**TABLE SUMMARIZING POSSIBLE NEW FACTS, ARGUMENTS AND SOURCES FOR WORKING GROUP DISCUSSION**

**Prepared by ICANN staff (2 May 2017)**

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| **1. Lack of suitability of Article 6ter as a legal basis for standing (Recommendation #2)** | **Commenter (with relevant excerpts)** | **WG Discussion** |
| 1. What might be an appropriate, alternative legal basis?  * GAC list * Unregistered (“common law”) rights * Unfair competition and/or consumer protection laws | **USG:** “A disagreement between several GAC members, including the U.S., and the IGOs on whether Article 6*ter* of the Paris Convention provides a legal basis for the presumption of protection for IGO names and acronyms led the GAC to advance an alternative basis for protection, i.e., the existing criteria for registration at the second level in the .int top-level domain. This approach was adopted in October 2012 and it has been the basis for progressive exchanges between the GAC and the ICANN Board, ultimately culminating in the IGO Small Group Report. While the IGOs continue to disagree with the U.S. (and others) on the interpretation of Article 6*ter*, the IGOs and the U.S. nevertheless “agreed to disagree” on the applicability of Article 6*ter* and to move forward on an alternative basis, as is reflected in the IGO Small Group Report … The GAC list was the result of protracted negotiations with the IGOs. Replacing that list with “all IGOs” (that have complied with the requisite communication and notification procedure, as set forth in Recommendation #2) is a game-changer, in that at least some organizations that proclaim themselves to be IGOs in fact are not.”  **IPC**: “IPC does not support using 6ter notifications as an independent basis for standing under the UDRP or URS. The mere notification to WIPO that an entity is claiming 6ter rights does not provide a sufficient basis for standing to bring a claim …  On the other hand, the list assembled by the GAC has even more tenuous claims as a legal basis for standing. While the list was the subject of extensive discussions between the GAC and IGOs, and was considered in the GAC/IGO “small group,” it is far from clear what method, if any, was used for determining that an IGO had sufficient rights in its name to convey standing and be admitted to the list.”  **GAC-GNSO Facilitated Dialogue (ICANN58):** Suggestion made to consult external legal expert as to whether IGOs may have substantive rights in their acronyms under other laws, e.g. international and/or multiple national laws on unfair competition and/or consumer protection | WG discussing if it supports the suggestion to consult an external legal expert on alternative legal basis (e.g. unfair competition, consumer protection) |
| 1. Alternatively, is there a way to scale back recommendation on 6ter, or have a recommendation that says use 6ter to establish procedural standing but it must be coupled with a substantive legal right of some sort? |  | WG discussing possibility that 6ter notification can be used as evidence of unregistered (“common law”) trademark rights – this means the legal basis for UDRP/URS will remain trademark law |
| **2. Not appropriate to import Article 6ter(1)(c) into UDRP/URS jurisprudence (Recommendation #3)[[1]](#footnote-1)** | **IPC:** “This would introduce an additional hurdle for IGO Complainants not currently found in UDRP/URS cases. Not only does this appear to be yet another instance where the Initial Report has created a UDRP that is “designed to fail,” this would open the door to importing this limitation into UDRP/URS cases that do not involve IGOs.”  **OECD:** “Recommendation #3 unduly interferes with panellists’ decision-making and proposes an interpretation of Article 6ter(1)(c) which does not enjoy consensus. Panellists should adjudicate the cases before them based on their interpretation of the applicable legal principles in the context of the facts at hand. The proposed recommendation would unduly increase the burden on IGOs bringing cases in the UDRP.”  **World Bank:** “It is not clear that this recommendation even makes sense.  … Such a formalistic preliminary determination is not currently required for any commercial claimant before the UDRP or the URS, and none should be imposed on IGOs. There is no reasonable or legal basis to attempt to use the Paris Convention for something that it was never designed to do – the provision above applies to the “countries of the Union,” not to ICANN. Article 6ter(1)(c) was not drafted with ICANN or the UDRP in mind, and the attempt to use it to limit an IGO’s claim that its acronym is being used in bad faith is unwarranted. An IGO should have the same ability to argue and prove bad faith as a commercial claimant.” |  |
