

## **DRAFT PROBLEM STATEMENT RELATING TO THE PROTECTION OF ACRONYMS OF INTERNATIONAL GOVERNMENTAL ORGANIZATIONS AT THE SECOND LEVEL IN GENERIC TOP LEVEL DOMAINS (as of 10 March 2017)**

### **ICANN's Role:**

ICANN coordinates the development and implementation of policies concerning the registration of second-level domain names in generic top-level domains (gTLDs) for which uniform or coordinated resolution is reasonably necessary to facilitate the openness, interoperability, resilience, security and/or stability of the domain name system (DNS). This includes policies regarding resolution of disputes regarding the registration of domain names.

### **The Objective:**

The allocation, management and operation of gTLDs should take into account the need to ensure that neither the registration of a domain name at the second level nor the manner in which it is used infringes the legal rights of International Governmental Organizations (IGOs). The development of any gTLD policies in relation to the registration of domain names matching IGO acronyms at the second level of gTLDs, and the resolution of disputes concerning these names, should include consideration of the legitimate rights and interests of other domain name registrants, and to the extent applicable and relevant, be based on applicable international law principles.

Where practicable, any protection mechanisms to be developed should take advantage of similar mechanisms that have been created for protecting other legal rights. These protections, which should also take into account IGOs' unique status, in particular the scope of their immunity from the jurisdiction of national courts, should also be worked out in tandem with the ongoing policy work being done by the Generic Names Supporting Organization (GNSO) Policy Development Process (PDP) Working Group on IGO-INGO Curative Rights.

### **The Problem:**

IGOs are concerned about the reputational risks associated with fraud in the DNS and minimizing risks to members of the public who are often targeted by individuals posing as IGOs or IGO officials.

Since the Governmental Advisory Committee (GAC) advice and GNSO policy recommendations in relation to IGO acronyms are in conflict, a resolution is now being sought. The main questions concern:

- (1) the appropriate form and extent of any protections that are to be conferred;<sup>1</sup> and
- (2) how to provide that protection in the context of the applicable legal rights framework as well as ICANN's mission as encapsulated in the ICANN Bylaws.

### **Proposed Method:**

The GAC and the GNSO are being requested to engage in a dialogue based on this Problem Statement and agreed Briefing Materials, assisted by a facilitator.

### **The Issue in Context:**

On [7 July 2013](#), the New gTLD Program Committee (NGPC) of the ICANN Board confirmed that the interim protections for IGO names and acronyms pursuant to Specification 5 (Schedule of Reserved Names) of the New gTLD Registry Agreement would continue while the GAC, NGPC, ICANN staff and community continue to actively work through outstanding implementation issues. This temporary reservation remains in place and the names and acronyms can be found at: <https://www.icann.org/sites/default/files/packages/reserved-names/ReservedNames.xml>.

The ICANN Board has approved permanently withholding from registration, at the second level in new gTLDs delegated under the 2012 New gTLD Program, the full names of those IGOs on the list provided to ICANN by the GAC in March 2013 (as updated from time to time by the GAC). This approval reflects the result of a GNSO PDP conducted in 2013. However, the question of appropriate protections at the second level for the acronyms of these IGOs remains unresolved. In relation to IGO acronyms, the advice that has been provided by the GAC to the ICANN Board between 2012-2015 is not consistent with the policy recommendations of the 2013 GNSO PDP (released in January 2014).

The most current GAC Communique, dating from the November 2016 ICANN meeting in Hyderabad, acknowledged the differences between the GAC's advice to date and the GNSO's policy recommendations on IGO acronyms. The GAC recommended that a starting point for a transparent, good faith dialogue to resolve these differences can be the Small Group Proposal that was developed by representative IGOs in conjunction with GAC and Board (NGPC) representatives. This proposal includes recommendations for:

- a procedure to notify IGOs of third party registration of their acronyms;
- a dispute resolution mechanism modeled on but separate from the UDRP, to include the possibility of appeal to an arbitral tribunal instead of national courts, in conformity with relevant principles of international law; and
- an emergency relief (e.g., 24-48 hours) domain name suspension mechanism to combat risk of imminent harm to an IGO.

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<sup>1</sup> From the GAC perspective, the basis for protections for IGOs is not just the application of international law but stems from the nature of IGOs as having been created by governments.

As the embodiment of the proposed compromise which grew out of the Small Group discussions, this proposal differs somewhat from previous GAC advice, which called for more “preventative” (i.e. before a third party is able to register a domain name corresponding to an IGO acronym) protections. For example, the GAC’s Buenos Aires Communique (November 2013) had advised that both the potential registrant and the affected IGO should be notified if a potential registrant seeks to register a domain name matching an IGO acronym, with final and binding determination by an independent third party in the event of a disagreement between the IGO and the potential registrant. Reflecting the input of non-IGO participants in the Small Group, the Small Group Proposal shifted from preventative measures and focuses on so-called “curative” protections (i.e. after a third party has already registered a domain name corresponding to an IGO acronym). In this scenario, a post-registration notification to the affected IGO would allow it to consider pursuing redress through one of the new processes recommended in the Small Group Proposal.

Under its PDP conducted between October 2012 and November 2013, the GNSO’s final policy recommendations for IGO acronym protection had been to enter the acronyms into the Trademark Clearinghouse database, to enable both a potential registrant to receive a Claims Notice if the attempted registration is for a domain matching an IGO’s acronym, as well as the affected IGO to receive a Notice of Registered Name should the registrant nevertheless proceed with the attempted registration. The 2013 PDP Working Group had also recommended that the GNSO Council explore the possibility of conducting a separate PDP on the issue of curative rights protections. This new PDP was launched in June 2014 and the PDP Working Group has released its preliminary recommendations for public comment.

## **ANNEX - Current ICANN Mechanisms Developed To Protect Existing Legal Rights:**

When registering a gTLD domain, a Registered Name Holder represents that, to the best of the Registered Name Holder's knowledge and belief, neither the registration of the Registered Name nor the manner in which it is to be directly or indirectly used infringes the legal rights of any third party.

Where the allegation concerns infringement of trademark rights, ICANN has an existing consensus policy (the UDRP) that allows trademark holders to initiate a dispute resolution process where:

- (i) the registered domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; AND
- (ii) the registrant has no rights or legitimate interests in respect of the domain name; AND
- (iii) the domain name was registered and is being used in bad faith.

Examples of bad faith include: (1) instances where a Registered Name Holder intentionally attempts to attract, for commercial gain, Internet users to the Registered Name Holder's website by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the website or of a product or service on the website; or (2) circumstances indicating that the domain name was registered primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant/mark-holder for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name.

In addition to the UDRP, the 2012 New gTLD Program incorporated new and additional trademark rights protection mechanisms. For example, entering one's trademark into the new Trademark Clearinghouse database ensures that a trademark holder will be notified when a domain name is registered that matches their trademark, and potential registrants are advised of trademark rights that may exist in a domain name as part of the registration process. A new dispute resolution policy based substantially on the UDRP – the Uniform Rapid Suspension system (URS) - was also introduced for the 2012 New gTLD Program.

The above-mentioned protection mechanisms are based on the existence of trademark rights. In this regard, it may be noteworthy that IGO acronyms are included in a group of names, armorial bearings, flags and other State insignia under the Paris Convention for the Protection of Industrial Property, for which Contracting States and members of the World Trade Organization are generally obliged to protect from third party registration under their national trademark regimes.