

GNSO Review of All Rights Protection Mechanisms in All gTLDs Policy Development Process Phase 1 Final Recommendations for ICANN Board Consideration:

NCSG Comments

April 30, 2021

About NCSG

NCSG represents the interests of non-commercial domain name registrants and end-users in the formulation of Domain Name System policy within the Generic Names Supporting Organisation (GNSO). We are proud to have individual and organizational members in over 160 countries, and as a network of academics, Internet end-users, and civil society actors, we represent a broad cross-section of the global Internet community. Since our predecessor's inception in 1999 we have facilitated global academic and civil society engagement in support of ICANN's mission, stimulating an informed citizenry and building their understanding of relevant DNS policy issues.

About this Public Comment Proceeding

<https://www.icann.org/public-comments/gnso-rpm-pdp-phase-1-final-recommendations-2021-04-07-en>

Highlighted topics about the background

The NCSG is glad to notice that the Working Group is being careful about stimulating discussions and opening the debate to those involved, taking those inputs seriously. It's possible to find some feedback complaining about the confusion of the initial report or the lack of objective of its opening to public comments. However, such a delicate proposal should be commented on by interested parties that are not part of the Working Group on every crucial step.

The initial report received substantial contributions until May 4, 2020, resulting in the final piece we are commenting on. Full consensus support of the Working group on 34 out of the total 35 recommendations are a sign of this effort.

General commentaries

The NCSG highlights three of its most critical concerns on the subject of All Rights Protection Mechanisms (RPMs). They are: (i) the disclosure of personal data from registrants, which could endanger human rights in many parts of the world; (ii) the possibility of abuse of intellectual property rights by its owners against good faith registrants¹; (iii) the accessibility and clear writing of those mechanisms, considering their comprehensibility in as many languages as possible.

These concerns were largely targeted in the final recommendations, especially those related to the URS (such as its Final Recommendation #2 to #4, #8 to #11 and #13). The response has often not been in the direction of ensuring the greatest security for non-commercial users, but some beneficial changes were proposed.

The only recommendation that did not receive complete consensus was TMCH Final Recommendation #1. The minority opinion here was drafted by Jason Schaeffer, Jay Chapman, Michael Karanicolas, Mitch Stoltz, Nat Cohen, Rebecca Tushnet, and Zak Muscovitch.

We consider that the minority opinion should have been taken more seriously and became the prevailing one, noting also the participation in its drafting of globally recognized names in the study of intellectual property and domain names.

The "Working Group Members Minority Statement on TMCH Final Recommendation #1", in Annex D (starting at p. 131) presents why the recommendation could be strongly improved by minor modification on its text, clarifying the concept of "word-mark" and avoiding ambiguities that could result in a broad interpretation of the concept.

Reaffirming what has already been pointed out in detail in Annex D, the TMCH Final Recommendation #1 is based on a fragile definition of an essential concept, namely "word-mark". It is circular² and much wider than the ones commonly used in other ICANN-related rules and guides³, including those marks that - in many jurisdictions - are only considered distinctive by virtue of their conjunction with a figurative/graphical element⁴. In other words, some of these "word marks" are deeply generic words that were deemed distinct from the "commercial commons" because they were presented in a very unique or

¹ Others largely repeated this concern in answers to the General Overarching Charter Question #1, Additional Overarching Charter Question #1, and General Content Question #1, in <https://docs.google.com/spreadsheets/d/1wke2krmhV2tNPNhviOskAILVraWp-88mqzScCtj01fw/edit#gid=872694278>

² Footnote n. 169 of the Minority Opinion

³ See p. 133 of the Final Draft

⁴ See the potentially harmful examples that already exist in Deloitte's database, pointed out in pp. 135-137, such as "Parents", "Dealhunter", "Music", "Cars", "A" and "Own Your Power"

unusual graphic format. Ultimately, this is a loophole could easily be abused by bad-faith IPR holders, even though the overwhelming majority use the mechanism regularly⁵.

We agree that referring to the rules adopted by the GNSO Council & ICANN Board (i.e., STI) and the Applicant Guide Book would help be a positive step to fend off an expansion of the rights related to domain names instead of just recognizing them efficiently. TMCH Final Recommendation #3 seems to take good steps toward resolving the issue, but this recommendation is not a deterrent to making the clarification presented in the minority statement.

Specific commentaries

- About the Overarching Charter Questions

Answers provided during the public comment period could have been more detailed in the final report. "General Overarching Charter Question #1" and "Additional Overarching Charter Question #1" are essential questions that received valuable input, but those inputs were seemingly sidelined. The refusal to even discuss this point in depth by some groups is a serious barrier to the further legitimization of RPMs, preventing their eventual expansion from being considered.

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

In the proposed response to TMCH Question #10, implicit in the related discussion, there appears to be an attempt to expand trademark rights beyond their characteristic scope of protection in many jurisdictions worldwide. This attempt is highly problematic. It seems to go beyond the RPM's role of simply recognizing rights and should be closely monitored by Working Group members to prevent such changes.

The lack of a proposed answer in TMCH Question #14 is equally important since this is a transparency issue. It is hard to find a legitimate reason to avoid simple conclusions in a primarily descriptive situation, even if they are just pointers to the necessity of collecting more data.

- About Sunrise Service Final Agreed Charter Questions & Proposed Answers

The uncertainty of the unintended effects of Sunrise is undoubtedly a good reason to worry about the overall effectiveness of this system. Preamble Q(b) to Q(f) should be the focus of the next steps on RPM, since the justification for improving, expanding or reformulating the system must identify the problems that it is possibly generating.

⁵ See p. 134 of the Final Draft

The difficulty in developing the debate on these essential points, perhaps due to the lack of available objective data, leads to a more passive position of the Working Group in the final recommendations regarding Sunrise.

- About Trademark Claims Service Final Agreed Charter Questions & Proposed Answers

The proposed answers to Q1 are even more worrisome than in the previous topic. The conclusion presented that the intended results are only possibly being achieved must be taken into account in any further discussion of expanding this mechanism. This is particularly relevant in light of the discussion about the freedom of registrars to adopt new RPMs.

Even so, the final recommendations listed in the report, especially #6, are positive and seem to be on a fruitful path despite fundamental disagreement about the efficiency of the mechanism.