

ICANN Transcription

IGO-INGO Curative Rights Protection Mechanisms Working Group

Thursday, 04 May 2017 at 16:00 UTC

Note: The following is the output of transcribing from an audio recording of the IGO-INGO Curative Rights Protection Mechanisms Working Group call on the Thursday, 04 April 2017 at 16:00 UTC. Although the transcription is largely accurate, in some cases it is incomplete or inaccurate due to inaudible passages or transcription errors. It is posted as an aid to understanding the proceedings at the meeting, but should not be treated as an authoritative record. Attendance may be found at:

<https://community.icann.org/x/OQPfAw>

The recordings are also available at: <https://audio.icann.org/gnso/gnso-igo-ingo-crp-pdp-04may17-en.mp3> AND <https://participate.icann.org/p7zh4k5xsa0/>

Michelle DeSmyter: Well good morning, good afternoon and good evening to you all.

Welcome to the IGO INGO Access to Charter Rights Protection Mechanisms Working Group call on the 4th of May at 1600 UTC. On the call today we have George Kirikos, Petter Rindforth, Mason Cole, Paul Tattersfield, David Maher, and Philip Corwin. We have apologies from Oswaldo Navarra. From staff we have Mary Wong, Steve Chan, Dennis Chang, Berry Cobb, Julie Bisland and myself, Michelle DeSmyter. I would like to remind you all to please state your name before speaking for transcription purposes and I would like to turn the call back over to Petter Rindforth.

Petter Rindforth: Thanks Petter here. Okay is there any new statements of interest? I see no hands up. So let's proceed to one interesting point two on the agenda, the update regarding possible legal expert consultation. And it was interesting to note that yesterday, you know, we had these small corporation group with IGOs, GAC and the GNSO representatives to discuss these related

questions. And to that group we - it has been discussions about possible new legal expert consultation.

And yesterday Jon Pessaro from OCED replied. And what - I think it's really interesting is that he said that he took a few days to consult with other members of the core group of IGOs meaning that at least the UN UPO will have the organization of WIPO. And first he made some comments that had been discussed on the fact that IGOs that have registered trademarks actually can use the current UDRP. And he stated that where IGOs, well the new jurisdiction and provision of the UDRP in fact prevents IGOs from using the UDRP. And let me refer to what has been previously stated from IGOs like the World Bank and then the United Nations. I know (unintelligible) on this aspect. But on the legal expert consultation they said that regarding the consultation of a legal expert my ideal colleagues share the OACD's concern that such an exercise will significantly prolong what has already been an extensive and resource intensive process.

In addition our past experiences with ICANN make us deeply concerned of such an exercise risk being manipulated against IGO's interests from the formulation of the research question, the selection of the expert and the choice of jurisdictions to their potential cherry-picking of language from the expert conclusions once a report is released.

We are grateful that you are trying to start a new less contentious chapter in this saga but hope that you understand why we are reluctant to embark down this path. So that's the initial note from this group that they as I read it they're not supporting an additional legal expert consultation. Let me say that if it's decided to proceed with that they would naturally expect that they IGOs would be involved in the formulation of research questions and the selection of expert in terms of reference guiding the expert's work and the choice of jurisdictions.

I want to say that please note already that a survey of five jurisdictions out of the 177 states brought this to the Paris convention seems unlikely to give any kind of accurate idea about the scope of mechanic states used to protect IGO acronyms.

So it's seems that basically there is no support for another external expert but if it's decided they will of course be more actively involved in that. And I was actually just going to pass over to Phil that also made some comments for less than an hour ago on this topic so please Phil.

Phil Corwin: Yes thank you Petter. And before I comment a bit more about that dialogue that's been going on on the discussion group email list so far as the work of this working group as you may have discerned from Petter's description it's really unclear whether this notion of engaging a new legal expert to see whether there's any legal bases for protecting IGOs names and acronyms other than trademark is going to go forward. I think the job for this working group is to continue doing what we're doing which is to review the comments and decide whether the comments we've received on our initial report merit any changes for our final report. And if this other legal group is established and if we're asked by the discussion group which includes the board members and if there's, you know, some indication from the leadership of GNSO Council that they'd like our - delivery of our final report to be delayed to for this work which I think realistically would to select an expert define the project and complete it would take you're talking six months to a year minimum I believe for the kind of very nebulous project they're talking about. We'll deal with it at that time but I think our responsibility is to continue doing our work.

So as far as our specific exchanges I did respond to (Jonathan)'s email with - I didn't make it personal but I took issue with his statement that the mutual jurisdiction clause of the UDRP prevents its use by IGOs and quoted the section of our report and the extensive footnote of all of the UDRPs that have been successful brought by IGOs that we took note of where they were not

prevented or were not sufficiently deterred. I took a very strong exception to his clear inference that we had in any way if this group tried to manipulate Professor Swain's work to come out in a certain way pointing out that those questions were prepared by with the assistance of staff and were modified, you know, in response to Professor Swain's request for clarification and that we were very careful in the review of the initial draft of this report to ask for clarifications but really leave it to him as to what the final content would be, not have a heavy hand on it and pointing out that had the IGOs joined our working group as members they would have had input into the wording of those questions in the review of that study.

And I have repeatedly emphasized that if they're going to go down this path of engaging a new legal expert that one I have great concerns about ICANN starting to design alternative dispute resolution procedures for laws other than trademark laws, trademark laws being kind of naturally implicated by ICANN's mission which is names and numbers. And it's the names part that implicates trademarks and potentially in domain name disputes. But I'm concerned that if this happens and other groups may come to ICANN and say we want a private right of action to correspond to this species of national law that species and it's not ICANN's job the legislature for the DNS. I've also said that if they're going to look at other legal basis and I'm dubious that any exist and that if they do exist no one's pointed them out to us where within the board small group calls for over 2-1/2 years. So they seem to be unknown to everybody if they exist but that they legal analysis should be restricted solely to laws that confer private right of action.

The UDRP is an alternative to bringing a trademark infringement suit where there's a private right and we shouldn't start creating alternative ICANN rights for schemes worth regulatory government enforcement and no individual right of action. And finally just this morning I forwarded the link that I had forwarded to this group the other day of the case that was published Monday by WIPO in which the tax authority of the United Kingdom successfully brought a UDRP to recover two domain names that weren't being used but

potentially could have been used in a phishing scheme or some other kind of scam so again as another example of successful use by sovereign entity of the existing CRPs.

