE TOP-LEVEL DOMAINS (ccTLD)

19. While the mandatory application of the UDRP is limited to domain names registered in gTLDs, such as .com and more recently introduced new gTLDs, the Center also assists ccTLD registries in their establishment of registration conditions and dispute resolution procedures that conform with best practices in registry management and IP protection. These procedures are mostly modeled after the UDRP, but may take account of the particular circumstances and needs of individual ccTLDs. The Center currently provides domain name dispute resolution services to 71 ccTLD registries, most recently including the domain space .GQ (Equatorial Guinea).²⁰

III. POLICY DEVELOPMENTS IN THE DNS

20. A number of policy developments in relation to ICANN present both opportunities and challenges for owners and users of IP rights. One is ICANN's introduction of up to 1,400 new gTLDs. Such new gTLDs may be of an "open" nature (similar to .com), or may take on more specific or restrictive characteristics, for example taking the form of .[brand], .[city], .[community], .[culture], .[industry], or .[language]. An important related development concerns the introduction of Internationalized Domain Names (IDNs) at the top level. Also, ICANN's envisaged expansion of the DNS raises rights protection questions in connection with the Second WIPO Internet Domain Name Process.

¹⁵ In alphabetical order, Chinese, Czech, Danish, Dutch, English, French, German, Hebrew, Italian, Japanese, Korean, Norwegian, Polish, Portuguese, Romanian, Russian, Slovak, Spanish, Swedish, Turkish, and Vietnamese.

¹⁶ The Overview is available at <http://www.wipo.int/amc/en/domains/search/overview2.0>.

¹⁷ This professional resource is available at <http://www.wipo.int/cgi-bin/domains/search/legalindex>.

¹⁸ See, e.g., WO/GA/41/17 Rev.2, paragraphs 14 to 16.

¹⁹ See footnote 2, *supra*.

²⁰ The full list of ccTLDs which have retained the Center as domain name dispute resolution provider is available at <http://www.wipo.int/amc/en/domains/ccTld>.

A. NEW GTLDS

21. ICANN implementation of its New gTLD Program was formally approved in June 2011.²¹ Information has been published in ICANN's much-revised "Applicant Guidebook".²² Delegation of the first new gTLDs into the Internet's Root Zone took place in October 2013, with 600 more gTLDs by June 2015.²³

22. The Center remains committed to working with stakeholders to attempt to safeguard the observance of general principles of IP protection in new gTLDs. A number of the RPMs have emerged from a series of ICANN committees and processes for new gTLDs.²⁴ Set out below is a broad description of these ICANN RPMs, for the top level and the second level respectively.

(a) Top Level RPMs

(i) Pre- (TLD) Delegation Dispute Resolution Procedure

23. This mechanism allowed trademark owners to lodge Legal Rights Objections (LRO) to new gTLD applications at the top level where certain substantive criteria were met.²⁵ The Center assisted ICANN in the establishment of these criteria on the basis of the "WIPO Joint Recommendation Concerning Provisions on the Protection of Marks, and Other Industrial Property Rights in Signs, on the Internet".²⁶

24. Appointed by ICANN as the exclusive provider of LRO dispute resolution services,²⁷ the Center received 69 compliant LRO filings, which it completed processing by September 2013.²⁸ All WIPO LRO expert panel determinations are available on the Center's website,²⁹ as is a Center report on the LRO process.³⁰

(ii) Post- (TLD) Delegation Dispute Resolution Procedure (PDDRP)

25. In early 2009, the Center communicated to ICANN a concrete substantive proposal for a permanent administrative option that would allow for the filing of a complaint with respect to an

²¹ See <http://www.icann.org/en/minutes/resolutions-20jun11-en.htm>. For further background including references, see document WO/GA/39/10, in particular paragraph 14.

²² ICANN's Applicant Guidebook is available at <http://newgtlds.icann.org/en/applicants/agb>.

²³ Delegated new gTLDs are listed at <http://newgtlds.icann.org/en/program-status/delegated-strings>.

²⁴ For further background including references, see WO/GA/39/10, in particular paragraphs 23 to 30. It is noted here that ICANN summarily rejected a proposal for a "Globally Protected Marks List".

