

FOR WORKING GROUP DISCUSSION ON 30 NOVEMBER 2017: EXCERPTS FROM DRAFT FINAL REPORT RELATING TO PROPOSED FINAL RECOMMENDATIONS 1, 2 & 4

EXCERPT FROM SECTION 1 OF THE DRAFT FINAL REPORT:

1.1 Final Recommendations

The WG Charter specifically directed the WG to examine the following questions: “*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.*” Following its analysis of each of the questions outlined in its Charter, the WG arrived at a set of preliminary recommendations for which it sought community input between January and March 2017. Following its review of all feedback received to its Initial Report, the WG prepared this Final Report, which reflects the group’s consensus recommendations based on the formal consensus call that is required by the GNSO Working Group Guidelines. This Final Report is being submitted to the GNSO Council for its review and action.

Recommendation #1:

The Working Group recommends that no changes to the UDRP and URS be made, and no specific new process be created, for INGOs (including the Red Cross movement and the International Olympic Committee). To the extent that the Policy Guidance document referred to in Recommendation #3A (below) is compiled, the Working Group recommends that this clarification as regards INGOs be included in that document.

Note on Recommendation #1: This recommendation is identical to the original recommendation on this point in the WG’s Initial Report.

Consensus Level: ____

Recommendation #2:

An IGO may elect to fulfil the requirement that a complainant must have standing to file a complaint under the UDRP and URS by demonstrating that it has complied with the requisite communication and notification procedure pursuant to Article 6ter of the Paris Convention for the Protection of Industrial Property¹. The WG believes that this recommendation may be an option in a case where an IGO has certain unregistered rights in its name and/or acronym and must adduce factual evidence to show that it has the requisite substantive legal rights in the name and/or acronym in question. For the avoidance of doubt, the WG emphasizes that:

- (a) this alternative mechanism for standing will not be needed in a situation where an IGO already holds trademark rights in its name and/or acronym, as the IGO would in such a case proceed in the same way as a non-IGO trademark owner;
- (b) whether or not compliance with Article 6ter will be considered determinative of standing is a decision to be made by the UDRP or URS panelist(s) based on the facts of each case; and

¹ The full text of Article 6ter of the Paris Convention can be found here: http://www.wipo.int/article6ter/en/legal_texts/article_6ter.html and in Annex D of this report.

Comment [A1]: This may need to be further detailed, e.g. whether certain recommendations received Full Consensus or Consensus support, whether there are recommendations that did not receive Consensus support and/or that have minority statements (as defined in the GNSO Working Group Guidelines).

(c) this recommendation is not intended to modify or affect any of the existing grounds which UDRP and/or URS panelists have previously found sufficient for IGO standing (e.g. based on statutes and treaties).

Note on Recommendation #2: This recommendation is significantly different from the WG's preliminary recommendation in its Initial Report, where it had recommended that compliance with Article 6ter can, in and of itself, satisfy the standing requirement. For a full discussion of the WG's deliberations on the changes to the original recommendation as a result of community input received, see the discussion at [insert relevant Section/Page].

Consensus Level: _____

Recommendation #4:

In respect of GAC advice concerning access to curative rights processes for IGOs, the Working Group recommends that ICANN investigate the feasibility of providing IGOs and INGOs with access to the UDRP and URS (in line with the recommendations for accompanying Policy Guidance as noted in this report), at no or nominal cost, in accordance with GAC advice on the subject.

Note on Recommendation #4: This recommendation is identical to the original recommendation on this point in the WG's Initial Report.

Consensus Level: _____

EXCERPT FROM SECTION 2 OF THE DRAFT FINAL REPORT:

Text of the Final Recommendations and Relevant Background Information

General

The Charter that was approved by the GNSO Council tasked the WG with examining the following questions: "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."

The WG's preliminary answers to these questions were no². The WG's final conclusions remain substantively the same, although it has developed certain recommendations to accommodate issues specific to IGOs, such as in relation to evidence of standing to file a complaint, and the possible use of an arbitration procedure in the case where an IGO has succeeded in claiming jurisdictional immunity against a respondent that brought a case to court following an initial UDRP or URS decision in the IGO's favor. In essence, the WG has concluded that the specific challenges noted in respect of the access to the UDRP and URS by IGOs and INGOs may be

² As detailed in Section 3.3 of this report (Review of Legal Instruments, Legal Expert Opinion and Other External Source Materials), IGOs and INGOs that have legally protected their names or acronyms can access, and some have already made use of, the UDRP and URS, even in the absence of potential recommendations from this WG.

resolved without the need to modify any of the substantive grounds of the UDRP and URS, or the need to create a specific and separate dispute resolution procedure.

