



FÉDÉRATION INTERNATIONALE DES CONSEILS
EN PROPRIÉTÉ INTELLECTUELLE

INTERNATIONAL FEDERATION OF
INTELLECTUAL PROPERTY ATTORNEYS

INTERNATIONALE FÖDERATION
VON PATENTANWÄLTEN

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Policy Development Process Working Group
ICANN

Via email: comments-igo-ingo-crp-access-initial-20jan17@icann.org

RE \\\ FICPI Comments on the Initial Report of the GNSO IGO-INGO
Access to Curative Rights Protection Mechanisms
Policy Development Process Working Group

Dear Sirs,

FICPI, the International Federation of Intellectual Property Attorneys, broadly representative of the free profession of more than 86 countries/regions world-wide, herewith gratefully accepts the opportunity to submit comments on the Initial Report.

The attached comments are respectfully submitted.

Yours faithfully,

Roberto Pistolesi
Secretary General

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28 February 2017

Founded over 100 years ago, **FICPI** is the international representative association for IP attorneys in private practice throughout the world, with about 5,500 members in 86 countries and regions, including Europe, China, Japan, South Korea and USA.

FICPI aims to enhance international cooperation amongst IP attorneys and promote the training and continuing education of its members and others interested in IP.

FICPI strives to offer well balanced opinions on proposed international, regional and national legislation based on its members' experience with a great diversity of clients having a wide range of different levels of knowledge, experience and business needs of the IP system.

FICPI is pleased to have an opportunity to submit comments on the Initial Report of the GNSO Protected International Governmental Organizations and International Non-Governmental Organizations Access to Curative Rights Protection Mechanisms Policy Development Process Working Group.

INITIAL COMMENTS

FICPI notes that curative rights for International Intergovernmental Organizations (IGOs) is a topic that has been under discussion for many years, with no clear result thus far.

As early as April 23, 2001 FICPI participated in WIPO's regional consultation meeting, held in Brussels, Belgium, which resulted in the WIPO2 RFC-3 (The Interim Report of the Second WIPO Internet Domain Name Process). In respect of IGO's top level domains (TLDs), the report (para 111) considered three options:

- a) The status quo – protection under the TLD .int, reserved for treaty organizations
- b) The establishment of an exclusion mechanism in some or all of the gTLDs for the exact name of the IGO, or for the names and acronyms
- c) The modification of the Uniform Domain Name Dispute Resolution Policy (UDRP) to extend it to names/acronyms of IGOs.

In its Initial Report, the Working Group (WG) has concluded that option c) from 2001, or at least a variant of option c), is the best solution.

Generally, FICPI supports the Working Group's suggestion to use the existing dispute resolution procedures to the extent possible to resolve the concerns of INGOs and IGOs. It is considered best to



avoid changes to the Uniform Rapid Suspension System (URS) and/or UDRP, other than for clarification purposes in respect of, for example, administrative or information issues.

COMMENTS TO THE SPECIFIC RECOMMENDATIONS IN THE 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".

FICPI supports Recommendation No 1.

In concordance with the Initial Report, and as confirmed through the experiences of FICPI members, including those who have represented INGOs involved in domain name disputes, the current dispute resolution policies are effective and there is therefore no need for change.

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 Property¹. 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 panellists, registrants and IGOs".

FICPI support Recommendation No 2.

As noted by the WG, under both the URS and the UDRP, the threshold substantive element that a complainant must satisfy under these procedures is that the complainant must hold rights in a trademark or service mark. Although Article 6ter of the Paris Convention does not cover trademark rights, but rather "state emblems, official hallmarks, and emblems of Intergovernmental Organizations", the protection is similar to the identification of trademark rights when it comes to Paragraph 4 a (i) of the UDRP, as well as Article 1.2.6.1. of the URS. Article 6ter also has more international legal effect than does a list of IGO references or identifications provided by GAC or other ICANN related interest groups.

FICPI notes that once an IGO's rights are identified according to Article 6ter, the IGO/Complainant must also provide arguments and evidence to show that the domain name holder has no rights or legitimate interests in respect of the domain name and that the domain name has been registered and is being used in bad faith.

