Attendance:

George Kirikos

Greg Shatan

Griffin Barnett

Kathy Kleiman

Maxim Alzoba

Michael Karanicolas

Philip Corwin

Susan Payne

Apologies:

Kristine Dorrain

Staff:

Julie Hedlund

Mary Wong

Ariel Liang

Michelle DeSmyter

AC chat:

Michelle DeSmyter:Dear all, welcome to the Review of all Rights Protection Mechanisms (RPMs) Sub Team for Sunrise Data Review call on Wednesdsay, 03 April 2019 at 18:00 UTC.

Michelle DeSmyter:Agenda wiki page: https://community.icann.org/x/dxZIBg George Kirikos:Hi folks.

Julie Hedlund:@All: We will start this call at 5 minutes after the top of the hour to allow people to transition from the previous call.

Griffin Barnett: Are only 3 people on right now? Or are there more on the audio bridge only? Seems like pretty light attendance.....

Griffin Barnett:(now 4 with Phil joining)

George Kirikos: Kathy mentioned on the prior call that this slot might cause a conflict for her.

George Kirikos: (i.e. on the TM Claims call of today)

George Kirikos:Kathy didn't make it last week for this sunrise subteam call, as per the attendance: https://mm.icann.org/pipermail/gnso-rpm-

 $\frac{sunrise/attachments/20190328/e98f0d3d/Attendance ACchatRPM Sunrise 27 March-0001.pdf$

Maxim Alzoba:Hello All

George Kirikos:Only Maxim didn't hear it, Phil.:-)

George Kirikos: (everyone else overlaps)

Maxim Alzoba:@George, what was not heard?

George Kirikos:@Maxim: what Phil is saying now (he said on the TM Claims sub team call earlier today).

George Kirikos:i.e. you're the only person here today that isn't on both sub teams.

George Kirikos:Oh, Kathy made it today, yayyyyy.

Maxim Alzoba:unfortunately I have some other obligations on the top

Kathy Kleiman:Tx George, not teaching today, but enjoyed my class last week. They found ICANN history & processes very interesting.

George Kirikos:Personally, 11 am to 1 pm (for both calls) Toronto time would be perfect...would let me catch afternoon movies more easily, etc.

Maxim Alzoba:Do we have any meetings 01-12 may?

George Kirikos: Might be easier for Susan, too.

susan payne:not really george as I have other meetings at those times

Ariel Liang:Starting page 13

George Kirikos:We did a lot on #3 last week, as

per: https://mm.icann.org/pipermail/gnso-rpm-sunrise/2019-March/000250.html

Maxim Alzoba:@Julie, is it possible to make the PDF scrollable?

George Kirikos:Oh, sorry Susan. What's best for you?

Julie Hedlund:@All: As noted, staff would be grateful if sub team members have suggested text for preliminary recommendations it would be helpful if that could be posted in the chat and identified.

Julie Hedlund:@Maxim: it is unsynced so scrollable.

Griffin Barnett: I thought I possted something in chat on this last week

Griffin Barnett: With a proposal on Q3

Kathy Kleiman: Greg-could you summarize last week?

susan payne:@George, since this is only running until 15 May, I can live with this time George Kirikos:I really need a 38 inch monitor!

Julie Hedlund: Here are the preliminary recommendations from last week:

Julie Hedlund:Tentative Preliminary RecommendationS:1) [George Kirikos] If there's a challenge mechanism, it could be modeled on the Passive Holding doctrine test under the UDRP (with better clarity, as some panelists misinterpret that test). This would be an Implementation Review Team task.2)[(Griffin Barnett] ICANN should establish a mechanism that allows trademark owners to challenge a determination by a registry operator that a particular domain name is a "Premium Name" or a "Reserved Name". The mechanism could be a component of an enhanced Sunrise Dispute Resolution Procedure (SDRP), where the challenger brings the issue to the registry first, with the possibility of an appeal to a neutral third party if the initial direct registry interaction does not result in the desired outcome for the challenger. If the challenger ultimately prevails, the registry operator would be required to change the designation of the domain name at issue such that it is no longer identified as a "Premium Name" or a "Reserved Name" and bec

Maxim Alzoba:@Julie, do we have any RPM meetings in this window? 1 may - 12 may? George Kirikos:I guess we can take (a) (b) and (c) sequentially? For me, (a) = Yes, (b) = Yes, and then a way to actually accomplish it would be to look at the Passive Holding test of the UDRP as a model.

