

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

**Forty-Seventh Session**  
**Geneva, March 18 to 20, 2024**

### **UPDATE ON TRADEMARK-RELATED ASPECTS OF THE DOMAIN NAME SYSTEM (DNS)**

*Document prepared by the Secretariat*

1. At the forty-sixth 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/46/3 (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 (DNS) (see document SCT/46/8). 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 Intellectual Property (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 First<sup>1</sup> and Second<sup>2</sup> WIPO Internet Domain Name Processes. Through the Arbitration and

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<sup>1</sup> 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>.

<sup>2</sup> 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: <https://www.wipo.int/amc/en/processes/process2/report>.

Mediation Center (Center), WIPO provides trademark owners with efficient international mechanisms to deal with the bad-faith registration and use of domain names corresponding to their trademark rights. The principal mechanism administered by the Center, the Uniform Domain Name Dispute Resolution Policy (UDRP) was adopted by the Internet Cooperation for Assigned Names and Numbers (ICANN) on the basis of recommendations made by WIPO in the First WIPO Internet Domain Name Process.

3. The UDRP is limited to clear cases of bad-faith, abusive registration and use of domain names and remains in high demand for trademark owners<sup>3</sup>. Since December 1999, the Center has administered some 67,000 UDRP-based cases<sup>4</sup>. Trademark holders in 2023 filed 6,192 UDRP-based complaints with the Center, an 8 per cent increase over 2022 filing (already a record at the time), the eighth consecutive year that WIPO domain name case filings have surpassed 3,000, and the tenth consecutive year marking an increase in filing generally. In 2023, the total number of domain names in WIPO UDRP-based cases brought by brand owners surpassed 122,000.

4. A diverse mixture of enterprises, institutions, and individuals used the Center's domain name dispute resolution procedures in 2023. The top sectors for complainant business activity were Banking and Finance; Biotechnology and Pharmaceuticals; Internet and IT; Retail; Food, Beverages, and Restaurants; and, Fashion. Nowadays, filings from rights owners include alleged fraudulent email or phishing schemes, impersonation, and other illicit uses of consumer-facing websites (e.g., counterfeits) associated with the disputed domain names. Reflecting the global scope of this dispute mechanism, named parties to WIPO cases from UDRP inception through 2023 represented over 185 countries. In function of the language of the applicable registration agreement of the domain name at issue, WIPO UDRP proceedings have so far been conducted in nearly 30 languages<sup>5</sup>.

5. All WIPO UDRP panel decisions are posted on the Center's website. Published in 2017, the Center's Third Edition of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions (WIPO Overview 3.0)<sup>6</sup> has been widely embraced by parties to proceedings and is applied by panelists across most cases nowadays. This globally-consulted online overview of decision trends on important case issues covers over 100 topics, including citations to almost 1,000 representative decisions from over 265 WIPO Panelists. To facilitate access to these decisions according to party business sector and dispute subject matter, the Center also offers an online searchable Legal Index of WIPO UDRP Decisions<sup>7</sup>. These WIPO resources are accessible free of charge.

6. Mindful of WIPO's foundational role in the UDRP, the Center monitors developments in the DNS with a view to adjusting its resources and practices. With the exceptions of 2020 and 2021 given the global COVID-19 pandemic, the Center regularly organizes, including most

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<sup>3</sup> The UDRP does not prevent either party from submitting a dispute to a competent court of justice; but very few cases that have been decided under the UDRP have been brought before a court. See Selected UDRP-related Court Cases at <http://www.wipo.int/amc/en/domains/challenged>.

<sup>4</sup> The Center makes available online real-time statistics to assist WIPO UDRP case parties and neutrals, trademark attorneys, domain name registrants, domain name policy makers, the media, and academics. Available statistics cover many categories, such as "areas of complainant activity", "domain name script", and "25 most cited decisions in complaint". See <https://www.wipo.int/amc/en/domains/statistics>.

<sup>5</sup> In alphabetical order, Bulgarian, Chinese, Czech, Danish, Dutch, English, Estonian, Finnish, French, German, Greek, Hebrew, Hungarian, Indonesian, Italian, Japanese, Korean, Norwegian, Polish, Portuguese, Romanian, Russian, Slovak, Spanish, Swedish, Turkish, Ukrainian, and Vietnamese.

