**Public Comment Review Tool – EPDPSPCR-IGO – Initial Report**

Updated 04 November 2021

# RECOMMENDATION 1

| **#** | **Comment** | **Contributor** | **EPDP Response / Action Taken** |
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| **Recommendation #1: Definition of “IGO Complainant”**  The EPDP team recommends that the UDRP Rules and URS Rules be modified in the following two ways:   1. Add a description of “IGO Complainant” to section 1 (i.e., the definitions section of both sets of Rules):   “‘IGO Complainant’ refers to:  (a) an international organization established by a treaty and which possesses international legal personality; or  (b) an ‘Intergovernmental organization’ having received a standing invitation to participate as an observer in the sessions and the work of the United Nations General Assembly; or  (c) a Specialized Agency or distinct entity, organ or program of the United Nations.”  AND   1. Add the following explanatory text to UDRP Rules Section 3(b)(viii), URS Section 1.2.6 and URS Rules Section 3(b)(v):   “Where the Complainant is an IGO Complainant, it may show rights in a mark by demonstrating that the identifier which forms the basis for the complaint is used by the IGO Complainant to conduct public activities in accordance with its stated mission (as may be reflected in its treaty, charter, or governing document).” | | | |
|  | We support the progress reflected in the proposed IGO definition | WIPO | Support  **EPDP Response:**  The EPDP Team has considered this comment.  **Action Taken:**  None  [**COMPLETED**] |
|  | Subject to our above-noted concerns, Preliminary Recommendation #1 appears to satisfactorily define IGOs. Preliminary Recommendation #1also appears to provide an apparently reasonable means of an IGO demonstrating its rights in a mark. | Internet Commerce Association | Support  **EPDP Response:**  The EPDP Team has considered this comment.  **Action Taken:**  None  [**COMPLETED**] |
|  | The RySG believes this a clear and targeted definition that contributes to an appropriate scope for these recommendations. | RySG | Support  **EPDP Response:**  The EPDP Team has considered this comment.  **Action Taken:**  None  [**COMPLETED**] |
|  | Digimedia supports Recommendation 1 to the extent that IGOs are properly defined and quantified. We do this while fully recognizing that Recommendation 1 does not assist all IGOs, as (per the previous IGO working group’s independent expert) some IGOs have already satisfactorily utilized the UDRP without the need for Recommendation 1. | Digimedia.com, LP | Concerns  Support  **EPDP Response:**  The EPDP Team acknowledges the concern raised regarding the previous WG’s recommendation and connection to 6ter.  **Action Taken:**  Task the small team to properly define the scope of the term “identifier”.  [**NOT COMPLETED**]  [Instruction of what was done.] |
|  | We oppose this recommendation. While others in the community might not have paid much attention to it, given the more radical ideas in other recommendations, the new working group is essentially rewriting the prior working group's Recommendation #2.  The new captured working group ignored how the old working group arrived at Recommendation #2. Initially, the old working group recommended that presence in the Article 6ter database alone was sufficient to meet the first part of the 3-part UDRP/URS test  [Note: there was some confusion amongst some readers as to what was meant by 'standing'. Using the most strict definition of 'standing', anyone can file a UDRP/URS regardless of whether or not they have trademark rights. So, it's not that sense of the word 'standing' that is meaningful from a policy debate. Instead, the 'broader' way the word 'standing' was used by many is that a complainant who had met the first part of the 3-part UDRP/URS test was said to have "standing". One can see that this broader definition of 'standing' (i.e. meeting the first part of the 3-part test) is widely used, e.g. even in the WIPO 3.0 Overview[13](#_bookmark12), for example,   * 1. Do registered trademarks automatically confer **standing** to file a UDRP case?      1. Where the complainant holds a nationally or regionally registered trademark or service mark, this prima facie satisfies the threshold requirement of having trademark rights for **purposes of standing** to file a UDRP case. [emphasis added]   However, the public comments[14](#_bookmark13) and response to that initial recommendation of the old working group was that it went too far.[15](#_bookmark14) The US government stated:  The U.S. disagrees with this recommendation because it incorrectly concludes that an IGO has standing, and therefore a right that is equivalent or similar to trademark rights, based on completion of the communication and notification under Article 6ter. This procedure does not have any legal effect under the terms of the treaty itself and therefore, there is no international right. Further, there is no harmonized approach among treaty members in implementation of Article 6ter.  