

Wednesday, December 11, 2013 8:07 AM

To: Christine Willett

Cc: Trang Nguyen, John Jeffrey; Amy Stathos

Subject: WIPO Arbitration and Mediation Center End Report on Legal Rights Objection Procedure 2013

Dear Ms. Willett and colleagues,

I hope this finds you well.

Please find attached the WIPO Arbitration and Mediation Center End Report on Legal Rights Objection ["LRO"] Procedure 2013. The Report is also available online at <http://www.wipo.int/amc/en/docs/lroreport.pdf>. This is for your information as well as to inform the ICANN Board, and we would appreciate your making it so available. Please feel free also to have this posted as LRO-related correspondence.

The Report provides a historical and statistical resume of WIPO's case administration and discusses the substantive contribution of LRO Panelists under this pre-delegation rights protection mechanism. The Report's first fourteen pages present the core information, with the remainder covering documentary annexes.

The principal purpose of this WIPO publication is to help inform future domain name dispute resolution practices and determinations, and we hope ICANN will find it useful.

Yours sincerely,

Erik Wilbers  
Director  
WIPO Arbitration and Mediation Center



# **WIPO Arbitration and Mediation Center End Report on Legal Rights Objection Procedure 2013**

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## Introduction

On September 11, 2013, the last Expert Determination was rendered in the 69 Legal Rights Objection procedures administered by the World Intellectual Property Organization's Arbitration and Mediation Center ("WIPO Center") under the New gTLD Dispute Resolution Procedure ("Procedure") forming part of Module 3 of the gTLD Applicant Guidebook ("Applicant Guidebook") (v. 2012-06-04) approved by the Internet Corporation for Assigned Names and Numbers ("ICANN") on June 20, 2011 and as updated on January 11, 2012 for the first round of ICANN's New gTLD process.

The present WIPO Center Report provides a resume and analysis in relation to the Legal Rights Objection procedure administered by the WIPO Center. The purpose of the Report is twofold: first, to provide a historical and statistical overview of this project and second, to help inform future domain name dispute resolution practices and determinations.

A full overview of cases and outcomes is attached as Annex 1.

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Figure 1 - WIPO Arbitration and Mediation Center End Report on Legal Rights Objection Procedure 2013

## 1. ICANN Process

In 2005, ICANN's Generic Names Supporting Organization ("GNSO") began a policy development process to consider the introduction of new generic top-level domains ("gTLDs"), based on the results of trial rounds conducted in 2000 and 2003.<sup>1</sup> The GNSO released its Final Report on the Introduction of New Generic Top-Level Domains in August 2007, including 19 recommendations for implementing a program for the introduction of new gTLDs.<sup>2</sup> Among the recommendations were that "[s]trings must not infringe the existing legal rights of others" (Recommendation 3) and that "[d]ispute resolution and challenge processes must be established prior to the start of the process" (Recommendation 12).

In December 2007, ICANN sought "Expressions of Interest from Potential Dispute Resolution Service Providers for [the] New gTLD Program".<sup>3</sup> In January 2008, the WIPO Center signaled its readiness to assist ICANN in devising and applying appropriate trademark-based dispute resolution procedures for new gTLDs. From that time, using the WIPO "Joint Recommendation Concerning Provisions on the Protection of Marks, and Other Industrial Property Rights in Signs, on the Internet"<sup>4</sup> (Annex 5) as a foundation, the WIPO Center provided input to ICANN on the development of pre-delegation dispute resolution for trademark-based Legal Rights Objections. The WIPO Center subsequently agreed to administer disputes under the ICANN Legal Rights Objection procedure.

<sup>1</sup> <http://gns0.icann.org/issues/new-gtlds/gns0-issues-rpt-gtlds-05dec05.pdf>

<sup>2</sup> <http://gns0.icann.org/en/issues/new-gtlds/pdp-dec05-fr-part-a-08aug07.htm>

<sup>3</sup> <http://archive.icann.org/en/topics/drsp-call-for-expressions-of-interest.pdf>

<sup>4</sup> [http://www.wipo.int/export/sites/www/about-ip/en/development\\_iplaw/pdf/pub845.pdf](http://www.wipo.int/export/sites/www/about-ip/en/development_iplaw/pdf/pub845.pdf)

In June 2008, the ICANN Board adopted the 19 GNSO policy recommendations on new gTLDs.<sup>5</sup> In June 2011 the ICANN Board approved the Applicant Guidebook and authorized the launch of the New gTLD Program<sup>6</sup>, which culminated in ICANN's receipt of 1,930 applications by the close of the applicant filing window on May 30, 2012.

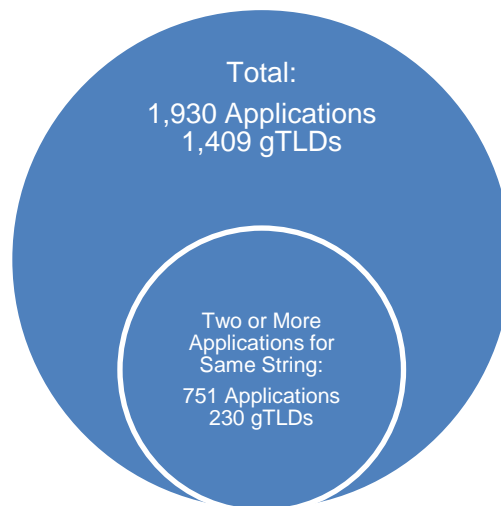


Figure 2 – WIPO Arbitration and Mediation Center End Report on Legal Rights Objection Procedure 2013

These 1,930 applications were for 1,409 separate strings. Applications were received from parties domiciled in 60

countries and territories, whereby 116 applications were for internationalized domains in 12 language scripts.<sup>7</sup> At least two applications were submitted for each of 230 of these proposed domains, for a total of 751 overlapping applications. Many of the legal rights objections received by the WIPO Center were filed by applicants against other applicants for the same gTLD string.

Prior to ICANN's approval of a New gTLD application, third parties had the opportunity to file a formal objection to an application on several grounds. In addition to Legal Rights Objections for trademark owners and Intergovernmental Organizations ("IGOs"), parties could file String Confusion Objections, Limited Public Interest Objections, and Community Objections. The WIPO Center administered the Legal Rights Objection procedure exclusively, with the other three procedures being administered by other dispute resolution service providers ("DRSP"). Proceedings under all four dispute resolution procedures were governed by the Procedure and the respective applicable DRSP Rules (Procedure, Articles 1(c) and 4(b)).

## 2. Policy and Rules

### 2.1. Framework

Module 3 of the Applicant Guidebook describes the dispute resolution procedure for Legal Rights Objections, including the purpose of this mechanism, the grounds for lodging a legal rights objection, the general procedures for filing or responding to a legal rights objection, and the manner in which dispute resolution proceedings are conducted. Module 3 also provides the guiding principles and standards that each expert panel must apply in reaching its expert determination (Preamble, Module 3 of the Applicant Guidebook). Attachment to Module 3 comprises the Procedure governing the proceedings. The Procedure provides for the DRSP to adopt a specific set of rules which will also apply to such proceedings (Preamble to Procedure; Procedure, Article 4(b)).

<sup>5</sup> <http://www.icann.org/en/groups/board/documents/resolutions-26jun08-en.htm>

<sup>6</sup> <http://www.icann.org/en/groups/board/documents/resolutions-20jun11-en.htm>

<sup>7</sup> <http://newgtlds.icann.org/en/announcements-and-media/announcement-13jun12-en>

## 2.2. Expert Determination Criteria

In each Legal Rights Objection proceeding, an independent expert panel (comprised of one or three experts) was tasked with determining whether the gTLD applicant's potential use of the applied-for gTLD would be likely to infringe the objector's existing trademark, or IGO name or acronym. Pursuant to Section 3.5.2 of the Applicant Guidebook, the expert panel would consider whether such potential use of the applied-for gTLD:

- (i) "takes unfair advantage of the distinctive character or the reputation of the objector's registered or unregistered trademark or service mark [...] or IGO name or acronym", or
- (ii) "unjustifiably impairs the distinctive character or the reputation of the objector's mark or IGO name or acronym", or
- (iii) "otherwise creates an impermissible likelihood of confusion between the applied-for gTLD and the objector's mark or IGO name or acronym."

Using the above test, the expert panel would furthermore take into account a range of non-exclusive consideration factors. For an objection based on trademark rights, these factors are the following<sup>8</sup>:

1. "Whether the applied-for gTLD is identical or similar, including in appearance, phonetic sound, or meaning, to the objector's existing mark.
2. Whether the objector's acquisition and use of rights in the mark has been *bona fide*.
3. Whether and to what extent there is recognition in the relevant sector of the public of the sign corresponding to the gTLD, as the mark of the objector, of the applicant or of a third party.
4. Applicant's intent in applying for the gTLD, including whether the applicant, at the time of application for the gTLD, had knowledge of the objector's mark, or could not have reasonably been unaware of that mark, and including whether the applicant has engaged in a pattern of conduct whereby it applied for or operates TLDs or registrations in TLDs which are identical or confusingly similar to the marks of others.
5. Whether and to what extent the applicant has used, or has made demonstrable preparations to use, the sign corresponding to the gTLD in connection with a *bona fide* offering of goods or services or a *bona fide* provision of information in a way that does not interfere with the legitimate exercise by the objector of its mark rights.
6. Whether the applicant has marks or other intellectual property rights in the sign corresponding to the gTLD, and, if so, whether any acquisition of such a right in the sign, and use of the sign, has

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<sup>8</sup> In the case where an objection has been filed by an IGO, the following non-exclusive factors were required to be considered by the panel:

1. "Whether the applied-for gTLD is identical or similar, including in appearance, phonetic sound or meaning, to the name or acronym of the objecting IGO.
2. Historical coexistence of the IGO and the applicant's use of a similar name or acronym. Factors considered may include:
  - a. Level of global recognition of both entities;
  - b. Length of time the entities have been in existence;
  - c. Public historical evidence of their existence, which may include whether the objecting IGO has communicated its name or abbreviation under Article 6ter of the Paris Convention for the Protection of Industrial Property.
3. Whether and to what extent the applicant has used, or has made demonstrable preparations to use, the sign corresponding to the TLD in connection with a *bona fide* offering of goods or services or a *bona fide* provision of information in a way that does not interfere with the legitimate exercise of the objecting IGO's name or acronym.
4. Whether and to what extent the applicant has been commonly known by the sign corresponding to the applied-for gTLD, and if so, whether any purported or likely use of the gTLD by the applicant is consistent therewith and *bona fide*.
5. Whether the applicant's intended use of the applied-for gTLD would create a likelihood of confusion with the objecting IGO's name or acronym as to the source, sponsorship, affiliation, or endorsement of the TLD."

been *bona fide*, and whether the purported or likely use of the gTLD by the applicant is consistent with such acquisition or use.

7. Whether and to what extent the applicant has been commonly known by the sign corresponding to the gTLD, and if so, whether any purported or likely use of the gTLD by the applicant is consistent therewith and *bona fide*.
8. Whether the applicant's intended use of the gTLD would create a likelihood of confusion with the objector's mark as to the source, sponsorship, affiliation, or endorsement of the gTLD."

### 3. WIPO Center Administration

#### 3.1. Procedure

The main stages of a Legal Rights Objection proceeding on the basis of the Procedure and the Applicant Guidebook are as follows:

1. Electronic filing of the legal rights objection to the WIPO Center within the designated filing window, and payment of the filing fee.
2. Appointment of Case Manager and administrative review of the legal rights objection by the WIPO Center. If required, notice to the objector for the correction of identified deficiencies.
3. WIPO Center issuance of an Acknowledgement of Receipt of the Objection and Notification of Compliance and Registration for Processing for compliant legal rights objections.
4. Publication of compliant legal rights objections on the WIPO Center's website.
5. ICANN publication of a Dispute Announcement, covering all compliant legal rights objections.
6. WIPO Center notification of the legal rights objection to the applicant, providing a 30-day response period.
7. Should the WIPO Center have not decided to consolidate a particular legal rights objection with any other legal rights objection, the applicant or objector may propose the consolidation of legal rights objections within 7 days of notification of the legal rights objection (as provided in step 6 above). Other interested parties may provide their comments or opposition to a consolidation request within 7 days of the initial consolidation request. Should the WIPO Center decide to consolidate legal rights objections on the basis of party request, the response deadline shall be 30 days from the applicant's receipt of the WIPO Center's notice of consolidation.
8. Following receipt of the response and payment of the filing fee, appointment of a single-member expert panel within 30 days.
9. In the event both parties agree to the appointment of a three-member expert panel, communication of such joint party agreement to the WIPO Center within 5 days of the receipt of the response. Additional fees apply to both parties.
10. Appointment of the expert panel; the expert panel is to make reasonable efforts to ensure that the expert determination is rendered within 45 days of expert panel constitution.
11. Notification of the expert determination to parties and ICANN, and publication of the expert determination on the WIPO Center's website. The WIPO Center furthermore included the expert determination in the WIPO Center's decision circular email.
12. Full refund of fees to the prevailing party.

### 3.2. WIPO Center Facilities

To give effect to the Procedure provided in the Applicant Guidebook, the WIPO Center put into place a number of user facilities.

- Pursuant to Article 4(b)(ii) of the Procedure, the WIPO Center made available the WIPO Rules for New gTLD Dispute Resolution, to be read and used in connection with such Procedure (Annex 4).
- Pursuant to Articles 7(b) and 11(c) of the Procedure, the WIPO Center made available a Model Objection form and a Model Response form (Annexes 6 and 7, respectively).
- The WIPO Center provided users with a website which centralized party resources, including a WIPO FAQ guide to a number of procedural and other queries to assist parties in making submissions (Annex 9).
- Cases were managed by senior lawyers, backed up by a secretariat and IT facilities.

### 3.3. Fees

ICANN’s Applicant Guidebook provided for party fees<sup>9</sup>, estimating that the filing fees (administrative fees) “could range from approximately USD 1,000 to USD 5,000 (or more) per party per proceeding” and that an adjudication fee (panelist fee) “for a proceeding involving a fixed amount could range from USD 2,000 to USD 8,000 (or more) per proceeding” whereas “an hourly rate based proceeding with a one-member panel could range from USD 32,000 to USD 56,000 (or more) and with a three-member panel it could range from USD 70,000 to USD 122,000 (or more).”<sup>10</sup> The Applicant Guidebook further provided that “[t]he prevailing party in a dispute resolution proceeding will have its advance payment refunded, while the non-prevailing party will not receive a refund and thus will bear the cost of the proceeding”.<sup>11</sup>

Well within the range estimated by ICANN, the WIPO Center in setting fees sought to strike a fair balance between affordability of the procedure and scope for proper panel composition reflecting the need for process quality and panelist expertise. The WIPO Center has provided a full refund of the administrative and panelist fees to each prevailing party in a Legal Rights Objection proceeding.

The following provides an overview of the WIPO schedule of fees for Legal Rights Objection proceedings (as further discussed below, no cases were in fact consolidated):

Fee Type	Single-Expert Panel	Three-Expert Panel
<b>WIPO Administrative Fee</b>	USD 2,000	USD 3,000
<b>WIPO Panelist Fee (no consolidation)</b>	USD 8,000	USD 20,000
WIPO Panelist Fee (consolidation – multiple objections to single application)	USD 4,800 (per string)	USD 12,000 (per string)
WIPO Panelist Fee (consolidation – multiple objections by same objector to multiple applications)	USD 6,400 (per string)	USD 16,000 (per string)

Figure 3 – WIPO Arbitration and Mediation Center End Report on Legal Rights Objection Procedure 2013

<sup>9</sup> Applicant Guidebook, Sections 1.1.2.9, 1.5.2, 3.3.2, 3.3.4.

<sup>10</sup> Funding from ICANN for objection filing fees and advance payment of costs was made available to the At-Large Advisory Committee, and to individual national governments (Applicant Guidebook, Section 3.3.2). No fees received for WIPO-administered cases were paid by ICANN.

<sup>11</sup> Applicant Guidebook, Section 1.5.2.



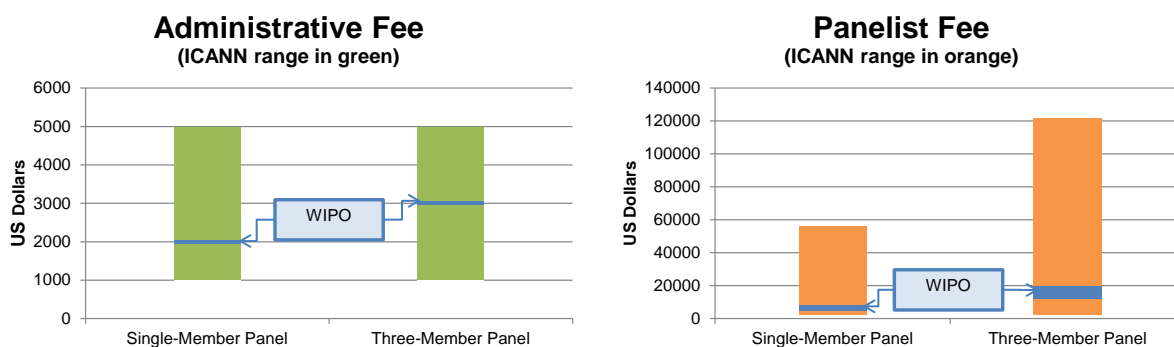


Figure 4 – WIPO Arbitration and Mediation Center End Report on Legal Rights Objection Procedure 2013

#### 4. Case Filings

The formal objection period under the New gTLD Program opened on June 13, 2012 and closed on March 13, 2013, during which the WIPO Center received a total of 71 Legal Rights Objection filings. Following an administrative review pursuant to Article 9 of the Procedure, 69 legal rights objections were found compliant and registered for processing, and 2 legal rights objections were dismissed pursuant to Articles 8(a)(ii) and 9 of the Procedure for failure to assert relevant rights. Subsequent reference to Legal Rights Objection proceedings in this Report will relate only to those compliant objections, unless stated otherwise.

The geographical spread of the filed legal rights objections covered objectors from 11 jurisdictions and applicants from 17 jurisdictions. Further information on the domicile of the parties and the nature of these objections follows.<sup>12</sup>

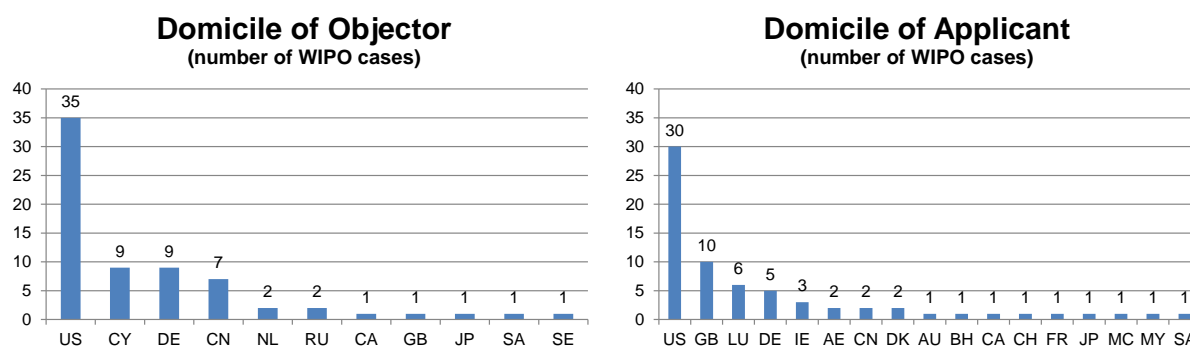


Figure 5 – WIPO Arbitration and Mediation Center End Report on Legal Rights Objection Procedure 2013

<sup>12</sup> AE: United Arab Emirates; AU: Australia; BH: Bahrain; CA: Canada; CH: Switzerland; CN: China; CY: Cyprus; DE: Germany; DK: Denmark; FR: France; GB: United Kingdom of Great Britain and Northern Ireland; IE: Ireland; JP: Japan; LU: Luxembourg; MC: Monaco; MY: Malaysia; NL: Netherlands; RU: Russian Federation; SA: Saudi Arabia; SE: Sweden; US: United States of America.

- Three legal rights objections concerned internationalized strings.



Figure 6 – WIPO Arbitration and Mediation Center End Report on Legal Rights Objection Procedure 2013

- 22 cases featured both parties from the same jurisdiction (18 cases with parties from the United States, 2 cases with parties from China, and 2 cases with parties from Germany).

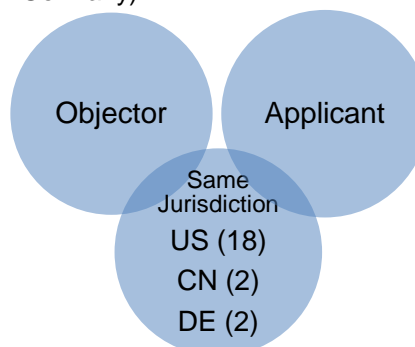


Figure 7 – WIPO Arbitration and Mediation Center End Report on Legal Rights Objection Procedure 2013

- The 69 cases involved 34 nominally-distinct objectors and 51 nominally-distinct applicants.
- Of the 34 nominally-distinct objectors, 23 filed only one legal rights objection and 11 filed more than one objection. Defender Security Company filed the most objections (9 objections).
- Of the 51 nominally-distinct applicants, 43 received only one legal rights objection and 8 received more than one objection. Charleston Road Registry Inc received the most objections nominally (7 objections). Certain other nominally-distinct applicants in legal rights objection proceedings appeared to be related entities.



Figure 8 – WIPO Arbitration and Mediation Center End Report on Legal Rights Objection Procedure 2013

## 5. Panel Appointment

The WIPO Center’s Legal Rights Objection roster comprised 107 panelists from 30 countries, with corresponding linguistic and regional diversity as well as significant expertise in trademark, e-commerce and Internet law. Between them, these panelists had decided approximately 11,500 out of a total of 20,000 WIPO panel decisions<sup>13</sup> under the WIPO-initiated Uniform Domain Name Dispute Resolution Policy (UDRP).

The WIPO Center exercised a conservative approach in panel appointment, with concern furthermore for equitable case distribution. In total, 49 out of the 107 panelists on the WIPO Center’s Legal Rights Objection roster were appointed. The appointed panelists spanned 17 nationalities, and between them had decided more than 6,000 WIPO UDRP decisions.

<sup>13</sup> As of December 2013, the WIPO Center had received over 27,000 UDRP-based complaints. Over 6,000 such disputes were settled and withdrawn prior to panel appointment (with full WIPO Center refund of panelist fees).

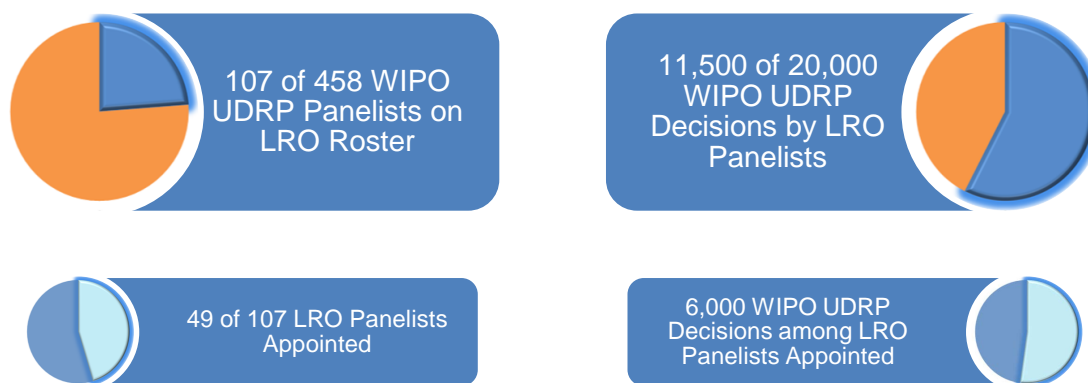


Figure 9 – WIPO Arbitration and Mediation Center End Report on Legal Rights Objection Procedure 2013

In accordance with Article 13(c) of the Procedure, all appointed panelists were required to affirm their neutrality by signing the WIPO Center’s Legal Rights Objection Statement of Acceptance and Declaration of Impartiality and Independence. A copy of the Declaration of Impartiality and Independence form was made publicly available on the WIPO Center’s website (Annex 8).

Of the 63 proceedings where expert determinations were rendered, 54 were rendered by single-member expert panels, and 9 were rendered by three-member expert panels.

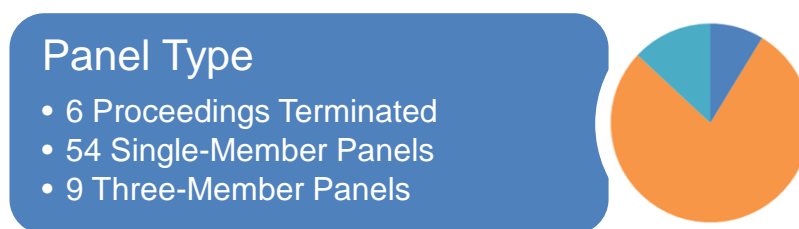


Figure 10 – WIPO Arbitration and Mediation Center End Report on Legal Rights Objection Procedure 2013

6. Results

6.1. Procedure

- While consolidation was proposed by parties in several proceedings, taking into account the absence of expressed party consent and/or the expressed party opposition to such consolidation, the WIPO Center did not decide to consolidate any proceedings (Procedure, Article 12).

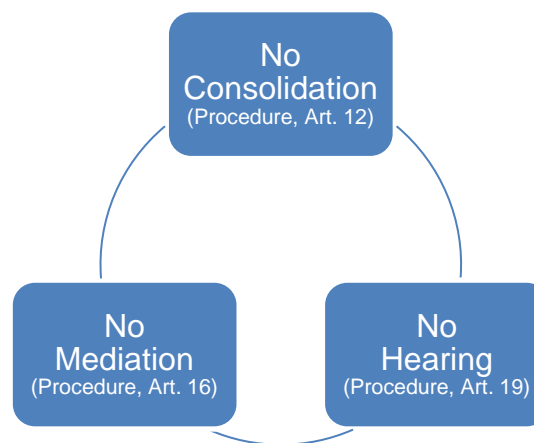


Figure 11 – WIPO Arbitration and Mediation Center End Report on Legal Rights Objection Procedure 2013

- In no case did an expert panel decide to conduct a hearing (Procedure, Article 19), although it was unilaterally requested in 5 proceedings.
- In no case did the parties jointly request mediation, although the possibility was raised in several instances (Procedure, Article 16).



- Supplemental submissions were filed in 38 of the 63 proceedings in which an expert determination was rendered (Procedure, Article 17).
- Pursuant to Article 5 of the Procedure, all proceedings were conducted in English.

Figure 12 – WIPO Arbitration and Mediation Center End Report on Legal Rights Objection Procedure 2013

## 6.2. Outcomes

Of the 71 filed legal rights objections, 2 were dismissed for non-compliance. Six proceedings were terminated, in 3 cases due to the withdrawal of gTLD applications. Expert panels upheld 4 legal rights objections, with dissenting opinions in 3 of these cases. Expert panels rejected 59 legal rights objections.

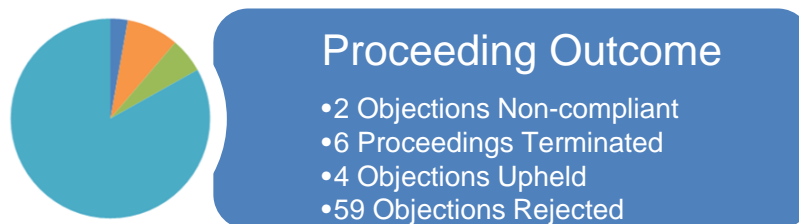


Figure 13 – WIPO Arbitration and Mediation Center End Report on Legal Rights Objection Procedure 2013

- Article 21(a) of the Procedure provides that the expert panel shall make reasonable efforts to ensure that the expert determination is rendered within 45 days of expert panel constitution.
- The average time to render an expert determination without supplemental filings in the proceeding was 44.6 days.
- The average time to render an expert determination with supplemental filings in the proceeding was 56.1 days.
- The first expert determination was rendered on July 3, 2013.
- The last expert determination was rendered on September 11, 2013.
- The average length of a rendered expert determination was 12.5 pages.
- Three (related) expert determinations included one expert panel addendum.



