



Intellectual Property Constituency Comments
on the Initial Report of the GNSO IGO-INGO Access to Curative Rights Protection
Mechanisms Policy Development Process Working Group

The Intellectual Property Constituency (IPC) of the Generic Names Supporting Organization (GNSO) welcomes the opportunity to comment on the Initial Report of the GNSO International Governmental Organizations (“IGOs”) and International Non-Governmental Organizations (“INGOs”) Access to Curative Rights Protection Mechanisms Policy Development Process Working Group (the “Initial Report”).

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 elsewhere in this set of recommendations is compiled, the Working Group recommends that this clarification as regards INGOs be included in that document".

IPC supports the first sentence of Recommendation #1. As seen from the Initial Report, and also noted from IPC members participating in the Working Group (“WG”) who have represented INGOs in domain name disputes, the current dispute resolution policies are already useful and functional for INGOs without any need of changes.

IPC does not support the second sentence of Recommendation #1. As discussed below, IPC does not support preparing and issuing a “Policy Guidance” document.

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 6ter 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."

IPC does not support Recommendation #2.

First, IPC does not support using 6ter notifications as an independent basis for standing under the UDRP or URS. The mere notification to WIPO that an entity is

claiming *6ter* rights does not provide a sufficient basis for standing to bring a claim.¹ It might be possible to consider whether (a) a *6ter* notification has been actively accepted by any national trademark office and (b) conversely, whether a *6ter* notification has been rejected by any national trademark office, in considering whether to allow standing. However, this seems both complex and uncertain.

On the other hand, the list assembled by the GAC has even more tenuous claims as a legal basis for standing. While the list was the subject of extensive discussions between the GAC and IGOs, and was considered in the GAC/IGO “small group,” it is far from clear what method, if any, was used for determining that an IGO had sufficient rights in its name to convey standing and be admitted to the list.

There is a simpler solution to be found in the current UDRP – the ability to assert common law or unregistered trademark rights. As noted in WIPO Overview 2.0²:

The complainant must show that the name has become a distinctive identifier associated with the complainant or its goods or services. Relevant evidence of such "secondary meaning" includes length and amount of sales under the trademark, the nature and extent of advertising, consumer surveys and media recognition. The fact that the secondary meaning may only exist in a small geographical area does not limit the complainant's rights in a common law trademark. For a number of reasons, including the nature of the Internet, the availability of trademark-like protection under passing-off laws, and considerations of parity, unregistered rights can arise for the purposes of the UDRP even when the complainant is based in a civil law jurisdiction. However, a conclusory allegation of common law or unregistered rights (even if undisputed) would not normally suffice; specific assertions of relevant use of the claimed mark supported by evidence as appropriate would be required. Some panels have also noted that in cases involving claimed common law or unregistered trademarks that are comprised of descriptive or dictionary words, and therefore not inherently distinctive, there may be a greater onus on the complainant to present compelling evidence of secondary meaning or distinctiveness. Some panels have noted that the more obvious the viability of a complainant's claim to common law or unregistered trademark rights, the less onus there tends to be on that complainant to present the panel with extensive supporting evidence. However, unless such status is objectively clear, panels will be unlikely to take bald claims of trademark fame for granted.

Given the difference in activities between an IGO and a typical commercial entity, some changes would need to be made in these standards (e.g., “length and amount of sales” would need to be translated into an appropriate measurement for the activities of an IGO). Overall, however, giving each IGO the opportunity to demonstrate a legal basis for its rights is far preferable to bootstrapping either the *6ter* list or the GAC list (unless the GAC used a demonstrated and transparent methodology for determining whether each IGO name had “secondary meaning or distinctiveness.”) This provides further support for creating a parallel and slight modified IGO-DRP, as discussed below, rather than amending the UDRP and URS.

¹ See, e.g., 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. <https://forum.icann.org/lists/comments-igo-ingo-crp-access-initial-20jan17/msg00013.html>

² WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition <http://www.wipo.int/amc/en/domains/search/overview2.0/#17>

Second the IPC continues to support the creation of an “IGO-DRP” (and potentially, IGO-URS). In May 2014, IPC provided comments on the “Preliminary Issue Report on IGO-INGO Access to the UDRP & URS.”³ At that time, there were only two alternative solutions presented: to amend the UDRP and URS to allow access to and use of these mechanisms by IGOs and INGOs, or develop a separate, narrowly-tailored dispute resolution procedure at the second level modeled on the UDRP and URS that would take into account the particular needs and specific circumstances of IGOs and INGOs.

Based on those two options, IPC's opinion was that there are “several distinct reasons for creating a separate, UDRP-like dispute resolution mechanism for IGOs rather than modifying the current UDRP to take into account the specific characteristics and limitations faced by IGOs in attempting to utilize the UDRP.” IPC further stated that the “new” policy or policies would be modified versions of the existing UDRP and URS, minimally adjusted and narrowly tailored to accommodate use by IGOs and/or INGOs, and to account for the special circumstances of those categories of organizations. “Thus, IPC does not recommend major changes to the basic elements of a UDRP or URS claim in any new policy.”