Maxim Alzoba: I asked because I do not see it

in https://urldefense.proofpoint.com/v2/url?u=https-3A gnso.icann.org en group-2Dactivities calendar&d=DwIFaQ&c=FmY1u3PJp6wrcrwll3mSVzgfkbPSS6sJms7xcl4I5cM <u>&r=8 WhWIPqsLT6TmF1Zmyci866vcPSF04VShFqESGe 5iHWGlBLwwwehFBfjrsjWv9&m =0d63PaaQ2Dm SgIYr385JwPdBHiRVYA 73zTX2 jPv4&s=RR1Zm1an5ePdz-etv0fI03Y73vWZimcq7BRbqv-lUvQ&e=</u>

Griffin Barnett:I think the text Julie pasted above was cut off

Julie Hedlund:@All: Staff suggests that if it's helpful staff can take a stab at consolidating the suggestions into language suitable for a preliminary recommendation

Griffin Barnett:But I assume the full thing was captured

Griffin Barnett:from last week

George Kirikos:Griffin: yes, all at: https://mm.icann.org/pipermail/gnso-rpm-sunrise/2019-March/000250.html

George Kirikos: I think Griffin and I do agree.

Julie Hedlund:@Griffin: Although we captured it in full in the notes, the chat room cut off my attempt to paste it.

Julie Hedlund: I must have run up on a limit

Griffin Barnett: Understood, that's what I figured

Maxim Alzoba:NOTE: not yet registered domain does not exist and can not be held Kathy Kleiman:@George: could you define the passive holding test? Always best to define terms:-)

Julie Hedlund:My posting was truncated, but there also was a proposal from Maxim: Julie Hedlund:3. [Maxim Alzoba] Since all registries are real-time (or almost real-time (there is no requirement to make it strictly real time with reaction in milliseconds, it is not a stock exchange after all), Registries have to use something saying - 'this should not pass registration '(for example Registrar via SSR (interface of the RO - Registry Operator platform) sent command to register a domain... the answer should be - registered /not , almost instantly (with ability to check - why not) or Check command - to understand what is possible to do, in what state the domain is etc.) – so there is no time for offline checks, and all types of exclusions (due to policies of ICANN, SSAC recommendations, prohibitions due to local reasons, like prohibition of the registration, for example due to decision of the local court, or the regulator -all records are in the Reserved list ...) So changing Reserved list, will affect Registries in their ability to run real time platforms (and it is required - via SLA means in RA (regist

Julie Hedlund: Also truncated here I see -- sorry

Griffin Barnett:I'm glad George and I agree on (a) and (b), but I'm still having trouble following George's point/suggestion involving passive holding test from UDRP and its applicability in this context

George Kirikos:@Griffin: I was describing how one would actually accomplish the challenge, to be fair to the TM holder and also fair to the registry.

Philip Corwin:https://urldefense.proofpoint.com/v2/url?u=https-

3A www.wipo.int amc en domains search overview3.0 -

23item33&d=DwIFaQ&c=FmY1u3PJp6wrcrwll3mSVzgfkbPSS6sJms7xcl4I5cM&r=8 WhWI PqsLT6TmF1Zmyci866vcPSF04VShFqESGe 5iHWGlBLwwwehFBfjrsjWv9&m=0d63PaaQ2 Dm SgIYr385JwPdBHiRVYA 73zTX2 jPv4&s=XK-

<u>Kp5h9QA LNt0RrBOPUV8dqlowCBZvn QqjljG8JU&e=</u> --- 3.3. Can the "passive holding" or non-use of a domain name support a finding of bad faith?From the inception of the UDRP, panelists have found that the non-use of a domain name (including a blank or "coming soon" page) would not prevent a finding of bad faith under the doctrine of passive

holding. While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put.

