

# ICANN | GNSO

Generic Names Supporting Organization

## Initial Report on the IGO-INGO Access to Curative Rights Protection Mechanisms Policy Development Process

### Status of This Document

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This is the Initial Report of the GNSO IGO-INGO Access to Curative Rights Protection Mechanisms Policy Development Process Working Group. This report contains the Working Group's preliminary recommendations and is being posted for public comment.

### Preamble

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The objective of this Initial Report is to document the Working Group's deliberations on the issues raised by its Charter, and describe its preliminary recommendations and any open issues the Working Group will consider before it issues its Final Report after a review of all public comments received on this report. The Final Report will be submitted to the GNSO Council in accordance with the motion that was proposed and carried during the Council teleconference meeting on 5 June 2014, and that resulted in the creation of this Working Group.

This Report or parts thereof may be translated into different languages; please note that only the English version is authoritative.

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## 1 Executive Summary

### 1.1 Introduction

In June 2014, the GNSO Council launched this Policy Development Process (PDP) and tasked the Working Group to determine whether, in order to address the specific needs and circumstances of international governmental organizations (IGOs) and international non-governmental organizations (INGOs): (1) the curative rights protection mechanisms currently in place for both existing and new generic top level domains (gTLDs) should be amended and, if so, in what respects; or (2) a separate, narrowly-tailored dispute resolution procedure modeled on the existing curative rights protection mechanisms should be developed.

As currently designed, IGOs and INGOs may encounter certain difficulties relying on these curative mechanisms, namely, the Uniform Dispute Resolution Policy (UDRP) and Uniform Rapid Suspension procedure (URS), to protect their names and acronyms against abuse. For IGOs, since the procedural rules for both processes require that the party filing the complaint state its agreement to submit to the jurisdiction of a national court for purposes of a challenge to the initial panel determination, this could potentially affect their ability to successfully claim immunity from national jurisdiction. In addition, both processes were originally designed to be mechanisms to protect the rights of trademark owners, and while some IGOs and INGOs might own trademarks in either their organizational names or acronyms or both, this is not necessarily true in all cases.

On 5 June 2014, the GNSO Council initiated this PDP and on 25 June 2014 it chartered this IGO-INGO Access to Curative Rights Protection Mechanisms Working Group. A Call for Volunteers to the Working Group (WG) was issued on 11 July 2014, and the WG held its first meeting on 11 August 2014.

### 1.2 Preliminary Recommendations

The WG Charter specifically directed the WG to examine the following questions: *“whether to amend the UDRP and URS to allow access to and use of these mechanisms by IGOs and INGOs and, if so in what respects; or whether a separate, narrowly-tailored dispute resolution procedure at the second level modeled on the UDRP and URS that takes into account the particular needs and specific circumstances of IGOs and INGOs should be developed.”* Following its analysis of each of the questions outlined in its Charter related to this task, the WG has arrived at a set of preliminary recommendations and conclusions for which it is seeking community input. Following its review of all feedback received to this Initial Report, the WG will prepare a Final Report and conduct a formal consensus call on all of its proposed final recommendations. The Final Report, which will contain all the WG’s final recommendations and include the designation of the WG’s consensus levels for each recommendation, will then be submitted to the GNSO Council for its review and action.

**Recommendation #1:**

The Working Group recommends that no changes to the UDRP and URS be made, and no specific new process be created, for INGOs (including the Red Cross movement and the International Olympic Committee). To the extent that the Policy Guidance document referred to elsewhere in this set of recommendations is compiled, the Working Group recommends that this clarification as regards INGOs be included in that document.

**Recommendation #2:**

For IGOs, in order to demonstrate standing to file a complaint under the UDRP and URS, it should be sufficient for an IGO (as an alternative to and separately from an IGO holding trademark rights in its name and/or acronym) to demonstrate that it has complied with the requisite communication and notification procedure in accordance with Article 6*ter* of the Paris Convention for the Protection of Industrial Property<sup>1</sup>. For clarity, the Working Group recommends that a Policy Guidance document pursuant to the UDRP and URS be prepared and issued to this effect for the benefit of panelists, registrants and IGOs.

**Recommendation #3:**

The WG does not recommend any specific changes to the substantive grounds under the UDRP or URS upon which a complainant may file and succeed on a claim against a respondent (e.g. as listed in Section 4(a)(i) – (iii) of the UDRP). However, the WG proposes that the Policy Guidance document referred to in Recommendation #2 includes a further recommendation that UDRP and URS panelists should take into account the limitation enshrined in Article 6*ter*(1)(c) of the Paris Convention in determining whether a registrant against whom an IGO has filed a complaint registered and used the domain name in bad faith.

**Recommendation #4:**

In relation to the issue of jurisdictional immunity, which IGOs may claim successfully in certain circumstances (but not INGOs), the WG recommends that: (a) no change be made to the Mutual Jurisdiction clause of the UDRP and URS; (b) the Policy Guidance document initially described in Recommendation #2 (above) also include a section that outlines 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; such that (c) claims of jurisdictional immunity made by an IGO in respect of a particular jurisdiction will be determined by the applicable laws of that jurisdiction.

Where an IGO succeeds in asserting its claim of jurisdictional immunity in a court of mutual jurisdiction<sup>2</sup>, the Working Group recommends that in that case:

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<sup>1</sup> Full text of Article 6*ter* of the Paris Convention can be found here:

[http://www.wipo.int/article6ter/en/legal\\_texts/article\\_6ter.html](http://www.wipo.int/article6ter/en/legal_texts/article_6ter.html) and in Annex D of this report.

<sup>2</sup> The WG notes that the determination in each case as to whether or not the IGO in question may successfully plead immunity is a question that each court decides according to its own law. It is not within the purview of ICANN to make any recommendations in respect of a judicial determination of this legal issue.

*Option 1 - the decision rendered against the registrant in the predecessor UDRP or URS shall be vitiated; or*

*Option 2 – the decision rendered against the registrant in the predecessor UDRP or URS may be brought before the [name of arbitration entity] for de novo review and determination.*

The WG recommends, further, that the Policy Guidance document referred to in Recommendation #2 (above) be brought to the notice of the Governmental Advisory Committee (GAC) for its and its members' and observers' information.

**An Important Note regarding Recommendation #4:**

The WG has yet to conclude which of the additional two options outlined above represents the optimal approach, or if a third alternative is preferable. As such, the WG has identified a number of different factors, including possible policy benefits and problems, to consider when examining the various options. Please see Section 2 of this Initial Report for further detail and context. The WG welcomes specific input from the community on this open question.

**Recommendation #5:**

In respect of GAC advice concerning access to curative rights processes for IGOs, the Working Group recommends that ICANN investigate the feasibility of providing IGOs and INGOs with access to the UDRP and URS (in line with the recommendations for accompanying Policy Guidance as noted in this report), at no or nominal cost, in accordance with GAC advice on the subject.

### 1.3 Deliberations and Community Input

The WG began its work with a review of historical documentation and related materials on the topic. This included work done previously in and by the ICANN community, including a GNSO Issue Report from 2007 on the topic of Dispute Handling for IGO Names & Abbreviations (which did not result in a PDP at that time due to a lack of GNSO Council votes) as well as reference materials from outside sources (e.g., treaty texts and reports from international organizations).

As required by the GNSO's PDP Manual, the WG reached out to all ICANN Supporting Organizations and Advisory Committees as well as GNSO Stakeholder Groups and Constituencies with a request for input at the start of its deliberations. All responses received were reviewed by the WG and incorporated into its deliberations for each of its Charter questions. The WG also encouraged the participation of IGOs, and sought their input on a number of questions relating to problems that IGOs had highlighted concerning their use of existing curative rights processes.

In addition to reviewing historical documents and related materials, the WG also considered relevant legal instruments and applicable international law. To assist it with this work, the WG sought the expertise of international legal experts. At the WG's request, ICANN engaged Professor Edward Swaine of George Washington University, USA, to prepare a legal memo on the scope of international law concerning jurisdictional immunity of IGOs. The WG also considered GAC advice relevant to the topic.

Finally, the WG reviewed a proposal from the IGO Small Group, comprising a number of IGO and GAC representatives who had been working with ICANN Board members and staff on a proposal that, among other things, presented some alternatives concerning protection for IGO acronyms for the GAC's and the GNSO's consideration.

## 1.4 Conclusions and Next Steps

This Initial Report will be posted for public comment for at least forty (40) days, in accordance with ICANN policy procedures. After the WG reviews all the public comments received on this report, it will complete this section documenting its final conclusions and submit its Final Report to the GNSO Council.

## 2 Working Group Preliminary Recommendations

The WG was chartered to provide the GNSO Council with policy recommendations regarding the issues identified in the Final Issue Report that preceded and informed the GNSO Council's decision to initiate this PDP<sup>3</sup>.

Following its analysis of each of the questions outlined in its Charter related to this task, the WG has arrived at a set of preliminary conclusions and recommendations. This Section 2 sets out the full text of all of the WG's preliminary conclusions, including any supplemental notes and relevant background information taken into account by the WG when developing these recommendations.

The WG believes that its final recommendations, if approved by the GNSO Council and the ICANN Board, will result in substantial improvement and clarity regarding IGOs' access to curative rights protection mechanisms.

### 2.1 The WG's Preliminary Recommendations

#### 2.1.1 Text of the Preliminary Recommendations and Relevant Background Information

The following preliminary recommendations are being published by the WG for public comments. All input received will be reviewed by the WG, and if deemed appropriate, incorporated into the WG's Final Report. This review process may result in amendments or updates to the preliminary recommendations contained in this Initial Report.

Several open questions on which the WG has yet to reach preliminary agreement or for which the WG would like to seek community input prior to finalizing its recommendations on those topics are also listed in this Section; in particular, community feedback is sought on whether Option 1 or Option 2 in relation to Recommendation #4, or some other alternative formulation, is preferred.

##### **General**

The Charter that was approved by the GNSO Council tasked the WG with examining the following questions: "whether to amend the UDRP and URS to allow access to and use of these mechanisms by IGOs and INGOs and, if so in what respects or whether a separate, narrowly-tailored dispute resolution procedure at the second level modeled on the UDRP and URS that

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<sup>3</sup> See <https://gns0.icann.org/en/issues/igo-ingo-crp-access-final-25may14-en.pdf>.

takes into account the particular needs and specific circumstances of IGOs and INGOs should be developed.”

The WG’s preliminary answers to these questions are no<sup>4</sup>, although the WG also identifies and suggests ways in which IGOs can have standing to access the protections of the UDRP and URS without registering trademarks in their names and acronyms, and can substantially insulate themselves from jurisdictional immunity concerns. Reasons for these conclusions, and specific recommendations pertaining to specific questions arising within the scope of its Charter, are described below. Essentially, the WG concluded that, for IGOs, the most prudent and advisable approach would be to not recommend any changes to the UDRP or URS at this time, given:

- (1) the ability for an IGO to file a complaint under the UDRP and URS via an assignee, licensee or agent;
- (2) the WG’s recommendation (below) that even in the absence of national trademark protections or common law rights an IGO may fulfill the “standing” requirement under the UDRP and URS as long as the IGO has completed the requisite notifications and communications procedure under Article 6*ter* of the Paris Convention for the Protection of Industrial Property;
- (3) the extremely limited probability of a scenario where an IGO might wish to assert immunity against a losing respondent in a national court, having already filed and won a UDRP or URS complaint from which the respondent appeals;
- (4) the WG’s potential further recommendation (below) that where an IGO successfully asserts jurisdictional immunity against a respondent in those limited cases which a losing respondent may file in a national court an arbitral appeal can be made;
- (5) recognition and preservation of a registrant’s longstanding legal right to appeal to a court of competent jurisdiction combined with ICANN’s questionable authority to deny such judicial access; and
- (6) the lack of a single, universally applicable rule in relation to IGO jurisdictional immunity.

For INGOs, the WG concluded relatively early on in its deliberations that these organizations have the ability to file (and many times have filed) UDRP and URS complaints by virtue of having national trademark and/or common law rights, and that – unlike IGOs – INGOs stand in the same legal position as other private parties and do not have the additional challenge of wanting to safeguard any possible jurisdictional immunity they may have against a respondent. As a result, the WG came to the conclusion that there is no principled reason to modify the UDRP

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<sup>4</sup> As detailed in Section 3.3 of this report ([Review of Legal Instruments, Legal Expert Opinion and Other External Source Materials](#)), IGOs and INGOs that have legally protected their names or acronyms can access, and some have already made use of, the UDRP and URS, even in the absence of potential recommendations from this WG.



and/or URS, or create a separate dispute resolution procedure, to address the needs of INGOs (see Recommendation #1 and Section 3 of this report, below, for the rationale).

**Recommendation #1: The WG recommends that no changes to the UDRP and URS be made, and no specific new process be created, for INGOs (including the Red Cross movement and the International Olympic Committee). To the extent that the Policy Guidance document referred to elsewhere in this set of recommendations is compiled, the WG recommends that this clarification as regards INGOs be included in that document.**

One of the first topics discussed by the WG was whether or not the specific needs and concerns of IGOs and of INGOs were of a similar nature, and whether such needs and concerns warranted policy changes to the UDRP and URS. The WG's initial conclusion is that the specific needs and concerns of INGOs are adequately addressed by the current dispute resolution processes (e.g., UDRP and URS) and that there was no principled reason to recommend any modifications to the UDRP or URS, or the creation of a new curative rights process for INGOs.

The following is the WG's rationale for its conclusion that the UDRP and URS do not need to be amended in order to address the needs and concerns of INGOs, and that a new curative rights process applicable to INGOs is not necessary<sup>5</sup>:

1. Many INGOs already have, and do enforce their trademark rights. There is no perceivable barrier to other INGOs obtaining trademark rights in their names and/or acronyms and subsequently utilizing those rights as the basis for standing in the existing dispute resolution procedures (DRPs) created and offered by ICANN as a faster and lower cost alternative to litigation. For UDRP and URS purposes they have the same standing as any other private party.
2. Unlike IGOs, who may claim and sometimes be granted jurisdictional immunity in certain circumstances, INGOs have no such claim and are not hindered from submitting to the jurisdiction of national courts under the Mutual Jurisdiction clause within the existing DRPs. The WG's research revealed that some INGOs regularly use the UDRP to protect their rights.
3. Although some INGOs may be concerned about the cost of using the UDRP and the URS, because enforcement through these rights protection mechanisms involves some expenditure of funds, this is not a problem for all INGOs nor is it unique to INGOs as among all rights holders. Furthermore, the issue of ICANN subsidizing

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<sup>5</sup> The rationale described in this Section were also sent to all ICANN Supporting Organizations (SOs), Advisory Committees (ACs) and GNSO Stakeholder Groups and Constituencies as part of the WG's solicitation of input from these groups in December 2014, as required by the GNSO's PDP Manual. As highlighted in Section 3 of this report, no objection to this preliminary conclusion or the rationale was raised by any SO, AC or other ICANN community group.

INGOs to utilize DRPs is outside the scope of the WG's Charter, and it has no authority to obligate any party (including ICANN) to subsidize the rights protection of another.

4. The WG found that, as of end-2015, the United Nations Economic and Social Council (ECOSOC) list of non-governmental organizations in consultative status consists of nearly 4,000 organizations, of which 147 organizations were in general consultative status, 2,774 in special consultative status, and 979 on the Roster. The WG notes that there might be many more organizations not presently on the ECOSOC list who might claim the right to utilize any new curative rights process created for INGOs. The WG felt that the sheer scale of INGOs, in combination with the factors cited above, weighed against the creation of a special DRP for INGOs, especially as they could not be readily differentiated from other private parties, including other non-profit organizations.

In relation to the Red Cross and the International Olympic Committee, the WG noted that although these INGOs had been specifically highlighted by the GAC as enjoying international legal treaty protections and rights under multiple national laws, for the purposes of this PDP these organizations have demonstrated that: (1) they have ready access to the UDRP and the URS; and (2) they possess strong trademark rights that they vigorously defend and enforce. As such, for the limited purpose of considering INGO access to curative rights protections, the WG determined there was no principled reason to distinguish them from other INGOs. The WG further noted that legal representatives of the International Olympic Committee participated actively in the WG and fully support this conclusion.

#### Additional Background to this Recommendation

The following two paragraphs are taken substantially from the Final Issue Report that outlined the scope of this PDP, and are provided herein as further background to this issue.

1. As recognized in the Final Issue Report scoping out this PDP, the scope of the UDRP and URS as drafted currently applies only to second level domain name disputes where the complainant has legal rights in a trademark or service mark, and the complaint alleges that the respondent's domain name is identical or confusingly similar to that trademark or service mark. The Final Issue Report had also noted that not all IGOs and INGOs will have trademarks in their names and acronyms, and that during the development of the Applicant Guidebook (AGB) for the New gTLD Program, while certain objection procedures and trademark rights-protection mechanisms had been created, the AGB did not contain any specific rules that pertained exclusively to either preventative (i.e. prevent the harm from occurring by excluding an identifier from registration or delegation) or curative (i.e. an organization that claims to have suffered harm is able to file a dispute to cure the defect or problem) rights protections for IGOs or INGOs related directly to their status as international organizations. Rather, the AGB prescribed that organizations that met the existing criteria for a .int registration could avail themselves of the legal rights objection process, and organizations that owned trademark and other intellectual property rights in their names and/or acronyms could

participate in the new Trademark Clearinghouse and the associated sunrise and Trademark Claims notice processes<sup>6</sup>

2. The AGB also contained top-level protections for certain Red Cross (RC) and International Olympic Committee (IOC) identifiers, through which these RC and IOC identifiers would be reserved and thus withheld from delegation under the New gTLD Program. Both the RC and IOC are INGOs. Subsequently, interim second-level protections for certain RC and IOC and for a specific list of IGO names and acronyms provided by the GAC was granted in response to advice from the GAC.

It is important to note that the second-level protections noted above were granted on an interim basis to allow new gTLDs to begin launching while policy development and consultations continued on the topic of what would be the appropriate second level protections for RC and IOC names and acronyms, and IGO acronyms.

**Recommendation #2: For IGOs, in order to demonstrate standing to file a complaint under the UDRP and URS, it should be sufficient for an IGO (as an alternative to and separately from an IGO holding trademark rights in its name and/or acronym) to demonstrate 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<sup>7</sup>. For clarity, the WG recommends further that a Policy Guidance document pursuant to the UDRP and URS be prepared and issued to this effect for the benefit of panelists, registrants and IGOs.**

Under the UDRP and URS, the first substantive element that a complainant must satisfy under both procedures is that the complainant has rights in a trademark or service mark. Most UDRP panelists have read this requirement as a requirement for standing to file a complaint<sup>8</sup>, and it is generally accepted that the threshold may be satisfied by establishing either ownership or exclusive license rights in the trademark or service mark<sup>9</sup>. The WG considered this requirement in the context of IGOs, with particular reference to the trademark protections offered to IGOs under Article 6ter of the Paris Convention for the Protection of Intellectual Property. The WG came to a preliminary conclusion that, based on Article 6ter, IGOs which have complied with the communications and notifications procedure described in that treaty provision will have satisfied the standing requirement of the UDRP and URS.

The WG is aware that, by considering IGOs who have fulfilled the requirements of Article 6ter as also fulfilling the standing requirement of the UDRP and URS, this means that the number and range of IGOs that would come within this category will be different from, and potentially larger

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<sup>6</sup> See, e.g., page 4 of the Final Issue Report (<https://gnso.icann.org/en/issues/igo-ingo-crp-access-final-25may14-en.pdf>).

<sup>7</sup> Full text of Article 6ter of the Paris Convention can be found here: [http://www.wipo.int/article6ter/en/legal\\_texts/article\\_6ter.html](http://www.wipo.int/article6ter/en/legal_texts/article_6ter.html) and in Annex D of this Initial Report.

<sup>8</sup> See, e.g., Halpern, Nard & Port, "Fundamentals of United States Intellectual Property Law: Copyright, Patent, Trademark" (Kluwer Law International, 2007).

<sup>9</sup> See the WIPO Overview 2.0 (<http://www.wipo.int/amc/en/domains/search/overview2.0/>).

than, the list of IGOs provided to ICANN by the GAC in 2013 and as updated by the GAC from time to time<sup>10</sup>. While this may represent a broadening of the UDRP and URS to more IGOs than may have initially been contemplated by the GAC, the WG believes that reliance on Article 6ter for the limited purpose of demonstrating standing will not necessarily result in an increased number of complaints, in view of the other factors to be considered by an IGO prior to filing a complaint (such as submission to the Mutual Jurisdiction clause of the UDRP and URS, which may be interpreted to intrude upon any jurisdictional immunity an IGO may have) and the other substantive components of the UDRP and URS that will still need to be shown.

The WG is also aware that Article 6ter does not in and of itself confer substantive legal rights, or national trademark rights, on an IGO. However, the WG's analysis of Article 6ter would seem to indicate that its inclusion in an international treaty signals a desire by States to afford some level of protection against unauthorized third party attempts to register an IGO's name or acronym as a trademark. For the limited purpose of standing to file a complaint under the UDRP and URS, the WG considers that this is sufficiently analogous to the corresponding requirement in the trademark law context that the complainant possess rights in a trademark. ***For the avoidance of doubt, this also means that IGOs that have not complied with the communications and notification procedure prescribed by Article 6ter (e.g. in terms of filing a notification as required) should not be deemed to have fulfilled the standing requirement under the UDRP and URS (in the absence of their possessing registered trademark or common law rights in the IGO name or acronym at issue).***

To enshrine this recommendation as part of binding Consensus Policy and/or contractual agreement with ICANN's contracted parties, the WG also recommends that a Policy Guidance document be prepared that will describe the scope of the standing issue for IGOs, as well as any other points that may warrant clarification should the GNSO Council and the ICANN Board accept these PDP recommendations.

#### Additional Background to this Recommendation

##### *A. Purpose, Scope and Limitations of Article 6ter*

The purpose of Article 6ter is to protect armorial bearings, flags and other State emblems of the States party to the Paris Convention<sup>11</sup> as well as official signs and hallmarks indicating control and warranty adopted by them. This protection was extended to armorial bearings, flags, other emblems, ***abbreviations and names*** of international intergovernmental organizations by the Revision Conference of Lisbon in 1958.

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<sup>10</sup> The current GAC list of IGOs for which appropriate protection was sought for their names and acronyms was sent to ICANN by the GAC in March 2013. It can be viewed here:

<https://www.icann.org/en/news/correspondence/dryden-to-crocker-chalaby-annex2-22mar13-en.pdf>

<sup>11</sup> Note that, as a result of the TRIPS Agreement which came into effect in January 1995, the obligations for States party to the Paris Convention also became applicable to any State that becomes a member of the World Trade Organization, regardless of whether that State also signed up to the Paris Convention individually.

Under paragraph 6(1)(a) of Article 6ter, the States that are party to the Paris Convention “agree to refuse or to invalidate the registration, and to prohibit by appropriate measures the use, without authorization by the competent authorities, either as trademarks or as elements of trademarks, of armorial bearings, flags, and other State emblems, of the countries of the Union, official signs and hallmarks indicating control and warranty adopted by them, and any imitation from a heraldic point of view.” Under paragraph 6(1)(b), the protections described by paragraph (a) “shall apply equally to armorial bearings, flags, other emblems, **abbreviations, and names**, of international intergovernmental organizations of which one or more countries of the Union are members, with the exception of armorial bearings, flags, other emblems, abbreviations, and names, that are already the subject of international agreements in force, intended to ensure their protection”.

It should be noted that paragraph (c) clarifies that States “shall not be required to apply the said provisions when the use or registration referred to in subparagraph (a), above, is not of such a nature as to suggest to the public that a connection exists between the organization concerned and the armorial bearings, flags, emblems, abbreviations, and names, or if such use or registration is probably not of such a nature as to mislead the public as to the existence of a connection between the user and the organization.” As discussed further below, the WG believes that this limitation on the extent of the obligations of States in relation to Article 6ter is likely to be and should be taken into account by UDRP and URS panelists in considering whether the registrant has registered and used the domain name in question in bad faith.

*B. The Communications Procedure to be followed by IGOs under Article 6ter<sup>12</sup>*

Under Article 6ter, States and IGOs wishing to avail themselves of the protections have to follow a prescribed procedure. This requires the sending of a communication regarding the particular sign or emblem for which protection is sought to the International Bureau of WIPO, which will then communicate it to the other States party to the Paris Convention. The current WIPO communication procedure involves the periodical electronic publication by WIPO of those signs and emblems (including IGO names and acronyms) for which protection under Article 6ter is being requested, in what is known as the Article 6ter Express Database (<http://www.wipo.int/ipdl/en/6ter/>). The nature of the names and acronyms concerned as well as the IGO that has requested their protection is published, in English and French, together with the individual reproductions of the names and acronyms concerned.

The electronic publication is made on a semi-annual basis, on the last working day of the months of March and September. A link to the most recent communications is inserted into the database, which indicates the communications that were received by WIPO during the six months previous to the most current publication. The date of publication is considered to

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<sup>12</sup> See <http://www.wipo.int/article6ter/en/communication.html> for a description of the communications procedure, and [http://www.wipo.int/article6ter/en/general\\_info.html](http://www.wipo.int/article6ter/en/general_info.html) for general information about Article 6ter.

constitute the date of receipt of the communication by individual States party to the Paris Convention and any other party bound to apply Article 6<sup>ter</sup> of the Paris Convention<sup>13</sup>.

There does not appear to be any procedure by which any publication may be investigated, examined, or challenged. In this regard the inclusion within the database bears similarity to registrations in jurisdictions that do not subject trademark registrations to an investigatory process. The WG notes that UDRP panels have typically found trademark registrations that are automatic or unexamined (such as US state registrations as opposed to US federal registrations) are not owed the same deference under the UDRP as examined registrations<sup>14</sup>. By stating its position above regarding the acceptance of Article 6<sup>ter</sup> notification as conferring standing under the UDRP, the WG is not intending to alter existing UDRP jurisprudence or suggesting that the pre-existing standards used by UDRP panelists with regard to the recognition of trademarks obtained via an automated or unexamined process be altered in any manner.

**Recommendation #3: The WG does not recommend any specific changes to the substantive grounds under the UDRP or URS upon which a complainant may file and succeed on a claim against a respondent (e.g. as listed in Section 4(a)(i) – (iii) of the UDRP). However, the WG proposes that the Policy Guidance document referred to in Recommendation #2 includes a further recommendation that UDRP and URS panelists should take into account the limitation enshrined in Article 6<sup>ter</sup>(1)(c) of the Paris Convention in determining whether a registrant against whom an IGO has filed a complaint registered and used the domain name in bad faith.**

In the view of the WG, a UDRP or URS panelist's/panel's finding that the use and registration of the domain name in question is of such a nature as to suggest to the public that a connection exists between the IGO concerned and the registrant, or that such use and registration is likely of such a nature as to mislead the public as to the existence of a connection between the respondent-registrant and the IGO in question, should be considered as indicative of bad faith.

**Recommendation #4: In relation to the issue of jurisdictional immunity, which IGOs (but not INGOs) may claim successfully in certain circumstances (but not INGOs), the WG recommends that: (a) no change be made to the Mutual Jurisdiction clause of the UDRP and URS; (b) the Policy Guidance document initially described in Recommendation #2 (above) also include a section that outlines 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; such that (c) claims of jurisdictional immunity made by an IGO in respect of a particular jurisdiction will fall to be determined by the applicable laws of that jurisdiction. Where an IGO succeeds in asserting its claim of jurisdictional immunity in a court of mutual jurisdiction<sup>15</sup>, the WG recommends that in that case:**

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<sup>13</sup> See <http://www.wipo.int/article6ter/en/communication.html>. The specific process for IGOs is also detailed by WIPO at <http://www.wipo.int/article6ter/en/igos.html>.

