

**Transcription ICANN Singapore
IGO INGO CRP Update to the Council
Saturday 07 February 2015**

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Jonathan Robinson: All right I'll move us rapidly on to the next item then which is an update on the IGO INGO access to curative rights protection mechanisms which I think is going to be provided to us by Phil Corwin. Over to you, Phil.

Phil Corwin: Thank you, Jonathan. And I'm delighted that this is my inaugural remarks as a member of the Council. Our group has been meeting since the fall. Our task is fairly simple to make sure that the existing right protection mechanisms, UDRP and URS, provide a mechanism for at least international intergovernmental organizations to protect their rights when they're abused in the domain name system by registrants who register domains that appear to be associated with these organizations but are not and that may mislead the public.

And we've been making very good progress. I do want to note with that excellent staff support from Mary Wong, Steve Chan and on occasion Berry Cobb. And I think it's good to note that we couldn't be making the progress we are without that support.

Could we have the first slide please? Okay, our first - the original charter from the Council asked us to also look at international nongovernmental organizations. We did spend a fair amount of time at the beginning of our process and determined that there was no good reason to include them in this consideration. They have no issue with standing, they're perfectly capable of getting trademarks and anything they want to protect. They have no sovereign immunity issue.

We simply didn't see any reason to confuse our consideration on the main event which is intergovernmental organizations by considering them. And we've sought input from a number of groups and we've received no objections to that decision.

I do want to say on the feedback we received, we sent out a number of questions I believe in early December and gave respondents until late January to respond. We heard from SSAC, they had no comment. We did get a fairly detailed response from the IGO small group; we're not quite sure which IGOs are in that small group but at least we got a detailed response.

And they're a little bit ahead of us in terms of our analysis of understanding how Article 6ter of the Paris Convention works and conferring rights on IGOs. So they did correct us. We didn't - we thought their feedback was fairly comprehensive and useful.

We also got useful feedback from the ISP Constituency and the IP Constituency. Those were the only groups we heard from. I will say that even though this has been a major issue for the GAC I've been very disappointed at the GAC's participation which has been nonexistent. We got in response to our questions that they'd have nothing to say about this until after this meeting. And that's particularly not helpful because our group is going to have a facilitated face to face meeting this coming Friday on which we hope to finish dealing with the standing issue.

And it was also not helpful for the GAC to issue a communiqué in LA in which they told us that we should not even consider amending the UDRP and URS which was in a part of our charge from the Council that we should consider that. So we're going to listen to our charge from Council on that.

And they also said that whatever we do it should be either free or nominal or IGOs. And we don't know what they mean by nominal cost, whether they consider the current cost to filing a UDRP or URS to be nominal. But we do know that we have no capability or charge to create a subsidy mechanism for

IGOs to bring arbitration actions, and that whoever hears these actions has experts who need to be paid for their time.

So I did want to note that. This has been a major issue for Mason Cole in his first few months as liaison from the Council to the GAC to try to work this out and get more substantive and helpful feedback from the GAC.

Also at this point I've been remiss in noting that I'm co-chair of this group. The other co-chair is Petter Rindforth, former member of the Council. Petter will be in town later today but we've been working very cooperatively in alternating chairing these meetings and working in very much consensus manner on how to move this group forward.

Back to the slide, we're currently discussing standing to file a complaint under the existing RPMs, UDRP or URS. We've reviewed the Article 6ter of the Paris Convention in detail. We now understand that it does not confer exactly trademark rights but it does confer protection under the trademark system.

And the way this works is that an IGO, which is covered by Article 6ter notifies the World Intellectual Property Organization, WIPO, that they are protected. WIPO in turn notifies all the signatories to the Paris Convention as well as all the members of the World Trade Organization. And they are supposed to protect the name and the acronym of those IGOs from abusive trademark registrations.