Figure 14 – WIPO Arbitration and Mediation Center End Report on Legal Rights Objection Procedure 2013

In accordance with the Procedure, each expert determination was notified to the parties and to ICANN and subsequently published on the WIPO Center’s website (Procedure, Article 21). The WIPO Center additionally included reference to published expert determinations in its daily domain name decision circular sent to thousands of subscribers. The ongoing WIPO Center publication of expert determinations was covered by domain name and intellectual property publications and blogs.

In the event that an applicant prevailed in a Legal Rights Objection proceeding, its application would continue within the ICANN New gTLD Program towards approval and the eventual delegation of the applied-for string. In the event that an objector prevailed in a proceeding, the “findings of the panel will be considered an expert determination and advice that ICANN will accept within the dispute resolution process” (Applicant Guidebook, Section 3.4.6) and the “[a]pplication proceeds no further” (Applicant Guidebook, Section 1.1.2.9). In any event, the availability of the Legal Rights Objection as an administrative dispute resolution option was not to preclude any options which an interested party may have to submit a dispute concerning a gTLD application to court at any time.

### 6.3. Evaluation

The following is a brief and informal WIPO Center summary of substantive findings that appear to be broadly representative of expert determinations.<sup>14</sup> These observations are provided subject to the full findings made by expert panels and without prejudice to any future Legal Rights Objection or other proceeding.

A significant proportion of legal rights objections were filed by applicants against other applicants for the same gTLD string (43 of 69 legal rights objections). A minority of applicants in Legal Rights Objection proceedings asserted and evidenced registered rights in support of their application and response.

In a number of cases, expert panels noted in their expert determinations that asserted trademark registrations were primarily obtained for the purpose of supporting an application for a new gTLD application and/or legal rights objection, with little or no demonstrable prior use. The legal rights objections ultimately upheld were made on the basis of established rights and/or marks with substantial demonstrated use, although not all legal rights objections based on such marks were upheld.

An overwhelming majority of legal rights objections were filed against applications for gTLD strings with descriptive or dictionary meaning. In most instances where the expert panel rejected a legal rights objection, including where the latter was based on recognized marks, the expert panel based such rejection on the applicant’s stated and evidenced explanation of its selection of the applied-for gTLD string for its descriptive or dictionary meaning. Many expert panels concluded that where a trademark owner has adopted a

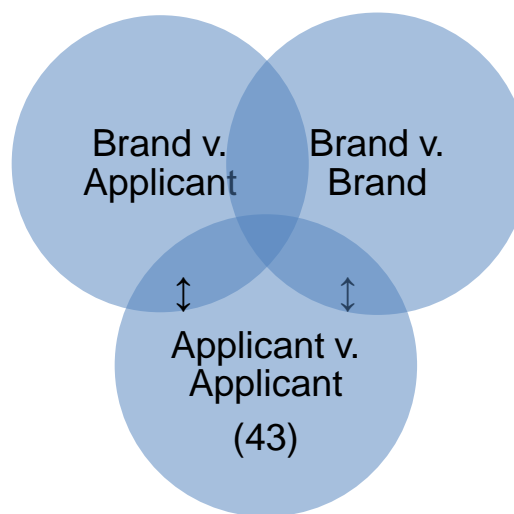
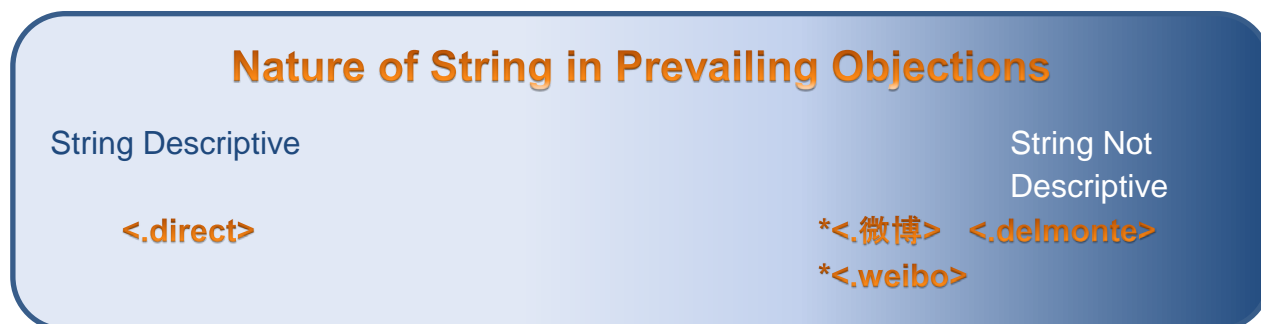


Figure 15 – WIPO Arbitration and Mediation Center End Report on Legal Rights Objection Procedure 2013

<sup>14</sup> These observations include insights shared by WIPO Legal Rights Objection panelist Andrew Christie in a presentation made in October 2013. The WIPO Center is grateful to Professor Christie.

common dictionary term as a trademark, a gTLD application intended to take advantage of such common meaning would not as such violate the dispute resolution standards for Legal Rights Objections. Where an expert panel determined that the application did not aim to use the descriptive or dictionary meaning of a string, but rather targeted a trademark, the expert panel declared the application objectionable.



**Figure 16 – WIPO Arbitration and Mediation Center End Report on Legal Rights Objection Procedure 2013**

\* A dissenting opinion concludes that the majority presumption that the string is not descriptive may be correct but has not been proven on the record.

Certain expert panels took the drafting approach to apply the core Legal Rights Objection test first, followed by a discussion of the non-exclusive factors to be taken into account. Other expert panels reviewed the non-exclusive factors first and then applied these findings to the core test to conclude the expert determination.<sup>15</sup>

While expert panels discussed all of the non-exclusive consideration factors, they tended to give more prominence to some of these in the specific context of a case.

- Factors 1-2: A number of expert determinations addressed the trademark status of the legal rights objection in relation to the timing and enforceability of the right. Some expert panels discussed the trademark status in terms of standing.
- Factor 3: This factor received mention in particular in connection with the actual or desired submission of survey evidence, whether on paper or in conjunction with a hearing request.
- Factor 4: If factor 4 was considered relevant, this was mostly in conjunction with factor 8.
- Factors 5-7: Applicant's use of the applied-for string or rights in a sign corresponding to the applied-for string was not identified as particularly relevant in the expert determinations. Expert panels noted that many applicants disclaimed such rights for the applied-for common term.
- Factor 8: Factor 8 featured prominently in most of the expert determinations, as important input for the expert panel's application of the higher-level Legal Rights Objection test.

Although this remains a matter of speculation, it appears reasonable to presume that the existence itself of the pre-delegation Legal Rights Objection mechanism, including published decision criteria and consideration factors, may have prevented a number of potentially improper gTLD applications from being made.

Especially in connection with dictionary terms, expert panels considered potential for infringement as such to be an insufficient basis to halt the application. Considering such potential in terms of the

<sup>15</sup> Reference here is made only to the non-exclusive factors for objections based on trademark rights, as no expert determination was rendered where the objection was filed by an IGO.

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substantive Legal Rights Objection test, expert panels focused on whether use of the gTLD by the applicant was “unfair”, “unjust”, or “impermissible”. A scenario which it seems the present round of expert determinations did not have to address was where large-scale infringement in a new gTLD would appear highly likely.

Expert panels’ observations with regard to the potential for infringement applied both to use of the top-level as such and at the second level. These observations referred to the nature of the top-level string (*e.g.*, whether the string was a dictionary term), its intended use, and any existence of competing trademark rights.

In a number of cases, expert panels recorded their presumption that the objector would monitor activity within a new gTLD with a view to possible further action, ranging from party arrangements to post-delegation procedures through ICANN or in court. As to the potential for infringement at the second level, in a number of instances expert panels noted the availability of corresponding ICANN mechanisms, notably the UDRP.

## Annex 1

# WIPO Legal Rights Objection Cases and Outcomes

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Annex 1 – WIPO Legal Rights Objection Cases and Outcomes (in alphabetical order, with objections in relation to internationalized strings presented last in order of objection filing)

<b>gTLD String</b>	<b>Objector</b>	<b>Applicant</b>	<b>Determination</b>
<b>.academy</b>	Academy, Ltd., d/b/a Academy Sports + Outdoors	Half Oaks, LLC	Objection Rejected
<b>.axis</b>	Axis Communications AB/ Axis AB	Saudi Telecom Company	Terminated
<b>.bio</b>	Biotechnology Industry Organization	Starting Dot	Objection Rejected
<b>.blue</b>	Blue Cross and Blue Shield Association ("BCBSA")	Afilias Limited	Objection Rejected
<b>.cam</b>	AC Webconnecting Holding B.V.	Dot Agency Limited	Objection Rejected
<b>.cam</b>	AC Webconnecting Holding B.V.	United TLD Holdco Ltd.	Objection Rejected
<b>.coach</b>	Coach, Inc.	Koko Island, LLC aka Dozen Donuts, LLC aka Donuts, Inc	Objection Rejected
<b>.delmonte</b>	Del Monte Corporation	Del Monte International GmbH	Objection Upheld with Dissenting Opinion
<b>.direct</b>	The DirecTV Group Inc.	Dish DBS Corporation	Objection Upheld
<b>.diy</b>	Scripps Networks, LLC	Charleston Road Registry Inc.	Objection Rejected
<b>.eco</b>	planet.ECO, LLC	Top Level Domain Holdings Limited	Objection Rejected
<b>.emerck</b>	Merck & Co., Inc.	Merck KGaA	Objection Rejected
<b>.express</b>	Express, LLC	Sea Sunset, LLC	Objection Rejected
<b>.food</b>	Scripps Networks Interactive, Inc.	Dot Food, LLC	Objection Rejected
<b>.food</b>	Scripps Networks Interactive, Inc.	Wild Orchard, LLC	Objection Rejected
<b>.gcc</b>	The Cooperation Council for the Arab States of the Gulf also known as the Gulf Cooperation Council or GCC	GCCIX WLL	Terminated
<b>.gmbh</b>	TLDDOT GmbH	InterNetWire Web-Development GmbH	Objection Rejected
<b>.goo</b>	NTT Resonant Inc.	Charleston Road Registry Inc.	Terminated
<b>.home</b>	Defender Security Company	.Home Registry Inc.	Objection Rejected
<b>.home</b>	Defender Security Company	Baxter Pike LLC	Objection Rejected
<b>.home</b>	Defender Security Company	Charleston Road Registry Inc.	Objection Rejected
<b>.home</b>	Defender Security Company	Dot Home LLC	Objection Rejected
<b>.home</b>	Defender Security Company	DotHome Inc.	Objection Rejected
<b>.home</b>	Defender Security Company	Lifestyle Domain Holdings, Inc.	Objection Rejected
<b>.home</b>	Defender Security Company	Merchant Law Group LLP	Objection Rejected
<b>.home</b>	Defender Security Company	Top Level Domain Holdings Limited	Objection Rejected
<b>.home</b>	Defender Security Company	Uniregistry, Corp.	Objection Rejected
<b>.limited</b>	Limited Stores, LLC	Big Fest, LLC	Objection Rejected
<b>.mail</b>	United States Postal Service	1&1 Mail & Media GmbH	Terminated

gTLD String	Objector	Applicant	Determination
<b>.mail</b>	United States Postal Service	Afilias Domains No. 2 Limited	Terminated
<b>.mail</b>	United States Postal Service	Amazon EU S.à r.l	Objection Rejected
<b>.mail</b>	United States Postal Service	Charleston Road Registry Inc.	Objection Rejected
<b>.mail</b>	United States Postal Service	GMO Registry, Inc.	Objection Rejected
<b>.mail</b>	United States Postal Service	Victor Dale, LLC	Objection Rejected
<b>.mail</b>	United States Postal Service	WhitePages TLD LLC	Objection Rejected
<b>.merck</b>	Merck & Co., Inc.	Merck KGaA	Objection Rejected
<b>.merck</b>	Merck KGaA	Merck Registry Holdings, Inc.	Objection Rejected
<b>.merck</b>	Merck KGaA	Merck Registry Holdings, Inc.	Objection Rejected
<b>.merckmsd</b>	Merck KGaA	MSD Registry Holdings, Inc	Objection Rejected
<b>.mls</b>	The Canadian Real Estate Association (CREA)	Afilias Limited	Objection Rejected
<b>.moto</b>	Motorola Trademark Holdings LLC	United TLD Holdco Ltd.	Objection Rejected
<b>.music</b>	DotMusic Limited	.music LLC	Objection Rejected
<b>.music</b>	DotMusic Limited	Amazon EU S.à r.l.	Objection Rejected
<b>.music</b>	DotMusic Limited	Charleston Road Registry Inc.	Objection Rejected
<b>.music</b>	DotMusic Limited	dot Music Limited	Objection Rejected
<b>.music</b>	DotMusic Limited	DotMusic Inc.	Objection Rejected
<b>.music</b>	DotMusic Limited	Entertainment Names Inc.	Objection Rejected
<b>.music</b>	DotMusic Limited	Victor Cross	Objection Rejected
<b>.now</b>	Starbucks (HK) Limited	Amazon EU S.a.r.l.	Objection Rejected
<b>.now</b>	Starbucks (HK) Limited	Global Top Level ApS	Objection Rejected
<b>.now</b>	Starbucks (HK) Limited	Grand Turn, LLC	Objection Rejected
<b>.now</b>	Starbucks (HK) Limited	One.com A/S	Objection Rejected
<b>.now</b>	Starbucks (HK) Limited	XYZ.COM LLC	Objection Rejected
<b>.pin</b>	Pinterest, Inc.	Amazon EU S.à.r.l.	Objection Rejected
<b>.rightathome</b>	Right At Home, Inc.	Johnson Shareholdings, Inc	Objection Rejected
<b>.song</b>	DotSong Limited	Amazon EU S.à.r.l.	Objection Rejected
<b>.tube</b>	Latin American Telecom, LLC	Charleston Road Registry, Inc.	Objection Rejected
<b>.tunes</b>	DotTunes Limited	Amazon EU S.à.r.l.	Objection Rejected
<b>.vip</b>	I-Registry Ltd.	Charleston Road Registry Inc.	Objection Rejected
<b>.vip</b>	I-Registry Ltd.	John Corner, LLC.	Objection Rejected
<b>.vip</b>	I-Registry Ltd.	Top Level Domain Holdings Limited	Objection Rejected
<b>.vip</b>	I-Registry Ltd.	VIP Registry Pte. Ltd	Objection Rejected
<b>.vip</b>	I-Registry Ltd.	Vipspace Enterprises LLC	Objection Rejected
<b>.weibo</b>	Sina Corporation	Tencent Holdings Limited	Objection Upheld with Dissenting Opinion
<b>.yellowpages</b>	Hibu (UK) Limited	Telstra Corporation Limited	Objection Rejected
<b>.zone</b>	AutoZone Parts, Inc.	Outer Falls, LLC	Terminated
<b>.微博</b>	Sina Corporation	Tencent Holdings Limited	Objection Upheld with Dissenting Opinion
<b>.kom</b>	Regtime Ltd.; Legato Ltd.	VeriSign Sarl	Objection Rejected
<b>.opr</b>	Regtime Ltd.; Legato Ltd.	Public Interest Registry	Objection Rejected

## **Annex 2**

### **ICANN gTLD Applicant Guidebook, Module 3, Objection Procedures**

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# gTLD Applicant Guidebook

(v. 2012-06-04)

Module 3

4 June 2012

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# Module 3

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## Objection Procedures

This module describes two types of mechanisms that may affect an application:

- I. The procedure by which ICANN's Governmental Advisory Committee may provide GAC Advice on New gTLDs to the ICANN Board of Directors concerning a specific application. This module describes the purpose of this procedure, and how GAC Advice on New gTLDs is considered by the ICANN Board once received.
- II. The dispute resolution procedure triggered by a formal objection to an application by a third party. This module describes the purpose of the objection and dispute resolution mechanisms, the grounds for lodging a formal objection to a gTLD application, the general procedures for filing or responding to an objection, and the manner in which dispute resolution proceedings are conducted.

This module also discusses the guiding principles, or standards, that each dispute resolution panel will apply in reaching its expert determination.

All applicants should be aware of the possibility that a formal objection may be filed against any application, and of the procedures and options available in the event of such an objection.

### 3.1 GAC Advice on New gTLDs

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ICANN's Governmental Advisory Committee was formed to consider and provide advice on the activities of ICANN as they relate to concerns of governments, particularly matters where there may be an interaction between ICANN's policies and various laws and international agreements or where they may affect public policy issues.

The process for GAC Advice on New gTLDs is intended to address applications that are identified by governments to be problematic, e.g., that potentially violate national law or raise sensitivities.

GAC members can raise concerns about any application to the GAC. The GAC as a whole will consider concerns

raised by GAC members, and agree on GAC advice to forward to the ICANN Board of Directors.

The GAC can provide advice on any application. For the Board to be able to consider the GAC advice during the evaluation process, the GAC advice would have to be submitted by the close of the Objection Filing Period (see Module 1).

GAC Advice may take one of the following forms:

- I. The GAC advises ICANN that it is the consensus of the GAC that a particular application should not proceed. This will create a strong presumption for the ICANN Board that the application should not be approved.
- II. The GAC advises ICANN that there are concerns about a particular application "dot-example." The ICANN Board is expected to enter into dialogue with the GAC to understand the scope of concerns. The ICANN Board is also expected to provide a rationale for its decision.
- III. The GAC advises ICANN that an application should not proceed unless remediated. This will raise a strong presumption for the Board that the application should not proceed unless there is a remediation method available in the Guidebook (such as securing the approval of one or more governments), that is implemented by the applicant.

Where GAC Advice on New gTLDs is received by the Board concerning an application, ICANN will publish the Advice and endeavor to notify the relevant applicant(s) promptly. The applicant will have a period of 21 calendar days from the publication date in which to submit a response to the ICANN Board.

ICANN will consider the GAC Advice on New gTLDs as soon as practicable. The Board may consult with independent experts, such as those designated to hear objections in the New gTLD Dispute Resolution Procedure, in cases where the issues raised in the GAC advice are pertinent to one of the subject matter areas of the objection procedures. The receipt of GAC advice will not toll the processing of any application (i.e., an application will not be suspended but will continue through the stages of the application process).

## 3.2 *Public Objection and Dispute Resolution Process*

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The independent dispute resolution process is designed to protect certain interests and rights. The process provides a path for formal objections during evaluation of the applications. It allows a party with standing to have its objection considered before a panel of qualified experts.

A formal objection can be filed only on four enumerated grounds, as described in this module. A formal objection initiates a dispute resolution proceeding. In filing an application for a gTLD, the applicant agrees to accept the applicability of this gTLD dispute resolution process. Similarly, an objector accepts the applicability of this gTLD dispute resolution process by filing its objection.

As described in section 3.1 above, ICANN's Governmental Advisory Committee has a designated process for providing advice to the ICANN Board of Directors on matters affecting public policy issues, and these objection procedures would not be applicable in such a case. The GAC may provide advice on any topic and is not limited to the grounds for objection enumerated in the public objection and dispute resolution process.

### 3.2.1 *Grounds for Objection*

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A formal objection may be filed on any one of the following four grounds:

**String Confusion Objection** – The applied-for gTLD string is confusingly similar to an existing TLD or to another applied-for gTLD string in the same round of applications.

**Legal Rights Objection** – The applied-for gTLD string infringes the existing legal rights of the objector.

**Limited Public Interest Objection** – The applied-for gTLD string is contrary to generally accepted legal norms of morality and public order that are recognized under principles of international law.

**Community Objection** – There is substantial opposition to the gTLD application from a significant portion of the community to which the gTLD string may be explicitly or implicitly targeted.

The rationales for these objection grounds are discussed in the final report of the ICANN policy development process for new gTLDs. For more information on this process, see

<http://gnso.icann.org/issues/new-gtlds/pdp-dec05-fr-part-08aug07.htm>.

### 3.2.2 *Standing to Object*

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Objectors must satisfy standing requirements to have their objections considered. As part of the dispute proceedings, all objections will be reviewed by a panel of experts designated by the applicable Dispute Resolution Service Provider (DRSP) to determine whether the objector has standing to object. Standing requirements for the four objection grounds are:

Objection ground	Who may object
String confusion	Existing TLD operator or gTLD applicant in current round. In the case where an IDN ccTLD Fast Track request has been submitted before the public posting of gTLD applications received, and the Fast Track requestor wishes to file a string confusion objection to a gTLD application, the Fast Track requestor will be granted standing.
Legal rights	Rightholders
Limited public interest	No limitations on who may file – however, subject to a “quick look” designed for early conclusion of frivolous and/or abusive objections
Community	Established institution associated with a clearly delineated community

#### 3.2.2.1 *String Confusion Objection*

Two types of entities have standing to object:

- An existing TLD operator may file a string confusion objection to assert string confusion between an applied-for gTLD and the TLD that it currently operates.
- Any gTLD applicant in this application round may file a string confusion objection to assert string confusion between an applied-for gTLD and the gTLD for which it has applied, where string confusion between the two applicants has not already been found in the Initial Evaluation. That is, an applicant does not have standing to object to another application with which it is already in a contention set as a result of the Initial Evaluation.

In the case where an existing TLD operator successfully asserts string confusion with an applicant, the application will be rejected.

In the case where a gTLD applicant successfully asserts string confusion with another applicant, the only possible



outcome is for both applicants to be placed in a contention set and to be referred to a contention resolution procedure (refer to Module 4, String Contention Procedures). If an objection by one gTLD applicant to another gTLD application is unsuccessful, the applicants may both move forward in the process without being considered in direct contention with one another.

### 3.2.2.2 *Legal Rights Objection*

A rightsholder has standing to file a legal rights objection. The source and documentation of the existing legal rights the objector is claiming (which may include either registered or unregistered trademarks) are infringed by the applied-for gTLD must be included in the filing.

An intergovernmental organization (IGO) is eligible to file a legal rights objection if it meets the criteria for registration of a .INT domain name<sup>1</sup>:

- a) An international treaty between or among national governments must have established the organization; and
- b) The organization that is established must be widely considered to have independent international legal personality and must be the subject of and governed by international law.

The specialized agencies of the UN and the organizations having observer status at the UN General Assembly are also recognized as meeting the criteria.

### 3.2.2.3 *Limited Public Interest Objection*

Anyone may file a Limited Public Interest Objection. Due to the inclusive standing base, however, objectors are subject to a "quick look" procedure designed to identify and eliminate frivolous and/or abusive objections. An objection found to be manifestly unfounded and/or an abuse of the right to object may be dismissed at any time.

A Limited Public Interest objection would be manifestly unfounded if it did not fall within one of the categories that have been defined as the grounds for such an objection (see subsection 3.5.3).

A Limited Public Interest objection that is manifestly unfounded may also be an abuse of the right to object. An objection may be framed to fall within one of the

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<sup>1</sup> See also <http://www.iana.org/domains/int/policy/>.

accepted categories for Limited Public Interest objections, but other facts may clearly show that the objection is abusive. For example, multiple objections filed by the same or related parties against a single applicant may constitute harassment of the applicant, rather than a legitimate defense of legal norms that are recognized under general principles of international law. An objection that attacks the applicant, rather than the applied-for string, could be an abuse of the right to object.<sup>2</sup>

The quick look is the Panel's first task, after its appointment by the DRSP and is a review on the merits of the objection. The dismissal of an objection that is manifestly unfounded and/or an abuse of the right to object would be an Expert Determination, rendered in accordance with Article 21 of the New gTLD Dispute Resolution Procedure.

In the case where the quick look review does lead to the dismissal of the objection, the proceedings that normally follow the initial submissions (including payment of the full advance on costs) will not take place, and it is currently contemplated that the filing fee paid by the applicant would be refunded, pursuant to Procedure Article 14(e).

#### 3.2.2.4 Community Objection

Established institutions associated with clearly delineated communities are eligible to file a community objection. The community named by the objector must be a community strongly associated with the applied-for gTLD string in the application that is the subject of the objection. To qualify for standing for a community objection, the objector must prove both of the following:

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<sup>2</sup> The jurisprudence of the European Court of Human Rights offers specific examples of how the term "manifestly ill-founded" has been interpreted in disputes relating to human rights. Article 35(3) of the European Convention on Human Rights provides: "The Court shall declare inadmissible any individual application submitted under Article 34 which it considers incompatible with the provisions of the Convention or the protocols thereto, manifestly ill-founded, or an abuse of the right of application." The ECHR renders reasoned decisions on admissibility, pursuant to Article 35 of the Convention. (Its decisions are published on the Court's website <http://www.echr.coe.int>.) In some cases, the Court briefly states the facts and the law and then announces its decision, without discussion or analysis. E.g., Decision as to the Admissibility of Application No. 34328/96 by Egbert Peree against the Netherlands (1998). In other cases, the Court reviews the facts and the relevant legal rules in detail, providing an analysis to support its conclusion on the admissibility of an application. Examples of such decisions regarding applications alleging violations of Article 10 of the Convention (freedom of expression) include: *Décision sur la recevabilité de la requête no 65831/01 présentée par Roger Garaudy contre la France* (2003); *Décision sur la recevabilité de la requête no 65297/01 présentée par Eduardo Fernando Alves Costa contre le Portugal* (2004).

The jurisprudence of the European Court of Human Rights also provides examples of the abuse of the right of application being sanctioned, in accordance with ECHR Article 35(3). See, for example, *Décision partielle sur la recevabilité de la requête no 61164/00 présentée par Gérard Duringer et autres contre la France et de la requête no 18589/02 contre la France* (2003).

***It is an established institution*** – Factors that may be considered in making this determination include, but are not limited to:

- Level of global recognition of the institution;
- Length of time the institution has been in existence; and
- Public historical evidence of its existence, such as the presence of a formal charter or national or international registration, or validation by a government, inter-governmental organization, or treaty. The institution must not have been established solely in conjunction with the gTLD application process.

***It has an ongoing relationship with a clearly delineated community*** – Factors that may be considered in making this determination include, but are not limited to:

- The presence of mechanisms for participation in activities, membership, and leadership;
- Institutional purpose related to the benefit of the associated community;
- Performance of regular activities that benefit the associated community; and
- The level of formal boundaries around the community.

The panel will perform a balancing of the factors listed above, as well as other relevant information, in making its determination. It is not expected that an objector must demonstrate satisfaction of each and every factor considered in order to satisfy the standing requirements.

### ***3.2.3 Dispute Resolution Service Providers***

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To trigger a dispute resolution proceeding, an objection must be filed by the posted deadline date, directly with the appropriate DRSP for each objection ground.

- The International Centre for Dispute Resolution has agreed to administer disputes brought pursuant to string confusion objections.
- The Arbitration and Mediation Center of the World Intellectual Property Organization has agreed to administer disputes brought pursuant to legal rights objections.

- The International Center of Expertise of the International Chamber of Commerce has agreed to administer disputes brought pursuant to Limited Public Interest and Community Objections.

ICANN selected DRSPs on the basis of their relevant experience and expertise, as well as their willingness and ability to administer dispute proceedings in the new gTLD Program. The selection process began with a public call for expressions of interest<sup>3</sup> followed by dialogue with those candidates who responded. The call for expressions of interest specified several criteria for providers, including established services, subject matter expertise, global capacity, and operational capabilities. An important aspect of the selection process was the ability to recruit panelists who will engender the respect of the parties to the dispute.

