

Final Report on the IGO-INGO Access to Curative Rights Protection Mechanisms Policy Development Process

Status of This Document

This is the Final Report of the GNSO IGO-INGO Access to Curative Rights Protection Mechanisms Policy Development Process (PDP) Working Group. This report contains the Working Group's final recommendations and is being submitted to the GNSO Council for its review and approval.

Preamble

The objective of this Final Report is to present the Working Group's final recommendations for Consensus Policies to be approved by the GNSO Council as a result of this PDP and record the Working Group's deliberations on the issues raised by its Charter (including its consideration of community input received on its Initial Report that was published for public comment in January 2017 and policy proposals discussed within the Working Group that did not attain consensus). This Final Report will be submitted to the GNSO Council in accordance with the motion that was proposed and carried during the Council teleconference meeting on 5 June 2014, and which resulted in the creation of this Working Group.

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1 Executive Summary

1.1 Introduction

In June 2014, the GNSO Council launched this Policy Development Process (PDP) and tasked the Working Group to determine whether, in order to address the specific needs and circumstances of international governmental organizations (IGOs) and international non-governmental organizations (INGOs): (1) the curative rights protection mechanisms currently in place for both existing and new generic top level domains (gTLDs) should be amended and, if so, in what respects; or (2) a separate, narrowly-tailored dispute resolution procedure modeled on the existing curative rights protection mechanisms should be developed.

As currently designed, IGOs and INGOs may encounter certain difficulties relying on these curative mechanisms, namely, the Uniform Domain Name Dispute Resolution Policy (UDRP) and Uniform Rapid Suspension procedure (URS), when trying to protect their names and acronyms against third party abuse. For example, in relation to IGOs, the procedural rules for both the UDRP and URS require that the party filing the complaint agree to submit to the jurisdiction of a national court for purposes of a challenge to the initial panel determination. This requirement could potentially affect an IGO's ability to successfully claim immunity from national jurisdiction. Both processes were also designed to be protective mechanisms for trademark rights; while some IGOs and INGOs may have trademarks in either their organizational names or acronyms or both, this is not necessarily true in all cases.

On 5 June 2014, the GNSO Council initiated this PDP and on 25 June 2014 it chartered this IGO-INGO Access to Curative Rights Protection Mechanisms Working Group. A Call for Volunteers to the Working Group was issued on 11 July 2014, and the Working Group held its first meeting on 11 August 2014.

1.2 Final Recommendations

The Working Group Charter specifically directed the Working Group to examine the following questions: *“whether to amend the UDRP and URS to allow access to and use of these mechanisms by IGOs and INGOs and, if so in what respects; or whether a separate, narrowly-tailored dispute resolution procedure at the second level modeled on the UDRP and URS that takes into account the particular needs and specific circumstances of IGOs and INGOs should be developed.”* Following its analysis of each of the questions outlined in its Charter, the Working Group arrived at a set of preliminary recommendations for which it sought community input in January 2017. Following its review of all feedback received to that Initial Report, the Working Group completed its discussions on any resulting modifications that it believed needed to be made to its

original recommendations and discussed various options it identified for resolving the remaining open issues. This Final Report reflects the group's consensus recommendations as well as documents those proposals discussed by the Working Group but for which it did not achieve consensus. In essence, the Working Group's answers to the questions laid out in its Charter (as quoted above) are no, although it has developed certain recommendations that it believes facilitates the accommodation of issues that IGOs may face in utilizing the UDRP and URS.

This Final Report is being submitted to the GNSO Council in its entirety for the Council's review and action.

Recommendation #1:

1(a). For IGOs (including the Red Cross movement and the International Olympic Committee), no substantive changes to the UDRP and URS are to be made, and no specific new dispute resolution procedures are to be created.

1(b). For IGOs, no specific new dispute resolution procedures are to be created.

Consensus result for Recommendation #1: **Full Consensus**

Note on Recommendation #1: This recommendation is substantively similar to the original recommendation on this point in the Working Group's Initial Report. Updated text was added to clarify the Working Group's intention that no new or additional dispute resolution procedures are being recommended to apply to either IGOs or INGOs.

Recommendation #2:

The Working Group notes that an IGO may seek to demonstrate that it has the requisite standing to file a complaint under the UDRP or URS by showing that it has complied with the requisite communication and notification procedure in accordance with Article 6ter of the Paris Convention for the Protection of Industrial Property¹. An IGO may consider this to be an option where it does not have a registered trademark or service mark in its name and/or acronym but believes it has certain unregistered trademark or service mark rights for which it must adduce factual evidence to show that it nevertheless has substantive legal rights in the name and/or acronym in question. In this regard, the Working Group recommends that specific Policy Guidance on this topic be issued by ICANN to clarify the following points:

(a) this alternative mechanism for standing is not needed in a situation where an IGO already holds trademark or service mark rights in its name and/or

¹ The full text of Article 6ter of the Paris Convention can be found here: http://www.wipo.int/article6ter/en/legal_texts/article_6ter.html and in Annex C of this report.

acronym, as the IGO would in such a case proceed in the same way as a non-IGO trademark owner;

(b) whether or not compliance with Article 6ter will be considered determinative of standing is a decision to be made by the UDRP or URS panelist(s) based on the facts of each case; and

(c) the possibility that an IGO may seek to rely on its compliance with Article 6ter to demonstrate standing should not modify or affect any of the existing grounds which UDRP and/or URS panelists have previously found sufficient for IGO standing (e.g. based on statutes and treaties).

Consensus result for Recommendation #2: **Consensus**

Note on Recommendation #2: This recommendation is significantly different from the Working Group’s preliminary recommendation in its Initial Report, where it had recommended that compliance with Article 6ter can, in and of itself, satisfy the standing requirement. For a full discussion of the Working Group’s deliberations on the changes to the original recommendation as a result of community input received, see the discussion in Sections 2.1 and 3.3, and Annex G.

Recommendation #3:

ICANN shall create and issue Policy Guidance: (a) outlining the various procedural filing options available to IGOs, e.g. they have the ability to elect to have a complaint filed under the UDRP and/or URS on their behalf by an assignee, agent or licensee; and (b) advising IGOs and INGOs to, in the first instance and prior to filing a UDRP or URS complaint, contact the registrar of record to address the harms for which they are seeking redress. In addition, ICANN shall ensure that this Policy Guidance document is brought to the notice of the Governmental Advisory Committee (GAC) for its and its members’ and observers’ information, and published along with the procedures and rules applicable to the UDRP and URS on the ICANN website.

Consensus result for Recommendation #3: **Consensus**

Note on Recommendation #3: This recommendation is based on part of an original recommendation in the Working Group’s Initial Report. Although significant discussion has subsequently occurred on the topic of IGO jurisdictional immunity, the Working Group remains in agreement that the existence of these procedural filing options should be noted for the GAC and the community.

Recommendation #4:

Notwithstanding GAC advice concerning access to curative rights processes for IGOs as well as the Charter language requiring the Working Group to consider “the need to address the issue of cost to IGOs and INGOs to use curative processes”, there was no support within the Working Group for a recommendation to provide subsidies to any party to use the UDRP or URS. Nevertheless, the Working Group recognizes that it has

no authority to obligate the expenditure of ICANN funds, and it understands, further, that the feasibility of providing IGOs with access to the UDRP and URS at no or nominal cost to the IGOs is a question that must be addressed directly through discussions between the ICANN Board with the GAC and IGOs. The Working Group also notes that many Working Group members believe that a respondent should also be eligible to receive financial support for its defense in a case where ICANN has subsidized the complainant.

Consensus result for Recommendation #4: **Consensus**

Note on Recommendation #4: This recommendation is substantively similar to the original recommendation on this point in the Working Group's Initial Report, although substantial textual changes have been made to clarify its intent and scope, especially as a few Working Group members strongly oppose providing any subsidies at all for using the UDRP or URS. Two Working Group members suggested that more specific boundaries should be prescribed should discussions with the GAC on this topic be initiated, e.g. creation of an objective standard for financial support, setting specific quantitative limits such as a specific dollar amount per year per IGO, or introducing some form of means testing.

Recommendation #5:

Where a losing registrant challenges the initial UDRP/URS decision by filing suit in a national court of mutual jurisdiction and the IGO that succeeded in its initial UDRP/URS complaint also succeeds in asserting jurisdictional immunity in that court, the decision rendered against the registrant in the predecessor UDRP or URS shall be set aside (i.e. invalidated).

Consensus result for Recommendation #5: **Consensus**

Note on Recommendation #5: As published originally (as Recommendation #4 in the Initial Report) for public comment, the recommendation included two options for which the Working Group specifically requested community input. The Working Group subsequently developed an additional four options, based on public comments received and suggestions from Working Group members. In October 2017, an informal poll was conducted on three of these options and discussed at ICANN60 in Abu Dhabi. Following its review of feedback received to these options and further deliberations, the final list of options to be considered for possible resolution of the issue of IGO jurisdictional immunity became a total of six options. For the text of the six options and a description of the Working Group's deliberations on these options, see the discussion in Sections 2.1 and 3.5.

The Working Group recognizes that implementation of this Recommendation #5 will likely require modifications to the current language of the UDRP and URS. For the UDRP, the main change will need to be to Paragraph 4(k) of the Policy, pursuant to which, if the

losing registrant notifies the registrar (within the 10-business day period following a panel decision) that a lawsuit has been filed in the appropriate national court, the registrar will take no action unless it receives evidence either of a resolution of the lawsuit or its dismissal or withdrawal, or a copy of a court order either dismissing the lawsuit or ruling that the registrant does not have the right to continue to use the domain name. For the URS, while the procedure does not contain the same 10-business day rule as the UDRP, Paragraph 13 expressly states that a URS Determination “*shall not preclude any other remedies available*”, and “*shall not prejudice the party in UDRP or any other proceedings*”.

The Working Group therefore specifically and additionally recommends that the Implementation Review Team that is formed to implement those of its consensus recommendations that are adopted by the GNSO Council and the ICANN Board review and update the UDRP and URS (including the relevant Rules), as appropriate, to ensure that they reflect this Recommendation #5.

1.3 Deliberations and Community Input

The Working Group began its work with a review of historical documentation and related materials on the topic. This included work done previously in and by the ICANN community, including a GNSO Issue Report from 2007 on the topic of Dispute Handling for IGO Names & Abbreviations (which did not result in a PDP at that time due to a lack of GNSO Council votes) as well as reference materials from outside sources (e.g., treaty texts and reports from international organizations).

As required by the GNSO’s PDP Manual, the Working Group reached out to all ICANN Supporting Organizations and Advisory Committees as well as GNSO Stakeholder Groups and Constituencies with a request for input at the start of its deliberations. All responses received were reviewed by the Working Group and incorporated into its deliberations for each of its Charter questions. The Working Group also encouraged the participation of IGOs, and sought their input on a number of questions relating to problems that IGOs had highlighted concerning their use of existing curative rights processes.

In addition to reviewing historical documents and related materials, the Working Group also considered relevant legal instruments and applicable international law. To assist it with this work, the Working Group sought the expertise of international legal experts. At the Working Group’s request, ICANN engaged Professor Edward Swaine of George Washington University, USA, to prepare a legal memo on the scope of international law concerning jurisdictional immunity of IGOs. Professor Swaine’s memo is included in this Final Report as Annex F. The Working Group also considered GAC advice relevant to the topic. The GAC advice is included in this Final Report as Annex E.

The Working Group also fully reviewed and extensively considered a proposal from the IGO Small Group, comprising a number of IGO and GAC representatives who had been

working with ICANN Board members on a proposal that, among other things, presented some alternatives concerning protection for IGO acronyms for the GAC's and the GNSO's consideration. The IGO Small Group proposal is included in this Final Report as Annex D.

Following the close of the public comment period to its Initial Report, the Working Group reviewed all community input received and specifically noted any new facts, additional issues or further information that were highlighted in the comments received. This Final Report contains several substantial modifications to some of the Working Group's preliminary recommendations as a result.

1.4 Conclusions and Next Steps

This Final Report is being submitted to the GNSO Council for its review and action. Should the GNSO Council approve the Working Group's recommendations, these will be forwarded to the ICANN Board following the requisite public comment period prescribed by the ICANN Bylaws.

2 The Working Group's Final PDP Recommendations

The Working Group was chartered to provide the GNSO Council with policy recommendations regarding the issues identified in the Final Issue Report that preceded and informed the GNSO Council's decision to initiate this PDP².

Following its analysis of each of the questions outlined in its Charter related to this task, including a comprehensive review of all the public comments that were submitted in response to its Initial Report, the Working Group has arrived at a set of final conclusions and policy recommendations. This Section 2 sets out the full text of all of the Working Group's final PDP recommendations, including any supplemental notes and relevant background information taken into account by the Working Group when developing these recommendations.

The Working Group believes that its final recommendations, if approved by the GNSO Council and the ICANN Board, will result in substantial improvement and clarity regarding IGOs' access to curative rights protection mechanisms.

2.1 Final PDP Recommendations

2.1.1 Text of the Final Recommendations and Relevant Background Information

General

The Charter that was approved by the GNSO Council tasked the Working Group with examining the following questions: *"whether to amend the UDRP and URS to allow access to and use of these mechanisms by IGOs and INGOs and, if so in what respects or whether a separate, narrowly-tailored dispute resolution procedure at the second level modeled on the UDRP and URS that takes into account the particular needs and specific circumstances of IGOs and INGOs should be developed."*

The Working Group's answers to these Charter questions are no³, although it has developed certain recommendations that it believes facilitates the accommodation of

² See <https://gnso.icann.org/en/issues/igo-ingo-crp-access-final-25may14-en.pdf>.

issues specific to IGOs, such as in relation to demonstrating standing to file a UDRP or URS complaint, and highlighting a number of procedural options for these filings that need not prejudice an IGO's jurisdictional immunity. ***In essence, the Working Group has concluded that the specific challenges noted in respect of the access to the UDRP and URS by IGOs and INGOs may be resolved without the need to modify any of the substantive grounds of the UDRP and URS, or the need to create a specific and separate dispute resolution procedure.***

Reasons for these conclusions, and specific recommendations pertaining to specific questions arising within the scope of its Charter, are described below. These reasons explain the Working Group's belief that the most prudent and advisable approach would be to not recommend any changes to the substantive grounds of the UDRP or URS at this time.

Recommendation #1:

1(a). For INGOs (including the Red Cross movement and the International Olympic Committee), no substantive changes to the UDRP and URS are to be made, and no specific new dispute resolution procedures are to be created.

1(b). For IGOs, no specific new dispute resolution procedures are to be created.

One of the first topics discussed by the Working Group was whether or not the specific needs and concerns of IGOs and of INGOs were of a similar nature, and whether such needs and concerns warranted policy changes to the UDRP and URS. With respect to INGOs, the Working Group's conclusion is that the specific needs and concerns of INGOs are adequately addressed by the current dispute resolution processes (e.g., UDRP and URS) and that there was no principled reason to recommend any modifications to the UDRP or URS, or the creation of a new curative rights process for INGOs.

The Working Group's rationale⁴ is as follows:

³ As detailed in Section 3.3 of this report (Review of Legal Instruments, Legal Expert Opinion and Other External Source Materials), IGOs and INGOs that have legally protected their names or acronyms can access, and some have already made use of, the UDRP and URS, even in the absence of potential recommendations from this Working Group.

⁴ The rationale described in this Section were also sent to all ICANN Supporting Organizations (SOs), Advisory Committees (ACs) and GNSO Stakeholder Groups and Constituencies as part of the Working Group's solicitation of input from these groups in December 2014, as required by the GNSO's PDP Manual. No objection to this preliminary conclusion or the rationale was raised by any SO, AC or other ICANN community group.

1. Many INGOs already have, and do, enforce their trademark rights. There is no perceivable barrier to other INGOs obtaining trademark rights in their names and/or acronyms and subsequently utilizing those rights as the basis for standing in the existing dispute resolution procedures (DRPs) created and offered by ICANN as a faster and lower cost alternative to litigation. For UDRP and URS purposes they have the same standing as any other private party.
2. Unlike IGOs, who may claim and sometimes be granted jurisdictional immunity in certain circumstances, INGOs have no such claim and are not hindered from submitting to the jurisdiction of national courts under the Mutual Jurisdiction clause within the existing DRPs. The Working Group's research revealed that some INGOs regularly use the UDRP to protect their rights.
3. Although some INGOs may be concerned about the cost of using the UDRP and the URS, because enforcement through these rights protection mechanisms involves some expenditure of funds, this is not a problem for all INGOs nor is it unique to INGOs as among all rights holders. Furthermore, as noted in Recommendation #4, the Working believes it has no authority to obligate any party (including ICANN) to subsidize the rights protection of another.
4. The Working Group found that, as of end-2015, the United Nations Economic and Social Council (ECOSOC) list of non-governmental organizations in consultative status consists of nearly 4,000 organizations, of which 147 organizations were in general consultative status, 2,774 in special consultative status, and 979 on the Roster. The Working Group notes that there might be many more organizations not presently on the ECOSOC list who might claim the right to utilize any new curative rights process created for INGOs. The Working Group felt that the sheer scale of INGOs, in combination with the factors cited above, weighed against the creation of a special DRP for INGOs, especially as they could not be readily differentiated from other private parties, including other non-profit organizations.

In relation to the Red Cross and the International Olympic Committee (IOC), the Working Group noted that although these INGOs had been specifically highlighted by the GAC as enjoying international legal treaty protections and rights under multiple national laws, for the purposes of this PDP these organizations have demonstrated that: (1) they have ready access to the UDRP and the URS; and (2) they possess strong trademark rights that they vigorously defend and enforce. As such, for the limited purpose of considering INGO access to curative rights protections, the Working Group determined there was no principled reason to distinguish them from other INGOs. The Working Group further noted that legal representatives of the IOC participated actively in the Working Group and fully support this conclusion.

In relation to IGOs, the Working Group reached a similar conclusion, i.e., that there is no principled reason at the moment to create a new and separate DRP applicable to IGOs. The Working Group's reasons for reaching this conclusion include the following:

1. An IGO currently has the ability to file a complaint under the UDRP and URS via an assignee, licensee or agent, thereby avoiding any direct concession on the issue of mutual jurisdiction;
2. There is only an extremely limited probability of a scenario where a losing respondent in a UDRP or URS proceeding files suit against the winning IGO in a national court such that the IGO might need to assert jurisdictional immunity in that court;
3. It is important to recognize and preserve a registrant's longstanding legal right to bring a case to a court of competent jurisdiction, and ICANN has no authority to deny such judicial access;
4. There is no single, universally applicable legal rule governing IGO jurisdictional immunity globally; and
5. Since the Working Group commenced its work, the GNSO Council has initiated a separate PDP on all the rights protection mechanisms that have been developed by ICANN, including the UDRP and URS; as such, any substantive changes to these curative rights processes need to be considered in a uniform manner in the absence of a clear legal argument or public policy rationale favoring a piecemeal approach in specific cases.

Additional Background to this Recommendation

The following two paragraphs are taken substantially from the Final Issue Report that outlined the scope of this PDP, and are provided herein as further background to this issue.

1. As recognized in the Final Issue Report scoping out this PDP, the scope of the UDRP and URS as drafted currently applies only to second level domain name disputes where the complainant has legal rights in a trademark or service mark, and the complaint alleges that the respondent's domain name is identical or confusingly similar to that trademark or service mark. The Final Issue Report had also noted that not all IGOs and INGOs will have trademarks in their names and acronyms, and that during the development of the Applicant Guidebook (AGB) for the New gTLD Program, while certain objection procedures and trademark rights-protection mechanisms had been created, the AGB did not contain any specific rules that pertained exclusively to either preventative (i.e. prevent the harm from occurring by excluding an identifier from registration or

delegation) or curative (i.e. an organization that claims to have suffered harm is able to file a dispute to cure the defect or problem) rights protections for IGOs or INGOs related directly to their status as international organizations. Rather, the AGB prescribed that organizations that met the existing criteria for a .int registration could avail themselves of the legal rights objection process, and organizations that owned trademark and other intellectual property rights in their names and/or acronyms could participate in the new Trademark Clearinghouse and the associated sunrise registration and Trademark Claims notice processes⁵.

2. The AGB also contained top-level protections for certain Red Cross and IOC identifiers, through which these Red Cross and IOC identifiers would be reserved and thus withheld from delegation under the New gTLD Program. Both the Red Cross and IOC are INGOs. Subsequently, interim second-level protections for certain Red Cross and IOC identifiers and for a specific list of IGO names and acronyms provided by the GAC were granted by the ICANN Board in response to advice from the GAC.

It is important to note that the second-level protections noted above were granted on an interim basis to allow new gTLDs to begin launching while policy development and consultations continued on the topic of what would be the appropriate second level protections for Red Cross and IOC names and acronyms, and IGO acronyms.

The final consensus level achieved for Recommendation #1: FULL CONSENSUS.

Recommendation #2:

The Working Group notes that an IGO may seek to demonstrate that it has the requisite standing to file a complaint under the UDRP or URS by showing that it has complied with the requisite communication and notification procedure in accordance with Article 6ter of the Paris Convention for the Protection of Industrial Property. An IGO may consider this to be an option where it does not have a registered trademark or service mark in its name and/or acronym but believes it has certain unregistered trademark or service mark rights for which it must adduce factual evidence to show that it nevertheless has substantive legal rights in the name and/or acronym in question. In this regard, the Working Group recommends that specific Policy Guidance be issued by ICANN to clarify the following points:

(a) this alternative mechanism for standing is not needed in a situation where an IGO already holds trademark or service mark rights in its name and/or

⁵ See, e.g., page 4 of the Final Issue Report (<https://gnso.icann.org/en/issues/igo-ingo-crp-access-final-25may14-en.pdf>).

acronym, as the IGO would in such a case proceed in the same way as a non-IGO trademark owner;
(b) whether or not compliance with Article 6ter will be considered determinative of standing is a decision to be made by the UDRP or URS panelist(s) based on the facts of each case; and
(c) the possibility that an IGO may seek to rely on its compliance with Article 6ter to demonstrate standing should not modify or affect any of the existing grounds which UDRP and/or URS panelists have previously found sufficient for IGO standing (e.g. based on statutes and treaties).

Under the UDRP and URS, the first substantive element that a complainant must satisfy under both procedures is that the complainant has rights in a trademark or service mark. Most UDRP panelists have read this requirement as a requirement for standing to file a complaint⁶, and it is generally accepted that the threshold may be satisfied by establishing either ownership or exclusive license rights in the trademark or service mark⁷.

The Working Group considered this requirement in the context of IGOs, with particular reference to the protections offered to IGOs under Article 6ter of the Paris Convention for the Protection of Intellectual Property. Initially, the Working Group concluded that, based on Article 6ter, IGOs which have complied with the communications and notifications procedure described in that treaty provision should be considered to have satisfied the standing requirement of the UDRP and URS. This was the preliminary recommendation in the Working Group's Initial Report that was published for public comment. However, following its review of comments received that provided additional information on the scope and nature of Article 6ter, the Working Group concluded that its original recommendation should be amended for the reasons listed below.

Additional Background to this Recommendation

The Working Group believes that an IGO's seeking to rely on its compliance with the Article 6ter procedure for the limited purpose of demonstrating standing will not necessarily result in an increased number of complaints, in view of the other factors to be considered by an IGO prior to filing a complaint (such as the need to submit to the Mutual Jurisdiction clause of the UDRP and URS, which may be interpreted to implicate any jurisdictional immunity an IGO may have) and the other substantive components of the UDRP and URS that will still need to be proven. The Working Group continues to

⁶ See, e.g., Halpern, Nard & Port, "Fundamentals of United States Intellectual Property Law: Copyright, Patent, Trademark" (Kluwer Law International, 2007).

⁷ See, e.g. Section 1.4 of WIPO's Jurisprudential Overview 3.0, issued in mid-2017: <http://www.wipo.int/amc/en/domains/search/overview3.0/>.

believe that these considerations more than offset the likelihood that the number and range of IGOs that may seek to rely on compliance with Article 6*ter* to demonstrate standing will be different from, and potentially larger than, the list of IGOs provided to ICANN by the GAC in 2013 and as may be updated by the GAC from time to time⁸.

From the start, the Working Group was aware that Article 6*ter* does not in and of itself confer substantive legal rights, or national trademark rights, on an IGO, although the Working Group believed that its inclusion in an international treaty nevertheless signaled a desire by States to afford some level of protection against unauthorized third party attempts to register an IGO's name or acronym as a trademark. Thus, and for the limited purpose of demonstrating that an IGO has the standing to file a complaint under the UDRP and URS, the Working Group originally considered this to be sufficiently analogous to the corresponding requirement in the trademark law context that the complainant possess rights in a trademark.

Specific comments were received in response to the Working Group's preliminary recommendation on this point, expressing concern that this could have the effect of elevating a treaty notification procedure to amount to trademark rights when the Article 6*ter* process does not have any substantive legal effect and is moreover not consistently applied by all States that are obliged to comply. Although several other commentators supported the Working Group's initial view, after careful review the Working Group concluded that the weight of the comments against its preliminary recommendation was more persuasive, especially as the favorable comments generally did not address the specific problems that were noted as a consequence of relying on Article 6*ter*. The Working Group also took into account the significant time that was spent at ICANN58 (in March 2017) and ICANN59 (in June 2017) discussing the legal implications and consequences of relying on Article 6*ter* for standing, where other community participants (including several with relevant legal expertise) expressed serious doubts about the advisability of retaining the original recommendation on standing.

To better assist the community in understanding how the Working Group came to its initial conclusion, the Working Group's previous consideration of Article 6*ter* has been excerpted from the Initial Report as Annex G to this Final Report. To view the comments received and discussions that took place over whether and how to modify that preliminary recommendation, please refer to the documents described and links provided in Section 7.2.

⁸ The current GAC list of IGOs for which appropriate protection was sought for their names and acronyms was sent to ICANN by the GAC in March 2013. It can be viewed here: <https://www.icann.org/en/news/correspondence/dryden-to-crocker-chalaby-annex2-22mar13-en.pdf>.

The final consensus level achieved for Recommendation #2: CONSENSUS

Recommendation #3:

ICANN shall issue Policy Guidance: (a) outlining the various procedural filing options available to IGOs, e.g. they have the ability to elect to have a complaint filed under the UDRP and/or URS on their behalf by an assignee, agent or licensee; and (b) advising IGOs and INGOs to, in the first instance and prior to filing a UDRP or URS complaint, contact the registrar of record to address the harms for which they are seeking redress. In addition, ICANN shall ensure that this Policy Guidance document is brought to the notice of the Governmental Advisory Committee (GAC) for its and its members' and observers' information, and published along with the procedures and rules applicable to the UDRP and URS on the ICANN website.

This recommendation originated in the Working Group's initial preliminary recommendation (published in its Initial Report) concerning an IGO's standing to file a UDRP or URS complaint based on compliance with the communications and notification procedure under Article 6*ter* of the Paris Convention. In that preliminary recommendation, the Working Group had made a distinction between the procedural matter of standing and the further need for a complainant to prove that it has also satisfied the substantive elements required by the UDRP and URS. The Working Group had therefore recommended that a Policy Guidance document be prepared and issued by ICANN to clarify the applicability of Article 6*ter* as well as the other procedural options available to IGOs. In light of the Working Group's subsequent decision to modify its original recommendation concerning Article 6*ter*, its recommendation for Policy Guidance has been modified accordingly, although the Working Group believes it remains important to specifically highlight various procedural filing options available to IGOs under the current UDRP and URS. The Working Group agreed that an IGO's ability to elect alternative procedural filing mechanisms allows an IGO to avoid the need to agree to Mutual Jurisdiction, thereby potentially preserving its ability to claim any jurisdictional immunity to which it may be entitled in subsequent judicial proceedings⁹.

⁹ The possibility of filing via an assignee was acknowledged by Professor Edward Swaine (the external legal expert retained to advise the Working Group on IGO jurisdictional immunity) in his memorandum (at pages 25-26; see Annex F). In addition, the Working Group's attention had been drawn to a number of cases where IGOs had either filed UDRP complaints itself (see, e.g., [http://www.wipo.int/amc/en/domains/decisions/html/2002-d2002-0222.html](http://www.wipo.int/amc/en/domains/decisions/html/2002/d2002-0222.html)) and thereby presumably waived any jurisdictional immunity it might otherwise have been entitled to, or via a third party that appeared to be a trademark assignee (see, e.g., <http://www.wipo.int/amc/en/domains/search/text.jsp?case=D2012-1922>). The WIPO Jurisprudential Overview recognizes the validity of UDRP complaints being filed by an assignee or exclusive licensee: <http://www.wipo.int/amc/en/domains/search/overview3.0/>.

The Working Group also agreed that it will be helpful to develop Policy Guidance advising IGOs and INGOs to, in the first instance, contact the registrars of record for the disputed domains since registrars have an obligation under their agreement with ICANN to deal with such harms at no cost and in a timely manner for both infringing and non-infringing domains¹⁰.

The final consensus level achieved for Recommendation #3: CONSENSUS

Recommendation #4:

Notwithstanding GAC advice concerning access to curative rights processes for IGOs as well as the Charter language requiring the Working Group to consider “the need to address the issue of cost to IGOs and INGOs to use curative processes”, there was no support within the Working Group for a recommendation to provide subsidies to any party to use the UDRP or URS. Nevertheless, the Working Group recognizes that it has no authority to obligate the expenditure of ICANN funds, and it understands, further, that the feasibility of providing IGOs with access to the UDRP and URS at no or nominal cost to the IGOs is a question that must be addressed directly through discussions between the ICANN Board with the GAC and IGOs. The Working Group also notes that many Working Group members believe that a respondent should also be eligible to receive financial support for its defense in a case where ICANN has subsidized the complainant

The Working Group notes that its Charter does not authorize it to make recommendations that would create a monetary obligation for ICANN or any other party to provide subsidies for particular groups of complainants, or that would otherwise require ICANN to cover the costs (whether in full or substantially) of any particular entity’s filing of a UDRP or URS complaint. Nevertheless, in view of GAC advice on the topic¹¹, it is within the Working Group’s Charter scope to recommend that ICANN investigate the feasibility of providing IGOs and INGOs with the ability to file UDRP and URS complaints at no or minimal cost. The Working Group further notes that it made inquiry of the GAC in regard to whether the existing fee levels for the UDRP and URS were considered “nominal”, but received no clear response on that question.

The Working Group believes it is important to emphasize that no Working Group member supports the provision of subsidies to any party (including an IGO or INGO) for using the UDRP or URS. As noted in Section 1 above, a number of specific suggestions were made for the Board and community to consider should discussions with the GAC

¹⁰ See the text of ICANN’s Registrar Accreditation Agreement, including Section 3.18: <https://www.icann.org/resources/pages/approved-with-specs-2013-09-17-en#3.18>.

¹¹ See, e.g., the GAC’s Los Angeles Communique (October 2014): <https://www.icann.org/en/system/files/correspondence/gac-to-board-15oct14-en.pdf>.

on this topic be initiated, e.g. the creation of an objective standard for financial support, setting specific quantitative limits such as a specific dollar amount per year per IGO, or introducing some form of means testing. A few Working Group members also believe that, to the extent any subsidies are eventually provided for particular groups of complainants (e.g. IGOs), the same should also be made available to respondents.

The final consensus level achieved for Recommendation #4: CONSENSUS

Recommendation 5:

Where a losing registrant challenges the initial UDRP/URS decision by filing suit in a national court of mutual jurisdiction and the IGO that succeeded in its initial UDRP/URS complaint also succeeds in asserting jurisdictional immunity in that court, the decision rendered against the registrant in the predecessor UDRP or URS shall be set aside (i.e. invalidated).

As with its deliberations and subsequent decision to modify its initial recommendation on standing, the Working Group spent a significant amount of time discussing the comments that were received to its preliminary recommendations on the topic of IGO jurisdictional immunity. In its Initial Report, the Working Group had also solicited community input on two options then under consideration, for dealing with the outcome of a successful challenge by an IGO to a court's claiming jurisdiction over it. These two options were:

Option 1 - the decision rendered against the registrant in the predecessor UDRP or URS shall be vitiated, or

Option 2 – the decision rendered against the registrant in the predecessor UDRP or URS may be brought before the [name of arbitration entity] for de novo review and determination.

The Working Group reviewed numerous comments that were submitted on both the issue of jurisdictional immunity and the two options on this topic. As part of its deliberations, the Working Group discussed the benefits and risks (including their likelihood and potential impact) of implementing either of the two options. Further Working Group discussions following the close of public comments to its Initial Report, including at community sessions at ICANN59 (in June 2017) and ICANN6 (in October 2017), contributed to the development of additional options suggested by Working Group members, for a final total of six policy options on the question of IGO jurisdictional immunity in the context of the filing of a UDRP or URS complaint by an IGO.

The final six policy options, with the associated outcome following the end of the Working Group’s formal consensus call process, were¹²:

Option 1:

Where a losing registrant challenges the initial UDRP/URS decision by filing suit in a national court of mutual jurisdiction and the IGO that succeeded in its initial UDRP/URS complaint also succeeds in asserting jurisdictional immunity in that court, the decision rendered against the registrant in the predecessor UDRP or URS shall be set aside (i.e. invalidated).

This option was suggested to align with the situation where an IGO, instead of filing a UDRP or URS complaint, chooses to file a lawsuit in court. In such an event, the IGO will not be entitled to any jurisdictional immunity (having elected to initiate the proceedings) and the court will proceed to decide the case on its merits.

Consensus Call Outcome: CONSENSUS (this is therefore the Working Group’s Consensus Recommendation #5 as noted above)

Option 2:

In relation to domain names with a CREATION DATE before the (Policy Effective Date), then Option 1 applies. In relation to domain names with a CREATION DATE on or after the (Policy Effective Date), Option 3 shall apply. After five (5) years or 10 instances of Option 3 being utilized, whichever occurs first, ICANN and the various dispute resolution providers (including any who have administered arbitration proceedings under the new Option 3) will conduct a review to determine the impact, both positive and negative, as a result of “trying out” Option 3.

This option was suggested as a compromise between Option 1 and Option 3, allowing in addition for empirical assessment of the effects of both options after a certain period of time.

Consensus Call Outcome: NO CONSENSUS/DIVERGENCE

Option 3:

Where a complainant IGO succeeds in a UDRP/URS proceeding, the losing registrant proceeds to file suit in a court of mutual jurisdiction, and the IGO

¹² For details of the Working Group’s deliberations on these options, refer to the recordings and transcripts of the various Working Group meetings that took place between October 2017 & June 2018, all available at: <https://community.icann.org/x/AQC8B>. Additional details have also been provided by those Working Group members who filed minority statements (see Annex B).

subsequently succeeds in asserting jurisdictional immunity, the registrant shall have the option to transfer the dispute to an arbitration forum meeting certain pre-established criteria for determination under the national law that the original appeal was based upon, with such action limited to deciding the ownership of the domain name. The respondent shall be given 10 days (or a longer period of time if able to cite a national statute or procedure that grants a period longer than 10 days) to either: (1) inform the UDRP/URS provider [and the registrar] that it intends to seek arbitration under this limited mechanism; or (2) request that the UDRP/URS decision continue to be stayed, as the respondent has filed, or intends to file, case in court against the IGO's successful assertion of immunity. An IGO which files a complaint under the UDRP/URS shall be required to agree to this limited arbitration mechanism when filing the complaint. If, subsequently, it refuses to participate in the arbitration, the enforcement of the underlying UDRP/URS decision will be permanently stayed. The parties shall have the option to mutually agree to limit the original judicial proceedings to solely determining the ownership of the domain name. Subject to agreement by the registrant concerned, the parties shall also be free to utilize the limited arbitration mechanism described above at any time prior to the registrant filing suit in a court of mutual jurisdiction. In agreeing to utilize the limited arbitration mechanism, both the complainant and respondent are required to inform ICANN.

This option was suggested in an attempt to balance the group's agreement that any additional avenues for dispute resolution should be permitted (if at all) only after an IGO has successfully claimed immunity in court with GAC advice for post-UDRP and post-URS proceedings to be handled by an arbitral tribunal rather than via judicial proceedings.

Consensus Call Outcome: MINORITY VIEW (WITH CONSENSUS AGAINST THIS OPTION)

Option 4:

Our initial report and recommendation (that no change is required) remains valid and should be reflected in the published report of this WG. Our report should advise that even if a change were advisable or appropriate, such would necessarily require modifications to the UDRP/URS and its accompanying rules. As such changes are within the ambit of the Review of All Rights Protection Mechanisms (RPM) PDP Working Group, we feel it inappropriate to inject our proposals in that regard. Accordingly, this Working Group strongly recommends that the GNSO Council consult with RPM Working Group and the IGOs participating in the GAC, on whether any changes (if any) to how the UDRP procedure and URS are drafted and employed for IGOs should be referred to the RPM Working Group for consideration within its broader mandate to review the UDRP/URS.

This option was suggested in view of the controversial nature of the topic of IGO immunity as against a registrant's right to legal recourse, and the broader mandate of

the RPM Working Group that was chartered by the GNSO Council after this Working Group commenced its work.

Consensus Call Outcome: STRONG SUPPORT BUT SIGNIFICANT OPPOSITION

Option 5:

The text of both the UDRP and URS rules and policies shall be modified so that, in the event a domain name dispute (UDRP or URS) is initiated by an IGO as complainant and a registrant commences an "in rem" action in a court of mutual jurisdiction concerning that domain name, the registrar shall treat that court action in the same manner as if an "in personam" action had been brought directly against the IGO.

This option was suggested as a technical fix to permit registrars to treat "in rem" and "in personam" actions in the same manner in terms of the locking of disputed domain names. Immunity issues in the type of proceedings under discussion are not likely to arise in "in rem" cases.

Consensus Call Outcome: NO CONSENSUS/DIVERGENCE

Option 6:

We should arrange for the UDRP providers [to] provide [mediation] at no cost to the parties. The UDRP already permits the resolution of disputes through arbitration - I would bind the IGOs to arbitration in the same way the Mutual Jurisdiction clause binds complainants to the registrant's judicial system. Where an IGO refuses to take part in a judicial proceeding or judicial or arbitral proceedings, or successfully asserts immunity in a judicial proceeding, any prior UDRP determination would be quashed.

This option was suggested following a review of the mandatory mediation step that is included in Nominet's DRP for the .uk domain, and includes the ability to introduce an arbitration component (which the registrant is free to choose as an alternative to judicial proceedings) as well as aspects of Option 1.

Consensus Call Outcome: STRONG SUPPORT BUT SIGNIFICANT OPPOSITION

Additional Background to this Recommendation

The Working Group anticipates that the circumstances under which this scenario would occur – viz., where an IGO files a complaint under the UDRP or URS, the IGO succeeds in

the dispute resolution process¹³, and the losing respondent then seeks relief against the IGO with respect to that UDRP or URS decision in a national court – will be rare. As noted for the Policy Guidance document recommended by the Working Group, IGOs are able to file complaints through an assignee, licensee or agent as a means of insulating themselves against any direct concession on mutual jurisdiction.

Where a losing registrant proceeds to file a complaint in a court against an IGO that had prevailed in a UDRP or URS proceeding, a fundamental question for the court is whether or not, by submitting to the Mutual Jurisdiction clause for purposes of the UDRP or URS proceeding, an IGO will be deemed to have waived any jurisdictional immunity it may otherwise have. In this regard, the court could find that any immunity that may have been claimed by an IGO in respect of a case brought before the court by a losing registrant was lost simply by the IGO having filed the UDRP or URS complaint. This possibility is not new¹⁴, and exists in the current environment under the present language of the Mutual Jurisdiction clause. It will continue to be the case regardless of whether an option to permit arbitration following a UDRP or URS proceeding is adopted by ICANN as a consensus policy. At least one Working Group member believes that agreeing to the Mutual Jurisdiction clause (as is required in order to file a UDRP or URS complaint) will lead to most, if not all, courts ruling that the IGO in question will therefore have ceded any jurisdictional immunity to which it may otherwise have claimed.

