

WG QUESTIONS AND PROVIDER RESPONSES – THE TRADEMARK PDDRP – 16 JUNE 2016

1. What reasons might there be for the TM-PDDRP to have not been used to date?

WIPO Response:

First, it is to be recalled that the PDDRP is intended to be a higher-level enforcement option; as such, the mere fact of its non-use to date does not necessarily indicate that there is no need for the availability of the PDDRP.

Reasons the PDDRP has not been used to date range from the substantive criteria to the various procedural layers. Merely to list a few examples, amongst a range of factors are: failure to accommodate a willful blindness standard, imposition of a two-pronged affirmative conduct requirement, questions about the burden of proof, questions about remedies – notably the failure to address the abusive second-level domain names underlying the PDDRP complaint, the applicability of the PDDRP to registrars (notably following V-I discussions), ICANN’s discretion/role in decision implementation, potentially duplicative procedural layers, failure to expressly allow class/joined complaints, etc.

In any event, as mentioned on the last call, we suggest that as a minimum starting point, the Working Group go back and examine the thorough and extensive comments submitted at least in response to the Proposed Final Applicant Guidebook. For WIPO’s part, these can be found at: www.wipo.int/amc/en/docs/icann021210.pdf.

Finally, we note that potential filing parties are likely to have additional feedback on this question.

ADNDRC Response:

(1) Burden of proof:

Parties to a TM-PDDRP dispute are (a) the trademark holder and (b) the gTLD registry operator.

In the TM-PDDRP mandatory administrative proceeding, a trademark holder as the Complainant claims that one or more of its marks have been infringed, and has thereby been harmed, by (i) the gTLD registry operator’s manner of operation or (ii) use of the gTLD.

The Complaint is based either on the ground of a “Top Level” infringement (for example where a gTLD string is identical to a trademark and then the gTLD registry operator holds itself out as the beneficiary of the mark); OR on the ground of a “Second Level” infringement (for example, where a gTLD registry operator has a

pattern or practice of actively and systematically encouraging registrants to register second level domain names and to take unfair advantage of the Complainant's trademark to the extent and degree that bad faith is apparent; OR where a gTLD registry operator has a pattern or practice of acting as the registrant or beneficial user of infringing registrations, to monetize and profit in bad faith).

(2) Pre-delegation objection, TMCH and SDRP

Probably, instances of a "Top Level" infringement have been minimized by the Pre-delegation objection, TMCH and SDRP. On the other hand, the burden of proof by clear and convincing evidence of an affirmative conduct of a "Second Level" infringement by the gTLD registry operator may be difficult to discharge by the trademark holder.

(3) Available remedies

More importantly the remedies available (as set out in paragraph 18 of TM-PDDRP) might not serve any useful purposes to the trademark holder harmed by a "Second Level" infringement. It might be more convenient and cost-effective to the trademark holder to take the usual UDRP or URS directly against the domain name registrant rather than initiating an action against the registry operator under TM-PDDRP.

FORUM Response:

It is our speculation that the high substantive standards, particularly at the second level (Para 6.2), might be a reason for the TM-PDDRP to have not been used to date.

The few questions we have received about the general purpose of the policy show that the PDDRP may not be well-know or well-understood and therefore, underutilized.

Based on our general experience in alternative dispute resolution, the unspecific nature of the remedies available in TM-PDDRP could be another reason why it has not been used.

2. Is there any ongoing cost to [providers] in having this procedure available if it is not used?

WIPO Response:

WIPO provides its ADR services, including the administration of tens of thousands of UDRP cases and the availability to administer PDDRP cases, on a not-for-profit basis. Any PDDRP case filing would incur filing fees which would in turn support such case administration.

ADNDRC Response:

Yes, the cost is incurred by the follows:

- System maintenance
- Staff training
- Business development

FORUM Response:

Not for FORUM.

3. Have [providers] received any feedback from trademark owners or Registry Operators as to potential problems or other considerations in relation to using the TM-PDDRP?

