

**ICANN
Transcription
IGO-INGO Curative Rights Protection PDP WG Meeting
Thursday, 28 July 2016 at 16:00 UTC**

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Attendees:

David Maher – PIR
Gary Campbell - GAC
George Kirikos – Individual
Holly Lance – IPC
Jim Bikoff - IPC
Lori Schulman - IPC
Mason Cole - RySG
Paul Tattersfield - Individual
Petter Rindforth - IPC
Phil Corwin - BC

Apologies:

None

ICANN staff:

Steve Chan
Berry Cobb
Mary Wong
Emily Barabas
Terri Agnew
Michelle DeSmyter

Coordinator: The recordings have started.

Michelle DeSmyter: Great, thank you. Good morning, good afternoon, good evening.

Welcome to the IGO INGO Curative Rights Protection Working Group call on the 28th of July at 1600 UTC. On the call today we do have George Kirikos, David Maher, Petter Rindforth, Philip Corwin, Jim Bikoff, Paul Tattersfield and Mason Cole.

We have no apologies. From staff we have Mary Wong, Berry Cobb, Steve Chan, Emily Barabas, and myself Michelle DeSmyter. I would like to remind you all to please state your name before speaking for transcription purposes. I'd like to turn the call over to you, Petter.

Petter Rindforth: Thanks. Petter here, as stated. Okay, any updates on statements of interest? I see no hands up so let's proceed to our main point of the agenda today to continue our discussion on policy options. And where I – thanks, a lot, Mary and the staff, for putting together these notes that you see on the screen with background and policy options and summarizing and also some questions to deal with.

And this is based on what we have discussed previously and especially on our last working group call. And also note that it's not intended to replace something but it's a good – very good base for our continuing discussion.

So I give it a quick – going through it – a quick – the background. As from last week several policy options have been identified and we agreed to discuss all the options before deciding on whether to amend or tweak the UDRP and/or the URS. Well, there was some support as a result of the straw poll we had on that meeting amongst working group members for either amending or tweaking the UDRP and/or the URS. There was no support for creating a new and separate dispute resolution procedure.

And I would like to state that it was done during the call so you haven't got any response from all working group members. And I'll come up with – or

follow up with that later on. So several working group members also supported not changing the policies and procedures at all.

And the working group members also recognized the possible implications of there being a resolution of the outstanding issue concerning IGO acronym protections as a result of the ongoing discussions between the GNSO Council, GAC and ICANN Board. And at least last week it was not clear what the timeline or result of that discussion will be.

And I presume that you have no updates on this compared to our call last week, Mary.

Mary Wong: Hi, Petter, everybody. This is Mary from staff. We, as staff, have not received any further updates.

Petter Rindforth: Okay. That's what I thought. So, yes, thanks, first. So the working group will aim to complete its preliminary recommendations for publication in its initial report for public comment before ICANN 57. A draft outline will be produced for the working group to review before the full text on the draft initial report is developed.

And what we have identified – there are some policy options, one is, of course, no change to mutual jurisdiction clause in current procedures, but add ability for IGO to assign its rights to another party. But note attendant risk of assignment being ineffective. That's the one option.

Another one is amend the current procedures by adding an arbitral appeal mechanism for IGO domain disputes. The third one is to change to mutual jurisdiction clause in current procedures but add ability only for particular IGOs to opt for arbitral appeal instead. Most likely the UN and its specialized agencies as the UN has also very specific and clear regulations when it comes to this compared to some of the other organizations.

And 2.1, provide mutual jurisdiction clause. And here is one example, in the event the action depends on the adjudication of the rights of an IGO that would but for the mutual jurisdiction provision, be entitled to immunity from such judicial process according to the law applicable in that jurisdiction as established decision of a court in that jurisdiction. The challenge must be submitted instead for determination by United Nations Commission on International Trade Law in according with its rules.

And as you may know, the UNCITRA also have a model of international commercial arbitration that's from – been on the spot for some years since 1985 and amended 2006. And then finally, no change to mutual jurisdiction clause in current procedures but clarify that standing to file for IGOs must be that the requisite notification to WIPO being made pursuant to Article 6ter of the Paris Convention.