Similar, the IPC said:  First, IPC does not support using 6ter notifications as an independent basis for standing under the UDRP or URS. The mere notification to WIPO that an entity is claiming 6ter rights does not provide a sufficient basis for standing to bring a claim.It might be possible to consider whether (a) a 6ter notification has been actively accepted by any national trademark office and (b) conversely, whether a 6ter notification has been rejected by any national trademark office, in considering whether to allow standing. However, this seems both complex and uncertain.  Thus, the old working group **changed** its recommendation, so that being in the Article 6ter database was no longer sufficient on its own to automatically meet the first part of the 3-part UDRP/URS test. It could form a piece of evidence, along with other evidence, to show unregistered "common law" rights, similar to how other complainants show demonstrate their rights when they lack a national trademark registration. As Paul McGrady said during the new working group meetings, it's a very low bar, and one simply needs to gather the evidence (do some web searches showing some publicity for a name, that it was being used, etc.). Any lawyer worth their salt could satisfy the first part of the 3-part UDRP/URS test in their sleep. All it requires is minimal education and/or experience.  [As an aside, some IGOs think that it's impossible for them to show "use in commerce" for common law trademarks, as they are non-profit. That's a myth, because many non-profits and charities do own trademark registrations. One need only scan the USPTO for phrases like "promoting awareness of" or similar broad/creative language, that meets the burden. See, for example US Registration Number 6352406 for "500 WOMEN SCIENTISTS"[16](#_bookmark15)]  So, that's why the prior working group's recommendation regarding Article 6ter was changed, to no longer make it an "automatic pass" of the first part of the test. Some minimal additional evidence was required, just like any other similarly situated complainant, to pass that hurdle.  Pragmatically, UDRP/URS cases are rarely decided by the first part of the test - the heart of of the domain dispute is usually the 2nd and 3rd parts (especially the third part regarding bad faith registration and bad faith usage). In a real sense, the old working group had worked hard to lower that initial hurdle just a tiny bit, but the pushback forced us to change it.  However, the new working group's recommendation **goes much further beyond even what the old working group's initial recommendation had been**. It would dramatically expand the definition far beyond even Article 6ter registration, which would be unacceptable.  Why unacceptable? If one reads the proposed recommendation carefully, it says that all an IGO needs to do is is demonstrate "that the identifier which forms the basis for the complaint is used by the IGO Complainant to conduct public activities in accordance with its stated mission."  If one parses that carefully, that goes well beyond even the name of the organization. It could literally be anything, for example the name of a newsletter, the name of an event, the name of a project, simply any term used by an IGO.  Why is that a problem? It's a problem because many terms can never be trademarked (e.g. because they are generic, descriptive, or other more esoteric reasons like primarily a surname, etc.).  For example, if an IGO called their newsletter simply "News" or their event "The Event", it would literally meet the test proposed by this new working group. That's unacceptable, as those terms are explicitly generic for those uses.  Another reason why the expanded definition, beyond the prior working group's recommendation, has problems is that there is little to no chance of the registrant having "**constructive notice**" of the identifier's usage (let alone, actual notice), if it's not in the Article 6ter database. With the old working group's Recommendation #2, a diligent domain name registrant could at least search the Article 6ter database for matching terms, to avoid registering domains that might conflict with terms used by IGOs [some of those recordals might also show up in national trademark databases, like the 8900-series ones in the USPTO; by the way, the old working group members were certainly aware that those were not trademarks in themselves, but merely recordals of potential blocking rights; some folks in the new working group didn't think we knew that, perhaps as the staff who wrote the report didn't make it clear].  In conclusion, this captured working group simply went beyond the scope of its mandate, and made it far too easy for an IGO to make complaints about **any identifier**, regardless of whether it is even generic or merely descriptive. If instead the very first recommendation (in the old working group's initial report) is desired, so that Article 6ter registration alone is sufficient to pass the first part of the three-part test, we can support that as a middle ground (despite the past objections of the US Government and IPC). At least with a minimal effort, an IGO can register in the Article 6ter database and declare to the world that "this mark is important to us", letting domain name registrants and others be aware that those are terms to avoid in the event their intended usage would be confusing to the public. [and as we know, many acronyms have multiple uses, so Article 6ter registration would not permit any monopolization of terms] An IGO would still need to prove the 2nd and 3rd parts of the 3-part UDRP/URS test, so good faith domain name registrants would still be protected.  