

Rights Protection Mechanisms for New gTLDs

18 November 2013

ICANN Generic Domains Division



Agenda

- + Developing the New gTLD Program
- + Trademark Clearinghouse
- + Post-Delegation Dispute Resolution Mechanisms

Developing the New gTLD Program



Developing the New gTLD Program

- + GNSO policy development process
 - Informed by independent working groups, advisory committee advice, including GAC Principles on New gTLDs
- + A team of IP experts' recommendations (IRT)
- + Subsequent public consultations
- + Multi-disciplinary team examined aspects of IRT recommendations and proposed revisions (STI)
- + GAC and Board collaborated
- + Result: The current set of trademark protections for new gTLDs

REGISTRY LIFECYCLE

RIGHTS PROTECTION MECHANISMS

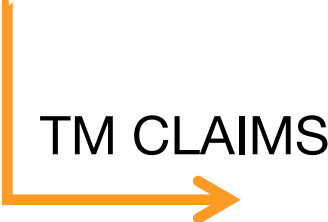
TLD STARTUP  ONGOING OPERATIONS



TM CLEARINGHOUSE



SUNRISE



TM CLAIMS



UDRP
URS



POST-DELEGATION
DISPUTE PROCESSES

Trademark Clearinghouse



Trademark Clearinghouse

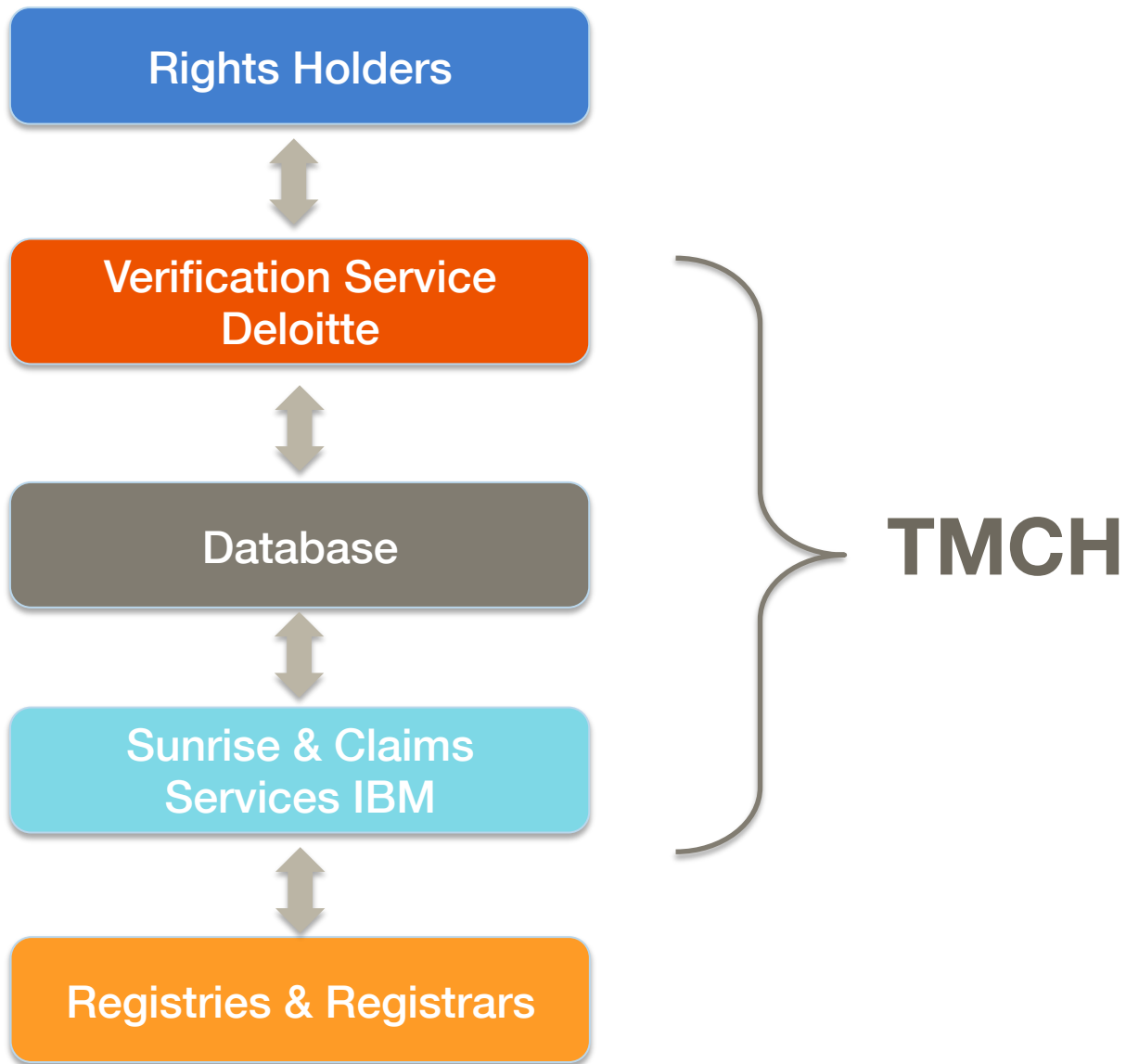
- + A global repository for trademark data
- + Intended to create efficiencies: allows trademark information to be verified once so that data can be used across various TLD launches
- + Verifies existing trademarks, does not adjudicate or create additional rights

