

Phase 1 Final PDP Recommendations

Introduction

The PDP Working Group has finalized a total number of thirty-five (35) recommendations for the GNSO Council consideration. The Working Group expects that the GNSO Council and ultimately the ICANN Board will approve and implement all recommendations set forth in this Final Report, and ICANN org will work closely with an Implementation Review Team (IRT) to ensure that implementation takes place in line with the Working Group's intent.

The Working Group has classified its recommendations for each of the Phase 1 RPMs into three categories:

1. **Recommendations for new policies or procedures:** these recommendations indicate the Working Group's agreement that new policies or procedures are necessary to improve the RPMs launched under the 2012 New gTLD Program, such as to enable fulfillment of the objectives for their creation and enhance their effectiveness in the next new gTLD expansion round.
2. **Recommendations to maintain status quo:** these recommendations indicate the Working Group's agreement that an element of the Phase 1 RPMs and associated structures and procedures is, and continues to be, appropriate, or at a minimum acceptable, to continue in the next new gTLD expansion round.
3. **Recommendations to modify existing operational practice:** these recommendations indicate the Working Group's agreement that modifications to existing operational practices related to the Phase 1 RPMs are necessary to improve their effectiveness, but their underlying structures or procedures do not require changes.

Early on in its work, the RPM Working Group agreed that a thorough and meaningful review of all the Phase 1 RPMs required access to historical data as well as regularly-updated data in the future. Although the Working Group engaged in extensive data collection and analysis efforts during its deliberations, it encountered challenges in obtaining sufficient quantitative data (as opposed to anecdotal reports) concerning the effectiveness of the Phase 1 RPMs. Therefore, the Working Group also put forward an Overarching Data Collection Final Recommendation aiming at addressing this data-related gap.

Some recommendations contain "Implementation Guidance", which commonly refers to how a recommendation should be implemented. The Working Group strongly recommends the stated action in the implementation guidance for consideration by the IRT, with a strong presumption that it will be implemented, but recognizes that there may exist valid reasons in particular circumstances to not take the recommended action exactly as described. However, the party to whom the action is directed must make all efforts to achieve the purpose behind the recommended action (as expressed in the Recommendation, agreed policy principles, and contextual language to which the Implementation Guidance is linked, if applicable) even if done through a different course. In all cases, the full implications must be understood and carefully weighed before choosing a different course.

This Phase 1 Final Report states the level of consensus within the PDP Working Group achieved for the different recommendations. In short:

- TBD

The Working Group’s review of the public comments submitted for the Initial Report resulted in the Phase 1 final recommendations. The Working Group used sub groups to review the public comments concerning the preliminary recommendations published in its Phase 1 Initial Report. Sub groups’ suggestions and public comment review outcomes were brought back to the full Working Group for consideration prior to a formal consensus call being conducted, in accordance with the GNSO Working Group Guidelines, on potential final recommendations. Please see the text under the “Public Comment Review” section of each recommendation for additional details regarding whether and how the public comments shaped the final recommendations.

At the plenary level, the full Working Group also reviewed the public comments relating to proposals published in the Initial Report that did not rise to the level of preliminary recommendations, as well as comments pertaining to overarching Charter questions and general input.

In developing its Phase 1 final recommendations, the Working Group also discussed recommendations developed by the Competition, Consumer Trust and Consumer Choice Review Team (CCT-RT) and referenced the relevant sections in the Wave 1 Report of the Expedited PDP (EPDP) on a Temporary Specification for gTLD Registration Data Phase 1 Recommendation #27. The results of the Working Group’s review of these efforts are reflected in the final recommendations presented in this report. Please see the “Background” section of this Final Report for additional details.

As part of its Phase 1 work, the Working Group also looked at a number of additional marketplace RPMs that several Registry Operators and the TMCH Validation Provider had voluntarily adopted, over and above the mandatory ICANN RPMs. However, the Working Group agreed that developing recommendations for these voluntary market mechanisms was outside the scope of this PDP. Please see the “Additional Marketplace RPMs” section of this Phase 1 Final Report for details of the Working Group’s discussion of this topic.

Uniform Rapid Suspension (URS) Final Recommendations

URS Recommendations for New Policies or Procedures

URS Final 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).

Context:

This recommendation specifically concerns the following parts of the URS Rules and URS Procedure:¹

- **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 the European Union’s General Data Protection Regulation (GDPR), personally identifiable information, including a registrant’s contact details, has been 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 GDPR.² 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 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.³ 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

¹ URS Rules can be downloaded here: <https://newgtlds.icann.org/en/applicants/urs/rules-28jun13-en.pdf>; URS Procedure can be downloaded here: <https://newgtlds.icann.org/en/applicants/urs/procedure-01mar13-en.pdf>.

² 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>.)

³ **BERO:** Back-end Registry Operator

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 Recommendation #21 that suggested that the RPM PDP Working Group consider whether existing URS requirements needed updating, 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 if a complainant should be given the opportunity to update its complaint upon receiving updated data. The EPDP work also included Recommendation #23 and Recommendation #27 that suggested updates be made to existing procedures and rules impacted by the GDPR.⁴ The Working Group believes that its recommendation is consistent with the EPDP Phase 1 Recommendations #21, #23, and #27, as well as the analysis in the ICANN Org EPDP Phase 1 Recommendation #27 Wave 1 Report.⁵

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 Complaint to satisfy the second and third URS elements.⁶ 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. The Working Group further notes that this recommendation maintains consistency with the EPDP Team’s Phase 1 recommendations, affirming that a complaint will not be deemed administratively deficient for failure to provide the name of the Respondent and all other relevant contact information if such information of the Respondent is not available in registration data publicly available in RDDS or not otherwise known to Complainant.

Public Comment Review:

The Working Group agreed that public comments did not raise any new or material perspectives, facts,

⁴ **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. **EPDP Recommendation #23:** Defines requirements for URS/UDRP to ensure the procedures continue to function given other EPDP recommendations. **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 Final Report.

⁵ See the ICANN Org EPDP Phase 1 Recommendation #27 Wave 1 Report here:

<https://gns0.icann.org/sites/default/files/file/field-file-attach/epdp-phase-1-recommendation-27-18feb20-en.pdf>.

⁶ 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.

or solutions. The Working Group also agreed that there was no widespread or substantial opposition to this recommendation. Therefore, the Working Group agreed that the recommendation be maintained “as is”.

URS Final Recommendation #2

The Working Group recommends that 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, URS Panelists have the discretion to decide whether to publish or redact such data in the Determination. The Working Group further recommends that each URS party has the right to request that Panelists consider redacting registration data elements from publication as part of the Determination.

Context:

This recommendation specifically concerns the following parts of URS Rules:

- **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 published.⁷

This final recommendation, 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.

The Working Group put forward URS Question #1 in its Initial Report and sought community input as to whether it would 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.⁸

In agreeing to put out this question for public comments, the Working Group noted the Phase 1 recommendations from the EPDP Team on the Temporary Specification for gTLD Registration Data that are relevant to the RPMs. Specifically, the Working Group considered the GNSO Council’s request that the Working Group consider EPDP Phase 1 Recommendations #21, #23, and #27.⁹ Furthermore, ICANN org’s EPDP Phase 1 Recommendation #27 Wave 1 Report suggested that the Working Group reference Purpose 6-PA5 from the EPDP Phase 1 Final Report when making recommendations as to the publication of registration data elements in URS Determinations.¹⁰ Purpose 6-PA5 references the GDPR FAQ of WIPO, a Uniform Domain Name Dispute Resolution Policy (UDRP) Provider, with regard to publishing registration data elements.

⁷ See the complete text of URS Rule 15 here: <http://newgtlds.icann.org/en/applicants/urs/rules-28jun13-en.pdf>

⁸ See URS Question #1 in the RPM PDP Phase 1 Initial Report on pp.31-32:

<https://gns0.icann.org/sites/default/files/file/field-file-attach/rpm-phase-1-initial-18mar20-en.pdf>

⁹ Please see the full text of EPDP Recommendations #21, #23, and #27 in the “Background” section of this Final Report.

¹⁰ See the full text of Purpose 6-PA5 on p.139 of the EPDP Phase 1 Final Report here:

<https://gns0.icann.org/sites/default/files/file/field-file-attach/epdp-gtld-registration-data-specs-final-20feb19-en.pdf>

In view of the public comments received and Purpose 6-PA5 in the EPDP Phase 1 Final Report, the Working Group agreed on this new recommendation after extensive discussions.

The Working Group noted that, prior to the EPDP, the standard practice had been for URS Providers to publish the party names in URS Determinations. According to FORUM, registration data published in the URS Determination usually consists of a Respondent's name, city, state, and country/territory. The Working Group agreed that the decision to publish or withhold registration data in Determinations should not hinge on whether a Respondent prevails or loses. Some members emphasized that publishing such registration data, in particular the party names, in the URS Determination is a matter of public record for accountability and transparency purposes.

However, the Working Group also agreed that there may be exceptional circumstances for redacting the registration data, including party names (e.g., identity theft, use of the information of a minor, revelation of a political dissident, etc.). The Working Group believed that either URS party should be able to raise the specific reason for the Panelists to consider and request publication or redaction of registration data, but it is ultimately up to the Panelist to decide whether publication or redaction is appropriate. The Working Group's recommended action is consistent with Purpose 6-PA5, which states that "any request to redact a party's name from a decision should normally be submitted for the panel's consideration". The Working Group's recommended action is also consistent with WIPO's practice for UDRP decisions, where in a fair number of UDRP cases, Respondents' names are redacted in the published Determinations at a Panelist's discretion.

Some Working Group members also believed that leaving the decision to the Panelists would mitigate potential concerns regarding defaulting Respondents not providing Panelists with reasons for party name redaction.¹¹ The Working Group's review of data from over 900 URS cases found that a large majority of cases resulted in Default Determinations, meaning that no Response to a Complaint was filed by a Respondent. The Working Group recognized that there was a noticeable number of defaulting Respondents who prevailed in URS proceedings.

Public Comment Review:

The Working Group recognized that there were strong differences of opinion and a variety of responses to URS Question #1 in the RPM PDP Phase 1 Initial Report. However, the Working Group ultimately agreed to make this new recommendation, which incorporates input from public comments and is consistent with the EPDP Phase 1 recommendations.

URS Final Recommendation #3

The Working Group recommends that the URS Rules 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

¹¹ 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>

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.”

Implementation Guidance:

As implementation guidance, the Working Group recommends that the IRT consider the following:

- Preliminary submissions by either side to the Panel regarding the language of the proceeding should be limited to 250 words, and not be counted against the existing URS word limits.
- The Notice of Complaint should, where applicable, contain a section explaining that the Respondent may make a submission regarding the language of the proceedings.
- If a translation is ordered by the URS Examiner, as long as the original submission meets the word limits in the original language, the translation of the original submission may nominally exceed the prescribed word limit; for the avoidance of doubt, the translation may not introduce new facts or arguments which may be contained in the Language of Proceeding submission.
- The IRT should consider developing potential guidance to assist URS Examiners in deciding whether to deviate from the default language in the context of a particular proceeding. Such potential guidance may take into account the language of the relevant registration agreement (irrespective of whether the domain is registered through a privacy or proxy service or reseller). Such potential guidance could also consider the relevance of other factors, including but not limited to:
 - the language requested by one of the URS parties;
 - the predominant language of the country or territory of the registrant;
 - principles articulated in the relevant section (presently 4.5) of the WIPO Overview;¹²
 - the language used by the registrar and/or predominant language of the country/territory of the registrar, if different from the language of the registration agreement; and
 - the language/script used in the domain name (including the TLD), in particular if it is an Internationalized Domain Name.

