

Phase 1 Initial Report on the Review of All Rights Protection Mechanisms in All gTLDs Policy Development Process

18 March 2020

Status of This Document

This is the Phase 1 Initial Report of the GNSO Policy Development Process (PDP) on the Review of All Rights Protection Mechanisms (RPMs) in All gTLDs, covering RPMs applicable to gTLDs launched under the 2012 New gTLD Program. This Initial Report has been posted for public comment.

Preamble

The primary objective of this Initial Report is to solicit input/feedback on the PDP Working Group's: (i) twenty-six (26) preliminary recommendations; (ii) seventeen (17) specific questions for community input; and (iii) twenty-four (24) proposals submitted by individual Working Group members that did not rise to the level of becoming preliminary recommendations. In addition, the Working Group invites input for its six (6) overarching Charter questions. This Initial Report also documents the Working Group's deliberations and other pertinent information that provides background, context, and rationale. The Working Group will produce its Final Report after its review of the public comments received in response to this Initial Report, and subsequently submit its Final Report to the GNSO Council for its consideration.

Table of Contents

1 EXECUTIVE SUMMARY	3
2 OVERVIEW OF PRELIMINARY RECOMMENDATIONS AND QUESTIONS FOR COMMUNITY INPUT	6
3 DELIBERATIONS OF THE WORKING GROUP	22
3.1 Introduction	22
3.2 Deliberations of Uniform Rapid Suspension System	22
3.3 Deliberations of Trademark Clearinghouse Structure and Scope	37
3.4 Deliberations of Sunrise Service	38
3.5 Deliberations of Trademark Claims Service	48
3.6 Deliberations of Trademark Post-Delegation Dispute Resolution Procedure	53
4 INDIVIDUAL PROPOSALS (NON-RECOMMENDATIONS)	56
4.1 Introduction	56
4.2 Individual Proposals for Uniform Rapid Suspension System	56
4.3 Individual Proposals for Trademark Clearinghouse	70
5 ADDITIONAL MARKETPLACE RIGHTS PROTECTION MECHANISMS	80
6 NEXT STEPS	81
7 BACKGROUND	83
8 APPROACH TAKEN BY THE WORKING GROUP	99
9 ANNEX A – PDP WORKING GROUP CHARTER	105
10 ANNEX B – CHARTER QUESTIONS	115
11 ANNEX C – WORKING GROUP DOCUMENTS	138
12 ANNEX D – WORKING GROUP MEMBERSHIP AND ATTENDANCE	142
13 ANNEX E – COMMUNITY INPUT	147

1 Executive Summary

1.1 Background

On 18 February 2016, the GNSO Council voted¹ to initiate the Policy Development Process (PDP) on the Review of All Rights Protection Mechanisms (RPMs) in All gTLDs. On 15 March 2016, the GNSO Council approved the PDP Charter² for the review to be conducted in two phases. Phase 1 focuses on reviewing all the RPMs and associated structures and procedures applicable to gTLDs launched under the 2012 New gTLD Program, specifically:

- The Uniform Rapid Suspension System (URS);
- The Trademark Clearinghouse (TMCH);
- The Sunrise and Trademark Claims services offered through the TMCH; and
- The Trademark Post-Delegation Dispute Resolution Procedure (TM-PDDRP).

Phase 2 will focus on reviewing the Uniform Dispute Resolution Policy (UDRP), which has been an ICANN Consensus Policy since 1999. Please see the “Background” section of this Initial Report for summaries of these RPMs.

On 21 April 2016, the Working Group held its first meeting to commence its Phase 1 work and has been meeting regularly since that time.

1.2 Deliberations and Outcome

The Working Group’s Charter contains a list of specific topics and questions that were reproduced verbatim from previous ICANN community consultations on the topic of RPMs. This led to the Working Group agreeing, early on in its work, that it would first need to refine these original Charter questions so as to clarify their intent and ensure that the PDP discussions remain objective and neutral. Please see the “Annex B - Charter Questions” section of this Initial Report for additional details.

To address the final agreed Charter questions for Phase 1, the Working Group engaged in extensive data collection and analysis efforts, as to date there has not been comprehensive studies or data collected that measures the effectiveness of the Phase 1 RPMs.

¹ See the approved GNSO Council motion initiating the PDP here:

<https://gns0.icann.org/en/council/resolutions#201602>

² The Charter of the PDP Working Group is included in the “Annex A - PDP Working Group Charter” section of this Initial Report. It can also be downloaded here: https://gns0.icann.org/sites/default/files/filefield_48755/rpm-charter-15mar16-en.pdf

As a result of its analysis of the data and input it collected, the Working Group is proposing a total number of twenty-six (26) preliminary recommendations at this time. No formal consensus call has been taken on any of the preliminary recommendations, but these received sufficient support among the Working Group to be included as preliminary recommendations for public comment.

The Working Group is also including seventeen (17) questions for which it wishes to seek community input. The Working Group hopes the community input will allow it to finalize any recommendations that it may wish to make on these topics in its Final Report. All these preliminary recommendations and community questions are consolidated in the “Overview of Preliminary Recommendations and Questions Seeking Community Input” section of this Initial Report.

In addition, the Working Group is putting forward a total number of twenty-four (24) individual proposals specifically pertaining to the URS and TMCH, which are included in the “Individual Proposals (Non-Recommendations)” section of this Initial Report. These proposals were submitted by individual Working Group members for Working Group consideration but have not, at this time, attained sufficient agreement amongst the Working Group such as to become preliminary recommendations.

This Initial Report also includes a summary of the Working Group’s discussion of the additional marketplace RPMs that several Registry Operators and the current TMCH Validation Service Provider have voluntarily adopted, over and above the mandatory ICANN RPMs. The Working Group did not develop any specific recommendations concerning these RPMs as they are outside the scope of this PDP. Please see the “Additional Marketplace RPMs” section of this Initial Report for details.

It should be noted that the PDP Charter includes several general, overarching questions as well as a number of additional questions that the Working Group is expected to address at the conclusion of Phase 1 or Phase 2 of its work, as appropriate. The Working Group also invites input for six (6) overarching Charter questions during the public comment proceeding for the Initial Report. Furthermore, after the completion of the public comment, the Working Group is expected to consider a general question about the additional marketplace RPMs, which is related to one of its overarching Charter questions. These overarching Charter questions and the additional general question are described in the “Next Steps” section.

1.3 Conclusions and Next Steps

This Initial Report will be posted for public comment for 40 days. After the Working Group reviews public comments received on this Initial Report, it will finalize its recommendations and develop the Final Report.

The Working Group’s review of the public comments may lead to Working Group consensus to:

- Amend, add, and/or remove its preliminary recommendation published in this Initial Report;

- Make final consensus recommendations on any of the proposals submitted by individual Working Group members that are published in this Initial Report.

Following a formal consensus call at the plenary level, the Working Group's Final Report will be updated accordingly with the proposed PDP final recommendation, which will then be reviewed by the GNSO Council and, if approved, forwarded to the ICANN Board of Directors for approval as an ICANN Consensus Policy.

1.4 Other Relevant Sections of this Initial Report

For a complete review of the issues, methodologies, and interactions of this Working Group, the following sections are included in this Initial Report:

- Summary of Working Group deliberation that includes context for preliminary recommendations and community questions;
- Documentation on the Working Group's Sub Team approach, data gathering and review efforts, and Charter question refinement work;
- An annex of featured documents and tools that assisted the Working Group's review of Phase 1 RPMs.

2 Overview of Preliminary Recommendations and Questions Seeking Community Input

2.1 Introduction

In its Phase 1 Initial Report, the PDP Working Group is putting forward a total number of twenty-six (26) preliminary recommendations for the URS, TMCH, Sunrise and Trademark Claims services, and TM-PDDRP. At this time, no formal consensus call has been taken on these preliminary recommendations, but these did receive the support of the Working Group for publication for public comment.

The Working Group is also including seventeen (17) questions related to some of these mechanisms, for which it wishes to seek community input. The Working Group hopes the community input will allow it to finalize any recommendations that it may wish to make on these topics in its Final Report.

In developing preliminary recommendations and community questions, the Working Group used the Sub Team approach, when it considered this to be appropriate. Specifically, the preliminary recommendations and community questions for the URS, Sunrise and Trademark Claims services were originally developed by the Working Group's Sub Teams and subsequently endorsed by the full Working Group at the plenary level.

While the Working Group also discussed additional marketplace RPMs that several Registry Operators and the TMCH Validation Service Provider had voluntarily adopted, over and above the mandatory ICANN RPMs, it did not develop any specific recommendations concerning these RPMs as they are outside the scope of this PDP. Please see the "Additional Marketplace RPMs" section of this Initial Report for details.

In addition, the Working Group is putting forward a total number of twenty-four (24) individual proposals specifically pertaining to the URS and TMCH, which are included in the "Individual Proposals (Non-Recommendations)" section of this Initial Report. These proposals were submitted by individual Working Group members for Working Group consideration but have not, at this time, attained sufficient agreement amongst the Working Group such as to become preliminary recommendations.

The Working Group's review of the public comments may lead to Working Group consensus to:

- Amend, add, and/or remove its preliminary recommendation published in this Initial Report;
- Make final consensus recommendations on any of the proposals submitted by individual Working Group members that are published in this Initial Report.

Following a formal consensus call at the plenary level, the Working Group’s Final Report will be updated accordingly with the proposed PDP final recommendation, which will then be reviewed by the GNSO Council and, if approved, forwarded to the ICANN Board of Directors for approval as an ICANN Consensus Policy.

2.2 URS Preliminary Recommendations and Community Questions

Note: Since many URS preliminary recommendations and community questions are related, they are placed side by side for easy reference.

Preliminary Recommendation	Question Seeking Community Input
<p>URS Recommendation #1 The Working Group recommends that URS Rule 3(b), and, where necessary, a URS Provider’s Supplemental Rules be amended to clarify that a Complainant must only be required to insert the publicly-available WHOIS/Registration Data Directory Service (RDDS) data for the domain name(s) at issue in its initial Complaint.</p> <p>Furthermore, the Working Group recommends that URS Procedure para 3.3 be amended to allow the Complainant to update the Complaint within 2-3 calendar days after the URS Provider provides updated registration data related to the disputed domain name(s).</p>	<p>URS Question #1 1a. Should URS Rule 15(a) be amended to clarify that, where a Complaint has been updated with registration data provided to the Complainant by the URS Provider, there must be an option for the Determination to be published without the updated registration data?</p> <p>1b. If so, when, by whom, and how should this option be triggered?</p> <p>1c. Are there any operational considerations that will need to also be addressed in triggering this option?</p>
<p>URS Recommendation #2 The Working Group recommends that URS Providers send notices to the Respondent by the required methods after the Registry or Registrar has forwarded the relevant WHOIS/RDDS data (including contact details of the Registered Name Holder) to the URS Providers.</p>	
<p>URS Recommendation #3 The Working Group recommends that URS Providers must comply with URS Procedure para 4.2 and para 4.3 and transmit the Notice of Complaint to the Respondent, with translation in the predominant language of the Respondent, via email, fax, and postal mail.</p>	

Preliminary Recommendation	Question Seeking Community Input
<p>URS Recommendation #4</p> <p>The Working Group recommends that the ICANN org establishes a compliance mechanism to ensure that URS Providers, Registries, and Registrars operate in accordance with the URS rules and requirements and fulfill their role and obligations in the URS process.</p> <p>The Working Group recommends that such compliance mechanism should include an avenue for any party in the URS process to file complaints and seek resolution of noncompliance issues.</p> <p>As an implementation guidance, the Working Group recommends that the Implementation Review Team considers:</p> <ul style="list-style-type: none"> Investigating different options for a potential compliance mechanism, such as ICANN Compliance, other relevant department(s) in ICANN org, a URS commissioner at ICANN org, a URS standing committee, etc. Developing metrics for measuring performance of URS Providers, Registries, and Registrars in the URS process. 	<p>URS Question #2</p> <p>2a. What compliance issues have Registries and Registrars discovered in URS processes, if any?</p> <p>2b. Do you have suggestions for how to enhance compliance of URS Providers, Registries, and Registrars in the URS process?</p>
<p>URS Recommendation #5</p> <p>The Working Group recommends that the ICANN org, Registries, Registrars, and URS Providers keep each other's contact details up to date in order to effectively fulfill the notice requirements set forth in the URS Procedure para 4.</p>	<p>URS Question #3</p> <p>The Working Group recommends that public comment be sought from <u>Registry Operators</u> on the following question:</p> <p>3a. Have Registry Operators experienced any issues with respect to receiving notices from URS Providers?</p> <p>3b. Were these notices sent through appropriate channels?</p> <p>3c. Did the notices contain the correct information?</p>
<p>URS Recommendation #6</p>	<p>URS Question #4</p>

Preliminary Recommendation	Question Seeking Community Input
<p>The Working Group recommends that a uniform set of educational materials be developed to provide guidance for URS parties, practitioners, and examiners on what is needed to meet the “clear and convincing” burden of proof in a URS proceeding.</p> <p>As an implementation guidance, the Working Group recommends that the educational materials be developed in the form of an administrative checklist, basic template, and/or FAQ. Specifically, the Working Group recommends that the educational materials be developed with help from URS Providers, Practitioners, Panelists, as well as researchers/academics who study URS decisions closely.</p>	<p>4a. What content and format should these educational materials have?</p> <p>4b. How should these educational materials be developed?</p> <p>4c. Who should bear the cost for developing these educational materials?</p> <p>4d. Should translations be provided?</p>
<p>URS Recommendation #7</p> <p>The Working Group recommends that all URS Providers require their examiners to document their rationale in sufficient detail to explain how the decision was reached in all issued Determinations.</p> <p>As an implementation guidance, the Working Group also recommends that URS Providers provide their examiners a uniform set of basic guidance for documenting their rationale for a Determination. The purpose of the guidance is to ensure consistency and precision in terminology and format as well as ensure that all steps in a proceeding are recorded. Such guidance may take the form of an administrative checklist or template of minimum elements that need to be included for a Determination.</p>	
<p>URS Recommendation #8</p> <p>The Working Group recommends that the Implementation Review Team considers reviewing the implementation issues with respect to the Registry Requirement 10 in the “URS High Level Technical Requirements for Registries and Registrars” and amend the</p>	<p>URS Question #5</p> <p>Should the Registry Requirement 10 be amended to include the possibility for another Registrar, which is different from the sponsoring Registrar but accredited by the same Registry, to be elected by the URS Complainant to renew the URS Suspended</p>

Preliminary Recommendation	Question Seeking Community Input
<p>Registry Requirement 10, if needed. The Providers Sub Team discovered issues with respect to implementing the outcomes of a URS proceeding (e.g. relief awarded following a URS decision, or where the parties settle³ the case prior to Determination, or where a Complainant requests to extend a suspension).</p>	<p>domain name, and to collect the Registrar renewal fee?</p>
<p>URS Recommendation #9 The Working Group recommends that as implementation guidance, the Implementation Review Team considers developing guidance to assist the URS providers in deciding what language to use during a URS proceeding and when issuing a Determination. Such guidance should take into account the fact that domains subject to a URS Complaint may have been registered via a privacy or proxy service and the location of the service will determine the language of that service, which may be relevant.</p>	
<p>URS Recommendation #10 The Working Group recommends that clear, concise, easy-to-understand informational materials should be developed, translated into multiple languages, and published on the URS Providers' websites to assist Complainants and Respondents in URS proceedings. Such information materials should include, but not be limited to: 1) a uniform set of basic FAQs, 2) links to Complaint, Response, and Appeal forms, and 3) reference materials that explain URS Providers' services and practices.</p>	<p>URS Question #6 Who has the responsibility for developing the uniform set of basic FAQs for URS Complainants and Respondents?</p>
	<p>URS Question #7 What mechanism do you suggest that allows a URS Provider to efficiently check with other URS and UDRP Providers in order to ensure that a disputed domain name is not already</p>

³ URS Rules 16(a) stipulates that if, before the Examiner's Determination, the Parties agree on a settlement, the Examiner shall terminate the URS proceeding.

Preliminary Recommendation	Question Seeking Community Input
	subject to an open and active URS/UDRP proceeding?
	<p>URS Question #8 The Working Group recommends that public comment be sought from <u>Registry Operators</u> on the following questions:</p> <p>8a. What issues have you encountered with respect to implementing the HSTS-preloaded domain suspension remedy, if any?</p> <p>8b. What would need to be done to help resolve the issues you have encountered?</p>
	<p>URS Question #9 Are the non-refundable, late Response fees paid by Respondent reasonable?</p> <p>FORUM has a flat fee for late response. ADNDRC and MFSD have fees based on the number of domains and/or the type of Respondents involved. FORUM has never collected these fees for late response.</p> <ul style="list-style-type: none"> • FORUM: <ul style="list-style-type: none"> ○ Re-examination Fee (more than 30 days late): 200 USD ○ Re-examination Extension Fee: 100 USD • ADNDRC: <ul style="list-style-type: none"> ○ 1 to 5 domain names: 180 USD ○ 6 to 14 domain names: 200 USD ○ 15 to 29 domain names: 225 USD ○ 30 domain names or more: To be determined by the Relevant Office of ADNDRC • MFSD: <ul style="list-style-type: none"> ○ Paid by the Respondent who is natural person/sole proprietorship/public body/non-profit entity <ul style="list-style-type: none"> ▪ 1-15 domain names: 175 EUR ▪ 16-50 domain names: 200 EUR ▪ 50 domain names or more: To be decided with MFSD

Preliminary Recommendation	Question Seeking Community Input
	<ul style="list-style-type: none"> ○ Paid by the Respondent who is partnership/corporation/public company/private limited/limited liability company <ul style="list-style-type: none"> ▪ 1-15 domain names: 190 Euros ▪ 16-50 domain names: 225 Euros ▪ 50 domain names or more: To be decided with MFSD
	<p>URS Question #10</p> <p>10a. Are penalties for Complainant or Respondent who abuses the URS process sufficient?</p> <p>10b. If not, should they be expanded?</p> <p>10c. If they should be expanded, how?</p> <p>Per Section 11.4 and 11.5 of the URS Procedure, the penalties for abusive complaints are:</p> <ul style="list-style-type: none"> • 11.4 In the event a party is deemed to have filed two (2) abusive Complaints, or one (1) “deliberate material falsehood,” that party shall be barred from utilizing the URS for one-year following the date of issuance of a Determination finding a complainant to have: (i) filed its second abusive complaint; or (ii) filed a deliberate material falsehood. • 11.5 Two findings of “deliberate material falsehood” shall permanently bar the Complainant from utilizing the URS.

2.3 TMCH Preliminary Recommendation

Preliminary Recommendation
<p>TMCH Recommendation #1</p>

The Working Group considered the following aspects of the TMCH⁴:

1. Whether the “TM +50” rule should be changed or maintained;
2. Whether the current “exact match” rules should be changed or maintained; and
3. Whether, where a trademark contains dictionary term(s), the Sunrise and Trademark Claims RPMs should be limited in their scope such as to be applicable only in those gTLDs that relate to the categories of goods and services for which the dictionary term(s) within that trademark are protected.

The Working Group’s preliminary recommendation for these three questions is that the status quo (i.e. the current rules as applied to the gTLDs delegated under the 2012 New gTLD Program round) should be maintained.

The Working Group’s review of the public comments on these topics may lead to Working Group consensus to amend its preliminary recommendation in respect of one or more of these topics, in which case the Working Group’s Final Report will be updated accordingly with specific, numbered recommendations.

2.4 Sunrise Service Preliminary Recommendations and Community Questions

Preliminary Recommendation
<p>Sunrise Recommendation #1</p> <p>In the absence of wide support for a change to the status quo, the Working Group recommends that the current availability of Sunrise registrations only for identical matches should be maintained, and the matching process should not be expanded.</p>
<p>Sunrise Recommendation #2</p> <p>The Working Group recommends that the Registry Agreement for future new gTLDs includes a provision stating that a Registry Operator shall not operate its TLD in such a way as to have the effect of circumventing the mandatory RPMs imposed by ICANN or restricting brand owners’ reasonable use of the Sunrise rights protection mechanism.</p>
<p>Sunrise Recommendation #3</p> <p>In the absence of wide support for a change to the status quo, the Working Group does not recommend the creation of a challenge mechanism.</p>
<p>Sunrise Recommendation #4</p> <p>In the absence of wide support for a change to the status quo, the Working Group does not recommend the publication of the Reserved Names lists by Registry Operators.</p>
<p>Sunrise Recommendation #5</p>

⁴ For additional details about the TMCH, please see Trademark Clearinghouse in Module 5 of the gTLD Applicant Guidebook: <https://newgtlds.icann.org/en/applicants/agb/trademark-clearinghouse-04jun12-en.pdf>

<p>The Working Group recommends that the current requirement for the Sunrise Period be maintained, including for 30-day minimum period for a Start Date Sunrise and the 60-day minimum period for an End Date Sunrise.</p>
<p>Sunrise Recommendation #6 In the absence of wide support for a change to the status quo, the Working Group recommends that the mandatory Sunrise Period should be maintained.</p>
<p>Sunrise Recommendation #7 The Working Group recommends that the next version of the Applicant Guidebook (AGB) for future new gTLDs be amended as follows:</p> <ol style="list-style-type: none"> 1. The new version of the AGB should include the TMCH dispute resolution procedure for challenging the validity of trademark records entered into the TMCH. This procedure is currently published at: https://www.trademark-clearinghouse.com/dispute#3.3. ICANN org should ensure that its contract for the provision of TMCH services makes the operation of the TMCH dispute resolution procedure a requirement for the TMCH Validation Service Provider. 2. Section 6.2.4 of the current Trademark Clearinghouse Model of Module 5 of the AGB must be amended to remove grounds (i) and (iii). 3. The Trademark Clearinghouse Model of Module 5 of the AGB must be amended to include a new Section 6.2.6 – “The Registry Operator will, upon receipt from the TMCH of a finding that a Sunrise registration was based upon an invalid TMCH record (pursuant to a TMCH dispute resolution procedure), immediately delete the domain name registration. Registry Operators in their applicable SDRPs will describe the nature and purpose of the TMCH challenge process and provide a link to the TMCH for reference.” <p>Note: Registry Operators should continue to have the option to offer a broader SDRP to include optional/additional Sunrise criteria as desired.</p>
<p>Sunrise Recommendation #8 In the absence of wide support for a change to the status quo, the Working Group does not recommend that the scope of Sunrise Registrations be limited to the categories of goods and services for which the trademark is actually registered and put in the Clearinghouse.</p>
<p>Question Seeking Community Input</p>
<p>Sunrise Question #1 What remedy(ies) would you propose for any unintended effects of the Sunrise Period that you have identified in your public comment?</p>
<p>Sunrise Question #2 2a. Have you identified abuses of the Sunrise Period? 2b. To the extent that you have identified abuses of the Sunrise Period, if any, please describe them and specify any documentation to substantiate the identified abuses.</p>
<p>Sunrise Question #3</p>

The Working Group recommends that public comment be sought on questions #3a-d from Registry Operators. The Working Group asks Registry Operators to be specific about which program(s) (i.e., ALP⁵, QLP⁶, and/or LRP⁷) they are referring in their responses to all questions and what the shortcomings of each of those mechanisms are. These questions are related to Sunrise Question #4.

3a-1. If you did not attempt an ALP, QLP, or LRP, was the reason for not taking advantage of those programs related to how they integrate with Sunrise?

3a-2. Were you able to achieve your goals in a different way (such as by combining any or all of these programs)?

3b-1. If you did attempt an ALP, QLP, or LRP (or combination) but didn't successfully use any, was the reason you did not take advantage of those programs related to how they integrate with Sunrise?

3b-2. Were you able to achieve your goals in a different way? For instance, some Registry Operators may have used the QLP 100 (Section 3.2 of Registry Agreement Specification 5⁸) (plus IDN variants) in combination with registry-reserved names to obtain the names they needed. Did you do this?

3b-3. If so, were you able to reserve or allocate all the names you needed to?

3c-1. If you used an ALP, QLP, or LRP (or combination), did you experience any unanticipated trouble with integrating the Sunrise Period into your launch?

3c-2. Specifically, were you able to allocate all of the names you needed to allocate under those programs before the Sunrise Period?

⁵ **Approved Launch Program (ALP):** Registry Operator MAY, prior to the start date of its Sunrise Period, apply to ICANN for approval to conduct a registration program not otherwise permitted by these TMCH Requirements. Such a registration program application could, for example, provide for authorization to implement programs set forth in Registry Operator's application for the TLD, which, if set forth in reasonable detail in the application for the TLD, will carry a presumption of being approved, unless ICANN reasonably determines that such requested registration program could contribute to consumer confusion or the infringement of intellectual property rights. To learn more, see Section 4.5.2 of the [Trademark Clearinghouse Rights Protection Mechanism Requirements](#).

⁶ **Qualified Launch Program (QLP):** Registry Operator MAY, through an ICANN-accredited registrar, Allocate or register one hundred (100) domain names (plus their IDN variants, where applicable) to third parties prior to or during the Sunrise Period for the purpose of promoting the TLD. Registry Operator MUST NOT Allocate or register such one hundred (100) domain names (plus their IDN variants, where applicable) to third parties prior to the Allocation and registration of all Sunrise Registrations. To learn more, see [Qualified Launch Program Addendum](#).

⁷ **Limited Registration Period (LRP):** In the New gTLD Program, any registration period in which a Registry Operator (RO) imposes registration restrictions beyond the restrictions imposed by the gTLD's general registration policy is called a Limited Registration Period (LRP). ROs can offer an LRP between the end of the Sunrise Period and the start of general registration. If an RO offers an LRP, all registrations during the LRP must be subject to the Claims Service in the same manner as registrations registered or allocated during the Trademark Claims Period.

⁸ **Section 3.2 of Registry Agreement Specification 5:** Registry Operator may activate in the DNS at All Levels up to one hundred (100) names (plus their IDN variants, where applicable) necessary for the operation or the promotion of the TLD. To learn more, see [Registry Agreement \(page 73\)](#).

3d-1. For each issue you have identified in your responses to questions #3a-c, please also include a suggested mitigation path. What do you suggest the RPM Working Group consider to help alleviate the pain points and make those programs more useful and functional, while still respecting the trademark protection goals of the Sunrise Period?

3d-2. How important is it to make changes to these programs before another round of new gTLDs (that is, are these issues worth “holding up” another round for, or are the work-arounds tolerable)?

The Working Group also recommends that public comment be sought on question #3e from non-Registry Operators:

3e. Did you experience struggles with the way ALP, QLP, or LRPs (or a combination) integrated with Sunrise, either as registrar, as a brand owner, or as a domain name registrant?

Sunrise Question #4

The Working Group recommends that the following guidance be sought from Registry Operators. These questions are related to Sunrise Question #3.

4a-1. If you had/have a business model that was in some way restrained by the 100-name pre Sunrise limit for names registries can reserve under Section 3.2 of Registry Agreement Specification 5, or the practical problems with the ALP, please share your experience and suggested path to improvement. What was your work-around, if any?

4a-2. For instance, if you withheld names from registration (“reserved” names), how well did that work?

4b-1. If the Working Group were to identify specialized gTLDs as a key concern that required changes to the way the Sunrise Period operates, are there other TLDs, besides GeoTLDs that did or will encounter the same problem?

4b-2. What suggestions do you have for work-arounds or solutions that will not diminish the protections available from the Sunrise Period (balanced with the need to finish this work in a timely manner)?

4c-1. Did you initially intend (prior to the implementation of Sunrise rules in the original Applicant Guidebook) to offer a special Sunrise before the regular Sunrise that targeted local trademark owners?

4c-2. For instance, would the ability to offer a special “pre-Sunrise” Sunrise solve any problems?

4c-3. If so, would you have validated the marks in some way?

4c-4. How would you have resolved conflicts between trademark holders that got their domains during the first Sunrise and trademark holders who had an identical trademark in the TMCH that was registered prior to Sunrise?

Sunrise Question #5

The Working Group recommends that public comment be sought from trademark holders who use non-English scripts/languages on the following questions:

5a. Did you encounter any problems when you attempted to participate in Sunrise using non-English scripts/languages?

5b. If so, please describe problems you have encountered.

5c. Do you have suggestions on how to enable trademark holders who use non-English scripts/languages to effectively participate in Sunrise?

2.5 Trademark Claims Service Preliminary Recommendations and Community Questions

Note: Since Trademark Claims preliminary recommendations and community questions are related, they are placed side by side for easy reference.

Preliminary Recommendation	Question Seeking Community Input
<p>Trademark Claims Recommendation #1 The Working Group recommends that the language of the Trademark Claims Notice be revised, in accordance with the Implementation Guidance outlined below. This recommendation aims to help enhance the intended effect of the Trademark Claims Notice by improving the understanding of recipients, while decreasing any unintended effects of deterring good-faith domain name applications.</p> <p>The Working Group recommends that the Trademark Claims Notice be revised to reflect more specific information about the trademark(s) for which it is being issued, and to more effectively communicate the meaning and implications of the Claims Notice (e.g., outlining possible legal consequences or describing what actions potential registrants may be able to take, following receipt of a notice).</p>	<p>Trademark Claims Question #1 1a-1. Have you identified any inadequacies or shortcomings of the Claims Notice? 1a-2. If so, what are they? 1b. Do you have suggestions on how to improve the Claims Notice in order to address the inadequacies or shortcomings?</p>

<p>To assist the Implementation Review Team (IRT) that will be formed to implement recommendations from this PDP in redrafting the Claims Notice, the Working Group has developed the following Implementation Guidance:</p> <ul style="list-style-type: none"> • The Claims Notice must be clearly comprehensible to a layperson unfamiliar with trademark law; • The current version of the Claims Notice should be revised to maintain brevity, improve user-friendliness, and provide additional relevant information or links to multilingual external resources that can aid prospective registrants in understanding the Claims Notice and its implications; • The Working Group advises that ICANN org considers input from external resources. Some Working Group members suggested external resources including the American University Intellectual Property Clinic, INTA Internet Committee, Electronic Frontier Foundation, and Clinica Defensa Nombres de Dominio UCN. 	
<p>Trademark Claims Recommendation #2</p> <p>The Working Group recommends that delivery of the Trademark Claims Notice be both in English as well as the language of the registration agreement. In this regard, the Working Group recommends:</p> <ul style="list-style-type: none"> • Changing the relevant language in the current Trademark Clearinghouse Rights Protection Mechanism Requirements⁹ on this topic (Section 3.3.1.2) to “...registrars MUST provide the Claims Notice in English and in the language of the registration agreement.” • The Claims Notice should include a link to a webpage on the ICANN org 	

⁹ <http://newgtlds.icann.org/en/about/trademark-clearinghouse/rpm-requirements-30sep13-en.pdf>

<p>website containing translations of the Claims Notice in all six UN languages.</p>	
<p>Trademark Claims Recommendation #3 The Working Group recommends that the current requirement for only sending the Claims Notice before a registration is completed be maintained.</p> <p>The Working Group also recognizes that there may be operational issues with presenting the Claims Notice to registrants who pre-registered domain names, due to the current 48-hour expiration period of the Claims Notice.</p> <p>The Working Group therefore recommends that the Implementation Review Team consider ways in which ICANN org can work with registrars to address this implementation issue.</p>	
<p>Trademark Claims Recommendation #4 The Working Group recommends, in general, that the current requirement for a mandatory Claims Period be maintained, including the minimum initial 90-day period when a TLD opens for general registration.</p>	<p>Trademark Claims Question #2</p> <p>2a. Is there a use case for exempting a gTLD that is approved in subsequent expansion rounds from the requirement of a mandatory Claims Period due to the particular nature of that gTLD? Such type of gTLD might include: (i) “highly regulated” TLDs that have stringent requirements for registering entities, on the order of .bank; and/or (ii) “Dot Brand” TLDs whose proposed registration model demonstrates that the use of a Trademark Claims Service is unnecessary.</p> <p>2b. If the Working Group recommends exemption language, what are the appropriate guardrails ICANN should use when granting the exception (e.g. Single-registrant? Highly-regulated or manually hand-registered domains¹⁰? Something else?)?</p>
<p>Trademark Claims Recommendation #5 The Working Group recommends that the current requirement for a mandatory Claims Period should continue to be uniform for all types of gTLDs in subsequent rounds, including for the minimum initial 90-day period when a TLD opens for general registration.</p>	

¹⁰ Manually hand-registered domains literally refer to the domains registered manually at a registrar by hand. In other words, it is the practice of registering a new domain name without the use of automated robots or automated computer systems that search for and register domain names; those domain names are purchased new and not on an after-market system. In the context of Trademark Claims Question #2, it refers to the domain name that is registered manually following the specific registry policy.

<p>Trademark Claims Recommendation #6 In the absence of wide support for a change to the status quo, the Working Group recommends that the current exact matching criteria for the Claims Notice be maintained.</p>	
--	--

2.6 Trademark Claims Service Preliminary Recommendation

Preliminary Recommendation
<p>TM-PDDRP Recommendation #1 The Working Group recommends that Rule 3(g) of the Trademark Post-Delegation Dispute Resolution Procedure (TM-PDDRP) Rules be modified, to provide expressly that multiple disputes filed by unrelated entities against a Registry Operator¹¹ may be initially submitted as a joint Complaint, or may, at the discretion of the Panel, be consolidated upon request.</p> <p>This recommendation is intended to clarify the fact that the TM-PDDRP permits the joint filing of a Complaint and the consolidation of Complaints by several trademark owners, even if these are unrelated entities, against a Registry Operator in the case where: (a) that Registry Operator has engaged in conduct that has affected the Complainants’ rights in a similar fashion; and (b) it will be equitable and procedurally efficient to permit the consolidation.</p> <p>To the extent that a TM-PDDRP Provider’s current Supplemental Rules¹² may not permit the filing of a joint Complaint or the consolidation of several Complaints, the Working Group further recommends that those Providers amend their Supplemental Rules accordingly.</p> <p>For the avoidance of doubt, the Working Group notes that:</p> <ol style="list-style-type: none"> 1. The filing of a joint Complaint or consolidation is to be permitted only where: (i) the Complaints relate to the same conduct by the Registry Operator, at the top or the second level of the same gTLD for all Complaints; and (ii) all the trademark owners have satisfied the Threshold Review criteria specified in Article 9 of the TM-PDDRP¹³; and 2. This recommendation is intended to apply to two distinct situations: one where several trademark owners join together to file a single Complaint, and the other where several

¹¹ Including those under common control, see definition at **TM-PDDRP Article 6**: “For purposes of these standards, “registry operator” shall include entities directly or indirectly controlling, controlled by or under common control with a registry operator, whether by ownership or control of voting securities, by contract or otherwise where ‘control’ means the possession, directly or indirectly, of the power to direct or cause the direction of the management and policies of an entity, whether by ownership or control of voting securities, by contract or otherwise.” More details of the TM-PDDRP can be found here: <http://newgtlds.icann.org/en/applicants/agb/pddrp-04jun12-en.pdf>

¹² The Supplemental Rules of the three TM-PDDRP Providers can be found here - ADNDRC: https://www.adndrc.org/mten/img/pdf/Supplemental_Rules_TMPDDRP_10-03-2014.pdf; FORUM: <https://www.adrforum.com/assets/resources/gTLD/Supplemental%20Rules-PDDRP.pdf>; and World Intellectual Property Organization (WIPO): <https://www.wipo.int/export/sites/www/amc/en/docs/supplrulestmpddrp.pdf>

¹³ See the Threshold Review criteria in Article 9 of TM-PDDRP on pp.5-6 here: <http://newgtlds.icann.org/en/applicants/agb/pddrp-04jun12-en.pdf>

trademark owners each file a separate Complaint but request that these be consolidated into a single Complaint after filing.