| **3. Opposition to Recommendation #4[[2]](#footnote-2)** | **Richard Hill:** “The reason why an arbitration court, rather than a national court, is appropriate in the case of a claim made by an IGO regarding its name have been exposed many times: basically, it is not appropriate for IGOs to litigate matters in national courts. Litigation regarding IGOs normally takes place in arbitration courts for what concerns commercial matters.  IGOs have stated repeatedly, and for many years, that they are unable to use the present UDRP because it requires them to waive immunity of jurisdiction, which they do not wish to do. Some people disagree with this position and think that IGOs should agree to waive immunity, or find some other means to use the existing UDRP … If there aren't many such abusive registrations, then what's the harm in creating a UDRP-like process that the IGOs can use without waiving immunity? Conversely, if there are a significant number of such abusive registrations, then surely consumers should be protected and a UDRP-like process that the IGOs can and will use should be created ...”  **GAC:** “[The WG’s suggestion of] a form of workaround, is incompatible with the position conveyed by the Legal Counsels of IGOs which was provided to the Working Group at its request.” |  |
| 1. Three reasons provided by the OECD | “First, the WG incorrectly restates the immunity test proposed by its own legal expert, Prof. Edward Swaine. Second, the WG misapplies this incorrect test by applying an inappropriate legal standard. Third, the WG’s proposed remedy for IGOs concerned about their immunities entails a complicated legal workaround which could undermine both an IGO’s immunities and its ability to defend its rights in its own name.  First, the WG incorrectly restates the functional immunity test provided by Prof. Swaine. The WG’s test asks whether, in a UDRP proceeding, the third party’s infringing use would be found to impede an IGO’s ability to carry out its core mission. However, Prof. Swaine stated that a functional immunity analysis would “typically look to whether immunity concerns activities immediately or directly related to the performance of tasks entrusted to the organization.” This is an important distinction: the immunity analysis as stated by Prof. Swaine does not focus on the potential legitimacy of the third party’s claim, or on whether the third party’s use might interfere with the IGO’s core mission. Instead, Prof. Swaine’s immunity test asks whether, as a matter of principle, the IGO’s use and protection of its name falls within its mission or functions (hence the term “functional immunity” test). On that question of principle, Prof. Swain found that “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.” … It is important to remember that this analysis assumes a court which interprets IGO immunities narrowly. Even using this strict test, Prof. Swaine found that an IGO’s immunity claim is likely to prevail.  Second, the WG applies an impossible-to-attain standard to the test it devised: it establishes the threshold of legal “certainty”, which will be satisfied only if it can be demonstrated that all courts will “necessarily” find that an infringing registration impedes the IGO from carrying out its core mission. However, a legal certainty threshold is impossible to fulfil on virtually any issue. Prof. Swaine’s conclusion that an IGO’s assertion of immunity under the circumstances in question is “likely to prevail” should be more than sufficient to justify accommodating these immunities in ICANN dispute resolution mechanisms.  Third, the WG states that no change to the mutual jurisdiction provision is necessary because “IGOs are able to file complaints through an assignee, licensee or agent.” The legal basis for this claim is tenuous; Prof. Swaine states that “the assignment might be ineffective”. Even if such an assignment were found to be legally effective—a claim for which there is little jurisprudential support—Prof. Swaine admits that “such assignments could themselves be regarded as waivers of immunity”. Moreover, Prof. Swaine observes that an IGO employing the assignment strategy is in danger of not only inadvertently waiving its immunities, but also potentially weakening its claim to the very mark it is trying to protect …  *The graver problem is that a flawed assignment might diminish the assignor’s priority in the underlying mark for all purposes.”[[3]](#footnote-3)* |  |