IPC is still of the position that there is no need for changing/modifying the current UDRP or URS in order to make it possible for IGO's to use these dispute resolution procedures.

Instead, the IPC continues to support the creation of a separate, narrowly-tailored UDRP or URS-like process solely for IGOs to protect their identifiers. Such a mechanism would likely only need a few key amendments to the UDRP/URS to accommodate appropriate access by IGOs, namely:

1. Removal of the “mutual jurisdiction” clause as to not prejudice arguments regarding IGO sovereign immunity;
2. Explicitly permitting appeals of the decision to any court of competent jurisdiction, e.g., on an *in rem* basis where the domain name is located (via the registry or registrar) and/or specifying that appeals must be made to an arbitrator (e.g., any ICC arbitrator, not a special panel) rather than a court (in order to preserve IGO immunity, since IGOs should not be forced to choose between waiving immunity and defending their UDRP/URS victory); and
3. While Article 6*ter* of the Paris Convention cannot by itself confer standing, a 6*ter* notification could be considered as an element in evidencing common law trademark rights in the IGO identifier(s) at issue sufficient to afford standing to the IGO under the first element of the mechanism (parallel to element one of the UDRP under which the complainant must demonstrate rights in the trademark). Of course, an IGO would still be able to use any actual trademark registrations it might have to satisfy this element, or it could rely on other evidence of secondary meaning or distinctiveness.

³ <https://ipc.memberclicks.net/assets/ipc-position-papers/2014/IPC+Comments+on+Preliminary+Issue+Report+on+Access+by+IGOs+and+INGOs+to+the+Curative+Rights+Protections+of+the+UDRP+and+URS.pdf>

Pursuing this preferable approach, the IPC believes that no “Policy Guidance” document would be warranted. Indeed, such a document appears aimed at making inappropriate back-door modifications to the existing UDRP and URS. We reject this approach.

The IPC is also concerned that the WG’s treatment of *6ter* notifications seems designed to cause UDRP or URS filings by IGOs to fail. The Initial Report, at p. 14, states:

There does not appear to be any procedure by which any publication may be investigated, examined, or challenged. In this regard the inclusion within the database bears similarity to registrations in jurisdictions that do not subject trademark registrations to an investigatory process. The WG notes that UDRP panels have typically found trademark registrations that are automatic or unexamined (such as United States (US) state registrations as opposed to US federal registrations) are not owed the same deference under the UDRP as examined registrations. By stating its position above regarding the acceptance of Article *6ter* notification as conferring standing under the UDRP, the WG is not intending to alter existing UDRP jurisprudence or suggest that the pre-existing standards used by UDRP panelists with regard to the recognition of trademarks obtained via an automated or unexamined process be altered in any manner.

Put more bluntly, the WG is recommending that UDRP or URS cases using *6ter* notifications give less “deference” to the IGO’s rights than in the typical UDRP or URS case. This “less deference” recommendation would handicap IGO UDRP cases at their very start. This may well be appropriate, given the limited value that *6ter* notifications have. However, this should provide a reason to reject using *6ter* notifications as the basis for a UDRP or URS filing, rather than providing a “second class” basis for UDRP and URS filings.

The IPC also notes that the Initial Report does not accurately summarize the discussion in WIPO Overview 2.0 on which it relies for the statement that “UDRP panels have typically found trademark registrations that are automatic or unexamined ... are not owed the same deference under the UDRP as examined registrations.” WIPO Overview 2.0 states this has only happened where “In certain, highly limited circumstances, some panels have opted to examine the circumstances of trademark registration in considering whether the registration satisfies UDRP requirements.” As such, the “less deference” findings are typical only in these “certain, highly limited circumstances” and not typical of all cases. Notably, the WIPO Overview 2.0 does not indicate that panelists should “opt to examine the circumstances” of registration. In contrast, the Initial Report is clearly laying the groundwork for UDRP/URS panelists handling IGO cases to opt to examine the circumstances of *6ter* notification and to then find such notifications wanting. This may please those who would like to see Complainants succeed less often in UDRP and URS cases, but it seems unfortunate to create a new form of “standing” only to immediately handicap it.

Recommendation #3:

"The WG does not recommend any specific changes to the substantive grounds under the UDRP or URS upon which a complainant may file and succeed on a claim against a respondent (e.g. as listed in Section 4(a)(i) – (iii) of the UDRP). However,

the WG proposes that the Policy Guidance document referred to in Recommendation #2 includes a further recommendation that UDRP and URS panelists should take into account the limitation enshrined in Article 6ter (1)(c) of the Paris Convention in determining whether a registrant against whom an IGO has filed a complaint registered and used the domain name in bad faith."

