

Suggested Text – IGO PDP

(Prepared by: George Kirikos, June 19, 2018)

For reference, the latest text used as a “baseline” for suggested changes is the June 11, 2018 document:

<https://mm.icann.org/pipermail/gnso-igo-ingo-crp/2018-June/001264.html>

NB: I don’t have software that generates “redline” changes automatically, so the “Redline” text below is a best effort, doing it manually

Let’s start with the “easier” Recommendation 2 (easier, since it’s only the addition of 4 words):

Recommendation 2:

Current Text	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 6ter of the Paris Convention for the Protection of Industrial Property. An IGO may consider this to be an option where it does not have a registered trademark or service mark in its name and/or acronym but believes it has 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. 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 6ter 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 6ter 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).
Proposed Text	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 6ter of the Paris Convention for the Protection of Industrial Property. An IGO may consider this to be an option where it does not have a registered trademark or service mark in its name and/or acronym but believes it has unregistered trademark or service mark 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. 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

	<p>would in such a case proceed in the same way as a non-IGO trademark owner;</p> <p>(b) whether or not compliance with Article 6ter 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</p> <p>(c) the possibility that an IGO may seek to rely on its compliance with Article 6ter 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).</p>
Redline	<p>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 6ter of the Paris Convention for the Protection of Industrial Property. An IGO may consider this to be an option where it does not have a registered trademark or service mark in its name and/or acronym but believes it has unregistered trademark or service mark 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. In this regard, the Working Group recommends that specific Policy Guidance on this topic be issued by ICANN to clarify the following points:</p> <p>(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;</p> <p>(b) whether or not compliance with Article 6ter 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</p> <p>(c) the possibility that an IGO may seek to rely on its compliance with Article 6ter 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).</p>

Reasoning: (a) added “trademark or service mark” in the appropriate place, as noted before, as otherwise there could be a huge expansion of the UDRP/URS to all kinds of other “unregistered rights”; (b) this matches the phrasing of the UDRP/URS standing requirements.

UDRP: <https://www.icann.org/resources/pages/policy-2012-02-25-en>

4(a)(i): (i) your domain name is identical or confusingly similar to a **trademark or service mark** in which the complainant has rights; and

URS: <http://newgtlds.icann.org/en/applicants/urs/procedure-01mar13-en.pdf>

1.2.5: The specific **trademark/service marks** upon which the Complaint is based and pursuant to which the Complaining Parties are asserting their rights to them, for which goods and in connection with what services.

Recommendation 1:

Current Text	1. No substantive 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).
Proposed Text	1. (a) For INGOs (including the Red Cross movement and the International Olympic Committee), no changes to the UDRP and URS are to be made, and no specific new dispute resolution procedures be created. (b) For IGOs, no specific new dispute resolution procedures be created.
Redline	1. (a) For INGOs (including the Red Cross movement and the International Olympic Committee), No substantive changes to the UDRP and URS are to be made, and no specific new process dispute resolution procedures be created, for INGOs (including the Red Cross movement and the International Olympic Committee). (b) For IGOs, no specific new dispute resolution procedures be created.

Reasoning: (a) moved the “For INGOs” from the end of the sentence to the beginning of the sentence, for clarity (otherwise, one might interpret the first part of the text applying “globally” instead of just for INGOs) (b) removed “substantive”, as it’s not needed here (c) changed “new process” to “new dispute resolution procedures”, again for clarity (i.e. modeled on the charter’s text “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.*” (d) captures the group consensus (in the body of the document, but not within a recommendation) that no specific new DRPs be created for IGOs (very important, otherwise IGOs will keep bringing this suggesting to ICANN, as they’ve done for nearly 20 years, and it was a specific charter question)

If PDP members would rather leave IGO-related recommendations out of Recommendation 1, then the above text for 1(b) could instead be moved into Recommendation 3.

Alternative Approach to incorporating language of 1(b), into Recommendation 3:

Recommendation 3:

Current Text	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.
--------------	---

Proposed Text	3. For IGOs, no specific new dispute resolution procedures be created. Rather, 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.
Redline	3. For IGOs, no specific new dispute resolution procedures be created. Rather, 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.

I don't know if folks noticed, but Recommendation 3 really got changed from the comparable January 2017 text (see: <https://community.icann.org/display/gnsoicrmpdp/Draft+Initial+Report+-+including+work+on+specific+sections+and+recommendations>)

i.e. the comparable text would have come from page 4 of that document, from the older Recommendations 3 and 4. They were condensed into a single recommendation, but didn't seem to capture everything.

Missing phrases that might be put back include (for IGOs):

~~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)~~

and

~~the WG recommends that: (a) no change be made to the Mutual Jurisdiction clause of the UDRP and URS;~~

and it's unclear to me why the following text still belongs in Recommendation 3, the way it currently stands (without restoring some of the older text)?

~~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~~

It doesn't seem to actually say anything, in relation to the policy guidance (i.e. the policy guidance is focused on the procedural options, but then the text veered off into unrelated things). If you look at the original text of Recommendation 4 from January 2017, there was actually a semi-colon after "licensee" (representing completion of a thought), but now the text that followed that semi-colon has been merged into one single thought, and it doesn't make sense anymore.