WIPO Response:

We have received some feedback, particularly concerning the perceived limitations in the PDDRP as outlined in broad terms in reply to Question No. 1.

ADNDRC Response:

No.

FORUM Response:

No.

4. Have [providers] received any enquiries from potential complainants who nevertheless decided not to proceed, in particular as to the standards to be applied?

WIPO Response:

See reply to Question No. 3.

ADNDRC Response:

Yes, we have received a couple of enquiries from potential complainants regarding the flow of proceeding, case filing fee and available remedies. However, we did not hear further from them.

FORUM Response:

FORUM has received very few enquiries about the general purpose of the TM-PDDRP (what does it do?). On a couple of occasions, parties who were facing a potential loss in a pre-delegation TMCH proceeding enquired about a potential TM-PDDRP filing post-delegation.

5. How ready are the Providers in the event that a Complaint is filed?

WIPO Response:

Founded on its globally-recognized expertise in the area of IP-related ADR, WIPO stands ready to administer PDDRP complaints. Our international and legally-trained staff is capable of handling cases in over a dozen languages. We have a dedicated PDDRP email address (in addition to email addresses for general queries) that we monitor regularly.

ADNDRC Response:

Being a key forum for resolving domain name disputes, ADNDRC has handled more than 1,800 UDRP cases, 31 URS cases and 4 TDRP cases.

The four Offices of ADNDRC are managed and supported by leading independent arbitration and dispute resolution institutions in Asia which possess the expertise and global resources for handling different kinds of alternative dispute resolution proceedings. For example, all these four institutions maintain panels of globally diverse neutrals for arbitration, domain name dispute resolution, mediation or adjudication. Moreover, staff members at the four offices are experienced in handling domain name dispute resolution proceedings in different languages, including Chinese, English, Korean and other Asian languages. The prime location of the four offices provides excellent hearing facilities for conducting in person hearings or teleconference.

ADNDRC has also endeavoured to promote the use of UDRP, URS and TM-PDDRP in Asia. Since 2005, ADNDRC has organised conferences on domain name dispute resolution annually in different places in Asia, including Beijing, Hong Kong, Seoul and Kuala Lumpur. With the participation of speakers from ICANN, intellectual property lawyers and domain name experts, ADNDRC conferences have been recognised as the major forum in Asia to discuss salient issues of the domain name dispute resolution. Moreover, staff members of ADNDRC regularly publish articles and deliver presentations on domain name dispute resolution in various occasions.

ADNDRC is ready to handle TM-PDDRP cases.

FORUM Response:

FORUM is ready:

- TM-PDDRP submission forms for both sides are available:
<http://www.adrforum.com/gTLD>
 - FORUM's Supplemental Rules are available:
<http://www.adrforum.com/resources/gTLD/Supplemental%20Rules-PDDRP.pdf>
 - Panelists designated: <http://www.adrforum.com/SearchPanelists>
 - Internal guidelines and procedures available for case coordinators
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6. Have the Providers identified potential Panelists? (Note: at least one seems to have)

WIPO Response:

WIPO has publicly posted a range of PDDRP filing and informational resources, including its current list of PDDRP panelists at: www.wipo.int/amc/en/domains/tmpddrp.

ADNDRC Response:

Yes, ADNDRC has identified several experienced Panelists within its list of 176 Panelists from 24 different places of the world. These panelists are renowned experts specialized in intellectual property and domain name dispute resolution. They have been serving as domain name Panelists in UDRP, URS and TDRP proceedings conducted under the auspices of ADNDRC for since 2002. All of these ADNDRC Panel members can be called upon to support the TM-PDDRP proceedings.

For the full list of ADNDRC Panelists, please refer the ADNDRC's website at <http://www.adndrc.org/mten/ListOfPanelists.php>.

FORUM Response:

Yes. About 35 panelists have signed up to hear TM-PDDRP cases. However, if the need arises, we can expand to our broader panel of domain dispute panelists.

