

A SUMMARY OF THE FINAL REPORT OF THE SECOND WIPO INTERNET DOMAIN NAME PROCESS

By Peter K. Yu

Introduction

In September 2001, the World Intellectual Property Organization (WIPO) released its final report of the Second WIPO Internet Domain Name Process (the “Second Report”). This report provides recommendations on how to deal with bad-faith, abusive, misleading or unfair registration and use of identifiers other than trademarks as domain names.

Four years earlier, WIPO conducted its first Internet Domain Name Process, which focused on problems created by the conflict between domain names and trademarks. After extensive consultation, WIPO published its final report of that process (the “First Report”). To deal with cybersquatting—bad-faith registration and use of trademarks as domains names—the First Report recommended the establishment of a uniform dispute resolution policy.

Since publication of the First Report, the Internet Corporation for Assigned Names and Numbers (ICANN)—the accreditation body in the generic top-level domains (gTLDs), including “.com,” “.net” and “.org”—adopted the mandatory Uniform Domain Name Dispute Resolution Policy (UDRP). Providing an efficient and cost-effective means to resolve domain name disputes, the UDRP has been applied in more than 4,000 cases and was voluntarily adopted by more than 20 country-code top-level domains (ccTLDs).

Despite the success of the First Report, several issues, in particular those concerning identifiers other than trademarks, remained unresolved. To fill this void, several WIPO member states called on the international intergovernmental body to conduct a second process. After a year of international consultation, WIPO finally released its Second Report.

The Second Report makes recommendations on how to deal with problems arising from conflicts between domain names and a range of naming systems, including standard nonproprietary names for pharmaceutical substances, the names and acronyms of international intergovernmental organizations, personal names, geographical indications and terms and trade names. The Second Report also contains practical recommendations concerning the “Whois” databases and search facilities. (As of this writing, none of these recommendations has been adopted or implemented.)

International Nonproprietary Names for Pharmaceutical Substances

Over the course of the years, the World Health Organization (WHO), in coordination with national authorities worldwide, has developed a class of unique identifiers for pharmaceutical substances known as the International Nonproprietary Names (INNs). Examples of INNs include, among others, amoxicillin, ampicillin, amphetamine and ibuprofen.

Under existing law, one cannot acquire proprietary rights, including trademark rights, in any INNs. However, because anyone can register a domain name without restrictions on a first-come, first-served basis, anyone may be able to register an INN as a domain name. Such registrations

not only create confusion among consumers, patients and health professionals, but they also present public safety concerns when inaccurate and misleading information is included in the website accessed through a domain name using an INN.

To alleviate these concerns, the Second Report recommends that ICANN's registration accreditation agreements and all gTLD domain name registration agreements include a provision prohibiting the registration of a domain name that is identical to any of the INNs registered in the Cumulative List of recommended INNs in all official languages (Arabic, Chinese, English, French, Latin, Russian and Spanish).

The Second Report also recommends that any interested party be granted the right to serve notice that a domain name registration in a gTLD is identical to an INN and that the domain name be canceled upon verification by WIPO and WHO of the identity, upon notice to ICANN and upon certification by ICANN to the registrar concerned. Moreover, the report recommends that the prohibition be applied to all existing and future domain name registrations and that ccTLD administrators adopt a corresponding policy in consultation with their national health authorities.

The Second Report, however, does not recommend the modification of the UDRP to include misleading variations—such as misspellings—of the INNs. As the report explains, there is no convincing evidence that the registration of these misleading variations as domain names has damaged the integrity of the INN system. Further protection of INNs also may increase the administrative and transaction costs associated with the domain name system. Nevertheless, WIPO may revisit the question in later processes if the problem with INNs exacerbates.

Names and Acronyms of International Intergovernmental Organizations

As the world becomes increasingly globalized, international intergovernmental organizations (IGOs)—such as the United Nations, the Food and Agricultural Organization, the International Labour Organization, the International Monetary Fund and the World Trade Organization—will play a greater role in our daily lives. Information about their activities and services and our communication with them are therefore very important.

However, a website that is accessed through a domain name using the IGO's name or acronym may not necessarily lead you to the official website of the organization. For example, unitednations.org leads you to a portal operated by a California-based company, and imf.com advertises a strategy game released by Mobilefreon. These unrelated websites may lead viewers to believe that they have visited an IGO's official website, thus causing consumer confusion. Some of these websites even may contain misleading, inaccurate or prejudicial information that might damage the IGO's reputation.

To make the matter even more complicated, a registrant may have a good-faith registration of the acronym of an IGO as a domain name. For example, as the Second Report points out, "UNO" not only stands for the United Nations Organization, but is "one" in Italian, a Fiat car model and a Swiss card game. "ICC" is the abbreviation of both the International Chamber of Commerce and the Internet Commerce Corporation. And "WIPO" is a registered U.S. trademark for tissues for personal and industrial use.

Under existing law, one cannot use the names and acronyms of IGOs as trademarks without the IGO's authorization. Article 6ter of the Paris Convention for the Protection of Industrial Property ("Paris Convention") specifically prohibits the registration and use of the abbreviations and names of IGOs as trademarks or elements of trademarks. The Trademark Law Treaty of 1994 includes similar prohibitions concerning service marks.

