

WIPO



SCT/S2/3

ORIGINAL: English

DATE: March 29, 2002

E

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

THE PROTECTION OF COUNTRY NAMES IN THE DOMAIN NAME SYSTEM

Document prepared by the Secretariat

1. The Report of the first Special Session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) (document STC/S1/6) concluded 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 seven questions 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.”
2. The present document constitutes the paper mentioned above and formulates, taking into account the comments received, a number of proposals for the protection of country names in the Domain Name System (DNS) for consideration by the second Special Session. The document consists of the following sections: (1) overview of comments received, (2) the principle of protection of country names in the DNS, (3) definitional, language and script issues, and (4) possible protection mechanisms.

OVERVIEW OF COMMENTS RECEIVED

3. 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 questions referred to above. At the date of printing of the present document, 25 governmental agencies and 5 non-governmental organizations had submitted comments to the Secretariat. These entities are identified in the annex to the present document.

4. As a general matter, a large majority of commentators¹ 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.”² A minority of commentators, however, opposed such protection³ on a variety of grounds, including insufficient evidence of abuse, sufficiency of existing national laws prohibiting the misleading use of country names, the potential impact of the protection under consideration on fair use of geographical terms and established trademark rights, freedom of expression and the lack of direct impact of SCT decisions on the mechanisms to be implemented in the DNS.⁴ One commentator expressed the view that it was not “[i]n the interests of member States to develop ad hoc solutions for the protection of country names, which would apply only on the Internet.”⁵

5. Each of the specific questions transmitted by the Secretariat is discussed below, with reference to the comments received.

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?

¹ See Comment of China (Trademark Office), Comment of Colombia (Department of Multilateral Economic, Social and Environmental Affairs), Comment of Croatia (State Intellectual Property Office), Comment of Denmark (Danish Patent and Trademark Office), Comment of Estonia (Estonian Patent Office), Comment of Government of France, Comment of Hungary (Hungarian Patent Office), Comment of Kyrgyzstan (State Agency of Science and Intellectual Property), Comment of Ireland (Intellectual Property Unit), Comment of Kenya, (Kenya Industrial Property Office), Comment of Latvia (Patent Office), Comment of Lithuania (State Patent Bureau), Comment of Mexico (Mexican Industrial Property Institute), Comment of Netherlands (Directorate-General for Telecommunications and Post), Comment of Portugal (National Institute of Industrial Property), Comment of Republic of Moldova (State Agency on Industrial Property Protection), Comment of Spain (Spanish Patent and Trademark Office), Comment of Turkey (Turkish Patent Institute), Comment of United Kingdom (Patent Office), Comment of Uruguay (National Directorate of Industrial Property), Comment of International Trademark Association, Comment of Japan Trademark Association, Comment of Japan Patent Attorneys Association, Comment of Arbitration Center for Industrial Property, Japan, Comment of Network Information Center, Mexico.

² See Comment of Ireland (Intellectual Property Unit).

³ See Comment of Government of Canada, Comment of New Zealand (Ministry of Economic Development), Comment of United States of America (Patent and Trademark Office).

⁴ See Comment of Government of Canada, Comment of United States of America (Patent and Trademark Office).

⁵ See Comment of New Zealand (Ministry of Economic Development).

6. Comments submitted were largely in favor of identifying the name of countries by reference to the International Standard ISO 3166-1 on Country Codes (the “ISO Standard”).⁶ A minority of commentators was of the view that the United Nations Terminology Bulletin No. 347/Rev. 1 (the “UN Bulletin”) should be used as a reference.⁷ Certain commentators suggested that both lists be used.⁸ Two commentators found those lists too restrictive and suggested that “[p]rotection should also include other terms under which the country is known in wider circles”⁹ and that “[i]t should be to the discretion of a country to supply a limited and stable list of names of the country.”¹⁰

7. On the issue of whether both the full and short names of countries should be protected, most commentators were in favor of protecting both.¹¹ A small minority of commentators proposed to limit protection to either the full names¹² or short names of countries.¹³

Question 2: In what languages should country names be protected?

8. Almost all commentators in favor of protection of country names were of the view that country names should be protected at least in the official language(s) of the concerned country.¹⁴

⁶ See Comment of Government of Canada, Comment of Kyrgyzstan (State Agency of Science and Intellectual Property), Comment of Latvia (Patent Office), Comment of Lithuania (State Patent Bureau), Comment of Portugal (National Institute of Industrial Property), Comment of Republic of Moldova (State Agency on Industrial Property Protection), Comment of Uruguay (National Directorate of Industrial Property), Comment of Network Information Center, Mexico.

