BUENOS AIRES – Rights Protection
Monday, November 18, 2013 – 13:30 to 15:00
ICANN – Buenos Aires, Argentina

UNIDENTIFIED MALE: Hello. This is the Rights Protection meeting, 1:30 PM local time, Buenos Aires, on Monday, November 18, in the San Telmo room.

KRISTA PAPAC: We'd like to invite everyone to join us at the table so we can begin the session. Rather than having everyone sit in the back of the room behind us, we'd love to join you so we can see you. And if you have any questions, if you anticipate potentially having a question, please join us at the table so you have access to one of 50 microphones.

Good afternoon. We're going to begin the Rights Protection Mechanisms section for New gTLDs in one moment if you'd come to order. Please, feel free to join us at the table and at the microphones if you anticipate having a question. We have a presentation, and then we will follow the presentation with a question and answer session. Are the scribes ready? I'll turn it over to Karen Lentz momentarily.

KAREN LENTZ: Thank you, Krista, and welcome, everybody. What we wanted to do with this session is sort of take a step back and look at the rights protection initiatives that are a part of the New gTLD Program. Since throughout all the discussions and history in developing and implementing the program that we have today, trademark protection

was a key theme in those discussions and the program has been built to have strong rights protection mechanisms in it. So we're going to be discussion where we are in terms of many of those things, including the Trademark Clearinghouse, including some of the post-delegation dispute resolution mechanisms.

So I think most people here are probably familiar with this, but in the history of the program development it began in the GNSO policy development process informed by wide participation in that process, informed by advice from many of the other groups and bodies within the ICANN environment.

A key milestone there was a team of IP recommendations – that group was known as the IRT – who proposed a number of solutions, many of which were ultimately adopted into the program. A number of consultations on those proposals.

There was another multi-disciplinary team that examined that from a policy standpoint. That group was called the STI. Governments were involved through the form of the GAC, dialogue between the GAC and Board throughout that resulting in the current set of trademark protections envisioned for the new space. Next slide.

So this is meant to depict the mechanisms that are applicable to new gTLDs and how they may apply at different points in the life cycle. So the Clearinghouse is intended primarily to support the startup phases as new gTLDs are coming online. There's a required Sunrise and claims service for some initial launch periods. And then once those periods are completed there continue to be rights protection mechanisms that are

available, including the current UDRP, the new URS, and some of the post-delegation processes that we will talk about here. Next slide.

Right. So I'll review first the Trademark Clearinghouse, and I'll also mention that there is a session on Wednesday that's very much focused on the nuts and bolts of the Clearinghouse processes. We will have our partners Deloitte and IBM who are operating these services presenting that session in terms of detail and instructions for using the Clearinghouse. I will be discussing it from a project standpoint and some of the most recent developments around that.

So the Trademark Clearinghouse was proposed to be a single global repository for trademark data. It was designed to create efficiencies so that a rights holder wouldn't need to go many places and have the same information verified repeatedly every time a new TLD was launching and, similarly, that registries or registrars wouldn't need to develop their own verification systems or go several different places, but that there would be a single source that can be relied upon.

Another principle of the Clearinghouse and how it has been developed, the role of the Clearinghouse is to verify existing rights. It does not serve an adjudication function in determining which rights are valid or superior to any other rights, and it's not intended to create any additional rights. It's merely a set of records that's used for the purposes of TLD startups. Next slide.

So as part of the Trademark Clearinghouse functions, it will support the Sunrise and claims services that are required in all of the new gTLDs. The Sunrise is the initial period which gives trademark holders an advance opportunity to request names before they become available

generally. The claims services is essentially a notification service, and that's required in all new gTLDs as well for at least the first 90 days of general registration.

So that service facilitates notice both to a registrant that's attempting to register a domain name that matches a Clearinghouse record and then when the name does get registered, if it does, the rights holder will also receive a notification that the name was registered so they can determine whether they might need to take any action. Next slide.

This is an attempt to depict the various functions of the Clearinghouse and who is operating them. Some of the questions that we get reflect confusion about where certain questions should be directed, who is performing what function, and how does this all work together. So we've actually added to the Clearinghouse page an FAQ grid that sort of categorizes the types of questions and whether they would be questions for ICANN, questions for Deloitte as the verification service provider, or questions for IBM as the Sunrise and claims service provider.

So in this diagram in the middle you have the actual Clearinghouse database. The input to that database comes from the verification service, which is operated by Deloitte. The rights holders then primarily interact with Deloitte as the verification service provider. The output of the database comes at the Sunrise and claims services as registries and registrars are accessing and using that data. The Sunrise and claims services are provided by IBM who is the main point of contact for those services. Next slide.

The verification service I mentioned earlier this morning has been available for about six months. It was always intended that the Clearinghouse verification opportunity would be available in advance of any new gTLDs actually starting up. So since March, the Clearinghouse has been processing and accepting Clearinghouse records. There are a little under 17,000 currently.

Also as part of this, we have added a capability for additional labels to be associated with a Clearinghouse record once it has been verified. So if there is a UDRP or a court decision on specific labels that are associated with the particular trademark in the Clearinghouse, then those can be verified also and also included as part of the trademark claims service. The URL at the bottom is where you can find all of the information on the verification service. Next slide.

Sunrise and claims services, those are also live as of August and September. We have since then been providing access to the test environment in partnership with IBM who is cooperative in supporting a robust testing environment.

So once a registry agreement is executed, a registry operator does have access to the Clearinghouse test environment. We also are providing access to applicants who may not have signed an agreement yet but who have active gTLD applications. And the instructions for requesting that are on the second link down there. We're also facilitating access for ICANN-accredited registrars to go through and use the test environment as well.

The first URL at the bottom is where you can find the IBM information regarding their services, and the second has all of the where to go and

the manuals and things of interest to registries and registrars on those services. Next slide.

