

## Final Issue Report on a Policy Development Process to Review All Rights Protection Mechanisms in All Generic Top-Level Domains

### Status of This Document

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This Final Issue Report has been drafted by ICANN Policy Support Staff and submitted to the GNSO Council for its consideration.

### Summary

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On 15 December 2011, the GNSO Council requested that eighteen (18) months after the launch of the New gTLD Program ICANN staff prepare and publish an Issue Report on the state of all rights protection mechanisms implemented for both existing and new gTLDs, including but not limited to the UDRP and URS. The Council subsequently agreed to extend the timeline for a report by a further six (6) months. This Issue Report is the result of that request.

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# 1 Executive Summary

## 1.1 Background

In referring to “rights protection mechanisms” (RPMs), this Issue Report is concerned with those policies and processes, developed in consultation with the ICANN community, aimed at combatting cyber-squatting and providing workable mechanisms for trademark owners to either prevent or remedy certain illegitimate uses of their trademarks in the domain name system (DNS). The first such mechanism, the Uniform Dispute Resolution Policy (UDRP)<sup>1</sup>, has been in effect as an ICANN Consensus Policy<sup>2</sup> since 1999.

A number of additional RPMs were developed subsequently to supplement the UDRP as part of the New gTLD Program, launched in 2012. These additional RPMs are:

- a. The Trademark Clearinghouse (TMCH)<sup>3</sup>, which authenticates global rights information, maintains a centralized database of these, and provides this information to registries and registrars during the domain name registration process in all gTLDs launched under the New gTLD Program. Verified data from the TMCH supports the additional protective mechanisms available during the Sunrise and Trademark Claims service periods.<sup>4</sup>
- b. The Uniform Rapid Suspension System (URS)<sup>5</sup>, which is modeled on the UDRP and aims to provide a trademark holder with a fast and reasonably inexpensive way to obtain the suspension of a domain name that was registered and used in bad faith.
- c. The Post-Delegation Dispute Resolution Procedures (PDDRs)<sup>6</sup>, which provide alternative avenues for a trademark holder who is harmed by a new gTLD registry operator’s conduct to obtain redress.

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<sup>1</sup> See <https://www.icann.org/en/help/dndr/udrp>.

<sup>2</sup> All gTLD registry operators and ICANN-accredited registrars are contractually obliged to comply with Consensus Policies that are developed by ICANN through community consensus. Annex A of the ICANN Bylaws outlines the Policy Development Process that has to be complied with to develop Consensus Policies within the GNSO: <https://www.icann.org/resources/pages/governance/bylaws-en/#AnnexA>. More specifically, the 2013 Registrar Accreditation Agreement (which is the contract between ICANN and all ICANN-accredited registrars) defines “Consensus Policies” as those policies that are established in accordance with the ICANN Bylaws and due process, and that relate to certain specific topics, including the resolution of disputes relating to the registration of domain names (see <https://www.icann.org/resources/pages/approved-with-specs-2013-09-17-en#consensus-temporary>). All current ICANN Consensus Policies can be accessed here: <https://www.icann.org/resources/pages/registrars/consensus-policies-en>.

<sup>3</sup> See <http://newgtlds.icann.org/en/about/trademark-clearinghouse>.

<sup>4</sup> For an updated list of the various periods and their dates, see <http://newgtlds.icann.org/en/program-status/sunrise-claims-periods>.

<sup>5</sup> See <http://newgtlds.icann.org/en/applicants/urs>.

<sup>6</sup> See <http://newgtlds.icann.org/en/program-status/pddr>.

The UDRP has not undergone any substantive review since its inception, and a 2011 GNSO community discussion to determine whether or not such a review should be conducted resulted in the GNSO Council's decision that a review should more appropriately be conducted in tandem with one for the new gTLD RPMs<sup>7</sup>. The GNSO Council therefore resolved in December 2011 to request an Issue Report on the state of all RPMs for both existing and new gTLDs, for publication eighteen (18) months following the delegation of the first gTLD in the New gTLD Program. Further to a staff request, the Council agreed to extend the timeline for delivery of a report by six (6) months.

In February 2015, community feedback was solicited for those RPMs developed for the New gTLD Program via an ICANN staff paper<sup>8</sup>. The aim of the exercise was to allow the ICANN community to assess the effectiveness of safeguards in meeting their intended rights protections objectives in the New gTLD Program, and identify areas where additional policy development or implementation improvements might be beneficial. Following the receipt and review of community comments, ICANN staff published a revised Rights Protection Mechanism Report (RPM Staff Paper) in September 2015<sup>9</sup>. In addition to feeding into other review processes to evaluate the operational effectiveness of the New gTLD Program, the analysis and feedback provided by the RPM Staff Paper was explicitly intended to also inform this specific Issue Report and the deliberations of the GNSO Council over whether or not to initiate a Policy Development Process (PDP) to review all the RPMs at this time.

Following the publication of the Preliminary Issue Report in October 2015 for public comment, ICANN policy support staff analysed the comments received and updated the report. This updated Final Issue Report is being sent to the GNSO Council for its consideration and further action, as appropriate.

## 1.2 Discussion of the Issue

The UDRP has been the subject of a GNSO Issue Report, published in February 2011<sup>10</sup> (prior to the delegation of the first gTLD under the New gTLD Program, which occurred in October 2013). Community feedback in response to this Issue Report was largely to the effect that the UDRP provides a “comparatively quick” and “effective” recourse for disputed second level domain name registrations in the globalized and trans-jurisdictional world of the DNS.<sup>11</sup> The primary conclusion in the Final Issue Report, published in October 2011 and based on a review of the community comments received, was that a review of the UDRP should not be conducted until

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<sup>7</sup> See <http://gnso.icann.org/en/council/resolutions#201112>.

<sup>8</sup> The initial staff paper and public comments can be viewed here: <https://www.icann.org/public-comments/rpm-review-2015-02-02-en>.

<sup>9</sup> See <https://www.icann.org/news/announcement-2015-09-11-en>.

<sup>10</sup> See <https://www.icann.org/resources/pages/prelim-report-udrp-2011-05-27-en>.

<sup>11</sup> See the Final Issue Report on the Current State of the UDRP (October 2011), Section 5.

eighteen (18) months after the launch of the URS. A review could then be based on data derived from the use of the URS, since it is modeled on the UDRP<sup>12</sup>.

October 2013 saw the delegation into the Internet root zone of the first gTLD under ICANN's New gTLD Program<sup>13</sup>. The TMCH opened for submission of trademark records in March 2013<sup>14</sup>, while the URS saw its first complaint filed in August 2013<sup>15</sup>. Available data and community feedback relating to these and the other new gTLD RPMs were summarized in the updated RPM Staff Paper, published in September 2015.

It is important to note at the outset that, to date, there has been no overall initiative that has sought to review in combination the effectiveness of all these RPMs in meeting their stated objectives. There is therefore no current, comprehensive policy guidance that covers the topic of the use and effectiveness of RPMs across both the so-called "legacy" gTLDs and those launched under the New gTLD Program, or that can be referred to as a uniform starting point for the future review and evolution of new or more streamlined RPMs that may be more appropriate. This is because the previous work efforts highlighted above each focused on specific RPMs – the October 2011 GNSO Final Issue Report on the then-current state of the UDRP (UDRP Report), and the RPM Staff Paper on those other processes developed for the New gTLD Program. Further, the UDRP is a Consensus Policy, applicable to all gTLDs, whereas the new RPMs were developed to address the overarching issue of trademark protection in connection with the introduction of new gTLDs<sup>16</sup>, following community consultations during the process of implementing the New gTLD Program. These new RPMs therefore apply only to gTLDs introduced as part of the New gTLD Program.

The work of any PDP reviewing the RPMs at this time is expected to build on prior ICANN and community work on the development of these RPMs, including the findings and community comments provided to the October 2011 UDRP Report and the more recent September 2015 RPM Staff Paper. A PDP is also expected to take into account relevant comments submitted to the public comment forum on the October 2015 Preliminary Issue Report.

There are a number of other review efforts underway or planned within the community that may have an impact on the work of the PDP and may help inform the PDP Working Group's deliberations. Therefore, a PDP need not necessarily be expected to be limited to the subjects identified in this Issue Report, and if initiated should take into account the findings from parallel efforts external to the PDP Working Group that may be formed for this effort.

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<sup>12</sup> See the Final Issue Report on the Current State of the UDRP, p.31.

<sup>13</sup> See <https://www.icann.org/resources/press-material/release-2013-10-23-en>.

<sup>14</sup> 13,261 trademark records were submitted to the TMCH between its launch and the delegation of the first New gTLD (RPM Staff Paper, pp 21-23).

<sup>15</sup> Note, however, that this was filed not against a domain name in a new gTLD but rather in the .pw ccTLD, whose operator had voluntarily adopted the URS: <http://www.prnewswire.com/news-releases/facebook-prevails-in-first-uniform-rapid-suspension-system-case-administered-by-national-arbitration-forum-234429801.html>.

<sup>16</sup> See, e.g., the Board resolution establishing the Implementation Recommendation Team: <https://www.icann.org/resources/board-material/resolutions-2009-03-06-en#07>.

## 1.3 Staff Recommendation

ICANN staff has confirmed that the proposed issue is within the scope of the GNSO's Policy Development Process.

Following review of community feedback received regarding the three options for a RPM review that were presented in the Preliminary Issue Report for public comment, ICANN staff recommends that the GNSO Council launch a PDP in accordance with what was presented as the third option in the Preliminary Issue Report: namely, to conduct a policy review of all the RPMs in two phases. The initial phase would focus on a review only of the RPMs developed for the New gTLD Program, and the second phase would focus on a review of the UDRP. The second phase may also include any issues identified during the first phase of the PDP that are more appropriately considered during the second phase. Cumulatively, the results of both phases of the PDP would be a full review of all RPMs developed to date for all gTLDs. Note, that staff has provided a summary and a flow chart of this unprecedented two-phased approach that can be found in Annex C.

Staff believes that conducting a standalone PDP in two phases to review the RPMs is preferable to folding in a review of the new RPMs into the New gTLD Subsequent Procedures PDP. A RPM PDP would result in the first comprehensive review by the GNSO of a longstanding ICANN Consensus Policy (the UDRP) together with a review of the new RPMs, and the likelihood that this PDP will set the framework for other subsequent review work favors the establishment of such a PDP as an independent exercise.

