

DRAFT SECTION 6 OF THE WORKING GROUP INITIAL REPORT – 5 SEPTEMBER 2016

The following preliminary recommendations are being published by the Working Group for public comments. All input received will be reviewed by the Working Group, and if appropriate, incorporated into the Working Group's Final Report. This review process may result in amendments or updates to the preliminary recommendations contained in this Initial Report.

[Several open questions on which the Working Group has yet to reach preliminary agreement or for which the Working Group would like to seek community input prior to finalizing its recommendations on those topics are also listed in this Section.][MW1]

General

The Charter for the Working Group tasked the Working Group to examine the questions: "whether to amend the UDRP and URS to allow access to and use of these mechanisms by IGOs and INGOs and, if so in what respects or whether a separate, narrowly-tailored dispute resolution procedure at the second level modeled on the UDRP and URS that takes into account the particular needs and specific circumstances of IGOs and INGOs should be developed."

The Working Group's preliminary answers to these questions are no. Reasons for these conclusions, and specific Working Group recommendations pertaining to specific questions arising within the scope of its Charter, are described below.

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.

One of the first topics discussed by the Working Group was whether or not the specific needs and concerns of IGOs and of INGOs were of a similar nature, and in either case whether such needs and concerns warranted policy changes to the UDRP and URS. The Working Group's initial conclusion is that the specific needs and concerns of INGOs are adequately addressed by the current dispute resolution processes (e.g., UDRP and URS) and that there was no principled reason to recommend any modifications to these processes or the creation of a new curative rights process for INGOs.

The following is the Working Group's rationale for its conclusion that the UDRP and URS do not need amending in order to address the needs and concerns of INGOs, and that a new curative rights process applicable to INGOs is not necessary¹:

¹ The rationale described in this Section were also sent to all ICANN SOs and ACs as part of the Working Group's solicitation of input from these groups in December 2014, as required by the GNSO's PDP Manual. The Working

Comment [1]: PRK: They are already allowed and permitted to use the UDRP/URS. The issue is limited to their demand to retain immunity relative to post-UDRP/URS proceedings concerning the domain name(s) at issue.

Comment [SC2]: Expand on this section.

Comment [3]: PRK: lacks clarity: Similar to what (each other or to other complainants)?

Comment [4]: PRK: what is the "either case" being referenced.

Comment [5]: PRK: Delete "thus"

Deleted: ,

Deleted: thus

Comment [6]: PRK: Change to "the UDRP/URS"

Deleted: [1]

Formatted: Font:9 pt

1. Many INGOs already have, and do enforce their trademark rights. There is no perceivable barrier to other INGOs obtaining trademark rights in their names and/or acronyms and subsequently utilizing those rights as the basis for standing in the existing dispute resolution procedures (DRPs) created and offered by ICANN as a faster and lower cost alternative to litigation.
2. Unlike IGOs, who may claim jurisdictional immunity in certain circumstances, INGOs are not hindered from submitting to the jurisdiction of national courts under the Mutual Jurisdiction clause within the existing DRPs. The Working Group's research revealed that some INGOs regularly use the UDRP to protect their rights.
3. Although some INGOs may be concerned about the cost of using the UDRP and the URS, because enforcement through these RPMs involves some expenditure of funds, this is not a problem for all INGOs nor is it unique to INGOs as rights holders; furthermore, the issue of ICANN subsidizing INGOs to utilize DRPs is outside the scope of the Working Group Charter.
4. The Working Group found that the United Nations Economic and Social Council (ECOSOC) list of non-governmental organizations in consultative status consists of nearly 4,000 organizations, of which 147 organizations were in general consultative status, 2,774 in special consultative status, and 979 on the Roster. The Working Group notes that there might be many more organizations not presently on the ECOSOC list who might claim the right to utilize any new curative rights process created for INGOs. The WG felt that the sheer scale of INGOs, in combination with the factors cited above, weighed against the creation of a special DRP for INGOs.

In relation to the RC and IOC, the Working Group noted that although these INGOs had been specifically highlighted by the GAC and the Charter provision cited above as enjoying international legal treaty protections and rights under multiple national laws, for the purposes of this PDP these organizations have demonstrated that: (1) they have access to the UDRP and the URS; and (2) they possess trademark rights that they defend and enforce. As such, for the limited purpose of considering access of INGOs to curative rights protections, the WG determined there was no principled reason to distinguish them from other INGOs. The WG noted that legal representatives of the IOC participate actively in the WG and fully support this conclusion.

The following two paragraphs are taken substantially from the Final Issue Report that outlined the scope of this PDP, and are provided herein as further background to this issue.