²⁵ Other objection grounds recognized by ICANN were: "String Confusion Objections", "Community Objections", and "Limited Public Interest Objections". The Applicant Guidebook further includes a number of other procedures which governments may avail themselves of following ICANN announcement of new gTLD applications. Notably, section 1.1.2.4 provides for "GAC Early Warning," and section 1.1.2.7 provides for "Receipt of GAC Advice on New gTLDs" for the ICANN Board's consideration.

²⁶ Adopted by the WIPO General Assembly in September 2001; see http://www.wipo.int/about-ip/en/development_iplaw/pub845-toc.htm.

²⁷ See section 3.2 of the ICANN Applicant Guidebook at <http://newgtlds.icann.org/en/applicants/agb/objection-procedures-04jun12-en.pdf>.

²⁸ See WIPO Rules for New gTLD Dispute Resolution, and Schedule of Fees and Costs, respectively at <http://www.wipo.int/amc/en/docs/wipolrrules.pdf> and <http://www.wipo.int/amc/en/domains/lro/fees/>; see WIPO-registered LRO cases at <http://www.wipo.int/amc/en/domains/lro/cases/>.

²⁹ See <http://www.wipo.int/amc/en/domains/lro/cases/>.

³⁰ The WIPO LRO report notes that an overwhelming majority of LROs were filed against applications for gTLD strings with descriptive or dictionary meaning. Many expert panels concluded that where a trademark owner has adopted a common dictionary term as a trademark, a gTLD application intended solely to take advantage of such common dictionary meaning would not as such violate the decision standards for LROs. In certain cases panels addressed trademark registrations that were primarily obtained for the purpose of supporting an application for a new gTLD and/or LRO, with little or no demonstrable prior use. See <http://www.wipo.int/amc/en/docs/lroreport.pdf>.

approved new gTLD registry operator whose manner of operation or use of its registry is alleged to cause or materially contribute to trademark abuse.³¹ The proposal's intent was to offer standardized assistance to ICANN's own compliance oversight responsibilities, by providing an administrative alternative to court litigation, encouraging responsible conduct by relevant actors and including appropriate safe-harbors.³²

26. Following various ICANN committee processes and consultations with registry operators, the effectiveness of this PDDRP in the form adopted by ICANN remains uncertain, in particular given the addition of overlapping procedural layers, and issues concerning the intended substantive scope of this mechanism. In light of broader policy interests, the Center in 2013 agreed with ICANN to become a provider for the trademark PDDRP.

(b) Second Level RPMs

(i) Trademark Clearinghouse

27. ICANN's New gTLD Program includes a "Trademark Clearinghouse" as a centralized repository of authenticated trademark data which could be invoked as the basis for filing under new gTLD RPMs.³³ The Center has commented that any such Clearinghouse should not unfairly burden rights holders in the treatment of trademark registrations legitimately obtained through examination and registration systems as applied in many global jurisdictions, and that, if and where relevant, practical measures may be envisaged to identify any allegedly inappropriate invocation of rights in specific contexts. It appears that through June 2015, the Clearinghouse contains some 37,000 entries.³⁴

(ii) Uniform Rapid Suspension (URS) System

28. While importantly the UDRP remains available as a curative tool for new gTLD disputes involving the considered transfer of a disputed domain name to the trademark owner, ICANN has introduced what is intended to be a lighter second-level RPM for appropriate cases.³⁵

³¹ See <http://www.wipo.int/amc/en/docs/icann130309.pdf>.

³² Given the perceived convergence of registry, registrar, and registrant roles within the DNS, the Center has further recommended, *inter alia* taking account of its UDRP-based experiences, and ICANN's decision to allow for cross-ownership between registries and registrars (see <http://www.icann.org/en/minutes/resolutions-05nov10-en.htm>), that ICANN consider extending the PDDRP for registries also to registrar conduct (see, *inter alia*, <http://www.wipo.int/amc/en/docs/icann260310rap.pdf>).