Griffin Barnett: Having trouble understanding Maxim, audio seems a bit fuzzy/blown out George Kirikos: e.g. Google-verification-login.tld = reserved, that's likely a winning challenge for Google, as no potential good faith use.

susan payne:me too

Philip Corwin:very muffled

George Kirikos:But, Apple.tld reserved, that's more defensible, as a dictionary word with many potential competing uses.

George Kirikos:Same muffling/mic issue?

susan payne:depends on the TLD george

Griffin Barnett: That's not really a passive holding issue, as it is a legitimate interest type analysis

George Kirikos:@Susan: agree, the test would depend on the TLD.

Griffin Barnett:*seems more like a legitimate interest analysis than passive holding analysis

susan payne:apple.fruit - yes apple.computer - no

George Kirikos:e.g. apple.computers == famous Apple would win.

Julie Hedlund:@Maxim: You also could write in the chat?

George Kirikos: Great minds think alike, or fools seldon differ...;-)

susan payne: I think we're in agreement on concept if not terminology

Griffin Barnett: Maxim I think we all agree that there must be "defenses" or elements that would override a challenge to premium/reserved names sstatus.... we have gone over that repeatedly

Maxim Alzoba: for example, violation of anti-abuse policies caused the domain to be deleted and added to reserved name list ...

George Kirikos: Kathy, then Susan, then me, and Phil.

Iulie Hedlund:@Greg: After Kathy then Susan, George, Phil

Maxim Alzoba: allowing this to be challenged will undermine PIC Spec (Spec 11) of Registry

Griffin Barnett:I disgaree; I think it actually comports with the spirit of Spec 11

Maxim Alzoba:strawberry will be the top

Griffin Barnett:especially in the context of avoiding discriminatory practices, in this case discriminating against brand owners through premium names/reserved names practices

Maxim Alzoba:@Griffin, under Spec 11 Registry can use violations of anti-abuse policy to ensure security and stability

Maxim Alzoba: and undermining this would cause damage to the latter

Griffin Barnett:Yes, and again no one is suggesting there wouldn't be carveouts like that for this proposed challenge mechanism

Griffin Barnett: I think I certainly support those kinds of carve-outs

Maxim Alzoba:@Griffin, I meant prosecution of violations of anti abuse policy by some party leading to deletion of a domain and reserving it forever

Maxim Alzoba:ok, there is a word EXAMPLE, and formally some TM having it might challenge it

Griffin Barnett:@Maxim, ok so if a registry or iCANN or someone has determined that a name MUST remain permanently reserved, that would be a ground for not complying with the challenge

Maxim Alzoba:but in Registry Agreement - ICANN forbids the use of this word Julie Hedlund:@All: Just a reminder that if there is language for a preliminary recommendation you would like staff to capture please include it in the chat -- and call it out as such (rather than just chat)

Griffin Barnett: You seem to be missing that we are all agreeing that such carve-outs should be built in to the suggested challenge mechanism

Maxim Alzoba: Burden and costs should be on the challenging party

Griffin Barnett: I think we are assuming they would be

Griffin Barnett:But again, we are talking about this at a high policy level not going into implementation details

Kathy Kleiman: Are we only staying with trademarks in the TMCH?

Griffin Barnett:Implementation discussions - the specific contours of the mechanism - would need to be discussed and worked out, likely through IRT

George Kirikos:@Kathy: yes, because these are sunrise challenges.

Maxim Alzoba:Clarification: reservation is not against TM owners, it does not allow Anyone to register it

Griffin Barnett:@Maxim but regsitries often reserve and later release/alocate a reserved

Kathy Kleiman:Reservation was also reserved to 100 domain names, at least in the first round

George Kirikos:If the domain goes through sunrise unregistered, then it can be reserved without justification, presumably.

Maxim Alzoba:we should not forget, reserved names are not only for sunrise

Griffin Barnett:And the point is to avoid a scenario where a reserved name otherwise eligible for SUnrise cannot be obtianed during Sunrise by an elgible TM owner, leaving the possiblity open that the name is later unreserved and allocated to another party by the RO, thereby circumventing Sunrise

Griffin Barnett: That's the situation we are trying to address/avoid with this proposed challenge mechanism

George Kirikos:@Maxim: yes, reserved names can go for much longer. But, this is the sunrise subteam.