Trademark Clearinghouse

Sunrise & Trademark Claims services required in all new gTLDs

- + **Sunrise**: gives trademark holders an advance opportunity to request domain names in a new gTLD, before names are generally available
- + **Trademark Claims**: notification service to registrants and rights holders
- + Required for at least the first 90 days of general registration
 - Those attempting to register a domain name matching a mark in the Trademark Clearinghouse will receive a notification
 - If the name is registered, trademark holders with matching records in the Clearinghouse will receive a notification

Trademark Clearinghouse Functions



Trademark Clearinghouse > Verification service

Launched in March 2013

- + Designed to be available in advance of new gTLD startups

Addition of domain labels

- + Up to 50 labels can be added to an existing verified record
- + Based on UDRP or court decision
- + Labels included in trademark Claims service
- + <http://trademark-clearinghouse.com/>

Trademark Clearinghouse > Sunrise & Claims services

Sunrise support launched August 2013

Claims support launched September 2013

Access to test environment:

- + Registry Operators (upon execution of Registry Agreement)
- + Applicants with active gTLD applications
- + ICANN-accredited registrars

<https://marksdb.org/tmdb/public/>

<http://newgtlds.icann.org/en/about/trademark-clearinghouse/scsvcs>

Upcoming > SMD Transition

Signed Mark Data (SMD file)

- + available for eligible TMCH records
- + presented to registrar to enable registration of names during Sunrise period

SMD Term

- + Initially: created with expiration 2 years from issuance
- + Initial SMDs to be revoked and reissued to align with term of TMCH record
- + User may download new SMD
- + Process and schedule for transition to be published

RPM Requirements

- + Part of Registry Agreement
 - Binding on all new gTLD registry operators
 - Developed with community input on how to create standard process balanced with flexibility for registry business models
- + **Requirements posted 30 September**: <http://newgtlds.icann.org/en/about/trademark-clearinghouse/rpm-requirements-30sep13-en.pdf>
- + **Webinar 6 November**: <http://newgtlds.icann.org/en/announcements-and-media/webinars>
- + **FAQ published**: <http://newgtlds.icann.org/en/about/trademark-clearinghouse/rpm-requirements-faqs-12nov13-en.pdf>
- + **Process for Approved Launch Programs**: <http://newgtlds.icann.org/en/announcements-and-media/announcement-12nov13-en>

TLD Startup Information > Submission

Overview

- + This information is fed into a public portal that consolidates all the TLD startup information as new gTLD registries are launching

Required Information

- + Dates of Sunrise period
- + Complete Sunrise policies for the registry (including Sunrise DRP)
 - Include whole document(s), not links
- + Dates of Claims period
- + Certification that integration testing has been completed

Optional Information

- + Dates of any Limited Registration Periods

Submit Information

- + Send notices to the Customer Service Center at newgtld@icann.org.

TLD Startup Information > Processing

ICANN Review & Publication

- + Notice may be submitted once TLD is delegated.
- + Registry submits its information to ICANN, including requested startup dates.
- + ICANN will confirm availability of dates with IBM. Registry is not required to do this in advance of submitting information.
- + ICANN does a straightforward review:
 - Do the dates comply with requirements?
 - Are all the required elements included?
- + ICANN notifies registry of acceptance and publishes the information
 - Will contact registry if corrections needed

Sunrise Period

Overview

- + Required for each new gTLD. After delegation, a Registry is responsible for executing Sunrise according to the RPM Requirements, published 30 September 2013.

