AIPPI

QUESTION 173

Issues of co-existence of trademarks and domain names: public versus private international registration systems

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Resolution

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Considering that:

a)   The trademark and domain name registration systems have evolved for different purposes and have developed different features. However, there are points of contact between the two systems.

b)   Domain name registrations have increased considerably, in both the generic Top Level Domains ("gTLDs") such as ".com" and ".net", as well as in the country code Top Level Domains ("ccTLDs") such as ".de" and ".jp", with an increase in the number of conflicts between trademarks and domain names.

c)   The growth of the domain name registration system has precipitated a need to review the rules governing domain name registration and the procedures for resolving conflicts between trademarks and domain names.

d)   International organizations, national governments, and the private sector have been asked to address these conflicts and improve the current system of domain name registration and administration.

e)   Several national governments have shown an interest in establishing and managing policy for their respective ccTLDs.

And whereas:

f)   There is a reasonable degree of harmonization of domain name registration and administration for generic Top Level Domains ("gTLDs").

g)   There is a divergence of viewpoints on several fundamental principles concerning ccTLD domain name registration and administration, including procedures for resolving trademark related conflicts.

h)   There is a growing need for harmonization among ccTLD registries regarding domain name registration and maintenance, as well as resolution options for trademark related conflicts.

i)   Organizations such as the World Intellectual Property Organization (WIPO), Internet Corporation for Assigned Names and Numbers (ICANN), and several NGOs have all encouraged greater cooperation between ccTLD registries, as well as the development of certain universal principles to which ccTLD registration and administration policies and procedures should conform.

j)   Harmonization will facilitate more efficient, equitable, and cost-effective domain name registration procedures, and improve due process for trademark related conflict resolution.

Adopts the following Resolution:

1.   Registration per se of a name as a domain name should not create proprietary rights in the name. Nevertheless, use of a domain name as a sign in commerce may confer legal rights on the domain name registrant, according to the applicable national law, for example by means of unfair competition law.

2.   Any rights resulting from domain name registrations should be capable of being the subject of transactions such as assignments and security interests/pledges.

3.   The domain name registration system for ccTLDs should allow national governments to determine whether their systems will be administered publicly and/or privately. Nevertheless, ccTLD domain name registration systems should provide for accountability, which may include minimal governmental involvement and/or oversight, as appropriate.

4.   The ccTLD registration systems should not discriminate among domain name registrants based on their nationality.

5.   The ccTLD domain name registries should not examine domain name applications for registration on grounds of being generic or based on the existence of prior trademark or geographical indication rights, since such examination will unduly burden registries as well as significantly impact the speed of domain name registration. If regulators impose public policy restrictions, the applicant must have the right to appeal such decisions.

6.   Accurate registrant and contact information (name, postal address, email address, telephone and fax number) should be readily available to the public, free of charge, in an online Whois database, which should include a local address for service of legal notice/process and other information sufficient to assert local jurisdiction. Such database should also include information regarding assignments (including the registration history), original creation date, encumbrances and security interests/pledges. The provision of false or misleading registrant and contact information should be a ground for rejection or cancellation of domain name registrations.

7.   A uniform dispute resolution procedure by which trademark rights holders may seek cancellation or transfer of infringing domain names should be established. The ccTLD registries are strongly encouraged to adopt a dispute resolution procedure in accordance

with the WIPO ccTLD Best Practices for the Prevention and Resolution of Intellectual Property Disputes or at a minimum the current ICANN Uniform Domain Name Dispute Resolution Policy (UDRP) procedure.

8. A renewal/maintenance fee should be payable to maintain the domain name registration.

9. AIPPI supports the current ccTLD harmonization efforts by ICANN through the new ccNSO (Country Code Names Supporting Organization).