The Working Group also notes that, in this context, the question of IGO jurisdictional immunity arises when an IGO is the defendant in a court proceeding brought by a losing respondent, since the creation of the UDRP and URS has meant that an IGO will now no longer need to file suit in court as a plaintiff. One concern that has been expressed in this regard is the need to ensure that no additional legal rights are created as a result of any consensus policies developed through the ICANN process. On this point, the Working Group agreed that any policies developed by ICANN should reflect the underlying legal rights which are already protected by national laws. The Working Group agreed that the UDRP and URS were designed to complement (not supersede or replace) existing legal rights, by functioning as additional avenues of recourse for rights-holders to enforce their existing rights.

The Working Group's deliberations on the topic of IGO jurisdictional immunity following the publication of its Initial Report in January 2017 continued through mid-2018. This next section describes the findings of an international legal expert that the Working

¹³ As noted by Professor Swaine, IGOs have filed and prevailed in UDRP proceedings: see, e.g., footnote 5 of Professor Swaine's memo (Annex F).

¹⁴ This possibility was also acknowledged by Professor Swaine in his memo: see, e.g., Page 3 & 6 (Annex F).

Group consulted on the topic, as well as the various policy options that it developed in an attempt to reach consensus on this issue.

The Working Group's Deliberations on Whether to Recommend the Creation of a Separate Dispute Resolution Mechanism for IGOs

A. Consultation with an external legal expert on the issue of IGO jurisdictional immunity

For the purpose of understanding the scope and limitations of public international law in relation to the issue of IGO jurisdictional immunity, the Working Group requested that ICANN engage an external legal expert to advise the Working Group of the current state of the law on this topic. Professor Edward Swaine of George Washington University in the USA was engaged following a detailed evaluation by the Working Group of the qualifications of other interested candidates¹⁵.

Professor Swaine's final expert opinion was considered by the Working Group in June 2016¹⁶. In sum, Professor Swaine's opinion was that:

There is no single universal rule that is applicable to IGOs' jurisdictional immunity globally. Rather, such immunity is essentially contextual - IGOs generally enjoy immunity under international law, but different jurisdictions apply the law differently, and even within the same jurisdiction different IGOs may be treated differently:

- *Immunity obligations vary by state and by IGO concerned;*
- *Immunity decisions are often based on organization-specific treaties to which not all states are party;*
- *States subject to the same international obligations may implement them in varying ways; and*
- *Every jurisdiction resolves immunity questions according to its own law (the "law of the forum", as informed by international law).*

On the other hand, under the UDRP and URS, a complainant is compelled to consent to a Mutual Jurisdiction (defined as either the domain name registrar or registrant) for purposes of an appeal from a panel's initial determination of a complaint. Thus, an IGO that files a complaint will therefore have agreed to the

¹⁵ For details about the criteria agreed on for this engagement, see the Working Group's wiki space at <https://community.icann.org/x/z4BYAw>.

¹⁶ For the full text of Professor Swaine's memo, see Annex F of this report and the Working Group's wiki space at <https://community.icann.org/x/z4BYAw>.

possibility of a judicial process, regardless of any immunity it might otherwise enjoy under international law.

According to Professor Swaine, under current international law principles as understood generally, there are three types of jurisdictional immunity which an IGO might claim – absolute, restrictive and functional. An IGO that is entitled to absolute immunity would be entitled to comprehensive immunity from judicial process, irrespective of the nature of the IGO’s activity, in the absence of an express (and strictly construed) waiver (for example, the United Nations and other IGOs protected in certain States by specific treaties binding those States, or bilateral arrangements between States).

Under a restrictive immunity approach, however, an exception from absolute immunity is made for litigation concerning commercial activities like those undertaken by private parties – however, with the notable exception of the United States, relatively few states have adopted this approach. The Working Group notes in this regard that the UDRP and URS were designed to apply to trademark related disputes, which are generally viewed as commercial in nature.

Finally, under a functional immunity approach, an IGO’s immunity with respect to a particular jurisdiction is limited to the functions of the IGO in question. For example, certain jurisdictions may have legislative language which limits the extent of IGO jurisdictional immunity to the “privileges and immunities as are reasonably necessary for the fulfilment of their functions”. While a functional immunity approach can overlap with a restrictive immunity approach, the distinction may be critical – for instance, a non-infringing use of its domain may be necessary for an IGO to carry out its mission regardless of whether the activities are commercial or not in nature. However, without discounting the importance of loss of monies, impact to reputation, or other harms that may result from an infringed domain, the Working Group is not able to say for certain that a third party’s infringing registration of a domain name would necessarily impede an IGO in carrying out its core mission within the scope of a functional immunity inquiry.

The Working Group agreed with Professor Swaine’s assessment and concluded that *“there is no single universal rule that is applicable to IGOs’ jurisdictional immunity globally.”* This lack of a universal rule made it challenging to justify declaring the mutual jurisdiction provisions in the UDRP and URS inapplicable to IGOs, as an IGO’s immunity is highly dependent upon the particular jurisdiction and the nature of the specific IGO, amongst other factors. Accordingly, the Working Group did not feel it was appropriate for ICANN to create a separate, narrowly-tailored dispute resolution procedure that presumed that every IGO would be able to successfully assert immunity in every instance in which a losing domain registrant sought a de novo court determination.

Professor Swaine also analyzed how, outside the domain name arena, IGOs are generally able to waive their jurisdictional immunity, and he noted that there seems to be two main ways to accomplish this: (1) through the IGO’s governing instrument (though Professor Swaine noted that the exact scope of this can be unclear); or (2) by

way of agreement or pleading (for which option the case law is not well developed). Professor Swaine also expressed the thought that an IGO's agreeing to a Mutual Jurisdiction under the UDRP or URS could be interpreted as a waiver.

In essence, Professor Swaine's legal conclusion in relation to an IGO's jurisdictional immunity for purposes of a domain name dispute under the UDRP or URS was that "[a]llowing an IGO that prevailed in the UDRP process to avoid its waiver and rest on the UDRP result by invoking immunity, while allowing it to waive that immunity by initiating judicial proceedings if it loses to a domain-name registrant, will likely seem asymmetrical and unfair." Based on Professor Swaine's expert opinion, the Working Group came to the conclusion that it would not be possible to recommend a single solution that takes into account all the varying types of IGOs, their activities and the different approaches of multiple national courts as well as the potential facts of a hypothetical UDRP or URS filing. Nevertheless, the Working Group strove to achieve an outcome that acknowledges an IGO's ability to assert jurisdictional immunity, balanced against a registrant's right to have appropriate and available legal recourse after initially losing a UDRP or URS determination.

B. The Working Group's consideration of Professor Swaine's suggestions and the available policy options

Professor Swaine's opinion was largely focused on the question of what might happen in the case where an IGO files a complaint under the UDRP or URS and wins at the administrative proceedings phase, following which a losing respondent files a claim in a national court against that initial determination. In view of this focus, various policy options were identified for addressing the IGOs' concern over losing the possibility of jurisdictional immunity for this type of proceeding.

In this regard, the Working Group initially discussed the following policy options noted by Professor Swaine:

(i) Make a distinction among different types of IGOs:

- This option would maintain the existing Mutual Jurisdiction terms in general, but permit particular IGOs to elect instead to submit to arbitration. An option for such arbitration would be the arbitration rules under the UNCITRAL Rules or some similar, internationally recognized procedure.
- In line with Professor Swaine's analysis, the most likely IGOs that would be able to elect an arbitration option would be the United Nations and its constituent bodies (e.g. WIPO, WTO, WHO).

(ii) Rewrite the Mutual Jurisdiction clause under the UDRP and URS, but without prejudging the outcome where an IGO pleads jurisdictional immunity:

- Adopting this option would mean that IGO immunity may not be assumed in circumstances where the relevant jurisdiction would not be inclined to afford it (e.g. its courts apply a functional or restrictive approach and regard the activity as beyond the scope of immunity). Essentially, this option would leave the determination of an IGO's jurisdictional immunity from domain name disputes in any particular jurisdiction to the judgment of that particular national court.
- Professor Swaine had suggested that additional language (in the form of an exception) could be added to the UDRP and URS as follows:

“In the event the action depends on the adjudication of the rights of an international intergovernmental organization that would, but for this provision, be entitled to immunity from such judicial process according to the law applicable in that jurisdiction, [as established by a decision of a court in that jurisdiction,] the challenge must be submitted instead for determination [by UNCITRAL in accordance with its rules.]”

The Working Group also noted the possibility, highlighted by Professor Swaine, that any hardship endured by a respondent as a result of submission to an arbitral process should be alleviated, e.g. by the IGO's agreeing to bear a proportion of the costs incurred. Given the stated desire of IGOs to have access to curative rights protections at no or exceedingly low cost, however, as reflected in GAC advice on the topic, the Working Group concluded that such an approach would elicit objections from them.

The Working Group spent considerable time reviewing Professor Swaine's notes and final memo, including in open sessions at the ICANN Public Meetings in Marrakech (March 2016) and Helsinki (June 2016). It also considered the applicability and scope of the UNCITRAL Rules¹⁷ to domain name disputes between IGOs and registrants, and noted that the issue of immunity is likely to arise only in those limited cases where a losing respondent (against an IGO complainant, who would have agreed to the Mutual Jurisdiction clause in order to file and proceed with its complaint) files a court case against the UDRP or URS determination.

Ultimately, the Working Group concluded that, in relation to the issue of IGO jurisdictional immunity, the most prudent and advisable approach would be not to recommend any changes to the substantive grounds of the UDRP or URS at this time. Having considered all the policy options and the varying interests at stake, the only change that the Working Group agreed may be required as an outcome of this PDP is an

¹⁷ For the full text of the UNCITRAL Rules, see http://www.uncitral.org/uncitral/en/uncitral_texts/arbitration/2010Arbitration_rules.html.

amendment to the relevant parts of the UDRP and URS in order to implement the Working Group's Recommendation #5.

C. Other research and documentation taken into account by the Working Group on this issue

Besides Professor Swaine's expert views, the Working Group also considered research and prior work done on this topic. This included the August 2003 report from the WIPO Secretariat on a possible arbitral appeal mechanism for domain name disputes involving country names, which could conceivably also apply to IGO names and acronyms¹⁸. The Working Group notes that, in this report, the WIPO Secretariat had expressly stated that the following principles ought to apply if a *de novo* arbitration process is to be created:

- The parties should be able to restate their case completely anew. They should not be confined to claiming that the panel did not consider certain relevant facts or wrongly applied the procedure, but should also be able to submit new evidence and new factual or legal arguments;
- In order to provide a meaningful "appeal," conducting a *de novo* arbitration should, as a general rule, not be more burdensome than conducting litigation in a court of mutual jurisdiction;
- The arbitral tribunal should consist of one or more neutral and independent decision makers, who should not be identical or related to the panelists who rendered the initial decision; and
- Either party should be able to present its case in a complete manner. The arbitral tribunal should, for example, have the authority to allow for, or request, additional written submissions, and it should be possible to hold in-person hearings

¹⁸ See www.wipo.int/edocs/mdocs/sct/en/sct_11/sct_11_5.doc. The Working Group acknowledges that, in this report, the WIPO Secretariat noted that "[i]n order to strike a balance between the privileges and immunities of sovereign States on the one hand, and the right of a losing UDRP respondent to have the dispute reconsidered in a neutral forum on the other, WIPO member States also recommended to allow IGOs to submit to a special appeal procedure by way of *de novo* arbitration rather than to the jurisdiction of certain national courts of justice". However, for reasons stated in the main text, the Working Group respectfully disagrees with this proposal and notes, further, that in the General Assembly report of the proceedings at hand, there was not agreement on the need to protect IGO names and acronyms and country names in this manner (see WO/GA/28/7: http://www.wipo.int/edocs/mdocs/govbody/en/wo_ga_28/wo_ga_28_7.pdf).

From publicly available information reviewed by the Working Group, it appears that no further action was taken on the above-noted *de novo* arbitral appeal mechanism. In light of the fact that it has been over a decade since that proposal was scoped, and given that the Working Group's recent research revealed that some IGOs do in fact waive their immunity and submit to the Mutual Jurisdiction clause in bringing a UDRP action¹⁹, the Working Group concluded that present circumstances do not justify amending the UDRP and URS in order to provide IGOs with broad immunity protections.

D. Consideration of GAC Advice and the IGO Small Group Proposal

Please see Section 3.4 below for a full discussion of the Working Group's discussion of GAC advice to the ICANN Board concerning the topic of IGO protections as well as the 2016 proposal developed by the IGO Small Group for consideration by the GAC and the GNSO.

E. Consideration of Additional Policy Recommendations on IGO Jurisdictional Immunity

Please see Section 3.5 below for a fuller discussion of how the Working Group approached, and ultimately handled, the various policy options developed to deal with the issue of IGO jurisdictional immunity.

¹⁹ See, e.g., the resources and links compiled by the Working Group at <https://community.icann.org/x/48PhAg> and the cases cited on this point by Professor Swaine in his memo (Annex F).

3 Deliberations of the Working Group

3.1 Review of Existing Materials

The Working Group began its work with a review of the historical documentation and related materials on the topic. This included both the records of prior ICANN community work as well as materials from other sources (such as treaty texts and reports from international organizations, in particular, WIPO²⁰). To review these materials, the Working Group formed three Sub Groups – Sub Group A focused on the current state of the UDRP and URS²¹, Sub Group B on the number of IGOs and INGOs that could come under consideration as well as the scope of their existing legal protections²², and Sub Group C on ICANN’s historic treatment of these two groups of organizations²³. ICANN staff also conducted research on the existence of national trademark registrations in a number of jurisdictions for selected IGO and INGO names and acronyms²⁴.

A partial list of the more significant documents and materials that were reviewed includes:

- The 2001 Final Report on the Second WIPO Internet Domain Name Process (also known as the “WIPO-2 Process”)²⁵
- The 2003 WIPO Secretariat Paper on a Possible De Novo Appeal Mechanism for Country Names²⁶
- The 2004 Final Report of ICANN’s Joint Working Group on the WIPO-2 Process
- The 2005 WIPO Paper on Legal and Administrative Aspects of Article 6ter²⁷
- The 2007 GNSO Issue Report on Dispute Handling for IGO Names and Abbreviations²⁸

²⁰ See the Working Group’s wiki page at <https://community.icann.org/x/DrvHAg> for a compilation of these sources.

²¹ Sub Group A has a wiki page at <https://community.icann.org/x/mRbxAg> showing its task list and status updates.

²² Sub Group B has a wiki page at <https://community.icann.org/x/mxbxAg> showing its task list and status updates.

²³ Sub Group C has a wiki page at <https://community.icann.org/x/nRbxAg> showing its task list and status updates.

²⁴ The scope of this limited initial research and lists of organizations can be viewed on the Working Group’s wiki page at <https://community.icann.org/x/wl4QAw>.

²⁵ <http://www.wipo.int/export/sites/www/amc/en/docs/report-final2.pdf>.

²⁶ http://www.wipo.int/meetings/en/doc_details.jsp?doc_id=18680.

²⁷ http://www.wipo.int/edocs/mdocs/sct/en/sct_15/sct_15_3.doc.

²⁸ <https://gnso.icann.org/en/issues/igo-names/issues-report-igo-drp-15jun07.pdf>.

- The 2007 ICANN Staff Report and Draft Text for a Dispute Resolution Process for IGO Domain Names²⁹
- The 2013 Final Report of the PDP Working Group on Protection of IGO and INGO Identifiers in All gTLDs³⁰

In addition, the Working Group reviewed the GAC Communiqués and other GAC advice and correspondence that have been issued to date concerning the issue of protection for IGO names and acronyms³¹. ICANN staff also prepared several Briefing Papers and background notes on a number of external sources and reports to assist with the Working Group's review and deliberations.

The following summary highlights the salient aspects of the above-referenced documents:

- The 2001 Final Report on the Second WIPO Internet Domain Name Process contains a recommendation that the names and acronyms of IGOs benefiting from protection under Article 6*ter* of the Paris Convention be protected from abusive registrations of domain names within the domain name system (DNS). The recommendation for protection was by way of a special administrative procedure to be developed and supervised by the constituent members of IGOs (namely, States), and enforced within the DNS through the ICANN system. Notably, the Report acknowledged that, at least in cases not involving the use of domain names as trademarks, establishing such a procedure would require the creation of new international law.
- The 2003 WIPO Secretariat Paper on a Possible De Novo Appeal Mechanism for Country Names noted that WIPO member States had recommended that the UDRP should be modified to allow IGOs to file complaints in respect of the abusive registration of their protected names and acronyms, but that a number of IGOs, including the United Nations, had indicated that they could not participate in a dispute resolution process which, like the UDRP, would require the organization to submit to the jurisdiction of national courts following the mandatory administrative proceeding. It therefore recommended allowing IGOs to submit to a special appeal procedure by way of de novo arbitration. However, another section of the same paper notes that, while the option of bringing the dispute before a court of competent jurisdiction is open to both parties, it is

²⁹ <https://gnso.icann.org/drafts/gnso-igo-drp-report-v2-28sep07.pdf>.

³⁰ <https://gnso.icann.org/en/issues/igo-ingo-final-10nov13-en.pdf>.

³¹ These have been collated (up to early 2017) and can be viewed at <https://gacweb.icann.org/display/GACADV/IGO+and+INGO+Names>.

particularly important for a losing respondent, for whom the UDRP procedure initiated by the complainant was mandatory. The paper notes further that for a losing respondent who had to submit to the UDRP in the domain name registration agreement, the possibility of initiating court litigation in at least one convenient forum is an important due process safeguard. The paper acknowledged that the requirement for UDRP complainants to submit to a “mutual jurisdiction” does not prevent either party from initiating court litigation elsewhere and, similarly, a State’s submission to de novo arbitration should not restrict either party’s recourse to a national court of justice.

- The 2005 WIPO Paper on Legal and Administrative Aspects of Article 6*ter* noted that Article 6*ter* provides a degree of legal protection to abbreviations and names of IGOs, of which at least one member State is a member of the Paris Union; that Article 6*ter* is applicable to the States party to the Paris Convention as well as to all Members of the World Trade Organization (WTO), whether or not party to the Paris Convention, by virtue of Article 2.1 of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement); and, that as of August 2005, 141 IGOs had requested communications that had subsequently been sent by the International Bureau of WIPO to those States that were party to the Paris Convention as well as to the Members of the WTO that were not party to the Paris Convention.
- The 2007 GNSO Issue Report on Dispute Handling for IGO Names and Abbreviations recommended that a separate DRP be developed for IGO names and abbreviations as domain names at the second or third level in new gTLDs, and that once the process was developed, the GNSO Council consider launching a PDP to investigate its application to existing gTLDs. However, no further action was taken by the Council in regard to this staff recommendation, and no PDP to investigate the possibility was launched until the chartering of the present Working Group.
- The 2007 ICANN Staff Report and Draft Text for a Dispute Resolution Process for IGO Domain Names was delivered three months after the above referenced Issue Report. It contained a proposed DRP in relation to the suggestion in the Issue Report that could be applicable to new gTLDs. The scope of the proposed process was that it would apply to complaints initiated by IGOs where there was a registration or use, as a domain name, of the complainant’s name or abbreviation that has been communicated under Article 6*ter* of the Paris Convention. It would have permitted either party to appeal an initial determination to an arbitral tribunal for independent resolution, but did not identify what tribunal might have such jurisdiction. Again, neither the GNSO Council nor ICANN took any action to implement this proposed mechanism, and no such process was included within the AGB for the 2012 New gTLD Program.

- The 2013 Final Report of the PDP Working Group on Protection of IGO and INGO Identifiers in All gTLDs dealt solely with preventative protections for the Red Cross/Red Crescent, IOC, INGOs, and IGOs, and not with potential curative rights mechanisms except to recommend that an Issue Report on the topic be created. This led to the Issue Report that scoped the issues for this current PDP.

3.2 Status of Previous ICANN Work

The Working Group's review of the historical materials confirmed that the issue of appropriate handling of domain name disputes relating to IGO names and, especially, acronyms, has been a long standing one in both the ICANN and international multilateral community. For example, in 2003, an ICANN Joint Working Group comprising community members from the At Large Advisory Committee (ALAC), the GAC and the GNSO had discussed options for handling domain name disputes involving IGOs, following the WIPO-2 Process. That Joint Working Group failed to reach consensus on any recommendations, and as a consequence no formal action was taken by the GNSO Council or ICANN on the matter. Subsequently, in 2007, a GNSO Issue Report on Dispute Handling for IGO Names & Abbreviations noted a number of possible methods for handling domain name disputes concerning IGO names and abbreviations. However, a PDP was not initiated on the topic at the time, as the requisite number of GNSO Council votes for launching a PDP was not attained.

The topic of IGO names and acronyms, and more specifically, the question of appropriate protection for such identifiers in the DNS, arose again during the development of the 2012 New gTLD Program expansion round. The AGB for the Program did not initially contain specific protections for IGOs, although it provided for the ability of organizations meeting the existing criteria for a .int registration to file objections under the prescribed legal rights objection process. The AGB also contained provisions allowing organizations that owned trademark and other intellectual property rights in their names and/or acronyms to enter those identifiers into the new Trademark Clearinghouse and as a result participate in the Sunrise Registrations and Trademark Claims Notice protections offered through the Clearinghouse. These organizations could also access and use the new URS procedure, on the basis of their having ownership of a relevant trademark.

In June 2011, the ICANN Board directed that top-level prohibitions on the delegation of certain Red Cross and IOC identifiers be included in the final AGB. In November 2012, second-level protections for certain Red Cross and IOC identifiers were added to the list of identifiers that new gTLD registry operators were obliged to withhold from registration. These protections were intended to be interim measures, applicable during

the period in which the GAC and GNSO continued to develop policy advice concerning appropriate protections for these two INGOs at the top and second level. Subsequently, the Board granted temporary protection for a specific list of IGO names and acronyms provided by the GAC³², in response to advice from the GAC, again on an interim basis, to allow gTLDs approved under the 2012 New gTLD Program to begin launching while policy development work continued.

The GNSO concluded an expedited PDP on the protection of IGO and INGO identifiers in all gTLDs in November 2013. The consensus recommendations from this PDP were adopted unanimously by the GNSO Council³³; however, some of those recommendations were inconsistent with GAC advice on the topic and in April 2014 the ICANN Board approved only those GNSO recommendations that were viewed as consistent with GAC advice³⁴. For purposes of this current PDP, the inconsistent recommendation of greatest relevance is the different perspective of the GAC and the GNSO on the question of protection for IGO acronyms. Where the GAC had advised that protection for IGO acronyms be of a permanent nature and disputes should be resolved via binding third party arbitration, the GNSO had recommended that IGO acronyms be protected via the Trademark Clearinghouse mechanism of a 90-days Claims Notice period. The inconsistency between the GAC advice and GNSO recommendations on this point remains unresolved, and led to the formation of the IGO Small Group in 2014, whose eventual proposal and its consideration by this Working Group is detailed further below, in Section 3.4.

3.3 Review of Legal Instruments, Legal Expert Opinion and Other External Source Materials

Consideration of the needs and concerns of INGOs

Assisted by the reports of its three Sub Groups that reviewed the historical documentation on the topic, the Working Group came to the preliminary conclusion early on in its deliberations that there was no substantive principled reason to accord any special treatment to INGOs (including the Red Cross movement and the IOC, which

³² The GAC's list of IGOs was provided to ICANN in March 2013:

<https://www.icann.org/en/news/correspondence/dryden-to-crocker-chalaby-annex2-22mar13-en.pdf>;
the criteria for inclusion on the GAC list was noted here:

<https://www.icann.org/en/news/correspondence/dryden-to-crocker-chalaby-annex1-22mar13-en.pdf>.

³³ See <http://gnso.icann.org/en/council/resolutions#20131120-2>.

³⁴ Those consistent policy recommendations that were approved by the Board are now the subject of Consensus Policy, effective 1 August 2018, following the completion of implementation work by an Implementation Review Team: <https://www.icann.org/news/announcement-2018-01-16-en>.

had been specific subjects of analysis under a previous GNSO PDP) in relation to either amendment of existing, or development of a new, dispute resolution process. The Working Group's rationale for this decision was set out in detail in an annex to the Working Group's initial solicitation of input from all ICANN SO/ACs, sent in December 2014³⁵. The Working Group also presented this preliminary conclusion to the GNSO Council and the community, and received no objections from the Council, any SO/AC or the community generally. **The Working Group's agreed text for this final recommendation, and its accompanying rationale, is set out in full as Recommendation #1(a) in Section 2, above.**

Consideration of the needs and concerns of IGOs, including how to demonstrate standing under the UDRP and URS

Following its decision to focus further discussions on IGOs, the Working Group moved on to consider the question of how to deal with the fact that not all IGOs possess registered or unregistered trademark rights in their names or acronyms – in which case the IGO would not then have standing to file a complaint under the UDRP or URS. As further described in Section 2 (above), the Working Group's preliminary recommendation in its Initial Report, after substantial research and discussion, was that standing to file can also be demonstrated by those IGOs which have invoked the protections provided by Article 6*ter* of the Paris Convention on Industrial Property.

The Working Group notes that the potential applicability of Article 6*ter* was first raised by the IGOs in their initial request to ICANN for protection of their names and acronyms in the top and second level of the domain name system, in which they stated, "*The names and acronyms of IGOs are protected within the scope of Article 6ter of the Paris Convention for the Protection of Industrial Property (with 173 Contracting Parties), as further referred to in Article 16 of the Trademark Law Treaty and Article 2 of the WTO Agreement on Trade Related Aspects of Intellectual Property Rights*".³⁶ In their letter, the various IGO legal counsel that signed it stated that international legal norms such as Article 6*ter* supported the targeted exclusion from registration by third parties of IGO names and acronyms (i.e. preventative protections). While this Working Group is concerned solely with the topic of curative protections for IGO names and acronyms, it nevertheless considered the applicability and relevance of Article 6*ter* to the issue.

³⁵ See Annex C of the Working Group's Initial Report published in January 2017 and containing the Working Group's letter to all ICANN SO/ACs, which can be found at <https://community.icann.org/x/T5gQAw>.

³⁶ See the 13 December 2011 letter sent by the legal counsel of twenty-eight IGOs: <https://www.icann.org/en/system/files/files/igo-counsels-to-beckstrom-et-al-13dec11-en.pdf>.

The Working Group acknowledges that Article 6*ter* does not confer substantive legal rights, whether as trademarks or in other forms. Rather, it provides protection to IGO names and acronyms by requiring contracting States that are party to the treaty or that otherwise are obliged to abide by the treaty provisions to prohibit confusing third-party use of those identifiers *as trademarks* in industrial or commercial activities, on the basis that such exclusion reflects the public status of IGOs and prevents confusion that would interfere with such status³⁷. Given this linkage of Article 6*ter* protections to national trademark regimes, and for the limited purpose of demonstrating standing to file a UDRP or URS complaint, the Working Group initially recommended that protections afforded to IGO names and acronyms by Article 6*ter* can be viewed as sufficient for that specific purpose. As detailed in Section 2.1 above, however, the Working Group's review of community input on this preliminary recommendation has resulted in the Working Group modifying its original conclusion on the issue of standing. **The Working Group's agreed text for this final recommendation, and its accompanying rationale, are set out in full as Recommendation #2 in Section 2, above.**

Consideration of the question of the cost for IGOs of using the UDRP and URS

The Working Group considered the GAC advice from its Los Angeles (October 2014) and Buenos Aires (November 2013) Communiqués that IGO access to and use of curative rights processes should be at low or nominal cost. The Working Group agreed that the question of the feasibility of providing dispute resolution services at lower or no costs was one more appropriately referred to ICANN. **This conclusion, and concerns expressed by Working Group members over the issue of subsidies, is further detailed as Recommendation #4 in Section 2, above.**

Consideration of a separate dispute resolution process for IGOs

The Working Group's conclusions on the issues of standing and substantive grounds under the UDRP and URS also meant that, in relation to these questions, there was no compelling reason based in those considerations to create a separate DRP applicable only to IGOs. In particular, the Working Group found no broadly accepted legal basis for the protection of IGO names and acronyms other than trademark law.

As noted in Section 2.1 above describing the final PDP recommendations, the Working Group also considered at length a further challenge that may be faced by IGOs – the risk

³⁷ See, e.g., http://www.wipo.int/edocs/pubdocs/en/intproperty/611/wipo_pub_611.pdf (BIRPI Guide to the Application of the Paris Convention, Bodenhausen (1968)); <http://www.wipo.int/export/sites/www/about-ip/en/iprm/pdf/ch5.pdf> (WIPO Intellectual Property Handbook: Policy, Law, and Use, chapter 5); and <http://archive.icann.org/en/committees/JWorkingGroupW2/WIPO2-note.pdf> (WIPO Briefing Note to ICANN, 2005).

that agreeing to submit to the Mutual Jurisdiction clause of the UDRP and URS by filing a complaint will strip an IGO of any jurisdictional immunity it may enjoy in a particular national court. ICANN staff, assisted by several Working Group members, conducted research on the scope of IGO jurisdictional immunity in selected jurisdictions and under applicable international treaties. The Working Group also initially consulted Mr. Hans Corell, an international law expert, in relation to several preliminary questions on the matter³⁸. Although this initial consultation provided the Working Group with some basic information, the Working Group concluded that there were still outstanding questions and a need for further information and guidance to enable the Working Group to reach substantive conclusions. The Working Group therefore requested that ICANN assist it by engaging an external legal expert to provide it with a more detailed analysis. The Working Group thanks ICANN for providing the staff resources and modest financial support to facilitate that request. Following consideration of several candidates nominated by Working Group members in the legal community, the Working Group agreed that Professor Edward Swaine of George Washington University, USA, should be engaged as the external legal expert³⁹. The internal process leading to the retention of Prof. Swaine for this task, and the subsequent development of his Final Memo and consideration thereof added approximately one year to the time required for completion of this PDP. However, the Working Group would have been unable to complete its task absent such expert legal advice on the scope of IGO jurisdictional immunity.

The Working Group developed several detailed questions for Professor Swaine to respond to, focusing on a determination of the scope of international law concerning the jurisdictional immunity of IGOs (as distinct from the sovereign immunity of States). In order for the Working Group to properly evaluate the need to either amend the UDRP or URS or develop a new mechanism to address the question of immunity, it needed to more fully understand international law (whether through treaty or customary law) on the topic and its scope.

Professor Swaine delivered a preliminary synopsis to the Working Group at the end of January 2016. Following review of this document and Working Group discussion, including at the ICANN meeting in Marrakech in March 2016, and a subsequent call between the Working Group and Professor Swaine, Professor Swaine updated his report and provided a Final Memo to the Working Group in June 2016⁴⁰. Subsequently,

³⁸ For the research conducted by ICANN staff, questions sent to Mr. Corell and his response, see <https://community.icann.org/x/wl4QAaw>.

³⁹ A list of the various experts under consideration by the Working Group can be found at <https://community.icann.org/x/z4BYAw>.

⁴⁰ Professor Swaine's preliminary synopsis and Final Memo can be found at <https://community.icann.org/x/z4BYAw>.

representatives from various IGOs sent a letter to the GNSO Council commenting on Professor Swaine's memo in October 2016⁴¹.

Based on Professor Swaine's expert opinion, as documented in his Final Memo, that there is not a uniform rule in international law governing IGO jurisdictional immunity and that the extent and success of an immunity claim in different national courts can vary depending on a number of factors, as well as concerns about ICANN seeking to deny domain registrants access to related statutory rights, the Working Group agreed that no change should be made to the Mutual Jurisdiction clause of either the UDRP or the URS.

The Working Group's conclusions on the issue of jurisdictional immunity further reinforces its view that there is no reason to develop a separate DRP applicable only to IGOs. It went on to consider what, if any, policy recommendation ought to be made that can deal with the challenge faced by IGOs when claiming jurisdictional immunity in the face of a lawsuit filed in a national court by a losing respondent. **The Working Group's agreed final text for this scenario, and its accompanying rationale, are set out in full as Recommendation #5 in Section 2, above.**

3.4 Working Group Interaction with IGOs, Consideration of GAC Advice and the IGO Small Group Proposal in Open Community Discussions at the ICANN57, ICANN58, ICANN59 & ICANN60 Public Meetings

Process Background

This PDP had been initiated to consider the specific topic of curative rights protections for IGOs and INGOs, which was a topic that had been noted but not addressed by the previous GNSO PDP on IGO-INGO Protections in All gTLDs. That previous PDP recommendation had been for an Issue Report scoping the issue as a mandatory first step prior to a separate, new PDP. The previous PDP Working Group had reached consensus on a number of recommendations pertaining to preventative protections for certain IGO and INGO names and acronyms⁴². While some of the policy

⁴¹ See <https://gns0.icann.org/en/correspondence/igo-note-wg-swaine-memo-12jul16-en.pdf>.

⁴² See the PDP Working Group's Final Report at <https://gns0.icann.org/en/issues/igo-ingo-final-10nov13-en.pdf>, with Minority Statements (including from participating IGOs) at <https://gns0.icann.org/en/issues/igo-ingo-final-minority-positions-10nov13-en.pdf>.

recommendations have since been approved by the ICANN Board⁴³, several remain under Board consideration as the GNSO's recommendations on those points are inconsistent with GAC advice provided to the Board on the same topics⁴⁴, and the Board had requested additional time to consider them. The Board had previously also requested that its New gTLD Program Committee (NGPC) develop a proposal for Board consideration that would take into account the GAC advice as well as the GNSO's recommendations⁴⁵.

To provide a procedural path forward for resolution of the matter, the NGPC facilitated the creation of an IGO Small Group, comprising representatives from the GAC and IGOs working with Board representatives and ICANN staff to finalize a proposal for GAC and GNSO consideration. The formation of the group was highlighted by the GAC Chair during the joint GAC-GNSO meeting at ICANN51 in Los Angeles in October 2014, where it was noted that the group would *"provide inputs or maybe some guidance to the GNSO so that it's clear, or as clear as possible, for [the GNSO] about what are the issues there that are really remaining"*⁴⁶. The starting point for the IGO Small Group's deliberations was the initial NGPC proposal that had been sent to the GAC and the GNSO in March 2014⁴⁷. Although the NGPC proposal focused on the topic of preventative protections for IGO acronyms, it also contained suggestions for modifying the URS (specifically, removing the need to consent to jurisdiction and the possibility of appeal) and the setting up of an arbitration process to resolve claims of abuse of IGO acronyms.

In June 2014, the NGPC wrote to the GNSO Council requesting that the GNSO consider modifying its original PDP recommendations in accordance with the GNSO's documented processes for such amendment⁴⁸. In the letter, the NGPC acknowledged

⁴³ The Board resolution approving the consistent recommendations and requesting more time to consider the remaining recommendations while facilitating discussions on reconciliation of the inconsistencies can be viewed at <http://www.icann.org/en/groups/board/documents/resolutions-30apr14-en.htm#2.a>.

⁴⁴ The GAC had issued advice to the ICANN Board via several Communiqués between 2013 and the present time concerning IGO protections, especially for IGO acronyms. For a listing of all the GAC advice on this point up to March 2017, see <https://gacweb.icann.org/display/GACADV/IGO+Names+and+Acronyms> and the summary compilation of GAC advice in Annex E.

⁴⁵ See <http://www.icann.org/en/groups/board/documents/resolutions-07feb14-en.htm#2.a>.

⁴⁶ See Page 27 of the transcript from this meeting: <https://la51.icann.org/en/schedule/sun-gac-gnso/transcript-gac-gnso-12oct14-en.pdf>.

⁴⁷ See <https://gnso.icann.org/en/correspondence/chalaby-to-robinson-20mar14-en.pdf> for a brief description of the scope of the original proposal, and <https://gnso.icann.org/mailling-lists/archives/council/msg15906.html> for the full text of the proposal.

⁴⁸ See <https://gnso.icann.org/en/correspondence/chalaby-to-robinson-16jun14-en.pdf>. Further correspondence followed between the GNSO Council and the NGPC, in July 2014 (<https://gnso.icann.org/en/correspondence/chalaby-to-robinson-24jul14-en.pdf>), October 2014 (<https://gnso.icann.org/en/correspondence/robinson-to-chalaby-disspain-07oct14-en.pdf>) and January

the then-recent initiation of this current PDP on curative rights, and noted that the Board would not take any action on GAC advice concerning curative rights protections for IGOs until the conclusion of this PDP. The GNSO Council took no further action in relation to IGO acronyms following additional discussions with the NGPC later that year, pending further Board/NGPC input on possible modifications to the GNSO's adopted policy recommendations that might be appropriate and acceptable to all parties.

In December 2014, pursuant to a mandatory requirement for all GNSO PDPs, this Working Group had sought input from all ICANN SO/ACs. In addition to a response from the GAC⁴⁹, IGO representatives also provided responses to the Working Group in January 2015, following which the Working Group sent a few additional questions to the IGOs to which the group did not receive a further response. Representatives of various IGOs who were participants in the IGO Small Group attended and participated in the Working Group's open sessions at ICANN53 in Buenos Aires (June 2015)⁵⁰ and at ICANN56 in Helsinki (June 2016)⁵¹; however, despite affirmative outreach, no IGO representative elected to become a member of the Working Group (although one IGO representative had earlier signed up as an observer).

In June 2015, the co-chairs of this Working Group met with the GAC Chair and two GAC vice-chairs at the ICANN meeting in Buenos Aires to discuss the progress of work on IGO curative rights protections and to encourage participation in the Working Group by GAC members⁵². In July 2015, representatives of the IGO Small Group held a face to face meeting to further discuss the proposal that would ultimately be shared with the GAC and the GNSO⁵³. In October 2015, the GAC Chair and Chris Disspain (the Board "shepherd" for this topic) held a teleconference with the Working Group co-chairs and other GNSO representatives regarding the various work tracks within the GNSO on IGO

2015 (<https://gnso.icann.org/en/correspondence/chalaby-to-robinson-15jan15-en.pdf>). The GNSO Council also wrote to the GAC Chair in July 2014, noting that it had already initiated a new PDP that would, among other things, consider modifications to the URS in relation to IGO protections (<https://gnso.icann.org/en/correspondence/robinson-to-dryden-25jun14-en.pdf>).

⁴⁹ For a copy of the original Working Group request and copies of all the responses received, see the Working Group wiki space at <https://community.icann.org/x/T5gQAw>.

⁵⁰ See <https://buenosaires53.icann.org/en/schedule/wed-igo-ingo-crp-access/transcript-igo-ingo-crp-access-24jun15-en.pdf>.

⁵¹ See <https://gnso.icann.org/en/meetings/transcript-igo-ingo-crp-access-28jun16-en.pdf>.

⁵² Initially, one representative of a GAC member country was a member of the Working Group; however, due to his not filling out a Statement of Interest (which is a requirement for participation in a GNSO Working Group) despite numerous reminders over a substantial period of time, his status was changed to that of an observer in accordance with GNSO practice. At the date of publication of the Initial Report and up to the completion of this Final Report, there are two GAC observers to this Working Group (in addition to one IGO observer).

⁵³ See letter from the Secretary General of the OECD (which hosted the meeting) to the ICANN CEO: <https://www.icann.org/en/system/files/correspondence/gurria-to-chehade-20jul15-en.pdf>.

protections and the IGO Small Group work. In June 2016, at the ICANN meeting in Helsinki, the topic of IGO acronyms protection was discussed by the GNSO Council and the ICANN Board⁵⁴, where the Council raised its concern that it had not had much visibility into the IGO Small Group discussions; and Working Group co-chair Philip Corwin provided an update on the PDP work, including noting the limited extent of GAC and IGO participation in the Working Group.

The final proposal from the IGO Small Group was circulated to the GAC and the GNSO on 4 October 2016⁵⁵ via letter from the ICANN Board. The Board noted that those aspects of the proposal that related to curative rights would likely be referred to this Working Group, and requested that the Working Group fully consider the proposal, stating, *“the Board hopes that the other elements of the attached proposal will be helpful to the GNSO in its deliberations over considering possible amendments to its previously adopted policy recommendations on preventative protection for IGO acronyms.”* However, that letter did not endorse the Small Group proposal, and further stated, *“I wish to reiterate our belief that the most appropriate approach for the Board in this matter is to help to facilitate a procedural way forward for the reconciliation of GAC advice and GNSO policy prior to the Board formally considering substantive policy recommendations”*. On 31 October 2016, legal counsel from various IGOs sent a letter to the GNSO Council stating that IGO immunity is incompatible with the Mutual Jurisdiction requirements of the UDRP and URS, and claiming that the IGO Small Group Proposal represents a compromise on the part of the IGOs in relation to their initial request that their acronyms (which are the terms by which they are most commonly known) be reserved permanently⁵⁶.

