



■ WIPO ccTLD Program and Legal Rights Objections under ICANN's New gTLD Program

6th International Conference for ccTLD registries and registrars of
CIS, Central and Eastern Europe

**Crete, Greece
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WIPO Arbitration and Mediation Center

- Established 1994, offices in Geneva and Singapore
 - Not-for-profit nature of WIPO

- Mission:
 - Promotion of the protection of IP rights via the provision of alternative dispute resolution (ADR) services
 - Alternatives to court proceedings
 - Time and cost-effective

- Roles:
 - Administration Authority
 - Active case management of the different procedures offered by the WIPO Center (arbitration, mediation, expedited arbitration)

 - Resource Center
 - Tailored dispute resolution schemes for specific sectors
 - Publications, training programs and conferences

WIPO ccTLD Program

- To develop a cooperation program for the administrators of ccTLDs to advise them on IP strategy and management of their domains (including dispute prevention and resolution)
- The program covers the following areas:
 - Design of DN registration practices
 - Design of dispute resolution procedure (to complement court litigation)
 - Provision of dispute resolution services by the WIPO Center
- Since the launch of the program in 2000, administrators of many ccTLDs have sought WIPO's advice on the management of IP in their domains and a number of them have retained WIPO Center as dispute provider (69 ccTLDs)



WIPO ccTLD Program

- **WIPO ccTLD Best practices:**
 - Set of minimum standards for the protection of IP in the ccTLDs
 - Flexible framework built around a number of basic elements that are deemed critical from an IP perspective
 - Apply to open ccTLDs (no restrictions to register the DN) and closed ccTLDs (particular registration conditions)

- The ccTLD Best practices focus on 3 areas:
 - **DN registration agreement** (payment of fees, renewal, public Whois, clause that would state that neither the registration nor the use of the DN infringes the IP rights of a party)
 - **Collection and availability of registrant contact details** (information should be true and accurate, name, email)
 - **Alternative Dispute Resolution**

WIPO ccTLD Program

- Alternative Dispute Resolution:
 - Resolving disputes concerning the entitlement of DN registration between registrants and third parties

- The Value of ADR:
 - DN dispute may be multijurisdictional
 - Need to resolve the DN dispute may often be urgent
 - The cost
 - The registration authority has often been joined in DN disputes because of its role in the technical management of the DN



WIPO ccTLD program

■ Minimum ADR Requirements:

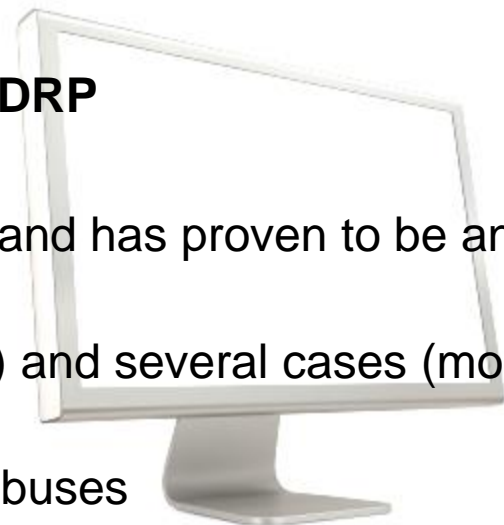
- Mandatory character (one the part of the registrant)
- Decisions based on all facts and circumstances
- Lock of the DN during the dispute
- Direct enforcement of decisions
- Quick result and moderate costs
- Relationship with ccTLD administrators (decision making and administration of the dispute should be conducted independently form the ccTLD administrator)
- ADR should not replace court proceedings, constitute only an additional option
- Scope of procedure (what type of conflicts is the procedure to cover, prudent to restrict the procedure to clear cases of abuses)



UDRP as adopted by WIPO ccTLDs

- **Over half of all WIPO ccTLDs have adopted the UDRP**
 - (38 ccTLDs out of 69)
 - **UDRP** constitute an excellent **reference model** and has proven to be an **efficient** mechanism
 - Considerable real-world experience (since 1999) and several cases (more than 23,000 with WIPO)
 - UDRP is restricted to clear cases of trademark abuses

- **Advantages**
 - Facilitates acceptance (no major changes are needed in the registration agreement)
 - Preserve recourse to national courts or tribunals
 - Neutrality
 - Independent of ccTLD registration and administration
 - Allows ccTLD registry to “outsource” decision
 - Impartial and independent decision-makers



WIPO ccTLD Variations (of the UDRP)

