**QUESTIONS ON JURISDICTIONAL IMMUNITY FOR INTERNATIONAL GOVERNMENTAL ORGANIZATIONS**

**I. Background**

We write to seek your assistance in ensuring that we have an accurate understanding of the current position in public international law on the issue of immunity from the jurisdiction of national courts for international governmental organizations (“IGOs”) as it applies to the litigation of trademark disputes arising out of or in connection with the UDRP.

We are the co-chairs of an ICANN Working Group (“WG), chartered to consider whether ICANN’s current dispute resolution processes - which enable trademark owners to seek either a transfer, cancellation or suspension of an identical or confusingly similar domain name registered by a third party in bad faith (among other criteria) – should be amended to better address the needs of IGOs and international non-governmental organizations. The dispute resolution processes in question are set forth in:

(a) the Uniform Dispute Resolution Policy (“UDRP”), and its accompanying Rules, both of which have been in place since 1999 (a copy of which may be found at <http://archive.icann.org/en/udrp/udrp-policy-24oct99.htm> and <http://archive.icann.org/en/udrp/udrp-rules-24oct99.htm>, respectively); and,

(b) the Uniform Rapid Suspension procedure (“URS”), which was created recently as a rights protection mechanism for the new gTLD program (a copy of which may be found at <http://newgtlds.icann.org/en/applicants/urs/procedure-01mar13-en.pdf> and <http://newgtlds.icann.org/en/applicants/urs/rules-28jun13-en.pdf>, respectively).

Both the UDRP and URS are mandatory administrative proceedings, the terms and rules of which are incorporated by reference within each domain name registration agreement. As such, a registrant of a domain name must contractually agree to the provisions of the UDRP and URS as a condition for registering a domain name. Although mandatory for domain name registrants, neither the UDRP nor the URS are the exclusive means of dispute resolution. The UDRP and URS apply only in the event a third party files an appropriate complaint. Litigation may be commenced prior to, during or subsequent to a UDRP or URS[[1]](#footnote-1). Both the UDRP and URS provide:

In the event of any legal proceedings initiated prior to or during a URS proceeding in respect to the domain-name that is the subject of the Complaint, the Examiner shall have the discretion to decide whether to suspend or terminate the URS proceeding, or to proceed to a Determination.[[2]](#footnote-2)

UDRP and URS disputes are resolved by third party providers “approved” by ICANN (“ADR Providers”)[[3]](#footnote-3). Upon filing of the complaint, the ADR Provider provides notice of the Complaint to the domain name registrar and to the registrant using the information provided in the WHOIS record for the domain name. The domain name registrant (“Respondent”) has a fixed period in which to file its response. In the UDRP context, a Respondent may require that the dispute be considered by either a single panelist or a three-member panel (in the case of a 3-member panel, one panelist is selected by the ADR Provider with the 2nd and 3rd panelist being selected by the ADR provider from a list of up to 5 nominees identified by the Complainant and Respondent respectively). Once constituted the panel reviews the complaint and any response, making a decision based upon filings submitted, without in-person-hearings or oral testimony.

To prevail on a complaint, the Complainant must prove that (1) the domain name is identical or confusingly similar to a trademark mark in which the Complainant has rights; (2) the domain registrant has no legitimate rights or interests in the domain; ; and (3) the domain was both registered and is being used in bad faith. The complainant must demonstrate these factors by a preponderance of the evidence in a UDRP action, and by clear and convincing evidence in a URS. The URS has an internal appeals mechanism. The UDRP does not. The filing of a URS does not preclude an unsuccessful Complainant from subsequently filing a UDRP against the same Respondent.

**I. The Issue**

The WG understands that some IGOs have expressed concerns to ICANN about the requirement in the UDRP that a Complainant agree to a “Mutual Jurisdiction”. The concerned IGOs have expressed the position that the requirement to select a Mutual Jurisdiction conflicts with their rights of immunity. The requirement that a Complainant agree to one of two defined “Mutual Jurisdictions” is a condition precedent to the filing of a UDRP complaint[[4]](#footnote-4). Mutual Jurisdiction is defined identically in both the UDRP[[5]](#footnote-5) and URS[[6]](#footnote-6) as follows:

“**Mutual Jurisdiction** means a court jurisdiction at the location of either (a) the principal office of the Registrar (provided the domain-name holder has submitted in its Registration Agreement to that jurisdiction for court adjudication of disputes concerning or arising from the use of the domain name) or (b) the domain-name holder's address as shown for the registration of the domain name in Registrar's Whois database at the time the complaint is submitted to the Provider.”