So I think the last thing I'll say I think this whole dialogue has been useful for all the people in the discussion list because a lot of the things being said are familiar to us in this working group but frankly I don't think are as familiar to board members and GAC members who are on that discussion list. And they're starting to say that things are not quite as black and white as asserted by the IGOs when they find out the actual facts of the situation.

So I'll stop there and I think if anyone has comments for Petter and I on what's going on with that discussion group or how we should respond to it be a good time to speak up but otherwise the best thing to do would be to back to our work and move toward preparing a final report. Thanks.

Petter Rindforth: Thanks Phil. I perfectly agree that especially these latest comments also show that even from the IGOs point of view it's not perfectly clear that they want to extend their time back even more to add another legal expert to consultation. And that also I just before let George come to the phone, just wanted to also echo again what I said as I heard from WIPO before that they also they want to avoid any policies that will open up for also other name rights then apart from the traditional trademarks. IGOs is one thing but I mean there are all over the world other types of names that are protected and disputes around them some probably not be handled in the traditional domain name issue stating that the conclusion from WIPO from that was that they didn't want to add our recommendation in the present UDRP procedure but rather prefer to have a specific IGO dispute procedure. Yes George?

George Kirikos: George Kirikos for the transcript. Yes thanks to both Phil and Petter for the great work that they're doing representing our working group in that separate mailing list and working group. Question, I noticed most of the discussions on the mailing list in April and May have been in relation to the possible

consultation of an external legal counsel. However is there anything else in that working group going on that we should be aware of? Like I haven't gone through all of the transcripts of the phone calls or the audio but barring the, you know, the external legal analysis is there anything else that is happening that might impact our work? Thank you.

Petter Rindforth: Thanks George, Petter here. I would say that apart from the discussion about a legal, an extra legal expert consultation it has of course been some discussions back and forth on about radicle 6ter and why the proposed addition to the recommendations that we have cannot be accepted. And so but otherwise I can't remember on state line that they - right now at least points that we need to pick up for our working group. Mary your hand's up.

Mary Wong: Yes it is Petter and just from the staff perspective you're right that most of the discussions or any other discussions really wouldn't impact the work of this working group because they're primarily the other point discussed in relation to IGOs particularly in Copenhagen was in relation to the possibility of a sort of permanent watch service being established for them. That said, and as Petter and Phil will remember it's fortunate or unfortunate depending on your point of view that the discussions in Copenhagen took place on a Sunday evening and we were practically getting chased out of the conference hall. So I do not know if (Bruce) and the board members who participated will be intending to suggest that those discussions towards the end of the meeting could continue. And those discussions included the immunity and arbitration questions.

At this point we've received no indication from (Bruce) but I thought I should just mention it because that really is where the actual discussions left off in Copenhagen. We haven't seen any activity on the mailing list so it's just something that we will continue to follow-up on. Thanks Petter.

Petter Rindforth: Thanks Mary. And I - I'm not sure if there has been any further discussion from that topic within the council. Mary is that a new hand?

Mary Wong: Yes Petter did you - which topic did you mean? I'm sorry. I'm sorry I thought it was a question for me. I'll put it down.

Petter Rindforth: Yes, no I guess you said that we had some issues, some questions left from Copenhagen. And I don't - I'm not sure if - I haven't seen it in the working group but I don't know if Phil can say anything about if it has been further discussed within the GNSO Council?

Phil Corwin: I'm sorry Petter what's the question regarding the council?

Petter Rindforth: If - well as Mary said we had some questions left on the - this - I don't know whether it's the - on this second part, the arbitration and so has there been any further questions within the council about this topic in general apart from the possible additional legal expert consultation?

Phil Corwin: No not within the full council meetings. We're below the radar. Right now they're aware of the general status of where we are as a working group. You know, we did you and I had that call with the chairs and vice chairs of council to bring them up to date in much more detail on what's going on. There was some discussion of the possibility of this legal expert and how we should respond but if that occurs. But within the full council no they're just standing by waiting for us to complete our work.

Petter Rindforth: Yes thanks. That's also my conclusion that we are actually we have - they're free to continue to work and then see if there will be after South Africa if there will be a decision on another legal expert consultation. But let's proceed with our work as it is right now. Okay so that was the update on that specific issue. And I have to say that I'm not perfectly updated on how far you came last week but thanks. Here we have the summarizing rising of possible new facts and arguments. And I will say that we have discussed already if the support of suggestion to consultant an external legal expert. And I think we are - we

have agreed upon that we should just put that aside from our point of view and proceed with our work.

So at the point of lack of suitability of Article 6ter as a legal basis for standing. And we note that the US (unintelligible) we just said that this agreement between several GAC members including the US and the IGOs on whether Article 6ter provides a legal basis and led GAC to advance an alternative basis for protection such as the existing criteria for registration at the second level in the .INTA top level domain. And this is more of a historical summary. This approach was adopted in 2012 and has been the basis for progressive exchanges between GAC and ICAAN board culminating in IGO small group report.

And while the IGOs continue to disagree with the US and others over the interpretation of Article 6ter the IGOs in the US nevertheless agreed to disagree on the applicability of Article 6ter and to move forward on an alternative basis as is affected in the IGO small group report, the GAC is for the (unintelligible) protected negotiations with IGOs replacing that list with all IGOs that have complied with the requisite communication and notification procedure as set forth in Recommendation 2. Well I say it's a game changer in that at least some organizations that proclaim themselves to be IGOs in fact are not.

And as we have said before and I don't think we have done that and I'm not sure that we need a new legal expert on that but we may study it a little bit more Article 6ter to make sure of that it is in fact not just to send in an application that is stamped and accepted automatically. I presume that it is some kind of reflection on the basis for the applicant. And as we have concluded it is in fact an international legal identification and sort of name right even if it's not the same as trademarks. So I'm a little bit - and I don't automatically accept that using the registration, the registered names of Article 6ter is a game changer.

