ICANN Transcription

IGO Work Track

Monday, 10 May 2021 at 15:00 UTC

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TERRI AGNEW: Good morning, good afternoon, and good evening. Welcome to the IGO Work Track call taking place on the 10th of May 2021 at 15:00 UTC.

In the interest of time, there will be no roll call. Attendance will be taken by the Zoom room. If you're only on the telephone, could you please identify yourselves now? Hearing no one, we do have listed apologies—oh, actually, you know what, Brian joined so we don't have any official listed apologies today. Thank you, everyone.

All members and alternates will be promoted to panelist for today's meeting. Members and alternates replacing members, when using chat, please select "all panelists and attendees" in

order for everyone to see your chat. Attendees will not have chat access, only view to the chat. Alternates not replacing a member are required to rename their lines by adding three Zs at the beginning of your name and at the end, in parentheses, the word alternate, which means you were automatically pushed to the end of the queue.

To remain in Zoom, hover over your name and click rename. Alternates are not allowed to engage in chat, apart from private chat, or use any other Zoom room functionality such as raising hands agreeing or disagreeing. As a reminder, the alternate assignment form must be formalized by the way of the Google link. The link's available in all meeting invites towards the bottom.

Statements of Interest must be kept up-to-date. If anyone has any updates, please raise your hand or speak up now. Seeing or hearing no one, if you do need assistance with your Statement of Interest, please e-mail the GNSO Secretariat. All documentation and information can be found on the IGO Work Track wiki space.

Recordings will be posted on the public wiki space shortly after the end of the call. Please remember to state your name before speaking. As a reminder, those who take part in ICANN multi-stakeholder process are to comply with the Expected Standards of Behavior. Thank you. And with this, I'll turn it back over to our chair, Chris Disspain. Please begin.

CHRIS DISSPAIN: Thank you, Terri. Good morning, good afternoon, good evening, everybody, and welcome. Today our main topic of conversation is

eligibility to use the UDRP. But before we do that, I'm going to hand it over to Berry who just wants to talk to us briefly about some logistical stuff. Berry?

BERRY COBB: Thank you, Chris. For the whole group, you'll notice last week I sent out our April version of the work track's project package. First and foremost, thank you to Justine that picked up an error that I had based on a template we've used. I've since corrected that error.

Really, the next step for this … This is a monthly cadence that we'll go through to wrap up each month. And after a few days of review by the work track, then we'll pass it over to the GNSO Council to provide them an update. So absent any strong objections here on the call, I will be sending this to the Council later today.

I'll just note that, again, the key takeaways here is that we've committed to the end of July to submit an initial report. And assuming we make it that far and going through a public comment, then we have until mid November to submit a final report.

The other takeaway here on this particular summary timeline is that we owe the Council a specific update at its meeting next week on the 20th, which kind of centers around some of the discussions about scope limitations with the current addendum and whether the group can continue its work as is or perhaps seek some

adjustments or at least some consultation with the Council that, I believe, Chris will talk to a little bit more.

Absent of that, as I've noted before on reviewing this in previous iterations, the second page, which is what we call the situation report, contains much more details as about what we're working on, what we're going to be working on, and what we've accomplished. The primary component or rationale for doing this is to show that we are making progress from one month to the next.

What is new to this version is that we're also including not a real time but the latest print of who's participating on this working group, as well as attendance percentages and some high level stats that we're starting to track from one group to the next, which includes just cursory statistics as to how much activity is going on with the group such as the number of e-mails, number of meetings that we're doing from one period to the next, total hours consumed, at least from a meeting calls perspective, and the number of action items and milestones that we complete over time.

The scary eye chart that I expect none of you to work, but this is the foundation that allows me to track the progress to the dates that we've committed to our primary deliverables of the initial report and final report. And then lastly, just kind of a detailed view of what our work plan looks like, which is meant to be a more tactical work product to show that we've got a number of meetings ahead of us, what are some of the key milestones that we want to hit, as well as any action items that we're assigning out to the

team. So that's all that I have for now. I'll turn it back to you, Chris. Thanks.

CHRIS DISSPAIN: Thanks, Berry. So as everybody knows, I hope, by now, on the 20th of this month of May, there is another Council call and we've agreed in the past that by then we would expect to be able to go to the Council to give them a real update of where we've got to. And that is also the date that we said if we decided we felt we needed to go and ask scope expansion or clarity or whatever, we would try and do that. So that gives us today and next Monday—really next Monday is pushing right up against the line because that's the 17th—to figure out where we're at and what we should be doing.

I've already acknowledged for the stuff that you sent through last week, Paul. We're going to get to that in a minute. I just want to say thank you to Alexandra for her comments, which I think Berry has included in the document, Brian, for your contribution which we'll get to, and Kavouss, who's not currently on the call, has also sent a couple of points through.

If I could just have my really simple document on the screen, that would be helpful. Thank you. I sent this simply because I wanted to try to make a clear distinction and try and keep it as simple as possible. Because, in essence, you can wrap it up in all sorts of complicated legalese if you want to, but at the end of the day, at least in my understanding, what we are talking about is, at this level, two specific differences.

The first difference between the current trademark-based UDRP process and a process that we're discussing in respect for NGOs, whether it's a parallel process or addition to the current process, it doesn't make any difference. The first difference is that whereas for the current UDRP complainant is required to specify the trademark or service mark, what we're talking about is that where the complainant is an IGO, and they specify that they are an IGO, and that the acronym that they are complaining about is on—what we've talked about, either on the GAC list, or on 6ter, or on some other agreed criteria. That's the first thing that is different.

