

Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications

**Thirty First Session
Geneva, March 17 to 21, 2014**

UPDATE ON TRADEMARK-RELATED ASPECTS OF THE DOMAIN NAME SYSTEM

Document prepared by the Secretariat

1. At the thirtieth session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT), the Chair stated that the SCT had taken note of document SCT/30/5 (Update on Trademark-related Aspects of the Domain Name System) and that the Secretariat was requested to keep Member States informed on future developments in the Domain Name System (see document SCT/30/8, paragraph 16). Accordingly, the Secretariat has prepared the present document which offers the requested update.

I. DOMAIN NAME CASE ADMINISTRATION

A. UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY

2. 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 First¹ and Second² WIPO Internet Domain Name Processes. In particular, the Center provides trademark owners with efficient international mechanisms to deal with the bad-faith registration and use of domain names corresponding to their trademark rights.

¹ 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>.

² 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>.

3. The Center administers dispute resolution procedures principally under the UDRP. The UDRP was adopted by ICANN on the basis of recommendations made by WIPO in the First WIPO Internet Domain Name Process. 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. It 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 justice³.

4. Since December 1999, the Center has administered some 28,000 UDRP and UDRP-based cases. The Center makes available online real-time statistics to assist WIPO case parties and neutrals, trademark attorneys, domain name policy makers, the media and academics⁴. Faced with uncertainties in the impending expansion of the DNS, and in many instances working on reduced enforcement budgets, trademark owners in 2013 filed 2,585 UDRP-based complaints with the Center, a 10 per cent decrease from the 2012 filing level. At the same time, the Center's market share as a UDRP service provider actually increased from 57.9 per cent in 2012 to 58.2 per cent in 2013, and the number of disputed domain names in WIPO cases was 6,191, a 21.9 per cent increase over 2012.

5. A diverse mixture of individuals and enterprises, foundations, and institutions used the Center's dispute resolution procedures in 2013. The top five sectors for complainant business activity were Retail, Fashion, Banking and Finance, Biotechnology and Pharmaceuticals, and Internet and Information Technology. Increased filings related to fashion and luxury brands reflect in part a growth in the number of cases filed by brand owners alleging counterfeiting *via* the web pages offered under the disputed domain name. Reflecting the truly global scope of this dispute mechanism, named parties to WIPO UDRP-based cases have so far represented 176 countries. In function of the language of the applicable registration agreement of the domain name at issue, WIPO UDRP-based proceedings have so far been conducted in 20 different languages⁵.

6. All WIPO 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) which distills thousands of UDRP cases handled by the Center. This globally relied-upon instrument was created in recognition of the need that has been expressed to identify, as much as possible, consensus among UDRP decisions so as to help maintain the consistency of WIPO UDRP jurisprudence⁶. To facilitate access to these decisions according to subject matter, the Center also offers a widely popular online searchable Legal Index of WIPO UDRP Decisions⁷.

7. As the leading provider of case administration services under the UDRP, the Center monitors developments in the DNS with a view to continually adjusting its resources and practices⁸. The Center regularly organizes Domain Name Dispute Resolution Workshops on updates to precedents and practices for interested parties⁹ and meetings of its Domain Name Panelists.

³ See Selected UDRP-related Court Cases at <http://www.wipo.int/amc/en/domains/challenged>.

⁴ Available statistics cover many categories, such as "areas of complainant activity", "named respondents", "domain name script", and "25 most cited decisions in complaint". See <http://www.wipo.int/amc/en/domains/statistics>.

⁵ In alphabetical order, Chinese, Czech, Danish, Dutch, English, French, German, Hebrew, Italian, Japanese, Korean, Norwegian, Polish, Portuguese, Romanian, Russian, Slovak, Spanish, Swedish, Turkish.

⁶ The Overview is available at <http://www.wipo.int/amc/en/domains/search/overview>.

⁷ The WIPO Legal Index has become an essential professional resource, allowing panelists, parties, academics or any interested person to familiarize themselves with WIPO case precedent. The Index is updated periodically to include new search categories that primarily reflect developments in the DNS itself and is available at <http://www.wipo.int/cgi-bin/domains/search/legalindex>.

⁸ See, e.g., WO/GA/41/17 Rev.2, paragraphs 14-16.