Consistent with this legal framework, the Second Report recommends that the names and acronyms of IGOs that benefit from protection under Article 6ter of the Paris Convention be protected from abusive registrations of domain names.

Because the UDRP fails to accommodate the privileges and immunities customarily granted to the IGOs, the Second Report recommends the establishment of a special administrative procedure developed and supervised by the international community. Under this procedure, qualifying IGOs would be able to file a complaint that a domain name registration is the same as, or misleadingly similar to, the name or acronym of the IGO, that there is no legal justification for the registration and that the registration is likely to mislead users into believing that an association exists between the domain name registrant and the IGO in question.

In addition, the Second Report recommends that remedies under the new procedure be limited to the cancellation or transfer of domain name registration and that the result of the procedure be enforced through contractual arrangement with ICANN. The report also recommends that the procedure be applied to domain name registrations in all gTLDs and ccTLDs (with the cooperation of corresponding local authorities).

Personal Names

Identity is a fundamental attribute of human dignity, and the unauthorized registration of personal names as domain names may offend sensitivities. However, although personality rights are recognized and protected throughout the world, there is no existing international norm concerning the protection of personal names.

Rather, protection is granted using different legal approaches, including common law principles, civil law provisions, statutory rights of publicity, privacy law and criminal law. As a result, the nature and scope of protection granted to personal names vary from one jurisdiction to another.

In light of this disparity, the Second Report recommends that no modification be made to the UDRP to provide broader protection for personal names than what currently is available in the UDRP—that is, the protection of personal names that qualify as trademarks. As the report explains, the wide differences in the protection of personality rights across the world would create a perception that the UDRP decisions are unfair. That perception would invite people to challenge the decisions in courts and eventually would damage the long-term credibility and continued viability of the UDRP.

Nonetheless, the Second Report acknowledges the UDRP's inability to protect those eminent political, scientific or religious persons who have not profited commercially from their reputation. The report also recognizes the injustice created by the unauthorized, bad-faith registration and

use of personal names as domain names and invites the international community to develop new norms that address the insufficiencies of the current international legal framework.

At the ccTLD level, however, the Second Report notes that the lack of international norms becomes less significant. Thus, the report suggests that the ccTLD administrators may modify the dispute resolution procedure to reflect local law that protects personal names against abusive domain name registrations.

Geographical Identifiers

There is a well-established legal framework prohibiting the misuse of geographical identifiers at the international, regional and national levels. This framework prohibits false description of the geographical source of goods—such as “Made in U.S.A.”—and the misuse of a special class of geographical source indicators known as geographical indications, which are commonly used to protect agricultural products, wines and spirits.

Notwithstanding the importance of this protection and the widespread evidence of abuse of geographical identifiers as domain names, the Second Report finds two major obstacles to implementing new protection for geographical indications and identifiers.

First, the existing international legal framework for protecting the false, deceptive and abusive use of geographical indications and identifiers—such as the Paris Convention, the Madrid Agreement and the TRIPs (Trade-Related Aspects of Intellectual Property Rights) Agreement—was developed for, and applies to, trade in goods, rather than use in the domain name system.

Second, the protection of those identifiers varies from one jurisdiction to another. Given the lack of consensus on the definition of geographical indications and the scope of protection concerning those identifiers, it is very difficult to ascertain the applicable law.

In sum, the Second Report recommends that no modification be made to the UDRP to permit complaints concerning the abusive registration and use of geographical indications and identifiers as domain names.

With respect to the names of countries and other geographical localities, the Second Report does not provide any specific recommendations. Rather, it acknowledges the limitation of the WIPO consultation process and recommends that the question be further considered in the appropriate intergovernmental fora.

As the report explains, some governments consider their national sovereign interest to determine whether they should permit the registration of country names in the gTLDs. Thus, WIPO believed it is inappropriate to make any recommendations regarding this issue.

Furthermore, protecting country names in the gTLDs would require the creation of new law, a function traditionally reserved for states. Such creation also would depart from the fundamental principles underlying the First Report, which seeks to avoid the creation of new intellectual

property rights or the granting of enhanced rights in cyberspace, as compared to what already exists in the physical world.

Finally, the Second Report cautions about the potential confusion and abuse regarding domain names using the ISO 3166 country alpha-2 code elements—the standardized codes for countries used at the ccTLD level, such as “fr” for France or “uk” for the United Kingdom. For example, a domain name that has “pepsi” at the third level and “uk” at the second level—pepsi.uk.com—undoubtedly would be misleadingly similar to pepsi.uk or pepsi.com.uk.

Thus, the Second Report recommends that ISO 3166 alpha-2 country code elements be registered as domain names in the gTLDs in a manner that minimizes the potential for confusion with domain names in the ccTLDs. Citing the difficulty of enforcement and the unfairness of subjecting holders of non-abusive third-level domains to cancellation or transfer, the Second Report recommends those who have country codes as domain names in the gTLDs and who accept registrations at the third or higher levels apply the UDRP to those registrations and ensure that the UDRP decisions be properly and promptly implemented.