Griffin Barnett: At least re reserved names

George Kirikos:So. in that context.

susan payne:@Phil, sometimes it's both - reserved because they want to release it as premium at a later date

Griffin Barnett:+1 Susan

Griffin Barnett: Need to keep in mind the entire context of discussion, which is addressing issues about Sunrise

George Kirikos:Of course, I'm saying all this while stil noting that I want sunrise eliminated entirely. (i.e. these are all conditional statements on sunrise surviving).

Julie Hedlund:@Phil and all: Staff sugggests that the Sub Team/WG could agree on the answer and develop specific principles to guide the IRT in creating the mechanism (esp considering that there may be cost, operational and technical considerations appropriate for the IRT to think about).

Maxim Alzoba:if we damage reserved names mechanism - it will be damaged even after the sunrise

Griffin Barnett: I support that approach Julie

Julie Hedlund: And staff could assist with consolidating the proposed preliminary recommendation language received from sub team members.

Griffin Barnett:@Maxim - this proposed mechanism is specifically in the context of a TM owner encountering an issue trying to register a name during SUnrise... so not, it shouldn't apply beyond Sunrise

michael.karanicolas:Non-dictionary marks in the clearinghouse seems like an important caveat

Kathy Kleiman:windows.construction vs. windows.software -- hmmm

Maxim Alzoba:@Griffin, it fits example of police.city

George Kirikos: When we say 'dictionary', I'm assuming that's shorthand, as short acronyms are another class of terms, or numeric domains, which have multiple competing uses.

Griffin Barnett:@Maxim, ALP, QLP, and potential carve-out to challenge mechanism can address that issue

Maxim Alzoba:I do not see reason to believe that Public interest is less important than TM owners interests in such cases

Maxim Alzoba: ALP does not work

Maxim Alzoba:and only combination of QLP, reserved lists, additional limited periods saved GEOs

Griffin Barnett:It's speaking to the same issue as others are mentioning about a legitimate interest in reserving the name to allocate it to a non-TM owner party for a legitimate reason

Griffin Barnett:for dictionary terms

Maxim Alzoba:if we damage reserved lists, then it will not work at all and will be regulated on the local level by the local govt.

Griffin Barnett:I disagree with your characterization that we are "damaging" reserved names lists

Maxim Alzoba: I mean for GEOs

susan payne: I think we have a ton of Qs on ALP to come later

Griffin Barnett:I think we all understand why it is important for certain registries, like GEOs, to be able to ensure that local authorities get dictionary term domains that correspond to their functions, versus a M owner getting such name

Griffin Barnett:*TM owner

Julie Hedlund:@Maxim: YOu are difficult to hear. If you have text that you would like to propose for a preliminary recommendation could you post it in the chat?

Griffin Barnett:We are not trying to prevent that practice

Kathy Kleiman: Do Phil and Maxim have an overlapping suggestion?

Kathy Kleiman: Do Phil and Maxim have an overlapping suggestion?

Griffin Barnett:Only to provide a uniform avenue for a TM owner to legitimately challenge a premium or reserved name where it is clear that the name should not be premium or reserved because its value is entirely because of its association with the brand

Kathy Kleiman: Expecially for Premiums?

George Kirikos:(is there a local dial-in number in Russia, for these calls? -- might be worth trying that)

Maxim Alzoba:I think we might need to ensure safeguards

Maxim Alzoba: also, please do not forget, premiums = pricing and thus regulating it is outside of picket fence and, very important,

Maxim Alzoba: Registries / Registrars, will not have obligations to such policy

Maxim Alzoba:* to follow

Kathy Kleiman: Was this a big problem in round 1?

George Kirikos:Dot-sucks

George Kirikos: A few others, see the supporting data.

Maxim Alzoba: are we really trying to 'circumvent' picket fence?

George Kirikos: (which we analyzed, etc.)

Philip Corwin: Griffin, if the registry operator provides a rationale and asserts its decision is justified the who will be the ultimate arbiter of the dispute and under what objective standard(s) will it be decided? And how much will that cost, and who will pay it?

