

# **FINAL ISSUE REPORT ON AMENDING THE UNIFORM DISPUTE RESOLUTION POLICY AND THE UNIFORM RAPID SUSPENSION PROCEDURE FOR ACCESS BY PROTECTED INTERNATIONAL GOVERNMENTAL ORGANIZATIONS AND INTERNATIONAL NON-GOVERNMENTAL ORGANIZATIONS**

## **STATUS OF THIS DOCUMENT**

This is the Final Issue Report on whether to amend the Uniform Dispute Resolution Policy (UDRP) and Uniform Rapid Suspension (URS) procedure to enable access to them by protected International Governmental Organizations (IGOs) and International Non-Governmental Organizations (INGOs). This Report is prepared for the Generic Names Supporting Organization (GNSO) Council following the closure of the public comment forum on the Preliminary Issue Report on 6 May 2014. The Preliminary Issue Report had been published for public comment on 10 March 2014.

## **SUMMARY**

This Final Issue Report is submitted to the GNSO Council in response to a request made pursuant to a unanimous GNSO Council decision taken during the GNSO Council meeting in Buenos Aires in November 2013.

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## I. Executive Summary

### **Issue:**

This Final Issue Report is published in response to a request for an Issue Report by the GNSO Council, made in November 2013, to outline the various policy issues that may need to be considered should the GNSO Council decide to proceed with launching a Policy Development Process (PDP) to determine whether the curative rights protection mechanisms currently in place for both existing and new gTLDs should be amended and, if so, how, to permit their use by International Governmental Organizations (IGOs) and International Non-Governmental Organizations (INGOs). As currently designed, IGOs and INGOs have difficulties in relying on these curative mechanisms, namely, the Uniform Dispute Resolution Policy (UDRP) and Uniform Rapid Suspension procedure (URS). For IGOs, since the procedural rules for both processes require that the party filing the complaint state its agreement to submit to the jurisdiction of a national court for purposes of a challenge to the initial determination, this could jeopardize their immunity from national jurisdiction. In addition, both processes were originally designed to be mechanisms to protect the rights of trademark owners – while some IGOs and INGOs might own trademarks in either their organizational names or acronyms or both, this is not necessarily true in all cases.

### **Background to this Issue Report:**

At its meeting on 20 November 2013, the GNSO Council unanimously adopted all the consensus recommendations made by the GNSO's PDP Working Group on the Protection of International Organization Names in All gTLDs (IGO-INGO WG). One of these recommendations was for the GNSO Council to request an Issue Report, to assist in determining whether a PDP should be initiated in order to explore possible amendments to the UDRP and the URS, to enable access to and use of such curative rights protection mechanisms by protected IGOs and INGOs. The GNSO Council also adopted the IGO-INGO WG consensus recommendations for varied protections at the top and/or second level for certain specified names and acronyms of IGOs and INGOs (including certain identifiers of the Red Cross movement and the International Olympic Committee). A list of those approved identifiers is appended to this Issue Report as Annex 2.

The 2007 [GNSO Issue Report on Dispute Handling for IGO Names & Abbreviations](#) had analyzed some possible methods for handling domain name disputes concerning IGO names and abbreviations (but not those of INGOs). A PDP on the topic was not initiated however due to lack of the requisite number of votes in

the GNSO Council. Previously, in 2003, an ICANN Joint Working Group comprising community members from the At Large Advisory Committee (ALAC), the Government Advisory Committee (GAC) and the GNSO had also discussed various possible dispute resolution mechanisms for IGOs in response to a 2001 report on the applicability of the UDRP to certain types of identifiers (including those of IGOs) by the World Intellectual Property Organization (WIPO). The Joint Working Group failed to reach consensus on WIPO's recommendations, and no further formal action was taken by the GNSO Council or ICANN on the matter.

In developing the Applicant Guidebook (AGB) for the New gTLD Program, several objection procedures and new rights-protection mechanisms were created, some of which can be used by qualifying IGOs and INGOs. The AGB did not contain any specific rules that pertained exclusively to either preventative (i.e. prevent the harm from occurring by excluding an identifier from registration or delegation) or curative (i.e. an organization that claims to have suffered harm is able to file a dispute to cure the defect or problem) rights protections for IGOs or INGOs related directly to their status as international organizations. Rather, the AGB prescribed that organizations that met the existing criteria for a .int registration could avail themselves of the legal rights objection process, and organizations that owned trademark and other intellectual property rights in their names and/or acronyms could participate in the new Trademark Clearinghouse and the associated sunrise and Trademark Claims notice processes. These organizations could also access and use the new URS procedure, on the basis that they own a relevant trademark.

In authorizing the launch of the New gTLD Program in June 2011, the ICANN Board directed that top-level protections for certain Red Cross and International Olympic Committee identifiers be included in the final AGB. In November 2012, second-level protections for certain Red Cross and International Olympic Committee identifiers were added. These protections were intended to be interim measures, applicable while the GAC and GNSO continued to develop policy advice concerning appropriate protections for these two INGOs at the top and second level. Subsequently, protection for a specific list of IGO names and acronyms provided by the GAC was granted in response to advice from the GAC, again on an interim basis to allow new gTLDs to begin launching while policy development continued. The GAC had issued advice on the matter in various Communiqués and letters of advice published between 2011 and 2013.

In April 2014 the ICANN Board took action to [adopt](#) those of the GNSO's consensus recommendations that were not inconsistent with GAC advice on this topic. The Board also resolved to continue to facilitate

dialogue between the affected parties, including the GAC and the GNSO, to achieve resolution of the remaining differences between the GAC advice and GNSO recommendations.

**Staff Recommendation:**

Staff recommends that the GNSO Council initiate a PDP to explore whether, as a policy matter, the UDRP and URS should be modified to enable access to and use of them by IGOs and INGOs whose names and acronyms are protected at the second level; and if so, to develop policy recommendations to guide the necessary amendments or other recommended procedures, as applicable. In view of the prior work that was done on developing dispute resolution processes applicable to IGOs, staff further recommends that in initiating the PDP and creating the PDP Working Group (WG), the GNSO Council direct the WG to take into account the various considerations and suggestions outlined in this Issue Report. In particular, the WG should take into account the specific issues described in Sections IX and the additional considerations listed in Section X of this Issue Report, including the need to gather additional data and research as an initial phase of the work, and the possibility that instead of amending the UDRP and URS, it may be more appropriate to create a separate, narrowly-tailored dispute resolution procedure for second level protections modeled on the UDRP and URS to accommodate the particular needs and specific circumstances of protected IGOs and INGOs. In view of the number of possible issues identified as suitable for consideration in this PDP, staff recommends that the GNSO Council also consider the minimum time it would take to complete a PDP and the nature and extent of the staff and community resources that will be necessary, in determining the scope of the charter for the PDP WG. Staff further recommends that the scope of IGO and INGO identifiers that are to be protected by any recommendations made pursuant to this PDP be limited to those identifiers previously listed by the GNSO's PDP WG on the Protection of International Organization Identifiers in All gTLDs in their consensus recommendations as identifiers eligible for protection (designated by that WG as Scope 1 and Scope 2 identifiers, and listed in Annex 2 of this Final Issue Report).

## II. Objective and Next Steps

This Final Issue Report is prepared at the request of the GNSO Council, as a mandatory preceding step to a possible PDP on the possibility of amending the UDRP and URS so as to permit IGOs and INGOs to access and utilize these dispute resolution processes (DRP), which may include consideration of a separate narrowly tailored DRP suitable for use by these organizations in relation to their protected identifiers.

This Report addresses the GNSO Council's specific request for an Issue Report concerning consensus recommendation 3.5.3 from the GNSO's IGO-INGO WG, which recommended that "the respective policies are amended so that curative rights of the UDRP and URS can be used by those organizations that are granted protections based on their identified designations". This recommendation was adopted unanimously by the GNSO Council at its 20 November 2013 meeting in Buenos Aires (see <http://gns0.icann.org/en/council/resolutions#201311>).

A Preliminary Issue Report on the topic of IGO and INGO access to the UDRP and URS was published for public comment on 10 March 2014. The public comment forum closed on 6 May 2014. A report of the public comments received has been published and is attached to this Final Issue Report as Annex 4. Public comments pertaining to the contents of the Preliminary Issue Report have been incorporated into this Final Issue Report, including in Section VIII. Following review of this Final Issue Report, the GNSO Council will vote on whether or not to initiate a PDP.

### III. Overview of the UDRP and the URS

#### 1. The Uniform Dispute Resolution Policy (UDRP)

The UDRP is one of a number of “[Consensus Policies](#)” recommended by the GNSO and adopted by the ICANN Board in 1999. Under ICANN’s contracts with gTLD Registry Operators and accredited ICANN Registrars, compliance with certain specified procedures and “Consensus Policies” that are developed in consultation with ICANN’s stakeholders is required. For example, the Consensus and Temporary Policies Specification of the 2013 Registrar Accreditation Agreement (RAA) states expressly (in [Section 1.1.2.4](#)) that the resolution of disputes over domain names is considered a suitable topic for “Consensus Policy” development.

The initial idea for a uniform policy for dispute resolution involving domain names had initially been proposed by WIPO in April 1999, in its [Final Report on the WIPO Internet Domain Name Process](#). This proposal formed the basis upon which the DNSO Names Council (the precursor to what is now the GNSO Council) developed policy recommendations that were sent to the Board regarding a uniform dispute resolution policy. The Board [approved](#) the UDRP itself on 24 October 1999. Since the UDRP was enacted, over 30,000 UDRP complaints have been filed with ICANN approved dispute resolution service providers.

The [UDRP](#) is a mandatory administrative proceeding applicable to all domain names registered in gTLDs as imposed through the Registrar Accreditation Agreement (RAA), which is the contract between ICANN and all its accredited Registrars, and flows through to the Registration Agreement between a Registrar and a domain name registrant. Under the UDRP, registering a domain name that is identical or confusingly similar to a trademark or service mark in which the complainant has rights can result in a cancellation or transfer of that registration if the registrant has no rights or legitimate interests in that domain name, and registered and uses it in bad faith. UDRP proceedings, whether merely commenced or already concluded, do not preclude recourse to a court of competent jurisdiction by either party.

The UDRP has not been amended since it was initially approved by the ICANN Board in 1999. As it is a “Consensus Policy”, any substantive amendments to the policy will need to go through a GNSO PDP. However, the procedures outlined in the UDRP Rules can be (and have been) amended without the need for a PDP, as occurred in [October 2009 when certain procedural changes were made that were consistent with the policy](#). It may be worth noting that an Issue Report reviewing all rights protection mechanisms (current

and developed for the New gTLD Program) including the UDRP and URS was requested by the GNSO Council, to be delivered eighteen months after the first delegation of new gTLDs (which occurred in October 2013). Should a PDP on IGO and INGO access to the UDRP and URS be initiated by the GNSO Council, the work of that PDP will need to be taken into account for the preparation of the Issue Report at that time.

## 2. The Uniform Rapid Suspension (URS) Procedure

In June 2008, the ICANN Board [adopted](#) the GNSO's policy recommendations for introduction of new gTLDs, and directed ICANN staff to develop a detailed implementation plan. This resulted in the [publication](#) for public comment of the first draft Applicant Guidebook (AGB) in October 2008. The AGB underwent a number of revisions based on public comment, community contributions and GAC advice, with the [final version](#) being published in January 2012. The URS was developed and finalized as part of the AGB process to address the need to provide a rapid, inexpensive method for trademark holders to protect against illegitimate bad faith uses of their trademarks at the second level, with the final version of the [URS Procedure](#) published in March 2013 and the accompanying [URS Rules](#) published in October 2013. The first case under the URS concerning a domain name in the New gTLD Program was filed and decided in the complainant's favor in February 2014.

