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GNSO Policy Development Process on Reviewing All Rights Protection Mechanisms in All gTLDs: Working Group Open Meeting

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Agenda 2 Slide

1. Welcome and introductions; brief update on the PDP
2. Review community feedback on scope of Phase One (on RPMs developed for the 2012 New gTLD Program):
 - Modify/delete/add to list of issues/topics on Trademark Clearinghouse (TMCH)
 - Modify/delete/add to list of issues/topics on Sunrise Registration Periods and Trademark Claims Notifications
 - Modify/delete/add to list of issues/topics on Uniform Rapid Suspension dispute resolution procedure (URS)
 - Next steps - refine and prioritize list of issues/topics?
3. Break
4. Discussion: Trademark Post-Delegation Dispute Resolution Procedure
 - Review Providers' feedback to Working Group questions
 - Additional questions/follow up with Providers
 - Review/refine list of Charter issues/topics
5. Next steps and closing

Introduction and Brief Update

Snapshot of the RPMs to be reviewed in the two phases of this PDP

Sunrise Registration Period and Trademark Claims Notification Services (Phase One)

- Sunrise services provide TM holders with advance opportunity to register domain names corresponding to their marks before names are generally available to the public
- The Trademark Claims period follows the Sunrise period and runs for at least the first 90 days in which domain names are generally made available
- TM Claims Notice is sent to a potential registrant whose domain matches that of a TM record in the TMCH
- TM owner is notified if registrant proceeds

Trademark Clearinghouse (Phase One)

- A global database of verified trademark information to support rights protection processes
- Benefits of inclusion are access to Sunrise Period and Trademark Claims Service

Uniform Rapid Suspension Dispute Resolution Procedure (Phase One)

- Designed as a complement to the UDRP, to provide TM owners with a quick and low-cost process to suspend domain names on the same substantive grounds as the UDRP
- Burden of proof and remedies are not the same as UDRP

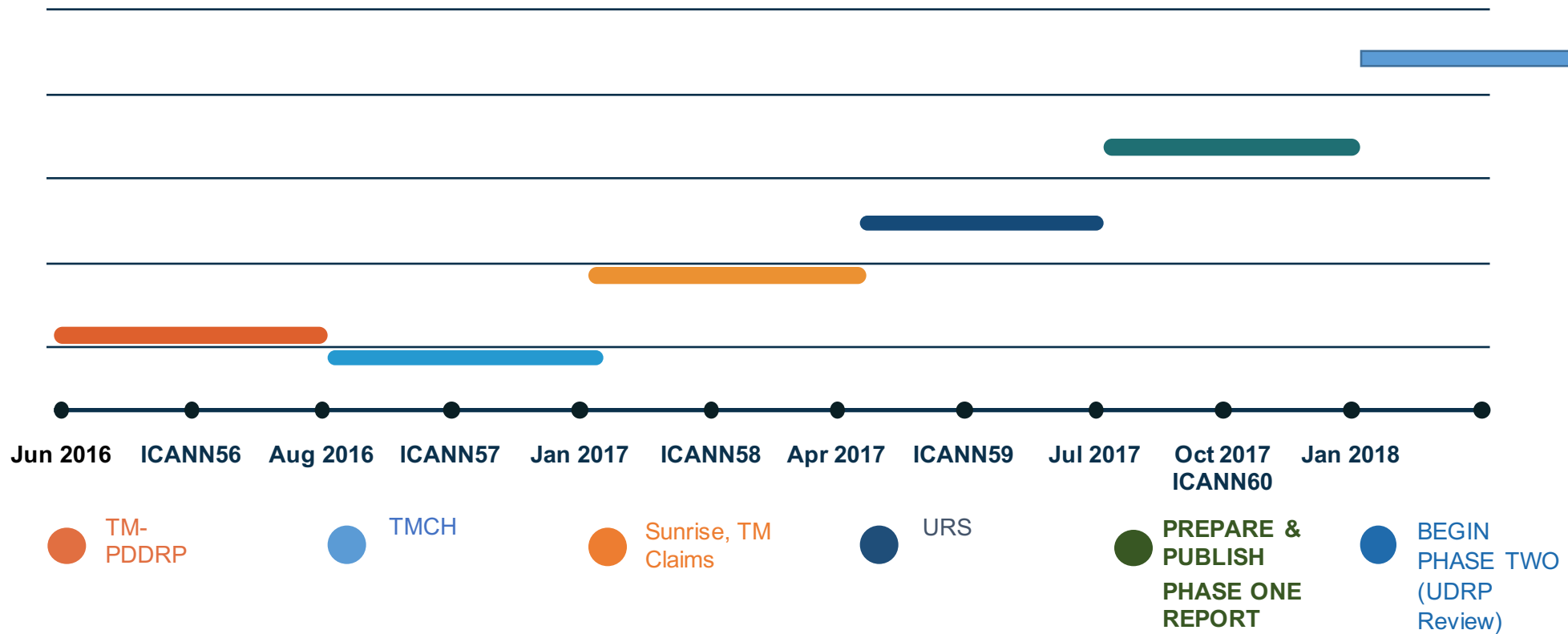
Trademark Post-Delegation Dispute Resolution Procedure (Phase One)

