

**Via online form submission**

24 October 2021

Mr. Chris Disspain  
Chair of the EPDP Specific Curative Rights Protections for IGOs  
% ICANN  
12025 Waterfront Drive, Suite 300  
Los Angeles, CA 90094-2536

**Re: Comment by Namecheap, Inc. regarding the Initial Report from the EPDP on Specific Curative Rights Protections for IGOs**

Dear Chairperson Disspain and Members of the EPDP,

Namecheap, Inc. (“Namecheap”) thanks ICANN for the opportunity to provide a comment on the [EPDP on Specific Curative Rights Protections for IGOs](#) (“Interim Report”). Namecheap believes that the multistakeholder model (“MSM”) of developing policy is one of the most important aspects of ICANN. This Interim Report, however, is not representative of the MSM. It does not consider the interests of other ICANN constituencies, it is biased in favor of trademark owners and arbitration providers, and ignores domain name registrants completely. It seeks to create new trademark rights for IGOs, anticipates costly arbitration that registrants cannot afford, and attempts to circumvent the UDRP and URS. The Interim Report also fails to consider many examples of IGOs filing (and winning) UDRPs, and as such, is a solution in search of a problem. Namecheap strongly urges the EPDP team to reassess and modify the recommendations in the Interim Report in light of the comments from Namecheap, the Registrar Stakeholder Group (RrSG), and other ICANN community members opposing these recommendations.

The EPDP team’s proposed solution exempts IGOs from the UDRP and URS Mutual Jurisdiction requirements and gives IGOs the option to waive (or not) judicial immunity at its own choosing in favor of arbitration. As currently proposed, the EPDP team’s recommendations could potentially force registrants into costly arbitration under foreign law in order to exercise their right to review/appeal a UDRP or URS decision. As such, the EPDP’s recommendations confer greater rights upon IGOs than non-IGO registrants, in direct violation of ICANN Board’s instruction that “protections for IGO names and acronyms cannot result in a broader scope of protection than is available under international treaties and national laws, including intellectual property laws.”<sup>1</sup>

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<sup>1</sup> <https://www.icann.org/en/system/files/files/resolutions-icann71-gac-advice-scorecard-12sep21-en.pdf>

Specifically, Namecheap's concerns about the Initial EPDP Report Regarding IGOs are as follows:

**I. Exempting IGOs from Mutual Jurisdiction Violates Fundamental Aspects of the UDRP and URS and Creates Broader Rights for IGOs**

Section 3(b)(xii) of the UDRP Rules and Section 3(b)(ix) of the URS Rules require that a Complainant, with respect to any challenges to a decision in a UDRP or URS proceeding, submit to the jurisdiction of the court in at least one Mutual Jurisdiction which is either (1) the location of the principal office of the Registrar or (2) the domain name registrant's address used for registration of the domain name. The clear purpose of this rule is to protect a registrant from the application of foreign law to which a registrant has not and does not submit to as a jurisdiction. Further, the secondary purpose of the rule is to protect a registrant from the obligation to litigate in a forum to which there is no connection. However, in Recommendation #3 (i) and (ii), the EPDP team proposes that IGO Complainants be exempt from the Mutual Jurisdiction requirements of the UDRP and the URS.

Through this exemption, the EPDP team is inviting IGOs to exercise legal dominion over unsuspecting or unsophisticated registrants. Indeed, the EPDP team acknowledges this fact under Recommendation #6 (ii), suggesting that if an IGO does not have a satisfactory cause of action in the registrar's principal office or the respondent's place of residence, the arbitral tribunal might determine the applicable law. As a result, an IGO could assert a substantive cause of action against a registrant entirely unknown to the registrant when it registered the domain name, creating obligations far exceeding those to which the registrant chose to accept. Stated differently, this is an open invitation for IGOS to forum shop with a direct adverse impact to registrants

Moreover, a non-IGO complainant would not have this jurisdictional freedom in enforcing its rights against an IGO. The inherent inequity in the EPDP team's recommendation is apparent from its Note on the subject, recognizing that insufficient causes of action in a registrant's Mutual Jurisdiction would be a concern for all UDRP complainants, not just IGOs. Thus, by exempting IGOs from Mutual Jurisdiction, the EPDP is expressly advocating that IGOs have broader protection for IGO names and acronyms than those of non-IGO registrants.