The URS was initially proposed in 2009 by an [Implementation Recommendations Team](#), convened by the GNSO's Intellectual Property Constituency (IPC) at the request of the ICANN Board to develop appropriate rights protection mechanisms for trademark holders in the New gTLD Program. It was subsequently refined through community feedback, including work undertaken by a GNSO cross-constituency [Special Trademark Issues](#) team. The substantive grounds upon which a URS complaint is based are the same as under the UDRP (although the URS requires in addition that the mark triggering the complaint either be in current use, validated through court proceedings or protected under a treaty or statute in effect at the time the complaint is filed). There are, however, significant differences between the two procedures in terms of the required burden of proof and the remedies available. Since it was designed to be a cheaper, more streamlined and faster version of the UDRP, applicable to clear-cut cases of abuse, a successful complaint under the URS requires clear and convincing evidence of abuse whereas the burden of proof under the UDRP is lower. Similarly, where a successful UDRP claim may result in either cancellation or transfer of a domain name, remedies under the URS are limited to suspension of the domain name for the duration of its registration. However, as with the UDRP, recourse to a court of competent jurisdiction (as well as the possibility of lodging a complaint under the UDRP itself) is a feature of the URS. Also, as noted before, the URS only applies to domain name registrations under the new gTLD program, while the UDRP applies to all.



## IV. Background to the Issue and the Current State of Protection for IGO & INGO Identifiers in the New gTLD Program

In June 2011, the ICANN Board formally approved the launch of the New gTLD Program and [directed](#) that the Applicant Guidebook be amended to incorporate text relating to top-level protection of specific names requested by the International Committee of the Red Cross, the International Federation of the Red Cross and Red Crescent Societies and the American Red Cross (collectively, the RCRC) and the International Olympic Committee (IOC), until such time as the GNSO and the GAC develop policy advice on the topic based on the global public interest. In September 2011, the GAC [recommended](#) to the GNSO that RCRC and IOC names be protected via reservation at the second level. The GNSO Council formed a Drafting Team (DT) in October 2011 to develop recommendations for top and second level protections for RCRC and IOC names.

In January 2012, a revised AGB that included prohibitions on the delegation of certain RCRC and IOC names at the top level for the New gTLD Program was published. In March 2012 three of the GNSO's DT recommendations relating to top level protection for RCRC and IOC names were [approved](#) by the GNSO Council; however, the ICANN Board [determined](#) in April 2012 that the public interest would be better served if the AGB remained unchanged, thus maintaining the temporary moratorium on the RCRC and IOC names at the top level. In September 2012 the ICANN Board [requested](#) that the GNSO continue its work on second level protections for RCRC and IOC names. In November 2012 the ICANN Board, acting through its New gTLD Program Committee (NGPC), passed a [resolution](#) approving interim restrictions on second level registrations for certain RCRC and IOC identifiers. The protections granted to the RCRC and IOC were based on the fact that these organizations perform global public interest missions that are recognized through the provision of unique legal protections under both international treaty and multiple national laws; a position that was [supported](#) by the GAC.

In December 2011, legal counsel from twenty-eight IGOs sent a [letter](#) to the ICANN Board in December 2011 requesting exclusion from registration of their organizational names and acronyms at both the top and second levels in the first round of the New gTLD Program. The letter highlighted the IGOs' public interest missions on a number of vital causes ranging from education and scientific research to disaster relief and

public health, and noted that combating abusive registrations in the absence of special protections would mean the diversion of resources otherwise earmarked for their mandated missions. In addition, the IGOs stated that organizational identifiers of many IGOs are protected under international legal instruments. In March 2012 the ICANN Board [asked](#) the GNSO and the GAC to provide it with advice concerning the IGOs' request.

Pursuant to the ICANN Bylaws, the GNSO Council [requested](#) an Issue Report in April 2012 as a preceding step to a possible PDP on the issue. In October 2012 the GNSO Council [approved](#) a motion to launch an expedited PDP to determine, first, whether additional special protections were needed at the top and second levels for the names and/or acronyms of both IGOs and INGOS (including further consideration of protections for RCRC and IOC names) and if so to develop policy proposals for such protections; and, secondly, to consider whether such policies should also apply to existing gTLDs. During its deliberations the IGO-INGO WG requested that ICANN's General Counsel provide it with [legal research](#) into whether specific jurisdictions prohibited either the assignment (at the top level) or registration (at the second level) of IGO and INGO names and acronyms protected under international treaties or various national laws. The General Counsel sampled eleven jurisdictions across all five ICANN geographic regions and noted that a number of jurisdictions provide legal protection to the RCRC, IOC and IGOs but that there were no universal criteria applicable to protections afforded to either IGOs or INGOS.

The IGO-INGO WG published its [Initial Report](#) for public comment in June 2013 and its [Final Report](#) (incorporating feedback received in response to its Initial Report) in November 2013. All of the IGO-INGO WG's consensus recommendations in its Final Report were [adopted unanimously](#) by the GNSO Council at its meeting on 20 November 2013. One of these consensus recommendations was that the GNSO Council should consider initiating a PDP to amend the UDRP and URS so as to permit IGOs and INGOS to access and use these curative rights protection measures. This recommendation was formulated upon the IGO-INGO-WG's recognition that such a proposal would require a PDP, especially given the fact that the UDRP is a Consensus Policy binding on all ICANN-accredited registrars. Although the IGO-INGO WG discussed the question of cost and fees for using the UDRP and URS, it did not reach consensus on the specific question as to whether IGOs and INGOS ought to receive either a fee waiver or reduced pricing should a UDRP or URS action be filed.

In its Communiqués from the ICANN meetings in [Toronto](#) (October 2012) and [Beijing](#) (April 2013), the GAC had advised the ICANN Board that it considered IGOs to be in an objectively different category to other

rights-holders, which would warrant special protection by ICANN. The GAC had emphasized the need for preventative protection for these IGOs in an expanded domain name system (DNS) as they perform important global public missions using public funds. Following consultations between the IGO coalition and the GAC, in March 2013 the GAC sent the ICANN Board the agreed criteria and a final list of IGO names and acronyms it recommended be protected at the second level in the current round of new gTLDs. The GAC did not include any recommendations relating to protections either at the top or second level for INGOs, except for the RCRC and IOC, for which the GAC considered a similar cost-neutral mechanism to be appropriate.

In July 2013, the ICANN Board, acting through the NGPC, [directed](#) that protections be provided for the list of IGO names and acronyms provided by the GAC, in the form of a requirement in the New gTLD Registry Agreement that appropriate preventative protections be provided for the IGO identifiers on the GAC list. The NGPC subsequently [confirmed](#) that these protections were to remain in place “as the GAC, NGPC, ICANN staff and community continue to actively work through outstanding implementation issues”. In its November 2013 Buenos Aires [Communique](#), the GAC stated its intention to continue to work with the NGPC and the IGOs to develop a “complementary cost-neutral mechanism” to provide notification to a protected IGO should a third party attempt to register a second-level domain name matching the IGO’s acronym, and allow for independent third party review of the registration request. In February 2014, the Board [acknowledged](#) receipt of the GNSO’s consensus recommendations, asked for additional time to consider them and directed its NGPC to actively develop a comprehensive proposal for subsequent Board consideration that would take into account both GAC advice and the GNSO recommendations. The NGPC [sent](#) a proposal to the GAC in March 2014. In April 2014 the Board took action to [adopt](#) those of the GNSO’s unanimous recommendations that are not inconsistent with GAC advice and requested additional time to consider the other recommendations. It also resolved to facilitate discussion among the relevant parties, including the GAC and the GNSO, to resolve the remaining differences.

As of the date of publication of this Final Issue Report, therefore, the current state of protection in the New gTLD Program for IGO names and acronyms is the interim protections granted by the NGPC to those IGOs specified on the GAC’s list of March 2013. For INGOs, the only organizations to have obtained interim protections at the top and second level are the RCRC and IOC, for certain of their names and acronyms. None of the ICANN Board’s resolutions or the GAC’s advice specifically extends protections, whether preventative or curative, temporary or otherwise, to other INGOs. Much of the GAC’s advice and Board actions in relation to IGO, RCRC and IOC protections have focused on preventative protections, i.e. exclusion from registration. The remaining differences between the GAC advice and GNSO recommendations on IGO acronyms centers

on two issues: first, the GAC has requested preventative second level protection for IGO acronyms through a permanent (not a 90-day period as was recommended by the GNSO) claims notice process via the Trademark Clearinghouse (TMCH); secondly, the GAC has requested that disputes at the second level for IGO acronyms and certain acronyms of the RCRC's international entities be subject to binding third party arbitral review (instead of an appeal to a national court) and be cost-neutral for the IGOs and the RCRC.

To date, neither IGOs nor INGOs have been designated as a specific category of entities that are to receive protection under existing measures, such as are available under the UDRP and URS for trademark holders. However, certain IGOs and INGOs may nonetheless be able to use these and other existing mechanisms to protect their organizational identifiers but only if they meet the respective criteria of the protective mechanism in question, such as ownership of a trademark represented by the domain name under dispute in a UDRP or URS proceeding, although IGOs will under the current systems need to submit to the jurisdiction of a national court in order to use these two processes. In its deliberations, the IGO-INGO WG considered evidence that some INGOs had filed UDRP proceedings in attempts to protect their organizational identifiers in existing gTLDs.

Despite the fact that the GAC advice on IGO, RCRC and IOC protections have largely focused on protections pertaining to the New gTLD Program, it should be noted that the GNSO Council did not limit its request to the exploration of the issue of IGO and INGO access to the UDRP and URS to the New gTLD Program. As such, any PDP initiated on the topic will also have to consider the applicability of any such curative protections to the legacy gTLDs as well.

## V. The 2007 GNSO Issue Report on Dispute Handling for IGO Names & Abbreviations

The challenges specific to IGOs in utilizing the UDRP were previously documented in the June 2007 [GNSO Issue Report on Dispute Handling for IGO Names & Abbreviations](#) (2007 GNSO Report), which noted, first, that IGOs do not necessarily have registered trademark rights in their names or acronyms, and, secondly, that the UDRP requirement that a party submit to the jurisdiction of a national court jeopardizes an IGO's immunity from such jurisdiction, thus raising questions of sovereignty for international treaty-based organizations. In the 2007 GNSO Report, a "strong preference" for creating a separate dispute resolution procedure (DRP) rather than modifying the existing UDRP was noted amongst those GNSO constituencies willing to support a dispute handling mechanism for IGOs.

The 2007 GNSO Report did not recommend that the GNSO proceed with a PDP on dispute handling for IGOs at the time; instead, it recommended that a more efficient way forward would be to create a separate DRP for IGO names and acronyms at the second (or even third) level in new gTLDs, with a framework to be developed for handling objections or challenges related to IGO names and acronyms at the top level as part of the application round for new gTLDs. On that basis, the GNSO Council could then consider, at a later date, initiating a PDP on the following terms:

1. Given a dispute resolution procedure for IGO names and abbreviations, developed for the new gTLD process, investigate the following:
  - (a) Are any modifications in the rules or their application essential for the adoption of the DRP as a consensus policy?
  - (b) Should existing domain names be treated differently from new ones in relation to the DRP and, if so, in what respects?

However, no action was subsequently taken by the GNSO relating to IGO names and acronyms and a PDP was not initiated as the GNSO Council motion on the matter failed for lack of the requisite number of votes.

It should be noted that the 2007 GNSO Report was completed prior to the launch of the current round of the New gTLD Program and prior to the development of the URS as an additional curative rights protection

mechanism for the New gTLD Program. The 2007 GNSO Report was also confined to examining the dispute resolution question only in relation to IGOs. No recommendation was therefore made with respect to the possibility of a similar mechanism for INGOs.

## VI. Other Relevant Background Information

In creating this Issue Report, Staff reviewed the following prior documents and work for the purpose of determining whether any previous recommendations or community discussions would be of assistance to the GNSO Council in considering whether or not to launch a PDP, and if so whether these previous documents and work can inform the deliberations of a PDP WG.

### 1. The WIPO-2 Process: Recommendations for IGO Names and Acronyms

Initiated by the Member States of the World Intellectual Property Organization (WIPO), the [Second WIPO Internet Domain Name Process](#) (WIPO-2) was begun in 2000 and concluded in September 2001 with the issuance of WIPO's [Final Report](#) on 3 September 2001.

WIPO-2 dealt with a range of identifiers that could be used as domain names in addition to IGOs, including geographical indications, trade names and personal names. In relation to IGOs, the WIPO-2 Report noted that unlike other identifiers where there are either clear international norms requiring protection of particular subject matter (but with under-developed modalities for its international recognition) or where there is no such international norm at all, IGOs fall into a category “where there are elements of an international framework for the protection of the subject matter, but those elements are incomplete or insufficiently precise”. The WIPO-2 Report noted that the international framework for IGO protection stems from Article 6ter of the Paris Convention on Industrial Property, which prohibits the registration or use of IGO names and acronyms as trademarks in such a way as to create a likelihood of confusion or deception among the general public.