So one of the things that we have upcoming in the Clearinghouse technically speaking, it relates to what we call the SMD files. So each Clearinghouse record that has been verified to be eligible for a Sunrise period has available to it an SMD file that can be presented to a registrar to enable registration of names during the Sunrise. So many of those have been continually issued since we've had records in the Clearinghouse.

Initially, it was unknown when the first Sunrise would be, and Deloitte was offering an early bird period where records that were put in there early the clock didn't start ticking in terms of expiration, so there was some additional benefit to doing that. Because of that, we need to revoke and reissue the SMDs at some point so that the expiration will be aligned with the actual term of the Trademark Clearinghouse record. So we're working on scheduling and communicating that process.

From the user standpoint it should be simple. They will just need to as of a certain date go download a new SMD, and we're working heavily on how to communicate that clearly in advance to all the affected parties so that it can minimize the disruption. So we'll be publishing some more detail on that shortly. Next slide.

Okay, I'll turn to what we call the RPM requirements. This is something that has been in development for the last year or so. The RPM requirements are the requirements for how registries and registrars need to implement and perform the Sunrise and claims services that are required of them. So the specification 7 of the registry agreement

relates to rights protection mechanisms, and the set of RPM requirements is incorporated by reference into the agreement.

We have been discussing with the community for a while how to create a standard process, a set of minimum requirements that are followed across all gTLDs balancing that with the variety of business models that registries may have as they're starting up. So that process was completed. Toward the end of September, we posted the requirements that are now part of the registry agreement.

We've continued to provide some additional clarity and detail and information on some of the questions we've gotten around that. There's a webinar link that's available there. We've published some frequently asked questions and answers, and also in the last week we published a process for approved launch programs, which I will discuss in a later slide.

One of the, kind of the initial requirement of a registry as it's starting up is to provide a notice of what we call TLD startup information. And that information is collected so that it can be fed into a public resource that consolidates that so that the advanced look at what registries are doing Sunrise now, what's coming up, what are their policies, what are the things I need to anticipate for these upcoming periods?

As part of the TLD startup information the registry provides the relevant dates for its Sunrise, the complete Sunrise policies that will apply during that period. They will provide the dates of the claims period and their certification that the technical integration testing has been completed.

There are also, the registry has the ability to provide some additional periods that we term limited registration periods, which I'll describe. But those are optional, but to the extent that a registry is offering those and they have the opportunity to provide that so that it's reflected in the startup information and the complete look at the registry launches there. The information is being collected from registries currently. When they are ready to send it, they are submitting to the CSC at the NewgTLD@ICANN.org email address. Next slide.

Once ICANN receives that notice from the registry, that occurs once the TLD has been delegated, the information is received. ICANN takes the role of confirming the availability of the Sunrise and claims period dates with IBM as the service provider. The registry doesn't need to go to IBM separately. That has been folded into the same process.

ICANN will do a straightforward review of the information that's submitted, including whether the dates are compliant with the requirements, whether all of the necessary elements are included. And then once that has been reviewed, in the absence of any issues, ICANN would notify the registry and go ahead and publish that information. Next slide.

So once the notice has been provided and the date arrives, the Sunrise period can commence. A Sunrise is required for every new gTLD, and that occurs after delegation. The principles of the Sunrise here from a registry standpoint, all of the registrations need to be based on a valid Signed Mark Data file that's presented by someone trying to register a name. There's a link there for more information on what SMDs are and how that works.

Registries also in addition to requiring the SMD file can establish certain other registry-specific restrictions, such as restrictions on the date that the trademark was issued, restrictions on the class of goods or services. The TLD may have some community-based registration restrictions that all registrants need to have, or even if they're not community-based they may still have eligibility requirements for the TLD. So those can be applied during the Sunrise period. And additionally, every registry is required to have a Sunrise dispute resolution policy, and I'll say a little bit about that in a minute. Next slide.

There are a couple of options in terms of how a Sunrise period is structured. There is the concept of a start-date Sunrise or an end-date Sunrise. In a start-date Sunrise, the registry can allocate names throughout the period once it begins. That consists of a minimum 30-day notice before any allocation occurs and a minimum 30-day period where the allocations and registrations are occurring.

In the case of an end-date Sunrise, the registry may take requests during the period but is only allocating names at the end, and that is a minimum 60-day period which can commence as soon as the notice is provided to ICANN. Next slide.

This is kind of a visual look at what I was just describing. So in the top bar, you're looking at a start-date Sunrise which has a 30-day notice period and then the 30-day Sunrise period itself in advance of general registration. In the end-date Sunrise, you have a larger 60-day period in which the allocations occur at the end prior to general registrations still. Next slide.

This is something we've gotten questions about in terms of what's required in a Sunrise dispute resolution policy. So it is required that every registry have one, and that needs to be included with the TLD startup information. The form that needs to take and the process that the registry would follow is at their discretion.

We've gotten questions about whether ICANN has additional requirements and what that needs to consist of. Really, it's at the discretion of the registry in what would be appropriate. In that case, some may choose to engage a third-party provider, some may not. It's not required. So the registry needs to provide an avenue for disputes regarding names during that period, but they have flexibility to do that as appropriate for their TLD. Next slide.

Following the Sunrise, there may be what we call a limited registration period, and that would be a period that does precede general availability. There are still some sort of restrictions that are being imposed by the registry to be able to register a name during that period. This is not required. There may be registries who wish to do many of these types of periods. There may be registries who wish to do none. So they have any option they want in terms of those additional periods.

The limited registration period may overlap with the Sunrise, but in terms of actual allocation the Sunrise names do have priority over any limited registration periods. Next slide. I'm sorry. Can you go back? I just wanted to add one other point at the bottom which is that the trademark claims service does still operate during any limited registration period. So if a registry is offering one of those periods –

which they don't have to, but if they are – then they do need to offer the claims service during that period. Next slide.

The trademark claims period occurs then during the first 90 days of general registration. I spoke about the notifications that provides. The registrar has some obligations here when a name is subject to claims to query what we call the Claims Notice Information Service that's provided by IBM.