### *3.2.4 Options in the Event of Objection*

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Applicants whose applications are the subject of an objection have the following options:

The applicant can work to reach a settlement with the objector, resulting in withdrawal of the objection or the application;

The applicant can file a response to the objection and enter the dispute resolution process (refer to Section 3.2); or

The applicant can withdraw, in which case the objector will prevail by default and the application will not proceed further.

If for any reason the applicant does not file a response to an objection, the objector will prevail by default.

### *3.2.5 Independent Objector*

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A formal objection to a gTLD application may also be filed by the Independent Objector (IO). The IO does not act on behalf of any particular persons or entities, but acts solely in the best interests of the public who use the global Internet.

In light of this public interest goal, the Independent Objector is limited to filing objections on the grounds of Limited Public Interest and Community.

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<sup>3</sup> See <http://www.icann.org/en/announcements/announcement-21dec07.htm>.

Neither ICANN staff nor the ICANN Board of Directors has authority to direct or require the IO to file or not file any particular objection. If the IO determines that an objection should be filed, he or she will initiate and prosecute the objection in the public interest.

**Mandate and Scope** - The IO may file objections against “highly objectionable” gTLD applications to which no objection has been filed. The IO is limited to filing two types of objections: (1) Limited Public Interest objections and (2) Community objections. The IO is granted standing to file objections on these enumerated grounds, notwithstanding the regular standing requirements for such objections (see subsection 3.1.2).

The IO may file a Limited Public Interest objection against an application even if a Community objection has been filed, and vice versa.

The IO may file an objection against an application, notwithstanding the fact that a String Confusion objection or a Legal Rights objection was filed.

Absent extraordinary circumstances, the IO is not permitted to file an objection to an application where an objection has already been filed on the same ground.

The IO may consider public comment when making an independent assessment whether an objection is warranted. The IO will have access to application comments received during the comment period.

In light of the public interest goal noted above, the IO shall not object to an application unless at least one comment in opposition to the application is made in the public sphere.

**Selection** – The IO will be selected by ICANN, through an open and transparent process, and retained as an independent consultant. The Independent Objector will be an individual with considerable experience and respect in the Internet community, unaffiliated with any gTLD applicant.

Although recommendations for IO candidates from the community are welcomed, the IO must be and remain independent and unaffiliated with any of the gTLD applicants. The various rules of ethics for judges and international arbitrators provide models for the IO to declare and maintain his/her independence.

The IO's (renewable) tenure is limited to the time necessary to carry out his/her duties in connection with a single round of gTLD applications.

**Budget and Funding** – The IO's budget would comprise two principal elements: (a) salaries and operating expenses, and (b) dispute resolution procedure costs – both of which should be funded from the proceeds of new gTLD applications.

As an objector in dispute resolution proceedings, the IO is required to pay filing and administrative fees, as well as advance payment of costs, just as all other objectors are required to do. Those payments will be refunded by the DRSP in cases where the IO is the prevailing party.

In addition, the IO will incur various expenses in presenting objections before DRSP panels that will not be refunded, regardless of the outcome. These expenses include the fees and expenses of outside counsel (if retained) and the costs of legal research or factual investigations.

### **3.3 Filing Procedures**

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The information included in this section provides a summary of procedures for filing:

- Objections; and
- Responses to objections.

For a comprehensive statement of filing requirements applicable generally, refer to the New gTLD Dispute Resolution Procedure ("Procedure") included as an attachment to this module. In the event of any discrepancy between the information presented in this module and the Procedure, the Procedure shall prevail.

Note that the rules and procedures of each DRSP specific to each objection ground must also be followed. See <http://newgtlds.icann.org/en/program-status/objection-dispute-resolution>.

#### **3.3.1 Objection Filing Procedures**

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The procedures outlined in this subsection must be followed by any party wishing to file a formal objection to an application that has been posted by ICANN. Should an applicant wish to file a formal objection to another gTLD application, it would follow these same procedures.

- All objections must be filed electronically with the appropriate DRSP by the posted deadline date.

Objections will not be accepted by the DRSPs after this date.

- All objections must be filed in English.
- Each objection must be filed separately. An objector wishing to object to several applications must file a separate objection and pay the accompanying filing fees for each application that is the subject of an objection. If an objector wishes to object to an application on more than one ground, the objector must file separate objections and pay the accompanying filing fees for each objection ground.

Each objection filed by an objector must include:

- The name and contact information of the objector.
- A statement of the objector's basis for standing; that is, why the objector believes it meets the standing requirements to object.
- A description of the basis for the objection, including:
  - A statement giving the specific ground upon which the objection is being filed.
  - A detailed explanation of the validity of the objection and why it should be upheld.
- Copies of any documents that the objector considers to be a basis for the objection.

Objections are limited to 5000 words or 20 pages, whichever is less, excluding attachments.

An objector must provide copies of all submissions to the DRSP associated with the objection proceedings to the applicant.

The DRSP will publish, and regularly update a list on its website identifying all objections as they are filed. ICANN will post on its website a notice of all objections filed once the objection filing period has closed.

### ***3.3.2 Objection Filing Fees***

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At the time an objection is filed, the objector is required to pay a filing fee in the amount set and published by the relevant DRSP. If the filing fee is not paid, the DRSP will

dismiss the objection without prejudice. See Section 1.5 of Module 1 regarding fees.

Funding from ICANN for objection filing fees, as well as for advance payment of costs (see subsection 3.4.7 below) is available to the At-Large Advisory Committee (ALAC). Funding for ALAC objection filing and dispute resolution fees is contingent on publication by ALAC of its approved process for considering and making objections. At a minimum, the process for objecting to a gTLD application will require: bottom-up development of potential objections, discussion and approval of objections at the Regional At-Large Organization (RALO) level, and a process for consideration and approval of the objection by the At-Large Advisory Committee.

Funding from ICANN for objection filing fees, as well as for advance payment of costs, is available to individual national governments in the amount of USD 50,000 with the guarantee that a minimum of one objection per government will be fully funded by ICANN where requested. ICANN will develop a procedure for application and disbursement of funds.

Funding available from ICANN is to cover costs payable to the dispute resolution service provider and made directly to the dispute resolution service provider; it does not cover other costs such as fees for legal advice.

### **3.3.3 Response Filing Procedures**

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Upon notification that ICANN has published the list of all objections filed (refer to subsection 3.3.1), the DRSPs will notify the parties that responses must be filed within 30 calendar days of receipt of that notice. DRSPs will not accept late responses. Any applicant that fails to respond to an objection within the 30-day response period will be in default, which will result in the objector prevailing.

- All responses must be filed in English.
- Each response must be filed separately. That is, an applicant responding to several objections must file a separate response and pay the accompanying filing fee to respond to each objection.
- Responses must be filed electronically.

Each response filed by an applicant must include:

- The name and contact information of the applicant.



- A point-by-point response to the claims made by the objector.
- Any copies of documents that it considers to be a basis for the response.

Responses are limited to 5000 words or 20 pages, whichever is less, excluding attachments.

Each applicant must provide copies of all submissions to the DRSP associated with the objection proceedings to the objector.

### ***3.3.4 Response Filing Fees***

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At the time an applicant files its response, it is required to pay a filing fee in the amount set and published by the relevant DRSP, which will be the same as the filing fee paid by the objector. If the filing fee is not paid, the response will be disregarded, which will result in the objector prevailing.

## ***3.4 Objection Processing Overview***

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The information below provides an overview of the process by which DRSPs administer dispute proceedings that have been initiated. For comprehensive information, please refer to the New gTLD Dispute Resolution Procedure (included as an attachment to this module).

### ***3.4.1 Administrative Review***

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Each DRSP will conduct an administrative review of each objection for compliance with all procedural rules within 14 calendar days of receiving the objection. Depending on the number of objections received, the DRSP may ask ICANN for a short extension of this deadline.

If the DRSP finds that the objection complies with procedural rules, the objection will be deemed filed, and the proceedings will continue. If the DRSP finds that the objection does not comply with procedural rules, the DRSP will dismiss the objection and close the proceedings without prejudice to the objector's right to submit a new objection that complies with procedural rules. The DRSP's review or rejection of the objection will not interrupt the time limit for filing an objection.

### ***3.4.2 Consolidation of Objections***

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Once the DRSP receives and processes all objections, at its discretion the DRSP may elect to consolidate certain objections. The DRSP shall endeavor to decide upon

consolidation prior to issuing its notice to applicants that the response should be filed and, where appropriate, shall inform the parties of the consolidation in that notice.

An example of a circumstance in which consolidation might occur is multiple objections to the same application based on the same ground.

In assessing whether to consolidate objections, the DRSP will weigh the efficiencies in time, money, effort, and consistency that may be gained by consolidation against the prejudice or inconvenience consolidation may cause. The DRSPs will endeavor to have all objections resolved on a similar timeline. It is intended that no sequencing of objections will be established.

New gTLD applicants and objectors also will be permitted to propose consolidation of objections, but it will be at the DRSP's discretion whether to agree to the proposal.

ICANN continues to strongly encourage all of the DRSPs to consolidate matters whenever practicable.

### 3.4.3 *Mediation*

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The parties to a dispute resolution proceeding are encouraged—but not required—to participate in mediation aimed at settling the dispute. Each DRSP has experts who can be retained as mediators to facilitate this process, should the parties elect to do so, and the DRSPs will communicate with the parties concerning this option and any associated fees.

If a mediator is appointed, that person may not serve on the panel constituted to issue an expert determination in the related dispute.

There are no automatic extensions of time associated with the conduct of negotiations or mediation. The parties may submit joint requests for extensions of time to the DRSP according to its procedures, and the DRSP or the panel, if appointed, will decide whether to grant the requests, although extensions will be discouraged. Absent exceptional circumstances, the parties must limit their requests for extension to 30 calendar days.

The parties are free to negotiate without mediation at any time, or to engage a mutually acceptable mediator of their own accord.

### **3.4.4 Selection of Expert Panels**

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A panel will consist of appropriately qualified experts appointed to each proceeding by the designated DRSP. Experts must be independent of the parties to a dispute resolution proceeding. Each DRSP will follow its adopted procedures for requiring such independence, including procedures for challenging and replacing an expert for lack of independence.

There will be one expert in proceedings involving a string confusion objection.

There will be one expert, or, if all parties agree, three experts with relevant experience in intellectual property rights disputes in proceedings involving an existing legal rights objection.

There will be three experts recognized as eminent jurists of international reputation, with expertise in relevant fields as appropriate, in proceedings involving a Limited Public Interest objection.

There will be one expert in proceedings involving a community objection.

Neither the experts, the DRSP, ICANN, nor their respective employees, directors, or consultants will be liable to any party in any action for damages or injunctive relief for any act or omission in connection with any proceeding under the dispute resolution procedures.

### **3.4.5 Adjudication**

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The panel may decide whether the parties shall submit any written statements in addition to the filed objection and response, and may specify time limits for such submissions.

In order to achieve the goal of resolving disputes rapidly and at reasonable cost, procedures for the production of documents shall be limited. In exceptional cases, the panel may require a party to produce additional evidence.

Disputes will usually be resolved without an in-person hearing. The panel may decide to hold such a hearing only in extraordinary circumstances.

### **3.4.6 Expert Determination**

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The DRSPs' final expert determinations will be in writing and will include:

- A summary of the dispute and findings;

- An identification of the prevailing party; and
- The reasoning upon which the expert determination is based.

Unless the panel decides otherwise, each DRSP will publish all decisions rendered by its panels in full on its website.

The findings of the panel will be considered an expert determination and advice that ICANN will accept within the dispute resolution process.

### **3.4.7 Dispute Resolution Costs**

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Before acceptance of objections, each DRSP will publish a schedule of costs or statement of how costs will be calculated for the proceedings that it administers under this procedure. These costs cover the fees and expenses of the members of the panel and the DRSP's administrative costs.

ICANN expects that string confusion and legal rights objection proceedings will involve a fixed amount charged by the panelists while Limited Public Interest and community objection proceedings will involve hourly rates charged by the panelists.

Within ten (10) calendar days of constituting the panel, the DRSP will estimate the total costs and request advance payment in full of its costs from both the objector and the applicant. Each party must make its advance payment within ten (10) calendar days of receiving the DRSP's request for payment and submit to the DRSP evidence of such payment. The respective filing fees paid by the parties will be credited against the amounts due for this advance payment of costs.

The DRSP may revise its estimate of the total costs and request additional advance payments from the parties during the resolution proceedings.

Additional fees may be required in specific circumstances; for example, if the DRSP receives supplemental submissions or elects to hold a hearing.

If an objector fails to pay these costs in advance, the DRSP will dismiss its objection and no fees paid by the objector will be refunded.

If an applicant fails to pay these costs in advance, the DSRP will sustain the objection and no fees paid by the applicant will be refunded.

After the hearing has taken place and the panel renders its expert determination, the DRSP will refund the advance payment of costs to the prevailing party.

### ***3.5 Dispute Resolution Principles (Standards)***

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Each panel will use appropriate general principles (standards) to evaluate the merits of each objection. The principles for adjudication on each type of objection are specified in the paragraphs that follow. The panel may also refer to other relevant rules of international law in connection with the standards.

The objector bears the burden of proof in each case.

The principles outlined below are subject to evolution based on ongoing consultation with DRSPs, legal experts, and the public.

#### ***3.5.1 String Confusion Objection***

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A DRSP panel hearing a string confusion objection will consider whether the applied-for gTLD string is likely to result in string confusion. String confusion exists where a string so nearly resembles another that it is likely to deceive or cause confusion. For a likelihood of confusion to exist, it must be probable, not merely possible that confusion will arise in the mind of the average, reasonable Internet user. Mere association, in the sense that the string brings another string to mind, is insufficient to find a likelihood of confusion.

#### ***3.5.2 Legal Rights Objection***

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In interpreting and giving meaning to GNSO Recommendation 3 (“Strings must not infringe the existing legal rights of others that are recognized or enforceable under generally accepted and internationally recognized principles of law”), a DRSP panel of experts presiding over a legal rights objection will determine whether the potential use of the applied-for gTLD by the applicant takes unfair advantage of the distinctive character or the reputation of the objector’s registered or unregistered trademark or service mark (“mark”) or IGO name or acronym (as identified in the treaty establishing the organization), or unjustifiably impairs the distinctive character or the reputation of the objector’s mark or IGO name or acronym, or otherwise creates an impermissible likelihood of confusion between the applied-for gTLD and the objector’s mark or IGO name or acronym.

In the case where the objection is based on trademark rights, the panel will consider the following non-exclusive factors:

1. Whether the applied-for gTLD is identical or similar, including in appearance, phonetic sound, or meaning, to the objector's existing mark.
2. Whether the objector's acquisition and use of rights in the mark has been bona fide.
3. Whether and to what extent there is recognition in the relevant sector of the public of the sign corresponding to the gTLD, as the mark of the objector, of the applicant or of a third party.
4. Applicant's intent in applying for the gTLD, including whether the applicant, at the time of application for the gTLD, had knowledge of the objector's mark, or could not have reasonably been unaware of that mark, and including whether the applicant has engaged in a pattern of conduct whereby it applied for or operates TLDs or registrations in TLDs which are identical or confusingly similar to the marks of others.
5. Whether and to what extent the applicant has used, or has made demonstrable preparations to use, the sign corresponding to the gTLD in connection with a bona fide offering of goods or services or a bona fide provision of information in a way that does not interfere with the legitimate exercise by the objector of its mark rights.
6. Whether the applicant has marks or other intellectual property rights in the sign corresponding to the gTLD, and, if so, whether any acquisition of such a right in the sign, and use of the sign, has been bona fide, and whether the purported or likely use of the gTLD by the applicant is consistent with such acquisition or use.
7. Whether and to what extent the applicant has been commonly known by the sign corresponding to the gTLD, and if so, whether any purported or likely use of the gTLD by the applicant is consistent therewith and bona fide.
8. Whether the applicant's intended use of the gTLD would create a likelihood of confusion with the objector's mark as to the source, sponsorship, affiliation, or endorsement of the gTLD.

In the case where a legal rights objection has been filed by an IGO, the panel will consider the following non-exclusive factors:

1. Whether the applied-for gTLD is identical or similar, including in appearance, phonetic sound or meaning, to the name or acronym of the objecting IGO;
2. Historical coexistence of the IGO and the applicant's use of a similar name or acronym. Factors considered may include:
  - a. Level of global recognition of both entities;
  - b. Length of time the entities have been in existence;
  - c. Public historical evidence of their existence, which may include whether the objecting IGO has communicated its name or abbreviation under Article 6<sup>ter</sup> of the Paris Convention for the Protection of Industrial Property.
3. Whether and to what extent the applicant has used, or has made demonstrable preparations to use, the sign corresponding to the TLD in connection with a bona fide offering of goods or services or a bona fide provision of information in a way that does not interfere with the legitimate exercise of the objecting IGO's name or acronym;
4. Whether and to what extent the applicant has been commonly known by the sign corresponding to the applied-for gTLD, and if so, whether any purported or likely use of the gTLD by the applicant is consistent therewith and bona fide; and
5. Whether the applicant's intended use of the applied-for gTLD would create a likelihood of confusion with the objecting IGO's name or acronym as to the source, sponsorship, affiliation, or endorsement of the TLD.

### ***3.5.3 Limited Public Interest Objection***

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An expert panel hearing a Limited Public Interest objection will consider whether the applied-for gTLD string is contrary to general principles of international law for morality and public order.

Examples of instruments containing such general principles include:

- The Universal Declaration of Human Rights (UDHR)

- The International Covenant on Civil and Political Rights (ICCPR)
- The Convention on the Elimination of All Forms of Discrimination Against Women (CEDAW)
- The International Convention on the Elimination of All Forms of Racial Discrimination
- Declaration on the Elimination of Violence against Women
- The International Covenant on Economic, Social, and Cultural Rights
- The Convention against Torture and Other Cruel, Inhuman, or Degrading Treatment or Punishment
- The International Convention on the Protection of the Rights of all Migrant Workers and Members of their Families
- Slavery Convention
- Convention on the Prevention and Punishment of the Crime of Genocide
- Convention on the Rights of the Child

Note that these are included to serve as examples, rather than an exhaustive list. It should be noted that these instruments vary in their ratification status. Additionally, states may limit the scope of certain provisions through reservations and declarations indicating how they will interpret and apply certain provisions. National laws not based on principles of international law are not a valid ground for a Limited Public Interest objection.

Under these principles, everyone has the right to freedom of expression, but the exercise of this right carries with it special duties and responsibilities. Accordingly, certain limited restrictions may apply.

The grounds upon which an applied-for gTLD string may be considered contrary to generally accepted legal norms relating to morality and public order that are recognized under principles of international law are:

- Incitement to or promotion of violent lawless action;
- Incitement to or promotion of discrimination based upon race, color, gender, ethnicity, religion or national origin, or other similar types of



discrimination that violate generally accepted legal norms recognized under principles of international law;

- Incitement to or promotion of child pornography or other sexual abuse of children; or
- A determination that an applied-for gTLD string would be contrary to specific principles of international law as reflected in relevant international instruments of law.

The panel will conduct its analysis on the basis of the applied-for gTLD string itself. The panel may, if needed, use as additional context the intended purpose of the TLD as stated in the application.

### 3.5.4 *Community Objection*

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The four tests described here will enable a DRSP panel to determine whether there is substantial opposition from a significant portion of the community to which the string may be targeted. For an objection to be successful, the objector must prove that:

- The community invoked by the objector is a clearly delineated community; and
- Community opposition to the application is substantial; and
- There is a strong association between the community invoked and the applied-for gTLD string; and
- The application creates a likelihood of material detriment to the rights or legitimate interests of a significant portion of the community to which the string may be explicitly or implicitly targeted. Each of these tests is described in further detail below.

**Community** – The objector must prove that the community expressing opposition can be regarded as a clearly delineated community. A panel could balance a number of factors to determine this, including but not limited to:

- The level of public recognition of the group as a community at a local and/or global level;
- The level of formal boundaries around the community and what persons or entities are considered to form the community;

- The length of time the community has been in existence;
- The global distribution of the community (this may not apply if the community is territorial); and
- The number of people or entities that make up the community.

If opposition by a number of people/entities is found, but the group represented by the objector is not determined to be a clearly delineated community, the objection will fail.

**Substantial Opposition** – The objector must prove substantial opposition within the community it has identified itself as representing. A panel could balance a number of factors to determine whether there is substantial opposition, including but not limited to:

- Number of expressions of opposition relative to the composition of the community;
- The representative nature of entities expressing opposition;
- Level of recognized stature or weight among sources of opposition;
- Distribution or diversity among sources of expressions of opposition, including:
  - Regional
  - Subsectors of community
  - Leadership of community
  - Membership of community
- Historical defense of the community in other contexts; and
- Costs incurred by objector in expressing opposition, including other channels the objector may have used to convey opposition.

If some opposition within the community is determined, but it does not meet the standard of substantial opposition, the objection will fail.

**Targeting** – The objector must prove a strong association between the applied-for gTLD string and the community represented by the objector. Factors that could be

balanced by a panel to determine this include but are not limited to:

- Statements contained in application;
- Other public statements by the applicant;
- Associations by the public.

If opposition by a community is determined, but there is no strong association between the community and the applied-for gTLD string, the objection will fail.

**Detriment** – The objector must prove that the application creates a likelihood of material detriment to the rights or legitimate interests of a significant portion of the community to which the string may be explicitly or implicitly targeted. An allegation of detriment that consists only of the applicant being delegated the string instead of the objector will not be sufficient for a finding of material detriment.

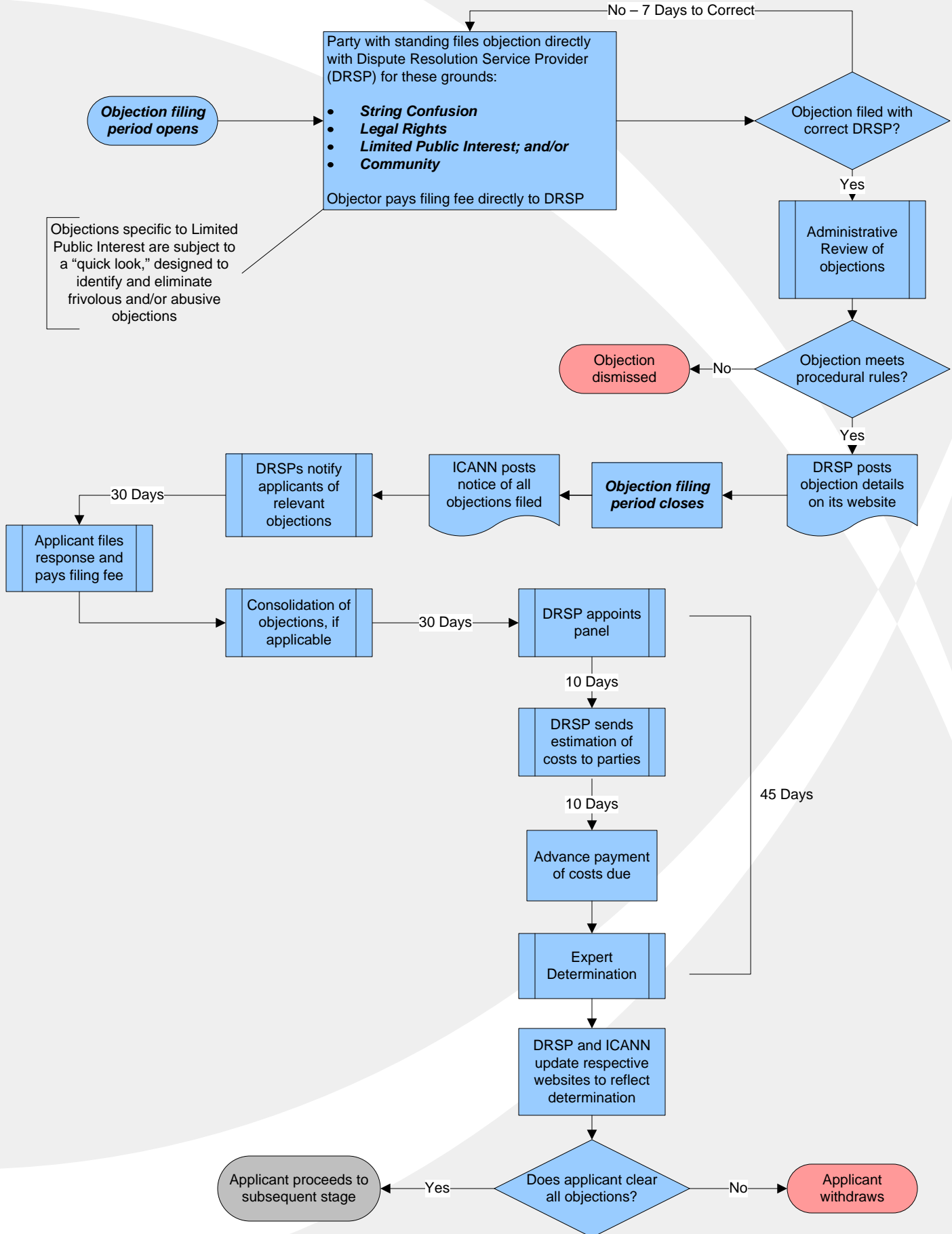
Factors that could be used by a panel in making this determination include but are not limited to:

- Nature and extent of damage to the reputation of the community represented by the objector that would result from the applicant's operation of the applied-for gTLD string;
- Evidence that the applicant is not acting or does not intend to act in accordance with the interests of the community or of users more widely, including evidence that the applicant has not proposed or does not intend to institute effective security protection for user interests;
- Interference with the core activities of the community that would result from the applicant's operation of the applied-for gTLD string;
- Dependence of the community represented by the objector on the DNS for its core activities;
- Nature and extent of concrete or economic damage to the community represented by the objector that would result from the applicant's operation of the applied-for gTLD string; and
- Level of certainty that alleged detrimental outcomes would occur.

If opposition by a community is determined, but there is no likelihood of material detriment to the targeted community resulting from the applicant's operation of the applied-for gTLD, the objection will fail.

The objector must meet all four tests in the standard for the objection to prevail.

# DRAFT - New gTLD Program – Objection and Dispute Resolution



## **Annex 3**

# **ICANN New gTLD Dispute Resolution Procedure**

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# *Attachment to Module 3*

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## *New gTLD Dispute Resolution Procedure*

These Procedures were designed with an eye toward timely and efficient dispute resolution. As part of the New gTLD Program, these Procedures apply to all proceedings administered by each of the dispute resolution service providers (DRSP). Each of the DRSPs has a specific set of rules that will also apply to such proceedings.

## NEW gTLD DISPUTE RESOLUTION PROCEDURE

### Article 1. ICANN's New gTLD Program

- (a) The Internet Corporation for Assigned Names and Numbers ("ICANN") has implemented a program for the introduction of new generic Top-Level Domain Names ("gTLDs") in the internet. There will be a succession of rounds, during which applicants may apply for new gTLDs, in accordance with terms and conditions set by ICANN.
- (b) The new gTLD program includes a dispute resolution procedure, pursuant to which disputes between a person or entity who applies for a new gTLD and a person or entity who objects to that gTLD are resolved in accordance with this New gTLD Dispute Resolution Procedure (the "Procedure").
- (c) Dispute resolution proceedings shall be administered by a Dispute Resolution Service Provider ("DRSP") in accordance with this Procedure and the applicable DRSP Rules that are identified in Article 4(b).
- (d) By applying for a new gTLD, an applicant accepts the applicability of this Procedure and the applicable DRSP's Rules that are identified in Article 4(b); by filing an objection to a new gTLD, an objector accepts the applicability of this Procedure and the applicable DRSP's Rules that are identified in Article 4(b). The parties cannot derogate from this Procedure without the express approval of ICANN and from the applicable DRSP Rules without the express approval of the relevant DRSP.