<sup>14</sup> See, e.g., Para 1.1, *WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition* ("WIPO Overview 2.0"), World Intellectual Property Organization (2011).

<sup>15</sup> The Working Group notes that the determination in each case as to whether or not the IGO in question may successfully plead immunity is a question that each court decides according to its own national law. It

***Option 1 - the decision rendered against the registrant in the predecessor UDRP or URS shall be vitiated or***

***Option 2 – the decision rendered against the registrant in the predecessor UDRP or URS may be brought before the [name of arbitration entity] for de novo review and determination.***

**The WG recommends, further, that the Policy Guidance document referred to in Recommendation #2 (above) be brought to the notice of the Governmental Advisory Committee (GAC) for its and its members' and observers' information.**

In presenting Options 1 and 2 above, the WG acknowledges that it has yet to conclude which of the two options represents the optimal approach, or if a third alternative is preferable. As such, the WG has identified a number of different factors, including possible policy benefits and problems, to consider when examining the various options. Accordingly, the WG welcomes specific input from the community on this question, to aid it in developing its final recommendations.

For context, the WG anticipates that the circumstances under which this scenario would occur – viz., where an IGO files a complaint under the UDRP or URS, the IGO succeeds in the dispute resolution process, and the losing respondent then seeks relief against the IGO with respect to that UDRP or URS decision in a national court – will be rare. As noted above, IGOs are able to file complaints through an assignee, licensee or agent.

The WG also notes that, where a losing registrant proceeds to file a complaint in a court against the UDRP or URS decision, a question for the court might be whether or not, by submitting to the Mutual Jurisdiction clause, an IGO will be deemed to have waived any jurisdictional immunity it may otherwise have. Consequently, whether or not Option 1 or 2 is ultimately selected by the WG as a final recommendation and possible refinement to the UDRP and URS, a court could find that any immunity that may have been claimed by an IGO in respect of an appeal brought before the court by a losing registrant was lost simply by the IGO having filed the UDRP or URS complaint. This possibility is not new, and exists in the current environment under the present language of the Mutual Jurisdiction clause. It will not change regardless of whether Option 1 or 2 is followed.

Further discussion of Option 1:

*“The decision rendered against the registrant in the predecessor UDRP or URS shall be vitiated.”*

- By vitiating the decision against the registrant in a UDRP or URS in the circumstance where an IGO has successfully claimed jurisdictional immunity, this would put the

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is not within the purview of ICANN to make any recommendations in respect of a judicial determination of this legal issue.

parties in a situation as if the UDRP did not exist (or as if a UDRP complaint had never been filed). In other words, the court proceedings would continue to be the sole mechanism to resolve the dispute.

- However, while the possibility of vitiating a decision against the registrant in a UDRP or URS in the circumstance where an IGO successfully claims jurisdictional immunity will not affect the right and ability of a losing registrant to seek relief in a court of competent jurisdiction, will adding this possibility have the effect of leaving an IGO with minimal choices (i.e. either waive jurisdictional immunity and defend the suit or seek jurisdictional immunity and thereby risk having the UDRP or URS decision vitiated)?
- Similarly, will introducing this option affect the likelihood that an IGO will file a UDRP or URS complaint in the first place rather than allow the conduct complained of to continue by not filing? The WG notes that this is a matter of individual decision making on the part of each IGO and will also depend on the facts of each case. Nevertheless, the WG believes it essential to fully explore the implications of adding a new component to the UDRP and URS.
- Nevertheless, use of a court of competent jurisdiction as a means to resolve commercial disputes are well-established.
- In addition, consideration may need to be given to the legal implications of setting aside a panel determination on the basis of a result in an unrelated proceeding (i.e. the successful claiming of jurisdictional immunity by an IGO).

#### Further discussion of Option 2:

*“The decision rendered against the registrant in the predecessor UDRP may be brought before the [name of arbitration entity] for de novo review and judgment.”*

- One disadvantage to registrants of the option to allow use of an arbitral or other third party non-judicial process is that this mechanism is unfamiliar to registrants, e.g. the use of arbitration in contractual disputes or proceedings, such as under the United Nations Commission on International Trade Law (UNCITRAL) Rules.
- One advantage to IGOs of the option to allow use of yet another arbitral or other third party non-judicial process is that this mechanism is familiar to IGOs, e.g. the use of arbitration in contractual disputes or proceedings, such as under the United Nations Commission on International Trade Law (UNCITRAL) Rules.
- Introducing this option would require that a registrant agree to such an appeal mechanism up front, in the form of a new provision in the domain name registration agreement – this would necessitate a consensus policy decision which would obligate all ICANN-accredited registrars to amend their registration agreements accordingly.
- A critical question in this regard is whether the provision of yet another de novo review in the form of an arbitral or other third party non-judicial mechanism is similar or equivalent in terms of access, fairness and the scope of relief it would offer a registrant compared to seeking relief via a court of competent jurisdiction.
- [Would adding binding arbitration without recourse to national courts create a risk that the jurisprudence developed under such a system diverges from and becomes disconnected from that developed in national courts, without the ability to reconcile those differences? Would this exacerbate the risk of forum shopping?](#)



- Nevertheless, the UNCITRAL Rules and the use of arbitration as a means to resolve commercial disputes are well-established.
- However, will adding the possibility of allowing use of yet another arbitral or other third party non-judicial process familiar to IGOs have the effect of leaving a registrant with no, or limited, choices (i.e. either be involuntarily submitting to a second layer of arbitral or other third party non-judicial process or have the registrant's domain name taken from the registrant)?
- Similarly, will introducing this option affect the likelihood that a registrant will not contest a UDRP or URS complaint in the first place rather than respond and challenge a complaint through multiple layers of non-judicial processes? The WG notes that this is a matter of individual decision making on the part of each registrant and will also depend on the facts of each case. Nevertheless, the WG believes it essential to fully explore the implications of adding a new component to the UDRP and URS.
- Consideration will also have to be given to amending the UDRP and URS to allow for this new appeal mechanism.

The WG has discussed both options extensively, but has not reached a firm conclusion on a recommendation incorporating either option. However, at the time of publication of this Initial Report, a majority of Working Group members have expressed support for Option 1. Following community feedback on this point, the Working Group will conduct a consensus call to try to determine the level of consensus on a particular approach.

#### Additional Background to this Recommendation

##### *A. Notes on the WG's consultation with an external legal expert on the issue of IGO jurisdictional immunity*

For the purposes of understanding the scope and limitations of public international law in relation to the issue of IGO jurisdictional immunity, the WG requested that ICANN engage an external legal expert to advise the WG of the current state of the law on this topic. Professor Edward Swaine of George Washington University in the USA was engaged following a detailed evaluation by the WG of the qualifications of other interested candidates<sup>16</sup>.

Professor Swaine's final expert opinion was delivered to the WG in June 2016<sup>17</sup>. In sum, Professor Swaine's opinion was that:

*There is no single universal rule that is applicable to IGOs' jurisdictional immunity globally. Rather, such immunity is essentially contextual - IGOs generally enjoy immunity under international law, but different jurisdictions apply the law differently, and even within the same jurisdiction different IGOs may be treated differently:*

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<sup>16</sup> For details about the criteria agreed on for this engagement, see the WG's wiki space at <https://community.icann.org/x/z4BYAw>.

<sup>17</sup> For the full text of Professor Swaine's memo, see Annex E of this Initial Report and the WG's wiki space at <https://community.icann.org/x/z4BYAw>.

- *Immunity obligations vary by state and by IGO concerned;*
- *Immunity decisions are often based on organization-specific treaties to which not all states are party;*
- *States subject to the same international obligations may implement them in varying ways; and*
- *Every jurisdiction resolves immunity questions according to its own law (the “law of the forum”, as informed by international law)*

*On the other hand, under the UDRP and URS, a complainant is compelled to consent to a Mutual Jurisdiction (defined as either the domain name registrar or registrant) for purposes of an appeal from a panel’s initial determination of a complaint. Thus, an IGO that files a complaint will therefore have agreed to the possibility of a judicial process, regardless of any immunity it might otherwise enjoy under international law.*

According to Professor Swaine, under current international law principles as understood generally, there are three types of jurisdictional immunity which an IGO might claim – absolute, restrictive and functional. An IGO that is entitled to absolute immunity would be entitled to comprehensive immunity from judicial process, irrespective of the nature of the IGO’s activity, in the absence of an express (and strictly construed) waiver (for example, the United Nations and other IGOs protected in certain States by specific treaties binding those States, or bilateral arrangements between States). Under a restrictive immunity approach, however, an exception from absolute immunity is made for litigation concerning commercial activities like those undertaken by private parties – however, with the notable exception of the United States, relatively few states have adopted this approach. The WG notes in this regard that the UDRP and URS were designed to apply to trademark related disputes, which are generally viewed as commercial in nature. Finally, under a functional immunity approach, an IGO’s immunity with respect to a particular jurisdiction is limited to the functions of the IGO in question. For example, certain jurisdictions may have legislative language which limit the extent of IGO jurisdictional immunity to the “privileges and immunities as are reasonably necessary for the fulfilment of their functions”. While a functional immunity approach can overlap with a restrictive immunity approach, the distinction may be critical – for instance, a non-infringing use of its domain may be necessary for an IGO to carry out its mission regardless of whether the activities are commercial or not in nature. However, without discounting the importance of loss of monies, impact to reputation, or other harms that may result from an infringed domain, the WG is not able to say for certain that a third party’s infringing registration of a domain name would necessarily impede an IGO in carrying out its core mission within the scope of a functional immunity inquiry.

The WG agreed with Professor Swaine’s assessment and concluded that “*there is no single universal rule that is applicable to IGOs’ jurisdictional immunity globally.*” This lack of a universal rule made it challenging to justify declaring the mutual jurisdiction provisions in the UDRP and URS inapplicable to IGOs, as an IGO’s immunity is highly dependent upon the particular jurisdiction and the nature of the specific IGO, amongst other factors. Accordingly, the WG did not feel it was appropriate to create a separate, narrowly-tailored dispute resolution procedure.

Professor Swaine also analyzed how, outside the domain name arena, IGOs are generally able to waive their jurisdictional immunity, and he noted that there seems to be two main ways to accomplish this: (1) through the IGO’s governing instrument (though Professor Swaine noted

that the exact scope of this can be unclear); or (2) by way of agreement or pleading (for which option the case law is not well developed), but Professor Swaine expressed the thought that an IGO's agreeing to a Mutual Jurisdiction under the UDRP or URS could be interpreted as a waiver.

In essence, Professor Swaine's legal conclusion in relation to an IGO's jurisdictional immunity for purposes of a domain name dispute under the UDRP or URS was that "[a]llowing an IGO that prevailed in the UDRP process to avoid its waiver and rest on the UDRP result by invoking immunity, while allowing it to waive that immunity by initiating judicial proceedings if it loses to a domain-name registrant, will likely seem asymmetrical and unfair." Based on Professor Swaine's expert opinion, the WG came to the conclusion that it would not be possible to recommend a single solution that takes into account all the varying types of IGOs, their activities and the different approaches of multiple national courts and the potential facts of a hypothetical UDRP or URS filing. Nevertheless, the WG has strived to find an outcome that respects and preserves an IGO's assertion of jurisdictional immunity as well as a registrant's right to appropriate legal recourse.

*B. The WG's consideration of Professor Swaine's suggestions and the available policy options*

Professor Swaine's opinion was largely focused on the question of what might happen in the case where an IGO files a complaint under the UDRP or URS and wins at the administrative proceedings phase, in which event a losing respondent would then be able to file a *de novo* appeal in a national court against that initial determination. In view of this focus, various policy options were identified for addressing the IGOs' concern over losing the possibility of jurisdictional immunity for this type of proceeding.

In this regard, the WG discussed the following policy options:

**(i) Make a distinction among different types of IGOs:**

- This option would maintain the existing Mutual Jurisdiction terms in general, but permit particular IGOs to elect instead to submit to arbitration. An option for such arbitration would be the arbitration rules under the United Nations Commission for International Trade Law (UNCITRAL) or some similar, internationally recognized procedure.
- In line with Professor Swaine's analysis, the most likely IGOs that would be able to elect an arbitration option would be the United Nations and its constituent bodies (e.g. WIPO, WTO, WHO).

**(ii) Rewrite the Mutual Jurisdiction clause under the UDRP and URS, but without prejudging the outcome where an IGO pleads jurisdictional immunity:**

- Adopting this option would mean that IGO immunity is not to be assumed in circumstances where the relevant jurisdiction would not be inclined to afford it (e.g. its courts apply a functional or restrictive approach and regard the activity as beyond the scope of immunity). Essentially, this option would leave the determination of an IGO's jurisdictional immunity from domain name disputes in any particular jurisdiction to the judgment of that particular national court.
- If this option were to be adopted by the WG, Professor Swaine suggested that additional language (in the form of an exception) could be added to the UDRP and URS as follows:

*“In the event the action depends on the adjudication of the rights of an international intergovernmental organization that would, but for this provision, be entitled to immunity from such judicial process according to the law applicable in that jurisdiction, [as established by a decision of a court in that jurisdiction,] the challenge must be submitted instead for determination [by UNCITRAL in accordance with its rules].”*

The WG also noted that Professor Swaine also highlighted the possibility that any hardship endured by a respondent as a result of submission to an arbitral process should be alleviated, e.g. by the IGO’s agreeing to bear a proportion of the costs incurred. The WG presumed, given the stated desire of IGOs to have access to curative rights protections at no or exceedingly low cost, that such an approach would elicit objections from them.

The WG spent considerable time reviewing Professor Swaine’s notes and final memo, including in open sessions at the ICANN Public Meetings in Marrakech (March 2016) and Helsinki (June 2016). It also considered the applicability and scope of the UNCITRAL Arbitral Rules<sup>18</sup> to domain name disputes between IGOs and registrants, and noted that the issue of immunity is likely to arise only in those limited cases where a losing respondent (against an IGO complainant, who would have agreed to the Mutual Jurisdiction clause in order to file and proceed with its complaint) files an appeal against the UDRP or URS determination.

Ultimately, the WG concluded that, in relation to the issue of immunity, given: (1) the limited instances of a scenario where an IGO would assert immunity against a losing respondent in a national court, having already filed and won a UDRP or URS complaint; (2) recognition and preservation of a registrant’s longstanding right to appeal to a court of competent jurisdiction; and (3) the lack of a single, universally applicable rule in relation to IGO jurisdictional immunity, the most prudent and advisable approach would be to not recommend any changes to the UDRP or URS at this time.

### *C. Other research and documentation taken into account by the WG on this issue*

Besides Professor Swaine’s expert views, the WG also considered research and prior work done on this topic. This included the August 2003 report from the WIPO Secretariat on a possible arbitral appeal mechanism for domain name disputes involving country names, which could conceivably also apply to IGO names and acronyms<sup>19</sup>. The WG notes that, in this report, the

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<sup>18</sup> For the full text of the UNCITRAL Arbitral Rules, see [http://www.uncitral.org/uncitral/en/uncitral\\_texts/arbitration/2010Arbitration\\_rules.html](http://www.uncitral.org/uncitral/en/uncitral_texts/arbitration/2010Arbitration_rules.html).

<sup>19</sup> See [www.wipo.int/edocs/mdocs/sct/en/sct\\_11/sct\\_11\\_5.doc](http://www.wipo.int/edocs/mdocs/sct/en/sct_11/sct_11_5.doc). The WG acknowledges that, in this report, the WIPO Secretariat noted that “[i]n order 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, WIPO member States also recommended to allow IGOs to submit to a special appeal procedure by way of *de novo* arbitration rather than to the jurisdiction of certain national courts of justice”. However, for reasons stated in the main text, the Working Group respectfully disagrees with this proposal and notes, further, that in the General Assembly report of the proceedings at hand, there was not agreement on the need to protect IGO names and acronyms and

WIPO Secretariat expressly stated that the following principles ought to apply if a *de novo* arbitration process is to be created:

- The parties should be able to restate their case completely anew. They should not be confined to claiming that the panel did not consider certain relevant facts or wrongly applied the procedure, but should also be able to submit new evidence and new factual or legal arguments;
- 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;
- 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 initial decision; and
- 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

From publicly available information reviewed by the WG, it appears that no further action was taken on the above-noted *de novo* arbitral appeal mechanism. In light of the fact that it has been over a decade since that proposal was scoped, and given that the WG’s recent research revealed that some IGOs do in fact waive their immunity and submit to the Mutual Jurisdiction clause in bringing a UDRP action<sup>20</sup>, the present circumstances do not justify amending the UDRP and URS in order to provide IGOs with broad immunity protections.

In this regard, the WG notes that GAC advice to the ICANN Board in relation to this issue was that the UDRP should not be amended<sup>21</sup>.

The Working Group recognizes that IGOs may not welcome the fact that adoption of this recommendation by ICANN will mean that IGOs will still have to agree to the Mutual Jurisdiction clause of the UDRP and URS when filing a complaint under either procedure. Nevertheless, in view of the concerns listed in the paragraph immediately above this one, and the other Policy Guidance principles that the WG is recommending be applied to IGO complaints (e.g. standing under Article 6*ter* of the Paris Convention), the totality of these recommendations will improve the protections of the rights of IGOs in their names and acronyms.

**Recommendation #5: In respect of GAC advice concerning access to curative rights processes for IGOs, the WG recommends that ICANN investigate the feasibility of providing IGOs and**

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country names in this manner (see WO/GA/28/7:

[http://www.wipo.int/edocs/mdocs/govbody/en/wo\\_ga\\_28/wo\\_ga\\_28\\_7.pdf](http://www.wipo.int/edocs/mdocs/govbody/en/wo_ga_28/wo_ga_28_7.pdf)).

<sup>20</sup> See, e.g., the resources and links compiled by the WG at <https://community.icann.org/x/48PhAg>.

<sup>21</sup> See, e.g., the GAC Communique from the Los Angeles ICANN meeting held in October 2014:

<https://www.icann.org/en/system/files/correspondence/gac-to-board-15oct14-en.pdf>.

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**INGOs with access to the UDRP and URS (in line with the recommendations for accompanying Policy Guidance as noted in this report), at no or nominal cost, in accordance with GAC advice on the subject.**

The WG notes that its Charter does not authorize it to make recommendations that would create an obligation for ICANN or any other party to provide subsidies for particular groups of complainants, or that would otherwise require ICANN to cover the costs (whether in full or substantially) of any particular entity's filing of a UDRP or URS complaint. Nevertheless, in view of GAC advice on the topic<sup>22</sup>, it is within its scope to recommend that ICANN investigate the feasibility of providing IGOs and INGOs with the ability to file UDRP and URS complaints at no or minimal cost.

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<sup>22</sup> See, e.g., the GAC's Los Angeles Communique (October 2014):  
<https://www.icann.org/en/system/files/correspondence/gac-to-board-15oct14-en.pdf>.

## 3 Deliberations of the Working Group

### 3.1 Review of Existing Materials

The WG began its work with a review of the historical documentation and related materials on the topic. This included both the records of prior ICANN community work as well as materials from other sources (such as treaty texts and reports from international organizations, in particular, WIPO<sup>23</sup>). To review these materials, the WG formed three Sub Groups – Sub Group A focused on the current state of the UDRP and URS<sup>24</sup>, Sub Group B on the number of IGOs and INGOs that could come under consideration as well as the scope of their existing legal protections<sup>25</sup>, and Sub Group C on ICANN’s historic treatment of these two groups of organizations<sup>26</sup>. ICANN staff also conducted research on the existence of national trademark registrations in a number of jurisdictions for selected IGO and INGO names and acronyms<sup>27</sup>.

A partial list of the more significant documents and materials that were reviewed includes:

- The 2001 Final Report on the Second WIPO Internet Domain Name Process (also known as the “WIPO-2 Process”)<sup>28</sup>
- The 2003 WIPO Secretariat Paper on a Possible De Novo Appeal Mechanism for Country Names<sup>29</sup>
- The 2004 Final Report of ICANN’s Joint Working Group on the WIPO-2 Process
- The 2005 WIPO Paper on Legal and Administrative Aspects of Article 6ter<sup>30</sup>
- The 2007 GNSO Issue Report on Dispute Handling for IGO Names and Abbreviations<sup>31</sup>
- The 2007 ICANN Staff Report and Draft Text for a Dispute Resolution Process for IGO Domain Names<sup>32</sup>
- The 2013 Final Report of the PDP Working Group on Protection of IGO and INGO Identifiers in All gTLDs<sup>33</sup>

<sup>23</sup> See the WG’s wiki page at <https://community.icann.org/x/DrvhAg> for a compilation of these sources.

<sup>24</sup> Sub Group A has a wiki page at <https://community.icann.org/x/mRbxAg> showing its task list and status updates.

<sup>25</sup> Sub Group B has a wiki page at <https://community.icann.org/x/mxbxAg> showing its task list and status updates.

<sup>26</sup> Sub Group C has a wiki page at <https://community.icann.org/x/nRbxAg> showing its task list and status updates.

<sup>27</sup> The scope of this limited initial research and lists of organizations can be viewed on the WG’s wiki page at <https://community.icann.org/x/wi4QAw>.

<sup>28</sup> <http://www.wipo.int/export/sites/www/amc/en/docs/report-final2.pdf>.

<sup>29</sup> [http://www.wipo.int/meetings/en/doc\\_details.jsp?doc\\_id=18680](http://www.wipo.int/meetings/en/doc_details.jsp?doc_id=18680).

<sup>30</sup> [http://www.wipo.int/edocs/mdocs/sct/en/sct\\_15/sct\\_15\\_3.doc](http://www.wipo.int/edocs/mdocs/sct/en/sct_15/sct_15_3.doc).

<sup>31</sup> <https://gns0.icann.org/en/issues/igo-names/issues-report-igo-drp-15jun07.pdf>.

<sup>32</sup> <https://gns0.icann.org/drafts/gns0-igo-drp-report-v2-28sep07.pdf>.

<sup>33</sup> <https://gns0.icann.org/en/issues/igo-ingo-final-10nov13-en.pdf>.

In addition, the WG reviewed the GAC Communiqués and other GAC advice and correspondence that had been published concerning the issue of protection for IGO names and acronyms<sup>34</sup>. ICANN staff also prepared several Briefing Papers and background notes on a number of external sources and reports to assist with the WG's review and deliberations.

The following summary highlights the salient aspects of the above-referenced documents:

- The 2001 Final Report on the Second WIPO Internet Domain Name Process contains a recommendation that the names and acronyms of IGOs benefiting from protection under Article 6ter of the Paris Convention be protected from abusive registrations of domain names within the domain name system (DNS). The recommendation for protection was by way of a special administrative procedure to be developed and supervised by the constituent members of IGOs (namely, States), and enforced within the DNS through the ICANN system. Notably, the Report acknowledged that, at least in cases not involving the use of domain names as trademarks, establishing such a procedure would require the creation of new international law.
- The 2003 WIPO Secretariat Paper on a Possible De Novo Appeal Mechanism for Country Names noted that WIPO member States had recommended that the UDRP should be modified to allow IGOs to file complaints in respect of the abusive registration of their protected names and acronyms, but that a number of IGOs, including the United Nations, had indicated that they could not participate in a dispute resolution process which, like the UDRP, would require the organization to submit to the jurisdiction of national courts upon appeal. It therefore recommended allowing IGOs to submit to a special appeal procedure by way of de novo arbitration. However, another section of the same paper notes that, while the option of bringing the dispute before a court of competent jurisdiction is open to both parties, it is particularly important for a losing respondent, for whom the UDRP procedure initiated by the complainant was mandatory. The paper notes further that for a losing respondent who had to submit to the UDRP in the domain name registration agreement, the possibility of initiating court litigation in at least one convenient forum is an important due process safeguard. The paper acknowledged that the requirement for UDRP complainants to submit to a "mutual jurisdiction" does not prevent either party from initiating court litigation elsewhere and, similarly, a State's submission to de novo arbitration should not restrict either party's recourse to a national court of justice.
- The 2005 WIPO Paper on Legal and Administrative Aspects of Article 6ter noted that Article 6ter provides a degree of legal protection to abbreviations and names of IGOs, of which at least one member State is a member of the Paris Union; that Article 6ter is applicable to the States party to the Paris Convention as well as to all Members of the World Trade Organization (WTO), whether or not party to the Paris Convention, by

<sup>34</sup> These have been collated and can be viewed at <https://gacweb.icann.org/display/GACADV/IGO+and+INGO+Names>.

**Commented [A1]:** Slightly edited from Phil's notes; but the substantive descriptions that follow are mostly unchanged.

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[virtue of Article 2.1 of the Agreement on Trade-Related Aspects of Intellectual Property Rights \( “the TRIPS Agreement”\); and, that as of August 2005, 141 IGOs had requested communications that had subsequently been sent by the International Bureau of WIPO to those States that were party to the Paris Convention as well as to the Members of the WTO that were not party to the Paris Convention.](#)

- [The 2007 GNSO Issue Report on Dispute Handling for IGO Names and Abbreviations recommended that a separate dispute resolution procedure be developed for IGO names and abbreviations as domain names at the second or third level in new gTLDs, and that once the process was developed, the GNSO Council consider launching a PDP to investigate its application to existing gTLDs. However, no further action was taken by Council in regard to this staff recommendation, and no PDP to investigate the possibility was launched until the chartering of the present Working Group.](#)
- [The 2007 ICANN Staff Report and Draft Text for a Dispute Resolution Process for IGO Domain Names was delivered three months after the above referenced Issue Report. It contained a proposed dispute resolution process in relation to the suggestion in the Issue Report that could be applicable to new gTLDs. The scope of the proposed process was that it would apply to complaints initiated by IGOs where there was a registration or use, as a domain name, of the complainant’s name or abbreviation that has been communicated under Article 6ter of the Paris Convention. It would have permitted either party to appeal an initial determination to an arbitral tribunal for independent resolution, but did not identify what tribunal might have such jurisdiction. Again, neither the GNSO Council nor ICANN took any action to implement this proposed mechanism, and no such process was included within the Applicant Guidebook for the 2012 New gTLD Program.](#)
- [The 2013 Final Report of the PDP Working Group on Protection of IGO and INGO Identifiers in All gTLDs dealt solely with preventative protections for the Red Cross/Red Crescent, International Olympic Committee, INGOs, and IGOs, and not with potential curative rights mechanisms except to recommend that an Issue Report on the topic be created. This led to the Issue Report that scoped the issues for this current PDP.](#)

### 3.2 Status of Previous ICANN Work

The WG’s review of the historical materials confirmed that the issue of appropriate handling of domain name disputes relating to IGO names and, especially, acronyms, has been a long standing one in both the ICANN and international multilateral community. For example, in 2003, an ICANN Joint Working Group comprising community members from the At Large Advisory Committee (ALAC), the Government Advisory Committee (GAC) and the GNSO had discussed options for handling domain name disputes involving IGOs, following the WIPO-2 Process. That Joint Working Group failed to reach consensus on any recommendations, and as a consequence no formal action was taken by the GNSO Council or ICANN on the matter. Subsequently, in 2007, a GNSO Issue Report on Dispute Handling for IGO Names & Abbreviations noted a number of

possible methods for handling domain name disputes concerning IGO names and abbreviations. A PDP was not, however, not initiated on the topic at the time, as the requisite number of GNSO Council votes for launching a PDP was not attained.

