

IGO small group response to the GNSO PDP Working Group questions

(1) Given that in many jurisdictions IGOs benefit from Article 6ter protection only by registering trademarks that they will have to defend in a national court, what are the specific problems and concerns faced by IGOs in relation to the UDRP and URS requirement that in order to file a complaint they agree to submit to the jurisdiction of a court of competent jurisdiction?

IGO's reply: This question appears to be based on a misunderstanding of Article 6ter of the Paris Convention. For our part, IGOs are not aware of a jurisdiction that would require IGOs to register their identifiers as a trademark to benefit from 6ter protection.

If the Working Group/GNSO is aware of such jurisdiction(s), IGOs would appreciate the GNSO providing a list of such jurisdiction(s), together with the texts of the relevant implementing legislation.

In this respect, it is noted that some countries may record IGO identifiers in their trademark databases, but this would be a purely administrative measure and does not change either the basis or the extent of the protection under 6ter.

Indeed, one effect of Article 6ter of the Paris Convention is that the emblems of sovereign States and IGOs identifiers need not be registered in national trademark registries. Notably, 6ter Paragraphs 1(a) and (b) provide that “[the 176] countries of the Union agree to **refuse or invalidate the registration, and to prohibit by appropriate measures the [misleading] use...as trademarks**...abbreviations, and names, of international intergovernmental organizations...”

In other words, the Paris Convention provides preventative (and curative) protection by requiring that contracting States refuse (or invalidate) the registration by a third party of a trademark that could mislead the public and prohibit any other misleading use. The obligations of the Paris Convention are on the signatories—not IGOs—to ensure that IGO identifiers are appropriately protected.

Thus, at first instance, the concern faced by IGOs in the UDRP and URS context arises from the manner in which 6ter is implemented in national legislation (i.e., by not requiring IGOs to proactively register their identifier as a trademark, but by prohibiting others from misleadingly doing so); in this way, IGOs would generally find difficulty in meeting the UDRP and URS standing requirements of holding a trademark registration.

With respect to the question about submission to a court of competent jurisdiction, this is a question that goes to the heart of IGOs' independent legal identity and ability to focus on their respective mandates (i.e., IGOs are not required to defend their rights in national courts).

IGO benefit from privileges and immunities, including immunity from legal process in a court of national jurisdiction. Indeed, IGO privileges and immunities are long-recognised under international law, and are formally inscribed in the respective IGO founding treaty and/or international treaties or, further agreements (such as host country agreements) signed with individual States. Recalling why such immunities exist, IGOs are effectively associations of independent sovereign States (each of whom individually maintain sovereign immunities). Because of this, subjecting an IGO to the laws of a given sovereign State (for example, by appearing before a national court) would effectively require other sovereign States that are members of the IGO to cede some sovereignty to the State in which the national court sits. **Thus, immunities are necessary to the functioning of IGOs in order to ensure their independence from any single State.**

When an attempt is made to summon an IGO before a national court, the IGO regularly raises its immunity, including with the intervention of the competent authorities (usually Foreign Ministry/State Department) of the relevant State. Similarly, the enforcement of misuse of IGO identifiers is the responsibility of the State signatory of the Paris Convention and/or WTO TRIPS.

Submission to the UDRP and URS as currently drafted would necessitate waiving IGOs' immunity from legal process, which would involve a specific decision taken at the highest levels of our governance structures. In fact, IGOs have only rarely and exceptionally waived their immunity for any purposes; doing so for application to the UDRP would be unacceptable.

It bears emphasizing that these concerns are fundamental to IGOs' existence, and extend beyond the DNS or particular invocations of intellectual property rights.

(2) What are some of the ways that IGOs currently use to obtain and enforce national rights pursuant to their Article 6ter protections?

IGO's reply: Referring to the above explanation, this question similarly appears to be based on a misunderstanding of Article 6ter of the Paris Convention.

Article 6ter of the Paris Convention places an obligation on States to prevent the misleading use of IGO identifiers. The Working Group/GNSO may wish to consult the attached document, which lists the various national legal mechanisms that States employ to fulfil these obligations. Again, IGOs are thus not required to "obtain" the rights in their identifiers.

Fundamentally, IGOs rely on States (e.g., through their trademark offices) to prevent (or allow for invalidation) abuse of IGO identifiers in the first place. IGOs are focused on their State-requested public causes, not necessarily on "brand enforcement".

It is up to each State to ensure that adequate measures are in place, e.g., so that trademark examiners properly account for IGO identifiers. We cannot speak for all jurisdictions, but we do know how it works in some, as we have been involved in the processes: trademark examiners would notify a trademark applicant of a possible conflict between an IGO identifier and the trademark application. The applicant, if it wishes to pursue its application, requests a non-objection letter from the IGO.

It is worth emphasizing here that IGOs seek only to prevent **abusive/misleading use** (not all uses) of their names and acronyms. This should not be misunderstood as IGOs seeking to universally block all registrations of web addresses that contain such identifiers. Rather, the current request in the DNS/New gTLD context is similar to the approach with trademark applications in that it seeks, in good faith, to prevent abuse or confusion.

Outside of the trademark registration processes, including in regard to the inappropriate use of IGO identifiers in the DNS, our enforcement efforts may take several forms. IGOs first generally seek to contact the potential infringer to assert our rights and in appropriate cases, to demand that their use ceases. In the case of domain names, we may report the use to the relevant internet service provider or domain name registry. IGOs may also seek the assistance of the relevant government entities, in particular the ministries of justice or foreign affairs, as well as the national representatives of the IGO. It bears repeating that, due to the fundamental nature of our immunities, we would rarely (if ever) consider waiving these immunities to enforce our rights guaranteed by international (not merely national) law.

In broader terms, against the backdrop of ICANN's striving to increase its global accountability, we recall that the Affirmation of Commitments calls for ICANN decisions to promote consumer trust (not to mention again ICANN's own Articles of Incorporation, which determine that the corporation shall carry out "its activities in conformity with relevant principles of international law and applicable international conventions and local law"). Allowing unfettered domain name registrations without providing for a curative mechanism to redress identified harms, is in direct contrast to fostering consumer trust. We feel it important to emphasize here that this request for curative protection is not at odds with the openness of the DNS, nor should it be mischaracterized as such; rather, this request for access to curative rights protection measures should be seen for what it is: one small means to tackle online fraud and confusion.

In this regard, an excerpt from the 2001 Report of the Second WIPO Internet Domain Name Process bears repeating: "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."

In conclusion we reiterate our call to ICANN, and this Working Group/the GNSO to recognize that protection of IGOs is in the public interest and to institute the appropriate measures of redress.