And then the second thing at this level is when you get into the complaint, as for the current UDRP, the name is identical or confusingly similar to the trademark or service mark. And in the case of an IGO-specific process, it would be the name is identical or confusingly similar to the acronym. And everything else remains the same in respect to legitimate interests, registered in bad faith, and all that stuff. So, being very, very specific about those two things that would be specific to an IGO process.

Before I go on, does anybody disagree that that is what we are talking about? I don't care whether you think it's feasible or not. I just want to make sure that everyone accepts that that is, in essence, what we're talking about at this level, at this particular part of the process. We've got other things to talk about in respect to arbitration and all of that, but at this particular part of the process, that is what we're talking about. Anybody disagree? Okay, so nobody disagrees. Excellent. I just want to stress that we've also got the major jurisdiction matter which we were nutting out last week, and I'm not suggesting it has to be dealt with. I'm

just putting that to one side for a minute because at the moment we're talking about the eligibility criteria.

So that said and if that's accepted for now, if we could go back, if we could bring up Paul's. Yes, Jeff, I agree with you. That's a detail but I agree that's similar to the name or the acronym.

Let's call up the other document. Thank you. I've got another copy of it. It's quite hard to see on that screen. Let me set this up this way. It's pretty clear from Paul's notes—and, Paul, if I'm in any way not being accurate in what I'm saying, I know you will anyway, but please holler and put your hand up. It's pretty clear from Paul's notes that Paul believes that what we're talking about is not merely a tweak. He's described it in a couple of places as major surgery and that it is not something that he is comfortable to accept.

I think I can say pretty much for sure that again, in simplistic terms, Jay would take much the same view. The nuances may be different but the fundamentals would be the same. I don't know if anybody else on this group, either on the wider group, the people who are not actually on this call, or the people who are on this call, who sit in the same position.

In circumstances where we were proceeding along a clear path and we had this disagreement, it might be possible for us to say to Paul and to Jay—and again I'm using really as an example here—"Look, we appreciate that you don't agree but you are in a minority and the rest of us agree and we should proceed to discuss it in some in some detail." For me, the challenge in doing that is that we're not just talking about a disagreement on a process. We're

talking about a disagreement on a much higher level, where I think it would be fair to say that Paul and Jay believe that this is outside of the scope and is not something that this work track should be doing.

So I want us to have the discussion today, I want us to talk about what Alexandra has said. I want us to talk about Paul's position and so on. But I want us to be cognizant of the fact that if we can't agree as a group that we can put this forward as a tweak of the process, then I think we really have no choice but to go to the Council and say, "We believe we may be able to come to some sort of consensus agreement but there is no consensus as to whether we would be in scope to do that," and we should therefore ask the Council for their input on that matter. I'm not saying those are the right words to use. We need to figure out how to finesse it properly, but fundamentally I think that's where we stand.

I'm happy that anyone to disagree with me. I'm happy for anyone who's taken on from a different point of view. But absent some sort of coming together, really, in this call and possibly if we see some progress next Monday, whilst I think the majority of us may well be able to coalesce around a possible way forward, I'm struggling to see how we can do that where we have a major disagreement about whether this is in scope or not. I wanted to start by saying that and I'm happy to discuss it, I'm happy just to leave it in the air and see where we get to today for those who would like to talk about it. Paul, go ahead.

PAUL MCGRADY: Just in response, a few things. I think one thing to keep in mind with this is a representative EPDP-ish environment. I don't know exactly what a work track is but this isn't one where it's open to all individuals. And ultimately, Jay and I have to go back to our constituencies and get their support. So it's not, I could say, a 100-participant EDP where there are two voices out of it. So we should keep that in mind if we want to ultimately get to consensus.

The second thing … I don't mean to contradict you. I'm not saying we can't get there within the four corners of the UDRP. What I'm saying is that to create a right from 6ter or GAC list is major surgery. **B**ut I put forward a very straightforward way to get there within the four corners of the UDRP, which I think I can sell to the IPC. When I raised the issue of [inaudible], it wasn't uniformly applauded but I think I can sell it. And that literally is a footnote to the UDRP that gives instructions to the panelists about how to treat the UDRP complaints where the complainant is an IGO and that happens to be on the 6ter list.

So I'm saying the opposite thing, which is if we choose to go down the path that I have suggested and said instead of entrenching ourselves and saying, "Well, we're not a commercial organization," or "Those particular uses that would otherwise qualify as [inaudible] are not our main mission …" If we can move past that and really look at those things, I think we can easily solve this. I think we can be done [inaudible].

CHRIS DISSPAIN: Let me push back on that, Paul. Let me push back on that for a second. If I've misunderstood then I'm happy to be wrong. But I

thought what you were saying was there would still need to be a trademark or be it unregistered, and that 6ter would be used as evidence of that.

PAUL MCGRADY: No. What I'm saying is that … And I challenge anybody to give me an IGO's name or give me three minutes for me to find some common law use that they already have that they're making [inaudible]. So they put forward minimal evidence of a common law trademark right, which all of them have, and then we use 6ter to tweak the elements so that the burden of proving trademark rights—the burden of proving those common law rights is lower for IGOs if they happen to be on 6ter.

Those are instructions to the panel. That's a footnote, "Hey panelists, do this when you see this kind of complaint." And it's literally just to update, then, of the WIPO—sort of a common rules document or whatever Brian is calling it these days. So that to me is a way literally to make no substantive changes to the UDRP at all and still take care of IGOs by simply giving better instructions to panelists through a footnote in UDRP.

