

# ICANN's New gTLD Program: Trademark-related Concerns

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**Arbitration and Mediation Center  
World Intellectual Property Organization**



# World Intellectual Property Organization

- Intergovernmental organization with 184 Member States, dedicated to the promotion of balanced and accessible intellectual property systems.
- Addressing IP questions raised by the DNS since 1998.
- Undertook the First and Second WIPO Internet Domain Name Processes to develop recommendations addressing the interface between IP and DN systems.
- Report of the First WIPO Internet Domain Name Process led to ICANN's adoption of the UDRP.
- Adopted in 2001, the "Joint Recommendation Concerning Provisions on the Protection of Marks, and Other Industrial Property Rights in Signs, on the Internet."
- Produced in 2005, upon ICANN's request, Report on "New Generic Top-Level Domains: Intellectual Property Considerations."

# WIPO Arbitration and Mediation Center

## Non-Domain Names

- *ADR Resource Institution*
- *Administering Authority*
  - Arbitration, mediation, expert determination cases relating to patent, software/IT, copyright, trademark, consultancy, distribution agreements, joint venture, employment, etc.

## Domain Names

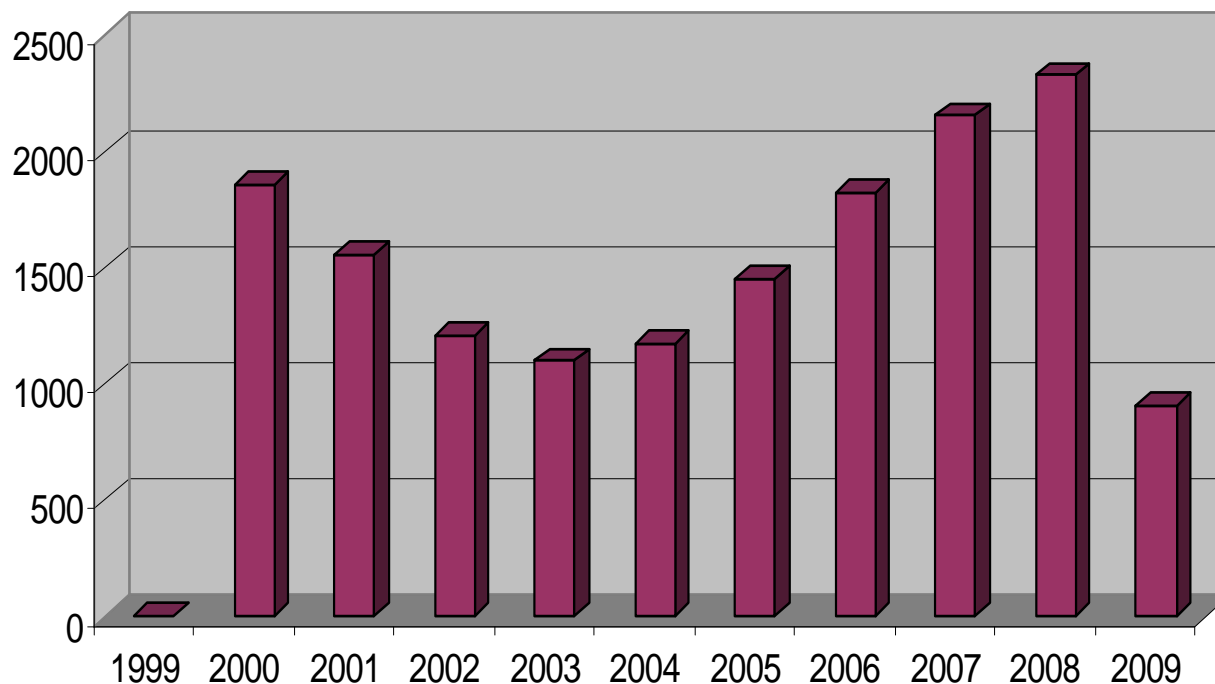
- *Policy Development:* UDRP, registry specific policies (.biz, .info, .mobi, .asia), and ccTLDs
- *Case Administration*
  - Administered over 15,500 UDRP/UDRP-based cases, involving over 27,700 domain names.
  - Administered over 15,000 cases under registry-specific policies (.biz STOP, .info Sunrise, .name ERDRP, .mobi sunrise and Premium Name Trademark Application Rules).
  - Provides dispute resolution services to 58 ccTLDs.