And then IPC says that they do not support using 6ter notifications as an independent basis for standing under the UDRP or URS, made a notification to WIPO that the entity is claiming 6ter rights does not provide a sufficient basis for standing to bring a claim. On the other hand the list assembled by the GAC has even more (tenuous) claims as the legal basis of standing while the list is the subject of extensive discussions between the GAC and IGOs was considered. But a small group it is far from clear what method if any was used for determining that an IGO has sufficient rights in its name to (could be) standing and be admitted to the list.

And that is also my personal point of view what I've concluded from that list. I haven't seen any specific acceptable national legal grounds for that list. I think it's more - it's practical for the purpose it was created for but now we're talking about something else. We're talking about a dispute resolution policy that will also be whatever solution we came up with in some cases will also be handled by local courts. Even if the court then decides that they can't handle the case the identification some kind of international, legally internationally accepted. And then we come back to Article 6ter.

And then we have the GAC GNSO facilitated dialogue suggest might consult external legal expert, yes. And that topic we have discussed. So do we have clear to make a conclusion on this topic? I was actually Phil thinking of you because I know that you have provided some amended wording where Article 6ter was one of the bases. I don't know if that's what you was going to rephrase now but please go ahead.

Phil Corwin: Yes thank you Petter. Phil for the record. Yes as I stated last week I think, you know, we're trying to help IGOs making it easier to establish standing by simply using the notification as a basis for standing to bring a UDRP or URS but in the tradition of no good deed goes unpunished we've gotten lots of pushback from IGOs and US government and IPC. So I will say I don't agree with the IPC criticism of the GAC list. I think the GAC list is the list that governments have agreed upon of what they regarded collectively as

authentic IGOs. So the fact that IGOs not on that list have asserted Article 6ter rights I think does raise a valid issue. And I think we'd be best served by scaling back on this recommendation and not having 6ter be evidence in and of itself of standing but have it be evidence in support of having common law trademark rights where there's no registered trademark.

It simplifies things. It brings - it gets rid of the pushback against using this as an independent non-trademark basis even though it's related to trademark protection for bringing these curative rights protection actions. It eliminates the need to give any guidance to panelists to look at the 6ter language in determining whether as a guide to bad faith registration and use in the context of IGOs names and acronyms and just puts everything right back squarely within the traditional trademark analysis. So I think we wind up accomplishing the same thing. We make it easier for IGOs to bring these actions by pointing out that their 6ter notification can be pointed to as strong evidence of a common law trademark right that is the basis for that action that would leave the whole issue of who's an authentic IGO.

I guess to the respondent if they do respond and they question the authenticity of the IGO or its trademarks they can bring it up as a legal dissent within the context of the action. So that would be my comment there. And I may have a little bit more to say after we get through the next one which is, you know, Number 2 here relating to our recommendation Number 3 which also relates to 6ter a little bit. But I'll stop there and see if other members of the working group have further views on scaling back Article 6ter notification from being an independent basis for standing to being strong evidence of common law trademark rights.

Petter Rindforth: Thanks. And I see Mary's notes have there's substantive test or relational of 6ter notifications. They are sent to member states who then deal with at according to their own individual laws. And as the USC comment notes that is not uniform.

And that's makes me sorry to say that but if we can't have Article 6ter as a basic identification if someone claims there to be a IGO don't registered by Article 6ter that will also give automatically a gray zone I suppose for some organizations stating that they are an IGOs when they might not formally be accepted as an IGOs. So we have to also identify something - some basics to identify a right IGO. Mary's hand was first.

Mary Wong: Thanks Petter and thanks for reading out the comment. It was just something that came out particularly through the US government comment that it demonstrates that even with a 6ter notification that's been communicated to member states it's not clear from that notification alone that the IGO in question would have any kind of rights whether that be trademark or some kind of unregistered right.

And my assumption when the group says common law rights they mean an unregistered trademark. So in essence what we seem to be saying is that the appropriate legal basis continues to be trademark if it's registered. Then this is not something we would even consider but some kind of unregistered right a.k.a. a common law trademark right.

So I think the disconnect here for us is about using 6ter to evidence that common-law unregistered right when we don't know just through that notification that there is such a right. There may be and there may be in a lot of cases but it may also be jurisdiction dependent. So that was our concern with using this list.

And on a related point but not exactly the same what we don't have in this extract from the USG comment is that the USG actually does conclude by supporting this small group proposal where the basis seems to be fraud or deception. So I think the wording there was where the third-party registrant is pretending to be the IGO or in some way carrying on active consumer fraud or deception. So to the extent that that's an alternative basis and that's something that may be part of that consumer protection discussion that we

had in Copenhagen I just thought I'd note that for the record for fullness.
Thank you.

Petter Rindforth: Thanks. And I don't think we have - we'll have time to come to that point this meeting but once we come to the suggested dispute, IGO dispute the solution procedure from 2007 I just noted that the identification there was a little bit different. It is initially stated that the registrational use as a domain name or the name or (abrogation) of the complaint and that has been communicated under Article 6ter of the Paris convention. So that is Paris convention we're talking about the part of that procedure that identifies applicable disputes.

But it also says that it - they make - states what this bad faith use could be. And one of the points is on the ground that the registrational use as a domain name or the name or (organization) of the complainant protected under an international treaty violates the terms of that treaty. So there I noted that it's not specifically referring to Article 6ter.

Obviously at that time the group that worked with this also considered that it could be other international treaties similar to Article 6ter. And it - once it come to that and to identify maybe we can use something similar. And I presume Phil has a specific suggestion on that. Over to you.

Phil Corwin: Well yes thanks Petter. Phil for the record. You know, I'd say the criticisms of Article 6ter had more weight when we were if we're going to say it just providing evidence that you've provided notification to WIPO gives you standing but if we scale it back to just being evidence that can be evaluated by the panelists of common law trademark rights still examine it the way they do any other claim of common law trademark rates. They can accept it or they can reject it. And also we can, again, we can provide guidance to the panelists.

We have in our charter clear authority to change the UDRP or URS if we believe it's necessary. We're not going that far but to provide guidance to panelists which they can follow to the extent they wish to, it's not binding. We have no enforcement mechanism it's perfectly appropriate. It's a much less intrusive form of into the current CRPs and changing any of their substance.

You know, I just think Article 6ter is the mechanism that the nations of the world have set up to for multiple purposes, one of which is to make it easy for authentic IGOs to protect our names and acronyms with national trademark law systems without having to register trademarks.