In considering the options for protecting IGO names and acronyms as domain names, three alternatives were identified in the WIPO-2 Report, *viz.* continued reliance on the .int gTLD; a blocking or exclusion mechanism; and modifying the UDRP. The .int gTLD, although useful in conveying information as to the legitimacy of qualifying IGOs, was thought to be inadequate by WIPO for the purpose of preventing abusive registrations in other gTLDs. Support for a blocking or exclusion mechanism was divided, with the Final Report

acknowledging the importance of permitting the existence of other good faith legitimate registrations and uses of a particular IGO's acronym by a third party.

There was "considerable support" for modifying the UDRP, as "[e]xtending the UDRP to protect the identifiers of IGOs would not require the creation of new law, but merely the reflection in the DNS of existing international legal principles for their protection. The key benefit perceived in the UDRP is that it can be used to target only those names and acronyms of IGOs that are used in bad faith, so as to mislead or confuse the public". However, given the special privileges and immunities afforded to IGOs such as the United Nations and its specialized agencies, the WIPO-2 Report concluded that simply extending the UDRP to IGOs was "untenable". Further, the current international framework was adjudged "not adequate to deal with the whole problem of the bad faith registration and use of the names and acronyms of IGOs as domain names", and "[t]he registration and use of domain names to create misleading associations with the duly constituted international authorities for public health, labor practices, peace-keeping operations, nuclear test bans, the containment of the proliferation of chemical weapons, trade disciplines, children's rights, refugees, aids and so forth is unacceptable, offensive to numerous public policies established by the international community and conducive to undermining the credibility and reliability of the DNS".

The WIPO-2 Report ultimately recommended an independent administrative procedure, similar to the UDRP but developed and supervised by the constituent bodies of the IGOs (i.e. States), be created and made available to IGOs to file a complaint on the basis that a domain name is "the same as or misleadingly similar to the name or acronym of the IGO concerned, has been registered in bad faith without legal justification, and is likely to mislead users into believing that there is an association between the holder of the domain name registration and the IGO in question". The Report goes on to acknowledge that creating such a procedure would involve creating new international law, which, while "desirable [would] require a legitimate source in international law. It would be for States to determine the appropriate basis for such an extension of law, either in the form of a resolution of a competent treaty organ, a memorandum of understanding duly accepted by national authorities or a treaty".

In 2002, WIPO's Standing Committee on Trademarks, Industrial Designs and Geographical Indications (SCT) held two Special Sessions to consider the WIPO-2 Report and its recommendations. Based on the SCT's recommendations, WIPO's Member States, with the exception of the United States, came to general [agreement](#) that the UDRP should be modified such that an IGO should be able to submit a Complaint under



the UDRP on the basis that the registration or use as a domain name of an IGO's name or acronym (if that name or acronym has been communicated to WIPO as required under Article 6*ter* of the Paris Convention) is of a nature to suggest to the public that a connection exists between the domain name holder and the IGO, or to mislead the public as to the existence of a connection between the domain name holder and the IGO. IGOs would not be required to submit to courts of national jurisdiction; rather, appeals would be handled through *de novo* binding arbitration. Limiting recourse to only those IGO names and acronyms that are protected by Article 6*ter* signifies a difference in scope between the original WIPO-2 recommendation and the SCT's position, and appears to suggest that most WIPO member states that participated in the SCT discussion believed that no new international law would be created as a result of modifying the UDRP in this way.

While the WIPO process and its recommendations are in no way binding on ICANN or the GNSO and were already analyzed by an ICANN WG (see further below), the nature of the amendments suggested for the UDRP by WIPO-2 may be helpful historical background information for any PDP WG that may be formed on the topic of IGO and INGO access to the UDRP and other curative rights protection measures. As with the 2007 GNSO Final Report on Dispute Handling for IGO Names and Abbreviations, the WIPO-2 process took place at a time prior to the development of the URS, did not include considerations relevant to INGOs, and before ICANN itself had embarked on preliminary explorations for what is now the New gTLD Program. Nevertheless, the options raised and discussed during WIPO-2 may be relevant to the extent that the GNSO Council may in its deliberations on whether or not to launch a PDP wish to consider whether such a PDP should also take into account the possibility of creating a separate DRP, based substantially on the substantive grounds and defenses currently found in the UDRP and URS (with the necessary adjustments, additions or restrictions) as an alternative to amending the UDRP and/or URS for IGOs and INGOs.

## 2. ICANN Response & Community Input

The ICANN Board invited the ICANN community to comment on the issues raised in the WIPO-2 Final Report and in May 2003 the GNSO Council [responded](#) with the recommendation that the ICANN Board consider the WIPO-2 recommendations separately from the UDRP (since the latter is aimed at trademarks) and suggested that the WIPO-2 recommendations relating to IGO names and acronyms be examined through a PDP.

### (a) The ICANN President's Joint Working Group

In October 2003 a Joint Working Group was convened (in accordance with a June 2003 ICANN Board [Resolution](#)) comprising members from the ALAC, GAC and GNSO, “for the purpose of analyzing the practical and technical aspects of implementing the WIPO recommendations, and notably the implications for the UDRP”. The WG failed to reach consensus on whether or not ICANN should adopt and implement the WIPO-2 recommendations. In its [Final Report](#), the WG noted “substantial and significant differences” between the UDRP and what had been proposed by WIPO-2, and further observed that “significant constituencies” within ICANN had also raised either concerns or reservations about the substance of the WIPO-2 recommendations. Notably, the difference between the mechanism originally proposed in the WIPO-2 Report (i.e. an independent mechanism developed and supervised by States) and the actual measure approved by the SCT and adopted by WIPO’s General Assembly of Member States, with the exception of the United States, Australia, Canada and Japan (i.e modifying the UDRP) was highlighted by the WG in its Final Report. The WG also affirmed the existence of extensive abuse of IGO identifiers in the DNS, but acknowledged that removing access to a court by appealing a UDRP decision in order to accommodate the special legal situation of IGOs could be a serious concern (although the WG did not further explore this question).

The WG identified two approaches to amending the UDRP to address IGO concerns: either by granting explicit protection to IGO names under the UDRP, or by adding the possibility for IGOs to choose international arbitration as a court of mutual jurisdiction. Since the UDRP was originally designed to protect trademarks, a central question for the WG was whether IGO names and acronyms, if protected under Article 6ter of the Paris Convention, would therefore constitute intellectual property to be protected by the UDRP. On arbitration as opposed to national jurisdiction, the WG agreed that there are significant differences between the two, ranging from cost to the possibility that an appeal to an arbitral tribunal would dramatically limit the possible grounds upon which a respondent may be able to appeal a UDRP loss – a change from the UDRP that some WG members felt was fundamental.

The WG also discussed the possibility of creating a mechanism independent of the UDRP, but noted that it was not clear what the differences would be should this solution be adopted rather than amending the UDRP. Since the UDRP constitutes “Consensus Policy” binding on ICANN’s contracted parties, a new and independent process would presumably also need to be characterized as such.

Although the WG did not reach consensus on any conclusions or recommendations, some of the issues that a new PDP on granting IGO (and now also INGO) access to the UDRP (and now also the URS) had already been raised and discussed in the 2003 process. As such, those deliberations may provide a good starting point should the GNSO Council decide to proceed with a PDP.

## **(b) Feedback from the GNSO's Constituencies**

### *(i) The Intellectual Property Constituency (IPC)*

In its January 2006 [Comment on Terms of Reference for New gTLDs](#), the IPC reiterated its opposition (articulated during the President's Joint Working Group deliberations in 2003-4) to amending the UDRP for IGOs, and described several distinct reasons for creating a separate, UDRP-like dispute resolution mechanism for IGOs rather than modifying the current UDRP to take into account the specific characteristics and limitations faced by IGOs in attempting to utilize the UDRP. These were similar to those identified in the 2007 GNSO Report, in that the IPC credited the success of the UDRP to its being tailor-made for clear-cut trademark-based cases of bad faith registration such that it is easy to use, clearly based on internationally-accepted principles of law and uses arbitrators with expertise in trademark law. In addition the IPC noted that one reason for the UDRP's acceptance by the broader ICANN community lay in its guaranteed access to *de novo* review by national courts; a safeguard that runs contrary to IGOs' immunity from national jurisdiction. Importantly, it also emphasized the possibility that the (non-trademark-based) treaties and laws governing IGOs may necessitate particular specificities that do not arise under the trademark-based UDRP. Finally, the IPC also highlighted the existence of alternate parallel DRPs that are modeled on, but not identical to, the UDRP.

Even under a UDRP-like parallel DRP, however, the IPC recommended that it should be based on the UDRP requirement of bad faith. It suggested that specific provisions in the UDRP could be amended to accommodate considerations specific to IGOs, e.g. in Section 4(b)(i) or in relation to defenses under Section 4(c) (including revising such defenses in view of the narrow scope of an IGO-only DRP. In any event, the IPC emphasized that such a mechanisms should be a required feature of all ICANN registry contracts – but such a contractual requirement (including in the ICANN Registrar Accreditation Agreement) should be viewed as an exception due solely to the international conventions governing IGOs, and not taken as a precedent.

In 2007 the IPC [repeated](#) its call for a separate UDRP-based DRP for IGO names and abbreviations, recommending that the GNSO call for an Issue Report on the topic as a preceding step toward launching a PDP on the topic.

### *(ii) The Registries and the Commercial & Business Users (CBUC) Constituencies*

The GNSO Registries Constituency [opposed](#) the 2007 IPC recommendation, noting that “[t]he WIPO 2 recommendations are tantamount to asking ICANN to become an “enforcer of treaties”, which is not its proper role. The treaties in question are not enforced in every signatory nation in the same way, and a globally uniform enforcement system will impinge on national law to some extent. This is “mission creep” and the establishment of a dangerous precedent.”

The Registries’ statement also referred to a 21 May 2003 letter [sent](#) to the ICANN CEO by the GNSO’s CBUC, which had raised a number of fundamental questions regarding potential ICANN implementation of the WIPO-2 recommendations that the Registries believed had not yet been addressed fully by 2007. The CBUC had questioned the nature and extent of the problem faced by IGOs, given their registrability in the .int domain and the existence of the UDRP for those IGOs holding trademark rights; they also noted that there seemed to be relatively few documented instances of actual bad faith confusion and were concerned that the WIPO-2 recommendations were disproportionate to the problem.

### **3. ICANN’s Registry Agreements with IGOs**

In December 2009 ICANN entered into a [Registry Agreement](#) with the Universal Postal Union (UPU) for the .post gTLD. The agreement recognized the UPU’s legal status as a specialized agency of the United Nations, and provides that in the event of a dispute concerning the agreement that mutual cooperative engagement has failed to resolve, the dispute will be resolved through final and binding arbitration pursuant to the rules of the International Court of Arbitration at the International Chamber of Commerce. Similarly, in ICANN’s New gTLD [Registry Agreement](#), an alternative dispute resolution procedure similar to that delineated in the .post Registry Agreement has been included, to apply specifically to IGOs who may become registry operators under the New gTLD Program. Should the GNSO Council decide to initiate a PDP, the provisions of and context relating to these two agreements may be relevant to the PDP WG’s deliberations.

## VII. EFFECT OF ABUSIVE SECOND LEVEL DOMAIN NAME REGISTRATIONS ON IGOs & INGOs

Based on the discussions to date as outlined above, there does not seem to be a consensus within the ICANN community as to whether the UDRP should be amended to allow IGOs (and perhaps other types of organizations that are not necessarily trademark owners, such as INGOs) to utilize it, or whether the better alternative would be to create a separate procedure based on the UDRP for such organizations. To the extent that either approach is explored, the fact that IGOs are immune from national jurisdiction would necessitate an in-depth examination of the consequences of removing the current requirement that a party submit to national jurisdiction as a result of engaging in the dispute resolution process.