# ICANN-Envisaged New gTLDs Expansion: Trademark-related Concerns

- Presents business opportunities as well as legal and practical challenges.
- WIPO Press Release of March 16, 2009: “This is a watershed moment in the development of the Domain Name System (DNS), and is of genuine concern for trademark holders.”
- Concerns broadly shared and expressed, including by governments (GAC Principles regarding New gTLDs, March 2007, and ensuing documents).

**Trademark abuse → consumer confusion  
→ undermining of public trust in the DNS**

# WIPO UDRP Domain Name Cases: Cybersquatting remains on the rise

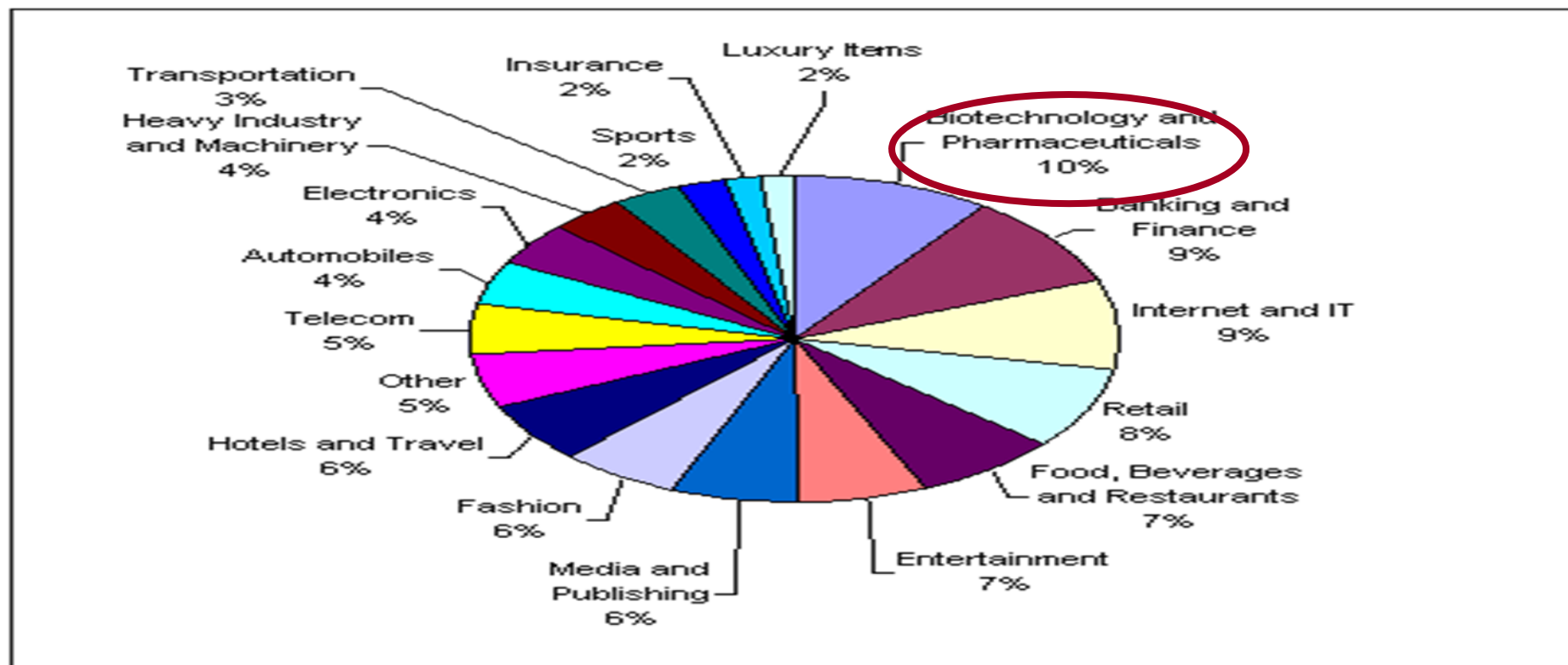


Year	Number of Cases
1999	1
2000	1857
2001	1557
2002	1207
2003	1100
2004	1176
2005	1456
2006	1824
2007	2156
2008	2329