⁷ See Comment of Colombia (Department of Multilateral Economic, Social and Environmental Affairs), Comment of Government of France, Comment of Kenya (Kenya Industrial Property Office), Comment of Hungary (Hungarian Patent Office), Comment of New Zealand (Ministry of Economic Development), Comment of United Kingdom (Patent Office), Comment of Japan Patent Attorneys Association, Comment of Japan Trademark Association.

⁸ See Comment of China (Trademark Office), Comment of Croatia (State Intellectual Property Office), Comment of Ukraine (State Department of Intellectual Property), Comment of Arbitration Center for Industrial Property, Japan.

⁹ See Comment of Denmark (Danish Patent and Trademark Office).

¹⁰ See Comment of Netherlands (Directorate-General for Telecommunications and Post).

¹¹ See Comment of China (Trademark Office), Comment of Colombia (Department of Multilateral Economic, Social and Environmental Affairs), Comment of Croatia (State Intellectual Property Office), Comment of Denmark (Danish Patent and Trademark Office), Comment of Estonia (Estonian Patent Office), Comment of Government of France, Comment of Hungary (Hungarian Patent Office), Comment of Ireland (Intellectual Property Unit), Comment of Kenya (Kenya Industrial Property Office), Comment of Latvia (Patent Office), Comment of Lithuania (State Patent Bureau), Comment of Netherlands (Directorate-General for Telecommunications and Post), Comment of Republic of Moldova (State Agency on Industrial Property Protection), Comment of Turkey (Turkish Patent Institute), Comment of Ukraine (State Department of Intellectual Property), Comment of United Kingdom (Patent Office).

¹² See Comment of New Zealand (Ministry of Economic Development).

¹³ See Comment of Japan Patent Attorneys Association, Comment of Japan Trademark Association, Comment of Network Information Center, Mexico.

¹⁴ See Comment of China (Trademark Office), Comment of Croatia (State Intellectual Property Office), Comment of Denmark (Danish Patent and Trademark Office), Comment of Estonia (Estonian Patent Office), Comment of Latvia (Patent Office), Comment of Lithuania (State Patent Bureau), Comment of Netherlands (Directorate-General for Telecommunications and Post), Comment of Portugal (National Institute of Industrial Property), Comment of Spain (Spanish Patent and Trademark Office), Comment of Republic of Moldova (State Agency on Industrial Property Protection), Comment of Turkey (Turkish Patent Institute), Comment of United Kingdom (Patent Office),

Many of those commentators specified that protection should also be extended to English.¹⁵ A minority proposed that the protection be limited to the official language(s) of the concerned country¹⁶ or to English.¹⁷ Other commentators suggested that country names should be protected in the official languages of the United Nations¹⁸ or in some of those languages, such as French, English and Spanish.¹⁹ One commentator expressed the view that, in addition to the official languages of the United Nations, country names should also be protected in Portuguese.²⁰ Another commentator argued that, in addition to the language of the country concerned and the official languages of the United Nations, protection also should be extended to German, Italian, Korean, as well as Portuguese.²¹ A number of commentators believed that country names should benefit from protection in all languages²² and dialects.²³

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.)?

9. The majority of commentators favored protection of country names in all existing and future domains (gTLDs and ccTLDs).²⁴ Others proposed to restrict the protection of country names to existing and future gTLDs only, stressing that protection in ccTLDs was within the competence of

[Footnote continued from previous page]

Comment of Uruguay (National Directorate of Industrial Property), Comment of Japan Patent Attorneys Association, Comment of Japan Trademark Association, Comment of Arbitration Center for Industrial Property, Japan.

¹⁵ See Comment of Latvia (Patent Office), Comment of Lithuania (State Patent Bureau), Comment of Portugal (National Institute of Industrial Property), Comment of United Kingdom (Patent Office).

¹⁶ See Comment of Uruguay (National Directorate of Industrial Property).

¹⁷ See Comment of Kyrgyzstan (State Agency of Science and Intellectual Property), Comment of Ukraine (State Department of Intellectual Property), Comment of Network Information Center, Mexico.

¹⁸ See Comment of China (Trademark Office), Comment of Estonia (Estonian Patent Office), Comment of Government of France, Comment of Kenya (Kenya Industrial Property Office), Comment of Netherlands (Directorate-General for Telecommunications and Post), Comment of Republic of Moldova (State Agency on Industrial Property Protection).

¹⁹ See Comment of Croatia (State Intellectual Property Office), Comment of Japan Patent Attorneys Association, Comment of Japan Trademark Association.

²⁰ See Comment of Government of France.

²¹ See Comment of Arbitration Center for Industrial Property, Japon.

²² See Comment of Colombia (Department of Multilateral Economic, Social and Environmental Affairs), Comment of Denmark (Danish Patent and Trademark Office), Comment of Ireland (Intellectual Property Unit), Comment of New Zealand (Ministry of Economic Development).