The WG is currently seeking to better understand the application and scope of the principle of immunity to IGOs; specifically, jurisdictional immunity. 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 may (though not universally) consist of sovereign nation states. As such, the WG acknowledges that it is possible that IGOs can enjoy special privileges and immunities under international law under some circumstances. We seek understanding as to whether, but for the requirement to select a Mutual Jurisdiction, immunity would apply in the case of the UDRP or URS, thereby shielding the IGO from litigation arising out of or in connection with their asserted trademark.

In the course of our preliminary research, we have come across a number of instances where, notwithstanding any jurisdictional concerns, IGOs have successfully filed complaints under the UDRP. Because these cases demonstrate that there are times (even if these turn out to be exceptional) when an IGO will decide to agree to the jurisdictional requirement of the UDRP, we are seeking to better understand the nature of IGOs’ concern over mandatory administrative proceedings in the context of jurisdictional immunity.

Our initial research into the topic of indicates to us that there is ***no universal legal rule that defines a single scope of jurisdictional immunity for IGOs***. Our sense is that modern public international law has evolved such that the concept of “absolute” immunity has largely given way to the more nuanced idea of “restricted” (or qualified) immunity. It would appear to us that while States generally accept the abstract concept of IGO immunity, they differ on the extent to which they will grant the immunity in particular cases[[7]](#footnote-7). Further, an increasing number of countries now consider such immunity to be functional only. Thus, while immunity may be recognized for acts inherently related to the IGO’s performing its public functions, it may not be recognized for acts of a commercial nature. Many of the WG are of the opinion that trademark disputes are inherently commercial in nature such that “functional” immunity would not bar litigation.

The WG is further aware also that a distinction may need to be drawn between a State (or government) and an IGO, given their different natures and the diversity of types of IGOs. We are informed that the distinction may matter on issues such as the source of jurisdictional immunity – such as whether this is derived from treaty or from customary international law[[8]](#footnote-8) – and in relation to specific questions such as when a particular IGO will be recognized as possessing legal personality within a particular country.

 As a final background matter, our WG has reached a preliminary decision that an IGO *may* have the requisite trademark rights to satisfy the standing requirements for filing a UDRP or URS complaint if it has opted for the protections afforded by Article 6ter of the Paris Convention. It is our understanding that the Paris Convention affords “trademark-like” registration rights to IGOs to the extent such registration is recognized by Convention signatories.

The WG is concerned that a potential policy recommendation that ICANN remove the existing rules pertaining to litigation and “Mutual Jurisdiction” could preempt the right to judicial access of a respondent who wishes to resort to formal court proceedings instead of the informal, streamlined and non-evidentiary nature of the URDP or URS. The UDRP and URS were intended as a speedy alternative to traditional litigation and were drafted as a result of a consensus-driven process, which sought to balance the rights of the respective parties. The WG believes that neither the UDRP nor the URS should be seen as a platform for altering pre-existing rights or conflicting with existing or developing principals of law..

We would therefore greatly welcome your expertise and advice on this matter, which would assist us in fully understanding the state of public international law in regards to jurisdictional immunity for IGOs.

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**3. Questions**

1. ***Is the Working Group’s understanding of the evolution and current status of IGO jurisdictional immunity (as summarized above) correct under general principles of public international law?***
	1. ***Are there additional principles, nuances or other relevant information (including specific treatment under differing national laws) that you think may be helpful for us to be aware of as we continue our work?***
2. ***Given that many, if not all, states require proof of ‘use in commerce’ in either granting trademark registration or maintaining valid trademark rights, is the mere assertion of trademark rights or the filing of a UDRP or URS complaint by an IGO, sufficient to preclude the assertion of immunity by an IGO?***
3. ***But for the existence of the “Mutual Jurisdiction” selection in the UDRP or URS context, is a complaining IGO entitled to immunity in connection with judicial action brought by a domain name registrant arising from the asserted conflict between the IGO’s asserted trademark and the domain name registrant’s registration or use of a domain name?***
4. ***To the best of your knowledge, how do IGOs generally handle standard contractual clauses (e.g. in software or services agreements) concerning submission to a particular jurisdiction or dispute resolution method?***
5. ***Are there methods which an IGO may take to escape or avoid becoming subject to judicial action brought by a domain name registrant arising from the asserted conflict between the IGO’s asserted trademark and the domain name registrant’s registration or use of a domain name? [[9]](#footnote-9)***

On behalf of our Working Group, we thank you in advance for your consideration of these questions. If you are unsure as to any matter being requested, please do not hesitate to contact us for clarification. Your reply, as well as any additional comments/information that you may wish to make, will be important for our better understanding the needs of IGOs’ concerning the immunity issue and our eventual policy recommendations on how to solve any problems and/or ambiguities.

