

**Comments of the United States**  
**to the Initial Report of the GNSO**  
**IGO-INGO Access to Curative Rights Protection Mechanisms**  
**Policy Development Process Working Group**

The United States (U.S.) welcomes the opportunity to provide comments to the Initial Report of the Generic Names Supporting Organization (GNSO) IGO-INGO Access to Curative Rights Protection Mechanisms Policy Development Process Working Group (WG). These comments focus on Recommendation #2 of the Initial Report,<sup>1</sup> in which the WG concludes that an IGO has “standing” to file a UDRP/URS complaint on compliance with the communication and notification procedure of Article 6*ter* of the Paris Convention. The U.S. disagrees with this recommendation because it incorrectly concludes that an IGO has standing, and therefore a right that is equivalent or similar to trademark rights, based on completion of the communication and notification under Article 6*ter*. This procedure does not have any legal effect under the terms of the treaty itself and therefore, there is no international right. Further, there is no harmonized approach among treaty members in implementation of Article 6*ter*.

***“Recommendation #2:***

*For IGOs, in order to demonstrate standing to file a complaint under the UDRP and URS, it should be sufficient (as an alternative to and separately from an IGO holding trademark rights in its name and/or acronym) to demonstrate that it has complied with the requisite communication and notification procedure in accordance with Article 6*ter* of the Paris Convention for the Protection of Industrial Property. For clarity, the Working Group recommends that a Policy Guidance document pursuant to the UDRP and URS be prepared and issued to this effect for the benefit of panelists, registrants and IGOs.”*

This recommendation was part of the GNSO WG’s discussion to determine whether inter-governmental organizations (IGOs) could “access” the Uniform Domain Name Dispute Resolution Policy (UDRP) or the Uniform Rapid Suspension System (URS); in other words, whether IGOs could establish standing to pursue a complaint in either of these mechanisms, without having to register their acronyms or names as trademarks. According to the WG’s Recommendation #2, a notification under Article 6*ter* of the Paris Convention would satisfy the first element of a proper UDRP and URS complaint. In other words, a notification under Article 6*ter* would be equivalent to a trademark owner’s claim of rights to a trademark or service mark under Section 4(a)(i) of the UDRP. By complying with the requisite communication and notification procedure in accordance with Article 6*ter*, an IGO then would have standing to

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<sup>1</sup> These comments do not address the other four recommendations in the Initial Report. Recommendation #1 merely notes that the Initial Report recommendations do not apply to international non-governmental (INGOs); two such INGOs, the Red Cross and the International Olympic Committee, are the subject of separate GAC advice. For the same reasons advanced in these comments, the U.S. cannot agree to Recommendation #3, which indicates that the Policy Guidance document identified in Recommendation #2 should reference Article 6*ter*(1)(c) for UDRP/URS panelists’ consideration. The U.S. also takes no position on Recommendation #4, addressing jurisdiction immunity, and further notes that Recommendation #5 already is the subject of GAC advice, i.e., that any curative rights protection mechanisms be provided at no or nominal cost, which the WG has taken into account.

pursue an action in the UDRP or URS, regardless of whether it had obtained a trademark for its name or acronym. (Initial Report at 11.)

The WG has acknowledged that Article 6*ter* does not create any substantive rights, yet it has concluded that Article 6*ter* of the Paris Convention provides the basis for IGOs' "rights" to use the UDRP/URS. (Initial Report at 12.) But there is no equivalency between a Paris Convention notification and a trademark right, as the following explanation of how the treaty operates will demonstrate.

The protection of IGO names and acronyms at the second level in new generic top-level domains (gTLDs) has been a Governmental Advisory Committee (GAC) priority since 2012. A disagreement between several GAC members, including the U.S., and the IGOs on whether Article 6*ter* of the Paris Convention provides a legal basis for the presumption of protection for IGO names and acronyms led the GAC to advance an alternative basis for protection, i.e., the existing criteria for registration at the second level in the .int top-level domain. This approach was adopted in October 2012 and it has been the basis for progressive exchanges between the GAC and the ICANN Board, ultimately culminating in the IGO Small Group Report. While the IGOs continue to disagree with the U.S. (and others) on the interpretation of Article 6*ter*, the IGOs and the U.S. nevertheless "agreed to disagree" on the applicability of Article 6*ter* and to move forward on an alternative basis, as is reflected in the IGO Small Group Report.