If ultimately the IGOs don't want to go down that path and they want to create a new right out of being on 6ter, then I think you're right. Then I think we've got to go back to Council and say, "Yeah, this isn't going to work within the UDRP. We need to develop an IGO DRP."

CHRIS DISSPAIN: So I was accurate then because what you what you are saying is that they can get in but by the fact they're on 6ter, and then demonstrate that by some use, somewhere, they've got a claim to a common law trademark, yes?

PAUL MCGRADY: Again, I think we're going back to the get in by way of 6ter. At least know if you have a common law right of any kind, that is more than sufficient to make that initial claim. What we're talking about is level of proof. There is no need to rely on being on 6ter or not being on 6ter to access the UDRP process. It just isn't necessary.

So, for example, again throw out any IGO at all. You'll find that they're doing something, they're organizing conferences. UNICEF has two funds under management or they're investing in things. Those are all sufficient use to show a common law right. We use 6ter, if we want to, to instruct the panelists about, "Okay, UNICEF has two funds under management. Those are financial services. They don't have a trademark registration for it. Fine. But they're an IGO that happens to be on the 6ter list. It happens to have a charter," or whatever we want to hang our hat on.

In situations like that, the panelist doesn't need to require trademark registration and they should allow that particular complainant to have a lower burden of proof to prove up those common law rights, and then the panelists can take it from there. But getting into the UDRP, 6ter, we don't need to create that right. It's not necessary.

CHRIS DISSPAIN: Okay. So let me try one more time. Because your note says being on 6ter could be used to lower the evidentiary standard of showing unregistered trademarks. So you would put that in the mix. You would say, "I'm on 6ter and the following things apply, and therefore, I have a trademark." I think I get that.

Jeff, I can see your note in the chat and I quite like you to talk to that if you could, and if I can encourage the IGO folk on the call to think about whether they want to respond to what Paul has said. Jeff, did you want to say something following on from your notes in the chat?

JEFF NEUMAN: Sure. I appreciate what Paul is saying but I think Paul is making it sound a little too much as a given that any IGO would automatically be found to be using their name and acronym as a common law trademark. And I also think it presents a couple of other issues in the sense of the notion of having common law trademark rights is not something that is global. It's not the law in every jurisdiction. Or let me say it differently. Not every jurisdiction recognizes common law rights. I think that it's also a matter of proving to the panelists, not only that you're using it in a kind of commercial sense that Paul is talking about but it's also showing that your mark is distinctive and in the minds of the consumers is the source of the product.

Paul, no, I'm not saying that you have to show you that you have a global common law right. I'm saying that not every jurisdiction

recognizes what common law rights are. So not everyone on this call understands how easy or not easy it is to establish a "common law right." That was my point, not that you have to show that you're using it around the world.

So I just think it's more than just showing that you've had a couple sales or a couple conference rooms. It's usually showing that you have trademark rights in a common law sense. It involves a lot more analysis and there's a lot of jurisprudence in the UDRP—and maybe Brian can talk about it—where there are cases where there are a number of things that have not been found to be a common law right. If we went down this path, I would think we would need an independent legal opinion so that everyone could understand what that actually means. Thanks.

CHRIS DISSPAIN: Okay. Thank you, Jeff. Brian, go ahead.

BRIAN BECKHAM: Thanks. Just checking you can hear me.

CHRIS DISSPAIN: Yes, we can hear you fine.

BRIAN BECKHAM: Thanks. Look, I was sort of anticipating we might find ourselves in this conversation. The suggestion about an independent legal opinion on this, I'm not sure I follow because as a starting principle, we're here in a policy making process. Now, I appreciate

that there's a lot of concern in these circles around this notion of creating new rights. I think on this point, I would agree more with what Paul is saying.

The question is really what would be the evidence that would be sufficient to satisfy a panel that there is—you can call it unregistered common law trademark rights, unregistered rights, source identifying capacity. The very fact that an IGO would have brought a complaint and on the basis of a registrant engaged in bad faith … And I'm going to put in the chat some sections of the WIPO overview on this. But there are cases which have said that the fact that a registrant has targeted a complainant's brand in bad faith, at minimum, in the minds of the registrant, presupposes a source identifying capacity of the things that they're trying to take advantage of.

In terms of the question of common law and civil law jurisdictions, maybe rather than get into a conversation on the call here, I can just refer the group to some sections of the overview of some cases that have dealt with that. But again, I think, ultimately, the question comes down to if being on a list is treated as sort of prima facie evidence that there is a trademark that the IGO is operating under, then I think that's something IGOs could get behind. But it sounds to me that we haven't unpacked that question of what criteria would be applied.

CHRIS DISSPAIN: Right. That's an interesting point, isn't it? So let me go back to Paul for a second because that wasn't my understanding. But if that is the case … If you could say—let's just stick with 6ter for the

sake of this discussion—I am on the 6ter and that, as you put it, Brian, would be prima facie evidence of a right to a common law trademark to bring UDRP, then we can pack that away as dealt with and move on to the next point. Jeff, is that an old hand? And, Paul, do you want to respond?

JEFF NEUMAN: It's sort of new. I'm just very confused because if we're talking about by being on a list, we are now saying you have de facto trademark rights, I thought that was the argument by Paul and by Susan, the USPTO, about creating trademark rights by being on a list. I am so confused right now. So, sorry. And if that's the case, then why do we even need this group? We don't even need to be here. We don't even need this work track.