<sup>6</sup> See <http://www.wipo.int/amc/en/domains/search/overview3.0/>. The increased scope of WIPO Overview 3.0 since publication of version 2.0 in 2011 reflects a range of DNS and UDRP case evolutions in the near doubling of cases managed by the Center since then. The WIPO Overview is instrumental in developing and maintaining consistency of WIPO UDRP jurisprudence.

<sup>7</sup> See <http://www.wipo.int/amc/en/domains/search/legalindex/>.

recently in November 2023, Domain Name Dispute Resolution Workshops to update interested parties<sup>8</sup>, as well as meetings of its Domain Name Panelists.

In 2019, the UDRP passed 20 years of successful operation and the Center hosted a conference in Geneva to commemorate this milestone.

The event both took stock and looked ahead in terms of UDRP jurisprudence, relevant Internet developments, and a range of other topical items such as platform ADR models<sup>9</sup>.

## B. Country Code Top-Level Domains (ccTLDs)

7. The application of the UDRP is mandated for domain names registered in generic Top Level Domains (gTLDs) (such as .com) and more recently introduced New gTLDs. The Center however also assists ccTLD registries in their establishment of registration conditions and dispute resolution procedures that conform with international best practices in registry management and IP protection. Some ccTLD registries adopt the UDRP directly, while others have adopted UDRP-based procedures which take account of relevant national considerations. The Center provides domain name dispute resolution services to some 80 ccTLD registries, having begun accepting cases for the .GA (Gabon) and .MG (Madagascar) ccTLDs in 2023, and reinstating the administration of complaints under the .UA (Ukraine) Policy in 2023 including with respect to additional Third Level Domains<sup>10</sup>.

8. With further reference to WIPO's ccTLD assistance, in 2023 the Center provided policy support to a number of ccTLD registries. This included collaborating with relevant authorities to promote efficiency and harmonization of domain name dispute resolution mechanisms inter alia by updating as relevant the registration conditions, administrative processes, Policies, Rules, and/or WIPO Supplemental Rules for .AD (Andorra), .AI (Anguilla), .AU (Australia), .BF (Burkina Faso), .BI (Burundi), .EC (Ecuador), .EU (European Union), .FR (France), .HT (Haiti), .LV (Latvia), .MA (Morocco), .MX (Mexico), .NL (Netherlands), .PE (Peru), .RO (Romania), .SA (Saudi Arabia), .SE (Sweden), and .TR (Turkey).

## C. Web 3.0

9. The Center is engaged in ongoing discussions with relevant registries and registrars concerning the application of rights protection mechanisms such as the UDRP to "Web 3.0" and blockchain domains. So far the Center is assisting Web 3.0 operator Namebase and new gTLD operator .ART in the application of the UDRP to second level domain names under the respective Web 3.0 registries.

## II. POLICY DEVELOPMENTS IN THE DOMAIN NAME SYSTEM

10. A number of policy developments in relation to ICANN present both opportunities and challenges for owners and users of IP rights. One is ICANN's introduction of hundreds of 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 noteworthy related development concerns the introduction of Internationalized Domain Names (IDNs) at the top level, such as .网店 (webshop/e-shop) and .شبكة (web/network). ICANN's expansion of the DNS also raises rights protection questions in connection with the Second WIPO Process.

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<sup>8</sup> See <https://www.wipo.int/amc/en/events/workshops/2022/domainname>.

<sup>9</sup> See [https://www.wipo.int/portal/en/news/2019/article\\_0050.html](https://www.wipo.int/portal/en/news/2019/article_0050.html).

<sup>10</sup> The full list of ccTLDs which have retained the Center as domain name dispute resolution provider is available at <https://www.wipo.int/amc/en/domains/cctld>.