3 Deliberations of the Working Group

3.1 Introduction

This section covers only the Working Group deliberations on preliminary recommendation and community questions, for which the Working Group reached preliminary agreement and on which it is seeking public comment.

With the Working Group's focus on putting out specific recommendations and questions for community input, this section is intended to serve as helpful context to illustrate or summarize the Working Group's deliberations by providing brief, relevant, and accompanying rationale to the recommendation(s). It should not be read as a comprehensive record of the Working Group's deliberations; more details of which are contained in the featured documents in the "Annex C - Working Group Documents" section of this Initial Report.

This section does not include the Working Group's deliberations on proposals submitted by individual Working Group members that did not rise to the level of becoming Working Group preliminary recommendations. Please see the "Individual Proposals (Non-Recommendations)" section of this Initial Report for additional details.

3.2 Deliberations of Uniform Rapid Suspension (URS)

3.2.1 URS Preliminary Recommendations

URS Recommendation #1

The Working Group recommends that URS Rule 3(b), and, where necessary, a URS Provider's Supplemental Rules be amended to clarify that a Complainant must only be required to insert the publicly-available WHOIS/Registration Data Directory Service (RDDS) data for the domain name(s) at issue in its initial Complaint.

Furthermore, the Working Group recommends that URS Procedure para 3.3 be amended to allow the Complainant to update the Complaint within 2-3 calendar days after the URS Provider provides updated registration data related to the disputed domain name(s).

Note: This recommendation is related to URS Question #1.

Context:

This recommendation specifically concerns the following URS Rules¹⁴ and URS Procedure¹⁵:

¹⁴ URS Rules can be downloaded here: <https://newgtlds.icann.org/en/applicants/urs/rules-28jun13-en.pdf>

¹⁵ URS Procedure can be downloaded here: <https://newgtlds.icann.org/en/applicants/urs/procedure-01mar13-en.pdf>

- **URS Rule 3(b)(iii):** Provide the name of the Respondent and all other relevant contact information from the Whois record as well as all information known to Complainant regarding how to contact Respondent or any representative of Respondent, including contact information based on pre-complaint dealings, in sufficient detail to allow the Provider to notify the Respondent of the complaint as described in Rule 2(a);
- **URS Procedure para 3.3:** Given the rapid nature of this Procedure, and the intended low level of required fees, there will be no opportunity to correct inadequacies in the filing requirements.

Since the implementation of European Union’s General Data Protection Regulation (GDPR), personally identifiable information, including the contact details of the registrants, is masked in the public WHOIS/RDDS data. URS Providers receive the contact information and other relevant WHOIS/RDDS data of the registrants from Registries or Registrars.

In May 2018, the ICANN Board approved a Temporary Specification as an interim measure to bring existing WHOIS obligations in line with requirements of GDPR¹⁶. In relation to the URS, Section 5.6 of the Temporary Specification obligates ICANN’s Contracted Parties to comply with Appendix D of the Temporary Specification (and, relatedly, Appendix E for the UDRP).

Appendix D states that a Registry Operator “MUST provide the URS provider with the full Registration Data for each of the specified domain names, upon the URS Provider notifying the Registry Operator (or appointed BERO¹⁷) of the existence of a Complaint, or participate in another mechanism to provide the full Registration Data to the Provider as specified by ICANN. If the gTLD operates as a ‘thin’ Registry, the Registry Operator MUST provide the available Registration Data to the URS Provider [and if] the domain name(s) subject to the Complaint reside on a ‘thin’ registry, the Registrar MUST provide the full Registration Data to the URS Provider upon notification of a Complaint”. In addition, “Complainant’s Complaint will not be deemed defective for failure to provide the name of the Respondent (Registered Name Holder) and all other relevant contact information required by Section 3 of the URS Rules if such contact information of the Respondent is not available in registration data publicly available in RDDS or not otherwise known to Complainant. In such an event, Complainant may file a ‘Doe’ Complaint and the Examiner shall provide the relevant contact details of the Registered Name Holder after being presented with a ‘Doe’ Complaint.”

The EPDP Phase 1 recommendations that were approved by the GNSO Council and adopted by the ICANN Board in 2019 included the Recommendation #21¹⁸ that suggested that the RPM

¹⁶ See <https://www.icann.org/en/system/files/files/gtld-registration-data-temp-spec-17may18-en.pdf>. Following the Board’s adoption of most of the EPDP’s Phase 1 recommendations, an Interim Registration Data Consensus Policy was implemented that requires gTLD Registry Operators and ICANN-accredited Registrars to continue to implement measures that are consistent with the Temporary Specification on an interim basis, pending the full implementation of the final Registration Data Policy (see <https://www.icann.org/resources/pages/interim-registration-data-policy-en>.)

¹⁷ **BERO:** Back-end Registry Operator

¹⁸ **EPDP Recommendation #21:** Requests the GNSO Council to instruct the RPMs PDP Working Group to consider whether to update existing requirements to clarify that a complainant must only be required to insert the publicly-available RDDS data for the domain name(s) at issue in its initial complaint, and whether the complainant may be given the opportunity to file an amended complaint upon receiving updated RDDS data. Please see the full text of this recommendation in the “Background” section of this Initial Report.

review consider the topic that is the subject of this URS Recommendation #1. The EPDP work also included Recommendation #23¹⁹ and Recommendation #27²⁰ that suggested updates be made to existing procedures and rules impacted by the GDPR. The Working Group believes that its recommendation is consistent with the EPDP Phase 1 Recommendations #21, #23, and #27.

During the Working Group's deliberations, MFSD (a URS Provider) suggested amending the URS Procedure para 3.3 in order to enable the Complainant to modify the Complaint within 2-3 days from the disclosure of the full registration data by the URS Provider. FORUM (another URS Provider) also supported the suggestion of manually amending the Complaint after submission.

MFSD commented that without access to the registration data before submission of the Complaint due to GDPR, and without the possibility to amend the Complaint after submission, it may be difficult for the Complainant to satisfy the second and third URS elements²¹. The utilization of URS may decrease because the Complainant may file a UDRP Complaint instead, which can be amended after submission.

Therefore, the Working Group recommends amending the URS Rule 3(b)(iii) and URS Procedure para 3.3 as a result of GDPR implementation.

URS Recommendation #2

The Working Group recommends that URS Providers send notices to the Respondent by the required methods after the Registry or Registrar has forwarded the relevant WHOIS/RDDS data (including contact details of the Registered Name Holder) to the URS Providers.

Context:

Before GDPR implementation, URS Providers typically referenced the contact details of the registrants in the WHOIS/RDDS data in order to communicate with and transmit notices to the registrant. Providers also obtained contact information of the registrant via the Complainant and registrant's website.

Since the implementation of GDPR, personally identifiable information is masked in the public WHOIS/RDDS data. URS Providers rely on the Registries and Registrars to forward contact information and other relevant WHOIS/RDDS data of the registrant before they can send the registrant notices.

¹⁹ **EPDP Recommendation #23:** Defines requirements for URS/UDRP to ensure the procedures continue to function given other EPDP recommendations. Please see the full text of this recommendation in the "Background" section of this Initial Report.

²⁰ **EPDP Recommendation #27:** Recommends that updates be made to existing policies to ensure consistency with the EPDP recommendations. Please see the full text of this recommendation in the "Background" section of this Initial Report.

²¹ The URS requires a trademark owner, or the "Complainant," to show all three of the following elements: (i) The disputed domain name is identical or confusingly similar to a word mark that meets certain criteria; (ii) the registrant of the domain name, or the "respondent," has no legitimate right or interest to the domain name; and (iii) the domain name was registered and is being used in bad faith.

Therefore, the Working Group proposed this recommendation as a result of GDPR implementation. This recommendation is also consistent with the EPDP Phase 1 Recommendations #23 and #27 (see footnote of URS Recommendation #1).

URS Recommendation #3

The Working Group recommends that URS Providers must comply with URS Procedure para 4.2 and para 4.3 and transmit the Notice of Complaint to the Respondent, with translation in the predominant language of the Respondent, via email, fax, and postal mail.

Context:

This recommendation specifically concerns the following URS Procedure:

- **URS Procedure para 4.2:** Within 24 hours after receiving Notice of Lock from the Registry Operator, the URS Provider shall notify the registrant of the Complaint (“Notice of Complaint”), sending a hard copy of the Notice of Complaint to the addresses listed in the Whois contact information, and providing an electronic copy of the Complaint, advising of the locked status, as well as the potential effects if the registrant fails to respond and defend against the Complaint. Notices must be clear and understandable to registrants located globally. The Notice of Complaint shall be in English and translated by the Provider into the predominant language used in the registrant’s country or territory.
- **URS Procedure para 4.3:** The Notice of Complaint to the registrant shall be sent through email, fax (where available) and postal mail. The Complaint and accompanying exhibits, if any, shall be served electronically.

The Working Group discovered non-compliance issues with ADNDRC (a URS Provider), which did not: 1) translate the Notice of Complaint into the predominant language used in the registrant’s country or territory per URS Procedure para 4.2; and 2) transmit the Notice of Complaint via fax and postal mail per URS Procedure para 4.3.

Nevertheless, the Working Group also noted that URS Providers are unable to use courier services to deliver mail to P.O. box addresses. FORUM and MFSD reported that their mail, fax, and email to the Respondent were not delivered sometimes.

URS Recommendation #4

The Working Group recommends that the ICANN org establishes a compliance mechanism to ensure that URS Providers, Registries, and Registrars operate in accordance with the URS rules and requirements and fulfill their role and obligations in the URS process.

The Working Group recommends that such compliance mechanism should include an avenue for any party in the URS process to file complaints and seek resolution of noncompliance issues.

As an implementation guidance, the Working Group recommends that the Implementation Review Team considers:

- Investigating different options for a potential compliance mechanism, such as ICANN Compliance, other relevant department(s) in ICANN org, a URS commissioner at ICANN org, a URS standing committee, etc.
- Developing metrics for measuring performance of URS Providers, Registries, and Registrars in the URS process.

Note: This recommendation is related to URS Question #2.

Context:

The Working Group discovered non-compliance issues with URS Providers, Registries, and Registrars.

There are cases where certain URS Provider did not: 1) translate the Notice of Complaint into the predominant language used in the registrant's country or territory per URS Procedure para 4.2²² and URS Rules 9(e)²³; 2) transmit the Notice of Complaint via fax and postal mail per URS Procedure para 4.3²⁴; and 3) list and maintain the backgrounds of all of their examiners as required by URS Rule 6(a)²⁵.

Some Registries delayed in fulfilling or did not fulfill their obligations relating to locking, unlocking, and suspension of disputed domains; some URS Provider reported their non-compliance to ICANN.

URS Providers and Practitioners reported difficulty in getting the Registrar on the same page with the Registry to implement a settlement²⁶, which typically involves a transfer of the domain registration at the Registrar level. Problems with Chinese Registrar to implement the Determination have also been reported.

The Working Group agreed that the ICANN org should proactively or reactively monitor the practices of URS Providers, Registries, and Registrars in the URS process, and establish a compliance mechanism for any stakeholder in the URS process to raise complaints. The Working Group is unsure which specific mechanism would be appropriate, so it recommends the future

²² **URS Procedure para 4.2:** Within 24 hours after receiving Notice of Lock from the Registry Operator, the URS Provider shall notify the Registrant of the Complaint ("Notice of Complaint"), sending a hard copy of the Notice of Complaint to the addresses listed in the Whois contact information, and providing an electronic copy of the Complaint, advising of the locked status, as well as the potential effects if the Registrant fails to respond and defend against the Complaint. Notices must be clear and understandable to Registrants located globally. The Notice of Complaint shall be in English and translated by the Provider into the predominant language used in the Registrant's country or territory.

²³ **URS Rule 9(e):** The URS Procedure Paragraph 4.2 specifies the languages in which the Notice of Complaint shall be transmitted...The Provider is not responsible for translating any documents other than the Notice of Complaint.

²⁴ **URS Procedure para 3.3:** Given the rapid nature of this Procedure, and the intended low level of required fees, there will be no opportunity to correct inadequacies in the filing requirements.

²⁵ **URS Rule 6(a):** Each Provider shall maintain and publish a publicly available list of Examiners and their qualifications.

²⁶ URS Rules 16(a) stipulates that if, before the Examiner's Determination, the Parties agree on a settlement, the Examiner shall terminate the URS proceeding

IRT to investigate different options, including the existing mechanism in the ICANN org (e.g., ICANN Compliance department).

The Working Group also seeks public comment on additional compliance issues, as well as suggestions for enhancing compliance in the URS process (see URS Question #2 below).

URS Recommendation #5

The Working Group recommends that the ICANN org, Registries, Registrars, and URS Providers keep each other's contact details up to date in order to effectively fulfill the notice requirements set forth in the URS Procedure para 4.

Note: This recommendation is related to URS Question #3.

Context:

URS Providers' feedback indicates there may be some clerical issues concerning the Registry Operators, including:

- Communicating from email addresses different from the contacts present in ICANN's repository;
- Not responsive to requests for information from URS Providers;
- Delay in sending notifications to the URS Providers regarding the completion of URS actions;
- Not completing URS actions despite notifications and reminders from the Providers, resulting in a need for the Providers to report non-compliance to ICANN;
- Due to GDPR, Registries are inconsistent with respect to how they would like to either receive verification requests or how the Provider should receive the verification from them (e.g., dropbox, zip file with password, web based access); the inconsistency adds a significant amount of time to case handling; a small number of Registries do not respond within the required 24 hours for verification requests.

To understand the full picture of the clerical issues reported by the Providers, the Working Group seeks public comment from Registry Operators regarding their experience of receiving notices from URS Providers (see URS Question #3).

URS Recommendation #6

The Working Group recommends that a uniform set of educational materials be developed to provide guidance for URS parties, practitioners, and examiners on what is needed to meet the "clear and convincing" burden of proof in a URS proceeding.

As an implementation guidance, the Working Group recommends that the educational materials be developed in the form of an administrative checklist, basic template, and/or FAQ. Specifically, the Working Group recommends that the educational materials be developed with help from URS Providers, Practitioners, Panelists, as well as researchers/academics who study URS decisions closely.

Note: This recommendation is related to URS Question #4.

Context:

About half of the Practitioners who responded to the Working Group survey agreed that there should be “more guidance provided to educate or instruct practitioners on what is needed to meet the ‘clear and convincing’ burden of proof in a URS proceeding” in light of the different laws around the world.

The Working Group noted that two of the three URS Providers did not strongly support the issuance of an Examiners Guide, at least, to the extent that the guidance is to provide direction or examples as to the distinction between clear-cut and more difficult cases.

Therefore, the Working Group recommends that the uniform set of guidance, or “educational material”, should not extend to providing Examiners with specific directions as to what is, and is not, a clear-cut case. It may be preferable to develop the educational material that is more in the nature of an administrative checklist, basic template, and/or FAQ, rather than a substantive document such as WIPO’s UDRP Overview²⁷.

In addition, the Working Group recommends the educational materials be developed via the collaboration of experienced parties in handling URS proceedings (i.e., Providers, Practitioners, Panelists) and researchers/academics who study URS decisions closely.

The Working Group seeks public comment on additional implementation guidance for the development of such educational materials (see URS Question #4 below).

URS Recommendation #7

The Working Group recommends that all URS Providers require their examiners to document their rationale in sufficient detail to explain how the decision was reached in all issued Determinations.

As an implementation guidance, the Working Group also recommends that URS Providers provide their examiners a uniform set of basic guidance for documenting their rationale for a Determination. The purpose of the guidance is to ensure consistency and precision in terminology and format as well as ensure that all steps in a proceeding are recorded. Such guidance may take the form of an administrative checklist or template of minimum elements that need to be included for a Determination.

Context:

URS Providers vary in terms of the amount of guidance they provide their Examiners with respect to issuing Determinations. They also vary in the use of a template Determination form. The Working Group reviewed data from over 900 URS cases and found that there are some inconsistencies across Examiners as to whether or not rationale or justifications are provided

²⁷ <https://www.wipo.int/amc/en/domains/search/overview3.0/>

(and in what detail) for their findings in the issued Determination. The Working Group's case review also indicated that a sufficient number of Determinations cited either inadequate or no rationale for the decisions, such that the WG recommends that URS Providers require their examiners to document their rationale in sufficient detail to explain how the decision was reached in all issued Determinations.

Nevertheless, some Working Group members cautioned against micromanaging and imposing burdensome guidance on panelists, who have limited time and compensation in handling URS cases.

URS Recommendation #8

The Working Group recommends that the Implementation Review Team considers reviewing the implementation issues with respect to the Registry Requirement 10 in the "URS High Level Technical Requirements for Registries and Registrars" and amend the Registry Requirement 10, if needed. The Providers Sub Team discovered issues with respect to implementing the outcomes of a URS proceeding (e.g. relief awarded following a URS decision, or where the parties settle²⁸ the case prior to Determination, or where a Complainant requests to extend a suspension).

Note: This recommendation is related URS Question #5.

Context:

This recommendation specifically concerns the following URS Technical Requirement²⁹:

- **Registry Requirement 10:** In cases where a URS Complainant (as defined in the URS Rules) has prevailed, Registry Operator MUST offer the option for the URS Complainant to extend a URS Suspended domain name's registration for an additional year (if allowed by the maximum registration policies of the TLD), provided, however, that the URS Suspended domain name MUST remain registered to the registrant who was the registrant at the time of URS Suspension. Registry Operator MAY collect the Registrar renewal fee if the URS Complainant elects to renew the URS Suspended domain name with the sponsoring Registrar.

One-third of URS Practitioners who responded to the Working Group survey indicated problems with implementing the relief awarded following a URS decision. URS Providers also reported that some Registries and Registrars had difficulty implementing the extension request of the URS Suspension, as they might not understand their roles in the process. Therefore, the Working Group recommends the future IRT to review the implementation issues regarding Registry Requirement 10, and consider whether enhanced education is needed to help Registries and Registrars understand how to implement relief and gain better awareness of URS process.

²⁸ URS Rules 16(a) stipulates that if, before the Examiner's Determination, the Parties agree on a settlement, the Examiner shall terminate the URS proceeding.

²⁹ URS Technical Requirements for Registries and Registrars can be downloaded here: <https://newgtlds.icann.org/en/applicants/urs/tech-requirements-17oct13-en.pdf>

In addition, some FORUM Examiners supported the possibility of altering registration information during the additional year of suspension that is available to a successful Complainant. One Working Group member also raised the question whether the prevailing Complainant could elect to transfer the suspended domain name to a different Registrar, which is accredited by the same Registry, for one additional year. Thus, the Working Group seeks public comment on whether Registry Requirement 10 should be amended (see URS Question #5 below).

URS Recommendation #9

The Working Group recommends that as implementation guidance, the Implementation Review Team considers developing guidance to assist the URS providers in deciding what language to use during a URS proceeding and when issuing a Determination. Such guidance should take into account the fact that domains subject to a URS Complaint may have been registered via a privacy or proxy service and the location of the service will determine the language of that service, which may be relevant.

Context:

FORUM and MFSD communicate with the Respondent in the language of the Respondent. Such practice includes assigning an Examiner who speaks the same language as the Respondent and also providing translations of notices, emails, templates, and Determinations.

FORUM researches what the predominant language is in Respondent's physical location based on the registration information provided by the Registry. FORUM also confirms the language based on the language used in the Respondent's response (if no response, the default option is to use English in the URS proceeding).

However, when the domain subject to a URS Complaint has been registered via a privacy or proxy service, FORUM has difficulty in determining the language to be used unless that information is relayed to them. The language in the location of the privacy or proxy service may be different from the language of the Respondent. Furthermore, if the Respondent resides in a region that has multiple predominant languages, research is needed to determine which language should be used. Hence, the Working Group recommends the future IRT develops guidance to assist URS Providers in deciding the language to communicate with the Respondent.

The Working Group also notes that ADNDRC communicates with Respondents only in English and is non-compliant with URS Procedure para 4.2 and URS Rules 9(e) (see URS Recommendation #4). Although most of its Examiners speak additional languages other than English, language skills do not seem to be a factor in its assignment and rotation of the Examiners. ADNDRC reported that it has not encountered a situation where the Respondent did not understand English.

URS Recommendation #10

The Working Group recommends that clear, concise, easy-to-understand informational materials should be developed, translated into multiple languages, and published on the URS Providers' websites to assist Complainants and Respondents in URS proceedings. Such information materials should include, but not be limited to: 1) a uniform set of basic FAQs, 2) links to Complaint, Response, and Appeal forms, and 3) reference materials that explain URS Providers' services and practices.

Note: This recommendation is related to URS Question #6.

Context:

URS Providers vary in terms of the amount of guidance and instructions they provide to Complainants and Respondents in the various stages of URS proceedings.

FORUM provides a PowerPoint Demo with step-by-step instructions. MFSD references specific URS Rules, URS Procedure, and Supplemental Rules in detail. ADNDRC seems to only provide the Complaint, Response, and Appeal forms. The Notice of Complaint from FORUM and MFSD includes instruction to the Respondent about the steps and what to expect in the URS proceedings. FORUM's case coordinator also assists Respondents on an individual basis via phone or email.

FORUM is aware that some Respondents did not file a Response as they did not know how to proceed, regardless of the materials provided by FORUM. FORUM reported that it has received some Respondent complaints regarding its online filing portal.

Therefore, this recommendation seeks to assist future URS Parties in URS proceedings. However, the Working Group is unclear whether the uniform set of basic FAQs should be developed by the ICANN org, the three URS Providers jointly, or some other entity. The Working Group seeks public comment on this resource-related implementation question (see URS Question #6 below).

3.2.2 URS Questions Seeking Community Input

URS Question #1

1a. Should URS Rule 15(a) be amended to clarify that, where a Complaint has been updated with registration data provided to the Complainant by the URS Provider, there must be an option for the Determination to be published without the updated registration data?

1b. If so, when, by whom, and how should this option be triggered?

1c. Are there any operational considerations that will need to also be addressed in triggering this option?

Note: This question is related to URS Recommendation #1.

Context:

This question specifically concerns the following URS Rule:

- **URS Rule 15(a):** The Provider shall publish the Determinations and the dates of implementation on a publicly accessible web site, subject to the considerations in Rule 15 (c) and (d) below. See URS Procedure Paragraphs 9.2 and 9.4. The portion of any Determination that a Complaint was brought in bad faith (see Rule 17) shall be published³⁰.

Currently, it is not possible to file an amended Complaint under the URS. The Working Group's URS Recommendation #1, if approved, will change the status quo and permit the filing of an amended Complaint following a Complainant's receipt of updated registration data from a URS Provider. This will mean that, without further amending the URS (specifically, URS Rule 15(a)), the previously-redacted registration data will be published along with the Determination of the Complaint. In this regard, the Working Group notes that its review of data from over 900 URS cases found that a large majority of cases resulted in Default³¹ Determinations, meaning that no Response to a Complaint was filed by a Respondent.

The Working Group is seeking community input as to whether it will be appropriate to also recommend that URS Rule 15 be amended in order to allow for redaction of registration data upon publication of a Determination, and if so in what circumstances. In agreeing to put out this question for public comments, the Working Group noted Phase 1 recommendations from the EPDP Team on the Temporary Specification for gTLD Registration Data that are relevant to the RPMs. Specifically, the GNSO Council referred and requested the Working Group consider EPDP Phase 1 Recommendations #21, #23, and #27³².

The Working Group will also welcome community input, particularly from the EPDP Team, more generally as to whether its preliminary recommendations concerning the URS are compliant with applicable law (including the GDPR and other applicable privacy laws) and consistent with the EPDP Team's intentions and Phase 1 recommendations.

URS Question #2

2a. What compliance issues have Registries and Registrars discovered in URS processes, if any?

³⁰ See the complete text of URS Rule 15 here: <http://newgtlds.icann.org/en/applicants/urs/rules-28jun13-en.pdf>

³¹ Where, at the expiration of the 14-day Response period (or extended period if granted), the Respondent does not submit an answer, the Complaint proceeds to Default status. All Default cases nevertheless proceed to Examination for review on the merits of the claim. See URS Rules 11 & 12: <https://newgtlds.icann.org/en/applicants/urs/rules-28jun13-en.pdf>

³² **EPDP Recommendation #21:** Requests the GNSO Council to instruct the RPMs PDP Working Group to consider whether to update existing requirements to clarify that a complainant must only be required to insert the publicly-available RDDS data for the domain name(s) at issue in its initial complaint, and whether the complainant may be given the opportunity to file an amended complaint upon receiving updated RDDS data. Please see the full text of this recommendation in the "Background" section of this Initial Report.

EPDP Recommendation #23: Defines requirements for URS/UDRP to ensure the procedures continue to function given other EPDP recommendations. Please see the full text of this recommendation in the "Background" section of this Initial Report.

EPDP Recommendation #27: Recommends that updates be made to existing policies to ensure consistency with the EPDP recommendations. Please see the full text of this recommendation in the "Background" section of this Initial Report.

2b. Do you have suggestions for how to enhance compliance of URS Providers, Registries, and Registrars in the URS process?

Note: This question is related to URS Recommendation #4.

Context:

See context of URS Recommendation #4, which is the same for this question.

URS Question #3

The Working Group recommends that public comment be sought from Registry Operators on the following question:

- 3a.** Have Registry Operators experienced any issues with respect to receiving notices from URS Providers?
- 3b.** Were these notices sent through appropriate channels?
- 3c.** Did the notices contain the correct information?

Note: This question is related to URS Recommendation #5.

Context:

See context of URS Recommendation #5, which is the same for this question.

URS Question #4

- 4a.** What content and format should these educational materials have?
- 4b.** How should these educational materials be developed?
- 4c.** Who should bear the cost for developing these educational materials?
- 4d.** Should translations be provided?

Note: This question is related to URS Recommendation #6. The “educational materials” refer to a uniform set of educational materials developed to provide guidance for URS parties, practitioners, and examiners on what is needed to meet the “clear and convincing” burden of proof in a URS proceeding.

Context:

See context of URS Recommendation #6, which is the same for this question.

URS Question #5

Should the Registry Requirement 10 be amended to include the possibility for another Registrar, which is different from the sponsoring Registrar but accredited by the same Registry, to be elected by the URS Complainant to renew the URS Suspended domain name, and to collect the Registrar renewal fee?

Note: This question is related to URS Recommendation #8.

Context:

This question specifically concerns the following URS Technical Requirement:

- **Registry Requirement 10:** In cases where a URS Complainant (as defined in the URS Rules) has prevailed, Registry Operator MUST offer the option for the URS Complainant to extend a URS Suspended domain name's registration for an additional year (if allowed by the maximum registration policies of the TLD), provided, however, that the URS Suspended domain name MUST remain registered to the registrant who was the registrant at the time of URS Suspension. Registry Operator MAY collect the Registrar renewal fee if the URS Complainant elects to renew the URS Suspended domain name with the sponsoring Registrar.

One Working Group member raised the question whether the prevailing Complainant could elect to transfer the suspended domain name to a different Registrar, which is accredited by the same Registry, for one additional year. This workaround may counter some operational challenges -- for example, the original sponsoring Registrar may not accept payment in the currency of the country where the prevailing Complainant resides. However, some other Working Group members questioned the feasibility of implementation. As the suspended domain name must remain registered to the Respondent, the Respondent may not agree with the transfer due to geo-political reasons or governmental regulations, for example.

Thus, the Working Group seeks public comment on whether Registry Requirement 10 should be amended to include such possibility of transferring the suspended domain name to a Registrar of the prevailing Complainant's choice.

URS Question #6

Who has the responsibility for developing the uniform set of basic FAQs for URS Complainants and Respondents?

Note: This question is related to URS Recommendation #10. The FAQs is part of the clear, concise, easy-to-understand informational materials to assist Complainants and Respondents in URS proceedings.

Context:

See context of URS Recommendation #10, which is the same for this question.

URS Question #7

What mechanism do you suggest that allows a URS Provider to efficiently check with other URS and UDRP Providers in order to ensure that a disputed domain name is not already subject to an open and active URS/UDRP proceeding?

Context:

This question stems from the URS Rule 3(g), which states: “A URS Complaint may not be filed against a domain name that is part of an open and active URS or UDRP case.”

FORUM already checks whether there is any duplicative filing of URS proceedings. Most of FORUM’s Complainants are also well informed and abide by the rules. Among the URS cases handled by FORUM, FORUM reported that no disputed domain name was already subject to an open and active URS/UDRP proceeding. ADNDRC at least checks whether the same Complaint has already been filed with another ADNDRC office.

URS Question #8

The Working Group recommends that public comment be sought from Registry Operators on the following questions:

8a. What issues have you encountered with respect to implementing the HSTS-preloaded domain suspension remedy, if any?

8b. What would need to be done to help resolve the issues you have encountered?

Context:

HSTS preloading is a function built into the browser whereby a global list of hosts enforce the use of HTTPS ONLY on their site. This removes the opportunity an attacker has to intercept and tamper with redirects over HTTP.

Suspending the HSTS-preloaded domain name has been problematic. FORUM reported that the suspension of HSTS-preloaded domain name requires it to obtain SSL certificates. Despite the fact that there are free SSL certificates available, FORUM will incur additional expenses to monitor and renew the certificates manually. The process will be further complicated if the Registry does not communicate regarding the status of the suspension. FORUM has been working with ICANN org to resolve this issue.

To better understand the issue, the Working Group seeks public comment from Registry Operators, which carry out the URS obligation of suspending disputed domain names, including the HSTS-preloaded domain names.

URS Question #9

Are the non-refundable, late Response fees paid by Respondent reasonable?

FORUM has a flat fee for late response. ADNDRC and MFSD have fees based on the number of domains and/or the type of Respondents involved. FORUM has never collected these fees for late response.

- FORUM:
 - Re-examination Fee (more than 30 days late): 200 USD
 - Re-examination Extension Fee: 100 USD
- ADNDRC:
 - 1 to 5 domain names: 180 USD
 - 6 to 14 domain names: 200 USD

- 15 to 29 domain names: 225 USD
- 30 domain names or more: To be determined by the Relevant Office of ADNDRC
- MFSD:
 - Paid by the Respondent who is natural person/sole proprietorship/public body/non-profit entity
 - 1-15 domain names: 175 EUR
 - 16-50 domain names: 200 EUR
 - 50 domain names or more: To be decided with MFSD
 - Paid by the Respondent who is partnership/corporation/public company/private limited/limited liability company
 - 1-15 domain names: 190 Euros
 - 16-50 domain names: 225 Euros
 - 50 domain names or more: To be decided with MFSD

Context:

The three URS Providers did not receive feedback on whether their fee structure has been a deterrence to the filing of Complaints or Responses. FORUM has not encountered a situation where the late Response fees need to be collected.

The Working Group seeks public comment to understand whether the late Response fees create a burden or deterrence for the Respondent.

URS Question #10

10a. Are penalties for Complainant or Respondent who abuses the URS process sufficient?

10b. If not, should they be expanded?

10c. If they should be expanded, how?

Per Section 11.4 and 11.5 of the URS Procedure, the penalties for abusive complaints are:

- 11.4 In the event a party is deemed to have filed two (2) abusive Complaints, or one (1) “deliberate material falsehood,” that party shall be barred from utilizing the URS for one-year following the date of issuance of a Determination finding a complainant to have: (i) filed its second abusive complaint; or (ii) filed a deliberate material falsehood.
- 11.5 Two findings of “deliberate material falsehood” shall permanently bar the Complainant from utilizing the URS.

Context:

All three URS Providers reported that there have been no abusive Complaint findings made in any URS Determination, and the Working Group did not find any instance of the penalty for abusive conduct being levied. Only FORUM has handled cases where the Respondent alleged an Abuse of Process by the Complainant, but no abuse was found by the Examiner. The URS Procedure has established penalties for abusive Complainants, but no penalties for abusive Respondents. The Working Group seeks public comment on the adequacy of penalties for abuses in the URS process.

3.3 Deliberations of Trademark Clearinghouse (TMCH) Structure and Scope

3.3.1 TMCH Preliminary Recommendation

TMCH Recommendation #1

The Working Group considered the following aspects of the TMCH³³:

1. Whether the “TM +50” rule should be changed or maintained;
2. Whether the current “exact match” rules should be changed or maintained; and
3. Whether, where a trademark contains dictionary term(s), the Sunrise and Trademark Claims RPMs should be limited in their scope such as to be applicable only in those gTLDs that relate to the categories of goods and services for which the dictionary term(s) within that trademark are protected.

The Working Group’s preliminary recommendation for these three questions is that the status quo (i.e. the current rules as applied to the gTLDs delegated under the 2012 New gTLD Program round) should be maintained.

The Working Group’s review of the public comments on these topics may lead to Working Group consensus to amend its preliminary recommendation in respect of one or more of these topics, in which case the Working Group’s Final Report will be updated accordingly with specific, numbered recommendations.