CHRIS DISSPAIN: I think that's fair.

JEFF NEUMAN: The one issue would be should we take out the mutual jurisdiction clause, but other than that—

CHRIS DISSPAIN: Yeah.

JEFF NEUMAN: If it was always going to be that because IGOs already do have common law rights, then let's just skip the whole subject and

move on to whether we should just get rid of mutual jurisdiction. But I'm confused again because again I thought—

CHRIS DISSPAIN: Let's see what Paul has to say since his hand is up. Paul?

PAUL MCGRADY: Thanks. I was simply referring to the chat, so I apologize if I don't respond this directly to Brian as you might hope, Chris. You can always correct me if I get it wrong. But, Jeff, to a certain extent, you're right. IGOs have always had these common law rights. Based upon the comments to my chart, there seems to be resistance to acknowledging that fact. I don't think any of them would have a problem showing sufficient recognition for panelists to [inaudible] they have sufficient rights to win a UDRP without a trademark registration.

But for some reason, there's some concern about that. So what I'm trying to do is to accommodate that concern, even though I don't think we need to do anything in this space. But by doing that—by suggesting, perhaps, that whether it's 6ter or whether it's showing some sort of treaty-based charter—whatever it is, that the panelists then can take some comfort and say, "Yeah, okay. This is an IGO and they sent me a handful of links. But they're the World Health Organization so I kind of know those guys. Good enough. These other guys shouldn't be doing what they're doing."

So by lowering the standard, then that's not creating a trademark right because the common law rights are the basis of the complaint, not the evidentiary standard. The evidentiary standard

is the evidentiary standard. So by doing this, we're not suggesting creating rights out of whole cloth and 6ter. That's the major surgery, just basically assuming you're writing this because you want to win it.

CHRIS DISSPAIN: So walk me through what an IGO would need to do. Because what Brian said is if what you're saying is that being on 6ter—and we'll stick with 6ter—is prima facie evidence of the common law trademark or common law right or call it whatever you want, then that's something he thinks that the IGOs could get behind. Is that what you're saying?

PAUL MCGRADY: Not what I'm saying. What I'm saying is that the common law use is the common law use, and that's what evidence is a common law right. 6ter only kicks in at the evidentiary standard level. It doesn't kick in to, again, create a presumption of some sort of trademark. You still have to show the trademark right.

CHRIS DISSPAIN: So what's the relevance of 6ter at all, then, in your take on it?

PAUL MCGRADY: How I'm trying to use 6ter, because everybody's all excited about it, is a data point for the panelists. When they get a complaint, they have a complaint from whomever. I don't want to use World Health Organization because I got chided for it a little bit in the

chart. So let's pick UNICEF. UNICEF goes in and provides a copy of its website, lists all the things it's up to, including having investment funds under management. There's all kinds of common law uses of UNICEF right now.

And the panelist says, "Okay, look at this. Here's the things that they're up to. I can spot several things that are certainly trademark uses in common law countries. They're a global organization so they're probably doing it there. I wish I had a little more comfort. Oh look, they're on 6ter. Aha. I can now apply the lower standard of evidentiary proof that's found in the new footnote in the UDRP that allows me to say a reasonable showing of common law rights—not the maximal showing you have to do now for simple trademark owner. But a reasonable showing of the common law right by an IGO is sufficient to sustain the complaint and we will then now turn to the respondent to see if they have any good-faith [intent]."

CHRIS DISSPAIN: Okay. So, Brian, given that that was in response to your question, do you want to respond? Does anybody else from the IGO other side want to say anything? Brian, go ahead.

BRIAN BECKHAM: Thanks, Chris. Thanks, Paul. I think that the concern … And this is really the difficulty of policymaking is trying to create a rule that casts a wide net and don't unintentionally cut out otherwise deserving causes. So the concern, simply put, is that by putting this bar in front of IGOs … And I accept, Paul, what you've said

about, “Give me a name of an IGO and give me three minutes and I will show that they’re using an identifier in commerce.” But the concern, of course, is that the potential failure to demonstrate that showing to an individual panelist who is judging based on an undefined criteria would bar an otherwise valid complaint from proceeding.

So it’s really a question of—are IGOs going to be able to jump through the hoops that we’re putting in front of them? Or is it more simply the fact that an IGO has been created by states through the instrument of a treaty, does that itself presuppose that there is a service being rendered to the public? I’m sorry to put it this way but that takes us back to does being on some sort of a list satisfy that standing criteria? Or do we want to make IGOs jump through as-yet undefined hoops?

CHRIS DISSPAIN: So, in simple terms, it’s this, isn’t it? Paul’s principle is UDRP is for trademarks and trademarks only, be they common law or be they registered. And I have a way that IGOs can, in most cases, I believe, utilize the common law trademark aspects of UDRP and that would work. And the IGO side is, “We think that”—and I don’t mean this to be derogatory in any way—“we’re a different and special case in respect to our names and acronyms, and that there should be a process that we can use where the fact that we are an IGO and the fact that our acronym is on whatever we agree to list or register means that we overcome the first hurdle of a case, which is that we have a right.”

That's the fundamental principle difference between the two approaches. Brian, would you say that that is a fair assessment?

BRIAN BECKHAM: I'm very sorry to ask. Would you mind repeating that?