Although I would note that they do have the ability to opt out for any particular IGO if they can state a reason for doing so. We don't know of many or any cases in which they've done that but they do retain that option. So our thinking right now is that because this is key to protecting IGOs from abusive registrations in the trademark system that it is substantially similar enough to a trademark registration that an IGO, which has taken the step of notifying WIPO, should have standing to bring a UDRP or URS.

We're working on proposed language to - right looking at UDRP and then we can look at URS - to clarify that we're not adding anything to these protective mechanisms, that we're simply clarifying that these IGOs already have standing under the current system. And that's going to be a major focus of our work this coming Friday.

We've also sought input on the sovereign immunity issue which is the more difficult issue. And we have another slide here. This arises mainly - would arise mainly in the context of where an IGO has brought an arbitration action and prevailed. This would be the main situation, though not the only conceivable one.

And the registrant feeling that a poor decision has been made, their current remedy is to - under UDRP is to appeal to a court of national jurisdiction. So this would be an instance where the registrant files an action in which the IGO wants to protect the UDRP decision has to go into the national court.

And we're still trying to get information about how individual nations implement these protections for IGOs. We have found that in the United States - the United States State Department took a position in 2002 that if an IGO felt that a trademark had been registered in the US trademark system that it felt infringed its rights under Article 6ter that its remedy was - it didn't say so but presumably either an administrative remedy to challenge the trademark registration or failing that, to bring a Lanham Act lawsuit in US courts.

So we're parsing this issue now on sovereignty and trying to decide if there's a meaningful distinction between an IGO filing an action in a national court to protect their rights when they feel that an abusive registration has been permitted, versus being pulled into a lawsuit filed by a registrant in an appeal from an arbitration process. We haven't really discussed that issue in detail yet and we're going to start dealing with that issue at our Friday face to face discussion.

So I think I've pretty much brought you up to speed. We have made a great deal of substantive process. We've had good participation from the working group members. I'd say about 75%, 80% attendance of the overall group on each call. There seems to be a lot of interest. Some members in particular are doing their own research and bringing helpful facts and citations to our attention. Staff has been very helpful in trying to get us additional information.

And we do believe we'll be able to wrap up on the standing issue under the current arbitration mechanisms at our Friday face to face meeting coming up in six days, and move on to the final issue, which is sovereign immunity. I'm not quite sure how we're going to deal with that yet but we do expect to have - hope to have good reason to believe we can have a final report and recommendation in draft form at least by the time of the next ICANN meeting in Buenos Aires.

So that is where we are at on this. And I'd be happy to answer any questions from members of the Council or anyone else regarding our progress. Would you show that last slide again, just make sure I didn't miss anything.

Yeah, as I said we expect to conclude on standing, get to work on sovereign immunity this Friday and - oh the last thing is there seems to be some lack of congruity between the IGO list provided by the GAC and the actual list of IGOs protected by the Paris Convention. So we're going to have to get into that issue as well.

We're clear that our work covers everybody who's covered by the Paris Convention. We're not sure if the status of these other IGOs listed by the GAC but that's another sub issue we need to parse through before making final recommendations.

So thank you, staff, and I'm ready for any questions.

Jonathan Robinson: Thank you, Phil. Bret.

Bret Fausett: Thanks, Phil. That was a very helpful report. On the - I think it was the last slide or maybe the one before it there was - it talked about the idea that - oh yeah, that - curative rights mechanisms should be at no cost to IGOs. What's the discussion there on how the providers are going to get paid or anything?

Phil Corwin: Well, that was, as I said, there was part of the LA communiqué from the GAC included comments on our work and said that we shouldn't even consider amending the UDRP or URS, which we had to reject because we're working under the charter - the resolution passed by the Council which specifically instructed us to consider such amendments as well as maybe creating a new curative rights process.

So I will say so far within our group we haven't had - we haven't found any reason to go over that bridge and consider designing an entirely new CRP. And I would say the broad consensus in our group is that's something we want to avoid unless we decide it's absolutely necessary based on the sovereign immunity issue.

