



Etienne Sanz de Acedo
Chief Executive Officer

655 Third Avenue, 10th Floor, New York, NY 10017-5646, USA
t: +1-212-642-1776 | f: +1-212-768-7796
inta.org | esanzdeacedo@inta.org

Submitted to: comments-irp-iot-recs-22jun18@icann.org

August 9, 2018

Patrick Dodson
Director, Strategic Initiatives
ICANN
12025 Waterfront Drive, Suite 300
Los Angeles, CA 90094-2536

Re: Independent Review Process - Updated Supplementary Procedure Rule 4, Time for Filing

Dear Mr. Dodson:

The International Trademark Association (INTA) appreciates this opportunity to comment on Rule 4 of the Updated Supplementary Procedures (USP), which the Independent Review Process Implementation Oversight Team (IRP-IOT) has proposed amending to read as follows:

4. Time for Filing

*An INDEPENDENT REVIEW is commenced when CLAIMANT files a written statement of a DISPUTE. A CLAIMANT shall file a written statement of a DISPUTE with the ICDR no more than **120** days after a CLAIMANT becomes aware, **or ought reasonably to have been aware,** of the material effect of the action or inaction giving rise to the DISPUTE.*

In order for an IRP to be deemed to have been timely filed, all fees must be paid to the ICDR within three business days (as measured by the ICDR) of the filing of the request with the ICDR.

INTA commends the IRP-IOT's removal of Rule 4's 12-month ultimate deadline for commencing

an IRP, and its expansion of Rule 4's period for filing from 45 days to 120 days.¹

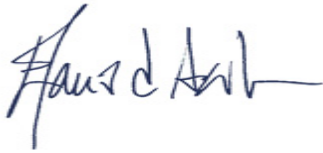
These changes will ensure that trademark owners have sufficient and continued access the IRP process.

That said, we are concerned that the newly added language, "*ought reasonably to have been aware*," is overly vague, may be subject to a variety of interpretations—and, in turn, may inadvertently prevent claimants from seeking redress through the IRP.

In turn, INTA recommends that the IRP-IOT revise Rule 4 to include a test for identifying when a claimant is deemed to be under inquiry notice injury and the clock begins to run. Such tests have been devised under U.S. jurisprudence² and there may be other jurisdictions that apply similar tests. It would be beneficial to the ICANN community to have more clarity in this critical area of procedure.

Should you have any questions about our comments, please contact Lori Schulman, INTA's Senior Director of Internet Policy, at 202-261-6588 or lschulman@inta.org.

Sincerely,



Etienne Sanz de Acedo
Chief Executive Officer

¹ In INTA's January 2018 Comment on the USP, we argued that Rule 4's (i) 45-day period for filing a written statement was insufficient, and should be extended to 90 days; and (ii) 12-month ultimate deadline was also insufficient, and should be extended to 24 months. According to ICANN's Staff Report, of the 19 comments received, 11 disputed the 45-day filing period, and 13 disputed the 12-month ultimate deadline.

² We note that U.S. jurisprudence on the "discovery rule"—which states that a statute of limitations begins to run at the time an injury is discovered or *reasonably should have been discovered*—may be instructive on how to best clarify this language. See, e.g., *Chevron U.S.A. Inc. v. Apex Oil Company, Inc.*, 113 F. Supp. 3d 807 (D. Md. 2015) (Under Maryland's discovery rule, the statute of limitations begins to run when a claimant knows, or should have known, of the existence of an injury; in other words, a claimant is under inquiry notice, and thus the statute of limitations will accrue, when the claimant has knowledge of circumstances which would cause a reasonable person in its position to undertake an investigation which, if pursued with reasonable diligence, would have led to knowledge of the alleged cause of action, regardless of whether such an investigation was actually undertaken.); *Caudill v. CSX Transp., Inc.*, 749 S.E.2d 342 (W. Va. 2013) (held that the discovery rule does not allow a plaintiff to unilaterally postpone the running of the statute of limitations by negligently failing to investigate the fact of and cause of his injury).

About INTA

The International Trademark Association (INTA) is global not for profit association with more than 7,200 member organizations from over 191 countries. One of INTA's goals is the promotion and protection of trademarks as a primary means for consumers to make informed choices regarding the products and services they purchase. INTA has also been the leading voice of trademark owners within the Internet Community, serving as a founding member of the Intellectual Property Constituency of ICANN. INTA's Internet Committee is a group of over 175 trademark owners and professionals from around the world charged with evaluating treaties, laws, regulations and procedures relating to domain name assignment, use of trademarks on the Internet, and unfair competition on the Internet, whose mission is to advance the balanced protection of trademarks on the Internet.