

A photograph of the Charminar in Hyderabad, India, at night. The monument is illuminated with warm yellow lights, highlighting its intricate architectural details, including the two prominent minarets and the central archway. The sky is a deep blue, and the foreground shows blurred lights from a busy street. The text 'I CANN|57 HYDERABAD' is overlaid in white on the right side of the image.

I CANN|57 HYDERABAD



Review of All Rights Protection Mechanisms (RPMs) in All gTLDs Policy Development Process

Open Working Group Session II 7 November 2016

Agenda for the session today

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Overview of this two-phased PDP

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Status update - where we are now in Phase 1 of the PDP

3

Finalize review - Trademark Post-Delegation Dispute Resolution Procedure

4

Initial discussion - Clarifying Charter questions on the Trademark Clearinghouse

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Community discussion & feedback

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Next steps and overall PDP timeline

Overview of this PDP

- ⊙ PDP Working Group chartered by GNSO Council to review all existing ICANN trademark-related rights protection mechanisms, in all gTLDs, in two phases

Phase One – all RPMs developed for the 2012 New gTLD Program:

- *Trademark Clearinghouse (TMCH) and associated mandatory RPMs offered through it, i.e. Sunrise Registration Periods and Trademark Claims Notices*
- *Uniform Rapid Suspension dispute resolution procedure (URS)*
- *Trademark Post-Delegation Dispute Resolution Procedure (TM-PDDRP)*

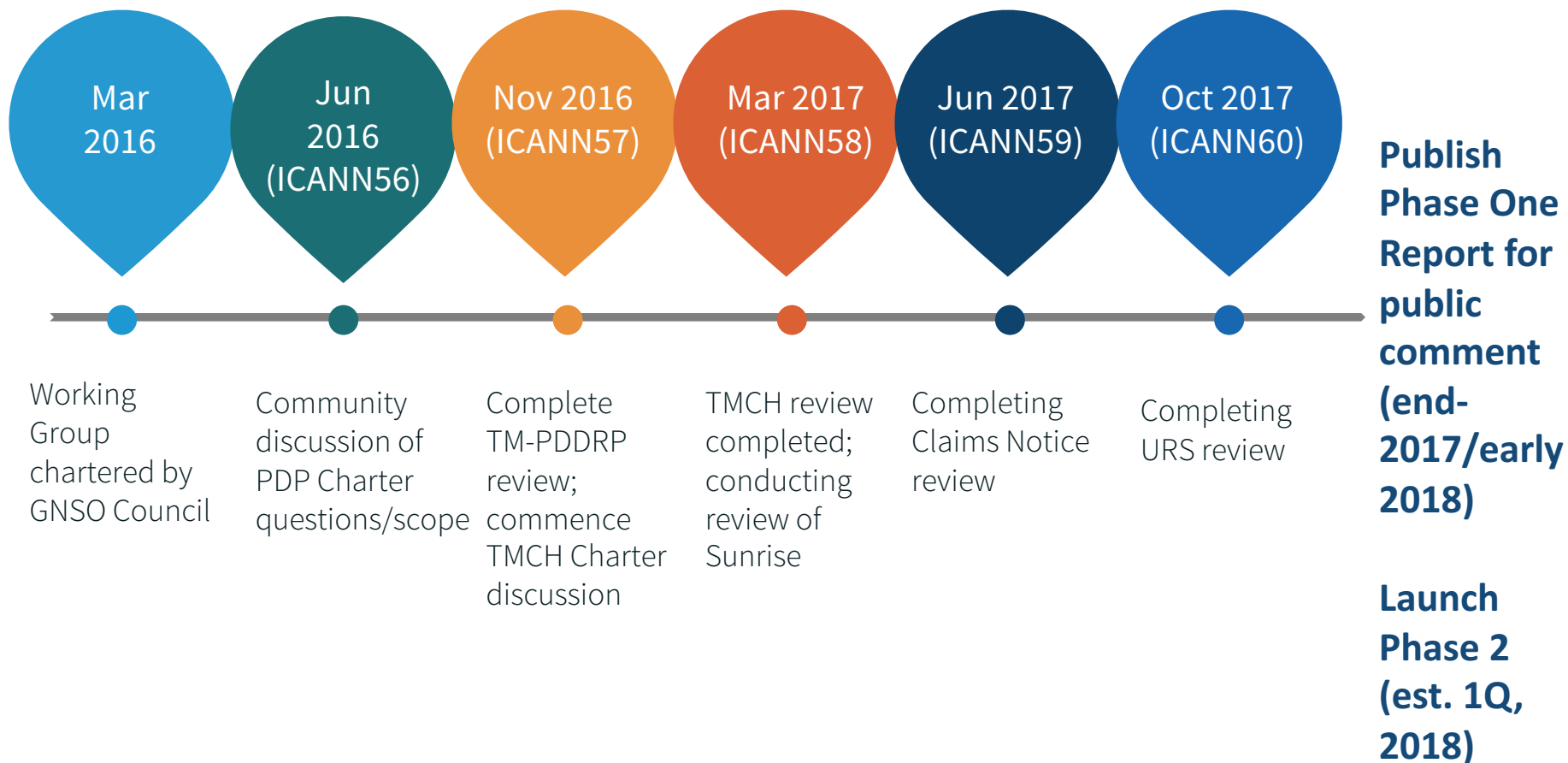
Phase Two – the Uniform Dispute Resolution Policy (UDRP)