◆ **2,329 cases filed in 2008 represent an 8% increase over 2007.**

# Areas of WIPO UDRP Complainant Activity (2008)

## - no sector is spared from cybersquatting



◆ Pharmaceutical manufacturers remained top filers – domain names used to provide online sales of (counterfeit) medications and drugs

- D2008-1419 <acompliabuyonline.com>: “an online pharmacy site on which the Respondent sells a large variety of drugs including counterfeit products and placebo products”
- D2005-0552 <bloussantadvanced.com >: “Respondent’s sale of counterfeit goods on a website accessible through the Domain Name is paradigmatic bad faith. [...] registered this Domain Name with the bad faith intent to deceive consumers with its counterfeit products.”
- D2004-0794 <cialisapcalis.com>, <cialis-viagra.info>: “Respondent is using the contested domain names in a way that is potentially harmful to the consumers’ health. In fact, Respondent’s website creates the false impression that those who purchase pharmaceutical products from Respondent’s website are buying safe and effective products from Complainant that have been approved by health authority laws and regulations. [...] The products sold on Respondent’s website are therefore illegal and potentially dangerous.”

(Full text of decisions is available on the WIPO Center’s website at:

<http://www.wipo.int/amc/en/domains/search/> )

<http://www.wipo.int/amc/en/domains/resources/icann>



<a href="#">D2006-0519</a>	4tamiflu.com	F. Hoffmann-La Roche AG	ORG-174337	<a href="#">Transfer</a>
<a href="#">D2006-0512</a>	puretamiflu.com	F. Hoffmann-La Roche AG	N/A	<a href="#">Transfer</a>
<a href="#">D2006-0467</a>	order-tamiflu-h5n1.com	F. Hoffmann-La Roche AG	Martha Sypkens	<a href="#">Transfer</a>
<a href="#">D2006-0466</a>	tamiflu-tamiflu.com	F. Hoffmann-La Roche AG	Eugenia Moskovchuk	<a href="#">Transfer</a>
<a href="#">D2006-0451</a>	all-about-tamiflu.com	F. Hoffmann-La Roche AG	Macalve e-dominios S.A.	<a href="#">Transfer</a>
<a href="#">D2006-0448</a>	tamiflu-antibiotic.com	F. Hoffmann-La Roche AG	Tamiflu-Antibiotic.com	<a href="#">Transfer</a>
<a href="#">D2006-0424</a>	tamifluonline.org	F. Hoffmann-La Roche AG	Titan Net	<a href="#">Transfer</a>
<a href="#">D2006-0410</a>	tamifluandeffectivenessandsafety.com tamifludogsveterinary.com tamifluedorel.com tamifluparvo.com tamiflucaterincolorado.com	F. Hoffmann-La Roche	Xrt Services P/L	<a href="#">Transfer</a>
<a href="#">D2006-0404</a>	buytamifluonline.net	F. Hoffmann-La Roche AG	Dron&K	<a href="#">Transfer</a>
<a href="#">D2006-0386</a>	purchasetamiflu.org	F. Hoffmann-La Roche AG	Domain Master	<a href="#">Transfer</a>
<a href="#">D2006-0371</a>	detamiflu.info	F. Hoffmann-La Roche AG	Alexander	<a href="#">Transfer</a>
<a href="#">D2006-0357</a>	planetatamiflu.com super-tamiflu.info tamiflumondo.com	F. Hoffmann-La Roche AG	AndrewZZZ	<a href="#">Transfer</a>
<a href="#">D2006-0354</a>	tamifluvacine.com	F. Hoffmann-La Roche AG	Brian Pubrat	<a href="#">Transfer</a>
<a href="#">D2006-0348</a>	buycheaptamiflu.com	Hoffmann-La Roche Inc.	US Online Pharmacies	<a href="#">Transfer</a>
<a href="#">D2006-0327</a>	rumsfeldandtamiflu.net sambucolvstamiflu.com tamifluforsale.com tamifluforsale.org tamifluuk.net tamifluscams.com	F. Hoffmann-La Roche AG	DOMIBOT	<a href="#">Transfer</a>
<a href="#">D2006-0326</a>	onlineconsultationtamiflu.com whatistamiflu.com	F. Hoffmann-La Roche AG	Spiral Matrix	<a href="#">Transfer</a>
<a href="#">D2006-0308</a>	tamiflu-cure.com	Hoffmann-La Roche Inc.	Tamiflu Shop	<a href="#">Transfer</a>
<a href="#">D2006-0306</a>	eccellentetamiflu.com superioretamiflu.com virtualetamiflu.com	F. Hoffmann-La Roche AG	Fred	<a href="#">Transfer</a>
<a href="#">D2006-0246</a>	super-tamiflu.com	F. Hoffmann-La Roche AG	Fred	<a href="#">Transfer</a>