Staff recommends that the work in the initial phase of the RPM PDP be performed by a standalone PDP Working Group that liaises with the recently launched PDP Working Group on New gTLD Subsequent Procedures as there may be overlapping issues arising during the work of both groups that would warrant careful coordination. Staff does not recommend folding in a review of the RPMs that were developed for the New gTLD Program into the scope of work for the New gTLD Subsequent Procedures PDP due to the likely complexity and size of that PDP. To ensure timely communication and effective coordination between both PDP Working Groups on issues or mutual relevance, staff recommends that a community liaison – who should ideally be a member of both Working Groups – be appointed by both groups. This recommendation is also mentioned in the summary overview in Annex C.

Staff also recommends that, upon completion of Phase One, the PDP Working Group submits a First Initial Report to the GNSO Council that is also published for public comment. In addition to serving as a status and progress report on the PDP as a whole, this document should at a minimum also flag any issues relevant to Phase Two that the PDP Working Group recommends for consideration during a review of the UDRP, any preliminary recommendations the Group intends to make, and any issues or recommendations that the Group believes should be considered by the PDP Working Group on New gTLD Subsequent Procedures.

The second, subsequent phase of work in the RPM PDP would be a review of the UDRP, ideally carried out by the same PDP Working Group and based substantially on the concerns specific to its scope that were raised in the 2011 GNSO Issue Report, as updated or supplemented by issues

identified during the public comment forum for the Preliminary Issue Report for this PDP. Other relevant topics, including those potentially derived from the first phase of work concerning the RPMs developed for the New gTLD Program, may also be included in the scope of this phase of work. Staff notes that community feedback has indicated that this second phase of work should be undertaken in the form of a full PDP and not an Expedited PDP. At the end of the second phase the PDP WG should publish a Second Initial Report that is also put out for public comment. Upon review of all comments submitted, including any remaining issue that may have been brought up by the New gTLD Subsequent Rounds PDP Working Group, the PDP Working Group shall publish its Final Report and forward it to the GNSO Council for its consideration.

Staff believes that a benefit of this two-phased approach is a better alignment of the timing of the work on reviewing the New gTLD Program RPMs with the operational reviews of the New gTLD Program<sup>17</sup> (including the CCT Review) and the PDP on New gTLD Subsequent Procedures.

Further, as pointed out in the Preliminary Issue Report, the current workload of the GNSO and the resulting demand on staff and community resources means that ‘staggering’ the work of reviewing all the RPMs will allow for more meaningful participation by all interested parties. This two-pronged approach means, however, that that community considerations of general, overarching issues concerning the comprehensiveness of all the RPMs as a set of aggregate protections for trademark holders in all gTLDs.

If a PDP to review all the RPMs is launched, the previous 2011 collation of community comments concerning a possible review of the UDRP, the more recent compilation of feedback concerning provider and user experiences with the new RPMs, and relevant comments submitted to the public comment forum on the Preliminary Issue Report collectively provide a useful list of issues which could help the PDP Working Group in planning its work. This Final Issue Report contains a list of specific issues for possible consideration in a PDP, derived from topics identified by the community in response to the UDRP Report, the RPM Staff Paper, and the public comment forum on the Preliminary Issue Report (see Section 3.2.2.3). The full list of issues can be found in Annex B.<sup>18</sup> Staff recommends that this list of issues be provided to the PDP Working Group as a guide toward framing its work rather than as an exhaustive and mandatory set of issues to be considered.

This Final Issue Report has been published on the GNSO website and forwarded to the GNSO Council for its consideration and further action, as appropriate.

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<sup>17</sup> See <http://newgtlds.icann.org/en/reviews>.

<sup>18</sup> Note, the list was updated with additional questions that were brought up during the public comment forum on the Preliminary Issue Report.

## 2 Objective

### 2.1 Submission

This Final Issue Report is submitted in accordance with Step 2 of the Policy Development Process described in Annex A of the ICANN Bylaws.<sup>19</sup>

### 2.2 Issue

#### 2.2.1 The Proposed Issue Raised For Consideration

As noted above, all the RPMs were developed to provide mechanisms to facilitate the protection of trademarks in the DNS. Where the UDRP was adopted in 1999 and applies to all gTLDs, the additional RPMs developed for the New gTLD Program do not apply to the “legacy” gTLDs and are comparatively new, having been launched less than three years ago. In addition, the UDRP is an ICANN Consensus Policy that is by nature binding on all gTLD registries and registrars, whereas the new RPMs were developed during the implementation period for the New gTLD Program. The UDRP has not been comprehensively reviewed since its inception in 1999. Where the new RPMs are concerned, the findings reported in the RPM Staff Paper were explicitly intended to inform either further policy development or additional implementation work (as appropriate). Should the GNSO Council decide to vote to initiate a PDP following review of this Final issue Report, this will represent the first time that all the RPMs are being reviewed by the GNSO.

#### 2.2.2 The Identity of the Party Submitting the Request

The GNSO Council

#### 2.2.3 How that Party is Affected by the Issue

The RPMs that are currently in operation have direct impact on the business operations of Registries and Registrars and provide remedies and recourse for users including Registrants. Therefore, the existence, operation and effectiveness of the RPMs directly affect all of the GNSO’s Stakeholder Groups (SGs) and Constituencies (Cs). A review of the RPMs and any updates or changes that may be recommended as a result of a GNSO PDP is likely to also be of

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<sup>19</sup> See: <http://www.icann.org/general/bylaws.htm#AnnexA>.



key interest to other ICANN Supporting Organizations (SOs) and Advisory Committees (ACs), as RPMs touch on consumer protection and the rights of users in the DNS<sup>20</sup>.

## 2.2.4 Support for the Issue to Initiate a PDP

On 15 December 2011, the GNSO Council passed a resolution requesting that “a new Issue Report on the current state of all rights protection mechanisms implemented for both existing and new gTLDs, including but not limited to, the UDRP and URS, should be delivered to the GNSO Council by no later than eighteen (18) months following the delegation of the first new gTLD.”<sup>21</sup> On 29 January, at the request of ICANN staff, the GNSO Council agreed to an extension of the delivery date of the requisite Preliminary Issue Report by six months<sup>22</sup>. This Final Issue Report is based on the October 2015 Preliminary Issue Report, updated to include relevant community comments submitted during the public comment period.

## 2.3 Scope

Based on the recommendations above, the launch of a dedicated policy development process (PDP) to consider at least the issues identified in this Issue Report has been confirmed by the General Counsel to be properly within the scope of the ICANN policy process and within the scope of the GNSO.

## 2.4 Report

In accordance with the GNSO PDP rules, the Staff Manager has forwarded this Final Issue Report, together with a summary of the comments received, to the GNSO Council for its consideration and potential action.

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<sup>20</sup> Staff notes that both the GAC and the ALAC submitted comments to the 2011 Preliminary Issue Report on the Current State of the UDRP. Both Advisory Committees had then cautioned against launching a review of the UDRP at that time, with the GAC further commenting that such a review might be more appropriately done in light of community experiences with the RPMs developed for the New gTLD Program.

<sup>21</sup> See <http://gnso.icann.org/en/council/resolutions#20111215-1>.

<sup>22</sup> See <http://gnso.icann.org/en/meetings/minutes-council-29jan15-en.htm>.

## 3 Background

### 3.1 Process Background

The question of who legally has rights to, or is the legitimate holder of, a domain name can be open to dispute. Since the Internet is a global resource and domain name holders are dispersed among numerous different jurisdictions, finding an effective, enforceable and reliable process to resolve rights disputes across various jurisdictions is not an easy undertaking. Over time, ICANN has developed a number of dispute resolution policies and procedures that attempt to address this issue and provide enforceable remedies for certain types of disputes concerning domain name registrations. These policies are essentially alternative dispute resolution procedures to court litigation that nevertheless do not preclude the initiation of legal proceedings in the appropriate jurisdiction. In relation to domain name disputes concerning the registration and use of legally protected trademarks, the Uniform Dispute Resolution Policy (UDRP) is the longest standing alternative dispute resolution procedure.<sup>23</sup> In general, community feedback to date (including the public comment forum on the Preliminary Issue Report) indicates that many believe the UDRP to be an effective and expedient alternative to more time consuming and expensive court litigation, and that the UDRP is viewed as reliable, predictable and consistent. The effectiveness of the UDRP with regard to disputes in the global DNS has meant that court resolutions of such disputes are rarely sought.<sup>24</sup>

As a result of the New gTLD Program, several new rights protection mechanisms (RPMs) were also developed to mitigate potential risks and costs to trademark rights holders that could arise in the expansion of the new gTLD namespace, and to help create efficiencies for registration service providers among gTLD launches. These new mechanisms were developed in the course of implementation of the New gTLD Program. They are the Uniform Rapid Suspension System (URS), the Trademark Clearinghouse (TMCH) and the associated availability through the TMCH of Sunrise periods and the Trademark Claims notification service, and the Post-Delegation Dispute Resolution Procedures (PDDRRPs).<sup>25</sup> Where the UDRP and URS cover trademark-related disputes arising over an actual domain name that has been registered in the second level of a gTLD (i.e. they are so-called “curative” mechanisms), the TMCH and the services provided using TMCH-verified data such as Sunrise and Trademark Claims are intended to facilitate trademark

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<sup>23</sup> For a complete background overview on the development of the UDRP see the UDRP Report, pp. 7-9.

<sup>24</sup> The responses to the UDRP Questionnaire that was distributed to the UDRP service providers as part of feedback to the UDRP Report indicate that, to the providers’ knowledge, very few UDRP decisions are appealed to a court (e.g. one case, or .1% from the Asian Domain Name Dispute Resolution Centre, “fewer than five” per year from the NAF, and none from the Czech Arbitration Court). It should be noted, however, that providers may not receive notice of all appeals or challenges in court: see UDRP Report, p. 14 footnote 23.

<sup>25</sup> For a complete background overview on the development of these rights protection mechanisms, see the RPM Staff Paper, pp. 15-19.

owners' ability to prevent registration of domain names matching their marks (i.e. these are so-called "preventative" mechanisms).