Context:

To determine whether there was sufficient support within the Working Group to change the status quo for each of these three topics, the Working Group agreed that the applicable standard should be whether there was “wide support” for any proposed changes.

1. “TM +50”³⁴

The current rule allows trademark owners to submit up to 50 “previously abused domain name labels” (i.e. domain names previously held to have been registered and used in bad faith either in a UDRP or court proceeding) into the TMCH in connection with an existing TMCH-recorded mark (i.e. “TM+50”). The Working Group reviewed data from Deloitte (the TMCH Validation Service Provider) demonstrating the extent that trademark owners had used this rule to submit such abused labels. In the absence of wide support for a change to the status quo, the Working Group recommends that the TM +50 rule be retained as is.

2. “Exact Match”

³³ For additional details about the TMCH, please see Trademark Clearinghouse in Module 5 of the gTLD Applicant Guidebook: <https://newgtlds.icann.org/en/applicants/agb/trademark-clearinghouse-04jun12-en.pdf>

³⁴ See Section 3 of the TMCH Guidelines for a description of the “TM+50” service and how labels are to be submitted and validated: https://www.trademark-clearinghouse.com/sites/default/files/files/downloads/TMCH_guidelines_v1.2_0.pdf

The Working Group’s recommendation on this point is related to Trademark Claims Recommendation #6: “In the absence of wide support for a change to the status quo, the Working Group recommends that the current exact matching criteria for the Claims Notice be maintained.”

The Working Group had diverging opinions as to whether the current exact match requirement is serving its intended purposes, and whether there is evidence of harm under the existing requirement. The Working Group debated these questions extensively during its deliberations over the Trademark Claims service, which operates off the data in the TMCH. The Working Group note in this Google Doc³⁵ provides details of these discussions.

Ultimately, the Working Group believes that the exact match criteria has already struck the proper balance of deterring bad-faith registrations but not good-faith domain name applications. As a result, the Working Group agreed on Trademark Claims Recommendations #6 and the TMCH Recommendation #1, which complement each other.

3. “Limiting the Sunrise & Claims RPMs to certain gTLDs for trademarks containing dictionary term(s)”

The Working Group had diverging opinions on this matter, which concerned the availability of Sunrise and Trademark Claim services for trademarks that contain dictionary term(s). In the absence of wide support for a change to the status quo, the Working Group agreed that the scope of the Sunrise and Trademark Claims RPMs should not be modified to limit their application to gTLDs that are related to the categories of goods and services for which the dictionary term(s) within those trademarks are protected.

3.4 Deliberations of Sunrise Service

3.4.1 Sunrise Preliminary Recommendation

Sunrise Recommendation #1

In the absence of wide support for a change to the status quo, the Working Group recommends that the current availability of Sunrise registrations only for identical matches should be maintained, and the matching process should not be expanded.

Context:

The Working Group had diverging opinions on this matter.

The Working Group members who supported the expansion of the matching criteria believed that the current exact match system is limiting. Other Working Group members opposed the expansion due to concerns including, but not limited to: 1) costs associated with the expansion, 2) potential deterrence to good-faith registration, 3) limited current usage of “expanded match” via abused labels, and 4) existing issues related to TMCH’s acceptance of non-standard character

³⁵ https://docs.google.com/document/d/10quBC1BnuIM_wOyEXH7TttNWEOrDTiPNscgSBd7QFXg/edit?usp=sharing

claim marks and common/dictionary words, and the broad scope of registration within the TMCH.

The Working Group ultimately concluded that the availability of Sunrise registrations only for identical matches should be maintained.

Sunrise Recommendation #2

The Working Group recommends that the Registry Agreement for future new gTLDs includes a provision stating that a Registry Operator shall not operate its TLD in such a way as to have the effect of circumventing the mandatory RPMs imposed by ICANN or restricting brand owners' reasonable use of the Sunrise rights protection mechanism.

Context:

The Working Group generally agreed that some Registry Sunrise or Premium Name³⁶ pricing practices have limited the ability of some trademark owners to participate during Sunrise. The Working Group is aware of cases where the Registry Operator practices may have unfairly limited the ability of some trademark owners to participate during Sunrise, when pricing set for the trademark owners was significantly higher than other Sunrise pricing or General Availability pricing. The Working Group noted that this problem seems sufficiently extensive that it requires a recommendation to address it. Hence the Sunrise Recommendation #2 has been put forth for public comment.

Nevertheless, the Working Group also had diverging opinions on whether registry pricing is within the scope of the PRM PDP Working Group. While some Working Group members expressed concerns about the interplay of Registry pricing with RPMs obligations, some Working Group members pointed to the Registry Agreements that state that registry pricing is not within the scope of the RPM Working Group due to the picket fence³⁷. Specifically, Section 1.4.1 of Specification 1 of the Registry Agreement and Section 1.4.1 of the Consensus Policies and

³⁶ **Premium Name:** second level domain names that are offered for registration that, in the determination of the registry, are more desirable for the purchaser. **Premium Pricing:** second level domain names that are offered for registration, that in the determination of the registry are more desirable for the purchaser, and will command a price that is higher than a non-premium name.

³⁷ **Picket Fence:** In its original agreements with ICANN, registries and registrars agreed to comply with "consensus" policies adopted by ICANN provided (i) that such policies did not unreasonably restrain competition and (ii) that the policies related to: 1) issues for which uniform or coordinated resolution is reasonably necessary to facilitate interoperability, technical reliability and/or stable operation of the Internet or domain-name system; 2) registry policies reasonably necessary to implement Consensus Policies relating to registrars; and 3) resolution of disputes regarding the registration of domain names (as opposed to the use of such domain names), and do not unreasonably restrain competition. ICANN's policy making mission, as described previously, creates a "picket fence" around ICANN's authority -- ICANN can only mandate registry and registrar compliance with policies affecting issues inside the "picket fence"; ICANN could establish policy and/or best practices affecting issues outside the picket fence, but could not mandate registry and registrar compliance with such policies. Learn more:

<https://gns0.icann.org/sites/default/files/file/field-file-attach/picket-fence-overview-23jan19-en.pdf>

Temporary Policies Specification of the Registrar Accreditation Agreement³⁸ respectively specify that Consensus Policies shall not prescribe or limit the price of Registry Services and Registrar Services.

Sunrise Recommendation #3

In the absence of wide support for a change to the status quo, the Working Group does not recommend the creation of a challenge mechanism.

Context:

The Working Group had diverging opinions on whether Registry Operators should be required to create a mechanism that allows trademark owners to challenge the determination that a second level name is a Premium Name or Reserved Name. The Working Group noted that Premium Names and Reserved Names are very different, and Premium Names are not clearly defined due to the multiple pricing tiers set by Registry Operators.

Some Working Group members supported the idea that ICANN org establish a uniform challenge mechanism and proposed a list of implementation guidance. Additionally, some Working Group members believed that the ICANN org should require Registry Operators to create a release mechanism in the event that a Premium Name or Reserved Name is challenged successfully.

Some Working Group members opposed establishing such challenge mechanism and listed some possible concerns, including but not limited to: 1) restricting Registry/Registrar's name lists and pricing; 2) impact on Registry Operators' ability to operate their platforms; 3) increase workload for Registry Operators and Registrars to handle challenges; 4) unpredictable consequences such as the violation of applicable law/ICANN policies and security/stability concerns; and 5) gaming by trademark owners.

To address those concerns, some Working Group members attempted to modify some elements of the proposed challenge mechanism, introduce a less formal challenge mechanism, or leverage existing mechanisms. However, there was no wide support for a challenge mechanism in any shape or form.

Sunrise Recommendation #4

In the absence of wide support for a change to the status quo, the Working Group does not recommend the publication of the Reserved Names lists by Registry Operators.

³⁸ Section 1.4.1 of Specification 1 of the Registry Agreement and Section 1.4.1 of the Consensus Policies and Temporary Policies Specification of the Registrar Accreditation Agreement state the following: "In addition to the other limitations on Consensus Policies, they shall not prescribe or limit the price of Registrar Services". See page 43 of the Base Registry Agreement (updated 31 July 2017): <https://newgtlds.icann.org/sites/default/files/agreements/agreement-approved-31jul17-en.pdf> and page 57 of the 2013 Registrar Accreditation Agreement: <https://www.icann.org/en/system/files/files/approved-with-specs-27jun13-en.pdf>.

Context:

The Working Group had diverging opinions on whether Registry Operators should be required to publish their Reserved Names lists.

Some Working Group members noted several possible registry concerns if Registry Operators were required to publish their Reserved Names lists, including but not limited to: 1) potential legal violations and security risks; 2) revelation of the confidential business plans of the Registry Operators; and 3) practical problems related to the publication.

Other Working Group members discussed possible problems that the publication of the Reserved Names lists could solve, particularly for trademark owners and registrants.

Sunrise Recommendation #5

The Working Group recommends that the current requirement for the Sunrise Period be maintained, including for 30-day minimum period for a Start Date Sunrise and the 60-day minimum period for an End Date Sunrise.

Context:

The Working Group noted two types of Sunrise Periods, which both require a total of 60 days at a minimum³⁹:

1. Start Date Sunrise: The Registry must give 30-days notice before commencing the Sunrise. Once the Sunrise starts, it must run for 30 days at a minimum.
2. End Date Sunrise: The Registry can announce the Sunrise as late as the day the Sunrise starts, but must run the Sunrise period for 60 days at a minimum.

The Working Group focused on reviewing the Start Date Sunrise, and noted that most Registry Operators have run the End Date Sunrise.

The Working Group generally agreed that the current 30-day minimum after the Start Date Sunrise Period starts appears to be serving its intended purpose. Some Working Group members believe that there are unintended results, such as complications when many TLDs are launched simultaneously for the Start Date Sunrise for 30 days. To address this unintended consequence, one Working Group member proposed to increase the notification period, but the proposal did not receive wide support for inclusion in the Initial Report for public comment.

The Working Group had diverging opinions on whether there are benefits observed when the Start Date Sunrise Period is extended beyond 30 days after the Period starts; some Working Group members believe that there are disadvantages when it is extended beyond 30 days. Nevertheless, the Working Group generally agreed that the existing ability of Registry Operators to expand their Sunrise Periods does not create uniformity concerns that should be addressed by this PDP.

³⁹ See reference here: https://icannwiki.org/Sunrise_Period

Sunrise Recommendation #6

In the absence of wide support for a change to the status quo, the Working Group recommends that the mandatory Sunrise Period should be maintained.

Context:

The Working Group had diverging opinions on whether the Sunrise Period should continue being mandatory or should become optional.

Trademark and brand owners supported that Sunrise Period should continue being mandatory. The Working Group also noted that there were 64,000+ Sunrise registrations across 484 gTLDs as of August 2017.

Some Registry Operators indicated desire to choose between Sunrise and Trademark Claims services. The Working Group also noted that blocking services such as DPML and DPML Plus may be an alternative to the Sunrise Period, although not every Registry Operator offers blocking mechanisms.

Some Working Group members had concerns about the continuation of the mandatory Sunrise Period. Their concerns stemmed from the suspicion that trademark owners may have the potential to abuse Sunrise due to TMCH's acceptance of non-standard character claim marks and common/dictionary words, as well as the broad scope of registration within the TMCH. However, there is a lack of concrete evidence to substantiate the suspicion.

Sunrise Recommendation #7

The Working Group recommends that the next version of the Applicant Guidebook (AGB) for future new gTLDs be amended as follows:

1. The new version of the AGB should include the TMCH dispute resolution procedure for challenging the validity of trademark records entered into the TMCH. This procedure is currently published at: <https://www.trademark-clearinghouse.com/dispute#3.3>. ICANN org should ensure that its contract for the provision of TMCH services makes the operation of the TMCH dispute resolution procedure a requirement for the TMCH Validation Service Provider.
2. Section 6.2.4 of the current Trademark Clearinghouse Model of Module 5 of the AGB must be amended to remove grounds (i) and (iii).
3. The Trademark Clearinghouse Model of Module 5 of the AGB must be amended to include a new Section 6.2.6 – “The Registry Operator will, upon receipt from the TMCH of a finding that a Sunrise registration was based upon an invalid TMCH record (pursuant to a TMCH dispute resolution procedure), immediately delete the domain name registration. Registry Operators in their applicable SDRPs will describe the nature and purpose of the TMCH challenge process and provide a link to the TMCH for reference.”

Note: Registry Operators should continue to have the option to offer a broader SDRP to include optional/additional Sunrise criteria as desired.

Context:

The Sunrise Dispute Resolution Policy (SDRP)⁴⁰ is a mechanism that a Registry Operator must provide to resolve disputes regarding its registration of Sunrise Registrations. According to the Section 6.2.2 and 6.2.4 of the Trademark Clearinghouse Model of Module 5⁴¹ of the Applicant Guidebook (AGB), the SDRP allows challenges to Sunrise Registrations related to Registry Operator's allocation and registration policies on four non-exhaustive grounds, including on the grounds that the registered domain name does not identically match the Trademark Record on which the Sunrise-Eligible Rights Holder based its Sunrise Registration.

The Working Group had difficulty determining whether SDRPs are serving the purpose(s) for which they were created, as each TLD has its own SDRP and there is hardly any analysis of the SDRP decisions across all new gTLDs.

However, the Working Group noted that the TMCH dispute procedure was created in the time between when the AGB was written and the TMCH requirements were established. As a result, two of AGB requirements for Registry operating the SDRPs are moot, specifically grounds (i) and (iii) of Section 6.2.4 of the current Trademark Clearinghouse Model of Module 5:

- (i) at time the challenged domain name was registered, the registrant did not hold a trademark registration of national effect (or regional effect) or the trademark had not been court-validated or protected by statute or treaty;
- (iii) the trademark registration on which the registrant based its Sunrise registration is not of national effect (or regional effect) or the trademark had not been court-validated or protected by statute or treaty.

The current procedure allows challenges to the recordal of marks in the TMCH that underlie Sunrise registrations. In any event, the Registry Operator is not the best-placed party to adjudicate these challenges due to the fact that the Registry Operator is reliant on trademark eligibility information provided by the TMCH.

Therefore, this recommendation seeks to eliminate the non-functional parts of the current SDRP requirements and codify the current practice in the next version of the AGB for future new gTLDs.

In addition, some Working Group members believe that the limited access to the TMCH and the lack of trademark information to identify whether a complaint is well-grounded makes it difficult

⁴⁰ Section 6.2.2 of the Trademark Clearinghouse Model of Module 5 of the Applicant Guidebook states the following: "Sunrise Registration Process. For a Sunrise service, sunrise eligibility requirements (SERs) will be met as a minimum requirement, verified by Clearinghouse data, and incorporate a Sunrise Dispute Resolution Policy (SDRP)." Section 6.2.4 states the following: "The proposed SDRP must allow challenges based on at least the following four grounds: (i) at time the challenged domain name was registered, the registrant did not hold a trademark registration of national effect (or regional effect) or the trademark had not been court-validated or protected by statute or treaty; (ii) the domain name is not identical to the mark on which the registrant based its Sunrise registration; (iii) the trademark registration on which the registrant based its Sunrise registration is not of national effect (or regional effect) or the trademark had not been court-validated or protected by statute or treaty; or (iv) the trademark registration on which the domain name registrant based its Sunrise registration did not issue on or before the effective date of the Registry Agreement and was not applied for on or before ICANN announced the applications received." See pages 296-297 here: <https://newgtlds.icann.org/en/applicants/agb/guidebook-full-04jun12-en.pdf>

⁴¹ <https://newgtlds.icann.org/en/applicants/agb/trademark-clearinghouse-04jun12-en.pdf>

to challenge a registration via the SDRP. The Working Group deliberated on some additional proposals that sought to address the access to the TMCH, SDRP decisions, and domain names registered during the Sunrise Period. None of these proposals received wide support for inclusion in the Initial Report for public comment.

Sunrise Recommendation #8

In the absence of wide support for a change to the status quo, the Working Group does not recommend that the scope of Sunrise Registrations be limited to the categories of goods and services for which the trademark is actually registered and put in the Clearinghouse.

Context:

The Working Group had diverging opinions on whether the scope of the Sunrise Registration should be limited to the categories of goods and services for which the trademark is actually registered and put in the TMCH.

Some Working Group members supported limiting the scope of Sunrise Registrations for reasons such as the potential gaming opportunities during the Sunrise Period due to TMCH's acceptance of non-standard character claim marks and common/dictionary words, as well as the broad scope of registration within the TMCH.

Some Working Group members opposed limiting the scope of Sunrise Registrations for reasons including, but not limited to: 1) the uncertainty regarding the scope and extent of abuses of the Sunrise Period; 2) the potential issues/problems if such limited scope were to be implemented; and 3) Registry Operators' existing capability to limit the scope of Sunrise Registrations.

3.4.2 Sunrise Questions Seeking Community Input

Sunrise Question #1

What remedy(ies) would you propose for any unintended effects of the Sunrise Period that you have identified in your public comment?

Context:

The Working Group generally agreed that the Sunrise Period is having unintended effects, but is uncertain about the scope and extent of the unintended effects.

Some of the unintended effects noted by Working Group members include, but are not limited to: 1) issues and expenses related to operating the Sunrise Period; 2) issues related to reserved names, parked domain names, and specific new gTLDs including .sucks and .love; and 3) potential "chilling effect" on legitimate registrants caused by TMCH's acceptance of common/dictionary words and broad scope of registration within the TMCH.

Sunrise Question #2

- 2a.** Have you identified abuses of the Sunrise Period?
- 2b.** To the extent that you have identified abuses of the Sunrise Period, if any, please describe them and specify any documentation to substantiate the identified abuses.

Context:

The Working Group is uncertain about the scope and extent of abuses of the Sunrise Period.

Some Working Group members noted abuses such as discriminatory pricing and unfair business practices related to Registry Operators, as well as anecdotal evidence of trademark owners using questionable means to gain priority for the Sunrise Period.

Some Working Group members suspected that trademark owners may have the potential to abuse Sunrise due to TMCH's acceptance of non-standard character claim marks and common/dictionary words, as well as the broad scope of registration within the TMCH. However, there is a lack of concrete evidence to substantiate the suspicion.

Sunrise Question #3

The Working Group recommends that public comment be sought on questions #3a-d from Registry Operators. The Working Group asks Registry Operators to be specific about which program(s) (i.e., ALP⁴², QLP⁴³, and/or LRP⁴⁴) they are referring in their responses to all questions and what the shortcomings of each of those mechanisms are. These questions are related to Sunrise Question #4.

3a-1. If you did not attempt an ALP, QLP, or LRP, was the reason for not taking advantage of those programs related to how they integrate with Sunrise?

3a-2. Were you able to achieve your goals in a different way (such as by combining any or all of these programs)?

⁴² **Approved Launch Program (ALP):** Registry Operator MAY, prior to the start date of its Sunrise Period, apply to ICANN for approval to conduct a registration program not otherwise permitted by these TMCH Requirements. Such a registration program application could, for example, provide for authorization to implement programs set forth in Registry Operator's application for the TLD, which, if set forth in reasonable detail in the application for the TLD, will carry a presumption of being approved, unless ICANN reasonably determines that such requested registration program could contribute to consumer confusion or the infringement of intellectual property rights. To learn more, see Section 4.5.2 of the [Trademark Clearinghouse Rights Protection Mechanism Requirements](#).

⁴³ **Qualified Launch Program (QLP):** Registry Operator MAY, through an ICANN-accredited registrar, Allocate or register one hundred (100) domain names (plus their IDN variants, where applicable) to third parties prior to or during the Sunrise Period for the purpose of promoting the TLD. Registry Operator MUST NOT Allocate or register such one hundred (100) domain names (plus their IDN variants, where applicable) to third parties prior to the Allocation and registration of all Sunrise Registrations. To learn more, see [Qualified Launch Program Addendum](#).

⁴⁴ **Limited Registration Period (LRP):** In the New gTLD Program, any registration period in which a Registry Operator (RO) imposes registration restrictions beyond the restrictions imposed by the gTLD's general registration policy is called a Limited Registration Period (LRP). ROs can offer an LRP between the end of the Sunrise Period and the start of general registration. If an RO offers an LRP, all registrations during the LRP must be subject to the Claims Service in the same manner as registrations registered or allocated during the Trademark Claims Period.

3b-1. If you did attempt an ALP, QLP, or LRP (or combination) but didn't successfully use any, was the reason you did not take advantage of those programs related to how they integrate with Sunrise?

3b-2. Were you able to achieve your goals in a different way? For instance, some Registry Operators may have used the QLP 100 (Section 3.2 of Registry Agreement Specification 5⁴⁵) (plus IDN variants) in combination with registry-reserved names to obtain the names they needed. Did you do this?

3b-3. If so, were you able to reserve or allocate all the names you needed to?

3c-1. If you used an ALP, QLP, or LRP (or combination), did you experience any unanticipated trouble with integrating the Sunrise Period into your launch?

3c-2. Specifically, were you able to allocate all of the names you needed to allocate under those programs before the Sunrise Period?

3d-1. For each issue you have identified in your responses to questions #3a-c, please also include a suggested mitigation path. What do you suggest the RPM Working Group consider to help alleviate the pain points and make those programs more useful and functional, while still respecting the trademark protection goals of the Sunrise Period?

3d-2. How important is it to make changes to these programs before another round of new gTLDs (that is, are these issues worth "holding up" another round for, or are the work-arounds tolerable)?

The Working Group also recommends that public comment be sought on question #3e from non-Registry Operators:

3e. Did you experience struggles with the way ALP, QLP, or LRPs (or a combination) integrated with Sunrise, either as registrar, as a brand owner, or as a domain name registrant?

Context:

The Working Group has received limited feedback that the rules for ALP and QLP do not integrate smoothly with the concept of Sunrise.

For instance, some GEO TLDs struggled to ensure that words needed for operation of their TLD (i.e. required by the governments that approved them) were all able to be allocated or reserved for later registration before Sunrise. These words may have been recorded in the TMCH, but needed to be reserved to the governments (one example is "police" which is both a word for local law enforcement and a brand).

⁴⁵ **Section 3.2 of Registry Agreement Specification 5:** Registry Operator may activate in the DNS at All Levels up to one hundred (100) names (plus their IDN variants, where applicable) necessary for the operation or the promotion of the TLD. To learn more, see [Registry Agreement \(page 73\)](#).

Notably, many Registry Operators did not use the ALP or QLP options and only a few used LRPs.

In order to evaluate the effectiveness of ALP, QLP, and LRP, as well as develop potential recommendations related to them, the Working Group seeks guidance especially from Registry Operators.

Sunrise Question #4

The Working Group recommends that the following guidance be sought from Registry Operators. These questions are related to Sunrise Question #3.

4a-1. If you had/have a business model that was in some way restrained by the 100-name pre Sunrise limit for names registries can reserve under Section 3.2 of Registry Agreement Specification 5, or the practical problems with the ALP, please share your experience and suggested path to improvement. What was your work-around, if any?

4a-2. For instance, if you withheld names from registration (“reserved” names), how well did that work?

4b-1. If the Working Group were to identify specialized gTLDs as a key concern that required changes to the way the Sunrise Period operates, are there other TLDs, besides GeoTLDs that did or will encounter the same problem?

4b-2. What suggestions do you have for work-arounds or solutions that will not diminish the protections available from the Sunrise Period (balanced with the need to finish this work in a timely manner)?

4c-1. Did you initially intend (prior to the implementation of Sunrise rules in the original Applicant Guidebook) to offer a special Sunrise before the regular Sunrise that targeted local trademark owners?

4c-2. For instance, would the ability to offer a special “pre-Sunrise” Sunrise solve any problems?

4c-3. If so, would you have validated the marks in some way?

4c-4. How would you have resolved conflicts between trademark holders that got their domains during the first Sunrise and trademark holders who had an identical trademark in the TMCH that was registered prior to Sunrise?

Context:

The Working Group has received information that the 2012 Applicant Guidebook (AGB) did not foresee that some TLDs (specifically GeoTLDs, but perhaps others) might need more than 100 domain names to allocate prior to the launch of the TLD and prior to Sunrise.

For GeoTLDs, one example is the potential need to register the websites of the city, county, office, and official, etc. in advance of Sunrise (e.g. the business of the TLD may make it critical that POLICE.[geo] is allocated to the police department, not to a brand).

The Working Group had limited information about the impact of this situation and did not know how many (and to what extent) Registry Operators were affected. For instance, if a Registry Operator withheld names from registration (“Reserved” names), how well did that work?

In order to understand whether Sunrise Registrations should have priority over other registrations under specialized gTLDs, and whether there should be a different rule for some Registry Operators (such as certain types of specialized gTLDs) based on their published registration/eligibility policies, the Working Group seeks guidance from Registry Operators.

Sunrise Question #5

The Working Group recommends that public comment be sought from trademark holders who use non-English scripts/languages on the following questions:

5a. Did you encounter any problems when you attempted to participate in Sunrise using non-English scripts/languages?

5b. If so, please describe problems you have encountered.

5c. Do you have suggestions on how to enable trademark holders who use non-English scripts/languages to effectively participate in Sunrise?

Context:

Some Working Group members believe that trademark holders who use non-English scripts/languages generally could not effectively participate in the Sunrise Period based on the limited information the Working Group collected and analyzed. The Working Group needs more information to better understand the experience of trademark holders who used non-English scripts/languages during the Sunrise Period.

3.5 Deliberations of Trademark Claims Service

3.5.1 Trademark Claims Preliminary Recommendation

Trademark Claims Recommendation #1

The Working Group recommends that the language of the Trademark Claims Notice be revised, in accordance with the Implementation Guidance outlined below. This recommendation aims to help enhance the intended effect of the Trademark Claims Notice by improving the understanding of recipients, while decreasing any unintended effects of deterring good-faith domain name applications.

The Working Group recommends that the Trademark Claims Notice be revised to reflect more specific information about the trademark(s) for which it is being issued, and to more effectively communicate the meaning and implications of the Claims Notice (e.g., outlining possible legal

consequences or describing what actions potential registrants may be able to take, following receipt of a notice).

To assist the Implementation Review Team (IRT) that will be formed to implement recommendations from this PDP in redrafting the Claims Notice, the Working Group has developed the following Implementation Guidance:

- The Claims Notice must be clearly comprehensible to a layperson unfamiliar with trademark law;
- The current version of the Claims Notice should be revised to maintain brevity, improve user-friendliness, and provide additional relevant information or links to multilingual external resources that can aid prospective registrants in understanding the Claims Notice and its implications;
- The Working Group advises that ICANN org considers input from external resources. Some Working Group members suggested external resources including the American University Intellectual Property Clinic, INTA Internet Committee, Electronic Frontier Foundation, and Clinica Defensa Nombres de Dominio UCN .

Note: This recommendation is related to Trademark Claims Question #1.

Context:

The Working Group could determine that the Trademark Claims service is at least “possibly” having its intended effect, and generally agreed that the service may possibly have unintended consequences, such as deterring good-faith domain name applications. However, the Working Group could not determine the extent of deterrence that occurred, if any.

The Working Group generally agreed that the Claims Notice generally meets its intended purpose of notifying prospective domain name registrants that the applied-for domain name matches at least one trademark in the Trademark Clearinghouse. However, the Working Group also recognized the shortcomings of the Claims Notice.

The Working Group generally agreed that for some of the actual and potential registrants, the Claims Notice is intimidating, hard to understand, or otherwise inadequate. Some Working Group members believe that the Claims Notice does not adequately inform domain name applicants of the scope and limitations of trademark holders’ rights (e.g., lack of identifying details of the trademark, issues with figurative/design marks).

Therefore, the Working Group proposed Trademark Claims Recommendation #1 to improve the Claims Notice, and also proposed Trademark Claims Question #1 (see below) to seek community input to address the inadequacy of the Claims Notice.

Trademark Claims Recommendation #2

The Working Group recommends that delivery of the Trademark Claims Notice be both in English as well as the language of the registration agreement. In this regard, the Working Group recommends:

- Changing the relevant language in the current Trademark Clearinghouse Rights Protection Mechanism Requirements⁴⁶ on this topic (Section 3.3.1.2) to “...registrars **MUST** provide the Claims Notice in English and in the language of the registration agreement.”
- The Claims Notice should include a link to a webpage on the ICANN org website containing translations of the Claims Notice in all six UN languages.

Context:

The Working Group generally agreed that the current Trademark Clearinghouse Rights Protection Mechanism Requirements on translations of the Claims Notice does not seem effective in informing domain name applicants of the scope and limitation of trademark holders’ rights.

The current requirement (Section 3.3.1.2) states: “The Claims Notice **MUST** be provided by the registrar to the potential domain name registrant in English and **SHOULD** be provided by the registrar to the potential domain name registrant in the language of the registration agreement” (bold for emphasis).

The Working Group noted that some Registrars do not translate the Claims into all of the languages that they use when conducting business with new gTLD registrants. As the Claims Notice has inadequacies and shortcomings in the English language in which it was initially drafted, it is implied that it would unlikely be more comprehensible among recipients who do not speak English or are not native speakers.

Trademark Claims Recommendation #3

The Working Group recommends that the current requirement for only sending the Claims Notice before a registration is completed be maintained.

The Working Group also recognizes that there may be operational issues with presenting the Claims Notice to registrants who pre-registered domain names, due to the current 48-hour expiration period of the Claims Notice.

The Working Group therefore recommends that the Implementation Review Team consider ways in which ICANN org can work with registrars to address this implementation issue.

Context:

The Working Group generally agreed that when there is a Claims Period and the issuance of a Claims Notice is required (see Trademark Claims Question #2 below), the Claims Notice should be sent to potential registrants, who are attempting to register domain names that are matches to entries in the TMCH, at some point before the domain name registration is completed.

⁴⁶ <http://newgtlds.icann.org/en/about/trademark-clearinghouse/rpm-requirements-30sep13-en.pdf>

The Working Group noted challenges reported by some Registrars regarding sending the Claims Notice for pre-order names, due to the current 48-hour expiration period of the Claims Notice. Therefore, the Working Group recommends the future IRT considering ways to address this issue.

Trademark Claims Recommendation #4

The Working Group recommends, in general, that the current requirement for a mandatory Claims Period be maintained, including the minimum initial 90-day period when a TLD opens for general registration.

Note: Some Working Group members asked for public comment on potential exemptions which would then not be subject to a Claims Period of any length, see Trademark Claims Question #2.

Context:

The Working Group generally agreed that where there is a Claims period (see Trademark Claims Question #2 below), it should be mandatory. The Working Group also generally agreed that the mandatory Claims period should be neither extended nor shortened. The Working Group noted that many trademark and brand owners are in favor of extending the Claims Period, while many other stakeholders (e.g., Registries, Registrars, and non-trademark owner registrants) are opposed to any extension and in favor of shortening the Claims Period. The Working Group ultimately came to an agreement of maintaining the status quo.

In addition, the Working Group generally agreed that Registries should have a certain degree of flexibility, based on a suitable business model, with the option to extend the Claims Period, provided this does not involve shortening the Claims Period. The Working Group noted that Registry Operators already operate their Claims Period in varying lengths beyond the minimum initial 90-day period.

Trademark Claims Recommendation #5

The Working Group recommends that the current requirement for a mandatory Claims Period should continue to be uniform for all types of gTLDs in subsequent rounds, including for the minimum initial 90-day period when a TLD opens for general registration.

Note: Some Working Group members asked for public comment on potential exemptions which would then not be subject to a Claims Period of any length, see Trademark Claims Question #2.

Context:

The Working Group generally agreed that where the Registry Operator has not obtained an exception (see Trademark Claims Question #1), the Trademark Claims period, including for the minimum initial 90-day period when a TLD opens for general registration, should continue to be uniform for all types of gTLDs in subsequent rounds.

In addition, the Working Group generally agreed that Registries should have a certain degree of flexibility, based on a suitable business model, with the option to extend the Claims Period. The Working Group noted that Registry Operators already operate the Claims Period in varying lengths beyond the minimum initial 90-day period.

Trademark Claims Recommendation #6

In the absence of wide support for a change to the status quo, the Working Group recommends that the current exact matching criteria for the Claims Notice be maintained.

Context:

The Working Group had diverging opinions on whether:

- The exact match requirement is serving the intended purposes of the Trademark Claims service;
- There is evidence of harm under the existing system of exact match;
- The matching criteria for the Claims Notice should be expanded.

The Working Group note in this Google Doc⁴⁷ provides details of these discussions.

The Working Group believes that the exact match criteria has already struck the proper balance of deterring bad-faith registrations but not good-faith domain name applications. The proper balance can be enhanced by a well-crafted Claims Notice that appropriately notifies prospective registrants about a potential problem with their chosen domain name, employs clear/concise/informative language, and avoids a potential overflow of false positives. Therefore, instead of proposing any changes to the matching criteria for the Claims Notice, the Working Group proposed Trademark Claims Recommendation #1 above.

3.5.2 Trademark Claims Questions Seeking Community Input

Trademark Claims Question #1

1a-1. Have you identified any inadequacies or shortcomings of the Claims Notice?

1a-2. If so, what are they?

1b. Do you have suggestions on how to improve the Claims Notice in order to address the inadequacies or shortcomings?

Note: This question is related to Trademark Claims Recommendations #1.

Context:

See context of Trademark Claims Recommendation #1, which is the same for this question.

⁴⁷ https://docs.google.com/document/d/10quBC1BnuIM_wOyEXH7TttNWEOrDTiPNscgSBd7QFXg/edit?usp=sharing

Trademark Claims Question #2

2a. Is there a use case for exempting a gTLD that is approved in subsequent expansion rounds from the requirement of a mandatory Claims Period due to the particular nature of that gTLD? Such type of gTLD might include: (i) “highly regulated” TLDs that have stringent requirements for registering entities, on the order of .bank; and/or (ii) “Dot Brand” TLDs whose proposed registration model demonstrates that the use of a Trademark Claims Service is unnecessary.

2b. If the Working Group recommends exemption language, what are the appropriate guardrails ICANN should use when granting the exception (e.g. Single-registrant? Highly-regulated or manually hand-registered domains⁴⁸? Something else?)?

Note: This question is related to Trademark Claims Recommendations #4 and #5.