Also notes, need to further discuss the substantive grounds in this case, which is a different issue than immunity. And also when it comes to – I mean, we – I think we have decided, so to say, within our working group that we used identification of the Article 6ter of the Paris Convention but also note that later on today there will be a meeting with the IGO INGO Identifiers Protection IRT meeting. And in those documents the international governmental organizations are identified by the names that listed in the GAC IGO list, that is – I think it's from currently now from March 2013 but will soon be updated and available in October.

And so we're coming to the discussion on the basic issue would an arbitral appeal process be an effective and fair alternative to their ability to file in national court? And consideration, I see a substantial number of UDRP decisions are overturned by subsequent adjudication, so when it changes, proposed cannot leave the responded winner with additional avenue of redress.

I'm a little bit surprised to see that there is substantial number of UDRP decisions, I thought it was not so common but it's interesting to see that that's a fact.

And the working group may need to consider if changing immunity rules for IGOs in the UDRP URS would have ramifications elsewhere. And there is a reference to the working group dealing with the review of all rights protection mechanisms, they also deal with the trademark post delegation dispute resolution procedure.

And it was up for discussion yesterday. I don't remember any specific thing on that topic that related to what we discuss here. Although we discussed some additional notes on medication as a start of these kind of procedure. But on the other hand, it's hard to refer to this special post delegation dispute resolution procedure because there is no cases so far.

And working group may need to consider if changing immunity rules for IGOs would have ramifications elsewhere. Oh, yes that was that I thought. Approval of likely cases are probably very small. What really are the likely harms of providing some sort of avenue of administrative appeal? And some of the domain names are extremely valuable unless we get rid of the UDRP, why would the registrant agree to give up rights to seek protection in the national court in favor of binding arbitrations or other judicial process.

And there's some suggestions here to consider a tweak to the procedures rather than replacing rights of appeal to a national court. If (unintelligible) IGOs is brought to court by the losing respondent, allow for the result of the IGOs successfully waiving a claim of immunity in that court to be notification of the UDRP decision.

And an additional question there, what would this preclude the IGO from then responding to file a claim against a respondent in court itself? And then would it be better to create a policy guidance framework, for example, to clarify

issues relating to standing ability to file through an agent assignment, etcetera, rather than change the underlying policy.

But notes that a guidance document would not be enough to address the trademark rights substantive basis for the UDRP URS. This may require actually amending of the policy procedure.

So I've seen that George, you have made some comments on the chat. But also you – you also sent out after last week's meeting interesting references to some of the disputes related to the UDRP. So I don't know if you've prepared to that but I think it would be – if you could just make some comments, updates on that. You're free, George.

George Kirikos: George Kirikos for the transcript. Can you hear me okay?

Petter Rindforth: Yes, we can.

George Kirikos: Yes, I think - well the emails basically speak for themselves to just reinforce the view of, you know, additional evidence that we are seeing more and more court cases challenging the UDRPs as more complainants, perhaps, overreach in terms of bringing UDRP actions on very valuable domain names or they don't have rights but where the panelists are perhaps more liberal in interpreting the UDRP than the courts would.

So I brought those attention – some of those cases to the attention of the working group. And noted that WIPO themselves haven't been updating their Website in terms of the challenged UDRPs which is, well, I won't comment on it but it's kind of obvious perhaps why they might not be posting it.

The other thing I noted in the chat room was that for suggestion Number 1, well the notification, I just wanted to – I don't agree with that. Like I'm in the status quo camp myself, but if we were going to consider suggestion Number 1 we might want to modify it that the nullification should take place regardless

of when the lawsuit is filed because the lawsuit could be filed in national court at any time, not just at the – not just after the panel has made a decision that it could be filed immediately like during the UDRP case itself before a final decision had been rendered by the panel.

Petter Rindforth: Thanks. Before I leave it to Phil, I also see Mary's comments on the chat room that options A-D are more fully detailed in Professor Swaine's legal memo that you all have received and we have gone through the two meetings before this. And Option E brings us back to the standing issue Phil provided clarification last week but this too is an option to consider.