CHRIS DISSPAIN: Sure. What I've said is, again, simplistically, the difference is Paul's view is UDRP is for trademarks and only for trademarks, be they common law or registered service marks as well. I know that most IGOs would probably be able to show that they had a common law trademark. If they want to use the UDRP, they should have to do that. The IGO position is that IGOs have their own special rights and that there should be a process that they can use the same as equivalent to UDRP process-wise as opposed to trademark-wise so that they can bring a claim in respect to their acronym for their name. Would you say that's a fair assumption of the fundamental difference between the two approaches?

BRIAN BECKHAM: I think so. I know we're just sort of restating this in big picture terms. I know probably some people on this call would choose other terminology than special rights. But I think that fundamentally describes the issue. Now, if we can come up with criteria—and I think this is the discussion that Jeff and Paul have been having—if we can come up with criteria that would satisfy that unregistered trademark rights threshold based on, let's say, as a starting point, that IGO exists …

By the way, just to kind of remind us—just to situate this—to get a trademark, it doesn't take much. To create an IGO is a whole different animal. Sorry to say this but I think we're kind of glossing over what it takes for an IGO to be created. This is governments coming together to create a body to do something for those governments or for the public. And it's a much more complex process than obtaining a trademark, whether that's a common law, registered, state/federal.

Let me say it this way. I think it may be worth having a conversation around what would be required to get across that threshold. And I think it's worth me saying that, obviously, we're having kind of on-the-fly conversations and we need to go back to the broader group of IGOs to make sure that we're coloring within the lines here. I think it may be worth having a conversation around what criteria we would be looking to apply. Of course, there's a more principled view about whether these criteria should be required. But maybe, if ultimately, we can land on something where it would satisfy both the IGOs that they wouldn't unnecessarily be cut out of the process and would satisfy people who think that there should be certain showings to get into the UDRP, then that sounds like it's a conversation that could be worth having.

CHRIS DISSPAIN: Thank you, Brian. Susan?

SUSAN ANTHONY: I don't take any exception to anything that Brian has said, but I did want to clarify for poor Jeff. I didn't want him to be confused about what [I] have may have said or may not have said. When I think of a list, I think of a list versus 6ter. There is a list on which IGOs have been for some time, starting back, I think, in 2012. And I think we agree, or many agree, that the list had not been updated and would need to be updated. I don't think anybody took an exception to that.

But then there is 6ter and I do not refer to 6ter as a list. And I want to remind everybody what 6ter is and isn't. I think some of you have been keeping score on how many times I say this so maybe we're up to, I don't know, maybe 90 percentile. But when Paul said that the panelist could look at everything that an IGO does, he would see perhaps common law rights by the various links that are provided, and then the panelist might say, "Oh look, they are on 6ter."

Well, I don't think of anybody as being on 6ter, although I appreciate that one can generate a list, I believe, through the WIPO website. But every member country reviews an IGO name or acronym for inclusion, for recordation on 6ter within their country. And the USPTO, like many other countries, takes this very seriously. It looks very, very carefully and makes some very hard determinations, many times saying, "I'm sorry, but you have not made the case for a 6ter recordation."

So I think for any one IGO, if you look around the world, an IGO may have gotten a 6ter recordation in some countries, no 6ter recordation in other countries. In other words, I think it would be very difficult for a UDRP panelist to ascribe really any evidentiary

weight. So I wanted to clarify for Jeff. I'm looking at the IGO list that has existed since 2012 and I'm not looking at 6ter.

CHRIS DISSPAIN: Thanks, Susan. That makes sense. Thank you. Jeff, go ahead.

JEFF NEUMAN: Thanks, Susan. Understood. I think my point was that at the time we started this discussion or around the time and I mentioned this was when it sounded like Paul and Brian were saying that by virtue of being on a "list," whatever that list was, they were saying that would create sort of a rebuttable presumption that there were trademark rights. That's the way the conversation seemed to be heading and that's what I was objecting—or that's what I was confused about because that's what I thought was something you had objected to about assigning "trademark rights" to something that was on a list. So that was when I raised it.

I guess I'll all step out but I just think that there's a lot more that goes into establishing common law rights than what's being said. While I appreciate the WIPO overview, I do want to caution that that's just a summary. There's nothing in the UDRP that creates a body of law. To me, it's always unusual. I don't like when an overview is cited in cases but that's something completely different. Let's just keep in mind that the overview is not law, so it's one thing to say let's look at the WIPO overview. It's another thing to look at actual cases.

I posted earlier in the chat probably a good summary of what the UDRP cases generally show as to what goes into the analysis of a

common law right. I do think it's something to take a look at. And certainly, with respect to acronyms and abbreviations, it's much harder to show a common law trademark right with respect to acronyms. Not impossible, but it is tougher. I just think the reason I called for an independent legal opinion was not to give an independent legal opinion on the UDRP and how panelists have determined, to date, what is common law, but to help those that do not live in a jurisdiction that recognizes common law—to help them understand how an analysis works. Thanks.

CHRIS DISSPAIN: Thank you, Jeff. Alexandra, I'm going to come to you in a second. Part of the issue and part of the reason why I tried to make a very simplistic sort of chart with a couple of simple columns in it is that we keep talking about, "Well, if we allow the IGOs to use this process, then we are giving them trademark rights or they're stretching their rights or they're getting new rights, etc." And Paul says that amongst other things, including that says that they may well have a common law trademark rights, anyway.