So when there is a name that's subject to claims, they can access and obtain the data that they need to display the claims notice to the registrant. They would then require acknowledgement from the registrant to proceed with the domain name registration. And that service is available for the purposes of trademark claims. The requirements provide that it's used only for that purpose.

We have a template of the claims notice available in the six UN languages. The guidebook provides that the notice would be displayed in English as well as another relevant language if there is one. Next slide.

The RPM requirements also provide for what we call approved launch programs. So this would be a case where a registry wants to do something in its startup phases that's not already provided for or permitted according to the RPM requirements. That process has been published. It's a tiny link there, but I hope you can see it. And the requests for that are being submitted to the customer service center.

There is consideration that ICANN gives to a registry specific request. What are they proposing? What are the details? How does it support what the registry is doing in terms of its goals for the TLD? Does it raise

any concerns in terms of creating an issue for rights protection? Does it raise any other concerns in terms of consumer confusion and how names are being allocated.

So in this process, there is a presumption of approval. In some cases, one being where the registry has in its application provided a detailed description of the launch program and there wasn't opposition or concern expressed throughout any of that period when those were being reviewed. And then where a launch program has been approved previously for someone in similar circumstances there would usually be a presumption of approval as well.

We would still consider each request individually and consider that as a unique case. Next slide. Sorry, Nicole, can you go back one? I just wanted to add in terms of the approved launch program process that we have a handful of requests for these that have been submitted, and we are actively reviewing them as we speak.

So some of the questions that we've received on the process relate to, what's the turnaround time and when can I expect an answer to this? Because these are the first few that we've done, it's hard to predict exactly how long it will take, but we certainly intend to turn them around as quickly as we can so that it's not a barrier to a timely launch. Okay, next slide.

Another subject that we've gotten questions about it's titled "100 names." And depending on what somebody is referring to or talking about the answer is a little bit different. So I've tried to create a little bit of clarity here if I can.

Specification 5 of the agreement, which is the schedule of reserved names, provides that the registry can allocate or register to itself up to 100 names, and that's over the life of the TLD. There's not a restriction on when those can occur. So the registry has the limited amount that it has available to it to use in terms of allocating to itself.

The RPM requirements make a reference to 100 names as well relating to a specific process that potentially could be developed for use of some of those 100 names to allocate to third parties and there's interest in being able to do that prior to or before the Sunrise for the purposes of promoting a TLD. And so the term used for that is a qualified launch program.

I want to emphasize that the qualified launch program does not yet exist. The intention with that would be that it would be something that's generally applicable. So if a process can be developed, which since those were posted we have been working on developing, but that would be something that the registries would be permitted to do without any additional action but subject to those details.

In the meantime, people have asked, "Well, does that mean I can't do anything else like this?" The request for use of the 100 names or some other type of allocation to third parties can still be requested as an approved launch program, which is the process that we do have available and are processing requests for. So that is still available in the interim before a general process is developed. Next slide.

Okay, I will turn it over to Krista who will talk about a number of post-delegation dispute procedures. Thanks.

KRISTA PAPAC:	Thanks. Hello, everybody. Next slide. So in the registry agreement, there are four different post-delegation dispute resolution procedures that Internet users can utilize in the event that they feel they have something they'd like to report. The four procedures are the Public Interest Commitments Dispute Resolution Procedure (PICDRP), the Trademark Post-Delegation Dispute Resolution Procedure (TMPDDRP) – this is a quiz in acronyms – the Registry Restriction Dispute Resolution Procedure (RRDRP), and then the Uniform Rapid Suspension System (URS). Next slide.

So Public Interest Commitments Dispute Resolution Procedure (PICDRP). Next slide. So what is the PICDRP? It's a procedure to address reports that a registry operator may not be complying with one or more of its public interest commitments as they're state in specification 11 of the registry agreement.

There are two types of PICs. There are mandatory PICs, which resulted from a couple of different rounds of GAC advice, and then there are voluntary PICs, which also resulted from GAC advice. The mandatory PICs are just that. They're required by all registry operators. The mandatory PICs require a number of things of the registry, the first being that the registry must only use registrars that have signed a 2013 Registrar Accreditation Agreement (or RAA).

There is a provision in the mandatory PICs that the registry operator [in its] registry registrar agreement require the registrar to include in their registration agreements with registrants protections against abusive activity, such as distributing malware, abusively operating botnets,

phishing, piracy, trademark or copyright infringement, fraudulent or deceptive practices, counterfeiting, or otherwise engaging in activity contrary to applicable law.

There is also a requirement in the registry agreement that the registry operator conduct periodic technical analysis of the TLD to determine whether domains in the TLD are being used to perpetrate security threats, such as pharming, phishing, malware, and botnets.

There's a requirement that the registry operator must operate the TLD in a transparent manner and that generic strings, generic TLDs, may not impose exclusive use criteria.

The second type of PIC, voluntary PICs which there were a number of applicants some who have now become registry operators who submitted voluntary public interest commitments. There's a wide range of voluntary public interest commitments, but to give a few examples, we've seen additional trademark protections provided, additional abuse mitigation procedures, privacy protections, and rules around acceptable use. These voluntary public interest commitments are incorporated into the registry agreement for those applicants that become registry operators that submitted them. Next slide.

So the PICDRP itself has just finished its second public comment period, which I'll talk about a little bit more on the next slide, but the most current version that was commented on, the way that the process works or the way that the PICDRP works is that a reporter submits using a Web form. They submit a report to ICANN's Contractual Compliance department. ICANN reviews the complaint and works with the registry operator and the reporter.

And there's a requirement in there where ICANN does a preliminary review. Assuming that the report passes the preliminary review, the registry operator and the reporter are asked to work together to resolve the issue. And if it gets past that point, then ICANN compliance will either make it a determination. Or if it's something that's outside of ICANN's area of expertise, then ICANN compliance would refer the report to a standing panel for a determination. Next slide.