Context:

This recommendation was developed following the Working Group’s review of public comments to URS Preliminary Recommendation #9, as well as URS Individual Proposal #34, which did not rise to the level of becoming a preliminary recommendation, but received sufficient support from the Working Group to be published in the Phase 1 Initial Report for public comment.¹³ This recommendation specifically

¹² See WIPO Overview Section 4.5 here: <https://www.wipo.int/amc/en/domains/search/overview3.0/#item45>

¹³ See the full text of the URS Preliminary Recommendation #9 on p.30 and URS Individual Proposal #34 on pp. 68-69 of the RPM PDP Phase 1 Initial Report: <https://gnso.icann.org/sites/default/files/file/field-file-attach/rpm-phase-1-initial-18mar20-en.pdf>

concerns the URS Rule 9.¹⁴

The Working Group noted that currently, the URS Rules (Rules #4 and #9 of the URS) only require that the Notice of Complaint be translated into the predominant language used in the registrant's country or territory, not the Complaint itself, which is currently required to be in English only. The Working Group agreed that this can put Respondents who do not understand English at a disadvantage in the process.

Nevertheless, the Working Group noted that FORUM and MFSD assign an Examiner who speaks the same language as the Respondent and also provide translations of notices, templates, and Determinations in the language of the Respondent.

FORUM informed the Working Group that it did not have significant issues identifying the predominant language of the registrant's country/territory. FORUM researches what the predominant language is in Respondent's physical location based on the registration information provided by the Registry by visiting various websites that curate information regarding predominant languages by country/territory. 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 helping Examiners determine the language to be used unless that information is relayed to them. FORUM provides the Notice of Complaint in English and the predominant language of the country or territory where the Proxy Service is located (very often Spanish). While the location of the privacy or proxy service will determine the language of that service, which may be relevant, the language in the location of the privacy or proxy service may be different from the language of the Respondent. A privacy shield is rarely lifted in a URS proceeding, and this makes it impossible for FORUM to determine the language likely spoken by the registrant.

Furthermore, if the Respondent resides in a region that has multiple predominant languages, research is needed to determine which language should be used. In some multilingual countries/territories, the percent split of the population speaking each one of the multiple predominant languages is negligible.

Therefore, the Working Group agreed that 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. The Working Group further agreed that this final recommendation will help provide URS Examiners a more definitive method to decide which language should be used for URS proceedings, irrespective of whether the domain is registered through a privacy or proxy service or reseller, or whether multiple predominant languages are spoken in the Respondent's physical location. Such clarity will help enhance the predictability for users involved in the URS proceeding while preserving Examiners' discretion to deviate from the default language where appropriate.

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

To be clear, the Working Group noted that URS providers would not be required to provide translations of pleadings (only the Notice of Complaint), so they 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 carried out by the parties.

Nevertheless, FORUM noted that in the context of URS proceedings, other than fulfilling obligations per URS Procedure para 4.4, it does not have contact with Registrars unless absolutely necessary to obtain registrant data unavailable from the Registry for whatever reason.¹⁵ In those rare instances when FORUM was forced to contact a Registrar for information, days were typically added to the process and 50% of the time FORUM encountered some push back on the request as it did not relate to a UDRP proceeding.

In addition, the Working Group also notes that ADNDRC communicates with Respondents only in English and is consequently non-compliant with URS Procedure para 4.2 and URS Rule 9(e). 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.

Public Comment Review:

Based on public comments received, the Working Group agreed that URS Individual Proposal #34, which served as the origin of this recommendation and implementation guidance, received wide support. The Working Group noted that, in essence, this recommendation seeks to apply the UDRP framework to determine the language of the proceeding in the URS. Although the URS Preliminary Recommendation #9 also received strong support from public comments, the Working Group agreed that this final recommendation should replace that preliminary recommendation.

In its deliberations of public comments, the Working Group discussed two different viewpoints about the language of the URS proceeding. One is that there should be an effort to enable respondents to be notified and have the proceeding in their own language as identified by the provider; another is to use the language of the registration agreement, unless decided otherwise by the Examiner. Ultimately, the Working Group agreed to recommend the approach based on the second viewpoint, which is consistent with the UDRP rules for the language of proceedings. The Working Group also adopted several suggestions raised in public comments on URS Preliminary Recommendation #9 to provide potential guidance to assist URS Examiners in deciding whether to deviate from the default language in the context of a particular proceeding. This potential guidance is noted in the fourth bullet and its sub bullets in the implementation guidance text.

Furthermore, FORUM suggested that the potential guidance can also include a list of ICANN sanctioned websites to review for the most accurate language data, a table of researched and approved languages for countries/territories with multiple languages, and/or guidance on what an acceptable percentage of population in a country/territory speaking certain language is to determine a language predominant.

¹⁵ URS Procedure para 4.4: The URS Provider shall also electronically notify the Registrar of record for the domain name at issue via the addresses the registrar has on file with ICANN.

URS Final Recommendation #4

The Working Group recommends that the URS Rule 4(b) and URS Procedure para 4.2 be amended to require the Provider to transmit the Notice of Complaint to the Respondent in English and translate it into the language of the Registration Agreement.

The Working Group further recommends that it be mandatory for URS Providers to comply with URS Procedure para 4.3 and transmit the Notice of Complaint to the Respondent via email, fax, and postal mail.

Context:

This recommendation specifically concerns the following parts of the URS Rules and URS Procedure:

- **URS Rule 4(b):** The Notice of Complaint to the Respondent shall be transmitted in English and shall be translated by the Provider into the predominant language used in the registrant's country or territory, as determined by the country(ies) listed in the Whois record when the Complaint is filed.
- **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 recommends that the Provider shall translate the Notice of Complaint to the Respondent into the language of the registration agreement. This final recommendation maintains consistency with the URS Final Recommendation #3, which concerns the language of proceeding. As registrants will have the opportunity to select a registration agreement in the language of their choice, the Working Group agreed that this final recommendation will help offer URS Providers a more definitive and predictable method to decide which language should be used for translating the Notice of Complaint, irrespective of whether multiple predominant languages are spoken in the Respondent's physical location or whether the domain is registered through a privacy or proxy service or reseller.

In addition, 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 the current 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 noted that URS Providers are unable to use courier services to deliver mail to P.O. box addresses. FORUM and MFSD also reported that mail, fax, and email to Respondents were sometimes not delivered.

Furthermore, in light of GDPR implementation and one of its effects that URS Providers now rely on the Registries and Registrars to forward non-public contact information and other relevant WHOIS/RDDS data of the registrant (as noted in the context of URS Final Recommendation #11), the Working Group believes that this recommendation does not contradict with the EPDP Phase 1 Recommendations, especially Recommendations #23 and #27 which suggested updates be made to existing procedures and rules impacted by the GDPR, as well as the analysis in ICANN org’s EPDP Phase 1 Recommendation #27 Wave 1 Report.¹⁶

Public Comment Review:

The Working Group discussed a suggestion raised in public comment regarding the Provider translating the Notice of Complaint into the language of the Registration Agreement. The Working Group ultimately adopted this suggestion to maintain consistency with URS Final Recommendation #3.

URS Final Recommendation #5

The Working Group recommends that the URS Procedure para 6.2 be amended to: (i) clearly define what “Default Period” means; and (ii) state that the registrant shall not change the public and non-public registration data elements related to the disputed domain name(s) during the Default Period.

The Working Group further recommends deleting the text “the Registrant will be prohibited from changing content found on the site to argue that it is now a legitimate use” from URS Procedure para 6.2, and incorporating it in other appropriate section(s) in the URS Procedure as factors which an Examiner may take into account in determining whether there was registration and use in bad faith.

Implementation Guidance:

For consideration of the IRT, the Working Group suggests that the deleted text may be incorporated in URS Procedure para 5.9 and/or 8.1.¹⁷

Context:

This recommendation was developed following the Working Group’s review of public comments to URS Individual Proposal #1, which did not rise to the level of becoming a preliminary recommendation, but received sufficient support from the Working Group to be published in the Phase 1 Initial Report for public comment.¹⁸

¹⁶ Please see the full text of these EPDP Phase 1 recommendations as well as the Wave 1 Report in the “Background” section of this Final Report.

¹⁷ See the full text of the URS Procedure para 5.9 and 8.1 here:
<http://newgtlds.icann.org/en/applicants/urs/procedure-01mar13-en.pdf>

¹⁸ See the full text of the URS Individual Proposal #1 on pp. 57-58 of the RPM PDP Phase 1 Initial Report:
<https://gns0.icann.org/sites/default/files/file/field-file-attach/rpm-phase-1-initial-18mar20-en.pdf>

This recommendation specifically concerns the following parts of the URS Procedure:

- **URS Procedure 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.

The Working Group agreed that the current language of URS para 6.2 needs to be amended in order to address technical issues and maintain consistency with the EPDP Team’s Phase 1 recommendations.¹⁹

The Working Group found that there is no definition of the phrase “Default Period” in its sole occurrence in the URS Procedure para 6.2; and this term is not defined anywhere else in the URS Rules, URS Procedure, or other URS related documentations. Based on the definition of the word “Default” pursuant to URS Rule 12(a), the Working Group understood that the Default Period starts when a URS case enters Default and ends when the Examiner issues a Default Determination.²⁰ For sake of clarity, the Working Group recommends that “Default Period” be clearly defined in URS Procedure para 6.2.

The current language of URS Procedure para 6.2 includes the phrase “Whois information”. ICANN Org’s EPDP Phase 1 Recommendation #27 Wave 1 Report suggests that the Working Group consider recommending an update to URS Procedure para 6.2 to clarify that a registrant shall not change the public and non-public registration data elements subject to URS proceedings during the Default Period.²¹ The Working Group agreed with this suggestion and is making a recommendation accordingly.

The Working Group also recommends replacing the use of the passive voice in the phrase “will be prohibited” in URS Procedure para 6.2 with the active voice, to provide direct instruction to the registrant, as no one but the registrant and its webhost can change the public and non-public registration data elements.

Furthermore, the Working Group agreed that a registrant’s action of changing website content can be taken into consideration by the Examiner, as to whether it might be further evidence of bad faith. Some Working Group members noted there may be legitimate or legal reasons for the registrant to update the content of a website, and some websites embed dynamically generated ads and social media feeds. Therefore, the Working Group recommends moving the prohibition against changing website content for domain names subject to URS proceedings to the appropriate section(s) in the URS Procedure as behaviors to be considered by the Examiners, who should make all reasonable inferences when finding bad faith.

¹⁹ Please see the full text of the EPDP Phase 1 recommendations #21, #23, and #27, as well as reference to the ICANN Org EPDP Phase 1 Recommendation #27 Wave 1 Report in the “Background” section of this Final Report.

²⁰ URS Rule 12(a): If 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. In case of Default, the Provider shall appoint an Examiner to review the Complaint for a prima facie case, including complete and appropriate evidence. See full text of the URS Rule 12 here: <http://newgtlds.icann.org/en/applicants/urs/rules-28jun13-en.pdf>

²¹ See the ICANN Org EPDP Phase 1 Recommendation #27 Wave 1 Report here: <https://gns0.icann.org/sites/default/files/file/field-file-attach/epdp-phase-1-recommendation-27-18feb20-en.pdf>.