Philip Corwin: "then who"

Griffin Barnett:@Phil - all good questions

Julie Hedlund: Hands up: George and then Maxim

Griffin Barnett: A lot of implementation detials to think about

Griffin Barnett:but we have manby other dispute mechanisms to look to for guidance Kathy Kleiman:and what is prior to the first sunrise registration, another tradmark owner has put the trademark on a private block list?

Julie Hedlund:@Greg: Staff can try to consolidate the proposals into suggest language for a preliminary recommendation for the sub team to review

Julie Hedlund: It was George and then Maxim with hands up

Maxim Alzoba: for premiums, we are going to invent the policy bit, which will not be enforcable due to picket fence ...

Griffin Barnett:@Kathy the DPML allows an override of that in certain cases for other legitimate brand owners

michael.karanicolas:I think the question of who would pay for this system is important. For me, it's intuitive that the party or parties making the complaints should support the system - since it's fundamentally in support of their interests. But we would need to take care to insure the independence of the decisionmaker against being biased as a result of the source of their funding.

Griffin Barnett: Michael, I think those are fair points

Kathy Kleiman:@Griffin, I think Donuts applied for a DPML with no override

Griffin Barnett:@Kathy, ves vou're referring to DPML+

Maxim Alzoba: also reserved lists is a part of real time software SRS system, and damaging it might cause security and stability concerns

Griffin Barnett:Personally Im not a big fan of that voluntary marketplace RPM

Kathy Kleiman: I think Registries could really face a lot of cases here...

Kathy Kleiman:@Griffin - you and me both :-), and I think it creates some unique complications here.

George Kirikos: The other issue, as mentioned before, is that registrants do not deal directly with registries. They see prices from Registrars.

George Kirikos:So, maybe it's \$1 million because MarkMonitor or CSC is charging that, and the registry price is not public.

Griffin Barnett:@George that's true, but the registry sets the premium names/reserved names

Griffin Barnett:I take your point about if it's possibly an issue of a registrar-markup George Kirikos:@Griffin: right, but the setting is binary, either it's a premium/reserved, or it's not.

Griffin Barnett:But I think going to Phil's earlier point, that issue is generally avoiding based on the marketplace itself

Griffin Barnett:Old hand, sorry

George Kirikos:That's why the Google-verification-login.tld is easier as a test case; only Google itself should get that, no conceivable good faith use.

George Kirikos:(for anyone else other than GOogle, I mean)

Griffin Barnett:@Phil, no there is a concern about infringement with a reserved name, because the name can later be released after Sunrise

Maxim Alzoba:@Griffin, then it is not reserved at that momend of time and can be challenged by URS . UDRP methods

Griffin Barnett:And if it only becomes unreserved after Sunrise, this circumvents the ability of the TM owner to get it during SUnrise and increases the lielhihood of later infringement

Kathy Kleiman: One thing we might think about is the initial filing -- a strict set of requirements for the initial filing by the TMCH trademark owners to the registry

Griffin Barnett:@Maxim that completely overlooks the point of SUnrise as a preventative mechanism

Griffin Barnett: You want to pay for the URS/UDRP if you decide to release the name after Sunrise and it goes to a third-party that infringes?

Griffin Barnett: Well we developed the PDDRPRP, PICDRP, and RRDRP and how often have they been used?

Griffin Barnett:Doesn't mean thye arent important or serve a useful purpose

Maxim Alzoba:@Griffin, URS is few hunderds USD, why there is a belief that the process of challenging is going to be cheaper?

Maxim Alzoba:*why is there

Griffin Barnett:Because I can challenge for free effectively

Maxim Alzoba:@Griffin, just for clarity - TM owners are third parties for Regitries too Griffin Barnett:It's not necessarily about being cheaper, too - remember TM owners have to think about the possible negative impact to goodwill/customers that comes with an infringing or abusive use

Griffin Barnett:So it's usually better to prvent that than to try and cure it after the fact Kathy Kleiman:Something to think about!

Maxim Alzoba: also what is going to happen when few TM owners challenge the same name?

