

STAFF SUMMARY OF PRIOR WORK ON IGO DISPUTE RESOLUTION¹

Prepared for Sub-Group C – 30 September 2014

I. WHAT DID THE SECOND WIPO INTERNET DOMAIN NAME PROCESS (WIPO-2) RECOMMEND AND ON WHAT BASIS?

(a) Basis for Legal Protection:

Existing international law (Article 6ter, Paris Convention) provides clear principles prohibiting the use of IGO names and abbreviations as trademarks or elements of trademarks. Exception: where use of the IGO name or acronym is *“not of such a nature to suggest to the public that a connection exists with the organization concerned, or is probably not of such a nature as to mislead the public as to the existence of a connection between the user and the organization”*.

However, this legal basis alone is insufficient to deal with the whole range of bad faith registration and use of IGO names and (especially) acronyms as domain names.

Also, the .int domain does not adequately protect IGO names and acronyms from abuse: criteria is too restrictive, it is not universally adopted by all IGOs and does not prevent registration in other gTLDs.

(b) Evidence of Harm:

“Evidence was provided throughout the Second WIPO Process of a sizeable problem of abuse of the names and acronyms of IGOs in the DNS ...

“... The 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 existing situation with respect to the names and acronyms of IGOs in the DNS is unbalanced. Any person, without any qualification whatsoever, may register the name or acronym of an IGO in an unrestricted gTLD. Furthermore, they can do so immediately and at an insignificant cost. In contrast, the potential damage that can be inflicted with the use of such a registration is of a different order. The pursuit of protection against such harm not only is distractful to the central missions of IGOs and wasteful of their limited resources, but also may involve questionably

¹ Note that staff has underlined key passages, quotes, excerpts and recommendations that the Sub-Group or the full WG may wish to discuss further.

unnecessary deviation from the standard principle of immunity of IGOs from jurisdiction.”

(c) Options & Recommendation:

The two options presented to our WG were expressly considered by WIPO:

“(i) A modification of the existing UDRP, specifically designed for the bad faith misuse of the names or acronyms of IGOs through domain name registrations. This option, however, is unacceptable because (a) insofar as ICANN, acting on the basis of recommendations from the Domain Name Supporting Organization (DNSO) or the DNSO Names Council, might be considered to be responsible for the introduction of modifications to the UDRP, it and its subsidiary bodies do not have any constituency pertinent to international intergovernmental organizations; and (b) the UDRP contains within its design an unacceptable deviation from the established principle of immunity of IGOs from the jurisdiction of national courts.”

OR

“(ii) An administrative procedure, similar to the UDRP, but independently developed and managed within the framework of international administrative tribunals. Such an administrative procedure could be available to any IGO to file a complaint that a domain name registration 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. Like the UDRP, the remedies that might be awarded by a panel under the special administrative procedure should be limited to cancellation or transfer of the domain name registration and should be implemented through the ICANN system (or ccTLD administrators) within the DNS.”

The WIPO Report recommended adopting Option (ii); however, it noted that this “would involve, at least in cases not involving the use of domain names as trademarks, the creation of new international law. It would represent an extension of the principles in Article 6ter of the Paris Convention, the Trademark Law Treaty and the TRIPS Agreement. While it is believed that such an extension is desirable, it 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.”

II. WHAT DID THE WIPO GENERAL ASSEMBLY ADOPT?

(a) Decision:

“The General Assembly adopted the recommendation of the SCT with respect to the names and acronyms of IGOs, namely that the UDRP be modified to provide for complaints to be filed by an IGO. The Delegation of the United States of America dissociated itself from this recommendation.”

(b) The specific recommendation from WIPO’s Standing Committee on the Law of Trademarks, Industrial Designs & Geographical Indications (SCT):

“1. The Special Session recommends that the UDRP be modified to provide for complaints to be filed by an international intergovernmental organization (IGO):

A. On the ground that the registration or use, as a domain name, of the name or abbreviation of the IGO that has been communicated under Article 6ter of the Paris Convention is of a nature

(i) to suggest to the public that a connection exists between the domain name holder and the IGO; or

(ii) to mislead the public as to the existence of a connection between the domain name holder and the IGO;

or

B. On the ground that the registration or use, as a domain name, of a name or abbreviation protected under an international treaty violates the terms of that treaty.

2. The Special Session further recommends that the UDRP should also be modified ... to take account of and respect the privileges and immunities of IGOs in international law. In this respect, IGOs should not be required, in using the UDRP, to submit to the jurisdiction of national courts. However, it should be provided that decisions given in a complaint filed under the modified UDRP by an IGO should be subject, at the request of either party to the dispute, to de novo review through binding arbitration.”