In 2001, when the WIPO-2 Report was published, there was a total of 91 IGOs that had requested protection under Article 6*ter* of the Paris Convention. The WIPO-2 Report notes that at the time evidence was presented of “sizable” instances of abuse of IGO names and abbreviations in the DNS, with many IGO commentators submitting statements and describing instances of such abuse. In the [Common Position Paper](#) submitted by legal counsel of over thirty IGOs (including the signatories to the original [IGO Open Letter](#) sent to the ICANN Board requesting special protections for IGOs in December 2011), the potential for abuse in the expanded New gTLD Program to be exponentially higher was noted, although the Paper did not include the number of IGOs that had requested protection under Article 6*ter* since 2001.

During the IGO-INGO WG deliberations, the group discussed the relevance of evaluating harms suffered by IGOs and INGOs in developing appropriate protection mechanisms. Although the WG ultimately did not rely on this factor in developing its recommendations, it reviewed a [spreadsheet](#) prepared by ICANN staff that sampled a number of domain name registrations matching certain IGO acronyms. The results showed some threat of monetization and the existence of a number of domains registered by entities other than the organizations themselves.

Should the GNSO Council vote to initiate a PDP, it will likely be useful for the PDP WG to have an initial, updated report on the number of IGOs that are currently protected under Article 6*ter*, and to invite the protected IGOs and INGOs to document updated instances of second level abusive registrations of their

acronyms. While the information should not be determinative as regards the question whether to amend the UDRP or URS, it could be helpful in determining whether the substantive grounds of each procedure ought to be retained or changed in any decision to modify the UDRP or URS in order to accommodate IGO and INGO needs. Should the GNSO Council vote to initiate a PDP that results in recommendations to be implemented, such information can also be usefully compared against any cases that may be filed under the amended procedures, to determine the extent to which the changes to either or both procedures succeed in providing adequate curative protection to IGOs and INGOs.

## VIII. Community Input on the Preliminary Issue Report

The Preliminary Issue Report was published for public comment on 10 March 2014 and the public forum closed on 6 May 2014. A total of twelve comments were received. A report of the public comments was published on 16 May 2014 and is attached to this Report as Annex 4.

Three commentators (one individual, two organizational) favored a PDP to explore the development of a separate, narrowly tailored DRP specifically applicable to IGOs and INGOs, modeled on the requirements of the UDRP and URS. The IGOs who had participated in the GNSO's IGO-INGO PDP WG that developed the initial consensus recommendations are among these supporters, although in their comment they expressly noted a continued preference for preventative protection. Nonetheless, they also provided suggestions for how such a narrowly tailored curative procedure could be designed if curative measures are to be adopted instead.

The IPC's comments in support of a PDP of this nature were consistent with their January 2006 feedback in favoring an alternate "UDRP-like" procedure for IGOs and INGOs. The IPC also included a caution against extending the PDP to other policy areas due to be reviewed by other ICANN processes (e.g. geographic TLDs or a UDRP review) and suggested limiting the scope of the PDP to those IGO and INGO identifiers previously specified as eligible for protection by the GNSO's IGO-INGO PDP WG.

Six individual and one organizational commentator expressed serious concerns over the risk that providing special protections to IGOs and INGOs could deprive legitimate registrants of due process and other existing legal protections, including the possibility that a procedure catering to the specific jurisdictional problems faced by IGOs might result in the loss of what is currently a strong safeguard present in the UDRP and URS – the possibility of recourse to a national court of competent jurisdiction. In addition, references were made to the WIPO-2 process and the subsequent SCT discussions, in particular to the risk that in developing special procedures and additional protections for IGOs ICANN would be engaging in the creation of new law not currently supported by international treaties.

In general, most of the public comments received centered either on overarching concerns or possible ways to conduct a PDP rather than the desirability of initiating a PDP based on the issues identified as suitable for a

PDP in the Preliminary Issue Report. They also reflected previous community and international discussions on the topic, including the WIPO-2 process and subsequent ICANN community dialogue. No new data was received on some of the topics that had been identified in the Preliminary Issue Report as warranting further information, such as the current number of IGOs that have requested protection under Article 6*ter* of the Paris Convention and the lack of updated comprehensive documented instances of second level abusive registrations. Substantive issues noted in the Preliminary Issue Report, such as possible distinctions between IGOs and INGOs, between the UDRP and URS, and between implementation in legacy gTLDs as distinct from gTLDs introduced as part of the New gTLD Program, also did not attract any comment. Nevertheless, a number of commentators cautioned against the creation of new laws and additional rights.



## IX. Issues to be Explored in a PDP

The staff recommendation in the Preliminary Issue Report had suggested that a PDP, if initiated, should first explore whether or not it would be desirable to amend the UDRP and/or URS for the specific purpose of their access and use by IGOs and INGOs. It is in this initial phase of a PDP that continued unresolved questions dating from the WIPO-2 process and prior ICANN community discussions on the issue can be discussed and perhaps resolved. Given the lapse of time between those earlier, inconclusive efforts and the present, it may be helpful to include in this initial PDP phase data and research into some of the possible justifications for extending specific protections to IGOs and/or INGOs, e.g. the legal basis for IGO protections originating in Article 6*ter*; data on the number of IGOs currently protected under Article 6*ter*; and information on the extent of second level abusive registrations relating to IGO and INGO acronyms. By obtaining the relevant data and materials, the PDP WG should then be in a better-equipped position to consider whether or not to recommend amending the UDRP and/or URS, or to proceed with a separate but parallel and narrow DRP. Should it reach this subsequent phase in its deliberations, the PDP WG can then begin to review and analyze the substantive issues identified in this Section IX.

The following issues were initially listed in the Preliminary Issue Report to document the breadth of possible issues that could be explored in a PDP. As noted by one commentator to the public forum for the Preliminary Issue Report, a full PDP that includes consideration of all the issues described below will likely require substantial staff and community time and resources. Should the GNSO Council decide to initiate a PDP, it may be helpful to the PDP WG that is to be formed for the GNSO Council to also include in the WG Charter those issues from the following list that it believes should be discussed by the WG.

### 1. Differences between the UDRP and URS

In addition to the need for further analysis and research described above, while some suggestions have already been made as to which parts of the UDRP could be changed to accommodate the particular needs of IGOs (and other international organizations), an analysis of each of the substantive grounds of the UDRP and of existing defenses will also be necessary to determine whether the same grounds and defenses can be employed, or whether new, additional or more restricted standards are required. Some of this analysis can presumably be conducted in collaboration with WIPO, other dispute resolution service providers and community participants from prior work on IGO dispute issues; however, the analysis will need to be

extended to consider the case of INGOs. It may be relevant also to take into account the body of jurisprudence that has developed under the UDRP to date.

Regardless of the outcome of the analysis of whether the UDRP can and should be changed to accommodate IGOs and INGOs, attention will also need to be paid to the question of whether the URS could and should be similarly amended or if a new streamlined process is justified. While the URS is based substantially on the UDRP in terms of substance, the rationale for its creation, the difference in remedies available and the burden of proof may necessitate a specific examination of the URS itself, and its applicability to IGOs and INGOs.

## **2. Relevance of Existing Protections under the AGB for the New gTLD Program**

Although the AGB for the New gTLD Program did not specifically refer to particular protections for IGOs or INGOs, several of the objection processes and rights-protection mechanisms created for the Program are clearly available for use by qualifying IGOs and INGOs. These include the ability at the top level by an IGO (if not necessarily an INGO due to the AGB's listed criteria) to file a legal rights objection against a new gTLD applicant if the IGO meets the requirements for a .int registration, meaning that it was established by treaty between or amongst national governments, and is widely considered to have an independent legal personality subject to and governed by international law (see AGB section 3.2.2.2, at <http://newgtlds.icann.org/en/applicants/agb/objection-procedures-11jan12-en.pdf>.)

At the second level, to the extent that an IGO or an INGO has trademark rights to its name or acronym, it can also use the new Trademark Clearinghouse, which validates marks for mandatory Sunrise registration protections and Trademark Claims notification processes in the New gTLD Program. The new URS procedure, modeled after the UDRP and using similar grounds for relief, is also available to these IGOs and INGOs on the same legal basis of trademark ownership (see <http://newgtlds.icann.org/en/applicants/agb/trademark-clearinghouse-04jun12-en.pdf> and <http://newgtlds.icann.org/en/applicants/agb/urs-04jun12-en.pdf>).

As the analysis of the WIPO-2 Process shows, however, these top and second level protections in the New gTLD Program are largely limited only to those IGOs and INGOs that have trademark or similar rights and protections. They were not specifically designed to protect, nor do they easily apply to all, IGOs or INGOs. Should a PDP be launched to consider access to these curative protection mechanisms by IGOs and INGOs, the WG that is established to conduct the PDP will have to consider whether the existence of as well as the limited nature of the AGB protections is a relevant factor in granting access to curative rather than

preventative rights protection mechanisms for IGOs and INGOs.

### **3. Interplay between this Issue and the Forthcoming Review of the UDRP**

In December 2011, the GNSO Council had [resolved](#) that an Issue Report on all current (i.e. UDRP) and new rights protection mechanisms be prepared eighteen months following the delegation of the first new gTLD. With the first delegations in the New gTLD Program occurring in October 2013, the GNSO Council is therefore scheduled to consider the question of reviewing the UDRP and other mechanisms such as the URS not earlier than March 2015. The GNSO Council's resolution stems from its 2011 call for an Issue Report on the Current State of the UDRP. The [Final Issue Report on the Current State of the UDRP](#) was published in October 2011 and recommended that the UDRP be reviewed only after the URS had been in effect for eighteen months, on the basis that information regarding the operation of the latter could be helpful in a PDP to review the former. In addition, the AGB specifies that a review of the URS should be conducted one year after the first determination issued under its rules, which occurred in February 2014.

The forthcoming publication of an Issue Report on the UDRP, URS and other rights protection mechanisms does not mean that a PDP on the issue will necessarily be launched as a result. Among other factors, it is not possible to predict the recommendations that may be included in the Final Issue Report, and the GNSO Council will still have to vote on whether or not to initiate a PDP. Given, however, that the New gTLD Program is underway, with some new gTLDs already delegated and others to come, it may not be practical or effective to postpone consideration of the applicability of the UDRP or URS to IGO and INGO domain name disputes until 2015. Nevertheless, the fact that it is possible that the GNSO Council will launch a PDP examining these various curative processes in the near future is another factor to be taken into account by any WG that may be formed to consider IGO and INGO access to these mechanisms in a GNSO PDP on the issue.

### **4. The Distinction (If Any) Between IGOs and INGOs for Purposes of this Issue**

Prior to the GNSO's PDP on Protection on IGO and INGO Identifiers in All gTLDs, the focus in terms of abusive registrations of international organizational names and acronyms had been on the particular situation of IGOs, given their international protection under Article 6<sup>ter</sup> of the Paris Convention and the sovereignty issues associated with the UDRP requirement of submission to a national jurisdiction. However, INGOs are not in the same position, with the possible partial exception of organizations such as the RCRC and IOC, who

enjoy protection under the Geneva Conventions and the Nairobi Treaty respectively, as well as national protection in a number of countries for their emblems and identifiers.

The IGO-INGO WG did not develop explicit criteria for determining which type of organization should enjoy special protections. It also did not base its recommendations on the distinctions between an IGO or an INGO, as it weighed protections for each group on its own merit. While a case has arguably been made through the previous work described in this Issue Report for either amending the UDRP to accommodate the special immunities and privileges of IGOs or creating a narrow and specific arbitration procedure based on the UDRP for IGOs, little if any analysis on the same scale has been done for INGOs.

For example, the sovereignty issues associated with an IGO submitting to national jurisdiction may not arise for many INGOs. This may mean that, to the extent existing curative processes are to be amended to permit access by IGOs and INGOs, a case could be made for extending the UDRP and/or URS to INGOs while creating a narrow DRP instead for IGOs, which would mean treating the two types of organizations differently. On the other hand, while certain IGOs may enjoy trademark-like protections by virtue of Article 6*ter* of the Paris Convention, it is possible that some INGOs may themselves also enjoy trademark rights under certain national laws, which could argue against differentiation based on whether an organization is an IGO or an INGO.