### Article 2. Definitions

- (a) The "Applicant" or "Respondent" is an entity that has applied to ICANN for a new gTLD and that will be the party responding to the Objection.
- (b) The "Objector" is one or more persons or entities who have filed an objection against a new gTLD for which an application has been submitted.
- (c) The "Panel" is the panel of Experts, comprising one or three "Experts," that has been constituted by a DRSP in accordance with this Procedure and the applicable DRSP Rules that are identified in Article 4(b).
- (d) The "Expert Determination" is the decision upon the merits of the Objection that is rendered by a Panel in a proceeding conducted under this Procedure and the applicable DRSP Rules that are identified in Article 4(b).
- (e) The grounds upon which an objection to a new gTLD may be filed are set out in full in Module 3 of the Applicant Guidebook. Such grounds are identified in this Procedure, and are based upon the Final Report on the Introduction of New Generic Top-Level Domains, dated 7 August 2007, issued by the ICANN Generic Names Supporting Organization (GNSO), as follows:
  - (i) "String Confusion Objection" refers to the objection that the string comprising the potential gTLD is confusingly similar to an existing top-level domain or another string applied for in the same round of applications.
  - (ii) "Existing Legal Rights Objection" refers to the objection that the string comprising the potential new gTLD infringes the existing legal rights of others



that are recognized or enforceable under generally accepted and internationally recognized principles of law.

- (iii) "Limited Public Interest Objection" refers to the objection that the string comprising the potential new gTLD is contrary to generally accepted legal norms relating to morality and public order that are recognized under principles of international law.
- (iv) "Community Objection" refers to the objection that there is substantial opposition to the application from a significant portion of the community to which the string may be explicitly or implicitly targeted.
- (f) "DRSP Rules" are the rules of procedure of a particular DRSP that have been identified as being applicable to objection proceedings under this Procedure.

### **Article 3. Dispute Resolution Service Providers**

The various categories of disputes shall be administered by the following DRSPs:

- (a) String Confusion Objections shall be administered by the International Centre for Dispute Resolution.
- (b) Existing Legal Rights Objections shall be administered by the Arbitration and Mediation Center of the World Intellectual Property Organization.
- (c) Limited Public Interest Objections shall be administered by the International Centre for Expertise of the International Chamber of Commerce.
- (d) Community Objections shall be administered by the International Centre for Expertise of the International Chamber of Commerce.

### **Article 4. Applicable Rules**

- (a) All proceedings before the Panel shall be governed by this Procedure and by the DRSP Rules that apply to a particular category of objection. The outcome of the proceedings shall be deemed an Expert Determination, and the members of the Panel shall act as experts.
- (b) The applicable DRSP Rules are the following:
  - (i) For a String Confusion Objection, the applicable DRSP Rules are the ICDR Supplementary Procedures for ICANN's New gTLD Program.
  - (ii) For an Existing Legal Rights Objection, the applicable DRSP Rules are the WIPO Rules for New gTLD Dispute Resolution.
  - (iii) For a Limited Public Interest Objection, the applicable DRSP Rules are the Rules for Expertise of the International Chamber of Commerce (ICC), as supplemented by the ICC as needed.
  - (iv) For a Community Objection, the applicable DRSP Rules are the Rules for Expertise of the International Chamber of Commerce (ICC), as supplemented by the ICC as needed.
- (c) In the event of any discrepancy between this Procedure and the applicable DRSP Rules, this Procedure shall prevail.

- (d) The place of the proceedings, if relevant, shall be the location of the DRSP that is administering the proceedings.
- (e) In all cases, the Panel shall ensure that the parties are treated with equality, and that each party is given a reasonable opportunity to present its position.

#### **Article 5. Language**

- (a) The language of all submissions and proceedings under this Procedure shall be English.
- (b) Parties may submit supporting evidence in its original language, provided and subject to the authority of the Panel to determine otherwise, that such evidence is accompanied by a certified or otherwise official English translation of all relevant text.

#### **Article 6. Communications and Time Limits**

- (a) All communications by the Parties with the DRSPs and Panels must be submitted electronically. A Party that wishes to make a submission that is not available in electronic form (e.g., evidentiary models) shall request leave from the Panel to do so, and the Panel, in its sole discretion, shall determine whether to accept the non-electronic submission.
- (b) The DRSP, Panel, Applicant, and Objector shall provide copies to one another of all correspondence (apart from confidential correspondence between the Panel and the DRSP and among the Panel) regarding the proceedings.
- (c) For the purpose of determining the date of commencement of a time limit, a notice or other communication shall be deemed to have been received on the day that it is transmitted in accordance with paragraphs (a) and (b) of this Article.
- (d) For the purpose of determining compliance with a time limit, a notice or other communication shall be deemed to have been sent, made or transmitted if it is dispatched in accordance with paragraphs (a) and (b) of this Article prior to or on the day of the expiration of the time limit.
- (e) For the purpose of calculating a period of time under this Procedure, such period shall begin to run on the day following the day when a notice or other communication is received.
- (f) Unless otherwise stated, all time periods provided in the Procedure are calculated on the basis of calendar days

#### **Article 7. Filing of the Objection**

- (a) A person wishing to object to a new gTLD for which an application has been submitted may file an objection ("Objection"). Any Objection to a proposed new gTLD must be filed before the published closing date for the Objection Filing period.
- (b) The Objection must be filed with the appropriate DRSP, using a model form made available by that DRSP, with copies to ICANN and the Applicant.
- (c) The electronic addresses for filing Objections (the specific addresses shall be made available once they are created by providers):
  - (i) A String Confusion Objection must be filed at: [●].

- (ii) An Existing Legal Rights Objection must be filed at: [●].
  - (iii) A Limited Public Interest Objection must be filed at: [●].
  - (iv) A Community Objection must be filed at: [●].
- (d) All Objections must be filed separately:
- (i) An Objector who wishes to object to an application on more than one ground must file separate objections with the appropriate DRSP(s).
  - (ii) An Objector who wishes to object to more than one gTLD must file separate objections to each gTLD with the appropriate DRSP(s).
- (e) If an Objection is filed with the wrong DRSP, that DRSP shall promptly notify the Objector of the error and that DRSP shall not process the incorrectly filed Objection. The Objector may then cure the error by filing its Objection with the correct DRSP within seven (7) days of receipt of the error notice, failing which the Objection shall be disregarded. If the Objection is filed with the correct DRSP within seven (7) days of receipt of the error notice but after the lapse of the time for submitting an Objection stipulation by Article 7(a) of this Procedure, it shall be deemed to be within this time limit.

## **Article 8. Content of the Objection**

- (a) The Objection shall contain, *inter alia*, the following information:
- (i) The names and contact information (address, telephone number, email address, etc.) of the Objector;
  - (ii) A statement of the Objector's basis for standing; and
  - (iii) A description of the basis for the Objection, including:
    - (aa) A statement of the ground upon which the Objection is being filed, as stated in Article 2(e) of this Procedure;
    - (bb) An explanation of the validity of the Objection and why the objection should be upheld.
- (b) The substantive portion of the Objection shall be limited to 5,000 words or 20 pages, whichever is less, excluding attachments. The Objector shall also describe and provide copies of any supporting or official documents upon which the Objection is based.
- (c) At the same time as the Objection is filed, the Objector shall pay a filing fee in the amount set in accordance with the applicable DRSP Rules and include evidence of such payment in the Objection. In the event that the filing fee is not paid within ten (10) days of the receipt of the Objection by the DRSP, the Objection shall be dismissed without prejudice.

## **Article 9. Administrative Review of the Objection**

- (a) The DRSP shall conduct an administrative review of the Objection for the purpose of verifying compliance with Articles 5-8 of this Procedure and the applicable DRSP Rules, and inform the Objector, the Applicant and ICANN of the result of its review within

fourteen (14) days of its receipt of the Objection. The DRSP may extend this time limit for reasons explained in the notification of such extension.

- (b) If the DRSP finds that the Objection complies with Articles 5-8 of this Procedure and the applicable DRSP Rules, the DRSP shall confirm that the Objection shall be registered for processing.
- (c) If the DRSP finds that the Objection does not comply with Articles 5-8 of this Procedure and the applicable DRSP Rules, the DRSP shall have the discretion to request that any administrative deficiencies in the Objection be corrected within five (5) days. If the deficiencies in the Objection are cured within the specified period but after the lapse of the time limit for submitting an Objection stipulated by Article 7(a) of this Procedure, the Objection shall be deemed to be within this time limit.
- (d) If the DRSP finds that the Objection does not comply with Articles 5-8 of this Procedure and the applicable DRSP Rules, and the deficiencies in the Objection are not corrected within the period specified in Article 9(c), the DRSP shall dismiss the Objection and close the proceedings, without prejudice to the Objector's submission of a new Objection that complies with this Procedure, provided that the Objection is filed within the deadline for filing such Objections. The DRSP's review of the Objection shall not interrupt the running of the time limit for submitting an Objection stipulated by Article 7(a) of this Procedure.
- (e) Immediately upon registering an Objection for processing, pursuant to Article 9(b), the DRSP shall post the following information about the Objection on its website: (i) the proposed string to which the Objection is directed; (ii) the names of the Objector and the Applicant; (iii) the grounds for the Objection; and (iv) the dates of the DRSP's receipt of the Objection.

## **Article 10. ICANN's Dispute Announcement**

- (a) Within thirty (30) days of the deadline for filing Objections in relation to gTLD applications in a given round, ICANN shall publish a document on its website identifying all of the admissible Objections that have been filed (the "Dispute Announcement"). ICANN shall also directly inform each DRSP of the posting of the Dispute Announcement.
- (b) ICANN shall monitor the progress of all proceedings under this Procedure and shall take steps, where appropriate, to coordinate with any DRSP in relation to individual applications for which objections are pending before more than one DRSP.

## **Article 11. Response to the Objection**

- (a) Upon receipt of the Dispute Announcement, each DRSP shall promptly send a notice to: (i) each Applicant for a new gTLD to which one or more admissible Objections have been filed with that DRSP; and (ii) the respective Objector(s).
- (b) The Applicant shall file a response to each Objection (the "Response"). The Response shall be filed within thirty (30) days of the transmission of the notice by the DRSP pursuant to Article 11(a).
- (c) The Response must be filed with the appropriate DRSP, using a model form made available by that DRSP, with copies to ICANN and the Objector.

- (d) The Response shall contain, inter alia, the following information:
  - (i) The names and contact information (address, telephone number, email address, etc.) of the Applicant; and
  - (ii) A point-by-point response to the statements made in the Objection.
- (e) The substantive portion of the Response shall be limited to 5,000 words or 20 pages, whichever is less, excluding attachments. The Applicant shall also describe and provide copies of any supporting or official documents upon which the Response is based.
- (f) At the same time as the Response is filed, the Applicant shall pay a filing fee in the amount set and published by the relevant DRSP (which shall be the same as the filing fee paid by the Objector) and include evidence of such payment in the Response. In the event that the filing fee is not paid within ten (10) days of the receipt of the Response by the DRSP, the Applicant shall be deemed to be in default, any Response disregarded and the Objection shall be deemed successful.
- (g) If the DRSP finds that the Response does not comply with Articles 11(c) and (d)(1) of this Procedure and the applicable DRSP Rules, the DRSP shall have the discretion to request that any administrative deficiencies in the Response be corrected within five (5) days. If the administrative deficiencies in the Response are cured within the specified period but after the lapse of the time limit for submitting a Response pursuant to this Procedure, the Response shall be deemed to be within this time limit.
- (g) If the Applicant fails to file a Response to the Objection within the 30-day time limit, the Applicant shall be deemed to be in default and the Objection shall be deemed successful. No fees paid by the Applicant will be refunded in case of default.

## **Article 12. Consolidation of Objections**

- (a) The DRSP is encouraged, whenever possible and practicable, and as may be further stipulated in the applicable DRSP Rules, to consolidate Objections, for example, when more than one Objector has filed an Objection to the same gTLD on the same grounds. The DRSP shall endeavor to decide upon consolidation prior to issuing its notice pursuant to Article 11(a) and, where appropriate, shall inform the parties of the consolidation in that notice.
- (b) If the DRSP itself has not decided to consolidate two or more Objections, any Applicant or Objector may propose the consolidation of Objections within seven (7) days of the notice given by the DRSP pursuant to Article 11(a). If, following such a proposal, the DRSP decides to consolidate certain Objections, which decision must be made within 14 days of the notice given by the DRSP pursuant to Article 11(a), the deadline for the Applicant's Response in the consolidated proceeding shall be thirty (30) days from the Applicant's receipt of the DRSP's notice of consolidation.
- (c) In deciding whether to consolidate Objections, the DRSP shall weigh the benefits (in terms of time, cost, consistency of decisions, etc.) that may result from the consolidation against the possible prejudice or inconvenience that the consolidation may cause. The DRSP's determination on consolidation shall be final and not subject to appeal.
- (d) Objections based upon different grounds, as summarized in Article 2(e), shall not be consolidated.

### **Article 13. The Panel**

- (a) The DRSP shall select and appoint the Panel of Expert(s) within thirty (30) days after receiving the Response.
- (b) Number and specific qualifications of Expert(s):
  - (i) There shall be one Expert in proceedings involving a String Confusion Objection.
  - (ii) There shall be one Expert or, if all of the Parties so agree, three Experts with relevant experience in intellectual property rights disputes in proceedings involving an Existing Legal Rights Objection.
  - (iii) There shall be three Experts recognized as eminent jurists of international reputation, one of whom shall be designated as the Chair. The Chair shall be of a nationality different from the nationalities of the Applicant and of the Objector, in proceedings involving a Limited Public Interest Objection.
  - (iv) There shall be one Expert in proceedings involving a Community Objection.
- (c) All Experts acting under this Procedure shall be impartial and independent of the parties. The applicable DRSP Rules stipulate the manner by which each Expert shall confirm and maintain their impartiality and independence.
- (d) The applicable DRSP Rules stipulate the procedures for challenging an Expert and replacing an Expert.
- (e) Unless required by a court of law or authorized in writing by the parties, an Expert shall not act in any capacity whatsoever, in any pending or future proceedings, whether judicial, arbitral or otherwise, relating to the matter referred to expert determination under this Procedure.

### **Article 14. Costs**

- (a) Each DRSP shall determine the costs for the proceedings that it administers under this Procedure in accordance with the applicable DRSP Rules. Such costs shall cover the fees and expenses of the members of the Panel, as well as the administrative fees of the DRSP (the "Costs").
- (b) Within ten (10) days of constituting the Panel, the DRSP shall estimate the total Costs and request the Objector and the Applicant/Respondent each to pay in advance the full amount of the Costs to the DRSP. Each party shall make its advance payment of Costs within ten (10) days of receiving the DRSP's request for payment and submit to the DRSP evidence of such payment. The respective filing fees paid by the Parties shall be credited against the amounts due for this advance payment of Costs.
- (c) The DRSP may revise its estimate of the total Costs and request additional advance payments from the parties during the proceedings.
- (d) Failure to make an advance payment of Costs:
  - (i) If the Objector fails to make the advance payment of Costs, its Objection shall be dismissed and no fees that it has paid shall be refunded.

- (ii) If the Applicant fails to make the advance payment of Costs, the Objection will be deemed to have been sustained and no fees that the Applicant has paid shall be refunded.
- (e) Upon the termination of the proceedings, after the Panel has rendered its Expert Determination, the DRSP shall refund to the prevailing party, as determined by the Panel, its advance payment(s) of Costs.

### **Article 15. Representation and Assistance**

- (a) The parties may be represented or assisted by persons of their choice.
- (b) Each party or party representative shall communicate the name, contact information and function of such persons to the DRSP and the other party (or parties in case of consolidation).

### **Article 16. Negotiation and Mediation**

- (a) The parties are encouraged, but not required, to participate in negotiations and/or mediation at any time throughout the dispute resolution process aimed at settling their dispute amicably.
- (b) Each DRSP shall be able to propose, if requested by the parties, a person who could assist the parties as mediator.
- (c) A person who acts as mediator for the parties shall not serve as an Expert in a dispute between the parties under this Procedure or any other proceeding under this Procedure involving the same gTLD.
- (d) The conduct of negotiations or mediation shall not, *ipso facto*, be the basis for a suspension of the dispute resolution proceedings or the extension of any deadline under this Procedure. Upon the joint request of the parties, the DRSP or (after it has been constituted) the Panel may grant the extension of a deadline or the suspension of the proceedings. Absent exceptional circumstances, such extension or suspension shall not exceed thirty (30) days and shall not delay the administration of any other Objection.
- (e) If, during negotiations and/or mediation, the parties agree on a settlement of the matter referred to the DRSP under this Procedure, the parties shall inform the DRSP, which shall terminate the proceedings, subject to the parties' payment obligation under this Procedure having been satisfied, and inform ICANN and the parties accordingly.

### **Article 17. Additional Written Submissions**

- (a) The Panel may decide whether the parties shall submit any written statements in addition to the Objection and the Response, and it shall fix time limits for such submissions.
- (b) The time limits fixed by the Panel for additional written submissions shall not exceed thirty (30) days, unless the Panel, having consulted the DRSP, determines that exceptional circumstances justify a longer time limit.

## **Article 18. Evidence**

In order to achieve the goal of resolving disputes over new gTLDs rapidly and at reasonable cost, procedures for the production of documents shall be limited. In exceptional cases, the Panel may require a party to provide additional evidence.

## **Article 19. Hearings**

- (a) Disputes under this Procedure and the applicable DRSP Rules will usually be resolved without a hearing.
- (b) The Panel may decide, on its own initiative or at the request of a party, to hold a hearing only in extraordinary circumstances.
- (c) In the event that the Panel decides to hold a hearing:
  - (i) The Panel shall decide how and where the hearing shall be conducted.
  - (ii) In order to expedite the proceedings and minimize costs, the hearing shall be conducted by videoconference if possible.
  - (iii) The hearing shall be limited to one day, unless the Panel decides, in exceptional circumstances, that more than one day is required for the hearing.
  - (iv) The Panel shall decide whether the hearing will be open to the public or conducted in private.

## **Article 20. Standards**

- (a) For each category of Objection identified in Article 2(e), the Panel shall apply the standards that have been defined by ICANN.
- (b) In addition, the Panel may refer to and base its findings upon the statements and documents submitted and any rules or principles that it determines to be applicable.
- (c) The Objector bears the burden of proving that its Objection should be sustained in accordance with the applicable standards.

## **Article 21. The Expert Determination**

- (a) The DRSP and the Panel shall make reasonable efforts to ensure that the Expert Determination is rendered within forty-five (45) days of the constitution of the Panel. In specific circumstances such as consolidated cases and in consultation with the DRSP, if significant additional documentation is requested by the Panel, a brief extension may be allowed.
- (b) The Panel shall submit its Expert Determination in draft form to the DRSP's scrutiny as to form before it is signed, unless such scrutiny is specifically excluded by the applicable DRSP Rules. The modifications proposed by the DRSP to the Panel, if any, shall address only the form of the Expert Determination. The signed Expert Determination shall be communicated to the DRSP, which in turn will communicate that Expert Determination to the Parties and ICANN.
- (c) When the Panel comprises three Experts, the Expert Determination shall be made by a majority of the Experts.



- (d) The Expert Determination shall be in writing, shall identify the prevailing party and shall state the reasons upon which it is based. The remedies available to an Applicant or an Objector pursuant to any proceeding before a Panel shall be limited to the success or dismissal of an Objection and to the refund by the DRSP to the prevailing party, as determined by the Panel in its Expert Determination, of its advance payment(s) of Costs pursuant to Article 14(e) of this Procedure and any relevant provisions of the applicable DRSP Rules.
- (e) The Expert Determination shall state the date when it is made, and it shall be signed by the Expert(s). If any Expert fails to sign the Expert Determination, it shall be accompanied by a statement of the reason for the absence of such signature.
- (f) In addition to providing electronic copies of its Expert Determination, the Panel shall provide a signed hard copy of the Expert Determination to the DRSP, unless the DRSP Rules provide for otherwise.
- (g) Unless the Panel decides otherwise, the Expert Determination shall be published in full on the DRSP's website.

## **Article 22. Exclusion of Liability**

In addition to any exclusion of liability stipulated by the applicable DRSP Rules, neither the Expert(s), nor the DRSP and its employees, nor ICANN and its Board members, employees and consultants shall be liable to any person for any act or omission in connection with any proceeding conducted under this Procedure.

## **Article 23. Modification of the Procedure**

- (a) ICANN may from time to time, in accordance with its Bylaws, modify this Procedure.
- (b) The version of this Procedure that is applicable to a dispute resolution proceeding is the version that was in effect on the day when the relevant application for a new gTLD is submitted.

## **Annex 4**

# **WIPO Rules for New gTLD Dispute Resolution for Existing Legal Rights Objections**

**World Intellectual Property Organization  
Rules for New gTLD Dispute Resolution for Existing Legal Rights Objections  
("WIPO Rules for New gTLD Dispute Resolution")**

*(In effect as of June 20, 2011)*

**1. Scope of WIPO Rules for New gTLD Dispute Resolution in Relation to Procedure**

(a) Set out below are the applicable WIPO Rules for New gTLD Dispute Resolution for Existing Legal Rights Objections as referred to in Article 4 of the New gTLD Dispute Resolution Procedure ("Procedure"), provided as an Attachment to Module 3 of the gTLD Applicant Guidebook ("Applicant Guidebook") (v. 2012-01-11) approved by the Internet Corporation for Assigned Names and Numbers ("ICANN") on June 20, 2011 and as updated on January 11, 2012. The WIPO Rules for New gTLD Dispute Resolution are to be read and used in connection with the Procedure which provides the basic framework for the four categories of objections (as referred to in Articles 2 and 4 of the Procedure) arising from Applications under ICANN's New gTLD Program.

(b) The version of the WIPO Rules for New gTLD Dispute Resolution applicable to a proceeding conducted under the Procedure is the version in effect on the day when the relevant Application for a new gTLD is submitted (as referred to in Article 23(b) of the Procedure).

**2. Definitions**

Terms defined in the Procedure shall have the same meaning in the WIPO Rules for New gTLD Dispute Resolution. Words used in the singular shall include the plural and *vice versa* as the context may require.

**3. Communications**

(a) Subject to Article 6 of the Procedure, except where otherwise agreed beforehand with the WIPO Arbitration and Mediation Center ("Center"), and subject to the discretion of any appointed Panel, any submission to the Center or to the Panel shall be made by electronic mail (email) using [lro@wipo.int](mailto:lro@wipo.int).

(b) In the event a party wishes to submit a hard copy or other non-electronic submission prior to Panel appointment, it shall first request leave to do so from the Center; the Center shall, in its sole discretion, then determine whether to accept the non-electronic submission. After Panel appointment, parties are referred to Article 6(a) of the Procedure.

#### **4. Submission of Objection and Response**

(a) In accordance with Articles 7 and 8 of the Procedure, the Objector shall transmit its Objection using the Objection Model Form set out in Annex A hereto and posted on the Center's website and shall comply with the Center's Filing Guidelines set out in Annex B hereto and posted on the Center's website.

(b) In accordance with Article 11 of the Procedure, the Applicant shall transmit its Response using the Response Model Form set out in Annex C hereto and posted on the Center's website and shall comply with the Center's Filing Guidelines set out in Annex B hereto and posted on the Center's website.

#### **5. Center Review of Objections**

(a) In accordance with Article 9 of the Procedure if an Objection is dismissed due to the Objector's failure to remedy an administrative deficiency, there shall be no refund of any DRSP Fee paid by the Objector pursuant to Article 14 of the Procedure and Paragraph 10 of the WIPO Rules for New gTLD Dispute Resolution.

(b) If an Objector submits a new Objection within ten (10) calendar days of closure of a proceeding as provided in Article 9(d) of the Procedure and Paragraph 5(a) of the WIPO Rules for New gTLD Dispute Resolution to remedy an administratively deficient Objection, such new Objection may be accompanied by a request for a DRSP Fee waiver, in whole or in part, for the Center's consideration in its sole discretion.

#### **6. Appointment of Case Manager**

(a) The Center shall advise the parties of the name and contact details of the Case Manager who shall be responsible for all administrative matters relating to the dispute and communications to the Panel.

(b) The Case Manager may provide administrative assistance to the parties or Panel, but shall have no authority to decide matters of a substantive nature concerning the dispute.

#### **7. Consolidation**

(a) In accordance with Article 12 of the Procedure, the Center may, where possible and practicable, and in its sole discretion, decide to consolidate Objections by appointing the same Panel to decide multiple Objections sharing certain commonalities. In the event of consolidation, the Panel shall render an individual Expert Determination for each Objection.

(b) A party may submit a consolidation request pursuant to Article 12(b) of the Procedure, or may oppose any consolidation request submitted. Any such opposition to a consolidation request shall be provided within seven (7) calendar days of the consolidation request. Any consolidation request or opposition thereto shall be limited to 1,500 words in length.

## World Intellectual Property Organization Rules for New gTLD Dispute Resolution

(c) In the case of consolidated Objections, the applicable reduced Panel fees are specified in Annex D hereto and posted on the Center's website.

(d) Pursuant to Article 12 of the Procedure, in weighing the benefits that may result from consolidation against the possible prejudice or inconvenience that consolidation may cause, the Center in reaching its decision concerning consolidation, may take into account, *inter alia*, the following non-exclusive factors:

- (i) Whether the Objections concern the same or similar TLD(s);
- (ii) Whether the same Objector files Objections concerning multiple TLD applications;
- (iii) Whether in any consolidation request, or opposition thereto, the Objector or Applicant relies on single or multiple mark(s);
- (iv) The scope of evidence relied on by an Objector or Applicant in any Objection or application;
- (v) Any other arguments raised in any consolidation request, or opposition thereto;
- (vi) Expert availability to accept appointment.

(e) The Center's decision on any consolidation of multiple Objections for Expert Determination by the same Panel is of an administrative nature and shall be final. The Center shall not be required to state reasons for its decision.

### **8. Panel Appointment Procedures**

(a) The Center will maintain and publish on its website a publicly-available List of Experts who may be available for Panel appointment.

(b) Pursuant to Article 13(b)(ii) of the Procedure, there shall be a single-member Panel unless all the Parties agree to the appointment of a three-member Panel.

(c) In the event of a single-member Panel, the Center shall in its sole discretion appoint a single-member Panel from its List of Experts.

(d) In the event all the Parties agree to the appointment of a three-member Panel, any such agreement shall be communicated to the Center within five (5) calendar days of the Center's receipt of the Response filed in accordance with Article 11 of the Procedure and Paragraph 4(b) of the WIPO Rules for New gTLD Dispute Resolution.

- (i) If Objections are not consolidated, and if the parties have communicated their agreement on the appointment of a three-member Panel, within five (5) days of such communication each party shall separately submit to the Center (notwithstanding Article 6(b) of the Procedure) the names of three (3) candidates from the Center's List of Experts, in the order of their respective preference, for appointment by the Center as a Co-Panelist. In the event none of a party's three (3) candidates is available for appointment as a Co-Panelist, the Center shall appoint the Co-Panelist in its sole discretion.