Context:

Some Working Group members (not the entire Working Group) recommended that public comment be sought on this question. Some Working Group members believe that some future TLDs should be exempt from the mandatory Trademark Claims Period and suggested seeking public comment on whether there is a use case for exempting a TLD due to the particular nature of the TLD, as well as any concerns about exempting those TLDs.

3.6 Deliberations of Trademark Post Delegation Dispute Resolution Procedure (TM-PDDRP)

3.6.1 TM-PDDRP Preliminary Recommendation

TM-PDDRP Recommendation #1

The Working Group recommends that Rule 3(g) of the Trademark Post-Delegation Dispute Resolution Procedure (TM-PDDRP) Rules be modified, to provide expressly that multiple disputes filed by unrelated entities against a Registry Operator⁴⁹ may be initially submitted as a joint Complaint, or may, at the discretion of the Panel, be consolidated upon request.

This recommendation is intended to clarify the fact that the TM-PDDRP permits the joint filing of a Complaint and the consolidation of Complaints by several trademark owners, even if these

⁴⁸ Manually hand-registered domains literally refer to the domains registered manually at a registrar by hand. In other words, it is the practice of registering a new domain name without the use of automated robots or automated computer systems that search for and register domain names; those domain names are purchased new and not on an after-market system. In the context of Trademark Claims Question #2, it refers to the domain name that is registered manually following the specific registry policy.

⁴⁹ Including those under common control, see definition at **TM-PDDRP Article 6**: “For purposes of these standards, “registry operator” shall include entities directly or indirectly controlling, controlled by or under common control with a registry operator, whether by ownership or control of voting securities, by contract or otherwise where ‘control’ means the possession, directly or indirectly, of the power to direct or cause the direction of the management and policies of an entity, whether by ownership or control of voting securities, by contract or otherwise.” More details of the TM-PDDRP can be found here: <http://newgtlds.icann.org/en/applicants/agb/pddrp-04jun12-en.pdf>

are unrelated entities, against a Registry Operator in the case where: (a) that Registry Operator has engaged in conduct that has affected the Complainants' rights in a similar fashion; and (b) it will be equitable and procedurally efficient to permit the consolidation.

To the extent that a TM-PDDRP Provider's current Supplemental Rules⁵⁰ may not permit the filing of a joint Complaint or the consolidation of several Complaints, the Working Group further recommends that those Providers amend their Supplemental Rules accordingly.

For the avoidance of doubt, the Working Group notes that:

1. The filing of a joint Complaint or consolidation is to be permitted only where: (i) the Complaints relate to the same conduct by the Registry Operator, at the top or the second level of the same gTLD for all Complaints; and (ii) all the trademark owners have satisfied the Threshold Review criteria specified in Article 9 of the TM-PDDRP⁵¹; and
2. This recommendation is intended to apply to two distinct situations: one where several trademark owners join together to file a single Complaint, and the other where several trademark owners each file a separate Complaint but request that these be consolidated into a single Complaint after filing.

Context:

This recommendation specifically concerns a proposed amendment to the TM-PDDRP Rule 3(g), and a reference to Article 9 of the TM-PDDRP:

- **TM-PDDRP Rule 3(g):** If a PDDRP Complaint is filed against a Registry Operator against whom another PDDRP is active, the parties to both disputes may agree to consolidate. See the Provider's Supplemental Rules regarding consolidation.
- **TM-PDDRP Article 9.1:** Provider shall establish a Threshold Review Panel, consisting of one panelist selected by the Provider, for each proceeding within five (5) business days after completion of Administrative Review and the Complaint has been deemed compliant with procedural rules.⁵²

The TM-PDDRP was designed to allow a trademark owner to file a complaint against a Registry Operator over certain forms of behavior claiming that one or more of its marks have been infringed, and thereby the Complainant has been harmed, by the Registry Operator's manner of operation or use of the gTLD.

At the top level of the gTLD, the requisite conduct by the Registry Operator must cause or materially contribute to either 1) taking unfair advantage of the distinctive character or the reputation of the Complainant's mark, 2) impairing the distinctive character or the reputation of the Complainant's mark, or 3) creating a likelihood of confusion with the Complainant's mark.

⁵⁰ The Supplemental Rules of the three TM-PDDRP Providers can be found here - ADNDRC: https://www.adndrc.org/mten/img/pdf/Supplemental_Rules_TMPDDRP_10-03-2014.pdf; FORUM: <https://www.adrforum.com/assets/resources/gTLD/Supplemental%20Rules-PDDRP.pdf>; and World Intellectual Property Organization (WIPO): <https://www.wipo.int/export/sites/www/amc/en/docs/supplrulestmpddrp.pdf>

⁵¹ See the Threshold Review criteria in Article 9 of TM-PDDRP on pp.5-6 here: <http://newgtlds.icann.org/en/applicants/agb/pddrp-04jun12-en.pdf>

⁵² Please see the complete text of Article 9 of TM-PDDRP on pp.5-6 here: <http://newgtlds.icann.org/en/applicants/agb/pddrp-04jun12-en.pdf>

At the second level of the gTLD, the affirmative conduct by the Registry Operator must constitute a substantial pattern or practice of specific bad faith intent by the Registry Operator to profit from: (i) the sale of trademark infringing domain names; and (ii) the systematic registration of domain names in that gTLD that either 1) takes unfair advantage of the distinctive character or the reputation of the Complainant's mark, 2) impairs the distinctive character or the reputation of the Complainant's mark, or 3) creates a likelihood of confusion with the Complainant's mark.

Rule 3(g) of the TM-PDDRP Rules specifically allows for the consolidation of Complaints where, during an ongoing TM-PDDRP proceeding, a second Complaint is filed against the same Registry Operator. The Working Group's recommendation⁵³, if approved, will clarify that joint Complaints filed in one single Complaint at first instance, or multiple Complaints by several trademark owners against the same Registry Operator are permitted to be consolidated, even when the Complainants are unrelated entities. However, the Complaints to be submitted jointly/consolidated must relate to conduct by that Registry Operator that affects all the Complainants similarly, and at the same level (i.e. top or second) of the gTLD, and must all have successfully passed the Threshold Review required under the procedure.

At the time the Working Group reviewed TM-PDDRP, and at the time of publication of this Initial Report, no Complaints had been brought under the procedure. Although the Working Group discussed a number of possible reasons why the procedure had not been used, as well as possible modifications to the criteria (e.g. whether a standard of willful blindness could be justified based on any observable conduct), it concluded that there was no evidence to clearly demonstrate a single or primary reason. It also concluded that, at this stage, there was insufficient agreement to make substantive changes to the TM-PDDRP.

⁵³ WIPO, one of the dispute resolution providers that administer the TM-PDDRP, submitted a possible mark-up of the Rules that can be used as a starting point for the Implementation Review Team that will be convened if this recommendation is approved. See details here:

<http://www.wipo.int/export/sites/www/amc/en/docs/icann130309.pdf>

4 Individual Proposals (Non-Recommendations)

4.1 Introduction

The Working Group agreed to put forward the following proposals submitted by individual Working Group members for public comment. These individual proposals are specifically pertaining to the Uniform Rapid Suspension (URS) and Trademark Clearinghouse (TMCH) structure and operations. They did not rise to the level of becoming Working Group preliminary recommendations, which can be found in the “Overview of Preliminary Recommendations and Questions Seeking Community Input” section.

Following the Working Group’s review of all public comments received on these individual proposals, the Working Group will consider whether or not to make final consensus recommendations on any of these individual proposals in its Final Report to the GNSO Council.

The Working Group is seeking public comments on both the concept underlying each of the individual proposals as well as their details (e.g. commentators can agree with a general concept while suggesting specific changes to the details). Commentators are also asked to consider whether there are modifications/enhancements that can be made to render the proposals widely acceptable and/or reconcile proposals advocating opposite ideas.

For each proposal, the “context” includes:

- the rationale provided by the proponent;
- a high-level summary to illustrate the Working Group’s deliberations;
- specific areas that the Working Group seeks community input on, if any.

Note that the rationale provided by the proponent did not receive support or endorsement by the full Working Group. In some cases, some Working Group members had concerns about the accuracy and validity of some proponents’ rationale.

Links to the full text of each individual proposal and details of the Working Group’s deliberations are included in the “Annex C - Working Group Documents” section of this Initial Report.

4.2 Individual Proposals for Uniform Rapid Suspension System (URS)

From September 2018 to October 2018, Working Group members submitted thirty-six (36) proposals for policy recommendations and operational fixes pertaining to the Uniform Rapid Suspension (URS) dispute resolution mechanism. These URS individual proposals were submitted in addition to the URS recommendations and questions for community input, which were originally proposed by the Working Group’s three URS-related sub teams and

subsequently endorsed by the full Working Group (see the “Deliberations of URS” section of this Initial Report for details).

By the end of the ICANN63 Barcelona Meeting in October 2018, the Working Group completed the initial review of all URS individual proposals, but remained uncertain whether and how to publish these individual URS proposals for public comment. The Working Group initially agreed to publish all proposals, but the decision was left unconfirmed.

In November 2019, the Working Group decided to revisit the decision and a survey was conducted to “take the temperature” of the Working Group membership as to which URS individual proposals should be included in the RPM Phase 1 Initial Report for public comment. Following the discussion of the survey results⁵⁴, the Working Group reviewed all proposals again in December 2019 and January 2020.

Based on this second round of assessment, the Working Group determined to publish seventeen (17) of the thirty-six (36) URS proposals submitted by Working Group individuals in the Initial Report. The remaining proposals are not published because they either did not receive adequate support from the Working Group or were superseded by related proposals. Nevertheless, none of the seventeen (17) published URS individual proposals rose to the level of Working Group preliminary recommendations.

The published URS individual proposals have retained their original assigned numbers, hence they are not in consecutive numeric order.

URS Individual Proposal #1

URS Paragraph 6 says:

6.2 In either case, the Provider shall provide Notice of Default via email to the Complainant and Registrant, and via mail and fax to Registrant. During the Default period, the Registrant will be prohibited from changing content found on the site to argue that it is now a legitimate use and will also be prohibited from changing the Whois information.

Option 1: Amend to delete "During the Default period, the Registrant will be prohibited from changing content found on the site to argue that it is now a legitimate use and will also be prohibited from changing the Whois information." and move this text to the section in the policy that indicates how bad faith may be proven (i.e. these behaviors may be used by the Examiner to find bad faith).

Option 2: Just delete the "During the Default period" text. [Note, there is no Default period defined here or anywhere - the case goes to the Examiner.]

Context:

⁵⁴ See survey results here: <https://community.icann.org/display/RARPMRIAGPWorkingGroup/URS+Proposals?preview=/93126760/124846698/URS%20Individual%20Proposal%20Survey%20Result.pdf#URSProposals--986447092>

Rationale provided by the Proponent: No one but the registrant and its webhost can change the content on a web page - the passive text indicating that changing it "will be prohibited" is confusing. If changing website content is prohibited (and it appears it is), that text should move to a direct instruction to the registrant, and the procedure should include a note to the Examiner to make all reasonable inferences from such behavior.

Working Group Deliberation: There was wide support in the Working Group to publish the proposal in the Initial Report to seek public comment.

URS Individual Proposal #2

Legal requirements should be moved from the technical document "URS High Level Technical Requirements for Registries and Registrars"⁵⁵ to another document (URS Procedure⁵⁶ or URS Rules⁵⁷).

The concerning "legal requirements" language is as follows:

4. Registry-Registrar Agreement:

- The Registry Operator MUST specify in the Registry-Registrar Agreement for the Registry Operator's TLD that the Registrar MUST accept and process payments for the renewal of a domain name by a URS Complainant in cases where the URS Complainant prevailed.
- The Registry Operator MUST specify in the Registry-Registrar Agreement for the Registry Operator's TLD that the Registrar MUST NOT renew a domain name to a URS Complainant who prevailed for longer than one year (if allowed by the maximum validity period of the TLD).

Alternative, leave the "legal requirements" text, but rename the "URS High Level Technical Requirements for Registries and Registrars" document as "URS High Level Requirements for Registries and Registrars". In addition, on ICANN's page <https://newgtlds.icann.org/en/applicants/urs>, change the document's title from "URS Technical Requirements 1.0" to "URS Registrars and Registries Requirements 1.0".

Context:

Rationale provided by the Proponent: The reason is to avoid confusion among Registries and Registrars. Usually Engineers read technical documents and legal teams read Rules and Procedures. Here we see a legal requirement to include particular text into Registry-Registrar Agreement. This change will simplify the process of understanding the URS implementation for new Registries and Registrars, and reduce the workload for ICANN Compliance/Legal departments without significant changes.

Working Group Deliberation: There was wide support in the Working Group to publish the proposal in the Initial Report to seek public comment.

⁵⁵ URS Technical Requirements for Registries and Registrars can be downloaded here:

<https://newgtlds.icann.org/en/applicants/urs/tech-requirements-17oct13-en.pdf>

⁵⁶ URS Procedure can be downloaded here: <https://newgtlds.icann.org/en/applicants/urs/procedure-01mar13-en.pdf>

⁵⁷ URS Rules can be downloaded here: <https://newgtlds.icann.org/en/applicants/urs/rules-28jun13-en.pdf>

Working Group Question for Public Comment for Public Comment: The Working Group particularly seeks public comment from the Contracted Parties House with regard to this proposal.

URS Individual Proposal #3

Revise URS Policy Paragraph 10 to reflect the following new provisions:

10.3 There shall be an option for a successful or unsuccessful Complainant to extend the registration period for one additional year at commercial rates.

10.5 Notwithstanding any locking of a domain name pursuant to Paragraph 4.1 and notwithstanding the suspension of domain name pursuant to Paragraph 10.2, a registrant shall be entitled to renew a subject domain name registration and the Registry shall permit same in accordance with its usual commercial rates for a period of up to one year.

Context:

Rationale provided by the Proponent: What happens when a URS decision is issued, for example, merely one (1) day prior to the expiry of the disputed domain name? Pursuant to Paragraph 12.4 of the URS Policy, an appeal must be brought within 14 days of the decision. Both Complainants and Respondents would as a result, be unable to appeal under such circumstances, unless they filed the appeal within one (1) day of the decision coming out, since the registration would expire before the end of the 14 day appeal period.

Accordingly, the URS Policy needs to correct this oversight in order to enable the appeal mechanism to work in all situations. Currently, a Complainant can only renew a domain name if it was successful in the URS proceeding. The proposal allows an unsuccessful Complainant to also renew the registration for a year, so as to enable an appeal in circumstances where the 14 day appeal period extends beyond the registration expiry date.

Similarly, a registrant who wants to appeal a suspension order also needs to be able to extend the registration beyond the original expiry date.

A registrant also needs to be able to extend the registration period if it wants to file a Response within six (6) months of the Default Determination, in circumstances where the registration expiry date will occur before the end of the six (6) month period.

This policy proposal would oblige the parties to extend the registration period if they wanted to appeal and the domain name was going to imminently expire.

Working Group Deliberation: There was wide support in the Working Group to publish the proposal in the Initial Report to seek public comment.

URS Individual Proposal #6

The recommendation is to permit multiple unrelated Complainants to bring a single Complaint jointly against a single domain name registrant (or related registrants) who has registered multiple domain names, by deleting the following procedural element within Section 1.1.3 of the URS Procedure:

"One Complaint is acceptable for multiple related companies against one Registrant, but only if the companies complaining are related."

Context:

Rationale provided by the Proponent: A single Complaint against a single domain name registrant (or related registrants) should be permitted to be joined by multiple unrelated Complainants. There is no practical difference between allowing a Complaint based on trademarks that are owned by different, but related corporate entities, as permitted in Paragraph 1.1.3 of the URS Procedure, and allowing a Complaint based on trademarks owned by different, but unrelated entities, whose marks are similarly being abused by the same registrant.

Allowing multiple unrelated Complainants to bring a single Complaint jointly will enhance the utility of the URS by:

- Reducing the cost burden on all parties, including Providers, by avoiding duplication and maintaining focus on the scope of the abuse to multiple trademarks by one Respondent registrant.
- Streamlining the process, creating significant efficiencies, and enabling the suspension of multiple domain names abusing third-party rights.

Working Group Deliberation: There was some support in the Working Group for publishing this proposal in the Initial Report to seek public comment. Some Working Group members expressed practical concerns about implementing the proposal.

URS Individual Proposal #11

The Response Fee threshold should be lowered from 15 domain names to 3, because this is sufficient to demonstrate a clear pattern by the registrant based on relevant URS precedent. In cases where the named Respondent is ultimately determined not to be the actual registrant of all the domain names in the Complaint, the fee would only apply if the registrant is confirmed for 3 or more of the listed domain names; otherwise, no such fee would apply.

Context:

Rationale provided by the Proponent: By 6 September 2018, six (6) URS cases out of 827 (0.7%) have involved Complaints listing 15 or more domain names (to which the Response Fee applies). There have been 25 cases (including those six) out of the 827 total cases (3%) where the Complaints listed five (5) or more domain names. There have been 43 cases (including those 25) out of the 827 total cases (5.2%) where the Complaints listed three (3) or more domain names.

URS precedent has indicated that as few as three (3) domain names can indicate a pattern of bad faith. See, e.g., *Moncler S.P.A. v. Trani Johanna*, Case No. 1713264 (Forum Feb. 6, 2017)⁵⁸ (“registration of three very similar domain names in issue in this case is indicative of a ‘pattern’ of bad faith registration by Respondent”). The threshold should be lowered from 15 domain names to three (3) domain names as a reasonable modification, given the case support for only 3 domains being required to establish a pattern.

Working Group Deliberation: There was general support in the Working Group for publishing this proposal in the Initial Report to seek public comment, but with some opposition. Some Working Group members expressed the concern that the proposed Response Fee threshold of three (3) domain names is too low.

Working Group Question for Public Comment: The Working Group seeks public comment on whether the current Response Fee threshold of fifteen (15) domain names should be lowered, and if so, what the new threshold should be.

URS Individual Proposal #13

The losing Respondent cannot re-register the same domain name once it is no longer suspended.

Context:

Rationale provided by the Proponent: Where a Respondent loses the URS case relating to a specific string, it should not be permitted to simply re-register that name once it is no longer suspended. This would help to prevent gaming of the system and unnecessary cluttering of the providers’ workload with spurious or vexatious cases.

Working Group Deliberation: There was some support in the Working Group for publishing this proposal in the Initial Report to seek public comment.

Working Group Question for Public Comment: The Working Group seeks public comment on the feasibility of enforcing the proposal should it be implemented.

URS Individual Proposal #15

The URS should be amended to include express provisions (beyond the mention of a “pattern of conduct” in URS Procedure paragraph 1.2.6.3(b)) which provide additional penalties for “repeat offenders” and “high-volume cybersquatting.”

The definition of a “repeat offender” should be any domain name registrant who loses two or more separate URS proceedings. The definition of “high-volume cybersquatting” should be any URS proceeding where the Complainant prevails against a single Respondent in a Complaint involving 10 or more domain names.

⁵⁸ <https://www.adrforum.com/DomainDecisions/1713264D.htm>

Once either of these standards are established, the penalties should include (i) a requirement that the registrant deposit funds into an escrow account, or provide an equivalent authorization on a credit card, with each new domain registration (such funds could be dispersed to prevailing Complainants in future domain name disputes against that registrant as part of a “loser pays” system), and (ii) a universal blocking of all domain registrations for a set period for the registrant (i.e. “blacklisting” the registrant on a temporary basis). There may be other possible enhanced penalties that would also be appropriate.

Such requirements could be included in updated URS Rules, made enforceable against Registrars via parallel updates to the RAA and domain name registration agreements of individual Registrars. These obligations would be enforceable by ICANN Compliance.

Context:

Rationale provided by the Proponent: Habitual cybersquatting is a significant problem and registrants who have lost multiple cases or have been found to target numerous domain names are clearly not changing their activities based on such losses. Enhanced penalties are needed to serve as a further deterrent against serial cybersquatting and patterns of bad faith and abusive domain name registration and use.

Repeat infringers meet little if any sanction. This should be defined as any registrant that has lost URS cases pertaining to, for example, two or more registrations. While of course this could be for many reasons and the registrant may be acting in good faith, sanctions such as a blocked guarantee being required for further registrations (which could be released after a new level of “clean” registrations is reached) will not be of concern to such a party. Other technical sanctions can be discussed for viability with the Contracted Parties House (CPH), which of course is also keen to promote a clean DNS.

Working Group Deliberation: There was general support in the Working Group for publishing this Individual Proposal in the Initial Report to seek public comment⁵⁹, with some Working Group members supporting the Individual Proposal as drafted. However, some Working Group members expressed opposition, in terms of both substance and implementation of the Individual Proposal, including the proposed remedies and the definition of “repeat offender” and of “high volume cybersquatting”.

Working Group Question for Public Comment: The Working Group seeks public comment on whether the proposed definitions of “repeat offender” and “high-volume cybersquatting” are appropriate, and the feasibility of implementing the proposal.

URS Individual Proposal #16

⁵⁹ The Working Group confirmed that URS Individual Proposal #15 incorporated and superseded URS Individual Proposal #14, of which its rationale applied to URS Individual Proposal #15. The Working Group decided not to publish URS Individual Proposal #14 in this Initial Report for public comment, but the link to all submitted URS Individual Proposals can be found in the “Annex C - Working Group Documents” section.

The URS should allow for additional remedies such as a “right of first refusal” to register the domain name in question once the suspension period ends or the ability of the Complainant to obtain additional extensions of the suspension period.

Context:

Rationale provided by the Proponent: One reason the URS has not met with wide adoption by brand owners is the limited remedies available. It would likely increase URS utility if prevailing Complainants had the opportunity to securely take possession of the disputed domain name(s) without the delay and risk of waiting for a suspended domain to expire and then placing a back order or otherwise attempting to acquire it in the marketplace once the suspension period ended. Such enhanced remedies could include a right of first refusal upon expiration of a suspended domain name but they could also provide for the ability of a losing Respondent to voluntarily transfer a suspended domain to the Complainant upon a negotiated settlement prior to the domain’s expiration. Also, a successful Complainant could be given the option of maintaining and extending the suspension for additional periods of time, potentially subject to payment of a reasonable extension fee in each instance.

The basis for the URS is rapid suspension of names that clearly infringe the rights of a trade mark owner. However, given the timeframe for the action, such names can rapidly be re-registered by the same, or another, infringer. A longer suspension period would prevent opportunistic infringers from simply monitoring URS cases and immediately registering such names when they are no longer in suspension: the simple fact that there has been a URS case will be regarded as evidence that this name is important to the right owner. This is a consumer protection issue: end-users must not be duped into believing that the name will resolve to the right holder’s site.

Working Group Deliberation: There was general support in the Working Group for publishing this proposal in the Initial Report to seek public comment⁶⁰, but some Working Group members expressed opposition to its substance.

Working Group Question for Public Comment: The Working Group seeks public comment on the feasibility of implementing the proposal.

URS Individual Proposal #22

The URS should incorporate a “loser pays” model.

Context:

Rationale provided by the Proponent: No enforcement action is without cost to the rights owner, while both the infringement and attempts at enforcement frequently cost very little to the infringer. While realizing that an infringer may be difficult to locate in many instances, we

⁶⁰ The Working Group confirmed that URS Individual Proposal #16 incorporated and superseded URS Individual Proposal #17, of which its rationale applied to URS Individual Proposal #16. The Working Group decided not to publish URS Individual Proposal #17 in this Initial Report for public comment, but the link to all submitted URS Individual Proposals can be found in the “Annex C - Working Group Documents” section.

should not perpetuate a system where any potential infringer knows that it will suffer little, if any, sanction or financial burden.

The current cost allocation model is sufficient for most cases but it is not equitable for situations involving serial cybersquatters whose activities do not seem to be deterred by multiple adverse URS or UDRP decisions.

In line with the above question regarding repeat offenders (see URS Individual Proposal #15), a provision requiring registrants who have met a set threshold for habitual cybersquatting could be required to deposit funds into an escrow account with each new domain registration or the Registrar should be authorized under its terms of service to charge the credit card on file in connection with the registration in order to satisfy the “loser pays” requirement. Such funds could be dispersed to prevailing Complainants in future domain name disputes against that registrant.

The loser pays model could be adopted in all cases regardless of whether the respondent meets the “repeat offender” or “high-volume cybersquatting” thresholds, or it could be limited only to those cases involving a “repeat offender” or “high-volume cybersquatting.”

Working Group Deliberation: There was an almost equal amount of support and opposition in the Working Group for publishing this proposal in the Initial Report to seek public comment⁶¹. Several Working Group members expressed significant concerns about the substance of the proposal.

Working Group Question for Public Comment: The Working Group seeks public comment on: 1) the appropriateness of a “loser pays” model; 2) the definition of specific criteria (e.g., “repeat offender” over a defined time period, “high-volume cybersquatting”); 3) the specific item(s) that should be paid in a “loser pays” model (e.g., administrative fees, attorneys’ fees), and 4) the enforcement mechanism of the proposed model.

URS Individual Proposal #26

Revise Paragraph 7 of the URS Policy to reflect the following additional provisions:

7.4 Each Provider shall publish their roster of Examiners who are retained to preside over URS cases specifically and identify how often each one has been appointed with a link to their respective decisions.

Context:

Rationale provided by the Proponent: The URS Policy does not adequately provide for rotation of panelists, as it only vaguely “to the extent feasible to avoid forum or Examiner shopping”, pursuant to Paragraph 7.3. The issue is that the parties and the public are unable to determine

⁶¹ The Working Group confirmed that URS Individual Proposal #22 incorporated and superseded URS Individual Proposal #21, of which its rationale applied to URS Individual Proposal #22. The Working Group decided not to publish URS Individual Proposal #21 in this Initial Report for public comment, but the link to all submitted URS Individual Proposals can be found in the “Annex C - Working Group Documents” section.

to what extent such Examiner appointments are truly random and well distributed, thereby depriving stakeholders and the public of effective oversight of this fundamental aspect of the procedure.

Working Group Deliberation: There was wide support in the Working Group to publish the proposal in the Initial Report to seek public comment. Some Working Group members expressed practical concerns about implementing the proposal by the URS Providers. The Working Group noted that most URS Providers already publish their roster of Examiners, but may not take the further step of identifying the number/frequency of their appointments and the links to their respective decisions beyond the general publication of all URS decisions.

URS Individual Proposal #27

Revise URS Rule 6 to reflect the following new provision:

6(a) Each Provider shall maintain and publish a publicly available list of Examiners and their qualifications by way of publishing a current curriculum vitae updated on a regular basis.

Context:

Rationale provided by the Proponent: As per the Super Consolidated URS Topics Table at Section M(1)⁶², it was found that some providers do not seem to publish all of their Examiner's CV's. URS Rule 6(a)⁶³ merely requires the provider to list the panelist's qualifications. This should be clarified to expressly require a CV. Moreover, it is important that this CV be reasonably current, as some panelists have been around for 20 years and their CV may not have been updated since. Knowing a panelist's background of course informs parties and stakeholders as to their suitability for appointment.

Working Group Deliberation: There was wide support in the Working Group to publish the proposal in the Initial Report to seek public comment. The Working Group discovered that a certain URS Provider did not list or maintain the backgrounds of all of their Examiners as required by URS Rule 6(a). The Working Group also noted that this URS individual proposal may complete the Working Group's URS Recommendation #4.

URS Individual Proposal #28

Revise URS Rule 6 to add the following provision:

6(c) Each Provider shall ensure compliance with the Panelist Conflict of Interest Policy.

The "Conflict of Interest Policy" should be developed by the Working Group and applied to all Providers.

⁶² See pages 42-45 here: <https://docs.google.com/document/u/1/d/1YR7f60lkbaTyWJLaWvMVultvxyujlp2uDE27B-SN30/edit?usp=sharing>

⁶³ **URS Rule 6(a):** Each Provider shall maintain and publish a publicly available list of Examiners and their qualifications.

Context:

Rationale provided by the Proponent: Currently there is no known conflict of interest policy for Examiners, let alone one which applies across all Providers. Accordingly Examiners are left to determine for themselves what constitutes a conflict of interest which must be disclosed pursuant to URS Rule 6. Examiners would generally appreciate having such guidance in place, as would parties who could then feel more confident in knowing when an Examiner is and is not required to disclose a conflict or recuse him or herself. There are codes of conduct employed for arbitrators in other forums, such as the IBA Guidelines on Conflict of Interest in International Arbitration⁶⁴.

Working Group Deliberation: There was some support in the Working Group for publishing this proposal in the Initial Report to seek public comment. Noting that URS Providers already implement conflict of interest measures⁶⁵, some Working Group members questioned the necessity of this proposal.

Working Group Question for Public Comment: The Working Group seeks public comment on the suggested elements of the proposed “Panelist Conflict of Interest Policy”, should it be developed by the Working Group and applied to all URS Providers, as well as existing conflict of interest policies that can serve as examples.

URS Individual Proposal #29

All URS decisions shall be published in a standardized machine-readable XML format, to complement existing formats of decisions.

Context:

Rationale provided by the Proponent: 1) It is consistent with ICANN’s recently announced Open Data Strategy⁶⁶; 2) it lowers the cost of academic research, by making it much easier to access and manipulate the data within decisions; 3) it improves transparency, and thus accountability, of the procedures; and 4) it makes future evidence-based reviews of the policies easier, since the raw data can be accessed at much lower cost than at present.

Working Group Deliberation: There was some support in the Working Group for publishing this proposal in the Initial Report to seek public comment. A URS Provider expressed practical concerns that it would be cost prohibitive to implement the proposal. Some Working Group members noted that the benefits derived from the proposal, if any, may be limited.

⁶⁴ See: <https://www.ibanet.org/Document/Default.aspx?DocumentUid=e2fe5e72-eb14-4bba-b10d-d33dafee8918>

⁶⁵ Both FORUM and MFSD’s Examiners have voluntarily disclosed conflict of interest, but no instance of a conflict presenting itself after an Examiner has accepted a case. ADNDRC’s Examiners have not voluntarily disclosed any conflict of interest, but no issue was raised. URS Providers have different methods seek confirmation from Examiners on their impartiality or independence (FORUM - [Neutral’s Oath](#); MFSD - email & checkbox on [Determination Form](#); ADNDRC - email)

⁶⁶ <https://www.icann.org/news/blog/icann-org-s-open-data-strategy>

Working Group Question for Public Comment: The Working Group seeks public comment on the cost-benefit evaluation of implementing the proposal.

URS Individual Proposal #31

For the sole purpose of assuring that this subject is included in the Initial Report for the solicitation of public comment, I am proposing that the Working Group put out for Public Comment the issue of whether the URS should become an ICANN Consensus Policy.

Context:

Rationale provided by the Proponent: On behalf of Verisign, I am proposing that the Working Group put out for Public Comment the issue of whether the URS should become an ICANN Consensus Policy. Verisign believes that it is the appropriate time for this matter to be discussed in the Public Comment forum on the Working Group's Initial Report. Sub team developed data indicates that URS in practice has proven viable, efficacious, and fit-for-purpose as a rapid remedy for clear-cut instances of protected mark abuse. We believe that inviting public input will be valuable, indeed essential, in informing the RPM PDP Working Group in its future work.

Working Group Deliberation: There was wide support in the Working Group to publish the proposal in the Initial Report to seek public comment. The Working Group noted that the question is silent on whether the URS referred to in this proposal would maintain its current form, or undergo certain unspecified changes⁶⁷.

URS Individual Proposal #33

All current and future URS providers should be brought under formal fixed-term contract with ICANN, instead of the current arrangements (MOUs for URS providers). Those contracts should not have any presumptive renewal clauses.

Context:

Rationale provided by the Proponent: The current legal relationships between ICANN and the URS Providers create uncertainty regarding accountability, transparency, and compliance. Formal contracts, for a fixed term, without presumptive renewal clauses, will help improve the current state of affairs. Contracts will provide all parties with clear expectations of rights and responsibilities.

URS Providers should be subject to the same scrutiny as other contracted parties such as Registrars and Registry Operators, to ensure that bad actors do not gain control over an ADR

⁶⁷ URS Individual Proposal #31 stems from one of the three (3) general overarching Charter questions -- "General Overarching Charter Question #2: 2a. Should any of the New gTLD Program RPMs (such as the URS), like the UDRP, be Consensus Policies applicable to all gTLDs? 2b. If so, what are the transitional issues that would have to be dealt with as a consequence?" The Working Group is expected to address these overarching Charter questions at the conclusion of Phase 1 or Phase 2 of its work, as appropriate. During the public comment proceeding for the Initial Report, the Working Group also seeks input for these overarching Charter questions which may help inform its overall work toward the Final Report.

Provider. All beneficial owners of 15% or more (directly or indirectly) of a Provider should be disclosed.

The current “accredit and forget it” model is unacceptable. These are multi-million dollar ADR services annually in aggregate and should be formalized with contracts.

Working Group Deliberation: There was some support in the Working Group for publishing this proposal in the Initial Report to seek public comment. Some Working Group members expressed concerns that this proposal seems to be based on a misconception that ICANN’s Memorandums of Understanding (MOUs)⁶⁸ with URS Providers are not enforceable. Those Working Group members noted that MOU is enforceable and has termination clauses.

Working Group Question for Public Comment: The Working Group seeks public comment on additional elements, if any, that need to be included to enhance ICANN’s MOUs with URS Providers and enforce their compliance.

URS Individual Proposal #34

URS shall be amended to incorporate in full Rule #11 of the UDRP Rules regarding “Language of Proceedings”, see: <https://www.icann.org/resources/pages/udrp-rules-2015-03-11-en>

“(a) Unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.

(b) The Panel may order that any documents submitted in languages other than the language of the administrative proceeding be accompanied by a translation in whole or in part into the language of the administrative proceeding.”

The Proponent proposed the following: Preliminary submissions by either side to the Panel regarding the language of the proceeding shall be limited to 250 words, and not be counted against the existing URS word limits. Notice of Complaint shall contain a section explaining that the Respondent may make a submission regarding the language of the proceedings. If a translation is ordered, exceeding the URS word limits shall be permitted, as long as the original submission met the word limits in the original language.