| 1. Agreeing to the Mutual Jurisdiction clause in the UDRP and URS can amount to waiver of immunity | **OECD:** mere acceptance of the mutual jurisdiction provision could be seen as a waiver of jurisdictional immunities for the purposes of the relevant proceeding. This is why IGOs have stated from the outset that the mutual jurisdiction provisions of the UDRP must be amended in order to be compatible with IGO immunities. If an IGO is found to have already waived its immunities, it is a purely theoretical exercise to contemplate what would occur if an IGO subsequently succeeded in asserting a claim of jurisdictional immunity in the relevant court of mutual jurisdiction. Where a court finds that the relevant IGO had already waived its immunity by submitting to the UDRP, the IGO would likely be estopped from subsequently raising jurisdictional immunity as a procedural defence.  **IFC:** “we note (without waiver or agreement) Professor Swaine’s counsel that “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 WG’s assertion that its proposed outcome “respects and preserves an IGO’s assertion of jurisdictional immunity”, or indeed any immunity, is therefore incorrect on the WG’s own terms.  Finally, we note that whatever the substantive concerns, by declining to consider the accommodations supported by the Small IGO Group, the GAC, or apparently, the ICANN Board, the WG is recommending an approach that impedes rapid or efficient resolution of domain name disputes by registrants.”  **UNESCO:** “IGOs’ immunity from legal process prevents IGOs from appearing before a national court at all, even if it is to raise a so-called “immunity claim.” This is because the mere fact that an IGO appears before a court could be construed as a waiver of immunity. Therefore, the Working Group based Recommendation #4 on the wrong assumption… IGOs’ immunity is not a mere jurisdictional objection that has to be raised during the proceedings by the IGO and that is ultimately decided by the Court … the mere fact that an IGO agrees to a Mutual Jurisdiction under the UDRP or URS could likely be interpreted as an implicit waiver of immunity.”  **UN:** “Forum selection clauses provide an expression of consent by the participating parties to submit to a given jurisdiction. The Mutual Jurisdiction Clause of the UDRP and URS does this exactly. The Mutual Jurisdiction Clause provides that the parties agree in advance that national courts shall be competent to hear and rule on disputes that have been brought to the UDRP and URS. Thus, leaving the jurisdictional clause of the UDRP and URS in place would require an IGO to have already agreed to appear before a court of national jurisdiction and, therefore, to have agreed in advance to waive its immunities. Should the IGO subsequently assert its immunity, the IGO could be perceived as reneging on that agreement.”  **World Bank:** “Professor Swaine concludes that "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 GNSO has no reasonable basis to ignore this advice, so only by departing from Professor Swain's analysis and conclusions can the GNSO justify its preliminary recommendations on this issue.” |  |
| 1. The option of arbitration should be further reviewed and existing examples (e.g. the New York Convention) noted. | **UN:** [Disagree] that arbitration may not be a proper alternative to national courts as a means to appeal an UDRP or URS finding because the arbitration mechanism is not familiar to registrants. Arbitration is a common method for dispute resolution and especially popular between entities that come from different national jurisdictions, since the awards are valid in any country, regardless of where the decision was made.”  **Several IGOs:** Arbitration is the standard mode of dispute settlement used in disputes between IGOs and other parties and is also commonplace in commercial settings.  **IPC:** “IPC especially supports and notes the importance that the arbitration entity handles such case for de novo review and determination. Option 2 is easily transferrable to an IGO-DRP as recommended by IPC.”  **OECD:** Referred to the New York Convention on the enforcement of foreign arbitral awards (<http://www.newyorkconvention.org/11165/web/files/original/1/5/15432.pdf)>. |  |