- Allows a TM owner to act directly against a New gTLD Registry Operator whose affirmative conduct supports TM infringement at the top or second level of its gTLD

Uniform Dispute Resolution Policy (UDRP) (Phase Two)

- Created in 1999
- Provides a uniform, standardized alternative dispute resolution procedure to resolve disputes concerning who is the rightful holder of a registered domain name
- Applicable to all domains registered in all generic top-level domains (gTLDs) – Phase One RPMs apply only to gTLDs delegated under the 2012 New gTLD Program round

Estimated Timeline for Phase One (RPMs developed for 2012 New gTLD Program)



Notes:

- Each RPM is being reviewed consecutively, starting with the TM-PDDRP
- Initial outreach to all SO/ACs, GNSO Stakeholder Groups & Constituencies began on 28 May 2016
- Aim to complete Phase One by late/end-2017



Reviewing Community Feedback on the Scope of the PDP

1. The Trademark Clearinghouse (TMCH) (1)

Current Charter Questions

Retain/Delete/Modify?

1. Should further guidance on verification guidelines for different categories of marks be considered?
2. Is the protection of the TMCH too broad? Is the TMCH providing too much protection for those with a trademark on a generic or descriptive dictionary word? Should TM+50 be reversed?
3. Are legitimate noncommercial, commercial and individual registrants losing legitimate opportunities to register domain names in New gTLDs?
4. How should the TMCH scope be limited to apply to only the categories of goods and services in which the generic terms in a trademark are protected?
5. Should the TMCH matching rules be expanded, e.g. to include plurals, 'marks contained' or 'mark+keyword', and/or common typos of a mark?

1. The Trademark Clearinghouse (TMCH) (2)

Current Charter Questions

6. Should there be an additional or a different recourse mechanism to challenge rejected trademarks?
7. How quickly can a cancelled trademark be removed from the TMCH?
8. How can TMCH services be much more transparent in terms of what is offered pursuant to ICANN contracts and policies vs. what is offered to private New gTLD registries pursuant to private contracts?
9. Should there be a review on accessibility to TMCH for individuals, private trademark holders and trademark agents in developing countries?
10. How can the TMCH provide education services not only for trademark owners, but for the registrants and potential registrants who are equally impacted by their services?

Retain/Delete/Modify?

2. Sunrise Registration Periods

Current Charter Questions

1. Should the availability of Sunrise registrations only for “identical matches” (e.g. without extra generic text) be reviewed?
2. Is the notion of “premium names” relevant to a review of RPMs, and, if so, should it be defined across all gTLDs? Should there be a mechanism to challenge whether a domain is a ‘premium name’?
3. Should there be a specific policy about the reservation and release of “reserved names” (e.g. modification of Section 1.3.3 of Specification 1 of the current Registry Agreement)?
4. Should there be a public, centralized list of all reserved trademarks for any given Sunrise period?
5. Should holders of TMCH-verified trademarks be given first refusal once a reserved name is released?
6. Should Sunrise periods continue to be mandatory? If so, should the current requirements apply or should they be more uniform, such as a 60-day end-date period?
7. Whether and how to develop a mechanism by which trademark owners can challenge Sunrise pricing practices that flout the purpose of Sunrise
8. Whether more can be done to improve transparency and communication about various Sunrise procedures

Retain/Delete/Modify?