Context:

Rationale provided by the Proponent: Currently, the URS Rules⁶⁹ only require that the Notice of Complaint be translated into the language of the respondent’s country, not the Complaint itself (Rules #4 and #9 of the URS) which is currently required to be in English. This can put

⁶⁸ ICANN has established MoUs with three URS Providers. MoU between ADNDRC and ICANN:

<http://www.icann.org/en/about/agreements/partnership-mous/adndrc-urs-17apr13-en.pdf>; MoU between FORUM and ICANN: <http://www.icann.org/en/about/agreements/partnership-mous/naf-urs-20feb13-en.pdf>; MoU between MFSD and ICANN: <https://www.icann.org/en/system/files/files/mfsd-urs-20aug15-en.pdf>.

⁶⁹ URS Rules can be downloaded here: <https://newgtlds.icann.org/en/applicants/urs/rules-28jun13-en.pdf>

Respondents who don't understand English at a severe disadvantage in the process. For ICANN to be placing one language above all others for mandatory policies in a multilingual world defies common sense.

By having the language of the registration agreement determine the language of the administrative proceeding, registrants will have the opportunity to select a registration agreement in the language of their choice, and thereby be able to fairly participate in the URS. To be clear, URS providers would not be required to provide translations of pleadings (only the Notice of Complaint), so would not bear additional costs (the pleadings need to be provided by the parties in the appropriate language, subject to panel discretion as per the URS' flexibility). Any panel order for translation would need to be done by the parties.

Working Group Deliberation: There was wide support in the Working Group to publish the proposal in the Initial Report to seek public comment.

URS Individual Proposal #36

Eliminate the existing post-default de novo review period and instead replace the current URS appeal filing period to 60 days, with the possibility of obtaining an additional 30 days to file a URS appeal as a matter of right, upon request within the initial 60 day filing period.

Context:

Rationale provided by the Proponent: Under the URS Procedure⁷⁰, a registrant defaults if it fails to reply to a Complaint within fourteen (14) days (Paragraph 6.1). All default cases proceed to examination on the merits of the claim (Paragraph 6.3) ("Examination #1"). If the defaulting registrant loses Examination #1, it can file for "de novo review" within six (6) months of default. It can ask for another six-month extension (Paragraph 6.4), thus up to twelve (12) months after default. The filing of a response by defaulting registrant after default is not an appeal - the case is considered as if responded to in a timely manner (Paragraph 6.5) ("Examination #2"). Under URS Procedure Paragraph 12, either party can file for de novo appeal (Paragraph 12.1) within fourteen (14) days after a default or final determination (Paragraph 12.4). For defaulting registrant this de novo procedure is Examination #3. So, a defaulting registrant gets up to three (3) examinations which can take up to a year and several months or more.

A registrant who actually responds to a Complaint within fourteen (14) days, on the other hand, gets up to two (2) examinations – the original examination (under Paragraph 9), and the de novo appeal under URS Procedure Paragraph 12.1. This can all happen within two (2) to three (3) months. This difference seems contrary to the 'rapid' nature of URS and could encourage defaults.

As domain name registrants often address URS cases on a pro se basis and sometimes view service of URS Complaints as spam, they may not become fully aware of the dispute until after their domain and website are disabled.

⁷⁰ URS Procedure can be downloaded here: <https://newgtlds.icann.org/en/applicants/urs/procedure-01mar13-en.pdf>

This proposal counsels in favor of some grace period for submitting a reply but the current one year period is excessive. If a losing Respondent doesn't notice that its domain has been suspended within thirty (30) days one may safely assume that the domain is of little importance to the Respondent and they have consciously foregone the opportunity to formally respond in the URS proceeding. Alternatively, given the availability of the "appeal" process under the URS, which is also a de novo review, the post-default de novo review process could be eliminated altogether.

Working Group Deliberation: There was some support in the Working Group for publishing this proposal in the Initial Report to seek public comment⁷¹.

4.3 TMCH Individual Proposals

From end-2016 through July 2017 and again from August 2019 to October 2019, the RPM PDP Working Group deliberated over the Trademark Clearinghouse (TMCH) structure and operations. The Working Group discussions were based on specific categories into which the original Charter questions had been placed by the TMCH Charter Questions Sub Team. The Working Group's deliberations resulted in proposals being submitted by individual Working Group members to address a number of these questions. Discussion of a few of these questions were deferred pending completion of the Working Group's review of the Sunrise and Trademark Claims services.

The Working Group returned to these open TMCH questions between August-October 2019. While the Working Group agreed on one preliminary recommendation (see the "Deliberations of TMCH Structure and Scope" section of this Initial Report for details), it did not reach agreement on the individual proposals. Ultimately, the Working Group agreed to include the following seven (7) proposals in this Initial Report for public comment.

TMCH Individual Proposal #1

The TMCH should be responsible for educating rights-holders, domain name registrants and potential registrants about the services it provides.

Context:

Rationale provided by the Proponent: First, the TMCH services are for the community, so for the TMCH to have a successful interaction with the community, the community needs to have a meaningful knowledge of the TMCH services. Second, the TMCH is the best place to explain its own services and correctly identify the stakeholders it interacts with. Third, the TMCH already provides some level of educational material and efforts toward trademark owners, and implementing these efforts to further develop education and outreach for current and potential

⁷¹ The Working Group confirmed that URS Individual Proposal #36 incorporated and superseded URS Individual Proposals #9 and #10, of which their rationale applied to URS Individual Proposal #36. The Working Group decided not to publish URS Individual Proposals #9 and #10 in this Initial Report for public comment, but the link to all submitted URS Individual Proposals can be found in the "Annex C - Working Group Documents" section.

registrants would serve the fuller community. Fourth, this proposal is aligned in the same direction as some of the new Trademark Claim notices.

Working Group Deliberations: Some Working Group members supported the proposal. In addition, some Working Group members supported a “hybrid” model in which ICANN org is to be responsible for developing the different sets of materials (including for potential registrants and the general public), which materials will be hosted by the TMCH and possibly distributed by registrars.

Working Group Question for Public Comment: The Working Group seeks community input as to whether, and if so how and by whom, education about the TMCH and its services should be provided.

TMCH Individual Proposal #2 (1 of 2 proposals concerning design marks)

The TMCH Provider Deloitte should be required to comply with the TMCH rules limiting the acceptance of marks into the TMCH Database to “word marks”.

TMCH Individual Proposal #3 (2 of 2 proposals concerning design marks)

1. Section 3.2 of the Applicant Guidebook be revised to use the term “text marks” rather than “word marks.” “Text marks” would be defined to consist of:
 - a. Marks consisting of text only, including marks where the text is portrayed in color, in a typeface (or typefaces), in a logo form, in a fanciful manner, and/or otherwise portrayed in a stylized fashion, as well as “standard character” marks.
 - b. Marks consisting of text in combination with design elements or devices, sometimes referred to as, e.g., composite marks or figurative marks, except for marks where the text portion of the mark is disclaimed in its entirety.
2. Trademark Clearinghouse Guidelines should be revised as follows (new language in bold):

An Applicant to the Trademark Clearinghouse must include in its application a sworn statement that the trademark registration does not include a disclaimer as to any portion of the mark, or if it does, the text portion of the mark is not disclaimed in its entirety. Where the text portion of a mark is disclaimed in its entirety, the mark is not eligible for registration in the Clearinghouse. For marks that are Text Marks that do not exclusively consist of letters, words, numerals, and/or special characters, the recorded name of the Trademark will be deemed to be an identical match to the reported name as long as the name of the Trademark includes letters, words, numerals, signs, keyboard signs, and punctuation marks (“Characters”) and all Characters are included in the Trademark Record submitted to the Clearinghouse in the same order they appear in the mark.

In the event that there is any doubt about the order in which the Characters appear, the description provided by the Trademark office will prevail. In the event no description is provided, such Trademarks will be allocated to a Deloitte internal team of specialists

with thorough knowledge of both national and regional trademark law who will conduct independent research on how the Trademark is used, e.g. check website, or they may request that the Trademark Holder or Trademark Agent provide additional documentary evidence on how the Trademark is used.

3. The Trademark Clearinghouse Guidelines should be revised as follows (new language in bold):

The Trademark Clearinghouse should not accept for inclusion marks where all textual elements are disclaimed and as such any Characters are only protectable as part of the entire composite mark including its non-textual elements.

4. The Working Group recommends that a new grounds to the challenge procedure be added to assess whether the underlying trademark registration was obtained in bad faith as a pretext solely to obtain a Sunrise registration.

In preparing the grounds for such challenges, guidance may be drawn from the pre-delegation Legal Rights Objection consideration factors:

<http://www.wipo.int/amc/en/domains/lro/faq/#3a> and the judgement of the European Court of Justice in Case C-569/08 Internetportal und Marketing GmbH v. Richard Schlicht <http://eur-lex.europa.eu/legalcontent/EN/TXT/HTML/?isOldUri=true&uri=CELEX:62008CJ0569>.

Context:

Rationale provided by the Proponent of TMCH Proposal #2: Some RPM PDP Working Group members have found a problem:

1. The RPM PDP Working Group members have learned that Deloitte is accepting the words of design marks, composite marks, figurative marks, stylized marks, mixed marks, and any similar combination of characters and design (collectively “design marks”).
2. However, the rules of the Applicant Guidebook (together with STI⁷² rules adopted by the GNSO Council and ICANN Board) expressly limits the acceptance of marks into the TMCH Database to “word marks”.
3. Accordingly, Deloitte is not following the applicable rules adopted by the GNSO Council and ICANN Board for TMCH operation.
4. Whether the current rules should be changed is a separate issue from whether Deloitte is currently complying with the applicable rules. The Working Group by Consensus can determine that the current rules should be changed and present the GNSO Council and ICANN Board with an expanded set of rules that Deloitte, or any future TMCH Provider, must follow.

Additional rationale provided by the Proponent is included in the document in the footnote⁷³.

⁷² STI refers to the work of the Special Trademark Issues Review Team. See “Background” section of this Initial report for additional details.

⁷³ <https://mm.icann.org/pipermail/gnso-rpm-wg/attachments/20190918/e9fbcd9d/KleimanMuscovitchProposal09042019-0001.pdf>

Rationale provided by the Proponent of TMCH Proposal #3:

Section 3.2 of the Applicant Guidebook describes the marks that may be accepted into the TMCH Database as “word marks.” However, the term “word mark” is not defined in the AGB. This has created ambiguity and the potential for misunderstanding.

- a. Specifically, it appears that marks may have been accepted into the TMCH Database where all of the words in the mark have been disclaimed.
- b. This ambiguity should therefore be clarified.

Working Group Deliberations on both Proposals: In March 2017 at ICANN58, Deloitte (the TMCH Validation Service Provider) provided the following information to the Working Group on how it handles design marks:

- Verification focuses on words in a design mark, but not the design aspect – note example from TMCH Guidelines.
- Disclaimers to exclusive use of marks are not factored in; verification process involves only matching factual data against corresponding trademark certificate - no legal opinion provided by TMCH on exclusive use.
- Verification of generic words also are matched against corresponding trademark certificate.
- Some jurisdictions do not distinguish between different types of marks (e.g. word vs figurative/design mark); no separate statistics on design marks per se.

The Working Group had diverging opinions on the appropriateness and adequacy of the TMCH Validation Service Provider’s handling of design marks. In light of Deloitte’s response, some Working Group members thought that they could support either proposal; some other Working Group members also had concerns with the accuracy of the accompanying rationale for TMCH Individual Proposal #2.

The Working Group notes that TMCH Proposal #2 essentially calls for the elimination of design marks in the TMCH, whereas TMCH Proposal #3 does not propose elimination but calls instead for clarifications regarding applicable definitions and usage. The Working Group believes that additional community input will be helpful in assisting the Working Group to determine whether there is a need for a policy recommendation to address the issue of design marks.

Working Group Question for Public Comment: The Working Group seeks community input on both proposals, in order to determine the extent of support for either TMCH Proposal #2 or TMCH Proposal #3. In addition, the Working Group welcomes suggestions for ways to reconcile the two proposals, if possible.

TMCH Individual Proposal #4 (1 of 2 proposals concerning geographical indications)

1. Geographical Indicators (GIs) may not be registered in the TMCH Database used for Sunrise or Trademark Claims under the theory that they are marks protected by statute/treaty. If they are not also eligible for the TMCH Database as trademarks, any GIs presently in the TMCH Database should be removed.

2. "Other marks that constitute intellectual property" are not eligible for Sunrise or Trademark Claims. If and when the TMCH Provider adds ancillary databases covering "other marks," it should revise its public-facing materials to make this distinction clear.
3. Proposals for amended language in the Applicant Guidebook (new language in bold):

"3.2.3 Any word marks protected by a statute or treaty in effect at the time the mark is submitted to the Clearinghouse for inclusion." This language should be amended to read **"3.2.3 Any word mark protected by a statute or treaty in effect at the time the mark is submitted to the Clearinghouse for inclusion; the word mark protected by statute or treaty must be a trademark."** An explanatory footnote to 3 should be added:

The Clearinghouse is for word marks that are trademarks. "Trademarks" here includes trademarks, service marks, collective marks, and certification marks. Geographic indications (that are not also protected as trademarks) are not trademarks.

"3.2.4 other marks that constitute intellectual property" should be amended:

Marks not eligible for inclusion in the Trademark Clearinghouse: Other marks or identifiers that constitute intellectual property may not be used for the purposes of Sunrise or Claims under the existing RPMs, as set forth in Section 7. Such marks or identifiers may be collected to support the services any given registry operator chooses to provide, solely for the purpose of providing ancillary services as set forth in Section 3.6.

3.5 should be amended for consistency with the revisions to 3.2.3.

Finally, 3.6 should itself be amended to clarify: **"Data supporting entry into databases that are separate from the Clearinghouse and used to provide ancillary services of marks that constitute intellectual property of types other than those set forth in sections 3.2.1-3.2.3 above shall be determined by the registry operator and the Clearinghouse, or other provider chosen by the registry operator, based on the services any given registry operator chooses to provide, consistent with 4.1."**

For reference: Current 4.1: ...There shall be no bar on the Trademark Clearinghouse Service Provider or other third party service providers providing ancillary services on a non-exclusive basis.

TMCH Individual Proposal #5 (2 of 2 proposals concerning geographical indications)

1.0 The main database function of the TMCH is for trademarks, specifically: trademarks registered at the national or regional level; trademarks protected under common law which are confirmed by court decision(s); and trademarks protected under national or international laws by Statute or Treaty.

1.1 The main database function of the TMCH shall be solely used for supporting the Mandatory RPMs, including TM Claims and Sunrise.

1.2 The TM Claims and Sunrise mechanisms are mandatory RPMs for the protection of trademarks; other signs or source identifiers, such as "Geographical Indications" or "Appellations of Origin" shall not be eligible for protection in the mandatory Sunrise or Claims periods, unless such "Geographical Indications or Appellations of Origin" are also independently registered as trademarks.

1.3 Section 3.2.3 of the Applicant Guidebook should be amended as follows (new language in bold): "**3.2.3 Any word mark protected by a statute or treaty in effect at the time the mark is submitted to the Clearinghouse for inclusion, and which is identified within the Statute or Treaty as a mark that functions as a trademark/source-identifier.**"

2.0 The TMCH Service Provider may provide Ancillary Services, including the creation of Ancillary Database(s), as long as those services and any data used for those services are kept separate from the main Clearinghouse database.

2.1 Ancillary Services may be used to support Voluntary RPMs, including the Limited Registration Period, and/or other mechanisms that may be designed by the Registry Operator at the sole discretion of the Registry Operator, and as permissible under the terms of the New gTLD Registry Agreement.

2.2 Ancillary Services, and Ancillary Database(s), may be used for the recordation of trademarks, Geographical Indications, Appellations of Origins, or other identifiers, at the discretion of the Registry Operator and TMCH Provider, or other Provider(s), and as permissible under the terms of the New gTLD Registry Agreement. There is no prohibition on multiple Registries using the same database for Ancillary Services.

2.3 Data supporting entry into databases that are separate from the Clearinghouse and used to provide Ancillary Services of marks that constitute intellectual property of types other than those set forth in sections 3.2.1-3.2.3 of the Applicant Guidebook above shall be determined by the Registry Operator and the TMCH Service Operator, or other Provider(s) chosen by the Registry Operator, based on the services any given Registry Operator chooses to provide. There is no prohibition on multiple Registries using the same database for ancillary services.

Context:

Rationale provided by the Proponent of TMCH Proposal #4:

1. The TMCH Database is for trademarks: those that are registered as trademarks, confirmed by court decision as trademarks, or protected by statute or treaty that specifies the trademarks covered. Sunrise and TM Claims are for the protection of trademarks only. Geographical Indications/Appellations of Origin ("GIs") are not eligible for protection in the mandatory Sunrise or Claims periods, save where they also qualify as trademarks.
2. Non-trademarks or other identifiers can be the subject of ancillary databases that may be voluntarily used by registries to provide additional services other than the Sunrise

and Trademark Claims mandated under the existing RPMs Requirements. Other ancillary service providers may compete to provide these services.

Rationale provided by the Proponent of TMCH Proposal #5:

The main database function of the TMCH is for trademarks, specifically: trademarks registered at the national or regional level; trademarks protected under common law which are confirmed by court decision(s); and trademarks protected under national or international laws by Statute or Treaty.

Working Group Deliberations on both Proposals: In March 2017 at ICANN58, Deloitte (the TMCH Validation Service Provider) provided the following information to the Working Group on how it handles this category of marks:

- “Marks protected by statute or treaty” is a separate category of marks within the TMCH.
- The TMCH Guidelines describe Deloitte’s process for validating and accepting submissions in this category.
- As part of this process, Deloitte does not distinguish between “geographical indicators”, “designations (or appellations) of origin”, and other marks that may be entitled to statutory protection.
- As of February 2017, 98 such marks had been submitted and 75 had been successfully validated. Due to Deloitte’s validation process, it was not possible to tell how many amongst the 75 validated marks constitute “geographical indications” as that term may be used in national or regional laws and treaties.

The Working Group also discussed the nature of national, regional and international legal protection for these marks, which are not necessarily the same as or equivalent to registered trademark rights. In light of Deloitte’s response and the Working Group’s discussions, the Working Group agreed to include the above two proposals in the Initial Report for public comment⁷⁴.

Working Group Question for Public Comment: The Working Group seeks community input on both proposals, in order to determine the extent of support for either TMCH Proposal #4 or #5. The Working Group also welcomes suggestions for ways to reconcile the two proposals, if possible.

TMCH Individual Proposal #6

The Trademark Clearinghouse database provider(s) should be contractually bound to maintain, at minimum, industry-standard levels of redundancy and uptime.

⁷⁴ Section 3.6 of Trademark Clearinghouse in Module 5 of the gTLD Applicant Guidebook may provide further context for the TMCH Individual Proposal #5. It states the following: “Data supporting entry into the Clearinghouse of marks that constitute intellectual property of types other than those set forth in sections 3.2.1-3.2.3 above shall be determined by the registry operator and the Clearinghouse based on the services any given registry operator chooses to provide.” See: <https://newgtlds.icann.org/en/applicants/agb/trademark-clearinghouse-04jun12-en.pdf>

To further ensure the effective delivery of the Sunrise and Trademark Claims services, the following implementation guidance should be provided to the Implementation Review Team that will be formed to advise ICANN org on implementation of those policy recommendations that are ultimately approved by the GNSO Council and the ICANN Board:

- Consider the advisability of requiring that more than one provider be appointed; and
- Review the work of the Implementation Advisory Group that was formed for the 2012 New gTLD Program⁷⁵ to assist ICANN org with developing the specifications for and design of the Trademark Clearinghouse.

Context:Rationale provided by the Proponent:

It is critical that the Trademark Clearinghouse database remains available for access by registries and registrars in order to provide the mandatory Sunrise and Trademark Claims services and, in some cases, additional services such as extended claims periods.

Working Group Deliberation: This proposal concerns the operation of the Trademark Clearinghouse Database (currently administered by IBM). Where Deloitte operates the Trademark Clearinghouse validation service that checks trademarks submitted for entry into the TMCH against the substantive and other criteria set out in the TMCH Guidelines, IBM operates the resulting TMCH Database with which registry operators and registrars interact, e.g. to offer the Trademark Claims service. In this context, some Working Group members expressed concerns about operational considerations due to there being only a single provider (e.g., one Working Group member noted that several Registry Operators had experienced downtime issues when accessing the TMCH Database). However, the Working Group did not develop a specific recommendation to address this issue.

TMCH Individual Proposal #7

In order to foster robust accountability, and in order to ease operational and commercial challenges flowing from a dearth of information about what is in the TMCH, the TMCH should transition from a closed database to an open and searchable database.

Context:Rationale provided by the Proponent:

1. Transparency is essential in order to monitor for abusive registrations, as well as to facilitate broader oversight over how the database is operating.

Throughout our review process, among the key challenges that this Working Group has faced has been a lack of data regarding what, exactly, is in the TMCH. What little information we have has come from the small number of journalists who are engaged enough on this issue to take a “trial-and-error” approach to dig up some particularly

⁷⁵ See details here: <https://neWorkingGroupTlds.icann.org/en/about/trademark-clearinghouse/summary-iag-input-26sep12-en.pdf>

egregious registrations, as well as general information provided by Deloitte regarding their overall approach to vetting marks.

Neither of these very limited insights into the TMCH database provides anything close to a complete picture of how the TMCH is operating, and the overall landscape of marks which it contains. This lack of information makes effective oversight vastly more difficult, both by this Working Group and by interested third parties who otherwise might be keen to audit the operations of the TMCH, such as academics and civil society watchdog groups. Accountability would be vastly improved by a shift to a transparent database.

It is also worth noting that transparency is fundamental to ICANN's broader legitimacy as steward of a global public resource. Article 3 of ICANN's bylaws, which focuses specifically on transparency, opens with a statement that "ICANN and its constituent bodies shall operate to the maximum extent feasible in an open and transparent manner". Maintaining the TMCH as a secret database is incongruent with the organization's broader commitment to and interest in promoting transparency and openness in its operations.

2. The commercial information contained within the TMCH is already effectively public.

In order to register a mark in the TMCH, it must already be registered in a national trademark database, almost all of which are open by default. In other words, trademarks are not secret or commercially confidential information, since the companies have already publicly identified their commercial interest in the marks by submitting them to a national database. Any party who is interested enough to track a party's commercial strategy will already be able to obtain a complete picture of their portfolio by studying registrations in major national databases. However, while it is relatively easy to obtain information about a particular company through surveying the different databases, these databases do not provide a complete or consolidated picture of the state of trademark claims in the domain name space. For example, existing public information would not allow a potential new entrant to differentiate between claims which are not actively enforced online. In other words, while the commercially sensitive aspects of this data are minimal, there is a significant utility in its publication for legitimate uses.

3. There are important public interest reasons why trademark databases are open.

Beyond merely promoting accountability, there are important public interest reasons why trademark databases are kept public which apply equally to the TMCH. For starters, letting the public see which marks have been "claimed" builds greater reliability and consistency into the system, allowing start-ups to build their brand in a way that will avoid future conflicts. A trademark database which is kept secret also defeats one of the core purposes of trademark law, namely in allowing consumers to associate a particular product with its commercial source. The public nature of this association is the entire point, as there would be little consumer benefit from a "secret" trademark.

Working Group Deliberation: The Working Group had sharply diverging opinions on whether the TMCH Database should remain confidential or become open and searchable. Several Working Group members noted that, while general transparency and openness may be beneficial to

good faith actors (e.g. informing them what domain names they should avoid registering ahead of receiving a Claims Notice), they also thought that rights-holders may have legitimate reasons for wanting to keep the TMCH Database closed, including the risk of thereby disclosing commercially sensitive information such as trademark value and brand strategies.

On the other hand, Working Group members who supported this proposal thought that allowing the TMCH Database to be searchable could yield information that may be used to flag trademarks that ought not to have been included, e.g. via objection proceedings initiated with the TMCH Validation Service Provider.

5 Additional Marketplace Rights Protection Mechanisms

5.1 Deliberations of Additional Marketplace RPMs

In addition to the ICANN-mandated RPMs (i.e. Sunrise and Trademark Claims services offered through the TMCH, the Uniform Rapid Suspension System and the Trademark Post-Delegation Dispute Resolution Procedure), the Working Group discussed a number of additional rights protection mechanisms that several Registry Operators and the TMCH Validation Service Provider had voluntarily adopted, separate from and in addition to ICANN's requirements.

The Working Group's purpose in looking at these additional marketplace RPMs was not to conduct a policy review, which would have been outside the scope of this PDP. Rather, the Working Group sought to understand the nature and mechanics of these additional mechanisms, as its Charter mandated that the Working Group consider the interplay between the mandatory RPMs, their collective fulfillment of their intended purpose, and their aggregate sufficiency. This necessarily required the working group to have an appreciation of the wider RPM landscape.

In May 2017, in preparation for the Working Group's discussions about the additional marketplace RPMs, the Working Group Co-Chairs prepared an initial set of questions that were further refined by an Additional Marketplace RPMs Sub Team. The Sub Team's final set of proposed questions were submitted to the full Working Group in September 2017.

Following the GNSO Council's approval of a funding request for professional surveys to be conducted on the Sunrise and Trademark Claims services, the Working Group set up a new RPM Data Sub Team to conduct preparatory work for those surveys. The RPM Data Sub Team reviewed the discussions about the additional marketplace RPMs and used relevant information derived from them to formulate guidance for Analysis Group, who had been contracted to conduct the Sunrise and Trademark Claims surveys in 2018.

6 Next Steps

6.1 Next Steps

Following its analysis of public comments received on this Initial Report, the Working Group will develop its final recommendations in a Final Report to be sent to the GNSO Council for review and approval.

The Working Group’s Charter includes several general, overarching questions as well as a number of additional questions that the Working Group is expected to address at the conclusion of Phase 1 or Phase 2 of its work, as appropriate. During the public comment proceeding for this Initial Report, the Working Group also invites input for three (3) general and three (3) additional overarching Charter questions⁷⁶, which may help inform its overall work toward the Final Report.

General Overarching Charter Questions	
#1	Q1. Do the RPMs collectively fulfil the objectives for their creation, namely “to provide trademark holders with either preventative or curative protections against cybersquatting and other abusive uses of their legally-recognized trademarks? In other words, have all the RPMs, in the aggregate, been sufficient to meet their objectives or do new or additional mechanisms, or changes to existing RPMs, need to be developed?
#2	Q2a. Should any of the New gTLD Program RPMs (such as the URS), like the UDRP, be Consensus Policies applicable to all gTLDs? Q2b. If so, what are the transitional issues that would have to be dealt with as a consequence?
#3	Q3a. Will changes to one RPM need to be offset by concomitant changes to the others? Q3b. If so, to what extent?
Additional Overarching Charter Questions	
#1	Q1. Do the RPMs adequately address issues of registrant protection (such as freedom of expression and fair use)?
#2	Q2. Is the recent and strong ICANN work seeking to understand and incorporate Human Rights into the policy considerations of ICANN relevant to the UDRP or any of the RPMs?
#3	Q3. How can costs be lowered so end users can easily access RPMs?

⁷⁶ There were other Additional Questions in the original PDP Charter that were subsumed into the Working Group’s discussions over specific RPMs and, as such, these have not been reproduced here.

In addition, based on an early suggestion from one of its Sub Teams, the Working Group is expected to consider the following general question related to the additional marketplace RPMs: “How, and to what extent, does use of Protected Marks Lists (e.g. blocking services) affect the utilization of other RPMs, especially Sunrise registrations?” This question is related to the General Charter Question #1 as described above.

Once the Working Group has considered all the public comments received and considered the above questions, the Co-Chairs will conduct a formal consensus call, at the plenary level, on all the proposed final PDP recommendations before the WG issues its Final Report. If adopted by the GNSO Council, the Final Report will then be forwarded to the ICANN Board of Directors for its consideration and, potentially, approval as an ICANN Consensus Policy.

7 Background

7.1 Issue Background

7.1.1 Issue Overview

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 procedure⁷⁷. In general, community feedback to date 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 sought⁷⁸.

As a result of the 2012 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 and the Trademark Claims Services, and the Trademark Post-Delegation Dispute Resolution Procedures (TM-PDDRP)⁷⁹.

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”

⁷⁷ For a complete background overview on the development of the UDRP, see UDRP Report, pp.7-9:

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

⁷⁸ 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 0.1% 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.

⁷⁹ For a complete background overview on the development of these rights protection mechanisms, see the RPM Staff Paper, pp.15-19: <https://www.icann.org/publiccomments/rpm-review-2015-02-02-en>.

mechanisms), the TMCH and the services provided using TMCH-verified data such as Sunrise and Trademark Claims are intended to facilitate trademark 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 UDRP⁸⁰. The recommended course of action in that UDRP Report was not to initiate a Policy Development Process (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 requested⁸¹ that ICANN staff prepare and publish a new 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. As a result of that GNSO Council request, the Final Issue Report on a PDP to Review All RPMs in All gTLDs⁸² was published on 11 January 2016.

7.1.2 Trademark Clearinghouse (TMCH) Background

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 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 currently 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)⁸³.

⁸⁰ Download the report here: https://gns0.icann.org/sites/default/files/filefield_27051/udrp-final-issue-report-03oct11-en.pdf

⁸¹ See the GNSO Council resolution related to the request here: <https://gns0.icann.org/en/council/resolutions#201112>

⁸² Download the report here: https://gns0.icann.org/sites/default/files/filefield_48411/rpm-final-issue-11jan16-en.pdf

⁸³ 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.

Learn More: <https://newgtlds.icann.org/en/applicants/agb/trademark-clearinghouse-04jun12-en.pdf>

7.1.3 Sunrise Service Background

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 Paper⁸⁴ 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 Sunrise⁸⁵.

New gTLD Registry Operators are also obliged to maintain a Sunrise Dispute Resolution Policy (SDRP), 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.

7.1.4 Trademark Claims Service Background

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 rights⁸⁶." Should the notified

⁸⁴ In February 2015, ICANN staff published a draft Rights Protection Mechanisms Review report to solicit community feedback. This report was not a comprehensive review; rather, it was based primarily on community feedback and a small set of sources, including specific topic studies, obligatory reports from Contracted Parties or contractors hired for specific projects, and community comments. See additional details in the "Related Work by the GNSO, the ICANN Community, and the ICANN org" sub section in this section of the Initial Report.

⁸⁵ RPM Staff Paper, p.54.

⁸⁶ RPM Staff Paper, p.75.

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.

Learn More: <http://newgtlds.icann.org/en/about/trademark-clearinghouse/rpm-requirements-30sep13-en.pdf>

7.1.5 Uniform Rapid Suspension System (URS) Background

The URS was designed as a complement to the UDRP⁸⁷, 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 UDRP⁸⁸.

Much like the UDRP, trademark holders may initiate a URS proceeding by electronically filing a Complaint with a URS Provider⁸⁹. 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 year⁹⁰.

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 his/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.

Learn More:

- URS Rules: <https://newgtlds.icann.org/en/applicants/urs/rules-28jun13-en.pdf>

⁸⁷ 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: 1) the Policy that sets out its scope, relief, and basis for mandatory administrative proceedings that may be brought within its ambit; and 2) the Rules that set out the procedural requirements that must be followed in such a proceeding. For additional details, see the RPM PDP Final Issue Report, p11:

https://gnso.icann.org/sites/default/files/filefield_48411/rpm-final-issue-11jan16-en.pdf

⁸⁸ For a side-by-side comparison of the URS and the UDRP, see RPM Staff Paper, p.92-99.

⁸⁹ Currently there are three URS Providers: ADNDRC, FORUM, and MFSD.

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

- URS Procedure: <https://newgtlds.icann.org/en/applicants/urs/procedure-01mar13-en.pdf>

7.1.6 Trademark Post-Delegation Dispute Resolution Procedures (TM-PDDRP) Background

Three new dispute resolution procedures were developed for the 2012 New gTLD Program: the Registration Restrictions Dispute Resolution Procedure (RRDRP), the Public Interest Commitments Dispute Resolution Procedure (PIC-DRP), and the Trademark Post-Delegation Dispute Resolution Procedure (TM-PDDRP). Unlike the UDRP and URS, these are dispute resolution processes 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 TM-PDDRP is intended to address trademark-related issues in the registry; the RRDRP and the PIC-DRP were not specifically designed as RPMs for the same purpose, although they can serve this function in certain limited circumstances⁹¹.

The TM-PDDRP generally addresses a Registry Operator's complicity in trademark infringement on the first or second level of a New gTLD. At least 30 days prior to filing a formal Complaint, a rights holder must notify the Registry of the alleged infringing conduct and express a willingness to meet to resolve the issue.

Learn More:

- TM-PDDRP Rules: <http://newgtlds.icann.org/en/applicants/agb/pddrp-rules-15oct13-en.pdf>
- TM-PDDRP Procedure: <http://newgtlds.icann.org/en/applicants/agb/pddrp-04jun12-en.pdf>

7.1.7 Additional Marketplace Rights Protection Mechanisms Background

In addition to the RPMs that ICANN mandated in the course of the development of the Applicant Guidebook for the 2012 New gTLD Program, several Registry Operators and the TMCH Validation Service Provider voluntarily adopted additional RPMs for those gTLDs they managed or provided services for, that collectively extend the scope of trademark rights protection beyond ICANN's mandatory RPMs. The Working Group agreed to use the phrase "additional marketplace RPMs" to describe these mechanisms.

Some examples of the additional marketplace RPMs include:

- **Protected Marks Lists:** This protection mechanism was first launched by Registry Operator Donuts Inc. It allows trademark holders, as confirmed by the TMCH Database, to block registrations for strings consisting of or containing their brand name or trademark across of the Registry Operator's gTLDs⁹².

⁹¹ RPM Staff Paper, p.111-112.

⁹² For example, see: <http://www.donuts.co/dpml/dpml-overview/>

- **Perpetual Block:** This mechanism allows a registered trademark holder to block any attempts to register a trademarked domain within a particular TLD by making a one time payment. For example, ICM Registry provides a perpetual blocking option in its .xxx domain space⁹³.

7.2 Process Background

7.2.1 Process Overview

On 18 February 2016, the GNSO Council initiated⁹⁴ the PDP on the Review of All RPMs in All gTLDs. On 15 March 2016, the GNSO Council chartered⁹⁵ the PDP Working Group to conduct a review of all Rights Protection Mechanisms (RPMs) in all gTLDs in two phases. Phase 1 focuses on reviewing all the RPMs applicable to gTLDs launched under the 2012 New gTLD Program. Phase 2 will focus on reviewing the Uniform Dispute Resolution Policy (UDRP), which has been an ICANN Consensus Policy since 1999. On 21 April 2016, the Working Group held its first meeting to commence its Phase 1 work and has been meeting regularly since that time.

