

**COMMON POSITION PAPER
REGARDING PROTECTION OF IGO NAMES AND ACRONYMS IN THE DNS
IN THE CONTEXT OF ICANN'S GTLD EXPANSION PLAN¹**

International Intergovernmental Organizations (IGOs) are subjects of international law, as is the case for States. IGOs are established by treaty, signed and ratified by sovereign States and are conferred international legal personality. IGOs play a vital role in public international law. They are created in order to achieve objectives that their Member States cannot fulfil individually, in the interest of the international community at large.

IGOs are fora that work towards cooperation between governments on vital issues and humanitarian causes, including public health, food security, labor practices, peace-keeping operations, containment of weapons proliferation, sustainable economic and social development and reconstruction, trade and commerce standards, children's rights, refugees, disaster relief, fundamental scientific research and transportation. IGOs also provide the forum for States to improve international relations, to find solutions to conflicts and to create international law, notably by providing the medium for negotiation of international agreements (treaties). Moreover, they provide important and accurate data, analysis and advice to States, their instrumentalities and to the public.

Protection of the reputation of IGOs and their credibility as sources of information and policy, are critical requirements for their functioning. As the GAC represents the governments of their Member States, these should be fundamental concerns for the GAC.

IGOs are funded essentially with public funds, through contributions to their budgets from their member States. Given this source of financing, it is particularly important that IGO funds be used efficiently and with transparency, primarily on achieving the important public interest missions of the Organizations.

The unique international legal protections which have been accorded to IGOs so as to permit their proper functioning, obviate the need to divert public funds from their missions to protect their names and acronyms as trademarks. These protections should also obviate the need for diverting inordinate amounts of such public funds towards registering and maintaining gTLDs (estimated to run to approximately USD 500,000) for solely defensive reasons or towards resource intensive and uncertain, curative mechanisms such as the legal rights protection. More generally, IGOs should not have to expend considerable resources towards monitoring/policing the Internet, defensive registrations and combating cybersquatters and fraudulent activities using their names and acronyms.

Until now, the number of available gTLDs has been limited, so the problems faced by IGOs from the misuse of their names and acronyms have been contained to the second level. With the

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future expansion, not only will the gTLD possibilities be unlimited, but this will also exponentially increase the domain name possibilities at the second level.

For these reasons, we consider it essential that the GAC, as the ICANN body charged with representing the interests of governments of States, and by extension the interests of the IGOs of which they are members, propose to the ICANN Board appropriate policy measures calculated to mitigate these potential threats and harms. Those measures should consist of the exclusion from third party registration of the names and acronyms of IGOs both at the top and second levels and in all rounds of gTLD applications.

In her letter dated 12 April 2012 to the ICANN Board, the Chair of the GAC expressed the position that the GAC would consider formulating advice regarding enhanced protection for IGO names and acronyms in the event that they meet the criteria of a two-tiered protection test, consisting of protection at both the international level through international treaties and through national laws in multiple jurisdictions. Notwithstanding the fact that the international treaties referred to above would already constitute a sufficient degree of protection in most jurisdictions², the names and acronyms of IGOs, including but not limited to those mentioned in the first footnote, meet this test, as established below and in the annex to the present position paper.

International law protection

By virtue of the special status and functions of IGOs, their names and acronyms are protected at the international level within the scope of Article 6*ter* of the Paris Convention for the Protection of Industrial Property, with 174 contracting parties, as further extended by Article 16 of the Trademark Law Treaty and Article 2 of the WTO Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS)³. Currently, the Paris Convention is in force in 180 States and the European Union.

It is noteworthy that, other than States, the only names to enjoy treaty protection are those of IGOs, as well as the terms “Red Cross” and “Geneva Cross” (under the Geneva Convention).

Clearly, the Internet was not a consideration at the time of the drafting of the Paris Convention, but the principles enacted by this treaty and the reasons for protection provided by the Paris Convention for States (also protected under Article 6*ter*) and IGOs for the physical world are just as valid, if not more so, for the boundless DNS. Special protections have been provided for

² In what pertains to the process of incorporation of international law, this varies depending on whether States follow the so-called “monist” system of incorporation (i.e., ratified international treaties directly become domestic law) or the “dualist” system whereby States require a more detailed process for treaties to be formally incorporated into their own national legal systems (for instance, through the enactment of specific federal legislation) before they can have domestic legal effects.

³ Article 6 *ter*(1)(b) of the Paris Convention reads: “*The provisions of subparagraph (a) above [regarding the protection of States], shall apply equally to armorial bearings, flags, other emblems, abbreviations, and names, of international intergovernmental organizations of which one or more countries of the Union are members, with the exception of armorial bearings, flags, other emblems, abbreviations, and names, that are already the subject of international agreements in force, intended to ensure their protection.*” The text of the Paris Convention may be consulted at <http://www.wipo.int/treaties/en/ip/paris>; the text of the Trademark Law Treaty at <http://www.wipo.int/treaties/en/ip/tlt>; the text of TRIPS at http://www.wto.org/english/docs_e/legal_e/27-trips.pdf.

names of States in the DNS. As IGOs are subjects of international law like States, they merit the same protections.