The topic of IGO names and acronyms, and more specifically, the question of appropriate protection for such identifiers in the domain name system, arose again during the development of the 2012 New gTLD Program expansion round. The Applicant Guidebook (AGB) for the Program did not initially contain specific protections for IGOs, although it provided for the ability of organizations meeting the existing criteria for a .int registration to file objections under the prescribed legal rights objection process. The AGB also contained provisions allowing organizations that owned trademark and other intellectual property rights in their names and/or acronyms to enter those identifiers into the new Trademark Clearinghouse and as a result participate in the Sunrise Registrations and Trademark Claims Notice protections offered through the Clearinghouse. These organizations could also access and use the new Uniform Rapid Suspension (URS) procedure, on the basis of their having ownership of a relevant trademark.

In June 2011, the ICANN Board directed that top-level ~~protections for prohibitions on the delegation of~~ certain Red Cross and International Olympic Committee identifiers be included in the final AGB. In November 2012, second-level protections for certain Red Cross and International Olympic Committee identifiers were added to the list of identifiers that new gTLD registry operators were obliged to withhold from registration. These protections were intended to be interim measures, applicable ~~while during the period in which~~ the GAC and GNSO continued to develop policy advice concerning appropriate protections for these two INGOs at the top and second level. Subsequently, the Board granted temporary protection for a specific list of IGO names and acronyms provided by the GAC<sup>35</sup>, in response to advice from the GAC, again on an interim basis, to allow gTLDs approved under the 2012 New gTLD Program to begin launching while policy development work continued.

The GNSO concluded an expedited PDP on the protection of IGO and INGO identifiers in all gTLDs in November 2013. The consensus recommendations from this PDP were adopted unanimously by the GNSO Council<sup>36</sup>; however, some of those recommendations were inconsistent with GAC advice on the topic and in April 2014 the ICANN Board approved only those GNSO recommendations that were viewed as consistent with GAC advice. For purposes of this current PDP, the inconsistent recommendation of greatest relevance is the different perspective of the GAC and the GNSO on the question of protection for IGO acronyms. Where the GAC had advised that protection for IGO acronyms be of a permanent nature and disputes should be resolved via binding third party arbitration, the GNSO had recommended that IGO acronyms be protected via the Trademark Clearinghouse mechanism of a 90-days Claims Notice

<sup>35</sup> The GAC’s list of IGOs was provided to ICANN in March 2013: <https://www.icann.org/en/news/correspondence/dryden-to-crocker-chalaby-annex2-22mar13-en.pdf>; the criteria for inclusion on the GAC list was noted here:

<https://www.icann.org/en/news/correspondence/dryden-to-crocker-chalaby-annex1-22mar13-en.pdf>.

<sup>36</sup> See <http://gns0.icann.org/en/council/resolutions#20131120-2>.

**Commented [A2]:** From Phil Corwin: Q. Any data on whether any IGOs used the TMCH? If so it should be noted

**Commented [A3]:** Added in response to Phil’s question about this.

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[period. The inconsistency between the GAC advice and GNSO recommendations on this point remains unresolved, and led to the formation of the IGO Small Group in 2014, whose eventual proposal and its consideration by this WG is detailed further below, in Section 3.4.](#)

### 3.3 Review of Legal Instruments, Legal Expert Opinion and Other External Source Materials

Assisted by the reports of its three Sub Groups that reviewed the historical documentation on the topic, the WG came to the preliminary conclusion early on in its deliberations that there was no substantive principled reason to accord any special treatment to INGOs in relation to either amendment of existing, or development of a new, dispute resolution process (including the international Red Cross movement and the International Olympic Committee, which had been specific subjects of analysis under a previous GNSO PDP). The WG's rationale for this decision was set out in detail in an annex to the WG's initial solicitation of input from all ICANN Supporting Organizations and Advisory Committees (SO/ACs), sent in December 2014<sup>37</sup>. The WG also presented this preliminary conclusion to the GNSO Council and the community, and received no objections from the Council, any SO/AC or the community generally. **The WG's agreed text for this preliminary recommendation, and its accompanying rationale, is set out in full as Recommendation #1 in Section 2, above.**

Following its decision to focus further discussions on IGOs, the WG moved on to consider the question of how to deal with the fact that not all IGOs possess national or common law trademark rights in their names or acronyms – in which case the IGO would not then have standing to file a complaint under the UDRP or URS. As further described in Section 2 (above), the WG determined, after substantial [research and](#) discussion, that standing to file can [also](#) be demonstrated by those IGOs which have invoked the protections provided by Article 6ter of the Paris Convention on Industrial Property.

The WG notes that the potential applicability of Article 6ter was first raised by the IGOs in their initial request to ICANN for protection of their names and acronyms in the top and second level of the domain name system, [in which they stated, "The names and acronyms of IGOs are protected within the scope of Article 6ter of the Paris Convention for the Protection of Industrial Property \(with 173 Contracting Parties\), as further referred to in Article 16 of the Trademark Law Treaty and Article 2 of the WTO Agreement on Trade Related Aspects of Intellectual Property Rights"](#).<sup>38</sup> In their letter, the various IGO legal counsel that signed on to it had stated that international legal norms such as Article 6ter supported the targeted exclusion from registration by third parties of IGO names and acronyms (i.e. preventative protections). While

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<sup>37</sup> See Annex C, [containing](#) the Working Group's letter to all ICANN SO/ACs, which can be found at <https://community.icann.org/x/T5gQAw>.

<sup>38</sup> See the 13 December 2011 letter sent by the legal counsel of twenty-eight IGOs: <https://www.icann.org/en/system/files/files/igo-counsels-to-beckstrom-et-al-13dec11-en.pdf>.

this WG is concerned solely with the topic of curative protections for IGO names and acronyms, it nevertheless considered the applicability and relevance of Article 6ter to the issue.

The WG acknowledges that Article 6ter does not confer substantive legal rights, whether as trademarks or in other forms. Rather, it provides protection to IGO names and acronyms by requiring contracting States that are party to the treaty to prohibit confusing third party use of those identifiers *as trademarks* in industrial or commercial activities, on the basis that such exclusion reflects the public status of IGOs and prevents confusion that would interfere with such status<sup>39</sup>. The WG considered, after substantial discussion, that [given this linkage of Article 6ter protections to national trademark regimes, and](#) for the limited purpose of demonstrating standing to file a UDRP or URS complaint, the protections afforded to IGO names and acronyms by Article 6ter can be viewed as sufficient for that specific purpose. **The WG's agreed text for this preliminary recommendation, the scope of Article 6ter and the requisite communication and notification procedure that must be followed to invoke its protections, are set out in full as Recommendation #2 in Section 2, above.**

Following from its conclusion on standing, the WG discussed the applicability of the other, substantive grounds of the UDRP and the URS to IGO complaints filed on the basis that standing is conferred by Article 6ter. The WG concluded that the main problem faced by IGOs in terms of the legal requirements of the UDRP and URS was essentially one of standing. The WG's analysis revealed no obstacle to an IGO's having to prove the other, substantive grounds under both procedures (i.e. that the respondent-registrant has no rights or legitimate interests in respect of the domain name at issue, and that the domain name has been registered and is being used in bad faith). Rather, the conduct that the UDRP and URS were designed to address included the type of abuse that IGOs had stated previously needed to be stopped. **The WG's agreed text for this preliminary recommendation and its observations on the scope of the UDRP and URS are set out in full as Recommendation #3 in Section 2, above.**

The WG's conclusions on the issues of standing and substantive grounds under the UDRP and URS also meant that, in relation to these questions, there was no compelling reason [based in those considerations](#) to create a separate dispute resolution process applicable only to IGOs.

The WG also considered at length a further challenge that may be faced by IGOs – the risk that agreeing to submit to the Mutual Jurisdiction clause of the UDRP and URS by filing a complaint will strip an IGO of any jurisdictional immunity it may enjoy in a particular national court. ICANN staff, assisted by several WG members, conducted research on the scope of IGO jurisdictional immunity in selected jurisdictions and under applicable international treaties. The WG also initially consulted Mr. Hans Corell, an international law expert, in relation to several preliminary

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<sup>39</sup> See, e.g., [http://www.wipo.int/edocs/pubdocs/en/intproperty/611/wipo\\_pub\\_611.pdf](http://www.wipo.int/edocs/pubdocs/en/intproperty/611/wipo_pub_611.pdf) (BIRPI Guide to the Application of the Paris Convention, Bodenhausen (1968)); <http://www.wipo.int/export/sites/www/about-ip/en/iprm/pdf/ch5.pdf> (WIPO Intellectual Property Handbook: Policy, Law, and Use, chapter 5); and <http://archive.icann.org/en/committees/JWGW2/WIPO2-note.pdf> (WIPO Briefing Note to ICANN, 2005).

questions on the matter<sup>40</sup>. As this initial consultation did not provide the WG with [sufficient information and guidance to reach](#) substantive conclusions, the WG requested that ICANN [assist it by engaging](#) an external legal expert to provide it with a more detailed analysis. [The WG thanks ICANN for providing the staff resources and modest financial support to facilitate that request](#). Following consideration of several candidates nominated by WG members in the legal community, the WG agreed that Professor Edward Swaine of George Washington University, USA, should be engaged as the external legal expert<sup>41</sup>.

The WG developed several detailed questions for Professor Swaine to respond to, focusing on a determination of the scope of international law concerning the jurisdictional immunity of IGOs (as distinct from the sovereign immunity of States). In order for the Working Group to properly evaluate the need to either amend the UDRP or URS, or develop a new mechanism, to address the question of immunity, it needed to more fully understand international law (whether through treaty or customary law) on the topic and its scope.

Professor Swaine delivered a preliminary synopsis to the WG at the end of January 2016. Following review of this document and WG discussion, including at the ICANN meeting in Marrakech in March 2016, and a subsequent call between the WG and Professor Swaine, Professor Swaine updated his report and provided a Final Memo to the WG in June 2016<sup>42</sup>. Subsequently, representatives from various IGOs sent a letter to the GNSO Council commenting on Professor Swaine's memo in October 2016<sup>43</sup>.

Based on Professor Swaine's expert opinion, as documented in his Final Memo, that there is not a uniform rule in international law governing IGO jurisdictional immunity and that the extent and success of an immunity claim in different national courts can vary depending on a number of factors, [as well as concerns about ICANN seeking to deny domain registrants access to related statutory rights](#), the WG preliminarily agreed that no change should be made to the Mutual Jurisdiction clause of either the UDRP or the URS. As the WG nevertheless recognized that IGOs may in some circumstances be able to successfully plead immunity, it went on to consider two options that might address this situation and supplement the UDRP and URS. **The WG's agreed text for its preliminary recommendation, the two options under consideration, and further elaboration on the nature of Professor Swaine's expert views<sup>44</sup>, are set out in fuller detail under Recommendation #4 in Section 2, above.**

The WG's conclusions on the issue of jurisdictional immunity further reinforces its view that there seems to be no reason to develop a separate dispute resolution process applicable only to

<sup>40</sup> For the research conducted by ICANN staff, questions sent to Mr. Corell and his response, see <https://community.icann.org/x/wl4QAw>.

<sup>41</sup> A list of the various experts under consideration by the WG can be found at <https://community.icann.org/x/z4BYAw>.

<sup>42</sup> Professor Swaine's preliminary synopsis and Final Memo can be found at <https://community.icann.org/x/z4BYAw>.

<sup>43</sup> See <https://gnso.icann.org/en/correspondence/igo-note-wg-swaine-memo-12jul16-en.pdf>.

<sup>44</sup> As noted above, for the full text of Professor Swaine's memo, see Annex E of this Initial Report and the WG's wiki space at <https://community.icann.org/x/z4BYAw>.

IGOs. On the related question of whether or not appeals from initial panel decisions should depart from the longstanding rule of appeal to a national court and instead be determined by another form of alternative dispute resolution in the form of arbitration, the WG's analysis of the available options, including previous documentation on this specific possibility<sup>45</sup>, and its impact on a registrant's legal rights led it to conclude that its recommendations provide sufficient protection to IGOs while preserving the right to judicial appeal.

Finally, the WG considered the GAC advice from its Buenos Aires Communique of November 2015 that IGO access to and use of curative rights processes should be at low or nominal cost. The WG agreed that the question of cost was one more appropriately referred to ICANN and is outside the remit of the WG Charter. **This preliminary conclusion is further detailed as Recommendation #5 in Section 2, above.**

The WG notes that its recommendations that the UDRP should not be amended is in line with previous GAC advice, as provided by the GAC in its October 2014 Communique from the Los Angeles meeting. The WG concludes that, while its preliminary recommendations differ on specific details with other aspects of GAC advice on the topic and with the IGO Small Group Proposal (discussed further in Section 3.4, below), overall they address the needs and concerns of IGOs that have been raised with ICANN while preserving the benefits and certainty of the existing curative rights processes and protecting the legal rights of registrants.

### 3.4 Working Group Interaction with IGOs, Consideration of the IGO Small Group Proposal and Outcome of the ICANN57 Meeting Sessions

#### Process Background

As noted in Section 2.1 above, this PDP was initiated to consider the specific topic of curative rights protections for IGOs and INGOs, which was a topic that had been noted by the previous GNSO PDP on IGO-INGO Protections in All gTLDs as needing to be scoped by an Issue Report as a mandatory first step prior to a separate, new PDP. The previous PDP Working Group had reached consensus on a number of recommendations pertaining to preventative protections for certain IGO and INGO names and acronyms<sup>46</sup>. While some of the policy recommendations have since been approved by the ICANN Board<sup>47</sup>, several remain under Board consideration as the

<sup>45</sup> See, e.g., a paper prepared by the WIPO Secretariat for the Standing Committee on Trademarks in August 2003: [www.wipo.int/edocs/mdocs/sct/en/sct\\_11/sct\\_11\\_5.doc](http://www.wipo.int/edocs/mdocs/sct/en/sct_11/sct_11_5.doc).

<sup>46</sup> See the PDP Working Group's Final Report at <https://gns0.icann.org/en/issues/igo-ingo-final-10nov13-en.pdf>, with Minority Statements (including from participating IGOs) at <https://gns0.icann.org/en/issues/igo-ingo-final-minority-positions-10nov13-en.pdf>.

<sup>47</sup> The Board resolution approving the consistent recommendations and requesting more time to consider the remaining recommendations while facilitating discussions on reconciliation of the inconsistencies can be viewed at <http://www.icann.org/en/groups/board/documents/resolutions-30apr14-en.htm#2.a>.

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GNSO's recommendations on those points are inconsistent with GAC advice provided to the Board on the same topics<sup>48</sup>, and the Board had requested additional time to consider them. The Board had previously also requested that its New gTLD Program Committee (NGPC) develop a proposal for Board consideration that would take into account the GAC advice as well as the GNSO's recommendations<sup>49</sup>.

To provide a procedural path forward for resolution of the matter, the NGPC facilitated the creation of an IGO Small Group, comprising representatives from ~~the NGPC~~, the GAC and IGOs working with Board representatives and ICANN staff to finalize a proposal for GAC and GNSO consideration. The formation of the group was highlighted by the GAC Chair during the joint GAC-GNSO meeting at ICANN51 in Los Angeles in October 2014, where it was noted that the group would "provide inputs or maybe some guidance to the GNSO so that it's clear, or as clear as possible, for [the GNSO] about what are the issues there that are really remaining"<sup>50</sup>. The starting point for the IGO Small Group's deliberations was the initial NGPC proposal that had been sent to the GAC and the GNSO in March 2014<sup>51</sup>. Although the NGPC proposal focused on the topic of preventative protections for IGO acronyms, it also contained suggestions for modifying the URS (specifically, removing the need to consent to jurisdiction and the possibility of appeal) and the setting up of an arbitration process to resolve claims of abuse of IGO acronyms.

In June 2014, the NGPC wrote to the GNSO Council requesting that the GNSO consider modifying its original PDP recommendations in accordance with the GNSO's documented processes for such amendment<sup>52</sup>. In the letter, the NGPC acknowledged the then-recent initiation of this current PDP on curative rights, and noted that the Board would not take any action on GAC advice concerning curative rights protections for IGOs until the conclusion of this PDP. The GNSO Council took no further action in relation to IGO acronyms following additional discussions with the NGPC later that year, pending further Board/NGPC input on possible

**Commented [A4]:** Clarified per Phil's comment on role of NGPC in the Small Group.

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<sup>48</sup> The GAC had issued advice to the ICANN Board via several Communiqués between 2013 and the present time concerning IGO protections, especially for IGO acronyms. For a listing of all the GAC advice on this point, see <https://gacweb.icann.org/display/GACADV/IGO+Names+and+Acronyms>.

<sup>49</sup> See <http://www.icann.org/en/groups/board/documents/resolutions-07feb14-en.htm#2.a>.

<sup>50</sup> See Page 27 of the transcript from this meeting: <https://la51.icann.org/en/schedule/sun-gac-gnso/transcript-gac-gnso-12oct14-en.pdf>.

<sup>51</sup> See <https://gns0.icann.org/en/correspondence/chalaby-to-robinson-20mar14-en.pdf> for a brief description of the scope of the original proposal, and <https://gns0.icann.org/mailling-lists/archives/council/msg15906.html> for the full text of the proposal.

<sup>52</sup> See <https://gns0.icann.org/en/correspondence/chalaby-to-robinson-16jun14-en.pdf>. Further correspondence followed between the GNSO Council and the NGPC, in July 2014 (<https://gns0.icann.org/en/correspondence/chalaby-to-robinson-24jul14-en.pdf>), October 2014 (<https://gns0.icann.org/en/correspondence/robinson-to-chalaby-disspain-07oct14-en.pdf>) and January 2015 (<https://gns0.icann.org/en/correspondence/chalaby-to-robinson-15jan15-en.pdf>). The GNSO Council also wrote to the GAC Chair in July 2014, noting that it had already initiated a new PDP that would, among other things, consider modifications to the URS in relation to IGO protections (<https://gns0.icann.org/en/correspondence/robinson-to-dryden-25jun14-en.pdf>).

modifications to the GNSO's adopted policy recommendations that might be appropriate and acceptable to all parties.

In December 2014, pursuant to a mandatory requirement for all GNSO PDPs, this WG had sought input from all ICANN Supporting Organizations and Advisory Committees. In addition to a response from the GAC<sup>53</sup>, IGO representatives also provided responses to the WG in January 2015, following which the WG sent a few additional questions to the IGOs to which the group did not receive a further response. However, representatives of various IGOs who were participants in the IGO Small Group attended and participated in the WG's open sessions at ICANN53 in Buenos Aires (June 2015)<sup>54</sup> and at ICANN56 in Helsinki (June 2016)<sup>55</sup>; however, despite affirmative outreach, no IGO representative elected to become a member of the Working Group (although one IGO representative had earlier signed up as an observer).

Commented [A5]: Added by staff for accuracy.

In June 2015, the co-chairs of this WG met with the GAC Chair and two GAC vice-chairs at the ICANN meeting in Buenos Aires to discuss the progress of work on IGO curative rights protections and to encourage participation in the WG by GAC members; again, no GAC member elected to become a WG member. In July 2015, representatives of the IGO Small Group held a face to face meeting to further discuss the proposal that would ultimately be shared with the GAC and the GNSO<sup>56</sup>. In October 2015, the GAC Chair and Chris Disspain (the Board "shepherd" for this topic) held a teleconference with the WG co-chairs and other GNSO representatives regarding the various work tracks within the GNSO on IGO protections and the IGO Small Group work. In June 2016, at the ICANN meeting in Helsinki, the topic of IGO acronym protection was discussed between the GNSO Council and the ICANN Board<sup>57</sup>, where the Council raised its concern that it had not had much visibility into the IGO Small Group discussions, and WG co-chair Philip Corwin provided an update on the PDP work, including noting the limited extent of GAC and IGO participation in the WG.

The final proposal from the IGO Small Group was circulated to the GAC and the GNSO on 4 October 2016<sup>58</sup> via letter from the ICANN Board. The Board noted that those aspects of the proposal that related to curative rights would likely be referred to this WG, and requested that the WG fully consider the proposal, stating, "the Board hopes that the other elements of the attached proposal will be helpful to the GNSO in its deliberations over considering possible amendments to its previously adopted policy recommendations on preventative protection for IGO acronyms. However, that letter did not endorse the Small Group proposal, and further stated, "I wish to reiterate our belief that the most appropriate approach for the Board in this matter is to help to facilitate a procedural way forward for the reconciliation of GAC advice and

<sup>53</sup> For a copy of the original WG request and copies of all the responses received, see Annexes B and C of this report and the WG wiki space at <https://community.icann.org/x/T5gQAw>.

<sup>54</sup> See <https://buenosaires53.icann.org/en/schedule/wed-igo-ingo-crp-access/transcript-igo-ingo-crp-access-24jun15-en.pdf>.

<sup>55</sup> See <https://gns0.icann.org/en/meetings/transcript-igo-ingo-crp-access-28jun16-en.pdf>.

<sup>56</sup> See letter from the Secretary General of the OECD (which hosted the meeting) to the ICANN CEO: <https://www.icann.org/en/system/files/correspondence/gurria-to-chehade-20jul15-en.pdf>.

<sup>57</sup> See <https://gns0.icann.org/en/meetings/transcript-gns0-board-27jun16-en.pdf>.

<sup>58</sup> See <https://gns0.icann.org/en/correspondence/crocker-icann-board-to-council-chairs-04oct16-en.pdf>.



[GNSO policy prior to the Board formally considering substantive policy recommendations](#)". On 31 October, legal counsel from various IGOs sent a letter to the GNSO Council stating that IGO immunity is incompatible with the Mutual Jurisdiction requirements of the UDRP and URS, and [claiming](#) that the IGO Small Group Proposal represents a compromise on the part of the IGOs in relation to their initial request that their acronyms (which are the terms by which they are most commonly known) be reserved permanently<sup>59</sup>.

#### The IGO Small Group Proposal and the WG's review of the proposal

The IGO Small Group Proposal included proposals touching on curative rights processes as a complement to meaningful preventative protections for IGO acronyms. It outlined the basis for the specific proposals it contained as follows:

- "(1) The basis for protection of IGO acronyms should not be founded in trademark law, as IGOs are created by governments under international law and are in an objectively different category of rights-holders;
- (2) As IGOs perform important global missions with public funds, the implementation of appropriate protections for IGO names and acronyms is in the public interest; and
- (3) The Eligible IGOs that would qualify for protections under this proposal are those that are named on the GAC List of IGOs (initially submitted to ICANN in March 2013) as may be updated from time to time in accordance with GAC advice issued on 22 March 2013."

On curative rights, one proposal was the creation of a separate dispute resolution process for IGOs, as follows:

- "ICANN will facilitate the development of rules and procedures for a separate (i.e., separate from the existing UDRP) dispute resolution mechanism to resolve claims of abuse of domain names that are registered and being used in situations where the registrant is pretending to be the IGO or that are otherwise likely to result in fraud or deception, and (a) are identical to an IGO acronym; or (b) are confusingly similar to an IGO acronym; or (c) contain the IGO acronym. Decisions resulting from this mechanism shall be "appealable" through an arbitral process to be agreed."

A further proposal was for a rapid relief mechanism, separate from the URS, to address clear-cut cases of abuse. Under this proposal, an eligible IGO may obtain a rapid temporary suspension of a domain name in situations where it would not be reasonable for it to use the above-mentioned dispute resolution mechanism, if certain conditions are met. These are:

- "(1) The subject domain name is
  - (a) identical or confusingly similar to an IGO acronym; and
  - (b) registered and used in situations where the registrant is pretending to be the IGO or that are otherwise likely to result in fraud or deception; and
- (2) there is an obvious risk of imminent harm from the claimed abuse of such domain name, (e.g. such as fraudulently soliciting donations in the wake of a humanitarian disaster)."

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<sup>59</sup> See <https://gns0.icann.org/en/correspondence/igos-to-gns0-31oct16-en.pdf>.

Relief under this new rapid relief mechanism would be the same as under the URS, i.e. suspension and not transfer or cancellation of the domain name in question.

The IGO Small Group Proposal also included a proposal for ICANN to “work with the IGOs and the mechanism providers to ensure that IGOs are not required to pay filing or any other ICANN-defined fees to access and use those mechanisms unless the examiner finds the case to have been brought in bad faith. Three or more findings of cases brought in bad faith by the same IGO may lead to that IGO being suspended from using the mechanism for a period of one year.”

The WG reviewed and discussed the IGO Small Group Proposal at its meetings on 13 October<sup>60</sup> and 20 October<sup>61</sup>. It should be noted that, by the time of receipt of the IGO Small Group Proposal, the WG had already reached preliminary agreement on a number of potential recommendations concerning curative rights protections for IGOs. The WG’s review of the IGO Small Group Proposal thus focused on whether the proposals contained therein warranted modifications or updates to the WG’s preliminary conclusions.

During the two meetings where it focused on the IGO Small Group Proposal, the WG reviewed all the aspects that pertained to curative rights. It concluded that, while IGOs may be in an objectively different category than trademark holders (as had been noted several times by the GAC), the WG’s agreed preliminary recommendations not only provide sufficient protection for IGO names and acronyms, in some cases its recommendations are broader than and thus provide potentially greater protection for IGOs than what is in the IGO Small Group Proposal. The WG also noted that the IGO Small Group Proposal continued to be based on the assumption that IGOs are able to claim broad jurisdictional immunity in multiple national courts, which the WG concluded is at substantial odds with the expert opinion provided by Professor Swaine. Therefore there is no basis for stripping a losing registrant of his right to appeal to a national court, as is called for by the IGO Small Group Proposal. Finally, the WG noted that the elements of the separate mechanisms outlined in the IGO Small Group Proposal are already within the scope of the existing URS and UDRP. There therefore did not seem to be a substantive rationale for creating separate dispute resolution processes as proposed by the IGO Small Group.

**Commented [A6]:** From Phil Corwin: In regard to the final clause of this sentence, I believe we should either state in precisely what manner the recommendations are broader (a broader group of eligible IGOs having standing under 6ter is all I can think of) or else drop it and merely state that the WG believes the recommended protections are sufficient

The following is a comparative table showing the differences between the specific details of the IGO Small Group Proposal concerning curative rights and the WG’s agreed preliminary recommendations following its review of the Proposal, as well as notes on the WG’s rationale for its decisions. **The community is invited to comment on the recommendations and notes, and all input provided will be taken into account by the WG in preparing its final recommendations.**

IGO Small Group Proposal	Working Group Preliminary Recommendations <sup>62</sup>	Notes
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<sup>60</sup> See <https://community.icann.org/x/-hi4Aw>.

<sup>61</sup> See <https://community.icann.org/x/wSC4Aw>.

<sup>62</sup> See Section 2, above, for the full set of recommendations and rationales.