The IGO Small Group Proposal and the Working Group’s review of the proposal

The IGO Small Group Proposal included proposals touching on curative rights processes as a complement to meaningful preventative protections for IGO acronyms. It outlined the basis for the specific proposals it contained as follows:

- “(1) The basis for protection of IGO acronyms should not be founded in trademark law, as IGOs are created by governments under international law and are in an objectively different category of rights-holders;*
- (2) As IGOs perform important global missions with public funds, the implementation of appropriate protections for IGO names and acronyms is in the public interest; and*

⁵⁴ See <https://gns0.icann.org/en/meetings/transcript-gns0-board-27jun16-en.pdf>.

⁵⁵ See <https://gns0.icann.org/en/correspondence/crocker-icann-board-to-council-chairs-04oct16-en.pdf>.

The Board letter and the full IGO Small Group Proposal has been included in this Report as Annex D.

⁵⁶ See <https://gns0.icann.org/en/correspondence/igos-to-gns0-31oct16-en.pdf>.

(3) The Eligible IGOs that would qualify for protections under this proposal are those that are named on the GAC List of IGOs (initially submitted to ICANN in March 2013) as may be updated from time to time in accordance with GAC advice issued on 22 March 2013.”

On curative rights, one proposal was the creation of a separate DRP for IGOs, as follows: *“ICANN will facilitate the development of rules and procedures for a separate (i.e., separate from the existing UDRP) dispute resolution mechanism to resolve claims of abuse of domain names that are registered and being used in situations where the registrant is pretending to be the IGO or that are otherwise likely to result in fraud or deception, and (a) are identical to an IGO acronym; or (b) are confusingly similar to an IGO acronym; or (c) contain the IGO acronym. Decisions resulting from this mechanism shall be “appealable” through an arbitral process to be agreed.”*

A further proposal was for a rapid relief mechanism, separate from the URS, to address clear-cut cases of abuse. Under this proposal, an eligible IGO may obtain a rapid temporary suspension of a domain name in situations where it would not be reasonable for it to use the above-mentioned dispute resolution mechanism, if certain conditions are met. These are:

*“(1) The subject domain name is
(a) identical or confusingly similar to an IGO acronym; and
(b) registered and used in situations where the registrant is pretending to be the IGO or that are otherwise likely to result in fraud or deception; and
(2) there is an obvious risk of imminent harm from the claimed abuse of such domain name, (e.g. such as fraudulently soliciting donations in the wake of a humanitarian disaster).”*

Relief under this new rapid relief mechanism would be the same as under the URS, i.e. suspension and not transfer or cancellation of the domain name in question.

The IGO Small Group Proposal also included a proposal for ICANN to *“work with the IGOs and the mechanism providers to ensure that IGOs are not required to pay filing or any other ICANN-defined fees to access and use those mechanisms unless the examiner finds the case to have been brought in bad faith. Three or more findings of cases brought in bad faith by the same IGO may lead to that IGO being suspended from using the mechanism for a period of one year.”*

The Working Group reviewed and discussed the IGO Small Group Proposal at its meetings on 13 October 2016⁵⁷ and 20 October 2016⁵⁸. It should be noted that, by the time of receipt of the IGO Small Group Proposal, the Working Group had already reached preliminary agreement on a number of potential recommendations concerning curative rights protections for IGOs. The Working Group's review of the IGO Small Group Proposal thus focused on whether the proposals contained therein warranted modifications or updates to the Working Group's preliminary conclusions.

During the two meetings where it focused on the IGO Small Group Proposal, the Working Group reviewed all the aspects that pertained to curative rights. It concluded that, while IGOs may be in an objectively different category than trademark holders (as had been noted several times by the GAC), the Working Group's agreed preliminary recommendations not only provide sufficient protection for IGO names and acronyms, in some cases its recommendations are broader than and thus provide potentially greater protection for IGOs than what is in the IGO Small Group Proposal. The Working Group believes that its final recommendations achieve substantially the same result. For instance, its final recommendations clarify how IGOs may seek to demonstrate that they have unregistered trademark rights in their names or acronyms sufficient to satisfy the requirement of standing to file a UDRP or URS complaint; and none of the Working Group's final recommendations are limited only to those IGOs identified by the GAC .

The Working Group also noted that the IGO Small Group Proposal assumes that IGOs are able to claim broad jurisdictional immunity in multiple national courts, whether as the initiator of or defending against a lawsuit. The Working Group concluded that this assumption is at substantial odds with the expert opinion provided by Professor Swaine. Therefore the Working Group concluded that there is no basis for stripping a losing registrant of the right of recourse in a national court, as is called for by the IGO Small Group Proposal. Finally, the Working Group noted that the elements of the separate mechanisms outlined in the IGO Small Group Proposal are already within the scope of the existing URS and UDRP. There therefore did not seem to be a substantive rationale for creating separate DRPs as proposed by the IGO Small Group.

The following is a comparative table showing the differences between the specific details of the IGO Small Group Proposal concerning curative rights and the Working Group's recommendations and rationale for its conclusions.

⁵⁷ See <https://community.icann.org/x/-hi4Aw>.

⁵⁸ See <https://community.icann.org/x/wSC4Aw>.

IGO Small Group Proposal	Working Group Recommendations ⁵⁹	Notes
<p>Separate dispute resolution process for domains registered and used in situations where registrant is pretending to be the IGO or otherwise likely to result in fraud or deception, <i>and</i> (a) are identical to an IGO acronym; or (b) are confusingly similar to an IGO acronym; or (c) contain the IGO acronym.</p> <p>Decisions to be “appealable” through an arbitral process.</p>	<p>No separate dispute resolution process:</p> <p>Subject to a UDRP or URS panel’s determination of this issue, standing to file under the UDRP or URS can potentially be evidenced by an IGO’s having filed the requisite notification to WIPO under Article 6<i>ter</i> of the Paris Convention for the Protection of Industrial Property (this supplements the existing option of filing under the UDRP or URS if the IGO has trademark rights in its name and/or acronym).</p> <p>A Policy Guidance document to be developed and issued clarifying that IGOs have the option to file through an assignee, licensee, or agent.</p>	<p>The Working Group’s recommendations apply to all IGOs and as such provide protection to a broader group of IGOs than those covered by the IGO Small Group Proposal.</p> <p>The Working Group also concludes that the substantive scope of the UDRP already covers the situations described in the IGO Small Group Proposal and in some cases may provide broader protection.</p> <p>The external legal expert report confirms that the state of international law on IGO jurisdictional immunity is not uniform, and can depend on a number of factors, including the existence of a bilateral treaty and whether the national court in question applies the principles of absolute, functional or restrictive immunity to the IGO. As such, the disadvantages (especially to a registrant) of removing entirely the right of recourse to a national court seemed</p>

⁵⁹ See Section 2, above, for the full set of recommendations and rationales.

		<p>disproportionate to the possible benefits. The Working Group further believed that the availability of curative relief is intended to be a supplement to rather than a substitute for existing legal protections; that an attempt by ICANN to prevent a domain registrant from exercising national legal rights could set an undesirable precedent; and that in any event there could be no assurance that a court would dismiss a legal action brought by a registrant based upon such ICANN policy seeking to prevent court access.</p> <p>Allowing an IGO to file via a representative third party would insulate the IGO from any direct admission that it was waiving its claimed immunity in the event of a subsequent proceedings in a court of mutual jurisdiction.</p>
<p>Rapid relief mechanism where domain is: (a) identical or confusingly similar to an IGO acronym; and (b) registered and used in situations where the registrant is pretending to be the IGO or that are otherwise likely to result in</p>	<p>No separate rapid relief mechanism and no change to the URS.</p>	<p>The Working Group believes that the substantive scope of the URS already covers the situations described in the IGO Small Group Proposal and may in some cases provide broader protection, as noted in this Final Report.</p>

<p>fraud or deception; and (c) there is obvious risk of imminent harm from the claimed abuse of the domain.</p>		<p>The Working Group notes that the external legal expert report confirms that the state of international law on IGO jurisdictional immunity is not uniform, and can depend on a number of factors, including the existence of a bilateral treaty and whether the national court in question applies the principles of absolute, functional or restrictive immunity to the IGO. As such, the disadvantages (especially to a registrant) of deleting the requirement to submit to the long standing Mutual Jurisdiction standard outweighed any purported benefits.</p>
<p>“Eligible IGOs” are IGOs who are on the GAC List from March 2013 (as updated from time to time by the GAC).</p>	<p>The Working Group’s final recommendations are not limited to these “Eligible IGOs” but apply to all IGOs who have either registered or unregistered trademark or service mark rights in their names and/or acronyms.</p>	<p>The Working Group recognizes that the number of eligible IGOs under its preliminary recommendations is likely to be greater than those on the current GAC List. The bona fide status of an IGO is an element to be considered by a court in evaluating its immunity request.</p>
<p>Mechanisms to be available to IGOs at no cost unless case is brought in bad faith. A finding of three or more</p>	<p>ICANN Board may engage with the GAC and IGOs to investigate the feasibility of providing IGOs with access to the UDRP and URS at low or nominal</p>	<p>The Working Group does not have the remit or authority to compel ICANN to create a subsidy or other cost relief measures for IGOs, whether</p>

<p>filings in bad faith to result in an IGO not being permitted to use the mechanism for one year.</p>	<p>cost.</p>	<p>generally or on a selective basis.</p> <p>As the Working Group has not recommended the creation of new, IGO-specific curative rights protection mechanisms, it believes that the rules regarding bad faith filings by IGO complainants should be the same as for any other party initiating a UDRP or URS; and that any recommended alterations are within the jurisdiction of the ongoing Working Group that is reviewing all rights protection mechanisms in all gTLDs.</p>
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GAC advice and community discussions at the ICANN57, ICANN58, ICANN59 & ICANN60 Public Meetings

At ICANN57 in Hyderabad in November 2016, the Working Group held an open community session where it presented a comparative overview of the differences between the Working Group’s agreed preliminary recommendations and the specific proposals contained in the IGO Small Group Proposal.

The GAC Communique issued at the conclusion of the Hyderabad meeting contained GAC consensus advice on IGO protections⁶⁰. The GAC advice included a request that this Working Group take the IGO Small Group Proposal into account in its deliberations. The rationale that was provided by the GAC was that

- *“IGOs undertake global public service missions, and protecting their names and acronyms in the [domain name system] is in the global public interest.*

⁶⁰ See

<https://gacweb.icann.org/download/attachments/27132037/GAC%20ICANN%2057%20Communique.pdf?version=6&modificationDate=1478668059355&api=v2>. The relevant text, as well as previous GAC advice on the topic of IGO protections, has been included in Annex E.

- *IGOs are unique treaty-based institutions created by governments under international law.*
- *The small group compromise strikes a reasonable balance between rights and concerns of both IGOs and legitimate third parties.*
- *ICANN's Bylaws and Core Values indicate that the concerns and interests of entities most affected, here IGOs, should be taken into account in policy development processes."*

At ICANN58 in Copenhagen in March 2017, the Working Group held another open community session where it presented the text of its preliminary recommendations, as published for public comment in January, and specifically sought community feedback on the two options relating to the handling of the IGO jurisdictional immunity question. Two dialogue sessions between GAC and GNSO representatives on the dual topics of Red Cross and IGO protections, facilitated by former Board member Bruce Tonkin and aimed at reconciling differing GAC advice and GNSO policy recommendations, were also held during ICANN58.

The GAC Communique issued at the conclusion of the Copenhagen meeting acknowledged the facilitated dialogues that took place, and included GAC advice that called on the ICANN Board to:

- I. "pursue implementation of (i) a permanent system of notification to IGOs regarding second-level registration of strings that match their acronyms in up to two languages and (ii) a parallel system of notification to registrants for a more limited time period, in line with both previous GAC advice and GNSO recommendations;*
- II. facilitate continued discussions in order to develop a resolution that will reflect (i) the fact that IGOs are in an objectively unique category of rights holders and (ii) a better understanding of relevant GAC Advice, particularly as it relates to IGO immunities recognized under international law as noted by IGO Legal Counsels; and*
- III. urge the Working Group for the ongoing PDP on IGO-INGO Access to Curative Rights Protection Mechanisms to take into account the GAC's comments on the Initial Report."*

At ICANN59 in Johannesburg in June 2017, the Working Group held an open community session where it presented some of its likely final recommendations based on its comprehensive consideration of public comments received on its preliminary recommendations, including from the GAC and a substantial number of IGOs. The Working Group presented its proposed substantive modification to its original recommendation concerning standing under the UDRP and URS and requested community feedback on the topic of arbitration as a possible option in a situation where an IGO has successfully claimed jurisdictional immunity as against a losing respondent who filed a claim in a national court.

The GAC Communique issued at the conclusion of the Johannesburg meeting reiterated previous GAC consensus advice on IGO protections, i.e. that curative rights protections for IGOs should be modeled on, but separate from, the existing UDRP, provide standing based on IGOs' status as public intergovernmental institutions, and respect IGOs' jurisdictional status by facilitating appeals exclusively through arbitration. The GAC's rationale for this advice was that it *"aligns with the view of governments that IGOs perform important public functions for citizens worldwide, and that protecting their identities in the DNS serves to minimize the potential for consumer harm."*

The GAC also expressed concern that this Working Group seemed to be preparing final PDP recommendations that differed from GAC advice, and requested that the ICANN Board *"ensure that such recommendations adequately reflect input and expertise provided by IGOs"*.

At ICANN60 in Abu Dhabi, the Working Group's open community session focused on the proposed final recommendations, including the still-outstanding question as to which of the various options on the handling of the IGO jurisdictional immunity issue (or other alternative) would be most appropriate.

The GAC Communique issued at the end of the Abu Dhabi meeting noted the GAC's willingness to continue to work with the GNSO community on resolving the issue of IGO protections, and called on the ICANN Board to *"review closely the [GNSO's] decisions on this issue in order to ensure that they are compatible with [the] values [of openness, transparency and inclusion, and representativeness and process integrity enshrined in the ICANN Bylaws and GNSO Operating Procedures,] and reflect the full factual record."*

The GAC Communique from ICANN61 in Puerto Rico noted *"ongoing developments in the PDP on IGO access to curative rights protection mechanisms, which the GAC is monitoring closely"* and saw the GAC affirming its previous advice *"concerning preventative protection of IGO identifiers, recall[ing] the importance of maintaining temporary protections until a permanent resolution on IGO identifiers is reached in order prevent irreparable harm to IGOs and [advising] the ICANN Board to [e]nsure that the list of IGOs eligible for preventative protection is as accurate and complete as possible."*

Most recently, the GAC Communique issued on 28 June 2018 from ICANN62 in Panama advised the ICANN Board to *"work with the GNSO and the GAC following the completion of the ongoing PDP on IGO-INGO access to curative rights protection mechanisms to ensure that GAC advice on protection of IGO acronyms, which includes the available "small group" proposal, is adequately taken into account also in any related Board decision"*. In the rationale accompanying this advice, the GAC stated that the PDP Final Report should reflect the *"substantial input"* that had been previously provided by the GAC, including in its public comments to the January 2017 Initial Report. The rationale went on to state that *"current indications are that the PDP recommendations will not*

adequately reflect the GAC's advice on this topic [and] the GAC remains open to discussions with the GNSO and the Board to ensure that this is the case. The GAC notes that the work on this PDP began by at least mid-2014 and has yet to satisfactorily reach a positive resolution. The GAC moreover notes that a 2007 GNSO Issue Report provided a blueprint for a means for handling domain name disputes concerning IGO identifiers which substantially matches the "small group" proposal".

Working Group Consideration of GAC Advice and Input

The Working Group acknowledges that the GAC has provided advice recommending the creation of a separate dispute resolution procedure for IGOs (e.g. in its March 2017 Copenhagen Communique). It also acknowledges that its final recommendations differ from GAC advice on the topic and the IGO Small Group Proposal; however, the Working Group believes that, overall, its consensus recommendations adequately address the needs and concerns of IGOs while preserving the benefits and certainty of the existing curative rights processes and protecting the legal rights of registrants⁶¹.

The Working Group appreciates the GAC advice that has been issued to date, and has given thorough consideration to all the GAC advice, the GAC's and the IGOs' comments on the group's Initial Report as well as the IGO Small Group Proposal and the various statements and correspondence it received from the IGOs. The many discussions that took place between the publication of its Initial Report and the preparation of this Final Report demonstrates the seriousness with which the Working Group considered all input received, in developing recommendations that the Working Group believes are respectful and protective of IGO missions and their treaty basis. In addition, representatives of some IGOs attended and spoke at several open meetings held by the Working Group at the various ICANN Public Meetings that took place between June 2015 and November 2017, and the Working Group has devoted a substantial amount of time to considering the IGOs' requests, positions and concerns.

The Working Group notes that its mandate, as scoped by its Charter, does not extend to reconciling GAC advice with consensus-based community-developed recommendations where these are inconsistent. With the modifications that it has made to some of its preliminary recommendations as noted in this Final Report, the Working Group believes that its final recommendations strike the necessary balance overall between recognizing the particular concerns of IGOs and preserving the existing legal rights of registrants.

⁶¹ A compilation of communications from the GAC, including GAC advice issued via various Communiqués in relation to the topic of IGO protections, is available in Annex E. The full text of the IGO Small Group Proposal, including the Board cover letter forwarding it to the GNSO Council, can be found in Annex D.

3.5 Working Group Deliberations on Policy Options for IGO Jurisdictional Immunity

By end-September 2017, the Working Group co-chairs considered that the Working Group had reached consensus on several likely final recommendations. Following ICANN59 in June 2017, the Working Group's focus had been on attempting to reach consensus on the remaining issue of IGO jurisdictional immunity. Its discussions took into account community input on the two options that had been published for public comment in its Initial Report and the community discussions that took place at ICANN58, ICANN59 and ICANN60. In September 2017, the Working Group co-chairs had also requested that staff conduct a "check-in" of all Working Group members, to ensure that the membership list was as up-to-date as possible given the length of time that had elapsed since the initiation of this PDP.

Following extensive Working Group discussions, a list of three options was proposed by the co-chairs for further Working Group consideration. This list contained the original two options first published in the Working Group's Initial Report, with Option 2 having been modified to add specific elements related to the possibility of arbitration and/or limited judicial consideration solely of ownership of the disputed domain names. The third option represented an attempt at a "middle ground" where disposition of the case would differ depending on whether the disputed domain was created before or a certain date. In October 2017, the Working Group conducted an informal poll on the three suggested options. The poll results⁶² were presented to the GNSO Council and community at ICANN60.

Additional Working Group deliberations were conducted in November and December 2017, resulting in a final list of six options for discussion. One of these further options was a new suggestion to refer the topic to the GNSO PDP Working Group reviewing all rights protection mechanisms (including the UDRP and URS) that had been launched after this Working Group had begun its work. Another suggestion was put forward based on a meeting between the Working Group and representatives of Nominet, which operates the .uk ccTLD and whose DRP includes the possibility of mediation.

During the Working Group's discussion of these six options, the Working Group co-chairs proposed the use of an anonymous poll in order to assist with designating consensus on one or more of them. Several Working Group members objected to this proposal. One Working Group member, supported by two others, filed an appeal against

⁶² See <https://community.icann.org/download/attachments/74581149/Options%20A-C%20Prelim%20Consensus%20Call%20Results.pdf?version=1&modificationDate=1510944920000&api=v2>.

the co-chairs' actions under Section 3.7 of the GNSO's Working Group Guidelines on 19 December 2017⁶³.

Following the requisite process outlined in the GNSO Working Group Guidelines, two calls took place between the Working Group co-chairs and the appellants on 11 and 18 January 2018⁶⁴. As these calls did not succeed in resolving the matter⁶⁵, a call then took place on 20 February 2018⁶⁶ between the appellants and the GNSO Chair, as prescribed by the Working Group Guidelines. Following that call, the GNSO Council liaison to the Working Group, in consultation with the GNSO Chair, made a proposal to the Working Group for a procedural path forward⁶⁷. This approach involved the liaison's conducting individual consultations with interested Working Group members either at ICANN61 or subsequently in March 2018. The results of these consultations were summarized in a report that the liaison sent to the Working Group mailing list on 13 April 2018⁶⁸. A Working Group call facilitated by the Council liaison was held on 19 April, following which a Summary Report was circulated to the Working Group⁶⁹. The Summary Report⁷⁰

⁶³ See <https://mm.icann.org/pipermail/gns0-igo-ingo-crp/2017-December/001005.html>. The mailing list discussions that led to this appeal as well as subsequent postings regarding the appeal can be reviewed here: <https://mm.icann.org/pipermail/gns0-igo-ingo-crp/2017-December/date.html> and <https://mm.icann.org/pipermail/gns0-igo-ingo-crp/2018-January/date.html>. Under Section 3.7 of the Working Group Guidelines, the process to resolve such appeals requires that the appellant "first discuss the circumstances with the WG Chair. In the event that the matter cannot be resolved satisfactorily, the WG member should request an opportunity to discuss the situation with the Chair of the Chartering Organization or their designated representative" (see <https://gns0.icann.org/en/council/annex-1-gns0-wg-guidelines-30jan18-en.pdf> for the full text of the relevant Guidelines).

⁶⁴ The appellant submitted supporting documentation for the first call on 11 January (see <https://mm.icann.org/pipermail/gns0-igo-ingo-crp/2018-January/001035.html>). As agreed on that call, the co-chairs submitted a response on 16 January (see <https://mm.icann.org/pipermail/gns0-igo-ingo-crp/2018-January/001057.html>).

⁶⁵ Although agreement was reached on the calls that the Working Group should be asked for their views on using a facilitator to assist with consensus, there were other disagreements that are documented on the Working Group mailing list: see, e.g. <https://mm.icann.org/pipermail/gns0-igo-ingo-crp/2018-February/001079.html> and the subsequent postings in that email thread; <https://mm.icann.org/pipermail/gns0-igo-ingo-crp/2018-February/001084.html> and the subsequent postings in that email thread; and a further reply from the appellant submitted to the mailing list on 12 February 2018: <https://mm.icann.org/pipermail/gns0-igo-ingo-crp/2018-February/001091.html>.

⁶⁶ Recordings of the calls that took place pursuant to the requirements under Section 3.7 of the Working Group Guidelines can be accessed here: <https://community.icann.org/x/AwC8B> (for the 11 January 2018 call), <https://community.icann.org/x/iAS8B> (for the 18 January 2018 call), and <https://community.icann.org/x/IBa8B> (for the 20 February 2018 call). The ICANN Ombudsman attended the two calls held with the co-chairs, and the GNSO Council liaison to the Working Group as well as one of the two GNSO Council Vice-Chairs attended the call held with the GNSO Chair.

⁶⁷ See <https://mm.icann.org/pipermail/gns0-igo-ingo-crp/2018-March/001093.html>.

⁶⁸ See <https://mm.icann.org/pipermail/gns0-igo-ingo-crp/2018-April/001111.html>.

⁶⁹ See <https://mm.icann.org/pipermail/gns0-igo-ingo-crp/2018-April/001138.html>.

included the GNSO Chair's and Council liaison's recommendation that the report as well as a Working Group report differentiating those in which consensus was reached from those presented in the form of options on which consensus was not reached be submitted to the GNSO Council.

On 26 April 2018, the GNSO Council received an update from the Council liaison to the Working Group, as a result of which the Working Group attempted to complete its work in time to submit its Final Report to the GNSO Council for consideration at the Council's meeting on 24 May 2018.

Facilitated by its GNSO Council liaison, the Working Group held meetings on 10 & 25 May 2018 to determine if it would be able to reach consensus on the remaining topic of IGO jurisdictional immunity, based on the six options under consideration. Following the 25 May meeting, a consensus call was announced in accordance with the GNSO's customary practice and pursuant to the GNSO Working Group Guidelines⁷¹, by which Working Group members were encouraged to share their views on all the recommendations and proposals by email. On 9 June 2018, following his review of the emails sent to the Working Group mailing list, the remaining Working Group chair⁷² published his proposed designations of consensus for each of the recommendations for Working Group discussion⁷³. A number of Working Group members provided feedback noting that some of the designated levels of support and objection, as proposed by the chair, may not have accurately reflected their views⁷⁴. The Working Group held further meetings on 12 & 21 June 2018, to reach final consensus on the text for all agreed policy recommendations and to agree on the appropriate levels of disagreement on those proposals that did not attain consensus amongst the group.

The final recommendations listed in Sections 1 and 2 of this report contains the final consensus recommendations of the Working Group, based on the results of its formal consensus call.

⁷⁰ At least one Working Group member raised concerns over whether the Summary Report was accurate in its depiction of the numbers of members who supported particular options (see <https://mm.icann.org/pipermail/gnso-igo-ingo-crp/2018-May/001140.html>); ICANN staff subsequently updated the report and clarified the source of the numerical inconsistency (see <https://mm.icann.org/pipermail/gnso-igo-ingo-crp/2018-May/001164.html>).

⁷¹ See <https://mm.icann.org/pipermail/gnso-igo-ingo-crp/2018-May/001213.html>.

⁷² Mr. Petter Rindforth remains the Working Group chair; Mr. Philip Corwin having resigned as co-chair on 11 May 2018.

⁷³ See <https://mm.icann.org/pipermail/gnso-igo-ingo-crp/2018-June/001238.html>.

⁷⁴ See the email thread at <https://mm.icann.org/pipermail/gnso-igo-ingo-crp/2018-June/thread.html>.

4 Conclusions and Next Steps

4.1 Results of Final Working Group Deliberations

The results of the Working Group's deliberations following its review of the public comments received on its Initial Report have been described in the preceding sections of this Final Report. The Working Group is submitting five consensus recommendations for the GNSO Council's consideration (with one of the five having attained the Full Consensus of the Working Group). Several Working Group members have also filed minority statements, which are documented in full in Annex B.

4.2 Next Steps

The Working Group is submitting this Final Report to the GNSO Council for its review and vote as to whether or not to approve the Working Group's final consensus recommendations, in accordance with the ICANN Bylaws and the GNSO PDP Manual.

5 Background

5.1 Process Background

On 20 November 2013, the GNSO Council unanimously adopted all of the consensus recommendations made by the PDP Working Group on the Protection of IGOs and INGOs in All gTLDs. The group had recommended that the GNSO Council request an Issue Report to assist it in determining whether a PDP should be initiated in order to explore possible amendments to the UDRP and the URS, to enable access to and use of such curative rights protection mechanisms by IGOs and INGOs.

- On 25 May 2014, ICANN published the Final Issue Report on Amending the Uniform Dispute Resolution Policy and the Uniform Rapid Suspension Procedure for Access by Protected International Governmental Organizations and International Non-Governmental Organizations. In this Final Issue Report, ICANN staff recommended that the GNSO Council commence a PDP on the topic.
- On 5 June 2014, the GNSO Council initiated the PDP.
- On 25 June 2014, the GNSO Council approved the Charter for the IGO-INGO Access to Curative Rights Protection Mechanisms PDP Working Group.
- A Call for Volunteers to the Working Group was issued on 11 July 2014, and the Working Group held its first meeting on 11 August 2014, with the initial Council liaison Mr. Petter Rindforth acting as interim Working Group Chair.
- On 4 September 2014, the GNSO Council confirmed the appointment of Mr. Philip Corwin and Mr. Petter Rindforth as Working Group Co-Chairs⁷⁵.
- On 16 June 2015, the GNSO Council approved a request from the PDP Working Group to amend the scope of its

⁷⁵ Following the conclusion of Mr. Rindforth's term as a GNSO Council member, in which capacity he had been the Council's initial liaison to the Working Group, Ms. Susan Kawaguchi was confirmed as the new Council liaison to succeed Mr. Rindforth.

Charter, such that the Working Group would be able to “take into account any criteria for IGO or INGO protection that may be appropriate, including any that may have been developed previously, such as the list of IGO and INGO identifiers that was used by the GNSO’s prior PDP Working Group on the Protection of International Organization Identifiers in All gTLDs as the basis for their consensus recommendations and the GAC list of IGOs as provided to ICANN in March 2013”⁷⁶.

5.2 Issue Background

The IGO-INGO Access to Curative Rights Protection Mechanisms PDP Working Group was tasked to provide the GNSO Council with policy recommendations regarding whether to amend the UDRP and URS to allow access to and use of these mechanisms by IGOs and INGOs and, if so in what respects; or whether a separate, narrowly-tailored dispute resolution procedure at the second level modeled on the UDRP and URS that takes into account the particular needs and specific circumstances of IGOs and INGOs should be developed. The Working Group was expected to, at a minimum, consider the following topics:

- Differences between the UDRP and URS
- Relevance of existing protections under the Applicant Guidebook for the New gTLD Program
- Interplay between this issue and the forthcoming review of the UDRP
- The distinction (if any) between IGOs and INGOs for purposes of this issue
- The potential need to distinguish between a “legacy” gTLD and a “new” gTLD launched under the New gTLD Program
- The potential need to clarify whether the URS is Consensus Policy binding on ICANN contracted parties
- The need to address the issue of the costs to IGOs and INGOs of using curative processes

⁷⁶ See <https://gns0.icann.org/en/council/resolutions#20150416-3> (noting that the original scope of the Charter was limited only to the identifiers of those IGOs and INGOs that had been listed by the previous PDP Working Group on IGO and INGO protections).

- The relevance of the existence of legal protections under international treaties and/or multiple national laws

5.2.1 Background Work by the GNSO and the ICANN Community

In 2007 a GNSO Issue Report on Dispute Handling for IGO Names & Abbreviations had analyzed some possible methods for handling domain name disputes concerning IGO names and abbreviations, but not those of INGOs. A PDP on the topic was however not initiated due to lack of the requisite number of votes in the GNSO Council. Previously, in 2003, an ICANN Joint Working Group comprising community members from the ALAC, the GAC and the GNSO had also discussed various possible dispute resolution mechanisms for IGOs in response to a 2001 report on the applicability of the UDRP to certain types of identifiers (including those of IGOs) by WIPO. The Joint Working Group failed to reach consensus on WIPO's recommendations, and no formal action was taken by the GNSO Council or ICANN on the matter.

6 Approach Taken by the Working Group

6.1 Working Methodology

The IGO-INGO Access to Curative Rights Protection Mechanisms Working Group began its deliberations on 11 August 2014. It decided to conduct its work primarily through weekly conference calls, in addition to email exchanges on its mailing list, with further discussions taking place at ICANN Public Meetings when scheduled. All the Working Group's meetings are documented on its wiki workspace (<https://community.icann.org/x/37rhAg>), including its mailing list (<http://mm.icann.org/pipermail/gnso-igo-ingo-crp/>), draft documents, background materials and input received from ICANN's SO/ACs and the GNSO's Stakeholder Groups and Constituencies as well as during the public comment process for the Working Group's Initial Report.

The Working Group also prepared a Work Plan (<https://community.icann.org/x/9brhAg>), which was reviewed on a regular basis. In accordance with the GNSO's PDP Manual, the Working Group solicited early input from ICANN's SO/ACs and the GNSO's Stakeholder Groups and Constituencies, and considered all input received in response. It also reviewed the historical documentation on this topic early on in its deliberations⁷⁷, and considered advice provided by the GAC to the ICANN Board as well as the IGO Small Group Proposal (as described in Section 3, above).

The Working Group scheduled community sessions at each ICANN Public Meeting that took place after its formation up to and including ICANN60 in October-November 2017, at which it presented its preliminary findings and/or conclusions to the broader ICANN community for discussion and feedback. The topics discussed at the ICANN Public Meetings that took place just prior to the publication of the Working Group's Initial Report and through November 2017 are summarized in Section 3, above.

6.1.1 Working Group Membership and Attendance

The members⁷⁸ of the IGO-INGO Access to Curative Rights Protection Mechanisms Working Group are:

⁷⁷ Much of the historical records, treaty texts, reports and papers considered by the Working Group is listed on the Working Group's wiki space: <https://community.icann.org/x/DrvhAg>.

⁷⁸ A person may join a GNSO Working Group as either a Member or an Observer. Observers have read-only rights to the Working Group mailing list, and do not participate in meetings, discussions or consensus

Name	Affiliation	
Alex Lerman	Individual	SOI
Andrew Rosener	CBUC	SOI
Brian Scarpelli	IPC	SOI
Claudia MacMaster Tamarit	Int'l Org for Standardization	SOI
Crystal Ondo	RySG	SOI
David Heasley	IPC	SOI
David Maher	RySG	SOI
George Kirikos	Individual	SOI
Helen Palm	Individual	SOI
Imran Ahmed Shah	NCUC	SOI
Jay Chapman	CBUC	SOI
Jim Bikoff	IPC	SOI
Keith Drazek	RySG	SOI
Mason Cole	RySG	SOI
Mike Rodenbaugh	IPC	SOI
Nat Cohen	CBUC	SOI
Osvaldo Novoa	ISPCP	SOI
Paul Raynor Keating	NCUC	SOI
Paul Tattersfield	Individual	SOI
Petter Rindforth (chair)	IPC	SOI

calls. For a list of the Observers to this Working Group, see the Working Group's wiki space at <https://community.icann.org/x/97rhAg>.

Phil Corwin (co-chair till 11 May 2018)	RySG	SOI
Poncelet Ileleji	NPOC	SOI
Reg Levy	RrSG	SOI
Susan Kawaguchi (GNSO Council liaison)	CBUC	SOI
Theo Geurts	RrSG	SOI
Zak Muscovitch	CBUC	SOI

The Statements of Interest of the Working Group members can be found at <https://community.icann.org/x/97rhAg>.

The attendance records can be found at <https://community.icann.org/x/-jXxAg>. The email archives can be found at (<http://mm.icann.org/pipermail/gnso-igo-ingo-crp/>).

* The following are the ICANN SO/ACs and GNSO Stakeholder Groups and Constituencies for which Working Group members were requested to provide affiliations for:

RrSG – Registrars Stakeholder Group

RySG – Registries Stakeholder Group

CSG – Commercial Stakeholder Group

CBUC – Commercial and Business Users Constituency

IPC – Intellectual Property Constituency

ISPCP – Internet Service Providers and Connectivity Providers Constituency

NCSG – Non-Commercial Stakeholder Group

NCUC – Non-Commercial Users Constituency

NPOC – Not-for-Profit Operational Concerns Constituency

GAC – Governmental Advisory Committee

ALAC – At Large Advisory Committee

** This list was accurate as of 2 July 2018. Note that some members joined the Working Group only after it began meeting, and Working Group members that have since left are indicated with ++ against their names.

7 Community Input

7.1 Requests for Community Input

According to the GNSO's PDP Manual, a PDP Working Group should formally solicit statements from each GNSO Stakeholder Group and Constituency at an early stage of its deliberations. A PDP Working Group is also encouraged to seek the opinion of other ICANN Supporting Organizations and Advisory Committees who may have expertise, experience or an interest in the issue. As a result, in December 2014 the Working Group reached out to all ICANN SO/ACs as well as GNSO Stakeholder Groups and Constituencies with a request for input at the start of its deliberations. In response, statements were received from the following:

- Intellectual Property Constituency (IPC) - GNSO
- Internet Service Providers & Connectivity Providers Constituency (ISPCP) - GNSO
- Registries Stakeholder Group (RySG) - GNSO
- Governmental Advisory Committee (GAC)
- Security and Stability Advisory Committee (SSAC)

The full statements can be found here: <https://community.icann.org/x/T5gQAw>.

In January 2017, the Working Group published its Initial Report for public comment, with the comment period closing on 30 March 2017⁷⁹. A total of 46 comments were received, including from the GAC, the United States Government, 21 IGOs, and the GNSO's Registries and Registrars Stakeholder Groups as well as the Business and Intellectual Property Constituencies.

The Working Group also received and reviewed input and statements from the IGO observers to the GAC at various stages of its work, as well as all relevant GAC advice issued to date.

⁷⁹ See <https://www.icann.org/public-comments/igo-ingo-crp-access-initial-2017-01-20-en> for the announcement, link to all submissions received, and the staff report.

7.2 Review of Input Received

All the statements received as a result of the Working Group's solicitation of initial input from the various SO/ACs, Stakeholder Groups and Constituencies were reviewed by the Working Group as part of its deliberations, and considered by the Working Group as it developed its preliminary recommendations for its Initial Report. The GAC and several GNSO stakeholder groups and constituencies (i.e. the Registries Stakeholder Group, the Registrars Stakeholder Group, the IPC and CBUC) also filed comments on the Initial Report, along with 21 IGOs and several individuals (including members of this Working Group), all of which were taken into account by the Working Group as it developed its final recommendations.

To facilitate the Working Group's review of all the 46 public comments received to its Initial Report, staff prepared a Public Comment Review Tool that categorized all the comments received according to whether the commentator supported or did not support a preliminary recommendation⁸⁰. The Working Group agreed to focus its deliberations on whether the comments revealed new issues, facts or arguments not previously discussed during the preparation of the Initial Report. Staff also prepared a preliminary impact analysis of the various policy options concerning IGO jurisdictional immunity for the Working Group's reference. Some of the group's preliminary recommendations were modified as a result of the Working Group's review of the comments made to its Initial Report.

The recommendations contained in this Final Report are the result of the Working Group's consideration of all input received throughout this PDP.

⁸⁰ See the various versions of the Tool prepared for the Working Group's meetings, and the Working Group's discussions of the comments received, on 6 April 2017 (<https://community.icann.org/x/NMfRAw>), 13 April 2017 (<https://community.icann.org/x/1MzRAw>), 20 April 2017 (<https://community.icann.org/x/YtLRAw>) and 27 April 2017 (<https://community.icann.org/x/MtjRAw>).

8 Annex A – PDP Working Group Charter

WORKING GROUP CHARTER



Working Group Charter for a Policy Development Process for IGO and INGO Access to Curative Rights Protections

Working Group Name:	IGO-INGO Access to Curative Rights Protection Working Group	
Section I: Working Group Identification		
Chartering Organization(s):	Generic Names Supporting Organization (GNSO) Council	
Charter Approval Date:	25 June 2014 (further amended on 16 April 2015)	
Name of Working Group Chair:	Philip Corwin and Petter Rindforth	
Name(s) of Appointed Liaison(s):	Susan Kawaguchi	
Working Group Workspace URL:	https://community.icann.org/x/37rhAg	
Working Group Mailing List:	http://mm.icann.org/pipermail/gnso-igo-ingo-crp/	
GNSO Council Resolution:	Title:	Motion to initiate a Policy Development Process (PDP) for IGO and INGO Access to Curative Rights Protection Mechanisms
	Ref # & Link:	https://gnso.icann.org/en/council/resolutions#20140625-1 (amended at https://gnso.icann.org/en/council/resolutions#20150416-3)
Important Document Links:		
Section II: Mission, Purpose, and Deliverables		
Mission & Scope:		
Background		
At its meeting on 20 November 2013, the GNSO Council unanimously adopted all the consensus recommendations made by the GNSO’s PDP Working Group on the Protection of International Organization Names in All gTLDs (IGO-INGO Working Group) and requested an Issue Report to assist		

in determining whether a PDP should be initiated in order to explore possible amendments to the Uniform Dispute Resolution Policy (UDRP) and the Uniform Rapid Suspension procedure (URS), to enable access to and use of such curative rights protection mechanisms by protected IGOs and INGOs.

In 2007 a [GNSO Issue Report on Dispute Handling for IGO Names & Abbreviations](#) had analyzed some possible methods for handling domain name disputes concerning IGO names and abbreviations, but not those of INGOs. A PDP on the topic was however not initiated due to lack of the requisite number of votes in the GNSO Council. Previously, in 2003, an ICANN Joint Working Group comprising community members from the At Large Advisory Committee (ALAC), the Government Advisory Committee (GAC) and the GNSO had also discussed various possible dispute resolution mechanisms for IGOs in response to a 2001 report on the applicability of the UDRP to certain types of identifiers (including those of IGOs) by the World Intellectual Property Organization (WIPO). The Joint Working Group failed to reach consensus on WIPO's recommendations, and no formal action was taken by the GNSO Council or ICANN on the matter.