But to me, it's got nothing to do with trademark rights as such. It is, do we agree that—which clearly we don't, at the moment, agree—that we should have a separate process where an IGO, because it is an IGO and because it has an acronym registered on a list, is entitled to some rights in respect to the use of that in bad faith. By saying that does not mean you're granting them trademark rights. It doesn't mean that. You would have to grant them trademark rights for that to happen. What it means is you're giving them a process that they can use that is similar to a process that trademark holders can use. But you are not just

giving them trademark rights by saying they can have a process. A least it seems to me that that's the case. Alexandra, go ahead, please.

ALEXANDRA EXCOFFIER: I think the OECD and other IGOs would be worried about this issue of legal uncertainty. I was worried about what Jeff was saying about how difficult it is to prove common law trademark rights, especially for acronyms.

We could talk about criteria, as Paul and Brian suggested, but if ultimately it would be up to the judgment of the panelists, I would like to know and ask those who have been panelists in other situations—not necessarily for IGOs—how did it work in the past or has it worked in the past? Have there been examples of entities who didn't have trademark certificates showing that they have either common law rights or other protections? So maybe a few examples. From what I hear from Jeff, it's not an easy bar to pass. So I would have that legal uncertainty element for IGOs, which would be worrying. That's all for the moment.

CHRIS DISSPAIN: Okay. Does anyone, any of our panelists, want to address that? No sign of anybody volunteering at the moment, Alexandra, but maybe somebody will in a minute. Jeff, go ahead.

JEFFREY NEUMAN: There are a number of cases. What Brian says is right, that the overwhelming majority of cases are with registered rights. But

there are a number of cases where common law rights have been found but there's some where common law rights that have not been found. It just depends. Basically, you don't have the presumption going in that registered trademark owners have. So when it comes to things like notice and other stuff, certain things are easier when you have a registration.

And most of the entities that have tried to get common law or have used common law rights and succeeded are commercial in nature. They have sales. They have the factors that I listed up in the chat earlier on. I'm not aware, but Brian might be, of non-profits or non-commercial entities that have had that success. Personal names, for example, is something that have had trouble getting common law rights, even if they do sell merchandise and other things under their name. That's something that they have had issues. Brian probably knows it better so I'll defer to Brian.

CHRIS DISSPAIN: Thank you, Jeff. Paul's put something in the chat, which I want to address. Paul, you said, "Alexandra, that's exactly why I'm suggesting tweaking the evidentiary standard." If I could ask you to talk us through how you think that would work, that would be enormously helpful. Because it seems to me this, I don't think there's any doubt that we could say, if we were taking the existing process and we were making some—let's wait what Paul has to say about tweaking the evidentiary standard—we were doing that and doing some tweaking, I don't think there's any doubt we could say that is not outside of our scope.

So if there was a way we could actually make that work then we would in fact probably be in a position where, in this particular aspect of it, we could make some recommendations that I think we could say we're within scope. I'm very interested in pursuing that further. If, Paul, you could explain perhaps what you meant by your comment that's why you're tweaking the evidentiary standard now that would look, from the point of view of an IGO, what they would need to show.

PAUL MCGRADY: That's the whole point of what I've been trying to convey. And I apologize for the bad explainer. But that's the whole point. Alexandra's concern, I think, about an IGO filing a UDRP complaint based upon—as Mary says, let's start calling them unregistered rights and having a panelist basically say, "This is unregistered and you don't have a lot of use. You're not giving us a lot of evidence. And so I'm going to apply the current standard for unregistered or common law, depending on what you want to call them—rights within the UDRP." Pretty high standard.

Well, if we do something … And again, let's say, maybe saying 6ter is not the right thing. Maybe it's the charter documents, treaty, whatever it is that gives the IGO its formation. Maybe that's what the panelists [inaudible] on. But in any event, based upon that, it doesn't create a right but it lowers the evidentiary standard so that the panelist can be comfortable, essentially, with a reasonable showing of some sort of right.

So for example, I don't know if the United Nations is an IGO or not but let's assume they are. And they have shop.unitednations.org

and I can buy a mask there with the United Nations logo on it. I can buy books. There's books to buy. All proceeds go towards the work of the United Nations. I sure hope this is the United Nations and not a cybersquatter because then I'll look stupid. But in any event, this is clearly a common law right for a retail store online. Without a doubt, it's an unregistered right.

So if the UN were able to show this—this link to their website—it shows that they have at least this unregistered right for retail sales online. And the panelist can then look at the charter documents or whatever we hang our hats on. They apply the lower standard that's found in the footnote [inaudible] right, and they can apply that lower standard.

I know Jeff means well and keeps pushing back on rebuttal presumptions of trademark registrations and all these other things. But the panelists already put the evidentiary standard where they want to put the evidentiary standard. There is no evidentiary standard found in the text of the UDRP. That evidentiary standard has evolved over time by the panelists coming to a decision that they collectively all sort of get behind, and then Brian puts it in the overview and then it is—

CHRIS DISSPAIN: How would you do that, then? How would you make that happen given what you've just said? How would you make that happen specifically for the IGOs, formally?

PAUL MCGRADY: Literally what I suggested on the [inaudible]. This could be done in a footnote—to revise the UDRP to drop a footnote that says, "IGOs need to show some very basic common law or unregistered rights claim—unregistered use of their name or acronym for the provision of some good or service," and that the IGO, if they do that and they produce whatever standard we pick, whether it's producing charter documents—could be a link to the charter document—or whatever it is, that those two things together reduces the evidentiary standard that the panelist applies. And then Alexandra will have a much lower instance of a wacky decision.