- (ii) In the event of consolidation in accordance with Paragraph 7 of the WIPO Rules for New gTLD Dispute Resolution, the Objectors or Applicants, as the case may be, shall jointly submit the names of the three (3) candidates from the Center's List of Experts in order of preference (i.e., one list on behalf of all Objector(s) and one list on behalf of all Applicant(s)). If the Objectors or Applicants as the case may be do not jointly agree on and submit the names of three (3) candidates within five (5) calendar days of the parties' communication to the Center on their agreement to the appointment of a three-member Panel, the Center shall in its sole discretion appoint the Co-Panelist.
- (iii) The third Panelist, who shall be the Presiding Panelist, shall absent exceptional circumstances be appointed by the Center from a list of five (5) candidates submitted by the Center to the parties. The Center's selection of a Presiding Panelist shall be made in a manner that seeks to reasonably balance the preferences of each party as communicated to the Center within five (5) calendar days of the Center's communication of the list of candidates to the parties.
- (iv) Where any party fails to indicate its order of preference for the Presiding Panelist to the Center, the Center shall nevertheless proceed to appoint the Presiding Panelist in its sole discretion, taking into account any preferences of any other party.

## **9. Expert Impartiality and Independence**

(a) In accordance with Article 13(c) of the Procedure, any prospective Panelist shall, before accepting appointment, disclose to the Center and parties any circumstance that might give rise to justifiable doubt as to his/her impartiality or independence, or confirm in writing that no such circumstance exist by submitting to the Center a *Declaration of Impartiality and Independence* using the form set out in Annex E hereto and posted on the Center's website.

(b) If at any stage during a proceeding conducted under the Procedure, circumstances arise that might give rise to justifiable doubt as to a Panelist's impartiality or independence, the Panelist shall promptly disclose such circumstances to the parties and the Center.

(c) A party may challenge the appointment of a Panelist if circumstances exist which give rise to justifiable doubt as to the Expert's impartiality or independence. A party may challenge a Panelist whom it has appointed or in whose appointment it concurred, only for reasons of which it becomes aware after the appointment has been made.

- (i) A party challenging a Panelist shall send notice to the Center and the other party, stating the reasons for the challenge, within five (5) calendar days after being notified of that Panelist's appointment or becoming aware of circumstances that it considers give rise to justifiable doubt as to that Panelist's impartiality or independence.
- (ii) The decision on the challenge shall be made by the Center in its sole discretion. Such a decision is of an administrative nature and shall be final. The Center shall not be required to state reasons for its decision. In the event of a Panelist's removal, the Center shall appoint a new Panelist in accordance with the Procedure and these WIPO Rules for New gTLD Dispute Resolution.

## 10. Fees

(a) The applicable fees for the Procedure for Existing Legal Rights Objections are specified in Annex D hereto and posted on the Center's website.

(b) After the Expert Determination has been rendered or a proceeding conducted under the Procedure has been terminated, the Center shall provide an accounting to the parties of the payments received and, in consultation with any Panel, return any unexpended balance of the Panel Fee to the parties.

## 11. Confidentiality

(a) A party invoking the confidentiality of any information it wishes or is required to submit in any Existing Legal Rights Objection proceeding conducted under the Procedure, shall submit the request for confidentiality to the Center for the Panel's consideration, stating the reasons for which it considers the information to be confidential. If the Panel decides that the information is to be treated as confidential, it shall decide under which conditions and to whom the confidential information may in part or in whole be disclosed and shall require any person to whom the confidential information is to be disclosed to sign an appropriate confidentiality undertaking.

(b) Further to Article 6(b) of the Procedure, except in exceptional circumstances as decided by the Panel and in consultation with the parties and the Center, no party or anyone acting on its behalf shall have any *ex parte* communication with the Panel.

## 12. Mediation

Further to Article 16 of the Procedure, prior to the Panel rendering its Expert Determination in a proceeding conducted under the Procedure, the parties may inform the Center that they wish to participate in mediation to attempt to resolve the dispute and may request the Center to administer the mediation. In such event, unless both parties agree otherwise, the WIPO Mediation Rules shall apply *mutatis mutandis*. On request from the parties, and absent exceptional circumstances, the Center's mediation administration fee shall be waived.

## 13. Effect of Court Proceedings

(a) The Objector and Applicant shall include in any Objection or Response relevant information regarding any other legal proceedings concerning the TLD. In the event that a party initiates any legal proceedings during the pendency of a proceeding conducted under the Procedure, it shall promptly notify the Center.

(b) In the event of any legal proceedings initiated prior to or during a proceeding conducted under the Procedure, the Panel shall have the discretion to decide whether to suspend or terminate such proceeding under the Procedure, or to proceed to an Expert Determination.

#### **14. Termination**

(a) If, before the Panel renders an Expert Determination, it becomes unnecessary or impossible to continue a proceeding conducted under the Procedure for any reason, the Panel may in its discretion terminate the proceeding.

(b) If, prior to Panel appointment, it becomes unnecessary or impossible to continue a proceeding conducted under the Procedure for any reason, the Center in consultation with the parties and ICANN, may in its discretion terminate the proceeding.

#### **15. Amendments**

Subject to the Procedure, the Center may amend these WIPO Rules for New gTLD Dispute Resolution in its sole discretion.

#### **16. Exclusion of Liability**

Except in respect of deliberate wrongdoing, a Panelist, the World Intellectual Property Organization and its staff shall not be liable to any party or ICANN for any act or omission in connection with any proceeding conducted under the Procedure and the WIPO Rules for New gTLD Dispute Resolution.



# Legal Rights Objection E-Filing Guidelines

## (Annex B to WIPO Rules for New gTLD Dispute Resolution)

The following filing guidelines apply to Objections and Responses filed with the WIPO Arbitration and Mediation Center (the Center) under ICANN's New gTLD Dispute Resolution Procedure including the World Intellectual Property Organization Rules for New gTLD Dispute Resolution for Existing Legal Rights Objections ("WIPO Rules for New gTLD Dispute Resolution").

### **Email Size (email communications)**

Unless approved beforehand by the Center, the size of any one email communication (including attachments) transmitted to the Center in connection with any Legal Rights Objection proceeding shall not exceed 10 MB (ten megabytes). For documentation exceeding 10 MB, files may be "split" across multiple email communications, subject to the total file size limits detailed below.

### **Total File Size (objection/response)**

The total size of an objection or response (including any annexes) filed in relation to a Legal Rights Objection proceeding shall not exceed 50 MB (fifty megabytes); in exceptional circumstances this limit may be exceeded, where approved beforehand by the Center.

### **Individual File Size Limit (email attachments)**

Unless approved beforehand by the Center, the size of any individual file (such as a document in Word, PDF or Excel format) transmitted to the Center in connection with any Legal Rights Objection proceeding shall not exceed 10 MB (ten megabytes). For documentation exceeding 10 MB, and subject to the total file size limits detailed above, files may be "split" into an appropriate number of separate files or documents, each no larger than 10 MB.

### **Email Subject Heading**

It is advised that the email subject heading for an Objection (including any annexes) or Response (including any annexes) should clearly identify the email e.g., as being either an "LRO Objection Filing" or an "LRO Response Filing", as the case may be. Once an Objection is registered for processing by the Center, a case number will be assigned; it is advised that the email subject heading for case related communications include the relevant case number.

### **File Type (format)**

Parties are encouraged to submit electronic files in a format that will be as universally accessible as reasonably possible; e.g., WORD (i.e., ".doc" or ".docx") or PDF. Parties should submit the pleadings themselves in WORD format; annexes and supporting evidence may be submitted in other formats.

## **Annex 5**

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

Joint Recommendation  
Concerning Provisions on the  
Protection of Marks,  
and Other Industrial Property Rights in Signs,  
on the Internet  
(with Explanatory Notes)

*Adopted by*

the Assembly of the Paris Union for the  
Protection of Industrial Property

and

the General Assembly of the  
World Intellectual Property Organization (WIPO)

at the

Thirty-Sixth Series of Meetings of the  
Assemblies of the Member States of WIPO  
September 24 to October 3, 2001

## PREFACE

The Joint Recommendation Concerning the Protection of Marks, and Other Industrial Property Rights in Signs, on the Internet, which includes the text of the provisions as adopted by the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) at its sixth session (March 12 to 16, 2001), was adopted at a joint session of the Assembly of the Paris Union for the Protection of Industrial Property and the General Assembly of the World Intellectual Property Organization (WIPO) at the Thirty-Sixth Series of Meetings of the Assemblies of the Member States of WIPO (September 24 - October 3, 2001).

Initiated at the first session of the SCT (July 13 to 17, 1998), the issue relating to the protection of marks on the Internet was discussed at the second session, second part of the SCT (June 7 to 11, 1999) and at the third session of the SCT (November 8 to 12, 1999). Draft provisions concerning the protection of marks on the Internet were discussed by the SCT at its fourth session (March 27 to 31, 2000), at its fifth session (September 11 to 15, 2000) and at its sixth session (March 12 to 16, 2001).

The provisions aim at providing a clear legal framework for trademark owners who wish to use their marks on the Internet and to participate in the development of electronic commerce. They are intended to facilitate the application of existing laws relating to marks, and other industrial property rights in signs, on the Internet, and to be applied in the context of:

- determining whether, under the applicable law, use of a sign on the Internet has contributed to the acquisition, maintenance or infringement of a mark or other industrial property right in the sign, or whether such use constitutes an act of unfair competition;
- enabling owners of conflicting rights in identical or similar signs to use these signs concurrently on the Internet;
- determining remedies.

The determination of the applicable law itself is not addressed by the present provisions, but left to the private international laws of individual Member States.

Further to the adoption by the WIPO Assemblies of the Joint Recommendation Concerning Provisions on the Protection of Well-known Marks, in September 1999, and of the Joint Recommendation Concerning Trademark Licenses in September 2000, this Joint Recommendation is the third achievement of the SCT in implementing WIPO's policy of finding new ways to accelerate the development of international harmonized principles. This new approach to the progressive development of international intellectual property law was implemented by WIPO pursuant to the WIPO Program and Budget for the biennium 1998-99.

This volume contains the text of the Joint Recommendation, the accompanying provisions, and explanatory notes prepared by the International Bureau.

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*Joint Recommendation*

The Assembly of the Paris Union for the Protection of Industrial Property and the General Assembly of the World Intellectual Property Organization (WIPO);

*Taking into account* the provisions of the Paris Convention for the Protection of Industrial Property;

*Recommend* that each Member State may consider the use of any of the provisions adopted by the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) at its sixth session, as guidelines concerning the protection of marks, and other industrial property rights in signs, on the Internet;

*It is further recommended* to each Member State of the Paris Union or of WIPO which is also a member of a regional intergovernmental organization that has competence in the area of registration of trademarks, to bring these provisions to the attention of that organization.

Provisions follow.

*Preamble*

*Recognizing* that the present provisions are intended to facilitate the application of existing laws relating to marks and other industrial property rights in signs, and existing laws relating to unfair competition, to the use of signs on the Internet;

*Recognizing* that Member States will apply, wherever possible, existing laws relating to marks and other industrial property rights in signs, and existing laws relating to unfair competition, to the use of signs on the Internet, directly or by analogy;

*Recognizing* that a sign used on the Internet is simultaneously and immediately accessible irrespective of territorial location;

The present provisions are intended to be applied in the context of determining whether, under the applicable law of a Member State, use of a sign on the Internet has contributed to the acquisition, maintenance or infringement of a mark or other industrial property right in the sign, or whether such use constitutes an act of unfair competition, and in the context of determining remedies.

PART I  
GENERAL

*Article 1*  
*Abbreviated Expressions*

For the purposes of these Provisions, unless expressly stated otherwise:

(i) “Member State” means a State member of the Paris Union for the Protection of Industrial Property, of the World Intellectual Property Organization, or of both;

(ii) “Right” means an industrial property right in a sign under the applicable law, whether registered or unregistered;

(iii) “Act of unfair competition” means any act of competition contrary to honest business practices in industrial or commercial matters as defined in Article 10*bis* of the Paris Convention for the Protection of Industrial Property, signed in Paris on March 20, 1883, as revised and amended;

(iv) “Competent authority” means an administrative, judicial or quasi-judicial authority of a Member State which is competent for determining whether a right has been acquired, maintained or infringed, for determining remedies, or for determining whether an act of competition constitutes an act of unfair competition, as the case may be;

(v) “Remedies” means the remedies which a competent authority of a Member State can impose under the applicable law, as a result of an action for the infringement of a right or an act of unfair competition;

(vi) “Internet” refers to an interactive medium for communication which contains information that is simultaneously and immediately accessible irrespective of territorial location to members of the public from a place and at a time individually chosen by them;

(vii) except where the context indicates otherwise, words in the singular include the plural, and *vice versa*, and masculine personal pronouns include the feminine.



PART II  
USE OF A SIGN ON THE INTERNET

*Article 2*  
*Use of a Sign on the Internet in a Member State*

Use of a sign on the Internet shall constitute use in a Member State for the purposes of these provisions, only if the use has a commercial effect in that Member State as described in Article 3.

*Article 3*

*Factors for Determining Commercial Effect in a Member State*

(1) [*Factors*] In determining whether use of a sign on the Internet has a commercial effect in a Member State, the competent authority shall take into account all relevant circumstances. Circumstances that may be relevant include, but are not limited to:

(a) circumstances indicating that the user of the sign is doing, or has undertaken significant plans to do, business in the Member State in relation to goods or services which are identical or similar to those for which the sign is used on the Internet.

(b) the level and character of commercial activity of the user in relation to the Member State, including:

(i) whether the user is actually serving customers located in the Member State or has entered into other commercially motivated relationships with persons located in the Member State;

(ii) whether the user has stated, in conjunction with the use of the sign on the Internet, that he does not intend to deliver the goods or services offered to customers located in the Member State and whether he adheres to his stated intent;

(iii) whether the user offers post-sales activities in the Member State, such as warranty or service;

(iv) whether the user undertakes further commercial activities in the Member State which are related to the use of the sign on the Internet but which are not carried out over the Internet.

(c) the connection of an offer of goods or services on the Internet with the Member State, including:

(i) whether the goods or services offered can be lawfully delivered in the Member State;

(ii) whether the prices are indicated in the official currency of the Member State.

(d) the connection of the manner of use of the sign on the Internet with the Member State, including:

(i) whether the sign is used in conjunction with means of interactive contact which are accessible to Internet users in the Member State;

[Article 3(1)(d), continued]

(ii) whether the user has indicated, in conjunction with the use of the sign, an address, telephone number or other means of contact in the Member State;

(iii) whether the sign is used in connection with a domain name which is registered under the ISO Standard country code 3166 Top Level Domain referring to the Member State;

(iv) whether the text used in conjunction with the use of the sign is in a language predominantly used in the Member State;

(v) whether the sign is used in conjunction with an Internet location which has actually been visited by Internet users located in the Member State.

(e) the relation of the use of the sign on the Internet with a right in that sign in the Member State, including:

(i) whether the use is supported by that right;

(ii) whether, where the right belongs to another, the use would take unfair advantage of, or unjustifiably impair, the distinctive character or the reputation of the sign that is the subject of that right.

(2) [*Relevance of Factors*] The above factors, which are guidelines to assist the competent authority to determine whether the use of a sign has produced a commercial effect in a Member State, are not pre-conditions for reaching that determination. Rather, the determination in each case will depend upon the particular circumstances of that case. In some cases all of the factors may be relevant. In other cases some of the factors may be relevant. In still other cases none of the factors may be relevant, and the decision may be based on additional factors that are not listed in paragraph (1), above. Such additional factors may be relevant, alone, or in combination with one or more of the factors listed in paragraph (1), above.

*Article 4*  
*Bad Faith*

(1) [*Bad Faith*] For the purposes of applying these provisions, any relevant circumstance shall be considered in determining whether a sign was used in bad faith, or whether a right was acquired in bad faith.

(2) [*Factors*] In particular, the competent authority shall take into consideration, *inter alia*:

(i) whether the person who used the sign or acquired the right in the sign had knowledge of a right in an identical or similar sign belonging to another, or could not have reasonably been unaware of that right, at the time when the person first used the sign, acquired the right or filed an application for acquisition of the right, whichever is earlier, and

(ii) whether the use of the sign would take unfair advantage of, or unjustifiably impair, the distinctive character or the reputation of the sign that is the subject of the other right.

PART III  
ACQUISITION AND MAINTENANCE OF RIGHTS IN SIGNS

*Article 5*

*Use of a Sign on the Internet and Acquisition and Maintenance of Rights*

Use of a sign on the Internet in a Member State, including forms of use that are made possible by technological advances, shall in every case be taken into consideration for determining whether the requirements under the applicable law of the Member State for acquiring or maintaining a right in the sign have been met.

PART IV  
INFRINGEMENT AND LIABILITY

*Article 6*

*Use of a Sign on the Internet, Infringement of Rights and Acts of Unfair Competition*

Use of a sign on the Internet, including forms of use that are made possible by technological advances, shall be taken into consideration for determining whether a right under the applicable law of a Member State has been infringed, or whether the use amounts to an act of unfair competition under the law of that Member State, only if that use constitutes use of the sign on the Internet in that Member State.

*Article 7*

*Liability for Infringement and Acts of Unfair Competition Under the Applicable Law*

Except where otherwise provided for in these provisions, there shall be liability in a Member State under the applicable law when a right is infringed, or an act of unfair competition is committed, through use of a sign on the Internet in that Member State.

*Article 8*

*Exceptions and Limitations Under the Applicable Law*

A Member State shall apply the exceptions to liability, and the limitations to the scope of rights, existing under the applicable law when applying these provisions to the use of a sign on the Internet in that Member State.



PART V  
NOTICE AND AVOIDANCE OF CONFLICT

*Article 9*  
*Use Prior to Notification of Infringement*

If the use of a sign on the Internet in a Member State is alleged to infringe a right in that Member State, the user of that sign shall not be held liable for such infringement prior to receiving a notification of infringement, if:

(i) the user owns a right in the sign in another Member State or uses the sign with the consent of the owner of such a right, or is permitted to use the sign, in the manner in which it is being used on the Internet, under the law of another Member State to which the user has a close connection;

(ii) any acquisition of a right in the sign, and any use of the sign, has not been in bad faith; and

(iii) the user has provided, in conjunction with the use of the sign on the Internet, information reasonably sufficient to contact him by mail, e-mail or telefacsimile.

*Article 10*  
*Use After Notification of Infringement*

If the user referred to in Article 9 has received a notification that his use infringes another right, he shall not be held liable if he

(i) indicates to the person sending the notification that he owns a right in the sign in another Member State, or uses the sign with the consent of the owner of such a right, or that he is permitted to use the sign, in the manner in which it is being used on the Internet, under the law of another Member State to which he has a close connection;

(ii) gives relevant details of that right or permitted use; and

(iii) expeditiously takes reasonable measures which are effective to avoid a commercial effect in the Member State referred to in the notification, or to avoid infringement of the right referred to in the notification.

*Article 11*  
*Notification Under Articles 9 and 10*

The notification under Articles 9 and 10 shall be effective if it is sent by the owner of a right or his representative, by mail, e-mail or telefacsimile, and indicates, in the language, or in one of the languages, used in conjunction with the use of the sign on the Internet, the following:

- (i) the right which is alleged to be infringed;
- (ii) the identity of the owner of that right and information reasonably sufficient to contact him or his representative by mail, e-mail or telefacsimile;
- (iii) the Member State in which that right is protected;
- (iv) relevant details of such protection allowing the user to assess the existence, nature and scope of that right; and
- (v) the use that is claimed to infringe that right.

*Article 12*  
*Disclaimer as a Measure Under Article 10*

Member States shall accept, *inter alia*, a disclaimer, by a user referred to in Article 9, as a reasonable and effective measure under Article 10, if:

- (i) the disclaimer includes a clear and unambiguous statement in conjunction with the use of the sign, to the effect that the user has no relationship with the owner of the right which is alleged to be infringed, and does not intend to deliver the goods or services offered to customers located in a particular Member State where the right is protected;
- (ii) the disclaimer is written in the language or in the languages used in conjunction with the use of the sign on the Internet;
- (iii) the user inquires, before the delivery of the goods or services, whether customers are located in the Member State referred to in item (i); and
- (iv) the user in fact refuses delivery to customers who have indicated that they are located in that Member State.

PART VI  
REMEDIES

*Article 13*  
*Remedy Proportionate to Commercial Effect*

(1) The remedies provided for the infringement of rights or for acts of unfair competition in a Member State, through use of a sign on the Internet in that Member State, shall be proportionate to the commercial effect of the use in that Member State.

(2) The competent authority shall balance the interests, rights and circumstances involved.

(3) The user of the sign shall, upon request, be given the opportunity to propose an effective remedy for consideration by the competent authority, prior to a decision on the merits of the case.

*Article 14*  
*Limitations of Use of a Sign on the Internet*

(1) In determining remedies, the competent authority shall take into account limitations of use by imposing reasonable measures designed:

- (i) to avoid a commercial effect in the Member State, or
- (ii) to avoid infringement of the right or to avoid the act of unfair competition.

(2) The measures referred to in paragraph (1) may include, *inter alia*:

(a) a clear and unambiguous statement in conjunction with the use of the sign on the Internet, to the effect that the user has no relationship with the owner of the infringed right or the person affected by the act of unfair competition, written in the language or in the languages used in conjunction with the use of the sign on the Internet, and any other language indicated by the competent authority;

(b) a clear and unambiguous statement in conjunction with the use of the sign on the Internet to the effect that the user does not intend to deliver the goods or services offered to customers located in a particular Member State, written in the language or in the languages used in conjunction with the use of the sign on the Internet, and any other language indicated by the competent authority;

(c) an obligation to inquire, before the delivery of the goods or services, whether customers are located in that Member State, and to refuse delivery to customers who have indicated that they are located in that Member State;

(d) gateway web pages.

*Article 15*

*Limitation on Prohibition to Use a Sign on the Internet*

(1) Where the use of a sign on the Internet in a Member State infringes a right, or amounts to an act of unfair competition, under the laws of that Member State, the competent authority of the Member State should avoid, wherever possible, imposing a remedy that would have the effect of prohibiting any future use of the sign on the Internet.

(2) The competent authority shall not, in any case, impose a remedy that would prohibit future use of the sign on the Internet, where

(i) the user owns a right in the sign in another Member State, uses the sign with the consent of the owner of such a right, or is permitted to use the sign, in the manner in which it is being used on the Internet, under the law of another Member State to which the user has a close connection; and

(ii) any acquisition of a right in the sign, and any use of the sign, has not been in bad faith.

[Explanatory Notes follow]

EXPLANATORY NOTES\*  
prepared by the International Bureau

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\*These notes were prepared by the International Bureau of the World Intellectual Property Organization (WIPO) for explanatory purposes only.



### *Notes on the Preamble*

0.01 The first and second recitals clarify that the present provisions do not constitute a self-contained industrial property law for the Internet, but are intended to guide the application of existing national or regional industrial property laws to legal problems resulting from the use of a sign on the Internet.

0.02 The third recital emphasizes the main particularity of the Internet, its “global nature” which challenges the territorial nature of national or regional laws. These challenges require some modifications in national or regional laws if marks and other rights in distinctive signs are to be granted an adequate level of protection on the Internet.

0.03 The purpose of the present provisions is, therefore, to provide a link between the global Internet and territorial laws and to make these laws Internet-compatible. The present provisions deal with all situations in which a competent authority is called upon to decide whether the use of a sign on the Internet has, under the applicable national or regional law, contributed to acquiring, maintaining or infringing a right in that sign, or whether such use constitutes an act of unfair competition. They also apply in the context of determining remedies.

0.04 The question of determining the applicable law is not addressed by the present provisions, but left to the private international laws of individual Member States. Once the applicable national or regional law has been determined, it should be applied, directly or by analogy, wherever this is possible.

## Notes on Article 1

1.01 *Items (i), (iii) and (v)* appear self-explanatory.

1.02 *Item (ii)*. The present provisions are not limited to trademark rights, but include all types of industrial property rights in signs existing under the applicable law. The provisions do not limit the freedom of Member States to determine the conditions for the protection of individual types of rights. Unregistered rights are included to the extent they are recognized under the applicable law. The provisions do not provide an exhaustive list of industrial property rights in signs. Trademark rights are just one example; other examples could include trade names, or geographical indications. Item (ii) describes the scope of industrial property rights in signs protected under national laws by reference to the following common characteristics of such rights: (i) they belong to one person or a group of persons (whether individualized or, as in the case of collective marks or geographical indications, defined in abstract terms) who may exclude every other person from using the sign (“exclusive rights”), and (ii) these rights are only protected in a commercial context. The present provisions neither limit the freedom of Member States to determine what kinds of industrial property rights in signs they recognize, nor interfere with obligations existing under international treaties, such as the Paris Convention. The present provisions do not apply in a purely non-commercial context. It is left to the law of Member States to determine whether and under what conditions they want to apply the provisions in a non-commercial context.

1.03 The concept of “sign” is not defined in the provisions. However, it follows from the purpose of the provisions that they only refer to “distinctive” signs. The provisions deal with the question whether the use of a sign on the Internet can be considered in the context of determining whether an industrial property right in that sign has been acquired, maintained, or infringed, or whether such use constitutes an act of unfair competition. Therefore, the provisions only deal with the use of signs which, at least in the abstract, can serve to distinguish enterprises, goods, etc. irrespective of whether the user of the sign owns a right in that sign. Use of a sign that cannot even in the abstract serve as a “distinctive sign” could not contribute to acquiring, maintaining or infringing a right in such a sign, and would therefore be of no relevance for the purpose of these provisions. It is not required that the sign be actually used to distinguish enterprises, goods, etc., as long as it can be used as such.

1.04 *Item (iv)*. The legal nature of the “competent authority” will depend on the national system in a given Member State. Item (iv) does not interfere with the power of Member States to determine competence. It has been drafted broadly in order to accommodate all systems that might exist in Member States.

1.05 *Item (vi)*. This item gives a description of the term “Internet” without attempting to provide a comprehensive definition. This is emphasized by the use of the words “refers to” instead of the word “means” used in the other items. Given the rapid technological development of that sector, a definition of the term “Internet” might soon be outdated. As is emphasized in the Preamble, one of the main particularities of the Internet is its “global nature,” the fact that a sign used on the Internet is simultaneously and immediately accessible irrespective of territorial location. This particular feature challenges the territorial basis of laws relating to marks or other industrial property rights in signs, and which therefore requires the application of the present provisions. The fact that the Internet allows a potentially unlimited number of users to access certain content distinguishes it from telephone networks.

Its public nature distinguishes it from private networks or Intranets. Its interactivity, and the fact that it provides content to individual members of the public at a time and from a place individually chosen by them distinguishes it from television and broadcasting. With regard to the last-mentioned aspect, item (vi) follows the wording of Article 8 of the WIPO Copyright Treaty (WCT) and Article 14 of the WIPO Performances and Phonograms Treaty (WPPT).

1.06 *Item (vii)*. This item has been added in order to facilitate the drafting of the provisions. A similar provision is contained in Article 1(xv) of the Patent Law Treaty.

1.07 References in the provisions to individual users or individual right owners also include legal entities recognized under the applicable law. Such entities can be regarded as users of a sign or owners of a right to the extent that they have competence to act or to own a right under the applicable law. The provisions do, however, not interfere with the power of Member States to determine the conditions for recognizing legal entities, and to regulate their structure and legal competence.

## Notes on Article 2

2.01 The question whether use of a sign on the Internet can be regarded as having taken place in a particular Member State is relevant for deciding whether such use should count towards deciding whether the user has acquired, maintained or infringed a right that is protected in the Member State, or whether he has committed an act of unfair competition in that Member State.

2.02 Article 2 is based on the assumption that not each and every use of a sign on the Internet should be treated as taking place in the Member State concerned, even though the use might be accessible to Internet-users based in that State. The effect of the provision is that only use that has commercial repercussions in a given Member State, or, in other words, use that has a “commercial effect” in that Member State, can be treated as having taken place in that Member State. The provisions introduce the term “use of a sign on the Internet in a Member State” as a shorthand expression for use of a sign on the Internet which is deemed to have taken place in a Member State as a result of its commercial effect.