Key Points

- + All registrations during Sunrise must be based on valid Signed Mark Data file
 - Files and additional information:
<http://newgtlds.icann.org/en/about/trademark-clearinghouse#smd-testing>
- + Registries may establish other restrictions as specified in Requirements:
 - Trademark date restrictions
 - Trademark class of goods/services
 - Community-based registration restrictions
 - Eligibility requirements
- + Registry must have a Sunrise Dispute Resolution Policy

Sunrise > Start-Date vs. End-Date

Start Date Sunrise

- + Allocation of names will occur throughout the period
- + Minimum 30-day period with required minimum 30-day notice

End Date Sunrise

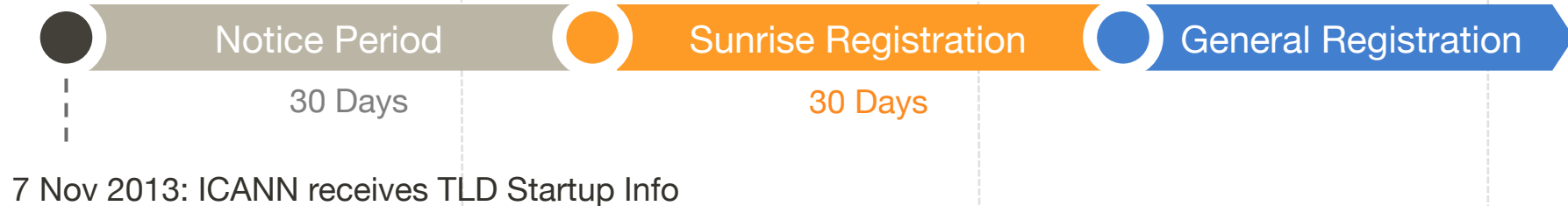
- + Allocation of names will occur only at the end of the period
- + Minimum 60-day period may commence as soon as notice is provided

In both cases, notice occurs when TLD Startup Information is submitted to ICANN

Sunrise > Start-Date vs. End-Date

Start-Date Sunrise

Trademark-related domains registered on first come, first served (or other) basis



End-Date Sunrise

Collect requests for allocating trademark-related domain names

Sunrise Registration

Resolve conflicting trademark-related requests and allocate prior to General Registration



Nov 2013

Dec 2013

Jan 2014

* Chart depicts hypothetical Sunrise types with start date of 7 November 2013

Sunrise > Dispute Resolution

Sunrise Dispute Resolution Policy (SDRP)

required for all registries

- + Must be included with TLD Startup Information
- + Form and process is at discretion of registry
- + Engagement of a third-party provider is at the discretion of registry (not required)

Limited Registration Periods

Overview

- + Limited Registration is a period during which a Registry will accept only domain name registrations that meet certain criteria, as defined by the Registry. Limited Registration periods occur prior to General Registration.

Key Points

- + Limited Registration Periods (LRPs) are optional. A registry may choose to hold an LRP at its discretion.
- + An LRP may overlap with the Sunrise period, but all Sunrise names must be allocated before any LRP names.
- + Registries:
 - may offer as many Limited Registration Periods as they wish.
 - must offer Trademark Claims service during any Limited Registration Periods.

Trademark Claims Period

Overview

- + Trademark Claims period occurs during first 90 days of General Registration. Provides notification to registrants of matching TMCH records. Provides notification to rights holders with TMCH records of matching domain name registrations.

Registrar Obligations

- + Query the Claims Notice Information Service (CNIS) and display Claims notice to registrant where required.
- + Require acknowledgement from registrant to proceed with domain name registration.
- + CNIS may only be used for purposes of Trademark Claims

Claims Notice Template(s)

- + Notice to be displayed in English + other relevant language
- + ICANN will provide template in 6 UN languages

Approved Launch Programs

Requests

- + Registry requests may be sent to Customer Service Center
- + Full process as published at:
<http://newgtlds.icann.org/en/announcements-and-media/announcement-12nov13-en>
- + Presumption of Approval
- + Where registry has provided detailed descriptions in application
- + Where launch program has been approved previously for similar circumstances

Approval

- + ICANN reserves the right to consider requests on a case-by-case basis

“100 names”

- + Specification 5 of the Agreement: Registry Operator may Allocate or register to itself up to one hundred (100) domain names cumulatively over the life of the TLD.