| **3. Some support emerging for Option #2[[4]](#footnote-4)** | **OECD:** Implementing [Option 1] would curtail any rights the IGO does have to its immunities. Any losing registrant would know that one means of sweeping aside an unfavourable UDRP decision would be to lodge an appeal in a court of mutual jurisdiction. Even if that appeal is baseless, the IGO will be prevented from asserting the immunities granted to it under national and international law because the decision in its favour will simply be swept aside if the immunities claim succeeds …  The OECD strongly supports [Option 2] as the only viable proposal, which would preserve the due process rights of both parties. In fact, as stated above, providing for the possibility of appeal to an arbitral tribunal from the outset of proceedings would resolve many of the issues raised in this PDP by eliminating the need for the mutual jurisdiction provision.”  **FICPI:** “Option 1 seems to correspond more closely to traditional trademark/domain name disputes, and is therefore also likely to be both more practical and more accepted by domain holders, registrars and other groups involved in domain name registration and administration. However, Option 2 may be more acceptable from the perspective of IGO's, as the final decision will not be restricted to a specific national court but will still be handled in a neutral / international way.  FICPI therefore recommends the Working Group should reach out to GAC and representatives of IGO's to obtain their view on relative merits of the two options. If a majority of active GAC members prefer Option 2, FICPI recommends the Working Group accept that solution in its Final Report.”  **BC:** “It is important to note that it is only within this very narrow circumstance of a complainant IGO’s successful assertion to a court of its judicial immunity in which we would countenance compelling a domain registrant to submit to arbitration as an appeals mechanism, and this position should not be viewed as setting a broader precedent. If the WG is swayed by public comment to adopt Option 2 then it will be extremely important that its eventual implementation rest upon carefully balanced selection of an arbitration forum and applicable rules for the de novo determination.  Option 1 would effectively compel an IGO to waive its (potentially valid) claim of jurisdictional immunity after prevailing in a UDRP … The BC remains open to the input of affected IGOs on this matter … we urge the WG to carefully review all comments and to be mindful of the potential impacts on time and cost to resolution, as well as the necessity to assure that the CRP provided to IGOs can be utilized in a practical matter that is respectful of valid immunity claims.”  **IPC:** “Option 1 seems harsh and draconian, and puts an IGO complainant in an appeal in an untenable position. On the other hand, it offers a “free pass” to the losing respondent. Option 2 is consistent with the general practice for appeals of UDRP cases, as registrants on the losing side of a UDRP are entitled to a de novo review upon appeal, except that the appeal goes to an arbitrator rather than a court.” |  |
| 1. WG should consider further review of arbitration as an option | **UN:** “Forum selection clauses provide an expression of consent by the participating parties to submit to a given jurisdiction. The Mutual Jurisdiction Clause of the UDRP and URS does this exactly. The Mutual Jurisdiction Clause provides that the parties agree in advance that national courts shall be competent to hear and rule on disputes that have been brought to the UDRP and URS. Thus, leaving the jurisdictional clause of the UDRP and URS in place would require an IGO to have already agreed to appear before a court of national jurisdiction and, therefore, to have agreed in advance to waive its immunities. Should the IGO subsequently assert its immunity, the IGO could be perceived as reneging on that agreement.  [Disagree] that arbitration may not be a proper alternative to national courts as a means to appeal an UDRP or URS finding because the arbitration mechanism is not familiar to registrants. Arbitration is a common method for dispute resolution and especially popular between entities that come from different national jurisdictions, since the awards are valid in any country, regardless of where the decision was made.”  **Several IGOs:** Arbitration is the standard mode of dispute settlement used in disputes between IGOs and other parties and is also commonplace in commercial settings.  **IPC:** “IPC especially supports and notes the importance that the arbitration entity handles such case for de novo review and determination. Option 2 is easily transferrable to an IGO-DRP as recommended by IPC.”  **RrSG:** “We recognize the complex legal considerations raised with Recommendation 4, regarding jurisdictional immunity claimed by some IGOs, and its impact on the use of these mechanisms. However, we do not believe that it’s within the remit of ICANN or GNSO consensus policy to grant or limit the scope of immunity as applied to some IGOs. We therefore applaud the working group’s consultation of outside experts on this topic, and encourage them to continue to engage all necessary resources in their review of Public Comments and development of their Final Report.” |  |