Prior to the launch of the New gTLD Program, on 3 October 2011 ICANN staff had published a Final Issue Report on the current state of the UDRP. The recommended course of action in that UDRP Report was not to initiate a PDP at the time, but to hold off launching any such PDP until after the new URS had been in operation for at least eighteen (18) months.

Subsequently, on 15 December 2011, the GNSO Council requested that ICANN staff prepare and publish a new Issue Report on the current state of all rights protection mechanisms implemented for both existing and new gTLDs, including but not limited to the UDRP and URS. This Issue Report is the result of that GNSO Council request.

### 3.1.1 Uniform Dispute Resolution Policy (UDRP)

The UDRP was created in 1999 to resolve disputes concerning disputes over entitlement to domain names registered at the second level of the DNS. It is an ICANN Consensus Policy that is applicable to all gTLDs, including those launching under the New gTLD Program. The universal and uniform operation of the UDRP is based on two documents: first, the [Policy](#) that sets out its scope, relief, and basis for mandatory administrative proceedings that may be brought within its ambit; and secondly the [Rules](#) that set out the procedural requirements that must be followed in such a proceeding.

To date the UDRP has not been amended and no complete substantive review of the UDRP has taken place, although the policy has been adapted to accommodate new malpractices (such as phishing, pay per click and mousetrapping<sup>26</sup>) that emerged after ICANN's adoption of the policy in 1999. The UDRP Report concluded that in general the UDRP is functioning well and that there has been well over 30,000 cases decided by experienced UDRP panelists – with only "the rarest of the tens of thousands of UDRP decisions successfully challenged in Court."<sup>27</sup> It is noteworthy that a majority of the public comments to that Preliminary Issue Report requested that the "UDRP should be untouched."<sup>28</sup> However, many commenters also pointed out several ways in which they thought the procedural aspects of the UDRP could be improved<sup>29</sup> while a few commenters believed that the UDRP should indeed be reviewed<sup>30</sup>. Policy-related questions that may be relevant in reviewing the UDRP derived from the community feedback are summarized in Section 3.2.2.3.1 below.

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<sup>26</sup> UDRP Report, p.13.

<sup>27</sup> UDRP Report, p.14.

<sup>28</sup> UDRP Report, p.23.

<sup>29</sup> UDRP Report, Annex 2.

<sup>30</sup> UDRP Report, p.15.

### 3.1.2 Uniform Rapid Suspension System (URS)

The URS was designed as a complement to the UDRP, and is intended to provide trademark owners with a quick and low-cost process to act against those infringing on their intellectual property rights and to combat cybersquatting. In this respect, the substantive grounds upon which a trademark holder would file a complaint under the URS are essentially similar to those under the UDRP<sup>31</sup>. Much like the UDRP, trademark holders may initiate a URS proceeding by electronically filing a complaint with a URS provider. The fees associated with a URS proceeding range from USD300 - 500. Procedurally, once a trademark holder files a URS complaint, the registry operator immediately locks the domain against changes. The provider then notifies the registrant against whom the complaint has been filed, who has fourteen (14) days to submit a response. The remedy for a successful URS complaint is the suspension of the domain name for the balance of the registration period, with the complainant's option to extend that period for one additional year.<sup>32</sup>

In addition to the differing remedies available to a successful complainant under the UDRP (i.e. cancellation or transfer of the domain name) and the URS (i.e. suspension of the domain name), another area where the URS differs substantially from the UDRP is that of the standard of proof required to succeed on a claim. Where under the UDRP the complainant must prove her case through a preponderance of the evidence, under the URS there must be clear and convincing evidence – the reason for this is that, as a complement to rather than a substitute for the UDRP, the URS was expressly designed to apply only to clear-cut cases (often colloquially referred to in this context as “slam dunk” cases).

Community feedback provided on the URS in response to the initial RPM Staff Paper indicates that it can achieve “positive results in certain limited cases [as it] is quick, inexpensive and caters to those who have slam-dunk cases or are indifferent towards the suspension of the name solution, perhaps due to the fact they are unable to register that name”<sup>33</sup>. Nevertheless, a number of commentators also expressed reservations and concerns about the current scope and operation of the URS, including the standard of proof, the remedy provided, the time periods for response and use of the appellate mechanism. These are summarized in Section 3.2.2.3.2 below.

### 3.1.3 Trademark Clearinghouse (TMCH)

The TMCH is a global database of verified trademark information intended to support other rights protection processes such as Sunrise registrations and the Trademark Claims service. It opened for submission of trademark records in March 2013. Benefits of recording a trademark

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<sup>31</sup> For a side-by-side comparison of the URS and the UDRP, see RPM Staff Paper, p.92-99.

<sup>32</sup> See, generally, RPM Staff Paper, pp. 90 et seq. For more details, see the URS provisions: <http://newgtlds.icann.org/en/applicants/urs>.

<sup>33</sup> RPM Staff Paper, p. 104.

with the Clearinghouse include access to Sunrise registration with new gTLD registries. This involves an initial period of at least thirty (30) days before domain names are offered to the general public. The Clearinghouse also supports a Trademark Claims service that runs for at least the first ninety (90) days of general registration. During this period, anyone attempting to register a domain name matching a mark that is recorded in the TMCH will receive a notification displaying the relevant mark information. If the notified party nevertheless goes ahead and registers the domain name, the TMCH will send a notice to those trademark holders with matching records in the Clearinghouse, informing them that someone has registered the domain name. The TMCH accepts and verifies information on the following types of intellectual property rights: (i) nationally or regionally registered trademarks; (ii) court-validated marks; and (iii) marks protected by statute or treaty (such as geographical indications or designations of origin).<sup>34</sup> The RPM Staff Paper noted that: “Between March 2013 and May 2015, the Clearinghouse verified and accepted for inclusion 32,667 nationally or regionally or registered trademarks, 42 trademarks protected by statute or treaty, and two court-validated trademarks.”<sup>35</sup>

Community feedback provided on the TMCH in response to the initial RPM Staff Paper indicated certain concerns with the operational effectiveness of the TMCH<sup>36</sup>. In addition, commenters raised a number of substantive questions concerning the scope of the TMCH, including the treatment of design marks, questions concerning the requirement to provide proof of use of the trademark, and the test of an identical match between the trademark and a register-able domain name. These are summarized in Section 3.2.2.3.3 below.

### 3.1.4 Sunrise Periods

The verified data in the TMCH is used to support Sunrise services, which allow trademark holders an early opportunity to register domain names corresponding to their marks before domain names are made generally available to the public. The RPM Staff Paper explains that “New gTLD registries are required to offer a Sunrise period of at least 30 days. This can occur in line with one of two options: (i) In the case of a Start-Date Sunrise, the Registry Operator must provide the service for a minimum of thirty (30) calendar days prior to General Registration and must provide thirty (30) calendar days’ notice prior to the start of the Sunrise period. (ii) In the case of an End-Date Sunrise, the Registry has no advance notice requirement; however, the Registry Operator must provide the service for a minimum of sixty (60) calendar days prior to General Registration, and must not use a time-based allocation method (e.g., first come, first served). The majority of registries who have launched to date have offered an End-Date Sunrise.”<sup>37</sup> New gTLD registry operators are also obliged to maintain a Sunrise Dispute

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<sup>34</sup> See generally the RPM Staff Paper, Section 3. For the actual TMCH guidelines see [http://trademarkclearinghouse.com/sites/default/files/files/downloads/TMCH%20guidelines%20v1.2\\_0.pdf](http://trademarkclearinghouse.com/sites/default/files/files/downloads/TMCH%20guidelines%20v1.2_0.pdf).

<sup>35</sup> RPM Staff Paper, p.27.

<sup>36</sup> RPM Staff Paper, p. 52.

<sup>37</sup> RPM Staff Paper, p.54.

Resolution Policy, which allows for challenges to Sunrise registrations related to the registry operator's allocation and registration policies, including on the grounds that the domain name that was registered does not match the trademark record on which the Sunrise-eligible rights holder based its Sunrise registration.

Community feedback provided on the Sunrise period in response to the initial RPM Staff Paper indicated that some community members would welcome clarity on issues such as the treatment of premium names and the reservation and release of reserved names by a registry operator. These questions and suggestions are summarized in Section 3.2.2.3.4 below.

### 3.1.5 Trademark Claims Service

The Trademark Claims period follows the Sunrise period and runs for at least the first ninety (90) days of general registration in which domain names are made available to all registrants who are able to register domain names within the particular gTLD. During the Trademark Claims period for a gTLD, anyone attempting to register a domain name matching a mark that is recorded in the TMCH will receive a notification displaying the relevant mark information. "The Claims Notice is intended to provide clear notice to the prospective domain name registrant of the scope of the Trademark Holder's rights."<sup>38</sup> Should the notified party nevertheless proceed to register that domain name, the relevant trademark holder with a matching record in the TMCH is then notified of the registration.

Extensive community feedback was provided on the Trademark Claims service in response to the initial RPM Staff Paper. Some of the substantive topics addressed by commenters include the premise of an identical match to trigger a notice, the limited applicability of the service to Abused Domain Name Labels, and the possibility of extending the period of the service. These comments are summarized in Section 3.2.2.3.5 below.

### 3.1.6 Post-Delegation Dispute Resolution Procedures (PDDRPs)

The Post-Delegation Dispute Resolution Procedures (PDDRPs), unlike the UDRP and URS, are dispute resolution processes that address a new gTLD registry operator's conduct rather than alleged bad faith registration of a second level domain name by a registrant. Of the current three PDDRPs, only the Trademark PDDRP is intended to address trademark-related issues in the registry; the Registration Restriction DRP (RRDRP) and the Public Interest Commitments DRP (PIC-DRP) were not specifically designed as RPMs for the same purpose, although they can serve this function in certain limited circumstances<sup>39</sup>.

As of the date of publication of the initial RPM Staff Paper, no valid complaints had been filed under any of these PDDRPs and as such, most of the community felt unable to provide any

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<sup>38</sup> RPM Staff Paper, p.75.

<sup>39</sup> RPM Staff Paper, p. 111-112.

useful feedback although some suggested that a review would be appropriate when more data becomes available. In consequence, unlike the other RPMs analyzed in this Preliminary Issue Report, no data or specific prior community input is available for consideration in determining whether or not a PDP on all RPMs should be initiated at this time.