Public Comment Review:

Based on the public comments received, the Working Group noted that URS Individual Proposal #1, which served as the origin of this recommendation, received general support with some opposition mostly from individual commenters. However, commenters also voiced preferences as between the two options indicated in the original proposal. The Working Group's final recommendation attempts to bridge the gap between the two options while maintaining consistency with the EPDP Team's Phase 1 recommendations.

URS Final Recommendation #6

The Working Group recommends that the URS Rule 6(a) be amended to clarify that each URS Provider shall maintain and publish a publicly available list of Examiners and their qualifications through regular updating and publication of their Examiners' curriculum vitae.

The Working Group further recommends that the URS Procedure para 7 be amended to add a requirement that each URS Provider shall publish their roster of Examiners who are retained to preside over URS cases, including identifying how often each one has been appointed together with a link to their respective decisions.

Implementation Guidance:

To assist the IRT that will be formed to implement recommendations adopted by the Board from this PDP, the Working Group has developed the following implementation guidance:

- As URS Providers cannot compel Examiners to provide updates or verify if there are changes to each Examiner's qualifications and professional affiliations, URS Providers shall be required to request that Examiners update their CV's as prescribed, keep their CV's current and submit any updates to the Provider;
- It will be sufficient to satisfy the objective of providing public visibility of Examiner rotations for if a Provider's website provides a mechanism or function where one can search for those URS decisions that a specific Examiner presided over.

Context:

This recommendation was developed following the Working Group's review of public comments to URS Individual Proposals #26 & #27, which did not rise to the level of becoming preliminary recommendations, but received sufficient support from the Working Group to be published in the Phase 1 Initial Report for public comment.²²

This recommendation specifically concerns the following parts of the URS Rules and URS Procedure:

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

²² See the full text of the URS Individual Proposals #26 and #27 on pp. 64-65 of the RPM PDP Phase 1 Initial Report: <https://gns0.icann.org/sites/default/files/file/field-file-attach/rpm-phase-1-initial-18mar20-en.pdf>

- **URS Procedure para 7.3:** Examiners used by any given URS Provider shall be rotated to the extent feasible to avoid forum or examiner shopping. URS Providers are strongly encouraged to work equally with all certified Examiners, with reasonable exceptions (such as language needs, non-performance, or malfeasance) to be determined on a case by case analysis.

In examining the URS Providers' websites, the Working Group found that some URS Providers did not seem to publish all of their Examiner's CV's. As the URS Rule 6(a) only requires the Provider to list the Examiner's qualifications, the Working Group agreed that this rule should be clarified to expressly require publication of a current CV of the Examiner, which will help inform the URS parties and other stakeholders involved in the URS proceeding of the Examiner's suitability for appointment in a URS proceeding.

Based on input from FORUM, the Working Group acknowledged that it may not be possible for URS Providers to compel Examiners to update their CVs, or actively keep track of professional/career related changes of their Examiners such as to make determinations on whether any particular CV is or is not current. As implementation guidance, the Working Group agreed that the Providers be required to request that Examiners update their CVs as prescribed, keep their CV's current, and submit the latest versions once updated.

The Working Group also noted that the current URS Procedure does not adequately provide the public with visibility into the rotation of Examiners to determine to what extent such Examiner appointments are random or well distributed. The Working Group found that while most URS Providers already publish their roster of Examiners, they may not take the further step of identifying the number or frequency of their appointments, or linking to their respective decisions beyond the general publication of all URS decisions. Therefore, the Working Group further recommends that the URS Providers shall make their roster of Examiners publicly searchable based on the decisions of URS cases that they preside over. This is to ensure that the Examiner rotation, as required in URS Procedure para 7.3, can be confirmed by the public.

The Working Group noted that FORUM, one of the URS Providers, offers a decision search function on its website -- decisions can be filtered by the URS cases and specific Examiners who presided over these cases; each decision can be displayed in response to a search based on the name of the Examiner. As implementation guidance, the Working Group agrees that it will be sufficient to satisfy the objective of this recommendation if a Provider's website already provides such a mechanism or function similar to FORUM's (i.e., one can search for URS decisions that an Examiner presided over).

Public Comment Review:

Based on the public comments received, the Working Group noted that URS Individual Proposals #26 and #27, which served as the origin of this recommendation, received wide and similar levels of support. Due to the close relationship between these two proposals, the Working Group agreed to put forward a recommendation which consolidates and bundles these two proposals in sequence. In addition, based on public comments from FORUM, the Working Group agreed to add implementation guidance

language to provide practical flexibility with regard to implementing this recommendation for consideration by the IRT.

URS Final Recommendation #7

The Working Group recommends that the URS Rule 6 be amended to add a requirement that each URS Provider shall publish an effective Examiner Conflict of Interest (COI) policy that the Provider reasonably enforces against any Examiners who violate such policy.

Context:

This recommendation was developed following the Working Group's review of public comments to URS Individual Proposal #28, which did not rise to the level of becoming a preliminary recommendation, but received sufficient support from the Working Group to be published in the Phase 1 Initial Report for public comment.²³

This recommendation specifically concerns the following parts of the URS Rules:

- **URS Rule 6(b):** An Examiner shall be impartial and independent and shall have, before accepting appointment, disclosed to the Provider any circumstances giving rise to justifiable doubt as to the Examiner's impartiality or independence. If, at any stage during the URS proceeding, new circumstances arise that could give rise to justifiable doubt as to the impartiality or independence of the Examiner, the Examiner shall promptly disclose such circumstances to the Provider. In such event, the Provider shall have the discretion to appoint a substitute Examiner.

The Working Group had diverging opinions on the adequacy of the current rules as regards to handling conflicts of interest for URS Examiners. On the one hand, some members believed that currently there is no known COI 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(b). Thus, these members believed that 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 himself or herself in a URS proceeding.

On the other hand, some Working Group members questioned the necessity of this recommendation. They agreed that in general there are already policies that appropriately prevent conflict of interest pursuant to URS Rule 6(b). They understood that each URS Provider implements its own individually-developed COI policy (akin to supplemental rules), so there is some variation among each Provider.²⁴ Thus, these members agreed that there is no need to develop a universal COI policy for all

²³ See the full text of the URS Individual Proposal #28 on pp. 65-66 of the RPM PDP Phase 1 Initial Report: <https://gns0.icann.org/sites/default/files/file/field-file-attach/rpm-phase-1-initial-18mar20-en.pdf>

²⁴ 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)

Providers, noting that all URS Providers already implement conflict of interest measures. The Working Group further agreed that it is not necessary or practical for the Working Group to develop a universal COI policy that can gain consensus support within the PDP timeframe.

Based on public comments received, the Working Group ultimately agreed that every URS Provider should publish an effective Examiner COI policy that the Provider reasonably enforces against any Examiner who violates such policy. The Working Group noted that while FORUM, one of the URS Providers, does not currently publish its COI policy, it does not have an issue making that policy public.

Public Comment Review:

Based on public comments received, the Working Group noted that URS Individual Proposal #28, which served as the origin of this recommendation, received general support but with some opposition. The Working Group took into account the opposing opinions to the original individual proposal and agreed to remove the sentence “The ‘Conflict of Interest Policy’ should be developed by the Working Group and applied to all Providers” when developing the final recommendation text. While the Working Group sought public comment on the suggested elements of the proposed universal COI policy for Examiners as well as existing COI policies that can serve as examples, the Working Group received very limited input.

URS Final Recommendation #8

The Working Group recommends that the ICANN org establishes a compliance mechanism or mechanisms 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(s) should include an avenue for any party in the URS process to file complaints and seek resolution of noncompliance issues.

Implementation Guidance:

As implementation guidance, the Working Group recommends that the IRT consider:

- Investigating different options for potential compliance mechanism(s), 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.

Context:

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

There were cases where certain URS Providers 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 URS Rules 9(e); 2) transmit the Notice of Complaint via fax and postal mail per URS Procedure para 4.3; 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 Providers reported such non-compliance to ICANN.

URS Providers and Practitioners reported difficulty in getting Registrars to coordinate with Registries to implement a settlement, which typically involves a transfer of the domain registration at the Registrar level. Problems with Chinese Registrars to implement Determinations were also reported.²⁶

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 or mechanisms for any stakeholder in the URS process to raise complaints.

The Working Group agreed that its intent is not to create redundant compliance mechanism(s) that already exist in ICANN org. The Working Group is aware that ICANN org has established practices for enforcing compliance of their contracts by Registries and Registrars. The Working Group also learned from public comment that there is an existing ICANN compliance mechanism related to certain aspects of the URS -- e.g., a URS Complaint Form that Internet users and Providers can use to submit to ICANN org concerning a Registry Operator's non-compliance to enforce a URS action/decision (e.g., lock or suspend a domain name subject to the URS).²⁷

However, the Working Group believes that there is still a lack of clarity/understanding with regard to how the existing compliance mechanism(s) work at ICANN and how to enforce compliance of contracted parties when they fail to fulfill their obligations in the URS process. There is also a lack of clarity/understanding with regard to enforcing compliance of URS Providers. The Working Group identified areas where non-compliance of Providers did not seem to be acted upon by ICANN org. ICANN org's public comment confirmed that enforcing compliance against Providers falls outside the scope of its current Compliance process.

The Working Group agreed that ICANN org has the obligation to enforce compliance of URS Providers. The Working Group acknowledged that ICANN Compliance is responsible for enforcing contractual agreements with Registries and Registrars, but compliance enforcement against Providers may be different as they are non-traditional contracted parties. While acknowledging that ICANN org's MoUs with Providers are enforceable, the Working Group agreed that MoUs and contracts may require

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

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.

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.

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.

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

²⁷ URS Complaint form: <https://forms.icann.org/en/resources/compliance/registries/urs/form>

different enforcement mechanisms . Furthermore, the Working Group noted that its recommendation does not specifically require ICANN Compliance to enforce compliance against URS Providers; some other relevant ICANN org department(s) may be responsible for enforcing compliance against Providers (e.g., Procurement, Legal).

Based on public comment review, the Working Group agreed that there is an underlying desire/common sentiment calling for consistency, predictability, and implementability for the compliance mechanism(s). Due to the lack of clarity mentioned above, the Working Group agreed to revise its preliminary recommendation text, recommending that “the ICANN org establishes a compliance mechanism or mechanisms”. This language may provide more flexibility for implementation, parsing the roles/responsibilities of the various stakeholders involved in the URS process who have different legal relationships with ICANN org.

As the Working Group is unsure which specific mechanism(s) would be appropriate, it recommends that the future IRT investigate different options. In addition, the Working Group recommends that the IRT review ICANN org’s practice to ensure that the contracted parties operate in accordance with the URS rules and requirements and fulfill their role and obligations in the URS process. However, the Working Group noted that the IRT is not asked to review all previous URS compliance cases as part of the implementation for this recommendation.

Public Comment Review:

The Working Group also sought public comment on any additional compliance issues, as well as suggestions for enhancing compliance in the URS process.²⁸

The Working Group agreed that the non-compliance issues identified in public comment seemed generally consistent with the non-compliance issues the Working Group uncovered during its deliberations. Public comment responses also reinforced the Working Group’s view that the current existing compliance mechanism(s) at ICANN org seem unclear and insufficient.

The Working Group noted ICANN org’s existing compliance mechanism(s) and the question regarding whether additional compliance mechanisms are needed, or whether only the existing ones should be enforced. Ultimately, the Working Group agreed to provide more flexibility for implementation by revising its text to provide for “a compliance mechanism or mechanisms”, and requesting that the IRT investigate different options for appropriate compliance mechanism(s) to hold accountable all stakeholders involved in the URS process.