So as I mentioned, the PICDRP just concluded its second public comment period on November 14. That second PICDRP is called the Revised PICDRP. The next steps are ICANN is evaluating the comments that we received and compiling our summary and analysis with a target of posting that report of summary and analysis sometime next week. We do also on the compliance Web page there is the ability to submit a PICDRP report right now. That is so that compliance can take those reports as we're working through finalizing the procedure itself. Next slide.

Trademark Post-Delegation Dispute Resolution Procedure (TMPDDRP). So the TMPDDRP is a procedure that addresses trademark rights infringement by a registry operator, so situations where it's believed that a registry operator is infringing, or actively participating in another's infringement, of trademarks in the TLD. The TMPDDRP is facilitated by ICANN-approved providers, much like you see with things like the UDRP, and complaints are actually submitted through the provider's website rather than through ICANN. Next slide.

So the TMPDDRP was finalized some months ago. We published the rules, almost rules of engagement if you will, on October 15, which can

be found on the microsite. And ICANN has currently approved three TMPDDRP providers: the National Arbitration Forum, the Asian Doman Name Dispute Resolution Center, and the Word Intellectual Property Organization (WIPO). As far as operational readiness, the National Arbitration Forum (NAF) is currently operational to accept TMPDDRP complaints, and the Asian Doman Name Dispute Resolution Center WIPO are close behind and should be operational in mid- to late-December. Next slide.

Here are some links for you, which for those of you that like to download the deck, you'd be able to access where you can file complaints with the three different providers. Next slide, please.

Okay, here's the third set of acronym soup, so Registry Restriction Dispute Resolution Procedure (RRDRP). The RRDRP is a procedure to address circumstances where a Community-based registry operator is deviating from the registration policies in its registry agreement. So community applicants have an extra specification which is specification 12 where they detail the registry restrictions for that specific community. So if a reporter believes that those aren't being followed, they would utilize the RRDRP to lodge a report about that.

The requirements under the RRDRP are that the person submitting the report is an established institution with an ongoing relationship with the community of that top-level domain. Prior to actually submitting a formal proceeding with the RRDRP provider, the reporter must first submit a report to ICANN where ICANN takes an initial review to confirm that there is a claim being stated. Once it passes that ICANN

initial review, then the reporter is asked to formally file a complaint with the RRDRP provider. Next slide.

So for the RRDRP we currently have one provider, which is the National Arbitration Forum. They are currently operational, and these links here let you know where you can file the initial ICANN report and then subsequently where you would file the RRDRP complaint with the NAF. Additionally, we published the rules also for this procedure on October 15. Next slide.

Alright, Uniform Rapid Suspension System (URS). So the URS was developed to resolve clear-cut cases of trademark infringement. It's a fast and inexpensive way to resolve these cases, with the fee being less than $500. In cases where the determination is found in favor of the complainant, the domain name is suspended and lookups resolve to a URS information site. This procedure itself is largely a registry operator procedure, so there's not a lot of interaction between the register but mostly between the registry, the complainant, and the URS provider.

We have two service providers for this as well. It's National Arbitration Forum and the Asian Domain Name Dispute Resolution Center. We currently have a third candidate that's interested in becoming a URS provider that we are beginning the evaluation process with. The NAF is currently operational, and the Asian Domain Name Dispute Resolution Center is also operational. Lastly, we actually have our first URS case that has been resolved, which was facebok.pw. So I guess the system works, or at least it did for that one.

To submit a complaint, again here are the Web addresses for the two providers. And in cases where a determination is made and the

determination is not being adhered to, a complaint can be submitted with – we call it a compliance complaint – can be submitted with the ICANN compliance department, and we've provided the link to do that.

And that concludes the post-delegation dispute resolution procedure presentation.

UNIDENTIFIED FEMALE: Okay, so questions. I'll do my best to moderate. Okay. Jeff, Dirk. Okay, [inaudible]. Let's start there. Go ahead, [Jeff].

[JEFF]:   Hi. Thanks. Thanks for the presentation. That was good. A lot of detail, so you guys have done a lot of work. Can I ask a question on the definition of allocation when you talk about the Sunrise? So there has been, you may have seen some articles written recently about different interpretations of the word allocation when you're not allowed to allocate names prior to Sunrise. I'm summarizing that rule basically. But there have been some unique interpretations of that. Can you in your own words kind of provide some guidance and clarity as to what ICANN means by the term allocation?

KRISTA PAPAC: Thanks, Jeff. So I will try to use my own words. There is actually a definition of allocation in the RPM requirements itself, but I would distinguish it from a "I would like to have this name. I'm interested in this name" and a "I could put my name in the WHOIS as the registrant for this domain name." In terms of how people are understanding or

interpreting the language that is in the RPM requirements, we have seen some of the discussions around that. And not knowing the details of what exactly the registry is doing, it's hard to comment on how it complies or it doesn't comply.

But certainly the community worked very hard on developing the rights protection mechanisms and developing these implementation details. So I can say that our compliance team is very well up to speed on what these requirements are. And because we are in early days, we are taking seriously the expectation that the registries will be acting in line with these. And so I think the goal is to have things smoothly running, and where there are issues or questions that those can be addressed quickly so that we have an understanding, everyone has an understanding of how things are working. Okay, Dirk?

[DIRK KRISCHENOWSKI]:   Yeah. I'm coming back to a basic point of the TMCH eligibility. You said in the beginning that the TMCH should not create any new rights or other rights. And we had asked ICANN what about the trademarks containing a dot? These are exempted of the TMCH? And we have trademarks like the city portal of Berlin has a trademark Berlin.de. It's not [illegible]. We ourselves as a registry have a trademark starting with a dot, .berlin in the European trademark registration. And there was no rationale provided why these trademarks have been exempted, and we think that creates an unfair and unreasonable exemption and creates new rights not allowing those trademarks with a dot inside.