3. Trademark Claims Notifications

Current Charter Questions

1. Should the Trademark Claims period be extended beyond ninety (90) days?
2. Should the Trademark Claims period continue to apply to all new gTLDs?
3. Should the Abused Domain Name Label service be continued?
4. Does a Trademark Claims period create a potential “chilling effect” on genuine registrations, and, if so, how should this be addressed?
5. Is the TMCH and the Sunrise Period allowing key domain names to be cherry picked and removed from New gTLDs unrelated to those of the categories of goods and services of the trademark owner?
6. What is the effect of the 90-day Trademark Claims process?
7. Should notices to the trademark owner be sent before the domain is registered?

Retain/Delete/Modify?

4. Uniform Rapid Suspension (URS) dispute resolution procedure (1)

Current Charter Questions

1. Should the ability for defaulting respondents to file a reply for an extended after the default notice, or even after a default determination is issued be changed?
2. Is the URS' 'clear and convincing' standard of proof appropriate?
3. Is there a need to develop express provisions to deal with 'repeat offenders' as well as a definition of what qualifies as 'repeat offences'?
4. Should the URS allow for additional remedies such as a perpetual block or other remedy, e.g. transfer or a "right of first refusal" to register the domain name in question?
5. Is the current length of suspension (to the balance of the registration period) sufficient?
6. Is the cost allocation model for the URS appropriate and justifiable?
7. Should there be a "loser pays" model? How can that be enforced if the respondent does not respond?
8. Should the Response Fee applicable to complainants listing 15 or more disputed domain names by the same registrant be eliminated?

Retain/Delete/Modify?

4. Uniform Rapid Suspension (URS) dispute resolution procedure (2)

Current Charter Questions

9. Has ICANN done its job in training registrants in the new rights and defenses of the URS?
10. Are the expanded defenses of the URS being used and if so, how, when, and by whom?
11. What sanctions should be allowed for misuse of the URS by the trademark owner?
12. What evidence is there of problems with the use of the English-only requirement of the URS, especially given its application to IDN New gTLDs?
13. How can the appeals process of the URS be expanded and improved?

Retain/Delete/Modify?

- What additional questions and/or modifications should be made to the list of issues/topics in the Working Group Charter?

***** COFFEE BREAK *****

Discussion – the Trademark Post-Delegation Dispute Resolution Procedure (TM-PDDRP)

Working Group status update on reviewing the TM-PDDRP

1

Phase One review kicked off with TM-PDDRP

2

WG sent list of questions to all three Providers

3

Providers are:

- ADNDRC
- The FORUM
- WIPO

4

WG to review Provider responses and follow up if needed

5

WG continues to refine and add to list of Charter questions to be reviewed

6

WG aims to complete TM-PDDRP review by end-August

The three current TM-PDDRP Providers:

- *Asian Domain Name Dispute Resolution Center (ADNDRC):*
<http://www.adndrc.org/mten/index.php>
- *The FORUM:* <http://www.adrforum.com/Home/HomePage>
- *The World Intellectual Property Organization (WIPO):*
<http://www.wipo.int/amc/en/index.html>

General information on the TM-PDDRP:

- <https://newgtlds.icann.org/en/program-status/pddrp>

Question to Provider

What are the possible reasons for the TM-PDDRP not having been used to date?

Provider Responses

WIPO:

- High-level DRP, non-use doesn't mean it's not needed.
- Substantive reasons and many procedural layers:
 - no willful blindness standard, two-pronged affirmative conduct requirement, burden of proof, remedies, applicability to registrars, ICANN's role in implementation, failure to expressly allow class/joined complaints.

ADNDRC:

- Burden of proof may be difficult to discharge, especially for second level infringements
- Top-level infringements possibly minimized by existence of pre-delegation objection processes, TMCH and SDRP
- Remedies may not be useful for second level infringements

FORUM:

- High substantive standards, particularly at the second level
- Procedure may not be well-known
- Unspecific nature of the remedies.

Question to Provider

Is there an ongoing cost to retain the Procedure even if it is not used?

Provider Responses

WIPO: Case filing fees support case administration.

ADNDRC: Yes - System maintenance; staff training; business development.

FORUM: No.

Question to Provider

Have you received feedback from any trademark owners or registry operators about potential problems or concerns with the Procedure?

