**ORGANISATION MONDIALE
DE LA PROPRIÉTÉ INTELLECTUELLE**

Centre d'arbitrage et de médiation de l'OMPI

**WORLD INTELLECTUAL
PROPERTY ORGANIZATION**

WIPO Arbitration and Mediation Center

RECEIVED JUL 23 2004

July 14, 2004

Dear Mr. Twomey,

As you know, the World Intellectual Property Organization (WIPO) is cooperating, in various ways, with ICANN since its establishment on a wide range of intellectual property-related questions. I am pleased that any issues that have arisen in the process could always be resolved through effective communication.

It is in this spirit that I contact you to express concern regarding a number of issues where, I feel, our interaction perhaps has not been as efficient as it could be. These issues relate, notably, to the recommendations made by WIPO as a result of the Second WIPO Internet Domain Name Process (WIPO II Recommendations), as well as a perceived lack of effectiveness in support of a proper functioning of the Uniform Domain Name Dispute Resolution Policy (UDRP).

Like the First WIPO Internet Domain Name Process underlying the establishment of the UDRP, the WIPO II Recommendations are the result of a comprehensive international consultation process involving both the Member States of WIPO as well as the "Internet community." In addition, they have been unanimously endorsed by the Governmental Advisory Committee of ICANN (GAC). The recommendations are limited to two types of identifiers, country

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Mr. Paul Twomey, President and CEO, Internet Corporation for Assigned Names and Numbers (ICANN), Marina del Rey – July 14, 2004

names and the names and acronyms of International Organizations (IGOs), and accommodate potentially competing interests. As presented in a submitted draft, only limited modifications to the UDRP would be required.

WIPO staff have participated in various ICANN fora to explain the WIPO II Recommendations and to offer implementation options. This includes most notably the WIPO II Working Group which you established last fall to discuss the practical and technical aspects of implementing the WIPO II Recommendations. As it turns out, discussions in this group focused on the desirability of implementation rather than on implementation itself, and the same is to be expected of the group's final report.

While I appreciate the importance of open, representative and transparent processes – WIPO has wide experience in this regard – I am sure you will agree that such processes should be results-oriented, and that those results should give due weight to the relative importance of the actors involved. We shall be delighted to further participate actively in ICANN processes that meet these objectives.

In the area of case administration under the UDRP, we have repeatedly experienced problems with a number of ICANN-accredited registrars who demonstrably fail to comply with their express obligations under ICANN's Registrar Accreditation Agreement. As a dispute resolution provider, we must rely, at several stages of a UDRP procedure, on the cooperation of registrars who are required, for example, to incorporate the UDRP in their registration agreements, confirm registration data, lock disputed domain names, and implement transfer decisions in accordance with the applicable rules. In order to assist ICANN's supervisory function in this regard, we have always shared with ICANN staff the specific difficulties encountered at each of the above stages; I attach our latest notices for your information. I hope that the assurances we received will be matched by effective follow-up.

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WIPO is committed to maintaining a balanced and efficient protection of intellectual property in the domain name space and I wish to assure you that we shall continue to provide our input and advice on these matters where required.

I look forward to our continued cooperation.

With best regards,

Yours sincerely,

Francis Gurry
Deputy Director General

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Centre d'arbitrage et de médiation de l'OMPI

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WIPO Arbitration and Mediation Center

June 22, 2004

Dear Mr. Halloran,

Reference is made to the WIPO Arbitration and Mediation Center's letter of March 22, 2004, in which we confirmed a number of UDRP-related issues that require ICANN's urgent intervention. While we are pleased to note that one of the issues raised, namely the listing of WIPO UDRP cases on ICANN's website, has been resolved, we would, in the interest of a proper functioning of the UDRP, appreciate receiving an indication as to the status of ICANN's follow-up on the other listed issues.

Thank you and we look forward to your reply.