- **Others ccTLDs have decided to adopt a variation of the UDRP**
 - Dispute resolution model that would tailor the local needs of the ccTLD
 - Balance: Parties' interest in predictability, fairness, efficiency and local needs of ccTLD

- **Scope of rights protected (local and/or foreign)**
 - Trademarks registered in the country corresponding to the ccTLD: .ma,
 - Trade names, personal names, company names, jurisdictionally defined intellectual property rights: .au, .es, .nl
 - Infringement of national IP laws: .ch, .br

- **Bad faith registration and/or use**

- Mutual jurisdiction clause: **local court**

WIPO ccTLD Variations (of the UDRP)

■ Number and Nationality of Panelists

- Single member or 3 member panel
- Panel who is a national of the country corresponding to the ccTLD
- Decisions based on or influenced by local law
(or also with reference to past cases decided under the relevant Policy)

■ Languages

- Language of the proceeding

■ Mediation element

- .ch, .nl

■ Dispute resolution providers

- Administer the case
- Appoint the panel
- Local institution (where both parties are located in the country of the ccTLD)
and one international institution (cases involving foreign parties)



WIPO-Administered ccTLD Disputes

.AC (Ascension Island)	.FJ (Fiji)	.PE (Peru)
.AE and امارات (United Arab Emirates)	.FR (France)	.PH (Philippines)
.AG (Antigua and Barbuda)	.FM (Federated States of Micronesia)	.PW (Palau)
.AM (Armenia)	.GT (Guatemala)	.PK (Pakistan)
.AO (Angola)	.HN (Honduras)	.PL (Poland)
.AS (American Samoa)	.IE (Ireland)	.PN (Pitcairn Islands)
.AU (Australia)	.IO (British Indian Ocean Territory)	.PR (Puerto Rico)
.BM (Bermuda)	.IR (Islamic Republic of Iran)	.QA and قطر (Qatar)
.BO (Bolivia (Plurinational State of))	.KI (Kiribati)	.RE (Reunion Island)
.BR (Brazil)	.KY (Cayman Islands)	.RO (Romania)
.BS (Bahamas)	.LA (Lao People's Democratic Republic)	.SC (Seychelles)
.BZ (Belize)	.LC (Saint Lucia)	.SH (St. Helena)
.CC (Cocos Islands)	.LI (Liechtenstein)	.SL (Sierra Leone)
.CD (Democratic Republic of the Congo)	.MA (Morocco)	.SO (Somalia)
.CH (Switzerland)	.MD (Republic of Moldova)	.TJ (Tajikistan)
.CO (Colombia)	.ME (Montenegro)	.TK (Tokelau)
.CR (Costa Rica)	.MP (Commonwealth of the Northern Mariana Islands)	.TM (Turkmenistan)
.CY (Cyprus)	.MW (Malawi)	.TT (Trinidad and Tobago)
.DJ (Djibouti)	.MX (Mexico)	.TV (Tuvalu)
.DO (Dominican Republic)	.NL (Netherlands)	.TZ (United Republic of Tanzania)
.EC (Ecuador)	.NR (Nauru)	.UG (Uganda)
.ES (Spain)	.NU (Niue)	.VE (Venezuela (Bolivarian Republic of))
	.PA (Panama)	.WS (Samoa)

WIPO ccTLD Experience

Filing Rates

Year	Number of Cases
2000	16
2001	50
2002	27
2003	47
2004	66
2005	95
2006	164
2007	205
2008	320
2009	303
2010	401
2011	441
2012	335

ccTLDs (January- December 2012)	Number of Cases
.NL	82 cases
.ES	44 cases
.CO	38 cases
.CH	36 cases
.AU	35 cases
.MX	17 cases
.BR	16 cases
.TV	13 cases

WIPO ccTLD Experience

Types of Policies (69 ccTLDs)

■ UDRP: 39

- .ag, .am, .as, .bm, .bs, .bz, .cc, .cd, .cy, .dj, .ec, .fj, .fm, .gt, .ki, .ky, .la, .lc, .md, .mw, .nr, .nu, .pa, .pk, .pn, .pr, .pw, .ro, .sc, .sl, .so, .tj, .tk, .tt, .tv, .ug, .ve, .ws

■ Variations (of UDRP): 26

- .ae and امارات., .ao, .au, .bo, .br, .ch, .co, .cr, do, .es, .ie, .ir, .fr, .hn, .li, .ma, .me, .mp, .mx, .nl, .pe, .ph, .qa and قطر., .re, .tm, .tz