1. As recognized in the Final Issue Report scoping out this PDP, the scope of the UDRP and URS as drafted currently applies only to second level domain name disputes where the complainant has legal rights in a trademark or service mark, and the complaint alleges that the

Group notes that no objection to this preliminary conclusion or the rationale was raised by any SO, AC or other ICANN community group.

Deleted: ·

Deleted: , and

Deleted: t

Formatted: List Paragraph, Numbered + Level: 1 + Numbering Style: 1, 2, 3, ... + Start at: 1 + Alignment: Left + Aligned at: 1.07" + Indent at: 1.32"

Comment [9]: PRK: Change to: "have and enforce their trademark rights. There is no perceivable....."

Deleted: ·

Comment [10]: PRK: This does not seem to be logically connected.

I agree that IGOs may assert immunity but it is optional - they may elect not to do so.

However, how is this "unlike" INGOs?

To the extent INGOs may assert immunity it is also optional.

Comment [SC11R10]: Per WG discussions, INGOs are not able to assert immunity.

Comment [12]: PRK: This should be a separate bullet point and either 1st or 2nd on the list. I also suggest we change the sentence to read: "The existing system appears to be sufficient. The Working Group's research revealed that INGOs regularly use the UDRP to protect their rights. Although the Working Group sought comments directly from the NGO/INGO community it received no evidence that any NGO/INGO had forgone exercising their rights under the UDRP/URS because of the immunity issue."

Deleted: ·

Comment [13]: PRK Change:

"While some INGOs may be concerned about the costs of the UDRP/URS process, the Working Group found that such issues were beyond the scope of the Working Group Charter. Evidence showed that the majority of costs related to a UDRP/URS proceeding are professional fees as opposed to ADR processing fees. The Working Group saw no reason why IGOs/INGOs could not request processing fee reductions directly from the ADR provider. No evidence was received to indicate that any IGO/INGO had requested such relief or that any request had been denied.

Moreover, it is highly unlikely that any alternative (... [1])

Deleted: ·

Deleted: with it

Comment [15]: I do not recall if we discovered what the process was for being included in the ECOSOS list.

(... [2])

Comment [16]: they actively defend and enforce

Comment [17]: by

Comment [18]: existing curative

respondent's domain name is identical or confusingly similar to that trademark or service mark. The Final Issue Report had also noted that not all IGOs and INGOs will have trademarks in their names and acronyms, and that during the development of the Applicant Guidebook (AGB) for the New gTLD Program, while certain objection procedures and trademark rights-protection mechanisms had been created, the AGB did not contain any specific rules that pertained exclusively to either preventative (i.e. prevent the harm from occurring by excluding an identifier from registration or delegation) or curative (i.e. an organization that claims to have suffered harm is able to file a dispute to cure the defect or problem) rights protections for IGOs or INGOs related directly to their status as international organizations. Rather, the AGB prescribed that organizations that met the existing criteria for a .int registration could avail themselves of the legal rights objection process, and organizations that owned trademark and other intellectual property rights in their names and/or acronyms could participate in the new Trademark Clearinghouse and the associated sunrise and Trademark Claims notice processes².

Deleted: [2].

2. The AGB also contained top-level protections for certain Red Cross (RC) and International Olympic Committee (IOC) identifiers, through which these RC and IOC identifiers would be reserved and thus withheld from delegation under the New gTLD Program. Both the RC and IOC are INGOs. Subsequently, interim second-level protections for certain RC and IOC and for a specific list of IGO names and acronyms provided by the GAC was granted in response to advice from the GAC.

It is important to note that the second-level protections noted above were granted on an interim basis to allow new gTLDs to begin launching while policy development and consultations continued on the topic of what would be the appropriate second level protections for RC and IOC names and acronyms, and IGO acronyms. As of the date of publication of this Initial Report, the Working Group understands that consultations and discussions continue among the ICANN Board, the GAC, the RC, IGO representatives and the GNSO. The Working Group therefore acknowledges that certain of its initial recommendations may be revisited if concrete proposals emerge from these consultations that come within the scope of this PDP, and which require the Working Group to review its initial conclusions in advance of its completion of its Final Report.[MW2]

Recommendation #2: For IGOs, standing to file a complaint under the UDRP and URS can, in addition to trademark rights, be demonstrated by IGOs who have complied with the requisite communication and notification procedure in accordance with Article 6ter of the Paris Convention for the Protection of Industrial Property³[MW3]. For clarity, the Working Group recommends further that a Policy Guidance document pursuant to the UDRP and URS be prepared and issued to this effect for the benefit of panelists and registrants.

² See, e.g., page 4 of the Final Issue Report (<https://gns0.icann.org/en/issues/igo-ingo-crp-access-final-25may14-en.pdf>).

