

FOR DISCUSSION: RECOMMENDATIONS & OPTIONS PREPARATORY TO OPENING A FORMAL CONSENSUS CALL FOR THE IGO-INGO CURATIVE RIGHTS WORKING GROUP

Prepared by ICANN staff for the Working Group call of 25 May 2018

RECOMMENDATION DRAFT TEXT AS CIRCULATED	MEMBER SUGGESTIONS	COMMENTS
<p>1. No changes to the UDRP and URS are to be made, and no specific new process created, for INGOs (including the Red Cross movement and the International Olympic Committee).</p>	<p>N.A. (no suggestions received)</p>	<p>Recommendation #1 remains unchanged.</p>
<p>2. The Working Group notes that an IGO may seek to demonstrate that it has the requisite standing to file a complaint under the UDRP or URS by showing that it has complied with the requisite communication and notification procedure in accordance with Article 6ter of the Paris Convention for the Protection of Industrial Property¹. An IGO may consider this to be an option where it does not have trademark rights in its name or acronym (as applicable) but believes it has certain unregistered rights for which it must adduce factual evidence to show that it nevertheless has substantive legal rights in the name and/or acronym in question. In this regard, the Working Group recommends that specific Policy Guidance on this topic be issued by ICANN to clarify the following points:</p> <p>(a) this alternative mechanism for standing is not 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;</p> <p>(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</p>	<p>Edit second sentence to read: “An IGO may consider this to be an option where it does not have registered trademark rights in its name or acronym (as applicable) but believes it has certain unregistered trademark rights for which it must adduce factual evidence to show that it nevertheless has substantive legal rights in the name/acronym in question.” (suggested by George Kirikos, additions highlighted in yellow)</p>	<p>Question for the WG on adding the word “trademark” to say “unregistered trademark rights” as opposed to the original text of “unregistered rights” – will this inadvertently limit or unduly affect the scope of standing (first prong of the UDRP and URS) where this is based on something other than common law trademarks (for example, passing off or unfair competition doctrines where secondary meaning can nevertheless be established)?</p>

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.

<p>(c) the possibility that an IGO may seek to rely on its compliance with Article 6^{ter} to demonstrate standing should not 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).</p>		
<p>3. ICANN Organization shall create and issue Policy Guidance outlining the various procedural filing options available to IGOs, e.g. they have the ability to elect to have a complaint filed under the UDRP and/or URS on their behalf by an assignee, agent or licensee, such that any claim of jurisdictional immunity made by an IGO in respect of a particular jurisdiction will be determined by the applicable laws of that jurisdiction. In addition, ICANN Organization shall ensure that this Policy Guidance document is brought to the notice of the Governmental Advisory Committee (GAC) for its and its members' and observers' information and published along with the procedures and rules applicable to the UDRP and URS on the ICANN website.</p>	<p>N.A. (no suggestions received)</p>	<p>Recommendation #3 remains unchanged.</p>
<p>4. In accordance with GAC advice concerning access to curative rights processes for IGOs, the Working Group recommends that ICANN investigate the feasibility of providing IGOs with access to the UDRP and URS at no or nominal cost to the IGOs.</p>	<p>N.A. (no suggestions received)</p>	<p>Recommendation #4 remains unchanged.</p>

POSSIBLE RECOMMENDATION TEXT FOR WHAT ARE APPARENTLY THE MOST FAVORED OPTIONS ON THE ISSUE OF IGO JURISDICTIONAL IMMUNITY

Note: In the following table, staff has attempted to draft text for the Working Group to discuss in relation to what seems to be the two most favored (of the six) options. **Following the 25 May 2018 meeting the Working Group may choose to put one or both potential recommendations out to the full Working Group for the formal consensus call.** The Working Group may also decide that one or more of the remaining options should be added to the list of potential recommendations for the formal consensus call. Should this be the decision from the 25 May call, staff will draft suggested text for the additional recommendation(s) to be added to the formal consensus call.

Text for Discussion	Staff Notes	WG Discussion/Agreement
<p>In a case where an IGO has prevailed in a UDRP or URS proceeding and the losing registrant proceeds to file suit against the IGO in a national court, the initial UDRP or URS decision shall be set aside (i.e. have no effect) where the IGO succeeds in its claim of jurisdictional immunity against the registrant in the court where the lawsuit was filed.</p>	<p>This text represents Option 1 of the 6 options under consideration.</p> <p>Staff continues to have concerns with this option, as it will mean that resolving a procedural question (immunity from jurisdiction) can automatically reverse a substantive panel finding, where the court has not had (and will not have) the opportunity to hear the case on its merits. This will reverse the current situation where, if a court refuses to hear the case, the original UDRP/URS decision stands.</p>	
<p>Addressing the issue of IGO jurisdictional immunity is likely to require a modification to the UDRP and URS (e.g. in relation to the possibility that some national courts may interpret the current Mutual Jurisdiction clause as a waiver of immunity by an IGO that files a complaint). There may also be other unforeseen consequences of modifying the UDRP and URS that are not within this Working Group’s scope to examine. Given that, since the inception of this Working Group, the GNSO Council has initiated a broader Policy Development Process (PDP) that will review the UDRP and URS in their entirety, the Working Group therefore recommends that the GNSO Council task the Review of All Rights Protection Mechanisms PDP Working Group to examine, as part of its scope of work, the question of IGO jurisdictional immunity</p>	<p>This text represents Option 4.</p>	

and whether any modifications to the UDRP and URS are warranted to address this issue.