<p><b>Separate dispute resolution process</b> for domains registered and used in situations where registrant is pretending to be the IGO or otherwise likely to result in fraud or deception, <i>and</i> (a) are identical to an IGO acronym; or (b) are confusingly similar to an IGO acronym; or (c) contain the IGO acronym.</p> <p>Decisions to be “appealable” through an arbitral process</p>	<p><b>No separate dispute resolution process:</b></p> <p>Standing to file under the UDRP or URS can be demonstrated by an IGO’s having filed the requisite notification to WIPO under Article 6<i>ter</i> of the Paris Convention for the Protection of Industrial Property (this supplements the existing option of filing under the UDRP or URS if the IGO has trademark rights in its name and/or acronym)</p> <p>The requirement of “bad faith” under the UDRP &amp; URS may be shown if the limitation in Article 6<i>ter</i> (indicating a connection to the IGO or misleading the public) is present</p> <p>Right to appeal to national court preserved (but with option to either create an arbitration option or to vitiate the original UDRP or URS decision in cases where an IGO has successfully argued that it has jurisdictional immunity in a national court); <a href="#">specific public comment is invited on this potential option</a></p>	<p>The Working Group notes the IGO Small Group clarification that IGO protections should not be based on the possession of national trademark rights. The Working Group’s recommendation to allow an IGO to file under the UDRP and URS on the basis of its having Article 6<i>ter</i> protection, <a href="#">in addition to trademark rights</a>, provides adequate protection to a broader group of IGOs than those covered by the IGO Small Group Proposal.</p> <p>The Working Group also concludes that the substantive scope of the UDRP already covers the situations described in the IGO Small Group Proposal and in some cases may provide broader protection.</p> <p>The external legal expert report confirms that the state of international law on IGO jurisdictional immunity is not uniform, and can depend on a number of factors, including the existence of a bilateral treaty and whether the national court in question applies the principles of absolute, functional or restrictive immunity to the IGO. As such, the disadvantages (especially to a registrant) of removing the right to appeal to a national court in favor of yet another form of alternative dispute resolution through binding arbitration clearly outweighed any purported</p>
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		<p>benefits. <a href="#">The Working Group further believed that the availability of CRP curative relief is intended to be a supplement to rather than a substitute for existing legal protections; that an attempt by ICANN to prevent a domain registrant from exercising national legal rights could set an undesirable precedent; and that in any event there could be no assurance that a court would dismiss a legal action brought by a registrant based upon such ICANN policy seeking to prevent court access.</a></p>
<p><b>Rapid relief mechanism</b> where domain is:                  (a) identical or confusingly similar to an IGO acronym; and                  (b) registered and used in situations where the registrant is pretending to be the IGO or that are otherwise likely to result in fraud or deception; and                  (c) there is obvious risk of imminent harm from the claimed abuse of the domain</p>	<p><b>No separate rapid relief mechanism and no change to the URS</b> (with accompanying clarification that standing to file a complaint can be satisfied with an IGO’s filing an Article 6ter notification, a mechanism that supplements the existing UDRP and URS which is also available to IGOs with trademarks in their names and/or acronyms)</p> <p>Policy Guidance document to be developed and issued clarifying that IGOs have the option to file through an assignee, licensee, or agent</p>	<p>The Article 6ter notification process is relatively straightforward and that once an IGO has filed the requisite notice with WIPO it should possess the necessary standing to file a complaint.</p> <p>The Working Group concludes that the substantive scope of the URS already covers the situations described in the IGO Small Group Proposal and may in some cases provide broader protection.</p> <p>The Working Group notes that the external legal expert report confirms that the state of international law on IGO jurisdictional immunity is not uniform, and can depend on a number of factors, including the existence of a bilateral treaty and whether the national court in question applies the principles of</p>

**Commented [A8]:** From Phil Corwin: Again, we need to list or reference the broader protections, or drop the assertion.

**Commented [A7]:** From Phil Corwin: I believe we should move this into its own section, perhaps names “Filing via third party”, as it is applicable to both the UDRP and URS and therefore should not be contained in the RRM section. It also needs its own explanation, as there is none at present in the RRM section.

		<p>absolute, functional or restrictive immunity to the IGO. As such, the disadvantages (especially to a registrant) of terminating the need to submit to the long standing Mutual Jurisdiction standard under the URS or UDRP outweighed any purported benefits.</p> <p><a href="#">Allowing an IGO to file via a representative third party would insulate the IGO from any direct admission that it was waiving its claimed immunity in the event of a subsequent appeal to a court of mutual jurisdiction.</a></p>
<p>“Eligible IGOs” are IGOs who are on the GAC List from March 2013 (as updated from time to time by the GAC)</p>	<p>“Eligible IGOs” are IGOs who have fulfilled the requisite notification procedure under Article 6ter of the Paris Convention for its name and/or acronym, or who have a trademark in its name and/or acronym</p>	<p>The Working Group recognizes that the number of eligible IGOs under its preliminary recommendations is likely to be higher than those on the GAC List. The Working Group is aware that not all IGOs on the GAC List may have sought, or be eligible for, Article 6ter protection, and that there are IGOs who have sought such protection but are not on the GAC List.</p>
<p>Mechanisms to be available to IGOs at no cost unless case is brought in bad faith</p> <p>A finding of three or more filings in bad faith to result in an IGO not being permitted to use the mechanism for one year</p>	<p>ICANN to investigate the feasibility of providing IGOs with access to the UDRP and URS at low or nominal cost</p>	<p>The Working Group does not have the remit or authority to compel ICANN to create a subsidy or other cost relief measures for IGOs, <a href="#">whether generally or on a selective basis, but has no objection if ICANN wishes to explore this possibility.</a></p> <p><a href="#">As the Working Group has not recommended the</a></p>

**Commented [A9]:** From Phil: New language to accompany the recommendation on Policy Guidance when it is moved to a separate section.

	<p><a href="#">creation of new, IGO-specific CRP curative rights protection mechanisms, it believes that the rules regarding bad faith filings by IGO complainants should be the same as for any other party initiating a UDRP or URS; and that any recommended alterations are within the jurisdiction of the ongoing Working Group that is reviewing all RPMs in all gTLDs.</a></p>
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At ICANN57 in Hyderabad in November, the WG held an open community session where it presented a comparative overview of the differences between the WG’s agreed preliminary recommendations and the specific proposals contained in the IGO Small Group Proposal.

The GAC Communique issued at the conclusion of the Hyderabad meeting contained GAC consensus advice on IGO protections<sup>63</sup>. The GAC advice included a request that this Working Group take the IGO Small Group Proposal into account in its deliberations. The rationale that was provided by the GAC was that

- “IGOs undertake global public service missions, and protecting their names and acronyms in the [domain name system] is in the global public interest.
- IGOs are unique treaty-based institutions created by governments under international law.
- The small group compromise strikes a reasonable balance between rights and concerns of both IGOs and legitimate third parties.
- ICANN’s Bylaws and Core Values indicate that the concerns and interests of entities most affected, here IGOs, should be taken into account in policy development processes.”

The WG appreciates and acknowledges the GAC advice, and has given thorough consideration to the IGO Small Group Proposal [that is respectful and protective of their missions and treaty basis](#). As representatives of some IGOs had previously attended and spoken at two open meetings held by the WG (in June 2015 and July 2016 respectively), [and as the Small group proposal has been carefully reviewed and considered](#), the Working Group has devoted a substantial amount of time to considering the IGOs’ requests, positions and concerns. Its preliminary recommendations strike the necessary balance between accommodating IGOs’ needs and status, and the [existing legal](#) rights of registrants.

<sup>63</sup> See <https://gacweb.icann.org/download/attachments/27132037/GAC%20ICANN%2057%20Communique.pdf?version=6&modificationDate=1478668059355&api=v2>.

The WG welcomes and will thoroughly consider all community input on its recommendations and rationale as stated in this Initial Report.

## 4 Conclusions and Next Steps

### 4.1 Preliminary Conclusions

As this document is an Initial Report in which the WG is presenting its preliminary conclusions for community input, those preliminary recommendations were not subjected to a formal consensus call among the WG. This section will be updated to provide the WG's consensus levels on each of its final recommendations, which it will develop upon reviewing public comments received and in the process of generating its Final Report.

### 4.2 Next Steps

The WG will complete the next phase of its work and develop its recommendations in a Final Report to be sent to the GNSO Council for review following its analysis of public comments received on this Initial Report.



## 5 Background

### 5.1 Process Background

On 20 November 2013, the GNSO Council unanimously adopted all of the consensus recommendations made by the PDP Working Group on the Protection of IGOs and INGOs in All gTLDs. The group had recommended that the GNSO Council request an Issue Report to assist it in determining whether a PDP should be initiated in order to explore possible amendments to the UDRP and the URS, to enable access to and use of such curative rights protection mechanisms by IGOs and INGOs.

- On 25 May 2014, ICANN published the Final Issue Report on Amending the Uniform Dispute Resolution Policy and the Uniform Rapid Suspension Procedure for Access by Protected International Governmental Organizations and International Non-Governmental Organizations. In this Final Issue Report, ICANN staff recommended that the GNSO Council commence a PDP on the topic.
- On 5 June 2014, the GNSO Council initiated the PDP.
- On 25 June 2014, the GNSO Council approved the Charter for the IGO-INGO Access to Curative Rights Protection Mechanisms PDP Working Group.
- A Call for Volunteers to the WG was issued on 11 July 2014, and the WG held its first meeting on 11 August 2014.
- On 16 June 2015, the GNSO Council approved a request from the PDP Working Group to amend the scope of its Charter, such that the WG would be able to “take into account any criteria for IGO or INGO protection that may be appropriate, including any that may have been developed previously, such as the list of IGO and INGO identifiers that was used by the GNSO’s prior PDP WG on the Protection of International Organization Identifiers in All gTLDs as the basis for their consensus recommendations and the GAC list of IGOs as provided to ICANN in March 2013”<sup>64</sup>.

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<sup>64</sup> See <https://gns0.icann.org/en/council/resolutions#20150416-3> (noting that the original scope of the Charter was limited only to the identifiers of those IGOs and INGOs that had been listed by the previous PDP Working Group on IGO and INGO protections).

## 5.2 Issue Background

The IGO-INGO Access to Curative Rights Protection Mechanisms PDP Working Group was tasked to provide the GNSO Council with policy recommendations regarding whether to amend the UDRP and URS to allow access to and use of these mechanisms by IGOs and INGOs and, if so in what respects; or whether a separate, narrowly-tailored dispute resolution procedure at the second level modeled on the UDRP and URS that takes into account the particular needs and specific circumstances of IGOs and INGOs should be developed. The WG was expected to, at a minimum, consider the following topics:

- Differences between the UDRP and URS
- Relevance of existing protections under the Applicant Guidebook for the New gTLD Program
- Interplay between this issue and the forthcoming review of the UDRP
- The distinction (if any) between IGOs and INGOs for purposes of this issue
- The potential need to distinguish between a “legacy” gTLD and a “new” gTLD launched under the New gTLD Program
- The potential need to clarify whether the URS is Consensus Policy binding on ICANN contracted parties
- The need to address the issue of the costs to IGOs and INGOs of using curative processes
- The relevance of the existence of legal protections under international treaties and/or multiple national laws

### 5.2.1 Background Work by the GNSO and the ICANN Community

In 2007 a GNSO Issue Report on Dispute Handling for IGO Names & Abbreviations had analyzed some possible methods for handling domain name disputes concerning IGO names and abbreviations, but not those of INGOs. A PDP on the topic was however not initiated due to lack of the requisite number of votes in the GNSO Council. Previously, in 2003, an ICANN Joint Working Group comprising community members from the ALAC, the GAC and the GNSO had also discussed various possible dispute resolution mechanisms for IGOs in response to a 2001 report on the applicability of the UDRP to certain types of identifiers (including those of IGOs) by WIPO. The Joint Working Group failed to reach consensus on WIPO’s recommendations, and no formal action was taken by the GNSO Council or ICANN on the matter.

## 6 Approach Taken by the Working Group

### 6.1 Working Methodology

The IGO-INGO Access to Curative Rights Protection Mechanisms WG began its deliberations on 11 August 2014. It decided to conduct its work primarily through weekly conference calls, in addition to email exchanges on its mailing list, with further discussions taking place at ICANN Public Meetings when scheduled. All the WG’s meetings are documented on its wiki workspace (<https://community.icann.org/x/37rhAg>), including its mailing list (<http://mm.icann.org/pipermail/gnso-igo-ingo-crp/>), draft documents, background materials and input received from ICANN’s SO/ACs and the GNSO’s Stakeholder Groups and Constituencies.

The WG also prepared a Work Plan (<https://community.icann.org/x/9brhAg>), which was reviewed on a regular basis. In accordance with the GNSO’s PDP Manual, the WG solicited early input from ICANN’s SO/ACs and the GNSO’s Stakeholder Groups and Constituencies, and considered all input received in response. It also reviewed the historical documentation on this topic early on in its deliberations<sup>65</sup>, and considered advice provided by the GAC to the ICANN Board as well as the IGO Small Group Proposal (as described in Section 3, above).

The WG scheduled community sessions at each ICANN Public Meeting that took place after its formation, at which it presented its preliminary findings and/or conclusions to the broader ICANN community for discussion and feedback.

#### 6.1.1 WG Membership and Attendance

The members of the IGO-INGO Access to Curative Rights Protection Mechanisms WG are:

Group / Name	Affiliation	Meetings Attended*
<b>NCSG:</b>		
Name 1	NCUC / NPOC	00
Name 2	NCUC / NPOC	00
Name 3	NCUC / NPOC	00

**Commented [A10]:** This section will be completed prior to publication for public comment.

<sup>65</sup> Much of the historical records, treaty texts, reports and papers considered by the WG is listed on the WG’s wiki space: <https://community.icann.org/x/DrvhAg>.

Group / Name	Affiliation	Meetings Attended*
<b>CSG:</b>		
Name 1	CBUC / IPC / ISPCP	00
Name 2	CBUC / IPC / ISPCP	00
Name 3	CBUC / IPC / ISPCP	00
<b>RrSG:</b>		
Name 1	Registrar Co. Name	00
Name 2	Registrar Co. Name	00
Name 3	Registrar Co. Name	00
<b>RySG:</b>		
Name 1	Registry Co. Name	00
Name 2	Registry Co. Name	00
Name 3	Registry Co. Name	00
<b>At-Large/ALAC:</b>		
Name 1	ALAC	00
Name 2	RALO	00
Name 3	RALO	00
<b>GAC:</b>		
Name 1	Country	00
Name 2	Country	00
Name 3	Country	00
<b>Individuals:</b>		
Name 1	Individual/Company?	00
Name 2	Individual/Company?	00
Name 3	Individual/Company?	00

Group / Name	Affiliation	Meetings Attended*

The Statements of Interest of the WG members can be found at <https://community.icann.org/x/97rhAg>.

The attendance records can be found at <https://community.icann.org/x/-jXxAg>. The email archives can be found at <http://mm.icann.org/pipermail/gns0-igo-ingo-crp/>.

\* The following are the ICANN SO/ACs and GNSO Stakeholder Groups and Constituencies for which WG members provided affiliations:

- RrSG – Registrar Stakeholder Group
- RySG – Registry Stakeholder Group
- CBUC – Commercial and Business Users Constituency
- NCUC – Non-Commercial Users Constituency
- IPC – Intellectual Property Constituency
- ISPCP – Internet Service and Connection Providers Constituency
- NPOC – Not-for-Profit Organizations Constituency
- GAC – Governmental Advisory Committee

\*\* This list was accurate as of the publication of this Initial Report. Note that some members joined the WG only after it began meeting, and WG members that have since left are indicated with ++ against their names.

## 7 Community Input

### 7.1 Request for Input

According to the GNSO's PDP Manual, a PDP WG should formally solicit statements from each GNSO Stakeholder Group and Constituency at an early stage of its deliberations. A PDP WG is also encouraged to seek the opinion of other ICANN Supporting Organizations and Advisory Committees who may have expertise, experience or an interest in the issue. As a result, the WG reached out to all ICANN SO/ACs as well as GNSO Stakeholder Groups and Constituencies with a request for input (see Annexes B and C) at the start of its deliberations. In response, statements were received from:

- The GNSO Intellectual Property Constituency (IPC)
- The GNSO Internet Service Provider & Connectivity Provider Constituency (ISPCP)
- The Registries Stakeholder Group (RySG)
- The Governmental Advisory Committee (GAC)
- Security and Stability Advisory Committee (SSAC)

The full statements can be found here: <https://community.icann.org/x/T5gQAw>.

### 7.2 Review of Input Received

All of the statements received were reviewed by the WG as part of its deliberations, and considered by the WG as it developed its preliminary recommendations.

## 8 Annex A – PDP Working Group Charter

[PASTE WG Charter HERE]

## 9 Annex B – WG Request for GNSO Stakeholder Group / Constituency Statements

### Stakeholder Group / Constituency Input Template

IGO-INGO Access to Curative Rights Protection Mechanisms Working Group

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December 12, 2014

Dear [SG/C/SO/AC Chair]

We write as the Co-Chairs of the GNSO's IGO-INGO Access to Curative Rights Protections (CRP) Working Group (WG), which was chartered by the GNSO Council to conduct a Policy Development Process (PDP) to determine:

- (1) Whether the Uniform Dispute Resolution Policy (UDRP) and/or the Uniform Rapid Suspension procedure (URS) should be amended, and if so, how; or
- (2) Whether a separate, narrowly-tailored dispute resolution procedure modeled on the UDRP and/or the URS should be developed, in either case to address the specific needs and concerns of International Governmental Organizations (IGOs) and/or International Non-Governmental Organizations (INGOs).

The origin of this WG lies in the work of the previous GNSO PDP Working Group on the Protection of International Organizational Names in All gTLDs, whose recommendations had been unanimously adopted by the GNSO Council at the GNSO Council meeting on 20 November 2013. One of those recommendations was for the GNSO Council to request an Issue Report on the question of curative rights protection for IGOs and INGOS, which led to the formation of this WG. The WG commenced its work in August 2014. The GNSO's PDP Manual mandates that each PDP WG reach out at an early stage to all GNSO Stakeholder Groups and Constituencies to seek their input, and encourages WGs to seek input from ICANN's Supporting Organizations and Advisory Committees as well. Given the progress and decisions made by our WG, we are now writing to update you on our activities to date, and to provide your group with an opportunity to assist the WG with its assigned task, in respect of the following questions and issues that stem from our Charter and the initial deliberations of the WG.

First, we wish to inform you that the WG has reached a majority decision that there is no principled reason to consider INGOS in general as a special category of protected



organizations, for purposes of the specific tasks for which the WG was chartered in this PDP. The rationale for this decision is provided in Attachment A.<sup>66</sup>

***Question 1: What is the [your organization]'s view on the WG's decision to exclude INGOs from further consideration in this PDP?***

Second, the WG has considered most of the background information available to it, including the documentation from the 2001-2 WIPO Process-2 and the previous scoping work done by the ICANN community (including the GNSO) in 2004 and 2007. It has also reviewed the various expressions of GAC advice concerning the issue of curative rights protection for IGOs, as expressed in several GAC Communiqués.

At this point, the WG would appreciate input from the [your organization] on the following questions that it will need to answer in the course of this PDP:

- One of the requirements under the UDRP and the URS is that the complainant must possess trademark or substantively similar rights in the word(s) for which the respondent has registered an identical or confusingly similar domain name (this is sometimes commonly called the “standing” requirement). The WG is still investigating the ability and practice of IGOs obtaining trademarks in their names and acronyms.

***Question 2: What should be the basis (if any) – other than trademark rights – for the “standing” criteria required in any dispute resolution process for IGOs?***

- A specific issue involving IGOs is the requirement for the organization, both as a domain registrant, and as a complainant under the UDRP and the URS, to agree to submit to the jurisdiction of a national court for purposes of an appeal. This may be problematic for IGOs due to possible issues with sovereign immunity. The WG is currently analyzing the sovereign immunity issue and is conducting research on how various nations have chosen to implement Paris Convention Article 6ter protections within their jurisdictions.

***Question 3: How should a curative rights process appropriately deal with this problem while also ensuring adequate due process protections for registrants?***

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<sup>66</sup> This determination is made with due recognition of the special protections afforded to the Red Cross movement and International Olympic Committee. Although the International Olympic Committee and the International Red Cross and Red Crescent Movement have access to and have used the existing Rights Protection Mechanisms, they have been afforded special protection by ICANN to reduce their reliance on these RPMs due to the volume of cybersquatting on the desirable names of these beneficent organizations, which compounded their cost and burden of using these RPMs. See <https://www.icann.org/resources/pages/reserved-2013-07-08-en/>. The Working Group understands this, and its statement regarding INGOs in general should be interpreted consistently with this special protection.

- The GAC has advised that any dispute resolution process relating to IGOs should be at no or nominal cost to the IGOs. The WG has noted that the fees and associated legal costs for the UDRP and the URS are substantially less than for litigation involving the same matters. Although the WG's charter tasks it to analyze the issue of costs, the WG does not have the ability to create any fund or other subsidy mechanisms for IGOs who claim an inability to shoulder the costs of existing dispute resolution mechanisms.

**Question 4: What is the [your organization]'s view on this issue, and in your view are the existing UDRP and URS fees "nominal"?**

In addition to the above questions, the WG Charter, which can be found at <http://gnso.icann.org/en/drafts/igo-ingo-crp-access-charter-24jun14-en.pdf>, requires the WG to discuss a number of other issues. We would welcome the [your organization]'s feedback on any or all of these Charter questions.

In particular, we would welcome input on the following topics:

- Whether the URS should be a Consensus Policy;
- Considerations of applying policies formulated by this WG to both "legacy" gTLDs and the new gTLDs currently being delegated in this expansion round. (**Note:** This may potentially include the URS, which is currently mandatory only for gTLDs delegated under ICANN's New gTLD Program. The WG also notes that the GNSO is scheduled to examine the issue of the efficacy of all rights protection mechanisms (RPMs) in both the legacy and new gTLDs in an upcoming Issue Report in early 2015);
- Whether the UDRP or the URS, or both, should be amended to address the particular needs and concerns of IGOs; and, if so, how;
- If the UDRP and/or the URS are not to be amended, whether a specific, narrowly-tailored dispute resolution procedure designed to address the particular needs and concerns of IGOs should be developed.

Thank you for the [your organization]'s consideration of these questions. We look forward to any comments and any input that you and the organization you Chair are able to provide to our WG. If possible, please forward your comments and input to us by **Friday, January 23 2015** so that we may fully consider it in our further deliberations.

Best regards,

Philip Corwin & Petter Rindforth (WG Co-Chairs)



### Attachment A

#### **Rationale for the Working Group's Decision to Exclude International Non-Governmental Organizations (INGOs) from Further Consideration in our Deliberations**

The WG has made an initial determination to exclude INGOs from further consideration for special curative rights protection procedures aside from the existing and un-amended UDRP and URS for the following reasons:

- Many INGOs already have, and do enforce their trademark rights, and there is no perceivable barrier to other INGOs obtaining trademark rights in their names and/or acronyms and subsequently utilizing those rights as the basis for standing in the existing dispute resolution procedures (DRPs) created and offered by ICANN as a faster and lower cost alternative to litigation.
- There is no claim of a “sovereign immunity” obstacle hindering INGOs from submitting to national jurisdiction in the appeals process from the existing DRPs, and some INGOs regularly use the UDRP to protect their rights.
- Given the above determinations regarding access to trademark rights and irrelevance of the sovereign immunity issue, the WG believes that there is no principled reason to consider any amendment of the UDRP or the URS to accommodate INGOs.
- Although some INGOs may be concerned about the cost of using the UDRP and the URS, because enforcement through these RPMs involves some expenditure of funds, this is not a problem for all INGOs nor is it unique to INGOs as rights holders; furthermore, the issue of ICANN subsidizing INGOs to utilize DRPs is outside the scope of this WG’s Charter and its authority.
- The September 1, 2013 United Nations Economic and Social Council (ECOSOC) list of non-governmental organizations in consultative status with it consists of nearly 4,000 organizations, of which 147 organizations were in general consultative status, 2,774 in special consultative status, and 979 on the Roster. The WG also became aware that there might be many more organizations not presently on the ECOSOC list who might claim the right to utilize any new curative rights process (CRP) created for INGOs. The WG felt that the sheer scale of INGOs, in combination with the factors cited above, weighed against creation of a special DRP.
- While this is the “IGO-INGO Access to Curative Rights Protection Working Group”, its Charter (available at <http://gnso.icann.org/en/drafts/igo-ingo-crp-access-charter-24jun14-en.pdf>) does not require it to develop a CRP mechanism responsive to any special legal status for all INGOs. Rather, the Charter only requires it to consider “*The relevance of specific legal protections under international legal instruments and various national laws for IGOs and certain INGOs (namely, the Red Cross movement and the International Olympic Committee)*” (Emphasis added). The Charter also requires that this WG consider “The distinctions (if any) between IGOs and INGOs for purposes of this PDP”. The WG has considered those distinctions and determined that they are sufficient such that a specially-tailored DRP for INGOs generally is not warranted, and that the

WG should focus its remaining time and attention on the complex issues relating to protections for IGOs.

The determination to suspend further consideration of INGO access to DRPs takes into consideration the special protections afforded to the Red Cross movement and the International Olympic Committee. The WG noted that although these INGOs are specifically highlighted by the GAC and the Charter provision cited above as enjoying international legal treaty protections and rights under multiple national laws, for the purposes of this PDP they have demonstrated that: (1) they have access to the UDRP and the URS; and (2) they possess trademark rights that they defend and enforce. As such, for the limited purpose of considering access of INGOs to curative rights protections, the WG determined there was no principled reason to distinguish them from other INGOs. The WG noted that legal representatives of the International Olympic Committee are active in the WG and fully support this conclusion.

The determinations cited above represent a strong majority position among all participating members of the WG. A minority view was expressed based on the viewpoint that the case for considering creation of a special DRP even for IGOs was too weak to justify further WG time and effort. That minority view did not prevail and the WG will continue to consider whether any special needs or considerations relating to IGOs justify amendment of the UDRP and the URS or, in the alternative, provide a rationale for creation of a DRP solely for use by IGOs.

## 10 Annex C – WG Request for Input from ICANN SO/ACs

### Supporting Organization / Advisory Committee Input Template

IGO-INGO Access to Curative Rights Protection Mechanisms Working Group

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December 12, 2014

Dear [SG/C/SO/AC Chair]

We write as the Co-Chairs of the GNSO's IGO-INGO Access to Curative Rights Protections (CRP) Working Group (WG), which was chartered by the GNSO Council to conduct a Policy Development Process (PDP) to determine:

- (1) Whether the Uniform Dispute Resolution Policy (UDRP) and/or the Uniform Rapid Suspension procedure (URS) should be amended, and if so, how; or
- (2) Whether a separate, narrowly-tailored dispute resolution procedure modeled on the UDRP and/or the URS should be developed, in either case to address the specific needs and concerns of International Governmental Organizations (IGOs) and/or International Non-Governmental Organizations (INGOs).

The origin of this WG lies in the work of the previous GNSO PDP Working Group on the Protection of International Organizational Names in All gTLDs, whose recommendations had been unanimously adopted by the GNSO Council at the GNSO Council meeting on 20 November 2013. One of those recommendations was for the GNSO Council to request an Issue Report on the question of curative rights protection for IGOs and INGOs, which led to the formation of this WG. The WG commenced its work in August 2014. The GNSO's PDP Manual mandates that each PDP WG reach out at an early stage to all GNSO Stakeholder Groups and Constituencies to seek their input, and encourages WGs to seek input from ICANN's Supporting Organizations and Advisory Committees as well. Given the progress and decisions made by our WG, we are now writing to update you on our activities to date, and to provide your group with an opportunity to assist the WG with its assigned task, in respect of the following questions and issues that stem from our Charter and the initial deliberations of the WG.

First, we wish to inform you that the WG has reached a majority decision that there is no principled reason to consider INGOs in general as a special category of protected

organizations, for purposes of the specific tasks for which the WG was chartered in this PDP. The rationale for this decision is provided in Attachment A.<sup>67</sup>

***Question 1: What is the [your organization]’s view on the WG’s decision to exclude INGOs from further consideration in this PDP?***

Second, the WG has considered most of the background information available to it, including the documentation from the 2001-2 WIPO Process-2 and the previous scoping work done by the ICANN community (including the GNSO) in 2004 and 2007. It has also reviewed the various expressions of GAC advice concerning the issue of curative rights protection for IGOs, as expressed in several GAC Communiqués.

At this point, the WG would appreciate input from the [your organization] on the following questions that it will need to answer in the course of this PDP:

- One of the requirements under the UDRP and the URS is that the complainant must possess trademark or substantively similar rights in the word(s) for which the respondent has registered an identical or confusingly similar domain name (this is sometimes commonly called the “standing” requirement). The WG is still investigating the ability and practice of IGOs obtaining trademarks in their names and acronyms.

