

**I C A N N**

**COMMUNITY FORUM**

**58**

**COPENHAGEN**

11-16 March 2017





# **IGO-INGO Curative Rights Protections Policy Development Process**

Open Community Session  
15 March 2017

# Agenda for the session today

1

Overview of this PDP & where it fits into overall work on IGO-INGO protections

2

Co-Chairs' update on GAC-GNSO facilitated dialogue

3

Discussion of Preliminary Recommendations & comments to date

4

Discussion of IGO and governments' comments

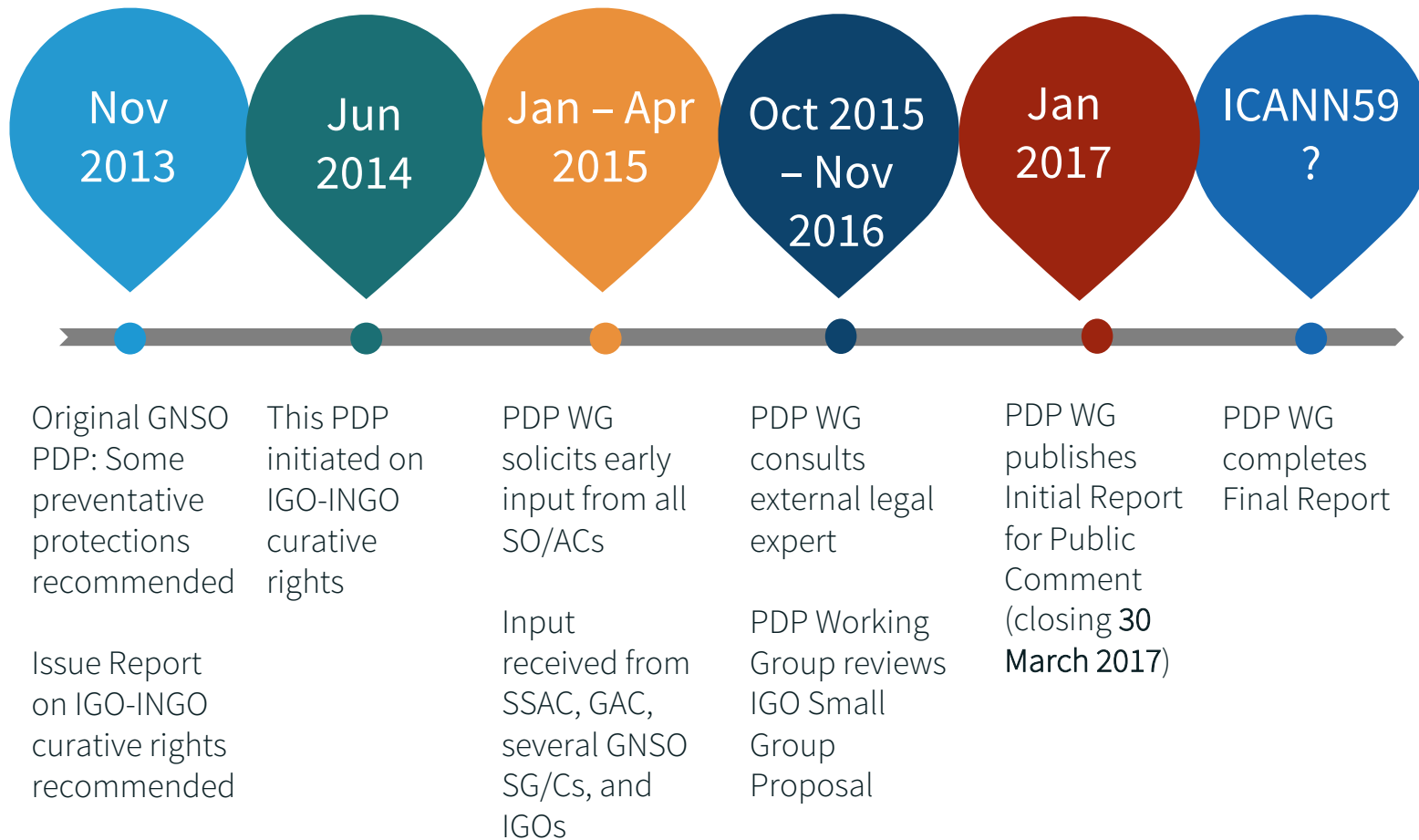
5

Next steps and timeline to completion of PDP

# Overview of this PDP (1/2)

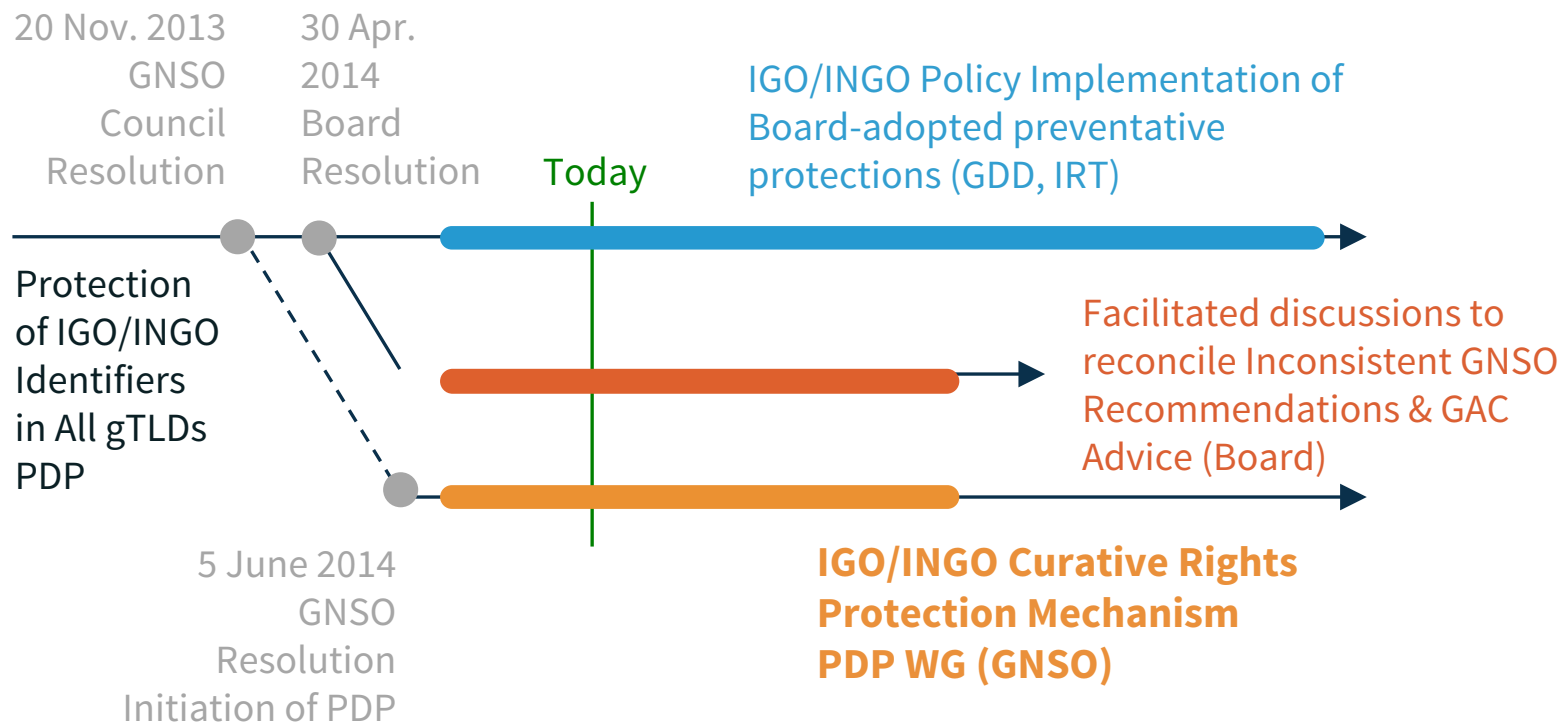
- ⊙ PDP Working Group chartered by GNSO Council to develop policy recommendations regarding ***“whether to amend the UDRP [Uniform Dispute Resolution Policy] and URS [Uniform Rapid Suspension procedure] to allow access to and use of these mechanisms by IGOs and INGOs and, if so, in what respects; or whether a separate, narrowly-tailored dispute resolution procedure at the second level modeled on the UDRP and URS that takes into account the particular needs and specific circumstances of IGOs and INGOs should be developed.”***
  - *IGOs = International Governmental Organizations*
  - *INGOs = International Non-Governmental Organizations*

# Overview of this PDP: Timeline (2/2)



Timing may need to align with completion of ongoing GAC-GNSO discussions on IGO acronym protections

# Where this PDP fits with other work on IGO-INGO Protections



***This PDP focuses on curative rights processes – not covered by the original GNSO PDP or the ongoing implementation of the preventative rights recommendations adopted from that PDP***