KRISTA PAPAC: Thank you, Dirk. So first, thank you for your letter. I can say that we did receive it, and I know if you haven't received your response yet, there is one that I've seen being drafted. So your question is about the rule that is actually part of the applicant guidebook saying that trademarks with a dot are not accepted in the Clearinghouse. That was a restriction, I guess, that was developed as part of creating the Clearinghouse during the development of the program. So it did appear in at least a few of the draft applicant guidebooks, and there was comment on it that was reviewed and responded to. And essentially the rationale was that, one, from a legal standpoint there was trying to maintain the principle that trademarks are an indicator of source as opposed to a domain name which was considered a little bit differently. In addition, I think there was a concern that people would go try to register trademarks with dots as part of claiming a right to get certain domain names or certain TLDs or that the interaction of the domain name system and the trademark system could interact in a way that would lead to not necessarily the desirable results. So there is a history to that. I do certainly understand the concern, and there have been other comments like that about those types of trademarks, but currently that is the rule that's in place. [Amadeu]?

[AMADEU ABRIL]:   [inaudible] I have some requests for clarification on things that I think I understand from what Karen has explained here. So please understand, I'm not trying to trick you. I'm just trying to see whether I got it correctly and also what we got from customer service.

First, regarding the Sunrise dispute resolution policy. Our assumption that's apparently wrong is that this was intended to be a traditional dispute resolution policy handled by an external dispute resolution policy. What we understand now is that this is optional. That is it could be an external dispute resolution provider or an external individual. I may appoint John Berryhill and Karen Lentz to solve the disputes. Or that this can also be solved by the registry itself as an internal reconsideration policy. Is that correct?

KRISTA PAPAC: Yes, I think so. So in many cases, the registry might wish to engage certain expertise or services that are already available. In other cases, the registry might have a specific community or industry channel where it would make sense to process those complaints in a different way. So the answer to your question is yes. There's flexibility to the registry.

[DIRK KRISCHENOWSKI]:   Thanks. We still believe it makes sense to have an external provider but perhaps not for exclusive [inaudible] TLD. But anyway, thanks for the clarification.

The second clarification is if I got it correct, I mean, is regarding 2311 and the limitations you can apply to trademarks. And one is it says clearly the jurisdiction of the trademark record. Now please help me. This means the jurisdiction in which the trademark has been registered or is not only the jurisdiction of the trademark holder legal seat or residence, correct? That is, I may say .buenosaires is only for trademarks in the Argentinian [inaudible]. This is correct according to 2311, correct?

KRISTA PAPAC: Yes. There are two different things at issue that the registry may choose to employ either one. One is where the trademark was issued, and the other is the jurisdiction of the registrant which registries can already do apart from the Sunrise or any of these issues. So there are two jurisdictions that could be in play, and they're independent of one another in terms of what a registry might wish to do.

[DIRK KRISCHENOWSKI]: Okay. And I have a topic that's longer, so perhaps I will allow other people to go ahead and I may go back through the line later. But I have a suggestion for ICANN. Why don't you publish the request application you have for approval [inaudible]? [inaudible] some. We know that this created some [anxiety] on what are people asking, what will be approved.

You will publish the result, but we are not proposing a public comment period, a formal thing. But I will think the default in ICANN should be transparency, so if you get a request, why don't publishing the request while you're [inaudible] that. I think it would help all the community here to have an idea what's going on. It will help even calming down some anxiety there is about what will be approved one day. And we all will learn from that. Thanks.

KRISTA PAPAC: Thank you for the suggestion. We'll take that.

KAREN LENTZ: Thank you. We have one question from the [inaudible] remote.

UNIDENTIFIED FEMALE: The question from the remote participant is, "New York City has 355 historic neighborhoods. What is the process by which we can segregate and assign these names some of which are otherwise trademarked, for example Corona beer versus Corona neighborhood, to appropriate local entities?"

KAREN LENTZ: Thank you for the question. So I think it really could vary in terms of what exactly the registry wants to do in terms of allocating names according to its procedure and when it wants to do that. If the registry is wanting to do something in regard to, for example, names of neighborhoods that wouldn't otherwise be permitted according to the RPM requirements, the registry can submit the specific proposal as to how it would like to account for those names in its startup phase if it is relevant to the startup phase and that can be considered on an individual basis.

KRISTA PAPAC: Thanks, Karen. I'm so sorry.

[CLAUDIO]:   Claudio, from the IPC.

KRISTA PAPAC: Claudio.

[CLAUDIO]: I have two questions about Sunrise. Is there a requirement that a registry/registrar contract be signed or be in place before the registry can initiate a Sunrise period?

KRISTA PAPAC: Do you want to say the other question?

[CLAUDIO]: Is there a requirement that a registry/registrar agreement be in place or if the registry is [inaudible] integrated, does that have to be in place before the Sunrise can start?

KRISTA PAPAC: Okay, thanks. I was going to ask if you wanted to say both of your questions first.

[CLAUDIO]: The other one is, are there any minimum requirements for the SDRP?

KAREN LENTZ: Okay, so the first question. Is there a requirement for an RRA to be in place prior to a registry doing a Sunrise period? And I'll look at legal team over here. I don't have the registry agreement in front of me, but I don't think there is. There is a requirement that they make available an RRA for registrars.

[DAN]:   Thanks, Karen. I heard the question earlier today, and I think we'll look at that. As we're getting started on this and the first ones are coming through, we're going to get questions like this. And I'm sure by the time we get up and running and we have lots of TLDs going and lots of registrars signed up, but we're at the very first ones and the first registrars coming on and the first registries coming on. So I think we're still having some shakeout. But we'll look at that question.

I think you would have an issue. Let's say a registry started up what they called a Sunrise and went through the whole thing and never had a registrar so it would be impossible for them to fulfill an order. I think that would be a problem. I don't think you'll see that. I mean, registries now, they're starting. They want to make sales. They're going to get it going. It's just some shakeout and issues getting started, I think, getting registrars on and getting registries on. Registrars have to pass and be certified with the Clearinghouse too, so I think we'll get there.