# WIPO Proposals, Comments

1. Trademark-Based Pre-Delegation Dispute Resolution Procedure for New gTLD Registries.
2. Trademark-Based Post-Delegation Dispute Resolution Procedure for New gTLD Registries ( / Registrars).
3. Discussion Draft Trademark-Based Expedited (Domain Name) Suspension Mechanism (2<sup>nd</sup> and lower level registrations).
4. Comments to IRT Draft and Final Reports.

## **WIPO Recommendations**

### **1. Trademark-based Pre-Delegation Dispute Resolution Procedure (published in DAG I & II)**

- WIPO Center responded on January 18, 2008, to ICANN's request for "Expressions of Interest from Potential Dispute Resolution Service Providers for New gTLD Program."
- Worked with ICANN in the development of the substantive criteria for the Legal Rights Objections (LRO) procedure - taking into account the "WIPO Joint Recommendation Concerning Provisions on the Protection of Marks, and Other Industrial Property Rights in Signs, on the Internet."
- Accepted to administer disputes under LRO Procedure.

## *WIPO Recommendations*

### **2. Trademark-Based Post-Delegation Dispute Resolution Procedure**

- In Jan 18, 2008 letter, WIPO called for a permanent administrative option to allow for filing of complaints, when the registry's actual manner of operation or use is alleged to cause or materially contribute to trademark abuse.
- ICANN confirmed availability of trademark-based post-delegation mechanism in the New gTLD Program Explanatory Memorandum on "Protection of Rights of Others in New gTLDs" of Oct 8, 2008
- WIPO Center communicated to ICANN on Feb 5, 2009, a substantive proposal for a trademark-based post-delegation dispute resolution procedure.

## *WIPO Recommendations*

### **2. Trademark-Based Post-Delegation Dispute Resolution Procedure (cont'd)**

- Intended as a form of standardized assistance to ICANN's own compliance oversight responsibilities, provides an administrative alternative to court litigation, encourages responsible conduct by relevant actors, and enhances the security and stability of the DNS.
- The criteria build on pre-delegation LRO criteria and consideration factors, existing UDRP jurisprudence, and accepted principles of law.

## *WIPO Recommendations*

### **2. Trademark-Based Post-Delegation Dispute Resolution Procedure (cont'd)**

#### Scenarios:

- E.g., Registry uses the TLD for a purpose unreasonably inconsistent with relevant representations made in the application phase, such that trademarks are infringed.
- E.g., TLD operator turns a blind eye to systemic cybersquatting in its domain, instead of adopting appropriate mechanisms to counter such abuse.