I don't think it can just be dismissed out of hand. It means something. The fact that a member state of the Paris convention or the WTO if not bound to accept an Article 6ter protect provided to a particular IGOs that's asserted it's right I don't think is determinative. We don't require a trademark owner to have a trademark in every nation of the world to bring a UDRP. They just need one trademark and one nation.

So the fact that an IGO may file a notification which most states and - or general understanding most states wouldn't implement that if they believe it's an authentic IGO. But if one or two don't accept it that would go to the evidence of a common law trademark rights and the authenticity of the IGO to be evaluated by the panelists.

So I think scaling back to evidence of common law trademark rights that can be evaluated by the expert panelists with some very nonintrusive guidance in our final report and which could be contested by the respondent where the respondent does file a reply is - satisfies any due process concerns. Thank you.

Petter Rindforth: Thanks Phil. Yes Petter. I agree. If we see Article 6ter as one possible identification of rights for something that is actually impractical then used as a trademark I don't mean already today panelists have to local legislation

national law on name rights that it's not specified as their trademark legislation but that our name rights that can be similar accepted as trademarks.

I mean apart from company names such that it's not accepted but there are a lot of name rights that in practical is actually used as trademarks. And there are also we cannot if we got - you don't need to have a registered trademark to figure trademarks rights and in a UDRP proceeding.

So if we - if you use Article 6ter as one example of such base it should be also I think more easy to show that than as it is today for some traditional trademarks to consider if that trademark if that name is actually protected by the very local in a small country somewhere in the world name rights. So it's not a new problem so to speak or issue for panelists to consider in the current UDRP.

Okay. And just the old chat there the example Phil gave to the mailing list today also felt it can be noncommercial or still be victorious in the UDRP. Mary?

Mary Wong: Thanks Petter. So staff had a question and I've tried to put in a note in some shorthand what Phil was saying. And we'll go back and check the transcript. The question we had is that if the group that's been on this call -- and then I think it's mostly the same group that's been on the last few calls -- feels that this is the proposal or the potential final recommendation it's going to make on 6ter what we can do is make notes of this and either now or when the time comes as determined by you Petter and Phil we can put that to the mailing list so that all other working group members have a chance to look at the specific language of the final proposal.

Petter Rindforth: Thanks Mary. Good suggestion. George?

George Kirikos: George Kirikos for the transcript. Yes just to comment slightly on Mary's note in the top left pod. I just want to kind of point out that IGOs don't have to rely just on the Article 6ter registration as evidence. They can also provide, you know, so much other evidence. They can point to press releases. You know, they can put - present, you know, archives of their Web site. There's all kinds of other evidence that they can use to demonstrate evidence of, you know, the unregistered rights to their name or acronym so I just wanted to make sure that that was clear. Thank you, just like anybody else can. Bye.

Petter Rindforth: Thanks yes. And I think that's what we have summarized that Article 6ter is one possibility. If you're an active IGO. You probably have the same set of issues, same examples as holders of unregistered trademarks. And as in all disputes you don't need to show that your name is globally well-known. It's enough to have to at least to start the dispute to have some kind of trademark related name protection somewhere in the world.

And if I don't see any thumbs down for Mary's suggestion I think it's a good idea to prepare a summary on this topic and send it out to the full list. And hopefully we can have some acceptance, full acceptance on that.

Okay good. I - looking at the Point B here I think it's we more or less have discussed this a (unintelligible) is there a way to scale back recommendation on 6ter or have recommendation that says use with 6ter to establish procedural standing but it must be coupled with a (staff) to legal right of some sort? That's more or less what we have concluded so far.

So I go to point two not appropriate to import Article 6ter into the UDRP URS jurisprudence. IPC stated that this would introduce an additional hurdle for IGO complaint not currently found in the UDRP URS cases. Not only does this appear to be yet another instance where the initial report has created a UDRP that is designed to fail this would open a door to importing this limitation into UDRP US cases that do not involve IGOs.

I would say that is more of an echo from what I heard from WIPO. And I think that if we - with the amended language that we have discussed we have sort of taken away the - at least at the main part of these obstacles because then we are still talking about more of trademark rights that are established by using marks that are also registered that Article 6ter names. And we're still talking about some kind of trademark protection.

I'll say George says perhaps we can scale back the recommendation to - "So that it applies only if Article 6ter is used for evidence." Yes it could be a possibility. That we have the OECD that Recommendation 3 unduly interferes with panelist decision-making and proposes an interpretation of Article 6ter. It does not enjoy consensus. Panelists should adjudicate the cases before them based on their interpretation of the applicable legal principles in the context of the facts at hand.

The proposed recommendation would unduly increase the burden of IGOs bringing cases in the UDRP. Again I don't really see that it would be the same burden as all complainants do have to actually show that they have a right and to identify themselves as the name holder. So and the World Bank say it's not clear that this recommendation even makes sense. Such a formalistic preliminary determination is not currently required for any commercial claimant before the UDRP or the URS and none should be imposed on IGOs. There's no reasonable or legal basis to attempt to use the Paris convention for something that it was never designed to.

The provision applies to the country, to the union, not to ICANN Article 6ter which was not drafted with ICANN or the UDRP in mind. No that's correct. And the - I would say no trademark acts in the world where also designated to domain names but it works as a ground.

My conclusion on these comments is again that if we use the amended identification that we have discussed it takes away most of negatives from these comments. I'll see if we have - if Mary says, "If 6ter is not the basis of

standing but merely evidence of standing there is no reason to incorporate the rest of 6ter into the UDRP is there?" I'm kind of not sure what you mean with that. Mary please?

Mary Wong: Thanks Petter and I think Phil is making the same point in the chat. If I recall correctly one reason why the working group included this recommendation on 6ter 1C was the awareness that in our original recommendation on standing there was a clear awareness that this would mean any IGO more than the ones on the GAC list could basically just use the UDRP. So this question of 6ter 1C was an attempt to not only relate it to the 6ter standing but to try and have some kind of scope limitation if you like.

If we're going to a recommendation where 6ter is evidence of a right of some sort just as other sources can evidence a right of some sort then it might be awkward or difficult to have 6ter 1C because then you are looking at the difference on the UDRP whereas you noted Petter that it's fairly broad in the sense of what panelists can look at in terms of applicable principles of law. So that was the point I was trying to make. Thank you.