The Working Group's Charter, as approved by the GNSO Council, maps out the deliverables expected in each phase of work and notes the need for the Working Group to track and if appropriate, coordinate its work with other relevant efforts underway (e.g. the Competition, Consumer Trust & Consumer Choice (CCT) Review Team and the GNSO's New gTLD Subsequent Procedures PDP).

In addition, the Charter contains a list of specific topics and questions that were reproduced verbatim from previous ICANN community consultations on the topic of RPMs. This led to the Working Group agreeing, early on in its work, that it would first need to refine these original Charter questions so as to clarify their intent and ensure that the PDP discussions remain objective and neutral.

Finally, the Charter also includes several general, overarching questions as well as a number of additional questions that the Working Group is expected to address at the conclusion of Phase 1 or Phase 2 of its work, as appropriate. These overarching Charter questions are described in the "Next Steps" section of this Initial Report.

7.2.2 Process Milestones

- On 11 January 2016, ICANN organization (ICANN org) published the Final Issue Report on Policy Development Process to Review All Rights Protection Mechanisms (RPMs) in All Generic Top Level Domains. In the Final Issue Report, ICANN org recommended that the GNSO Council commence a policy development process (PDP) to conduct the policy review

⁹³ <https://adultblock.icmregistry.com/>

⁹⁴ See the approved GNSO Council motion initiating the PDP here:
<https://gns0.icann.org/en/council/resolutions#201602>

⁹⁵ See the approved GNSO Council motion chartering the PDP Working Group here:
<https://gns0.icann.org/en/council/resolutions#201603>

of all the RPMs in two phases -- Phase 1 being a review of the RPMs developed for the New gTLD Program and Phase 2 of work a review of the UDRP.

- On 18 February 2016, the GNSO Council initiated the PDP.
- On 15 March 2016, the GNSO Council approved the Charter for the Working Group.
- On 21 March 2016, a Call for Volunteers for the Working Group was issued.
- On 21 April 2016, the Working Group held its first meeting, with Philip Corwin, the initial GNSO Council liaison, acting as the interim Working Group Chair.
- On 24 May 2016, the GNSO Council confirmed the appointment of Kathy Kleiman, Philip Corwin, and J. Scott Evans⁹⁶ as Working Group Co-Chairs, and confirmed the appointment of Paul McGrady as the GNSO Council Liaison to the PDP Working Group.
- On 28 May 2016, the Working Group sent outreach letters to solicit early input from each GNSO Stakeholder Group and Constituency and other Supporting Organizations and Advisory Committees.
- In November 2016, the Working Group completed its review of the TM-PDDRP.
- On 6 April 2018, the Working Group completed its initial review of the additional marketplace RPMs.
- On 24 May 2018, the GNSO Council confirmed the appointment of Brian Beckham as an additional Co-Chair, succeeding J. Scott Evans, to join existing Co-Chairs Philip Corwin and Kathy Kleiman.
- On 24 July 2019, the Working Group completed its initial review of the Sunrise and Trademark Claims services.
- On 23 October 2019, the Working Group completed its review of the structure and scope of the TMCH.
- On 6 November 2019, the GNSO Council appointed John McElwaine as the GNSO Council Liaison to the PDP Working Group, replacing Paul McGrady who was term-limited as a GNSO Councillor.
- On 15 January 2020, the Working Group concluded its review of the URS.
- On 4 March 2020, the GNSO Council approved a Project Change Request submitted by the Working Group, reflecting a revised 9th work plan that projects the submission of the Phase 1 Final Report by mid-October 2020.
- On 11 March 2020, the Working Group completed its review of its draft Phase 1 Initial Report with the objective of publishing it for public comment by 18 March 2020.

7.2.3 TM-PDDRP Review Process

- In June 2016, the Working Group commenced its review of the TM-PDDRP, having agreed that this should be the first RPM that it would review for Phase 1 of this PDP.

⁹⁶ J. Scott Evans resigned as Co-Chair effective 02 March 2018.

- In August 2016, The Working Group surveyed the three TM-PDDRP Providers and, based on Working Group discussions of the initial responses received, sought additional feedback from the Providers.
- In September-October 2016, the Working Group discussed a number of potential modifications to the procedure, but due to the fact that no Complaint had been filed, agreed that it was premature to propose substantive changes.
- In November 2016, the Working Group completed its initial review of the TM-PDDRP. It tasked a small team of Working Group volunteers to develop a specific recommendation for a procedural modification to the procedure.
- In January 2017, the small team met to discuss and agree on the procedural modification, which concerned the filing of a joint Complaint by several trademark holders and the consolidation of multiple Complaints against a single Registry Operator.
- In March 2020, the Working Group agreed to publish this specific preliminary recommendation for public comment in this Initial Report.

7.2.4 TMCH Review Process

- In November 2016, a survey developed by the Working Group's TMCH Data Gathering Sub Team was distributed to Registry Operators, Registrars and the TMCH Validation Service Provider (Deloitte). Three Registry Operators responded to the survey.
- In December 2016, the TMCH Charter Questions Sub Team completed its work of refining the original TMCH related Charter questions and suggested that the refined questions be grouped into specific categories to facilitate deliberations.
- In March 2017, the Working Group met with Deloitte during the ICANN58 Copenhagen meeting. The Working Group subsequently followed up with Deloitte on a number of data points.
- In July 2017, following initial discussions about specific proposals that had been submitted by individual Working Group members about certain aspects of the TMCH, the Working Group decided to defer further discussions on these topics until it had completed an initial review of the Sunrise and Trademark Claims services.
- On 23 October 2019, the Working Group completed its review of the structure and scope of the TMCH. It agreed on one preliminary recommendation and agreed to publish seven (7) proposals submitted by individual Working Group members, that at this time had not attained sufficient support to be considered Working Group preliminary recommendations, in this Initial Report for public comment.

7.2.5 Sunrise & Trademark Claims Services Review Process

- In March 2017, the Working Group formed a Sunrise Charter Questions Sub Team and a Trademark Claims Charter Questions Sub Team to refine the original Charter Questions.
- Between April-July 2017, the Working Group discussed a report on an Independent Review of TMCH Services that had been prepared by the Analysis Group and commissioned by

ICANN org based on a recommendation from the Governmental Advisory Committee (GAC). During this time, the Working Group also met with representatives of the Analysis Group to discuss the report.

- In July 2017, following completion of work by its two Sub Teams, the Working Group began to develop a funding request to seek resources for professional surveys it believed were needed, in order to obtain data critical to reviewing the Sunrise and Trademark Claims services. The GNSO Council approved this data request in September 2017.
- In August 2017, as part of its data analysis work, the Working Group reviewed the results of the INTA Cost Impact Survey that had been conducted as part of the CCT Review.
- In October 2017, a new RPM Data Sub Team began to develop guidance, based on the Working Group's identified data needs and the work done to date, for the vendor to develop surveys. These surveys were intended to obtain quantitative and anecdotal evidence from several different target groups (e.g. Registry Operators, Registrars, Trademark and Brand Owners, and Actual and Potential Registrants) related to the Sunrise and Trademark Claims services.
- In May 2018, the Analysis Group, which had been selected by ICANN org as the survey vendor through ICANN org's Request For Proposal process, began working with the RPM Data Sub Team to finalize the surveys.
- In October 2018, at ICANN63 in Barcelona, the Analysis Group presented its findings from the surveys. The Working Group subsequently formed a Sunrise Data Review Sub Team and a Trademark Claims Data Review Sub Team to: 1) analyze the Sunrise and Trademark Claims related data collected to date, and 2) propose preliminary recommendations for consideration by the full Working Group.
- In July 2019, the Working Group endorsed the Sub Team-proposed preliminary recommendations for Sunrise and Trademark Claims.

7.2.6 Additional Marketplace RPMs Review Process

- In May 2017, the Working Group Co-Chairs proposed an approach by which the Working Group could discuss and understand the scope and mechanics of the various additional marketplace RPMs that were being offered by a number of Registry Operators and Deloitte, the current TMCH Validation Service Provider. The Working Group agreed to form a Sub Team that would review the Co-Chairs' proposed questions and propose a refined set of questions to the full Working Group.
- In September 2017, the Additional Marketplace RPMs Sub Team submitted a final set of proposed questions for the Working Group to consider.
- Also in September 2017, the GNSO Council approved the Working Group's request to contract with a professional services firm to conduct surveys relating to the Sunrise and Trademark Claims services offered through the TMCH. The Working Group formed the RPM Data Sub Team to develop specific guidance for the survey provider.
- In March 2018, the RPM Data Sub Team discussed the work that had been done to date on the additional marketplace RPMs and agreed that most of the questions were already subsumed into the work for the Sunrise and Trademark Claims surveys.

- In April 2018, the RPM Data Sub Team agreed that any remaining questions about the additional marketplace RPMs questions, which the Working Group concludes to have not been addressed by the outcomes of the Sunrise and Trademark Claims surveys, could be sent to Deloitte for additional follow up. In addition, the Sub Team suggested that, following the completion of its review of the Sunrise and Trademark Claims RPMs, the Working Group consider this question: “How, and to what extent, does use of Protected Marks Lists (e.g. blocking services) affect the utilization of other RPMs, especially Sunrise registrations?” This question has been placed in the “Next Steps” section as a topic for the Working Group to return to, following its review of all public comments to this Initial Report⁹⁷.

7.2.7 URS Review Process

- In December 2017, the Working Group agreed to commence the URS review by grouping the original Charter questions into a list of specific sequential topics. The Working Group also agreed to apply a standard set of high level questions to the review, as a framework for evaluating and developing preliminary recommendations for the URS.
- In February 2018, three URS Sub Teams (i.e. URS Providers, URS Practitioners, and URS Documents Sub Teams) began their work. The URS Providers and URS Practitioners Sub Teams were tasked to develop, administer, and analyze results of surveys for the current URS Providers and experienced URS Practitioners. The URS Documents Sub Team was tasked with 1) identifying various data sources in addition to what would be sought from the URS providers and practitioners, 2) reviewing and examining specific categories of URS cases, and 3) developing potential recommendations for full Working Group consideration.
- In May 2018, Professor Rebecca Tushnet, a member of the Working Group, presented her individual analysis of URS cases to the Working Group.
- In August 2018, the three Sub Teams discussed their preliminary findings/issues with the full Working Group, as well as their proposals for recommendations and operational fixes and proposed questions for community input. Individual Working Group members were also invited to submit proposals for consideration by the Working Group, in addition to the proposals developed by the three Sub Teams.
- In October 2018 during the ICANN63 Barcelona meeting, the Working Group completed its initial review of the URS, including its initial deliberation on the thirty-four (34) proposals from its three Sub Teams and thirty-six (36) proposals submitted by individual Working Group members. It subsequently conducted a survey to assess the level of support for

⁹⁷ This question is related to one of the three (3) general overarching Charter questions -- “General Overarching Charter Question #1: Do the RPMs collectively fulfil the objectives for their creation, namely “to provide trademark holders with either preventative or curative protections against cybersquatting and other abusive uses of their legally-recognized trademarks? In other words, have all the RPMs, in the aggregate, been sufficient to meet their objectives or do new or additional mechanisms, or changes to existing RPMs, need to be developed?” The Working Group’s Charter includes several general, overarching questions as well as a number of additional questions that the Working Group is expected to address at the conclusion of Phase 1 or Phase 2 of its work, as appropriate. During the public comment proceeding for the Initial Report, the Working Group also invites input for these overarching Charter questions, which may help inform its overall work toward the Final Report.

including each of these individually-submitted proposals in the Initial Report for community input.

- Subsequently, in November 2019 during the ICANN66 Montréal meeting, the Working Group agreed that it would need to: 1) conclude its initial review of the URS procedure; 2) consolidate or otherwise finalize the Sub Team proposals to formulate the Working Group preliminary recommendations; and 3) narrow down the number of individual proposals for inclusion in the Initial Report. This work was completed in December 2019 for the Sub Team proposals and January 2020 for the individual proposals.

7.3 Related Work by the GNSO, the ICANN Community, and the ICANN Organization

7.3.1 Related Work Prior to the Initiation of this PDP

Prior to the initiation of this PDP, the GNSO and ICANN org had worked on a number of activities that formed part of the background materials for the scoping and chartering of this PDP.

Implementation Review Team (2009)

On 6 March 2009, the GNSO Intellectual Property Constituency formed the Implementation Review Team (IRT) in accordance with a 6 March, 2009 ICANN Board resolution. The objective of the IRT was to develop potential, practicable solutions for trademark protections as part of the implementation work for the 2012 New gTLD Program.

The IRT published its Final Report⁹⁸ on 29 May 2009, including recommendations for several proposed solutions with respect to:

- An IP Clearinghouse, a Globally Protected Marks List and associated RPMs, and standardized pre-launch rights protection mechanisms such as Sunrise and an IP Claims service;
- A dispute resolution procedure modeled on the UDRP;
- PDDRs;
- Whois requirements for new TLDs; and
- Use of algorithm in string confusion review during initial evaluation.

Special Trademark Issues Review Team (2009)

On 12 October 2009, the ICANN Board sent a letter to the GNSO Council requesting its view on the trademark protection mechanisms that were being proposed for the New gTLD Program. In response, on 28 October 2009 the GNSO Council created the Special Trademarks Issues (STI) Review Team, which included representatives from each Stakeholder Group, the At-Large community, Nominating Committee Appointees, and the Governmental Advisory Committee (GAC). The STI was directed to analyze the staff implementation models of the TMCH and URS that were proposed for inclusion in the Draft Application Guidebook Version 3. On 11 December 2009, the STI Review Team delivered its Report⁹⁹ to the GNSO Council describing an alternative

⁹⁸ See <https://archive.icann.org/en/topics/new-gtlds/irt-final-report-trademark-protection-29may09-en.pdf>

⁹⁹ See <https://gns0.icann.org/issues/sti/sti-wt-recommendations-11dec09-en.pdf>

proposal to address trademark concerns in the New gTLD Program that was supported by a consensus of its members.

On 17 December 2009, the GNSO Council approved the overall package of recommendations contained in the STI Report. The GNSO Council also directed ICANN staff to publish the STI recommendations for public comment. In March 2010, the ICANN Board passed a resolution directing ICANN staff to analyze the public comments and develop final versions of the TMCH and URS, to be included in version 4 of the Draft Applicant Guidebook.

UDRP Issue Report (2011)

The UDRP has been the subject of a previous GNSO Preliminary Issue Report, published in February 2011¹⁰⁰ prior to the delegation of the first gTLD under the New gTLD Program. 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 DNS¹⁰¹. The Final Issue Report¹⁰² was published in October 2011 and its primary conclusion was that a review of the UDRP should not be conducted until 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 UDRP¹⁰³.

RPM Staff Paper (2015)

In February 2015, ICANN staff published a draft Rights Protection Mechanisms Review report to solicit community feedback¹⁰⁴, with the aim of assessing their operational effectiveness to date and to identify topics and areas that can inform future policy work. In September 2015, ICANN staff published a revised Rights Protection Mechanism Report (RPM Staff Paper) following its review of community comments received¹⁰⁵. The community’s suggestions and questions were incorporated into the Final Issue Report for this PDP.

7.3.2 Related Work After the Initiation of this PDP

Under its Charter, the Working Group is required, among other tasks, to take into consideration the work/outcome of the TMCH Independent Review, the CCT Review, and any other relevant GNSO policy development processes, including the EPDP on the Temporary Specification for gTLD Registration Data.

Independent Review of the TMCH (2017)

¹⁰⁰ See <https://www.icann.org/resources/pages/prelim-report-udrp-2011-05-27-en>

¹⁰¹ See the Final Issue Report on the Current State of the UDRP (October 2011), Section 5.

¹⁰² https://gns0.icann.org/sites/default/files/filefield_27051/udrp-final-issue-report-03oct11-en.pdf

¹⁰³ See the Final Issue Report on the Current State of the UDRP, p.31.

¹⁰⁴ The initial staff paper, public comments, and revised staff paper can be viewed here: <https://newgtlds.icann.org/en/reviews/cct/rpm>

¹⁰⁵ See <https://www.icann.org/news/announcement-2015-09-11-en>

In 2016, based on a recommendation from the GAC¹⁰⁶, ICANN commissioned the Analysis Group to conduct an independent review of the TMCH¹⁰⁷. The firm examined whether domains that relate to, but do not exactly match, trademarks should be considered for use in the Claims period of a new gTLD's lifecycle. The review also explored whether extending the number of days of the Claims service would be of value, as well as measured how frequently trademark holders use the Sunrise period, among other topics. The review identified some additional related topics that could be addressed as part of ICANN's policy development work. As noted above, in 2017 the Working Group met with the Analysis Group and reviewed the report.

Competition, Consumer Trust and Consumer Choice Review Team (2018)

ICANN's CCT-RT conducted a review of the new gTLD program, monitoring and assessing issues of competition, consumer protection, security, stability, malicious abuse, and rights protection for the new gTLDs. As part of its review, the CCT-RT examined the impact of new gTLDs on brand owners, specifically the cost and effort required to protect and police trademarks¹⁰⁸.

The CCT-RT ultimately directed the following recommendations, which are published in its Final Report on 8 September 2018, to the RPM PDP Working Group:

- **Recommendation #9:** "The ICANN community should consider whether the costs related to defensive registration for the small number of brands registering a large number of domains can be reduced."
- **Recommendation #27:** "Since the Review Team's initial draft recommendation, the PDP Review of All RPMs in All gTLDs Working Group started reviewing the URS in detail and, at the time of writing, their review is ongoing. Given this ongoing review, the Review Team recommends that the Working Group continue its review of the URS and also looks into the interoperability of the URS with the UDRP. The review team encountered a lack of data for complete analysis. The PDP Review of All RPMs appears to also be encountering this issue and this may well prevent it from drawing firm conclusions. If modifications are not easily identified, then the CCT Review Team recommends continued monitoring until more data is collected and made available for review at a later date."
- **Recommendation #28:** "A cost-benefit analysis and review of the TMCH and its scope should be carried out to provide quantifiable information on the costs and benefits associated with the present state of the TMCH services, and thus to allow for an effective policy review. Since the review team's initial draft recommendation, the PDP Review of All RPMs in All gTLDs Working Group has started reviewing the TMCH in detail and ICANN has appointed Analysis Group to develop and conduct the survey(s) to assess the use and effectiveness of the Sunrise and Trademark Claims RPMs. Provided that the PDP Working Group has sufficient data from this survey or other surveys and is able to draw firm conclusions, the review team does not consider that an additional review is necessary."

¹⁰⁶ See the GAC recommendations on page 5-8: <https://archive.icann.org/en/topics/new-gtlds/gac-comments-new-gtlds-26may11-en.pdf>

¹⁰⁷ The revised report of the independent review is available for download via: <https://newgtlds.icann.org/en/reviews/tmch/revised-services-review-22feb17-en.pdf>

¹⁰⁸ The CCT-RT Final Report can be found via: <https://www.icann.org/en/system/files/files/cct-final-08sep18-en.pdf>. The sections related to Trademark / RPMs are from pp.10-12, 15, 22-24, 72, 125-140.

However, the CCT Review Team reiterates its recommendation for a cost-benefit analysis to be carried out if such analysis can enable objective conclusions to be drawn. Such cost-benefit analysis should include, but not necessarily be limited to, looking at cost-benefits of the TMCH for brand owners, registries, and registrars now and going forward, as well as examine the interplay of the TMCH with premium pricing.”

In relation to CCT Recommendation #9, during its deliberations on the Sunrise and Trademark Claims RPMs, the Working Group agreed that matters of pricing are outside the scope of this PDP.

In relation to CCT Recommendation #27, the Working Group agrees that the lack of comprehensive data made it difficult to conduct the initial URS review. However, it was able to collect and analyze sufficient data -- through a combination of surveys, staff summaries of URS cases and metrics, and the URS case analysis of Professor Rebecca Tushnet (a Working Group member) -- to develop a series of preliminary recommendations for the URS. Please refer to the “Deliberations of URS” and “Approach Taken by the Working Group” sections for further details. The Working Group is likely to consider the question of interoperability between the URS and UDRP as part of its Phase 2 work.

In relation to CCT Recommendation #28, the Working Group relied largely on Analysis Group’s TMCH independent review, survey results, interactions with the TMCH Validation Service Provider, and information from a few Registry Operators for both quantitative and anecdotal data. It did not consider if necessary, nor did it have the resources, to conduct a full cost-benefit analysis of the TMCH. Nevertheless, the Working Group was able to develop a number of TMCH-related recommendations (including recommendations related to the Sunrise and Trademark Claims services offered through the TMCH) and is also presenting a few proposals submitted by individual Working Group members in this Initial Report for community input. Please refer to the “Deliberations of the Working Group” and “Individual Proposals for Trademark Clearinghouse” sections of this Initial Report for further details.

EPDP on Temporary Specification for gTLD Registration Data (2018-Present)

On 17 May 2018, the ICANN Board approved the Temporary Specification for gTLD Registration Data to facilitate compliance by ICANN’s contracted parties with existing ICANN contractual requirements as well as the European Union’s General Data Protection Regulation (GDPR). The adoption of the Temporary Specification triggered the requirement for the GNSO to complete a consensus PDP within one year. On 19 July 2018, the GNSO Council initiated the EPDP on the Temporary Specification for gTLD Registration Data, to be conducted in two phases.

On 15 May 2019, the ICANN Board adopted most of the EPDP Phase 1 policy recommendations in its Final Report¹⁰⁹. The GNSO Council referred the following RPM-related recommendations to the Working Group in July 2019:

¹⁰⁹ See the EPDP Phase 1 Final Report here: <https://gnso.icann.org/sites/default/files/file/field-file-attach/epdp-gtld-registration-data-specs-final-20feb19-en.pdf>

-
- **Recommendation #21:** “The EPDP Team also recommends that the GNSO Council instructs the review of all RPMs PDP WG to consider, as part of its deliberations, whether there is a need to update existing requirements to clarify that a Complainant must only be required to insert the publicly-available RDDS data for the domain name(s) at issue in its initial Complaint. The EPDP Team also recommends the GNSO Council to instruct the RPMs PDP WG to consider whether upon receiving updated RDDS data (if any), the Complainant must be given the opportunity to file an amended Complaint containing the updated respondent information.”
 - **Recommendation #23:** “The EPDP Team recommends that, for the new policy on gTLD registration data, the following requirements MUST apply in relation to URS and UDRP until such time as these are superseded by recommendations from the RPMs PDP WG and/or policies from the EPDP regarding disclosure:
 - Uniform Rapid Suspension (supplemental requirements for the 17 October 2013 URS High Level Technical Requirements for Registries and Registrars and URS Rules effective 28 June 2013)
 - (1) Registry Operator Requirement: The Registry Operator (or appointed BERO) MUST provide the URS Provider with the full Registration Data for each of the specified domain names, upon the URS Provider notifying the Registry Operator (or appointed BERO) of the existence of a Complaint, or participate in another mechanism to provide the full Registration Data to the Provider as specified by ICANN. If the gTLD operates as a "thin" registry, the Registry Operator MUST provide the available Registration Data to the URS Provider.
 - (2) Registrar Requirement: If the domain name(s) subject to the Complaint reside on a "thin" registry, the Registrar MUST provide the full Registration Data to the URS Provider upon notification of a Complaint.
 - (3) URS Rules: Complainant's Complaint will not be deemed defective for failure to provide the name of the Respondent (Registered Name Holder) and all other relevant contact information required by Section 3 of the URS Rules if such contact information of the Respondent is not available in registration data publicly available in RDDS or not otherwise known to Complainant. In such an event, Complainant may file a Complaint against an unidentified Respondent and the Provider shall provide the Complainant with the relevant contact details of the Registered Name Holder after being presented with a Complaint against an unidentified Respondent.
 - Uniform Dispute Resolution Policy (supplemental requirements for the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"))
 - (1) Registrar Requirement: The Registrar MUST provide the UDRP Provider with the full Registration Data for each of the specified domain names, upon the UDRP Provider notifying the Registrar of the existence of a Complaint, or participate in another mechanism to provide the full Registration Data to the Provider as specified by ICANN.
 - (2) Complainant's Complaint will not be deemed defective for failure to provide the name of the Respondent (Registered Name Holder) and all other relevant contact information required by Section 3 of the UDRP Rules if such contact
-

information of the Respondent is not available in registration data publicly available in RDDS or not otherwise known to Complainant. In such an event, Complainant may file a Complaint against an unidentified Respondent and the Provider shall provide the Complainant with the relevant contact details of the Registered Name Holder after being presented with a Complaint against an unidentified Respondent.”

- Recommendation #27: “The EPDP Team recommends that as part of the implementation of these policy recommendations, updates are made to the following existing policies / procedures, and any others that may have been omitted, to ensure consistency with these policy recommendations as, for example, a number of these refer to administrative and/or technical contact which will no longer be required data elements:

- Registry Registration Data Directory Services Consistent Labeling and Display Policy
- Thick WHOIS Transition Policy for .COM, .NET, .JOBS
- Rules for Uniform Domain Name Dispute Resolution Policy
- WHOIS Data Reminder Policy
- Transfer Policy
- Uniform Rapid Suspension System (URS) Rules
- Transfer Dispute Resolution Policy

Please refer to the URS Recommendation #1 and URS Question #1 in the “Deliberations of URS” section of this Initial Report for the Working Group’s initial conclusions regarding these EPDP Phase 1 recommendations.

8 Approach Taken by the Working Group

8.1 Working Methodology

The Working Group began its deliberations on 21 April 2016. It decided to conduct its work primarily through weekly conference calls, in addition to email exchanges on its mailing list, with further discussions taking place at ICANN Public Meetings when scheduled. All the Working Group's meetings are documented on its wiki workspace¹¹⁰, including its mailing list archive¹¹¹, draft documents, background materials, and input received from across the ICANN community.

The Working Group also prepared a Work Plan¹¹², which was reviewed and updated on a periodic basis. In accordance with the GNSO's PDP Manual, the Working Group solicited early input from ICANN's Supporting Organizations (SOs)/Advisory Committees (ACs) and the GNSO's Stakeholder Groups and Constituencies, and considered all input received in response (please see the "Annex E - Community Input" section of this Initial Report for additional details). The Working Group also reviewed historical documentation relating to the development of the various RPMs during its deliberations¹¹³.

The Working Group scheduled community sessions at each ICANN Public Meeting that took place after its formation, at which it presented its preliminary findings and/or conclusions to the broader ICANN community for discussion and feedback.

8.2 Sub Teams

The Working Group employed Sub Teams as an efficient means of delegating topics or assignments to be completed and conducting the preliminary work. The Sub Teams: 1) refined the original Charter questions¹¹⁴; 2) gathered and reviewed data; 3) developed proposed answers to the final agreed Charter questions; 4) assessed proposals submitted by individual Working Group members; and/or 5) formulated preliminary recommendations for review by the full Working Group.

The full list of Sub Teams in the RPM Working Group is included below:

- TMCH Charter Questions: wiki - <https://community.icann.org/x/siK4Aw>, mailing list - <https://mm.icann.org/pipermail/gnso-rpm-tmch/>

¹¹⁰ <https://community.icann.org/x/wCWAaw>

¹¹¹ <https://mm.icann.org/pipermail/gnso-rpm-Working%20Group/>

¹¹² An archive of the Working Group's work plans can be found here: <https://community.icann.org/x/wBeOAw>

¹¹³ Much of the historical records, reports, papers, rules and procedures considered by the Working Group is listed on the Working Group's wiki space. See: <https://community.icann.org/x/4SWAAw>.

¹¹⁴ The original Charter questions which were reproduced in the PDP Charter by the GNSO Council from the unedited community questions submitted to previous ICANN work on RPMs.

- TMCH Data Gathering: wiki - <https://community.icann.org/x/UwSbAw>, mailing list - <https://mm.icann.org/pipermail/gnso-rpm-tmch/>
- RPM Data: wiki - <https://community.icann.org/x/e11EB>, mailing list - <https://mm.icann.org/pipermail/gnso-rpm-data/>
- Sunrise Charter Questions: wiki - <https://community.icann.org/x/yIIWBg>, mailing list - <https://mm.icann.org/pipermail/gnso-rpm-sunrise/>
- Sunrise Data Review: wiki - <https://community.icann.org/x/y4IWBg>, mailing list - <http://mm.icann.org/pipermail/gnso-rpm-sunrise/>
- Trademark Claims Charter Questions: wiki - <https://community.icann.org/x/psrRAw>, mailing list - <https://mm.icann.org/pipermail/gnso-rpm-trademark/>
- Trademark Claims Data Review: wiki - <https://community.icann.org/x/34IWBg>, mailing list - <http://mm.icann.org/pipermail/gnso-rpm-trademark/>
- URS Practitioners: wiki - <https://community.icann.org/x/xBW8B>, mailing list - <https://mm.icann.org/pipermail/gnso-rpm-practitioner/>
- URS Documents: wiki - <https://community.icann.org/x/zRW8B>, mailing list - <https://mm.icann.org/pipermail/gnso-rpm-documents/>
- URS Providers: wiki - <https://community.icann.org/x/1hW8B>, mailing list - <https://mm.icann.org/pipermail/gnso-rpm-providers/>
- Additional Marketplace RPMs: wiki - <https://community.icann.org/x/s8rRAw>, mailing list - <http://mm.icann.org/pipermail/gnso-rpm-protection/>

The work of and outcomes from using a Sub Team approach are the basis for much of the Working Group's preliminary recommendations and questions for community input that are published in this Initial Report for public comments.

8.3 Data Gathering and Review

As this PDP is the first time that the RPMs have been subject to a policy review by the ICANN community, to date there has not been comprehensive studies or data collected that measures their effectiveness. The Working Group agreed early on in its work that, in order to fulfill its Charter requirements and effectively review each of the Phase 1 RPMs, it would need to analyze any available data (including data reported by Registry Operators and the various service Providers to ICANN org, as it may have been required by their contracts or other arrangements with ICANN org) as well as gather and examine new data, particularly with respect to the usage of the RPMs that were developed for the 2012 New gTLD Program. Accordingly, the Working Group collected and analyzed data and input from a number of sources, including but not limited to the following items below.

Links to some of these data/input sources are included in the “Annex C - Working Group Documents” section of this Initial Report. For a complete record of data/input source documents and materials, please visit the Working Group wiki workspace¹¹⁵.

8.3.1 URS Data

- URS Rules, URS Procedure, URS Providers’ Supplemental Rules, URS Technical Requirements, and Memoranda of Understanding (MoU) between ICANN and URS Providers;
- Presentations and materials provided by URS Providers (March 2018), as well as URS Providers’ websites, tools, and platforms;
- URS Providers and Practitioners’ responses to the Sub Team-developed surveys (June/August 2018);
- ICANN Org source materials including:
 - Staff report of URS cases and initial metrics, including claims denied cases, de novo review cases, and cases with final determination (July-August 2018);
 - Competition, Consumer Trust and Consumer Choice Review Team (CCT-RT) Recommendations related to the URS (7 March 2017);
 - Expedited Policy Development Process on Temporary Specification for gTLD Registration Data Phase 1 Recommendations related to the URS (20 February 2019);
 - Special Trademark Issues (STI) Review Team Report (11 December 2009);
- INTA’s New gTLD Cost Impact Survey results (April/May 2017);
- Analysis of URS cases performed by Professor Rebecca Tushnet, a Working Group member (May 2018).

8.3.2 TMCH Data

- Final TMCH Framework Document as published in the final version of the Applicant Guidebook (AGB) (4 June 2012);
- Specifications and operational documentation developed for the TMCH, including the TMCH Guidelines, TMCH Operational Requirements, TMCH Functional Specification, TMCH Database Terms of Service Agreement, Registry/Registrar User Manuals, and information about the Qualified Launch Program & Approved Launch Program;
- Information about the TMCH Provider, eligibility criteria, and submission/validation process published on the TMCH website and ICANN’s new gTLD program microsite;
- Responses from a few registries to TMCH Sub-Team developed survey (December 2016);
- ICANN Org source materials including:

¹¹⁵ <https://community.icann.org/x/wCWAaw>

- TMCH Implementation Assistance Group (IAG) Report (26 September 2012);
- Final Report of the Implementation Review Team (IRT) convened by the GNSO Intellectual Property Constituency at Board request following identification of trademark protection as an overarching issue for the New gTLD Program(29 May 2009);
- STI Review Team Report (11 December 2009);
- Metrics compiled for the CCT-RT (2012-2018);
- RPM Staff Paper assessing the operations of the various RPMs in 2015 (11 September 2015);
- Terms and descriptions for design marks and geographical indications (29 April 2017);
- External source materials including:
 - Analysis Group’s Independent Review of the Trademark Clearinghouse (TMCH) Services Revised Report (23 February 2017) and its responses to Working Group questions about that report (June/July 2016);
 - INTA’s New gTLD Cost Impact Survey results (April/May 2017);
 - Data from Deloitte (the TMCH Validation Service Provider) (February 2017) and its responses to Working Group questions (January/April 2017);
- Previous versions of TMCH documentation published in the Draft Applicant Guidebook, explanatory memoranda, and other materials relating to the launch of the 2012 New gTLD Program Round (May 2010-April 2011).

8.3.3 Sunrise & Trademark Claims Services Data

- External source materials considered by the Working Group for its TMCH review (see above);
- Responses from registries, registrars, trademark owners, and actual/potential registrants to the Sunrise and Trademark Claims surveys (October 2018)¹¹⁶;
- Responses from a few registries to TMCH Sub-Team developed survey (13 December 2016);
- ICANN Org source materials including:
 - RPM Staff Paper assessing the operations of the various RPMs in 2015 (11 September 2015);
 - Staff-compiled summary data on Sunrise registrations (based on data reported to ICANN org by Contracted Parties and IBM, which is the TMCH Database Provider) (October 2017);

¹¹⁶ The surveys were commissioned pursuant to a data request approved by the GNSO Council in September 2017.

