Follow Up Questions to the IGO Small Group: Sovereign Immunity Issues

This ICANN Working Group (“WG”) is currently seeking to better understand the application and appropriate scope of the principle of sovereign immunity to international intergovernmental organizations (“IGOs”). The WG is aware that an IGO is commonly viewed as an organization established by an international treaty and which may possess international legal personality of its own, with members that generally (though not universally) consist of sovereign nation states. As such, the WG acknowledges that an IGO can enjoy special privileges and immunities under international law. For purposes of this Policy Development Process (“PDP”), the immunity in question would be immunity from the jurisdiction of a national court, i.e. jurisdictional immunity.

IGOs have informed ICANN that they rarely and only exceptionally rely on the Uniform Dispute Resolution Policy (“UDRP”) to address situations where a third party has registered an IGO’s name or acronym (or a confusingly similar variant) as a domain name, as the Policy requires a Complainant to agree to submit to the jurisdiction of a national court[[1]](#footnote-2) for purposes of a Respondent’s appeal from the decision of a UDRP panelist canceling or transferring the domain name in dispute.

In the course of our preliminary research, we came across a number of instances where IGOs on the GAC list of IGOs filed complaints under the UDRP, based largely on trademark rights that each organization held in its name and/or acronym in certain national jurisdictions. Several of these involved the Bank for International Settlements, and one the World Bank. While none concerned the registration of a domain name identical to the IGO’s acronym (the domain names in dispute included bisettlement.com[[2]](#footnote-3), bfisonline.net[[3]](#footnote-4), bisonlinedept.com[[4]](#footnote-5), bankforinternationalsettlement.com[[5]](#footnote-6), bfis.net[[6]](#footnote-7), bfois.org[[7]](#footnote-8) and worldbank.net[[8]](#footnote-9)) and bfois.org[[9]](#footnote-10)), the cases demonstrate certain instances when an IGO will decide to agree to the jurisdictional requirement of the UDRP. We therefore seek to better understand the nature of IGOs’ concern over use of the UDRP in the context of the sovereign immunity issue.

Our initial research into the topic of sovereign immunity indicates that in the evolution of modern public international law the concept of “absolute” immunity has largely given way to the more nuanced idea of “restricted” (or qualified) immunity, where the distinction will generally be drawn between whether the act in question is a public (or official) act or one of a more private character, e.g. if it involves a commercial transaction. It would appear that while states generally accept the abstract concept of sovereign immunity, they differ on the extent to which they will grant the immunity in particular cases, although there is recognition that immunity should respect the IGO’s essential purpose and related functions. Where IGOs are concerned, we are informed that a number of countries now consider such immunity to be functional only, i.e. to the extent necessary for the IGO to perform its functions and fulfill its objectives. We are aware that several countries have enacted legislation concerning the privileges and immunities to be granted to IGOs, and we understand that there is no clear single standard defining the scope and limits of jurisdictional immunity in all cases as a result of these developments. We also note that, under Article 6ter of the Paris Convention for the Protection of Industrial Property, protection for IGO names and abbreviations requires that an IGO first notify the World Intellectual Property Organization who, acting as intermediary, will communicate this to all States that are obligated to comply with the Convention; and a State may transmit an objection to extending such protection for up to twelve months following such communication.

The WG acknowledges the IGO Small Group’s note in its January 2015 response that the decision by an IGO to agree to the Mutual Jurisdiction requirement of the UDRP is made at the highest levels of the organization’s governance structure. While the WG believes that it will be a rare case where a Respondent who registers a domain name that is identical or confusingly similar to an IGO’s name or acronym and who loses in a UDRP filing will appeal the decision, we understand that the IGOs’ central concern is likely the fact that the Mutual Jurisdiction requirement is a blanket requirement in all cases, and as such needs to be agreed to at the very initial stages of filing a Complaint. Nevertheless, without such an appeals mechanism the UDRP could arguably preempt the right to judicial access of a losing respondent who wishes to seek court review.

As the WG has begun our research and deliberations into the scope of and possible solutions for this problem, we would greatly appreciate the IGO Small Group’s assistance with the following questions. We believe that your response will be very helpful in enabling us to fully understand the nature of the issue. Similarly, we will also be reaching out to the GAC for its input on the topic.

