

24 October 2021

RrSG Comment on the Initial Report from the EPDP on Specific Curative Rights Protections for IGOs

Introduction

The Registrar Stakeholder Group (RrSG) is pleased to comment on the [EPDP on Specific Curative Rights Protections for IGOs](#) ("Interim Report"). While the RrSG appreciates the significant effort of the EPDP in reviewing this issue, the RrSG has serious concerns about a number of the recommendations in the Interim Report that are contrary to the EPDP's charter, the position of the ICANN Board, and could prejudice the rights of domain name registrants.

General Feedback

Before addressing concerns regarding specific recommendations, the RrSG would like to provide general feedback regarding the Interim Report.

First, the RrSG is concerned that some of the preliminary recommendations violate the EPDP's charter by potentially impacting the ability of registrants to file court proceedings. While these will be considered in detail within this comment, it is concerning that the EPDP team participants as well as ICANN support staff allowed such problematic recommendations to be included in the Interim Report.

Second, the RrSG notes that the EPDP does not appear to contain any representatives from the RrSG, the Registry Stakeholder Group (RySG), and the Not-for-Profit Operational Concerns Constituency (NPOC), and some of the recommendations appear to have significant impact on those constituencies or domain name registrants. The absence of certain constituencies in the EPDP should not be rationale for drafting recommendations that could impact those constituencies. The RrSG strongly recommends that for the Final Report, the EPDP must consider and incorporate the feedback from constituencies not represented on the EPDP.

Third, the RrSG review of the recommendations in the Interim Report suggest that the Interim Report conflicts with ICANN Board feedback regarding the EPDP's efforts, specifically "the Board remains of the view 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."¹ [placeholder: waiting for feedback from outside counsel]

Fourth, the RrSG notes that several members of the EPDP have a direct financial interest in adopting these recommendations. Mandating costly arbitration procedures will significantly benefit arbitration service providers and attorneys, at the expense of domain name registrants. Costs for these arbitrations could be tens of thousands of dollars or more, and at least one of the providers recommended for review of rules includes a "loser pays" provision. The RrSG

¹ See

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

would be less concerned about these recommendations if the anticipated utilizing review processes that utilizes the services of providers not represented on the EPDP, or represent significantly lower potential costs than the four providers identified in the Interim Report.

Fifth, the RrSG is concerned that this EPDP is a solution looking for a problem. According p.12 of the [Final Report on the IGO-INGO Access to Curative Rights Protection Mechanisms Policy Development Process](#), one of the reasons that the working group reached a conclusion not to create a new and separate dispute resolution process applicable to IGOs was:

There is only an extremely limited probability of a scenario where a losing respondent in a UDRP or URS proceeding files suit against the winning IGO in a national court such that the IGO might need to assert jurisdictional immunity in that court.

Has the EPDP considered whether there is significant need for IGOs to utilize UDRP or URS to resolve domain name disputes? Will this result in a few cases per year, or dozens? If the number of domain name disputes is low, then the significant time and resources dedicated to addressing this issue could be better focused elsewhere (as ICANN and the ICANN community have finite resources).

As detailed in footnote 5 on p.118 of [Final Report on the IGO-INGO Access to Curative Rights Protection Mechanisms Policy Development Process](#), IGOs have filed and prevailed in UDRPs:

Respectively, in International Mobile Satellite Organisation and Inmarsat Ventures Limited (formerly known as Inmarsat Holdings Limited) v. Domains, EntreDomains Inc. and Brian Evans, D2000-1339 (WIPO Nov. 30, 2000); International Bank For Reconstruction and Development d/b/a The World Bank v. Yoo Jin Sohn, D2002-0222 (WIPO May 7, 2002); and Bank for International Settlements v. BFIS, D2003-0984 (WIPO March 1, 2004), Bank for International Settlements v. BIS, D2003-0986 (WIPO March 2, 2004), Bank for International Settlements v. James Elliott, D2003-0987 (WIPO March 3, 2004), Bank for International Settlements v. G.I Joe, D2004-0570 (WIPO (Sept. 27, 2004), Bank for International Settlements v. BIS, D2004-0571 (WIPO Oct. 1, 2004), and Bank for International Settlements v. Fortune Nwaiwu, D2004-0575 (WIPO Oct. 1, 2004). A few other matters are catalogued in the Index of WIPO UDRP Panel Decisions, <http://www.wipo.int/amc/en/domains/search/legalindex/>, as involving IGOs. In one, involving the European Monitoring Centre for Drugs and Drug Addiction (EMCDDA), a decentralized agency of the European Union, the complaint was denied due to its failure to establish rights to marks or services. European Monitoring Centre for Drugs and Drug Addiction (EMCDDA) v. Virtual Clicks / Registrant ID:CR36884430, Registration Private Domains by Proxy, Inc., D2010-0475 (WIPO July 7, 2010). In another, involving UNITAID, an IGO hosted by the World Health Organization (WHO), trademark rights were assigned by a fiduciary agreement to a private enterprise, which registered them on behalf of the WHO and UNITAID. Lenz & Staehelin Ltd v. Christopher Mikkelsen, D2012-1922 (WIPO Jan. 8, 2013).