³³ The Clearinghouse allows for inclusion of registered word marks, word marks protected by statute or treaty or validated by court, and "[o]ther marks that constitute intellectual property" (the latter being undefined). With respect to RPMs utilizing Clearinghouse data, the availability of "Sunrise" services (*i.e.*, an opportunity for a trademark owner, for a fee, to preemptively register an exact match of its mark as a domain name) is limited to those trademarks for which current use can be demonstrated. Whether or not substantiated by demonstration of current use, trademark owners would also be eligible to participate in a time limited "Claims" service (*i.e.*, notice to a potential domain name registrant of the existence of a potentially conflicting trademark right, and notice to the relevant trademark owner(s) in the event that the registrant nevertheless proceeds with domain name registration). As mandated by ICANN, the availability of the Claims service is for a period of 90 days after a new gTLD is opened for general public registration, but users of the Clearinghouse can opt-in to receive notifications indefinitely. The demonstration of use required for Sunrise services similarly applies to the invocation of trademarks as a basis for a complaint filed under the "Uniform Rapid Suspension" RPM described below.

³⁴ See <http://trademark-clearinghouse.com/content/tmch-stats>.

³⁵ The Center for its part communicated to ICANN in April 2009 a discussion draft of an "Expedited (Domain Name) Suspension Mechanism", (See <http://www.wipo.int/amc/en/docs/icann030409.pdf>) and has made subsequent proposals for a streamlined mechanism based on this model at ICANN Meetings (See <http://prague44.icann.org/node/31773> and <http://toronto45.icann.org/node/34325>). Such proposals took account of the need to strike a balance between the protection of trademark rights recognized by law, the practical interests of good-faith registration authorities to minimize operational burdens, and the legitimate expectations of *bona fide* domain name registrants.

29. Having evolved from a sequence of ICANN processes and committees, the URS continues to raise a number of questions, including its relationship to the UDRP.³⁶ ICANN invited tenders from prospective URS providers, to which after careful consideration of the ICANN URS model and related resources, the Center was not in a position to apply.³⁷ The Center continues to closely monitor developments.

B. ICANN'S PLANNED REVISION OF THE WIPO-INITIATED UDRP, AND THE UDRP LOCK WORKING GROUP

30. Accommodating the dynamic development of the DNS, the UDRP has been offering an effective alternative to court litigation for trademark owners, domain name registrants, and registration authorities. Nevertheless, following discussions at which the clear majority of participants were of the opinion that more harm than good could result from any review of the UDRP by ICANN as a registration-driven body,³⁸ a decision was taken by ICANN's Generic Names Supporting Organization (GNSO) to review the UDRP. That process is now commencing and the Center will be a concerned participant.³⁹ Separately, the Center has participated in an ICANN policy process that has reviewed and now codified the practice of "locking" domain names to prevent so-called "cyberflight" in UDRP proceedings.

C. IDNS

31. As noted in paragraph 20, another significant policy development in the DNS is the introduction of IDNs (non-Latin script) at the top level.⁴⁰ Many of these were among the first new gTLDs announced by ICANN for delegation in the DNS root zone.

D. OTHER IDENTIFIERS

32. In addition to and in connection with the above, there are further developments taking place at ICANN in relation to the protection of non-trademark identifiers.

(a) International Governmental Organizations (IGOs)

33. It is recalled that the First WIPO Internet Domain Name Process addressed the relationship between domain names and trademarks. The Second WIPO Internet Domain Name Process concerned the relationship between domain names and other types of identifiers that had not been addressed, including country names and IGO names and acronyms.

³⁶ An extensive inventory of these issues is provided *inter alia* in the Center's letter to ICANN of December 2, 2010, available at <http://www.wipo.int/amc/en/docs/icann021210.pdf>.

³⁷ The question of accreditation of providers gives rise to concerns as to the stability of RPMs; WIPO raised concerns about this as early as 2007 in the context of the UDRP (see <http://www.wipo.int/amc/en/docs/icann040707.pdf>).

³⁸ See <https://community.icann.org/display/gnsoudrpdtd/Webinar+on+the+Current+State+of+the+UDRP>; see also more generally document WO/GA/39/10, paragraph 31.

³⁹ See <http://gnso.icann.org/meetings/minutes-council-15dec11-en.htm>.

⁴⁰ See also ICANN's Final Implementation Plan for IDN ccTLD Fast Track Process published in November 2009 (see <http://www.icann.org/en/topics/idn/fast-track/idn-ccTld-implementation-plan-16nov09-en.pdf>). Since then, this has allowed for the introduction of IDN ccTLDs, associated with the two-letter codes in the ISO 3166-1 standard (see http://www.iso.org/iso/english_country_names_and_code_elements).