## A. NEW GTLDS

11. ICANN implementation of its New gTLD Program, formally approved in June 2011<sup>11</sup>, was detailed in its iterative “Applicant Guidebook”<sup>12</sup>. Delegation of the first New gTLDs into the Internet’s Root Zone took place in October 2013; with over 1,200 gTLDs delegated by 2021<sup>13</sup> only a few (e.g., “.music”) remain to launch. Together, these New gTLDs appear to have so far attracted some 29 million second-level registrations (owing e.g., to non-renewals, this figure is down from a prior 32 million)<sup>14</sup>. ICANN concluded its “New gTLD Subsequent Procedures Policy Development Process” (PDP) in 2020<sup>15</sup>. While topics such as “Mitigating DNS Abuse” and “Closed Generics” remain under consideration, further ICANN processes including GNSO Council and ICANN Board consideration have seen this Subsequent Procedures process move towards an “Operational Design Phase” to prepare for future new gTLD rounds. In July 2023, ICANN approved further rounds of New gTLDs, which is expected to culminate in the completion of the next Applicant Guidebook in May 2025 and with new gTLD applications to follow in April 2026<sup>16</sup>.

12. The Center remains committed to working with stakeholders to attempt to safeguard the observance of general principles of IP protection in New gTLDs. A number of RPMs specifically created for New gTLDs had emerged from a series of ICANN processes<sup>17</sup>. As described *inter alia* in Document SCT 46/3, ICANN’s RPMs for GTLDs include the Pre-Delegation Dispute Resolution Procedure whereby trademark owners can lodge Legal Rights Objections (LRO) to New gTLD applications thought to infringe their rights<sup>18</sup>, and the Post-Delegation Dispute Resolution Procedure (PDDRP), which allows 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<sup>19</sup>. As regards second level RPMs, ICANN’s New gTLD Program includes a Trademark Clearinghouse (TMCH) that serves as a centralized repository of authenticated trademark data which may be invoked as the basis for using New gTLD RPMs<sup>20</sup>. Further, while the UDRP remains available as a curative tool for New

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<sup>11</sup> 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.

<sup>12</sup> ICANN’s Applicant Guidebook is available at [newgtlds.icann.org/en/applicants/agb](http://newgtlds.icann.org/en/applicants/agb).

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

<sup>14</sup> See <https://ntldstats.com/>.

<sup>15</sup> See the New gTLD Subsequent Procedures PDP January 2021 Newsletter at: <https://myemail.constantcontact.com/Read-the-SubPro-PDP-Newsletter---January-2021-Edition.html?soid=1122025845763&aid=qJxZ65sQtok>. For the Working Group Final Report submitted on January 18, 2021, see <https://gnso.icann.org/sites/default/files/file/field-file-attach/final-report-newgtld-subsequent-procedures-pdp-02feb21-en.pdf>.

<sup>16</sup> See <http://www.icann.org/en/board-activities-and-meetings/materials/approved-resolutions-special-meeting-of-the-icann-board-27-07-2023-en#section1.b/>.

<sup>17</sup> For further background including references, see [WO/GA/39/10](#), in particular paragraphs 23 to 30. It is noted here that ICANN rejected a proposal for a “Globally Protected Marks List”.

<sup>18</sup> Other objection grounds recognized by ICANN were: “String Confusion Objections”, “Community Objections”, and “Limited Public Interest Objections”. The Applicant Guidebook further includes a number of other procedures which governments could 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.

<sup>19</sup> See <http://www.wipo.int/amc/en/docs/icann130309.pdf>.

<sup>20</sup> The TMCH 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 TMCH data, the availability of “Sunrise” services (*i.e.*, an opportunity for a trademark owner, for a fee, to preemptively register an exact match of its mark as a domain name) is limited to those trademarks for which current use can be demonstrated. Whether or not substantiated by demonstration of current use, trademark owners would also be eligible to participate in a time-limited “Claims” service (*i.e.*, notice to a potential domain name registrant of the existence of a potentially conflicting trademark right, and notice to the relevant trademark owner(s) in the event that the registrant nevertheless proceeds with domain name registration). As mandated by ICANN, the availability of the Claims service is for a period of 90 days after a New gTLD is opened for general public registration, but users of the TMCH can opt-in to receive notifications indefinitely. The demonstration of use required for Sunrise

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gTLD disputes involving the requested transfer of a disputed domain name to the trademark owner, ICANN has introduced the temporary-suspension-based Uniform Rapid Suspension System, which is intended to be a lighter second-level RPM for appropriate cases<sup>21</sup>.