In January 2012 ICANN launched the New gTLD Program, which included a number of rights-protection mechanisms specifically developed for the Program. These included objection procedures to new gTLD applications (including a legal rights objection procedure for trademark owners and organizations with registrations in the .int TLD) and the URS for second level registrations in approved new gTLDs (modeled after the UDRP). The ICANN Board also granted certain temporary protections at the top and second levels in the New gTLD Program for the Red Cross movement, the International Olympic Committee and IGOs, which were to remain in place until a permanent solution based on GAC Advice and policy recommendations from the GNSO could be developed. The GNSO's recommendations, as approved by the GNSO Council on 20 November 2013, were submitted to the ICANN Board for consideration in February 2014. These were acknowledged by the Board in February 2014, in directing its New gTLD Program Committee (NGPC) to develop a comprehensive proposal taking into account the GAC advice received on the topic and the GNSO's recommendations. The NGPC developed and sent a proposal to the GAC in March 2014. In April 2014 the ICANN Board adopted those GNSO recommendations that are not inconsistent with GAC advice received on the same topic and resolved to facilitate dialogue among the GAC, GNSO and other affected parties to resolve the remaining differences between GAC advice and the GNSO recommendations.

Mission and Scope

This Curative Rights Protection for IGOs and INGOs PDP Working Group (Working Group) is tasked to provide the GNSO Council with policy recommendations regarding whether to amend the UDRP and URS to allow access to and use of these mechanisms by IGOs and INGOs and, if so in what respects or whether a separate, narrowly-tailored dispute resolution procedure at the second level modeled on the UDRP and URS that takes into account the particular needs and specific circumstances of IGOs and INGOs should be developed. In commencing its deliberations, the Working Group should at an early stage gather data and research concerning the specific topics listed in Section X of the Final Issue Report as meriting such further documentation.

As part of its deliberations, the CRP PDP Working Group should, at a minimum, consider the following issues detailed in Section IX of the Final Issue Report. These are:

- *The differences between the UDRP and the URS;*

- *The relevance of existing protection mechanisms in the Applicant Guidebook for the New gTLD Program;*
- *The interplay between the topic under consideration in this PDP and the forthcoming GNSO review of the UDRP, URS and other rights-protection mechanisms;*
- *The distinctions (if any) between IGOs and INGOs for purposes of this PDP;*
- *The potential need to distinguish between a legacy gTLD and a new gTLD launched under the New gTLD Program;*
- *The potential need to clarify whether the URS is a Consensus Policy binding on ICANN's contracted parties;*
- *The need to address the issue of cost to IGOs and INGOs to use curative processes; and*
- *The relevance of specific legal protections under international legal instruments and various national laws for IGOs and certain INGOs (namely, the Red Cross movement and the International Olympic Committee)*

The Working Group should also include the following additional topics in its deliberations:

- *Review the deliberations of the 2003 President's Joint Working Group on the 2001 WIPO report as a possible starting point for the PDP Working Group's work and consider whether subsequent developments such as the introduction of the New gTLD Program and the URS may mean that prior ICANN community recommendations on IGO dispute resolution are no longer applicable;*
- *Examine whether or not similar justifications and amendments should apply to both the UDRP and URS, or if each procedure should be treated independently and/or differently;*
- *Reach out to existing ICANN dispute resolution service providers for the UDRP and URS as well as experienced UDRP panelists, to seek input as to how the UDRP and/or URS might be amended to accommodate considerations particular to IGOs and INGOs;*
- *Determine what (if any) are the specific different considerations (including without limitation qualifying requirements, authentication criteria and appeal processes) that should apply to IGOs and INGOs;*
- *Conduct research on applicable international law regarding special privileges and immunities for IGOs*
- *Conduct research on the extent to which IGOs and INGOs already have trademarks and might be covered, in whole or in part, by existing UDRP and URS proceedings;*
- *Conduct research on the number and list of IGOs currently protected under Article 6ter of the Paris Convention on Intellectual Property;*
- *Conduct research on the number and list of INGOs included on the United Nations list of non-governmental organizations in consultative status with the Economic and Social Council. ;*
- *Consider whether or not there may be practicable alternatives, other than amending the UDRP and URS, that can nonetheless provide adequate curative rights protections for IGOs and INGOs, such as the development of a specific, narrowly-tailored dispute resolution procedure modeled on the UDRP and URS, and applicable only to IGOs and/or INGOs;*
- *Consider mechanisms that would require a very clear definition of the mission of the IGOs, its scope of operations and the regions and countries in which it operates; the goal here being to provide a context for the IGO or INGO similar to the scope and terms of a trademark with its*

<p><i>International Class and clear description of goods and services;</i></p> <ul style="list-style-type: none"> • <i>Consider recommendations that incorporate fundamental principles of fair use, acknowledge free speech and freedom of expression, and balance the rights of all to use generic words and other terms and acronyms in non-confusing ways; and</i> • <i>Bear in mind that any recommendations relating to the UDRP and URS that are developed by this PDP Working Group may be subject to further review under the GNSO’s forthcoming PDP to review the UDRP and all the rights protection mechanisms that were developed for the New gTLD Program.</i> <p>The Working Group should invite participation from other ICANN Supporting Organizations and Advisory Committees, including the GAC, and from interested IGOs and INGOs. It should track any ongoing discussions between the GAC and GNSO on resolving remaining differences between GAC advice and the GNSO recommendations on RCRC and IGO acronym protection. It may also wish to consider forming sub-groups to work on particular issues or sub-topics in order to streamline its work and discussions.</p> <p>For purposes of this PDP, the Working Group shall take into account any criteria for IGO or INGO protection that may be appropriate, including any that may have been developed previously, such as the list of IGO and INGO identifiers that was used by the GNSO’s prior PDP Working Group on the Protection of International Organization Identifiers in All gTLDs as the basis for their consensus recommendations and the GAC list of IGOs as provided to ICANN in March 2013¹.</p>
<p>Objectives & Goals:</p> <p>To develop, at a minimum, an Initial Report and a Final Report regarding the Working Group’s recommendations on issues relating to the access by IGOs and INGOs to curative rights protection mechanisms, following the processes described in Annex A of the ICANN Bylaws and the GNSO PDP Manual.</p>
<p>Deliverables & Timeframes:</p> <p>The Working Group shall respect the timelines and deliverables as outlined in Annex A of the ICANN Bylaws and the PDP Manual. As per the GNSO Working Group Guidelines, the Working Group shall develop a work plan that outlines the necessary steps and expected timing in order to achieve the milestones of the PDP as set out in Annex A of the ICANN Bylaws and the PDP Manual, and shall submit this to the GNSO Council.</p>
<p>Section III: Formation, Staffing, and Organization</p>
<p>Membership Criteria:</p>

¹ This paragraph was amended by the GNSO Council on 16 April 2015. The original text of this paragraph read as follows: “For purposes of this PDP, the scope of IGO and INGO identifiers is to be limited to those identifiers previously listed by the GNSO’s PDP Working Group on the Protection of International Organization Identifiers in All gTLDs as protected by their consensus recommendations (designated by that Working Group as Scope 1 and Scope 2 identifiers, and listed in Annex 2 of the Final Issue Report).”

The Working Group will be open to all interested in participating. New members who join after certain parts of work has been completed are expected to review previous documents and meeting transcripts.

Group Formation, Dependencies, & Dissolution:

This Working Group shall be a standard GNSO PDP Working Group. The GNSO Secretariat should circulate a 'Call For Volunteers' as widely as possible in order to ensure broad representation and participation in the Working Group, including:

- Publication of announcement on relevant ICANN web sites including but not limited to the GNSO and other Supporting Organizations and Advisory Committee web pages; and
- Distribution of the announcement to GNSO Stakeholder Groups, Constituencies and other ICANN Supporting Organizations and Advisory Committees

Working Group Roles, Functions, & Duties:

The ICANN Staff assigned to the Working Group will fully support the work of the Working Group as requested by the Chair including meeting support, document drafting, editing and distribution and other substantive contributions when deemed appropriate.

Staff assignments to the Working Group:

- GNSO Secretariat
- ICANN policy staff members (Berry Cobb & Mary Wong)

The standard Working Group roles, functions & duties shall be those specified in Section 2.2 of the GNSO Working Group Guidelines.

Statements of Interest (SOI) Guidelines:

Each member of the Working Group is required to submit an SOI in accordance with Section 5 of the GNSO Operating Procedures.

Section IV: Rules of Engagement

Decision-Making Methodologies:

The Chair will be responsible for designating each position as having one of the following designations:

- **Full consensus** - when no one in the group speaks against the recommendation in its last readings. This is also sometimes referred to as **Unanimous Consensus**.
- **Consensus** - a position where only a small minority disagrees, but most agree. *[Note: For those that are unfamiliar with ICANN usage, you may associate the definition of 'Consensus' with other definitions and terms of art such as rough consensus or near consensus. It should be noted, however, that in the case of a GNSO PDP Working Group, all reports, especially Final Reports, must restrict themselves to the term 'Consensus' as this may have legal implications.]*
- **Strong support but significant opposition** - a position where, while most of the group supports a recommendation, there is a significant number of those who do not support it.
- **Divergence** (also referred to as **No Consensus**) - a position where there is no strong support for any particular position, but many different points of view. Sometimes this is due to irreconcilable differences of opinion and sometimes it is due to the fact that no one has a particularly strong or convincing viewpoint, but the members of the group agree that it is worth listing the issue in the report nonetheless.
- **Minority View** - refers to a proposal where a small number of people support the

recommendation. This can happen in response to **Consensus**, **Strong support but significant opposition**, or **No Consensus**; or it can happen in cases where there is neither support nor opposition to a suggestion made by a small number of individuals.

In cases of **Consensus**, **Strong support but significant opposition**, and **No Consensus**, an effort should be made to document variances in viewpoint and to present any **Minority View** recommendations that may have been made. Documentation of **Minority View** recommendations normally depends on text offered by the proponent(s). In all cases of **Divergence**, the Working Group Chair should encourage the submission of minority viewpoint(s).

The recommended method for discovering the consensus level designation on recommendations should work as follows:

- i. After the group has discussed an issue long enough for all issues to have been raised, understood and discussed, the Chair, or Co-Chairs, make an evaluation of the designation and publish it for the group to review.
- ii. After the group has discussed the Chair's estimation of designation, the Chair, or Co-Chairs, should reevaluate and publish an updated evaluation.
- iii. Steps (i) and (ii) should continue until the Chair/Co-Chairs make an evaluation that is accepted by the group.
- iv. In rare cases, a Chair may decide that the use of polls is reasonable. Some of the reasons for this might be:
 - A decision needs to be made within a time frame that does not allow for the natural process of iteration and settling on a designation to occur.
 - It becomes obvious after several iterations that it is impossible to arrive at a designation. This will happen most often when trying to discriminate between **Consensus** and **Strong support but Significant Opposition** or between **Strong support but Significant Opposition** and **Divergence**.

Care should be taken in using polls that they do not become votes. A liability with the use of polls is that, in situations where there is **Divergence** or **Strong Opposition**, there are often disagreements about the meanings of the poll questions or of the poll results.

Based upon the Working Group's needs, the Chair may direct that Working Group participants do not have to have their name explicitly associated with any Full Consensus or Consensus views/positions. However, in all other cases and in those cases where a group member represents the minority viewpoint, their name must be explicitly linked, especially in those cases where polls were taken.

Consensus calls should always involve the entire Working Group and, for this reason, should take place on the designated mailing list to ensure that all Working Group members have the opportunity to fully participate in the consensus process. It is the role of the Chair to designate which level of consensus has been reached and to announce this designation to the Working Group. Working Group member(s) should be able to challenge the designation of the Chair as part of the Working Group discussion. However, if disagreement persists, Working Group members may use the process set forth below to challenge the designation.

If several participants (see Note 1 below) in a Working Group disagree with the designation given to a position by the Chair or any other consensus call, they may follow these steps sequentially:

1. Send email to the Chair, copying the Working Group explaining why the decision is believed to be in error.
2. If the Chair still disagrees with the complainants, the Chair will forward the appeal to the liaison(s) from the Chartering Organization (CO). The Chair must explain his or her reasoning in the response to the complainants and in the submission to the liaison(s). If the liaison(s) supports the Chair's position, the liaison(s) will provide their response to the complainants. The liaison(s) must explain their reasoning in the response. If the liaison(s) disagrees with the Chair, the liaison(s) will forward the appeal to the CO. Should the complainants disagree with the liaison(s)'s support of the Chair's determination, the complainants may appeal to the Chair of the CO or their designated representative. If the CO agrees with the complainants' position, the CO should recommend remedial action to the Chair.
3. In the event of any appeal, the CO will attach a statement of the appeal to the Working Group and/or Board report. This statement should include all of the documentation from all steps in the appeals process and should include a statement from the CO (see Note 2 below).

Note 1: Any Working Group member may raise an issue for reconsideration; however, a formal appeal will require that a single member demonstrates a sufficient amount of support before a formal appeal process can be invoked. In those cases where a single Working Group member is seeking reconsideration, the member will advise the Chair and/or Liaison(s) of their issue and the Chair and/or Liaison(s) will work with the dissenting member to investigate the issue and to determine if there is sufficient support for the reconsideration to initiate a formal appeal process.

Note 2: It should be noted that ICANN also has other conflict resolution mechanisms available that could be considered in case any of the parties are dissatisfied with the outcome of this process.

Status Reporting:

As requested by the GNSO Council, taking into account the recommendation of the Council liaison(s) to the Working Group.

Problem/Issue Escalation & Resolution Processes:

The Working Group will adhere to [ICANN's Expected Standards of Behavior](#) as documented in Section F of the ICANN Accountability and Transparency Frameworks and Principles, January 2008.

If a Working Group member feels that these standards are being abused, the affected party should appeal first to the Chair and Liaison(s) and, if unsatisfactorily resolved, to the Chair of the CO or their designated representative. It is important to emphasize that expressed disagreement is not, by itself, grounds for abusive behavior. It should also be taken into account that as a result of cultural differences and language barriers, statements may appear disrespectful or inappropriate to some but are not necessarily intended as such. However, it is expected that Working Group members make every effort to respect the principles outlined in ICANN's Expected Standards of Behavior as

referenced above.

The Chair, in consultation with the CO liaison(s), is empowered to restrict the participation of someone who seriously disrupts the Working Group. Any such restriction will be reviewed by the CO. Generally, the participant should first be warned privately, and then warned publicly before such a restriction is put into place. In extreme circumstances, this requirement may be bypassed.

Any Working Group member that believes that his/her contributions are being systematically ignored or discounted or wants to appeal a decision of the Working Group or CO should first discuss the circumstances with the Working Group Chair. In the event that the matter cannot be resolved satisfactorily, the Working Group member should request an opportunity to discuss the situation with the Chair of the CO or their designated representative.

In addition, if any member of the Working Group is of the opinion that someone is not performing their role according to the criteria outlined in this Charter, the same appeals process may be invoked.

Closure & Working Group Self-Assessment:

The Working Group will close upon the delivery of the Final Report, unless assigned additional tasks or follow-up by the GNSO Council.

Section V: Charter Document History

Version	Date	Description

Staff Contact:	Mary Wong	Email:	Policy-staff@icann.org
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9 Annex B – Minority Statements

Minority Statement of Philip S. Corwin

On June 25, 2014 the [Charter](#) for this Working Group (WG) was adopted, in which it was “tasked to provide the GNSO Council with policy recommendations regarding whether to amend the UDRP and URS to allow access to and use of these mechanisms by IGOs and INGOs and, if so in what respects or whether a separate, narrowly-tailored dispute resolution procedure at the second level modeled on the UDRP and URS that takes into account the particular needs and specific circumstances of IGOs and INGOs should be developed”. The Charter further directed the WG to consider a minimum number of issues, and it soon became apparent in its work that the most important was to consider “The relevance of specific legal protections under international legal instruments and various national laws for IGOs”.

After four years of effort this WG has utterly failed to provide a policy recommendation that reasonably resolves the central challenge it confronted; that being how to equitably resolve the inherent tension between the right of domain registrants to seek de novo review of the decision of a curative rights process (CRP) in a court of mutual jurisdiction, with the recognized scope of immunity from judicial process enjoyed by IGOs. Instead, it has produced a policy recommendation that grants excessive favoritism to registrant rights by effectively obliterating any shred of IGO immunity and, in doing so, casts ICANN into a role that is far beyond its proper remit. It is virtually ensured that this central recommendation will not be adopted ICANN’s Board, both on its own lack of merit and after the inevitable receipt of harsh and contrary GAC advice, in the event that GNSO Council elects to send it on to the Board – which, as I explain below, Council should refrain from doing.

This failure not only leaves the festering issue of IGO access to CRP for future resolution within the ICANN community, but brings into question the ability of the PDP consensus approach to resolve narrow but difficult legal/policy issues, or to adequately respond to the legitimate interests of governments and international intergovernmental organizations. I shall, in the second part of this document, outline my thoughts on what lessons the experience of this WG might have for GNSO Council’s ongoing “PDP 3.0” reform effort.

I was selected by this WG’s members as one of its two co-chairs shortly after Charter adoption, and continued in that role until May 11, 2018 when I submitted a letter of resignation stating that, due to other responsibilities and time demands, “I can no longer devote the time and effort required to effectively and responsibly serve as a Co-Chair of this WG. I shall remain a member of this WG and participate in the wrapping up of its work.” Given that I served as co-chair for most of the WG’s four year existence I bear some significant responsibility for its failure, and for that I apologize to the entire ICANN community. I believe that I have learned some important lessons from this unhappy experience that will

permit me to make more successful contributions to other ICANN policy development efforts, and that will be of assistance to Council as it pursues the PDP 3.0 reform effort.

Recommendation Five Should Be Rejected by Council and the Board

Recommendation Five addresses the central question that this WG wrestled with, that being what should occur in the rare but nonetheless realistic potential circumstance that a domain registrant sought de novo review of an adverse UDRP decision in a court of mutual jurisdiction and the IGO that successfully prosecuted the UDRP subsequently succeeded in asserting its judicial immunity, and the case was therefore dismissed for lack of jurisdiction over one of the parties to the dispute.

The relevant language of the [UDRP](#) pertaining to such circumstance is contained in Section 4(k), which states in its entirety:

k. Availability of Court Proceedings. *The mandatory administrative proceeding requirements set forth in [Paragraph 4](#) shall not prevent either you or the complainant from submitting the dispute to a court of competent jurisdiction for independent resolution before such mandatory administrative proceeding is commenced or after such proceeding is concluded. If an Administrative Panel decides that your domain name registration should be canceled or transferred, we will wait ten (10) business days (as observed in the location of our principal office) after we are informed by the applicable Provider of the Administrative Panel's decision before implementing that decision. **We will then implement the decision unless we have received from you during that ten (10) business day period official documentation (such as a copy of a complaint, file-stamped by the clerk of the court) that you have commenced a lawsuit against the complainant in a jurisdiction to which the complainant has submitted under [Paragraph 3\(b\)\(xiii\)](#) of the Rules of Procedure.** (In general, that jurisdiction is either the location of our principal office or of your address as shown in our Whois database. See [Paragraphs 1](#) and [3\(b\)\(xiii\)](#) of the Rules of Procedure for details.) **If we receive such documentation within the ten (10) business day period, we will not implement the Administrative Panel's decision, and we will take no further action, until we receive (i) evidence satisfactory to us of a resolution between the parties; (ii) evidence satisfactory to us that your lawsuit has been dismissed or withdrawn; or (iii) a copy of an order from such court dismissing your lawsuit or ordering that you do not have the right to continue to use your domain name.** (Emphasis added)*

That is, under current policy the dismissal of the litigation initiated by the losing domain registrant, for whatever reason, would result in the domain registrar's implementation of the UDRP Panel's decision to extinguish or transfer the domain.

Recommendation Five would turn that policy completely on its head for cases involving IGOs, stating:

Recommendation #5:

Where a losing registrant challenges the initial UDRP/URS decision by filing suit in a national court of mutual jurisdiction and the IGO that succeeded in its initial UDRP/URS complaint also succeeds in asserting jurisdictional immunity in that court, the decision rendered against the registrant in the predecessor UDRP or URS shall be set aside (i.e. invalidated).

While I concur with the other four recommendations contained in the Final Report, they constitute mere window dressing around the edges of this central IGO CRP issue. Those secondary recommendations do not directly address the primary question which underpinned the creation of this WG and which has generated so much discussion and controversy over the four years of its existence.

That question can be introduced and summarized as follows:

- The UDRP and URS both provide a losing domain registrant/respondent with a right to file a judicial appeal where the registrant has ties to a jurisdiction providing a relevant right of action. Both CRPs do that by permitting appeal to a court of mutual jurisdiction; that being a court jurisdiction at the location of either (a) the principal office of the Registrar or (b) the domain-name holder's address as shown for the registration of the domain name in the Registrar's WHOIS database at the time the complaint is submitted to the Provider.

Both CRPs also provide either party to a dispute with the right to file a judicial action prior to the initiation of or during the pendency of the CRP, with the examiner free to suspend or terminate the proceeding, or to continue on to determination (however, if the proceeding continues on to determination, any subsequent court decision is controlling as regards disposition of the domain). The URS also provides for an internal administrative appeal process that is not relevant to the overarching question before the WG.

Domain registrants who are either located within a jurisdiction that allows for litigation of a domain-related trademark dispute to be initiated by the registrant, or that have obtained a favorable "mutual jurisdiction" through deliberate selection of a registrar principally located in such a jurisdiction, value that legal right and do not want ICANN to require that they surrender it in deference to any party as a condition for domain registration.

- However, IGOs claim broad jurisdictional immunity from litigation, and both relevant law and judicial decisions provide substantial support for that position, although the ultimate answer as to whether an IGO enjoys such immunity in regard to a particular dispute can only be determined by the national court in which an immunity defense is raised. The issue of whether an IGO has waived its jurisdictional immunity as a consequence of filing a CRP action is also one that can only be answered by a national court when and if such an immunity defense is asserted; the "Swaine

- memo” described the variety of analytical approaches that would be employed by a court in this situation and noted that different approaches, in combination to differing national law and judicial precedents, could result in different decisions in similar cases. *Whatever the ultimate merits of an IGO’s claim to judicial immunity, IGOs do not want ICANN to require that they surrender any claim to judicial immunity as a condition for filing a CRP action.* In the view of IGOs, their legal rights – and the WG has discerned no available rights other than those conferred under the “trademark or service mark” standard of the UDRP and URS as being the proper basis for initiating a UDRP or URS – should be sufficient to establish standing without further condition, including immunity waiver.
- There is no indication that the potential legal clash between domain registrants and IGOs (or entities possessing sovereign immunity generally; that is, nation-states) was ever considered when the mutual jurisdiction clause of the UDRP was adopted. How, then, are the clashing legal rights of domain registrants and IGOs to be balanced? *And, in particular, what should occur when a losing respondent files a judicial appeal from a UDRP or URS decision, and the IGO targeted by the resulting lawsuit successfully asserts its defensive claim of judicial immunity and the litigation is dismissed by the court?*
 - This question is likely to arise very infrequently, as the percentage of UDRP cases that are judicially appealed is quite small, as is the number of CRP actions initiated by IGOs. *But unless this question has been answered in a manner that has a reasonable chance of being adopted as policy by the GNSO Council, and subsequently by the ICANN Board – after the Board considers any relevant GAC advice – this WG has failed in its primary responsibility.* While a WG’s final recommendations should not be determined solely by internal ICANN “political” considerations, a WG’s members must also recognize that its output is just the first step in the process and must be reasonably attuned to receiving a harmonious reception from the broader ICANN community as the policymaking process moves beyond its initial PDP stage.

Given this introductory background, I strongly oppose Recommendation Five, which would vitiate the decision rendered against the registrant in the predecessor UDRP or URS if the IGO succeeded in its assertion of judicial immunity in a subsequent appeal.

I do so for the following reasons:

- ICANN is a California non-profit corporation. It has no right or authority to override, or make any determination regarding the validity or scope of, the legal rights of either party to a CRP whether the relevant law in question

is that of California, the United States, or any other nation. I have been unable to support the GAC consensus advice on this matter because it requested that ICANN preemptively deny domain registrants their right, where available, to appeal a UDRP or URS decision to a court of competent and mutual jurisdiction; my view is that ICANN has no valid remit to extinguish the legal rights of one party on behalf of another. Similarly, ICANN has no authority to determine whether an IGO's filing of a CRP constituted a complete waiver of the procedural and substantive components of its judicial immunity, as that question of waiver can only be determined by a national court based upon its own approach to analyzing issues of sovereign immunity, relevant statutes and case law, and the facts of the dispute. Finally, as a practical matter, ICANN has no ability to prevent a domain registrant who has lost a CRP determination from filing a de novo "appeal", nor does ICANN have authority to prevent an IGO from asserting a claim of judicial immunity or to compel jurisdiction over an IGO in any national court that has determined that a party appearing before it possesses lawful immunity and is therefore not subject to its jurisdiction.

- This option would single out IGOs – and only IGOs among all possible classes of CRP Complainants -- for punitive treatment for successfully raising a judicial defense in a court appeal from a UDRP or URS decision. A trademark dispute is a civil case, and it is common in such cases for the respondent to seek summary dismissal or otherwise assert available defenses for the purpose of terminating the action prior to judgment on the merits. UDRP Rule 4k makes clear that an adverse administrative decision will be implemented against the domain registrant if the panel receives satisfactory evidence that the lawsuit has been dismissed or withdrawn, regardless of the reason for dismissal.

Proponents of Option 1 appear to feel that an assertion of judicial immunity is a violation of the "mutual jurisdiction" provision in the UDRP and URS, but that is an incorrect reading. An IGO's refusal to participate in a subsequent judicial appeal would be such a violation (and would likely result in a default judicial judgment for the domain registrant/plaintiff), but in the contemplated situation an IGO would have procedurally recognized and acquiesced to the court's jurisdiction through its appearance before it, while retaining its right to assert relevant substantive defenses. In short, an IGO asserting an immunity defense has accepted the court's procedural jurisdiction while retaining its ability to assert a substantive defense; if the court rejected that defense, the IGO would either have to acquiesce to its substantive jurisdiction or, by

withdrawing, provide the domain registrant with a favorable default judgment.

- This Recommendation fails to satisfy the charge contained in the WG Charter that we “provide the GNSO Council with policy recommendations regarding whether to amend the UDRP and URS to allow access to and use of these mechanisms by IGOs and INGOs”, as it would further discourage IGO use of available CRPs by making clear that such utilization requires an advance capitulation on any substantive claim of jurisdictional immunity raised in a subsequent court appeal. While the WG has determined that a handful of IGOs have utilized CRP, that does not necessarily negate the assertions of IGO representatives that the potential loss of judicial immunity deters many IGOs from utilizing existing CRP avenues. Indeed, ICANN has frozen the registration of all domains matching IGO acronyms at all new gTLDs pending resolution of this issue in a belief that present CRP policy would leave IGOs more vulnerable to cybersquatting than is the situation for private sector entities.
- The notion of vitiating a previously issued decision in a CRP based upon a successful assertion of rights by a party in a subsequent judicial proceeding (as opposed to a final court decision) is both badly flawed policy and of questionable legality.
- This Recommendation, regardless of support level or subsequent action by the GNSO Council, is highly unlikely to ever be adopted by the ICANN Board given the near-certainty of strong adverse advice from the GAC. That opposition would stem not just from the distance between it and prior GAC advice (which, as noted, I do not support), but from two other significant factors.

First, it would create a precedent that any successful assertion of sovereign immunity vitiates a prior CRP decision against the domain registrant bringing the judicial action, and that precedent would logically be applicable not just to IGOs but to any national government or unit thereof that files a CRP action; such result will never be acceptable to the GAC. Second, it would encourage bad actor domain registrants who had lost a CRP decision to file a judicial appeal against an IGO known to guard its sovereign immunity, as that would present the IGO with a very difficult choice between abandoning assertion of its legal status or, if succeeding in such assertion, seeing the cybersquatting determined to exist at the domain in question continue unabated and without additional remedy. While proponents of this Recommendation assert that it would merely restore matters to the stat quo ante that existed prior to the filing of the CRP, if the original CRP determination of bad faith registration and use of a domain had been correct that means that the cybersquatting

determined to exist in the CRP action would continue unabated with no alternative means available to stem the ongoing harm to the IGO and the Internet-using public.

This Recommendation should also be rejected because it represents a view of a minority of the full WG membership; and further, because the participating members of the WG were not representative of the broad ICANN community and the WG had, in fact, been operationally captured by a narrow and self-interested faction:

- The list of WG members that can be found at pp. 58-59 of the Final Report shows a membership of 25 (excluding Council Liaison). As the WG approached the decisional phase of its work in the fall of 2017, the other co-chair and I conducted outreach to WG members through support staff to determine whether those members who had not been active on calls and the email list had been continuing to monitor WG activities and wished to participate in a consensus call. We also had staff review all statements of interest (SOIs) to ensure they were current. The list contained in the Final Report resulted from that due diligence and is therefore valid.

However, the result of the consensus call released on June 9, 2018 showed that only 11 members of the WG – a minority of the full membership – supported the recommendation, while 2 (myself and the Chair) opposed it. Council and the Board should not approve a policy recommendation that failed to receive majority support among the full membership of the WG.

- Of the 11 WG members who supported the Recommendation, a majority (7) were either domain investors or attorneys representing domain investors (domainers), indicating that the WG's consensus call process had been captured by a narrow segment of the ICANN community with a significant commercial interest in the outcome. In addition, 3 of those 7 members participated in an individual capacity and are unaffiliated with any ICANN stakeholder group or constituency.

Domainers are certainly a legitimate segment of the ICANN community; indeed, for more than a full decade, from 2006-2017, I represented a trade association of domain investors within the Business Constituency (BC) and spent substantial time in defense of their legitimate rights. However, based upon that representation, I know that domainers often express a minority view on trademark-related matters even within the BC, much less the entirety of the ICANN community; and that due to their large domain portfolios are substantially more likely to be subject to a UDRP or URS filing than the average domain registrant.

I am certain that if this had been a Recommendation that ICANN implement GAC advice on this matter and thereby deprive domain registrants of a right of judicial appeal when an IGO was the complainant, and the majority of those WG members supporting the recommendation were IGOs, domainers would be quick to assert that the Recommendation should be rejected based upon the self-interest and lack of diversity among those supporting it. The same principle should apply when a WG dominated by domainers supports a recommendation that their appeal rights should extinguish the ability of IGOs to assert judicial immunity by essentially requiring that, if successful, they must acquiesce to a continuation of the cybersquatting found to exist by a CRP panel.

Section 3.2 of the GNSO WG Guidelines states:

3.2 Representativeness

*Ideally, a Working Group should mirror the diversity and representativeness of the community by having representatives from most, if not all, CO Stakeholder Groups and/or Constituencies. It should be noted that certain issues might be more of interest to one part of the community than others. The Chair, in cooperation with the Secretariat and ICANN Staff, is continually expected to assess whether the WG has sufficiently broad representation, and if not, which groups should be approached to encourage participation. **Similarly, if the Chair is of the opinion that there is over-representation to the point of capture, he/she should inform the Chartering Organization.** (Emphasis added)*

At several points in the course of the WG's activities, IGO representatives publicly stated that they perceived the WG to have been captured by commercial domain investor interests and might challenge any Final Report on that basis. The Co-Chairs were aware of that possibility and, in an effort to maximize the size and breadth of member participation to deflect such challenge, proposed to initiate the consensus call process with an anonymous poll of members seeking both positions on pending options, as well as full and frank justification for that view without the risk of harsh criticism from other WG members – while being clear that all WG consideration post-poll would be fully transparent. Unfortunately, a WG member who is a domainer not affiliated with any ICANN SO or SG and who strongly supports the Recommendation filed a Section 3.7 appeal in opposition to that proposed poll. After discerning that other WG members had concerns about an anonymous poll, but did not object to a transparent one, the co-chairs proposed to act in that manner -- but the objecting member persisted in his 3.7 action even after the co-chairs stated that the poll would be conducted with full transparency. That is unfortunate, because the final result is exactly what was feared; a central recommendation supported by only a minority of the WG, of whom a majority can be alleged by IGOs to have acted in their own commercial self-interest.

Support for Option 3 for Recommendation 5

Along with the Chair and another WG member, I supported Option 3 for Recommendation Five. While it is imperfect, I believe it constitutes the best feasible approach to balancing the respective legal rights of IGOs and domain registrants while confining ICANN within the proper bounds of its remit.

Option 3 states in its entirety:

Option 3:

Where a complainant IGO succeeds in a UDRP/URS proceeding, the losing registrant proceeds to file suit in a court of mutual jurisdiction, and the IGO subsequently succeeds in asserting jurisdictional immunity, the registrant shall have the option to transfer the dispute to an arbitration forum meeting certain pre-established criteria for determination under the national law that the original appeal was based upon, with such action limited to deciding the ownership of the domain name. The respondent shall be given 10 days (or a longer period of time if able to cite a national statute or procedure that grants a period longer than 10 days) to either: (1) inform the UDRP/URS provider [and the registrar] that it intends to seek arbitration under this limited mechanism; or (2) request that the UDRP/URS decision continue to be stayed, as the respondent has filed, or intends to file, case in court against the IGO's successful assertion of immunity. An IGO which files a complaint under the UDRP/URS shall be required to agree to this limited arbitration mechanism when filing the complaint. If, subsequently, it refuses to participate in the arbitration, the enforcement of the underlying UDRP/URS decision will be permanently stayed. The parties shall have the option to mutually agree to limit the original judicial proceedings to solely determining the ownership of the domain name. Subject to agreement by the registrant concerned, the parties shall also be free to utilize the limited arbitration mechanism described above at any time prior to the registrant filing suit in a court of mutual jurisdiction. In agreeing to utilize the limited arbitration mechanism, both the complainant and respondent are required to inform ICANN.

I strongly supported Option 3 for the following reasons:

- It acknowledges that ICANN has no right or authority to restrict or extinguish the legal rights and protections of domain registrants or IGOs.
- It properly leaves determination of the merits of an IGO's claim of judicial immunity to the court of competent and mutual jurisdiction in which it is raised.
- It provides the domain registrant with an ability to receive a determination of the legality of its domain use under relevant national law through an arbitration procedure in the wake of an IGO's successful assertion of judicial immunity. This would be a substantial improvement for domain registrants compared to current UDRP practice, where the prior UDRP decision would take effect upon dismissal of the litigation. It would therefore fulfill ICANN's commitment to provide a domain registrant with a

- second opinion under the law of a mutual jurisdiction, this being done via arbitration when the relevant national court determines that it has no authority over one of the parties to the suit and therefore cannot hear the matter. (I would not support such an arbitration right where the court has authority over both parties and had dismissed the suit based on substantive or procedural grounds other than an immunity defense.) While some members of the WG expressed concerns regarding the lack of full details of how such an arbitration would be conducted, there are multiple professional arbitration bodies around the world that regularly decide commercial disputes on the basis of national law, and there is no reason to believe that the same could not be achieved in this context in a subsequent implementation phase.
- As the only Option that restricts ICANN to its proper remit by restraining it from interference with any party's legal rights and protections, that properly leaves the determination of judicial immunity to the courts, that recognizes and attempts to balance the respective rights of domain registrants and IGOs, and that introduces the concept of arbitration (which is contained in the GAC advice on this subject), it was the sole Option under discussion that had any realistic chance of being adopted by both GNSO Council and the ICANN Board. While it is imperfect, as are most policy options addressing conflicts of legal rights, it is reasonable and balanced. Once it becomes apparent that Recommendation Five will never become ICANN policy, and that the desire of IGOs to have a means of redressing domain abuse that does not require immediate concession of any claims to substantive judicial immunity, I believe that this option will be revisited as a starting point for a means of attaining that goal in a fair and practical manner.

Potential Referral of this Matter to WG Reviewing All RPMs in all gTLDs

Option 4 for Recommendation Five received strong support but significant opposition. I was one of those who opposed it, and I remain opposed.

The text of Option4 reads:

Option 4:

Our initial report and recommendation (that no change is required) remains valid and should be reflected in the published report of this WG. Our report should advise that even if a change were advisable or appropriate, such would necessarily require modifications to the UDRP/URS and its accompanying rules. As such changes are within the ambit of the Review of All Rights Protection Mechanisms (RPM) PDP Working Group, we feel it inappropriate to inject our proposals in that regard. Accordingly, this Working Group strongly recommends that the

GNSO Council consult with RPM Working Group and the IGOs participating in the GAC, on whether any changes (if any) to how the UDRP procedure and URS are drafted and employed for IGOs should be referred to the RPM Working Group for consideration within its broader mandate to review the UDRP/URS.

It would appear that Option 4 has been negated by the consensus for Recommendation Five, as it would require substantial modifications of the UDRP and the URS and their accompanying rules. However, once it becomes clear that Recommendation Five will not become ICANN policy, members of this WG who are also participating in the ongoing Review of all Rights Protection Measures in all gTLDs may suggest that the difficult and divisive issue of how to reconcile registrant legal rights and claims of sovereign immunity from judicial process be relitigated in that WG forum.

The general issue of a judicial immunity based upon a sovereign immunity claim, and its specific application to IGOs, while important, has no broader implications for UDRP/URS appeals practice. If a singularly focused WG cannot provide a viable answer to this question after nearly four years of work, then it is insupportable to ask that it be taken up by a WG that already faces the daunting challenge of multiple difficult issues. Proponents of this Option have also failed to identify with any specificity what other aspects of the UDRP and URS might be implicated by a rifle shot policy recommendation regarding sovereign immunity.

As I am a co-chair of that other WG I am acutely aware of the contentious and challenging issues it must already address under its Charter, encompassing a review of all RPMs created for the new gTLD program in phase one of its work, and then proceeding to the first-ever review of the UDRP in phase two. The Charter of the RPM review WG already directs it to consider the issue of appeals, and the members of the WG are quite capable of determining whether it should address any special attention to the matter of sovereign immunity defenses in that context. While I will of course abide by the consensus among RPM working group members in regard to its administration, I will personally oppose adding the potential “poison pill” issue of treatment of claims of sovereign immunity in the CRP appeals process to its already heavy workload.

In my view, if that issue is to be revisited it should:

- Be considered within a separate and narrowly focused WG
- Address all potential claims of judicial immunity that may arise from both nation-state and IGO complainants, and
- Proceed only if there is a firm commitment from GAC members and IGO representatives to actively participate within it.

Mediation

Option 6 for Recommendation Five received strong support but significant opposition; I opposed it.

Its text reads:

Option 6:

We should arrange for the UDRP providers [to] provide [mediation] at no cost to the parties. The UDRP already permits the resolution of disputes through arbitration - I would bind the IGOs to arbitration in the same way the Mutual Jurisdiction clause binds complainants to the registrant's judicial system. Where an IGO refuses to take part in a judicial proceeding or judicial or arbitral proceedings, or successfully asserts immunity in a judicial proceeding, any prior UDRP determination would be quashed.

This Option should not become ICANN policy for a number of reasons:

- Its imprecise language seems to confuse voluntary arbitration with mandatory binding arbitration.
- While voluntary mediation may be worthy of encouragement, it should not be required when the resulting delay may permit especially harmful cybersquatting to continue for additional weeks or months.
- Just as this WG has no authority to commit ICANN funds to subsidize the filing of CRP actions by IGOs, we have no authority to require CRP providers to provide mediation services at no cost to the parties.
- To the extent that it requires vitiation of a prior UDRP or URS decision, it suffers from the same fatal defects as Recommendation Five.

The Swaine Memo

The “Legal Memo on IGO Jurisdictional Immunity Prepared by Professor Edward Swaine” appears at pages 89-122 of the Final Report. I am in general agreement with the background discussion of this memo and the WG’s consideration of it that appears at pp. 23-26 of the Report. As described in the Memo, while IGOs do possess judicial immunity its scope is not absolute and varies by jurisdiction; and different courts might rule differently on the question of whether an IGO had waived both procedural and substantive immunity by filing a CRP action subject to “mutual jurisdiction” language.

