**CONSENSUS CALL ON FOUR POLICY RECOMMENDATIONS & SIX ADDITIONAL OPTIONS FOR A POSSIBLE RECOMMENDATION FIVE**

**Prepared by ICANN staff (25 May 2018)**

RECOMMENDATIONS FOR WHICH TEXT HAS BEEN AGREED OR DISCUSSED:

1. No changes to the UDRP and URS are to be made, and no specific new process created, for INGOs (including the Red Cross movement and the International Olympic Committee).

2. The Working Group notes that an IGO may seek to demonstrate that it has the requisite standing to file a complaint under the UDRP or URS by showing 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[[1]](#footnote-1). An IGO may consider this to be an option where it does not have ~~trademark rights in its name or acronym (as applicable)~~ rights in a trademark or service mark but believes it has ~~certain unregistered~~ rights for which it must adduce factual evidence to show that it nevertheless has substantive legal rights in the name and/or acronym in question[[2]](#footnote-2). In this regard, the Working Group recommends that specific Policy Guidance on this topic be issued by ICANN to clarify the following points:

(a) this alternative mechanism for standing is not needed in a situation where an IGO already holds trademark rights in its name and/or acronym, as the IGO would in such a case proceed in the same way as a non-IGO trademark owner;

(b) whether or not compliance with Article 6*ter* will be considered determinative of standing is a decision to be made by the UDRP or URS panelist(s) based on the facts of each case; and

(c) the possibility that an IGO may seek to rely on its compliance with Article 6*ter* to demonstrate standing should not modify or affect any of the existing grounds which UDRP and/or URS panelists have previously found sufficient for IGO standing (e.g. based on statutes and treaties).

3. ICANN Organization shall create and issue Policy Guidance outlining 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 any claim of jurisdictional immunity made by an IGO in respect of a particular jurisdiction will be determined by the applicable laws of that jurisdiction. In addition, ICANN Organization shall ensure that this Policy Guidance document is brought to the notice of the Governmental Advisory Committee (GAC) for its and its members’ and observers’ information and published along with the procedures and rules applicable to the UDRP and URS on the ICANN website.

4. In accordance with GAC advice concerning access to curative rights processes for IGOs as well as the Charter language requiring the Working Group to consider “The need to address the issue of cost to IGOs and INGOs to use curative processes”, and in recognition that this Working Group has no authority to obligate the expenditure of ICANN funds,  the Working Group recognizes that the feasibility of providing IGOs with access to the UDRP and URS at no or nominal cost to the IGOs is one that must be addressed directly through discussions between the ICANN Board with the GAC and IGOs, while further noting that many Working Group members believe that a respondent should also be eligible to receive financial support for its defense in a case where ICANN has subsidized the complainant[[3]](#footnote-3).

SIX POLICY OPTIONS FOR A POSSIBLE RECOMMENDATION FIVE:

Option 1 (unchanged from the text presented for the October 2017 poll):

* *Where a losing registrant challenges the initial UDRP/URS decision by filing suit in a national court of mutual jurisdiction and the IGO that succeeded in its initial UDRP/URS complaint also succeeds in asserting jurisdictional immunity in that court, the decision rendered against the registrant in the predecessor UDRP or URS shall be vitiated (i.e. set aside).*

Option 2 (unchanged from the text presented for the October 2017 poll):

* *In relation to domain names with a CREATION DATE before the (Policy Effective Date), then Option [1] applies. In relation to domain names with a CREATION DATE on or after the (Policy Effective Date), Option [3] shall apply. After five (5) years or 10 instances of Option [3] being utilized, whichever occurs first, ICANN and the various dispute resolution providers (including any who have administered arbitration proceedings under the new Option [3] will conduct a review to determine the impact, both positive and negative, as a result of “trying out” Option [3].*

Option 3 (unchanged from the text presented for the October 2017 poll):