²³ See Comment of United States of America (Patent and Trademark Office).

²⁴ See Comment of China (Trademark Office), Comment of Colombia (Department of Multilateral Economic, Social and Environmental Affairs), Comment of Croatia (State Intellectual Property Office), Comment of Denmark (Danish Patent and Trademark Office), Comment of Estonia (Estonian Patent Office), Comment of Ireland (Intellectual Property Unit), Comment of Hungary (Hungarian Patent Office), Comment of Kenya (Kenya Industrial Property Office), Comment of Latvia (Patent Office), Comment of Lithuania (State Patent Bureau), Comment of Mexico (Mexican Industrial property Office), Comment of Portugal (National Institute of Industrial Property), Comment of Republic of Moldova (State Agency on Industrial Property Protection), Comment of Spain (Spanish Patent and Trademark Office), Comment of Turkey (Turkish Patent Institute), Comment of Ukraine (State Department of Intellectual Property), Comment of Uruguay (National Directorate of Industrial Property).

the government of the relevant country,²⁵ or at least should not be mandatory.²⁶ A minority of commentators were of the view that protection should cover future domains only²⁷ or the .INFO gTLD only.²⁸ One commentator pointed out that the answer to this question depended on the mechanism that would be adopted for implementing protection: if an exclusion mechanism were to be adopted, protection would necessarily be limited to future domains; if a challenge mechanism were to be adopted, existing domains also would be covered.²⁹

Question 4: How should any alleged acquired rights be treated?

10. Assuming that the scope of protection would also cover existing domains, the question arises how to deal with acquired rights. 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.³⁰ 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 name 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,³¹ or the payment of compensation.³²

Question 5: What mechanism should be used to implement protection (for example, the UDRP or some other mechanism)?

11. Most commentators were of the view that the UDRP (or a variation thereof) could operate as a cost-effective and suitable mechanism to protect country names in the DNS.³³ One

²⁵ See Comment of Government of France, Comment of Netherlands (Directorate-General for Telecommunications and Post), Comment of Japan Patent Attorneys Association, Comment of Japan Trademark Association, Comment of Network Information Center, Mexico.

²⁶ See Comment of United Kingdom (Patent Office).

²⁷ See Comment of New Zealand (Ministry of Economic Development), Comment of Arbitration Center for Industrial Property, Japan.

²⁸ See Comment of Government of Canada.

²⁹ See Comment of United States of America (Patent and Trademark Office).

³⁰ See Comment of Government of France, Comment of Ireland (Intellectual Property Unit), Comment of Latvia (Patent Office), Comment of Lithuania (State Patent Bureau), Comment of Portugal (National Institute of Industrial Property), Comment of United Kingdom (Patent Office), Comment of Japan Trademark Association, Comment of Japan Patent Attorneys Association.

³¹ See Comment of Ireland (Intellectual Property Unit).

³² See Comment of Croatia (State Intellectual Property Office), Comment of Hungary (Hungarian Patent Office).

³³ See Comment of Government of Canada, Comment of China (Trademark Office), Comment of Colombia (Department of Multilateral Economic, Social and Environmental Affairs), Comment of Croatia (State Intellectual Property Office), Comment of Denmark (Danish Patent and Trademark Office), Comment of Estonia (Estonian Patent Office), Comment of Government of France, Comment of Kenya (Kenya Industrial Property Office), Comment of Kyrgyzstan (State Agency of Science and Intellectual Property), Comment of Hungary (Hungarian Patent Office), Comment of Latvia (Patent Office), Comment of Lithuania (State Patent Bureau), Comment of Netherlands (Directorate-General for Telecommunications and Post), Comment of New Zealand (Ministry of Economic Development), Comment of Portugal (National Institute of Industrial Property), Comment of Spain (Spanish Patent and Trademark Office), Comment of Turkey (Turkish Patent Institute), Comment of Ukraine (State Department of Intellectual Property), Comment of United Kingdom (Patent Office), Comment of Uruguay (National Directorate of Industrial Property), Comment of

commentator proposed a dispute resolution mechanism, based on the UDRP, but incorporating new “[d]efenses to a cause of action initiated by a national government for the bad faith registration or use of the country name as a domain name: (1) being the first in time to register a country name so long as registrant is using the domain name or has the intent to use it in good faith for a legitimate purpose; (2) being the owner of a trademark that is also the name of a country; or (3) being an entity associated with that country”.³⁴