## *WIPO Recommendations*

### 2. Trademark-Based Post-Delegation Dispute Resolution Procedure (cont'd)

- Given the perceived convergence of registry, registrar, and registrant roles within the DNS, the WIPO Center further recommends to extend the concept behind this proposal also to address relevant registrar conduct.
- See WIPO Letter to ICANN of April 9, 2009, on the observed conduct of one particular ICANN-accredited registrar. Alleged conduct in lawsuits involving the registrar included “UDRP evasion services” and “contributory cybersquatting.”

## *WIPO Recommendations*

### **3. Discussion Draft Expedited (Domain Name) Suspension Mechanism**

- Communicated to ICANN on April 3, 2009.
- Intended to present options for brand owners to combat cybersquatting in a cost and time effective manner.
- Intended as a narrowly tailored complement to the UDRP.
- Includes an important safety valve mechanism for defaulting respondents.



# WIPO Comments to IRT Reports

- WIPO Comments to Draft IRT Report (May 10, 2009).
- WIPO Comments to Final IRT Report (June 18, 2009).
- IRT Reports represent substantive progress and a serious foundation for mechanisms designed to prevent trademark abuse.
- WIPO Center commends the IRT for the Final IRT Report, and the consequential efforts of individual IRT members.
- WIPO Center looks forward to continued dialogue.

## General Comments

- System design should minimize burdens on users and stakeholders.
- Implementation should take account of operational realities.
- Relationship between mechanisms should be further clarified.