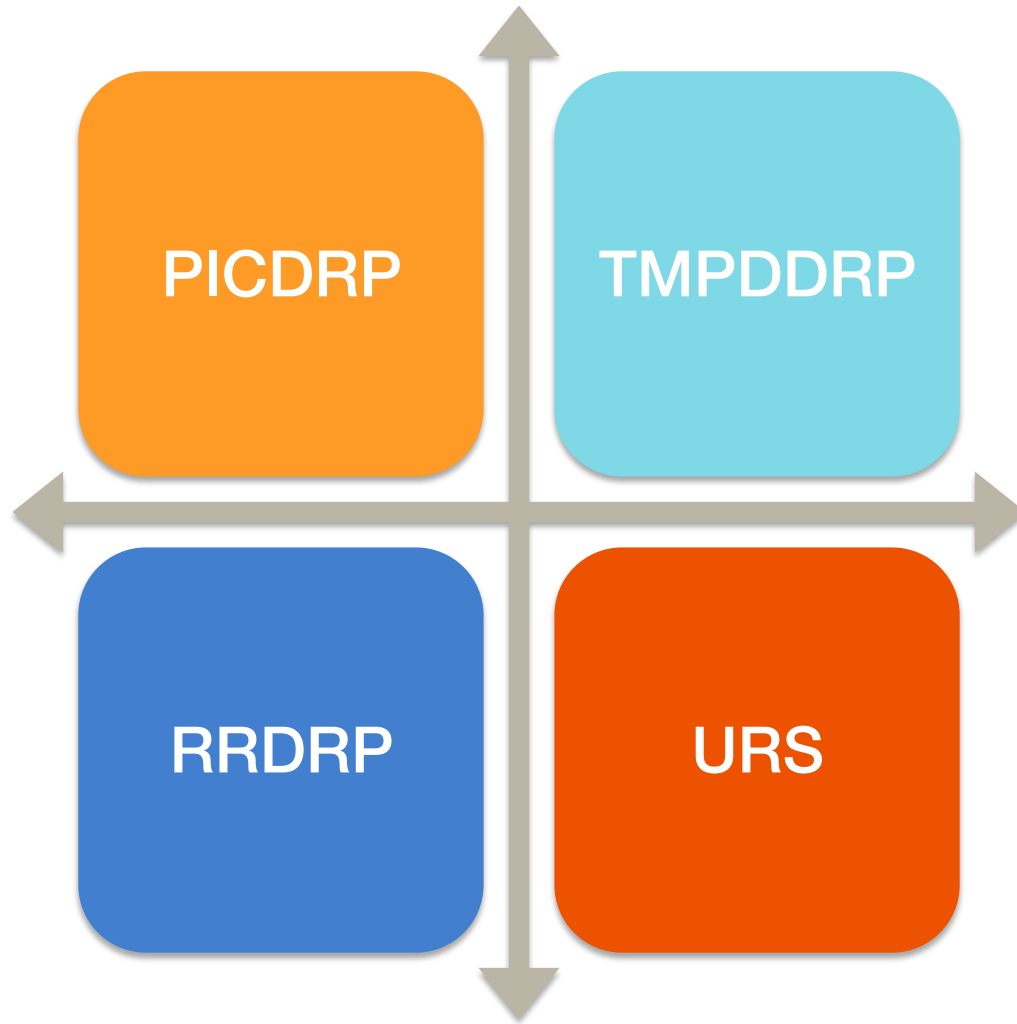
RPM Requirements: if a process for permitting registry operators to Allocate or register some or all of such one hundred (100) domain names to third parties prior to or during the Sunrise Period for the purposes of promoting the TLD (i.e., a “Qualified Launch Program”) is developed, this would be announced and incorporated into the requirements.



Post-Delegation Dispute Resolution Procedures

- » **Public Interest Commitment Dispute Resolution Procedure**
- » **Trademark Post-Delegation Dispute Resolution Procedure**
- » **Trademark Post-Delegation Dispute Resolution Procedure**

Post-Delegation Dispute Resolution Procedures



- + Public Interest Commitments Dispute Resolution Procedure
- + Trademark Post-Delegation Dispute Resolution Procedure
- + Registry Restriction Dispute Resolution Procedure
- + Uniform Rapid Suspension System



Public Interest Commitment Dispute Resolution Procedure (PICDRP)

Public Interest Commitment Dispute Resolution Procedure

What is the PICDRP?