### 3.1.7 Relevant Selected ICANN Documentation and Reports

- Protecting the Rights of Others Working Group: Final Report, June 2007
- Implementation Recommendations Team: Final Report, May 2009
- GNSO Special Trademark Issues Review Team: Report and Recommendations, December 2009
- The Current State of the Uniform Domain Name Dispute Resolution Policy: Final Issue Report, October 2011
- Staff Paper on Rights Protection Mechanisms in the New gTLD Program: Revised Report, September 2015
- Metrics compiled on the new RPMs collected for the Competition, Consumer Trust and Consumer Choice Review: <https://www.icann.org/resources/reviews/cct/metrics#rights%20protection%20mechanisms>
- Nielsen Global Consumer Survey, Phase One: <https://www.icann.org/news/announcement-2015-05-29-en>

In addition, a variety of external sources were consulted for further background. These include the 2011 WIPO 2.0 Overview of WIPO Panel Views on Selected UDRP Questions<sup>40</sup>, a number of academic papers and reports, and the public comments referenced in the UDRP Report and the RPM Staff Paper.

## 3.2 Discussion of Potential Issues to be considered in a PDP to Review All the Existing RPMs in All gTLDs

### 3.2.1 Possible Outcomes and Basic Objectives of a PDP

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<sup>40</sup> See <http://www.wipo.int/amc/en/domains/search/overview2.0/>.

A potential Rights Protection Mechanisms Policy Development Process (RPM PDP) would, at a minimum, review the existing RPMs (including the UDRP) and build on the community's collective experiences of their application, effectiveness and other relevant matters. It is important to note that the scope, rules and procedures underlying the existing RPMs will remain fully applicable unless a GNSO PDP were to propose amendments to one, some or all of the existing policies (and corresponding rules), or recommends the creation of replacement mechanisms. The outcomes of a potential RPM PDP Working Group may include but are not limited to:

- Developing new or additional RPMs (which could also include recommending the development of new or additional procedural requirements<sup>41</sup>);
- Clarifying, amending or overriding existing RPMs (which could include not only situations where particular changes are recommended to a RPM but possibly also scenarios where the PDP does not result in the recommendation of substantive changes to a RPM but rather making certain needed clarifications (e.g. in the applicable language of a RPM));
- Recommending the supplementing of existing, or the development of new, procedural requirements for any existing RPMs (which may more appropriately be performed by an Implementation Review Team convened for the purpose, following adoption of the PDP recommendations); or
- Recommending neither substantive nor procedural changes to any existing RPMs, nor the creation of new RPMs
- All RPMs to become Consensus Policy applicable to all gTLDs.

A review of the prior work done by ICANN that is clearly relevant to considering any potential review of the RPMs at this time (i.e. the UDRP Report and the RPM Staff Paper) would seem to demonstrate that there are no simple problems for which there is a clear and immediate remedy. As such, one basic objective of any RPM PDP that may be initiated as a result of this round of community consultation would be to build on the prior work that has already been done in order to conduct a more detailed review that focuses on the substantive policy rationales and consequent issues raised for and by each RPM, with possible further analysis of the underlying procedural rules as necessary to fulfill that objective. Such a detailed review would ideally be conducted at a very early stage of a PDP, to better inform and to clarify the scope of the analysis to follow, as to whether or not all the RPMs collectively can be said to

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<sup>41</sup> It is envisaged that the actual creation of specific rules implementing any policy recommendations made by the PDP Working Group will be the role of an Implementation Review Team, convened to work with ICANN operational staff.



achieve the intention of providing sufficient protection to trademark holders in both existing and new gTLDs, or if further changes may be required<sup>42</sup>.

### 3.2.2 The Fundamental Questions to be Analyzed in a PDP

All the RPMs discussed in this Issue Report were designed to provide trademark holders with either preventative or curative protections against cybersquatting and other abusive uses of their legally recognized trademarks. The genesis of the UDRP lies in the discussions around the US Government's January 1998 Green Paper, which noted (among other topics) that "[f]or cyberspace to function as an effective commercial market, businesses must have confidence that their trademarks can be protected. On the other hand, management of the Internet must respond to the needs of the Internet community as a whole, and not trademark owners exclusively." This called for development of a "balanced and transparent process, which includes the participation of trademark holders and members of the Internet community who are not trademark holders, to ... develop recommendations for a uniform approach to resolving trademark/ domain name disputes involving cyberpiracy (as opposed to conflicts between trademark holders with legitimate competing rights)"<sup>43</sup>. Following initial work from the World Intellectual Property Organization (WIPO) and policy development work in the Domain Names Supporting Organization (DNSO), the precursor to what is now the GNSO, the ICANN Board approved the UDRP on 24 October 1999<sup>44</sup>.

In moving towards the launch of the New gTLD Program, the ICANN Board had acknowledged in 2009 that providing adequate protection for trademark holders in an expanded DNS was one of the overarching issues in the New gTLD Program<sup>45</sup>. Following the submission of a Final Report containing its recommendations by the Implementation Recommendations Team (IRT) that had been formed by the Intellectual Property Constituency at the request of the Board, the GNSO's Special Trademarks Issues team was convened for further consideration of the IRT recommendations. The result of this work was the inclusion of the new RPMs that are discussed in this report, in the final version of the Applicant Guidebook for the New gTLD Program<sup>46</sup>.

The focus of the 2011 UDRP Report was exclusively on the UDRP and whether or not to review it, and that analysis was conducted prior to the launch of the New gTLD Program. More recently, the scope of the recent RPM Staff Paper was on gathering community feedback on the new

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<sup>42</sup> This exercise would, however, necessarily be postponed to a later stage of work should the decision be made to adopt the third option outlined by staff in this report.

<sup>43</sup> See the Statement of Policy published in Vol. 63, No. 111 (10 June 1998) of the Federal Register: <http://www.gpo.gov/fdsys/pkg/FR-1998-06-10/pdf/98-15392.pdf>.

<sup>44</sup> The timeline for development and eventual adoption of the UDRP can be viewed here: <https://www.icann.org/resources/pages/schedule-2012-02-25-en>.

<sup>45</sup> See <https://www.icann.org/resources/board-material/resolutions-2009-03-06-en#07> (March 2009 Board resolution setting up the Implementation Recommendations Team to develop appropriate mechanisms to achieve this during implementation of the New gTLD Program).

<sup>46</sup> See RPM Staff Paper for further background on the creation of and community consultations involved in the new RPMs.

RPMs created for the New gTLD Program rather than highlighting which issues identified by the community ought to be subject to a GNSO PDP. All this means that, to date, a comprehensive review of all the RPMs has not been conducted. More specifically, there has not been an analysis of whether or not these RPMs are collectively fulfilling the objectives for their creation as noted above, a question that should be asked independently of any operational and procedural issues surrounding the functionality of the RPMs<sup>47</sup>.

### 3.2.2.1 Divergent community views on reviewing the UDRP

The UDRP Report reveals two primary divergent views on the topic of whether the UDRP should be reviewed. This divergence of views has been reflected consistently in community feedback on the UDRP Report as well as the 2015 Preliminary Issue Report. According to one view, “it is a basic best practice to review all long-standing policies after implementation”, whereas the other view was that “a review should not be conducted simply for the sake of form if the policy is generally viewed as being effective and serves the community well.”<sup>48</sup> While some commenters to the Preliminary Issue Report thought that it is not timely to review the UDRP, others went further, suggesting that the UDRP should remain untouched as a policy framework given its effectiveness, consistency and predictability. One concern expressed was that the UDRP ‘has [...] evolved over the last 15 years, and has been sufficiently flexible to deal with new issues in the DNS as they arise. As such, and with over 50,000 cases, there is a significant body of precedent carefully developed by hundreds of expert domain name panellists coming from a wide variety of jurisdictions. That very body of precedent is at risk if the underlying framework is significantly amended or destabilized.’<sup>49</sup> Other comments reflected similar views, noting that ‘UDRP predictability has also supported a high settlement rate between parties. More broadly, UDRP jurisprudence informs domain name registration practices and website use.’<sup>50</sup> In the same vein it was mentioned that ‘if the UDRP were to be subject to review and subsequent revision, there is a risk that it will be weakened to the point that it no longer serves its intended purpose, and thus more trademark owners are likely to resort to court action.’<sup>51</sup>

In the previous UDRP Report, some commenters had noted that while the UDRP has worked well, it is not necessarily perfect. They were therefore amenable to the idea of exploring possible improvements to the procedural aspects of the policy, presumably through changes to the UDRP Rules or development of further Supplemental Rules for providers that would align with the UDRP Rules. The view that the UDRP or its Rules could be improved was even stronger in some of the community responses submitted to the 2015 Preliminary Issue Report, for example: ‘the UDRP needs to be fixed’;<sup>52</sup> ‘it now seems timely to engage in a review of [the

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<sup>47</sup> Many of these were pointed out from the community’s perspective in the public comments to the UDRP Report and the initial RPM Staff Paper.

<sup>48</sup> UDRP Report, p.19.

<sup>49</sup> Public Comment Review Tool, Preliminary Issue Report, p.10.

<sup>50</sup> Public Comment Review Tool, Preliminary Issue Report, p.7.

<sup>51</sup> Public Comment Review Tool, Preliminary Issue Report, p.13.

<sup>52</sup> Public Comment Review Tool, Preliminary Issue Report p.24.

UDRP's] performance with an eye toward considering possible improvements';<sup>53</sup> 'Any procedure which has been operating for 15 years without any review really ought to be subject to some assessment of whether it has met the objectives for which it was created, and whether it continues to do so.'<sup>54</sup>

In 2012, based on the public comments received to that year's Preliminary Issue Report, staff had recommended in the final UDRP Report that a UDRP review be initiated only after the URS has been in operation for eighteen (18) months. This is reflected in the GNSO Council's subsequent request for a further Issue Report to be delivered on all the RPMs eighteen (18) months after the delegation of the first gTLD in the New gTLD Program<sup>55</sup>. The public comments received to the October 2015 Preliminary Issue Report reveal a strong sense amongst some community members that the UDRP ought to be reviewed. In this regard, some other commenters cautioned that a review of such a complex and long-standing policy should not be undertaken based on the premise that the UDRP should be rewritten; rather, the purpose of a review should be to assess its purpose, its performance and its effectiveness such that any recommendations for amendments are based on the outcome of this analysis, and only insofar as may be deemed necessary.