12. Certain commentators suggested other protection mechanisms as an alternative to reliance on the UDRP. Some commentators proposed the introduction of a sunrise registration system³⁵ allowing relevant public authorities to register domain names during a pre-registration period in any new gTLDs that might be created. One commentator argued that the exclusion of country names from the possibility of registration as domain names would be an appropriate form of protection.³⁶ However, another commentator believed that an exclusion mechanism presented disadvantages to “[w]ork to prevent future registrations of domain names consisting of the names of countries... and [would] [r]equire a pre-determined list of terms in all languages and dialects to be reserved...”³⁷ Yet another commentator proposed to protect country names in the DNS through a cancellation mechanism for the exact name of countries.³⁸ The creation of a restricted new TLD also has been advanced as a possible mechanism, whereby only governments would be allowed to register their country names as domain names.³⁹

13. Finally, one commentator pointed out that there were a number of already existing mechanisms that could be used for the protection of country names in the DNS, such as the registration of the country name in the relevant ccTLD, the assignment to the relevant public authorities of domain names corresponding to country names that have been reserved in .INFO, and the cancellation of the domain name registration in cases of violation of the domain name registration agreement.⁴⁰

Question 6: Should any protection extend to the exact country name only or also to misleading variations?

14. Some commentators were of the view that protection should be restricted to exact names of countries,⁴¹ while others found that protection should be extended to misleading variations as

[Footnote continued from previous page]

Arbitration Center for Industrial Property, Japan, Comment of Japan Trademark Association, Comment of Japan Patent Attorneys Association, Comment of Network Information Center, Mexico.

³⁴ See Comment of International Trademark Association.

³⁵ See Comment of Netherlands (Directorate-General for Telecommunications and Post), Comment of Japan Patent Attorneys Association.

³⁶ See Comment of Hungary (Hungarian Patent Office).

³⁷ See Comment of United States of America (Patent and Trademark Office).

³⁸ See Comment of Croatia (State Intellectual Property Office).

³⁹ See Comment of United States of America (Patent and Trademark Office), Comment of International Trademark Association.

⁴⁰ See Comment of United States of America (Patent and Trademark Office).

⁴¹ See Comment of Colombia (Department of Multilateral Economic, Social and Environmental Affairs), Comment of Denmark (Danish Patent and Trademark Office), Comment of Government of France, Comment of Hungary (Hungarian Patent Office), Comment of Kyrgyzstan (State Agency of Science and Intellectual Property), Comment of Portugal (National Institute of Industrial Property), Comment of United Kingdom (Patent Office), Comment of Uruguay (National Directorate of

[Footnote continued on next page]

well.⁴² One commentator stated that the scope of the protection depended on the mechanism that would be adopted: if a sunrise registration system were to be adopted, protection should cover only exact names; if a dispute resolution mechanism were to be adopted, protection should also cover misleading variations of country names.⁴³

Question 7: Should protection be absolute or should it be dependent upon a showing of bad faith?

15. Opinions on this question were more or less evenly divided. Half of the commentators were of the view that country names should be protected without any requirement of bad faith on the part of the registrant,⁴⁴ while the other half stated that protection of country names should be limited to instances of bad faith.⁴⁵ One commentator stated that the protection of the exact country name should not be dependent on a showing of bad faith, which element should only be required in connection with misleading variations of country names.⁴⁶

THE PRINCIPLE OF PROTECTION OF COUNTRY NAMES

16. Consistent with the conclusions reached at the first Special Session, a large majority of commentators favored some form of protection of country names in the DNS, although, admittedly, views are not unanimous on this question. In considering whether or not, as a matter of principle, country names warrant protection in the DNS, it is observed that at least the Internet Corporation for Assigned Names and Numbers (ICANN) has found the matter to be sufficiently

[Footnote continued from previous page]

Industrial Property), Comment of Japan Patent Attorneys Association, Comment of Japan Trademark Association, Comment of Network Information Center, Mexico.

⁴² See Comment of China (Trademark Office), Comment of Croatia (State Intellectual Property Office), Comment of Estonia (Estonian Patent Office), Comment of Ireland (Intellectual Property Unit), Comment of Kenya (Kenya Industrial Property Office), Comment of Latvia (Patent Office), Comment of Lithuania (State Patent Bureau), Comment of Mexico (Mexican Industrial Property Institute), Comment of New Zealand (Ministry of Economic Development), Comment of Republic of Moldova (State Agency on Industrial Property Protection), Comment of Spain (Spanish Patent and Trademark Office), Comment of Turkey (Turkish Patent Institute).

⁴³ See Comment of Netherlands (Directorate-General for Telecommunications and Post).