CHRIS DISSPAIN: Can we focus/zoom in on that one point there? Given that you've referred to the WIPO footnote, perhaps, Brian, if you are able to address that point and talk to it and see whether that is feasible, workable as a way forward?

BRIAN BECKHAM: Thanks, Chris. It's an interesting suggestion. While I don't necessarily agree with the way Jeff has characterized the overview in the chat … I'm not sure it's due. But the point is, it's a summary of jurisprudence. It's not a binding policy document. That much is right. And basically, what it does is it looks back at past cases and it summarizes the consensus views of panelists. It doesn't look forward and say, "In such-and-such a scenario, a panelist shall do the following." That would really be more the role of the UDRP policy itself.

Now, that's not to say that we couldn't put out some kind of a guidance through this working group that operated outside of the four corners of the UDRP policy itself. But the question, I think, is less for me, can we change the WIPO overview, but more can we find a way to bring that together here in this working group?

I just want to take a minute to remind everybody … And I don't mean to shortcut the importance of this conversation on rights, and standing, and getting in the front of the line or whatever we want to call it. But the reality is that the overwhelming majority of cases don't hinge on the first element. Now, of course, there are cases where there's not sufficient trademark rights shown so that the complainant fails for lack of standing effectively. But the overwhelming majority of cases are actually decided on the second and third elements. And more often, it's really that third element, whether the registrant is acting in bad faith.

So I'm not suggesting that we should shortcut this conversation but I just want to kind of help situate that a little bit to say this is … I'm sorry to put it this way but this is all feeling very hypothetical and it's really not where the core purpose of the policy, whether that's the UDRP or … If we go back to the task that this group has been put to, it's that IGOs have expressed that they have difficulties in using the existing UDRP and we're supposed to see if we can't find a solution to help them through that. And really, what that means is a way to address bad faith domain name registrations.

CHRIS DISSPAIN: Brian, that's not right. With respect, that's not correct. That is not the role of this work track. The role of this work track is actually specifically to deal with Recommendation 5. And whilst I'm more than happy to stretch things and try and find solutions, it isn't correct to say that this work track's role is to solve the IGO's difficulties in dealing with using the current UDRP. We can tweak, we can play around the edges, but it's not for us to talk about bad faith, for example. That's just outside of our remit, which is what I thought you just said. But if I misheard you, I apologize.

BRIAN BECKHAM: Well, first of all, as I said in the chat, I would refer us back to our problem statement. I'm not sure I would agree with the characterization. But anyways, the point I was trying to make is that we're spending a lot of energy on this rights, this standing issue, and in fact, that's not really where most of the cases are decided. They're decided on the bad faith element. So what I'm suggesting is—sorry to put it this way—but it's a bit of a tempest in a teapot.

CHRIS DISSPAIN: But it's only a tempest in a teapot, Brian, if you guys can get to a point where you can bring your argument about bad faith. If you can't get to that point, then it's not a tempest in a teapot at all. I know that they're not necessarily in an order, but effectively the first hurdle is trademark. Second hurdle is etc. If you can't get over that first hurdle, then it doesn't matter about bad faith. You can't even discuss it. I'm not clear. Are you saying we shouldn't worry about this? We shouldn't move on and talk about something else?

BRIAN BECKHAM: I'm saying that we're sort of losing the forest for the trees. We're here to see if we can't help solve the problem that IGOs have identified and we're just putting hurdles in front of ourselves.

CHRIS DISSPAIN: Well, we've broken it down. And maybe we need to change the way that we're doing things but we've broken it down into a number of relatively small—although the problems are not small but they're small, bite-sized pieces for discussion. Just to remind us all, they are what we've called the eligibility, and in simple terms for a UDRP, it's the trademark thing, the mutual jurisdiction, and then what happens at the end, if there needs to be some form of reconsideration or appeal. If we don't solve the current situation is that you've got to show that you've got a trademark—we don't solve that—how does that help us? Brian, go ahead.

BRIAN BECKHAM: Yes. That's all understood. Let me ask this. I'm wondering. I think a lot of our calls go this way. It seemed as if we kind of were making good progress and unpacking some good conversations. Then we find ourselves tripping over ourselves. I feel that there seems to be a more or less shared view along the lines of Paul's suggestion with the exception of Jeff. So I guess I'm wondering, does that position us to say we have some kind of … I appreciate this can be thorny when we're talking about working groups and people worry about verbiage—consensus calls and this sort of thing. But in other words, is there enough to say, "Look, there's a

rough consensus in the group that we want to look at this topic this way. We have a member who has a different view but that one different view shouldn't hold us back?"

CHRIS DISSPAIN: Well, absolutely. What I was going to say three paragraphs back was I wonder if I—this is not literally, figuratively—put you and Paul in a room together, if you could nut out the way in which we could suggest formalizing—again, I use the term formalizing, small F—the concept of Paul has put forward of your common law trademark in a way that satisfies Alexandra's legitimate question about certainty. And just as a combination of footnotes and overviews and whatever is to whether it's feasible that you two could come up with a proposal that would at least go some way to dealing with that point. Jeff, I can see your hand, but I just want to see if Brian wants to respond first.

BRIAN BECKHAM: Sure. Thanks, Chris. I think it's certainly achievable. Obviously, it would be something that would require some discussions amongst the IGOs. I would also frankly not mind if Paul and I were to add Susan to the conversation because I think we want to also make sure that we're—but I think it's certainly feasible.