Reasons for these conclusions, and specific recommendations pertaining to specific questions arising within the scope of its Charter, are described below. Fundamentally, the WG believes that the most prudent and advisable approach would be to not recommend any substantive changes to the UDRP or URS at this time, given:

- (1) the ability for an IGO to file a complaint under the UDRP and URS via an assignee, licensee or agent, thereby avoiding any direct concession on the issue of mutual jurisdiction;
- (2) the extremely limited probability of a scenario where an IGO might wish to assert immunity against a losing respondent in a national court, where the respondent files a claim following the IGO's success in the UDRP or URS complaint;
- (3) the WG's recommendation that where an IGO successfully asserts jurisdictional immunity against a losing respondent in a national court the case may be brought to arbitration instead at the registrant's option;
- (4) the importance of recognizing and preserving a registrant's longstanding legal right to bring a case to a court of competent jurisdiction combined with ICANN's questionable authority to deny such judicial access;
- (5) the lack of a single, universally applicable rule in relation to IGO jurisdictional immunity; and
- (6) the fact that, since the WG commenced its work, the GNSO Council has initiated a separate PDP on all the rights protection mechanisms that have been developed by ICANN, including the UDRP and URS, and as such any substantive changes to these curative rights processes need to be considered in a uniform manner in the absence of a clear legal argument or public policy rationale favoring of a piecemeal approach in specific cases.

For INGOs, the WG concluded relatively early on in its deliberations that these organizations have the ability to file (and on many occasions have filed) UDRP and URS complaints by virtue of having national trademark and/or common law rights, and that – unlike IGOs – INGOs stand in the same legal position as other private parties and do not have the additional challenge of wanting to safeguard any possible jurisdictional immunity they may have against a respondent. As a result, the WG came to the conclusion that there is no principled reason to modify the UDRP and/or URS, or create a separate dispute resolution procedure, to address the needs of INGOs (see Recommendation #1 and Section 3 of this report, below, for the rationale).

Recommendation #1:

The WG recommends that no changes to the UDRP and URS be made, and no specific new process be created, for INGOs (including the Red Cross movement and the International Olympic Committee). To the extent that the Policy Guidance document referred to elsewhere in this set of recommendations is compiled, the WG recommends that this clarification as regards INGOs be included in that document.

One of the first topics discussed by the WG was whether or not the specific needs and concerns of IGOs and of INGOs were of a similar nature, and whether such needs and concerns warranted policy changes to the UDRP and URS. The WG's initial conclusion is that the specific needs and concerns of INGOs are adequately

addressed by the current dispute resolution processes (e.g., UDRP and URS) and that there was no principled reason to recommend any modifications to the UDRP or URS, or the creation of a new curative rights process for INGOs.

The following is the WG's rationale for its conclusion that the UDRP and URS do not need to be amended in order to address the needs and concerns of INGOs, and that a new curative rights process applicable to INGOs is not necessary³:

1. Many INGOs already have, and do, enforce their trademark rights. There is no perceivable barrier to other INGOs obtaining trademark rights in their names and/or acronyms and subsequently utilizing those rights as the basis for standing in the existing dispute resolution procedures (DRPs) created and offered by ICANN as a faster and lower cost alternative to litigation. For UDRP and URS purposes they have the same standing as any other private party.
2. Unlike IGOs, who may claim and sometimes be granted jurisdictional immunity in certain circumstances, INGOs have no such claim and are not hindered from submitting to the jurisdiction of national courts under the Mutual Jurisdiction clause within the existing DRPs. The WG's research revealed that some INGOs regularly use the UDRP to protect their rights.
3. Although some INGOs may be concerned about the cost of using the UDRP and the URS, because enforcement through these rights protection mechanisms involves some expenditure of funds, this is not a problem for all INGOs nor is it unique to INGOs as among all rights holders. Furthermore, the issue of ICANN subsidizing INGOs to utilize DRPs is outside the scope of the WG's Charter, and it has no authority to obligate any party (including ICANN) to subsidize the rights protection of another.
4. The WG found that, as of end-2015, the United Nations Economic and Social Council (ECOSOC) list of non-governmental organizations in consultative status consists of nearly 4,000 organizations, of which 147 organizations were in general consultative status, 2,774 in special consultative status, and 979 on the Roster. The WG notes that there might be many more organizations not presently on the ECOSOC list who might claim the right to utilize any new curative rights process created for INGOs. The WG felt that the sheer scale of INGOs, in combination with the factors cited above, weighed against the creation of a special DRP for INGOs, especially as they could not be readily differentiated from other private parties, including other non-profit organizations.