- ⊙ Ultimately, the PDP will examine the “*overarching question as to whether 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*”.
- ⊙ Objective is also to create a coherent framework for future RPM reviews

Status Update

- ⊙ **PDP is currently in Phase One** – Working Group elected to begin work with review of the TM-PDDRP
- ⊙ Working Group has begun to consider how to review the TMCH in its formulation as a repository of verified trademarks
 - Two Sub Teams formed:
 - TMCH Data Gathering Sub Team
 - TMCH Charter Questions Sub Team
- ⊙ **Current milestones:**
 - For ICANN57 – aim to complete initial review of TM-PDDRP
 - Chronologically – followed by TMCH; Sunrise; Claims Notification; URS
- ⊙ Aim to **complete Phase One by end-2017/early 2018**
 - No projected date set yet for completion of Phase Two and full PDP

PDP Timeline for Phase One



DISCUSSION TOPIC #1:

Completing the initial review of the Trademark Post-Delegation Dispute Resolution Procedure (TM-PDDRP)

- **Feedback from the dispute resolution providers**

Solicitation of Feedback from TM-PDDRP Providers

Working Group sought initial feedback from the three TM-PDDRP Providers in June 2016

- Initial feedback discussed with the community at ICANN56

Working Group followed up with second request for additional feedback from the Providers in September 2016

- Feedback received from FORUM and WIPO

Following ICANN57 and any additional Working Group deliberations (if needed), ***Working Group will conclude its initial review of TM-PDDRP*** and move on to the Trademark Clearinghouse (TMCH)

Four Follow Up Questions were sent to the TM-PDDRP Providers:

1. Do you think that the TM-PDDRP in its present form permits or does not permit the filing of a joint complaint by multiple different trademark holders, even against the same registry operator for the same allegedly infringing behavior in respect of different trademarks?
2. Under your Supplemental Rules, does consolidation of several complaints by the same trademark owner against different registry operators present any procedural limitations? If so, what are these limitations?
3. Under your Supplemental Rules, is consolidation of several complaints by different trademark owners (including unaffiliated entities) against the same registry operator permitted? If so, what are the limitations?

Follow Up Questions (cont'd):

4. What is your view on the proposal to add the express possibility of a joint complaint to the TM-PDDRP and/or your Supplemental Rules?

- *The Working Group notes that one goal of such an option could be to clarify pre-filing and post-filing consolidation of complaints and minimize any administrative burdens of consolidation on Providers while also maximizing efficiency and cost-effectiveness for complainants.*

If this option is added, what in your view would be the limitations (if any)? If you do not think this would be a useful addition, what are the reasons?

Follow Up Feedback from TM-PDDRP Providers (3)

Q1 - Do you think that the TM-PDDRP in its present form permits or does not permit the filing of a joint complaint by multiple different trademark holders, even against the same registry operator for the same allegedly infringing behavior in respect of different trademarks?

FORUM:

- TM-PDDRP permits filing of joint complaint by multiple different trademark holders; but we assume the parties are related (similar to UDRP requirements for establishing a nexus between multiple Complainants), and not entirely different, unrelated entities.

WIPO:

- It is well-accepted that both corporate affiliates, and separate but commonly aggrieved trademark owners, may file a joint complaint; no reason PDDRP framework would not support this.

Follow Up Feedback from TM-PDDRP Providers (4)

Q2 - Under your Supplemental Rules, does consolidation of several complaints by the same trademark owner against different registry operators present any procedural limitations? If so, what are these limitations?