URS Final Recommendation #9

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.

²⁸ See URS Question #2 in the in the RPM PDP Phase 1 Initial Report on pp.32-33:
<https://gnso.icann.org/sites/default/files/file/field-file-attach/rpm-phase-1-initial-18mar20-en.pdf>

Implementation Guidance:

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

- 1) reaching out to the broader multistakeholder community, including Providers/experts, to assist ICANN org and the IRT to develop those educational materials;
- 2) ICANN org should bear the cost; and
- 3) translations of the resulting materials should be provided.

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 Overview²⁹.

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

Public Comment Review:

The Working Group sought public comment on the need to develop educational materials (see URS Question #4 of the Initial Report).³⁰

Based on its review of public comments, the Working Group agreed to revise its preliminary recommendation text to include 1) the broader multistakeholder community, including Providers/experts to develop the educational materials with the support of ICANN Org; 2) a preference for ICANN org to bear the cost; and 3) the need to provide translations.

²⁹ <https://www.wipo.int/amc/en/domains/search/overview3.0/>

³⁰ See URS Question #4 on p.33 of the RPM PDP Phase 1 Initial Report:
<https://gnso.icann.org/sites/default/files/file/field-file-attach/rpm-phase-1-initial-18mar20-en.pdf>

The Working Group also noted that this final recommendation addresses the need to develop materials for URS parties and practitioners/Examiners, while URS Final Recommendation #10 is intended to address the need to develop materials only for URS parties. Because they have a substantially different focus, the Working Group agreed that it will be preferable to separate the two recommendations.

URS Final 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 informational 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 the URS Providers' services and practices.

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. For example, 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 reported that some Respondents did not file a Response as they did not know how to proceed, regardless of the materials provided by FORUM. FORUM also 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 did not have a position as to whether the uniform set of basic FAQs should be developed by the ICANN org, the three URS Providers jointly, or some other entity. Therefore, the Working Group sought public comment on this resource-related implementation question (see URS Question #6).³¹

Based on the public comment review of URS Question #6, the Working Group suggested that the future IRT consider the following additional details in developing the uniform set of basic FAQs for URS parties:

- ICANN org should primarily bear the cost of developing the FAQs.
- The IRT, which typically consists of community volunteers with support by ICANN org staff, can reach out to URS Providers if they are not represented on the IRT, as well as other additional interested parties outside the IRT for input.
- Providers could share any existing materials with the IRT as a starting point for developing the FAQs.
- ICANN org staff can hold the pen and prepare the materials with input from members of the IRT and other interested parties.

³¹ See URS Question #6 on p.34 of the RPM PDP Phase 1 Initial Report:
<https://gnso.icann.org/sites/default/files/file/field-file-attach/rpm-phase-1-initial-18mar20-en.pdf>

- There should be public comment opportunities for the public to provide input for the draft FAQs.
- The FAQs should not address the question as to what constitutes a clear and convincing standard of proof (this topic is addressed by a different set of education materials as proposed in URS Final Recommendation #9).

Public Comment Review:

Based on its review of public comments, the Working Group agreed to include additional details provided by commenters in response to URS Question #6, which should be considered by the Implementation Review Team (IRT) to develop the uniform set of basic FAQs for URS parties.

URS Recommendations to Maintain Status Quo

None

URS Recommendations to Modify Existing Operational Practice

URS Final Recommendation #11

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:

Prior to the GDPR, URS Providers had 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 registrant contact information via the Complainant and the registrant’s website. Since the entry into force of the GDPR, personally identifiable information has been masked in the public WHOIS/RDDS data. URS Providers now rely on Registries and Registrars to forward non-public contact information and other relevant WHOIS/RDDS data of the registrant before they can send the registrant notices.

In light of GDPR implementation, the Working Group believes that this recommendation does not contradict with the EPDP Phase 1 Recommendations, especially Recommendations #23 and #27 which suggested updates be made to existing procedures and rules impacted by the GDPR, as well as the analysis in ICANN org’s EPDP Phase 1 Recommendation #27 Wave 1 Report.³²

Public Comment Review:

The Working Group agreed that public comments did not raise any new or material perspectives, facts, or solutions. The Working Group also agreed that there was no widespread or substantial opposition to this recommendation.

³² Please see the full text of these EPDP Phase 1 recommendations as well as the Wave 1 Report in the “Background” section of this Final Report.

The Working Group noted a suggestion raised in public comment to codify what the URS Provider should do when the Registry/Registrar does not timely provide the WHOIS/RDDS data of the registrant. FORUM informed the Working Group that Registries/Registrars rarely delayed in providing the registrant contact information. When this happens, FORUM contacts ICANN org to contact the Registry/Registrar to acquire the information. If the Registry/Registrar fails to respond after several attempts, historically the Complainant would give FORUM permission to hold off on commencing the case until the information was obtained.

In light of FORUM's input, the Working Group agreed that the recommendation should be maintained "as is".

URS Final Recommendation #12

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

Context:

URS Providers' feedback indicated some clerical issues concerning Registry Operators, including:

- Communicating from email addresses different from the contacts present in ICANN's repository;
- Not being 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.

Public Comment Review:

The Working Group noted that this recommendation received overwhelming support from public comment with no objection.

The Working Group adopted a suggestion raised in public comment to revise the original recommendation text to make clear that the various interested parties should be taking affirmative steps to resolve the issues identified in the feedback from URS Providers and ensure that URS Providers, Registries, and Registrars have one another's correct, up-to-date contact details in order to ensure the efficacy of the URS process.

In light of compliance issues identified by the Working Group, the Working Group noted ICANN org's public comment that it has faced difficulties in obtaining accurate/up-to-date contact data from contracted parties. ICANN org's comment reinforced the Working Group's view that this recommendation is necessary. However, the Working Group did not reach agreement as to whether

ICANN org should be responsible for enforcing such requirements via its formal contracts with Registries and Registrars, as well as the Memorandum of Understanding (MoU) with Providers.

To gain more information about the clerical issues reported by the Providers, the Working Group also sought public comment from Registry Operators regarding their experience of receiving notices from URS Providers.³³ However, this question received only one substantive response, which seemed to concern an operational issue already dealt with between ICANN org and Providers.³⁴

URS Final Recommendation #13

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.

Implementation Guidance:

As implementation guidance, the Working Group recommends that URS Providers provide their Examiners a set of basic guidance for documenting their rationale for a Determination. The purpose 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; specifically and at a minimum, that the relevant facts are spelled out and each of the three URS elements listed in the original language of the Determination are addressed in the Determination.³⁵

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 (and in what detail) for their findings in the issued Determination. The Working Group's case review also indicated that a number of Determinations cited either inadequate or no rationale for the decisions, such that the Working Group believes it necessary to recommend 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. The Working Group agreed that Providers should have the discretion to provide their Examiners the basic

³³ See URS Question #3 in the in the RPM PDP Phase 1 Initial Report on pp.33:

<https://gnso.icann.org/sites/default/files/file/field-file-attach/rpm-phase-1-initial-18mar20-en.pdf>

³⁴ The only substantive public comment response was from GNSO's Contracted Parties House (CPH), noting the following: "Certain emails have been signed with self-issued certificates, which has led to questions about the legitimacy of those emails among some registry operators". The CPH did not respond to the Working Group's follow-up questions regarding its comment. The Working Group discussed the issues regarding emails signed with self-issued certificates, but it seems that ICANN org and URS Providers have been working to address this operational matter.

³⁵ 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.

guidance in a suitable form, so long as such guidance requires the Examiners to document their rationale for a Determination and at a minimum, to spell out relevant facts and address each of the three URS elements listed in the original language of the Determination.

Public Comment Review:

Based on its review of public comments, the Working Group agreed to tighten its preliminary recommendation language to clarify that the Determination includes at minimum all the required elements of a decision, such as the facts, rationale, test(s) employed, and conclusions.

URS Final Recommendation #14

The Working Group recommends that the IRT consider reviewing the implementation issues identified by the Working Group with respect to Registry Requirement 10 in the “URS High Level Technical Requirements for Registries and Registrars” and amend Registry Requirement 10, if deemed necessary.³⁶

For clarity, the Working Group notes that this recommendation is not intended to create any transfer remedy for the URS. In addition, the Working Group agrees that as set out in the URS Rules and Procedure, a domain name suspension can be extended for one additional year, and the WHOIS for the domain name shall continue to display all of the information of the original Registrant and reflect that the domain name will not be able to be transferred, deleted, or modified for the life of the registration.³⁷

Context:

This recommendation specifically concerns the following parts of the 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-third of URS Practitioners who responded to the Working Group survey on the URS indicated

³⁶ URS Technical Requirements for Registries and Registrars can be downloaded here:

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

³⁷ URS Rule 14(b): If the Complainant wishes to extend the remedy for an additional year per URS Procedure Paragraph 10.3, Complainant shall contact the Registry Operator directly regarding this option.

URS Procedure para 10.2: Immediately upon receipt of the Determination, the Registry Operator shall suspend the domain name, which shall remain suspended for the balance of the registration period and would not resolve to the original web site. The Registry Operator shall cause the nameservers to redirect to an informational web page provided by the URS Provider about the URS. The URS Provider shall not be allowed to offer any other services on such page, nor shall it directly or indirectly use the web page for advertising purposes (either for itself or any other third party). The Whois for the domain name shall continue to display all of the information of the original Registrant except for the redirection of the nameservers. In addition, the Registry Operator shall cause the Whois to reflect that the domain name will not be able to be transferred, deleted or modified for the life of the registration.

URS Procedure para 10.3: There shall be an option for a successful Complainant to extend the registration period for one additional year at commercial rates.

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 that the future IRT 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 the URS process.

Public Comment Review:

Based on its review of public comments, the Working Group agreed that it should expressly clarify that this recommendation is not intended to create any transfer remedy for the URS. In addition, the Working Group agreed to emphasize that the suspension can be extended for one year, but ownership of the domain name is not transferred to the winning Complainant or another registrar .

Furthermore, the Working Group also sought public comment on whether Registry Requirement 10 should be amended to include the possibility for a winning Complainant to elect another Registrar, which is different from the sponsoring Registrar but accredited by the same Registry, to renew the domain name(s) at issue, and to collect the Registrar renewal fee (see URS Question #5 in the Initial Report).³⁸ The Working Group agreed that public comments provided no conclusive direction with respect to this question and consequently did not develop a recommendation on this point.

URS Final Recommendation #15

The Working Group recommends that the "URS High Level Technical Requirements for Registries and Registrars" document be renamed as the "URS High Level Requirements for Registries and Registrars". The Working Group also recommends that on ICANN org's web page <https://newgtlds.icann.org/en/applicants/urs>, the "URS Technical Requirements 1.0" document be renamed as the "URS Registrars and Registries Requirements 1.0".

Context:

This recommendation was developed following the Working Group's review of public comments to URS Individual Proposal #2, which did not rise to the level of becoming a preliminary recommendation, but received sufficient support from the Working Group to be published in the Phase 1 Initial Report for public comment.³⁹

The Working Group recognized that the technical document "URS High Level Technical Requirements for Registries and Registrars" also includes the following legal requirements pertaining to the inclusion of a particular text in the Registry-Registrar Agreement:⁴⁰

³⁸ See URS Question #5 on pp.33-34 of the RPM PDP Phase 1 Initial Report:

<https://gnso.icann.org/sites/default/files/file/field-file-attach/rpm-phase-1-initial-18mar20-en.pdf>

³⁹ See the full text of the URS Individual Proposal #2 on pp.58-59 of the RPM PDP Phase 1 Initial Report:

<https://gnso.icann.org/sites/default/files/file/field-file-attach/rpm-phase-1-initial-18mar20-en.pdf>

⁴⁰ See p.5 of the URS Technical Requirements for Registries and Registrars:

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

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).