Provider Responses

WIPO: Some (along the lines of the topics outlined in response to Q1).

ADNDRC: No.

FORUM: No.

Question to Provider

Have you received any enquiries from potential complainants who nevertheless did not proceed?

Provider Responses

WIPO: See response to Q3.

ADNDRC: Yes, a couple of enquiries regarding the proceedings flow, case filing fee and available remedies but did not hear further from them.

FORUM: Very few enquiries about the general purpose of the TM-PDDRP (what does it do?). On a couple of occasions, parties who were facing a potential loss in a pre-delegation TMCH proceeding enquired about a potential TM-PDDRP filing post-delegation.

Question to Provider

Are you operationally ready should a complaint be filed?

Provider Responses

WIPO: Yes.

ADNDRC: Yes.

FORUM: Yes.

Question to Provider

Have you selected panelists?

Provider Responses

WIPO: Yes.

ADNDRC: Yes.

FORUM: Yes.

Question to Provider

Should mediation be added to the Procedure?

Provider Responses

WIPO:

- Difficult to positively answer given the additional layers to the process that were created.
- Difficult to justify if merely an additional layer - but a mediation component might be useful if it serves to assist the parties in considering tailored settlement options or remedies (or e.g., to supplant the role of the Threshold Review Panel)

ADNDRC:

- Could be an effective means of resolving disputes in a time and cost efficient manner
- Note possible adverse effect on panelist's neutrality after having obtained confidential information from a party during a fruitless mediation.

FORUM:

- Not recommended if mandatory, though an optional step could be considered (but note additional fees if mediation is unsuccessful).
- Does not believe that adding a mediation step will have a significant influence on triggering filings.

Question to Provider

Do you have any additional feedback about the TM-PDDRP at this stage?

Provider Responses

WIPO:

See generally response to Q3; bear in mind that the TM-PDDRP is part of the “tapestry” of protections created for the New gTLD Program.

ADNDRC:

More concrete wordings for available remedies, e.g.:

- Amount of monetary damages or sanctions other than the cost of proceedings
- Actual direct actions by the registry operator contrary to those required under the Registry Agreement

FORUM:

- ICANN Compliance has been influential in controlling registrars and registries: potential filer may not file under TM-PDDRP - goes directly to ICANN Compliance
- Although it has not been used so far, cannot be certain that it is unnecessary
- Solidifying remedies could potentially trigger filings
- Example cases could be helpful to indicate why it hasn't been used so far

SUGGESTIONS:

- WG should also seek feedback from panelists/arbitrators, especially those who have been trained in the PDDRP or who have extensive experience with similar administrative proceedings or arbitration (from ADNDRC and WG members)
- More promotional events can be hosted jointly by ICANN, providers and registry operators (from ADNDRC)

QUESTIONS:

- Do you have any knowledge of why the potential complainants who enquired did not proceed to filing?
- Looking over the PDDRP, are there any requirements that present administrative challenges?
- Do you believe that the lack of use of the PDDRP results from a lack of instances of the abuse it was designed to target, or are there cost or evidentiary elements that discourage potential complaints?

Policy questions for the Working Group in reviewing the TM-PDDRP

1. Is there a policy-based need to address the goal of the TM-PDDRP?
2. Is it broad enough to cover abuses that were not anticipated when it was developed?
Alternatively, do we still need it?
3. There is an overarching Charter question as to whether the RPMs collectively fulfill the objectives for which they were developed. In this context, are there some policies/procedures that should be carried across all mechanisms (assuming applicability) e.g. costs/fees for the prevailing party? Should the standards be changed to address the full range of conduct that may appropriately be sanctioned by this process?
4. Even if we made no changes to the TM-PDDRP, is there any burden to it remaining available for use should an appropriate case arise? Or would changes make it more useful?
5. Given how much it costs to be a registry operator, is it too easy to bring a TM-PDDRP action?
6. Concerning TMCH/sunrise practices, certain registries charged fees that some considered disproportionately high for trademark owners. Is there any relation between the sunrise registration fees for trademark owners, in particular registries, to the conduct of the registry operator itself that would be relevant to think about in the post-delegation context?
7. Would adding mediation to the PDDRP be advisable?

Next steps for the Working Group

***** THANK YOU *****