**DRAFT TEXT FOR PRELIMINARY RECOMMENDATIONS**

**EPDP on Specific Curative Rights Protections for IGOs**

**Updated Draft as of 13 September 2021**

**Recommendation #1: Definition of “IGO Complainant”**

The EPDP team recommends that the UDRP Rules and URS Rules be modified in the following two ways:

1. Add a description of “IGO Complainant” to section 1 (i.e., the definitions section of both sets of Rules):

“‘IGO Complainant’ refers to:

(a) an international organization established by a treaty and which possesses international legal personality; or

(b) an ‘Intergovernmental organization’ having received a standing invitation to participate as an observer in the sessions and the work of the United Nations General Assembly; or

(c) a Specialized Agency or distinct entity, organ or program of the United Nations[[1]](#footnote-1).”

AND

1. Add the following explanatory text to UDRP Rules Section 3(b)(viii), URS Section 1.2.6 and URS Rules Section 3(b)(v):

“Where the Complainant is an IGO Complainant, it may show rights in a mark by demonstrating that the identifier which forms the basis for the complaint is used by the IGO Complainant to conduct public activities in accordance with its stated mission (as may be reflected in its treaty, charter, or governing document).”

**Recommendation #2: Cumulative Effect of Recommendations #3, #4, #5 & #6**

If the GNSO Council approves the recommendations set out below in Recommendations #3, #4, #5 and #6, then the EPDP team recommends that the original Recommendation #5 from the IGO-INGO Access to Curative Rights Protections PDP be rejected.

*\*\* A Note from the EPDP team on Recommendations #3, #4, #5 & #6:*

*The EPDP team continues to deliberate on the text and final concept for these Recommendations. While the EPDP team is in general agreement that arbitration is an appropriate solution, it has not yet reached agreement on two specific aspects relevant to such an option (viz., (i) whether the option to arbitrate will remain available to a registrant following the outcome of a court proceeding initiated by the registrant where the court declined to exercise jurisdiction in the matter, and (ii) what should be the applicable choice of law for any arbitration that the parties may agree to). As such, the text that follows reflects proposals submitted by EPDP team members on these specific issues, as indicated by the square brackets around the relevant proposals and their text:*

* *For two options in relation to arbitration following a UDRP proceeding, see Recommendation #4(v);*
* *For two options in relation to arbitration following a URS proceeding, see Recommendation #5(iii);*
* *For two options and a possible additional step in relation to the applicable law in an arbitration proceeding, see Recommendation #6(i) and #6(ii); and*
* *For possible additional text under consideration relating to the parties’ ability to present a complete case in an arbitration proceeding, see Recommendation #6(iii).*

**Recommendation #3: Exemption from Agreement to Submit to Mutual Jurisdiction for IGO Complainants**

1. **In relation to the UDRP**: The EPDP team recommends that an IGO Complainant (as defined under Recommendation #1, above) be exempt from the requirement to state that it 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”[[2]](#footnote-2).
2. **In relation to the URS:** The EPDP team recommends that an IGO Complainant (as defined under Recommendation #1, above) be exempt from the requirement to state 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”[[3]](#footnote-3).

**Recommendation #4: Arbitral Review following a UDRP Proceeding**
The EPDP team recommends that the following provisions be added to the UDRP to accommodate the possibility of binding arbitration to review an initial panel decision issued under the UDRP:

1. When submitting its complaint, an IGO Complainant shall also indicate whether it agrees that final determination of the outcome of the UDRP proceeding shall be through binding arbitration, in the event that the registrant also agrees to binding arbitration.
2. In communicating a UDRP panel decision to the parties where the complainant is an IGO Complainant, the UDRP provider shall also request that the registrant indicate whether it agrees that any review of the panel determination will be conducted via binding arbitration. The request shall include information regarding the applicable arbitral rules. The arbitral rules shall be determined by the Implementation Review Team which, in making its determination, shall consider existing arbitral rules such as those of the International Centre for Dispute Resolution (ICDR)[[4]](#footnote-4), the World Intellectual Property Organization (WIPO)[[5]](#footnote-5), the United Nations Commission for International Trade Law (UNCITRAL)[[6]](#footnote-6) and the Permanent Court of Arbitration (PCA)[[7]](#footnote-7).
3. As provided in Paragraph 4(k) of the UDRP, the relevant registrar shall wait ten (10) business days (as observed in the location of its principal office) before implementing a UDRP panel decision rendered in the IGO Complainant’s favor, and will stay implementation if, within that period, it receives official documentation that the registrant has submitted a request for or notice of arbitration[[8]](#footnote-8), as described further below.
4. If it receives a request for or notice of arbitration, the registrar shall continue to stay implementation of the UDRP panel decision until it receives official documentation concerning the outcome of an arbitration or other satisfactory evidence of a settlement or other final resolution of the dispute.
5. *Note: The square bracketed text below describes two alternatives under consideration by the EPDP team, as to whether the option to arbitrate will remain available to the registrant after it initiates court proceedings against an IGO that has prevailed in the UDRP proceeding and the court declines to hear the case on its merits:*

