

August 5, 2016

Re: *WIPO Arbitration and Mediation Center observations on ICANN's Proposed Measures for Letter/Letter Two-Character ASCII Labels to Avoid Confusion with Corresponding Country Codes*

The Second WIPO Internet Domain Name Process, convened by the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) of the World Intellectual Property Organization (WIPO) produced a Report of September 3, 2001 addressing issues relevant to the present ICANN public comment process.

The First WIPO Internet Domain Name Process, which addressed issues raised by the intersection of trademark rights and domain names, provided the blueprint for the Uniform Domain Name Dispute Resolution Policy (UDRP).

A number of other non-trademark identifiers were considered in the context of the Second WIPO Internet Domain Name Process. Among these were ISO 3166 Alpha-2 Country Code Elements.

The Second WIPO Process considered measures to ensure that any 2-character domain name registrations be undertaken in a manner that minimizes the potential for confusion with country code top level domains (ccTLDs).

For the event such 2-character domain name registrations would be permitted for third parties, the Second WIPO Process identified the potential for trademark abuse at the third level.

The purpose of the present submission is to bring to ICANN's attention that the Second WIPO Process considered the possibility of exploring measures for the UDRP to apply to such third-level registrations in order to mitigate the potential for trademark abuse.

/...

WIPO Arbitration and Mediation Center observations on *ICANN's Proposed Measures for Letter/Letter Two-Character ASCII Labels to Avoid Confusion with Corresponding Country Codes* – August 5, 2016

./ Relevant excerpts of the Report of the Second WIPO Process are set out in Annex 1.

These observations are posted on the WIPO website at:

www.wipo.int/amc/en/domains/resources/icann.

Thank you for your consideration.

Yours sincerely,



Erik Wilbers
Director
WIPO Arbitration and Mediation Center



Brian Beckham
Head
Internet Dispute Resolution Section
WIPO Arbitration and Mediation Center

Annex 1

WIPO Arbitration and Mediation Center observations on ICANN's Proposed Measures for Letter/Letter Two-Character ASCII Labels to Avoid Confusion with Corresponding Country Codes – August 5, 2016

Excerpt from the *Report of the Second WIPO Internet Domain Name Process*¹

ISO 3166 Alpha-2 Country Code Elements

294. The practice of registering ISO 3166 country code elements at the second level in the gTLDs in order to offer to the public the opportunity to register names under them raises questions regarding the application of the UDRP. The current version of the UDRP essentially is aimed at ensuring that names registered at the second level under the gTLDs to which the UDRP applies are not abusive. If they are found to be abusive, the UDRP foresees that the names can be cancelled or transferred to the complainant. However, if a country code is registered at the second level in one of these gTLDs and names are allowed to be registered under it, the level where the abuse most likely will occur is not only, or necessarily, the second level, but the third level (for example, famousmark.uk.com registered by a cybersquatter). This raises questions in terms of the applicability and enforcement of the UDRP. First, while it is clear that the registrant of the country code at the second level is bound to the UDRP (through its registration agreement with an ICANN-accredited registrar), it is not clear whether the registrant of the name at the third level would also be (indirectly) bound to the UDRP (as its agreement is with the registrant of the name at the second level, who may not have included a submission to the UDRP as a condition for accepting the registration of the name at the third level). Secondly, even if it were found that the UDRP indirectly applies to the third level, enforcement issues nonetheless would persist. The UDRP foresees that the ICANN-accredited registrars must cancel or transfer the name registered at the second level in case a violation of the Policy is found to exist. However, numerous names may be registered under the country code at the third level, only some of which might be abusive. Canceling or transferring the registration at the second level (i.e., the country code) might then be a disproportionate measure, because all the names at the third level (as well as those at any lower levels) would be adversely affected, irrespective of whether they were abusive or not. In view of these considerations, the persons or entities who have registered ISO 3166 country code elements and accept registrations of names under them should take measures to render the UDRP applicable to these registrations and to ensure the proper and prompt implementation of decisions transferring or canceling the registrations resulting from the UDRP. We are encouraged by the fact that certain such entities through comments submitted on the Interim Report have expressed a desire to work toward this goal.

295. With regard to the ISO 3166 alpha-2 code elements, it is recommended that the persons or entities in whose name such codes are registered at the second level in the existing gTLDs and who accept registrations of names under them be encouraged to take measures to render the UDRP applicable to these registrations, as well as to registrations at lower levels, and to ensure the proper and prompt implementation of decisions transferring or canceling these registrations resulting from the UDRP.

¹ For the full Report of the Second WIPO Internet Domain Name Process, see <http://www.wipo.int/amc/en/processes/process2/report/html/report.html>.