And then Mary also had follow question with you this – but this would be a case filed by the losing respondent. Right. And he also says, Mary, it would be filed in the UDRP before the panel has deemed the respondent a loser.

Okay, that's so from the chat room. Phil, go ahead.

Phil Corwin: Thank you, Petter. Phil Corwin for the record. Want to do two things here. First on whether in regard to permitting an IGO to file through a third party agent, if they feel that is necessary to immunize themselves on the sovereign immunity question and on clarifying that Article 6ter, a successful assertion of Article 6ter rights will suffice for meeting the trademark requirement in the absence of trademark registration of the mark in question.

I don't think – I think we need to look carefully at the language of the UDRP. If those goals can be achieved by guidance to the providers that's fine. But if we just look at the language and say, no, that's insufficient, we need to actually suggest a revision to the UDRP, which could be in the form of either going directly into the rules and adding clauses on this inserting language into the existing language or adding a, you know, new section which says special rules for IGOs and would have two parts, one, you can bring it through an agent, that's okay, it doesn't have to be the rights holder bringing the action.

And, two, even if the mark hasn't been trademarked if you've asserted Article 6ter rights with WIPO that's sufficient for standing. I don't think we should be – have a hard stance against amending it, I don't see any damage. I think it should be based on whether that's required when we look at the existing language to the UDRP.

On the – and what I'm going to say now, I'm not advocating anything, I'm simply playing devil's advocate and thinking things through. And hoping that this clarifies the decisions before us. On whether there should be a separate arbitration mechanism. And my starting point, my personal viewpoint, is that we don't, and there's no consensus in this group to create a separate CRP for IGOs.

You've got two potential appeal situations. One would be where the IGO brings a UDRP against a registrant, IGO wins the UDRP, registrant is unhappy with the decision, believes it can be overturned on appeal to a court of mutual jurisdiction. And brings that court action, within the required time period, and then the IGO comes in and the IGO, rather than consenting to the action, asserts that it has sovereign immunity and shouldn't be in a courtroom.

And I think that's the proper way to resolve the sovereign immunity issue. I don't think we can – I think we've seen from Swaine's memo, there is no blanket global rule; it's something that's going to be decided in individual jurisdictions by the courts as to whether this type of action is entitled to sovereign immunity.

So two things can happen then. IGO asserts its sovereign immunity, the court can say no, this is not a core issue. The scope of your immunity has limits. This is not a core activity, it's a commercial right and you need to defend it here or perhaps you're going to lose by default if you refuse to participate.

That's fine. But what if the court says you're right, you shouldn't be in here. You have immunity. Where does that leave the registrant? Now George has proposed, and this has merit and should be considered, that in that situation it should go back to the status quo ante and be as if the UDRP never happened. But we can imagine the IGOs will say, well, that makes the UDRP even more useless because if we successfully assert immunity we've gone through an administrative procedure provided by ICANN and it's nullified and we have no recourse other than waiving our immunity, which the court just agreed on that we shouldn't be in there.

So, you know, the other option is to provide in those specific cases for some – for appeal to an arbitration forum. I don't know which one it should be. I'm a little concerned about UNCITRAL, about an UN agency deciding cases for other UN agencies and other IGOs. But I think that's the decision tree.

On the other hand, we go in here and – and I don't know how to handle this one – IGO brings the UDRP, IGO loses, IGO still believes that its rights are being infringed, but doesn't want to appeal to a court. They can't go – to go into a court – I don't see any way an IGO can go into a court and then assert we're only here to get a determination by you that we shouldn't be in here because we're immune and shouldn't be covered by this mutual jurisdiction clause. I don't know if that's a practical option.

So, you know, that's where the IGO loses. Do we force them to essentially – that would be a coerced waiver of immunity. But on the other hand, the UDRP is providing them with an avenue they wouldn't have in its absence where their only option would be to go to court in the first place or should the arbitration forum be effective, be available to IGOs that have lost on the UDRP and want to appeal but feel that they have immune rights and don't want to be put in this box of having to waive them to seek a determination that they have immunity.