³ 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 I of this report.

Deleted:

Formatted: Font:9 pt

Formatted: Font:9 pt, No underline, Font color: Black

Formatted: Normal

Deleted: .

... [3]

Deleted: See the WIPO Overview 2.0 (<http://www.wipo.int/amc/en/domains/search/overview2.0/>).

Formatted: Font:9 pt

Formatted: Font:9 pt

Formatted: Font:9 pt

Formatted: Font:9 pt

Formatted: Font:9 pt, Highlight

Formatted: Font:9 pt

Under the UDRP and URS, the first substantive element that a complainant must satisfy under both procedures is that the complainant has rights in a trademark or service mark. Most UDRP panelists have read this requirement as a requirement for standing to file a complaint⁴, and it is generally accepted that the threshold may be satisfied by establishing either ownership or exclusive license rights in the trademark or service mark⁵. The Working Group considered this requirement in the context of IGOs, with particular reference to the trademark protections offered to IGOs under Article 6ter of the Paris Convention for the Protection of Intellectual Property. The Working Group came to a preliminary conclusion that, based on Article 6ter, IGOs who have complied with the communications procedure described in that treaty provision will have satisfied the standing requirement of the UDRP and URS.

The purpose of Article 6ter is to protect armorial bearings, flags and other State emblems of the States party to the Paris Convention⁶, as well as official signs and hallmarks indicating control and warranty adopted by them. This protection was extended to armorial bearings, flags, other emblems, **abbreviations and names** of international intergovernmental organizations by the Revision Conference of Lisbon in 1958.

Under paragraph 6(1)(a) of Article 6ter, the States that are party to the Paris Convention “agree to refuse or to invalidate the registration, and to prohibit by appropriate measures the use, without authorization by the competent authorities, either as trademarks or as elements of trademarks, of armorial bearings, flags, and other State emblems, of the countries of the Union, official signs and hallmarks indicating control and warranty adopted by them, and any imitation from a heraldic point of view.” Under paragraph 6(1)(b), the protections described by paragraph (a) “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 Paris Convention has an established procedure for recognition of those items subject to the protection of Article 6ter(1)(a).

It should be noted that paragraph (c) clarifies that States “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.” As discussed further below (in ____), the Working Group believes that this limitation reflects the other substantive grounds of the UDRP

⁴ See, e.g., Halpern, Nard & Port, “Fundamentals of United States Intellectual Property Law: Copyright, Patent, Trademark” (Kluwer Law International, 2007).

⁵ See the WIPO Overview 2.0 (<http://www.wipo.int/amc/en/domains/search/overview2.0/>).

⁶ Note that, as a result of the TRIPS Agreement which came into effect in January 1995, the obligations for States party to the Paris Convention also became applicable to any State that becomes a member of the World Trade Organization, regardless of whether that State also signed up to the Paris Convention individually.

Comment [19]: Change: “Under both the UDRP and URS a complainant must, as a threshold, establish that it holds rights in a trademark or service mark.”

Deleted: [3]

Deleted:]

Comment [20]: Change: “threshold may be satisfied by establishing either ownership or exclusive license rights in the trademark or service mark.” In the UDRP context, trademark rights do not require registration and may be established by evidence of use (referenced as “common law” rights). URS proceedings, however, require proof of (a) registration and actual use; (b) validation by court proceedings; or (c) protection by specific statute or treaty presently in force.

Deleted: ownership by a complainant of a trademark is sufficient to satisfy the threshold requirement of having trademark rights

Deleted: [4].

Deleted: [5]

Formatted: Font:Bold, Italic

Comment [21]: Suggested addition.

Formatted: Font:9 pt

Formatted: Font:9 pt

Formatted: Normal

Formatted: Font:9 pt, No underline, Font color: Black

Formatted: Font:9 pt

Formatted: Font:9 pt

and URS, which require that the respondent have no legitimate rights or interests in the domain that is identical or confusingly similar to the complainant's mark, and has registered and used the domain name in bad faith.

Consequently, the Working Group believes that, while Article 6ter does not necessarily in and of itself confer substantive legal rights in any particular jurisdiction – that being the province of each sovereign nation state – for the limited purpose of possessing the requisite standing to file a complaint under the UDRP and URS, this requirement would be satisfied if IGOs have complied with the communication procedure prescribed by Article 6ter. **For the avoidance of doubt, this also means that IGOs that have not complied with the communications procedure prescribed by Article 6ter (e.g. in terms of filing a notification as required) should not be deemed to have fulfilled the standing requirement under the UDRP and URS.**

To enshrine this recommendation as part of binding Consensus Policy and/or contractual agreement with ICANN's contracted parties, the Working Group recommends that a binding Policy Guidance document be prepared that will describe the scope of the standing issue for IGOs, as well as any other points that may warrant clarification should the GNSO Council and the ICANN Board accept these PDP recommendations.