GAC advice to the ICANN Board has repeatedly emphasized that IGOs are in an objectively different category to other right holders and that the governments support the implementation of appropriate protections of IGO names and acronyms on public policy grounds. This is the basis for the inclusion of IGOs on the reserved names list for gTLDs, and the GAC has taken the position that those IGOs on the list should have access to a separate curative rights dispute resolution mechanism.

### **The Purpose of 6*ter* and Notification**

Eligibility to use the UDRP/URS cannot be defined on the basis of whether an IGO has notified its name or acronym to the World Intellectual Property Organization (WIPO), who then communicates that notification to WIPO Member States. The notification process has no legal effect under the Paris Convention and WIPO does not have the authority under the treaty to grant any international rights or recognition by virtue of that process. The treaty only requires members to prohibit uses of IGO names and acronyms that mislead consumers. WIPO Member States are the only entities that have the ability to decide what is an IGO name or acronym for purposes of interpreting and implementing the treaty obligation and under what conditions the misleading use of an IGO name or acronym should be actionable under national law.

The primary purpose of Article 6*ter* of the Paris Convention is to recognize symbols of national sovereignty and prevent them from being used as commercial trademarks, not to protect commercial trademarks or indications of source adopted by Member States or their departments. In *the Guide to the Application of the Paris Convention for the Protection of Industrial Property*, Professor G.H.C. Bodenhausen describes the purpose of Article 6*ter* as follows: “The Article concerns trademarks, but its purpose is not to regulate their protection as subjects of industrial property but rather to exclude them from becoming subjects in certain circumstances.”<sup>2</sup> The same interpretation is set forth in the *WIPO Intellectual Property Handbook*: “The purpose of Article 6*ter* is not to create an industrial property right in favor of the State...in respect of the distinctive signs concerned but simply to prevent the use of those signs as trademarks in industrial or commercial activities.”<sup>3</sup> The *Handbook* further notes that “[t]his Article obliges a member country, in certain circumstances, to refuse or invalidate the registration and to prohibit the use, either as trademarks or as elements of trademarks, of the distinctive signs specified in that Article of member countries and certain international intergovernmental organizations.”<sup>4</sup>

The Paris Convention is not self-executing in the United States and many other countries. This means that national legislation is required in those countries to implement its obligations and that IGOs have no direct cause of action in national courts to enforce its provisions. The notification process outlined in Article 6*ter* does not, nor was it intended to, function as a governmental or IGO trademark registry. It is merely designed to assist Paris Convention members in identifying which designations the notifying party, i.e., the government or the IGO, wishes to be considered for recognition under the Convention. It is up to each Member to decide whether that notification meets the subject matter conditions of the treaty and if it does in their view, whether to then give that notification any weight in evaluating whether the terms of the treaty have been met at the national level. Thus, nothing is conveyed, granted, or established by an IGO’s mere completion of the communication and notification requirement.

### **USPTO Review Process for 6*ter* Notifications**

Under Article 6*ter*, each member country or IGO may communicate armorial bearings, emblems, official signs and hallmarks indicating warranty and control, and names and abbreviations of IGOs to the IB (the International Bureau of the World Intellectual Property Organization (WIPO) who administers the Paris Convention), which then transmits the notification to the member

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<sup>2</sup> G.H.C. Bodenhausen, *Guide to the Application of the Paris Convention for the Protection of Industrial Property*, WIPO Publication No. 611(E), 1969, p. 95, at [http://www.wipo.int/edocs/pubdocs/en/intproperty/611/wipo\\_pub\\_611.pdf](http://www.wipo.int/edocs/pubdocs/en/intproperty/611/wipo_pub_611.pdf) (last accessed February 22, 2017).

<sup>3</sup> *WIPO Intellectual Property Handbook: Policy, Law and Use*, 2d ed., WIPO Publication No. 489(E), Chapter 5, ¶ 5.88 (2004), at <http://www.wipo.int/about-ip/en/iprm> (last accessed February 22, 2017).

<sup>4</sup> *Id.* at ¶ 5.87.

countries.<sup>5</sup> Within twelve months from receipt of the notification, a member state may transmit its objections to the notification, through the IB.

