Staff Summary/Action Items Email from Sub Group B

Dear all,

Thank you for the excellent discussion both on the Sub-Group call yesterday and continuing on this list. As Phil has noted in a separate reply, some of the points are beyond the scope of this Sub-Group, but staff hopes that the good discussion can continue on the main WG mailing list and future WG calls.

Based on the Sub-Group call, here is a summary of some of the substantive points that were made and that may help guide our further work, as well as a list of proposed action items, as requested.

GENERAL:

- There are 192 IGOs on the list provided to ICANN by the GAC (in spring 2013); and this list is the "universe" of IGOs for whose identifiers (names and acronyms) the original GNSO PDP Working Group recommended certain protections for in November 2013. This is therefore also the list that was given to our WG to consider curative protections for – although it may be useful to bear in mind going forward that it's possible the GAC may request changes to this list in the future (though it has not done so to date). Although this is beyond the scope of our Sub-Group, this may be a point to make to the full WG as it begins to consider appropriate measures (if any) in the next phase of its work.

- There are approximately 140+ INGOs on the General Consultative ECOSOC list, and over 3000 INGOs on the Special Consultative ECOSOC list. For both lists, an INGO has to submit an application that is substantively vetted by the ECOSOC before being admitted (or not) to one or the other list. As with IGOs, this list was that agreed on by the original GNSO PDP Working Group as the "universe" of INGOs for which certain protections were recommended; similarly, this list may change in the future (though not through ICANN or GAC action but rather via updates by ECOSOC).

- Of the original PDP WG's recommendations relating to IGOs, the Board

has accepted those that recommend protection for IGO Full Names (not acronyms) via reservation at the top and second level. The issue of appropriate protection for IGO acronyms other than through post-registration curative rights dispute resolution remains unresolved – but the GNSO Council is currently considering the GAC advice and consequent Board request to amend the original recommendation such that IGO acronyms will be entered into the TMCH for the life of the TMCH (i.e. so-called "permanent" TMCH protection) so that an IGO on the GAC list will receive a Notice of Registered Name should a third party register a second level domain name that matches the IGO's acronym.

- For IGO acronyms, the full extent of protection for these will therefore only be known after the GNSO-Board-GAC resolve the TMCH question and after our WG completes our work and recommendations.

- The GAC has not issued any advice or requested any protection for any INGO except for the Red Cross and the International Olympic Committee (these being two INGOs that have international legal protection via treaty and legislation in multiple jurisdictions).

- The main problem for IGOs in using the UDRP or URS is likely the jurisdictional immunity issue rather than trademarks (although some IGOs have trademarks, not all do).

- The main problem for INGOs in using the UDRP or URS is the need to have trademarks (or similar rights) - however, some INGOs (e.g. the IOC) do have trademarks (or similar rights).

- We do not currently have records as to which IGOs and INGOs have trademarks (or similar rights) in their acronyms.

- The ICANN General Counsel report to the original PDP WG had highlighted eleven jurisdictions that provide protection for IGO identifiers – of these, five (Australia, Canada, South Africa, South Korea and the USA) seem to have specific legislation that either refers to Article 6ter of the Paris Convention or that are otherwise specific to IGOs.

SUB-GROUP NOTES ON SOME OF THE ABOVE POINTS:

- The Sub-Group noted that the full WG should – at the appropriate juncture – discuss whether or not INGOs should be dropped from consideration based on the general principles and observations noted above.

- The Sub-Group also noted that while the WG Charter limited the WG to the GAC list of IGOs and the ECOSOC list of INGOs, the WG should bear in mind when developing its eventual recommendations that these lists may change with time.

ACTION ITEMS / PROPOSALS (Please note the QUESTIONS posed below):

1. Trademark searching:

- Focus initially on IGOs rather than INGOs.
- Search for all 192 IGOs on the GAC list.

QUESTION FOR THE SUB-GROUP -

- Option #1: Search TMView – however, note that this is a largely European-based database; as such, four of the five countries from the GCO survey (Australia, Canada, South Africa, South Korea) are not in TMView.
- Option #2: Search TMView AND the national TM databases for the five GCO-noted countries (except for South Africa, the other four appear to be freely searchable online).
- Option #3: Search just the national TM databases for the five GCO-noted countries (except for South Africa, the other four appear to be freely searchable online).

2. Article 6ter searching:

- Search the WIPO 6ter Database for all 192 IGOs on the GAC list to see if they have registered for protection under 6ter. (**NOTE**: I attach a list from October 2007 that may have been compiled as part of the GNSO's 2007 Issue Report effort on this issue; perhaps we can start there to see how many of the 192 IGOs are already on the list, and do a search for the

others?)

3. Staff Suggestion:

- We will approach our colleagues in the GCO to seek assistance with the TM database search outside of TMView. As noted on the Sub-Group call, we do not have interns or research fellows that we can assign to the work, but the GCO may be able to assist (as they did for the original IGO-INGO PDP Working Group survey of jurisdictions).

- In the meantime, perhaps the Sub-Group members (with or without staff included, at your option) could divide up the searches e.g. take 30-40 IGOs each and search TM View and the 6ter database? Staff can compile the results into charts or other suitable documentation for comparison and analysis by this group and the full WG.

- Following the TM and 6ter searches, the Sub-Group can discuss dividing up the IGO list or perhaps taking a representative sample from that list to do a compilation of each of the IGO's mission and geographic presence (from information presented on that IGO's website).

I hope the above helps – please let the Sub-Group know your thoughts on how to proceed, including your preference on the three TM search options.

Thanks and cheers
Mary