The RrSG did not review filings since the publication of the above-referenced Final Report, however it is likely that there were additional UDRP and/or URS filings by IGOs. Additionally, the number of filings by IGOs is likely higher than reported in the Final Report, as one is required to

search by all IGO names to confirm all filings. It is thus not apparent to the RrSG why such extraordinary processes are needed.

Feedback Regarding Specific Recommendations

Mutual Jurisdiction

Recommendations 3 and 4 propose to exempt IGOs from the requirements in the UDRP Decisions and URS Determinations that complainants must submit to a mutual jurisdiction for appeals of UDRP and URS proceedings. Although later recommendations provide for an arbitration method to appeal decisions, the Interim Report is silent about how a registrant can file a court proceeding in mutual jurisdiction to appeal an adverse outcome from a UDRP or URS. It is imperative that any recommendations that may potentially impact the rights of domain name registrants should clearly specify if and how registrants are still legally protected. If these recommendations are adopted, the EPDP should confirm that domain name registrants will still be able to utilize court proceedings to appeal a UDRP Decision or URS Determination, and ensure that any final policy recommendations reflect this vital registrant right.

Arbitration to Appeal UDRP Decision and URS Determination

The RrSG has concerns regarding the arbitration process detailed in recommendations 4 and 5. First, Recommendation 4 refers to a UDRP Decision as an “initial panel decision”, which presumes that UDRP decisions are temporary and likely subject to appeal. Although there are no statistics readily available, it is the experience of members of the RrSG that only a very small number of UDRP decisions are subject to court proceedings, which is an extraordinary measure in domain name disputes.

Second, the wording used in recommendations 4 and 5 appear to imply that the complainant can utilize the appeal process, e.g. an IGO that loses a UDRP or URS could appeal that Decision or Determination. The recommendations should be clarified to ensure that the appeal process is for registrants only, and does not provide a new avenue for trademark owners to appeal UDRP Decisions or URS Determinations decided against them.

Third, the recommendations should be clarified to ensure that the default option for appealing a UDRP Decision or URS Decision is through a court proceeding initiated by the registrant. If the final recommendations include an arbitration appeal option, it should require informed and affirmative consent from the registrant, including an explanation of potential legal and financial impacts of accepting the arbitration appeal process (and foregoing the court proceeding). In no circumstances should arbitration be initiated without the consent of the registrant.

Fourth, the appeal process detailed in the charts in recommendations 4 and 5 appear to be incomplete and should be revised. Some deficiencies include (a) applying to a US-centric judicial system and not reflective of other jurisdictions around the world, (b) do not anticipate appeals by the registrant, (c) envisions domain disputes being appealed to the Supreme Court (which would be cost prohibitive for registrants), and (d) delay implementation until all appeals are exhausted (the UDRP allows implementation upon conclusion of the original court proceeding and does not extend to appeals).

Finally, the RrSG is concerned about the potential costs associated with the arbitration appeal process detailed in the Interim Report. Although the process is still to be defined, the Interim Report provides examples of four arbitration providers as guidance for their rules and processes. The costs associated with these processes are significant, and substantially exceed the resources available to almost every domain name registrant (with the exception of large corporations). Some require thousands of dollars for each hearing², and others charge over \$40,000 for a hearing³ (including the requirement that the loser pay for all costs⁴). These enormous costs will severely prejudice domain name registrants, who are mostly individuals without unlimited resources for costly arbitration procedures (or multiple appeals to the highest court in the jurisdiction). Although court proceedings can have significant costs, certain jurisdictions (in particular those outside of North America or Europe) have significantly lower court costs. Although those costs may be significant compared to the median income in those jurisdictions, those costs are still substantially lower than the arbitration providers detailed in the Interim Report.

For the reasons detailed above, the RrSG does not support the recommendations as detailed in the Interim Report. Thank you for your time and consideration, and the RrSG looks forward to a Final Report that reflects (and where appropriate incorporates) the feedback from public comments.

Sincerely,

Ashley Heineman
RrSG Chair

² <https://pca-cpa.org/fees-and-costs/>)

³ <https://icsid.worldbank.org/services/arbitration/uncitral/fees>

⁴ <https://icsid.worldbank.org/services/arbitration/uncitral/cost-submission>