■ Arbitration: 4

- .ac, .io, .pl, .sh

2,636 WIPO ccTLDs cases (July 2013)

CSI, Central and Eastern European region

- The WIPO Center is a domain name dispute service resolution provider for seven (7) CSI, Central and Eastern European ccTLDs :
 - **.ar (Armenia)**
 - **.md (Republic of Moldova)**
 - **.me (Montenegro)**
 - **.pl (Poland)**
 - **.ro (Romania)**
 - **.tj (Tajikistan)**
 - **.tm (Turkmenistan)**

- 3 have adopted the UDRP : .md, .ro, .tj
- 3 have adopted variations of the UDRP : .am, .me, .tm
- 1 has adopted WIPO expedited arbitration : .pl

CSI, Central and Eastern European Region

■ Number of cases:

■ 3 cases for .am:

- WIPO Case No. DAM2013-01 <nespresso.am> ; WIPO Case No. DAM2012-01 <allianz.am>

■ 7 cases for .md:

- WIPO Case No. DMD2010-02 <epson.md>

■ 63 cases for .me:

- WIPO Case No. DME2013-01 <maglite.me>

■ 22 arbitration cases for .pl

■ 110 cases for .ro:

- WIPO Case N. DRO2008-05 <samsung.ro>

- WIPO Case No. DRO2012-03 <ibm.ro>

1 for .tj

■ 1 case for .tm

WIPO ccTLD Variations (of the UDRP)

■ .me (Montenegro)

- DoMen (the .me Registry) has adopted the UDRP
- Dispute resolution provider: WIPO Center **exclusive** provider
- 63 cases filed since 2008
 - WIPO Case No. DME2008-02 <porsche.me>
 - WIPO Case No. DME2010-05 <facebook.me>

WIPO ccTLD Variations (of the UDRP)

■ .pl (Poland)

- The WIPO Center does not administer disputes where one or both parties are registered or resident in Poland (those disputes are administered by Arbitration Courts in Poland)
- The WIPO Center administers disputes **where both parties are registered or resident outside of Poland**
- Applicable policy is a slightly adapted version of the **WIPO Expedited Arbitration Rules** (Arbitration agreement is needed otherwise the dispute is suspended)
- **22 cases filed since 2003**
 - WIPO 2010PL21 <igoogle.pl> (terminated)
 - WIPO 2010PL2 <elitemodel.pl> (award)

WIPO ccTLD Variations (of the UDRP)

■ .tm (Turkmenistan)

- Mutual jurisdiction: Location of the registry and/or domain name holder
- Registration or use in bad faith
- 1 case filed in 2009
 - WIPO Case No. DTM2009-01 <samsung.tm>

WIPO ccTLD Resources and Filing

WIPO ADR Arbitration and Mediation Center

WORLD INTELLECTUAL PROPERTY ORGANIZATION

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Domain Name Dispute Resolution Service for country code top level domains (ccTLDs)

Since the launch of the [WIPO ccTLD Program](#) in 2000, WIPO has provided advice to many ccTLDs with a view to establishing registration conditions and dispute resolution procedures that conform with international standards of intellectual property protection while taking into account the particular circumstances and needs of the individual ccTLD. WIPO also provides a variety of information resources for users who wish to register ccTLD domain names or file disputes in relation to such names.

- The [WIPO ccTLD Best Practices for the Prevention and Resolution of Intellectual Property Disputes](#) provide an overview of practices and policies for ccTLD operations designed to curb abusive and bad faith registration of protected names, and to resolve related disputes.
- The [WIPO ccTLD Database](#) contains links to the websites of 252 ccTLDs allowing to determine the availability of a registration agreement, the existence of a WHOIS service and the adoption of alternative dispute resolution (ADR) procedures.
- The [Trademark Database Portal](#) facilitates access to online trademark databases of a number of national and regional intellectual property offices, allowing any person wishing to register a domain name to perform a prior trademark search.