2.03 The provision is only intended to deal with the question of whether use of a sign on the Internet can be deemed to have taken place in a particular Member State. The legal effects of such use in that Member State would have to be determined under the applicable law in accordance with Articles 5 and 6.

2.04 The term “commercial effect” has been chosen rather than “in the course of trade,” in order to include situations in which a non-profit company has produced a commercial effect in a particular country by using the sign on the Internet without using it “in the course of trade.” It should be noted that use of a sign on the Internet can have a commercial effect even before any business transactions are carried out in that Member State.

2.05 The present provisions are only applicable to rights that are protected in a commercial context. In so far as Member States also protect certain rights in signs, such as personality rights, in a purely non-commercial context, they are free to either to grant such protection in relation to use of a sign on the Internet independently of whether such use has a commercial effect, or to apply the present provisions.

## Notes on Article 3

3.01 *Paragraph (1)*. The determination of whether use of a sign on the Internet has produced a commercial effect in a particular Member State, and whether such use can be deemed to have taken place in that Member State, shall be made on the basis of all relevant circumstances. A competent authority is free to determine which factors are relevant in a given case. Once it has identified the relevant factors, it is obliged to take them into account. Paragraph (1) provides a non-exhaustive list of factors that can be relevant. The factors are grouped into various categories for clarity.

3.02 *Subparagraph (a)* This subparagraph contains two general principles and, in that regard, supplements all following items. First, doing business in a Member State is the most obvious way of creating a commercial effect in that State. Second, planning to do business in a Member State can have a commercial effect in that Member State. It should be noted, however, that use of a sign on the Internet might have a commercial effect in a Member State even if the user was not yet planning to do business in that particular Member State.

3.03 *Subparagraph (b)*. This subparagraph invites a competent authority to determine whether the level and character of commercial activity carried out in conjunction with the use of the sign on the Internet contributes to a finding that such use has a commercial effect in that Member State. This does not mean, however, that there always has to be some commercial activity in the Member State; use of a sign on the Internet can have a commercial effect in a Member State even though the user of the sign does not, or not yet, carry out any commercial activity.

3.04 *Item (i)*. The location of actual or prospective customers in the Member State is an important factor for determining whether use of the sign in the context of actual delivery of goods or services, or in the context of other commercially motivated relationships has a commercial effect in that State. Customers are located in the Member State if they are physically present in the Member State at the time of the relevant activity. For the purposes of these provisions, “location” is a purely factual concept, for which mere presence in the State should be sufficient. “Other commercially motivated relationships” include activities of the user that are, like direct mailing of advertisements or product information, aimed at prospective customers in preparation for the eventual future conclusion of commercial contracts.

3.05 *Item (ii)*. This item refers to what might be called a “territorial disclaimer.” If a web site contains a statement to the effect that the goods or services offered are not available in particular Member States, it is less likely that such use would produce a commercial effect in those Member States. Such statements can either be drafted in a “positive” or in a “negative” way: The user can, for example, expressly exclude particular Member States (“No delivery to customers located in countries X, Y and Z”), or he can provide an exclusive list of countries in which the goods or services are available (“Delivery only to countries A, B, and C”), which would implicitly exclude all countries which are not listed. Since mere use of “disclaimers” should not shield users of signs on the Internet from every liability, the item invites the competent authority to inquire whether the user has adhered to his stated intent. It is recalled that “location” is used in a purely factual way, and does not require any continuous presence in the Member State, such as the term “domicile” (see Note 3.04 above).

3.06 As currently drafted, “disclaimers” constitute merely one factor among other factors which a competent authority can consider for determining whether the use of a sign on the Internet has produced a commercial effect in the Member State concerned. The use of “disclaimers” can, therefore, be outweighed by other factors, such as actual delivery of goods to customers located in the Member State. A competent authority can also hold, for example, that a disclaimer was not effective in an individual case because it was not drafted clearly enough, because it was not placed obviously enough, or because it was written in a language that is not understood in the Member State in question. In sum, the determination as to whether a disclaimer is effective or not is ultimately left to competent authorities of Member States.

3.07 The concept of disclaimer used in item (ii) of Article 3 is broader than the one used in Article 12. In Article 3, the statement serves as a precautionary measure by a user who does not necessarily own a right in the sign he uses, and who does not necessarily know of any other existing rights. This could be one way of reducing the need to do a “global search” for existing rights, which is often difficult and prohibitively expensive. In item (ii) of Article 3, the effectiveness of the disclaimer is left to the appreciation of competent authorities in each individual case. In Article 12, however, the disclaimer serves as a means for users in good faith, who own a right in the sign they use, to avoid liability for the infringement of a particular right, after having been notified by the owner of that right. Article 12 therefore explicitly requires that the disclaimer also contain a statement designed to avoid confusion with the holder of the allegedly infringed right. Article 12 further sets out, in items (iii) and (iv), the specific actions the user must take in order to abide by the disclaimer. Under these circumstances, the disclaimer can effectively shield the user from liability.

3.08 Items (iii) and (iv). These items appear self-explanatory

3.09 *Subparagraph (c)*. This subparagraph invites a competent authority to determine whether the goods or services offered in conjunction with the use of the sign on the Internet relate or can relate to a particular Member State. Again, this does not mean that use of a sign on the Internet can only have a commercial effect in a particular Member State if it takes place in conjunction with the offer of goods or services over the Internet. As in the example of advertisement targeted at a particular Member State, use of a sign on the Internet can have a commercial effect in a particular Member State without any goods or services being offered over the Internet.

3.10 *Item (i)* This item refers to national laws which set conditions for the marketing of particular goods or services, such as product regulations. Use of a sign on the Internet in conjunction with the offer of goods or services that do not comply with the product regulations of a particular Member State is less likely to produce a commercial effect in that Member State because, in such a case, the goods or services could not lawfully be delivered in that State.

3.11 *Item (ii)* This item appears self-explanatory.

3.12 *Subparagraph (d)*. This subparagraph directs the attention of competent authorities to the manner of use of the sign on the Internet. A sign can be used on a web site, in an e-mail or an e-mail heading. It can also be used to direct Internet users to a particular web site, for example if it is used in an Internet domain name or as a meta-tag without being visible on the web site itself. It should be noted, however, that a sign can be used on the Internet without

there being a web site on which or for which it is used. Therefore, the item does not explicitly mention any specific forms of uses.

3.12 *Items (i) and (ii)*. These items include all means which enable Internet users located in a particular country to communicate with the user of the sign in question. In addition to an address or telephone number in the Member State (*item (ii)*) which provide an obvious relationship with that State, a web site can offer means of interactive contact which allow customers located in the Member State not only to communicate with the user via e-mail, but also to place orders or to obtain delivery directly via the Internet. Similarly, if the sign was used in an e-mail which was sent to (potential) customers in the Member State, the recipients could directly reply to that e-mail, and thus easily communicate with the user of the sign. Thus, the “degree of interactivity” of the use can be an important factor for determining a commercial effect.

3.13 *Item (iii)*. Top level domain names based on the ISO Standard country code 3166 refer to individual States. For example, “.ch” refers to Switzerland, “.fr” to France and “.ru” refers to the Russian Federation. If a domain name, which identifies a web site or an e-mail address, is registered in a top level domain referring to a particular country, this might indicate that use of the sign as part of, or in conjunction with, that domain name is in some way connected to that country.

3.14 *Item (iv)*. Language can be a decisive factor if the language used in conjunction with the use of the sign is not widely spoken outside the Member State in question. However, the more widely a language is used outside the Member State, the less conclusive is the evidence provided by its use.

3.15 *Item (v)*. It should be noted that the fact alone that a particular Internet location, such as a web site, has been visited by Internet users located in a particular Member State may not suffice for concluding that use of a sign on that Internet location has a commercial effect in that Member State. Even though such visits will probably not be conclusive as such, they can nevertheless constitute one factor among others for determining whether the use of a sign on the Internet has a commercial effect in that country. It is recalled that the term “location” is used in a purely factual way, and does not require any continuous presence in the Member State, such as the term “domicile” (see Note 3.04 above).

3.16 *Subparagraph (e)*. This subparagraph highlights the importance of any right in the sign used. Use of a sign on the Internet can have a commercial effect in a Member State if the sign is the subject of a right protected under the law of that Member State. This link between the sign used and a right in that sign can become relevant in two situations: First, in a positive way (*item (i)*), if the user himself owns a right in the sign. If the user has, for example, registered a mark in a particular Member State, this can serve as an indication that he or she intends to engage in activities which have a commercial effect in that State. Second, in a negative way (*item (ii)*), if someone else owns a right in the sign under the law of a particular Member State. If the user, knowing of that right, nevertheless uses the sign, for example because he or she wants to profit from the goodwill embodied in that sign, such use can have a commercial effect in the State in which the right is protected, be it only because the commercial value of the sign for the right holder is diminished. Such use is generally considered to be use in “bad faith.” “Cybersquatting” would be the most obvious case of such unauthorized use. Thus, item (ii) would allow a competent authority to find a link between such cases of bad faith use, and the country in which the infringed right is protected. In order

to clarify that item (ii) refers to the effect of bad faith use, it follows the wording of Article 4(2)(ii).

3.17 *Paragraph (2)*. This provision states expressly that the list of factors is neither cumulative nor exhaustive, but functions as a checklist of factors which might be relevant in a given case, without obliging the competent authority to express an opinion about every listed factor. Paragraph (2) follows the model of Article 2(1)(c) of the Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks.



## Notes on Article 4

4.01 It should be noted that Article 4 does not introduce bad faith as a prerequisite of liability for infringement. However, since use of a sign on the Internet in bad faith is relevant in the context of Article 9 and 15, it is necessary to include a provision describing this concept in Part II which deals with use of a sign in the Internet in a general way.

4.02 *Paragraph (1)*. This provision requires competent authorities to consider all relevant circumstances when determining bad faith. A competent authority will determine bad faith in accordance with the applicable law. Accordingly, for determining whether a right has been acquired in bad faith, the law under which the right has been acquired will have to be applied, whereas the question whether a sign was used in bad faith can be determined under the law of the State in which the sign was used.

4.03 *Paragraph (2)*. This provision sets out, by way of example, the factors that appear particularly relevant in the context of the determination under paragraph (1). Member States are, however, free to adopt different standards for determining bad faith. The factors are stated in an abstract and general way. A more detailed list of factors could only provide examples for “unfair advantage” or “unjustifiable impairment,” such as those which are included in the Report of the WIPO Internet Domain Name Process (paragraph 172). Such a list might, however, rather be perceived as a limitation of relevant factors. A more general formulation chosen in the present provisions allows competent authorities of Member States to adapt their reasoning to the merits of each individual case.

4.04 *Item (i)*. This item specifies that users must have had knowledge of the conflicting right at the time when they acquired the right or started to use the sign. If a user later becomes aware of a conflicting right, he would not be considered to have acted in bad faith. The expression “could not have reasonably been unaware” is used instead of the term “reason to know” in order to avoid the inclusion of broad constructive knowledge provisions under certain national laws. A similar provision is contained in Article 4(5)(c) of the Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks. It should be noted that knowledge, or the fact that the user could not reasonably have been unaware of the conflicting right, alone, would not be sufficient for a finding of bad faith.

4.05 *Item (ii)*. This item introduces an additional element of bad faith, namely that the sign was used with a view to profit from the goodwill associated with the sign protected by the right of another, or to impair its distinctive character or reputation. However, because of the difficulty of proving a certain intent, an objective formulation has been adopted.

## Notes on Article 5

5.01 This provision confirms that use of a sign on the Internet shall be taken into consideration for determining whether rights in the sign have been acquired or maintained through use in a particular Member State. Instances in which a right can be acquired or maintained through use include, *inter alia*: acquiring or maintaining a right in an unregistered mark or other sign; acquiring or maintaining the registration of a mark; avoiding abandonment of a right; determining whether a mark has acquired distinctiveness; or determining whether a mark has become well-known. If relevant under the applicable law, use of a sign on the Internet by another can also be considered as prior use of a sign in that Member State.

5.02 The provision does not require Member States to provide the legal possibilities for acquiring or maintaining rights in marks or other industrial property rights in signs through use. However, if use of a sign is relevant in these contexts under the law of a Member State, use on the Internet shall also be taken into account, provided that such use can be deemed to have taken place in that Member State (see Article 2). It should be noted that the provision does not specify the legal requirements for acquiring or maintaining a right in a sign through its use. This determination is left to the applicable law. Article 5 merely requires that use of a sign on the Internet that has a commercial effect in a Member State be subject to the same general principles as use in that Member State outside the Internet.

5.03 The provision also reminds competent authorities that “new” forms of use should not be discarded only because they are new. However, the final determination as to whether a particular “new” form of use can be taken into account for the purposes of acquiring or maintaining a right is left to the applicable law.

## Notes on Article 6

6.01 Mere use of a sign on the Internet shall not be considered as infringing any rights in that sign which might exist under the law of a particular Member State. Use on the Internet shall only be taken into consideration under the laws of a particular Member State if such use has a commercial effect and can, therefore, be deemed to have taken place in that Member State (see Articles 2 and 3).

6.02 The present provisions also address matters of unfair competition on the Internet. They are, however, limited to the question as to when and under what conditions use of a sign on the Internet can constitute an act of unfair competition in Member States. Consistent with the approach generally adopted in the present provisions, the substantive criteria for determining that use of a sign on the Internet constitutes an act of unfair competition in an individual case are left to the applicable law of Member States. Such an approach is also mandated by the fact that the private international law rules of unfair competition have not been harmonized. Therefore, the present provisions merely provide that use of a sign on the Internet shall only be considered as an act of unfair competition under the law of a Member State, if such use has a commercial effect in a particular Member State.

6.03 Article 6 also requires Member States to protect rights in marks and other signs in situations which might appear unusual if compared with forms of use outside the Internet, such as use of signs in banner advertisements, sale or purchase of signs as keywords for search engines, use as metatags, use in Uniform Resource Locators (URLs), use as search terms, or any other “new” forms of use that might be possible in the future.

6.04 It should be noted, however, that Article 6 does not require Member States to consider such forms of use as generally infringing marks or other industrial property rights in signs. Whether an infringement has in effect taken place will be determined under the applicable law, including any exceptions which might apply in certain situations, such as “fair use” of descriptive terms (see Article 8). Article 6 in effect obliges Member States to monitor new and emerging, possibly circumventive, forms of use, and to provide protection under their national laws. This protection may be provided under any of the laws relating to marks or other industrial property rights in signs, including unfair competition laws, of the Member State, at the Member State’s option.

## Notes on Article 7

7.01 This provision states the general principle that the user of a sign on the Internet shall, under the applicable law on distinctive signs or unfair competition of a Member State, be liable for such use which constitutes an infringement or an act of unfair competition if use of the sign on the Internet can be deemed to have taken place in that Member State in accordance with Sections 2 and 6. The only exceptions to that principle are provided for by Section 8 (Exceptions and Limitations under the applicable law) and contained in Part V (Notice and Avoidance of Conflict).

7.02 The provision does not specify the conditions for determining whether such use in fact infringes a right which is protected under the law of a particular Member State, or whether it constitutes an act of unfair competition. This determination has to be made under the applicable law of that Member State. Similarly, liability of intermediaries, such as online service providers, is not specifically addressed under these provisions, but left to the applicable law.

## Notes on Article 8

8.01 This provision generally requires Member States to apply any existing exceptions and limitations under the applicable law in respect of liability that arises in connection with the use of a sign on the Internet, provided, of course, that the use on the Internet can be considered to have taken place in the Member State in question in accordance with Section 2. This means that all exceptions to liability or limitations to the scope of rights existing under the law applicable in that Member State have to be available to users of a sign on the Internet. However, the provision neither obliges Member States to recognize particular exceptions or limitations, such as “fair use” or “free speech,” nor requires them to introduce particular exceptions or limitations for use of signs on the Internet. It is left to the applicable law to determine the forms of use that could benefit from an exception or limitation.

## *Notes on Article 9*

9.01 Because of the territoriality of marks and other industrial property rights in signs, different owners can hold rights in identical or similar signs in different countries. This can create problems if the sign is used on the Internet. Because of the necessarily global nature of the Internet such use might be considered as infringing a right under the law of a Member State in which the right of the user is not recognized. Similar conflicts arise when the use of a sign is permitted in one country, but is considered to infringe the right of someone else under the law of another country.

9.02 Part V provides for what might be called a “notice and avoidance of conflict” procedure in an attempt to balance the interests of good faith legitimate users who hold a right in the sign they use or are otherwise permitted to use that sign on the one hand, and owners of rights which might be infringed by such use on the other. It also implements the general principle that no one should be obliged to undertake a worldwide search for registered or unregistered rights before using a sign on the Internet. Right holders, or persons who are otherwise permitted to use the sign, are exempt from liability up to the point when they receive a notification of infringement provided that they use the sign in good faith, and provide in conjunction with the use of the sign on the Internet, sufficient information to be contacted. As a consequence, they cannot be subjected to any injunction, or held liable for any damages occurring, before notification. Such users are, therefore, not compelled to undertake a worldwide search for existing rights before using the sign on the Internet. However, once they have received a notice of infringement, they have to take certain measures for avoiding or ending the conflict. If they do so, they are not only exempt from any liability for any infringing use prior to notification, but continue to be exempt for any such use after notification .

9.03 Articles 9 to 12 do not apply to cases where the use of a sign on the Internet is considered an act of unfair competition in a Member State. In most cases of unfair competition, there is no clearly specified right holder who could start the “notice and avoidance of conflict” procedure by sending a notification. The unfair competition laws of individual countries diverge widely with regard to the question who has standing to bring an action in unfair competition. It should be noted, however, that nothing would prevent a Member State from applying the “notice and avoidance of conflict” procedure to acts of unfair competition as well.

9.04 Article 9 exempts users of signs on the Internet from liability for the infringement of a right up to the point of notification, provided that all conditions listed in items (i) to (iii) are met. The provision is, of course, only applicable when the use on the Internet has a commercial effect in the Member State where the allegedly infringed right is protected, as set out in Articles 2, 3 and 6, because otherwise the user could not be held liable. It should be noted that the “notice and avoidance of conflict” procedure does not result in a permanent restriction or limitation of rights that are infringed by the use of a sign on the Internet; liability for infringement begins with the notification if the user does not comply with the requirements set out in Articles 10 to 12.. Nothing in this provision shall derogate from the existing obligations that Member States may have to each other under existing international conventions and agreements concerning industrial property.

9.05 *Item (i)* Only users who own a right in the sign in another Member State, users who use the sign with the consent of the owner, or users who are otherwise permitted to use the sign can benefit from that procedure.

9.06 The phrase “otherwise permitted to use the sign” is understood to refer to:

- (i) the use of the sign by a user who has a right in that sign which is, like his personal name, protected in a non-commercial context;
- (ii) the fair use of generic or descriptive terms.

Member States may also apply the “notice and avoidance of conflict” procedure if the use is permitted in another Member State for other reasons or simply because no other person owns a right in the sign in that other Member State.

9.07 The term “close connection” describes a certain relationship between the user of the sign and the Member State under the laws of which he is permitted to use the sign. Such a relationship is obvious in cases where the user owns a right in that sign under the laws of a particular Member State. If the user, however, does not own a right in the sign, he should not be able to rely on the laws of a country with which he has no relationship whatsoever for asserting that his use was permitted. He should have valid reasons for this assertion, which would have to be based on his relationship with a country that permits the use. Domicility would satisfy this requirement. Since the present provisions are concerned with use which has a commercial effect, the “close connection” would typically be of a commercial nature. Obvious examples for such a “close connection” would be the relationship with a country in which the user has his seat or headquarters, or a real and effective industrial or commercial establishment in the sense of Article 3 of the Paris Convention for the Protection of Industrial Property. The user would also have a “close connection” with a country in which he carries out a substantial part of his business.

9.07 *Item (ii)* The exception from liability does not apply if the user has acquired or used the right in bad faith. The criteria for determining whether a right was acquired or used in bad faith are set out in Article 4.

9.08 *Item (iii)* The user can only be notified if he has provided sufficient contact information in conjunction with the use. If he fails to do so, he can be held liable for any infringement even without having received a notification of infringement.

## *Notes on Article 10*

10.01 Article 10 sets out the consequences of an effective notification. After notification, the user of a sign on the Internet only continues to be exempt from liability if he substantiates his own right in the sign, or spells out why he is permitted to use the sign, in accordance with items (i) and (ii), and, in addition to this substantiation, takes the measures set out in item (iii). The time period within which the user has to act is not specified because the time to implement the measures might be different in each individual case. However, the user has to act “expeditiously,” which means that he or she has to act as quickly as possible under the given circumstances.

10.02 In item (iii), the measures are described only with reference to their objective, namely, to avoid a commercial effect in the Member State in which the allegedly infringed right is protected, or to avoid infringement of that right through other means.. The user can, however, only be expected to take “reasonable” measures. Such measures should not unreasonably burden the commercial activity the user carries out over the Internet. Thus, the user should not be obliged, for example, to stop every activity on the Internet which would, of course, be the most effective way of avoiding a commercial effect in any given country (see also Article 15 for remedies). The parties to the conflict are free to determine which measures would achieve these objectives in a given case. They are, of course, free to have recourse to alternative dispute resolution procedures, but are not obliged to do so. If the user adopts certain measures unilaterally, the competent authority, which is called upon to decide whether the user can be held liable for the infringement of the other right, will have to decide whether the measures adopted by the user are sufficient. Member States are, however, obliged to accept the measure set out in Article 12 as sufficient under Article 10.



## *Notes on Article 11*

11.01 Article 11 sets out the requirements under which a notification has the effect described in Article 10. The owner of the allegedly infringed right has to enable the user to assess the case and to respond to the notification. Therefore, the owner of the allegedly infringed right has to present a *prima facie* case of infringement (items (i), (iii) to (v)), and to furnish sufficient contact information (item (ii)). If the notification fails any of the requirements listed in items (i) to (v), it shall not be considered effective and the user continues to be exempt from liability. Whether the notification becomes effective once it has been sent or only on receipt is, however, left to the applicable law.

11.02 The notification can also be sent by a person other than the owner if the sender acts as the “representative” of the owner. The term “representative” includes every person that is authorized under the applicable law (*i.e.* the law under which the right is protected) to take steps for enforcing the right. Thus, the term can also include a licensee having this authority under the applicable law.

11.03 The notification has to be sent by mail, e-mail or telefacsimile. This requirement ensures that the required information exists in, or, as in the case of e-mail, can be reduced to, a physical embodiment. Oral notification by telephone or the like would thus not be sufficient.

11.04 The notification has to be drafted in the language, or in one of the languages, used in conjunction with the sign on the Internet. This requirement seems justified in view of the fact that the user of the sign has to act under time pressure under paragraph (2), and must therefore be in a position to understand the notification.

## Notes on Article 12

12.01 This provision is meant to give right holders, and other permitted users, who use their sign on the Internet in good faith, some degree of legal certainty as to how to avoid liability for the infringement of another right after having received a notification of infringement. The effect of Article 12 is that such users cannot be held liable for the infringement of the other right provided that they fulfill all the requirements set out in Article 12. Hence, a disclaimer under Article 12, has to be accepted as an effective measure described in Article 10(iii), and can, therefore, shield right owners and other permitted users from liability.

12.02 The disclaimer has to include the two statements listed in item (i) in order to avoid confusion with the owner of the conflicting right, and to avoid a commercial effect in the Member State in which the other right is protected. The user also has to take certain qualified actions in order to render the disclaimer effective under Article 10 (item (iii)).

12.03 The statements listed in item (i) have to appear “in conjunction” with the use of the sign. If the sign is used on a web site, the statement would have to appear on that web site. The provisions do not address further details, such as the exact location or the size of the statements, or whether it would suffice to place a link on the relevant page which leads to the statements. This determination is left to the competent authorities of Member States.

12.04 *Item (i)*. Once users have received a notification of conflict, they can be expected to make the statements set out in item (i), in order to avoid confusion with the owner of the other right on the one hand, and to avoid a commercial effect with a particular Member State on the other.

12.05 *Item (ii)*. The user should be able to remove the commercial effect caused by his use in one language, and to avoid liability for infringement, by making the prescribed statements in the same language.

12.06 *Item (iii) and (iv)*. The disclaimer is only effective under Article 10 if the user abides by it as described in items (iii) and (iv). This procedure should, however, not unreasonably burden his commercial activity. The user should, therefore, not be expected to verify the statements made by his customers. If the goods or services are physically delivered, it is in the own interest of customers to indicate their address correctly. If payments are effected via credit card, most companies require a billing address. If, however, the goods or services are directly delivered over the Internet, a business has in most cases no means to find out, in the normal course of business, where their customers are really located. In line with the rationale that the user should only be required to take measures which do not unreasonably burden his or her commercial activity, it seems justified to pose the remaining risk of false indications on the owner of the other right, that is the right which is alleged to be infringed. It is recalled that the term “location” is used in a purely factual way, and does not require any continuous presence in the country, such as the term “domicile” (see Note 3.04 above).

12.07 Unlike Article 14, Article 12 does not mention “gateway web pages.” The reason for this is that Article 12 describes measures which a user can take unilaterally in order to avoid liability. The establishment of gateway pages, however, would require consent of all parties involved. Gateway web pages can, of course, be adopted under Article 10 by way of consent

between the user and the owner of the allegedly infringed right, but not as a unilateral measure of the user.

12.08 Article 12 is part of the “notice and avoidance of conflict” procedure set out in Articles 9 to 11. As a consequence, right owners and other permitted users, who use their sign in good faith, can only rely on a disclaimer in the context of this procedure, *i.e.* once they have received a notification of infringement as set out in Articles 10 and 11. It should be noted, however, that a right owner or other permitted user in good faith, who is aware of another right without having been notified, would probably not produce a commercial effect under Article 2 if he takes all the measures set out in Article 12, and could, therefore, not be held liable for the infringement of that right. This would, however, have to be decided by a competent authority in the individual case.

### Notes on Article 13

13.01 This provision emphasizes the necessity to adapt national or regional laws on remedies to infringements taking place on the Internet, and to take account of the fact that marks and other industrial property rights in signs, as well as the means for enforcing these rights, are territorial in nature, whereas the Internet is global. The same is generally true for the laws against unfair competition which apply only to acts which affect the market of a certain country. Such laws cannot claim authority over acts occurring in foreign countries. Thus, by being linked to certain national markets, unfair competition laws are also territorially limited.

13.02 *Paragraph (1)*. In principle, a decision as to remedies should take into account the territorial limitation of marks or other industrial property rights in signs. Remedies should, therefore, be limited, as far as possible, to the territory in which the right is recognized, and they should only be available if the allegedly infringing use of the sign can be deemed to have taken place in that territory (see Article 6). This is determined with regard to the “commercial effect” of such use in the Member State in question (see Articles 2 and 3). Thus, the “commercial effect” of Internet use should serve as a yardstick for determining a “proportionate” remedy. Use of a sign on the Internet that infringes a right which is protected under the laws of a Member State should not be prohibited any more than is proportionate to the commercial effect that such use has produced in that Member State. Injunctions should generally be limited to what is necessary to prevent or remove the commercial effect in the Member State in which the infringed right is protected, and damages should be granted only for the commercial effect of the use in that Member State.

13.03 Similarly, remedies for acts of unfair competition should only be granted if the allegedly unfair use on the Internet can be deemed to have occurred in the Member State concerned (Article 6), and they should be limited as far as possible to removing the commercial effect from the Member State in which the unfair competition law applies.

13.04 *Paragraph (2)* emphasizes the need for a balanced approach. In addition to the interests of the parties involved, a competent authority could also take account, *inter alia*, of the number of Member States in which the infringed right is also protected, the number of Member States in which the infringing sign is protected by a right, or the relative extent of use on the Internet.

