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Submitted to: <mailto:comments-igo-ingo-crp-recommendations-11jul19@icann.org>

August 20, 2019

Mary Wong
Vice President for Strategic Community Operations, Planning and Engagement
ICANN
12025 Waterfront Drive, Suite 300
Los Angeles, CA 90094-2536

Re: GNSO Policy Development Process on IGO-INGO Access to Curative Rights Protection Mechanisms Policy Recommendations for ICANN Board Consideration

Dear Ms. Wong:

The International Trademark Association (“INTA”) appreciates this opportunity to comment on the GNSO Policy Development Process on IGO-INGO Access to Curative Rights Protection Mechanisms Policy Recommendations (the “IGO RPM Recommendations”) for ICANN Board Consideration published by ICANN Org (“ICANN”) on July 11, 2019.¹

Initial Comments

As an initial matter, INTA notes very serious concerns with how the PDP Working Group (“WG”) produced its recommendations. As is summarized in one of the minority statements in the WG’s Final Report on the PDP on IGO-INGO Access to Curative Rights Protection Mechanisms (the “Final Report”), the recommendations represent “a view of a minority of the full WG membership ... and the participating members of the WG were not representative of the broad ICANN community and the WG had, in fact, been operationally captured by a narrow and self-interested faction....” While this statement relates specifically to Recommendation #5, which as discussed further below is not under consideration by the Board, we believe the comments apply equally to all of the WG’s recommendations. As the minority statement notes, “Council and the Board should not approve a policy recommendation that failed to receive majority support among the full membership of the WG.” Again, this statement relates specifically to Recommendation #5, but INTA has the same concern regarding all of the WG’s recommendations, which it feels were the result of a captured process dominated by one specific class of stakeholders with a direct vested interest in achieving a certain outcome. For these reasons, INTA calls into question the legitimacy of the Final Report and all of its recommendations, including the true level of consensus support for those recommendations.

Further, as noted above, Recommendation #5 within the Final Report has been treated separately and is not part of the set of IGO RPM Recommendations now being presented to the ICANN Board. Recommendation #5 has already been designated by the GNSO Council for

¹ See <https://www.icann.org/public-comments/igo-ingo-crp-recommendations-2019-07-11-en>.

further consideration as part of the separate PDP on Review of All Rights Protection Mechanisms in All gTLDs (the “RPM Review PDP”). Although INTA does not object in principle to such treatment of Recommendation #5, we wish to go on record to strongly suggest that consideration take place as a separate, dedicated and expedited sub-team of RPM Review PDP Phase 2, and also that such sub-team use as a starting point for its deliberations the various options for Recommendation #5 that had previously been discussed by the IGO Curative RPMs WG, including in particular Option 3, which in INTA’s view represented the most reasonable and balanced solution to the issue of IGO jurisdictional immunity in the context of a post-UDRP challenge.

With these prefatory comments in mind, it would be reasonable for the Board to reject the report in its entirety as the PDP has been seriously flawed and may not reflect true community consensus. In the event the Board opts to move forward with any of the recommendations in the report, INTA provides the following specific comments regarding each of the individual IGO RPM Recommendations under consideration.

Recommendation #1

1(a). For INGOs (including the Red Cross movement and the International Olympic Committee), no substantive changes to the UDRP and URS are to be made, and no specific new dispute resolution procedures are to be created.

1(b). For IGOs, no specific new dispute resolution procedures are to be created.

INTA supports Recommendation #1(a). The IGO RPM PDP was not able to establish that INGOs lack sufficient access to curative RPMs under the current policies and rules such that any changes or new policies or procedures are needed to accommodate access by INGOs.

INTA supports Recommendation #1(b). For reasons explained in other portions of these comments, INTA agrees that no specific new dispute resolution procedures are needed to accommodate access to curative RPMs by IGOs. In particular, we believe IGOs would have an appropriate pathway to establish standing under both the UDRP and URS through Article 6ter of the Paris Convention, as suggested in Recommendation #2, or through evidence of common law rights, and that IGOs can directly engage in UDRP and URS proceedings without improperly compromising their general jurisdictional immunity, as related to Recommendation #3. Further discussion on these aspects of Recommendations #2 and #3 is provided below.