Consideration should also be given to the need to differentiate between a review of the Policy itself, and one of the procedures involved in applying the Policy (as noted earlier, this might involve amendments to the prevailing UDRP Rules, or the creation of new Supplemental Rules for providers). Should the GNSO Council initiate a PDP on reviewing the RPMs including the UDRP, the PDP Working Group should determine whether and how to distinguish between these tasks as a matter of early priority in each phase of the PDP (if the two-pronged approach recommended in this report is adopted). Although the PDP Working Group would not be precluded from providing guidance on operational and procedural improvements to a RPM, the actual development of these rules and processes would be more appropriately performed by an Implementation Review Team formed after the adoption of the Working Group's overall policy recommendations.

### 3.2.2.2 The availability of data and the timing of other relevant review exercises

The 2011 UDRP Report contains information and statistics provided by most of the UDRP service providers concerning the number of filings, nature of rulings and other useful data concerning the extent of use and the outcomes of UDRP proceedings<sup>56</sup>. In addition, some providers maintain searchable databases of all UDRP panel decisions<sup>57</sup>. Providers such as the WIPO

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<sup>53</sup> Public Comment Review Tool, Preliminary Issue Report p.21.

<sup>54</sup> Public Comment Review Tool, Preliminary Issue Report p.12.

<sup>55</sup> <http://gnso.icann.org/en/council/resolutions#201112>.

<sup>56</sup> See UDRP Report, Annex 3.

<sup>57</sup> See, e.g., WIPO Arbitration and Mediation Center

(<http://www.wipo.int/amc/en/domains/search/legalindex.jsp>), which also maintains statistics at

Arbitration and Mediation Center and the National Arbitration Forum also regularly publish statistics concerning their caseloads and filings<sup>58</sup>. These sources as well as the longstanding nature of the UDRP means that data concerning the UDRP is readily available. Further, as shown by the responsiveness of the various UDRP providers to the 2011 UDRP Report process and other forums of engagement with ICANN, the providers are generally able and willing to provide information and other assistance as may be necessary for analysis and policy work. This was also reflected in the public comment forum on the 2015 Preliminary Issue Report.

The RPM Staff Paper includes a number of charts and statistics illustrating the use of the various RPMs in the New gTLD Program, dating to May 2015 (approximately 19 months after the delegation of the first gTLD in the New gTLD Program). In addition, the TMCH service provider maintains statistics on usage of the TMCH<sup>59</sup> while data on the URS can be obtained from the URS service providers. The “newness” of the New gTLD Program compared to the history of the UDRP means that the data available to evaluate the new RPMs does not match that which is available for the UDRP.

This disparity need not, however, prevent the GNSO from moving forward with a PDP. While postponing a review of the RPMs would doubtless mean more statistics will be available in time, the data currently available would seem to provide a sufficiently rich basis for commencing a review, with the possibility that the PDP Working Group perform a “check” of its work at periodic intervals concerning RPM usage in the new gTLDs (e.g. six months following its inception, the Working Group can request an update on the data currently in the RPM Review Staff Paper from ICANN staff). No objections to this approach were received in the public comment forum on the 2015 Preliminary Issue Report.

Another important consideration concerning the timing of the launch of an RPM PDP, as also expressed in the Preliminary Issue Report, is the coordination of such an effort with other reviews of, or work that may be related to, the new RPMs. Of most direct relevance is ICANN’s commencement<sup>60</sup> of an independent review of the TMCH, which had been requested by the Governmental Advisory Committee (GAC) in its April/May 2011 comments on the Applicant

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<http://www.wipo.int/amc/en/domains/statistics/>, the National Arbitration Forum (<http://www.adrforum.com/UDRP>), the Asian Domain Name Dispute Resolution Centre ([http://www.adndrc.org/mten/UDRP\\_Decisions.php](http://www.adndrc.org/mten/UDRP_Decisions.php)) and the Czech Arbitration Court (<http://udrp.adr.eu/adr/decisions/index.php>).

<sup>58</sup> See, e.g., WIPO’s 2011 paper on “The UDRP and WIPO” (<http://www.wipo.int/export/sites/www/amc/en/docs/wipointaudrp.pdf>) and the recent release by the National Arbitration Forum (<http://www.adrforum.com/news>)

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

<sup>59</sup> For the TMCH: <http://www.trademark-clearinghouse.com/>; for the URS:

<http://www.adrforum.com/URS> and [http://www.adndrc.org/mten/URS\\_index.php?st=4](http://www.adndrc.org/mten/URS_index.php?st=4).

<sup>60</sup> A Request for Proposals was issued by ICANN on 7 August 2015, closing on 28 August: see <https://www.icann.org/news/announcement-2015-08-07-en>.

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Guidebook for the New gTLD Program<sup>61</sup>. In its request, the GAC had listed several specific topics to be examined as part of the review, including: (1) an assessment of whether non-identical matches can be included in the TMCH (e.g. domain names that include a mark at the beginning or the end of an applied for second level domain, or key terms associated with the goods or services identified by the mark, or typographical variations identified by the rights holder); and (2) consultation with registry operators, registrants and rights holders on the benefits (or otherwise) of extending the Trademark Claims Service beyond the current ninety (90) day period. Notably, these recommendations are similar to some of the comments received in response to ICANN's recent solicitation for input through the initial RPM Staff Paper.

It is important to note that the objectives of the TMCH review include the identification of issues that may be addressed in policy development work. The review is intended to also "help inform the discussion and enable consideration of the rights protection mechanisms available in the domain name space."<sup>62</sup> Care should therefore be taken in a GNSO RPM PDP to engage appropriately with the independent reviewer appointed to evaluate the TMCH and to ensure that the PDP Working Group's timeline and project milestones take the results of the TMCH review fully into account where these raise policy-related issues. It is possible, for instance, that this independent review may reveal additional policy-related topics that would fall appropriately within the scope of the PDP. Flexibility in scope and remit of any PDP is therefore paramount to allow the GNSO community to adapt its work to any other relevant developments and findings.

Less directly associated with a potential RPM review but nonetheless of likely relevance is the Competition, Consumer Choice and Consumer Trust Review, which is part of the overall review of the New gTLD Program mandated by ICANN's Affirmation of Commitments with the United States government. An Implementation Advisory Group was formed in October 2013 to evaluate and make recommendations on the metrics for such a review that were initially proposed by the GNSO and the ALAC. Of the sixty-five (65) metrics ultimately recommended by the IAG in September 2014 for the review, the relative incidence of combined UDRP and URS complaints (possibly comparable to UDRP complaints in the "legacy" gTLDs) was identified as a "first priority" metric, with additional recommendations concerning a survey to be conducted on registrant and Internet users' experience with regard to cybersquatting<sup>63</sup>, and information to be collected on the quantity of intellectual property claims and cost of domain name policing relating to new gTLDs<sup>64</sup>. ICANN anticipates this review to commence in January 2016, with the current goal to complete the work by December 2016<sup>65</sup>. As with the TMCH review, a PDP

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<sup>61</sup> The GAC had requested a post-launch review of the TMCH one year after the launch of the 75<sup>th</sup> new gTLD in the New gTLD Program: see <https://archive.icann.org/en/topics/new-gtlds/gac-comments-new-gtlds-26may11-en.pdf>.

<sup>62</sup> See <https://www.icann.org/news/announcement-2015-08-07-en>.

<sup>63</sup> See <https://www.icann.org/news/announcement-2015-05-29-en>.

<sup>64</sup> The full report and list of metrics can be viewed here: <http://newgtlds.icann.org/en/reviews/cct/iag-metrics-final-recs-26sep14-en.pdf>.

<sup>65</sup> This is outlined in the Call for Volunteers that was published on 1 October: <https://www.icann.org/news/announcement-2-2015-10-01-en>.

Working Group reviewing all the RPMs should also monitor the work and outcome of this review group, with a similar flexibility to amend or adapt its work accordingly.

As with the matter of data availability, the launch of these other parallel reviews should not, in and of themselves, militate against launching a PDP to review the RPMs at this time<sup>66</sup>. However, any Working Group that is chartered to conduct the PDP will need to, at a minimum, track and consider any relevant output of these reviews as part of its scope and timeline.

### 3.2.2.3 Potential issues for review in a PDP

A review of the community feedback provided to the UDRP Report and initial RPM Staff Paper shows that some members of the community believe there to be a number of issues that are in need either of policy development by the GNSO or that are ripe for review more generally. While some of the issues identified by the community clearly relate to operational problems and possible procedural improvements, some would seem to warrant community consideration of whether they would be appropriate issues for a GNSO Working Group to analyze in a PDP to review the RPMs. A non-exhaustive list of issues and questions that had been raised previously by the community in relation to a possible RPM/UDRP review had been included in the Preliminary Issue Report preceding this report for community feedback as to their continued relevance and appropriateness for policy review. Staff recommends, however, that instead of mandating that the PDP Working Group examine all these issues, the list as well as the community feedback collected on it would be more useful if it was provided to the PDP Working Group as a starting point and a reference, as including such a list at the outset of a PDP might unnecessarily restrict the scope of work of the PDP Working Group. The list of issues has therefore been moved to Annex B and updated with comments and other issues that were raised in the public comment forum to the Preliminary Issue Report. In addition, the proposed Working Group Charter (see Annex A) includes an express reference to these issues but makes clear that the PDP Working Group should use these as guidance of what its review should entail rather than as a definitive or exhaustive list.<sup>67</sup>

### 3.2.2.4 Other factors relevant to the decision whether to initiate a PDP

It is important to note that the list of issues now contained in Annex B does not represent the consensus or majority views of the community. The two prior ICANN exercises that summarized

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<sup>66</sup> Note, however, the possibility of alternative approaches to a full PDP as outlined by staff elsewhere in this report.