* *Where a complainant IGO succeeds in a UDRP/URS proceeding, the losing registrant proceeds to file suit in a court of mutual jurisdiction, and the IGO subsequently succeeds in asserting jurisdictional immunity, the registrant shall have the option to transfer the dispute to an arbitration forum meeting certain pre-established criteria for determination under the national law that the original appeal was based upon, with such action limited to deciding the ownership of the domain name. The respondent shall be given 10 days (or a longer period of time if able to cite a national statute or procedure that grants a period longer than 10 days) to either: (1) inform the UDRP/URS provider [and the registrar] that it intends to seek arbitration under this limited mechanism; or (2) request that the UDRP/URS decision continue to be stayed, as the respondent has filed, or intends to file, a judicial appeal against the IGO’s successful assertion of immunity. An IGO which files a complaint under the UDRP/URS shall be required to agree to this limited arbitration mechanism when filing the complaint. If, subsequently. it refuses to participate in the arbitration, the enforcement of the underlying UDRP/URS decision will be permanently stayed. The parties shall have the option to mutually agree to limit the original judicial proceedings to solely determining the ownership of the domain name. Subject to agreement by the registrant concerned, the parties shall also be free to utilize the limited arbitration mechanism described above at any time prior to the registrant filing suit in a court of mutual jurisdiction. In agreeing to utilize the limited arbitration mechanism, both the complainant and respondent are required to inform ICANN*.

Option 4 (initially proposed by Zak Muscovitch[[4]](#footnote-4), updated following Working Group discussion on 25 May 2018):

* *Our initial report and recommendation (that no change is required) remains valid and should be reflected in the published report of this WG.  Our report should advise that even if a change were advisable or appropriate, such would necessarily require modifications to the UDRP/URS and its accompanying rules.  As such changes are within the ambit of the RPM WG, we feel it inappropriate to inject our proposals in that regard. Accordingly, the IGO WG strongly recommends that the GNSO Council consult with the Review of All Rights Protection Mechanisms (RPM) Working Group and the IGOs participating in the GAC on whether any changes to how the UDRP ~~procedure~~ and URS are ~~is~~ drafted and employed for IGOs~~, if any,~~ should be referred to the RPM WG for consideration within its broader mandate to review the UDRP/URS.*

Option 5 (proposed by George Kirikos[[5]](#footnote-5), modified from an earlier proposal and also noted as a proposal that can be included in Option 4 in the event of a referral to the RPM Working Group):

* *The text of both the UDRP and URS rules and policies shall be modified so that, in the event a domain name dispute (UDRP or URS) is initiated by an IGO as complainant and a registrant commences an "in rem" action in a court of mutual jurisdiction concerning that domain name, the registrar shall treat that court action in the same manner as if an "in personam" action had been brought directly against the IGO.*

Option 6 (initially proposed by Paul Tattersfield[[6]](#footnote-6), with a slight amendment to the text following discussion by the Working Group):

* *We should arrange for the UDRP providers [to] provide [mediation] at no cost to the parties. The UDRP already permits the resolution of disputes through arbitration - I would bind the IGOs to arbitration in the same way the Mutual Jurisdiction clause binds complainants to the registrant’s judicial system. Where an IGO refuses to take part in a judicial proceeding or judicial or arbitral proceedings, or successfully asserts immunity in a judicial proceeding, any prior UDRP determination would be quashed.*
1. The 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> and in Annex D of this report. [↑](#footnote-ref-1)
2. Proposed deletions and edits made based on discussions held on the Working Group call of 25 May 2018. [↑](#footnote-ref-2)
3. Language suggested on the Working Group mailing list by Philip Corwin on 25 May 2018. The original language of Recommendation #4 was: “In accordance with GAC advice concerning access to curative rights processes for IGOs, the Working Group recommends that ICANN investigate the feasibility of providing IGOs with access to the UDRP and URS at no or nominal cost to the IGOs”. [↑](#footnote-ref-3)
4. See <https://mm.icann.org/pipermail/gnso-igo-ingo-crp/2017-December/000965.html> for Zak’s full message outlining also the rationale. [↑](#footnote-ref-4)
5. See <https://mm.icann.org/pipermail/gnso-igo-ingo-crp/2017-December/000974.html> for George’s full message including links to previous notes on this suggestion. [↑](#footnote-ref-5)
6. See <https://mm.icann.org/pipermail/gnso-igo-ingo-crp/2017-December/000975.html> for Paul’s full message explaining this suggestion. [↑](#footnote-ref-6)