

**IGO-INGO Access to Curative Rights Protection Mechanisms Working Group
TRANSCRIPT**

Wednesday 10 December 2014 at 17:00 UTC

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Attendees:

George Kirikos - Individual
Petter Rindforth – IPC
Phil Corwin – BC
Kristine Dorrain- Individual
Nat Cohen - BC
Mason Cole – RySG
David Maher – RySG
Paul Keating – NCUC
Val Sherman - IPC
David Heasley - IPC
Susan Kawaguchi – BC
Osvaldo Novoa - ISPCP

Apologies:

Mary Wong

ICANN staff:

Berry Cobb
Steve Chan
Nathalie Peregrine

Coordinator: And this call is officially being recorded.

Nathalie Peregrine: Thank you very much, (Troy). Good morning, good afternoon, good evening, everybody, and welcome to the INGO-NGO Curative Rights Protection PDP Working Group call on the 10 of December 2014.

On the call today we have Petter Rindforth, George Kirikos, Mason Cole, Val Sherman, David Heasley , David Maher, Paul Keating, Susan Kawaguchi,

Phil Corwin and Kristine Dorrain. We have apologies from Mary Wong. And from staff we have Steve Chan, Berry Cobb and myself, Nathalie Peregrine.

I'd like to remind you all to please state your names before speaking for transcription purposes. Thank you ever so much and over to you Petter Rindforth.

Petter Rindforth: Thank you. Petter Rindforth here. Any statements of interest to update? I see no hands up, so let's proceed to the first item on the agenda, the update. And what you see on the screen is still called a draft for your consideration only, updated December 2, our letter to be sent out to GNSO stakeholder group constituency chairs.

However, I notice that it was actually sent out already yesterday, the final version of this. And as you know we had some general questions, four questions. Number one, what is the view of your stakeholder group constituency on their working decision to exclude INGOs from further consideration in this PDP?

And question number two, what should be the basis, if any, other than trademark rights what are standing criteria required in any dispute resolution process for IGOs, whether in the form of amendments through the UDRP and/or URS or a specific (unintelligible) proceeding based upon them? Question number three, how should the curative rights process properly deal with this problem, one of them during (unintelligible)? And question number four, what does your stakeholder group's constituency view on the big issue with the existing UDRP or URS see constitute a nominal cost?

I noticed from - because I've just seen the version that was actually sent out yesterday to the IPC, the Intellectual Property Constituency, and in the e-mail that followed it, it was a bit wrongly described as on behalf of the co-chairs the working group requests your input on. And then it was in the e-mail notice the two initial questions for our working group, namely number one, whether

the UDRP and/or the URS should be amended and, if so, how or whether a separately non-detailed dispute resolution proceedings modeled on the UDRP or the URS should be developed.

So that was - and then it says, "Please see the attached document for full details." So that e-mail was a little bit confused, but I hope that everybody that has actually received our document see that our questions are a little bit different than going into deeper details on these two questions.

Yes I will, George. Because I just saw it when we had our preparatory call, so I will clarify it through the IPC mailing list so that there's no problem. But just a note to all of you that are members of any groups, it could be good to just send out this clarification that the few questions we have is actually in this document that has been sent out.

Okay. Any other comments on this? I see no hands up. Just to also note that we discussed - we suggested initially by the January 9 as the date to get the input, but we have extended to January 23. So - but I think it would be good if the staff could send out a reminder just after new year so that all the groups that needs to respond to comment on this will have a reminder on the due date. But we're still talking about January.

Yes, (Paul), go ahead. (Paul), sorry can't hear you. Okay. I see your comment. That is right from George, a note the way out on mute. Well I see (Paul)'s note is there. "I think the registrar should receive a copy as well since any change to the UDRP would require change to the RA." I have no problem with that to send it out. Steve?