<sup>67</sup> Please note that, as with the Preliminary Issue Report, the items listed in Annex B exclude those items identified as relating to operational and procedural matters as they would likely fall outside the scope of a GNSO policy review.

the current state of the UDRP and the new RPMs and that gathered community feedback on their workings did not differentiate between issues that were brought forward by large numbers of the community or by individuals. This is not to say that issues brought forward by a single person would not have the support of others nor that it is less important simply because it was highlighted by just one or a few commenters. Given, however, the fact that all the RPMs are existing and functioning mechanisms, and that the UDRP has been acknowledged to be largely successful in its objectives, the question of whether a PDP should be launched to resolve all the issues identified by the community needs to be very carefully considered, to avoid inadvertently creating new problems (e.g. through an overly long or complicated review process, or creating uncertainty about the future scope of certain policies and associated rules). Should the GNSO Council decide to initiate a PDP to address these questions, it will be necessary for the resulting PDP Working Group to first gain a thorough understanding of the current functionality, applicability, and compatibility with other processes of each RPM. Staff believes that this should occur at a very early stage of work in a RPM PDP.

On the other hand, the UDRP has never been substantively or comprehensively reviewed. In addition, since the creation of the new RPMs there has not been a single, uniform review of all the RPMs or a consideration of their possible applicability to all gTLDs. There is therefore no clear, consistent framework for analyzing all the RPMs that have been developed to date that can assist with the future review and evolution of such protection mechanisms.

Moreover, as noted previously, the UDRP is an ICANN Consensus Policy that is binding on all gTLD registries and registrars whereas the RPMs that were developed for the New gTLD Program were the result of a process of community consultation through various iterations of the Applicant Guidebook for the Program. They are binding on all new gTLD registries through inclusion in the respective contract each party enters into with ICANN, and through the Registrar Accreditation Agreement for ICANN-accredited registrars. Thus, though achieving the same effect (especially from a registrant's perspective), the means through which these RPMs are binding are not consistent.

It may therefore be helpful as a matter of policy consistency for a PDP Working Group to clarify whether or not RPMs such as the URS – being a dispute resolution process modeled on the UDRP – should be a Consensus Policy applicable to all gTLDs. In addition, in exploring this question, the Working Group may need to examine the potential consequences of the URS having the status of a Consensus Policy, especially in relation to the so-called “legacy” gTLDs (i.e. those predating the New gTLD Program). The Working Group may wish also to take note of the fact that several registry operators of these “legacy” gTLDs (e.g. .cat, .pro, .travel) recently agreed to adopt the URS in renewing their registry agreements with ICANN. Thus, where the URS is a standard contractual obligation for all registry operators of the New gTLD registries, this is not the case universally for the “legacy” gTLDs.

Furthermore, the PDP Working Group will need to take into account the fact that a different but existing PDP Working Group has already been chartered to examine the question of the URS as a Consensus Policy in a narrower, more specific context. This is the IGO-INGO Access to Curative Rights Protection Mechanisms PDP Working Group, which is currently examining the need for protection for the acronyms of international governmental organizations (IGOs) at the second level in all gTLDs. In its charter, the IGO-INGO PDP Working Group was asked to review the question whether the URS should, like the UDRP, be a Consensus Policy. Any potential overlap

that may emerge with the work of this PDP Working Group, were a new PDP to review all RPMs be initiated, should therefore be taken into account.

In addition, the convening of the CCT Review Team (CCTRT) is another factor that might impact on the initiation of a PDP at this time. It should be noted that this was pointed out in the Preliminary Issue Report and the community feedback did not indicate that this would be a reason to stall the launch of a PDP reviewing all RPMs in all gTLDs at this moment. However, staff strongly encourages close cooperation and communication between any future PDP Working Group reviewing RPMs and the CCTRT; this is also marked in the draft Charter (Annex B).

Finally, as was noted in the UDRP Report in 2011, the impact of a new PDP on staff and community resources also needs to be highlighted. While this factor should not be dispositive of the issue of whether or not a PDP is launched, it should be a consideration for at least the PDP Working Group in determining its timeline and prioritizing its work.



## 4 Procedural Matters and Staff Recommendation

### 4.1 General Council Recommendation

#### 4.1.1 Scope Considerations

In determining whether the issue is within the scope of the ICANN policy process and the scope of the GNSO, ICANN staff and the General Counsel's office have considered the following factors:

#### 4.1.2 Whether the Issue is within the Scope of ICANN's Mission Statement

ICANN's mission statement states that ICANN should '[coordinate] the operation and evolution of the DNS root name server system; [and coordinate] policy development reasonability and appropriately related to these technical functions.'<sup>68</sup> The review of existing Consensus Policies as well as the RPMs developed for the New gTLD Program fall within this coordination function of ICANN's.

#### 4.1.3 Whether the Issue is Broadly Applicable to Multiple Situations or Organizations

All the RPMs directly affect Registries, Registrars, as well as other stakeholders such as registrants, rights holders, business and other users. These RPMs are applicable across the DNS and changes to any of these policies would equally affect the parties listed above. Other ICANN Supporting Organizations and Advisory Committees will also likely be interested in the issue and the outcomes of a PDP, given the likely impact of these policies and processes on Internet users and the general public.

#### 4.1.4 Whether the Issue is Likely to Have Lasting Value of Applicability, albeit with the Need For Occasional Updates

The UDRP has been in place since 1999 and the RPMs related to the New gTLD Program have been in operation for approximately two years as of this writing. There has to date been no comprehensive overarching review of all the RPMs in the aggregate. A review of these would have lasting value. Indeed, the potential need to review their effectiveness in light of their policy

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<sup>68</sup> <https://www.icann.org/resources/pages/governance/bylaws-en/#/>

objectives as well as the potential for necessary updates to some of these RPMs is the primary reason for the GNSO Council's request for this Issue Report.

#### 4.1.5 Whether the Issue Will Establish a Guide or Framework for Future Decision-Making

The review of a long-standing Consensus Policy, the UDRP, would establish an important framework for any future reviews of existing ICANN Consensus Policies. In addition, a policy review of the RPMs developed for the New gTLD Program will guide future reviews of such processes, including in future rounds of gTLD expansion. A PDP could also result in clear and consistent policy frameworks for all RPMs in all gTLDs.

#### 4.1.6 Whether the Issue Implicates or Affects ICANN Policy

Any review that results in proposed changes to the UDRP would affect the existing UDRP, which is an ICANN Consensus Policy.

### 4.2 Staff Recommendation

ICANN staff confirms that the issue of reviewing the UDRP as well as all New gTLD-related RPMs is within the remit of the GNSO's Policy Development Process as outlined in the ICANN Bylaws.

Staff notes that a complete review of a longstanding Consensus Policy such as the UDRP – as well as a review of new RPMs that were developed specifically for the New gTLD Program – is an unprecedented endeavor for the GNSO. The UDRP is a functioning policy that has been in place for a long time. While a review could be beneficial, prior ICANN work reporting on its operations did not highlight any one issue as generally being agreed upon as susceptible to a clear and simple remedy. Similarly, the New gTLD Program RPMs have been in place for over two years and do not seem to have revealed obvious problems for which a straightforward remedy can easily be designed through quick consensus. These observations should be borne in mind in a PDP to review the RPMs and are reflected in the scope of the draft Charter that can be found in Annex A.

Staff notes further that any review of the RPMs need not be based entirely on the list of issues contained in Annex B. Although the list is based on extensive community consultation, the issues as identified have not yet been subjected to broad community discussion as to which of them represent actual problems with the policies or, more broadly, an example that the policy in question is clearly falling short of its objectives. Staff also cautions against a "pick and mix" approach to these issues for inclusion in the charter for a possible PDP, and recommends instead that these serve as guidelines in the sense of a starting point or possible framework for the work to be done. The Working Group could first assess the various RPMs for effectiveness and then decide which of the issues raised should be addressed in respect of each such RPM. This may ultimately mean that all the issues contained in Annex B are addressed – with the possibility that more issues are also analyzed – as a result of the consensus decision of the PDP Working Group. Staff believes that permitting the Working Group this discretion would enhance

the effectiveness of a PDP as it would allow for an initial assessment of each RPM prior to determining which specific community-based concerns should be prioritized, how they might be addressed, appropriate remedies sought and, if necessary, additional mechanisms explored. In assessing the workings of each RPM, additional consultation with all of ICANN's Supporting Organisations and Advisory Committees (as mandated by the GNSO's PDP Manual) as well as experienced dispute resolution providers should be one of the first tasks of any PDP WG.

### 4.2.1 Two-Phased Policy Development Process

In the Preliminary Issue Report, staff had presented three possible options to the community for feedback on a preferred course of action. The feedback received was mixed but there was stronger support for option three<sup>69</sup> than for either of the other two.<sup>70</sup>

Staff therefore recommends that a policy review of all the RPMs be conducted in two phases, with the initial phase being a review only of the RPMs developed for the New gTLD Program and the second, subsequent phase of work a review of the UDRP. A summary overview of this approach can be found in Annex C.

Staff believes that this two-pronged approach will allow for better alignment of the timing of the work on reviewing the new RPMs with the operational reviews of the New gTLD Program (including the CCT Review) and the new PDP on New gTLD Subsequent Procedures. Staff notes that the PDP (possibly in the second phase) should also consider whether any of the new – and by then reviewed – RPMs should be considered Consensus Policies like the UDRP.

As is clear from the proposed draft Charter below, Staff recommends that, prior to commencing the second phase of the PDP, the Working Group should provide a report to the GNSO Council to explain their achievements and to request any updates to the Charter, to take into account any new and unforeseen issues or challenges that may have arisen during the first phase of the PDP. This report should also be published for public comment prior to commencement of Phase Two of the PDP.

### 4.2.2 Recommended Steps in a PDP

Should the GNSO Council agree with staff and launch a two-phased PDP to review all the RPMs in all gTLDs, staff recommends that the following steps be followed by the PDP Working Group:

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<sup>69</sup> The first option would have meant a review of all RPMs in all gTLDs in the same PDP at the same time; the second option would have included a mandatory requirement in the PDP Charter to review scope and work plan once the results of the Consumer Choice and Trust Review are published; the third option would be a two-phased PDP that is presented as staff recommendation in this final Issue Report.

<sup>70</sup> One contributor suggested an alternative fourth option (a reverse of option 3) but there was no support for such an approach from any other community members.