In 2015 the co-chairs recognized that we could not knowledgeably evaluate IGO claims of broad and absolutely immunity, or how courts would treat an assertion of such immunity in a post-CRP “appeal”, without guidance from an expert in international law. Although it delayed our work for about one year while we conducted a search for an available and knowledgeable expert, and while Professor Swaine prepared his memo, it would have been impossible to responsibly proceed without such input. I want to personally thank ICANN for providing the funds required to retain Professor Swaine’s services, and Professor Swaine for providing such detailed and expert guidance.

When this subject is revisited in the future following the likely failure of Recommendation Five to be adopted as ICANN policy, the Swaine memo should be looked to for guidance by whatever WG revisits the subject of reconciling registrant rights and IGO judicial immunity.

Appendix: Observations on Implications of this WG's Experience for the GNSO Policy Development Process 3.0

On May 8, 2018 ICANN released the document titled, "GNSO Policy Development Process 3.0/How to increase the effectiveness and efficiency of the GNSO Policy Development Process". Given my belief that this WG has failed to produce a recommendation on the key issue before it that constitutes a consensus representative of the full ICANN community, or that will ultimately be adopted as policy, I would like to share certain personal observations that may be of use to this ongoing Council effort to improve the efficiency and effectiveness of the multistakeholder model (MSM) consensus policy development process that is a central defining feature of ICANN. This ongoing effort is extremely important, because if WG participants are unwilling to compromise and seek acceptable middle ground policy solutions any dissenting minority can effectively deny the achievement of consensus and, by effectively exercising a veto, prevent ICANN from adopting necessary policy changes and additions in a timely manner.

Unless the MSM can be assured of greater efficiency and effectiveness the only viable alternative might be to adopt a more legislative model of policymaking, in which the achievement of high consensus levels would not be required to effect policy adoption in a timely fashion; that is, a majority would prevail and a minority would lose, as opposed to the PDP's present goal of a "win-win" compromise. Moving in that direction would fundamentally alter the nature of ICANN and its policymaking function, and therefore should be avoided unless it proves impossible to effectively reform the MSM.

Based upon my experience in this WG, the vast majority of it spent as a co-chair, I would make the following suggestions for consideration as the PDP 3.0 project continues:

- A WG should likely not be permitted to proceed if a key constituency that is a central focus of its work is unwilling to actively participate as a member. In the case of this WG, while IGO representatives did on occasion attend and speak at face-to-face meetings, and provide some other limited input to the WG, those IGO representatives stressed they were doing so solely in an individual capacity and not on behalf of the IGOs that employed them, and no IGO representative ever joined the WG as a member. In addition, these and other IGO representatives, along with GAC members, were engaged during much of the WG's existence in parallel "IGO small group" discussions with the Board. That parallel effort originally started as a forum to address a prior WG's contentious policy recommendations regarding permanent protections for IGO names and acronyms in new gTLDs, but eventually took up discussion of the same CRP issues being addressed simultaneously by this WG. It appeared that some IGO and GAC participants in those talks were under the misimpression that the "small group" discussions could deliver results on

CRP policy matters that can only be properly decided under ICANN Bylaws through the GNSO's PDP mechanism.

The absence of IGO membership and continuous participation in the WG had two undesirable effects. First, the views of domain investors came to dominate the WG's policy discussion with no countervailing input from IGOs regarding potential compromises. Second, when the co-chairs on occasion attempted to "play devil's advocate" and inject what we understood of the IGO perspective into ongoing discussions, this ultimately eroded co-chair authority as some WG members appeared to incorrectly believe that this balancing attempt constituted bias and lack of concern for registrant rights.

- The WG Guidelines should be clarified so that when a chair provides information to WG members regarding other developments within the ICANN community that are relevant to the WG's task, or conveys views based upon experience with the stages of the PDP mechanisms beyond initial WG efforts (Council and Board consideration of WG recommendations), doing so does not elicit charges of bias and political manipulation.

The co-chairs of this WG were asked to participate by the Board in several discussions it held with IGO representatives and GAC members regarding outstanding IGO-related issues, and we naturally consented. We subsequently conveyed back to the WG the substance of these discussions, as well as the fact that the CRP issue was of great concern to the GAC and that resolving it in a balanced manner could influence future governmental support for ICANN and its MSM. Also, as my co-chair had just left GNSO Council, and I was serving on it for much of this WG's tenure, we conveyed our personal views on what type of policy resolution could achieve both Council and Board approval, especially given the likelihood of contrary GAC advice to the Board.

Rather than being welcomed by the WG, this information and observations elicited charges from some WG members that we were attempting to manipulate its outcome, and were seeking a final result based on internal ICANN politics rather than objective analysis of relevant law and policy considerations.

- Steps must be taken to ensure that WG chairs can exercise their reasonable discretion in administration of WG activities. While I was a co-chair we always consulted with ICANN policy staff to ensure that our suggestions for the way forward were within any reasonable reading of WG Guidelines. Yet we faced substantial challenges, culminating in the

filing of a 3.7 appeal when we proposed to initiate an anonymous poll of all WG members in order to gain better understanding of their policy preferences; and that 3.7 appeal was continued even after we offered to conduct the poll transparently. After I departed as co-chair a second 3.7 appeal was filed by the same WG member in regard to procedures for completing the Final Report that had been communicated by the Chair and the Council Liaison. (I should also note that, while the filing of a 3.7 appeal should not necessitate the halting of WG activities, the initial one we faced was filed as the WG was about to enter the final decisional stage of its work, and the co-chairs expected it to be resolved expeditiously and never anticipated that it would result in a five-month halt.)

Given the impending launch of the first-ever EPDP, to address the Board’s Temporary Specification on collection and dissemination of WHOIS data in relationship to the EU’s GDPR privacy regulation, 3.7 appeal reform should be undertaken at once to minimize the possibility that this potent mechanism may be utilized to inordinately delay completion of the EPDP’s work within the limited time available.

At least three substantial reforms should be made to the 3.7 appeal process—

- A minimum threshold, akin to “probable cause”, should be required to be stated when an action is filed. In addition, ICANN support staff for the WG should file an explanatory statement regarding whether the administrative action being challenged was taken in consultation with staff and whether, in staff’s opinion, the challenged action is consistent with WG Guidelines. These steps can assist the Liaison and Council leadership in quickly assessing whether the challenge is meritorious or should be summarily dismissed.
- A meritorious challenge should be rapidly resolved under clear standards, and available forms of relief should be specified in the Guidelines. Absent expeditious action within a pre-stated framework, 3.7 appeals can cast a pall over a WG for an extended period or even bring its work to a halt for an indeterminate time.
- Sanctions should be established to deter the filing of non-meritorious 3.7 challenges to WG administrative proposals, including a public warning or termination of member status. If the only penalty for a substantially baseless challenge is its dismissal, there will be no effective disincentive for this mechanism being used to unduly delay or derail a WG’s efforts.

- Finally, under current WG Guidelines a 3.7 challenge can be used in reaction to a chair decision regarding WG administration, as well as to appeal a 3.5 finding that a WG member has acted in a disruptive and/or obstructive manner. These are very different situations, with the first regarding decisions about the best path forward for a WG, and the second relating to a member's personal conduct. They should be clearly differentiated in the Guidelines and not lumped together as at present.

The GNSO Policy Development Process 3.0 document contains multiple sections relevant to the above concerns and suggestions as well as to observations made in the first section of my Minority Statement, including:

- That “topics under discussion are arguably more complex and divisive compared to previous efforts”, an apt description for the legal treatment of IGO immunity and balancing the respective rights of domain registrants and IGOs. (section 3, p.5)
- While the IGO CRP WG was not large, it nonetheless experienced “discussions turning into zero sum games rather than efforts at compromise”; and it definitely demonstrated that the “longer the PDP lifecycle, the more WG members that drop out, potentially resulting in a ‘consensus by exhaustion’ situation” (section 3.1, p.5).
- Noting that three of the eleven individuals who supported Recommendation Five were not affiliated with any ICANN constituency or stakeholder group, this confirms the observation that, “Recently, WGs have seen a significant increase in individual members who do not represent anyone but themselves and individuals who have been engaged to represent the interests of a third party. There appears to be a fear of giving in and giving up ground at the expense of others. This leads at times to an apparent difficulty (sometimes unwillingness) to listen and meaningfully consider others’ viewpoints.” This was exacerbated by the unwillingness of IGO representatives to participate as WG members and make the case for, and work toward, compromise. (section 3.4, p.8)
- The existence and activities of the “IGO small group” dis-incentivized IGOs from participating in the WG, which exacerbated the imbalance in WG member interests and affiliations, and thereby resulted in “circumvention” of the PDP mechanism and provided “incentives to work around and outside of the PDP, for example, by petitioning the Board or working through respective governments”. Unfortunately, the Board contributed to this situation by allowing the IGO small group to discuss not just the previously addressed topic of permanent protections for IGOs in

- new gTLDs, but also the very access to CRP issue that was simultaneously being addressed in the WG (section 3.5, p.7).
- All of the Incremental improvements described in the document -- terms of participation for WG members; alternatives to open WG model; and limitations to joining of new members after a certain time – might have been of assistance in delivering a more balanced result from this WG (section 4.1, pp.8-9).
 - Likewise, it might have been of assistance to the co-chairs had there been “A playbook or expansion of the GNSO Working Group Guidelines to help WG leaders, members, or participants identify capture tactics as such, along with a toolkit of possible responses to help the WG get back on track without escalating the situation”. (section 4.2, p.9)
 - Given that the Section 3.7 appeal was brought against the co-chairs’ proposal for the means of initiating the consensus call process resulted in a delay in WG activity of five months, it is demonstrably correct that “further guidance may be welcome in case there is an appeal under section 3.7 that would result in a faster response to allow a WG to move forward more efficiently during and after the appeal process” (section 4.4, p.11).
 - Finally, while it might be useful to “scope the different positions at the outset of a PDP so that it is clear from the start where a possible middle / common ground lies”, the utility of that would be reduced where, as in the case of this WG, the central policy recommendation required an understanding of international law applicable to IGOs that was not available at the start of the WG’s activities, and where the WG comes to be operationally captured by a self-interested faction that has no interest in compromise. (section 4.4, p.11)

In conclusion, it is my hope that this Minority Statement will be of use to Council as it considers how to respond to the Final Report of the WG, as well as how to substantially improve the PDP mechanism for future WGs.

Minority Statement of Paul Tattersfield

Background

Recommendation 3 (b) “advising IGOs and INGOs to, in the first instance and prior to filing a UDRP or URS complaint, contact the registrar of record to address the harms for which they are seeking redress” in many ways surpasses GAC advice as it provides a route to deal with such harms at no cost and in a timely manner (minutes/hours) for both infringing and non-infringing domains (whereas URS or UDRP is weeks/months, involves substantial costs and the domain needs to infringe).

If we look at the harms the representatives of the IGOs submitted in evidence to the working group¹ to demonstrate an urgent need for a separate IGO specially tailored appeal mechanism within UDRP, we can safely say (a) that it is highly improbable that any registrant engaging in the cited harms is even going to defend a UDRP proceeding brought against them and (b) more often than not, will not even use an infringing domain.²

Further the idea that such a registrant losing a UDRP is then going to initiate a lawsuit is not credible, however this is how the IGOs have presented the issue at the highest level³ in an attempt to gain support for a separate curative rights appeal mechanism within UDRP⁴ and this is what the working group was asked to consider.

Legal expert’s external report

Professor Edward Swaine considered whether an IGO had a reasonable expectation that the scope of IGO immunity would extend to the situation where an IGO had initiated a claim absent UDRP.⁵

He isolated the case where an IGO would have a reasonable expectation of immunity namely the scenario where a domain-name registrant sought a declaratory judgment against an IGO in relation to some actual or potential infringement, and then asks his reader to believe that any reasonable expectation of immunity could also be applied to the scenario the working group was asked to consider namely where the IGO was initiating proceedings.

In every forum in the world we have a claimant (red) and a defendant (blue). Immunity is a blue shield it is ONLY a defence for a defendant (blue). There is no forum anywhere in the world (on any matter not just domain names) where an IGO can initiate a claim (red) and expect to use a blue immunity shield in either the initial round or any subsequent rounds, yet Professor Swaine at the bottom of page 8 of his memo is asking his readers to believe that it is possible.⁶

It isn't, therefore we can safely say absent UDRP the IGOs have no reasonable expectation of immunity after initiating a claim.

Proof

Absent UDRP there are two possible ways the immunity question could come before a court: (a) A TM owner seeks to acquire a domain which an IGO has registered, (b) An IGO seeks to acquire a domain which a domain registrant has registered.

In (a) the IGO would be entitled to raise an immunity defence, in (b) the IGO would be required to waive immunity for the court to consider the matter.

As the UDRP is an administrative procedure to help take less complex cases out of the judicial system if UDRP is to afford the same protections as any other forum then UDRP needs to take into account both cases.

(a) A TM owner seeks to acquire a domain which an IGO has registered by bringing a UDRP, (b) An IGO seeks to acquire a domain which a domain registrant has registered by bringing a UDRP.

Conclusion

The working group has not considered (a) which hides the fact that in (b) an IGO is never entitled to jurisdictional immunity after choosing to initiate proceedings. The incorrect Swaine reasoning introduces irrelevant complexity which confuses rather than clarifies and should therefore I believe have no place in the working group's final report.

Once one accepts that after initiating a dispute an IGO has no reasonable expectation of immunity it is far easier to narrow the options for recommendation #5 and this is what should have happened prior to any final working group consensus vote.

Note on recommendation #5

The various options the working group considered for Recommendation #5 were for what should happen in the extremely unlikely situation where the respondent files a post-UDRP action, the IGO asserts immunity by filing a motion to dismiss, the Court grants the motion and the case is dismissed rather than reaching a decision on the merits, as currently the effect of dismissal is that the UDRP decision is no longer deferred and the domain transfers to the Complainant.

It was very disappointing that those leading the working group were intent for political reasons on the working group reaching consensus around their own preferred option #3, an inelegant post-UDRP-post-judicial arbitration option, even when it was apparent the overwhelming majority of working group members did not support option #3.

Option #6 built on option #1 in an attempt to try and get those leading the working group to explore the opportunity of using UDRP process improvements for all IGO disputes not just the highly unlikely post-judicial disputes. Under Nominet DRS around 30% of disputes are settled through free private mediation at no cost to either party with less than 0.5% of disputes getting appealed.

While the working group reached consensus on option #1, had those leading the working group been less determined to develop and then try and force through their option #3 there would easily have been time for the working group to explore free private mediation for IGO & INGO UDRP disputes and the creation of an arbitration appeal route for all IGO & INGO UDRP disputes that registrants could choose to use as an alternative to the judicial route. As it was, those leading the working group were not prepared to allow any time for consideration of option #6 beyond presenting it as an additional option for voting on.

¹ WIPO Center observations on Initial Report on IGO Access to Curative Rights Protection Mechanisms

<https://forum.icann.org/lists/comments-igo-ingo-crp-access-initial-20jan17/msg00000.html>

² My comments on Initial Report on IGO Access to Curative Rights Protection Mechanisms

<https://forum.icann.org/lists/comments-igo-ingo-crp-access-initial-20jan17/msg00038.html>

³ Letter to World Leaders from The Secretary-General of the United Nations

<http://mm.icann.org/pipermail/gnso-igo-ingo-crp/2017-September/000845.html>

⁴ URS already contains an internal appeal mechanism

<https://www.icann.org/resources/pages/urs-2014-01-09-en>

⁵ The Final Memo from External Legal Expert

<https://community.icann.org/pages/viewpage.action?pageId=56131791>

(See also: 13 ANNEX F of this report)

⁶ Proof with colour highlighting

<http://mm.icann.org/pipermail/gnso-igo-ingo-crp/2018-May/001202.html>

**Minority Statement of Petter Rindforth
In support of Option 3 of Recommendation 5**

STATEMENT:

I, Petter Rindforth, fully support Option 3 of Recommendation 5, namely:

Where a complainant IGO succeeds in a UDRP/URS proceeding, the losing registrant proceeds to file suit in a court of mutual jurisdiction, and the IGO subsequently succeeds in asserting jurisdictional immunity, the registrant shall have the option to transfer the dispute to an arbitration forum meeting certain pre-established criteria for determination under the national law that the original appeal was based upon, with such action limited to deciding the ownership of the domain name. The respondent shall be given 10 days (or a longer period of time if able to cite a national statute or procedure that grants a period longer than 10 days) to either: (1) inform the UDRP/URS provider [and the registrar] that it intends to seek arbitration under this limited mechanism; or (2) request that the UDRP/URS decision continue to be stayed, as the respondent has filed, or intends to file, a judicial appeal against the IGO's successful assertion of immunity. An IGO which files a complaint under the UDRP/URS shall be required to agree to this limited arbitration mechanism when filing the complaint. If, subsequently, it refuses to participate in the arbitration, the enforcement of the underlying UDRP/URS decision will be permanently stayed. The parties shall have the option to mutually agree to limit the original judicial proceedings to solely determining the ownership of the domain name. Subject to agreement by the registrant concerned, the parties shall also be free to utilize the limited arbitration mechanism described above at any time prior to the registrant filing suit in a court of mutual jurisdiction. In agreeing to utilize the limited arbitration mechanism, both the complainant and respondent are required to inform ICANN.

BACKGROUND AND EXPLANATION:

As noted in the Executive Summary of the Report, the procedural rules for both the UDRP and URS require that the party filing the complaint agree to submit to the jurisdiction of a national court for purposes of a challenge to the initial panel determination. This requirement could potentially affect an IGO's ability to successfully claim immunity from national jurisdiction.

As Professor Swaine concluded in his final expert opinion, considered by the Working Group in June 2016:

There is no single universal rule that is applicable to IGOs' jurisdictional immunity globally. Rather, such immunity is essentially contextual - IGOs generally enjoy immunity

under international law, but different jurisdictions apply the law differently, and even within the same jurisdiction different IGOs may be treated differently.

It is also interesting to note that already back in 2003, based on the WIPO Secretariat Paper on a Possible De Novo Appeal Mechanism for Country Names, the possibility to introduce allowance for IGOs to submit to a special appeal procedure by way of de novo arbitration was discussed.

However, another section of the same paper noted that, while the option of bringing the dispute before a court of competent jurisdiction is open to both parties, it is particularly important for a losing respondent, for whom the UDRP procedure initiated by the complainant was mandatory.

The paper further noted that the requirement for UDRP complainants to submit to a "mutual jurisdiction" does not prevent either party from initiating court litigation elsewhere and, similarly, a State's submission to de novo arbitration should not restrict either party's recourse to a national court of justice.

It is important to find a solution that has the possibility to recognize the legal rights of both IGO's and the domain name registrant (domain holder).

Option 1 does not solve that problem. IGO's have clearly referred to their right to claim jurisdictional immunity. It was advised by IGO's in their communication of January 15, 2015 to the WG, that they consider their claimed immunity from national jurisdiction to be fundamental to their role as international bodies. This was repeated in the Governmental Advisory Committee's reply of April 29, 2015, to the WG's questions on the topic, stating that: *"There are non-judicial means to ensure due process, such as arbitration, which the GAC believes should be considered in more detail"*.

As concluded in Prof. Swain's report: it is not clear how all national courts around would deal with the jurisdictional immunity. If they accept, and it is the domain holder that has taken the case to court, the system is indeed not neutral to both parties. Also the domain holders need to have the possibility to have the case handled by a court or arbitration forum.

Clause 4(k) of the UDRP Policy states that *"The mandatory administrative proceeding requirements set forth in Paragraph 4 shall not prevent you or the complainant from submitting the dispute to a court of competent jurisdiction for independent resolution before such mandatory administrative proceeding is commenced or after such proceeding is concluded..."*

This is however not 100% clear for all jurisdictions and courts around the world.

One example of court decision based on a UDRP dispute is *Yoyo.Email Ltd v Royal Bank of Scotland Group Plc* [2015] EWHC 3509 (Ch) Case No: HC-2015-000379, of December 2, 2015, where the UK High Court of Justice held that "a proper construction of the UDRP clause [providing for independent court resolution of a controversy that is the subject of a UDRP proceeding] does not give rise to a separate cause of action in favour of the [registrant that is the losing party in that proceeding]." In conclusion: *"... it is trite law that an agreement cannot confer a jurisdiction on the court which it does not otherwise have. Under the [UDRP] the Registrar will abide by a judicial decision, but the function of this Court is not as a judicial review or appellate body. The claimant must demonstrate some independent right of action justiciable in this Court. Thus if a complaint is dismissed, the complainant may refer the case to the Court for an order that its trade mark has been infringed. If, on the other hand, the complaint is upheld, the burden is not on the complainant to establish infringement. It is for the registrant to plead and prove a cause of action giving him an interest in retaining the domain name. An unsuccessful registrant therefore faces considerable difficulty in identifying a cause of action upon which the Panel's decision can be challenged..."*

Although the above case does not involve an IGO, it generally show that proceeding with a UDRP or URS case to a national court is not always a simple and clear way to finally solve a domain name dispute.

Option 3 of Recommendation 5 is the best way to solve the issue.

It takes into consideration the legal aspects of both groups of interest: the IGOs as well as the domain holder. Especially if including the possibility for the parties to utilize the limited arbitration mechanism at any time prior to the registrant filing suit in a court of mutual jurisdiction, and further investigating the possibilities of made the decisions faster in order support both groups of interest (IGO's as well as domain holders).

The reason to keep the first step to file suit in a court of mutual jurisdiction is that some domain holders prefer this as the first step, as this is the traditional and open way, also in accordance with the current Policy.

However, arbitration is generally promoted as a way to resolve disputes efficiently, and proponents of arbitration commonly point to a number of advantages it offers over litigation, court hearings, and trials. As noted above, arbitration has also been suggested previously by IGO's and GAC, and gives at the same time a guarantee to the domain holder that the case will be fully considered.

Some examples of advantages of arbitration:

Avoids hostility: Because the parties in an arbitration are usually encouraged to participate fully and sometimes even to help structure the resolution, they are often

more likely to work together peaceably rather than escalate their angst and hostility toward one another, as is often the case in litigation.

Usually cheaper than litigation: There are also developed possibilities for online arbitration, which can cut the costs and time, and will work out very well when it comes to domain name disputes.

Faster than litigation: A court case normally takes from 18 months to three years to wend its way through the courts. It should be possible to develop an online arbitration procedure that can be close to the time related for an UDRP case.

Flexible: Unlike trials, which must be worked into overcrowded court calendars, arbitration hearings can usually be scheduled around the needs and availabilities of those involved, including weekends and evenings.

Simplified rules of evidence and procedure: The often convoluted rules of evidence and procedure do not apply in arbitration proceedings -- making them less stilted and more easily adapted to the needs of those involved. This is important for both IGO's and domain holders.

Private: Arbitration proceedings are generally held in private. And parties sometimes agree to keep the proceedings and terms of the final resolution confidential. Both of these safeguards can be a boon if the subject matter of the dispute might cause some embarrassment or reveal private information, such the list of users of the domain holder, and thereby also fulfil the requirements of the General Data Protection Regulation (GDPR).

Some suggested General Principles for Binding Arbitration:

Substantive law – arbitrator decides dispute under the national law under which the judicial appeal was originally brought, not the UDRP/URS, but both parties can mutually agree to proceed under another national law (this is the normal practice in arbitration cases).

Procedural rules – same as in the applicable judicial system / different rules can be mutually agreed to by both parties.

Venue – to be conducted in an arbitration forum certified to meet certain basic criteria, and cannot be an IGO or the arbitration forum that decided the underlying UDRP, to assure lack of bias and de novo review.

Panelist(s) – Default option is a three-member panel, the chair of which must be a retired judge from that jurisdiction; explore possibility of creating a standing panel from

which to choose the two panelists other than the chair (i.e. parties cannot choose the chair of the panel.)

Language – same language to be used as in national judicial forum (alternate language can be selected by mutual agreement of the parties).

Discovery – same as in judicial case.

Interim remedies (e.g., domain locking)? – same as if court case had continued.

Remedies – same as in judicial case.

Costs – seek to be the same as or lower than in a judicial case.

Enforcement of award – decision to uphold UDRP determination would result in domain transfer or extinguishment.

Precedential value of decision – While there's no way to fully replicate the precedent of a court decision, policy could state a distinct recommendation that any case shifted to arbitration should consider and seek to follow judicial precedent on similar cases brought under the same law, and also be consistent with prior arbitrations under that law (if any).

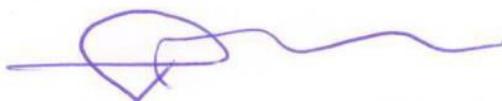
CONCLUSION AND RECOMMENDATION

Option 3 of Recommendation 5 is a mid-way to solve the problem for both IGO's and domain holders. And it is indeed the most practical and best solution of all of the options discussed and suggested.

I strongly recommend GNSO Council to further consider Option 3, and to work together with GAC to finalize a solution based on Option 3 in order to solve the topic of our WG in a decent and practical way that will in fact solve the problem for all groups of interest.

Stockholm, July 10, 2018

Sincerely yours,



Petter Rindforth

GNSO Council liaison to the working group and interim chair (July – September 8, 2014)
Co-Chair (September 8, 2014 – May 11, 2018)
Chair (from May 12, 2018)

10 Annex C – Text of Article 6^{ter} of the Paris Convention for the Protection of Industrial Property

Article 6^{ter} of the Paris Convention

Marks: Prohibitions concerning State Emblems, Official Hallmarks, and Emblems of Intergovernmental Organizations

(1) (a) The countries of the Union agree to refuse or to invalidate the registration, and to prohibit by appropriate measures the use, without authorization by the competent authorities, either as trademarks or as elements of trademarks, of armorial bearings, flags, and other State emblems, of the countries of the Union, official signs and hallmarks indicating control and warranty adopted by them, and any imitation from a heraldic point of view.

(b) The provisions of subparagraph (a), above, shall apply equally to armorial bearings, flags, other emblems, abbreviations, and names, of international intergovernmental organizations of which one or more countries of the Union are members, with the exception of armorial bearings, flags, other emblems, abbreviations, and names, that are already the subject of international agreements in force, intended to ensure their protection.

(c) No country of the Union shall be required to apply the provisions of subparagraph (b), above, to the prejudice of the owners of rights acquired in good faith before the entry into force, in that country, of this Convention. The countries of the Union shall not be required to apply the said provisions when the use or registration referred to in subparagraph (a), above, is not of such a nature as to suggest to the public that a connection exists between the organization concerned and the armorial bearings, flags, emblems, abbreviations, and names, or if such use or registration is probably not of such a nature as to mislead the public as to the existence of a connection between the user and the organization.

(2) Prohibition of the use of official signs and hallmarks indicating control and warranty shall apply solely in cases where the marks in which they are incorporated are intended to be used on goods of the same or a similar kind.

(3) (a) For the application of these provisions, the countries of the Union agree to communicate reciprocally, through the intermediary of the International Bureau, the list of State emblems, and official signs and hallmarks indicating control and warranty, which they desire, or may hereafter desire, to place wholly or within certain limits under the protection of this Article, and all subsequent modifications of such list. Each country of the Union shall in due course make available to the

public the lists so communicated. Nevertheless such communication is not obligatory in respect of flags of States.

(b) The provisions of subparagraph (b) of paragraph (1) of this Article shall apply only to such armorial bearings, flags, other emblems, abbreviations, and names, of international intergovernmental organizations as the latter have communicated to the countries of the Union through the intermediary of the International Bureau.

(4) Any country of the Union may, within a period of twelve months from the receipt of the notification, transmit its objections, if any, through the intermediary of the International Bureau, to the country or international intergovernmental organization concerned.

(5) In the case of State flags, the measures prescribed by paragraph (1), above, shall apply solely to marks registered after November 6, 1925.

(6) In the case of State emblems other than flags, and of official signs and hallmarks of the countries of the Union, and in the case of armorial bearings, flags, other emblems, abbreviations, and names, of international intergovernmental organizations, these provisions shall apply only to marks registered more than two months after receipt of the communication provided for in paragraph (3), above.

(7) In cases of bad faith, the countries shall have the right to cancel even those marks incorporating State emblems, signs, and hallmarks, which were registered before November 6, 1925.

(8) Nationals of any country who are authorized to make use of the State emblems, signs, and hallmarks, of their country may use them even if they are similar to those of another country.

(9) The countries of the Union undertake to prohibit the unauthorized use in trade of the State armorial bearings of the other countries of the Union, when the use is of such a nature as to be misleading as to the origin of the goods.

(10) The above provisions shall not prevent the countries from exercising the right given in paragraph (3) of Article 6quinquies, Section B, to refuse or to invalidate the registration of marks incorporating, without authorization, armorial bearings, flags, other State emblems, or official signs and hallmarks adopted by a country of the Union, as well as the distinctive signs of international intergovernmental organizations referred to in paragraph (1), above".

11 Annex D - Text of Final IGO Small Group Proposal and Accompanying Board Letter

4 October 2016

Dr. Stephen D. Crocker, Chair
Board of Directors, ICANN

Donna Austin, GNSO Council Vice-Chair (Contracted Parties House)
Heather Forrest, GNSO Council Vice-Chair (Non-Contracted Parties House)
James Bladel, GNSO Chair

NEXT STEPS IN RECONCILING GAC ADVICE AND GNSO POLICY RECOMMENDATIONS WITH RESPECT TO THE PROTECTION OF IGO ACRONYMS IN THE DOMAIN NAME SYSTEM

Dear Donna, Heather and James,

I write on behalf of the ICANN Board of Directors, in response to the GNSO Council's letter to the Board of 31 May 2016 concerning next steps in the reconciliation of GAC advice with GNSO policy recommendations relating to the protection of certain Red Cross identifiers and International Governmental Organizations (IGO) acronyms (<https://www.icann.org/en/system/files/correspondence/gnsocouncilchairs-to-crocker-31may16-en.pdf>). We note the GNSO Council's request for specific input from the Board on this topic, and wish to record our appreciation to the Council for the discussion that we had at ICANN56 in Helsinki.

As we mentioned at the time, staff and Board representatives continue to work with a small group of representatives from the GAC and the IGOs to finalize a proposal regarding IGO acronym protection to be sent to the GAC and the GNSO for consideration. In this regard, I am pleased to inform you that the Board has been notified that the small group has reached consensus on a proposal for a number of general principles and suggestions that it hopes will be acceptable to the GAC and the GNSO. I attach that proposal to this letter for the GNSO's review.

The Board's understanding is that those aspects of the proposal that concern curative rights protection may be referred by the GNSO Council to the GNSO's Working Group that is conducting the ongoing Policy Development Process (PDP) on IGO-INGO Access to Curative Rights Mechanisms. We understand further that the Working Group is

currently discussing preliminary recommendations that it intends to publish for public comment soon, in the form of an Initial Report. We therefore hope that the presentation of the attached proposal is timely, and will be fully considered by the Working Group regarding the specific topic of enabling adequate curative rights protections for IGO acronyms, and in conjunction with the GNSO Council's management of the overall process for possible reconciliation of GNSO policy with GAC advice. We also acknowledge, in line with prior correspondence between the Board's New gTLD Program Committee and the GNSO Council, that the Board will not take action with respect to GAC advice on curative rights protections for IGOs prior to the conclusion of the GNSO's PDP.

Similarly, the Board hopes that the other elements of the attached proposal will be helpful to the GNSO in its deliberations over considering possible amendments to its previously adopted policy recommendations on preventative protection for IGO acronyms. We have acknowledged previously the process in the GNSO's PDP Manual that will apply to the consideration of any such amendment prior to Board consideration of the policy recommendations (<https://gns0.icann.org/en/correspondence/chalaby-to-robinson-16jun14-en.pdf>).

On behalf of the Board, I wish to reiterate our belief that the most appropriate approach for the Board in this matter is to help to facilitate a procedural way forward for the reconciliation of GAC advice and GNSO policy prior to the Board formally considering substantive policy recommendations. We note that the attached proposal concerns only the matter of protection for IGO acronyms, and does not also cover the outstanding issue of protection for Red Cross national society names and the identifiers of the international Red Cross movement. We hope to continue discussion on this topic with the GNSO and the GAC, and anticipate a fuller discussion amongst all affected parties concerning resolution of the issue of protections for the Red Cross and IGOs at the upcoming ICANN57 meeting in Hyderabad in early November. We will direct ICANN staff to coordinate the Hyderabad scheduling for each of our groups accordingly.

We continue to appreciate the GNSO's hard work in developing policy recommendations and look forward to working together with you on this matter. In the meantime, we note that the temporary protections afforded to IGO acronyms remain in place while we continue our discussions.

Thank you.

Sincerely,



IGO “SMALL GROUP” PROPOSAL FOR DEALING WITH THE PROTECTION OF IGO ACRONYMS AT THE SECOND LEVEL OF THE DOMAIN NAME SYSTEM (4 October 2016)

Executive Summary

This Paper sets out a proposal to deal with the protection of IGO acronyms at the second level in the domain name system (the ICANN Board permanently implemented protections for full names at the top and second levels on 30 April 2014). It describes a process whereby an Eligible IGO (as defined in this Paper) may be notified of a third party registration of its acronym in a new gTLD launched under ICANN’s New gTLD Program, as well as the proposed establishment of appropriate dispute resolution processes to enable protection of an Eligible IGO’s acronym in appropriate circumstances in all gTLDs.

The proposal outlined in this Paper was developed by the “small group”¹ of representative IGOs in conjunction with GAC and Board (NGPC) representatives. ICANN staff assisted with certain aspects of drafting as well as subject matter advice during the process.

It is hoped that this Paper, coupled with further detailed discussions with the GNSO, the GAC and staff as to the feasibility of these proposals and their implementation will lead

¹ This informal IGO “small group” had been formed following the ICANN51 meeting in October 2014, comprising representatives from various IGOs working with GAC and Board (NGPC) representatives to develop this proposal in order to facilitate a reconciliation of GAC advice and GNSO policy recommendations on the issue of IGO acronyms protection. See, e.g., the GAC’s ICANN53 Buenos Aires Communique (June 2015) (https://gacweb.icann.org/download/attachments/28278854/GAC_Buenos_Aires_53_Communique.pdf?version=1&modificationDate=1436284325000&api=v2); this January 2015 letter from the NGPC Chair to the GNSO Council (<https://gns0.icann.org/en/correspondence/chalaby-to-robinson-15jan15-en.pdf>); this July 2015 letter from the OECD Secretary-General to ICANN’s CEO (<https://www.icann.org/en/system/files/correspondence/gurria-to-chehade-20jul15-en.pdf>); and the most recent GAC Communique from ICANN56 Helsinki (June 2016) (https://gacweb.icann.org/download/attachments/27132037/20160630_GAC_ICANN_56_Communique_FINAL_%5B1%5D.pdf?version=1&modificationDate=1469016353728&api=v2).

to an agreed permanent solution for the protection of IGO acronyms in the domain name system.

Background

The IGO-GAC-NGPC small group that has been discussing the topic of appropriate IGO protections, based on the NGPC's initial proposal of March 2014, agree that the following general principles should underpin the framework for any permanent solution concerning the protection of IGO names and acronyms in the domain name system:

1. The basis for protection of IGO acronyms should not be founded in trademark law, as IGOs are created by governments under international law and are in an objectively different category of rights-holders;
2. As IGOs perform important global missions with public funds, the implementation of appropriate protections for IGO names and acronyms is in the public interest; and
3. The Eligible IGOs that would qualify for protections under this proposal are those that are named on the GAC List of IGOs (initially submitted to ICANN in March 2013) as may be updated from time to time in accordance with GAC advice issued on 22 March 2013.

Proposals

1. Pre-Registration Protections for IGO Acronyms:

- A process will be established whereby Eligible IGOs will be able to submit to the GAC Secretariat within a defined time period and at no cost to them, up to two acronyms per IGO (representing their names in up to two different languages) to be added to a mechanism functionally equivalent to the Trademark Clearinghouse (TMCH).
- Participating Eligible IGOs shall designate a contact email address (which shall be updated from time to time by the IGO) via the GAC Secretariat and within a defined time period to receive email notifications of domain name registrations corresponding to their submitted IGO Acronyms for the duration of the existence of any mechanism functionally equivalent to the TMCH.
- Where the above proposals differ from the existing GNSO policy recommendations, the GNSO will be requested to consider modifying its recommendations, as envisaged in the 2014 discussion and correspondence between the GNSO Council and the NGPC.

2. Dispute Resolution Mechanism

- ICANN will facilitate the development of rules and procedures for a separate (i.e., separate from the existing UDRP) dispute resolution mechanism to resolve

claims of abuse of domain names that are registered and being used in situations where the registrant is pretending to be the IGO or that are otherwise likely to result in fraud or deception, *and* (a) are identical to an IGO acronym; (b) are confusingly similar to an IGO acronym; or (c) contain the IGO acronym.

- Decisions resulting from this mechanism shall be “appealable” through an arbitral process to be agreed.

3. Rapid relief mechanism

- ICANN will facilitate the creation of a mechanism through which an Eligible IGO may obtain a rapid temporary suspension of a domain name in situations where it would not be reasonable for it to use the agreed Dispute Resolution Mechanism, as per the specific conditions defined below. For clarity, this procedure would not be intended for use in any proceedings with material open questions of fact, but only clear-cut cases of abuse.
- To obtain such relief an Eligible IGO must demonstrate that:
 - 1) The subject domain name is (a) identical or confusingly similar to an IGO acronym, and (b) registered and used in situations where the registrant is pretending to be the IGO or that are otherwise likely to result in fraud or deception; and
 - 2) there is an obvious risk of imminent harm from the claimed abuse of such domain name, (*e.g.* such as fraudulently soliciting donations in the wake of a humanitarian disaster).
- Relief under this mechanism will be the same as that provided under the URS.

4. Costs related to the mechanisms referred to in this proposal

- ICANN will work with the IGOs and the mechanism providers to ensure that IGOs are not required to pay filing or any other ICANN-defined fees to access and use those mechanisms unless the examiner finds the case to have been brought in bad faith. Three or more findings of cases brought in bad faith by the same IGO may lead to that IGO being suspended from using the mechanism for a period of one year.

5. Glossary

- *Eligible IGO*: An intergovernmental organisation whose name appears on the list attached as Annex 2 to the 22 March 2013 Letter from Heather Dryden, Chair of the Governmental Advisory Committee to Steve Crocker, Chair, ICANN Board as may be updated from time to time in accordance with the GAC advice issued on 22 March 2013.

- *IGO Acronym*: An abbreviation of the names of Eligible IGOs in up to two languages.

Next Steps

- 1) This proposal will be circulated to and discussed with the larger group of IGOs, and to the GAC and the GNSO, including the Chairs of the Curative Rights PDP Working Group;
- 2) Subject to advice from the GAC and the GNSO, the GDD will consider adopting the amended proposal and instructing staff to work up the relevant implementation details for subsequent discussion and (as appropriate) approval; and
- 3) Temporary protection for IGO Acronyms will cease when the new process is implemented (as noted above, IGO full names have been accorded protection at both the top and second levels pursuant to the ICANN Board's decision of 30 April 2014).

12 Annex E - Compilation of GAC Communications and Advice Issued Concerning IGO Protections

COMPILATION OF GAC COMMUNICATIONS AND ADVICE CONCERNING PROTECTION FOR IGO NAMES & ACRONYMS

April 2012 (Letter to ICANN Board)

The GAC has considered the Board's request for policy advice on the expansion of protections to include IGOs, and advises that in the event that additional IGOs are found to meet the above criteria, this would be a consideration in the formulation of GAC advice for IGO protections in future rounds, as well as consideration of protections for IGOs, more generally.

Therefore, the GAC advises that no additional protections should be afforded to IGOs, beyond the current protections found in the Applicant Guidebook, for the current round.

October 2012 (Toronto Communique)

While the GAC continues its deliberations on the protection of the names and acronyms of Intergovernmental Organizations (IGOs) against inappropriate third-party registration;

The GAC advises the ICANN Board that:

- In the public interest, implementation of such protection at the second level must be accomplished prior to the delegation of any new gTLDs, and in future rounds of gTLDs at the second and top level.
- The GAC believes that the current criteria for registration under the .int top level domain, which are cited in the Applicant Guidebook as a basis for an IGO to file a legal rights objection, provide a starting basis for protecting IGO names and acronyms in all new gTLDs.
- Building on these criteria, the GAC and IGOs will collaborate to develop a list of the names and acronyms of IGOs that should be protected. Pending further work with ICANN on specific implementation measures for this initiative, the GAC believes this list of IGOs should be approved for interim protection through a moratorium against third-party registration prior to the delegation of any new gTLDs.