Steve Chan: Thanks, Petter. This is Steve from staff. Yes just to confirm, the letter should have been sent to all stakeholder groups and constituencies, and we're also intending to send to the SOs and the ACs in the next couple days. So I'll make sure that it was actually sent to the BC, but it should have been sent to

all SGs and Cs. So just taking note of George's note he left in the chat. I'll make sure it actually gets sent there. Thanks.

Petter Rindforth: Okay thanks. (Paul), I still see your hand's up. Is there anything you want to add to this? No. And Steve? Okay. Sorry just reading the chat. Then I think we are proceed to point three, which is to discuss the working group approach and initially to have brainstorming on a work plan question.

We have two specific questions. What might be a justifiable, principle basis for standing other than trademark rights, whether under the UDRP, URS or a new dispute resolution procedure? And the question two, assuming for the moment that sovereign immunity is a problem for IGOs and in responses from the GAC and the IGOs, what type of appeal process other than what is now the UDRP and the URS might be a solution that would still offer adequate protection to registrants?

And I see George's hand's up. Go ahead.

George Kirikos: Thanks, Petter, I was on mute. George Kirikos speaking. Just to go back to the prior topic, do we have any news on any feedback from the GAC or the IGOs, or do we expect them to respond in January at the same time as the constituencies?

Petter Rindforth: Petter here. I haven't heard anything back yet so I presume that we will get, and I hope that we will get, replies from them also in January. I don't know if Nathalie or Steve will have any comments on that. Okay. George?

George Kirikos: Yes one further point. Did we hear back from ICANN legal counsel regarding the research that they were planning to do regarding how the various national governments enforce the Article 6ter requirements or enforcement? I think Mary had said that she was going to talk to ICANN Legal because they obviously budgets to do, you know, west law and other database searches, but I guess she's not hear today. So perhaps next time, or she can maybe

send something to the mailing list, but maybe other ICANN staff are aware of any progress on that. I'd appreciate an update.

Petter Rindforth: Have we got any news on that?

Steve Chan: Hi this is Steve. I don't think we have any progress to date on that, so we'll look into that further.

Petter Rindforth: Okay thanks. Well this is literally something to get up with doing maybe not next week's call, if we have one, but in January call to have some kind of initial report, at least that had been sent out and what we can expect dealing on the time limit for that.

Okay. Then back to questions. I open the floor. If we start with number one, we've got a little bit of a basis for standing other than trademark rights. I mean, when we're talking about IGOs, they have in fact at least I presume in most jurisdictions other pure trademarks related trademark legal protective rights to their signs and names. And that is obviously something that we need to describe and consider further to probably add into our new versions of the UDRP or the URS or if we come out with a similar new dispute resolution field procedure.

George?

George Kirikos: George Kirikos speaking. Yes, in my opinion it should not be trying to make new law, so I think we should limit it to trademark rights. Last week I had actually sent a couple of links to the chat room, which I also followed up by sending to the mailing list, regarding a UDRP brought by World Bank, regarding the worldbank.net domain name in 2002. I'll repost that link to the chat room.

And so that's an example where, you know, they're an obviously an IGO because they're listed on the ICANN reserve list, and they had trademark

rights and they were able to enforce it under the UDRP. So that's an example of where somebody could enforce their rights using, you know, existing mechanisms where no changes, no special procedure was required.

And I think if one reads, you know, through all the UDRP decisions, they have kind of expanded it to not necessarily require a register trademark, you can have, you know, common law rights. So I think, you know, the basis should still be trademark rights and if a complainant wanted to use the Article 6 (tier), you know, database as an example of their, you know, registration or semi-registration of rights, you know, that's something they could use to try to argue for common law rights. But of course, you know, they could register it on the normal trademark database as well, as the World Bank has done.

Petter Rindforth: Thanks, George. I agree that they can, but I also as I've seen - I would say many of the at least the ccTLD dispute resolution procedures they have a list of these kind of protected acronyms and names that are not pure trademarks that can either be - they cannot be registered by others as domain names and they also basis for their local dispute resolution procedures.