In addition to its role as dispute resolution service provider for .com, .net, .org, .biz, .info., .mobi and other generic top level domains ([gTLDs](#)), the Center also provides domain name dispute resolution services for the following country code top level domains:

List of ccTLDs	
<p>A</p> <p>.AC (Ascension Island) .AE and امارات (United Arab Emirates) .AG (Antigua and Barbuda) .AM (Armenia) .AO (Angola) .AS (American Samoa) .AU (Australia)</p>	<p>B</p> <p>.BM (Bermuda) .BO (Bolivia (Plurinational State of)) .BR (Brazil) .BS (Bahamas) .BZ (Belize)</p>
<p>C</p> <p>.CC (Cocos Islands) .CD (Democratic Republic of the Congo) .CH (Switzerland)</p>	<p>D</p> <p>.DJ (Djibouti) .DO (Dominican Republic)</p>

Where to find ccTLD Policies, Model Documents, Fees, Prior Decisions, Registry websites and contact information, etc.:

Found at:

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

WIPO ccTLD Database

The screenshot shows the WIPO IP SERVICES website. The header includes the WIPO logo, 'IP SERVICES', and language options for Spanish and French. A search bar is present. The main navigation bar lists 'ABOUT WIPO', 'IP SERVICES', 'PROGRAM ACTIVITIES', 'RESOURCES', and 'NEWS & EVENTS'. The breadcrumb trail indicates the path: Home > IP Services > Arbitration and Mediation Center > Domain Names.

The page content is titled 'ccTLD Database'. It explains that the database contains links to 252 ccTLD websites for checking registration availability, WHOIS services, and ADR procedures. A dropdown menu prompts the user to 'Please select the country / territory name'. Below this, there are links to 'Other Resources', including 'WIPO ccTLD Best Practices for the Prevention and Resolution of Intellectual Property Disputes' and the 'Trademark Database Portal'. A footer note mentions domain name dispute administration services for various country codes.

On the left side, there is a sidebar menu for 'ARBITRATION AND MEDIATION CENTER' with sub-links like 'About the Center', 'Arbitration', 'Mediation', 'Expert Determination', 'Recommended Clauses', 'Domain Names', 'gTLDs', 'ccTLDs', 'Cases', 'Decisions', 'Resources', 'Panelists', 'Search', 'Statistics', 'New gTLDs', 'Neutrals', 'Meetings and Workshops', 'Publications', 'What's New', and 'Contact'. There is also an 'E-NEWSLETTER' section with links to subscribe to WIPO, Arbitration and Mediation Center, and Mailing Lists.

For general information about a ccTLD, you may first wish to consult the ccTLD Database, which contains information for over 250 ccTLDs.

Found at:

http://www.wipo.int/amc/en/domains/cctld_db/index.html

Legal Rights Objections under ICANN's New gTLD Program

- New gTLD Expansion and Rights Protection Mechanisms:
 - The Domain Name System is set for a potentially massive expansion at the top level via ICANN's New gTLD Program
 - A range of new "Rights Protection Mechanisms" (RPMs) has been established for this purpose

- Prior to any new gTLDs being approved and becoming operational:
 - **Pre-delegation Objection Procedures**

- Additional mechanisms for use once a new gTLD has been approved and becomes operational include:
 - **Trademark Clearinghouse**
 - **Uniform Rapid Suspension system (URS)**
 - **Post Delegation Dispute Resolution Procedure (PDDRP)**

- **The existing UDRP will also apply to all new gTLDs**

Pre-Delegation Objection Procedures

- **String Confusion Objection** confusingly similar to existing/applied for TLD
- **Limited Public Interest Objection** contrary to generally accepted legal norms of morality and public order recognized under principles of international law
- **Community Objection** substantial opposition from a significant portion of the intended target community
 - Public Interest/Community: Independent (public interest) Objector
- **Legal Rights Objection (LRO)** infringes existing trademarks or IGO rights

What is a Legal Rights Objection?

- Prior to ICANN approving a New gTLD application, trademark owners and IGOs may file a formal objection on the basis of a “Legal Rights Objection” (LRO)
 - Standing: “rightsholders” (3.2.2) registered or unregistered trademark or service mark or IGO name or acronym (3.5.2)
- An independent panel would determine whether the applicant’s potential use of the applied-for gTLD would be likely to infringe the objector’s trademark, or IGO name or acronym
- The availability of an LRO does not preclude court options

What Criteria Will LRO Panels Apply?

- **ICANN AGB, Section 3.5.2**

- LRO criteria founded on WIPO *Joint Recommendation Concerning Provisions on the Protection of Marks, and Other Industrial Property Rights in Signs, on the Internet*

- **Whether – with respect to Objector’s trademark – the potential use of the applied-for gTLD by Applicant:**

- (i) **Takes unfair advantage of** the distinctive character or reputation, or

- (ii) **Unjustifiably impairs** the distinctive character or reputation, or

- (iii) Otherwise **creates an impermissible likelihood of confusion**

- Panels may refer to non-exclusive consideration factors

LRO Procedure Timeline

- Jan 2012: new ICANN Applicant Guidebook; application window opened
- May 30 2012: application window closed
- June 13 2012: “ICANN Reveal Date” (1,930 applications)
- March 13 2013: close of LRO filing window
 - 69 LRO Objections filed with WIPO Center