And then they also said whatever you do it should be at nominal or no cost to IGOs. They didn't provide a definition of nominal. We don't know if they consider the \$500 fee for URS or the approximately \$1500 fee for UDRP to be nominal. It's certainly nominal in comparison to filing litigation in any national court.

And as I said, we don't have a charge nor do we believe our working group has an capability to create a subsidy system that would provide free access to arbitration for IGOs. So this was from the GAC. And, again, we didn't find it particularly helpful for them to be coming - kind of coming in and telling us to not do things that we have been told to do and to look at things we haven't been asked to look at.

And I think it speaks to the need for better integration of the GAC with the GNSO process at a much earlier stage.

Jonathan Robinson: I think I've got James, Avri and then Mason, I don't know if you want to come in.

James Bladel: Actually that's kind of where I was going with this as well. Thanks. James speaking. And I didn't mean to put Mason on the spot but it says here on the slide that you're going to have a dialogue with the GAC on these issues that Phil has outlined. And is that already happening? Is that going to happen this week or...

Mason Cole: Yeah, it's happened in a limited capacity, it'll happen more this week, yes.

James Bladel: Okay. So they haven't really heard these concerns yet or...

Mason Cole: No, they're aware of the concerns.

James Bladel: Okay.

Phil Corwin: Well and as I noted on January 22, our working group received a very short email copied on it - an email to Glen from Olof Nordling of ICANN staff simply advising us that in response to the questions we had put out to all these SOs and ACs and others that the GAC would have no feedback for us until after this meeting in Singapore. So, again, now is the time we could really use some feedback from them. And it's not happening.

Jonathan Robinson: Mason, do you have any other comments or...

Mason Cole: Not at this point, no.

Jonathan Robinson: I mean, one of the issues there clearly is this whole point of - I mean, I think my sense is there's probably two things going on. One, as you know, we are midway through figuring out how to work better with the GAC and this is - and whilst we're doing that we kind of - we've got an issue like this going on.

The other is they will or their current modus operandi is to work at ICANN meetings, not in between ICANN meetings. And this is - that's one of the structural challenges we've got which presumably what - exactly what you're facing.

Phil Corwin: Yes, yes. And this all seems to revolve around - some of it revolves around this sovereign immunity issue although, again, that issue can be parsed in many ways and we're trying to find out how other nations tell IGOs to protect their rights and their trademark system when they think a mistake has been made.

But we strongly suspect that they take a position similar to the US which is use our national trademark arbitration systems, or our courts. There's no international court for trademark disputes. So we're trying to find out what is the actual existence, if any, of this sovereign immunity within the trademark system.

Jonathan Robinson: I've got Mason and then James.

Mason Cole: Thank you. Mason speaking. Just separate from the content of what Phil is discussing here in his role as chair, I spoke - we're going to have a bit more of a briefing on this tomorrow when we meet with the GAC with Marika and Manal. But I did speak with the GAC chair yesterday about working intercessionally on issues related to the GNSO.

And the GAC is well aware that they're going to need to step up the pace of their work if they expect to have input on GNSO process. So they know that the GNSO is not going to be synchronizing its work along with the GAC schedule. So I just wanted to put that out there so that the Council is aware the GAC knows that it needs to move along with its work if it expects to have dialogue with the GNSO.

In fact in just a moment I'm going to meet with Thomas and Suzanne to talk about that some more.

Jonathan Robinson: Thanks, James. I overlooked Stephanie so we're going to go back to Stephanie and then come to you.

Stephanie Perrin: Thanks very much. This is a - sort of clarification question. That process that you described, Phil, where the organizations would notify WIPO that they had a mark worth considering sounded deceptively simple. What does it - how complex is that process? In other words, is it a one-time only thing? And what does it get you if you still have to fight it out in each jurisdiction?

Phil Corwin: Well what it should - it is from our understanding of it it is quite simple, an IGO simply notifies WIPO that it is covered by the Paris Convention. WIPO in turn notifies all the signatory nations to the Paris Convention as well as all the nations that are part of the World Trade Organization. There's a lot of overlap but there's also some that are in one but not the other.