So whatever we came up to in this will still lead to - even if we come to a conclusion that there's no need to extend the basis of protection other than the traditional trademark rights, we need to describe how we have come up with that conclusion and the basis for that.

Phil?

Phil Corwin: Yes thanks, Peter. You know, from perspective, we've got some interesting anecdotal evidence right now but we don't have the kind of comprehensive input that we need that we need to go forward on some of this stuff. We know anecdotally that at least one or more IGOs has brought a UDRP based on its registration of a trademark, but we don't know how widespread the registration of trademarks for full names and acronyms by IGOs is.

We know that the U.S. requires IGOs that they want to protect their Article 6ter rights in the U.S. to register with the PTO. I'm unclear as to whether that's registering a trademark or just registering something the trademark authorities can check against, which is similar to but not quite the same as a trademark. And of course we don't know yet how other nations implement Article 6ter and whether they require any type of registration.

So I just want to point out, I mean, we've got some interesting anecdotes, so far we don't have the kind of comprehensive survey we're going to need to decide here. It may be - I think we all, unless it's absolutely necessary, want to avoid for many reasons creating an entirely new curative rights process separate from UDRP and URS. And we may find that existing UDRP and URS rules are fine or that we just have to make a very minor amendment for standing.

And as to classification of goods and services, it would be being an INGO, being an international inter-governmental organization. Sorry for getting tongue-tied there.

But, you know, we're not at that point yet, so we're really - we need to know the prevalence of trademark registrations by IGOs. We need to know how other nations have implemented Article 6ter, and we've got the U.S. representative to the GAC checking to make sure that 2002 State Department position is still the U.S. position. And we need - and that's also going to bear on the sovereign immunity issue.

So right now we're faced with a question of we're going to lose some time and momentum anywhere. At least we're not going to be meetings definitely the last two Wednesdays of this month because of Christmas and New Year's. What's the best way to organize ourselves over then so we can make some progress and come back in early January and have more of this information that we need? What's the best way to get organized? As I see it, that's the big question before us today.

Petter Rindforth: George?

George Kirikos: Yes as (Paul) noted in the chat room, you know, the UDRP panels can consider the names of the IGOs to be common law marks, whether they're registered or not. So I think it's still - the foundation should be in trademark law.

In fact, the other foundation I was thinking about was that the IGOs seem to be mostly concerned, at least, you know, in terms of legitimate concerns, about other entities impersonating them on the Internet. So the example they tended to use were, you know, you can have a website pretending to be UNESCO and looking for donations or they could be pretending to be some, you know, charitable, you know, relief website and trying to, you know, solicit donations from the public, you know, impersonating the IGOs.

So I think in that kind of case they would have a very strong ability to deter that activity via the UDRP. I'm not clear what, you know, besides a wish to have certain domain names that are valuable like, you know, the example of, you know, (IDEA) or ISO, which are valuable domain names that could be used by many, many organizations. The desire to just have those domain names reserved for IGOs doesn't necessarily seem to be to me to be a legitimate desire. It might be kind of a want rather than a need, and so we should look more towards what the IGOs need rather than, you know, want they might, you know, simply want.

Petter Rindforth: Yes, Petter here. We also can see that, I mean, when the UDRPs was initiated it was based on pure traditional trademarks but rather soon we got disputes regarding were non-people's names that were not registered or even by those people use those trademarks but obviously they were seen as well know trademarks, well know identifications for that kind of person for specific services. So if we talk about trademark in a broad perspective, it's probably not needed to add something.

But just to summarize, both this question number one and question number two, we definitely need to again rather quick work and solution on so that we can proceed. And I think that we don't need to discuss in item number one more. Then we also have the second question on the, what do we call, the appeal process, and we don't have any clear answer to that today. So what I said before, shall we form maybe two small groups to further discuss these two items and get initial input on our January meeting. What do you think about the best way to proceed?