1. ***How do IGOs handle standard contract clauses on jurisdiction and choice of law in mass-market and other standard form contracts (e.g. when licensing software or entering into standard arrangements for the provision of goods and services)?***
2. ***When IGOs register their own second level domain names, how do they handle standard clauses in domain name registration agreements covering the binding nature of the UDRP as an ICANN Consensus Policy, governing jurisdiction and choice of law?***
3. ***When IGOs decide whether or not to file a complaint in a UDRP proceeding, is it relevant if the Mutual Jurisdiction specified is that of the registrar concerned or of the registrant/respondent?***
4. ***As the WG charter tasks us with gathering data and research on the topic, we would appreciate it if IGOs can provide specific recent examples demonstrating the extent of cybersquatting in respect of their acronyms. In addition, what is the scope of the problem in the gTLD space as compared to ccTLDs? How do IGOs deal with the issues of standing and sovereign immunity in dispute resolution proceedings involving ccTLDs where, e.g., the relevant policy also includes a Mutual Jurisdiction (or similar) clause[[10]](#footnote-11)?***
5. ***In view of the jurisdictional concerns, what are the forms of legal action that IGOs are likely to pursue when they believe their rights (including those beyond the domain name system or trademark law) are infringed[[11]](#footnote-12)? For example, are there inter-governmental, national or other legal or judicial mechanisms that IGOs can use that do not involve a waiver of immunity? Would a mechanism by which an IGO member state acts on the IGO’s behalf in the event of an appeal be appropriate (e.g. if the Mutual Jurisdiction requirement specified that, for IGOs, it has to be a jurisdiction of one of its member states)? Alternatively, would a provision that expressly limited submission to jurisdiction only to that specific dispute involving that specific domain name and registrant alleviate IGOs’ concerns?[[12]](#footnote-13)***
6. ***Since the adoption of the UDRP, has an IGO on the GAC list pursued legal action in a national court against an alleged cybersquatter or trademark infringer[[13]](#footnote-14)? Besides juridical and other remedies at law, what other means do IGOs use to pursue cybersquatters (e.g. contact the registrar in question, web hosting companies or payment processors)?***
7. ***A major concern with removing the Mutual Jurisdiction requirement is that this would raise due process issues and prejudice an individual’s right of access to courts, e.g. if the role of the court were replaced by a binding private arbitral mechanism. It could also change the nature of the UDRP from an optional supplement to juridical determination under national laws to a preemptive procedure. What substantive or procedural safeguards can be put into place that can adequately replace the diminution of such a right and assure due process?***
1. In accordance with Paragraph 3(b)(xiii) of the Rules applicable to the UDRP, the Complainant has to submit, with respect to any challenges that may be made by the Respondent to a decision in the administrative proceeding canceling or transferring the domain name, to the jurisdiction of the courts in at least one specified Mutual Jurisdiction, meaning a court jurisdiction in the location of either: (a) the Registrar (if this is what is agreed to by the Respondent in its Registration Agreement); or (b) the Respondent’s address at the time of the Complaint, as shown in the Registrar’s Whois database. The WG notes that the UDRP is a mandatory administrative proceeding designed to be faster and cheaper than most court proceedings; it is an optional addition to and not a preemptive substitute for a Complainant or Respondent’s rights and remedies under applicable law, including access to the judicial system. As an ICANN Consensus Policy, it is binding on all ICANN registries and registrars (who are contractually bound to ICANN) and thus applies to all registrants of domain names in the gTLD space. The Policy can be viewed in its entirety at <https://www.icann.org/resources/pages/policy-2012-02-25-en>. [↑](#footnote-ref-2)
2. See <http://www.wipo.int/amc/en/domains/decisions/html/2004/d2004-0571.html> (Bank for International Settlements v BIS of Staten Island, Case No. D2004-0571). [↑](#footnote-ref-3)
3. See <http://www.wipo.int/amc/en/domains/decisions/html/2004/d2004-0575.html> (Bank for International Settlements v Fortune Nwaiwu, Case No. D2004-0575). [↑](#footnote-ref-4)
4. See <http://www.wipo.int/amc/en/domains/decisions/html/2003/d2003-0987.html> (Bank for International Settlements v James Elliott, Case No. D2003-0987). [↑](#footnote-ref-5)
5. See <http://www.wipo.int/amc/en/domains/decisions/html/2003/d2003-0986.html> (Bank for International Settlements v BIS, Case No. D2003-0986). [↑](#footnote-ref-6)
6. See <http://www.wipo.int/amc/en/domains/decisions/html/2003/d2003-0984.html> (Bank for International Settlements v BFIS, Case No. D2003-0984). [↑](#footnote-ref-7)
7. See <http://www.wipo.int/amc/en/domains/decisions/html/2004/d2004-0570.html> (Bank for International Settlements v. G.I. Joe, Case No. D2004-0570). [↑](#footnote-ref-8)
8. See <http://www.wipo.int/amc/en/domains/decisions/html/2002/d2002-0222.html> (International Bank for Reconstruction & Development d/b/a The World Bank v. Yoo Jin Sohn, Case No. D2002-0222). [↑](#footnote-ref-9)
9. See <http://www.wipo.int/amc/en/domains/decisions/html/2004/d2004-0570.html> (Bank for International Settlements v. G.I. Joe, Case No. D2004-0570). [↑](#footnote-ref-10)
10. E.g., as is the case in .eu (<http://eu.adr.eu/html/en/adr/adr_rules/eu%20adr%20rules.pdf>) and .uk (http://www.nominet.org.uk/disputes/when-use-drs/policy-and-procedure/drs-procedure). [↑](#footnote-ref-11)
11. The Working Group has been informed that some IGOs may rely on national governments or governmental agencies to bring suitIn addition, we have seen that a third party may hold trademark rights for the benefit of an IGO and thus be able to file a UDRP complaint on behalf of that IGO, e.g. in Lenz & Staehelin Ltd. v Christopher Mikkelson (<http://www.wipo.int/amc/en/domains/search/text.jsp?case=D2012-1922>), national and regional trademark rights in the term Unitaid were registered by a law firm in its own name but for the benefit of the World Health OrganizationCan you confirm and elaborate on such arrangements? [↑](#footnote-ref-12)
12. The WG understands that some of these possibilities may create broader immunity issues beyond the domain name context and is seeking to understand the impediments faced by IGOs in exploring these alternatives. [↑](#footnote-ref-13)
13. Although these preceded the development and adoption of the UDRP, the following two cases are examples of where an IGO on the GAC list has initiated legal action against an alleged trademark infringer in a United States federal district court: <http://mm.icann.org/pipermail/gnso-igo-ingo-crp/attachments/20150311/414ba4d3/WorldBank-v-WorldBankLimited-docket-0001.pdf> and <http://mm.icann.org/pipermail/gnso-igo-ingo-crp/attachments/20150311/414ba4d3/UnitedNationsChildrensFund-v-Art95-docket-0001.pdf> (these cases concerned the World Bank and UNICEF, respectively). [↑](#footnote-ref-14)