- List of New gTLD Registry Operators and relevant dates for each of their Sunrise, Trademark Claims, and other specific approved program periods, maintained by ICANN org and published on the New gTLD Program microsite (2012-Present);
- Articles and posts published on domain industry blogs referenced by Working Group members.

8.3.4 TM-PDDRP Data

- TM-PDDRP Rules (June 2012) and Providers' Supplemental Rules (October 2013-March 2014);
- Responses from TM-PDDRP Providers (WIPO, FORUM, and ADNDRC) to Working Group questions (June/September 2016);
- ICANN community responses to Working Group questions about TM-PDDRP (September 2016);
- Feedback from Working Group members related to Registry conduct within TM-PDDRP scope (October 2016);
- Prior versions of the TM-PDDRP as published in the Applicant Guidebook and public comment summaries/analysis (October 2009-May 2011);
- WIPO's proposal to amend the TM-PDDRP (13 March 2009) and community responses to the proposal (March-December 2009).

8.3.5 Additional Marketplace RPMs Data

- Staff-compiled information on additional marketplace RPMs voluntarily adopted by some registry operators (21 September 2017);
- Responses from a few registries to the survey developed by the TMCH Data Gathering Sub Team (13 December 2016);
- Information shared with the additional marketplace RPMs Sub Team by Donuts, Inc., a Registry Operator offering additional marketplace RPMs, during the ICANN61 Puerto Rico meeting (10 March 2017).

8.4 Charter Questions

The Working Group's Charter contains a list of specific topics and questions that were reproduced verbatim from previous ICANN community consultations on the topic of RPMs. This led to the Working Group agreeing, early on in its work, that it would first need to refine these original Charter questions so as to clarify their intent and ensure that the PDP discussions remain objective and neutral.

In addressing the final agreed Charter questions, the Working Group used the Sub Team approach, when it considered this to be appropriate, to develop proposed responses and

recommendations. Due to the Working Group's subsequent data analysis, discussions, and agreements, not all of the final agreed Charter questions resulted in specific answers being proposed by the Working Group at this stage. This does not mean, however, that the Working Group did not address the topic or objective of that specific Charter question; rather that the Working Group believes that it has addressed those issues sufficiently via its data analysis and the outcome of its deliberations. Please see the "Annex B - Charter Questions" section of this Initial Report for additional details.

9 Annex A – PDP Working Group Charter

CHARTER FOR PROPOSED PDP TO REVIEW ALL RIGHTS PROTECTION MECHANISMS IN ALL gTLDS



Working Group (WG) Charter

WG Name:	TBD	
Section I: Working Group Identification		
Chartering Organization(s):	GNSO Council	
Charter Approval Date:	TBD	
Name of WG Chair/Co-Chairs:	TBD	
Name(s) of Appointed Liaison(s):	TBD	
WG Workspace URL:	TBD	
WG Mailing List:	TBD	
GNSO Council Resolution:	Title:	TBD
	Ref # & Link:	TBD
Important Document Links:	<ul style="list-style-type: none"> • GNSO Working Group Guidelines • GNSO PDP Manual • The Current State of the Uniform Domain Name Dispute Resolution Policy: Final Issue Report, October 2011 (“UDRP Final Issue Report”) • Staff Paper on Rights Protection Mechanisms in the New gTLD Program: Revised Report, September 2015 (“RPM Staff Paper”) • 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 	
Section II: Mission, Purpose, and Deliverables		
Mission & Scope:		

Background

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, which included certain safeguards to protect registrants who engage in legitimate uses of domain names: 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 Final Issue 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**(a) A Two-Phased Approach**

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. , 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.

In public comments to the UDRP Final Issue Report, the RPM Staff Paper and the Preliminary Issue Report for this PDP, various community groups and participants had identified a number of issues that they considered appropriate for review in a PDP. As such, and following its preliminary assessment of the effectiveness of the relevant RPM(s) in each phase of its work, 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. These community suggestions are attached to this Charter and they are intended to provide a framework and starting point for the PDP Working Group at the appropriate stage in its work, with further modifications, additions and deletions to be determined by consensus of the Working Group.

(b) Coordination with Other Parallel Efforts

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. In particular, this PDP Working Group shall maintain a close working relationship with the Competition, Consumer Trust and Consumer Choice (CCT) Review Team and the PDP Working Group on New gTLDs Subsequent Procedures. To facilitate interaction between the two GNSO PDPs, a GNSO community liaison, who is a member 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 phase(s) of its work.

In addition, the GNSO Council, as the manager of the policy development process, should be kept informed at all times about coordination efforts with the CCT Review Team and the PDP on New gTLD Subsequent Procedures. In case of conflict between these groups, the Council 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 its work in Phase One. 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 Working Group 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 Working Group is formed, each member of its will be required to submit a 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 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	
1.0			
Staff Contact:	Lars Hoffmann, Mary Wong	Email:	Policy-Staff@icann.org

Translations: If translations will be provided please indicate the languages below:											

ATTACHMENT – LIST OF POTENTIAL ISSUES FOR CONSIDERATION IN THIS PDP¹¹⁷

The issues that are listed here reflect the suggestions that have been made to date by the community regarding improvements or modifications to the RPM(s) in question and should form part of the discussions of the PDP Working Group. The Working Group may decide to address all, some or even additional issues to these.

General:

- Do the RPMs collectively fulfil the objectives for their creation, namely “to provide trademark holders with either preventative or curative protections against cybersquatting and other abusive uses of their legally-recognized trademarks? In other words, have all the RPMs, in the aggregate, been sufficient to meet their objectives or do new or additional mechanisms, or changes to existing RPMs, need to be developed?
- Should any of the New gTLD Program RPMs (such as the URS), like the UDRP, be Consensus Policies applicable to all gTLDs, and if so what are 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

¹¹⁷ As the list was derived from various community suggestions in different forums, they are not listed in any particular order of importance nor has staff attempted to analyze the merits, relevance or significance of each issue.

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?
- 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?
- 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?
- Does there need to be a severe penalty to deter Reverse Domain Name Hijacking attempts?
- Major UDRP decisions of 2011-2015 should be taken into account.
- Should the term "free speech and the rights of non-commercial registrants" be expanded to include "free speech, freedom of expression and the rights of non-commercial registrants" to include rights under US law and the United Nations' Universal Declaration of Human Rights?
- Are the critical concepts of "fair use" and "fair dealing" fully and accurately reflected in the UDRP (and also URS and TMCH rules)?

- Are generic dictionary words being adequately protected so that they are available for all to use as allowed under their national laws and international treaties? E.g. sun, windows.
- Are last names and geographic places adequately protected so that they are available for all to use as allowed under their national laws, e.g. Smith, McDonald, Capitol Hill Cafe, Old Town Deli?
- Now that Reverse Domain Name Hijacking is a regular finding of UDRP panels, indicating that domain name registrants are being abused by complaints brought against them in the UDRP process, what penalties and sanctions should be imposed on Complainants found to be reverse domain name hijackers? How can those penalties and sanctions be aligned so as to be fair, as compared to the loss of a domain name taken from a registrant found to be a “cybersquatter”?
- Are free speech, freedom of expression and the rights of non-commercial registrants uniformly protected in the existing UDRP (and URS and TMCH) policies and their implementation procedures? As currently phrased, the “potential issue” asks if it is “adequately protected,” but where we find differences among Panelists of different countries, we should ask if free speech is “adequately and uniformly protected” – as equity and fairness lies in both.
- Should defenses be expanded, e.g., as seen in Nominet's policy and the URS?

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?¹¹⁸
- 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)¹¹⁹ 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?¹²⁰
- Has ICANN done its job in training registrants in the new rights and defenses of the URS?
- Are the expanded defenses of the URS being used and if so, how, when, and by whom?

¹¹⁸ See Section 8.2 of the [URS Procedure](#).

¹¹⁹ See Section 14 of the [URS Rules](#).

¹²⁰ See Section 2 of the [URS Procedure](#).

- What sanctions should be allowed for misuse of the URS by the trademark owner?
- What evidence is there of problems with the use of the English-only requirement of the URS, especially given its application to IDN New gTLDs?
- How can the appeals process of the URS be expanded and improved?

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?
- 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?
- Is the protection of the TMCH too broad?
- Is the TMCH providing too much protection for those with a trademark on a generic or descriptive dictionary word, thus allowing a trademark in one category of goods and services to block or postpone the legitimate and rightful use of all others in other areas of goods and services? Are legitimate noncommercial, commercial and individual registrants losing legitimate opportunities to register domain names in New gTLDs?
- Is the TMCH and the Sunrise Period allowing key domain names to be cherry-picked and removed from New gTLDs unrelated to those of the categories of goods and services of the trademark owner (e.g., allowing “Windows” to be removed from a future .CLEANING by Microsoft)?
- How should the TMCH scope be limited to apply to only the categories of goods and services in which the generic terms in a trademark are protected?
- How can TMCH services be much more transparent in terms of what is offered for ICANN pursuant to ICANN contracts and policies vs. what services are offered to private New gTLD registries pursuant to private contract?

Potential issues 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 TMCH-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

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?
- Should notices to the trademark owner ought to be sent before the domain is registered?

Additional Questions and Issues

- 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?
- Examine the protection of country names and geographical indications, and generally of indications of source, within the RPMs

- In the light of concrete cases (case law) and from the perspective of owners of protected signs and of marks, which are the identified deficits of the RPMs?
- Assess the benefit of the Arbitration Forums self-reviews, including the *WIPO Advanced Workshop on Domain Name Dispute Resolution, May 2015* [italics in original], in which inconsistencies of decisions, including in the free speech/freedom of expression area were candidly discussed and contemplated
- Are recent and strong ICANN work seeking to understand and incorporate Human Rights into the policy considerations of ICANN relevant to the UDRP or any of the RPMs?
- Are there any barriers that can prevent an end user to access any or all RPMs?
- How can costs be lowered so end users can easily access RPMs?

10 Annex B – Charter Questions

10.1 Introduction

The Working Group Charter¹²¹ that the GNSO Council approved contains a list of specific topics and questions that were reproduced verbatim from previous ICANN community consultations on the topic of RPMs. This led to the Working Group agreeing, early on in its Phase 1 work, that it would first need to refine these original Charter questions so as to clarify their intent and ensure that the PDP discussions remain objective and neutral.

The Working Group used the Sub Team approach to conduct an initial refinement of most of the original Charter questions. The final lists of refined Charter questions for these RPMs reflect initial Sub Team work as well as subsequent Working Group discussion on an agreed approach. For the URS, the Working Group agreed to apply standard high level questions to frame the discussions; as such, there are no final agreed Charter questions for the URS.

In working through data analysis and in-depth discussions, the Working Group agreed that addressing all the topics covered by the original Charter questions did not require specific answers being prepared for all the final agreed Charter questions. In general, the Working Group believes that it has addressed all the specific issues raised by those original Charter questions relating to each of the Phase 1 RPMs via its data analysis and discussions, and its preliminary conclusions are reflected in the recommendations, proposals and questions included in this Initial Report.

The Working Group will not finalize its responses to the final agreed Charter questions until it has conducted a thorough review of the public comments on this Initial Report. At this time, no formal consensus call has been taken on these responses, but these did receive the support of the Working Group for publication for public comment. Where applicable, the Working Group has noted where positions within the Working Group differ.

10.2 Overarching Charter Questions

The Working Group's Charter includes several general, overarching questions as well as a number of additional questions that the Working Group is expected to address at the conclusion of Phase 1 or Phase 2 of its work, as appropriate. During the public comment proceeding for this Initial Report, the Working Group also invites input for three (3) general and three (3) additional overarching Charter questions¹²², which may help inform its overall work toward the Final Report.

¹²¹ The Charter of the PDP Working Group is included in the "Annex A - PDP Working Group Charter" section of this Initial Report. It can also be downloaded here: https://gnso.icann.org/sites/default/files/filefield_48755/rpm-charter-15mar16-en.pdf

¹²² There were other Additional Questions in the original PDP Charter that were subsumed into the Working Group's discussions over specific RPMs and, as such, these have not been reproduced here.

General Overarching Charter Questions	
#1	Q1. Do the RPMs collectively fulfil the objectives for their creation, namely “to provide trademark holders with either preventative or curative protections against cybersquatting and other abusive uses of their legally-recognized trademarks? In other words, have all the RPMs, in the aggregate, been sufficient to meet their objectives or do new or additional mechanisms, or changes to existing RPMs, need to be developed?
#2	Q2a. Should any of the New gTLD Program RPMs (such as the URS), like the UDRP, be Consensus Policies applicable to all gTLDs? Q2b. If so, what are the transitional issues that would have to be dealt with as a consequence?
#3	Q3a. Will changes to one RPM need to be offset by concomitant changes to the others? Q3b. If so, to what extent?
Additional Overarching Charter Questions	
#1	Q1. Do the RPMs adequately address issues of registrant protection (such as freedom of expression and fair use)?
#2	Q2. Is the recent and strong ICANN work seeking to understand and incorporate Human Rights into the policy considerations of ICANN relevant to the UDRP or any of the RPMs?
#3	Q3. How can costs be lowered so end users can easily access RPMs?

10.3 Uniform Rapid Suspension System (URS) High Level Questions & Review Topics

The Working Group agreed that its review of the URS would be based on the following list of high-level framing questions and specific topics.

High Level Questions
<ol style="list-style-type: none"> 1. Has it been used? Why or why not? 2. What was the original purpose and is it being fulfilled? 3. Bearing in mind the original purpose, have there been any unintended consequences? 4. What changes could better align the mechanism with the original purpose/facilitate it to carry out its purpose? 5. What was the ultimate outcome?
URS Review Topic
<p>A. <u>THE COMPLAINT:</u></p> <ol style="list-style-type: none"> 1. Standing to file

<ul style="list-style-type: none"> 2. Grounds for complaint 3. Limited filing period 4. Administrative review
<p>B. <u>THE NOTICE OF COMPLAINT:</u></p> <ul style="list-style-type: none"> 1. Receipt by Registrant 2. Effect on Registry Operator
<p>C. <u>THE RESPONSE:</u></p> <ul style="list-style-type: none"> 1. Duration of response period 2. Response fee 3. Other issues (e.g. default procedures)
<p>D. <u>STANDARD OF PROOF:</u></p> <ul style="list-style-type: none"> 1. Standard of proof
<p>E. <u>DEFENSES:</u></p> <ul style="list-style-type: none"> 1. Scope of defenses 2. Unreasonable delay in filing complaint
<p>F. <u>REMEDIES:</u></p> <ul style="list-style-type: none"> 1. Scope of remedies 2. Duration of suspension period 3. Review of implementation of current remedies
<p>G. <u>APPEAL:</u></p> <ul style="list-style-type: none"> 1. Appeal process
<p>H. <u>POTENTIALLY OVERLAPPING PROCESS STEPS:</u></p> <ul style="list-style-type: none"> 1. Potential overlap concerning duration of respondent appeal, review and extended reply periods along the URS process timeline
<p>I. <u>COST:</u></p> <ul style="list-style-type: none"> 1. Cost allocation model
<p>J. <u>LANGUAGE:</u></p> <ul style="list-style-type: none"> 1. Language issues, including current requirements for complaint, notice of complaint, response, determination
<p>K. <u>ABUSE OF PROCESS:</u></p> <ul style="list-style-type: none"> 1. Misuse of the process, including by trademark owners, registrants and “repeat offenders” 2. Forum shopping 3. Other documented abuses
<p>L. <u>EDUCATION & TRAINING:</u></p> <ul style="list-style-type: none"> 1. Responsibility for education and training of complainants, registrants, registries and registrars

M. <u>URS PROVIDERS</u> : 1. Evaluation of URS providers and their respective processes
N. <u>ALTERNATIVE(S) TO THE URS</u> : 1. Possible alternative(s) to the URS, e.g. summary procedure in the UDRP

10.4 Trademark Clearinghouse (TMCH) Final Agreed Charter Questions & Proposed Answers

To facilitate the review of the TMCH structure and scope, the Working Group's TMCH Charter Questions Sub Team proposed that the original TMCH-related Charter questions be placed in specific categories to facilitate deliberations.

Question #	Final Agreed Charter Question	Proposed Answer
Category 1: Education		
TMCH Question #1	Is the TMCH clearly communicating: (i) the criteria it applies when determining whether or not to accept marks for entry into the TMCH; (ii) options for rights-holders when their submissions are rejected; and (iii) options for third parties who may have challenges to or questions about records in the TMCH?	The Working Group considered this question but did not reach a conclusion.
TMCH Question #2	Should the TMCH be responsible for educating rights-holders, domain name registrants and potential registrants about the services it provides? If so, how? If the TMCH is not to be responsible, who should be?	The Working Group discussed this question and agreed to include the TMCH Proposal #1, which argued that the TMCH should be responsible for educating rights-holders, domain name registrants, and potential registrants the services it provides, in the Initial Report for public comment.
TMCH Question #3	What information on the following aspects of the operation of the TMCH is available and where can it be found? (a) TMCH services; (b) Contractual relationships between the TMCH providers and private parties; and (c) With whom does the TMCH share data and for what purposes?	Deloitte, the TMCH Service Provider, provided information with respect to this question on 26 January 2017 (see Deloitte's response on this document in

Question #	Final Agreed Charter Question	Proposed Answer
		the footnote ¹²³). The Working Group concluded that no additional policy recommendation needs to be developed on this topic.
Category 2: Verification & Updating of TMCH Database		
TMCH Question #4	Should the verification criteria used by the TMCH to determine if a submitted mark meets the eligibility and other requirements of the TMCH be clarified or amended? If so how?	The Working Group considered this question but did not reach a conclusion.
TMCH Question #5	Should there be an additional or a different recourse mechanism to challenge rejected submissions for records in the TMCH?	The Working Group considered this question but did not reach a conclusion.
TMCH Question #6	How quickly can and should a cancelled trademark be removed from the TMCH Database?	The Working Group considered this question but did not reach a conclusion.
Category 3: Breadth & Reach (Scope)		
TMCH Question #7	How are design marks currently handled by the TMCH provider?	Deloitte, the TMCH Service Provider, provided information with respect to this question on 5 March 2017 (see Deloitte's response to Q6 on this document in the footnote ¹²⁴). In light of Deloitte's response, the Working Group agreed to include TMCH Proposals #2 and #3 in the Initial Report for public comment.
TMCH Question #8	How are geographical indications, protected designations of origin, and protected appellations of origin currently handled by the TMCH provider?	Deloitte, the TMCH Service Provider, provided information with respect to this question on 5 March 2017 (see Deloitte's response to Q7 on this document in the

123

<https://community.icann.org/download/attachments/64066042/Deloitte%20responses%20to%20TMCH%20Data%20Gathering%20Sub%20Team%20questions%20-%20Jan%202017.docx?version=1&modificationDate=1485897782000&api=v2>

124

<https://community.icann.org/download/attachments/64066042/Deloitte%20Responses%20to%20Follow%20Up%20Questions.pdf?version=1&modificationDate=1493341766000&api=v2>

Question #	Final Agreed Charter Question	Proposed Answer
		footnote ¹²⁵). In light of Deloitte's response, the Working Group agreed to include TMCH Proposals #4 and #5 in the Initial Report for public comment.
TMCH Question #9	Should the TM+50 be retained as is, amended or removed?	In the absence of wide support for a change to the status quo, the Working Group recommends that the TM +50 should be retained as is.
TMCH Question #10	Should the TMCH matching rules be retained, modified, or expanded, e.g. to include plurals, 'marks contained' or 'mark+keyword', and/or common typos of a mark?	In the absence of wide support for a change to the status quo, the Working Group ultimately recommends that the current TMCH matching rules should be maintained, noting that members of the Working Group had diverging opinions on this matter.
TMCH Question #11	Should the scope of the RPMs associated with the TMCH be limited to apply only to TLDs that are related to the categories of goods and services in which the dictionary term(s) within a trademark are protected.	The Working Group had diverging opinions on this matter and in the absence of wide support for a change to the status quo, the Working Group agreed that the scope of the RPMs associated with the TMCH should not be limited to apply only to TLDs that are related to the categories of goods and services in which the dictionary term(s) within a trademark are protected.
Category 4: Costs & Other Fundamental Features		
TMCH Question #12	Are there concerns about operational considerations (such as cost, reliability, global reach, service diversity and consistency) due to the TMCH Database being provided by a single Provider? If so, how may they be addressed?	Some Working Group members had concerns about the operational considerations due to the TMCH Database being provided by a single provider (i.e, IBM). The Working Group agreed to include the TMCH Proposal #6 in the Initial Report for public comment.
TMCH Question #13	Are the costs and benefits of the TMCH reasonably proportionate amongst rights holders, registries,	The Working Group considered this question but did not reach a conclusion.

125

<https://community.icann.org/download/attachments/64066042/Deloitte%20Responses%20to%20Follow%20Up%20Questions.pdf?version=1&modificationDate=1493341766000&api=v2>

Question #	Final Agreed Charter Question	Proposed Answer
	registrars, registrants, other members of the community and ICANN?	
Category 5: Access & Accessibility		
TMCH Question #14	How accessible is the TMCH Database and RPM Rights Protection Actions and Defenses to individuals, organizations and rights-holders; as well as trademark agents in developing countries?	The Working Group considered this question but did not reach a conclusion.
TMCH Question #15	What concerns are being raised about the TMCH Database being confidential, what are the reasons for having/keeping the TMCH Database private, and should the TMCH Database remain confidential or become open?	The Working Group had diverging opinions on whether the TMCH Database should remain confidential or become open. The Working Group agreed to include the TMCH Proposal #7, which advocated for an open and searchable TMCH Database, in the Initial Report for public comment. The Working Group also agreed to include the opposing opinions on the proposal and the reasons for having/keeping the TMCH Database private.
TMCH Question #16	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 rights of non-trademark registrants?	The Working Group ultimately concluded that the current balance between the rights of trademark holders and the rights of non-trademark registrants, as reflected in the scope of the TMCH and the protection mechanisms which flow from it, be maintained, noting that members of the Working Group had diverging opinions on this matter.

10.5 Sunrise Service Final Agreed Charter Questions & Proposed Answers

Question #	Final Agreed Charter Question	Proposed Answer
Sunrise Preamble Question	Preamble Q(a): Is the Sunrise Period serving its intended purpose?	The Working Group noted that the intended purpose for Sunrise service is as follows: Sunrise services allow

Question #	Final Agreed Charter Question	Proposed Answer
		trademark holders an advance opportunity to register domain names corresponding to their marks before names are generally available to the public ¹²⁶ . The Working Group generally agreed that the Sunrise Period is serving its intended purpose as stated previously.
	Preamble Q(b): Is it having unintended effects?	The Working Group generally agreed that the Sunrise Period is having unintended effects. However, the Working Group was uncertain about the scope and extent of the unintended effects.
	Preamble Q(c): Is the TMCH Provider requiring appropriate forms of “use” (if not, how can this corrected)?	The Working Group generally agreed that the TMCH Provider is requiring appropriate forms of proof of use, according to the enumerated rules (i.e., Section 2.2.3 of the TMCH guidelines) ¹²⁷ .
	Preamble Q(d): Have abuses of the Sunrise Period been documented by trademark owners?	The Working Group interpreted these questions as follows: “Have abuses of the Sunrise Period been documented?”
	Preamble Q(e): Have abuses of the Sunrise Period been documented by Registrants?	
	Preamble Q(f): Have abuses of the Sunrise Period been documented by Registries and Registrars?	
Sunrise Question #1	Q1(a): Should the availability of Sunrise registrations only for identical matches be reviewed?	The Working Group ultimately concluded that the availability of Sunrise registrations only for identical matches should be maintained, noting that members of the Working Group had diverging opinions on this matter.

¹²⁶ See <https://neWorkingGroupTlds.icann.org/en/about/trademark-clearinghouse/faqs>

¹²⁷ See Section 2.2.3 of the TMCH guidelines on pages 8-10 here: https://www.trademark-clearinghouse.com/sites/default/files/files/downloads/TMCH%20guidelines%20v1.0%20_1.pdf

Question #	Final Agreed Charter Question	Proposed Answer
	Q1(b): If the matching process is expanded, how can Registrant free expression and fair use rights be protected and balanced against trademark rights?	Since the Working Group ultimately concluded that the availability of Sunrise registrations only for identical matches should be maintained, the Working Group did not consider this question in detail.
Sunrise Question #2	Q2 Threshold: Is Registry pricing within the scope of the RPM Working Group or ICANN's review?	The Working Group had diverging opinions on whether registry pricing is within the scope of the RPM PDP Working Group. Some Working Group members pointed to the Registry Agreements that state that registry pricing is not within the scope of the RPM Working Group due to the picket fence ¹²⁸ . Specifically, Section 1.4.1 of Specification 1 of the Registry Agreement and Section 1.4.1 of the Consensus Policies and Temporary Policies Specification of the Registrar Accreditation Agreement respectively specify that Consensus Policies shall not prescribe or limit the price of Registry Services and Registrar Services ¹²⁹ . However, some Working Group members expressed concerns about the interplay of Registry pricing with RPMs

¹²⁸ **Picket Fence:** In its original agreements with ICANN, registries and registrars agreed to comply with “consensus” policies adopted by ICANN provided (i) that such policies did not unreasonably restrain competition and (ii) that the policies related to: 1) issues for which uniform or coordinated resolution is reasonably necessary to facilitate interoperability, technical reliability and/or stable operation of the Internet or domain-name system; 2) registry policies reasonably necessary to implement Consensus Policies relating to registrars; and 3) resolution of disputes regarding the registration of domain names (as opposed to the use of such domain names), and do not unreasonably restrain competition. ICANN’s policy making mission, as described previously, creates a “picket fence” around ICANN’s authority -- ICANN can only mandate registry and registrar compliance with policies affecting issues inside the “picket fence”; ICANN could establish policy and/or best practices affecting issues outside the picket fence, but could not mandate registry and registrar compliance with such policies. Learn more:

<https://gnso.icann.org/sites/default/files/file/field-file-attach/picket-fence-overview-23jan19-en.pdf>

¹²⁹ Section 1.4.1 of Specification 1 of the Registry Agreement and Section 1.4.1 of the Consensus Policies and Temporary Policies Specification of the Registrar Accreditation Agreement state the following: “In addition to the other limitations on Consensus Policies, they shall not prescribe or limit the price of Registrar Services”. See page 43 of the Base Registry Agreement (updated 31 July 2017):

<https://newgtlds.icann.org/sites/default/files/agreements/agreement-approved-31jul17-en.pdf> and page 57 of the 2013 Registrar Accreditation Agreement: <https://www.icann.org/en/system/files/files/approved-with-specs-27jun13-en.pdf>.

Question #	Final Agreed Charter Question	Proposed Answer
		obligations, which are discussed further in the proposed answer to Q2(a)-(b).
	Q2(a): Do Registry Sunrise or Premium Name pricing practices unfairly limit the ability of trademark owners to participate during Sunrise?	The Working Group generally agreed that some Registry Sunrise or Premium Name ¹³⁰ pricing practices have limited the ability of some trademark owners to participate during Sunrise. The Working Group is aware of cases where the Registry Operator practices may have unfairly limited the ability of some trademark owners to participate during Sunrise, when pricing set for the trademark owners was significantly higher than other Sunrise pricing or General Availability pricing.
	Q2(b): If so, how extensive is this problem?	The Working Group noted that this problem seems sufficiently extensive that it may require a recommendation to address it. The Working Group also noted that pricing is outside the picket fence.
Sunrise Question #3	Q3(a): Should Registry Operators be required to create a mechanism that allows trademark owners to challenge the determination that a second level name is a Premium Name or Reserved Name?	<p>The Working Group noted that every Q3 sub question covers both Premium Names and Reserved Names, which are very different. Premium Names are not clearly defined, as a Registry Operator can have multiple pricing tiers.</p> <p>The Working Group had diverging opinions on whether Registry Operators should be required to create a mechanism that allows trademark owners to challenge the determination that a second level name is a Premium Name or Reserved Name.</p>

¹³⁰ **Premium Name:** second level domain names that are offered for registration that, in the determination of the registry, are more desirable for the purchaser. **Premium Pricing:** second level domain names that are offered for registration, that in the determination of the registry are more desirable for the purchaser, and will command a price that is higher than a non-premium name.

Question #	Final Agreed Charter Question	Proposed Answer
	<p>Q3(b): Additionally, should Registry Operators be required to create a release mechanism in the event that a Premium Name or Reserved Name is challenged successfully, so that the trademark owner can register that name during the Sunrise Period?</p>	<p>Since there was no wide support for a challenge mechanism within the Working Group, the Working Group did not consider this question.</p>
	<p>Q3(c): What concerns might be raised by either or both of these requirements?</p>	<p>Some Working Group members noted some possible concerns, but there was no wide support within the Working Group for those concerns. Hence the Working Group did not develop an answer to this question.</p>
<p>Sunrise Question #4</p>	<p>Q4(a): Are Registry Operator Reserved Names practices unfairly limiting participation in Sunrise by trademark owners?</p>	<p>Some Working Group members believe that certain Registry Operators' Reserved Names practices may be unfairly limiting participation in Sunrise by trademark owners.</p>
	<p>Q4(b): Should Section 1.3.3 of Specification 1 of the Registry Agreement be modified to address these concerns?</p>	<p>The Working Group did not agree that there are concerns that should be addressed with regard to Section 1.3.3 of Specification 1 of the Registry Agreement¹³¹.</p>
	<p>Q4(c): Should Registry Operators be required to publish their Reserved Names lists -- what Registry concerns would be raised by that publication, and what problem(s) would it solve?</p>	<p>The Working Group had diverging opinions on whether Registry Operators should be required to publish their Reserved Names lists.</p> <p>Some Working Group members noted several possible registry concerns if Registry Operators were required to publish their Reserved Names lists.</p>

¹³¹ Section 1.3.3 of Specification 1 of the Registry Agreement states the following: "Such categories of issues referred to in Section 1.2 of this Specification shall include, without limitation, reservation of registered names in the TLD that may not be registered initially or that may not be renewed due to reasons reasonably related to (i) avoidance of confusion among or misleading of users, (ii) intellectual property, or (iii) the technical management of the DNS or the Internet (e.g., establishment of reservations of names from registration). See page 43 of the Base Registry Agreement (updated 31 July 2017) here: <https://neWorkingGroupTlds.icann.org/sites/default/files/agreements/agreement-approved-31jul17-en.pdf>

Question #	Final Agreed Charter Question	Proposed Answer
		Other Working Group members discussed possible problems that the publication of the Reserved Names lists could solve.
	Q4(d): Should Registry Operators be required to provide trademark owners in the TMCH notice, and the opportunity to register, the domain name should the Registry Operator release it – what Registry concerns would be raised by this requirement?	The Working Group had diverging opinions on this matter.
Sunrise Question #5	Q5(a): Does the current 30-day minimum for a Sunrise Period serve its intended purpose, particularly in view of the fact that many Registry Operators actually ran a 60-day Sunrise Period?	<p>The Working Group noted two types of Sunrise Periods:</p> <p>1) Start Date Sunrise: The Registry must give 30-days notice before commencing the Sunrise. Once the Sunrise starts, it must run for 30 days at a minimum.</p> <p>2) End Date Sunrise: The Registry can announce the Sunrise as late as the day the Sunrise starts, but must run the Sunrise Period for 60 days at a minimum.</p> <p>Both types of Sunrise Periods require a total of 60 days at a minimum¹³².</p> <p>The Working Group generally agreed that the current 30-day minimum after a Start Date Sunrise Period starts appears to be serving its intended purpose.</p>
	Q5(a)(i): Are there any unintended results?	Some Working Group members believe that there are unintended results, such as complications when many TLDs are launched simultaneously for the Start Date Sunrise for 30 days. Other Working Group members believe that the 30-day advance notice before the launch of a Start Date Sunrise may help mitigate the administrative burdens on the trademark owners.