⁹ See footnote 2, *supra*.

B. COUNTRY CODE TOP-LEVEL DOMAINS (ccTLD)

8. While the mandatory application of the UDRP is limited to domain names registered in gTLDs, such as .com, .net, and .org, the Center also assists ccTLD registries in their establishment of registration conditions and dispute resolution procedures that conform with best practices in 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 70 ccTLD registries, most recently including the domain spaces .FM (Micronesia (Federated States of)), .GD (Grenada), .ML (Mali), .PW (Palau), and .TZ (Tanzania (United Republic of))¹⁰.

II. POLICY DEVELOPMENTS IN THE DOMAIN NAME SYSTEM

9. A number of policy developments in relation to ICANN present both opportunities and challenges for owners and users of IP rights. The most significant of these is ICANN's planned 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]. A second development concerns the introduction of 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.

A. NEW GENERIC TOP-LEVEL DOMAINS

10. ICANN implementation of its New gTLD Program was formally approved in a Board vote at ICANN's Meeting in Singapore on June 20, 2011¹¹. Information has been published in ICANN's much-revised "Applicant Guidebook"¹². Delegation of the first new gTLDs into the Internet's Root Zone took place in October 2013 and as of January 21, 2014 the number of delegated new gTLDs stood at 100¹³.

11. While the Center remains committed to working with stakeholders to attempt to safeguard the observance of general principles of IP protection in any new gTLDs ultimately approved by ICANN, a number of the RPMs which have emerged from a series of ICANN committees and processes for new gTLDs are seen to have been diluted in their intended effectiveness, both in operational and in substantive terms¹⁴. Set out below is a broad description of the RPMs adapted and adopted by ICANN, in relation to the top level and the second level respectively.

(i) Top Level Rights Protection Mechanisms

- Pre- (TLD) Delegation Dispute Resolution Procedure

12. This mechanism allows trademark owners to lodge Legal Rights Objections (LRO) to new gTLD applications at the top level where certain substantive criteria are met (other objection grounds recognized by ICANN are: "String Confusion Objections", "Community Objections",

¹⁰ 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>.

¹¹ 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.

¹² ICANN's Applicant Guidebook is available at <http://newgtlds.icann.org/en/applicants/agb>.

¹³ Delegated new gTLDs are listed at <http://newgtlds.icann.org/en/program-status/delegated-strings>.

¹⁴ For further background including references, see WO/GA/39/10, in particular paragraphs 23-30. It is noted here that ICANN summarily rejected a proposal for a "Globally Protected Marks List".

and “Limited Public Interest Objections”¹⁵). The Center has assisted ICANN in the establishment of the substantive criteria for the LRO procedures which are rooted in the “WIPO Joint Recommendation Concerning Provisions on the Protection of Marks, and Other Industrial Property Rights in Signs, on the Internet”¹⁶ (Joint Recommendation) adopted by the WIPO General Assembly in September 2001.

13. The Center was appointed by ICANN as the exclusive provider of LRO dispute resolution services¹⁷. The window for filing LRO objections closed in March 2013, with the Center receiving 69 LRO Objections found to be procedurally compliant¹⁸. The first LRO determinations were notified to the parties and published by the Center in July 2013, and the Center processing of LRO matters was essentially completed by early September 2013. All WIPO expert panel determinations are available on the Center’s website¹⁹.

14. The Center has published a report on the LRO process which is available on the Center’s website²⁰. As to its resume of panel findings, 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 to take advantage of such common meaning would not as such violate the dispute resolution standards for LROs. Where an expert panel determined that the application did not aim to use the descriptive or dictionary meaning of a string, but rather targeted a trademark, the expert panel declared the application objectionable. 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.

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

15. From early 2008, the Center has raised with ICANN the potential usefulness of a permanent administrative option that would allow for the filing of a complaint with respect to an approved new gTLD registry operator whose manner of operation or use of its registry is alleged to cause or materially contribute to trademark abuse. In early 2009, the Center communicated to ICANN a concrete substantive proposal for such a trademark-based post-delegation dispute resolution procedure²¹. 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-harbors²².

¹⁵ The Applicant Guidebook further foresees 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.

¹⁶ See http://www.wipo.int/about-ip/en/development_iplaw/pub845-toc.htm.