The Working Group agreed that this minimal change would enhance clarity of the document scope and reduce the risk of confusion among Registries and Registrars, who may be puzzled by the inclusion of requirements with legal implications inside a document with the phrase "technical requirements" in its title. The Working Group also agreed that the title of the same document published on the ICANN org's web page <https://newgtlds.icann.org/en/applicants/urs> needs to be updated for sake of clarity and consistency.

Public Comment Review:

Based on the public comments received, the Working Group noted that there was no objection to the URS Individual Proposal #2, which served as the origin of this recommendation. Furthermore, the Working Group noted that the second approach suggested in the original proposal garnered more support among public comment contributors; the GNSO's Contracted Parties House, which the Working Group particularly sought public comment from with regard to the original proposal, also supported the second approach. Therefore, the Working Group agreed to put the second approach forward as a recommendation for inclusion in its Phase 1 Final Report.

Trademark Clearinghouse (TMCH) Final Recommendations

TMCH Recommendation for New Policies or Procedures

TMCH Final Recommendation #1

Agreed Policy Principles:

The Working Group recommends that the scope and applicability of the TMCH be clarified and limited in accordance with the following agreed policy principles:

1. Only word marks that meet one of the following requirements are eligible for the mandatory Sunrise and Trademark Claims RPMs:
 - a. Nationally or regionally registered word marks from all jurisdictions; or
 - b. Word marks validated by a court of law or other judicial proceeding; or
 - c. Word marks that are protected by a statute or treaty that is in effect at the time the mark is submitted to the TMCH and that are listed with a national or regional

trademark office. This provision is important for the protection of certain marks of international governmental and non-governmental organizations (see Explanatory Note below).

2. “Word marks” include service marks, collective marks, certification marks and word marks protected by statute or treaty, as further limited by Policy Principle #3 below.
3. Geographical indications, protected designations of origin, and other signs protected by quality schemes for distinguishing or indicating the geographic source or quality of goods or services are not eligible for the mandatory Sunrise and Trademark Claims RPMs unless they are also trademarks as defined in 1(a) or 1(b) above.⁴¹
4. The TMCH Validation Provider(s), registry operators and other third parties may provide ancillary services to intellectual property rights-holders. To the extent that the TMCH Validation Provider validates and accepts other forms of intellectual property (such as geographical indications) in order to provide such additional voluntary services, these other forms of intellectual property must be held in a separate ancillary database.

Implementation Guidance:

The Working Group recommends that the Implementation Review Team (IRT) consider adopting the following language in amending the Module 5 Trademark Clearinghouse of the Applicant Guidebook to reflect the agreed policy principles noted above:

3.2.1 Nothing in this section shall exclude the TMCH Validation Provider and registry operators from offering additional voluntary services to mark holders.

3.2.2 In this section “word mark” includes service marks, collective marks, certification marks, and word marks protected by statute or treaty.

3.2.3 The standards for inclusion in the Clearinghouse in order to be eligible for the mandatory Trademark Claims and Sunrise RPMs are:

- (1) Nationally or regionally registered word marks from all jurisdictions;
- (2) Word marks that have been validated through a court of law or other judicial proceeding;
- (3) Word marks protected by a statute or treaty in effect at the time the mark is submitted to the Clearinghouse for inclusion and listed at a national or regional trademark office.
- (4) Subsection (3) does not apply to geographical indications, protected designations of origin, or other quality schemes unless they also satisfy subsections (1) or (2).

3.2.4 The standards for being validated and accepted for the sole purpose of inclusion in ancillary databases to permit the provision of additional voluntary services, but not for the purpose of accessing mandatory Trademark Claims or Sunrise RPMs are:

⁴¹ The Working Group is using the phrase “quality scheme” in the sense used by the European Union when describing its quality policy: see, e.g.: https://ec.europa.eu/info/food-farming-fisheries/food-safety-and-quality/certification/quality-labels/quality-schemes-explained_en.

- (1) Other marks that constitute intellectual property;
- (2) Geographical indications, protected designations of origin, or other quality schemes for distinguishing or indicating the geographic source or quality of goods or services.

3.2.5 Applications for trademark registrations, marks within any opposition period or registered marks that were the subject of successful invalidation, cancellation or rectification proceedings are not eligible for inclusion in the Clearinghouse.

Explanatory Note in relation to word marks protected by statute or treaty:

Treaty organizations and non-governmental organizations protected by statute are not always able to register their word marks at a national trademark office. In some jurisdictions their marks are reflected as a “non-registration” (e.g. the 89 series in the United States Patent & Trademark Office) which ensures no one can subsequently register those marks as a trademark, or are otherwise listed with the relevant trademark office. Where such word marks are listed with a national or regional trademark office, they must be treated within the Clearinghouse in the same way as a registered word mark or a court validated word mark and must be eligible for Claims and Sunrise.

An illustrative example of a network of societies whose word marks are protected by international treaty and national statutes is the Red Cross, whose signs and emblems are protected by the Geneva Conventions, and which has signs listed, inter alia, in the 89 series at the United States Patent & Trademark Office.

Context:

This recommendation was developed following the Working Group’s review of public comments to TMCH Individual Proposals #4 and #5, which did not rise to the level of becoming preliminary recommendations, but received sufficient support from the Working Group to be published in the Phase 1 Initial Report for public comment.⁴²

Based on the public comments received, the Working Group agreed to develop a recommendation that consolidates those two TMCH Individual Proposals and clarifies the TMCH requirements in the Applicant Guidebook (AGB). During its deliberation, the Working Group coalesced around the following ideas: (1) mandatory RPMs should only be for trademarks, not other source designations that do not function as trademarks, including Geographical Indications; (2) while such other designations can be entered into an additional/ancillary database maintained by the TMCH Validation Provider, they are not eligible for Sunrise and Claims; and (3) the ability for the TMCH Validation Provider and Registry Operators to offer additional/voluntary ancillary services to such other designations should be preserved (e.g., via an ancillary database).

⁴² See the full text of the TMCH Individual Proposal #4 and #5 on pp. 73-76 of the RPM PDP Phase 1 Initial Report: <https://gnso.icann.org/sites/default/files/file/field-file-attach/rpm-phase-1-initial-18mar20-en.pdf>

The Working Group ultimately agreed that the policy principles contained in the recommendation text reflect those ideas, and frame the suggested amendments to the Applicant Guidebook (AGB) text in the Implementation Guidance. The Working Group further agreed that its proposed amendment to the AGB text should serve as a starting point; the IRT will have the flexibility/latitude to develop the final language of the AGB. The Working Group noted that the AGB will be subject to extensive community consultation; in the implementation stage, the actual language of the final policy will also be posted for public comment.

Public Comment Review:

Based on the public comments received, the Working Group noted that different stakeholders indicated their preference for either the TMCH Individual Proposal #4 or the TMCH Individual Proposal #5. Due to the similarities between these two proposals, the Working Group agreed to put forward a recommendation which consolidates them based on the agreed policy principles that received cross-community support.

The Working Group considered the comments from Deloitte, the TMCH Validation Provider, which explicitly stated that it has never deviated or overstepped the TMCH guidelines and always had taken into account the requirements and rules defined in the guidebook.⁴³ However, the Working Group believed that this recommendation is necessary in clarifying the requirements and rules in the AGB, which Deloitte must follow.

TMCH Recommendation to Maintain Status Quo

TMCH Final Recommendation #2

The Working Group considered the following aspects of the TMCH:⁴⁴

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 changed such as to be limited in their scope to be applicable only in those gTLDs that pertain to the categories of goods and services for which the dictionary term(s) within that trademark are protected.

The Working Group’s 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.

Context:

To determine whether there was sufficient support within the Working Group to change the status quo

⁴³ See Deloitte’s comments for the TMCH Individual Proposal #4 in the public comment review tool row #39 here: https://docs.google.com/spreadsheets/d/1QTT_m5qdzoalRDclUED01ur-yJgODCex8bj_-aKO7fl/edit#gid=722865735

⁴⁴ 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>

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”⁴⁵

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 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”

The Working Group’s recommendation on this point is consistent with Trademark Claims Final Recommendation #4: “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 deliberation note in a Google Doc (see footnote) provides details of these discussions.⁴⁶

Ultimately, the Working Group believes that the exact match criteria strikes an appropriate balance of deterring bad-faith registrations without evidence that good-faith domain name applications were deterred to any substantial extent. As a result, the Working Group agreed on Trademark Claims Final Recommendations #4 and the TMCH Final Recommendation #2, which are consistent with each other.

3. “Scope of Applicability of the Sunrise & Claims RPMs to specific gTLDs for trademarks containing dictionary term(s)”

Currently, Sunrise and Trademark Claims RPMs are not limited, in the sense that these RPMs are applicable in all gTLDs launched during the 2012 New gTLD Program round. As such, these RPMs would have been available to owners of trademarks that contain dictionary term(s) regardless of whether the gTLDs are related or unrelated to the categories of goods and services for which the dictionary term(s) within that trademark are protected.

The Working Group had diverging opinions on whether the availability of Sunrise and Trademark Claim services for trademarks that contain dictionary term(s) should be limited to apply only to those gTLDs that pertain directly to the relevant categories of goods and services. 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

⁴⁵ 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%20guidelines%20v1.2_0.pdf.

⁴⁶ https://docs.google.com/document/d/10quBC1BnuIM_wOyEXH7TttNWEOrDTiPNscgSBd7QFXg/edit?usp=sharing

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.

Public Comment Review:

Based on public comments received, the Working Group clarified the text of its preliminary recommendation on the point pertaining to the unlimited scope of Sunrise and Trademark Claims. However, as noted, the substance of the recommendation remains unchanged.

TMCH Recommendations to Modify Existing Operational Practice

TMCH Final Recommendation #3

The Working Group recommends that the TMCH Validation Provider be primarily responsible for educating rights-holders, domain name registrants, and potential registrants about the services it provides.

The Working Group also recommends that the IRT work with the TMCH Validation Provider and consider enhancing existing educational materials already made available by the TMCH Validation Provider, with additional attention to providing information that can benefit domain name and potential registrants.

Context:

This recommendation was developed following the Working Group’s review of public comments to TMCH Individual Proposal #1, which did not rise to the level of becoming a preliminary recommendation, but received sufficient support from the Working Group to be published in the Phase 1 Initial Report for public comment.⁴⁷

The Working Group agreed that the TMCH services benefit multiple stakeholders, so for the TMCH to have successful interactions with the community, it should provide meaningful information about its services. The Working Group further agreed that the TMCH Validation Provider is best positioned to explain its own services and correctly identify the stakeholders it interacts with. It therefore should be primarily responsible for the educational efforts.

Based on public comments submitted by Deloitte, the current TMCH Validation Provider, the Working Group understood that Deloitte has already been providing education on the TMCH, the New gTLD Program, and its associated RPM’s since the launch of the TMCH in March 2013. Therefore, the Working Group further suggested these existing educational and outreach efforts be enhanced to benefit current and potential domain name registrants beyond trademark owners in order to serve the fuller community. This suggestion aligns with the Working Group’s Trademark Claims Final Recommendation #6 concerning the improvement of the Trademark Claims Notice.