¹³² See reference here: https://icannwiki.org/Sunrise_Period

Question #	Final Agreed Charter Question	Proposed Answer
	Q5(a)(ii): Does the ability of Registry Operators to expand their Sunrise Periods create uniformity concerns that should be addressed by this Working Group?	The Working Group generally agreed that the existing ability of Registry Operators to expand their Sunrise Periods does not create uniformity concerns that should be addressed by this Working Group.
	Q5(a)(iii): Are there any benefits observed when the Sunrise Period is extended beyond 30 days?	The Working Group had diverging opinions on whether there are benefits observed when the Start Date Sunrise Period is extended beyond 30 days.
	Q5(a)(iv): Are there any disadvantages?	Some Working Group members believe that there are disadvantages when the Sunrise Period is extended beyond 30 days, but the Working Group did not come to a conclusion on this point.
	Q5(b): In light of evidence gathered above, should the Sunrise Period continue to be mandatory or become optional?	The Working Group had diverging opinions on whether the Sunrise Period should continue being mandatory or should become optional.
	Q5(b)(i): Should the Working Group consider returning to the original recommendation from the IRT and STI of Sunrise Period OR Trademark Claims in light of other concerns, including freedom of expression and fair use?	The Working Group considered this question but did not reach a conclusion.
	Q5(b)(ii): In considering mandatory vs optional, should Registry Operators be allowed to choose between Sunrise and Claims (that is, make ONE mandatory)?	The Working Group considered this question but did not reach a conclusion.
Sunrise Question #6	Q6(a): What are Sunrise Dispute Resolution Policies (SDRPs), and are any changes needed?	According to the Section 6.2.2 and 6.2.4 of the Trademark Clearinghouse Model of Module 5 of the Applicant Guidebook (AGB), SDRP is a mechanism that a Registry Operator must provide to resolve disputes regarding its

Question #	Final Agreed Charter Question	Proposed Answer
		<p>registration of Sunrise Registrations¹³³. It allows challenges to Sunrise Registrations related to Registry Operator's allocation and registration policies on four non-exhaustive grounds, including on the grounds that the registered domain name does not identically match the Trademark Record on which the Sunrise-Eligible Rights Holder based its Sunrise Registration.</p> <p>In the time between when the AGB was written and the TMCH requirements were established, the TMCH dispute procedure was created. This procedure allows for challenges to the recordal of marks in the TMCH that underlie Sunrise Registrations.</p> <p>As a result, two of AGB requirements for Registry Operator SDRPs are moot; and in any event the Registry Operator is not the best-placed party to adjudicate these challenges due to the fact that the Registry Operator is reliant on trademark eligibility information provided by the TMCH.</p> <p>Hence, the Working Group proposed a preliminary recommendation (as noted in the column on the right) that codifies the current practice.</p>

¹³³ Section 6.2.2 of the Trademark Clearinghouse Model of Module 5 of the Applicant Guidebook states the following: "Sunrise Registration Process. For a Sunrise service, sunrise eligibility requirements (SERs) will be met as a minimum requirement, verified by Clearinghouse data, and incorporate a Sunrise Dispute Resolution Policy (SDRP)." Section 6.2.4 states the following: "The proposed SDRP must allow challenges based on at least the following four grounds: (i) at time the challenged domain name was registered, the registrant did not hold a trademark registration of national effect (or regional effect) or the trademark had not been court-validated or protected by statute or treaty; (ii) the domain name is not identical to the mark on which the registrant based its Sunrise registration; (iii) the trademark registration on which the registrant based its Sunrise registration is not of national effect (or regional effect) or the trademark had not been court-validated or protected by statute or treaty; or (iv) the trademark registration on which the domain name registrant based its Sunrise registration did not issue on or before the effective date of the Registry Agreement and was not applied for on or before ICANN announced the applications received." See pages 296-297 here: <https://newgtlds.icann.org/en/applicants/agb/guidebook-full-04jun12-en.pdf>

Question #	Final Agreed Charter Question	Proposed Answer
	<p>Q6(b): Are SDRPs serving the purpose(s) for which they were created?</p>	<p>The Working Group had difficulty determining whether SDRPs are serving the purpose(s) for which they were created, as each TLD has its own SDRP and there is hardly any analysis of the SDRP decisions across all new gTLDs.</p> <p>The Working Group has proposed a preliminary recommendation in relation to Q6(a) that will eliminate the non-functional parts of the SDRP requirements and codify the current practice. Some Working Group members believe that the limited access to the TMCH and the lack of trademark information to identify whether a complaint is well-grounded makes it difficult to challenge a registration via the SDRP.</p>
	<p>Q6(c): If not, should they be better publicized, better used or changed?</p>	<p>The Working Group attempted to address this question in its proposed preliminary recommendation in relation to Q6(a).</p> <p>One Working Group member commented that whether SDRPs should be better publicized is contingent on whether they are serving the purpose(s) for which they were created. However, it is not harmful for Registry Operators to periodically remind registrants of the existence of SDRPs. One Working Group member believes that it is not within the scope of the RPM PDP Working Group to recommend how SDRPs can be better used. It is up to the Registry Operators and challengers to decide.</p>
<p>Sunrise Question #7</p>	<p>Q7(a): Can SMD files be used for Sunrise Period registrations after they have been canceled or revoked?</p>	<p>The Working Group noted that after an SMD file or its underlying trademark record has been canceled or revoked, the SMD file cannot be used for Sunrise Period registrations. However, theoretically, an SMD file might still</p>

Question #	Final Agreed Charter Question	Proposed Answer
		work for an asynchronous short period of time due to the registry process.
	Q7(b): How prevalent is this as a problem?	The Working Group generally agreed that the problem does not seem to be prevalent.
Sunrise Question #8	Q8(a): Are Limited Registration Periods in need of review vis a vis the Sunrise Period? Approved Launch Programs? Qualified Launch Programs?	The Working Group discussed this question but was unable to conclude whether the Limited Registration Periods, Approved Launch Programs, or Qualified Launch Programs are in need of review.
	Q8(b): Are the ALP and QLP periods in need of review?	The Working Group discussed this question but was unable to conclude whether ALP and QLP periods are in need of review.
	Q8(c): What aspects of the LRP are in need of review?	The Working Group discussed this question but was unable to conclude what aspects of the LRP are in need of review.
Sunrise Question #9	Q9: In light of the evidence gathered above, should the scope of Sunrise Registrations be limited to the categories of goods and services for which the trademark is actually registered and put in the Clearinghouse?	The Working Group had diverging opinions on this matter, and the Working Group did not come to a conclusion.
Sunrise Question #10	Q10: Explore use and the types of proof required by the TMCH when purchasing domains in the Sunrise Period.	While the Working Group recognized that this question has a genesis, the Working Group did not formulate a response due to disagreement on what the question is asking.
Sunrise Question #11	Q11(a): How effectively can trademark holders who use non-English scripts/languages able to participate in Sunrise (including IDN Sunrises)?	Some Working Group members believe that Trademark holders who use non-English scripts/languages generally cannot effectively participate in Sunrise.
	Q11(b): Should any of them be further “internationalized” (such as in terms of service providers, languages served)?	The Working Group did not address this question as the question was unclear.

Question #	Final Agreed Charter Question	Proposed Answer
Sunrise Question #12	Q12(a): Should Sunrise Registrations have priority over other registrations under specialized gTLDs?	The Working Group discussed this question but was unable to conclude whether Sunrise Registrations should have priority over other registrations under specialized gTLDs.
	Q12(b): Should there be a different rule for some registries, such as certain types of specialized gTLDs (e.g. community or geo TLDs), based on their published registration/eligibility policies? (Examples include POLICE.PARIS and POLICE.NYC for geo-TLDs , and WINDOWS.CONSTRUCTION for specialized gTLDs)	The Working Group discussed this question but was unable to conclude whether there should be a different rule for some registries, such as certain types of specialized gTLDs, based on their published registration/eligibility policies.

10.6 Trademark Claims Service Final Agreed Charter Questions & Proposed Answers

Question #	Final Agreed Charter Question	Proposed Answer
Trademark Claims Question #1	Q1 Threshold: Is the Trademark Claims service having its intended effect?	The Working Group did not come to an agreement as to whether the Trademark Claims service is “probably” or “likely” having its intended effect, although the Working Group could determine that the service is at least “possibly” having its intended effect.
	Q1(a): Is the Trademark Claims service having its intended effect of deterring bad-faith registrations and providing Claims Notice to domain name applicants?	The Working Group did not come to an agreement as to whether the Trademark Claims service is “probably” or “likely” having its intended effect of deterring bad-faith registrations, although the Working Group could determine that the service is at least “possibly” having its intended effect. The Working Group could not determine the extent of deterrence that occurred, if any.
	Q1(b): Is the Trademark Claims service having any unintended consequences, such as deterring	The Working Group generally agreed that the Trademark Claims service may possibly have unintended consequences,

Question #	Final Agreed Charter Question	Proposed Answer
	good-faith domain name applications?	such as deterring good-faith domain name applications. The Working Group could not determine the extent of deterrence that occurred, if any.
Trademark Claims Question #2	Q2(a): Should the Claims period be extended - if so, for how long (up to permanently)?	The Working Group generally agreed that where there is a mandatory Claims period (see Trademark Claims Q2(d)), it should not be extended. However, the Working Group generally agreed that registries should have a certain degree of flexibility, based on a suitable business model, with the option to extend the Claims Period, provided this does not involve shortening the Claims Period.
	Q2(b): Should the Claims period be shortened?	The Working Group generally agreed that where there is a mandatory Claims Period (see Trademark Claims Q2(d)), it should not be shortened.
	Q2(c): Should the Claims period be mandatory?	The Working Group generally agreed that where there is a Claims period, it should be mandatory (see Trademark Claims Q2(d)). However, the Working Group generally agreed that registries should have a certain degree of flexibility, based on a suitable business model, with the option to extend the Claims Period, provided this does not involve shortening the Claims Period.
	Q2(d): Should any TLDs be exempt from the Claims RPM and if so, which ones and why?	Some Working Group members believe that some future TLDs should be exempt from the Claims RPM. Some Working Group members suggested that public comment should be sought on whether there is a use case for exempting a TLD from the requirement of a mandatory Claims Period due to the particular nature of the TLD.
	Q2(e): Should the proof of use requirements for Sunrise be extended	The Working Group had diverging opinions on whether the proof of use requirements for Sunrise should be

Question #	Final Agreed Charter Question	Proposed Answer
	to include the issuance of TMCH notices?	extended to include the issuance of TMCH notices.
Trademark Claims Question #3	Q3(a): Does the Trademark Claims Notice to domain name applicants meet its intended purpose?	The Working Group generally agreed that the Trademark Claims Notice generally meets its intended purpose of notifying prospective domain name registrants that the applied-for domain name matches at least one trademark in the Trademark Clearinghouse. However, the Working Group also recognized the inadequacies and shortcomings of the Trademark Claims Notice as set out in the proposed answers to Q3(a)(i)-(iii).
	Q3(a)(i): If not, is it intimidating, hard to understand, or otherwise inadequate? If inadequate, how can it be improved?	The Working Group generally agreed that for some of the actual and potential registrant respondents, the Claims Notice is intimidating, hard to understand, or otherwise inadequate. The Working Group made preliminary recommendations to improve the Claims Notice (see Trademark Claims Recommendation #1), and also sought community input to address its inadequacy (see Trademark Claims Question #1).
	Q3(a)(ii): Does it inform domain name applicants of the scope and limitations of trademark holders' rights? If not, how can it be improved?	Some Working Group members believe that the Claims Notice does not adequately inform domain name applicants of the scope and limitations of trademark holders' rights (e.g., lack of identifying details of the trademark, issues with figurative/design marks). The Working Group made preliminary recommendations to improve the Claims Notice (see Trademark Claims Recommendation #1), and also sought community input to address its inadequacy (see Trademark Claims Question #1).
	Q3(a)(iii): Are translations of the Trademark Claims Notice effective in informing domain name applicants of	The Working Group generally agreed that the current requirement on translations of the Trademark Claims

Question #	Final Agreed Charter Question	Proposed Answer
	the scope and limitation of trademark holders' rights?	<p>Notice does not seem effective in informing domain name applicants of the scope and limitation of trademark holders' rights.</p> <p>The current requirement¹³⁴ states: "The Claims Notice MUST be provided by the registrar to the potential domain name registrant in English and SHOULD be provided by the registrar to the potential domain name registrant in the language of the registration agreement".</p>
	Q3(b): Should Claims Notifications only be sent to registrants who complete domain name registrations, as opposed to those who are attempting to register domain names that are matches to entries in the TMCH?	The Working Group generally agreed that when there is a Claims Period and the issuance of a Claims Notice is required (see proposed answer to Trademark Claims Q2(d)), the Claims Notice should be sent to potential registrants, who are attempting to register domain names that are matches to entries in the TMCH, at some point before the domain name registration is completed.
Trademark Claims Question #4	Threshold Q4: Is the exact match requirement for Trademark Claims serving the intended purposes of the Trademark Claims RPM? In conducting this analysis, recall that IDNs and Latin-based words with accents and umlauts are currently not serviced or recognized by many registries.	The Working Group had diverging opinions on whether the exact match requirement is serving the intended purposes of the Trademark Claims RPM.
	Q4(a): What is the evidence of harm under the existing system?	The Working Group had diverging opinions on whether there is evidence of harm under the existing system of exact match.
	Q4(b): Should the matching criteria for Notices be expanded?	The Working Group had diverging opinions on whether the matching

¹³⁴ See the requirements of the Trademark Claims service here: <http://newgtlds.icann.org/en/about/trademark-clearinghouse/rpm-requirements-30sep13-en.pdf>

Question #	Final Agreed Charter Question	Proposed Answer
		criteria for the Claims Notice should be expanded.
	Q4(b)(i): Should the marks in the TMCH be the basis for an expansion of matches for the purpose of providing a broader range of claims notices?	<p>The Working Group generally agreed that if the matching criteria for the Claims Notice were to be expanded, the marks in the TMCH should be the basis for an expansion of matches for the purpose of providing a broader range of Claims Notice.</p> <p>While there was no agreement within the Working Group that the matching criteria should be expanded, most Working Group members generally assumed that the TMCH would be the likely implementation for any expansion because contracted parties are already integrated with, and querying, the TMCH for the Claims Notice today. Nevertheless, the Working Group did not know how the implementation would technically work.</p>
	Q4(b)(ii): What results (including unintended consequences) might each suggested form of expansion of matching criteria have?	Since the Working Group did not agree on the expansion of matches, the Working Group did not consider this question in detail.
	Q4(b)(iii): What balance should be adhered to in striving to deter bad-faith registrations but not good-faith domain name applications?	<p>The Working Group believes that the exact match criteria has already struck the current balance of deterring bad-faith registrations but not good-faith domain name applications.</p> <p>The Working Group believes that the current balance can be enhanced by a well-crafted Claims Notice that appropriately notifies prospective registrants about a potential problem with their chosen domain name, employs clear/concise/informative language, and avoids a potential overflow of false positives.</p>

Question #	Final Agreed Charter Question	Proposed Answer
	Q4(b)(iv): What is the resulting list of non-exact match criteria recommended by the Working Group, if any?	Since the Working Group did not agree on the expansion of matches, the Working Group did not consider this question in detail.
	Q4(c): What is the feasibility of implementation for each form of expanded matches?	Since the Working Group did not agree on the expansion of matches, the Working Group did not consider this question in detail.
	Q4(d)(i): If an expansion of matches solution were to be implemented, should the existing TM Claims Notice be amended? If so, how?	Since the Working Group did not agree on the expansion of matches, the Working Group did not consider this question in detail.
	Q4(d)(ii): If an expansion of matches solution were to be implemented, should the Claim period differ for exact matches versus non-exact matches?	Since the Working Group did not agree on the expansion of matches, the Working Group did not consider this question in detail.
Trademark Claims Question #5	Q5: Should the Trademark Claims period continue to be uniform for all types of gTLDs in subsequent rounds?	The Working Group generally agreed that where the Registry Operator has not obtained an exception (see proposed answer to Trademark Claims Q2(d)), the Trademark Claims period, including for the minimum initial 90-day period when a TLD opens for general registration, should continue to be uniform for all types of gTLDs in subsequent rounds. In addition, the Working Group generally agreed that registries should have a certain degree of flexibility, based on a suitable business model, with the option to extend the Claims Period.

10.7 TM-PDDRP Charter Question

The Working Group’s Charter contains one question about the TM-PDDPR: **“Is there a policy-based need to address the goal of the TM-PDDRP?”**

The Working Group agreed that its approach to review this RPM would be to first engage with

the various dispute resolution providers. Accordingly, it developed a list of survey questions¹³⁵ to frame its interaction with the providers.

10.8 Additional Marketplace RPMs Questions

Since reviewing the additional marketplace RPMs is out of scope for this PDP, the Working Group's Charter does not contain any specific questions pertaining to these additional RPMs.

Nevertheless, the Working Group discussed these additional mechanisms, as its Charter mandated that it consider the interplay between the mandatory RPMs, their collective fulfillment of their intended purpose, and their aggregate sufficiency.

The Working Group's discussions about the additional marketplace RPMs were based on a final set of six (6) questions¹³⁶ from the Additional Marketplace RPMs Sub Team that was formed to refine the initial list of questions prepared by the Working Group Co-Chairs. As mentioned in the "Additional Marketplace Rights Protection Mechanisms" section of this Initial Report, a subsequent Sub Team (the RPM Data Sub Team) reviewed the Working Group's discussions about the additional marketplace RPMs and used relevant information derived from them to formulate guidance for Analysis Group, who had been contracted to conduct the Sunrise and Trademark Claims surveys. As such, the Working Group has not developed specific recommendations for this topic.

Nevertheless, based on the RPM Data Sub Team's suggestion, the Working Group is expected to consider one additional general question following its review of all public comments to this Initial Report: "**How, and to what extent, does use of Protected Marks Lists (e.g. blocking services) affect the utilization of other RPMs, especially Sunrise registrations?**" This question is related to the General Overarching Charter Question #1 as described above.

¹³⁵ See the TM-PDDRP survey questions targeting the TM-PDDRP Providers here:

https://www.google.com/url?q=https://community.icann.org/download/attachments/59644078/PDDRP%2520Questions%2520List.docx?version%3D1%26modificationDate%3D1465585803000%26api%3Dv2&sa=D&ust=1583518417453000&usg=AFQjCNE4kecyhiCaKHX5VAY_e9OSCo154A

¹³⁶ See the final set of proposed questions for Additional Marketplace RPMs here:

<https://community.icann.org/download/attachments/69283988/CLEAN%20Draft%20Final%20Additional%20Marketplace%20RPM%20Questions%20-%2015%20September%202017.pdf?version=1&modificationDate=1505764402000&api=v>

11 Annex C – Working Group Documents

The Working Group prepared a number of documents to conduct the review of each Phase 1 RPM, analyze data and input from numerous sources, develop preliminary recommendations, and evaluate proposals submitted by individual Working Group members.

This Annex lists some of the documents that were used by the Working Group in the course of its deliberations, and is included in this Initial Report to provide the community with a sense of the extent of the work involved, the tools/formats that were used, and the Working Group's discussion processes.

Please note, however, that this list is not a comprehensive record of all of the documents that the Working Group used during its deliberations. To see the complete record of all the Working Group documents, including records of all Working Group and Sub Team meetings, please visit the Working Group wiki workspace¹³⁷.

11.1 URS Documents

- Individual Proposals for URS Policy Recommendations & Operational Fixes -- Initial Report Review (22 January 2020):
https://docs.google.com/document/d/110tgExAlgzrCbuiy0OiefXG2mKbo_SCLrU037zErN2k/edit?usp=sharing
- Sub Team Proposals for URS Policy Recommendations & Operational Fixes for Initial Report (12 December 2019):
https://docs.google.com/document/d/1jlsM6yl3A9ssPdHymjZwoSQXsncl8h_9oOE1vFYm9o/edit?usp=sharing
- Working Group Survey to Ascertain More Specific Support Levels for Inclusions of the Individual Members' Proposals in the Initial Report (3 November 2019):
<https://community.icann.org/download/attachments/93126760/URS%20Individual%20Proposal%20Survey%20Result.pdf?version=1&modificationDate=1576086277000&api=v2>
- URS proposals submitted by individual Working Group members:
<https://community.icann.org/display/RARPMRIAGPWG/URS+Proposals#URSProposals--324377862> (September-October 2018)
- Super Consolidated URS Topics Table with Findings, Issues, Suggestions from All Three URS Sub Teams for Working Group Discussion (31 August 2018):
<https://docs.google.com/document/d/1YR7f60lkbaTyWJLaWvMVultyvxuyjlp2uDE27B-SN30/edit?usp=sharing>

¹³⁷ <https://community.icann.org/x/wCWAaw>

- Responses from URS Providers (ADNDRC, MFSD, FORUM) to Sub Team-Developed Survey (23 August 2018): https://docs.google.com/spreadsheets/d/1l-ge_I4OkQT7IU_rjHMQVa9Ebj8Ik6vay1vr5Yt9Zlg/edit?usp=sharing
- List of Topics for Review of the URS (31 July 2018): <https://community.icann.org/download/attachments/90769206/Consolidated%20URS%20Discussion%20Document%20-%20updated%2031%20July%202018v2.docx?version=1&modificationDate=1533145538000&api=v2>
- Staff Report of URS Cases and Initial Metrics:
 - Compilation Report (31 July 2018): https://community.icann.org/download/attachments/90769206/Staff%20compilation%20report%20-%20updated%20URS%20data_v1.1%20-%2009%20July%202018.docx?version=2&modificationDate=1533053814000&api=v2
 - Claims Denied Cases (28 August 2018): https://community.icann.org/download/attachments/90769206/claim_denied_analysis_v0.3%20-%20with%20UPDATED%20notes.docx?version=1&modificationDate=1535564718000&api=v2
 - De Novo Review Cases (23 July 2018): <https://community.icann.org/download/attachments/90769206/Summary Table - URS Final Determination Cases as of Dec 2017 - UPDATED 25 July 2018.docx?version=1&modificationDate=1533053859000&api=v2>
 - Cases with Final Determination (23 July 2018): <https://community.icann.org/download/attachments/90769206/Summary Table - URS Final Determination Cases as of Dec 2017 - UPDATED 25 July 2018.docx?version=1&modificationDate=1533053859000&api=v2>
- Responses from URS Practitioners to Sub Team-Developed Survey (12 June 2018): <https://community.icann.org/download/attachments/86606544/URS Practitioners Survey Summary Results 12 June 2018.pdf?version=1&modificationDate=1528859972000&api=v2>
- Mapping of URS Rules, URS Procedure, and URS Providers' Supplemental Rules (14 May 2018): <https://docs.google.com/spreadsheets/d/1Ej4rcuW3qYnj-vuMNZ2jF6aY6eoQOg9nGjj8H5rztWY/edit?usp=sharing>
- Analysis of URS cases performed by Professor Rebecca Tushnet, a Working Group member (2 May 2018): <https://www.dropbox.com/s/1dodxsqkauqp1vr/URS%20Case%20Review%20-%20Final.xlsx?dl=0>

11.2 TMCH Documents

- Proposed Answers to TMCH Charter Questions & Proposals for Community Input Agreed by the Working Group (23 October 2019) <https://docs.google.com/document/d/1YkrdpK0-JiVqEiIXi-C4CpbBK6SzmNidbYZeXMFitiw/edit#>

- Status of Working Group Discussions on Agreed TMCH Charter Questions (17 October 2019):
<https://drive.google.com/a/icann.org/file/d/1XVBTQEKU2zTCnaXAMIPGiUnFedKp8SZI/viw?usp=sharing>
- TMCH proposals submitted by individual Working Group members (April-May 2017 & September-October 2019): <https://community.icann.org/x/HJOGBg>
- Chronological Listing of Source Documents for the Trademark Clearing House (TMCH) (9 August 2019):
https://docs.google.com/document/d/17wmc_hmA25KXOL7W43A4vKyAeQnrxiUrU3ewCa8VYoA/edit?usp=sharing
- Tabular summaries of categorized, final TMCH Charter Questions, data reports and related discussions (February - March 2017): https://community.icann.org/x/_pHRAw

11.3 Sunrise & Trademark Claims Services Documents

- Sunrise Sub Team Recommendations Endorsed by RPM PDP Working Group (24 July 2019):
https://drive.google.com/open?id=1WRKL_3JfzWtRIBmutxthyaEtO6yirn9XtgImWaB0eZk
- Trademark Claims Sub Team Recommendations Endorsed by RPM PDP Working Group (17 July 2019):
https://drive.google.com/open?id=1jlu8SSGBh297PFAHPy_F59iqO7RD4c2MCNWG5ZDLwR_s
- Summary Table of Final Agreed Sunrise Questions, Data & Discussions (30 May 2019):
https://drive.google.com/open?id=1WmHmHz_fO6nrzkyXkgQ7uVoLEksyqQ1Kl6dENJf9yal
- Summary Table of Final Agreed Trademark Claims Questions, Data & Discussions (20 May 2019):
<https://drive.google.com/open?id=1sHelCAyd5ptxRynuG4LWQAR8q3fZfj3nffw1SqsUtXo>
- Sunrise and Trademark Claims proposals submitted by individual Working Group members:
<https://community.icann.org/pages/viewpage.action?pageId=102146375#SunriseClaims--324377862> (27 March 2019)
- Analysis Tool for Previously Collected Data Related to Sunrise & Trademark Claims (27 February 2019):
https://docs.google.com/spreadsheets/d/1SzvdmVhY8dZ4I_ZGVoN5IOSueHNzbn1jQErssAJI8QQ/edit?usp=sharing
- Additional Data related to Sunrise & Trademark Claims (20 February 2019):
https://docs.google.com/spreadsheets/d/13cFaDug4DKMyajz_t1hunV6U4MSiyFFWbWBNGD4ppN0/edit?usp=sharing
- Analysis Tool for Sunrise & Trademark Claims Survey Results (12 December 2018):
<https://docs.google.com/spreadsheets/d/1aBw-dW2gBzvBfhUgl3u6ShWIPZt0yyNF-Vs1qmUuljg/edit?usp=sharing>

11.4 TM-PDDRP Documents

- Analysis of ICANN community responses to TM-PDDRP survey (18 October 2016): <https://community.icann.org/download/attachments/61606586/Consolidated%20GNSO%20RPM%20WG%20Survey%20with%20graphs.docx?version=1&modificationDate=1476828167000&api=v2>
- Collated information from Working Group members concerning perceived abuse by new GTLD Registry Operators relating intellectual property rights (17 October 2016): <https://community.icann.org/download/attachments/61606586/Collated%20Examples%20Of%20Perceived%20Registry%20Conduct%20within%20TM-PDDRP%20scope%20-2017%20Oct%202016.pdf?version=1&modificationDate=1476830337000&api=v2>
- Compilation of survey questions and responses from TM-PDDRP Providers (June/September 2016): <https://community.icann.org/x/ugqsAw>

11.5 Additional Marketplace RPMs Documents

- Categorization of Additional Marketplace RPM Questions by Target Stakeholder/Respondent (10 March 2018 & 4 October 2017): <https://static.ptbl.co/static/attachments/169149/1520706764.pdf?1520706764> and <https://static.ptbl.co/static/attachments/169133/1520694505.pdf?1520694505>
- Summary Compilation of Information on Additional Marketplace RPMs (Protected Marks List Services) (21 September 2017): <https://static.ptbl.co/static/attachments/169136/1520695803.pdf?1520695803>
- Final set of proposed questions related to the additional marketplace RPMs that was considered by the Working Group (15 September 2017): <https://community.icann.org/download/attachments/69283988/CLEAN%20Draft%20Final%20Additional%20Marketplace%20RPM%20Questions%20-%2015%20September%202017.pdf?version=1&modificationDate=1505764402000&api=v2>
- Initial list of questions proposed by the Working Group Co-Chairs (28 May 2017): <https://community.icann.org/download/attachments/66080081/Questions%20for%20Private%20Protections%20Sub%20Team%20-%20For%20WG%20Discussion%20-%2028%20May%202017.docx?version=1&modificationDate=1497552761000&api=v2>

12 Annex D – Working Group Membership and Attendance

12.1 Working Group Membership and Attendance

The members of the full Working Group are listed below. Note that this list was accurate as of the publication of this report. Some members joined the Working Group only after it began meeting but left during its deliberation.

Name	Affiliation
Alyne De Andrade De Oliveira Bezerra	At-Large
Mona Al Achkar	At-Large
Plamena Petrova Popova	At-Large
Sean Martin McDonald	At-Large
Vinzenz Heussler	At-Large
Alison Simpson	BC
Beth Allegretti	BC
Gabriela Szlak	BC
Jay Chapman	BC
Margie Milam	BC
Marie Pattullo	BC
Nat Cohen	BC
Susan Kawaguchi	BC
Mathieu Weill	ccNSO
Heather Costelloe	CSG
Brian Beckham - Co-Chair	GAC
Jaifa Mezher Arango	GAC
Alexandra Perry	Individual
Alonso Mayordomo Castilla	Individual
Andrew Sadler	Individual
Arthur Fouré	Individual
Ben Menor Jr.	Individual
Brian Hayes	Individual
Charles Oluoch Oloo	Individual
Christine Farley	Individual
Christopher M. Thomas	Individual
Cindy Spencer	Individual
Colin O'Brien	Individual
Cyntia King	Individual
Dale Nelson	Individual
Danielle Abel	Individual
Daniel Loka	Individual
Danny Glix	Individual

Name	Affiliation
Dan Weinstein	Individual
Dominic DeLuca	Individual
Elisa Cooper	Individual
Elizabeth Kathryn Brock	Individual
Elizabeth Orembo	Individual
Elliot Silver	Individual
Flip Petillion	Individual
Gary Saposnik	Individual
Georges Nahitchevansky	Individual
Gerald M. Levine	Individual
Hasanuzzaman Lasker	Individual
Ines Hfaiedh	Individual
Ivett Paulovics	Individual
Jan Janssen	Individual
Jeff Lloyd	Individual
Joe Styler	Individual
Josh A. Partington	Individual
Julien Chaisse	Individual
Justin Bukspan	Individual
Justine Chew	Individual
Kamila Sekiewicz	Individual
Khaled Koubaa	Individual
Kostantinos Oikonomoy	Individual
Kurt Pritz	Individual
Liz Orembo	Individual
Louise Marie Hurel	Individual
Mariia Parubets	Individual
Mark Massey	Individual
Mary Forbes	Individual
Massimo Vittori	Individual
Michael De Wit	Individual
Mike Russell	Individual
Mitch Stoltz	Individual
Monica Mitchell	Individual
Patricia Aufderheide	Individual
Paul Raynor Keating	Individual
Paul Tattersfield	Individual
Peter Muller	Individual
Rebecca Tushnet	Individual
Renee Fossen	Individual
Renee Reuter	Individual
Robin Cali	Individual
Roger Oteng Baah	Individual
Ryan Pearce	Individual
Salvador Camacho Hernandez	Individual

Name	Affiliation
Shiva Kanwar	Individual
Steven M. Levy	Individual
Sue Williams	Individual
Takashi Nagazaki	Individual
Thomas Brackey	Individual
Toni Ojala	Individual
Vaibhav Aggarwal	Individual
Voica Emil Catalin	Individual
Yogesh Malik	Individual
Zak Muscovitch	Individual
Zhou Heng	Individual
Alistair Payne	IPC
Ankur Raheja	IPC
Brian J. King	IPC
Brian Scarpelli	IPC
Brian Winterfeldt	IPC
Caroline Chicoine	IPC
Claudio DiGangi	IPC
David Einhorn	IPC
David Taylor	IPC
Diana Arredondo	IPC
Doug Isenberg	IPC
Emily Weaver	IPC
Greg Shatan	IPC
Griffin Barnett	IPC
Heather Forrest	IPC
Hector Ariel Manoff	IPC
Jim Bikoff	IPC
Jonathan Agmon	IPC
John McElwaine - GNSO Council Liaison	IPC
Kiran Malancharuvil	IPC
Liz Williams	IPC
Lori Schulman	IPC
Marc Trachtenberg	IPC
Michael Flemming	IPC
Michael R Graham	IPC
Michael Peroff	IPC
Mike Rodenbaugh	IPC
Nick Wood	IPC
Pascal Boehner	IPC
Petter Rindforth	IPC
Phillip Marano	IPC
Sarah Deutsch	IPC
Scott R. Austin	IPC
Susan Payne	IPC

Name	Affiliation
Zaki Ahmed Siddiqui	IPC
Paul McGrady	IPC
Amr Elsadr	NCSG
Kathy Kleiman - Co-Chair	NCSG
Monika Zalnierute	NCSG
Wisdom Donkor	NCSG
Benjamin Akinmoyeje	NCUC
Dina Solveig	NCUC
Farzaneh Badii	NCUC
Huthaifa Mohammad Albustanji	NCUC
Michael Karanicolas	NCUC
Padmini Baruah	NCUC
Renata Aquino Ribeiro	NCUC
Roxanne John	NCUC
Sarah Clayton	NCUC
Sonigitu Asibong Ekpe	NCUC
Taiwo Peter Akinremi	NCUC
Yuri Chumak	NCUC
Martin Silva Valent	NPOC
Poncelet Ileleji	NPOC
Rudi Vansnick	NPOC
Jeff Neuman	RrSG
Laurie Anderson	RrSG
Reg Levy	RrSG
Roger Carney	RrSG
Theo Geurts	RrSG
Volker Greimann	RrSG
Hector Gonzalez	RySG
Alan Woods	RySG
Elizabeth (Beth) Bacon	RySG
David Maher	RySG
David McAuley	RySG
Jason Schaeffer	RySG
Jonathan Frost	RySG
Jon Nevett	RySG
Kristine Dorrain	RySG
Lillian Fosteris	RySG
Maxim Alzoba	RySG
Philip S. Corwin - Co-Chair	RySG
Scott Harlan	RySG

Additional information

- Statement of Interest of Working Group members:
<https://community.icann.org/x/3iWAAw>

- Detailed attendance records: <https://community.icann.org/x/7EqAAw>
- Email archives of the full Working Group: <http://mm.icann.org/pipermail/gnso-rpm-wg/>

12.2 Sub Team Membership

Membership was also tracked for all of the Sub Teams as well, which can be found on the Sub Team wiki workspaces below:

- TMCH Charter Questions: <https://community.icann.org/x/siK4Aw>
- TMCH Data Gathering: <https://community.icann.org/x/UwSbAw>
- RPM Data: <https://community.icann.org/x/fY1EB>
- Sunrise Charter Questions: <https://community.icann.org/x/nMrRAw>
- Sunrise Data Review: https://community.icann.org/x/3wT_BQ
- Trademark Claims Charter Questions: <https://community.icann.org/x/qMrRAw>
- Trademark Claims Data Review: https://community.icann.org/x/6QT_BQ
- URS Practitioners: <https://community.icann.org/x/yhW8B>
- URS Documents: <https://community.icann.org/x/1BW8B>
- URS Providers: <https://community.icann.org/x/3BW8B>
- Additional Marketplace RPMs: <https://community.icann.org/x/tcrRAw>

12.3 Observers

There were close to 100 observers to the full Working Group. Observers were allowed to receive messages from the Working Group, but were not able to post to the mailing list nor attend the Working Group meetings. As Observers, they were not required to submit Statements of Interest. A list of the Observers can be found at: <https://community.icann.org/x/3iWAAw>

13 Annex E – Community Input

13.1 Request for Input

According to the GNSO’s PDP Manual, a PDP Working Group should formally solicit statements from each GNSO Stakeholder Group and Constituency at an early stage of its deliberations. A PDP Working Group is also encouraged to seek the opinion of other ICANN Supporting Organizations and Advisory Committees who may have expertise, experience or an interest in the issue.

At the start of its deliberation on Phase 1, the Working Group reached out to all ICANN Supporting Organizations (SOs) and Advisory Committees (ACs) except for the Country Code Names Supporting Organization (ccNSO), as well as all GNSO Stakeholder Groups and Constituencies with requests for input.

The Working Group sought input for the following three questions:

1. What are your general views, concerns, and questions on the RPMs listed in Phase 1?
2. What issues concerning the Phase 1 RPMs are most relevant to your work and what do you feel it is essential that our Working Group be aware of or focus on as it proceeds in its tasks?
3. What questions and specific data points would you advise the Working Group to pursue in this data gathering effort?

In response, statements were received from the:

- Registries Stakeholder Group (RySG)
- Root Server System Advisory Committee (RSSAC)
- Security and Stability Advisory Committee (SSAC)

Their full statements can be found here: <https://community.icann.org/x/zheOAw>

13.2 Review of Input Received

All of the statements received were reviewed by the Working Group as part of its deliberations on relevant topics.