**STAFF BRIEFING NOTE ON THE POSSIBILITY OF A DE NOVO APPEALS MECHANISM UNDER THE UDRP FOR IGOs**

**Background**

In 2002, the WIPO General Assembly (GA) adopted a recommendation from its Standing Committee on Trademarks, Industrial Designs and Geographical Indications (SCT) to amend the UDRP to protect IGO names and abbreviations[[1]](#footnote-1), and formally noted that most (though not all) delegations favored some form of protection for country names against their registration or use as domain names by persons unconnected with the constitutional authorities of the country in question and where registration would cause confusion as to source. We note here that the preliminary agreement reached by our Working Group (WG) relating to standing under, and scope of, the UDRP for IGOs is essentially what the SCT had recommended – viz., a claim must be founded on an IGO’s actually having gone through the Article 6ter notification and communication process, and is to be limited only to cases where the respondent’s use of the IGO acronym is as a trademark or service mark.

**The Question of an Appeal from a UDRP Determination by a Losing Respondent**

In 2003, at the request of the SCT, the WIPO Secretariat prepared a paper that outlined a special de novo appeals procedure 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”.

The 2003 Secretariat paper[[2]](#footnote-2) recognized that a losing respondent’s ability to go to a national court in a convenient forum is an important due process safeguard; as such, the following were recommended as minimum elements for such a procedure (the following is the exact language from the paper):

*(1) The parties should be able to restate their case completely anew.  They should not be confined to claiming that the UDRP panel did not consider certain relevant facts or wrongly applied the UDRP, but should also be able to submit new evidence and new factual or legal arguments.*

*(2) 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.*

*(3) 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 UDRP decision*

*(4) 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.*

Additionally, the paper recommended that, provided the losing respondent initiates the appeal process within the prescribed time limit (e.g. 14 days), the domain name should remain in locked status and not be cancelled or transferred pending the outcome of the appeal.

Importantly, the paper seems to contemplate that the Mutual Jurisdiction clause may **NOT** need to be removed and replaced. Instead, it recommends the following – when filing the complaint, the State has to agree to the de novo appeal mechanism. It will be for the losing respondent to decide whether or not to initiate such an appeal. Once he/she does so, then final determination of the case will be resolved through the appeal procedure, and the possibility of challenge in a national court will then be precluded.

**Notes:**

It is important to remember that this outline was presented not specifically for the case of IGOs, but to apply to country names (hence the focus on State, rather than IGO, immunity). It is not clear, however, that this is a substantive difference when the general issue is about ensuring due process safeguards for losing respondents, so the process outlined in the 2003 paper may still be useful for the WG to discuss.

The SCT discussed the paper at its 2003 meeting and the following countries expressed reservations about the process - Australia, Canada, Japan, and the USA, for reasons ranging from the cost and burden of such a process (Canada) to doubting the need for it (Australia) since certain countries had already filed UDRP complaints[[3]](#footnote-3) and thus presumably submitted to the national jurisdiction of a court. The US delegation’s reservations (supported by Japan) were summarized in the official Report of the meeting in this way:

*“… an arbitral appeal mechanism would contribute to eliminating the four most important due process safeguards of the UDRP: the possibility of broad court review, the limitation of the procedure to narrow causes of action, the limitation of available remedies, and the limitation to trademark rights for which there is a firm basis in international law. The Delegation expressed concern that this might undermine the legitimacy of the UDRP as a whole.”*

Denmark, New Zealand, Sweden and Switzerland supported such an appeals mechanism while the Netherlands stated that it had no definite view on the matter but was not convinced it was necessary.

As a result, the SCT did not come to agreement and no recommendation or further formal action on the matter was taken.

1. See <http://www.wipo.int/amc/en/processes/sct/decision/index.html> for the text of the GA decision. Note that the USA disassociated itself from this recommendation: see <http://www.wipo.int/edocs/mdocs/sct/en/sct_s2/sct_s2_8.pdf> for the full SCT deliberations and report. [↑](#footnote-ref-1)
2. <http://www.wipo.int/edocs/mdocs/sct/en/sct_11/sct_11_5.pdf>. The paper also includes discussion of considerations as to place, applicable substantive law, whether or not to use one or more arbitral institutions, fees/cost, applicable rules for the proceedings, and language issues. [↑](#footnote-ref-2)
3. In the SCT deliberations, these were noted to be Canada, Germany, the Netherlands and New Zealand. [↑](#footnote-ref-3)