⁴⁴ See Comment of China (Trademark Office), Comment of Colombia (Department of Multilateral Economic, Social and Environmental Affairs), Comment of Croatia (State Intellectual Property Office), Comment of Denmark (Danish Patent and Trademark Office), Comment of Ireland (Intellectual Property Unit), Comment of Kenya (Kenya Industrial Property Office), Comment of Portugal (National Institute of Industrial Property), Comment of Republic of Moldova (State Agency on Industrial Property Protection), Comment of Spain (Spanish Patent and Trademark Office), Comment of Ukraine (State Department of Intellectual Property), Comment of Uruguay (National Directorate of Industrial Property), Comment of Japan Patent Attorneys Association, Comment of Japan Trademark Association, Comment of Japanese Arbitration Center for Industrial Property.

⁴⁵ See Comment of Government of Canada, Comment of Estonia (Estonian Patent Office), Comment of Government of France, Comment of Hungary (Hungarian Patent Office), Comment of Latvia (Patent Office), Comment of Lithuania (State Patent Bureau), Comment of Mexico (Mexican Industrial Property Institute), Comment of Netherlands (Directorate-General for Telecommunications and Post), Comment of New Zealand (Ministry of Economic Development), Comment of United Kingdom (Patent Office), Comment of International Trademark Association, Comment of Network Information Center, Mexico.

⁴⁶ See Comment of Turkey (Turkish Patent Institute).

pressing to take corrective measures in the .INFO gTLD. For more details on this, reference is made to document SCT/S2/4. The remainder of this document discusses how general protection for country names could be implemented in the DNS, assuming its establishment were to be desired in principle.

DEFINITIONAL, LANGUAGE AND SCRIPT ISSUES

17. A fundamental question to be addressed in considering the protection of country names in the DNS is which terms should be deemed worthy of the protection that might be envisaged. As there does not exist a list of country names which has formal status in law, the answer is not obvious.

18. There are two documents listing country names which merit prime attention in this connection: the UN Bulletin and the ISO Standard. The UN Bulletin “provides a list, in English alphabetical order, of the names of States Members of the United Nations, as well as members of the specialized agencies and parties to the Statute of the International Court of Justice.” This list contains the short, as well as the full names of the countries concerned, in all six official languages of the United Nations (in their order of appearance in the Bulletin: English, French, Spanish, Russian, Chinese and Arabic). The ISO Standard, as such, does not purport to be a list of country names, but rather aims to “establish codes that represent the current names of countries, dependencies, and other areas of particular geopolitical interest.” In as far as it refers to country names, the ISO Standard does so by reference to “lists of country names obtained from the United Nations” (including the UN Bulletin). The ISO Standard also includes the short, as well as the full names of countries, which are provided, however, in English and French only.

19. In terms of providing a basis for the protection of country names in the DNS, each of the two above lists has advantages and disadvantages. This is also reflected in the comments received by the Secretariat, which are split on the question of whether the UN Bulletin or the ISO Standard is to be deemed the preferred instrument in this regard. The advantages of using the UN Bulletin would appear to be the following:

(i) The purpose of the ISO Standard is not to provide a list of country names, but of country codes. The purpose of the UN Bulletin, however, is to provide a list of country names.

(ii) The ISO Standard is derived from the UN Bulletin, a fact which is expressly acknowledged by the ISO Standard.

(iii) The question of which terms are country names is closely linked to the question of which territorial entities are countries. This is a sensitive question with obvious political and public international law ramifications. Because legal connotations are inescapable, reliance on a document which is considered the standard in the international political and legal arena is advisable. Although the UN Bulletin does not express any opinion whatsoever on the part of the Secretariat of the United Nations concerning the legal status of any country or territory, it (and not the ISO Standard) is considered to be the reference document on country names in those circles.

(iv) The UN Bulletin provides country names in the six official languages of the United Nations, including two in non-Latin scripts (Arabic and Chinese). The ISO Standard provides country names only in English and French.

Notwithstanding the above, it must be recognized that reliance on the ISO standard also would have a number of advantages:

(i) The ISO Standard has a greater tradition of use in the technical Internet community, which, for instance, is reflected in the fact that it constituted the basis for the creation of the ccTLDs. A further illustration of this is that the .INFO Country Name Discussion Group (ICNG) of the Internet Corporation for Assigned Names and Numbers (ICANN) also relies on the ISO Standard for its recommendations (see document SCT/S2/4).

(ii) A number of autonomous economic regions that are members of certain international intergovernmental organizations do not appear in the UN Bulletin, but are listed in the ISO Standard.

20. Country names obviously would need to be protected first and foremost in the official language(s) of the countries concerned. However, neither the UN Bulletin nor the ISO Standard provide the country names in all such official language(s). Whichever of these instruments ultimately may be deemed preferable as a basis for providing protection to country names in the DNS, it in any event could usefully be supplemented by the official language versions of the relevant country names (if such versions are not already covered by the chosen instrument).⁴⁷ Many languages are based on non-Latin scripts and the availability of a standard list of country names in those scripts, as a supplement to either the UN Bulletin or the ISO Standard, is likely to be useful in the future, in light of the increasing popularity of Internationalized (non-Latin character) Domain Names.