In addition to clarifying these concerns regarding mutual jurisdiction, the EPDP team should affirmatively state in the Final Report that registrants will continue to be able to file court proceedings as currently enshrined in the UDRP and the URS. Failure to do so would erode a fundamental (and long established) right of domain name registrants.

**II. Voluntary Arbitration Creates Unfair Advantages for IGOs**

In addressing how a determination of rights might be reviewed or appealed in a jurisdiction where an IGO enjoys immunity from suit, the EPDP team has recommended arbitration as an alternative to judicial review. Recommendations #4 and #5 suggest that when filing a complaint, an IGO complainant would need to indicate whether it agrees that the final outcome

of a UDRP or URS proceeding would be determined through binding arbitration. As an initial matter, Recommendations #4 and #5 assume that an IGO complainant will participate in the UDRP or URS proceeding when seeking a determination of its rights, an option that is not mandatory.

More fundamentally, the EPDP team has expressly stated that arbitration would only apply if both parties agreed to it, but the recommendations are silent as to what would happen in the event that the IGO complainant does not agree to binding arbitration. Under the current scheme, if a non-IGO files a UDRP or URS complaint and wins, a registrant-respondent has the right to seek judicial review of the UDRP or URS determination in a court of Mutual Jurisdiction.

However, because an IGO may be immune from suit in a court of Mutual Jurisdiction, the EPDP team has suggested that arbitration take the place of judicial review, but only if both parties agree. Thus, if an IGO files a UDRP or URS complaint against a registrant and wins, a court may not exercise jurisdiction over the IGO, and if the IGO does not voluntarily agree to arbitration, then the registrant will be left with no opportunity for judicial review at all. This obvious loophole could result in almost no oversight or regulation of IGOs in exercising intellectual property rights for domain names. Moreover, these recommendations, if adopted, would amount to a due process violation with respect to the rights of the registrant, who would be deprived by the IGO of their otherwise available review/appeal rights where the UDRP is decided in favor of the IGO. On balance, a prevailing registrant would not be able to equally prevent an IGO's exercise of its appeal rights. Such an anti-registrant result cannot possibly be an acceptable objective or result under the ICANN MSM.

Moreover, Section 4(k) of the UDRP confers an express right to submit a dispute to a court of competent jurisdiction. Indeed, if ICANN adopts the EPDP team's recommendations, IGOs would have near complete control over the manner in which a dispute is resolved and/or reviewed. When laws of Mutual Jurisdiction are favorable to the IGO, it could waive its immunity and file suit in court. If unfavorable, the IGO could submit to arbitration under a different set of laws, for which for a registrant could be prohibitively expensive, particularly in a loser pays scenario. Worst case, in a situation where the IGO has received a favorable ruling from a UDRP or URS proceeding, and will enjoy immunity from court jurisdiction, the IGO could simply refuse to arbitrate, leaving the registrant with no available recourse.

The recommendations are additionally silent on whether the IGO complainant can file binding arbitration if the registrant-respondent wins. The right to appeal a UDRP or URS proceeding currently is reserved solely for the registrant-respondent (and should remain as such through the current court proceeding process). The specter of losing IGO complainants appealing a UDRP or URS is chilling, and represents a substantial threat to the rights of all domain name registrants. This would create additional uncertainty regarding the rights of domain name registrants, and provide an additional avenue to attempt reverse domain name hijacking.

Finally, the potential costs associated with the proposed voluntary arbitration process will significantly prejudice registrants. Although the Initial Report does not provide any specifics

regarding the arbitration process, it identifies four arbitration providers as examples for rules and processes. Although Namecheap has not conducted a detailed review of the fees and attorney costs associated with these arbitration providers, they are likely to be significantly more than most domain name registrants can afford (except for large corporations). One provider requires over \$40,000 for a hearing<sup>2</sup>, and also specifies that the losing party must pay all costs of the prevailing party. It is shocking that an ICANN working group would suggest an appeals process with staggering costs, and due to the unrepresentative nature of the EPDP's composition, it appears no one on the EPDP identified this as a concern or result in significant harm to registrants. While these costly arbitration procedures may be accessible to well-funded IGOs, the proposed appeals process would ensure that no registrant could participate due to the staggering costs.