Notes on the Prescribed Communications Procedure under Article 6ter:

The current communication procedure involves the periodical electronic publication by WIPO of those IGO names and acronyms for which protection under Article 6ter is being requested, in what is known as the Article 6ter Express Database (<http://www.wipo.int/ipdl/en/6ter/>). The nature of the names and acronyms concerned as well as the IGO that has requested their protection is published, in English and French, together with the individual reproductions of the names and acronyms concerned.

The electronic publication is made on a semi-annual basis, on the last working day of the months of March and September. A link to the most recent communications is inserted into the database, which indicates the communications that were received by WIPO during the six months previous to the most current publication. The date of publication is considered to constitute the date of receipt of the communication by individual States party to the Paris Convention and any other party bound to apply Article 6ter of the Paris Convention⁷.

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 Working Group notes that UDRP panels have typically found trademark registrations that are automatic or unexamined (such as US state registrations as opposed to

⁷ See <http://www.wipo.int/article6ter/en/communication.html>. The specific process for IGOs is also detailed by WIPO at <http://www.wipo.int/article6ter/en/igos.html>.

Comment [22]: I propose the following for discussion:

6Ter does not provide for any trademark rights itself. It merely imposes a burden on signatory states to prohibit registrations of trademarks or use in trademarks that are identical BUT ONLY IF it suggests a connection at the public level or if use/registration does not likely mislead the public as to such a connection. In other words, absent satisfying Para (c) there is no "trademark" protection at all.

It would not be sufficient IMHO for an NGO/INGO to show 6ter publication, lack of legitimate interest, and bad faith without satisfying Para(c).

It should be noted that paragraph (c) clarifies that States "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." As discussed further below (in _____), the Working Group believes that this limitation potentially reflects an additional substantive threshold (in addition to the other elements of the UDRP/URS) that must be met to assert any rights under the Convention.

Comment [23]: I have difficulties agreeing to this recommendation. No additional documentation is required.

I believe that in the UDRP context the language is sufficiently broad such that panelists would recognize the nature of the claim raised. Because the UDRP is not restricted to "registered" trademarks, complainants are free to satisfy the threshold by way of evidence of substantial equivalence (e.g. 6ter(1)(b) compliance or common law trademark rights). As such, no additional documentation or advice is necessary for the UDRP.

As concerns the URS, the protection by treaty is already embodied in Paragraph 1.2.6.1. It is the responsibility of the complainant (or its counsel) to assert the basis of rights. It is not the place of ICANN (or this Working Group) to do the work of complainants for them. Nor is it the place of ICANN (or this Wo... [4]

Deleted: [6]

Formatted: Font:9 pt

Formatted: Font:9 pt

Formatted: Font:9 pt

Formatted: Font:9 pt, No underline, Font color: Black

Formatted: Font:9 pt

Formatted: Font:9 pt

Formatted: Font:9 pt, No underline, Font color: Black

Formatted: Font:9 pt

US federal registrations) are not owed the same deference under the UDRP as examined registrations.]footnote: See: Para 1.1, *WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition* ("WIPO Overview 2.0"), © 2011 World Intellectual Property Organization). By stating its position above, the Working Group is not intending to alter existing UDRP jurisprudence or suggesting that the pre-existing standards used by UDRP panelists with regards to the recognition of trademarks obtained via an automated or unexamined process be altered in any manner.

Recommendation #3: For IGOs, the Working Group does not recommend that any specific changes be made to the substantive grounds 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). In relation to IGOs, however, the Working Group proposes that the limitation enshrined in Article 6ter(1)(c) of the Paris Convention be considered an approximation of the remaining substantive grounds of the UDRP and URS^[PC4], with respect to the required findings that a respondent possess no legitimate rights in the domain name that is identical or confusingly similar to an IGO's name or acronym, and has registered and used the domain name in question in bad faith.

For the avoidance of doubt, the above-noted recommendation means that, where a panelist's/panel's finding that the use and registration of the domain name in question, is not of such a nature as to suggest to the public that a connection exists between the IGO concerned and the registrant, or if such use and registration is probably not of such a nature as to mislead the public as to the existence of a connection between the respondent-registrant and the IGO in question, a complaint under the UDRP and/or URS would also fail.

