ICANN|56|POLICY
HELSINKI|FORUM
27–30 June 2016

Community Session – Review of All Rights Protection Mechanisms in All gTLDs Policy Development Process

ICANN56 | 27 June 2016

Goals of this Cross Community Session

Purpose	• To discuss with the community the proposed methodology and timelines for this Policy Development Process (PDP) • To obtain the community's input on data to be collected, and list of issues to be analyzed, as part of the PDP

Scope	• Why this PDP is being conducted in two phases, and how
	
	• What is being covered in Phase One and Phase Two?
	
	• What is the timeline for each Phase?
	
	• What is the community's view on the scope of topics and possible data to be gathered for Phase One:
	    o Trademark Clearinghouse (TMCH)
	    o Sunrise registrations through the TMCH
	    o Claims Notices sent to potential registrants through the TMCH
	    o Uniform Rapid Suspension dispute resolution procedure
	    o Trademark Post-Delegation Dispute Resolution Procedure

Introduction to the Rights Protection Mechanisms in All gTLDs Policy Development Process (PDP)

ICANN

What is this PDP Working Group tasked to do?

- March 2016: WG chartered by the GNSO Council to conduct the PDP in two phases:
  - *Phase One: review of the RPMs that were developed for the 2012 New gTLD Program*
  - *Phase Two: review of the 1999 Uniform Dispute Resolution Policy*
- For each Phase, WG to assess effectiveness of the relevant RPM(s)
- WG work should ultimately also cover:
  - *the interplay between and complementary roles of each RPM in seeking to more fully understand their overall functioning and effectiveness.*
  - *the overarching issue as to whether or not all the RPMs collectively fulfill the purposes for which they were created, or whether additional policy recommendations are needed, including to clarify and unify policy goals*

Note:

"Rights protection mechanisms" (RPMs) in this context means those ICANN policies and processes that are aimed at combatting cyber-squatting and providing workable mechanisms for trademark owners to either prevent or remedy certain illegitimate uses of their trademarks in the domain name system (DNS)

