

**VIRTUALAW LLC**

**Philip S. Corwin, Founding Principal**  
**1155 F Street, NW Suite 1050**  
**Washington, DC 20004**  
**202-559-8597/Direct**  
**202-559-8750/Fax**  
**202-255-6172/Cell**  
[\*\*psc@vlaw-dc.com\*\*](mailto:psc@vlaw-dc.com)

**April 14, 2014**

**By E-Mail**

Internet Corporation for Assigned Names and Numbers  
12025 Waterfront Drive, Suite 300  
Los Angeles, CA 90094-2536

**Re: Preliminary Issue Report on Access by IGOs and INGOs to the Curative Rights Protections of the UDRP and URS**

Dear ICANN:

I am writing on behalf of the members of the Internet Commerce Association (ICA). ICA is a not-for-profit trade association representing the domain name industry, including domain registrants, domain marketplaces, and direct search providers. Its membership is composed of domain name registrants who invest in domain names (DNs) and develop the associated websites, as well as the companies that serve them. Professional domain name registrants are a major source of the fees that support registrars, registries, and ICANN itself. ICA members own and operate approximately ten percent of all existing Internet domains on behalf of their own domain portfolios as well as those of thousands of customers.

This letter addresses the Preliminary Issue Report on Access by IGOs and INGOs to the Curative Rights Protections of the UDRP and URS published for public comment on March 10, 2014<sup>1</sup>.

ICA commends the members of the ICANN staff who prepared this Preliminary Issue Report. Overall, it impresses us as a comprehensive discussion of a highly complex subject with a long and convoluted history.

**That said, we take strong exception to the Staff Recommendation contained in the Report:**

Staff recommends that the GNSO Council initiate a PDP to explore whether, as a first step, it is desirable to modify the UDRP and URS to enable access to and use of them by IGOs and INGOs whose names and acronyms are protected at the second level; and if so, to develop policy recommendations to guide the necessary amendments. In view of the prior work that was done on developing dispute resolution processes applicable to IGOs, Staff further recommends that in initiating the PDP and creating the PDP Working Group (WG), the GNSO Council direct the WG to take into account the various considerations and suggestions outlined in this Issue Report, in particular, the specific issues described in Sections VIII and the additional considerations listed in Section IX of this Issue Report, including the possibility that instead of amending the UDRP and URS, it may be more appropriate to create a separate, narrowly-tailored dispute resolution procedure at the second level modeled on the UDRP and URS to accommodate the particular needs and specific circumstances of protected IGOs and INGOs.

**ICA believes that the Issue Report, when fully considered, argues strongly against the initiation of a PDP on this subject. We therefore urge that the Staff Recommendation be altered to delete this recommendation and that it be replaced it with one that urges IGOs and INGOs to trademark their names and acronyms and to make use of the existing UDRP and URS arbitration procedures if they believe that their rights therein have been infringed.**

#### Prior ICA Comments on this Matter

On October 11, 2013 we filed a comment on the draft "Final Report on Protection of IGO and INGO Identifiers in All gTLDs"<sup>ii</sup>. In that letter we noted that many acronym domains have substantial market value and are registered by individuals and business that have legitimate rights in them and use them in a non-infringing manner that in no way causes confusion with the activities of an IGO or INGO utilizing the same acronym. Therefore we believe that the continuing quest of some IGOs and INGOs to secure blanket protections for their acronyms and prohibit their use in the domain address system by other parties is without merit and should be dismissed by ICANN.



Our pragmatic suggestions for addressing any legitimate concerns consisted of an approach that would:

- Prohibit registration of the exact full name of any IGO or INGO at the top or second level of any new gTLD.
- Permit registration of those full names in the Trademark Clearinghouse so that the IGO & INGO organizations benefit from the associated benefits of sunset registrations and generation of a Trademark Notice against exact match registration attempts.
- Address the highly unlikely possibility of an attempt to abusively register an IGO or INGO acronym at the top level through a new gTLD application via ICANN's multiple objection processes.
- **Permit IGOs and INGO's to use the UDRP or URS against any second level acronym domain registration where there is purported evidence of bad faith registration and use.**
- Other than permitting a UDRP filing, keep hands off all incumbent gTLDs.

Then, on December 18, 2013, we filed an additional comment letter<sup>iii</sup> addressing the "Protection of IGO and INGO Identifiers in All gTLDs (PDP) Recommendations for Board Consideration". That letter expressed general support for the Resolution on this subject adopted unanimously by the GNSO Council – with the exception of certain recommendations relating to the inclusion of exact matches and acronyms in the Trademark Clearinghouse database. It also expressed gratitude that the GNSO's recommendations did not adopt a hostile position toward acronyms of the encompassed organizations that are registered at the second level of existing gTLDs.

#### Reaction to the Preliminary Issue Report

Our review of the Report convinces us that the information it imparts actually makes a compelling case against initiation of a PDP:

- The PDP may be pointless. The Second WIPO Internet Domain Name Process (WIPO-2) concluded in fall 2001 acknowledged that creating a new and independent administrative procedure similar to the UDRP but solely available to IGOs would involve the creation of new international law through a resolution issued by a competent treaty organ, a memorandum of understanding accepted by national authorities, or a new multilateral treaty. ICANN has no authority to create new law, only a duty to see that its policies and procedures are in accord

with existing relevant law. Indeed, in 2002 an ICANN representative commenting on a WIPO report on this subject noted that "ICANN can only rely on existing international law and, in this respect, takes guidance from the international community, including WIPO. Earlier made observations are correct. ICANN cannot function as a de facto trademark office".<sup>iv</sup> Further, Article 6ter of the Paris Convention does not require states to protect the names and acronyms of IGOs and INGOs if their use does not suggest to the public a connection or authorization by the concerned organization, or if the use is not of a nature to mislead the public in regard to such connection. And the government of the United States has previously adopted the position that the creation of a new dispute resolution process for IGOs is unnecessary and would create rights beyond those established by Article 6ter of the Paris Convention. **Given this history, it is pointless to even consider initiation of a PDP on this subject unless and until it is determined with finality that such an initiative would not exceed ICANN's powers and place it in the position of creating new legal rights rather than considering procedures to address existing rights.**