### **III. IGOs Already Utilize the UDRP**

Although the Interim Report cites a report from an external expert regarding the need to resolve concerns regarding Mutual Jurisdiction, the EPDP apparently completely ignored the fact that IGOs have filed and prevailed in UDRPs. This information was available to the EPDP (e.g. as detailed in footnote 5 on p.118 of Final Report on the IGO-INGO Access to Curative Rights Protection Mechanisms Policy Development Process<sup>3</sup>), and additional research by Namecheap identified approximately thirty UDRPs filed by IGOs (see Exhibit A). It is likely that this number is higher due to search limitations. IGOs have additionally filed more UDRPs, which demonstrate that these organizations are already able to sufficiently utilize the UDRP. It is not clear why such drastic recommendations are necessary, when it appears that IGOs already utilize the UDRP regularly. Unless there is a significant problem that will greatly impact the DNS, it is best to focus ICANN's limited resources on more important matters (rather than making it slightly easier for a small number of IGOs to trademark rights).

### **IV. The Recommendations of the Interim Report Appear Biased in Favor of the EPDP Members and Exceed the Charter**

The members of the EPDP are not representative of the diverse interests of the ICANN community. It does not appear that any of the EPDP members are from the RrSG, the gTLD Registries Stakeholder Group (RySG)<sup>4</sup>, or the Not-for-Profit Operational Concerns Constituency (NPOC). As a result, the recommendations favor the participant groups of the EPDP, to the detriment of the unrepresented groups, and above all, domain name registrants. It should be expected that when certain groups are not represented in an ICANN PDP, recommendations

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<sup>2</sup> <https://icsid.worldbank.org/services/arbitration/uncitral/fees>

<sup>3</sup> [https://gnso.icann.org/sites/default/files/file/field-file-attach/igo-ingo-crp-access-final-17jul18-en\\_0.pdf](https://gnso.icann.org/sites/default/files/file/field-file-attach/igo-ingo-crp-access-final-17jul18-en_0.pdf)

<sup>4</sup> Namecheap notes that the Chair of the EPDP, Chris Disspain, began providing consulting services to a registry during the EPDP. However, as the Chair role is intended to be neutral (see <https://gnso.icann.org/en/basics/101/wg-chairs-guide>), the participation of Mr. Disspain cannot be considered as an advocate for RySG interests.

should be drafted to consider those not represented on the PDP. This, however, does not appear to have happened for the Interim Report. Trademark attorneys and arbitration providers were represented on the EPDP whereas domain name registrants were not (via the RrSG or RySG), and the resulting recommendations skew in favor of trademark rights protection and increased arbitration for domain name disputes to the detriment of domain name registrants.

In addition to Namecheap's concerns regarding bias in the EPDP's recommendations, it appears that the EPDP has exceeded its charter. As detailed in this comment, Namecheap has demonstrated that the Interim Report are against the following requirements in the charter, specifically that the recommendations:

"[do] not affect the right and ability of registrants to file judicial proceedings in a court of competent jurisdiction; [and] preserves registrants' rights to judicial review of an initial [Uniform Domain Name Dispute Resolution Policy or Uniform Rapid Suspension decision]"<sup>5</sup>

Namecheap requests that the EPDP team, along with ICANN org support staff, review the recommendations against the charter, and provide an explanation how, in their opinion, the recommendations align with the charter. To the extent that they do not (as Namecheap has demonstrated repeatedly in this comment), the EPDP should amend or remove those recommendations.

#### **V. ICANN Should Consider Requiring IGOs to Waive Immunity When Asserting Intellectual Property Rights Against a Registrant**

The EPDP team has recognized the unique problem of eligibility of IGO registrants in asserting intellectual property rights – that is, due to national State obligations under the Paris Convention for the Protection of Industrial Property, IGOs may not hold registered trademarks in their names, acronyms, or other identifiers. Thus, through Recommendation #1, the EPDP team has proposed a special definition of "IGO Complainant" as a special exception that confers eligibility rights in IGOs to assert rights under the UDRP and the URS. The intent of Recommendation #1 is to put an IGO in the same footing as a non-IGO registrant in protecting its rights. Thus, if an IGO has the right to participate in UDRP and URS proceedings outside of the actual ownership requirements, then ICANN should consider requiring IGOs to abide by the same rules and constraints as non-IGO registrants – that is, IGOs should agree to waive immunity in courts of Mutual Jurisdiction as to the narrow issue of domain name ownership and review. As currently proposed in the EPDP team's recommendations, waiver of immunity is voluntary, and is thus not so offensive as to be considered immutable. And mandatory waiver is the simplest way in which ICANN ensures that protections for IGO names and acronyms do not

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<sup>5</sup> <https://www.icann.org/en/public-comment/proceeding/initial-report-epdp-specific-curative-rights-protections-igos-14-09-2021>

result in a broader scope of protection than is available under international treaties and national laws, including intellectual property laws.