[CLAUDIO]:   But just in terms of now, there could be TLDs that are doing Sunrise and have no registrars signed up.

[DAN]:   Yeah, I think somebody said there is one today. So again, and if you think about what doing Sunrise means, sometimes that's just sort of a notice period that, "Hey, we're starting to take orders. We're not really going to allocate anything for 60 days now." So I would trust that by the end of that or in the middle of that, shortly they'll be up and running.

But there might be a situation right now, which I heard there is, where you've got one going but there's no registrar yet signed up.

KAREN LENTZ: Thanks, Dan. And then on the second question, are there any minimum requirements for the SDRP? So initially, I think it goes all the way back to the IRT, there were four types of cases that the SDRP was supposed to be able to handle. As we went further down the road in terms of implementing the Clearinghouse and having those available, some of those were covered already by the Clearinghouse dispute resolution processes. So the challenge procedure is there regarding a record that should or should not have been accepted.

And then the one that wasn't covered is if a registry were to register names during the Sunrise period that weren't associated with a valid SMD. So maybe I presented you an SMD, but it didn't say that I could get that name. That is also, I think, fairly unlikely because it's part of the registry requirements that they check that, but that's one case of dispute.

And then since the registry is often doing registry specific things in its startup it's really going to vary what types of disputes would be relevant and would need to be handled and how they would be handled by the registry, what would be the facts or circumstances that were giving rise to the dispute. So we have not given any other specifications in terms of what must be included.

I will say that it is a requirement that when the registry's startup information is included that it does include that, so they need to have

one. And certainly for the first few we are trying to be very informed about what the registries are doing so are paying attention to those as well.

KRISTA PAPAC: Okay, I've got Werner, Philip, and Jim in the queue. Then I think we have the chat. And I have Kristina, Tony. Sorry. Let me do this side. Who else wanted? Dirk again and Amadeu? Okay. Werner, please.

[WERNER]:   Okay. Thank you. Good afternoon. My question is about how to deal with abuse of the Trademark Clearinghouse, specifically the practice of putting trademark that are real trademarks and they're registered that are designed to get a generic term registered specific in the register that may have to be extremely sensitive to that, for instance, geographic TLDs.

I'll give you an example. Somebody gets a trademark "health & care" – I've seen "Gen & eva" for Geneva – so "health & care." That's a valid trademark. So it goes through, and one of the strings protected is healthcare. So that SMD file is sent to one of the registries. It happened not to have specifically put that on the list. They haven't seen that, but they're watching it.

And then it turns out there's a privilege. There's a right. This party should actually be getting healthcare.nyc, healthcare.london, healthcare.paris should be going to that party. Now, of course, if the registry does its job as I would expect it to, it would not let that happen

because it is bad for the reputation of not just the TLD but the entire city.

Now, what can be done in such a case? We have solutions, but I'm not quite sure how we would handle it in the context of the trademark Clearinghouse rules.

KAREN LENTZ: Thank you, Werner. So your question is about a trademark that has been issued that someone might question whether it should have been issued as a trademark. The Clearinghouse does not have a mechanism to distinguish or to review the actual decision to issue the trademark. The Clearinghouse collects the information. It records the information, and then it gets fed into the Sunrise and claims systems as you talked about.

So in terms of accepting things in the Clearinghouse, as it currently stands the Clearinghouse does not have a mandate to do its own review or apply its own judgment in terms of whether a particular trademark is valid. It's verifying that the information is accurate in terms of what has been issued in that jurisdiction.

For a case where maybe something registered as a trademark with the intent to abuse, there are dispute resolution procedures already existing in terms of names that get registered. And as we just discussed, there are Sunrise dispute resolution procedures. So I understand the case that you're outlining. The way that the Clearinghouse has been designed and built, it doesn't have a role in taking steps against something like that.

But you mentioned you are thinking or might have a solution, so perhaps we can talk offline about what your ideas are.

[WERNER]: Okay.

KRISTA PAPAC: Okay, and next we have Phil.

PHIL CORWIN: Thank you. Phil Corwin asking on behalf of the Internet Commerce Association. My question relates to the trademark claims notice. The purpose is to provide the potential registrant with notice that the domain they are seeking to register is a match to a term registered in the Clearinghouse and to give them notice of the rights of the person who is registered at the Clearinghouse so that they can determine whether they wish to proceed and perhaps be subject to a UDRP or URS or even litigation or wish to withdraw.

And it was fairly simple when it was just going to be trademarks in the Clearinghouse because you get a notice that it's either a unique trademark or a generic word for these goods and services is registered in these jurisdictions and you can make your decision. But we've added trademark plus 50, which provides trademark holders with the right to register up to 50 variations of a mark that have been found to be infringing in a URS or in a UDRP or in a court case.

And so suddenly the description of the rights is different. Clearly a trademark holder has rights in a trademark but in a previously lost term

in a UDRP is really not that kind of rights. There may be a potential right to object if it's being used in an infringing manner, but the fact that it has been lost before is not determinative.

So I had submitted a letter on behalf of the Association suggesting that the notice differentiate between very strong rights in a trademark and the different rights in a variation and also provide the potential registrant, many of whom will not be sophisticated parties, with a link to either the UDRP decision or at least a reference to the court case so they could look at it and determine whether it applied to them or didn't and make an informed decision. And nothing changed with the trademark notice. There's no differentiation between the rights. There's no link to that type of information.

So I guess my question is, is that a lockdown or is there still some change to provide the potential registrant with a clear differentiation and with a link to more information so they can make a fully informed decision? It's not just a situation with the registrant. It's also for the registries. A lot of registrants, again particularly without legal counsel and without the desire or means to pay for it, will simply withdraw and not make the registration when in fact they may have a right to do so depending on their intended use.