Recommendation #4: In relation to the issue of jurisdictional immunity, which IGOs may claim successfully in certain circumstances (but not INGOs), the Working Group recommends that: (a) no change be made to the Mutual Jurisdiction clause of the UDRP and URS; (b) IGOs be notified that 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 (c) claims of jurisdictional immunity made by an IGO in respect of a particular jurisdiction will fall to 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, then [Option 1 – the decision rendered against the registrant in the predecessor UDRP (URS?) shall be vitiated] [Option 2 – the decision rendered against the registrant in the predecessor UDRP may be brought before the [name of arbitration entity] for de novo review and judgment^[PC5]]. The Working Group recommends, further, that a Policy Guidance document be prepared and circulated to the Governmental Advisory Committee (GAC) and the IGO representatives who have been active on this issue at ICANN, that outlines the specific options available to IGOs who seek to suspend, cancel or transfer a registrant's domain name.

[In presenting Options 1 and 2 above, the WG acknowledges that it has yet to uncover a perfect solution. As such, the WG has identified a number of different factors to consider when

Comment [24]: It COULD be easily argued that Para(c) in fact operates as a condition for the recognition of the right AND that this condition presents a higher burden for the complainant because it is not merely a text vs text comparison but necessarily includes establishing an element of confusion at the level of the public.

Comment [SC25]: I don't see an explanation for how the WG reached this conclusion. If I've missed it, should include language that states essentially that "...allowing action to be brought by assignee, agent, or licensee should eliminate most assertions of jurisdictional immunity at appeals stages, providing that the court recognizes validity on the original procedure transfer of rights."

Deleted:

Deleted: /

examining the two options. Accordingly, the WG would like to solicit input from the community to aid in developing its final recommendations.

For context, the WG anticipates that the circumstances under which this scenario would occur – where an IGO files a complaint under the UDRP or URS, the IGO succeeds in the dispute resolution process, and the losing respondent then seeks relief against the UDRP or URS decision – will be extremely rare.

Option 1:

- By vitiating the decision against the registrant in a UDRP or URS in the circumstance where an IGO has successfully claimed jurisdictional immunity, would we avoid creating a situation that would not otherwise arise in the absence of the UDRP?
- By vitiating the decision against the registrant in a UDRP or URS in the circumstance where an IGO has successfully claimed jurisdictional immunity, would we encourage the losing registrant to seek relief in the courts (leaving the IGO with minimal choices – either waive jurisdictional immunity or seek jurisdictional immunity and thereby have the decision vitiated)?
- Is the registrant provided adequate paths for recourse?
- Other?

Option 2:

- Would an IGO be deemed to have already waived immunity by utilizing the UDRP or URS and accordingly, submitting to the Mutual Jurisdiction clause?
- Is the provision of a de novo review similar or equivalent in the scope of relief it would offer a registrant that sought relief via the courts?
- Other?

In considering the benefits and drawbacks of each option, the WG has not achieved full consensus for either option, though it has reached rough consensus in support of Option 1]

For the purposes of understanding the scope and limitations of public international law in relation to the issue of IGO jurisdictional immunity, the Working Group requested that ICANN engage an external legal expert to advise the Working Group of the current state of the law on this topic. Professor Edward Swaine of George Washington University in the USA was engaged following a detailed evaluation by the Working Group of the qualifications of other interested candidates⁸.

Notes on the Working Group's consultation with an external legal expert on the issue of IGO jurisdictional immunity

⁸ For details about the criteria agreed on for this engagement, see the Working Group's collaborative wiki space at <https://community.icann.org/x/z4BYAw>.

Formatted: Normal, No bullets or numbering

Formatted: Bulleted + Level: 1 + Aligned at: 0.3" + Indent at: 0.55"

Formatted: Normal, No bullets or numbering

Deleted: [7]

Formatted: Font:9 pt, No underline, Font color: Black

Professor Swaine's final expert opinion was delivered to the Working Group in June 2016⁹. In sum, Professor Swaine's opinion was that:

Deleted: [8]

There is no single universal rule that is applicable to IGOs' jurisdictional immunity globally. Rather, such immunity is essentially contextual - IGOs generally enjoy immunity under international law, but different jurisdictions apply the law differently, and even within the same jurisdiction different IGOs may be treated differently:

- *Immunity obligations vary by state and by IGO concerned;*
- *Immunity decisions are often based on organization-specific treaties to which not all states are party;*
- *States subject to the same international obligations may implement them in varying ways; and*
- *Every jurisdiction resolves immunity questions according to its own law (the "law of the forum", as informed by international law)*

On the other hand, under the UDRP and URS, a complainant is compelled to consent to a Mutual Jurisdiction (defined as either the domain name registrar or registrant) for purposes of an appeal from a panel's initial determination of a complaint. Thus, an IGO that files a complaint will therefore have agreed to the possibility of a judicial process, regardless of any immunity it might otherwise enjoy under international law.