[**OPTION 1**:

Where the registrant initiates court proceedings and the result is that the court is unable to proceed, the original UDRP decision will be implemented by the relevant registrar within ten (10) business days from the court order declining to hear the merits of the case.]

[**OPTION 2**[[9]](#footnote-9):

Where the registrant initiates court proceedings and the result is that the court is unable to proceed, the registrant may submit the dispute to binding arbitration within ten (10) business days from the court order declining to hear the merits of the case, by submitting a request for or notice of arbitration to the competent arbitral institution with a copy to the relevant registrar, UDRP provider and the IGO Complainant. If the registrant does not submit a request for or notice of arbitration to the competent arbitral institution (with a copy to the registrar, UDRP provider and the IGO Complainant) within ten (10) business days from the court order declining to hear the merits of the case, the original UDRP decision will be implemented by the registrar.]

*Note: With respect to these two options under consideration, IGO members of the EPDP team have provided the following illustrative high-level potential court flow chart to explain the difference – in terms of added time and cost and legal uncertainty – when arbitration is not the direct path for review of a UDRP or URS decision:*



1. The Registrar shall continue to maintain the Lock on the disputed domain name during the pendency of any judicial proceedings and/or arbitration, as applicable.

**Recommendation #5: Arbitral Review following a URS Proceeding**

The EPDP team recommends that the following provisions be added to the URS to accommodate the possibility of binding arbitration to review a Determination made under the URS:

1. When submitting its complaint, an IGO Complainant shall also indicate whether it agrees that final determination of the outcome of the URS proceeding shall be through binding arbitration, in the event that the registrant also agrees to binding arbitration.
2. In communicating a URS Determination to the parties where the complainant is an IGO Complainant, the URS provider shall also request that the registrant indicate whether it agrees that any review of the URS Determination will be conducted via binding arbitration. The request shall include information regarding the applicable arbitral rules. The arbitral rules shall be determined by the Implementation Review Team which, in making its determination, shall consider existing arbitral rules such as those of the International Centre for Dispute Resolution (ICDR)[[10]](#footnote-10), the World Intellectual Property Organization (WIPO)[[11]](#footnote-11), the United Nations Commission for International Trade Law (UNCITRAL)[[12]](#footnote-12) and the Permanent Court of Arbitration (PCA)[[13]](#footnote-13).
3. *Note: The square bracketed text below describes two alternatives under consideration by the EPDP team, as to whether the option to arbitrate will remain available to the registrant after it initiates court proceedings against an IGO that has prevailed in the URS proceeding and the court declines to hear the case on its merits:*

[**OPTION 1:**

Where the registrant initiates court proceedings and the result is that the court is unable to proceed, the relevant domain name(s) will remain suspended in accordance with the URS Determination. The registrant will not have the option to proceed to arbitration at this stage.]

[**OPTION 2:**

Where the registrant initiates court proceedings and the result is that the court is unable to proceed, the registrant may submit the dispute to binding arbitration within ten (10) business days from the court order declining to hear the merits of the case, by submitting a request for or notice of arbitration[[14]](#footnote-14) to the competent arbitral institution, with a copy to the URS provider and IGO Complainant.]

1. Where a registrant that has lost in a URS proceeding files an appeal under URS Section 12 and does not prevail in the appeal, it may submit the dispute to binding arbitration within ten (10) business days from the date of the appeal panel’s decision, by submitting a request for or notice of arbitration to the competent arbitral institution, with a copy to the URS provider and the IGO Complainant. The relevant domain name(s) will remain suspended throughout the pendency of any such arbitration proceeding.

**Recommendation #6: Applicable Law in an Arbitration Proceeding**

1. Any arbitration will be conducted in accordance with the law as mutually agreed to by the parties.

*Note: The square bracketed text below describes two alternatives under consideration by the EPDP team, to apply in situations where the parties cannot agree on the applicable law:*

**[OPTION 1:** Where the parties cannot reach mutual agreement, the arbitration will be conducted in accordance with the law of the relevant registrar’s principal office or where the respondent is resident at the election of the IGO Complainant.]