***Question 2: What should be the basis (if any) – other than trademark rights – for the “standing” criteria required in any dispute resolution process for IGOs?***

- A specific issue involving IGOs is the requirement for the organization, both as a domain registrant, and as a complainant under the UDRP and the URS, to agree to submit to the jurisdiction of a national court for purposes of an appeal. This may be problematic for IGOs due to possible issues with sovereign immunity. The WG is currently analyzing the sovereign immunity issue and is conducting research on how various nations have chosen to implement Paris Convention Article 6ter protections within their jurisdictions.

***Question 3: How should a curative rights process appropriately deal with this problem while also ensuring adequate due process protections for registrants?***

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<sup>67</sup> This determination is made with due recognition of the special protections afforded to the Red Cross movement and International Olympic Committee. Although the International Olympic Committee and the International Red Cross and Red Crescent Movement have access to and have used the existing Rights Protection Mechanisms, they have been afforded special protection by ICANN to reduce their reliance on these RPMs due to the volume of cybersquatting on the desirable names of these beneficent organizations, which compounded their cost and burden of using these RPMs. See <https://www.icann.org/resources/pages/reserved-2013-07-08-en/>. The Working Group understands this, and its statement regarding INGOs in general should be interpreted consistently with this special protection.

- The GAC has advised that any dispute resolution process relating to IGOs should be at no or nominal cost to the IGOs. The WG has noted that the fees and associated legal costs for the UDRP and the URS are substantially less than for litigation involving the same matters. Although the WG's charter tasks it to analyze the issue of costs, the WG does not have the ability to create any fund or other subsidy mechanisms for IGOs who claim an inability to shoulder the costs of existing dispute resolution mechanisms.

**Question 4: What is the [your organization]'s view on this issue, and in your view are the existing UDRP and URS fees "nominal"?**

In addition to the above questions, the WG Charter, which can be found at <http://gns0.icann.org/en/drafts/igo-ingo-crp-access-charter-24jun14-en.pdf>, requires the WG to discuss a number of other issues. We would welcome the [your organization]'s feedback on any or all of these Charter questions.

In particular, we would welcome input on the following topics:

- Whether the URS should be a Consensus Policy;
- Considerations of applying policies formulated by this WG to both "legacy" gTLDs and the new gTLDs currently being delegated in this expansion round. (Note: This may potentially include the URS, which is currently mandatory only for gTLDs delegated under ICANN's New gTLD Program. The WG also notes that the GNSO is scheduled to examine the issue of the efficacy of all rights protection mechanisms (RPMs) in both the legacy and new gTLDs in an upcoming Issue Report in early 2015);
- Whether the UDRP or the URS, or both, should be amended to address the particular needs and concerns of IGOs; and, if so, how;
- If the UDRP and/or the URS are not to be amended, whether a specific, narrowly-tailored dispute resolution procedure designed to address the particular needs and concerns of IGOs should be developed.

Thank you for the [your organization]'s consideration of these questions. We look forward to any comments and any input that you and the organization you Chair are able to provide to our WG. If possible, please forward your comments and input to us by **Friday, January 23 2015** so that we may fully consider it in our further deliberations.

Best regards,

Philip Corwin & Petter Rindforth (WG Co-Chairs)





## 11 Annex D – Text of Article 6ter of the Paris Convention for the Protection of Industrial Property

### 11.1 Full Text of Article 6ter of the Paris Convention<sup>68</sup>

#### Article 6ter of the Paris Convention

##### **Marks: Prohibitions concerning State Emblems, Official Hallmarks, and Emblems of Intergovernmental Organizations**

(1) (a) The countries of the Union agree to refuse or to invalidate the registration, and to prohibit by appropriate measures the use, without authorization by the competent authorities, either as trademarks or as elements of trademarks, of armorial bearings, flags, and other State emblems, of the countries of the Union, official signs and hallmarks indicating control and warranty adopted by them, and any imitation from a heraldic point of view.

(b) The provisions of subparagraph (a), above, shall apply equally to armorial bearings, flags, other emblems, abbreviations, and names, of international intergovernmental organizations of which one or more countries of the Union are members, with the exception of armorial bearings, flags, other emblems, abbreviations, and names, that are already the subject of international agreements in force, intended to ensure their protection.

(c) No country of the Union shall be required to apply the provisions of subparagraph (b), above, to the prejudice of the owners of rights acquired in good faith before the entry into force, in that country, of this Convention. The countries of the Union shall not be required to apply the said provisions when the use or registration referred to in subparagraph (a), above, is not of such a nature as to suggest to the public that a connection exists between the organization concerned and the armorial bearings, flags, emblems, abbreviations, and names, or if such use or registration is probably not of such a nature as to mislead the public as to the existence of a connection between the user and the organization.

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<sup>68</sup> The full text of Article 6ter of the Paris Convention as replicated in this Annex was obtained from this link: [http://www.wipo.int/article6ter/en/legal\\_texts/article\\_6ter.html](http://www.wipo.int/article6ter/en/legal_texts/article_6ter.html)

(2) Prohibition of the use of official signs and hallmarks indicating control and warranty shall apply solely in cases where the marks in which they are incorporated are intended to be used on goods of the same or a similar kind.

(3) (a) For the application of these provisions, the countries of the Union agree to communicate reciprocally, through the intermediary of the International Bureau, the list of State emblems, and official signs and hallmarks indicating control and warranty, which they desire, or may hereafter desire, to place wholly or within certain limits under the protection of this Article, and all subsequent modifications of such list. Each country of the Union shall in due course make available to the public the lists so communicated. Nevertheless such communication is not obligatory in respect of flags of States.

(b) The provisions of subparagraph (b) of paragraph (1) of this Article shall apply only to such armorial bearings, flags, other emblems, abbreviations, and names, of international intergovernmental organizations as the latter have communicated to the countries of the Union through the intermediary of the International Bureau.

(4) Any country of the Union may, within a period of twelve months from the receipt of the notification, transmit its objections, if any, through the intermediary of the International Bureau, to the country or international intergovernmental organization concerned.

(5) In the case of State flags, the measures prescribed by paragraph (1), above, shall apply solely to marks registered after November 6, 1925.

(6) In the case of State emblems other than flags, and of official signs and hallmarks of the countries of the Union, and in the case of armorial bearings, flags, other emblems, abbreviations, and names, of international intergovernmental organizations, these provisions shall apply only to marks registered more than two months after receipt of the communication provided for in paragraph (3), above.

(7) In cases of bad faith, the countries shall have the right to cancel even those marks incorporating State emblems, signs, and hallmarks, which were registered before November 6, 1925.

(8) Nationals of any country who are authorized to make use of the State emblems, signs, and hallmarks, of their country may use them even if they are similar to those of another country.

(9) The countries of the Union undertake to prohibit the unauthorized use in trade of the State armorial bearings of the other countries of the Union, when the use is of such a nature as to be misleading as to the origin of the goods.

(10) The above provisions shall not prevent the countries from exercising the right given in paragraph (3) of Article 6quinquies, Section B, to refuse or to invalidate the registration of marks incorporating, without authorization, armorial bearings, flags, other State emblems, or official signs and hallmarks adopted by a country of the Union,

as well as the distinctive signs of international intergovernmental organizations referred to in paragraph (1), above".

## 12 Annex E – Final Legal Memo From Professor Edward Swaine

### 12.1 Full Text of Legal Memo on IGO Jurisdictional Immunity Prepared by Professor Edward Swaine

#### Memorandum

Date: 6/17/2016

To: Mary Wong, Senior Policy Director  
Steve Chan, Senior Policy Manager

From: Edward Swaine

RE: IGO Immunity

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#### 1. Introduction and Summary

I was asked the following questions:

*1. In relation to the requirement to select a “Mutual Jurisdiction” 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 an asserted conflict between the IGO’s and the domain name registrant’s rights – even when the IGO has initiated the dispute under a dispute resolution process that is in addition to, and not a replacement for, the registrant’s legal rights under its applicable national law?*

*2. Are there procedural or other mechanisms which an IGO may use to escape or avoid becoming subject to judicial action brought by a domain name registrant arising from an asserted conflict between the IGO’s and the registrant’s rights?*

*3. To the best of your knowledge, how do IGOs generally handle standard commercial contractual clauses concerning submission to a particular jurisdiction or dispute resolution method?*

*4. Are there additional principles, nuances or other relevant information (including to your knowledge general principles of law which have been applied by States) that are relevant to our work to find a solution and conclusion on domain name disputes related to IGOs?*

In addressing these questions, this memo makes some simplifying assumptions. First, while domain-related litigation involving an international or intergovernmental organization (“IGO”) might arise in different ways, this focuses on the most likely scenario: that in which an IGO, possessing rights in a name, abbreviation, emblem or the like arising under the Paris Convention (“name,” for short), has complained and prevailed before an administrative panel in Uniform Domain Name Dispute Resolution Policy (“Policy” or “UDRP”)<sup>69</sup> proceedings against a domain-name registrant—resulting in an order of cancellation or transfer to which the losing registrant objects by commencing a judicial action. Whether that action succeeds will depend on the facts, and the law of the jurisdiction concerned, but this memo assumes that a court would properly exercise jurisdiction over the action but for the possibility that the IGO is entitled to immunity.

Even focusing on immunity, some generalization is required. Immunity obligations vary by state and by the IGO concerned: immunity decisions are often based on organization-specific treaties to which not all states are party, and even states subject to the same international obligations implement them in varying ways. While jurisdictions in which IGOs are active may offer guidance, other jurisdictions offer much less, and there is no certain overlap between states with a developed IGO immunity jurisprudence and those hosting registrars or domain-name registrants. This memo will focus on jurisdictions in which follow-on litigation seems likely, particularly the United States—which hosts registrars and affords a clear statutory basis for so-called reverse domain name hijacking suits. Each jurisdiction will, however, resolve immunity questions according to its own law. Immunity concerns each state’s exercise of its own jurisdiction, and as a jurisdictional question will presumptively be determined by the law of the forum, as informed by international law.

Putting these complications aside, the situation raises at least two distinct immunity issues. The first, more abstract question is whether—absent the Mutual Jurisdiction provision, which assents to court proceedings following certain UDRP proceedings—an IGO would in principle enjoy immunity from judicial process with respect to name-related rights it might

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<sup>69</sup> See <https://www.icann.org/resources/pages/policy-2012-02-25-en/>. The Policy, and this memo, focus on the circumstances of the generic Top Level Domains (gTLDs), as to which the UDRP applies. And for simplicity’s sake, this memo will focus on the UDRP rather than the newer Uniform Rapid Suspension System (URS). Although the URS establishes a different administrative procedure, applicable to a different range of TLDs, it does not appear to pose distinct immunity issues—insofar as a party to URS proceedings may either follow with UDRP proceedings (with the possibility of later recourse to a Mutual Jurisdiction) or initiate judicial proceedings directly based on a similar jurisdictional commitment. See URS, §13, <http://newgtlds.icann.org/en/applicants/urs/procedure-01mar13-en.pdf>; URS Rules, Uniform Rapid Suspension System (URS) Rules, Rule 1 (defining “Mutual Jurisdiction”), Rule 3(b)(ix) (providing for complainant’s submission that it “will submit, with respect to any challenges to a determination in the URS proceeding, to the jurisdiction of the courts in at least one specified Mutual Jurisdiction”), <http://newgtlds.icann.org/en/applicants/urs/rules-28jun13-en.pdf>.

assert in the UDRP proceedings. The answer depends on whether the jurisdiction in which the case arises would apply an absolute, functional, or restrictive immunity approach to the IGO in question. That may be hard to predict. In the United States, unless an IGO benefits from broader treaty protection—as the United Nations, but *not* its specialized agencies, does, because the United States is only party to a treaty governing the former’s immunity—the question is addressed by the International Organizations Immunities Act (the “IOIA”), but some cases interpret the statute as establishing absolute immunity and others view it as establishing restrictive immunity only. Other states tend to favor either an absolute or a functional approach. Which approach is taken may be material. If an IGO is entitled to absolute immunity, it would in principle be protected from a suit of the kind in question, and probably under a functional approach as well—because an IGO’s protection of its name is likely to be deemed part of its functions. Immunity is less likely under a restrictive approach, which might regard this as more akin to trademark-related activity that is commercial in character.

The second, more relevant, question is whether—in light of an IGO’s assent to Mutual Jurisdiction—its immunity remains. Here, the more likely answer is that it would not. IGOs are capable of waiving their immunity from suit, and if they do so, they may no longer interpose immunity as a defense if another party commences a judicial action falling within the scope of that waiver. The grant of Mutual Jurisdiction would likely establish such a waiver, as it would for a state entity otherwise entitled to foreign sovereign immunity. This waiver would be construed narrowly, but it would likely permit proceeding against an IGO in at least some domestic courts.

The overall answer, then, is contingent. If there were no Mutual Jurisdiction clause, an IGO might be entitled to immunity from judicial process; in the status quo, however, it likely would not. Equitable considerations might influence any judicial analysis. If the Mutual Jurisdiction obligation were altered to preserve IGO immunity, without any possibility of judicial recourse, it might be considered an insufficient remedy for domain registrants. And because the IGO would have availed itself of a procedure to which it would not otherwise be entitled, by initiating UDRP proceedings, it might seem unfair for it to invoke a defense unavailable to the other party. An IGO, on the other hand, might regard the present Mutual Jurisdiction clause as requiring it to make a greater compromise than the average complainant: not merely acquiescing in the choice of a particular jurisdiction, but also consenting to the very possibility of a judicial proceeding—more than anything required of parties that lack immunity in the first place.

Several alternatives may be considered. IGOs may be able to use an assignment of rights, or similar mechanism, to allow their interests to be expressed in UDRP proceedings while disassociating the IGO itself from any waiver. IGOs might also volunteer a non-judicial substitute, such as arbitration—for example, according to the United Nations Commission on International Trade Law (“UNCITRAL”)—in lieu of follow-on judicial proceedings. While this is often employed in staff-related matters or commercial dealings, it translates imperfectly to the UDRP context. Unlike a potential employee or contract partner, who may decline to accept such an arrangement and take its business elsewhere, an arbitration alternative to Mutual Jurisdiction would likely force a domain-name registrant to accept that possibility (for any potential IGO matters) in order to register—essentially, shifting any immunity concession by IGOs into an arbitration concession by domain registrants, and raising judicial concerns about access to court. Other avenues may be available, but should be considered with sensitivity both to immunity-related concerns and to the legitimate interests of domain-name registrants.

## 2. Background

The UDRP provides that registrants must submit to a mandatory administrative proceeding, before a stipulated dispute resolution service provider,<sup>70</sup> upon submission of a complaint that the domain name is identical or confusingly similar to a mark in which the complainant has rights, the registrant has no rights or legitimate interests in respect of the domain name, and the domain name has been registered and is being used in bad faith. UDRP, para. 4(a).

IGOs are among the possible parties to such proceedings. An IGO may register a domain name and, in theory, find itself a respondent to an administrative complaint brought by a mark's owner. In practice, however, IGOs are more likely to be complainants, alleging that another party has registered a domain name in bad faith. Article 6*ter* of the Paris Convention, as augmented by the Trademark Law Treaty of 1994 and the Singapore Treaty on the Law of Trademarks, extends to certain IGOs protections for, inter alia, their names and abbreviations, giving rise in appropriate circumstances to a protectable interest they may seek to vindicate.<sup>71</sup> Although Paragraph 4 of the Policy indicates that a UDRP complaint is to be framed in terms of "trademark or service mark," rather than names and other interests indicated in Article 6*ter*, such interests appear to suffice for purposes of initiating a complaint against a domain-name registrant.<sup>72</sup> Indeed, several IGOs—including the International Mobile Satellite Organization (INMARSAT), the International Bank for Reconstruction and Development (IBRD), and the Bank for International Settlement (BFIS)—have prevailed in UDRP complaints.<sup>73</sup>

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<sup>70</sup> See <https://www.icann.org/resources/pages/providers-6d-2012-02-25-en>.

<sup>71</sup> Paris Convention for the Protection of Industrial Property, Mar. 20, 1883, art. 6*ter*, 21 U.S.T. 1583, 828 U.N.T.S. 305; Trademark Law Treaty, Oct. 27, 1994, S. Treaty Doc. 105-35, 2037 U.N.T.S. 35; Singapore Treaty on the Law of Trademarks, Mar. 27, 2006, S. Treaty Doc. No. 110-2. For discussion of the relevant preconditions, including notification of the relevant emblems and signs for which protection may be sought, see WIPO Secretariat, Article 6*ter* of the Paris Convention: Legal and Administrative Aspects (SCT/15/3) (2005), [http://www.wipo.int/edocs/mdocs/sct/en/sct\\_15/sct\\_15\\_3.pdf](http://www.wipo.int/edocs/mdocs/sct/en/sct_15/sct_15_3.pdf). See also Agreement Between the World Intellectual Property Organization and the World Trade Organization (WTO-WIPO Cooperation Agreement), Dec. 22, 1995, at [http://www.wto.org/english/tratop\\_e/trips\\_e/wtowip\\_e.htm](http://www.wto.org/english/tratop_e/trips_e/wtowip_e.htm).

<sup>72</sup> See generally Gerald M. Levine, Domain Name Arbitration: A Practical Guide to Asserting and Defending Claims of Cybersquatting Under the Uniform Domain Name Dispute Resolution Policy 99-100 (2015) (noting "potentiality" approach to a complainant's interests).

<sup>73</sup> Respectively, in International Mobile Satellite Organisation and Inmarsat Ventures Limited (formerly known as Inmarsat Holdings Limited) v. Domains, EntreDomains Inc. and Brian Evans, D2000-1339 (WIPO Nov. 30, 2000); International Bank For Reconstruction and Development d/b/a The World Bank v. Yoo Jin Sohn, D2002-0222 (WIPO May 7, 2002); and Bank for International Settlements v. BFIS, D2003-0984 (WIPO March 1, 2004), Bank for International Settlements v. BIS, D2003-0986 (WIPO March 2, 2004), Bank for International Settlements v. James Elliott, D2003-0987 (WIPO March 3, 2004), Bank for International Settlements v. G.I Joe, D2004-0570 (WIPO (Sept. 27, 2004), Bank for International Settlements v. BIS, D2004-0571 (WIPO Oct. 1, 2004), and Bank for International Settlements v. Fortune Nwaiwu, D2004-0575 (WIPO Oct. 1, 2004). A few other matters are catalogued in the Index of WIPO UDRP Panel Decisions, <http://www.wipo.int/amc/en/domains/search/legalindex/>, as involving IGOs. In one, involving the European Monitoring Centre for Drugs and Drug Addiction (EMCDDA), a decentralized agency of the



Although the Policy describes this procedure as “mandatory” (para. 4), it is less coercive than that would suggest, and the fact that IGOs incorporated within the UDRP is not itself particularly problematic. An IGO solely interested in preventing a domain-name registrant from using its name or something confusingly similar may commence a judicial action in a relevant jurisdiction—just as it might in the absence of the UDRP.<sup>74</sup> In the United States, for example, an IGO could file an action under the Lanham Act, as modified by the Anticybersquatting Consumer Protection Act (ACPA), although that route may present hurdles for foreign parties like IGOs.<sup>75</sup>

For IGOs bound to use the UDRP process because they are domain-name registrants, that constraint is not especially onerous, nor does it severely limit even those IGOs who elect to employ it by filing UDRP complaints. Paragraph 4(k) provides that “The mandatory administrative proceeding requirements set forth in Paragraph 4 shall not prevent either [the registrant] or the complainant from submitting the dispute to a court of competent jurisdiction for independent resolution before such mandatory administrative proceeding is commenced or after such proceeding is concluded.”<sup>76</sup> The obligation to submit to UDRP proceedings, or even the choice thereof, does not interfere unduly with the preexisting option to submit the matter to judicial proceedings.<sup>77</sup>

In these respects, the UDRP simply offers an alternative arbitral process to IGOs. What may be less welcome to IGOs, however, is the fact that the UDRP also *compels* consent to judicial proceedings if the losing party elects to pursue them—in the principal scenario, meaning that a complained-against domain-name registrant can take the IGO to court. According to the Rules for the Uniform Domain Name Dispute Resolution Policy (“Rules”),<sup>78</sup> a complaint must indicate that “Complainant will submit, with respect to any challenges 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.” Rules, ¶ 3(b)(xii). Such “Mutual

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European Union, the complaint was denied due to its failure to establish rights to marks or services. European Monitoring Centre for Drugs and Drug Addiction (EMCDDA) v. Virtual Clicks / Registrant ID:CR36884430, Registration Private Domains by Proxy, Inc., D2010-0475 (WIPO July 7, 2010). In another, involving UNITAID, an IGO hosted by the World Health Organization (WHO), trademark rights were assigned by a fiduciary agreement to a private enterprise, which registered them on behalf of the WHO and UNITAID. Lenz & Staehelin Ltd v. Christopher Mikkelsen, D2012-1922 (WIPO Jan. 8, 2013).

<sup>74</sup> See Parisi v. Netlearning, Inc., 139 F. Supp. 2d 745, 751 (E.D. Va. 2001) (“UDRP complainants, as strangers to the registration agreement, are under no obligation to avail themselves of the UDRP”) (citing BroadBridge Media, L.L.C. v. Hypercd.com, 106 F. Supp. 2d 505, 509 (S.D.N.Y. 2000)); see also Oneida Tribe of Indians of Wisconsin v. Harms, 2005 WL 2758038 (E.D. Wis. 2005); GlobalSantaFe Corp. v. Globalsantafe.com, 250 F. Supp. 2d 610 (E.D. Va. 2003).

<sup>75</sup> See 5 U.S.C. §§ 1114, 1125. In addition to conventional hurdles, like proper venue and personal jurisdiction, an IGO with an interest in a foreign mark may not have a protectable interest under U.S. law. See *infra* note 83.

<sup>76</sup> For ease of discussion, the remaining discussion will generally assume that any litigation follows resolution of the administrative proceeding.

<sup>77</sup> This may also mean that if an IGO is unsatisfied with its initial choice of a judicial proceeding, it can initiate UDRP proceedings thereafter. In Gerolsteiner Brunnen GmbH & Co., KG v. R4L Privacy Advocate/Gero Leon Steiner, D2008-1450 (WIPO Nov. 7, 2008), a complainant initiated proceedings in order to object to the transfer of a domain name to a new registrant after it had received an order from a German court prohibiting the original registrant from using the domain name or allowing it to be used.

<sup>78</sup> See <https://www.icann.org/resources/pages/udrp-rules-2015-03-11-en>.

Jurisdiction” is defined as either the principal office of the Registrar or the domain-name holder’s stipulated address.<sup>79</sup> Accordingly, an IGO complainant will have consented to judicial proceedings if a losing respondent wishes to challenge a cancellation or transfer<sup>80</sup>—in a jurisdiction that the IGO will have selected, but from limited choices that the registrant can craft through its choice of registrar and its registering address.

How matters unfold from that point will depend on national law. Most follow-on actions have been filed in the United States, and the ACPA provides registrants with a cause of action enabling them, in appropriate circumstances, to restore domain names lost during the UDRP process.<sup>81</sup> Such follow-on litigation is expensive and may be infrequently pursued, but even so it may cause concern. The UDRP result receives no deference.<sup>82</sup> In addition, IGOs holding foreign marks, and certainly those seeking protection for names *not* protectable as marks at all, may be out of luck: some U.S. decisions have permitted the enforcement only of trademark rights protectable under U.S. law, notwithstanding any obligations that would appear to arise under Article 6ter of the Paris Convention.<sup>83</sup> Results may vary, of course, by jurisdiction.

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<sup>79</sup> More specifically, “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.” Rules, ¶ 1.

<sup>80</sup> If the registrant actually prevailed in the UDRP proceeding, the IGO has two options. First, it can acquiesce in the adverse result, rather than initiate any judicial proceedings to reconsider it. Its immunity, in that scenario, is not directly at issue—only its refusal to *compromise* that immunity. Second, and alternatively, the IGO could commence judicial proceedings, per the Mutual Jurisdiction scheme. That option exists, however, much as it would absent the UDRP (at least so long as the UDRP receives no judicial deference in the relevant jurisdiction), and amounts to a decision to waive immunity.

<sup>81</sup> 15 U.S.C. § 1114(2)(D)(v) (“A domain name registrant whose domain name has been suspended, disabled, or transferred under a policy described under clause (ii)(II) may, upon notice to the mark owner, file a civil action to establish that the registration or use of the domain name by such registrant is not unlawful under this chapter. The court may grant injunctive relief to the domain name registrant, including the reactivation of the domain name or transfer of the domain name to the domain name registrant.”).

<sup>82</sup> See *Storey v. Cello Holdings, L.L.C.*, 347 F.3d 370, 382–83 (2d Cir. 2003); *Hawes v. Network Solutions, Inc.*, 337 F.3d 377, 386–87 (4th Cir. 2003); *Barcelona.com, Inc. v. Excelentísimo Ayuntamiento de Barcelona*, 330 F.3d 617, 626 (4th Cir. 2003); *Dluhos v. Strasberg*, 321 F.3d 365, 373–74 (3d Cir. 2003); *Sallen v. Corinthians Licenciamentos LTDA*, 273 F.3d 14, 28 (1st Cir. 2001).

<sup>83</sup> *Barcelona.com, Inc. v. Excelentísimo Ayuntamiento de Barcelona*, 330 F.3d 617, 627–29 (4th Cir. 2003) (reversing decision in favor of Spanish-law mark, because “United States courts do not entertain actions seeking to enforce trademark rights that exist only under foreign law,” and holding that the “City Council could not obtain a trademark interest in a purely descriptive geographical designation that refers only to the City of Barcelona” under U.S. law); see also *International Finance Corporation v. Bravo Company*, 64 U.S.P.Q.2d 1597 (Trademark Tr. & App. Bd. 2002) (rejecting opposition to trademark registration on the basis of Article 6ter). Domain-name registrants have been permitted at least provisionally to proceed against those holding an interest in a name not registered as U.S. marks, likely on the premise that the name was protectable. *Sallen v. Corinthians Licenciamentos LTDA*, 273 F.3d 14, 23–24 (1st Cir. 2001). Still, if the view expressed in *Barcelona.com* prevails, one commentator observed, “foreign mark owners will always lose UDRP review cases filed by domain name registrants” under the ACPA; “unless foreign mark owners can also demonstrate trademark rights under U.S. law, nothing will prevent registrants from

In short, the Mutual Jurisdiction clause means that participating IGOs will have agreed to the possibility of a judicial process, notwithstanding any immunity to which they otherwise would be entitled. This will loom largest in cases in which the IGO is the complainant and benefited from an initial panel decision in its favor, such that the decision to resort to judicial proceedings against the IGO—and the risks that creates for adverse results—is made by the private party.

The remainder of the memo will focus on that scenario. There are other circumstances, however, in which the IGO or its domain-related interests might conceivably be drawn into litigation.<sup>84</sup> Some involve closely-related issues of IGO immunity. Parties registering domain names also consent, in similar terms, to Mutual Jurisdiction.<sup>85</sup> This may be relevant in two

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proving that their use of the domain name embodying a foreign mark was lawful under the Lanham Act . . . even if their conduct . . . would qualify as cybersquatting under the UDRP or the ACPA (had it been challenged by a mark owner with U.S. rights).” Laurence R. Helfer, *Whither the UDRP: Autonomous, Americanized, or Cosmopolitan?*, 12 *Cardozo J. Int’l & Comp. L.* 498-99 (2004). Whatever these consequences, U.S. courts have consistently held that the Lanham Act, including its generally-applicable restrictions, are sufficient to discharge U.S. obligations under the Paris Convention—without giving additional weight to statutory provisions advertising to rights established by treaty. *Grupo Gigante SA de CV v. Dallo & Co.*, 391 F.3d 1088, 1099-1100 (9th Cir. 2004); *Barcelona.com, Inc.*, 330 F.3d at 628-29; *International Cafe, S.A.L. v. Hard Rock Cafe Int’l (U.S.A.), Inc.* 252 F.3d 1274, 1277-78 (11th Cir. 2001); see 5 U.S.C. § 1126(b). And the United States considers that it has discharged its Paris Convention obligations by enabling parties to initiate suit on their own behalf, declining to accept that it may be incumbent upon states to pursue in their courts relief against infringement on behalf of an IGO or other party concerned. U.S. Mission to the United Nations, *Note on the Enforcement of Obligations under the Paris Convention for the Protection of Industrial Property* (June 2002), 2002 Digest U.S. Prac. Int’l L. 389-91, <http://www.state.gov/s/l/38648.htm>.