- + A procedure to address reports that a Registry Operator (RO) may not be complying with one or more of its Public Interest Commitments (PICs) stated in Specification 11 of their Registry Agreement.

Public Interest Commitment Dispute Resolution Procedure

Two types of PICs:

+ Mandatory PICs

- May only use Registrars on the 2013 RAA
- Additional protections against abusive activity
- Periodic technical analysis of TLD
- Operate in a transparent manner
- Generic strings may not impose exclusive use criteria

+ Voluntary PICs

Public Interest Commitment Dispute Resolution Procedure

How does the PICDRP work?

- + Reports are submitted using web form on ICANN Contractual Compliance page
- + ICANN reviews complaints and works with RO and Reporter
- + ICANN makes determination or refers report to Standing Panel for a determination

Public Interest Commitment Dispute Resolution Procedure

Status of PICDRP:

- + Public Comment for Revised PICDRP
- + Closed on 14 November 2013
- + Next Steps:
- + Summary and analysis report in preparation (target: week of 25 November)
- + Report Submission form is available at <http://www.icann.org/en/resources/compliance/registries/picdrp/form>



Trademark Post-Delegation Dispute Resolution Procedure (TM PDDRP)

Trademark Post-Delegation Dispute Resolution Procedure

Procedure to address trademark rights infringement by a RO

- + Addresses situations where it is believed a Registry Operator is infringing, or actively participating in another's infringement, of trademarks in its TLD
- + Performed by ICANN-approved providers
- + Complaints submitted through provider website

Trademark Post-Delegation Dispute Resolution Procedure

TM-PDDRP Rules

- + Published on 15 October 2013

Three DRP service providers:

- + National Arbitration Forum
- + Asian Domain Name Dispute Resolution Center
- + World Intellectual Property Organization



Trademark Post-Delegation Dispute Resolution Procedure

To submit a complaint:

+ National Arbitration Forum

- <http://domains.adrforum.com/main.aspx?itemID=1929&hideBar=False&navID=>

+ Asian Domain Name Dispute Resolution Center <https://www.adndrc.org/index.html>

- [http://www.wipo.int/amc/en/domains/Intellectual
Property Organization](http://www.wipo.int/amc/en/domains/IntellectualPropertyOrganization)

+ <http://www.wipo.int/amc/en/domains/>

Registry Restriction Dispute Resolution Procedure (RRDRP)

Registry Restriction Dispute Resolution Procedure (RRDRP)

To address circumstances where a Community-based RO deviates from the registration policies in its Registry Agreement

- + To be filed by established institutions
- + Prior to filing a formal proceeding with RRDRP Provider, must file report with ICANN and ICANN reviews the initial report to confirm it states a claim
- + ICANN forwards to Reporter
- + If dispute is unresolved, Reporter may file a complaint with provider

Registry Restriction Dispute Resolution Procedure

Rules for RRDRP

- + Published on 15 October 2013

Initial Report form is available at

- + <http://www.icann.org/en/resources/compliance/registries/rrdrp/form>

One service provider:

- + National Arbitration Forum <http://domains.adrforum.com/main.aspx?itemID=271&hideBar=False&navID=203&news=26>



Uniform Rapid Suspension System (URS)

Uniform Rapid Suspension System

- + To resolve clear-cut cases of trademark infringement
- + Fast and inexpensive (< 500 USD)
- + For determinations in favor of the complainant: the domain name is suspended and lookups resolve to a URS information site
- + Largely a Registry Operator procedure

Uniform Rapid Suspension System

First URS case resolved:

+ facebook.pw

Two service providers



+ National Arbitration Forum

+ Asian Domain Name Dispute Resolution
Center

**Third candidate provider in evaluation

Uniform Rapid Suspension

To submit a complaint:

- + National Arbitration Forum

 - <https://secure.arb-forum.com/ddfiling/urs/>

- + Asian Domain Name Dispute Resolution Center

 - <https://www.adndrc.org/index.html>

- + ICANN Compliance Complaint Submission form

 - <http://www.icann.org/en/resources/compliance/registries/urs/form>

Thank You



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