**[OPTION 2**: Where the parties cannot reach mutual agreement, the arbitral tribunal shall determine the applicable law.]

1. [**POSSIBLE ADDITIONAL STEP UNDER CONSIDERATION**: If either party raises concerns to the arbitral tribunal about applying the law of the registrar’s principal office or the respondent’s place of residence, e.g., because it does not have a satisfactory cause of action related to the parties’ dispute, the arbitral tribunal may request submissions from the parties as to the suggested applicable law or principles of law (which may include UDRP case precedent) to be applied.]

*(Note: With respect to the bracketed text immediately above, some members of the EPDP team have raised concerns that some jurisdictions may not have a substantive cause of action for the parties to invoke. However, other members of the EPDP team have noted that this concern may arise for all UDRP complainants; as such, it will be more appropriate to address this topic as part a general review of the UDRP.)*

1. In addition, the following non-exhaustive general principles (to be further developed by the expected Implementation Review Team) shall govern all arbitral proceedings conducted through this process:
	1. The arbitration shall be conducted as a de novo review; i.e., the parties are permitted to restate their case completely anew, including making new factual and legal arguments and submit new evidence;
	2. The parties may select more than one arbitrator;
	3. The arbitrator(s) must be neutral and independent, and cannot be the panelist(s) who rendered the initial UDRP or URS decision; and
	4. Both parties should be able to present their case in a complete manner.

*Note: The EPDP team continues to discuss whether specific requirements should be included in this policy recommendation. Some EPDP team members believe it is important to include requirements to ensure that an arbitration proceeding will provide the same procedural protections as would have been provided through a court review of the merits of the case; other members believe that these details are more appropriate for the expected IRT to develop, as part of its consideration of the arbitral rules to be applied. The EPDP team is currently discussing whether the following additional text should be included:*

[For example, and within the framework of the applicable arbitral rules, the parties should be able to provide additional written submissions and call witnesses, and hearings (which may be conducted online) should be permitted.]

1. A visual depiction of the United Nations system is available here, including its Specialized Agencies and various programs: <https://www.un.org/en/pdfs/un_system_chart.pdf>. [↑](#footnote-ref-1)
2. See Section 3(b)(xii) of the UDRP Rules. <https://www.icann.org/resources/pages/udrp-rules-2015-03-11-en>. [↑](#footnote-ref-2)
3. See Section 3(b)(ix) of the URS Rules. <https://newgtlds.icann.org/en/applicants/urs/rules-28jun13-en.pdf>. [↑](#footnote-ref-3)
4. See <https://www.icdr.org/rules_forms_fees>. [↑](#footnote-ref-4)
5. See <https://www.wipo.int/amc/en/arbitration/rules/index.html>. [↑](#footnote-ref-5)
6. See <https://uncitral.un.org/en/texts/arbitration/contractualtexts/arbitration>. [↑](#footnote-ref-6)
7. See <https://pca-cpa.org/en/services/arbitration-services/pca-arbitration-rules-2012/>. [↑](#footnote-ref-7)
8. The EPDP team is using the terms “notice of arbitration” and “request for arbitration” as the former is the term used by UNCITRAL while the latter is used for proceedings at the ICC and WIPO. [↑](#footnote-ref-8)
9. If approved and implemented, Option 2 will preserve the registrant’s ability to agree to binding arbitration throughout the duration of any judicial proceedings that it may file prior to such agreement. Under Option 1, the registrant may only elect to pursue either judicial proceedings or binding arbitration within the ten (10) day period following the relevant registrar’s notification of the outcome of the initial UDRP decision. [↑](#footnote-ref-9)
10. See <https://www.icdr.org/rules_forms_fees>. [↑](#footnote-ref-10)
11. See <https://www.wipo.int/amc/en/arbitration/rules/index.html>. [↑](#footnote-ref-11)
12. See <https://uncitral.un.org/en/texts/arbitration/contractualtexts/arbitration>. [↑](#footnote-ref-12)
13. See <https://pca-cpa.org/en/services/arbitration-services/pca-arbitration-rules-2012/>. [↑](#footnote-ref-13)
14. The EPDP team is using the terms “notice of arbitration” and “request for arbitration” as the former is the term used by UNCITRAL while the latter is used for proceedings at the ICC and WIPO.] [↑](#footnote-ref-14)