Petter Rindforth: Okay thanks Mary. Yes and Phil also says the (unintelligible) of item Number 2 I'll avoid it if we just use 6ter as evidence of common law trademark rights. And I think that's where we are going to. It seems that, that can be actually a rather useful change of our recommendations.

Okay so let's proceed to the Number 4 recommendation, the positions. Well now we had so certainly and Richard Hill that's the reason why - yes George before we proceed yes?

George Kirikos: Yes George Kirikos. Should we have them be like checkmarks to see if everybody agrees on deleting that recommendation? Like I tend towards agreeing that it can be deleted because it's kind of redundant and that it's, you know, very consistent with the second and third problems of the UDRP, you know, showing bad faith but we probably don't want to proceed unless

we've heard from everybody else that's on the call whether we should or are we going to just put it on the mailing list to see that everybody concurs?

Petter Rindforth: I thought more or less...

((Crosstalk))

Petter Rindforth: ...a rephrasing of it. And then we send it out of course to the full list to have comments. Yes Poncelet? And Phil that's a new hand or...

Petter Rindforth: Yes. That's a new hand.

Phil Corwin: Yes.

Petter Rindforth: Yes could staff remind us of what is in Recommendation 3 before we discuss removing it? I'm not sure that the part that was commented on is the entirety of Recommendation 3. So can staff just remind us of what Recommendation 3 consists of because it's not quoted in the footnote?

Mary Wong: Hi Phil. Yes it's not and I you - remind us that we should probably include it as part of any sort of final recommendation or poll that we take off the whole working group. And I'm trying to pull up the report now but as I recall Recommendation 3 has to do with the other prongs of the UDRP in terms of the substantive grounds. And it basically mostly would have to do with the bad faith topic that in that regard, particularly 6ter 1C which talks about the deception issue and the connection to the IGO that should be something that the panelists take into account when deciding bad faith. Let me pull up the document. I'll paste it in the chat but I think overall generally that seems to be what we were concerned about in Reg 3.

Phil Corwin: Yes hold on. I've got the document open in another tab. Let me - if it will cooperate maybe I can okay come on. Okay Recommendation...

Mary Wong: Okay I think...

Phil Corwin: ...3 no specific changes no substantive grounds during the UDRP URS upon which a complaint and may file and succeed on a claim. Working group proposed a policy guidance document could have further recommendation the panel should take into account the limitation enshrined on Article 6ter and determine whether registrant has - yes I would say we would keep the first part of the recommendation that we don't recommend any specific change. I guess we don't have to say it but it's already there. There's no harm in saying we don't since that was a specific part of our charter and drop the second part which was the guidance to panelists which now becomes unnecessary if we turn Article 6ter into mere evidence to be evaluated by the panelists of common law trademark rights. Everything is brought squarely back within the traditional trademark framework of the UDRP.

And there's no need to look at that language of 6ter by a panelist who would see when they're trying to determine bad faith registration and use its analyzed just as it's always been in the trademark context. So my recommendation would be that we keep the first sentence of 6.3 noting that we're not recommending any UDRP or URS policy changes but - and drop the second part.

Petter Rindforth: Thanks Phil. Yes sound like a good solution. And if you say it could be good to keep the first sentence just to be clear that we are not proposing any changes. So in - it's another group working on that topic that will be considered in - well in the near future in a couple of years. So Mary?

Mary Wong: From the staff I guess we just had an observation and a suggestion because if we do indeed move towards this different reliance on 6ter then we're not actually recommending any change to the UDRP or the URS at all. It seems that maybe we could have one recommendation that is very specific about how 6ter can be evidence. And as part of that explanation we basically say

this in no way changes any of the substance or any of the prongs or grounds of the UDRP or the URS.

I just I say that simply because by retaining the first sentence it's kind of a non-recommendation. And looking down the road to implementation -- and Dennis from GDD is on the call -- it may be awkward if we have a recommendation that doesn't have to be implemented basically. So my recommendation is to bundle that in some way into or as part of the explanation of the 6ter as evidence recommendation. And of course we can develop the language as we go along.

Petter Rindforth: Thanks Mary. Yes I understand that and sorry I don't have that document in front of me but as I understand from you it's not mentioned in any other part of the other recommendations. So if that's the only part where we make some statements on how to read Article 6ter as a base that's one of the basis for filing a dispute then that to say let's rephrase it in that way.

Well Phil says that's the change in oral statement I made a few minutes ago yes, okay. Good. Okay then we have the Recommendation 4 of a case in court. And George says or we can rephrase it, firmly recommend that the three-pronged test be used. Okay opposition to Recommendation Number 4 where Richard Hill stated that the recent (way) in arbitration court rather than the national court is appropriate in the case of a claim made by an IGO regarding its name of being exposed many times. Basically it's not appropriate for IGOs to litigate matters in national court. Litigation regarding IGO normally takes place in an arbitration court for what concerns commercial matters.

IGOs have stated that deeply and for many years that they are unable to use the present UDRP because it requires them to waive immunity of jurisdiction which they don't wish to do. Some people disagree with this position and think that IGOs should agree to waive immunity or find some other means to use the existing UDRP.

Okay so conversely if there's anything on number of such abuse of registrations then surely consumers should be protected and a UDRP like process that the IGOs can and will use should be created. And GAC says that the working group suggestions are a form of work around is incompatible with the position conveyed by the legal counsel for IGOs which was provided to the working group as its request.

And there are three reasons provided by the - (unintelligible) the first the working group incorrectly restates the immunity tests proposed by its own legal expert Professor Swain and secondly the working group may surprise with incorrect test by applying an inappropriate legal standard. The working group's proposed remedy for IGOs concern about the immunities entails a complicated legal workaround which could undermined both an IGO immunities and its ability to affirm its rights in its own name. And it also states that we have incorrectly restated the functional immunity test provided by Professor Swain. And they say that the tests ask whether in a UDRP proceeding the third parties infringing views would be found to impede an IGO's ability to carry out its core mission.

They also said that Professor Swain stated that a function of immunity analyzers would typically look to whether immunity concerns, activities immediately or directly related to the performance of task is due to the organization. This is an important distinction. The immunity analyzes a state that Professor Swain does not focus on the potential legitimacy of the third parties claim or on whether the third parties use might interfere with a IGO's core mission, et cetera, et cetera.