IPC does not support Recommendation #3.

First, in view of the above suggestion that the Working Group reconsider developing a separate DRP solely for use by IGOs, Recommendation #3 would be rendered unnecessary, given that UDRP and URS panelists would have separate guidelines for regular UDRP and URS cases and for cases involving IGOs under the envisaged separate mechanism. Again, pursuing this preferable approach, no "Policy Guidance" would be needed, and we reject pursuing such a document, which appears aimed at making inappropriate back-door modifications to the existing UDRP and URS.

The IPC is also concerned by the suggestion that the "limitation enshrined in Article 6ter (1)(c)"⁴ should be imported into UDRP/URS jurisprudence. This would introduce an additional hurdle for IGO Complainants not currently found in UDRP/URS cases. Not only does this appear to be yet another instance where the Initial Report has created a UDRP that is "designed to fail," this would open the door to importing this limitation into UDRP/URS cases that do not involve IGOs. While the Initial Report claims that the "WG does not recommend any specific changes to the substantive grounds under the UDRP or URS," importing the 6ter (1)(c) limitation is virtually indistinguishable from "changes to the substantive grounds." Any changes to the elements of a UDRP/URS case should be approached with extreme caution. However, it may be appropriate to consider this limitation in a separate IGO DRP process, but only where the IGO has chosen to introduce its 6ter notification as proof of its rights in its name.

Recommendation #4:

"In relation to the issue of jurisdictional immunity, which IGOs (but not INGOs) may claim successfully in certain circumstances, the WG recommends that: (a) no change be made to the Mutual Jurisdiction clause of the UDRP and URS; (b) the Policy Guidance document ... also include a section that outlines the various procedural filing options available to IGOs, ... (c) claims of jurisdictional immunity made by an IGO in respect of a particular jurisdiction will be determined by the applicable laws of that jurisdiction. Where an IGO succeeds in asserting its claim of jurisdictional immunity in a court of mutual jurisdiction, the Working Group recommends that in that case: Option 1 – the decision rendered against the registrant in the predecessor UDRP or URS shall be vitiated; or Option 2 – the decision rendered against the registrant in the predecessor UDRP or URS may be brought before the [name of arbitration entity] for de novo review and determination."

⁴ "The countries of the Union shall not be required to apply the said provisions when the use or registration referred to in subparagraph (a), above, is not of such a nature as to suggest to the public that a connection exists between the organization concerned and the armorial bearings, flags, emblems, abbreviations, and names, or if such use or registration is probably not of such a nature as to mislead the public as to the existence of a connection between the user and the organization."

IPC does not support Recommendation #4. Specifically, the IPC does not support maintaining the “Mutual Jurisdiction” clause with regard to IGO cases, nor does IPC support the creation of a “Policy Guidance” document. The IPC does support (c): “claims of jurisdictional immunity ... will be determined by the applicable laws of that jurisdiction.”

However, by revisiting the option to prepare a separate DRP applicable to IGOs, Recommendation #4 would be rendered unnecessary, as the language of the separate IGO DRP would intentionally omit any “mutual jurisdiction” clause as found in the UDRP/URS. The separate IGO DRP could include explicit instructions that any decisions under the DRP would be appealable to any court of competent jurisdiction on an *in rem* basis where the domain name is located (via the registry or registrar). IGOs would then be free to enter a special appearance arguing sovereign immunity without having prejudiced such arguments by agreeing to mutual jurisdiction in the first instance. The IGO DRP could be appealable to an arbitration entity as suggested in Option 2. Either way, there needs to be a mechanism that does not require an IGO to choose between initiating a claim and preserving immunity.

Again, by pursuing this solution, there would be no need to create a separate Policy Guidance document.

As to the two options in Recommendation #4, Option 1 seems harsh and draconian, and puts an IGO complainant in an appeal in an untenable position. On the other hand, it offers a “free pass” to the losing respondent.

Option 2 is consistent with the general practice for appeals of UDRP cases, as registrants on the losing side of a UDRP are entitled to a *de novo* review upon appeal, except that the appeal goes to an arbitrator rather than a court. IPC especially supports and notes the importance that the arbitration entity handles such case for *de novo review and determination*. Option 2 is easily transferrable to an IGO-DRP as recommended by IPC.

Recommendation #5:

"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."

IPC supports Recommendation #5 in principle (or rather, IPC supports “investigating the feasibility of” no or low cost access to our suggested IGO-DRP rather than the UDRP or URS) but would want assurance that any costs are not passed on to other stakeholders. We wish also point to the fact that the costs for using URS or UDRP (or, presumably, the IGO DRP) are already lower than traditional civil court actions. Finally, it should be clear that this refers only to filing fees, and not to any other costs in bringing an action (and not to any costs on appeal).

Respectfully submitted,

Intellectual Property Constituency