13.05 *Paragraph (3)*. The user of the sign might, in a given case, be in a position to propose a remedy which is equally (or more) effective as the remedy envisaged by the competent authority, but less burdensome for him. Thus, a defendant should, in an infringement procedure, have the right to propose a remedy. This does not mean, however, that the competent authority is obliged to ask the defendant for proposals; paragraph (3) is a mere application of the principle that defendants have a right to be heard before a decision on the merits is taken. This is emphasized by the words “upon request”. The final decision at the end of the infringement procedure is, of course, left to the competent authority. Furthermore, the provision does not interfere with the authority of courts or other competent authorities under the applicable law to order provisional measures without hearing the other party (*inaudita altera parte*); the right to be heard can be given at a later stage in the proceedings before a decision on the merits is taken.

## *Notes on Article 14*

14.01 This provision further specifies the general principle of proportionality contained in Article 13. Under normal circumstances, remedies should not have the effect of forcing the user of a sign on the Internet to abandon any use of that sign on the Internet because the right, or the law against unfair competition, which they are meant to enforce is territorially limited.

14.02 *Paragraph (1)* For this reason, paragraph (1) requires competent authorities, in designing remedies, to consider limitations of use designed to avoid a commercial effect in the Member State in which the infringed right is protected, or in which the law against unfair competition applies. If there is not commercial effect, the user can no longer be considered to infringe a right or to commit an act of unfair competition in that Member State (Article 6). The competent authority can also order the user to avoid the infringement or the act of unfair competition in the Member State by other means. These objectives mirror the ones listed in item (iii) of Article 10. The situation is, however, different: Whereas Articles 9 to 12 deal with measures that right owners in good faith can adopt to avoid liability for the infringement of another right, Article 14 addresses a situation in which a court has already found an infringement or an act of unfair competition and is now determining a proportionate remedy.

14.03 *Paragraph (2)* gives examples for proportionate limitations of use. Unlike Article 12, Article 14(2) does not require a competent authority to adopt one or all of the measures listed. Competent authorities are free to choose other remedies which are effective and proportionate in a given case.

14.04 *Subparagraphs (a) to (c)* mirror the disclaimer described under Article 12, but in this case the disclaimer is imposed by way of an injunction. In such a case, the competent authority is free to determine the language of the disclaimer, and to take account of laws regulating the use of languages by official authorities.

14.05 *Subparagraph (d)* proposes an alternative measure which has already successfully been applied in practice: owners of mutually infringing rights could be required either to set up a gateway page through which the web site of both right holders could be accessed, or to provide links from one web site to the other.

## *Notes on Article 15*

15.01 *Paragraph (1)* This provision contains another implementation of the general principle of proportionality set out in Article 13. An injunction to cease every use of a sign on the Internet would go far beyond the territory for which the infringed right in that sign has effect. It would have an effect which is as global as the Internet and could, therefore, also be called a “global injunction.” Applying the principle of proportionality, therefore, means that competent authorities should, as far as possible, refrain from granting such “global injunctions.” However, the provision does not completely exclude prohibitions of use, which can be justified particularly in cases of bad-faith use, such as cybersquatting. The provision does, therefore, not interfere with national anti-cybersquatting laws which provide for prohibitions of use in such cases of use in bad faith.

15.02 *Paragraph (2)* This provision generally exempts users from “global injunctions” if they do not act in bad faith as described in Article 4, and if they either hold a right in that sign themselves, or are otherwise permitted to use the sign on the Internet in the way they use it. It should be noted that the concept of “permitted use” in Article 15 is wider than the one in Article 9. In Article 9, “permitted use” is limited to the fair use of generic or descriptive terms, and to use which is supported by a non-commercial right such as a personal name (see Note 9.06 above). For the purpose of applying Article 15, however, no such limitation exists. Under this provision, there are many additional reasons why users might be permitted to use a sign in a particular way even if they do not own a right in it as defined in Article 1(ii); the user might, for example, be permitted to use the sign simply because no other person owns a right in it. If his use is merely permitted, the user could not rely on Articles 9 to 12 in order to avoid liability for the infringement of rights protected under the laws of other countries. The effect of paragraph (2) is that, in cases of permitted good-faith use, a competent authority can only apply limitations of use, such as those described in Article 14.

[End of Notes and of Document]

## **Annex 6**

# **WIPO Legal Rights Objection Model Objection**

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## **LEGAL RIGHTS OBJECTION**

### **WIPO Model Form**

#### **(Annex A to WIPO Rules for New gTLD Dispute Resolution)**

This Legal Rights Objection model form must be used by parties wishing to file a Legal Rights Objection with the World Intellectual Property Organization Arbitration and Mediation Center (“WIPO Center”) pursuant to the New gTLD Dispute Resolution Procedure (“Procedure”), provided as an Attachment to Module 3 of the gTLD Applicant Guidebook (“Applicant Guidebook”) (v. 2012-01-11) approved by the Internet Corporation for Assigned Names and Numbers (“ICANN”) on June 20, 2011 and as updated on January 11, 2012. The specific grounds on which a Legal Rights Objection may be filed are outlined in Applicant Guidebook Module 3, art. 3.5.2.

Upon filing, a copy of this Objection must be provided to the Applicant/Respondent and ICANN.

In accordance with the Applicant Guidebook and Procedure, the following information will be publicly posted on the WIPO Center’s website:

- (i) the proposed string to which the Objection is directed;
- (ii) the names of the Objector and the Applicant/Respondent;
- (iii) the grounds for the Objection; and
- (iv) the date of the WIPO Center’s receipt of the Objection.

By submitting this Objection to the WIPO Center the Objector hereby agrees to abide and be bound by the provisions of the Procedure and the World Intellectual Property Organization Rules for New gTLD Dispute Resolution for Existing Legal Rights Objections (“WIPO Rules for New gTLD Dispute Resolution”) in effect on the day when the relevant Application for a new gTLD was submitted, pursuant to Procedure, art. 1(d).

Pursuant to Procedure, art. 5 all submissions made in connection with this Procedure must be made in English; parties may submit supporting evidence in its original language, provided and subject to the authority of the Panel to determine otherwise, that such evidence is accompanied by a certified or otherwise official English translation of all relevant text.

*[In the event of any questions relating to the filing of a Legal Rights Objection under the Procedure, parties are invited to contact the WIPO Center by email at [lro@wipo.int](mailto:lro@wipo.int), or by telephone to +41 22 338 8247 or (toll free) 0800 888 549.]*



**Before the:**

**WORLD INTELLECTUAL PROPERTY ORGANIZATION  
ARBITRATION AND MEDIATION CENTER**

[NAME OF OBJECTOR]

**(Objector)**

-v-

[NAME OF APPLICANT]

**(Applicant/Respondent)**

TLD string objected to: [*<.EXAMPLE>*]

**LEGAL RIGHTS OBJECTION**

(Applicant Guidebook, Module 3; Procedure, art. 6, 7, 8;  
WIPO Rules for New gTLD Dispute Resolution, para. 4)

**I. Introduction**

- [1.] This Legal Rights Objection is hereby submitted to the World Intellectual Property Organization Arbitration and Mediation Center (“WIPO Center”) for determination in accordance with the New gTLD Dispute Resolution Procedure (“Procedure”), provided as an Attachment to Module 3 of the gTLD Applicant Guidebook (“Applicant Guidebook”) approved by the Internet Corporation for Assigned Names and Numbers (“ICANN”) on June 20, 2011 and as updated on January 11, 2012, and the World Intellectual Property Organization Rules for New gTLD Dispute Resolution for Existing Legal Rights Objections (“WIPO Rules for New gTLD Dispute Resolution”) in effect on the day when the relevant Application for a new gTLD was submitted.

**II. The Parties**

**A. The Objector**

(Procedure, art. 8(a)(i))

- [2.] The Objector in this proceeding is [*please provide the Objector’s full name and, if relevant, legal status, place of incorporation, and principal place of business*].

- [3.] The Objector’s contact details are:

Address: [*mailing address*]

Phone: [*phone number*]

E-mail: [e-mail address]  
Fax: [fax number]

[4.] The Objector's authorized representative in this proceeding is:

Name: [full name]  
Address: [mailing address]  
Phone: [phone number]  
E-mail: [e-mail address]  
Fax: [fax number]

[5.] The Objector's preferred contact details for purposes of this proceeding are:

For electronic-only material

Method: e-mail  
Address: [Specify one e-mail address]  
Contact: [Identify name of one contact person]

For any hardcopy\* material

Method: [Specify one: fax, post/courier]  
Address: [Specify one address, if applicable]  
Fax: [Specify one fax number]  
Contact: [Identify name of one contact person]

[ \* Please note that according to Procedure, Article 6(a), all communications must be submitted electronically. A Party wishing to make a submission not in electronic form shall first request leave from the Panel, who shall in its sole discretion, determine whether to accept the non-electronic submission; prior to Panel appointment, parties are referred to Article 3(b) of the WIPO Rules for New gTLD Dispute Resolution.]

## **B. The Applicant/Respondent** (Procedure, art. 11(d)(1))

[6.] The Applicant/Respondent in this proceeding is [identify the Applicant/Respondent, including full name, and if relevant, legal status, place of incorporation and principal place of business]. [Copies of the printout of the relevant ICANN posting\*\* conducted on [date] are provided as Annex [Annex number]].

[ \*\* According to Applicant Guidebook article 1.1.2.2, ICANN will post the public portions of all applications considered complete and ready for evaluation within two weeks of the close of the application submission period.]

[7.] All information known to the Objector regarding how to contact the Applicant/Respondent is as follows:

[Provide all contact details (postal address, phone number, e-mail addresses, and fax number) for the Applicant/Respondent, including those that may have been used successfully in the course of pre-Objection dealings and those available from any ICANN application-related documents.]

*[Please note that in accordance with Procedure, art. 7(d)(ii) in the event the Objector wishes to file multiple Objections to multiple Applications, each Objection must be filed separately, and accompanied by the appropriate filing fees.]*

### **III. TLD string objected to (applied-for TLD string):**

(Procedure, art. 7, 8)

[8.] This Objection concerns the applied-for TLD string identified below:

*[<.EXAMPLE>]*

*[NOTE: in case of any doubt, e.g., where certain numbers or letters may appear similar depending on the font used (e.g., the number “1” and the lower-case letter “l”), please confirm the exact nature/characters of the string being objected to.]*

### **IV. Jurisdictional Basis for the Objection**

(Procedure, art. 1(d), 4(b)(ii))

[9.] By applying for a new gTLD, the Applicant/Respondent has accepted the applicability of the Procedure and the WIPO Rules for New gTLD Dispute Resolution.

By filing the present Objection to a new gTLD, the Objector accepts the applicability of this Procedure and the WIPO Rules for New gTLD Dispute Resolution.

The parties cannot derogate from the Procedure without the express approval of ICANN and from the WIPO Rules for New gTLD Dispute Resolution without the express approval of the WIPO Center.

### **V. Factual and Legal Grounds**

(Applicant Guidebook Module 3, art. 3.5.2; Procedure, art. 8)

*[This section of the Objection may not exceed 5,000 words or 20 pages, whichever is less, excluding attachments (Procedure, art. 8(b)). Pursuant to Procedure, art. 6(a), any supporting evidence or documentation must be submitted electronically as Annexes with an accompanying schedule listing and describing all Annexes. For any cases or other legal documentation cited in support of the Objection, please use a full legal citation, e.g., in the format predominantly used or accepted in your jurisdiction.]*

[10.] The Objector’s basis for standing under the Procedure is:  
(Procedure, art. 8(a)(ii))

*[Please specify the rights (trademark, service mark, or Intergovernmental Organization (IGO) name or acronym) on which the Objection is based; please describe the goods or services the mark, or the activity the IGO name or acronym, is used in connection with. If applicable, please attach as Annexes copies of the registration certificates for the relevant marks.]*

[11.] This Objection is based on the following grounds:  
(Procedure, art. 2(e), 8(a)(iii)(aa))

“Existing Legal Rights Objection”, which refers to the objection that the string comprising the potential new gTLD infringes the existing legal rights of others that are recognized or enforceable under generally accepted and internationally recognized principles of law.

*[The grounds on which the Objection is being filed, as stated in Procedure, art. 2(e)]*

[12.] This Objection is valid and should be upheld for the following reasons:  
(Applicant Guidebook, art. 3.5.2; Procedure, art. 8(a)(iii)(bb))

The potential use of the applied-for gTLD by the Applicant/Respondent

[(i) takes unfair advantage of the distinctive character or the reputation of the Objector’s registered or unregistered trademark or service mark (“mark”) or IGO name or acronym (as identified in the treaty establishing the organization)], and/or

[(ii) unjustifiably impairs the distinctive character or the reputation of the Objector’s mark or IGO name or acronym], and/or

[(iii) otherwise creates an impermissible likelihood of confusion between the applied-for gTLD and the Objector’s mark or IGO name or acronym].

*[Please provide a sufficiently detailed explanation of the validity of the Objection and why the Objector believes the Objection should be upheld; this may include reference to the following, non-exclusive consideration factors:*

*[Where the Objection is based on trademark rights, the Panel will consider the following non-exclusive factors:*

- 1. Whether the applied-for gTLD is identical or similar, including in appearance, phonetic sound, or meaning, to the objector’s existing mark.*
- 2. Whether the objector’s acquisition and use of rights in the mark has been bona fide.*
- 3. Whether and to what extent there is recognition in the relevant sector of the public of the sign corresponding to the gTLD, as the mark of the objector, of the applicant [respondent] or of a third party.*
- 4. Applicant’s [respondent’s] intent in applying for the gTLD, including whether the applicant [respondent], at the time of application for the gTLD, had knowledge of the objector’s mark, or could not have reasonably been unaware of that mark, and including whether the applicant [respondent] has engaged in a pattern of conduct whereby it applied for or operates TLDs or registrations in TLDs which are identical or confusingly similar to the marks of others.*
- 5. Whether and to what extent the applicant [respondent] has used, or has made demonstrable preparations to use, the sign corresponding to the gTLD in connection with a bona fide offering of goods or services or a bona fide provision of information in a way that does not interfere with the legitimate exercise by the objector of its mark rights.*

6. Whether the applicant [respondent] has marks or other intellectual property rights in the sign corresponding to the gTLD, and, if so, whether any acquisition of such a right in the sign, and use of the sign, has been bona fide, and whether the purported or likely use of the gTLD by the applicant [respondent] is consistent with such acquisition or use.

7. Whether and to what extent the applicant [respondent] has been commonly known by the sign corresponding to the gTLD, and if so, whether any purported or likely use of the gTLD by the applicant [respondent] is consistent therewith and bona fide.

8. Whether the applicant's [respondent's] intended use of the gTLD would create a likelihood of confusion with the objector's mark as to the source, sponsorship, affiliation, or endorsement of the gTLD.]

[Where the Objection is based on rights in an IGO name or acronym, the Panel will consider the following non-exclusive factors:

1. Whether the applied-for gTLD is identical or similar, including in appearance, phonetic sound or meaning, to the name or acronym of the objecting IGO;

2. Historical coexistence of the IGO and the applicant's [respondent's] use of a similar name or acronym. Factors considered may include:

a. Level of global recognition of both entities;

b. Length of time the entities have been in existence;

c. Public historical evidence of their existence, which may include whether the objecting IGO has communicated its name or abbreviation under Article 6ter of the Paris Convention for the Protection of Industrial Property.

3. Whether and to what extent the applicant [respondent] has used, or has made demonstrable preparations to use, the sign corresponding to the TLD in connection with a bona fide offering of goods or services or a bona fide provision of information in a way that does not interfere with the legitimate exercise of the objecting IGO's name or acronym;

4. Whether and to what extent the applicant [respondent] has been commonly known by the sign corresponding to the applied-for gTLD, and if so, whether any purported or likely use of the gTLD by the applicant [respondent] is consistent therewith and bona fide; and

5. Whether the applicant's [respondent's] intended use of the applied for gTLD would create a likelihood of confusion with the objecting IGO's name or acronym as to the source, sponsorship, affiliation, or endorsement of the TLD.]]

A schedule and description listing all supporting evidence/documentation for Annexes [Annex number] through [Annex number] is attached.

## **VI. Panel (of Experts)**

(Procedure, art. 13; WIPO Rules for New gTLD Dispute Resolution, para. 8)

[13.] The Objector elects to have the dispute decided by a [choose **either**: "single-member Panel" / "three-member Panel"].

*[Please note that the appointment of a three-member Panel is contingent on party agreement; absent party agreement, a single-member Panel will be appointed. In the event all Parties agree to the appointment of a three-member Panel, any such agreement shall be communicated to the WIPO Center within five (5) calendar days of the WIPO Center's receipt of the Response filed in accordance with Procedure, art. 11 and WIPO Rules for New gTLD Dispute Resolution, para. 4(b). If the parties agree on the designation of a three-member Panel, the names of three experts must be provided by each party (jointly amongst Applicants/Respondents and/or Objectors in the event of consolidation) one of whom the WIPO Center would endeavor to appoint as the respective party-elected Co-Panelist. The names of such nominees must be taken from the WIPO Center's published list of experts [to be posted]. The WIPO Center would then endeavor to appoint the Presiding Panelist in accordance with WIPO Rules for New gTLD Dispute Resolution, para. 8.]*

## **VII. Other Legal Proceedings**

[14.] [Please identify any other legal proceedings of which you are aware that have been commenced or terminated in connection with the applied-for TLD that forms the basis for the Objection and summarize the issue(s) that is (are) the subject of those proceedings.]

## **VIII. Communications**

(Procedure, art. 6(b), 7(b))

[15.] A copy of this Objection has been sent electronically to the Applicant/Respondent on [date] by [indicate method(s) of communication and contact details used], and to ICANN on [date] by [indicate method(s) of communication and contact details used].

## **IX. Payment**

(Procedure, art. 8(c); WIPO Rules for New gTLD Dispute Resolution, para. 10; Annex D to WIPO Rules for New gTLD Dispute Resolution)

[16.] As required by the Procedure and WIPO Rules for New gTLD Dispute Resolution, payment in the amount of USD 10,000 has been made by [method]; evidence of such payment is provided as Annex [Annex number].

By submitting this Objection, the Objector acknowledges and agrees that further payments may be required, e.g., in the event the parties elect Determination by a three-member Panel, or as may otherwise be provided in the Procedure and WIPO Rules for New gTLD Dispute Resolution.

*[At the same time the Objection is filed, please include evidence of payment. If the filing fee is not paid (i.e., received by the WIPO Center) in full within ten (10) days of the WIPO Center's receipt of the Objection, the Objection will be dismissed without prejudice.]*

**X. Certification**

(Procedure, art. 1(d) and 22;  
WIPO Rules for New gTLD Dispute Resolution, para. 16)

- [17.] The Objector understands and agrees that its claims and remedies concerning the application of the applied-for TLD, the instant Legal Rights Objection and the Determination thereof shall be solely against the Applicant/Respondent, and neither the Expert(s)/Panel(ists), nor WIPO Center and its staff, nor ICANN and its Board members, employees and consultants shall be liable to any person for any act or omission in connection with any proceeding conducted under this Procedure.
- [18.] By submitting this Objection to the WIPO Center the Objector hereby agrees to abide and be bound by the provisions of the applicable New gTLD Dispute Resolution Procedure and WIPO Rules for New gTLD Dispute Resolution.
- [19.] The Objector certifies that the information contained in this Objection is to the best of the Objector's knowledge complete and accurate, that this Objection is not being presented for any improper purpose, such as to harass, and that the assertions in this Objection are warranted under the Procedure and under applicable law, as it now exists or as it may be extended by a good-faith and reasonable argument.

Respectfully submitted,

\_\_\_\_\_  
*[Name/Signature, Title]*

\_\_\_\_\_  
*[Month Day, Year]*

*[To avoid any doubt, please spell out the month]*

## **XI. Schedule of Annexes**

*[Please provide a schedule listing and describing any and all relevant supporting evidence or documentation as Annexes.]*

*[Please note that according to Procedure, Article 5(b), parties may submit supporting evidence in its original language, provided and subject to the authority of the Panel to determine otherwise, that such evidence is accompanied by a certified or otherwise official English translation of all relevant text.]*

*[Please note that according to Procedure, Article 6(a), all communications must be submitted electronically. A Party wishing to make a submission not in electronic form shall first request leave from the Panel, who shall in its sole discretion, determine whether to accept the non-electronic submission; prior to Panel appointment, parties are referred to Article 3(b) of the WIPO Rules for New gTLD Dispute Resolution.]*

[1.

2.

3.

etc.]



## **Annex 7**

# **WIPO Legal Rights Objection Model Response**

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## **RESPONSE TO LEGAL RIGHTS OBJECTION**

### **WIPO Model Form**

#### **(Annex C to WIPO Rules for New gTLD Dispute Resolution)**

This Legal Rights Objection model form Response must be used by parties wishing to file a Response to a Legal Rights Objection which has been filed with the World Intellectual Property Organization Arbitration and Mediation Center (“WIPO Center”) pursuant to the New gTLD Dispute Resolution Procedure (“Procedure”), provided as an Attachment to Module 3 of the gTLD Applicant Guidebook (“Applicant Guidebook”) (v. 2012-01-11) approved by the Internet Corporation for Assigned Names and Numbers (“ICANN”) on June 20, 2011 and as updated on January 11, 2012. The specific grounds on which a Legal Rights Objection may be filed are outlined in Applicant Guidebook Module 3, art. 3.5.2.

Upon filing, a copy of this Response must be provided to the Objector(s) and ICANN.

In accordance with the Applicant Guidebook and Procedure, the following information is publicly posted on the WIPO Center’s website:

- (i) the proposed string to which the Objection is directed;
- (ii) the names of the Objector and the Applicant/Respondent;
- (iii) the grounds for the Objection; and
- (iv) the date of the WIPO Center’s receipt of the Objection.

By submitting this Response to the WIPO Center the Applicant/Respondent hereby agrees to abide and be bound by the provisions of the Procedure and the World Intellectual Property Organization Rules for New gTLD Dispute Resolution for Existing Legal Rights Objections (“WIPO Rules for New gTLD Dispute Resolution”) in effect on the day when the relevant Application for a new gTLD was submitted, pursuant to Procedure, art. 1(d).

Pursuant to Procedure, art. 5 all submissions made in connection with this Procedure must be made in English; parties may submit supporting evidence in its original language, provided and subject to the authority of the Panel to determine otherwise, that such evidence is accompanied by a certified or otherwise official English translation of all relevant text.

*[In the event of any questions relating to the filing of a Response to a Legal Rights Objection which has been filed under the Procedure, parties are invited to contact the WIPO Center by email at [Iro@wipo.int](mailto:Iro@wipo.int), or by telephone to +41 22 338 8247 or (toll free) 0800 888 549.]*

**Before the:**

**WORLD INTELLECTUAL PROPERTY ORGANIZATION  
ARBITRATION AND MEDIATION CENTER**

[NAME OF OBJECTOR]

**(Objector)**

-v-

[NAME OF APPLICANT]

**(Applicant/Respondent)**

TLD string objected to: [*<EXAMPLE>*]

**RESPONSE TO LEGAL RIGHTS OBJECTION**

(Applicant Guidebook, Module 3; Procedure, art. 6, 11;  
WIPO Rules for New gTLD Dispute Resolution, para. 4)

**I. Introduction**

- [1.] This Response to a Legal Rights Objection is hereby submitted to the World Intellectual Property Organization Arbitration and Mediation Center (“WIPO Center”) for determination in accordance with the New gTLD Dispute Resolution Procedure (“Procedure”), provided as an Attachment to Module 3 of the gTLD Applicant Guidebook (“Applicant Guidebook”) approved by the Internet Corporation for Assigned Names and Numbers (“ICANN”) on June 20, 2011 and as updated on January 11, 2012, and the World Intellectual Property Organization Rules for New gTLD Dispute Resolution for Existing Legal Rights Objections (“WIPO Rules for New gTLD Dispute Resolution”) in effect on the day when the relevant Application for a new gTLD was submitted.

**II. Applicant/Respondent Contact Details**

(Procedure, art. 11(d)(i))

- [2.] The Applicant/Respondent in this proceeding is *[please provide the Applicant/Respondent’s full name and, if relevant, legal status, place of incorporation, and principal place of business]*.
- [3.] The Applicant/Respondent’s contact details are:

Address: *[mailing address]*  
Phone: *[phone number]*  
E-mail: *[e-mail address]*  
Fax: *[fax number]*

[4.] The Applicant/Respondent's authorized representative in this proceeding is:

Name: [full name]  
Address: [mailing address]  
Phone: [phone number]  
E-mail: [e-mail address]  
Fax: [fax number]

[5.] The Applicant/Respondent's preferred contact details for purposes of this proceeding are:

For electronic-only material

Method: e-mail  
Address: [Specify one e-mail address]  
Contact: [Identify name of one contact person]

For any hardcopy\* material

Method: [Specify one: fax, post/courier]  
Address: [Specify one address, if applicable]  
Fax: [Specify one fax number]  
Contact: [Identify name of one contact person]

*[ \* Please note that according to Procedure, Article 6(a), all communications must be submitted electronically. A Party wishing to make a submission not in electronic form shall first request leave from the Panel, who shall in its sole discretion, determine whether to accept the non-electronic submission; prior to Panel appointment, parties are referred to Article 3(b) of the WIPO Rules for New gTLD Dispute Resolution.]*

*[Please note that in accordance with Procedure, art. 7(d)(ii) in the event the Applicant/Respondent wishes to file multiple Responses to multiple Objections, each Response must be filed separately, and accompanied by the appropriate filing fees.]*

### **III. TLD string objected to (applied-for TLD string):**

(Procedure, art. 7, 11)

[6.] This Response concerns the applied-for TLD string identified below:

[<.EXAMPLE>]

*[NOTE: in case of any doubt, e.g., where certain numbers or letters may appear similar depending on the font used (e.g., the number "1" and the lower-case letter "l"), please confirm the exact nature/characters of the string being objected to.]*

### **IV. Jurisdictional Basis for the Response**

(Procedure, art. 1(d), 4(b)(ii))

[7.] By applying for a new gTLD, and by filing the present Response to a Legal Rights Objection, the Applicant/Respondent has accepted the applicability of the Procedure and the WIPO Rules for New gTLD Dispute Resolution.

Having filed its Objection, the Objector has accepted the applicability of this Procedure and the WIPO Rules for New gTLD Dispute Resolution.

The parties cannot derogate from the Procedure without the express approval of ICANN and from the WIPO Rules for New gTLD Dispute Resolution without the express approval of the WIPO Center.

## **V. Factual and Legal Grounds**

(Applicant Guidebook Module 3, art. 3.5.2; Procedure, art. 11)

*[This section of the Response may not exceed 5,000 words or 20 pages, whichever is less, excluding attachments (Procedure, art. 11(e)). Pursuant to Procedure, art. 6(a), any relevant supporting evidence or documentation must be submitted electronically as Annexes with an accompanying schedule listing and describing all Annexes. For any cases or other legal documentation cited in support of the Response, please use a full legal citation, e.g., in the format predominantly used or accepted in your jurisdiction.]*

[8.] The Applicant's/Respondent's relevant rights on which its applied-for TLD and Response is based are:

*[Please specify the relevant rights, if any, being invoked. Such rights may include any rights (trademark, service mark, or Intergovernmental Organization (IGO) name or acronym) on which the applied-for TLD and/or Response is based; in such case, please describe the goods or services the mark, or the activity the IGO name or acronym, is used in connection with. If applicable, please attach as Annexes copies of the registration certificates for the relevant marks.]*

[9.] This Response is valid and should be upheld for the following reasons:  
(Applicant Guidebook, art. 3.5.2; Procedure, art. 11(d)(ii))

The potential use of the applied-for gTLD by the Applicant/Respondent does not

[(i) take unfair advantage of the distinctive character or the reputation of the Objector's registered or unregistered trademark or service mark ("mark") or IGO name or acronym (as identified in the treaty establishing the organization)], and/or

[(ii) unjustifiably impair the distinctive character or the reputation of the Objector's mark or IGO name or acronym], and/or

[(iii) otherwise create an impermissible likelihood of confusion between the [Applicant's/Respondent's] applied-for gTLD and the Objector's mark or IGO name or acronym].