## B. ICANN'S PLANNED REVISION OF THE WIPO-INITIATED UDRP AND OTHER RPMs

13. 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 in 2011 at which the clear majority of participants were of the opinion that more harm than good could result from any review of the UDRP by ICANN as a registration-driven body<sup>22</sup>, a decision was taken by ICANN's Generic Names Supporting Organization (GNSO) to review the UDRP following the launch of New gTLDs. ICANN's Preliminary Issue Report on this topic was issued in October 2015 describing a range of complex substantive and process-related questions<sup>23</sup>. In this regard, the Center provided observations highlighting both the UDRP's long-proven success and the risks associated with any attempted ICANN revision of the UDRP. Following a public comment period, ICANN issued its Final Issue Report in January 2016 recommending that the GNSO launch a PDP to review all RPMs in two phases. The now-concluded initial phase focused on RPMs developed for the New gTLD Program, notably the TMCH (including "Sunrise" and "Claims Notice" RPMs)<sup>24</sup> and URS resulting in a range of operational and procedural suggestions for changes to the RPMs covered in Phase I<sup>25</sup>. The Phase I Final Report contained 35 consensus recommendations<sup>26</sup> and was approved by the GNSO Council and ICANN Board for implementation in several stages<sup>27</sup>. Phase II (initially anticipated to begin chartering work in 2022) will focus on the UDRP<sup>28</sup>. This is a matter of serious concern, noting also the accreditation by ICANN of further UDRP providers and the uncertainty of how the UDRP may evolve in this ICANN process. The Center continues to closely follow ICANN stakeholders' intentions with regard to the UDRP and trademark RPMs generally. In this effort, the Center where relevant is in contact with trademark stakeholders such as ECTA, INTA, and MARQUES, in addition to ICANN.

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services similarly applies to the invocation of trademarks as a basis for a complaint filed under the "Uniform Rapid Suspension" RPM described herein. Some registry operators have introduced a provision in their Registry-Registrar Agreement for an extended Claims service of indefinite length, as for example Charleston Road Registry (part of Google) for ".app" (see [FAQs | Google Registry](#)).

<sup>21</sup> The Center for its part communicated to ICANN in April 2009 a discussion draft of an "Expedited (Domain Name) Suspension Mechanism", (see <https://www.wipo.int/export/sites/www/amc/en/docs/icann030409.pdf>) and has made subsequent proposals for a streamlined mechanism based on this model at ICANN Meetings (see [prague44.icann.org/node/31773](https://prague44.icann.org/node/31773) and [toronto45.icann.org/node/34325](https://toronto45.icann.org/node/34325)). Such proposals took account of the need to strike a balance between the protection of trademark rights recognized by law, the practical interests of good-faith registration authorities to minimize operational burdens, and the legitimate expectations of *bona fide* domain name registrants.

<sup>22</sup> 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.

<sup>23</sup> See [https://gnso.icann.org/sites/default/files/filefield\\_48143/rpm-prelim-issue-09oct15-en.pdf](https://gnso.icann.org/sites/default/files/filefield_48143/rpm-prelim-issue-09oct15-en.pdf).

<sup>24</sup> See footnote 20.

<sup>25</sup> See Final Report at <https://gnso.icann.org/sites/default/files/file/field-file-attach/council-recommendations-rpm-pdp-phase-1-report-10feb21-en.pdf>

See also presentation to the GNSO Council at <https://gnso.icann.org/sites/default/files/policy/2021/presentation/presentation-gnso-rpm-final-report-11Jan21-en.pdf>.

<sup>26</sup> These comprised the following four categories of recommendations: to Maintain Status Quo (9), to Modify Operational Practice (10), to Create New Policies and Procedures (15), and for Overarching Data Collection (1).

<sup>27</sup> See <https://www.icann.org/resources/board-material/resolutions-2022-01-16-en#2.a>.

<sup>28</sup> See [https://gnso.icann.org/sites/default/files/filefield\\_48411/rpm-final-issue-11jan16-en.pdf](https://gnso.icann.org/sites/default/files/filefield_48411/rpm-final-issue-11jan16-en.pdf). See also the ICANN GAC Communiqué 74, which states: "Following the public comment period on the Policy Status Report relating to the UDRP, the GAC received input from some GAC Members in relation to whether the scope of the UDRP could be extended to address Geographical Indications. The GAC therefore intends to consider the matter in preparation for discussion at subsequent meetings."

Notably, calls have been made from within ICANN's constituent bodies for an expert-led initial review of the UDRP to be undertaken by the WIPO Secretariat to inform the charter for any review under ICANN's policy processes<sup>29</sup>.