Sincerely,

Philip Corwin & Petter Rindforth (Working Group co-chairs)

**ANNEX A: LIST OF SELECTED COUNTRIES WITH LEGISLATION CONCERNING IGO IMMUNITIES**

***Australia*** – the *Foreign States Immunities Act* (1985), granting immunity to foreign States as well as individuals or corporations that are their agencies and instrumentalities, subject to certain exceptions (including a “commercial transactions” exception)

***Canada*** – the *State Immunity Act* (1985), granting immunity to foreign States, their political subdivisions and agencies, subject to certain exceptions (including a “commercial activity” exception); also the *Foreign Missions and International Organizations Act[[10]](#footnote-10)* (1991), granting immunity to IGOs[[11]](#footnote-11) similar to that enjoyed by the UN under the relevant UN Convention (see below)

***Malaysia*** – the *International Organizations (Privileges and Immunities) Act* (1992), applying the two Conventions protecting the UN and its specialized agencies (see below) as well as extending protection to other international organizations to be designated from time to time by the Minister for Foreign Affairs

***The United Kingdom*** – the *International Organisations Act (1968)*, granting immunity to those IGOs that the UK is a member[[12]](#footnote-12) of and that have been recognized to have legal personality by an Order in Council

***The United States*** – the *Foreign Sovereign Immunities Act* (1976), granting immunity to foreign States, their political subdivisions, agencies and instrumentalities, subject to certain exceptions (including a “commercial activity” exception); also, the *International Organizations Immunities Act* (1945), granting IGOs “the same immunity from suit and every form of judicial process as is enjoyed by foreign governments”.

Note: Because the IOIA predates the FSIA, we understand that there is some disagreement amongst US courts and academics as to whether the more restrictive provisions of the FSIA now apply also to IGOs – this arises because the IOIA was enacted when the prevailing theory of immunity was more of an absolute one.

1. Both the UDRP and URS are 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 applies to all domain name registrants by way of their registration agreements with registrars. [↑](#footnote-ref-1)
2. UDRP, Rule 18(a); URS, Rule 17(a). [↑](#footnote-ref-2)
3. ICANN maintains no contractual relationship with any ADR Provider and does not manage or control the actions of any ADR Provider or their panelists. [↑](#footnote-ref-3)
4. UDRP, Rule 3(b)(xiii); URS, Rule 3(b)(ix. [↑](#footnote-ref-4)
5. UDRP, Rule 1 (Definitions). [↑](#footnote-ref-5)
6. UDRP, Rule 1 (Definitions). [↑](#footnote-ref-6)
7. See Appendix A for a list of illustrative laws in select countries that the WG came across as part of our research. [↑](#footnote-ref-7)
8. Our limited research on the case law on this seems to show the position to be rather fragmented, with conflicting decisions in some countries (e.g. Belgium, France, Germany, Italy) and a more prevalent view in others (e.g. the Netherlands courts have tended to recognize IGO immunity as being based on customary international law). [↑](#footnote-ref-8)
9. The WG has been informed that some IGOs may rely on national governments or governmental agencies to bring suit. In addition, we have found cases where a third party (e.g. a law firm) holds trademark rights in its own name for the benefit of an IGO and thus is able to file a UDRP complaint on behalf of that IGO. [↑](#footnote-ref-9)
10. We note that this statute contains a definition of “international organization”, meaning “an intergovernmental organization, whether or not established by treaty, of which two or more states are members”; this seems more specific than the definition used in the Vienna Convention. [↑](#footnote-ref-10)
11. We found the most current list of IGOs that have been granted protection in Canada at <http://laws-lois.justice.gc.ca/eng/acts/F-29.4/>. [↑](#footnote-ref-11)
12. For those IGOs where the UK is not a member, we note the Act can still apply if the organization “maintains or proposes to maintain an establishment in the UK”. [↑](#footnote-ref-12)