*[Please provide a point-by-point response to the statements made in the Objection, i.e., why the Applicant/Respondent believes the Response should be upheld, and the Objection denied; this may include reference to the following, non-exclusive consideration factors:*

*[Where the Objection is based on trademark rights, the Panel will consider the following non-exclusive factors:*

1. *Whether the applied-for gTLD is identical or similar, including in appearance, phonetic sound, or meaning, to the objector's existing mark.*
2. *Whether the objector's acquisition and use of rights in the mark has been bona fide.*
3. *Whether and to what extent there is recognition in the relevant sector of the public of the sign corresponding to the gTLD, as the mark of the objector, of the applicant [respondent] or of a third party.*
4. *Applicant's [respondent's] intent in applying for the gTLD, including whether the applicant [respondent], at the time of application for the gTLD, had knowledge of the objector's mark, or could not have reasonably been unaware of that mark, and including whether the applicant [respondent] has engaged in a pattern of conduct whereby it applied for or operates TLDs or registrations in TLDs which are identical or confusingly similar to the marks of others.*
5. *Whether and to what extent the applicant [respondent] has used, or has made demonstrable preparations to use, the sign corresponding to the gTLD in connection with a bona fide offering of goods or services or a bona fide provision of information in a way that does not interfere with the legitimate exercise by the objector of its mark rights.*
6. *Whether the applicant [respondent] has marks or other intellectual property rights in the sign corresponding to the gTLD, and, if so, whether any acquisition of such a right in the sign, and use of the sign, has been bona fide, and whether the purported or likely use of the gTLD by the applicant [respondent] is consistent with such acquisition or use.*
7. *Whether and to what extent the applicant [respondent] has been commonly known by the sign corresponding to the gTLD, and if so, whether any purported or likely use of the gTLD by the applicant [respondent] is consistent therewith and bona fide.*
8. *Whether the applicant's [respondent's] intended use of the gTLD would create a likelihood of confusion with the objector's mark as to the source, sponsorship, affiliation, or endorsement of the gTLD.]*

*[Where the Objection is based on rights in an IGO name or acronym, the Panel will consider the following non-exclusive factors:*

1. *Whether the applied-for gTLD is identical or similar, including in appearance, phonetic sound or meaning, to the name or acronym of the objecting IGO;*
2. *Historical coexistence of the IGO and the applicant's [respondent's] use of a similar name or acronym. Factors considered may include:*
  - a. *Level of global recognition of both entities;*
  - b. *Length of time the entities have been in existence;*
  - c. *Public historical evidence of their existence, which may include whether the objecting IGO has communicated its name or abbreviation under Article 6ter of the Paris Convention for the Protection of Industrial Property.*
3. *Whether and to what extent the applicant [respondent] has used, or has made demonstrable preparations to use, the sign corresponding to the TLD in connection with a bona fide offering of goods or services or a bona fide provision of information in*

a way that does not interfere with the legitimate exercise of the objecting IGO's name or acronym;

4. Whether and to what extent the applicant [respondent] has been commonly known by the sign corresponding to the applied-for gTLD, and if so, whether any purported or likely use of the gTLD by the applicant [respondent] is consistent therewith and bona fide; and

5. Whether the applicant's [respondent's] intended use of the applied for gTLD would create a likelihood of confusion with the objecting IGO's name or acronym as to the source, sponsorship, affiliation, or endorsement of the TLD.]]

A schedule and description listing all supporting evidence/documentation for Annexes [Annex number] through [Annex number] is attached.

#### **VI. Panel (of Experts)**

(Procedure, art. 13; WIPO Rules for New gTLD Dispute Resolution, para. 8)

[10.] The Applicant/Respondent elects to have the dispute decided by a [choose **either**: "single-member Panel" / "three-member Panel"].

*[Please note that the appointment of a three-member Panel is contingent on party agreement; absent party agreement, a single-member Panel will be appointed. In the event all Parties agree to the appointment of a three-member Panel, any such agreement shall be communicated to the WIPO Center within five (5) calendar days of the WIPO Center's receipt of the Response filed in accordance with Procedure, art. 11 and WIPO Rules for New gTLD Dispute Resolution, para. 4(b). If the parties agree on the designation of a three-member Panel, the names of three experts must be provided by each party (jointly amongst Applicants/Respondents and/or Objectors in the event of consolidation) one of whom the WIPO Center would endeavor to appoint as the respective party-elected Co-Panelist. The names of such nominees may be taken from the WIPO Center's published list of experts [to be posted]. The WIPO Center would then endeavor to appoint the Presiding Panelist in accordance with WIPO Rules for New gTLD Dispute Resolution, para. 8.]*

#### **VII. Other Legal Proceedings**

[11.] [Please identify any other legal proceedings of which you are aware that have been commenced or terminated in connection with the applied-for TLD that forms the basis for the Objection and the Response thereto and summarize the issue(s) that is (are) the subject of those proceedings.]

#### **VIII. Communications**

(Procedure, art. 6(b), 11(c))

[12.] A copy of this Response has been sent electronically to the Objector on [date] by [indicate method(s) of communication and contact details used], and to ICANN on [date] by [indicate method(s) of communication and contact details used].

### **IX. Payment**

(Procedure, art. 11(f); WIPO Rules for New gTLD Dispute Resolution, para. 10;  
Annex D to WIPO Rules for New gTLD Dispute Resolution)

- [13.] As required by the Procedure and WIPO Rules for New gTLD Dispute Resolution, payment in the amount of USD 10,000 has been made by *[method]*; evidence of such payment is provided as Annex *[Annex number]*.

By submitting this Response, the Applicant/Respondent acknowledges and agrees that further payments may be required, e.g., in the event the parties elect Determination by a three-member Panel, or as may otherwise be provided in the Procedure and WIPO Rules for New gTLD Dispute Resolution.

*[At the same time the Response is filed, please include evidence of payment. If the filing fee is not paid (i.e., received by the WIPO Center) in full within ten (10) days of the WIPO Center's receipt of the Response, the Response will be dismissed without prejudice.]*

### **X. Certification**

(Procedure, art. 1(d) and 22;  
WIPO Rules for New gTLD Dispute Resolution, para. 16)

- [14.] The Applicant/Respondent understands and agrees that its claims and remedies concerning this proceeding in relation to the applied-for TLD, the instant Response to a Legal Rights Objection and the Determination thereof shall be solely against the Objector, and neither the Expert(s)/Panel(ists), nor WIPO and its staff, nor ICANN and its Board members, employees and consultants shall be liable to any person for any act or omission in connection with any proceeding conducted under this Procedure.
- [15.] By submitting this Response to a Legal Rights Objection to the WIPO Center the Applicant/Respondent hereby agrees to abide and be bound by the provisions of the applicable New gTLD Dispute Resolution Procedure and WIPO Rules for New gTLD Dispute Resolution.
- [16.] The Applicant/Respondent certifies that the information contained in this Response is to the best of the Applicant's/Respondent's knowledge complete and accurate, that this Response is not being presented for any improper purpose, such as to harass, and that the assertions in this Response are warranted under the Procedure and under applicable law, as it now exists or as it may be extended by a good-faith and reasonable argument.

Respectfully submitted,

\_\_\_\_\_  
*[Name/Signature, Title]*

\_\_\_\_\_  
*[Month Day, Year]*

*[To avoid any doubt, please spell out the month]*



## **XI. Schedule of Annexes**

*[Please provide a schedule listing and describing any and all relevant supporting evidence or documentation as Annexes.]*

*[Please note that according to Procedure, Article 5(b), parties may submit supporting evidence in its original language, provided and subject to the authority of the Panel to determine otherwise, that such evidence is accompanied by a certified or otherwise official English translation of all relevant text.]*

*[Please note that according to Procedure, Article 6(a), all communications must be submitted electronically. A Party wishing to make a submission not in electronic form shall first request leave from the Panel, who shall in its sole discretion, determine whether to accept the non-electronic submission; prior to Panel appointment, parties are referred to Article 3(b) of the WIPO Rules for New gTLD Dispute Resolution.]*

- [1.
- 2.
- 3.
- etc.]

## **Annex 8**

# **WIPO Legal Rights Objection Expert Panel Statement of Acceptance and Declaration of Impartiality and Independence**

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**STATEMENT OF ACCEPTANCE**  
**AND**  
**DECLARATION OF IMPARTIALITY AND INDEPENDENCE**

Case Number: [number]

I, the undersigned, \_\_\_\_\_ (Last Name, First Name),

[ ] hereby declare that I accept to serve as an Expert in accordance with the World Intellectual Property Organization (WIPO) Rules for New gTLD Dispute Resolution for Existing Legal Rights Objections ("WIPO Rules for New gTLD Dispute Resolution") in effect as of June 20, 2011 and the New gTLD Dispute Resolution Procedure ("Procedure"), provided as an Attachment to Module 3 of the gTLD Applicant Guidebook ("Applicant Guidebook") (v. 2012-01-11) approved by the Internet Corporation for Assigned Names and Numbers ("ICANN") on June 20, 2011 and as updated on January 11, 2012. By making this declaration, I confirm that I have familiarized myself with the principles, standards, requirements and fees set out in the aforementioned instruments and that I am available to serve as an Expert in accordance therewith. I further declare that, by accepting to serve as an Expert in this case, I shall execute my responsibilities honestly, fairly and within the time periods required by the WIPO Rules for New gTLD Dispute Resolution and the Procedure.

[ ] hereby agree that, unless required by a court of law or authorized in writing by the parties, by undertaking to act as an Expert in the above-captioned case, I will not act in any capacity whatsoever, in any pending or future proceedings, whether judicial, arbitral or otherwise, relating to the matter referred to expert determination under the Procedure.

[ ] hereby agree that, if at any stage during the above-captioned case, as conducted under the Procedure, circumstances arise that might give rise to justifiable doubt as to my impartiality or independence as an Expert, I will promptly disclose such circumstances to the parties and the WIPO Center.

Please check the appropriate box below, taking into consideration, *inter alia*, whether there exists any past or present relationship, direct or indirect, with either of the parties, whether financial, professional or of another kind and whether the nature of any such relationship is such that disclosure is called for.  
***[Any doubt should be resolved in favor of disclosure.]***

[ ] I am independent of each the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as they might be of such a nature as to call in to question my independence in the eyes of one or both of the parties.

[ ] I am independent of each of the parties. However, I wish to disclose the circumstances described in the attachment hereto (attach separate sheet) as they might be of such a nature as to call in to question my independence in the eyes of one or both of the parties.

[ ] hereby declare that I decline to serve as an Expert in the present case. (Disclosure of the reasons for declining to accept the appointment may be made on a separate sheet and attached hereto.)

Signature: \_\_\_\_\_

Place: \_\_\_\_\_

Date: \_\_\_\_\_

## **Annex 9**

# **WIPO Legal Rights Objection Frequently Asked Questions**

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## Frequently Asked Questions

- [What is a Legal Rights Objection?](#)
- [Does ICANN offer other types of objection options?](#)
- [What criteria will a panel use to determine the outcome of a Legal Rights Objection?](#)
- [Until when can a Legal Rights Objection be filed?](#)
- [How does a rights owner submit a Legal Rights Objection?](#)
- [Is it necessary for an applicant to file a response to a Legal Rights Objection?](#)
- [What are the main stages of a Legal Rights Objection?](#)
- [How many rounds of pleadings are involved?](#)
- [Are there hearings?](#)
- [Can the parties mediate/settle their dispute?](#)
- [How much does it cost to file/defend a Legal Rights Objection?](#)
- [Are there language requirements?](#)
- [Are there word/page limits?](#)
- [Who are the experts available for appointment?](#)
- [How is the expert panel appointed?](#)
- [What are the remedies available?](#)
- [What happens if there is more than one Objection to an applied-for New gTLD?](#)
- [What level of Objection-related information is made publicly available?](#)
- [Do parties retain their court options?](#)
- [What is the WIPO Center's role in Legal Rights Objections?](#)
- [Background on WIPO's involvement in Legal Rights Objections](#)
- [What trademark protection mechanisms are available after new gTLDs are approved?](#)
- [Additional information on WIPO's involvement in the Domain Name System](#)
- [Questions?](#)

## **What is a Legal Rights Objection?**

Prior to ICANN’s approval of a New gTLD, third parties may file a formal objection to an application on several grounds, including, for trademark owners and Intergovernmental Organizations (IGOs), on the basis of a “Legal Rights Objection.”

When such an objection is filed, an independent panel (comprised of one or three experts) will determine whether the applicant’s potential use of the applied-for gTLD would be likely to infringe (described below) the objector’s existing trademark, or IGO name or acronym.

According to the ICANN Applicant Guidebook, a panel determination is "considered an expert determination and advice that ICANN will accept within the dispute resolution process." Such determination is independent of any determination under either of the other types of ICANN objection options available.

## **Does ICANN offer other types of objection options?**

To address potential disputes over new gTLD applications, ICANN offers three other types of pre-delegation objection-based dispute resolution procedures which are not administered by WIPO, namely, “String Confusion Objection,” “Limited Public Interest Objection,” and “Community Objection.” For the latter two types of objections, ICANN is also making available an “Independent Objector” by way of public service. ICANN has furthermore established a process for the ICANN Governmental Advisory Committee (GAC) to provide “GAC Advice on New gTLDs” concerning applications identified by governments as problematic. For more detailed information on all ICANN objection options, see [Module 3](#) of the ICANN Applicant Guidebook.

## **What criteria will a panel use to determine the outcome of a Legal Rights Objection?**

As provided for in section 3.5.2 of the ICANN Applicant Guidebook, the independent panel will determine whether the potential use of the applied-for gTLD by the applicant:

- (i) takes unfair advantage of the distinctive character or the reputation of the objector’s registered or unregistered trademark or service mark (“mark”) or IGO name or acronym, or
- (ii) unjustifiably impairs the distinctive character or the reputation of the objector’s mark or IGO name or acronym, or

(iii) otherwise creates an impermissible likelihood of confusion between the applied-for gTLD and the objector's mark or IGO name or acronym.

The panel will ordinarily determine the merits of the objection based solely on the parties' pleadings, and may make reference to a range of non-exclusive consideration factors listed below.

**For an objection based on trademark rights, the panel will consider the following non exclusive consideration factors:**

1. Whether the applied-for gTLD is identical or similar, including in appearance, phonetic sound, or meaning, to the objector's existing mark.
2. Whether the objector's acquisition and use of rights in the mark has been bona fide.
3. Whether and to what extent there is recognition in the relevant sector of the public of the sign corresponding to the gTLD, as the mark of the objector, of the applicant or of a third party.
4. Applicant's intent in applying for the gTLD, including whether the applicant, at the time of application for the gTLD, had knowledge of the objector's mark, or could not have reasonably been unaware of that mark, and including whether the applicant has engaged in a pattern of conduct whereby it applied for or operates TLDs or registrations in TLDs which are identical or confusingly similar to the marks of others.
5. Whether and to what extent the applicant has used, or has made demonstrable preparations to use, the sign corresponding to the gTLD in connection with a bona fide offering of goods or services or a bona fide provision of information in a way that does not interfere with the legitimate exercise by the objector of its mark rights.
6. Whether the applicant has marks or other intellectual property rights in the sign corresponding to the gTLD, and, if so, whether any acquisition of such a right in the sign, and use of the sign, has been bona fide, and whether the purported or likely use of the gTLD by the applicant is consistent with such acquisition or use.
7. Whether and to what extent the applicant has been commonly known by the sign corresponding to the gTLD, and if so, whether any purported or likely use of the gTLD by the applicant is consistent therewith and bona fide.
8. Whether the applicant's intended use of the gTLD would create a likelihood of confusion with the objector's mark as to the source, sponsorship, affiliation, or endorsement of the gTLD.

**For an objection based on rights in the name or acronym of an IGO, the panel will consider the following non-exclusive consideration factors:**

1. Whether the applied-for gTLD is identical or similar, including in appearance, phonetic sound or meaning, to the name or acronym of the objecting IGO.

2. Historical coexistence of the IGO and the applicant's use of a similar name or acronym. Factors considered may include: a. Level of global recognition of both entities; b. Length of time the entities have been in existence; c. Public historical evidence of their existence, which may include whether the objecting IGO has communicated its name or abbreviation under Article 6ter of the Paris Convention for the Protection of Industrial Property.
3. Whether and to what extent the applicant has used, or has made demonstrable preparations to use, the sign corresponding to the TLD in connection with a bona fide offering of goods or services or a bona fide provision of information in a way that does not interfere with the legitimate exercise of the objecting IGO's name or acronym.
4. Whether and to what extent the applicant has been commonly known by the sign corresponding to the applied-for gTLD, and if so, whether any purported or likely use of the gTLD by the applicant is consistent therewith and bona fide.
5. Whether the applicant's intended use of the applied-for gTLD would create a likelihood of confusion with the objecting IGO's name or acronym as to the source, sponsorship, affiliation, or endorsement of the TLD.

### [Until when can a Legal Rights Objection be filed?](#)

Subsequent to ICANN's closing of its new gTLD application window (which ran from January 12 to May 30, 2012), and announcement/posting of all applications, the objection filing window commenced on June 13, 2012.

The objection filing window was nine months and closed on **13 March 2013 at 23:59:59 UTC**.

Concurrent with the objection filing window, ICANN is undertaking so-called Initial Evaluation of applications for compliance with ICANN Applicant Guidebook formalities; ICANN has indicated that they plan to release the first of the Initial Evaluations on March 23, 2013, with further Initial Evaluations released on a rolling basis thereafter based on Prioritization Draw results.

### [How does a rights owner submit a Legal Rights Objection?](#)

All Legal Rights Objections had to be submitted electronically by email to [lro@wipo.int](mailto:lro@wipo.int) using the WIPO Center's [LRO Model Objection](#) with a copy of the objection to ICANN and the applicant. The objection filing had to be submitted at the time of filing.



An objection must contain at least the following: (i) the names and full contact information of the objector; (ii) a statement of the objector's basis for standing under the procedure; and (iii) a confirmation of the basis for the objection (i.e., "Legal Rights Objection") including "an explanation of the validity of the objection and why the objection should be upheld."

### **Is it necessary for an applicant to file a response to a Legal Rights Objection?**

Responses must be submitted electronically to the WIPO Center by email to [lro@wipo.int](mailto:lro@wipo.int) using the WIPO Center's [LRO Model Response](#) with a copy to ICANN and the objector. The response filing fee must be submitted at the time of filing of the response.

A response must contain at least the following: (i) the names and full contact information of the applicant; and (ii) a "point-by-point response to the statements made in the objection." An applicant's failure to reply to an objection would be considered a "default" and would result in the objection being deemed successful.

### **What are the main stages of a Legal Rights Objection?**

On receipt of an objection or response, the WIPO Center will conduct an administrative compliance review and process the case filing fee. Any administrative deficiencies must be corrected within five (5) days of notification by the Center. Within 30 days of the close of the objection window, ICANN will publish a "Dispute Announcement" listing all administratively compliant objections. The WIPO Center will then notify applicants of any objections; applicants will then have 30 days to file a response. Within 30 days of receiving a response, the WIPO Center will appoint the expert panel. Normally the panel will render its determination within 45 days of appointment.

A graphic overview is provided by the respective "[Objection and Dispute Resolution](#)" and "[Evaluation Process](#)" flow charts found in the ICANN Applicant Guidebook.

### **How many rounds of pleadings are involved?**

While the panel has discretion to order or admit additional written statements, the ICANN dispute resolution procedure typically contemplates a single round of pleadings.

## **Are there hearings?**

Only in exceptional cases may a panel hold a hearing (by videoconference if possible).

## **Can the parties mediate/settle their dispute?**

In the event the parties wish to participate in mediation/settlement negotiations, at any point during the proceedings, they may jointly request a 30-day suspension. The WIPO Center can assist the parties in finding an appropriately qualified mediator to help the parties in seeking to reach a mutually satisfactory settlement of their dispute, under the [WIPO Mediation Rules](#). In such event, the WIPO Center will not charge any additional fee for its mediation case administration services.

## **How much does it cost to file/defend a Legal Rights Objection?**

For a case involving an objection to one application (i.e., for one gTLD) to be decided by one expert, the fee payable upon filing will be USD 10,000 for each party (this includes a non-refundable USD 2,000 case administration fee), subject to a refund of the expert fee (USD 8,000) to the prevailing party. Different fee arrangements apply to three-member panels and to possible consolidation scenarios; full details are provided in the [WIPO Schedule of Fees for New gTLD Dispute Resolution](#).

For all objections and responses filed with WIPO, the initial fee to be paid at the time of filing of the objection or response is 10,000 (which covers the WIPO DRSP fee and Panel fee). Any applicable reduced Panel fees specified below (i.e. where a consolidation scenario is applied by WIPO in accordance with the WIPO Rules for New gTLD Dispute Resolution), would be refunded to the appropriate party from the initial filing fee, after the close of proceedings.

Payments may be made by any of the following means: bank transfer, credit card, WIPO Account. Please see the [Schedule of Fees and Costs: New gTLD Pre-Delegation Legal Rights Objection Procedure](#) for more details.

*Non-payment of fees by an objector will result in rejection of the objection, without panel appointment. Non payment of response fees by an applicant will result in the objection being deemed successful.*

## **Are there language requirements?**

In all cases, the language of proceedings is English. According to the ICANN Applicant Guidebook, "Parties may submit supporting evidence in its original language, provided and subject to the authority of the Panel to determine otherwise, that such evidence is accompanied by a certified or otherwise official English translation of all relevant text."

## **Are there word/page limits?**

The substantive portion of an objection or response is limited to 5,000 words or 20 pages, whichever is less, excluding attachments. The objector or applicant must also list, describe and provide copies of any attached supporting evidence.

## **Who are the experts available for appointment?**

The WIPO Center has posted a [list of experts](#) available for appointment prior to the start of the objection filing period. This list takes into account requirements of professional expertise and may be subject to additional development by the WIPO Center in light of case needs. As part of the process of appointment to an actual case, experts are required to affirm their neutrality by signing the WIPO Center's [LRO Statement of Acceptance and Declaration of Impartiality and Independence](#).

## **How is the expert panel appointed?**

Unless the parties agree on a three-member expert panel, for a single-member expert panel the WIPO Center will appoint the expert in its sole discretion. Where the parties agree on a three member expert panel, each party may submit a list of three candidates from the WIPO Center's list of experts, one of whom would be appointed as the respective party-elected expert co-panelist; the WIPO Center will then provide the parties with a list of five candidates from the WIPO Center's list of experts for the parties' respective ranking, with a view to the WIPO Center's appointment of the third (presiding) expert panelist.

## **What are the remedies available?**

The remedies are limited to the success or dismissal of the objection. There are no monetary damages, but the prevailing party is entitled to a partial refund of the panel fee (as described above). According to the ICANN Applicant Guidebook, a panel determination is "considered an expert determination and advice that ICANN will accept

within the dispute resolution process." Such determination is independent of any determination under either of the other types of ICANN objection options available.

### **What happens if there is more than one Objection to an applied-for New gTLD?**

In certain scenarios, such as where multiple objections are filed against the same application, to streamline costs and for procedural efficiency, the WIPO Center will endeavor where appropriate to consolidate such objections for determination by a single panel; in such consolidated cases, a separate determination would be rendered for each objection. Within seven days of the WIPO Center's notification of the commencement of the response filing period to the applicant, the parties themselves may also propose, for the WIPO Center's determination, in its discretion, that objections be consolidated. The WIPO Center may take into account factors such as whether the same or similar application is at issue; any request/opposition of the parties; the trademarks/evidence relied-upon; or expert availability.

### **What level of Objection-related information is made publicly available?**

Upon registering an objection for processing, the WIPO Center will post on its [website](#) the following information about the objection: the proposed string to which the objection is directed; the names of the objector and applicant; the grounds for objection (i.e., "Legal Rights Objection"); and the date of the WIPO Center's receipt of the objection.

On conclusion of a case the WIPO Center will post the determination in full on its website, unless in exceptional circumstances the panel has deemed it appropriate to redact portions of its determination.

### **Do parties retain their court options?**

The availability of the Legal Rights Objection as an administrative dispute resolution option does not preclude court options which either party may have to submit the dispute to court.

### **What is the WIPO Center's role in Legal Rights Objections?**

The WIPO Center's role is limited to case administration, including verifying that the objection and response satisfy the relevant filing requirements, issuing case related notifications, appointment of the panel of experts, coordinating communications

between the parties and panel, and otherwise facilitating efficient case resolution. The WIPO Center is independent and impartial in this case administration role; the merits of an objection are determined by the appointed expert.

### **Background on WIPO's involvement in Legal Rights Objections**

In December 2007, ICANN sought "Expressions of Interest from Potential Dispute Resolution Service Providers for [its] New gTLD Program." In January 2008, the WIPO Center signaled its readiness to assist ICANN in devising and applying appropriate trademark-based dispute resolution procedures for New gTLDs. From that time, using the WIPO "[Joint Recommendation Concerning Provisions on the Protection of Marks, and Other Industrial Property Rights in Signs, on the Internet](#)" as a foundation, the WIPO Center has collaborated with ICANN on the development of substantive criteria and procedural rules for pre-(TLD) delegation dispute resolution for trademark-based Legal Rights Objections as set out in [module 3.5.2 of the ICANN Applicant Guidebook](#). The WIPO Center subsequently accepted to administer disputes under the ICANN [Legal Rights Objection Procedure](#); the ICANN Applicant Guidebook includes the resulting [WIPO Rules for New gTLD Dispute Resolution](#) including a [Schedule of Fees and Costs](#).

### **What trademark protection mechanisms are available after new gTLDs are approved?**

Beyond the above-described pre-delegation objection procedures (available prior to any new gTLD being approved and becoming operational), ICANN has established a range of "Rights Protection Mechanisms" (RPMs). These include a Trademark Clearinghouse (for use in connection with Sunrise periods and Trademark Claims services), a Uniform Rapid Suspension system (URS), and a Post-Delegation Dispute Resolution Procedure (PDDRP). In addition, the existing Uniform Domain Name Dispute Resolution Policy ([UDRP](#)) will be applicable to all new gTLDs. More information on these RPMs can be found in the WIPO Center's overview of [Trademark Rights Protection Mechanisms for New gTLDs](#).

### **Additional information on WIPO's involvement in the Domain Name System**

WIPO has been engaging with Alternative Dispute Resolution (ADR) for the Domain Name System (DNS) since it conducted the [First WIPO Internet Domain Name Process](#) in 1998 and 1999, which provided the blueprint for ICANN's adoption of the

UDRP. With a globally unique range of jurisprudential [resources](#), the WIPO Arbitration and Mediation Center is the leading provider of UDRP case administration services; through 2011, it has processed over 22,000 such cases. The Center furthermore has engaged in a range of further activities such as [Sunrises](#), [ccTLD policy advice and case administration](#), and [policy input for New gTLDs](#).

- [WIPO Observations on New gTLD Dispute Resolution Mechanisms](#)
- [Selected WIPO correspondence with ICANN](#)
- [Domain Name Disputes \(including UDRP\)](#)

### **Questions?**

For more information about the Legal Rights Objection procedure, please direct any inquiries by email to [lro@wipo.int](mailto:lro@wipo.int), or by telephone to +41 22 338 8247 or (toll free) 0800 888 549. More detailed information can be found in the ICANN [Applicant Guidebook](#).