34. The 2002 WIPO General Assembly recommended amending the UDRP in order to provide protection for country names and for the names and acronyms of IGOs.⁴¹ The WIPO Secretariat transmitted these recommendations to ICANN in February 2003.⁴²

35. Following ICANN deliberations,⁴³ ICANN's New gTLD Applicant Guidebook limited its consideration of the protection of the names and acronyms of IGOs to providing recourse through the pre-delegation objection procedure concerning the top level (*i.e.*, an applied-for TLD), discussed in paragraphs 19 and 20 above. However, following sustained IGO efforts, ICANN's Governmental Advisory Committee (GAC) advised the ICANN Board that IGO identifiers be granted protection against inappropriate third-party registration in the DNS prior to the delegation of any new gTLDs.⁴⁴ The GAC further advised the ICANN Board that, building on existing criteria for ".int" second-level registrations, it would collaborate with IGOs to develop a list of IGO names and acronyms that should be protected. Such protection would be at the second level for the current round of new gTLDs, and at both the second and top level in any future new gTLD rounds. The GAC also advised the Board that, pending work on further implementation, interim protection for IGO names and acronyms should be provided through a moratorium on third-party registration prior to the delegation of any new gTLDs.

36. The ICANN Board responded to the GAC indicating that it had adopted a resolution laying the groundwork for such interim protection at the second level based on the existing .int criteria, via an ICANN reserve list of IGO identifiers, to be withheld from third-party registration through the new gTLD Registry Agreement. ICANN invited qualifying IGOs to identify themselves to ICANN, while also seeking provision by the GAC (with IGOs) of a consolidated IGO package comprising the criteria and list of IGO names and acronyms for which the GAC advised protection.⁴⁵ In response, an IGO coalition developed .int-based criteria for IGO protection and an accompanying list of IGOs, which the IGO coalition forwarded to the ICANN Board in February 2013. This was followed by a GAC communication to the ICANN Board of the GAC's preferred advice on IGO protection eligibility criteria,⁴⁶ together with a list of protectable IGO names and acronyms.⁴⁷

37. On April 1, 2013, the Board wrote to the GAC with concerns as to how the protection of IGO acronyms would be reconciled with certain potentially legitimate third-party attempts to register domain names corresponding to a protected IGO acronym, and sought further particulars about the means by which cases of potentially legitimate co-existent use of such acronym could be managed in practice.⁴⁸ The GAC's response stressed the important global public mission of IGOs, committed to actively working to find a way forward, and reiterated its advice to the ICANN Board that preventative initial protection for listed IGO names and acronyms be in place before any new gTLDs would launch.⁴⁹

⁴¹ See http://www.wipo.int/edocs/mdocs/govbody/en/wo_ga_28/wo_ga_28_3.pdf; see also documents SCT/9/8, paragraphs 6 to 11; and, SCT/9/9, paragraph 149.

⁴² See <http://www.wipo.int/amc/en/docs/wipo.doc>.

⁴³ For background, see WO/GA/41/17 Rev.2, in particular paragraphs 40 and 41.

⁴⁴ See

https://gacweb.icann.org/download/attachments/27132070/FINAL_Toronto_Communique_20121017.pdf?version=1&modificationDate=1354149148000&api=v2.

⁴⁵ See

<https://gacweb.icann.org/download/attachments/27132070/Board%20Response%20to%20GAC%20Toronto%20Communique.pdf?version=1&modificationDate=1361909146000&api=v2>.

⁴⁶ Such criteria comprise treaty-based IGOs with international legal personality, or which are UN Observers, or which are funds or programs of the UN.

⁴⁷ See <http://www.icann.org/en/news/correspondence/dryden-to-crocker-chalaby-22mar13-en>.

⁴⁸ The Board also sought further specifics on means for periodic review of the list, along with clarification of any additional languages in which protection of IGO names and acronyms is sought. See

<http://www.icann.org/en/news/correspondence/crocker-to-dryden-01apr13-en>.

⁴⁹ See <https://www.icann.org/en/system/files/correspondence/gac-to-board-18apr13-en.pdf>.