⁴⁷ See the full text of the TMCH Individual Proposal #1 on pp.70-71 of the RPM PDP Phase 1 Initial Report: <https://gnso.icann.org/sites/default/files/file/field-file-attach/rpm-phase-1-initial-18mar20-en.pdf>

The Working Group adopted the suggestion raised in public comments that the IRT should work with the TMCH Validation Provider and consider enhancing the educational materials. In this regard, the IRT (consisting of community volunteers working in consultation with ICANN org staff) should bear primary responsibility for improving the education materials, to be subsequently published and distributed by the TMCH Validation Provider.

Public Comment Review:

Based on the public comments received, the Working Group noted that TMCH Individual Proposal #1, which served as the origin of this recommendation, received wide support. The Working Group adopted a suggestion raised in public comment to clarify that it is the TMCH Validation Provider who has the primary responsibility for education. Furthermore, the Working Group adopted another suggestion raised in public comment that the IRT should consider enhancement of educational materials already being made available by the TMCH Validation Provider, with an eye toward also benefiting current and potential domain name registrants.

TMCH Final Recommendation #4

The Working Group recommends that the Trademark Clearinghouse database provider be contractually bound to maintain, at minimum, industry-standard levels of redundancy and uptime.

Implementation Guidance

To assist the IRT that will be formed to implement recommendations adopted by the Board from this PDP, the Working Group has developed the following implementation guidance:

- 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 Program to assist ICANN org with developing the specifications for and design of the Trademark Clearinghouse.⁴⁸

Context:

This recommendation was developed following the Working Group’s review of public comments to TMCH Individual Proposal #6, which did not rise to the level of becoming a preliminary recommendation, but received sufficient support from the Working Group to be published in the Phase 1 Initial Report for public comment.⁴⁹

This recommendation 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

⁴⁸ See details about the Implementation Advisory Group here:

<https://newgtlds.icann.org/en/about/trademark-clearinghouse/summary-iag-input-26sep12-en.pdf>

⁴⁹ See the full text of the TMCH Individual Proposal #6 on p.77 of the RPM PDP Phase 1 Initial Report:

<https://gns0.icann.org/sites/default/files/file/field-file-attach/rpm-phase-1-initial-18mar20-en.pdf>

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).

Based on the wide support received from public comments for the original proposal, the Working Group believed that 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. Therefore, the Working Group agreed to put forward this recommendation in its Phase 1 Final Report for consideration by the IRT.

Public Comment Review:

Based on the public comments received, the Working Group noted that TMCH Individual Proposal #6, which served as the origin of this recommendation, received wide support. In reviewing the public comments, the Working Group agreed that there was an anecdotal but real report of operational problems related to the TMCH Database, and there was support that the uptime requirements and reliance of the TMCH services should be changed to industry standards.

Sunrise Final Recommendations

Sunrise Recommendation for New Policies or Procedures

Sunrise Final Recommendation #1

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

Implementation Guidance:

The Working Group agrees that this recommendation and its implementation are not intended to preclude or restrict a Registry Operator's legitimate business practices that are otherwise compliant with ICANN policies and procedures.

Context:

The Working Group generally agreed that some Registry Sunrise or Premium Name pricing practices have limited the ability of some trademark owners to participate during Sunrise.⁵⁰ The Working Group was made aware of cases where certain 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

⁵⁰ **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.

significantly higher than other Sunrise pricing or Landrush/General Availability pricing. The Working Group noted that this problem seems sufficiently extensive that it warranted a policy recommendation to address.

To assist the IRT that will be formed to implement recommendations adopted by the Board from this PDP, the Working Group tried to reach agreement on some possible types of specific Registry conduct that could have the effect of intentionally circumventing trademark owners' use of the Sunrise Period within the meaning of the Registry Agreement provision envisioned in this recommendation, so as to trigger enforcement action by ICANN org (e.g., its Contractual Compliance department). As part of its discussion, the Working Group noted that several public comments to the Initial Report had raised the following examples as non-exhaustive illustrations of such conduct (some of which had also been raised by Working Group members):

- Withholding or self-allocating domain names that correspond to trademarks recorded in the TMCH with the intent of circumventing the use of the Sunrise Period by trademark owners;
- Discriminatory pricing practices clearly designed to effectively prevent the reasonable ability of trademark owners to obtain defensive Sunrise registrations for their marks recorded in the TMCH. In this context, "discriminatory pricing practices" could include extremely high pricing during the Sunrise Period of the domain names that correspond to trademarks recorded in the TMCH followed by significantly lower prices for the same domain names during Landrush or General Availability, such as to evidence an intent to target trademark owners either specifically, or as a general class of registrants, for the purpose of inhibiting access to Sunrise registrations.

Furthermore, some Working Group members suggested that the IRT consider the following non-exhaustive list of resources raised in public comments, which could provide relevant examples of Registry Operator conduct that may have the effect of intentionally circumventing trademark owners' use of the Sunrise Period:

- Correspondence from ICANN's GNSO Business Constituency regarding the rollout of the .sucks new gTLD by Vox Populi Registry (8 May 2015): <https://www.bizconst.org/assets/docs/positions-statements/letter-to-icann-dotsucks.pdf>
- Correspondence from the Federal Trade Commission (FTC) regarding the rollout of the .sucks new gTLD by Vox Populi Registry (27 May 2015): <https://www.icann.org/en/system/files/correspondence/ramirez-to-jeffrey-27may15-en.pdf>
- Panel Report of ICANN's Public Interest Commitment Dispute Resolution Procedure (PICDRP) concerning the .feedback registry (17 March 2017): <https://www.icann.org/en/system/files/correspondence/ramirez-to-jeffrey-27may15-en.pdf>
- Collated information from RPM PDP Working Group members concerning perceived Sunrise abuse by new gTLD Registry Operators (17 October 2016): <https://go.icann.org/collated>

Nevertheless, the Working Group also had diverging opinions on whether registry pricing is within the scope of the RPM PDP Working Group. While some Working Group members expressed concerns about the interplay of Registry pricing with RPMs obligations, other 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.”⁵¹ 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.⁵²

Several Working Group members also noted that many trademarks consist of generic dictionary words that have inherent value which can be used by potential registrants (other than the trademark owner) in a non-infringing manner, thus justifying a premium price being charged for the domain name.⁵³

Therefore, some Working Group members expressed concerns about or objected to listing those above examples, cautioning that premium pricing level in and of itself may not indicate the kind of conduct that this recommendation is meant to address. Several Working Group members noted that highlighting registry pricing practices could put the Working Group at risk of violating the “picket fence”.

The Working Group also discussed the question of whether there should be an additional enforcement mechanism, apart from actions taken by ICANN Compliance on its own or at the request of an outside party, for addressing such conduct by a Registry Operator. Some members suggested that the IRT should consider developing an enforcement mechanism where discriminatory pricing resulted in bad faith registration of a domain that corresponds to a trademark recorded in the TMCH and subsequent infringement of the trademark after the Sunrise Period. In addition, a small team of Working Group members proposed that the IRT should explore the possibility of a third party challenge mechanism as one of the possible means of enforcement among others (for example, direct enforcement by ICANN Compliance), provided that any such third party challenge mechanism should also include appropriate safeguards for Registry Operators. However, this small team proposal did not receive wide support and received significant opposition in the Working Group. As such, the Working Group did not reach agreement on the question of an additional enforcement mechanism to supplement enforcement actions taken by ICANN Compliance.

⁵¹ **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>

⁵² 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>.

⁵³ One Working Group member noted that based on the empirical research of Barton Beebe & Jeanne C. Fromer, 81.3% of the most commonly used English words were single-word registered trademarks in the US; for registrations at EUIPO, the corresponding number is 69.4% for English; the results are similar for French, German, Italian, and Spanish. See “Are We Running out of Trademarks?”, 131 Harv. L. Rev. 945, pp.981-82 (2018) and “Coping with Trademark Depletion in a Global Economy: A Comparative Empirical Study of the United States and the European Union (draft)” at pp.3, 24.

Public Comment Review:

Based on public comments received, the Working Group agreed that it should try to develop additional implementation guidance on this topic, including a non-exhaustive list of clarifying ideas/examples of registry conduct that may have the effect of intentionally circumventing mandatory RPMs, particularly the Sunrise Period used by trademark owners. As described above, the Working Group did not agree on the specific form of implementation guidance or examples for inclusion. Despite the divergence of opinions on implementation guidance, the actual policy recommendation received wide support among Working Group members. Ultimately, the Working Group agreed to leave it to the IRT to determine what forms of Registry Operator conduct would constitute a violation of this recommendation such as to trigger enforcement action by ICANN org, should the Registry Agreement contain a prohibition on such conduct.⁵⁴

Sunrise Recommendations to Maintain Status Quo

Sunrise Final Recommendation #2

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 for all new gTLDs, with the sole exception of those gTLDs who receive exemptions pursuant to Specification 13 .Brand TLD Provisions and Section 6 of Specification 9 Registry Operator Code of Conduct of the Registry Agreement (or their equivalent in the next new gTLD expansion round).⁵⁵

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 the Sunrise Period continuing to be mandatory. The Working Group noted that there were 64,000+ Sunrise registrations across 484 gTLDs as of August 2017.

Some Registry Operators indicated that they would prefer an option to choose between offering Sunrise or Trademark Claims services. The Working Group also noted that, where these are offered by a Registry Operator, trademark and brand owners may view blocking services such as Domains Protected Marks

⁵⁴ See community input regarding the Sunrise abuse in responses to Sunrise Question #2 in the public comment review tool here: <https://docs.google.com/spreadsheets/d/1xMehg9o44bdz85ry0LjvhzoOaKdmJ6SwlrLneMx0lxc/edit#gid=581453427>

⁵⁵ See **Specification 13 .Brand TLD Provisions** here:

<https://newgtlds.icann.org/sites/default/files/agreements/agreement-approved-specification-13-31jul17-en.pdf>;

The exemption language in **Section 6 of Specification 9 Registry Operator Code of Conduct** is as follows: "Registry Operator may request an exemption to this Code of Conduct, and such exemption may be granted by ICANN in ICANN's reasonable discretion, if Registry Operator demonstrates to ICANN's reasonable satisfaction that (i) all domain name registrations in the TLD are registered to, and maintained by, Registry Operator for the exclusive use of Registry Operator or its Affiliates, (ii) Registry Operator does not sell, distribute or transfer control or use of any registrations in the TLD to any third party that is not an Affiliate of Registry Operator, and (iii) application of this Code of Conduct to the TLD is not necessary to protect the public interest." See full text of the Specification 9 here:

<https://newgtlds.icann.org/sites/default/files/agreements/agreement-approved-31jul17-en.html#specification9>. More information about the Specification 9-exempted TLDs can be found here.

List (DPML) and DPML Plus as viable alternatives to the Sunrise Period.⁵⁶

Some Working Group members voiced concerns about the continuation of the mandatory Sunrise Period, based on the potential for abuse by trademark owners due to the 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, the Working Group concluded overall that there is currently inadequate evidence to validate this concern.

Public Comment Review:

The Working Group noted that there was wide community support for exempting dot Brand TLDs, whose Registry Agreement with ICANN org include Specification 13 which does not require them to run a mandatory Sunrise Period. Public comments received also clarified that those TLD Registries who receive exemptions pursuant to Section 6 of Specification 9 in the Registry Agreement are also not expected or required to run a mandatory Sunrise Period.