<sup>84</sup> For example, in the event an IGO prevailed in the UDRP process, it might conceivably have to initiate a judicial action to compel cooperation by a registrar reluctant to effectuate a cancellation or transfer. Such an action might waive any immunity to which the IGO would otherwise be entitled. Alternatively, an original registrant may seek declaratory relief against a registrar with the aim of preventing the registrar’s cooperation with UDRP-based relief; jurisdiction in such a case would likely be prescribed by the registration agreement, and need not directly involve the IGO. Finally, although this discussion assumes that a judicial proceeding would proceed *in personam*, the ACPA also allows *in rem* proceedings by a mark’s owner against a domain name if the court finds that the owner either is not able to obtain *in personam* jurisdiction over an allowed defendant or was not able to find a person who would have been an allowed defendant. 15 U.S.C. § 1125(d)(2). To the extent the IGO has a property interest in a transferred domain name, it is likely that similar immunity interests would arise. *International Organizations Immunities Act of 1945*, 22 U.S.C. § 288a(b) (establishing that “International organizations, their property and their assets, wherever located, and by whomsoever held, shall enjoy the same immunity from suit and every form of judicial process as is enjoyed by foreign governments”); see *Odyssey Marine Exploration, Inc. v. Unidentified Shipwrecked Vessel*, 657 F.3d 1159 (11<sup>th</sup> Cir. 2011) (foreign sovereign immunity). If the IGO’s property interest has not yet been perfected, an *in rem* action may instead bear more directly on the registrar.

<sup>85</sup> The “Mutual Jurisdiction” definition in paragraph 1 of the Rules indicates that a domain-name holder may have “submitted in its Registration Agreement to that jurisdiction for court adjudication of disputes concerning or arising from the use of the domain name,” and the Registrar Accreditation Agreement provides that “[f]or the adjudication of disputes concerning or arising from use of the Registered Name, the Registered Name Holder shall submit, without prejudice to other potentially applicable jurisdictions,

different scenarios. Most obviously, if an IGO registers a domain name in its own right, another party may initiate a UDRP complaint concerning that registration, which may ultimately implicate the IGO registrant's assent to Mutual Jurisdiction.<sup>86</sup> It may also be relevant, however, if an IGO—this time as a complainant, and one that prevails in that complaint against a domain-name registrant—receives an award transferring the domain-name registration to it, since that would likely entail the IGO's consent to Mutual Jurisdiction and to further judicial proceedings.<sup>87</sup> Accordingly, any reconsideration of the grant of Mutual Jurisdiction should probably be harmonized with the terms required for IGO registration, which will in turn require coordination with registrars and their current terms.

### 3. Discussion

The core question is whether an IGO is “entitled to immunity,” but the baseline assumptions may be disaggregated. The scope of IGO immunity would most clearly be at issue if the Mutual Jurisdiction provision were irrelevant and the IGO had not itself initiated judicial proceedings, since that would risk waiving any immunity to which it may be entitled, including to counterclaims.<sup>88</sup> This might be the case, for example, if a domain-name registrant sought a declaratory judgment against an IGO in relation to some actual or potential infringement.<sup>89</sup> That

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to the jurisdiction of the courts (1) of the Registered Name Holder's domicile and (2) where Registrar is located.” See 2013 Registrar Accreditation Agreement, para. 3.7.7.10, <https://www.icann.org/resources/pages/approved-with-specs-2013-09-17-en#raa>; Levine, *supra* note 72, at 53 (2015).

<sup>86</sup> Consent to Mutual Jurisdiction would obviously be relevant in the event an IGO registrant prevailed in the UDRP proceeding and a complainant sought judicial review. If a complainant were successful, the options for the losing IGO registrant would be much the same as when an IGO complaint (against a domain-name registrant) is at first unsuccessful. See *supra* note 80.

<sup>87</sup> The precise basis for the IGO's consent may depend on the facts. The transfer of a registration to a prevailing IGO arguably establishes by itself the IGO's constructive consent to the prior registrant's terms, including Mutual Jurisdiction. A clearer basis might be afforded if subsequent re-registration by the IGO were required by ICANN or by the policy of an individual registrar, and certainly if the IGO elected itself to renew its registration or to change registrars afterward.

<sup>88</sup> For example, Libya was held to have waived any sovereign immunity to which it might be entitled under the FSIA in relation to particular types of counterclaims (those seeking monetary damages for tortious interference with contract and prospective business advantage) that arose out of the use of domain names that were the subject of an action, initiated by Libya itself, alleging violation of its rights under the Lanham Act and the Anticybersquatting Consumer Protection Act (ACPA). *Great Socialist People's Libyan Arab Jamahiriya v. Miski*, 683 F. Supp. 2d 1 (D.D.C. 2010).

<sup>89</sup> A few cases have explored analogous circumstances involving foreign states. In one, a domain name registrant sought declaratory and injunctive relief in a U.S. court against the Republic of South Africa and its agency or instrumentality, which had announced its intention eventually to assert its rights under some (uncertain) process to secure second-level domains including the country's name. The district court dismissed the action on the basis of South Africa's sovereign immunity, reasoning that its press release was not “commercial activity” warranting an exception to sovereign immunity under the Foreign Sovereign Immunities Act (FSIA) nor anything with sufficient connection to the United States. *Virtual Countries, Inc. v. Republic of South Africa*, 148 F. Supp. 2d 256 (S.D.N.Y. 2001), *aff'd*, 300 F.3d 230 (2nd Cir. 2002) (assuming *arguendo* that the press release was “commercial activity” and affirming on the ground that the commercial activity, if any, lacked the requisite “direct effect” within the United States under the FSIA).

scenario, though not otherwise of concern here, does usefully isolate the question as to whether an IGO has a legitimate expectation that it would be entitled to immunity *absent* the UDRP. If such immunity is minimal or uncertain, then any compromises required by the UDRP loom less large; if the IGO would otherwise be entitled to immunity, however, its potential sacrifice seems more substantial.

As explained in Part A, the answer depends. IGOs generally enjoy immunity under international law, but different jurisdictions apply the law differently, and even within the same jurisdiction different IGOs may be treated differently. Part B then introduces the complication that any such immunity may be waived through the Mutual Jurisdiction provision, and affording such waiver is not the same thing as violating an IGO's immunity. Part C then discusses alternative ways to resolve the situation.

A. Scope of IGO Immunity

1. Varied Bases for immunity

Immunity under international law is surprisingly contextual. To begin with, foreign states, IGOs, and officials enjoy varying types of immunity. (Even IGO immunity takes different forms; this memo will refer to IGO immunity as a shorthand for the basic immunity from judicial process, though the immunity of an IGO from enforcement or execution, or the immunity of IGO officials, may also be implicated.<sup>90</sup>) The differences are meaningful. IGO immunity is often likened to the foreign “sovereign” immunity of states, but they are distinct in their purposes and potential scope. IGOs are considered more vulnerable than states, since they have no territory or population, and must conduct their affairs in jurisdictions and through persons not their own. On the other hand, IGOs tend to be purpose-built, unlike states, and may more easily be restricted to fulfilling specific functions; these vary by organization, of course, and so may their immunity.<sup>91</sup>

Beyond that, the legal vehicle for immunity creates further variety. For IGOs, two multilateral treaties are of particular note. The most universally ratified—with 161 parties as of this date—is the Convention on the Privileges and Immunities of the United Nations (the “General Convention”), which governs the immunity of the United Nations and its integral parts.<sup>92</sup> More IGOs are addressed by the Convention on the Privileges and Immunities of the

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<sup>90</sup> As noted earlier, it is possible that *in rem*, property-oriented immunity might be involved. See *supra* note 84. IGO officials might in principle be subject to attempts to litigate rights in protectable marks—for example, through attempts to enjoin their exercise of mark-related functions.

<sup>91</sup> See, e.g., Hazel Fox & Philippa Webb, *The Law of State Immunity* 571 (3rd ed. 2015).

<sup>92</sup> Feb. 13, 1946, 21 U.S.T. 1418, T.I.A.S. 6900. The United States, among others, considers subsidiary organs of the United Nations—such as certain peacekeeping missions, and the United Nations Development Program—to enjoy the same scope of immunity as that conferred by the General Convention on the UN itself. See, e.g., *Lempert v. Rice*, 956 F. Supp. 2d 17, 23-24 (D.D.C. 2013) (applying absolute immunity under the General Convention to the United Nations Development Program as a subsidiary organ); *Sadikoglu v. United Nations Development Programme*, 2011 WL 4953994, \*3-\*4 (S.D.N.Y. 2011) (same). In some instances, the immunity afforded by the General Convention may be supplemented by agreements that incorporate General Convention standards. See *Georges v. United Nations*, 84 F. Supp. 3d 246, 248-49249 (S.D.N.Y. 2015) (concluding that both the United Nations and the United Nations Stabilization Mission in Haiti (MINUSTAH) were entitled to absolute immunity, the latter “as a subsidiary body of the UN,” though it was also subject to a Status of Forces Agreement extending

Specialized Agencies (“Special Convention”), which governs the immunity of autonomous organizations that carry out various functions on behalf of the United Nations.<sup>93</sup> The Special Convention has been ratified by 127 parties—some states that loom large in IGO dealings (like Belgium and Switzerland, as of 2012) are parties, while others (notably, the United States) are not.<sup>94</sup> Like the General Convention, the Special Convention confers broad immunity on IGOs subject to it, but its scope is contingent: states parties have varied obligations,<sup>95</sup> and they may modify those obligations further with IGOs they host.<sup>96</sup>

The Special Convention is not unique in accommodating bilateral arrangements. A number of IGOs subject to Article 6*ter* of the Paris Convention have their immunities governed at least in part by other treaties, like headquarters agreements, that defy easy generalization. The variety this introduces is all the more consequential in light of the fact that some states, like Italy, have intimated that IGO immunity can only be resolved on the basis of treaties.<sup>97</sup>

The differences due to international treaties are accentuated by national law, which is important in determining the immunity of international organizations. Of course, national law is usually aligned with international law. In the United Kingdom, for example, international obligations must be implemented in domestic law by statute—in the case of IGO immunity, by the International Organizations Act 1968 (as amended), which is applied to particular

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the privileges and immunities of the General Convention), appeal pending, No. 15-455; accord Brief for the United States as Amicus Curiae in Support of Affirmance at 8, *Georges v. United Nations*, No. 15-455 (2<sup>nd</sup> Cir. 2016) (describing both United Nations and MINUSTAH as subject to the General Convention).  
<sup>93</sup> Nov. 21, 1947, 33 U.N.T.S. 261. The originally designated agencies are the International Labour Organization (ILO), Food and Agriculture Organization (FAO), the United Nations Educational, Scientific and Cultural Organization (UNESCO), the International Civil Aviation Organization (ICAO), the International Monetary Fund (IMF), the International Bank for Reconstruction and Development (IBRD), the World Health Organization (WHO), the Universal Postal Union (UPU), and the International Telecommunication Union (ITU). Among those subsequently created and governed are the World Meteorological Organization (WMO), the International Maritime Organization (IMO), the International Finance Corporation (IFC), the International Development Association (IDA), the World Intellectual Property Organization (WIPO), the International Fund for Agricultural Development (IFAD), and the United Nations Industrial Development Organization (UNIDO).

<sup>94</sup> As made clearer below, these and other non-parties observe immunity for the agencies on other bases.

<sup>95</sup> States may file reservations when acceding, and in some cases these bear on privileges and immunities; the Special Convention also addresses particular agencies in annexes that are occasionally amended (Special Convention §§ 2, 36, 38), and states vary as to whether they accept the annexes as revised or only as originally tendered. For example, Norway and the United Kingdom have accepted revisions to the WHO’s annex, but Algeria and Brazil have not. See Gian Luca Burci & Egle Granziera, *Privileges and Immunities of the World Health Organization: Practice and Challenges*, in *Immunity of International Organizations* 93 (Niels Blokker & Nico Schrijver eds., 2015).

<sup>96</sup> See Special Convention, § 39. See, e.g., *Diallo v. Strauss-Kahn*, 2012 WL 1533179 (N.Y. Sup. 2012) (noting adaptation to IMF via its Articles of Agreement).

<sup>97</sup> See Beatrice Bonafè, *Italian Courts and the Immunity of International Organizations*, 10 *Int’l Org. L. Rev.* 505, 512 (2013); see also Eric De Brabandere, *Belgian Courts and the Immunity of International Organizations*, 10 *Int’l Org. L. Rev.* 464, 471-74 (2013) (noting similar tendency, subject to some ambiguity, in Belgium).

organizations by orders in Council.<sup>98</sup> The United States, in contrast, accords self-executing effect to some treaties (like the General Convention),<sup>99</sup> and implements other immunities—whether derived from non-self-executing treaties, treaties to which it is not a party (like the Special Convention), or customary international law—by means of the International Organizations Immunity Act (IOIA).<sup>100</sup> The IOIA provides privileges and immunities to international organizations that have been designated by the President through an executive order, which may also modify the privileges and immunities as the President considers appropriate.<sup>101</sup> Among the IGOs thus designated are some, like WIPO, which are subject in other jurisdictions to the Special Convention. Other national laws, like Austria's, are possibly even more complicated.<sup>102</sup>

The diversity among treaties and national laws is in principle constrained by customary international law, which consists of the practice of states acting out of a sense of legal obligation. Cases and commentary occasionally advert to customary international law of IGO immunity, particularly in situations not addressed by a treaty. But how readily and enthusiastically customary international law is applied depends to a great degree on the state concerned. In some jurisdictions, like the United States, it is treated as a last resort: that is, an IGO to which the United States owes no treaty obligations, and which has not been designated

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<sup>98</sup> A few organizations are addressed by separate legislation, as are those whose privileges and immunities arise under EU law. See generally Chanaka Wickremasinghe, *The Immunity of International Organizations in the United Kingdom*, 10 *Int'l Org. L. Rev.* 434, 437 & n.6 (2014); Dan Sarooshi & Antonios Tzanakopolous, *United Kingdom, in The Privileges and Immunities of International Organizations in Domestic Courts* 290 (August Reinisch ed., 2013). Litigating IGO immunities in U.K. courts poses certain idiosyncratic justiciability and legal personality issues that will not be explored here.

<sup>99</sup> See, e.g., *Brzak v. United Nations*, 597 F.3d 107, 111-12 (2d Cir. 2010). The UN was also designated by the President as receiving immunities under the International Organizations Immunity Act of 1945 (IOIA), discussed below. See Exec. Ord. No. 9698, 11 Fed. Reg. 1809 (Feb. 19, 1946). This is potentially confusing because (as also discussed below) the scope of immunity under the IOIA may be less than that afforded under the General Convention. Some courts have sidestepped that question by noting that the General Convention might simply add to statutory protection (see, e.g., *Brzak*, 597 F.3d at 112), while others simply assume the same standard. *Van Aggelen v. United Nations*, 311 Fed. Appx. 407, 409 (2<sup>nd</sup> Cir. 2009) (“The United Nations enjoys absolute immunity under the U.N. Charter, the Convention on the Privileges and Immunities of the United Nations . . . and the [IOIA].”). The better view seems to be that the General Convention, together with the Headquarters Agreement, were concluded subsequent to the IOIA and might be required to address the greater needs of the United Nations. See United States Statement of Interest, *Begum v. Saleh*, 99 Civ. 11834 (S.D.N.Y. 2000), reprinted in 2000 *Digest of United States Practice in International Law* 602, 608 n.7.

<sup>100</sup> International Organizations Immunities Act of 1945, 22 U.S.C. § 288a(b).

<sup>101</sup> The IOIA formally distinguishes between IGOs in which the United States participates (either by virtue of a treaty, or under the authority of Congress authorizing participation or making appropriations for such), see 22 U.S.C. § 288, and IGOs and similar entities that according to statute are to be treated similarly for purposes of their privileges and immunities, see *id.* § 288 f-1 et seq. At present, approximately 80 IGOs have been designated. See 28 U.S.C.A. § 288 note (detailing organizations and executive orders).

<sup>102</sup> Kirsten Schmalenbach, *Austrian Courts and the Immunity of International Organizations*, 10 *Int'l Org. L. Rev.* 446, 448-54 (2013).

under the IOIA, might in theory have its immunities considered on the basis of customary international law, but that would pose difficult questions of enforceability.

Ultimately, it is unclear when customary international law doctrines of immunity will be asserted and prevail. Sometimes courts or commentators assert a customary norm without much (or any) evidence, and at least some of the underlying practice cited in support is better attributed to treaties or domestic law. Significantly, a recent expert survey concluded that “it cannot be said that ‘there is ‘a general practice accepted as law’ establishing a customary rule of immunity” and that “it would be difficult to conclude that any such rule exists.”<sup>103</sup> Even those cases recognizing a customary international law basis for immunity appear to differ on its extent.<sup>104</sup> Regardless, as a practical matter, a dispute about IGO immunity may arise in a court inclined to resolve it based on customary international law as that court perceives it.

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<sup>103</sup> Michael Wood, Do International Organizations Enjoy Immunity Under Customary International Law?, 10 Int'l Org. L. Rev. 287, 317 (2014).

<sup>104</sup> Compare, e.g., *ZM v. Permanent Delegation of the League of Arab States to the UN*, 116 ILR 643, 647 ¶¶ 22-23 (Labour Court (TPH) of Geneva, Nov. 17, 1993) (holding that “[c]ustomary international law recognizes that international organisations, whether universal or regional, enjoy absolute immunity,” but noting that “[t]his privilege . . . arises from the purposes and functions assigned to them”), with *Spaans v. Iran-US Claims Tribunal*, 94 ILR 321, 327 ¶ 3(3)(4) (Hoge Raad der Nederlanden (Supreme Court), Dec. 20, 1985) (reporting “that, according to unwritten international law, as it stands at present, an international organization is in principle not subject to the jurisdiction of the courts of the host State in respect of all disputes which are immediately connected with the performance of the tasks entrusted to the organization in question”).



## 2. Varied approaches to immunity

### a. Absolute immunity

Some organizations, in some jurisdictions, are afforded comprehensive immunity from judicial process, irrespective of the nature of the IGO's activity, in the absence of an express (and strictly construed) waiver. The United Nations is the most certain example. Article 105(1) of the Charter provides that "[t]he Organization shall enjoy in the territory of each of its Members such privileges and immunities as are necessary for the fulfillment of its purposes." Article 2 of the General Convention states more unequivocally that "[t]he United Nations, its property and assets wherever located and by whomsoever held, shall enjoy immunity from every form of legal process except insofar as in any particular case it has expressly waived its immunity." That is generally understood to require absolute immunity, subject to waiver, even in those jurisdictions that regulate (or ordinarily regulate) immunity by separate enactment.<sup>105</sup>

Other treaties may also establish absolute immunity, for those states bound by them. The Special Convention uses similar language, providing (in Article 3(4)) that "[t]he specialized agencies, their property and assets, wherever located and by whomsoever held, shall enjoy immunity from every form of legal process except in so far as in any particular case they have expressly waived their immunity." As noted previously, the Special Convention is less definitive in character—there are fewer states parties, and greater potential for variation in the treatment of particular IGOs—but the treaty language creates a presumption in favor of similarly broad immunity.<sup>106</sup> Bilateral agreements (such as headquarters agreements) may also establish immunity that appears comprehensive in scope.<sup>107</sup>

National law may also afford extremely broad immunity, but requires careful scrutiny. In the United States, for example, some (but not all) decisions treat the immunity conferred by

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<sup>105</sup> For U.S. decisions treating United Nations immunity as absolute, see, e.g., *Brzak v. United Nations*, 597 F.3d 107, 112 (2d Cir. 2010); *Van Aggelen v. United Nations*, 311 Fed. Appx. 407 (2<sup>nd</sup> Cir. 2009); *Boimah v. United Nations General Assembly*, 664 F. Supp. 69, 71 (E.D.N.Y.1987). These and other decisions typically treat the General Convention as self-executing and as affording immunity independent of any derived from statute. See *infra* notes 99-100. In the United Kingdom, the United Nations is simply subject to an Order in Council that respects the extent of immunity under the General Convention. See *The United Nations and International Court of Justice (Immunities and Privileges) Order 1974/1261*.

<sup>106</sup> See, for example, its broad treatment in United Kingdom: *The Specialised Agencies of the United Nations (Immunities and Privileges) Order 1974/1260*; *Entico Corp. v. UNESCO*, [2008] CLC 524, [2008] EWHC 531, 156 ILR 382.

<sup>107</sup> For example, the Restatement (Third) of Foreign Relations Law, which was otherwise open to affording immunity to IGOs on a restrictive basis only, appeared to consider that the Organization of American States (OAS)—the immunity of which is addressed, inter alia, in its Charter (see Article 139 of the Charter of Organization of American States, 2 UST 2394, TIAS 2361, as amended, 21 UST 607, TIAS 6849), in a 1975 bilateral agreement (see Article 2 of the Agreement Relating to Privileges and Immunities, 26 U.S.T. 1025, T.I.A.S. No. 8089), and subsequently in a 1992 bilateral agreement (see Article IV(1) of the Headquarters Agreement Between The Organization of American States and the Government of the United States of America, Treaty Doc. No. 102-40, entered into force Nov. 17, 1994)—might be due absolute immunity, given the comparability of its treaty terms to those used in the General Convention and the Special Convention. See Restatement (Third) of Foreign Relations Law § 467 cmt. f & rptrs. note 4.

IOIA designation as absolute in character,<sup>108</sup> and it remains contingent in some respects.<sup>109</sup> Other jurisdictions profess to apply an absolute standard, but justify it by noting that IGOs (unlike foreign states) act only in a manner confined to their purposes—which, while *not* spelling out when, how, and by what means such purposes are to be assessed, at least suggests the possibility of outer bounds to immunity.<sup>110</sup> Conversely, some jurisdictions that profess to apply a less robust scope of immunity apply it so reflexively and broadly that may, in practice, seem absolute.<sup>111</sup>

The customary international law of IGO immunity—which some courts tend to deny altogether<sup>112</sup>—is sometimes, where recognized, described as absolute. In practice, this too may be less clear as applied. Swiss decisions, for example, have suggested that all IGOs enjoyed absolute immunity, but have also premised that on their performance of functions appropriate to their mission—and proposed this absolutism in a context where treaty commitments, not benefiting all IGOs, play an inescapable role.<sup>113</sup>

In sum, the United Nations and its constituent elements are likely to be regarded as entitled to absolute immunity, as are the specialized agencies—at least to the extent the state concerned is a party to the Special Convention and has not modified its application. As to other

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<sup>108</sup> See, e.g., *Atkinson v. Inter-Am. Dev. Bank*, 156 F.3d 1335, 1341 (D.C. Cir. 1998); *Price v. Unisea, Inc.*, 289 P.3d 914, 919-20 (Alaska 2012); *Bro Tech Corp. v. European Bank for Reconstruction and Development*, No. 00-CV-02160-CG, 2000 WL 1751094, at \*3 (E.D. Pa. Nov. 29, 2000). As noted below, this position has in recent years become more controversial. See *infra* notes 122-125 (discussing *OSS Nokalva*).

<sup>109</sup> Notwithstanding the immunity conferred upon designated IGOs under the IOIA, it may be waived by the organization itself, it may be limited by the President when that organization is first designated as one entitled to enjoy IOIA immunity, and the President may modify, condition, or revoke the immunity by executive order. *Mendaro v. World Bank*, 717 F.2d 610, 613-14 (D.C. Cir. 1983).

<sup>110</sup> See Schmalenbach, *supra* note 102, at 457-58 (discussing *Company Baumeister L. v. OPEC Fund*, ILDC 362 (AT 2004)); Gregor Novak & August Reinisch, Austria, in *Privileges and Immunities*, *supra* note 98, at 47-49 (same).

<sup>111</sup> See, e.g., August Reinisch, *Transnational Judicial Conversations on the Personality, Privileges, and Immunities of International Organizations—An Introduction*, in *Privileges and Immunities*, *supra* note 98, at 8 (concluding that “[i]t appears that, in practice, the concept of functional immunity frequently leads to *de facto* absolute immunity”); De Brabandere, *supra* note 97, at 474 (“International organization immunity has, unlike State immunity, remained absolute. When one defines the immunity of international organizations as *functional*, in practice this essentially boils down to absolute immunity”).

<sup>112</sup> See Wood, *supra* note 103, especially at 299 & nn. 39-42.

<sup>113</sup> Thus, in *Groupeement D’Entreprises Fougerolle v. CERN*, 102 ILR 209 (CH Dec. 21, 1992), the Swiss Federal Supreme Court stated categorically that “[i]nternational organizations enjoy absolute and complete immunity without any restriction,” but at the same time said that this immunity is “is always based on an instrument of public international law in the form of either multilateral conventions between the Member States of such organizations, bilateral agreements, or most frequently headquarters agreements with the host State.” In *ZM v. Permanent Delegation of the League of Arab States to the United Nations*, 116 ILR 643, 647 (CH 1993), a Swiss labor court stated more directly that “[c]ustomary international law recognizes that international organizations, whether universal or regional, enjoy absolute jurisdictional immunity.” It also stated, however, that “[t]his privilege of international organisations arises from the purposes and functions assigned to them,” since “[t]hey can only carry out their tasks if they are beyond the censure of the courts of member states or their headquarters.” See generally Thore Neumann & Anne Peters, Switzerland, in *Privileges and Immunities*, *supra* note 98, at 242-51.

IGOs, it would be difficult to state with confidence whether they are entitled to absolute immunity without particular information about the treaty obligations or national law of the jurisdiction in question. As discussed further below, however, in these circumstances little may ride on the distinction between absolute and functional immunity, and ultimately little may depend on the potential scope of immunity at all.

b. Restrictive immunity

With rare exception,<sup>114</sup> sovereign (state) immunity has evolved from an absolute standard to what is known as “restrictive” immunity. Under the restrictive approach, states retain immunity for acts *jure imperii*, which are fundamentally sovereign in character, but lack immunity for acts *jure gestionis*—in essence, carving an exception from immunity for litigation concerning commercial activities like those undertaken by private parties.

Relatively few states have shown interest in applying this restrictive approach to IGOs. As noted previously, IGO immunity has different premises than sovereign immunity, so there is no inherent reason why both would have exceptions of similar scope. One recent suggestion of a commercial activities exception—by a Belgian court of appeals, in a case concerning an employment dispute brought against the Arab League—was ignored by the Belgian Cour de Cassation, which resolved the case on other grounds.<sup>115</sup> Italian courts, in cases involving the Food and Agriculture Organization and the Bari Institute of the International Center for Advanced Mediterranean Agronomic Studies (ICAMAS), denied immunity for acts they regard as being of a private character, but such decisions may have been driven by a now-moot dispute over Italy’s accession to the Special Convention<sup>116</sup>—with Italy’s more recent cases being better characterized as entailing a narrower approach to functional immunity.<sup>117</sup>

The United States is an important exception. There, some courts have followed a restrictive approach not because of a conviction about international law, but rather due to the text of the IOIA, which provides the statutory basis for IGO immunity in U.S. courts. The IOIA provides, in relevant part, that IGOs “shall enjoy the same immunity from suit and every form of judicial process as is enjoyed by foreign governments.”<sup>118</sup> Because this emulated sovereign immunity, U.S. courts have wrestled with whether IGOs continue to enjoy the immunity afforded foreign states as of the time the IOIA was enacted in 1945 (when foreign sovereign immunity was generally understood to be absolute) or whether their immunity follows

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<sup>114</sup> See International Decision: *FG Hemisphere Associates v. Democratic Republic of the Congo*, 108 Am. J. Int’l L. 776 (2014) (reporting decision of Hong Kong Court of Final Appeal applying absolute immunity approach).