**The Working Group's  
Preliminary  
Recommendations &  
Summary of comments  
Received to date**

# Preliminary Recommendation #1

**The Working Group recommends that no changes to the UDRP and URS be made, and no specific new process be created, for INGOs (including the Red Cross movement and the International Olympic Committee). To the extent that the Policy Guidance document referred to elsewhere in this set of recommendations is compiled, the Working Group recommends that this clarification as regards INGOs be included in that document.**



# Preliminary Recommendation #1, Comments

Few comments related to this recommendation

- 2 comments in support (as of 10 March)

# Preliminary Recommendation #2

**For IGOs, in order to demonstrate standing to file a complaint under the UDRP and URS, it should be sufficient for an IGO (as an alternative and separately from an IGO holding trademark rights in its name and/or acronym) to demonstrate that they have complied with the requisite communication and notification procedure in accordance with Article 6ter of the Paris Convention for the Protection of Industrial Property.**

**For clarity, the Working Group recommends further that a Policy Guidance document pursuant to the UDRP and URS be prepared and issued to this effect for the benefit of panelists and registrants.**

- ⦿ *Under Article 6ter, States “agree to refuse or to invalidate the registration, and to prohibit by appropriate measures the use, without authorization by the competent authorities, either as trademarks or as elements of trademarks, of ... armorial bearings, flags, other emblems, abbreviations, and names, of international intergovernmental organizations ... ”*

# Preliminary Recommendation #2, Comments

## Some concerns

- On the Policy Guidance document:
  - *could be construed as “alternative guidance” and contravene the UDRP itself.*
- Article 6ter does not create or grant rights
  - *WIPO notification process has no legal effect under the Paris Convention;*
  - *treaty basically merely requires that members states prohibit use of IGO names and acronyms that mislead consumers.*
- Expansion of the GAC IGO list

# Preliminary Recommendation #3

**WG does not recommend that any specific changes be made to the substantive grounds under the UDRP or URS upon which a complainant may file and succeed on a claim against a respondent (Section 4(a)(i) – (iii) of the UDRP) as the WG believes that bad faith registration and use concept covers a very broad range of offensive activities, including those covered by scope of Article 6ter protections.**

**However, WG proposes that the Policy Guidance document (see Recommendation #2) includes a further recommendation that UDRP and URS panelists should take into account the limitation enshrined in Article 6ter(1)(c) of the Paris Convention in determining whether a registrant against whom an IGO has filed a complaint registered and used the domain name in bad faith.**

- ⦿ *There is no State obligation when the third party use or registration “is not of such a nature as to suggest to the public that a connection exists between the organization concerned and the ... abbreviations, and names, or if such use or registration is probably not of such a nature as to mislead the public as to the existence of a connection between the user and the organization.”*

# Preliminary Recommendation #3, Comments

Concerns include:

- Recommendation interferes with panelists' decision-making and unduly increases burden on IGOs bringing cases in the UDRP
- Support from one commenter

# Preliminary Recommendation #4 (Part 1)

**On the issue of jurisdictional immunity, which IGOs may claim successfully in certain circumstances (but not INGOs), WG recommends that:**

- (a) no change be made to the Mutual Jurisdiction clause of the UDRP and URS, as ICANN CRPs are in addition to and not a substitute for existing statutory rights and ICANN has no power to extinguish registrant rights to seek judicial redress;**
- (b) the Policy Guidance document initially described in Recommendation #2 (above) also include a section that outlines the various procedural filing options available to IGOs, e.g. they have the ability to elect to have a complaint filed under the UDRP and/or URS on their behalf by an assignee, agent or licensee; such that**
- (c) claims of jurisdictional immunity made by an IGO in respect of a particular jurisdiction will fall to be determined by the applicable laws of that jurisdiction .**

# Preliminary Recommendation #4 (Part 2)

**Where a losing registrant appeals to a court of mutual jurisdiction and an IGO succeeds in asserting its claim of jurisdictional immunity in a court of mutual jurisdiction, WG recommends that in that case:**

***Option 1 - the decision rendered against the registrant in the predecessor UDRP or URS shall be vitiated; or***

***Option 2 - the decision rendered against the registrant in the predecessor UDRP or URS may be brought before the [name of arbitration entity] for de novo review and determination.***

- ⦿ *WG has yet to agree on which Option, or another option, is preferred*
- ⦿ *WG relied extensively on the opinion of an external legal expert that the state of international law on the issue of IGO jurisdictional immunity is not uniform, and may vary (e.g. by IGO, treaty, or national court treatment)*
- ⦿ *WG also recommends that the Policy Guidance document (see Recommendation #2) be brought to the notice of the Governmental Advisory Committee (GAC) for its and its members' and observers' information*

# Preliminary Recommendation #4, Comments (1/2)

- Several commenters noted the unique nature of IGOs, which precludes them from submitting to national courts

Concerns include:

- An infringing registration of a domain name impedes an IGO in carrying out its core mission within the scope of a functional immunity inquiry.
- The licensee/agent approach may cause an IGO to inadvertently waiving its immunities and weakening its claim on the mark it is trying to protect.