CHRIS DISSPAIN: Okay. That's one. Paul, are you going to give it a go? I can see yes from you in the chat so that's two. And that just leaves Susan. Are you going to give this and go, Susan?

SUSAN ANTHONY: Go.

CHRIS DISSPAIN: Pardon?

SUSAN ANTHONY: Give it a go.

CHRIS DISSPAIN: Oh good, excellent. Thank you. Marvelous, brilliant. I thought you said no. I was quite surprised. Okay. So then, Jeff, I'm going to come to you in a second. So what I'm going to say then is that Brian, Susan, and Paul can get together in the next few days and get work out—if there is a way of putting together something that we can put to the group, that we can call it a tweak because it's built around trademarks, albeit common law. We can put it in place with the existing rules. And we can put some level of formality to it that gives a level of certainty to the claimant that coming in as an IGO with some form of charter, treaty, whatever you want to decide, and showing some sort of common law usage is sufficient to make it likely that a panelist is going to at least agree that they're over that first hurdle. Thank you. Jeff, go ahead.

JEFF NEUMAN: I just want to be clear for the record. I do not … How am I saying this? Why am I saying this wrong? I do not disagree or oppose the approach that Paul and Brian and others want to take. It's never

been an opposition. My point was that I believe it as major of a change as what Paul is saying the other proposal was, and therefore, either approach would require going to the Council and letting them know. Lowering an evidentiary standard for certain players to get into the UDRP is just as major as just saying that they should get into the UDRP, which is what the kind of IGO DRP thing was. So I'm fine with it going forward is all I'm saying. I don't oppose it.

CHRIS DISSPAIN: Well, let's wait and see what our triumvirate comes back with and see if we can push that out as dealt with subjects. All of this is always going to be subject, Jeff, and I know you know this, and I know Paul knows it too. Everybody knows it. All of this is going to be subject to the possibility of the GNSO saying at some point, "This is outside of your scope," or "This is not tweaking, this is major change," or whatever. We all know that. What we've agreed is that subject to checking in on a fairly regular basis and me saying I'm concerned that we're stepping way too far outside is that it's a risk worth taking.

So if we've managed to achieve that and if we can get some information from the three volunteers by the end of this, by close on Friday, that would enable the rest of us to have a look at something over the weekend. And then when we come to our call on Monday, hopefully we'll know where we are. So hopefully, that will at least give us a chance of reaching some sort of understanding, and then we will have dealt with that point.

Now, at the risk of throwing this wide open to another big debate, if we achieve that, then where I think we're at is this. I think it was pretty clear to me from last week's call that in respect to a secondary review or appeal or call it whatever you wish, that there was a leaning towards some form of arbitration because that was something that was understood.

But I would like everyone to consider—we'll need to come back and revisit this so I am assuming that we're still here, so I'm planting a seed—as to whether or not there is an advantage to what we've called, somewhat humorously, a super panel on the basis that you are dealing with an arcane area where there's not a lot of experts around. And it may be that dealing with it inside of the current structure, inside of the UDRP—I'm not pushing this; I'm just asking a question—UDRP is something to consider. So I'd like us to think about that and as part of our homework, if we could.

But irrespective, I think if we can say we have a solution to the end game, which is arbitration or super panel but we're leaning towards arbitration, what does that leave? If Susan, Paul, and Brian are able to come up with something that is that is workable and acceptable in principle by this group, if we say the devil is in the detail but it looks like we could coalesce around and review by arbitration, what does that leave? That leaves one thing that splits into two things.

It leaves the mutual jurisdiction agreement at the beginning. Are we prepared to say that that's not necessary because it means the IGOs would be binding to that major jurisdiction? And the second point on jurisdiction is the question of whether or not, as a part of

the process, a registrant would be entitled to, as a part of the process, a registrant would be entitled to, as a part of the process, having agreed that it would be finalized in arbitration, would still have the step on going to their own jurisdiction.

That is something that we also need to think about. Because it seems to me that if we agree that it is feasible for the matter to be finalized by way of arbitration, it raises the question of whether or not going to our local jurisdiction is necessary within the confines of the agreement to operate within the UDRP, acknowledging up front that, of course, you don't have to use the UDRP if you don't really want to.

We've got 15 minutes left. I'm going to take a little bit of discussion but I think we've gone a long way today. So I'm wondering if we shouldn't let our volunteers coalesce around their thoughts. But I'll take any last comments from anybody before closing up the meeting. Does anybody else want to say anything? Now I stunned you all into silence. Marvelous. I've stunned you all into silence. Okay.

So we will convene next Monday. If it's possible to get something from our triumvirate by the end of the week, that would be fantastic, that will be very much appreciated. We will coalesce around that on Monday and see if we can reach some sort of an agreement. And I'm going to set aside 40 minutes at the end of next Monday's meeting, if we need it, to talk about anything other than a "things are going well" message to the GNSO Council. Because if John needs to go to the GNSO Council on the 20th and we are still not in a position to be able to say we're all on one page

about tweaking, then we are going to need to go to them and ask them for a wider scope.

Okay. I want to say thank you to everybody. I think we've actually made a significant progress today and I appreciate those of you who prepared to continue to regularly be on these calls and to contribute. It's enormously helpful. Thank you. With that, let's adjourn and see you all next week. Thanks, everybody.

MARY WONG: Thanks, everyone.

TERRI AGNEW: I'll stop the recording and disconnect all remaining lines. Stay well.

[END OF TRANSCRIPT]