Griffin Barnett:Hence the importance and value of preventative mechanisms

Griffin Barnett:In theory there is supposed to be a limit, but in practice its not the case Maxim Alzoba:it is too much, just to remove profanity names we had tp use 10k list alone Maxim Alzoba:Registries are forbdden from looking into TMCH

Philip Corwin:I guess if more than one rights holder registered the same mark for different goods and services and both wanted the domain there could be (dare i say it;-) an auction of last resort?

susan payne:I don't think that the solution to this is to start prohibiting reserving names Maxim Alzoba:and on top of that - Red Cross and Olympics .e.t.c.

Kathy Kleiman:Interesting about the profanity... which are profanity in some languages and regular words in another (e.g., shit)

Kathy Kleiman:can people share data about this last round?

Griffin Barnett:@Maxim recall that regular SUnrise rules still apply... if a challenged reserved name is determined that it should be unreserved because reserving it inappropriately prevent sit from being registered during SUnrise, FCFS or end-date allocation procedures still apply

George Kirikos:It'll be the 2000th best extensions, vs. the 100th best extensions, i.e. the leftover extensions in the next rounds.

Philip Corwin: As stated orally, I don't think the unavailability of a reserved name that matches a TMCH recorded mark raises a rights protection issue. It's not available, therefore there cannot be an infringing domain.

George Kirikos:@Phil: assumes that the only purpose was a defensive registration.

George Kirikos: (which is likely statistically true for the past rounds!)

Kathy Kleiman: Good discussion - tx Greg!

George Kirikos:But, theoretically, a TM owner might actually want to use that new gTLD domain

Maxim Alzoba:regulating of reserved lists might damage ability of registries to deliver services and to bring innovation to the industry

George Kirikos:Innovations in non-use?

susan payne:@Maxim, agreed

George Kirikos: That's counter to the idea of expansion of the namespace.

Kathy Kleiman: a trademark owner challenges a premium name and it falls into an open list -- not to the trademark owner?

Maxim Alzoba:@George, reserved lists is something deep inside of software almost real-time systems

Griffin Barnett:@Kathy I was specifically discussing reserved names

Kathy Kleiman: I thought we decided to leave reserved names aside?

Maxim Alzoba:ability for third parties to directly affect Registry systems is not something envisioned , hopefully

Julie Hedlund: @All: If we change this time we will run into conflicts.

George Kirikos: EU will be eliminating the time change.

Kathy Kleiman: for the many other purposes that they serve...

susan payne:northern H only!

Julie Hedlund: Not everyone is on this call -- the question has gone to the list.

Griffin M Barnett: Sorry accidentally quit the AC room

George Kirikos: As Griffin said, bad sample, since we all made it.

Philip Corwin:@Griffin -- later release of a reserved name can be addressed in other ways; eg, letting the rights holdfer have first dibs upon release

Maxim Alzoba:@George, unfortunately it might be introduced again for us :(again George Kirikos:Ask those who didn't make the call today, too.

Greg Shatan 2:Good point George.

Julie Hedlund:@All: We have already asked the list and have not gotten objections Griffin M Barnett:@Phil - I'd be open to a right of first refusal to TM owners if a reserved name is later unreserved

Griffin M Barnett:Seems to solve the problem, but need to think about it a bit more Maxim Alzoba:5 -10 may is going to be GDD summit in Bangkok , and Registries and Registrars will not be able to attend

Griffin M Barnett: Again, seems like many implementation issues to work out with that suggestion

Julie Hedlund: We can't go earlier or we have to change TM Claims and that also causes conflicts as were noted on the last call.

George Kirikos:@Julie: yes, but you can ask on the mailing list if anyone objects to (some random idea), and get silence too.....unfortunately, folks tend to not reply on the mailing list.

Griffin M Barnett: Unfortunately, not really a better way to try and address it than that....

George Kirikos:Looks like he's logging back in? (Greg Shatan 2)

Maxim Alzoba: I do not hear Greg, maybe it is because of top of the hour

Griffin M Barnett: Bye all, thanks for the discussion today

Maxim Alzoba: Could we add time of meetings to GNSO Calendar?

George Kirikos:Bye folks.

Maxim Alzoba:bve all