

## Status Summary of IGO Work Track Discussions (as of the Work Track meeting of 29 March 2021)

### Nature of the Problem:

The Work Track has agreed that IGOs face two challenges in relation to using the UDRP and URS: (1) the requirement to have a trademark or service mark in order to show that a respondent-registrant's domain name is "identical or confusingly similar to a trademark or service mark in which the complainant has rights" under both processes; and (2) potentially jeopardizing jurisdictional immunity by agreeing to submit to Mutual Jurisdiction under Section 3(b)(xii) of the UDRP Rules (Section 3(b)(ix) of the URS Rules) when filing a complaint..

### The Requirement for a Trademark or Similar Rights:

The Work Track agreed that this first requirement under the UDRP and URS is the basis upon which a complainant is able to file a claim. In this regard, the Work Track discussed two possible options that may assist IGOs who do not have trademark rights. The first option is to amend the UDRP and URS by allowing IGOs who have fulfilled the requisite notification procedure under Article 6ter of the Paris Convention for the Protection of Industrial Property to file a complaint under the UDRP and URS, even in the absence of a trademark. The second option is to amend the UDRP and URS to allow filings by IGOs that have been included on a [list of IGOs prepared by the GAC](#) in 2013. That list was based on specific [criteria](#) such as an IGO being created through a treaty and having international legal personality.

Several Work Track members have noted a number of problems with both of those approaches, including the following:

- The current need for a complainant to demonstrate an identical match or confusing similarity is a substantive question that depends on an IGO having a trademark or service mark in which it has "rights". It is not a purely procedural issue.
- In relation specifically to Article 6ter, that treaty provision was never intended to create substantive trademark or service mark rights. Its objective was to protect recognized IGOs against unauthorized third-party trademark or service mark registrations. In addition, its scope may be implemented in different ways by each nation that has adopted the Paris Convention.
- In relation to the GAC list, there is little information known about the process by which IGOs were (or were not) included. Further, the list is 8 years old at this point and it is unclear whether such a list can be maintained and updated, and by whom.

The Work Track has agreed to defer further discussion of this topic, pending progress of its deliberations on the jurisdictional immunity issue.

### The Question of Jurisdictional Immunity:

In discussing a policy solution to address IGOs' concerns that the requirement to agree to "Mutual Jurisdiction" could amount to a waiver of jurisdictional immunity, the Work Track identified a number of options for discussion, as listed in the Google Document summarizing its work to date:

<https://docs.google.com/document/d/1BxGr2f1d5670Zgcr42a7grU-moa254la-NdqA0EsN4/edit>.

On its latest call (29 March), the Work Track considered the possibility of recommending that rehearings from an initial UDRP or URS panel determination be handled exclusively through either formal, binding arbitration or via convening a “Supreme Panel” of experienced UDRP and URS panelists. As part of its deliberations, the Work Track noted the following concerns:

- Who will pay for the cost of an arbitral proceeding or other appeal?
  - Note: the GAC advice was that protections for IGOs should be at “no or nominal cost” to the IGO, but it is unclear that this was intended to - or should, as a policy matter - extend to appeals, court appearances and other processes following the initial dispute resolution proceeding.
- Is this recommendation intended to be a substitute for legal action in a court of competent jurisdiction, or is it intended to apply only if a registrant is unable to bring a legal action against the IGO in a court of competent jurisdiction?
- If there were this form of rehearing, would the existing UDRP and URS frameworks apply, or would this new process have to be introduced into agreements between Registries, Registrars and Registrants?
- To implement either of these options, will it suffice to include a statement in the applicable Rules stating that the section currently requiring consent to Mutual Jurisdiction shall not apply to IGOs?
- What are the differences and consequences of having the sole “rehearing mechanism” be arbitration versus a Supreme Panel?

In addition, the Work Track also discussed the possibility of looking to narrow, specific proposals focusing on creating a separate dispute resolution procedure whereby an IGO could obtain a suspension, transfer or deletion of a domain name by demonstrating that the registrant was either (a) “impersonating the IGO or misrepresenting themselves as being (or authorized to act for) the IGO” or (b) otherwise engaging in consumer fraud or deception.

Work Track members raised the following questions and concerns in relation to this topic:

- Is this proposal actually narrower than the above-noted “tweaks” to the UDRP and URS?
- Is the new criteria intended to be a substitute for all of the UDRP and URS elements, including the requirements that a domain name be registered and used in bad faith?
  - For example, if an IGO can show that the registrant is pretending to be the IGO (e.g., in fraudulently soliciting donations from the public), but the domain name registration occurred prior to the IGO getting these new protections, would the registrant’s actions be considered a violation of this new standard?
  - Under the current UDRP and URS, a trademark owner under such a scenario would not be successful because the domain name cannot be shown to have been “registered” in bad faith.
- To the extent that the Work Track agrees to further explore this alternative, it will be necessary to clarify and tighten the scope, especially around what it means to engage in behavior that is “otherwise likely to result in fraud or deception”.

- This could conceivably be more than a tweak to the UDRP and URS. The GNSO Council's directions were specifically that the Work Track's recommendations should be "generally consistent" with the policy recommendations the Council has already approved, including one that specifies that no separate process is to be created for IGOs.

Other Notes:

The Work Track Chair noted that not being able to develop a separate and more narrowly focused process for IGOs, based on a registrant's intention to misrepresent or engage in fraudulent and deceptive behavior, could result in the Work Track's coming up with a proposal that broadens the UDRP and URS by providing an alternative basis for IGOs to file complaints.

On its next call (12 April), the Work Track will continue its discussions on: (1) the issue of "standing" (i.e. Article 6ter and the GAC list as options); and (2) the jurisdiction issue (i.e. formal arbitration or appeal to a Supreme Panel in lieu of court proceedings).