FORUM:

- We see important procedural limitations. FORUM’s Supplemental Rules state that a consolidation of complaints would be between the “same parties.” They would preclude consolidation of claims against multiple different Registry Operators into a single case.

WIPO:

- The PDDRP, PDDRP Rules and WIPO Supplemental PDDRP Rules mention consolidation of cases involving the same registry operator. A PDDRP case seeking to consolidate claims against different registry operators would seem to meet a (substantive) limitation insofar as they would not be under common control.

Q3 - Under your Supplemental Rules, is consolidation of several complaints by different trademark owners (including unaffiliated entities) against the same registry operator permitted? If so, what are the limitations?

FORUM:

- Not permitted in current Supplemental Rules for unaffiliated entities.

WIPO:

- No reason the PDDRP framework would not support this approach.
 - UDRP panels faced with the question of a potential consolidated proceeding look at whether the particular facts and circumstances of each case support a claim ... Subject to the panel's ultimate authority on the matter [WIPO] on receipt [assesses whether] criteria are prima facie satisfied.
- In practice, such complaints typically filed jointly at first instance (as opposed to being joined after filing).

Follow Up Feedback from TM-PDDRP Providers (6)

Q4 - What is your view on the proposal to add the express possibility of a joint complaint to the TM-PDDRP and/or your Supplemental Rules? If this option is added, what in your view would be the limitations (if any)? If you do not think this would be a useful addition, what are the reasons?

FORUM:

- Recognizes the potential utility of explicitly permitting multiple unaffiliated claimants to file a single Complaint [but more extensive changes to Supplemental Rules likely needed].
- Little room for potential efficiencies with respect to inclusion of multiple registry operator into a a single complaint as due process considerations would demand fundamentally separate determinations.

WIPO:

- While not in our view strictly necessary, adding language to the PDDRP and PDDRP Rules (and WIPO Supplemental PDDRP Rules) to expressly address joint and consolidated complaints may be useful insofar as it could provide clarity to potential filing parties.
- Parties would likely also benefit from reasonable consistency in terms of outcome.

DISCUSSION TOPIC #2:

Outline of TMCH Charter Questions

- **Partial list of clarifications agreed to by the TMCH Charter Questions Sub Team**

TMCH Charter Questions Sub Team – formation and task

- ⦿ Sub Team formed to review all Working Group Charter questions relating to the TMCH (not including Sunrise or Claims Notice RPMs)
- ⦿ Sub Team has not reached agreement on all the questions – for ICANN57 only those questions where agreement was reached are being presented

GENERAL NOTE:

- ⦿ All questions on each RPM currently listed in the Charter are those raised by the community in various public comment forums (including to the Preliminary Issue Report for this PDP)

For each RPM, the Working Group will be reviewing the questions, with the aim of:

- Clarifying and refining them where appropriate
- Adding questions where fundamental gaps are found
- Editing and deleting questions that are duplicative or out of scope

TMCH Review - Suggested Categories for the Charter Questions

Five suggested categories:

- ⦿ Guidance
- ⦿ Verification & Updating of TMCH Database
- ⦿ Balance
- ⦿ Accessibility & Access
- ⦿ Costs & Other Fundamental Features

GUIDANCE:

1. Should the TMCH verification criteria be clarified or amended? If so, how?
2. What activities does the TMCH undertake to communicate: (i) the criteria it applies when determining whether or not to accept marks; and (ii) what to do when registrations are challenged?
3. Should the TMCH be responsible for education services for trademark owners, domain name registrants and potential registrants? If so, how? If the TMCH is not to be responsible, who should be?

VERIFICATION & UPDATING OF TMCH DATABASE:

1. Should there be an additional or a different recourse mechanism to challenge rejected trademarks?
2. How quickly can and should a cancelled trademark be removed from the TMCH to avoid discouraging or losing domain names registration? Is this satisfactory?

BALANCE

1. Does the scope of the TMCH and the protection mechanisms which flow from it, reflect the appropriate balance between the rights of trademark holders and the legitimate rights of non-trademark registrants?

Background to the PDP:

<https://gnso.icann.org/en/group-activities/active/rpm>

PDP Working Group Charter:

<https://community.icann.org/x/2CWAAw>

Working Group online wiki space (containing recordings and transcripts of all Working Group and Sub Team calls; draft documents and background materials):

<https://community.icann.org/x/wCWAAw>

Engage with the PDP Working Group



Thank you for your feedback!

Reach us at:

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