While INGOs do not have governments and states as their constituent bodies, they are nonetheless engaged in missions that affect the public interest, and many operate globally. In addition, as noted above, INGOs such as the RCRC and the IOC enjoy certain protections under both international treaties and various national laws. Should a PDP be launched to examine whether and how IGOs and INGOs can or should be given access to the UDRP or URS, it may be necessary for that PDP WG to revisit the issue of clarifying the distinction between IGOs and INGOs, or between certain types of organizations within each of these two groups, to determine the necessity and extent of modifications to either procedure as a result

## **5. The Potential Need to Distinguish Between a “Legacy” gTLD and a “New” gTLD Launched Under the New gTLD Program**

The New gTLD Program was formally approved by the ICANN Board in June 2011 and launched in January 2012. The first new gTLD registry agreements were signed in July 2013 and a number of new gTLDs have since been delegated, beginning in October 2013.

Up to the point when new gTLD registry agreements were signed between ICANN and new gTLD registry operators, it may have been possible to refer to those gTLDs that were already approved and/or operational prior to the New gTLD Program (such as .com, .org, .biz, .info, .net, .mobi and so on) as “existing” or “incumbent” (i.e. “legacy”) gTLDs and all applications under the New gTLD Program as “new” gTLDs. With the delegation and activation of an increasing number of so-called “new” gTLDs since October 2013, however, possible differences in the treatment of any recommendations that may emerge from a PDP that may be launched consequent to this Issue Report will need to be explored. For example, the WG may need to resolve the question whether to treat a delegated gTLD similarly to the “legacy” (pre-New gTLD Program) gTLDs, and when and how the line (if any) between operational gTLDs (whether delegated previously or under the New gTLD Program) and gTLDs that are yet to be delegated should be drawn. While many of the questions relating to this issue may be questions of implementation, there may be some that could carry policy implications.

In addition, there is no contractual or other mandatory requirement regarding the URS in the pre-New gTLD Program registry agreements, whereas both the UDRP and URS are mandatory in the New gTLD Program. In this regard, the IGO-INGO WG contemplated that the question of IGOs and INGOs accessing the URS should be a question applicable to all gTLDs (new or otherwise).

## **6. The Potential Need to Clarify Whether the URS is Consensus Policy Binding on ICANN Contracted Parties**

As described in Section III above, the UDRP and URS were developed through different processes. Where the UDRP was the result of a consensus recommendation of the DNSO, the URS was created during the implementation phase of the New gTLD Program. In addition, where the UDRP applies to all domain names registered in both existing as well as new gTLDs, the URS as it stands currently was developed for and is a mandatory procedure only for domain names registered in new gTLDs delegated under the New gTLD Program.

The IGO-INGO PDP WG was tasked to consider the issue of IGO and INGO protection in all gTLDs. As part of its deliberations, the WG discussed the possibility of opening up the UDRP and URS to IGOs and INGOs without distinguishing between the UDRP and the URS concerning the current limitation of the URS to disputes arising in relation to new gTLDs. In order to give full effect to IGO and INGO protections from a

curative perspective (if any), a PDP on the topic could also consider the potential benefits and consequences of the URS as binding Consensus Policy.

### **7. The Need to Address the Issue of the Cost to IGOs and INGOs of Using Curative Processes**

Both IGOs and the GAC have previously noted the need for either a cost-neutral or low-cost mechanism to ensure that public funds are not unnecessarily diverted to enforcement and protection of IGO and RCRC identifiers in the domain name system. However, as noted above, the IGO-INGO WG did not reach consensus on the issue as to whether IGOs and INGOs ought to receive fee waivers or reduced pricing in this regard. Any WG that may be created for a PDP on this issue and that intends to recommend either an amendment to the UDRP and URS, or the development of a specific procedure for IGOs and INGOs, should therefore also consider the need to include either a fee waiver or reduced pricing for IGO and INGO use of such procedures.

### **8. The Relevance of the Existence of Legal Protections under International Treaties and/or Multiple National Laws**

In addition to considering whether a distinction ought to be made between IGOs and INGOs based on the nature of their constituent status, a WG that is created to conduct a PDP on the topic of IGO and INGO access to the UDRP, URS or other appropriate curative rights protection procedure may also need to take into account the potential need to distinguish between the two types of organizations based on the additional fact that IGOs are protected by specific international legal treaties, viz. the Paris Convention on Industrial Property as subsequently recognized by the Trade-Related Agreement on Intellectual Property Rights agreed on as part of the framework that established the World Trade Organization in 1994. A WG analysis on this point may, however, be complicated by the further fact that while the RCRC and IOC are not IGOs but rather are INGOs, they are also specifically protected by international legal treaties, viz. the Geneva Conventions and the Nairobi Treaty, respectively.

In addition, it may be necessary to conduct research and analysis as to whether the form, scope and type of legal protections available for IGOs, the RCRC and IOC as noted above warrants distinguishing between each of these organizations for purposes of either amending the UDRP and URS or developing a specific DRP. Subject matter expertise in this area will be required in order to conduct the necessary research and analysis.

## X. Staff Recommendation

### 1. Scope

In determining whether the issue is within the scope of the ICANN policy process and the scope of the GNSO, Staff and the General Counsel's office have considered the following factors:

#### ***Whether the issue is within the scope of ICANN's mission statement***

The ICANN Bylaws state that:

"The mission of The Internet Corporation for Assigned Names and Numbers is to coordinate, at the overall level, the global Internet's systems of unique identifiers, and in particular to ensure the stable and secure operation of the Internet's unique identifier systems. In particular, ICANN:

1. Coordinates the allocation and assignment of the three sets of unique identifiers for the Internet, which are
  - a. domain names (forming a system referred to as "DNS");
  - b. Internet protocol ("IP") addresses and autonomous system ("AS") numbers; and,
  - c. protocol port and parameter numbers.
2. Coordinates the operation and evolution of the DNS root name server system.
3. Coordinates policy development reasonably and appropriately related to these technical functions."

Designed to address trademark infringement in the registration of domain names, the UDRP is a policy that serves to preserve and enhance the operational stability, reliability, security and interoperability of the Internet. Developed as a faster and more streamlined procedure but based substantively and substantially on the UDRP, the URS also serves a similar function.

#### ***Whether the issue is broadly applicable to multiple situations or organizations.***

Since the UDRP applies uniformly to all registrants of gTLDs and to all registrars, and the URS to all registrants and registrars for the New gTLD Program, the issue is broadly applicable to multiple situations or organizations. Any changes to the policy or the rules that may result from a PDP would also be broadly applicable to multiple situations or organizations.

***Whether the issue is likely to have lasting value or applicability, albeit with the need for occasional updates.***

The UDRP has had lasting value, having been in operation for well over ten years, and continues to have applicability in today's domain name market. Any amendments, extensions or modifications to the UDRP would have to be undertaken in a way that ensures its continued viability and value for many more years. Unlike the UDRP, the URS is a new procedure developed for the New gTLD Program; however, the objective behind its development was to create an additional avenue for the protection of legal rights with the expansion of new gTLDs and as such it is anticipated to have lasting value and applicability, including for future rounds of gTLD expansion.

***Whether the issue will establish a guide or framework for future decision-making.***

Since previous work concerning protections for international organizations had focused largely on preventative rather than curative measures, and was concentrated on IGOs rather than INGOs, conducting a PDP on IGO and INGO access to curative rights protection mechanisms such as the UDRP and URS can establish a guide or framework for future decision-making as it will be the first time such a policy will have been developed. It is also likely that similar concerns will arise in relation to future rounds of gTLD expansion such that lessons learned from examining this issue at this time can be applied to those future rounds, and in a timely fashion.

***Whether the issue implicates or affects an existing ICANN policy.***

The UDRP, an existing ICANN policy, and the URS, developed for the New gTLD Program, are implicated, and would be affected by any change.

Based on the foregoing, it is the opinion of the ICANN General Counsel that commencing a PDP on modifying the UDRP and URS to permit access by IGOs and INGOs would be in scope for the GNSO Council.

## **2. Recommended Action**

In light of the fact that new gTLDs continue to be delegated in the New gTLD Program and the Board's recent adoption of those of the GNSO's consensus recommendations for IGO and INGO protections that are not inconsistent with GAC advice, there is arguably a pressing need to identify workable solutions to a problem



that has already been discussed within the ICANN community for some time. Staff therefore recommends that the GNSO Council commence a PDP on the specific issue described in this Issue Report, i.e. exploring whether the UDRP and URS should be amended, and if so in what way; or whether a separate narrowly tailored procedure designed, to enable curative protection for IGOs and INGOs should be developed. Staff further recommends that any WG created for the purposes of such a PDP invite participation from other ICANN Supporting Organizations and Advisory Committees, including the GAC, and from interested IGOs and INGOs; in particular to track the discussions to be facilitated by the Board (per the Board's 30 April 2014 resolution) between the GAC, GNSO and other affected parties, and to integrate the views of the GAC with respect to the remaining differences between it and the GNSO on RCRC and IGO acronym protection.

Staff also recommends that in launching the PDP and determining the scope of the issues for which the PDP WG will be chartered the GNSO Council consider the extent of staff and community resources that will be required. In doing so the GNSO Council may wish to consider directing the PDP WG to, as a first step, gather the necessary data and research on the following:

- (a) The number of IGOs that have requested protection under Article 6ter of the Paris Convention;
- (b) Current information documenting the extent of second level abusive registrations for IGO and INGO identifiers; and
- (c) The scope of legal protection provided by Article 6ter.

Staff also recommends that the GNSO Council consider whether or not to include the following additional topics in the WG charter, in addition to the specific issues outlined in Section IX above:

- (a) Review the deliberations of the 2003 President's Joint Working Group on the WIPO-2 recommendations as a possible starting point for the PDP WG's work and consider whether subsequent developments such as the introduction of the New gTLD Program and the URS may mean that prior ICANN community recommendations on IGO dispute resolution are no longer applicable;
- (b) Examine whether or not similar justifications and amendments should apply to both the UDRP and URS, or if each procedure should be treated independently and/or differently;

- (c) Reach out to existing ICANN dispute resolution service providers for the UDRP and URS as well as experienced UDRP panelists, to seek input as to how the UDRP and/or URS might be amended to accommodate considerations particular to IGOs and INGOs;
- (d) Determine what (if any) are the specific different considerations (including without limitation qualifying requirements, authentication criteria and appeal processes) that should apply to IGOs and INGOs;
- (e) Conduct research on applicable international law regarding special privileges and immunities for IGOs;
- (f) Conduct research on the number and list of IGOs currently protected under Article 6*ter* of the Paris Convention on Intellectual Property;
- (g) Consider whether or not there may be practicable alternatives, other than amending the UDRP and URS, that can nonetheless provide adequate curative rights protections for IGOs and INGOs, such as the development of a specific, narrowly-tailored DRP applicable only to IGOs and/or INGOs; and
- (h) Bear in mind that any recommendations relating to the UDRP and URS that are developed by this PDP WG may be subject to further review should the GNSO Council decide to launch a PDP to review the UDRP and all the rights protection mechanisms that were developed for the New gTLD Program.

Finally, staff recommends that the scope of the PDP be limited to those IGO and INGO identifiers that were listed by the GNSO's IGO-INGO PDP WG as identifiers to be protected by their consensus recommendations (designated by that WG as Scope 1 and Scope 2 identifiers, and listed in Annex 2 of this Final Issue Report).