So I don't know if that's helpful but that's the way I'm thinking about it. And I think those are the only two scenarios. And we should discuss each one and whether in the first case there should be if the IGO successfully asserts immunity in the court whether the original UDRP should be nullified or whether then there should be an arbitration option. And I realize arbitration is not quite – dispute resolution option, it's not really arbitration, as George will point out when I stop speaking.

((Crosstalk))

Phil Corwin: And the other one where the IGO fails in its UDRP and wants an appeal but doesn't want to waive immunity to have the appeal. So hope that's helpful. Thank you.

Lori Schulman: Phil, it's Lori. I'm sorry, I'm not on Adobe so I don't have a hand.

Phil Corwin: Okay.

Lori Schulman: I just have one question about UNICTRAL. In the documentation that as submitted by any of the IGOs, do we know statistically – do we have like a rate of favorability decision for or against UN agencies in those disputes? I think that would be valuable to have to address your concern. For instance, in the US Patent and Trademark Office when the (prosay) appeals to the TTAB Board, it's overwhelmingly in favor of the government. I think it's like 80%-90% is found in favor of the examiner. So you can see a skew in that ex parte appeal process or (unintelligible) ex parte but singular appeals process.

Do we have any data on UNICTRAL for that? You know, are they doing 80% in favor of their agencies? Or are they coming out 50%-50%? Like I'm just wondering if the fear that you have could either be reinforced or assuaged with some statistics.

Phil Corwin: Well, yes, Lori, I'll respond and then I'll let Petter take the call back over. One, I think just the optics are questionable of having a UN agency decide appeals that will primarily be – involve other UN agencies. There may be just a perception, a bias. I don't know if we have those statistics or whether staff has them or can obtain them.

I think if we decide that arbitration in either case should be an available option, and again, a dispute resolution provider rather than a court, let me stop saying arbitration, a DRP provider, then we need to look at that and decide which one would be suitable, whether UNICTRAL either through appearance or practice seems to be biased and we want someone else to be available. So I'll defer to staff on that question. And that's all I have to say. Thanks.

Petter Rindforth: Thanks. Mary.

Mary Wong: Thanks, Petter. I had another comment but let me just follow up on Lori's question first. So the quick answer, Lori, is that at this point, staff does not have any data or any information about the rates that you asked about. I will add that I am not sure if or how we can obtain those because – and I understood that the UNICTRAL appellate mechanism we're talking about is the UNCITRAL rules, which could be, and in many cases are, adopted by contractual parties including IGOs. So I'm not sure that there is any way, indeed, to have any reliable way to track how many uses there have been and what their success rates or otherwise were. We can try but I'm not overly hopeful.

Then, the comment that I had previously was to follow up to Phil's comments about the two scenarios, which Phil, I think that that's exactly how we've been trying to look at these options. The point that staff wanted to make here is that in terms of going about an arbitral appeal or any other form of alternative mechanism, it seems to us that some of these options, A-E, are not mutually

exclusive. That may be a very obvious point to everybody but I wanted to make it for the record.

So for example, if there is to be some kind of exceptional mechanism created, say, for the UN, perhaps also for a specialized agencies, that does not preclude an IGO from assigning its rights to another party and therefore avoiding the immunity issue in a different case. So I just wanted to make that clear. Thanks, Petter. Thanks, everyone.

Petter Rindforth: Thanks, Mary. Petter here. Just a comment on I think that we still have the possibility to at least suggest to keep this – the regulations as they are. And to make comments on or references to the guidance rather on Paris Convention as being identified also or treated like trademarks.

And when it comes to the representatives, in fact, when it comes – looking at the UDRP the paragraph 4a of the policy, requires that the complainant can (unintelligible) that the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights. But these words do not require the complainant to be the owner of the trademark. And they've been accepted in several decisions that, for instance, a company related that the subsidiary or parent to the register holder or – have license agreement. So it may be that the text as it is today, the complainant has rights. Also can, if we add that to the guidance that be some kind of agreement within – between the IGO and the representative that actually deals with the disputes.

