

DRAFT—FOR DISCUSSION ONLY

November __, 2014

Dear members of the GNSO Council:

We are writing to you in our capacity as Co-Chairs of the Curative Rights Protection for IGOs and INGOs PDP Working Group (WG). We wish to both make you aware of a portion of the GAC Communique issued on October 16th in Los Angeles that bears directly on the task before this WG; as well as to request enlisting the assistance of Mason Cole, the new liaison between the Council and the GAC, to clarify certain relevant aspects of the Communique and help facilitate a better understanding of our task by the GAC as well as generate constructive input from the GAC as well as IGOs.

The relevant portion of the Communique (see Attachment A) states:

Concerning curative protection at the second level, and noting the ongoing GNSO PDP on access to curative Rights Protection Mechanisms, the GAC reminds the ICANN Board that any such mechanism should be at no or nominal cost to IGOs

-and-

That the UDRP should not be amended

As can be seen, the GAC has advised the ICANN Board that any curative rights process developed by our WG “should be at no or nominal cost to IGOs” and that in developing an appropriate curative rights mechanism “the UDRP should not be amended”.

This communication is at some variance from the Charter for our WG (see Attachment B). In regard to the expense of any curative rights process for IGOs, we have been directed to consider “the issue of cost to IGOs and INGOs to use curative processes”.

Many members of our WG already consider the fees charged by UDRP and URS arbitration providers to be nominal, especially in comparison to the far higher cost of litigation. We have not been directed to create a process that is without charge to IGOs, nor do we have the ability to determine what entities might bear the cost of a free curative rights process or the power to direct existing or future dispute resolution providers to undertake their work at no charge.

In regard to the GAC directive that the UDRP not be amended, that is also at variance with our WG Charter. We have been directed to consider, in part:

- The interplay between the topic under consideration in this PDP and the forthcoming GNSO review of the UDRP, URS and other rights-protection mechanisms
- 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
- Conduct research on the extent to which IGOs and INGOs already have trademarks and might be covered, in whole or in part, by existing UDRP and URS proceedings
- **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 **(Emphasis added)**

As can be readily seen, our Charter clearly requires us to consider potential amendments of the UDRP (and URS) to accommodate the protective needs of IGOs; as well as to consider whether there are practicable alternatives to such amendment. The GAC's advice to the Board, if we were to follow it, would prevent us from faithfully carrying out the Charter's directive. Further, while our deliberations are in a very early stage, amendment of the UDRP, if deemed necessary and practicable, would rest on the existing foundation of trademark law. Creation of an entirely new curative rights process solely for IGOs would need to be based on globally recognized rights of another kind because, as we believe the GAC would concur, ICANN has a responsibility to protect existing rights but is not an international legislature authorized to create new forms of rights.

Given the incompatibility between certain aspects of the GAC advice and portions of our Charter, and noting that our WG is at an early stage in addressing its task, we hereby seek the assistance of the Council in directing Mason Cole to engage in a dialogue with the GAC regarding this matter and to seek to have interested GAC representatives and/or IGOs to engage cooperatively in this policy process.

Further, we would hope that the following questions could be directed to the GAC as we seek clarifications that will assist the WG in its task:

- On the matter of no or nominal costs to IGOs – Does the GAC consider the current fees charged by URS and UDRP providers to be nominal? If the GAC

- considers those charges to be in excess of nominal, then what source of funding or other support mechanism would the GAC suggest to fully pay or subsidize the fees charged by dispute resolution providers?
- In regard to the issue of potential amendment of the UDRP – Why has the GAC gone on record as opposing any UDRP amendments as a means of providing IGOs with access to curative rights? If it is the GAC's position that an entirely new curative rights mechanism must be created, then what universally recognized legal rights of IGOs should be its basis?

We thank the Council in advance for whatever assistance it is able to provide us to clarify this situation.

Sincerely,

Philip Corwin

Petter Rindforth

Co-Chairs

Attachment A – Relevant Portion of the LA GAC Communiqué

On October 16th the GAC issued a Communiqué that is available at https://gacweb.icann.org/download/attachments/27132037/Los%20Angeles_GAC%20Communique_Final.pdf?version=1&modificationDate=1413479079702&api=v2

On pp.6-7 of the Communiqué the following language relevant to the task of our WG appears:

3. Protection of Inter--Governmental Organisation (IGO) Names and Acronyms

a. The GAC reaffirms its advice from the Toronto, Beijing, Durban, Buenos Aires, Singapore and London Communiqués regarding protection of IGO names and acronyms at the top and second levels, as implementation of such protection is in the public interest given that IGOs, as created by governments under international law, are objectively different right holders; namely,

i. Concerning preventative protection at the second level, the GAC reminds the ICANN Board that notice of a match to an IGO name or acronym to prospective registrants, as well as to the concerned IGO, should apply in perpetuity for the concerned name and acronym in two languages, and at no cost to IGOs;

ii. **Concerning curative protection at the second level, and noting the ongoing GNSO PDP on access to curative Rights Protection Mechanisms, the GAC reminds the ICANN Board that any such mechanism should be at no or nominal cost to IGOs; and further, in implementing any such curative mechanism,**

b. The GAC advises the ICANN Board:

i. **That the UDRP should not be amended;** welcomes the NGPC's continued assurance that interim protections remain in place pending the resolution of discussions concerning preventative protection of IGO names and acronyms; and supports continued dialogue between the GAC (including IGOs), the ICANN Board (NGPC) and the

GNSO to develop concrete solutions to implement long--
standing GAC advice. **(Emphasis added)**

4. Protection of Red Cross/Red Crescent Names

The GAC welcomes the decision of the New gTLD Program Committee (Resolution 2014.10.12.NG05) to provide temporary protections for the names of the International Committee of the Red Cross and International Federation of Red Cross and Red Crescent Societies, and the 189 National Red Cross and Red Crescent Societies. The GAC requests the ICANN Board and all relevant parties to work quickly to resolve the longer term issues still outstanding.

Attachment B – GNSO Council resolution Establishing the WG

WG Charter:

<http://gns0.icann.org/en/drafts/igo-ingo-crp-access-charter-24jun14-en.pdf>

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 extent to which IGOs and INGOs already have trademarks and might be covered, in whole or in part, by existing UDRP and URS proceedings;
- Conduct research on the number and list of IGOs currently protected under Article 6ter of the Paris Convention on Intellectual Property;
- Conduct research on the number and list of INGOs included on the United Nations list of non-governmental organizations in consultative status with the Economic and Social Council. ;
- **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;**

- Consider mechanisms that would require a very clear definition of the mission of the IGOs, its scope of operations and the regions and countries in which it operates; the goal here being to provide a context for the IGO or INGO similar to the scope and terms of a trademark with its International Class and clear description of goods and services;
- Consider recommendations that incorporate fundamental principles of fair use, acknowledge free speech and freedom of expression, and balance the rights of all to use generic words and other terms and acronyms in non-confusing ways; 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). **(Emphasis added)**