April 2013 (Beijing Communique)

The GAC stresses that the IGOs perform an important global public mission with public funds, they are the creations of government under international law, and their names

and acronyms warrant special protection in an expanded DNS. Such protection, which the GAC has previously advised, should be a priority.

This recognizes that IGOs are in an objectively different category to other rights holders, warranting special protection by ICANN in the DNS, while also preserving sufficient flexibility for workable implementation.

The GAC is mindful of outstanding implementation issues and commits to actively working with IGOs, the Board, and ICANN Staff to find a workable and timely way forward.

Pending the resolution of these implementation issues, the GAC reiterates its advice to the ICANN Board that ... appropriate preventative initial protection for the IGO names and acronyms on the provided list be in place before any new gTLDs would launch.

July 2013 (Durban Communiqué)

The GAC reaffirms its previous advice from the Toronto and Beijing Meetings that IGOs are in an objectively different category to other rights holders thus warranting special protection by ICANN. IGOs perform important global public missions with public funds and as such, their identifiers (both their names and their acronyms) need preventative protection in an expanded DNS.

The GAC understands that the ICANN Board, further to its previous assurances, is prepared to fully implement GAC advice; an outstanding matter to be finalized is the practical and effective implementation of the permanent preventative protection of IGO acronyms at the second level.

The GAC advises the ICANN Board that:

The GAC is interested to work with the IGOs and the NGPC on a complementary cost-neutral mechanism that would:

- a. provide notification to an IGO if a potential registrant seeks to register a domain name matching the acronym of an IGO at the second level, giving the IGO a reasonable opportunity to express concerns, if any; and
- b. allow for an independent third party to review any such registration request, in the event of a disagreement between an IGO and potential registrant.

The initial protections for IGO acronyms confirmed by the NGPC at its meeting of 2 July 2013 should remain in place until the dialogue between the GAC, NGPC, and IGO representatives ensuring the implementation of preventative protection for IGO acronyms at the second level is completed.

November 2013 (Buenos Aires Communiqué)

The GAC advises the ICANN Board that:

The GAC, together with IGOs, remains committed to continuing the dialogue with NGPC on finalising the modalities for permanent protection of IGO acronyms at the second level, by putting in place a mechanism which would:

- a. provide for a permanent system of notifications to both the potential registrant and the relevant IGO as to a possible conflict if a potential registrant seeks to register a domain name matching the acronym of that IGO;
- b. allow the IGO a timely opportunity to effectively prevent potential misuse and confusion;
- c. allow for a final and binding determination by an independent third party in order to resolve any disagreement between an IGO and a potential registrant; and
- d. be at no cost or of a nominal cost only to the IGO.

The GAC looks forward to receiving the alternative NGPC proposal adequately addressing this advice. The initial protections for IGO acronyms should remain in place until the dialogue between the NGPC, the IGOs and the GAC ensuring the implementation of this protection is completed.

March 2014 (Singapore Communique)

The GAC recalls its previous public policy advice from the Toronto, Beijing, Durban and Buenos Aires Communiqués regarding protection for IGO names and acronyms at the top and second levels and awaits the Board's response regarding implementation of the GAC advice.

June 2014 (London Communique)

The GAC:

- reaffirms its advice from the Toronto, Beijing, Durban, Buenos Aires and Singapore Communiqués regarding protection for IGO names and acronyms at the top and second levels, as implementation of such protection is in the public interest given that IGOs, as created by governments under international law are objectively different rights holders;
- notes the NGPC's letter of 16 June 2014 to the GNSO concerning further steps under the GNSO Policy Development Process while expressing concerns that the process of implementing GAC advice has been so protracted;
- welcomes the NGPC's assurance that interim protections remain in place pending any such process; and
- confirms its willingness to work with the GNSO on outcomes that meet the GAC's concerns.

October 2014 (Los Angeles Communique)

The GAC reaffirms its advice from the [Toronto](#), [Beijing](#), [Durban](#), [Buenos Aires](#), [Singapore](#) and [London](#) Communiqués regarding protection of IGO names and

acronyms at the top and second levels, as implementation of such protection is in the public interest given that IGOs, as created by governments under international law, are objectively different right holders; namely,

- i. Concerning preventative protection at the second level, the GAC reminds the ICANN Board that notice of a match to an IGO name or acronym to prospective registrants, as well as to the concerned IGO, should apply in perpetuity for the concerned name and acronym in two languages, and at no cost to IGOs;
- ii. Concerning curative protection at the second level, and noting the ongoing GNSO PDP on access to curative Rights Protection Mechanisms, the GAC reminds the ICANN Board that any such mechanism should be at no or nominal cost to IGOs; and further, in implementing any such curative mechanism,

The GAC advises the ICANN Board:

- that the UDRP should not be amended;
- welcomes the NGPC's continued assurance that interim protections remain in place pending the resolution of discussions concerning preventative protection of IGO names and acronyms; and
- supports continued dialogue between the GAC (including IGOs), the ICANN Board (NGPC) and the GNSO to develop concrete solutions to implement long-standing GAC advice.

February 2015 (Singapore Communique)

The GAC will continue to work with interested parties to reach agreement on appropriate permanent protections for names and acronyms for Inter-Governmental Organisations. This will include working with the GNSO PDP Working Group on IGO-INGO Access to Curative Rights Protection Mechanisms; and with IGOs and the NGPC.

June 2015 (Buenos Aires Communique)

Consistent with previous GAC advice in previous Communiqués regarding protection for IGO names and acronyms at the top and second levels, the GAC takes note of the progress made by the informal “small group” towards developing mechanisms in line with previous GAC advice, and calls upon the small group to meet in the near term with a view towards developing a concrete proposal for these mechanisms before the next ICANN meetings in Dublin; and welcomes the preventative protections that remain in place until the implementation of permanent mechanisms for protection of IGO names and acronyms at the top and second levels.

October 2015 (Dublin Communique):

The GAC advises the Board:

- to facilitate the timely conclusion of discussions of the “small group” and the NGPC in an effort to resolve the issue of IGO protections.

June 2016 (Helsinki Communique):

The GAC remains committed to protections of IGO names and acronyms at the top and second levels, which are in the public interest given that IGOs, as publicly-funded entities created by governments under international law, are objectively unique rights holders.

The GAC recalls its advice since the 2012 Toronto Communiqué in this regard, and remains of the view that: (i) concerning preventive protection at the second level, that notice of a match to an IGO name or acronym to prospective registrants as well as the concerned IGO should be mandated in perpetuity for the concerned name and acronym in two languages and at no cost to IGOs; (ii) concerning curative protection at the second level, and noting the ongoing GNSO PDP on access to curative rights protection measures, that any such mechanism should be separate from the existing UDRP, offer parties an “appeal” through arbitration, and be at no or nominal cost to IGOs;

The GAC notes the ongoing work of the informal “small group” and the efforts of those involved to develop mechanisms that implement the above-mentioned advice. The GAC remains of the view that the preventive protections for IGO acronyms should be maintained pending the implementation of mechanisms for the permanent protection of IGO names and acronyms at the top and second levels.

November 2016 (Hyderabad Communiqué):

The GAC takes note of the letter from the Secretary General of the United Nations to Ministers regarding policy development at ICANN related to the potential unauthorized use of IGO names and acronyms in the Internet Domain Name System. In this respect, the GAC reiterates its concern regarding the issue set forth by the UN Secretary General.

The GAC advises the ICANN Board:

I. To take action and engage with all parties in order to facilitate, through a transparent and good faith dialogue, the resolution of outstanding inconsistencies between GAC advice and GNSO recommendations with regard to the protection of IGO acronyms in the DNS and to report on progress at ICANN 58.

II. That a starting basis for resolution of differences between GAC Advice and existing GNSO Recommendations would be the small group compromise proposal set out in the October 4, 2016 letter from the ICANN Board Chair to the GNSO, namely that ICANN would establish all of the following, with respect to IGO acronyms at the second level:

- a procedure to notify IGOs of third-party registration of their acronyms;
- a dispute resolution mechanism modeled on but separate from the UDRP, which provides in particular for appeal to an arbitral tribunal instead of national courts, in conformity with relevant principles of international law; and

- an emergency relief (e.g., 24-48 hours) domain name suspension mechanism to combat risk of imminent harm.

III. That, to facilitate the implementation of the above advice, the GAC invites the GNSO Working Group on Curative Rights Protection Mechanisms to take the small group proposal into account.

IV. That, until such measures are implemented, IGO acronyms on the GAC-provided list remain reserved in two languages.

Rationale:

IGOs undertake global public service missions, and protecting their names and acronyms in the DNS is in the global public interest. IGOs are unique treaty-based institutions created by governments under international law. The small group compromise strikes a reasonable balance between rights and concerns of both IGOs and legitimate third parties. ICANN's Bylaws and Core Values indicate that the concerns and interests of entities most affected, here IGOs, should be taken into account in policy development processes.

March 2017 (Copenhagen Communique):

The GAC notes that a dialogue facilitated by the Board on this topic has begun between the GAC and the GNSO (including its relevant Working Groups). The GAC expects that these discussions would resolve the long-outstanding issue of IGO acronym protections and understands that temporary protections will continue to remain in place until such time as a permanent agreed solution is found. Based upon the facilitated discussions up to this stage,

The GAC advises the ICANN Board to:

- I. pursue implementation of (i) a permanent system of notification to IGOs regarding second-level registration of strings that match their acronyms in up to two languages and (ii) a parallel system of notification to registrants for a more limited time period, in line with both previous GAC advice and GNSO recommendations;
- II. facilitate continued discussions in order to develop a resolution that will reflect (i) the fact that IGOs are in an objectively unique category of rights holders and (ii) a better understanding of relevant GAC Advice, particularly as it relates to IGO immunities recognized under international law as noted by IGO Legal Counsels; and
- III. urge the Working Group for the ongoing PDP on IGO-INGO Access to Curative Rights Protection Mechanisms to take into account the GAC's comments on the Initial Report.

Rationale:

This Advice captures achievements made to date in the facilitated discussions, in the hope that this will be instrumental in resolving this long-standing issue at the earliest opportunity.

June 2017 (Johannesburg Communique):

The GAC reiterates its Advice that IGO access to curative dispute resolution mechanism should:

- be modeled on, but separate from, the existing Uniform Dispute Resolution Policy (UDRP)
- provide standing based on IGOs' status as public intergovernmental institutions, and
- respect IGOs' jurisdictional status by facilitating appeals exclusively through arbitration.

The GAC expresses concern that a GNSO working group has indicated that it may deliver recommendations which substantially differ from GAC Advice, and calls on the ICANN Board to ensure that such recommendations adequately reflect input and expertise provided by IGOs.

Rationale:

This Advice aligns with the view of governments that IGOs perform important public functions for citizens worldwide, and that protecting their identities in the DNS serves to minimize the potential for consumer harm.

November 2017 (Abu Dhabi Communique):

The GAC recalls its longstanding advice on the topic of IGO protections and is closely monitoring the ongoing PDP on IGO-INGO Access to Curative Rights Protection Mechanisms. The GAC remains open to working with the GNSO to try to find a mutually-agreeable resolution to this issue. The GAC also recalls the values of openness, transparency and inclusion, and representativeness and process integrity, that are respectively enshrined in ICANN's Bylaws and GNSO Operating Procedures.

The GAC advises the ICANN Board to:

- a. review closely the decisions on this issue in order to ensure that they are compatible with these values and reflect the full factual record.

Rationale:

Although the ICANN Community is still awaiting the final report for the PDP on IGO-INGO Access to Curative Rights Protection Mechanisms, preliminary communications indicate that the Working Group's proposal will conflict with GAC advice on the issue and GAC input to the PDP as well as the comments of over 20 IGOs who submitted comments to the Working Group's draft report. The Board plays an important role in ensuring the proper application of the ICANN Bylaws and GNSO Operating Procedures,

and the GAC expects that a basic safeguard would be a close Board review of GNSO policy recommendations, especially where such recommendations directly contradict GAC advice.

March 2018 (San Juan Communique):

Noting ongoing developments in the PDP on IGO access to curative rights protection mechanisms, which the GAC is monitoring closely, the GAC affirms its advice from previous Communiqués concerning preventative protection of IGO identifiers, recalls the importance of maintaining temporary protections until a permanent resolution on IGO identifiers is reached in order prevent irreparable harm to IGOs and

a. advises the ICANN Board to [e]nsure that the list of IGOs eligible for preventative protection is as accurate and complete as possible.

Rationale:

Despite indications to the contrary, the GNSO has still not concluded its PDP on curative rights protection mechanisms. The GAC and IGOs remain fully engaged on this issue and emphasize that a removal of interim protections before a permanent decision on IGO acronym protection is taken could result in irreparable harm to IGOs. In the interim, ICANN has moved forward to implement GAC advice related to protection of IGO full names at the second level. These protections will be based on a list of IGOs that fulfil previously agreed-upon criteria. To ensure this advice is effectively implemented, following significant work undertaken by IGOs resulting in significant progress on compiling this list, a focused effort is needed to contact remaining IGOs, so their names are protected accurately in the chosen two languages. ICANN has been in contact with the OECD and WIPO on this initiative, which the GAC supports.

June 2018 (Panama Communique):

The GAC advises the ICANN Board to:

- i. Maintain current temporary protections of IGO acronyms until a permanent means of protecting these identifiers is put into place; [and]
- ii. Work with the GNSO and the GAC following the completion of the ongoing PDP on IGO-INGO access to curative rights protection mechanisms to ensure that GAC advice on protection of IGO acronyms, which includes the available “small group” proposal, is adequately taken into account also in any related Board decision ...

Rationale:

The GAC continues to await the long-delayed completion of the PDP on IGO-INGO access to curative rights protection mechanisms. As to (i), this PDP will have a direct impact on a permanent means of protecting IGO identifiers, which has been the subject of longstanding and consistent GAC advice. As to (ii), the GAC provided input to the PDP’s draft report in 2017, notably on the issue of IGO immunities, as did individual members and observers. The final report should reflect that substantial input; noting

that current indications are that the PDP recommendations will not adequately reflect the GAC's advice on this topic, the GAC remains open to discussions with the GNSO and the Board to ensure that this is the case. The GAC notes that the work on this PDP began by at least mid-2014 and has yet to satisfactorily reach a positive resolution. The GAC moreover notes that a 2007 GNSO Issue Report provided a blueprint for a means for handling domain name disputes concerning IGO identifiers which substantially matches the "small group" proposal. The temporary protections currently in place for IGO acronyms must remain in place until such time as the Board makes a decision regarding the most appropriate means to provide a permanent means for protecting these identifiers, given the irreparable harm that could result if these acronyms are released from the temporary reserve list before a permanent mechanism is established ...

13 Annex F – Final Memo from External Legal Expert

13.1 Full Text of Legal Memo on IGO Jurisdictional Immunity Prepared by Professor Edward Swaine **

*** Note that the original ordering of footnotes has been retained, but the page numbers are relative to their position in this Final Report. For the original page numbering, please review the final memo here:*

<https://community.icann.org/download/attachments/56131791/Swaine%20-%20Updated%20IGO%20Immunity%20Memo%20-%202017%20June%202016.pdf?version=1&modificationDate=1467111617000&api=v2>.

Memorandum

Date: 6/17/2016
To: Mary Wong, Senior Policy Director
Steve Chan, Senior Policy Manager
From: Edward Swaine
RE: IGO Immunity

1. Introduction and Summary

I was asked the following questions:

1. In relation to the requirement to select a “Mutual Jurisdiction” in the UDRP or URS context, is a complaining IGO entitled to immunity in connection with judicial action brought by a domain name registrant arising from an asserted conflict between the IGO’s and the domain name registrant’s rights – even when the IGO has initiated the dispute under a dispute resolution process that is in addition to, and not a replacement for, the registrant’s legal rights under its applicable national law?

2. Are there procedural or other mechanisms which an IGO may use to escape or avoid becoming subject to judicial action brought by a domain name registrant arising from an asserted conflict between the IGO’s and the registrant’s rights?

3. To the best of your knowledge, how do IGOs generally handle standard commercial contractual clauses concerning submission to a particular jurisdiction or dispute resolution method?

4. Are there additional principles, nuances or other relevant information (including to your knowledge general principles of law which have been applied by States) that are relevant to our work to find a solution and conclusion on domain name disputes related to IGOs?

In addressing these questions, this memo makes some simplifying assumptions. First, while domain-related litigation involving an international or intergovernmental organization (“IGO”) might arise in different ways, this focuses on the most likely

scenario: that in which an IGO, possessing rights in a name, abbreviation, emblem or the like arising under the Paris Convention (“name,” for short), has complained and prevailed before an administrative panel in Uniform Domain Name Dispute Resolution Policy (“Policy” or “UDRP”)¹ proceedings against a domain-name registrant—resulting in an order of cancellation or transfer to which the losing registrant objects by commencing a judicial action. Whether that action succeeds will depend on the facts, and the law of the jurisdiction concerned, but this memo assumes that a court would properly exercise jurisdiction over the action but for the possibility that the IGO is entitled to immunity.

Even focusing on immunity, some generalization is required. Immunity obligations vary by state and by the IGO concerned: immunity decisions are often based on organization-specific treaties to which not all states are party, and even states subject to the same international obligations implement them in varying ways. While jurisdictions in which IGOs are active may offer guidance, other jurisdictions offer much less, and there is no certain overlap between states with a developed IGO immunity jurisprudence and those hosting registrars or domain-name registrants. This memo will focus on jurisdictions in which follow-on litigation seems likely, particularly the United States—which hosts registrars and affords a clear statutory basis for so-called reverse domain name hijacking suits. Each jurisdiction will, however, resolve immunity questions according to its own law. Immunity concerns each state’s exercise of its own jurisdiction, and as a jurisdictional question will presumptively be determined by the law of the forum, as informed by international law.

Putting these complications aside, the situation raises at least two distinct immunity issues. The first, more abstract question is whether—absent the Mutual Jurisdiction provision, which assents to court proceedings following certain UDRP proceedings—an IGO would in principle enjoy immunity from judicial process with respect to name-related rights it might assert in the UDRP proceedings. The answer depends on whether the jurisdiction in which the case arises would apply an absolute, functional, or restrictive immunity approach to the IGO in question. That may be hard to predict. In the United States, unless an IGO benefits from broader treaty protection—as the United Nations, but *not* its specialized agencies, does, because the United States is only party to a treaty governing the former’s immunity—the question is addressed by the

¹ See <https://www.icann.org/resources/pages/policy-2012-02-25-en/>. The Policy, and this memo, focus on the circumstances of the generic Top Level Domains (gTLDs), as to which the UDRP applies. And for simplicity’s sake, this memo will focus on the UDRP rather than the newer Uniform Rapid Suspension System (URS). Although the URS establishes a different administrative procedure, applicable to a different range of TLDs, it does not appear to pose distinct immunity issues—insofar as a party to URS proceedings may either follow with UDRP proceedings (with the possibility of later recourse to a Mutual Jurisdiction) or initiate judicial proceedings directly based on a similar jurisdictional commitment. See URS, §13, <http://newgtlds.icann.org/en/applicants/urs/procedure-01mar13-en.pdf>; URS Rules, Uniform Rapid Suspension System (URS) Rules, Rule 1 (defining “Mutual Jurisdiction”), Rule 3(b)(ix) (providing for complainant’s submission that it “will submit, with respect to any challenges to a determination in the URS proceeding, to the jurisdiction of the courts in at least one specified Mutual Jurisdiction”), <http://newgtlds.icann.org/en/applicants/urs/rules-28jun13-en.pdf>.

International Organizations Immunities Act (the “IOIA”), but some cases interpret the statute as establishing absolute immunity and others view it as establishing restrictive immunity only. Other states tend to favor either an absolute or a functional approach. Which approach is taken may be material. If an IGO is entitled to absolute immunity, it would in principle be protected from a suit of the kind in question, and probably under a functional approach as well—because an IGO’s protection of its name is likely to be deemed part of its functions. Immunity is less likely under a restrictive approach, which might regard this as more akin to trademark-related activity that is commercial in character.

The second, more relevant, question is whether—in light of an IGO’s assent to Mutual Jurisdiction—its immunity remains. Here, the more likely answer is that it would not. IGOs are capable of waiving their immunity from suit, and if they do so, they may no longer interpose immunity as a defense if another party commences a judicial action falling within the scope of that waiver. The grant of Mutual Jurisdiction would likely establish such a waiver, as it would for a state entity otherwise entitled to foreign sovereign immunity. This waiver would be construed narrowly, but it would likely permit proceeding against an IGO in at least some domestic courts.

The overall answer, then, is contingent. If there were no Mutual Jurisdiction clause, an IGO might be entitled to immunity from judicial process; in the status quo, however, it likely would not. Equitable considerations might influence any judicial analysis. If the Mutual Jurisdiction obligation were altered to preserve IGO immunity, without any possibility of judicial recourse, it might be considered an insufficient remedy for domain registrants. And because the IGO would have availed itself of a procedure to which it would not otherwise be entitled, by initiating UDRP proceedings, it might seem unfair for it to invoke a defense unavailable to the other party. An IGO, on the other hand, might regard the present Mutual Jurisdiction clause as requiring it to make a greater compromise than the average complainant: not merely acquiescing in the choice of a particular jurisdiction, but also consenting to the very possibility of a judicial proceeding—more than anything required of parties that lack immunity in the first place.

Several alternatives may be considered. IGOs may be able to use an assignment of rights, or similar mechanism, to allow their interests to be expressed in UDRP proceedings while disassociating the IGO itself from any waiver. IGOs might also volunteer a non-judicial substitute, such as arbitration—for example, according to the United Nations Commission on International Trade Law (“UNCITRAL”)—in lieu of follow-on judicial proceedings. While this is often employed in staff-related matters or commercial dealings, it translates imperfectly to the UDRP context. Unlike a potential employee or contract partner, who may decline to accept such an arrangement and take its business elsewhere, an arbitration alternative to Mutual Jurisdiction would likely force a domain-name registrant to accept that possibility (for any potential IGO matters) in order to register—essentially, shifting any immunity concession by IGOs into an arbitration concession by domain registrants, and raising judicial concerns about access to court. Other avenues may be available, but should be considered with sensitivity both to immunity-related concerns and to the legitimate interests of domain-name registrants.

2. Background

The UDRP provides that registrants must submit to a mandatory administrative proceeding, before a stipulated dispute resolution service provider,² upon submission of a complaint that the domain name is identical or confusingly similar to a mark in which the complainant has rights, the registrant has no rights or legitimate interests in respect of the domain name, and the domain name has been registered and is being used in bad faith. UDRP, para. 4(a).

IGOs are among the possible parties to such proceedings. An IGO may register a domain name and, in theory, find itself a respondent to an administrative complaint brought by a mark's owner. In practice, however, IGOs are more likely to be complainants, alleging that another party has registered a domain name in bad faith. Article 6*ter* of the Paris Convention, as augmented by the Trademark Law Treaty of 1994 and the Singapore Treaty on the Law of Trademarks, extends to certain IGOs protections for, inter alia, their names and abbreviations, giving rise in appropriate circumstances to a protectable interest they may seek to vindicate.³ Although Paragraph 4 of the Policy indicates that a UDRP complaint is to be framed in terms of "trademark or service mark," rather than names and other interests indicated in Article 6*ter*, such interests appear to suffice for purposes of initiating a complaint against a domain-name registrant.⁴ Indeed, several IGOs—including the International Mobile Satellite Organization (INMARSAT), the International Bank for Reconstruction and Development (IBRD), and the Bank for International Settlement (BFIS)—have prevailed in UDRP complaints.⁵

² See <https://www.icann.org/resources/pages/providers-6d-2012-02-25-en>.

³ Paris Convention for the Protection of Industrial Property, Mar. 20, 1883, art. 6*ter*, 21 U.S.T. 1583, 828 U.N.T.S. 305; Trademark Law Treaty, Oct. 27, 1994, S. Treaty Doc. 105-35, 2037 U.N.T.S. 35; Singapore Treaty on the Law of Trademarks, Mar. 27, 2006, S. Treaty Doc. No. 110-2. For discussion of the relevant preconditions, including notification of the relevant emblems and signs for which protection may be sought, see WIPO Secretariat, Article 6*ter* of the Paris Convention: Legal and Administrative Aspects (SCT/15/3) (2005), http://www.wipo.int/edocs/mdocs/sct/en/sct_15/sct_15_3.pdf. See also Agreement Between the World Intellectual Property Organization and the World Trade Organization (WTO-WIPO Cooperation Agreement), Dec. 22, 1995, at http://www.wto.org/english/tratop_e/trips_e/wtowip_e.htm.

⁴ See generally Gerald M. Levine, Domain Name Arbitration: A Practical Guide to Asserting and Defending Claims of Cybersquatting Under the Uniform Domain Name Dispute Resolution Policy 99-100 (2015) (noting "potentiality" approach to a complainant's interests).

⁵ Respectively, in *International Mobile Satellite Organisation and Inmarsat Ventures Limited (formerly known as Inmarsat Holdings Limited) v. Domains, EntreDomains Inc. and Brian Evans*, D2000-1339 (WIPO Nov. 30, 2000); *International Bank For Reconstruction and Development d/b/a The World Bank v. Yoo Jin Sohn*, D2002-0222 (WIPO May 7, 2002); and *Bank for International Settlements v. BFIS*, D2003-0984 (WIPO March 1, 2004), *Bank for International Settlements v. BIS*, D2003-0986 (WIPO March 2, 2004), *Bank for International Settlements v. James Elliott*, D2003-0987 (WIPO March 3, 2004), *Bank for International Settlements v. G.I Joe*, D2004-0570 (WIPO (Sept. 27, 2004), *Bank for International Settlements v. BIS*, D2004-0571 (WIPO Oct. 1, 2004), and *Bank for International Settlements v. Fortune Nwaiwu*, D2004-0575 (WIPO Oct. 1, 2004). A few other matters are catalogued in the Index of WIPO

Although the Policy describes this procedure as “mandatory” (para. 4), it is less coercive than that would suggest, and the fact that IGOs incorporated within the UDRP is not itself particularly problematic. An IGO solely interested in preventing a domain-name registrant from using its name or something confusingly similar may commence a judicial action in a relevant jurisdiction—just as it might in the absence of the UDRP.⁶ In the United States, for example, an IGO could file an action under the Lanham Act, as modified by the Anticybersquatting Consumer Protection Act (ACPA), although that route may present hurdles for foreign parties like IGOs.⁷

For IGOs bound to use the UDRP process because they are domain-name registrants, that constraint is not especially onerous, nor does it severely limit even those IGOs who elect to employ it by filing UDRP complaints. Paragraph 4(k) provides that “The mandatory administrative proceeding requirements set forth in Paragraph 4 shall not prevent either [the registrant] or the complainant from submitting the dispute to a court of competent jurisdiction for independent resolution before such mandatory administrative proceeding is commenced or after such proceeding is concluded.”⁸ The obligation to submit to UDRP proceedings, or even the choice thereof, does not interfere unduly with the preexisting option to submit the matter to judicial proceedings.⁹

In these respects, the UDRP simply offers an alternative arbitral process to IGOs. What may be less welcome to IGOs, however, is the fact that the UDRP also *compels* consent to judicial proceedings if the losing party elects to pursue them—in the principal scenario, meaning that a complained-against domain-name registrant can take the IGO to

UDRP Panel Decisions, <http://www.wipo.int/amc/en/domains/search/legalindex/>, as involving IGOs. In one, involving the European Monitoring Centre for Drugs and Drug Addiction (EMCDDA), a decentralized agency of the European Union, the complaint was denied due to its failure to establish rights to marks or services. *European Monitoring Centre for Drugs and Drug Addiction (EMCDDA) v. Virtual Clicks / Registrant ID:CR36884430, Registration Private Domains by Proxy, Inc.*, D2010-0475 (WIPO July 7, 2010). In another, involving UNITAID, an IGO hosted by the World Health Organization (WHO), trademark rights were assigned by a fiduciary agreement to a private enterprise, which registered them on behalf of the WHO and UNITAID. *Lenz & Staehelin Ltd v. Christopher Mikkelsen*, D2012-1922 (WIPO Jan. 8, 2013).

⁶ See *Parisi v. Netlearning, Inc.*, 139 F. Supp. 2d 745, 751 (E.D. Va. 2001) (“UDRP complainants, as strangers to the registration agreement, are under no obligation to avail themselves of the UDRP”) (citing *BroadBridge Media, L.L.C. v. Hypercd.com*, 106 F. Supp. 2d 505, 509 (S.D.N.Y. 2000)); see also *Oneida Tribe of Indians of Wisconsin v. Harms*, 2005 WL 2758038 (E.D. Wis. 2005); *GlobalSantaFe Corp. v. Globalsantafe.com*, 250 F. Supp. 2d 610 (E.D. Va. 2003).

⁷ See 5 U.S.C. §§ 1114, 1125. In addition to conventional hurdles, like proper venue and personal jurisdiction, an IGO with an interest in a foreign mark may not have a protectable interest under U.S. law. See *infra* note 15.

⁸ For ease of discussion, the remaining discussion will generally assume that any litigation follows resolution of the administrative proceeding.

⁹ This may also mean that if an IGO is unsatisfied with its initial choice of a judicial proceeding, it can initiate UDRP proceedings thereafter. In *Gerolsteiner Brunnen GmbH & Co., KG v. R4L Privacy Advocate/Gero Leon Steiner*, D2008-1450 (WIPO Nov. 7, 2008), a complainant initiated proceedings in order to object to the transfer of a domain name to a new registrant after it had received an order from a German court prohibiting the original registrant from using the domain name or allowing it to be used.

court. According to the Rules for the Uniform Domain Name Dispute Resolution Policy (“Rules”),¹⁰ a complaint must indicate that “Complainant will submit, with respect to any challenges to a decision in the administrative proceeding canceling or transferring the domain name, to the jurisdiction of the courts in at least one specified Mutual Jurisdiction.” Rules, ¶ 3(b)(xii). Such “Mutual Jurisdiction” is defined as either the principal office of the Registrar or the domain-name holder’s stipulated address.¹¹ Accordingly, an IGO complainant will have consented to judicial proceedings if a losing respondent wishes to challenge a cancellation or transfer¹²—in a jurisdiction that the IGO will have selected, but from limited choices that the registrant can craft through its choice of registrar and its registering address.

How matters unfold from that point will depend on national law. Most follow-on actions have been filed in the United States, and the ACPA provides registrants with a cause of action enabling them, in appropriate circumstances, to restore domain names lost during the UDRP process.¹³ Such follow-on litigation is expensive and may be infrequently pursued, but even so it may cause concern. The UDRP result receives no deference.¹⁴ In addition, IGOs holding foreign marks, and certainly those seeking protection for names *not* protectable as marks at all, may be out of luck: some U.S. decisions have permitted the enforcement only of trademark rights protectable under U.S.

¹⁰ See <https://www.icann.org/resources/pages/udrp-rules-2015-03-11-en>.

¹¹ More specifically, “a court jurisdiction at the location of either (a) the principal office of the Registrar (provided the domain-name holder has submitted in its Registration Agreement to that jurisdiction for court adjudication of disputes concerning or arising from the use of the domain name) or (b) the domain-name holder’s address as shown for the registration of the domain name in Registrar’s Whois database at the time the complaint is submitted to the Provider.” Rules, ¶ 1.

¹² If the registrant actually prevailed in the UDRP proceeding, the IGO has two options. First, it can acquiesce in the adverse result, rather than initiate any judicial proceedings to reconsider it. Its immunity, in that scenario, is not directly at issue—only its refusal to *compromise* that immunity. Second, and alternatively, the IGO could commence judicial proceedings, per the Mutual Jurisdiction scheme. That option exists, however, much as it would absent the UDRP (at least so long as the UDRP receives no judicial deference in the relevant jurisdiction), and amounts to a decision to waive immunity.

¹³ 15 U.S.C. § 1114(2)(D)(v) (“A domain name registrant whose domain name has been suspended, disabled, or transferred under a policy described under clause (ii)(II) may, upon notice to the mark owner, file a civil action to establish that the registration or use of the domain name by such registrant is not unlawful under this chapter. The court may grant injunctive relief to the domain name registrant, including the reactivation of the domain name or transfer of the domain name to the domain name registrant.”).

¹⁴ See *Storey v. Cello Holdings, L.L.C.*, 347 F.3d 370, 382–83 (2d Cir. 2003); *Hawes v. Network Solutions, Inc.*, 337 F.3d 377, 386–87 (4th Cir. 2003); *Barcelona.com, Inc. v. Excelentísimo Ayuntamiento de Barcelona*, 330 F.3d 617, 626 (4th Cir. 2003); *Dluhos v. Strasberg*, 321 F.3d 365, 373–74 (3d Cir. 2003); *Sallen v. Corinthians Licenciamentos LTDA*, 273 F.3d 14, 28 (1st Cir. 2001).

law, notwithstanding any obligations that would appear to arise under Article 6^{ter} of the Paris Convention.¹⁵ Results may vary, of course, by jurisdiction.

In short, the Mutual Jurisdiction clause means that participating IGOs will have agreed to the possibility of a judicial process, notwithstanding any immunity to which they otherwise would be entitled. This will loom largest in cases in which the IGO is the complainant and benefited from an initial panel decision in its favor, such that the decision to resort to judicial proceedings against the IGO—and the risks that creates for adverse results—is made by the private party.

The remainder of the memo will focus on that scenario. There are other circumstances, however, in which the IGO or its domain-related interests might conceivably be drawn into litigation.¹⁶ Some involve closely-related issues of IGO

¹⁵ *Barcelona.com, Inc. v. Excelentísimo Ayuntamiento de Barcelona*, 330 F.3d 617, 627-29 (4th Cir. 2003) (reversing decision in favor of Spanish-law mark, because “United States courts do not entertain actions seeking to enforce trademark rights that exist only under foreign law,” and holding that the “City Council could not obtain a trademark interest in a purely descriptive geographical designation that refers only to the City of Barcelona” under U.S. law); see also *International Finance Corporation v. Bravo Company*, 64 U.S.P.Q.2d 1597 (Trademark Tr. & App. Bd. 2002) (rejecting opposition to trademark registration on the basis of Article 6^{ter}). Domain-name registrants have been permitted at least provisionally to proceed against those holding an interest in a name not registered as U.S. marks, likely on the premise that the name was protectable. *Sallen v. Corinthians Licenciamentos LTDA*, 273 F.3d 14, 23-24 (1st Cir. 2001). Still, if the view expressed in *Barcelona.com* prevails, one commentator observed, “foreign mark owners will always lose UDRP review cases filed by domain name registrants” under the ACPA; “unless foreign mark owners can also demonstrate trademark rights under U.S. law, nothing will prevent registrants from proving that their use of the domain name embodying a foreign mark was lawful under the Lanham Act . . . even if their conduct . . . would qualify as cybersquatting under the UDRP or the ACPA (had it been challenged by a mark owner with U.S. rights).” Laurence R. Helfer, *Whither the UDRP: Autonomous, Americanized, or Cosmopolitan?*, 12 *Cardozo J. Int’l & Comp. L.* 498-99 (2004).

Whatever these consequences, U.S. courts have consistently held that the Lanham Act, including its generally-applicable restrictions, are sufficient to discharge U.S. obligations under the Paris Convention—without giving additional weight to statutory provisions advertent to rights established by treaty. *Grupo Gigante SA de CV v. Dallo & Co.*, 391 F.3d 1088, 1099-1100 (9th Cir. 2004); *Barcelona.com, Inc.*, 330 F.3d at 628-29; *International Cafe, S.A.L. v. Hard Rock Cafe Int’l (U.S.A.), Inc.* 252 F.3d 1274, 1277-78 (11th Cir. 2001); see 5 U.S.C. § 1126(b). And the United States considers that it has discharged its Paris Convention obligations by enabling parties to initiate suit on their own behalf, declining to accept that it may be incumbent upon states to pursue in their courts relief against infringement on behalf of an IGO or other party concerned. U.S. Mission to the United Nations, *Note on the Enforcement of Obligations under the Paris Convention for the Protection of Industrial Property* (June 2002), 2002 Digest U.S. Prac. Int’l L. 389-91, <http://www.state.gov/s/l/38648.htm>.

¹⁶ For example, in the event an IGO prevailed in the UDRP process, it might conceivably have to initiate a judicial action to compel cooperation by a registrar reluctant to effectuate a cancellation or transfer. Such an action might waive any immunity to which the IGO would otherwise be entitled. Alternatively, an original registrant may seek declaratory relief against a registrar with the aim of preventing the registrar’s cooperation with UDRP-based relief; jurisdiction in such a case would likely be prescribed by the registration agreement, and need not directly involve the IGO. Finally, although this discussion

immunity. Parties registering domain names also consent, in similar terms, to Mutual Jurisdiction.¹⁷ This may be relevant in two different scenarios. Most obviously, if an IGO registers a domain name in its own right, another party may initiate a UDRP complaint concerning that registration, which may ultimately implicate the IGO registrant's assent to Mutual Jurisdiction.¹⁸ It may also be relevant, however, if an IGO—this time as a complainant, and one that prevails in that complaint against a domain-name registrant—receives an award transferring the domain-name registration to it, since that would likely entail the IGO's consent to Mutual Jurisdiction and to further judicial proceedings.¹⁹ Accordingly, any reconsideration of the grant of Mutual Jurisdiction should probably be harmonized with the terms required for IGO registration, which will in turn require coordination with registrars and their current terms.

3. Discussion

The core question is whether an IGO is “entitled to immunity,” but the baseline assumptions may be disaggregated. The scope of IGO immunity would most clearly be at issue if the Mutual Jurisdiction provision were irrelevant and the IGO had not itself

assumes that a judicial proceeding would proceed *in personam*, the ACPA also allows *in rem* proceedings by a mark's owner against a domain name if the court finds that the owner either is not able to obtain *in personam* jurisdiction over an allowed defendant or was not able to find a person who would have been an allowed defendant. 15 U.S.C. § 1125(d)(2). To the extent the IGO has a property interest in a transferred domain name, it is likely that similar immunity interests would arise. International Organizations Immunities Act of 1945, 22 U.S.C. § 288a(b) (establishing that “International organizations, their property and their assets, wherever located, and by whomsoever held, shall enjoy the same immunity from suit and every form of judicial process as is enjoyed by foreign governments”); see *Odyssey Marine Exploration, Inc. v. Unidentified Shipwrecked Vessel*, 657 F.3d 1159 (11th Cir. 2011) (foreign sovereign immunity). If the IGO's property interest has not yet been perfected, an *in rem* action may instead bear more directly on the registrar.

¹⁷ The “Mutual Jurisdiction” definition in paragraph 1 of the Rules indicates that a domain-name holder may have “submitted in its Registration Agreement to that jurisdiction for court adjudication of disputes concerning or arising from the use of the domain name,” and the Registrar Accreditation Agreement provides that “[f]or the adjudication of disputes concerning or arising from use of the Registered Name, the Registered Name Holder shall submit, without prejudice to other potentially applicable jurisdictions, to the jurisdiction of the courts (1) of the Registered Name Holder's domicile and (2) where Registrar is located.” See 2013 Registrar Accreditation Agreement, para. 3.7.7.10, <https://www.icann.org/resources/pages/approved-with-specs-2013-09-17-en#raa>; Levine, *supra* note 4, at 53 (2015).

¹⁸ Consent to Mutual Jurisdiction would obviously be relevant in the event an IGO registrant prevailed in the UDRP proceeding and a complainant sought judicial review. If a complainant were successful, the options for the losing IGO registrant would be much the same as when an IGO complaint (against a domain-name registrant) is at first unsuccessful. See *supra* note 12.