¹⁷ For the procedural LRO Rules, see section 3.2 of the ICANN Applicant Guidebook.

¹⁸ See WIPO Rules for New gTLD Dispute Resolution, and Schedule of Fees and Costs, respectively at <http://www.wipo.int/amc/en/docs/wipolrorules.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/>.

¹⁹ See <http://www.wipo.int/amc/en/domains/lro/cases/>.

²⁰ See <http://www.wipo.int/export/sites/www/amc/en/docs/lroreport.pdf>.

²¹ See <http://www.wipo.int/amc/en/docs/icann130309.pdf>.

²² 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>).

16. 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 mechanism²³. Notwithstanding this uncertainty, in light of the policy interests involved, the Center on September 18, 2013 concluded a Memorandum of Understanding with ICANN to become a provider for the PDDRP as it pertains to trademarks.

(ii) Second Level Rights Protection Mechanisms

- Trademark Clearinghouse

17. 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 RPMs²⁴. The adoption of this concept involved extensive ICANN discussions *inter alia* concerning the relation to trademark office determinations. 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 appropriate, practical measures may be envisaged to identify any allegedly inappropriate invocation of rights in specific contexts.

18. The Clearinghouse has been open for trademark submission and validation since March 2013²⁵, and the Center continues to monitor developments regarding this mechanism.

- Uniform Rapid Suspension (URS) System

19. 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. The Center for its part communicated to ICANN in April 2009 a discussion draft of an "Expedited (Domain Name) Suspension Mechanism"²⁶, and has made subsequent proposals for a streamlined mechanism based on this model at the ICANN Prague and Toronto Meetings in 2012²⁷. Such proposals took account of the need to strike a reasonable 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.

²³ The Center in June 2013 submitted a proposal to provide dispute resolution services under the ICANN Trade Mark PDDRP, in response to an ICANN request.

²⁴ 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 presently 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). The availability of the Claims service is limited to a maximum duration of 90 days after a new gTLD is opened for general public registration. Among trademark owners, it is anticipated that such limitations may give rise to gaming, with attendant financial and enforcement burdens for trademark owners and increased potential for consumer confusion. 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.

²⁵ See <http://trademark-clearinghouse.com/>.

²⁶ See <http://www.wipo.int/amc/en/docs/icann030409.pdf>.

²⁷ See <http://prague44.icann.org/node/31773> and <http://toronto45.icann.org/node/34325>.

20. The URS adopted by ICANN has evolved from a sequence of ICANN processes and committees, and is viewed by many as having become an overburdened procedure for a limited remedy. Questions remain as to how effective the URS will be as an efficient and enforceable complement to the court-alternative UDRP, and a range of issues remain to be addressed, including its relationship with the UDRP²⁸. ICANN invited tenders in late 2012 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 apply²⁹. The Center continues to closely monitor developments.

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

21. 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 ICANN³⁰, a decision was taken by ICANN's Generic Names Supporting Organization (GNSO) to review the UDRP through a process envisaged to commence within some 18 months following the delegation of the first new gTLDs³¹.

22. The UDRP functions today as the remarkable result of care invested by many stakeholders over a dozen years, for public and private benefit. By accommodating evolving norms and practices, the UDRP has proven to be a flexible and fair dispute resolution system. Given ICANN's institutional structure, where IP stakeholders hold a mere minority vote, it appears likely that any wide-ranging review could end up weakening the foundation and functioning of the UDRP. In the meantime, ICANN's GNSO has commenced a "Policy Development Process" (PDP) with a more limited technical mandate of examining the mechanism for locking domain names subject to UDRP proceedings, in which the Center is actively involved. This process is expected to shortly move to the implementation phase. The Center anticipates participating in such implementation, and more generally will continue to closely follow ICANN stakeholders' intentions with regard to the UDRP.

C. INTERNATIONALIZED DOMAIN NAMES

23. As noted in paragraph 2, another significant policy development in the DNS is the introduction of IDNs (non-Latin script) at the top level. A total of 116 applications under ICANN's New gTLD Program were for IDNs. Because of the high priority drawn by IDN applications in the ICANN New gTLD approval process, a number of these have been among the first new gTLDs announced by ICANN for delegation in the DNS root zone³².