National law protection

A treaty is an international agreement concluded between States in written form, creating binding obligations for States, which must be performed in good faith. International law provides that the States cannot invoke the legal procedures of their domestic system as a justification for not complying with international rules set by the treaty (Article 27 of the Vienna Convention on the Law of Treaties).

Article 25 of the Paris Convention, states that:

“(1) Any country party to this Convention undertakes to adopt, in accordance with its constitution, the measures necessary to ensure the application of this Convention.

(2) It is understood that, at the time a country deposits its instrument of ratification or accession, it will be in a position under its domestic law to give effect to the provisions of this Convention.”

This may, but not necessarily, be done through the enactment of specific legislation.⁴ Indeed, since in many jurisdictions the force of the treaty provisions is the same as if they were written in national law, this alone would justify that the second tier of GAC’s criteria be considered to be met.

Furthermore, many States have enacted legislation protecting the names and acronyms of IGOs. In fact the overwhelming majority of jurisdictions in the world have enacted such legislation, thus providing additional support to meeting the second set of criteria devised by the GAC.

The attached Annex provides a non-exhaustive table setting out the protections granted to IGOs under treaties and national legislations.

Proposal

The following is a proposal for the exclusion of the IGO names and acronyms from registration by third parties in the DNS.

Top level

At the top level, the Applicant Guidebook should be amended so that IGO names and acronyms protected under Article 6ter of the Paris Convention, as included in the “6ter Express” database maintained by the International Bureau of World Intellectual Property Organization (WIPO), be treated as “Reserved Names”. The “6ter Express” database contains all IGO names and acronyms which have been duly communicated in accordance with the Paris Convention⁵. It is fully accessible and searchable online at <http://www.wipo.int/ipdl/en/6ter>, and is free of charge.

⁴ See footnote 2 above.

⁵ The protection of names, acronyms and emblems of intergovernmental organisations under Article 6ter is subject to communication to States party to the Paris Convention and the WTO TRIPS Agreement – through the intermediary of the WIPO International Bureau – of the names, acronyms and emblems for which protection is sought. This communication is made electronically twice a year.

Updated versions of the database are also being made available on CD-ROM, and can be ordered from WIPO.

This may be done by introducing a new category of Reserved Names in section 2.2.1.2 of the Applicant Guidebook (*Reserved Names and Other Unavailable Strings*), by means of a new section 2.2.1.2.4 as follows:

“The names and acronyms of intergovernmental organizations protected under article 6ter of the Paris Convention for the Protection of Industrial Property, as included in the World Intellectual Property Organization “6ter Express” database will be treated as IGO Reserved Names.

The IGO Reserved Names will be available exclusively to the respective intergovernmental organizations.

If any applied-for gTLD string identically matches any of the names or acronyms contained in the WIPO “6ter Express” database, it cannot be registered by anyone other than the respective intergovernmental organization.

In addition, applied-for gTLD strings will be reviewed during the String Similarity review to determine whether they are similar to these IGO Reserved Names. An application for a gTLD string that is too similar to an IGO Reserved Name will not pass this review.

The applicant may attempt to override a string similarity failure by either (i) seeking a letter of non-objection from the respective intergovernmental organization; or (ii) demonstrating that the applicant has a legitimate interest in the string, that the new TLD is not confusingly similar to one of the protected strings and that it does not refer to the intergovernmental organization or the intergovernmental organization’s activity. A determination in favor of the applicant will not preclude the respective intergovernmental organization from bringing a legal rights objection or otherwise contesting the determination.”

Second Level

The permanent protection at the top level should be complemented through the amendment of the new gTLD Registry Agreement, so that IGO names and acronyms included in the “6ter Express” database be treated as names reserved at the second level.

This may be done by introducing a paragraph 6 in “Specification 5-Schedule of reserved names at the second level in GTLD Registries” (page 285 of the Applicant Guidebook) as follows: “The names and acronyms of intergovernmental organizations protected under article 6ter of the Paris Convention for the Protection of Industrial Property, as included in the World Intellectual Property Organization “6ter Express” database will be treated as Reserved Names and can only be registered by the respective intergovernmental organization”.

Reserved Names are treated as “forbidden names”. This means that any registrar receiving a request of registration of a second-level domain would have an automatic system by which the

request for registration of any denomination from the *6ter* Express database would raise a red flag, requiring the registry to automatically prevent their registration by third parties.

Conclusion

The expansion of gTLDs will likely exacerbate the already existing problems faced by IGOs with regard to the misuse of their identities in the DNS and potentially give rise to new ones. This will bring further harm to the important international public interest causes represented by IGOs and a significant waste of public funds, unless steps are taken ahead of time to protect IGO names and acronyms, by excluding them from the possibility of third party registration at both the top and second levels. Given the apparently high number of first round gTLD applications, for such exclusion to be meaningful, it should also cover the first application round. There is ample opportunity to implement such exclusions given the length of the examination process, which is yet to begin.

It must be emphasized also that, while this common position paper includes the specific proposal outlined above, IGOs would consider alternative ways to effectively address the issues raised herein.

The IGOs supporting this position paper are convinced, thus, that finding an appropriate solution is extremely important to maintaining the credibility of GAC's policy advice on issues of international concern and are ready to enter into a direct dialogue with GAC.