# Preliminary Recommendation #4, Comments (2/2)

On the two Options:

- Concern that the Mutual Jurisdiction clause may be construed as waiving immunities.
  - Arbitration preferred as more reasonable option
- Several commenters supported Option 1 (vitiates the panel decision)
  - UDRP & URS designed to be alternative, not replacement of existing law. Registrants should not be deprived access to recourse via national courts.
- Several commenters challenged the judgment of panelists
  - Concern in potentially denying registrants access to national courts (and instead, requiring submission to de novo arbitration)

# Preliminary Recommendation #5

**In respect of GAC advice concerning access to curative rights processes for IGOs, the Working Group recommends that ICANN investigate the feasibility of providing IGOs and INGOs with access to the UDRP and URS (in line with the recommendations for accompanying Policy Guidance as noted in this report), at no or nominal cost, in accordance with GAC advice on the subject.**

- ⦿ *WG inquired of GAC whether existing administrative fees for URS and UDRP were viewed as "nominal" but GAC did not provide definitive response*

# Preliminary Recommendation #5, Comments

- A few commenters supported this recommendation.

# Discussion: Comments from Governments & some IGOs\*\*

*\*\*The following are excerpts/summary of comments submitted by the GAC, US Government, OECD and WIPO (participants in the GAC-GNSO Facilitated Discussions held this week on IGO acronyms protection)*

# Excerpt: GAC Comment (filed 12 March 2017)

The GAC recalls that IGOs – unique treaty-based institutions created by governments under international law – undertake global public service missions, and that ***protecting their names and acronyms in the DNS serves the global public interest.***

The GAC further recalls that IGOs have recognized that policies seeking to protect their identities in the Domain Name System should ***accommodate legitimate third-party co-existence.***

The GAC affirms its position, expressed in the Hyderabad Communiqué and elsewhere, and articulated in more detail below, that the ***small-group compromise proposal should be duly taken into account by ICANN and the GNSO (at both the Working Group, and Council, levels).***

The GAC also notes that ***ICANN's Bylaws and Core Values specify that the concerns and interests of entities most affected, here IGOs, should be taken into account in policy development processes.***

# GAC Comment on Recommendations #1 & #5

- The GAC does not take exception to the Working Group Recommendation #1, which notes that the Initial Report recommendations do not apply to international non-governmental organizations (INGOs) particularly insofar as two such INGOs, the Red Cross and International Olympic Committee, are the subject of separate, GAC advice.
- Recommendation #5 is the one Working Group recommendation that takes the GAC's advice into account, i.e., that any curative rights protection mechanisms be provided at no or nominal cost.

# GAC Comment on Recommendations #2 & #3

ICANN should establish a ***dispute resolution mechanism modeled on but separate from the UDRP***, which provides:

- Standing for IGOs which need not be expressly grounded in trademark law as such (IGOs are created by governments under international law and are in an objectively different category of rights-holders);
- Appeal to an arbitral tribunal instead of national courts, in conformity with relevant principles of international law concerning recognized privileges and immunities conferred by governments on IGOs

Concerns:

- It will “effectively alter an existing Consensus Policy [and] improperly bypasses the ordinary Bylaws-prescribed Policy Development Process (it should not therefore be described merely as some form of policy “implementation” guidance”.
- Disregards the plain language of the UDRP which requires trademark rights for standing to file a case.

# GAC Comment on Recommendation #4

## Concerns:

- [Recommendation is] ***incompatible with the position conveyed by the Legal Counsels of IGOs*** which was provided to the Working Group at its request.
- ***Does not adequately account for GAC Advice*** on this subject which recognizes international norms regarding IGOs' status as treaty-based organizations.

Recommendations #2 and #4 (which suggest various adjustments to the UDRP) plainly fail to account for GAC Advice (see, e.g., the Los Angeles and Hyderabad Communiqués) which calls for a separate standalone IGO-specific dispute resolution mechanism.