²⁸ An extensive inventory of these issues is provided *inter alia* in the Center's letter of December 2, 2010, available at <http://www.wipo.int/amc/en/docs/icann021210.pdf>. A number of these have been on the agenda of ICANN's June 2012 Prague Meeting.

²⁹ ICANN has announced the National Arbitration Forum and the Asian Domain Name Dispute Resolution Center as the first two URS providers in early 2013.

³⁰ See <https://community.icann.org/display/gnsoudrpd/Webinar+on+the+Current+State+of+the+UDRP>; see also more generally document WO/GA/39/10, paragraph 31.

³¹ See <http://gns0.icann.org/meetings/minutes-council-15dec11-en.htm>.

³² These include for example: شبكة (Arabic for 'web/network'), 公司 (Chinese for 'company'), and онлайн (Russian for 'online').

24. Separately, and prior to new gTLD development, ICANN's Final Implementation Plan for IDN ccTLD Fast Track Process was published on November 16, 2009³³. Since then, this has allowed for the introduction of several IDN ccTLDs, associated with the two-letter codes in the ISO 3166-1 standard³⁴. Approved requests continue to be delegated into the DNS root zone³⁵.

D. OTHER IDENTIFIERS

25. 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.

26. 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 five other types of identifiers that had not been addressed, including country names and the names and acronyms of inter-governmental organizations (IGOs).

27. At its meeting from September 23 to October 1, 2002, the WIPO General Assembly recommended amending the UDRP in order to provide protection for country names and for the names and acronyms of IGOs³⁶. The WIPO Secretariat transmitted these recommendations (WIPO-2 Recommendations) to ICANN in February 2003³⁷.

(i) International Governmental Organizations

28. Following further ICANN deliberations³⁸, ICANN's New gTLD Program Applicant Guidebook limited its consideration of the protection of the names and acronyms of IGOs to providing potential 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 an open letter from IGO legal counsel to ICANN in December 2011, and sustained IGO efforts, ICANN's Governmental Advisory Committee (GAC) issued advice to the ICANN Board that the names and acronyms of IGOs be granted protection against inappropriate third-party registration in the DNS prior to the delegation of any new gTLDs³⁹. The GAC further advised the ICANN Board that, building on existing .int criteria for second-level registrations in that space, 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.

29. 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 identified IGO names and acronyms, to be withheld from third-party registration through the new gTLD registry agreement. ICANN specified a deadline for provision of relevant qualifying IGO names and acronyms of February 28, 2013, inviting qualifying IGOs to identify themselves to ICANN by that date, while also seeking provision by the GAC

³³ See <http://www.icann.org/topics/idn/fast-track/idn-cctld-implementation-plan-16nov09-en.pdf>.

³⁴ See http://www.iso.org/iso/english_country_names_and_code_elements.

³⁵ See <http://www.icann.org/en/topics/idn/fast-track/>.

³⁶ 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.

³⁷ See <http://www.wipo.int/amc/en/docs/wipo.doc>.

³⁸ For background, see WO/GA/41/17 Rev.2, in particular paragraphs 40 and 41.

³⁹ See

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

(with IGOs) of a consolidated IGO package comprising the criteria and list of IGO names and acronyms for which the GAC advises protection⁴⁰. 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 on February 28, 2013. This was followed by a GAC communication to the ICANN Board of the GAC's preferred advice on IGO protection eligibility criteria (comprising treaty-based IGOs with international legal personality, or which are UN Observers, or which are funds or programs of the UN), together with a list of protectable IGO names and acronyms⁴¹.

30. On April 1, 2013, the Board responded to the GAC with a letter raising certain issues regarding its advice. In particular, the Board sought further specifics on a possible means for periodic review of the list, along with clarification of any additional languages in which protection of IGO names and acronyms is sought. The third issue, rather more fundamentally, raised certain concerns about 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 possible means by which cases of potentially legitimate co-existent use could be managed in practice⁴². 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 appropriate preventative initial protection for listed IGO names and acronyms be in place before any new gTLDs would launch.