Consequently, the Working Group agreed to clarify its recommendation to ensure that Specification 13/dot Brand TLDs and Specification 9-exempted TLDs, who do not allow third-party registrations, are exempted from running the mandatory Sunrise Period. For further clarity, the Working Group notes that this recommendation is intended to apply to all subsequent versions of Specification 9 and Specification 13, to the extent that these specifications mean that exempted Registry Operators do not have to run a mandatory Sunrise Period.

Sunrise Final Recommendation #3

The Working Group recommends that the current requirement for the Sunrise Period be maintained, including for the 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 minimum:⁵⁷

- 1) Start Date Sunrise: The Registry must give 30-day 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.

Since most Registry Operators to date have run an End Date Sunrise, the Working Group focused its work on reviewing the Start Date Sunrise.

The Working Group generally agreed that the current 30-day minimum after the Start Date Sunrise

⁵⁶ Donuts inc. offers the DPML and DPML Plus programs as additional solutions that protect brand's trademarks and prevent cybersquatting. With these programs, trademark owners can block registrations of validated trademarks without requiring defensive purposes in each of Donuts' 241 TLDs. Learn more: <https://donuts.domains/what-we-do/brand-protection>

⁵⁷ See reference here: https://icannwiki.org/Sunrise_Period

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.

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.

Public Comment Review:

While the Working Group noted that a public comment contributor suggested eliminating the less used Start Date Sunrise, which seemed to be a new perspective, the Working Group agreed that the status quo of the two types of Sunrise Periods should be kept and the recommendation be maintained “as is”.

Sunrise Final Recommendation #4

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 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.

Public Comment Review:

The Working Group agreed that public comments did not raise any new or material perspectives, facts, or solutions. The Working Group also agreed that there was no widespread or substantial opposition to this recommendation. Therefore, the Working Group agreed that the recommendation should be maintained “as is”.

Sunrise Final Recommendation #5

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

On the one hand, 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 the TMCH's acceptance of non-standard character claim marks and common/dictionary words, as well as the broad scope of the TMCH.

On the other hand, some Working Group members opposed limiting the scope of Sunrise Registrations in this way 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.

Public Comment Review:

The Working Group agreed that public comments did not raise any new or material perspectives, facts, or solutions. The Working Group also agreed that there was no widespread or substantial opposition to this recommendation. Therefore, the Working Group agreed that the recommendation should be maintained "as is".

Sunrise Final Recommendation #6

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 relating to Registry Operators' determinations of Premium and/or Reserved Names.⁵⁸

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

⁵⁸ **Premium Name:** second level domain names that are offered for registration that, in the determination of the registry, are more desirable for the purchaser. **Reserved Name:** All registry operators are required by their Registry Agreement (RA) to exclude certain domain names from registration in a TLD. These reserved names include strings that are for Country Code Top Level Domains (ccTLDs), ICANN-related names (such as ICANN), IANA-related names (such as example), country and territory names, international and intergovernmental organizations, and names that the registry operator can use in connection with the operation of the TLD.

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 set of implementation guidance. Additionally, some Working Group members believed that ICANN org should require Registry Operators to create a release mechanism in the event that a Premium Name or Reserved Name is challenged successfully.

However, some Working Group members opposed establishing such a challenge mechanism for reasons including but not limited to: 1) the effect on restricting Registry/Registrar's name lists and pricing; 2) impact on Registry Operators' ability to operate their platforms; 3) increased workload for Registry Operators and Registrars to handle challenges; 4) unpredictable consequences such as the potential 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 refine certain elements of the proposed challenge mechanism, introduce a less formal challenge mechanism, or leverage existing mechanisms. However, there was ultimately no wide support for the creation of a challenge mechanism in any shape or form.

Public Comment Review:

The Working Group agreed that public comments did not raise any new or material perspectives, facts, or solutions. The Working Group also agreed that there was no widespread or substantial opposition to this recommendation. Therefore, the Working Group agreed that the recommendation should be maintained "as is".

Sunrise Final Recommendation #7

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

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 noted that requiring publication of the Reserved Names lists could solve a number of problems that had been raised by trademark owners and registrants.

Public Comment Review:

Public comments pointed out that certain Registry Operators reveal information about whether a second-level string is reserved by the Registry via a WHOIS lookup. However, this is not a universal practice. For those Registry Operators that do not provide such information, there is no record of the reserved second-level strings in the WHOIS lookup (e.g., when attempting to register a domain name that has been reserved by the Registry Operator, the registrant gets a generic message "name is not available" in the WHOIS lookup).

While the Working Group did not agree to a recommendation requiring all Registry Operators to reveal the information that certain second-level strings are reserved in the WHOIS lookup, the Working Group nevertheless agreed to highlight this voluntary option for Registry Operators to consider as a means to address the information gap experienced by registrants.

The Working Group therefore encourages trademark owners to contact the Registry Operator and/or the Registrar to enquire about the reason(s) for not being able to register certain domain names in Sunrise. Registry Operators and/or Registrars have the option to reveal whether a second-level string is reserved by the Registry, and the trademark owners have the opportunity to negotiate the release of the domain name for Sunrise registration.

Sunrise Recommendation to Modify Existing Operational Practice

Sunrise Final Recommendation #8**Agreed Policy Principles:**

The Working Group agrees that the TMCH dispute resolution procedure should be the primary mechanism for challenging the validity of the Trademark Record on which a registrant based its Sunrise registration.

While the Working Group agrees that the Sunrise Dispute Resolution Policy (SDRP) allows challenges to Sunrise registrations related to Registry Operator's allocation and registration policies, it is not intended to allow challenges to Sunrise registrations on the grounds that the Trademark Record on which the registrant based its Sunrise registration is invalid.

The Working Group therefore recommends that, once informed by the TMCH Validation Provider that a Sunrise registration was based on an invalid Trademark Record (pursuant to a TMCH dispute resolution procedure), the Registry Operator must immediately suspend the domain name registration for a period of time to allow the registrant to challenge such finding using the TMCH dispute resolution procedure.

Implementation Guidance:

The Working Group suggests that the IRT consider incorporating the following requirements to amend the Applicant Guidebook (AGB) to reflect the above-noted policy principles.

- 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 publication and 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 be amended to remove grounds (i) and (iii) for the SDRP.⁵⁹
- 3) The Trademark Clearinghouse Model of Module 5 of the AGB be amended to include a new Section 6.2.6, with suggested language as follows – “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 suspend the domain name registration for a period of time to allow the registrant to challenge such finding using the TMCH dispute resolution procedure. As a point of reference, Registry Operators in their applicable SDRPs will describe the nature and purpose of the TMCH dispute resolution procedure and provide a link to the relevant resource on the TMCH Validation Provider’s site.”

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

Context:

The SDRP is a mechanism that a Registry Operator must provide to resolve disputes regarding its registration of Sunrise registrations.⁶⁰ According to the Section 6.2.2 and 6.2.4 of the Trademark Clearinghouse Model of Module 5 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.⁶¹ All Registry Operators with Sunrise periods are required to develop a SDRP mechanism in accordance with Section 2.3.5 of the RPM Requirements.

⁵⁹ In this recommendation, some of the terms are capitalized in accordance with the terms used in the AGB. These terms include but are not limited to: “Trademark Clearinghouse Model of Module 5”, “Sunrise Registration”, “TMCH Validation Provider”, “Trademark Holder”, and “Trademark Agent”.

⁶⁰ 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>

⁶¹ Trademark Clearinghouse Model of Module 5 of the Applicant Guidebook (AGB) can be found here <https://newgtlds.icann.org/en/applicants/agb/trademark-clearinghouse-04jun12-en.pdf>

Furthermore, the Working Group noted that the TMCH dispute resolution procedure was created in the time between when the AGB was written and the TMCH requirements were established. The TMCH dispute resolution procedure is used for challenging a decision of the TMCH Validation Provider that a Trademark Record was valid on the grounds that the Trademark Record has been incorrectly verified.

As a result of the creation of the TMCH dispute resolution procedure, two of the AGB requirements for Registries 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.

Due to the aforementioned grounds (i) and (iii), the current SDRP procedure allows challenges to the recordal of marks in the TMCH that underlie Sunrise registrations by engaging with the Registry Operator. However, it is the TMCH Validation Provider's role to confirm that the information submitted by a Trademark Holder or Trademark Agent (on behalf of a Trademark Holder) is accurate and that the Trademark Record meets the eligibility requirements for inclusion in the Clearinghouse. In any event, the Registry Operator is not the best-placed party to adjudicate challenges to the validity of Trademark Record in the TMCH 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, 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 scant analysis of the SDRP decisions across all new gTLDs. 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. 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.

Public Comment Review:

The Working Group adopted a suggestion raised in public comment to refine the recommendation and its contextual language, clarifying the distinction between the two dispute resolution procedures in question -- the TMCH dispute resolution procedure and SDRPs.

Furthermore, the Working Group adopted another suggestion raised in public comment that, instead of deleting a Sunrise registration immediately after learning that it was based on an invalid Trademark

Record in the TMCH, the Registry Operator suspends the domain name for a period of time in order to provide the registrant a fair opportunity to challenge such findings, using the TMCH dispute resolution procedure.

Trademark Claims Final Recommendations

Trademark Claims Recommendations for New Policies or Procedures

Trademark Claims Final Recommendation #1

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, with the exception of those gTLDs who receive exemptions pursuant to Specification 13 .Brand TLD Provisions and Section 6 of Specification 9 Registry Operator Code of Conduct of the Registry Agreement (or their equivalents in subsequent new gTLD expansion rounds).⁶²

Context:

The Working Group generally agreed that where the Registry Operator has not obtained an exception, 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, to have 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.

Public Comment Review:

The Working Group noted that there was wide community support for exempting dot Brand TLDs, who have Specification 13 in their Registry Agreement with ICANN org, from running the mandatory Trademark Claims Period. In addition, based on public comments received, the Working Group agreed to clarify that gTLD Registries, who receive exemption pursuant to Section 6 of Specification 9 in the Registry Agreement, are also not expected or required to run the mandatory Trademark Claims Period. Under the current policy, Specification 13/dot Brand TLDs and Specification 9-exempted TLDs are required to run the mandatory Trademark Claims Period.

Therefore, the Working Group recommends amending the existing policy to clarify that Specification 13/dot Brand TLDs and Specification 9-exempted TLDs, who do not allow third-party registrations, are exempted from running the mandatory Trademark Claims Period. While the Working Group noted that there was some community support for exempting “highly regulated” TLDs, it ultimately concluded that such TLDs should not be exempted from running the mandatory Claims Period.

⁶² For more information about Specification 13 and Section 6 of Specification 9, please see the footnote of Sunrise Final Recommendation #2.

Trademark Claims Final 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 Requirements 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.”⁶³
- The Claims Notice **MUST** include a link to a webpage on the ICANN org website which contains translations of the Claims Notice in all six UN languages.

Context:

The Working Group generally agreed that the current requirements regarding translations of the Claims Notice do not seem effective in informing domain name applicants of the scope and limitation of trademark holders’ rights.

The current TMCH RPM 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 Working Group agreed that the Claims Notice has inadequacies and shortcomings in the English language in which it was initially drafted, it follows that the notice is unlikely to be more comprehensible among recipients who do not speak English or are not native speakers.