Yours sincerely,

Erik Wilbers
Acting Director
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March 22, 2004

Dear Mr. Halloran,

Please find summarized below UDRP-related issues that require ICANN's urgent intervention. As you know, many of these have been raised with ICANN on a number of occasions in the past. When my colleague, Mr. Christian Wichard, most recently raised them with you during the ICANN Rome meeting, you requested us to list all such issues again in writing.

1.   ICANN Case Listing •

We have recently learned that UDRP cases filed with the WIPO Arbitration and Mediation Center (the "Center"), and the decisions duly rendered, since September 2003, are not listed on ICANN's website, whereas the cases filed with NAF and ADNDRC are listed (*http://icann.org/udrp/proceedings-list.htm*). We have been communicating with your colleague, Ms. Jennifer Rodriguez, on this matter but wish to draw your attention to this in order to urgently rectify the situation. As mentioned to Ms. Rodriguez, WIPO's technical staff is ready to work together with ICANN's staff to achieve an automated option for case listing that would benefit both ICANN and WIPO. Pending the introduction of such an automated option, we believe the backlog should be listed immediately.

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Mr. Dan Halloran, Chief Registrar Liaison, Internet Corporation for Assigned
Names and Numbers, Marina del Rey – March 22, 2004

2.   Mutual Jurisdiction

As part of the provider's review of a UDRP complaint for administrative
compliance with the UDRP Policy and the Rules (Rules, Para. 4(a)), the Center
examines whether the Complaint states that the Complainant will submit to the
jurisdiction of the courts in at least one specified mutual jurisdiction
(Rules, Para. 3(b)(xiii)). The majority of complaints filed with the Center choose
the location of the principal office of the registrar as the mutual jurisdiction. It is
the Center's practice (we are not aware of other providers' practice in this regard)
to confirm that the respondent submitted in its domain name registration
agreement with the registrar to that jurisdiction for court adjudication of disputes
concerning or arising from the use of the domain name. (See parenthetical
phrase in the definition of "Mutual Jurisdiction" in UDRP Rules, Para. 1.)

As we have raised on a number of occasions in the past, a number of
ICANN accredited registrars do not provide for such submission by the domain
name registrant in the registration agreement. The absence of the appropriate
jurisdiction submission clause carries important legal consequences for the
integrity of a UDRP process.

The UDRP Policy and Rules provide for "mutual jurisdiction" for the
purposes of challenging a UDRP decision. To ensure "parity of appeal"
(see ICANN *Second Staff Report on Implementation Documents for the Uniform
Dispute Resolution Policy*, Paras. 4.7-4.8) between complainants and
respondents, the UDRP Rules define "mutual jurisdiction" as a court jurisdiction
at either (a) the principal office of the Registrar or (b) the domain name holder's
address. ICANN's Registrar Accreditation Agreement (Section 3.7.7.10)
requires registrars to provide in the domain name registration agreement that the
domain name holder with submit to the above-mentioned jurisdictions, and it is
such a provision in the registration agreement that leads to the court jurisdiction
at the principal office of the registrar being a viable option.

The absence of the jurisdiction submission clause in the domain name
registration agreement deprives the complainant of the option to select the court
jurisdiction at the location of the principal office of the registrar as the mutual
jurisdiction and hence obstructs the "parity of appeal" that the UDRP Policy and
Rules were designed and drafted to protect.

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3.

Mr. Dan Halloran, Chief Registrar Liaison, Internet Corporation for Assigned
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To our knowledge, registrars whose domain name registration agreements
do not contain an appropriate jurisdiction submission clause or contain clauses
that are ambiguous in this respect include the following:

007Names, Inc.
1eNameCo
AAAQ.COM, Inc.
BB Online UK Limited
Capital Networks Pty Ltd
Gandhi SARL
Intercosmos Media Group, Inc.
Key-Systems GmbH dba domaindiscount24.com
Korean Information Certificate Authority d/b/a DomainCA.com
Namescout
Name2Host, Inc dba Name2Host.com
Netpia.com, Inc.
Omnis Network LLC
OnlineNic (English language version only)
OVH
Register.it SpA
Registration Technologies, Inc.