What are 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

- Conducting a review does <u>not</u> mean there will definitely be new RPMs or changes to the existing RPMs
  - *Existing policies and processes will continue to apply unless policy recommendations to modify, add to or delete them are adopted*
- Possible outcomes of a PDP may include:
  - *Developing new or additional RPMs and/or new or additional procedures applicable to one or more RPM(s)*
  - *Clarifying, amending or overriding existing RPMs*
  - *Supplementing existing, or developing new, procedural requirements for existing RPMs;*
  - *Recommending neither substantive nor procedural changes to any existing RPMs, nor the creation of new RPMs*
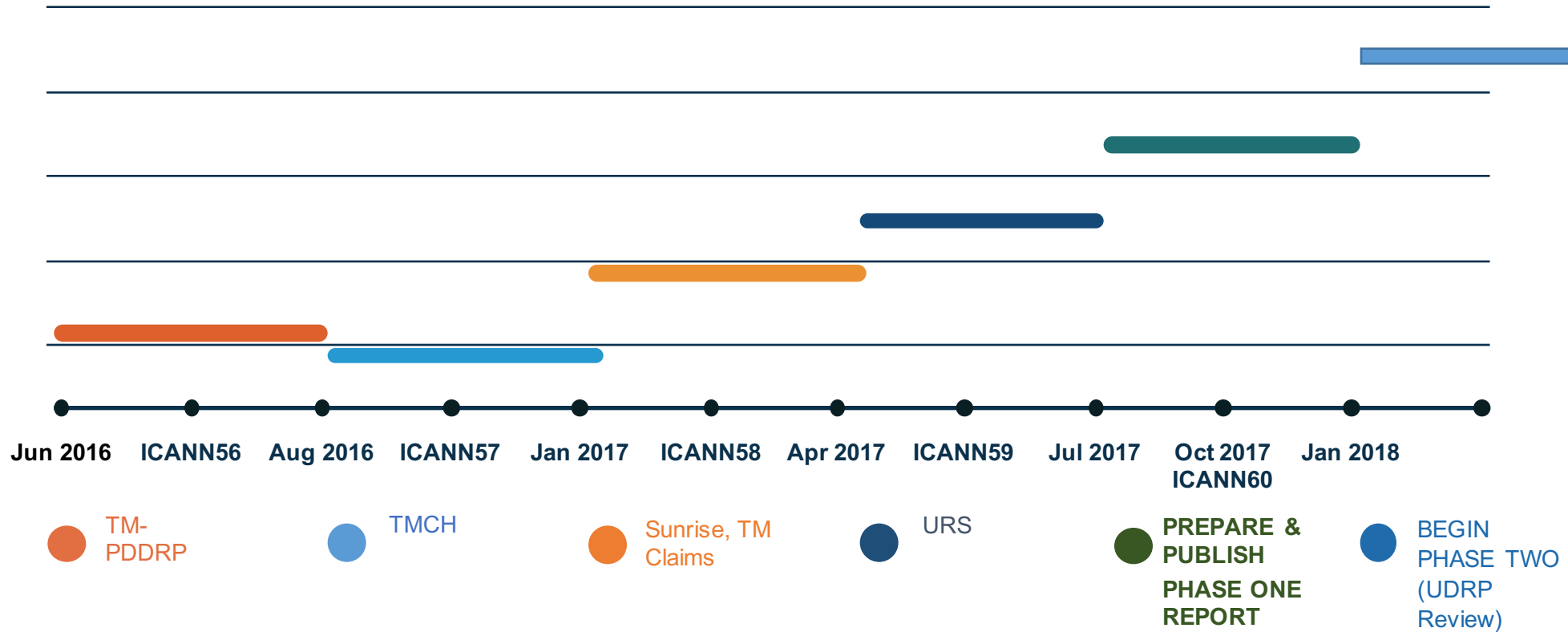 - *Recommending that all RPMs are Consensus Policies applicable to all gTLDs*

- The Working Group will coordinate its work (including timelines) with the following ongoing parallel efforts:
  - *The GNSO PDP on New gTLD Subsequent Procedures*
  - *The Competition, Consumer Choice & Consumer Trust Review Team*
  - *The independent review of the Trademark Clearinghouse*
- The Working Group Charter specifically contemplates community liason(s) will be appointed between this PDP and that on New gTLD Subsequent Procedures

PDP Work Plan and Proposed Methodology

Estimated Timeline for Phase One

Jun 2016   **ICANN56**   **Aug 2016**   **ICANN57**   **Jan 2017**   **ICANN58**   **Apr 2017**   **ICANN59**   **Jul 2017**   **Oct 2017 ICANN60**   **Jan 2018**

TM-PDDRP

TMCH

Sunrise, TM Claims

URS

PREPARE & PUBLISH PHASE ONE REPORT

BEGIN PHASE TWO (UDRP Review)

Notes:

- Each RPM is being reviewed consecutively
- For most RPMs, a Sub Team to perform data collection and initial analysis will be formed (except for the TM-PDDRP)
- Initial outreach to all SO/ACs, GNSO Stakeholder Groups & Constituencies began on 28 May 2016

Community Feedback on Some of the RPMs being Reviewed in Phase One

1. Reviewing the Trademark Clearinghouse (TMCH)

- Should further guidance on verification guidelines for different categories of marks be considered?

- 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?

- Are legitimate noncommercial, commercial and individual registrants losing legitimate opportunities to register domain names in New gTLDs?

- 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?

- Should the TMCH matching rules be expanded, e.g. to include plurals, 'marks contained' or 'mark+keyword', and/or common typos of a mark?

- Should there be an additional or a different recourse mechanism to challenge rejected trademarks?

- How quickly can a cancelled trademark be removed from the TMCH?

- 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?

