

23 February 2021

Manal Ismail, Chair
ICANN Governmental Advisory Committee (GAC)

RE: Follow up Questions from the Board-GAC Consultation Process Call on IGO Protections

Dear Manal,

On behalf of the ICANN Board, I'd like to extend our appreciation to you, the members of the GAC, and the International Governmental Organization (IGO) representatives for taking the time to engage with us on the Board-GAC Consultation Process call about IGO protections on 1 February. Following the call, we received several follow-up questions from a GAC member. As we believe that our responses to those questions may be of interest to the GAC and IGOs, we are sending this note to you in your capacity as GAC Chair, should you wish to circulate it.

To reiterate the points we made on the call, the main distinction the Board is making is between pre-registration and post-registration notifications for IGOs. The sole ICANN-mandated mechanism currently available for pre-registration notification is part of the Trademark Claims service, where a registrar displays a standard notice to a potential registrant who is trying to register a second-level domain name that matches a validated trademark in the Trademark Clearinghouse. This pre-registration service is performed by registrars through their interaction with the Trademark Clearinghouse. It is important to note that a trademark owner is only notified if a registrant decides to proceed with the domain registration after having been shown the Trademark Claims Notice. This post-registration is known as a Notice of Registered Name.

The Board intends to provide this type of post-registration notice to IGOs. The Board understands the GAC's concern about the need to protect IGOs on a permanent basis. This is why our proposal is to provide the post-registration service on a permanent, ongoing basis at no or nominal cost to an IGO. The current temporary reservations would remain in place until the post-registration service is ready so that there will be no lapse in IGO protections and strings matching IGO acronyms will remain reserved until the launch of the post-registration service.

Another follow-up question related to other potential interested users of strings matching IGO acronyms, in addition to the IGOs themselves. In essence, unlike IGO full names (which are already protected by a Board-adopted GNSO Consensus Policy), there can be multiple legitimate uses by both IGOs and third parties of acronyms. These are the examples mentioned on the call:

- "WHO" can refer to the World Health Organization, the rock band The Who, or the science fiction character Dr. Who.

- “ICC” can be both the International Chamber of Commerce and the UN’s International Computing Centre.
- “ILO” can be used by the International Labor Organization (ilo.org) and a German manufacturer of medical devices (ilo.com).
- “SBA” can mean the US Small Business Association (sba.gov), the Southern Bakers’ Association (sba.org) and the law firm Smith, Bucklin & Associates (sba.com).

These examples were included in the official report from the Second Domain Name Process conducted by the World Intellectual Property Organization in 2001, which indicates that the co-existence of legitimate uses of IGO acronyms has been recognized for some time.

We were also asked for clarification about Article 6ter of the Paris Convention for the Protection of Industrial Property. In relevant part, it reads as follows:

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

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

(c) The countries of the Union shall not be required to apply the said provisions when the use or registration referred to in subparagraph (a), above, is not of such a nature as to suggest to the public that a connection exists between the organization concerned and the armorial bearings, flags, emblems, abbreviations, and names, or if such use or registration is probably not of such a nature as to mislead the public as to the existence of a connection between the user and the organization. (For the full text, see: https://www.wipo.int/article6ter/en/legal_texts/article_6ter.html)

As we mentioned on the call, Article 6ter does not create absolute or substantive legal rights and does not give IGOs enforceable trademark rights in their names or acronyms. It requires contracting states to implement their own national measures to prevent unauthorized third-party trademark registrations. Notably, Article 6ter makes it clear that these protections do not apply where the third-party use is not likely to mislead or confuse the public. These limitations of Article 6ter are well-recognized in academic research on the Paris Convention.

For the reasons noted here and on the call, the Board does not believe it is appropriate to provide greater protection to IGOs than what exists under international law. However, it is appropriate to strike a balance between recognizing the public interest need to protect IGOs from abusive registrations and use of related acronyms while ensuring the protection of the legitimate rights of third parties. A permanent post-registration notification system that alerts an IGO whenever a third party registers a matching domain reflects the scope of international law and allows an IGO to take appropriate action to protect related acronyms.

Finally, we confirm that the Bylaws require a Board voting threshold of 60% (or higher) for the Board to reject GAC consensus advice. We also confirm that the existing temporary protections for IGO acronyms will continue until the permanent post-notification system is in place. This will form part of the totality of IGO protections when combined with the existing Consensus Policy that protects IGO full names and with the final outcomes of the GNSO's ongoing curative rights Work Track, which we are grateful to see that GAC and IGO participants have kindly volunteered to participate in.

Best regards,



Maarten Botterman
Chair, ICANN Board of Directors