

Review of All Rights Protection Mechanisms in All gTLDs PDP – Liaison Briefing on Phase 1 Final Recommendations

GNSO Council Meeting
17 December 2020

Background

What is the PDP about? Why is it important?

- Chartered in March 2016 to conduct a two-phased PDP
- Phase 1 – RPMs applicable to gTLDs launched under the 2012 New gTLD Program:
 - Uniform Rapid Suspension (URS) dispute resolution procedure
 - Trademark Clearinghouse (TMCH)
 - Sunrise and Trademark Claims offered through the TMCH
 - Trademark Post-Delegation Dispute Resolution Procedures (TM-PDDRP)
- Phase 2 – UDRP (an ICANN Consensus Policy since 1999)
- To complete Phase 1 by End-November 2020 (40-day extension granted in September 2020 in addition to 5.5 months previous extension)

Milestones

May – Early September 2020: Review Public Comments from 55 contributors

- ❑ Two Sub Groups reviewed public comments for preliminary recommendations and questions for community input
- ❑ Full Working Group reviewed
 - Public comments for individually-submitted proposals, overarching charter questions, and general input for the Initial Report
 - Two Sub Groups' suggestions & public comment review outcome
 - EPDP Phase 1 Recommendation 27 Wave 1 Analysis & CCT-RT Recommendations

Mid September – Mid November 2020:

- ❑ Finalize Phase 1 Recommendations
- ❑ Conduct Consensus Call
- ❑ Complete Final Report

24 November 2020: Submitted Final Report to GNSO Council

RPM PDP Phase 1 Final Recommendations

Recommendation Overview

- 35 Total Recommendations for RPMs applicable to gTLDs launched under the 2012 New gTLD Program
- 34 achieved “Full Consensus” & 1 achieved “Consensus” (TMCH Final Recommendation #1)
 - 9 maintain the status quo
 - 10 modify existing operational practice
 - 15 create new policies and procedures
 - 1 Overarching Data Collection recommendation
- Subsequent slides include summary or excerpt of the 35 Recommendations and the minority statement; see full text, including implementation guidance if applicable, in the Final Report

Recs to Maintain Status Quo

- TMCH:

 - “TM+50” rule

 - ”Exact Match” rule

 - Scope of Applicability of Sunrise & Claims RPMs to specific gTLDs for trademarks containing dictionary term(s)

- Sunrise:

 - Mandatory Sunrise Period

 - Exception for those who receive exemptions pursuant to Spec 13 .Brand TLDs & Section 6 of Spec 9 Registry Operator Code of Conduct

 - Requirements for the Sunrise Period

 - Availability of Sunrise registration only for identical matches

 - NOT to limit the scope of Sunrise Registrations to the categories of goods/services for which trademark was registered

 - NOT to create a challenge mechanism relating to Premium/Reserved Names

 - NO mandatory publication of the Reserved Names lists

- Trademark Claims

 - Mandatory Claims Period (also cover the Limited Registration Period)

 - ”Exact Match” rule (exact matching criteria for the Claims Notice)

Recs to Modify Existing Operational Practice

- URS:

- Providers to send notices to Respondent after Registry/Registrar has forwarded registration data
 - ICANN org, Registries, Registrars, and Providers to take steps to ensure contact details are up to date
 - Providers to require that Examiners document their rationale in sufficient detail
 - IRT reviews implementation issues with respect to Registry Requirement 10 in URS High Level requirements in the “URS High Level Technical Requirements for Registries and Registrars”
 - Remove “Technical” in title of “URS High Level Technical Requirements for Registries and Registrars”

- TMCH:

- Validation Provider primarily responsible for educating rights-holders, domain name registrants, and potential registrants about its services; IRT to work with Validation Provider and consider enhancing existing educational materials, with additional attention to registrants

- Database Provider must maintain industry-standard levels of redundancy and uptime

- Sunrise

- SDRP not intended to allow challenges to Sunrise registrations on grounds of invalid Trademark Record; Registry Operator to immediately suspend domain name registration to allow registrant to file challenge under the TMCH’s dispute resolution procedure

- Trademark Claims:

- Maintain current requirement to send the Claims Notice before a registration is completed; ICANN org can work with Registrars to address implementation issues

- Revise language of Trademark Claims Notice to improve the understanding of recipients; reflect more specific information about the trademark(s) for which it is being issued, and communicate its meaning and implications

URS: Recs for New Policies and Procedures

- **GDPR (aligns with EPDP recommendations):**

 - Complainant must only be required to insert publicly-available WHOIS/RDDS data in Initial Complaint; allow update to Complaint within 2-3 calendar days

 - URS Panelists have discretion to decide whether to publish/redact registration data in the Determination; URS party has the right to request redaction

 - Clearly define what “Default Period” means; registrant must not change public and non-public registration data elements during the Default Period

- **Language:**

 - Incorporate in full Rule #11 of UDRP Rules regarding “Language of Proceedings”