## ANNEX 1 – THE GNSO COUNCIL REQUEST FOR AN ISSUE REPORT

QUESTIONS	ANSWERS
1) Name of Requester:	IGO-INGO WG
2) Enter the name of your Stakeholder Group (SG), Constituency, or Advisory Committee (AC) supporting this request: <i>(Please enter "Not Applicable" if appropriate).</i>	Not Applicable
3) Briefly identify (or name) the Issue:	IGO-INGO Access to Curative Dispute Resolution Mechanisms (i.e. UDRP & URS)
4) Explain how this Issue affects the organization provided in Question #2 above:	Not Applicable
5) Provide rationale for policy development:	The two current domain name dispute resolution mechanisms (UDRP & URS) are premised on the complainant’s legally owning trademark rights to the domain name(s) in question. With recommendations that IGOs and INGOs should also be able to utilize these mechanisms, the current UDRP & URS policy needs to be amended to allow these organizations similar access as trademark owners but without creating new or additional trademark or other legal rights.
6) Describe problems raised by the Issue including quantification to the extent known:	<p>Amending UDRP and URS policy to allow IGOs and INGO access to these mechanisms would amount to extending the scope of these dispute resolution processes beyond pure trademark disputes. Care should be taken to not expand their workings beyond what is necessary to ensure IGO and INGO protections tailored specifically to the WG’s recommendations.</p> <p>The Council should take note that the scope of any PDP created as a result of this Issue Report will not impact the scope of the RPM (UDRP/URS) Review PDP that is presently on-hold at the GNSO Council. It is likely not to be started until 2015 and that this PDP on access for</p>

## ANNEX 2 – THE LIST OF PROTECTED IGO & INGO IDENTIFIERS (AS APPROVED BY THE GNSO COUNCIL)

#	Red Cross Red Crescent Movement (RCRC) Identifiers
	<ul style="list-style-type: none"> <li>○ <b>Scope 1 Identifiers</b><sup>1</sup>: "Red Cross", "Red Crescent", "Red Lion and Sun" and "Red Crystal" (Language: UN6)</li> <li>○ <b>Scope 2 Identifiers</b>: 189 recognized National Red Cross and Red Crescent Societies; International Committee of the Red Cross; International Federation of Red Cross and Red Crescent Societies; ICRC, CICR, CICV, MKKK, IFRC, FICR (Language: in English, as well as in their respective national languages; ICRC &amp; IFRC protected in UN6)</li> </ul>
1	<b>Top-Level</b> protections of <u>Exact Match, Full Name</u> Scope 1 identifiers of the <i>Red Cross Red Crescent Movement</i> are placed in the Applicant Guidebook section 2.2.1.2.3, Strings "Ineligible for Delegation"
2	For <i>Red Cross Red Crescent Movement</i> identifiers placed in the Applicant Guidebook as ineligible for delegation at the <b>Top-Level</b> , an exception procedure should be created for cases where a protected organization wishes to apply for their protected string at the Top-Level
3	<b>Second-Level</b> protections of only <u>Exact Match, Full Name</u> Scope 1 identifiers of the <i>Red Cross Red Crescent Movement</i> are placed in Specification 5 of the Registry Agreement
4	For <i>Red Cross Red Crescent Movement</i> identifiers placed in Specification 5 of the Registry Agreement, an exception procedure should be created for cases where a protected organization wishes to apply for their protected string at the <b>Second-Level</b>
5	<b>Second-Level</b> protections of only <u>Exact Match, Full Name</u> Scope 2 identifiers of the <i>Red Cross Red Crescent Movement</i> are bulk added as a single list to the Trademark Clearinghouse (TMCH)
6	<b>Second-Level</b> protections of only <u>Exact Match, Acronym</u> Scope 2 identifiers of the <i>Red Cross Red Crescent Movement</i> are bulk added as a single list to the Trademark Clearinghouse
7	<i>Red Cross Red Crescent Movement</i> Scope 2 (Full Name & Acronym) identifiers added to the TMCH, allowed to participate in <u>90 Day Claims Notification</u> <sup>2</sup> phase of each new gTLD launch for <b>Second-Level</b> registrations

<sup>1</sup> The Scope 1 identifiers for RCRC are already placed on the reserved list:

<http://www.icann.org/sites/default/files/packages/reserved-names/ReservedNames.xml>. This list should be confirmed upon Board approval of the GNSO recommendations.

<sup>2</sup> If IGO-INGO identifiers are to utilize the Claims service, both WG deliberation and public comments noted that a separate claims notice, as distinct from the Trademark notices, may be required since IGO-INGO Identifiers are protected on a different legal basis from trademarks.

#	International Olympic Committee (IOC) Identifiers
<b>Scope 1 Identifiers:</b> olympic, olympiad (Language: UN6, + German, Greek, and Korean) <sup>3,4</sup>	
1	<b>Top-Level</b> protections of <u>Exact Match, Full Name</u> Scope 1 identifiers of the <i>International Olympic Committee</i> are placed in the Applicant Guidebook section 2.2.1.2.3, Strings "Ineligible for Delegation"
2	For <i>International Olympic Committee</i> Identifiers placed in the Applicant Guidebook as ineligible for delegation at the <b>Top-Level</b> , an exception procedure should be created for cases where a protected organization wishes to apply for their protected string at the <b>Top-Level</b>
3	<b>Second-Level</b> protections of only <u>Exact Match, Full Name</u> Scope 1 identifiers of the <i>International Olympic Committee</i> are placed in Specification 5 of the Registry Agreement
4	For <i>International Olympic Committee</i> identifiers placed in Specification 5 of the Registry Agreement, an exception procedure should be created for cases where a protected organization wishes to apply for their protected string at the <b>Second-Level</b>

#	International Governmental Organization (IGO) Identifiers
<ul style="list-style-type: none"> <li>○ <b>Scope 1 Identifiers:</b> GAC List<sup>5</sup> (22 March 2013) - Full Name (Language: Up to two languages<sup>6</sup>)</li> <li>○ <b>Scope 2 Identifiers:</b> GAC List (22 March 2013) - Acronym (Language: Up to two languages)</li> </ul>	
1	<b>Top-Level</b> protections of <u>Exact Match, Full Name</u> Scope 1 identifiers of the <i>International Governmental Organizations</i> are placed in the Applicant Guidebook section 2.2.1.2.3, Strings "Ineligible for Delegation"
2	For <i>International Governmental Organizations</i> Identifiers placed in the Applicant Guidebook as ineligible for delegation at the <b>Top-Level</b> , an exception procedure should be created for cases where a protected organization wishes to apply for their protected string at the <b>Top-Level</b>
3	<b>Second-Level</b> protections of only <u>Exact Match, Full Name</u> Scope 1 identifiers of the <i>International Governmental Organizations</i> are placed in Specification 5 of the Registry Agreement

<sup>3</sup> The Scope 1 identifiers for IOC are already placed on the reserved list:

<http://www.icann.org/sites/default/files/packages/reserved-names/ReservedNames.xml>. This list should be confirmed upon Board approval of the GNSO recommendations.

<sup>4</sup> Note that the IOC did not request protections for acronyms and therefore no recommendations are included within this Scope 1 set.

<sup>5</sup> List of IGO Full Name & Acronym (Scope 1 & 2) Identifiers from GAC Advice:

<http://www.icann.org/en/news/correspondence/dryden-to-crocker-chalaby-annex2-22mar13-en.pdf>

<sup>6</sup> The IGO Representatives collaborating with the GAC are to provide a list of the two languages each organization prefers because ICANN may not be in a position to determine which languages should be reserved for each of the 190+ organizations on the GAC list (UN6 is the standard scope for which ICANN conducts translations.)

#	International Governmental Organization (IGO) Identifiers
	<ul style="list-style-type: none"> <li>○ <b>Scope 1 Identifiers:</b> GAC List<sup>5</sup> (22 March 2013) - Full Name (Language: Up to two languages<sup>6</sup>)</li> <li>○ <b>Scope 2 Identifiers:</b> GAC List (22 March 2013) - Acronym (Language: Up to two languages)</li> </ul>
4	For <i>International Governmental Organizations</i> identifiers placed in Specification 5 of the Registry Agreement, an exception procedure should be created for cases where a protected organization wishes to apply for their protected string at the <b>Second-Level</b>
5	<b>Second-Level</b> protections of only <u>Exact Match, Acronym</u> Scope 2 identifiers of the <i>International Governmental Organizations</i> are bulk added as a single list to the Trademark Clearinghouse
6	<i>International Governmental Organizations</i> Scope 2 identifiers added to the TMCH, allowed to participate in <u>90 Day Claims Notification</u> <sup>7</sup> phase of each new gTLD launch for <b>Second-Level</b> registrations

#	International Non-Governmental Organizations (INGO) Identifiers
	<ul style="list-style-type: none"> <li>○ <b>Scope 1 Identifiers:</b> ECOSOC List<sup>8</sup> (General Consultative Status) (Language: English only)</li> <li>○ <b>Scope 2 Identifiers:</b> ECOSOC List (Special Consultative Status) (Language: English only)</li> </ul> <p><b>***Note, this list of Identifiers are INGOs other than the RCRC and IOC</b></p> <p>See <a href="http://csonet.org/content/documents/E2011INF4.pdf">http://csonet.org/content/documents/E2011INF4.pdf</a></p>
1	<b>Top-Level</b> protections of <u>Exact Match, Full Name</u> Scope 1 identifiers of the <i>International Non-Governmental Organizations</i> are placed in the Applicant Guidebook section 2.2.1.2.3, Strings "Ineligible for Delegation"
2	For <i>International Non-Governmental Organizations</i> Identifiers placed in the Applicant Guidebook as ineligible for delegation at the <b>Top-Level</b> , an exception procedure should be created for cases where a protected organization wishes to apply for their protected string at the Top-Level
3	<b>Second-Level</b> protections of only <u>Exact Match, Full Name</u> Scope 2 identifiers of the <i>International Non-Governmental Organizations</i> are bulk added as a single list to the Trademark Clearinghouse (TMCH) <sup>9</sup>

<sup>7</sup> If IGO-INGO identifiers are to utilize the Claims service, both WG deliberation and public comments noted that a separate claims notice as distinct from the Trademark notices may be required as IGO-INGO Identifiers are protected on a different legal basis than trademarks.

<sup>8</sup> The Implementation Recommendations Team (IRT) to be formed in relation to this PDP will need to determine how this list is managed as new organizations enter the ECOSOC list.

<sup>9</sup> The concept of bulk addition into the TMCH was to minimize cost associated with entry and validation. However, the Scope 2 names exceed 2000+ organizations. The IRT will need to determine how contact information required for TMCH forms is to be acquired and validated for bulk entry. Note that voluntary submission requests into TMCH will require backend validation of eligibility.

#	International Non-Governmental Organizations (INGO) Identifiers
<ul style="list-style-type: none"> <li>○ <b>Scope 1 Identifiers:</b> ECOSOC List<sup>8</sup> (General Consultative Status) (Language: English only)</li> <li>○ <b>Scope 2 Identifiers:</b> ECOSOC List (Special Consultative Status) (Language: English only)</li> </ul> <p><b>***Note, this list of Identifiers are INGOs other than the RCRC and IOC</b></p> <p>See <a href="http://csonet.org/content/documents/E2011INF4.pdf">http://csonet.org/content/documents/E2011INF4.pdf</a></p>	
4	<p><i>International Non-Governmental Organizations</i> Scope 2 identifiers added to the TMCH, allowed to participate in <u>90 Day Claims Notification</u><sup>10</sup> phase of each new gTLD launch for <b>Second-Level</b> registrations</p>

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<sup>10</sup> If IGO-INGO identifiers are to utilize the Claims service, both WG deliberation and public comments noted that a separate claims notice as distinct from the Trademark notices may be required as IGO-INGO Identifiers are protected on a different legal basis than trademarks.

## ANNEX 3 – DRAFT WORKING GROUP CHARTER



### Working Group Charter for a Policy Development Process for IGO and INGO Access to Curative Rights Protections

<b>WG Name:</b>	<b>IGO-INGO Access to Curative Rights Protection Working Group</b>	
<b>Section I: Working Group Identification</b>		
<b>Chartering Organization(s):</b>	Generic Names Supporting Organization (GNSO) Council	
<b>Charter Approval Date:</b>	TBD	
<b>Name of WG Chair:</b>	TBD	
<b>Name(s) of Appointed Liaison(s):</b>	TBD	
<b>WG Workspace URL:</b>	TBD	
<b>WG Mailing List:</b>	TBD	
<b>GNSO Council Resolution:</b>	<b>Title:</b>	Motion to initiate a Policy Development Process (PDP) for IGO and INGO Access to Curative Rights Protection Mechanisms
	<b>Ref # &amp; Link:</b>	TBD
<b>Important Document Links:</b>	•	



## Section II: Mission, Purpose, and Deliverables

### Mission & Scope:

#### Background

At its meeting on 20 November 2013, the GNSO Council unanimously adopted all the consensus recommendations made by the GNSO's PDP Working Group on the Protection of International Organization Names in All gTLDs (IGO-INGO WG) and requested an Issue Report to assist in determining whether a PDP should be initiated in order to explore possible amendments to the Uniform Dispute Resolution Policy (UDRP) and the Uniform Rapid Suspension procedure (URS), to enable access to and use of such curative rights protection mechanisms by protected IGOs and INGOs.