As a practical consideration, there is nothing inherently unfair about the current framework for resolution of domain disputes through the UDRP and subsequent right of review within a place of Mutual Jurisdiction. This framework has protected the rights of IGO and non-IGO registrants in countless proceedings. Consequently, mandating that an IGO waive its immunity in order to participate in a UDRP proceeding does not prejudice the IGO, particularly so where it always has the option of sidestepping the UDRP proceeding and corresponding contractual right of review altogether and, instead, commence a Court proceeding in the first instance with respect to a contested domain.

Namecheap would like to acknowledge the efforts of the RrSG in drafting a comment to the Interim Report, and the diverse participants that contributed to the RrSG efforts. Namecheap supports the [RrSG comment](#), and incorporates it by reference in this comment.

For the reasons detailed above, the Namecheap does not support the recommendations contained in the Interim Report, and requests that the EPDP consider alternative means of addressing the imbalance of rights between IGOs and non-IGOs in the context of dispute resolution that respect the rights of registrants. Thank you.

Sincerely,

Owen Smigelski  
Head of ICANN Compliance & Relations  
Namecheap, Inc.

## EXHIBIT A

<b>IGO</b>	<b>UDRP Case</b>	<b>Result</b>
International Organization for Standardization ISO	<a href="#">D2008-1782</a>	Transfer
International Organization for Standardization ISO	<a href="#">D2008-1184</a>	Transfer
International Organization for Standardization ISO	<a href="#">D2007-1809</a>	Transfer
International Organization for Standardization ISO	<a href="#">D2007-1529</a>	Transfer
International Organization for Standardization ISO	<a href="#">D2007-0700</a>	Transfer
International Organization for Standardization ISO	<a href="#">D2006-1190</a>	Complaint Denied
International Organization for Standardization ISO	<a href="#">D2006-1021</a>	Transfer
International Organization for Standardization ISO	<a href="#">D2005-1028</a>	Transfer
International Organization for Standardization ISO	<a href="#">D2005-0984</a>	Transfer
International Organization for Standardization ISO	<a href="#">D2005-0903</a>	Transfer
International Organization for Standardization	<a href="#">D2004-0666</a>	Complaint denied with dissenting opinion
International Organization for Standardization	<a href="#">D2004-0376</a>	Transfer
International Organization for Standardization	<a href="#">D2003-0739</a>	Transfer
International Organization for Standardization, ISO	<a href="#">D2003-0565</a>	Transfer
International Organization for Standardization	<a href="#">D2002-0460</a>	Transfer
International Organization for Standardization	<a href="#">D2001-1194</a>	Transfer
International Organization for Standardization (ISO)	<a href="#">DMX2010-0013</a>	Transfer
Bank for International Settlements	<a href="#">D2004-0575</a>	Transfer
Bank for International Settlements	<a href="#">D2004-0571</a>	Transfer

Bank for International Settlements	<a href="#">D2004-0570</a>	Transfer
Bank for International Settlements	<a href="#">D2003-0987</a>	Transfer
Bank for International Settlements	<a href="#">D2003-0986</a>	Transfer
Bank for International Settlements	<a href="#">D2003-0984</a>	Transfer
Inmarsat Ventures Limited International Mobile Satellite Organisation	<a href="#">D2000-1339</a>	Transfer
International Bank for Reconstruction and Development d/b/a The World Bank	<a href="#">D2002-0222</a>	Transfer
European Monitoring Centre for Drugs and Drug Addiction (EMCDDA)	<a href="#">D2010-0475</a>	Complaint Denied
Lenz & Staehelin Ltd (on behalf of Unitaid through a trademark rights assignment agreement)	<a href="#">D2012-1922</a>	Transfer