As one of its first steps, the PDP Working Group chartered to perform this task should prioritize the need to understand fully the scope and applicability of each RPM, and how each of the RPMs interact with and supplement one another, in order to gain a more cohesive view of how the RPMs work collectively. In a two-pronged PDP, the Working Group should take care to ensure that its work on the UDRP during the first phase is limited to understanding the UDRP's interplay and complementarity with the new RPMs, rather than engaging in an in-depth review of the UDRP (which is reserved for the second phase of the PDP).

Secondly, the PDP Working Group should review the suggestions that have already been brought forward by the community regarding possible modifications to the new RPMs (during the first PDP phase) and the UDRP<sup>71</sup> (during the second PDP phase), in each case at an early stage in its work, in order to evaluate which are more suited to policy review and development work, and which relate to procedural and implementation improvements. Staff anticipates that it is at this stage of the work that the PDP Working Group will also consider the relevance of, and need to address, the list of issues (as they pertain to each RPM under consideration) in Annex B.

Thirdly, the PDP Working Group should coordinate with, and track the work of, other parallel or ongoing reviews of specific RPMs and relevant projects that may provide useful data or information to the Working Group (e.g. the ongoing GNSO IGO-INGO Access to Curative Rights Protections Mechanisms PDP Working Group, the TMCH independent review, the CCT Review and the New gTLD Subsequent Procedures PDP Working Group). In this regard, the PDP Working Group should appoint a community liaison to the New gTLD Subsequent Procedures PDP Working Group, who should ideally be a member of both PDP Working Groups.

Fourthly, upon the completion of Phase One of its work, the PDP Working Group should prepare a First Initial Report that also serves as a status report for the GNSO Council and is published for public comment. At a minimum, the report should flag any issues relevant to Phase Two that the PDP Working Group recommends for consideration during a review of the UDRP, any preliminary recommendations the Group intends to make, and any issues or recommendations that the Group believes should be considered by the PDP Working Group on New gTLD Subsequent Procedures.

Finally, in preparing its timeline and project milestones (which would include separating out the tasks appropriate to the two stages of a PDP if the two-pronged approach is adopted), the PDP Working Group should take into account the availability of and demands on community and staff resources, so as to facilitate timely and effective outcomes of various stages of its work.

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<sup>71</sup> These are summarized in Annex 2 of the UDRP Report.

## 5 Next Steps

Staff will forward this Final Issue Report to the GNSO Council for its consideration and action. If the Council decides to launch a PDP, staff will put out a call for volunteers to facilitate a timely launch of the PDP Working Group.

## Annex A – Working Group Charter



# Working Group (WG) Charter

<b>WG Name:</b>	TBD	
<b>Section I: Working Group Identification</b>		
<b>Chartering Organization(s):</b>	GNSO Council	
<b>Charter Approval Date:</b>	TBD	
<b>Name of WG Chair:</b>	TBD	
<b>Name(s) of Appointed Liaison(s):</b>	TBD	
<b>WG Workspace URL:</b>	TBD	
<b>WG Mailing List:</b>	TBD	
<b>GNSO Council Resolution:</b>	<b>Title:</b>	TBD
	<b>Ref # &amp; Link:</b>	TBD
<b>Important Document Links:</b>	<ul style="list-style-type: none"> <li>• GNSO Working Group Guidelines</li> <li>• GNSO PDP Manual</li> <li>• The Current State of the Uniform Domain Name Dispute Resolution Policy: <a href="#">Final Issue Report</a></li> <li>• Staff Paper on Rights Protection Mechanisms in the New gTLD Program: <a href="#">Revised Report</a>, September 2015</li> <li>• Metrics compiled on the new RPMs collected for the Competition, Consumer Trust and Consumer Choice Review: <a href="https://www.icann.org/resources/reviews/cct/metrics#rights%20protection%20mechanisms">https://www.icann.org/resources/reviews/cct/metrics#rights%20protection%20mechanisms</a></li> </ul>	
<b>Section II: Mission, Purpose, and Deliverables</b>		
<b>Mission &amp; Scope:</b>		
<b>Background</b>		
The question of who legally has rights to, or is the legitimate holder of, a domain name can be open to dispute. In relation to domain name disputes concerning the registration and use of		

legally protected trademarks, the Uniform Dispute Resolution Policy (UDRP) is the longest standing alternative dispute resolution procedure. As a result of the New gTLD Program, several new rights protection mechanisms (RPMs) were developed to mitigate potential risks and costs to trademark rights holders that could arise in the expansion of the gTLD namespace: the Uniform Rapid Suspension System (URS); the Trademark Clearinghouse (TMCH) and the associated availability through the TMCH of Sunrise periods and the Trademark Claims notification service; and the Post-Delegation Dispute Resolution Procedures (PDDRs).

Prior to the launch of the New gTLD Program, on 3 October 2011 ICANN staff had published a Final Issue Report on the current state of the UDRP. The recommended course of action in that UDRP Report was not to initiate a PDP at the time, but to hold off launching any such PDP until after the new URS had been in operation for at least eighteen (18) months. In addition, the September 2015 revised RPM Staff Paper had explicitly noted that some of the concerns identified by the community for consideration as part of a review of the RPMs might be appropriate topics for policy development work.

The UDRP has not been subject to comprehensive review. There has also not been a full review of all the RPMs developed to date by ICANN, to consider whether or not they are collectively achieving the objectives for which they were created.

### **Mission and Scope**

This PDP Working Group is being chartered to conduct a review of all RPMs in all gTLDs in two phases: Phase One will focus on a review of all the RPMs that were developed for the New gTLD Program, and Phase Two will focus on a review of the UDRP. Nevertheless, by the completion of its work, the Working Group will be expected to have also considered the overarching issue as to whether or not all the RPMs collectively fulfill the purposes for which they were created, or whether additional policy recommendations are needed, including to clarify and unify the policy goals.

At a minimum, in each Phase of this PDP, the Working Group is expected to first assess the effectiveness of the relevant RPM(s), for which the Working Group should seek the input of experienced online dispute resolution providers and other subject matter experts, as may be appropriate. The Working Group should also consider the interplay between and complementary roles of each RPM in seeking to more fully understand their overall functioning and effectiveness.

Following its preliminary assessment of the effectiveness of the RPM(s), the Working Group should consider the suggestions that have been made to date by the community regarding improvements or modifications to the RPM(s) in question. The list of issues identified for each of the RPMs in the Final Issue Report for this PDP and included in that report as Annex B provide a framework and starting point for the PDP Working Group at this stage in its work, with further modifications, additions and deletions to be determined by consensus of the Working Group.

In the course of its work, the Working Group should monitor the progress of and, where appropriate, coordinate with, other ICANN groups that are working on topics that may overlap with or otherwise provide useful input to this PDP. Especially, this PDP Working Group shall maintain a close working relationship with the Comtetiion, Consumer Trust and Consumer Choice Review Team (CTTRT) and the PDP Working Group on New gTLDs Subsequent Rounds. To

facilitate interaction between the two GNSO PDPs, a GNSO community liaison, who is a member and/or observer of both PDP WGs, shall be appointed by both Working Groups as soon as both Groups have taken up their work. In addition, the RPM PDP Working Group should also take into consideration the work/outcome of the TMCH Independent Review, the CCT Review, and any other relevant GNSO policy development projects.

In addition to any flexibility provided by the GNSO Operating Procedures, Working Group Guidelines and the PDP Manual, the Working Group should, at the conclusion of Phase One of its work, assess the need for modification to this Charter and, if appropriate, submit a request to the GNSO Council accordingly for the subsequent phases of its work.

In addition, the GNSO Council, as the manager of the PDP process should be kept informed at all times about coordination efforts with the CCT and the PDP on New gTLD Subsequent Rounds. It is thus the Council who, in case of conflict between these groups, shall take appropriate action to align work processes if and when necessary.

#### **Objectives & Goals:**

In addition to an assessment of the effectiveness of each RPM, the PDP Working Group is expected to consider, at the appropriate stage of its work, the overarching issue as to whether or not all the RPMs collectively fulfill the purposes for which they were created, or whether additional policy recommendations are needed, including to clarify and unify the policy goals. If such additional policy recommendations are needed, the Working Group is expected to develop recommendations to address the specific issues identified.

The Working Group is also directed to bear in mind that a fundamental underlying intention of conducting a review of all RPMs in all gTLDs is to create a framework for consistent and uniform reviews of these mechanisms in the future.

#### **Deliverables & Timeframes:**

In addition to the PDP deliverables prescribed in the ICANN Bylaws and the PDP Manual, the Working Group shall provide a first Initial Report to the GNSO Council at the conclusion of Phase One of the PDP. The Report shall be put out for public comment and also inform the GNSO Council about the progress of the Working Group. At a minimum, the Report shall outline the Working Group's progress and any preliminary recommendations it may have developed with regard to the new gTLD RPMs. The first Initial Report shall also highlight any relevant findings, information or issues that may have emerged during Phase One and any issues or recommendations that the Group believes should be considered by the PDP Working Group on New gTLD Subsequent Procedures, and/or that the Working Group considers relevant to its work in Phase Two.

Phase Two of the PDP Working Group shall focus primarily on the review of the UDRP. However, during this Phase the WG is also expected to review its first Initial Report, taking into account public comments received, and/or feedback submitted from the New gTLD Subsequent Rounds PDP or other ongoing efforts. Before concluding its work the Working Group shall take into account any relevant developments from the New gTLD Subsequent Rounds PDP WG and/or other relevant ICANN review or policy development work. The Working Group's second Initial Report shall be completed and published for public comment, as per the PDP Manual. The



Working Group shall then review all comments, complete its Final Report and submit it, as per the PDP Manual, to the GNSO Council for its consideration and further action.

**Section III: Formation, Staffing, and Organization**

**Membership Criteria:**

TBD

**Group Formation, Dependencies, & Dissolution:**

TBD

**Working Group Roles, Functions, & Duties:**

TBD

**Statements of Interest (SOI) Guidelines:**

If a WG is formed, each member of its will be required to submit an SOI in accordance with Section 5 of the GNSO Operating Procedures.

**Section IV: Rules of Engagement**

**Decision-Making Methodologies:**

The PDP Working Group will be expected to adhere to the rules in the GNSO PDP Manual and Working Group Guidelines.