<sup>115</sup> *League of Arab States v TM*, Appeal Judgment, Cass No S.99.0103.F, ILDC 42 (BE 2001), 12th March 2001, Court of Cassation, discussed in Cedric Ryngaert, *The Immunity of International Organizations Before Domestic Courts: Recent Trends*, 7 Int’l Org. L. Rev. 121, 124, 126 (2010).

<sup>116</sup> For discussion, see Riccardo Pavoni, *Italy*, in *Privileges and Immunities*, *supra* note 98, at 157-62; August Reinisch, *Accountability of International Organizations According to National Law*, 36 Neth. Y.B. Int’l L. 119, 131-33 (2005); Peter Neumann, *Immunity of International Organizations and Alternative Remedies Against the United Nations 5-7* (2006), [http://ilmc.univie.ac.at/uploads/media/Neumann\\_-\\_Immunity\\_of\\_IOs\\_and\\_alternative\\_remedies\\_against\\_the\\_United\\_Nations.pdf](http://ilmc.univie.ac.at/uploads/media/Neumann_-_Immunity_of_IOs_and_alternative_remedies_against_the_United_Nations.pdf).

<sup>117</sup> See Bonafè, *supra* note 97, at 508, 522-23, 537.

<sup>118</sup> 22 U.S.C. § 288a(b).

subsequent changes in foreign sovereign immunity (including the commercial activities exception, which was codified in the Foreign Sovereign Immunities Act in 1976).<sup>119</sup>

This puzzle remains unsolved. The Restatement (Third) of Foreign Relations Law, an influential compilation of U.S. law and practice, expressed two positions: first, that IGOs “generally” enjoyed functional immunity as a matter of international law (a standard addressed in the next section); and second, that as a matter of U.S. law, IGOs enjoyed the privileges and immunities provided “by international agreements to which the United States is party,” and IGOs “designated by the President under the [IOIA] are entitled to the privileges and immunities provided in that Act.”<sup>120</sup> This said little about the actual scope of immunity under the Act. In accompanying comments, however, the Restatement (Third) took the position that “[w]hether other international organizations enjoy absolute or restricted immunity under international law is unclear,” but that “at least until that question is authoritatively resolved they will probably be accorded only restricted immunity under the law of the United States.”<sup>121</sup>

That prediction as to the course of U.S. case law has not been clearly vindicated, but neither has it been repudiated. In 2010, one U.S. court of appeals—the Third Circuit, which exercises authority over federal cases arising from Pennsylvania, New Jersey, Delaware, and the Virgin Islands—construed the IOIA as incorporating the restrictive theory, basing its conclusion in part on an opinion expressed by the Legal Adviser to the U.S. Department of State.<sup>122</sup> The court intentionally diverged from the D.C. Circuit, which over a decade earlier reached the conclusion that the IOIA conferred 1945-era, absolute immunity for IGOs that has not tracked changes in sovereign immunity.<sup>123</sup> For the foreseeable future, then,<sup>124</sup> U.S. cases arising in the Third Circuit are likely to be resolved according to the restrictive theory, while cases arising in the D.C. Circuit will be resolved based on the absolute immunity, and other jurisdictions will

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<sup>119</sup> Under the FSIA, “commercial activity” means “means either a regular course of commercial conduct or a particular commercial transaction or act,” with the commercial character “determined by reference to the nature of the course of conduct or particular transaction or act, rather than by reference to its purpose.” 28 U.S.C. § 1603(d). The exception to immunity, then, encompasses cases “in which the action is based upon a commercial activity carried on in the United States by the foreign state; or upon an act performed in the United States in connection with a commercial activity of the foreign state elsewhere; or upon an act outside the territory of the United States in connection with a commercial activity of the foreign state elsewhere and that act causes a direct effect in the United States.” 28 U.S.C. § 1605(a)(2).

<sup>120</sup> Restatement (Third) of the Foreign Relations Law of the United States § 467(2).

<sup>121</sup> Restatement (Third) of the Foreign Relations Law of the United States § 467 cmt. d. As noted earlier, the Restatement allowed that this restrictive theory “appears” not to apply “to the United Nations, to most of its Specialized Agencies, or to the Organization of American States.”

<sup>122</sup> *OSS Nokalva, Inc. v. European Space Agency*, 617 F.3d 756, 763-64 (3<sup>rd</sup> Cir. 2010); see Letter from Roberts B. Owen, Legal Adviser, State Department, to Leroy D. Clark, General Counsel, Equal Employment Opportunity Commission (June 24, 1980) (emphasis added), reprinted in Marian L. Nash, *Contemporary Practice of the United States Relating to International Law*, 74 *Am. J. Int’l L.* 917, 917–18 (1980); 1980 *Digest U.S. Prac. Int’l L.* 16.

<sup>123</sup> *Atkinson v. Inter-Am. Dev. Bank*, 156 F.3d 1335 (D.C. Cir. 1998).

<sup>124</sup> The U.S. Supreme Court is entrusted with resolving circuit conflicts, but has shown little interest in this particular dispute, which at present remains the subject of disagreement between the D.C. Circuit and Third Circuit only. See, e.g., *Nyambal v. International Monetary Fund*, 135 S. Ct. 2857 (Mem.) (2015) (denying certiorari).

eventually side with one position or the other.<sup>125</sup> The D.C. Circuit may enjoy a degree of deference given its relative expertise concerning IGOs, but its approach has been criticized and appears inconsistent with the view espoused by the U.S. government.<sup>126</sup>

If the restrictive approach were taken, it might diminish the immunity owed an IGO. The defense of marks appears commercial in character, since it is just the sort of activity engaged in by private persons in their own commercial pursuits. Thus, for example, the International Law Commission's Draft Articles on Jurisdictional Immunities of States and Their Property—which addressed sovereign rather than IGO immunity—exempted the determination of a state's rights in intellectual and industrial property, including trademarks.<sup>127</sup> To be sure, this translates imperfectly to IGOs, and before the D.C. Circuit settled on an absolute standard, its decisions considering a commercial activities exception for IGOs adapted it to their perceived needs.<sup>128</sup> It is possible, therefore, that an IGO's registration of trademarks in the United States solely for defensive purposes might not be deemed commercial activity;<sup>129</sup> if an IGO could defend a transfer order in an action initiated by a registrant simply by invoking the IGO's interests in its name, without U.S. registration, the argument for deeming that non-commercial would seem still stronger. On the whole, however, a domain-name registrant seeking to reverse a UDRP cancellation or transfer may find the United States to be the friendliest jurisdiction in which to present that argument: if it could invoke a restrictive approach, it would be the best basis for arguing that that name-related activities are outside IGO immunity.

c. Functional immunity

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<sup>125</sup> There has been little indication elsewhere, though a couple of decisions have followed the D.C. Circuit approach. See *Price v. Unisea, Inc.*, 289 P.3d 914, 919-20 (Alaska 2012); *Bro Tech Corp. v. European Bank for Reconstruction and Development*, No. 00-CV-02160-CG, 2000 WL 1751094, at \*3 (E.D. Pa. Nov. 29, 2000) (preceding *OSS Nokalva*). The Ninth Circuit Court of Appeals, which hears cases arising in California and the State of Washington, among others, has not established a position.

<sup>126</sup> See, e.g., Steven Herz, *International Organizations in U.S. Courts: Reconsidering the Anachronism of Absolute Immunity*, 31 *Suffolk Transnat'l L. Rev.* 471, 532 (2008) ("The broad immunity afforded by *Atkinson* far exceeds the legitimate functional needs of international organizations.").

<sup>127</sup> Rep. of the Int'l Law Comm'n: Draft Articles on Jurisdictional Immunities of States and Their Property, art. 14, 43d Sess., April 29-July 19, 1991, U.N. Doc. A/46/10; GAOR, 46th Sess., Supp. No. 10, pt. 2 (1991), [http://legal.un.org/ilc/texts/instruments/english/commentaries/4\\_1\\_1991.pdf](http://legal.un.org/ilc/texts/instruments/english/commentaries/4_1_1991.pdf).

<sup>128</sup> See, e.g., *Broadbent v. Org. of Am. States*, 628 F.2d 27, 33-34 (D.C. Cir. 1980) (distinguishing IGO immunity under an IOIA commercial activities exception from treatment under the FSIA—which would consider employment by a foreign state in the United States of diplomatic, civil service, or military personnel to be governmental, but the employment of American citizens or third country nationals to be commercial—on the ground that "[a] comparable exception is not applicable to international organizations, because their civil servants are inevitably drawn from either American citizens or 'third' country nations," meaning that for IGOs "such an exception would swallow up the rule of immunity for civil service employment disputes"). For similar outcomes in other employment cases, see *Tuck v. Pan Am. Health Org.*, 668 F.2d 547, 550 (D.C. Cir. 1981); *Mendaro v. World Bank*, 717 F.2d 610, 620 (D.C. Cir. 1983). Even in *Atkinson*, the court of appeals held *arguendo* that if there had been a commercial activities exception, wage garnishment proceedings would not fall within it. 156 F.3d at 1342-43.

<sup>129</sup> See *In re Aluminum Warehousing Antitrust Litigation*, 20014 WL 5801607 (S.D.N.Y. 2014) (FSIA).

The idea that IGOs are limited by their functions, often recognized as a general principle of international law,<sup>130</sup> is frequently urged as a basis for assessing IGO immunity claims as well<sup>131</sup>—not least, because the governing treaties often contain language suggesting that IGO immunity should be limited by its purposes.<sup>132</sup> This may carry over into the national law mediating international obligations. Thus, in Canada and the United Kingdom, a functional test may be incorporated by an Order in Council that implements those states' international obligations (according to, respectively, the Foreign Missions and International Organizations Act and the International Organisations Act). In principle, the scope of immunity afforded by such orders is not supposed to exceed that required by an international agreement.<sup>133</sup>

Cases applying a functional test, whether derived from an agreement or elsewhere, typically look to whether immunity concerns activities immediately or directly related to the performance of tasks entrusted to the organization.<sup>134</sup> As noted below, however, applications of

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<sup>130</sup> See, e.g., Advisory Opinion on the Legality of the Use of Nuclear Weapons, 1996 I.C.J. Reports 78, para. 25 (“International organizations . . . are invested by the States which create them with powers, the limits of which are a function of the common interests whose promotion those States entrust to them.”).

<sup>131</sup> See generally Peter H.F. Bekker, *The Legal Position of Intergovernmental Organizations: A Functional Necessity Analysis of Their Legal Status and Immunities* (1994); Michael Singer, *Jurisdictional Immunity of International Organizations: Human Rights and Functional Necessity Concerns*, 36 Va. J. Int'l L. 65 (1996).

<sup>132</sup> See, for example, Article 40(a) of the Statute of the Council of Europe (“The Council of Europe, representatives of members and the Secretariat shall enjoy in the territories of its members such privileges and immunities as are reasonably necessary for the fulfilment of their functions.”). Analysis is complicated by the potential relevance, depending on jurisdiction, of more than one treaty. As has previously been noted, while Article 105 of the UN Charter states that “[t]he Organization shall enjoy in the territory of each of its Members such privileges and immunities as are necessary for the fulfilment of its purposes”), the General Convention states a less qualified immunity for states parties. Likewise, the agreements for particular specialized agencies may suggest a more qualified approach, focusing on the IGO's functions, than would be gleaned from a reading of the Special Convention. See, e.g., Article 67(a) of the Constitution of the World Health Organization (“The Organization shall enjoy in the territory of each Member such privileges and immunities as may be necessary for the fulfilment of its objective and for the exercise of its functions.”); Article 40(1) of the ILO Constitution (“The International Labour Organization shall enjoy in the territory of each of its Members such privileges and immunities as are necessary for the fulfilment of its purposes.”), as clarified by its Article 39 (defining ILO capacities); Article XII of the UNESCO Convention (incorporating the provisions of Article 105 of the UN Convention concerning privileges and immunities). Other IGOs may state the terms of their immunities in a basic instrument that is then augmented by a more focused agreement, either of which may be further varied by reservations. Compare Article XV of the IAEA Statute (“The Agency shall enjoy in the territory of each member such legal capacity and such privileges and immunities as are necessary for the exercise of its functions.”), with § 3 of the Agreement on Privileges and Immunities of the International Atomic Energy Agency (providing that “The Agency [and all its property and assets] shall enjoy immunity from every form of legal process except in so far as in any particular case it has expressly waived its immunity”).

<sup>133</sup> See Wickremasinghe, *supra* note 98, at 438. In Canada, nonetheless, these orders reportedly do not necessarily restrict immunities to functional necessity, see Phillip M. Saunders, Canada, in *Privileges and Immunities*, *supra* note 98, at 84-86, but at least sometimes they do. See, e.g., *Amaratunga v. Northwest Atlantic Fisheries*, 451 N.R. 1, 2013 N.R. T.BEd. No. 020, ¶¶ 47-53 (Sup. Ct. Canada Nov. 29, 2013) (construing Northwest Atlantic Fisheries Organization order).

<sup>134</sup> See *Spaans v. Iran-US Claims Tribunal*, 94 ILR 321, 327 ¶¶ 3(3)(4) (Neth. Sup. Ct. Dec. 20, 1985); accord *Stichting Greenpeace Nederland v. Euratom*, 136 ILR 429, 434-35 ¶¶ 6.2-6.4 (Neth. Sup. Ct. Nov. 13,

this principle vary considerably in their stringency. Important variables include, for example, whether (and how) the functional inquiry is stated in a relevant agreement, as well as where the burden of proof is placed. In one Canadian case, for example, both the lower courts and the Supreme Court agreed that the relevant agreements and their national implementation established a functional standard, but while the lower court placed the burden on the IGO to demonstrate that immunity was strictly necessary for its functioning, the Supreme Court's inquiry (which ultimately upheld the most substantial immunity defense) simply asked whether the suit concerned would amount to undue interference with the IGO's functions.<sup>135</sup>

Despite its appeal elsewhere, including under international law,<sup>136</sup> functional immunity has not been directly applied at the test in the United States. To be sure, U.S. courts will afford immunity at least sufficient to fulfill an IGO's purposes, and presumably they will be skeptical of protecting activities that bear a completely attenuated relationship with the IGO's mission—not unlike the commercial activities that are distinguished under the restrictive approach.<sup>137</sup> At the same time, because the IOIA does not describe immunities in functional terms, and because presidential designation orders do not typically alter the default scope of immunity afforded by the IOIA, U.S. courts do not generally devote much attention to assessing whether immunity is necessary to fulfill the organization's purposes. As a consequence, there is little U.S. law directly endorsing and applying a functional approach as a general method for reckoning IGO immunity.

If a functional approach were employed, how would it apply in these circumstances? Those jurisdictions employing a functional test have demonstrated its flexibility and unpredictability. The Dutch Supreme Court has rejected as inappropriate the criterion of whether the IGO could have fulfilled its task without committing an offense for which immunity is being invoked; the question, instead, is whether “the actions in question are directly related to the fulfillment of [the IGO's] tasks.”<sup>138</sup> Some courts seem to have been satisfied with assessing whether immunity is, in general and as a whole, necessary for the organization to achieve its objectives—which approaches the elaboration sometimes provided by states that prefer a nominally absolute standard<sup>139</sup>—while others have more readily classified matters that are private and less diplomatic in character as falling outside functional immunity.<sup>140</sup>

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2007); Eckhardt v. European Org. for the Safety of Air Navigation (No. 2), 94 ILR 331, 333 (Maastricht D. Ct. Jan. 12, 1984).

<sup>135</sup> See Amaratunga, *supra* note 133, ¶ 53; see also Saunders, *supra* note 133, at 94-98 (discussing lower court proceedings).

<sup>136</sup> The Restatement (Third), while predicting that U.S. courts might be inclined toward a restrictive approach, reported that “[u]nder international law, an international organization generally enjoys such privileges and immunities from the jurisdiction of a member state as are necessary for the fulfillment of the purposes of the organization, including immunity from legal process.” Restatement (Third) of the Foreign Relations Law of the United States § 467(1).

<sup>137</sup> See, e.g., *Int'l Bank for Reconstruction & Dev. v. District of Columbia*, 996 F. Supp. 31, 36 & n.3 (D.D.C. 1998) (invoking functional necessity approach of the Restatement (Third)), *rev'd*, *Int'l Bank for Reconstruction & Dev. v. District of Columbia*, 171 F.3d 687 (D.C. Cir. 1999) (reversing on the ground that tax immunity appropriate to the IBRD did not extend to activities of its independent contractor, even if the IBRD would itself have been immune were it to have conducted them).

<sup>138</sup> *Euratom*, *supra* note 134, ¶¶ 6.3-6.4; see Ryngaert, *supra* note 115, at 130-32.

<sup>139</sup> See Neumann & Peters, *supra* note 113, at 248-50. In *NML Capital Ltd. v. Bank for International Settlements and Debt Enforcement Office Basel Stadt*, ILDC 1547 (Swiss Federal Supreme Court July 12,

In an arbitration involving the European Molecular Biology Laboratory, an IGO headquartered in Germany, the arbitrators had to determine whether the operation of a cafeteria and guest-house were “official activities” for purposes of resolving whether they were immune from national taxation according to the relevant headquarters agreement, and construed that agreement “in the light of its primary purpose of enabling the EMBL . . . fully and efficiently to discharge its responsibilities and fulfill its purposes.” It found that the conduct of scientific seminars, and providing meals and accommodations to participants, were official activities. On the other hand, supplying meals and accommodation for payment was not, because those functions could not be inferred from the agreement establishing the EMBL, nor was supplying meals or accommodations for EMBL staff.<sup>141</sup>

As *EMBL* suggests, there may be considerable overlap between the kinds of activities excluded from immunity under a restrictive approach (because they are commercial in nature) and those excluded under a functional approach (because activities that are commercial are not part of the IGO’s mission), but the distinction may be critical here. An IGO would argue that the noninfringed use of its name (including, if it so chooses, in maintaining a domain and making available the information on it) is related to fulfillment of its mission, not unlike the physical seminars at issue in *EMBL*. Registrants would try to distinguish that case, insofar as the agreement establishing the EMBL specifically referenced hosting visiting scientists, training, teaching, and the like,<sup>142</sup> and much would turn on the nature of the IGO as articulated by its founding instruments and any treaties relating to immunity. But 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.

B. Waiver of immunity

Assuming that an IGO is entitled to immunity, that immunity may be waived. This may be done through the IGO’s governing instruments or through a particular agreement or pleading.

1. Waiver by governing instrument

International financial institutions like the IBRD, the IFC, and the Inter-American Development Bank provide in their Articles of Agreement or comparable instrument for the waiver of immunity with respect to particular suits. The one for the Inter-American Development Bank, for example, provides: “Actions may be brought against the Bank only in a court of competent jurisdiction in the territories of a member in which the Bank has an office, has appointed an agent for the purpose of accepting service or notice of process, or has issued

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2010), the Federal Supreme Court applied an absolute immunity standard, derived from a headquarters agreement, but arguably assessed the functional relevance of garnishment to the Bank for International Settlements’ mission.

<sup>140</sup> For the range of results from the Netherlands, see Rosanne van Alebeek & Andre Nollkaemper, *The Netherlands, in Privileges and Immunities, supra* note 98, at 179, 190-93 (contrasting decisions in *Pichon-Duverger v. PCA and Stichting Mothers of Srebrenica*).

<sup>141</sup> *EMBL v. Germany, Arbitration Award*, 105 ILR 1, 41-44 (1997).

<sup>142</sup> *Id.* at 42.



or guaranteed securities.”<sup>143</sup> In the United States, at least, this is understood as a waiver of immunity and a designation of venue, not merely a provision establishing venue in the event of individual waivers.<sup>144</sup>

The scope of this waiver, however, is not entirely clear. A number of D.C. Circuit decisions take a functional approach to construing such waivers—one that preceded, but now exists alongside, that court’s precedent upholding an absolute immunity standard that governs in the *absence* of waiver<sup>145</sup>—which assumes that waiver would have been intended to secure “a corresponding benefit which would further the organization’s goals” or “when an insistence on immunity would actually prevent or hinder the organization from conducting its activities.”<sup>146</sup> The presumption is against waiver,<sup>147</sup> and asks “whether a waiver of immunity to allow this *type* of suit, by this *type* of plaintiff, would benefit the organization over the long term.”<sup>148</sup> The approach distinguishes, for example, between commercial transactions, in which failure to waive immunity would “unreasonably hobble [an IGO’s] ability to perform the ordinary activities of a financial institution operating in the commercial marketplace,” and other matters like employment, where the benefit of waiver is less clear and the potential for disruptive interference is greater.<sup>149</sup>

Applying that inquiry here—for financial IGOs and those with similar articles—is not straightforward. A waiver is not a commercial precondition allowing an IGO to enter into commercial relationships with others concerning their domain; that is, it does not arise in a contractual setting in which legal exposure to the plaintiff is necessary to secure a negotiated transaction.<sup>150</sup> An IGO might well argue, accordingly, that its objectives are furthered if its exposure to adverse determinations concerning its name is limited. Still, one could argue that the IGO’s consent is necessary to sustain the UDRP process and the validity of a domain-name

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<sup>143</sup> Agreement Establishing the Inter-American Development Bank, Apr. 8, 1959, Art. XI, Section 3, 10 U.S.T. 3068, 3095. For similar provisions relating to the World Bank Organizations, see <http://web.worldbank.org/WBSITE/EXTERNAL/EXTABOUTUS/ORGANIZATION/BODEXT/0,,contentMDK:50004943~menuPK:64020045~pagePK:64020054~piPK:64020408~theSitePK:278036,00.html>.

<sup>144</sup> *Lutcher S.A. Celulose e Papel v. Inter-American Development Bank*, 382 F.2d 454, 457 (D.C. Cir. 1967).

<sup>145</sup> The early cases suggest a view of immunity that is less absolute. See, e.g., *Mendaro v. World Bank*, 717 F.2d 610, 615 (D.C. Cir. 1983) (indicating that under international law IGOs enjoy “such privileges and such immunity from the jurisdiction of a member state as are necessary for the fulfillment of the purposes of the organization”) (citing and quoting a tentative draft of the Restatement (Third) of the Foreign Relations Law of the United States). With regard to the issue of waiver, however, cases like *Mendaro* are broadly reconcilable with the later cases premised on absolute immunity. See, e.g., *Atkinson v. Inter-Am. Dev. Bank*, 156 F.3d 1335, 1338-39 (D.C. Cir. 1998).

<sup>146</sup> *Id.* at 617.

<sup>147</sup> *Atkinson v. Inter-Am. Dev. Bank*, 156 F.3d 1335, 1338 (D.C. Cir. 1998).

<sup>148</sup> *Osseiran v. Int’l Finance Corp.*, 552 F.3d 836, 840 (D.C. Cir. 2009).

<sup>149</sup> *Mendaro*, 717 F.2d at 618; accord *id.* at 620 (discussing how the finding of waiver for suits by borrowers, approved in *Lutcher*, “would directly aid the Bank in attracting responsible borrowers”). Compare *Osseiran*, 552 F.3d at 840 (deeming IFC’s charter to have waived immunity for breaches of agreements), and *Vila v. Inter-Am. Inv. Corp.*, 570 F.3d 274, 278 (D.C. Cir. 2009) (waiver for unjust enrichment claim brought by advisor), with *Atkinson*, 156 F.3d at 1338-39 (no waiver for action to garnish employee wages), and *Jam v. Int’l Finance Corp.*, 2016 WL 1170936 (D.D.C. 2016) (no waiver for action alleging breach of IFC environmental and social policies).

<sup>150</sup> See *Atkinson*, 156 F.3d at 1338 (D.C. Cir. 1998) (discussing *Mendaro*).

registrant's own consent to Mutual Jurisdiction and that, like the waivers in prior cases, is the price of access to domains and the interests they touch. Moreover, the costs do not seem as disruptive as in other cases. Unlike a waiver for employment actions, a waiver permitting domain-related suits would not likely impose "devastating administrative costs" by requiring differentiated policies for each jurisdiction, nor would it offer only marginal advantages relative to established internal administrative procedures as available for employees. In the end, though the argument for waiver under this kind of article is colorable, the presumption against construing such provisions as establishing a waiver may be decisive.<sup>151</sup>

2. Waiver by agreement or pleading

Waiver may also be accomplished by agreement or pleading. Article 2(2) of the General Convention, for example, provides that the UN's absolute immunity from legal process (other than relative to execution) may be expressly waived in particular cases. More generally, under the IOIA, IGOs "may expressly waive their immunity for the purpose of any proceedings or by the terms of any contract."<sup>152</sup>

Putting aside potential complications, such as limits on who is entitled to waive, granting Mutual Jurisdiction—via initiation of a complaint or, for that matter, registration—would likely be understood as a waiver of any immunity the IGO might otherwise assert. The case law regarding waiver by IGOs is not particularly well developed, not least because IGOs are typically reluctant to waive their immunity. As noted above, numerous U.S. cases in the D.C. Circuit conclude that the governing instruments of international financial institutions, which refer to the bringing of actions in specified jurisdictions, amount to a sufficiently express waiver of immunity—rather than a mere venue provision—despite the fact that such provisions lack any explicit reference to immunity. For similar reasons, reference in the Mutual Jurisdiction provision to complainants' obligation to "submit, with respect to any challenges 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" (Rules, ¶ 3(b)(xii)), seems to require submission to judicial jurisdiction rather than mere non-objection to the choice among putative venues.

Cases concerning the waiver of sovereign immunity may be instructive, though the underlying scope of immunity likely differs, as may national practices concerning waiver for IGOs.<sup>153</sup> These circumstances are different than the categories originally thought to establish

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<sup>151</sup> See, e.g., *Jam v. Int'l Finance Corp.*, at \*6 (concluding lengthy assessment of costs and benefits on the basis of this presumption).

<sup>152</sup> 22 U.S.C. § 288a(b).