In 2007 a [GNSO Issue Report on Dispute Handling for IGO Names & Abbreviations](#) had analyzed some possible methods for handling domain name disputes concerning IGO names and abbreviations, but not those of INGOs. A PDP on the topic was however not initiated due to lack of the requisite number of votes in the GNSO Council. Previously, in 2003, an ICANN Joint Working Group comprising community members from the At Large Advisory Committee (ALAC), the Government Advisory Committee (GAC) and the GNSO had also discussed various possible dispute resolution mechanisms for IGOs in response to a 2001 report on the applicability of the UDRP to certain types of identifiers (including those of IGOs) by the World Intellectual Property Organization (WIPO). The Joint Working Group failed to reach consensus on WIPO's recommendations, and no formal action was taken by the GNSO Council or ICANN on the matter.

In January 2012 ICANN launched the New gTLD Program, which included a number of rights-protection mechanisms specifically developed for the Program. These included objection procedures to new gTLD applications (including a legal rights objection procedure for trademark owners and organizations with registrations in the .int TLD) and the URS for second level registrations in approved new gTLDs (modeled after the UDRP). The ICANN Board also granted certain temporary protections at the top and second levels in the New gTLD Program for the Red Cross movement, the International Olympic Committee and IGOs, which were to remain in place until a permanent solution based on GAC Advice and policy recommendations from the GNSO could be developed. The GNSO's recommendations, as approved by the GNSO Council on 20 November 2013, were submitted to the ICANN Board for consideration in February 2014. These were acknowledged by the Board in February 2014, in directing its New gTLD Program Committee (NGPC) to develop a comprehensive proposal taking into account the GAC advice received on the topic and the GNSO's recommendations. The NGPC developed and sent a proposal to the GAC in March 2014. In April 2014 the ICANN Board adopted those GNSO recommendations that are not inconsistent with GAC advice received on the same topic and resolved to facilitate dialogue among the GAC, GNSO and other affected parties to resolve the remaining differences between GAC advice and the GNSO recommendations.

#### Mission and Scope

This Curative Rights Protection for IGOs and INGOs PDP Working Group (WG) is tasked to provide the GNSO Council with policy recommendations regarding whether to amend the UDRP and URS 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. In commencing its deliberations, the WG should at an early stage gather data and research concerning the specific topics listed in Section X of the Final Issue Report as meriting such further documentation.

As part of its deliberations, the CRP PDP WG should, at a minimum, consider the following issues detailed in Section IX of the Final Issue Report. These are:

- *The differences between the UDRP and the URS;*
- *The relevance of existing protection mechanisms in the Applicant Guidebook for the New gTLD Program;*
- *The interplay between the topic under consideration in this PDP and the forthcoming GNSO review of the UDRP, URS and other rights-protection mechanisms;*
- *The distinctions (if any) between IGOs and INGOs for purposes of this PDP;*
- *The potential need to distinguish between a legacy gTLD and a new gTLD launched under the New gTLD Program;*
- *The potential need to clarify whether the URS is a Consensus Policy binding on ICANN's contracted parties;*
- *The need to address the issue of cost to IGOs and INGOs to use curative processes; and*
- *The relevance of specific legal protections under international legal instruments and various national laws for IGOs and certain INGOs (namely, the Red Cross movement and the International Olympic Committee)*

The WG should also include the following additional topics in its deliberations:

- *Review the deliberations of the 2003 President's Joint Working Group on the 2001 WIPO report as a possible starting point for the PDP WG's work and consider whether subsequent developments such as the introduction of the New gTLD Program and the URS may mean that prior ICANN community recommendations on IGO dispute resolution are no longer applicable;*
- *Examine whether or not similar justifications and amendments should apply to both the UDRP and URS, or if each procedure should be treated independently and/or differently;*
- *Reach out to existing ICANN dispute resolution service providers for the UDRP and URS as well as experienced UDRP panelists, to seek input as to how the UDRP and/or URS might be amended to accommodate considerations particular to IGOs and INGOs;*

- *Determine what (if any) are the specific different considerations (including without limitation qualifying requirements, authentication criteria and appeal processes) that should apply to IGOs and INGOs;*
- *Conduct research on applicable international law regarding special privileges and immunities for IGOs;*
- *Conduct research on the number and list of IGOs currently protected under Article 6ter of the Paris Convention on Intellectual Property;*
- *Consider whether or not there may be practicable alternatives, other than amending the UDRP and URS, that can nonetheless provide adequate curative rights protections for IGOs and INGOs, such as the development of a specific, narrowly-tailored dispute resolution procedure modeled on the UDRP and URS, and applicable only to IGOs and/or INGOs; and*
- *Bear in mind that any recommendations relating to the UDRP and URS that are developed by this PDP WG may be subject to further review under the GNSO’s forthcoming PDP to review the UDRP and all the rights protection mechanisms that were developed for the New gTLD Program.*

The WG should invite participation from other ICANN Supporting Organizations and Advisory Committees, including the GAC, and from interested IGOs and INGOs. It should track any ongoing discussions between the GAC and GNSO on resolving remaining differences between GAC advice and the GNSO recommendations on RCRC and IGO acronym protection. It may also wish to consider forming sub-groups to work on particular issues or sub-topics in order to streamline its work and discussions.

For purposes of this PDP, the scope of IGO and INGO identifiers is to be limited to those identifiers previously listed by the GNSO’s PDP WG on the Protection of International Organization Identifiers in All gTLDs as protected by their consensus recommendations (designated by that WG as Scope 1 and Scope 2 identifiers, and listed in Annex 2 of the Final Issue Report).

**Objectives & Goals:**

To develop, at a minimum, an Initial Report and a Final Report regarding the WG’s recommendations on issues relating to the access by IGOs and INGOs to curative rights protection mechanisms, following the processes described in Annex A of the ICANN Bylaws and the GNSO PDP Manual.

**Deliverables & Timeframes:**

The WG shall respect the timelines and deliverables as outlined in Annex A of the ICANN Bylaws and the PDP Manual. As per the GNSO Working Group Guidelines, the WG shall develop a work plan that outlines the necessary steps and expected timing in order to achieve the milestones of the PDP as set out in Annex A of the ICANN Bylaws and the PDP Manual, and shall submit this to the GNSO Council.

## Section III: Formation, Staffing, and Organization

### Membership Criteria:

The WG will be open to all interested in participating. New members who join after certain parts of work has been completed are expected to review previous documents and meeting transcripts.

### Group Formation, Dependencies, & Dissolution:

This WG shall be a standard GNSO PDP Working Group. The GNSO Secretariat should circulate a 'Call For Volunteers' as widely as possible in order to ensure broad representation and participation in the WG, including:

- Publication of announcement on relevant ICANN web sites including but not limited to the GNSO and other Supporting Organizations and Advisory Committee web pages; and
- Distribution of the announcement to GNSO Stakeholder Groups, Constituencies and other ICANN Supporting Organizations and Advisory Committees

### Working Group Roles, Functions, & Duties:

The ICANN Staff assigned to the WG will fully support the work of the Working Group as requested by the Chair including meeting support, document drafting, editing and distribution and other substantive contributions when deemed appropriate.

Staff assignments to the Working Group:

- GNSO Secretariat
- ICANN policy staff members (Berry Cobb & Mary Wong)

The standard WG roles, functions & duties shall be those specified in Section 2.2 of the GNSO Working Group Guidelines.

### Statements of Interest (SOI) Guidelines:

Each member of the WG is required to submit an SOI in accordance with Section 5 of the GNSO Operating Procedures.

## Section IV: Rules of Engagement

### Decision-Making Methodologies:

The Chair will be responsible for designating each position as having one of the following designations:

- **Full consensus** - when no one in the group speaks against the recommendation in its last readings. This is also sometimes referred to as **Unanimous Consensus**.
- **Consensus** - a position where only a small minority disagrees, but most agree. *[Note: For those that are unfamiliar with ICANN usage, you may associate the definition of 'Consensus' with other definitions and terms of art such as rough consensus or near consensus. It should be noted, however, that in the case of a GNSO PDP WG, all reports, especially Final Reports, must restrict themselves to the term 'Consensus' as this may have legal implications.]*
- **Strong support but significant opposition** - a position where, while most of the group supports a recommendation, there is a significant number of those who do not support it.
- **Divergence** (also referred to as **No Consensus**) - a position where there is no strong support for any particular position, but many different points of view. Sometimes this is due to

irreconcilable differences of opinion and sometimes it is due to the fact that no one has a particularly strong or convincing viewpoint, but the members of the group agree that it is worth listing the issue in the report nonetheless.

- **Minority View** - refers to a proposal where a small number of people support the recommendation. This can happen in response to **Consensus**, **Strong support but significant opposition**, or **No Consensus**; or it can happen in cases where there is neither support nor opposition to a suggestion made by a small number of individuals.

In cases of **Consensus**, **Strong support but significant opposition**, and **No Consensus**, an effort should be made to document variances in viewpoint and to present any **Minority View** recommendations that may have been made. Documentation of **Minority View** recommendations normally depends on text offered by the proponent(s). In all cases of **Divergence**, the WG Chair should encourage the submission of minority viewpoint(s).

The recommended method for discovering the consensus level designation on recommendations should work as follows:

- After the group has discussed an issue long enough for all issues to have been raised, understood and discussed, the Chair, or Co-Chairs, make an evaluation of the designation and publish it for the group to review.
- After the group has discussed the Chair's estimation of designation, the Chair, or Co-Chairs, should reevaluate and publish an updated evaluation.
- Steps (i) and (ii) should continue until the Chair/Co-Chairs make an evaluation that is accepted by the group.
- In rare cases, a Chair may decide that the use of polls is reasonable. Some of the reasons for this might be:
  - A decision needs to be made within a time frame that does not allow for the natural process of iteration and settling on a designation to occur.
  - It becomes obvious after several iterations that it is impossible to arrive at a designation. This will happen most often when trying to discriminate between **Consensus** and **Strong support but Significant Opposition** or between **Strong support but Significant Opposition** and **Divergence**.

Care should be taken in using polls that they do not become votes. A liability with the use of polls is that, in situations where there is **Divergence** or **Strong Opposition**, there are often disagreements about the meanings of the poll questions or of the poll results.

Based upon the WG's needs, the Chair may direct that WG participants do not have to have their name explicitly associated with any Full Consensus or Consensus views/positions. However, in all other cases and in those cases where a group member represents the minority viewpoint, their name must be explicitly linked, especially in those cases where polls were taken.

Consensus calls should always involve the entire WG and, for this reason, should take place on the designated mailing list to ensure that all WG members have the opportunity to fully participate in the consensus process. It is the role of the Chair to designate which level of consensus has been reached

and to announce this designation to the WG. WG member(s) should be able to challenge the designation of the Chair as part of the WG discussion. However, if disagreement persists, WG members may use the process set forth below to challenge the designation.

If several participants (see Note 1 below) in a WG disagree with the designation given to a position by the Chair or any other consensus call, they may follow these steps sequentially:

1. Send email to the Chair, copying the WG explaining why the decision is believed to be in error.
2. If the Chair still disagrees with the complainants, the Chair will forward the appeal to the liaison(s) from the Chartering Organization (CO). The Chair must explain his or her reasoning in the response to the complainants and in the submission to the liaison(s). If the liaison(s) supports the Chair's position, the liaison(s) will provide their response to the complainants. The liaison(s) must explain their reasoning in the response. If the liaison(s) disagrees with the Chair, the liaison(s) will forward the appeal to the CO. Should the complainants disagree with the liaison(s)'s support of the Chair's determination, the complainants may appeal to the Chair of the CO or their designated representative. If the CO agrees with the complainants' position, the CO should recommend remedial action to the Chair.
3. In the event of any appeal, the CO will attach a statement of the appeal to the WG and/or Board report. This statement should include all of the documentation from all steps in the appeals process and should include a statement from the CO (see Note 2 below).

**Note 1:** Any Working Group member may raise an issue for reconsideration; however, a formal appeal will require that a single member demonstrates a sufficient amount of support before a formal appeal process can be invoked. In those cases where a single Working Group member is seeking reconsideration, the member will advise the Chair and/or Liaison(s) of their issue and the Chair and/or Liaison(s) will work with the dissenting member to investigate the issue and to determine if there is sufficient support for the reconsideration to initiate a formal appeal process.