When the USPTO receives a notification from the IB of an IGO name or acronym under Article 6*ter*, the USPTO reviews the notification to determine whether it should object to the notification or enter it into the USPTO search records to assist USPTO examining attorneys in evaluating possible statutory refusals for pending trademark applications. The review of the notification primarily focuses on evaluating whether the notification consists of appropriate subject matter, i.e., whether it was notified by a qualified IGO, whether it consists of a name or acronym of an IGO as outlined by the Paris Convention, or whether it conflicts with an existing mark in the USPTO search records. In these cases, the USPTO notifies WIPO of its objection and has done so routinely.

In sharing experiences relating to Article 6*ter* with other intellectual property offices, the USPTO has noted that some Paris Convention members review notifications that have been transmitted through WIPO's IB and submit objections, while some do not. We have observed that many members do not have a procedure for evaluating whether the notifier or the notified sign falls under the intended subject matter of Article 6*ter*. It is possible that these members are relying on the WIPO IB's preliminary review of each possible notification; however, the treaty does not give WIPO the authority to evaluate whether a notification is eligible to be considered under the treaty. That is a decision to be made, not by WIPO, but by each Paris Convention Member State. In short, the fact of notification and communication cannot be read to mean that the IGO's name and acronym is deemed "protected" or "recognized" under the treaty for purposes of establishing eligibility to use the UDRP/URS, when such notification cannot even be relied upon to mean that the notifier is a qualified IGO under the treaty.

The WG's conclusion that an IGO may meet the "standing" requirement under the UDRP/URS as long as the IGO has completed the communication and notification procedure of Article 6*ter* reflects a misunderstanding of the nature of the treaty and its obligations. The conclusion necessarily assumes that the notification process results in either an international or national right. To reiterate, the notification procedure does not have any legal effect under the terms of the treaty itself and therefore, there is no international right. The notification procedure would only have effect at the national level if a Member elects to give it legal effect under national law. The fact that a member state made no objection to a notification, however, should not be taken to mean that the notified sign is "protected" in that territory; one would have to evaluate national law to determine how the Paris Member implemented the provisions of Article 6*ter*. The United States is unaware of any harmonized approach among WIPO Members in implementation.

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<sup>5</sup> An Article 6*ter* entry on WIPO's website simply means that an IGO has notified its name or acronym to WIPO; it does not indicate that any of the WIPO member states have agreed that the IGO name or acronym has been accepted for Article 6*ter* notification purposes.

Absent any substantive legal right for IGOs under Article 6*ter* at the international level, it is impossible to impute a likelihood of harm to the IGO based solely on the Article 6*ter* notification procedure for purposes of establishing an entitlement to or eligibility for the UDRP/URS.

### **Proposed Expansion of IGO “List”**

The WG’s Initial Report also indicates that, by considering IGOs who have fulfilled the requirements of Article 6*ter* as also fulfilling the “standing” requirement of the UDRP/URS, this means that the range of IGOs that would come within this category would be different from, “and potentially larger than,”<sup>6</sup> the list of IGOs that the GAC has provided. The GAC list was the result of protracted negotiations with the IGOs. Replacing that list with “all IGOs” (that have complied with the requisite communication and notification procedure, as set forth in Recommendation #2) is a game-changer, in that at least some organizations that proclaim themselves to be IGOs in fact are not. The GAC list provides the ICANN community with the security that those on the list are in fact IGOs.

### **Concluding Observations**

There is some suggestion in the WG’s discussions that, even if we cannot agree that Article 6*ter* provides an IGO with a right that is equivalent or similar to trademark rights, their recommended approach is merely allowing an IGO to suspend, cancel or transfer a third-party registration that was registered in bad faith, so recognition under 6*ter* may be sufficient for that purpose. But as these remedies (suspension, cancellation or transfer) are reserved for successful parties with trademark rights, what the WG is proposing is an approach that would convey “rights” by the mere completion of the notification and communication process under Article 6*ter* of the Paris Convention. While we recognize the WG’s considerable effort to identify a way forward for the IGOs, the U.S. cannot support an approach using Article 6*ter* as a basis, and that raises considerably more issues than it is attempting to resolve. The U.S. stands with the GAC and the IGOs in support of the IGO Small Group Proposal, for all of the reasons noted above.

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<sup>6</sup> Initial Report at 11-12.