I might say it's 100% sure it's possible but I see that there's a gray zone and there are more possibilities to amend rather the guidance than the policy as such. And Paul says in the chat room, "I don't believe that 6ter 1a grants exclusive use rather it grants the rights to prevent the registration and use of trademarks, which infringes states mark. So if the UDRP panelist has correctly decided a domain should not be transferred they have probably

done it with good reason and that should be the end of the matter as far as the UDRP case is concerned.”

And, yes, Mary.

Mary Wong: Hi, Petter. Hi, everybody. This is Mary again from staff. I wanted to respond to Phil's question in the chat partly because I think there's folks on the call that are not in Adobe today. And, Phil, your question is whether staff or anyone else in the group believes that the Swaine memo has any conclusions that would compel us to believe that the UN and its specialized agencies have full immunity and therefore should have access to a separate DRP for appeal.

And your view is that unless that is the case, then IGO immunity should be determined by the courts. So from the staff side, our read of the Swaine memo is that at least in terms of the three types of jurisdictional immunity, absolute, functional and restrictive, the UN and its specialized agencies would be those IGOs that are most likely to enjoy absolute immunity.

We would think that this conclusion would then allow the working group to say does that justify us creating some kind of different avenue appeal mechanism or separate DRP for these particular agencies? I don't believe Professor Swaine goes as far as that, so that's probably one topic that the working group could deliberate. And I see that Phil's hand is up, Petter.

Petter Rindforth: Yes, thanks Mary. And sorry, Phil, before I leave it over to you, just a note when it comes to the UN – the organizations, I have – I don't have the regulations in front of me right now but wasn't it so that there was a specific clause there stating that they could actually recently, like from claiming its immunity and then once they've done that as we thought at that time, they would have to rely on the result of the UDRP and follow that session.

Okay, Phil.

Phil Corwin: Yes, thank you Petter. Phil for the record. Yes, Mary, I agree that UN agencies would have the strongest claim to immunity but my read of the Swaine memo is that having the strongest claim is not equivalent to saying they absolutely have full immunity and you must create a separate CRP. I think his memo was pretty clear that we were not legally compelled to take that step that it was a policy issue.

So I think the policy issue for us now is in the scenario where – particularly where an IGO brings a claim of infringement, wins the UDRP, registrant appeals, court of mutual jurisdiction, IGO asserts its immunity in the court, court agrees, it's a UN – the UN itself or UN agency says, yes, you shouldn't be here, you're immune from this national judicial process, where does that leave us?

That would be you've got two less than ideal choices. You can create at that point say, well, the IGO can move for the appeal to go to our designated DRP provider and we haven't decided yet who that should be or if that should be available. And that the registrant has to participate in that DRP or the UDRP will stand which forces the registrant out of their court right, although, you know, they're gone to the court and the court has said, you know, you can't be bringing that IGO in here; it's not allowed in this jurisdiction.

Or you leave the IGO in the position of having won a UDRP, which found infringement, and under George's suggestion, the UDRP would be nullified and the IGO would have no choice unless it, in that scenario, decides to change position and waive immunity, but to let the infringement go on.

So neither choice is ideal. But I think that's what we're looking at. But, again, my position is that even for a UN specialized agency we don't have any legal guidance that we must provide them with immunity up front, you know, that this is really something that's going to be decided by courts if they assert it

and different courts will decide the matter differently depending on the jurisdiction. Thank you.

Petter Rindforth: Thanks, Phil. Petter here. Yes, and I – coming back to Professor Swaine’s report, it’s interesting to see that there was no clear answer to the question on the immunity that depending on the country and the court there could be very different solutions. So that’s why we can’t really solve that in our proposed solution here.

I see Mary had commented on the chat room there is a general convention on privilege and immunities of the UN and another relating to privilege and immunity for the specialized agencies. However, that these treaties are broader than just jurisdictional immunity.

George, your hand is up.

George Kirikos: Yes, George Kirikos for the transcript. I had another idea just on the assignment option that we’ve discussed before, there’s another slight variation that we haven’t discussed that I just thought about during this call, we could consider allowing licensees of trademarks to file a UDRP. They might actually already have that right, I’m not aware of any cases off hand where UDRPs were brought.