Trade Names

Trade names are informal names companies use to identify themselves and to distinguish them from other businesses and enterprises. Examples of trade names include Ericsson, Holiday Inn, Microsoft, Nestlé and Sony, among countless others.

Although trade names are recognized in many jurisdictions and in the Paris Convention, there are wide variations in countries’ approaches to the protection of trade names. Throughout the world, trade names are protected through a combination of civil and criminal law, commercial law, trade practices, trade name and trademark legislation and common law principles of unfair competition and passing off.

In addition, the level of importance a nation grants to trade name protection vis-à-vis other rights varies from one jurisdiction to another. For example, as the Second Report points out, businesses in the Scandinavian countries are protected more commonly through registered trade name protection than through trademark law. Thus, trade names may receive stronger protection than trademarks in those countries.

In light of the absence of an internationally harmonized scheme for the protection of trade names and the potential difficulty in ascertaining the applicable law, the Second Report recommends that no modifications be made to the UDRP concerning the abusive registration and use of trade names. Thus, the UDRP will not be applicable except in those instances when trademark rights also are involved.

“Whois” Information and Search Facilities

The “Whois” system of databases collects information concerning the domain name registrants—such as the registrants’ full name, postal address, e-mail address, telephone and facsimile number—as well as other technical and administrative data.

Available in real time, this information helps rightsholders identify and locate possible infringers, allows customers to identify online merchants and enables law enforcement authorities to investigate illegal activities. The Whois databases also provide technical information that helps network administrators correct network problems and determine the perpetrators of spam or hacking attacks. The information also promotes the due process of the law by enabling registrants to be notified of any legal or administrative proceedings against them.

Unfortunately, registrars rarely check the information for veracity or completeness when the registrant first enters the information, nor do they update the information after the initial registration. As a result, information available through the Whois search facilities may be inaccurate, outdated and unreliable.

Thus, the Second Report recommends that registration authorities take measures to ensure that Whois data is accurate, reliable, up-to-date and publicly accessible. The report also recommends the establishment of a centralized Whois database that provides comprehensive search facilities across data from all accredited providers. That database is particularly needed in light of the increased competition among gTLD registrars and the resulting decentralization of responsibility for Whois services.

The Second Report also recommends the development of comprehensive search facilities across all registrars' databases using search terms other than the exact domain name. This enhanced feature would allow users to ascertain and to prove a pattern of abusive bad-faith registrations.

With regards to the ccTLDs, the Second Report recommends that administrators adopt policies for the collection, verification and public availability of Whois data via online databases that seeks to be uniform with the Whois system at the gTLD level.

Conclusion

The Second Report provides a lot of recommendations. Yet, most of these recommendations are constrained, and none of them is groundbreaking. Compared to the First Report, the Second Report tells us more about what we should **not** do than what we **should** do. Nonetheless, the Second Report teaches us several things about Internet policy and the online community.

First, the Internet community consists of a large variety of organizations and individuals who use the Internet for different purposes—including research, science, technology, commerce, culture, entertainment, leisure, communication, religion, politics and even pornography.

To accommodate this diverse range of interests, the Second WIPO Internet Domain Name Process includes three Requests for Comments (RFCs) conducted in three different languages (English, French and Spanish). These RFCs were published on both the WIPO website and in paper format, and the paper version of each RFCs was sent to governments and industrial property offices of the WIPO member states and to IGOs and nongovernmental organizations (NGOs) accredited with observer status at WIPO.

In addition, WIPO organized physical meetings in 10 different countries in six continents (Argentina, Australia, Belgium, Brazil, Ghana, Jordan, Thailand, Poland, Spain and the United States). Through the RFCs and physical participation, WIPO enlisted responses from and participation of 51 government agencies from 28 countries, 18 IGOs, 44 NGOs, 201 corporations and professional firms and 184 individuals.

Second, because the Internet is theoretically accessible by anyone anytime anywhere, regulation is very difficult. Most of the time, regulation would implicate different political and legal systems and would involve serious questions as to who has authority to make policy for a global space and to enforce that policy.

As the Second Report demonstrates, there are limitations to both the UDRP and the WIPO Internet Domain Name Process. At some point in time, the international community must gather to resolve their problems and differences by creating new international norms. Delegation to an international intergovernmental body was no solution, especially when there is no clear guidance on the intention and will of the international community.

Finally, there are different models for developing an intellectual property policy concerning the Internet. Among the models discussed in the Second Report are:

- **Self-Regulation.** Under this model, domain name registries develop and adopt rules governing intellectual property protection within the domains for which they are responsible.
- **ICANN Contractual Model.** This model involves a hierarchical structure—such as ICANN—that uses contractual arrangement to implement common rules governing the interface between domain names and intellectual property.
- **Treaty.** States traditionally use this model to create binding rules that limit the inconsistent exercise of national legislative power.

Each model has its own advantages and disadvantages and therefore should be adopted in light of the particular circumstances.

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