KAREN LENTZ: Thank you, Philip. Yeah, so in terms of the claims notice, the language in that notice was very carefully worked on by many in the community because of the goal of being very clear about this group of rights and what the implications might be for the party that is trying to register the domain name. So the text in the beginning about you may or may not

be entitled to register depending on the laws of your country, etc., there are a number of caveats in there. So I think that still applies. That language still applies to the case where you have some additional labels via a UDRP or a court decision.

So when we were adding the service for the additional labels to become part of claims, we actually did differentiate in terms of here are the records that match the name you're trying to register. Here are some names that were the subject of a UDRP or a court decision.

So I think the general text about you need to look at the specific case still apply, but we do have the notice as it has been updated. If you look at the latest RPM requirements that were published, there's a sample notice in there. But those make the distinction, and in the example of the UDRP or court case, it does include the reference number and the data that would enable a registrant to see what the actual case was in those circumstances.

KRISTA PAPAC: Okay. We're going to go to Jim Prendergast and then to the chat.

JIM PRENDERGAST: Yep, thanks. Jim Prendergast with the Galway Strategy Group. Question about the startup plans, since they are in essence an exception to the rights protection requirements, what criteria will ICANN staff be using to evaluate those startup plans and will that criteria be published? And then just a follow on to that, when there are launch plans that are approved that are exceptions to the rights requirements will a whitelist of approved launch plans or techniques be created or do applicants

have to go look at all the previous launch plans that have been out there to see what has been approved and what hasn't? Thanks.

KAREN LENTZ: Thanks, Jim. So as the process is drafted, there are really two I'll call them criteria that ICANN would be looking at in terms of a proposed launch program, which I think is what you mean. And those could contribute to infringement of intellectual property rights and could this cause issues of consumer confusion.

So there are cases that the registries have been describing where they are seeking an exception to the RPM requirements not necessarily for the purpose of weakening rights protection or infringing anybody but to do something that is supporting the community or target audience for their TLD. So that's one of the things that's part of the review is does this have a detrimental impact on the overall rights protection goals.

The other kind of going along with that is consumer confusion and whether the way that names are proposed to be allocated is going to result in something that would be counterintuitive in a way that sort of destabilizes the TLD.

And then your second question was about approved programs and a whitelist. So we haven't done any yet, so we don't have that currently. We have provided that if a program has been approved in one case and more TLDs that are similarly situated come along and ask for the same thing, there would be a presumption that would be approved. It could be that there becomes a program that is approved and [inaudible] that

people find positive and haven't been any concerns raised. There could potentially be something like that, but it's not…

JIM PRENDERGAST: So essentially no plans right now for one central repository of those approved launch plans that are outside of the RPM requirements?

KAREN LENTZ: No, not currently.

JIM PRENDERGAST: Hunt and peck is what you're telling me? Read through them all? Will you create a list of, "Here are launch plans that we've already approved that deviate from a standard launch plan"?

KAREN LENTZ: Okay. So, yeah, I understand the request. Once they're approved, they'll be published as part of the startup info, and we haven't specifically contemplated creating a repository but we could.

KRISTA PAPAC: So we'll take the question from the chat [inaudible].

UNIDENTIFIED FEMALE: From remote participant Connie of IP Mirror, "Can I please trouble you" – was it Karen? My apologies if I'm wrong – "to clarify what said about time period of initial SMD files were for two years and that SMD files will transit to actual number of years applied for? Are you saying that

initial SMD files are valid for two years even if they were registered for one year? And if so, when is the cutoff date for registered trademarks to adhere to the time periods that they were registered for?"

KAREN LENTZ: Okay. Thank you for the question. This relates to my slide about the initial issuance of SMD files and the coming update to those. The reason they were initially issued with a two-year term is we were issuing them before we knew when any TLDs would be in a position to be launching when the SMDs would actually go into use. And so we sort of estimated conservatively and wanted to make sure that there was ample time for them to actually be useful, and so they were issued for a two-year term. So all of the ones that we have right now have that term regardless of how long the actual record was submitted for.

When we do the transition, the expiration dates will align with the actual length of the record. And so there really isn't anything that the rights holder needs to do or a deadline that they'll need to follow once the old one is revoked. And the date for that will be pre-announced and communicated strongly. But all they will need to do is go get the new file and start using it.

KRISTA PAPAC: Do we have any more questions in the [inaudible].

UNIDENTIFIED FEMALE: Two more questions from the remote participants, Volker Greimann, "Please provide reasoning why a claims notice confirmation by the

prospective registrant may not be more than 48 hours old, especially in cases where the notice has not changed since the registrant accepted an older notice at the time the registration is submitted to the registry. The current model breaks the pre-registration model that is standard for launches."

KAREN LENTZ: Hi, Volker. I will try to get confirmation on this question, as I'm not the technical spec expert. But I believe in an earlier iteration of the specifications, both the SMD and the claims acknowledgement had a validity period in terms of the turnaround for how long a registry could continue to treat something as current. I thought we got rid of all of those, so there may still be a different requirement than the one I'm thinking of. So I will get back to you on that and make sure that's clear for everybody.

UNIDENTIFIED FEMALE: Thank you. One more. Thank you, and the last question from [Dante Vermeer]. Question, "I'm a trademark holder registered in ICANN's trademark Clearinghouse. I paid for my verification, but now it seems that local geoTLDs are creating additional limited registration periods that can even run simultaneously with a Sunrise. I find this very confusing, and I'm afraid this will cost me extra. Which guarantee does ICANN give to trademark holders that the prices during Sunrise will be kept at a fair level in comparison to those LRPs?

KAREN LENTZ: Thank you for the question. In terms of the value of submitting your mark in the Clearinghouse and having that verified, in the cases where the Sunrise eligibility is verified that does create an advantage in terms of timing because the Sunrise allocations do need to precede the limited registration period allocations of names.

So you might have periods running concurrently where requests are being taken for those that meet Sunrise eligibility and requests are being taken for names that would meet limited registration period eligibility, but the Sunrise allocations are all required to occur prior to any of the allocations of the limited registration period. So I just want to be clear on that.