But a licensee like there was a concern that IGOs might not want to assign or may not be able to successfully assign their rights but to license their rights is slightly different than to assign a right so that might give them an additional option.

Just to give an example, Toyota might own the Toyota brand but they might license the use of that brand for, say, Toronto Toyota or, you know, like an individual car dealer and so that individual car dealer might bring a UDRP if somebody registers say, torontotoyota.ca or – not ca but dotNet or something, gTLD, instead of waiting for Toyota themselves to bring the

UDRP, you know, the licensee could bring that UDRP. And so that might be another mechanism for IGOs to kind of have that workaround instead of doing assignment to have licensing of their trademark. I just wanted to toss that out as an idea.

Petter Rindforth: Thanks, George. Yes, well I full agree. And there are a lot of – well at least number of cases that has been accepted with licensee as filing the complaint. As I said before, the policy just stating that the complainant has to prove rights but that could be an agreement with the trademark holder to represent or to have the possibility to also deal with the domain disputes. So it's – I would say that's – that possibility is already there today. It's just again, it could be added to the guidance as we also suggested with the Paris Convention part.

Mary.

Mary Wong: Thanks, Petter. So following up on what you said and George's comments and Phil's additional comments in the chat, it seemed to staff that we may need to do some more additional research and analyses on these options. So for example, on the question of Option A, assigning the rights to another party, the difference between that and using an agent to bring a UDRP, there are different legal consequences. And certainly the staff supporting this group are not experts on the effects of legal assignments or using agents to sue.

What I do want to say on that particular point referring back to Professor Swaine's memo though, is that – and this goes to George's point about trademarks and licensees, that part of Professor Swaine's memo seems to contemplate that the IGO would assign all of its rights, such as trademark rights, to a third party such that that third party such that that third party would then have the ability to stand in the IGO's shoes.

And I understand George's suggestion as being some variant of that where it's not a full assignment but is a license, and we don't have to get into

exclusive licenses. The danger, or one danger that Professor Swaine pointed out with this scenario is the risk that an assignment of the trademark's rights without the underlying good will would be ineffective amongst other possible problems.

But the point here is that are we talking about an IGO assigning its full rights, all the substantive legal rights? If so, then that still brings us back to the trademark problem because recalling that our group started with two problems for the IGOs. One is jurisdictional immunity; the other is that under the current procedures they must have a trademark either common law or nationally registered to bring a UDRP in the first place.

So while the assignment mechanism could address the immunity problem to some extent, it would not overcome the trademark problem. That's Number 1. Number 2, we would probably need to explore what we really mean by assignment. Like I said, assignment of the full substantive rights or is it possible to simply appoint or have an agent or assign the right to bring an action?

And that – each of these may or may not be plausible and each of these may have different legal consequences. Sorry to go on so long but I hope that that's clear. Thank you.

Petter Rindforth: Thanks, Mary. Petter here. I don't think that we need to put in real legal assignment, rather that it's more of an identification of someone that can actually claim the rights on behalf of the true owner, so to speak, and also have the domain if they would in the case to be transferred to that representative.

I think rather that than someone that is identified as the owner of the name on the mark. George.

George Kirikos: Sorry, I was muted there. George Kirikos for the transcript. Yes, that's why I think the licensing route might be superior from an IGOs perspective because it's a more limited transfer of rights and it would still be probably sufficient for the licensee to have standing to bring the UDRP and thereby shield the IGO itself from the dispute.

Just to give it another example that's been in the news lately, Facebook is in trouble because some of their intellectual property rights are being held in Ireland and there was – there were questions about whether they assigned a fair value to those intellectual property rights and how they were assigned to different countries.

Like, for example, I don't know if they do it for domain names but they might hold patents or trademarks in Ireland and then charge the US based company a licensing fee or sorry the US-based company would pay a licensing fee to the Irish owner and thereby move their costs back and forth between countries to optimize their taxes. And so I think that's an example where you have the kind of like licensing arrangement that would work for the context of the – a UDRP.

Petter Rindforth: Thanks.