21. In light of these considerations, taking either the UN Bulletin or the ISO standard as a starting basis, a list of country names with the following characteristics could be compiled:

(i) WIPO Member States would have the opportunity to supplement either the UN Bulletin or the ISO Standard with the corresponding official language versions of their country names (in Latin and non-Latin scripts).

(ii) These supplemental names in official languages would include short, as well as full country names.

(iii) The compilation would include country names in the official language(s) of the countries concerned, as well as the six official languages of the United Nations.

(iv) The list would be compiled and administered by an appropriate organization and made available to all.

22. The SCT is invited to decide whether it would be appropriate to compile a list of country names, as described in paragraph 21 above. If the SCT were to decide this to be appropriate, the SCT also is invited to decide:

⁴⁷ This has already occurred in a limited fashion in the context of ICANN's initiative to protect country names in the .INFO gTLD, where the list of reserved names, which was based on the ISO Standard, was supplemented by the official language versions of certain country names (in Latin script). See document SCT/S2/4.

(i) *whether the UN Bulletin or the ISO Standard would be the proper starting basis for this list; and*

(ii) *which organization should compile and administer the list.*

POSSIBLE PROTECTION MECHANISMS

23. The comments received reveal that two methods for achieving protection of country names in the DNS merit further discussion in this paper: (1) a sunrise registration system and (2) an administrative challenge procedure.

Sunrise Registration System for Country Names

24. As explained in document SCT/S1/3, some of the new gTLDs have adopted policies on the basis of which a designated category of persons or entities (for instance, owners of trade or service marks) were entitled to pre-register certain identifiers in the domains concerned for protective purposes. These procedures are commonly referred to as “sunrise registration systems.” Certain Members of the SCT have advocated in their comments the introduction of similar sunrise registration systems in relation to country names for the benefit of governments, if and when further gTLDs are added to the root. In considering these comments, it is to be noted that the ICNG report on the protection of country names in the .INFO gTLD also recommends the adoption of what is in effect a sunrise registration system for country names in .INFO, although the end-result is reached in an indirect manner, particularly in those cases where the names had already been registered by third parties.

25. In paragraph 33(iii) of document SCT/S1/3, the Secretariat observed that, while sunrise registration systems have proven useful in certain respects, they were not entirely devoid of problems. Although all these problems are unlikely to recur in the context of country names, the Secretariat is of the view that the introduction of sunrise registration systems for such names would not be an optimal solution for several reasons:

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

(ii) Rights in names (including trademark rights) are rarely absolute and there are many instances where a person or entity other than the rightsholder may have a legitimate interest in a name and therefore be entitled to use or refer to it. Sunrise registration systems, however, are unable to reflect this careful balance of competing legitimate interests, because they do not take into consideration the legal and factual circumstances in which different parties may find themselves in relation to any given name.

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

26. Furthermore, in considering the appropriateness of a sunrise registration system for country names in relation to future gTLDs, the following passage of the ICNG report may be noted:

“[T]he GAC reiterated on several occasions that the request for the reservation of country and distinct economy names was only for .INFO, due to .INFO’s perceived unique nature and the desire of governments to ensure that information about their respective countries is provided on the Internet responsibly and reliably. Repeated statements by the GAC reassured the participants that the concern would not set a precedent for all other TLDs while other appropriate inter-governmental fora address the matter with regard to geographical terms in domain names.”

Administrative Challenge Procedure for Country Names

27. A mechanism allowing a government to challenge the registration of a country name would appear to be most flexible and effective way of dealing with the problem. In the trademark area, the procedural framework of the Uniform Dispute Resolution Policy (UDRP), coupled with its in-built enforcement mechanism, based on ICANN’s contractual relationship with domain name registrars, has proven to be an effective means of dealing with trademark cybersquatting. That being the case, it is submitted that a similar approach would also work well for country names. As viewed by the Secretariat, the main characteristics of such a challenge procedure for country names would be the following.

An Adversarial Procedure

28. It is submitted that the procedure should be adversarial in nature whereby a complainant and a respondent have the opportunity to argue their case before one or more neutral decisionmaker(s) who would be called upon to rule upon the dispute.