| 1. How arbitration works | **OECD:** The WG inaccurately claims that “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”. [Citing the Convention on the Recognition and Enforcement of Foreign Arbitral Awards and a United Nations Commission on Trade and Development treatise on arbitration], an agreement signed by the parties at the outset of UDRP proceedings (or later) will therefore constitute a valid agreement to arbitrate. No amendment to registration agreements would be necessary.  … Given that only a minimum number of cases (the small number of those cases involving IGOs and which are subsequently appealed) would be concerned, there is no apparent basis for [the WG’s concern of “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”].  **Richard Hill:** “It is important to understand that the institution administering an arbitration (e.g. WIPO) does not have any role regarding the decisions made by the arbitrators. The arbitrators are not employees of the institution: they are independent professionals who are named to hear a dispute. Further, the choice of the arbitration institution could be left up to the non-IGO party in a domain name dispute …  In the case of a UDRP-like mechanism, the arbitrators would hear the case de novo, just as would a national court, and they would not give any deference to the UDRP decision.  Finally, it is worth noting that an arbitration clause in a contract between a private party and an IGO typically protects the private party, because it ensures that the IGO will not invoke immunity, as it might if the private party took the IGO to court in a national jurisdiction.” |  |
| 1. Is there a difference between recommending binding arbitration as the sole option for appealing a UDRP decision vs filing a separate, new proceeding in a national court (which is not an appeal from a UDRP panel)? |  | Observation noted during initial review of public comments for further WG discussion. |
| 1. GoDaddy requires arbitration per Article 25 of its Universal Terms of Service (However, there is a relationship between registrar and registrant and unclear how widespread this practice is) |  | Observation noted during initial review of public comments for further WG discussion. |
| **4. Further discussion of a separate DRP[[5]](#footnote-5)** | **WIPO:** “ICANN should be able to accommodate IGOs’ specific needs and circumstances through a narrowly tailored dispute resolution mechanism modeled on, but separate from, the UDRP. By facilitating this, not only would ICANN help protect IGO causes recognized by governments the world over, but it would signal a commitment to a more credible DNS that prioritizes trust and consumer safety in balancing the rights of IGOs and good-faith registrants.”  **GAC:** “ICANN should establish a dispute resolution mechanism *modeled on but separate from the UDRP*, which provides … standing for IGOs which need not be expressly grounded in trademark law as such, as IGOs are created by governments under international law and are in an objectively different category of rights‑holders.”  **IPC:** “[G]iving each IGO the opportunity to demonstrate a legal basis for its rights is far preferable to bootstrapping either the 6ter list or the GAC list (unless the GAC used a demonstrated and transparent methodology for determining whether each IGO name had “secondary meaning or distinctiveness.”) … Option 2 [from Recommendation 4] is easily transferrable to an IGO-DRP as recommended by IPC.” |  |
| 1. Specific recommendations from IPC | **IPC:** “continues to support the creation of a separate, narrowly-tailored UDRP or URS-like process solely for IGOs to protect their identifiers.  Such a mechanism would likely only need a few key amendments to the UDRP/URS:  1. Removal of the “mutual jurisdiction” clause as to not prejudice arguments regarding IGO sovereign immunity;  2. Explicitly permitting appeals of the decision to any court of competent jurisdiction, e.g., on an in rem basis where the domain name is located (via the registry or registrar) and/or specifying that appeals must be made to an arbitrator (e.g., any ICC arbitrator, not a special panel) rather than a court (in order to preserve IGO immunity …); and  3. While Article 6ter of the Paris Convention cannot by itself confer standing, a 6ter notification could be considered as an element in evidencing common law trademark rights in the IGO identifier(s) at issue sufficient to afford standing …  Of course, an IGO would still be able to use any actual trademark registrations it might have to satisfy this element, or it could rely on other evidence of secondary meaning or distinctiveness.” |  |