13 WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, <https://www.wipo.int/amc/en/domains/search/overview3.0/>   1. <https://forum.icann.org/lists/comments-igo-ingo-crp-access-initial-20jan17/> 2. Report of Public Comments, May 5, 2017, [https://itp.cdn.icann.org/en/files/generic-names-supporting- organization-council-gnso-council/report-comments-igo-ingo-crp-access-initial-05may17-en.pdf](https://itp.cdn.icann.org/en/files/generic-names-supporting-organization-council-gnso-council/report-comments-igo-ingo-crp-access-initial-05may17-en.pdf) 3. 500 WOMEN SCIENTISTS trademark registration, US Registration #6352406, [https://tsdr.uspto.gov/#caseNumber=90086485&caseType=SERIAL\_NO&searchType=statusSearch](https://tsdr.uspto.gov/#caseNumber%3D90086485%26caseType%3DSERIAL_NO%26searchType%3DstatusSearch) | Leap of Faith Financial Services Inc. | Divergence  **EPDP Response:**  The EPDP Team acknowledges the concern; however, the recommendation cannot be viewed in isolation. and the word “identifier” may therefore have been misunderstood. The EPDP Team’s objective is to ensure that an IGO that may not have a registered trademark can be eligible to proceed under the UDRP or URS by demonstrating unregistered rights that are functionally equivalent to a trademark through use in the conduct of its public activities as stated in its mission.  The EPDP Team’s recommended definition of an “IGO Complainant” is consistent with criteria that the Governmental Advisory Committee (GAC) used to develop its list of protected IGOs. Changes and updates to the GAC’s list is outside the scope of this EPDP; however, in relation to the comment about “constructive notice”, the EPDP Team believes that the GAC’s list can be a useful source of information to potential registrants as to the entities that satisfy the eligibility criteria for “IGO Complainants”. In this regard, the EPDP Team may consider recommending that ICANN org ensure that the GAC’s list is made publicly available in an accessible online location.  .  **Action Taken:**  Following discussion of the proposed small team work on the term “identifier”, consider adding explanatory text to the Final Report on Recommendation 1.  [**NOT COMPLETED**]  [Instruction of what was done.] |
|  | Subject to review and consideration by the expert Phase 2 RPM Working Group, the BC supports Preliminary Recommendation 1, as it is consistent with our previous position in favor of further “assist[ing] IGOs in accessing their existing rights under the existing UDRP and URS” and that “IGOs should be able to access the UDRP even without a registered trademark”. The BC therefore supports the proposed inclusion of a definition of “IGO Complainant” and the accompanying proposed explanatory text regarding how an IGO may show rights in a mark. | ICANN Business Constituency (BC) | Concerns  Support  **EPDP Response:**  The EPDP Team has considered this comment.  **Action Taken:**  None. The GNSO Council has the authority to decide whether to refer the EPDP Team’s recommendations to the Phase 2 RPM Working Group (when that work is initiated).  [**COMPLETED**] |
|  | To this end the ALAC supports the following preliminary recommendations:  Preliminary Recommendation #1 which seeks to provide clarity and reasonable certainty as to which entities are deemed as IGOs and defines an “IGO Complainant” for purposes of the UDRP and URS.. | ALAC | Support  **EPDP Response:**  The EPDP Team has considered this comment.  **Action Taken:**  None  [**COMPLETED**] |
|  | The IPC supports these proposed changes.  Consider modifying “…having received a standing invitation to participate…” to “…having received, accepted, and is actively engaging in, a standing invitation to participate…”  Consider adding “Such use shall not be a token use” at the end of the final sentence, such that the revised sentence reads ““Where the Complainant is an IGO Complainant, it may show rights in a mark by demonstrating that the identifier which forms the basis for the complaint is used the IGO Complainant to conduct public activities in accordance with its stated mission (as may be reflected in its treaty, charter, or governing document). Such use shall not be a token use.”  Consider specifying for the sake of clarity how this Recommendation #1 relates to the original Recommendation #2 from the IGO-INGO Access to Curative Rights Protections PDP (“Old 2”). From the Deliberations section it appears that the intent is to supplement Old 2 but from the Recommendation alone this may be misunderstood.  Implementation Suggestion: in order to ensure that the IGO's identification is applied consistently throughout policy development across the organization, we recommend that those keeping the IGO Identifier List use the identical system we set forth in this Recommendation going forward. | IPC | Support New Idea  **EPDP Response:**  The EPDP Team has considered this comment.  **Action Taken:**  Suggested changes will be considered by the EPDP team.  [**COMPLETED**] |