In relation to the Red Cross and the International Olympic Committee, the WG noted that although these INGOs had been specifically highlighted by the GAC as enjoying international legal treaty protections and rights under multiple national laws, for the purposes of this PDP these organizations have demonstrated that: (1) they have ready access to the UDRP and the URS; and (2) they possess strong trademark rights that they vigorously defend and enforce. As such, for the limited purpose of considering INGO access to curative rights protections, the WG determined there was no principled reason to distinguish them from other INGOs. The WG further noted that legal representatives of the International Olympic Committee participated actively in the WG and fully support this conclusion.

³ The rationale described in this Section were also sent to all ICANN Supporting Organizations (SOs), Advisory Committees (ACs) and GNSO Stakeholder Groups and Constituencies as part of the WG's solicitation of input from these groups in December 2014, as required by the GNSO's PDP Manual. As highlighted in Section 3 of this report, no objection to this preliminary conclusion or the rationale was raised by any SO, AC or other ICANN community group.

After reaching its conclusions in regard to INGOs, the WG conveyed them to GNSO Council, which subsequently amended the WG's Charter to remove INGOs from its scope.

Additional Background to this Recommendation

The following two paragraphs are taken substantially from the Final Issue Report that outlined the scope of this PDP, and are provided herein as further background to this issue.

1. As recognized in the Final Issue Report scoping out this PDP, the scope of the UDRP and URS as drafted currently applies only to second level domain name disputes where the complainant has legal rights in a trademark or service mark, and the complaint alleges that the respondent's domain name is identical or confusingly similar to that trademark or service mark. The Final Issue Report had also noted that not all IGOs and INGOs will have trademarks in their names and acronyms, and that during the development of the Applicant Guidebook (AGB) for the New gTLD Program, while certain objection procedures and trademark rights-protection mechanisms had been created, the AGB did not contain any specific rules that pertained exclusively to either preventative (i.e. prevent the harm from occurring by excluding an identifier from registration or delegation) or curative (i.e. an organization that claims to have suffered harm is able to file a dispute to cure the defect or problem) rights protections for IGOs or INGOs related directly to their status as international organizations. Rather, the AGB prescribed that organizations that met the existing criteria for a .int registration could avail themselves of the legal rights objection process, and organizations that owned trademark and other intellectual property rights in their names and/or acronyms could participate in the new Trademark Clearinghouse and the associated sunrise registration and Trademark Claims notice processes⁴
2. The AGB also contained top-level protections for certain Red Cross (RC) and International Olympic Committee (IOC) identifiers, through which these RC and IOC identifiers would be reserved and thus withheld from delegation under the New gTLD Program. Both the RC and IOC are INGOs. Subsequently, interim second-level protections for certain RC and IOC and for a specific list of IGO names and acronyms provided by the GAC were granted in response to advice from the GAC.

It is important to note that the second-level protections noted above were granted on an interim basis to allow new gTLDs to begin launching while policy development and consultations continued on the topic of what would be the appropriate second level protections for Red Cross and International Olympic Committee (IOC) names and acronyms, and IGO acronyms.

The final consensus level achieved for Recommendation #1 following the formal consensus call among the WG is ().

Recommendation #2:

An IGO may elect to fulfil the requirement that a complainant must have standing to file a complaint under the UDRP and URS by demonstrating that it has complied with the requisite communication and notification procedure pursuant to Article 6ter of the Paris Convention for the Protection of Industrial Property⁵. The WG believes that this recommendation may be an option in a case where an IGO has certain unregistered

⁴ See, e.g., page 4 of the Final Issue Report (<https://gns0.icann.org/en/issues/igo-ingo-crp-access-final-25may14-en.pdf>).

⁵ The full text of Article 6ter of the Paris Convention can be found here: http://www.wipo.int/article6ter/en/legal_texts/article_6ter.html and in Annex D of this report.

rights in its name and/or acronym and must adduce factual evidence to show that it has the requisite substantive legal rights in the name and/or acronym in question. For the avoidance of doubt, the WG emphasizes that:

- (a) this alternative ground for standing will not be needed in a situation where an IGO already holds trademark rights in its name and/or acronym, as the IGO would in such a case proceed in the same way as a non-IGO trademark owner would;
- (b) whether or not compliance with Article 6ter will be considered determinative of standing is a decision to be made by the UDRP or URS panelist(s) based on the facts of each case; and
- (c) this recommendation is not intended to modify or affect any of the existing grounds which UDRP and/or URS panelists have previously found sufficient for IGO standing (e.g. based on statutes and treaties).

Under the UDRP and URS, the first substantive element that a complainant must satisfy under both procedures is that the complainant has rights in a trademark or service mark. Most UDRP panelists have read this requirement as a requirement for standing to file a complaint⁶, and it is generally accepted that the threshold may be satisfied by establishing either ownership or exclusive license rights in the trademark or service mark⁷. The WG considered this requirement in the context of IGOs, with particular reference to the protections offered to IGOs under Article 6ter of the Paris Convention for the Protection of Intellectual Property. Initially, the WG concluded that, based on Article 6ter, IGOs which have complied with the communications and notifications procedure described in that treaty provision should be considered to have satisfied the standing requirement of the UDRP and URS. This was the preliminary recommendation in the WG's Initial Report that was published for public comment. However, following its review of comments received that provided additional information on the scope and nature of Article 6ter, the WG concluded that its original recommendation should be amended for the reasons listed below.