According to Professor Swaine, under current international law principles as understood generally, there are three types of jurisdictional immunity which an IGO might claim – absolute, restrictive and functional. An IGO that is entitled to absolute immunity would be entitled to comprehensive immunity from judicial process, irrespective of the nature of the IGO's activity, in the absence of an express (and strictly construed) waiver (for example, the United Nations and other IGOs protected in certain States by specific treaties binding those States, or bilateral arrangements between States). Under a restrictive immunity approach, however, an exception from absolute immunity is made for litigation concerning commercial activities like those undertaken by private parties – however, with the notable exception of the United States, relatively few states have adopted this approach. Finally, under a functional immunity approach, an IGO's immunity with respect to a particular jurisdiction is limited to the functions of the IGO in question. For example, certain jurisdictions may have legislative language which limit the extent of IGO jurisdictional immunity to the "privileges and immunities as are reasonably necessary for the fulfilment of their functions". While a functional immunity approach can overlap with a restrictive immunity approach, the distinction may be critical – for instance, a non-infringing use of its domain may be necessary for IGO to carry out its mission regardless of whether the activities are commercial or not in nature.

Professor Swaine also analyzed how, outside the domain name arena, IGOs are generally able to waive their jurisdictional immunity, and he noted that there seems to be two main ways to accomplish this: (1) through the IGO's governing instrument (though the exact scope of this can

⁹ For the full text of Professor Swaine's memo, please refer to Annex of this Initial Report and the Working Group's wiki space at <https://community.icann.org/x/z4BYAw>.

Formatted: Font:9 pt, No underline, Font color: Black

be unclear); or (2) by way of agreement or pleading (for which option the case law is not well developed, but Professor Swaine expressed the thought that an IGO's agreeing to a Mutual Jurisdiction under the UDRP or URS could be interpreted as a waiver.

In essence, Professor Swaine's legal conclusion in relation to an IGO's jurisdictional immunity for purposes of a domain name dispute under the UDRP or URS was that *"[a]llowing an IGO that prevailed in the UDRP process to avoid its waiver and rest on the UDRP result by invoking immunity, while allowing it to waive that immunity by initiating judicial proceedings if it loses to a domain-name registrant, will likely seem asymmetrical and unfair."*

Professor Swaine's opinion was largely focused on the question of what might happen in the case where an IGO files a complaint under the UDRP or URS and wins at the administrative proceedings phase, in which event a losing respondent would then be able to file a *de novo* appeal in a national court against that initial determination. In view of this focus, various policy options were identified for addressing the IGOs' concern over losing the possibility of jurisdictional immunity for this type of proceeding. The Working Group discussed the following options:

A. Make a distinction among different types of IGOs:

- This option would maintain the existing Mutual Jurisdiction terms in general, but permit particular IGOs to elect instead to submit to arbitration. An option for such arbitration would be the arbitration rules under the United Nations Commission for International Trade Law (UNCITRAL) or some similar, internationally recognized procedure.
- In line with Professor Swaine's analysis, the most likely IGOs that would be able to elect an arbitration option would be the United Nations and its constituent bodies (e.g. WIPO, WTO, WHO).

B. Rewrite the Mutual Jurisdiction clause under the UDRP and URS, but without prejudging the outcome where an IGO pleads jurisdictional immunity:

- Adopting this option would mean that IGO immunity is not to be assumed in circumstances where the relevant jurisdiction would not be inclined to afford it (e.g. its courts apply a functional or restrictive approach and regard the activity as beyond the scope of immunity). Essentially, this option would leave the determination of an IGO's jurisdictional immunity from domain name disputes in any particular jurisdiction to the judgment of that particular national court.
- If this option were to be adopted by the Working Group, Professor Swaine suggested that additional language (in the form of an exception) could be added to the UDRP and URS as follows:
 - *"In the event the action depends on the adjudication of the rights of an international intergovernmental organization that would, but for this provision, be entitled to immunity from such judicial process according to the law applicable in that jurisdiction, [as established by a decision of a court in that jurisdiction,] the challenge must be submitted instead for determination [by UNCITRAL in accordance with its rules]."*

The Working Group also noted that Professor Swaine also highlighted the possibility that any hardship endured by a respondent as a result of submission to an arbitral process should be alleviated, e.g. by the IGO's agreeing to bear a proportion of the costs incurred.

The Working Group's consideration of Professor Swaine's suggestions and the available policy options

The Working Group spent considerable time reviewing Professor Swaine's notes and final memo, including in open sessions at the ICANN Public Meetings in Marrakech (March 2016) and Helsinki (June 2016). It also considered the applicability and scope of the UNCITRAL Arbitral Rules¹⁰ to domain name disputes between IGOs and registrants, and noted that the issue of immunity is likely to arise only in those limited cases where a losing respondent (against an IGO complainant, who would presumably have agreed to the Mutual Jurisdiction clause in order to file and proceed with its complaint) files an appeal against the UDRP or URS determination.