George Kirikos: Mary had a question in the chat. George again. "Would a non-exclusive license be able to bring a complaint? I think that would be sufficient. I think, you know, to go back to that car example, if, you know, if somebody in Toronto had a license for Toyota for the local dealership area, they wouldn't have an exclusive license, it would just be, you know, non-exclusive. Same for like say 7-11 or anybody in the franchise business, they're given like a limited license. But I'll defer to others.

Petter Rindforth: Yes, George, right. Petter here. I agree with that conclusion. I will say I recommend when I right license agreements that for the trademark holder that specifically states in that agreement that it's just the trademark holder

that can file a dispute procedure just to make sure that they have 100% option to make the decisions.

So, yes, if you can prove that you're some kind of – some kind of rights holder or license or when you're of course a parent company and subsidiaries you can actually deal with the trademark in the UDRP process.

Okay. Sorry, going back to the – to the list, yes, Phil, got in the chat room, “Regardless of the current language of the UDRP, at least we can give the – has the authority to recommend that an agent as an e-licensee whichever we choose. And it can be more than one of those categories of an IGO be permitted to have standing to bring an action on its behalf even if nonexclusive so long as IGO authorized the action. We have no control over whether a particular court would allow that entity to participate in an appeal.”

And, yes, I fully agree with that. What I think we all try to do here is to avoid the necessity to make any changes in the procedure as such and keep to the guidance. And I have – I've so far not seen any heavy difficulties in doing that at least these two questions when it comes to the procedure as such.

And also when it comes to the – so to say, second phase when you want to take the case to a court. Obviously, as also we've seen from Professor Swaine's support, it's up to each court to decide whether they can take the case or not.

George, your hand is up.

George Kirikos: George Kirikos for the transcript. I did some research on UDRP search right now, the udrpsearch.com – searching for the term “licensee” and found a useful precedent where the panel remark, I'll just quote from the ruling, which I pasted into the chat room.

“Although a licensee of a trademark or a company related to the registered owner, example, (unintelligible) of a trademark, may have rights in a trademark under the UDRP, evidence of such license and/or authorization should be submitted,” and then it gives an example, “Example, Komatsu Deutschland, GNBH versus (Ali Asman ANS), WIPO case 2009-0107.”

So I think that establishes a precedent that the licensee is sufficient to bring the UDRP. And that, you know, provides a complement to the assignment procedure.

Petter Rindforth: Yes, thanks again. Petter here. I think even on the WIPO's guidance part of the page there is some question on participate or not the true trademark owners if they can start a procedure and there's also some cases refer to that. The majority accept it and there is of course, always couple of decisions that I think would – with the case another way.

But I would say that generally if you have that kind of cooperation and agreement regarding the trademarks, yes, you can represent the trademark holder in the dispute. And as I said before, not just representing it but also claim transfer to you as that kind of representative.

And, yes, George, I see a very long thing in the chat room. Sorry, oops, sorry about that you said. George, is that something you would like to state vocally instead? Please.

George Kirikos: George here. Sorry about that. Actually did a search on the WIPO site and Section 1.0 – sorry, 1.8 of the WIPO overview asks, “Can a trademark licensee or related company to a trademark holder have rights in the trademark of the purpose of filing a UDRP case? Answer 1.8.” And the consensus view is, “In most circumstances a licensee of a trademark or related company,” blah, blah, blah, “is considered to have rights in a trademark under the UDRP.” And then it goes on and on. So actually that reinforces the earlier find that, you know, licensing is an alternate route for

the UDRP to complement assignment. So since licensing is a lot simpler than assignment I think this would help the IGOs.

Petter Rindforth: Thanks. Phil.

Phil Corwin: Yes, Phil here. One – thank you, George, for finding that reference. That's very helpful to the discussion. Second, on both the general question of whether we should be in our report and recommendations just trying to provide guidance to the providers or suggesting actual language, and again, I think we have to look at the actual language of the UDRP and URS first.

On things like this, just because WIPO has this guidance, I think we have to go beyond that in some way because WIPO is not the only provider for the UDRP. And they're not a provider at all for URS. So we have to do something even if it's just to adopt their position that is either recommended or required of all the separate providers. Thank you.