Focused on Recommendation #2

***No equivalency*** between Paris Convention notification and trademark rights

- Notification has no legal effect and WIPO does not have authority under the treaty to grant any international rights or recognition
- Primary purpose of Article 6<sup>ter</sup> is to recognize symbols of national sovereignty and prevent them from being used as commercial trademarks, not to protect commercial trademarks
- Paris Convention is not self-executing in the United States and many other countries - national legislation required to implement its obligations and IGOs have no direct cause of action in national courts
- Some Paris Convention members review the WIPO-transmitted notifications, some do not - notification and communication “cannot be read to mean that the IGO’s name and acronym is deemed “protected” or “recognized” under the treaty for purposes of establishing eligibility to use the UDRP/URS”

# US Government Comment (filed on 1 March 2017)

- Disagreement between several GAC members on whether Article 6ter provides a legal basis for protection for IGO names and acronyms, led to the GAC proposing ***an alternative basis for protection***, i.e., the existing criteria for registration at the second level in the .int top-level domain – the basis for progressive exchanges with the ICANN Board, ultimately culminating in the IGO Small Group Report
- GAC list of IGOs was the “result of protracted negotiations with the IGOs”. ***Replacing it with all IGOs that have complied with the 6ter process is a game-changer***, in that at least some organizations that proclaim themselves to be IGOs in fact are not.
  - The GAC list provides the ICANN community with the security that those on the list are in fact IGO

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On Recommendation #2 (standing):

- Agree that standing should be established under international law, not national trademark law

On Recommendation #3 (to consider limitation in Article 6ter(1)(c) when determining bad faith):

- Unduly restricts panelist decision making
- Proposes interpretation that does not enjoy consensus
- Increases burdens on IGOs bringing UDRP cases

On Recommendation #4 (no change to Mutual Jurisdiction clause):

Conclusion not supported by PDP findings

Reasons:

- Incorrectly restates IGO jurisdictional immunity test proposed by external expert
- Misapplies the test by using the WG's own inappropriate standard
- WG's proposed remedy is a complicated legal workaround that could undermine IGO immunities and ability to defend rights in IGO names

On the 2 options relating to Recommendation #4:

Fundamental problem with assumption that an IGO could successfully claim immunity after having submitted to Mutual Jurisdiction

- Strongly supports Option 2 as the only viable option
- Option 1 would curtail rights an IGO may have to immunity
- Disagrees that arbitration is unfamiliar to registrants and would require change to registration agreements

On Recommendation #5:

- Agrees that ICANN should investigate feasibility of subsidizing costs as IGOs are non-commercial in nature

Recommendations do not account for IGOs' unique status

- In terms of accommodating standing and Mutual Jurisdiction, a separate dispute resolution process modeled on the UDRP would
- ICANN's Bylaws and Core Values indicate that concerns and interests of entities most affected (here, IGOs) should be taken into account in policy development

Recommendations do not reflect the global public interest

- IGOs are unique institutions created by governments to fulfill global public missions
- Nothing in today's DNS prevents criminal elements from executing scams through the misuse of IGO identities
- GAC Principles on New gTLDs call on ICANN to accommodate IGOs' rights in their names and acronyms

Suggested workaround of “Policy Guidance” misses the target

- Contravenes plain language of the UDRP
- Fair resolution of disputes involving IGOs through independent and impartial arbitration already widely accepted; applying agency principles would be an artifice creating unnecessary legal hurdles

Core question for the PDP is simple:

- Should an unfettered DNS market prevail over appropriately protecting IGO identifiers in accordance with their international status?
- IGOs’ specific needs and circumstances can be accommodated through a narrowly tailored dispute resolution mechanism modeled on, but separate from, the UDRP
  - IGOs – and the donors supporting them and especially the citizens relying on them – merit tailored protection in the DNS commensurate with their unique treaty-based position.



# Next Steps & PDP Completion

# Timeline (estimated) to completion of Final Report

## JANUARY 2017:

- Initial Report published for public comment

## MARCH-MAY 2017:

- WG reviews comments received, prepares Final Report

## ICANN59 (JUNE 2017) (estimate):

- Final Report submitted to GNSO Council

## 2017, 3Q (estimate):

- GNSO Council considers recommendations; if adopted, they are sent to Board

## 2017, 3-4Q (estimate):

- Board considers (and approves?) PDP recommendations

## NOTE:

- Timing may be impacted by ongoing facilitated GAC-GNSO discussions

- Background information: <https://gnso.icann.org/en/group-activities/active/igo-ingo-crp-access>
- ICANN58 Background Briefing Paper: <https://gnso.icann.org/en/issues/policy-briefing-igo-ingo-crp-access-27feb17-en.pdf>
- Working Group online wiki space (with meeting transcripts, call recordings, draft documents and background materials): <https://community.icann.org/x/37rhAg>