III. WHAT DID THE ICANN PRESIDENT'S JOINT WORKING GROUP RECOMMEND IN 2004?

(a) Outcome:

No consensus on adopting the WIPO-2 Recommendation to modify the UDRP

(b) Arguments opposing adoption:

- 1)"the UDRP is flawed...fix it first before amending or adding"
- 2)"There is no support in International law for protecting country names in any manner or forum and ICANN does not and should not have the power to create what amounts to international law"
- 3)"many trade marks for country names and the acronyms of IGOs are already registered in many countries legally and in keeping with both national law and international treaties (Paris Union)"
- 4)"Denying access to the Courts is a fundamental (breach) change in the original bargain negotiated between the constituencies of the GNSO (DNSO) and the Board"
- 5)"The GNSO has already said ...No"

(c) Arguments in favor of adoption:

Essentially, a GAC (government) recommendation so question for ICANN is not WHETHER but rather HOW:

- 1) "There is no support in International law for the existing UDRP. ICANN simply came up with a set of rules through consultation with WIPO and the GNSO (DNSO) and incorporated them into its contracts. It can amend same if it chooses to do so as long as it does not 'break' national or international law"
- 2) "Arbitration is a long well established form of dispute resolution and in this case solves the problem of jurisdiction which in the case of Governments would be very tricky under a Court based Appeal system"
- 3) "The system is "bad faith" based and therefore is not an unfair interference with existing or future registrations of trademarks or domain names which happen to coincide with an IGO or country name (unless there is a reserve list which they generally do not approve)"
- 4) "It is open to the Board to accept this recommendation despite the GNSO, and, where it has a commitment in its Charter to the GAC this is such a case

where the importance of the matter requires the Board to make its decision without being bound by the GNSO position”

5) “This is a serious problem for many countries and needs to be addressed quickly just as domain name cybersquatting was originally dealt with using the existing UDRP”

IV. WHAT DID THE GNSO ISSUE REPORT ON DISPUTE HANDLING FOR IGO NAMES & ABBREVIATIONS RECOMMEND IN 2007?

(a) Background:

The Issue Report had been requested by the GNSO Council pursuant to an IPC request. The IPC’s request had been opposed by the Registries Constituency.

Note also that the 2007 GAC Principles on New gTLDs contains the following principles:

“2.3 The process for introducing new gTLDs must make proper allowance for prior third party rights, in particular trademark rights as well as rights in the names and acronyms of inter-governmental organizations (IGOs).

2.7 Applicant registries for new gTLDs should pledge to:

(a) Adopt, before the new gTLD is introduced, appropriate procedures for blocking, at no cost and upon demand of governments, public authorities or IGOs, names with national or geographic significance at the second level of any new gTLD.

(b) Ensure procedures to allow governments, public authorities or IGOs to challenge abuses of names with national or geographic significance at the second level of any new gTLD.”

This issue was not dealt with by the GNSO Reserved Names Working Group in its Final Report.

(b) Staff Recommendation in the Issue Report:

- “Staff does not recommend a PDP on the protection of IGO names and abbreviations at this time.
- Staff recommends that new gTLD agreements may provide for protection of IGO names and abbreviations as a contractual condition for new gTLDs.

- Staff recommends that a separate Dispute Resolution Procedure be developed for IGO names and abbreviations as domain names at the second or third level in new gTLDs and that a framework be developed for handling objections or challenges related to IGO names and abbreviations in the upcoming application round for new gTLDs.
- Once the DRP has been developed, staff recommends that the GNSO Council consider launching a PDP to investigate its application to existing gTLDs
- In the alternative, the GNSO Council may consider forming a Working Group or assistance group to collaborate on a DRP for IGO names and abbreviations and conduct a PDP for application of the DRP to existing gTLDs.
- The GNSO Council may also consider extending the work of the Protections of Rights of Others (PRO) Working Group to develop a DRP for IGO names and abbreviations.

(c) Outcome:

No further work was undertaken by the GNSO as a motion failed to carry in the GNSO Council due to lack of votes.

Email From Mike Rodenbaugh:

2. The Sub-Group's focus is on identifying circumstances that may have changed the need for and/or scope of protections for IGO and/or INGO identifiers since the GNSO's work in 2007. Please see below for those that identified by our Subgroup, and please reply with any additional suggestions you may have:

- The New gTLD Program: now we know the scale and scope of the expansion that was only speculative in 2007

- Increasing GAC role/IGO request for protections in the New gTLD Program: there is now specific GAC advice that there be additional protections for IGOs (including acronyms) and for the Red Cross and IOC (two INGOs) in the New gTLD Program. Certain interim protections have been put in place for some of these while the GNSO completes its work. For IGO acronyms, the final scope of their protection will depend on (1) the extent of Trademark Clearinghouse (and accompanying trademark claims notice) protection they get (see further below); and (2) whether our WG develops recommendations that will enable them to better use curative rights mechanisms.

- GNSO recommendations for IGO acronyms differ from GAC advice: As noted above, differences remain between the GNSO's adopted recommendation for IGO acronyms

and the GAC advice. Discussions are ongoing among the Board, GAC and GNSO on resolving this, which hinge in part on the duration and nature of TMCH (and TM claims) protection.

- The creation of added RPMs (e.g. TMCH and URS) for the New gTLD Program: however, as noted in the Issue Report for our WG, these may not address IGO or INGO needs.

3. In our next phase of work (Phase II), we suggest that the full WG consider these identified changed circumstances alongside the data gathered by Sub-Groups A and B, to discuss whether these changes and data illustrate that there is indeed a need (or not) to update the GNSO's 2007 work by considering either amending the UDRP and/or URS, or developing a special dispute resolution procedure, for IGOs or INGOs (either or both).

Thanks,
Mike