Deleted: [9]

Ultimately, the Working Group concluded that, given: (1) the limited instances of a scenario where an IGO would assert immunity against a losing respondent in a national court, having already filed and won a UDRP or URS complaint; (2) the need to preserve a registrant's right to appeal to a court of competent jurisdiction; and (3) the lack of a single, universally applicable rule in relation to IGO jurisdictional immunity, the most prudent and advisable approach would be to not recommend any changes to the UDRP or URS at this time.

Other research and documentation taken into account by the Working Group on this issue

Besides Professor Swaine's expert views, the Working Group also considered research and prior work done on this topic. This included the August 2003 report from the WIPO Secretariat on a possible arbitral appeal mechanism for domain name disputes involving country names, which could conceivably also apply to IGO names and acronyms¹¹. The Working Group notes that, in this report, the WIPO Secretariat expressly stated that the following principles ought to apply if a *de novo* arbitration process is to be created:

Deleted: [10]

¹⁰ For the full text of the UNCITRAL Arbitral Rules, see

http://www.uncitral.org/uncitral/en/uncitral_texts/arbitration/2010Arbitration_rules.html.

¹¹ See www.wipo.int/edocs/mdocs/sct/en/sct_11/sct_11_5.doc. The Working Group acknowledges that, in this report, the WIPO Secretariat noted that "[i]n order to strike a balance between the privileges and immunities of sovereign States on the one hand, and the right of a losing UDRP respondent to have the dispute reconsidered in a neutral forum on the other, WIPO member States also recommended to allow IGOs to submit to a special appeal procedure by way of *de novo* arbitration rather than to the jurisdiction of certain national courts of justice". However, for reasons stated in the main text, the Working Group respectfully disagrees with this proposal and notes, further, that in the General Assembly report of the proceedings at hand, there was not agreement on the need to protect IGO names and acronyms and country names in this manner (see WO/GA/28/7: http://www.wipo.int/edocs/mdocs/govbody/en/wo_ga_28/wo_ga_28_7.pdf).

Formatted: Font:9 pt, No underline, Font color: Black

Formatted: Font:9 pt, No underline, Font color: Black

Formatted: Font:9 pt, No underline, Font color: Black

- The parties should be able to restate their case completely anew. They should not be confined to claiming that the panel did not consider certain relevant facts or wrongly applied the procedure, but should also be able to submit new evidence and new factual or legal arguments;
- In order to provide a meaningful “appeal,” conducting a *de novo* arbitration should, as a general rule, not be more burdensome than conducting litigation in a court of mutual jurisdiction;
- The arbitral tribunal should consist of one or more neutral and independent decision makers, who should not be identical or related to the panelists who rendered the initial decision; and
- Either party should be able to present its case in a complete manner. The arbitral tribunal should, for example, have the authority to allow for, or request, additional written submissions, and it should be possible to hold in- person hearings

From publicly available information reviewed by the Working Group, it appears that no further action was taken on the above-noted *de novo* arbitral appeal mechanism. In light of the fact that it has been over a decade since that proposal was scoped, and given the fact that the Working Group’s recent research revealed that some IGOs do in fact waive their immunity and submit to the Mutual Jurisdiction clause in bringing a UDRP action¹², the Working Group believes that the present circumstances do not adequately justify amending the UDRP and URS in order to provide IGOs with broad immunity protections.

Deleted: [11]

In this regard, the Working Group notes that GAC advice to the ICANN Board in relation to this issue was that the UDRP should not be amended¹³.

Deleted: [12]

The Working Group recognizes that IGOs may not welcome the fact that adoption of this recommendation by ICANN will mean that IGOs will still have to submit to the Mutual Jurisdiction clause of the UDRP and URS when filing a complaint under either procedure. Nevertheless, in view of the concerns listed in the paragraph immediately above this one, and the other Policy Guidance principles that the Working Group is recommending be applied to IGO complaints (e.g. standing under Article 6ter of the Paris Convention), the Working Group believes that the totality of these recommendations will suffice to protect the rights of IGOs in their names and acronyms.

Recommendation #5: In respect of the remainder of the GAC’s 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 (with the accompanying Policy Guidance as recommended in this report), at no or nominal cost, in accordance with GAC advice on the subject^[PC6].

¹² See, e.g., the resources and links compiled by the Working Group at <https://community.icann.org/x/48PhAg>.