Again, referring to Article 6ter 1(c), "the countries of the Union shall not be required to apply the said provisions when the use or registration referred to in subparagraph (a)... 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". This is comparable to Paragraph 4 a (ii) and (iii) of the UDRP, as well as Articles 1.2.6.2. and 1.2.6.3. of the URS, referring to the fact that a domain name holder may have rights/legitimate interests in a disputed domain name, and may also have registered and is using the disputed domain name in good faith.

In summary, once the right either as trademarks or as an Article 6^{ter} name is identified, the complainant still has to demonstrate that the domain name holder has no legitimate interests and has registered and is using the disputed domain name in bad faith.

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 panellists should take into account the limitation enshrined in Article 6^{ter}(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."

FICPI support Recommendation No 3.

FICPI further notes that both the URS and the UDRP have Rules and Supplemental Rules wherein references to rights of IGO under Article 6^{ter} can be included without changing current policies. WIPO also provides "a Model Complaint and Filing Guidelines" for UDRP cases, wherein a further clarification related to IGO protection can easily be made, again without revising the policies.

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."

FICPI support the recommendation that no changes shall be made to the Mutual Jurisdiction clause of the UDRP and URS.



FICPI further support the recommendation that the Policy Guidance document also include a section that outlines the various procedural filing options available to IGOs, especially as these will be the same as already exist for traditional trademark owners using these dispute resolution procedures.

FICPI notes from the Working Group report (especially from Professor Swaine's legal conclusion in relation to an IGO's jurisdictional immunity) that there is no international clear praxis, and that claims of jurisdictional immunity made by an IGO in respect of a particular jurisdiction will have to be determined by the applicable laws of that jurisdiction. FICPI therefore also support the Working Group's conclusion on this topic.

As to the two options related to cases where an IGO succeeds in asserting its claim of jurisdictional immunity in a court of mutual jurisdiction, FICPI notes that Option 1 seems to correspond more closely to traditional trademark/domain name disputes, and is therefore also likely to be both more practical and more accepted by domain holders, registrars and other groups involved in domain name registration and administration.

However, Option 2 may be more acceptable from the perspective of IGO's, as the final decision will not be restricted to a specific national court but will still be handled in a neutral / international way.

FICPI therefore recommends the Working Group should reach out to GAC and representatives of IGO's to obtain their view on relative merits of the two options. If a majority of active GAC members prefer Option 2, FICPI recommends the Working Group accept that solution in its Final Report.

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."

FICPI support Recommendation No 5.



IMPORTANT NOTE:

The views set forth in this paper have been provisionally approved by the Bureau of FICPI and are subject to final approval by the Executive Committee (ExCo). The content of the paper may therefore change following review by the ExCo.

The International Federation of Intellectual Property Attorneys (FICPI) is the global representative body for intellectual property attorneys in private practice. FICPI's opinions are based on its members' experiences with a great diversity of clients having a wide range of different levels of knowledge, experience and business needs of the IP system.

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The Australian Federation of Intellectual Property Attorneys, FICPI Canada, Association of Danish Intellectual Property Attorneys (ADIPA), Suomen Patenttiasiamiesyhdistys ry, Association de Conseils en Propriété Industrielle (ACPI), Patentanwaltskammer, Collegio Italiano dei Consulenti in Proprietà Industriale, Japanese Association of FICPI, Norske Patentingeniører Forening (NPF), Associação Portuguesa dos Consultores em Propriedade Industrial (ACPI), F.I.C.P.I South Africa, the International Federation of Intellectual Property Attorneys – Swedish Association, Verband Schweizerischer Patent und Markenanwälte (VSP) and the British Association of the International Federation of Intellectual Property Attorneys are members of FICPI.

FICPI has national sections in Argentina, Austria, Belgium, Brazil, Chile, China, Colombia, Czech Republic, Greece, Hungary, India, Ireland, Israel, Malaysia, Mexico, Netherlands, New Zealand, Peru, Romania, Russia, Singapore, South Korea, Spain, Turkey and the United States of America, a provisional national section in Poland and individual members in a further 41 countries and regions.

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