Public Comment Review:

The Working Group adopted a suggestion raised in public comment and replaced “should” with “must” in the second bullet point in its final recommendation text.

Trademark Claims Recommendations to Maintain Status Quo

Trademark Claims Final Recommendation #3

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

The Working Group further recommends that if a Registry Operator offers a Limited Registration

⁶³ <http://newgtlds.icann.org/en/about/trademark-clearinghouse/rpm-requirements-30sep13-en.pdf>

Period, the Registry Operator must maintain the current requirement pursuant to RPM Requirements Section 3.2.5 and provide the Claims Services during the entire Limited Registration Period in addition to the minimum initial 90-day Claims Period when the TLD opens for general registration.⁶⁴

Context:

The Working Group generally agreed that where there is a Claims period, 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 to maintain the status quo of the minimum initial 90-day Claims period when a TLD opens for general registration.

In addition, the Working Group generally agreed that Registries should have a certain degree of flexibility, based on a suitable business model, to have 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.

Public Comment Review:

The Working Group adopted a suggestion raised in public comment to expressly refer to the RPM Requirements Section 3.2.5 and confirm in the recommendation language that where a Registry Operator offers a Limited Registration Period after Sunrise and prior to General Availability (GA), Trademark Claims Period must operate throughout, in addition to the first 90 days of GA.

Trademark Claims Final Recommendation #4

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 deliberation note in a Google Doc (see footnote) provides details of these

⁶⁴ RPM Requirements Section 3.2.5 states: "If Registry Operator offers a Limited Registration Period, Registry Operator MUST provide the Claims Services during the entire Limited Registration Period in addition to the standard Claims Period. For the avoidance of doubt, the first ninety (90) calendar days of General Registration must employ the Claims Services, regardless of any other registration period prior to the start of General Registration." See p.10 here: <http://newgtlds.icann.org/en/about/trademark-clearinghouse/rpm-requirements-14may14-en.pdf>

discussions.⁶⁵

The Working Group believes that the exact match criteria strikes the appropriate balance of deterring bad-faith registrations without clear evidence that good-faith domain name applications are substantially deterred. The Working Group agreed that the 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 Final Recommendation #6.

Public Comment Review:

The Working Group agreed that public comments did not raise any new or material perspectives, facts, or solutions. The Working Group also agreed that there was no widespread or substantial opposition to this recommendation. Therefore, the Working Group agreed that the recommendation should be maintained “as is”.

Trademark Claims Recommendations to Modify Existing Operational Practice

Trademark Claims Final Recommendation #5

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

Implementation Guidance:

The Working Group agrees that the IRT needs to recognize 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.

For clarity, the Working Group notes that this recommendation is not intended to preclude or restrict Registrars’ legitimate business practice of pre-registration, provided this is compliant with the Trademark Claims service requirements.

The Working Group requests that the IRT uses appropriate flexibility and consider ways in which ICANN org can work with Registrars to address all relevant implementation issues (e.g., possibly alter the 48-hour expiration period of the Claims Notice as the IRT deems appropriate), but which will continue to allow legitimate pre-registration programs compliant with RPM requirements to continue.

Context:

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

⁶⁵ See https://docs.google.com/document/d/10quBC1BnuIM_wOyEXH7TttNWFOrDTiPNscgSBd7QFXg/edit?usp=sharing

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

Public Comment Review:

The Working Group agreed with a point raised in public comment that if a Registrar cannot present the Claims Notice before a registration is completed in its pre-registration program, the Registrar is not in compliance with the Trademark Claims service requirement. While noting this operational issue, the Working Group agreed on the need to clarify that its recommendations and guidance do not attempt to prohibit the legitimate practice of pre-registration, as long as it is compliant with RPM requirements.

The Working Group also agreed that the IRT should have flexibility/latitude to facilitate solutions of all relevant implementation issues related to pre-registration. For example, the Working Group agreed that it is the IRT's role to decide whether the 48-hour expiration period of the Claims Notice should or should not be changed.

Trademark Claims Final Recommendation #6

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 the risk of unintended effects or consequences of deterring good-faith domain name applications.

The Working Group agrees 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).

Implementation Guidance:

To assist the IRT that will be formed to implement recommendations adopted by the Board 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 the IRT use appropriate flexibility and consider whether it

believes it will be helpful to solicit input from resources internal and/or external to the ICANN community as the IRT deems necessary and appropriate. Suggested external resources could include academic and industry sources such as the American University Intellectual Property Clinic, INTA Internet Committee, the Electronic Frontier Foundation, and Clinica Defensa Nombres de Dominio UCN . The IRT may also, in its discretion, consider input from communications experts, who can help review the Claims Notice for readability purposes and ensure it is understandable to the general public.

Context:

The Working Group discussed whether 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 such deterrence that occurred, if any.

The Working Group generally agreed that, overall, the Claims Notice 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 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).

Public Comment Review:

Based on public comments received, the Working Group refined this recommendation to ensure that it accurately reflects the Working Group's deliberations on the intended effect and unintended consequences of the Trademark Claims service.

Furthermore, the Working Group agreed that the IRT should have flexibility/latitude to decide whether it wishes to consult any resources for the revision of the Claims Notice language and if so, from which resources it wishes to solicit input. In this regard, the Working Group adopted a suggestion raised in public comment and revised its recommendation to make it less prescriptive. The Working Group also agreed to include a mention of communications experts, as suggested in public comment, as a potential resource for consideration by the IRT.

Trademark Post-Delegation Dispute Resolution Procedure (TM-PDDRP) Final Recommendation

TM-PDDRP Recommendation for New Policies or Procedures

TM-PDDRP Final Recommendation

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 Operator may be initially submitted as a joint Complaint, or may, at the discretion of the Panel, be consolidated upon request.⁶⁶

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.

To the extent that a TM-PDDRP Provider's current Supplemental Rules 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.⁶⁷

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-PDDRP;⁶⁸ 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.

⁶⁶ 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>

⁶⁷ 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>

⁶⁸ 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>

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.⁶⁹

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.

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 recommendation, 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.⁷⁰ 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 Phase 1 Final Report, no Complaints had been brought under the procedure. Although the Working Group discussed a

⁶⁹ 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>

⁷⁰ 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 IRT that will be convened if this recommendation is approved. See details here: <http://www.wipo.int/export/sites/www/amc/en/docs/icann130309.pdf>

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.

Public Comment Review:

While the Working Group noted concerns raised in public comment that this recommendation may impose additional costs and resource burden on Providers, the Working Group agreed that such concerns may be misplaced -- as the TM-PDDRP is an expensive process, the consolidation of multiple disputes against the same Registry Operator may provide efficiency and other benefits to counterbalance or outweigh the burden/cost for Providers.⁷¹

The Working Group agreed that public comments have not raised any new or material perspectives, facts, or solutions. The Working Group also noted this recommendation did not receive any opposition from public comments. Therefore, the Working Group agreed that the recommendation be maintained "as is".

TM-PDDRP Recommendations to Maintain Status Quo

None

TM-PDDRP Recommendations to Modify Existing Operational Practice

None

Overarching Data Collection Final Recommendation

Overarching Data Collection Final Recommendation

In relation to the TMCH, the Working Group recommends that, for future new gTLD rounds, ICANN Org collect the following data on at least an annual basis (to the extent it does not do so already) and make the data available to future RPM review teams:

- Number of marks submitted for validation in each category of marks accepted by the TMCH;
- Number of successfully validated marks in each category of marks accepted by the TMCH;
- Number of labels generated for all successfully validated marks;
- Number of abused labels;⁷²

⁷¹ The Working Group noted that consolidated complaints against the same Registry Operator may be covered in Providers' supplemental rules to the extent that it may involve additional time and/or fees for TM-PDDRP Providers.

⁷² The term "abused label" refers to those labels associated with a verified trademark record in the TMCH that a trademark owner may register, where the domain was the subject of a determination in a prior UDRP case or court decision in which the rights holder prevailed. A trademark owner may register up to 50 such labels. The TMCH Validator examines UDRP Providers' database information and court case documentation to ensure each label submitted meets this criterion: see <https://newgtlds.icann.org/en/announcements-and-media/announcement-11oct13-en>.

- Number of marks deactivated in and removed from the TMCH;
- Breakdown of the scripts/languages represented in a validated and active trademark in the TMCH; and
- Number of cases decided under the TMCH dispute resolution procedure.

In relation to the Trademark Claims service, the Working Group recommends that, for future new gTLD rounds, ICANN-accredited registrars must provide ICANN Org with periodic reports of the number of Claims Notices that were sent out to prospective registrants not less than every 12 months.

In relation to the URS, the Working Group recommends that ICANN Org explore developing a mechanism, in consultation with the URS Providers, to enable publication and search of all URS Determinations in a uniform format.

The Working Group further recommends that, in implementing Board-adopted recommendations from the 2018 Final Report of the Competition, Consumer Choice & Consumer Trust Review Team, ICANN org also collect data concerning trademark owners' and registrants' experience with the RPMs that can be provided to future GNSO RPM policy review teams (including result of studies that ICANN org may conduct pursuant to Recommendations #26, if approved by the ICANN Board, and #28).⁷³

Context:

Early on in its work, the RPM Working Group agreed that a thorough and meaningful review of all the Phase 1 RPMs required access to historical data as well as regularly-updated data on a going-forward basis. Although ICANN org was able to provide the Working Group with data relating to the RPMs (e.g. lists of delegated gTLDs and the respective dates of each Sunrise and Trademark Claims period, monthly registry reports) and the Working Group also requested and received data relating to the TMCH from Deloitte (e.g. number of validated trademark records and total submissions) as well as from the Analysis Group which conducted an Independent Review of the TMCH, the Working Group encountered challenges in obtaining sufficient quantitative data (as opposed to anecdotal reports) concerning the effectiveness of the RPMs.

The Working Group acknowledged that there are practical difficulties associated with obtaining specific data concerning a possible deterrent effect on potential good faith registrants who receive a Trademark Claims Notice. The Working Group also understands that knowing the number of Claims Notices sent to prospective registrants that were not followed by actual domain registrations is not evidence of a

⁷³ **CCT Review Team's Final Report:** <https://www.icann.org/en/system/files/files/cct-final-08sep18-en.pdf>

CCT Recommendation #26: "A study to ascertain the impact of the New gTLD Program on the costs required to protect trademarks in the expanded DNS space should be repeated at regular intervals to see the evolution over time of those costs. The CCT Review Team recommends that the next study be completed within 18 months after issuance of the CCT Final Report, and that subsequent studies be repeated every 18 to 24 months". As of September 2020, this recommendation remains in pending status, i.e. it has not yet been approved by the ICANN Board.

CCT Recommendation #28: "A cost-benefit analysis and review of the Trademark Clearinghouse (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".

deterrent effect. Nevertheless, the Working Group believes that it will be useful if future RPM review teams are provided with data concerning the number of such notices that are actually sent by registrars.

The Working Group also found that data was not necessarily available in uniform formats (e.g. URS Determinations) and that, to date, except for an ICANN org review of the RPMs in 2015 there have not been any studies done on the RPMs that involved significant data collection and analysis. The Working Group's analysis of the URS was largely informed by initial data work undertaken by ICANN org staff and additional detailed research by a Working Group member.

The dearth of data was also noted by the CCT Review Team, which developed a number of final recommendations aimed at addressing this gap. In relation to RPMs, the Working Group believes that future RPM reviews will greatly benefit if the relevant surveys and studies to be undertaken include relevant questions about the RPMs for which useful data can be collected and analyzed.