7. Would adding mediation to the Procedure be advisable?

WIPO Response:

With the various procedural layers added to the PDDRP during the iterations of the Applicant Guidebook following its original proposal (www.wipo.int/amc/en/docs/icann130309.pdf), it is difficult to positively answer this question in the abstract. If mediation would merely be an additional layer, then stakeholders may find it difficult to justify yet another layer being added to the PDDRP. If, on the other hand, a mediation component would serve to assist the parties in considering tailored settlement options or remedies (or e.g., to supplant the role of the Threshold Review Panel), then it might prove to be a useful addition to consider. It is recalled in this respect, that WIPO's experience with the UDRP has shown that settlement options are invoked in between 20% – 25% of cases; while these are not mediation-facilitated, it does show the relative benefit of parties considering options other than a full decision on the merits. (It is further recalled that some ccTLDs (e.g., .NL and .CH) successfully employ a mediation component.)

ADNDRC Response:

It could be an effective means of resolving disputes in a time and cost efficient manner following the principle of “Med-Arb”, “Arb-Med” or “Arb-Med-Arb”. The Panelist appointed could also serve as a mediator during the proceeding with the parties' agreement to mediate. There is no duplication of time and cost in bringing different individuals up to speed with the legal and factual background.

However, it has also been criticized that the adverse effect on the panelist's neutrality after having obtained confidential information from a party without the presence of another party during a fruitless mediation.

If mediation will be introduced to the Procedure, ADNDRC will have no problem in handling the proceedings with the support of the four member organizations. There are more than 2000 mediators on the lists and many of them are also on the list of ADNDRC Domain Name Panelists.

FORUM Response:

FORUM does not recommend a mandatory mediation step. Forcing parties to mediate defeats the purpose of mediation, and at times frustrates the parties with undue delays.

We stand ready to consider administering an optional mediation step. However, the working group might consider the additional fees that could be added to the process in case mediation is unsuccessful and the proceedings continue. FORUM does not believe that adding a mediation step will have a significant influence on triggering filings under the TM-PDDRP.

8. What other feedback do the Providers have at this stage, given that the TM-PDDRP has not been used and that the first New gTLD was delegated in October 2013?

WIPO Response:

Generally speaking, see the reply to Question No. 3. We would also encourage this Working Group to bear in mind that the PDDRP forms part of the so-called “tapestry” of RPMs designed in connection with ICANN’s New gTLD Program. Depending on the Working Group’s consideration of, and indeed depending on any changes to other RPMs, there may be yet additional considerations to be taken into account in an assessment of the PDDRP’s likely or intended effectiveness. (To name but one example, the relation between raised concerns over TMCH and Sunrise fees/practices, and registry operator conduct in connection thereto.)

Finally, please note that the above answers are provided merely as a reply to the specific questions raised by members of the RPM Working Group on its most recent call, and should not be taken as our comprehensive policy in put on this or other RPMs.

ADNDRC Response:

More concrete wordings under the paragraph 18 of the, i.e. the available remedies, could be used, including but not limited to:

- Amount of monetary damages or sanctions other than the cost of proceedings
- Actual direct actions by the registry operator that are contrary to those required under the Registry Agreement

FORUM Response:

- ICANN’s compliance has been influential in controlling the registrars and registries. This may raise a question as to why would a potential filer spend their resources to bring a claim under TM-PDDRP and, if successful, receive a recommendation from a panelist to ICANN when instead, it can go directly to ICANN compliance?
- Although TM-PDDRP has not been used so far, we cannot be certain that it is unnecessary as a RPM.
- Solidifying remedies could potentially trigger filings.
- Creating and analyzing example cases could be helpful in determining when TM-PDDRP can be used and who could use it. This process could shed some light on why it hasn’t been used so far.

Additional Suggestions from ADNDRC:

WG should also seek feedback from panelists/arbitrators, especially those who have been trained in the PDDRP or who have extensive experience with similar administrative proceedings or arbitration.

More promotion events should be hosted jointly by ICANN, providers and registry operators.