¹³ See, e.g., the GAC Communique from the Los Angeles ICANN meeting held in October 2014: <https://www.icann.org/en/system/files/correspondence/gac-to-board-15oct14-en.pdf>.

Formatted: Font:9 pt, No underline, Font color: Black

Formatted: Font:9 pt, No underline, Font color: Black

[insert text here providing context related GAC Advice on his subject -
<https://gacweb.icann.org/display/GACADV/IGO+and+INGO+Names>. The following two links are
in regards to GAC Advice specific to curative rights:

- [16 October 2014 – Los Angeles Communique -
https://gacweb.icann.org/display/GACADV/2014-10-16-Protection+of+Inter-Governmental+Organisation+%28IGO%29+Names+and+Acronyms](https://gacweb.icann.org/display/GACADV/2014-10-16-Protection+of+Inter-Governmental+Organisation+%28IGO%29+Names+and+Acronyms)
- [11 February 2015 – Singapore Communique -
https://gacweb.icann.org/pages/viewpage.action?pageId=37617838](https://gacweb.icann.org/pages/viewpage.action?pageId=37617838)

[insert text here about how this may be beyond the scope of the WG's authority]

Recommendation #6: To the extent that the GNSO receives a concrete proposal from the Board-GAC-IGO “small group” prior to the issuance of this Working Group’s Final Report, the Working Group requests that the GNSO Council refers to the Working Group those aspects of the proposal that affect any curative rights protections for IGOs, so that the Working Group may review the proposed recommendations with a view toward discussing them in its Final Report^[PC7].

[Insert text here about the known status of the IGO small group discussions]

[MW1] The inclusion (or not) of this sentence and section will depend on whether the WG believes there are open questions for which community input should be specifically solicited.

[MW2] This may need to be moved up, or repeated a few times in the Initial Report.

[MW3] Staff continues to have misgivings about this recommendation. We will be happy to elaborate further on this during the WG call.

[PC4] Need to discuss this language to fully consider its import and to discuss whether the language should be modified. In any event, it will need to be described at greater length in the explanatory text following.

[PC5] This is placeholder language to deal with the situation where registrant loses UDRP, registrant appeals, IGO successfully asserts sovereign immunity and registrant therefore without an appeals avenue.

[PC6] Are we taking this suggested approach because the issue of costs is somehow beyond on Charter? In any event, we should make clear that we have no ability to authorize spending to provide low or no-cost filings.

While I’m not personally opposed to ICANN investigating “feasibility”, I don’t recall our WG reaching a consensus one way or another on that GAC advice.

Formatted: List Paragraph, Bulleted + Level: 1 + Aligned at: 0.25" + Indent at: 0.5"

[PC7]Do we really have leeway to incorporate [in the sense of recommending] them in a Final Report when they were not previously considered by the WG (if indeed it's a new idea we never considered) and the community has had no opportunity to comment on them?

PRK Change:

"While some INGOs may be concerned about the costs of the UDRP/URS process, the Working Group found that such issues were beyond the scope of the Working Group Charter. Evidence showed that the majority of costs related to a UDRP/URS proceeding are professional fees as opposed to ADR processing fees. The Working Group saw no reason why IGOs/INGOs could not request processing fee reductions directly from the ADR provider. No evidence was received to indicate that any IGO/INGO had requested such relief or that any request had been denied.

Moreover, it is highly unlikely that any alternative ADR process would be any more cost-effective for any IGO/INGO and would certainly impose a further burden upon domain registrants and ADR providers."

I do not recall if we discovered what the process was for being included in the ECOSOS list.

I presume it involves being listed by a sponsoring governmental authority with inclusion automatically following a notice and non-objection process. If that is the case then we should add a line item noting the lack of qualification process and then concluding with the last 2 sentences.

[3] See, e.g., Halpern, Nard & Port, "Fundamentals of United States Intellectual Property Law: Copyright, Patent, Trademark" (Kluwer Law International, 2007).

[4]

I have difficulties agreeing to this recommendation. No additional documentation is required.

I believe that in the UDRP context the language is sufficiently broad such that panelists would recognize the nature of the claim raised. Because the UDRP is not restricted to "registered" trademarks, complainants are free to satisfy the threshold by way of evidence of substantial equivalence (e.g. 6ter(1)(b) compliance or common law trademark rights). As such, no additional documentation or advice is necessary for the UDRP.

As concerns the URS, the protection by treaty is already embodied in Paragraph 1.2.6.1. It is the responsibility of the complainant (or its counsel) to assert the basis of rights. It is not the place of ICANN (or this Working Group) to do the work of complainants for them. Nor is it the place of ICANN (or this Working Group) to advise panelists as to how they should or should not analyze the cases before them.