Protected Country Names

29. The procedure would grant protection to those country names that appear on a pre-determined list (see paragraphs 17 to 22 above for a discussion of this list). While there is divergence amongst the views expressed by commentators on the issue, the Secretariat believes that the procedure should apply not only to domain names that are identical to the country names concerned, but also to those that are misleadingly similar. Limiting the scope of the procedure to identical domain names would significantly reduce its effectiveness and appeal. The UDRP caseload makes it abundantly clear that most disputes filed under it concern variations of trade and service marks and there is no reason to expect the situation to be any different for country names. As one commentator succinctly put it “[i]f only the exact country names are protected, the misleading variations will inevitably be taken advantage of and the original intention of the protection shall not be realized.”

Legal Status of the Procedure and its Decisions

30. The procedure would be administrative in nature and the decisions emanating from it would not, as such, have weight of binding precedent under national judicial systems.

Relationship with the Courts

31. The parties to a dispute brought under the procedure would not be prevented from bringing the case before a court of competent jurisdiction either before, during or after the procedure.

32. Nonetheless, questions of immunities may arise before national courts which could prevent registrants from having their cases reconsidered. Because registrants, for due process reasons, should have the ability to challenge decisions emanating from the procedure, it is proposed that complainants, as a condition for initiating the procedure, should submit to the jurisdiction of certain specified national courts for challenge purposes. It should be noted in this connection that several governments or governmental entities and institutions already have submitted complaints under the UDRP and, by doing so, have submitted to the jurisdiction of national courts. This is notably the case for Australia,⁴⁸ Canada,⁴⁹ Germany,⁵⁰ Netherlands,⁵¹ Norway,⁵² Turkey⁵³ and the United States of America.⁵⁴

Direct Enforcement of Decisions

33. Decisions emanating from the procedure would be enforced directly by the domain name registration authorities that have adopted the procedure (including ICANN and its accredited registrars).

Scope of Procedure Limited to Bad Faith

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

35. Considering that, at the international level, countries do not have a right in their names, the protection which the procedure offers could usefully be centered, not so much on safeguarding a country's interest in the name concerned, but rather on the avoidance of consumer confusion. Bad faith conduct for purposes of the procedure could therefore be defined as the registration or use of

⁴⁸ This concerned a case filed by IP Australia regarding the domain name <ipaustalia.com>. The case was terminated without a decision.

⁴⁹ See <<http://arbiter.wipo.int/domains/decisions/html/2001/d2001-0470.html>>. The case involved several domain names including <canadacouncil.com> and was denied in part and granted in part.

⁵⁰ See <<http://arbiter.wipo.int/domains/decisions/html/2001/d2001-1401.html>>. The case involved several domain names including <bundesinnenministerium.com> and was granted.

⁵¹ See <<http://arbiter.wipo.int/domains/decisions/html/2001/d2001-0520.html>>. The case involved the domain name <staten-generaal.com> and was granted.

⁵² See <<http://arbiter.wipo.int/domains/decisions/html/2000/d2000-1314.html>>. The case involved the domain name <skatteetaten.com> and was granted.

⁵³ See <<http://arbiter.wipo.int/domains/decisions/html/2001/d2001-1279.html>>. The case involved the domain name <genelkurmay.net> and was denied.

⁵⁴ See <<http://arbiter.wipo.int/domains/decisions/html/200/d2000-1286.html>>. The case involved several domain names including <internicregistrations.com> and was granted.

a domain name which is identical or misleadingly similar to a country name appearing on the pre-determined list, without any right or legitimate interest on the part of the registrant in the name and where users are likely to be misled into believing that there is an association between the registrant and the constitutional authorities of the country in question.

Eligible Top-Level Domains

36. Subject to what is stated below in paragraph 32 regarding acquired rights, the Secretariat is of the view that the procedure should apply to all existing and future gTLDs. Applying the procedure only to the future gTLDs would render it meaningless at least in the short term, because it would take years before any beneficial impact it may have would be felt. In the meantime, currently existing abusive practices in the gTLDs would remain entirely undisturbed. It is recalled that the application of the UDRP to the gTLDs that were already in existence at the time of its creation was a prime reason for its appeal and success.

37. The Secretariat is also of the view that the procedure should apply to the ccTLDs, although it recognizes that this would require a decision on the part of the relevant administrators to adopt the procedure for their domains.

Acquired Rights

38. To the extent the procedure would apply to existing TLDs (and therefore to existing registrations), the question arises how acquired rights should be treated. The Secretariat shares the view expressed by many commentators that restricting the scope of the procedure to cases of bad faith would resolve this problem. In effect, it could not reasonably be argued that a registration which was obtained in bad faith can be the source of any legal entitlement (“*fraus omnia corrumpit*”). In January 2000, the UDRP came into force in respect of all existing registrations in the .COM, .NET and .ORG TLDs and, to date, this has not been the source of any difficulty. To the contrary, it has significantly contributed to the effectiveness of the UDRP as a means of combating cybersquatting.