The pricing is at the discretion of the registry and registrar, so that is not an aspect that's part of the requirements from ICANN. Thanks.

KRISTA PAPAC: Okay. Thanks, Karen. I've got Kristina, Tony, Dirk, Amadeu, and Claudio in the queue, but we have eight minutes left so let's see how far we get through and if we can take any more time. Thanks.

KRISTINA ROSETTE: Great. Thank you. Just a quick follow up on a question that Jim asked part of, with regard to for example the kind of [inaudible] "unless ICANN reasonably determines that such requested registration program could contribute to consumer confusion or the infringement of intellectual IP rights," first let me just note that I obviously am very pleased to see that there.

But I was wondering to the extent that you've developed any criteria for not only flagging when that determination might be necessary but also what criteria are used to actually make the determination. If those criteria exist, I think it would be very helpful for the entire community – registry operators, IP owners, etc. – to be able to see those.

And similarly, again as a follow up to Jim just perhaps a step further, that I think it would be very helpful when the launch programs that have been approved are published for there to be some kind of note about no determination of consumer confusion or IP infringement was deemed necessary or we thought the determination was necessary and we made the conclusion, just so that everybody is clear as to where everything is lining up. I think that would be really helpful, so thank you.

KAREN LENTZ: Thanks, Kristina. I'll just note those suggestions so that we can go on to questions. But in terms of potentially more detail on the analysis and the factors of the process, that's one request. And then in terms of how something gets approved and providing the rationale and detailing that, I'll take both of those. Thanks.

KRISTA PAPAC: And Tony.

TONY ONORATO: My question concerns claims notice and the UDRP and URS. The question is, is there an intent on ICANN's part for how much weight a dispute resolution provider ought to put on claims notice in the fact that

the registrant received the claims notice in establishing bad faith or in the case of URS in particular that you've met the clear cut infringement standard, the high standard there?

UNIDENTIFIED MALE: Thanks. I don't know. I'd have to go back and look, I guess, at the text of the URS and it wouldn't be addressed in UDRP, but I think the idea is back from when that idea first came out from the STI was let's put that out there and then it would be up to, I guess, the panelists and the parties to argue that or use that as evidence. Definitely in the UDRP it wouldn't be addressed, but I'd have to go look at the URS.

TONY ONORATO: Okay. So it's just a matter at this point in time it's unclear what weight the panel might put on the fact that they received claims notice in establishing the evidentiary standard you need to meet?

UNIDENTIFIED MALE: Yeah. I hate to comment more without going and looking at the URS, but definitely it would be up to the parties to make whatever arguments they could out of the fact that that name was subject to a claims notice.

TONY ONORATO: Thanks. I appreciate it.

KRISTA PAPAC: Dirk we have in the queue.

[DIRK KRISCHENOWSKI]:   Yes, we had a meeting with our geo top-level domain names, and the question from New York City about the names that they reserved already in their application like all the other geoTLDs did last year and the local Sunrise phase as a lot of geoTLDs have were allowed last year in our applications. And we did the best to serve our interests and the interest of the city.

And we are all surprised about these RPM requirements that for cities like New York need to apply for an exemption what was before allowed. And that's something we still don't get why this is there now and we need all to apply for our interests here.

KAREN LENTZ: Thank you, Dirk. So in terms of the process that was used, spec 7 of the registry agreement requires the registries to offer a Sunrise and claims period. And there was always a blank reference in that in terms of in accordance with these set of procedures or requirements to be developed. And so that's what the RPM requirements do is to establish and define how registries need to do that.

You've expressed that applicants at the time they were applying didn't have that level of detail available to them and were in good faith applying and developing programs. And so that's understood as well. That's why we've accounted for a consideration of exceptions, and in that consideration one of the factors that can create a presumption of approval is that these detailed plans were included in the application, there was extensive opportunity to review and raise any concerns. So

we tried to respect as much as possible that effort that applicants have gone to without hollowing out or weakening the minimum set that all of the registries are expected to do.

KRISTA PAPAC: Okay. We have two minutes left. Amadeu, and then I may need to cut off the queue at that point. Yes, Amadeu.

[AMADEU ABRIL]: Okay. The question is regarding the claims service and the pricing of the claims service. As I said, we don't have a concrete final price of the initial price we have, but we heard the price for the mandatory 90 days for the claims service will be the same if we extended that, and I would just submit that I think that is a very bad idea. That is wrong incentive.

The idea is that if claims service is a good thing, it should be a good thing beyond the 90 days. Let's imagine that the price is 15 cents or 20 cents or whatever. Why pay in 20 cents forever for any new registration no matter what whether there is a real match with an existing record [inaudible] or not.

I would encourage ICANN to revisit that, if that's a decision that I repeat we don't know, and to have much lower prices after the end of the 90 days to encourage registries to apply for longer but then with a higher price when a concrete match with a concrete [inaudible] happens. That's the [magical] principle of any good policy: pay as you pollute.

So those that have a [inaudible] TLD name [inaudible] where there are very little conflicts with trademarks should not be paying exactly the

same as people that don't take any care about that because the result if this is the situation that we will be paying 15 cents or 20 cents forever for any registration no matter what happens with an existing trademark record or not in the Trademark Clearinghouse, the solution is we will only do the 90 mandated dates and that's all.

KAREN LENTZ: Thank you, Amadeu. I understand your comment, and I know you asked the question in the earlier session. And I'm sorry, I haven't had a chance to look at the detail on that yet, but I did note the request for us to take a look at that. Thanks.

KRISTA PAPAC: So I'm going to, Claudio, let me take your question offline. There are other sessions starting at 3:00. There's an SSR session starting at 3:15. I'll make sure that we get that other question answered. We have other sessions throughout the week, so if there are other topics that come up we will be here.

Thank you all for your participation. Thanks, Karen, for all of the information. And we'll see you at the next session later today. Thank you.

[END OF TRANSCRIPT]