**Note 2:** It should be noted that ICANN also has other conflict resolution mechanisms available that could be considered in case any of the parties are dissatisfied with the outcome of this process.

#### **Status Reporting:**

As requested by the GNSO Council, taking into account the recommendation of the Council liaison(s) to the WG.

#### **Problem/Issue Escalation & Resolution Processes:**

The WG will adhere to [ICANN's Expected Standards of Behavior](#) as documented in Section F of the ICANN Accountability and Transparency Frameworks and Principles, January 2008.

If a WG member feels that these standards are being abused, the affected party should appeal first to the Chair and Liaison(s) and, if unsatisfactorily resolved, to the Chair of the CO or their designated representative. It is important to emphasize that expressed disagreement is not, by itself, grounds for

abusive behavior. It should also be taken into account that as a result of cultural differences and language barriers, statements may appear disrespectful or inappropriate to some but are not necessarily intended as such. However, it is expected that WG members make every effort to respect the principles outlined in ICANN’s Expected Standards of Behavior as referenced above.

The Chair, in consultation with the CO liaison(s), is empowered to restrict the participation of someone who seriously disrupts the Working Group. Any such restriction will be reviewed by the CO. Generally, the participant should first be warned privately, and then warned publicly before such a restriction is put into place. In extreme circumstances, this requirement may be bypassed.

Any WG member that believes that his/her contributions are being systematically ignored or discounted or wants to appeal a decision of the WG or CO should first discuss the circumstances with the WG Chair. In the event that the matter cannot be resolved satisfactorily, the WG member should request an opportunity to discuss the situation with the Chair of the CO or their designated representative.

In addition, if any member of the WG is of the opinion that someone is not performing their role according to the criteria outlined in this Charter, the same appeals process may be invoked.

**Closure & Working Group Self-Assessment:**

The WG will close upon the delivery of the Final Report, unless assigned additional tasks or follow-up by the GNSO Council.

**Section V: Charter Document History**

Version	Date	Description

<b>Staff Contact:</b>	Mary Wong	<b>Email:</b>	<a href="mailto:Policy-staff@icann.org">Policy-staff@icann.org</a>
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<b>Translations: If translations will be provided please indicate the languages below:</b>											

## ANNEX 4 – REPORT OF PUBLIC COMMENTS ON THE PRELIMINARY ISSUE REPORT

<b>Title:</b>	Preliminary Issue Report on Access by IGOs & INGOs to the Curative Rights Protections of the UDRP & URS																						
<b>Publication Date:</b>	16 May 2014																						
<b>Prepared By:</b>	Mary Wong																						
<table border="1"> <tr> <td colspan="2"><b>Comment Period:</b></td> </tr> <tr> <td>Comment Open Date:</td> <td>10 March 2014</td> </tr> <tr> <td>Comment Close Date:</td> <td>14 April 2014</td> </tr> <tr> <td>Reply Close Date:</td> <td>6 May 2014</td> </tr> <tr> <td>Time (UTC):</td> <td>23:59 UTC</td> </tr> </table>		<b>Comment Period:</b>		Comment Open Date:	10 March 2014	Comment Close Date:	14 April 2014	Reply Close Date:	6 May 2014	Time (UTC):	23:59 UTC	<table border="1"> <tr> <td colspan="2" style="text-align: center;"><b>Important Information Links</b></td> </tr> <tr> <td colspan="2" style="text-align: center;">Announcement</td> </tr> <tr> <td colspan="2" style="text-align: center;">Public Comment Box</td> </tr> <tr> <td colspan="2" style="text-align: center;">View Comments Submitted</td> </tr> <tr> <td colspan="2" style="text-align: center;">Report of Public Comments</td> </tr> </table>		<b>Important Information Links</b>		Announcement		Public Comment Box		View Comments Submitted		Report of Public Comments	
<b>Comment Period:</b>																							
Comment Open Date:	10 March 2014																						
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Announcement																							
Public Comment Box																							
View Comments Submitted																							
Report of Public Comments																							
<b>Staff Contact:</b>	Mary Wong	<b>Email:</b>	policy-staff@icann.org																				
<b>Section I: General Overview and Next Steps</b>																							
<p>In October 2013 the GNSO Council unanimously approved the consensus recommendations of its Policy Development Process (PDP) Working Group (WG) on Protection for IGO and INGO Identifiers in All gTLDs. One of these recommendations was for the Council to request an Issue Report, mandated in the ICANN Bylaws as a preceding step to a possible PDP, on the possibility of amending the Uniform Dispute Resolution Policy (UDRP) and Uniform Rapid Suspension procedure (URS) such as to enable access to and use of these curative rights protection measures by IGOs and INGOs. A Preliminary Issue Report was published for community input on 10 March 2014.</p> <p>Following the close of the public comment period and the publication of this Report of Public Comments, a Final Issue Report will be prepared for the GNSO Council, which will vote on whether or not to initiate a PDP on the issue. The Final Issue Report will include consideration of the feedback that was received through the public comment forum and that specifically addressed the contents of the Preliminary Issue Report. This summary report of all public comments received will be also be included as an Annex to the Final Issue Report.</p>																							
<b>Section II: Contributors</b>																							
<p><i>At the time this report was prepared, a total of twelve (12) community submissions had been posted to the Forum, not including a correction from one of the contributors and a spam message. One contributor submitted an initial comment and two reply comments. The contributors, both individuals and organizations/groups, are listed below in chronological order by posting date with initials noted. To the extent that quotations are used in the following narrative (Section III), such citations will reference the contributor’s initials.</i></p>																							



**Organizations and Groups:**

Name	Submitted by	Initials
IGO Commentators	OECD Legal	IGO
Internet Commerce Association	Phil Corwin	ICA
GNSO Intellectual Property Constituency	Claudio di Gangi	IPC

**Individuals:**

Name	Affiliation (if provided)	Initials
George Kirikos	Leap of Faith Financial Services, Inc.	GK
Alex Lerman		AL
Jay Chapman		JC
Konrad von Finckenstein		KF
Nat Cohen	Telepathy Inc.	NC
Ed Lehmann		EL
Chip Meade	MarketLift	CM

**Section III: Summary of Comments**

*General Disclaimer: This section is intended to broadly and comprehensively summarize the comments submitted to this Forum, but not to address every specific position stated by each contributor. Staff recommends that readers interested in specific aspects of any of the summarized comments, or the full context of others, refer directly to the specific contributions at the link referenced above (View Comments Submitted).*

**Support for a PDP**

One individual commentator (KF) and two groups/organizations (IGO; IPC) supported the initiation of a narrowly tailored PDP applicable only to IGOs and INGOs. KF noted that IGOs and INGOs face special issues, and supported ICANN staff's suggestion to investigate alternatives other than amending the UDRP and URS to address these needs. IGO restated their support (as stated initially during the PDP WG phase) for preventative protections but commented that, to the extent second level identifier protection other than for full names is to be curative instead, this should take the form of a separate procedure modeled on the UDRP and URS (such that there would be no interference with existing third party rights and obligations under these mechanisms). IPC supported first determining that special treatment for appropriately qualified IGOs and INGOs is necessary and, if so, developing a resulting policy that should be a modified form of the UDRP and URS, minimally adjusted for IGO and INGO needs – it should not include consideration of other issues such as geographic TLDs or revisiting the UDRP, which may be the subject of other ICANN processes.

**Opposition to a PDP**

Six individual commentators (GK; AL; JC; NC; EL; CM) opposed the creation of “special rights” and “special rules” for IGOs, and one organization (ICA) specifically opposed the initiation of a PDP. GK, AL,

JC and CM opposed any incursions on legitimate registrant and third party rights, including the need to protect due process. The creation of special rules for IGOs and INGOs was seen as amounting to the creation of new rights and new law by ICANN (GK; JC; ICA) and problematic in relation to acronyms (CM; NC; ICA). ICA also believed that a PDP to investigate the avenues of enquiry recommended by ICANN staff in the Preliminary Issue Report would constitute a substantial drain on GNSO and staff time and resources; it also pointed out that key ICANN constituencies had previously either opposed the development of a separate procedure for IGOs (the GNSO's Registry then-Constituency) or questioned the extent of the problem for IGOs (the GNSO's Business Constituency), such that a protracted PDP may still not end up with a solution. GK believed this to be a "miniscule" issue which did not justify the expenditure of ICANN resources. NC indicated support for GK's and ICA's comments.

### **Concerns over developing a dispute resolution procedure specific to IGOs and INGOs**

GK's and ICA's comments highlighted prior international inter-governmental forums where a dispute resolution procedure for IGOs had been discussed at length, viz. the Second WIPO Internet Domain Name Process (WIPO-2) in 2001 and the 2002 meeting of WIPO's Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications. These commentators quoted government and ICANN representatives participating in those proceedings who had warned against the creation of new law instead of focusing on procedures to address existing legal rights. In this regard, both commentators quoted the WIPO Secretariat's statement that Article 6ter of the Paris Convention contained guidelines for as well as qualifiers to the legal protections to be afforded to IGO names and acronyms; GK also commented that Article 6ter had been "misunderstood" and was not binding on ICANN.

GK and ICA also expressed concern that a procedure that removed the ability to appeal to a national court would unfairly dilute legitimate protections currently available to registrants. GK further pointed out that IGOs already currently waive their immunity from national jurisdiction in certain other contexts.

### **Suggestions for a dispute resolution procedure specific to IGOs and INGOs**

IGO suggested a number of design elements that could guide the creation of such a procedure, including its scope (not trademark-based, but reliance on IGO-specific criteria such as the list of IGOs that had been provided to ICANN previously and that can be included in the Trademark Clearinghouse for permanent claims notice protection); jurisdiction (not submission to the jurisdiction of national courts but, if necessary, to arbitration for a limited appeal purpose); and cost (subsidized by ICANN in view of IGOs' public interest missions).

### **Other Comments and Suggestions**

NC stated that international organizations should not be favored above other legitimate users of acronyms in widespread use, especially as international organizations can use the .int and .org extensions. GK and ICA considered that IGOs and INGOs should seek protection under existing laws

and ICANN's current procedures and mechanisms, including trademark registrations, judicial options and existing second level protections. GK, EL and CM opposed the initial IPC reply comment (subsequently withdrawn and amended) that had suggested possibly changing a substantive requirement in the UDRP and URS for any new procedure to be developed for IGOs and INGOs.

#### **Section IV: Analysis of Comments**

*General Disclaimer: This section is intended to provide an analysis and evaluation of the comments received along with explanations regarding the basis for any recommendations provided within the analysis.*

Commentators did not challenge the substantive research and background information provided in the Preliminary Issue Report; instead, most comments focused on either on the design and conduct of the PDP should one be initiated by the GNSO Council (viz. those commentators who supported a PDP) or on the risks of a PDP outcome that would create unique procedures or rights for IGOs and INGOs (viz. those commentators who did not support a PDP).

Those commentators who supported the initiation of a PDP expressed a preference for a narrowly tailored dispute resolution procedure applicable specifically to IGOs and/or INGOs, modeled on the UDRP and URS. One commentator specifically disfavored amending the UDRP and URS as part of this effort, and another specified that it should not overlap with or include issues that may be taken up in other ICANN processes already underway or to be launched. A third commentator provided a number of suggestions for the design of such a narrowly tailored procedure.

Those commentators who opposed the initiation of a PDP did not provide views on the differences between a PDP that would amend the UDRP and/or URS for IGO and INGO use and a PDP that would focus on developing a narrowly tailored procedure specific to IGO and INGO needs. The clear overall concern expressed was that creating any procedure to cater to IGOs and INGOs could be tantamount to ICANN (rather than governments) creating new law, and in the process result in the dilution or divestiture of protections that legitimate registrants currently enjoy under the UDRP and URS, including the option for recourse to national courts.

In relation to the practicalities of conducting a PDP, one commentator was concerned about the number and scope of issues that had been identified by ICANN staff as possibly warranting consideration as part of a PDP. In relation to the legal basis warranting special protections or procedures for IGOs, two commentators brought up the question of the scope of Article 6ter of the Paris Convention.

The Final Issue Report will include this Report and analysis of the public comments received, to enable the GNSO Council to fully consider all the issues and concerns expressed by the community in order to vote on whether or not to initiate a PDP on access by IGOs and INGOs to the curative rights protections of the UDRP and URS.