And each of those nations is supposed to note the name and the acronym, whatever the IGO has asked protection for. And to be on alert to protect identical or misleading trademark registrations within their own nation against those marks.

So it's supposed to provide them with the sense of protection in each individual nation. Of course that's not full proof. Sometimes mistakes can be made and that's when they might have to go to the national trademark authority or to the courts and say you let someone register a trademark which infringes our Paris Convention rights and can mislead the public.

Stephanie Perrin: But at the risk of over-simplifying again, that essentially throws the ball into national courts. It's up to the national governments who are running their own trade processes to sort that one out, correct?

Phil Corwin: From what we've learned so far, and we need a more comprehensive survey of how different nations implement this and what they do when an IGO has a complaint that they haven't been adequately protected, but so far what we

found is that, yes, the remedy is, if you think a trademark has been registered in violation of your Paris Convention rights, the only two possibilities are use - if there's an administrative means of challenging the trademark registration and getting it stricken, to use that or if that doesn't work or isn't available to go in and file a legal action.

So we don't know of any other way that an aggrieved IGO could tend to what they say is a mistake made by a national trademark system.

Stephanie Perrin: Thank you. Very helpful.

Phil Corwin: But we'll be getting into all of this in more detail as we begin our discussion of sovereign immunity which will commence this coming Friday.

Jonathan Robinson: Thanks, Stephanie. Thanks, Phil. James is next and then I think we have to wrap this up and move on.

James Bladel: Oh I'll be quick. First just two quick points, first I just want to point out one of Mason's statements that - because I don't think it's ever been said before, that the GNSO is moving too quickly through its PDP process for the GAC to catch up intercessionally. So let's just kind of make sure that that's on the record that we're - we have to slow down and wait for other groups to catch up. I don't know that that's ever been said publicly.

The second thing, Phil, and maybe I'm just not picking up on this, but the sovereign immunity issue, I'm trying to figure out how that is relevant to what we're - I mean, this isn't - I think this is what Stephanie was getting at, this isn't a court here.

We're trying to come up with an administrative process and while that may have some relevance outside of ICANN, I'm trying to understand what the bearing of that issue is on the work of a PDP where we're trying to extend some, you know, kind of just, you know, administrative or contractual protections to these groups that they don't otherwise have.

You know, so I'm really struggling with why that is, you know, kind of the linchpin right now. Maybe you can help me untangle that.

Phil Corwin: Well it's only - it would only arise in the very rare instance of a IGO using one of the existing dispute resolution process, probably the UDRP because they would probably want to acquire the offending domain rather than just suspend it. And also that would be their only remedy in an incumbent gTLD as opposed to a new one.

That they either they bring the action, they lose it and they want to appeal and the way to appeal is to a court or national jurisdiction, or they even more rare case of they bring a UDRP against what appears to be an infringing registration that would mislead the public that, you know, the registrant is masquerading as one of these UN agencies. And somehow they lose it or they win it and the registrant wants to throw their money away and appeal to file a very expensive appeal to a national court. And then their only way to protect their UDRP win would be to go in and contest that national court filing.

We're talking about very rare instances in which this would arise. We're assuming that most of these disputes, which are rare anyway, would be resolved at the arbitration level with no recourse to national courts as a matter of appeal. So we're only talking about a very tiny percentage were there to be an appeal from the original decision of the arbitrators.

James Bladel: Okay thanks. So that's - if they lose they want to pursue it further or if they win and the other party wants to...

Phil Corwin: Right.

James Bladel: ...seek some sort of redress, okay. Thanks.

Jonathan Robinson: Okay thanks, Phil. Thanks, James. I'm just mindful of the time. We're a little bit behind schedule already. I think we will catch up as we go through.

But let's move on. So we probably need to stop the recording at that point, do we? And so let's close that item.