Recommendation #2

The Working Group notes that an IGO may seek to demonstrate that it has the requisite standing to file a complaint under the UDRP or URS by showing 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. An IGO may consider this to be an option where it does not have a registered trademark or service mark in its name and/or acronym but believes it has certain unregistered trademark or service mark rights for which it must adduce factual evidence to show that it nevertheless has substantive legal rights in the name and/or acronym in question. In this regard, the Working Group recommends that specific Policy Guidance on this topic be issued by ICANN....

INTA supports in part and opposes in part Recommendation #2. While INTA does not oppose the ability for IGOs to demonstrate standing under the UDRP or URS by providing evidence that the IGO has complied with procedures under Article 6ter of the Paris Convention, INTA also suggests that IGOs could equally establish standing through common law rights in their organization name or other trade names or designations associated with the organization, such rights are supported through similar evidence as any other party seeking to establish such rights.² INTA believes that URS and UDRP panels are already sufficiently equipped to make appropriate findings with respect to IGO standing based on existing policies, procedures, and rules, as well as prior URS and UDRP jurisprudence.³

That said, INTA opposes the concept of separate “Policy Guidance” on this issue. Indeed, Policy Guidance appears to be an inappropriate “back door” for modifying the UDRP or URS and could unintentionally open the door for further “Policy Guidance” that does not comport with the substantive or procedural requirements for ICANN policy-making. To the extent modifications to the UDRP or URS are needed to accommodate the substantive portion of Recommendation #2 concerning establishing standing based on Article 6ter, these could perhaps be implemented through supplemental rules issued by dispute resolution providers, to the extent necessary to properly apprise panelists of this basis for establishing standing by an IGO. However, as noted above, we believe URS and UDRP providers and panelists are already equipped under existing policies, procedures, and rules to address the standing requirements, including for IGOs, either on the basis of Article 6ter or on other grounds (e.g. evidence of common law rights) and that no further memorialization is needed to address this consideration.

Recommendation #3

ICANN shall create and issue Policy Guidance: (a) outlining the various procedural filing options available to IGOs, e.g. 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; and (b) advising IGOs and INGOs to, in the first instance and prior to filing a UDRP or URS complaint, contact the registrar of record to address the harms for which they are seeking redress. In addition, ICANN shall ensure that this Policy Guidance document is brought to the notice of the Governmental Advisory Committee (GAC) for its members’ and observers’ information and published along with the procedures and rules applicable to the UDRP and URS on the ICANN website.

² See, e.g., *European Monitoring Centre for Drugs and Drug Addiction (EMCDDA) v. Virtual Clicks / Registrant ID:CR36884430, Registration Private Domains by Proxy, Inc.*, Case No. D2010-0475 (WIPO July 7, 2010) (“The Complainant does not alternatively argue that it has common law rights in the acronym of its name. However the Panel has considered this option for completeness. Even though it is not argued by the Complainant, such a finding might be open to the Panel if there were sufficient evidence in the case file to support it.... The Complainant has, however, made no argument that it has such unregistered rights. As such, the Complainant has provided little evidence of the kind referred to in the [WIPO Overview](#), that might support a finding of unregistered rights. For these reasons, the Panel is not able to find that the Complainant has rights in an unregistered mark for EMCDDA for the purpose of the present Policy proceedings. Although recommendations have been made to ICANN that the Policy be expanded to apply also to certain emblems of international governmental organizations (see e.g. Report of the Second WIPO Internet Domain Name Process, September 3, 2001, recommendations 158 to 168), the Policy presently only applies to trade or service marks.”). We note that at the time of this UDRP proceeding, EMCDDA had not formally recorded this abbreviation with the International Bureau under Article 6ter of the Paris Convention, but the abbreviation was subsequently recorded as of 29 September, 2017.