**Status Reporting:**

At a minimum, the Working Group should provide periodic updates at appropriate intervals to the GNSO Council, including a first Initial Report at the conclusion of Phase One of its work, and a second Initial Report upon the conclusion of Phase Two (as described above).

**Problem/Issue Escalation & Resolution Processes:**

These are expected to be resolved in accordance with the procedures in the GNSO’s Working Group Guidelines.

**Closure & Working Group Self-Assessment:**

If a Working Group (WG) is formed it will close upon the delivery of a Final Report, unless assigned additional tasks or follow-up by the GNSO Council. A self-assessment of its work will be carried out following the conclusion of the WG’s work.

**Section V: Charter Document History**

Version	Date	Description

<b>Staff Contact:</b>	Lars Hoffman, Mary Wong	<b>Email:</b>	<a href="mailto:Policy-Staff@icann.org">Policy-Staff@icann.org</a>
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**Translations: If translations will be provided please indicate the languages below:**

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## Annex B – List of potential issues for review<sup>72</sup>

The issues that are listed here have largely been derived from the public comments provided to the UDRP Report, initial RPM Staff Paper, and the Preliminary Issue Report. They are being listed here as issues identified by the community that may possibly have some policy impact or necessitate further policy work, and should not be read as indicating any particular level of community support for inclusion in a PDP. These issues are intended to inform the work of any PDP Working Group that is to be formed, and serve as guidelines and a framework for its work, which is expected to include consideration of more general, overarching issues such as:

- Whether all the RPMs have, in the aggregate, been sufficient to meet their objectives or whether new or additional mechanisms, or changes to existing RPMs, need to be developed; and
- Whether any of the new RPMs (such as the URS) should, like the UDRP, be Consensus Policies applicable to all gTLDs, and the transitional issues that would have to be dealt with as a consequence.
- Whether, and if so to what extent, changes to one RPM will need to be offset by concomitant changes to the others.

### 5.1.1.1.1 Potential issues concerning the UDRP

- Are the UDRP's current appeal mechanisms sufficient?
- Should there be a limit to the time period allowed (e.g. similar to a statute of limitation) for bringing UDRP complaints?
- Are free speech and the rights of non-commercial registrants adequately protected in the existing policy?
- Should there be a formal (mandatory) mechanism of early mediation?
- Are the current time limits of the UDRP (for filing, response, determinations and appeals) adequate?

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<sup>72</sup> These issues have been derived from community feedback to the UDRP Report, the Staff Paper, and the Preliminary Issue Report – the merit and importance of each of these has not been analysed by staff as this should be done by the PDP Working Group.

- Should there be rules for the appointment of UDRP panels, such as formalized rotations?
- Under what circumstances (if any) should/could UDRP proceedings be anonymized?
- Should there be clearer policy guidance on a registrar's obligations if a case is stayed or suspended?
- Should the possibility of laches be recognized in UDRP proceedings; if so, how can this be expressly addressed?
- Policy, then this must be done with extreme care, covering the above listed issues but also others, such as:
  - · Should "or" be introduced instead of "and" in the bad faith requirements?
  - · Should there be an introduction of a "loser-pays" scenario?
  - · Should monetary damages be awarded? The UDRP (unlike court proceedings) does not allow this, but there are examples of ccTLD registries now applying monetary damages.
  - · Should the relevant time periods be reduced?
  - · Should filing fees be lower?
  - · Should injunctive relief be available?
  - · Should there be a bad-faith presumption for repeat/serial offenders?
  - · Should repeat/serial offenders be blacklisted from new registrations?
  - · Should permanent suspension be added as an additional potential remedy under the UDRP?
  - · How should the Privacy and Proxy services which are now frequently used by registrants
    - · to shield their identity be more efficiently removed in the course of a UDRP proceeding?
    - · Should the UDRP be revised to cover challenges to trademark-infringing content even in the absence of trademark infringement in the domain name? Should a failure to respond result in an automatic default victory for the complainant?
    - · Should a failure to maintain an active credit card with the registrar in order to fulfil any "loser pays"

- obligations result in an automatic default victory for the complainant?

### 5.1.1.1.2 Potential issues concerning the URS

- Should the ability for defaulting respondents in URS cases to file a reply for an extended period (e.g. up to one year) after the default notice, or even after a default determination is issued (in which case the complaint could be reviewed anew) be changed?
- Is the URS' 'clear and convincing' standard of proof appropriate?<sup>73</sup>
- Is there a need to develop express provisions to deal with 'repeat offenders' as well as a definition of what qualifies as 'repeat offences'?
- Should the URS allow for additional remedies such as a perpetual block or other remedy, e.g. transfer or a "right of first refusal" to register the domain name in question?
- Is the current length of suspension (to the balance of the registration period)<sup>74</sup> sufficient?
- Is the cost allocation model for the URS appropriate and justifiable?
- Should there be a loser pays model? If so, how can that be enforced if the respondent does not respond?
- Should the Response Fee applicable to complainants listing 15 or more disputed domain names by the same registrant be eliminated?<sup>75</sup>

### 5.1.1.1.3 Potential issues concerning Trademark Claims

- Should the Trademark Claims period be extended beyond ninety (90) days?
- Should the Trademark Claims period continue to apply to all new gTLDs?

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<sup>73</sup> See Section 8.2 of the [URS Procedure](#).

<sup>74</sup> See Section 14 of the [URS Rules](#).

<sup>75</sup> See Section 2 of the [URS Procedure](#).

- Should the Abused Domain Name Label service be continued?
- Does a Trademark Claims period create a potential “chilling effect” on genuine registrations, and, if so, how should this be addressed?

#### 5.1.1.1.4 Potential issues for review concerning the Sunrise Period

- Should the availability of Sunrise registrations only for “identical matches” (e.g. without extra generic text) be reviewed?
- Is the notion of “premium names” relevant to a review of RPMs, and, if so, should it be defined across all gTLDs?
- Following from Question 2, should there be a mechanism to challenge whether a domain is a ‘premium name’?
- Should there be a specific policy about the reservation and release of “reserved names” (e.g. modification of Section 1.3.3 of Specification 1 of the current Registry Agreement)?
- Should there be a public, centralized list of all reserved trademarks for any given Sunrise period?
- Should holders of Trademark Clearing House-verified trademarks be given first refusal once a reserved name is released?
- Should Sunrise Periods continue to be mandatory? If so, should the current requirements apply or should they be more uniform, such as a 60-day end-date period?
- Whether and how to develop a mechanism by which trademark owners can challenge Sunrise pricing practices that flout the purpose of Sunrise.
- whether more can be done to improve transparency and communication about various Sunrise procedures.

#### 5.1.1.1.5 Potential issues concerning the Trademark Clearing House (TMCH)

- Should there be an additional or a different recourse mechanism to challenge rejected trademarks?
- Should further guidance on the TMCH verification guidelines for different categories of marks be considered?

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

### 5.1.1.1.6 Additional Questions

- Do the RPMs work for registrants and trademark holders in other scripts/languages, and should any of them be further "internationalized" (such as in terms of service providers, languages served)?
- Do the RPMs adequately address issues of registrant protection (such as freedom of expression and fair use)?
- Have there been abuses of the RPMs that can be documented and how can these be addressed?
- Is there a policy-based need to address the goal of the Trademark PDDRP?
- Are the processes being adopted by Providers of UDRP, URS, and TMCH services fair and reasonable?
- Are the Providers' procedures fair and equitable for all stakeholders and participants?
- Are the Providers consulting with all stakeholders and participants in the evaluation, adoption and review of these new procedures?
- Are the Providers training both the Complainants and the Respondents, and their communities and representatives, fairly and equally in these new procedures?
- Are Providers exceeding the scope of their authority in any of the procedures they are adopting?
- Is ICANN reaching out properly and sufficiently to the multi-stakeholder community when such procedures are being evaluated by ICANN at the Providers' request? Is this an open and transparent process?
- What remedies exist, or should exist, to allow questions about new policies by the Providers offering UDRP, URS and TMCH services, and how can they be expeditiously and fairly created?
- What changes need to be made to ensure that procedures adopted by providers are consistent with the ICANN policies and are fair and balanced?

## Annex C – Overview for 2-phased PDP and coordination with PDP on New gTLD Subsequent Rounds

### Issue

The GNSO has just launched the Subsequent Rounds PDP and may soon launch the RPM PDP. RPMs and their review is an issue that is directly relevant to the Subsequent Rounds PDP. However, it would not be advisable for both PDP working groups to consider the issue as problems could arise ranging from duplicative work and overlapping discussions to contradictory outcomes and recommendations.

### Proposed Approach

Staff suggests that the following steps be taken to facilitate effective functioning and outcomes of both PDPs:

#### ***(1) Potential RPM PDP should have an initial focus on New gTLD RPMs:***

A comprehensive review of all RPMs would include a review of the UDRP. The scope of an RPM PDP would thus be broader than the remit of the Subsequent Rounds PDP. Staff believes that the need to develop a consistent, uniform framework for comprehensive RPM review means that a review of the New gTLD RPMs should be done outside the Subsequent Rounds PDP. In order to align the work (including timing) of the two PDPs while ensuring that a full RPM review includes both the New gTLD RPMs and the UDRP, staff is proposing that the RPM PDP be conducted in two phases, with the review of New gTLD RPMs being done in Phase One. Review of the UDRP would then be done in Phase Two, which will commence upon completion of Phase One.

#### ***(2) Subsequent Rounds PDP to expressly exclude RPM review:***

Staff further proposes to expressly exclude the development of policy recommendations on New gTLD RPMs from the Charter and scope of the Subsequent Rounds PDP. While this should not prevent the Working Group from spotting issues relating to RPMs, the Charter would stipulate that any such pertinent issues that arise in the Subsequent Rounds PDP must be referred to the RPM PDP Working Group.

#### ***(3) Community liaison and staff support:***

To ensure timely communication and facilitate coordination between the two PDP Working Groups, staff is also proposing that a special community liaison – ideally a member of both PDP WGs – be appointed. This should be reflected in the respective Charters for both Working Groups. In terms of ensuring similar coordination and communication among the support staff for both Working Groups, staffing will be assigned to ensure that subject-specific knowledge is shared among the different support teams.



**Flow-Chart of new gTLD RPM PDP**