 - Provider must translate Notice of Complaint into the language of the Registration Agreement

- **Examiner:**

 - Provider maintains and publishes list of Examiners and their qualifications (CVs); identify how often each one has been appointed and link to their decisions

 - Provider publishes and reasonably enforces an effective Examiner Conflict of Interest Policy

- **Education:**

 - Uniform set of educational materials for guidance on what is needed to meet the “clear and convincing” burden of proof

 - Informational materials to assist Complainants and Respondents, including FAQs, forms, reference materials to explain Providers’ services & practices

- **Complaint Mechanism(s):**

 - ICANN org to establish a compliance mechanism(s), including an avenue for any party in the URS process to file complaints and seek resolution

Other RPMs: Recs for New Policies and Procedures

- **TMCH (the only recommendation that did not achieve “full consensus”, see Slide 8):**

Only “word marks” (including service marks, collective marks and certification marks) that meet one of the following requirements are eligible for the mandatory Sunrise and Trademark Claims RPMs:

 - a. Nationally or regionally registered word marks from all jurisdictions; or
 - b. Word marks validated by a court of law or other judicial proceeding; or
 - c. Word marks that are protected by a statute or treaty that is in effect at the time the mark is submitted to the TMCH and that are listed with a national or regional trademark office

Geographical indications, protected designations of origin, and other signs protected by quality schemes for distinguishing or indicating the geographic source or quality of goods or services are not eligible for the mandatory Sunrise and Trademark Claims RPMs (unless they are also trademarks as defined in (a) or (b))

TMCH Validation Provider(s), registry operators and other third parties may provide ancillary services to intellectual property rights-holders; these other forms of intellectual property must be held in a separate ancillary database
- **Sunrise:**

Registry Agreement for future new gTLDs to include a provision stating that a Registry Operator shall not operate its TLD in such a way as to have the effect of intentionally circumventing the mandatory RPMs or restricting brand owners’ reasonable use of the Sunrise RPM
- **Trademark Claims:**

Current mandatory Claims Period remain uniform for all gTLDs in subsequent rounds, with exception for those exempted pursuant to Spec 13 .Brand TLDs & Section 6 of Spec 9 Registry Operator Code of Conduct

Trademark Claims Notice to be delivered both in English and the language of the registration agreement
- **Trademark Post-Delegation Dispute Resolution Procedure (TM-PDDRP):**

Multiple disputes filed by unrelated entities against the same Registry Operator may be initially submitted as a joint Complaint, or may, at the discretion of the Panel, be consolidated upon request

Recommendation: Overarching Data Collection

- For future new gTLD rounds, ICANN Org to collect the following data on at least an annual basis and make the data available to future RPM review teams:
 - Number of marks submitted for validation in each category of marks accepted by the TMCH;
 - Number of successfully validated marks in each category of marks accepted by the TMCH;
 - Number of labels generated for all successfully validated marks;
 - Number of abused labels;
 - Number of marks deactivated in and removed from the TMCH;
 - Breakdown of the scripts/languages represented in a validated and active trademark in the TMCH; and
 - Number of cases decided under the TMCH dispute resolution procedure.

- For future new gTLD rounds, ICANN-accredited registrars must provide ICANN Org with periodic reports of the number of Claims Notices that were sent out to prospective registrants, not less than every 12 months

- ICANN Org explore developing a mechanism, in consultation with the URS Providers, to enable publication and search of all URS Determinations in a uniform format

- ICANN org to also collect data concerning trademark owners' and registrants' experience with the RPMs that can be provided to future RPM review teams

Minority Statement on TMCH Final Rec #1

Important to note that minority statement did not oppose the primary thrust of the recommendation, but had concerns over a single definition:

- “Word Marks” not satisfactorily defined, thereby enabling the continued misapprehension of the scope and applicability of the TMCH by the TMCH Validation Provider
- Absence of a satisfactory definition of “Word Mark” will likely contribute to the continuation of the erroneous TMCH Validation Provider practices, which violate the fundamental promise that the TMCH would not expand rights but would rather only recognize existing rights
 - e.g. inclusion of Text-Plus Marks
- Problem compounded by unwarranted lack of transparency of the TMCH database

Next Steps

- GNSO Council considers recommendations and Final Report, and if approved send Recommendations Report to the ICANN Board (Sections 7 & 8, ICANN Bylaws Annex A and GNSO PDP Manual)
- Public comment proceeding on GNSO Council-approved recommendations (Section 3.6; ICANN Bylaws on Notice & Comment on Policy Actions, before Board consideration)
- ICANN Board considers recommendations and Final Report (Section 9, Bylaws Annex A)
- If Board adopts recommendations, Board normally also directs ICANN org to begin implementation and GNSO Council generally forms IRT to advise org

Note on RPMS Phase 2:

- ADR: GNSO Council to form charter drafting / scoping team (1 month to 3 months)

Questions?