It's important to remember that this analyzers assumes a core which interprets IGO's immunities narrowly. Even using the strict test Professor Swain found that IGO's immunity claim is likely to prevail. And second a working group applies an impossible to obtain standard to the test it devised. It established a (threshold) legal certainty which will be satisfied only if it can

be demonstrated that all court will necessarily find that an infringing registration impedes the IGO from carrying out its core mission. However a legal certainty threshold is impossible to fulfill on virtually any issue. I'm going to refer to Professor Swain's conclusion that a IGO's assertion of immunity under the circumstances in question are likely to prevail to be more than sufficient to justify culminating these immunities in ICANN dispute resolution mechanism.

If I take that first because the next comment is the possibility to file complaint through so like of your agent. So what can we say here? We as I seen from Professor Swain's support it's - and I can agree with that concern also that that's a fact that taking the case to a court depending on the nationality and the face of the court there will be different solutions.

Some courts will obviously as Professor Swain had pointed out saying that the IGO has not any immunity in that specific court and that it can take the case and other courts will just kick out the case referring to the - these statements or the statements of the IGOs. But again if we have a separate second phase with panelists dealing with the - with a case there is no - there's actually still a risk or a slash possibility the other part will take the case to a national court. And then again the court will decide in different ways. Phil?

Phil Corwin: Thank you Petter. I make a couple of statements here. Number one I'm usually very supportive of staff but as we go through this document I frankly I find it unbalanced. We see a calm opposition to Recommendation Number 4. I don't see any summary of all the comments that were filed that were strongly in favor of Recommendation Number 4 that supported preserving the right of de novo appeal to a court of mutual jurisdiction.

I know the business constituency filed one. I know the Internet Commerce Association filed one. I know George Kirikos filed, I know, lots of parties filed one. So we're seeing here number one just opposition with no

counterbalancing summary of the support for our recommendation. And second frankly most of these arguments are not new. They're arguments we heard throughout the process. They selectively quote from Professor Swain's memo the part that supports their position without - while ignoring other parts where particularly that part where he said that for the benefits of a less expensive and much faster arbitration process it would not be unreasonable to require a waiving of immunity which is not something we've done. We don't go that far.

So I'm - I think the more Recommendation 4 the more important debate is going to be what happens if the IGOs asserts immunity in the subsequent appeal, de novo appeal and succeeds on that argument, what happens with the UDRP decision? Is it initiated or does it go forward to be heard in arbitration forum? But I frankly I don't see this summation as being properly balanced. I don't see most of these arguments as being anything we didn't consider in formulating the initial report. And this working group after much deliberation decided that it was not ICANN's place to predetermine what the decision of a judicial forum would be on the immunity question and that it was inappropriate for ICANN to do that and that it was inappropriate for ICANN to deprive domain registrants of their existing legal rights under relevant national laws.

So, you know, I think frankly unless there's an up swell in this working group to change its mind on the most basic issue and to decide that we're going to eliminate right of appeal to a court of mutual jurisdiction which was the whole justification for IGOs seeking a separate process to avoid the mutual jurisdiction clause of the UDRP there's really not much needed to discuss any of this further. Our time would be better spent on the Option 1 and 2 question where we did get comments and there was some way to - of comments of those who commented in favor of Option 2.

Let me say two other things one on the issue of asserting immunity. It's clearly the thrust of our initial report that that question should not be decided

in advance, the question of whether an IGO has or has not immunity from a judicial proceeding. It's up to the court. And I think we should in our final report make some statement for the guidance of courts in such situations something that IGOs can point to that it's our intent that the court determine that question independently using based on its own national law and its own analytical method and that an IGO's compel descent to the mutual jurisdiction clause should be reviewed as something which they commit to from appear in that forum if an appeal is brought by the registrant but not one that strips them of the right to assert their legal defense of immunity just as no party is stripped of any of its rights to assert legal defenses in any subsequent court case.

Also in regard to Option 1 and 2 I just want to state for the record that I had a role in drafting the statement of the Internet Commerce Association which favors Option 1. I also had a role in providing input through the statement of the business constituency which favors Option 2. So I'm either completely conflicted or totally neutral on that question but I do understand both sides of it very well. And I just want to get that on the record so as we get into that further discussion no one thinks I'm pushing one point of view or the other since I had a hand in the drafting of comments with opposite positions on that very important question. Thank you very much.

Petter Rindforth: Thanks Phil. And if I (pose) to summarize what you're stating is that if there is a problem that it cannot be solved by us or ICANN that has to be dealt with in a court and where the IGO taking the case to a court or have the case to a court is free - are free to state their jurisdictional immunity. And then it's up to the court that handle the case to decide which will go in some ways in favor of the IGOs and in other ways consider that the local court can actually deal with the case.

And that having said that the - it's not so many UDRP cases actually taken to a court and there's even less percentage of them that where the cases have

been dealt with in another way then the decision of the UDRP if the decision was to transfer the domain name. Mary?

Mary Wong: Thanks Petter and thanks Phil. I should say it's not just you're normally supportive of staff you are always amongst the most supportive of staff and we thank you for that. So it's just a note and I think George has type the same thing in the chat that this document really was just meant to extract some of the potential new arguments. And it may be as you say Phil that some retread ground we've already trodden.

I will note that in an earlier discussion the group had parked the reasons that OECD had given and once we actually started looking at those three reasons and putting into this table it became clear to us that, you know, this whole section needs to be kind of considered in its entirety and in relation with the possibility of a separate DRP because there were comments that brought in arbitration into the separate DRP issue as well. So basically our intent was to have this document not replace the public comment review tool where all the viewpoints we hope are represented but to be read alongside it possibly because there may be some new facts or arguments that came through some of the comments. So hopefully that's helpful and thanks very much.

Phil Corwin: Yes and just to jump back in and I know George is waiting yes that's fine Mary and it's on for - the Adobe chat room does not allow us to display the full public, document and this document simultaneously. So let me pull back a little on what I said a few minutes ago.

But the important thing is to remind everybody that our report overall had very substantial support, the initial report from a wide variety of parties including both entities in the contracted party side of the GNSO Council. The registries and the registrars had strong support from the BC had strong support from many other private parties and trade groups. So when we're looking at the criticisms we've got to keep the criticism in context. And as we look forward to the - to ultimate council consideration of our final report we can be fairly

confident that we're in pretty good shape with again both the registries and the registrars in strong support of our original report and support from the BC.