- Should there be a review on accessibility to TMCH for individuals, private trademark holders and trademark agents in developing countries?

- 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?

What other questions/topics should the Working Group address?
What feedback do you have on these questions?

2. Reviewing the Sunrise Registration Period

- Should the availability of Sunrise registrations only for "identical matches" (e.g. without extra generic text) be reviewed?

- 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'?

- 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)?

- Should there be a public, centralized list of all reserved trademarks for any given Sunrise period?

- Should holders of TMCH-verified trademarks be given first refusal once a reserved name is released?

- 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?

- Whether and how to develop a mechanism by which trademark owners can challenge Sunrise pricing practices that flout the purpose of Sunrise

- Whether more can be done to improve transparency and communication about various Sunrise procedures

What other questions/topics should the Working Group address?
What feedback do you have on these questions?

3. Reviewing the Trademark Claims Notification Service

- Should the Trademark Claims period be extended beyond ninety (90) days?
- Should the Trademark Claims period continue to apply to all new gTLDs?
- Should the Abused Domain Name Label service be continued?
- Does a Trademark Claims period create a potential "chilling effect" on genuine registrations, and, if so, how should this be addressed?
- 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?
- What is the effect of the 90-day Trademark Claims process?
- Should notices to the trademark owner be sent before the domain is registered?

> *What other questions/topics should the Working Group address?*
> *What feedback do you have on these questions?*

4. Reviewing the Uniform Rapid Suspension Procedure (URS)

- 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?

- Is the URS' 'clear and convincing' standard of proof appropriate?

- Is there a need to develop express provisions to deal with 'repeat offenders' as well as a definition of what qualifies as 'repeat offences'?

- 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?

- Is the current length of suspension (to the balance of the registration period) sufficient?

- Is the cost allocation model for the URS appropriate and justifiable?

- Should there be a "loser pays" model? How can that be enforced if the respondent does not respond?

- Should the Response Fee applicable to complainants listing 15 or more disputed domain names by the same registrant be eliminated?

- Has ICANN done its job in training registrants in the new rights and defenses of the URS?

- Are the expanded defenses of the URS being used and if so, how, when, and by whom?

- What sanctions should be allowed for misuse of the URS by the trademark owner?

- 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?

- How can the appeals process of the URS be expanded and improved?

What other questions/topics should the Working Group address?
What feedback do you have on these questions?

What additional sources besides those below should the Working Group/ICANN approach to obtain useful data for the work ahead?

Providers:
- *TMCH – Deloitte (for verification services); CHIP S.A. is contracting party issuing invoices:* *http://www.trademark-clearinghouse.com/content/clearinghouse-team*
- *URS – The FORUM; Asian Domain Name Dispute Resolution Center (ADNDRC); MFSD Srl:* *https://newgtlds.icann.org/en/applicants/urs*
- *TM-PDDRP – ADNDRC; The FORUM; The World Intellectual Property Organization (WIPO):* *https://newgtlds.icann.org/en/program-status/pddrp*

ICANN Compliance and Global Domains Division (GDD)

The TMCH Independent Reviewer: https://newgtlds.icann.org/en/reviews/tmch

Also, join the Working Group's meeting on Thursday to discuss the Providers' feedback on the TM-PDDRP:
https://icann562016.sched.org/event/7Gl1/gnso-review-of-all-rights-protection-mechanisms-rpms-in-all-gtlds-pdp-working-group?iframe=yes&w=i:100;&sidebar=yes&bg=no

To Learn More about this PDP and the Working Group

Further Information

- GNSO Activity Page (with background information, relevant GNSO Council Resolutions, and the PDP Issue Reports): http://gnso.icann.org/en/group-activities/active/rpm
- The Working Group Charter (describing the two-phased PDP and the scope of work): https://community.icann.org/x/2CWAAw
- The Working Group's online collaborative wiki space (containing agendas, transcripts and recordings of all Working Group meetings; draft documents; and background material): https://community.icann.org/x/wCWAAw