- A new arbitration procedure tailored to accommodate IGOs would inevitably prejudice the legal rights of domain name registrants. When WIPO's Standing Committee on Trademarks, Industrial Designs and Geographical Indications (SCT) further considered this matter in 2002 it recommended that appeals be handled through de novo binding arbitration in recognition of the unwillingness of some IGOs to submit to national law. However, the ability to appeal to a court of competent jurisdiction has been an invaluable protection of the legal rights of domain name registrants seeking to appeal UDRP decisions, and depriving registrants of this ultimate protection is not an acceptable option.
- A separate arbitration procedure has been opposed by key ICANN constituencies. In 2007 the Registries Constituency opposed a suggestion from the Intellectual Property Constituency favoring creation of a new arbitration procedure for IGOs, stating that the recommendations "are tantamount to asking ICANN to become an "enforcer of treaties", which is not its proper role. The treaties in question are not enforced in every signatory nation in the same way, and a globally uniform enforcement system will impinge on national law to some extent. This is "mission creep" and the establishment of a dangerous precedent." Similarly, in the past the Commercial and Business Users Constituency (CBUC, of which ICA is a member) "questioned the nature and extent of the problem faced by IGOs, given their registrability in the .int domain and the existence of the UDRP for those IGOs holding trademark rights; they also noted that there seemed to be relatively few documented instances of actual bad faith confusion and were concerned that the WIPO-2 recommendations were disproportionate to the problem."



- The PDP would involve so many complex and interacting issues as to be a substantial drain on GNSO Council and staff resources over an extended time period, to the detriment of more important matters having a higher priority. As the Report itself points out, a PDP would involve consideration of at least the following eight matters:
  1. Differences between the UDRP and URS
  2. Relevance of Existing Protections under the AGB for the New gTLD Program
  3. Interplay between this Issue and the Forthcoming Review of the UDRP
  4. The Distinction (If Any) Between IGOs and INGOs for Purposes of this Issue
  5. The Potential Need to Distinguish Between a “Legacy” gTLD and a “New” gTLD Launched Under the New gTLD Program
  6. The Potential Need to Clarify Whether the URS is Consensus Policy Binding on ICANN Contracted
  7. The Need to Address the Issue of the Cost to IGOs and INGOs of Using Curative Processes
  8. The Relevance of the Existence of Legal Protections under International Treaties and/or Multiple National Laws

In addition to those eight discrete issues, the staff further recommends “that in launching the PDP the GNSO Council direct the PDP WG to also work on the following additional topics, in addition to the specific issues outlined in Section VIII above:

- (a) Review the deliberations of the 2003 President’s Joint Working Group on the WIPO-2 recommendations 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;
- (b) 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;
- (c) 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;
- (d) 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;
- (e) Conduct research on applicable international law regarding special privileges and immunities for IGOs;

(f) Conduct research on the number and list of IGOs currently protected under Article 6~~ter~~ of the Paris Convention on Intellectual Property;

(g) 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 DRP applicable only to IGOs and/or INGOs; and

(h) 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 should the GNSO Council decide to launch a PDP to review the UDRP and all the rights protection mechanisms that were developed for the New gTLD Program.”

We would submit that there are simply too many “moving parts” in the contemplated PDP for timely or comprehensible resolution. It would probably take years to fully consider all of them separately and in relation to one another. This PDP would require an inordinate expenditure of GNSO Council and staff time and resources to address an undocumented problem that may not even be amenable to solution through ICANN efforts. And it also may coincide with a comprehensive review of the UDRP that could alter some aspects of that administrative arbitration procedure and thereby require a complete reset of the proposed IGO/INGO PDP.

### Conclusion

**Again, while we commend ICANN staff for a well-researched, objective, and comprehensive treatment of this long-standing and complex dispute, we strongly oppose the Staff Recommendation that a PDP should be initiated.**

**Instead, we urge ICANN to reaffirm its support for the bottom-up, private-sector led, multi-stakeholder policy development process by embracing the unanimously adopted GNSO Council resolution on this matter. IGOs and INGOs that have concerns about potential infringement of their official names and the acronyms thereof can readily file for trademark protection and utilize existing rights protection mechanisms against any second level domain that they believe is infringing their rights; and of course they can also utilize available judicial options. That approach accords them equal protection of their legitimate rights without depriving domain registrants of the full legal protections provided under existing arbitration procedures.**

We appreciate your consideration of our views in this matter.

Sincerely,



Philip S. Corwin

Counsel, Internet Commerce Association

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<sup>i</sup> <http://www.icann.org/en/news/public-comment/igo-ingo-crp-prelim-10mar14-en.htm>

<sup>ii</sup> <http://forum.icann.org/lists/comments-igo-ingo-final-20sep13/msg00009.html>

<sup>iii</sup> <http://forum.icann.org/lists/comments-igo-ingo-recommendations-27nov13/msg00027.html>

<sup>iv</sup> [http://www.wipo.int/edocs/mdocs/sct/en/sct\\_s2/sct\\_s2\\_8.pdf](http://www.wipo.int/edocs/mdocs/sct/en/sct_s2/sct_s2_8.pdf)