The UDRP or Another Procedural Vehicle?

39. In order to give effect to the above key features of a desired procedure, two main avenues are possible: either the scope of the UDRP could be amended to cover also country names, or an entirely separate procedure, akin to, but distinct from the UDRP, could be created.

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

- (1) It would contribute to maintaining uniformity in domain name dispute resolution procedures, as the UDRP’s existing procedural framework would be relied upon as a protection mechanism.
- (2) Rendering the UDRP applicable to country names only would require a technical adjustment to the procedure (essentially taking the form of an amendment of the grounds on

which a complaint can be brought), without the need for a complete overhaul of the entire procedural framework.⁵⁵

(3) The UDRP provides protection for the identifiers to which it applies in relation to identical, as well as misleadingly similar, domain names.

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

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

41. However, relying on the UDRP for the protection of country names in the DNS also has a number of disadvantages:

(1) The UDRP leaves the reconsideration of a case lost by a registrant to the national courts. The procedure requires a complainant to submit to the jurisdiction of certain national courts for this purpose and this may be an obstacle for certain countries, in light of state immunity considerations. However, as noted in paragraph 32 above, several governments or governmental entities and institutions already have submitted complaints under the UDRP and, by doing so, have submitted to the jurisdiction of national courts.

(2) Filing a complaint under the UDRP entails certain costs. Currently, the WIPO Arbitration and Mediation Center charges US\$1500 for a case involving one to five domain names that is to be decided by a single member panel and US\$3000 if it is to be decided by a three-member panel. While these costs are not insignificant, they are considerably lower than the cost of litigation before the national courts.

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

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

(2) Instead of resorting to national courts for the reconsideration of cases, the system could incorporate an administrative appeal mechanism, which would be less problematic from the point of view of the immunities of States.

⁵⁵ This could be achieved by incorporating, for instance, the following clause into the UDRP: “For the purposes of this Policy, a country is deemed to have rights in its name in accordance with Paragraph 4(a)(iii). A domain name which is identical or confusingly similar to a country name will be deemed to have been registered and used in bad faith in accordance with Paragraph 4(a)(iii) if users are likely to be misled into believing that there is an association between the domain name registrant and the constitutional authorities of the country concerned. Country names are to be determined by reference to [the pre-determined list].”

(3) States could be designated to act as the custodians of the system, rather than ICANN, in light of its special aim and purpose.

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

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

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

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

44. The SCT is invited to decide whether it would be appropriate to protect country names through an administrative dispute resolution procedure. If the SCT were to decide this to be appropriate, the SCT also is invited to decide:

(i) whether such procedure should have the characteristics proposed in paragraphs 28 through 38; and

(ii) whether such procedure should be effectuated through an amendment to the UDRP or by the creation of a new mechanism akin to the UDRP.

[Annex follows]

ANNEX

List of Governments and Organizations
Submitting Comments on the Protection of Country Names in the Domain Name System

I. STATES

COUNTRY	AGENCY
Canada	Government of Canada
China	Trademark Office State Administration for Industry and Commerce
Colombia	Department of Multilateral Economic, Social and Environmental Affairs Ministry of External Relations
Croatia	State Intellectual Property Office
Cuba	Cuban Industrial Property Office
Denmark	Danish Patent and Trademark Office
Estonia	Estonian Patent Office
France	Government of France
Ireland	Intellectual Property Unit Department of Enterprise, Trade and Employment
Kenya	Kenya Industrial Property Office Ministry of Trade and Industry
Kyrgyzstan	State Agency of Science and Intellectual Property
Hungary	Hungarian Patent Office
Latvia	Patent Office
Lithuania	State Patent Bureau of the Republic of Lithuania
Mexico	Mexican Industrial Property Institute
Netherlands	Directorate-General for Telecommunications and Post Ministry of Transport, Public Works and Water Management
New Zealand	Ministry of Economic Development
Portugal	National Institute of Industrial Property Ministry of Economy
Republic of Moldova	State Agency on Industrial Property Protection
Spain	Spanish Patent and Trademark Office Ministry of Science and Technology
Turkey	Turkish Patent Institute Department of International Affairs

COUNTRY	AGENCY
Ukraine	State Department of Intellectual Property Ministry of Education and Science
United Kingdom	Intellectual Property Policy Directorate The Patent Office
United States of America	Patent and Trademark Office (USPTO) United States Department of Commerce
Uruguay	National Directorate of Industrial Property

II. ORGANIZATIONS

International Trademark Association
Japan Patent Attorneys Association
Japan Trademark Association
Arbitration Center for Industrial Property, Japan
Network Information Center, Mexico

[End of Annex and of document]