31. In July 2013, following further discussions with ICANN and sustained efforts from IGOs, the GAC issued advice to the ICANN Board that reaffirmed support for special preventative protection for IGO names and acronyms in the DNS⁴³. 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 of the DNS, and that the interim protection for IGO names and acronyms should remain in place until the dialogue between the GAC, ICANN and IGOs was completed. Following this advice, the ICANN Board issued a resolution extending interim protection for IGOs until the first meeting of the ICANN New gTLD Program Committee (NGPC) after the November 2013 ICANN meeting⁴⁴.

32. In August 2013 IGOs proposed a meeting with the NGPC and the GAC to take place in Paris on September 30. Following initial agreement by all parties, the GAC later informed IGOs that it was unable to attend, causing the NGPC to cancel its participation as well. In October 2013 the latter 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. The IGO coalition responded to the NGPC indicating disappointment with the proposal, and also conveyed its concerns to the GAC.

33. The NGPC, the GAC, and IGOs conducted discussions 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 excluded. The GAC advised the ICANN Board that interim protection 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

⁴⁰ See

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

⁴¹ See <http://www.icann.org/en/news/correspondence/dryden-to-crocker-chalaby-22mar13-en>.

⁴² See <http://www.icann.org/en/news/correspondence/crocker-to-dryden-01apr13-en>.

⁴³ See <http://durban47.icann.org/meetings/durban2013/presentation-gac-communique-18jul13-en.pdf>.

⁴⁴ See <http://www.icann.org/en/groups/board/documents/resolutions-new-gtld-17jul13-en.htm>.

about the need for preventative protection⁴⁵. On January 9, 2014 the NGPC passed a resolution extending temporary protection for IGO acronyms until the NGPC made a final determination⁴⁶.

34. In parallel to these efforts, the ICANN GNSO had launched a PDP on the issue of IGO protection, in which process the Center along with other IGO representatives participated. Over IGO objections, in November 2013 this GNSO process came out against preventative protection for IGO acronyms on the second level. Instead, it recommended merely lower-level curative protection mechanisms for IGO acronyms, as well as the removal of the temporary protections for IGO acronyms already in place. These recommendations were adopted unanimously by the GNSO Council on November 20, 2013. In response to this development, IGOs wrote a letter expressing concern to the GAC on January 24, 2014. In this letter IGOs noted that the mechanisms now foreseen would miss an important opportunity to curtail abuse of IGO acronyms online (by way of example, illicit profiteering from UNICEF funding campaigns in the wake of humanitarian emergencies). The Center will continue to closely follow these developments.

(ii) Geographical Terms

35. Concerning geographical terms, the GAC in particular has expressed concerns about their use and protection in the new gTLDs. In 2007 it issued the “GAC Principles regarding New gTLDs”⁴⁷, 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.

36. Concerning the top level, ICANN’s Applicant Guidebook foresees 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”⁴⁸. Applied-for strings which are considered by ICANN to be certain other geographic names, e.g., capital city names, need to be accompanied by documentation of support or non-objection from the relevant governments or public authorities⁴⁹. 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 as contained in internationally recognized lists from the United Nations and the International Organization for Standardization⁵⁰.

37. The GAC has expressed further reservations regarding a number of new gTLD applications on grounds of correspondence to geographical or other terms, advising the ICANN Board not to proceed beyond initial evaluation for these, and seeking further clarification from the Board on scope for applicants to modify their new gTLD applications to address specific GAC concerns. The GAC has further identified several broad categories of new gTLD applications as warranting further consideration in terms of additional safeguards⁵¹. While the

⁴⁵ See <http://www.icann.org/en/news/correspondence/gac-to-board-20nov13-en.pdf>.

⁴⁶ See <http://www.icann.org/en/groups/board/documents/resolutions-new-gtld-09jan14-en.htm#2.d.i>.

⁴⁷ See <https://archive.icann.org/en/topics/new-gtlds/gac-principles-regarding-new-gtlds-28mar07-en.pdf>.

⁴⁸ 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”.

⁴⁹ 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”.

⁵⁰ See <http://newgtlds.icann.org/en/applicants/agb/agreement-approved-20nov13-en.pdf>, at Specification 5.

⁵¹ See https://gacweb.icann.org/download/attachments/27132037/Beijing%20Communique%20april2013_Final.pdf.

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, notably on the additional safeguards sought by the GAC.

38. The Secretariat will continue to monitor these developments and provide input where possible.

39. The SCT is invited to take note of the contents of this document.

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