- April 12 2013: ICANN published its “Dispute Announcement”
 - WIPO Center notified the Objection to Applicant
 - 30 day response
 - WIPO Center appointed expert panels
 - 45 days for panel determination

- July 2013: Expert Determinations posted

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Legal Rights Objections filed with the WIPO Arbitration and Mediation Center

[WIPO Advanced Workshop on Domain Name Dispute Resolution: Update on Precedent and Practice](#)
Geneva, Switzerland, October 29 and 30, 2013

PROPOSED STRING TO WHICH THE OBJECTION IS DIRECTED	OBJECTOR	APPLICANT	GROUND FOR OBJECTION	DATE OF THE WIPO CENTER'S RECEIPT OF THE OBJECTION	DETERMINATION
.delmonte	Del Monte Corporation	Del Monte International GmbH	Legal Rights Objection	March 2, 2013	Objection Upheld with Dissenting Opinion
.coach	Coach, Inc.	Koko Island, LLC aka Dozen Donuts, LLC aka Donuts, Inc	Legal Rights Objection	March 8, 2013	Objection Rejected
.academy	Academy, Ltd., d/b/a Academy Sports + Outdoors	Half Oaks, LLC	Legal Rights Objection	March 11, 2013	Objection Rejected
.blue	Blue Cross and Blue Shield Association ("BCBSA")	Afflias Limited	Legal Rights Objection	March 12, 2013	Objection Rejected
.direct	The DirecTV Group Inc.	Dish DBS Corporation	Legal Rights Objection	March 12, 2013	Objection Upheld
.mls	The Canadian Real Estate Association (CREA)	Afflias Limited	Legal Rights Objection	March 12, 2013	Objection Rejected
.merck	Merck KGaA	Merck Registry Holdings, Inc.	Legal Rights Objection	March 12, 2013	Objection Rejected
.merck	Merck KGaA	Merck Registry Holdings, Inc.	Legal Rights Objection	March 12, 2013	Objection Rejected
.merckmsd	Merck KGaA	MSD Registry Holdings, Inc	Legal Rights Objection	March 13, 2013	Pending
.goo	NTT Resonant Inc.	Charleston Road Registry Inc.	Legal Rights Objection	March 13, 2013	Terminated
.yellowpages	Hibu (UK) Limited	Telstra Corporation Limited	Legal Rights Objection	March 13, 2013	Objection Rejected
.vip	I-Registry Ltd.	VipSpace Enterprises LLC	Legal Rights Objection	March 13, 2013	Objection Rejected
.vip	I-Registry Ltd.	John Corner, LLC.	Legal Rights Objection	March 13, 2013	Objection Rejected
.vip	I-Registry Ltd.	VIP Registry Pte. Ltd	Legal Rights Objection	March 13, 2013	Objection Rejected
.vip	I-Registry Ltd.	Charleston Road Registry Inc.	Legal Rights Objection	March 13, 2013	Objection Rejected
.vip	I-Registry Ltd.	Top Level Domain Holdings Limited	Legal Rights Objection	March 13, 2013	Objection Rejected
.diy	Scripps Networks, LLC	Charleston Road Registry Inc.	Legal Rights Objection	March 13, 2013	Objection Rejected
.food	Scripps Networks Interactive, Inc.	Dot Food, LLC	Legal Rights Objection	March 13, 2013	Objection Rejected
.food	Scripps Networks Interactive, Inc.	Wild Orchard, LLC	Legal Rights Objection	March 13, 2013	Pending
.express	Express, LLC	Sea Sunset, LLC	Legal Rights Objection	March 13, 2013	Objection Rejected
.zone	AutoZone Parts, Inc.	Outer Falls, LLC	Legal Rights Objection	March 13, 2013	Terminated
.gcc	The Cooperation Council for the Arab States of the Gulf also known as the Gulf Cooperation Council or GCC	GCCIX WLL	Legal Rights Objection	March 13, 2013	Terminated



Additional information :

- WIPO Center email:

- arbiter.mail@wipo.int

- charlotte.spencer@wipo.int

- Upcoming events :

- [WIPO Arbitration Workshop](#), Republic of Korea, October 10 and 11, 2013

- [WIPO Advanced Workshop on Domain Name Dispute Resolution: Update on Precedent and Practice](#), Geneva, October 29 and 30, 2013

- Program information and registration: www.wipo.int/amc/en/events/