14. In anticipation of ICANN's review of the UDRP, the WIPO Center is undertaking a focused consultative process to produce a report on jurisprudential and operational experiences with the UDRP to identify areas which may be appropriate for future policy recommendations or practice updates under ICANN's policy processes or otherwise; it is anticipated that the resulting work -product would be of relevance to inform ICANN's processes.

### C. PRIVACY REGULATION AND THE "WHOIS DATABASE"

15. As a result of the European Union's General Data Protection Regulation (GDPR)<sup>30</sup>, which came into force on May 25, 2018, publicly-available Whois data generally no longer includes full contact details of domain name registrants. Instead, publicly-available Whois data is largely redacted, or if available, is often limited to the "registrant organization" (for legal persons) and country. Notably, the registrant's name and email address will in most instances not be visible. However, in order to facilitate contact with the domain name registrant, the concerned registrar is required to provide an "anonymized" email address or web-based contact form. In addition to these limited options, where a UDRP complaint has been submitted to a UDRP provider, registrars are instructed by ICANN to provide registrant contact information on request from such provider (and at the same time "lock" the domain name's registration and registrar details), further to due process requirements codified in the UDRP Rules. An ICANN "Temporary [contract] Specification" for gTLD Registration Data expressly acknowledges that registrars must provide full "Registration Data" to UDRP providers<sup>31</sup>. This appears to be on the recognition that UDRP providers meet the GDPR's Article 6(1)(f) "legitimate purposes" and Article 6(1)(b) "performance of a contract" criteria<sup>32</sup>, such that registrars have been required to provide Whois data to UDRP providers. In July 2018, the GNSO initiated the Expedited PDP (EPDP) to review the "Temporary [contract] Specification" and discuss a standardized access model to nonpublic registration data<sup>33</sup>; a Final Report was submitted to the GNSO Council in July 2020 including the EPDP Team's recommendations for a System for Standardized Access/Disclosure (SSAD)<sup>34</sup> on which a number of concerns were raised by governments and IP stakeholders and for which consultations are still underway. The Center continues to monitor SSAD-related policy discussions, which are ongoing<sup>35</sup>. Most recently, ICANN launched a Registration Data Request Service (RDRS), which is a new centralized service that introduces a more consistent and standardized format to submit requests – to participating registrars – for requests for access to

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<sup>29</sup> See, inter alia, the ICANN GAC Communiqué 74, stating: "The GAC received an update on the status of a planned review of the UDRP, and in particular notes reference to section 13.1 of the ICANN Bylaws which calls on and indeed encourages, the Board and constituent bodies to seek advice from relevant public bodies with existing expertise that resides outside of ICANN (notably the World Intellectual Property Organization—WIPO, as author and steward of the UDRP) to inform the policy process, and looks forward to further exploring this provision prior to any review of the UDRP."

<sup>30</sup> Regulation (EU) 2016/679 of the European Parliament and of the Council of 27 April 2016 on the protection of natural persons with regard to the processing of personal data and on the free movement of such data, and repealing Directive 95/46/EC (General Data Protection Regulation).

<sup>31</sup> See <https://www.icann.org/resources/pages/gtld-registration-data-specs-en>, at Annex F. See also <https://www.icann.org/en/announcements/details/icann-board-reaffirms-temporary-specification-for-gtld-registration-data-29-1-2019-en>.

<sup>32</sup> In 2018, the Center published informal WIPO guidance for parties on the practical impact of the GDPR on UDRP proceedings. See <https://www.wipo.int/amc/en/domains/gdpr>.

<sup>33</sup> See <https://gns0.icann.org/en/group-activities/active/gtld-registration-data-epdp>.

<sup>34</sup> See <https://gns0.icann.org/en/group-activities/active/gtld-registration-data-epdp-phase-2>.

<sup>35</sup> See <https://gns0.icann.org/sites/default/files/file/field-file-attach/policy-briefing-icann70-03mar21-en.pdf>. See also the Governmental Advisory Committee Minority Statement on the Final Report of Phase 2 of the EPDP on gTLD Registration Data at: <https://mm.icann.org/pipermail/gns0-epdp-team/attachments/20200824/aeab8dd/gac-minority-statement-epdp-phase2-24aug20-0001.pdf>.

nonpublic registration data related to gTLDs<sup>36</sup>. The Center has published an updated FAQ webpage which raises awareness of ICANN's RDRS and discussed potential UDRP case implications<sup>37</sup>. Touching in some respects on EPDP and WhoIs-related issues, the European Commission has adopted a revised Directive on Security of Network and Information Systems (NIS 2 Directive) to be transposed into national law and which is anticipated to potentially impact WHOIS-related practices and requests<sup>38</sup>.