<sup>153</sup> In the United States, from which examples in the text are drawn, the FSIA provides an exception to foreign sovereign immunity for "cases . . . in which the foreign state has waived its immunity either explicitly or by implication." 28 U.S.C. § 1605(a)(1). Under the IOIA, which governs most IGOs, "international organizations . . . shall enjoy the same immunity from suit and every form of judicial process as is enjoyed by foreign governments, except to the extent that such organizations may expressly waive their immunity for the purpose of any proceedings or by the terms of any contract." 22 U.S.C. § 288a. As previously discussed, the IOIA's structure leaves it unclear whether it is subject to the same exceptions as available under the FSIA—including, in this instance, waiver by implication—or whether, as seems more likely here, its waiver provision is independent and exclusive. Even assuming the latter reading, though, it remains unclear whether a requirement that IGOs "expressly" waive their immunity

waiver by implication under the FSIA—“where a foreign state has agreed to arbitration in another country,” “where a foreign state has agreed that the law of a particular country should govern a contract,” or in “a situation where a foreign state has filed a responsive pleading in an action without raising the defense of sovereign immunity.”<sup>154</sup> That said, the Mutual Jurisdiction provision seems more “unmistakable” or “unambiguous”<sup>155</sup> than those examples: unlike instances in which a foreign state has agreed to *arbitration* in a state *other than* the one assessing its immunity (which some courts have in fact resisted as indicating an implicit waiver),<sup>156</sup> Mutual Jurisdiction indicates an IGO’s consent to a judicial action (rather than just arbitration) in exactly the state that would be assessing its jurisdiction.<sup>157</sup> Cases involving the UDRP seem to bear this out. In one U.S. action, initiated by a domain registrant disputing the outcome of the UDRP, the City Council of Barcelona—after asserting that it was entitled to sovereign immunity under U.S. law—appeared to concede that it was subject to U.S. jurisdiction by operation of its waiver under the UDRP, though it contended that such waiver should be narrowly construed so as to permit challenges to the UDRP transfer decision only.<sup>158</sup> In another, more recent decision, a district court held that tribal sovereign immunity, waivers of which must also be strictly construed, had nonetheless been waived when a tribe initiated a UDRP proceeding—to the extent that a follow-on lawsuit actually challenged “a decision in the administrative proceedings canceling or transferring the domain name,” though immunity was sustained to the extent the complaint sought broader or different relief not encompassed by the initial proceedings.<sup>159</sup> Likewise, it seems plausible that the Mutual Jurisdiction provision would

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imposes in practice a substantially higher threshold than the FSIA’s requirement that they do so “explicitly or by implication,” since courts construing the FSIA have read waiver by implication narrowly. See, e.g., *Shapiro v. Republic of Bolivia*, 930 F.2d 1013, 1017 (2d Cir. 1991).

<sup>154</sup> H.R. Rep. No. 1487, 94th Cong., 2d Sess. 18, reprinted in 1976 U.S. Code Cong. & Admin. News 6604, 6617.

<sup>155</sup> *Shapiro*, 930 F.2d at 1017.

<sup>156</sup> See *Frolova v. Union of Soviet Socialist Republics*, 761 F.2d 370, 377 (7th Cir.1985) (asserting that “most courts refuse to find an implicit waiver of immunity to suit in American courts from a contract clause providing for arbitration in a country other than the United States”); see also *Creighton Ltd. v. Government of the State of Qatar*, 181 F.3d 118, 122-23 (D.C. Cir. 1999) (viewing skeptically the scope of implicit waiver as described in the FSIA’s legislative history); *Seetransport Wiking Trader v. Navimpex Centrala*, 989 F.2d 572, 577 (2d Cir. 1993) (same).

<sup>157</sup> It is not, on the other hand, so direct as to refer to immunity as such. See *Gulf Resources America, Inc. v. Republic of Congo*, 370 F.3d 65, 72-74 (D.C. Cir. 2014); see also *World Wide Minerals, Ltd. v. Republic of Kazakhstan*, 296 F.3d 1154, 1162-64 (D.C. Cir. 2002) (noting waiver of immunity pursuant to two agreements advertent to waiver immunity, but contrasting two that did not—and which also referred to resolution by arbitration in other jurisdictions).

<sup>158</sup> See Brief for Appellee, *Barcelona.com, Inc. v. Excelentísimo Ayuntamiento De Barcelona* at 26, 330 F.3d 617 (4th Cir. 2003). That issue was not the focus of proceedings, though the court of appeals eventually favored the view of the registrant on the ground that (under the Lanham Act) the domain name in question implicated a purely descriptive geographical designation that, having not acquired any secondary meaning, was not entitled to protection. *Barcelona.com, Inc. v. Excelentísimo Ayuntamiento De Barcelona*, 330 F.3d 617, 628-29 (4th Cir. 2003).

<sup>159</sup> See Order Granting with Leave to Amend Defendant’s Motion to Dismiss at 7-11, *Virtualpoint, Inc. v. Poarch Band of Creek Indians, Dba PCI Gaming Authority*, Case No. SACV 15-02025-CJC(KESx) (C.D. Cal.

relieve the jurisdiction designated and entertaining the action of any responsibility for having violating the IGO's immunity.

Perhaps an IGO might argue that a waiver was compelled and therefore ineffective. It might argue compulsion or duress, for example, if a state party to the Paris Convention were to demand that an IGO waive its immunity in exchange for the state's willingness to respect the IGO's privileges. These facts, however, seem quite different. As a threshold matter, ICANN is not in a position comparable to a self-dealing state: to my knowledge, ICANN is not itself constrained by any obligation to respect immunity, nor does it seek the waiver of immunity to its jurisdiction as the price of conforming to that obligation. Accordingly—even as to the agreement to Mutual Jurisdiction made by an IGO while registering a domain-name—any compulsion objection seems attenuated. The objection is even harder to make when an IGO has filed a UDRP complaint. As noted previously, nothing compels any complainant to initiate the UDRP and accept Mutual Jurisdiction; beyond tolerating an infringement of its interests, an IGO might elect instead to proceed first (or solely) to court. Even if these options are unappealing (including because filing in court would waive immunity), those are the options that would confront IGOs in the absence of the present UDRP, so it is not as though a preexisting or independent privilege were being conditioned or withdrawn. IGOs might, indeed, take consolation from the advantages afforded them by the UDRP, which—but for cases in which judicial review is later sought by a losing registrant—affords them an efficient recourse to which they are not otherwise entitled.<sup>160</sup>

National courts may have other reasons to pause before reading this waiver narrowly. Allowing an IGO that *prevailed* in the UDRP process to avoid its waiver and rest on the UDRP result by invoking immunity, while allowing it to waive that immunity by initiating judicial proceedings if it *loses* to a domain-name registrant, will likely seem asymmetrical and unfair.<sup>161</sup> In addition, courts may resist letting matters rest after the abbreviated UDRP process. There is broad acceptance of a principle, expressed in some treaties and governing instruments, according to which IGOs *should* waive immunity in the absence of any sufficient alternative.<sup>162</sup>

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May 10, 2016), available at <https://www.scribd.com/doc/312906586/Virtualpoint-v-Poarch-Band-of-Creek-Indians-opinion-pdf>.

<sup>160</sup> IGOs that have submitted to Mutual Jurisdiction as the price for domain-name registration may have a stronger claim that their submission is compulsory, but they too derive benefit from the UDRP procedure, and fewer IGOs are likely to find themselves subjected to judicial proceedings based on their own registration.

<sup>161</sup> By analogy, the enforceability of arbitration agreements is sometimes limited on the ground that they lack a "bilateral" quality or "mutuality": requiring one party to submit its claims to arbitration, while allowing the other to elect between arbitration and court, or allowing one side only to appeal. *Armendariz v. Found. Health Psychcare Servs., Inc.*, 24 Cal. 4th 83, 117, 120, 99 Cal. Rptr. 2d 745, 6 P.3d 669 (2000); *Higgins v. Superior Court*, 140 Cal. App. 4th 1238, 1253-54, 45 Cal. Rptr. 3d 293, 304-05 (Ct. App. 2006); *Sullenberger v. Titan Health Corp.*, 2009 WL 1444210, \*5-\*6 (E.D. Cal. 2009).

<sup>162</sup> See, e.g., General Convention, art. 29 (providing that "[t]he United Nations shall make provisions for appropriate modes of settlement of . . . disputes arising out of contracts or other disputes of private law character to which the United Nations is a party"); see generally Institut de Droit International, Resolution on Contracts Concluded by International Organizations with Private Persons (1977), art. 9 ("If a dispute arises in connection with a contract which contains no clause on the settlement of disputes, the organization concerned should either waive immunity from jurisdiction or negotiate with the other party

The absence of a sufficient alternative may not be a basis for overriding immunity—at least not in the United States<sup>163</sup>—but it might reduce the appeal of arguments for limiting the scope of waiver by Mutual Jurisdiction.

C. The UDRP and Its Alternatives

The question of IGO immunity may be resolved, at least in part, outside ICANN—to the extent that national courts were inclined to find that the matter lies outside a particular IGO’s immunity, or that any immunity was waived by the IGO’s governing instrument. In other cases, though, a national court might find that Mutual Consent effectuates a waiver, even though it would otherwise be inclined to recognize the IGO’s immunity from judicial process. With respect to this latter possibility, ICANN confronts a policy question infused with legal principles. Several alternatives may be considered.

1. Maintaining the Status Quo

One legally available option is to maintain the status quo. Even if one assumes that an IGO, absent Mutual Jurisdiction, might be capable of asserting immunity, affording them a means of surrendering that immunity via the Mutual Jurisdiction provision is not *itself* an infringement. Accordingly, as a purely legal matter, it seems unlikely that the Mutual Jurisdiction provision, as it may be accepted by an IGO, establishes or occasions a violation of IGO immunity. And as explored further below, it may seem more appropriate to require an IGO to abide by a judicial process, given that it has elected to initiate UDRP proceedings, than it would be require a domain-name registrant to accept the IGO’s preferred alternative.

Even the status quo, moreover, may leave IGOs some room for adaptation. An IGO will have no interest in giving others an exclusive right to use its name, but it may be able, according to the law of its seat, to assign a right of use to another (or, at least, to appoint an agent to

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to the contract with a view to settling the dispute or to establishing an appropriate procedure for its settlement - particularly through arbitration.”).

<sup>163</sup> See, e.g., *Brzak v. United Nations*, 597 F.3d 107, 112 (2d Cir. 2010) (“Although the plaintiffs argue that purported inadequacies with the United Nations’ internal dispute resolution mechanism indicate a waiver of immunity, crediting this argument would read the word ‘expressly’ out of the [General Convention]”); *Georges v. United Nations*, 84 F. Supp. 3d 246, 249 (S.D.N.Y. 2015) (rejecting argument that absolute immunity “is conditioned on the UN’s providing the alternative modes of settlement contemplated by section 29” of the General Convention); *Lempert v. Rice*, 956 F. Supp. 2d 17, 24-25 (D.D.C. 2013) (rejecting argument that the UN had implicitly waived immunity by failing to provide an adequate alternative dispute settlement in violation of due process and obligations arising under the General Convention). The United States government has explicitly rejected the view that the General Convention encumbers the UN’s capacity to assert immunity, either by virtue of an obligation to waive that immunity or to establish alternative mechanisms. Reply in Support of the Statement of Interest of the United States of America, *Lempert v. Rice*, 956 F. Supp. 2d 17 (D.D.C. 2013), <http://www.state.gov/documents/organization/226371.pdf>, 2013 Digest U.S. Prac. Int’l L. 297; Statement of Interest of the United States of America at 11-12, *Sadikoglu v. United Nations Development Programme*, 11 Civ. 0294 (PKC) (S.D.N.Y. 2011), <http://www.state.gov/documents/organization/194079.pdf>, 2011 Digest U.S. Prac. Int’l L. 352, 353.

enforce its interest).<sup>164</sup> It is presumably within ICANN's authority to establish standing rules permitting such assignees to act as complainants. Indeed, no reform may be necessary: in at least one case, a panel permitted a legal representative of an IGO to proceed as the complainant.<sup>165</sup>

While the validity of assignments under foreign law may be assumed,<sup>166</sup> their consequences are uncertain, and will undoubtedly depend on national trademark and immunity law. One problem is that such assignments could themselves be regarded as waivers of immunity, although that risk that could be reduced by careful drafting.<sup>167</sup> A second is that the assignment might be attacked as falling outside the scope of the IGO's immunity. The significance of these issues will depend on whether the IGO is in principle entitled to absolute immunity under national law (and, if not, whether the assignment would be considered to be outside the IGO's restrictive or functional immunity), and whether any domain-related claim could be brought based on the assignment itself.<sup>168</sup>

Third, and finally, the assignment might be ineffective—for example, because it is transferred without the accompanying goodwill previously associated with the mark, thus constituting an invalid “assignment in gross”<sup>169</sup>—and fail to establish an enforceable interest for the assignee. This concern is genuine, but it may not be disabling, and it is certainly not unique. It is already possible that the substantive standard resulting in a UDRP transfer will be different than the one applied in any following judicial proceeding.<sup>170</sup> Just as a name protectable within the UDRP may not be entitled to protection under national law, an assignment that enables an IGO to prevail in the UDRP may not be sufficient to prevail in an action initiated by a losing registrant. This may not be a serious problem in terms of the dispute at hand: if the assignment is imperfect, it would require reversal of the transfer, but the IGO still would not have consented

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<sup>164</sup> Of course, either instrument would license the IGO the right to use its name and associated marks. Such license-back schemes are consistent with a valid assignment, notwithstanding the “assignment in gross” doctrine. *E & J Gallo Winery v. Gallo Cattle Co.*, 967 F.2d 1280, 1290 (9th Cir. 1992).

<sup>165</sup> *Lenz & Staehelin Ltd v. Christopher Mikkelsen*, D2012-1922 (WIPO Jan. 8, 2013). As noted previously (see *supra* note 73), UNITAID, an IGO hosted by the World Health Organization (WHO), had assigned its trademark rights by a fiduciary agreement to *Lenz & Staehelin*, a private enterprise, which registered them on behalf of the WHO and UNITAID.

<sup>166</sup> *Federal Treasury Enterprise Sojuzplodoimport v. Spirits Intern. B.V.*, 809 F.3d 737, 742-43 (2<sup>nd</sup> Cir. 2016); *id.* at 743-45 (Act of State doctrine).

<sup>167</sup> See *Universal Trading & Inv. Co. v. Bureau for Representing Ukrainian Interests in International and Foreign Courts*, 898 F. Supp. 2d 301, 310-11 (D. Mass. 2012) (concluding that agreement and other legal documents do not explicitly or implicitly waive a foreign state's immunity).

<sup>168</sup> In *Universal Trading*, the Ukraine conducted commercial activity insofar as it contracted with a private party to conduct asset recovery, but in that case the claims were actually based on a breach of the asset-recovery agreement. In the arrangement contemplated here, the domain-registrant's claim would likely be viewed as based on the UDRP transfer order as opposed to the assignment itself. 898 F. Supp. 2d at 313-17.

<sup>169</sup> 3 *McCarthy on Trademarks & Unfair Competition* § 18:2 (4th ed. 2015); *Parkinson v. Robanda Intern., Inc.*, 2016 WL 761633 (9<sup>th</sup> Cir. 2016). United States application of this doctrine has been affected by TRIPs, NAFTA, and the Trademark Treaty, but that analysis is complex and outside the scope of this memorandum. See generally 3 *McCarthy, supra*, § 19:31.75; Irene Calboli, *Trademark Assignment “With Goodwill”: A Concept Whose Time Has Gone*, 57 Fla. L. Rev. 771 (2005).

<sup>170</sup> See *supra* note 83.

to being involved in the judicial proceedings against it; if, on the other hand, the assignment is sufficient, the matter can proceed with the IGO assignee, and the IGO's immunity is again not at issue. The graver problem is that a flawed assignment might diminish the assignor's priority in the underlying mark for all purposes, making it indispensable to scrutinize national trademark law.<sup>171</sup> As partial consolation, because the IGO (or surrogate) complainant initiating the UDRP process gets to choose among the jurisdictions initially proposed by the registrant, it could take such matters into account in deciding whether to execute an assignment prior to filing a UDRP complaint.

## 2. Non-Judicial Alternatives

The way that IGOs typically resolve the tension between immunity and judicial processes is to establish a non-judicial dispute resolution process, usually consisting of some form of arbitration—either as part of an internal procedure, typically for employee matters, or involving a third-party provider. The form of this procedure varies widely, even within organizations, and depends on the nature of the claim and the relation of the parties.<sup>172</sup> Of particular relevance here, however, IGOs often provide for settling contractual disputes by negotiation and conciliation or, failing that, according to arbitration under United Nations Commission on International Trade Law (“UNCITRAL”) or similar rules.<sup>173</sup>

These practices are generally accepted by commercial partners.<sup>174</sup> For example, Apple's software licenses anticipate that some IGO licensees, at least, might object to judicial processes, providing as follows:

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<sup>171</sup> Neil R. Platt, *Good Will Enduring: How to Ensure That Trademark Priority Will Not Be Destroyed By the Sale of a Business*, 99 *Trademark Rep.* 788 (2009).

<sup>172</sup> It is difficult to describe contract-based practices of IGOs, which are not transparent, with certainty, and of course hazardous to generalize about quite different organizations. Cf. Reinisch, *supra* note 116, at 130 (acknowledging that “[d]ue to the limited case-law and an equally limited number of arbitral awards, it is very difficult to ascertain the real practice of international organizations with regard to the law applied to contracts with private parties”). For a survey for one IGO with extensive practice, see Bruce C. Rashkow, *Immunity of the United Nations: Practice and Challenges*, 10 *Int'l Org. L. Rev.* 332 (2013).

<sup>173</sup> International Fund for Agricultural Development (IFAD), *General Terms and Conditions for the Procurement of Goods*, art. 24, [http://www.ifad.org/governance/procurement/procure\\_21.pdf](http://www.ifad.org/governance/procurement/procure_21.pdf); International Labour Office, *Terms and Conditions Applicable to ILO Contracts for Services*, para. 13, [http://www.ilo.org/wcmsp5/groups/public/---ed\\_mas/---inter/documents/legaldocument/wcms\\_117516.pdf](http://www.ilo.org/wcmsp5/groups/public/---ed_mas/---inter/documents/legaldocument/wcms_117516.pdf); International Labour Office, *Terms and Conditions Applicable to ILO Contracts*, para. 13, [http://www.ilo.org/wcmsp5/groups/public/---ed\\_mas/---inter/documents/legaldocument/wcms\\_117515.pdf](http://www.ilo.org/wcmsp5/groups/public/---ed_mas/---inter/documents/legaldocument/wcms_117515.pdf); see also Edward Kwakwa & Marie-Lea Rols, *The Privileges and Immunities of the World Intellectual Property Organization*, 10 *Int'l Org.* 373, 391 (2013) (quoting WIPO *General Conditions of Contract*). For a like declaration, expressed as a policy rather than as a contractual provision, see International Organization for Migration, *General Procurement Principles and Practices*, para. 5.4, <https://www.iom.int/sites/default/files/about-iom/procurement/IOM-General-Procurement-Principles-and-Processes-Jan-2016-final.pdf>.

<sup>174</sup> See Yves Renouf (WTO Secretariat), *When Legal Certainty Matters Less than a Deal: Procurement in International Administrations 3*, *Inst. for Int'l L.J.* (March 19, 2009), <http://www.iili.org/gal/documents/GALch.Renouf.pdf> (reporting that bidders and contractors typically accept IGO-proposed mechanisms “without a word”).

If You (as an entity entering into this Agreement) are an international, intergovernmental organization that has been conferred immunity from the jurisdiction of national courts through Your intergovernmental charter or agreement, then any controversy or claim arising out of or relating to this Agreement, or the breach thereof, shall be determined by arbitration administered by the International Centre for Dispute Resolution in accordance with its International Arbitration Rules. The place of arbitration shall be London, England; the language shall be English; and the number of arbitrators shall be three. Upon Apple's request, You agree to provide evidence of Your status as an intergovernmental organization with such privileges and immunities.<sup>175</sup>

Adopting a similar mechanism as a supplement to the UDRP process would likely appeal to IGOs, which may regard it as unfair that the Mutual Jurisdiction provision asks them to pay a greater price for UDRP participation (the loss of their immunity from jurisdiction) than other parties, which are merely asked to waive objection to a *particular* jurisdiction. Still, the UDRP context seems materially different. Unlike a contracting situation, in which a typical prospective partner can agree to the IGO's preferred mechanism or pursue similar opportunities elsewhere, a party interested in registering a domain name would have less freedom; conceding to the IGO's preferred mechanism, at least its possibility, would be an inescapable aspect of registration. (There may be little sympathy, of course, for those who actually register their names in bad faith, but that premise is in theory open for reexamination after the UDRP proceeding; those whose misconduct is less apparent, moreover, may have had little cause to scrutinize an IGO-specific resolution option, which may appear to them like a remote contingency.) An alternative dispute resolution would also require compliance by a third party to a greater degree, since ICANN would be facilitating the IGO's preference by changing the terms it prescribes, as opposed to a situation in which IGOs and their contract partners decided the question the question bilaterally.

ICANN is, of course, prescribing terms in any event. But as against compelling waiver by IGOs, compelling arbitration may be more easily challenged in domestic courts, including as the basis for suggesting a further exception to IGO immunity. The conflict between immunity and access to courts was developed most famously in the *Waite and Kennedy* case, which involved employment-related actions brought against the European Space Agency in German courts. In upholding immunity, the European Court of Human Rights stated that a material factor was "whether the [employees] had available to them reasonable alternative means to protect effectively their rights under the Convention," though it held that the ESA appeals board sufficed.<sup>176</sup> Other decisions have permitted the assertion of immunity against employee

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<sup>175</sup> Xcode and Apple SDKs Agreement, para. 8.6(c), <https://www.apple.com/legal/sla/docs/xcode.pdf>.

<sup>176</sup> See *Waite & Kennedy v. Germany*, App. No. 26083/94, 30 Eur. H.R. Rep. 261, 265-67, 274-75 (1999); see also *Beer & Regan v. Germany*, App. No. 28934/95, 33 Eur. H.R. Rep. 3, 78-79 (1999).



dismissal lawsuits based on the perceived adequacy of the Administrative Tribunal of the International Labour Organization.<sup>177</sup>

These cases show that inquiring into reasonable alternative means does not necessarily imperil immunity, and there are grounds for differentiating this context or otherwise avoiding this exception.<sup>178</sup> First, domain-related rights are unlikely to be considered the equivalent of employee rights.<sup>179</sup> Second, the principle may be limited to states subject to the European Convention on Human Rights, meaning that other jurisdictions would have to simulate this doctrine under other international or domestic human rights instruments.<sup>180</sup> Third, even for employee matters and for states subject to the European Court of Human Rights, national courts have distinguished matters involving IGOs entitled to absolute immunity (at least where that immunity is reinforced, as for the United Nations, by the UN Charter)<sup>181</sup> and organizations for which immunity was established in the state concerned before the European Convention came into force.<sup>182</sup>

Subject to these important qualifications, were an IGO able to secure from ICANN the transfer of another registrant's domain, without adequate means of challenging that result, such proceedings might pose concerns for those states disposed to employ a *Waite & Kennedy* assessment. If the Mutual Jurisdiction provisions were revisited so as to permit only non-judicial review for IGOs, ICANN should pay close attention to the robustness of these alternatives, whether they likewise constrain the options for losing IGOs, and whether such recourse may be made voluntary only.

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<sup>177</sup> See Thomas Henquet, *The Jurisdictional Immunity of International Organizations in the Netherlands and the View from Strasbourg*, 10 *Int'l Org. L. Rev.* 538, 551-52 (2013).

<sup>178</sup> See, among many treatments, August Reinisch, *The Immunity of International Organizations and the Jurisdiction of their Administrative Tribunals*, 7 *Chinese J. Int'l L.* 285 (2008). Some argue, naturally, that the doctrine is excessively limited. See, e.g., Emmanuel Gaillard & Isabelle Pingel-Lenuzza, *International Organisations and Immunity from Jurisdiction: To Restrict or to Bypass*, 51 *Int'l & Comp. L.Q.* 1 (2002).

<sup>179</sup> But cf. Fox & Webb, *supra* note 91, at 577 (noting that "it has additionally been contended that the interest of individuals dealing with the [international] organization whether as suppliers of goods or services or employees . . . also require legal protection").

<sup>180</sup> The United States government has emphasized that, for this reason, such arguments are of limited value in U.S. court. Statement of Interest of the United States of America at 11-12, *Sadikoglu v. United Nations Development Programme*, *supra* note 163; see note 163 and accompanying text (discussing potential for arguing the inadequacy of alternatives in construing the scope of waiver); *Amaratunga*, *supra* note 133, ¶¶ 59-63 (examining and rejecting, as a basis for avoiding IGO immunity, attempt to invoke analogous denial-of-justice principles in the Canadian Bill of Rights and the International Covenant on Civil and Political Rights).

<sup>181</sup> *Stichting Mothers of Srebrenica v. Netherlands & United Nations*, ¶¶ 4.3.3-4.3.6, LJN:BW 1999 (Neth. Sup. Ct. Apr. 13, 2012), <http://www.asser.nl/upload/documents/20120905T111510-Supreme%20Court%20Decision%20English%2013%20April%202012.pdf>. See also *Brzak v. United Nations*, 597 F.3d 107, 112 (2nd Cir. 2010) (suggesting that where absolute immunity is otherwise conferred, attempting to measure the adequacy of internal mechanisms would be inconsistent with absolute immunity and the requirement that waivers be express).

<sup>182</sup> *Entico*, *supra* note 106, ¶¶ 23-29 (concluding, in the alternative, that arbitration according to UNCITRAL rules is a sufficient alternative).

### 3. Other Possible UDRP Reforms

Beyond simply maintaining the status quo, or accepting non-judicial alternatives familiar to IGOs, several possible compromises are worth considering.

First, ICANN could distinguish among IGOs: maintaining existing Mutual Jurisdiction terms in general, but permitting particular IGOs to elect instead to submit to arbitration (according to UNCITRAL or some similar procedure) disputes persisting beyond the UDRP process. The most obvious candidates would be IGOs almost universally entitled by treaty to absolute immunity, like the United Nations. Starting with the clearest cases would also allow ICANN to evaluate the alternative mechanisms before permitting them generally, but repeated modification of the terms (including conforming changes in registration agreements) may pose logistical problems.

Second, the Mutual Jurisdiction clause could be rewritten to address the special case of IGOs *without* prejudging the question of their immunity. The objective would be to avoid assuming IGO immunity in circumstances where the relevant jurisdiction would not be inclined to afford it anyway—because, for example, its courts would apply a functional or restrictive approach and regard the activity as beyond immunity’s scope. It may be difficult, of course, to agree on the proper threshold for diverting cases toward an alternative mechanism, in particular whether and by what means a legal evaluation could be obtained from the jurisdiction concerned, and the issue of the appropriate alternative would have to be resolved. Bracketing these questions, however, the Rules could in principle provide something like the following:

Complainant will submit, with respect to any challenges 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, *except that*: in the event the action depends on the adjudication of the rights of an international intergovernmental organization that would, but for this provision, be entitled to immunity from such judicial process according to the law applicable in that jurisdiction, [as established by a decision of a court in that jurisdiction,] the challenge must be submitted instead for determination [by UNCITRAL in accordance with its rules].

Finally, it may be possible to ameliorate the hardship that a non-judicial process might impose on the other party. For example, an IGO might be permitted to elect arbitration if it agreed to bear some or all of the cost. Assuming IGOs were found that appealing, the formulation of such a provision might be complex, given that national law may influence its enforceability.<sup>183</sup> In principle, though, such a mechanism could eliminate the higher costs arbitration may impose relative to litigation and, potentially, compensate the would-be litigant for the lost opportunity to proceed in court.

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<sup>183</sup> See, e.g., John L. Gardiner & Timothy G. Nelson, Recovery of Attorneys’ Fees in International Arbitration: The Dueling ‘English’ and ‘American’ Rules, 2010 Arb. Rev. of the Americas 25.

Reforming Mutual Jurisdiction along one of these three lines would benefit IGOs to the extent it restored to them a version of their pre-UDRP immunity.<sup>184</sup> By the same token, however, it would tend to discount the benefit they received from the UDRP process. And even if either losing party were permitted to initiate a post-UDRP arbitration, even one subsidized by the IGO, the mechanism would still be one imposed by ICANN as an accommodation to IGOs rather than to other parties—which would continue to resort to judicial action in cases not involving IGOs. Whether such an accommodation is appropriate, in light of the immunity often owed IGOs, is ultimately a policy question.

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<sup>184</sup> That which they might have enjoyed, for example, in a declaratory judgment action commenced against them by a domain-name registrant. See *supra* text accompanying note 89.