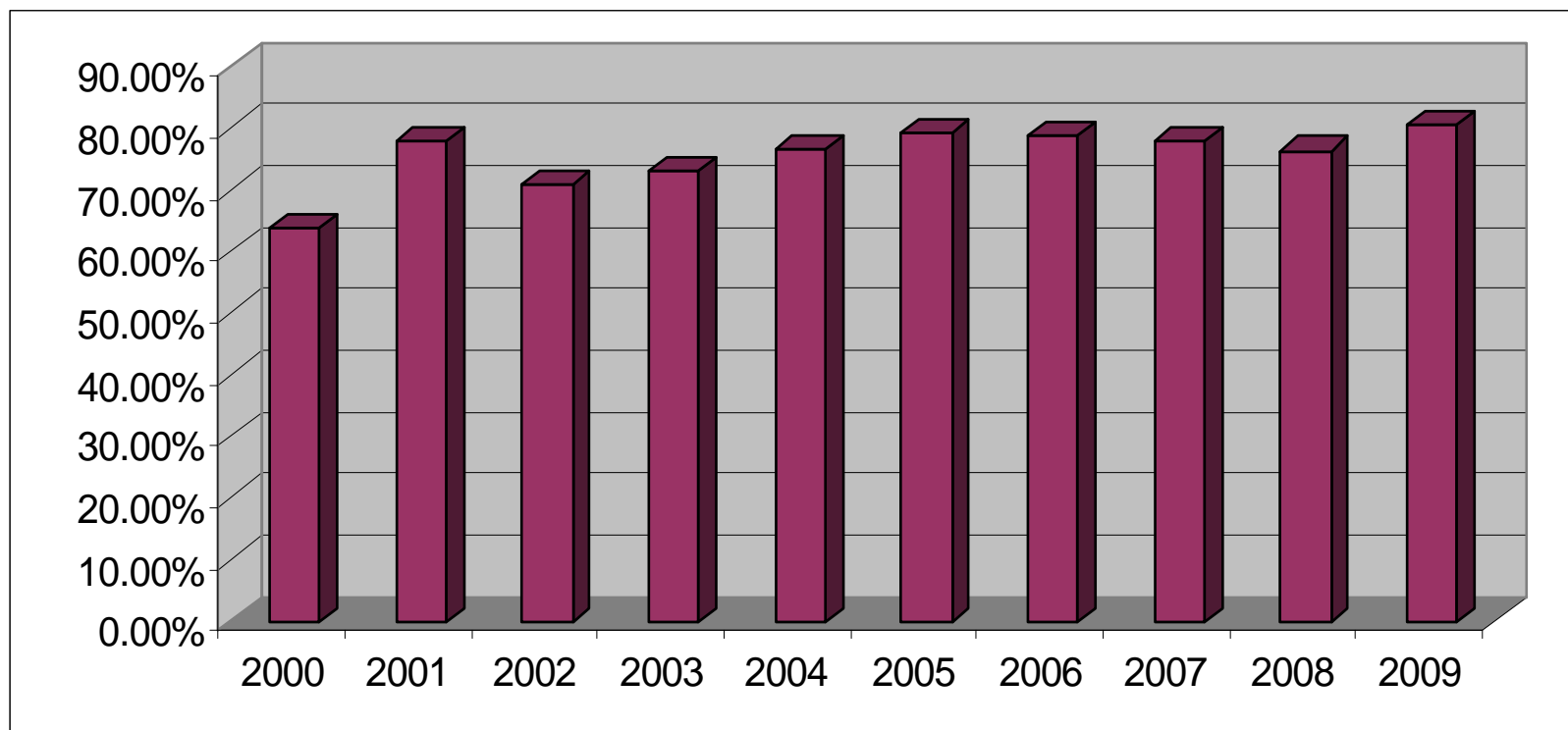
## IP Clearinghouse

- Ubiquitous role envisaged for the Clearinghouse calls for adequate safeguards and ICANN oversight.
- Differentiation of roles may be appropriate for the Clearinghouse.
- Trademark owners should not shoulder the entire burden of financing a Clearinghouse.

## Uniform Rapid Suspension Mechanism

- Requiring panelist evaluation even in URS default cases would unnecessarily increase costs and burdens to trademark owners.
- The duration of the proposed remedy is of limited effectiveness.
- The URS must interoperate with the UDRP.
- The URS substantive criteria adaptations are not clear.
- Elements of the URS may be adjusted with a view to time and cost-efficiency.

# WIPO UDRP Cases: Respondent Default



Looking at WIPO UDRP Cases - the vast majority are undefended - overall default rate in WIPO cases around 75%

## Post-Delegation Dispute Resolution Mechanism at the Top Level

- Post-delegation system design must bear in mind its intended preventive effect.
- Trademark owners should be given the option to initiate a post-delegation *sua sponte*.
- We recommend an analogous dispute resolution procedure for ICANN-accredited registrars.

# Additional Information

Email: [arbiter.mail@wipo.int](mailto:arbiter.mail@wipo.int) ; [brian.beckham@wipo.int](mailto:brian.beckham@wipo.int)

Website: <http://www.wipo.int/amc/en/domains/resources/icann>



The screenshot shows a Windows Internet Explorer browser window with the address bar displaying <http://www.wipo.int/amc/en/domains/resources/icann/index.html>. The page content includes the WIPO logo and navigation menu. The main heading is "Selected WIPO UDRP-related Correspondence with ICANN". Below this heading is a list of links:

- [Letter of June 18, 2009 to ICANN and IRT on Final IRT Report](#) New
- [Letter of May 10, 2009 to IRT on Draft IRT Report](#)
- [Letter of April 9, 2009 Concerning the Registrar Lead Networks](#)
- [Letter of April 3, 2009 on WIPO Discussion Draft – Model Expedited \(Domain Name\) Suspension Mechanism](#)
- [Letter of March 13, 2009 on WIPO-Proposed New gTLD Post-Delegation Procedure](#)
- [Letter of December 30, 2008 on WIPO eUDRP Initiative](#)
- [Letter of November 27, 2008 concerning draft registrar best practices](#)
- [Letter of July 1, 2008 following up on registrar practices](#)
- [Letter of April 16, 2008 on registrar practices](#)
- [Letter of November 29, 2007 on UDRP dispute resolution service providers](#)
- [Letter of July 4, 2007 principally on UDRP dispute resolution service providers](#)

The browser's taskbar at the bottom shows the start button, several open applications (Internet Explorer, New\_gTLD\_Backgrou..., My Documents, WIPO ICANN Sydney, DRT\_WF5GL\_Present...), and the system tray with the date and time (Monday, 6/22/2009, 7:27 PM).