¹⁹ The precise basis for the IGO's consent may depend on the facts. The transfer of a registration to a prevailing IGO arguably establishes by itself the IGO's constructive consent to the prior registrant's terms, including Mutual Jurisdiction. A clearer basis might be afforded if subsequent re-registration by the IGO were required by ICANN or by the policy of an individual registrar, and certainly if the IGO elected itself to renew its registration or to change registrars afterward.

initiated judicial proceedings, since that would risk waiving any immunity to which it may be entitled, including to counterclaims.²⁰ This might be the case, for example, if a domain-name registrant sought a declaratory judgment against an IGO in relation to some actual or potential infringement.²¹ That scenario, though not otherwise of concern here, does usefully isolate the question as to whether an IGO has a legitimate expectation that it would be entitled to immunity *absent* the UDRP. If such immunity is minimal or uncertain, then any compromises required by the UDRP loom less large; if the IGO would otherwise be entitled to immunity, however, its potential sacrifice seems more substantial.

As explained in Part A, the answer depends. IGOs generally enjoy immunity under international law, but different jurisdictions apply the law differently, and even within the same jurisdiction different IGOs may be treated differently. Part B then introduces the complication that any such immunity may be waived through the Mutual Jurisdiction provision, and affording such waiver is not the same thing as violating an IGO's immunity. Part C then discusses alternative ways to resolve the situation.

A. Scope of IGO Immunity

1. Varied Bases for immunity

Immunity under international law is surprisingly contextual. To begin with, foreign states, IGOs, and officials enjoy varying types of immunity. (Even IGO immunity takes different forms; this memo will refer to IGO immunity as a shorthand for the basic immunity from judicial process, though the immunity of an IGO from enforcement or execution, or the immunity of IGO officials, may also be implicated.²²) The differences are meaningful. IGO immunity is often likened to the foreign “sovereign”

²⁰ For example, Libya was held to have waived any sovereign immunity to which it might be entitled under the FSIA in relation to particular types of counterclaims (those seeking monetary damages for tortious interference with contract and prospective business advantage) that arose out of the use of domain names that were the subject of an action, initiated by Libya itself, alleging violation of its rights under the Lanham Act and the Anticybersquatting Consumer Protection Act (ACPA). *Great Socialist People's Libyan Arab Jamahiriya v. Miski*, 683 F. Supp. 2d 1 (D.D.C. 2010).

²¹ A few cases have explored analogous circumstances involving foreign states. In one, a domain name registrant sought declaratory and injunctive relief in a U.S. court against the Republic of South Africa and its agency or instrumentality, which had announced its intention eventually to assert its rights under some (uncertain) process to secure second-level domains including the country's name. The district court dismissed the action on the basis of South Africa's sovereign immunity, reasoning that its press release was not “commercial activity” warranting an exception to sovereign immunity under the Foreign Sovereign Immunities Act (FSIA) nor anything with sufficient connection to the United States. *Virtual Countries, Inc. v. Republic of South Africa*, 148 F. Supp. 2d 256 (S.D.N.Y. 2001), *aff'd*, 300 F.3d 230 (2nd Cir. 2002) (assuming *arguendo* that the press release was “commercial activity” and affirming on the ground that the commercial activity, if any, lacked the requisite “direct effect” within the United States under the FSIA).

²² As noted earlier, it is possible that *in rem*, property-oriented immunity might be involved. See *supra* note 16. IGO officials might in principle be subject to attempts to litigate rights in protectable marks—for example, through attempts to enjoin their exercise of mark-related functions.

immunity of states, but they are distinct in their purposes and potential scope. IGOs are considered more vulnerable than states, since they have no territory or population, and must conduct their affairs in jurisdictions and through persons not their own. On the other hand, IGOs tend to be purpose-built, unlike states, and may more easily be restricted to fulfilling specific functions; these vary by organization, of course, and so may their immunity.²³

Beyond that, the legal vehicle for immunity creates further variety. For IGOs, two multilateral treaties are of particular note. The most universally ratified—with 161 parties as of this date—is the Convention on the Privileges and Immunities of the United Nations (the “General Convention”), which governs the immunity of the United Nations and its integral parts.²⁴ More IGOs are addressed by the Convention on the Privileges and Immunities of the Specialized Agencies (“Special Convention”), which governs the immunity of autonomous organizations that carry out various functions on behalf of the United Nations.²⁵ The Special Convention has been ratified by 127 parties—some states that loom large in IGO dealings (like Belgium and Switzerland, as of 2012) are parties, while others (notably, the United States) are not.²⁶ Like the General Convention, the Special Convention confers broad immunity on IGOs subject to it, but its scope is

²³ See, e.g., Hazel Fox & Philippa Webb, *The Law of State Immunity* 571 (3rd ed. 2015).

²⁴ Feb. 13, 1946, 21 U.S.T. 1418, T.I.A.S. 6900. The United States, among others, considers subsidiary organs of the United Nations—such as certain peacekeeping missions, and the United Nations Development Program—to enjoy the same scope of immunity as that conferred by the General Convention on the UN itself. See, e.g., *Lempert v. Rice*, 956 F. Supp. 2d 17, 23-24 (D.D.C. 2013) (applying absolute immunity under the General Convention to the United Nations Development Program as a subsidiary organ); *Sadikoglu v. United Nations Development Programme*, 2011 WL 4953994, *3-*4 (S.D.N.Y. 2011) (same). In some instances, the immunity afforded by the General Convention may be supplemented by agreements that incorporate General Convention standards. See *Georges v. United Nations*, 84 F. Supp. 3d 246, 248-49249 (S.D.N.Y. 2015) (concluding that both the United Nations and the United Nations Stabilization Mission in Haiti (MINUSTAH) were entitled to absolute immunity, the latter “as a subsidiary body of the UN,” though it was also subject to a Status of Forces Agreement extending the privileges and immunities of the General Convention), appeal pending, No. 15-455; accord Brief for the United States as Amicus Curiae in Support of Affirmance at 8, *Georges v. United Nations*, No. 15-455 (2nd Cir. 2016) (describing both United Nations and MINUSTAH as subject to the General Convention).

²⁵ Nov. 21, 1947, 33 U.N.T.S. 261. The originally designated agencies are the International Labour Organization (ILO), Food and Agriculture Organization (FAO), the United Nations Educational, Scientific and Cultural Organization (UNESCO), the International Civil Aviation Organization (ICAO), the International Monetary Fund (IMF), the International Bank for Reconstruction and Development (IBRD), the World Health Organization (WHO), the Universal Postal Union (UPU), and the International Telecommunication Union (ITU). Among those subsequently created and governed are the World Meteorological Organization (WMO), the International Maritime Organization (IMO), the International Finance Corporation (IFC), the International Development Association (IDA), the World Intellectual Property Organization (WIPO), the International Fund for Agricultural Development (IFAD), and the United Nations Industrial Development Organization (UNIDO).

²⁶ As made clearer below, these and other non-parties observe immunity for the agencies on other bases.

contingent: states parties have varied obligations,²⁷ and they may modify those obligations further with IGOs they host.²⁸

The Special Convention is not unique in accommodating bilateral arrangements. A number of IGOs subject to Article 6*ter* of the Paris Convention have their immunities governed at least in part by other treaties, like headquarters agreements, that defy easy generalization. The variety this introduces is all the more consequential in light of the fact that some states, like Italy, have intimated that IGO immunity can only be resolved on the basis of treaties.²⁹

The differences due to international treaties are accentuated by national law, which is important in determining the immunity of international organizations. Of course, national law is usually aligned with international law. In the United Kingdom, for example, international obligations must be implemented in domestic law by statute—in the case of IGO immunity, by the International Organizations Act 1968 (as amended), which is applied to particular organizations by orders in Council.³⁰ The United States, in contrast, accords self-executing effect to some treaties (like the General Convention),³¹

²⁷ States may file reservations when acceding, and in some cases these bear on privileges and immunities; the Special Convention also addresses particular agencies in annexes that are occasionally amended (Special Convention §§ 2, 36, 38), and states vary as to whether they accept the annexes as revised or only as originally tendered. For example, Norway and the United Kingdom have accepted revisions to the WHO's annex, but Algeria and Brazil have not. See Gian Luca Burci & Egle Granziera, Privileges and Immunities of the World Health Organization: Practice and Challenges, in *Immunity of International Organizations* 93 (Niels Blokker & Nico Schrijver eds., 2015).

²⁸ See Special Convention, § 39. See, e.g., *Diallo v. Strauss-Kahn*, 2012 WL 1533179 (N.Y. Sup. 2012) (noting adaptation to IMF via its Articles of Agreement).

²⁹ See Beatrice Bonafè, Italian Courts and the Immunity of International Organizations, 10 *Int'l Org. L. Rev.* 505, 512 (2013); see also Eric De Brabandere, Belgian Courts and the Immunity of International Organizations, 10 *Int'l Org. L. Rev.* 464, 471-74 (2013) (noting similar tendency, subject to some ambiguity, in Belgium).

³⁰ A few organizations are addressed by separate legislation, as are those whose privileges and immunities arise under EU law. See generally Chanaka Wickremasinghe, The Immunity of International Organizations in the United Kingdom, 10 *Int'l Org. L. Rev.* 434, 437 & n.6 (2014); Dan Sarooshi & Antonios Tzanakopolous, United Kingdom, in *The Privileges and Immunities of International Organizations in Domestic Courts* 290 (August Reinisch ed., 2013). Litigating IGO immunities in U.K. courts poses certain idiosyncratic justiciability and legal personality issues that will not be explored here.

³¹ See, e.g., *Brzak v. United Nations*, 597 F.3d 107, 111-12 (2d Cir. 2010). The UN was also designated by the President as receiving immunities under the International Organizations Immunity Act of 1945 (IOIA), discussed below. See Exec. Ord. No. 9698, 11 Fed. Reg. 1809 (Feb. 19, 1946). This is potentially confusing because (as also discussed below) the scope of immunity under the IOIA may be less than that afforded under the General Convention. Some courts have sidestepped that question by noting that the General Convention might simply add to statutory protection (see, e.g., *Brzak*, 597 F.3d at 112), while others simply assume the same standard. *Van Aggelen v. United Nations*, 311 Fed. Appx. 407, 409 (2nd Cir. 2009) (“The United Nations enjoys absolute immunity under the U.N. Charter, the Convention on the Privileges and Immunities of the United Nations . . . and the [IOIA].”). The better view seems to be that the General Convention, together with the Headquarters Agreement, were concluded subsequent to the IOIA and might be required to address the greater needs of the United Nations. See

and implements other immunities—whether derived from non-self-executing treaties, treaties to which it is not a party (like the Special Convention), or customary international law—by means of the International Organizations Immunity Act (IOIA).³² The IOIA provides privileges and immunities to international organizations that have been designated by the President through an executive order, which may also modify the privileges and immunities as the President considers appropriate.³³ Among the IGOs thus designated are some, like WIPO, which are subject in other jurisdictions to the Special Convention. Other national laws, like Austria’s, are possibly even more complicated.³⁴

The diversity among treaties and national laws is in principle constrained by customary international law, which consists of the practice of states acting out of a sense of legal obligation. Cases and commentary occasionally advert to customary international law of IGO immunity, particularly in situations not addressed by a treaty. But how readily and enthusiastically customary international law is applied depends to a great degree on the state concerned. In some jurisdictions, like the United States, it is treated as a last resort: that is, an IGO to which the United States owes no treaty obligations, and which has not been designated under the IOIA, might in theory have its immunities considered on the basis of customary international law, but that would pose difficult questions of enforceability.

Ultimately, it is unclear when customary international law doctrines of immunity will be asserted and prevail. Sometimes courts or commentators assert a customary norm without much (or any) evidence, and at least some of the underlying practice cited in support is better attributed to treaties or domestic law. Significantly, a recent expert survey concluded that “it cannot be said that ‘there is ‘a general practice accepted as law’ establishing a customary rule of immunity” and that “it would be difficult to conclude that any such rule exists.”³⁵ Even those cases recognizing a customary international law basis for immunity appear to differ on its extent.³⁶ Regardless, as a practical matter, a

United States Statement of Interest, *Begum v. Saleh*, 99 Civ. 11834 (S.D.N.Y. 2000), reprinted in 2000 Digest of United States Practice in International Law 602, 608 n.7.

³² International Organizations Immunities Act of 1945, 22 U.S.C. § 288a(b).

³³ The IOIA formally distinguishes between IGOs in which the United States participates (either by virtue of a treaty, or under the authority of Congress authorizing participation or making appropriations for such), see 22 U.S.C. § 288, and IGOs and similar entities that according to statute are to be treated similarly for purposes of their privileges and immunities, see *id.* § 288 f-1 et seq. At present, approximately 80 IGOs have been designated. See 28 U.S.C.A. § 288 note (detailing organizations and executive orders).

³⁴ Kirsten Schmalenbach, *Austrian Courts and the Immunity of International Organizations*, 10 *Int’l Org. L. Rev.* 446, 448-54 (2013).

³⁵ Michael Wood, *Do International Organizations Enjoy Immunity Under Customary International Law?*, 10 *Int’l Org. L. Rev.* 287, 317 (2014).

³⁶ Compare, e.g., *ZM v. Permanent Delegation of the League of Arab States to the UN*, 116 ILR 643, 647 ¶¶ 22-23 (Labour Court (TPH) of Geneva, Nov. 17, 1993) (holding that “[c]ustomary international law recognizes that international organisations, whether universal or regional, enjoy absolute immunity,” but noting that “[t]his privilege . . . arises from the purposes and functions assigned to them”), with *Spaans v. Iran-US Claims Tribunal*, 94 ILR 321, 327 ¶ 3(3)(4) (Hoge Raad der Nederlanden (Supreme

dispute about IGO immunity may arise in a court inclined to resolve it based on customary international law as that court perceives it.

Court), Dec. 20, 1985) (reporting “that, according to unwritten international law, as it stands at present, an international organization is in principle not subject to the jurisdiction of the courts of the host State in respect of all disputes which are immediately connected with the performance of the tasks entrusted to the organization in question”).

2. Varied approaches to immunity

a. Absolute immunity

Some organizations, in some jurisdictions, are afforded comprehensive immunity from judicial process, irrespective of the nature of the IGO's activity, in the absence of an express (and strictly construed) waiver. The United Nations is the most certain example. Article 105(1) of the Charter provides that "[t]he Organization shall enjoy in the territory of each of its Members such privileges and immunities as are necessary for the fulfillment of its purposes." Article 2 of the General Convention states more unequivocally that "[t]he United Nations, its property and assets wherever located and by whomsoever held, shall enjoy immunity from every form of legal process except insofar as in any particular case it has expressly waived its immunity." That is generally understood to require absolute immunity, subject to waiver, even in those jurisdictions that regulate (or ordinarily regulate) immunity by separate enactment.³⁷

Other treaties may also establish absolute immunity, for those states bound by them. The Special Convention uses similar language, providing (in Article 3(4)) that "[t]he specialized agencies, their property and assets, wherever located and by whomsoever held, shall enjoy immunity from every form of legal process except in so far as in any particular case they have expressly waived their immunity." As noted previously, the Special Convention is less definitive in character—there are fewer states parties, and greater potential for variation in the treatment of particular IGOs—but the treaty language creates a presumption in favor of similarly broad immunity.³⁸ Bilateral agreements (such as headquarters agreements) may also establish immunity that appears comprehensive in scope.³⁹

³⁷ For U.S. decisions treating United Nations immunity as absolute, see, e.g., *Brzak v. United Nations*, 597 F.3d 107, 112 (2d Cir. 2010); *Van Aggelen v. United Nations*, 311 Fed. Appx. 407 (2nd Cir. 2009); *Boimah v. United Nations General Assembly*, 664 F. Supp. 69, 71 (E.D.N.Y.1987). These and other decisions typically treat the General Convention as self-executing and as affording immunity independent of any derived from statute. See *infra* notes 31-32. In the United Kingdom, the United Nations is simply subject to an Order in Council that respects the extent of immunity under the General Convention. See *The United Nations and International Court of Justice (Immunities and Privileges) Order 1974/1261*.

³⁸ See, for example, its broad treatment in United Kingdom: *The Specialised Agencies of the United Nations (Immunities and Privileges) Order 1974/1260*; *Entico Corp. v. UNESCO*, [2008] CLC 524, [2008] EWHC 531, 156 ILR 382.

³⁹ For example, the Restatement (Third) of Foreign Relations Law, which was otherwise open to affording immunity to IGOs on a restrictive basis only, appeared to consider that the Organization of American States (OAS)—the immunity of which is addressed, *inter alia*, in its Charter (see Article 139 of the Charter of Organization of American States, 2 UST 2394, TIAS 2361, as amended, 21 UST 607, TIAS 6849), in a 1975 bilateral agreement (see Article 2 of the Agreement Relating to Privileges and Immunities, 26 U.S.T. 1025, T.I.A.S. No. 8089), and subsequently in a 1992 bilateral agreement (see Article IV(1) of the Headquarters Agreement Between The Organization of American States and the Government of the United States of America, Treaty Doc. No. 102-40, entered into force Nov. 17, 1994)—

National law may also afford extremely broad immunity, but requires careful scrutiny. In the United States, for example, some (but not all) decisions treat the immunity conferred by IOIA designation as absolute in character,⁴⁰ and it remains contingent in some respects.⁴¹ Other jurisdictions profess to apply an absolute standard, but justify it by noting that IGOs (unlike foreign states) act only in a manner confined to their purposes—which, while *not* spelling out when, how, and by what means such purposes are to be assessed, at least suggests the possibility of outer bounds to immunity.⁴² Conversely, some jurisdictions that profess to apply a less robust scope of immunity apply it so reflexively and broadly that may, in practice, seem absolute.⁴³

The customary international law of IGO immunity—which some courts tend to deny altogether⁴⁴—is sometimes, where recognized, described as absolute. In practice, this too may be less clear as applied. Swiss decisions, for example, have suggested that all IGOs enjoyed absolute immunity, but have also premised that on their performance of functions appropriate to their mission—and proposed this absolutism in a context where treaty commitments, not benefiting all IGOs, play an inescapable role.⁴⁵

might be due absolute immunity, given the comparability of its treaty terms to those used in the General Convention and the Special Convention. See Restatement (Third) of Foreign Relations Law § 467 cmt. f & rptrs. note 4.

⁴⁰ See, e.g., *Atkinson v. Inter-Am. Dev. Bank*, 156 F.3d 1335, 1341 (D.C. Cir. 1998); *Price v. Unisea, Inc.*, 289 P.3d 914, 919-20 (Alaska 2012); *Bro Tech Corp. v. European Bank for Reconstruction and Development*, No. 00-CV-02160-CG, 2000 WL 1751094, at *3 (E.D. Pa. Nov. 29, 2000). As noted below, this position has in recent years become more controversial. See *infra* notes 54-57 (discussing *OSS Nokalva*).

⁴¹ Notwithstanding the immunity conferred upon designated IGOs under the IOIA, it may be waived by the organization itself, it may be limited by the President when that organization is first designated as one entitled to enjoy IOIA immunity, and the President may modify, condition, or revoke the immunity by executive order. *Mendaro v. World Bank*, 717 F.2d 610, 613-14 (D.C. Cir. 1983).

⁴² See Schmalenbach, *supra* note 34, at 457-58 (discussing *Company Baumeister L. v. OPEC Fund*, ILDC 362 (AT 2004)); Gregor Novak & August Reinisch, Austria, in *Privileges and Immunities*, *supra* note 30, at 47-49 (same).

⁴³ See, e.g., August Reinisch, *Transnational Judicial Conversations on the Personality, Privileges, and Immunities of International Organizations—An Introduction*, in *Privileges and Immunities*, *supra* note 30, at 8 (concluding that “[i]t appears that, in practice, the concept of functional immunity frequently leads to *de facto* absolute immunity”); De Brabandere, *supra* note 29, at 474 (“International organization immunity has, unlike State immunity, remained absolute. When one defines the immunity of international organizations as *functional*, in practice this essentially boils down to absolute immunity”).

⁴⁴ See Wood, *supra* note 35, especially at 299 & nn. 39-42.

⁴⁵ Thus, in *Groupement D’Entreprises Fougere v. CERN*, 102 ILR 209 (CH Dec. 21, 1992), the Swiss Federal Supreme Court stated categorically that “[i]nternational organizations enjoy absolute and complete immunity without any restriction,” but at the same time said that this immunity is “is always based on an instrument of public international law in the form of either multilateral conventions between the Member States of such organizations, bilateral agreements, or most frequently headquarters agreements with the host State.” In *ZM v. Permanent Delegation of the League of Arab States to the United Nations*, 116 ILR 643, 647 (CH 1993), a Swiss labor court stated more directly that “[c]ustomary international law recognizes that international organizations, whether universal or

In sum, the United Nations and its constituent elements are likely to be regarded as entitled to absolute immunity, as are the specialized agencies—at least to the extent the state concerned is a party to the Special Convention and has not modified its application. As to other IGOs, it would be difficult to state with confidence whether they are entitled to absolute immunity without particular information about the treaty obligations or national law of the jurisdiction in question. As discussed further below, however, in these circumstances little may ride on the distinction between absolute and functional immunity, and ultimately little may depend on the potential scope of immunity at all.

b. Restrictive immunity

With rare exception,⁴⁶ sovereign (state) immunity has evolved from an absolute standard to what is known as “restrictive” immunity. Under the restrictive approach, states retain immunity for acts *jure imperii*, which are fundamentally sovereign in character, but lack immunity for acts *jure gestionis*—in essence, carving an exception from immunity for litigation concerning commercial activities like those undertaken by private parties.

Relatively few states have shown interest in applying this restrictive approach to IGOs. As noted previously, IGO immunity has different premises than sovereign immunity, so there is no inherent reason why both would have exceptions of similar scope. One recent suggestion of a commercial activities exception—by a Belgian court of appeals, in a case concerning an employment dispute brought against the Arab League—was ignored by the Belgian Cour de Cassation, which resolved the case on other grounds.⁴⁷ Italian courts, in cases involving the Food and Agriculture Organization and the Bari Institute of the International Center for Advanced Mediterranean Agronomic Studies (ICAMAS), denied immunity for acts they regard as being of a private character, but such decisions may have been driven by a now-moot dispute over Italy’s accession to

regional, enjoy absolute jurisdictional immunity.” It also stated, however, that “[t]his privilege of international organisations arises from the purposes and functions assigned to them,” since “[t]hey can only carry out their tasks if they are beyond the censure of the courts of member states or their headquarters.” See generally Thore Neumann & Anne Peters, Switzerland, in *Privileges and Immunities*, *supra* note 30, at 242-51.

⁴⁶ See International Decision: *FG Hemisphere Associates v. Democratic Republic of the Congo*, 108 Am. J. Int’l L. 776 (2014) (reporting decision of Hong Kong Court of Final Appeal applying absolute immunity approach).

⁴⁷ *League of Arab States v TM*, Appeal Judgment, Cass No S.99.0103.F, ILDC 42 (BE 2001), 12th March 2001, Court of Cassation, discussed in Cedric Ryngaert, *The Immunity of International Organizations Before Domestic Courts: Recent Trends*, 7 Int’l Org. L. Rev. 121, 124, 126 (2010).

the Special Convention⁴⁸—with Italy’s more recent cases being better characterized as entailing a narrower approach to functional immunity.⁴⁹

The United States is an important exception. There, some courts have followed a restrictive approach not because of a conviction about international law, but rather due to the text of the IOIA, which provides the statutory basis for IGO immunity in U.S. courts. The IOIA provides, in relevant part, that IGOs “shall enjoy the same immunity from suit and every form of judicial process as is enjoyed by foreign governments.”⁵⁰ Because this emulated sovereign immunity, U.S. courts have wrestled with whether IGOs continue to enjoy the immunity afforded foreign states as of the time the IOIA was enacted in 1945 (when foreign sovereign immunity was generally understood to be absolute) or whether their immunity follows subsequent changes in foreign sovereign immunity (including the commercial activities exception, which was codified in the Foreign Sovereign Immunities Act in 1976).⁵¹

This puzzle remains unsolved. The Restatement (Third) of Foreign Relations Law, an influential compilation of U.S. law and practice, expressed two positions: first, that IGOs “generally” enjoyed functional immunity as a matter of international law (a standard addressed in the next section); and second, that as a matter of U.S. law, IGOs enjoyed the privileges and immunities provided “by international agreements to which the United States is party,” and IGOs “designated by the President under the [IOIA] are entitled to the privileges and immunities provided in that Act.”⁵² This said little about the actual scope of immunity under the Act. In accompanying comments, however, the Restatement (Third) took the position that “[w]hether other international organizations enjoy absolute or restricted immunity under international law is unclear,” but that “at

⁴⁸ For discussion, see Riccardo Pavoni, Italy, in Privileges and Immunities, *supra* note 30, at 157-62; August Reinisch, Accountability of International Organizations According to National Law, 36 Neth. Y.B. Int’l L. 119, 131-33 (2005); Peter Neumann, Immunity of International Organizations and Alternative Remedies Against the United Nations 5-7 (2006), http://ilmc.univie.ac.at/uploads/media/Neumann_-_Immunity_of_IOs_and_alternative_remedies_against_the_United_Nations.pdf.

⁴⁹ See Bonafè, *supra* note 29, at 508, 522-23, 537.

⁵⁰ 22 U.S.C. § 288a(b).

⁵¹ Under the FSIA, “commercial activity” means “means either a regular course of commercial conduct or a particular commercial transaction or act,” with the commercial character “determined by reference to the nature of the course of conduct or particular transaction or act, rather than by reference to its purpose.” 28 U.S.C. § 1603(d). The exception to immunity, then, encompasses cases “in which the action is based upon a commercial activity carried on in the United States by the foreign state; or upon an act performed in the United States in connection with a commercial activity of the foreign state elsewhere; or upon an act outside the territory of the United States in connection with a commercial activity of the foreign state elsewhere and that act causes a direct effect in the United States.” 28 U.S.C. § 1605(a)(2).

⁵² Restatement (Third) of the Foreign Relations Law of the United States § 467(2).

least until that question is authoritatively resolved they will probably be accorded only restricted immunity under the law of the United States.”⁵³

That prediction as to the course of U.S. case law has not been clearly vindicated, but neither has it been repudiated. In 2010, one U.S. court of appeals—the Third Circuit, which exercises authority over federal cases arising from Pennsylvania, New Jersey, Delaware, and the Virgin Islands—construed the IOIA as incorporating the restrictive theory, basing its conclusion in part on an opinion expressed by the Legal Adviser to the U.S. Department of State.⁵⁴ The court intentionally diverged from the D.C. Circuit, which over a decade earlier reached the conclusion that the IOIA conferred 1945-era, absolute immunity for IGOs that has not tracked changes in sovereign immunity.⁵⁵ For the foreseeable future, then,⁵⁶ U.S. cases arising in the Third Circuit are likely to be resolved according to the restrictive theory, while cases arising in the D.C. Circuit will be resolved based on the absolute immunity, and other jurisdictions will eventually side with one position or the other.⁵⁷ The D.C. Circuit may enjoy a degree of deference given its relative expertise concerning IGOs, but its approach has been criticized and appears inconsistent with the view espoused by the U.S. government.⁵⁸

If the restrictive approach were taken, it might diminish the immunity owed an IGO. The defense of marks appears commercial in character, since it is just the sort of activity engaged in by private persons in their own commercial pursuits. Thus, for example, the International Law Commission’s Draft Articles on Jurisdictional Immunities of States and Their Property—which addressed sovereign rather than IGO immunity—exempted the determination of a state’s rights in intellectual and industrial property,

⁵³ Restatement (Third) of the Foreign Relations Law of the United States § 467 cmt. d. As noted earlier, the Restatement allowed that this restrictive theory “appears” not to apply “to the United Nations, to most of its Specialized Agencies, or to the Organization of American States.”

⁵⁴ *OSS Nokalva, Inc. v. European Space Agency*, 617 F.3d 756, 763-64 (3rd Cir. 2010); see Letter from Roberts B. Owen, Legal Adviser, State Department, to Leroy D. Clark, General Counsel, Equal Employment Opportunity Commission (June 24, 1980) (emphasis added), reprinted in Marian L. Nash, *Contemporary Practice of the United States Relating to International Law*, 74 *Am. J. Int’l L.* 917, 917-18 (1980); 1980 *Digest U.S. Prac. Int’l L.* 16.

⁵⁵ *Atkinson v. Inter-Am. Dev. Bank*, 156 F.3d 1335 (D.C. Cir. 1998).

⁵⁶ The U.S. Supreme Court is entrusted with resolving circuit conflicts, but has shown little interest in this particular dispute, which at present remains the subject of disagreement between the D.C. Circuit and Third Circuit only. See, e.g., *Nyambal v. International Monetary Fund*, 135 S. Ct. 2857 (Mem.) (2015) (denying certiorari).

⁵⁷ There has been little indication elsewhere, though a couple of decisions have followed the D.C. Circuit approach. See *Price v. Unisea, Inc.*, 289 P.3d 914, 919-20 (Alaska 2012); *Bro Tech Corp. v. European Bank for Reconstruction and Development*, No. 00-CV-02160-CG, 2000 WL 1751094, at *3 (E.D. Pa. Nov. 29, 2000) (preceding *OSS Nokalva*). The Ninth Circuit Court of Appeals, which hears cases arising in California and the State of Washington, among others, has not established a position.

⁵⁸ See, e.g., Steven Herz, *International Organizations in U.S. Courts: Reconsidering the Anachronism of Absolute Immunity*, 31 *Suffolk Transnat’l L. Rev.* 471, 532 (2008) (“The broad immunity afforded by *Atkinson* far exceeds the legitimate functional needs of international organizations.”).

including trademarks.⁵⁹ To be sure, this translates imperfectly to IGOs, and before the D.C. Circuit settled on an absolute standard, its decisions considering a commercial activities exception for IGOs adapted it to their perceived needs.⁶⁰ It is possible, therefore, that an IGO's registration of trademarks in the United States solely for defensive purposes might not be deemed commercial activity,⁶¹ if an IGO could defend a transfer order in an action initiated by a registrant simply by invoking the IGO's interests in its name, without U.S. registration, the argument for deeming that non-commercial would seem still stronger. On the whole, however, a domain-name registrant seeking to reverse a UDRP cancellation or transfer may find the United States to be the friendliest jurisdiction in which to present that argument: if it could invoke a restrictive approach, it would be the best basis for arguing that that name-related activities are outside IGO immunity.

c. Functional immunity

The idea that IGOs are limited by their functions, often recognized as a general principle of international law,⁶² is frequently urged as a basis for assessing IGO immunity claims as well⁶³—not least, because the governing treaties often contain language suggesting that IGO immunity should be limited by its purposes.⁶⁴ This may carry over

⁵⁹ Rep. of the Int'l Law Comm'n: Draft Articles on Jurisdictional Immunities of States and Their Property, art. 14, 43d Sess., April 29-July 19, 1991, U.N. Doc. A/46/10; GAOR, 46th Sess., Supp. No. 10, pt. 2 (1991), http://legal.un.org/ilc/texts/instruments/english/commentaries/4_1_1991.pdf.

⁶⁰ See, e.g., *Broadbent v. Org. of Am. States*, 628 F.2d 27, 33-34 (D.C. Cir. 1980) (distinguishing IGO immunity under an IOIA commercial activities exception from treatment under the FSIA—which would consider employment by a foreign state in the United States of diplomatic, civil service, or military personnel to be governmental, but the employment of American citizens or third country nationals to be commercial—on the ground that “[a] comparable exception is not applicable to international organizations, because their civil servants are inevitably drawn from either American citizens or ‘third’ country nations,” meaning that for IGOs “such an exception would swallow up the rule of immunity for civil service employment disputes”). For similar outcomes in other employment cases, see *Tuck v. Pan Am. Health Org.*, 668 F.2d 547, 550 (D.C. Cir. 1981); *Mendaro v. World Bank*, 717 F.2d 610, 620 (D.C. Cir. 1983). Even in *Atkinson*, the court of appeals held *arguendo* that if there had been a commercial activities exception, wage garnishment proceedings would not fall within it. 156 F.3d at 1342-43.

⁶¹ See *In re Aluminum Warehousing Antitrust Litigation*, 20014 WL 5801607 (S.D.N.Y. 2014) (FSIA).

⁶² See, e.g., *Advisory Opinion on the Legality of the Use of Nuclear Weapons*, 1996 I.C.J. Reports 78, para. 25 (“International organizations . . . are invested by the States which create them with powers, the limits of which are a function of the common interests whose promotion those States entrust to them.”).

⁶³ See generally Peter H.F. Bekker, *The Legal Position of Intergovernmental Organizations: A Functional Necessity Analysis of Their Legal Status and Immunities* (1994); Michael Singer, *Jurisdictional Immunity of International Organizations: Human Rights and Functional Necessity Concerns*, 36 Va. J. Int'l L. 65 (1996).

⁶⁴ See, for example, Article 40(a) of the Statute of the Council of Europe (“The Council of Europe, representatives of members and the Secretariat shall enjoy in the territories of its members such privileges and immunities as are reasonably necessary for the fulfilment of their functions.”). Analysis is complicated by the potential relevance, depending on jurisdiction, of more than one treaty. As has previously been noted, while Article 105 of the UN Charter states that “[t]he Organization shall enjoy in

into the national law mediating international obligations. Thus, in Canada and the United Kingdom, a functional test may be incorporated by an Order in Council that implements those states' international obligations (according to, respectively, the Foreign Missions and International Organizations Act and the International Organisations Act). In principle, the scope of immunity afforded by such orders is not supposed to exceed that required by an international agreement.⁶⁵

Cases applying a functional test, whether derived from an agreement or elsewhere, typically look to whether immunity concerns activities immediately or directly related to the performance of tasks entrusted to the organization.⁶⁶ As noted below, however, applications of this principle vary considerably in their stringency. Important variables include, for example, whether (and how) the functional inquiry is stated in a relevant agreement, as well as where the burden of proof is placed. In one Canadian case, for example, both the lower courts and the Supreme Court agreed that the relevant agreements and their national implementation established a functional standard, but while the lower court placed the burden on the IGO to demonstrate that immunity was strictly necessary for its functioning, the Supreme Court's inquiry (which ultimately upheld the

the territory of each of its Members such privileges and immunities as are necessary for the fulfilment of its purposes”), the General Convention states a less qualified immunity for states parties. Likewise, the agreements for particular specialized agencies may suggest a more qualified approach, focusing on the IGO's functions, than would be gleaned from a reading of the Special Convention. See, e.g., Article 67(a) of the Constitution of the World Health Organization (“The Organization shall enjoy in the territory of each Member such privileges and immunities as may be necessary for the fulfilment of its objective and for the exercise of its functions.”); Article 40(1) of the ILO Constitution (“The International Labour Organization shall enjoy in the territory of each of its Members such privileges and immunities as are necessary for the fulfilment of its purposes.”), as clarified by its Article 39 (defining ILO capacities); Article XII of the UNESCO Convention (incorporating the provisions of Article 105 of the UN Convention concerning privileges and immunities). Other IGOs may state the terms of their immunities in a basic instrument that is then augmented by a more focused agreement, either of which may be further varied by reservations. Compare Article XV of the IAEA Statute (“The Agency shall enjoy in the territory of each member such legal capacity and such privileges and immunities as are necessary for the exercise of its functions.”), with § 3 of the Agreement on Privileges and Immunities of the International Atomic Energy Agency (providing that “The Agency [and all its property and assets] shall enjoy immunity from every form of legal process except in so far as in any particular case it has expressly waived its immunity”).

⁶⁵ See Wickremasinghe, *supra* note 30, at 438. In Canada, nonetheless, these orders reportedly do not necessarily restrict immunities to functional necessity, see Phillip M. Saunders, Canada, in *Privileges and Immunities*, *supra* note 30, at 84-86, but at least sometimes they do. See, e.g., *Amaratunga v. Northwest Atlantic Fisheries*, 451 N.R. 1, 2013 N.R. T.BEd. No. 020, ¶ 47-53 (Sup. Ct. Canada Nov. 29, 2013) (construing Northwest Atlantic Fisheries Organization order).

⁶⁶ See *Spaans v. Iran-US Claims Tribunal*, 94 ILR 321, 327 ¶ 3(3)(4) (Neth. Sup. Ct. Dec. 20, 1985); accord *Stichting Greenpeace Nederland v. Euratom*, 136 ILR 429, 434-35 ¶¶ 6.2-6.4 (Neth. Sup. Ct. Nov. 13, 2007); *Eckhardt v. European Org. for the Safety of Air Navigation* (No. 2), 94 ILR 331, 333 (Maastricht D. Ct. Jan. 12, 1984).

most substantial immunity defense) simply asked whether the suit concerned would amount to undue interference with the IGO's functions.⁶⁷

Despite its appeal elsewhere, including under international law,⁶⁸ functional immunity has not been directly applied at the test in the United States. To be sure, U.S. courts will afford immunity at least sufficient to fulfill an IGO's purposes, and presumably they will be skeptical of protecting activities that bear a completely attenuated relationship with the IGO's mission—not unlike the commercial activities that are distinguished under the restrictive approach.⁶⁹ At the same time, because the IOIA does not describe immunities in functional terms, and because presidential designation orders do not typically alter the default scope of immunity afforded by the IOIA, U.S. courts do not generally devote much attention to assessing whether immunity is necessary to fulfill the organization's purposes. As a consequence, there is little U.S. law directly endorsing and applying a functional approach as a general method for reckoning IGO immunity.

If a functional approach were employed, how would it apply in these circumstances? Those jurisdictions employing a functional test have demonstrated its flexibility and unpredictability. The Dutch Supreme Court has rejected as inappropriate the criterion of whether the IGO could have fulfilled its task without committing an offense for which immunity is being invoked; the question, instead, is whether “the actions in question are directly related to the fulfillment of [the IGO's] tasks.”⁷⁰ Some courts seem to have been satisfied with assessing whether immunity is, in general and as a whole, necessary for the organization to achieve its objectives—which approaches the elaboration sometimes provided by states that prefer a nominally absolute standard⁷¹—

⁶⁷ See Amaratunga, *supra* note 65, ¶ 53; see also Saunders, *supra* note 65, at 94-98 (discussing lower court proceedings).

⁶⁸ The Restatement (Third), while predicting that U.S. courts might be inclined toward a restrictive approach, reported that “[u]nder international law, an international organization generally enjoys such privileges and immunities from the jurisdiction of a member state as are necessary for the fulfillment of the purposes of the organization, including immunity from legal process.” Restatement (Third) of the Foreign Relations Law of the United States § 467(1).

⁶⁹ See, e.g., *Int'l Bank for Reconstruction & Dev. v. District of Columbia*, 996 F. Supp. 31, 36 & n.3 (D.D.C. 1998) (invoking functional necessity approach of the Restatement (Third)), *rev'd*, *Int'l Bank for Reconstruction & Dev. v. District of Columbia*, 171 F.3d 687 (D.C. Cir. 1999) (reversing on the ground that tax immunity appropriate to the IBRD did not extend to activities of its independent contractor, even if the IBRD would itself have been immune were it to have conducted them).

⁷⁰ *Euratom*, *supra* note 66, ¶¶ 6.3-6.4; see Ryngaert, *supra* note 47, at 130-32.

⁷¹ See Neumann & Peters, *supra* note 45, at 248-50. In *NML Capital Ltd. v. Bank for International Settlements and Debt Enforcement Office Basel Stadt*, ILDC 1547 (Swiss Federal Supreme Court July 12, 2010), the Federal Supreme Court applied an absolute immunity standard, derived from a headquarters agreement, but arguably assessed the functional relevance of garnishment to the Bank for International Settlement's mission.

while others have more readily classified matters that are private and less diplomatic in character as falling outside functional immunity.⁷²

In an arbitration involving the European Molecular Biology Laboratory, an IGO headquartered in Germany, the arbitrators had to determine whether the operation of a cafeteria and guest-house were “official activities” for purposes of resolving whether they were immune from national taxation according to the relevant headquarters agreement, and construed that agreement “in the light of its primary purpose of enabling the EMBL . . . fully and efficiently to discharge its responsibilities and fulfill its purposes.” It found that the conduct of scientific seminars, and providing meals and accommodations to participants, were official activities. On the other hand, supplying meals and accommodation for payment was not, because those functions could not be inferred from the agreement establishing the EMBL, nor was supplying meals or accommodations for EMBL staff.⁷³

As *EMBL* suggests, there may be considerable overlap between the kinds of activities excluded from immunity under a restrictive approach (because they are commercial in nature) and those excluded under a functional approach (because activities that are commercial are not part of the IGO’s mission), but the distinction may be critical here. An IGO would argue that the noninfringed use of its name (including, if it so chooses, in maintaining a domain and making available the information on it) is related to fulfillment of its mission, not unlike the physical seminars at issue in *EMBL*. Registrants would try to distinguish that case, insofar as the agreement establishing the EMBL specifically referenced hosting visiting scientists, training, teaching, and the like,⁷⁴ and much would turn on the nature of the IGO as articulated by its founding instruments and any treaties relating to immunity. But an argument that it is part of an IGO’s mission to maintain the distinctive character of its name, and avoid confusing domain-name registration, and thus deserving of immunity, seems colorable or even likely to prevail.