38. In July 2013, following further discussions with ICANN and sustained efforts from IGOs, the GAC issued advice to the ICANN Board that highlighted the need for special preventative protection for IGO names and acronyms in the DNS.⁵⁰ Following this advice, the ICANN Board issued a resolution extending interim protection for IGOs until the first meeting of the ICANN Board's New gTLD Program Committee (NGPC) after the November 2013 ICANN meeting.⁵¹

39. In October 2013 the NGPC made a proposal for protection of IGO acronyms at the second level that fell well short of providing IGO acronyms with the permanent preventative protection envisaged in previous GAC Communiqués.⁵² The IGO coalition responded to the NGPC indicating disappointment that the proposal was strictly curative in nature and did nothing to prevent harm from occurring in the first place, and also conveyed its concerns to the GAC.

40. The NGPC, the GAC, and IGOs met around ICANN's November 2013 Buenos Aires meeting. The NGPC indicated that although specific technical points of its October 2013 proposal could be worked on, full preventative protection of IGO acronyms was intentionally excluded. The GAC advised the ICANN Board that interim protections for IGO acronyms should remain in place until the dialogue between the GAC, the NGPC and IGOs ensuring implementation of protection was completed, but without reiterating the GAC's previous position about the need for preventative protection.⁵³ In January 2014, the NGPC resolved to extend temporary protections for IGO acronyms until the NGPC made a final determination.⁵⁴

41. In parallel to these efforts, the GNSO had launched a Policy Development Process (PDP) concerning IGO protection, in which process the Center with other IGO representatives participated. Over IGO objections, in November 2013 this GNSO process rejected preventative protection for IGO acronyms on the second level. Instead, it recommended curative protection mechanisms for IGO acronyms, coupled with the removal of the temporary protections for IGO acronyms in place. These recommendations were adopted unanimously by the GNSO Council in November 2013. In response to this development, IGOs wrote to express concern noting that the mechanisms now foreseen would miss an important opportunity to curtail abuse of IGO acronyms in the DNS before harm could occur.⁵⁵

42. In February 2014, IGOs met with the ICANN NGPC representative to discuss the NGPC's October 2013 proposal. Following this, in March 2014, the NGPC provided a draft proposal for curative rights protection for IGO acronyms. Further discussions were held between IGOs and the NGPC in ICANN's March 2014 meeting, where the GAC also advised the ICANN Board that it was awaiting the Board's response regarding the implementation of previous GAC advice.

43. In April 2014, the ICANN Board resolved to adopt the GNSO Council recommendations not in conflict with GAC advice (reserving from registration the full names of IGOs at the top and second levels, in two languages) while requesting more time to consider the recommendations that then differed from GAC advice (duration of "claims notices"⁵⁶ and a potential curative RPM). Notwithstanding this GAC advice and IGO positions, in June 2014, the GNSO Council voted to initiate a second PDP on the desirability and modalities of giving IGOs access to curative RPMs (such as the UDRP or URS). In October 2014, the GAC affirmed its prior advice seeking a

⁵⁰ The GAC further advised that it expressly assumed that the ICANN Board was prepared to fully implement the GAC advice and focus on practical and effective implementation of preventative protection at the second level in new gTLDs, and that the interim protections for IGO names and acronyms should remain in place until the dialogue between the GAC, ICANN and IGOs was completed. See <http://durban47.icann.org/meetings/durban2013/presentation-gac-communique-18jul13-en.pdf>.

⁵¹ See <http://www.icann.org/en/groups/board/documents/resolutions-new-gtld-17jul13-en.htm>.

⁵² The GAC and the NGPC had cancelled their participation in a September 30 meeting proposed by IGOs.

⁵³ See <http://www.icann.org/en/news/correspondence/gac-to-board-20nov13-en.pdf>.

⁵⁴ See <http://www.icann.org/en/groups/board/documents/resolutions-new-gtld-09jan14-en.htm#2.d.i>.

⁵⁵ By way of example, the IGO letter cited illicit profiteering from UNICEF funding campaigns in the wake of humanitarian emergencies.