| 1. WG had deferred discussion of 2007 draft procedure from ICANN staff until after completion of initial review of all comments | Draft text: <https://gnso.icann.org/en/drafts/gnso-igo-drp-report-v2-28sep07.pdf> |  |
| **5. Concerns about proposed scope of a Policy Guidance document** |  |  |
| 1. Cannot be used for cases where a WG recommendation amounts to a substantive change of the UDRP (e.g. if Recommendation 4 Option #1 is adopted) | **IPC:** “believes that [if a separate DRP is created] no “Policy Guidance” document would be warranted. Indeed, such a document appears aimed at making inappropriate back-door modifications to the existing UDRP and URS. We reject this approach.”  **WIPO:** “The Working Group’s suggestion to issue “Policy Guidance” on UDRP standing, and to apply agency principles to avoid jurisdictional questions, is misguided in two respects.  First, such “alternative guidance” would contravene the plain language of the UDRP itself. We strongly feel that ICANN should see this as inadvisable for a number of reasons.  Second, given that fair resolution of disputes involving IGOs more generally through independent and impartial arbitration is already widely accepted (see Swaine Memo page 28), the application of agency principles would be an artifice creating unnecessary legal hurdles.”  **GAC:** “First, insofar as the Recommendation itself would effectively alter an existing Consensus Policy (no amendment of the UDRP), it improperly bypasses the ordinary Bylaws‑prescribed Policy Development Process (it should not therefore be described merely as some form of policy “implementation” guidance).  Second, aside from failing to adequately account for GAC Advice on this subject, this Recommendation disregards the plain language of the UDRP which requires trademark rights for standing to file a case.” |  |
| 1. Inappropriate | **RySG:** [On Recommendation 4(b)] “The RySG does not believe ICANN or the WG should provide any sort of legal advice to an IGO filing a UDRP or URS complaint. Furthermore, the locale of the agency or assignee filing the complaint is completely unrelated to the Mutual Jurisdiction of UDRP or URS (which are both limited to the location of the registrar or registrant, as elected by the complainant).”  **IPC:** “there needs to be a mechanism that does not require an IGO to choose between initiating a claim and preserving immunity.” |  |

1. However, the RySG supports “an appropriate policy guidance document that clearly explains the limitations of any rights under Article 6ter of the Paris Convention.” [↑](#footnote-ref-1)
2. Recommendation 4: “In relation to the issue of jurisdictional immunity, which IGOs (but not INGOs) may claim successfully in certain circumstances, 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.” [↑](#footnote-ref-2)
3. Note that Richard Hill had commented that if there is no change in either the IGOs’ or the WG’s views, “Unless there is a change in those positions, it might be better to explore the option of making it easier for IGO's to file a complaint through an assignee.” [↑](#footnote-ref-3)
4. Although there were a few commenters who supported Option 2, it is important to note that several commenters strongly agreed with the need to preserve a registrant’s right to recourse in a national court, and at least two expressly support Option 1: e.g. “The only reasonable option in this situation is to vitiate or set aside the UDRP/URS ruling, in order to preserve the status quo and the legal rights of all parties and to ensure that the UDRP/URS does not interfere with those legal rights. It would put all parties in the same situation as if the UDRP/URS did not exist, and only the national laws existed … Depriving a domain name registrant recourse to the courts through compulsory arbitration represents a denial of due process to those domain name registrants.” (per George Kirikos). In addition, a few commenters did not support either Option 1 or 2: e.g. “neither Option 1 nor 2 solve the problem the working group is trying to address. Both merely introduce new levels of complexity and cost and lose the delicate balance the UDRP and URS have struck ” (per the Registries Stakeholder Group). [↑](#footnote-ref-4)
5. Some commenters expressly did not support the creation of a new dispute resolution process, e.g. the GNSO Registries and Registrars Stakeholder Groups, FICPI. [↑](#footnote-ref-5)