This list has been compiled through the Center's review of registrars'
responses to the Center's request to "indicate whether the domain name registrant
has submitted in its Registration Agreement to the jurisdiction at the location of
the principal office of the Registrar for court adjudication of disputes concerning
or arising from the use of the domain name(s)" and does not necessarily follow
from the Center's examination of the registrars' agreements. Therefore this list is
not meant to be comprehensive and there may be other registrars that have not
come to the Center's attention for lack of case involvement.

Experience suggests that close ICANN review of registrars' domain name
registration agreements for compliance with Registration Accreditation
Agreement is called for. We would appreciate your informing us about steps
taken to have the above-listed registrars correct their registration agreements in
accordance with their stated legal obligations.

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4.

Mr. Dan Halloran, Chief Registrar Liaison, Internet Corporation for Assigned Names and Numbers, Marina del Rey – March 22, 2004

3.   Registrar Lock and Decision Implementation

A.   On occasion, registrars fail to lock the domain name disputed in a UDRP proceeding, resulting in the domain name being transferred to a third party. This is clearly in violation of the UDRP (UDRP Policy, Para. 8) and when the domain name is not restored to the original holder (*i.e.* party named as respondent in the UDRP complaint), the UDRP case stalls. As we have alerted you on previous occasions, we have two cases where such a transfer occurred and where the
./.   administrative panel's decision is yet to be implemented. Annex 1 contains the correspondence which relate to these two cases.

B.   We also have a pending case where a transfer to a different registrant with a different registrar occurred even after the original registrar (Info Avenue d/b/a/ IA Registry) confirmed that the domain name is under registrar lock. IA Registry has failed to recover the domain name and the Center is unable to
./.   process this case. See Annex 2 for related correspondence.

C.   We have a case which involves the domain name <tonysnow.com> that shows as registered with Domain Monger. Upon learning that the registrant details changed after the filing of the complaint and Domain Monger's confirmation that the domain name will remain locked during the administrative proceeding, the Center inquired with Domain Monger how or why such change occurred. Domain Monger replied that it is unable to place the domain name on lock and that domain name locking is handled by eNom. eNom has subsequently confirmed that eNom is responsible for locking the domain name and implementing any UDRP decision. As our understanding is that such matters fall under the responsibility of the concerned registrar, I would like to seek your clarification on this relationship and any appropriate action to be taken to ensure
./.   proper application of the UDRP. See Annex 3 for related correspondence.

Although these cases, which have caused parties to incur significant costs in vain, remain the exception among the UDRP cases filed with the Center, failure to correct the problem will discourage parties from using the UDRP and tends to discredit those involved in the UDRP process.

4.   eNom

We have had a number of difficulties with the registrar eNom. As we alerted you early last year, eNom does not respond at all to the Center's request for registrar verification and is generally uncooperative. For example, even when parties have alleged the inaccuracy of eNom's WhoIs and the Center requested eNom to verify the registrant's details, eNom would simply revert us back to
./.   their WhoIs evading confirmation of registrant's details. See Annex 4 for related correspondence.

Mr. Dan Halloran, Chief Registrar Liaison, Internet Corporation for Assigned
Names and Numbers, Marina del Rey – March 22, 2004

We are concerned that further delay in addressing these problems will
undermine the success UDRP has enjoyed to date. We look forward to your
early reply. In the meantime, should you have any questions, please do not
hesitate to contact my colleague Ms. Eun-Joo Min, Senior Legal Officer
(telephone: +41 22 338 8565, e-mail: eunjoo.min@wipo.int).

Thank you.

Yours sincerely,

Erik Wilbers
Acting Director
WIPO Arbitration and Mediation Center