Additional Background to this Recommendation:

The WG believes that reliance on Article 6ter for the limited purpose of demonstrating standing will not necessarily result in an increased number of complaints, in view of the other factors to be considered by an IGO prior to filing a complaint (such as the need to submit to the Mutual Jurisdiction clause of the UDRP and URS, which may be interpreted to implicate any jurisdictional immunity an IGO may have) and the other substantive components of the UDRP and URS that will still need to be proven. The WG also believes that these considerations more than offset the likelihood that the number and range of IGOs that may rely on Article 6ter to demonstrate standing will be different from, and potentially larger than, the list of IGOs provided to ICANN by the GAC in 2013 and as may be updated by the GAC from time to time⁸.

From the start, the WG was aware that Article 6ter does not in and of itself confer substantive legal rights, or national trademark rights, on an IGO, although the WG believed that its inclusion in an international treaty nevertheless signaled a desire by States to afford some level of protection against unauthorized third party attempts to register an IGO's name or acronym as a trademark. Thus, and for the limited purpose of standing to file a complaint under the UDRP and URS, the WG originally considered this to be sufficiently analogous to

⁶ See, e.g., Halpern, Nard & Port, "Fundamentals of United States Intellectual Property Law: Copyright, Patent, Trademark" (Kluwer Law International, 2007).

⁷ See the WIPO Overview 2.0 (<http://www.wipo.int/amc/en/domains/search/overview2.0/>).

⁸ The current GAC list of IGOs for which appropriate protection was sought for their names and acronyms was sent to ICANN by the GAC in March 2013. It can be viewed here: <https://www.icann.org/en/news/correspondence/dryden-to-crocker-chalaby-annex2-22mar13-en.pdf>.

the corresponding requirement in the trademark law context that the complainant possess rights in a trademark.

Specific comments were received in response to the WG’s preliminary recommendation on this point, expressing concern that this could have the effect of equalizing a treaty notification procedure to trademark rights when the Article 6ter process does not have any substantive legal effect and is moreover not consistently applied by all States that are obliged to comply. Although several other commentators supported the WG’s initial view, after careful review the WG concluded that the weight of the comments against its preliminary recommendation was more persuasive, especially as the favorable comments generally did not address the specific problems that were noted as a consequence of relying on Article 6ter. The WG also took into account the significant time that was spent at ICANN58 (in March 2017) and ICANN59 (in June 2017) discussing the legal implications and consequences of relying on Article 6ter for standing, where other community participants (including several with relevant legal expertise) expressed serious doubts about the advisability of retaining the original recommendation on standing⁹.

To better assist the community in understanding how the WG came to its initial conclusion, the WG’s previous consideration of Article 6ter has been excerpted from the Initial Report as Annex [] to this Final Report. To view the comments received and discussions that took place over whether and how to modify that preliminary recommendation, please refer to the documents described and links provided in Annex [].

The final consensus level achieved for Recommendation #1 following the formal consensus call among the WG is ().

Recommendation #4: In respect of GAC advice concerning access to curative rights processes for IGOs, the WG recommends that ICANN investigate the feasibility of providing IGOs and INGOs with access to the UDRP and URS (in line with the recommendations for accompanying Policy Guidance as noted in this report), at no or nominal cost, in accordance with GAC advice on the subject.

The WG notes that its Charter does not authorize it to make recommendations that would create a monetary obligation for ICANN or any other party to provide subsidies for particular groups of complainants, or that would otherwise require ICANN to cover the costs (whether in full or substantially) of any particular entity’s filing of a UDRP or URS complaint. Nevertheless, in view of GAC advice on the topic¹⁰, it is within the WG’s Charter scope to recommend that ICANN investigate the feasibility of providing IGOs and INGOs with the ability to file UDRP and URS complaints at no or minimal cost. The WG further notes that it made inquiry of the GAC in regard to whether the existing fee levels for the UDRP and URS were considered “nominal”, but received no clear response on that question.

The final consensus level achieved for Recommendation #1 following the formal consensus call among the WG is ().

⁹ [ADD LINKS TO THE PUBLIC COMMENT REVIEW TOOL, COMMENT FORUM and ICANN58/59/60 SESSIONS]

¹⁰ See, e.g., the GAC’s Los Angeles Communique (October 2014): <https://www.icann.org/en/system/files/correspondence/gac-to-board-15oct14-en.pdf>.