16. The Center continues to closely monitor the impact of the GDPR on UDRP proceedings. Separate from the Center's UDRP function, with a view to addressing broader IP enforcement concerns occasioned by GDPR implementation, as noted above with respect to the proposed SSAD for WhoIs queries, a range of discussions continue on a possible WhoIs "accreditation and access" model, including as to a potential WIPO role to certify IP owners' rights for such access<sup>39</sup>.

#### D. OTHER IDENTIFIERS

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

##### (a) International Governmental Organizations (IGOs)

18. As previously reported *inter alia* in document SCT/46/3, an ICANN Working Group arrived at a set of recommendations to provide IGOs access to the UDRP, and these recommendations were approved unanimously by the GNSO Council on September 27, 2018. On January 27, 2019, the recommendations were adopted by the ICANN Board and ICANN was directed to implement the recommendations; so far, ICANN implementation work on these policy recommendations remains outstanding. Together with other involved IGOs, the Center continues to closely monitor implementation developments in this longstanding ICANN file.

##### (b) Geographical Terms

19. Concerning geographical terms, the GAC in particular has expressed concerns about their use and protection in the new gTLDs<sup>40</sup>. Concerning the top level<sup>41</sup>, ICANN's Applicant Guidebook provides that "applications for strings that are country or territory names will not be approved, as they are not available under the New gTLD Program in this application round<sup>42</sup>."

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<sup>36</sup> See <https://www.icann.org/resources/press-material/release-2023-11-28-en>.

<sup>37</sup> See <https://www.wipo.int/amc/en/domains/gdpr>.

<sup>38</sup> See <https://eur-lex.europa.eu/eli/dir/2022/2555>

<sup>39</sup> See <https://www.icann.org/en/system/files/files/framework-elements-unified-access-model-for-discussion-18jun18-en.pdf>.

See also <https://www.ipconstituency.org/assets/Outreach/DRAFT%20-%20WHOIS%20Accreditation%20and%20Access%20Model%20v1.7.pdf>

<sup>40</sup> In 2007, the GAC issued the "GAC Principles regarding New gTLDs", which states *inter alia* that ICANN should avoid delegation of New gTLDs concerning country, territory or place names, and regional language or people descriptions, unless in agreement with the relevant governments or public authorities. Those GAC Principles further stated that new registries should adopt procedures for blocking/challenge of names with national or geographical significance at the second level upon demand of governments. See <https://archive.icann.org/en/topics/new-gtlds/gac-principles-regarding-new-gtlds-28mar07-en.pdf>. See also <https://gac.icann.org/contentMigrated/icann63-barcelona-communique>.

<sup>41</sup> Concerning second-level registrations, ICANN's base registry agreement includes a "Schedule of Reserved Names at the Second Level in gTLD Registries" which makes provision for certain country and territory names. See <https://newgtlds.icann.org/sites/default/files/base-agreement-specs-04jun12-en.pdf> at Specification 5.

<sup>42</sup> See <https://newgtlds.icann.org/sites/default/files/evaluation-procedures-04jun12-en.pdf>, from section 2.2.1.4.1 "Treatment of Country or Territory Names".

Applied-for strings which are considered by ICANN to be certain other geographical names, e.g., capital city names, should be accompanied by documentation of support or non-objection from the relevant governments or public authorities<sup>43</sup>.

20. GAC members have expressed further reservations regarding a number of new gTLD applications on grounds of correspondence to geographical or other “sensitive” terms, advising the ICANN Board not to proceed beyond initial evaluation, and seeking Board clarification on scope for applicants to modify their new gTLD applications to address specific GAC concerns<sup>44</sup>.

21. Concerning possible future New gTLD rounds, a so-called Work Track 5 “cross community” working group had submitted a Final Report to the New gTLD Subsequent Procedures PDP Working Group on the subject of geographic names at the top level<sup>45</sup>. While overall ICANN’s next application round appears likely to maintain the status of the 2014 round, the broader subject of geographical names remains a topic of interest to a number of ICANN stakeholders, including governments and potential applicants.