⁵⁶ See footnote 23.

solution for IGO identifier protection at the second level, whereby such protection should not require amending the existing UDRP.⁵⁷ In January 2015, the NGPC again sought information from the GAC concerning the latter's understanding of "the nature and extent of the rights of international governmental organizations with respect to curative rights protections for IGO names and acronyms".⁵⁸ In parallel, the GAC clarified its position on IGO protection to the GNSO IGO Working Group.⁵⁹ Together with other IGOs, the Center continues to closely monitor this longstanding ICANN file.

(b) Geographical Terms

44. Concerning geographical terms, the GAC in particular has expressed concerns about their use and protection in the new gTLDs.⁶⁰ Concerning the top level,⁶¹ ICANN's Applicant Guidebook provides that "applications for strings that are country or territory names will not be approved, as they are not available under the New gTLD Program in this application round."⁶² Applied-for strings which are considered by ICANN to be certain other geographical names, e.g., capital city names, need to be accompanied by documentation of support or non-objection from the relevant governments or public authorities.⁶³

45. GAC members have expressed further reservations regarding a number of new gTLD applications on grounds of correspondence to geographical or other "sensitive" terms, advising the ICANN Board not to proceed beyond initial evaluation, and seeking Board clarification on scope for applicants to modify their new gTLD applications to address specific GAC concerns.⁶⁴

⁵⁷

See

https://gacweb.icann.org/download/attachments/27132037/Los%20Angeles_GAC%20Communique_Final.pdf?version=1&modificationDate=1413479079000&api=v2.

⁵⁸ See <https://www.icann.org/en/system/files/correspondence/chalaby-to-schneider-22jan15-en.pdf>.

⁵⁹ See <http://mm.icann.org/pipermail/gnso-igo-ingo-crp/2015-April/000345.html>.

⁶⁰ In 2007 the GAC issued the "GAC Principles regarding New gTLDs", which states *inter alia* that ICANN should avoid delegation of new gTLDs concerning country, territory or place names, and regional language or people descriptions, unless in agreement with the relevant governments or public authorities. Those GAC Principles further stated that new registries should adopt procedures for blocking/challenge of names with national or geographical significance at the second level upon demand of governments. See http://gac.icann.org/web/home/gTLD_principles.pdf.

⁶¹ Concerning second-level registrations, ICANN's base registry agreement includes a "Schedule of Reserved Names at the Second Level in gTLD Registries" which makes provision for certain country and territory names. See <http://newgtlds.icann.org/en/applicants/agb/base-agreement-specs-04jun12-en.pdf> at Specification 5.

⁶² See <http://newgtlds.icann.org/en/applicants/agb/evaluation-procedures-04jun12-en.pdf>, from section 2.2.1.4.1 "Treatment of Country or Territory Names".

⁶³ See <http://newgtlds.icann.org/en/applicants/agb/evaluation-procedures-04jun12-en.pdf>, from section 2.2.1.4.2 "Geographic Names Requiring Government Support".

⁶⁴ See <https://www.icann.org/en/system/files/correspondence/gac-to-board-27mar14-en.pdf>, at "4. Specific Strings". While the Board has accepted the GAC's advice against proceeding with certain applications, it has sought further information from the GAC, as well as public comments, on a range of additional safeguards sought by the GAC concerning several broad categories of new gTLD applications such as for those new gTLDs which correspond to regulated industries or dictionary terms. See https://gacweb.icann.org/download/attachments/27132037/Beijing%20Communique%20april2013_Final.pdf. A GAC Sub-group on Geographic Names (a Sub-group of the GAC Working Group on Future New gTLDs) has developed a draft document for future New gTLD rounds outlining several public policy aspects related to geographic names which is currently subject to further ICANN discussions. See <https://gacweb.icann.org/download/attachments/27132037/Geo%20names%20in%20new%20gTLDs%20Updated%200%20V3%20%2029%20august%202014%5B4%5D.pdf?version=1&modificationDate=1411549935000&api=v2>.

46. Overall, the Center has endeavored to apprise relevant sectors within the Secretariat on the above-mentioned matters, including in support of the work of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT).⁶⁵ The Secretariat will continue to monitor these developments and provide input where possible.

47. The WIPO General Assembly is invited to take note of the document "WIPO Arbitration and Mediation Center, Including Domain Names" (document WO/GA/47/14).

[End of document]

⁶⁵ See e.g., documents SCT/24/4, SCT 25/3, SCT 26/6 and 27/8.