

GNSO Recommendations on IGO Access to Curative Rights Protection Mechanisms

Comments from the Legal Directorate of the Organisation for Economic Co-operation and Development (OECD)

Overall comments:

During the public comment period for the Initial Report in the Policy Development Process on INGO-IGO Access to Curative Rights Protection Mechanisms, 39 individuals and entities (at least one of whom was a member of the Working Group) provided comments on the Working Group's Initial Report. Nearly half of these were intergovernmental organisations (IGOs) that raised fundamental issues with the main recommendations put forward by the GNSO. The GAC also provided comments that called into question the recommendations—unsurprising given that the recommendations largely contravened longstanding GAC advice on the matter.

Yet, in spite of such overwhelming public comments against the recommendations, the Working Group maintained its position, modifying its conclusions only to make them even less favourable for the IGOs that commented in large numbers to expose the flaws in the recommendations. The Working Group then simply moved some elements from recommendation 3 to recommendation 1 in an effort to claim “full consensus” despite strong objections during the public comment period.

The above, coupled with the procedural irregularities of the PDP well known to the GNSO Council (and raised in part by former vice-chair of the PDP Phil Corwin in his minority statement), have resulted in a flawed set of recommendations that conflict with GAC advice on the matter and that the Board should reject.

Recommendation #1:

The GNSO's final report misleadingly claims that this recommendation “*is substantively similar to the original recommendation on this point in the Working Group's Initial Report*” and that it enjoys “*full consensus*”. Neither are true.

Recommendation 1 differs substantially from the Recommendation 1 in the Initial Report, where it dealt exclusively with international non-governmental organisations (INGOs).

Recommendation 1 as presented to the Board directly conflicts with longstanding GAC advice that specifically calls for the creation of a curative rights mechanism for IGOs separate from the Uniform Domain-Name Dispute Resolution Policy (UDRP). This is in part because the UDRP was designed for trademark holders, and as a result is not adequate to deal with IGOs, which are non-commercial entities whose emblems enjoy unique protections under international law. The UDRP likewise requires a complainant to submit to the jurisdiction of a national court in order to bring a claim, which conflicts with IGOs' jurisdictional immunities.

Furthermore, Recommendation 1 encompasses an earlier recommendation included in the Initial Report stating that no change should be made to the UDRP's mutual jurisdiction clause. A

substantial number of commenters disagreed with this recommendation. For this reason, the claim of “*full consensus*” is inaccurate.

The GNSO’s recommendation is based in part on the fact that “[t]here is no single, universally applicable legal rule governing IGO jurisdictional immunity globally”. However, the issue at hand is not IGO jurisdictional immunity writ large, but rather the much more focussed issue of an IGO’s jurisdictional immunity in actions related to its name and acronym. Prof. Edward Swaine, hired by the Working Group to provide an expert opinion on IGO immunities, found that “*an argument that it is part of an IGO’s mission to maintain the distinctive character of its name, and avoid confusing domain-name registration, and thus deserving of immunity, seems colorable or even likely to prevail.*”¹ In other words, Prof. Swaine found it likely that a court would determine that an IGO’s activities related to utilising and protecting its name and acronym fall within the IGO’s mission, and that an IGO is therefore entitled to immunity when exercising these functions. Even on this most strict of tests, therefore, Prof. Swaine found that an IGO’s immunity claim is likely to prevail. Of course, numerous IGOs enjoy broader immunities, and numerous courts would not take such a narrow approach to assessing IGO immunities.

Recommendation #2:

Given the non-commercial nature of IGOs and the unique protection their marks enjoy under international law, standing to file a complaint under the UDRP and URS should be based in international law rather than national trademark law.

Recommendation #3:

The Working Group’s suggestion that an IGO can file a complaint by assigning its rights to a licensee is based on a complex legal theory constructed by Prof. Swaine, who himself acknowledges that “*the assignment might be ineffective*”.² Even if such an assignment were found to be legally effective—a claim for which there is little jurisprudential support—Prof. Swaine admits that “*such assignments could themselves be regarded as waivers of immunity*”.³ Moreover, Prof. Swaine observes that an IGO employing the assignment strategy is in danger of not only inadvertently waiving its immunities, but also potentially weakening its claim to the very mark it is trying to protect:

*The graver problem is that a flawed assignment might diminish the assignor’s priority in the underlying mark for all purposes.*⁴

Indeed, a recent case involving the Pan American Health Organisation and a foundation that used that organisation’s name without authorisation following a severed partnership demonstrates the risk that an IGO could lose control over its name and emblem in the context of a licensing agreement.

¹ Swaine Memo, p. 21.

² Swaine Memo, p. 27

³ Swaine Memo, p. 27.

⁴ Swaine Memo, p. 27.

In light of the uncertainty surrounding the effectiveness of assignment from both an immunities and intellectual property perspective, the conclusion that such a complicated legal workaround is a viable remedy for the problem at hand is unsupported by the facts presented in the Working Group's final report.