I don't know how some of the other groups, the IPC has some criticisms. The other groups in the non-contracted side didn't go on the record but knowing their usual positions I'm not very worried about this report getting council approval as it goes forward kind of in the amended - the form we seem to be heading toward without prejudging our final decisions. So I'll stop there and return the gavel to Petter and he may want to hear from George now.

Petter Rindforth: Well that's yes that's immediately give it over to George.

George Kirikos: Yes George Kirikos for the transcript. Yes I was going to make the same point that Mary made and Phil could - agreed with. Just going back to the actual comments that we see in the document I think the comments of Richard Hill, you know, they're not necessarily ones that we haven't already discussed in the working group before like, you know, the issues, you know, should we stand on principle or should we be more pragmatic? You know, what's the harm if you allow only a small number of cases to be ruled by this new DRP. Though I think we need to take a principled stand that those are actually the cases that do tend to go to court, the ones that are the more, you know, most valuable demands the two and three letter .coms where there is a real dispute over, you know, whether the UDRP panelists or the URS panelists made the right decision. So we shouldn't be depriving those domain registrants of appropriate relief in their national courts compared to arbitration which can be, you know, the forum where the problem was caused in the first place but albeit, you know, it may be new panelists but it's still an area where all of the jurisprudence might not be as developed as in the national courts.

As per the OECD comments I think the OECD rep, you know, and in that small group we - if we see - if we go back to those comments that we saw in that separate mailing list which I linked to before it seems that they're working under some, you know, misinformation and they seem to be kind of, you

know, repeating that misinformation. And then Phil and Petter kind of countered them on the mailing list appropriately.

We've seen, you know, them actually using the UDRP and winning. And so it's like they talked about how, you know, preventing their use and, you know, and it's simply incorrect. In the analysis that they presented and I don't think Professor Swain, you know, got it wrong or the parts that they're picking up from his arguments actually support their case at all because I think, you know, our own conclusions are fully consistent with those of the Professor Swain report.

And I think the broader question is, you know, should we be creating a brand-new law which we would be doing if we created a separate DRP. And that's a something that, you know, we should be, you know, willing to do because otherwise it would totally, you know, it would be unprecedented. It would be transforming ICANN into its own separate judiciary which I don't think anybody supports - well some people on extremes might support but we shouldn't as a working group support. Thank you.

Petter Rindforth: Thanks. And I can note that when it comes to Option 1 I note both from 6ter and BC that they basically support Option 1 but also state that it should be further considered and we should listen to what IGOs point of views. And the BC constituency says that if we take Option 1 then it will be extremely important that its eventual implementation rest upon carefully balanced selection of an arbitration forum and applicable rules for the de novo determination. We also say that Option 1 would effectively be compel an IGO to waive its potentially valid claim of jurisdictional immunity. The BC remains open to the input on affected IGOs on this matter.

Well I would say the if I would say - if I say it's a problem. But it's what makes that a little bit unclear as that what we're hearing from a place most IGOs is that they prefer Option 2. So if we take these recommendations to even if Option 1 seems to be the best one and the most known by also traditional

trademark users and domain name users if IGOs actually if there is a majority from the IGOs of Option 2 well we have to consider that. So I want to hear some comments, some further comments on Option 1 or Option 2 here.
George?

George Kirikos: George Kirikos for the transcript. Yes I'm firmly in the Option 1 camp that you need to preserve the people's right to go to court. That's their, you know, fundamental right that would be stripped if we went with Option 2. I don't support the analysis that they provided that it's, you know, very familiar or that, you know, some of the registrant agreements support it. It's not all registrant agreements that supported.

And it's also, you know, to use an example of where a party voluntarily contracts with a IGOs that they knew what they were going into. And so it would - it's a big leap from that situation to the situation we're presented with here where a totally unrelated party have a dispute which the IGO initiates. I mean IGO wants to select the forum for that dispute that's totally uncalled for. And so I think Option 1 is the most natural one that we should support.

Also for option - yes I'll just stick with that. I see Phil has hand up. Thanks.

Petter Rindforth: Thanks. Yes before Phil I give it over to Mary. Are you on mute Mary?

Mary Wong: Petter I'll seed to fill.

Petter Rindforth: Yes Phil?

Phil Corwin: Okay first comment on this forum. I would like to see this document. Right now we have a list of support for Option 2 and quotes from statements. There's nothing about support for Option 1 and those views are new as well. There's simply a footnote to the box that's sort of emerging for Option 2.

There's a footnote which briefly sites some support for Option 1 and doesn't even include a reference to the ICA statement which I was involved with. So I'd like to see this document to have a box on support for Option 1 just for the sake of historically of having a correct document when we reconvene in the future.

On the - having been involved both drafting the ICA statement and the BC statement which we take opposite views I'm comfortable with the analysis which leads to support for Option 1 that if you didn't have a - if you're going to - if you win the UDRP and are going to try to deny the registrant a right for a de novo hearing in a judicial forum by asserting immunity and trying to - and we want IGOs to be able to (unintelligible) immunity. That's the whole thrust of our document that their immunity should be decided by individual national courts not by ICANN in advance I see the logic to that.

I would say there is an equally reasonable rationale for Option 2. And I would say within ICANN internal politics I think that if we recommend Option 1 it will have a very difficult time surviving after we complete our work. I think it will be subject to rather strident criticism within counsel and certainly there'll be very harsh GAC advice to the effect that the board will have to consider to the effect well you've really put IGOs in a position of, you know, heads you lose, tails I win and that if they assert their immunity and prevail they're left without a remedy even when the initial UDRP panel has found cybersquatting going on.

Now we all know that UDRP panels sometimes make mistakes that there have been reversals in national courts of initial UDRP decisions. So that the UDRP decision is not 100% determined but politically I think the position that an IGO that wins the UDRP is brought into court successfully and successfully asserts immunity winds up with nothing and the cyber-squatting that was initially found can - is allowed to continue. It's going to be a very tough sell going forward.