George?

George Kirikos: George Kirikos speaking. My preference actually would be that it be on the entire mailing list, like not to form subgroups at all. If you look at the traffic on the mailing list it's been very, very low so I think it would be better to have the discussions be public amongst everybody and that would probably help encourage more members to actively participate outside of the weekly phone calls. Perhaps some people can't make it and, you know, would prefer to participate via the mailing list.

Petter Rindforth: Okay. (Unintelligible) Yes it seems that we'll agree on George's suggestion here. That may be the most - the best way to deal with it. So if we don't have further comments on this during the upcoming week and then I'll proceed to talk about the next week. As I saw initially on the chat list some of you may have problems to participate in the meeting next week, which is December 17.

But I still think it would be good to - if we can have an active chat in the upcoming days and meet - it's probably not needed to have a full hour meeting, but to at least to have let's say around 30 minutes summarizing our comments and see if we have come to any initial conclusions by next week.

Yes, Phil?

Phil Corwin: Yes thanks, Petter. Yes I'm in favor, as co-chair here. I think we've already decided we're not having calls on the 24th or 31st because of Christmas and New Year's. I know someone brought up the fact that Hanukah starts next Tuesday night, but I'm Jewish, Hanukah's not the type of holiday where people are going to be in temple all day Wednesday. It's not quite the high holy days of Rosh Hashanah, Yom Kippur where that's going to prevent any member from being here.

So I think if only for a short call we ought to follow up on this call some emails on, you know, putting together a practical, pragmatic plan for going forward for gathering the information we need to make further decisions on what, if anything, needs to be done and then to use the time of the last half of December to do some of the research that's required so we can get back together in early January and actually have made some substantive progress.

And we're going to need assistance from ICANN legal staff and policy staff on some of that. But we just need to - we don't want to bog down for a month and come back in January with a loss of momentum and with nothing having been uncovered in terms of information that we need between now and then. So I think if we can't decide how we're going to proceed exactly right now but we're going to do it as a group, which seems to be the consensus in regard to George's suggestion, let's figure out how we're going to go forward.

I see that (Paul) just stated that January 6, 7 is a big day in Europe. What is - so that may interfere with some European participation on the first call in January. I think all the more reason to use the coming week and a short call next week to, you know, get some commitments and get some - put some details in of how we're going to move forward. That's my two cents on...

Petter Rindforth: Thanks, Phil. Yes I agree. And maybe we have to come back to see what to do with our first meeting in January if we should also have as a quick update or if we shall move to the week after that. So if ICANN just ask the - ICANN

staff can send out the two main questions again to the full list so that we can start collecting comments on those by the deadline before our meeting, our summarizing meeting, next week, that would be good.

Steve?

Steve Chan: Thanks, Petter. I was actually just agreeing to send out those two questions.

Petter Rindforth: Okay.

Steve Chan: Actually while I have the floor, actually there is a question. So one of the actions that I think still needs to be done, and Phil mentioned this, he said is to understand the prevalence of trademarks for IGOs. I'm not sure who you wanted to assign to actually do this. It could be staff or if someone wanted to volunteer from the group to look at the list of IGOs in certain jurisdictions like South Africa and the U.S. I think we might have mentioned that staff would be able to take this on, but if someone would like to volunteer, I'm open to any suggestions. But I think this is one of the things that would be done through the holidays.

Petter Rindforth: Yes. As I see no hands up directly, so yes I appreciate the (unintelligible) from the staff. And I hear some other discussions. If you can mute your phone, thanks.

Okay. So any other updates? Okay. I see nothing. So it seems that if we start with collecting comments from all of you on these two issues before our meeting, quick updating meeting, next week, that's good. And it seems that we have concluded our meeting today. Thanks, everybody, and see you next week. Bye.

Nathalie Peregrine: Thank you very much. (Troy), you may now stop the recording.

END