Petter Rindforth: Thanks, Phil. Petter here. Just an additional question to that, you say that we perhaps in that way need to make changes in the policies as such or whatever we call it, guidance or something similar. Can that be used? Because, sorry, but at least personally want to avoid as much as possible to make changes in the policies. And as we all know, there is another working group that will deal with both the dispute resolution policies and there will be, of course, probably some changes in the near future. But I don't see this – our task here to – if we can avoid it – to open that door.

Phil Corwin: Yes, Phil again. Let me speak to that. Yes, as I stated earlier, I think the responsible way to proceed is to, you know, once we reach basic consensus on the questions, put aside the question of whether there should be arbitration – well, a dispute resolution available in any potential scenario as an appeals process, and looking just at the Article 6ter rights conferring standing and use of a licensee or other third party to provide some separation for the IGO and protect its immunity but allow it access to the procedures.

I think we need to look at the actual language of the current UDRP and URS and base our decision there on whether or not it's sufficient to have a report that just makes strong recommendations that we believe the different DRPs should adopt or whether we think it's necessary to assure the IGOs of that standing and of that ability to use a third party to bring the action, whether it's necessary to insert very surgically without changing anything else about either procedure just those very narrow questions.

I don't – being one of the three cochairs of the other working group that's looking at all the RPM issues, I don't personally perceive any trespass that would occur. This working group has been set up to address very narrow questions, not the big questions that working group is looking at. As to what I – as to what ICANN will do, you know, we're going to have a process here where we hope by mid-fall to put out an initial report and recommendations for public comment. Then based on the comment to go to a final report that we send to the GNSO Council hopefully before the end of the year.

It'll be then up to Council and then the Board, two things, one, whether it adopt all or part of our recommendations and, two, whether to implement them in the near term or to hold any implementation until the big RPM working group completes its work, which will be the end of next year for the new TLD rights protection mechanisms and not until I'm guessing late 2019 or maybe 2020 for the UDRP portion.

So that's not our decision. I think we should just do what we have been assigned to do under our charter and the most responsible way and proceed. Thank you.

Petter Rindforth: Thanks. Okay, we have one minute left and I thank you for participating here with – your active comments and so at the same time, we note that we are 31 members on our working group and eight observers. And it was – will be

good to have more inputs also from the other members on these questions and topics.

So what we have discussed with the staff is to – you got the memo or the paper late today. And I would suggest that we – that we go further and get your comments from the full working group on the options A-E and to have views on the basic issues outlined for the (unintelligible) option and also to have feedback on two suggestions that was made at the end of the document.

And, sorry, Mary, please go ahead.

Mary Wong: Not at all, Petter, so actually you and Phil did say quite a lot of what staff wanted to put on the record. Going back to Phil's point, that when we release our initial report it will be for public comment and at that point obviously we can also reach out specifically to those parties that may be most helpful for some of the recommendations such as the UDRP and the URS providers.

And as Phil notes, when we then come to the final report, which may or may not contain changed recommendations based on the feedback that we get to the initial report, the Council may accept those recommendations but decide to hold off acting on some or all of them in fact.

And to your point, Petter, staff will work with you and Phil to try and update this document but we can also recirculate it for further comment particularly by members who have not been as active recently. And on that score we did have a question and we wonder if it would be helpful to the working group to dive a little deeper into what the UNCITRAL rules might be.

To that extent we can send them around because we haven't really discussed what that kind of alternative avenue might look like. And our understanding is that those rules are procedural and that they aren't binding to a particular arbitration institution unlike some other international rules. So it

may be of interest to the group to at least take a look at what those rules look like. Thanks.

Petter Rindforth: Thanks, Mary. I see no other hands up but I think – I'm talking to the full group and I agree with your suggestion. So please, go ahead with that. And then once again, thanks for very good and interesting discussion for today. And we – Mary has the document also that we can look at during the week and we'll have a follow up discussion next week on this. So thanks for today.

Michelle DeSmyter: Thank you. This call has been adjourned.

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