22. In December 2016, ICANN authorized the release of all previously-reserved 2-character domain names at the second level in new gTLDs provided that registry operators first allow respective governments a thirty-day period to acquire such domain names; require registrants to represent that they would not falsely imply government affiliation in connection with the use of such 2-character domain name; and, provide a means for post-registration complaints<sup>46</sup>. In this context, the Center submitted comments to ICANN noting that the Second WIPO Process considered the possibility of exploring measures for the UDRP to apply to third-level registrations in order to mitigate the potential for trademark abuse<sup>47</sup>. Since ICANN’s release, including in recent discussions, a number of GAC members have expressed concerns and further requested that ICANN provide coordinated information on related requests and delegations<sup>48</sup>. It is anticipated that a similar process may be used for country names at the second level (currently still blocked).

23. In 2023, the European Parliament and Council approved a Regulation for the protection of geographical indications (GIs) relating to craft and industrial products including in the DNS. A similar proposed Regulation on wine, spirits, and agricultural products remains outstanding. While a number of European ccTLDs already account for GIs in their ADR systems, in its

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<sup>43</sup> See <https://newgtlds.icann.org/sites/default/files/evaluation-procedures-04jun12-en.pdf>, from section 2.2.1.4.2 “Geographic Names Requiring Government Support”.

<sup>44</sup> See <https://www.icann.org/en/system/files/correspondence/gac-to-board-27mar14-en.pdf>, at “4. Specific Strings”. While the Board accepted the GAC’s advice against proceeding with certain applications, it had sought further information from the GAC, as well as public comments, on a range of additional safeguards sought by the GAC concerning several broad categories of new gTLD applications such as for those new gTLDs which correspond to regulated industries or dictionary terms. See <https://www.icann.org/en/system/files/correspondence/gac-to-board-11apr13-en.pdf>. Concerning the “.amazon” application, ICANN entered into a Registry Agreement in December 2019 granting Amazon EU S.à r.l. the authority to operate the .amazon new gTLD. See <https://www.icann.org/resources/agreement/amazon-2019-12-19-en>. A GAC Sub-group on Geographic Names (a Sub-group of the GAC Working Group on Future New gTLDs) has developed a draft document for future New gTLD rounds outlining several public policy aspects related to geographic names which is currently subject to further ICANN discussions.

<sup>45</sup> See <http://mm.icann.org/pipermail/gnso-newgtld-wg-wt5/attachments/20191022/c47fb9cf/WorkTrack5FinalReporttotheNewgTLDSubProPDPWG-22October2019-0001.pdf>.

<sup>46</sup> Together these comprise ICANN’s so-called “confusion mitigation” plans. See <https://itp.cdn.icann.org/en/files/registry-agreements/multiple/two-character-ltr-ltr-authorization-release-13dec16-en.pdf>.

<sup>47</sup> See <http://forum.icann.org/lists/comments-proposed-measures-two-char-08jul16/pdfECmcS9knuk.pdf>.

<sup>48</sup> See the Survey of the existing state of play of geographical indications, country names, and other geographical terms in the domain name system prepared by the Center with the SCT Secretariat on March 12, 2018 that was submitted to the SCT/39/7, available at: [https://www.wipo.int/edocs/mdocs/sct/en/sct\\_39/sct\\_39\\_7.pdf](https://www.wipo.int/edocs/mdocs/sct/en/sct_39/sct_39_7.pdf).



current formulation, the proposal is expected to impact a number of European ccTLDs' ADR policies insofar as they would need to be updated to account for the approved regulation.

24. On these and other DNS-related issues, the Center has endeavored to apprise relevant sectors within the Secretariat, including in support of the work of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT)<sup>49</sup>. The Secretariat will continue to monitor these developments and provide input where appropriate.

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

[End of document]

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<sup>49</sup> See e.g., documents [SCT/37/4](#), [SCT37/5](#), [SCT38/3](#), [SCT39/5](#), [SCT40/4](#), [SCT41/5](#), [SCT/42/3](#), and [SCT/43/4](#). See also meeting [SCT/IS/GEO/GE/17](#).