³ See *id.*

INTA does not support Recommendation #3, because INTA believes it is unnecessary or ill-fit to achieve its ostensible purpose. As noted above, INTA generally does not support the use of “Policy Guidance” as a vehicle for addressing these issues. Furthermore, INTA does not understand the purpose or value of this recommendation, given that: (a) filing through an assignee, agent or licensee would not seem achieve the ostensible purpose of preserving the IGO’s potential jurisdictional immunity in the event of a subsequent lawsuit to challenge the URS or UDRP determination (due to basic agency principles); and (b) all parties, including IGOs or INGOs, already have the ability to contact any domain name registration authority, including the registrar, to address the harms for which they may otherwise seek redress through a URS or UDRP, just as non-IGO or non-INGO parties do. That said, INTA would defer to IGOs themselves to weigh in on these points, and in particular part (a) of this Recommendation #3.

Recommendation #4

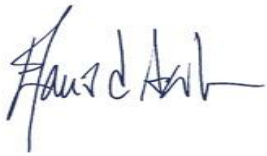
Notwithstanding GAC advice concerning access to curative rights processes for IGOs as well as the Charter language requiring the Working Group to consider “the need to address the issue of cost to IGOs and INGOs to use curative processes”, there was no support within the Working Group for a recommendation to provide subsidies to any party to use the UDRP or URS. Nevertheless, the Working Group recognizes that it has no authority to obligate the expenditure of ICANN funds, and it understands, further, that the feasibility of providing IGOs with access to the UDRP and URS at no or nominal cost to the IGOs is a question that must be addressed directly through discussions between the ICANN Board with the GAC and IGOs.

In general, INTA supports the lowering of UDRP and URS fees for all filers while still maintaining the integrity and quality of these systems. INTA disagrees as a procedural matter that the Working Group does not have the authority to recommend UDRP and/or URS fee waivers or subsidies to IGOs and INGOs.

That said, INTA does not understand the portion of this Recommendation indicating that the Working Group does not have the authority to “obligate the expenditure of ICANN funds” and therefore defers the substance of this matter to further discussion between the Board, GAC, and IGOs. While it is true that only the ICANN Board can literally direct expenditures of ICANN funds, a properly-constituted and Chartered GNSO PDP has all requisite authority to recommend policy changes or implementation steps that would, by extension, require allocation of ICANN resources. Accordingly, INTA disagrees with the suggestion that a final decision regarding whether or not to grant fee waivers or subsidies to IGOs or INGOs is not within this PDP’s authority to direct one way or another and is concerned by the suggestion that this discussion should be carried out through direct, non-PDP discussions between the Board, GAC, and IGOs. Of course, the GAC is free to provide its Advice to the Board on this topic, which the Board would consider pursuant to the Bylaws requirements. IGOs are also free to comment, and indeed GAC members and IGOs were all free to participate in the PDP in order to weigh in on this issue through the proper formal policy-development channels.

INTA thanks the ICANN Board for its consideration of our comments. If you require further information relating to this submission, please contact Lori Schulman, Senior Director, Internet Policy at lschulman@inta.org.

Sincerely,

A handwritten signature in black ink, appearing to read "Etienne Sanz de Acedo". The signature is fluid and cursive, with the first name "Etienne" being the most prominent.

Etienne Sanz de Acedo
Chief Executive Officer

About INTA and the Internet Committee

INTA is a 140-year-old global not for profit association with more than 7,200-member organizations from over 191 countries. One of INTA's goals is the promotion and protection of trademarks as a primary means for consumers to make informed choices regarding the products and services they purchase. During the last decade, INTA has also been the leading voice of trademark owners within the Internet Community, serving as a founding member of the Intellectual Property Constituency of the Internet Corporation for Assigned Names and Numbers (ICANN). INTA's Internet Committee is a group of over 200 trademark owners and professionals from around the world charged with evaluating treaties, laws, regulations and procedures relating to domain name assignment, use of trademarks on the Internet, and unfair competition on the Internet, whose mission is to advance the balanced protection of trademarks on the Internet.