B. Waiver of immunity

Assuming that an IGO is entitled to immunity, that immunity may be waived. This may be done through the IGO’s governing instruments or through a particular agreement or pleading.

1. Waiver by governing instrument

International financial institutions like the IBRD, the IFC, and the Inter-American Development Bank provide in their Articles of Agreement or comparable instrument for the waiver of immunity with respect to particular suits. The one for the Inter-American Development Bank, for example, provides: “Actions may be brought against the Bank only in a court of competent jurisdiction in the territories of a member in which the Bank

⁷² For the range of results from the Netherlands, see Rosanne van Alebeek & Andre Nollkaemper, *The Netherlands*, in *Privileges and Immunities*, *supra* note 30, at 179, 190-93 (contrasting decisions in *Pichon-Duverger v. PCA* and *Stichting Mothers of Srebrenica*).

⁷³ *EMBL v. Germany*, Arbitration Award, 105 ILR 1, 41-44 (1997).

⁷⁴ *Id.* at 42.

has an office, has appointed an agent for the purpose of accepting service or notice of process, or has issued or guaranteed securities.”⁷⁵ In the United States, at least, this is understood as a waiver of immunity and a designation of venue, not merely a provision establishing venue in the event of individual waivers.⁷⁶

The scope of this waiver, however, is not entirely clear. A number of D.C. Circuit decisions take a functional approach to construing such waivers—one that preceded, but now exists alongside, that court’s precedent upholding an absolute immunity standard that governs in the *absence* of waiver⁷⁷—which assumes that waiver would have been intended to secure “a corresponding benefit which would further the organization’s goals” or “when an insistence on immunity would actually prevent or hinder the organization from conducting its activities.”⁷⁸ The presumption is against waiver,⁷⁹ and asks “whether a waiver of immunity to allow this *type* of suit, by this *type* of plaintiff, would benefit the organization over the long term.”⁸⁰ The approach distinguishes, for example, between commercial transactions, in which failure to waive immunity would “unreasonably hobble [an IGO’s] ability to perform the ordinary activities of a financial institution operating in the commercial marketplace,” and other matters like employment, where the benefit of waiver is less clear and the potential for disruptive interference is greater.⁸¹

Applying that inquiry here—for financial IGOs and those with similar articles—is not straightforward. A waiver is not a commercial precondition allowing an IGO to enter into commercial relationships with others concerning their domain; that is, it does not arise in a contractual setting in which legal exposure to the plaintiff is necessary to secure

⁷⁵ Agreement Establishing the Inter-American Development Bank, Apr. 8, 1959, Art. XI, Section 3, 10 U.S.T. 3068, 3095. For similar provisions relating to the World Bank Organizations, see <http://web.worldbank.org/WBSITE/EXTERNAL/EXTABOUTUS/ORGANIZATION/BODEXT/0,,contentMDK:50004943~menuPK:64020045~pagePK:64020054~piPK:64020408~theSitePK:278036,00.html>.

⁷⁶ *Lutcher S.A. Celulose e Papel v. Inter-American Development Bank*, 382 F.2d 454, 457 (D.C. Cir. 1967).

⁷⁷ The early cases suggest a view of immunity that is less absolute. See, e.g., *Mendaro v. World Bank*, 717 F.2d 610, 615 (D.C. Cir. 1983) (indicating that under international law IGOs enjoy “such privileges and such immunity from the jurisdiction of a member state as are necessary for the fulfillment of the purposes of the organization”) (citing and quoting a tentative draft of the Restatement (Third) of the Foreign Relations Law of the United States). With regard to the issue of waiver, however, cases like *Mendaro* are broadly reconcilable with the later cases premised on absolute immunity. See, e.g., *Atkinson v. Inter-Am. Dev. Bank*, 156 F.3d 1335, 1338-39 (D.C. Cir. 1998).

⁷⁸ *Id.* at 617.

⁷⁹ *Atkinson v. Inter-Am. Dev. Bank*, 156 F.3d 1335, 1338 (D.C. Cir. 1998).

⁸⁰ *Osseiran v. Int’l Finance Corp.*, 552 F.3d 836, 840 (D.C. Cir. 2009).

⁸¹ *Mendaro*, 717 F.2d at 618; accord *id.* at 620 (discussing how the finding of waiver for suits by borrowers, approved in *Lutcher*, “would directly aid the Bank in attracting responsible borrowers”). Compare *Osseiran*, 552 F.3d at 840 (deeming IFC’s charter to have waived immunity for breaches of agreements), and *Vila v. Inter-Am. Inv. Corp.*, 570 F.3d 274, 278 (D.C. Cir. 2009) (waiver for unjust enrichment claim brought by advisor), with *Atkinson*, 156 F.3d at 1338-39 (no waiver for action to garnish employee wages), and *Jam v. Int’l Finance Corp.*, 2016 WL 1170936 (D.D.C. 2016) (no waiver for action alleging breach of IFC environmental and social policies).

a negotiated transaction.⁸² An IGO might well argue, accordingly, that its objectives are furthered if its exposure to adverse determinations concerning its name is limited. Still, one could argue that the IGO's consent is necessary to sustain the UDRP process and the validity of a domain-name registrant's own consent to Mutual Jurisdiction and that, like the waivers in prior cases, is the price of access to domains and the interests they touch. Moreover, the costs do not seem as disruptive as in other cases. Unlike a waiver for employment actions, a waiver permitting domain-related suits would not likely impose "devastating administrative costs" by requiring differentiated policies for each jurisdiction, nor would it offer only marginal advantages relative to established internal administrative procedures as available for employees. In the end, though the argument for waiver under this kind of article is colorable, the presumption against construing such provisions as establishing a waiver may be decisive.⁸³

2. Waiver by agreement or pleading

Waiver may also be accomplished by agreement or pleading. Article 2(2) of the General Convention, for example, provides that the UN's absolute immunity from legal process (other than relative to execution) may be expressly waived in particular cases. More generally, under the IOIA, IGOs "may expressly waive their immunity for the purpose of any proceedings or by the terms of any contract."⁸⁴

Putting aside potential complications, such as limits on who is entitled to waive, granting Mutual Jurisdiction—via initiation of a complaint or, for that matter, registration—would likely be understood as a waiver of any immunity the IGO might otherwise assert. The case law regarding waiver by IGOs is not particularly well developed, not least because IGOs are typically reluctant to waive their immunity. As noted above, numerous U.S. cases in the D.C. Circuit conclude that the governing instruments of international financial institutions, which refer to the bringing of actions in specified jurisdictions, amount to a sufficiently express waiver of immunity—rather than a mere venue provision—despite the fact that such provisions lack any explicit reference to immunity. For similar reasons, reference in the Mutual Jurisdiction provision to complainants' obligation to "submit, with respect to any challenges to a decision in the administrative proceeding canceling or transferring the domain name, to the jurisdiction of the courts in at least one specified Mutual Jurisdiction" (Rules, ¶ 3(b)(xii)), seems to require submission to judicial jurisdiction rather than mere non-objection to the choice among putative venues.

Cases concerning the waiver of sovereign immunity may be instructive, though the underlying scope of immunity likely differs, as may national practices concerning waiver for IGOs.⁸⁵ These circumstances are different than the categories originally

⁸² See *Atkinson*, 156 F.3d at 1338 (D.C. Cir. 1998) (discussing *Mendaro*).

⁸³ See, e.g., *Jam v. Int'l Finance Corp.*, at *6 (concluding lengthy assessment of costs and benefits on the basis of this presumption).

⁸⁴ 22 U.S.C. § 288a(b).

⁸⁵ In the United States, from which examples in the text are drawn, the FSIA provides an exception to foreign sovereign immunity for "cases . . . in which the foreign state has waived its immunity either

thought to establish waiver by implication under the FSIA—“where a foreign state has agreed to arbitration in another country,” “where a foreign state has agreed that the law of a particular country should govern a contract,” or in “a situation where a foreign state has filed a responsive pleading in an action without raising the defense of sovereign immunity.”⁸⁶ That said, the Mutual Jurisdiction provision seems more “unmistakable” or “unambiguous”⁸⁷ than those examples: unlike instances in which a foreign state has agreed to *arbitration* in a state *other than* the one assessing its immunity (which some courts have in fact resisted as indicating an implicit waiver),⁸⁸ Mutual Jurisdiction indicates an IGO’s consent to a judicial action (rather than just arbitration) in exactly the state that would be assessing its jurisdiction.⁸⁹ Cases involving the UDRP seem to bear this out. In one U.S. action, initiated by a domain registrant disputing the outcome of the UDRP, the City Council of Barcelona—after asserting that it was entitled to sovereign immunity under U.S. law—appeared to concede that it was subject to U.S. jurisdiction by operation of its waiver under the UDRP, though it contended that such waiver should be narrowly construed so as to permit challenges to the UDRP transfer decision only.⁹⁰ In

explicitly or by implication.” 28 U.S.C. § 1605(a)(1). Under the IOIA, which governs most IGOs, “international organizations . . . shall enjoy the same immunity from suit and every form of judicial process as is enjoyed by foreign governments, except to the extent that such organizations may expressly waive their immunity for the purpose of any proceedings or by the terms of any contract.” 22 U.S.C. § 288a. As previously discussed, the IOIA’s structure leaves it unclear whether it is subject to the same exceptions as available under the FSIA—including, in this instance, waiver by implication—or whether, as seems more likely here, its waiver provision is independent and exclusive. Even assuming the latter reading, though, it remains unclear whether a requirement that IGOs “expressly” waive their immunity imposes in practice a substantially higher threshold than the FSIA’s requirement that they do so “explicitly or by implication,” since courts construing the FSIA have read waiver by implication narrowly. See, e.g., *Shapiro v. Republic of Bolivia*, 930 F.2d 1013, 1017 (2d Cir. 1991).

⁸⁶ H.R. Rep. No. 1487, 94th Cong., 2d Sess. 18, reprinted in 1976 U.S. Code Cong. & Admin. News 6604, 6617.

⁸⁷ *Shapiro*, 930 F.2d at 1017.

⁸⁸ See *Frolova v. Union of Soviet Socialist Republics*, 761 F.2d 370, 377 (7th Cir.1985) (asserting that “most courts refuse to find an implicit waiver of immunity to suit in American courts from a contract clause providing for arbitration in a country other than the United States”); see also *Creighton Ltd. v. Government of the State of Qatar*, 181 F.3d 118, 122-23 (D.C. Cir. 1999) (viewing skeptically the scope of implicit waiver as described in the FSIA’s legislative history); *Seetransport Wiking Trader v. Navimpex Centrala*, 989 F.2d 572, 577 (2d Cir. 1993) (same).

⁸⁹ It is not, on the other hand, so direct as to refer to immunity as such. See *Gulf Resources America, Inc. v. Republic of Congo*, 370 F.3d 65, 72-74 (D.C. Cir. 2014); see also *World Wide Minerals, Ltd. v. Republic of Kazakhstan*, 296 F.3d 1154, 1162-64 (D.C. Cir. 2002) (noting waiver of immunity pursuant to two agreements advertent to waiver immunity, but contrasting two that did not—and which also referred to resolution by arbitration in other jurisdictions).

⁹⁰ See Brief for Appellee, *Barcelona.com, Inc. v. Excelentísimo Ayuntamiento De Barcelona* at 26, 330 F.3d 617 (4th Cir. 2003). That issue was not the focus of proceedings, though the court of appeals eventually favored the view of the registrant on the ground that (under the Lanham Act) the domain name in question implicated a purely descriptive geographical designation that, having not acquired

another, more recent decision, a district court held that tribal sovereign immunity, waivers of which must also be strictly construed, had nonetheless been waived when a tribe initiated a UDRP proceeding—to the extent that a follow-on lawsuit actually challenged “a decision in the administrative proceedings canceling or transferring the domain name,” though immunity was sustained to the extent the complaint sought broader or different relief not encompassed by the initial proceedings.⁹¹ Likewise, it seems plausible that the Mutual Jurisdiction provision would relieve the jurisdiction designated and entertaining the action of any responsibility for having violating the IGO’s immunity.

Perhaps an IGO might argue that a waiver was compelled and therefore ineffective. It might argue compulsion or duress, for example, if a state party to the Paris Convention were to demand that an IGO waive its immunity in exchange for the state’s willingness to respect the IGO’s privileges. These facts, however, seem quite different. As a threshold matter, ICANN is not in a position comparable to a self-dealing state: to my knowledge, ICANN is not itself constrained by any obligation to respect immunity, nor does it seek the waiver of immunity to *its* jurisdiction as the price of conforming to that obligation. Accordingly—even as to the agreement to Mutual Jurisdiction made by an IGO while registering a domain-name—any compulsion objection seems attenuated. The objection is even harder to make when an IGO has filed a UDRP complaint. As noted previously, nothing compels any complainant to initiate the UDRP and accept Mutual Jurisdiction; beyond tolerating an infringement of its interests, an IGO might elect instead to proceed first (or solely) to court. Even if these options are unappealing (including because filing in court would waive immunity), those are the options that would confront IGOs in the absence of the present UDRP, so it is not as though a preexisting or independent privilege were being conditioned or withdrawn. IGOs might, indeed, take consolation from the advantages afforded them by the UDRP, which—but for cases in which judicial review is later sought by a losing registrant—affords them an efficient recourse to which they are not otherwise entitled.⁹²

National courts may have other reasons to pause before reading this waiver narrowly. Allowing an IGO that *prevailed* in the UDRP process to avoid its waiver and rest on the UDRP result by invoking immunity, while allowing it to waive that immunity by initiating judicial proceedings if it *loses* to a domain-name registrant, will likely seem

any secondary meaning, was not entitled to protection. *Barcelona.com, Inc. v. Excelentísimo Ayuntamiento De Barcelona*, 330 F.3d 617, 628-29 (4th Cir. 2003).

⁹¹ See Order Granting with Leave to Amend Defendant’s Motion to Dismiss at 7-11, *Virtualpoint, Inc. v. Poarch Band of Creek Indians, Dba PCI Gaming Authority*, Case No. SACV 15-02025-CJC(KESx) (C.D. Cal. May 10, 2016), available at <https://www.scribd.com/doc/312906586/Virtualpoint-v-Poarch-Band-of-Creek-Indians-opinion-pdf>.

⁹² IGOs that have submitted to Mutual Jurisdiction as the price for domain-name registration may have a stronger claim that their submission is compulsory, but they too derive benefit from the UDRP procedure, and fewer IGOs are likely to find themselves subjected to judicial proceedings based on their own registration.

asymmetrical and unfair.⁹³ In addition, courts may resist letting matters rest after the abbreviated UDRP process. There is broad acceptance of a principle, expressed in some treaties and governing instruments, according to which IGOs *should* waive immunity in the absence of any sufficient alternative.⁹⁴ The absence of a sufficient alternative may not be a basis for overriding immunity—at least not in the United States⁹⁵—but it might reduce the appeal of arguments for limiting the scope of waiver by Mutual Jurisdiction.

C. The UDRP and Its Alternatives

The question of IGO immunity may be resolved, at least in part, outside ICANN—to the extent that national courts were inclined to find that the matter lies outside a particular IGO’s immunity, or that any immunity was waived by the IGO’s governing instrument. In other cases, though, a national court might find that Mutual Consent effectuates a waiver, even though it would otherwise be inclined to recognize the IGO’s immunity from judicial process. With respect to this latter possibility, ICANN

⁹³ By analogy, the enforceability of arbitration agreements is sometimes limited on the ground that they lack a “bilateral” quality or “mutuality”: requiring one party to submit its claims to arbitration, while allowing the other to elect between arbitration and court, or allowing one side only to appeal.

Armendariz v. Found. Health Psychcare Servs., Inc., 24 Cal. 4th 83, 117, 120, 99 Cal. Rptr. 2d 745, 6 P.3d 669 (2000); *Higgins v. Superior Court*, 140 Cal. App. 4th 1238, 1253-54, 45 Cal. Rptr. 3d 293, 304-05 (Ct. App. 2006); *Sullenberger v. Titan Health Corp.*, 2009 WL 1444210, *5-*6 (E.D. Cal. 2009).

⁹⁴ See, e.g., General Convention, art. 29 (providing that “[t]he United Nations shall make provisions for appropriate modes of settlement of . . . disputes arising out of contracts or other disputes of private law character to which the United Nations is a party”); see generally Institut de Droit International, Resolution on Contracts Concluded by International Organizations with Private Persons(1977), art. 9 (“If a dispute arises in connection with a contract which contains no clause on the settlement of disputes, the organization concerned should either waive immunity from jurisdiction or negotiate with the other party to the contract with a view to settling the dispute or to establishing an appropriate procedure for its settlement - particularly through arbitration.”).

⁹⁵ See, e.g., *Brzak v. United Nations*, 597 F.3d 107, 112 (2d Cir. 2010) (“Although the plaintiffs argue that purported inadequacies with the United Nations’ internal dispute resolution mechanism indicate a waiver of immunity, crediting this argument would read the word ‘expressly’ out of the [General Convention]”); *Georges v. United Nations*, 84 F. Supp. 3d 246, 249 (S.D.N.Y. 2015) (rejecting argument that absolute immunity “is conditioned on the UN’s providing the alternative modes of settlement contemplated by section 29” of the General Convention); *Lempert v. Rice*, 956 F. Supp. 2d 17, 24-25 (D.D.C. 2013) (rejecting argument that the UN had implicitly waived immunity by failing to provide an adequate alternative dispute settlement in violation of due process and obligations arising under the General Convention). The United States government has explicitly rejected the view that the General Convention encumbers the UN’s capacity to assert immunity, either by virtue of an obligation to waive that immunity or to establish alternative mechanisms. Reply in Support of the Statement of Interest of the United States of America, *Lempert v. Rice*, 956 F. Supp. 2d 17 (D.D.C. 2013), <http://www.state.gov/documents/organization/226371.pdf>, 2013 Digest U.S. Prac. Int’l L. 297; Statement of Interest of the United States of America at 11-12, *Sadikoglu v. United Nations Development Programme*, 11 Civ. 0294 (PKC) (S.D.N.Y. 2011), <http://www.state.gov/documents/organization/194079.pdf>, 2011 Digest U.S. Prac. Int’l L. 352, 353.

confronts a policy question infused with legal principles. Several alternatives may be considered.

1. Maintaining the Status Quo

One legally available option is to maintain the status quo. Even if one assumes that an IGO, absent Mutual Jurisdiction, might be capable of asserting immunity, affording them a means of surrendering that immunity via the Mutual Jurisdiction provision is not *itself* an infringement. Accordingly, as a purely legal matter, it seems unlikely that the Mutual Jurisdiction provision, as it may be accepted by an IGO, establishes or occasions a violation of IGO immunity. And as explored further below, it may seem more appropriate to require an IGO to abide by a judicial process, given that it has elected to initiate UDRP proceedings, than it would be require a domain-name registrant to accept the IGO's preferred alternative.

Even the status quo, moreover, may leave IGOs some room for adaptation. An IGO will have no interest in giving others an exclusive right to use its name, but it may be able, according to the law of its seat, to assign a right of use to another (or, at least, to appoint an agent to enforce its interest).⁹⁶ It is presumably within ICANN's authority to establish standing rules permitting such assignees to act as complainants. Indeed, no reform may be necessary: in at least one case, a panel permitted a legal representative of an IGO to proceed as the complainant.⁹⁷

While the validity of assignments under foreign law may be assumed,⁹⁸ their consequences are uncertain, and will undoubtedly depend on national trademark and immunity law. One problem is that such assignments could themselves be regarded as waivers of immunity, although that risk that could be reduced by careful drafting.⁹⁹ A second is that the assignment might be attacked as falling outside the scope of the IGO's immunity. The significance of these issues will depend on whether the IGO is in principle entitled to absolute immunity under national law (and, if not, whether the assignment would be considered to be outside the IGO's restrictive or functional immunity), and whether any domain-related claim could be brought based on the assignment itself.¹⁰⁰

⁹⁶ Of course, either instrument would license the IGO the right to use its name and associated marks. Such license-back schemes are consistent with a valid assignment, notwithstanding the "assignment in gross" doctrine. *E & J Gallo Winery v. Gallo Cattle Co.*, 967 F.2d 1280, 1290 (9th Cir. 1992).

⁹⁷ *Lenz & Staehelin Ltd v. Christopher Mikkelsen*, D2012-1922 (WIPO Jan. 8, 2013). As noted previously (see *supra* note 5), UNITAID, an IGO hosted by the World Health Organization (WHO), had assigned its trademark rights by a fiduciary agreement to Lenz & Staehelin, a private enterprise, which registered them on behalf of the WHO and UNITAID.

⁹⁸ *Federal Treasury Enterprise Sojuzplodoimport v. Spirits Intern. B.V.*, 809 F.3d 737, 742-43 (2nd Cir. 2016); *id.* at 743-45 (Act of State doctrine).

⁹⁹ See *Universal Trading & Inv. Co. v. Bureau for Representing Ukrainian Interests in International and Foreign Courts*, 898 F. Supp. 2d 301, 310-11 (D. Mass. 2012) (concluding that agreement and other legal documents do not explicitly or implicitly waive a foreign state's immunity).

¹⁰⁰ In *Universal Trading*, the Ukraine conducted commercial activity insofar as it contracted with a private party to conduct asset recovery, but in that case the claims were actually based on a breach of

Third, and finally, the assignment might be ineffective—for example, because it is transferred without the accompanying goodwill previously associated with the mark, thus constituting an invalid “assignment in gross”¹⁰¹—and fail to establish an enforceable interest for the assignee. This concern is genuine, but it may not be disabling, and it is certainly not unique. It is already possible that the substantive standard resulting in a UDRP transfer will be different than the one applied in any following judicial proceeding.¹⁰² Just as a name protectable within the UDRP may not be entitled to protection under national law, an assignment that enables an IGO to prevail in the UDRP may not be sufficient to prevail in an action initiated by a losing registrant. This may not be a serious problem in terms of the dispute at hand: if the assignment is imperfect, it would require reversal of the transfer, but the IGO still would not have consented to being involved in the judicial proceedings against it; if, on the other hand, the assignment is sufficient, the matter can proceed with the IGO assignee, and the IGO’s immunity is again not at issue. The graver problem is that a flawed assignment might diminish the assignor’s priority in the underlying mark for all purposes, making it indispensable to scrutinize national trademark law.¹⁰³ As partial consolation, because the IGO (or surrogate) complainant initiating the UDRP process gets to choose among the jurisdictions initially proposed by the registrant, it could take such matters into account in deciding whether to execute an assignment prior to filing a UDRP complaint.

2. Non-Judicial Alternatives

The way that IGOs typically resolve the tension between immunity and judicial processes is to establish a non-judicial dispute resolution process, usually consisting of some form of arbitration—either as part of an internal procedure, typically for employee matters, or involving a third-party provider. The form of this procedure varies widely, even within organizations, and depends on the nature of the claim and the relation of the parties.¹⁰⁴ Of particular relevance here, however, IGOs often provide for settling

the asset-recovery agreement. In the arrangement contemplated here, the domain-registrant’s claim would likely be viewed as based on the UDRP transfer order as opposed to the assignment itself. 898 F. Supp. 2d at 313-17.

¹⁰¹ 3 McCarthy on Trademarks & Unfair Competition § 18:2 (4th ed. 2015); Parkinson v. Robanda Intern., Inc., 2016 WL 761633 (9th Cir. 2016). United States application of this doctrine has been affected by TRIPs, NAFTA, and the Trademark Treaty, but that analysis is complex and outside the scope of this memorandum. See generally 3 McCarthy, *supra*, § 19:31.75; Irene Calboli, Trademark Assignment “With Goodwill”: A Concept Whose Time Has Gone, 57 Fla. L. Rev. 771 (2005).

¹⁰² See *supra* note 15.

¹⁰³ Neil R. Platt, Good Will Enduring: How to Ensure That Trademark Priority Will Not Be Destroyed By the Sale of a Business, 99 Trademark Rep. 788 (2009).

¹⁰⁴ It is difficult to describe contract-based practices of IGOs, which are not transparent, with certainty, and of course hazardous to generalize about quite different organizations. Cf. Reinisch, *supra* note 48, at 130 (acknowledging that “[d]ue to the limited case-law and an equally limited number of arbitral awards, it is very difficult to ascertain the real practice of international organizations with regard to the law applied to contracts with private parties”). For a survey for one IGO with extensive practice, see

contractual disputes by negotiation and conciliation or, failing that, according to arbitration under United Nations Commission on International Trade Law (“UNCITRAL”) or similar rules.¹⁰⁵

These practices are generally accepted by commercial partners.¹⁰⁶ For example, Apple’s software licenses anticipate that some IGO licensees, at least, might object to judicial processes, providing as follows:

If You (as an entity entering into this Agreement) are an international, intergovernmental organization that has been conferred immunity from the jurisdiction of national courts through Your intergovernmental charter or agreement, then any controversy or claim arising out of or relating to this Agreement, or the breach thereof, shall be determined by arbitration administered by the International Centre for Dispute Resolution in accordance with its International Arbitration Rules. The place of arbitration shall be London, England; the language shall be English; and the number of arbitrators shall be three. Upon Apple’s request, You agree to provide evidence of Your status as an intergovernmental organization with such privileges and immunities.¹⁰⁷

Adopting a similar mechanism as a supplement to the UDRP process would likely appeal to IGOs, which may regard it as unfair that the Mutual Jurisdiction provision asks them to pay a greater price for UDRP participation (the loss of their immunity from

Bruce C. Rashkow, Immunity of the United Nations: Practice and Challenges, 10 Int’l Org. L. Rev. 332 (2013).

¹⁰⁵ International Fund for Agricultural Development (IFAD), General Terms and Conditions for the Procurement of Goods, art. 24, http://www.ifad.org/governance/procurement/procure_21.pdf; International Labour Office, Terms and Conditions Applicable to ILO Contracts for Services, para. 13, http://www.ilo.org/wcmsp5/groups/public/---ed_mas/---inter/documents/legaldocument/wcms_117516.pdf; International Labour Office, Terms and Conditions Applicable to ILO Contracts, para. 13, http://www.ilo.org/wcmsp5/groups/public/---ed_mas/---inter/documents/legaldocument/wcms_117515.pdf; see also Edward Kwakwa & Marie-Lea Rols, The Privileges and Immunities of the World Intellectual Property Organization, 10 Int’l Org. 373, 391 (2013) (quoting WIPO General Conditions of Contract). For a like declaration, expressed as a policy rather than as a contractual provision, see International Organization for Migration, General Procurement Principles and Practices, para. 5.4, <https://www.iom.int/sites/default/files/about-iom/procurement/IOM-General-Procurement-Principles-and-Processes-Jan-2016-final.pdf>.

¹⁰⁶ See Yves Renouf (WTO Secretariat), When Legal Certainty Matters Less than a Deal: Procurement in International Administrations 3, Inst. for Int’l L.J. (March 19, 2009), <http://www.iilj.org/gal/documents/GALch.Renouf.pdf> (reporting that bidders and contractors typically accept IGO-proposed mechanisms “without a word”).

¹⁰⁷ Xcode and Apple SDKs Agreement, para. 8.6(c), <https://www.apple.com/legal/sla/docs/xcode.pdf>.

jurisdiction) than other parties, which are merely asked to waive objection to a *particular* jurisdiction. Still, the UDRP context seems materially different. Unlike a contracting situation, in which a typical prospective partner can agree to the IGO's preferred mechanism or pursue similar opportunities elsewhere, a party interested in registering a domain name would have less freedom; conceding to the IGO's preferred mechanism, at least its possibility, would be an inescapable aspect of registration. (There may be little sympathy, of course, for those who actually register their names in bad faith, but that premise is in theory open for reexamination after the UDRP proceeding; those whose misconduct is less apparent, moreover, may have had little cause to scrutinize an IGO-specific resolution option, which may appear to them like a remote contingency.) An alternative dispute resolution would also require compliance by a third party to a greater degree, since ICANN would be facilitating the IGO's preference by changing the terms it prescribes, as opposed to a situation in which IGOs and their contract partners decided the question the question bilaterally.

ICANN is, of course, prescribing terms in any event. But as against compelling waiver by IGOs, compelling arbitration may be more easily challenged in domestic courts, including as the basis for suggesting a further exception to IGO immunity. The conflict between immunity and access to courts was developed most famously in the *Waite and Kennedy* case, which involved employment-related actions brought against the European Space Agency in German courts. In upholding immunity, the European Court of Human Rights stated that a material factor was "whether the [employees] had available to them reasonable alternative means to protect effectively their rights under the Convention," though it held that the ESA appeals board sufficed.¹⁰⁸ Other decisions have permitted the assertion of immunity against employee dismissal lawsuits based on the perceived adequacy of the Administrative Tribunal of the International Labour Organization.¹⁰⁹

These cases show that inquiring into reasonable alternative means does not necessarily imperil immunity, and there are grounds for differentiating this context or otherwise avoiding this exception.¹¹⁰ First, domain-related rights are unlikely to be considered the equivalent of employee rights.¹¹¹ Second, the principle may be limited to states subject to the European Convention on Human Rights, meaning that other

¹⁰⁸ See *Waite & Kennedy v. Germany*, App. No. 26083/94, 30 Eur. H.R. Rep. 261, 265-67, 274-75 (1999); see also *Beer & Regan v. Germany*, App. No. 28934/95, 33 Eur. H.R. Rep. 3, 78-79 (1999).

¹⁰⁹ See Thomas Henquet, *The Jurisdictional Immunity of International Organizations in the Netherlands and the View from Strasbourg*, 10 *Int'l Org. L. Rev.* 538, 551-52 (2013).

¹¹⁰ See, among many treatments, August Reinisch, *The Immunity of International Organizations and the Jurisdiction of their Administrative Tribunals*, 7 *Chinese J. Int'l L.* 285 (2008). Some argue, naturally, that the doctrine is excessively limited. See, e.g., Emmanuel Gaillard & Isabelle Pingel-Lenuzza, *International Organisations and Immunity from Jurisdiction: To Restrict or to Bypass*, 51 *Int'l & Comp. L.Q.* 1 (2002).

¹¹¹ But cf. Fox & Webb, *supra* note 23, at 577 (noting that "it has additionally been contended that the interest of individuals dealing with the [international] organization whether as suppliers of goods or services or employees . . . also require legal protection").

jurisdictions would have to simulate this doctrine under other international or domestic human rights instruments.¹¹² Third, even for employee matters and for states subject to the European Court of Human Rights, national courts have distinguished matters involving IGOs entitled to absolute immunity (at least where that immunity is reinforced, as for the United Nations, by the UN Charter)¹¹³ and organizations for which immunity was established in the state concerned before the European Convention came into force.¹¹⁴

Subject to these important qualifications, were an IGO able to secure from ICANN the transfer of another registrant's domain, without adequate means of challenging that result, such proceedings might pose concerns for those states disposed to employ a *Waite & Kennedy* assessment. If the Mutual Jurisdiction provisions were revisited so as to permit only non-judicial review for IGOs, ICANN should pay close attention to the robustness of these alternatives, whether they likewise constrain the options for losing IGOs, and whether such recourse may be made voluntary only.

¹¹² The United States government has emphasized that, for this reason, such arguments are of limited value in U.S. court. Statement of Interest of the United States of America at 11-12, *Sadikoglu v. United Nations Development Programme*, *supra* note 95; see note 95 and accompanying text (discussing potential for arguing the inadequacy of alternatives in construing the scope of waiver); *Amaratunga*, *supra* note 65, ¶¶ 59-63 (examining and rejecting, as a basis for avoiding IGO immunity, attempt to invoke analogous denial-of-justice principles in the Canadian Bill of Rights and the International Covenant on Civil and Political Rights).

¹¹³ *Stichting Mothers of Srebrenica v. Netherlands & United Nations*, ¶¶ 4.3.3-4.3.6, LJM:BW 1999 (Neth. Sup. Ct. Apr. 13, 2012), <http://www.asser.nl/upload/documents/20120905T111510-Supreme%20Court%20Decision%20English%2013%20April%202012.pdf>. See also *Brzak v. United Nations*, 597 F.3d 107, 112 (2nd Cir. 2010) (suggesting that where absolute immunity is otherwise conferred, attempting to measure the adequacy of internal mechanisms would be inconsistent with absolute immunity and the requirement that waivers be express).

¹¹⁴ *Entico*, *supra* note 38, ¶¶ 23-29 (concluding, in the alternative, that arbitration according to UNCITRAL rules is a sufficient alternative).

3. Other Possible UDRP Reforms

Beyond simply maintaining the status quo, or accepting non-judicial alternatives familiar to IGOs, several possible compromises are worth considering.

First, ICANN could distinguish among IGOs: maintaining existing Mutual Jurisdiction terms in general, but permitting particular IGOs to elect instead to submit to arbitration (according to UNCITRAL or some similar procedure) disputes persisting beyond the UDRP process. The most obvious candidates would be IGOs almost universally entitled by treaty to absolute immunity, like the United Nations. Starting with the clearest cases would also allow ICANN to evaluate the alternative mechanisms before permitting them generally, but repeated modification of the terms (including conforming changes in registration agreements) may pose logistical problems.

Second, the Mutual Jurisdiction clause could be rewritten to address the special case of IGOs *without* prejudging the question of their immunity. The objective would be to avoid assuming IGO immunity in circumstances where the relevant jurisdiction would not be inclined to afford it anyway—because, for example, its courts would apply a functional or restrictive approach and regard the activity as beyond immunity’s scope. It may be difficult, of course, to agree on the proper threshold for diverting cases toward an alternative mechanism, in particular whether and by what means a legal evaluation could be obtained from the jurisdiction concerned, and the issue of the appropriate alternative would have to be resolved. Bracketing these questions, however, the Rules could in principle provide something like the following:

Complainant will submit, with respect to any challenges to a decision in the administrative proceeding canceling or transferring the domain name, to the jurisdiction of the courts in at least one specified Mutual Jurisdiction, *except that*: in the event the action depends on the adjudication of the rights of an international intergovernmental organization that would, but for this provision, be entitled to immunity from such judicial process according to the law applicable in that jurisdiction, [as established by a decision of a court in that jurisdiction,] the challenge must be submitted instead for determination [by UNCITRAL in accordance with its rules].

Finally, it may be possible to ameliorate the hardship that a non-judicial process might impose on the other party. For example, an IGO might be permitted to elect arbitration if it agreed to bear some or all of the cost. Assuming IGOs were found that appealing, the formulation of such a provision might be complex, given that national law

may influence its enforceability.¹¹⁵ In principle, though, such a mechanism could eliminate the higher costs arbitration may impose relative to litigation and, potentially, compensate the would-be litigant for the lost opportunity to proceed in court.

Reforming Mutual Jurisdiction along one of these three lines would benefit IGOs to the extent it restored to them a version of their pre-UDRP immunity.¹¹⁶ By the same token, however, it would tend to discount the benefit they received from the UDRP process. And even if either losing party were permitted to initiate a post-UDRP arbitration, even one subsidized by the IGO, the mechanism would still be one imposed by ICANN as an accommodation to IGOs rather than to other parties—which would continue to resort to judicial action in cases not involving IGOs. Whether such an accommodation is appropriate, in light of the immunity often owed IGOs, is ultimately a policy question.

¹¹⁵ See, e.g., John L. Gardiner & Timothy G. Nelson, Recovery of Attorneys' Fees in International Arbitration: The Dueling 'English' and 'American' Rules, 2010 Arb. Rev. of the Americas 25.

¹¹⁶ That which they might have enjoyed, for example, in a declaratory judgment action commenced against them by a domain-name registrant. See *supra* text accompanying note 21.

14 Annex G – Background to the Working Group’s Initial Recommendation concerning Article 6ter of the Paris Convention for the Protection of Industrial Property **

*** Note that the original ordering of footnotes has been retained, but the page numbers are relative to their position in this Final Report.*

The following text is excerpted from the Working Group’s Initial Report, where it described the scope of this treaty provision and outlined the requisite notification process. It is being reproduced in this Annex to provide the full context for the Working Group’s initial conclusion.

A. Purpose, Scope and Limitations of Article 6ter

The purpose of Article 6ter is to protect armorial bearings, flags and other State emblems of the States party to the Paris Convention¹ as well as official signs and hallmarks indicating control and warranty adopted by them. This protection was extended to armorial bearings, flags, other emblems, and abbreviations and names of international intergovernmental organizations by the Revision Conference of Lisbon in 1958.

Under paragraph 6(1)(a) of Article 6ter, the States that are party to the Paris Convention “agree to refuse or to invalidate the registration, and to prohibit by appropriate measures the use, without authorization by the competent authorities, either as trademarks or as elements of trademarks, of armorial bearings, flags, and other State emblems, of the countries of the Union, official signs and hallmarks indicating control and warranty adopted by them, and any imitation from a heraldic point of view.” Under paragraph 6(1)(b), the protections described by paragraph (a) “shall apply equally to armorial bearings, flags, other emblems, abbreviations, and names, of international intergovernmental organizations of which one or more countries of the Union are members, with the exception of armorial bearings, flags, other emblems, abbreviations,

¹ Note that, as a result of the TRIPS Agreement which came into effect in January 1995, the obligations for States party to the Paris Convention also became applicable to any State that becomes a member of the World Trade Organization, regardless of whether that State also signed up to the Paris Convention individually.

and names, that are already the subject of international agreements in force, intended to ensure their protection”.

It should be noted that paragraph (c) clarifies that States “shall not be required to apply the said provisions when the use or registration referred to in subparagraph (a), above, is not of such a nature as to suggest to the public that a connection exists between the organization concerned and the armorial bearings, flags, emblems, abbreviations, and names, or if such use or registration is probably not of such a nature as to mislead the public as to the existence of a connection between the user and the organization.”

B. The Communications Procedure to be followed by IGOs under Article 6ter²

Under Article 6ter, States and IGOs wishing to avail themselves of the protections have to follow a prescribed procedure. This requires the sending of a communication regarding the particular sign or emblem for which protection is sought to the International Bureau of WIPO, which will then communicate it to the other States party to the Paris Convention or otherwise bound to observe the obligations thereunder. The current WIPO communication procedure involves the periodical electronic publication by WIPO of those signs and emblems (including IGO names and acronyms) for which protection under Article 6ter is being requested, in what is known as the Article 6ter Express Database (<http://www.wipo.int/ipdl/en/6ter/>). The nature of the names and acronyms concerned as well as the IGO that has requested their protection is published, in English and French, together with the individual reproductions of the names and acronyms concerned.

The electronic publication is made on a semi-annual basis, on the last working day of the months of March and September. A link to the most recent communications is inserted into the database, which indicates the communications that were received by WIPO during the six months previous to the most current publication. The date of publication is considered to constitute the date of receipt of the communication by individual States party to the Paris Convention and any other party bound to apply Article 6ter of the Paris Convention³.

There does not appear to be any procedure by which any publication may be investigated, examined, or challenged. In this regard, the inclusion within the database bears similarity to registrations in jurisdictions that do not subject trademark

² See <http://www.wipo.int/article6ter/en/communication.html> for a description of the communications procedure, and http://www.wipo.int/article6ter/en/general_info.html for general information about Article 6ter.

³ See <http://www.wipo.int/article6ter/en/communication.html>. The specific process for IGOs is also detailed by WIPO at <http://www.wipo.int/article6ter/en/igos.html>.

registrations to an investigatory process. The Working Group notes that UDRP panels have typically found trademark registrations that are automatic or unexamined (such as United States (US) state registrations as opposed to US federal registrations) are not owed the same deference under the UDRP as examined registrations⁴.....

⁴ See, e.g., Para 1.1, *WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition* (WIPO Overview 2.0), World Intellectual Property Organization (2011).