But if we do go for Option 2 I would say further we're going to have to have some more detailed discussion of how that should proceed. It would be my view that WIPO would not be a suitable forum for hearing such cases. It would be perceived as having perhaps a conflict of interest being an IGO. So we may need to discuss what's an appropriate forum for this? And ICANN has used other dispute arbitration providers and other contacts for the - for various dispute procedures under the new TLD program. We could look at those. And we're going to have to look at we had talked in the past about using the (UNSA) Trail rules what we need to settle on some set of rules.

So sum it up I see the logic of Option 1. I think within ICANN's internal politics Option 1 faces a very difficult future that Option 2 would be the way to go if we want to protect the overall report from greater criticism. But as we go to Option 2 we're going to have to spend time deliberating proper form and proper rules for any such arbitration.

And in all of this we need to remember that the percentage of UDRP cases that are appealed is extremely small. And we have no way of knowing in what percentage of those that are appealed that involves IGOs they would be able to successfully assert immunity. We're simply trying to preserve the right of the judiciary to make that determination. And I'll stop there I see George's hand up. I'm sure he has some comment on that.

Petter Rindforth: Thanks Phil. Petter here just say two words about I was also assisting in (unintelligible) as was stated I think Option 1 is the most practical from a traditional trademark point of view and also considering the registrants and the demand holders. But as (Ralph) indicated we have to listen also to IGOs in this case and to come out with a proposal that can be more acceptable for also for IGOs. It seems that Option 2 is the one that we should work further on. George a quick note and then I hand it over to Mary for the final comments.

George Kirikos: George Kirikos for the transcript. I know we're get - we're a little bit over time so I'll be brief. Just for Option 1 we should point out though that we only get Option 1 under very rare circumstances. And those circumstances even start where the IGO brought the case themselves. You know, if we - we've already kind of steered people towards the fact that there is that work around where they could bring the case through the agent licensee or signee. And perhaps we should be more vocal but even the national authorities themselves can be the initiator of the dispute like if there's some consumer protection agency in Australia or whatever they can bring the case for the World Health Organization under that, you know, scenario that Bruce Tonkin raised.

So if we make it clear that, you know, the IGOs do have the ability to get that release even under Option 1 because, you know, the national authority obviously fight the case all the way through. So it's not as though the procedure can be gained by the registrant, you know, there would still be justice for the IGO. It just needs to be, you know, a properly - proper path through the system that we're proposing.

Also if we do get down the Option 2 route which I, you know, vehemently disagree with we should perhaps consider grandfathering all existing registrants so that people that are, you know, not willing to agree with the system know that they don't have to go that route. You know, they would still have the protection of the national courts but that those who are going to be affected by, you know, binding arbitration know about it going into the registrations.

So for newly created domains perhaps Option 2 could apply. But for all existing domain names, you know, going by the creation date so even if they changed ownership it would still go by the creation date. They would gone under the option number one where they could definitely have, you know, full recourse national courts because I think the IGOs are really pushing these kinds of DRPs because they were worried about, you know, cybersquatting in the New gTLDs which we haven't really seen.

But that's been there, you know, there means of, you know, trying to get this through the ICANN system because they've wanted the subsidy since the 1990s and been completely rejected. So if they're really concerned only about New gTLDs then we should only apply it to either New gTLDs or to freshly created domains and grandfather them...

Petter Rindforth: Okay.

George Kirikos: ...the existing (unintelligible) thanks.

Petter Rindforth: Thanks George. Mary's hand is down Steve's up.

Steve Chen: Thanks Petter. This is Steve Chen from staff. And I had a real quick comment about ICANN 59. Staff has put in a request for a tentative slot. Right now it's scheduled for 27 June which is a Tuesday local time it's 10:30 to 12:00. I believe currently it's across from an RDS session but I just wanted to let the working group know that there is a session request for ICANN 59. Thanks.

Petter Rindforth: Thanks, excellent. And thanks all for today. See you...

Phil Corwin: Whoa, whoa.

Petter Rindforth: ...so to speak next week. Yes.

Phil Corwin: Yes on next week - this is Phil can you hear me?

Petter Rindforth: Yes.

Phil Corwin: Yes. Next week I have to - I want to talk about next weekend and the week after. Next week I apologize for this. I just realized this looked on my calendar for next week. I made - I need some dental work. And I took - I had - it's one of these things where you had to schedule it like more than a month in

advance. And my appointment is scheduled for 1:30 Eastern Time next week which would be the end time of our call.

I scheduled this when we're having 60 minute meetings before we went to 90 minutes. So I can be on next week's call for the first hour and even chair for the first hour. But I'm going to have to leave at about that one hour mark. So I wanted to note that right now the call on Thursday the 11. And then on Thursday the 18th I'm really not sure at this time whether I'll be able to participate in the call.

Petter Rindforth: Same here.

Phil Corwin: Yes. That's the day I'm leaving for the INTA Meeting in Barcelona. I have a two hour GNSO Council call that morning. And I have to leave mid-afternoon for the airport so - and I'm usually running around like a crazy person on the day of departure for a long meeting with last minute details.

So - and it sounds like Petter has the same problem on the 18th. And that also would be a problem on the meeting of the 25th. Well that's the day after the INTA meeting and people will be traveling back from that meeting that day. It ends the evening before.

So I know a lot of working groups are not having meetings that week because of the INTA annual meeting which gives thousands of participants many of whom are active in ICANN groups. So we're fine for next week other than I'll have to drop off of the first hour but we may not have a meeting for a week or two after that which...

Petter Rindforth: Yes as Mary said do you want to propose a break for 18th and May 25. Unfortunately I think it's - it will be necessary for practical reasons.

Phil Corwin: Yes. I think because of travel to and from the INTA annual meeting we're going to have to do that. That's unfortunate. It's going to push back our work

by two weeks. And may make it unrealistic for us to have a final report ready pre-Johannesburg though I think we can be very close. But we just have to deal with the reality of the calendar and competing demands on our time. So my answer to that question would be yes. And yes of course we can continue to...

Petter Rindforth: Yes.

Phil Corwin: ...do some of the work by email.

Petter Rindforth: Definitely. Okay good so again if you can maybe with us for 45 minutes next week but as we then will be off for a couple of weeks even if we have email correspondence in between I think it's good to do a further update and meeting next week. Thanks for today.

Phil Corwin: Okay, bye all.

Woman: Thank you very much.

END